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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 19.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT) No.168 of 2023
(OA/SR.40/2020/PT/CHN)

Qualcomm Incorporated
5775, Morehouse Drive
San Diego, California 92121-1714
United States of America
Address for Service in India
Remfry & Sagar
Remfry House at the Millennium Plaza
Sector 27, Gurgaon - 122 009, NCR ... Appellant

Vs

The Controller General of Patents and Designs
The Patent Office, Boudhik Sampada Bhawan
Plot No.32, Sector - 14
Dwarka, New Delhi - 110 078 ... Respondent

****

Prayer : Civil Miscellaneous Appeal filed under Section 117-A(2) read with Section 15 of the Patents Act, 1970 to call for the records of the Patent Application No.3484/CHENP/2009 relating to the impugned order; to set aside

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and quash the impugned order dated 18.10.2019 as unjust, illegal and arbitrary and for a direction to the respondent to grant patent on the Patent Application No.3484/CHENP/2009 by allowing the present appeal.

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For Appellant : Mr.Vineet Rohilla and Mr.D.Subbin for M/s.Remfry and Sagar

For Respondent : Mr.J.Madanagopal Rao, SPC

JUDGMENT

Having lost its application for patenting its invention titled *"Pilot Transmission in a Wireless Communication System"* under Sections 2(1)(j) and 3(k) of the Patents Act, 1970 (in short 'the Act'), the applicant before the Patent Office, has approached this court with this appeal.

2. The invention of the appellant, to the extent it may be explained to a lay person, involves developing a Nano-Processor which would be part of a mobile phone, and this processor enables the mobile phone to send what the appellant terms as a pilot signal, whose purpose is to identify that base station (Cell Phone Tower) which gives the optimum connectivity and enables

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synchronization of the mobile station or the terminal station (that is how a mobile phone is technically described) with the chosen base station. The other facts material to this case may now be bullet pointed:

- In its application, the appellant had made 49 claims of which 8 are its independent claims and the rest are dependent claims. It evoked objection as to its patentability by the respondent under Section 3(k) as well as under Section 2(1)(j) for which the Controller drew support from four prior arts in D1 to D4.
- The appellant had responded to the FER and made certain internal amendments to its claims. This was followed by a hearing notice in which the respondent had retained both his grounds of objection which he had earlier raised in the FER. The only change is that he gave up the citations in D1, D3 and D4 to which he had made reference in his FER, and confined his objection based only to D2. (However, in his hearing notice, the Controller had referred to its earlier D2 as D1. For narrative convenience, this court will also refer the citation relied on by the Controller in his hearing notice as D1).
- The appellant participated in the hearing and also amended its claims. In

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all, it would now make 32 claims of which 5 are its independent claims. In the end, the Controller had passed an order as outlined in the opening paragraph of this order. Hence the applicant is before this court with the appeal.

3. The learned counsel for the appellant made two pointed submissions:

(a) Whereas in the Claim No.1, the appellant has described it as one involving at least one processor but the Controller appears to have overlooked the same and has treated the appellant's invention as involving exclusively some software, and hence he had fallen back on CRI Guidelines, 2016 and had raised an objection that the invention of the appellant was not backed by a hardware. The error committed by the respondent is too apparent, since at the time when he passed the impugned order, the CRI Guidelines, 2016, had already been replaced by CRI Guidelines, 2017, which does not require any hardware support to obtain patent for a software. And irrespective of the same, the appellant did indicate in his first claim that its invention involves a processor, which implies the appellant's invention has a hardware as part of its invention.

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(b) Turning to objection under Section 2(1)(j), the Controller has relied on paragraphs 402 to 409 of D1 to hold that the appellant's invention lacked novelty, and it also lacked inventive steps, within the meaning of Section 2(1)(ja) of the Act. However, the hearing notice does not refer to Sec.2(1)(ja). Even if it is kept aside, the Controller, through his order informs that the afore referred to paragraphs 402 to 409 of D1 supposedly deal with a scrambling sequence which is an aspect of the pilot signal, which the appellant's invention generates but it is simply not there in those paragraphs.

3.2. Having made his submissions as above, the learned counsel added that the appellant's invention has been patented in other jurisdictions, and in all, it has patent in 18 countries including the United States of America, where it has priority. The learned counsel added that D1 which the respondent has relied on to deny the appellant a patent to its invention, had been considered by the U.S. Patent Office, before it proceeded to grant patent to appellant's invention.

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4. This court carefully weighed the submissions of the learned counsel for the parties and also considered its alongside the material papers provided to this court. This court must record that the appellant has satisfied this court on both the grounds. Vis-a-vis his objection under Section 3(k), the Controller is surely on the back-foot for which he was in egregious error in relying on the CRI Guidelines, 2016 as well as overlooking the fact that even in its first claim, the appellant had introduced its processor. Turning to the other objection under Section 2(1)(j), the Patent Controller requires one to believe that paragraphs 402 to 409 of D1 actually deal with scrambling sequence, whereas this court could not find any reference made to it in these paragraphs.

5. The conclusion is to state the obvious. The matter may have to be remanded back to the Controller for a *de novo* consideration.

6. To conclude, this appeal is allowed. The impugned order of the respondent dated 18.10.2019 passed in Indian Patent Application No.3484/CHENP/2009 is set aside. The matter is remanded back and the matter will be heard by another Controller. Since the application was filed sometime in 2009, in the eventuality

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of the appellant's invention obtaining patent, it will have an effective shelf value of little over five years. This court, therefore, requires such of the Controller, who may now be in-charge of the matter to dispose of the same, within a period of six months from the date on which he/she takes cognizance of the application. No costs.

19.03.2024

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

To
The Controller General of Patents and Designs
The Patent Office, Boudhik Sampada Bhawan
Plot No.32, Sector - 14
Dwarka, New Delhi - 110 078

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