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Dear Sir,

**Subject: Comment on the Draft Guidelines for Examination of
Computer Related Inventions (CRIs)**

This is with reference to the Notification dated June 28, 2013 inviting public comments to the draft Guidelines for Examination of Computer Related Inventions (CRIs).

The submission below are our general observations on the draft guidelines as it is not feasible for us to give comments on each and every aspect of the guidelines. We hope these general observations of ours are taken into consideration before finalizing these guidelines:

CRIs have different categories including but not limited to:

1. Software Per Se
2. Business Methods
3. Algorithms
4. Mathematical methods
5. Telecommunications

which forms integral part of CRIs

The proposed guidelines are silent with respect to the telecommunication related inventions which forms an integrated part of CRIs. The telecommunication related invention cannot be categorized under either software per se or business methods or algorithms or mathematical methods. It is felt that these draft guidelines may be made more specific.

The illustrations which have been given in the draft guidelines are only for rejected matters and reasoning of their rejections shows that the Indian Patent office only look for the novel and inventive hardware features in CRI inventions, which is beyond the essence of the computer related inventions, since in such inventions the hardware in combination with software gives a technically advanced effect which overcomes the drawback of the prior art.

It has to be borne in mind that there are very limited case laws in India from Indian courts relating to patentability of computer related inventions. At the same time, the only guidelines available in India relating to patentability of computer related inventions are those issued in Manual of Patent Practice and Procedure.

Keeping the above in mind it would be prudent to learn about laws in other developed countries relating to patentability of computer related inventions.

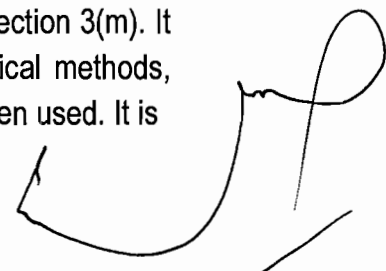
"Software as such" is also excluded from the patentable subject matter in other jurisdictions like EU and JPO. However, the computer related inventions are still being granted.

Within European Union member states, the EPO and other national patent offices have issued many patents for inventions involving software since the European Patent Convention (EPC) came into force in the late 1970s.

Article 52 EPC excludes "programs for computers" from patentability (Art. 52(2)) to the extent that a patent application relates to a computer program "as such" (Art. 52(3)). This has been interpreted to mean that any invention which makes a non-obvious "technical contribution" or solves a "technical problem" in a non-obvious way is patentable even if that technical problem is solved by running a computer program.

In Australia pure or abstract methods of doing business are not considered to be patentable, but if the method is implemented using a computer, it avoids the exclusion for business methods and the subject matter becomes patentable.

The CRI guidelines have to be based on the Section 3(k) and to some extent Section 3(m). It is appreciated that an explanation has been made with respect to mathematical methods, business methods, algorithms and what the dictionary meaning of "per se" is when used. It is



to be noted that the expression "per se" has been used with respect to only computer programmes and not with respect to other constituents of Section 3(k). The intention of the legislature was in case the novelty and/or inventiveness reside in the computer programme alone, such inventions were to be considered not patentable under Chapter 2, Section 3(k) of Indian Patents Act, 1970.

These guidelines are intended to be directed to persons skilled in the art who on their own or through their authorised Attorneys/ Agents/ Lawyers will prosecute the Patent Applications before the patent Office.

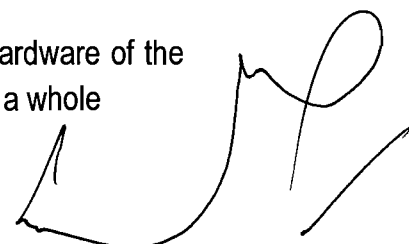
It will be appreciated that a person skilled in the art particularly in the field of CRIs is aware that a computer program alone cannot give novel and inventive results which is expected thereof for the successful working of CRIs.

It is very clear for all those skilled in the art that it is interaction of computer programme with the hardware which gives the desired results and inventiveness and novelty lies in the system. It is again to be appreciated here that this interaction/ association/ relationship existing between the computer programme/ software and the hardware cannot be based upon the constructional modifications or constructional changes having been made to said hardware features. On page 15 paragraph 4.2 of the guidelines and in the illustrations, substantial emphasis has been made for the novelty and inventiveness to reside in the hardware components. Looking for novel and inventive features in hardware would contravene Section 3(k) of the Patents Act, 1970 since as disclosed above, the objective of Section 3(k) is to allow a unique combination of computer program/software alongwith hardware producing novel and inventive end results.

Most importantly, if we are to agree to qualify the hurdle of Section 3(k) of the Patents Act, 1970 that in CRIs novel and inventive features have to be located in hardware, it would appear that we are still following orthodox and traditional approach for examination of Patent Applications as followed for mechanical inventions where the novelty and inventiveness resides in the constructional/structural features and interrelationship of components with each other.

However, with the dawn of the electronic age, specifically looking for novelty and inventiveness in hardware features would amount to disincentive to the Applicants and inventors in the field of CRIs.

In most of the telecommunication inventions, the software modules and the hardware of the system cannot be segregated and the technical advancement of the system as a whole



should be considered because it is not always possible to show inventive constructional features in hardware. Sometimes the novelty and inventive step is in the software module which in connection with hardware results in a novel and inventive system, which as a whole represents technical advancement over the state of the art.

The term "technical advancement" is defined in paragraph 3.16 of the proposed guidelines that technical advancement comes with technical effect but all technical effect may or may not result in technical advancement. The draft guidelines does not clearly lay out as to what constitutes "technical advancement" viz-a-viz CRIs. The draft guidelines does not say anything about the cases wherein in a system computer programme and hardware are so intricately interlinked or interconnected with each other, that it is impossible to pinpoint the novelty and inventive step separately in either part of the system whether computer programme or hardware. In such a system it is the whole arrangement or combination or interaction which gives technical advancement over the prior art. What should be the criteria of judging novelty and inventive step in such a system?

There are numerous Patent Application in the field of CRIs wherein the Indian Patent Office in all its four branches have granted Patents and have avoided looking for novel and inventive step in the hardware features of the invention. For what reasons, illustrations have not been provided in the draft guidelines where Patents have been granted for cases showing novelty and inventive step in the combination of the computer program and hardware as a whole?

We request that in case stakeholders meeting is held to discuss the draft Guidelines for Examination of Computer Related Inventions (CRIs) prior to their finalization, we may also be provided an opportunity to be represented in the same.

In case any clarification, please feel free to contact the undersigned at knk@kankrishme.com.

Very truly yours,
For, **KAN AND KRISHME**

Sharad Vadehra
Advocate and Registered Patent Agent

