

SHORT PRESENTATION OF CURRENT SITUATION ON PATENT IN INDONESIA RELATED OF QUALITY MANAGEMENT SYSTEM

REGIONAL WORKSHOP,

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Presented by :

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OUTLINE

- The Law and Regulation
- Some aspects on substantive examination of patent application
 - Patent granting procedure
 - Number of Patent Examiner and their background
 - Examination, Classification, Communication

Vision

To become Internationally
standardized Intellectual
Property Office

Mission

DGIP administers the IP system by

☺ Delivering quality services,

☺ Promoting Intellectual Property,

☺ Providing Legal Assurance.

DJIP's strategic goals focused on three (3) major pillars which became core business of DGIP as a public servant in the field of Intellectual Property (IP). The three pillars mentioned above are :

1. Intellectual Property protection and law enforcement;
2. Legal assurance on intellectual property application;
3. Intellectual property online service with accurate application system and database.

The recent year highlights the improvement in the area of administration and management in DGIP through two programs, namely the implementation of IPAS (Industrial Property Automation System) and IMIC (Internal Management Improvement Competition) :

1. As a concept Industrial Property Automation System (IPAS) is a flexible, modular system that can be customized to individual industrial property offices to automate their IP business and administrative processes from application reception to registration, including post-registration actions such as amendments, assignment, renewal, annuities, etc.
2. This IMIC program aims to encourage entire working units of DGIP to develop and improve new working method and system in order to increase expected outcome.

1. Primarily the IMIC Program is intended to evaluate the system or process of internal performance management to achieve targeted outcome of which in the long run it will improve the deliverance of the quality of public service.

2. This IMIC Program encourages self-evaluation in which each unit make self-judgment concerning their own unit to identify the existing problems and issues and come out with their own solution. It required each member of the unit to participate in concluding existing problems and then brainstorm ideas, opinion to solve the problems.

There are several aspects to consider in proposing the solution for the improvement of internal management; quality, cost, delivery, safety, moral, and productivity.

In the assessment of the proposals these six aspects were given scores in order to determine the best proposal of the competition :

1. Quality : increasing the standard of the quality of outcome;
2. Cost : increasing budget efficiency in performing task;
3. Delivery : increasing efficiency in the performance of work in timely and accurately manner;
4. Safety : increasing cautiousness over the risk in the process of performing work to minimize the risks by providing prevention and other secure devices;
5. .

Lanjutan In the assessment of the proposals these six aspects were given scores in order to determine the best proposal of the competition :

5. Moral : building new and improved work ethic and culture;
6. Productivity : increasing productivity of each employee in general.

At the end of the competition the best proposal was rewarded a prize of conducting study visit to IP office in another country. The award was expected to induce each units to give their best efforts in achieving their best performance.

The LAW and REGULATION

- Law Number 14 of 2001 regarding Patent
- Government Decree Number 34 of 1991 regarding Patent Request Procedure
- Guide Line for Substantive Examination (Under Revision)
- Minister of Law and Human Rights Decree Number M.07-HC.02.10 of 1991 regarding Formation and Requirement of Patent Substantive Examination Request

Some aspects on substantive examination of patent application

1. An applicant should request for substantive examination with the payment fee before the examination be conducted. It means that the substantive examination system have deferred examination.
2. If the request for substantive examination has not been filed within 36 months from filing date, or the pertinent fee not been paid, the application should be deemed withdrawn.
3. For the simple patent application, the request of substantive examination filled at the same time with the filling of application or at least 6 months from filing date.

4a. To make the substantive examination efficiently, the DGIPR may request that an application filed with a priority rights also be furnished by the applicant with:

- (i) a valid copy of the documents connected with results of examination, and/or the patent document granted, and/or the decision of the rejection, and/or the decision of cancellation of the foreign application with respect to the first application;
- (ii) other documents required to facilitate an evaluation that the invention for which a patent is requested is indeed a new invention and truly involves inventive steps and industrially applicable;
- (iii) the said copies of documents may be furnished with separate additional explanations by the application.

- 4b. (i) for purpose of the substantive examination, the DGIPR may request experts assistance and/or utilize appropriate facilities from other government agencies or may request the assistance from examiners of other patent offices; and
- (ii) the use of expert assistance, facilities, examiners of the paten offices shall be performed by observing the provisions concerning the obligation to preserve it confidentiality.

