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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 16.02.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT) No.165 of 2023 and
(OA/SR No.169 of 2020)

Qualcomm Incorporated
a corporation organized and existing
under the laws of USA
International IP Administration, 5775 Morehouse Drive,
San Diego, California 92121-1714 USA ... Appellant

Vs.

Assistant Controller of Patents & Designs
Patent office Boudhik Sampada Bhawan
CP-2, Sector - V, Salt Lake City
Kolkata - 700 091 ... Respondent

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Prayer : Civil Miscellaneous Appeals filed under Section 117(A) of the Patents Act, 1970 praying for an order setting aside the impugned order dated 15.06.2020 passed by the respondent and an order granting patent on Indian Patent Application No.2825/CHENP/2012 in favour of the applicant

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For Appellant : Mr.N.Shrivatsav

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for Ms.Archana Shanker
for M/s.Anand and Anand

For Respondent : Mr.C.Samivel, Senior Panel Counsel

JUDGMENT

Aggrieved by the rejection of its application by the respondent under Section 2(1)(ja) of the Indian Patents Act, 1970, which the appellant has filed seeking patent to its invention titled 'METHODS AND APPARATUS FOR ESTIMATING DEPARTURE TIME BASED ON KNOWN CALENDAR EVENTS', this appeal is filed. The invention according to the appellant, enables an estimated time for departure for reaching a destination based on certain known criteria.

2. The application was filed sometime in 2009. In its application, the appellant had claimed patent for 62 claims, which is made up of 10 independent claims and the rest are dependent claims.

3. The controller would now come out with his FER wherein, he cited D1 to D3 as prior arts. The appellant responded to the same and also made some amendments to its claims and brought down the total number of claims from 62

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to 58. Thereafter, on 20.11.2019, the Controller issued a hearing notice, which was scheduled to take place on 05.12.2019. In the hearing notice, the Controller had cited four prior arts, which included the earlier prior arts and another prior art D4 and informed the appellant that D1 to D3 needed to be read along with D4. The appellant was hardly given any time to respond to the same concretely. Yet, still it participated in the hearing. In its written submission, the appellant has also made further amendment to its claims and this time, besides making certain internal amendment to its earlier claims, it also brought down the total number of claims from 58 to 56.

4. On considering the written submissions, the Controller has rejected the appellant's application for patent on the ground that the invention of the appellant is obvious to the person skilled in the art and hence, it lacked inventive step within the meaning of Section 2(1)(ja).

5. Heard both sides and perused the materials available on record in the form of typed set of papers.

6. Mr.N.Srivatsav, learned counsel appearing for the appellant submitted that the order of the respondent is too cryptic and it does not disclose expressly how

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a person skilled in the art would find the invention of the appellant obvious enough as to bring the said invention within the meaning of Section 2(1)(ja) as lacking in inventive step. He also added that having cited a new prior art, it would have been appropriate that the Controller had granted further time to the appellant to respond to D4.

7. This court perused the impugned proceedings of the respondent and finds that it is far too cryptic and does not convey its line of reasoning for supporting the decision, something this court expects. There is no discussion on the quality of inspection on the prior arts for this court to understand which among the prior arts will render the invention obvious to the person skilled in the art.

8. To conclude, this appeal is allowed. The matter is remanded back to the Controller for a *de novo* consideration of appellant's application. To save embarrassment to the Controller who passed the impugned order, the matter will now be considered by some other Controller. The petitioner will also be at liberty to amend the claims, if so necessary and this court further makes it clear that in the eventuality of the Controller relying on any new prior art, the

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appellant shall have all its right well protected and preserved for defending its case vis-a-vis the newly cited prior art. Since the application is filed during 2009, the Controller who would now be in-charge of the matter, is required to dispose of the same after complying with all the procedural requirements strictly, within a period of six months from the date of receipt of a copy of this order. No costs.

16.02.2024

Asr
Index: Yes/No
Speaking Order / Non-Speaking Order
Neutral Citation: Yes / No

To

The Assistant Controller of Patents & Designs
Patent office Boudhik Sampada Bhawan
CP-2, Sector - V, Salt Lake City
Kolkata - 700 091

N. SESHASAYEE, J.

Asr

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