

July 26, 2013

To: Office of the Controller General of Patents, Designs and Trade Marks
Department of Industrial Policy Promotions
Ministry of Commerce and Industry
Government of India
birendrap.singh@nic.in

From: Japan Machinery Center for Trade and Investment
Special Committee for Issues on Intellectual Property Rights
Hideaki Togawa, Chair of the Committee

Comments on the Draft of “Guidelines for Examination of Computer Related Inventions (CRIs)” of India

Japan Machinery Center for Trade and Investment (the Center) is a non-profit organization established in 1952 for sound development of machinery trades and investments. The members are 256 companies, large and medium sized, making exports and direct investments overseas of a broad range of machinery products, in the areas of manufacturing, trading and engineering of electronic or electric equipment, office machineries and industrial machineries.

Special Committee for Issues on Intellectual Property Rights of the Center has studied the systems of intellectual property rights in Japan and Asia, etc. We would like to submit our comments below on the Draft of “Guidelines for Examination of Computer Related Inventions (CRIs)” (the Guidelines) on which Office of the Controller General of Patents, Designs and Trade Marks of India has been inviting public comments.

We hope our opinions are taken into consideration.

1. Requirement that the hardware portion has to be something more than general-purpose machine

(1) Article

5.4.6 A computer programme which may work on any general purpose known computer does not meet the requirements of the law. For considering the patentability of computer programme in combination with hardware features, the hardware portion has to be something more than general-purpose machine. In cases where the novelty resides in the device, machine or apparatus and if such devices are claimed in combination with the novel or known computer programmes to make their functionality definitive, the claims to these devices may be considered patentable, if the invention has passed the triple test of novelty, inventive step and industrial applicability.

(2) Our Studies and Opinions

According to the prescription that “A computer programme which may work on any general purpose known computer does not meet the requirements of the law. For considering the patentability of computer programme in combination with hardware features, the hardware portion has to be something more than general-purpose machine.”, it may be judged that all of operating systems, application software, user interfaces, image processing, a network service, etc. which operate on general purpose hardware, do not have patentability regardless of description of claims.

In the guidelines for examination for computer software related inventions of Japan at least, even if information processing by software is concretely realized by using general purpose hardware, patentability will be accepted when prescribed requirements are satisfied. We acknowledge that the above view is in common in the West.

The prescription that “the hardware portion has to be something more than general-purpose machine.” in 5.4.6 of the Guideline is a severe standard as guidelines for examination of computer related inventions as compared with the main patent bureaus in the world, and since the unity with judgment with the main patent bureaus in the world has lacked, we hope the above prescription is reconsidered.

In "1. INTRODUCTION", the Guidelines prescribe “The major patent offices across the world are confronted with the issue of patentability of CRIs. They have developed examination guidelines/ manuals for the use of examination divisions in these areas of technologies so as to achieve uniform examination practices.”, “The aim of this document is to prepare guidelines for the examination of patent applications in the field of CRIs so as to foster uniformity and consistency in the examination of such inventions.” Since the Guidelines have intention of performing examination which has unity in view of the trend of the main patent bureaus in the world, we would like your consideration so that the Guidelines may not become severer than those of the main patent bureaus in the world.

2. The indication of examples that patentability is accepted

(1) Article

This guideline entirety.

(2) Our Studies and Opinions

The Guidelines mainly indicate the constraints that patentability is not accepted, therefore we can easily understand what is not patented. On the other hand, since the Guidelines do not indicate examples that patentability is accepted, the constraints of patentability are indefinite.

The guidelines for examination for computer software related inventions of Japan indicate not only the examples that patentability is not accepted but the examples that patentability is accepted, therefore an applicant can easily understand the criteria. We hope that the Guidelines indicate the examples that patentability is accepted, so that an applicant can correctly understand the criteria between what is patentable and what is not patentable.

3. The term “a normally skilled but unimaginative addressee”

(1) Article

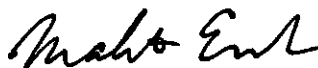
5.2

2. Imputing to a normally skilled but unimaginative addressee what was common general knowledge in the art at the priority date;

(2) Our Studies and Opinions

The Article prescribes “a normally skilled but unimaginative addressee”, however, it is not clear the difference between the above term and the term “a person skilled in the art”. If these terms have the same meaning, it is easier to use the vocabulary not an "addressee" but "a person skilled in the art."

Very truly yours,



Makoto Endo

BLJ LAW OFFICE

on behalf of

Japan Machinery Center for Trade and Investment