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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 02.07.2024

CORAM:

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

(T) CMA (PT) No.199 of 2023

Nokia of America Corporation
600-700, Mountain Avenue,
Murray Hill, New Jersey 07974-0636,
USA.

.. Appellant

..Vs.

Assistant Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy.

.. Respondent

Prayer: This appeal came to be numbered by transfer of IPAB Case SR.No.38/2019/PT/CHN from the file of the Intellectual Property Appellate Board, Chennai praying that the order dated 04.02.2019 issued by the respondent be set aside and the Application No.61/CHENP/2009 for patent be allowed to proceed to grant.

For Appellant : Mr.P.V.Balasubramanian,
for M/s.De Penning & De Penning
For Respondent : Mr.S.Janarthanam,
Central Government Standing Counsel

J U D G M E N T

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This Appeal has been preferred against the rejection of the Patent Application of the appellant in Patent Application No.61/CHENP/2010 dated 04.02.2019.

2. I have heard Mr. P.V.Balasubramanian, learned Senior Counsel for M/s.De Penning and De Penning and Mr.S.Janarthanam, learned Senior Panel Central Government Standing Counsel for the respondent.

3. According to the learned Senior Counsel, Mr.P.V.Balasubramanian, the order impugned is a non speaking order and there is absolutely no discussion about the invention and as to how it is hit by obviousness to a person skilled in the art. He would take me through the impugned order and point out the lacuna regarding discussion with regard to the invention claimed and the prior arts also cited and that absolutely no independent reason has been assigned by the respondent/Patent Controller in coming to the conclusion that there is no novelty or inventive steps under Section 2(1(j)) of the Indian Patents Act, 1970.

4. The learned Senior Counsel would also submit that Form-3 was

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filed along with the Application. The invention has been patented in several other countries and this fact also has not been taken note of by the respondent and while rejecting the Application, the respondent ought to have been extra careful since the very same technology has been patented by several other countries.

5. Per contra, Mr.S.Janarthanam, learned Senior Panel Central Government Standing Counsel would submit the order was passed after considering the submissions made on behalf of the appellant. He would contend that it is a speaking order and he would take me through the concluding portions of the impugned order dated 04.02.2019 and submit that there is no necessity or warrant seeking remand.

6. I have carefully considered the rival submissions advanced by the learned counsel for the Appellant and the respondent/ Assistant Controller. I have also perused the entire records, including the impugned rejection order passed by the respondent.

7. It is clear that the after extracting the prior arts, D1 & D2, the respondent/Controller has merely come to the conclusion that the technical

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glitches and additional journey time can be calculated by a person skilled in the art by combining teachings of citations D1, D2 & D3. However, he has not tested the prior arts in the light of the invention claimed. In fact, written submissions have been filed distinguinshing the prior arts. This was also not taken into consideration by the respondent. I therefore feel it to be a fit case for remand.

8. In fine, the Appeal is allowed and the matter is remitted to the respondent for fresh consideration, in accordance with law and after affording an opportunity, by way of a hearing to the Appellant, by a different Patent Controller. Such an exercise shall be completed within a period of four (4) months from the date of receipt of the copy of this judgment. No costs.

02.07.2024

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

To

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P.B.BALAJI,J.

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