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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **19.12.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT)/29/2023

NEC Corporation,
7-1, Shiba 5-chome Minato-ku, Tokyo 108-8001,
Japan, Nationality: Japan, Rep. by its
constituted Power of Attorney,
Mr.Raghavan Ravindran Nair,
De Penning & De Penning, Having Office at
No.120, Velachery Main Road,
Guindy, Chennai - 32. ... Appellant

v.

The Assistant Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy, Chennai - 32. ... Respondent

PRAYER: Civil Miscellaneous Appeal (Patents) is filed under Section 117-A of the Indian Patents Act, 1970, praying to call for the records of the respondent culminating in the impugned order dated 31.03.2023 rejecting the Grant of Patent and set aside the same

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consequently, direct Grant of the Patent in respect of the appellant's Application No.7830/CHENP/2014.

For Appellant : Mr.S.Shivathanu Mohan
for M/s.S.Ramasubramaniam
Associates

For Respondent : Mr.S.Janarthanam, SPC

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JUDGMENT

The appellant filed Patent Application No.7830/CHENP/2014 on 24.10.2014 before the Indian Patent Office. The said application was the national phase application corresponding to PCT International Application No.PCT/JP2013/058886. In the application, the appellant had stated that the inventors were Iskren Ianev, Yannick Lair and Kouhei Gotou and that the said inventors had assigned the invention to the appellant. Subsequently, the declaration of the inventors to the effect that they had assigned the

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invention was provided. The declaration issued by Yannick Lair in Form 1 was dated 07.02.2015, which was the date of declaration. On that ground, the patent application was rejected as being in violation of sub-section 2 of Section 7 of the Patents Act, 1970. The present appeal arises in the above facts and circumstances.

2. Learned counsel for the appellant submitted that Rule 10 of the Patents Rules, 2003 (the Patents Rules), provided for a six month period within which the proof of right should be submitted by the applicant. He further submits that the declarations were provided in compliance with the statutory requirement. Although the inventors had assigned the invention to the appellant earlier, learned counsel submitted that one of the inventors, Yannick Lair, put down the date of signing the declaration while signing. According to learned counsel, the respondent misconstrued the said date as the date of assignment and issued the impugned order on that basis. By referring to the Assignment and Inventor's Declaration relating to the

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corresponding application made before the US Patent Office, learned counsel submitted that all the inventors, including Yannick Lair, issued a declaration with reference to an application made on 15.03.2013. He also pointed out that the declaration is applicable to any corresponding foreign patent application, such as the Indian application. Learned counsel also pointed out that the inventors were employed by the appellant and that the invention related to work done in the normal course of employment.

3. Mr.S.Janarthanam, learned SPC, made submissions in response. His first contention was that the impugned order was issued under Section 6(1) of the Patents Act and, therefore, an appeal is not permitted under Section 117-A thereof. The next contention of Mr.S.Janarthanam, learned SPC, was that the appellant admitted breach of Sections 6 and 7 by requesting for a waiver under paragraph 7 of the declaration dated 14.10.2022. Consequently, he submitted that the impugned order does not contain any infirmity.

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4. The contention of Mr.S.Janarthanam, learned SPC, that the appeal is not maintainable cannot be countenanced because the appeal is against a refusal order under Section 15 of the Patents Act. It is abundantly clear that an appeal is maintainable against such order under Section 117-A.

5. Section 6 of the Patents Act sets out the persons who are entitled to apply for a patent. Apart from the true and first inventor, clause (b) of sub-section (1) enables the assignee of the true and first inventor to make the application. If an application is made by the assignee, sub-section 2 of Section 7 requires the applicant to provide proof of the right to make the application within the prescribed period. Such period is prescribed under Rule 10 of the Patents Rules and the prescribed period is six months from the date of filing of the application. The appellant has admittedly provided declarations from the inventors within the prescribed period. The only question

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to be considered is whether the declaration of Yannick Lair is in consonance with the statutory prescription.

6. The declaration issued by the appellant on 14.10.2022 asserts that the inventors were employed by the company and that the invention was a work product in course of employment. The assignment and inventors' declaration made by the three inventors in relation to the corresponding application before the US Patents Office is on record. In such declaration, each inventor, including Yannick Lair, has recorded that the invention has been assigned and that the assignee is entitled to claim rights in respect of the application filed before the US Patents office and any corresponding foreign patent office.

7. When the above facts and circumstances are considered cumulatively, it leads to the inference that the assignment pre-dated the declaration dated 07.02.2015 by Mr.Yannick Lair. It should be

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recognized that there is a distinction between the date of assignment and the date of declaration relating thereto, and the impugned order is the consequence of conflating the two. Therefore, the impugned order is unsustainable and is, hereby, set aside. As a consequence, the respondent is directed to decide Patent Application No.7830/CHENP/2014 on merits and in accordance with law. 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.

8. CMA(PT)/29/2023 is allowed on the above terms without any order as to costs.

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

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