

# Suggestions/Comments on Manual of Patent Office Practice and Procedure

Submitted by

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## **Background**

The Office of the Controller General of Patents, Designs, and Trademarks (hereinafter referred to as “CGPDTM” or “IP Office”) issued a notification calling for comments and suggestions on existing intellectual property (IP) manuals and Guidelines on August 20, 2023. In furtherance of the said notification, patent attorneys at BananaIP Counsels (“BananaIP”) are hereby submitting their views and suggestions with respect to the Manual of Patent Office Practice and Procedure (“Manual”) for the CGPDTM’s consideration.

These comments, suggestions, and opinions with respect to the Manual of Patents have been submitted with the bonafide and honest intent of aiding the Office of Controller General of Patents, Designs, and Trademarks improve the Manuals, and make the IP process more transparent, accessible, certain, and efficient.

The comments and suggestions in this document are divided into five (5) parts. They are:

- I. Clarity on AI Inventorship
- II. Accessibility of the IP Process/Systems to Persons with Disabilities
- III. Examination Process
- IV. Hearings and Objections
- V. Opposition Process

## **Comments and Suggestions**

### **I. Clarity on AI Inventorship**

In the context of recent debates about whether AI qualifies as an inventor under the Patents Act, 1970, as last amended, it will be helpful if the Manual of Patent Office Practice and Procedure (“Manual”) can provide clarity on this question. Based on provisions of patent statute, patent procedure, Court Judgments, and legislative history, the following conclusions may be drawn:

- a. The objective of the patent system is to incentivize human ingenuity and creativity;
- b. Sections 6 and 7 of the Patents Act require an applicant to be a true and first inventor, who can voluntarily transfer rights, has a limited life period that ends

when she/he is deceased, and can affix signatures on relevant forms. All of these are possible only if the inventor is a human being.

- c. The tests for patentability includes persons with ordinary skill, or skill in the art, and human intervention, which indicate that patentability of inventions is verified based on human related benchmarks.
- d. Courts have consistently held that the objective of patent law in India is to encourage inventive activity and ingenuity of human beings.

Suggestion: Based on the aforesaid, it would be helpful if the Manual can clearly state that only human beings qualify as true and first inventors under Section 6 of the Patents Act.

## **II. Accessibility of the IP Process/Systems to Persons with Disabilities**

Owing to the advantages offered by the IP profession that makes it possible for persons with disabilities to practise independently, and earn a dignified livelihood, the number of IP attorneys and agents with disabilities is increasing. Additionally, many persons with disabilities are not only inventors and creators, but also use the website and the online systems of the IP Office for scientific, technical, business, and other information. To facilitate accessibility of information, systems, and the IP process, the IP Office has taken the much-needed step of issuing Guidelines for Accessibility and Reasonable Accommodations in March, 2022. However, many officers in the IP Office are not aware of these guidelines, and the need to facilitate accessibility and reasonable accommodations. To address this issue, and to integrate accessibility into IP processes and systems, a section on accessibility may be included in the Manual of patents and other forms of IP.

Suggestion:

The following para may be considered for inclusion in the Manual:

“Accessibility to Persons with Disabilities

The IP Office recognizes the need to facilitate accessibility of its website, processes, and systems to persons with disabilities, and is committed to taking accessibility steps and providing reasonable accommodations. Towards this end, the Office of CGPDTM has

issued 'Guidelines for Accessibility and Reasonable Accommodations on 4<sup>th</sup> March 2022.

To implement the same, all controllers, examiners, and other officers shall:

- i. Provide the requisite accessibility measures and reasonable accommodations as stated in the guidelines for accessibility and reasonable accommodations, and as required under the Rights of Persons with Disabilities Act, 2016, and rules/guidelines framed thereunder;
- ii. Provide the reasonable accommodations recommended by the nodal officer appointed to address accessibility issues of persons with disabilities.
- iii. Acknowledge communications from persons with disabilities relating to accessibility within twenty-four (24) hours, and confirm if a requested accessibility measure and/or accommodation will be provided or not;
- iv. Give reasons in writing if a requested/recommended accessibility measure or accommodation cannot be provided without undue delay, and bearing in mind the statutory timelines applicable for a given case/file; and
- v. Not require the person with a disability to pay fee for processing an accessibility request, or to provide a reasonable accommodation such as adjournment or time extension to address accessibility issues."

