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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 27.02.2024

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MR.JUSTICE N.SESHASAYEE

(T)CMA(PT)/24/2023
(OA/16/2013/PT/CHN)

VICTAULIC COMPANY
490/1, Kesslersville Road
Easton
Pennsylvania - 18040
USA; ... Appellant

Vs.

Asst. 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 (i) that the refusal order of the respondent dated 16 November 2012 be stayed pending disposal of the appeal; (ii) the refusal order of the respondent dated 16 November 2012 be set aside and the application for patent be allowed to proceed toward the grant.

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For Appellant : Mr.S.Shivathana Mohan

For Respondent : Mr.M.Karthikeyan
Senior Panel Counsel

JUDGMENT

This appeal is directed against an order of the respondent rejecting appellant's application for patenting its invention titled "Mechanical Pipe Coupling having Spacers', which concerns mechanical pipe couplings that have segments maintained in spaced apart relation using spacers.

2. The facts are as below:

- The appellant preferred its application on 10.05.2005 with 43 claims of which the six claims alone are independent claims.

- This evoked the first FER from the respondent, wherein it raised certain objections for want of novelty and inventive steps under Section 2(1)(ja) and certain other procedural objections.

- The Controller also relied on two prior arts, D1 and D2. The

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appellant responded to the same and made its first amendment by which it brought down the total number of claims to 21 from 43, of which the two claims alone are its independent claims.

- The Controller would now come with its second FER in which it retained the two major objections vis-a-vis lack of novelty and inventive steps but gave up objections related to certain aspects of procedure. This apart, the Controller had dropped the earlier prior art D2, which he had cited in the first FER and replaced with another prior art, D2. The appellant would respond to the second FER and again amended its claims and brought down the total claims from 21 to 11, of which two claims continue to be the independent claims.

- The Controller would now come out with its third FER, which is almost identical to the second FER. The appellant responded to the same and this was followed by a hearing notice in which the appellant participated and also submitted his written submissions.

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- On considering the same, the Controller has chosen to reject the appellant's application only on the ground that the appellant's invention lacked any inventive steps. In other words, on the issue relating to lack of novelty, the appellant was able to get over the objection of the controller. This order is now under challenge in this appeal.

3. The learned counsel for the appellant made the following submissions:

a) The invention of the appellant in effect relates to a coupling to be used over any pipe or a cylindrical material. The coupling will have three parts, namely, the upper arc, the bottom arc and the connecting members at both ends. Now both the upper arc and the bottom arc of the coupling will be connected by a nut - bolt technology at both ends. Accordingly, when this coupling is used to bind any pipe or a cylindrical object, the upper arc and the bottom arc have to be separated, put at the respective places on the pipe of the cylindrical object appropriately, they will be nut-bolted, so that they stay bound to the object. The present

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invention of the appellant, however, involves a collapsable spacer, which will be part of the connecting members. This provides a degree of collapsibility. According to him when both the upper arc and the bottom arc of the coupling are bound together by a collapsible spacer at both ends, then for its use they need not be separated or dismantled, and only the object, namely the pipe or any cylindrical substance may have to be inserted through the coupling. The collapsibility of the inner spaces will then contract to adjust itself to the size of the periphery of the pipe or cylindrical object. This advantage is not there in any of D1 and D2. Developing his arguments further, the learned counsel submitted that D1 was registered in 1956 by certain John H.Krooss of America, who later assigned it to the present appellant. In other words, D1 is appellant's invention. In D1, it uses a small shim with a perforation about the middle through which the bolt will sail. It is more like a washer about the middle of the bolt. It does not in any way avoid the need for separating the upper arc and bottom arc of the couple.

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b) Turning to D2, here a bush like substance is placed in the bolt portion between the connecting members so that it prevents both ends of the connecting members from converging. The present invention does not bear any similarities to D1 & D2 due to its collapsibility.

4. Heard both sides. This Court weighed the submissions of the learned counsel and also perused the records. This Court finds that the petitioner's invention operates on a different concept which cannot be considered as very obvious prima facie D1 & D2. It is not made evident how a person skilled in the art will find his invention obvious when the Controller has already conceded that the appellant's is novel.

5.In view of the same, this Court deems it appropriate to set aside the order of the Controller and remands the matter back to the Controller. To save embarrassment to the Controller who had earlier decided the matter and passed the impugned order, this Court requires that some other controller to consider the petitioner's application and its sustainability. In the eventuality

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of petitioner's invention pass the scrutiny of the Controller it may have only about 15 months as its effective shelf value. This Court therefore, requires the Controller who would now be in charge of the issue, to dispose of the matter within a period of four (4) months from the date on which it assumes charge of the issue.

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

27.02.2024

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Index : Yes / No
Neutral Citation: Yes / No

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