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Re: Comments on Draft Manual of Patent Office Practice & Procedure, (Version 4.0, 2026)

Dear Controller General:

The Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the invitation to provide comments and suggestions on the *Draft Manual of Patent Office Practice & Procedure, (Version 4.0, 2026)* ("Draft Manual") published on August 19, 2026.

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers, and individuals in all industries and fields of technology that own, or are interested in, intellectual property (IP) rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP rights.

IPO's vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. IPO's mission is the promotion of high-quality and enforceable IP rights and predictable legal systems for all industries and technologies.

IPO recognizes the importance of the objective of the Draft Manual to update the procedures for the examination of patent applications to reflect developments in technology and the law. IPO hopes that its comments below will be helpful during the process of finalizing the Manual.

General Comments

The Draft Manual is a welcome and timely exercise that substantially reconciles practices with the Patents (Amendment) Rules, 2024, and recent judicial guidance. We particularly appreciate the revised treatment of divisional applications (following *Syngenta Limited v. Controller of Patents*), the streamlined Statement of Working (Form-27) requirements,[1] and the expanded discretionary power for extensions up to six months. However, to ensure the Draft Manual remains a practical guide without inadvertently creating new substantive or procedural requirements, we offer the following specific suggestions.

Clause 05.01 (Specification), Paragraph 4: Scope of Claim Amendments allowed under Section 59 of Patents Act

In practice, objections frequently reject amended claims merely because a feature was not separately recited in the original claims, despite being clearly disclosed in the complete specification. IPO recommends that the final Manual should reflect judicial interpretations (*Nippon A&L Inc. v. Controller of Patents* and *Allergan Inc. v. Controller of Patents*) by adopting an integrated reading of the claims and specification, avoiding a mechanical claim-to-claim comparison.

IPO suggests the following wording: "For the purpose of Section 59, the claims before amendment shall be construed in the context of the complete specification as originally filed and not in isolation from it. At the pre-grant stage, an amendment shall not be refused solely because the precise feature, limitation or subject matter incorporated in the amended claim was not separately or verbatim recited in the original claim set, where such matter is clearly and unambiguously disclosed in the complete specification and the amendment otherwise satisfies Section 59."

Clause 05.03.09 (Detailed Description of Invention), Paragraph 14: National Biodiversity Authority (NBA) Approval Requirements

We appreciate the updated reference to NBA approval or registration under the amended Biological Diversity Act, 2023.[2] However, Patent Office objections frequently issue a generic demand for NBA approval whenever any biological material is mentioned.

IPO suggests for consideration a nuanced decision framework for Examiners assessing:

[1] IPO would support the removal of the working requirement and its supporting statement, but appreciates the shift requiring the Statement of Working (Form-27) to be filed only once every three financial years. (Section 11.05) This removes a massive recurring administrative burden and better aligns India with global best practices for patent maintenance.

[2] More specifically, while IPO would support the deletion of the special disclosure requirements, it appreciates that the Draft Manual updates the earlier generic reference to "NBA approval" to reference the current law.

- Nexus with India: Ensuring the resource was accessed from India.
- Nature of the resource: Whether statutory exclusions or commercial procurement exemptions apply.
- Commercial procurement: If the material was purchased commercially from a marketplace, that should constitute sufficient ground for establishing an exemption from obtaining NBA approval. Applicability should be assessed by reference to source/origin, the statutory concept of access, the purpose for which the resource was procured or possessed, and the applicable exclusions. Where the material is a standard commercially procured input, the applicant should be permitted to explain the factual and statutory basis for its position, instead of having to obtain NBA approval.
- Acceptable proof: Distinguishing, separately for the relevant categories, the NBA approval order, Certificate of Registration, or other document that is sufficient for the Patent Office to move forward. Additionally, substantive examination should not be halted or refused solely because the external NBA regulatory process is underway.

Clause 06.01.01, Paras 8 and 9: Physical duplicates and refiling of material already in records

Certain provisions retain document-duplication requirements (e.g., refiling attested copies of parent Powers of Attorney or assignments for divisionals, or physical duplicates for post-grant oppositions). IPO suggests adopting a "file once, reference thereafter" principle. If a valid document is already in the electronic record, parties should identify the earlier filing rather than re-uploading, reducing administrative burdens.

Clause 09.01: Omnibus Extensions (Amended Rule 138) & Request for Examination (RFE) Timelines

IPO strongly endorses the expanded discretionary extensions up to six months. To preserve flexibility for aligning Indian prosecution with global search reports, IPO suggests explicit confirmation in the Manual that the Rule 138 omnibus extension can be utilized to extend the new 31-month RFE deadline.

