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

% *Judgment delivered on: 30.04.2026*

\+ **C.A.(COMM.IPD-PAT) 14/2022**

BLACKBERRY LIMITED .....Appellant

versus

CONTROLLER OF PATENTS AND DESIGNS .....Respondent

Advocates who appeared in this case

For the Appellant : Mr. Pravin Anand, Mr. Ashutosh Upadhyaya and Mr. Sandeep Bhola, Advocates.

For the Respondent : Mr. P.S. Singh, CGSC with MR. Rajneesh Kr. Sharma, Ms. Minakshi Singh, Mr. Ashutosh Bharti and Ms. Shivangi Sharma, Advocates.

CORAM:
HON'BLE MR. JUSTICE TEJAS KARIA

JUDGMENT

TEJAS KARIA, J

INTRODUCTION

1. This is an Appeal filed under Section 117A of the Patents Act, 1970 ("**Act**") seeking quashing and setting aside of orders dated 11.10.2019 ("**Impugned Order I**") and 05.03.2020 ("**Impugned Order II**") passed by the Assistant Controller of Patents and Designs ("**Respondent / Controller**") under Section 15 of the Act ("**Impugned Orders**") refusing

the Patent Application No. 1976/DEL/2008 filed on 20.08.2008 titled as "*COLOUR DIFFERENTIATING A PORTION OF A TEXT MESSAGE SHOWN IN A LISTING ON A HANDHELD COMMUNICATION DEVICE*" ("**Subject Application**").

FACTUAL MATRIX

2. The Subject Application claims priority from European Patent Application No. 07117003.9 filed on 21.09.2007 ("**EP Application**"). The Subject Application and the request for examination for the same was filed on 20.08.2008. The Subject Application was published under Section 11(A) of the Act on 17.04.2009.

3. The Subject Application was examined, and First Examination Report was issued on 10.09.2014 ("**FER**"). The substantial objection raised in the FER relates to the claims lacking novelty under Section 2(1)(j) of the Act in view of the document EP1767008 (A1) ("**D1**"). The documents US6671718B1 ("**D2**") and US2003/0084109A ("**D3**") were cited as relevant documents. The claims were also objected under Section 3(k) of the Act for falling within the scope of computer program.

4. In response to the objections raised in the FER, the Appellant's Agent submitted the response *via* their letter dated 01.05.2015, uploaded on the portal on the Patent Office on 05.05.2015 ("**Reply**"). Thereafter, a hearing notice dated 06.08.2019 ("**Hearing Notice I**") scheduling a hearing for 21.08.2019 ("**Hearing I**"). During the Hearing I, the Respondent raised an oral objection under Section 3(k) of the Act and directed the Agent for the Appellant to present submissions with respect to Section 3(k) of the Act. The post-Hearing I written submissions were filed by the Appellant on 04.09.2019 ("**Written Submissions I**").

5. Thereafter, the Respondent *via* the Impugned Order I, refused the Subject Application. On 11.11.2019, the Appellant filed a review application ("**Review Petition**") under Sections 77(1)(f) and 15 of the Act against the Impugned Order I. The Respondent issued a hearing notice dated 22.01.2020 ("**Hearing Notice II**") scheduling a hearing for 10.02.2020 ("**Hearing II**"). The post-Hearing II written submissions were filed by the Appellant on 25.02.2020 ("**Written Submissions II**").

6. The review application was dismissed *vide* the Impugned Order II. Hence, the Appellant has filed the present Appeal seeking to set aside the Impugned Orders and grant of the Patent under the Subject Application.

SUBMISSIONS ON BEHALF OF THE APPELLANT

7. The learned Counsel for the Appellant made the following submissions:

7.1. The Appellant is a corporation organized and existing under the laws of Ontario, Canada. The Appellant specializes in providing telecommunication solutions including, but not limited to, enterprise software and Internet of Things. The Appellant is well known as a former developer of the BlackBerry brand of smartphones and tablets and its products are used worldwide by various businesses, car makers, and government agencies.

7.2. The present invention relates to the field of handheld wireless communication devices. The handheld devices have a very small screen size compared to standard desktop where users can implement filters or otherwise easily distinguish recipients. The handheld devices require user interfaces created for limited screen size, through which users input and perform sophisticated

operations including sending messages. Considering the limited amount of information that can be displayed on handheld devices, the handled devices require UIs that allow users to easily and quickly distinguish intended recipients in an outgoing message and prevent re-sending of messages to correct recipients. The quick visual identification of any unintended recipients reduces the likelihood of sending inadvertent messages to unintended recipients and further saves the time and resources of the handheld communication device in re-sending the messages to the correct recipients.

7.3. Reliance was placed upon the decision in ***Ferid Allani v. Union of India & Ors.***, 2019 SCC Online Del 11867 held the following:

> "*10. It is rare to see a product which is not based on a computer program. ... Thus, the effect that such programs produce including in digital and electronic products is crucial in determining the test of patentability. Patent applications in these (computer) fields would have to be examined to see if they result in a 'technical contribution. ...*"

7.4. The essential ingredients for an invention to qualify the threshold of the inventive step under Section 2(1)(ja) of the Act, includes: (i) the invention involves a technical advancement as compared to existing knowledge or economic significance or both; and (ii) makes the invention non-obvious to the persons skilled in the art ("**PSITA**"). These are conjunctive requirements under Section 2(1)(ja) of the Act, which means that not only should there be a technical advancement in the invention but at the same time, it should not be obvious to the PSITA. Therefore, both the requirements are to be satisfied conjunctively. The Subject

Application fulfils both criteria, technical advancement and non-obviousness. Accordingly, the invention claimed in the Subject Application is inventive.

7.5. The Respondent has failed to understand the present invention. The Respondent's reasoning suffers from hindsight bias, and begins to rationalize how teachings in various prior arts could be combined to solve the problem which is being solved by the present invention.

7.6. D1 addresses a situation where when the user cannot easily distinguish between the messages received, there is a probability that the user will be unable to recognize an important message or accidentally delete the message. Therefore, D1 aims to display messages to the user in a proper order or format, so that the user can easily distinguish between them.

7.7. In D1, incoming messages are grouped with other received messages that are associated with the same message attribute. Specifically, the application software in D1 processes the message(s) to determine if a message attribute identifies the message as belonging to a category predefined by the user. The received messages are grouped with other received messages that are associated with the same message attribute.

7.8. On the contrary, the Subject Application enables a user to easily and quickly distinguish recipients in an outgoing draft message using a colour code based upon a message address characteristic such as the identity of the host's name associated with the message addresses of recipients. The claims of the Subject

Application which relate to identifying intended recipients for an outgoing draft message is different from D1. In the present invention, the sender of the message is enabled to determine whether the recipients of the message are those to whom the message should be sent.

