

**Philips Intellectual Property & Standards**

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Subject: Comments on draft guidelines for  
computer related inventions

Date: 2013-07-26

To:

The Office of the Controller General of Patents, Designs & Trade Marks  
Bhouthik Sampada Bhavan,  
Antop Hill, S. M. Road,  
Mumbai - 400 037

Dear Sir/Madam,

In response to your call for comments/suggestions on “**the draft guidelines for computer related inventions**” we hereby submit our comments on behalf of Philips Electronics India Ltd.

## **1.0 General remarks**

The draft guidelines attempt to interpret and apply Section 3(K) in a restricted manner, particularly with regard to the interpretation of the term “Per se”. This creates a major concern for us. The revised manner of examining Section 3(k) requirements is not aligned with major or established jurisprudence in other major patent jurisdictions. It is possible to apply Section 3(k) such that the requirements of Article 27(1) WTO TRIPs Agreement<sup>1</sup> are met and at the same time it does not prevent granting patents to technical inventions, even when they are implemented by means of software.

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<sup>1</sup> Article 27 WTO TRIPs Agreement  
Patentable Subject Matter

1. Subject to the provisions of paragraphs 2 and 3, patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application.<sup>5</sup>  
Subject to paragraph 4 of Article 65, paragraph 8 of Article 70 and paragraph 3 of this Article, patents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology and whether products are imported or locally produced.

The draft guidelines suggest to first identify the core inventive aspect in the computer related inventions, subsequently to apply Section 3(k) on this identified core inventive aspect, and then finally to identify the technical nature in the inventions only when the core inventive concept passes the application test. This restrictive manner of evaluating patentable subject matter introduces subjectivity and thus the possibility of introducing knowledge from prior arts in subject matter evaluation. Whether or not a computer related invention covers patentable subject matter is a question of law, and to analyse that, an evaluation of the invention as a whole (as claimed) seems to be more appropriate than a rather narrow evaluation of the core inventive aspect.

Method claims applicable to any other application domain derived from algorithms should be allowable, as long as these method claims are technical in nature in that they involve a solution to a technical problem<sup>2</sup>, defined by technical features<sup>3</sup>. Further, process limitations in the form of novel hardware features should not be made mandatory for such claims to be patentable. Patents may be awarded for inventions that are novel, inventive and industrially applicable, as long as the inventions are of a technical nature. From this perspective, method claims that satisfy these three filters for patentability and contain a technical feature should also be patentable, independent of their area of application.

If the claim is directed towards a technical invention involving a technical problem and a technical solution, then the claim should be allowable even though the invention may be implemented by means of software. As an instance, the claimed subject matter could process physical data and not mere abstract data. The physical data should represent physical entities rather than mere numbers, e.g. image data, audio data, sound data etc. The claim should be allowable if it is novel, inventive and industrially applicable. There should be some technical character involved which acts on the physical entity and changes the physical entity. For example a new operating system could make a computer novel. There could be a program that makes certain changes in the file organization, or memory organization when the program is run. Software should be patentable if it has a technical character. The technical character could be derived from a further technical effect; e.g. a technical effect produced by a program when run on a computer, which goes beyond normal interactions between programs and the computer. Examples could be control of a chemical process in a refinery; control of certain internal functions of a computer, control of an automated industrial process; It should also be submitted that the claim should be allowable if it has the potential to produce the technical effect and does not operate on mere abstract number but on physical entities. It would be good if parallels could be drawn with a few EPO case laws such as T38/86, T 158/88 and T 154/04.

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<sup>2</sup> See e.g. Rule 5 PCT The Description

5.1 Manner of the Description

(a) The description shall first state the title of the invention as appearing in the request and shall:

(i) specify the technical field to which the invention relates;

(ii) ...

(iii) disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state the advantageous effects, if any, of the invention with reference to the background art;

<sup>3</sup> See e.g. Rule 6 PCT The Claims

6.3 Manner of Claiming

(a) The definition of the matter for which protection is sought shall be in terms of the technical features of the invention.

