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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 18.07.2024	Pronounced on : 26.07.2024

CORAM:

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

CMA (PT) No.14 of 2024

VICTAULIC COMPANY,
4901 Kesselersville Road,
Easton Pennsylvania 18040,
USA
Rep. by its Power of Attorney Mr.R.R.Nair .. 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 to set aside the impugned order dated 08.12.2023 rejecting the Grant of Patent and consequently direct Grant of the Patent in respect of the Appellant's Application No.2019648026248.

For Appellant : Mr.P.V.Balasubramanian
for M/s.BFS Legal

For Respondent : Mrs.A.Anuradha
Central Government Standing Counsel

https://www.mhc.tn.gov.in/judis

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J U D G M E N T

This appeal has been preferred challenging the rejection of the patent application of the appellant in Application No.201948026248 dated 08.12.2023.

2.I have heard Mr.P.V.Balasubramanian, learned Senior Counsel for M/s.BFS Legal, learned counsel for the petitioner and Mrs.A.Anuradha, learned Central Government Standing Counsel appearing for the respondent.

3.Mr.P.V.Balasubramanian, learned Senior Counsel would submit that the respondent/Controller has passed the impugned order against the dictum of the Hon'ble Division Bench of the Delhi High Court in ***Syngenta limited Vs. Controller of Patents and Designs*** reported in ***2023 SCC Online Del 6392***.

4.I have gone through the impugned order of rejection passed by the respondent/Controller.

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5.Despite the order of the Hon'ble Division Bench of the Delhi High Court being brought to the notice of the respondent/Controller, the Controller has chosen to disregard the same and proceeded to reject the patent application in respect of splitting of the original application.

6.The Judgment of the Delhi High Court has been followed by this Court also in ***CMA (PT) No.35 of 2023*** dated ***13.03.2024*** in the case of ***GENSQUARE LLC Vs. The Assistant Controller of Patents and Design, Patent Office, Chennai***, where this Court, taking note of the decision of the Hon'ble Division Bench of the Delhi High Court, held that the Patent Act only requires that the divisional application ought to flow from the specifications in the parent application, and it does not say that the claims made in the divisional application to flow from the claims made in the parent application. Hence, the issue is no longer *res judicata*. Unfortunately, the respondent has acted against the ratio laid down by the Hon'ble Division Bench of the Delhi High Court in ***Syngenta Limited's*** case and on this limited ground alone, the rejection order passed by the respondent deserves to be set aside.

7.In fine, the appeal is allowed and the matter is remitted to the

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respondent for *denovo* examination, 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 the patent application and such exercise shall be completed within a period of three months from the date of receipt of copy of this judgement. There shall be no order as to costs.

26.07.2024

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

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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CMA (PT) No.14 of 2024

26.07.2024

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