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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PCT COMMITTEE FOR TECHNICAL COOPERATION

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APPOINTMENT OF THE INDIAN PATENT OFFICE AS AN INTERNATIONAL
SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Document prepared by the International Bureau

1. The appointment of International Searching Authorities (ISAs) and International Preliminary Examining Authorities (IPEAs) under the Patent Cooperation Treaty (PCT) is a matter for the Assembly of the PCT Union and is governed by Articles 16(3) and 32(3) of the PCT. The detailed requirements which must be satisfied by an Office in order to be appointed as an International Authority are described in paragraphs 4 and 5 of document PCT/CTC/23/2.
2. In a letter dated August 20, 2007, the text of which appears in the Appendix, the Government of India requested that the Indian Patent Office (IPO) be appointed as an ISA and IPEA and supplied supporting documentation: Annex I (of the Appendix) contains a general presentation; Annex II lists the examination resources of the IPO; and Annex III lists the search documentation used by the IPO.

3. Articles 16(3)(e) and 32(3) of the PCT require that, before the Assembly makes a decision on such an appointment, it shall seek the advice of the PCT Committee for Technical Cooperation. The Committee's advice, which is sought by the present document, will be submitted to the Assembly during its 36th session, which is being held during the same period as the session of the Committee.

4. *The Committee is invited to give its advice on this matter.*

[Appendix follows]

APPENDIX

LETTER FROM THE GOVERNMENT OF INDIA TO THE DIRECTOR GENERAL

“Ajay Shankar
“Secretary to Government of India

“Deptt. of Industrial Policy and Promotion
“Ministry of Commerce & Industry
“Udyog Bhawan, New Delhi – 110 011

“D.O.No.8/10/2007 – IPR-III

“20th August 2007

“Excellency,

“It is with pleasure that I convey to you India’s intention of gaining recognition as an International Searching Authority (ISA) and an International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT) of the World Intellectual Property Organization (WIPO). In order to facilitate this process, kindly find enclosed the requisite information. It would be appreciated if this matter is placed on the agenda of the PCT Assembly scheduled to be held in conjunction with the 43rd series of meetings of the Assemblies of Member States of WIPO in September-October 2007.

“Accept, Excellency, the assurances of my highest consideration.

“Yours sincerely,

[signed]

“(Ajay Shankar)”

[Annex I follows]

ANNEX I

PRESENTATION OF THE INDIAN PATENT OFFICE

Aim of the Indian Patent Office (IPO)

Statistical evidence shows a clear correlation between the innovative performance of a country and the quality of the local framework conditions for protection of innovation in that country. The recent modernisation activities undertaken by IPO aims at strengthening of the search capabilities, maintaining and improving search tools with overall objective for improving the efficiency and coherence of the Indian patent system.

The strengthening of patent system contributes to stimulating Indian companies, in particular small and medium-sized enterprises, to innovation and contributes in economic growth through addition of new innovative product in the market. National patent office being a hub for IP activity need to emerge as competent centres for industrial property rights, capable of offering customized services of quality and efficiency, which is competitive by international standards.

Another objective of IPO is to support the global development and usefulness of the PCT system by adding further competent resources to those presently available.

Organisation of IPO

IPO propose to make available space and infrastructure necessary for efficient functioning of ISA and IPEA. It is proposed to appoint Director for International Searching Authority in Delhi who will be supported by one Assistant Director, ISA and one Assistant Director, IPEA. These appointments will be made from the existing Controllers in the Patent Offices. For search and substantive examination, the resources will be the examiners of the patent office. The Director will be supervised by the Controller General of Patents, Designs and Trademarks (CGPDTM).

Director, ISA and IPEA, will be responsible for distributing search and examination tasks between the examiners of the patent offices in such a way that work will be performed by an examiner having the necessary competencies.

IPO will have an International Secretariat under the Director, which will be the interface to all external parties, including the International Bureau of WIPO and the Receiving Offices of the patent offices. The tasks of the International Secretariat will be performed by the staff of the Receiving Offices acting under full instructions of Director.

Use of IPO as a PCT authority will initially be open to applicants and residents of India who, however, will still have the option of choosing any other PCT authority and may be open to other States in due course as the Authority gains experience and capacity.

Quality Assurance

ISA and IPEA will establish a Quality Assurance system, which will be certified according to ISO 9001. The system will cover all services offered by IPO.

The Indian Patent Office already have well established quality assurance systems under the supervision of Controller General of Patents, Designs and Trade Marks covering the patent granting procedures. The patent system complies with the provisions on quality assurance in the PCT International Search and Preliminary Examination Guidelines (PCT/GL/ISPE).

