IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

IN ITS COMMERCIAL DIVISION

COMMERCIAL MISCELLANEOUS PETITION (L) NO. 15327 OF 2025

Navya Network Inc. ...Petitioner

Versus

Assistant Controller of Patents and Designs ...Respondent

Mr. Manish Aryan (through VC), a/w. Mr. Abhai Pandey, Ms. Manisha Singh, Mr. Nishant Rai, Ms. Khushi Chauhan, Ms. Shweta Nisar i/b. SONAL DOSHI & CO. for Petitioner.

Mr. Yashodeep Deshmukh a/w. Mr. Ashutosh Mishra, Ms. Vaidehi Pradeep, Ms. Rutwik Rao, Mr. Pratam Gawali for Respondent.

CORAM : ARIF S. DOCTOR, J.

RESERVED ON : 16th MARCH 2026

PRONOUNCED ON : 15th APRIL 2026

JUDGMENT

1. The present Petition has been filed under Section 117A of the Patents Act, 1970 ("**Patents Act**") challenging the Order dated 27th May 2024

("**Impugned Order**") passed by the Respondent, i.e., Assistant Controller of Patents & Designs, refusing the Petitioner's Patent Application No. 2068/MUMNP/2014 titled "*Medical Research Retrieval Engine*", a PCT national phase application claiming priority to US Application No. 13/428,539 dated 23rd March 2012.

2. The Application was refused on two grounds: (**i**) lack of inventive step under Section 2(1)(ja) of the Patents Act in view of the prior art documents D1-D3; and (**ii**) non-patentability under Section 3(k) on the ground that the claimed invention constitutes an *algorithm* and *computer program per se*.

Submissions on behalf of the Petitioner:

3. Mr. Aryan, the Learned Counsel appearing on behalf of the Petitioner, submitted that while the Respondent found that Claims 1-24 lacked inventive step in view of prior art documents D1-D3, the Impugned Order contained no reasoning whatsoever as to how the claimed invention was taught by a combination of D1-D3. He pointed out that the Respondent merely reproduced Claim 1 of the Application and baldly held that the

Petitioner's claim lacked inventive step without any reasoning or basis to support such a finding.

4. Mr. Aryan submitted that in assessing inventive step under Section 2(1)(ja) of the Patents Act, the Respondent had failed to follow the five-step test as laid down by the Delhi High Court in the case of ***F. Hoffmann La Roche Ltd. v. Cipla Ltd.***[1] viz.

> *120. From the decisions noted above to determine obviousness/lack of inventive steps the following inquiries are required to be conducted:*
>
> *Step No. 1: To identify an ordinary person skilled in the art,*
>
> *Step No. 2: To identify the inventive concept embodied in the patent,*
>
> *Step No. 3: To impute to a normal skilled but unimaginative ordinary person skilled in the art what was common general knowledge in the art at the priority date.*
>
> *Step No. 4: To identify the differences, if any, between the matter cited and the alleged invention and ascertain whether the differences are ordinary application of law or involve various different steps requiring multiple, theoretical and practical applications,*
>
> *Step No. 5: To decide whether those differences, viewed in the knowledge of alleged invention, constituted steps which would have been obvious to the ordinary person skilled in the art and rule out a hindsight approach."*

[1] 2015 SCC OnLine Del 13619.

He pointed out that the above was reaffirmed by the Division Bench of the Delhi High Court in ***Tapas Chatterjee v. Assistant Controller of Patents and Designs and Anr.***[2]. He submitted that the fact that the above steps were not followed by the Respondent, was apparent from a plain reading of the Impugned Order.

5. Mr. Aryan then placed reliance upon the decision of the Delhi High Court in the case of ***Auckland Uniservices Limited v. Assistant Controller of Patents and Designs***[3] to submit that an order refusing a patent application must be a reasoned and speaking order and must reflect due application of mind to the applicant's submissions and the statutory requirements under the Patents Act. He submitted that a mere reiteration of objections or a cryptic conclusion, without addressing the Applicant's arguments on patentability, which would include novelty and inventive step, would be in violation of the principles of natural justice and would thereby render the order susceptible to challenge.

