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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 06.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT)/208/2023
(OA/SR.296/2015/PT/CHN)

INDUSTEEL FRANCE
Formerly known as INDUSTEEL CREUSOT
Nationality: French Company
1a 5 Rue Luigi
Cherubuni SAINT DENIS
93200 Saint-Denis
France
Through its Authorized Representative
Ms.Sophie Plaisant ... Appellant

Vs.

The Assistant Controller of Patents, Design, Trade Mark
And Geographical Indications
Patent Office
Intellectual Property Rights Building
G.S.T Road, Guindy
Chennai 600 032 ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) is filed under Sections 117 A of the Indian Patents Act, 1970, praying (1) to allow the

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present appeal; (2) pass an order setting aside the impugned order dated 16.01.2015 passed by the respondent; (3) pass an order granting a patent on Indian Patent Application No.119/CHENP/2007 in favour of the appellant.

For Appellant : Mrs.Vidhya S Mani

For Respondent : Mr.K.Gunasekar
SPC CG

JUDGMENT

1. The learned counsel for the appellant narrated certain facts which on the face of it are disturbing. They are as below:

- Pursuant to the filing of the application and the examination subsequently made, the respondent came out with his FER dated 24.02.2012, wherein he has raised an objection for patenting the invention of the appellant under Section 3(k) and cited D1 to D10 as the prior arts. In simple terms, the 1st objection and perhaps the only objection raised by the controller is that he intended not to treat the invention of the appellant as an invention. The appellant, responded to the same.

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- This was followed by a hearing notice dated 26.12.2012, wherein the date of hearing was notified as 30.01.2023. In this, the controller had abandoned all the ten prior arts which he had earlier cited in his FER and also abandoned his objection under Section 3(k) of the Act. He would now come out with an objection under Section 3(c).

- Another objection he raised was under Section 2(1)(ja), as the invention was lacking in inventory step, and tried to support it with two new prior arts in D1 and D2. The appellant participated in the hearing and also submitted its written submissions.

- The Controller would now issue a second hearing notice dated 31.07.2013, wherein he has fixed the date of hearing as 27.08.2013. In this he abandoned the two prior arts introduced in the first hearing notice and introduced another set of two prior arts. It abandoned the objection under Section 3(c). The appellant again participated in the hearing and had also filed its

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written submissions. Ultimately, the Patent Controller chose to dismiss / reject the appellant's application for patent vide its impugned order dated 16.01.2015.

2.Developing her arguments further, the learned counsel for the appellant submitted that the concerned Patent Controller has been constantly changing the goal post, which implies that the appellant is put to considerable procedural inconvenience. Indeed, every applicant has 12 months time to respond to a FER, but to a hearing notice they hardly get two months time. When new prior arts are frequently changed, it every time puts the applicant on the back foot and they are driven to desperation to meet the time line. But in the instant case, the Controller had gone one step ahead and kept issuing more than one hearing notice and also kept altering the position all the time. He had taken literally more than one and half years to pass his orders and that too with inadequate discussion of the written submission filed by the appellant after the second hearing.

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3.Heard both sides. This Court perused the papers. This Court is satisfied that this Controller hardly seems to understand the anxiety of an inventor and having the same patented. There appears to be a strong attitudinal problem with this Controller as he not just appears to be changing the goal post, but seems to be running with the goal post, and expects an applicant for patent to run along with him all the time. This apparently is not the legislative intent behind the enactment. When a Controller makes his examination, it has to be a thorough study of the applicant's specifications and claims. And when a FER is brought out by him, that will form the basis for further examination of any applicant's entitlement to have the invention patented. There can be a scenario, on going through the response of an applicant to a FER, the Controller may notice certain aspects omitted to be considered during examination and may change the prior arts. But then that should not become an endless exercise for it holds the potential to kill the scientific temper of an inventor.

4.Turning to merit, the Controller has made a cryptic statement that he is not

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satisfied with the arguments made on behalf of the appellant without explaining as to why and how of it.

5.The conclusion is to state the obvious. This matter has to go through the filters of the Patent Act yet another time, and hence remanding the matter emerges as an automatic choice.

6.To conclude, this appeal stands allowed. The impugned order dated 16.01.2015 passed by the respondent is hereby set aside. The matter is remanded back. This Court does not consider that the Patent Controller who had already passed the order is good enough to consider it again, and hence it directs that another Controller may now consider the application of the appellant denovo.

7.This Court understands that in the eventuality of the appellant's invention being patented, it is likely to have shelf value of about only 15 months. Hence, this Court requires such Patent Controller who may now be in

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charge of the matter to dispose of the matter within a period of four (4) months from the date on which he or she takes cognizance of this matter.

There is no order as to costs.

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Index: yes / no
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N.SESHASAYEE, J.

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