

Intellectual Property advocacy in the fields of:

- IP Infrastructure
- IP Policy
- Patent Law
- Copyright
- IP Valuation
- Technology Transfer
- Licensing
- Collaborations
- M & A
- Innovation Research
- Data Management
- Balance for Rights & Obligations

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## Editorial.....

India is proud of the phenomenal progress made by the Indian Patent Office, presently being designated from Office of Controller General of Patents, Designs & Trademarks as Intellectual Property Office India. Often, comparisons are made between Indian Patent Office and others such as China, USA, Japan etc. India has focused on quality (of IP & IP enforcement) and not on quantity. Further, India has tailored the Indian IP and Patent Policy with the balance of Rights and Obligations as well as public interest. India has taken care to avail the flexibilities in TRIPs as eligible to a sovereign member country, such as India. The quality of IP/Patent resource persons, the degree and extent of automation, digitalization and modernisation and the quality of IP products such as Patents, Designs, Trademarks, Geographical Indications granted by India has grown exponentially over the years. The days, when the IP/Patent Office was in shambles in the nineties and the extremely chaotic and corrupt days of the early 2000's are forgettable history now.

With the Government of India (DIPP in particular) appointing upright and no-nonsense IAS officers like Mr. P.H. Kurian, Mr. Chaitanya Prasad, Mr. Rajiv Aggarwal, Jt. Secretary, DIPP (who held the charge for few months), have made commendable contributions during their tenure. Now, Mr. Om Prakash Gupta, the present Controller General of Patents, has taken the IP office and its productivity, quality and transparency to new heights. The success in digitalisation in recent times is indeed commendable.

On the Trademarks front also, similar progress and improvements on reducing backlog as well as digitalisation with transparency has been achieved in recent times, which merits mention and appreciation.

On the Patents front, the "inPASS" & other search engines as well as total online access of entire "Prosecution History/File Wrapper" as well as status & Register data on a day to day upgraded format, has made the Indian Patent Office website based information & data accessibility, second to none. Commendable is the "grievance redressal windows" and frequent meetings with stakeholders.

After a gap of 2 years, the Patent Agent Examination has been held recently. The manner in which the schedule, question paper-setting and the holding of the written exams as well as the announcement of results were processed merits appreciation and kudos (notwithstanding the poor hardware infrastructure in the exam centres, at least in Mumbai).

Consequent to the Recommendations of the Nikko Denko Committee, the facility for "Expedited Examination" has been introduced in May 2016. The Government (DIPP & the office of the CG) has also implemented the other major recommendation of the Nikko Denko Committee and have recruited nearly 400+ Patent Examiners, which is commendable. With these reforms, it is hoped that timelines for grant of Patents will come down to 1 to 2 years from the current 6 to 7 years.

Indigenous Research based patenting has received a major setback with the lopsided implementation of the National Biodiversity Act. It is shocking that not only the NBA (National Biodiversity Authority), but also the State Biodiversity Boards are enforcing the Act & Rules, ruthlessly and senselessly. To add insult

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to injury, the National Green Tribunal has also been brought in, not to adjudicate the cases, but to ruthlessly penalise genuine research and "Make in India" efforts based on indigenous materials, most of which are either waste recycling materials, such as waste paper, useless/rejected seeds of edible fruits and the like. The Spirit of Nagoya Protocol is being sacrificed in the ruthless claims and demands, without exemptions/exceptions. The definition of "Value added products" in the Act which reads as "value added products means products which may contain portions or extracts of plants and animals in unrecognizable and physically inseparable form" is clearly indicative of the fallacy and the legal lacuna in the NBA & Rules thereunder.

## PATENT ANECDOTES

In 1899, Mr. Charles H. Duell, Commissioner, U.S. Office of Patents was reportedly asked "What is the future of Patents?" after a lecture in his visit to UK.

