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* IN THE HIGH COURT OF DELHI AT NEW DELHI
Reserved on: 26th July, 2024
Pronounced on: 30th August, 2024
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C.A.(COMM.IPD-PAT) 318/2022

BLACKBERRY LIMITED

.....Appellant

Through: Mr Pravin Anand, Ms. Vaishali. R. Mittal, Mr Sandeep Bhola & Mr Gursimran Singh Narula, Advs.

versus

CONTROLLER OF PATENTS AND DESIGNS

.....Respondent

Through: Mr. Harish Vaidyanathan Shankar CGSC, Mr. Srish Kumar Mishra, Mr. Alexander Mathai Paikaday, Advs. with Mr. Santosh Kr. Gupta, Assistant Controller of Patents

CORAM:

JUSTICE PRATHIBA M. SINGH

JUDGMENT

Prathiba M. Singh, J.

1. This hearing has been done through hybrid mode.

A. Background

2. The convergence of computing, entertainment, gaming, word processing, scanning, communication, etc., on single devices has posed significant challenges to technology developers as devices grow smaller and smaller and their capabilities are to be enhanced simultaneously. In order to cater to such challenges technologies had to be developed for optimum utilization of the available capabilities by inter-linking devices with multiple sources and keeping them connected. The inter-linking of multiple sources to



a particular device and the addition of a capability in the device to download, store and make available media content, as per the likability or preference of a user, may appear seamless today but may not have been so easy to achieve at the time when the subject invention under consideration was applied for.

3. The Appellant is a corporation organised under the laws of Ontario, Canada, specializing in providing telecommunication products, services, and solutions. These include enterprise software, Internet of Things (IoT), network infrastructure, and other associated services. The Appellant was originally known as Research In Motion (RIM) and is widely known as the former developer of the BlackBerry brand of smartphones and tablets as also the messaging app BlackBerry Messenger, commonly referred to as 'BBM'. The Appellant claims that its products are used worldwide by various businesses, automobile makers, and government agencies. The Appellant – BlackBerry Ltd. which was amongst the leading companies at the relevant point in time developed various technologies to make handheld and other similar devices more user friendly, versatile and efficient.

4. The present appeal under Section 117A of the Patents Act, 1970 (*hereinafter 'the Act'*) was originally filed by the Appellant- BlackBerry Limited before the Intellectual Property Appellate Board (*hereinafter, 'IPAB'*) in the year 2020. Thereafter, consequent upon the abolition of the IPAB and, upon the enactment of the Tribunals Reforms Act, 2021, the present appeal stood transferred to this Court. No order sheets of the IPAB are on record in the present appeal. Notice is not stated to have been issued by the IPAB. Consequently, vide order dated 20th December, 2022, notice was issued by this Court.

5. The present appeal relates to the subject patent application titled "Auto-



Selection of Media Files”. The subject patent bearing Application Number 717/DEL/2009 was filed on 25th July, 2008, with twelve (12) Claims, as a Convention Application, claiming priority from five US patent applications. The earliest priority date of the subject patent is 12th May, 2008 and the publication date of the application is 31st August, 2016. The Bibliographic details of the subject patent application are set out below:

APPLICATION NUMBER	717/DEL/2009
APPLICATION TYPE	CONVENTION APPLICATION
DATE OF FILING	06/04/2009
ASSIGNEE	Malikie Innovations Limited
TITLE OF INVENTION	Auto-Selection of Media Files
FIELD OF INVENTION	COMPUTER SCIENCE
E-MAIL	anandandanand@vsnl.com
PRIORITY DATE	12/05/2008
REQUEST FOR EXAMINATION	06/04/2009
PUBLICATION DATE	31/08/2016
REPLY TO FER DATE	20/12/2016

6. The subject patent application relates to a method of auto selection of media files and was, initially filed with 12 Claims. A request for examination dated 6th April, 2009 was filed on behalf of the Appellant. Thereafter, various objections of lack of novelty, inventive step and non-patentability under Section 3(k) of the Patents Act, 1970 (*hereinafter 'the Act'*) were raised by the Indian Patent Office. The same were replied to by the Appellant and finally, amended claims were filed. A tabular representation of the three prior arts relied upon by the Id. Controller to substantiate the objection of lack of



novelty and inventive step are set out below:

