Annexure

Comments on the Draft Guidelines for Computer Related Inventions

1. At the outset, we note the effort taken by the Controller General of Patents, Designs and Trade Marks (CGPDTM) to compile the referenced document to act as a ready reckoner in the area of patenting of Computer Related Inventions and as a means of ensuring greater transparency and consistency in the patenting system.

2. We note that the Draft Guidelines are not intended to constitute rule making and as such are merely a guideline to ensure uniformity, maintain standards and consistency in the examination of patent applications pertaining to computer related inventions. We also note that in its text, the Draft Guidelines repeatedly refer to the processes and practices laid out in the Manual of Patent Office Practice and Procedure. Further, and as mentioned in the Draft Guidelines, in case of any conflict, the provisions of the Patents Act, 1970 (as amended) would prevail.

2.1. *In this context, we request the CGPDTM to include, in the Introduction to the Guidelines, in addition to a reference to the provisions of the Patents Act, 1970, a reference to the provisions and procedures specified in the Manual of Patent Office Practice and Procedure, which procedures and practices the Draft Guidelines cannot seek to replace but must indeed build upon in a harmonious and consistent fashion.*

3. Paragraph 2.4, Page 6/47:

3.1. Text in Draft Guidelines: "Therefore, the re-instatement of the original phraseology of section 3 (k) clearly indicates that the legislature intended to retain the original scope of exclusion and did not approve its widening under this sub-section as

attempted through the ordinance."

3.2. Problem: While the Draft Guidelines are indeed correct in stating that the legislature intended to retain the original wording of Section 3(k) of the Patents Act (in the context of the changes made to the section in the Patents Amendment Ordinance of 2004 and thereafter the Patents Amendments Act of 2005), the legislature clearly intended to widen the scope of the exclusion in Section 3(k) by removing the words "other than its technical application to industry or a combination with hardware" (as a qualifier to "a computer program per se"). The scope of the exclusion had been narrowed by the Amendment Ordinance and not expanded as stated in the referenced paragraph. Looking at it another way, the object of the Amendment Ordinance was to increase the subject matter of patentability and narrow the exclusions permissible, which the legislature has thereafter decided against in the Patents Amendment Act of 2005.

3.3. Suggestion: The paragraph should read "*Therefore, the re-instatement of the original phraseology of section 3 (k) clearly indicates that the legislature intended to retain the original scope of exclusion and did not approve the narrowing of the exclusions and widen patentability under this sub-section as attempted through the ordinance.*"

4. Paragraph 4.2, Page 15/47:

4.1. Text in Draft Guidelines: "The apparatus claim should clearly define the inventive constructional/ hardware features. The claim for an apparatus may incorporate a "process limitation" for an apparatus, where "limitation" means defining the specific application and not the general application. Example: Apparatus….authentication"

4.2. Problem: The Draft Guidelines fail to specifically mention that this is an example of patent application that does not fulfill the criteria mentioned in the paragraph above.

4.3. Suggestion: *It should be clearly mentioned that the example provided falls outside the scope of patenting, is masquerading as a patent and should not be granted.*

5.   Paragraph 8, Page 41,42/47

5.1.   Text in Draft Guidelines: "The following examples indicate the…the agents deleted the said claim in reply to FER"

5.2.   Problem: The Draft Guidelines fail to specifically mention that the three illustrations provided are examples of patent applications that do not fulfill the criteria of patentability. At present the Draft Guidelines merely state these are examples of biotechnology patents and any ambiguity could be avoided by making the changes suggested below.

5.3.   Suggestion: *We suggest that the Draft Guidelines clearly state that the examples provided fall outside the scope of patenting, are masquerading as patents and should not be granted. We also recommend cross-referencing Paragraph 17 (page 16) of the Guidelines for Examination of Biotechnology Applications for Patent issued by the CGPDTM in March 2013.*

6.   Paragraph 7, pages 35 - 41 /47; paragraph 9 (flowchart 4), page 46/47

6.1.   Text in Draft Guidelines: "For resolving the cases belonging to the claim category of "means plus function", the claims in means plus function form shall not be allowed if the structural features of those means are not disclosed in the specification. Further, if the specification supports implementation of the invention solely by the computer program then in that case means plus function claims shall be rejected as these means are nothing but computer program per se…"

6.2.   Further, from the Flowchart on Page 46/47: "claim directed to "means plus function" where no structural features of those means are disclosed in the specification. Further, if the specification supports implementation of the invention solely by the software then in that case means in the "means plus function" claims are nothing but software".

6.3.   Problem: The explanation (reproduced hereinabove), the examples provided (illustrations 12-14) and the 4th flowchart on page 46 of the Draft Guidelines do not clearly indicate that the hardware / device component of such an application must form an essential part of the invention.

6.4. The Draft Guidelines appear to lower the barrier to patenting (and therefore narrow the scope of the exclusion in Section 3(k) contrary to the intention of the legislature) by only requiring a disclosure of a hardware / device / structural portion in an invention.

6.5. Mere disclosure of the existence of a hardware or structural portion is an insufficient standard to grant a patent, is not contemplated by the legislature and goes against previously established practice as exemplified in paragraph 08.03.05.10 (f) of the Manual of Patent Office Practice and Procedure, and any such patents granted will be nothing other than computer program / software patents in disguise.

