WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 13.03.2024

CORAM :JUSTICE N.SESHASAYEE

CMA(PT) No.35 of 2023

GENSQUARE LLC
2nd Floor Dongrim Building 38
Gangnam-daero 62-gil
Gangnam-gu, Seoul, 06254
Republic of Korea

Through the Authorised Representative
Mr.KIM Myong Soo, CEO/President
of GNESQUARE LLC
134, Maebong-ro, Dongjak-gu
Seoul, Republic of Korea. ... Appellant

Vs.

The Assistant Controller of Patents & Design
Patent Office
IPR Building, SIDCO Plot
GST Road, Guindy
Chennai - 600 032. ... Respondent

PRAYER: Civil Miscellaneous Appeal (Patent) filed under Section 117A of the Patents Act, 1970, praying to allow the appeal, quash the impugned order dated 27th March, 2023 passed by the respondent in Indian Patent Application No.2931/CHENP/2015 and grant patent; and to pass any other order as this Court may deem fit and proper based on the facts of the case.

https://www.mhc.tn.gov.in/judis

WEB COPY

For Appellant : Ms.Sarah Haque

For Respondent : Mr.S.Janarthanam
Senior Panel Counsel

JUDGMENT

This appeal is directed against the order of the respondent dated 27.03.2023, in which he had refused the divisional application filed by the appellant under Sec.16 of the Patents Act.

2.1 The facts are :

a) On 12.03.2014, the appellant had filed an application for patenting a certain invention. While this application was pending consideration of the Patent Controller, on 20.05.2015, the appellant had filed the present divisional application with 9 claims. According to the appellant, the nine claims flow directly from the specification in the parent application.

b) This application eventually evoked a FER from the Controller, wherein he had raised three objections resisting the divisional application, and they are :

https://www.mhc.tn.gov.in/judis

WEB COPY

i. That there is no inventive step within the meaning of Sec.2(1)(ja), which is sought to be backed with two prior arts in D1 and D2;

ii. That the divisional claims are beyond the scope of the parent application; and

iii. The divisional application lacks clarity and conciseness within the meaning of Section 10 of the Act.

c) The appellant responded to the FER and amended the claims, and brought it down from 9 to 7, of which, the first claim is an independent claim.

d) This was followed by a hearing notice, wherein the Controller retained the same set of objections which he had earlier raised in its FER.

e) The appellant participated in the hearing and also filed its written submissions, and also amended claim No.1, which as earlier stated is its only independent claim.

2.2 The Controller would ultimately reject the appellant's application vide his order dated 27.03.2023, on the ground that the divisional claims do not flow

https://www.mhc.tn.gov.in/judis

WEB COPY

from the original claims made in the parent application, for arriving which conclusion he relied on the authority of the learned Single Judge of Delhi High Court in ***Boehringer Ingelheim International GMBH Vs The Controller of Patents*** [order dated 12.07.2022 in C.A.(COMM.IPD.PAT)295/2022 & I.As.10369-70/2022]. So far as other grounds of objections are concerned, the order was silent. Hence, this appeal.

3. Heard both sides. The learned counsel for the appellant submitted that the authority relied on by the Patent Controller was since overruled by a Division Bench of Delhi High Court in ***Syngenta Limited Vs Controller of Patents and Designs*** [2023 SCC OnLine Del 6392]. She further added that Sec.16 of the Patent Act only requires that the divisional application must flow from the specification in the parent application, and does not say that the claims made in the divisional application must flow from the claims made in the parent application. This precisely is the reason why in ***Syngenta Limited case*** the Court chose to overrule the earlier view of the learned Single Judge.

4. The submissions of the counsel for the appellant sums it all, and it does not require anything for this Court to add to it. When the foundational reason

https://www.mhc.tn.gov.in/judis

WEB COPY

for the conclusion arrived by the Patent Controller does not exist, necessarily the said conclusion cannot have legitimacy to stay alive. Necessarily, the impugned order must now go.

5. To conclude, the appeal is allowed and the impugned order of the respondent dated 27.03.2023, is set aside and matter is remanded back for a *de novo* consideration. To save embarrassment to the Controller who has passed the impugned proceedings, this Court directs that appellant's application now be considered by some other Controller. In the eventuality of the appellant's invention getting patented, it will have a shelf value and hence the Patent Controller, who will now be in incharge of disposing of the appellant's application, is required to dispose of the appellant's application as expeditiously as possible. No costs.

13.03.2024

Index : Yes / No
Speaking order/ Non-speaking order
ds

To:
The Assistant Controller of Patents & Design
Patent Office, IPR Building, SIDCO Plot

https://www.mhc.tn.gov.in/judis

WEB COPY

GST Road, Guindy
Chennai - 600 032.

N.SESHASAYEE, J.
ds

CMA(PT) No.35 of 2023

13.03.2024