DIRECTOTARE GENERAL OF IPR
MINISTRY OF LAW AND HUMAN RIGHTS
REPUBLIC OF INDONESIA

PATENT EXAMINATION IN INDONESIA

WIPO Workshop on Effective Utilization of Search Results and Communications Derived from the Patent Cooperation Treaty (PCT) System in National / Regional Phase

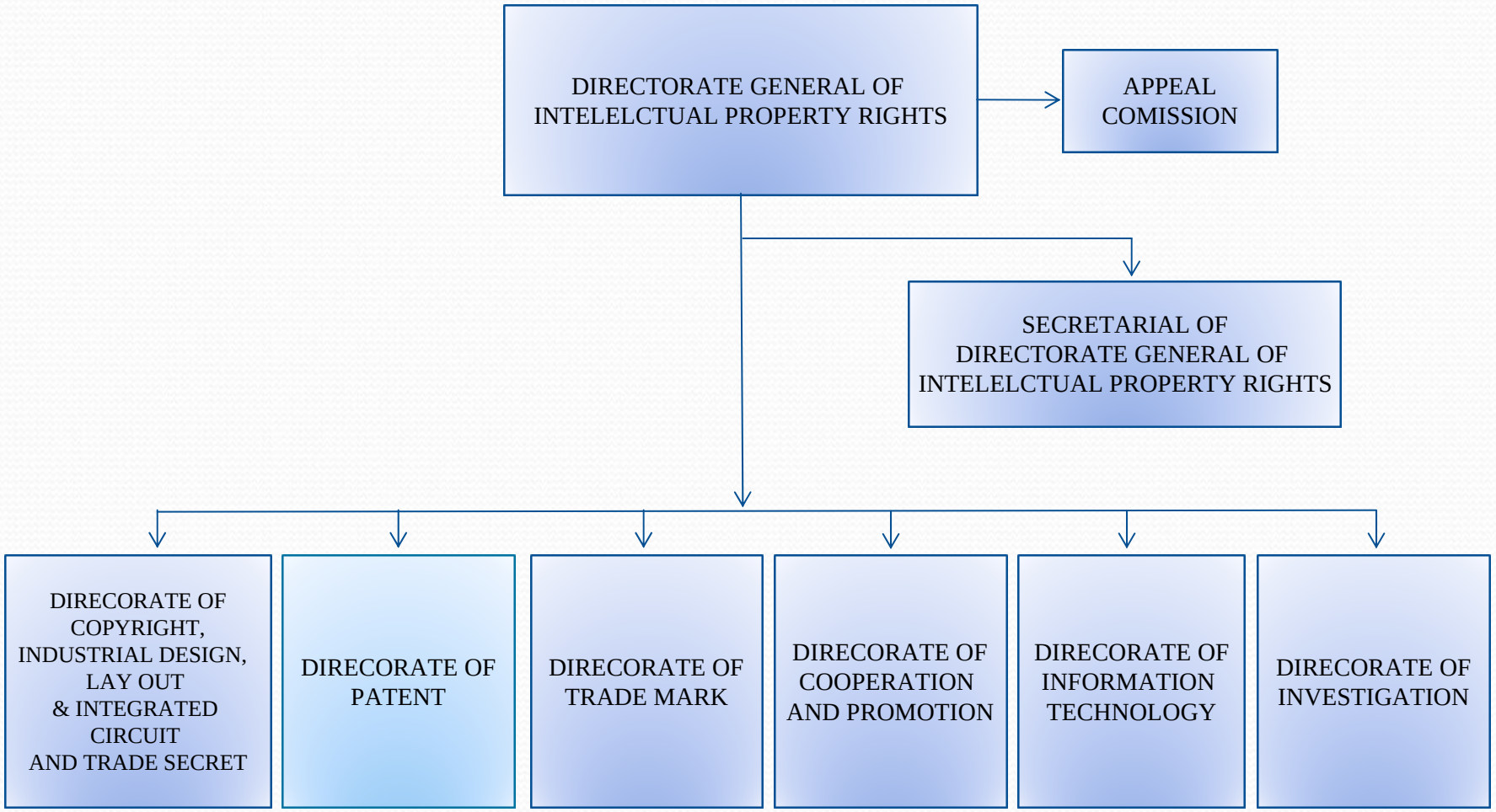
Outline

- The Regulations
- Organizational Chart
- Patent Examination Procedure
- Utilization of ISR , WO and IPER in National Stage
- Statistics

