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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 01.03.2024

CORAM :JUSTICE N.SESHASAYEE

CMA(PT) No.38 of 2023
and CMP.No.25528 of 2023

SICPA HOLDING SA,
Rep by its Authorised Representative
Mr.Kapil Kumar Mahipal
Avenue de Florissant 41,
1008, Prilly, Switzerland. ... Appellant

Vs.

The Controller of Patents
The Patent Office
Intellectual Property Building
GST Road, Guindy
Chennai - 600 032. ... Respondent

PRAYER: Civil Miscellaneous Appeal (Patent) filed under Section 117A of the Patents Act, as amended by the Tribunal Reforms Act, 2021, praying to set aside the order dated 25.08.2021 of the Ld. Controller of Patents, Chennai passed in Patent Application No.1524/CHENP/2013, allow the appeal and pass such further or other orders as this Court deem fit and proper in the circumstances of the case.

For Appellant : Mr.Ramesh Ganapathy

For Respondent : Mrs.R.Durga Rani
Central Government Standing Counsel

JUDGMENT

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The appellant having been aggrieved by the order of the respondent rejecting its application for grant of patent for its invention titled “Inline Spectroscopic Reader and Methods”, on the ground that it lacked inventive step within the meaning of Sec.2(1)(ja) of the Patent Act, has preferred this appeal.

2. The facts are :

(a) The appellant claims that its invention achieves a real time scanning of spectroscopically active marker or a tag in motion. All other inventions in the field which are functional hitherto leave a time lag for scanning, and another time lag for processing the data obtained during scanning. This is stated to have applications in the manufacturing unit of any products which are on a moving conveyor before they are packed and marketed. The broader idea behind it is stated to identify the bad apples from the good apples.

(b) In its application, the appellant had made 22 claims, of which two are independent claims and the rest are dependent claims.

(c) Eventually it evoked a FER from the Controller in which he has cited two prior arts, D1 and D2. The Controller has raised objections to the patentability of appellant’s invention on the

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ground of lack of inventive step within the meaning of Sec.2(1)(ja) of the Act.

(d) The appellant had responded to the FER and amended its claims and brought down the total number of claims from 22 to 17. Of the 17 claims, two are independent (one relating to the system and the other relating to method) and the rest are dependent claims.

(e) This is followed by a hearing notice, wherein the Controller had cited a fresh set of prior arts in D1 to D4 (not one of which were cited in the FER).

(f) The appellant had participated in the hearing, and submitted its written submissions. In its written submissions, the appellant has explained how its invention is different from any one of the prior arts in D1 to D4, which the Controller has cited in his hearing notice.

(g) The Controller however, stuck to his objections raised in the hearing notice and rejected the appellant's application for lack of inventive step, and declined to patent the same.

3. Heard both sides. The Controller also had appeared in the virtual mode.

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The respondent has filed its counter.

4. The learned counsel for the appellant submitted :

a) In his order, the Controller has copy pasted the objections he has raised in D1 to D4, and did not choose to give his opinion on the explanations offered by the appellant in his written submissions on any one of these prior arts.

b) That the appellant had already patented its invention in the U.S., Japan, Mexico and Australia. While grant of patent in other jurisdictions may not bind the Patent Office in this country, yet inasmuch as India is a signatory to Patent Co-operation Treaty, it would have been appropriate that the Controller had taken the grant of patent in other jurisdictions seriously.

5. This Court perused the order of the Patent Controller and finds that he has not appeared to have examined the explanations offered by the appellant to the prior arts D1 to D4 cited in the hearing notice, and in his written submissions. When the submissions including the written submissions of the applicant/appellant during hearing is not shown to have been considered in the order, it only leaves this court to conclude that the Controller has not applied his mind to

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the issue. It may be that the Controller may be justified in arriving at the conclusion which he had arrived, but what is significant is that the rule of fairness requires that the order must also indicate the explanations offered by the applicant/appellant to the objections raised by the Controller, are also fairly considered and discussed in the order.

6. Left with no option, this Court allows this appeal, sets aside the order of the respondent and remands the matter back to the Controller of Patents for a *de novo* consideration of the appellant's application. To save embarrassment to the Patent Controller who have decided the issue, this Court directs the appellant's application be considered by some other Controller. The Patent Controller now incharge of the appellant's application is required to expedite the same and dispose of the same as expeditiously as possible. No costs. Consequently, connected miscellaneous petition is closed.

01.03.2024

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Index : Yes / No
Speaking order/ Non-speaking order

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To:

The Controller of Patents
The Patent Office
Intellectual Property Building
GST Road, Guindy
Chennai - 600 032.

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N.SESHASAYEE, J.

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CMA(PT) No.38 of 2023

01.03.2024

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