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OA/17/2020/PT/DEL

MONDAY, THIS THE 20TH DAY OF JULY 2020

**HON'BLE SHRI JUSTICE MANMOHAN SINGH**  
**HON'BLE DR. ONKAR NATH SINGH**  
**MEMBER (PVPAT)**

**CHAIRMAN**  
**TECHNICAL**

1. **ALLANI FERID**  
65, BOULEVARD LANNES, F-75016.  
PARIS, FRANCE

...APPLICANT/APELLANT

(Represented by: MR. Praveen Anand and Ms. Archana Shanker )

Versus

1. **ASSISTANT CONTROLLER OF**  
**PATENTS & DESIGNS**  
THE PATENT OFFICE, BOUDHIK  
SAMPADA BHAWAN, PLOT NO. 32,  
SECTOR 14, DWARKA, NEW DELHI - 110  
075

...RESPONDENT

(Represented by – None)

**ORDER**

**HON'BLE SHRI JUSTICE MANMOHAN SINGH, CHAIRMAN**

The present appeal under Section 117A of the Indian Patents Act has been fixed against the order dated 07<sup>th</sup> February, 2020 passed by respondent being the Controller of Patents under section 15 of the Indian Patents Act, who rejected the appellant's Indian patent application No. IN/PCT/2002/00705/DEL (hereinafter referred to as IN'00705)

2. The facts of the case are that the appellant has filed the present patent application entitled **“METHOD AND DEVICE FOR ACCESSING INFORMATION SOURCES AND SERVICES OF THE WEB”** on 17<sup>th</sup> July, 2002 at the Indian Patent Office and allotted the application No. IN/PCT/2002/705/DEL.

3. The present patent application No. IN/PCT/2002/705/DEL derived from PCT International Application No. PCT/FR00/03759 dated 29/12/2000, which claims priority from the French Application No. 99/16704 dated 30<sup>th</sup> December, 1999.

4. A request for examination for the said patent application IN/PCT/2002/705/DEL was filed on 19<sup>th</sup> November 2004. The application was published under the provisions of Section 11(A) of the Patents Act, 1970 as amended in 2005 (hereinafter referred as ‘Act’) on 31/08/2016.

The application was examined and First Examination Report (FER) was issued on 21<sup>st</sup> February 2005 with objections raised that *“subject matter does not constitute under section 2(1)(j) as it lacks inventive in view of the prior art i.e.D-1 for the invention titled “Method and device for accessing information sources and services on the web EP0847019”.*

5. In response to the objections raised in the said FER the appellant’s agent submitted the response via their letter dated 17<sup>th</sup> September 2005.

Second examination report was issued on 21<sup>st</sup> September, 2005 maintaining the objections of first examination report on claims 9-14 along with a technical objection of non-allowability of claims 1-8 under section 3(k) of the Act. As no response to second examination report was filed, the application was deemed to have been abandoned under section 21(1) of the Act.

6. The appellant had filed the writ petition © No.6836 of 2006 challenging order of abandonment of Patent Application No. IN/PCT/2002/00705/DEL was filed on 2<sup>nd</sup> May 2006

7. On 25<sup>th</sup> February 2008 Hon'ble High Court directed Indian Patent office to review the Patent Application no. IN/PCT/2002/00705/DEL by providing the necessary opportunity of oral or written hearing. The response to further First Examination report dated 21<sup>st</sup> September, 2005 was filed on 20<sup>th</sup> March 2008. Thereafter, a hearing was scheduled for 22<sup>nd</sup> August 2008, in the matter by Patent Office in view of directions of the Hon'ble Delhi High Court. The agents for the appellant appeared for the hearing and submitted written submissions on 12<sup>th</sup> August 2008.

8. The respondent by an order dated 18<sup>th</sup> November 2008 refused the application. An appeal under section 117A(2) of the act against said order dated 18<sup>th</sup> November 2008 was filed before the IPAB on 20<sup>th</sup> February 2009. IPAB dismissed aforementioned appeal.

9. The appellant filed the writ petition before the Hon'ble High Court of Delhi on December 19<sup>th</sup>, 2013 in view of said dismissal of appeal.

10. Delhi High Court order dated 12<sup>th</sup> December, 2019 disposed the petition and has directed the Indian Patent Office to re-examine the said patent application No. IN/PCT/2002/00705/DEL. The Hon'ble High Court held that the bar on patenting is in respect of '*computer programmes 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.

11. Thereafter, in view of said order of Hon'ble High Court of Delhi a hearing was scheduled by Patent Office on 27<sup>th</sup> January, 2020. The agents for the appellant for the hearing via video conferencing and submitted written submissions.

The respondent by an order dated 07<sup>th</sup> February 2020 refused the application . The respondent refused the grant of patent on application No. IN/PCT/2002/705/DEL (IN' 00705) also on the grounds that claimed invention lacks novelty falls under section 3(k).

The said has been challenged before us. Despite of service, no counter affidavit has been filed. No one appeared on behalf of respondent. It is the admitted position that term of patent is expiring in December 2020. Thus, the appeal was heard on urgent basis.

12. The invention as claimed by the appellant in the rejected independent claim(s) of IN" 00705 is as follows:

(i) The present invention provides a method and device for accessing information sources on the web.

(ii) As also discussed in the complete specification

(iii) Before the disclosure of present invention, in response to a request for a particular information resource, typically, the requesting station (e.g. aclient) .... Can receive either directly a document, or usually a new HTML page containing itself a more and less high number of links among which the user will still have to make a new choice....”

iv) As such request for search before the present invention was merely a generalized one, and therefore multiple request-answer step(s) are generated and a corresponding delay is associated for each such request for information resource.

Thus as a disadvantage, response time and search duration for such a request is significantly increased and one of the reason for the same is generalized nature of request without clear details of the information requested.

