



December 9, 2010

Shri P.H. Kurian, IAS
Controller General of Patents, Designs & Trade Marks
BhouthikSampadaBhavan (IP Office)
Near Antop Hill Head Post Office
S.M. Road, Antop Hill
Mumbai – 400 037
India

Dear Mr. Kurian:

The Intellectual Property Owners Association (IPO) appreciates the opportunity to comment on the Draft Manual of the Indian Patent Office Practice and Procedure ("Draft Manual"), released by the Indian Patent Office on November 4, 2010.

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and more than 11,000 individuals involved in the association, either through their companies or law firms or as IPO individual members. Our members file about 30% of the patent applications filed in the United States Patent and Trademark Office by US nationals and represent a substantial number of applications in the Indian Patent Office.

The Indian Patent Office should be congratulated on the significant step forward in completing this comprehensive document and the improvements in content and readability of the present "Draft Manual" over the previous March 25, 2008 Version 3 Draft Manual. Nevertheless, certain specific phrases are still unclear and clarification of certain phrases might further still improve the language. However, our organization wishes to comment briefly on some particularly significant areas that we believe need further review:

I. Software Related Inventions-Chapter 08.03.06.10 Section 3(k)

- a. The statement of patentability for software implemented inventions is more restrictive than in previous versions of the Draft Manual and in what is observed today in India patent law and practice. The purpose for this shift in policy is unclear and a clarifying explanation would be most helpful. Maintaining this shift in policy would seem substantially detrimental to the development of a software industry that has heretofore been a significant pillar of innovation and economic development for India.
- b. Interpretation of India patent law and practice to date has tracked rather closely to the EPC. While remnants of the approach that tracked the EPC survive in the November 4, 2010 Draft Manual, the literal interpretation of 'per se' in the present Draft Manual is the most obvious departure from

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EPC law and practice. The IPO strongly encourages a review of the EPO Enlarged Board decision G03/08 and associated briefs submitted by industry as guidance to an interpretation of patentability in this technology area.

- c. Throughout Section 3(k) of the Draft Manual, there are references that suggest a conclusion that a technology category (e.g., software, business method, etc) is not patentable on its face. The IPO wishes to encourage a low threshold to patent eligibility, while allowing substantive examination and prior art to do the job of determining allowability. To dismiss patent eligibility based on a category of technology will dampen the fire of innovation and the self-perpetuating benefits of a robust industry and economy.
- d. In Subsection (d) it would appear to prohibit computer-readable medium claims. Such claims are not programs per se, but cover a physical device. Claims of this sort are an important aspect of IP protection in the software industry and allowable in most major patent offices. These are not claims to a computer program as a written or electronic word processing document, but to the program in its operational ready to-run form.
- e. In Subsection (h), it is unclear what is meant by the phrase “limiting hardware integers.”
- f. Subsections (i) and (g) appear to conflict. The prohibition against patentability of software operating on a general purpose machine in Subsection (g) appears in conflict with the example of a computer program operating on what could be general purpose hardware in subsection (i). Deleting subsection (g) and maintaining subsection (i) would clarify what is believed to be the law and practice in India today.
- g. Machine Specific and General Purpose Computers – The requirement for software to be ‘machine specific’ suggests that the same software implemented invention operating on different hardware platforms is somehow not patentable subject matter. This is in conflict with the well accepted concept that software operating on a ‘general purpose’ computer, is at the moment of execution a ‘special purpose’ machine or ‘machine specific’ implementation. These hardware platform limitations overlook the primary point that it is the resulting activity that should be the focus of attention rather than the type of hardware involved.

II. Pharmaceutical Inventions - 08.03.06.08

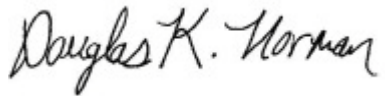
It should be made clear that although methods of treatment of humans and animals using medicaments are not patentable as such, the use of medicaments in the manufacture of agents to treat specific diseases may be. For example, the so called "Swiss Type Claim" in the form of "Use of substance X in the manufacture of a medicament for the treatment of condition Y" should be permissible. Unless such claims are permitted, large fields of research and investment including research in personalised medicine will continue to be denied protection in India.

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Conclusion

We again thank the Indian Patent Office for its ongoing leadership as it continues to address the quality, efficiency and effectiveness of the patent system in India.

Sincerely,

A handwritten signature in black ink that reads "Douglas K. Norman". The signature is written in a cursive, flowing style.

Douglas K. Norman
President