2023:MHC:4862

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 30.10.2023

CORAM:

THE HON'BLE MR. **JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T) CMA(PT).No.73 of 2023

[OA/17/2021/PT/CHN]

DOW GLOBAL TECHNOLOGIES LLC
2040 Dow Center, Midland
Michigan 48674, USA. ... Appellant

Vs.

CONTROLLER OF PATENTS AND DESIGNS
Government of India,
Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai - 600 032. ... Respondent

PRAYER : This Transfer Civil Miscellaneous Appeal (Patents) filed under Section 117-A of the Patents Act, 1970 prays to set aside the impugned order dated 28.09.2020 issued by the respondent and grant the patent in respect of the appellant's Patent Application No.9283/CHENP/2014 in accordance with the provisions of the Act and the Rules.

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For Appellant : Mr.Sivathanu Mohan
for M/s. De Penning and De Penning

For Respondent : Mr.C.Samivel, SPC
Mr.Bommineni Ramamuni
(Controller of Patents and Designs)

JUDGMENT

The appellant assails an order dated 28.09.2020 by which Application No.9283/CHENP/2014 for the grant of patent to a claimed invention entitled "Ethylene-based polymers and processes for the same" was rejected.

2. The appellant submitted the above mentioned application on 08.03.2013 as the national phase application derived from the PCT application. As part of its complete specification, the appellant submitted fifteen claims. The First Examination Report (FER) was issued on 06.09.2019 after examining the application. The appellant filed its response on 05.03.2020 and submitted nine amended claims along with the response to the FER. Thereafter, hearing notice was issued and the appellant submitted five amended claims along with the written

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submissions on 22.09.2020. Eventually, by impugned order dated 28.09.2020, the application was rejected. The only ground on which the application was rejected was the lack of inventive step in terms of Section 2(1)(ja) of the Patents Act, 1970 (the Patents Act). The present appeal was filed in the above facts and circumstances.

3. Learned counsel for the appellant invited my attention to amended claim 1 and focused attention on two aspects: (a) the invention provides for an ethylene-based polymer formed from the reaction of ethylene and at least one asymmetrical polyene; and (b) the ethylene-based polymer comprises, in reacted form, less than, or equal to, 10 moles of asymmetrical polyene per 1000 moles of ethylene-based polymer back bone carbons, based on the weight of the polymer. He also adverted to the structure of the said polymer.

4. By referring to prior art document D4, which is referred to in the impugned order, learned counsel pointed out that the said prior art deals with novel ethylene copolymers and that the patent was granted by the US based Patent Office on 24.11.1970 in respect thereof. Likewise, by

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referring to prior art document D5, which is in respect of ethylene/acrylate ester co-polymer, he submitted that the patent was granted by the US Office on 31.10.1967. By pointing out that the priority date in respect of the present application was 27.06.2012, learned counsel submitted that despite the passage of more than 40 years, the claimed invention was not arrived at on the basis of either D4 or D5. According to learned counsel, this is indicative of the fact that the claimed invention is not obvious to a person skilled in prior art documents, D4 and D5.

5. The next contention of learned counsel was that neither D4 nor D5 teach, suggest, or motivate a person skilled in the prior art to arrive at the claimed invention, especially with regard to the features or characteristics adverted to above. In fact, learned counsel pointed out that the US Patent Office considered all the prior arts cited herein, including prior art documents D4 and D5. By referring to the relevant US Patent No.10, 442, 878 B2, he pointed out that the prior art document D4 is referred to therein as 3, 542, 749A and prior art document D5 is referred to as 3, 350, 372A. Since the cited prior arts were considered and

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construed as not rendering the claimed invention obvious to a person skilled in the prior art by the US Patent Office, learned counsel submitted that this is a material consideration while evaluating the appellant's application for grant of patent.

6. In support of these submissions, learned counsel referred to and relied upon the following judgments:

(i) *Societe Des Produits Nestle SA v. The Controller of Patents and Designs and another, 2023/DHC/000774*, particularly paragraphs 63 to 65, wherein the earlier decision in *Avery Dennison Corporation v. Controller of Patents and Designs* (2002/DHC/004697) was cited with regard to the time gap between the cited prior art and the priority date of the claimed invention being a material consideration while assessing obviousness.

