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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 23.02.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT) No.154 of 2023
(OA/37/2020/PT/CHN)

Sharp Kabushiki Kaisha
22-22, Nagaike-Cho
Abeno-ku, Osaka-shi
Osaka 545-8522
Japan ... Appellant

Vs.

Assistant Controller of Patents and Designs
Government of India, Patent Office
Intellectual Property Rights Building
GST Road, Guindy
Chennai - 600 032 ... Respondent

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Prayer : Civil Miscellaneous Appeal filed under Section 15 of the Patents Act, 1970 to set aside the impugned order dated 11.12.2019 passed by the respondent in Indian Patent Application No.1157/CHENP/2011 and allow the patent application.

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For Appellant : Mr.P.V.Balasubramanian, Sr. Counsel
for M/s.Depenning and Depenning

For Respondent : Mr.K.Subburanga Bharathi

JUDGMENT

Having lost its application for patenting its invention titled "Communication System, Mobile Station Device, and Communication Method" under Sections 2(1)(ja), 3(k), 10(4) and 59 of the Indian Patents Act, 1970 (in short 'the Act'), the applicant before the Patent Office, is now before this court with this appeal.

2.The facts are as below:

- The appellant's invention relates to a communication system, a mobile device, and a communication method. It further explains its invention as a mechanism to provide communication system that can reduce information to be transmitted from a base station device of a cellular service to the mobile station device for rapid initiation of communication.
- In his application, the appellant had made 12 claims of which, one is its

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independent claim. The respondent eventually came out with its FER wherein it cited two prior arts, D1 and D2. The resistance in essence was under sec.2(1)(ja) and 10(4) of the Act. The appellant responded to the FER and made an amendment to its claims, and brought it down to 8 from 12. This was followed by a hearing notice issued by the respondent wherein it retained both the prior arts cited in its FER. In the hearing notice, the respondent included its objection under Sec.59 of the Act as well. The appellant had participated in the hearing and filed his written submissions. Along with the same, the appellant had made further amendments to its claims and brought it down to 2 from 8.

- Vide this impugned order dated 11.12.2019, the Controller had rejected appellant's claim, in which it included Sec.3(k) of the Act as an additional ground of rejection.

This is now under challenge.

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

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4. The learned counsel for the appellant made the following submissions:

- So far as the ground of rejection under Section 3(k) of the Act is concerned, it was never disclosed in the FER and the hearing notice and hence the appellant never had an opportunity to meet it.
- So far as the objection under Sec. 2(1)(ja) of the Act is concerned, the Controller essentially relies on two prior arts, both of which have little relevance to the invention of the appellant. While D1 relates to communication between a base device and a mobile device when the mobile device is on motion. D2 deals with an invention that enables the mobile user to access the base station unhindered by any pre-configured channels. In other words, the invention in D2 enables free channels for all.
- So far as the appellant's invention is concerned, it neither involves anything to do with a moving mobile device as in D1 or establishing connect to a common channel as in D2. It essentially deals with rapid initiation of communication between base station and the mobile device through a channel. The Controller appeared to have read some commanality in the invention of the appellant, where there is nothing.

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- So far as the objection under Sec.59 of the Act is concerned, the last amendment made along with the filing of the written submission itself brings it outside the purview of Sec.59. Apparently, the respondent has overlooked it.
- Turning to the objection under Sec.10(4) is concerned, contrary to the finding of the Controller that the appellant has not adequately made clear whether the invention involves a hardware or a software, in claim No.1, as finally amended, it is made amply evident that the invention of the appellant involves both hardware and software even though the words 'hardware' and 'software' were not explicitly stated. Indeed in the written submissions this was made clear. Yet another time, the Controller has overlooked it.
- Turning to the objection under Sec.3(k) is concerned, the appellant was literally taken aback since it was never raised either in the FER or in the hearing notice.

5. This court, carefully weighed the submissions of the appellant counsel and also perused the papers. It is indeed disappointing to note that the appellant has

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established its case on all the four grounds, which the controller with some degree of care, could have easily avoided. Necessarily, this court is constrained to interfere and chooses to set aside the impugned order of the Patent Controller.

6. To conclude, this appeal is allowed. The impugned order of the respondent dated 11.12.2019 passed in Indian Patent Application No.1157/CHENP/2011 is set aside. The matter is remanded back and the matter will be heard by another Controller. Since the application was filed sometime in 2011, it is imperative that the appellant's application is disposed of by the Controller, who would now be the in-charge of the same, within a period of six months from the date on which he/she takes cognizance of the application. No costs.

23.02.2024

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

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