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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 25.07.2024	Pronounced on:02.08.2024

CORAM:

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

(T) CMA (PT) No.227 of 2023

TVS MOTOR COMPANY LIMITED,
"Jayalakshmi Estates",
No.29 (Old No.8), Haddows Road,
Chennai 600 006, India.

.. Appellant

..Vs.

The Controller of Patents,
The Patent Office,
Chennai.

.. Respondent

Prayer: This appeal came to be numbered by transfer of IPAB Case OA SR.No.189/2020/PT/CHN from the file of the Intellectual Property Appellate Board, Chennai praying to quash and set aside the impugned order and allow the Patent Application to proceed to grant. The grant of the Patent Application be expedited as the Patent Application has been pending since the year 2011 with the Patent Office.

For Appellant :Mr.Thriyambak J.Kannan,
assisted by
Mr.S.Harish for
M/s.Khaitan & Co.

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For Respondent :Mr.Prasad Vijayakumar,
Senior Panel Central Government
Standing Counsel

J U D G M E N T

The appellant, aggrieved by the impugned order rejecting the Patent Application in 4590/CHE/2011, in and by an order dated 08.08.2020, has preferred the present appeal.

2. I have heard Mr. Thriyambak J.Kannan, assisted by Mr.S.Harish for M/s.Khaitan & Co. learned counsel for the appellant and Mr.Prasad Vijayakumar, learned Senior Panel Central Government Standing Counsel for the respondent.

3. The learned counsel for the appellant, Mr.Thriyambak J.Kannan, would take me through the specifications and the claims made and would submit that there has been total non-application of mind on the part of the respondent while rejecting the Patent Application. He would also submit that the respondent has not assigned any reasons whatsoever for ultimately

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rejecting the Patent Application. He would also take me through the written submissions as well as the explanation to the First Examination Report (FER) to fortify his contention that, despite the objections of the respondent being adequately explained and met, none of it has been considered by the respondent in the final order, rejecting the Patent Application.

4. The learned counsel for the appellant would also submit that for the very same invention, the appellant has been successfully granted Patents in several other countries and though the same may not have a binding effect, according to the learned counsel of the appellant, the foreign Patents certainly had a persuasive effect on the Indian Patent Controller and unfortunately, none of these have even been touched upon by the respondent in the final order.

5. In support of his submissions, he would place reliance on the following decisions,

5.1. In ***AGFA NV and Anr vs. The Assistant Controller of Patents and Desings & Anr in CA.(COMM.IPD-PAT)477/2022 dated 02.06.2023,*** where the Delhi High Court held that when the claim is rejected on the

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ground of 'common general knowledge', the order should provide reference for such 'common general knowledge'. The learned counsel for the appellant referring to this decision would submit that even in the instant case,the respondent has cited 'common general knowledge' in the art.

5.2. In ***Microsoft technology licensing vs. The Controller of Patents and Designs and Anr, in CMA(PT)No.21 of 2023 dated 20.09.2023,*** this Court held that when same prior art documents were taken into consideration before Patent was granted by Foreign Patent Office, the test of obviousness being common across jurisdictions, at least a material consideration ought to have been undertaken while deciding the Patent Application.

5.3. In ***Pinnacle Engines Inc and another vs Assistant Controller of Patents & Designs,*** reported in ***2024 SCC Online Mad 1052,*** while deciding a Patent Appeal, this Court held that when there is no analysis or discussion of the features of the claimed invention, then the impugned order is effectively unreasoned and cannot be sustained.

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5.4. In the case of ***Stempeutics Research Pvt.Ltd vs. The Assistant Controller of Patents and Designs***, reported in ***MANU/IC/0023/2020,*** the Delhi High Court held that when identical claims have been granted in major jurisdictions and yet patent claims were rejected in India, the same was in contradiction to the statements and objects of the Patents Amendment Act 2005, thereby amounting to injustice and also resulting in acting against the principles of equity and fair play.

6. The learned counsel for the appellant further submit that the respondent has also not objectively considered that in the prior arts, the system involved was hydraulic whereas, in the claimed invention it was electric and further prior arts D4 to D6 were pertaining only to four wheelers whereas, the claimed invention was only limited to two wheelers. Further, the learned counsel for the appellant would submit that the finding of the respondent that combined teachings of D1 to D6 were not teaching away from the claimed invention is also unsustainable, since there has been no specific findings as to how the prior arts or even the combined effect of the prior arts would lead to obviousness in the claimed invention.

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7. The learned counsel for the appellant would also rely on the observations made by the respondent with regard to inventive steps referred in the counter affidavit filed by the respondent, where the respondent Controller has stated that the appellant claims to provide an electrically operated clutch actuator for an automatic transmission system for automatically actuating a clutch before a gear shift operation, "thereby removing the need for a clutch lever, and thereby increase the operator's comfort….". The learned counsel for the appellant referring to the said statement in the counter affidavit at paragraph 5 would submit that the respondent Controller has not even understood the invention claimed in a proper manner, since the appellant never did away with the need for a clutch lever in the first place. The learned counsel for the appellant would therefore submit that it is a fit case for remand and fresh consideration of the Patent Application of the appellant.

