2023:MHC:4705

IN THE HIGH COURT OF JUDICATURE AT MADRAS

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Judgment reserved on	**03.08.2023**
Judgment Pronounced on	**17.10.2023**

CORAM:

THE HON'BLE MR. **JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(PT).53 of 2023

(OA/33/2020/PT/CHN)

Huawei Technologies Co., Ltd.,
A Chinese Corporation at
Huawei Administation Building, Bantian,
Longgang District, Shenzhen,
Guangdong 518 129,
China. ...Appellant

v.

1. The Controller General of Patents & Designs,
Patent Office, Boudhik Sampada Bhawan,
S.M.Road, Near Antop Hill Post Office,
Antop Hill, Mumbai-400 037.

2. Deputy Controller of Patents & Designs,
Patent Office, Intellectual Property Building,
G.S.T. Road, Guindy, Chennai-600 032.

3. Assistant Controller of Patents and Design,
The Patent Office, Boudhik Sampada Bhawan,
Plot No.32, Sector 14, Dwarka, New Delhi-110 075.

4. Deputy Controller of Patents & Designs,
Patent Office, Boudhik Sampada Bhawan, S.M.Road,
Near Antop Hill Post Office, Antop Hill,
Mumbai – 400 037. ...Respondents

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PRAYER : This Civil Miscellaneous Appeal filed under Section 117-A of the Patents Act, 1970, prays to pass orders: (i) setting aside the impugned order dated December 23, 2019 passed by the Respondent No.3 in application number 4561/CHENP/2010; (ii) directing the Respondent No.1 to allot the application to some other Controller in any of the four offices of the Patents Office and to consider the application on merits afresh; and (iii) directing the Respondent authority to proceed with the instant application expeditiously in accordance with law and (iv) any other such further order(s) as this Hon'ble Court deems appropriate in the facts and circumstances of the present case and in the interests of justice.

For Appellant : Mr.S.Majumdar
for M/s.S.Majumdar and Co.

For Respondents : Mr.Rajesh Vivekanandan,
Deputy Solicitor General

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JUDGMENT

Background

The appellant filed an international application for grant of patent under the Patent Cooperation Treaty claiming priority from the application filed in Japan. The national phase application derived from the above was filed under Indian Patent Application

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No.4561/CHENP/2010 (IN 4561). The application was in relation to a claimed invention entitled "Radio Communication System, Reception Device, Mobile Station Device, Transmission Device, Base Station Device, Transmission/Reception Device Control Method, and Transmission/Reception Device Control Program".

2. In response to the request for examination, the First Examination Report (FER) was issued by the Patent Office on 26.10.2017. In the FER, objections were raised under Sections 2(1)(ja), 3(k) and 10(4) and 10(5) of the Patents Act, 1970 (the Patents Act). By response dated 24.04.2018, the appellant replaced claims 1 to 13 and 17 with new claims 1 to 6 and the remaining claims were re-numbered. The appellant set out in considerable detail the reasons for asserting that the claimed invention would not be obvious to a person skilled in the prior art and that prior arts D1 and D2 do not teach, suggest or disclose the claimed invention. By hearing notice dated 20.11.2019, the respondent raised objections *inter alia* under Sections 59, 3(k), 2(1)(j) and 10(4) of the Patents Act. The appellant submitted detailed written

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arguments on 18.12.2019. Eventually, the impugned order was issued on 23.12.2019.

Contentions of counsel

3. Learned counsel for the appellant, Mr.S.Majumdar, pointed out that the appellant had explained in great detail as to why prior art documents D1 and D2 do not teach, suggest or disclose the claimed invention. He also pointed out that the said prior art documents were distinguished by filing post-hearing written submissions. With reference to the impugned order, learned counsel pointed out that the respondent merely extracted specific passages from prior art document D1 and concluded that the claimed invention is obvious to a person skilled in the art without setting out any reasons for such conclusion. Likewise, learned counsel submitted that a passage was picked out from prior art document D2 without providing proper reasons for the conclusion that the claimed invention lacks an inventive step.

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4. Learned counsel further submitted that the respondent rejected amended claims 1 to 7 on the ground that these amendments are not permissible under Section 59 of the Patents Act. In support of the contention that the rejection of the amended claims was not in accordance with Section 59 of the Patents Act, learned counsel relied upon the judgment of the Delhi High Court in *Nippon A & L Inc. v. Controller of Patents, 2022 SCC OnLine Del 1909*. Learned counsel submitted that amendments by which the appellant makes disclaimers, corrections or explanations are permitted under Section 59. In this case, he submitted that the substance of the amendments was disclosed in the specification.

