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

Date of Decision: 12th December, 2019

\+ **W.P.(C) 7/2014 & CM APPL. 40736/2019**

FERID ALLANI ..... Petitioner

Through: Mr. Pravin Anand, Mr. Shrawan Chopra & Mr. Vibhav Mithal, Advocates (M-8447458389)

versus

UNION OF INDIA & ORS ..... Respondents

Through: Mr. Akshay Makhija, CGSC with Ms. Roshni Namboodiry, Advocate (M-9818332885)

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. The present writ petition challenges the order of the IPAB dated 25th March, 2013, by which the IPAB has dismissed the appeal filed by the Petitioner challenging the order of the Patent Office dated 18th November 2008, in effect, confirming the rejection of the patent application filed by the Petitioner.

2. The Petitioner, who is a citizen of Tunisia, filed a patent application No. IN/PCT/2002/00705/DEL seeking grant of patent for a "*method and device for accessing information sources and services on the web*". The claims in the patent consisted of both method claims and device claims.

3. The application entered the national phase in India through the PCT route. The filing date was 17th July, 2002, with priority date of 30th December, 2000. The first examination report dated 21st February, 2005

issued by the Patent Office raised objections as to lack of novelty and patentability under Section 2(1)(j) and Section 3 (k) of the Act. A further examination report was also issued on 21st September, 2005, which stated that despite the amendments made in the claims by the Petitioner, the application was still hit by Section 3(k). Challenging the said order dated 21st September, 2005, a writ was filed before this Court. On 25th February, 2008, a ld. Single Judge of this Court directed that the Patent Office ought to give reasons for the rejection, and accordingly the matter was remanded to the Patent Office. The operative portion of the said order reads as under:

> *"…*
> *The petitioner is permitted to submit its reply to the objections pointed out by the respondents in the communication dated 21st September, 2005 within four weeks from the passing of this judgment.*
> *The respondents shall furnish opportunity to the petitioner, both written as well as by oral hearing, in accordance with the statutory mandate and thereafter to pass appropriate orders on the petitioner's application seeking grant of the patent.*
> *The writ petition is allowed in the above terms."*

4. After passing of the said order, the Patent Office again rejected the patent application by a detailed order on 18th November, 2008. Vide the said order, the Patent Office came to the conclusion that claims 1 to 8 were hit by Section 3(k) of the Patent Act, and claims 9 to 14 lacked novelty. The operative portion of the said order is set out below:

> *"…*
> *Therefore method Claims as claimed in Claims 1-8 is a computer program and does not constitute to be a patentable invention as defined in Sub-section k of Section 3 of Patent Acts 1970. And Claimed invention in Claims 9-14 lacks Novelty as well as Inventive steps*

as defined under section 2(1)(j) of the Patents Act1970. In view of my aforesaid findings and circumstances of the case, I refuse to grant the patent on this patent application No. IN/PCT/2002/00705/DEL."

5. The Petitioner's appeal before the IPAB challenging the said order of rejection was also dismissed by the IPAB by the impugned order. The reasoning given by the IPAB was that the patent application did not disclose any technical effect or technical advancement.

6. In the present petition, the case of the Petitioner, after relying upon the various parts of the patent specification, is that the specification clearly discloses a technical effect and a technical advancement, especially as of the priority date. It is not a mere software which is simply loaded on to a computer. It requires a particular method of implementation, as is evident from the claims and thus the rejection, according to the ld. counsel for the Petitioner, is incorrect. Reliance is placed on the Draft Guidelines for Examination of Computer Related Inventions, 2013 which define "technical effect" and "technical advancement" as under:

*"**Technical Effect***

It is defined for the purpose of these guidelines as solution to a technical problem, which the invention taken as a whole, tends to overcome. A few general examples of technical effect are as follows:

- *Higher speed*
- *Reduced hard-disk access time*
- *More economical use of memory*
- *More efficient data base search strategy*
- *More effective data compression techniques*
- *Improved use interface*
- *Better control of robotic arm*
- *Improved reception/transmission of a radio signal*

Technical advancement

It is defined for the purpose of these guidelines as contribution to the state of art in any field of technology. It is important to divide between software, which has a technical outcome, and that which doesn't, while assessing technical advance of the invention. Technical advancement comes with technical effect, but all technical effects may or may not result in technical advancement."

7. Ld. counsel for the Petitioner submits that any patent application which discloses an invention which would allow the user more efficient data base search strategies, more economical use of memory or higher speed, etc., would constitute "technical effect" and thus the rejection of the patent is not in accordance with law. It is further submitted that Section (3)(k) ought to be interpreted in the context of the guidelines which have been introduced.

