Matal hints at PTAB improvements

Judge Michel: the patent system is in your hands

Lisa Jorgenson on a busy year for AIPLA

Leahy outlines legislative goals

Matal has been busy giving speeches these past few months – “I feel like I’ve become the ‘It Girl’ of the IP speaking circuit,” he confided at the beginning of yesterday’s keynote speech at the Opening Plenary Session. Matal, who is performing the functions and duties of the USPTO Director before a permanent Director is confirmed, went on to cover a range of issues during an entertaining speech. He suggested that attendees should look out for a number of developments from the Patent Trial and Appeal Board.

One of the most timely discussion points was the Federal Circuit’s Aqua Products v Matal opinion, issued on October 4. Judge O’Malley’s opinion said the ruling was “narrow” as a result of the different rationales presented in multiple opinions. The decision took a long time to come out – oral argument was in December last year. “Now that we have the decision and I have had time to read it, I wished I hadn’t nagged them to get it out so quickly,” Matal confided. “I think they would have benefited from another month on it.”

The Federal Circuit did rule that the USPTO may not place the burden of persuasion with respect to the patentability of amended claims on the patentee during IPRs. Matal said the USPTO just wants to follow the judicial decisions. “But obviously with five different opinions and no clear majority in that case, it has been a challenge for us to divine what the law is now and what is expected of us,” he said. “We do feel now we have a bit of a handle on it, and we will be issuing guidance at some point on the Office’s procedures for amendments going forward.”

This guidance “won’t be the final word on these procedures, seeing that we still have authority over these amendments,” added Matal. He reported the USPTO has been studying what it can do to create a more robust amendment process. “One of the conclusions we have come to internally is that we really need to give people earlier notice and an opportunity to amend after it is clear the earlier claims are going to get cancelled.”

Matal also discussed serial petitions challenging the same patent, which he admitted “has been the source of some controversy.” He said the expectation at the time of the America Invents Act (AIA) was that a patent would only be challenged once. “It has really been a surprise that there is this subset of cases where you have multiple attacks on the same patent,” he said.

Matal revealed that about 68% of patents that are ever challenged in an AIA trial are only challenged once, with about 20% challenged twice and the remaining 12% having multiple challenges. Matal said this is sometimes justified, such as when the patent owner has sued all the companies challenging its patents. “On the other hand, you get cases where a patent is challenged once, institution is denied and then the petitioner tries to do it again. There were cases where unfortunately that was allowed,” Matal said. “But to those that were unhappy with these serial challenges, I would point to some of the improvements the Board has made to this process.”

This week, the PTAB revealed it had designated as precedential its decision in General Plastic Industrial v Canon Kabushiki Kaisha. “General Plastic was a case where if you brought a petition and it was denied in any way, you better have a good reason for trying to bring another petition,” said Matal. “You better be able to show that it is something that you couldn’t have presented earlier. Given the nature of what you can present, it is going to be a rare case where you couldn’t have presented earlier. So General Plastic is dealing with the piecemeal attacks. We now have a precedential decision that should cut those off.”

Another issue Matal discussed was the Board’s evolving 35 USC § 325(d) jurisprudence. “I think we are going to have some upcoming informative decisions on that, highlighting the Board’s use of its authority to show we are not revisiting the same issue again and again. This includes issues that were already fully considered at prosecution,” he said.

Lastly, Matal identified “two sleeper cases that haven’t got that much attention” that he believes have a shot of being granted certiorari by the Supreme Court. These were the Unwired Planet and Secure Axcess cases, dealing with the scope of covered business methods (CBM) cases and reviewability of the CBM determination. “If you are interested in what might percolate up to the Supreme Court next, I would keep an eye on the Unwired Planet and Secure Axcess cases.”
In-house counsel share secrets for IP success

Attorneys were treated to useful tips about how to succeed in litigation, transactions and trademark practice yesterday afternoon in a session called “IP Isn’t Just Important Patents! Successfully Leveraging All Intellectual Property.”

Moderator Troy Grabow of Cabeau shared a number of lessons learned about finding the right business resolution in litigation. He said success in litigation should focus on a business win, not necessarily just a court win, it requires a flexible and responsive approach, and the short-term cost of litigation can be necessary for the long-term benefit of the business.

La Nelle Owens of Walnut Technology discussed trademark portfolio management. “I have found that it helps if you can slow your clients down just a little bit to help them develop some type of process with respect to trademarks – use dates, specifications and all those different things that people don’t think about,” she said. “In a difficult for a trademark practitioner to get all that information once an issue comes up and a commercial product is on the truck.”

Phil Petti of USG Corporation noted some of the pitfalls of the IP team not being kept in the loop about brands. “There has been more than one time when something is on the market and they’ve given it a new brand without telling you,” he said.