The ISA and IPEA quality assurance system will be based on the national systems but will obviously have to be extended to cover the full PCT procedure. The quality standards and practices will be harmonised for all PCT work and brought in full compliance with the standards and practices established by the PCT. The IPO have, for many years, co-operated on harmonisation of patent practice and bench marking of the patent granting procedure including search and examination procedures and tools. This co-operation will be further strengthened as part of the IPO cooperation.

The competence and number of examiners is an important aspect of quality. The PCT minimum requirements are fully met in this respect. This is dealt with separately in Annex II.

Another aspect of quality is the access to the PCT minimum documentation. To the best of our knowledge, these minimum requirements are also met by IPO. Any possible gaps that might be identified will be rectified before IPO will start operation as a PCT authority. Further details can be found in Annex III.

[Annex II follows]

ANNEX II

EXAMINATION RESOURCES OF THE INDIAN PATENT OFFICE

1. INTRODUCTION

Search and Preliminary examination of PCT applications will be carried out by Examiners of the Indian patent offices on behalf of ISA and IPEA. Information contained in the present Annex concerning examiner resources will therefore generally refer to the examiner resources of the patent offices.

The Patent offices in India have for many years pursued a strategy of performing search and examination of a quality, which matches international standards. The Indian Patent Offices have a long-standing tradition of ensuring highly competent and motivated staff as well as the best possible search and examination tools, comprehensive search material and general quality assurance.

2. EXAMINER RESOURCES

Presently, the Indian Patent Office has 135 examiners and plans for recruitment of 100 more examiners in the 2007-08. These examiners are employed on a full-time basis and are predominantly occupied with search and examination. The examiners have a university degree in technology or natural science, law and in some cases further postgraduate degrees such, PhD or equivalent. The examining divisions of patent office comprise examiners in the fields of Electricity & Physics, Machinery, Biotechnology, and Organic Chemistry, Industrial Chemistry, and Construction and Foodstuff & Healthcare.

3. COMPETENCE OF EXAMINERS

The examiners are all experts in their own branch of technology and allocated to specific technical areas. A large number of the examiners also have many years of experience in the patent field. The density of examiner competencies within the various technical disciplines obviously reflects the structure of national industry. In general, patent offices have more than adequate coverage of all technical fields. All examiners have excellent knowledge of English language. In addition they are well versed in Hindi and other languages such as Tamil and Bengali.

4. PROCESSING OF PATENT APPLICATIONS AND OTHER WORK

The Patent Office receives about 25,000 first national filings per year. Close to thirty percent of the Indian applications, however, are filed in order to obtain a priority date and are not carried on to full examination.

The high number of first filings at the Patent Office despite the possibility of using the International Bureau (IB) route signifies a trust in the quality of services delivered by the IPO.

5. TRAINING AND JOB DESCRIPTION

New examiners are trained and supervised by a senior examiner. Initially, the Controller keeps supervision on the work of the new examiner and is responsible for all decisions taken by the new examiner during the processing of an application. The new examiner also takes up in-house training for two week organised by Intellectual Property Training Institute at Nagpur. This training provides better understanding to the examiner on procedure and legal aspects of patent law. This training also enhances the capability of the examiner in performing novelty searches. The examiners are also subjected to specialised training provided by experts from European Patent Office and other offices in the specialised area such as biotechnology invention and computer related inventions. Examiners are also being sent for short term and long-term training under WIPO programmes and bilateral cooperation training programmes.

Examiners are also nominated to participate in seminars and courses in their respective technological fields in order to maintain and update their competencies at a high level.

6. QUALITY CONTROL

The general principles of the forthcoming IPO Quality Assurance System are explained in Annex I.

The existing national quality assurance system in the IPO is being revamped. IPO has extensive manuals for all parts of the patent granting process, including particular guidelines on search, examination and communication with the applicant. There are permanent working groups specifically dedicated to improvement of tools and procedures, quality control, and initiation of corrective action in response to feedback from the quality control. These features will be further strengthened in future with the aim of harmonising tools and procedures in the offices. The objective is to ensure that search and examination of any application should lead to the same result irrespective of which office performed the task.

As a further step of harmonisation, the quality standards, practice, tools and (where appropriate) procedures will be harmonised with those applied universally at the EPO.

7. EXAMINATION METHODS AND TOOLS

It is proposed to conduct online novelty searches mainly by using the databases such as EPODOS, WPI, PAJ and INSPEC accessed via the EPOQUE search tool. Other important document databases are accessed for instance via Micro pat and STN. Examiners also use full text databases in various languages and other databases containing articles and other non-patent literature. IT tools, including work stations, used by the examiners are of a high and modern standard.

The collection of patent documents and other publications in paper form is very comprehensive and is used whenever appropriate.

