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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 23.02.2024

CORAM :JUSTICE N.SESHASAYEE

CMA(PT) No.33 of 2023
and CMP.No.20937 of 2023

1.Dr.Vandana Parvez
2.Ms.Vedika Parvez
3.Mahek Parvez ... Appellants

Vs.

The Controller of Patents
Office of Controller General of Patents
Anna Salai
Guindy Industrial Estate
Guindy, Chennai – 600 032. ... Respondent

PRAYER: Civil Miscellaneous Appeal (Patent) filed under Section 117A of Patents Act, 1970, praying for (a) grant of direction for D1/Old Application No.201941001564 to be disregarded as prior art in New Application No.202041010232; (b) grant of direction for New Application No.202041010232, i.e., the present application to be processed for 'Grant of Patent'; and (c) pass such further or other orders as may be just and necessary in the circumstances of the case.

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For Appellants : Mr.Ramesh Ganapathy

For Respondent : Mr.S.Janarthanam
Senior Panel Counsel

JUDGMENT

1. Aggrieved by the rejection of their application for the grant of patent to their invention titled “Method and System for Providing Effective Generation and Delivery of Interactive Online Digital Content”, the applicants before the Patent Controller have preferred this appeal.

2. The first appellant has a professional qualification in advertising and promotion of goods and services, and she has also secured a doctorate in behavioural science- psychology.

3.1 It is the case of the appellants that they have developed a unique model/methodology for advertising and promotion of goods and services, in that, instead of making the advertisement common for all categories of individuals, the appellants' model would address a specific category of persons who share a common psychological pattern.

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3.2 To be precise, the invention which belongs to the field of computer science, provides a method for creating and delivering interactive digital content for online advertising campaigns. It employs one or more processing units, along with a memory unit comprising a plurality of modules, that create different message combinations, customizing them based on collected campaign metadata, and delivering them to segmented audiences. To expatiate, if a company launches an online advertising campaign, it may input details such as target audience, campaign goals, etc., into the system, which then creates different combinations of persuasive messages tailored to different target audience segments and delivers them via online channels such as social media. As the campaign runs, the system collects data such as click-through rates, interactions, and engagement. The system also analyses the campaign's performance and continuously refines its approach based on real-time feedback and delivers updated content. This segmentation logic is made possible by a process that makes use of machine learning (ML) to correlate between the message and the intended audience. Simply put, the claimed invention provides an optimized iterative process that allows advertisers to effectively engage with their target audience. The method also includes analysis of audience response

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data to improve future targeting and delivery of updated content accordingly.

4. Earlier in 2019, the appellants had promoted a company by the name of "Gemini Associates", on whose behalf, they had made an application for patent, but that was later withdrawn on 10.03.2020. Thereafter, they presented the same claim in their individual capacity. In their instant application, the appellants had made 10 claims of which 2 are independent claims and 8 are dependent claims.

5. The application was followed by a First Examination Report (hereinafter "FER" for the sake of brevity) by the Controller of Patents. In the FER, the Controller had objected to the patentability of the invention on the grounds:

a) that lack of novelty and inventive step within the meaning of Section 2(1)(l) and Section 2(1)(ja) of the Patents Act (hereinafter the "Act" for the sake of brevity) respectively and backed it with two prior arts, namely D1 and D2;

b) that the invention is not patentable under Section 3(k) of the Act;

c) that the application lacked sufficiency of disclosure, clarity, conciseness, and definitiveness as required under Section 10 of the Act.

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Peculiarly, prior art D1 is the appellants' old patent application filed as a corporate concern which, as stated earlier was later withdrawn by them.

6.1 In response to the FER, the appellants filed a detailed reply. In the said reply, the appellants brought out the differences between their proposed invention and the prior arts forming a part of D1 and D2. With regard to D1, the appellants explained that the prior art cited in D1 was nothing but their own application for grant of patent, filed as a corporate concern sometime in 2019. They clarified that the said application was physically withdrawn on 10.03.2020 and that the same was not reflected on the website of the Patent Office. They had also admitted that while filing Forms 9 and 18A [request for early publication and expedited examination] for the instant patent application, they had also filed the same for the old patent application as well.

6.2 Apart from this, the FER Response also outlined the submissions differentiating the claims from prior art D2 and submitted that the objections under Section 3(k) could not be sustained in light of the clear technical effect exhibited by the instant invention by facilitating the optimization of performance and delivery of interactive digital content associated with an

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online advertising campaign.

