2025:MHC:2580

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Orders Reserved on	**05.08.2025**
Orders Pronounced on	**05.11.2025**

CORAM

THE HON'BLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(PT) No.159 of 2023

SR No.87/2020/PT/CHN

TRANS UNION, LLC
(Through its constituted power of attorney holders
Mr.Tanmay Joshi and Mr.Nipun Sangra)
555 W Adams Street,
Chicago, Illinois, 6066
United States of America

Address for Service in India:

Remfry & Sagar
First Floor, Block-B Chaitanya Imperial Building
610, Anna Salai
Teynampettai
Chennai-600 018
Tel:91-44-48514474
Email:remfry-sagar@remfry.com ... Appellant

-vs-

1. The Controller General of Patents, Designs &
Trademarks, Doudhik Sampada Bhawan
Antop Hill, S.M.Road, Mumbai-400 037

2. Assistant Controller of Patents

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Patent Office Intellectual Property Building
G.S.T.Road, Guindy
Chennai-600 032. ... Respondents

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) is filed under Section 117-A of the Indian Patents Act, 1970, prays that:

A. this Court may be pleaded to call for the records of the patent application no.4268/CHE/2012 relating to the impugned order and issue an order setting aside/quashing the impugned order dated January 20, 2020 and direct the Respondents to grant a patent on the patent application no.4268/CHE/2012 allowing the present appeal;

B. The Appellant be allowed to amend, add or alter any ground of Appeal and also be permitted to place on record relevant material including evidence in the form of an affidavit, written submissions and synopsis of case law;

C. Pass such other appropriate relief, order and/or direction which this Court may deem fit and proper in the circumstances of the case.

For Appellant : Mr.Vineet Rohilla & D.Subbin
for M/s. Remfry and Sagar

For Respondent : Mr.M.Karthikeyan, SPC

****

JUDGMENT

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Background:

The present appeal arises from an order dated January 29, 2020 passed by the second respondent, Assistant Controller of Patents and Designs, in respect of the appellant's patent application no. 4268/CHE/2012 pertaining to the invention titled 'System and Method for Matching of Database Records Based on Similarities to Search Queries' claiming priority from U.S. Provisional Application No.61/547,544 dated October 14, 2011. The application, consisting of claims 1-20, was filed on October 12, 2012, and was followed by a request for examination on October 19, 2018. The First Examination Report (FER) was issued on October 09, 2018 wherein objections were raised on grounds of non-patentability under Section 3(k) of the Patents Act, 1970 (the Patents Act); lack of inventive step under Section 2(1)(ja) in view of prior art references D1: US20004220918A1, D2: US2009006075A1 and D3: US20005108212A1; lack of sufficiency of disclosure and definite scope under Section 10(4); and lack of clarity and succinctness under Section 10(5). The appellant filed its response to the FER by amending claim 1 and submitting claims 1-17 to meet the objection in respect of lack of inventive step. A hearing letter was issued on August 26, 2019 fixing the hearing on September 27, 2019. After the hearing, the appellant filed its written submissions on October 11,

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2019 along with final version of claims. By way of impugned order dated September 20, 2019, the subject application was refused on the sole ground of non-patentability under Section 3(k).

Counsel and their contentions:

2. Arguments on behalf of the appellant were advanced by Mr. Vineet Rohilla, learned counsel, assisted by Mr. D. Subbin. Mr. M. Karthikeyan, learned Special Panel Counsel, represented the respondent, assisted by learned counsel, Mr. Girish Sundaram. Learned counsel for the appellant submitted written submissions and additional written submissions.

3. Learned counsel for the appellant submitted that the subject invention relates to a system and method for the matching of database records based on the similarity between fields in the database records and fields in the search queries. He explained the claimed invention briefly as follows. Traditional algorithms on a consumer database to retrieve consumer data are unsuitable for emerging markets due to lack of relevant records with a unique identification number, varying formats of addresses, unreliable dates of birth and the return of a large number of search results. To address this lacuna, the subject

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application provides an improved system and method that accurately returns matching records from a database and accounts for the formatting and quality issues with consumer data.