[2] 2025 SCCOnLine Del 6369.
[3] 2022 SCC OnLine Del 5165.

6. Mr. Aryan pointed out that the reasoning given by the Respondent in the Impugned Order for refusing Claims 1-24 under Section 3(k) was entirely different from the objection communicated in the hearing notice dated 5th March 2024. He pointed out that the hearing notice only flagged that Claims 1-24 did not define any structural/hardware features and defined computer programs, whereas the Impugned Order, for the first time, introduced the reasoning that the claimed invention provided a “self-learned ontology", which was non-technical and merely a computer algorithm. He submitted that these new grounds were never communicated to the Petitioner, thereby depriving the Petitioner of an opportunity to address them. He thus submitted that the Impugned Order would have to be set aside and the matter remanded for de novo consideration.

7. Mr. Aryan then submitted that despite having amended Claims 1-24 to incorporate hardware features and having filed written submissions in response to the hearing notice, the Respondent had completely changed its objection under Section 3(k) of the Patents Act in the Impugned Order by

taking new grounds that were never previously communicated to the Petitioner. He submitted that this, therefore clearly constituted a breach of the principles of natural justice.

8. Mr. Aryan then pointed out that the Respondent had, in the Impugned Order, *inter alia*, held as follows, viz.

> "*The concept of ontology learning is well known in the art, and it is not clear what technical effect and purpose the learning of ontology serves*" and "*All the features presented in the instant application are widely recognised in the field and do not represent any notable technical advancements and technical effect.*"

He submitted that the above findings were, in substance, considerations germane to inventive step analysis under Section 2(1)(ja) of the Patents Act and not as to the aspect of non-patentability under Section 3(k) of the Patents Act. He pointed out that the Respondent had thereby conflated two distinct enquiries and that the question of whether something was "well-known" must be assessed in view of the cited prior art and not determined arbitrarily.

9. He further submitted that an order must be reasoned in its entirety and that a finding on one ground could not be a substitute for the absence of reasoning on another. Furthermore, he placed reliance upon the CRI Guidelines, 2025, to point out that the foremost criterion for examination of a patent application was novelty and that an assessment of patentability under Section 3 must not be made without first addressing 'novelty' and 'inventive step'.

10. Mr. Aryan then submitted that on the merits of the Section 3(k) objection of the Patents Act, the claimed invention was patentable subject matter when assessed as a whole, since Claim 1, which was an independent claim, disclosed a method of retrieving relevant documents having medical research evidence, implemented by an apparatus, and comprised the following steps:

    a. Receiving a request to access a plurality of documents in a database stored in at least one memory device, each document containing medical research evidence and having an associated pre-defined

relational expression that defines a link between fields in a pre-existing medical ontological hierarchy derived deductively from a plurality of medical literature and separately mapped onto each document;

b. Causing display of a user interface with a plurality of fields of the pre-existing ontological hierarchy, certain fields having selectable, prescribed terms;

c. Generating a received relational expression based on information received from the user interface, including at least one selectable prescribed term;

d. Comparing the received relational expression with the pre-defined relational expressions associated with at least one of the plurality of documents; and

e. Causing display of information relating to a set of documents as a function of that comparison.

11. He further submitted that the invention solved a technical problem, namely the inefficiency of conventional medical literature databases that index documents based on known standardised medical ontologies and keyword searches. He pointed out that such conventional systems either returned large volumes of irrelevant documents or omitted relevant articles that did not contain the search keyword. He thus submitted that the technical problem was the inefficient functioning of the database system as a whole in returning the relevant documents.

12. Mr. Aryan then submitted that with regard to the technical solution, the invention solved the above problem by means of a hardware controller that created a unique “relational expression” for each document being added to the database by deductively deriving an ontology from medical literature and mapping it back to individual papers through a 'Boolean' or other operators. Mr. Aryan pointed out that when a user query was submitted, a hardware component generated a received relational expression from the user interface, and a comparator, i.e., a distinct hardware component,

compared it against the predefined relational expressions of stored documents, thereby displaying the most relevant results. He reiterated that this process enabled more effective and efficient indexing and search.