Prior Art	Publication Number	Assignee	Publication Date	Title
D1	US6366296B1	Xerox Corporation, Fuji Xerox Co. Ltd.	02-04-2002	Media browser using multimodal analysis
D2	US7065521B2	Motorola, Inc.	20-06-2006	Method for fuzzy logic rule-based multimedia information retrieval with text and perceptual features
D3	EP1227396A1	Microsoft Corporation	31/06/2002	A method, system, and computer program product for synchronizing data represented by different data structures by using update notifications

7. The final set of claims which were filed by the Appellant, which were refused under Section 15 of the Act are set out below:

“We Claim:

*1. A method for managing content in a device (210) comprising the steps of:
providing a confidence level for each media file in a plurality of media files, by a controller (1105), the confidence level being a measure of likeability;
automatically selecting, by the controller (1105), media files from the plurality of media files, based on the confidence levels, to fill a media storage of a device, the media storage being an allocated amount of a storage medium of the device; and
updating, by a cache manager (307) implemented by the controller (1105), a list with information corresponding to the selected media files, wherein the method includes;
categorizing, by the controller (1105), the media files based on the confidence levels of each media file; and
applying a comparison of file sizes of the categorized*



media files , by the controller (1105), , with respect to a portion of the media storage that is determined to be available for automatic filling, as a filter for automatically selecting the media files to fill the media storage of the device.

2. An apparatus for managing content and implementing the method as claimed In claim 1.”

8. The Id. Controller has, however, refused the grant of the patent on the ground of non-patentability under Section 3(k) of the Act. The relevant extract of the impugned order which contains the discussion on Section 3(k) of the Act is set out below:

“6. With regard to the substantive objection under the header “Non-Patentability u/s 3” of the said Hearing notice, the applicant/agent of the applicant has made extensive submissions and has cited various case laws and guidelines. The matter has been carefully considered in detail. Without prejudice to the above said, having considered the aforesaid submission, I do not find the submission persuasive in view of following: The subject matter as described and claimed relates to a control selection of media content provide a mechanism to enhance user interaction with multimedia devices. In view of the above, the subject matter of claims 1-2 represents managing content in a device [Fig 1 and para [0020]], confidence level for each media file in a plurality of media files, by a controller, the confidence level being a measure of likeability [fig 4 and para [0039]] and categorizing such as The confidence level for each media file can be provided using artifacts in metadata associated with the respective media file. The artifacts may reside in a metadata library of an apparatus. It is noted that the features related to generating a confidence level for each media file , where the confidence level is being a measure of likeability categorizing media files for selection, and the feature about how the measure of likeability is being calculated,



*are considered nontechnical features. **However, the features defined as non-technical are not used for any apparent technical purpose (like controlling a technical process) because they do not contribute to a technical effect and therefore do not contribute to a solution of a technical problem.** Automatically selecting, by the controller, media files from the plurality of media files, based on the confidence levels, to fill a media storage of a device, the media storage being an allocated amount of a storage medium of the device and updating, by a cache manager [para [0033]] such as collection of media content may be accessed either by using iTunes software or through an iTunes xml file, cache manager can determine whether to use the iTunes application connector or the iTunes xml file connector in order to access the iTunes collection. Cache manager may provide a unified interface to multiple sources/libraries. Cache manager may maintain a buffer that unifies files from different libraries and implemented by the by the controller, a list with information corresponding to the selected media file. **Applying a comparison of file sizes of the categorized media files, by the controller, with respect to a portion of the media storage that is determined to be available for automatic filling, as a filter for automatically selecting the media files to fill the media storage of the device[para [0040], [0074] and fig 4] as such set of computer executable instructions and automatic filing with sorting process on a general purpose computer and an algorithm to execute the said instructions in a pre-defined sequential manner.** In claims of the instant alleged invention, computer programs are claimed in the form of device for supporting media file with algorithmic steps indicating the function of flow charts or process steps. **Hence these instructions are algorithm and computer program per se and the subject matter of claims, though oriented towards system, yet pertains to computer program per***



se. Hence, subject matter of claims 1-2 relates to “algorithm and computer program per se” and falls within scope of section 3(k) of The Patents Act, 1970 (as amended).”

9. The conclusion in the decision of the Id. Assistant Controller of Patents and Designs in the impugned order is set out below:

“7. 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 3(k) is not found complied with. Hence, in view of the above and unmet requirements, this instant application is not found in order for grant.

