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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 11.07.2024

CORAM:

THE HONOURABLE MR.JUSTICE P.B.BALAJI

(T) CMA (PT) No.15 of 2023
(OA.No.54 of 2020)

Rhodia Operations,
40, Rue de la Haie Coq,
F-93306 Aubervilliers,
France; Nationality: France. ... Appellant

Vs.

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

PRAYER: Appeal filed under Section 117-A of the Patents Act, 1970, praying that the order dated 30.05.2020 be set aside and the Application No.4551/CHENP/2010 for patent be allowed to proceed to grant in accordance with the provisions of the Act and the Rules.

For Appellant : Mr.Shivathanu Mohan

For Respondents : Mr.Rajesh Vivekanandhan

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JUDGMENT

The appellant, aggrieved by the rejection of its patent application in Application No.4551/CHENP/2010 by order dated 30.05.2020 for esteramide as a compound, has preferred this appeal.

2.Originally, the appellant has made a claim for the method use as well as the compound as such. However, subsequently, they have given up the claims in respect of the use and the method for preparation of esteramide compound and limited the claim to the compound itself, the respondent, in and by the impugned order, has rejected the claim as lacking inventive steps under Section 2(1)(ja) of the Indian Patents Act.

3.I have heard Mr.Shivathanu Mohan, learned counsel for the appellant and Mr.Rajesh Vivekanandhan, learned Central Government Stating Counsel for the respondent.

4.The learned counsel for the appellant would take me through the impugned order and submit that the analysis and findings arrived at by the respondent are general in nature and they do not address the specific points raised in the written submissions, which are also made available in the typed set of papers. The learned counsel would also take me through

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the written submissions which have been filed before the respondent even before the impugned order came to be passed and he would specifically invite me to the paragraphs pertaining to the comparison with the prior arts, D2 which has been cited by the respondent/Controller against the appellant. He would therefore submit that the respondent has erred in not discussing the explanation to the objections made by way of written submissions and has merely jumped to conclusions without sufficient material or reasoning. Therefore, he would seek for the matter being remitted to the respondent for fresh consideration.

5.Per contra, the learned counsel for the respondent would submit that the esteramide is a Bio-degradable compound and as such, though the respondent/Controller found novelty to exist, he has only rejected the patent on the ground that it does not lack any inventive steps, as it was obvious to a persons skilled in the art.

6.Having considered the rival submissions of the learned counsel for the appellant and the learned counsel for the respondent, I find force in the submissions advanced by the learned counsel for the appellant. In the written submissions there is specific reference to prior art, D2 which concerns plasticize whereas, the invention concerns disinfectants for

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plants and the appellant has also given specific explanation as to why D2, prior art fails to disclose teach or suggest that the esteramide compounds formula I comprising R1, R2 and R3 as recited in the present claims and as to how they are different from the compositions of prior art, D2 which are not solvents or coalescing agents.

7.I find that the appellant has also given a detailed comparison chart, which clearly explains that the invention is Alcaline group in contrast to both D1 and D2 which are linear groups in nature. However, the respondent, without considering these explanations offered by the appellant, has merely stated that “some of the compounds claimed are described in D2. In addition, the structural diversity of the compounds according to D2 indicates that the person skilled in the art would have reasonably considered some variability in the formula while retaining the properties sought”. That apart, the respondent/Controller has also observed that in the field of Synthetic Organic Chemistry, it is routine knowledge while dealing with different Synthetic routes to explore linear and branched chains. However, the Controller has not defined or explained what is routine in knowledge. Similarly, he has also not stated which are the compounds which are described in D2, prior art against the invention claimed by the appellant. Therefore, it is a fit case where the

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matter has to be remitted for proper consideration of the appellant's application.

8.In fine, the appeal is allowed and the matter is remitted to the respondent for fresh consideration. The respondent shall assign the task of scrutinizing the patent application of the appellant to a different Patent Controller to avoid any embarrassment to the parties and after affording an opportunity to the appellant, the application shall be disposed of within a period of four months from the date of receipt of a copy of this order.

11.07.2024

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P.B.BALAJI, J.

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Deputy Controller of Patents and Designs,
Government of India,
Patent Office,
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(T)CMA(TM) No.71 of 2023

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