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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **18.12.2023**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT)/15/2023

Martinswerk GmbH,
Kolner Strasse 110, 50127 Bergheim,
Germany; a German Company
Rep. by its Authorized Representative
Mr.Raghavan Ravindran Nair, De Penning & De Penning,
Having Office at No.120, Velachery Main Road,
Guindy, Chennai - 600 032. ... Appellant

-vs-

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

PRAYER: Civil Miscellaneous Appeal (Patents) is filed under Section 117-A of the Indian Patents Act, 1970, praying to call for the records of the Respondent culminating in the Impugned Order dated 28.05.2021 rejecting the Grant of Patent and Set Aside the same and

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consequently direct Grant of the Patent in respect of the Appellant's Application No.201748011754.

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

For Respondent : Mr.M.Karthikeyan, SPC

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JUDGMENT

The appellant challenges an order dated 28.05.2021 by which Patent Application No.201748011754 was rejected.

2. The appellant filed an divisional application for grant of patent for the invention entitled "Aluminum Trihydrate Particles". According to the appellant, this was a divisional application in relation to Application No.7047/CHENP/2008, which was filed on 21.06.2007. By First Examination Report (FER) dated 20.02.2020, objections were raised on the grounds of insufficiency of disclosure

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and lack of clarity and conciseness. The FER was responded to on 18.11.2020. After a hearing on 08.03.2021, the appellant filed written submissions on 22.03.2021. The impugned order was issued in the said facts and circumstances.

3. Learned counsel for the appellant invited my attention to the impugned order. With reference to paragraph 3 thereof, learned counsel submitted that the respondent recorded the conclusion that the application does not fulfil the requirements of Section 16 of the Patents Act, 1970 (the Patents Act), without providing any reasons in support of the conclusion. Although the impugned order draws reference to the hearing notice, learned counsel submits that even the hearing notice merely records conclusions that the features cited in the divisional application overlap with features set out in the parent application. In support of the contention that the application qualifies as a divisional application, learned counsel relies upon the written opinion of the International Searching Authority (ISA) in respect of the corresponding PCT application. He points out that the

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ISA concluded that the application contains four separate inventive concepts and that the application does not meet the requirements of unity of invention. According to learned counsel, the divisional application corresponds to the second concept outlined in the written opinion of the ISA.

4. Learned counsel further submitted that the conclusion of the respondent that the applicant did not respond to point no.2 of the hearing notice is contrary to fact. In this connection, he pointed out that the written submissions contain a detailed response to point no.2 of the hearing notice and that the same was not referred to or considered by the respondent while recording such conclusion. Since the impugned order is completely unreasoned, learned counsel submits that the said order is liable to be set aside, and the matter remanded for re-consideration.

5. In response to these submissions, it was submitted on behalf of the respondent that the appellant's claims relate to both surface

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area and pore volume. Therefore, it is submitted that the complete specification does not disclose more than one invention. Learned counsel referred to Section 2(1)(j) of the Patents Act and pointed out that the requirements specified therein should be satisfied in order to conclude that an application consists of more than one invention and that, therefore, a divisional application may be filed in respect thereof. The next submission of learned counsel was that the disclosures at paragraphs [0036] to [0049] of the complete specification are insufficient for enabling a person skilled in the art to prepare ATH particles having the BET specific surface areas and maximum specific pore volumes indicated in independent claim 1. Therefore, he submits that the requirements of Section 10(4) of the Patents Act are not satisfied.

6. The impugned order should be examined against the backdrop of the rival submissions. The operative portion of the impugned order is set out below:

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"The present application relates to alumium hydorixde flame retardants and their use. The agent for the applicant argued that the features of the parent application are different from the feature of the present application. So, the present application should be allowed as a divisional application. However, office is in the opinion that the application does not fulfill the requirements of section 16 in view of the objections raised in the hearing notice. The agent for the applicant not given reply submissions w.r.to point no.2 of other requirements and the application failed to disclose the best method to perform the invention for which the protection is sought. In view of the above, the objections raised in the hearing notice still stands."

7. While drawing the conclusion that the application does not fulfil the requirements of Section 16, the respondent has merely referred to the objections raised in the hearing notice. In the hearing notice, the respondent records that the parent application does not

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contain more than one invention and that the features cited in the divisional application overlap with the features claimed in the parent application. The basis for the said conclusions are not recorded. Moreover, learned counsel for the appellant referred to the written opinion of the International Searching Authority and to the conclusion therein that four separate concepts of invention are contained in the PCT application and that it does not meet the requirements of unity of invention. These contentions were also raised in the written submissions of the appellant but the respondent failed to engage with these contentions and record reasons for rejecting the same. Similarly, as regards point no.2 of the hearing notice, the appellant has responded to the same in its written submissions. Once again, the said response has not been dealt with while recording the conclusion that the appellant did not reply in respect of point no.2.

8. For reasons set out in the preceding paragraph, the impugned order is unsustainable and is, hereby, set aside.

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Consequently, the matter is remanded for re-consideration on the following terms:

(i) In order to preclude the possibility of pre-determination, an officer other than the officer who issued the impugned order shall undertake such re-consideration.

(ii) After providing a reasonable opportunity to the appellant, a reasoned decision shall be issued within a period of ***three months*** from the date of receipt of a copy of this order.

(iii) It is made clear that no opinion is expressed herein on the merits of the application.

9. Therefore, CMA(PT)/15/2023 is disposed of on the above terms without any order as to costs.

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Neutral Citation: Yes / No

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