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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 15.07.2024	Pronounced on: 19.07.2024

CORAM:

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

CMA (PT) No.12 of 2024

DHAMA INNOVATIONS PRIVATE LIMITED,
503, Legend Apartments,
Street Number 7, Himayatnagar,
Hyderabad, Andhra Pradesh 500 029,
India.

.. Appellant

..Vs.

The Assistant Controller of Patents and Designs,
The Patent Office,
Intellectual Property Rights Building,
S.M.Road, Mumbai – 400 037, India.

.. Respondent

Prayer: This Civil Miscellaneous Appeal filed under Section 117-A (2) of the Patents Act, 1970 praying this Court to pass an order setting aside the impugned order dated 01.01.2024 passed by the respondent in respect to the Application No.628/CHE/2012 and allow the Patent Application No.628/CHE/2012.

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For Appellant : Mr.Adharsh Ramanujam for
Mr.Tarun khurana

For Respondents : Ms.S.P.Aarthi,
Central Government Standing Counsel

JUDGMENT

The Appeal has been preferred by the appellant, challenging the impugned order of rejection of the appellant's Patent Application No. 628/CHE/2012 dated 01.01.2024.

2. I have heard Mr. Adharsh Ramanujam, learned counsel for Mr. Tarun Khurana, learned counsel for the appellant and Ms.S.P.Aarthi, learned Central Government Standing Counsel for the respondent.

3. I have also gone through the records as well as written submissions filed by the learned counsel for the appellant and the authorities on which reliance is placed on by the learned Counsel for the appellant.

4. The appellant claims an invention for a device seeking to achieve

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high rates of heat dissipation without consuming much power. According to the appellant, the prior knowledge in the field were entirely relating to different inventions and the appellant's invention overcame the disadvantage of the earlier inventions, besides also coming with its own added advantages. The learned counsel for the appellant would take me through the invention itself and explained the benefits that accrued from.

5. He would also state that the impugned order has been passed without any discussion on the material aspects of the submissions made by the appellant before the respondent Controller. He would submit that the impugned order is not only unreasoned, but also in violation of principles of natural justice. He would also submit that the Controller has attempted to split the claimed invention into its basic and individual components and putting it against the same prior arts, which exercise is impermissible in law.

6. In this connection, he would place reliance on the decision of the Delhi High Court in the case of *Biomoneta Research Private Limited vs. Controller General of Patents Designs and another* reported in *(2023) SSC*

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Online, Delhi, 1482. As regards the combined prior arts D1 to D3, rendering the claimed invention obvious, the learned counsel for the appellant would submit that a mere mosaic of three prior arts without demonstrating any motivation or teaching that a person skilled in the art is again unsustainable. In this regard, he would rely on the decision of this Court in *Rhodia Operations v. Assistant Controller of Patents and Designs* reported in *2024, MHC 6024.*

7. The learned counsel for the appellant would further submit that the impugned order merely speculates on common general knowledge. It is trite law that when the Controller cites common general knowledge of a person skilled in the art against the appellant or the applicant for Patent, then it is fundamental that the source of such common knowledge is not only to be stated but also discussed by the respondent Controller.

8. Per contra, Ms.S.P.Arthi, learned Central Government Standing Counsel appearing for the respondent would submit that the impugned order is a well reasoned order and has discussed all the prior arts connected to the

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claimed invention and therefore, does not suffer from any infirmity or irregularity. She would pray for dismissal of the Appeal.

9. I have considered the rival submissions advanced by the learned counsel on either side, I find from the impugned order that the respondent despite stating that the written opinion and written amendment have been examined and has proceeded to hold that there is no basis available to overthrow the previous given reasons with respect to inventive step for refusal not being found in the claimed invention.

10. However, such a finding is without any discussion of the submissions made by the learned counsel for the appellant before the Controller. In fact, I find that written submissions have also been filed on 22.11.2022, prior to the impugned order being passed on 01.01.2024, where the appellant has addressed the presence of inventiveness and non-obviousness in the claimed invention. Similarly, even while dealing with the prior arts, the respondent Controller has erroneously split the claimed invention into individual components and thereafter, came to a finding that

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each of the components are found in the prior arts.

11. Such an approach is not permissible in law and as held by the Delhi High Court in *Biomoneto*'s case, (referred herein supra) when the claimed invention is said to be not a mere addition to a well-known combination but contains new features and is projected as an improvement in the method bringing about greater efficiency, such synergistic combination or procedure giving better, new and improved results, then the subject matter would be patentable.

12. The Delhi High Court also relying on the following decision in the case of *Albert Wood and Amcolite Limited. v. Gowshall Limited.*, reported in *(1936) 54 RPC 37,* the Court of Appeal held as under:

> *"The dissection of a combination into its constituent elements and the examination of each element in order to see whether its use was obvious or not is, in our view,* ***a method which ought to be applied with great caution since it tends to obscure the fact that the invention claimed is the combination.*** *Moreover, this method also tends to obscure the facts that the conception of the combination is what normally governs and precedes the selection of the elements of which it is composed and that the obviousness or otherwise of each act of selection must in general be examined in the light of this consideration. The real and ultimate question is: Is the combination obvious or not? In the*

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present case we think that the Patent satisfies this test"

13. Dissection of a combination into its constituent elements and examination of each element in order to see whether its use was obvious or not is impermissible as it tends to obscure the fact that the invention claimed is a combination. The ratio laid down by Delhi High Court would squarely apply to the findings rendered by the respondent Controller in this regard.

14. With regard to *'common general knowledge',* the learned counsel for the respondent relies on the decision of this Court in the case of *Microsoft Technology Limited Vs. The Assistant Controller of Patents and Designs* in *CMA (PT) No. 4 of 2024 dated 27.06.2024*, where I had an occasion to hold that the findings were not supported by material documents, the impugned order rejecting the Patent Application cannot be sustained.

15. In view of the above, I deem it fit and proper to remit the matter to the respondent for a *de novo* hearing of the Patent Application of the

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appellant, by a different Patent Controller. Such exercise shall be completed by the respondent within a period of four (4) months from the date of receipt of the copy of the judgment and the respondent/Controller shall dispose of the Application after affording an opportunity of hearing to the appellant.

16. In fine, this Civil Miscellaneous Appeal is allowed with the above directions. No costs.

19.07.2024

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

To
The Assistant Controller of Patents and Designs,
The Patent Office,
Intellectual Property Rights Building,
S.M.Road, Mumbai – 400 037, India.

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CMA (PT) No.12 of 2024

19.07.2024

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