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Patent Prosecution Highway

特許審査ハイウェイ

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About Us

S.S. Rana & Co., established in 1989, is a leading full-service IP & Corporate Law Firm with a well-established and highly recognized Intellectual Property Law practice in India. Over the last 31 years the firm has been recognized for its reliable, trustworthy and proactive legal advice. The firm represents clients for IP, Litigation and Corporate & Commercial Law matters in not just in India but also in the SAARC Region as well as worldwide.

Team Strength : 170+ Advocates, Patent Attorneys, Patent Agents & Engineers, Paralegals etc.

Clients : 1600+ worldwide

Fortune 500, Multinational & Indian Companies



Practice Area:

- Trademark
- Patent
- Design
- Copyright
- Intellectual Property Laws
- IP Litigation
- Commercial Litigation
- Corporate & Commercial Laws
- Arbitration & Disputes Resolution

Industries Covered:

- Aviation
- Automobile
- Bio Medical
- Pharmaceutical
- Pharmaceutical
- Consumer Goods
- Real Estate
- IT & Technology
- Media & Entertainment
- E-commerce
- Heavy Machinery
- Electronics & Communication
- Sports & Gaming
- Mobile Computing & IOT
- Hospitality
- FMCG
- Luxury Goods Industry
- Education
- Freight and Shipping
- Banking & Insurance, etc.

IP Facilitator: Managing Partner **Mr. Vikrant Rana** is registered as an **IP Facilitator** with the Indian Patent Office and has assisted several Start-ups for filing and prosecuting their IP rights in India and worldwide.

Quality certifications:



Empanelment: Technical Universities, Design Institutes, Government & Private Institutions, Innovation Foundations -As advisors for IP Matters including Patents, Trademarks, Copyrights and Designs.

IIT Delhi IIIT Jabalpur NIF Ahmedabad DIT Dehradun Good Food Institute

Trends of IP filings in INDIA

Application	2014-15	2015-16	2016-17	2017-18	2018-19
Patent	42,763	46,904	45,444	47,854	50,659
Design	9,327	11,108	10,213	11,837	12,585
Trade mark	2,10,501	2,83,060	2,78,170	2,72,974	3,23,798
Geographical Indication	47	14	32	38	32
Copyrights	Copyright administration shifted to DIPP/ CGPDTM in 2016-17		16,617	17,841	18,250
Semiconductor Integrated Layout Designs (SCILD)	SCILD administration shifted to DIPP/ CGPDTM in 2016-17		NIL	02	NIL
Total	2,62,638	3,55,898	3,50,467	3,50,546	4,05,324

Trends of IP filings by Japanese entity INDIA –

IP Filings by Japan in India

Japan's contribution in bolstering India's IP regime is reflected in the latest IP Annual Report (2019-19)

- Patents: Japan was the amongst the top 5 PCT National Phase Applications filing Countries. It was the 2nd largest filer with 3,607 applications, right after USA (8,199). Additionally, three of Japanese business entities, Honda Motor Co (7) , TOYOTA JIDOSHA KABUSHIKI KAISHA (8) , Mitsubishi Electric Corporation (09) amongst the top 10 Foreign Resident Applicants.
- Trademark: Japan is amongst the top 10 International Trademark Fillers in India. As per the report, out of total 323798 applications filed, the number of applications filed by foreign applicants during the year was 13682. Out of the total applications filed United States of America filed 4204, China 2716, United Kingdom 669 and Japan 517.
- Design: In the sector of registered designs originating from abroad, Japan 3rd largest filer with 421 applications and Honda Motor Co. Ltd (37) is amongst the leading foreign companies those filed applications.

Patent Prosecution Highway (PPH)

Amendments in Indian Patents Rules

As per Patents (Amendment) Rule, 2019, which came into effect on 18th of September 2019, Rule 24C of the Indian Patents Rules has been amended to include following clause as one of the criteria for expedited examination:

(j) that the applicant is eligible under an arrangement for processing a patent application pursuant to an agreement between Indian Patent Office and a foreign Patent Office.

Explanation:- The patentability of patent applications filed under clause (j) above will be in accordance with the relevant provisions of the Act.

Overview

Commencement

The Bilateral Patent Prosecution Highway (PPH) program between Indian Patent Office (IPO) and Japanese Patent Office (JPO) commenced on November 21, 2019.

Duration

It is a pilot project for a period of 3 years and patent offices started accepting PPH requests on December 5, 2019.

Request Limit

The number of requests for PPH in each office was limited to 100 cases per year. The office notifies the other office via email as soon as the number of PPH requests reaches 100 cases and the same may be notified on the official websites of the offices.

Current Status

IPO - As on 8th July 2021, total numbers of PPH requests received by IPO is 66 out of 100.

Overview

Technical Fields

IPO - Electrical, Electronics, Computer Science, Information Technology, Physics, Civil, Mechanical, Textiles, Automobiles and Metallurgy.

JPO – All fields

Request Limit (per applicant)

IPO - An applicant who has filed a patent application, either alone or jointly with any other applicant, shall not file more than 10 PPH requests per year.

JPO - No limit on the maximum number of applications from a single applicant

Documents Required (IPO as OLE)

- (a) Copies of all office actions issued by OEE (which are relevant to substantial examination for patentability in the OEE), translations and a self-certification of the translations.
- (b) Copies of all claims determined to be patentable/allowable by the OEE and translations of them and a self-certification of the translations.
- (c) Copies of references cited by the OEE examiner: Patent documents – to be submitted at examiner’s request when OLE does not possess the said patent document; Non-patent literature - must always be submitted.
- (d) Claim correspondence table - The applicant requesting PPH must submit the claim correspondence table in the prescribed Form, which indicates how all claims in the OLE application sufficiently correspond to the patentable/allowable claims in the OEE application.

