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(T)CMA(PT) No.13 of



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 25.09.2023

CORAM

**THE HONOURABLE MR.JUSTICE SENTHILKUMAR
RAMAMOORTHY**

(T)CMA(PT) No.13 of 2023
(OA/22/2020/PT/CHN)

Oracle International Corporation,
500, Oracle Parkway,
M-S5OP7 Redwood Shores,
California - 94065, U.S.A.

...Appellant

Vs.

The Controller of Patents,
The Patent Office, Chennai Branch,
Intellectual Property Office Building,
Industrial Estate, GST Road,
Guindy, Chennai – 600 032.

...Respondent

Prayer: Transfer Civil Miscellaneous Appeal (Patents) filed under Section 117-A of the Patents Act, 1970, to set aside the order dated 14 February 2020 refusing patent Application NO.630/CHE/2007 under Section 15 of the Patents Act, 1970 passed by the Controller of Patents named in the subject appeal and to remand the case to the respondent for further proceeding in accordance with the specific directions which this Court may please to set and provide any other remedies which it deems fit.



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For Appellant : Mr.Narendra Reddy Thappeta,
Mr.P.Dileep Kumar
for M/s.Law Firm of Naren Thappeta

For Respondent : Mr.M.Karthikeyan,
Senior Panel Counsel

JUDGMENT

The appellant applied for the grant of a patent for an invention titled "User Specific Logs in Multi-User Applications" on 28.03.2007. The First Examination Report (FER) in relation thereto was issued on 30.01.2017. The appellant submitted its response thereto. Eventually, after a hearing on 08.01.2020, the impugned order was issued on 14.02.2020. The present appeal was filed in the said facts and circumstances.

2. Oral arguments on behalf of the appellant were made by Mr.Narendra Reddy Thappeta, learned counsel, and on behalf of the respondent by Mr.M.Karthikeyan, learned Senior Panel Counsel.

3. Learned counsel for the appellant submitted that the claimed invention relates to a back end log maintained by the server and customised for different



users. Learned counsel submitted that the claimed invention satisfies all the requirements of Section 2(1)(j) of the Patents Act, 1970 (the Patents Act), results in a technical effect and provides a technical solution to the problem. He further submitted that the prior art cited in the FER was a printer. By referring to the impugned order, learned counsel submitted that the respondent relied upon Sections 2(1)(j) and 3(k) of the Patents Act to reject the application. As regards Section 2(1)(j), learned counsel submitted the claimed invention is novel, satisfies the requirements of Section 2(1)(ja) and is capable of industrial application. He further submitted that Section 3(k) applies only if it is a computer programme *per se* and not if the claimed invention provides a technical solution. In support of this contention, learned counsel referred to and relied upon several judgments. Reference may be made, in particular, to the judgment of the Delhi High Court in *Microsoft Technology Licensing, LLC v. The Assistant Controller of Patents and Designs, 2023 : DHC : 3342*.

4. In response to these submissions, Mr.M.Karthikeyan, learned Senior Panel Counsel, submitted that the respondent is ready and willing to reconsider the application. He clarified that this submission is being made without making any concession on the merits of the matter.



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5. On examining the impugned order, it is evident that the patent application was rejected by drawing reference to Sections 2(1)(j) and 3(k) of the Patents Act. The operative portion of the order is very brief and is set out below:

"Also, In view of the above, the subject matter of claims 1-6 represent a set of computer executable instructions on a general purpose computer and an algorithm to execute the said instructions in a pre-defined sequential manner. It has been implemented on a conventional computer system hardware and software environment. In claims of the instant alleged invention, computer programs are claimed in the form of system claims. As evident from the above cited documents, the said system or device is an implementation of computer executable instructions on a general purpose computing device to achieve the intended functional features. The said computer executable instructions have been implemented in the form of "computer program per se" in the system claim. Hence, subject matter of claims relates to "computer program per se" and falls within scope of section 3(k) of The Patents Act, 1970 (as amended).



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6. The oral argument and the written submission of the agent of applicant have been carefully considered. However without prejudice, although the hearing submissions have attempted to address the other requirements, yet the substantive requirement of the Patents Act, 1970 i.e. Section 2(1)(j) and section 3(k) is not found complied with. Hence, in view of the above and unmet requirements, this instant application is not found in order for grant Also I agree with the findings of the examiner that the subject matter as described and claimed attract the provisions of sections 2(1)(j) and 3(k) of the Patent Act, 1970.

*7. 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 does not comply with the requirements of the Act. I, therefore, hereby order that the grant of a patent is **REFUSED** under the provisions of Section 15 of the Patents Act."*

6. From the above operative portion, it appears that the response of the appellant to the FER was not duly taken into consideration while concluding that the claimed invention does not satisfy the requirements of Sections 2(1)(j)



and 3(k) of the Patents Act. For such reason, the impugned order is unsustainable and liable to be set aside.

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7. As contended by learned counsel for the appellant, the meaning of the expression "computer programme *per se*" has been considered in great detail in judgments such as *Ferid Allani v. Union of India & Ors.*, 2019 SCC OnLine Del 11867, and *Microsoft Technology Licensing v. Assistant Controller of Patents*, 2023 SCC OnLine Del 2772. It is appropriate that the patent application be reconsidered after taking note of the principles laid down in such judgments. It is further appropriate that an officer other than the officer who issued the impugned order undertakes such reconsideration to preclude the possibility of pre-determination.

8. Accordingly, (T)CMA(PT) No.13 of 2023 is disposed of on the following terms:

(1) The order dated 14.02.2020 is set aside without, however, expressing any opinion on the merits of the matter.

(2) Application No.630/CHE/2007 is restored and remanded for reconsideration.



(3) Such reconsideration shall be undertaken by an officer other than the officer who issued the impugned order.

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(4) While undertaking such reconsideration, the precedents with regard to the scope and ambit of Section 3(k) of the Patents Act shall be taken into consideration.

(5) After providing a reasonable opportunity to the appellant, a reasoned decision shall be issued within a period of four months from the date of receipt of a copy of this order.

25.09.2023

Index:Yes
Speaking order
Neutral Citation:Yes
hvk

To

The Controller of Patents,
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SENTHILKUMAR RAMAMOORTHY,J.

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