

(2011) 09 IPAB CK 0005

In the Intellectual Property Appellate Board

Case No : M.P. No. 2/2011 In OA/18/2010/PT/KOL And OA/18/2010/PT/KOL

Touchsensor Technologies, LLC., A United States Corporation
OF 203 North Gables Boulevard, Wheaton, IL 60187, United
States OF America

APPELLANT

Vs

Controller Of Patents And Designs, Office Of The Patent
Office, Boudhik Sampada Bhawan CP-2, Sector - V, Salt Lake
City, Kolkata - 700 091. India And Ors

RESPONDENT

Date of Decision : 13-09-2011

Acts Referred:

Patents Rules, 2003 — Rule 6
Patent Act, 1970 — Section 2(1)(j), 14, 21, 117(A)

Citation : (2011) 09 IPAB CK 0005

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

Bench : Division Bench

Final Decision : Allowed

Judgement

Prabha Sridevan, J

1 . This appeal is filed against the rejection of the application for patent by order dated 10th February, 2010. It has National Phase Entry to

International PCT Application No. PCT/US2004/014970 with International filing date of May 13, 2004, in respect of an invention relating to ""Touch

Controlled Switch Apparatus Having A Two Wire Interface"", and claiming priority date of May 16, 2003 from the corresponding U.S. Patent

Application No. 60/470, 961.

2. The application for patent and complete specification and drawings were examined by the Patent Office Examiner and the First Examination

Report dated 9th July, 2008 raised 09 objections but the objection relevant for us in this case is objection No. 4.

Subject matter of claims do not constitute an 'invention' in view of the Patent Nos. US 5412255A & DE3511207A.

3 . The appellant sent their reply on 23rd February, 2009 where at Para 4, the appellant referred to the objections regarding novelty and inventive step

and submitted that claims had been revised substantially in line with the corresponding US Patent. The appellant gave reasons why the present

invention shall be considered ""novel"" and ""possessing inventive step"". The 2nd Examination Report was sent on 8th June 2009 where the objection

regarding to novelty and inventive step did not feature and five other objections were raised. The appellant had therefore assumed that his explanation

regarding novelty and inventive step had found acceptance. The appellant's counsel replied to this by their letter dated 16th June 2009. There was also

a personal discussion which proceeded that on 11th June 2009. According to the appellant, they requested whether they could meet the Assistant

Controller for further discussion. This was turned down. Therefore the appellant sent a letter dated 10th July 2009 where the appellant referred to a

telephonic conversation on 8th July 2009 where the examiner had contacted appellant and again to a meeting with the examiner on 9th July 2009

clarifying the objections raised. On 9th July 2009 ie. the same day a communication was sent by Speed Post referring to a telephonic intimation with

the counsel on 7th July 2009 pertaining to the objections and also the discussion dated 9th July 2009. A hearing was fixed on 15th July 2009. To this,

the appellant replied on 13th July 2009 stating that since the written submissions had already been given they would not be attending the hearing and

the reasoned order may be passed. Thereafter, the impugned order was passed where the grant of patent was refused because ""claims 1 to 5 do not

constitute an invention as defined under Section 2(1) (j) of the Patent Act, 1970. as it lacks novelty and inventive steps"".

4 . On 17 February, 2010, the appellant sent a letter to the Controller of Patents requesting inter alia ""Concrete proof of issuance/communication of

fresh objections on 7th July, 2009, as mentioned in the second paragraph on page 4 of the Decision dated 10th February, 2010 in as much as the official

communication dated 9th/10th July, 2009 did not refer to any of the said objections.

This request was repeated on 22nd March 2010 where it was states that :

For and on behalf of the applicant herein, we would, therefore, respectfully request you to furnish us copies of all the documents, sought for in our said letter dated 17th February, 2010, and, in particular, the said "Concrete proof" within 10 days from the date of receipt of this letter. In default, we have instructions from our overseas client, the applicant herein, to take appropriate steps before the suitable Judicial Forum to redress its grievances, which may kindly be noted.

The legal notice was also sent to the office of the Controller.

