

(2021) 02 IPAB CK 0014

Intellectual Property Appellate Board, Chennai Circuit Bench At Kolkata

Case No: Original Application No. 18 Of 2020/PT/MUM

Tata Consultancy Services
Limited.,

APPELLANT

Vs

Assistant Controller Of Patents
And Designs,

RESPONDENT

Date of Decision: Feb. 13, 2021

Acts Referred:

- Indian Patents Act, 1970 - Section 2(1)(j), 2(1)(ja), 15, 117A
- Patents Rules, 2003 - Rule 28(7)

Hon'ble Judges: Dr. B.P. Singh, Technical Member; Manmohan Singh, J

Bench: Division Bench

Advocate: Vindhya.S.Mani

Final Decision: Allowed

Judgement

1. The present appeal is filed under Section 117A of the Indian Patents Act, 1970, against the order dated 18/09/2020, passed by the Respondent,

being the Assistant Controller of Patents & Designs, under Section 15 of the Indian Patents Act, 1970, refusing to grant the Appellant's Indian patent application no. 3133/MUM/2011.

2. The appellant informed this Board that they have affected service to the respondent already.

3. The appellant has filed a miscellaneous petition for exemption of filing the original documents. Keeping in view the prevailing Covid-19 crisis, we are inclined to allow the said MP for the reasons as stated therein.

4. It is the case of the appellant that:

Â That the impugned order violates the principles of natural justice since it is a non-speaking and unreasoned order.

Â That the Respondent has failed to determine the lack of inventive step as per mandate expressed in the Act.

Â That the Respondent has concluded the lack of inventive step, without determining the "person skilled in the art", contrary to the statutory mandate.

Â That the impugned order is in manifest error of law since it holds that the invention claimed in the instant Application lacks inventive step in the light of the disclosure in Document D1.

Â That the impugned order is in manifest error of law since it holds that the invention claimed in the instant Application lacks inventive step in the light of the disclosure in Document D2.

Â The Respondent issued an Order under Section 15 of the Act, rejecting the Application no. 3133/MUM/2011. The Respondent found that the previously pending claims 1-13, and not the amended claims 1-4 submitted along with the written submissions dated 2nd March 2020, lacked inventive step under Section 2(1)(ja) of the Act in the light of prior art documents D1 and D2. Essentially, the Respondent refused the previously pending claims 1-13 of the instant Application.

5. We have reviewed the order of the respondent. The order reflects confusion in the approach of the respondent. The order of the respondent at para

7 mentions "In response to the said hearing notice, applicant has submitted claims 1 through 9 that are recited hereunder as:" But quotes only 4

claims as last submitted by the appellant. Further, we observe that confusion not only limits itself to the order of the respondent but remains even

in the amended set of claims by the appellant too, wherein they make amended claim 2 dependent on erstwhile claim 10 and amended claim 4

dependent on erstwhile claim 12 even after deleting the earlier claims.

6. We further noted that at para 4 of the order of the respondent he mentions the date of hearing and written submission alike- a further sign

of confusion.

7. We have noted that the hearing notice carried objections mainly on three grounds:

Invention u/s 2(1)(j)

Non-Patentability u/s 3

Other Requirement(s)

However, the order of the respondent talks only about the first one, though not comprehensively, leaving the other two unaddressed. The

Controller being the first adjudicating quasi-judicial body is expected to comprehensively address each and every relevant issue and annotate

his/her opinion in accordance with the Patents Act, 1970 and the Rules made thereunder.

8. Further, the operating portion of the order of the respondent shown herein under, adds up the confusion:

¶11. Therefore, after duly considering the extensive hearing submission, the cited and existing case laws and anticipation of prior documents referenced above,

1. The subject matter of claim 1 is not inventive as, at the time of invention, it would have been obvious to the person skilled in the art. Thus, in the

view of all features of alleged invention described in D1 and D2. Therefore, the subject matter as claimed in claim 1 is not inventive and

as such does not constitute an invention u/s 2(1)(j) of The Patents Act, 1970 (as amended).

2. Without prejudice, the claimed subject matter of the dependent claims 2 to 6 falls within the scope of the independent claim. Since the independent

claims are found to involve no inventive step over the cited art as detailed in the preceding paragraph, the claimed subject matter of their subsequent

dependent claims is also rendered obvious and not inventive mutatis mutandis.

3. Without prejudice, the claims 7-9,10-11,12-13 are also based on the same essential features as claimed in claims 1-6. Hence, the same

reasoning also applies, to the subject matter of claims 7-9,10-11,12-13 which, therefore, does not involve an inventive step.

12. Therefore, in view of the aforesaid, it is concluded that the subject matter of claims 1 through 13 in this instant application lacks inventive step. As

such, the substantive objection under section 2(1)(j) still holds good. Therefore, the claimed subject does not constitute an "Invention" as defined under section 2(1)(j) of The Patents Act, 1970 (as amended).

9. We have noticed that the appellant has submitted amended set of claims, retaining just 4 claims 1-4, orienting towards "method" on

02/03/2020, after hearing with the respondent. The order of the respondent was issued on 18/09/2020, much after the prescribed period of 15 days

under Rule 28(7) of the Patents Rules, 2003. Even then the occurrence of such inconsistencies reminds us whether the case is victim of

over quantifications of disposals by the Controllers or is the result of frequent shifting of cases from one Controller to another, as this case was

handled by Controller "A" at FER stage and Controller "B" at post- FER stage. In either case, there is a need to fully strengthen the

Quality Management System (QMS), not only for International Applications but for National Applications as well at IPO.

10. It is evident, therefore, that the order of respondent talks about claims 1-13 whereas the claims on record are just 4 in numbers. Hence, there is

factual inconsistency in the order.

11. We have observed that initially the application was filed with a total of 15 claims; out of which claims 1-6 were oriented towards "health data monitoring device", claims 7-9 were oriented towards "communication Device", claims 10-11 towards "method for

monitoring health" claims 12-13 towards an independent "method" and finally claims 14-15 towards "computer readable medium". In response to First Examination Report (FER), the appellant deleted

claims 14-15 and amended claim 12-13 to orient towards "method for reporting health related data" retaining claim 1-9 as it is. Later in their submission after hearing, the appellant deleted claims 1-9 and

retained only claims 10-13, re-numbering them as claims 1-4 and confusedly maintaining their previous dependency.

12. Therefore, we are not inclined to go into the merit of this case at this stage. We set aside the order of the Respondent dated 18/09/2020 and

remand back the matter to the respondent to decide the matter on merit, taking into account all the factual aspects, including further amendment of

claims, if so required, and decide the case on merit, after giving a fair opportunity to the appellant of being heard and on considering the written

submission of the appellants after such hearings under Rule, 28(7) of the Patents Rules 2003; within 3 months from the issuance of this order.

13. Keeping in view the above, the instant appeal is allowed. No cost.