



A.No.2655 of 2021
in C.S.(Comm.Div).No.400 of 2019

IN THE HIGH COURT OF JUDICATURE AT MADRAS

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Reserved on : 26.08.2021

Pronounced on : 01.09.2021

Coram:

THE HONOURABLE DR. JUSTICE G.JAYACHANDRAN

A.No.2655 of 2021

in

C.S.(Comm.Div).No.400 of 2019

Mr.Arumugam Rajendra Babu
Son of Mr.Arumugam,
No.20F, Vasu Apartments,
92nd Street, 18th Avenue,
Ashok Nagar, Chennai – 600 083.

... Applicant/plaintiff

/versus/

1. Ashok Leyland Limited,
Represented by its Managing Director,
No.1, Sardar Patel Road,
Guindy, Chennai – 600 032.

2. Sun Mobility,
Represented by its Chairman,
'Maini Sadan', No.38, 3rd Floor,
7th Cross Street, Lavelle Road,
Bengaluru – 560 001.

3. Virya Mobility 5.0 LLP,
Represented by its Managing Partner,
'Maini Sadan', No.38, 3rd Floor,
7th Cross Street, Lavelle Road,
Bengaluru – 560 001.

4. Sun New Energy Systems,
Represented by its Chairman,
'Maini Sadan', No.38, 3rd Floor,
7th Cross Street, Lavelle Road,



Bengaluru – 560 001.

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5. Sun Mobility Private Limited,
Represented by its Managing Director,
having address at:
Block No.41/4 & 5
Speed Bird House,
Connaught Circus, New Delhi,
Central Delhi – 110 001.
And also at:
Epsilon Office,
A1, First Floor,
Kariyammana Agrahara,
Yemalu, Bengaluru – 560 037.

... Respondents

Prayer:- This application is filed under Order XIV and Rule 8 of High Court Original Side Rules with Section 117 (E) of the Patents Act, 1970, Order XVI Rule 1 (2) and Section 151 of the Code of Civil Procedure.

a). Why the above application should not be treated as urgent?

b). This Court is pleased to direct the Controller of Patents, Indian Patent Office, Intellectual Property Office, Guindy, Chennai, under Section 117-E of the Patents Act, 1970, to appear, submit a statement in writing signed by him and give evidence before this Hon'ble Court relating to (i). the features and extent under claims regarding plaintiff patent bearing No.262461 and the grounds of decision given by him prior to its grant (ii). the difference between plaintiff's earlier Indian Patent bearing No.142/MAS/2003 and Patent No.262461 (iii). the extent, scope and features of patent bearing No.309399 consequent upon its amendment of specification and claims deleting and replacing the word 'vehicles' to “device” and the ground of decision given by him prior to its grant.



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For Applicant : Mr.S.P.Vijayaraghavan
For D2 to D5 : Mr.M.S.Bharath
For D1 : Mr.S.Vijayanand

ORDER

The suit is filed for the relief of permanent injunction to restrain the defendants from infringing the patent bearing No.262461 and for costs.

2. The 5th defendant has filed written statement, wherein counter claim to revoke the plaintiff's patent under No.262461 and to dismissal of the suit with punitive costs is prayed.

3. The case of the plaintiff is that, he is the inventor of "Electrically Operated Vehicle having a wind operated battery charging system" for which, the patent under No.262461 duly granted on 22.08.2014. While so, the defendants during the month of January, 2019 advertised for selling mass electric mobility solutions through "Quick Interchange Station" and "Smart Battery" for automobiles. The said solution offered by the defendants incorporates predominantly and substantively the essential features of the



plaintiff's patent bearing No.262461. The products of the defendant fall within the scope of the plaintiff's patent. Therefore, the defendants are to be restrained from infringing its patent and directed to pay costs.

4. Denying the plaint averments, the defendants have filed written statement contending that the 5th defendant is the holder of the patent No.309399 titled "Swap stations for enabling swapping of rechargeable batteries". This Technology has been launched in India as early as April 2018. The 5th defendant entered into a strategic alliance with the 1st defendant to push for integrated ecosystem comprising of 1st defendant's state of art electric vehicles and the 2nd to 5th defendants Proprietary battery swapping technology along with a network of quick interchange battery stations. The plaintiff's patent 262461 is anticipated by prior art including prior patent specifications, claims and other published documents. It does not include an inventive step based on prior patents and publications and the said patent lack novelty. Hence, under section 64 of the Patent Act, the grant of patent to the plaintiff has to be revoked and the suit to be dismissed with punitive costs.

