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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

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Date of decision: 23rd April, 2025+ **C.A.(COMM.IPD-PAT) 125/2022****BLACKBERRY LIMITED**

.....Appellant

Through: Ms. Reetika Ahuja, Mr. Achyut
Tewari, Mr. Aayush Maheshwari &
Ms. Krisha Baweja, Advocates.

versus

**ASSISTANT CONTROLLER OF
PATENTS AND DESIGNS**

.....Respondent

Through: Mr. Arnav Kumar, CGSC with
Ms.Gitanjali Vohra, Advocates.

CORAM:**HON'BLE MR. JUSTICE AMIT BANSAL****AMIT BANSAL, J. (Oral)**

1. The present appeal has been filed under Section 117A of the Patents Act, 1970 (hereinafter 'the Act') and is directed against impugned order dated 31st July, 2019 passed by the Assistant Controller of Patents & Designs (hereinafter the 'Controller'), whereby the Indian Patent Application No. 1071/DEL/2007 titled "*METHOD AND SYSTEM FOR SIGNALING RELEASE CAUSE INDICATION IN A UMTS NETWORK*" (hereinafter the 'subject patent application') has been refused under Section 15 of the Patents Act.



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2. The appellant filed the subject application relating to radio resource control between User Equipment (UE) and Universal Terrestrial Radio Access Network (UTRAN), and in particular to the release of an existing signaling connection in a UMTS network on 17th May, 2007 at the Patent Office, New Delhi.
3. The respondent had issued First Examination Report (hereinafter “FER”) on 18th June, 2015, raising various objections against the subject application, which are as follows:
 - i. Lack of novelty and inventive step under Section 2(1)(j) of the Act.
 - ii. Not patentable under Section 3(k) and Section 3(m) of the Act.
 - iii. Lack of clarity and unity under Section 10(4)(c) and 10(5) of the Act.
 - iv. Suppression of information under Section 8 of the Act.
4. The appellant had filed a detailed response addressing the objections raised in the FER on 20th October, 2015.
5. Thereafter, the respondent issued a hearing notice on 26th April, 2018 containing the following objections:
 - i. Lack of novelty and inventive step under Section 2(1)(j) of the Act.
 - ii. Not patentable under Section 3(k) and Section 3(m) of the Act.
 - iii. Lack of clarity under Section 10(5) of the Act.
 - iv. Amendment in claims not allowed under Section 57 and Section 59 of the Act.
6. Subsequently, a hearing was conducted on 8th May, 2018 and written



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submissions were filed by the appellant along with amended claims on 22nd May, 2018.

7. The Controller, *via* the impugned order, rejected the subject application under Section 2(1)(j), Section 3(k), Section 3(m) and Section 8 of the Act without considering the proposed amendments filed by the appellant. According to the Controller, the proposed amendments did not comply with the requirements under Section 57 and 59 of the Act. The operative part of the impugned order dealing with the proposed amendments of the appellant is set out below:

“Under Section 57 & 59 Of The Indian Patent Act 1970

The subject matter of the claims are not supported by the description and drawings. Agent of the Applicant silent on the objection related to section 57 & 59 of the Indian Patent Act 1970 as amended.”

[Emphasis supplied]

8. It is the case of the appellant that the amendments are in the nature of correction or explanation and are supported by the as-filed specification. Therefore, the amendments are within the scope of Section 59 of the Patents Act. In this regard, reliance has been placed by the appellant on ***Allergan Inc. v. Controller of Patents***, 2023 SCC OnLine Del 295.

9. A perusal of the impugned order would show that the Controller proceeds to refuse the proposed amendments on the basis that the amendments are not within the scope of Sections 57 and 59 of the Act. However, the Controller has not given any reasoning as to how the proposed amendments are beyond the mandate of Sections 57 and 59 of the Act.

10. It is a settled legal position that the amendments are permitted if they



are in the nature of correction, disclaimer or explanation, and for addition of actual facts, provided they remain within the scope of the pre-amended specification and claims. Reference in this regard may be made to *Nippon A & L Inc. v. Controller of Patents*, 2022 SCC OnLine Del 1909, which is followed by this Bench in *Abbvie Biotherapeutics INC v. Controller of Patent Designs*, 2025 SCC OnLine Del 2384.

11. There is no discussion or reasoning in the impugned order as to whether the amendments are within the scope of Section 59(1) of the Act. The proposed amendments have been rejected in a cryptic manner.

12. At this stage, reference may be made to the judgment of a Coordinate Bench of this Court in *Agriboard International LLC v. Deputy Controller of Patents and Designs*, 2022 SCC OnLine Del 940. The relevant observations are set out below:

“23. The said reasoning has been reiterated by the Supreme Court in Manohar v. State of Maharashtra & Ors. AIR 2013 SC 681 wherein it has been categorically observed that application of mind and recording of reasoned decision are the basic elements of natural justice. There can be no doubt that scrupulous adherence to these principles would be required while rejecting patent applications.”

[Emphasis supplied]

13. The aforesaid judgement in *Agriboard* (supra) has been followed by me in *Rosemount Inc. v. Deputy Controller of Patents and Designs* 2023 SCC Online Del 2487 and *The Coca-Cola Company v. The Controller of Patents*, C.A.(COMM.IPD-PAT) 342/2022.

14. In the present case, the appellant had sought to make detailed amendments in the claims to overcome the objections of the Controller. Therefore, the Patent Office was required to pass a speaking order analysing



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the proposed amendments filed by the appellant along with post-hearing written submissions.

15. Accordingly, the impugned order is set aside and the matter is remanded back to the Controller for a *de-novo* consideration.

16. The Controller would afford a fresh opportunity of hearing both sides before deciding the subject patent application after giving a hearing notice to the appellant. If any new material comes to the knowledge of the respondent, the same would be put to the appellant in the hearing notice so that the appellant has an opportunity to deal with the same.

17. The Controller shall first examine the proposed amendments filed by the appellant, with the post-hearing written submissions and determine whether the same can be permitted in terms of Sections 57 and 59 of the Act.

18. Based on the said decision, the Controller shall proceed to deal with other objections under Sections 2(1)(j), 3(k), 3(m) and 8 of the Act.

19. The appeal is disposed of in the aforesaid terms.

20. The Registry is directed to send a copy of the present order to the office of the Controller General of Patents, Designs and Trade Marks at the e-mail - *llc-ipo@gov.in* for compliance.

AMIT BANSAL, J

APRIL 23, 2025
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