



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

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Judgment Reserved on: 30.04.2025
Judgment pronounced on: 01.07.2025

+ **C.A.(COMM.IPD-PAT) 439/2022**

KROLL INFORMATION ASSURANCE, LLCAppellant
Through: Mr. Vineet Rohilla, Mr. Rohit Rangi,
Mr. Tanveer Malhotra and Mr.
Debashish Banerjee, Advocates.

versus

THE CONTROLLER GENERAL OF PATENTS,
DESIGNS AND TRADEMARKS AND ORSRespondents
Through: Mr. Piyush Beriwal, Mr. Nikhil Kumar
Chaubey and Ms. Jyotsna Vyas,
Advocates with Mr. Praveen Kumar,
Officer (through VC).

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

JUDGMENT

AMIT BANSAL, J.

1. The present appeal has been filed under Section 117A of the Patents Act, 1970 (hereinafter the 'Act') and is directed against the order dated 25th June, 2019 (hereinafter the 'impugned order') passed by the Assistant Controller of Patents and Designs (hereinafter the 'Controller'), whereby the Indian Patent Application No. 8100/DELNP/2007 titled '*A System, Method and Apparatus to locate at least one type of person, via a Peer to Peer Network*' (hereinafter 'subject patent application') has been refused.

**BRIEF FACTS**

2. Brief facts necessary for deciding the present appeal are set out below:

2.1. The appellant, Kroll Information Assurance, LLC, is an entity based in the United States of America.

2.2. The subject patent application was filed as a national phase application under the Patent Cooperation Treaty (hereinafter the 'PCT') claiming priority from the US patent application with priority date 12th April, 2005. The bibliographic details of the application are given below:

Indian Application No.	8100/DELNP/2007
Applicant	TIVERSA, INC.
Current Assignee	Kroll Information Assurance LLC
Priority Application No. & Date	US 11/103,672 Dated 12/04/2005
International Application No. & Filing Date	PCT/US2006/013666; Dated 11/04/2006
PROSECUTION	
India Filing Date	19/10/2007
Date of publication u/s 11A	04/07/2008
Request for Examination	01/11/2007



First Examination Report Issue Date	19/02/2013
First Examination Report Response Filed on	22/10/2013
Hearing Notice Issued Date	10 th April, 2019
Controller Decision	25 th June, 2019

2.3. A request for examination of the subject patent application was filed by the appellant on 1st November 2007, and the First Examination Report (hereinafter the 'FER') was issued on 19th February 2013. The following substantive objections were communicated to the appellant *via* the said FER:

- a. that the subject matter does not constitute an invention under Section 2(1)(j) of the Act;
- b. that the subject matter lacks inventive step under Section 2(1)(ja) of the Act;
- c. Claims are not sufficiently defined under Section 10(4)(c) of the Act;
- d. that the subject matter is contrary to public order under Section 3(b) of the Act;
- e. that the subject matter falls under '*algorithm*' and '*computer program per se*' under Section 3(k) of the Act.

2.4. In reply to the objections raised in the FER, the appellant submitted a detailed response *vide* letter dated 22nd October 2013, along with proposed



amendments to the Claims.

2.5. Thereafter, a hearing was scheduled for 13th May 2019, and the following objections were communicated to the appellant *via* the hearing notice:

- a. subject matter does not constitute an invention under Section 2(1)(j) of the Act;
- b. the proposed amendments of Claims 1 to 12 are not allowable under Section 59 read with Section 57 of the Act.
- c. subject matter falls under ‘*algorithm*’ and ‘*computer program per se*’ under Section 3(k) of the Act.

2.6. Post hearing, written submissions were filed by the appellant before the Patent Office on 27th May 2019.

3. The impugned order was passed by the Controller on 25th June, 2019, refusing the subject patent application on the following grounds:

- a. The proposed amendments claimed are beyond the scope of the invention under Section 59 of the Act.
- b. The Claims of the subject patent application are non-inventive under Section 2(1)(j) of the Act in light of prior art D1;
- c. The subject invention relates to ‘*algorithm*’ and ‘*computer program per se*’ under Section 3(k) of the Act.

