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Comments on Draft Guidelines

for Examination of

Computer Related Inventions (CRIs)

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Date: July 09, 2013

To:

Controller General of Patents, Designs and Trademarks,

Office of the Controller General of Patents, Designs & Trade Marks,

Bhoudhik Sampada Bhavan,

Antop Hill, S. M. Road,

Mumbai - 400037

Dear Sir,

RE: Comments on Draft Guidelines for Examination of Computer Related Inventions (CRIs) dated June 28, 2013

We highly appreciate the steps undertaken by your office for issuance of above-mentioned guidelines. However, we have certain apprehensions and the same have been explained herein-below for your kind perusal.

General Comments

In accordance with Chapter XV of the Patents Act, 1970, including Sections 77 – 81, read with corresponding rules, we respectfully submit that responsibility to issue such guidelines has not been assigned to the Controller. Therefore, such guidelines are for reference purpose only and cannot be used by the patent office during patent

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examination to decide the patentability of subject matter as claimed within the scope of any patent application filed within the jurisdictional limits of India.

3. Terms/Definitions

With regards to various terms / definitions included in the referenced section, we respectfully submit that inclusion of such definitions from various other acts (IT Act, Copyright Act, etc.) and other sources (Dictionary) is beyond the scope of power and jurisdiction of the Controller.

In the absence of any law (or rule) to include such definitions for examination of patent applications, the patent office cannot rely on such definitions. More specifically, since Section 10 of the Patents Act, read with corresponding rules, does not mention anything about including any definition in a patent specification, the applicant has full right to use any technical term in any context in the patent specification, to suit the needs of the claimed subject matter, provided such usage satisfies all the requirements of the Patents Act.

Therefore, restricting the technical terms by specifying definitions from various acts and dictionaries is highly arbitrary and discriminatory, which will highly limit the scope of technical terms mentioned in a patent specification.

4. Various Categories of Claims concerning Computer related Inventions:

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We respectfully submit that defining various categories of claims for all patent applications is highly arbitrary and discriminatory, which will highly limit the scope of subject matter claimed in a patent specification.

With a view to achieve speedy prosecution, instead of attempting to fit the claims into pre-defined categories, the patent office shall review each claim for compliance with every requirement for patentability, even if one or more claims are found to be deficient with respect to a statutory requirement.

5. Examination Procedure

With a view to achieve transparent and effective prosecution, the patent office should state all valid reasons and legal grounds for rejecting claims in the first examination report, wherein objections should be explained clearly, particularly when they pertain to non-patentability.

In addition to the above, whenever practicable, the patent office shall indicate how objections may be overcome. In absence of such positive approach and continuance of existing practice followed by the patent office, wherein generic objections are issued without any reasoning, the patent applicants are subject to unnecessary delays in the prosecution of the application.

We respectfully submit that patent office should examine patent applications with an open-minded approach, wherein prior to focusing on specific statutory requirements,

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the patent office should precisely determine what the applicant has invented and is seeking to patent, and how the claims relate to and define that invention.

Therefore, the patent office should not begin the examination by determining if subject matter relates to Method/process, or Apparatus/system, or Computer readable medium, or Computer program product. Instead, the patent office shall review the complete specification, including the detailed description of the invention, any specific embodiments that have been disclosed, the claims, and any specific applications that have been described for the invention.

5.3 Industrial Applicability:

The determination of industrial applicability in case of CRIs is very crucial since the inventions relating to these categories of exclusions are considered abstract theories, lacking in industrial application.

We strongly object to such pre-defined and closed minded approach. Instead, the patent office should follow an open-minded approach as the applicant for a patent is in the best position to explain why an invention is believed useful. Consequently, the patent office should focus their efforts on pointing out statements made in the specification that identify all practical applications for the invention.

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Similarly, while examining a patent application, the patent office should rely on such disclosure throughout the examination when assessing the invention for patentability and other statutory requirements.

In most of the cases, an applicant may assert more than one practical application, but only one is necessary to satisfy the requirement of industrial application. Therefore, the patent office should review the entire disclosure to determine the features necessary to accomplish at least one industrial application.

In addition to the above, the patent office shall carefully review the detailed description to determine what the applicant has invented as it will provide the appropriate explanation of the invention, by describing the accompanying figures, explaining how it relates to the prior art and explaining the relative significance of various features of the invention.

For example, the patent office may begin their evaluation of a computer-related invention by:

(a) determining what the programmed computer does when it performs the processes dictated by the software (i.e., the functionality of the programmed computer);

(b) determining how the computer is to be configured to provide that functionality (i.e., what elements constitute the programmed computer and how those elements are configured and interrelated to provide the specified functionality); and,

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(c) if applicable, determine the relationship of the programmed computer to other subject matter outside the computer that constitutes the invention (e.g., machines, devices, materials, or process steps other than those that are part of or performed by the programmed computer).

In cases of patent applications disclosing technical terms with conflicting definitions (meanings), the patent office should suggest the applicant to amend the claim to better reflect what applicant intends to claim as the invention. This will be highly helpful for all future matters, as in case the application becomes a patent, it becomes prior art against subsequent applications. Therefore, it is important for later search purposes to have the patentee employ commonly accepted terminology, particularly for searching text-searchable databases.

While deciding the patentability, the patent office should use the perspective of one of ordinary skill in the art. Accordingly, the patent office shall give claims their broadest reasonable interpretation in light of the accompanying description. With a view to ensure proper justice to the claimed subject matter, every limitation in the claim must be considered and the patent office shall not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.