Randi Karpinia of Motorola Solutions said her biggest challenge when it comes to brands is acquisitions and divestitures. Motorola was split into Motorola Mobility and Motorola Solutions in 2012, with Motorola Mobility sold to Google the following year. Two years later, it was sold to Lenovo. “So managing our use as a licensee of that brand is huge – and not necessarily in a friendly market. So for acquisitions and divestitures, when thinking about these types of things it is really about thinking about end results,” she said.

Karpinia said some of the lessons learned about trademark management were that it is important to understand how to manage mature versus growing portfolios, and that an established portfolio requires constant audits and gap risk assessments, while developing portfolios should create methods and processes for assessing importance and risk, such as anticipated scope of launch and use.

Trade secrets are something that for me personally as an IP attorney I prefer not to utilize,” said Karpinia. “The problem I find with determining whether we will keep something as a trade secret is that trade secret laws are so strict. You can train a group and then a new person comes in and trying to keep the restricted confidentiality that is required for trade secrets is so difficult that the decision for us to keep something as a trade secret is thought out very carefully.”

Petti of USG responded: “We are probably on the other end of the scale now. Trade secrets are a really big issue for us.”

He noted challenges with them, however. One came during the recession when his company lost a lot of people. This meant USG was making decisions about whether to keep something as a trade secret based on the fact that people may be leaving. Lessons learned for non-IP company disclosures were that care must be taken to avoid conflicts in non-IP documents with your IP strategies, be careful that corporate documentation does not take a position or make a statement that unknowingly and/or inadvertently impacts intellectual property, and be careful not to disclose potential confidential information/trade secrets in non-IP documents.

Third party interactions were also discussed, with some of the lessons learned about managing IP unless under a confidentiality agreement, and customer interactions are a way of life so you should implement flexible, efficient processes and strong business/client relationships to ensure IP protections.

Lastly, Kathryn Owens of Star2Star Communications gave an overview of IP law affecting business decisions. One of the subjects she discussed was exhaustion – a hot topic following the Impression vs Lexmark decision from the Supreme Court in May this year, stating that once a sale occurs, all patent rights in the item are exhausted regardless of any restrictions the patent owner tries to impose on the location of sale.

This decision is important for companies who offer their products and services for sale as opposed to those who license,” said Owens. “Exhaustion of patent rights at the time of sale may substantially minimize the value of a legal entity’s patent portfolio, and may require a company to reevaluate their existing patent capitalization and defense strategies.”

Top 10 tips for successful mediation

1. Negotiate best timing and selection of mediator
2. Planning is key – hold pre-mediation conference and decide who’s going to be involved in the mediation
3. Prepare counsel
4. Prepare client
5. Think like the other side
6. Manage expectations
7. Be civil
8. Consider non-monetary issues
9. Nail down the deal with detailed terms
10. Keep the door open - mediation isn’t over until the case is over

But trust between the parties involved is also important. “Trust is one of the most important factors in that room,” said Paul Burns of Procopio, whose presentation focused on ethics in mediation proceedings.

In a setting where emotions can run high, Jeanne Gills of Foley & Lardner said it’s crucial to make sure your client checks their feelings at the door. Holderman added: “Be calm, creative and in control.”

In an earlier presentation in the same track, Laura Kaster of Laura A Kaster explained the differences between mediation and arbitration and said that “mediation is a completely different animal from arbitration” because of the need to understand your client’s relationship with the other side. “You have to have the best intelligence on what the other side wants; mediation is an opportunity to listen and find out what your opponent needs,” said Kaster.

This differs from arbitration, where the main goal is to help the arbitrators understand your story using graphics and other aids, if possible.

Despite the fact that, according to Burns, “mediation is universally recognized and supported by courts throughout the US as the most effective means of resolving litigation,” many parties miscalculate settlement

In mediation we trust
During his luncheon keynote yesterday, retired Chief Judge of the Federal Circuit, Paul Michel, painted a dire picture of the present "health" of the patent system, and urged AIPLA members and the broader IP bar to take action to rescue it.

Beginning with the Supreme Court's decision in eBay v. MercExchange in 2006, which Michel said "decimated the availability of injunctions," continuing with its "upending of patent eligibility law" in cases such as Alice and Mayo, and ending with the America Invents Act changes, a climate of uncertainty now reigns, said the judge.

Michel pointed out that the US Chamber International IP Index, Fifth Edition earlier this year ranked the US patent system in 10th place, tied with Hungary. Start-up growth has declined, patent value is down, and the majority of applications at the USPTO are now made by foreign companies.

Because of this drastically altered "risk calculus," investors – who the patent system was really created for – are discouraged. "Creatives will always create [but] uncertainty is exactly what business cannot abide," said Michel.