It is alleged that in order to overcome at least said disadvantage , the present invention proposes to first extract clear and concise details of the information resource the user is looking for in a localized manner (e.g. on a client device) before passing a well construed query to internet. All such localized steps for such extraction called “preliminary selection steps” are implemented locally on a client machine deliberately avoiding an access to the web unless necessary information for a well formed query is obtained from user. Likelihood of a successful access of information resource increases manifold.

### 13 Claims of the appellant

It is the claim of the appellant that the main objective of present invention to be able get the desired information resource with a single“hit” to the web (to achieve above technical advantages) the present invention advantageously teaches delaying such a hit to the web unless necessary parameters to construe the request have been extracted from user.

Such extraction from user (implemented via preliminary selection steps) is done locally on client machine without accessing the web.

Said feature (s) of Para 0032 above are illustrated at least via FIGURE 1 of the Complete Specification.



and **present invention** is that **D1** is related to method of selection from two options which are already available to a user while present invention is directed to a method (and device) for accessing information resources not available to user.

13.1. It is submitted that the fundamental difference can be understood at least from the abstract of D1 which states that

*“...In an information processing system a user is given access to two subsets (203, 206) of information items through two respective hierarchical multi-level menu-structure (100,204). The second of the menu- structures (204) comprises at least the sub-menus provided for in the first of the menu-structures(100)and the **second of the subsets (206) includes at least the information items included in the first of the subsets (203)....”***

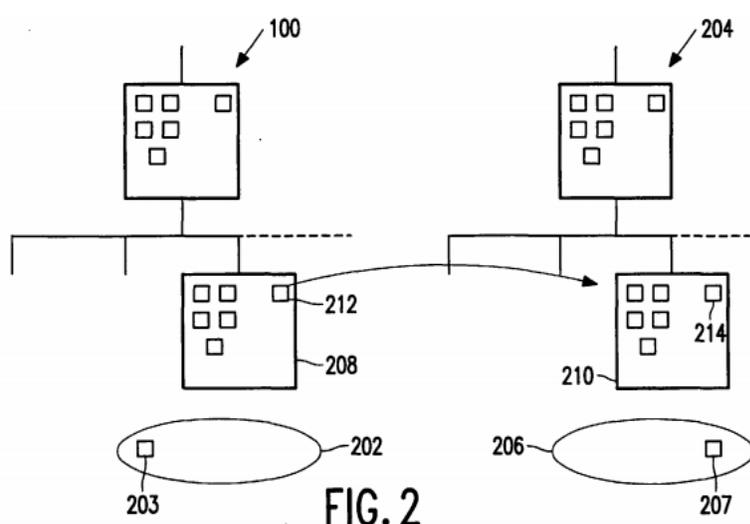
It is informed that in fact, **D1** describes that first subset of data items on a local station is actually merely acting as a cache for second subset of data items on a central station.

In this regard, **D1** states

*“...The invention is not limited to such a system with a local station and a central station but can also be employed in other systems, e.g. where the first subset forms some kind of cache for the second subset...”*

Thus, again confirming that **D1** is suitable as a method of selection only.

It is submitted that for example, admittedly, **D1** enables a user to select the particular information item from a first subset of the information items through a first hierarchical multi-level menu-structure and to alternatively select the particular information item from a second subset of the information items.



A user is able to proceed from a particular sub-menu in the first menu-structure to a corresponding sub-menu in a second hierarchical multi-level menu-structure (for selecting the particular information item from the second subset through the second menu-structure) because the second menu-structure comprises sub-menus corresponding to the sub-menus of the first menu-structure and the second subset comprising the information items of the first subset i.e. in **D1** both first menu structure and second menu structure have similar structure of navigation. **D1** clearly states that it “...offers the user access to the second subset of information items in a way that is highly similar to the way of access to the first subset of information items. This relieves the cognitive load of the user when navigating between the first and second subset of information items, because initially the user only has to familiarise himself with a single menu-structure that underlies both the first and the second menu-structure...”.The **D1** in its own language admits that it “...enables the user to return from a particular sub-menu in the second menu-structure to the corresponding sub-menu in the first menu-structure. This offers the user the possibility to return to the first menu-structure, after having consulted the second menu-structure...”.

Thus, again the first menu structure and second menu structure are used for “consultation”.**DI** also states that “...local station is connected to the central station via Internet...”.

Thus, for each such “*consultation*” D1 makes use of internet. Further, importantly, as disclosed in **D1**,

“...upon selecting the particular item from the second subset, **it is verified whether the first subset comprises an information item corresponding to the particular information item in the second subset** and if such information item is comprised in the first subset then this information item is accessed to substitute for the particular information item. By verifying whether the first subset of the information items comprises an information item corresponding to the particular information, i.e. an information item containing data on the same subject as the particular information item that has been selected by the user from the second subset of information items, a transfer of the data of that information item from the second menu-structure to the first menu-structure can be avoided. The data on that subject can in that case be retrieved from the information item in the first subset. This then avoids the need of sending potentially a lot of data over the network, in the case the method according to the invention is applied for a local station with the first menu-structure and a central station with the second menu-structure. ...”

**D1** goes on to state that

“.....*second menu-structure allows modification to include a further sub-menu and/or to include an updated information item. The fact that the second menu-structure and/or the second subset of information items can be updated makes it in an easy way possible to supply the user with more recent data. This is because the first menu-structure and the first subset of the information items may remain static, i.e. the structure and items are not updated, while the user gets access to the more recent data through the second menu-structure....”*

Thus it is stated that in essence **D1** merely provides a selection method to access to the more recent data through the second menu-structure.

