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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **18.02.2025**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT)/35/2024
and C.M.P.No.12404 of 2024

Tahoe Research Ltd.,
Plaza 255 Suite 2A, Blanchardstown,
Dublin D15 YH6H, Ireland
Represented by its Authorized Signatory
Lalitha Santhanam ... Appellant

-vs-

The Controller of Patents,
The Patent Office, Chennai
Intellectual Property Office Building
GST Road, Guindy, Chennai 600 032. ... Respondent

PRAYER: Civil Miscellaneous Appeal (Patents) is filed under Section 117A of the Patents Act, 1970, pleased to set aside the order dated 19.01.2024 passed by the respondent in Indian Patent Application No.201647014734.

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For Appellant : Mr.P.Dileep Kumar
for Mr.Narendra Reddy Thappeta

For Respondent : Mr.S.N.Parthasarathy, SPC

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JUDGMENT

This appeal is directed against order dated 19.01.2024 rejecting Patent Application No.201647014734. The above mentioned patent application was for grant of patent for an invention titled "Method for training a control signal based on a stroke signal in memory module". Pursuant to a request from the patent applicant, the First Examination Report (FER) was issued on 27.09.2019. In the FER, objections were raised *inter alia* on grounds of lack of novelty and inventive step. The appellant responded to the FER on 26.03.2020; thereafter, hearing notice dated 23.02.2022 was issued. In the hearing notice, objections on the grounds of lack of clarity [Section 10(4)] and lack of novelty (especially with reference to prior art document D3) were raised. The appellant filed written submissions on 28.03.2022 and annexed amended claims 1 to 16 (current claims). Significantly, the appellant amended independent claim 1 by incorporating features of original

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claims 2 and 4 therein. As a consequence, earlier claims 2 and 4 were cancelled. The order impugned herein was issued in these facts and circumstances.

2. Learned counsel for the appellant invited my attention to paragraph 12 of the impugned order. He pointed out that the patent application has been rejected by objecting to features of independent claim 1 although such features had been incorporated earlier in original claims 2 and 4. By referring to the hearing notice, learned counsel submits that objections to the features of original claims 2 and 4 were not raised in the hearing notice. Consequently, he contends that principles of natural justice were violated as the appellant was not provided a reasonable opportunity to deal with the ground on which the impugned order was issued with reference to Section 10(4) of the Patents Act, 1970.

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3. As regards the conclusion on lack of novelty, learned counsel submits that the impugned order was substantially based on the order of the EPO. After pointing out that prior art document D3 corresponds to prior art document D1 in the proceedings before the EPO, learned counsel pointed out that the conclusion at paragraph 11 of the impugned order, especially with reference to the feature described as (b) in the impugned order is based on independent claim 1 before the EPO and not based on independent claim 1 before the Indian Patent Office (IPO). In particular, he points out that independent claim 1 in these proceedings pertains to the receipt by the memory controller of the strobe signal accompanied by read data, whereas the independent claim 1 before the EPO pertains to the transmission of a clock signal to the memory module. Without recognizing the material difference between the nature of independent claim 1 before the controller in contradistinction to independent claim 1 before the EPO, learned counsel contends that the decision of the EPO was blindly followed.

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4. In response to these contentions, learned counsel for the respondent submits that the claims made by the appellant before the IPO were substantially similar to those before the EPO because the application was the national phase application derived from the PCT application. Consequently, he submits that the Controller adopted the reasoning of the EPO while rejecting the patent application of the appellant herein.

5. On examining the current claims submitted by the appellant along with written submissions dated 28.03.2022, it is evident that features of original claims 2 and 4 were fused with current independent claim 1. The hearing notice dated 23.02.2022 preceded the written submissions and the current claims enclosed with such written submissions. In the hearing notice, as regards lack of clarity, an objection was raised only in respect of original independent claim 1, but not in respect of original claims 2 and 4. Therefore, the appellant did not have a reasonable opportunity to respond to objections on the ground of lack of clarity with regard to features incorporated in original claims 2 and 4, which were subsequently incorporated in independent claim 1. To that extent, principles of natural

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justice were not adhered to.

6. Turning to the conclusions on novelty, it is pertinent to set out current independent claim 1 in patent application no.201647014734 and the corresponding independent claim 1 before the EPO. The said independent claims are as under:

Claim 1 in India	Claim 1 in EP
A method (400) for signal adjustment, the method comprising: transmitting (402), by a memory controller, a control signal to a memory module, wherein the memory controller continuously transmits a clock signal to the memory module; and determining, by the memory controller, adjustments to the control signal with respect to the clock signal, by iteratively analyzing a strobe signal, wherein the determining of the adjustments to the control signal further comprises: ***sending, by the memory controller, a read command to the memory module:*** ***receiving, by the memory controller, the strobe signal accompanied by read data from the***	A method (400) for signal adjustment, the method comprising: transmitting (402), by a memory controller, a control signal to a memory module, wherein the memory controller continuously transmits a clock signal to the memory module; characterised by: iteratively analyzing strobe signals received after shifting (408) a timing of the control signal earlier and later in time with respect to the clock signal, to determine respective left and right limits of a passing region of the timing of the control signal relative to a rising edge of the clock signal; determining iteratively a largest passing region of the timing of the control signal; and changing the control signal timing to the center of the determined

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Claim 1 in India	Claim 1 in EP
memory module, in response to the sending of the read command: ***determining (406), by the memory controller, a clock cycle position in which the preamble of the strobe signal normally occurs***; and shifting (408) a timing of the control signal earlier and later in time with respect to the clock signal to center a timing of the control signal relative to a rising edge of the clock signal ***while ensuring that a preamble of the strobe signal retains correct positioning.***	largest passing region.

7. At paragraph 11 of the impugned order while considering novelty over D3, it was recorded, in relevant part as under:

> *"D3 discloses a method for signal adjustment (text in bracket shows relevant paragraphs from the cited document),*
>
> *b) receiving, by the memory controller, the strobe signal accompanied by read data from the memory module, in response to the sending of the read command; determining (406), by the memory controller, a clock cycle position in which the preamble of the strobe signal normally occurs;*
> *(par.9: "timing adjustment of the clock inputted to the memory";)"*

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8. The corresponding EPO decision is as under:

> *"b) continuously transmitting a clock signal to the memory module;*
>
> *par.8: "timing adjustment of the clock inputted to the memory";"*

9. From the above extracts, the conclusion that follows is that the respondent adopted the reasoning of the EPO without recognizing the material change made in current independent claim 1 *vis a vis* independent claim 1 before the EPO. Consequently, even with regard to novelty analysis, the impugned order calls for re consideration.

10. Therefore, impugned order dated 19.01.2024 is set aside and the matter is remanded for re consideration on the following terms:

(i) In order to preclude the possibility of pre determination, such re consideration shall be undertaken by an officer other than the officer who issued the impugned order.

(ii) After providing a reasonable opportunity to the appellant, including a personal hearing, a fresh order shall be issued within a period of ***four months*** from the date of receipt of a copy of this order.

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(iii) For the avoidance of doubt, it is made clear that no observation has been made on the merits of the patent application.

11. CMA(PT)/35/2024 is disposed of on the above terms without any order as to costs. Consequently, the C.M.P.No.12404 of 2024 is closed.

18.02.2025

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Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No

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