4. Turning to the impugned order, learned counsel contended that there are contradictions and internal inconsistencies therein. He pointed out that, in one paragraph, it is recorded that the claimed invention admittedly does not relate to a mathematical method or a computer programme and that it is objected to under the category of algorithms; whereas, later, it is recorded that "the search query optimization algorithm is computer program per se." Apart from such internal contradictions, learned counsel submitted that the claimed invention cannot be rejected as a 'computer programme per se' merely because it contains algorithms or computer executable instructions and it must be assessed for its technical contribution or effect. He relied on *Lava International Limited v Telefonaktiebolaget LM Ericsson, 2024: DHC : 2698* (*Lava International)* for this purpose.

5. Furthermore, learned counsel relied on the 'Guidelines for Examination in the European Patent Office, March 2024' (the EPO

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Guidelines), particularly Chapter II-20, to contend that: database management systems are technical in nature and perform the technical tasks of storing and retrieving data using various data structures for efficient management of data; and that optimizing execution of structured queries with respect to computer resources involves technical considerations and deployment of features such as main memory, CPU, hard disk, which contribute to the technical character of the claimed invention. In addressing the technical problem of reducing search times and optimizing results, learned counsel submitted that the claimed invention makes the technical contribution of providing for a system and method that is designed to screen a set of retrieved records from a consumer database based on the names and/or initials in the records; keep or reject the retrieved records based on the matching strength of the records as compared to a search query; and potentially merge the records based on similarity between the kept records in a functionally efficient way thereby making it patent eligible.

6. Learned counsel further submitted that use of novel or customised hardware is not an essential criterion for assessing the patent eligibility of a computer related invention by relying on *Raytheon Company v Controller General of*

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Patents and Designs, 2023:DHC:6673. Without prejudice to this contention, he relied on paragraphs 19, 28, 29, 34-35 of the claimed invention which recite a technique for matching records from a database by reducing search time, which is implemented by various means such as hardware which may encompass a computing device with a processor, memory and input output devices to perform refined matching; software; or a combination thereof. He also added that a patent was granted in other jurisdictions, such as the US and Australia, thereby substantiating the patentability of the claimed invention.

7. Submissions in response were made on behalf of the respondent. The respondent contended that the claimed invention involves methods/systems for matching of database records based on similarity between fields in the records and those in the search queries that are implemented using a source program, executable program, script or any other entity comprising a set of instructions to be performed, as described in paragraphs [0007] and [00033] of the complete specification. Therefore, it was contended that the claimed invention is no more than an algorithm or computer programme per se. After submitting a compilation of precedents, the following precedents, including decisions of the Technical Board of the European Patent Office (the EPO

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Board), were relied on in support of the contention that the claimed invention is not patent-eligible:

(i) *Aerotel Limited v. Telco Holdings Limited and others (Aerotel); and Macrossan's Application (Macrossan), [2006] EWCA Civ 1371*

(ii) Symbian Limited v. Comptroller General of Patents [2008] EWCA Civ 1966

(iii) AT&T Knowledge Ventures/CVON Innovations v. Comptroller General of Patents [2009] EWHC 343 (Pat)

(iv) HTC Europe Co Ltd v. Apple Inc. [2013] EWCA Civ 451

(v) T/641/00, Comvik GSM AB, Decision of the EPO Board dated September 26, 2002

(vi) T/1784/06, Comptel Corporation, Decision of the EPO Board dated September 21, 2012

(vii) T/0309/10, Multex.com, Inc., Decision of the EPO Board dated June 19, 2013 for the proposition that data archival and retrieval is a task performed by a librarian and is not technical

(viii) T/1924/17, Accenture Global Services Limited, Decision of the EPO Board dated July 29, 2019

(ix) T/0697/17, Microsoft Technology Licensing, LLC, Decision of the EPO Board dated October 17, 2019

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Discussion, analysis and conclusion:

8. The relevant portion of the impugned order that rejects the subject application under Section 3(k) of the Patents Act is as follows:

