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AAM/MJ/GF/1863

July 26, 2013

The Controller General of Patents, Designs and Trademark
Office of the Controller General of Patents
BoudhikSampadaBhavan
S M Road, Antop Hill
Mumbai-400037

via email only

Respected Sir,

Re: Comments on Draft Guidelines for Examination of Computer Related Inventions (CRIs).

Please find our comments in respect of Draft Guidelines for Examination of Computer Related Inventions (CRIs).

We expect that you will consider our comments before finalizing the said guidelines.

Thank you,

Yours Sincerely,


(A.A. MOHAN)
Founder,
Mohan Associates

Encl.:
Our Comments
Cc:

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Mr. Chaitanya Prasad, I.A.S.,
Controller General of Patents, Trade Marks & Designs,
Mumbai
Encl.: Our Comments

**COMMENTS ON PROPOSED GUIDELINES FOR EXAMINATION OF
COMPUTER RELATED INVENTIONS**

1. MATHEMATICAL METHOD

The patent office has defined the mathematical method as mental faculty. Further, it has been defined that the mathematical methods are used for writing algorithms and computer programs. Furthermore, the guidelines indicate that a mathematical method claimed in any form is not patentable.

In this regard, we herebelow provide the reasoning given in the EPO for adjudicating mathematical methods, accordingly, we here below take the Viacom case decision as reference to understand as to what can be objected under a mathematical method.

It is in Europe, one of the first major case laws was of VICOM, in which the board set out the principles governing the patentability of computer-related inventions. ***The Board held the fact that the idea or concept underlying the subject-matter of a claim resides in a mathematical method does not necessarily mean that the claimed subject-matter is a mathematical method "as such"***, "Decisive is what technical contribution the invention as defined in the claim when considered as a whole makes to the known art". This technical contribution test established in VICOM therefore moves the essential enquiry away from the fact that one is dealing with an invention based on a computer program /mathematical method to a consideration of the kind of technical effect which the invention as a whole produces in the device in which it operates and emphasized that the intention of article 52(2) and (3) is not to exclude all computer programs/mathematical methods from patentability.

From the decision it can be clearly understood that the bench mark for adjudicating the claims as falling under mathematical method should be considered based on invention as a whole and not merely by one step which relates to some form of mathematics.

Accordingly, based on the guidelines, it can be inferred that the following are the characteristics of a mathematical method:

	CRI Guildlines	Inference
1.	Mental Faculty	Devoid of any technical application and the entire method must be performable only by a human being and not by a machine
2.	<i>“A method of calculation, formulation of equations, finding square roots, cube roots...etc.”</i>	The purpose of the invention is to solve a mathematical problem only.
3.	<i>“A method of calculation, formulation of equations, finding square roots, cube roots...etc.”</i>	While solving the mathematical problem, the invention involves operations on numbers, wherein the output results in only numbers.

Based on these inferences drawn from the guidelines, it can be established that a mathematical method is a mere application of mind to operate merely on mathematical expressions to obtain output, which still remains a mathematical expression.

On the other hand, if the invention is realized by any means and if the output manifests any physical transformation in the real world, such inventions do not fall under the purview of mathematical method and such claims should be patentable.

2. BUSINESS METHOD:

According to the guidelines, “business methods” mean “**methods** of **transaction** of goods or services”. The manual further states that activities such as B2B business **transactions** and B2C business **transactions** would fall under the category of business methods and hence, would be considered as non-patentable subject matter.

Now coming to the dictionary meaning of the term **transaction**, it can be noticed that transaction is defined as “a process between a **buyer** and a **seller** to **exchange** an **asset** for **payment**”.

Keeping in view the above, it can be noticed that the guidelines clearly teaches that “when a claim relates to a **method** which improves the process of **selling** **(or alternatively purchasing)** of the goods or the services”, a **prima-facie** case to object the claimed method as non-patentable arises.

The criteria for a method claims falling under “business method” is as follows:

- a) Method involving financial transaction
- b) Method steps claiming monopoly over the trade or the new business strategies
- c) Output resulting in claiming monopoly of a new type of carrying out business / trade / financial transaction...etc.
- d) Method increasing the revenue

However, any method or system, which do not fall under any of the above mentioned criteria should be patentable.

3. Algorithms:

Algorithms are mere ideas or principles. If the idea or principle is transformed into a sort of workability or practicality then such workable ideas are always

patentable. The algorithms are a pure logic or idea implemented by a program. Once this pure logic built upon or invested with one or more practical reasons, steps, means or components... such practical/technical or a reasonable method becomes a patentable subject matter. The algorithm cannot be practiced as such. It ought to be transformed of with one or more softwares which in turn should be implemented in a computer.