13. Mr Aryan, then, on the aspect of the technical effect, submitted that the use of predefined relational expressions mapped onto each document reduced the computational load required to identify relevant evidence, thereby improving database querying efficiency and minimising the volume of data a user must manually filter. He pointed out that the comparing step was a technical comparison of structured relational expressions, not a simple string match, yielding a concrete technical result in the form of a specific set of documents, and this constituted a tangible technical benefit in the field of healthcare technology.

14. Mr. Aryan further submitted that the CRI Guidelines, 2025, expressly acknowledged that "*technical implementation of efficient searching, indexing, or retrieving data from databases that improve overall system performance*" does not constitute the excluded subject matter under Section

3(k) of the Patents Act, and hence the same was patentable. He then also placed reliance upon Examples 1 and 4 of the CRI Guidelines, 2025, and submitted that these Guidelines also state that allowability under Section 3(k) of the Patents Act does not necessitate the presence of novel hardware.

15. Mr. Aryan then placed reliance upon the decision in the case of ***Microsoft Technology Licensing, LLC v. Assistant Controller of Patents and Designs***[4], to point out that a mere conclusion that claims were implemented on a computer or comprise computer-executable instructions performed on a general-purpose computing device was not a correct basis for refusing a patent application.

16. Mr. Aryan pointed out that the Petitioners' corresponding US patent application had been granted with claims of the exact same scope as those which had been refused in India, notwithstanding the fact that the US Patent Code under 35 U.S.C. §101 similarly excluded inventions directed to

[4] 2023 SCC OnLine Del 2772.

abstract ideas. He reiterated that the grant of Patent in the US jurisdiction was indicative of the patentable nature of the claimed invention

17. In light of the above facts and submissions, he submitted that the Petitioner's valuable rights in pursuing a patent application over a breakthrough invention for retrieving medical evidence documents from a database should not be denied, and therefore, the Impugned Order should be set aside, and the matter may be remanded back for de novo consideration.

Submissions on behalf of the Respondent:

18. *Per contra* Mr. Deshmukh, learned counsel appearing on behalf of the Respondent, submitted that the Petitioner had filed a PCT National Phase Application No. 2068/MUMNP/2014 on 16th October 2014, and after examination under Sections 12 and 13 of the Patents Act, a First Examination Report was issued on 4th March 2020, to which the Petitioner had filed a reply. A hearing notice was thereafter issued on 5th March 2024, pursuant to which the Petitioner appeared at the hearing held on 1st April

2024 and thereafter filed written submissions and other documents. He, however, pointed out that the application was refused on the grounds of lack of inventive step under Section 2(1)(ja) in view of prior art D1, D2, and D3 and non-patentability under Section 3(k) of the Patents Act. He then, in support of the contention that the Petitioners' Application had rightly been rejected, made the following submissions.

I. Barred Subject matter under Section 3 of the Act

19. Mr. Deshmukh submitted that the impugned invention fell squarely within the ambit of Section 3(k) of the Patents Act as being "*a mathematical or business method or a computer program per se or algorithms*". He further submitted that this ground alone was sufficient to justify the refusal of the application and did not warrant a further assessment of novelty or obviousness. In support of this contention, Mr. Deshmukh placed reliance upon the decision of the Delhi High Court in ***Ferid Aliani v. Union of India,***[5] in which the Delhi High Court applying the judicial test to ascertain

[5] 2019 SCC OnLine Del 11867.

if an invention attracts Section 3(k), held that a computer-related invention demonstrating a 'technical effect' or a 'technical contribution' is patentable even though it may be based on a computer program.

20. Mr. Deshmukh, however, submitted that in the facts of the present case, the impugned invention did not demonstrate any such technical effect or technical contribution, as was evident from the complete specification, since the claimed invention was purely algorithmic in nature, operating on generic computer hardware without improving the internal functioning of a computer or database, and the sole purported "technical effect" was the generation of a "unique logical expression", which did not go beyond the output of any ordinary algorithmic process. He then pointed out that in ***Microsoft Technology Licensing v. Controller of Patents,***[6] the Delhi High Court had laid down the conditions necessary for computer-related inventions to circumvent the limitations imposed by Section 3(k) as follows:

[6] 2024 SCC OnLine Del 3239.