5. Aggrieved by the refusal to grant patent based on alleged telephonic conversation which according to the appellant was contrary to law, the appellant filed a Writ Petition No. 9686 of 2010 before the Kolkata High Court for quashing the arbitrary action of the Controller. The Learned Single Judge did not entertain the writ petition since an appeal was maintainable under Section 117 (A) of the Patent Act, 1970. The learned Single Judge held that all the points available in law could be raised including any statutory violation in proceedings. Against this, the appellant filed an appeal before the Division Bench. The Division Bench in M.A.T. 951 of 2010 and C.A.N. 6552 of 2010, did not differ from the view of the Learned Single Judge and expressed their desire that this Board shall dispose off the matter within a period of six months from 31.07.2010.

6. Since the Bench could be convened only after May 2011, the matter is listed before us today. We have heard the learned Senior Counsel for the appellant. He submitted that Rule 6 of the Patents Rules provides for how all notices and written communications shall be sent and it does not provide for telephonic conversation. The learned counsel pointed out the discrepancies between the contents of the letter regarding telephonic discussion on 8.7.2009 and personal meeting on 9.7.09 and what is stated in the impugned order regarding telephone discussion and personal meeting as well as the contents of the letter dated 9.7.09. It was submitted that while granting patent, the Controller undoubtedly must consider whether the alleged invention is patentable and may even go beyond the objections raised in the examination report, the applicant must always be given the opportunity to know on what grounds the Controller rejects the patent. Only when the objections are made known to applicant, the applicant will have the opportunity to answer the objection and that alone would serve the principles of natural justice.

According to the learned Senior Counsel, in the present case, the action was contrary to the Rule it was arbitrary and since there were discrepancies between the stand taken by the appellant and the respondent, it is clear that had there been a written communication, this confusion would not have arisen. In the counter statement filed by the respondent an explanation is given for the telephone conversation

On observing the above objections on 07/07/2009 i.e. adverse report to applicant, third Examination Report was issued and the Examiner was directed to intimate the above objections (third Examination Report) telephonically immediately as per Section 14 of Patent Acts 1970 since only two days time period were left for last date i.e. 09/09/2009 for putting the instant patent application in order for grant as per Section 21 of Act 1970. It is respectfully submitted that the controller is required under the Act to intimate the said objections of third examination report dated 07/07/2009 as expeditiously as possible under Section 14 of the Act which is stipulated below:-

Section 14 - Consideration of the report of Examiner by Controller:

Where, in respect of an application for patent, the report of the Examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or other documents to ensure compliance with the provisions of this Act or of the Rules made there under, the Controller, before proceedings to dispose of the application in accordance with the provisions herein after appearing shall communicate as expeditiously as possible the gist of the objections to the applicant and shall, if so required by the applicant within the prescribed period, give him an opportunity of being heard.

In view of the above, the Examiner contracted on Telephone to the agent for the applicant and intimated the above objections (a) to (e) of the third Examination Report dated 07/07/2009. These objections were of Third Examination Report dated 07/07/2009 and not the second examination report dated 08/06/2009 as contended by petitioner's/appellant's agent/attorney. On receipt of the above objections of third Examination report telephonically on 07/07/2009, Shri S. Chakraborty along with Mrs. M. Maharaj, both patent attorney met the Examiner and the official discussion held on 09/09/2009.

The statement of official discussion with Examiner on receipt of Official objections is on record as well as it is mentioned at Para No. 7 of Appellant's

letter No. Ref. PNAT11520 SC dated 10th July 2009 (Annexure-'H' at Page-91). It is pertinent to note that no amendment was carried out and stated

that same was already explained in response dated 16th June, 2009 (as Para 8 of Appellant's letter No. PNAT 11520 SC dated 10th July 2009). All

allegations contrary to above facts and developments are denied.

7 . We have considered the submissions made by the learned counsel for the appellant as well as the counter statement filed by the respondent herein.

There is no dispute that objection No. 4 of the first examination report states that the claims did not constitute an invention. It is also clear that in the

second examination report this objection does not find a place. In the letter dated 10.07.2009 Annexure-H there is a narration of what happened on

08.07.2009 and 09.07.2009.

6 . On the 8th July, 2009, the present Learned Examiner, Mr. V.A. Ambigapathy, contacted our office, over the telephone, and expressed that his

objections/requirements of the SER dated 8th June, 2009 had not been met and personal interview should be made with him on or before the 9th July,

2009 that being the deadline for putting the instant application in order for grant.