More particularly, if a claimed invention is a workable, practically implementable method supported by physical reference points and means, then such claims at no stretch of imagination can even be presumed as an “algorithm”.

Further, as per the Indian Patent Act, a method or a process is always a patentable subject that is why the definition of the term “invention” under section 2(1)(j) specifically contains the words “new...process...”. This definition of the expression “invention” is literally borrowed from Article 27 of the TRIPS agreement which is quoted below.

Article 27 paragraph 1 of TRIPS Agreement states that:

"(...) 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. (...) 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."

It is respectfully submitted to the Ld. Controller that Article 27 of TRIPS Agreement confers right to inventors, wherein patent 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.

The reason for the TRIPS Agreement was that patents should be granted in all fields of technology, without discrimination. The emphasis is on a ban on discrimination, not on a technology requirement.

Now coming to the Indian Law, wherein India being a contracting state of the TRIPS Agreement, the Indian Patent Act is Trips compliant. Accordingly, section 2(1)(j) of the Indian Patents Act allows inventor to seek protection for **new process** having inventive step and capable industrial applicability.

Since Indian Patents Act is Trips compliant, we can infer that new process quoted in section 2(1)(j) relates to processes **in all field of technology** which can be patentable, if they are new, non obvious and are capable of industrial application.

Further, the Act provides an artificial exclusion prohibiting “Algorithms” from patentability according to section 3(k).

Even if we consider for argument sake that all methods/process are algorithms, then the Patent Act would not have specified the term Algorithm separately under section 3(k). Hence, it can be inferred that methods/process are definitely different from algorithms.

Secondly, by analyzing the section 3(k), we can notice that the “Algorithms” has been included specifically in sub clause (k) and did not include in any other sub clause of section (3). This is due to the reason that, the term “algorithms” can only be associated with software/ computer programme or mathematical method only. More specifically, an algorithm is written to solve a mathematical problem or to solve a specific problem using a computer programme which is to be implemented in a computer.

In contrast, the term Method/Process is always associated with the steps which are enabled using any physical tangible hardware features. Consequently, the Patent Act has viewed the terms “process/method” and “algorithm” separately.

The exclusions specifically prescribed under Section 3 are very specific and limited exclusions and such exclusions should be construed in a very limited / narrow sense only and it should not be considered in a broad or generic sense.

4. Computer program per se

As regards computer related inventions three restrictions are imposed upon the Applicant namely:

- a) a novel and non-obvious function/method performable by a hardware is non patentable;
- b) the method claims should be limited/restricted to a specific hardware component; and
- c) Apparatus claims should show structural / constructional novelty.

Our comments in view of the above is that a novel method producing technical effect which is being carried out on a physical entity by a hardware component is patentable **as the effects are manifested as changes in the said physical entity**. Accordingly, a technical process is one which produces technical results and which brings in changes in the real world. Hence, a machine performing specific method/functions would produce an entirely different result or can perform different tasks as compared to other machines.

Hence, a method/process that brings out technical effect should be patentable.

Secondly, the requirement of incorporating specific hardware components for performing novel method step should be removed / waived due to the reason that

the method steps can be performed by more than one hardware component or by various combinations of hardware and software means and incorporation of specific hardware feature will restrict the scope of method claims.

Furthermore, the reasons for claiming method/process claim is to protect/safeguard the novelty and the inventive concept residing in the method steps itself regardless of the modes of implementation of the said steps.

Hence, the limitation of incorporation of hardware components unduly narrows the scope of the method claims.

Coming onto the apparatus/device/medium claims, we believe that the guidelines imposed that the apparatus/device/medium claims are related to computer program per se merely based on the assumption that components taken individually are known. We respectfully disagree and submit that the apparatus/device/medium as such do not relate to computer program per se.

If the apparatus performing a novel function providing a technical contribution to the prior art and involves a technical effect should not be considered as obvious and hence does not fall under section 3(k) of the Indian Patents Act. More specifically, if the method claims (functions) themselves do not fall under section 3(k), the apparatus/device claims would inevitably NOT fall under section 3(k). In other words, we submit that an apparatus/device implementing a method (that provides technical contribution to the prior art) cannot be equated to computer program per se. Further, the apparatus/device claims that defines or provides details or contains details of various elements/components, the physical interconnectivity between the said various components, the functional inter-relationship between the various components, or functional details of each component, cannot alleged by the Indian patent office to be lacking novelty or

inventive step without adducing sufficient proof. Thus, we submit that the apparatus/device/medium claims in no way relate to computer program per se.

In view of the above, the above mentioned requirements stated in the guidelines in respect of computer related inventions should be removed.



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