

(2026) 08 DEL CK 4071

In the Delhi High Court, Principal Bench, New Delhi

Case No : C.A.(COMM.IPD-PAT) 149/2022

T-Mobile International Ag And Co. Kg. Through Mr. Tanmay Joshi, Constituted Attorney APPELLANT

Vs

The Controller General Of Patents, Designs And Trademarks & Anr. RESPONDENT

Date of Decision : 04-08-2026

Acts Referred:

Patents Act, 1970 — Section 3(k), 3(m), 3, 2(1)(ja), 2(1)(j)
Patents Bill of 1953 — Clause 3
1911 Act

Citation : (2026) 08 DEL CK 4071

Hon'ble Judges : Tushar Rao Gedela, J

Bench : Single Bench

Advocate : Mr. Vineet Rohilla, Mr. Rohit Rangi, Mr. Tanveer Malhotra, Dr. Monika Arora, CGSC, Mr. Subhrodeep Saha, Ms. Animika Thakur, Mr. Adarsh Ramanujan, Parth Singh

Final Decision : Disposed Of

Judgement

Tushar Rao Gedela, J.

1. The present appeal was filed challenging the order dated 29.12.2016 passed by the respondent in respect of a patent application No. 468/DELNP/2008, titled "*Method and Arrangement for optimising the Operational Times and Cell Change Performance of Mobile Terminals*" whereby the subject application was refused on the grounds under Section 3(k) and Section 3(m) of the Patents Act, 1970 (hereinafter referred to as 'the Act').

2. This Court having heard the arguments of the learned counsel for the appellant and the respondent on merits of the appeal had, *vide* order dated 26.02.2026, remanded the appeal for denovo consideration by the respondent.

3. However, during the arguments it transpired and the learned counsel had fairly submitted that there are no guidelines in respect of the manner in which the

objections under Section 3(m) of the Act, is to be ascertained and evaluated by the Patent Office. Learned counsel for the parties sought to assist this Court on the aforesaid issue, however, it was deemed appropriate to request assistance of an amicus. It was on this issue that the Court restrained the said appeal for a limited purpose in public interest.

4. In that view of the matter, this Court requested and Mr Adarsh Ramanujan, a learned advocate and a young counsel having vast practice and knowledge of the Patent regime, very kindly consented to assist this Court.

5. Further upon the request of this Court, learned Amicus and learned counsel for both parties had furnished the draft guidelines for perusal of this Court.

6. Thereafter, the learned Amicus on 20.05.2026 has submitted an updated Report containing suggested draft guidelines.

7. Legislatively, the 1911 Act did not contain any provision similar to Section 3 as it exists today in the Patent Act 1970. It was in the Patents Bill of 1953 that by way of Clause 3, "*What is not patentable*" was proposed. Later the Justice Ayyangar Committee, re-drafted Clause 3 and was incorporated into the Patents Act 1970. The Committee noted that such a clause has the purpose of codifying in "*precise terms inventions for which patents should be refused in the interest either of national economy or national health or well-being*". Clearly, the legislature wanted to engraft exceptions to the patentability under the enactment. This was in the form of exceptions carved out in various sub-sections of Section 3 of the Act.

8. Sub-section (m) to Section 3 of the Act was inserted by way of an amendment in the year 2002. The statement of objects and reasons allude to insertion of Section 3(m) with "international practices" and belongs to a category which do not constitute patentable invention. This aligns with the rationale espoused by Justice Ayyangar Committee behind insertion of Section 3 in the Act. It should be borne in mind that provisions of Section 3(m) are "*pari materia*" with Article 52(2) (c) of the European Patent Convention. Section 3(m) of the Act is reproduced hereunder:

"Section 3. What are not inventions.—

The following are not inventions within the meaning of this Act,—

(m) a mere scheme or rule or method of performing mental act or method of playing game;"

9. Plainly, having regard to the use of the expression "or" between the words *mere scheme; rule; method of performing mental act and; method of playing game*, it appears that Section 3 of the Act postulates four exceptions, i.e., (i) a mere scheme of performing a mental act; (ii) a mere rule of performing a mental act; (iii) a mere method of performing a mental act; and (iv) a method of playing games.

10. It may be significant to note that the word "mere" has been used at the

commencement of the provision followed by the “act” with the word “or” between each of such acts suggesting disjunctionaries. Thus, it can be safely assumed that the word “mere” would be a qualifier governing the first three exceptions demonstrating that the exception is limited to claims that solely amount to a mental act and nothing more. Moreover, as against the other exceptions contained in Section 3 as a whole, sub-section (m) relates only to “mental” acts. In the ordinary context, “mental” act is an act of the mind like calculation, reasoning, evaluation, cognition, discriminative faculties, logic, judgement etc.

