

February 1, 2018

China & India Make Software Patenting Easier

Prepared by Adrian O'Donnell, Patent Agent

No matter the path to establishing intellectual property rights one reaches a “put up or shut up” point where we reach a final deadline to file in any jurisdictions that the patent owner wants to secure rights to their technology, product etc. in. Naturally, when doing so and looking globally the massive population bases and potential of China and India loom large alongside the US and Europe. Still, a billion people in each with potential patent rights extending 20 years into the future is still crystal ball gazing to some extent.

In the US considerable attention and coverage has been given to the evolving position of the US Court's in respect of business methods and software. Particularly, the US Supreme Court's decision in *Alice Corp. v CLS Bank International* (“Alice”) has made software patenting in the US more challenging. In contrast, both China and India have recently revised their patent office guidelines for the examination of software-related inventions. In both cases the guidelines broaden the scope of patent eligible subject matter and generally create a positive climate for patenting software-related inventions. It may now actually be easier to obtain a software-related patent in China and India than it is here in North America.

China

The revisions in China to their Guidelines for Patent Examination were not a surprise but they have clarified and confirmed the direction that the Chinese State Intellectual Property Office has been taking over the past few years in allowing limited types of software and business method patenting. The revised guidelines directly address business method-related inventions and provide that claims directed to a “business model” are allowable, provided that the claims recite technical features. Thus, while business methods per se are remaining ineligible for patenting where specific technical features are required, and especially where these are of a physical nature, then these should provide sufficient grounds to overcome a rejection that invention is not patent-eligible subject matter.

The guidelines also adopt a similar policy toward inventions related to computer programs where the guidelines distinguish between computer programs per se, which are excluded from patentability, and computer program-related inventions, which are patentable. As a result, a computer program may be a component of a system or device claim, and it may be possible to claim elements such as a computer program product or a machine-readable memory with a computer program for performing a process. What remains imperative is that the claims recite technical solutions, since non-technical solutions remain outside the scope of patentable subject matter.

India

The position in India is similarly a more permissive set of guidelines. Accordingly, under the new Indian Guidelines for Examination of Computer Related Inventions (CRIs) a previously requirement that the computer software be associated with a novel hardware



PERLEY-ROBERTSON,
HILL & MCDUGALL LLP/s.r.l.

requirement has been removed and accordingly, the guidelines now instruct examiners to focus on the underlying substance of the claims taken as a whole. Thus, whilst computer programs per se and algorithms remain excluded subject matter, “the mere presence of a mathematical formula in a claim” or “the mere presence of words such as ‘enterprise’, ‘business’ [or] ‘business rules...’ should not lead to the conclusion that the claims are automatically excluded during prosecution of an Indian patent application.

Accordingly, both China and India have taken direct action in dealing with the challenges of software patenting. Accordingly, the current landscape is one favouring the protection of software in both India and China versus a corresponding patent for the same software-based method in the US. As each of these markets represent over a billion potential users and a combined potential user base already 7 times that of the US with rapidly expanding technology adoption then perhaps a shift in software based patent strategies and markets will result.

Adrian O'Donnell is a Patent Agent in the Intellectual Property Law Group at Perley-Robertson, Hill & McDougall. With over 20 years' experience in information technology including research and development, senior management and as an entrepreneur, Adrian leverages his experience to support both individuals, start-ups and established enterprises both nationally and internationally. Specializing in telecommunications, electronics, photonics, and manufacturing technologies, Adrian is able to support clients from software to hardware in both specialized and consumer markets.

Adrian can be contacted at 613.566.2858 or aodonnell@perlaw.ca.