4. The relevant extracts from the impugned order are set out below:

4.1. Regarding objections under Section 59 of the Act, the Controller has held as under:

“ 5. As response filed in view of objections raised in the hearing notice and at the time of hearing, following has been observed:”

- a. **The instant claims as filed along with response are not allowed as it violates the section 59 to claim the subject matter beyond**



the scope of the invention.

The initial filing of the claims discloses a manual searching by a person while providing input to the system whereas the latest claims as filed along with the response to hearing among other objections state on automated system to be functioning at its own.

Further the claim to locate one type of person as in latest claims is also not allowed beyond the scope of the originally filed claims.

The features as in sub-part b of III and IV of principal (sic) claim 1.

iii. receive a response from a responding computer associated with a particular user as a result of the search on the Peer-to-Peer network indicating that a file associated with the search is available for download, the response from the responding computer relating to the search on the Peer-to-Peer network, and the response from the responding computer being associated with the information being shared without knowledge of the particular user associated with the responding computer; and

iv. wherein receiving the response from the responding computer associated with the particular user indicates that the particular user is at least one type of person to be located.

Are also did not fall within the scope of the invention as originally filed. Therefore, the subject matter of the invention as explained above is not allowed under section 59.”

[Emphasis Supplied]

4.2. Regarding objections under Section 2(1)(j) of the Act, the Controller has held as under:

“Now the D1 document as an (sic) extension to the normal search procedures where D1 discloses the search in not only networked environment but also could be performed a database semantically arranged in variety of types of files, not merely a memory attached to the workstation as claimed in the instant invention.

Further the instant invention also discloses the search result would return results along with certain attributes attached with the result i.e. location of the said document.

Judgment of specific type of a person based on the search result is entirely a subjective outcome of a person manually analyzing the origin of search result.



Therefore, in view of the document D1 and general domain knowledge about searching in a networked environment, a person skilled in the art can easily implement the claimed invention; hence the said invention is not inventive.”

[Emphasis Supplied]

4.3. Regarding objections under Section 3(k) of the Act, the Controller has held as under:

“The claimed subject matter of the invention is merely performing a search within a peer-to-peer connected environment without addition of any inventive technical step therefore, the invention does (sic) not solve any new or existing technical problem other than search. The existing search techniques which are merely software modules are being implemented without any inventive technical effect with respect to the instant invention therefore the claimed subject matter is merely a repetition of existing search algorithms and programs for searching which is widely available in technical literature and known to a person skilled in the art; hence the are mere computer program per-se and same is not allowed under section 3k. The claims 2-10 for system and method claims separately do not disclose any novel or inventive subject matter with respect to reasons above mentioned.”

[Emphasis Supplied]

SUBMISSIONS BY THE PARTIES

5. The counsel appearing on behalf of the appellant has made the following submissions:

5.1. The respondent has erred in rejecting the proposed amendments under Section 59 of the Act. The features (iii) and (iv) incorporated in the form of amendments to the main Claim narrow down the scope of the original Claims. These limitations have already been disclosed and are supported by the complete specification.

5.2. The invention claimed in the subject patent application provides a



system and method for identifying sensitive or protected information and/or identifying users inadvertently sharing such information on a peer-to-peer network through profiling using specific search terms.

5.3. The technical challenge addressed in the subject patent application is the inadvertent or unauthorized sharing of sensitive data on peer-to-peer networks due to user error, malware, or malicious activity, and the need to identify and mitigate such sharing. The invention achieves a technical effect by enabling a secure environment in peer-to-peer networks through identification and removal of sensitive content or restricting responsible users.

5.4. The respondent has not considered the hardware implementation in the subject application, which is in amalgamation with the software modules as claimed in the subject matter. The respondent has erroneously considered their implementation independently, specifically focusing on software modules and has ignored the technical effect exhibited by the subject application. Reliance in this regard is placed on ***LAVA International Ltd. v. Telefonaktiebolaget LM Ericsson¹***.