7.9. D2 involves marking of a confirmation box in an alert received by the user so as to allow the user to modify the list or cancel the sending entirely or to alert the user in case of a potentially undeliverable message. D2 merely recites displaying all of the addresses in a dialogue with an alert colour such as red, to draw the attention of the user to the dialogue box itself. According to D2, a user enters a message and then presses send. The system then pre-displays recipients and the user accept or modifies the recipients Particularly, D2 in Column No. 3, describes a system in which a user receives an alert including a list of addresses divided according to their addressee status in Sections 'To', 'cc', and 'bee', etc., before each message is sent. A user of the system must then mark a confirmation box associated with each of the addresses in the list. As per D2, all recipient addresses must be individually reviewed and approved or disapproved by the user.

7.10. There is no suggestion or teaching in D2 of an automatic and immediate visual indication of recipient names, based on the host names, enabling the users to identify and distinguish the recipients even while writing the message. D1 and D2 do not parse the host name from the identification code and differentiate the recipients based thereon.

7.11. Contrary to D1 and D2, in the present invention in the Subject Application, message addresses are dynamically examined in a device to obtain the messages' address characteristics which includes the host name / domain name / organization. The respective names of intended recipients may be distinguished according to affiliation of particular users with each other and displayed in a manner colour differentiated by respective host name / domain name / organization. This provides an easy way to distinguish the intended recipients of a message especially given a user may not implement filters on the messages sent to and from the handheld communication device in the device's message application as they do on the desktop.

7.12. D1 and D2, thus, fail to defeat the inventive merit of the Subject Application. The decision is purely hindsight based on the claims and not on the cited references as none of the documents suggest the conclusion drawn by the Respondent. Therefore, the claims of the Subject Application involve an inventive step. While conducting an inquiry into obviousness, hindsight is impermissible and the legal conclusion must be reached on the basis of facts gleaned from the prior art and should not include knowledge gleaned from patent disclosure. Reliance was placed upon the decision in ***F. Hoffmann-La Roche Ltd. & Anr. v. Cipla Ltd.***, Neutral Citation: 2015:DHC:9674-DB while making the above submission.

7.13. The Appellant has secured grant in several corresponding applications in major countries such as USA and European Union

for substantially the same invention, i.e., EP2275980B1 and US8682394B2. The Respondent has, thus, erred in holding that the Subject Application lacks inventive step and ought to have allowed the Subject Application to grant the patent in accordance with the provisions of the Act and the Patent Rules, 2003.

7.14. The Respondent has erred in adjudicating that claims of the Subject Application are not patentable under Section 3(k) of the Act because the subject matter of the claims of the Subject Application relates to computer program *per se* or algorithm. The invention Subject Application is directed to addressing the technical problem.

7.15. The Manual of Patent Office Practice and Procedure ("**Manual**") at Paragraph No. 09.03.03.02 under the "*Determination of Inventive Step*" states that:

> "*1. For determination of inventive step, the prior art as a whole, revealed during the search process, is relied upon to assess if such prior art(s) disclose(s) the claimed invention.*
> *2. Invention as a whole shall be considered. In other words, it is not sufficient to draw the conclusion that a claimed invention is obvious merely because individual parts of the claims taken separately are known or might be found to be obvious.*
>
> *** *** ***
>
> *4. For the purpose of establishing obviousness of the invention to a person skilled in the art, mosaicing multiple documents of prior arts is permissible, if the cited prior art provides lead to the skilled person to combine the teachings thereunder, at the time of filing or priority date of patent application.*"

7.16. Reliance was placed upon the decision in ***Enercon (India) Limited v. Aloys Wobben***, Order No. 123/2013 in ORA/08/2009/PT/CH, wherein the Court held that the mere

existence in the prior arts, of each of the elements in the invention, will not *ipso facto* mean obviousness. There must be a coherent thread leading from the prior arts to the invention, the tracing of the thread must be an act which follows obviously. The relevant paragraph is reproduced hereunder:

> "*43. ... For after all most inventions are built with prior known puzzle-pieces. We must apply this reasoning to test if indeed it is obvious, or if it seems to us to be obvious to the person skilled in the art because of what we know now. If it is the latter, it is hindsight deduction and is not acceptable, but if it is the former, then the patent must go.*"

7.17. The improvement in user convenience and ergonomics give rise to technical effect. Article 52(2)(c) of The European Patent Convention is a provision that is *pari materia* to Section 3(k) of the Act. With respect to comparison to foreign jurisdictions, Indian approach mirrors global standards. Even under the U.S. Alice Test and European problem-solution framework, software inventions are patentable when they improve the functioning of a computer or a technological process. Reliance was placed upon the decision in ***Raytheon Company v. Controller General of Patents and Designs***, Neutral Citation: 2023:DHC:6673 and ***Halliburton Energy Services Inc's Patent Application***, [2011] EWHC 2508 (Pat) while making the above submission.

7.18. The present invention provides a technical advantage enabling a person to quickly and easily identify the intended recipients of the messages and to efficiently use the handheld device to respond to the message ensuring such that the message is going to the proper and intended recipients. The invention also reduces

the user – device interaction steps that would otherwise be required to go through each message address in an outgoing message. This advantageously helps to prevent a potentially sensitive message from being inadvertently sent outside the sender's domain or to an unintended recipient. The present invention, therefore, provides the technical effect relating to efficiently and quickly differentiating between recipients of the message before the message is sent in devices with limited screen size.

7.19. The Appellant had filed three cases before this Court in ***Blackberry Limited v. Assistant Controller of Patents and Designs***, Neutral Citation: 2025:DHC:3100; ***Blackberry Limited v. Assistant Controller of Patents and Designs***, Neutral Citation: 2024:DHC:6571; and ***Blackberry Limited v. Assistant Controller of Patents and Designs***, Neutral Citation: 2024:DHC:6572. This Court ruled in favour of the Appellant in ***Blackberry Limited v. Assistant Controller of Patents and Designs***, Neutral Citation: 2025:DHC:3100 and ***Blackberry Limited v. Assistant Controller of Patents and Designs***, Neutral Citation: 2024:DHC:6572.

7.20. The legal position is settled that inventions demonstrating technical effect or technical contribution are patentable. Section 3(k) of the Act excludes only computer programs *per se*, i.e., disembodied algorithms or policy frameworks without technical application. The test, as reaffirmed by this Court in ***Blackberry Limited v. Assistant Controller of Patents and Designs***, Neutral

Citation: 2025:DHC:3100 and ***Ferid Allani*** (*supra*), is whether the invention provides a technical solution to a technical problem. The present invention squarely satisfies this test.

7.21. The device-level integration of domain verification and *alias* display enhances reliability and security of handheld communication. This improvement is neither business-driven nor administrative but purely technical. It increases the device's operational autonomy, ensuring trust validation without human intervention.

