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Office of the Controller General
of Patents, Designs and Trademarks

July 24, 2013

Re: Public Comments on the Draft of Guidance for Examination of Computer Related
Inventions (CRIs) by the Office of the Controller General of Patents, Designs & Trade
Marks in India

Dear Sirs:

The Japan Patent Attorneys Association (JPAA) is a professional association of more than 10,000 patent attorneys practicing in intellectual property law in Japan. Its members practice in all areas of intellectual property law including copyright and unfair competition as well as patent, trademark and design laws. Many are capable of representing clients in infringement lawsuits. The JPAA would like to submit comments.

1. The item "5. Examination Procedure" (p. 16) of the draft describes that "the determination that the subject matter is relating to one of the excluded category requires greater skill of the examiner and these guidelines focus more on this aspect." However, all of the illustrative examples are "non-patentable" examples.

(1) The draft does not present "patentable" examples. Therefore, there is a possibility that the examiner cannot determine what kind of subject matter is "patentable." Consequently, there is a concern that the determination whether claims are falling under the ambit of subsections of section 3 with regard to the CRIs becomes more strict.

(2) We would like to request presentation of "patentable" examples of the CRIs.



(3) Since there is no patentable example in the flowchart, we would like to request presentation of "patentable" examples of the CRIs in the flowchart.

2. The flowchart shown in p. 44 of the draft includes the description of "separating the 'Technical' and 'Non-Technical' features appearing in the claim."

(1) Since claimed elements generally have correlation with each other, we would like to request clarification on what kind of standard is used for such separation of technical and non-technical features.

(2) Is the "Non-Technical" feature also considered in the determination of Novelty and Inventive Step?

3. Generally, a control of device, machine, or apparatus may be implemented with use of computer programs, and may be implemented also with use of a hard-wired logic such as an LSI. Is the examination conducted based on the draft with respect to claims of an apparatus to which implementation of both a computer program and a hard-wired logic is applicable? In other words, is the determination on whether claims are falling under the ambit of subsections of section 3 conducted also with respect to such claims?

4. Section 7 describes handling of "means plus function" claims.

(1) There is no clear description and definition as to which form of claim is regarded as means plus function claim. Therefore, we would like to request clear description and definition.

(2) It is described that the structural features of means defined in the means plus function form must be disclosed in the specification. We would like to request presentation on to what extent the variation of the structural feature (in other words, hardware) should be described. For example, the draft does not clearly explain if illustrating one example of hardware is sufficient, or all the hardware corresponding to the means defined in the means plus function must be covered.

5. Section 8 specially shows examples as to CRIs related to bio-informatics/bio-technology. However, it is not clear if any particular handling is conducted. We believe that there is no need to have special handling of CRIs in the field of bio-informatics/bio-technology if no particular handling is made.

6. An example regarded as corresponding to "computer programs per se" is shown as



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Illustration 9. However, subject claim is not presented. In other words, since the content of claim from the Controller's perspective is merely presented, and it cannot be determined whether the Controller's determination is objectively reasonable. At least an example of subject claim should be illustrated.

Best Regards,

Fumio Furuya
President
Japan Patent Attorneys Association