Clause 09.03.02 (Novelty): Individual claim elements

The Draft Manual states that if the invention "or any of its claimed elements" is found in the prior art, the invention is not novel. IPO suggests deleting the words "or any of its claimed elements," to be consistent with settled anticipation tests and rules against mosaicing for novelty, as novelty requires the prior art to directly and unambiguously disclose every essential feature of the claimed combination.

Clause 09.03.03.02 (Determination of Inventive Step), Paragraph 4: Sufficiency of "analogous field" to combine prior art

The Draft Manual permits mosaicing if prior arts are from "analogous fields." Treating analogousness as sufficient, however, risks hindsight bias. IPO suggests that Examiners must identify an objective reason or lead that would have prompted the skilled person to combine the teachings at the priority date without knowledge of the claimed invention.

Clause 09.03.05.04 (Section 3(d)): Original disclosure and subsequent evidence

The phrasing regarding efficacy "subsequently by way of an amendment" may imply that applicants can invoke Section 59 to introduce new technical efficacy data. IPO suggests distinguishing between (i) technical disclosure/basis for efficacy, which must be in the application as filed, and (ii) subsequent evidence/experimental data that merely corroborates an effect already derivable from the original specification.

Clause 09.03.05.05 (Section 3(e)): "Synergy" as an additional statutory requirement

The Draft Manual requires a "synergistic effect" for all mixed substances. IPO suggests synergy should not be an absolute requirement in every case; functional reciprocity or a technically meaningful interaction establishing the subject matter is not a "mere admixture" should also suffice.

Clause 09.03.05.10 (Section 3(k))

Claim-format exclusions

The Manual categorically excludes computer program products, storage media, and databases, contradicting the 2025 Computer Related Inventions ("CRI") Guidelines' focus on "form and substance." IPO suggests removing blanket format exclusions and adopting a single technology-neutral test assessing whether the implementation provides a specific technical solution/effect.

Examples of patentable Artificial Intelligence (AI) and Machine Learning (ML) inventions

To solidify the standard from *Microsoft Technology Licensing LLC v. Assistant Controller*, IPO recommends adding non-exhaustive examples of patentable AI/ML innovations (e.g., novel neural network training, LLM architectures, on-device machine learning implementations).

Absolute bar on business methods

The quotation from *OpenTV* asserting an "absolute bar without analyzing issues relating to technical effect" is not consistent with the *Microsoft* precedent. IPO requests this quotation be struck or subordinated to the "technical effect" analysis.

Clause 09.03.07 (Sufficiency of Disclosure)

IPO recommends amending Clause 09.03.07(b) to read “the subject matter is fully and particularly described in the specification to enable a person skilled in the art to work the invention without any assistance of the patentee or any further undue experimentation,” as directed by section 4.4 of the 2025 CRI guidelines.

Clause 09.04, Paragraph 9: Second Examination Report

The Draft Manual mandates an SER whenever claims are amended, creating a prosecution stage not prescribed by the Rules. The introduction of a routine or mandatory SER creates an unprecedented stage of prosecution that increases overall prosecution time and adds substantial financial burden. Respectfully, this added procedural layer is inconsistent with Section 12 of the Patents Act, which does not contemplate an automatic re-examination stage upon every claim amendment. IPO respectfully requests removing the SER as a mandatory stage, or clarifying that it is strictly discretionary, does not suspend Section 21 deadlines, and remains aligned with statutory limits.

Clause 06.01 (*Divisional Application*) & Clause 09.06 (*Grant of Patent*): Procedural Window for Filing Divisional Applications Prior to Issuance

Under current practice, the Controller’s decision to grant a patent and the actual issuance occur concurrently. This leaves applicants no opportunity to review the final allowed claim set before deciding whether to file a divisional application, forcing 'blind' filings. Because Indian divisional practice under Section 16 is particularly restrictive regarding maintainable subject matter, certainty regarding the precise scope of granted claims is essential prior to filing.

IPO respectfully requests the introduction of a procedural window prior to patent issuance. Specifically, we suggest either:

- Establishing a fixed time lag (e.g., 30 to 60 days) between the Controller's decision to grant and the final issuance of the patent certificate; or
- Modifying practice to issue a formal 'Notice of Intent to Grant,' which triggers a minimum waiting period before grant recordal.

Either mechanism would provide applicants with a defined window to assess allowed claims and file necessary divisional applications with clarity.

Clause 22.03 (Petition for Extension of Time): Filing request under Rule 138

The Draft Manual states requests for extension must be filed "before expiry of the time limit prescribed under the relevant Rules." This defeats the newly introduced power to condone delay after a deadline expires. IPO suggests using a single formulation that accurately reflects amended Rule 138's outer six-month condonation mechanism, and including a consolidated table identifying which deadlines are extendable under specific rules as compared with Rule 138.

IPO thanks the Controller General for its attention to IPO's comments submitted herein and welcomes further dialogue and opportunity to provide additional comments.

Sincerely,

John Cheek
President