One of the reasons for these many changes, according to Michel, is that experts are no longer in charge of patent law. "Patent policy used to be mainly dominated by experts, but in more recent times experts wrote the 1952 Patent Act because patent law is big politics now."

In his September testimony before the House Subcommittee on Courts, Intellectual Property, and the Internet, Michel provided a number of suggestions to fix the situation, outlining seven actions the Committee take to "rescue the US patent system and reinvigorate the US economy." He said that the discussion during that hearing was the first time he had heard concern expressed by Congress about the state of the patent system, particularly from Representatives Lamar Smith, Bob Goodlatte and Darrell Issa, which gave him some hope.

Michel also pointed to AIPLA's Legislative Proposal and Report on Patent Eligible Subject Matter as a way forward, and was hopeful that a consensus proposal among IP associations could be reached.

But ultimately, said Michel, "the problem is us and our lack of political activism as a profession. The question is stark – will we or will we not act in concert to rescue the patent system from decline?"

Earlier in the Luncheon, AIPLA Outgoing President Mark Whitaker presented awards to several members for their distinguished service or academic accomplishments. The recipients were:

- President's Outstanding Service Award: Esther Kepplinger, Wilson Sonsini Goodrich & Rosati
- Coordinator of the Year Award: Elise Selinger, Conley Rose
- Jan Jancin Award: Alvin Carter, Northeastern University School of Law, Boston, MA

The fate of the patent system is in our hands.

Open the doors by encouraging excellence

Judge Jimmie Reyna of the Federal Circuit sat down with Valerie Calloway of Alltech, a member of the AIPLA Board of Directors, during yesterday's Diversity Reception, for a Q&A about his road to becoming a Federal Circuit judge. Reyna grew up in a small town in New Mexico, where his parents were Spanish Baptist Missionaries who "gave everything away." He said his parents' charity for others shaped his approach to the law, and caused him to focus his career on enhancing access to the system of justice. "Pro Bono work and increasing diversity are both about lifting the human spirit," said Reyna. "As more kids become educated, we open the doors of the courthouse."

Reyna also urged the audience to commit to encouraging young lawyers – particularly minorities – to hone their writing and oral skills. "To improve diversity, produce excellent legal practitioners," said Reyna.
Reflecting on a productive year

AIPLA Executive Director Lisa Jorgenson and the Association have had a busy year since last year’s Annual Meeting, with much progress made domestically and internationally.

The Board last summer went through a process of evaluating its strategic plan. At the end of that process the Board adopted new guidelines, which is now in use to work with its more than 60 committees to help them achieve their goals.

“This year that process alone has really helped us become more efficient in evaluat- ing projects, getting them ready for prime- time, allowing us to be more flexible and a lot faster in developing AIPLA’s positions,” says Jorgenson. “That is a key project we have had in the background here.”

The Association has continued to grow some of its activities. For example, its Women in IP Law Committee global net- working event was the biggest yet this year. Simultaneous networking dinners took place in about 60 locations in 25 countries in May.

The Association has also benefitted from more modern headquarters. This includes a new state-of-the-art meeting space dubbed the Past President’s Conference Center where the Association has hosted programs, such as the ninth annual Trademark Boot Camp and the Patent Cooperation Treaty (PCT) workshop. AIPLA is also undertak- ing a major project to update and improve its website, which should be rolled out within the next 12 months.

AIPLA has been as busy as ever on judi- cial advocacy. It filed seven briefs in the past 12 months in both the Federal Circuit and Supreme Court. In the pending Oil States case, the Supreme Court will assess whether inter partes review violates the Constitution by extinguishing patent rights through a non- Article III forum without a jury. AIPLA argued that IPRs do not violate the Separation of Powers or the Seventh Amendment.

“Our brief acknowledged that Separation of Powers decisions have assigned private property issues to Article III courts, but we argued that this is not dispositive of when issues are properly before Article I tribunals. AIPLA affirmed in the strongest terms that patents are a private property right that are fully transferrable commodities, and we argued that the proper criteria for this case is the source of the right—a detailed statute enacted by Congress—not the character of the right in question,” says Jorgenson.

The issue in the case is really whether you can still be in front of the PTAB, an Article I court, and our belief is the answer is yes, based on the AIA. I think there was some confusion over whether people believe that patents were private property rights, and of course they are. We just felt that was not dispositive of the case.”

In the Aqua Products case, the en banc Federal Circuit this month ruled that the PTAB improperly required patent owner in IPRs to show that proposed patent claim amendments are patentable before it will grant a motion to amend those claims. The Court unanimously agreed that it was wrong to impose that burden on patent owners instead of petitioners, but the Court was deeply divided on whether to defer to the USPTO rule to the contrary. A majority of the Court decided that it need not defer for procedural reasons, but we are now waiting to see what procedural adjustments the USPTO makes.