The Commissioner replied, "Bleak because, everything that can be invented has been invented". Remember this was 1899. Today is 21<sup>st</sup> century, almost everything we use was invented after 1900.

After the first prototype of a 'computer' was presented to Thomas Watson, chairman of IBM for evaluation, he was asked for his views of the market potential for computers. He replied "I think there is a world market for maybe five computers."

### Section 4 of the Patents Act, 1970

Section 4 is an uneventful section in the Indian Patents Act, 1970. There may not be too many cases involving Section 4 in India. However, US is much more diligent regarding secrecy orders.

<https://www.bloomberg.com/news/articles/2016-06-08/congratulations-your-genius-patent-is-now-a-military-secret>

### Useful links for IP related learning:

WIPO: <http://www.wipo.int/portal/en/index.html>

Indian Patent Office: <http://www.ipindia.nic.in/>

Department of Industrial Policy and Promotion: <http://dipp.nic.in/English/default.aspx>

Spicy IP | De-Coding Indian Intellectual Property Law: <https://spicyip.com/>



# 125<sup>th</sup> Year of Madrid System

India has acceded to Madrid System for registration of Trademark in July, 2013. During 2016, WIPO has recently released the Year in Review as follows :

2016 marked the 125<sup>th</sup> anniversary of the Madrid System's founding treaty, the Madrid Agreement. As the end of this landmark year approaches, here's a look back at some of the Madrid System's most notable achievements.

Growing membership and commitment to accession by key trading markets

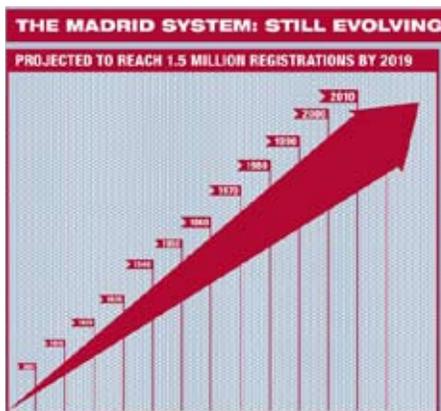
Since the signing of the Madrid Agreement (the Agreement), membership of the Madrid System has grown steadily. This year, the Registry welcomed Brunei Darussalam as its 98<sup>th</sup> member.

In November, Brazil's Minister of Industry, Foreign Trade and Services announced his nation's intention to join the Madrid System by mid-2018. In addition to Brazil, we expect numerous significant accessions in the coming years, including Canada, the remaining members of the Association of Southeast Asian Nations (ASEAN), as well as several African and Caribbean nations.

## Registration of mark number 1.3 million, record number of international applications filed

With membership on the rise, the number of international trademark registrations reached 1.3 million following the registration of SkinStudio, a skin care-related trademark by Singapore-based company Best World International Ltd.

By the end of November 2016, the Madrid System had welcomed over 9% more applications as compared to the same time last year, marking our seventh consecutive year of growth and a record number of applications filed. So far, the European Union is the top filer, followed by the United States and Germany.



(Image: WIPO)

## Madrid becomes a one-treaty system

In October, the Madrid Union Assembly moved to suspend the application of Articles 14(1) and (2)(a) of the Madrid Agreement, preventing any potential new members from acceding to the Agreement only.

From now on, all new members will be required to accede to the Madrid Protocol (or to both the Protocol and the Agreement), effectively making Madrid a single-treaty system with one unified set of rules. Users and Contracting Parties will continue to benefit from the Protocol's unique features and flexibility.

## Redesigned e-Services and new web content

The development of a comprehensive environment for interaction with IP offices and users remained at the forefront of our initiatives throughout 2016. To this end, we focused on the creation of several new online resources and the launch of e-Madrid, a System-wide initiative to deliver new and enhanced services to support users to obtain and manage international trademark registrations.