4c. The application have to reply the examiner report normally within 3 months and it can be extended by request from application the next 3 months.

If the applicant does not reply, the examiner send the warning letter in the next step to applicant that he/she has to response.

If the applicant does not response that the application of patent shall be deemed withdrawn.

The decision of withdrawn could not be requested an appeal petitions.

6. The examiner can conduct hearing by applicant request in the time period of substantive examination before the final decision from examiner.

7. The application of patent can be claimed for product/an apparatus and/or process/method. The number of independent/dependent claims are not limited. If an applicant request a simple patent, the type of claim only limited for one independent claim regarding a product or/an apparatus and not limited for the number of dependent claim.

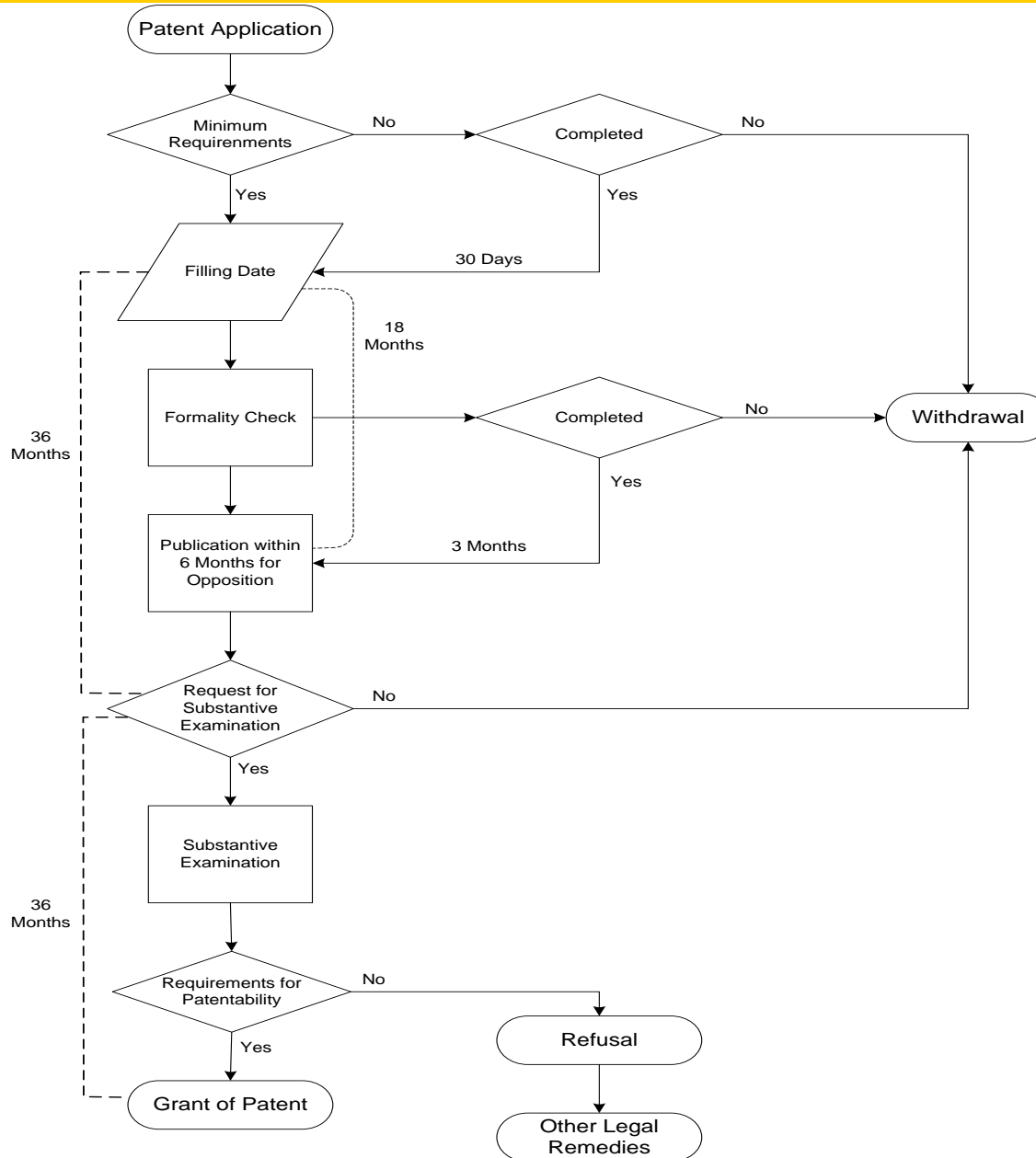
8. For the purpose of advisory service for applicants, especially to support for drafting of patent application, the DG IPR have periodically program together with the certain universities to conduct the certified training for IP consultant. The training basically comprise the patent drafting.
9. For the prior art searches, we use espacenet, patentscope, and othe on-line patent searching database via internet e.q. US Patents, EP documents, JPO, PCT(WIPO), etc.