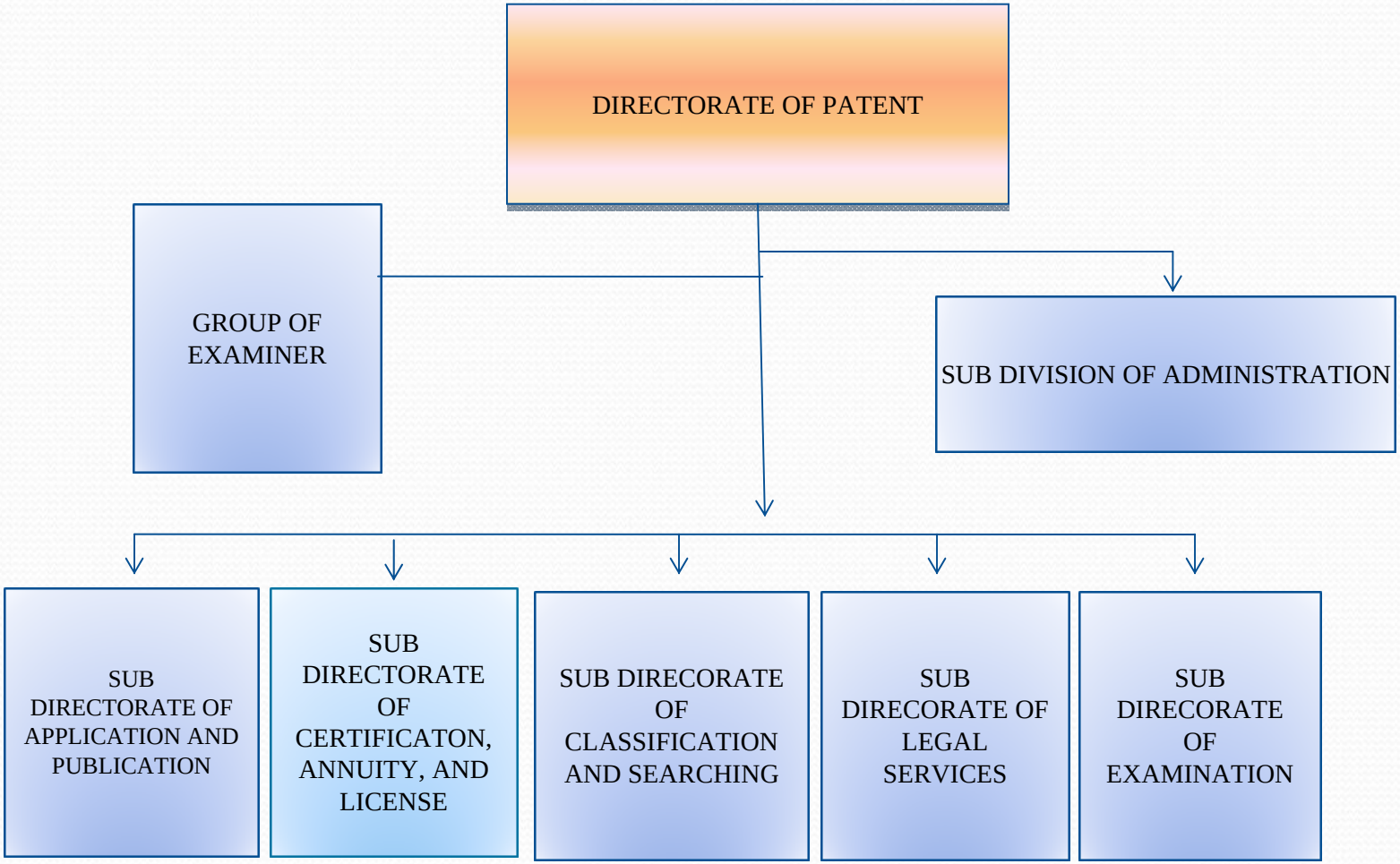
REGULATION

- Law No. 14 of 2001 regarding Patent
- Government Decree Number 24 of 1991 regarding Patent request Procedure
- Guideline for substantive Examination
- Minister of Law and Human Rights Decree Number M.07-HC.02.10 of 1991 regarding Formation and Requirement of Patent Substantive Examination Request