8. On the other hand, Mr. Akshay Makhija, ld. CGSC submits that the present case does not call for any interference under Article 227 inasmuch as the IPAB, which is a technical Tribunal has taken a view in the matter and in writ jurisdiction, the Court is not to re-appreciate the technical arguments raised before the Tribunal.

9. A perusal of the Patent office website reveals that in respect of CRIs, the following guidelines have been issued:

i. Draft Guidelines for Examination of Computer Related Inventions, 2013

ii. Guidelines for Examination of Computer Related Inventions, 2016

iii. Revised Guidelines for Examination of Computer Related Inventions, 2017

10. Moreover, Section 3(k) has a long legislative history and various

judicial decisions have also interpreted this provision. The bar on patenting is in respect of *`computer programs per se….'* and not all inventions based on computer programs. In today's digital world, when most inventions are based on computer programs, it would be retrograde to argue that all such inventions would not be patentable. Innovation in the field of artificial intelligence, blockchain technologies and other digital products would be based on computer programs, however the same would not become non-patentable inventions – simply for that reason. It is rare to see a product which is not based on a computer program. Whether they are cars and other automobiles, microwave ovens, washing machines, refrigerators, they all have some sort of computer programs in-built in them. Thus, the effect that such programs produce including in digital and electronic products is crucial in determining the test of patentability.

10. Patent applications in these fields would have to be examined to see if they result in a `technical contribution'. The addition of the terms *`per se'* in Section 3(k) was a conscious step and the Report of the Joint Committee on the Patents (Second Amendment) Bill, 1999[1] specifically records the reasons for the addition of this term in the final statute as under:

> "*In the new proposed clause (k) the words "per se" have been inserted. This change has been proposed because sometime the computer programme may include certain other things, ancillary thereto or developed thereon. The intention here is not to reject them for grant of patent if they are inventions. However, the computer programmes `**as such'** are not intended to be granted patent. The*

[1]Page no. 2, *Report of the Joint Committee on the Patents (Second Amendment) Bill, 1999* (19th December, 2001)

amendment has been proposed to clarify the purpose.[2] *"*

A perusal of the above extract from the Report shows that Section 3 (k) which was sought to be inserted by the Patents (Second Amendment) Bill, 1999 originally read as "*a mathematical or business method or a computer program or algorithms*." "The words `per se' were incorporated so as to ensure that genuine inventions which are developed, based on computer programs are not refused patents.

11. The use of *`per se'* read along with above extract from the report suggests that the legal position in India is similar to the EU which also has a similar provision, Article 52 of the European Patent Convention, which reads as under:

> *"(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:*
> *(a) discoveries, scientific theories and mathematical methods;*
> *(b) aesthetic creations;*
> *(c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;*
> *(d) presentations of information.*
> *(3) Paragraph 2 shall exclude the patentability of the subject-matter or activities referred to therein only to the extent to which a European patent application or European patent relates to such subject-matter or activities* ***as such****."*

Across the world, patent offices have tested patent applications in this field of innovation, on the fulcrum of `technical effect' and 'technical contribution'. If the invention demonstrates a 'technical effect' or a

'technical contribution' it is patentable even though it may be based on a computer program.

12. After hearing ld. counsels for the Parties, there is no doubt that this patent application was filed in the Patent Office prior to the issuance of the guidelines for Computer Related Inventions. Over the years, the Patent Office has introduced various guidelines in respect of various technological subject matter, in order to guide the examiners as to the settled case law by way of judicial precedents and the legal position internationally. These guidelines do explain the principles that have to be applied by the examiner, and are expected to assist the examiner in dealing with applications, especially, those which involve complex subject matter.

13. Insofar as Computer Related Inventions are concerned, there are three sets of guidelines that have been published by the Patent Office. The initial Guidelines are termed as 'Draft Guidelines', the second document is described as 'Guidelines' and the one issued in 2017 is termed `Revised Guidelines'. While the initial 2013 Draft Guidelines defines "technical effect", the said definition is not to be found in the later guidelines. The meaning of 'technical effect' is no longer in dispute owing to the development of judicial precedents and patent office practices internationally and in India. There can be no doubt as to the fact that the patent application deserves to be considered in the context of settled judicial precedents which have now laid down the interpretation of Section 3(k), the Guidelines and other material including the legislative material.

14. Accordingly, considering the fact that the term of the patent would be ending very soon - in one year, it is deemed appropriate to direct that the Petitioner's patent application is re-examined in the light of the above

observations and in accordance with the judicial precedents, settled practices of patent offices in examining such patent applications, including the Guidelines which have been issued for Computer Related Inventions. It is directed that the patent would be re-examined and a decision on the patent shall be taken within a period of two months from today, after granting a hearing to the patent applicant.

15. The petition is allowed in the above terms. All pending applications are disposed of.

PRATHIBA M. SINGH
JUDGE

DECEMBER 12, 2019
Rahul