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CMA(PT) No.38 of 2024

IN THE HIGH COURT OF JUDICATUE AT MADRAS

DATED: 28.11.2024

CORAM

THE HONOURABLE MR. JUSTICE ABDUL QUDDHOSE

C.M.A.(PT) No.38 of 2024

BASF SE
Ludwigshafen 67056,
Germany

.. Appellant

Vs

The Deputy Controller of Patents and Designs,
The Patent Office,
Intellectual Property Building,
GST Road, Guindy,
Chennai – 32.

.. Respondent

Prayer: This petition is filed under Section 117A of the Patents Act, 1970, seeking to allow the appeal and set aside the impugned order dated 01.01.2024 and grant a patent in Indian Patent Application No.201945034726 with a consequential direction to enter the patent in the Patent Register.

For Appellant : Vindhya S Mani

For Respondent : Mr.S.N.Parthasarathy, SPC



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JUDGMENT

This appeal has been filed by the appellant aggrieved by the order dated 01.01.2024 passed by the respondent refusing to grant patent in respect of the Divisional Application filed by the appellant under Section 16 of the Patents Act, 1970, on the ground that the said Divisional Application has been filed after the grant of patent in respect of the original patent application filed by the appellant.

2. As per Section 16 of the Patents Act, the Divisional Application will have to be filed before the grant of patent. Section 16 of the Patents Act reads as follows:-

16. Power of Controller to make orders respecting division of application.— (1) A person who has made an application for a patent under this Act may, at any time [before the grant of the patent], if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.



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(2) The further application under sub-section (1) shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.

(3) The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other.

[Explanation.— For the purposes of this Act, the further application and the complete specification accompanying it shall be deemed to have been filed on the date on which the first mentioned application had been filed, and the further application shall be proceeded with as a substantive application and be examined when the request for examination is filed within the prescribed period.]

3. The learned counsel for the appellant would submit that the impugned order has been passed by total non-application of mind to the



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fact that on the very same day when the patent was granted by the respondent in respect of the original patent application, the appellant had filed a Divisional Application in respect of the disputed claims as per the provisions of Section 16 of the Patents Act, 1970. The learned counsel for the appellant also submits that it will be impossible for the appellant to know the exact timing when the patent was granted in favour of the appellant.

4. Admittedly, the Divisional Application was filed on the same day when the patent in favour of the appellant in respect of the original patent application was granted. The appellant will not know the exact timing as to when the patent was granted in its favour.

5. Though the learned standing counsel for the respondent would submit that the timing of the grant of patent was earlier to the timing when the Divisional Application filed by the appellant, the said fact cannot be made known to the appellant. But, despite the said admitted fact, the respondent under the impugned order has refused to consider the appellant's Divisional Application filed under Section 16 of the Patents Act, 1970, on the ground that the said Divisional Application was filed on



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the same day when the patent was granted in favour of the appellant in respect of its original patent application. Therefore, this Court is of the considered view that by total non-application of mind, the impugned order has been passed rejecting the Divisional Application filed by the appellant under Section 16 of the Patents Act, 1970.

6. The learned counsel for the appellant also brought to the notice of this Court that the impugned order has been passed in violation of the principles of natural justice. According to her, in the notice of hearing issued to the appellant, there was no reference to the distinctiveness of the appellant's patent under their Divisional Application. But, in the impugned order, one of the reasons given by the respondent for refusing to grant patent in respect of the Divisional Application is that the claims are not distinctive. According to her, had the respondent granted an opportunity to the appellant prior to the passing of the impugned order by disclosing the same in the notice of hearing, the appellant would have been able to submit its explanation with regard to the contentions of the respondent. But, since this has not been done, the impugned order passed by the respondent is liable to be set aside on the ground of violation of principles of natural justice.



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7. This Court, after giving due consideration to the submissions of the learned counsel for the appellant, which has not been disputed by the learned standing counsel for the respondent, is of the considered view that principles of natural justice has been violated by the respondent while passing the impugned order. Since the impugned order is passed by total non-application of mind to the admitted fact that the Divisional Application filed on the same day when the patent was granted and it was impossible for the appellant to know the exact timing when the patent was granted, necessarily, the impugned order has to be quashed and the appeal will have to be disposed of by remanding the matter back to the respondent for fresh consideration of the Divisional Application filed by the appellant under Section 16 of the Patents Act, 1970, on merits and in accordance with law.

8. Accordingly, the impugned order is hereby quashed and the appeal is disposed of with the following directions:-

- (i) The matter is remanded back to the respondent for fresh consideration.
- (ii) The respondent is directed to pass final orders on the Divisional



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Application filed by the appellant under Section 16 of the Patents Act, 1970, on merits and in accordance with law, within a period of six months from the date of receipt of a copy of this order.

(iii) In the interest of justice, to prevent any pre-determination of the appellant's Divisional Application, the respondent is directed to appoint a different Controller other than the Controller who has passed the impugned order.

No Costs.

28.11.2024

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Index:yes/no
Neutral citation: yes/no

ABDUL QUDDHOSE,J.

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To



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