WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 23.01.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT)/110/2023
(OA/17/2018/PT/CHN)

Mimozax Co., Ltd.
4291-1, Miyauchi, Hatsukaichi-shi,
Hiroshima 738-0034
Japan
Through its Authorized Representative
Mr.Takeshi Kataoka ... Appellant

Vs.

Assistant Controller of Patents and Design,
Patent Office Chennai,
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;

a) Allow the present Appeal;

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

WEB COPY

b) Pass an order setting aside the impugned order of the Respondent dated 23rd October, 2017;

c) Pass an order granting a patent on Indian Patent Application No.1399/CHENP/2009 and issue consequential directions to effectuate such grant;

d) Pass any other order which the Court may deem fit in the interest of justice.

For Appellant : Ms.Vindhya S.Mani
for M/s.Lakshmikumaran and Sridharan

For Respondent : Mr.P.R.Ramesh Babu,
Special Panel Counsel

JUDGMENT

The Appellant herein was unsuccessful in obtaining patent to what it claims as its invention that relates to an anti-obesity composition derived from a tree belonging to the genus Acacia, and to uses as a food, an animal feed material, a medicine and a quasi-drug containing this anti-obesity composition.

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

WEB COPY

2.The application was rejected and grant of patent was refused by the impugned order of the respondent dated 23.10.2017 under Section 2(1)j(a), Section 3(c) and Section 3(p) of the Indian Patents Act, 1970.

3.Introducing her case, the learned counsel for the appellant submitted that after the first examination report, the respondent raised certain objections based on two priors, that two relates to certain traditional knowledge relating to the properties of acacia and other compositions and circulated the same to the appellant. The appellant too had submitted its response to the same. During hearing of the matter, the controller relied on four other priors but, did not circulate the same to the appellant and ultimately, the controller also relied on the 4 priors referred to above, for rejecting the claim of the appellant.

4.The learned Special Panel Counsel appearing for the respondent made a submission both on merits as well as on certain embarrassment that he faces,

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

WEB COPY

as his appointment as the special panel counsel was not extended as on date.

5.The petitioner has filed her application in 2006 and in the eventuality of the respondent patenting its invention, it will have a shelf value of less then 3 years and this Court cannot wait to hear certain lapses on the part of the respondent from extending the term of the counsel. Today, the learned counsel for the respondent did assist the Court with his submissions, which is important to this Court.

6.The learned counsel for the respondent justified the impugned proceedings on the ground that if every traditional knowledge is fully circulated it will hijack the traditional knowledge which this country possesses and it will go into the wrong hands.

7.The apprehension expressed by the counsel apart, what is significant to this Court is whether the Controller of Patents was fair and just. The doctrine of fairness is indispensable in any situation where a civil right of a

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

WEB COPY

litigant is involved, and in this case it is the right of the appellant to have its invention patented. That cannot be rejected by utilizing materials behind the back of the applicant. Necessarily, the applicant is entitled to a fair dealing in our judicial process.

8.In view of the same, this Court is constrained to set aside the impugned proceedings of the respondent dated 23.10.2017 and remands the matter back to the respondent for a *de novo* appreciation of the application of the appellant herein. As indicated earlier since the application was filed about 17 years from today, this Court requires and expects a certain decree of urgency on the part of the respondent to respond to the claim and cry of the appellant to have its invention patented.

9.To save embarrassment to the Controller of Patents who had already taken a view, this Court now required that another Controller of Patents decides the issue and for the reasons states, the Controller now hearing the matter may not take no more than four (4) months, from the date on which he takes

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

WEB COPY

charge of the issue, to decide the matter.

10.The Transfer Civil Miscellaneous Appeal (Patents) is accordingly disposed of. No costs.

23.01.2024

Tsg

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

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

WEB COPY

N.SESHASAYEE, J.

Tsg

(T)CMA(PT)/110/2023
(OA/17/2018/PT/CHN)

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

WEB COPY

23.01.2024

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