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

\+ C.A.(COMM.IPD-PAT) 275/2022

QUALCOMM INCORPORATED ..... Appellant

Through: Mr. Vineet Rohilla, Mr. Rohit Rangi, Mr. Debashish Banerjee, Mr. Ankush Verma and Mr. Tanveer Malhotra, Advs.

versus

CONTROLLER OF PATENTS AND OTHERS

..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC, Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advs.

CORAM:
HON'BLE MR. JUSTICE C.HARI SHANKAR

JUDGEMENT (O R A L)

% 24.07.2023

1. This appeal under Section 117A of the Patents Act, 1970 challenges the following order dated 31 October 2016 passed by the Deputy Controller of Patents and Designs, whereby Patent Application no. 5159/DELNP/2007 dated 4 July 2007 filed by the appellant for grant of a patent in respect of an invention titled "Minimizing feedback by sending a quality indicator for a non-restrictive reuse set and a vectored quality indicator for other reuse sets" stands rejected.

2. The impugned order reads as under:

"**DECISION**

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The instant patent application No. 5159/DELNP/2007 titled "MINIMIZING FEEDBACK BY SENDING A QUALITY INDICATOR FOR A NON-RESTRICTIVE REUSE SET AND A VECTORED QUALITY INDICATOR FOR OTHER REUSE SETS" was filed on 04/07/2007. Consequent upon filing request for examination no. 4003/RQ-DEL/2007 dated 17/07/2007 and publication dated 17/08/2007, the first examination report was issued on 19/12/2011 with the following major official requirements:

> "1. Subject matter as described and claimed in method claims falls within the scope of sub clause k of section 3 of The Patents Act 1970 as amended by the Patents (Amendment) Act 2005, for being algorithm based method.
>
> 2. Subject matter as described and claimed in claim 24 falls within the scope of sub clause k of section 3 of The Patents Act 1970 as amended by the Patents (Amendment) Act 2005, for being relating to computer program per se.
>
> 3. Without prejudice to objection 1-2. Claims do not sufficiently define the invention. In view of the plurality of the independent set of claims, the nature and scope of the alleged invention is not clearly understood. Subject matter for which protection is sought may be different to that defined by the claims, thereby resulting in a lack of clarity of the claims when the description is used to interpret the claims. The claims should be redrafted to make them sufficiently definitive and Inventive features should be brought out clearly under characterized clause and reference numerals should be supplemented in parenthesis to enhance the intelligibility of Claims and clearly define the scope of the invention, in accordance with section 10(4)(c) of The Patents Act 1970 as amended by the Patents (Amendment) Act 2005. During revision and redrafting, care should be taken not to add any subject matter, which extends beyond scope of the application as originally filed."

The agent of the applicants submitted their response on 19/12/2012. The replies of the applicant were considered and the examiner retained the official requirements mainly on grounds of definitiveness and that under section 3(k) mainly as follows:

> "1. Regarding your observation given for objection No. 1 of FER dated 19.12.2011 is carefully considered but it does not meet the office requirements: Subject matter as described and claimed in method claims fall within the

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scope of sub clause k of section 3 of The Patents Act 1970 as amended by the Patents (Amendment) Act 2005, for falling within the scope algorithm based on method steps. Since the method steps can be implemented using software only and no inventive constructional feature is needed to perform the method steps (i.e. method steps are performed using conventional system). Further the apparatus claimed (claims 21-23) is a conventional apparatus and is based on the method steps, hence said claims fall under section 3(K) for falling within the scope algorithm.

2. Claim 21 recite various means. This claim is not clear in respect of structural features of the said means. Also this claim is not supported by the description. In absence of such structural features the claim is indefinite and do not satisfy the requirement of section 10(4)(c) of the Act. Further claims 21,22 and 23 are not clear as the purpose or object of the claimed apparatus is not mentioned in the preamble of the claims. Further Claims 22 and 23 are mere repetition of claim 21. Hence claims should be redrafted to have a one independent claim in each category."

Keeping in view the provisions of Patent Acts, 1970 and with a view to provide natural justice to the applicant, a hearing was offered to the agent of the applicant on 03/12/2014. Mr Ritam N Rawal appeared from the applicant side during hearing. He submitted the oral and written submissions against the examiner's objection. Therefore, the instant application needs to be disposed off on merit.

The subject matter as described and claimed relates to data transmission in a wireless multiple-access communication system. It's a method of providing feedback to support restrictive reuse in a single-input single-output (SISO) system comprises sending a quality indicator for a non-restrictive reuse set and sending a vectored quality indicator for reuse sets other than the non-restrictive reuse set. *I fully agree with the findings of the examiner that the subject matter as described and claimed attracts the provisions of section 10 and are also attracting the provisions of section 3(k) of the Patent Act, 1970.*

Therefore, keeping in view the above facts and the outstanding official requirements, I hereby refuse to proceed with the instant application and no patent shall be granted in pursuance of this application.

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Dated: 31st October, 2016.

(B P SINGH)
Deputy Controller of Patents and Designs"

(Emphasis supplied)

3. The impugned order acknowledges the fact that responses to the objections raised by the Patent Office were submitted by the appellant on 19 December 2012 and during hearing granted on 3 December 2014. The order makes no reference to the contents of the said submissions; needless to say, there is no finding, either, on the merits thereof. While the Deputy Controller, in the penultimate paragraph of the impugned order, notes his "entire agreement" with the findings of the Examiner – providing no reasons therefor – there is no observation, much less any finding, on the response submitted by the appellant thereto.

4. An order which does not deal with the submissions advanced before the authority passing the order suffers from manifest non-application of mind and is also, that extent, *ex facie* unreasoned. It cannot sustain, either in law or on facts.

5. Orders such as that impugned in the present appeal reduce the exercise of the examination of the patent application, raising of objections thereto, and grant of an opportunity to the applicant to respond to the objects, to an empty paper formality.

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6. Mr. Rohilla, learned Counsel for the appellant further submits that the impugned order erroneously draws attention to the penultimate paragraph of the impugned order which reads thus:

> The subject matter as described and claimed relates to data transmission in a wireless multiple-access communication system. It's a method of providing feedback to support restrictive reuse in a single-input single-output (SISO) system comprises sending a quality indicator for a non-restrictive reuse set and sending a vectored quality indicator for reuse sets other than the non-restrictive reuse set. I fully agree with the findings of the examiner that the subject matter as described and claimed attracts the provisions of section 10 and are also attracting the provisions of section 3(k) of the Patent Act, 1970."

Mr. Rohilla submits that the claim relating to "data transmission in a wireless multiple access communication system", to which the afore-extracted passage eludes was in fact withdrawn by the appellant while amending his claims and that the Deputy Controller, instead of addressing the claim which survived, has apparently returned a finding on the claim which already stood withdrawn.

7. Given this position, Mr. Mishra, learned Counsel for the respondent, is agreeable to the impugned order being set aside and the matter being remanded to the patent office for *de novo* adjudication in accordance with law as well as the provisions of the Patents Act and the Patent Rules and after affording an opportunity of hearing to the applicant/appellant.

8. Accordingly, the impugned order is set aside in the above terms.

9. The adjudicating officer, who would adjudicate on the

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appellant's application is directed to take a decision on the application as expeditiously as possible and positively within a period of two months from today. Hearing shall be granted to the appellant on 31 July 2023.

10. The present appeal stands allowed in the aforesaid terms.

C.HARI SHANKAR, J

JULY 24, 2023/kr

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