5. With the above said set of pleadings, the plaintiff in Application

No.639 of 2019 sought for interim injunction against the defendants. This
<https://hcservices.ecourts.gov.in/hcservices/>



Court, dismissed the petition and observed that the true nature of the invention claimed by the rival parties can be determined only with the aid of an expert and therefore, exercising the power under Section 115 of the Patent Act, a Scientific Adviser was appointed to submit report on the queries formulated by the Court. Accordingly, the Scientific Adviser had submitted his report. The plaintiff has also filed his objection to the report.

6. On the facts controvert in the pleadings, this Court has framed issues and posted the matter for fixing date for examination of witnesses.

7. At this juncture, the plaintiff has taken out the instant application under Section 117 E of the Patents Act, to issue direction to the Controller of Patents, to appear, submit a statement in writing signed by him and give evidence in relation to the questions formulated.

8. The defendant has filed counter stating that under Section 117 E of Patent Act, there is no scope for summoning the Controller of Patents to give evidence. The provision of law is wrongly interpreted by the plaintiff. The essential features of the plaintiff's Patent No.262461 and the defendant's Patent No.309399 are different. By getting report from the Scientific Advisor for the



queries formulated, the Court is assisted with expert opinion. The law does not provide for summoning the Controller of Patents to give evidence to explain the reasoning for granting patent which is an act he discharged in the course of his duty.

9. The point for determination:-

Whether Section 117 E of the Patents Act, entitles parties to the litigation before the Court to seek direction to the controller of Patents to appear, submit statement and give evidence ?

10. Legislative background:-

On repeal of the Indian Patents and Designs Act 1911 in so far as provisions relates to Patents, the Patents Act, 1970 came into force from 20th April, 1972. Substantial amendments to the Act was made through the Patents (Amendment) Act, 2002 (Act 38 Of 2002) which came into force on 20th May 2003. Through this amendment, in the Principal Act, for the words “**High Court**” wherever they occurred in Sections 21, 43 and 71 and the word “**Court**” occurring in Sections 21 and 71, the words “**Appellate Board**” and “**Board**” were respectively substituted. Also, in the Chapter XIX, Sections 116 and 117 were substituted with amended sections 116 and Section 117-A – 117-H.

<https://hcservices.ecourts.gov.in/hcservices/> 14. In so far as the Patents Act, the Appellate Board become



functional from 02.04.2007. Nearly after 14 years, in view of the Promulgation of “The Tribunals Reforms (Rationalization and Conditions of Service) Ordinance, 2021” from 04.04.2021, the Appellate Board dissolved and had become *functus officio*. The resultant consequence, the powers and functions of the Appellate Board is now been vested with the High Court.

12. In the instant application, the plaintiff seeks direction to the Controller of Patents to appear, submit statement and give evidence. Therefore, it is also necessary to look into the provisions relating to Controller which deals with his powers, right and duty.

13. Controller of Patents:-

Section 73 of this Act says, The Controller General of Patents, Designs and Trade Marks appointed under sub-section (1) of Section 3 of Trade Marks Act, 1999, shall be the Controller of Patents for the purposes of this Act. Sub-Section (2) empowers the Central Government to appoint as many examiners and other Officers with such designations as it think fit. Sub-Section (3) enables the Controller to delegate his powers to Examiners. Sub-Section (4) gives power to the Controller to withdraw any matter pending before an Officer appointed under sub-section (2) or to transfer the matter from one officer to any



other officer. For quick reference, Section 73 of the Patents Act, is extracted below:-

“73. Controller and other officers.—

(1). The Controller General of Patents, Designs and Trade Marks appointed under sub-section (1) of [Section 3 of the Trade Marks Act, 1999 (47 of 1999)] shall be the Controller of Patents for the purposes of this Act.

(2). For the purposes of this Act, the Central Government may appoint as many examiners and other officers and with such designations as it thinks fit.

(3). Subject to the provisions of this Act, the officers appointed under sub-section (2) shall discharge under the superintendence and directions of the Controller such functions of the Controller under this Act as he may, from time to time by general or special order in writing, authorise them to discharge.