Number of Patent Examiner and Their Background

Chemical	Pharmaceutical	Biotechnological	Electro/ Physic	Mechanical
24	15	5	21	25

In 2016, DGIP has 10 new examiners for 2 chemicals, 2 pharmaceuticals, 2 biotechnologicals, 1 electro, and 3 mechanicals background

Patent Granting Procedure





Examination Procedure

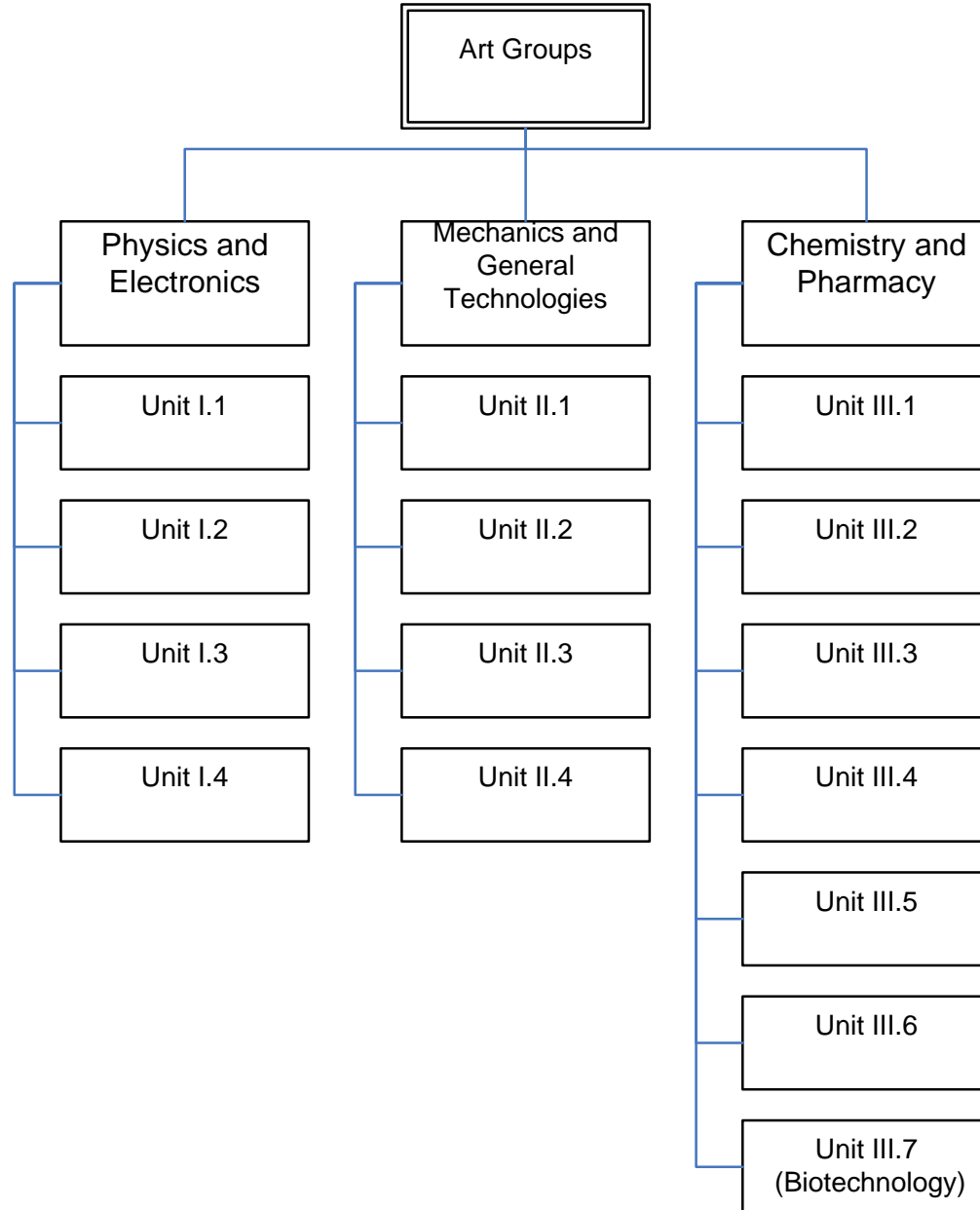
- Classification
- Assigned to an Art Group
- Assigned Within the Art Group to a Patent Examiner
- Search
- Review the Application
- Office Actions and Responses
- Final Step