AIPLA also filed a number of comment letters related to judicial advocacy. One example was a letter brief in the In re Silver case at the Texas Supreme Court, in which AIPLA supported privilege for communica- tions between a patent agent and client. AIPLA has also continued to have a strong voice on Capitol Hill, monitoring issues such as patent litigation reform and copyright modernization efforts. AIPLA is also waiting for the new USPTO Director to be confirmed. “A number of issues and proj- ects seem to be in a holding pattern until the new Director is in place,” Jorgenson says.

Looking forward, Jorgenson says patent eligibility remains a hot topic. “Our mem- bers tell us that the Section 101 issue is still the most important issue for them,” she says. “They are very concerned about the current uncertain state of the law. We believe this has discouraged investment in US-based research and development activities.”

Jorgenson says Section 101 was not intended to provide the standard for deciding whether a particular technical advance should receive patent protection. AIPLA and two other IP associations, independent- ly concluded that a legislative change is needed to fix the Section 101 problem, and this year AIPLA published a report and proposed amendment.

“AIPLA’s goal is to provide more clear guidance to the Patent Office, the courts and the innovation community that can be consis- tently applied to all technologies including those that we cannot yet predict,” says Jorgenson. “We know that legislation in a very complex area such as this is not going to be easy. But the law of subject matter eligibility really needs to be more stable and pre- dictable, and the best solution is a compre- hensive legislative fix to address the problem.”

On the international side, AIPLA, as part of the Industry Triilateral and Industry IP’s, has continued to work very closely with (respectively) the Triateral and IP’S patent offices on such issues as patent harmonization, the global dossier, and other projects.

Life after Tam

Following the US Supreme Court’s deci- sion in Matal v Tam, “the Redskins will win in the fourth quarter” and scan- dalous or immoral trademarks will be the “next shoe to drop,” said Bennett Evan Cooper of Steptoe & Johnson, speaking in yesterday’s Track 3 morning session on lessons learned after Tam.

In Matal v Tam, issued on June 19, 2017, the Supreme Court upheld the Federal Circuit’s finding that Lanham Act provision 15 USC §1052(a) prohibiting the registration of trade- marks that may “disparage . . . or bring . . . into contempt[1] or disrepute” any “persons, living or dead” violates the First Amendment’s Free Speech Clause. The case involved the USPTO’s rejection of the mark THE SLANTS, for which applicant Simon Shiao Tam of the rock band, The Slants, had applied.

The opinion of the court, written by Justice Alito, said that the disparagement clause consti-itutes “viewpoint discrimination,” which is barred. “Giving offense is a viewpoint. The ‘public expression of ideas may not be prohibit- ed merely because the ideas are themselves offensive to some of their hearers,’” it said.

The Supreme Court’s ruling does not bode well for the plaintiff in Blackhorse v Pro Football, in which a group of Native Americans succeed- ed in its plea to have the Washington Redskins’ REDSKINS trademark invalidated under that clause. The case was on hold in the Fourth Circuit pending the Supreme Court’s decision in the Tam case. It now will likely be revived. Another case that is pending review by the Federal Circuit, In re Brunett, challenges the scandalousness provision of the Lanham Act. During the Q&A, attendee Jeffrey Epstein of Cowan, Liebowitz & Latman expressed his concern that the Supreme Court had gone too far. “After Tam, what is the difference between a disparaging mark and hate speech that causes pain and social unrest?” asked Epstein.

Steptoe & Johnson’s Cooper added that the USPTO will likely push back on such marks in other ways; for instance in the case of a hateful term used on t-shirts, the office might argue that the use is merely ornamental.

Session moderator Pina Campagna of Carter DeLuca Farrell & Schmidt agreed. “Bad words are part of the First Amendment, but a trademark has to be a source identifier.” Another panelist, Dyan Finguerra-Ducharme of Pryor Cashman, pointed out that “the USPTO’s rejection of a trademark application isn’t going to stop hate speech.”

But Epstein told the AIPLA Daily Report that he remains worried. “The Supreme Court could have said that the Tam mark wasn’t disparaging while still keeping the bar on hate speech,” he said. “There are marks that may meet the requirements for a trademark and are very dangerous; hate speech should be regulated, as it is in other countries.”

