Centre for CIPROM intellectual property management

NEWSLETTER

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Intellectual Property advocacy in the fields of:

- IP Infrastructure
- IP Valuation
- M & A
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Wishing You
A Merry Christmas & A Happy New Year
From Ciprom, GNAs, GNANLEX LLP, Patent Gurukul

May the treasure and traditions of Christmas fill your heart with hope and happiness in the New Year

CURRENT STATUS OF IPAB

In response to a grievance-based query by Dr. Gopakumar G. Nair, the Government of India has issued a status Report. The Reply received from the Department for Promotion of Industry and Internal Trade (DPIIT), Ministry of Commerce and Industry is reproduced herein.

No. P-24017/163/2019-IPR-I
भारत सरकार / Government of India
वाणिज्य एवं उद्योग मन्त्रालय / Ministry of Commerce & Industry
उद्योग संवर्धन एवं आंतरिक व्यापार विभाग / Department for Promotion of Industry and Internal Tra
[आई.पी-आर-I अनुभाग / IPR - I Section]

उद्योग भवन, नई दिल्ली –110 0
Udyog Bhavan, New Delhi –110 0
दिनांक: 15th नवम्बर, 20

To,

M/s Gopakumar Nair Associates,
Patent and Trademark attorneys,
Shivmangal, 3rd Floor, Near Big bazar,
Akurli Road, Kandivli (East),
Mumbai – 400 101.

Sir,

I am directed to refer to your public grievance dated 09.10.2019 bearing registration numt PMOPG/D/2019/0379360 regarding appointment of Chairman, Vice-Chairman and Techni Members in Intellectual Property Appellate Board (IPAB), Chennai & regarding the location a website of IPAB and to say the concern raised by yourself has been taken note in this Department.

2. On the basis of queries raised in the said grievance vis-à-vis information available in tl Department, information is furnished below:

Sl. No	Grievance raised/ suggestion given by applicant	Reply on the basis of DPIIT
1	urgent steps to appoint Chairman, Vice-Chairman and Technical Members of IPAB should be taken to make IPAB functional at the earliest.	Steps taken to fill the post of Chairman IPAB: Section 85 (6) of the Trade Marks Act, 1999 provides that "No appointment of a person as the Chairperson shall be made except after consultation with the Chief Justice of India." Hon'ble Justice (Retd.) Manmohan Singh, vacated the office of Chairperson IPAB on 21.09.2019 on attaining the age of superannuation. In anticipation of the vacancy, a request had been made to the Secretary General, Supreme Court of India vide letter dated 04.04.2019 seeking the recommendations of Hon'ble Chief Justice of India for nominating a suitable person for appointment as the Chairperson IPAB. A reminder has been sent on 16.07.2019. Thereafter the Secretary General, Supreme Court of India has again been requested vide DO letters dated 09.09.2019 and 18.10.2019.
		Steps taken to fill the post of Vice-Chairman IPAB: The matter for appointment of Vice-Chairman IPAB was referred to Department of Legal Affairs seeking comments. The Department of Legal Affairs suggested to advertise the post in view of Article 14 and Article 16 of the Constitution of India. The post has been advertised in 19.10.2019 edition of Employment news. Steps taken to fill the post of Technical Members IPAB: The vacancies were advertised on 28.07.2018 to 03.08.2018 edition of the Employment News. The Department has, in response to the said advertisement, received a number of applications to the vacant posts. The Search-cum-Selection Committee (SCSC) constituted for the appointments has conducted the interviews on 31.08.2019. The recommendations of SCSC are under consideration with the Competent Authority.
2.	IPAB should have a new operational website, the current website of IPAB has become non functional.	The National Informatics Centre (NIC) has already started to develop new website of IPAB. The domain name has also been re-registered.
3.	The IPAB should have been located (Headquarters) at Delhi or Mumbai, instead of Chennai.	The suggestion has been noted.

Yours faithfully,

[Rajesh Ranjan]
Under Secretary to the Govt. of India

Tel No. 2306 3651

Copy to :

PR&C Section, DPIIT w.r.t. PMOPG/D/2019/0379360 dated 09.10.2019.

The **Spicy IP Report** dated November 24, 2019 discusses the **Supreme Court Judgement on Validity of the Appellate Tribunal.**

https://spicyip.com/2019/11/supreme-court-strikes-down-tribunal-rules-trade-marks-act-to-govern-ipab-appointments-again-till-new-rules-are-framed.html

"The Judgement states that the Appellate Tribunal to be formed under the Trade Marks Act remains valid. Further, it states that the Qualification of the Technical members for patents has been specified under the Patents Act [Section 116(2)].

