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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 19.03.2024

CORAM :JUSTICE N.SESHASAYEE

CMA(PT) No.4 of 2023

GENOMATICA INC.,
Via 4757 Nexus Center Drive
San Diego, CA 92121, USA
Nationality : USA
Represented by its Power of Attorney
Mr.Raghavan Ravindran Nair ... Appellant

Vs.

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, praying to call for the records of the respondent culminating in the impugned order dated 05.07.2021 rejecting the grant of patent and to set aside the same, and consequently direct grant of the patent in respect of the appellant's application No.201747013084, and to pass such further or other order as this Court deems fit and proper in the circumstances of the case.

For Appellant : Mr.Shivathanu Mohan

For Respondent : Mr.C.Kulandaivelu
Senior Panel Counsel

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JUDGMENT

Having lost its application for patenting its invention titled *'Non-Natural Microbial Organisms with improved Energetic Efficiency'* for lack of novelty under Sec.2(1)(j) of the Patent Act, and for lack of unity and conciseness and insufficiency of disclosure within the meaning of Secs.10(4), 10(5) and 59, besides an objection, the applicant is before this Court with this appeal.

2. The applicant had filed its PCT application in 2015, and filed its application in this country on 12.04.2017 for patenting its invention. The other materials facts are as below :

a) In its application, the appellant had made 72 claims, of which four were its independent claims. This application eventually evoked an FER, in which the Controller has raised objections under Secs.2(1)(j), 2(1)(ja), 3(b), 3(d), 10(4) and 10(5), and backed them with six prior arts D1 to D6.

b) The appellant had responded to it and amended its claims, and brought it down from 72 to 70, of which four are its independent claims.

c) This was followed by a hearing notice in which the Controller

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retained the same set of objections and also relied on the same set of prior arts.

d) The appellant participated in the hearing, and also filed its written submissions. Along with the written submissions, it brought about an amendment and reduced the number of claims from 70 to 68, of which only one was its independent claim.

e) The Controller would now state that the last amendments made to the claims exceeded the specifications and hence, the claims cannot be considered under Sec.59 of the Act, and then he chose to fall back on the earlier set of claims, and rejected it under Sec.10(4) and 10(5) of the Act.

This is now under challenge.

3. Heard both sides. The learned counsel for the appellant submitted that inasmuch as the objection under Sec.59 was not part of the hearing notice and since an occasion to invoke Sec.59 appeared to have arisen only after the final set of amendments were made by the appellant which it wanted to introduce along with its written submissions, in fitness of things, the Controller ought to have issued an another hearing notice citing Sec.59 as her core objection. This would have enabled the appellant to explain the said objection.

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Secondly, having taken a view under Sec.59, the Controller had fallen back on the old set of claims which even the appellant has given a go by. In effect, the Controller has chosen to apply her mind to a set of claims which are not before her for consideration.

4. The submissions of the counsel for the appellant make sense. After all, the Controller would not have had an opportunity to consider whether the last set of amended claims fall within the ambit of Sec.59 or not, or this would not have arisen when she issued a hearing notice. This is a new ground and in fitness of things, the Controller should have heard the appellant on her objection under Sec.59. Secondly, when once the appellant had amended the claims through its written submission, it implies that it had already communicated to the Controller that it is not falling back on its earlier claims. Therefore, if the Controller intends to fall back on the earlier claims, then again she should have heard the appellant on the same. Ideally, she should not have fallen back on the claims which the appellant had given up.

5. This Court intends to clarify for the benefit of the Patent Office what it now terms as "given up amendments", should not be construed by the Controller as if the appellant had abandoned its earlier claims. After all, when a set of

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claims undergoes amendments made to the existing claims, the amended claims get superimposed on the previous set of claims, and therefore, it is not permissible for the Controller to read something which is not before him/her.

6. The conclusion is to state the obvious: The appeal is allowed, the impugned order of the Patent Controller dated 05.07.2021 is set aside and the matter is remanded back for *de novo* consideration. To save embarrassment to the Controller who has passed the impugned proceedings, this Court directs that appellant's application be now considered by some other Controller. And the Controller now incharge of the appellant's invention is required to dispose of the appellant's application as expeditiously as possible. No costs.

19.03.2024

Index : Yes / No
Speaking order/ Non-speaking order
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N.SESHASAYEE, J.

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To:
The Controller of Patents & Design
Patent Office Intellectual Property Building
GST Road, Guindy
Chennai - 600 032

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