5. Both on account of non-consideration of the response of the appellant to objections with regard to lack of inventive step and on account of the untenable rejection of the amendments, learned counsel submitted that the impugned order is liable to be set aside and the matter be remanded for reconsideration.

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6. In response to these submissions, Mr.Rajesh Vivekanandan, learned Deputy Solicitor General, submitted that no procedural irregularity was committed and that the appellant was provided with sufficient opportunity in this case. As regards the lack of an inventive step, learned counsel submitted that the Controller of Patents referred to prior art documents, D1 and D2, and concluded that the claimed invention would be obvious on that basis. In this connection, learned counsel relied on paragraph 10 of the impugned order.

7. As regards the amendments, learned counsel submitted that the amended claims are beyond the scope of the original claims. In support of this submission, learned counsel relied on paragraph 9 of the impugned order. Therefore, learned counsel concluded his submissions by stating that the impugned order does not call for interference.

8. By way of rejoinder, learned counsel for the appellant submitted that the impugned order does not contain any

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discussion as to how prior arts, D1 and D2, can be read in conjunction and as to how the said prior arts point towards the claimed invention. Indeed, learned counsel submitted that the problem to which the claimed invention provides a solution is the transition between 3G and 4G networks in telecommunication in course of transmission. By referring to Section 13(3) of the Patents Act and Rule 28(5) of the Patents Rules, 2003 (the Patents Rules), learned counsel concluded his submissions by contending that the rejection of the amendments is clearly contrary to the above provisions.

Discussion, analysis and conclusions

8. The original set of claims filed by the appellant consisted of 22 claims. The said claims include the following:

"1. A radio communication system comprising:

transmission/reception devices which perform communication by dynamically switching a first transmission mode and a second transmission mode having a lower quality than the first transmission mode,

wherein the transmission/reception devices have

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a transmission mode decision means which fixes a transmission mode upon communication to the first transmission mode for a given period of time.

....

10. A radio communication system which performs transmission from a first transmission/reception device having a plurality of transmit antennas to a second transmission/reception device by dynamically switching between a plurality of transmission modes including spatial diversity and spatial multiplexing, comprising:

performing, by the first transmission/reception device, transmission by the spatial diversity after the start of communication;

changing a transmission mode after transmission mode information indicating the changed transmission mode is transmitted to the second transmission/reception device when the transmission mode is changed.

performing, by the second transmission/reception device, reception by the spatial diversity after the start of communication; and

changing the transmission mode according to the transmission mode information after the transmission mode information is received.

11. ...

12. The radio communication system according to Claim

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10 or 11,

wherein the start of communication includes the case where the communication is temporarily interrupted and thereafter resumed.

13. A reception device which performs reception by dynamically switching a first transmission mode and a second transmission mode having a lower quality than the first transmission mode, comprising:

a transmission mode decision means which fixes a transmission mode upon reception to the first transmission mode for a given period of time.

14. A mobile station device in a communication system which performs transmission from a base station device having a plurality of transmit antennas to a mobile station device by dynamically switching between a plurality of transmission modes including spatial diversity and spatial multiplexing, comprising:

performing reception by the spatial diversity after the start of communication; and

changing a transmission mode according to transmission mode information after receiving the transmission mode information indicating the changed transmission mode from the base station device."

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9. In response to the FER, the appellant submitted a revised set of 12 claims on 24.04.2018. Eventually, along with the written submissions dated 18.12.2019, the appellant submitted the following three claims (the current set of amended claims):

> *"WE CLAIM:*
>
> *1. A radio communication system, comprising:*
>
> *a base device (100) as a first transmission/reception device and a mobile station device (200) as a second transmission/reception device,*
>
> *wherein said base station device (100) adapted to transmit through a spatial diversity mode, a control information to the mobile station device (200), the control information being always transmitted to the mobile station device (200) by the spatial diversity mode upon the start of communication; and*
>
> *the base station device (100) adapted to transmit a transmission mode information to the mobile station device, wherein the transmission mode information indicates the mobile station device to change into a spatial multiplexing mode if the quality of radio wave reception is greater than or equal to a threshold value or maintain the spatial diversity mode if the quality of radio wave reception is less than the threshold value;*
>
> *wherein the base station device communicates, after the*

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end of the transmission of the control information, user data with the mobile station device through the spatial multiplexing mode or the spatial diversity mode according to the transmission mode information;

wherein the base station (100) has multiple antennas (101).

2. The radio communication system as claimed in claim 1, wherein the start of communication includes restart of communication between the base station device (100) and the mobile station device (200) after the communication is temporarily suspended.

3. The radio communication system as claimed in claim 1, wherein the first control information is allocated on layer 1 or layer 2, or the first control information is allocated on a control channel."

