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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 14.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT)/64/2023
(OA/14/2021/PT/CHN)

VOICEMONK INC
1063 Morse Avenue Apt 9-100
Sunny vale CA 94089 ... Appellant

Vs.

Controller General of Patents, Designs & Trade Marks
Patent Office
Intellectual Property Building
G.S.T Road, Guindy
Chennai 600 032 ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) is filed under Sections 117 A of the Indian Patents Act, 1970, praying to reverse the order of the respondent dated December 23, 2019, issued in the matter of patent application number 201944001284, and grant the patent in favour of the appellant.

For Appellant : Mr.Ramesh Ganapathy
for Mr.Karthik Puttaiah

For Respondent : Mr.M.Karthikeyan
Senior Panel Counsel

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JUDGMENT

Aggrieved by an order of the respondent rejecting its invention titled 'System and method for recommending actions on a device' which relates to data processing, more particularly, but not exclusively, relates to a system and method for content and action recommendation based on user behaviour, under Sections 10(4), 3(k) and 2(1)(j) of the Indian Patents Act, 1970, the applicant before the Registrar has approached this Court with this appeal.

2.Given the scope of this litigation and the outcome to be arrived, this Court considers that there is no necessity to labour hard on delving into the facts in great detail. It may broadly be stated that appellant's invention involves Augmented Reality (AR) which enables to develop a personalised module for one who put his device to multiple applications. Along with his application, the appellant had made 17 claims, of which 3 are his independent claims. The rest of the facts are:

- To the application made, after the examination, the Controller came up with its FER, wherein he raised 3 principal objections:

  (i) objection under Section 2(1)(j) back by prior arts D1

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and D2;

(ii) objection under Section 3(k); and

(iii) objection under Section 10(4) on the ground that the claim lacks clarity;

The appellant responded to the same and amended its claims, brought down the total number of claims from 17 to 16, and restricted its independent claims to the first claim alone.

- The Controller would now issue his hearing notice, where he retained its earlier objections raised in the FER. In addition to that two prior arts which he referred to in the FER, he added one more (D3, in his hearing notice). The appellant participated in the hearing and submitted his written submissions and there were no further amendments.

3. The Controller in his order rejecting the appellant's application has essentially laid emphasis on lack of clarity of the appellant's claim and proceeded to state that owing to lack of clarity he is not able to appreciate

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appellant's claim vis-a-vis his objections raised under Section 2(1)(j) and Section 3(k) of the Act. To state it differently, the Controller had made Section 10 as a denominator wherein he tried to fit in both his objections under Sections 2(1)(j) and 3(k), but he cannot.

4.Heard both sides. The learned counsel for the appellant submitted that the appellant is inclined to make necessary amendments to facilitate the Controller to appreciate its invention and also to enable him to convince himself that its invention is not hit by either Section 2(1)(j) or by Section 3(k).

5.In view of the statement of the learned counsel for the appellant, this Court deems it appropriate to grant liberty to the appellant to amend its claims suitably and to re-agitate the matter before the Controller. On a perusal of the impugned order, this Court also finds that the learned Controller had not adequately updated himself vis-a-vis the march of law, more particularly the

Computer Related Invention Guidelines (CRI Guidelines 2017), which now

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enables the Controller to examine the patentability of any invention on software unsupported by hardware.

6.In view of the same, this Court deems it necessary to set aside the order of the Controller dated December 23, 2019 and remands the matter back to him. To save embarrassment for the patent controller who passed the impugned proceedings, this Court directs that the application be now considered by another controller. Such Controller who would now take cognizance of the application of the appellant is required to consider the same in the light of prevailing CRI Guidelines, 2017. The appellant is directed to file his amended claims within a period of eight (8) weeks from today.

7.In the result, this appeal stands allowed. There is no order as to costs.

14.03.2024

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N.SESHASAYEE , J.

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