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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 20.09.2023

CORAM:

THE HON'BLE MR. **JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT).No. 21 of 2023
&
CMP.No. 17945 of 2023

MICROSOFT TECHNOLOGY LICENSING, LLC
One Microsoft Way, Redmond,
Washington 98052,
United States of America ... Appellant

Vs.

1. THE CONTROLLER OF PATENTS AND DESIGNS
   The Patent Office,
   Intellectual Property Building,
   GST Road, Guindy, Chennai-600032
2. The Assistant Controller of Patents and Designs
   The Patent Office,
   Intellectual Property Building,
   Plot No.32, Sector 14,
   Dwarka, New Delhi-110078 ... Respondents

PRAYER : This Civil Miscellaneous Appeal filed under Section 117A of the Patents Act, 1970 (as amended by the Tribunals Reforms Act, 2021, published in the Gazette of India dated 13

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August 2021) prays to (1) allow the present appeal; (2) set aside the order passed by the Respondent No.2 dated 26.07.2021 in Patent Application No.3211/CHENP/2010; (3) hold that the claimed subject matter of Clams 1-11 of the Patent Application No.3211/CHENP/2010 is inventive and complies with the requirements under Section 2(1)(j) of the Patents Act, 1970 and is thus liable to proceed to grant; (4) direct the Respondent No.2 to grant the patent and publish the grant in the journal.

For Appellant : Ms. Vindhya S. Mani
Mr.Kiran Manoharan
for M/s.Lakshmi Kumaran and Sridharan

For Respondents : Mr.J.Madhanagopal Rao, SPC

JUDGMENT

The appellant assails an order dated 26.07.2021 by which Application No.3211/CHENP/2010 for grant of patent was declined.

2. The above mentioned application was the national-phase application pursuant to PCT Application PCT/US2008/084130 dated 20.11.2008. The claimed invention was titled "Software Defined Radio Architecture". By the First Examination Report

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(FER) dated 27.03.2018, an objection was raised that claims 1 to 20 do not qualify as an invention in terms of Section 2(1)(j) of the Patents Act, 1970 (the Act), and that the said claims are not patent eligible under Section 3(k) thereof. The appellant responded to the FER on 27.09.2018 and submitted amended claims 1 to 20. Pursuant to a hearing on 19.04.2021, the impugned order was issued. Hence, this appeal.

3. Learned counsel for the appellant referred to the impugned order and pointed out that the operative part thereof is limited to pages 56 to 58 of the paper book. In page 56, learned counsel pointed out that paragraph [0032] of the prior art document D1 was reproduced. At page 57, paragraph [0003] of prior art document D2 was reproduced. Thereafter, the respondent recorded the conclusion that the application of multiplexing properties are disclosed both in D1 and D2 and that multiplexing in data exchange or communication is a very well known technology for a person skilled in the art. Paragraph [0025] of prior art document D1 was also reproduced before recording the

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conclusion that stack implementation in the alleged invention is a basic feature of the stack in data structure and does not represent technical advancement.

4. Learned counsel submitted that these conclusions were recorded without providing any reasons and by merely reproducing specific paragraphs of prior art documents D1 and D2. In the concluding paragraph, learned counsel pointed out that there is also a reference to prior art document D3 although the same was not discussed previously. Learned counsel also invited my attention to the European Search Report at page 164 of the paper book and pointed out that the prior art documents, D1 and D2, were cited. Upon consideration thereof, she pointed out that the patent was granted as evidenced by the document at page 173 of the paper book.

5. By comparing the FER in respect of the present application and the European Search Report, learned counsel pointed out that the two documents cited in the European Search

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Report are, indeed, prior art documents, D1 and D2, which were discussed in the impugned order. Therefore, learned counsel contended that, at a minimum, the impugned order is liable to be set aside and the matter remanded for re-consideration.

6. In response to these contentions, Mr.J.Madhanagopal Rao, learned SPC, submits that the claimed invention was refused a patent in view of the prior art documents, D1 to D3, and that the claimed invention would be obvious to a person skilled in the art. However, without making any concession on the merits of the matter, he is agreeable to a remand in view of the assertion that the order does not contain sufficient reasons.

7. On perusal of the impugned order, it is evident that two paragraphs of prior art document D1 and one paragraph of prior art document D2 were reproduced before recording conclusions. Such conclusions were not preceded by any reasoning and the submissions of the appellant in response to the FER were not taken into consideration. In addition, it appears that the same

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prior art documents were taken into consideration before the patent was granted by the European Patent Office. Given the fact that the test of obviousness is common across jurisdictions, when the same prior art documents were considered by the European Patent Office, at a minimum, it is a material consideration while deciding the application. Since the order impugned herein does not contain reasons and there is no evidence of consideration of the fact that the same prior art documents were construed as not leading to the claimed invention, the impugned order cannot be sustained. Consequently, CMA(PT) No.21 of 2023 is allowed, the impugned order is set aside and the matter is remanded on the following terms:

(i) An officer other than the officer who issued the impugned order shall re-consider the matter on remand so as to preclude the possibility of pre-determination.

(ii) While re-considering the matter, the fact that the same prior art documents were considered by the European Patent Office should be taken into consideration and dealt with.

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(iii) Upon providing a reasonable opportunity to the appellant, the application shall be disposed of by a reasoned order within a maximum period of four months from the date of receipt of a copy of this order.

(iv) There shall be no order as to costs. Consequently, connected miscellaneous petition is closed.

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Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No

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