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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **C.A.(COMM.IPD-PAT) 349/2022**

HUCK INTERNATIONAL, INC

..... Appellant

Through: Dr. Satyapal Arora, Mr. Ashish
Sharma, Mr. Kuldeep Singh, AR, Mr.
Jitender Sharma and Mr. Nitin
Sharma, Advocates.

versus

ASSISTANT CONTROLLER OF PATENTS AND DESIGNS

..... Respondent

Through: Mr. Srish Kumar Mishra and Mr.
Alexander Mathai Paikaday,
Advocates.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA

ORDER

10.01.2024

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1. The present appeal under Section 117A of the Patents Act, 1970 impugns order dated 25th September, 2019 [*hereinafter, "impugned order"*], whereby Appellant's divisional application 4777/DELNP/2010 for the invention "Low Swage Load Fastening System and Method" has been rejected for not qualifying the test provided under Section 16 of the Patents Act.

2. At the outset, counsel for Appellant has urged that the impugned order deserves to be set aside as Appellant was denied a fair opportunity to contest the objection under Section 16, which forms the basis for refusal of their application. It is pointed out that the First Examination Report ["FER"]



issued on 13th July, 2017 mentions that the claims of the divisional application were not allowable under Section 16 of Patents Act. A detailed reply was submitted by the Appellant responding to this ground on 09th January, 2018. Thereafter, notice of hearing was issued on 05th June, 2018, which did not cite Section 16 of Patents Act as a bar to the grant of patent. Hence, Appellant's written submissions filed pursuant to the hearing notice, did not deal with the aforesaid objection. However, as can be seen from a perusal of the impugned order, during the hearing, Respondent has proceeded to reject Appellant's application on the basis of an objection contained in the FER, which was not enumerated in the hearing notice.

3. In the opinion of the Court, since the notice of hearing dated 05th June, 2018 [annexed at page No. 191] does not mention an objection under Section 16 of Patents Act, this ground could not have been raised at the stage of final decision, without allowing Appellant an opportunity to advance submissions to overcome the objection. In ***Perkinelmer Health Sciences Inc and Ors. v. Controller of Patents***,¹ while referring to the Circular on Examination of Patent Applications and Consideration of Report of Examiner by Controller,² this Court held that it is incumbent upon the Controller to disclose all objections that remain outstanding after Appellant's response to the FER, in the notice of hearing. It was observed that an applicant must be informed of all the objections prior to a final order, thereby affording sufficient opportunity to contest the same at the time of hearing. As per the counsel, ground of refusal (under Section 16) was not even deliberated upon during the hearing, thus depriving the Appellant of

¹ Order dated 04th January, 2023 in C.A.(COMM.IPD-PAT) 311/2022.

² Circular No. 4/2011 and CG/PG/Circular(Patents)/2011/468.



their right to a fair hearing.

4. For the foregoing reasons, without delving into the merits of the case, petition is allowed and following directions are issued:

4.1 Impugned order dated 25th September, 2019 is set aside.

4.2 Respondent shall, within a period of three weeks from today, issue a fresh notice of hearing to the Appellant, disclosing all outstanding objections. Appellant shall be permitted to file a response thereto within four weeks thereafter.

4.3 Respondent shall, thereafter, conduct a hearing within four months from the date of issuance of notice of hearing.

5. Registry is directed to supply a copy of the present order to the Trade Marks Registry at llc-ipo@gov.in for compliance.

6. Petition is disposed of.

7. It is clarified that the Court has not expressed any opinion on the merits of the case. All rights and contentions of parties are left open.

SANJEEV NARULA, J

JANUARY 10, 2024

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