

JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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To: Shri Chaitanya Prasad, IAS
Controller General of Patents, Designs & Trade Marks
Bhoudhik Sampada Bhavan,
Antop Hill, S.M. Road,
Mumbai-400037,
India

Dear Shri Chaitanya Prasad, IAS,

Re: Guidelines for Examination of Computer Related Inventions (CRIs)

The Japan Intellectual Property Association (JIPA) is a non-governmental organization that was established in 1938, which represents users of intellectual property systems. As an association having about 900 Japanese leading companies, JIPA submits recommendations and proposals to the relevant authorities and organizations with regard to the establishment of intellectual property systems overseas and improvements in the implementation thereof.

JIPA appreciates the latest draft of the Guidelines for Examination of CRIs of India as providing for more examples and becoming more comprehensive overall than the section 08.03.05.10 in the MANUAL OF PATENT OFFICE PRACTICE AND PROCEDURE Version 01.11 as modified on March 22, 2011

However, with regard to some points on the attached document, JIPA finds that the latest draft is still unclear or inappropriate in certain respects and would therefore request its revision.

Your deeply consideration on these matters will be appreciated.

Yours faithfully

(Kenichi Osonoe)

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JIPA's Opinions on the Draft Guidelines
for Examination of Computer Related Inventions (CRIs) of India

Japan Intellectual Property Association

1. Treatment of inventions relating to combinations of computer programs and devices (cf. 5.4.5–5.4.7)

The latest draft provides that while a novel device in combination with a computer program that defines its functionality may be patentable, a computer program loaded on a general purpose known computer is not patentable.

Meanwhile, recent computers, including processors or memories, mostly do not rely on any specific programs. In addition, software-related inventions should be patentable originally for their functioning on the basis of novel computer programs in combination with general purpose devices. However, these computer-related inventions would be excluded from protection under the abovementioned standards for patentability.

Furthermore, many computer manufacturers make end products by purchasing basic devices (e.g. processors) from other companies and installing therein novel computer programs that they have developed. The abovementioned standards for patentability would also exclude these products from protection.

In recent years, the value of electronic devices is more likely to be determined by the computer programs that run the devices, instead of the devices themselves. It is often the case that products made of general purpose components, in combination with excellent computer programs, can be innovative products. India retains a wealth of excellent IT technologies, and expanding the scope of protectable computer programs will be beneficial for protecting and enhancing IT technologies and IT-related industries in India.

For these reasons, JIPA would request that the latest draft should be revised so that inventions relating to combinations of computer programs and general purpose devices will be protected under certain conditions.

2. Treatment of business methods (cf. 5.4.8, Illustration5–8)

The inventions based on the claims presented as Illustrations 5 to 8 in Section 5.4.8 of the latest draft were regarded as business methods and therefore held not patentable. JIPA has no objection to the Indian Patent Act excluding business methods from patentability. However, the criteria for determining whether each of the inventions based on these illustrative claims can be regarded as a mere business method are unclear. Illustrations 5 to 8 are not accompanied by any explanation as to why each invention is

regarded as a business method, but the explanation that follows each illustration only states "the invention is a business method." It is uncertain whether the matters described in the patent specification were taken into consideration when making such determination. In order to clarify the criteria for determining whether a claimed invention is a business method, the latest draft should be revised by adding an explanation as to the process toward making a determination that the claimed invention is a business method. If it is difficult to explain such process, the guidelines should also provide for illustrations of claims of inventions not regarded as a business method.

3. Description of hardware (cf. 5.4.8, Illustration 9)

Illustration 9 in Section 5.4.8 of the latest draft indicates that a claim that formally describes the use of a computer would be construed as a claim that substantially describes a computer program per se, and that merely using a computer to automate what was previously done manually is not enough for an invention to be said to make a technical contribution. In that case, hardware must constitute the essential element of the invention. However, the latest draft does not clearly show the adequate level of description or disclosure of the invention, so it should explain this point more specifically. In addition, the latest draft should also specifically explain the level of technical contribution beyond the mere automated processing of what was previously done manually that is achieved by the use of a technical means installed in the computer.