7.22. Section 117A of the Act provides a statutory right to an applicant of patent application to file an appeal against the order of learned Controller under Section 15 of the Act.

7.23. It is settled law that if an invention exhibits a technical effect and a technical contribution, such inventions cannot be excluded under Section 3(k) of the Act. By focusing solely on the implementation of the invention using computer-executable instructions and algorithms on a general purpose computing device, the technical effect and technical solution of the claims must be considered for patentability. The inventive step does not lie in the business concept but rather lies in the technical process. Reliance was placed upon the following decisions while making the above submission:

a. ***Microsoft Technology v. The Assistant Controller of Patents and Designs***, Neutral Citation: 2023:DHC:3342

b. ***Blackberry Limited v. Assistant Controller of Patents and Designs***, Neutral Citation: 2024:DHC:6572

c. ***Comviva Technologies Limited v. Assistant Controller of Patents and Designs***, Neutral Citation: 2024:DHC:8990

7.24. Accordingly, the Appeal may be allowed and the Impugned Orders I and II are liable to be set aside.

SUBMISSIONS ON BEHALF OF THE RESPONDENT

8. The learned CGSC for the Respondent made the following submissions:

8.1. The subject matter of the Subject Application is obvious for a PSITA in view of D1 and D2 and does not constitute an invention.

8.2. The alleged feature "*differentiating between recipients and notifying the sender of the message before the message is sent*" itself is not of technical nature. The method proposed in the Subject Application may provide comfort and convenience in managing an address book but it is not technical in nature.

8.3. A technical problem is universal in nature and technicality does not varied person to person. For example, noise in a communication system. Here every person faces the same noise problem if using the same communication system. But an error in sending a message with respect to recipient cannot be considered a technical problem because it depends on the person sending the message. It is not guaranteed that the said error committed by a person shall also be committed by another person.

8.4. Moreover, the problem of choosing wrong recipients is not arising due to small size of screens but it is a human error which may occur with any screen size. This error also varies from

person to person. Choosing a correct recipient may be problematic to one person at the same time other person may not find any problem at all.

8.5. The Appellant's argument that Computer Related Invention ("**CRI**") guidelines issued in 2013 also cited an "*improved user interface*" as an example of a technical effect is not acceptable as CRI, 2013 has already been superseded by CRI, 2016 and CRI, 2017 and CRIs of 2016 and 2017 have no such example. Therefore, the present invention in the Subject Application lies in various software implemented non-technical processes like associating colour, accepting message address, examining message address, displaying message information etc. One of the major alleged inventive features of the Subject Application is colour coding with intended recipient; this feature is not a technical feature. This is just managing the address book to avoid errors; therefore, can be called a data management style.

8.6. Moreover, the limitations recited in the claims are all software limitations defining the procedure that should be followed through the execution of specific commands. It is, therefore, derived that the actual contribution of the present invention solely lies in computer program / algorithm as such. The only hardware which is disclosed is the wireless communication device, which is just a mobile terminal device, that executes program in a conventional or normal manner devoid from any interaction beyond the normal hardware-software interaction. Further, the problem being addressed relates to an administrative

/ business solution for data management. The subject matter is administrative and non-technical in nature pertaining to business needs / motives. Consequently, the subject matter of Claim Nos. 1 to 14 of the Subject Application relates to computer program *per se* or algorithm and falls within scope of Section 3(k) of the Act.

8.7. The grant of a patent, in general, in all global jurisdictions is subject to fulfilling the criteria of an invention being solidly backed on the planks of possession of 'novelty', 'non-obviousness attributes' and 'commercial viability'. The Act introduced in qualifying criteria for an invention the attribute of Section 2(j) and / or Section 2(j)(a).

8.8. The USA and European Union jurisdictions use concept of 'anticipation' as a tool to evaluate the 'novelty' plank while assessing the patentability. In the Act, though the 'Anticipation of Invention' is not specifically defined, yet Section 2(1)(l) defines a "new invention" as one which is not anticipated by prior art or prior publication in either India or abroad, and thus, represents homologous origin of the concept in so far as the test for novelty is concerned.

8.9. The Appellant had participated and attended the Hearing I and filed the Written Submissions I which were then assessed again by the Respondent, and based on the assessment the Respondent passed a reasoned and speaking order *vide* the Impugned Order I whereby the Subject Application was refused under Section 15 of the Act on the grounds that the Subject Application was unable to

meet out the objections of Sections 2(1)(j) and 3(k) of the Act whereby the Subject Application was assessed as being a "computer program *per se*" and / or a business method that is not allowable under the Act.

8.10. Additionally, thereafter the Review Petition preferred by the Appellant, was dismissed *vide* Impugned Order II by categorical finding of law recorded on the non-maintainability and invalidity of Impugned Orders I and II and on this ground alone the present Appeal filed by the Appellant suffers from legal infirmities and warrants no interference from this Court.

8.11. In view of the pre-dated prior art citations Dl to D3 and the evidence on record of the Subject Application being existent in public domain through more than 60 citations 'incorporated by reference' in Dl to D3 of the Subject Application was rightly refused for not being able to comply with the provisions / requirements of Section 2 (1)(j) of the Act.

8.12. In view of the EP Application being squarely related to either software or software applications or computer program *per se* or business methods, the Subject Application is directly hit by Section 3(k) of the Act and hence, the Respondent had rightly refused the same *vide* Impugned Orders I and II.

8.13. The Subject Application suffers from the infirmity of non-sufficient disclosure. The Subject Application is silent on the aspect of manner and quantity basis of colour differentiation deployed in the present invention's working. The Subject Application attempts to demonstrate an already known technical

effect of macro-scale (colour differentiation in desktop computers and laptops / tablets) on a mobile phone (micro-scale) which does not qualify as an invention under the Indian Patent Law.

8.14. The Subject Application does not qualify as an invention, since the said concept functions purely on the basis of a micro-processor that runs on a software and represents an algorithmic output that is not patentable under Section 3(k) of the Act, besides having been known was already existing in implementable and executable forms in desktop computer systems, palmtops, laptops, tablets etc., available in public domain on the determining priority date.