5.5. Prior art D1, cited by the Controller in respect of the objection on inventive step, is concerned with a client-server network, which is different from a peer-to-peer network as claimed in the subject patent application. D1 discloses a system in which the client provides a user interface for a user to communicate with the server, which in turn responds to user queries based upon one or more of the semantic properties.

5.6. D1 does not disclose or suggest locating a particular type of person who is inadvertently sharing information based on a search and receiving a

¹ 2024 SCC OnLine Del 2497



response from the particular type of person, as claimed in the subject invention. Further, it fails to suggest locating a malicious person who intentionally selects a folder as the shared folder that contains sensitive information. Hence, the features of Claim 1 are not disclosed by the cited document D1.

5.7. The respondent has held that prior art D1, along with general domain knowledge, makes the subject invention obvious to a person skilled in the art. The respondent has failed to establish the common general knowledge available on the priority date of the subject patent application. Moreover, the respondent has failed to construe the Claims and identify their actual technical contribution and technical advancement exhibited by the subject invention.

5.8. The corresponding applications in major jurisdictions, *inter-alia*, USA, China, Australia, and Japan, have proceeded to grant of patent.

6. Per Contra, counsel for the respondent has made the following submissions:

6.1. The proposed amendments filed by the appellants were not supported by the originally filed Claims. The appellant failed to justify how these amendments fall within the scope of the original Claim.

6.2. The claimed invention is essentially a computer-implemented algorithm for query processing in a peer-to-peer network. It does not solve any identifiable technical problem or demonstrate a technical effect. Hence, it falls squarely within the subject matter exclusion under Section 3(k) of the Act.

6.3. No evidence or comparative analysis was provided to show how the claimed invention overcomes cited prior art or exhibits an inventive step. References to the specification without correlating them to the scope of the



Claims are insufficient.

6.4. The appellant has claimed a method for locating a type of person on a peer-to-peer network, using a system comprising a storage medium and a processor for executing search instructions. However, the search within a peer-to-peer environment is routine and obvious to a person skilled in the art.

6.5. The invention claimed in the subject patent application lacks inventive step under Sections 2(1)(j) and 2(1)(ja) of the Patents Act.

Analysis and Findings

7. I have heard the learned counsel for the parties and examined the records of the case.

REFUSAL UNDER SECTION 59 OF THE ACT

8. I will first consider the permissibility of the proposed amendments under Section 59 of the Act.

9. A comparative table depicting the originally filed independent Claim 1 and the amendments proposed to it is set out below:

Original Claims	Proposed Amendments
1. A system for searching a Peer-to-Peer Network for at least one of specific types of people or specific types of information by using at least one specific search term known to result in locating said specific types of people or specific types of information, said system comprising: a. a storage medium for storing instructions; b. a user input device for receiving user input;	1. A system to locate at least one type of person, via a Peer-to-Peer network, the system comprising: a. a storage medium for storing instructions; and b. a processor unit for executing the stored instructions to: i. connect to the Peer-to-Peer network; ii. issue a search on the Peer-to-Peer network



<p>and</p> <p>c. a processor unit operable to process said user input and to use said</p> <p>instructions to execute a program to:</p> <p>i. connect to said Peer-to-Peer network; and</p> <p>ii. issue at least one specific search term known to locate said specific types of people or specific types of information.</p>	<p>for a specific term or specific group of terms, wherein the search is utilized to find information that should not be shared among computers connected to the Peer-to-Peer network, and wherein the computers in the Peer-to-Peer network are each associated with at least one user;</p> <p><u>iii. receive a response from a responding computer associated with a particular user as a result of the search on the Peer-to-Peer network indicating that a file associated with the search is available for download, the response from the responding computer relating to the search on the Peer-to-Peer network, and the response from the responding computer being associated with the information being shared without knowledge of the particular user associated with the responding computer; and</u></p> <p><u>iv. wherein receiving the response from the responding computer associated with the particular user indicates that the particular user is the at least one type of person to be located.</u></p>
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10. A perusal of the aforesaid table would show that the originally filed independent Claim 1 was amended, and sub-paragraphs (iii) and (iv) have been added.