> *Now, after going through the submissions and the method claims it is found that the method for matching data in a search query in a database is algorithmic step implemented by software only.* ***The search query optimization algorithm is computer program per se. The method steps claimed are algorithmic steps for screening and matching of database records.***
> *Figure 1 is showing DBMS having database (search query is default with every database management system) with matching engine only do not have structural features.*
>
> *Figure 2 is showing block diagram of generic computer architecture and same as figure 2 of D1 (US2004220918A1).*
>
> *None of them per se can be claimed as additional structural features to achieve the further technical effect.*
>
> *None of the claims define specific hardware or structural features of the said system rather they have been drafted in*

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terms of functional aspect of the system. It is evident from the drawings filed with complete specification and standard block diagram of computer (available in any text book of computer architecture and also in D1). In absence of ***any structural features, the claimed system is nothing but the computer program per se in the form of a software application.***

Regarding invention under section 2(1)(j) applicants argument that the application have a better search query matching algorithm for unstructured data comprising consumer identifying data and consumer financial data is accepted. Therefore, the claimed invention as claimed in claims 1-17 constitutes an invention as defined under Section 2(1)(j) of the Act.

The whole processing is done through ***a computer program which determines the consumer credit risk (business application) after matching data in search query (well known algorithmic step in DBMS). The contribution, therefore, lies solely in the algorithm implemented by computer program*** *and also, it is* ***not claimed in conjunction with any specific hardware or additional***

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structural features.

(emphasis added)

The subject application was thus rejected on the sole ground that in the absence of structural features, the claimed invention is a computer programme per se in the form of a software and, therefore, falls under the exclusions 'computer programme per se' and 'algorithm', respectively, under Section 3(k) of the Patents Act.

9. I had discussed the interpretation of Section 3(k) of the Patents Act in considerable detail in *Ab Initio Technology LLC. v. The Controller of Patents & Designs, (T) CMA (PT) 58 of 2023, judgment dated 04.11.2025* after considering precedents from the UK, the EPO and India. Reference may be made to paragraphs 21 to 48 thereof, which may be read as part and parcel of this judgment. In a nutshell, I concluded that the patent application would pass through the exemption filter "*per se*" under Section 3(k) if one or more features therein makes a technical contribution and thereby augments the functioning of the computer or the device in which the computer programme(s) are embedded.

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10. Against this jurisprudential backdrop, I turn to the claimed invention next. Independent claim 1 of the subject application is reproduced below:

> *1. A method of matching data in a search query to data in a database (108) for determining a subject consumer's credit risk, the method comprising:*
> *arranging a search query search engine and a search query matching engine to be in communication with a processor (202) and an Internet accessible database, the database (108) comprising a plurality of unstructured, incomplete and/or inconsistently formatted data about a plurality of consumers from a free form data source(104), the data being stored in respective database fields in a plurality of database records; in response to receiving, via the processor(202), a search query communicated over the Internet to the search engine (106) by a remote application to search for and retrieve credit-related data corresponding to the subject consumer, retrieving via the processor an initial set of search results from the database corresponding to the subject consumer, the step of retrieving being accomplished by converting and standardizing the search query and the plurality of database records via exact and pattern substitutions into a normalized search query and a plurality of normalized database records, based on a normalization rule, wherein the normalized search query comprises a normalized search field and each of the plurality*

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of normalized database records comprises a normalized database field;

refining the initial set of search results to obtain a final plurality of normalized database records corresponding to the subject consumer by determining by the processor a degree to which fields in the search query match the fields in the plurality of database records, the step of refining comprising the steps of comparing. by a-matching the matching engine (110) via the processor(202), the normalized search field and the normalized database field of each of the plurality of normalized database records, wherein comparing comprises calculating a difference between a date of birth of the normalized search field and a date of birth of the normalized database field of each of the plurality of normalized database records, and assigning a matching strength metric associated with each of the plurality of normalized database records, based on the calculated difference between the date of birth of the normalized search field and the date of birth of the normalized database field of each of the plurality of normalized database records, using the processor; and

transmitting, by the matching engine (110) via the processor (202) to the application over the Internet, a subset of the normalized plurality of database records, wherein the subset meets qualifying criteria that are based on the matching

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strength metric.

