2023:MHC:3916

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **25.08.2023**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(PT)/75/2023
(OA/19/2021/PT/CHN)

Nokia Technologies OY
a Corporation organized and existing
under the laws of Finland, of Karakaari 7,
02610 Espoo, Finland ... Appellant

-vs-

Assistant Controller of Patents and Designs
The patent Office
Patent Office, Intellectual Property Building,
G.S.T. Road, Guindy,
Chennai - 600032 ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) filed under Sections 117(A) of the Patents Act, 1970, prays to (1) an order setting aside the impugned order dated October 08,2020 passed by the Respondents; and (2) an order granting a patent on Indian Patent Application No. 2359/CHENP/2010 in favour of the Appellant.

For Appellant : Ms.Archana Shanker
Ms.Shraddha Singh Chauhan
N.C.Vishal and Srivatsav
for M/s.Anand and Anand

For Respondent : Mr.C.Samivel, SPC

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JUDGMENT

The appellant applied for grant of a patent in respect of a system and method for listening to audio content. The said application was filed on 23.04.2010. Originally, the appellant made 20 claims. The First Examination Report (FER) was issued on 11.08.2016. In the FER, objections were raised. The objections were responded to on 10.02.2017. In order to meet the objections, the appellant amended the claims and submitted 11 amended claims for consideration. Pursuant to a hearing notice dated 13.08.2020, the appellant was heard and the impugned order of refusal was issued on 08.10.2020.

2. Learned counsel for the appellant opened her submissions by pointing out that the European Patent Office granted a patent for this invention. She invited my attention to the original claims, the amended claims and the impugned order. With reference to the impugned order, learned counsel pointed out that only claims 1 to 5 and claims 11 to 14 were objected to. Consequently, it is submitted

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that the patent should have been granted as regards apparatus claims to which no objections were raised. Learned counsel further submits that the impugned order discloses complete non-application of mind inasmuch as there were only 11 amended claims whereas claims 11 to 14 are referred to in the impugned order. This also reveals that the amended claims were not considered while pronouncing the impugned order.

3. As regards the objections on the ground of Section 3(k) of the Patents Act, 1970, learned counsel submitted that the scope of Section 3(k) is limited to computer programmes per se and that Section 3(k) would not inhibit the grant of patents if a technical solution is provided by deploying computer programmes. In support of these contentions, learned counsel placed for consideration the following judgments:

(i) Ferid Allani v. Union of India and Others, order dated 12.12.2019 in W.P.(C)/2014, particularly paragraphs

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10 to 12 thereof (also placed before the Assistant Controller).

(ii) Microsoft Technology Licensing, LLC v. The Assistant Controller of Patents and Designs, 2023:DHC:3342, particularly paragraphs 39 and 40 thereof.

4. If remanded, learned counsel further submitted that the matter should be heard by an officer other than the officer who passed the impugned order. In support of this submission, learned counsel placed reliance on several judgments, including the following:

(i) Art Screw Co. Ltd. v. The Assistant Controller of Patents and Designs, 2022/DHC/005571.

(ii) Dr.Sapna Nangia v. The Assistant Controller of Patents and Designs, 2023/DHC/001283.

(iii) Dolby International AB v. The Assistant Controller of Patents and Designs, 2023/DHC/001854.

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5. In response to these submissions, Mr.Samivel, learned SPC, relied on Section 3(k) of the Patents Act and contended that a computer programme is not an invention in terms of the Patents Act and that, therefore, the impugned order is in order and does not call for interference.

6. According to Mr.Samivel, neither the original claims nor the amended claims satisfy the requirements for patentability. Without making any concession on the merits of the matter, he submits that the matter may be remanded for re-consideration because the impugned order refers to claims 11 to 14, whereas only 11 amended claims were submitted.

7. The operative part of the impugned order is as under:

"Examiner's Observation about

1. claims 1 – 5 of the alleged invention discloses a method for listening to audio content, which refers to an algorithm, as it consists of a set of instructions for controlling a sequence of operations to get the desired

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result. Hence, the same is not patentable u/s.3(k) of The Patents Act, 1970. Without prejudice to any other objections, claims 11 – 14 of the alleged invention discloses a computer program product, which does not have any inventive hardware features and refers to computer program per se as it consists of a set of instructions for controlling a sequence of operations. Hence, the same is not patentable u/s.3(k) of the Patents Act, 1970.

6. The oral argument and the written submission of the agent of the applicant have been carefully considered. However without prejudice, although the hearing submissions have attempted to address the other requirements, yet the substantive requirement of the Patents Act, 1970 i.e. ***Section 3(K)*** *is not found complied with. Deletion of claims containing software instructions in claims clearly signify the invention lied in set of algorithm to which Examiner has pointed out.*

Hence, in view of the above and unmet requirements, this instant application is not found in order for grant Also ***I agree with the findings of the examiner that the***

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subject matter as described and claimed attract the provisions of Section 2(1)(j) of the Patents Act, 1970."

8. On examining the operative part of the order, it is evident that the examiner's observations with regard to original claims 1 to 5 and 11 to 14 are set out therein. In light of the fact that 11 amended claims were submitted in response to the FER and the objections raised therein, it is clear that there was non-application of mind while issuing the impugned order. Besides, after setting out the examiner's observations on the original claims, the impugned order records the conclusion that the substantive requirement of the Patents Act, i.e. Section 3(k) is found not complied with. Other than setting out the said conclusion, the Assistant Controller of Patents and Designs has not considered the response of the appellant to the FER or the submissions made with regard to the scope and ambit of Section 3(k) of the Patents Act. Consequently, the impugned order is unsustainable and is hereby set aside.

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9. As a corollary, the matter is remanded for re-consideration. It is appropriate that such re-consideration is undertaken by an officer other than the officer who issued the impugned order so as to eliminate the possibility of confirmation bias.

10. For reasons set out above, (T)CMA(PT)/75/2023 is disposed of without any order as to costs and without expressing any opinion on the merits by remanding the matter for re-consideration of Application No.2359/CHENP/2010 on the following conditions:

(i) The re-consideration shall be restricted to objections contained in the impugned order.

(ii) Legal submissions, including precedents, on Section 3(k) of the Patents Act shall be considered and dealt with.

(iii) Such re-consideration shall be by an officer other than the officer who issued the impugned order.

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(iv) After providing a reasonable opportunity to the appellant, a reasoned decision shall be pronounced within a maximum period of *three months* from the date of receipt of a copy of this order.

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Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes / No

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