## **2.0 Specific remarks with regard to the draft guidelines:**

2.1 We agree that the examples mentioned in Section 4.1 of the draft guidelines are indeed not patentable.

2.2 The example cited in Section 4.3 of the draft guidelines may lack technical features resulting in new and non-obvious technical invention, and may not be patentable indeed. However the opening sentence which reads, “The claims relating to computer program product are nothing but “computer program per se” is not correct, in our opinion. We believe that if the computer program product claim defines a technical invention whose novelty and non-obviousness result from technical features, it should be patentable.

Further, it would be odd to allow a claim on a device that, if programmed by this computer program, is a technical invention that is new and non-obvious as a result of technical features being listed in the claim, and to allow a claim on a method which is carried out by this technical device, but to refuse a claim on a computer program product that has the very same technical features as the technical device and the technical method.

2.3 The opening sentence of Section 5.0 is fully correct which reads as:

“The examination procedure of patent applications relating to computer related inventions is common with other inventions to the extent of considering novelty, inventive step and industrial applicability.”

We believe Section 5.0 to be correct up to and including sub-section 5.4.4. However, a serious problem arises in sub-section 5.4.5 when it recites: *“The question therefore is whether a computer program loaded on a general purpose known computer or related devices can be held patentable. Keeping in view the spirit of The Patent Act 1970, the answer is in the negative.”*

This we strongly believe, is the wrong approach: here the proposed interpretation of the patent law starts from the exclusion of computer programs, **broadened by ignoring the “per se” limitation** and then expanding that broadened exclusion to devices programmed by the computer program. A proper interpretation of the applicable law starts from the general principle that all technical inventions (i.e., inventions that are new and non-obvious as a result of technical features) are patentable, and the exclusion of *computer programs per se* must be read in the light of that general principle.

So, whether a claim on a computer program loaded on a general purpose known computer or related devices can be held patentable is a question that can only be answered after having considered whether this claim defines a technical invention ( i.e., an invention that is new and non-obvious as a result of technical features) or whether it is merely a non-technical computer program running on existing technology that cannot result in a non-obvious technical invention.

2.4 In sub-section 5.4.5, the next sentence also, we believe is wrong which reads as:

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“In an application for patent for a new hardware system, the possibility of a computer programme forming part of the claims is not ruled out. The examiner is to carefully consider as to how integrated is the novel hardware with the computer programme.”

This sentence suggests that patentability may only result from new hardware. This is not true: if old hardware is used in a technically new and non-obvious way, then we have a patentable technical invention in view of Article 27(1) WTO TRIPs agreement.

For the very same reasons, sub section 5.4.6 of the draft guidelines is, we believe, wrong too.

2.5 In sub-section 5.5.8, illustrations 1 and 3 are correct (for illustration 2 insufficient details about the features listed in the claim are provided to assess whether it is correct). As regards illustrations 4 – 8, we could not find new technical features either. As regards illustration 9, insufficient details are mentioned to be able to assess whether the claim was new and non-obvious as a result of technical features, while the approach seems wrong as it starts from the exception read out of context (the outcome may be right, but that cannot be checked). As regards illustrations 10 and 11, we could not find any new technical features either.

2.6 Section 7 again contains, what we believe is, a fundamentally wrong statement: “Further, if the specification supports implementation of the invention solely by the computer program then in that case means plus function claims shall be rejected as these means are nothing but *computer program per se*. If this input to the skilled person is enough that he can implement the algorithm on the general purpose computer and get the invention working, then it should be considered as an enabled invention.”

The question that should be asked is whether we have a new and non-obvious invention as a result of technical features; a computer program may perfectly result in patentable technical invention. Again, the words *per se* are not given its proper weight, and again, the exception is read out of context and broadened to affect all inventions in which a computer program is used.

While we disagree with these Guidelines on matters of principle, it does not mean that the outcome will be different, as many examples mentioned in the draft Guidelines would also be held un-patentable when the exceptions of section 3(k) are read in the context of Article 27 WTO TRIPs Agreement, which is the approach advocated by us.

Also illustrations 12 and 13 are indeed not patentable. However, the patentability of illustration 14 can only be determined after considering the prior art, as this claim contains many technical features that may result in novelty and non-obviousness. We respectfully submit that The Controller’s approach is incorrect as it looks for new hardware, while the claim should be examined as to whether new technical features are present.