Working of the claimed invention:

11. The claimed invention, which is intended to determine a consumer's credit risk, provides for a method of matching data in a search query to that in a data base. The method is implemented using software executable by one or more servers or computers, such as a computing device with a processor and memory. An application transmits a message that contains the search query to the system and the search engine. An initial set of search results are retrieved from the database after normalization of raw data and search queries into a condensed normalized format and returned to the application by the matching engine.

12. The matching engine normalizes the search query and plurality of database records and then assigns matching strength points by comparing the normalized fields of the search query to those in the records. Based on a set of predetermined criteria, the matching engine then chooses the relevant record and returns it to the application if there is only one record. In case of there being more than one record, the matching engine determines the similarity between them and merges them together. The merged records, which meet the

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qualifying criteria and have a statistically significant probability of belonging to the customer in question, are returned to the application by the matching engine via the processor.

13. The subject application was rejected by the impugned order on the ground that it lacks structural features and that it relates to a method for searching matching data. It must be borne in mind that while evaluating a patent application, all the claims and the features contained therein must be read together as a whole. A few paragraphs from the complete specification are extracted and set out, in relevant part, to illustrate the working of the claimed invention:

> *"[00042) The search query and the records may be normalized at step 306, based on one or more normalized rules .... Examples of the normalization rules for names may include concatenation of multiple name fields, setting all text to upper case characters, removing text within brackets or parantheses, checking for particular non-allowed characters (e.g., digits), expanding abbreviations, converting particular characters to spaces, detecting gender based on predetermined lookup tables, removing predetermined unwanted noise words,*

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removing single characters and removing multiple spaces ...."

"[00045] Names and parts of names in a search query and a record may be compared to determine their level of matching. Normalized versions of the names may be used for matching. Phonetic algorithms such as Soundex and Phonex may be utilized to determine exact, strong or partial matching of all or parts of names ...."

14. The method of the claimed invention may be explained with greater granularity with the following description and the corresponding figures from the complete specification. It involves: receiving a search query, retrieving relevant records from the database; receiving retrieved search records by the matching engine from the search engine (302); screening the retrieved records by comparing the data in the search query to the data in the retrieved records (304); discarding irrelevant data; normalizing the search query and records for standardization by concatenating multiple name fields, removing text within brackets, checking for non-allowed characters, removing unwanted noise words and single characters among others and assigning matching strength scores to the records based on comparison (see Fig 5)(306); determining whether the record qualifies for further consideration (308) using qualifying criteria (see Fig 6) based on strength of matching points; rejecting the record if it does not meet

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the qualifying criteria (310); keeping it if it qualifies (312); determining if there are more records to be considered (314); repeating the process from step 308 to determine if further records meet the qualifying criteria; proceeding to step 316 if there are no further records wherein it is considered whether there is only one remaining record; if there is only one record, it is returned to the application at step 320; if there are more than one record, similar records are merged at step 318 (see Fig 4) and returned to the application.

15. This process is best exemplified by Figure 3:

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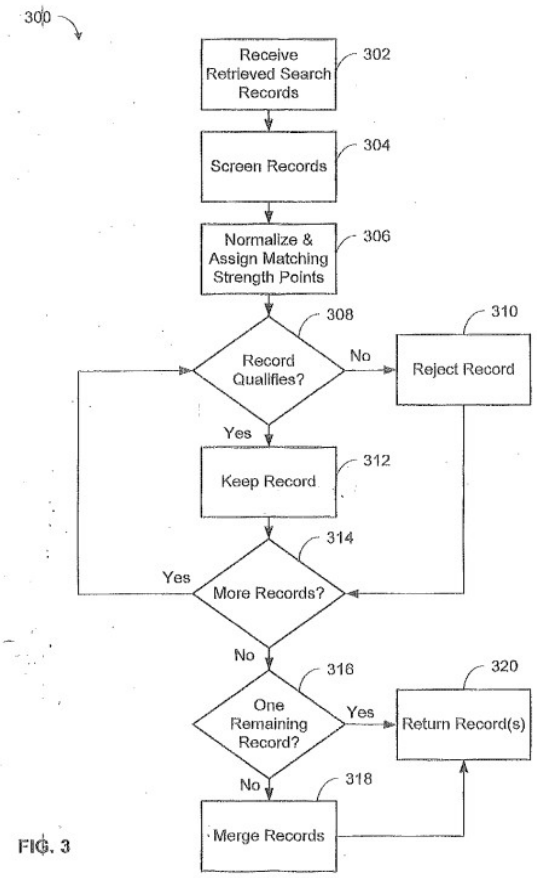