33. ***Technical effect of the subject patent application***

> *In light of the above discussion, it is clearly established that in case of an invention involving computer programmes, to circumvent the limitations imposed by Section (k) of the Act, a patentee must demonstrate that the overall method and system disclosed in the patent application, upon implementation in a general-purpose computer, must contribute directly to a specific and credible technical effect or enhancement beyond mere general computing processes. Therefore, the inventive contribution of a patent should not only improve the functionality of the system but also achieve an innovative technical advantage that is clearly defined and distinct from ordinary operations expected of such systems.*

21. Mr. Deshmukh also pointed out that the Delhi High Court in ***Blackberry Ltd v. Controller Patents & Design***[7] had *inter alia* held that where an invention incorporated an algorithm but related purely to a set of instructions regulating information flow through conditional logic without any substantial change in hardware, the invention in question was not entitled to patent protection. He submitted that a technical contribution arising primarily from an algorithmic process on generic hardware was insufficient

[7] 2024 SCC OnLine Del 6027.

for the grant of a patent. He pointed out that the Delhi High Court had rejected the Patent Application in the said case while upholding the following findings of the Controller pertaining to Section 3(k), viz.

> *"58. Accordingly, in light of the analysis and findings presented in this judgment, it is evident that while the subject patent application has a technical contribution, the said contribution primarily arises out of the use of an algorithmic process that regulates the flow of information through a sequence of instructions. The claims, when read in conjunction with the complete specification, clearly indicate that the core functionality of the invention relies heavily on conditional logic and procedural steps. As established, such algorithmic processes fall under the exclusion criteria outlined in Section 3(k) of the Patents Act, which disqualifies mathematical methods, business methods, and computer programs per se from being patentable subject-matter."*

II. The impugned invention is barred under Section 3(k), i.e., being a computer program per se and an algorithm.

22. Mr. Deshmukh then submitted that when the tests laid down in the case of ***Ferid Allani v. Union of India*** and ***Blackberry Ltd. v. Controller Patents & Design*** were applied to the impugned invention, and that the following emerged from the complete specification, i.e., Form 2: (a) The field of the

invention was algorithmic and not technical in nature; (b)The background of the invention identified a non-technical problem faced by human researchers in searching medical literature; (c) The impugned invention was an algorithm run on generic computer hardware, including laptops and mobile phones; (d) The technical effect described by the applicant itself was merely a "unique logical expression"; and (e) The "relational expression" claimed as the inventive step was purely algorithmic implementation, i.e., computer-readable program code, implemented through a predetermined, step-by-step sequence of instructions on generic hardware.

23. Mr. Deshmukh further submitted that the Controller's findings in the Impugned Order could be summarised as follows:

    a. Lack of Inventive Step, i.e., Section 2(1)(ja), all key features of Claims 1-24 were disclosed in the prior art. D1 disclosed database systems for retrieving medical studies; D2 disclosed medical information retrieval systems; and D3 disclosed semantic and ontology-based matching of medical data and clinical trials. The

method claimed in Claim 1 matched almost entirely with the teaching of D3, with support from D1. The apparatus claim (Claim 21) was considered a routine client-server computer system that was well-known and obvious. Any differences over the prior art were minor and non-technical, did not involve any technical ingenuity, and a person skilled in the art could easily arrive at the claimed invention from existing knowledge. Accordingly, Claims 1-24 were held to lack an inventive step.

b. Non-Patentability, i.e., Section 3(k): The invention essentially performed data processing, ontology learning, and comparison of relational expressions, which were software algorithms, not technical inventions. The “self-learned ontology” was a non-technical concept already well-known in the art. The invention did not improve the internal functioning of a computer or database and using hardware components alone did not render a software-based solution patentable. The claimed system did not demonstrate any real technical

effect or technical contribution. The invention solved a non-technical problem (how to search medical documents better) through a non-technical, software-based solution and, accordingly, fell squarely under the exclusion of "computer program per se" under Section 3(k).

