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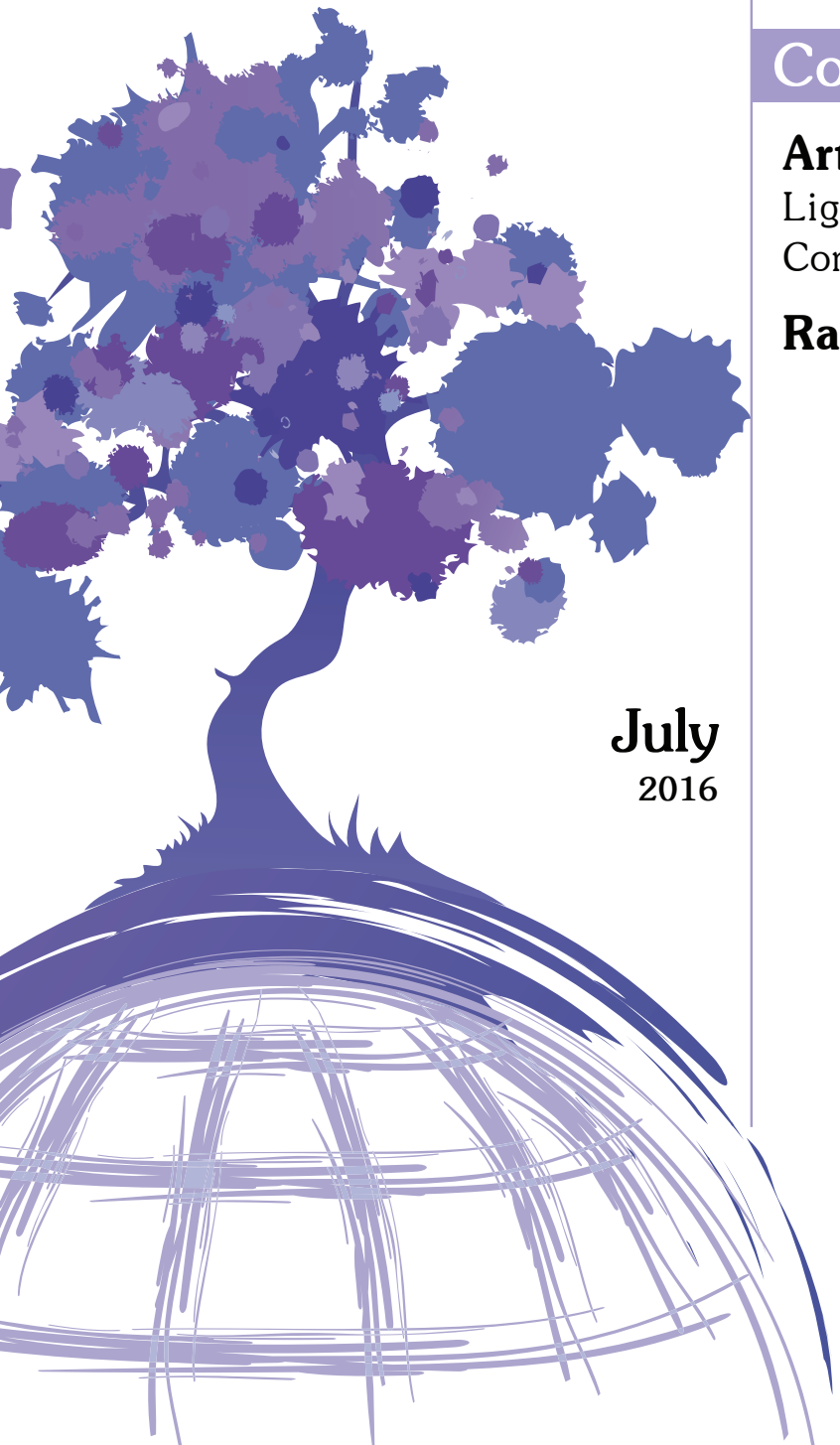

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Article

Light at the end of the tunnel for Computer-Related Inventions?

