

COMMENTS ON THE RECENT GUIDELINES PUBLISHED BY THE PATENT OFFICE ON COMPUTER RELATED INVENTIONS (CRIs)

We are a firm of Patent and Trademark Agents/Attorneys practicing before the Ld. Controller and the other IPR granting bodies, for the past about 20 years. We also practice contentious matters in the field of IPR before different forums like the IPAB, the High Courts and the Supreme Court.

We are forwarding these comments being representative of a large number of Applicants starting from individuals, micro-industries, small scale and medium scale units, universities and other educational institutions, corporate, multi-nationals and others in the field of patents for inventions related to computers and computer software applications in a method and/or apparatus or device or systems and application of software in electronics and telecommunications.

We sincerely thank the Learned Controller General to provide us an opportunity to forward our comments on the GUIDELINE of CRIs.

From the Guideline on CRI we understand the following :

The Indian Patent Act as of now still excludes 'computer programs *per se*' from patentability. It is to be noted that the issue of whether computer programs tied to certain hardware can be patented is a controversial one. The interpretation and definitions of computers, computer networks, computer programs, data, information and computer system as provided in the GUIDELINE are general definitions from text books. However, in the context of the Patent Protections and the extent to which Section 3(k) of the Patent Act prohibits patenting of invention related to computer programs needs deeper thought and broader perspective considering the interest of the Applicants/Inventors engaged in the field of computer science and information technology.

In 2004, the President of India promulgated the Patents (Amendment) Ordinance (on December 27, 2004). The Ordinance split the sub-section 3k into two- sub-section 3(k) and 3(ka). The excluded subject matters as originally contained in Sub-section 3(k) were provided in the new Sub-section 3(ka). It included '*a mathematical method or a business method or algorithms*'. The amended Section 3(k) read as follows:

"(k) a computer programme per se other than its technical application to industry or a combination with hardware".

This would have allowed computer software in combination with hardware to have fallen within the scope of patentability. However, the 2004 Patent Ordinance was not accepted and hence the acceptability of claims related to computer program inventions depends on the extensibility of the expression "a computer program *per se*" which defines the inventions which are not patentable.

From the Guidelines published by the Indian Patent Office, we understand that the examination procedure with respect to the CRI would become very stringent and tough. The Examiners are now going to look into the claims and their scopes more closely than before. While a method claim should have some hardware means support in claim, the Examiners have been guided to understand and perceive whether actually the method being implemented in the hardware means is providing an improved functionality or whether the claim is trying to protect latently a software program. If the method and hardware components are known and it is only new set of instructions being provided in the method, the findings of the inventors will be considered to be construed in software program *per se* and not in the method or the apparatus. Such inventions would be considered not patentable.

As provided in the Guidelines, we understand that Examiners are required to correlate each claimed element to that portion of the disclosure that describes the claimed element. This is to be done in all cases, i.e., whether or not the claimed invention is defined using means or step plus function language. The correlation step will ensure that Examiners clearly understand the meaning and scope of each claim limitation.

The subject matter of a properly construed claim is defined by the terms that limit its scope, and it is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that *suggests or makes optional* but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim element.

Examiners must rely on the applicant's disclosure to properly determine the meaning of terms used in the claims.

An applicant is entitled to be his or her own lexicographer, and in many instances will provide an explicit definition for certain terms used in the claims. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. It is therefore required by the Examiners to properly appreciate the scope of the claims in view of the matter disclosed in the description from where proper interpretations of the claims can be arrived at.

As regards providing support of specific hardware components in a method claim we feel this would put restriction on the claims as a method step can be made to be functional on any specific multiple hardware components. We have also noted that in US and EP means plus function claims are allowed if such means have proper support in the description even if functional and the function achieved by computer programs when implemented in hardware

means are new and technically advanced than what was known earlier. It is our opinion that a method step can be executed by one or more hardware means and mentioning any particular hardware will restrict the method. We think that same method can be performed by numerous hardware means. Such incorporation of means will unnecessarily narrow the scope of the claims. From the applicant's point of view, many users will be able to avoid infringement based on the hardware components to perform the method. Moreover, known hardware components do not add to the novelty or any uniqueness of the method, then why such requirement of putting hardware means in method claims when the method itself is well defining the scope of an invention is not understood.