FIG. 3

16. Figure 4, which depicts the merging process, is set out below:

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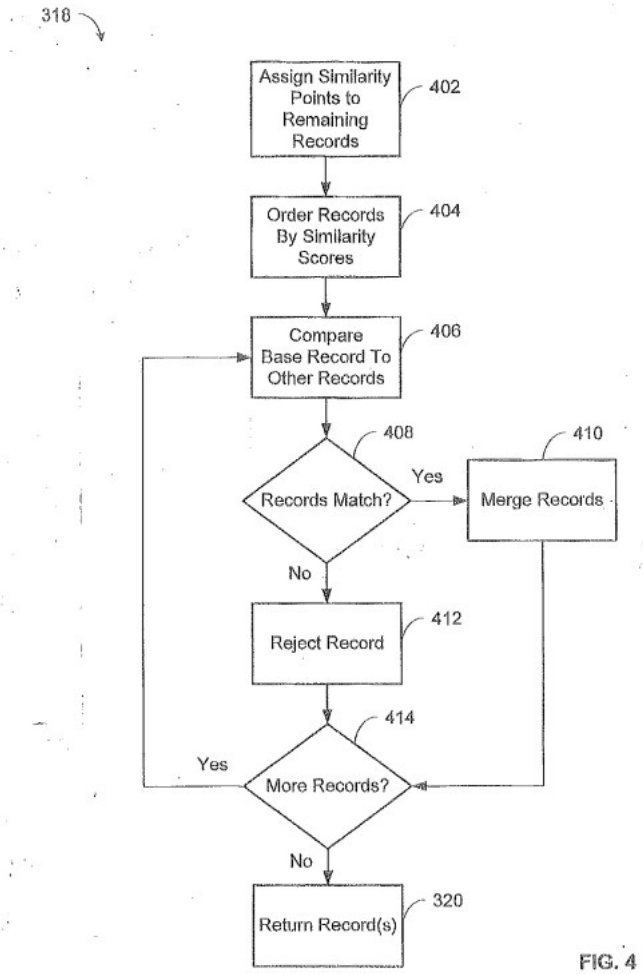


FIG. 4

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17. Figure 5, which consists of a table of exemplary matching strength points assigned for matching of fields between search queries and records, is set out below:

Match Strength	Points
Exact Name Match	6
Strong Name Match	4 or 5
Partial Name Match	2 or 3
No Name Match	1 or less
Exact ID Number Match	2
Partial ID Number Match	1
Exact Account Number Match	2
Partial Account Number Match	1

FIG. 5

Figure 6, consisting of a table of exemplary qualifying criteria for matching of search queries and records, is as follows:

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Decision Number	Matched Flag Set	Unmatched Flag Set	Minimum Name Score	Minimum ID/Account# Score
1a	ADDRESS	none	4	0
1b	ADDRESS	none	3	1
2	ADDRESS DOB	none	3	0
3	ADDRESS PHONE	none	3	0
4	ADDRESS DOB PHONE	none	2	0
5a	DOB	ADDRESS	4	1
5b	DOB	ADDRESS	3	2
6a	PHONE	ADDRESS	4	0
6b	PHONE	ADDRESS	3	1
7	DOB PHONE	ADDRESS	3	0
8	none	ADDRESS	4	2
9	ADDRESS	DOB	4	0
11	ADDRESS PHONE	DOB	4	1
12a	ADDRESS	PHONE	4	0
12b	ADDRESS	PHONE	3	1
13a	none	ADDRESS PHONE	4	2
13b	none	ADDRESS PHONE	3	3
14a	none	ADDRESS DOB	4	2
14b	none	ADDRESS DOB	3	3
15	ADDRESS DOB	PHONE	3	0
16a	PHONE	ADDRESS DOB	6	1
16b	PHONE	ADDRESS DOB	5	2
17	DOB	ADDRESS PHONE	4	2
18	ADDRESS	DOB PHONE	5	2
19a	none	ADDRESS DOB PHONE	5	4
19b	none	ADDRESS DOB PHONE	6	3
99	Exception	Exception	Exception	Exception