By **Mukundan Chakrapani**

In the May edition of IPR Amicus, we commented on the continued ambiguity in the examination of computer-related inventions (CRIs) by the Indian Patent Office.[1] Here, we review three recent Controller's Decisions to highlight that probably, consistency is emerging in the examination of CRIs. We hope that the Indian Patent Office will continue to apply the provisions of Section 3(k) of the Indian *Patents Act* in a balanced, transparent, and unambiguous manner consistent with the Guidelines for Examination of CRIs issued in February, 2016.

Indian Patent Application 1582/DEL/2004 entitled *'Enhanced Computer Telephony Integration and Interaction,'* describes a method and system for interfacing server computers with telephone switching devices and client computers to integrate telephone and personal computer features. Independent claim defines a computer telephony integration system comprising a telephony server; a computer network; a telephony client; and a private branch exchange (PBX). The telephony client (e.g., on a personal computer) is in communication with the telephony server via the computer network. The private branch exchange (handling telephone services) is in communication with the telephony server. A switch database residing in the telephony server stores information about a physical connection of an extension (e.g., a telephone) serviced by the PBX. A translation module also residing on the telephony server translates PBX data that the private branch understands into client data that the telephony client understands. The information in the switch database including PBX-specific parameters is used by the translation module to perform the translation. The telephony server forwards telephone action requests from the telephony client to the PBX and relays telephone events from the PBX to the telephony client.

Claim 1 and its dependent claims were sought to be rejected by the Patent Office under Section 3(k) of the *Patents Act* as being directed to computer program *per se*. Upon hearing the Applicant, the Controller, in his order dated May 25, 2016, reversed the rejection proposal and granted the application. Specifically, the Controller agreed with the Applicant that the 'the present subject matter clearly involves *a technical advancement and also does not solely lie in the excluded subject matter* as per section 3(k) of the Act [and] *as per CRI guidelines*' (emphasis added).

Indian Patent Application 1592/MUMNP/2009 entitled *'Pre-programmed Subscriber Response,'* describes a method and apparatus for providing pre-programmed

[1] Ambiguous Standard for Examination of CRIs. Online: http://www.lakshmisri.com/News-and-Publications/Publications/Articles/IPR/ambiguous-standard-for-examination-of-cris. Last accessed: July 25, 2016.

context based responses to received communications. The method is executed by an application specific integrated circuit (ASIC) on an access terminal (e.g., a mobile device). The ASIC receives and identifies a communication on the access terminal. The ASIC then associates the communication with a pre-recorded response stored on the access terminal by displaying identification information for the communication on the access terminal and a list of contexts of the access terminal (in meeting, theatre, restaurant, etc.). The ASIC receives a user selection of a context from the displayed list of contexts and in response, displays a list of pre-recorded response messages on the access terminal based on the selected context. Each pre-recorded response message is recorded prior to receiving the communication and stored on the access terminal and includes an indication to inform a recipient of the selected context. Finally, the ASIC receives a user selection of a pre-recorded response message from the displayed list of pre-recorded response messages and responds, via a transceiver, to the communication using the selected pre-recorded response message. The original claims were sought to be rejected as being directed to computer program *per se*.

The Controller, after hearing, in his order dated May 30, 2016, agreed with the Applicant's submission that the claimed subject matter provides a technical solution to a technical problem using 'various physical hardware components (technical means) in a telecommunication network cannot be construed as 'computer program per se''. It should be noted that the claims were amended to add the technical means (the ASIC and the transceiver) in the written submissions subsequent to the oral hearings.

Indian Patent Application 1564/MUMNP/2010 entitled *'A Telecommunications Network for Providing Access to a Plurality of Terminals and Method of Controlling Network Access,'* describes a method and system for time-based and network load-based controlled access to a telecommunication network. Independent claim 1 is directed to a telecommunication network configured for providing controlled access to a plurality of terminals during specified access time intervals and outside of peak load time intervals. Each terminal is associated with a unique identifier for accessing the telecommunications network. The telecommunication network includes a register configured to store the unique identifier of at least one terminal in combination with identification of at least one associated grant access time interval defining a time period during which the terminal can access the telecommunications network. An access request receiver of the telecommunication network is configured to receive an access request from the terminal and to determine the unique identifier associated with the terminal. The telecommunication network also includes an access module that denies access for the terminal if the access request is received outside the time period. The telecommunications network is further configured to monitor a network load of the

telecommunications network and to adapt the time period depending on the monitored network load. Terminals executing machine to machine applications are denied access to the telecommunications network during peak load time intervals, which are outside the grant access time period. The original claims were sought to be rejected as being directed to computer program *per se*.