In this regard, **D1** states that

*“...data in the local subset can be stored in a format that is particularly suitable for the local station, whereas the data stored in the external subset must be stored in a generally applicable format since potentially different types of local station must be able to receive and interpret that data. An example is that the data concerns a still image which is stored in high resolution in the local subset and in a low resolution in the second subset, because the high resolution image would take too much time to be transferred. Another example is that the data constitutes in the local subset a video track in MPEG format and in the external subset a slide show with a number of still images, mimicking a video track, because not all kinds of local stations that are serviced from the external subset can handle MPEG....”*

13.2. Further, **D1** states that

*“.....The first subset 202 includes a selection of the information items available to the user. .... The second subset 206 includes at least the information items that are also included in the first subset 202. A particular information item included in the second subset 206, like information item 207, may contain data that are different from the data contained by the corresponding information item in the first subset. So an information item can be included in both subsets, like an element that is a member of two sets in the mathematical sense, while its data in the two subsets remains distinct. An information item is to be understood as an identification for the data that can be retrieved for a user. An example is an information item that is the Eiffel Tower in Paris, whereby its data in the first subset is a still image in first format (e.g. JPEG) and its data in the second*

subset is a still image in a second format (e.g. GIF). Then both subsets include the same information item Eiffel Tower, the first subset contains the JPEG image and the second subset contains the GIF image....”

Thus, in nutshell, **D1** merely allows a user to selection different versions of same data items stored on two menu structures. One version on local station and another on a central station.

**13.3** In deep contrast with present invention **D1** does not allows a user to search for an information resource which is not already present on either of the menu structures be it on local station or on central station (as it is a method of selection).

In fact, importantly, **D1** merely refers to second menu structure on a central station which contains more recent version of data items (as it is updated) and **consumes bandwidth resources (against the teaching of present invention) for this as well irrespective of whether this will result in a successful selection or not.**

Also, as submitted above with respect to **D1** local station is connected to a central station VIA Internet.

Every time a user migrates to second menu structure , as explained above it is verified whether the first subset comprises an information item corresponding to the particular information item in the second subset and if such information item is comprised in the first subset then this information item is accessed to substitute for the particular information item.

Thus, in **D1**, a user migrates to second menu structure of server irrespective of whether it has the data item or not. Therefore, as discussed it would **NOT** be fair to say that **D1** suggests that every time a data item is not present on first menu structure that user referred to second menu structure on central station.

13.4. Further, every time a user proceeds from a particular sub-menu in the first menu-structure to a corresponding sub-menu in a second hierarchical multi-level menu-structure whether for mere consultation or for accessing another version of data item the CENTRAL STATION is accessed via INTERNET.

Thus, irrespective of whether data item on second menu structure is retrieved or not i.e. second menu structure is merely consulted or an actual data item is accessed, internet access is made to central station which itself **defeats** the teaching of present invention that web/internet access must be made only as a single and final step for a single retrieval of information which is not available with user.

In fact, as per **D1** multiple access to central station can be made via internet (thus using bandwidths multiple time) even a before a single item of retrieval is made.

“...the local station is connected to the central station via Internet. Since Internet is widely available and used by many people, it is advantageous to use Internet as the connection mechanism between the local station and the central station in the method according to the invention...”

13.5. Further, as submitted before **D1** is merely a method of selection.

Thus, as **D1** teaches against the disclosure of present invention i.e. delaying and emitting of only a “final” and “single” well –directed request to internet/web, it does not make the present invention obvious.

13.6. Structure which is a well known technique in the art.

In response thereto, it is submitted that hierarchical structure navigation is merely a known algorithm on which vast number of inventions serving different purposes may be based.

**D2** is allowing online help information by providing a navigational window pane and a HTML window pane in a single window. Once a user selects a topic in the navigational window pane, the corresponding content information is displayed in the HTML window pane.

The crux of **D2** is to provide both navigational window and HTML window pane on a single window (which displays the results) as a matter of convenience.

**D2** states that

“.....By simultaneously providing both the navigational window pane and the HTML window pane to the user, the user can easily determine whether the displayed information in the HTML window pane is desired. If it is not desired, the user can quickly and readily select different information without having to change or close the window. As a result, the user is able to more easily and effectively access online information and/or use the help application than was possible with prior art techniques for providing user information....”

13.7. With regard to D-3, it is alleged that **D3** merely relates to providing services over internet and does not overcome the shortcomings of **D1** and **D2** as submitted above which are not repeated merely for the sake of brevity.

13.8. That with respect to Respondent's objection that claimed invention falls under section 3 (k) we note that as per section 3 ,among other things, following are not inventions within the meaning of this Act

“...mathematical or business method or a computer program *per se* or algorithms..”

14. Admittedly the Hon'ble High Court of Delhi via order W.P. (C) 7/2014 & CM APPL. 40736/2019 dated December 12th, 2020 made, among others, following observations:

“... ”

10. 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<sup>1</sup> 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 amendment has been proposed to clarify the purpose.”<sup>2</sup> ...”*

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...”

15. It was also observed by **Hon’ble Delhi High Court** 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..”, we are providing our submissions accordingly.

16. It is submitted on behalf of the appellant that the present invention delays emitting of a “final” request to (web) internet by locally implementing preliminary selection steps and using said locally implemented selection to form a well-constructed query which is finally emitted to Internet. As only a “final” and “single” well-directed request is emitted to internet, at least following **technical advantages** are achieved as alleged.

- bandwidth (for emitting a request on web/ internet) is utilized only once (per request) [saving of network resources]
- the mean time duration observed for accessing searched information is drastically reduced
- likelihood of a successful access of information resource increases manifold.

These technical advantages now fall under paragraphs of Guidelines for Examination of Computer Related Inventions, 2013 which define “technical effect” (and “technical advancement”) as under:

*“...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:*

- *Higherspeed*
- *Reduced hard-disk accesstime*
- *More economical use ofmemory*
- *More efficient data base searchstrategy*
- *More effective data compressiontechniques*
- *Improved useinterface*
- *Better control of roboticarm*
- *Improved reception/transmission of a radiosignal...”*

17. Counsel for the appellant submits in that in view of present invention as claimed clearly exhibits a **“technical effect”** for

- avoiding the use unnecessary bandwidth (for emitting a request on web/ internet) as the same is utilized only once (per request) [saving of network resources] and when search request has sufficient details

i.e. till the user has not provided sufficient details in the search request, no request is emitted to internet and bandwidth is not consumed.

