

**BEFORE**  
**THE CONTROLLER OF PATENTS,**  
**PATENT OFFICE, DELHI BRANCH**

THE PATENTS ACT,  
1970

(as amended)

&

THE PATENT RULES,  
2003

(as amended)

<https://ipworld.in>

**SECTION 15**

**Applicant** ----- **GOOGLE LLC**

**Address for service** ----- REMFRY & SAGAR, ATTORNEYS-AT-LAW REMFRY  
HOUSE MILLENNIUM PLAZA SECTOR 27, GURGAON 122 009, INDIA.

**DECISION**

1. An application for patent bearing number 9486/DELNP/2007 was filed in the Patent Office, Delhi on 07/12/2007. The request for examination was filed vides RQ No. 8123/RQ-DEL/2007 dated 28/12/2007 under section 11 read along with the rule 24B of the Patents Act, 1970 (as amended). The said application was published on 18/01/2008 with journal number of publication 03/2008. The said application was examined under sections 12 and 13 of the Patents Act, 1970 (as amended) and the First Examination report was issued on 23/04/2013. In response to the First Examination Report, the applicant's agent submitted their reply on 23/04/2015.
2. The undersigned was allotted this case on 09/07/2019. After considering the reply filed in response to the FER by the applicant's agent and the report of the examiner's view on the

reply, it was observed that the said patent application was not in order for grant. Keeping in view the provisions of the Patents Act, 1970 (as amended) and to provide natural justice to the applicant, a hearing was offered to the agent of the applicant on 28/08/2019.

3. The intimation of said hearing (hearing notice) was sent to the applicant's agent vide e-mail dated 25/07/2019 along with the following outstanding objections.

- Invention u/s 2(1)(j)

1. The present application does not meet the requirements of sec 2(1)(ja) of the Indian Patent Act because the subject matter of claims lacks an inventive step in reference with the documents D1:-US20040187184A1, D2:-US20020009989A1 and D3:-WO2001099450A2. Here D1 discloses(the references in parentheses applying to this document):AnApparel articles including flexible personal device and information displays provide a system and method for displaying text and graphical output of personal devices to the wearer of the apparel article or another person interacting with a personal device of the wearer. The apparel includes a display having enhanced flexibility that is visible in low ambient light conditions without requiring the use of a backlight. Hats, shirts and other apparel articles provide displays for programming by other persons via a wireless network interface and for displaying information such as Internet messages and pages, temperature, exercise data, stock quotes, computer monitor displays and other information to the wearer of the apparel. Control inputs of personal devices are also incorporated in the apparel via a touch-screen aligned with the display or other discrete controls integrated within the apparel(abstract, claim no. 1, fig.1-2 and para [0013]-[0020]). D2 discloses:-An information provision method effectively utilizes a mobile communication infrastructure to offer a user-friendly communication service. A portable telephone is carried in a state of being separated from a user's body while a wrist-worn portable terminal is carried in a state of being maintained in direct contact with the user's wrist like a wristwatch. When the portable telephone receives service information during a main communication process, e.g., telephone

conversation, it transfers the service information to the wrist-worn portable terminal. The wrist-worn portable terminal outputs and displays the transferred service information. A portable telephone company enables communication through the user's portable telephone by using a portable telephone communication infrastructure, and transmits service information to the portable telephone during intervals between time periods for the main communication process. A service information provider company provides an advertisement as service information to be transmitted to the user's portable telephone (abstract, fig. 1-2, claim no. 1 and para [0009]-[0013]); which discloses the subject matter of alleged invention claims. D3 discloses:—A watch-shaped information processing device comprising: a transmitter-receiver unit that carries out bidirectional and local communication with a mobile telephone; an incoming call notification unit that, when the watch-shaped information processing device receives from the mobile telephone an incoming call notification signal that indicates that there is an incoming call to the mobile telephone, carries out a notification to a user of the watch-shaped information processing device to the effect that there is an incoming call; and an instruction transmission unit that, by using the transmitter-receiver unit, transmits an instruction signal for controlling the mobile telephone (claim no. 1); which discloses the inventive features of alleged invention claims. The additional features of the dependent claims do not add anything new or inventive to the independent claims, because these features are either known from the above mentioned prior art or are common measures, see documents D1, D2 and D3 and the corresponding passages cited in the search report. As all of the technical features of the present application have been described in the document described above, hence, in view of the documents D1, D2 and D3, the claims 1-20 of the alleged invention lacks inventive step as required under section 2(1)(ja) of the Indian Patent Act, 1970 (as amended)

- Sufficiency of Disclosure u/s 10 (4)
  1. Please indicate in the response communication the support for the claims

in the original specification, as required u/s 10(4) of the Act. Care shall be taken that requirements of Section 59 (1) of the Act are also met. Please provide an additional copy of marked up amendments (highlighting the amendments) wherever applicable.

