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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 08.02.2024

CORAM : JUSTICE N.SESHASAYEE

(T)CMA(PT)/178/2023
(OA/SR.164/2020/PT/CHN)

1.TVS Motor Company Limited
Jayalakshmi Estate, 24(Old No.8)
Haddows Road
Chennai - 600 006.

2.Indian Institute of Science
Bangalore - 560 012.
Karnataka. ..... Appellants

Vs

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

Prayer : Transferred Civil Miscellaneous Appeal filed (i) to set aside the impugned order of the respondent dated 03.10.2019 in 594/CHE/2011; (ii) to hold that the claimed invention in the present case is patentable subject matter, and involves inventive step; and (ii) to direct the Controller to grant the patent.

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For Appellants : Ms.Vindhya S.Mani

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

JUDGMENT

Aggrieved by the rejection of their application for grant of patent to their invention of two-stroke combustion engine on the ground of lack of inventive step, the applicants before the Patent office has preferred this appeal.

2. The case of the appellants is as follows :

(a) The title of appellants' invention reads 'Two-stroke internal combustion engine'. This is briefly described in the specification filed by the applicants, and it is as below:

> *"To achieve the intake of charge during the intake stroke and to expel the combustion product during the exhaust stroke, the conventional two-stroke engines are usually provided with ports in a cylinder wall. Due to layout of the port in the cylinder wall and the simultaneous intake and exhaust strokes, a mixing of the charge and the combustion products occurs in the cylinder bore. Further, because of the overlapping intake and exhaust strokes, some amount of the charge may leak out from the cylinder bore*

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during the exhaust stroke. The subject matter described herein relates to a two-stroke internal combustion (IC) engine. The two-stroke IC engine includes a cylinder head and a cylinder block on which the cylinder head is mounted. The cylinder head include a auxiliary combustion chamber."

(b) This arrangement according to the appellants will block the leakage charge from the engine.

(c) In its application, the appellants had made 30 claims.

(d) The appellants applied for examination, pursuant to which, the Controller made available his FER, wherein he cited four prior arts as D1 to D4.

(e) The appellants had offered their explanations and also amended their claims, and brought it down to 1 to 26 claims. This was followed by a hearing notice issued by the respondent, wherein the Controller retained prior arts D1 to D3, dropped D4, but introduced a new D4.

(f) The appellants participated in the hearing, made their written submissions, and further amended their claims, and brought down the total number of claims from 26 to 24. This was followed by a second hearing notice, in which the Controller introduced a new set of three prior arts [D1 to D3].

(g) The appellants have filed their written submissions and made further

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amendment to its claims, and it related to Claim No.1, which is its only independent claim.

(h) Ultimately, it resulted in the Controller passing the impugned order dated 03.10.2019. In its order, the Controller had relied on prior arts D1 to D3 of the second hearing notice, and relied on D4 of the first hearing notice.

(i) The grievance of the appellants is that inasmuch as the Controller had dropped D4 of the first hearing notice in his second hearing notice, he did not have an occasion to offer his further explanation vis-a-vis D4.

3. Heard both sides. The learned counsel for the appellants submitted that when the Controller dropped his newly added prior art in his second hearing notice, the appellants bonafide believed that the Controller was satisfied with the written submissions offered to him. However, he brought a surprise upon the appellants when he opted to rely on D4 of the first hearing notice in his order.

4. This Court likes to make an opening remark that the oscillating pattern or approach which the Patent Controller had opted to adopt is baffling. He

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literally seen swinging between his hearing notice and the FER. Unless a new prior art emerges between the date of FER and the hearing notice, it should be incumbent on the part of the Controller to cite all the prior arts in one go. This will not only be convenient to an inventor to answer all the queries, but it is also likely to shorten the entire procedure and process from the date of the application to order. Secondly, when all the prior arts are cited in the FER, an applicant for patent has a longer time to respond to the same, whereas when new prior arts are cited in the hearing notice, they will relatively have a shorter response time. After all, a scientific invention requires a certain amount of support from the experts and collection of data, processing them to build a case against a prior art. In the present case, the very method adopted by the Controller in citing his prior arts in installments itself is prejudicial to any applicant. Needless to say, in the instant case, it is prejudicial to the present applicants / appellants as well.

5. Turning to the merit of the allegations made, this Court considers that the appellants herein have a point to feel aggrieved about. Having dropped the newly added fourth prior art and chooses to rely on the D4 of his first hearing notice in the second hearing notice itself gives an impression that he was

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satisfied with the explanation offered for this prior art. In including it again, the impugned order breaches the rule of fairness to which the appellants are entitled to. The Patent Controller is required to take a principled decision and cannot shift the goal post at his will. In the instant case, the Controller helped himself with considerable free space to roam about, but the frame he helped himself with apparently has interfered with the appellants' right to have their invention patented.

6.In conclusion, this Court deems it appropriate to set aside the impugned order of the Controller dated 03.10.2019, and remands the matter back to the Controller. To save embarrassment to the Controller who passed the earlier order dated 03.10.2019, this Court requires that it be placed for denovo consideration by any other Controller. Since the application was made as early as in 2011, this Court requires the Patent Controller who may now take charge of the appellants' application pursuant to this order, to expedite his process of disposal, but strictly in accordance with the procedure contemplated and without breaching the fairness to which the appellants are entitled to in law, at any rate not later than six months from the date of receipt of a copy of this order.

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7. In the result, this appeal stands allowed. No costs.

08.02.2024

Index : Yes / No
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To:
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N.SESHASAYEE.J.,

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