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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **08.08.2024**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(PT)/207/2023

M/s. Microsoft Technology Licensing, LLC
Earlier Microsoft Corporation (Assignor),
One Microsoft Way,
Redmond, Washington 98052-6399,
United States of America.

Represented by:

Mr. Prashant Philips,
B-6/10, Safdarjung Enclave,
New Delhi. ... Appellant

-vs-

M/s. The Assistant Controller of Patents and Designs,
The Patent Office,
Intellectual Property Office Building,
Plot No. 32, Sector 14, Dwarka,
New Delhi - 110075. ... Respondent

Prayer: Transfer Civil Miscellaneous Appeal (Patents) filed under Section 117-A of the Patents Act, 1970, praying to the Hon'ble Court that (i) The present appeal be allowed; (ii) The order of the Assistant Controller of

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Patents and Designs dated 22.01.2020 in 1196/CHENP/2011 be set aside; (iii) To hold that claimed invention in the present case is patentable subject matter, and involves inventive step and (iv) To direct the Controller to grant the patent.

For Appellant : Ms.Vindhya S. Mani
for M/s.Lakshmikumaran and Sridharan

For Respondent : Mr.C.Samivel, SPC

JUDGMENT

This appeal is directed against an order dated 22.01.2020 rejecting Indian Patent Application No.1196/CHENP/2011. Such application was filed in respect of an invention titled as "DOCUMENT LENGTH AS A STATIC RELEVANCE FEATURE FOR RANKING SEARCH RESULTS". Upon request, the First Examination Report (FER) was issued on 26.10.2018. The appellant responded thereto on 26.04.2019 and submitted amended claims 1 to 19. Pursuant to a hearing on 11.09.2019, the appellant filed written submissions on 26.09.2019. The impugned order was issued in these facts and circumstances.

2. Oral arguments on behalf of the appellant were advanced by

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Ms.Vindhya Mani, learned counsel and on behalf of the respondent by Mr.C.Samivel, learned SPC.

3. Learned counsel for the appellant invited my attention to the impugned order and pointed out that the respondent merely extracted from prior art documents D1 to D3. She further submits that the purported inventive step analysis is limited to about 1 ½ paragraphs at pages 58 and 59 of the paper book. She also submits that the application was rejected by relying on Section 3(k) of the Patents Act, 1970 (the Patents Act) on the ground that the claimed invention did not envisage the use of novel hardware. By relying on a recent judgment of the Delhi High Court in *Microsoft Technology Licensing, LLC v. Assistant Controller of Patents and Designs, C.A.(Comm.IPD-PAT) 185/2022 (Microsoft Technology Licensing)*, she submits that the Delhi High Court concluded that a computer related invention may be granted a patent, even if implemented on a general purpose computer, if it results in a specific and credible technical effect or enhancement beyond mere general computing processes. In view of the consistent position taken in this regard both by this Court and the Delhi High

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Court, she contends that the claimed invention could not have been rejected merely because it is implemented on a general purpose computer. Her last submission was that the FER and hearing notice did not refer to the claimed invention as being an algorithm, whereas the impugned order makes such reference at page 60 of the paper book.

4. In response, Mr.C.Samivel draws reference to the consideration of claims 1 to 13 at page 60 of the paper book and points out that it was concluded therein that the claimed invention uses computer algorithms to carry out some procedure and method steps.

5. Section 3(k) of the Patents Act provides for exclusions in respect of mathematical or business methods, algorithms or computer programmes per se. Each exclusion is distinct although these exclusions cannot be characterised as unrelated. On perusal of the FER, there is reference therein to method claims 14 and 15 being computer based algorithmic steps. However, the objection under Section 3(k) is made on the ground that it is a computer programme per se and, therefore, excluded. The hearing notice

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also raises the objection under Section 3(k) on the ground that the claimed invention is a computer programme per se. When the impugned order is examined in this context, it is noticeable that the following conclusion is recorded therein:

> *"Moreover, the claimed technical implementation does not go beyond a generic technical implementation as such technical considerations must go beyond merely finding a computer algorithm to carry out some procedure and the method steps as claimed herein are completed or done with the help of computer-executable instructions in form of a pre-defined sequential manner. Hence, all the above steps are done with the help of computer programs in terms of an algorithm and performed on a computing device and it is apparent that the proposed algorithmic change has no technical motivation and that its implementation is trivial in form of an algorithm."*

The above extract discloses that the claimed invention was also rejected on the ground that it is an algorithm without providing a reasonable opportunity to the petitioner to respond to such objection.

