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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 05.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

CMA(PT) No.41 of 2023

Microsoft Technology Licensing, LLC.,
One Microsoft Way
Redmond, Washington 98052
United States of America ... Appellant

Vs.

1.The Assistant Controller of Patents & Designs
Patent Office Kolkata
Boudhik Sampada Bhawan
CP-2 Sector V, Salt Lake City
Kolkata - 700 091

2.The Assistant Controller of Patents
Patent Office Intellectual Property Building
G.S.T. Road, Guindy
Chennai - 600 032 ... Respondents

Prayer : Civil Miscellaneous Appeal filed under Section 117A of the Patents Act, 1970 against the order of the 2nd respondent dated 28.09.2022 and set aside the same and direct the 2nd respondent to allow the Indian Patent Application Number 4866/CHENP/2015 filed on August 10, 2015.

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For Appellant : Mrs.Gladys Daniel

For Respondent : Mr.P.Mahadevan for R1 & R2

JUDGMENT

The appellant having lost its application for patenting its invention titled as '*METHOD AND APPARATUS FOR TRANSMITTING A PHYSICAL DOWNLINK CONTROL CHANNEL (PDCCH) IN A MOBILE COMMUNICATION SYSTEM*', has approached this Court with this appeal.

2. The brief facts are :

a) On 10.08.2015, the appellant had made its divisional application for patenting its invention with 19 claims. Along with its application, it has also filed Form-3, disclosing the application it had made under other jurisdictions as mandated under Section 8 of the Patents Act.

b) This was followed by FER with citations (D1 to D3), whereupon the appellant had offered its response and brought down the total number of claims from 19 to 12.

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c) This was followed by a hearing notice dated 26.08.2022. In the hearing notice, the respondent retained D1 to D3.

d) On 12.09.2022, there was a hearing, and on 28.09.2022, the application was dismissed. The grounds for dismissal are as below :

i. that the appellant had not filed Form-3, which is required to be filed under Sec.8 of the Act.

ii. the divisional application that the appellant had filed on 10.08.2015 is covered by the original application; and

iii. that the claim exceeds the original specification, and the same is impermissible under Sec.59 of the Act.

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

4. The learned counsel for the appellant submitted that:

(a) The appellant had filed atleast three Form-3s. The first was on 10.08.2015, the second was on 16.11.2015, and the last one was on 17.11.2021. However, the respondent had overlooked the same and had entered a finding as if the appellant had not filed any Form-3.

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(b) So far as the second ground for rejection which is to the effect that the divisional application is covered by the parent application is concerned, the appellant in its written submissions filed on 26.09.2022, has listed atleast 19 distinctive features that distinguishes the parent application from the divisional application.

(c) Turning to the last ground that the amended claims exceed the original specification is concerned, the specific allegation is that there is no reference to UE equipment in the main specification, whereas this has been pointedly brought to his notice in the written submissions.

5. The learned counsel for the respondents submitted that the appellant has preferred a review and even during the pendency of the review, this appeal has been preferred and challenged the very maintainability of this petition.

6. If the submissions of the learned counsel for the appellant is scrutinised, it essentially highlights two aspects: (a) that the controller has not applied its mind to the facts and materials before it; and (b) that the super fast disposal of the application was done in abut 48 hours, ignoring a 155 page written

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submissions.

7. Now, even if the review petition were to be considered, they can be considered only under these two grounds, which implies the appellant will only seek fresh application of the mind by the Controller to the facts. Review in this scenario can be a technical impediment. The learned counsel submitted that she would withdraw the review petition within four weeks from today. The said statement is recorded.

8. This court does not want to stand on hyper-technicality essentially because non-application of mind by the Controller is far too palpable. Therefore, in the larger interest of justice of the case, this court deems it appropriate to assume jurisdiction, more so, when the counsel for the appellant had given an undertaking to withdraw the review now pending before the Controller.

9. In conclusion, this court allows the civil miscellaneous appeal and sets aside the impugned order of the second respondent dated 28.09.2022 made in Indian Patent Application No.4866/CHENP/2015 filed on August 10, 2015 and remands the matter back to the Controller for a *de novo* consideration. To save

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embarrassment to the Controller who passed the impugned order, this court, now requires some other controller may consider appellant's application for grant of patent. Since the application was filed some 8½ years ago in August, 2015, this court directs the controller, who would now be in-charge of the issue to dispose of the matter, as expeditiously as possible, at any rate not later than six months from the date on which he takes cognizance of the issue. No costs.

05.03.2024

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

To

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