OIP-108

IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Intellectual Property Rights Division)

IPDPTA/90/2023

GOOGLE LLC (77/2020/PT /KOL)
VS
THE CONTROLLER OF PATENTS

BEFORE:
The Hon'ble JUSTICE RAVI KRISHAN KAPUR
Date : 6 August, 2025.

Appearance:
Mr. VineetRohilla, Adv.
Ms. RajshreeKajaria, Adv.
Mr. Uttam Sharma, Adv.
Ms. VrindaKedia, Adv.
…for the applicant

Mr. Swatarup Banerjee, Adv.
Ms. Rashmi Bothra, Adv.
Mr. TapanBhanja, Adv.
…for the respondent

The Court: This appeal has been filed under section 117A of the Patents Act, 1970, challenging an order dated 3 July, 2020, passed by the Assistant Controller of Patents and Designs, whereby Indian Patent Application No. 2705/KOLNP/2014, titled "A Method for LabellingVisited Locations Based on Contact Information", has been rejected on the ground of non- patentability under section 3(k) of the Patents Act, 1970.

Briefly, the invention provides improved location-tracking or location-aware services through a technical implementation which has the ability to determine locations visited by use and inter-links relevant location labels with the locations visited based on the contact information. The invention also reduces or eliminates disadvantages and problems associated with "the relation of a geographical position(e.g., a latitude and longitude on the globe) with a particular location label (e.g., home, work, etc.)".

The application was filed in India on 25 November 2014 and a request for examination for the said application was filed on 27 November 2014. The First Examination Report was issued on 27 June 2018and a reply thereto was filed on 24 December 2018. Pursuant to such reply,a hearing was held on 3 December 2019 andwritten submissions were filed on 17 January 2020. The respondent sought for further clarification vide email dated 19 February 2020. Such mail trail continued till 29 February 2020. Subsequently, the impugned order was passed on 3 July 2020.

It is alleged by the appellant that the respondent erred in concluding that the invention is an "algorithm/computer program"*per se* and failed to construe the claims or apply the tests for determining the patentability of computer related inventions. Despite providing elaborate and extensive explanations about the technical effect, the respondent has rejected the same in a cryptic manner. It is further alleged that the claims have been misconstrued and misinterpreted resulting in flawed reasoning which is reflected in the impugned order. The appellant also contends that the invention entails a novel method executed by a computing device which collects user-specific location history data, determines a visited location, generates a contact location label based on contact information associated with the user, associates such label with the location, and outputs the same. It is contended that the said method goes beyond mere

implementation of a computer program *per se*, and instead manifests a technical effect, thereby rendering it patentable. The appellant also submits that the claimed process involves a practical application of computing which provides contextual awareness to the location history, thereby solving a real-world problem through a technological solution. It is also contended that the claimed method enhances the functionality of the computing device and cannot be classified as an "abstract idea". The claimed invention has a technical implementation and a definitive impact on the user experience through the device of the user. In any event, several countries have grantedpatent for the invention which has not been taken into consideration. In support of its contentions, the appellant relies on *FeridAllani v. Union of India, 2019 SCC OnLine Del 11867, Blackberry Limited v. Controller of Patents and Designs, 2024 SCC OnLine Del 6028 and Microsoft Technology Licensing, LLC v. Assistant Controller of Patents, 2024 SCC OnLine Del 3239*.

On behalf of the respondent it is contended that the subject matter of the impugned claims is devoid of any technical advancement or hardware novelty, and is nothing more than a software-implemented business logic disguised as a method claim. It is also contended that the claimed invention fails the three-pronged test laid down in the Guidelines for Examination of Computer Related Inventions (CRI Guidelines): namely, (i)

identifying the actual contribution, (ii) determining whether such contribution lies solely in a mathematical method, business method or algorithm; and (iii) assessing whether the claimed invention demonstrates a technical effect or involves novel hardware. In addition, all the steps of the claimed invention are performed within a single computing device and do not result in any tangible technical outcome beyond normal data processing. The application has been rejected under section 15 read with section 3(k) of the Act, *inter-alia* holding that the subject matter claimed is directed to a computer program *per se* and hence, non-patentable. The claims 1 to 4 fail to define any specific structural or hardware features which are articulated in terms of the functional steps which, in essence, amount to algorithmic processing. In any event, the Proof of Right document submitted in relation to one of the inventors was defective, thereby rendering the application procedurally infirm.