8. 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. 717/DEL/2009 does not comply with the requirements of The Patents Act, 1970 (as amended).

9. I, therefore, hereby order that the grant of a patent for application no. 717/DEL/2009 is refused under the provisions of Section 15 of The Patents Act, 1970 (as amended).”

B. Submissions

10. On behalf of the Appellant, submissions have been advanced by Mr. Pravin Anand, Id. Counsel and Mr. Harish Vaidyanathan Shankar, Id. CGSC has made submissions on behalf of the Respondent. In addition, Mr. Santosh Kr. Gupta, Id. Assistant Controller of Patents has also appeared before the Court virtually to assist the Court. The prosecution history of the corresponding European patent applications has also been placed on record



by both the parties and perused by the Court.

B1. Submissions of the Appellant

11. At the outset, Mr. Pravin Anand, Id. Counsel for the Appellant has submitted that the subject patent application has to be adjudged on the state of the art prevalent on the priority date. Before commencing his arguments on merits in respect of the subject application he submits that the corresponding patent applications of the subject patent have been granted in other jurisdictions including Australia, Japan, US and China.

12. At this stage, on a query from the Court, Mr. Anand, Id. Counsel submits that the corresponding patent application filed before the European Patent Office has been refused. However, Mr. Anand submits that the objection relied upon by the Id. Controller under Section 3(k) of the Act is completely non-tenable inasmuch as the invention addresses a technical problem i.e., it evaluates the memory available on a particular device which is connected to a server and based on the user's requirements, upon the memory in the device becoming available, it downloads that much content which the device can handle. **The invention permits downloading of different quantities of content in different devices which may be connected to the same server.** Thus, according to him, the subject patent application is in effect an invention which discloses a system for management of media content, wherein such media content could be audio files, video files or any other form of content.

13. Mr. Anand, Id. Counsel submits that the various steps undertaken in the invention are as follows:

- Determination of the correct memory.
- Transfer of content within the available capacity after adjudging the



available capacity.

- Downloading the same with dynamic synchronization.

14. According to the Appellant, the above invention, if considered, on the basis of the available technologies in 2008 was a patentable invention as such systems and methods are not known at the relevant point of time. Reliance is placed upon the decision of this Court in *Ferid Allani v. Union of India, 2019 SCC OnLine Del 11867*.

15. In respect of the contentions surrounding the refusal of the corresponding European patent application, Mr. Anand, Id. Counsel submits that the corresponding EU application to the Subject Patent Application which bears application no. 09155841.1 was rejected vide decision dated 10th January, 2018. He strongly contends that, in the said decision, in paragraph 18.1, the EPO proceeds to hold that the document described as D6 which is the prior art US'765 renders the patent application non-patentable due to lack of novelty. However, the objection of lack of novelty has already been waived by the Id. Controller in the impugned order. It is submitted that the Indian Patent Office has copied the conclusions of the EPO in respect of the said prior art but itself has not relied on US'765.

16. According to Mr. Anand, the verbatim nature of the extracts from the EPO's order and the impugned order set out in the table in paragraph 7 of the written submissions dated 26th July, 2024 would show complete non-application of mind. The EPO had given certain observations based on US'765 while the said prior art has not been cited by the Indian Patent office. Despite this, the observations of the EPO w.r.t. the said prior art, i.e., US'765 have been reproduced verbatim in the impugned order. It is further submitted by Mr. Anand that insofar as the prior art US'765 is concerned, the said prior



art divides the memory into four separate sub-categories and the dynamic synchronization nature of the subject invention, is not present in the prior art. The table showing the verbatim copying from the EPO order in the impugned order is extracted below for ready reference:

“7. It is respectfully submitted that the sole ground of rejection, as per the impugned order, pertains to non-patentable subject matter under Section 3(k). The impugned order is incorrect and is liable to be set aside for the following reasons:

i. The impugned order lacks reasoning and is merely a copy-paste of refusal order in the EPO.

