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IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON : 04.07.2024

DELIVERED ON: 12.07.2024

CORAM:

THE HON'BLE MR. JUSTICE P.B. BALAJI

CMA(PT)No.27 of 2023

HONDA MOTOR CO., LTD
1-1, Minami-Aoyama 2-chome,
Minato-ku Tokyo 107-8556 Japan
Nationality:Japan
Represented by its Power of Attorney
Mr.Raghavan Ravindran Nair,
De Penning & De Penning, having Office at
No.120, Velachery Main Road, Guindy,
Chennai-600 032. .... Appellant

vs

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

Appeal filed under Section 117-A of the Patents Act, 1970 against the order passed by the Controller of Patents and Designs dated 14.08.2021 in Indian Patent Application No.380/CHE/2015.

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

For Respondent : Mr.S.Madana Gopal Rao
SPCGSC

JUDGMENT

The appellant has preferred the above patent appeal against the refusal of its Patent Application No.380/CHE/2015 on the grounds of lack of inventive step and also not being definitive.

2. I have heard Mr.Shivathanu Mohan for M/s S..Ramasubramaniam and Associates learned counsel for the appellant and Mr.S.Madana Gopal Rao, learned Senior Panel Central Government Standing Counsel for the respondent.

3. Learned counsel for the appellant would argue only for a limited relief of remitting the matter to the respondent, citing the following arguments:-

(i) With regard to the lack of inventive step and the prior arts, the

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learned counsel for the appellant would invite my immediate attention to the impugned order passed by the respondent, where, the respondent, after merely discussing the prior arts, proceeds to jump to the conclusion that it would be obvious for any skilled person to arrive at the said claimed features of the alleged invention in the light of D1 to D3 prior arts and common knowledge in the course of normal research, experimentation and trial and error.

I do not find any reasons or discussions justifying the said conclusion, excepting for describing the prior arts D1 to D3 in the earlier portions of the order. Therefore, the conclusion arrived at by the respondent that the claimed subject matter of the patent application is obvious and lacks inventive step is clearly not substantiated or well founded. Further, to cite common knowledge, the respondent has not disclosed the source of such knowledge also in the impugned order. Therefore, on this ground also, the appellant is entitled to succeed.

(ii) With regard to definitiveness, the learned counsel for the

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appellant would submit that in the hearing notice, the sufficiency of disclosure under Section 10(4) of The Patent Act, 1970 was not properly raised in order to put the appellant on notice and afford a fair opportunity to the appellant to explain the same. However, on the ground of lack of sufficiency of disclosure, for which, no opportunity was given by raising the said objection in the hearing notice, the order has been passed citing lack of sufficiency of disclosure against the appellant.

4. Learned counsel for the appellant would further invite my attention to the additional typed set of papers and submit that the appellant has been granted Chinese Patent as well as Japanese Patent and the prior arts, which have been cited by the respondent against the appellant, have all been considered before grant of the patent by the Chinese and Japanese authorities. He would also state that this was also brought to the notice of the respondents by providing relevant particulars in Form III.

5. Mr.J.Madana Gopal Rao, learned Senior Panel Central Government Standing Counsel would submit that the order passed by the

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respondent is a well reasoned order and prior arts are discussed in detail and therefore, the matter does not require to be remitted. On the contrary, he would submit that the appeal is liable to be dismissed since no substantial questions have been raised attacking the merits of the order.

6. This case, in my considered opinion, is clearly amounting to a deprivation of a fair opportunity to the appellant, to address the objections of the respondent. Without raising any relevant objection regarding "sufficient disclosure" at the time of the hearing notice, the impugned order rejects the Application on that ground. Therefore, the appellant has no opportunity to meet the said objection. Further, even regarding the prior arts, there is no discussion or explanation by the Controller, justifying the conclusion. To put "common knowledge" against the appellant, the Controller has not even stated or disclosed the source of common knowledge. Therefore, I deem it fit to remit the matter to the respondent for fresh consideration, though by a different Controller, to avoid embarrassment to the parties.

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7. In the result, the appeal is allowed and the matter is remitted to the respondent for fresh consideration of the Patent Application No. 380/CHE/2015 and a different Controller of Patents and Designs shall be assigned the task of scrutinizing the patent application. Such exercise shall be completed within a period of four months from the date of receipt of a copy of this order, after affording a fair opportunity to the appellant to canvass all his submissions. No costs.

. 12.07.2024

Index:yes/No
Speaking Order/Non-Speaking Order
sr

To

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

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P.B.BALAJI,J.,

sr

Pre-Delivery Judgment in CMA(PT)No.27 of 2023

12.07.2024

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