8.15. Reliance was placed upon the following decisions:

a. ***Vincent Panikurlangara v. Union of India & Others***, (1987) 2 SCC 165, wherein the Court held that the technical matters which arise for consideration in a matter of scientific / technical type cannot be effectively handled by a Court. Similarly, the question of policy which is involved in the matter is also one for the Union Government to decide. No final say in regard to such aspects come under the purview of the Court.

b. ***Dr. Shivarap Shantaram Wagle & Others v. Union of India & Others***, (1988) 2 SCC 115, wherein the Court relying upon decision in ***Vincent Panikurlangara*** (*supra*) held that a judicial proceeding of the nature initiated is not an appropriate one for determination of such matters and

reiterated the view taken in ***Vincent Panikurlangara*** (*supra*) that matters relating to highly specialized scientific and technical field not amenable to judicial intervention / judicial review.

c. ***Blackberry Limited v. Assistant Controller of Patents and Designs***, Neutral Citation: 2024:DHC:6571 wherein the Court held that the computer programs *per se* are not patentable in Indian context. An outcome of sequence of instructions dependent on an algorithmic mediated process cannot be deemed to be an invention as per Section 3(k) of the Act.

8.16. Accordingly, the Appeal is ought to be dismissed and the Impugned Orders are liable to be upheld.

ANALYSIS AND FINDINGS

THE INVENTION

9. The present invention is titled as "*COLOUR DIFFERENTIATING A PORTION OF A TEXT MESSAGE SHOWN IN A LISTING ON A HANDHELD COMMUNICATION DEVICE*". The present invention pertains to communication devices equipped with wireless communication capabilities, along with the networks in which such devices function and further addresses a colour-differentiating of e-mail messages based upon a characteristic common to other received messages. The "*Field*" of the present invention is reproduced hereunder:

> "*[0001] This disclosure, in a broad sense, is directed toward a handheld communication device that has wireless communication capabilities and the networks within which the wireless communication device operates. The present disclosure further*

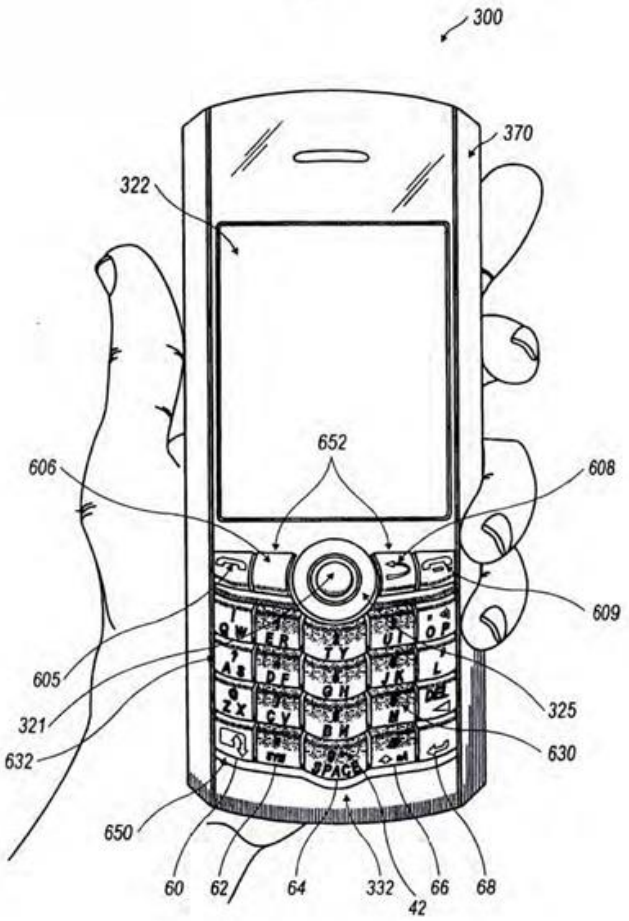
relates to color-differentiating an email message based upon a characteristic common to other received email messages."

10. While sending and receiving e-mails, many users put filters on their desktops to prioritize or to sort through their incoming and / or outgoing messages but users may not implement filters on the messages sent to and from the handheld communication device e-mail software. Therefore, the need for a convenient way to differentiate the intended recipient / sender of an e-mail message was needed. The relevant paragraph from the "*Background*" of the Complete Specification is reproduced hereunder:

"*With the proliferation of wireless communication systems, compatible handheld communication devices are becoming more prevalent, as well as advanced. Whereas in the past such handheld communication devices were typically limited to either voice transmission (cell phones) or text transmission (pagers and PDAs), today's consumer often demands a multifunctional device capable of performing both types of transmissions, including even sending and receiving e-mail. Furthermore, these higher-performance devices can also be capable of sending and receiving other types of data including that which allows the viewing and use of Internet websites. These higher level functionalities necessarily require greater user interaction with the devices through included user interfaces (Uls) which may have originally been designed to accommodate making and receiving telephone calls and sending messages over a related Short Messaging Service (SMS). As might be expected, suppliers of such mobile communication devices and the related service providers are anxious to meet these customer requirements, but the demands of these more advanced functionalities have in many circumstances rendered the traditional user interfaces unsatisfactory, a situation that has caused designers to have to improve the UIs through which users input information and control these sophisticated operations.*"

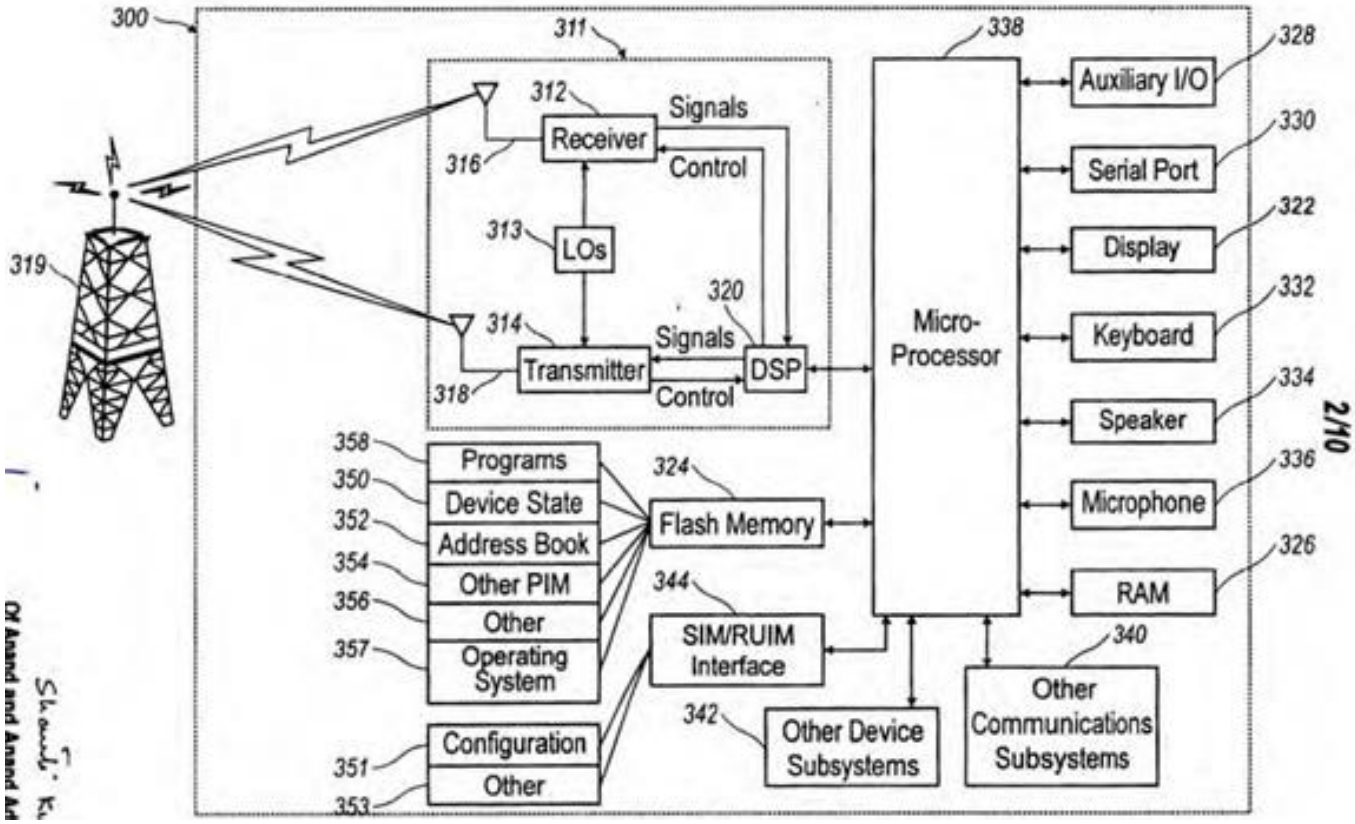
11. An example of handheld electronic device (300) is shown in Figure No. 1. As illustrated in Figure No. l, the handheld communication device (300) comprises a lit display (322) located above a keyboard (332) constituting a user input and suitable for accommodating textual input to the

