
(2020) 12 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : Original Application No. 20 Of 2020/PT/CHN

Huawei Technologies Co., Ltd.

APPELLANT

Vs

Controller General Of Patents & Designs

RESPONDENT

Date of Decision : 04-12-2020

Acts Referred:

Indian Patents Act, 1970 — Section 2(1)(j), 15, 59, 73(4), 117A

Citation : (2020) 12 IPAB CK 0002

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

Bench : Division Bench

Advocate : S Majumdar

Final Decision : Allowed

Judgement

1. The present appeal is filed under Section 117A of the Indian Patents Act, 1970, against the order dated 17/03/2020, passed by the Respondent no.3,

being the Assistant Controller of Patents & Designs, under Section 15 of the Indian Patents Act, refusing to grant the Appellantsâ?? Indian patent

application no. 490/CHENP/2011.

2. The Invention of the Appellant:

2.1 Itâ??s the submission of the appellant that the Appellantâ??s invention discloses a method as well as a device that can automatically produce

vocabulary entries from specified input acoustic data for any kind of words including special words.

2.2 In particular, the Appellantâ??s invention teaches a method for automatically generating vocabulary entries from input acoustic data (3), said

method characterized by the steps of: performing, by a device (1), an acoustic phonetic transcription of vocabulary entries of a specific type with

respect to language morphology, and a classification of vocabulary entry types with respect to language morphology on the basis of the phonetic

structure, wherein the classification of vocabulary entries is carried out in accordance with a number of predetermined types with respect to language

morphology; and performing, by the device (1), a phoneme-to-grapheme conversion which is suited for conversion of vocabulary entries of a specific

type with respect to language morphology, to derive the respective vocabulary entries comprising a pair of a phonetic transcription and its grapheme

form.

2.3 The Appellant's invention finds application in speech recognition systems, in speech synthesis systems, or in automatic processing of audio-

visual lectures for information retrieval. For example, Siri, Google Ok, Alexa, Audible etc.

2.4 TECHNICAL ADVANCEMENT OVER PRIOR METHODS AND DEVICES:

One of the unsolved problems in current speech processing systems is the presence of OOV (out of vocabulary) words, i.e., words which are not

contained in the vocabulary. The OOV words can be general purpose ones or user-specific pronunciations of known words, for example, foreign

words, family names with foreign origin or abbreviations. Most of the prior art speech recognition systems cannot detect automatically these out of

vocabulary words; instead thereof, they make a recognition error. So, a correctionist or the user identifies these out of vocabulary words and after the

identification the system can determine the corresponding input acoustic data. The user has the opportunity to add new words to the vocabulary by

simple spelling them.

2.5 Thus, the existing systems can produce automatically vocabulary entries only for standard words, i.e., words fitting to the morphology of the actual

language, but they cannot produce automatic vocabulary entries for special words having a morphology differing from the actually used language. This

makes both the process of correcting out of vocabulary words and the process of adding new words to a vocabulary cumbersome and time-

consuming.

2.6 Typically, the specific technical advancement of the Appellant's invention can be said to be the generation of special vocabulary entries having

phonetic transcriptions different from the language morphology, e.g., foreign

words (foreign language words), family names with foreign origin or abbreviations etc.

3. The Appellant has preferred this appeal on the following grounds:

3.1 The Ld. Controller ignored the technical aspect of the invention which is the key feature and focuses on the term “device” which according to him is the Centre of dispute.

Respondent erred in stating that the claimed method (claim 1) is performed through a device, has no disclosure and support in the claims, specification and drawings, since claims 9-14 has been deleted (upon discussion and as per direction of the Controller with the Ld. Controller; and in view of this, the amended set of claims with inclusion of device shall not be allowed under section 59. Therefore, the observations are solely based upon the subject matter of the method as originally claimed.

3.2 The Respondent neither considered the plethora of case laws that provide settled judicial precedents laid down on the interpretation of Section 2(1)

(j), the Manual of Patent Office Practice and Procedure and other material, nor take into account the detailed submissions of the Appellant in respect

of the prior arts cited by the patent office. The Respondent referred to certain portions of the amended principal claim and not the entire claim

whereas while supporting an obviousness objection, all features of the claim ought to be considered.

