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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **01.12.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT)/22/2023

Panasonic Intellectual Property Management Co. Ltd.,
1-61, Shiromi 2-chome, Chuo-ku,
Osaka-shi, Osaka 540-6207, Japan,
Rep.cby its Authorized Representative,
Mr.Raghavan Ravindran Nair,
De Penning and De Penning,
Having office at No.120, Velachery Main Road,
Guindy, Chennai 600 032. ... Appellant

-vs-

Deputy Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building, GST Road,
Guindy, Chennai - 600 032. ... Respondent

PRAYER: Civil Miscellaneous Appeal (Patents) is filed under Section 117-A of the Indian Patents Act, 1970, praying to call for the records of the Respondent culminating in the Impugned order dated 12th January 2022 rejecting the Grant of Patent and Set Aside the same and consequently direct Grant of the Patent in respect of the

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For Appellant : Mr.Sivathanu Mohan
for M/s.S.Ramasubramaniam and Associates
For Respondent : Mr.J.Madanagopal Rao, SPC

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JUDGMENT

The appellant assails an order dated 12.01.2022 by which Patent Application No.201647039396 for the grant of patent to the claimed invention entitled "Washing Machine" was refused. The appellant filed the above-mentioned application on 18.11.2016. Upon a request for examination from the appellant, the First Examination Report (FER) was issued by the respondent on 08.07.2019. In the FER, by citing prior arts, the Controller raised objections *inter alia* on the ground of lack of inventive step. The appellant responded to the FER on 23.12.2019. Pursuant to a hearing on 13.08.2021, the appellant filed written submissions explaining how the cited prior arts do not lead to the claimed invention. Eventually, by impugned

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order dated 12.01.2022, the application was rejected. The present appeal arises in the above facts and circumstances.

2. Learned counsel for the appellant invited my attention to the impugned order and, in particular, the operative portion thereof. After pointing out that the impugned order merely extracts from prior art documents D1 to D3, he contended that the impugned order contains no reasons at all. He also submitted that a patent was granted in respect of the claimed invention by the Japanese Patent Office and the Chinese Patent Office and that prior art document D3 was considered by the above mentioned patent offices. As regards prior art documents D1 and D2, he submitted that they are non-analogous prior arts.

3. In response to these submissions, Mr.J.Madanagopal Rao, learned SPC, submitted that the application was rejected because the

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prior art documents referred to therein would lead a person skilled in the art to the claimed invention. He also relies upon the counter filed to the appeal. Without making any concession on the merits of the matter, he submits that the matter may be remanded for re-consideration on account of the allegation that the impugned order does not contain detailed reasons.

4. The operative portion of the order consists of extracts from prior art documents, D1, D2 and D3. Thereafter, the following conclusions are recorded:

> "*After considering the arguments along with theteachings of the citations, This office has formed an opinion that A person skilled in the art would able to combine the teachings of the cited documents to arrive at the invention as claimed in the instant application and there fore present application lacks inventive step in accordance with Section 2(1)(ja) of the Patents Act.*
>
> *Having considered all the documents before me including amended claims, applicants*

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arguments along with the written submission, further the teachings disclosed in the cited documents D1 to D3 and my own analysis, I have formed an opinion that Present application as claimed in the amended claims lacks Inventive step in accordance with Section 2(1)(ja) of the Patents Act and decided to Refuse this Application U/S 15 of the Patents Act."

5. It is evident from the above conclusions that no attempt was made by the Deputy Controller to engage with the responses of the appellant to the FER or to the oral and written submissions made pursuant to the hearing notice. Since the order merely records conclusions with no reasons in support thereof, the order is unsustainable and is, hereby, set aside.

6. Consequently, the matter is remanded for re-consideration on the following terms:

(i) In order to preclude the possibility of pre-determination, an officer other than the officer who issued the impugned order shall

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undertake such re-consideration.

(ii) After providing a reasonable opportunity to the appellant, a reasoned decision shall be issued within a period of ***four months*** from the date of receipt of a copy of this order.

(iii) It is made clear that no opinion is being expressed herein on the merits of the application.

7. Therefore, CMA(PT)/22/2023 is disposed of on the above terms without any order as to costs.

01.12.2023

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

SENTHILKUMAR RAMAMOORTHY,J

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