<i>Relevant Portion of Impugned Order (PDF Page 31; Pleading-I)</i>	<i>Relevant Portion of EPO-I refusal Order (Para 19.1 of EPO refusal order) (PDF Page 10 of Note filed on 15.01.2024)</i>
<p><i>“It is noted that the features related to generating a confidence level for each media file, where the confidence level is being a measure of likeability is being calculated, are considered non-technical features.</i></p> <p><i>However, the features defined as non-technical are not used for any apparent technical</i></p>	<p><i>“it is noted that the features related to generating a confidence level, where the confidence level is being a measure of likeability categorizing media files for selection, and the feature about the measure of likeability is being calculated, are considered non-technical features.</i></p> <p><i>However, the features defined as non-technical are not used for an apparent technical</i></p>



<p><i>purpose (like controlling a technical process) because they do not contribute to a technical effect and therefore do not contribute to a solution of a technical problem.....”</i></p>	<p><i>purpose (like controlling a technical process) because they do not contribute to a technical effect and therefore do not contribute to a solution of a technical problem.....”</i></p>
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17. Apart from the above, it is submitted by Mr. Anand, Id. Counsel submits that the technical feature which is the subject invention added was such an important feature that it led Blackberry to issue proper promotional material highlighting that more music could be downloaded on Blackberry devices. Thus, the technical effect is evident. If the feature claimed in the subject invention is enabled, more and more music or other content can be downloaded on a device that too on a live basis. This feature of the invention is sufficient to cross the threshold of Section 3(k) of the Act.

18. Finally, it is submitted that the technical effect of the subject invention is quite evident from the fact that it enables the user to get music through multiple sources which was hitherto not possible prior to this invention.

B2. Submissions of the Respondent

19. *Per Contra*, Mr. Harish V. Shankar, Id. CGSC has appeared along with Mr. Santosh Kumar Gupta, Id. Assistant Controller of Patents and Designs from Indian Patent Office. It is submitted on behalf of the Respondent that though Mr. Gupta is not the Controller who had examined the subject patent application; however, he has appeared to assist the Court. Mr. Gupta submits that the method which is disclosed in the patent specification is a standard function which is performed by any generalised computer software and, thus,



the patent would not be liable to be granted and would be hit by Section 3(k) of the Act. The solution which is found does not have technical effect according to Mr. Gupta.

20. Mr. Harish V. Shankar, Id. CGSC also submits that multiple sources is not a feature of the Claims in the subject invention, in any event he submits that both in the corresponding applications, i.e. the EP application as also in the divisional application, the EPO has considered this very aspect and has held the patent non-grantable on the basis of lack of any technical effect. Reliance is placed upon paragraph 17.3.6 of the decision dated 8th August, 2019 passed by the EPO.

21. In the written submissions dated, 11th April, 2023, on behalf of the Respondent, Mr. Harish V. Shankar, Id. CGSC, further states that the subject matter described and claimed in the subject patent application pertains to controlling the selection of media content in order to enhance user interaction with multimedia devices and autofill media files based on available storage. He emphasizes that the Claims of the subject patent primarily involve managing content within a device by generating a confidence level for each media file, which is described as a measure of likeability. According to the Respondents, this confidence level is then used to categorise and select media files for download and storage management. However, these features are non-technical as they merely categorise and filter media files based on user preference or available storage, without contributing to any technical effect or solving a technical problem.

22. Id. CGSC also submits that the claimed invention involves steps that can be executed by any general-purpose computer, involving standard algorithms for media file management. According to him, such steps include



automatically selecting media files, managing a cache, and sorting media files based on size and available storage. It is asserted by Id. CGSC that these are basic computational tasks that are well within the capabilities of existing technology and do not present any novel or inventive technical features. Therefore, it is the contention of Id. CGSC that the inventive features claimed in the subject patent application fall under the purview of Section 3(k) of the Act, and accordingly, the refusal by the Id. Controller is justified.

23. Further, Id. CGSC contends that the claimed features, including generating a confidence level and categorizing media files, are abstract and non-technical, which are merely automating user preferences without serving a defined technical purpose. He contends that these features do not contribute to the technical character of the invention, as they neither produce a technical effect nor solve a technical problem, but instead implement a standard algorithm on a general-purpose computer, making them ineligible for patent protection and attracting objections under Section 3(k) of the Act.

24. In conclusion, Mr. Harish V. Shankar, Id. CGSC submits that the claimed invention fails to demonstrate any technical advancement or show any contribution to a technical field. It is essentially a computer program executed on general-purpose hardware, with algorithmic steps that fall squarely within the exclusion of Section 3(k) of the Act. Accordingly, the appeal against the order refusing the patent application should be dismissed, and the decision of the Id. Controller should be upheld.

