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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 08.02.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT)/180/2023
(OA/SR.11/2020/PT/CHN)

Techpolymers Industria E Comercio LTDA
Estrada Galvao Bueno
5505-Parte Bairro Batistini
Do Campo-Sp 09842-080 Brazil,
[Assigned by Rhodia Poliamida E Especialidades LTDA]
... Appellant

Vs.

The Deputy Controller of
Patents and Designs,
The Patent Office,
Intellectual Property Building,
Cp-2, Sector V, Salt Lake City,
Kolkata – 700 091, India. ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) is filed under Section 117-A of the Indian Patents Act, 1970, praying that;

1) The present appeal be allowed;
2) The impugned order of the Deputy Controller of Patents & Designs dated 23.10.2019 in 7994/CHENP/2012 be set aside;

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3) The Hon'ble Court may be pleased to hold that claimed invention in the present case is patentable subject matter, and involves inventive step;
4) The Hon'ble Court may be pleased to direct the Controller to grant the patent; and
5) The Hon'ble Court may pass any other orders in the interest of justice.

For Appellant : M/s.Vindhya S.Mani
for M/s.Lakshmikumaran and Shidharan

For Respondent : Mr.J.Madhanagopal Rao
Special Panel Counsel

JUDGMENT

Aggrieved by the rejection of the appellant's application seeking patent for its invention under Section 2(1)(ja) and 59(1) of the Patents Act, the applicant before the patent office has come forward with this appeal.

2.The appellant has sought patent for its invention which it describes as below;

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"The invention relates to the use of thermoplastic polymers for the preparation of injection-molded articles and to the molded articles thus obtained. The invention relates more particularly to the use, for the preparation of injected-molded articles, of a lubricated thermoplastic polymer, in particular a lubricated polyamide, obtained by addition of least one lubricant during the process for the polymerization of the polymer"

3.The applicant has made one independent claim and 17 dependent claims and in all, 18 claims. After examination, the respondent came up with its FER, in which it cited 4 priors D1 to D4. The appellant claims that it has filed its explanations, explaining how its invention is not hit by any of the cited priors. Alongside, the appellant also filed its amended claim, which in fact retained the total number of claims originally made. The amendment principally is to the first claim, which is the independent claim. This was followed by a hearing notice, in which, the Controller confined its objection to priors D2 to D4. Alongside, it also raised another objection under Section 59, contending that the appellant's amended claim goes beyond the

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original claim. The appellant again made further amendment to its claim, more significantly and in the context of the case, amendment to the sole independent claim. The Controller of Patents however stuck to his ground which it raised in its hearing notice and rejected the appellant's application for patenting its invention.

4.Heard both sides.

5.The learned counsel for the appellant made the following submissions;

a) So far as the rejection on the ground of lack of innovative step under Section 2(1)(ja) is concerned, the Controller has merely extracted the priors D2 to D4 which he has stated in his hearing notice and did not consider either the explanations offered by the appellant to the same in its response to the FER nor to the statement made during the final hearing of the matter;

b) So far as the ground of rejection founded on Section 59 of the Act is concerned, the Controller appears to have considered both the original claim and the independent claim on the same footing. In

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particular, he has focused more on English and the words used and has not focused on the specifications regarding the invention. Reliance was place on ***Allergan Inc Vs. The Controller of Patents*** [2023:DHC:000515, C.A.(COMM.IPD-PAT)22/2021].

6.So far as the first of the ground for rejection of the the appellant's application founded on lack of inventive step, within the meaning of Section 2(1)(ja) is concerned, the same does not trouble this Court, since all that the Court is required to ascertain is whether the respondent has considered the explanations offered by the appellant to the priors relied on by the Controller of Patents.

7.The Controller appears to have made short of his responsibility by merely extracting the priors he relied on but, had not thought it fit to consider the explanations. Necessarily, the ground for rejection founded on Section 2(1)(ja) has to fail and it deserves to be reconsidered. Turning to the other ground of rejection founded on Section 59 is concerned, the Controller appears to have focused more on the semantics of the language employed by

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the appellant in stating its claim. The original claim says with an expression "*the use of a lubricated polyamide for the preparation of articles by injection molding...*" and the amended claim reads "*A method of preparing an article, the method comprising injection molding the article using a lubricated polyamide....*".

8.The respondent has understood the original claim as involving only the use of lubricated polyamide and has understood the amended claim as a method in using the same substance. In his perspective, the word 'method' expands the scope of whatever the word 'use' conveys. When this Court carefully read both the original claim as well as the amended claim, all it finds is that the original claim uses the word 'use of lubricated polyamide' whereas, the amended claim conveys the idea that it relates to method of using the same substance.

9.This Court can appreciate that a Controller is essentially a man of science and not of language and therefore, this Court deems it appropriate to help the Controller to understand that beyond the choice of words which an

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applicant for patent may consider appropriate, it has to look into the substance of the claim. Section 59 is not intended to be used for wrong understanding of the language employed by an applicant, since an applicant will also be a person of science and long of language. Looking into the substance, this Court could not find anything therein which may indicate that the amended claim goes beyond the original claim. In this context, the following passage from the Judgement of the Delhi High Court in ***Allergan Inc Vs. The Controller of Patents*** referred to above is relevant;

> *"41.Referring back to Section 59(1), what the Section proscribes is permitting of an amendment of the claim where the amended claim would not fall wholly within the scope of the pre-amended claim. Interestingly, even this last part of Section 59(1) uses two expressions. It states that "no amendment of a complete specification shall be allowed, the effect of which would be ... that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment." What the Section compares, therefore, is the amended claim with the scope of the pre-amended claim. Where the amended claim does not fall within the scope of the pre-amended claim, the amendment would not be allowed.*

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10.The conclusion is to state the obvious. This appeal deserves to be allowed and accordingly, it is allowed. The matter is now remanded back to the Controller of Patents for a *de novo* consideration of the amended claim(1 independent claim and 17 dependent claims that was made post hearing) of the appellant. To save embarrassment to the Controller who had earlier decided the matter, this Court directs that some other Controller of Patents consider the petitioner's claim.

11.Since the appellant's application is dated in 2012, this Court requires that such Controller of Patent, who might take cognizance of the application before it, to expedite the process of passing its final orders under the application and dispose of the same, at the very earliest, at any rate, not later than six months from the date on which he takes cognizance of the matter. No costs.

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