11. There may be situations where an invention may satisfy the requirement under Section 2(1)(ja) of the Act, yet may not be patentable on account of falling foul of Section 3(m). This would clearly indicate that the exception carved out in Section 3(m) would act as an independent category and has to be considered and dealt with as a separate and distinct objection, not to be mixed or conflated with steps or tests of novelty and/or inventive step. It is trite that exceptions are to be tested on their own objectivity when examined in the backdrop of the objects and reasons for promulgation of an enactment. Thus, the objections under sub-section (m) of Section 3 of the Act are independent of the tests required for determining novelty and/or inventive step and cannot be viewed with the same prism.

12. It is also relevant to examine the fourth exception - “method of playing game”. Learned Amicus is right to submit that while playing a game may involve something physical or tangible like a human moving a chess piece on the chess board, the method itself for playing the game is quite abstract. He is yet again right that Parliament by a deliberate provision, while pairing “mental acts” with “method of playing game” intended to exclude a genus of activities under Section 3(m). The edifice appears to be the conundrum that abstract rules or methods operate in the realm of logic and cognition, rather than upon physical matter. That is precisely what the Legislature sought to resolve by exclusion.

13. However, while applying Section 3(m), it would be relevant to focus on the claim in the invention. One has to be careful not to dissect the claim into its individual components while applying Section 3(m), inasmuch as the protection conferred by the Patent Act is defined and dependent upon the entire claim and not its individual parts.

14. At this juncture, it would be apposite to consider the judgements rendered by this Court in the above context. In ***Koninklijke Philips N.V. vs. Maj (retd) Sukech behl & Anr.: 2025 SCC Online Del 1121*** held that a method involving physical means, producing a tangible output, and requiring technical implementation that cannot be performed mentally, falls outside the scope of Section 3(m) of the Act. Similarly, in ***Lava International Ltd. vs. Telefonaktiebolaget LM Ericsson: 2024 SCC Online Del 2497*** observed that claims involving hardware and software components working together to measure, evaluate, signal, and control handover parameters in a mobile radio system are beyond the scope of mere mental acts. The Madras High Court in

Robert Bosch Limited vs. Deputy Controller of Patents and Designs in CMA(PT) 1/2024 decided on 25.03.2025 did consider a situation emanating from objections under Section 3(m) of the Act, however did not prescribe any test or standard. The matter was remanded for denovo consideration by the Deputy Controller.

15. Learned Amicus had assisted this Court in bringing to its notice judgements of EPO Boards of Appeal under Article 52(2)(c) EPC for gauging the instructive observations rendered therein. The opinion gathered by this Court on those decisions is as under:

"(a) In T 914/02 (General Electric), the Board held that for the exclusion to be overcome, the claim must recite a technical implementation, resulting in the method providing a tangible, technical effect, such as the provision of a physical entity or a "non-abstract activity".

(b) In T 619/02 (Quest International) the Board held that a claim will not be excluded where the method "involves physical activities, i.e., activities in the physical world", contrasting it with the "abstract nature" of mental acts excluded by the statute. The invention was held not to be a "mental act" even though part of the method involved a human and mental act; the method was assessed as a whole.

(c) Although the language in T 471/05 (Philips) is less precise, the judgment holds that what is intended to be excluded are "purely abstract and conceptual implementations", as opposed to a "technical activity or a technical entity" or "physical" activity or entity". It reiterates that a method claim may be excluded if the method is not confined to physical, technical implementations."

16. It is in the aforesaid context that guidelines for determining the objections under sub-section (m) of Section 3 of the Act, are proposed as under:

GUIDELINES FOR EXAMINATION UNDER SECTION 3(m) OF THE PATENTS ACT, 1970

The examination of a claim as to whether it is excluded as "a mere scheme or rule or method of performing mental act" under Section 3(m) shall proceed in accordance with the following steps:

Step 1: Construe the claim: Construe each claim in the light of the specification, as it would be understood by a person skilled in the relevant art, without importing limitations from the specification into the claim (See *Canva Pty Ltd & Ors. vs Rxprism Health Systems Private Limited & Anr.* 2026:DHC:659-DB at paras 105- 111).

Step 2: Product claims are not hit by Section 3(m): A claim that is, in substance, a genuine product claim, such as an apparatus or device defined by its physical features, is not a 'scheme, rule or method' and cannot be objected to under Section 3(m).

Step 3: Identify what is monopolised: For a process claim, identify what the claim, read as a whole, monopolises. A claimed method shall not be excluded by dissecting the claim into its individual steps and isolating one step that involves a

mental act. The protection conferred is defined by the entire claim, and the exclusion is assessed on the claim as a whole.

Step 4: Apply the exclusion:

(a) Ask whether that monopoly is nothing more than a mental act. The operative question is not whether the claimed method could theoretically be performed in the mind, but whether the claim language, and the monopoly it confers, amount to nothing more than a monopoly over a mental act. As a practical test, ask whether the claim, as construed, could be infringed by a person doing nothing but thinking, reasoning, calculating, judging or deciding. If it could, the claim monopolises a mental act and is excluded.