Section 3(k) of the Act isas follows:

> *"Section 3. What are not inventions.*
>
> > *The following are not inventions within the meaning of this Act,*
> > *(k) a mathematical or business method or a computer programme per se or algorithms;"*

The term *per se*qualifying “computer program” was introduced by way of the Patents (Second Amendment Bill) 1999. When recommending

this, the Joint Parliamentary Committee stated the following as the purpose of the qualifier :

> *"In the new proposed clause (k) the words "per se" have been inserted. This change has been proposed because sometimes 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. This amendment has been proposed to clarify the purpose."*[*Report of the Joint Committee, The Patents (Second Amendment) Bill, 1999, Parliament of India, COMM.91/2001, at p 3.*]

The core issue is whether the claimed invention, though expressed as a method executed by a computing device, constitutes patentable subject matter in light of the prohibition under section 3(k) of the Act.

The impugned order records as follows:

> *"As per the claims, "A method for labeling a location visited by a user, comprising: collecting by a computing device, location history data associated with a user; determining, by the computing device and based on the location history data, a location visited by the user; characterized by: determining, by the computing device, a contact location label based at least in part on contact information associated with the user and the location visited by the user; associating, by the computing device, the location visited by the user with the contact location label, wherein the contact location label comprises additional context for the location visited by the user; and outputting, by the computing device, the contact location label." These functional steps that started with data, added an algorithm, and ended with a new form of data [that] was directed to an abstract idea. Further, the steps of "collecting", "determining", "determining". "associating" and "outputting" are result-based functional language that does not sufficiently describe how to achieve these results in a non-abstract way. All these functions for labeling a location visited by a user are performed and controlled by a computing device (120), having a processor programmed with software with memory to store the location history data (paras[0003]-[0005] and [0020]). There isn't any data transfer from this single processor to the other blocks.*
>
> *Further, the claim as a whole is analysed to determine whether any element, or combination of elements, is sufficient to ensure that the claim amounts to significantly more than the algorithm/computer*

program. This is simply a generic recitation of computing device and a processor, performing their basic function of collecting, determining, associating and outputting according to the protocol. The claim amounts to no more than collecting a data and outputting the contact location label. Further, the processor is recited at a high level of generality and its broadest reasonable interpretation comprises only a processor to simply perform the generic computer functions of carrying out the instructions of a computer program. These generic computing elements alone do not amount to significantly more than the algorithm/computer program

Therefore, all these steps are combination of different software/computer program i.e., algorithm performed by the processor. In claims of the instant alleged invention, computer programs are claimed in the form of method /system comprising various algorithmic steps indicating the function of flow charts or process steps. These programs do not have further technical effect going beyond the "normal" interactions between the program and the hardware (processor, storage media, interfaces, a network). Also the problem solved by the claimed subject-matter is non-technical and related to administrative and management. Hence these instructions, claimed in form of different steps, are computer program per se and the subject matter of claims, though oriented towards method, yet pertains to algorithm/computer program per se. Hence, subject matter of claims 1-4 relates to "algorithm/computer program per se" and falls within scope of section 3(k) of The Patents Act, 1970 (as amended)."

The finding in the impugned order that there is no technical effect as the steps are performed based on the history which is stored in the memory of the computing device and the history data which has been processed on the computer programme does not justify any interference. The absence of any technical effect in the invention has been comprehensively dealt with in the impugned order. There is no infirmity nor perversity in the impugned order which warrants any interference whatsoever.