4. Treatment of claims in "means plus function" form (cf. Section 7)

In the illustrations in this section, it is explained that a claim in means plus function form is not allowed if allowing such a claim would result in the protection of a computer program per se or a mathematical method. However, electronic devices and IT devices have more than a little of such nature or aspect. Therefore, the latest draft should be revised by adding illustrations to indicate to what extent the characteristics of hardware should be specifically disclosed in order for the invention to be held patentable and protectable.

5. Illustrations of claims of inventions held patentable and those of claims of inventions not held patentable (Illustration 1–17)

Illustrations 1 to 17 indicate claims of inventions not held patentable. It is difficult to understand the claims of inventions held patentable just by referring to these illustrations and accompanying explanations. The Examination Guidelines of Japan

provide for and explain both examples of claims of inventions held patentable and those of claims of inventions not held patentable, so as to make it easier for applicants to judge the patentability of their inventions. JIPA would request that the Indian guidelines should also provide for both illustrations.

Reference: Examination Guidelines for Patent and Utility Model in Japan
Part VII Examination Guidelines for Inventions in Specific Fields
Chapter 1 Computer Software-Related Inventions
http://www.jpo.go.jp/cgi/linke.cgi?url=/tetuzuki_e/t_tokkyo_e/1312-002_e.htm

Examples of claims presented in the Japanese Examination Guideline

[Title of Invention]

Storing method of articles distributed via network

[Claims]

[Claim 1]

A storing method of articles distributed via network, comprising the steps of:
receiving articles distributed via communication network;
displaying the said received articles;
checking if intended keywords exist in texts of the said articles by users, and if exist, giving "save" command to an article storing execution means; and
storing the said article given "save" command on the article storage means.

[Claim 2]

A storing method of articles distributed via network, comprising the steps of:
receiving articles distributed via communication network;
displaying the said received articles;
determining whether intended keywords exist in texts of the said articles by article storing determination means, and if exist, giving "save" command from the said determination means to an article storing execution means; and
storing the said article given "save" command on the article storage means.

[Conclusion]

[Claim 1] The invention of claim 1 does not constitute a "statutory invention."

[Claim 2] The invention of claim 2 constitutes a "statutory invention."

[Explanation]

[Claim 1]

The claimed invention identified on the basis of the definition of claim 1 is:
"A storing method of articles distributed via network, comprising the steps of:
receiving articles distributed via communication network;
displaying the said received articles;
checking if intended keywords exist in the texts of the said articles by users,
and if exist, giving "save" command to an article storing execution means; and
storing the said article given "save" command on the article storage means. "
The claimed invention includes a process wherein users check if intended
keywords exist in the texts of the articles, and if they exist, give "save"
command to an article storing execution means. This process is performed
based on the mental activity. Therefore, in spite of the fact that the claimed
invention uses a "communication network," information processing cannot be
said to be constructed by cooperative working of software and hardware
resources. Namely, it cannot be said that information processing by software is
concretely realized by using hardware resources.
Therefore, the invention of claim 1 does not constitute a "statutory invention."

[Claim 2]

The claimed invention identified on the basis of the definition of claim 2 is:
"A storing method of articles distributed via network, comprising the steps of:
receiving articles distributed via communication network;
displaying the said received articles;
determining whether intended keywords exist in texts of the said articles by
article storing determination means, and if exist, giving "save" command to an
article storing execution means; and
storing the said article given "save" command on the article storage means."
In case of claim 2, the procedure wherein article storing determination means
determine if a prescribed keyword exists in articles and, and if exists, store
those articles, can be said being constructed by concrete means in which
software and hardware resources are cooperatively working through the said
determination means, execution means and article storage means. In another
word, information processing by software is concretely realized by using
hardware resources.
Therefore, the invention of claim 2 constitutes a "statutory invention."

End