AIPLA congratulates James Crowne on his nearly 15 years of service to the association.
Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

SINCE 1949

UNITED TRADEMARK & PATENT SERVICES
International Intellectual Property Attorneys

Trademark, Patent, Design, Copyright, Domain name registration, litigation & enforcement services

Pakistan Office
85 -The Mall Road, Lahore 54000 Pakistan (Opposite Ferozesons books store / adjacent rado time center)
Email: UnitedTrademark@UnitedTm.com Websites: www.utmps.com and www.unitedip.com

Gulf, Middle East, South & East Asia and African Offices

DUBAI (UAE)
Suites 401-402, Al-Hawai Tower
Sheikh Zayed Road, Dubai
Tel : +971-4-3437 544
Fax: +971-4-3437 546
Email: Dubai@UnitedTm.com

OMAN
Suite No. 702, 7th Floor
Oman Commercial Centre, Ruwi
Tel : +968-24-787555, 704788
Fax: +968-24-794447
Email: Oman@UnitedTm.com

SRI LANKA
105, Hunupitiya Lake Road, Colombo 02,
Sri Lanka.
Tel : +94 11 4322790-1
Email: srilanka@UnitedTm.com

JORDAN (Amman)
Suite 7, 2nd Floor
Chicago Building, Al Abdali
Tel : +962-6-5683088
Fax: +962-6-5683089
Email: Jordan@UnitedTm.com

QATAR
Villa # 40, Al Amir Street
Al Mirgap Area, Doha, Qatar
Tel : +974-444 3083, 444 3093
Fax: +974-444 7311
Email: Qatar@UnitedTm.com

LEBANON
6th Floor, Burj Al-Ghazal Bldg.,
Tabaris, Beirut, Lebanon
Tel : +961-1-21 5373
Fax: +961-1-21 5374
Email: Lebanon@UnitedTm.com

SAUDI ARABIA
Behind Maktaba Al Shawwaf
30th Street-Olaya, Riyadh 11444
Tel : +966 -11-4616157, 4655477
Fax: +966 -11-4616156, 4622134
Email: SaudiArabia@UnitedTm.com

TANZANIA
Shauri Moyo Area,
Pugu Road
Dar-Es-Salaam
Tel : +255-222862900
Email: Tanzania@UnitedTm.com

MOROCCO
58, Rue Ibn Batouta,
PPT. No. 4, 1 er Estage,
Casablanca, Morocco
Tel : +212-52206096
Email: Morocco@UnitedTm.com

SHARJAH (UAE)
Suite 203, Al Buhairah Building
Buhairah Corniche, Sharjah
Tel : +971-6-5722742
Fax: +971-6-5722741
Email: UAE@UnitedTm.com

YEMEN
6th Floor
Ideal Clinic Building
Hadda Street, San'a, Yemen.
Tel : +967 181 9642
Email: yemen@UnitedTm.com
The agonizing past...
When it comes to innovation and development, India has often been seen as a laggard by the economic enthusiasts. Often compared as an ‘Elephant’ to the ‘Dragon’ when it comes to innovation capacities and capabilities, wherein China has been tracking on the zenith in the eyes of the developed western world. Talking of innovation, the best parameter to scale the progress of innovation and development of any country is its intellectual property protection regime.

With the enforcement of the Indian Patents Act of 1970, the law has been continuously and consistently evolving. We do not disagree that the Indian intellectual property regime, particularly patents, could not match the pace of the IP practice and system in the developed countries particularly US, Europe and Japan. This is evident from the huge patent backlog prevailing in the Indian Patent Office and the time taken for securing a patent in India, which has caused some kind of aversion among the foreign applicants from securing patent protection in India.

It is true that it took an average time of 6-8 years for a patent to be granted in India from the date of its filing. The examination itself began after 3-4 years from the date of filling a request to be granted in India from the date of its filing. The examination process for patent applications prevailing on account of tremendous shortage of trained manpower to examine patent applications. This is evident from the fact that as much as 237,671 patent applications were pending in India in 2013.

“There is enormous pendancy of patent applications in India. It takes around 6-8 years to clear patents here while outside of the country the time taken is 2-3 years whether its US, Japan or Europe,” quoted Wockhardt Chairman Habil Khaorakwala in a press release in 2016, who even disclosed that of around 2,178 patents filed by his company in the last 10-12 years, only 79 grants have been received until 2016.

Further, it is not just the functioning of the Indian Patent Office that has alone contributed to this negative perception of the Indian intellectual property regime on the global stage, but certain strict statutory norms of the Indian Patents Act, which are not particularly appreciated by the big industrial players especially the multinational pharmaceutical giants who have found it difficult to secure protection for their products in India. This difficulty is owing to challenging provisions like Section 3(k) of the Indian Patents Act, which are not present in laws of Europe or US. Further, certain rulings coming from higher courts and the Intellectual Property Appellate Board (IPAB) added to the anxiety of the foreign applicants. For example, the decision of the Honorable Supreme Court of India upholding the refusal of patent to Novartis’ cancer drug Gleevac and the grant of first compulsory license for Bayer’s patented cancer drug Nexavar has been criticized worldwide and has created an impression that India is not an innovation friendly country. Further, the flip-flops on the interpretation of Section 3(k) in the guidelines for examination of Computer Related Inventions (CRI) issued by the Indian Patent Office has further added to the agony of the foreign applicants seeking protection in computer-related inventions.