(b) Section 3(m) is not attracted where the claim, read as a whole, satisfies any one of the following (See, *Koninklijke Philips N.V. v. Maj (Retd.) Suresh Behl & Anr.*, 2025 SCC OnLine Del 1121, para 133; *Lava International Ltd. v. Telefonaktiebolaget LM Ericsson*, 2024 SCC OnLine Del 2497, para 395; *Robert Bosch Ltd. v. Deputy Controller of Patents & Designs*, CMA(PT) 1/2024, order dated 25.03.2025, paras 5–7):

- (i) the claim recites physical means integral to the performance of the method; or
- (ii) the claim requires the interaction of physical components, including hardware operating together with software, to achieve a practical result; or
- (iii) The performance of the claim results in a tangible output or product.

Step 5: Token additions: On the other hand, it is not sufficient that a claim refers to physical objects, or names a physical field of use. The physical means must be integral to, and used in, the actual performance of the claimed steps. A nominal, token or post-solution physical step, such as displaying, presenting or printing, shall not take a claim outside Section 3(m) where the substance of the monopoly, read as a whole, remains a mental act.

Step 6: No conflation with novelty and inventive step: The Section 3(m) inquiry is directed solely at what the claim monopolises; it is independent of the novelty and inventive-step requirements of Sections 2(1)(j) or 2(1)(ja) and must not be conflated with them. A claim is not excluded under Section 3 merely because the claimed invention appears to be an obvious or trivial advance (See, *Novartis v. UOI*, (2013) 6 SCC 1, paras 77, 83–87).

Step 7: Separate from Section 3(k): Where the claim recites that the method is performed by a computer or computer programme, Section 3(m) is not attracted on that ground; the claim shall instead be separately examined under Section 3(k).

Illustrations

Illustration (a) A method of solving a Sudoku puzzle by logical deduction. No physical means, apparatus, computer or tangible output is recited. Read as a

whole, the monopoly extends to the logical deduction itself, which is entirely an act of the mind; the claim could be infringed by a person doing nothing but thinking. **Excluded under Section 3(m).**

Illustration (b) Same as Illustration (a), with the added claim element that the solution, once deduced, is printed on paper. Although the claim now recites a physical step, that step is a mere token, post-solution activity, not integral to the performance of the method. **Excluded under Section 3(m).**

Illustration (c) A method of identifying the optimum arrangement of fuel bundles in a nuclear reactor core, comprising evaluating candidate arrangements and selecting the arrangement that minimises a given parameter. Although the claim refers to a reactor core and to fuel bundles, the operative steps, being evaluating and selecting, are analytical steps. The claim requires no physical loading, measurement or apparatus for their performance; the reactor core is the subject of the analysis, not a means of performing it. Read as a whole, the monopoly is over an analytical exercise capable of being carried out in the mind.

Excluded under Section 3(m). (This illustration reflects the claim refused in *T 914/02 (General Electric) before the EPO Boards of Appeal.*)

Illustration (d) A method of preheating fuel in a combustion engine, comprising sensing engine parameters by sensors, heating the fuel by a fuel-heating device, and controlling the engine by an engine control unit. Read as a whole, the claim recites physical means, such as sensors, a fuel-heating device and an engine control unit, which are integral to the performance of the method, and the method physically heats fuel and controls an engine. The monopoly extends to a physical process and monopolises no mental activity. **Not excluded under Section 3(m).**

Illustration (e) A method of converting information words into a modulated signal, comprising processing the information words through circuits, buses and a modulator, and writing the modulated signal onto a record carrier. The claim recites tangible components, such as circuits, buses and a modulator, integral to its performance, and produces a tangible output, namely a signal written onto a record carrier. Read as a whole, the monopoly extends to a physical process and monopolises no mental activity. **Not excluded under Section 3(m).**

Illustration (f) A method of determining an optimal circuit-board layout, performed by a computer programmed to simulate electromagnetic interference by finite-element analysis and to produce a layout file. Because the performance of the claimed method requires a computer, the monopoly is not over a mental act as such, and Section 3(m) is not attracted. The claim is computer-implemented; the examiner shall not dispose of it under Section 3(m), but shall separately examine it under Section 3(k). **Not excluded under Section 3(m).**

17. These may be suitably placed before the Controller General of Patents and Designs, Delhi for appropriate steps to be undertaken within a period of 6 weeks from receipt of this order.

18. Before parting, this Court would be failing if it does not place its deep appreciation of the time, efforts and extreme dedication of the Amicus Curiae Mr Adarsh Ramanujan in assisting, collating and furnishing the unbiased and practical report on the tests to determine the objections under section 3(m) of the Act. This Court also places on record its appreciation of the efforts invested by the able team of Mr Ramanujan. Mr Vineet Rohilla and Mr. Subhrodeep Saha, learned counsel for the parties too assisted the Court in formulation of points of determination and final output.

19. Since the appeal was disposed of on merits *vide* order dated 26.02.2026 and was kept pending only for the purposes of framing guidelines, now that the guidelines have been finalised, with the fond hope that the aforesaid humble attempt provides the Patent Office as also the patentees some guiding principles in testing/evaluating the objections under section 3(m) of the Patent Act, 1970, the appeal is finally closed.