24. Mr. Deshmukh accordingly submitted that the refusal of the application by the Controller under Section 3(k) was both appropriate and justified and submitted that the Petition be dismissed.

Submissions in Rejoinder:

25. Mr. Aryan, in rejoinder, submitted that the Respondent's reliance on the decision of the Delhi High Court in ***Microsoft Technology Licensing, LLC v. Assistant Controller of Patents and Designs***[8] was misplaced and, in fact, supported the Petitioner's case since the Court had held that where optimisation was applied in practical hardware configurations contributing a clear technical effect of enhanced capabilities, the Impugned Order was

[8] 2024 SCC OnLine Del 3239.

set aside. He further submitted that the reliance placed by the Respondent on the decision of the Delhi High Court in the case of ***Blackberry*** was also misplaced, as the invention therein related to a set of logical instructions governing information flow through conditional logic characteristic of an algorithm, which was not the character of the present invention.

Reasons and Conclusions:

26. Having heard learned counsel and having considered the pleadings and the case law upon which reliance is placed, I find that the Petition would have to be allowed, to the limited extent of remitting the matter back for consideration afresh. I say so for the following reasons:

A. It is now well settled that the process for determining 'inventive step' has been laid down by the Delhi High Court in the case of ***F. Hoffmann-La Roche Ltd. v. Cipla Ltd***. A perusal of the Impugned Order indicates plainly that the aforesaid steps have not been followed and the Respondent has concluded that Claims 1 to 24 lack 'inventive steps' in view of prior art documents, i.e., D-1 to D-3. Crucially, however, the

Impugned Order is bereft of any analysis as to how the said prior art discloses or renders obvious the claimed invention.

B. Furthermore, the Impugned Order also does not undertake any comparison of the Petitioner's invention with the cited prior art, nor does it explain the manner in which a person skilled in the art could, on the basis of the prior art cited, arrive at the claimed invention or make the claimed invention obvious. In an inventive step analysis, it is not sufficient for the examiner to cite prior art documents. It was necessary for the Respondent to identify which features of the claimed invention were taught by the prior art and thus obvious to a person skilled in the art. This absence of reasoning/analysis, in my view, renders the Impugned Order vulnerable to challenge and liable to be set aside, since it is well settled that the reasons are the heart and soul of an order.

C. Furthermore, the Impugned Order also materially departs from the objections communicated to the Petitioner in the hearing notice dated 5th March, 2024. While the hearing notice indicated that the claims did not

disclose structural or hardware features and were in the nature of a computer program, the Impugned Order contains findings to the effect that the Petitioner's invention pertains to a 'self-learned ontology' and is therefore non-technical in nature. Such a finding was plainly beyond the scope of the hearing notice, and thus, the Petitioner did not have the opportunity to respond to such claims. Hence, there is material in the contention that there has been a violation of the principles of natural justice.

D. While the Respondent has placed reliance upon the decision in the case of ***Blackberry*** to justify the Impugned Order by contending that since the invention is merely a computer program *per se* and an algorithm which can be implemented on generic hardware, such contention even if correct, would not cure the defects noted at paragraphs (A), (B) and (C) above.

E. Furthermore, the Petitioner has placed reliance upon the decision of the Delhi High Court in the case of ***Microsoft Technology Licensing LLC***

to contend that the Petitioner's invention yields a technical effect in the form of improved database retrieval efficiency and reduced computational load, and thus such inventions are not barred under Section 3(k). This is also a factor which would have to be specifically examined and was not done in the present case.

27. Hence, for the aforesaid reasons:

i. The Impugned Order is set aside, and the matter is remanded back for consideration afresh in accordance with the law. The Respondent shall offer the Petitioner an opportunity for a hearing and thereafter pass a reasoned order.

iii. It is clarified that this Order shall in no manner be construed to mean that the Court has cast any aspersion upon the Respondent.

iii. The Petition is accordingly disposed of.

[ARIF S. DOCTOR, J.]

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