FIG. 6

Technical contribution and technical effect

18. On perusal of the claims, particularly the independent claim, it is evident that the monopoly claim is not in respect of any algorithm or computer programme or for information retrieval *simpliciter*, but for a method that uses algorithms, applications and programmes to enable effective credit appraisal through a technical process involving normalization, matching, assigning

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matching strength and the like. This is in contrast to applications, wherein the process involves considerations which are of a purely linguistic or semantic nature such as a word replaceability matrix that involves a mathematical model for determining the probability that a first word of a pair is semantically suitable as a replacement for the second word of a pair (*See* Decision of the Technical Board of Appeal dated November 6, 2014 in *T 0598/14*).

19. Although the claimed invention is aimed at data retrieval of cognitive information, i.e. credit risk of consumers, which is non-technical in nature, such data retrieval is achieved by a method using technical means involving: normalizing raw data in the data base records; converting search queries into standardized and structured formats; screening the plurality of database records to find the matching record to the search queries; discarding the unrelated subset; assigning matching strength points; and returning the sole/merged record(s) to the applicant. The above narration along with the figures shows that the claimed invention involves a sophisticated series of steps and cannot be equated with the job of a librarian being performed through a computer, as held in *T0309/10* wherein information archival and retrieval were accomplished through a simple normalization process by assigning a parent

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identifier, and storing and retrieving the relevant document. Therefore, the reasoning adopted by the EPO Board in *T0309/10* cannot be applied in this case. Hence, the claimed method, which is implemented via a processor, search and matching engines that aid in the technical process. Involving assigning matching strength points based on similarity between the normalized search query and data base record, and returning the desired records to the user. Such method is based on technical considerations and cannot be characterized as being solely non-technical, i.e. linguistic, semantic or otherwise.

20. In view of the foregoing discussion, the claimed invention cannot be said to fall under the categories of 'computer programme *per se*' or algorithm under Section 3(k) of the Patents Act. Instead, it involves technical considerations, achieved by technical means, and implemented on a computer involving hardware such as processor and search engines. In the impugned order, it was recorded categorically that the claimed invention satisfies the requirements of Section 2(1)(j) and that the rejection is solely under Section 3(k). Upon reaching the conclusion that Section 3(k) is not an impediment, I conclude that the impugned order cannot be sustained and is hereby set aside.

21. Nonetheless, I find that the claims are wide and not limited to the

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use of specific software (although there are indications, for instance, in paragraph [00033]) or a particular normalization or matching process. I also find that it is not possible to identify the specific normalization or matching process from the complete specification. Therefore, if granted as claimed, the scope of monopoly would extend to any method of normalizing, matching and retrieving database records based on similarities of search queries. For the limited purpose of whittling down the width of the claims by lending greater specificity, a remand is necessary. Hence, the matter is remanded for reconsideration on the limited aspect of the scope of the claims and the enablement thereof. Any amendments to the complete specification and/or claims to the extent necessary for this limited purpose shall be permitted. Considering the fact that the application was filed in 2012, it is just and necessary that the same be decided expeditiously. After providing a reasonable opportunity to the appellant, the second respondent is directed to issue a speaking order within 3 months from the date of receipt of a copy of the order.

22. (T)CMA(PT) No.159 of 2023 is disposed of on these terms without any order as to costs.

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05.11.2025

Index : Yes
Internet : Yes
Neutral Citation : Yes

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To

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Trademarks, Doudhik Sampada Bhawan
Antop Hill, S.M.Road, Mumbai-400 037

2. Assistant Controller of Patents
Patent Office Intellectual Property Building
G.S.T.Road, Guindy
Chennai-600 032.

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SENTHILKUMAR RAMAMOORTHY J.

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