## Among the enhancements delivered this year were:

- an updated version of the Madrid Goods & Services Manager offering new functionality and content;
- an enriched Future Members Page with information to support countries considering accession to the Madrid System, including a model Road Map to accession and an Accession Kit;
- the launch of Madrid Monitor *beta* – an integrated online service which combines the functionalities of four popular tools into one simple and intuitive database; and
- a redesigned Madrid System homepage, with new “How To” guides delivering a wealth of information on how to file an international application and how to manage an International Registration.

## Looking ahead to 2017

With several countries on the pathway to accession, the Madrid System moves closer to the vision of its founding members and closer to becoming a truly global system for trademark registration. In the coming year, members and users can look forward to:

- ongoing development of the System's rules and regulations, including amendments to the Common Regulations;
- the launch of a new Madrid Member Profiles database, providing users with access to a wide range of key information on member IP offices, from contact information and fees, to opposition and review processes; and
- continued expansion of the Madrid System's online resources, including additional “how to” guides and video tutorials to support users throughout each stage of the lifecycle of their marks.

## OBITUARY



### Dr. B.N. Roy, (01-01- 1936 to 01-01- 2017)

Dr. B. N. Roy was like an IP/Patent Oasis in the pre-WTO/TRIPs times in India. Indian Pharmaceutical Industry was lacking professional expertise in IP/Patents with Industry experience. Dr. B.N. Roy contributed immensely through IDMA (Indian Drug Manufacturers' Association) in advising, guiding and policy planning on Uruguay Round, Patent Act Amendments, post-WTO/TRIPs and planning for the transition to product patent regime in 2005. He was also a Learned Faculty at IIPS (Institute of Intellectual Property Studies), Mumbai. Dr. B.N. Roy was associated with Lupin Ltd., as a Technical Advisor in Management of R&D, Generic Research & Intellectual Property. Prior to that, he was Director of ICI Corporate Research Centre. Dr. Roy passed away peacefully on the 1 st of January 2017 on his 81 st birthday.

## DIPP CALLS FOR FAST-TRACK COMMERCIAL COURTS

The industry department has asked the law ministry to bring an ordinance to allow the government to open fast-track commercial courts in Delhi and Mumbai to improve India's record in enforcing contracts

(<http://www.livemint.com/Politics/sPN2UErxLiGI6StvPRBxAM/Ease-of-doing-business-DIPP-calls-for-fasttrack-commercial.html>).

### CIPROM's Response/Representation



CIPROM/SK/489/2016-17

9<sup>th</sup> January 2017

To,

**Shri Rajiv Aggarwal**

Joint Secretary

Department of Industrial Policy & Promotion

Ministry Of Commerce And Industry

Udyog Bhawan, New Delhi

**Respected Sir,**

We, Centre for Intellectual Property Management (CIPROM), wholeheartedly support the proposal to open Fast Track Commercial Courts in Delhi and Mumbai for enforcing contracts and IPR cases.

Currently, due to a very strange nexus, financially weak (without deep pockets) Indian Companies, especially MSMEs are unable to finance litigations (mainly defensive) even the Indian Companies are non-infringing or non-violative of contracts and IPR. Therefore, the Indian Companies are avoiding protracted litigations imposed on them (even when they have a strong defense), by settling by surrender.

Establishment of Fast Track Courts for Contracts and IPR will help both parties, faster enforcement as well as lower litigation costs (by avoiding/eliminating protracted litigations).

This initiative by DIPP is welcome step for "ease of doing business" (as attached) and speedy resolution of enforcement litigations in contracts & IPR.

With best regards,

For **Centre for Intellectual Property Management**

**Dr.Gopakumar G. Nair**

Chairman

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In Draft-Drugs & Cosmetics Rules published as recommended by DTAB, published on 16<sup>th</sup> January 2017, the item No.8 (PATENT STATUS of the DRUG) in Paragraph 1 of Form 44 of Schedule A, is being omitted.

As such, reference to "Patent Status" in Form 44 is likely to get deleted.

This is in response to a long pending request and representation from the Indian Pharma Industry.