(ii) *Auckland Uniservices Limited v. Assistant Controller of Patents and Designs, 2022/DHC/004336*, particularly paragraphs 30 to 33 thereof, wherein, the Delhi High Court concluded that the impugned order is liable to interfered with because the respondent did not discuss or analyse how a person skilled in the art would move from the existing

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state of knowledge to the claimed invention. In the said order, the Delhi High Court also noticed that the same prior art documents were cited before the Patent Offices in other jurisdictions and that the patent was granted in spite of considering such prior art.

(iii) *Agriboard International LLC v. Deputy Controller of Patents and Designs, 2022 SCC OnLine Del 940,* particularly paragraph 24 to 27 thereof, where the Delhi High Court set out the factors to be taken into consideration while assessing whether an inventive step is involved as per Section 2(1)(ja) of the Patents Act.

(iv) *Hettich-Oni Gmbh & Co. Kg v. Controller of Patents and Designs, 2020 12 IPAB CK 0003*, wherein in the penultimate page, the IPAB concluded that the determination of the presence or absence of inventive step is a mixed question of fact and law and that the relevant facts and applicable law should be discussed before arriving at a conclusion.

7. In response to these contentions, the respondent submitted that the claimed invention is in respect of ethylene-based polymers and processes in relation thereto. According to the respondent, all elements of

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the claimed invention, including the combination of ethylene and at least one asymmetrical polyene would be obvious to a person skilled in the art. With specific reference to prior art document D5, the respondent submitted that Table 2 thereof clearly suggests that the ethylene-based polymer comprises, in reacted form, less than, or equal to, 10 moles of asymmetrical polyene per 1000 moles of ethylene-based polymer back bone carbons. For all these reasons, the respondent submitted that the impugned order does not warrant interference and the conclusion that the claimed invention lacks inventive step is unexceptionable.

8. The impugned order is brief and the operative portion thereof is as under:

> *"The office has objected that, the present set of claims does not meet the requirements of Section 2(1)(ja) of the Patent Act 1970. [Hearing Notice is attached herewith]*
>
> *The applicant has argued that D4 and/or D5 do not disclosed or suggest the ethylene-based polymer according to the amended set of claims; etc. But, the argument is not valid and the cited prior art discloses the ethylene acrylic ester as that of present invention [Ref Hearing Notice]. Claim 7 is merged with claim 1*

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but the applicant failed to explain by incorporating the claim 7 into claim 1 how the invention is not obvious to a person skilled in the art in view of the existing teachings mentioned in the documents in the hearing notice."

From the above extract, it is evident that the only ground of rejection is lack of inventive step. Such conclusion has been drawn by relying on the prior art documents D4 and D5. In particular, the respondent concluded that the cited prior art documents disclose ethylene acrylic ester and that the merger of claim 7 with original claim 1 is immaterial.

9. On examining prior art document D4, it is evident that the patent was granted by the US Patent Office on 24.11.1970. Likewise, as regards prior art document D5, the US Patent Office granted patent on 31.10.1967. When compared with the priority date of the claimed invention, more than four decades have lapsed. Such passage of time does not *ipso facto* lead to the conclusion that the claimed invention is not obvious. At the same time, it is a relevant consideration to be taken into account by the Controller while assessing obviousness. US Patent No.10, 442, 878 B2 was granted in respect of the claimed invention by

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the US Patent Office. The relevant document indicates beyond doubt that both prior art documents D4 (3, 542, 749A) and D5 (3, 350, 372A) were considered while granting the patent. The requirement of non-obviousness or inventive step is substantially the same across all jurisdictions. In that context, the grant of patent by other jurisdictions by considering the same prior art documents is a material consideration, *albeit* non-determinative and non-dispositive, while assessing an application for grant of patent.

10. As discussed earlier, the impugned order records the conclusion that the claimed invention is not inventive by drawing reference to D4 and D5. However, the submissions of the appellant that the cited prior arts do not lead to the claimed invention were not engaged with and no reasons were recorded for rejecting such submissions. Therefore, the impugned order is unsustainable and is hereby set aside. As a consequence, the matter is remanded for reconsideration. Such reconsideration shall be undertaken on the following terms:

(i) The observations contained in this order with regard to the evaluation of obviousness when the same prior art documents were cited

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in other jurisdictions and the observations with regard to the passage of considerable time between the cited prior arts and the claimed invention should be taken into consideration.

(ii) In order to preclude the possibility of predetermination, an officer other than the officer who issued the impugned order shall undertake reconsideration.

(iii) 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 judgment.

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

11. Consequently, (T) CMA (PT) No.73 of 2023 is disposed of on above terms. There shall be no order as to costs.

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

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