Returning to the matter of software generally, the logical approach of a computer programmer is certainly of a mathematical nature, but that is quite different than saying that the code created by the programmer is a mathematical algorithm. We find no justification for all computer program claims having no hardware support to be considered unpatentable subject matter because it is simply not correct to say that method step based on software programs is the equivalent of a mathematical equation or a mathematical algorithm or an algorithm or is of abstract nature.

The influence mathematics has on programmers is largely or perhaps even solely related to work-flow. Mathematics teaches how to manage a problem by going through the steps to solve the problem in a predictable and traceable manner. By employing the same type of thoughtful, step-by-step approach to writing code the programmer can manage write segments of code and tie everything together into an overall structure that will deliver the desired functionality. However, the important difference between mathematical module and computer program implemented method/apparatus claim is that the computer program cannot be said to an abstract idea due to its ability to communicate with the real world. Thus when a method has the functional

ability to bridge communications by way of receiving, processing and transmission of signals between a machine and the real world or between two entities, such method ought to be regarded as having technical effect. Then one needs to only examine the technical contribution of the inventors in the method of the invention which would help him to determine its technical advance over the know methods.

Regarding means plus function, it is said in the Guidelines that claims would not be allowed if the structural features of those means are not disclosed in the specification.

Further, it is stated in the Guidelines 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*.

Most frequently we come across applications where computer programs are implemented in electronics and telecommunications and in such cases it is not required to specify the constructional means in the specification. If means are described functionally a person skilled in the field would easily understand and contemplate what actually the author has tried to indicate in the description and such invention is well reducible to practice. In those cases, we do not think that specifying of means is needed. It is to be noted that this type of description of means by its function has been universally accepted and we cannot be an exception.

Computer Program Product Claims

We note that the Guideline has stated that Computer Program Product Claims will also be considered as computer program *per se* and therefore not patentable. We believe that Computer Program Product is not same as

computer program per se and the scope a claim covered by a computer program claim and a Computer Program Product claims is also different.

In Europe, where programs for computers as such are excluded from patentability under the European Patent Convention, **computer program product claims** have been granted since 1998 so long as the program stored on the carrier, when loaded and executed on a computer or a computer processor, produces the *additional technical effect* necessary to qualify as patentable subject matter (*IBM/Computer Program Product* (1999) T1173/97; *IBM/Computer Program Product II* (1999) T0935/97).

The logic behind this approach, as expressed by the EPO Technical Board of Appeal in *IBM/Computer Program Product* (paragraph [9.8]), is that it would be illogical to grant a patent for both a method and the apparatus adapted for carrying out the same method, but not for the computer program product, which comprises all the features enabling the implementation of the method and which, when loaded in a computer, is indeed able to carry out that method.'

From the above it would be clear that when the programme running on a computer or loaded into a computer or computer program carrier brings about or capable of bringing about a technical effect which is beyond the normal physical interactions between the programme and the computer on which it is run, the computer programme cannot be excluded from patentability. Further it does not make any difference whether a computer programme is claimed by itself or as a record on a carrier medium.

Accordingly, in a case where a specific computer program product when run on a computer, brings about such a technical effect, it may be said that there is no distinction between a direct technical effect and an indirect technical effect. Therefore, it would be illogical to grant patents only on method and apparatus

adapted to carry out the same program method but not for the computer program which comprises all the features for implementing and executing the method and when loaded in a computer or in a carrier medium which is loaded in a computer is able to carry out the method.

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Abhishek Sen
On Behalf of S. Majumdar & Co.