11. The Controller in the impugned order has held that the additional features (iii) and (iv) of amended Claim no.1 are beyond the scope of the originally filed Claim 1.

12. The scope and ambit of Section 59 of the Act has been interpreted by a coordinate bench of this court in *Nippon A & L Inc. v. Controller of Patents*².

The relevant paragraphs of this judgement are:

“40. A perusal of Section 59(1) shows that an amendment of an application, specification or any document related thereto would be permissible only if the following conditions are satisfied:

(i) The amendment has to be by way of disclaimer, correction or explanation; And

(ii) The amendment has to be for the purpose of incorporation of actual facts; And

(iii)(a) The effect of the amendment ought not be to amend the specification to claim or describe any matter which was not disclosed in substance or shown in the originally filed specification.

And

(iii)(b) The amended claims have to fall within the scope of claims as originally filed.

41. Thus, for an amendment to be allowed all conditions have to be satisfied. Any amendment falling foul of (i), (ii), (iii)(a) or (iii)(b) above cannot be allowed.”

[Emphasis Supplied]

13. The aforesaid extract stipulates that only the amendments which are in the nature of either disclaimer, correction or explanation are permissible under Section 59 of the Act. Further, while amending the Claims, the scope of the original Claims should not be broadened and the proposed amendments should be in line with the original Complete Specification.

² 2022 SCC OnLine Del 1909



14. In the present case, a reading of the proposed amendments in Claim 1 would show that the additional features proposed to be added by the appellant, *via* sub-paragraphs (iii) and (iv), are in fact limitations, specifying the retrieved information as mentioned in sub-paragraph (i). These additional features narrow down the scope of the Claims. Further, the additional features are in the nature of explanation, which explains how the locating of a specific file and person is done, and do not include anything which was not disclosed in the Complete Specification. In my view, the proposed amendments in Claim 1 are fully within the scope of Section 59 of the Act. Accordingly, the findings of the Controller, insofar as they relate to rejection of the proposed amendments, are erroneous and are set aside.

REFUSAL UNDER SECTION 3(k) OF THE ACT.

15. I will now consider the objection of the Controller under Section 3(k) of the Act.

16. A perusal of the impugned order passed by the Controller would show that the subject patent application has been refused under Section 3(k) of the Act on the basis that the invention claimed in the subject patent application is in the nature of ‘*algorithm*’ and ‘*computer programme per se*’.

17. For understanding the invention claimed in the subject patent application, a reference may be made to the summary of the invention as given in the Complete Specification of the subject patent application, and the same is reproduced below:

“Generally, the present invention provides a system for locating specific types of people of specific types of information by issuing specific search terms known to result in a response from a specific type of person or a response by someone with, a specific type of information. The preferred system comprises:



- a. a storage medium for storing instructions;*
- b. a user input device for receiving user input; and*
- c. a processor unit operable to process the user input and to use the instructions to execute a program to:*
 - i. connect to the Peer-to-Peer network; and*
 - ii. issue a search for a specific term or specific group of terms for a specific type of person or a specific type of information.*

The present invention also provides a method for locating specific types of people or specific types of information.”

[Emphasis Supplied]

18. A reading of the aforesaid extract would show that the invention pertains to a system and method for identifying specific types of people or specific types of information on a peer-to-peer network. It operates by using specific search terms to query the network, with the objective of profiling users or locating particular types of data based on the search results. The system also uses standard computing components such as a processor, memory, storage and conventional software to execute keyword-based searches across the peer-to-peer network.

19. In the Complete Specification, the appellant has also provided an example illustrating the working of the invention claimed in the subject patent application, which is reproduced below:

“Example 1: This example illustrates a system for locating information relating to military operations.

