WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 27.02.2024

Pronounced on : 15.03.2024

CORAM : JUSTICE N.SESHASAYEE

W.P.(IPD) No.1 of 2024
and WMP.Nos.1 & 2 of 2024

Ashok Leyland Limited
Represented by its Authorised Signatory
Mr.Mahesh Thakar
No.1, Sardar Patel Road
Guindy, Chennai - 600 032. ... Petitioner

Vs

1.The Controller of Patents & Designs
The Patent Office, Chennai
Patent Office Intellectual Property Building
G.S.T.Road, Guindy
Chennai - 600 032.

2.Tata Motors Ltd.,
Bombay House
24 Homi Mody Street
Hutatma Chowk
Mumbai - 400 001. ... Respondents

PRAYER : Writ Petition filed under Article 226 of the Constitution of India praying to issue a Writ of Certiorarified Mandamus, calling for the records of the recommendations passed by the first respondent pertaining to Opposition Proceedings initiated by respondent No.2 against petitioner's

https://www.mhc.tn.gov.in/dis

WEB COPY

Patent bearing IN387429, the Recommendation of the Opposition Board issued under Rule 56(4) of the Patent Rules dated 31.10.2023, and quash the same and consequently direct the respondent No.1 to consider the documents filed by the petitioner and the respondent No.2 to consider the matter afresh by reconstituting a fresh Opposition Board for providing a fresh Joint Recommendation.

For Petitioner : Mr.M.S.Bharath

For Respondents : Mr.J.Madanagopal Rao
Senior Panel Counsel for R1

Mr.P.V.Balasubramaniam, Senior Counsel
Assisted by Ms.Archana Shankar,
Mr.K.Premchandar, Mr.N.C.Vishal
Mr.Ravi Aggarwal & Mr.N.Shrivatsav
of M/s.Anand and Anand for R2

ORDER

This writ petition is filed challenging the recommendations of the Opposition Board constituted under Rule 56 of the Patent Rules.

2.1 The issue roams within a narrow space. The petitioner is keen to defend its patented invention titled "*Multi-Axle Vehicle Configuration having Heavy Duty Lift Axle*". To describe the same in a layman's language, a multi

https://www.mhc.tn.gov.in/ipdis

WEB COPY

axle vehicle invariably will have two major parts: The front portion is called the tractor (where the engine will be) and the rear portion is the chassis-trailer which will be attached to the tractor. In the context of the present case, further details of the petitioner's invention may not be necessary. The facts relevant to the context of the present case are:

a) Subsequent to the grant of patent to the above invention of the petitioner, the 2nd respondent herein came out with its opposition to the grant of patent under Section 25(2) of the Patents Act. Along with it, it also, filed the evidence of Dr.Anoop Chawla and Mr.Amit Kumar Gupta, both of whom are claimed to be experts in the field. In response, the petitioner-patentee had filed its reply statement with two evidences – the affidavits of certain Dr.S.Ramamurthy and Dr.Sathya Prasad Mangalaramanan, who according to the petitioner are also experts in the field.

b) The matter was then duly placed before the Opposition Board constituted under Rule 56 of the Patent Rules by the Controller. On 31.10.2023, the Opposition Board has come out with its recommendations (henceforth would be referred to as the OBR). Now the matter is posted for hearing by the Controller of Patents on

https://www.mhc.tn.gov.in/ipdis

WEB COPY

07.02.2024.

According to the petitioner, the Opposition Board had a made an easy job of its responsibility when it merely cut-copy-pasted the written statement of the 2nd respondent and the reply statement of the petitioner and its impressions on them, but sans the evidence which both the parties. The failure to consider the evidence of both the petitioner and the 2nd respondent has rendered the OBR incomplete. The OBR however, is no ordinary document, but will be a foundational document when the Controller takes up the matter for hearing, and hence it assumes considerable significance. Since the Opposition Board has omitted to consider the evidence produced by both the sides, the entire exercise that it undertook has been reduced to a cosmetic exercise. It is plainly incomplete and an incomplete OBR cannot be a foundational document during hearing. Hence the challenge is made to the OBR.

2.2 None filed the counters, but the respondents opposed the sustainability of the relief sought in the petition.

3. Placing reliance on ***CIPLA Ltd. v. Union of India and others*** [(2012) 13

https://www.mhc.tn.gov.in/ipdis

WEB COPY

SCC 429], the learned counsel for the petitioner submitted that the Hon'ble Supreme Court had not only made a strong statement regarding the significance of the OBR, but had also emphasized that the Opposition Board needs to consider the evidence produced by the parties. It may be that the petitioner may have an opportunity to address the flaws in the OBR before the Controller, and may also require him to consider the evidence which the opposition board had failed to consider, yet the apprehension is not based on any competency or integrity of the Controller, but on the possible adverse economic ramification of the decision of the Controller affecting the balance sheet of the petitioner company if the Controller unconsciously allows himself to be swayed by the OBR. Indeed, the petitioner has a substantial market presence for its invention, which has enabled it to produce a turn over of over ?66 billion. It is hence, the OBR requires a revisit, and must be set aside and a new Opposition Board may have to be constituted for making a fresh recommendations. Reliance was placed on the judgements in ***Merck Sharp & Dohme Corporation & another Vs Glenmark Pharmaceuticals Ltd.*** (CS(OS)586/2013 & CC.No.46/2013 & I.A.Nos.9827/2013, 8048/2014 & 13626/2015); ***The Regents of the University of California v. Union of India & others*** (WP(C)1163/2017 and

https://www.mhc.tn.gov.in/ipdis

WEB COPY

CM APPL.38867/2017); ***Akebia Therapeutics INC v. Controller General of Patents and Others*** (2023 SCC Online Del.4841); ***Optimus Drugs Private Limited, Vs. Union of India*** (2023 SCC Online Mad 8013) (paragraph 8 and 9).