10. The question that arises for consideration is whether the current set of amended claims are permissible under Section 59 of the Patents Act. Sub-section (1) of Section 59 is as under:

"59. Supplementary provisions as to amendment of application or specification- (1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and no amendment

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thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment."

As is evident from the above, under Section 59(1) of the Patents Act, amendments of the application for grant of patent, the complete specification or any documents relating to the application may be made only by way of disclaimer, correction or explanation. Sub-section 1 of Section 59 consists of three limbs. The first limb thereof is wide in ambit and applies to amendments relating to the patent application, the complete specification, and all documents relating thereto. The second and third limbs thereof are focused on amendments to the complete specification and claims, respectively. The second and third limbs are inter-related because every complete specification ends with the claims [Section 10(4)]. As regards amendments to the specification, the restriction

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is that amendments should not claim or describe matter which was not in substance disclosed or shown in the complete specification before such amendment. As regards amendments to the claims, such amendments are required to be wholly within the scope of the original claims of the complete specification. On the interpretation of Section 59 of the Patents Act, especially in the context of a national phase filing of a PCT application, reference may be made to the judgment of the Delhi High Court in *Allergan Inc. v. The Controller of Patents, 2023/DHC/000515.*

11. In the impugned order, the Controller of Patents set out claim 1 of the current set of amended claims. After setting out the same, the following conclusion was recorded:

> *"These amendments are not allowable under Section 59 of The Patents Act, 1970 (as amended) since section 59 is very clear that the claims of specification as amended shall fall wholly within the scope of the claims of the specification before the amendments whereas here the stated amendments has no where been disclosed in*

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the claims before amendments and is also not explaining any feature which is existing in the claims before amendments. "

The above conclusion was recorded without setting out the reasons supporting such conclusion. Claim 1 of the current set of amended claims, which is the only independent claim therein, makes the claim in respect of a radio communication system comprising a base device as a first transmission/reception device and a mobile station device as a second transmission/reception device. It also provides that the base station device is adapted to transmit through a spatial diversity mode. Claim 1 of the original set of claims makes the claim in respect of a radio communication system comprising transmission/reception devices. Claim 10 of the original set of claims makes the claim in respect of a radio communication system which transmits from a first transmission/reception device having a plurality of transmit antennas to a second transmission/reception device. Claims 9 and 14 of the original set of claims make claims in respect of transmission from a base station device to a mobile station device.

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These claims are combined in claim 1 of the current set of claims, which is wholly within the scope of the above original set of claims. Claim 2 of the current set of claims corresponds to and is wholly within the scope of original claim 12. The first control information and control channel referred to in claim 3 of the current set of claims is also wholly within the scope of original claims 2-5 and 7. Thus, even if the second and third limbs of sub-section 1 of section 59 of the Patents Act were to be construed as distinct compartments, notwithstanding indications to the contrary, the appellant has satisfied the requirements thereof.

12. Turning to the conclusions with regard to lack of inventive step, in paragraph 10 of the impugned order, the respondent has reproduced about two paragraphs from prior art document D1. Likewise, one paragraph from prior art document D2 is partly set out in paragraph 10. After doing so, the respondent has recorded the following conclusion:

"The document D2(US 5859875A) being considered as a prior art discloses" determination of how to

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perform the change of the transmission mode (from the first transmission mode, e.g. the spatial diversity) during a transmission composed of symbols of a signal transmitted at predefined, successive time intervals. (See column 2, line 20 to column 3, line 8) which discloses a similar radio communication system as the present invention, and as D1, and wherein the transmission mode is changed after or at each data transmission, i.e. a first transmission mode is performed until the communication of a given data is completed after the start of communication (see D2, e.g. column 3, lines 9 to 13). "

13. The appellant set out extensive reasons as to why prior art documents D1 and D2 do not make the claimed invention obvious both in reply to the FER and in the written submissions filed subsequently. While the impugned order does contain brief reasons, the submissions of the appellant were not examined and no reasons were recorded for rejecting the submissions of the appellant with regard to prior art documents D1 and D2.

14. In view of the foregoing discussion, the impugned order is unsustainable. Consequently, the impugned order is set

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aside and the matter is remanded for reconsideration. In order to preclude the possibility of pre-determination, the reconsideration shall be undertaken by an officer other than the officer who issued the impugned order. After providing a reasonable opportunity to the appellant, a reasoned order shall be issued within a period of four months from the date of receipt of a copy of this order. It is clarified that no opinion has been expressed herein on the merits of the application for grant of patent. (T) CMA(PT) 53 of 2023 is disposed of on the above terms without any order as to costs.

17.10.2023

Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No

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To

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   Patent Office, Boudhik Sampada Bhawan,
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SENTHILKUMAR RAMAMOORTHY, J.

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