OLE - Office of Later Examination with which applicants file a PPH request

OEE - Office of Early Examination which determines patentability of claims of an application before the OLE

Common Requirement

- The decision regarding patentability of a patent application under PPH program will be governed by the respective domestic laws and regulations applicable to the office concerned.
- Request for PPH can be requested if the substantive examination of the OLE application for which participation in the PPH is requested has not begun.
- Claims on file (originally or amended) of OLE, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable/patentable in the OEE.
- The OLE decides whether the application can be entitled to the status for an expedited examination under the PPH when it receives a request with the documents stated above.
- When the OLE decides that the request is acceptable, the application is assigned a special status for an expedited examination under the PPH.

Steps to be followed – Indian Patent Office (IPO)

Request for special status

- The Applicant is required to file a request for assigning special status for expedited examination in under the PPH.

Scrutiny of Request

- After scrutiny of such request, the IPO will assign a special status for expedited examination in India.

Rectification of Defects

- In case of any defect found in said request, the Applicant will be provided opportunity to rectify the defects by submitting necessary documents within 30 days from the date of notification by the IPO.

Decision - acceptance or rejection

- The IPO will consider the documents submitted and decide whether the defects are corrected or not. The decision on acceptance or rejection shall be communicated through email as well as message on e-filing portal.

Steps to be followed – Indian Patent Office (IPO)

Request for expedited examination

- After the request for assigning special status for expedited examination under PPH is accepted by the IPO, the applicant can file request for expedited examination on Form 18A.

Request for Publication (if required)

- Except where the application is already published or a request for publication has already been filed, a Form 18A shall be accompanied by a request for publication on Form 9.

Deadline

- Form 18A shall be filed within 48 months from the date of priority of the application or from the date of filing of the application, whichever is earlier.

Filing manner and fee

- Form 18A shall be submitted by electronic transmission along with fee as prescribed under the amended Indian Patent Rules.

PPH filed by us

PPH request filing date

- December 05, 2019

Assignment of special status by the IPO under PPH

- December 18, 2019

Request for expedited examination filed on Form-18A

- December 26, 2019

First Examination Report received date

- January 30, 2020

Response to First Examination Report filed with the Indian Patent Office

- March 31, 2020

Grant received

- July 31, 2020

COMMERCIAL WORKING STATEMENT

(Form 27)

WHY COMMERCIAL WORKING ??

According to Section 84 (1) of the Indian Patents Act,

- at any time after **three years** after the grant of a patent,
- any person interested may apply to the Controller for a compulsory license on the patent on grounds that, inter alia,
- the **reasonable requirements** of the public with respect to the patented invention **have not been satisfied**
- or the patented invention is **not available to the public** at reasonably affordable price, or
- the patented invention is **not worked in the territory of India.**

Amended Rule 131(2)

- “*The statements referred to in sub-rule (1) shall be furnished once in respect of every financial year, starting from the financial year commencing immediately after the financial year in which the patent was granted, and shall be furnished within six months from the expiry of each such financial year.*”

Target Year

- Before Amendment - previous calendar year
- After Amendment - previous **financial year**

Deadline

- Before Amendment - within 3 months of the end of each calendar year : due date was 31st March
- After Amendment - within **6 months** from the expiry of each financial year : due date is 30th September

Related Patents

- A **single Form 27** can now be filed for related patents (all belonging to a **single patentee**), wherein the approximate revenue/value accrued from a particular patented invention cannot be derived separately from the approximate revenue/value accrued from related patents

Revenue Value Details

- Before Amendment - exact amount of revenue/value accrued was required
- After Amendment - previous financial year **approximate value** is sufficient

License Details

- Details of licenses and sub-licenses granted -
 - Before Amendment - required to be submitted
 - After Amendment - **not required**

Public Requirement

- Before Amendment – required to submit public requirement met “partly/adequately/to the fullest extent” or not
- After Amendment - **not required**

Import Details

- Country wise details of import -
 - Before Amendment - required to be submitted
 - After Amendment - **not required**

ABOLITION OF INTELLECTUAL PROPERTY APPELLATE BOARD (IPAB)

- The Intellectual Property Appellate Board (IPAB), which possessed the power to hear appeals against decisions of the Controller General of Patents, has been dissolved with effect from April 04, 2021.
- Now the word 'Appellate Board' in all the IP Acts including in Section 117-A of the Patents Act, has been substituted with the word 'High Court'.

- All proceedings which were pending with the IPAB shall be transferred to the Court before which it would have been filed had this Ordinance been in force on the date of filing of such appeal or application. Thus, the functions of the IPAB have been transferred to the appropriate High Courts.
- Any appeal against the decisions of the Controller of Patents shall now be made before the concerned High Court within three months from the date of the decision, order or direction.

- On July 06, 2021, the Hon'ble Delhi High Court had issued a press release, inter alia announcing their directive to **create an Intellectual Property Division (IPD) in the Delhi High Court** for the purpose of avoiding multiplicity of proceedings and to avoid possibility of conflicting decisions with respect to same trademarks, patents, designs, etc.

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Thank You !

Vikrant Rana
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Intellectual Property
Practice



Thank you

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