- reducing the mean time duration observed for accessing searched information.

Thus, claimed invention falls under at least the following indicators of technical effect i.e. *Higherspeed, more economical use ofmemory* and a *more efficient data base searchstrategy*.

As observed by Hon'ble High Court of Delhi in said order W.P. (C) 7/2014 & CM APPL. 40736/2019 dated December 12th, 2017. In para 10 it was observed that ".....the effect that such programs produce including in digital and electronic products is crucial in determining the test of patentability..."and also in Para 11 that

"...If the invention demonstrates a „technical effect“ or a „technical contribution“ it is patentable even though it may be based on a computer program.”.

Said Para 11 also states that

"...Across the world, patent offices have tested patent applications in this field of innovation, on the fulcrum of `technical effect“ and „technical contribution“....”

18. In para 48 of order dated 7<sup>th</sup> February, 2020, Respondent maintained that first hierarchical multi- level menu-structure of **D1**, which is stored in local station is similar to the locally stored “preliminary selection steps” of the instant application. However, Respondent failed to appreciate that “hierarchical navigation” is a well - known navigation algorithm and can be implemented in a variety of ways.

In fact **D1** admits at least via [Column 1, Lines 30-33] that “It is known to retrieve an information item from a plurality of information items through a hierarchical menu-structure in an information processing system.”

Importantly, present invention utilizes “*hierarchical navigation*” to narrow down a request to make it well directed and construed to access a specific resource in a single attempt/iteration.

**D1** uses “*hierarchical navigation*” to navigate through data items both in local station and central station.

In Para 49 of impugned order dated 7<sup>th</sup> February, 2020 the respondent maintained that (a) “...feature of “*final request to internet*” of instant application can't be said to

*involve any technical difference vis-a-vis D1, as it allows user to access the second menu-structure which resides on a central station...”*

19. It is mentioned by the counsel that the respondent erred in his finding as illustrated in Para 0078 above as in **D1** user continuously hops from location station to a central server (utilizing internet at each such hop), the exact disadvantage the present invention is avoiding (of going to internet multiple times (for each such switch) and again checking whether found item on second menu structure is already present on first menu structure or not).

20. We have heard, Mr. PravinAnand and Ms. ArchanaShanker on behalf of appellant. No one appeared on behalf of respondents who even failed to file the counter statement and written submission. Let us now deal with the case of the appellant on merit.

21. **The relevant dates related to the patent application–**

Title of the invention: *Method and Device for Accessing Information Sources and Services on the Web”*.

- a. Indian national phase application IN/PCT/2002/00705/DEL date- **17.07.2002**
- b. International PCT application PCT/FR2000/003759 date - **29.12.2000**
- c. Priority date of Indian patent application – **30.12.1999**
- d. Term of the patent application due for expiry on – **29.12.2020**

22. **Background of the Invention –**

In simple language the invention is as follows -

- a. The invention dates back to 1999, when the internet technology was still in the nascent stage of its development.

- b. The goal of the present invention is to provide, easy, quick and direct access to required sources and services on the internet (web) without wasting precious network resources, such as bandwidth.
- c. On the internet, a web search engine allows a user to carry out a search for any particular information, so desired by the user.
- d. The search results are generally presented in a list of results, often referred to as search engine results pages (SERPs) and such results comprise a mix of links to web pages, images, videos, infographics, articles, research papers, and other types of files. The user is expected to select the desired result from the list so provided.
- e. Unlike web directories, which are maintained only by human editors, search engines also maintain real-time information because they can access real time content available on the internet. Thus a typical web search engine will access the internet and provide the user, on request, with results which were not previously available with user in near real time.

23. As per appellant the present invention is that :-

- a. As stated above, prior to the present invention, whenever a user wished to conduct a search over the internet, in response a high number of hyperlinks were returned and user had to make a choice again.
- b. To overcome at least the said disadvantage(s), the present invention proposes to first extract clear and concise details of the information which the user is looking for, in a localized manner [i.e. on the user's computer], before passing a well construed query to internet.
- c. It is important to note that the access was only in relation to the address on the website and not to the data unlike the prior art document. To

d. The steps taken to extract the information on the user's computer are called "preliminary selection steps", which are implemented locally on the user's computer itself, in order to avoid access to the web, unless necessary information for a well formed query is obtained from user.

e. Through the preliminary selection steps of the present invention, the query of the user is refined and narrowed down at each step so that the user is interactively made to target a particular and well-defined information and a website address is particularly generated locally (without using the internet bandwidth). Thereby, the user is taken directly to the said website, limiting the use of the bandwidth resource only once per search.

24. As in the present invention, the web site address is generated locally and passed on to a network for retrieving the required information /data and consuming the internet bandwidth only once, no bandwidth is assigned unless the user has provided sufficient information to take such user to the particular website address, therefore avoiding the unnecessary wastage of bandwidth.

