

## Legal Issues in ‘Computer Related Inventions’

Issue: What is the Patentability Criteria for Software Inventions in India?

# The Computer Programmes Patentability Saga

- ❖ Introduction.
- ❖ Indian Patent Act in line with the TRIPS.
- ❖ The Patents (Second Amendment) Bill, 1999 - “*a mathematical or business method or a computer program or algorithms*”.
- ❖ The Patent (Second Amendment) Act, 2002 – introduction of “computer programmes per se” to the Act. The clause now read as- “*a mathematical or business method or a computer programme **per se** or algorithms*”.

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## The Computer Programmes Patentability Saga (Contd.)

- ❖ The 2004 Patents (Amendment) Ordinance and its repeal – Rejecting the dilution of S.3(k) exclusion.
- ❖ The ordinance proposed splitting 3(k) into two sub-sections, which would've effectively diluted the exclusion:
  - (k) a computer programme per se other than its technical application to industry or a combination with hardware;
  - (ka) a mathematical method or a business method or algorithms.
- ❖ Union Minister of Commerce and Industry Press Statement.
  - Split between the minister's statement and the amendment.
- ❖ Ordinance Repealed.
- ❖ 2005 draft Manual on Patent Practice and Procedure.

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## The Computer Programmes Patentability Saga (Contd.)

- ❖ First definition of “Computer Programme Product”: “Computer program product is claimed as “A computer program product in computer readable medium”, “A computer-readable storage medium having a program recorded thereon”, etc. In such cases the claims are treated as relating to software per se, irrespective of the medium of its storage and are not held patentable.”
- ❖ First definition of “Technical Effect”: The method claim should clearly define the steps involved in carrying out the invention. It should have a technical effect. In other words, it should solve a technical problem.
- ❖ Various Categories of Claims were defined-
  - Method/Process
  - Apparatus/System
  - Computer Program Product.

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## The Computer Programmes Patentability Saga (Contd.)

- ❖ Draft Manual of Patent Practice and Procedure (2008).
  - Diluted the Provision, led to great stir.
  - Several rounds of consultation between Stakeholders.
  - Should India follow the European or US scheme?
- ❖ Parliamentary Standing Committee Report (88th Report on Patents and Trade Marks Systems in India.
- ❖ Revised Draft Manual of Patent Practice and Procedure.

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## The Computer Programmes Patentability Saga (Contd.)

- ❖ 2011 Manual on Patent Practice and Procedure.
- ❖ The relevant text- *“If the claimed subject matter in a patent application is only a computer programme, it is considered as a computer programme per se and hence not patentable. Claims directed at ‘computer programme products’ are computer programmes per se stored in a computer readable medium and as such are not allowable. Even if the claims, inter alia, contain a subject matter which is not a computer programme, it is examined whether such **subject matter is sufficiently disclosed** in the specification and forms an essential part of the invention.”*
- 6 ❖ **Yahoo v. Controller-** Overture claimed an invention titled- *“A method of operating a computer network search apparatus.”*
  - It was related with a method of operating a computer network search apparatus for generating a result list of items entered by a user through an input device.

## The Computer Programmes Patentability Saga (Contd.)

- ❖ 2013 Draft Guidelines on Computer Related Inventions.
- ❖ The draft guidelines acknowledged the rejection of the language in the 2002 Patent Amendment Ordinance as legislative intent to maintain the original scope of Section 3(k).
- ❖ Not all ‘**technical effects**’ will amount to ‘**technical advancement**’.
- ❖ Then, it attempted to explain the role of hardware in determination of patentability of a CRI, by indicating that a general purpose machine would place it within Section 3(k)’s ambit, but then also mentioning that new or novel hardware with computer programmes could be patentable.

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## The Computer Programmes Patentability Saga (Contd.)

- ❖ 2015-16-17 : Guidelines for Examination of Computer Related Inventions.
- ❖ **6 exceptions** - whether the claimed technical feature has a technical contribution on a process which is carried on outside the computer; whether the claimed technical feature operates at the level of the architecture of the computer; whether the technical contribution is by way of change in the hardware or the functionality of hardware; whether the claimed technical contribution results in the computer being made to operate in a new way; in case of a computer programme linked with hardware, whether the programme makes the computer a better computer in the sense of running more efficiently and effectively as a computer; whether the change in the hardware or the functionality of hardware amounts to technical advancement.
- ❖ Opened the door for making not just Computer Programs Patentable, but also business models and Mathematical Models.
- ❖ Guidelines were kept in abeyance after fierce criticism.

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## The Computer Programmes Patentability Saga (Contd.)

### ❖ **Ericsson v. Intex-**

- Ericsson filed plea against Intex for grant of Injunction. Intex argued for invalidation of Patents of Ericsson.
- Argued that the Patents are hit by section 3(k).

### ❖ 2016 saw a new set of Guidelines on Examination of Computer Related Inventions.

### ❖ **3-step test** to checking for patentability was introduced-

- Properly identifying the actual contribution.
- Denying outright if the contribution was a mathematical or business model or algorithm.
- Requirement of novel hardware before proceeding to other steps of patentability.

### ❖ The 2017 Revised Guidelines for Examination of Computer Related Inventions.

### ❖ Novel Hardware requirement was removed.

## The Computer Programmes Patentability Saga (Contd.)

- ❖ **Clause 4.5 of the Guidelines** said: “...it is important to ascertain from the nature of the claimed Computer-related invention whether it is of a technical nature involving technical advancement as compared to the existing knowledge or having economic significance or both and is not subject to exclusion under Section 3 of the Patents Act.”
- ❖ The 2019 Manual of Patent Office Practice and Procedure.

**THANK YOU!**  
**Questions?**

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