
(2012) 12 IPAB CK 0006

In the Intellectual Property Appellate Board

Case No : OA/24/2009/PT/DEL

Telefonaktiebolaget LM Ericsson (Publ)	APPELLANT
Vs	
Controller Of Patents And The Assistant Controller Of Patents	RESPONDENT

Date of Decision : 28-12-2012

Acts Referred:

Patents Act, 1970 — Section 2(1)(j), 2(10), 3(k), 15

Citation : (2012) 12 IPAB CK 0006

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

Bench : Division Bench

Advocate : G. Deepak Srinivas, Manisha Singh, Abhai Pandey

Final Decision : Allowed

Judgement

D.P.S. Parmar, Technical Member

1 . The appellant is aggrieved by the rejection of the Patent Application No. 4411/DELNP/2005 for ""Method and System for rate control services in a

network"". The matter came up before us on 26/09/2012 and learned counsel Shri G. Deepak Srinivas, appeared for the appellants.

2 . The Appellant filed a National Phase Application 4411/DELNP/2005 dated 29.09.2005 based on an International Application No.

PCT/IB2003/005231 dated 18.11.2003 under the Patent Cooperation Treaty (PCT) claiming priority from a Swedish Patent Application 0301053-5.

On Appellant's request, the Patent Office published the said application in the Patent Office Journal dated 31st August 2007 and the examination was conducted.

3. The claim 1 as originally filed with the Patent Office read as under:

1. A method for controlling the transmission flow rate of data bits in a data bit

transfer session from a serving entity to a client, the session involving bit transfer over a wireless communications link, the method comprising:

setting up the session by providing a radio control node to establish flow rate parameters relating to the wireless link, wherein the setting up includes:

resolving addressing between the radio control node and the serving entity,

sending rate control configuration parameters to the radio control node,

generating in the radio control node an initial rate control (RC) message including initial flow rate parameters,

sending at least one initial rate control message to allow the serving entity to set initial transmission rates for the session in accordance with at least one of the initial flow rate parameters;

monitoring the wireless communication link;

based on monitoring, sending new flow rate parameters so that the serving entity can update the transmission rate of the session in accordance with the new rate control parameters.

6 . In First Examination Report (FER) to the Appellant some objections were raised which inter alia included the following objections:

1. Claims 1 to 14 and 23 to 34 do not constitute an invention under section 2(10)] of Patents Act 1970 (as amended in 2005) as the claims lacks novelty in view of cited Patent document No. WO02052800.

2 . Claim (s) 1 to 14,15-22 and 23 to 34 fall(s) within the scope of such clause (k) of section 3 of Patents Act 1970 (as amended in 2005).

3. Claims 15 to 22 relates to an invention Distinct from the Principal claim.

4. Without prejudice to the other objections, Claims 1 to 14,15-22 and 23 to 34 do not sufficiently define the invention.

5. During the prosecution of the application the claims were amended and Claim 1 as amended is as follows.

1. A method for controlling the transmission flow rate of data bits in a data bit transfer session from a serving entity (104) to a client (102), the session involving bit transfer over a wireless communications link, the method comprising:

setting up the session by providing a radio control node (126, 128, 356) to establish flow rate parameters relating to the wireless link, wherein the setting up comprises:

resolving addressing by a GGSN (130, 352b), between the radio control node (126,128,356) and the serving entity (104),

sending rate control configuration parameters by the GGSN (130, 352b) to the radio control node (126,128,356),

generating in the radio control node (126, 128, 356) an initial rate control (RC) message having initial flow rate parameters,

sending by the GGSN (130, 352b) at least one initial rate control message to allow the serving entity (104) to set initial transmission rates for the

session in accordance with at least one of the initial flow rate parameters;

monitoring the wireless communication link;

based on monitoring, sending new flow rate parameters so that the serving entity (104) updates the transmission rate of the session in accordance with

the new rate control parameters.

6. On June 9, 2009, a notice of hearing with reference to objection raised in para 2 of the First Examination Report dated 27.05.2008 VIZ.

2. Claim (s) 1 to 14,15-22 and 23 to 34 fall(s) within the scope of such clause (k) of section 3 of Patents Act 1970 (as amended in 2005).

7. The counsel for the appellant submitted that the notice of hearing did not include objection under Section 2(1)(j) of the Act as to the patentability on

the grounds of novelty, inventive steps and industrial applicability of the invention disclosed in the subject Application. Accordingly the Appellant

prepared a written submissions and oral arguments to address the objections of the Examiner that the subject matter of the invention was related to ""a

software module"" or ""a computer program per se"".

8. The counsel for the appellant submitted that even during the hearing in the subject the Respondent continued to maintain the objection which was

earlier raised by the Examiner of Patent that the invention as claimed in the Application was related to ""a computer program per se"". In addition during

the said hearing the Respondent further increased the ambit of the said objection to include that the said invention may also amount to a ""mathematical

method"" thus also not a subject matter for patent under Section 3(k) of the Act.