2.7 The flowcharts on pages 44-46 are wrong as the wrong questions are asked. The examiner should not search for the presence of excepted subject matter in a claim to reject the claim, but should check whether the claim as a whole defines a technical invention for which it holds that novelty and inventive step result from technical features. In that context, features

that are a mathematical or business method or listed in sections 3(l) – 3(m) of the act, are clearly not patentable, but the claim may still be patentable if there are other, technical, features that result in novelty and non-obviousness.

As regards the *computer program per se* or algorithms in section 3(k), there is no categorical exclusion: what matters is still whether the claim as a whole is patentable as a result of technical features that result in novelty and non-obviousness, noting that in principle, any perfectly patentable method is an algorithm because any perfectly patentable method is a process or set of rules to be followed in problem-solving operations. So, examiners should not focus on whether a claim contains an algorithm, but on whether the claim defines an invention in a field of technology, reciting technical features that result in novelty and non-obviousness. While a *computer program per se* is excluded, computer programs not per se are not excluded, so that claims should not be rejected if they contain a computer program; instead, the claim should be examined as to the presence of technical features that result in novelty and non-obviousness.

## **2.0 Additional remarks:**

From reading the above, it will be clear that we have relied, broadly speaking, on a European patent attorney's approach. However, we still believe that our approach is sound in India as well, as our context is the same: Europe too is bound by the WTO TRIPs Agreement, EPC Article 52(1) (European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step) quite nicely matches Article 27(1) WTO TRIPs Agreement, and Europe too has a list of exceptions in Article 52(2) EPC that are not patentable, including discoveries, scientific theories and mathematical methods; aesthetic creations; schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers; and presentations of information.

So, the European Patent Office (EPO) too had to find its way to comply both with Article 52(1) EPC and Article 52(2) EPC, and the result is the approach outlined above.

Clearly, while this EP approach differs from the approach in the draft India (IN) guidelines, many examples of not-patentable inventions listed in the draft IN guidelines are equally un-patentable in Europe. However, whenever the claim as a whole defines technical features resulting in novelty and non-obviousness, a European patent can be granted, and we believe that the same should apply in India as the legal context is the same. Further, EPO praxis is not the only way to do this but it is considered an advanced system and used by many other jurisdictions and is guiding. Further, EPO sets these criteria in a sense of common denominator for these interpretations that are acceptable to many other patent offices worldwide.

Recently, on March 8, 2013, the Canadian Intellectual Property Office (CIPO), which was also following guidelines similar to the draft guidelines, published a new set of guidelines more aligned with the EPO approach of evaluating computer related inventions after the decision of the Federal Court of Appeal in *Canada (Attorney General) v Amazon.com Inc.* 2011 FCA 328 [Amazon FCA].

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#### **4.0 Conclusion/submission:**

We hold the opinion that a software program having a technical effect and providing a technical solution should be allowable without any hardware restriction if the claimed subject matter is novel and produces a non-obvious technical effect which contributes to the state of the art. A software program producing a technical effect or a software program having technical character is allowable in the EPO. We hold the opinion that it would be good to adopt some of the EPO patent practices built on Articles 52(1), 52 (2) and 52 (3) where similar provisions exist to examine and grant patents for software related inventions or to introduce objective criteria rather than subjective criteria in evaluating patentable subject matter in computer related inventions.

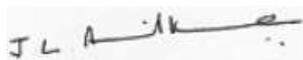
We hope that the Indian Patent Office would give due considerations to our submissions and effect necessary revisions in the draft guidelines for computer related inventions in the interest of the software industries which rely on software technologies.

We look forward to work with the Controller General on this edition and further revision if they occur. Kindly feel free to contact us as and when needed for any further clarification or discussion on our submissions.

We would be honored to be of service to the Office of the Controller General and the Government of India in an ongoing consultation on IP Rights Policy and practice in India.

Thanking you,

Yours Sincerely,



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Head of IP&S India

Philips Intellectual Property & Standards

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