(4). Without prejudice to the generality of the provisions of sub-section (3), the Controller may, by order in writing and for reasons to be recorded therein withdraw any matter pending before an officer appointed under sub-section (2) and deal with such matter himself either de novo or from the stage it was so withdrawn or transfer the same to another officer



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Section 116: Appellate Board.- (1) Subject to the provisions of this Act, the Appellate Board established under section 83 of the Trade Marks Act, 1999 (47 of 1999) shall be the Appellate Board for the purposes of this Act and the said Appellate Board shall exercise the jurisdiction, power and authority conferred on it by or under this Act:

Provided that the Technical Member of the Appellate Board for the purposes of this Act shall have the qualifications specified in sub- section (2).

(2).....

16. Section 117 A to 117 D of Patents Act, deals with the nature of matters which can be subjected to appeals, procedure and powers of the Appellate Board, Bar of jurisdiction of courts and procedure for application for rectification of register or revocation of patents. Section 117 E deals with the right of the Controller to appear before the Appellate Board and be heard.

Section 117 E: Appearance of Controller in legal proceedings:-

(1) The Controller shall have the right to appear and be heard -

(a) in any legal proceedings before the

Appellate Board in which the relief sought includes



alteration or rectification of the register or in which any question relating to the practice of the patent office is raised;

(b) in any appeal to the Appellate Board from an order of the Controller on an application for grant of a patent-

(i) which is not opposed, and the application is either refused by the Controller or is accepted by him subject to any amendments, modifications, conditions or limitations, or

(ii) which has been opposed and the Controller considers that his appearance is necessary in the public interest, and the Controller shall appear in any case if so directed by the Appellate Board.

(2) Unless the Appellate Board otherwise directs, the Controller may, in lieu of appearing, submit a statement in writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue or of the grounds of any decision given by him or of the practice of the patent office in like cases, or of other matters relevant to the issues and within his knowledge as the Controller may deem it necessary, and such statement shall be



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evidence in the proceeding.

17. Since the Appellate Board is abolished from 04.04.2021 and the functions of the Appellate Board is vested with the High Court, for the purpose of this case the words Appellate Board has to be read as High Court.

18. In the instant suit for infringement of Patent filed by the Plaintiff, is resisted with a counter claim to revoke the said patent by the defendant. In view of Section 64, both the issues namely infringement and revocation are before the High Court for adjudication.

19. Appearance of Controller in legal proceedings:-

Section 117-E is an unique provision in the Patents Act and to this Court's knowledge, there is no other statute which have a similar or analogous provision. The reason for incorporating such provision in this Act alone is also not difficult to understand. As far as Patents Act is concern, it deals with description, drawings, abstract and claim which are cumulatively called 'Specification'. They are technical in nature. Physical appearance of the product or device will not disclose the actual inventiveness or novelty involved in it. Hence, under section 115 the Court can appoint an independent Scientific



Advisor to assist the Court or to inquire and report upon any such question of fact or of opinion (not involving a question of interpretation of law). There may be cases, where certain particulars or procedure will be within the exclusive knowledge of the Controller or matter to which the controller will have privy, if there is no opposition or in case of opposition if the public interest is involved, the right to appear and to be heard is conferred on the Controller on the circumstances mentioned in section 117 E.

20. This unique provision which confer right to the authority who is vested with power to grant, refuse, accept application with modifications, amendments, conditions or limitations to appear and get audience before the Appellate body which adjudicate the statutory appeal against his order is incorporated in this Act with the intention to enable the Controller to assist the Appellate Authority by providing the particulars which the Controller thinks necessary for the appellate authority to decide the matter in issue before them and those are within the knowledge of the Controller. His role while appearing under section 117 E is more or less like an “amicus” and not a “witness.”

21. While analysing, subsection (1)(a) of section 117 E, the right of appearance and hearing is, *“in any legal proceedings before the Appellate*



Board in which relief sought includes alteration or rectification of the register or in which any question relating to the practice of the patent office is raised.”

