WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 11.03.2024

CORAM :JUSTICE N.SESHASAYEE

(T)CMA(PT) No.2 of 2023
(OA/22/2017/PT/CHN)

MARTINSWERK GmbH
Kolner Strasse 110
50127 Bergheim
Germany
Nationality : Germany ... Appellant

Vs.

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

PRAYER: Transferred Civil Miscellaneous Appeal (Patent) filed under Section 117-A of the Patents Act, 1970, against the order of the respondent dated 05.07.2017, be set aside and the application No.7047/CHENP/2008 for patent be allowed.

For Appellant : Mr.Shivathanu Mohan

For Respondent : Mr.K.Subbu Ranga Bharathi
Central Govt. Standing Counsel

https://www.mhc.tn.gov.in/judis

WEB COPY

JUDGMENT

Aggrieved by the order of the respondent dated 05.06.2017, rejecting the application of the appellant for patenting its invention relating to novel aluminum hydroxide flame retardants and their use. According to the appellant, the application is for product patent.

2. The brief facts are :

a) In its application for patenting its aforesaid invention, the appellant had made 34 claims, of which 5 were cited as its independent claims. The respondent would now come out with its FER dated 24.11.2014, in which he had raised objections to the patentability of the appellant's invention for lack of novelty and inventive step, by placing reliance on five prior arts in D1 to D5, besides raising objection under Sec.3(d), 3(e) and 10(5) of the Patents Act.

b) The appellant responded to the same and amended its claims, by which it brought down the total number of claims to 19, of which, the first claim alone was its independent claim.

c) The respondent would now come out with its hearing notice dated 09.01.2017, wherein it retained all the aforesaid objections raised in

https://www.mhc.tn.gov.in/judis

WEB COPY

the FER, but abandoned all the five prior arts referred in the FER, and cited two fresh prior arts in D6 and D7.

d) The appellant participated in the hearing and filed its written submissions. Since the contentions of the appellant did not carry conviction with the respondent, the latter chose to reject the appellant's application for grant of patent.

Hence, this appeal.

3. Heard both sides. The learned counsel for the appellant submitted that the Controller of Patent is seen oscillating between the various limbs of Sec.3(d). In its FER, the Patent Controller has raised objections based on the first limb of Sec.3(d), wherein he would state that the petitioner's invention is but a discovery of a new form of known substance which does not result in enhancement of the known efficacy of that substance. In the hearing notice, the respondent gave up the aforesaid limb of Sec.3(d), but moved to the third limb of the same section, and almost converted the appellant's invention into a process invention, when it sought only patent for product invention. And when this was posted, the appellant has addressed this objection which was taken out by the respondent in his hearing notice. However, in the impugned

https://www.mhc.tn.gov.in/judis

WEB COPY

order, the respondent had again reverted back to the first limb of Sec.3(d), which even the Controller had abandoned in his hearing notice. The learned counsel concluded his arguments with his statement that the Controller ought to be certain about the ground under which he raises objection for that any applicant is only required to respond to the specific objection which the Controller may raise. And insofar as the Controller had raised an objection based on the last limb of Sec.3(d), the appellant had an occasion only to respond to that, it having already addressed the objection to the first limb of Sec.3(d).

4. This Court finds considerable merit in the submissions of the counsel for the appellant. The Controller is seen constantly shifting the goalpost and has created a considerable uncertainty in the minds of the appellant. As was pointed by the counsel for the appellant that the Controller in his FER, has raised objection based on the first limb of Sec.3(d), but later abandoned it and moved to the third limb of Sec.3(d) in his hearing notice. Having invited the appellant's response only to his objection to the third limb of Sec.3(d) he again moved to the first limb of said provision to reject the application, but without giving an opportunity of being heard on the said objection.

https://www.mhc.tn.gov.in/judis

WEB COPY

Necessarily the matter has to be reheard and decided.

5. It has now become inevitable for the Court to set aside the impugned order of the Patent Controller. Accordingly, this Court sets aside the impugned proceedings of the respondent dated 05.06.2017, remands the matter back for a *de novo* consideration. To save embarrassment to the Controller who has passed the impugned proceedings, this Court directs that appellant's application now be considered by some other Controller. In the eventuality of the appellant's invention getting patented, it will have a shelf value of barely about four years, and hence the Patent Controller, who will now be in incharge of disposing of the appellant's application, is required to dispose of the appellant's application within a period of six months from the date on which he/she takes charge of the issue.

6. To conclude, the appeal is allowed. No costs.

11.03.2024

ds

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

https://www.mhc.tn.gov.in/judis

WEB COPY

N.SESHASAYEE, J.

ds

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

(T)CMA(PT) No.2 of 2023

11.03.2024

https://www.mhc.tn.gov.in/judis