WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **13.12.2023**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(PT)/11/2023
(OA/13/2020/PT/CHN)

Mitsubishi Electric Corporation,
7-3, Marunouchi 2-Chome,
Chiyoda-ku,
Tokyo 100-8310,
Japan ... Appellant

-vs-

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

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) is filed under Section 117-A of the Indian Patents Act, 1970, praying that the refusal order dated **28 February 2020** be set aside and the application for patent be allowed to proceed to grant.

For Appellant : Mr.S.Shivathanu Mohan for

https://www.mhc.tn.gov.in/judis

WEB COPY

M/s.De Penning and De Penning

For Respondent : Mr.K.Subbu Ranga Bharathi, CGSC

****

JUDGMENT

The appellant challenges an order dated 28.02.2020 by which Patent Application No.2482/CHENP/2012 for the grant of patent to an invention entitled "IMAGE CONSTRUCTION APPARATUS" was rejected.

2. The appellant submitted that the above mentioned application was filed on 16.03.2012. In response to a request for examination, the respondent issued the First Examination Report (FER) on 28.07.2017. In the FER, objections were raised *inter alia* with reference to Sections 2(1)(ja), 3(k) and 10(4) of the Patents Act 1970. The appellant responded to the FER. A hearing was held on 02.12.2019. Pursuant thereto, the appellant submitted written submissions. Eventually, the impugned order was issued on 28.02.2020. The present appeal arises in the above facts and

https://www.mhc.tn.gov.in/judis

WEB COPY

circumstances.

3. Learned counsel for the appellant invited my attention to the complete specification in respect of the claimed invention and submitted that the invention relates to an image construction apparatus, which enables image generation both at the source and destination and, thereby, enables multiple units, such as air-conditioning units, to be easily controlled and further enables even additional devices or units to be controlled. According to learned counsel, the claimed invention satisfies all requirements of an invention under Section 2(1)(j) of the Patents Act.

4. By referring to the impugned order, learned counsel submits that the conclusions recorded on obviousness are completely unreasoned. He points out that prior art documents D1 and D2 were referred to in the impugned order, but the appellant's contentions as to how the cited prior art does not lead to the claimed invention were not discussed therein. In this connection, learned counsel also points

https://www.mhc.tn.gov.in/judis

WEB COPY

out that the claimed invention was granted a patent by the European Patent Office. He also points out that both prior art documents D1 and D2 were considered by the European Patent Office before granting the patent. Turning to the objection under Section 3(k), learned counsel points out that the claimed invention cannot be construed as a computer programme per se.

5. With reference to the written submissions of the appellant, learned counsel points out that the appellant referred to the CRI Guidelines issued by the Patent Office and to a judgment of the Delhi High Court to contend that the claimed invention provides a technical solution to the problem of transfer of data for each screen transition, without complicating the development process. According to learned counsel, these contentions were not duly considered and the respondent recorded unreasoned conclusions that it is a computer programme per se. With regard to the conclusion that the appellant did not make sufficient disclosure, learned counsel submits that the best method of performing the invention was duly disclosed

https://www.mhc.tn.gov.in/judis

WEB COPY

in the complete specification.

6. In response to these contentions, learned counsel for the respondent submitted that the claimed invention would be obvious to a person skilled in the prior art. In order to substantiate this contention, learned counsel points out that both prior art documents D1 and D2 would lead a person skilled in the art to the claimed invention. Learned counsel for the respondent also submits that the claimed invention is not patent eligible as per Section 3(k) of the Patents Act. Without prejudice to these contentions and without making any concession on the merits of the patent application, learned counsel submits that the matter may be remanded for re-consideration.

7. In support of the rejection under Section 2(1)(ja) of the Patent Act, the operative portion of the order is as under:

"1. Under section 2(1)(ja) of the Indian Patent Act. The subject matter of claims are does not involve inventive step

https://www.mhc.tn.gov.in/judis

WEB COPY

over the cited documents D1: US20060052884 A1) and D2:US6211870B1 are disclosed all the feature of the claims. Claim does not involves an inventive step. The other dependent claims are also not allowed under section 2(1)(ja) of the Indian Patent Act 1970 as amended.