Consequently, foreign applicants/attorneys maintained their reservations in filing for patent protection in India while they knocked the doors of the other Asian jurisdictions, which knocked the doors of the other Asian jurisdictions, which found them to be more IP friendly. Qualcomm’s Chief IP Counsel at AIPPI’s 2017 Spring Meeting has stated that for every application they file in US, a corresponding Patent Application is being filed in China also.

The way forward...
Amidst all the twists and turns, India has been continuously striving to strike a balance between the interest of the innovators and the interest of the Indian public represented by generic Indian industry, local R&D units and local software industries. Since the Modi Government came into power in India in 2014, India has witnessed a ‘wave of change’. Never in the past has India had any prime minister who has been so proactively involved in promoting scientific development. Mr Modi has travelled the world, met the CEO’s of various US, EU and Japanese organizations and realized the importance of IP framework and IP offices for securing protection for intellectual property and the positive results thereof, for the industry and for the country. The Prime Minister has personally involved himself in discussing the issue of handling and resolution of grievances related to patents and trademarks during one of the PRAGATI (Pro-Active Governance And Timely Implementation) sessions. The seeds sown then have started to reap now. One arm of the most talked “Make in India” mission stretched towards building a strong IP regime in India. On May 12 2016, the Indian Government approved its first ever National Intellectual Property Rights Policy. The IPR Policy with the slogan “Creative India, Innovative India” proposed tax breaks to promote research and development, simpler procedures to get benefits, creation of a cell to facilitate promotion, creation and commercialization of IP assets, loan guarantee scheme to cover risk of failures in commercialization of IP, strengthening IP protections by streamlining of the enforcement mechanisms, adjudication of IP disputes by commercial courts and making IP integral part of Indian education etc.

While the National IPR Policy was welcomed with open hands and seen as a huge step towards strengthening the Indian IP regime, what followed thereafter was seen as a revolutionary step in changing the face of Indian IP, particularly the Indian patent system. With the enforcement of the Patent (Amendment) Rules in 2016, some remarkable improvements in the Indian patent system and practice could be seen, particularly directed to expediting the process of securing a patent in India.

The prime highlights of the Patent (Amendment) Rules of 2016 included: reduction of time period to respond to examination reports from one year to six months; restricting the number of adjournments allowed for attending the hearing proceedings at the Patent Office to two and that too with prescribed official fees; permitting deletion of claims at the national phase entry for PCT applications entering India; provision for refunding up to 90% of the examination fee if an applicant

**Why India??? Has the Elephant really woken up??**

Sharad Vadehra and Somitra Kumar of Kan and Krishme discuss improvements to India’s patent regime, including the impact of the Patent (Amendment) Rules of 2016

Sharad Vadehra

Sharad Vadehra is the managing partner at Kan and Krishme. He joined the profession in 1989, and is amongst the few attorneys in the country with both technical and legal qualifications. Sharad specializes in intellectual property law, media, entertainment, sweepstake and litigation and more than 28 years experience in these fields and in handling such matters for both domestic and international companies (including Fortune 500 companies) and research institutions. Sharad has the prosecution of more than 20,000 patents and trade mark applications to his credit. He has been a speaker in more than 500 institutions and corporate bodies in India and overseas, and is the author of the book Indian Patent Law and Practice, published by Chosaikai in Japanese language.

Sharad has often been consulted by the Government of India when any new guidelines or rules are being framed with respect to the Indian Patent Act and Rules.

Sharad, along with other colleagues, founded the FICPI India group in the year 2009 and has been closely associated with it. He is presently the president of the FICPI India. He has recently been appointed the coordinator for CET 9 in FICPI for all Asian Countries including but not limited to Japan, South Korea and China. He has recently been elected as vice-president of APAA India and he will be playing an active role in organizing the APAA Congress to be held in New Delhi in 2018. He is one of the founding members of GALA and is the past president of its Asia Pacific branch. He holds membership of FICPI, APAA, AIPPI, AIPLA, AIPPI, INTA, LES, and Delhi High Court Bar Association.

Somitra Kumar

Somitra Kumar has a Masters degree in Physics and a Masters degree in Law. He is a partner at Kan and Krishme and heads the Litigation & Contentious Matters Department. Besides being an advocate, he is a registered patent agent and has several years of experience in IP Law particularly, drafting and prosecuting patent applications in the field of core electronics, telecommunications, electrical, electronic engineering, instrumentation, computer related inventions. Somitra regularly provides opinion to clients on various aspects of IP Law including validity and freedom-to-operate opinion. He also advises clients on media, entertainment, sweepstakes and promotions, marketing and commercial disputes. He holds membership of APAA, INTA, AIPLA, and Delhi High Court Bar Association.