handheld communication device (300). The front face (370) of the device has a navigation row (370) and a key field (650) that includes alpha-numeric keys (630), alphabetic keys (632), numeric keys (42), and other function keys as shown in Figure No. 1. Figure No. 1 is reproduced hereunder:



12. An example of the device's cooperation in a wireless network (319) is provided in Figure No. 2. The detailed description of the Complete Specification of the Subject Application states that these figures are exemplary and those PSITA will appreciate the additional elements / modifications which are necessary to make the device work. As shown in the block diagram of Figure No. 2, the device (300) includes a micro-processor

(338) that controls the operation of the device (300). Figure No. 2 is reproduced hereunder:

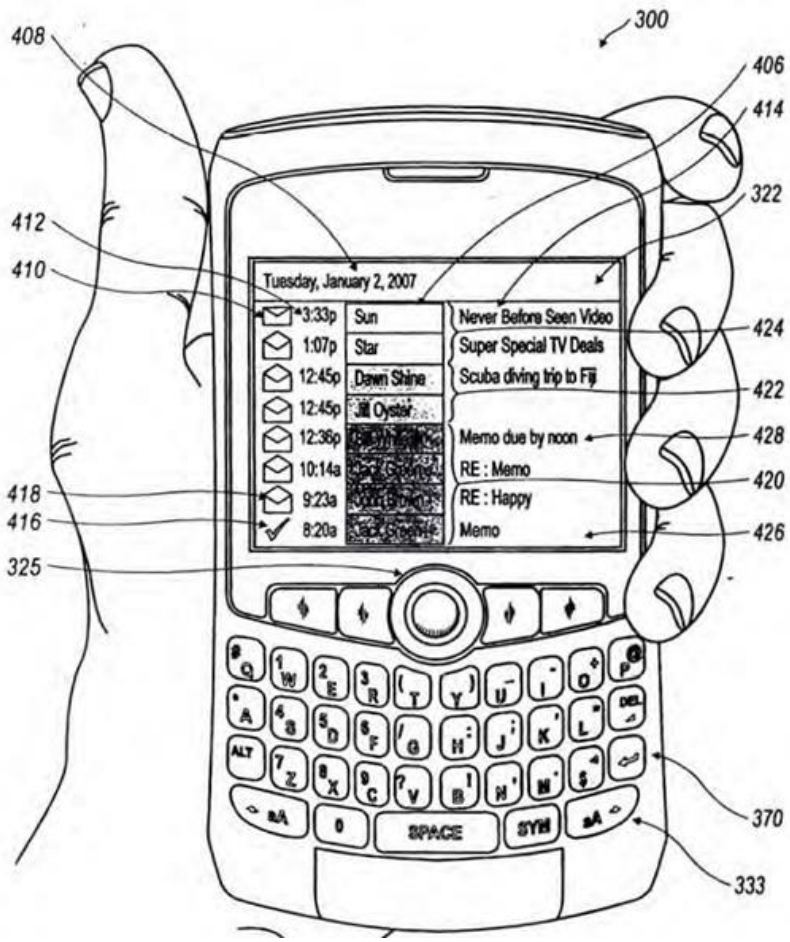


13. The Complete Specification of the Subject Application under Paragraph No. [0026] notes that keys, typically of a push-button / push-pad nature, perform well as data entry devices. However, it encounters the problem to the user when they must also be used to effect navigational control over a screen-cursor. To address this challenge, the present handheld electronic device includes an auxiliary input which acts as a cursor navigational tool and is also exteriorly located upon the front face (370) of the device (300) as shown in Figure No. 7. The front face location is specifically advantageous because it makes the tool easily thumb-acutable like the keyboard's key. As per the Complete Specification of the Subject

Application, a particularly usable embodiment provides the navigational tool as a trackball (321) which can easily be utilized to instruct two-dimensional screen cursor movement in substantially any direction, as well as act as an actuator when the trackball (321) is depressed like a button. The relevant paragraph of the Complete Specification of the Subject Application is reproduced hereunder:

> "*[0026] Keys, typically of a push-button or push-pad nature, perform well as data entry devices but present problems to the user when they must also be used to effect navigational control over a screen-cursor. In order to solve this problem the present handheld electronic device 300 preferably includes an auxiliary input that acts as a cursor navigational tool and which is also exteriorly located upon the front face 370 of the device 300. Its front face location is particularly advantageous because it makes the tool easily thumb-actuable like the keys of the keyboard. A particularly usable embodiment provides the navigational too in the form of a trackball 321 which is easily utilized to instruct two-dimensional screen cursor movement in substantially any direction, as well as act as an actuator when the trackball 321 is depressed like a button. The placement of the navigation tool is preferably above the keyboard 332j and below the display screen 322; here, it avoids interference during keyboarding and does not block the user's view of the display screen 322 during use. (See FIG. 1).*"

14. Figure No. 7 of the Complete Specification of the Subject Application is reproduced hereunder:



THE IMPUGNED ORDER II

Objection on the ground of lack of inventive step under Section 2(1)(j) of the Act

