

Blackberry Limited vs Assistant Controller Of Patents And ... on 22 March, 2023

Author: Sanjeev Narula

Bench: Sanjeev Narula

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IN THE HIGH COURT OF DELHI AT NEW DELHI
C.A.(COMM.IPD-PAT) 301/2022
BLACKBERRY LIMITED

Through: Mr. Pravin Anand, Ms. A
Chakar, Mr. Kumar Abhis
Mr. Shivang Sharma, Adv

versus

ASSISTANT CONTROLLER OF PATENTS AND DESIGNS

..... Respond

Through: Mr. Vijay Joshi, Mr. Gurjas Singh
Narula and Mr. Mohit Joshi,
Advocates.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA
ORDER

% 22.03.2023 I.A. No...../2023 (to be numbered)

1. Registry is directed to number the afore-noted application.
2. Considering the fact that there has been only a short delay in filing the present appeal, application is allowed and the delay is condoned.
3. Disposed of.

C.A.(COMM.IPD-PAT) 301/2022

4. Petitioner's Indian Patent Application No. 2170/DEL/2008 for the invention "Text Selection Using a Touch Sensitive Screen of a Handheld Mobile Communication Device" [hereinafter, "subject invention"], was filed on 16th September, 2008, claiming priority since 26th October, 2007 from a corresponding European application.¹ First Examination Report was issued on 28th August, 2014, to which, Appellant responded on 13th March, 2015. Hearing was scheduled after four years on 23rd October, 2019, whereafter, vide order dated 23rd June, 2020, the Assistant Controller of Patents and Designs refused the application under section 15 of the Patents Act, 1970 [hereinafter, "impugned order"].

5. As nearly three-quarters of the twenty-year patent term have expired, the Appellant is confronted with a scenario in which, even if the questioned order were to be nullified, their battle continues. They must re-engage with the patent office to establish their invention's validity in order to secure a patent.

6. Having set out the chronology of events, let us briefly take note of subject invention and 'grounds' for rejection in the impugned order. Subject invention, comprising of 23 claims, is a method and system for facilitating character/ text selection by a user on touch screen of a handheld device where displayed characters available for selection are small enough that user contact with the screen is capable of overlapping a plurality of simultaneously displayed characters. It is intended to provide for accurate control for selection of text/ icons displayed on the touch screen.

7. The impugned order rejecting the application, has been structured as follows:

European Application No.: 07119388.2.

7.1. It begins noting the procedural history of the application. Then, in paragraph No. 2, the Assistant Controller reproduces the objections entailed in the hearing notice. Paragraph No. 3 records that Appellant's agent attended the hearing on 23rd October, 2019 and submitted written submissions on 27th November, 2019. 7.2. Paragraph No. 4 is devoted to summarising the invention and the succeeding sub-paragraphs, record the points on which Appellant laid emphasis:

"4. I now turn my attention to the claimed subject matter. The alleged invention is summarized as follows:

A system and method is disclosed that provides for character or text selection and editing. The text and character selection is made by user contact with a touch sensitive screen. In order to allow for refinement of the selection, a second expanded view is implemented as compared to the original display configuration of the screen. Furthermore, the selection is described in relation to two endpoints of the block of text. Additionally, a point is specified as the point desired for insertion of the selected text. The expanded view is implemented along with the original view as required when making character selection.

Applicant has also emphasized on following points in submitted reply document:

1. present invention provides technical effect in terms of providing an efficient system of selection of text without compromising with storage capacity and thus, making the system more robust and resource effective. It is submitted that therein lies a technical effect of the invention.

2 . The method claims do not refer to an executable list of defined instructions at all and they do not claim a logical, arithmetical or computational method at all.

Accordingly, the method claims of the present application do not fall within the scope of 3(k) as defined in the Manual of Patent Practice and Procedure."

7.3. In the subsequent paragraph (No. 5), it is mentioned that Assistant Controller was unpersuaded by Appellant's submissions in view of the following:

"5. Without prejudice to the above said, having considered the aforesaid submission, I do not find the submission persuasive in view of following:

Claims 1-18 claims mainly A method for accommodating character or text selection by a user on a touch screen of a handheld electronic device (300) where displayed characters available for selection are small enough that user contact with the touch screen (322) when making a character selection is capable of overlapping a plurality of simultaneously displayed characters, said method comprising: displaying text on a touch screen (322) of a handheld electronic device in which selectable characters are smaller than an area of user contact with the screen, said display of text constituting an original display configuration; detecting that a first area of the touch screen (322) has been user contacted, said first area encompassing a plurality of characters of which at least two have been partially covered by the user's contact with the touch screen; displaying an expanded view of the first area that has been expanded to an extent that each of the at least two partially covered characters is individually sufficiently large that only one of said at least two characters can be predominantly covered by similar user contact with the touch screen (322); detecting a first character from the at least two characters that is being selected in the first expanded view by being predominantly covered by said similar user contact with the touch screen in said expanded view; and resuming the original display configuration of the text with the first character that has been detected as being user selected in the first expanded view being signified."