3.3 The Respondent misjudged the prior art documents in as much as document D3 is deemed by the International Searching Authority to be

“Category A” document, indicating that said document merely discloses the state of the art and is not prejudicing novelty or inventive step of the claimed invention.

3.4 The Respondent failed to appreciate that documents D1 and D3, neither alone, nor in combination disclose the features of the amended claims of

the appellant’s invention, as a whole, since features collected in bits and pieces from different prior art documents (or being known or obvious),

does not render the Appellant’s invention to be obvious.

3.5 In view of the above, the refusal of the application on the above grounds is bad and erroneous and deserves to be set aside.

4. Let’s have a look on the order of the Respondent no.3 :

4.1 The respondent no.3 mentions the objections of the hearing notice in his order dated 17/03/2020, as follows:

4.2 With regard to non- allowance of the amendment of the claims under section 59, the respondent no. 3 holds:

“In view of claims made in written submission following observations with respect to instant invention made :

The amended set of claims as addition to a device that the claimed method is performed through a device has no disclosure and upon the

considering that no such device is present and disclosed along with support in the claims, specification and drawings, claims 9-14 has been

deleted; therefore in view of this the amended set of claims with inclusion of device shall not be allowed under section 59.” Therefore the

observations are solely based upon the subject matter of the method as originally claimed.

4.3 On the issue of lack of “inventive step”, the respondent no. 3 holds as under:

“The above disclosure of cited prior art D3 clearly provide a method how to add a new unknown word to the vocabulary. Therefore in

view of disclosure in cited prior art D1 and D3 over the phenomenon in natural language processing the instant invention is not

inventive.”

4.4 The operating portion of his order is as under:

“5. The oral argument and the written submission of the agent of the applicant have been carefully considered. However without prejudice,

although the hearing submissions have attempted to address the other requirements, yet the substantive requirement of the Patents Act, 1970 i.e.

Section 2(1)(j) is not found complied with. Hence, in view of the above and unmet requirements, this instant application is not found in order for

grant.”[Emphasis added]

5. It is brought to our notice that during the hearing the appellant were asked to delete the “device” claims 9-14 by Respondent no.3. The order of

Respondent no.3 at para 4 reveals that “..and upon the considering that no such device is present and disclosed along with support in the claims,

specification and drawings, claims 9-14 has been deleted; therefore in view of this the amended set of claims with inclusion of device shall not be

allowed under section 59.â The learned counsel of the appellants was able to show that the â??deviceâ? has been described in the specification with reference to figure 1 and 5 of the accompanying drawings.

6. Therefore, getting the claims relating to â??deviceâ? deleted by the applicant and holding that no such device is present and disclosed and as such these claims 9-14 have been deleted; is not a correct assessment. The appellant mentioned that the deletion of the claims was not voluntary but as per the requirement of Controller. We, therefore, hold that these claims need to be restored.

7. Further, about other objections, the order is not very specific. It just mentions that the hearing submissions have attempted to address the other requirement but do not categorically says whether these requirements have been complied with or not.

8. On the issue of lack of â??inventive stepâ? the order has neither narrated the facts properly nor applied law and simply quoting certain paragraphs from the cited prior arts. The respondent no. 3 comes to conclusion that the invention lacks â??inventive stepâ? without following due process for determination of â??inventive stepâ?. This is not how the inventive step is determined. The procedure of determination of inventive step is well formulated in the Manual of Patent Office Practice and Procedure version 3 Available at

http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/Manual_for_Patent_Office_Practice_and_Procedure_.pdf, apart from several judicial pronouncements on the subject.

9. This Board, in recent case PHARMACYCLICS, LLC OA/46/2020/PT/DEL, has elaborately explained the procedure of determination of â??inventive stepâ? and emphasized the need for following it strictly.

10. Thus, we find that the order of the Respondent of No. 3 is erroneous on all the above discussed points. Keeping in view the above facts and circumstances, we set aside the order dated 17/03/2020.

11. We direct the appellant to file amended set of claims, including deleted claims 9-14, as they existed just prior to the hearing, within 2 week from the issuance of this order.

12. In the best interest of justice, the instant application be referred to some

other Controller in accordance with section 73(4) of the Patents Act, 1970, who shall give a fair opportunity to be heard, to the applicant and decide the case on merit, in accordance with law, taking into consideration the complete set of claims 1-14, strictly within 6 weeks from the issuance of this order.

13. The appeal is allowed. No cost.