Organizational Chart



Directorate of Patent



Patent Examination Procedure

- Classification
- Assigned patent application to an Art Group
- Assigned Within the Art Group to A Patent Examiner
- Search the prior art
- Review the Application
- Office Actions and Applicant Responses
- Final Step

Classification

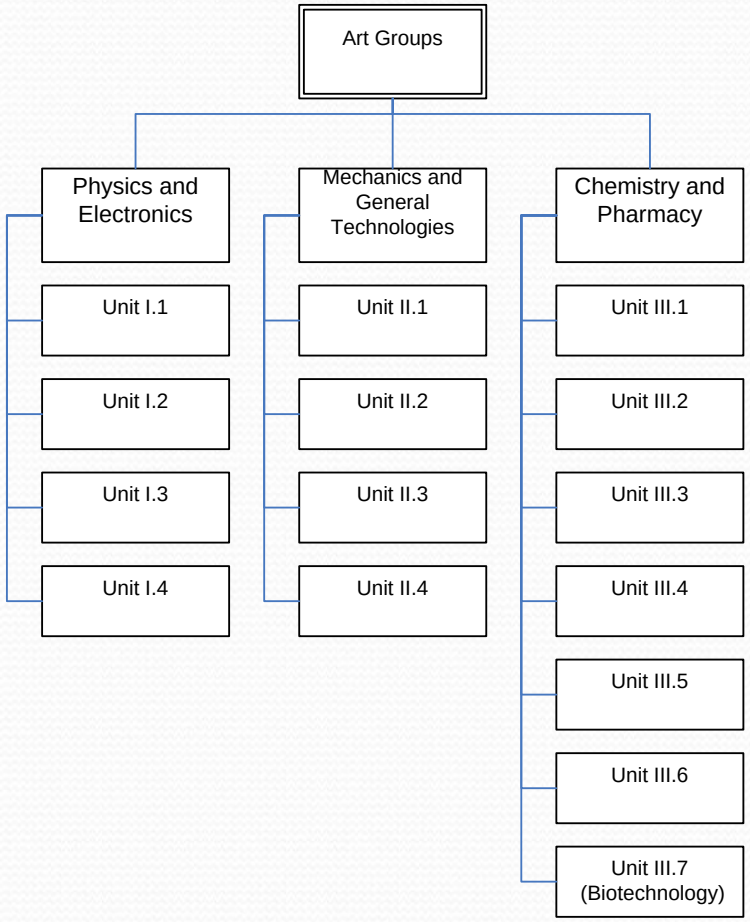
- Based on IPC 8th Edition
- Classification is done by junior patent examiner or classification section officer
- Once IPC is assigned, the senior senior patent examiner may be inspect the accuracy.
- Inaccuracy will lead to reclassification by senior patent examiner.

Search

- Search of the prior art will be done by patent examiner
  - Patent Document

    Patent Databases
    - www.uspto.gov
    - http://ep.espacenet.com
    - www.wipo.int/pctdb/en/
  - Non-Patent Document
  - Indonesian IP Database. (IPDL)

Art Groups


Art Groups
Physics and Electronics
Unit I.1
Unit I.2
Unit I.3
Unit I.4
Mechanics and General Technologies
Unit II.1
Unit II.2
Unit II.3
Unit II.4
Chemistry and Pharmacy
Unit III.1
Unit III.2
Unit III.3
Unit III.4
Unit III.5
Unit III.6
Unit III.7 (Biotechnology)

Review the Application

- Invention or not ? (Article 1 Law No. 14 of 2001)
  - 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.