During oral hearing and the subsequent written submissions, the Applicant contended that the claimed subject matter solved a technical problem using technical means and provided a technical effect. The Controller agreed with the Applicant's submission and granted the application vide his order dated May 31, 2016.

In addition to the above Controller's orders, Indian Patent Applications 1376/DEL/2004; 5428/DELNP/2006; 5754/DELNP/2007 have also been found to be directed to patent-eligible subject matter. Specifically, the Controller, in his order dated April 29, 2016 for Patent Application 1376/DEL/2004, agreed with the Applicant's submission that, in accordance with the February 2016 CRI Guidelines, 'a claim for a CRI whose contribution does not solely lie in the excluded subject matter is not excluded under Sec. 3(k)' and held that 'subject matter of claims does not fall under excluded category as per Sec. 3(k) since *contribution lies in both the computer programme as well as hardware'* (emphasis added).

The above decisions suggest that the Patent Office is slowly but steadily evolving to a settled standard for the examination of CRIs. The technical problem-solution using technical means approach as well as the technical contribution approach have been accepted by the Controllers in the determination of patent-eligible subject matter. While it is speculated that further revisions to the CRI Examination Guidelines are in progress, we hope that Controller's decisions reviewed here form the basis for inclusion of positive examples of patent-eligible claims that were conspicuously absent from the February 2016 Guidelines.

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Ratio Decidendi

Trademarks – Similarity in inverted, reversed or mirror image of logo

Bombay High Court has denied interim injunction to the plaintiff in a case involving infringement of trademarks, copyright and passing off on the ground that the logos of the plaintiff and defendant are not similar and that there is no likelihood of confusion and also that copyright infringement was not established. The Court while holding so, relied upon Supreme Court decision in the case of *Cadila* Healthcare Ltd., and observed that the test of comparisons of the marks side- by-side is not a sound one. The Court noted that there was a clear difference between the plaintiff's curve which is in round circular shape and the curve used by the defendant.

The defendant contended, successfully that

the marks should be compared as a whole. The Court further rejected the contention of the plaintiff that the defendant's logo was inverted or reversed or mirror image of their logo. It was stated that no average man with imperfect recollection was going to look at the 'rotated' mark of the plaintiff and be led to believe that the inverted or reversed or mirror image of such 'rotated' logo is deceptively similar to the defendant's logo, so as to cause confusion. [*Reliance Industries Ltd.* v. *Concord Enviro Systems Pvt. Ltd.* - Notice of Motion No. 573 of 2015 in Suit No. 309 of 2015, decided on 30-6-2016, Bombay High Court]

Trademarks – Infringement when pronunciation same though spelling different

In a suit for permanent injunction for infringement of trademark 'EXXON', Single Judge of the Delhi High Court has made the earlier ex-parte interim orders granted in favour of the plaintiff absolute. The plaintiff was using the mark in the business of petroleum and gas while the defendant was using the mark 'EXON' in the business of conducting online examination and tests. Finding that the trademark of the plaintiffs being famous and powerful, the Court held that there was a *prima facie* case for continuation of injunction orders. The Court in this regard was also of the view that *prima facie* trademark registration of the defendants would not come to their rescue.