6. In earlier judgments of the Delhi High Court and this Court, it was concluded that it is not necessary for a computer related invention to be

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embedded or used in relation to novel hardware for it to fall outside the exclusion under Section 3(k). Paragraph 33 of the recent judgment of the Delhi High Court in *Microsoft Technology Licensing* is set out below:

> *"33. In light of the above discussion, it is clearly established that in case of an invention involving computer programmes, to circumvent the limitations imposed by Section (k) of the Act, a patentee must demonstrate that the overall method and system disclosed in the patent application, upon implementation in a general-purpose computer, must contribute directly to a specific and credible technical effect or enhancement beyond mere general computing processes. Therefore, the inventive contribution of a patent should not only improve the functionality of the system but also achieve an innovative technical advantage that is clearly defined and distinct from ordinary operations expected of such systems."*

The respondent recorded the following finding in the impugned order:

> *"It is therefore understood that the actual contribution of the invention solely lies in computer*

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program. The only hardware which is disclosed are general purpose processor, memory and computing device that executes the above said computer program per se in a conventional or normal manner. Further, the above mentioned computer program do not have technical effect going beyond the "normal" interactions between the program and the hardware. Hence, subject matter of claims 1-13 relates to "computer program per se" and falls within scope of section 3(k) of the Patents Act, 1970 (as amended)."

The above finding indicates that the application was rejected on the ground that the hardware is in the form of a general purpose processor, memory and computing device. Thus, the principles formulated by the Delhi High Court and this Court in relation to Section 3(k) have not been taken note of while recording this finding.

7. As regards inventive step analysis, it is noticeable that extracts from prior arts D1, D2 and D3 have been set out in the impugned order. Thereafter, the following finding is recorded:

"D2 discloses implementing a relevance analysis in association with a document length (para [0075]) but it

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does not talks about directly normalizing the document length but it would have been obvious to person skill in the art at the time of invention was made to normalized the document length of D2 and incorporate the normalized document length analysis into the search results ranking invention of D1 to produce an expected result of ranking search results in association with document length. The modification would be obvious because person skill in the art would be motivated to produce results in the highest order of relevance and similarity.

Subject matter of claims 1-13 has been carefully considered in detail. It is found that technical contribution lies with respect to claimed subject matter only in use of normalized document length. From a technical point of view the length of the ranked document would not appear to be relevant. The idea to use the documents length as a ranking feature follows from non-technical information requirements of the user (e.g., that the user prefers documents of a certain length over other document), rather than from any technical considerations). Subject matter of claims 1-13 relates to a system for providing information comprising a search component, a database component and a ranking component. In the present case

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these components are software components installed in the data processing system that provide the claimed functionality. ”

While a conclusion has been reached that the modification would be obvious from prior arts D1 and D2, the respondent has not set out reasons as to why the claimed invention would be obvious from prior arts D1 and D2. The settled legal position, in this regard, is that there should be clear pointers either direct or indirect, in the prior art documents which would lead the person skilled in the art to the claimed invention. Since the conclusions recorded in the impugned order are not supported by cogent reasons, interference therewith is necessary.

8. For reasons set out above, impugned order dated 22.01.2020 is set aside and the matter is remanded for reconsideration on the following terms:

(i) In order to preclude the possibility of pre-determination, an officer other than the officer who issued the impugned order shall undertake reconsideration;

(ii) Upon providing a reasonable opportunity to the appellant, a fresh

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order shall be issued within a period of four months from the date of receipt of a copy of this order.

9. Therefore, (T)CMA(PT)/207/2023 is disposed of on the above terms, without any order as to costs.

08.08.2024

Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No

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To

M/s. The Assistant Controller of Patents and Designs,
The Patent Office,
Intellectual Property Office Building,
Plot No. 32, Sector 14, Dwarka,
New Delhi - 110075.

SENTHILKUMAR RAMAMOORTHY,J

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