2024:MHC:1768

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 10.04.2024

CORAM

THE HONOURABLE MR.JUSTICE **M.SUNDAR**
and
THE HONOURABLE MRS.JUSTICE **K.GOVINDARAJAN THILAKAVADI**

W.A. No.1181 of 2024
and
C.M.P.Nos.8549 and 8550 of 2024

Ashok Leyland Limited rep. By its
Authorized Signatory Satish S.M.,
No.1, Sardar Patel Road,
Guindy, Chennai – 600 032. .. Appellant

Vs.

1.The Controller of Patents & Designs,
The Patent Office, Chennai
Patent Office Intellectual Property Building,
G.S.T. Road, Guindy, Chennai – 600 032.

2.Tata Motors Ltd.,
Bombay House,
24, Homi Mody Street,
Hutatma Chowk, Mumbai – 400 001. .. Respondents

Writ Appeal filed under Clause 15 of the Letters Patent against the impugned order dated 15.03.2024 passed in W.P. (IPD) No.1 of 2024 in respect of post-grant opposition proceedings against the Appellant's patent number IN387429 (Patent application number 201641025668 dated 27.07.2016) and

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consequently direct respondent No.1 to consider the documents filed by the petitioner and the respondent No.2 and to consider the matter afresh by re-constituting a fresh Opposition Board for providing a fresh joint recommendation pending disposal of the present writ appeal.

For Appellant : Mr.M.S.Bharath

For Respondents : Mr.R.Rajesh Vivekananthan,
Deputy Solicitor General
for R1
Mr.P.V.Balasubramanian,
Senior Counsel
for Ms.Archana Shankar
for R2

ORDER

(Order of the Court was made by **M.Sundar, J.**)

Captioned 'Writ Appeal' (hereinafter 'captioned WA' for the sake of convenience and clarity) is an intra-court appeal and it is directed against an order dated 15.03.2024 made by Intellectual Property Division of this Court i.e., by a Hon'ble Single Judge of this Court in W.P.(IPD) No.1 of 2024 and W.M.P. Nos.1 and 2 thereat.

2. Though the captioned WA and the captioned Civil

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Miscellaneous Petitions (hereinafter 'CMPs' in plural and 'CMP' in singular for the sake of convenience and clarity) thereat are in the Admission Board, with the consent of Mr.M.S.Bharath, learned counsel for appellant and Mr.P.V.Balasubramanian, learned senior counsel instructed by Ms.Archana Shankar, Mr.K.Premchandar, Mr.N.C.Vishal and Mr.N.Shrivatsav on caveat for the 'second respondent' (hereinafter 'R2' for the sake of clarity) and Mr.Rajesh Vivekanandan, learned Deputy Solicitor General of India who are before us, main matter i.e., captioned WA is taken up with the consent of both sides and learned Solicitor.

3. Owing to the nature of the matter, short facts will suffice. Short facts are that the matter at hand pertains to a product patent and a product titled 'Multi-Axle Vehicle Configuration having Heavy Duty Lift Axle' (hereinafter 'said patent' for the sake of convenience and brevity); that grant of said patent (Patent number IN387429) in favour of 'appellant company' (hereinafter 'ALL' denoting 'Ashok Leyland Limited') was on 27.07.2016 and therefore the 20 year period under 'The Patents Act, 1970 (39 of 1970)' (hereinafter 'said Act' for the sake of brevity) will be from 27.07.2016; that the second respondent 'Tata Motors Limited' (hereinafter 'TML' or 'R2' for the sake of

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convenience) filed opposition to said patent under Section 25(2) of said Act; that under Section 25(2) of said Act, opposition can be under 11 different grounds and the adumbration is vide clauses (a) to (k); that in the case on hand, it is under (b) prior publication, (d) prior art (lack of novelty), (e) lack of 'invention' i.e., invention within the meaning of Section 2(1)(j) of said Act and it does not involve any inventive step within the meaning of Section 2(1)(ja) of said Act, (f) not invention within the meaning of Section 2(1)(j) of said Act and (g) insufficient disclosure; that in taking up the opposition under Section 25(2), the 'first respondent' (hereinafter 'said Controller' for the sake of convenience and clarity) constituted as Opposition Board under Section 25(3)(b); that this 'Opposition Board' which shall hereinafter be referred to as 'said Board' is to submit a recommendation under Section 25(4) of said Act; that the said Board did so vide recommendation dated 31.10.2023 (hereinafter 'said recommendation' for the sake of convenience); that ALL filed aforementioned W.P. (IPD) No.1 of 2024 assailing the procedure adopted by the said Board; that the grievance of ALL is that expert evidence has not been considered by said Board in giving said recommendation dated 31.10.2023; that the writ petition was taken up by Hon'ble Single Judge who made the aforementioned 'order dated 15.03.2024' (hereinafter

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'impugned order' for the sake of convenience) and came to the conclusion after hearing both sides that the writ petition deserves to be dismissed saying that if said Controller in the final hearing finds merit in the contention of failure to consider evidence of the experts, the Board can be reconstituted; that ALL is now on appeal.

