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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 28.06.2024	Pronounced on: 05.07.2024

CORAM:

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

(T) CMA (PT) No.139 of 2023

INVENTIO AG,
Seestrasse 55,
CH- 6052 Hergiswil,
Switzerland.

.. Appellant

..Vs.

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

.. Respondent

Prayer: This appeal came to be numbered by transfer of IPAB Case OA/10/2017/PT/CHN from the file of the Intellectual Property Appellate Board, Chennai praying this Court to the refusal order of Respondent vide letter No.1549/CHENP/2008/CNS/M8975 dated 11 November 2016 be set aside and the Application for patent be allowed to proceed to grant.

For Appellant : Mr.Shivathanu Mohan

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for M/S.De Penning & De Penning

For Respondent : Mr.Rajesh Vivekanandhan,
Deputy Solicitor General

J U D G M E N T

This Appeal is preferred against the rejection of the Patent Application No.1549/CHENP/2008/CNS/M8975 dated 11.11.2016 on the file of Deputy Controller of Patents and Designs.

2. I have heard Mr.Shivathanu Mohan, the learned counsel for the Appellant for M/s.De Penning and De Penning and Mr.Rajesh Vivekananthan, learned Deputy Solicitor General for the respondent.

3. The learned counsel for the appellant would submit that the Patent Application was rejected on two grounds, viz., invention claim was only a computer program and that it did not teach away from D1. However, the contentions of Mr.Shivathanu Mohan is that as many as 10 prior arts were cited in the First Examination Report, but in the order, the respondent has discussed only prior arts D1 and D2 and there is absolutely no discussion about prior arts, D3 to D10. He would also submit that the appellant had

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claimed invention of the method alone and not any computer program as such, which was wrongly understood by the respondent. He would therefore, pray for a remand of the matter for proper adjudication.

4. Per contra, Mr.Rajesh Vivekananthan, learned Deputy Solicitor Genera, would submit that the impugned order has discussed all relevant materials and found that the evaluating unit is only a standard computer unit with a program and that several such recognition programs are already available in the market for commercial use. He would therefore submit that there is no error or perversity in the reasoning of the respondent and prayed for dismissal of the Appeal.

5. I have considered the rival submissions advanced by the learned counsel on either side.

6. Admittedly, when as many as 10 prior arts were cited in the First Examination Report, the order is totally silent about prior arts D3 to D10 and only prior arts D1 and D2 are discussed . Further it is also brought to my notice that US Patent has been granted to the appellant where there is a

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reference to all the prior arts, D1 to D10. It is also an admitted case that the said factum was brought to the notice of the respondent through the written submissions but however, the same has not been considered.

7. The learned counsel for the appellant would further submit that European Patent was granted citing prior arts D1 to D8, subsequent to the order of rejection passed by the respondent. Further, he would take me through the claim itself where the invention is only in respect of detection of the position of the lift user in the building area and comparing whether the position of the lift user who has boarded the lift cage corresponds with the position of the lift user that has triggered the destination point. Unfortunately, the respondent has lost sight of the very claim of the appellant and has proceeded to decide the Application as if the appellant is making a claim on the invention based on the computer program. Therefore, it is a clear mis-appreciation of the very claim itself and on this limited ground alone, the matter requires reconsideration.

8. For all the foregoing reasons, I am inclined to remit the matter to the respondent for fresh consideration in accordance with with law. Considering that the life of the Patent left is very short, I direct the

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respondent to assign the task of scrutinising the Patent Application to a different Patent Controller to avoid embarrassment to the parties and also decide the same after hearing the appellant by way of affording an opportunity to advance any further submissions and in any event, dispose of the Application within a period of two (2) months from the date of the copy of the judgment.

9. In fine, this Appeal is allowed with the above directions. No costs.

05.07.2024

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

To

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

P.B.BALAJI,J.
rkp

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Pre-delivery Judgment in
(T) CMA (PT) No.139 of 2023

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