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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : **28.11.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT)/23/2023

BCS S.P.A.,
via Marradi 1-Milano Italy,
Rep. by its Power of Attorney, Raghavan Ravindran Nair,
De Penning and De Penning,
having office at No.120,
Velachery Main Road,
Guindy, Chennai 600 032. ... Appellant

-vs-

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

PRAYER: Civil Miscellaneous Appeal (Patents) filed under Section 117-A of the Patents Act, 1970, praying to call for the records of the respondent culminating in the impugned order dated 09 July 2021 rejecting the Grant of Patent and Set Aside the same and consequently direct grant of the Patent in respect of the Appellant's

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Application No.992/CHE/2011.

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

For Respondent : Mr.J.Madanagopal Rao, SPC

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JUDGMENT

The appellant assails an order dated 09.07.2021 by which Application No.992/CHE/2011 for the grant of patent to an invention entitled "Agricultural Driving Mechanism and Related Tool" was rejected. The appellant filed the above mentioned application on 29.03.2011. Pursuant to the examination, the first examination report (FER) was issued on 19.03.2018. In the FER, the controller raised objections *inter alia* on the grounds of lack of inventive step by citing prior arts. The appellant replied to the FER on 12.07.2018. The hearing notice was issued on 12.04.2021 and the objections with regard to lack of inventive step were maintained

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therein. Pursuant to a hearing on 19.05.2021, the appellant filed written submissions on 24.05.2021. The impugned order was issued thereafter.

2. Learned counsel for the appellant assails the impugned order primarily on the ground that the order is completely unreasoned. By inviting my attention to the said order, learned counsel submits that ten prior art documents (D1 to D10) were cited therein. Thereafter, learned counsel points out with reference to internal pages 3 to 30 thereof that the Controller merely reproduced extracts from each prior art. Learned counsel further submits that the controller merely extracted key words from the above mentioned prior arts in the operative portion of the order at internal pages 30 and 31 thereof before drawing the conclusion at internal pages 31 and 32 that the claimed invention is obvious on the basis of the cited prior art. In fact, learned counsel handed over a marked up version of the operative portion of the order where the portions lifted straight from the respective prior art documents are marked. In these

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circumstances, learned counsel submits that the impugned order is liable to be set aside and the application remanded for re-consideration.

3. In response of these submissions, Mr.J.Madanagopal Rao, learned SPC, relies on the counter filed by the respondent. He further submits that a scientific adviser may be appointed in view of the technical nature of the claimed invention.

4. On examining the impugned order, it is evident that portions of the cited prior arts were extracted across most of the pages thereof. Even the operative paragraphs of the impugned order do not contain any consideration of the submissions of the appellant either in response to the FER or in the written submissions filed pursuant to the hearing. The cited prior arts appear to have been combined in the operative portion of the order by lifting portions thereof in order to draw a conclusion that the claimed invention is obvious to the person skilled in the prior art. Since such order is bereft of reasoning, the

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order cannot be sustained and is, hereby, set aside.

5. Consequently, the matter is remanded for re-consideration on the following terms and conditions:

(i) In order to preclude the possibility of pre-determination, an officer other than the officer who issued the impugned order shall undertake such re-consideration.

(ii) 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.

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

6. Therefore, CMA(PT)/23/2023 is disposed of 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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