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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 11.07.2024	Pronounced on : 19.07.2024

CORAM:

THE HON`BLE MR.JUSTICE P.B.BALAJI

CMA (PT) No.85 of 2023

Mitsubishi Electric Corporation
7-3, Marunouchi 2-chome
Chiyoda-ku
Tokyo 100-8310
Japan. .. Appellant

..Vs.

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

Prayer: This Civil Miscellaneous Appeal filed under Section 117-A of the Patents Act, 1970, praying that the impugned order dated 21.08.2020 passed by the respondent to be set aside and the subject application to be granted considering the written submission as required under Rule 28(7) of the Patent Rules, 2003, and the claims filed on 09.04.2019.

For Appellant : Mr.S.Shivathanu Mohan for
M/s.De Penning & De Penning

For Respondent : Mr.S.Janarthanam
Senior Panel Central
Government Standing Counsel

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J U D G M E N T

The appellant has preferred the present appeal against the refusal of the appellant's patent application in Application No.6745/CHENP/2015, by order dated 21.08.2020.

2.The respondent has rejected the patent application of the appellant citing lack of inventory step and unity of invention.

3.I have heard Mr.S.Shivadhanu Mohan for M/s.De Penning and De Penning for the appellant and Mr.S.Janarthanam, learned Senior Panel Central Government Standing Counsel for the respondent. I have also gone through the records.

4.Mr.S.Shivadhanu Mohan, learned counsel for the appellant would take me through the impugned order and state that the Controller, after discussing the prior arts while dealing with inventory step, without assigning any reasons, has jumped to the conclusion that the persons skilled in the art can choose the features of the prior art and come to the

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technical features of the present application and hence, it is an obvious selection. Unfortunately and as rightly contended by the learned counsel for the appellant, the Controller has not assigned any reasons whatsoever for such a conclusion. There is also no discussion as to how the present invention was obvious to a person skilled in the art. Excepting for extracting claim-1, there is absolutely no discussion in order to arrive at the finding.

5.With regard to “Unity of Invention”, the Controller has affirmed that the claim was not relating to single invention or to a group of inventions linked so as to form a single inventive concept. In short, the respondent has held that the invention was not clear and succinct and therefore, was hit by Section 10(5) of the Patents Act. In this regard, the learned counsel for the appellant would take me through the complete specifications and explain the claim made. He would also take me through the various components of the stacking type header, heat exchanger and Air Conditioning components and would also refer to the figures provided to fortify his submissions that all these combined into a single unit and therefore, it was not hit by Section 10(5) of the Patents Act.

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6.Mr.S.Janarthanam, learned Senior Panel Central Government Standing Counsel for the respondent would submit that the respondent has considered all the objections of the appellant and clearly found that there was lack of inventive step and that the claimed invention was also hit by Section 10(5) of the Patents Act since the specifications did not disclose or relate to a single invention or a group of inventions linked to form a single inventive step. He would therefore pray for dismissal of the appeal.

7.I have carefully considered the rival submissions put forth by the learned counsel on either side.

8.The appellant is a globally leading manufacturer of Electrical and Electronics, especially Air Conditioners. According to the appellant, the claimed invention would solve a major challenge and also play a vital role in environmental issues since the invention increases efficiency by reducing the heat exchange loss of the refrigerant.

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9.With regard to the lack of inventive step, I am in agreement with the arguments advanced by the learned counsel for the appellant. Excepting for verbatim extracting in the claim I made by the appellant, there is absolutely no discussion or reasons assigned by the Controller as to why there is a lack of inventive step. Therefore, on this limited ground, the matter requires to be remitted to the respondent. However, dealing with second reason for refusal of the patent application, namely unity of invention, though the respondent has rightly tested the appellant's claims, especially made in the complete specifications, the Controller has not assigned valid reasons as to why the specification claims are hit by Section 10(5) of the Patents Act. There is no reasoning whatsoever as to why the claim lacks unity despite the explanation offered by the appellant. Therefore, even on this ground, the matter requires to be remitted to the respondent for fresh consideration.

10.In fine, the appeal is allowed and the matter is remitted to the respondent to decide the patent Application No.6745/CHENP/2015 afresh, in accordance with law, after affording an opportunity by way of a fresh hearing to the appellant. In order to avoid embarrassment to parties, a different Patent Controller shall be assigned for the scrutiny of

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the patent application and such exercise shall be completed within a period of four months from the date of receipt of copy of this judgement.

There shall be no order as to costs.

19.07.2024

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

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

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P.B.BALAJI,J.

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