C. Analysis and Findings

25. The subject invention was sought for by the Appellant way back in 2008-09 for a method by which management of media content could be



achieved. A perusal of the complete specification would show that with minimal interference by the user, the system could manage media content.

26. Media content could include a large variety of content such as music, movies, videos, audio books, games, presentations, etc. Such content could be in different formats including MP3, MPEG, AAC, etc. The systems would include a combination of hardware and software used for managing the media which could be connected to devices such as mobiles, portable computers, PDAs which could be carried by the users conveniently and also provide wireless communication. The user devices could be connected to PCs or even wireless servers.

27. The communication between the user devices and the PCs/servers could be triggered by a combination of algorithms with computer programmes which could thereafter be implemented through software implementations. These would be capable of processing, computing, calculating, displaying or even conducting manipulation and transformation within the systems so as to enable management of media content. The PCs/servers could be connected to external and internal libraries which could be the sources for the media content. As and when the user devices become capable of receiving content, without the user's interference or manual intervention, content could be made available to the user from libraries, other online servers, play lists, etc. Retrieval of content is also one of the embodiments in the complete specification. The system could also connect to multiple media sources or a single media source. The user's likability of a particular kind of content based upon previous usage could also be measured. Another embodiment of the invention includes monitoring of the openly available content on the internet based on the likability of the user.



28. Therefore, the invention contemplates assessment of the user's liking for example, the number of times a user plays a song irrespective of whether the same is in one album or in multiple albums. The invention gives weightage to various forms of data which was collected from the user and enables auto-filling of the content. Management of media files as per the invention is also made possible by keeping some transfers in a pending status as well. The user could be allowed to brose and sync a library on a server or a PC with the user handheld communication device.

29. Another embodiment also contemplates enabling the user to remotely view and manage the content library. The transfer and management was possible both through hardware devices such as USBs or even through W-Fi communication. Offline access could also be possible to a particular extent of the content in the form of a music library or a content library. The devices could also be configured in a manner so as to provide even unlimited storage through automatic sinking. With all these embodiments, the claims in the patent reads as under:

"We claim:

*1. A method for managing content in a device (210) comprising the steps of:
providing a confidence level for each media file in a plurality of media files, by a controller (1105) ,the confidence level being a measure of likeability;
automatically selecting, by the controller (1105), media files from the plurality of media files, based on the confidence levels, to fill a media storage of a device, the media storage being an allocated amount of a storage medium of the device; and
updating , by a cache manager (307) implemented by the by the controller (1105), a list with information corresponding to the selected media files, wherein the*



method includes;
categorizing, by the controller (1105), the media files based on the confidence levels of each media file; and applying a comparison of file sizes of the categorized media files, by the controller (1105), with respect to a portion of the media storage that is determined to be available for automatic filling, as a filter for automatically selecting the media files to fill the media storage of the device.
2. An apparatus for managing content and implementing the method as claimed In claim 1.”

30. A perusal of the claims would show that claim no. 1 is for a method for managing content and claim no. 2 relates to apparatus for managing content. The various embodiments set out in the patent specification have also been depicted in various figures attached to complete specification. Overall, from a reading of the Complete Specification and the Claims, the subject patent discloses the following features:

- The functionality supporting the creation of a unified library, which organizes media content from multiple sources into a single unified library file for centralized management. The said feature enables Claim 1 by providing a structured source for selecting and managing media files.
- Metadata-Only Files: This feature creates library files that contain metadata only, reducing file size for efficient browsing and transfer, thereby allowing easy categorization and selection based on metadata attributes like confidence levels.
- Facilitation of both remote and local access to library files by mobile devices with varied capabilities providing methods for accessing and managing media files from different storage locations and devices seamlessly.



- Cache Manager Functionality: This feature maintains the buffer that manages files from different libraries and monitors changes. This feature is claimed in Claim 1 and enables dynamically managing the list of selected files and handling updates.
- Automatic selection of media files based on file sizes and confidence levels to optimize storage.
- Synchronisation of media content between devices, for ensuring that the latest content is accessible across devices.
- Randomized Selection Support: Allows randomized selection of media files to fill storage efficiently under various constraints, thereby enabling flexibility in file selection criteria.
- Dynamic Storage Management based on storage capacity, user behaviour, and media attributes, resulting in application of filters to optimize available storage space.
- Device-Specific Configuration: Configures devices to manage media independently from PC desktops, enhancing accessibility and usability.
- Adjustment of media selection criteria based on user preferences and usage patterns, which enables Claim 1 by prioritizing files.
- Efficient Media Transfer: The subject patent enables efficient transfer of media content by using metadata for optimizing file selection for available storage thereby ensuring that selected files fit storage constraints.