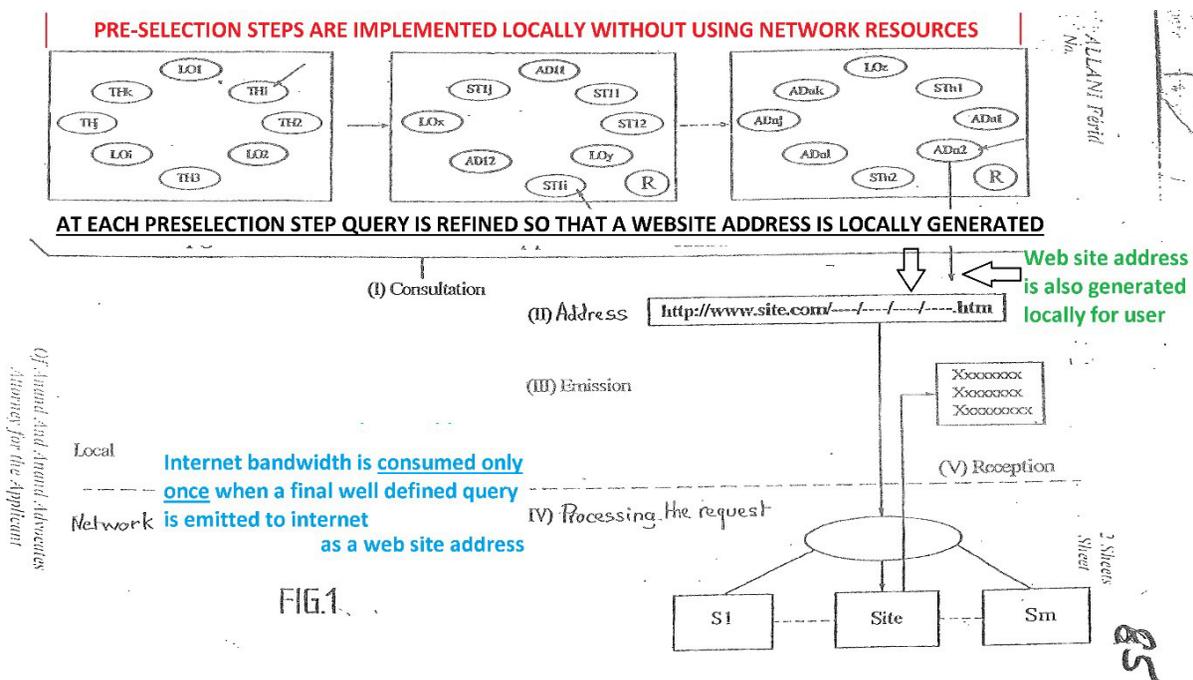


FIGURE 1 OF THE PRESENT INVENTION

Thus, essentially, the present invention delays emitting of a “final” request to the internet by locally implementing preliminary selection steps and using the said locally implemented selection to form a well-construed query (a locally formed website address) which is finally emitted to the Internet, thereby gaining the technical effects as detailed in the next section.

25. It is submitted on behalf of appellant that all Technical effect of the present invention which solves the aforesaid limitations

- a. The invention provides a forward looking solution in the form of an ‘Efficient Search Strategy’ to overcome the problems encountered in the traditional search engines which existed in 1999.
- b. The technical solution provided by the present invention is to retrieve the detailed information about the result which the user is looking for, and thereafter taking the user directly to the desired internet resource (utilising the said detailed information) e.g. a website, rather than providing a list of results for user to choose from, therefore making it inconvenient for the user. As the user has accurately specified the resource required, the bandwidth so consumed is guaranteed to assure a successful result to the user.
- c. Thus, the present invention delays emitting of a final request to the internet by locally implementing preliminary selection steps to form a well construed query, which is finally emitted to the internet.
- d. The present invention drastically reduces the mean time duration for accessing the searched information, because the user does not spend time in selecting and reviewing multiple search results as returned by the other prevalent technologies in 1999. Therefore, the user gets the desired results without compromising on the relevancy and quality of results.

- e. The present invention avoids the use of unnecessary bandwidth (for emitting a request on the internet) as the same is utilized only once per request, thereby saving the network resources. i.e. till the user has not provided sufficient details in the search request, no request is emitted to the internet and bandwidth is not consumed.
- f. The present invention is also economical, as the internet bandwidth is consumed only once per search. Since, the present invention drastically reduces the use of bandwidth per user, it is likely to result in a decrease in network congestion, resulting in increased quality of internet service to the user.

26. As per the case of appellant that the Novelty of the present invention resides:-

- a. It is stated that the present invention, apart from providing a critical technical effect, is also novel and unique.
- b. The Respondent relies upon EP 0847019 (hereinafter referred to as “D1”) as the prior art with respect to the present invention.
- c. Examples to simplify the understanding of D1 vis-à-vis the present invention –

**D1** - A user is selecting an information item, for eg. an image of the Eiffel Tower, which is available on the Local Station (User computer) in a JPEG format. Now, the image of the Eiffel Tower may also be available in a different format (such as GIF Format) on the Central Station. Thus clearly, the image of the Eiffel Tower is already available to the user, but the User is allowed to make a selection in order to choose either of the image stored in either JPEG format in the Local Station or the GIF format in the Central Station.

27. It is submitted that the present invention - Assuming the user wishes to search for the address and the contact details of the supporters of the Chelsea Football Club, with the intention of acquiring a shirt with the colours of the club and possibly

booking slots for the next championship final. To implement this search, in line with the present invention, the following steps would be executed, without the use of the internet

a) The user will select the theme 'TH1' on Page 'P0' leading to the display of sub-theme 'TH1i' as "COLLECTIVE SPORTS".



b)The user will then select the sub-theme as TH1i, as "COLLECTIVE SPORTS".



c)The user reaches the Page 'Pn-m', dedicated to "FOOTBALL CHAMPIONSHIP".



d)Among the various options available to the user on Page 'Pn-m', the user selects ADn2, i.e. "CLUB OF SUPPORTERS", as the user is looking for a shirt with the colours of the club and possibly booking slots for the next championship final.



e) As the selected icon is of type 'AD', i.e. direct access icon, it means that the present invention has gathered sufficient information from the user, and accordingly a complete address of the 'Welcome' page of the target website is generated.



f)Thus, the user is taken directly to the requisite website, as he has already provided sufficient details for the information which he is looking for. Neither the user is provided with a list of results to choose from, nor there is a chance that the bandwidth used in emitting well-formed queries or request would be wasted, as long as the target website is in working condition.

