

Interview No.13

The patent systems are thus different between India and Japan (2)

Deadlines on the examination side are set by law

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Deadlines on the examination side are set by law or the Japanese companies to survive, it is no longer avoidable to advance into developing countries. Especially India, as well as China, is highly likely to become an important industrial stronghold. However, the Indian patent system that is essential to protect and exploit intellectual property rights in India is not so well known in Japan. Mr. Vinit Bapat, an Indian Patent Attorney who is familiar with patent affairs in India, Japan and the United States, and Mr. Masakazu Ito, a Patent Attorney and the President of Miyoshi & Miyoshi, talked about differences between the Indian and Japanese patent systems.

Attendees:

Mr. Vinit Bapat, Indian Patent Attorney, Representative Director of Sangam IP; and
Mr. Masakazu Ito, Patent Attorney, President of Miyoshi & Miyoshi.

Ito: Would you teach me about procedures after filing an application in India?

Bapat: Firstly, in India, a patent application will be laid open 18 months after the priority date or the filing date in India.

Ito: That's the same as in Japan.

Bapat: In India, as in Japan, there is an examination system. An application is deemed to be abandoned unless an examination is requested. When a request for examination is filed, a process of examination is started regardless of whether the application is laid open or not. A patent administrator appoints an examiner within one month from the request for examination. Then, the examiner delivers an official action such as a notice of reasons for rejection to the patent administrator within one month at the earliest and within 3 months at the latest. Up to this stage, it will take 3 to 5 months in total.

Ito: In Japan, too, there is no relation between the timings of public disclosure and start of examination.

Bapat: And the application must be brought in a patentable condition within 12 months from the time when the first notice of reasons for rejection reached the applicant. If not, the

application is deemed to be abandoned. Therefore, during this period, the applicant should file an amendment and an argument in response to the rejection.

Ito: There is no deadline such as to respond within 60 days from the receipt of an official action as in Japan, is there?

Bapat: No, there isn't.

Ito: However, if it took 6 months for the applicant to respond, there remain only 6 months.

Bapat: So, if it took 4 to 5 months for the patent administrator to deliver the second notice, there remains only one month, but it is necessary to respond so as to maintain the application. If only a response is filed (if necessary, by convincing the examiner at a hearing), "the application will be brought to a patentable condition."

Ito: Is it just as the applicant is driven to a critical moment?

Bapat: There is another rule in India. If an examination result is not favorable to the applicant, the patent administrator must give the applicant an opportunity to have a hearing. Then, the agent, and in some cases, the applicant, too, attend a conference with the patent administrator and the examiner in charge of the case. The agent or the applicant argues like "Why do you reject?" or, in some cases, there is such a remark as: "I'll come back, so please give me time to consider." If the applicant fails to visit again, the case is deemed to be withdrawn.

Ito: In what cases are applications rejected?

Bapat: Basically, for such reasons as non-patentable grounds, lack of novelty or inventive step. At the hearing, the case is sometimes approved depending on an amendment. So, it is close to an interview with the examiner. The difference is: the interview with the examiner can be made over the telephone, while the hearing requires you to go in person to the Patent Office by taking formal and open procedures. The agent and, if necessary, the applicant are present together with the patent administrator and the examiner in charge of the case. Is there such a procedure in Japan?

Ito: No, there isn't. It sounds like similar to a hearing in Europe, doesn't it? What is on my mind is the 12-month term. Such a rule does not exist in Japan.

Bapat: In Japan, also, a term is specified from the receipt of a notice of reasons for rejection to filing of a response, right?

Ito: In Japan, it is 60 days. After that, though it is not determined how many days the examiner should take for examination, it may take 60 days more or less. In Japan, there are deadlines for an applicant's procedures, but no deadline is set for an examiner.

Bapat: On the contrary, in India, there are deadlines on the patent office side, too. The term of 3 to 5 months corresponds to it. This is determined by the law.

Ito: It is rare in the world, isn't it?

Bapat: If there is no reply from the Patent Office even after 5 months passed, the applicant could urge the examiner, saying "What has become of the next action?" You said the "12 months" is on your mind. Thinking about this, Japanese law seems more severe to me. How is it, for example, in the United States? It takes basically 3 months by the time the first notice of rejection issues, and a response can be extended for 6 months at the maximum. In case the applicant responded in one month upon receipt of a notice, already 7 months have elapsed. As it takes further 6 months until the next notice comes, it is about 12 months, so it is about the same as in India.

Ito: I am afraid it is scarce even all over the world that an examination process will finish in 12 months.

Bapat: I said that in India it is determined to be 5 months by law, but actually it is not carried out like that. Now there are about 80 examiners in India, but they will be further increased by 250 persons.



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