7.1 Following the response to the FER, a hearing notice was issued by the Controller on 12.10.2021, scheduling a hearing on 12.11.2021, which was then adjourned to 13.12.2021. In the hearing notice, the Controller had chosen to retain his objections relating to novelty and had also retained the objection under Section 3(k), among other objections relating to clarity and conciseness. In the hearing notice, the Controller had only cited D1,signifying that he had chosen to waive D2. The appellants participated in the hearing and also filed their written submissions. In particular, the appellants had also prayed that D1 be disregarded as part of the record, as it never ought to be in the public domain in the first place since any form filed subsequent to the withdrawal of an application must not be accepted or acted upon.

7.2 Thereafter, second hearing notice was issued on 29.12.2021, scheduling a hearing on 14.01.2022, retaining the very same objections as the first hearing notice. Written submissions were once again filed addressing the objections on 29.01.2022.

8. After considering the submissions of the appellants, the Controller passed

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the impugned order on 19.10.2022 rejecting the application of the appellants. The operative portion of the order, which runs barely to one page, plainly refuses to grant patent stating that the grant would be contrary to Section 13(1)(b) as the proposed invention is the same as the subject matter contained in D1. Aggrieved by the said order, the appellants have preferred the present appeal.

9. This Court heard the arguments of Mr.Ramesh Ganapathy for the appellants who come to the aid of the appellants, and Mr.S.Janarthanam, learned Counsel appearing for the respondent. The learned counsel for the appellants submitted :

a) It incorporates one or more processing units, along with a memory unit comprising of a plurality of modules. The processing unit first receives campaign metadata (i.e. details such as objective, target audience, ad placement etc.).

b) Based upon this information, an aesthetic specification is developed (i.e. a set of guidelines to determine the visual and design elements of the digital content) in accordance with the metadata.

c) Subsequently, the method involves accessing message frames

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(templates) stored in a frame pool and customizes the same based on two psychological principles:

i. Heuristic Parameters: guiding principles to optimize decision making process based on experience and trial and error method.

ii. Persuasion Principles: To create messages that are compelling and persuasive – to encourage desired actions such as engaging with the content.

d) A plurality of message combinations is derived following this customization process and cognitive message sets are created. These are cross tabbed with the compiled specifications, and this results in interactive digital content.

e) Next, the target audience is segmented based on psychographic parameters and delivers the content in a first flight. The response data is then collected, and a strategy recommendation is provided.

f) Based on the strategy selected, an improved segmentation is recommended which is used in subsequent flights which improves and becomes more accurate with every single use.

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10. This Court carefully perused the records as well as the order passed by the Patent Controller. The order, to say the least is a huge disappointment as the Patent Controller was not seen to have applied his mind to the response of the appellants and the points covered in the written submissions. The operative portion of the order runs to a total of barely one page, citing the appellants' own withdrawn patent application as D1, and makes no mention of other objections or submissions advanced by the appellants to justify the claims. Such non-speaking orders go against the very object of patent and IP laws, and the principles of natural justice.

11. In the impugned order, the Controller had attempted to justify the rejection of the application citing Section 13(1)(b) of the Act. It is here that the Controller had failed to take note of the fact that D1, the prior relied upon by him to refuse the grant of patent, is a patent application filed and withdrawn by the appellants themselves. On a conjoined reading of Sections 11A, 11B of the Patents Act and Rule 24 of the Patents Rules, it is clear that a request for withdrawal may be filed within 3 months prior to the specified period of 18 months, i.e., 15 monthsfrom the date of application/priority date. In this regard, it is pertinent to reproduce the aforementioned provisions to clarify the

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position of law relating to the withdrawal of patent applications:

> ***Sec. 11A. Publication of applications. —*** *(1) Save as otherwise provided, no application for patent shall ordinarily be open to the public for such period as may be prescribed. (3) Every application for a patent shall, on the expiry of the period specified under sub-section (1), be published, except in cases where the application— (c) has been withdrawn three months prior to the period specified under sub-section (1).*
>
> ***Sec11B. Request for examination.*** *— (4) In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under subsection (1) or sub-section (3), the application shall be treated as withdrawn by the applicant:Provided that— (i) the applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner.*
>
> ***Rule 24: Publication of application****: The period for which an application for patent shall not ordinarily be open to public under sub-section (1) of section 11A shall be eighteen months from the date of filing of application or the date of priority of the application, whichever is earlier.*

12. The old patent application filed on 14.01.2019, was withdrawn on

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10.03.2020well within the time limit prescribed. Additionally, it must be noted that Forms 9 and 18A for the old application were filed on 18.01.2021 which is after the lapse of the period prescribed in Sec. 11A r/w. Rule 24. Therefore, the old patent application, one which is withdrawn should never have been undertaken by the respondent as it violates the provisions of the Act as well the principles of natural justice. Even if the old patent was to be published or examined, the Patent Office cannot do so without restoring/reinstating the old patent. Hence, the procedure employed by the respondent is in clear violation of the general procedure and established practice followed while dealing with patent applications.

