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IN THE HIGH COURT OF JUDICATUE AT MADRAS

DATED: 12.12.2024

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THE HONOURABLE **MR. JUSTICE ABDUL QUDDHOSE**

(T)CMA(PT) No.149 of 2023

1.Vellaisamy Thavamani Pandi
2.Thavamani Pandi Jeyanthi Rani .. Appellants

Vs

1.The Controller of Patents & Designs,
Guindy, Chennai – 32.

2.The Assistant Controller of Patents & Designs,
IPO Buildings, Plot No.32,
Dwarka, New Delhi – 110 075. .. Respondents

Prayer: This appeal is filed under Section 117-A of the Patents Act, 1970 (39 of 1970) and the Patent Rules, 2003, seeking to allow the appeal and set aside the impugned order dated 28.11.2018 passed by the second respondent in Indian Patent Application No.201841013760 and proceed with grant of the patent; and in the alternative, remand the Indian Patent Application No.201841013760 before the respondent with a direction for fresh and time-bound hearing.

For Appellants : Mr.K.Muthuselvam
for M/s.K and S Partners

For Respondents : Mr.M.Satyan, ACGSC

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JUDGMENT

This appeal has been filed challenging the impugned order dated 28.11.2018 passed by the second respondent refusing to grant patent to the appellants' claimed invention under the title “System for construction of composite U shaped reinforced girders bridge deck and methods thereof”, on the ground that claimed invention is not patentable as per Section 3 of the Patents Act, 1970.

2. The appellants have challenged the impugned order on the following grounds:-

(a) By total non-application of mind to the fact that for the very same invention, the appellant had obtained patent from various other countries, the respondent has passed the impugned order refusing to grant patent in India.

(b) Eventhough in the hearing notice dated 10.09.2018 sent to the appellants, the respondent had stated that there is an inventive step in the appellants' claimed invention, by total non-application of mind to the said fact, in the impugned order, the respondent has held that there is no inventive step in the applicants' claimed invention, which is arbitrary.

(c) The respondent has not disclosed in the impugned order as to in

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which sub-clause of Section (3) of the Patents Act the claimed invention of the appellant has been rejected.

3. The learned counsel for the appellants drew the attention of this Court to the impugned order in respect of the aforementioned grounds raised by the appellants in this appeal.

4. The learned standing counsel for the respondents reiterated the contents of the impugned order and would submit that only due to the fact that there is no inventive step in the appellants' claimed invention, the patent application of the appellants was refused as per Section 3 of the Patents Act. He also drew the attention of this Court to the relevant portion of the impugned order in respect of his contention.

5. However, as seen from the impugned order, the following facts are undisputed:-

(a) The appellants have obtained patents in respect of their invention before various other countries. However, the same has not been considered in the impugned order. Unless the patents obtained by the appellants before other jurisdictions are considered by the respondent,

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the respondent cannot also come to the conclusion as to whether the patents obtained by the appellant before other jurisdictions are not identical to the patent sought for by the appellants in India, which is the subject matter of consideration in this appeal.

(b) In the hearing notice issued by the respondent dated 10.09.2018 to the appellants, an observation has been made that there is an inventive step in the appellants' claimed invention. However, as seen from the impugned order, a finding has been rendered by the respondent stating that there is no inventive step in the appellants' claimed invention. There is no reason given in the impugned order as to why the decision has been changed from the hearing notice by giving a finding that there is no inventive step in the appellants' claimed invention.

(c) In the impugned order, the respondent has refused to grant patent by stating that the appellants' claimed invention is not patentable as per Section 3 of the Patents Act. However, the respondent has failed to indicate under which sub-clause of Section 3 of the Patents Act the appellants' claimed invention falls. Therefore, necessarily, while refusing to grant patent, the respondent ought to have mentioned the sub-clause of Section 3 of the Patents Act to enable the appellants to know under what category the appellants' claimed invention falls for refusal to grant patent.

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6. In the impugned order, there is an observation made by the respondent in paragraph C that a reply to the First Examination Report (FER) dated 20.08.2018 was submitted by the petitioners'/applicants' agent on 23.08.2018 and the said reply was also re-examined by the Examiner and subsequently, this was also communicated to the petitioners/applicants through Second Examination Report (SER) dated 28.09.2004. It is also observed that the application filed by the petitioner failed to comply with the requirements and the application was abandoned under Section 21(1) of the Patents Act. On the face of it, the said observations are arbitrary and have been made by total non-application of mind, as admittedly, there was no SER on 28.09.2004. Admittedly, when FER itself is on 20.08.2018, the question of SER held on 28.09.2004 does not arise. Therefore, the observation made by the respondent in paragraph C of the impugned order is absurd.

7. Necessarily, the respondent, being a quashi-judicial authority, will have to pass order refusing to grant patent by applying its mind to the claimed invention as per the provisions of the Patents Act. As seen from the above, it is clear that by total non-application of mind to the

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contentions of the appellants, the respondent has passed the impugned order, which is arbitrary, and not in accordance with the statutory provisions as provided under the Patents Act.

8. For the foregoing reasons, the impugned order dated 28.11.2018 passed by the second respondent is hereby set aside and the matter is remanded back to the respondents for re-consideration on merits and in accordance with law and the following directions are issued by this Court to the respondents:-

(a) In the interest of justice and in order to avoid the possibility of pre-determination, an officer other than the officer who issued the impugned order shall undertake the re-consideration;

(b) such re-consideration shall be undertaken by taking into account the observations set out in this judgment; and

(c) a fresh order in Application No.201841013760 shall be passed within a period of six months from the date of receipt of a copy of this judgment.

In the result, this appeal is disposed of. No Costs.

12.12.2024

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Index:yes/no
Neutral citation: yes/no

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ABDUL QUDDHOSE,J.

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