

**RESPONSE TO GUIDELINES
FOR EXAMINATION OF
COMPUTER RELATED
INVENTIONS**



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Response to Draft guidelines for examination of computer related relations (CRIs) published by the Indian Patent office on June 28th 2013.

We commend the Controller General of Patents, Designs and Trademarks and his team at the Indian Patent office for all efforts taken to bring in transparency in examination procedure of various technical fields. It is important to bring synergy between the practitioners of IP and the authorities empowered with granting rights, to reduce unprecedented delays to a significant extent. In this continuous effort, we welcome the controller's initiative in bringing out guidelines relating to Computer Related Inventions (CRIs). India being the innovation hub for CRIs, it is important to promote technology in that field and suitably grant patents to genuine inventive ideas. This becomes important since the inventive ideas originating from Indian inventors are also making their mark in the international market.

The following are our observations and comments to the guidelines issued:

1. We thank the Indian patent office for providing detailed definitions for various concepts related to CRIs. They bring much clarity to what is being attributed when examining patent applications.
2. With respect to the statutory amendments mentioned in the guidelines and reinstating the phraseology of Section 3(k) to retain the original scope of exclusion, it is still not clear as to what is the interpretation of the phrase "manner of manufacture or capable of

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industrial production” as applied to CRIs. It is not clear under 5.4.1 how patent office ascertains this either.

3. Reading definition 3.10 along with 3.11 clearly identifies that a computer program working in isolation or by itself devoid of any connection is the exclusion stated under S.3(k).
4. Does this mean that a computer program working in connection with other things may not be excluded from patentability under S.3(k). The subsequent sections of the draft guidelines that exclude computer program working on general-purpose computers conflicts with 3.10 and 3.11.
5. In 3.16 of the guidelines relating to definition of technical advancement a statement that reads “Technical advancement comes with technical effect, but all technical effects may or may not result in technical advancement” lacks illustrations/examples to distinguish technical effect that constitute technical advancement.
6. Section 4 of the guidelines provides categories for CRIs that relate to method/process, apparatus/system, computer readable medium and computer program product. It is not clear whether the examples provided under the categorization are decided cases or hypothetical illustrations.
7. Section 5.3 about industrial applicability, the illustration provided relating to a method of contraception is an unrelated subject matter. It is not clear how industrial applicability is determined specific to CRIs. This uncertainty is further highlighted in the paragraph “The determination of industrial applicability in case of CRIs is very crucial since the inventions relating to these categories of exclusions are considered abstract theories, lacking in industrial application”

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8. We recommend that illustrations/examples of either hypothetical situation or decided cases that exemplify the industrial applicability of CRIs would be resourceful as guidelines. The Manual of Patent Office Practice and Procedure does not provide additional information specific to CRIs.
9. The Illustrations provided to determine the excluded subject matter under Section 5 of the guidelines do not provide citations to cases. Citing the case numbers will help the practitioners to study the patent application and understand the controller's decision.
10. Section 6 of the guidelines referring to "form and substance" and section 7 referring to means plus function provides illustrations that specifically point exclusively to computer programs.
11. Illustration provided under Section 8 of the guidelines refers to specific claims rather than the subject matter itself that were refused grant. Hence it is not clear as to what are the guidelines for examining CRIs related to bio-informatics and biotechnology.

CONCLUSION:

We are of the opinion that although the Guidelines provide a first attempt at bringing clarity regarding the Subject matter, it needs to distinguish the non patentable subject matter much more rigorously, in the absence of established case laws to determine patentability. Further, it is important to encourage inventions, specifically, in the field of information technology (IT), which includes the computer related inventions. Since India is heralded as the IT hub unless we encourage local inventions and provide the same with adequate protection, we may not promote growth of IT giants like Google, IBM and Microsoft. **We hope that the Controller**

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General considers these recommendations and we urge the Controller General to call a meeting of all stakeholders in the field prior to implementation of the guidelines.

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