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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 12.02.2024

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MR.JUSTICE N.SESHASAYEE

(T)CMA(PT) No.147 of 2023

Tekelec, Inc.,
a US Corporation, 5200 Paramount
Parkway, Morrisville, NC 27560, USA. ... Appellant

Vs.

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

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Prayer : Civil Miscellaneous Appeals filed under Section 117-A of the Patents Act, 1970 to set aside the order dated 21.02.2020 refusing patent Application No.7474/CHENP/2014 under Section 15 of the Patents Act, 1970 (as amended) passed by the controller of patents and to remand the case to the respondent for further proceedings in accordance with specific directions.

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For Appellant : Mr.Narendra Reddy Thappeta
for M/s.Law Firm of Naren Thappeta

For Respondent : Mr.P.G.Santhoshkumar, CGSC

JUDGMENT

This appeal is directed against the order of the respondent dated 21.02.2020, by which it rejected the appellant's request for patenting its invention which it describes as 'performing Diameter overload control system'. The specification describes the invention as "the diameter base protocol is defined in International Engineering Task Force (IETF) request for comments (RFT) 3588, which is incorporated by reference herein in its entirety. Diameter messages use a per user framework and exist in the format of request-answer messages. Diameter answer messages travel back to the request source via the same path through which the request message was routed using hop-by-hop transport". The rejection was on the ground of lack of inventive step under Section 2(1)(ja) of the Patents Act.

2.Heard both sides.

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3.Introducing the invention of the appellant, the learned counsel for the appellant submitted that the invention is something that helps in monitoring and regulating the cellphone calls. Explaining it further with the aid of a diagram at page No.85, he submitted that when calls are made through cellphone, all the calls which are made at any point of time are routed by what is called a 'diameter agent', and it in turn routes each individual calls to different servers. In other words, the diameter agent essentially routes the various calls to different diameter servers depending on the load of each particular diameter server. Accordingly, when calls are received by a 'diameter agent', it identifies that diameter server with a lower load for diverting the calls for commencing a call session. The learned counsel added that the invention of the appellant is essentially to identify the call session of an individual call based on its evaluation of call, its priority, alerts the diameter agent in routing a call to a diameter server, and thus improves the efficiency and effectiveness of diameter server. In other words, appellant's invention may identify a less important call from the more important call, and accordingly alerts.

4.The learned counsel submitted that the registration was first resisted by the respondent in its FER, in which it cited three prior arts, namely D1, D2 and D3.

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The appellant had responded to the same as to how its invention is different from D1 to D3. This is followed by a hearing notice wherein the patent controller had given a go by to D1 to D3, and had raised a new ground which questions the existence of structural novelty in the hardware. The appellant had responded to the same, along with that he had also made some amendments to its original claim. However, in the impugned proceedings, the respondent had ignored the amended claims of the appellant, ignored his own hearing notice and went back to the three prior arts which he had cited in the FER, which implies that what was given up by the controller in his hearing notice. was revived in the order without notice to the appellant. To a pointed question, the learned counsel for the appellant, on instructions, submitted that there will not be any invasion of privacy of callers and the appellant's invention will not aid such violation of privacy.

5. This court perused the papers and finds that the patent controller literally has taken the appellant by surprise when he chose to rely on a set of prior arts which he himself had given up in his hearing notice. Very apparently and obviously, a fair hearing in tune with the hearing notice has not been accorded to the appellant, necessarily it warrants interference by this court.

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6. In conclusion, this court allows the appeal, sets aside the impugned order of the respondent dated 21.02.2020 made in patent Application No.7474/CHENP/2014 and remands the matter back to the patent controller, for a *de novo* consideration. In the eventuality of the patent controller relying on subsequent prior art invention since passing of the impugned order, the appellant will have the right to amend its claim accordingly. To save embarrassment to the patent controller who had passed the impugned order, this court directs that an enquiry on appellant's application will now be conducted by some other patent controller. Since the appellant's application was filed in 2013, in the eventuality of the appellant succeeding in obtaining patent to its invention, it will have an effective shelf life of only nine years. The Registrar is now required to dispose of appellant's application, as expeditiously as possible, but at all times after complying with all procedures contemplated under the Act. No costs.

12.02.2024

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

N. SESHASAYEE, J.

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To

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