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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 06.03.2024

CORAM :JUSTICE N.SESHASAYEE

(T)CMA(PT) No.5 of 2023
(OA/3/2018/PT/CHN)

MONSNTO TECHNOLOGY LLC
800, North Lindbergh Blvd.,
St.Louis Missouri 63167
United States of America
Through its Authorised Representative
Mr.Thomas P.McBride ... Appellant

Vs.

The Assistant Controller of Patents and Designs
Patent Office, Chennai
Boudhik Sampada Bhawan
GST Road, Guindy
Chennai - 600 032. ... Respondent

PRAYER: Transferred Civil Miscellaneous Appeal (Patent) filed under Section 117-A of the Patents Act, 1970, praying to allow the appeal and to set aside the impugned order of the respondent dated 19.04.2017 and pass an order granting patent on Indian Patent application No.5415/CHENP/2009, and issue consequential directions to effectuate such grant or to pass any other order as this Court may deem fit.

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For Appellant : Ms.Vindhya S.Mani
Mr.Kiran Manokaran
Ms.Krithika Jaganathan
for M/s.Lakshmikumaran and Sridharan

For Respondent : Mr.S.Janarthanam
Senior Panel Counsel

JUDGMENT

Aggrieved by the order of the Patent Controller rejecting the application for patenting its invention titled '*Chloroplast Transit Peptides for Efficient Targeting of DMO and Uses thereof*' which has its use essentially in the field of plant biotechnology, the inventor has preferred this appeal.

2. The brief facts are :

a) In its application for patenting its aforesaid invention, the appellant had made 12 claims, of which 3 are its independent claims.

b) It eventually evoked FER wherein the respondent had taken objection for patenting its invention under Sec.2(1)(ja) backed by one prior art, namely D1., Sec.3(j), Sec.3(g) and Sec.10(5) of the Patents Act.

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c) The appellant responded to the same and amended its claims, and increased it from 12 to 13.

d) This is followed by a hearing notice, and the Controller has cited two prior arts namely D2 and D3. The appellant participated in the hearing, and filed its written submissions.

Ultimately, the Controller chose to reject the appellant's application on Sec.2(1)(ja) based on D1 to D3, and Sec.10(5). This is now under challenge.

3. Heard both sides. The learned counsel for the appellant made a short candid statement. The Controller had confined her objection under Sec.10(5) to claim No.2 and the objection under Sec.2(1)(ja) to claim No.1 of the amended claims. In that eventuality, the Controller, at least should have considered the other claims of the appellant, but she opted not to do it. Secondly, the Controller had cited D2 and D3 in rejecting the appellant's application, of which D1 and D2 are subsequent prior arts, to be more specific, they had come into existence after the appellant had filed its application for grant of patent, a fact the appellant did not realise when it filed its written submissions.

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4. This Court considered the submissions made and verified its correctness upon perusal of the records. To conclude, this Court allows the appeal, sets aside the impugned proceedings of the respondent dated 19.04.2017, 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 three years, 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. No costs.

06.03.2024

ds

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

To:

The Assistant Controller of Patents and Designs
Patent Office, Chennai
Boudhik Sampada Bhawan
GST Road, Guindy
Chennai - 600 032.

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N.SESHASAYEE, J.

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