The subject claims, when construed purposively, reveal that the entirety of the alleged invention operates through the execution of software

instructions within a conventional computing architecture, without reciting any novel technical implementation, hardware integration, or measurable technical contribution. The specification *per se*lacked articulation of a technological problem or an improvement in the functioning of the device. A computer software or program which determines whether data which is uploaded on a server relates to how information is administered and is managed in a database on a server is a computer program *per se* and not patentable. A technical advancement would mean that such program would not work in the same way without such advancement coming into effect. This necessarily involves that something more is needed to circumvent the exclusion. The purported "technical effect" in the present invention is limited to contextual labeling based on previously stored data, which falls within therealm of administrative or management functions. The expression of functionality through result-oriented language such as "collecting", "determining", "associating" and "outputting" have been held to be abstract in nature, without sufficient technical disclosure as to the manner of implementation. The claimed method lacks any technical effect or advancement, as the steps are performed within the confines of a generic computing device and are executed solely through pre-programmed software routines. The mere automation of such a process, without more, cannot render the invention patentable.

In this connection, the Guidelines for Examination of Computer Related Inventions (CRIs) *inter alia* provide as follows:

> *"The sub-section 3(k) excludes mathematical methods or business methods or computer programme per se or algorithms from patentability. While the judgment of mathematical methods or business methods is comparatively easier, it is the computer programme per se or algorithms related inventions that require careful consideration of the examiner. Computer programmes are often claimed in the form of algorithms as method claims or system claims with some 'means' indicating the functions of flow charts or process steps. The algorithm related claims are even wider than the computer programmes claimed by themselves as a single algorithm can be implemented through different programmes in different computer languages. If, in substance, claims in any form such as method/process, apparatus/system/device, computer program product/ computer readable medium belong to the said excluded categories, they would not be patentable.*
>
> *Even when the issue is related to hardware/software relation, (e.g., when the claims recite 'processor is programmed to... or 'apparatus comprising a processor and configured/ programmed to.....) the expression of the functionality as a 'method', is judged on its substance. It is wellestablished that, in patentability cases, the focus should be on the underlying substance of the invention, not the particular form in which it is claimed. The Patents Act clearly excludes computer programmes per se and the exclusion should not be allowed to be avoided merely by camouflaging the substance of the claim by wording (e.g. different subroutines are performed in different physical locations such as processors will not suffice)."*

Further para 5 of the CRI Guidelines is as follows:

> *"Tests/Indicators to determine Patentability of CRIS:*

> *Examiners may rely on the following three stage test in examining CRI applications:*
>
> *Properly construe the claim and identify the actual contribution; If the contribution lies only in mathematical method, business method or algorithm, deny the claim;*
>
> *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."*

The language of the Guidelines suggests that one must consider whether the invention is "technical in nature" involving technical advancement as compared to the existing knowledge or having economic significance or both. (*Ramanujan's Patent Law at page 552*).

To this extent, the decisions relied on by the appellant are distinguishable and inapposite. In *Blackberry Limited v. Controller of Patents and Designs (Supra),* the petitioner was able to demonstrate technical effects both within and beyond the computer. Similarly, in *Microsoft Technology Licensing, LLC v. Assistant Controller of Patents (Supra),* the petitioner was not only able to demonstrate the improvement in the functionality of the system but also achieve an innovative technical advantage which was clearly defined and distinct from ordinary operations expected of such systems. As such, the claimed inventions in all the cited decisionswere found to be beyond the purview of section 3(k) of the Act.

In light of the above, there is no infirmity in the order dated 3 July 2020 which warrants any interference. The impugned order is adequately reasoned and has considered all the contentions of the appellant. The appellant has been unable to satisfy the objections raised under section 3(k) of the Act. In such circumstances, the appeal fails.

IPDPTA 90 of 2023 stands dismissed.

(RAVI KRISHAN KAPUR, J.)

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