Military operation change orders are called frago's. In this example, user #1 wishes to locate military personnel. User #1 connects to the Peer-to-Peer network and issues a search for the term "frago." User #2 is in the military and has a file named "frago-opordl.doc." User #2 responds to User #1 that he possesses a file that matches the term "frago" and makes the file available for User #1 to download. User # 1 has located military information being shared by military personnel.”



20. To get further clarity on the invention claimed in the subject patent application, a table depicting the amended Claims and the subject matter covered in them is given below:

CLAIM	SUBJECT MATTER
Claim 1	1. System to locate a person, in a peer-to-peer network comprising a storage and a processing medium. 2. The processing unit (a) connects to the network, (b) issues search, (c) receives response and indicates the user which qualifies the search request.
Claim 2	System claimed in Claim 1 wherein person is related to financial, identity, investment or credit card activities.
Claim 3	System claimed in Claim 1 wherein person is related to corporate activities
Claim 4	System claimed in Claim 1 wherein person is related to corporate financials
Claim 5	System claimed in Claim 1 wherein person is related to miscellaneous corporate operations
Claim 6	System claimed in Claim 1 wherein person to be located should not be sharing info about search request
Claim 7	System claimed in Claim 1 wherein person to be located is the one sharing info about another entity related to search request
Claim 8	Method to be performed on a system including storage and processing units comprising (a) connecting system, (b) issuing search, (c) receiving info and (d) identifying user which qualifies the search request.
Claim 9	Method claimed in Claim 8 wherein the person to be located is a person unauthorizedly sharing info
Claim 10	Method claimed in Claim 8 wherein the person to be located is a person unauthorizedly sharing info related to another entity

21. To examine the aspect of whether the invention claimed in the subject application relates to a '*computer programme per se*' or '*algorithm*', a reference may be made to the **Guidelines for Examination of Computer Related Inventions, 2017** [hereinafter the 'CRI Guidelines'] issued by the



Patent Office. The relevant extracts from CRI Guidelines relating to ‘algorithm’ and ‘computer programme per se’ are set out below:

“4.5 Determination of excluded subject matter relating to CRIs:

“Since patents are granted to inventions, whether products or processes, in all fields of technology, it is important to ascertain from the nature of the claimed Computer-related invention whether it is of a technical nature involving technical advancement as compared to the existing knowledge or having economic significance or both, and is not subject to exclusion under Section 3 of the Patents Act.

The sub-section 3(k) excludes mathematical methods or business methods or computer programme per se or algorithms from patentability. 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. It is well-established that, while establishing patentability, the focus should be on the underlying substance of the invention and not on the particular form in which it is claimed.

What is important is to judge the substance of claims taking whole of the claim together. If any claim in any form such as method/process, apparatus/system/device, computer program product/ computer readable medium falls under the said excluded categories, such a claim would not be patentable. However, if in substance, the claim, taken as whole, does not fall in any of the excluded categories, the patent should not be denied.

Hence, along with determining the merit of invention as envisaged under Sections 2(1) (j), (ja) and (ac), the examiner should also determine whether or not they are patentable inventions under Section 3 of the Act.”

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xxx

xxx

4.5.3 Claims directed as “Algorithm”: Algorithms in all forms including but not limited to, a set of rules or procedures or any sequence of steps or any method expressed by way of a finite list of defined instructions, whether for solving a problem or otherwise, and whether employing a logical, arithmetical or computational method, recursive or otherwise, are excluded from patentability.



4.5.4 Claims directed as “Computer Programme per se”: Claims which are directed towards computer programs per se are excluded from patentability, like,

(i) Claims directed at computer programmes/ set of instructions/ Routines and/or Sub-routines.

(ii) Claims directed at “computer programme products” / “Storage Medium having instructions” / “Database” / “Computer Memory with instruction” stored in a computer readable medium.

