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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 12.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

CMA(PT) No.42 of 2023 and
C.M.P. No.28469 of 2023

Business Objects Software Limited
1012-1014 Kineswood Ave City
West Business Campus Dublin 24 ... Appellant

Vs.

The Controller of Patents
The Patent Office
Intellectual Property Office
G.S.T. Road, Guindy
Chennai - 600 032 ... Respondent

Prayer : Civil Miscellaneous Appeal filed under Section 117A of the Patents Act, 1970, as amended by the Tribunals Reforms Act, 2021 to set aside the order dated 28.06.2023 of the learned Assistant Controller of Patents & Designs, Delhi passed in Patent Application No.7583/CHENP/2011.

For Appellant : Mr.Ramesh Ganapathy
For Respondent : Mr.P.Mahadevan, CGSC

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JUDGMENT

This appeal is directed against an order of the respondent refusing to patent an invention of the appellant herein titled 'Transparent Distribution and Module Decoupling Through Asynchronous Communication and Scopes'. The invention relates to systems and methods consistent with the present invention generally relate to decouping modules using asynchronous communication and scopes and it was rejected under Section 2(1)(j) of the Patent Act.

2. The other facts relevant to the issue may now be bullet pointed:

- In its application seeking patent, the appellant had made 19 claims of which the first claim alone is the independent claim. It eventually evoked the FER from the respondent in which the Controller had raised an objection to the grant of patent under Section 2(1)(j) and backed the said objection with two prior arts D1 and D2. This apart, the Controller also raised an objection under Sec.3(k) of the Act. The appellant responded to the said FER.
- While so, the respondent came out with its hearing notice in which he had stuck to the earlier objections raised in FER. The appellant

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participated in the hearing and has also amended its claims and brought them down from 19 to 11.

- The Controller, ultimately chose to reject petitioner's application under Section 2(1)(j) of the Act and this is now under challenge.

3. Heard both sides and perused the materials available on record. The learned counsel for the appellant made the following submissions:

- Both during the oral hearing and the written submissions, the appellant has explained how the objection raised under Sec.2(1)(j) may not be applicable vis-a-vis the invention of the appellant. But the Controller, after cut, copy, pasting of the hearing notice for 9/10th of its order has just left one paragraph, which is non-speaking, to reject appellant's explanation to the objection raised under Section 2(1)(j).
- The appellant has aslo submitted that it has patented its invention at least in three other jurisdictions.
- That the Controller has not applied his mind is also borne out by another fact in the order where he had stuck to the original 19 claims and had not taken into account the amended claims made during hearing of the application.

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4. This court perused the record to ascertain the correctness of the submissions made and here, the appellant scores very heavily over the respondent. The operative portion of the order of the Controller reads that *"the oral agrument and the written submission of the agent of the applicant have been carefully considered, the substantive requirement of the Patent Act, 1970 i.e. Section 2(1)(j) not found complied with. Hence, in view of the above and unmet requirements, this instant application is not found in order for grant"* and as argued by the learned counsel for the appellant, the order refers to the original claims and not to the amended claims, whereas the same have been amended by the appellant in his written submissions.

5. It would have been appreciable if the Patent Controllers are taught how to write an order. Their job may be technical, but it is subjected to judicial review where the court will look for some tangible and objective reason from the Controller to justify his order.

6. Turning to the present case, this court has very little hesitation to hold that the impugned order of the Controller lacks quality, which it should possess to pass the scrutiny in judicial review, and hence this court is constrained to set

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aside order of the respondent.

7. In conclusion, this appeal is allowed and the order of the Assistant Controller of Patents & Designs, Delhi dated 28.06.2023 passed in Patent Application No.7583/CHENP/2011 is set aside and the matter is remanded back to the Controller for a *de novo* consideration. To save embarrassment to the Controller who passed the impugned order, this court, now requires some other Controller to consider appellant's application for grant of patent. This court is informed that the priority application was filed in 2010 and in India it was filed in 2011. Since in the eventuality of the appellant obtaining a patent for its invention, in effect, it may not have effective shelf value of six years and hence the Controller would now be in-charge of the matter is required to dispose of appellant's application within a period of six months from the date on which he takes cognizance. No costs.

12.03.2024

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Index: Yes/No
Speaking Order / Non-Speaking Order
Neutral Citation: Yes / No

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N. SESHASAYEE, J.

Asr

To

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