31. The question that arises is whether such an invention is hit by the bar contained in Section 3(k). The law in respect of Section 3(k) has now been well settled in the following decisions:

- *Ferid Allani v. Union of India & Ors., 2019 SCC OnLine Del*



- *Microsoft Technology Licensing v. Assistant Controller of Patents And Designs, 2023 SCC OnLine Del 2772*
- *Lava International v. TLM Ericsson, 2024:DHC:2698*
- *Microsoft Technology Licensing LLC v. The Assistant Controller of Patents And Designs, 2024:DHC:3547*

32. A perusal of the subject invention along with the law on the subject would show that the invention can by **no stretch of imagination be described as merely a computer programme or an algorithm. The same has a technical implementation and a definitive impact on the user experience through the device of the user. It also has an effect on the capability of the device. The subject invention enhances the functionality and the capacity of the device almost in an unlimited manner. It is also enabling autonomous operation of device without any specific intervention by the user.**


33. The age old saying that *the proof of pudding is in the eating* is applicable in the present case wherein the invention in fact is stated to have resulted in the Appellant marketing this feature for advertising its devices. This invention is stated to have been publicized by Blackberry in promotional material which was issued contemporaneously in the following manner:



BlackBerry Media Sync

WES2008
WORLDWIDE ELECTRONIC SYNDICATE

- Get more music onto your BlackBerry!
- BlackBerry Media Sync is a free application providing BlackBerry smartphone users with a **simple way to sync their iTunes® digital music collection with their device**



-As we continue to improve the media capabilities of BlackBerry – one item that is top of mind for us is continuing to find ways to make it easier for BlackBerry users to get their music collection onto their BlackBerry

-The launch of BlackBerry Media Sync is one big step in the right direction – BlackBerry users can now get their iTunes collection onto their BlackBerry

-(Get stats from preso) Research shows that many iTunes users – use iTunes to organize music they have ripped from their CDs

-The mobile phone will become the primary music management device:

US OTA download revenue will reach \$940 million in 2011 (Yankee Group, 2006)

23.5% of people expect their mobile phone to be the de facto entertainment and communications hub, even above the PC (EMR, 2007)

40% of US BlackBerry target-customers are already interested in finding and purchasing music directly from their handheld device (Torque, 2007)

16% of UK phone users have already purchases music OTA to their device (EMR, 2007)

34. Any invention which can increase the capability of a device to such an extent would not be hit by Section 3(k) of the Act. The argument of Mr. Harish V. Shankar, Id. CGSC that the rejection by the EPO ought to result in rejection of subject patent – though extremely appealing, is not tenable.

35. This Court has independently assessed the nature of the invention and is of the opinion that the bar under Section 3(k) of the Act would apply to the



subject invention.

36. Even in the EU, the refusal of the corresponding patent application has been primarily on account of lack of novelty in view of the prior art document being US'765. This Court does not agree with the EPO's analysis that the purpose of the invention is merely to select files based on popularity ratings and the same is not linked to a technical task. In fact, this Court is of the opinion that the enhancement of the capability of any device to such a far-reaching extent that the functionality of the device is made more efficient within the same storage space, is a concrete technical effect and technical contribution.

37. The Court has also perused US'765 wherein the main Claim reads as under:

“1. A method of automatically selecting at least one of a plurality of stored multimedia files for transfer between a first storage medium and a second storage medium, the method comprising assigning each stored file a popularity weighting based on popularity information and selecting from among the plurality of stored files those files having a popularity weighting within a preferred range.”

38. At first blush, there could appear to be some similarity between the invention set out in US'765. This Court notes that the Id. CGSC is correct in his submission that the prior art document, US'765 describes methods of automatically selecting multimedia files for transfer between storage mediums based on criteria such as popularity weighting and recency of access. However, in the opinion of this Court, US'765 may have been just the first step which may have been achieved. The subject patent application has gone far beyond the invention disclosed in US'765 and thus US'765 does not render



the present subject patent non-patentable due to lack of novelty.

