A new day for computer inventions – Novel hardware not a requirement anymore

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The Indian patent office has published the revised guidelines for examination of Computer related inventions (CRIs). The guidelines, while still being silent on the technical effect, do away with the thrust on "novel hardware" feature, which comes as a breather after a long, dry spell. Also summarized below are the new guidelines, which do not show any tangible shift from what was published earlier.

- **Novelty:** For novelty the guidelines state that no matter disclosed before the date of priority is patentable. The guidelines rely on the Manual of patent practise for the same.
- **Inventive step:** The guidelines rely on law laid down by Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries Ltd and F.Hoffman la Roche v Cipla for inventive step analysis. Essentially the steps for inventive step analysis are stated to be as follows:-

    1. Identify the "person skilled in the art", i.e competent craftsman or engineer as distinguished from a mere artisan;
    2. Identify the relevant common general knowledge of that person at the priority date;
    3. Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
    4. Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
    5. Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of inventive ingenuity?

- **Industrial applicability:** The guidelines state that the patent specification must disclose a practical application and industrial use for the claimed invention wherein a concrete benefit must be derivable directly from the description coupled with common general knowledge to meet this requirement. Mere speculative use or vague and speculative indication of possible objective will not suffice.
- **Sufficiency:** The guidelines state that in cases of patent application concerning computer related inventions (CRIs), Sufficiency requirements are considered as fulfilled if the specification addresses the following:
- Each and every feature of the invention shall be described with suitable illustrative drawings.
- If the invention relates to "method", the necessary sequence of steps shall clearly be described so as to distinguish the invention from the prior art with the help of the flowcharts and other information required to perform the invention together with their modes/means of implementation.
- The working relationship of different components together with connectivity shall be described.

- The desired result/output or the outcome of the invention as envisaged in the specification and of any intermediate applicable components/steps shall be clearly described.
- The best mode of performing and/or use of the invention shall be described with suitable illustrations. The specification should not limit the description of the invention only to its functionality rather it should specifically and clearly describe the implementation of the invention.
- **Non Patentability under Section 3(k):** The guidelines discuss not patentability under section 3(k)in great length. The guidelines also state to be overriding the chapter of the Manual, containing provisions pertaining to section 3(k) of the Patents Act, 1970. The guidelines state as follows:-
- **COMPUTER PROGRAMMES**
- The guidelines state that the invention should be analysed in substance to determine if it falls under the excluded category. If, in substance, claims in any form such as method/process, apparatus/system/device, computer program product/ computer readable medium belong to the said excluded categories, they would not be patentable.
- The exclusion should not be allowed to be avoided merely by camouflaging the substance of the claim by its wording.
- However, if in substance, the claim, taken as whole, does not fall in any of the excluded categories, the patent should not be denied.
- The claims in means plus function form shall not be allowed if the structural features of those means are not disclosed in the specification. Further, if the specification supports performing 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 programme per se.
- **MATHEMATICAL METHODS**
- Method of calculation, formulation of equations, finding square roots, cube roots and all other similar acts of mental skill are, not patentable.
- Similarly mere manipulations of abstract idea or solving purely mathematical problem/equations without specifying a practical application also attract the exclusion under this category.
- Mere presence of a mathematical formula in a claim, to clearly specify the scope of protection being sought in an invention, may not necessarily render it to be a “mathematical method” claim.
- Also, such exclusions may not apply to inventions that include mathematical formulae and resulting in systems for encoding, reducing noise in communications/ electrical/electronic systems or encrypting/ decrypting electronic communications.
- **BUSINESS METHODS**
- When a claim is “business methods” in substance, it is not to be considered a patentable subject matter. However, if the claimed subject matter specifies an apparatus and/or a technical process for carrying out the invention even partly, the claims shall be examined as a whole.
- However, mere presence of the words such as “enterprise”, “business”, “business rules”, “supply-chain”, “order”, “sales”, “transactions”, “commerce”, “payment” etc. in the claims may not lead to conclusion of an invention being just a “Business Method”, but if the subject matter is essentially about carrying out business/ trade/ financial activity/ transaction and/or a method of

buying/selling goods through web (e.g. providing web service functionality), the same should be treated as business method and shall not be patentable.

- **ALGORITHMS**
- Algorithms in all forms including but not limited to, a set of rules or procedures or any sequence of steps or any method expressed by way of a finite list of defined instructions, whether for solving a problem or otherwise, and whether employing a logical, arithmetical or computational method, recursive or otherwise, are excluded from patentability.
- **COMPUTER PROGRAMMES**
- The computer programmes as such are not intended to be granted patent. The following are essentially not patentable:-
- Claims directed at "computer programme products" / "Storage Medium having instructions" / "Database" / "Computer Memory with instruction" stored in a computer readable medium.
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