15. The Impugned Order II notes that the colour coding in Subject Application is done through an algorithm and the algorithm uses message address characteristic. In D1 also the algorithm uses message attributes for the purpose of categorization. The Impugned Order II further notes that the difference is in the designs of algorithms and therefore, in the outcome which the Subject Application is categorizing the message for approved and unapproved categories whereas D1 categorizes for urgent, family and

professional acquaintance categories. The relevant paragraphs of the Impugned Order II are reproduced hereunder:

> "*8. Conclusion regarding inventiveness U/S 2(1)(j):*
> *With regard to the cited documents, my observation is as follows:*
> *The method of D1 comprises applying an* ***identifying style to a message received by the mobile communication device in accordance with a message attribute associated with the message,*** *wherein t****he message attribute identifies a category to which the message belongs****. The message categories, as defined in para [0034] of Dl, are - Urgent, family and Professional acquaintance.*
>
> ***D2 describes a system in which a user receives an alert including a list of addresses before each email is sent.*** *A user of the system must then mark a confirmation box associated with each of the addresses in the list.* ***Obviously this marking is done to avoid the unintended recipients***
>
> *Now it can easily be decided that the underlying problem of instant application* ***and D2 is same that is of avoiding unintended recipients****; however both addressing this in different ways.*
> ***In instant case this problem is being addressed by color coding on the basis of message address characteristic.***
>
> *In written submission Applicant's attorney argued that "Further, Dl, in particular the paragraphs {0012}-{0017} cited in the notice, disclose the application of visual identifying styles to messages.* ***Paragraph [0038) of D1 specify that visual identifying styles are applied to one or more segments of received messages e.g. body, title etc.*** *It does not, however, teach disclose or even suggest the application of any visual identification styles to the recipients of messages which have been sent or are yet to be sent.*
> *Therefore, it is incorrect to suggest that the only difference between the teaching of D1 and the instant invention is the application of the categorizing feature in D1 is at the time of receipt of the message whereas in the instant invention it is at the time of sending the message.*
> ***Additionally, it is pertinent to note that subject matter upon which such color-coding categorizing feature is applied is name of the recipient before sending in the instant invention, as opposed to the message itself after receipt in D1.***

The above reasoning of attorney is for novelty of the instant subject matter .However, the Application was refused for being obvious for skilled person in view of D1-D2.

The color coding in instant application is being done through an algorithm. The algorithm uses message address characteristic. In D1 also algorithm using message attributes for categorising purpose. The difference is in the designs of algorithms and therefore in outcome that is the instant application categorising the message for approved and unapproved categories whereas D1 categorises for Urgent, family and Professional acquaintance categories.

However the difference in algorithms is superficial and obvious for skilled person once a skilled person view the problem of D2 with the solution proposed in D1.A skilled person can instantly decide that necessary changes can be made in the algorithm of D1 to create categories of approved and unapproved recipients using message attributes.

Therefore I am still of the opinion that the instant subject matter is obvious for skilled person in view of D1 and D2 and does not constitute an invention.

Emphasis supplied"

16. Further, the prior arts cited by the learned Controller to examine the analysis under objection of lack of inventive step under Section 2(1)(j) of the Act are discussed as under:

PRIOR ART D1

17. Dl is titled as "*MESSAGE RECOGNITION AND DISPLAY SYSTEM AND METHOD FOR A MOBILE COMMUNICATION DEVICE*". D1 pertains to a system designed to detect when an electronic message is being initiated for transmission. Before sending, the user receives a notification / warning indicating that the message is about to be sent. This alert presents a list of all intended recipients, incorporating any available *aliases* for easy identification. Thereafter, the sender can review and confirm the accuracy of

the recipient list, and can modify / remove / cancel the message entirely. Additionally, the system is also capable of alerting the user in case an unauthorized message is being sent by the computer and provides the user with the ability to delete such messages before they are transmitted. The "*Abstract*" of D1 is reproduced hereunder:

> "*A system that monitors for an initiation of the sending of an electronic message. The user is alerted or warned that the message is about to be sent. The alert includes a list of the addressees of the message. The list includes addressee aliases where available. The sender can then verify that the addressees are correct and change or delete those on the list, or erase the message. The system also provides such an alert when a computer initiates the sending of an unauthorized message and allows the user to delete the unauthorized message.*"

The relevant Paragraph Nos. [0011] to [0017] of D2 are reproduced hereunder:

> "*[0011] In an alternative embodiment, the display shows contents of Ille individual messages in various message-notification bands across the display. The bands visually differ based on intended recipients of the individual messages. The bands differ by color or graphic pattern for messages intended for different users.*
> *[0012] In the illustrative embodiment, a third mechanism senses when someone enters a room in which the system is installed and provides an enable signal in response thereto to the display. A fifth mechanism automatically activates the display based on the enable signal. The sensor includes a motion sensor and/or a light sensor.*
> *[0013] The novel design of the present invention is facilitated by the second mechanism, which enables users of the convergence device to quickly and efficiently determine if a message is waiting for them by viewing the display. The display includes message notifications for different users that are displayed in different colors or patterns, which are pre-assigned to the different users. Users may efficiently access the full message content by selecting the personalized message notification on the display via a keyboard, mouse, touch screen or other input device. Alternatively, users may*

watch as the message content scrolls across the message notification on the display.

BRIEF DESCRIPTION OF THE DRAWINGS

[0014] FIG. 1 is a block diagram of an efficient communications system employing a convergence device with an efficient message-notification display constructed in accordance with the teachings of the present invention.

[0015] FIG. 2 is a flow diagram of a method employed by the convergence device of FIG. 1 for conveniently simultaneously notifying individual users that one or more messages are waiting and displaying content of the pending messages.

DESCRIPTION OF THE INVENTION

[0016] While the present invention is described herein with reference to illustrative embodiments for particular applications, it should be understood that the invention is not limited thereto. Those having ordinary skill in the art and access to the teachings provided herein will recognize additional modifications, applications, and embodiments within the scope thereof and additional fields in which the present invention would be of significant utility.

[0017] FIG. 1 is a block diagram of an efficient communications system 10 that includes a convergence device 12 with an efficient message-notification display constructed in accordance with the teachings of the present invention. For clarity, various well-known components, such as computer operating systems, bard drives, power supplies, and so on, have been omitted from FIG. 1. However, those skilled in the art with access to the present teachings will know which components lo implement and how to implement them to meet the needs of a given application."

18. Claim No. 10 of D1 claims that the message characteristics /attributes of the Subject Application i.e., a host name, domain name. Claim No. 10 is reproduced hereunder:

"*10. The method of claim 9, wherein the message attribute comprises at least one of an identifier, a flag, an origination source, a source number, and a keyword.*"

19. The learned Counsel for the Respondent has relied on Paragraph No. 10 of D1 to submit that D1 lends credible critical weight to demonstrating the prior existence of the present invention.