Sharad Vadehra and Somitra Kumar discuss improvements to India’s patent regime, including the impact of the Patent (Amendment) Rules of 2016.
withdraws the application before issuance of examination report; provisions for expedited examination for start-ups or for applicants who have elected the Indian Patent Office as ISA and IPEA; provisions to request examination for foreign filings within 21 days of the date of filing such request; and introduction of conducting hearings by way of video conferencing.

Seen as a whole, all of the above mentioned amendments aim to curb down the prosecution time of a patent application in India and expedite the process of examination and grant of patent applications.

The introduction of the “Start-up-India” initiative was further seen as a strategy towards enhancing industrial competitiveness of the Indian innovators. The government launched the “Start Up Action Plan” to empower startups to grow and innovate. With the benefits provided to startups under these schemes such as reduction in almost 80% of the fees, tax break for three years, expedited examination, etc., Indian startups can now promptly realize their IPR value.

With the advent of new Patent (Amendment) Rules allowing expedited examination, it is now possible for a patent to be granted within 100-300 days, thus drastically reducing the time for securing a patent. Recently, the Indian Patent Office made news for granting a patent within a record 113 days to Hyderabad based Applicant- Optimus Drugs for their drug- Apixaban (Patent Number: 285091) under the expedited examination scheme.

Talking in terms of whether the “Elephant” has really woken up, the answer appears to be in the affirmative in view of the innumerable measures being implemented by the Indian Patent Office actively in the span of last one and a half years to reduce the pendency and expedite examination and grant process of patent applications in India. To list a few, these measures include: introduction of video conferencing facility for conducting patent hearings; auto allotment of examination reports of patent applications among the Indian Examiners in India and expedite the process of examination and grant of patent applications.

With the Prime Minister of Japan having reaffirmed to Indian Prime Minister Mr Modi Japan’s commitment to a strong bilateral relationship with India. Very recently the officials of the Indian Patent Office and Japan Patent Office entered into a consultation for exploring the possibility of a bilateral Patent Prosecution Highway (PPH) between India and Japan to expedite the process of patent prosecution in India. In this connection, Indian officials also proposed that for PCT applications, India can be selected as ISA/IPEA by making suitable changes in the present scheme and therefore, benefit of expedited examination under new rules can be availed. Developed countries such as US, Germany which have been keen to see their companies doing business in India and obtaining Patent protection for their technologies would be better off entering into a similar arrangement with India.