### **III. Examination Process**

While the examination process has significantly improved over the years, certain issues with the process continue to subsist. Some of these issues are responsible for delays in processing patent applications. Two issues that have been highlighted by the Courts also are:

- a. Lack of analysis while raising objections based on statutory provisions and/or prior art references, which leave patent applicants guessing what the examiner meant; and
- b. Raising new objections following the first statement of objections without issuing an examination report.

The first issue makes it difficult for applicants to address and resolve objections effectively, and the second issue gives rise to issues relating to fairness and natural

justice. These concerns have also been highlighted by the Courts on different occasions.

Suggestion: The IP Office may consider including specific guidelines with respect to the approach, format, and analysis of statutory provisions and prior art that may form part of examination reports. The guidelines may also include specific and clear guidance on the mechanism to be adopted for raising new objections to reinitiate the examination process with requisite opportunities afforded to the applicant to respond to the same. In line with statutory provisions, the Manual may also provide for a bar on new objections at stages after the first examination report such as hearing without issuance of a subsequent examination report.

#### **IV. Hearings and Objections**

Over the years, the hearing system of the IP Office has been streamlined, and online hearings have become transparent and well organized. However, certain procedural and substantive issues with respect to hearings continue to subsist and addressing them will help in making the process effective, efficient, and legally compliant. Some of the hearing issues being faced by patent agents/attorneys and applicants include:

- a. Raising of new objections and/or prior art in the hearing notice, or during the hearing;
- b. Lack of a timeline for issuance of orders following hearings; and
- c. Lack of process clarity with respect to formal adjournment filings, and non-attendance of hearing officers at scheduled hearings.

Suggestion: The IP Office may consider incorporating guidelines with respect to hearing notices and conducting of hearings in the Manual. The guidelines may clearly state that it is not permitted to cite new prior arts or new objections at the hearing stage. This will enable compliance with statutory and natural justice requirements and will also bring about predictability and certainty to the hearing process.

Additionally, the IP Office may also consider incorporating specific timelines for issuance of orders following hearings within the Manual. Furthermore, the IP Office may also include clear protocols with respect to adjournment requests and related decisions, and the process with respect to hearings missed by hearing officers or attorneys.

## V. Opposition Process

The opposition process is well defined and laid out in the Manual and is generally conducted in an organized manner. However, there is lack of clarity and transparency with respect to certain matters that form part of opposition.

- a. The order constituting the opposition board is not published, which makes it impossible for the patentee as well as the opponent to learn about the members of the board until a report is given;
- b. There is no guidance on how the opposition board members will be picked, and whether they are expected to have a good understanding of applicable patent provisions and the technology to which the invention relates; and
- c. Opposition proceedings are currently not conducted in a time driven manner.

Addressing the afore-mentioned issues can help in making the process transparent, in improving quality, certainty and predictability of the process, and in ensuring that applicable law is duly followed.

Suggestion: The IP Office may consider providing guidance on how members of the opposition board must be selected in the Manual. The Manual may clearly state that the order constituting the opposition board shall be made available to the parties and also published online as a part of the prosecution history. Furthermore, specific guidance may be included in the Manual with respect to timelines within which Controllers are required to complete opposition proceedings.

**Disclaimer:**

The comments, suggestions, and opinions provided in this document are based on the experience and understanding of patent attorneys at BananaIP counsels. They may not be considered as generalization of any particular aspect or matter addressed in this document. It is understood that attorneys and experts within and outside BananaIP may have differing opinions, and that the suggestions provided are not the only ways of resolving issues expounded in the document.

The views expressed in this document do not reflect the views of the BananaIP's clients.

**About BananaIP:**

BananaIP's Attorneys have been filing & prosecuting patent applications over the last 20 years. The comments in this document are based on their experience in the field, ongoing research activities, and expertise in Patent Law.

**Contact information:**

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