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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Date of Decision:10th May, 2023

\+ C.A.(COMM.IPD-PAT) 140/2022

MICROSOFT TECHNOLOGY LICENSING LLC ..... Appellant

Through: Ms. Vindhya S. Mani, Mr. Gursimran Singh Narula and Ms. Vaishali Joshi, Advocates.

versus

ASSISTANT CONTROLLER OF PATENTS AND DESIGNS ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advocates.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

JUDGMENT

SANJEEV NARULA, J. (Oral)

1. The present appeal is directed against order of the Assistant Controller of Patents and Design (Respondent) dated 18 November 2019 ("**Impugned Order**") under Section 15 of the Patents Act, 1970 ("**Act**") refusing Appellant's patent application 1983/DELNP/2008 for the invention titled "FILTERING USER INTERFACE FOR A DATA SUMMARY TABLE".

2. In the hearing notice, the Controller raised objections on the following grounds: (A) Section 2(1)(j) of the Act, asserting that the invention lacks inventive steps in light of the prior arts, cited as D1 to D4. (B) The invention

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being a "computer program per se" is non-patentable under Section 3(k) of the Act; and (C) subject matter of amended claims 1 to 9 are excluded as per Section 3(n) of the Act (presentation of information). However, the Controller finally rejected the application under Section 3(k) of the Act, without delving into the other objections.

3. The Court has heard counsel for parties. Controller's reasoning in support of findings rendered by him are as follows:

> *"**Regarding objection no. 9 |section 3(K)|:-***
>
> *Amended claims 1-10 still objected to as being non-statutory subject matter under the **provisions contained in section 3 (k) of the Patents act 1970.***
>
> *The present invention (i.e., as claimed in claim 1 and claim 9) involves processing large amount of primary data based on one or more filter options as has been claimed in claim 9. Furthermore, the present subject matter also involves determining the data type of the data present within one or more field and automatically moving the field into the appropriate zone within the layout pane.*
>
> ***Pertinent Section of the statute:***
>
> *The section 3(k) of Patents Act is quoted below for reference:*
>
> ***a mathematical or business method or a computer program per se or algorithms**.*
>
> *The section proscribes patenting of matter falling under any of the categories mentioned above. Admittedly, the matter does not relate to a mathematical or business method. However, whether it pertains to category titled computer program per se is an inquiry which I would make in the light of the facts pertinent to this case.*
>
> *In the recently **published guidelines for examining the computer related inventions,** the test indicators to determine patentability are:*
>
> *1. Properly construe the claim and identify the actual contribution;*
> *2. If the contribution lies only in mathematical method, business method or algorithm, deny the claim;*
> *3. If the contribution lies in the field of computer programme, check whether it is claimed in conjunction with a novel hardware and proceed to other steps to determine patentability with respect to the invention. The computer programme in itself is never patentable. If the contribution lies solely in the computer programme, deny the claim. If the contribution lies in both the computer programme as well as hardware, proceed to other steps of patentability.*

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If I read through the principal claim 1 and 9, I find that there is a general purpose computer system, in which method steps are executed.

From the above paragraph, it is clear that the actual contribution of the invention solely lies in software and there is no specific hardware available in the claimed invention. All the steps of the invention are carried out by computer program only. The only hardware mentioned in the present invention are the general purpose computer system, which comprises processor which executes program in a conventional or normal manner.

Applicant's submission that the present invention complies with the official requirements set forth by the Hon'ble Delhi High Court in Ericsson vs. Intex (order in CS (OS) No. 1045/ 2014 dated March 13, 2015). The order holds that, 'Thus, it is appears to me prima facie that any invention which has a technical contribution or has a technical effect and is not merely a computer program per se alleged by the defendant and the same is patentable.' In this regard, it is stated that claimed invention does not qualify the said order as the contribution lies solely in the area of the excluded subject matter as computer program. If the computer program is able to operate the computer/system in a new and different way to consider it has a technical effect/technical contribution rather than processing the data in a conventional manner. Therefore, in view of the above, the claims 1-10 are not patentable u/s 3 (k) for being computer program per se.

It is noted that although the hearing submissions have attempted to address the other requirements, yet without fulfilling the substantive requirements of the Patents Act, 1970 i.e. Section 3(k), this instant application is not found in order for grant.
Thus, in view of the aforesaid and unsatisfactory submissions made by the Agents in respect of the pertinent requirements as raised in the said hearing notice, this instant application no. 1983/DELNP/2008 does not comply with the requirements of the Patents Act, 1970. I, therefore, hereby order that the grant of a patent is refused under the provisions of Section 15 of the Patents Act.