4. Distinguishing the authorities on facts, the learned counsel for the second respondent submitted that :

(a) Contrary to the contention of the petitioner that the evidence of the experts have not been considered, the Opposition Board did consider their evidence but without reference to the names of those who have given the evidence. (A elaborate tabulation highlighting the places where the OBR has considered the evidence was provided)

(b) In its opposition, the second respondent has raised five objection to the grant of patent, but the Opposition Board has approved just one, and rejected the rest. This belies the allegation that the Opposition Board had not applied its mind and that its recommendations are but a product of cut-copy-pate technology.

https://www.mhc.tn.gov.in/ipdis

WEB COPY

(c) At the end of the day, OBR by its very nomenclature has only a recommendatory value, and it is not binding on the Controller of Patents. Both sides can still persuade the Controller to consider the evidence filed by them, and it is for the Controller to take a call. A mere allegation that the OBR is incomplete is not adequate to invite interference of this Court in judicial review, since the OBR has only a recommendatory value.

(d) The petition is not maintainable, since there cannot be a challenge to the recommendations of the Opposition Board since the Controller has a duty to take an independent call on the issue before him. Hence, the Court may not preempt the Controller as to how how he may weigh the OBR at this stage. Reliance was placed on the ratio of the order of the Delhi High Court in ***Willowood Chemicals Private Limited Vs Assistant Controller of Patents and Designs & Anr*** [W.P.(C)-IPD 15/2023 & CM No.34-35/2023]; ***Pharmacyclics LLV Vs Union of India and others*** [W.P.(C) 12105/2019 & CM Appls.49593 to 49595 of 2019], and ***Novo Nordisk A S Vs Union of India and others*** [W.P.(C)-IPD 19/2022 & CM 68-69/2022].

https://www.mhc.tn.gov.in/ipdis

WEB COPY

(e) The petitioner's apprehension is not based on what has happened but is based on what is likely to happen. In that context, it has exaggerated its turnover to support what it claims.

Discussion and Decision :

5. The rival contentions are carefully weighed alongside the authorities that both sides have relied on. It is indisputable that the Opposition Board is a statutory creation and that it is mandated to consider all the materials which the parties are required to produce under Rule 57 to Rule 60 of the Patent Rules. In the present case, there is no controversy that both the second respondent as well as the petitioner have filed their written statement and the reply statement, as the case may be, along with the respective evidences of the experts. According to the petitioner, even though the Opposition Board had the advantage of examining all the materials produced by the parties, yet it did not consider the evidence produced by both the sides. This allegation is disputed by the second respondent whose counsel tried to demonstrate how and where in its report, the Opposition Board has considered the evidence provided by the parties but without referring to

https://www.mhc.tn.gov.in/ipdis

WEB COPY

them by their names. There however, is a larger question: how far can this Court interfere with the OBR in judicial review.

6. As stated earlier, there is no controversy that such of the materials which the parties had filed under Rule 57 to Rule 59 have been placed before the Opposition Board by the Controller. The point is as long as those materials which the Opposition Board is required to examine under Rule 56(4) are made available to it, then the extent to which the evidence are considered and appreciated by the Opposition Board is left to the Opposition Board. Both the materials which the Opposition Board is required to examine under Rule 56(4) as well as the recommendations it ultimately comes out with, involve complex issues of scientific applications. Therefore, it may not be appropriate for this Court, in exercise of its jurisdiction under Article 226 of the Constitution to examine the adequacy of such recommendations.

7. This apart, the OBR by its very nomenclature is only intended to be a recommendation and hence it is not binding on the Controller. It is like any other piece of evidence, something akin to a Commissioner's report received in evidence under Order XXVI Rule 10 of CPC. And going by the scheme

https://www.mhc.tn.gov.in/ipdis

WEB COPY

of the Patent Act, and the Rules framed thereunder, the duty is cast on the Controller to decide on the qualitative merit or otherwise of the OBR. To state it differently, OBR will be one of the materials which the Controller will be considering along with the oral and written submissions of the parties during its scheduled hearing on the opposition of the second respondent. Therefore, the petitioner will have an opportunity to expose its perceived inadequacy of the OBR. In a situation such as this, it may not be appropriate for this Court to pre-empt a decision on the quality of the OBR in judicial review. Therefore, notwithstanding the fact that the OBR is a foundational document during final hearing, yet, to enter a finding as to the reliability of the OBR is inappropriate as the statute has assigned it to the Controller.

8. If however the Controller during final hearing considers that the OBR now presented by the Opposition Board finds merit in the contention of the petitioner vis-a vis its alleged failure to consider the evidence of the experts, then it is for the Controller to reconstitute the Opposition Board and to require such Board so constituted to make its recommendations.

https://www.mhc.tn.gov.in/ipd

WEB COPY

9. To conclude, this Court does not find any merit and the writ petition stands dismissed. No costs. Consequently, connected miscellaneous petitions are closed.

10. At the time of pronouncing the order, the counsel for the petitioner submitted that inasmuch as the optimism of the petitioner vis-a-vis the cause he has raised in this petition now ended in disappointment, he needs to prepare for the final hearing before the Controller, for which he needs some time. The other side submitted that any reasonable time may be granted. The Controller may now hold an hearing on 10.04.2024.

15.03.2024

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

To:
The Controller of Patents & Designs
The Patent Office, Chennai
Patent Office Intellectual Property Building
G.S.T.Road, Guindy
Chennai - 600 032.

WEB COPY

N.SESHASAYEE.J.,

ds

Pre-delivery order in
W.P.(IPD) No.1 of 2024

15.03.2024