7 . Consequently, on the 9th July, 2009, the undersigned along with our dealing Attorney, Mrs. M. Maharaj, called on said Learned Examiner, Mr.

V.A. Ambigapathy, and clarified that the objections/requirements of the said SER dated 8th June, 2009, were already dealt with by our previous

response dated 16 June, 2009, and in that respect, personal discussion had been held by the undersigned with the Learned Deputy Controller of

Patents & Designs and Technical Head (Patent), Mr. D.K. Rahut on the 11th June, 2009, as mentioned in our response dated 16th June, 2009.

8 . It has been also explained to the said Learned Examiner, during said discussion, that no amendment was warranted in claim 2, as called for by the

Learned Examiner, because as already explained in our response dated 16th June, 2009 said dependent claim 2 defines a preferred/particular

embodiment of the ""apparatus"" according to the main claim 1. Moreover, it has also been explained that claims 4 and 5 are allowable according to the

universally established proposition of Law on Patents, which was also explained in our said response dated 16th June, 2009. In that context, relevant

portion of the aforesaid proposition of Law has been handed over to the said Learned Examiner, during the aforesaid discussion, which is quoted

below for ready reference

In a claim for an apparatus it is permissible in a proper case to define the physical characteristics of the article by a suitable reference to the results

which it is to achieve.

8 . In Annexure - 'I' which is dated 09.07.2009 however reference to ""telephonic intimation to Shri Samaresh Chakraborty on 7th July 2009 pertaining objections of Patent Application No. 2288/koInp/2005 and also the discussion held with him on 9th July 2009 on above subject

9 . While the appellant's letter refers to objections of the second examination report dated 08.06.2009, this letter dated 09.07.2009 merely refers to

objections. In the counter statement filed by the respondent however, which has been extracted above there is reference to a third examination report

and also the necessity to make the telephone call because of the paucity of time. This specifically denies that the objections were of the third

examination report and not the 2nd examination report.

10. In the impugned order there is no reference to a third examination report. The relevant paragraph is extracted hereunder:

09/072009: On receipt of response to the second examination report on 16/06/2009, the application was again re-examined and following objections

were issued which is communicated telephonically to the agent as stipulated below:

a) Claims as claimed in claims 1 to 5 fall under section 2(1)(j) of Patents Act, 1970 as per Para 4 of this office letter dated 9th July, 2008.

b) Claims are not clear and don't define the invention,

c) Claims 2 and 3 is beyond the scope of claim 1 which is to be deleted.

d) Claims 4 and 5 are functional claims which are not allowable.

e) Form-2 is to be filed along with complete specification.

09/07/2009: Mr. S. Chakraborty discussed on the outstanding objections with the Examiner as per telephonic conversation held on 06/07/2009 but no

amendment was made in complete specification. Besides he stated that his observations on form-2 and other objections are already given in their letter

dated 16th June 2009.

In this order, the telephonic conversation is dated 06.07.2000.

11. If we need any justification for strict adherence to Rule 6, this case provides

us. It is not necessary for the officers to face this controversy, if they had only complied with Rule 6 had sent their communications by writing. Rule 6 speaks of service a patentee or applicant or opponent through special messenger, registered post, speed post, courier service or electronic transmission duly authenticated. It does not refer to telephone messages. When, even with regard to dates, there are discrepancies, we do not think that we can brush aside the objection raised by the appellant. The appellant must necessarily know on what grounds his application for patent is rejected. From the narration of events, it is clear that we cannot safely presume that the objection was communicated to the appellant on telephone. If the objections were not communicated then the appellant did not have a fair opportunity. There is no dispute regarding fact that the communication said by telephone. Infact, even before the Hon'ble Calcutta High Court, the counsel appearing for the Union of India had tried to justify the step do not think correct. Rules especially those regarding to service of notice must be strictly complied. The impugned order is therefore set-aside. The appeal is allowed and the matter is sent back to the Controller who shall consider the application after giving an opportunity to the applicant to be heard on ""Novelty and Inventive Step"" and any other objection and decide the matter in accordance with law.