Dated: 18/11/2019

(Srinivasarao Reesu)
Assistant Controller of Patents & Designs"

4. Heard the counsel for parties. The Impugned Order is not legally tenable for several reasons discussed hereinafter. Firstly, the subject application has been examined relying upon Guidelines for Examination of Computer-Related Inventions (CRIs) of 2016, without noticing the revised guidelines of 2017 ("**CRI 2017 Guidelines**") which were in force on the

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date of passing of the Impugned Order.[1] CRI 2017 Guidelines provide clarification on the patentability of computer-related inventions and bring more clarity and consistency to the examination process for computer-related inventions. They cite the Joint Parliamentary Committee discussions on introduction of the term '*per se*' with computer programme under Section 3(k) of the Act, which notes the legislative intent behind introducing the phrase '*per se*'. These new CRI guidelines outline certain criteria that inventions related to computer programs, must meet in order to be considered patentable in India which is radically different from the previous version of the guidelines that have been relied upon by the Controller. One of the key improvements in the CRI 2017 Guidelines is the increased focus on technical effect and technical contributions. The new guidelines emphasize that for an invention to be eligible for a patent, it must demonstrate a technical advancement and a technical contribution beyond the generic computer program. The ambiguities and uncertainties that existed in the previous guidelines have been removed and CRI 2017 Guidelines. They provide more specific criteria for determining the patentability of computer-related inventions. Thus, Controller's examination through the prism of 2016 Guidelines cannot be sustained and the subject invention must be re-examined.

5. Secondly, the Controller has misapplied the decision of this Court in ***Telefonaktiebolaget LM Ericsson (PUBL) v. Intex Technologies (India)***

[1] On page 3 of the Impugned Order, Respondent has given only a vague indication that the present invention has been analysed under the recently published guidelines for examining the computer related inventions. However, the guidelines quoted on page 4 of the Impugned Order are not from the latest CRI 2017 Guidelines.

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Limited.[2] Despite acknowledging the significance of technical effect and contribution as guiding principles in the evaluation of Computer-Related Inventions (CRIs), the Respondent fails to consider the Court's observations that even a computer program may qualify for patent protection if it showcases a technical contribution to the field or delivers a discernible technical effect.

6. Thirdly, the Controller has emphasised upon the lack of novel hardware as one of the grounds for rejecting the patent application. In the Court's view, the Controller has wrongly assumed that absence of novel hardware renders computer programme to be inherently non-patentable. This observation is erroneous as for technical effect and contribution in the field of computer programmes, conjunction with novel hardware may not be always be necessary. Under the 2017 CRI Guidelines, dependency on novel hardware is not mandatory for the patentability of computer-related inventions. The CRI 2017 Guidelines acknowledge that inventions related to computer programs can be patentable if they meet the criteria of demonstrating a technical advancement and a technical contribution beyond the generic computer program. In other words, even if an invention is purely software-based, it may still be considered patentable if it provides a technical solution to a technical problem and goes beyond conventional programming techniques. The focus is on the technical nature and technical effect of the invention rather than the presence of specific hardware components. Thus, the entire foundation of the Impugned Order is flawed and it deserves to be set aside.

7. For the foregoing reasons, the present appeal deserves to be allowed.

[2] 2015 SCC OnLine Del 8229 at Paragraph 120.

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The Impugned Order is quashed. The Controller shall re-consider the application and analyse the technical contribution and technical effect of the invention claimed in the subject application. This decision shall be rendered keeping in mind the observations made herein above, the views expressed by this Court in ***Ferid Allani v. Union of India***[3], CRI 2017 Guidelines, Manual of Patent Office Practice and Procedure (2019), as also other judgments on this issue rendered by this Court.

8. Taking into account the relatively short lifespan of the potential patent, which is projected to expire as early as 2026, it is hereby ordered that a decision shall be reached within a timeframe of four months, starting from date of release of this order.

9. The Court has not expressed any opinion on the other objections raised in the hearing notice. However, it is expected that the Controller shall, pass a comprehensive order dealing with other objections set out in the hearing notice while deciding the application afresh.

10. Allowed in the above terms.

SANJEEV NARULA, J

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[Corrected and released on 27th May, 2023]

[3] 2019 SCC OnLine Del 11867

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