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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 19.09.2023

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

CMA(PT)/6/2023
and C.M.P.No.15812 of 2023

HUAWEI TECHNOLOGIES CO., LTD
Huawei Administration Building,
Bantian, Longgang District, Shenzhen,
Guangdong - 518129, P.R.China
Represented by its Constituted Attorney /
Authorised Signatory, Nripendra Kashyap.

... Appellant

vs.

The Controller of Patents,
The Patent Office,
Intellectual Property Office Building,
GST Road, Guindy,
Chennai - 600 032.

...Respondent

PRAYER: Civil Miscellaneous Appeals (Patents) filed under Section 117-A of the Patents Act, 1970, praying to set aside the orders dated 13th December 2021 passed by the respondent in Patent Application 201947029757 and consequently direct the respondent to restore the appellant's patent for further prosecution.



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For Appellant : Mrs.Archana Shanker
Mr.N.C.Vishal, Mr.Abhishek Kumar

For Respondent : Mr.S.Janarthanam, SPC

JUDGMENT

The appellant assails an order dated 13.12.2021 by which Patent Application No.201947029757 was rejected. The said application was the PCT National Phase application.

2. Upon examining of the application, the First Examination Report (FER) was issued on 21.12.2020 raising several objections. The appellant replied thereto on 10.03.2021 and submitted amended claims. In the Second Examination Report (SER) issued on 23.04.2021, the following objections were raised:

"Clarity and Conciseness

- 1. The method claims shall be numbered properly in order.*



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2. *Claim 6 is claiming for a computer-readable storage medium that stores softwares instructions/computer program which are intangible entities not allowable for patents under the Indian Patents Act hence the claim 6 is not allowable under the Indian Patents Act, 1970 (as amended).*
3. *Only one application claims is allowable out of claim 5 and 11.*
4. *The claim 11 cannot be allowable in the current form.*
5. *The method claims shall be given in clear method steps."*

3. In response thereto, the appellant, once again, amended its claims. The impugned order was issued in these facts and circumstances. Such order was sought to be reviewed by filing a review application on 13.01.2022. The said review application was rejected on 20.04.2022. Hence, this appeal.

4. Learned counsel for the appellant invited my attention to the SER and to the amended claims submitted in response thereto. She



submitted that the objections raised in the SER were effectively addressed by changing Claim 6 from a computer-readable storage medium (product claim) to a method claim and by deleting Claim 11. In spite of doing so, she submitted that the patent application was rejected on the ground that the appellant had not submitted proper method claims in sequential order and on the ground that in Claim 10, a claim for a communication system was made which did not meet the requirements of an invention.

5. In response to these contentions, Mr.S.Janarthanam, learned SPC, invited my attention to the SER and submitted that the appellant failed to meet the objections raised in the SER. He further submitted that the appellant did not provide any clarity as regards the method claims. Therefore, he submitted that the impugned order does not call for interference.

6. The impugned order sets out the history of prosecution of the patent application across multiple pages before recording the findings and conclusions. The operative portion of the order is set out below:



"The applicant's agent has not shown any interest to meet the objections raised in the SER, with utter disregard to the discussion happened during the hearing and objections taken, he has failed to meet the following requirements:

- a) The method claims in sequential order i.e claims 1-4 and claims 5-9 as per objection 1 under clarity.*
- b) The objections 3 & 4 under clarity.*
- c) The objection 5 regarding claim 9.*
- d) The present claim 10, instead of claiming as an application claim, a communication system was claimed without having any invention in it.*

Finally the applicant's agent has failed to meet the requirements of the Patents Act informed vide this office Subsequent Examination Report dated 23rd Apr 2021 even after giving the opportunity of the hearing and ample scope for rectifying with utter disregard to what was discussed/agreed during the hearing."

7. From the above operative portion of the order, it is abundantly clear that the patent application was not dealt with on merits. Instead, the Controller of Patents has assigned the following three reasons for



rejecting the application:

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(i) The appellant failed to submit the method claims in proper form by disregarding the discussion during the hearing.

(ii) The appellant failed to provide clarity regarding sequential order of the method claims.

(iii) The present Claim 10 does not meet the requirements of an invention.

8. By examining the objections raised in the SER and the amended claims submitted in response thereto, all the claims were revised and Claim 11 was deleted by the appellant in response to the SER. In these circumstances, the rejection of the application on the ground that the method claims were not presented in proper form is untenable. Even if there were procedural lapses with regard to the numbering of such claims, the appellant could have been called upon to remedy the same and such procedural errors do not justify the rejection of the patent application. Therefore, the impugned order is, hereby, set aside and the matter is remanded for reconsideration. Such reconsideration shall be undertaken on the following terms:



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(i) An officer other than the officer who issued the impugned order shall consider the appellant's application so as to preclude any possibility of pre-determination.

(ii) Such reconsideration shall be limited to objections already raised.

(iii) The appellant shall be permitted to make amendments as regards clerical / typographical errors in the amended claims.

(iv) A reasoned decision shall be issued within a period of *six months* from the date of receipt of a copy of this order after providing a reasonable opportunity to the appellant.

(v) Consequently, the connected miscellaneous petition is closed.

19.09.2023

Index : Yes/No
Internet : Yes/No
Neutral Citation : Yes/No
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