



WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 20.11.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(PT)/42/2023
(OA/21/2020/PT/CHN)

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

... Appellant

-vs-

The Assistant Controller of Patents
Intellectual Patent Office,
Property Building, G.S.T. Road,
Guindy, Chennai 600 032.

... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) is filed under Section 117-A of the Indian Patents Act, 1970, praying to set aside the order dated 26.12.2019 of respondent refusing the grant of the Indian Patent Application No.8984/CHENP/2012 dated 19.10.2012 in the name of Blackberry Limited.

For Appellant : Ms.Archana Shanker,



WEB COPY



Mr.N.C.Vishal,
Mr.K.Premchandrar,
for M/s.Anand and Anand
For Respondent : Mr.S.Diwakar, SPC

JUDGMENT

The appellant challenges an order dated 26.12.2019 by which Indian Patent Application No.8984/CHENP/2012 was rejected.

2. The above mentioned application was in respect of a claimed invention entitled "Solving Character Display Ambiguities". Pursuant to the examination, the First Examination Report (FER) was issued on 27.04.2018. In the FER, objections were raised by citing prior art document D1 on the grounds of lack of novelty, inventive step, unity of invention and Section 3(k) of the Patents Act, 1970 (Patents Act). A response was issued to the FER on 16.10.2018. Thereafter, the hearing notice was issued and a hearing was scheduled on 15.10.2019. In the hearing notice dated 13.09.2019, objections were raised under Section 2(1)(j) on the ground that



WEB CODE

amended claims 1 to 12 lack inventive step in view of documents D1 to D4. In addition, an objection was raised under Section 59(1) of the Patents Act. Pursuant thereto, the appellant filed written submissions on 28.10.2019. In the said written submissions, the appellant pointed out the differences between the claimed invention and the cited prior art. Eventually, by the impugned order, the Assistant Controller held that all the features of the amended claims were anticipated by the prior art documents D1 to D4. The present appeal arises in the said facts and circumstances.

3. Learned counsel for the appellant submitted that the claimed invention is a method for solving character display ambiguities. She further submitted that the claimed invention provides a solution for identifying language specific characters based on the relevant country code. She also pointed out that the claimed invention would not be obvious to a person skilled in the art and that no new signaling or new network is required to operate the claimed invention. As regards the prior art document D1, learned counsel submitted that it



WEB COM

pertains to the field of message translation and that it addresses a completely different technical problem. As regards the prior art document D4, she submitted that it provides for multiple character sorting based on the number of strokes and that it is completely different from the claimed invention. Learned counsel also submitted that the objection with regard to novelty / anticipation was not raised in the hearing notice. The last submission of learned counsel was that prior art documents D1 to D4 were considered and rejected by the European Patent Office while granting the patent.

4. Mr.S.Diwakar, learned SPC, submits that the application was rejected by taking into account prior art documents D1 to D4.

Without making any concession on the merits of the case, he submits that the matter may be remanded for re-consideration.

5. The impugned order sets out the objections raised in the hearing notice. On perusal thereof, it is evident that no objection



WEB COPY

with regard to novelty / anticipation was raised therein. However, in paragraph 11 of the impugned order, the Assistant Controller has concluded that all the features of the amended claims were anticipated in the prior art documents, D1 and D4. As discussed earlier, learned counsel for the appellant submitted that the two key prior art documents discussed in the impugned order address and resolve a different technical problem. She also submitted that the claimed invention solves character display ambiguities by identifying language specific characters based on the country code. There is no discussion in the impugned order with regard to such submissions, in spite of the fact that written submissions were filed by the

appellant on 28.10.2019. Therefore, the impugned order is not sustainable and is, hereby, set aside.

6. Consequently, Indian Patent Application No.8984/CHENP/2012 is remanded for re-consideration on the following terms :



WEB COPY

(i) In order to preclude the possibility of pre-determination, an officer other than the officer who issued the impugned order shall undertake re-consideration.

(ii) After providing a reasonable opportunity to the appellant, a reasoned decision shall be issued within a period of *four months* from the date of receipt of a copy of this order.

(iii) It is made clear that no opinion is expressed herein on the merits of the application.

7. (T)CMA(PT)/42/2023 is disposed of on the above terms without any order as to costs.

20.11.2023

rna

Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes / No



WEB COPY



SENTHILKUMAR RAMAMOORTHY,J

rna



WEB COPY



(T)CMA(PT)/42/2023
(OA/21/2020/PT/CHN)

20.11.2023