13. When the respondent received Forms 9 and 18A for the old patent application, he must have either sent a notice/correspondence demanding a clarificationas to which of the applications have to be processed or must have conducted some sort of hearing to get the necessary clarification from the appellants. An erroneous filing of Forms 9 and 18A for a withdrawn application does not imply that the patent application itself has been revived/restored/reinstated.

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14. In such circumstances, an innocent party may not be allowed to suffer due to an error committed by a quasi-judicial body. In ***Inderchand Jain (Dead) through LRs. Vs Motilal (Dead), LRs.,* (2009) 14 SCC 663**, the Supreme Court observed that "*There can be no quarrel with the proposition as noted by the High Court that a party cannot be made to suffer on account of an act of the Court. There is a well-recognized maxim of equity, namely, **Actus Curiae NeminemGravabit** which means an act of the Court shall prejudice no man. This maxim is founded upon justice and good sense which serves a safe and certain guide for the administration of law*." This applies in equal force, to every statutory authority who is enjoined with a duty to decide on the rights of the citizen. Thus, the publication of the old patent application and its subsequent citation as D1 in the instant application is invalid and not in consonance with the provisions of the Act. Therefore, the objections in regard to novelty and inventive step insofar as D1 is concerned cannot be sustained.

15. Turning to the next point for consideration, though the impugned order only clutches to Section 13(1)(b) of the Act to refuse the grant of patent, it is the submission of the learned counsel appearing for the appellants that the proposed invention is not hit by Section 3(k) of the Act for the same has a

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visible technical advancementin accordance with the 2017 Guidelines for Examination of Computer Related Inventions, as well as the law laid out in ***Telefonktiebolaget LM Ericsson (PUBL) Vs Lava International Ltd***[I.A. Nos.5768/2015 & 16011/2015 in CS(OS) No.764/2015, Delhi High Court], ***Ferid Allani Vs Union of India***[2019 SCC OnLine Del 11867], and ***Microsoft Technology Licensing, LLC Vs.The Assistant Controller of Patents and Designs***, [2023 SCC OnLine Del 2772].

16. In short, the subject matter of patent appears to utilize a combination of hardware and software and streamlines user experience by enhancing the personalization of interactive digital content. It emphasizes enhancements in ad customization, message delivery optimization, and audience segmentation by incorporating psychological parameters to create cognitive data sets. Therefore, it is obvious that the present invention meets the mandates of the 2017 Guidelines for Examination of Computer Related Inventions as there isa clear technical advancement. In this backdrop, it would not be wrong to say that the invention contributes to the state of the art in its field of technology.

17. Now turning to the objections relating to clarity and conciseness of the

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claims and over-broad claims, in any case, these are formal objections and an opportunity to remedy the same may be provided to the appellants.

18. Considering that the citation of the appellants' own patent as D1 is invalid and not in consonance with the provisions of the Patents Act, 1970, and that the objection under Sec. 3(k) would not be applicable to the subject invention and ought to be waived in view of the clear technical effect and contribution, it is *prima facie* evident that the impugned order dated 19.10.2022 passed by the Respondent is a non speaking and suffers from non-application of mind, and therefore goes against not only the very objective of the Patents Act, 1970, but also the foundations of natural justice.

19. Left with little option, this Court is now constrained to set aside the impugned order of the Controller dated 19.10.2022 and remand the matter back to the respondent. To save embarrassment to the Controller who passed the impugned order, this Court requires some other Controller to examine the application of the appellant. Such Controller, who may now take up the issue, is advised to dispose of the appellants' application within a reasonable period, at any rate not later than six months from the date on which he takes

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cognizance of the application for patent. Further, the Patent Office is directed to undertake the requisite measures to expunge D1 bearing Application No. 201941001564 from the public domain, as its publication should have never been undertaken in the first place, and to prevent its erroneous citation as a prior art in any subsequent application.

20. In the result, this appeal stands allowed. There shall be no order as to costs. Consequently, connected miscellaneous petition is closed.

23.02.2024

Index : Yes / No
Neutral Citation : Yes / No
Speaking order/ Non-speaking order
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To:

The Controller of Patents
Office of Controller General of Patents
Anna Salai
Guindy Industrial Estate
Guindy, Chennai – 600 032.

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N.SESHASAYEE, J.

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CMA(PT) No.33 of 2023

23.02.2024