- Formal Requirement(s)

1. Updated forms should be filed reflecting the changes made as a result of Form 6 and Form13. Updated forms should also reflect the new agents, their registration numbers and their signatures.
  2. Drawings should be filed as per rule 15 of Patents Rules, 2003. Drawings should be improved as they do not clearly exemplify the intent of the alleged invention
  3. Petition for delay in filing annexure of Form 3 has not been submitted with prescribed fee.
  4. The applicant has informed this office on the Form 6 received on 12/04/2016 that the name of the applicant has changed from Lawrence, Kate-->Nest Labs, Inc. -->Google, Inc. However, Form6 has not been submitted for change of applicant from Lawrence, Kate-->Google, Inc. Another Form6 should be filed.
  5. Proper fee for application and forms has not been paid by the applicant, therefore remaining fee should be paid by the applicant. You are required to verify if this instant (NP) application is indeed filed U/R7(2)(c) read together U/S10(4-A) and 138(4) of the Act. If otherwise, balance fees in respect of additional claims and pages(corresponding to international application) should be submitted immediately along with necessary petition and fees in view of such irregularity, failing which the instant application shall proceed U/S142(3) of the Act.
4. The hearing was attended by the applicant's authorized agent. The authorized agent substantiated the oral arguments with the written submissions dated 12/09/2019. No changes were made in the claims
  5. Therefore, the instant application needs to be disposed of on merit based on the facts on records and the oral as well as written submission of the agents of the applicants.

6. Claims 1-20 were pending at the time of issuance of the hearing notice. NO amendments were made in the claims
7. All the oral arguments and the written submission of the agent of the applicant have been carefully considered.
8. Now, I turn my attention to the claimed subject matter. The subject matter as described and claimed originally dated 07/12/2007 under claims 1-32 relates to a method and a system for electronic devices which can be attached to clothing. The said device comprises of following features
  - *Display time and date*
  - *Display calendar information*
  - *Satellite navigation receiver*
  - *Inertial motion Unit to detect motion of the apparatus*
  - *Send answer command to cellular telephone*
  - *Camera*
  - *Vibrator*
  - *Temperature Sensor*
  - *Humidity sensor*
  - *Air pressure sensor, etc*
9. In response to the FER, the originally filed claims 1-32 were amended to claims 1-20 pertaining to an apparatus comprising of various features. Same set of claims were retained after hearing submissions.
10. In the F. Hoffmann-La Roche Ltd vs Cipla Ltd case (2012), the Hon'ble Delhi High Court had observed that the obviousness test is what is laid down in Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries Ltd (AIR 1982 SC 1444) and that “Such observations made in the foreign judgments are not the guiding factors in the true sense of the term as to what qualities that person skilled in the art should possess. The reading of the said qualities would mean qualifying the said statement and the test laid down by the Supreme Court.” Hon'ble High Court further added “From the bare reading of the afore quoted observations of Supreme Court, it is manifest that the Hon'ble Supreme Court has laid down the test for the purposes of ascertaining as to what constitutes an inventive step which is to be seen from the standpoint of technological advancement as

well as obviousness to a person who is skilled in the art. It is to be emphasized that what is required to be seen is that the invention should not be obvious to the person skilled in the art. These are exactly the wordings of the New Patents Act, 2005 u/s Section 2(ja) as seen above. Therefore, the same cannot be read to mean that there has to exist other qualities in the said person like the unimaginary nature of the person or any other kind of person having distinct qualities..... Normal and grammatical meaning of the said person who is skilled in art would presuppose that the said person would have the knowledge and the skill in the said field of art and will not be unknown to a particular field of art and it is from that angle one has to see that if the said document which is prior patent if placed in the hands of the said person skilled in art whether he will be able to work upon the same in the workshop and achieve the desired result leading to patent which is under challenge. If the answer comes in affirmative, then certainly the said invention under challenge is anticipated by the prior art or in other words, obvious to the person skilled in the art as a mere workshop result and otherwise, it is not. The said view propounded by Hon'ble Supreme Court in Biswanath Prasad (supra) holds the field to date and has been followed from time to time by this Court till recently without any variance..... Therefore, it is proper and legally warranted to apply the same very test for testing the patent; be it any kind of patent. It would be improper to import any further doctrinal approach by making the test modified or qualified what has been laid down by the Hon'ble Supreme Court in of Biswanath Prasad (supra).”

