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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)/5/2023
and C.M.P.No.15804 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 October 28, 2021 passed by the respondent in Patent Application 201947017802 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 28.10.2021 by which Patent Application No.201947017802 was rejected. The said application was the PCT National Phase application.

2. Upon examining the application, the First Examination Report (FER) was issued on 05.10.2020 raising several objections. The appellant replied thereto on 03.12.2020 and submitted amended claims. In the Second Examination Report (SER) issued on 05.02.2021, the following objections were raised:

"Clarity and Conciseness

1. The device claims 17-24 are simply



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implementing the steps of the method claims 1-8 by virtue of various software modules executing the computer program stored in the memory to perform the method step operations. Hence the device claims 17-24 cannot be allowed under the Indian Patents Act, 1970 (as amended). The objection is maintained.

2. The device claims 25-32 are simply implementing the steps of the method claims 9-16 by virtue of various software modules executing the computer program stored in the memory to perform the method step operations. Hence the device claims 25-32 cannot be allowed under the Indian Patents Act, 1970 (as amended). The objection is maintained.

3. The alleged invention may / may not lie only in the method hence the non-method claims 17-33 are not allowable. The objection is maintained."

3. In response thereto, the appellant, once again, amended its claims. In particular, the appellant deleted all the device claims, i.e., claims 17 to 32. The impugned order was issued in these facts and



circumstances. Such order was sought to be reviewed by filing a review application on 22.11.2021. The said review application was rejected on 18.04.2022. Hence, this appeal.

4. Learned counsel for the appellant invited my attention to the SER and to the amended claims submitted in response thereto. Except for a typographical / clerical error whereby claim 16 was repeated, she submitted that the objections raised in the SER were effectively addressed by deleting the claims to which objections were raised. 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 and had instead reproduced the earlier method claims.

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 filed Form - 3 belatedly, and refused to file a petition to condone the delay in filing the said Form. Therefore, he submitted that the impugned order does not call for interference.



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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:

"In view of the objection on the method claims, during the hearing the applicant's agent has agreed to make the method claims in proper method steps form as per the discussion happened. With utter disregard to the discussion happened during the hearing the applicant's agent has simply reproduced the previous method claims 1-16 in verbatim on which this office has taken objection. In spite of discussion on the method claims during the hearing the applicant's agent has failed to utilise the opportunity given during the hearing for amending the claims instead the previous claims were reproduced simply.

The applicant's agent has not shown any interest to check the 2 application claims numbering before filing in the Patent Office.

The applicant has filed Form-3 dated 8th Nov 2019 regarding the foreign filing details beyond the time on 2nd Dec 2019. An objection has been raised in the FER in this regard. This



office has raised the objection regarding Form-3 filed 2nd Dec 2019. The applicant without properly checking the details was talking about the Form-3 filed on 3rd Dec 2020. Since applicant has failed to file the petition for the delay in filing the Form-3 the objection was maintained again in the subsequent report dated 5th Feb 2021. In the hearing also the objection was reiterated the applicant's agent has agreed to file the petition for the delay in filing the Form-3. But in the final reply filed on 31st Mar 2021 the applicant's agent irresponsibly talking again about the Form-3 filed on 3rd Dec 2020 instead of objection raised on the Form-3 filed on 2nd Dec 2019 and failed to file the petition required causing revenue loss to the Government."

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 two reasons for rejecting the application:

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



(ii) The appellant failed to file a petition to condone the delay in filing Form - 3.

8. By examining the objections raised in the SER and the amended claims submitted in response thereto, it is evident that all the device claims running from claims 17 to 32 were deleted by the appellant in response to the SER. While doing so, a typographical / clerical error crept in whereby claim 16 was repeated. 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. The other reason cited in the order, namely, the non filing of a petition to condone the delay in filing Form - 3 certainly does 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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