Further, rejecting the contention that the words 'EXON' and 'EXXON' are different, the Court observed that a customer of the plaintiff will not pay attention whether the brand of the plaintiffs uses the alphabet 'X' singly or in double. It was noted that what stays in the mind would be the word 'EXXON', the pronunciation of which remains the same, irrespective of whether the alphabet 'X' is used singly or doubly. The Court granted 15 days time to the defendants to initiate steps to have the name of the company changed. [*EXXON Mobil Corporation* v. *Shailesh H Mehta* - CS(OS) 2562/2015 & IAs No.17826/2015, decided on 14-7-2016, Delhi High Court]

Trademarks – Names of Gods cannot be monopolized

The Bombay High Court has denied the grant of interim injunction in favour of the plaintiffs, in a case where the plaintiff had contended infringement of their trademark by use of the word 'LAXMI', a device or a label mark in the defendant's mark 'MAHALAXMI'. The Court in this regard held that no rights can be claimed exclusively over the word mark 'LAXMI' as it is a common word and the name of a deity. Rejecting plaintiff's submission that LAXMI is the leading, central and memorable feature of the plaintiffs' mark, the Court observed that registration had been obtained for a label or a device using a common first name of a deity. Hence, it was not possible to extract the name itself out of the label and claim any sort of exclusivity over it.

The Court was of the view that claiming a device or a label mark is one thing, while claiming a word monopoly is another. It was also held that nothing in the Trade Marks Act, 1999 allows monopolization of any of the Gods. [*Freudenberg Gala Household Products Private*

Limited v. *Gebi Products* - Notice of Motion No.1530 of 2015 in Suit No.758 of 2015, decided on 14-7-2016, Bombay High Court]

Territorial jurisdiction of High Court for filing trademark and copyright suits

A plaintiff can file a suit in a court within the local jurisdiction of which its registered office or principal office is located and that the location of the defendants and the place of accrual of the cause of action is inconsequential. The defendants argued that if it is shown that the plaintiff has another office where the defendant carries or business or resides, or where the cause of action has arisen, then the plaintiff must file the suit in that other location. The High Court opined that that the decision of the Supreme Court in the case of *Indian Performing Rights Society Limited* v. *Sanjay Dalia* [(2015) 10 SCC 161], did not rewrite the provisions of the Copyright Act or Trade Marks Act. The Court in this regard held that a plaintiff can always travel to where the defendant is located or where the cause of action arises and bring suit there invoking jurisdiction under Section 20 CPC and this has nothing at all to do with Section 134(2) of the Trademarks Act or Section 62(2) of the Copyright Act. Further, deliberating on the wordings of Sections 134(2) and 62(2), it was observed that the jurisdictional benefit of said provisions is not exclusive or exclusionary, but is an additional benefit or an additional provision. A plaintiff in a trade mark or copyright action has an additional option of instituting a suit in the jurisdiction where he has his registered office. This has nothing to do with the defendants' location or that of the cause of action [*Manugraph India Limited* v. *Simarq Technologies Pvt. Ltd.* - Notice of Motion No. 494 of 2014 in Suit No. 516 of 2013, decided on 15-6-2016, Bombay High Court]

Trademarks – No infringement when plaintiff himself using mark descriptively

Bombay High Court has denied the grant of interim injunction in a case where the plaintiffs had instituted a suit against the defendant for infringing its trademark 'GARWARE SUNCONTROL', by using the trademark '3M SCOTCHTINT SUNCONTROL'. Referring to Sections 30(2)(a) and 35 of the Trademarks Act, 1999, the Court concurred with the view of the defendant that the use of the term 'sun control' was descriptive in nature inasmuch as it only indicates the kind, quality and intended purpose of these films while describing their main characteristic, which is to block certain effects of sunlight. The Court while holding so, also noted that the plaintiff's own use of the expression was descriptive. Besides it was not shown that defendant's use was calculated to deceive and defendant had a huge international presence with well-known trademarks and huge sales.

Finally, absence of any evidence of the expression having acquired a secondary meaning was also taken note of by the Court while it held that merely because 3M's website uses 'sun control' in its domain name, it does not follow that this is used as a trade mark, or that it ceases to be descriptive. [*Garware Polyester Limited* v. *3M Company* - Notice of Motion (L) No. 1445 of 2015 in Suit No. 612 of 2015, decided on 12-7-2016, Bombay High Court]

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