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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 27.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT) No.209 of 2023
(OA/SR.61/2016/PT/CHN)

1.2236008 Ontario Inc
2200 University Avenue E
Waterloo, Ontario N2K0A7
Canada

2.Malikie Innovations Limited
The Gasshouses GH2
92 Georges Street Lower, Dun Laoghaire
Dublin, Ireland, A96 VR66 ... Appellants
(2nd appellant impleaded vide order dated 27.2.24
made in CMP(PT) 3 of 2024)

Vs

1.Controller General of Patents, Design,
Trade Mark and Geographical Indications
The Patent Office
Government of India
Intellectual Property Rights Building
G.S.T. Road, Guindy
Chennai - 600 032

2.Assistant Controller of Patents & Designs

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The Patent Office
Intellectual Property Rights Building
G.S.T. Road, Guindy
Chennai - 600 032 ... Respondents

Prayer : Civil Miscellaneous Appeal filed under Section 117A of the Indian Patents Act, 1970 for an order setting aside the impugned order dated 22.06.2015 made in Patent Application No.1827/CHE/2007 and an order granting patent on Indian Patent Application No.1827/CHE/2007.

For Appellant : Mr.N.C.Vishal
for Mrs.Archana Shankar
Mr.Sandeep Bhala and
N.Srivatsan
for M/s.Anand & Anand

For Respondent : Mrs.R.Durga Rani, CGSC

JUDGMENT

This appeal is preferred challenging an order of the Patent Controller dated 22.06.2015 made in Patent Application No.1827/CHE/2007, refusing to patent appellants invention titled *'File System having variable logical storage block size'*, which according to the appellants relates to a file system for use in a computer, embedded controller, processing system, or the like. More

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particularly, this invention is directed to a file system that organizes data storage space into logical storage blocks of different sizes. To explain the invention in a manner which a person with ordinary familiarity with computers and software, the invention of the appellants involves development of a software which has an identifier that would identify the size of any document that is proposed to be stored in any electronic device with a hard disk/storage facility and make suitable partitions to enable quick, easy and efficient transferability of document. The other material facts, which are relevant for the current purpose are :

- In its aplication, the appellants had made 22 claims of which four are its independent claims.
- The Controller came out with its FER wherein he has raised objection under Section 2(1)(j) and 2(1)(ja) based on four prior arts in D1 to D4. Besides he had also made an objection under Section 3(k) of the Act.
- The appellants responded to FER and also amended their claims by brining down the total number of independent claims from 4 to 2. This was followed by another examination report wherein the Controller had raised objection under Sections 2(1)(j) and 3(k). The respondent does not make any reference to any of the earlier prior arts in its Second

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Examination Report. The appellants have responded to the same and again amended their claims and brought down their claims from 22 to 19 and also the independent claims from 2 to 1.

- Thereafter, the respondent had issued a hearing ntoice wherein he reiterated his objection under Section 2(1)(j) and 3(k). The appellants participated in the hearing and have also filed their written submissions. They have also made certain internal amendments to their 19 claims.

2. The learned counsel for the appellants submitted that the impugned order is dated 22.06.2015 before the introduction of Computer Related Invention Guidelines, 2017, which makes it ampy clear that a software can be patented without refernece to a hardware. In the instant case, the Controller had delved deeply into the entire application of the appellant and found it to be a non invention under sec.3(k), which is understandable since the modification of the Guidelines came only in 2017, after the impugned proceedings of the Controller. However, he has tagged Sec.2(1)(j) to Sec.3(k) while concluding his order without stating how Sec.2(1)(j) is attracted. The learned counsel further submitted that the appellants' invention has been patented by the European Patents Office.

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3. This court finds a considerable merit in the submissions of the learned counsel for the appellants. The entire discussion in the impugned order pertains to the permissibility of recognising a certain invention of the appellant as an invention under Section 3(k). The Controller has highlighted and emphasized the fact that the invention of the appellant relates only to a software and no more and there is hardly any discussion on sec.2(1)(j). Here it may have to be stated that by the time the application has reached the final hearing stage, the Controller had given up all the four prior arts which he had initially relied on in his FER.

4. Now in view of CRI Guidelines, 2017, the only point that could be objected by the Controller has gone. This implies the appellant's invention can be patented as a software under the existing guidelines.

5. Turning to his objection under Section 2(1)(j) is concerned, the relevant line perhaps, the parting line in the order of the Controller requires to be reproduced, as below:

"Hence it is hereby decided and concluded that subject matter

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of this alleged invention represented vide claims 1-19 (system) are nothing, but pure software/algorithm/software PER-SE/programming codes represented in the form of an algorithm/in the guise of a system thereby lacking any hardware limitations, implemented and executed by software, on conventional computer/computing system, ***falls under non-patentable subject matter and hence NOT being allowable u/s's 3(k)/2(1)(j) of the Patents Act, 1970****."*

If the aforesaid concluding paragraph including the last couple of highlighted lines are closely read, the thrust of the Controller essentially relates to his objection under sec.3(k). If appellant's software cannot be treated as an invention in the perception of the respondent under Sec. 3(k), then an objection under 2(1)(j) cannot be derived from the same. For invoking Sec.2(1)(j), first the Controller must at least acknowledge that there is an invention in the first place which must fail the tests of patentability when the inventor's claim pass through the filters of second examination report. But when once the Controller holds a certain invention cannot even be considered as an invention under Section 3, then it is incongruent to construe something as an invention for the purposes under Sec.2(1)(j).

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6. In conclusion, this court allows the civil miscellaneous appeal and sets aside the impugned order of the respondents dated 22.06.2015 made in Patent Application No.1827/CHE/2007. This court now directs the respondents to patent the invention of the appellant titled *'File System having variable logical storage block size'*. No costs.

27.03.2024

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

To

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