9. The counsel for the appellant submitted that since the objections as raised by the Respondent under Section 3(k) of the Act was confined to the

invention either being ""a computer program per se"" or ""a mathematical method"", the Appellant's confined its oral and written submissions to address

only those objections and explained that the principal claims of the present application narrated a method for controlling the transmission data bits in a data bit transfer session from a serving entity to a client wherein the session involved bit transfer over a wireless communication link. It was further submitted that the subject invention disclosed a communication session, which is set up between a client and an application server via a proxy by means of TP connection wherein the TCP connection involved transmission over a radio link in a mobile network. The mobile network reports network feedback data regarding the quality of service of the radio link transmission to the proxy. The proxy uses the network feedback to change TCP parameter settings, such as the TCP window size and segment size of the TCP connection to optimally fit the radio resource situation in order to optimize the end-user's quality of service on the basis of obtained bandwidth from the Radio Network Controller (RNC). Further the method disclosed in the Application can be implemented in a system that includes a radio access network comprising a number of Radio Base station (RBSs) and at least one Radio Network Controller (RNC). It was further submitted that the amended set of claims as filed on May 27, 2009 by the Appellant clearly recited the requisite hardware components for executing the steps disclosed in the claims and that the said invention could be industrially utilized in P2C and P2P packet switched services in a mobile system based on a transport protocol with a flow control mechanism.

10. The counsel for the appellant submitted that to the utter surprise and shock of the Appellant, the Appellant's representative on September 3, 2009 received the impugned Order from the Respondent whereby the Respondent refused to grant patent to Appellant's Application No.

4411/DELNP/2005 on the grounds and by stating that:

The method, therefore, is interpreted as having claimed in such a fashion that it represents a collection of algorithms recited in a series of steps. As

stated earlier that the algorithm(s) claimed either as such or in combination with an application has been rendered a non statutory by Section 3(k) of

the statute. The Office construes the matter with group of algorithms working together to perform steps of the method as an abstract concept not

worthy of being granted a patent protection. Therefore, claims are considered as not qualifying for a patent under the statutory proscription.

From the foregoing analysis, I believe that the subject matter of claim 1 through 26 is not a patent eligible matter. I, therefore, refuse the grant of patent under Section 15 of the Patent Act, 1970 (as amended).

11. The counsel submitted that at no point in time during the prosecution of the application or during the hearing held on July 6, 2009 before the

Respondent, the Respondent ever expressed or shown any inclination to raise objection on the claims of the Appellant's application amounting to ""a

collection of algorithms"" or ""an abstract concept"" not worthy of being granted a patent protection. On the contrary, the concerned Examiner of Patent

and the Respondent all this while raised objection only to the effect that in their view the claimed invention either amounted to a computer program pre

se"" or a mathematical method"". Accordingly, the Appellant continued to address all its averments and submission only to address those objections and

in fact, filed amended claims by incorporating and enumerating hardware enabling provisions in the invention to exhibit that the claimed invention did

not fall in the category of ""a computer program per se"" or ""a mathematical method"". At no stage of the prosecution of the subject application the

Respondent or the Examiner of Patent ever expressed their view to the effect that the claimed invention amounted to ""a collection of algorithm"" or ""an

abstract concept not worthy of being granted patent"". Had such an objection was ever raised by the Respondent during the prosecution of the

Application or during the hearing, the Appellant would have filed appropriate reply, submissions, averments, etc. addressed to those objection.

12. The counsel submitted that the impugned order therefore is in complete violation of principles of natural justice, as the Appellant had never been

informed about the nature of objections on which the Respondent refused the subject Application. In addition, knowing the prevailing ambiguity in

relation to subject matter inquiry under section 3(k) of the Act, the Appellant cautiously derived their submissions and arguments based on the facts of

the present invention and international precedents on the subject and confined its submissions only to those objections which were expressly and

explicitly made to the Appellant by the Respondent. The case laws cited by the Appellant in its written submission filed on July 6, 2009 and during the

hearing held on the said date such as VICOM Systems Application Case of 1987 and Koch & Sterzel (T26 EPO OJ 1998), etc. demonstrate that the

efforts of the Appellant was only confined to remove the objections of the Respondent that the claimed invention amounted to ""a computer program per se"" or ""a mathematical method"" under Section 3(k) of the Act.

13. On perusal of the FER and notice of hearing we found that the objections raised by the Examiner of Patent during the prosecution of the application and by the Respondent during the hearing held on July 6, 2009 was confined to treating the subject invention Claim(s) 1 to 14,15-22 and 23 to 34 fall(s) within the scope of such clause (k) of section 3 of Patents Act 1970 (as amended in 2005)."" without specifically stating whether the subject matter is (a) a mathematical method or (b) business method or (c) a computer programme per se or (d) algorithms.

14 . The Respondent while passing the impugned order surprisingly refused the subject application based on altogether new objection that ""Office construed the matter with group of algorithm working together to perform steps of method as an abstract concept not worthy of being granted a patent protection."" , without giving the appellant an opportunity to present his case in respect of this fresh objection. Such an order is against the principle of natural justice and it is unsustainable in law.

15 . We are convinced that the respondent has not given the opportunity to the appellant to present his case in respect of the objections based on which the decision is made that is ""Office construed the matter with group of algorithm working together to perform steps of method as an abstract concept not worthy of being granted a patent protection."" Therefore, we are inclined to remand this case back to the Controller for giving the opportunity to the appellant to argue his case based on the objections raised by the Controller.

16. It is the important principle of law that a person must be told before any adverse decision is taken. 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/24/2009/PT/DEL is allowed. No order as to costs.