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IN THE HIGH COURT OF JUDICATURE AT MADRAS

| Reserved on: 12.06.2024 | Pronounced on: 14.06.2024 |
|---|---|

CORAM:

**THE HON`BLE MR.JUSTICE P.B.BALAJI**

**CMA (PT) No.20 of 2023**

IFP Energies nouvelles,
1 et 4, avenue de Bois-Preau, F-92852
Rueil-Malmaison Cedex, France,
Represented by its constituted Power of Attorney,
Mr.Raghavan Ravindran Nair,
De Penning & De Penning,
Having Office at,
No.120, Velacherry Main Road,
Guindy, Chennai - 600 032.

.. Appellant

..Vs.

The Assistant Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai - 600 032.

.. Respondent

**Prayer**: This Civil Miscellaneous Appeal filed under Section 117-A of the Patents Act, 1970 praying this Court to call for records of the Respondent culminating in the impugned order dated 29 March, 2023 rejecting the Grant of Patent and Set Aside the same and consequently direct Grant of the Patent in respect of the Appellant's Application No.1373/CHE/2015.

For Appellant : Mr.S.Shivathanu Mohan for
M/s.S.Ramasubramaniam Associates



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For Respondent : Mr.J.Madhanagopal Rao,
Senior Panel Counsel

**JUDGMENT**

This is an Appeal preferred against the order dated 29.03.2023, passed by the Controller of Patents and Designs, Chennai in respect of the Appellant's Application No.1373/CHE/2015.

2. Aggrieved by the Rejection of the Patent Application made by the Appellant, the present Appeal has been preferred. Though several grounds have been raised touching the merits of the Patent Application, the learned counsel for the Appellant, Mr.S.Shivathanu Mohan for M/s. S.Ramasubramaniam Associates, would submit that the order is a non speaking order and therefore, it is a clear case where the matter has to be remitted to the Controller for fresh consideration.

3. I have heard Mr.S.Shivathanu Mohan, learned counsel for Appellant and Mr.J.Madanagopal Rao, learned Senior Panel Counsel for the Respondent/Controller.

4. I have heard the arguments with regard to the requirement of the Appeal being sent back to the Controller for fresh consideration. The



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learned counsel for the appellant would take me through the impugned order and submit that none of the contentions raised in the written submissions have been considered and the order has been passed without reference to materials produced by the Appellant.

5. He would invite my attention to the specific portions of the impugned order to fortify his submissions in this regard. He would also place reliance on the judicial pronouncements of the Courts, including this Court. In *Intercontinental Great Brands LLC and Another Vs. Assistant Controller of Patents and Design* in *(T) CMA (PT) No. 182 of 2023, dated 09.02.2024,* this Court held that when the submissions of the Appellants or the explanations provided were not considered, then the matter has to necessarily go back to the Patent Controller. I am not inclined to go into the other judgments cited by the learned counsel for the Appellant, since I am deciding the issue with regard to whether the Appeal has to be remitted or not.

6. Mr.J.Madanagopal Rao, on the other hand would refer to the counter affidavit filed by the Respondent and submit that there is no violation of principles of natural justice and the order impugned does not



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require to be reconsidered.

7. I have carefully considered the arguments advanced by the learned counsel on either side and I have also gone through the impugned order of the Controller.

8. Elaborate written submissions have been filed before the Controller. However, without considering the material contentions and submissions made by the Appellant, the Controller has proceeded to pass an order rejecting the Patent Application. The Controller has also not taken note of the fact that the very same Application was favourably accepted and patented by United States of America. The explanation offered by the Appellant has not been objectively considered. The findings are also not backed by discussions and reasons, meeting the written submission and explanation offered by the Appellant. Moreover, by comparing the invention of the Appellant itself with D1 & D2 to the impugned invention it was certainly a surprise to the Appellant and they could have addressed the said issue and therefore, in true letter and spirit, the Appellant should have been afforded an opportunity. Hence, I am of the opinion that the Controller passes a fresh order after considering all the material submissions



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advanced by the appellant and also discuss/factor the explanation with regard to the process involved. As ordered by this Court in *Intercontinental Great Brand's LLC*'s case (referred herein supra), to avoid any embarrassment, the appellant's Application shall be considered by a different Patent Controller. The hearing shall be expedited and the Application shall be disposed of within a period of four (4) months from the date of receipt of a copy of the judgement. No costs.

**14.06.2024**

Index : Yes/No
Speaking/Non-speaking order
rkp

**To**
The Assistant Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai - 600 032.

**P.B.BALAJI,J.**
rkp



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**CMA (PT) No.20 of 2023**

**14.06.2024**



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