The above examples, as cited in the respective specifications of both the inventions, make it abundantly clear that the objective, process involved and the effect of both the inventions are entirely different.

28. It is rightly alleged that the Respondent has incorrectly identified D1 as the relevant prior art with respect to the present invention as both these inventions have different objectives and they therefore provide different solutions.

The following table elucidates the key differences between the present invention and D1.

<b>S. No.</b>	<b>Features</b>	<b>EP0847019 (D1 cited by the Respondent)</b>	<b>Present Invention</b>
1	<b>Goal / Technical Problem being addressed</b>	The object of D1 is to allow a user to move from menu structure of Local Station to the menu structure of the Central station in a seamless manner by keeping the menu structure of the Central Station highly similar with the menu structure of the Local Station.	Prior to this invention, a request for making a search was merely a generalized one which resulted in generation of multiple request-answer step(s) and such a delay corresponded to each request-answer step, which is emitted on the Internet.
		D1 does not allow a user to	The invention allows a

		<p>access a remote resource / information (not already available with the user), but it merely allows for selection of data items available to the user on the Local Station having static data or as a “more recent” data on the Central Station.</p>	<p>user to access a remote resource / information, not currently available to the user by any means, but available on the web.</p>
2	<p><b>Technical Solution</b></p>	<p>To provide users with an <u>updated recent version</u> of the locally stored information (from Local Station or Central Station) by providing a hierarchical menu structure on a Central Station which is highly similar in “structure” of the Local Station.</p>	<p>The present invention proposes to first extract clear and concise details of the information which the user is looking for, in a localized manner [i.e. on the user’s computer], using “Preliminary Selection Steps”, before passing a well construed query to the internet.</p>
		<p>The fundamental difference between D1 and present invention is that D1 is related to method of selection from two options, one option available to user as a</p>	

		<p>static data on local station while second option available as a more recent data to a user.</p> <p>Conversely present invention is directed to a method (and device) for accessing information resources not available to user on its local device, be it as a static data and certainly not as an updated recent data. In fact in present invention no data is stored on user's device but is accessed from web as a final step and only when sufficient information is gathered from user.</p>	
		<p>The local menu structure of D1 has a connection button that allows a user to move to a second menu structure on a Central Station, having a similar hierarchical structure.</p>	<p>In the present invention, selection of a direct access icon results in generation of a website address locally on a user's computer machine, which is emitted to the internet.</p>
3	<p><b>Area of application</b></p>	<p>D1 can only be used for implementing product catalogues, service brochures etc. because D1 inherently stores data itself on Local Station as well as Central Station, and only a</p>	<p>Since there is no storing of data on the user's computer machine, but only webpages are saved for seeking details of the information the</p>

		limited amount of data can be stored.	user is looking for through the 'Preliminary Selection Steps', the present invention can be used for searching virtually unlimited information across a variety of field, available on the web.
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29. The said findings are interpretations are not with the spirit of the order passed by the High Court. From the entire gamut of the matter, it appears to us that in view of previous invention, technical problem which the invention solves in the present application is that the present invention was a critical addition to the functionality of the internet in 1999, as the state of the art at the time, faced the following limitations -

- a. Before the disclosure of the present invention, whenever a request was sent for accessing a particular information resource by a client / user, in response a high number of hyperlinks were returned and the client / user had to make a choice again, thereby making a constant to and fro. Repeated access was required to the internet and the connection to the internet had to be made multiple times, in order to derive the accurate result of the user's query.
- b. The technical problem which existed in the art prior to the present invention was that a typical user was made to use precious bandwidth even before the desired result was provided to the user.

- c. Prior to this invention, a request for making a search was merely a generalized one which resulted in generation of multiple request-answer step(s) and such a delay corresponded for each such request for the information resource.
- d. Such a delay corresponded to each request-answer step, which is emitted on the Internet. The existing art prior to the priority date of the invention, would immediately assign network resources in delivering a number of results to the user, even before the user could indicate whether the list of results so received are useful to it or not.
- e. Allocation of network resources such as bandwidth, even before the user receives the desired results, resulting in jamming of network traffic, servers, and increase in the memory size of pages etc., and a corresponding delay in the search process, thereby making the search process long, tedious and uncertain. The said disadvantages increase manifold when multiple users would make use of the search process, as described above in points (a) to (d).
- f. The search and navigation methodology being used in the art prior to the present invention was difficult to understand and non-intuitive, which created problems for users, who are unfamiliar with the system.

30. The Respondent has committed an error in holding that, while referring to the guidelines followed by Patent offices to grant patents in Computer Related Inventions, the Hon'ble High Court was referring to EU guidelines, instead of the Indian guidelines, without giving any explanation thereof.

31. The Respondent has incorrectly held that if there are any inconsistencies between the guidelines in the European Union ("EU") and the guidelines relating to Computer Related Inventions, 2013 ("CRI Guidelines, 2013"), as issued by the Office of the Controller General of Patents, Designs and Trademarks of India, the EU guidelines shall supersede. This error is apparent as the CRI Guidelines, 2013 provide cogent and

coherent guidance in terms of the indicators of “technical effect”, and no reasoning is provided by the Respondent, for not following the same.