As stated in the Report, "In fact, a recent response received from the DPIIT to a representation made by **Dr. Gopakumar Nair** as regards appointment to IPAB offers very little hope. In its response to the representation – made to enquire the undue delay in appointment of IPAB members – DIPP has informed of the steps that have been taken to fill up the positions to IPAB. While the appointment of the Chairperson has been held up at Supreme Court's end for several months now, the vacancy for the Vice-Chairman was re-advertised only last month and the appointment of Technical Members is pending with the Competent Authority that's considering the recommendations of the Search-cum-Selection Committee."

The Department for Promotion of Industry and Internal Trade (DPIIT), Ministry of Commerce and Industry has published a new Manual of Patent Office Practice and Procedure on 26th day of November, 2019 in supersession of earlier Manual of Patent Office Practice and Procedure published on 22nd day of March, 2011. The new Manual is being implemented with immediate effect for effecting/implementing re-engineered processes as a result of IT automation and amendments in the Patents Rules, 2003.

The new Manual of Patent Office Practice and Procedure is available on:

http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/Manual_for_Patent_Office_Practice_and_Procedure_.pdf

Patent Prosecution Highway

The Notice issued by Press Information Bureau, India, Government of India, on Patent Prosecution Highway is reproduced herein below.

"The Indian Cabinet of Ministers has approved the proposal for adoption of Patent Prosecution Highway (PPH) programme by the Indian Patent Office (IPO) under the Controller General of Patents, Designs & Trade Marks, India (CGPDTM) with patent offices of various other interest countries or regions.The said programme will initially commence between Japan Patent Office (JPO) and Indian Patent Office on pilot basis for a period of three years only. Under this Pilot programme, Indian Patent Office may receive patent applications in certain

specified technical fields only, namely, Electrical, Electronics, Computer Science, Information Technology, Physics, Civil, Mechanical, Textiles, Automobiles and Metallurgy while JPO may receive applications in all fields of technology.

What is Patent Prosecution Highway (PPH)?

With the growth of globalization around the world, there has been a drastic upsurge in the number of patent applications filed in numerous fields and sectors of a vast variety of industries. On witnessing the increase in number of the patent applications, the Patent Offices all over the world are trying to cooperate and function in a unified manner to ease the workload. As a consequence of the backlog of the patent applications, such cooperation was essential, and this gave an impetus for the introduction of the *Patent Prosecution Highway (PPH).*

The PPH is an initiative to provide an accelerated patent prosecution procedure between the participating intellectual property offices. The primary objective is to expedite the patent prosecution procedures, with the goal of reducing the effort of examinations and searches conducted for the same patents, filed in multiple countries. The participating intellectual property offices have agreed that when the applicant receives a final ruling from the first patent office that at least one claim is allowed, the applicant may request a fast track examination of corresponding claim(s) in a corresponding patent application that is pending in a second patent office.

The PPH was introduced on a trial basis in July 2006 between the U.S Patent and Trade Mark Office (USPTO) and the Japan Patent Office (JPO). On success of this pilot program, the establishment of the PPH was fully implemented between the two nations in January 2009. Reflecting the same, as stated above, the IPO has extended its first PPH program to the Japanese Patent Office (JPO) on a pilot basisin certain identified fields of inventions for the first quarter of fiscal year 2019.

The new rules under the Patents Rules, 2003 permit the Indian Patent Office (IPO) to enter into agreements with other participating patent offices to allow the examiners of one patent office to rely upon the search and examination results already conducted by another patent office.Thus, the participating patent office benefits from the work previously done by the other patent office, with the goal of reducing examination workload and improving patent quality.

On 29th November 2019, the Indian Patent office published the PPH Procedure Guidelines to file a PPH request under the Patent Prosecution Highway Pilot Program between the Indian Patent Office (IPO) and the Japan Patent Office (JPO).The guidelines are available on:
http://www.ipindia.nic.in/writereaddata/Portal/News/591_1_PPH_Procedure_Guideline_combined_20191128_final.pdf

DR. GOPAKUMAR. G. NAIR ADDRESSING THE AUDIENCE AT THE 4TH ANNUAL INTERNATIONAL CONFERENCE ON IPR AT GOA COLLEGE OF PHARMACY ON 11TH–12TH NOVEMBER 2019.

The 'Mumbai' Team of GNA Group