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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 27.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

CMA(PT)//3/2023

Panasonic Intellectual Property Management Co. Ltd.,
1-61, Shiromi 2-chome, Chuo-ku
Osaka-shi, Osaka 540-6207 Japan
Nationality : Japan
Rep. by its Authorized Representative
Mr.Raghavan Ravindran Nair ... Appellant

Vs.

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

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) is filed under Sections 117 A of the Indian Patents Act, 1970, praying to call for the records of the respondent culminating in the impugned order dated 24.01.2022 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.8954/CHENP/2014.

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For Appellant : Mr.Shivathanu Mohan

For Respondent : Mr.C.Kulandaivel
Senior Panel Counsel

JUDGMENT

Having lost its application under Section 2(i)(ja) of the Patent Act, which it had filed for patenting its invention titled "ARC-Welding method and ARC-Welding apparatus" which according to the appellant relates to an arc-welding method and an arc-welding apparatus for welding by alternately making a short circuit state and an arc state while repeating a forward feed and a reverse feed for feeding a welding wire as a consumable electrodes is now before this Court.

2.The other material facts relevant for the current purpose are bullet pointed as below:

- On 11.03.2013, the appellant had made a PCT application in Japan, and on 11.12.2014, it made a National Phase Application. In its application, the appellant had made 11

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claims of which 3 are independent and 8 are dependent.

- The Controller eventually came up with his FER dated 08.08.2018, wherein he had raised atleast five objections and they are:

  (i). that the appellant's invention lacks inventive step within the meaning of Section 2(1)(ja) based on four prior arts in D1 to D4;

  (ii). under Section 3(f);

  (iii). for insufficiency of disclosure under Rules 13 and 15 of the Patent Rules;

  (iv). failure to define the scope of the invention as required under Section 10(4)(c); and

  (v). certain formal procedural objections.

- The appellant had responded to the said FER and also amended its claims and brought it down its claim from 11 to 7. Of that 2 are its independent claims and 5 are dependent claims.

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- Subsequently, the respondent issued a hearing notice dated 16.07.2021, wherein the Controller had taken objections to the patentability of the appellant's invention only under Section 2(1)(ja). He has also added one more prior art in D5 to the earlier disclosed prior arts D1 to D4.

- Ultimately, the respondent chose not to grant patent to the appellant's invention under Section 2(1)(ja).

3. Heard both sides. The learned counsel for the appellant submitted that in his lengthy order running to several pages, the Controller has allotted barely two lines for his appreciation and decision. In other words, according to the learned counsel, the Controller has chosen not to apply his mind the way it is required to be demonstrated.

4.This Court perused the papers and finds that the impugned order effectively runs to 26 pages, all of which are a mere reproduction of appellant's claims and a travelogue of the journey through D1 to D5. When

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it comes to his line of reasoning, the Controller has chosen to rely on just an aspect of invention which according to him appears to possess certain technical features in D1 and D2 but did not go to explain how. In effect, this Court finds that the Controller had not explained why he had come to the conclusion which he had taken adequately and explicitly.

5.Left with little option, this Court is now constrained to allow this appeal and remands the matter back to the same Controller, who may now give an opportunity of hearing the appellant on the objection raised in the hearing notice dated 16.07.2021 and to dispose of the matter within a period of three (3) months from the date of receipt of a copy of this order.

6.In the result, this appeal stands allowed. There is no order as to costs.

18.03.2024

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Index: Yes / No
Neutral Citation

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