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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 18.06.2024	Pronounced on: 21.06.2024

CORAM:

THE HON`BLE MR.JUSTICE P.B.BALAJI

(T) CMA (PT) No.211 of 2023

Microsoft Technology Licensing, LLC
(Earlier Microsoft Corporation (Assignor),
One Microsoft Way,
Redmond, Washington 98052-6399,
United States of America,
Represented by:
Mr.Prashant Phililips,
B-6/10, Safdarjung Enclave,
New Delhi.

.. Appellant

..Vs.

Deputy Controller of Patents and Designs,
The Patent office,
G.S.T. Road, Guindy,
Chennai – 600 032.

.. Respondent

Prayer: This appeal came to be numbered by transfer of IPAB Case SR. No.95/2018/PT/CHN from the file of the Intellectual Property Appellate Board, Chennai praying this Court to call for records, quash and set aside the order of the Deputy Controller of Patents and Designs dated 08.05.2018 in 4759/CHENP/2009 and to hold that claimed invention in the present case is patentable subject matter and to direct the Controller to grant the patent.

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For Appellant : Ms.S.Vindhya for
for M/s.Lakshmikumaran and
Sridharan

For Respondent : Mr.S.Janarthanan,
Senior Panel Central Government
Standing Counsel

JUDGMENT

The appellant, aggrieved by the rejection of the Patent Application by the respondent has preferred the present Appeal.

2. The appellant filed Patent Application on 12.08.2009 and after the First Examination Report came to be issued on 30.08.2016, the appellant also filed its amended claims and a hearing was conducted and the submissions on the side of the appellant were also advanced. However, the appellant's Application for grant of Patent was rejected, as against which the appellant preferred the Appeal originally before the Intellectual Property Appellate Board (IPAB) and subsequently the same has been transferred to the file of this Court in the above (T) C.M.A (PT) No. 211 of 2023.

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3. I have heard Ms.S.Vindya for M/s. Lakshmikumaran and Sridharan, learned counsel for Appellant and Mr.S.Janardhanan, learned Senior Panel Central Government Standing Counsel, for the Respondent.

4. The learned counsel for the appellant would take me through the impugned order passed by the respondent, rejecting the appellant's Application. She would invite my attention to Section 3(k) and Section 2(1)(ja) of the Patents Act, 1970 and contend that though the respondent has held both these Sections against the appellant, the respondent has not objectively tested the Application of the appellant in a proper perspective. She would also state that the respondent has merely summarized the appellant's case and without assigning any reasons and testing the appellant's invention in the light of prior art, the respondent has summarily rejected the appellant's claim. She would therefore persuade me to remit the matter to the respondent for fresh consideration as a preliminary submission, without going into the merits of the Patent Application.

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5. I have heard the learned counsel for the respondent on this preliminary issue as well.

6. On going through the impugned order rejecting the Patent, I find, as rightly contended by the learned counsel for appellant, that the respondent, though held lack of inventive steps, has not even discussed the prior art in Exhibit D1. Further, even though the respondent has concluded that Section 2(1)(ja) and Section 3(k) of the Patents Act, 1970 would stand in the way of granting Patent to the appellant, I do not find any reasons substantiating the ultimate decision of the respondent and under these circumstances, I deem it fit and proper to remit the matter to the respondent for fresh consideration, after affording an opportunity to the appellant to putforth further submissions apart from what have already been placed before the respondent Controller.

7. In view of the matter being remitted to the respondent and in order to avoid any embarrassment to the parties, I direct the Patent Application to be considered by a different Patent Controller, that is, any other Patent

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Controller other than the person who decided and rejected the appellant's Application by the impugned order dated 08.05.2018. The respondent shall endeavor to dispose of the Application within a period of four (4) months from the date of receipt of the copy of the order.

8. In fine, this Appeal is allowed with the above direction. No costs.

21.06.2024

Index : Yes/No
Speaking/Non-speaking order
rkp

To
Deputy Controller of Patents and Designs,
The Patent office,
G.S.T. Road, Guindy,
Chennai – 600 032.

P.B.BALAJI,J.

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