D1 discloses Document D1 discloses following features of independent claim 1 : displayed on a screen of a remote control apparatus image generation, generates a database, that associates the apparatus information source code generation, program generation. (See in particular ;Abstract, Description paragraphs 16,17,29-39 and fig 1,8), All the hardware feature of the present claims are already disclosed in the cited document. Document D2 discloses following features of independent claim 1: database generation, remote control, program medium, (See in particular; Abstract, Description and claim) it would have been obvious to a person skilled in the art to combine the teachings of D1 & D2 to arrive at the subject matter under consideration. Hence, the subject matter of the amended claims 1-5 are not allowed under section 2(1)(j) of the Indian Patent Act 1970 as amended. Further amendment in the claims are not allowed without form 13."

From the above, it is evident that the respondent has set out features

https://www.mhc.tn.gov.in/judis

WEB COPY

allegedly common to prior art documents D1 and D2 and independent claim 1. After doing so, the respondent has recorded the conclusion that all the hardware features of the present claims are disclosed in prior art D1. Thereafter, after referring to prior art document D2, the respondent has recorded the conclusion that the claimed invention would be obvious if the teachings of D1 and D2 are combined.

8. The respondent has, therefore, recorded conclusions without providing cogent reasons in support of such conclusions. Importantly, the respondent has not taken into account the fact that the same prior art documents were considered by the European Patent Office before granting a patent to the claimed invention. While the grant of the patent by the European Patent Office upon consideration of the same prior art is not conclusive or dispositive, it is certainly a material consideration that should be taken into account by the respondent while deciding the patent application.

https://www.mhc.tn.gov.in/judis

WEB COPY

9. As regards the rejection under Section 3(k), the operative portion of the order is as under:

> *"The subject matter of claims are not patentable, the present claims does not involve any technical contribution / a technical effect and it's a merely a computer program. The general structure of a program store in the memory of the general purpose computer. This program execute instruction code to perform the function of the image construction apparatus. The image construction apparatus are nothing but it a software program store in the memory of the general purpose computer. The image construction apparatus are nothing its only general purpose computer. The functioning of the apparatus (computer program) are clearly mention on the fig 4,5,6,7, and 8 and its details description, hence claims 1-5 are not allowed under section 3(k) of the Indian Patent Act 1970 as amended. The word "means" mentioned in claims are not defined properly either in description or/and in claims. The various means are software. As such the claims falls U/S 3(k) of The Indian Patent Act 1970."*

Once again, the above extract shows that the respondent has recorded the categorical conclusion that the present claims do not involve a technical contribution or technical effect and that it is

https://www.mhc.tn.gov.in/judis

WEB COPY

merely a computer programme. Such conclusion is not backed by either adequate reasoning or due consideration of the written submissions of the appellant, including the reference thereto to the CRI guidelines and relevant precedents. In cases such as *Ferid Allani v. Union of India and Others 2019 SCC OnLine Del 11867 and Microsoft Technology Licensing LLC v. Assistant Controller of Patents and Designs, 2023 SCC OnLine Del 3370,* the Delhi High Court has held that the words '*per se*' in Section 3(k) should be accorded meaning and that not all computer programmes are patent ineligible under Section 3(k) of the Patents Act. Since the impugned order does not appear to have taken these aspects into consideration, the impugned order calls for interference. Therefore, the impugned order is set aside and the matter is remanded for re-consideration.

10. Such re-consideration shall be undertaken on the following terms:

(i) In order to preclude the possibility of pre-determination, an officer other than the officer who issued the impugned order shall undertake such re-

https://www.mhc.tn.gov.in/judis

WEB COPY

consideration.

(ii) After providing a reasonable opportunity to the appellant, a reasoned decision shall be issued within a period of four months from the date of receipt of a copy of this order, after taking into account the observations contained in this order .

(iii) It is made clear that no opinion is expressed herein on the merits of the application for grant of patent.

11. Consequently, (T)CMA(PT)/11/2023 is disposed of on the above terms without any order as to costs.

13.12.2023

Index : Yes / No
Internet : Yes / No
Neutral Citation : Yes/No
kal

SENTHILKUMAR RAMAMOORTHY J.

kal

https://www.mhc.tn.gov.in/judis

WEB COPY

(T)CMA(PT)/11/2023
(OA/13/2020/PT/CHN)

13.12.2023

https://www.mhc.tn.gov.in/judis