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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 08.07.2024

CORAM:

THE HON`BLE MR.JUSTICE P.B.BALAJI

CMA (PT) No.32 of 2023

3M INNOVATIVE PROPERTIES COMPANY,
3M Center, P O Box 33427,
Saint Paul MN 55133-3427, USA,
Nationality: US
Rep. by its Power of Attorney,
Mr.Raghavan Ravindran Nair,
De Penning & De Penning, Having Office at
No.120, Velachery Main Road, Guindy,
Chennai - 600 032.

..

Appellant ..Vs.

The Assistant Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai - 600 032.

.. Respondent

Prayer: This Civil Miscellaneous Appeal filed under Section 117-A of the Patents Act, 1970 praying this Court to call for records of the Respondent culminating in the impugned order dated 02.11.2022 rejecting the Grant of Patent and Set Aside the same and consequently direct Grant of the Patent in respect of the Appellant's Application No.201747024977.

For Appellant : Mr.Shivathanu Mohan for
M/s.S.Ramasubramaniam Associates

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For Respondents : Mr.A.R.Sakthivel,
Senior Panel Central Government
Standing Counsel
Mr.Ashlesh Maurya,
(Controller)

JUDGMENT

The appellant has been aggrieved by the rejection of the Patent Application No.201747024977 citing Section 3(k) of the Indian Patents Act, 1970, (in short 'Act') more specifically the claimed invention being a computer program and computer implementable method.

2. I have heard Mr.Shivathanu Mohan, learned counsel for the Appellant and Mr.A.R.Sakthivel, learned Senior Panel Central Government Standing Counsel assisted by Mr.Ashlesh Maurya, learned Controller.

3. Mr.Shivathanu Mohan, learned counsel for the Appellant would take me through the hearing notices and specifically pointed out that the reasons as to why the claims 1 to 10 were not patentable under Section 3(k) of the Act and specifically mentioned as being relatable to computer program and computer implementable method. Thereafter, he would take me through the impugned order, where after discussing the prior arts, the

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learned Controller held that the subject matter of the invention is non technical, mathematical/statistical falls under Section 3(k) of the Act.

4. He would also submit that the Appellant had hidden information in Form -III about refusal of the Patent. In this regard, Mr.Shivadhanu Mohan, learned counsel would submit that before the impugned order was passed, the appellant had filed revised Form-III, where it was brought to the respondent's notice that the EP Patent Application had been abandoned and this was not considered by the respondent/Controller while passing the order of rejection. He would therefore pray for the matter being remitted for fresh consideration.

5. The learned counsel for the respondent assisted by the learned Controller would submit that the definition under Section 3(k) of the Act is wide enough and not limited to a computer program alone. Therefore, he would justify the refusal of the Application of the appellant.

6. I have heard the rival submission advanced by the learned counsel on either side and perused the materials available on record.

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7. The only ground on which the appellant's Application has been rejected is citing Section 3(k) of the Act. Section 3 deals with the what are not inventions within the meaning of this Act and Section 3(k) is as follows:

(k) a mathematical or business method or a computer programme per se or algorithms;

8. On a perusal of the definition of Section 3(k), it would indicate that the sub section covers totally different aspects, namely mathematical or business method or a computer program per se, algorithms. Therefore when the appellant's Application has been negatived citing Section 3(k) of the Act, the respondent/controller ought to have narrowed down the reasoning for rejection of the Patent by citing which part of Section 3(k) is being applied to the appellant's invention.

9. As seen from the hearing notice, the learned Controller has specifically stated that the objection is only regarding the claim being a computer program and computer implementable method. However as seen from the impugned decision, the learned Controller has abandoned the said objection and has arrived at a totally different conclusion that the subject matter of invention is mathematical/statistical. Therefore, the appellant has

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clearly been deprived of a fair opportunity to offer his explanation/give his objections with regard to the invention being non technical, mathematical/statistical, falling under Section 3(k) of the Act.

10. I therefore deem it fit to remit the matter to the respondent for fresh consideration after affording a fair opportunity to the appellant. To avoid any embarrassment, the appellant's Application shall be considered by a different Patent Controller. The hearing shall be expedited and the Application shall be disposed of within a period of four (4) months from the date of receipt of a copy of the judgment. No costs.

08.07.2024

Index : Yes/No
Speaking/Non-speaking order
rkp

To
The Assistant Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai - 600 032.

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P.B.BALAJI,J.
rkp

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