7.4. Paragraph No. 6 contains the conclusion that the subject invention is not patentable. The said paragraph is extracted below:

"6. 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 3(K) is not found complied with. Hence, in view of the above and unmet requirements, this instant application is not found in order for grant Also I agree with the findings of the examiner that the subject matter as described and claimed attract the provisions of sections 2(l)(j) of the Patent Act, 1970."

8. Although the initial sentences of paragraphs No. 5 and 6 may appear to demonstrate thoughtful consideration and rationale, a more meticulous examination of the text unveils a contrasting reality. The reasons for dismissing the Appellant's arguments, as detailed in paragraph No. 5, are merely a

word-for-word replication of their own claims. Therefore, no reasoning is discernible in this paragraph. The miniscule reasoning is then found in paragraph No. 6 in the expression "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 3(k) is not found complied with. Hence, in view of the above and unmet requirements, this instant application is not found in order for grant". The above lines are the only shred of rationale in the impugned order. The Court is therefore unable to comprehend as to how this conclusion has been drawn. Simply remarking that subject invention is not patentable being a mathematical or business method, a computer programme per se, or an algorithm is not sufficient. The Controller ought to have disclosed reasons to support his conclusion. Reasoning through a speaking order is a vital aspect of the principles of natural justice and is of utmost importance, which needs to be underscored. If the patent office's orders lack proper reasoning, it may be difficult for the applicant to identify the grounds for appeal. The legal proposition that an order of such kind should be supported by reasons, needs no reiteration. Not only does this benefit the applicant, whose rights are likely to be affected, but also assists the Court in ascertaining how the concerned officer applied their minds and reached the impugned conclusion, while exercising judicial review. This Court, in an earlier decision of *SK Geo Centric Co Ltd. v. The Controller of Patents*,² observed that such reasoning should be discernible to the Court and in absence thereof, the entire order stands vitiated. In the impugned order, the Court is bewildered as to how the Controller has concluded that subject invention is hit by Section 3(k) of Patents Act and has plainly agreed with the Examiner's opinion that the claimed patent is not an invention.

9. The entire text of the impugned order has been dedicated to noting the details of the invention, claims made therein and how the proceedings were Dated 08th February, 2023 in C.A. (COMM. IPD-PAT) 241/2022.

conducted. That may be necessary, and no fault lies there; however, the crux of the issue is lack of reasoning supporting the final decision, a task at which the Assistant Controller has completely fallen short. This makes the decision arbitrary, suggesting a subjective determination without any objective criteria. Such kind of mechanical, template and cut-and-paste orders cannot sustain and must be stridently discouraged. In a recent decision of *Dolby International AB v. The Assistant Controller of Patents and Designs*,³ Hon'ble Mr. Justice C. Hari Shankar had the occasion to consider an unreasoned order of the Controller. The Judge was at pains to identify the reasoning in the order impugned therein and observed that concerned officers of the Controller of Patents and Designs office must bear in mind that question of grant and rejection of a patent is a serious matter. Indeed, these words must resonate with the authorities, and it must be ensured that Patent Controller's officers practice due application of mind while rendering decisions. Well-articulated reasons in such orders would demonstrate that the decision has been made with proper consideration and allows for more effective judicial review, if necessary.

10. The impugned order fails to satisfy the basic requirements of any order adjudicating on patentability of an invention. It is for this arbitrary approach of the Assistant Controller that the Court is not in a position to examine the impugned order on merits. Accordingly, same is quashed and set aside, and following directions are issued:

- 10.1. The matter is remanded back to the Controller of Patents for re-consideration.
- Neutral Citation No.: 2023/DHC/001854.
- 10.2. Prior to deciding the matter afresh, Appellant shall be granted a hearing.
- 10.3. Application for subject invention shall not be decided by the Officer who passed the impugned order.
- 10.4. Above exercise be completed and a fresh order be passed within a period of three months from the date of release of this order.
11. Needless to say, de novo consideration would proceed independently, uninfluenced by the impugned order.
12. The appeal is disposed of in above terms, along with pending applications.
13. A copy of the order be also brought to the notice of the Controller General of Patents, Designs and Trademarks for information and necessary administrative action.

SANJEEV NARULA, J MARCH 22, 2023 sapna (Corrected and released on 29th March, 2023)