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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **13.12.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(PT)/59/2023
(OA/7/2021/PT/CHN)

ARKEMA FRANCE,
A French Company,
of 420, rue d'Estienne d'Orves,
F-92700 Colombes, France,
Through its Authorised Representative. ... Appellant

-vs-

The Assistant Controller of Patents & Designs,
The Patent Office,
IPO Building,
G.S.T.Road, Guindy,
Chennai-600 032. ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) filed under Section 117-A of the Patents Act, 1970, praying to the Hon'ble Court to allow the present appeal; to set aside/quash the impugned decision dated 20.12.2019 passed by the respondent in Indian Patent Application No.2248/CHENP/2012; to allow the said application

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and direct grant of patent in respect thereof.

For Appellant : Mr.Abhishek Jan,
Mr.K.Muthu Selvam
for M/s.K and S Partners

For Respondent : Mr.M.Karthikeyan, SPC

JUDGMENT

The appellant impugns an order dated 20.12.2019 by which Patent Application No.2248/CHENP/2012 was rejected.

2. The appellant submitted the above mentioned application as the national phase application of the PCT application relating to an invention entitled "Heat Transfer Method". The First Examination Report (FER) in relation thereto was issued on 22.09.2017. The appellant responded to the FER on 20.03.2018. Eventually, pursuant to the hearing on 01.06.2018, the impugned order was issued. The present appeal arises in these facts and circumstances.

3. Learned counsel for the appellant submitted that the

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invention relates to a method of heat transfer or heat exchange and that the claimed invention pertains to and is particularly useful in heating, ventilation and air conditioning systems. Learned counsel next submitted that the respondent cited prior arts D1 to D4 in the FER. Therefore, the appellant's response was with reference to prior arts D1 to D4. Learned counsel pointed out that prior art document D5 was not referred to even in the hearing notice. For the first time, in course of hearing, the respondent referred to prior art document D5. Since prior art document D5 was referred to only in the hearing notice, learned counsel submits that the appellant could deal with the same only in the written submissions. According to learned counsel, the reliance on a new prior art document at the hearing stage is sufficient cause to interfere with the order.

4. The next submission of learned counsel was that prior art documents D1 to D4 were considered in the International Search Report but classified as 'A', i.e. documents which are not of particular

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relevance. He also pointed out that the claimed invention was granted a patent by the United States Patent Office and the European Patent Office. According to learned counsel, the only difference between the claims made before the United States Patent Office and the European Patent Office, on the one hand, and the claimed invention, on the other, is that the claims made in the above mentioned foreign jurisdictions were wider in scope and included use claims which had to be omitted in light of Indian law.

5. By referring to the complete specification at page 38 of the appeal paper book, learned counsel pointed out the technical advancement claimed in the invention is by way of zero ozone depletion potential, lower global warming potential, greater volumetric capacity and greater co-efficient of performance. As regards the objection under Section 10(4)(c) of the Patents Act, 1970 (the Patents Act), learned counsel submitted that the said objection is untenable and that the appellant had made sufficient disclosure for a

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person skilled in the art to work the invention. He also pointed out that the obligation imposed on a patent applicant is to disclose the best method and that the same was disclosed.

6. In response to the contentions of learned counsel for the appellant, learned counsel for the respondent submitted that the appellant had originally submitted eight claims. Out of these eight claims, the first six claims pertain to the use of the specified composition. These use claims were subsequently given up in the revised claims of the appellant. By referring to the revised claims, learned counsel submitted that all four revised claims are method claims. According to learned counsel for the respondent, the said method claims are not supported by disclosures made in the complete specification. By referring to pages 39 and 40 of the paper book (internal pages 5 and 6 of the complete specification), learned counsel submitted that the disclosure with regard to the method of heat transfer, which forms the subject of the pending current claims,

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is insufficient and would not be adequate for putting the invention to use after the term of patent, if granted.

7. On examining the FER, it is clear that only four prior art documents "D1 to D4" were disclosed or referred to therein. Likewise, on examining the hearing notice, the hearing notice also does not refer to prior art document D5. Against this backdrop, if the impugned order is examined, it is evident that the operative portion of the impugned order is entirely based on prior art document D5, which was not referred to until the hearing stage. The impugned order is liable to be interfered with on this ground even without examining other aspects of the impugned order.

8. Since learned counsel for the respondent contended that the complete specification does not contain adequate support for the current method claims of the appellant, the issue of alleged non disclosure is briefly dealt with. The record shows that the claims as

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originally filed included both use claims and method claims. This is obviously a function of the fact that this is the national phase application of a PCT application and, therefore, the appellant had to file the claims as originally formulated. Nonetheless, it needs to be examined as to whether there is sufficient disclosure with regard to the method of heat transfer. As pointed out by learned counsel for the respondent, the method of heat transfer is dealt with in lines 35 to 39 of internal page 5 of the complete specification and in lines 1 to 4 of internal page 6 thereof. In case the respondent is of the view that the disclosure is insufficient, it is always possible for the respondent to call upon the appellant to amend the complete specification *albeit* in consonance with Section 59 of the Patents Act to provide greater disclosure in such regard. Section 59 permits amendments in respect of matters in substance disclosed in the complete specification before the amendment.

9. For reasons set out above, the impugned order is set aside

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and the matter is remanded for reconsideration. Such reconsideration shall be undertaken on the following terms:

(1) In order to preclude the possibility of pre-determination, such reconsideration shall be undertaken by the officer other than the officer who issued the impugned order.

(2) If the respondent is of the opinion that the disclosure is inadequate, an opportunity shall be provided to the appellant to amend the complete specification to the extent permissible under Section 59 of the Patents Act.

(3) After providing a reasonable opportunity to the appellant, a reasoned decision shall be issued within a period of four months from the date of receipt of a copy of this order.

(4) It is made clear that no opinion is being expressed herein on the merits of the patent application.

10. Therefore, (T)CMA(PT)/59/2023 is disposed of on the

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above terms, without any order as to costs.

13.12.2023

Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No

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