
(2012) 12 IPAB CK 0001

In the Intellectual Property Appellate Board

Case No : OA/22/2009/PT/DEL And Miscellaneous Petition No. 118/2012 In
OA/22/2009/PT/DEL

Accenture Global Service GMBH

APPELLANT

Vs

Assistant Controller Of Patents & Designs And The Examiner
Of Patents

RESPONDENT

Date of Decision : 28-12-2012

Acts Referred:

Patent Act, 1970 — Section 2(1)(j), 3(k), 57

Citation : (2013) 1 MIPR 283

Hon'ble Judges : Prabha Sridevan, J;D.P.S. Parmar, Technical Member

Bench : Division Bench

Advocate : Soumitra Kumar

Final Decision : Allowed

Judgement

D.P.S. Parmar, Technical Member

1 . The appellant is aggrieved by the rejection of the patent application No. 01398/DELNP/2003 for the invention "Distributed Development Environment For Building Internet Applications By Developers At Remote Locations". The matter came up before us on 26/09/2012 and learned counsel Shri Sharad Vadehra appeared for the appellants.

FACTS:

2 . The appellants filed a National phase application No. 01398/DELNP/2003 dated 01/09/2003 with 22 claims based on a PCT application No. PCT/US02/04964. On 03.02.2004 Form 13 was filed and claims were suo moto reduced to 18 and claims 19-22 as follows were deleted.

19. A software development application services provider comprising:

a portal;

multiple development tools;
pre-built and pre-configured environments; and
applications for creating said pre-configured environments.

2 0 . A method for developing Internet-hosted business applications composed of web services, comprising the steps of:

providing a software development application services provider (DASP), including a portal with multiple developmental tools, pre-built and pre-configured environments, having unique applications for creating said environments;

customizing said pre-configured environments by generating application services tailored for a specific target hosting environment and facilitating product construction, versioning, and deployment of said application services into a production environment; and

providing an index to allow a user to utilize said application services existing on an application service provider infrastructure platform.

2 1 . A system for developing an Internet-hosted business application composed of web services substantially as herein described with reference to the foregoing description and the accompanying drawings.

22. A method for developing Internet-hosted business application composed of web services substantially as herein described with reference to the foregoing description and the accompanying drawings.

3 . In the First Examination Report (FER) dated 29/01/2008, based on the amended claims following objections, Inter-alia, were raised:-

1. Claims 1-18 do not fall within the meaning of invention as defined under section 2(1)(j) of the Patent Act, 1970 (as amended) in view of US 5907704, US 6145119, US 5911075, US 5966535 and US 6014666.

2 . Claims in essence fall within the sense of section 3(k) of the Patent Act, 1970 (as amended).

4. During the hearing the appellants submitted revised set of the claims. New Claim

19 was also added without seeking amendment under section 57. and principle claim 1 as amended is reproduced below:-

1 . A system comprising: at least one client computer (100) that includes a central processor (110), the central processor (110) controlling the overall operation of the at least one client computer (100) and;

a server (160) communicatively coupled to the at least one client computer (100) for developing an Internet-hosted business application composed of web services, the server (160) including:

a transmitter for transmitting computer code to the at least one client computer (100) the computer code serving as a representation of said business application;

a development application services provider (DASP) module (180) for customizing said business application by, generating application services and facilitating Construction, versioning, deployment, and abrogation of said application services, the DASP module (180) including estimating tools, data, modeling utilities, software development tools, testing environment support, documented methodologies, and a portal (192) for providing to the at least one computer (100) access to web application services; and a hosted production environment. (HPE) module (188) for provisioning and abrogating an environment through said DASP module, the HPE module (188) including a Remote Run-Time environment for integrating production monitoring systems and business system support and an integrator for integrating application servers, hardware, and software.

Preliminary objections of the appellant

5 . The counsel for Appellant submitted that the Respondent indicated in the impugned order that the method claims were deleted by the Applicant only after raising of the objection by the Patent Office and have therefore on their own concluded that the objections raised by the Patent Office was correct and valid. However, the Respondents overlook the fact that the method claims had been deleted from the present set of claims even before the filing a request for examination and only system claims were examined by the Examiner. Therefore, the order issued is influenced by incorrect facts and without application of mind and should be subjected to correction.

6. On the perusal of the patent office records we found that the method claims were suo moto deleted by the appellant on 03.02.2004 before the examination was carried out. This fact alone is sufficient to convince us to say that the respondent has not applied his mind based on the existing facts when he stated in the impugned order that

Now I would like to address another issue that is considered to have considerable weight in deciding the matter placed before me. The applicant during the proceedings before the patent office disowned claim to the method claim under the proscription of section 3(k) of the statute. Also, the method claim was filed as an independent claim by the applicant because it was considered by the applicant that the method claim is linked to the system set of claims by single inventive concept. Since, the inventive concept is same for both set of claims and that one has been accepted by the applicant to be under the attack of section 3(k), the second set of claims should not hold validity on the same ground. One cannot and should not mask method by system. The system is interpreted as nothing more than recital of method in a different way. It is pertinent to point out that patent is granted on the fact and not on the presentation of fact.

7 . Such a slipshod approach of the respondent is not correct and unjustified and

liable to be set aside.

8 . The counsel for Appellant submitted that respondent have relied on the examination standards in the impugned order as follows:

1. A hardware implementation performing a novel function is not patentable if that particular hardware is known or is obvious irrespective of the function performed.

2 . If the novel features of the invention resides in a set of instructions (programme) designed to cause the hardware to perform the desired operations without special adoption of the hardware or modification of the hardware, then the matter claimed either alone or in combination is not patentable.

9. The learned counsel contended that above said standards are neither mentioned in the Indian Patent Act nor in the Patent Office Manual and also there are no such guidelines by the Indian Courts in such matters.

10 . We agree with appellant that the 'Applicable Standards' relied on by the respondent to refuse the patent are neither mentioned in the Indian Patent Act nor in the Patent Office Manual or in guidelines by the Indian Courts in such matters. We find that impugned order is based on ill founded premises and far from being logical and reasonable.

11 . The Respondent passed the impugned order without giving the appellant an opportunity to amend the claims. Such an order is against the principle of natural justice and it is unsustainable in law.

12. It is the important principle of law that the quasi judicial tribunal must follow the principle of natural justice and give reasoned decision based on the facts of the case and position of the law. A person must be given an opportunity to present his case before any adverse decision is taken. We are convinced that the respondent has not applied his mind based on the existing facts and relevant provision of the patent law. Therefore, we are inclined to remand this case back to the Controller for giving the opportunity to the appellant to argue his case afresh. The respondent is directed to issue a fresh notice of hearing giving clear details of objections raised. The matter shall be decided by the Controller afresh based on the hearing conducted. Though the appellant has submitted the argument relating to the merits of the case, we are not going into the merit as we are remanding the case back to the respondent. The respondent must be given fair opportunity to the patent applicant by setting aside the impugned order. This order shall not be construed to indicate any expression on the merits of the case. The Controller shall consider the issue of patentability independently. This application shall be dealt with in accordance with law after giving opportunity for hearing to the appellant in six months time. Accordingly, OA/22/2009/PT/DEL is allowed. The Miscellaneous Petition No. 118 of 2012 for filing complete specification is also allowed. No order as to costs.