6.6. Suggestion: The Draft Guidelines deal only with the case of a claim that recites software elements without any reference to hardware (and state that the same is unpatentable). The Draft Guidelines fail to clarify and specifically deal with the instance where a claim recites both software elements and hardware elements, but the hardware elements amount to nothing more than reference to the components of a general purpose (or indeed purpose built to make it appear that the software does not run on a general purpose computer) computer on which the software is executed, or an information storage medium in which the software is stored, such that the only possibly inventive aspect of the claim resides in the software elements. *It is submitted that such a claim should also not be permitted and the same should be explicitly clarified.*

6.7. If the software is combined with any other hardware (general purpose of purpose built), and the inventive contribution resides primarily in the software or in the software in combination either with components of the computer or in an information storage medium, then the claim must not be patentable. *If the claim recites software elements and hardware elements, and the hardware elements themselves are an inventive contribution to the art, then the claim may be patentable, provided that the claim as a whole is such that the pre-requisites of novelty, non-obviousness and utility are met.* It must be essential for the claim / patent application to disclose structural or hardware components that form an essential part of the invention with the onus on the applicant to show how the hardware of structural component is essential thereto.

6.8. It is established law regarding patentable subject matter that

the inquiry into whether a subject is eligible for patenting is one of substance, not form. This requires that one look, not simply at the language of the patent claim to see if it recites a structure of multiple steps or components, but also at the practical effect of the claim to see if it in fact covers -- or otherwise would restrict the public's access to -- a principle, law of nature, abstract idea, mathematical formula, mental process, algorithm or other abstract intellectual concept. Otherwise, it would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature. By skilled patent drafting, one should not be able to start patenting essentially abstract ideas, mental processes and newly discovered laws of nature or mathematical algorithms. If these could be patented, then in effect one would be patenting the tools of scientific enquiry itself, something no patent law allows as it would lead to halting scientific progress.

6.9.   We also recommend that the flowchart on page 46 be modified to reflect the above, particularly in the last blue box thereof which should read "*Claims directed to "means plus function" where no structural features of those means are disclosed in the specification <u>and any structural features disclosed do not constitute an essential part of the invention</u>. Further, if the specification supports implementation of the invention solely by the software then in that case means in the "means plus function" claims are nothing but software""* in order to better reflect and clarify the understood law on the point.

6.10 We also believe that the Draft Guidelines must contain examples of the aforesaid type of claim (that discloses a hardware or structural component but fails to show this is an essential part of the invention) and must specifically state that such claims are unpatentable.

6.11 We have provided two examples of the aforesaid situation, to illustrate and clarify the scope of what should be deemed an unpatentable claim *inter alia* on account of the fact that the claims do not disclose a hardware component that is an essential part of the invention. Such claims are essentially to grant a patent for a computer program (computer implemented software applications) possibly in conjunction with other unpatatentable matters such as a business method or algorithm.

Illustration 1: "A method of licensing use of a computer asset comprising:receiving at a server a request for a license, the license for metered utilization of the computer asset, the request including an identifier that uniquely identifies a computer comprising the computer asset;generating the license for the metered utilization of the computer asset, the license incorporating the identifier;receiving the license at the computer;verifying the license;utilizing the computer asset after the verifying the license is successful;metering the utilization of the computer asset;consuming a value associated with the license at a rate corresponding to a payment schedule and the metering; andlimiting utilization of the computer asset when the value associated with the license reaches a threshold. A system for licensing metered-use of an asset associated with a computercomprising:a server for processing a request for a license associated with metered use of the asset; andthe computer having an identifier unique within a sphere of operation, the computer coupled to the server and operable to request and receive the license, the computer further operable to cryptographically verify the license and meter use of the asset in accordance with a term of the license. A computer for use in a metered business model comprising:a processor;a secure memory coupled to the processor for storing an identifier, the identifier comprising a hardware identifier associated with the computer and a provider identifier;a cryptographic unit coupled to the processor; andan input/output circuit for conveying a registration request to a service provider, the request including the identifier, the input/output circuit further for receiving a registration response, wherein the processor activates the cryptographic unit to confirm a digital signature of the registration response and the processor is operable to store a portion of the registration response in the secure memory.

Illustration 2: "The present invention relates to a system and a method of providing security and facilitating the integrity of components or assemblies (eg: components including metadata), employed during runtime by application programs. The present invention employs cryptographic techniques to facilitate relationships between components. According to one aspect of the invention, a method is provided for facilitating integrity of an assembly employable by application programs during runtime. An assembly is provided with a manifest that

contains a list of modules that make up the assembly and the manifest is provided with a hash of the contents of the at least one module of the list of modules. Another aspect of the invention relates to a computer readable medium having at least one computer executable component employable by an application program at runtime. The computer readable medium comprises an assembly having a manifest that contains a list of at least one references assembly that the assembly depends on a hash of the contents of a manifest of at least one referenced assembly. In accordance with another aspect of the inventions, a system is provided for facilitating integrity of assemblies employable by application programs during runtime."