

July 26, 2013

To:

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

Dear Sir,

**SUB: Comments on The Draft Guidelines for Examination of Computer related Inventions  
(CRIs)**

We appreciate the various initiatives that are being undertaken by the Controller General and officers of the Patent Office in improving various functions, processing of the patent applications and efforts for bringing more transparency and clarity. One such important initiative taken is providing the draft guidelines for examination of Computer related inventions (CRIs) and inviting the observations of stakeholders on the same. Taking this opportunity with sincere gratitude we provide our comments below for your kind consideration.

Thanking you,

Yours faithfully,

KRISHNA & SAURASTRI ASSOCIATES

**COMMENTS ON THE DRAFT GUIDELINES FOR EXAMINATION OF COMPUTER RELATED  
INVENTIONS (CRIs)**

We provide below our comments which relate to the technical matter as well as those which are non-technical in nature:

**A. TECHNICAL COMMENTS:**

**1. Point 5.4.5 (page 20):**

Our Comments:

Essentially, all computer programmes need a combination with some hardware for its functionality. Does it imply that all such programmes can be considered as away from the purview of computer programme per se? The question therefore, is whether a computer programme loaded on a general purpose known computer or related devices can be held patentable. Keeping in view the spirit of law the answer is in the negative. 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 **novel is the integrated integration is of** the ~~novel~~ hardware with the computer programme. Further, whether the machine is programme specific or the programme is machine specific is important to ascertain. This requires critical care of the Examiners.

**2. Point 5.4.6 (page 20-21):**

Our Comments:

**A Any** computer programme which may work on ~~any a~~ general purpose known computer does not meet the requirements of the law. For considering the patentability of computer programme in combination with hardware features, the hardware portion has to **solve a technical problem in a novel way resulting in a technical advancement of known** ~~be something more than~~ general-purpose machine. In cases where the novelty resides in the device, machine or apparatus and if such devices are claimed in combination with the novel or known computer programmes to make their functionality definitive, the claims to these devices may be considered

patentable, if the invention has passed the triple test of novelty, inventive step and industrial applicability.

**3. Point 5.4.7 (page 21):**

Our Comments:

It is important to note that the term per se has been suffixed to the computer programme alone. Therefore, if the invention is relating to mathematical method, business method or algorithm, they are considered to be non-patentable by direct application of law. However, if a claim of an invention is oriented towards a novel, inventive and industrially applicable ***integration of a*** computer or related device **along** with the programme for defining its functionality, then it may be considered to be patentable.

**Important observation:**

***It has been depicted in the illustrations of the draft guidelines that use of conventional hardware does not amount to any technical advancement. This appears to be in contradiction to the purpose of research and development in any technical domain, especially research and development intending to provide cost effective solutions to various problems with minimal or no change in the existing hardware.***

**4. Point 9 Flowchart (page 43)**

Our observation:

The draft guidelines suggest that a novel hardware has to be involved in combination with a computer programme for patentability. In any case, novelty which is the first criteria of patentability (under section 2(1)(j)) will always be brought in question by the Examiner on basis of the prior arts. It would be unreasonable if the novelty for hardware is checked separately (referring to 5.4.5 and 5.4.6 of the draft guidelines for CRI on pg. 20) just because the subject matter is a computer related invention. (Referring to the flowchart on page 43, in step 4 and step 6)

**B. NON-TECHNICAL COMMENTS:**

1. The examples provided in the draft guidelines only indicate the type of claims that may not be granted, but to bring clarity it shall be appropriate to provide examples of claims that will be allowable.

**C. CONCLUSION:**

1. We believe patents are granted for encouraging innovations and as very rightly acknowledged in the introductory part of the draft guidelines that information technology has emerged as a vital tool for scientific development, it is essential to protect computer related inventions for encouraging innovations.
2. To bring point 1 above in perspective, we would like to bring to your kind notice that in some of the Asian countries like China, Taiwan, Korea and Japan the patenting of software, as such is prohibited, but when the claims recite the use of software working in concert with specific hardware, particularly when the invention resolves a technical problem and achieves a technical result, the invention may be allowable.