EXECUTIVE BENCH BRIEFING FOR FOREIGN PATENT COUNSEL

Section 3(k) Software Eligibility, High Court IPD Practice & Section 8 Compliance

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EXECUTIVE SUMMARY & KEY TAKEAWAY
Computer programs per se are excluded under Section 3(k), but software achieving a technical effect or technical advance clears statutory eligibility under binding Ferid Allani and Microsoft IPD rulings.

1. Deconstructing Section 3(k): Computer Program Per Se

Section 3(k) of the Indian Patents Act excludes 'a mathematical or business method or a computer programme per se or algorithms.' The legislative addition of the qualifying phrase 'per se' by Parliament explicitly confirms that software-implemented inventions are NOT categorically barred from patentability.

When software produces a technical effect or operates in conjunction with hardware to achieve a technical advance, it clears Section 3(k) eligibility.

2. Landmark High Court IPD Jurisprudence

- Ferid Allani v. Union of India (DHC 2019): The High Court held that in today's digital era, computer programs that achieve a technical effect or technical contribution are patentable.
- Microsoft Technology Licensing v. Assistant Controller (DHC 2023): Confirmed that software providing improved security, optimized resource allocation, or hardware control is eligible.
- Lava International v. Telefonaktiebolaget LM Ericsson (DHC 2024): Reaffirmed that technical advancement in mobile network protocols clears Section 3(k).

3. Section 8 Statutory Compliance Traps

Software patent prosecution in India requires rigorous adherence to Section 8(1) (filing Form 3 search and examination details of foreign family members) and Section 8(2) (submitting foreign prosecution claims/grants upon Controller requisition). Non-compliance is a statutory ground for pre-grant and post-grant opposition.

4. The 4-Step Prosecution Protocol for Software Dossiers

1. Frame Technical Hardware Interaction: Highlight concrete hardware control, memory optimization, or processor execution.
2. Demonstrate Technical Contribution: Rely on Ferid Allani and Microsoft IPD precedents establishing technical effect.
3. Audit Section 8 Filings: Maintain up-to-date Form 3 foreign family prosecution status tables.
4. Prepare Pre-Grant Opposition Shield: Ensure technical effect arguments are supported by specification text as filed.

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