39. To further elucidate the differences between the subject patent application and the prior art disclosed in US'765, a comparative analysis of the key features of the respective claims has been made. In order to highlight the distinction in the features claimed in the subject patent application as compared to those disclosed in US'765, the following key pointers are set out below:

- **Unified Library System:** The subject patent organizes media content from multiple sources into a single unified library file, allowing centralized management and indexing, which is not at all disclosed in the prior art document US'765.
- **Metadata-Only Library Files:** The subject patent enables creation of library files using only metadata, reducing file size for efficient browsing and transfer, unlike the approach in US'765, which focuses solely on transferring media files between storage devices based on popularity and likeability. In effect, While the subject patent utilizes a technical basis for efficient transfer and synchronization of media files, the prior art relies on a non-technical approach for transfer.
- **Cache Management:** The subject patent specifically discloses and claims a cache manager that maintains buffers to unify and separate files from different libraries, which dynamically monitors changes to update device libraries, a feature completely absent in US'765.
- **Remote or Local Access by Mobile Devices:** The prior art does not cover or include the feature of allowing remote or local access by mobile devices, a feature expressly covered in the subject patent application. While the prior art discusses transferring media files, it does not address an interface



that provides access based on device capabilities, nor does the prior art disclose the ability for devices to browse, select, and transfer media content in the same way as enabled by the subject patent application.

- **Mobile Device Configuration for Enhanced Media Accessibility:** Although the prior art refers to portable media players connecting to other devices (such as PCs or media centers) and describes configurations for automatic updates via USB or wireless connections (e.g., through Bluetooth), it does not enable the feature of virtually unlimited media storage as described specifically in paragraph [0069] of the complete specification of the subject patent application, which is clearly novel and demonstrates a further technical effect.

40. From the above pointers, the clear position that emerges is that while there are conceptual similarities between the subject patent application and the prior art US'765, the subject patent application introduces several novel elements that distinguish it. While both the methods in the subject patent and the prior art involve automatic selection of media files based on user preferences; however, the subject patent's use of a 'confidence level' based on likeability offers a different metric compared to the 'popularity weighting' used in US'765. Additionally, the subject patent includes a specific step for categorizing media files based on confidence levels and comparing file sizes to the available storage as a filter for selection. This particular method of filtering selections is not disclosed in the prior art.

41. Further, the inclusion of a specific cache manager in the subject patent application, which is specifically responsible for updating a list containing information corresponding to the selected media files, represents a novel feature not found in US'765. The apparatus Claim in the subject patent, which



implements the method with these specific advancements, also contributes to its novelty. Overall, these distinguishing features, especially the technical step involving the cache manager and the specific categorization and filtering process, substantiate the case that the subject patent application provides for a technical advance beyond the disclosure in prior art, US'765 and thus should not be deemed non-patentable due to lack of novelty.

42. To support the argument that the claimed invention meets the requirements for subject matter eligibility, the discussion in *Terrell on the Law of Patents, 19th Edition (South Asian Edition)* is relevant, which highlights the conditions under which the implementation of computer programs may be deemed patentable. The relevant extract is as follows:

“2-111 The Court went on to accept that two types of technical advantage which are attributable to computer programs may suffice for patentability. The first is where the program solves a problem within the computer itself. The second is where the effect of the program is not merely within the computer but where the beneficial consequences feed into other devices. It concluded:

“Indeed, it appears to us that upholding the conclusion of the Comptroller in this case, would involve the English courts departing from all the decisions of the Board to which we have referred. In particular... we consider that it would be inconsistent with the reasoning of the Board in Game account, if we allowed this appeal. In [2.7], the Board said that there must be 'further technical advantages or effects associated with specific features of implementation over and above the effects and advantages inherent in the excluded subject-matter'. That cannot mean that any technical



advantage attributable to a computer program is excluded, as it would make a nonsense of art 52(3) and of all the previous Board decisions. Therefore, it must mean, consistently with VICOM and the two IBM Corp. cases, that a technical innovation, whether within (as in the last-mentioned cases) or outside the computer will normally suffice to ensure patentability (subject of course to the claimed invention not falling foul of the other exclusions in art 52(2)).”

43. The above discussion emphasizes the need for technical advantages that extend beyond the excluded subject matter. In respect of the present appeal, the features of the subject patent application such as cache management for unifying and updating libraries, metadata-only library files for efficient transfer, and dynamic media synchronization, provide technical effects both within the computer (e.g., optimizing storage and retrieval processes) and beyond the computer (e.g., enhancing the functioning of mobile devices, improving media accessibility).