PRIOR ART D2

20. D2 is titled as "*EMAIL CLIENT APPLICATION INCORPORATING AN ACTIVE TRANSMIT AUTHORIZATION REQUEST*" is a US patent granted on 30.12.2003. The claimed invention under D2 pertains to a system monitoring for an initiation of the sending of an electronic message. Under the said invention, the user is alerted that the message is about to be sent, wherein the said alert includes a list of the addressees of the message. The list includes addressee *aliases* where available. Thereafter, the sender can verify the correctness of addressees and change / delete those on the list / erase the message. The "*Abstract*" of D2 reproduced hereunder:

> "*A system that monitors for an initiation of the sending of an electronic message. The user is alerted or warned that the message is about to be sent. The alert includes a list of the addressees of the message. The list includes addressee aliases where available. The sender can then verify that the addressees are correct and change or delete those on the list, or erase the message. The system also provides such an alert when a computer initiates the sending of an unauthorized message and allows the user to delete the unauthorized message.*"

21. The learned Counsel for the Respondent relied upon the snapshot view of D2 lending credible critical weight to demonstrating the prior existence of the present invention in the Subject Application.

22. The similarity between D2 and the Subject Application is that both the inventions pertain to avoiding the wrong recipients.

PRIOR ART D3

23. D3 is titled as "*EFFICIENT MESSAGE NOTIFICATION SYSTEM AND METHOD FOR COMMUNICATION DEVICES*" granted on 01.05.2003.

24. D3 discloses a system for facilitating message notification for an electronic communication and communication device. The system under D3 includes a first mechanism which organizes, by an individual user, individual messages received by the electronic communications device and in response, provides a signal.

25. Further, the second mechanism allows the individual users to visually differentiate their received message based on the signal. The second mechanism, under a specific embodiment, includes a display for showing contents of the individual messages in various visually distinguishable formats corresponding to different individual users.

26. A further additional mechanism under D3 covers the individual messages into text messages and scrolls the text messages through the text which differs by colour / font for various individual users. Alternatively, the display also presents individual message contents within distinct notification bands, differentiated by colour / graphic pattern based on the intended recipient.

27. The learned Controller cited D3 in their Written Submissions filed in the present Appeal though D3 was not cited in the Impugned Orders. However, D3 was cited in Hearing Notice I along with D1 and D2 and not in Hearing Notice II.

28. In the Subject Application, the colour coding is being done through an algorithm, wherein the algorithm uses message address characteristic such

as a host name, domain name etc. in order to differentiate between recipients. In D1, the algorithm uses message characteristic attributes such as identifier, flag, origination source, and a keyword etc.

29. The subject matter is name of the recipient on which the colour coding categorizing feature is applied before sending in the Subject Application. Under D1, it applied to the message itself after receipt. In other words, the use of message characteristics in algorithms in order to create the categorizing features is similar in D1 and the present invention under the Subject Application.

30. D2, like the Subject Application, the invention pertains to avoiding the wrong recipients. D3, under a specific embodiment, includes a display for showing contents of the individual messages in various visually distinguishable formats corresponding to different individual users.

31. In the light of the disclosures in D1 and D2 along with the teaching of D3, which discloses the individual messages content in various visually distinguishable formats corresponding to different individual users, the present invention lacks inventive step. The disclosures in D1 to D3 renders the present invention obvious.

32. Therefore, the present invention under the Subject Application lacks inventive step.

Objection on the ground of non-patentability under Section 3(k) of the Act

33. The Impugned Order II notes that the problem indicated in the Subject Application is not related to the performance of existing hardware and the solution proposed in the present invention is not impacting performance of existing hardware as the algorithm is only related to colour coding on the basis of message characteristic and is unrelated to the performance of the

existing hardware. The Impugned Order II further states that the feature "*differentiating between recipients and notifying the sender of the message before the message is sent*" is not of technical nature.

34. Describing the "*Technical Problem*", the Impugned Order II states that a technical problem is universal in nature and technicality does not change person to person on the other hand, since the error in sending a message with respect to recipient depends on person sending the message, it cannot be considered a technical problem.

35. The Impugned Order II further notes that the said feature is just managing the address book in order to avoid the errors and therefore, can be called a data management style. Under the said objection, the learned Controller noted that the limitations recited in the claims of the Subject Application are all software limitations defining the procedure that should be followed through the execution of specific commands. Therefore, the learned Controller held that it is, therefore, derived that the actual contribution of the present invention solely lies in computer program / algorithm as such. The relevant paragraphs of the Impugned Order II are reproduced hereunder:

> "*The claimed subject-matter accordingly provides a method for differentiating between recipients of a message and notifying the sender of the message by color-coding a name of a recipient associated with the message address of the message, based on the identified message address characteristic.*
>
> *Applicant's attorney argued that "present method results in an improvement and has technical advancement which affects a change in the functionality/ performance of existing hardware and is capable of bringing technical effect having real-world application."*
>
> *This argument cannot be accepted as the problem indicated in instant* ***subject matter is not related to the performance of existing***

hardware and anyway the solution proposed is not impacting performance of existing hardware because the algorithm is only related to color coding on the basis of message characteristic and not related to the performance of the existing hardware. ***Hardware will execute this algorithm in the same way it executing other algorithms.***

*The alleged feature "**differentiating between recipients and notifying the sender of the message before the message is sent**" itself is not of technical nature.*

The method proposed in Instant application may provide comfort and convenience in managing address book but it is not technical in nature.

***A technical problem is universal in nature and technicality is not varied person to person**. For example noise in a communication system . Here every person faces the same noise problem if using the same communication system. **But error in sending a message with respect to recipient cannot be considered a technical problem because it depends on person sending the message.** It is not guaranteed that the said error committed by a person shall also be committed by another person.*

Therefore I am still of the opinion that the subject matter of the alleged invention lies in various software implemented non technical processes like associating color, accepting message address, examining message address, displaying message information etc. One of the major alleged inventive features of instant subject matter is color coding with intended recipient ;this features is not a technical feature .This is just managing the address book to avoid errors ;therefore can be called a data management style. ***Moreover, the limitations recited in the claims are all software limitations defining the procedure that should be followed through the execution of specific commands**. It is therefore derived that the actual contribution of the invention solely lies in computer program/algorithm as such. The only hardware which is disclosed is the wireless communication device; which is just a mobile terminal device; that executes program in a conventional or normal manner devoid from any interaction beyond the normal hardware-software interaction. **Further, the problem is being addressed relates to an administrative/business solution for data management**. The subject*

matter is administrative and non-technical in nature pertaining to business needs/motives. Therefore, the subject matter of claims 1-14 relates to "computer program per se" or "algorithm" and falls within scope of section 3(k) of The Patents Act, 1970 (as amended).

