



(T)CMA(PT) No.184 of 2023

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 22.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT) No.184 of 2023
(OA/SR.1/2021/PT/CHN)

Nripendra Kashyap
Constituted Attorney of
BlackBerry Limited
2200, University Avenue East
Waterloo, Ontario N2K 0A7
Canada

... Appellant

Vs

Assistant Controller of Patents & Designs
Intellectual Property Building
G.S.T. Road, Guindy
Chennai - 600 032

... Respondent

Prayer : Civil Miscellaneous Appeal filed under Section 117(A) of the Indian Patents Act, 1970, praying for setting aside the impugned order dated 01.09.2020 in respect of Application No.2600/CHENP/2012 passed by the respondent and for granting patent on Indian Patent Application No.2600/CHENP/2012.



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For Appellant : M/s.Archana Shankar
N.C.Vishal
N.Shrivatsav
for M/s.Anand and Anand

For Respondent : Mr.S.Janarthanam, Sr. Panel Counsel

JUDGMENT

Having lost his application for patenting his invention titled '*Reference Signal Design for Downlink High-Order Mimo*' essentially under Secs.10(4) and 59 of the Patent Act, the applicant before the Patent Office is now before this court with this appeal.

2.1 The facts are :

- The appellant's invention relates to cellular communication systems. More specifically, this application relates to reference signal design in a cellular network that supports both legacy and current mobile systems. Along with the application, the appellant has made 20 claims of which 3 are its independent claims and the rest are its dependent claims. The Controller responded to the same with his FER wherein he had raised objections under Secs.2(1)(j) and 2(1)(ja) for which he relied on six



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citations in D1 to D6, and under Sec.10(4) for lack of clarity and conciseness. The appellant responded to the same, amended the claims and brought it to 17 claims from 20 claims of which two are stated to be independent claims.

- This was followed by a hearing notice wherein the Controller dropped his objection under Sec.2(1)(j) but included Sec.59. He relied on the same set of citations in D1 to D6. The appellant has participated in the hearing and also filed his written submissions. He has also filed certain amendments to bring it to infuse his independent claim with a degree of clarity in the fond hope that the Controller might understand the same.

2.2 The Controller would now choose not to allow the amendment, as according to him it lacked the clarity required within the meaning of Sec.10(4) of the Act and also proceeded to hold that it is in excess of original specifications within the meaning of Sec.59 of the Act and hence this appeal.

3. The learned counsel for the appellant made her candid statement vis-a-vis the quality of the order of the Controller and argued that nowhere the Controller had explained how and why the amendment which the appellant wanted to



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introduce during hearing lacked clarity or how exceeded the original specification as to invite the application of Sec.59 of the Act. She also provided a tabular column indicating both the nature of the original claim and also the amended claim and the same is reproduced hereunder:

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Indian Patent Application No. 2600/CHENP/2012

<u>ORIGINAL CLAIM 1</u>	<u>AMENDED Claim 1</u>
	<u>(Refused)</u>
A method of operation of a MIMO transmitter, in a cellular network supporting both legacy standard-compliant mobile terminals and next generation standard-compliant mobile terminals,	A method of operation of a MIMO transmitter, (14, 15), in a cellular network supporting both legacy standard-compliant mobile terminals and next generation standard-compliant mobile terminals, (16),
said method comprising:	said method comprising:
defining a matrix of resource blocks within an information channel of said cellular network,	defining identifying a matrix plurality of resource blocks within an information communication channel of said cellular network,
wherein each resource block corresponds to a region of subcarriers of a transmission timeslot at a given frequency subband;	wherein each resource block corresponds to a region of subcarriers of a transmission timeslot at a given frequency subband;
assigning a first set of reference signals (RSs) for said legacy standard compliant mobile terminals to	assigning periodically transmitting a first set of reference signals (signals, RSs), for said legacy



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<u>ORIGINAL CLAIM 1</u>	<u>AMENDED Claim 1</u>
	(Refused)
resource blocks at specific locations within said matrix to be transmitted by said MIMO transmitter, said specific locations being defined by said legacy standard; and	standard-compliant mobile terminals <u>to at a first set of time and frequency resources within said plurality of</u> ~~[Para 0074] resource blocks at specific locations within said matrix to be transmitted by said MIMO transmitter, using a first period; said specific locations~~ <u>first set of time and frequency resources</u> being defined by said legacy standard; and
assigning a second set of RSs for said next-generation standard compliant mobile terminal to other resource blocks within said matrix to be transmitted by said MIMO transmitter.	~~assigning~~ <u>periodically transmitting</u> a second set of RSs for said next-generation standard -compliant mobile terminals ~~to other~~ <u>at a second set of time and frequency resources within said plurality of resource blocks within said matrix to be transmitted by said MIMO transmitter.</u> <u>using a second period, wherein the second period is configured to be different from the first period.</u>

4. When this court compared the right hand side column with the left hand side column, this court finds that the nature of amendment made was essentially cosmetic in the sense the appellant essentially has tried to substitute one word with another word. For instance, in one place, the appellant has substituted information channel with communication channel. This court is aghast that the Controller's problem appears to be one in comprehending English and hence he appears to struggle in understanding the science behind the invention. In other



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words, the Controller appears to be far too fastidious about the choice of expression an inventor shall use rather than trying to understand the substance which the expression he used to convey. It appears most Controllers approach their examination process with some preconception. To compound the problem for the inventor Patent Controllers essentially are habituated to write non-speaking orders. This is not the way a Controller shall deal with an inventor's scientific quest. Here is the classic example where the Controller was cryptic in making a two line statement to reject an invention. It is high time, the concerned Ministry educate the Controllers on the art of writing an order, and also ensure that they are not only qualified in the chosen field of science but also have a reasonable acquaintance with the English language. This court may sound bit harsh, given its experience with the quality of orders, but this court to considers it to be essentially just.

5. In conclusion, this court allows the civil miscellaneous appeal and sets aside the impugned order of the respondent dated 01.09.2020 made in Indian Patent Application No.2600/CHENP/2012 and remands the matter back to the Controller for a *de novo* consideration. To save embarrassment to the Controller who passed the impugned order, this court, now requires some other



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controller to consider appellant's application for grant of patent. Since the application was filed during 2011, this court directs the controller, who would now be in-charge of the issue to dispose of the matter, as expeditiously as possible, at any rate not later than six months from the date on which he takes cognizance of the issue. No costs.

22.03.2024

Asr

Index: Yes/No

Speaking Order / Non-Speaking Order

Neutral Citation: Yes / No

To

The Assistant Controller of Patents and Designs
Government of India, Patent Office
Intellectual Property Rights Building
GST Road, Guindy
Chennai - 600 032



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