44. In these facts and circumstances of this case as discussed above, the objection under Section 3(k) of the Act is rejected. No objections as to novelty or inventive step have been raised by the Patent Office though the prior art considered by EU, i.e. US’765 has also been perused and discussed for the sake of completeness. In view of the fact that this Court has found merit on the argument of the Id. CGSC that the prior art US’765 does disclose the feature of selection multimedia files for transfer between storage mediums based on criteria such as popularity weighting and recency of access, this Court directs an appropriate amendment of the Claims be carried out so that the subject patent can proceed to be grant. Support for issuing such a direction is drawn from the decision of the Coordinate Bench of this Court in *Societe*



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45. Accordingly, this Court directs that the Appellant shall characterize the Claims of the subject patent to limit the scope of the patent to the feature of ‘automatic selection’ and ‘updating by a cache manager’. Therefore, the first part of Claim 1, i.e. the feature of providing confidence level on the basis of likeability shall be acting as the prior art over which the characterizing features of ‘automatic selection’ and ‘updating by a cache manager’ are a novel technical advancement. The first Claim of the subject patent application shall accordingly read as:

1. *A method for managing content in a device (210) wherein a controller (1105), provides a confidence level for each media file in a plurality of media files, such that, the confidence level is a measure of likeability **characterized by the steps of:***

automatically selecting, by the controller (1105), media files from the plurality of media files, based on the confidence levels, to fill a media storage of a device, the media storage being an allocated amount of a storage medium of the device; and

updating, by a cache manager (307) implemented by the by the controller (1105), a list with information corresponding to the selected media files, wherein the method includes;

categorizing, by the controller (1105), the media files based on the confidence levels of each media file; and

applying a comparison of file sizes of the categorized media files, by the controller (1105), with respect to a portion of the media storage that is determined to be available for automatic filling, as a filter for automatically selecting the media files to fill the media storage of the device.



46. A comparative table of the earlier Claim 1 and the amended Claim 1 is set out below:

Earlier Claim 1	Amended Claim 1
<p>1. A method for managing content in a device (210) comprising the steps of:</p> <p>providing a confidence level for each media file in a plurality of media files, by a controller (1105), the confidence level being a measure of likeability;</p> <p>automatically selecting, by the controller (1105), media files from the plurality of media files, based on the confidence levels, to fill a media storage of a device, the media storage being an allocated amount of a storage medium of the device; and</p> <p>updating, by a cache manager (307) implemented by the by the controller (1105), a list with information corresponding to the selected media files, wherein the method includes;</p> <p>categorizing, by the controller (1105), the media files based on the confidence levels of each media file; and</p> <p>applying a comparison of file sizes of the categorized media files, by the controller (1105), with respect to a portion of the media storage that is determined to be available for automatic filling, as a filter for automatically selecting the media files to fill the media storage of the device.</p>	<p>1. A method for managing content in a device (210) wherein a controller (1105), provides a confidence level for each media file in a plurality of media files, such that, the confidence level is a measure of likeability <u>characterized by the steps of:</u></p> <p>automatically selecting, by the controller (1105), media files from the plurality of media files, based on the confidence levels, to fill a media storage of a device, the media storage being an allocated amount of a storage medium of the device; and</p> <p>updating, by a cache manager (307) implemented by the by the controller (1105), a list with information corresponding to the selected media files, wherein the method includes;</p> <p>categorizing, by the controller (1105), the media files based on the confidence levels of each media file; and</p> <p>applying a comparison of file sizes of the categorized media files, by the controller (1105), with respect to a portion of the media storage that is determined to be available for automatic filling, as a filter for automatically selecting the media files to fill the media storage of the device.</p>



47. The Appeal is allowed and the patent be proceeded for grant, as amended.
48. Ordered accordingly.
49. List before the Controller General of Patents Designs and Trademarks on 6th September, 2024 for completion of necessary formalities including recording of the amendment directed by the Court.
50. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trademarks of India on the e- mail- llc-ipo@gov.in for compliance. Ld. CGSC is also requested to communicate the directions given by this Court to the Appropriate Office of the Controller of Patents.
51. All pending applications, if any are disposed of.

PRATHIBA M. SINGH
JUDGE

AUGUST 30, 2024

Rahul/am