- Not Patentable Invention ? (Article 7 Law No.14 of 2001)
  - 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.

Review the Application

- Patentability Requirements
  - Novelty
    - Article 3 (1)(2) 1 Law No. 14 of 2001
      - The invention must not have been disclosed or available to the public at any time before the filing date or priority date.
  - Inventive Step (Non Obvious) Article 2(2) Law No. 14 of 2001
    - 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 Law No. 14 of 2001
    - An Invention shall be considered susceptible of industrial application if it can be implemented in the industrial as described in the Application

Review the Application

- Sufficiency and Clarity
  - Examining the sufficiency of disclosure and clarity in description and claim.
  - All the findings will be notified to the applicant (Article 52 Law 14 2001)

- Unity of Invention
  - Article 21 Law 14 2001, Each Application may be filed for one Invention only, or a number of Inventions that constitute a unity of Invention. So that the application must be divided in order to get whole protection.
  - Request for the division must be filed no later than the original Application is granted a decision. (Article 36)

Software-based Invention

- It is not included in Article 7
- But in the Elucidation of the Patent Law, A Computer Software per se is un patentable
- Examination Guidelines
  - Computer software implemented in a hardware, resulting technical contribution over the prior art

Second Medical Use

- Invention : Product and Process
- Article 7: Un patentable 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

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 priort art, the priort art will be cited
  - and discuss the relevances of the priort 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

The Utilization of ISR , WO and IPER in National Stage

- For patent application with a priority right,where generally has done searches or even has done the substantive examination, or has given decision in another country then the patent examiner can refer to the search report or preliminary examination report or can refer to the decision which it can make examination more efficient and avoid duplication of work. (Article 28(2))

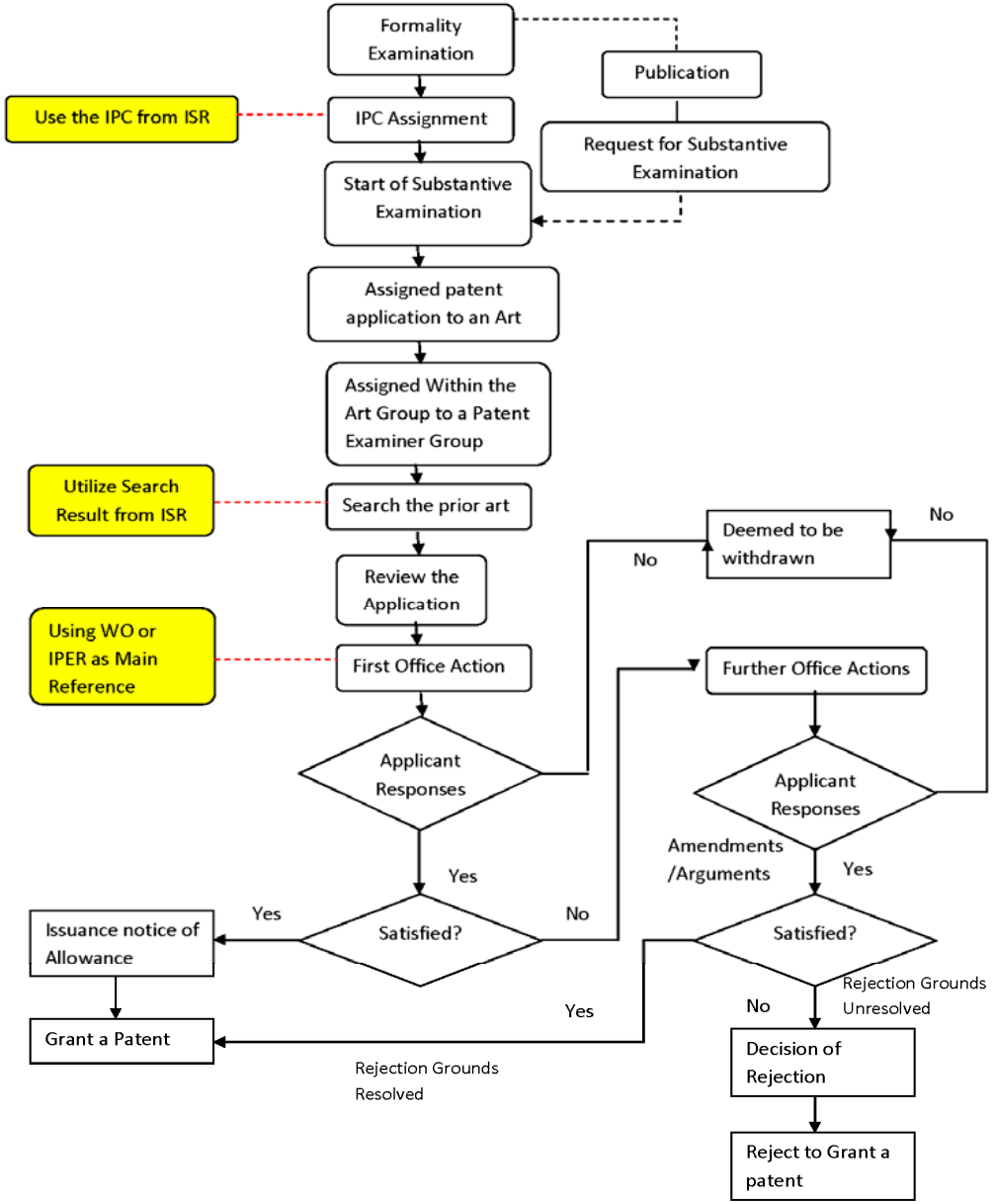
The Utilization of ISR , WO and IPER in National Stage