The legislative intent to attach suffix per se to computer programme is evident by the following view expressed by the Joint Parliamentary Committee while introducing Patents (Amendments) Act, 2002:

“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.”³”

[Emphasis Supplied]

22. In terms of the aforesaid CRI Guidelines, an ‘algorithm’ is a mere sequence of instructions or set of rules or procedures or any sequence of steps and is not considered to be subject matter eligible for the grant of a patent. Further, a ‘computer programme per se’ stored as instructions in a computer memory in a computer-readable medium would also not be an eligible subject matter for the grant of a patent.

23. Therefore, in terms of Section 3(k) of the Act, an ‘algorithm’ or ‘computer programme per se’ is not patentable. Further, while assessing the patentability of ‘computer programme per se’ under Section 3(k) of the Act,

³ Report of the Joint Committee presented to the Rajya Sabha on 19th December, 2001 and laid on the table of Lok Sabha on 19th December 2001



the Controller has to see whether the invention results in a technical effect or a technical advancement of the hardware.

24. The scope of patentability of ‘algorithms’ and ‘computer programme per se’ under Section 3(k) of the Act was examined by me in ***Lava*** (supra).

The relevant observations in ***Lava*** (supra) are set out below:-

“69. After analysing the CRI Guidelines and the aforementioned judgments, I am of the view that the inventions that are solely directed towards algorithms, mathematical methods, business methods or are computer programmes per se, would not satisfy the test of patentability and would consequently not be inventions. However, an invention that merely incorporates algorithms, sets of instructions, mathematical or business methods within a method or system, and satisfies all the criteria for patentability, is not inherently non-patentable. **Therefore, what has to be seen is that if the algorithms are directed at enhancing the functionality of a system or a hardware component, the effect or the functionality derived by the system or the hardware component is a patentable subject matter. However, the algorithm itself is not a patentable subject matter.** To illustrate, we may consider the example of a smart thermostat algorithm that dynamically adjusts the heating or cooling of a room in a building based on real-time weather data, occupancy patterns and energy prices. This algorithm, by itself, is a series of computational steps and may not be patentable. However, the implementation of this algorithm within a device, even if the said device is a general-purpose computer, in such a way that it transforms the computer’s capabilities and leads to tangible benefits like reduced energy consumption, cost savings and improved comfort levels for occupants, can be considered as a patentable subject matter.

70. It is clear that an invention should not be deemed a ‘computer programme per se’ merely because it incorporates algorithms and computer executable instructions. **In fact, the patentability should be assessed based on its practical application in solving technical problems and the technical advancements it offers. Furthermore, if the subject matter is implemented on a general-purpose computer, but results in a further technical effect that improves the computer system’s functionality and effectiveness, the claimed invention cannot be rejected as non-patentable for being a ‘computer programme per se’. This aligns with the intent behind the qualifier ‘per se’, introduced by the legislature in the Patent (Amendment) Act of 2002 for computer programmes.**



Further, the said approach also aligns with the legislative intent behind the patentability of software related inventions, which is evident from the press release issued by the Press Information Bureau dated 27th December, 2004 titled – ‘Kamal Nath's statement on the Ordinance relating to Patents (Third) Amendment’. The relevant extracts from the said press release are set out below:

“8. In IT, the trend is to have software in combination with or embedded in hardware - such as in computers or cell phones or a variety of other gadgets. Software as such has no patent protection (the protection available is by way of copyright), but the changing technological environment has made it necessary to provide for patents when software has technical applications in industry in combination with hardware. This has been a demand of NASSCOM.

xxx xxx xxx

11. The ordinance is the same as the Bill introduced last year with improvements in some significant respects. We have introduced for patenting of software that is embedded in hardware [...]” (Emphasis supplied)”

[Emphasis supplied]

25. In *Microsoft Technology Licensing v. Controller of Patents & Designs*⁴, a coordinate bench of this Court, after considering the judgment in *Lava* (supra), held that for a software invention to overcome the bar under Section 3(k) of the Act, it has to have a technical transformation that significantly enhances the hardware functionality. The relevant extracts from *Microsoft* (supra) are given below:

“Technical effect of the subject patent application

33. In light of the above discussion, it is clearly established that in case of an invention involving computer programmes, to circumvent the limitations imposed by Section (k) of the Act, a patentee must demonstrate that the overall method and system disclosed in the patent application, upon implementation in a general-purpose computer, must contribute directly to a specific and credible technical effect or enhancement beyond mere general computing processes. Therefore, the

⁴ 2024 SCC OnLine Del 3239



inventive contribution of a patent should not only improve the functionality of the system but also achieve an innovative technical advantage that is clearly defined and distinct from ordinary operations expected of such systems.”