As Steve Jobs rightly said: “You can’t connect the dots looking forward; you can only connect them looking backwards.” Thus, with IP reforms in progress, the results will certainly be visible soon and overpower all the criticism. And, this Elephant has not only woken up, but also started moving and shaking the IP landscape, in India as well as globally.
<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
</tr>
</thead>
<tbody>
<tr>
<td>9:30am-1:30pm</td>
<td>Spouse/Guest Tour: The Newseum</td>
<td>Meet at Harry’s Pub entrance by 9:15am</td>
</tr>
<tr>
<td></td>
<td><strong>Committee Meetings</strong></td>
<td></td>
</tr>
<tr>
<td>6:45am-8:45am</td>
<td>Women in IP Law Breakfast Meeting</td>
<td>Washington Rooms 1-3, Exhibition Level</td>
</tr>
<tr>
<td>7:45am-8:45am</td>
<td>Amicus (Committee Members Only)</td>
<td>Capitol Boardroom, Lobby Level</td>
</tr>
<tr>
<td>7:45am-8:45am</td>
<td>US Bar/JPO Liaison Council (Council Members Only)</td>
<td>Coolidge, Mezzanine Level</td>
</tr>
<tr>
<td></td>
<td><strong>Concurrent Morning Tracks</strong></td>
<td></td>
</tr>
<tr>
<td></td>
<td>8:45-11:45am Track #1 Patent</td>
<td>Thurgood Marshall Ballroom, Mezzanine Level</td>
</tr>
<tr>
<td></td>
<td>8:45-11:45am Track #2 Trade Secret</td>
<td>Marriott Ballroom with Salon 1, Lobby Level</td>
</tr>
<tr>
<td></td>
<td>8:45-11:45am Track #3 International</td>
<td>Maryland Ballroom, Lobby Level</td>
</tr>
<tr>
<td></td>
<td><strong>Lunchtime Events</strong></td>
<td></td>
</tr>
<tr>
<td>11:45am-12:15pm</td>
<td>Lunch Reception</td>
<td>Exhibit Hall A, Exhibition Level</td>
</tr>
<tr>
<td>12:15-1:45pm</td>
<td>Luncheon - AIPLA Excellence Awards</td>
<td>Marriott Ballroom 2 + 3, Lobby Level</td>
</tr>
<tr>
<td>1:45-2:00pm</td>
<td>Annual Association Business Meeting</td>
<td>Marriott Ballroom 2 + 3, Lobby Level</td>
</tr>
<tr>
<td></td>
<td><strong>Concurrent Afternoon Tracks</strong></td>
<td></td>
</tr>
<tr>
<td></td>
<td>2:00-3:30pm Track #1 Litigation/Ethics</td>
<td>Thurgood Marshall Ballroom, Mezzanine Level</td>
</tr>
<tr>
<td></td>
<td>2:00-3:30pm Track #2 Supreme Court Cases/Litigation</td>
<td>Marriott Ballroom with Salon 1, Lobby Level</td>
</tr>
<tr>
<td></td>
<td>2:00-3:30pm Track #3 Copyright</td>
<td>Maryland Ballroom, Lobby Level</td>
</tr>
<tr>
<td></td>
<td><strong>Committee Educational Sessions</strong></td>
<td></td>
</tr>
<tr>
<td>3:30-5:30pm</td>
<td>Industrial Designs/IP Practice in the Far East/IP Practice in Japan (Joint Session)</td>
<td>Thurgood Marshall Ballroom, Mezzanine Level</td>
</tr>
<tr>
<td>3:30-5:30pm</td>
<td>International and Foreign Law</td>
<td>Marriott Ballroom with Salon 1, Lobby Level</td>
</tr>
<tr>
<td>3:30-5:30pm</td>
<td>Patent Law/Mentoring Committee</td>
<td>Maryland Ballroom, Lobby Level</td>
</tr>
<tr>
<td></td>
<td><strong>Concurrent evening Tracks</strong></td>
<td></td>
</tr>
<tr>
<td>3:30-4:30pm</td>
<td>American Bar Association Business Meeting with Reception</td>
<td>Thurgood Marshall Ballroom, Mezzanine Level</td>
</tr>
<tr>
<td>3:30-4:30pm</td>
<td>Online Programs</td>
<td>Hoover, Mezzanine Level</td>
</tr>
<tr>
<td>3:30-4:30pm</td>
<td>Trade Secret Law</td>
<td>Coolidge, Mezzanine Level</td>
</tr>
<tr>
<td>3:30-5:30pm</td>
<td>Chemical Practice/IP Practice in Latin America (Joint Meeting)</td>
<td>Virginia A, Lobby Level</td>
</tr>
<tr>
<td>3:30-5:30pm</td>
<td>Education/IP Practice in Europe (Joint Meeting)</td>
<td>Wilson A, Mezzanine Level</td>
</tr>
<tr>
<td>3:30-5:30pm</td>
<td>Law Practice Management /Law Students/New Lawyers (Joint Meeting and Reception)</td>
<td>Madison AB, Mezzanine Level</td>
</tr>
<tr>
<td>4:30-5:30pm</td>
<td>ADR</td>
<td>Coolidge, Mezzanine Level</td>
</tr>
<tr>
<td>4:30-5:30pm</td>
<td>Diversity in IP Law</td>
<td>Jackson, Mezzanine Level</td>
</tr>
<tr>
<td>4:30-5:30pm</td>
<td>Membership</td>
<td>Capitol Ballroom, Lobby Level</td>
</tr>
<tr>
<td>4:30-5:30pm</td>
<td>Public Education</td>
<td>Hoover, Mezzanine Level</td>
</tr>
<tr>
<td></td>
<td><strong>Friday evening events 8-10pm</strong></td>
<td></td>
</tr>
<tr>
<td>4:30-5:30pm</td>
<td>International Networking Reception</td>
<td>Washington Room 5-6, Exhibition Level</td>
</tr>
<tr>
<td>8:00-10:00pm</td>
<td>Dinner, Entertainment and Dancing (Black Tie Optional)</td>
<td>Marriott Ballrooms 1-3, Lobby Level</td>
</tr>
<tr>
<td>10:00pm-12:00am</td>
<td>Dessert Reception</td>
<td>Thurgood Marshall Ballroom, Mezzanine Level</td>
</tr>
</tbody>
</table>

In an uncertain legal environment, we are one law firm that is not content simply to accept the status quo. We work constantly to influence the evolving body of Mexico’s intellectual property laws, with the goal of ultimately bringing them in line with international standards. While we continue to make great strides in this regard, clients from all over the world rely on us to prosecute, manage, and defend their IP portfolios under the laws that exist today. In other words, we work effectively within the system, even as we seek to change it.

www.olivares.com.mx | Tel: +52 55 5322 3000 | olivlaw@olivares.com.mx