10. The oral argument and the written submission of the agent of the applicant have been carefully considered. However, without prejudice, although the hearing submissions have attempted to address the other requirements, yet the substantive requirements of the Patents Act, 1970 i.e. requirements of section 2(1)(j) and section 3(k) are not found complied with. Therefore, in view of the aforementioned reasons and unmet requirements, this instant application is not found in order for grant.

11. Therefore, keeping in view the above facts, the submissions of the agents during hearing and subsequently through the written submissions, as well as the outstanding official requirements, instant application no. 1976/DEL/2008 DATED 20/08/2008 does not comply with the requirements of The Patents Act, 1970 (as amended). I, therefore, hereby order that the grant of a patent for application no. 1976/DEL/2008 is REFUSED under the provisions of Section 15 of The Patents Act, 1970 (as amended).

Emphasis supplied"

36. Section 3(k) of the Act explicitly excludes "*a mathematical or business method or a computer program per se or algorithms*" from patentability in India. The Appellant claims that recipient colour coding, enterprise integration and push notifications rely on algorithmic rules as well as software-based methods of processing, transmitting information or displaying.

37. Section 3(k) of the Act is reproduced hereunder:

"*3. What are not inventions.—The following are not inventions within the meaning of this Act,—*

(k) a mathematical or business method or a computer programme per se or algorithms;"

38. Section 3(k) of the Act requires that any computer-implemented invention must demonstrate a clear "*technical effect*" or "*technical contribution*" which is beyond the abstract logic of a program. Such "*technical effect*" or "*technical contribution*" is absent in the subject matter of the present invention.

39. In ***Microsoft Technology Licensing LLC, One Microsoft Way v. Assistant Controller of Patents, Patent Office***, 2024 SCC OnLine Mad 2785, it is held that even when the invention in question relates to a CRI, if it results in a technical effect which improves the functioning of the system and efficacy (effect on hardware), or provides a technical solution to a technical problem discussed in the complete specification, the impact of the claimed invention is not limited to a particular application / data set, and therefore, it overcomes the exclusion. The relevant paragraphs of the ***Microsoft Technology Licensing LLC, One Microsoft Way*** (*supra*) are reproduced hereunder:

> "*36. Thus, even when the claimed invention relates to a CRI, if it results in a technical effect that improves the system's functioning and efficacy (effect on hardware), or provides a technical solution to a technical problem and is, therefore, not limited in its impact to a particular application or data set, it would surmount the exclusion under section 3(k) of the Patents Act.*
>
> ***Claimed invention and Section 3(k)***
>
> *37. As the independent claim recites, the claimed invention processes commands to multiple unrelated applications by associating the command surface to more than one component registered to receive commands from the command surface. The command lists are identified by the command surface by polling the components first and each command on the list is associated with the respective component. This enables the outflow of commands to unrelated applications from a single command surface removing the necessity of multiple command surfaces. This technical contribution makes the claimed invention efficacious over conventional systems*

which require the presence of multiple command surfaces on the web page for processing unrelated applications. Thus, the claimed commanding system is more than a set of instructions in code or any other language and is not limited in impact to a particular application or data set, i.e. it is application/data set agnostic. Put differently, it possesses a 'technical effect' that enhances the system's functionality by processing multiple unrelated applications using the same command surface. This eliminates the need for multiple command surfaces, reduces the use of memory space in the system and augments efficiency. As a result, it is patent-eligible under Section 3(k) of the Patents Act. The respondent also concluded that the claimed invention fails to address 'enablement'. This is not a relevant consideration under Section 3(k) of the Patents Act and, therefore, is not a valid ground for rejection under the said provision. Having concluded that the claimed invention is not excluded from patent eligibility, it remains to be considered if the claimed invention would be obvious to the PSITA."

40. The present invention pertains to address the problem of inefficiency of conventional systems to process more than one different unrelated applications simultaneously because each component includes its independent command surface in order to process the respective application.

41. The learned Counsel for the Appellant submitted that to solve the identified problem, the present invention provides a system and method in which the command surface is coupled to more than one component on a page, even when the components are associated with different applications that leads to directing the command to more than one application for processing. The learned Counsel for the Appellant further submitted that the system efficiency is increased when a large number of unrelated applications are processed by utilizing / sharing the same command surface.

42. The learned Controller held that the command lists are identified by the command surface by polling the components first and each command on the list is associated with the respective component and this results in the

enablement of the outflow of commands to unrelated applications from a single command surface thereby removing the necessity of multiple command surfaces.

43. The learned Controller further held that this technical contribution makes the present invention efficacious compared to the conventional systems which require the presence of multiple command surfaces on the web page to process unrelated applications.

44. The "*technical effect*" that enhances the system's functionality by processing multiple unrelated applications using the same command surface. As a result, the need for multiple command surfaces is eliminated, and the use of memory space in the system is reduced and thereby results in the improvement in the overall system efficiency.

45. Since the algorithm in the present invention claimed under the Subject Application is only related to colour coding on the basis of message characteristic and not enhancing the systems functionality, it does not possess a "*technical effect*" or "*technical contribution*". The present invention relates to CRI, but does not result in a "*technical effect*" that improves the systems functionality and efficacy at the hardware level. The "*technical effect*" that can be possibly considered is the improved reliability. However, reliability increase should be intrinsic to the computer that is an improvement in the machine itself, which is not the case here. Accordingly, in the present invention, there is no such "*technical effect*" enhancing the system's functionality.

46. The feature of the present invention of differentiating between recipients and notifying the sender of the message before the message is sent is not of technical nature, thereby fails to provide a technical solution. An

error in sending a message to a recipient cannot be considered a technical problem as it depends on the person sending the message. The problem that the present invention under the Subject Application solves is in itself not a technical problem.

47. Even after the present invention is implemented, the sender still may commit an error, if the recipients having the same name are more in number. For example, if the recipients having same name are five in number, the user shall have to remember the all five different colours corresponding to five different recipients. In this case, the sender still may commit the same error, if failed to remember the assigned colours. The Impugned Order II rightly states that a technical problem is universal in nature and technicality is not varied person to person and an error in sending a message with respect to the recipient cannot be considered a technical problem as it depends on the person sending the message.

48. Therefore, the present invention under the Subject Application is not patentable under Section 3(k) of the Act. Accordingly, there is no infirmity with the Impugned Orders and no interference is warranted in the present Appeal.

CONCLUSION

49. In view of the above analysis, the present Appeal is dismissed and the Impugned Orders are upheld. There shall be no order as to costs.

TEJAS KARIA, J

APRIL 30, 2026
'*KC*' / '*N*'