8. Per contra, the learned counsel for the respondent, Mr. Prasad Vijayakumar would submit that the impugned order is well reasoned and does not deserve even a remission. He would submit that at all stages the appellant was given a fair and adequate opportunity and there can be no

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grievance on the ground of violation of principles of natural justice. He would further submit that right at the inception, namely in the First Examination Report on 15.06.2018, the respondent had objected to the claimed invention on the ground of lack of inventive step and also being obvious in view of teachings in D1 and D2. He would further submit that even under D5, an Opposition Application was made by Bajaj Auto Limited and that was also brought to the notice of the appellant and explanation was sought for. He would further submit that merely because Bajaj Auto Limited had withdrawn their Opposition, it would not automatically result in the said objection also being waived and it was still incumbent on the appellant to explain and differentiate the claimed invention from prior art D5.

9. With regard to the Foreign Patents, Mr. Prasad Vijayakumar, learned counsel for the respondent would submit that they only had a persuasive value and when, the appellant had failed to satisfy the several objections taken by the respondent at every stage of the proceedings, the respondent had rightly rejected the Patent Application. He would further submit that the exchange of documents/correspondence also would be

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relevant for consideration in this Appeal and the mere omission of the controller to refer to some of the objections raised earlier would not entail rejection or setting aside of the impugned order.

10. Further, the learned counsel would also submit that the prior arts were all relating to vehicles and not differentiating between two wheelers and four wheelers and therefore, he would state that there was no merit in the submission of the learned counsel for the appellant in this regard.

11. He would further submit that the appellant has not given satisfactory explanation or reasons and he would take me through the written submissions and support his submissions that the very same explanation has been offered by the appellant for all the prior arts. The learned counsel for the respondent would therefore pray for dismissal of the appeal.

12. I have carefully considered the rival submissions advanced by the learned counsel on either side. Admittedly, the Original Application made by the appellant included nine claims and after the FER, two of the claims were dropped, viz., claims 4 and 9 and claim 1, which was the principal

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claim was also amended.

13. In response to the FER, the appellant has given its explanation in an attempt to meet the prior arts D1 and D2. Subsequently, prior arts D3 to D6 were added during the hearing notice, which were also sought to be met by the appellant by way of written submission. It is seen from the written submission that detailed explanation has been offered as to how the claimed invention was different from the teachings of the prior arts and had an inventive step and a technical advancement over the teachings of the prior arts. Admittedly, the same invention which now stands rejected by the respondent has been granted patent in several foreign countries. The same is not in dispute. On a reading of the impugned order, I find that there is absolutely no discussion about the Foreign Patents granted to the appellant. In the impugned order, the respondent after extracting the amended independent claim discussed prior arts D3 and D4 as well as D5 and D6 and straight away jumped to the conclusion that he was of the view that any person skilled in the art can be easily inspired to arrive at features of claim 1, by combining the knowledge of cited documents D1 to D6 and from common general knowledge in the art.

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14. Unfortunately, the impugned order suffers on the following grounds:

(i) Having referred to common general knowledge in the art, the respondent has not even set out the source of said general common knowledge, leave alone discuss the same and arrive at a finding as to how such general common knowledge would render the Patent Application obvious to a person skilled in the art.

(ii) Secondly, the controller has merely found that any person skilled in the art would be easily inspired by the combined teachings of D1 to D6 prior arts to arrive at features in claim 1. This finding again, is totally unsubstantiated and I find in the impugned order that there is absolutely no discussion with regard as to how the claimed invention pitted against the prior arts would enable the Controller to arrive at such a decision.

15. Moreover, when the very same invention has been recognized and most of the prior arts cited against the present invention have already been tested by foreign patent offices before granting Patent, it is fundamental that the respondent at least refers to such patents granted abroad and give reasons as to why the same cannot be applied or adopted in India. However,

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I do not find even a reference to the foreign patents granted in respect of the very same invention.

16. In fine, for all the above foregoing reasons, I deem it fit to remit the matter to the respondent controller for a *denovo* scrutiny of the appellant's Patent Application. The respondent shall assign the task of scrutinizing the Patent Application of the appellant to a different Patent Controller to avoid embarrassment to the parties and such exercise shall be completed within a period of three (3) months from the date of receipt of copy of the judgment after recording fair opportunity to the appellant.

17. In fine, the Appeal is allowed with the above directions. No costs.

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

To

The Controller of Patents,
The Patent Office,

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Chennai.

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P.B.BALAJI,J.

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