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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 01.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT)/203/2023
(OA/SR.147/2018/PT/CHN)

W.R.GRACE & CO.-CONN.
Through its Constituted
Power of Attorney holder
Mr.Cyril Abrol
a Connecticut Corporation 7500 Grace Drive,
Columbia, Maryland 21044,
United States of America. ... Appellant

Vs.

The Controller of Patents
The Patent Office,
Boudhik Sampada Bhawan,
G.S.T.Road, Guindy,
Chennai – 600 032. ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) is filed under Section 117A of the Indian Patents Act, 1970, seeking the following prayer;

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i. to call for the records of the matter relating to the impugned order and issue an order setting aside the impugned order passed on September 05, 2018 with respect to the subject application 4670/CHENP/2011 and direct the Respondent to grant a patent on the subject application allowing the present appeal;

ii. such other appropriate further relief, order and/or direction which this court may deem fit and proper in the circumstances of the case and to meet the ends of justice be granted;

iii. for costs of the appeal

For Appellant : Mr.Debashish Banerjee
Mr.Vineet Rohila
Mr.D.Subbin
for M/s.Remfry and Sagar

For Respondent : Mr.C.Samivel,
Senior Panel Counsel (GSC)

JUDGMENT

Aggrieved by an order of the Controller of Patent rejecting the appellant's application for patenting its invention titled PROPYLENE IMPACT

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COPOLYMER AND METHOD, this appeal is preferred.

2.The learned counsel for the appellant explained that the invention has three components; a) a process of developing polymer using low volatile elements; b) the product or the outcome of such process; c) developing a catalyst to be used in the process. This was rejected by the respondent under Section 2(1)(ja), 3(d), 10(4) and 59 of the Patents Act.

3.The facts are;

- The petitioner applied for patenting its invention. The invention may be briefly explained as under;

  "5.In an embodiment, the process includes forming a propylene impact copolymer having a volatiles content less than about 30 mg/g as measured in accordance with VW standard PV3341.
  6.The present disclosure provides a composition. In an embodiment, a propylene impact copolymer is provided and includes a propylene-based polymer, and a propylene/ethylene copolymer dispersed within the propylene -based polymer. The propylene

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impact copolymer also includes a substituted phenylene aromatic diester.

7.The present disclosure provides an article. In an embodiment, an article is provided and includes the foregoing propylene impact copolymer."

- In its application, the appellant had made 10 claims, of which 3 are independent and the rest are dependent.
- The application eventually evoked FER from the Controller in which he cited on D1 to D3 as prior arts and resisted the patentiability of the appellant's invention under Section 2(1)(ja), 3(d) and 10(4) of the Act.
- The appellant responded to the same, made certain amendments and increased the number of claims from 10 to 16, retained the three original independent claims, leaving the rest as dependent claims.
- This was followed by a hearing notice in which the Controller did not site any priors. However, it cited Section 2(1)(ja), 3(d), 10(4) and also added Section 59 to resist the appellant's application for grant of patent. The petitioner participated in the hearing and filed

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his written statements.

4.In the end, the respondent came out with its impugned order dated 05.09.2018 rejecting the petitioner's claim under the aforesaid provisions indicated in the hearing notice.

5.Heard both sides. The learned counsel for the appellant made the following submissions;

- When once the Controller took objection that the first claim (which relates to the catalyst/compound) lacked clarity under Section 10(4), the appellant did make amendments to the said claim. In particular, the objection was to the phrase '*substituted phenylene aromatic diester'*, and the appellant had brought in clarity to it as *(i) a magnesium moiety; (ii) a titanium moiety, (iii) an aluminum-containing cocatalyst etc*..By so doing, the appellant had narrowed down its broad based specification in claim 1 to a particular *moiety*. The Controller would now insist that it required further filtering. In

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this context, he has not adverted to the statements of the appellant made in the written submissions.

- When once the Controller had given up on the three prior arts in D1 to D3 which he had cited, it is too obvious that the invention cannot be considered as lacking any inventive step. But, the Controller did enter a finding that the appellants invention lacked inventive step.
- Thirdly, the Controller had merely made a statement that the amendment sought while responding to the FER goes beyond the original specification but, it does not go to explain how this claim goes beyond the original specification, inspite of his decision to allow the amendment. What is of significance is that the Controller has confined his investigation to the sustainability of the amendment but, did not venture to consider the same alongside the response to the FER and the written submissions. Indeed, nowhere in his order the Controller whispers about the written submissions made by the appellant.

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6.This Court carefully evaluated the submissions of the learned counsel for the appellant and also perused the records. At least two facts are noticeable instantly;

a) When the Controller, even as he had raised objections under Section 2(1)(ja) and 10(4) in his FER and in his hearing notice, has not chosen to consider the written submissions. Indeed, the hearing notice itself appears to be a pre-decision on amendments sought by the appellant to its original claims, when it would have been advisable for the Controller of Patents to hear the appellant on the same.

b) In the impugned order, in the last but one paragraph, the patent Controller has expressed his view that he did not consider that discussing other issues as it would go beyond the scope of what he has discussed on the scope of the amendment is meaningless, and this if read alongside the earlier aspect *vis-a-vis* the failure of the Controller to consider the written submissions of the appellant, is

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unfortunate.

7.Left with little choice, this Court allows this appeal and remands it back to the Controller of Patents for a *de novo* consideration of the appellant's application. To save embarrassment to the Controller of Patents who passed the impugned order, another Controller of Patents is directed to pass orders on the application of the appellant. The appellant is at liberty to amend its claim. The Controller of Patents who is now in charge is required to expedite the process and to pass an order within a period of six (6) months from the date of receipt of a copy of this order.

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Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No

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