22. Sub-section (2) of 117 E qualifies the right of appearance in case of no opposition and in case of opposition, only if the Controller considers his appearance is necessary in the public interest. By saying ‘unless the Appellate Board otherwise directs’ the said right of appearance becomes subjective. Further the said appearance need not be physical appearance. The Controller may, in lieu of physical appearance, may submit a statement in writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue or of the grounds of any decision given by him or of the practice of the Patent Office in like cases, or of a other matters relevant to the issues and within his knowledge as the Controller may deem it necessary.

23. In other words, Sub-section(1)(a) of section 117 E gives the controller right to appear and be heard in any legal proceedings pending before the Appellate Board. Sub-section (1)(b)(i) gives the similar right in appeals where there is no opposition. Whereas, under Sub-section (1)(b)(ii) in case there is opposition, the right of appearance and hearing can be exercised only if it is



necessary in the public interest. Further, by using the conjunction ‘and’ followed by the expression in any case, if so directed by the Appellate Board the Controller shall appear before the Appellate Board, it is clear that this power can be exercised only in case which is referred in 117 E (1)(b)(ii) and not in all cases. Since, there is restriction on the Controller to exercise his right of appearance and right of audience in appeals which has been opposed, unless it is necessary in the public interest, by using the conjunction “and” the Act enables the Court to get statements from the Controller even in cases where there is opposition.

24. Thus, in any appeal before the Appellate Board whether opposed or not opposed, if the Appellate Board is of the opinion that the Controller must be heard on any of the matter before it, the Appellate Board may direct the Controller to appear. If his personal appearance is not required, in lieu of his personal appearance, he may be asked to submit statement in writing containing the request particulars duly signed. Such statement shall be taken as evidence by the Court.

25. The right of appearance in person is not essential in all cases. It is subject to the specific direction to that effect by the Appellate Board.

The Controller, who wanted to be heard in any legal proceedings before the



Appellate Board or in appeal subject to the restrictions mentioned, he shall exercise his right by submitting statement in writing duly signed.

26. Except the circumstances specifically referred in the Section, the Authority who is duly empowered to discharge duty under the statute cannot be directed to appear before Appellate Authority. Under this Section, he cannot be summoned to give evidence. The right to appear and to be heard is a right with limitations and restrictions prescribed under the law.

27. In the given context, it is also appropriate to refer sections 73(2) and 73(3). Under Section 73(2) for the purposes of this Act, the Central Government may appoint as many examiner and other Officers and with such designations as it thinks fit. The Controller shall authorize the Examiner and other Officers appointed under sub-section (2) to discharge such functions of the Controller by general or special order in writing. Thus, powers of the Controller can be delegated to the Examiners under Sub-Section (3) of Section 73.

28. In this juncture, it is appropriate to consider Section 144 and

Section 147 of the Act. Sections 144 of the Act says, report of examiners to be



confidential. Such reports shall not be liable to production or inspection in any legal proceedings unless the Court certifies that the production or inspection is desirable in the interest of justice, and ought to be allowed.

Section 147 of Patents Act, 1970:-

147. Evidence of entries, documents, etc.—

(1). A certificate purporting to be signed by the Controller as to any entry, matter or thing which he is authorised by this Act or any rules made thereunder to make or do, shall be prima facie evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or omitted to be done.

(2). A copy of any entry in any register or of any document kept in the patent office or of any patent, or an extract from any such register or document, purporting to be certified by the Controller and sealed with the seal of the patent office shall be admitted in evidence in all Courts, and in all proceedings, without further proof or production of the original.

(3). The Controller or any other officer of the patent office shall not, in any legal proceedings to which he is not a party, be compellable to produce the register or any other document in his custody, the contents of which can be proved by the



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Adviser. The applicant/plaintiff has filed his objection to the Scientific Adviser and same is taken on record. There is opposition by way of a counter-claim for revocation. There is no public interest involved in this case. In such case, the Controller has no right of appearance or right of hearing in view of the restriction mentioned in section 117 E (1)(b)(ii).

32. From the facts and pleadings, this Court does not find any reason to direct the appearance of the Controller of Patent and give answer to the queries mentioned in the Judges Summon. Also does not find any special cause to exercise the power under section 147 of the Act to direct the controller of patents and give evidence.

33. As a result, the Application is liable to be dismissed. Accordingly, the *Application No.2655 of 2021 is dismissed* without costs.

Sd./-G.J.J
01.09.2021

//Certified to be true copy//
Dated at Madras this the day of 2021.

COURT OFFICER(O.S.)
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