[Emphasis supplied]

26. The aforesaid judgments in *Lava* (supra) and *Microsoft* (supra) were considered by a coordinate Bench in *Blackberry v. Controller of Patents & Designs*. The relevant extract from *Blackberry* (supra) is set out below:

“48. Accordingly, it is evident that insofar as algorithms are concerned, if the invention relates purely to a set of instruction or policies which determine the flow without any substantial change in the hardware, such instructions even if they have a bearing on the manner in which the flow of data occurs would not be entitled to patent protection in India.”

[Emphasis supplied]

27. Holding that the technical contribution of the subject matter of the patent application therein was solely covering a complex sequence of instructions without offering any technical effect or advancement on the hardware, the coordinate bench in *Blackberry* (supra) sustained the objection of the Controller under Section 3(k) of the Act.

28. It is apparent from the judgments discussed above that for a software or computer programme to qualify as an eligible subject matter under section 3(k) of the Act, it should be more than a mere sequence of instructions and should result in significant technical effect or advancement of the hardware.

29. Applying the rationale of the aforesaid cases to the facts of the present case, it is clear that the invention claimed in the subject patent application utilizes conventional and generic computer hardware components which implement the computer programme used to connect to the peer-to-peer



network and issue searches, performing standard operations where a sequence of instructions is given by the user to achieve the desired result of profiling and finding the relevant information and users associated with the same.

30. After examination of the Complete Specification along with the Claims, in my view, the invention claimed in the subject patent application is merely enabling a search within a peer-to-peer network. The function of search is being performed based on the keywords given by the user, which reflects conventional '*computer programme*' behaviour. Therefore, it cannot be stated that the '*computer programme*' is enhancing the functionality of the hardware. Furthermore, the profiling aspect of the invention, which uses keyword lists to search for specific types of users or data, is abstract in nature and lacks any technical character.

31. As a result, the features claimed in Claims 1 to 7 fall under the category of '*computer programme per se*', and Claims 8 to 10 fall under the category of '*algorithms*'. Therefore, they will collectively fall within the scope of excluded subject matter under Section 3(k) of the Act, being directed towards a mere '*algorithm*' or '*computer program per se*' without any demonstrable technical advancement.

32. Therefore, I am unable to accept the submission of the appellant that the subject invention demonstrates a technical effect or a technical advancement to the hardware, which takes it beyond the realm of an '*algorithm*' or '*computer programme per se*', as prescribed in Section 3(k) of the Act.

33. In my considered view, the appellant's reliance on the judgments in *Lava* (supra) and *Microsoft* (supra) is misplaced. In fact, the reasoning adopted in *Blackberry* (supra) for upholding non-patentability under Section



3(k) of the Act would squarely be applicable in the present case. The invention claimed in the patent application is a mere sequence of instructions stored in hardware without solving any technical problem or offering any technical advancement to the hardware.

34. In view of my conclusion that the subject patent application has rightly been refused by the Controller under Section 3(k) of the Act, I need not examine the sustainability of the rejection under Section 2(1)(j) of the Act.

35. Accordingly, for the reasons discussed above, there is no error in the finding of the Controller that the subject patent application cannot be granted in terms of Section 3(k) of the Act.

36. Accordingly, the present appeal is disposed of

37. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trade Marks of India on the e-mail- llc-ipo@gov.in.

**AMIT BANSAL
(JUDGE)**

JULY 01, 2025

Vivek/-