11. In the view of the above, it is understood that the person skilled in the art is a competent craftsman or engineer as distinguished from a mere artisan. Hence, in the instant application, the person skilled in the art is a person competent in information management systems.
12. With respect to the 2(1)(j) objection: The implementation of the alleged invention is easily comprehensible for a person having ordinary skills in the art (as defined in Para 11). Moreover, Section 2(1)(ja) of the Patents Act defines "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art. It has been argued by the agent of the applicant that the present disclosure involves both technical advancements as well as economic

significance over the cited documents. It can be agreed that it may lead to economic significance or saving of the cost as described by the applicant in the complete specification. However, if we focus on the requirement of section 2(1)(ja) of the Act it says that (technical advance as compared to the existing knowledge or having economic significance or both) and (that makes the invention not obvious to a person skilled in the art). Although it may pass the test of the first phrase, still it will have to pass the test of the second phrase i.e. being non-obvious to the person skilled in the art.

13. The alleged invention seeks to combine the already known features such as clock, calendar, GPS, temperature sensor, humidity sensor, etc. This is an aggregation of already known devices each functioning independently of one another. In *Ram Pratap v Bhabha Atomic Research Centre (1976) IPLR 28 at 35*, it was held that a mere juxtaposition of features already known before the priority date, which have arbitrarily been chosen from among a number of different combinations which could be chosen, was not a patentable invention. It has further held that when two or more features of an apparatus or device are known and juxtaposed without any interdependence on their functioning of the apparatus or device should be held to have been already known.
14. Now coming to cited documents: D1: US20040187184A1; D2: US20020009989A1 and D3: WO2001099450A2. The agents for the applicant have argued that none of the cited documents ‘ teaches or suggests the features of claim 1, particularly, the features “said apparatus (105) is configured to send an answer command to said cellular telephone when a prescribed user-generated motion is detected by an inertial motion sensor (383)” as recited in claim 1. The remaining claims 2-20 are inventive for depending upon claim 1.’
15. The argument of the applicant is not valid in view of both D2 and D3. D2 teaches in para [0066] and Fig. 7 teaches how calls will be transmitted and received on the wrist worn portable device. Line 10 of the same para states that “The wrist-worn portable terminal **200** notifies the user of the transfer of the advertisement or the like by means of a signal or the like (**104**) and displays the advertisement or the like (**105**). Then, when a user's confirmation operation or the like is performed, the wrist-worn portable terminal **200** transmits the result of confirmation to the portable telephone **100** (**106**).” D3 in claim 1 talks about a call notification unit which upon receiving an incoming call,

sends a notification to a watch shaped information processing device. The user wearing the watch is informed of the call. The user then chooses to either to accept/decline the call. D1 relates to a display panel and in the description explains “The display panel of the device may be detachable from the housing. The housing may include in addition to a display panel, other components of the display device, such as electronic apparatus to provide display parameters (such as driving signals, interface signals including a vertical synchronization pulse and clock signals), a battery, ac/dc converter or other power source, driving electronics and buttons or other control features. Components of the display such as an image display controller and telecommunications hardware and software may also be in the housing.” Therefore, the alleged invention does not meet the requirements of section 2(1)(j) in view of D1 and/or D2 and/or D3.

16. With respect to 10(4) objection: The applicant/agent of the applicant has made submissions. The matter has been carefully considered in detail. Without prejudice to the above said, having considered the aforesaid submission, I do not find the submissions persuasive in view of following: It is the imperative of the applicant to describe the ‘what’ and ‘how’ of the invention in question. *In Press Metal Corporation Limited vs Noshir Sorabji Pochkhanwalla*, it was held that “It is the duty of a patentee to state clearly and distinctly the nature of what he claims”. In the present case, the applicant does not talk about the enablement of the alleged invention i.e. exactly how the calendar, time, satellite navigation systems, etc will be compiled into a single apparatus. The applicant has combined the various features on paper just by mentioning their names and has not disclosed how the features will be integrated in the claimed apparatus. This points to the fact that the alleged invention expects that the person implementing the alleged invention would know the working of the various elements.

17. The complete specification should disclose the best method of performing the invention, which is known to the applicant and for which he is entitled to claim protection. The description of the method or the instructions for working the invention in the complete specification should by themselves be sufficient to enable a person in India possessing average skill and average knowledge of the art to which the invention relates to work the invention and to obtain the results claimed for the invention. Still the invention and its operation or use and the method by which it is to be performed is not fully and

particularly described in the complete specification as per section 10(4) of the Patents Act, 1970 (as amended).

18. Therefore, keeping in view the above facts, the submissions of the agents during the hearing and subsequently through the written submissions, as well as the outstanding official requirements, application number 9486/DELNP/2007 dated 07/12/2007 does not comply with the requirements of the Patents Act, 1970 (as amended). I, therefore, hereby order that the grant of a patent for application no. 9486/DELNP/2007 is refused under the provisions of Section 15 of The Patents Act, 1970 (as amended).
19. This is to be noted that the aforesaid observations, and decision thereof, are based solely on the electronically uploaded documents to date.

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27/02/2020

(HIMANSHI KHARB)

**Assistant Controller of Patents & Designs**