Annex III gives detailed information on the document files and databases available to examiners for search purposes.

[Annex III follows]

ANNEX III

SEARCH DOCUMENTATION USED BY IPO

1. PCT MINIMUM DOCUMENTATION

PCT authorities must have access to the minimum documentation which comprises patent publications since 1920 on paper, microfilm, electronic carriers or databases as well as certain non-patent literature. Indian Patent Office (IPO) has documents from the year 1912 onwards till date, in paper and electronic form.

Patent Documents

According to PCT Rule 34.1, the minimum documentation comprises the following patent publications, published patent applications and granted patents:

- (i) the patents issued in and after 1920 by France, the former Reichspatentamt of Germany, Japan, the former Soviet Union, Switzerland (in the French and German language only), the United Kingdom, and the United States of America,
- (ii) the patents issued by the Federal Republic of Germany and the Russian Federation,
- (iii) the patent applications, if any, published in and after 1920 in the countries referred to in items (i) and (ii),
- (iv) the inventors' certificates issued by the former Soviet Union,
- (v) the utility certificates issued by, and the published applications for utility certificates of France,
- (vi) such patents issued by, and such patent applications published in, any other country after 1920 as are in the English, French, German or Spanish language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority,
- (vii) the published international (PCT) applications, the published regional applications for patents and inventors' certificates, and the published regional patents and inventors' certificates.

According to PCT Rule 34.1(e), IPO as a PCT Authority will only be requested to have access to patent documents of Japan, the Russian Federation and the former Soviet Union as well as Spanish language patent documents to the extent that English language abstracts of these documents are generally available.

At the Indian Patent Office, the patent document full text available as per country US (1836 onwards), GB (1979 onwards), EP (1985 onwards), WO (1978 onwards), JAPAN (1994 onwards), in CD-ROM, AU (1979 onwards) in MICROFICHE, India (1912 onwards), MICROPATENT (1971 onwards). These are available at the Patent Information System, Nagpur, India.

Non-patent Literature

The PCT minimum documentation also covers such other items of non-patent literature which are agreed on by the international research organs and which are published in a register kept by the International Bureau of the World Intellectual Property Organization. An updated list of currently agreed non-patent literature is available at the WIPO website.

IPO has most of Indian journals and several international journals (copy enclosed) including chemical abstract, biotechnology abstract, science, nature, patent and designs journal, cipa journals, computer in libraries, etc.

Two Indian journals (Indian Journal of Traditional Knowledge, Medical and aromatic plants abstracts) are listed in PCT list.

Patent specification and abstract available 95,00,000 approximately in paper form and 15,000 in CD form.

2. SEARCH FILES USED BY IPO

Search Methods and Tools

Searches are primarily conducted electronically by IPO by using following databases. Searches are conducted in paper files when necessary, which in particular is the case for searches in Indian patent literature. The paper based search files of patent office are very comprehensive and organised by classification systems in a way suitable for searching.

Proposed use of EPOQUE

The proposed EPOQUE search tool would give access to the following patent literature:

Country	Access to		
	BNS	EPOQUE- Full-text	EPODOC
Switzerland, CH	All documents from: CH1 (A 18881101)	French, German and Italian Oldest document from 1900	All documents from: CH1 (A 18881101)
Germany, DE	Documents from: DE1 (C 18770702) DE1427159U (U 19330203)	German full-text since 1920 . Oldest document: DE318791 (C 19200207)	Documents from: DE1 (C 18770702) DE1427159U (U 19330203)
France, FR	Documents from: FR1983E (E 19000101) FR2000029 (A1 19690829) (Utility model)	French full-text since 1900 . Oldest document: FR1983E (E 19000101)	Documents. From: FR1983E (E 19000101)
United Kingdom, GB	Documents from: GB189503951 (A 18960330) GB20000136 (B 1979)	English full-text since: GB189503951 (A 18960330)	Documents from: GB189300739 (A 18931011)
Japan, JP	JP documents from 1970	Not available	Documents from: JP40000046Y1 (Y1 19650106)
Soviet Union, SU Russia, RU	SU documents from 1972	Not available	SU documents from: SU115325 (A1 19721207)
USA, US	All documents from: USX000001 (A 17900731)	All documents from: US1 (A 18360713)	All documents from: US1 (A 18360713)

