

To,

Via E-Mail: birendrap.singh@nic.in

The Patent Office,
Bhouthik Sampada Bhavan,
Near Antop Hill Head Post Office,
S.M. Road, Antop Hill,
Mumbai - 400037

Subject: Regarding invitation for comments on Draft Guidelines for Computer related inventions released by CGPDTM.

Dear Mr. Singh,

We are pleased to submit our comments on the Draft Guidelines for Computer related inventions in India released by CGPDTM. Please find them attached. We appreciate this much awaited initiative and believe it will help bring uniformity and consistency in examination.

Thanking you.

Yours Sincerely,


Anju Khanna


Mohit Kumar Choudhary
Of Lall & Sethi Advocates

**COMMENTS ON GUIDELINES FOR EXAMINATION OF COMPUTER
RELATED INVENTIONS (CRIS)**

1. We note that the IPO through this draft has clearly defined the boundary of inventive step and non-obviousness requirement to differentiate patentable subject matter with the non-patentable subject matter vis-à-vis CRIS. However, we would like to point that though ample number of illustrations have been provided regarding the excluded subject matter, the illustrations as regards to acceptable subject matter are missing. We therefore believe inclusion of a fair number of acceptable illustrations would have made the picture much clearer for the Examiners as well as other stake holders.

2. At sub-section 3.15 & 3.16 on Page 10, the explanation of technical effect that would result in technical advancement vis-à-vis CRIS lacks clarity. We believe, inclusion of a couple of specific illustrations in place of the general examples would have resulted in better understanding on this important aspect.

3. At sub-section 5.4.5 on page 20, regarding the test '*whether the machine is programme specific or the programme is machine specific*', we would like to submit that the modification, even a minor one in the hardware may result in surprising result. So, applying such a strait jacket test may prove to be detrimental in many cases. It is pertinent to note the following case law:

Canadian General Electric Co., Ltd. v. Fada Radio Ltd. [AIR1930PC1] At p. 90:

"It is true that the fact that increased selectivity was apt to result in a diminution of signal strength had been realized by others, and certain devices had been suggested for overcoming it, for example, the employment of a relay in a mechanical or acoustic form by Lorenz. For this purpose, Alexanderson suggests the use of the vacuum tube for coupling the several circuits together at each relay. In their Lordships' opinion, following that of Mr. Justice Maclean, and assuming for this purpose that Alexanderson's

suggestion had not been anticipated, the assembling by Alexanderson in one device of the instrumentalities which furnish means for providing selectivity, progressively improving from circuit to circuit, and at the same time preserving the signal strength, displayed sufficient invention to support his Patent. It is true that the vacuum tube which in Alexanderson's invention performs the function of keeping up the signal strength, was not itself new, but the particular use of it for the purpose described in combination with the other elements of the system, and producing the advantageous result, is, in their Lordships' opinion, a sufficient element of novelty to support the Patent. It may be only a small step, but it is a step forward, and that is all that is necessary so far as subject-matter is concerned."

4. It is well accepted that software steps executed with software programs are not patentable. To qualify for patentability the triple test should always relate to the device/system alone or subject matter as a whole should be considered. In the draft manual it is provided that *'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.'*

There may be cases wherein the program is designed to limit the functioning of hardware components of general purpose machine and invention as a whole may produce surprising result. So, there is a general purpose machine along with software that provides for surprising result which is a result of so much of R&D. What should be approach of the Examiner in such cases? Currently it is mostly dependent on the Examiner's interpretation and hence makes it subjective. The guidelines should be made more succinct and we hope a clarification on this aspect would help fill this loose end and thus may help streamline the examination of CRIS.

5. At Para 6 on Page 32 regarding 'FORM AND SUBSTANCE', it is well accepted that it is not the form but the subject matter that makes a subject matter Patentable. However, in the past we have noted anomaly with regard to signal processing claims (mainly related to domain of electronics and telecommunication), wherein simply by changing the language of the

mathematical steps to read as a technical application the scope of the subject matter is shadowed. A few illustrations vis-à-vis signal processing systems and methods would have helped in a better understanding.

6. We note that the decisions have been quoted in bits and pieces which at several places are quite vague and limiting in nature. This may prove to be detrimental for many applicants and must be avoided. Therefore for clarity we suggest including the illustrations of the allowed cases and the basis of such allowance.

We expect that the IPO will certainly look into the above cited issues that would help in its endeavor for bringing uniformity and consistency in the examination of CRIS.

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