

GUIDELINES IN MAKING TO CLARIFY EXAMINATION OF THE COMPUTER RELATED INVENTIONS

There is a recent development in Indian Patent office with regard to discussion on patent eligibility of computer related inventions.

The Indian Patent Office has uploaded the Draft Guidelines on the official website of the Indian Patent office with regard to examination of Computer Related Inventions (CRI). We are mentioning herein below hyperlink of the same:

http://www.ipindia.nic.in/iponew/draft_Guidelines_CRIs_28June2013.pdf

The aim of the said guidelines is to lay down rules for the examination of CRIs which may have computer program, mathematical methods, business methods and algorithm as one of the main components of the invention.

In this connection, we quote herein below Section 3(k) of the Indian Patents Act, 1970 (as amended in 2002) for your reference:

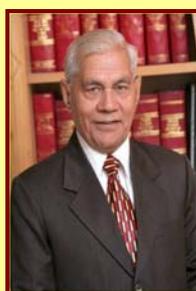
SECTION 3: WHAT ARE NOT INVENTIONS?

The following are not invention with the meaning of this Act:

(k) A mathematical or business method or a computer program per se or Algorithms;

The above quoted Section discloses that a mere computer program per se, business method or algorithm is not patentable.

However, the main purpose of the said guidelines is to lay down rules for the examination of the CRIs invention which has computer program as essential components.



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More particularly, these guidelines concerned with the examination of the CRIs in view of the presence of expression "computer program". The draft guidelines stated that the "term per se has been suffixed to the computer program alone. Therefore, if the invention is relating to mathematical method, business method or algorithm, they are considered to be non-patentable by direct application of law. However, if a claim of an invention is oriented towards a novel, inventive and industrially applicable computer or related device along with the program for defining its functionality, then it may be considered to be patentable."

In the said guidelines, it has been mentioned that in computer related inventions, there is a specific requirement to pinpoint novelty and inventive step in the hardware features and link it to the software/computer program used in the invention for the grant of the patent.

This was also the practice prevailing with regard to the patentability of computer related inventions for several years in Indian Patent Office.

However, in the recent discussion between Patent Attorneys and Controller General of Patents and other stakeholders on the above mentioned draft guidelines, there appears to be a consensus on not requiring novel and inventive hardware features in computer related inventions as a condition for their grant by Indian Patent Office. It has been agreed that the intention of the legislature was that mere software related inventions should be excluded from patentability and therefore, if a software functions with hardware and claims of the same shows the limitation of the hardware or the

program per se" in Section 3(k) of the Indian Patents Act, 1970 (as amended in 2002).

constructional features then it may be patentable even though the hardware features are not novel.

Now, the focus has further shifted to the interpretation of the wording of relevant extract of "Report of the Joint Committee" on the Patents (Second Amendment) Bill, 1999, wherein it was noted:

"In the new proposed clause (k) the words "per se" have been inserted. This change has been proposed because sometimes the computer programmes may include certain other things, ancillary thereto or developed thereon. The intention here is not to reject them for grant of patent if they are inventions. However, the computer programmes as such are not intended to be granted patent."

In view of the above, the software related invention may be patentable if it includes certain other things, "ancillary thereto" or "developed thereon".

As to what is the meaning of or interpretation which may be given to expression "ancillary thereto or developed thereon", discussions are still on among officials of Indian Patent Office and stakeholders.

The Patent Attorneys have given their feedback as to what is the possible meaning of expressions "ancillary thereto or developed thereon".

Once the meaning of the expressions "ancillary thereto or developed thereon", is decided by the officials of Indian Patent

Office, the draft guidelines on the examination of the CRIs will be finalized.

Further, there was also discussion on the examples of the inventions given in the draft guidelines which all relates to cases where the invention was rejected as falling under the prohibition of the Section 3(k) of the Indian Patents Act and there is no adequate reasoning for such rejection. The Indian Patent Official promised to have a relook at the illustrations of cases in the draft guidelines.

There was also discussion on the requirement of including hardware limitation in method claims of CRIs. Patent Attorneys suggested that there is no requirement to include hardware limitations in the method claims once the prohibition imposed by the Section 3(k) is overcome.

However, the Officials of Indian Patent Office insisted that there is a requirement to mention hardware limitation in order to make scope of claims more definitive. This issue still remains unresolved among the Officials of Indian Patent Office and Patent Attorneys.

Finally, Patent Attorneys during discussions cautioned the official of the Indian Patent Office that the draft guidelines should not result in laying down interpretation of law by the Indian Patent Office as Indian Patent Office does not have such power.

Indian Patent Office was expected to finalize these guidelines by now. However, a considerable amount of time has lapsed and there is no news from Indian Patent Office about the finalization of these guidelines. We will keep you updated of any new development in this regard.

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