Consolidated Search Files of the Indian Patent Office

Country/Union	Contents	Nature of carrier	Duration
India IN	Patent specifications (1-166000)	Paper Data base	1912 onwards
	Bibliographic data	CD-ROM	2005-2007
United Kingdom, GB	UK Patent Applications (885891-1605200, 2000001-2268600) UK Patent Abridgements (001-1605200, 2000001-2245130) Bibliographic Data and Abstract	Paper CD-ROM DATABASE	1962-1985 1979 onwards 1971 onwards
	United States of America US	Patent specifications Bibliographic Data and Abstract Abridgements (1210895-5181273, 5181274-5269022)	CD & DVD DATABASE
Canada CA	Patent Abridgements (551796-1315914)	Paper	1948-1993
Korean	Patent Abstract (79.301-91.9302)	Paper	1979-1992
European EP	Description, claims Bibliographic Data Granted patents	CD-ROM DATABASE	1985 onwards 1971 onwards
	France FR	Bibliographic data Abstract	CD-ROM
Japan JP	Bibliographic Data Abstracts	DATABASE Paper CD-ROM	1971 onwards 1985-1992 & 1995 2001
Germany, DE	Patent specifications (46201-153310) Abstracts	Paper/ CD-ROM	1967-1983 1961-1992 & 1995
Belgium BE	Bibliographic data	CD-ROM	1990-2004
Portugal PT	Bibliographic data	CD-ROM	1990-2004
Luxembourg LU	Bibliographic data	CD-ROM	1990-2004
Switzerland CH	Bibliographic data/Abstract	CD-ROM	1971- 2004
New Zealand NZ	Abstract/Abridgements	Paper	1962-1992
Netherlands NL	Patent specifications (103461-140000, 140001-190043)	Paper/CD-ROM	1966-1974
Australia AU	Patent specifications (234605-296236, 400001-496400)	Paper	1959-1971 1980
	Abridgements (236001- 494000)	CD-ROM Microfilm Microfiche	1998 onwards
			1975 onwards

Consolidated Search Files of the Indian Patent Office (Cont.)

WIPO WO	PCT International Applications	CD-ROM/DVD	1978 onwards
EPIDOS (70 countries)	Bibliographic Data	CD-ROM	1998-2005
EPC (29 countries)	Bibliographic Data	CD-ROM	2005 onwards
INPADOC	Microfiche	Bibliographic data including title of patents from more than 70 countries	1968 to Aug 1998

Periodicals

- Chemical Abstracts – 1952 –1991 (Bound Vols.): 2000 (approx)
- Scientific & Technical Journals (Bound Vols): 18000 (approx)

Patent Specification & Abstracts (Paper)

- Indian Patent Specifications – 1-175399
- Patent Documents (Indian & Foreign),
classified Search Files & Serial Vols. 9500000 (approx)

Patent Specifications & Abstracts (CD-Roms)

- Patent Documents (Indian & Foreign) 15000 (approx)

Foreign Patent Abstracts Published by Derwent Publications Ltd., London.

- British Patent Abstracts weekly – 1962 – 1985
- Central patents Index Sec. “A” Plasdoc – ER Weekly 1970 – 89
- –do- “B” Formdoc “ – 1970 -1 989
- German patent Abstracts Weekly 1961 – 1992 + 1995
- –Do_ Sec-PQ & BL Weekly 1985 – 1992 + 1995
- Japanese Patent Abstracts Weekly 1985 – 1992
- PCT Patent Abstracts Bi-Weekly 1985 - 1992 +1995
- Soviet Invention Illustrated Weekly 1967 – 1991
- – do – PQ – General/Mechanical Weekly 1967 - 1991 +
- –do – EL – Electrical Weekly 1967 – 1991 +

Chemical Abstract Issues with Indexes 1952 – 1991

Collection of Industrial Reports

- BIOS (British Intelligence Objectives Subcommittee final Reports No. 1 - 1742 = 1742
- – do – Evaluation Reports No. ER/1 – ER/576 = 576
- –do- Japanese Reports (U.K.) No. JAP/PR/8 – 1666 = 1659
- –do- Miscellaneous Reports (U.K.) No. Misc/1 – 67 = 67
- CIOS – (Combined Intelligence objectives sub-committee) Reports (UK) No. I/1 – XXXIII – 72 = 612
- FIAT (Field Information Agency Technical) Reports (UK) No. 1 – 1208 = 1208
- JIOA (Joint Intelligence Objective Agency) Reports (Washington) No. 1 – 80 = 80

Other On-line Tools

For searching of patent applications, IPO will make use of EPOQUE together with certain full text databases. Additionally, CHEMICAL ABSTRACT and BIOSIS, accessed via STN, are used for searches in chemistry, pharmaceuticals and other special technologies. STN is also used for accessing other databases as appropriate. Various useful Internet sites, for instance, ESPACE, USPTO, SURFIP, PATENTSCOPE are used for conducting additional searches.

Non-Patent Literature

IPO propose to subscribe the non-patent literature required under PCT minimum documentation, which are not accessible through EPOQUE.

[End of Appendix and of document]