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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 01.03.2024

CORAM :JUSTICE N.SESHASAYEE

CMA(PT) No.13 of 2023

Omega SA
Jakob-Stampfli-Strasse 96 CH-2502
Biel/Bienne Switzerland
Nationality : Switzerland ... Appellant

Vs.

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

PRAYER: Civil Miscellaneous Appeal (Patent) filed under Section 117A of the Patents Act, 1970, praying to call for the records of the respondent culminating in the impugned order dated 29.12.2022, rejecting the grant of patent and set aside the same and consequently direct the grant of patent in respect of the appellant's application No.1342/CHE/2011 and pass such further or other orders as this Court deems fit and proper in the circumstances of the case.

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

For Respondent : Mr.K.Subbu Ranga Bharathi
Central Government Counsel

JUDGMENT

The appellant herein is aggrieved by rejection of its application for patenting its invention titled "CERAMIC ELEMENT INLAID WITH AT LEAST ONE METALLIC DECORATION", which relates to a ceramic element inlaid with at least one metallic decoration and more specifically an element of this type that is intended to be mounted in a timepiece, on the ground that it lacked the inventive step, as the nature of invention is far too obvious to those who are skilled in the art.

2. The facts are :

a) The appellant herein is an internationally renowned watch maker and it claims that it has invented a method to embed a metal on a ceramic surface. In its application, it had made 14 claims, of which one is independent claim and the rest are dependent claims.

b) In response, the respondent came out with its FER, in which the Controller had cited D1 to D5 as prior arts, and objected to the

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patentability of appellant's invention on grounds of (a) lack of novelty; (b) lack of inventive step; and (c) for lack of clarity under Sec.10(4).

c) The appellant gave its response to the FER and amended its claims. It retained the total number of claims as 14, but the total number of independent claims went up from 1 to 2. This apart, certain internal amendments to various claims were also made.

d) This was followed with a hearing notice in which the Controller had cited four prior arts, of which except D4, rest are all new prior arts. The appellant participated in the hearing and also filed its written submissions.

e) Eventually the Controller rejected the appellant's application on the ground that the nature of appellant's invention is far too obvious to those who are skilled in the art.

3.1 Heard both sides. The counsel for the appellant made the following submissions:

(a) The Controller had over simplified his approach to the application before him. The four prior arts cited in the hearing notice have been

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considered and distinguished in other jurisdiction, and that the appellant has been able to patent its invention in the U.S, and multiple countries in Europe.

(b) The appellant's invention relates to a process of inlaying a metal on ceramic surface. Inasmuch as the appellant is a watch maker, these details are done in nanoscale with utmost precision. It commences with a ceramic body which may be zirconia or titanium carbide. Then it is subjected to a procedure called 'sintering' which may be stated as a process where zirconia or titanium is turned into a solid mass on heating. Thereafter, laser etching is done on the surface of the ceramic mark to a nanoscale. This laser etching is commonly available, but it is only one of the multiple steps involved in the invention of the appellant. Through laser etching, a small depression or a recession is made on the ceramic surface, on which is laid two layers of electrically conductive of 50 nanometers. On this is placed a metal which is fixed to the aforesaid electrically conductive layer through galvanization. This is a hyper precision technology, and it is not akin to a metallic inlay in a ceramic teapot. And it has multiple advantages, and the chief among the same is its

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enormously high adhesive capability to bind a metallic body to the ceramic body. And it is also wear resistance.

3.2 Arguing further the learned counsel submitted that the Controller did not explain in his order how the prior arts D1 to D4 can specifically be applied to appellant's invention. And in this regard, the Controller has not considered the written submissions of the appellant. He almost equated the hyper precision technology of the appellant as some kind of an ordinary laser etching, and tried to generalize it. It is not without reason in U.S. and other European countries, the Patent Office have been able to distinguish appellant's invention from D4 and D2, and have granted patent.

4. This Court carefully weighed the appellant's submission and also perused the records. It is evident from the two paged order of the Patent Controller (in effect it runs to only two paragraphs, and can be easily condensed in one page) that the extent to which he has applied his mind to the issue before him falls far short of expected requirements. When prior arts are cited or grounds of objections are raised in the hearing notice, it becomes imperative for every Patent Controller to examine the quality of response given to them in the written submissions. As has been argued by the counsel for the appellant, it

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appears that the Patent Controller almost appeared to have equated the appellant's technology to some commonly available laser etching technology, when he ought to have focused on the entire process involved in the inlay and the finished product taken as a whole. That would have given him an indication to ascertain if the appellant's invention will be too obvious to a person skilled in the art. There it falls short of the required level.

5. This Court is left with little option, but to set aside the impugned order of the Patent Controller, and is constrained to remand the matter back to the Controller for denovo consideration. To save embarrassment to the Patent Controller who have decided the issue, this Court directs the appellant's application be considered by some other Controller. The appellant is at liberty to amend its claim. The Controller of Patents who will now be incharge is required to expedite the process and to pass an order within a period of six (6) months from the date of receipt of a copy of this order. No costs.

01.03.2024

Index : Yes / No
Speaking order/ Non-speaking order
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To:
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N.SESHASAYEE, J.

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