

We are really thankful to the Patent Office for bringing up guidelines for examining Computer related Inventions.

We have following observations regarding the guidelines:

1/ The guidelines are to assist examiner for identifying non-patentable subject-matter according to Section 3. More precisely, the guidelines have taken in it's ambit not just "computer programme per se" of sub-section 3(k), rather it has referred to other non-patentable subject matter of section 3 such as sub-section 3(m), 3(n), other aspects of subsection 3(k). Hence, it is quite clear that the purpose of the guideline is to provide guidelines for an invention which has anything to do with computers and not just with computer programme per se.

2/ The guideline focuses over negative subject matter, vis-a-vis, subject-matter of section 3 of Indian Patent Act. It doesn't mention about "patentable subject-matter" for computer related invention. Hence, if a patent application clears such negative test under guidelines, it may be a patentable subject matter under section 3 of India Patent Act.

3/ In paragraph 5.4.3 of the guidelines, it is mentioned that the subject matter in sub-sections 3(k) – 3(n) relates to non-technical subject-matter. However, section 3 in general, never mentions that the invention may be unpatentable due to non-technical subject-matter. Even, in the act, no such intention of legislators can be derived in section 3. However, as protection for computer programme per se is provided in Indian Copyright Act, hence such protection is avoided in the Patent Act. Same is true for other subject-matter of sub-sections 3(k) – 3(n).

4/ Further, in 5.4.5 of the guidelines, it is discussed that for making the invention patentable the computer programme may be tied up to an hardware for providing a novel hardware. However, none of such requirements have ever formulated by the regulators and cannot be considered as intent of the legislators. Generally speaking, the section 3 doesn't put up anything to be negative which is generally related to computers except the computer programme per se in sub-section 3(k).

5/ In 5.4.6 of the guidelines, it is discussed that computer programme in combination with an hardware can be patentable, if such combination provides definitive functions to the hardware. The discussion provides a non-

definitive identification of such computer programme and hardware configuration. Generally speaking none of such combination is mentioned in section 3 by legislator. Further, dividing hardware and software in such cases to read section 3 on them individually, can only be possible if such combination can be mere combination under sub-section 3(e).

6/ In illustration 4 of the guidelines, it is discussed that the Controller have considered that the computer, the server and the database are known and there interactions are known and hence there is no contribution of inventor. However, dividing every elements and sub-elements of invention in such a way is never validated and intended by the legislator. If elements are analysed individually in such a way, with exception of sub-section 3(e), nothing will be patentable, as majority of times, elements may not be new, however there combination may be new and non-obvious.

7/ In the guidelines, various illustrations are referred to and explained and reference to either controller's decision or IPAB is made through such illustrations. It appears that the purpose of these illustrations is to identify legal support for the guidelines. Hence, it is requested from the Indian Patent Office to kindly upload the decisions referred into the illustrations, so that the people at large may have better clarity over such legal support.

8/ In the flow-chart, it is mentioned that the subject-matter has to be divided into "technical" and "non-technical" subject-matter before identifying any application to lie under non-patentable subject matter for the "technical" subject-matter. However, Indian Patent Act do not refer to any such bifurcation of the claims. Further, the guidelines do not refer to any Indian laws like rules, regulations, decided cases by Indian courts, etc. It is requested from Indian Patent Office to provide such legal basis for benefit of public at large.

9/ In the guidelines, a huge variety of subject-matter is referred to be non-patentable for computer related invention. It appears that if any subject, even if spells words like processor, database, computer, software, etc. will held to be non-patentable at the outset. It is quite obvious that in today's world a large number of inventions are directed toward automation of certain aspect. Most of the activities which are performed today by a computer can be performed by a human or a plurality of human, in a multiplicity of time in comparison to the automated aspect, with equal or less accuracy with respect to automated aspect. Hence, if we break down elements of each invention into elements and sub-elements and try to look into individual capacity of each elements than surely all inventions where computer is anyhow related will be non-

patentable. Atleast, this is not an intention of the law-makers in section 3 to deny an inventions with it's merit.

It is requested from the Patent Office to bring out further clarity on the examination guidelines for benefit of people.

In case, any clarity is required, please do not hesitate to contact the undersigned.

Yours Sincerely,

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