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(T) CMA (PT) No.195 of 2



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 23.07.2024

CORAM:

THE HON'BLE MR.JUSTICE P.B.BALAJI

(T) CMA (PT) No.195 of 2023

R. & D. S.R.L.
Via Olanda, 71/a-41122,
Modena MO Italy,
Nationality: Italy

.. Appellant

..Vs.

Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy, Chennai - 600 032.

.. Respondent

Prayer: This appeal came to be numbered by transfer of IPAB Case OA.SRNo.55/2021/PT/CHN from the file of the Intellectual Property Appellate Board, Chennai praying that the impugned order dated 24.12.2020 passed by the respondent to be set aside and the subject patent application to be granted considering the written submission as required under Rule 28(7) of the Patent Rules, 2003 and the claims filed on 03.06.2019, that Form 1 submitted at IPO on 08.10.2020 along with Petition under Rule 137 be allowed and pending Claim 1 should be accepted as they are well within the purview of Section 57/59.

For Appellant : Mr.Rahul Balaji



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for M/s.De Penning & De Penning

For Respondent : Mr.A.R.Sakthivel
Senior Panel Counsel

J U D G M E N T

This Appeal has been preferred against the rejection of the Patent Application of the appellant in Patent Application No.8850/CHENP/2012 dated 24.12.2020.

2. I have heard Mr.Rahul Balaji, learned Counsel for M/s.De Penning and De Penning and Mr.A.R.Sakthivel, learned Senior Panel Counsel for the respondent/Patent Controller.

3. The short matrix on which the appeal has been preferred is that the order impugned in the present Appeal is a non speaking order and the Controller has not assigned any reasons or offered any explanation for rejection of the Application of the Appellant. Mr.Rahul Balaji, learned counsel for the Appellant would take me through the impugned order to fortify his submissions in this regard.

4. Mr.Rahul Balaji, learned counsel would also submit that the proof of right was also rejected by the respondent/Controller without any



discussion on this aspect. Though the respondent has disallowed the amended claim under Sections 59 & 57 of the Indian Patents Act, 1970, (in short 'Act'), there is no reason assigned for arriving at such a conclusion. Similarly even while arriving at the decision to non suit the appellant on the ground that the claimed invention was obvious under Section 2(1)(ja) of the Act and that persons skilled in the art and combination of prior arts, D1 to D3 were clearly against the appellant, after merely extracting the prior arts, the respondent has come to the conclusion that prior arts would clearly defeat the claim for registration of the claimed invention. The written submissions filed by the appellant have also not been objectively considered by the respondent.

5. Mr.A.R.Sakthivel, learned Senior Panel Counsel appearing for the respondent would submit that the impugned order is a reasoned order and the matter does not require to be remitted.

6. I have considered the rival submissions advanced by the learned counsel on either side.

7. I find that though the respondent has held that the proof of right



cannot be allowed under Sections 57/ 59 of the Act, no reasons are assigned for such decision and consequently amended claims which are factually narrowing down the original claim have also not been considered. Similarly, after discussing the prior arts D1 to D3 and the claims of the appellant, the respondent has concluded that the claimed invention was obvious to a person of ordinary skills in the art. However, there is no discussion as to how the Controller has arrived at such a conclusion/finding. The decision is not supported by any reasons. In view of the above, this matter is required to be re-heard.

8. In fine, this Appeal is allowed and there shall be a *de novo* hearing of the Patent Application of the Appellant by a different Patent Controller and the entire exercise shall be concluded after affording an opportunity to the appellant to make further submission and final orders will be passed within a period of three months. No costs.

23.07.2024

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

To



Controller of Patents and Designs,
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P.B.BALAJI,J.

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