- **ARTICLE 28(2):**
- Directorate General may request the applicant filed with priority rights these include:
- A valid copy of letters that relating to the results
- The substantive examination of a patent application which is done the first time abdroad; a copy of a valid patent document which has been given in respect of the first paten application abroad
- A copy of a valid decision on the rejection of patent application the first time abroad where the patent application is rejected
- A valid copy of the relevant decision of cancellation of patent ever issued abroad when the patent is cancelled
- Other documents required to ease appraisement that the requested patent is indeed a new invention and actually contain an inventive step and industrial applicability

The Utilization of ISR , WO and IPER in National Stage

For PCT Application:

- Due to limited time to do the patent examination (36 months), examiners are highly recommended to utilize International search report, Written Opinion or international preliminary examination report and Examination Result from main patent office such as EPO, USPTO, JPO, IP Australia(examination guidelines)
- The Result of ISR from ISA usually use for determining classification and prior art search. IPC from ISR usually automatically will be assigned to PCT application, even though reclassification is still open to do.
- Written Opinion from ISA or IPER from IPEA usually will be use as main reference for determining patentability, but it is still remain as non binding opinion for the examiner. The patentability of the claims still need to consider Indonesian patent law (article 7)
- Notwithstanding with the Indonesian Patent Law, The Examination Result and Decision from main patent office can be used as ground to grant or reject a patent application,



Utilization of ISR , WO and IPER in Patent Examination

Patent Application Statistic

YEAR	PATENT				SIMPLE PATENT		TOTAL
	PCT		NON PCT				
	RO	DO/EO	Domestic	Foreign	Domestic	Foreign	
2001	4	2901	208	813	197	24	4147
2002	6	2976	228	633	157	48	4048
2003	0	2620	201	479	163	29	3492
2004	1	2989	226	452	177	32	3877
2005	1	3536	234	533	163	32	4499
2006	6	3805	282	519	242	26	4880
2007	5	4357	279	493	209	34	5377
2008	11	4278	375	469	214	34	5381
2009	2	3761	413	342	247	38	4803
2010	11	4596	497	401	251	38	5794
2011	8	4839	533	458	236	56	6130
2012	11	5471	601	680	219	51	7032
TOTAL	67	50757	4826	30144	3257	907	89957

Thank You
Arigatou Gozaimasu

www.dgip.go.id