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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : **19.09.2023**

CORAM

THE HONOURABLE MR.JUSTICE **SENTHILKUMAR RAMAMOORTHY**

CMA(PT)/7/2023
and C.M.P.No.15831 of 2023

HUAWEI TECHNOLOGIES CO., LTD
Huawei Administration Building,
Bantian, Longgang District, Shenzhen,
Guangdong - 518129, P.R.China
Represented by its Constituted Attorney
/Authorised Signatory, Nripendra Kashyap. ... Appellant

vs.

The Controller of Patents,
The Patent Office,
Intellectual Property Office Building,
GST Road, Guindy,
Chennai - 600 032. ...Respondent

PRAYER: Civil Miscellaneous Appeals (Patents) filed under Section 117-A of the Patents Act, 1970, praying to set aside the orders dated 16th December 2021 passed by the respondent in Patent Application 201947028978 and consequently direct the respondent to restore the

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appellant's patent for further prosecution.

For Appellant : Mrs.Archana Shanker
Mr.N.C.Vishal, Mr.Abhishek Kumar

For Respondent : Mr.S.Janarthanam, SPC

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JUDGMENT

The appellant assails an order dated 16.12.2021 by which Patent Application No.201947028978 was rejected. The said application was the PCT National Phase application.

2. Upon examining the application, the First Examination Report (FER) was issued on 01.12.2020 raising several objections. The appellant replied thereto on 12.02.2021 and submitted amended claims. In the Second Examination Report (SER) issued on 23.04.2021, the following objections were raised:

> "***Invention u/s 2(1)(j)***
>
> *1. The objections raised under section 2(1)(j) of the Indian Patents Act, are still maintained with respect to the device claims 15-29 for the lack of any novel hardware constructional feature with respect to the*

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citations as well as the common general knowledge in the field of communication to the person skilled in the art.

Clarity and Conciseness

1. The "configured to" used in various claims shall be deleted. The objection is maintained.

2. The apparatus claims 15-23 are simply implementing the steps of the method claims 1-9 by virtue of software processing units executing the software instructions stored in the memory, to perform the method step operations. Hence the apparatus claims 15-23 are not allowable under the Indian Patents Act, 1970 (as amended). The objection is maintained.

3. The apparatus claims 24-29 are simply implementing the steps of the method claims 10-14 by virtue of software processing units executing the software instructions stored in the memory, to perform the method step operations. Hence the apparatus claims 24-29 are not allowable under the Indian Patents Act, 1970 (as amended). The objection is maintained.

4. The apparatus claims 15-23 and 24-29 are not supported with any novel hardware constructional feature disclosure through description/illustrations. The objection is maintained.

5. The alleged invention lies only in the method, hence the non-method claims 15-29 cannot be allowed. The

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objection is maintained.

6. The claims shall be supported by the reference numerals (in parenthesis) from the illustrations.

7. The method claims should be given in clear method steps.

Non-Patentability u/s 3

1. The apparatus claims 15-23 are simply implementing the steps of the method claims 1-9 by virtue of software processing units executing the software instructions stored in the memory, to perform the method step operations. Hence the apparatus claims 15-23 are not allowable under section 3(k) of the Indian Patents Act, 1970 (as amended). The objection is maintained.

2. The apparatus claims 24-29 are simply implementing the steps of the method claims 10-14 by virtue of software processing units executing the software instructions stored in the memory, to perform the method step operations. Hence the apparatus claims 24-29 are not allowable under section 3(k) of the Indian Patents Act, 1970 (as amended). The objection is maintained."

3. In response thereto, the appellant, once again, amended its claims. In particular, the appellant deleted all the apparatus claims, i.e.,

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claims 15 to 29, and included only two apparatus claims as 15 and 16. The impugned order was issued in these facts and circumstances. Such order was sought to be reviewed by filing a review application on 11.01.2022. The said review application was rejected on 20.04.2022. Hence, this appeal.

4. Learned counsel for the appellant invited my attention to the SER and to the amended claims submitted in response thereto. She submitted that the objections raised in the SER were effectively addressed by deleting the claims to which objections were raised and claim 15 and 16 were changed from claims for an information transmission apparatus to a communication apparatus using the method specified in any one of claims 1 to 9. In spite of doing so, she submitted that the patent application was rejected on the ground that the appellant had not submitted proper method claims and had amended the correct preamble to the specification.

5. In response to these contentions, Mr.S.Janarthanam, learned SPC, invited my attention to the SER and submitted that the appellant

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failed to meet the objections raised in the SER. He further submitted that the appellant did not provide clarity in method claims 2, 4, 6, 7, 11-14 and refused to rectify the claims in order to meet the requirements. Therefore, he submitted that the impugned order does not call for interference.

6. The impugned order sets out the history of prosecution of the patent application across multiple pages before recording the findings and conclusions. The operative portion of the order is set out below:

> *"This office has not taken any objection on claim 1 but the applicant's agent has unnecessarily removed the existing step i.e "phase shifting" from claim 1 and reworded it without any step.*
>
> *During the hearing the applicant's agent has agreed to bring clear method steps into claims 2, 4, 6, 7, 11-14 but failed to do for meeting the objection raised in this regard.*
>
> *Without any objection on preamble of claims the applicant's agent has amended the preambles of the claims. Whereas earlier preambles are correct according to the*

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specification.

In spite of discussion on the method claims during the hearing the applicant's agent has failed to utilise the opportunity given for amending the claims as agreed.

The applicant's agent has not shown any interest to check the 2 application claims 15 and 16 wording before filing in the Patent Office.

With utter disregard to the discussion happened during the hearing the applicant's agent has not for rectified the claims in order to meet the requirements.

Finally the applicant's agent has failed to meet the requirements of the Patents Act informed vide this office Subsequent Examination Report dated 23rd Apr 2021 even after giving the opportunity of the hearing."

7. From the above operative portion of the order, it is abundantly clear that the patent application was not dealt with on merits. Instead, the Controller of Patents has assigned the following two reasons for rejecting the application:

(i) The appellant failed to bring clear method claims in claims 2, 4,

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6, 7 and 11-14 by disregarding the discussion during the hearing.

(ii) The appellant unnecessarily amended the existing step in claim 1 and the preamble of claims, when the earlier versions were not objected to.

(iii) The wording of claims 15 and 16 were not checked before filing the same.

8. By examining the objections raised in the SER and the amended claims submitted in response thereto, it is evident that all the apparatus claims running from claims 15 to 29 were deleted by the appellant in response to the SER. In these circumstances, the rejection of the application on the ground that the method claims were not presented in proper steps is untenable as it was not indicated in the SER. The other reason cited in the order, namely, amendment to the preamble and claim 1, does not justify the rejection of the patent application. Therefore, the impugned order is, hereby, set aside and the matter is remanded for reconsideration. Such reconsideration shall be undertaken on the following terms:

(i) An officer other than the officer who issued the impugned order

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shall consider the appellant's application so as to preclude any possibility of pre-determination.

(ii) Such reconsideration shall be limited to objections already raised.

(iii) The appellant shall be permitted to make amendments as regards clerical / typographical errors in the amended claims.

(iv) A reasoned decision shall be issued within a period of ***six months*** from the date of receipt of a copy of this order after providing a reasonable opportunity to the appellant.

(v) Consequently, the connected miscellaneous petition is closed.

19.09.2023

Index : Yes/No
Internet : Yes/No
Speaking Order/Non-Speaking Order
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