Classification

- IPC
- By Patent Examiners

Art Groups





Search

- Patent Documents
- Non-patent References
- Indonesian IP Database
- Internet
 - Patent Databases
 - www.uspto.gov
 - <http://ep.espacenet.com>
 - www.wipo.int/pctdb/en/
 - Non-patent Databases



Review the Application

- Invention or not ?
- Not Patentable Invention ?
- Sufficiency and Clarity
- Claims
- Patentability Requirements
- Unity
- Etc.



Office Action

- Specifically states the point of rejection
- Should state clearly the parts of application that are objected, with page and line number citations
- Examiner may suggest changes to overcome the rejection
- In the case of rejection on basis of prior art, the prior art will be cited
 - and discuss the relevances of the prior art
- States the due date to response, usually 3 months



Response To Office Action

- Must address each and every point raised by the examiner
- May amend claims; arguments distinguishing the claimed invention from references are also included
- Changes to specification may be made, but “new matter” cannot be added to an application
- Applicant or Patent Attorney/Agent may conduct a telephonic or personal interview with the examiner
- A maximum 3 months to file a response, or the application will be deemed to be withdrawn



Response To Office Action (*cont'd*)

- If the response is not satisfied
 - Second and further office action may be issued
 - Rejection
- If the response is satisfied
 - Issuance of patent allowance



Invention

Article 1

Invention shall mean an Inventor's idea that is poured in any activity of solving a specific problem in the field of technology, either in the form of a product or process, or an improvement and development of a product or a process.



Patentability Requirements

- Novelty
- Inventive Step (Non Obvious)
- Industrial Applicability
- Must not fall under the Article 7 (Unpatentable inventions)



Novelty

The invention must not have been disclosed or available to the public at any time before the filing of the application.



Inventive Step/Obviousness

- Article 2(2)
 - An Invention shall be considered to involve an inventive step if said Invention does not constitute something that is obvious to a person skilled in the art.
- The obviousness standard prevents the patenting of relatively insignificant differences between the invention and the prior art.



Industrial Applicability

Article 5

An Invention shall be considered susceptible of industrial application if it can be implemented in the industrial as described in the Application.



Unpatentable Inventions

Article 7

- any process or product of which the announcement and use or implementation contravenes the prevailing rules and regulations, religious morality, public order or ethics;
- any method of examination, treatment, medication, and/or surgery applied to humans and/or animals;
- any theory and method in the field of science and mathematics;
or
- all living creatures, except micro-organism
- any biological process which is essential in producing plant or animal, except non-biological process or microbiological process.



Software-based Invention

- It is not included in Article 7
- But in the Elucidation of the Patent Law, A Computer Software per se is unpatentable



Software-based Invention (cont'd)

- Examination Guidelines
 - Computer software implemented in a hardware, resulting technical contribution over the prior art



Second Medical Use

- Invention: Product and Process
- Article 7: Unpatentable inventions
 - any method of examination, treatment, medication, and/or surgery applied to humans and/or animals
- Article 16: Rights of a Patent Owner
 - Patent for products
 - Patent for processes



Second Medical Use (cont'd)

- The Elucidation of Article 16
 - A Process includes “use”
- Examination Guidelines
 - Swiss-type Claim is OK
 - The use is novel and involves an inventive step



**THANK YOU
FROM INDONESIA**

<http://www.dgip.go.id/>