IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **24.08.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(PT)/4/2023
(OA/2/2018/PT/CH)

BIGTEC PRIVATE LIMITED,
Through its Authorized Representative
2nd Floor, Golden Heights,
59th 'C' Cross, 4th 'M' Block, Rajajinagar,
Bangalore 560 010, Karnataka, India. ... Appellant

-vs-

The ASSISTANT CONTROLLER OF PATENTS & DESIGNS,
Patent Office Branch
Intellectual Property Building,
G.S.T. Road,
Guindy,
Chennai 600 032 ...
Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) filed under Sections 117-A of the Patents Act, 1970, prays to (i) allow the present Appeal and set aside quash the impugned order dated July 26, 2017 passed by the Respondent for Indian Patent Application No. 421/CHE /2009 (ii) direct grant of patent in respect of the said Indian Patent Application No. 421/CHE/2009

For Appellant : Mr.Shatadal Ghosh &
Mr.K.Muthuselvam for
for M/s.K and S Partners

For Respondent : Mr.K.Subbu Ranga Bharathi, CGSC

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JUDGMENT

The appellant assails an order dated 26.07.2017 by which the request for grant of patent was declined. By the impugned order, the respondent concluded that the amended claims 1 to 10 do not involve an inventive step as required by Section 2(1)(ja) of the Patents Act, 1970 (the Patent Act). The respondent also concluded that amended claims 5 to 7 are not patentable under Section 3(e) of the Patents Act.

2. At the hearing on 25.07.2023, learned counsel for the appellant dealt with the cited prior art and contended that the claimed invention satisfies all the requirements of Section 2(1)(j) and that the claimed invention would not be obvious to a person skilled in the art on the basis of the cited prior arts. He also contended that amended claims 5 to 7 are not within the scope of Section 3(e) of the

Patents Act. With specific reference to the cited prior art documents, learned counsel pointed out that the cited prior arts are either not relevant or, at any rate, do not contain any teaching that lead to the claimed invention.

3. Upon obtaining instructions, Mr.Subbu Ranga Bharathi, learned Central Government Standing Counsel, submits that the matter may be remanded for re-consideration. The said submission is made without making any concession on the merits of the matter.

4. Learned counsel for the appellant is agreeable to this course of action subject to two caveats:

(i) Such re-consideration should be confined to the grounds on which the patent application was refused and the prior arts cited therein.

(ii) Such re-consideration should be by a different officer.

5. On instructions, Mr.Subbu Ranga Bharathi is agreeable to the

first requirement of learned counsel for the appellant. As regards the second, I am of the view that it is appropriate that a different officer considers the matter on remand so as to preclude confirmation bias.

6. In view of the above development, it is unnecessary to adjudicate the appeal on merits. Instead, the impugned order is set aside on the ground of non-consideration of contentions raised by the appellant both with regard to the cited prior art and the objection under Section 3(e).

7. Consequently, (T)CMA(PT) No.4 of 2023 is disposed of without any order as to costs, without expressing any opinion on the merits, and the matter is remanded for re-consideration on the following conditions:

(i) Re-consideration shall be confined to the grounds on which the application was rejected by impugned order dated 26.07.2017 and the prior art cited therein.

(ii) An officer other than the officer who passed the impugned order shall undertake such re-consideration.

(iii) After providing a reasonable opportunity to the appellant, a reasoned decision should be issued within a maximum period of *four months* from the date of receipt of a copy of this order.

24.08.2023

Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes/No

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SENTHILKUMAR RAMAMOORTHY, J

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(OA/2/2018/PT/CH)

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