32. In para 13, it is observed that *“Insofar as Computer Related Inventions are concerned, there are three sets of guidelines that have been published by the Patent Office..... 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.”*

In Para 14 of the Order dated 12.12.2019 it was held that *“Accordingly,..... 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.”*

33. Para 6 of the Impugned Order it was observed that – *“Now, having said that legal position in India similar to the EU, the Hon’ble High Court must have meant the patent offices of EU only, while referring to the settled practices of patent offices in the para 14. Thus, now traversing the course of evolution of exclusion provision, of computer program from patentability, in EU can bring clarity, despite any inconsistency within the Guidelines for Examination of Computer Related Inventions (CRIs) as pointed out by the Hon’ble High Court.”*

The Indian guidelines relating to Computer Related Inventions, 2013, as issued by the Office of the Controller General of Patents, Designs and Trademarks clearly stipulate the following examples to provide a ‘technical effect’ [Ref: Point 3.15 at Page 177 of the Written-Submissions dated 30.06.2020] –

- i. Higher speed
- ii. Reduced hard-disk access time
- iii. More economical use of memory
- iv. More efficient data base search strategy
- v. More effective data compression techniques
- vi. Improved user interface
- vii. Better control of robotic arm
- viii. Improved reception/transmission of a radio signal

As the present invention falls under at least the following indicators of technical effect i.e. Higher speed, more economical use of memory and a more efficient data base search strategy, the present invention is patentable.

34. Therefore, in light of the Hon'ble Delhi High Court's direction that the Guidelines for grant of patents relating to the Computer Related Inventions are to be considered, along with the settled judicial precedents for granting the patent, as well as the fact that the present invention provides atleast the aforesaid technical effects, the Patent ought to be granted in favour of the Appellant.

35. It appears to us that the respondent has incorrectly identified D1 as the relevant prior art with respect to the present invention as both these inventions have different objectives and they therefore provide different solutions. The Respondent erred in stating that the hierarchical multilevel menu-structure of D1, is similar to the locally stored "preliminary selection steps" of the present invention.

Para 48 of the Impugned Order was referred – *“But, from the disclosures of D1, it is clear that the first hierarchical multilevel menu-structure of D1, which is stored in local station is similar to the locally stored “preliminary selection steps” of the instant application*

The said reasoning of the Respondent is incorrect for the following reasons –

- i. Respondent failed to appreciate that ‘hierarchical navigation’ is a well-known navigation algorithm and can be implemented in a variety of ways.
- ii. Importantly, the present invention utilizes ‘hierarchical navigation’ to narrow down a user’s search query to make it well construed without the use of the internet, to access a specific resource in a single attempt/iteration on the internet (*Ref: Line 18 at Page 3 of the specification, at Page 232 of the written submissions dated 30.06.2020*), **whereas**, D1 uses “hierarchical navigation” to navigate through data items both in Local Station and Central Station.

36. The Respondent erred in stating that the feature of “final request to internet” of instant application can’t be said to involve any technical difference vis-à-vis D1, and therefore the present invention shares the same objective as D1. In reply to the same, it is submitted that in **D1** the user continuously hops from Location Station to a Central Server (utilizing internet bandwidth at each such hop), the exact disadvantage the present invention is avoiding (of going to internet multiple times (for each such switch) and again checking whether found item on second menu structure is already present on first menu structure or not). In fact, as compared to D1,

37. The present invention solves the aforesaid problem, thereby optimizing the **mean time duration** and **bandwidth usage** required in successfully accessing a remote resource. The Respondent has erred in stating that the argument regarding the technical effect provided by the present invention, can only be sustained if the ‘second menu structure’ as covered in D1, is considered an impediment. Further the Respondent has erred in stating that D1 is an advancement over the present invention

It is obvious that in **D1** the user continuously hops from Location Station to a Central Server (utilizing internet bandwidth at each such hop), the exact disadvantage the present invention is avoiding (of going to internet multiple times (for each such

switch) and again checking whether found item on second menu structure is already present on first menu structure or not. In fact, as compared to D1, the present invention solves the aforesaid problem, thereby optimizing the **mean time duration** and **bandwidth usage** required in successfully accessing a remote resource. D1 does not achieve the 'technical effect' of present invention, i.e. saving of the internet bandwidth as well as the reduced time duration in receiving the desired search results. Rather in contrast, D1 remains only a method of selection, fetching data from either a local station or updated data from a central station. In D1, the internet bandwidth is used again and again since the user continuously hops from Location Station to a Central Server, irrespective of the fact that whether ultimately the data item is retrieved or not.

It is apparent that the Respondent has incorrectly appreciated the specification of the present invention to say that (i) the term "extract clear and concise details of the information resource" in the specification is ambiguous and vague. Further the Respondent has erred in stating that (ii) the "preliminary selection steps" and icons of page P0 are contradictory.

38. Mr. Pravin Anand has given the working example of the present invention is present in the specification of the present invention. The example shows that, how clear and concise details of the information resource (which the user is looking for) are extracted by making the user to select a particular theme (e.g. SPORT), then subtheme and so on till necessary information for locally generating a web site address is obtained by way of such selections by the user.

The complete specification of the present invention clearly states that method of claimed invention starts when user selects a "**TH**" icon, i.e. the "Theme Icon". (*L01, L02, ..., L0i*) as referred to in the specification are not a part of novelty and inventive step of invention and are not utilized for the same. For Example, the Respondent, while holding that the icon 'Po' is contradictory to the 'preliminary selection steps', and also holding

that“...instant application recites “preliminary selection steps”, however it itself at first page P0 provides various icons (L01, L02,...., L0i) featuring merchant sites or portals i.e. a request to the internet..” has failed to appreciate that icons L01, L02... L0i [as referred to by Respondent] featuring logotypes, graphic or semi graphic marks, merchant sites or portals for entering major commercial brands, for example a chain of hotels and restaurants or a large scale distribution company, in fact refers to those cases wherein a user can be taken directly to a website and the user is not required to provide any further detail about the information that he/she is looking for and therefore a website address can be generated locally right at first page P0 . So there is no contradiction, as pointed by the Respondent.

39. No doubt the Respondent stated that structuring of the query is in the realm of computer programming, but the present invention delays emitting of a “Final” request to the internet (web) by locally implementing the “Preliminary Selection Steps”, gathering more information from user and using such gathered information via the said locally implemented selection to form a well construed query which is finally emitted to the internet. Therefore, the claimed invention is not limited to “structuring of query” as stated by the Respondent.

