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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 28.06.2024	Pronounced on: 05.07.2024

CORAM:

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

(T) CMA (PT) No.187 of 2023

Cornell Research Foundation, INC,
Cornell Center for Technology,
Enterprise & Commercialization,
395 Pine Tree Road, Suite 310, Ithaca,
NY 14850,
USA; Nationality: USA

.. 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: This appeal came to be numbered by transfer of IPAB Case SR. No.54/2017/PT/CHN from the file of the Intellectual Property Appellate Board, Chennai praying this Court to call for records, the order dated 31.03.2017 and issued by the respondent on 03.04.2017 be set aside and the Application No.4167/CHENP/2010 for patent be allowed to proceed to grant.

For Appellant : Mrs.Karuna Guleria for
M/s.De Penning & De Penning

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For Respondent : Mrs.ME.Sarashwathy,
Senior Panel Counsel.

JUDGMENT

This Patent Appeal is preferred by the appellant who aggrieved by the rejection of the Patent Application.

2. I have heard Mrs.Karuna Guleria for M/s.De Penning & De Penning, learned counsel for the appellant and Mrs.ME.Sarashwathy, learned Senior Panel Counsel for the respondent.

3. The learned counsel for the appellant would submit that initially the appellant had made 42 claims and at the time of First Examination, it was reduced to 38 claims and further reduced to 31 claims at the hearing. Out of the said 31 claims, claims 1 to 25 were retained and the remaining claims were dependant claims.

4. According to the learned counsel for the appellant, the Controller has held that the Application is hit by Section 59 of the Indian Patents Act, 1970, being beyond scope. She would also submit that the Appellant had filed five affidavits of experts along with written submissions and the same

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were not taken on record and the Application was rejected based on the First Examination Report. She would further submit that the responses given by the appellant to the hearing notice were not even discussed.

5. Further she would also bring to my notice that the US Patent was granted to the appellant, considering the same, prior arts which were cited by the respondent. She would also submit that even the European Patent was granted to the appellant on some of the prior arts cited, though subsequent to the rejection order passed by the respondent. She would take me through the impugned order and referred to the relevant portions in support of her submissions. She would therefore seek limited prayer of remand since material particulars have not been considered.

6.Per contra, the learned counsel for the respondent would submit that the entire process has been dealt with in detail and satisfactory and sufficient grounds are available in the impugned order rejecting the above Patent Application of the Appellant and therefore, there is no necessity for even remission of the matter to the respondent.

7. I have considered the rival submissions advanced by the learned

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counsel on either side.

8. Without going into the merits of the Appeal grounds, I proceed to consider the arguments with regard to the request for remand. As rightly pointed out by the learned counsel for the appellant, though the appellant had given a detailed response to the hearing notice, the respondent/Controller has not discussed the same while passing the order. That apart, the affidavits of the experts, though referred to, have also not been objectively considered or tested before passing the final order. In fact, the appellant has also filed the US Patent granted to the appellant on the same prior arts which were cited before the respondent and I do not find any reference to the same as well.

9. Considering the above, I am remitting the matter to the respondent for fresh consideration of the Patent Application in accordance with law, after affording a fair opportunity to the appellant to advance contentions in respect of all 31 claims and the respondent/Patent Controller shall also take into account the fact that the US Patent as well as European Patent have been already granted to the appellant in respect of the same process, after having referred to the same prior arts too. The respondent shall also

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consider the affidavits of the experts which were filed along with the written submissions before the impugned order came to be passed.

10. In fine, the Appeal is allowed and the matter is remitted to the respondent for fresh consideration of the Patent Application of the appellant No.4167/CHENP/2010. The respondent shall assign the task of scrutinising the Patent Application of the appellant to a different Patent Controller to avoid embarrassment to the parties and the said exercise shall be completed within a period of three (3) months from the date of receipt of the copy of the order.

11. In fine, this Appeal is allowed with the above direction. No costs.

05.07.2024

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

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

P.B.BALAJI, J.

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