4. We carefully considered the rival submissions. As the main WA was taken up with the consent of both sides as alluded to supra, this Court is of the view that the procedure adopted by said Board in making said recommendation and the correctness of the same or testing the same cannot be left to the said Controller in final hearing as said Board vide Rule 56(4) of 'The Patents Rules, 2003' (hereinafter 'said Rules' for the sake of convenience and clarity) has to give a report i.e., submit a report and recommendation with reasons on each ground after examining the documents and learned counsel on both sides i.e., learned counsel for ALL and TML in this case agreed that term 'documents' occurring in sub-rule (4) of Rule 56 includes/means 'documents and evidence' when read in the light of Rules 57 to 60 of said Rules which talk about 'evidence'. Though said recommendation is not binding on said Controller, it is a determinant qua post grant

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opposition cannot be tested and sent back by reconstituting the Board in the final hearing proceeding itself as that would tantamount to testing a parameter on which the drill is pivoted in the drill itself.

5. A perusal of said recommendation brings to light that the question as to whether said Board has considered the evidence is clearly debatable and requires an exercise by itself to take a call on this aspect of the matter. At this juncture, with the intention of giving quietus to the simmering disputation and with the further larger objective of expediting the opposition to patent legal drill, both sides agreed that it will be desirable to have the Board reconstituted and have the drill of the Board giving a recommendation done *de novo*. Before we write operative part on the basis of this consensus, we make it clear that judicial review qua procedure to be followed by said Board is an aspect which this Constitutional Court is not denuded of and we deem it appropriate to answer the 'larger question' propounded by Hon'ble single Judge in paragraph 5 of the impugned order in this manner.

6. There is one other aspect of the matter which we need to set out and that is, when the said Board is constituted under Section 25(3)(c) of said Act by the said Controller, the said Board

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has to give a recommendation by resorting to procedure as prescribed and this is also vide Section 25(3)(c). The procedure prescribed is vide relevant applicable Rules under Chapter VI of said Rules. Said Rules have been made by the Central Government in exercise of rule making power vide Section 159 of said Act and a careful perusal of adumbration of list of matters regarding which the subordinate legislation can be made as contained in sub-section (2) of Section 159 makes it clear that there is no specific slot pertaining to prescribing a procedure to be adopted by the Board vide section 25(3)(c). Therefore, as of today, 'procedure prescribed' is only vide applicable Rules under Chapter VI of said Rules.

7. The following consent order is made:

7.1 Impugned order being order dated 15.03.2024 made in W.P.(IPD) No.1 of 2024 is set aside;

7.2 We make it clear that the impugned order is set aside for the purpose of facilitating de novo drill by the Board to be reconstituted by said Controller and on merits we have expressed only one view and that view pertains to paragraph 5 of the impugned order wherein we have said that this Court is not denuded of constitutional powers of judicial review qua recommendation of said Board or the

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procedure to be followed by said Board;

7.3 The first respondent/Controller i.e., said Controller is requested to reconstitute the Opposition Board within a fortnight from today i.e., by 24.04.2024;

7.4 The reconstituted Opposition Board shall embark upon the legal drill of submitting a recommendation inter-alia in accordance with sub-sections (3) and (4) of Section 25 of said Act;

7.5 The reconstituted Opposition Board shall complete de novo exercise and give report/recommendation as expeditiously as possible and in any event within four weeks from 24.04.2024 i.e., by 22.05.2024;

7.6 Post-recommendation by the Reconstituted Board, the first respondent/Controller shall proceed in accordance with said Act and said Rules as expeditiously as his business would permit;

7.7 Though obvious we make it clear that the Reconstituted Opposition Board shall consider the evidence also in giving its recommendation and documents occurring in sub-rule (4) of Rule 56 of said Rules for the purposes of this case will include evidence under Rules 57 to 61.

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8. In the light of the aforementioned consent order, no orders are required in the captioned two CMPs and the same are closed. We also make it clear that all other questions are left open qua first respondent/Controller and or any other fora.

9. Captioned WA and captioned CMPs are disposed of in the aforesaid manner and there shall be no order as to costs.

(M.S.J.) (K.G.T.J.)
10.04.2024

Index:Yes/No
Neutral Citation: Yes/No
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To

The Controller of Patents & Designs,
The Patent Office, Chennai
Patent Office Intellectual Property Building,
G.S.T. Road, Guindy, Chennai – 600 032.

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M.SUNDAR.J.,
and
K.GOVINDARAJAN THILAKAVADI, J.,
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