The Respondent has failed to appreciate and apply the direction of the Hon’ble Delhi High Court as contained in Paragraphs 10 and 11 of the Order dated 12.12.2019 passed in W.P. (C) 7/2014 & CM APPL. 40736/2019. The Hon’ble Court clearly stated that if the invention demonstrates a “technical effect” or a “technical contribution”, it is patentable even though it may be based on a computer program. Therefore, without appreciating the technical effect produced by the present invention, as elucidated above, the mere fact that a computer program is used for effectuating a part of the present invention, does not provide a bar to patentability. Thus, the invention **MUST** be examined as whole and the following factors are to be considered while deciding upon

the patentability of such inventions – i.e (i) technical effect achieved by it, and its (ii) technical contribution.

40. It is rightly stated by the learned counsel for the appellant that the Respondent has incorrectly relied upon the judgment in *Aerotel Ltd v. Telco Holdings Ltd. &Ors.* [2007]1All ER225 (“*Aerotel*”), to conclude it as the definitive statement on the law on patentability of Computer Related Inventions, in the United Kingdom.

In the impugned order considers several judgments on the aspect of patentability of Computer Related Inventions, it has incorrectly concluded that the judgment in *Aerotel* is the definitive judicial pronouncement on the said subject matter, in the United Kingdom.

The same is evident from the following –

- i. In paragraph 29 of the impugned order, the Respondent appreciates the four (4) steps approach / test, as laid down by *Aerotel*, to determine the patentability of Computer Related Inventions. The test is as follows –
  - a. properly construe the claim
  - b. identify the actual contribution;
  - c. ask whether it falls solely within the excluded subject matter;
  - d. check whether the actual or alleged contribution is actually technical in nature

The Respondent did not appreciate that *Aerotel* does not define the term “technical contribution( para 45 and 46). However, *Aerotel* specifies that, “*The second step - identify the contribution - is said to be more problematical.....*

*What has the inventor really added to*

*human knowledge perhaps best sums up the exercise.” As mentioned in*

*Paragraph 43 of Aerotel.*

ii. The judgment in *Aerotel* was not centred around the concept of “technical contribution”, was also subsequently pointed out in the case of *Symbian Ltd v. Comptroller-General of Patents*, (2009) R.P.C. 1. (“*Symbian*”).

41. While relying on *Symbian*, the Respondent also notes the judgment in *AstronClinica Ltd. v. Comptroller-General* [2008] R.P.C. 14, [49] (“*Astron*”), however it fails to rely upon the guidance provided by *Astron* on the aspect of “technical contribution”.

*Astron* clarifies that in the case of a computer related invention which produces a substantive technical contribution, the application of step (ii) will identify that contribution and the application of step (iii) will lead to the answer that it does not fall wholly within the excluded matter. Any computer related invention which passes step (iii) but does not involve a substantive technical contribution will fail step (iv). Therefore, following *Aerotel*, even *Astron* confirms that step 3 and step 4 are inter-related.

**42. Status of corresponding Foreign applications**

a. The Appellant has been awarded Patents for the present inventions in various foreign jurisdictions, as detailed in the table below.

<b>NAME OF THE COUNTRY</b>	<b>DATE OF APPLICATION</b>	<b>APPLICATION NO.</b>	<b>STATUS OF THE APPLICATION</b>	<b>DATE OF GRANT</b>
<b>AUSTRAL</b>	29 December	31 818/01	<b>Patent</b>	16

<b>IA</b>	2000		<b>granted</b> n°783 481	February 2006
<b>NEW ZEALAN D</b>	29 December 2000	00/03759	<b>Patent granted</b> n°520235	9 June 2005
<b>SOUTH AFRICA</b>	29 December 2000	20025712	<b>Patent granted</b> n° 2002/5712	25 February 2004
<b>EURASIA</b>	29 December 2000	20020726	<b>Patent granted</b> n° 004075	25 December 2003
<b>CANADA</b>	29 December 2000	PCT/FR/2000/ 003759	<b>Patent granted</b>	01 September r 2015
<b>FRANCE</b>	30 December 1999	2803929B 1	<b>Patent granted</b> n° FR9916704B1	17 September r 2004
<b>CHINA</b>	29 December 2000	00819111.5	<b>Patent granted</b>	22 November

			n° ZL00819111.5	2006
<b>HONG KONG</b>	29 December 2000	04100 729.4	<b>Patent granted</b> n° HK 1058083	15 June 2007
<b>SINGAPO RE</b>	29 December 2000	200203926-1	<b>Patent granted</b> n° 89975	31 October 2006
<b>U.S.A.</b>	29 December 2000	10/169 355	<b>Patent granted</b> n° US 8.271.877	18 September 2012
<b>JAPAN</b>	20 December 2000	2001-550631	<b>Patent granted</b> n°6150454	2 June 2017
<b>EUROPE</b>	29 December 2000	10003146.7	<b>Under Appeal</b>	-
<b>U.S.A</b>	9 September 2014	14/480701	<b>Application pending</b>	-

43. In the present case , more than nineteen and half years are passed in deciding the present application by raising objections right and left. The term of the patent in this country is twenty years. The said patent is expiring in December, 2020. The same is

not the object of amending the law. The purpose will be defeated if application of mind is missing. The present invention had a significant technical contribution to the state of the art and possesses a critical technical effect

44. In the present case the appellant has been able to show that the patent application is to be allowed. Thus the impugned order dated 7th February, 2020 in respect of application number IN/PCT/2002/705/DEL passed by Respondent is set-aside by allowing the appeal.

45. We allow the application of patent in hand on Indian Patent Application No. IN/PCT/2002/705/DEL in favour of the appellant.

46. No costs

-Sd/-

**(Dr. Onkar Nath Singh)**  
Technical Member (PVPAT)

-Sd/-

**(Justice Manmohan Singh)**  
Chairman

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