



28 July 2016

The Honorable Shri O. P. Gupta, IAS
Controller General of Patents, Designs & Trade Marks
Boudhik Sampada Bhavan
Antop Hill, S.M. Road,
Mumbai-400037
India
Email: cgooffice-mh@nic.in

Re: IPO Comments on Modified Guidelines for Examination of Computer Related Inventions

Dear Controller General Gupta:

Intellectual Property Owners Association (IPO) submits the following comments in regard to the modified guidelines for examination of computer-related inventions (CRIs) issued on 19 February 2016.

IPO is an international 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 about 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO membership spans 43 countries. IPO advocates for effective and affordable IP ownership rights and provides a wide array of services to members, including supporting member interests relating to legislative and international issues; analyzing current intellectual property issues; providing information and educational services; and disseminating information to the general public on the importance of intellectual property rights.

IPO supports claims being evaluated as a whole to determine the subject matter eligibility for CRIs. We are concerned that there is ambiguity in the CRI guidelines on this issue. For example, section 4.5 of the CRI guidelines states “[w]hat is important is to judge the substance of claims taking whole of the claims together.” But that same section also indicates that “while establishing patentability, the focus should be on the underlying substance of the invention and not on the particular form in which it is claimed.” The later statement appears to invite the examiner to potentially ignore some the claim language. Unfortunately, in practice, when examiners focus on the “underlying substance” of the invention, they might ignore important claim elements in mischaracterizing an invention as being directed to a high-level abstract idea.

IPO suggests revising section 4.5 of the CRI guidelines to underscore the importance of considering the claim language as a whole during examination in lieu of focusing on the “underlying substance” of the invention. To this end, we suggest revising the last

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Milbank Tweed

Executive Director
Mark W. Lauroesch

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sentence of the second paragraph of section 4.5 to state that “the focus should be on the substance of the claims as whole and not on the particular form in which the invention is claimed.”

IPO also supports the three-stage test provided in section 5 of the CRI guidelines. We offer a few suggestion that we believe would improve the clarity without departing from the spirit of section 3(k) of the 1970 Patents Act and its legislative intent.

The three-stage test contains ambiguous language relating to “novel hardware.” As currently stated, the third stage of this test seems to require “novel hardware” for patent eligibility as an initial requirement, but we believe that is not what was intended. In section 5.1 of the previous CRI guidelines dated 21 August 2015, a “novel computer program with a known hardware” is patent eligible if it is “beyond the normal interaction with such hardware and affects a change in the functionality and/or performance of the existing hardware.”

To remove ambiguity, we propose revising the third stage of this test as follows:

(3) If the contribution lies in the field of computer programme, check whether it is claimed in conjunction with ~~novel~~ hardware and, if so, proceed to other steps to determine patentability with respect to the invention. The computer programme ~~in itself~~ per se is never patentable. If the contribution lies solely in the computer programme, deny the claim. If the contribution lies in both the computer programme as well as hardware, proceed to other steps of patentability. The contribution can be considered for other steps of patentability to the extent that the contribution affects a change in the functionality and/or performance of existing hardware, or is claimed in combination with novel hardware.

IPO also suggests that examples of patent-eligible claims be included in the CRI guidelines along with the examples of claims that are not patent-eligible. We propose the following five examples should be considered:

- Claim 1 of Appl. No. 1582/DEL/2004.
- Claim 1 of Appl. No. 1564/MUMNP/2010.
- Claim 1 of Appl. No. 1592/MUMNP/2009.
- Claim 1 of Appl. No. 1376/DEL/2004.
- Claim 1 of Appl. No. 5428/DELNP/2006.

Each of the above examples was originally rejected as being directed to patent-ineligible subject matter under section 3(k), but each has since been allowed by the Controller. Moreover, each of these examples was heard by the Controller in oral hearings after the February 2016 CRI guidelines were released.

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IPO appreciates your consideration of these comments. Please let us know if you have any questions, require additional clarification, or would otherwise wish to discuss further.

Sincerely,



Kevin H. Rhodes
President

Cc: Sh. Rajiv Aggarwal
Joint Secretary
Ministry of Commerce and Industry
Department of Industrial Policy and Promotion
Udyog Bhawan
New Delhi
Email:Rajiv.aggarwal@nic.in