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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 08.03.2024

CORAM :JUSTICE N.SESHASAYEE

(T)CMA(PT)/113/2023
(OA/25/2018/PT/CHN)

A.L.M.HOLDING COMPANY
920, 10th Avenue North, Onalaska
Wisconsin 54650, USA
Nationality : An American Company ... Appellant

Vs

Assistant 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 (Patent) filed under Section 117-A of the Patents Act, 1970, that the order dated 06 June 2018 issued by the respondent may be set aside and the application No.734/CHENP/2011 for patent be allowed to proceed to grant.

For Appellant : Ms.Karuna Goleria
for M/s.DE PENNING AND DE PENNING

For Respondent : Mr.P.R.Ramesh Babu
Senior Panel Counsel

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JUDGMENT

The applicant, having lost its application for patenting its invention titled '*Process For Cold-in-place Recycling Using Foamed Asphalt and Lubrication Additive'* under Sec.2(1)(ja) as lacking inventive step vide the Order of the Patent Controller, dated 06.06.2018, is the appellant herein.

2. The facts are :

(a) The appellant explains its invention as below :

- *Cold-in-place Recycling (CIR) is a method of removing and reusing the existing asphalt surface (upper surface of the road). In involves grinding off the top 2 to 5 inches of the existing asphalt surface and mixing the crushed asphalt with an asphalt recycling agent, and placing it back down with a paver.*
- *Cold-in-place recycling is used to restore and reuse the existing material reducing the amount of outside material required to be hauled to the site. This efficiently improves the road surface and strength while minimizing the expenses typically incurred during the paving process.*

(b) In its application, the appellant had made 20 claims, of which, three are

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its independent claims.

(c) The application eventually brought into existence the FER, wherein the respondent had taken an objection to the patentability of the applicant's/appellant's invention under Sec.2(1)(j) on the basis of 7 prior arts, D1 to D7, and also under Sec.3(d) of the Act.

(d) The appellant responded to the same and amended its claims, and brought them down from 20 to 12, of which two are its independent claims.

(e) This was followed by a hearing notice from the respondent, wherein he had given up his reliance on D1 to D7, but cited another four prior arts in D8 to D11, and stuck to its earlier objection under Sec.2(1)(j) and Sec.3(d). Besides, he also added an objection under Sec.10(5).

(f) The appellant participated in the hearing and came out with its written submissions.

Ultimately, the Controller came out with his impugned order, by which he rejected the appellant's application for patenting its invention only under

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Sec.2(1)(j) of the Act, as according to him, the appellant's invention lacked inventiveness. To back his conclusion, the Controller relied on the prior arts in D8 to D10. This is now under challenge in this appeal.

3. Heard both sides. The learned counsel for the appellant made the following submissions :

(a) The appellant's invention relates to recycling method in re-layering roads. She explained that the process involves fourt steps. Stage-I involves removing the existing asphalt material from the previously laid road; Stage-II involves preparing a binder mixture; Stage-III involves adding this mixture to the removed asphalt material. Stage-IV involves using such mixture as prepared in Stage-III, and paving the same back on the road. In all these four stages, no heat is used in stage-I, stage-III or in the stage-IV. Only for preparing the mixture with the components described in stage-II, heat is used.

(b) In both the prior arts D8 and D10 (of which the latter was wrongly indicated as D11 in the order), heat is used at all three major stages, and neither of them has any relevance to the invention of the appellant. In D8, titled 'Bituminous Paving Composition and

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Process for Bituminous Paving', the process involved is heat recycling, where heat is used for removal of the asphalt from the existing road, and again heat is used for relaying the road, whereas in the appellant's invention, no heat is involved in these two stages. Indeed, D8 relates to the process for preparing a bituminous paving, by which a foamable solution comprising a lubricating substance is injected into a heated asphalt binder to provide a heated, foamed mixture, and then to make it a suitable heated aggregate. And then further mix the heated foamed mixture and heated aggregate to coat the heated aggregate with the heated, foamed, asphalt binder to form a heated paving composition. The appellant's invention further does not involve any heat except in preparing the liquid asphalt binder.

(c) Turning to D10, it is essentially a machine, which is used for re-layering the asphalt. The invention in D10 is titled 'Mobile mixer to be used in train for cold recycling asphalt concrete roadways', whereas the appellant's invention essentially relates to cold recycling method. And the Controller had relied on a machine for denying the patent to the appellant's invention, which in fact is a

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mixture.

(d) The objections raised in the hearing notice were adequately addressed and explained in the written submissions. Indeed, in his order, the Controller combines D8 and D10 (which is wrongly given as D11), and has used the same against the appellant.

(e) The appellant's application has been patented in other jurisdictions such as Europe, USA, Canada, China, Mexico, Eurasia, Brazil.

4.1 This Court carefully weighed the appellant's submissions and perused the records. Here is a scenario where the appellant claims that its invention does not involve heat, whereas D8 essentially requires heat at all stages, and as earlier stated D10 is only a machine, whereas the invention in the instant case, is a mixture which is used for paving the roads.

4.2 The learned counsel in the course of her arguments has taken this Court extensively through the written submissions. This Court would have appreciated if only the Controller cared to consider the written submissions of the appellant and tired to address the fundamental difference between the process which requires heat, and the invention in the present case which

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does not involve heat, as claimed by the appellant. It is much easier to make a statement that an invention lacks inventiveness on the ground that it may not bring surprises to a person skilled in the art, and it is entirely another thing to justify the said statement. Often this Court finds that most Controllers choose to copy-paste the claims, the FER, the hearing notice and the written submissions of the applicant in the orders, and when the Order goes to the discussions of the Controllers where this Court looks for his/her reasoning for rejecting the application for patent, there will be hardly anything to justify the decision. This order is no different.

5. In conclusion, this Court is constrained to allow this appeal, sets aside the impugned order of the Patent Controller dated 06.06.2018, remands the matter back for a *de novo* consideration. To save embarrassment to the Controller who has passed the impugned proceedings, this Court directs that appellant's application now be considered by some other Controller. In the eventuality of the appellant's invention getting patented, it will have a shelf value of barely about four years, and hence the Patent Controller, who will now be in incharge of disposing of the appellant's application, is required to dispose of the appellant's application within a period of six months from the

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date on which he/she takes charge of the issue. No costs.

08.03.2024

Index : Yes / No
Speaking order/ Non-speaking order
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To:
The Deputy Controller of Patents & Design
Patent Office Intellectual Property Building
GST Road, Guindy
Chennai - 600 032

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N.SESHASAYEE, J.

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