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C.M.A.(PT) No.43 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on	19.08.2025
Pronounced on	18.11.2025

CORAM:

THE HONOURABLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY**C.M.A.(PT) No. 43 of 2023 & CMP No. 17701 of 2025 in****C.M.A. (PT) No.43 of 2023**

M/s.HI TECH CHEMICALS LIMITED
 Represented by its Authorized Representative
 Rajkumar Agarwal
 White House, 119,
 Park Street, 4th Floor 'D',
 Kolkatta - 700 016.

... Appellant

Vs.

1. Deputy Controller of Patents and Designs,
 Intellectual Property Office,
 Intellectual Property Office Building,
 G.S.T.Road, Guindy, Chennai - 600 032.

2. M/s.Allied Metallurgical Products Private Limited,
 201/3 12th Main, 3rd Phase,
 Peenya Industrial Area,
 Bangalore, India - 560 058.

... Respondents



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Prayer : Appeal filed under Section 117A of Patent's Act to issue:

a. An order setting aside and quashing the impugned order dated 05.07.2023 passed by Respondent No. 1 in PATENTA.NO.382/CHE/2012;

b. An order remanding the Appellant's Post Grant Opposition to Respondent No. 1 for consideration thereof *de novo* after taking into account the documents filed by the Appellant on 26.02.2020 [documents filed with the Post Grant Opposition) and 30.01.2023 [Document Set (I) and Document Set (II)) ;

c. An order allowing the Petition filed by the Appellant before the Respondent No. 1 on 21.02.2023 and staying the proceedings in the Post Grant Opposition before Respondent No. 1 during the pendency of the counter claim for invalidity of Patent No. 311984 pending before the Hon'ble Karnataka High Court;

d. An order directing Respondent No. 1 to pass a reasoned order upon reconsideration of the Post Grant Opposition *de novo* in terms of prayer (b) above, subject to the judgment of the Hon'ble Karnataka High Court in the counter claim for invalidity of Patent No. 311984;



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e. Costs of the present proceedings in favour of the Appellant; and

f. Such further or other order or orders as to this Hon'ble Court may deem fit and proper.

For Appellant : Mr.Adarsh Ramanujan
Ms.Madhupreetha Elango
Ms.Priscilla Carolyn

For R1 : Mr. J. Madhanagopal Rao, SPC

For R2 : Mr.Pramod Nair
Senior Advocate
instructed by
Mr.R.Palaniandavan
Ms.Anjanaa Aravindan
Mr.Hrishikesh Diwakar

CMP No.17701 of 2025

M/s.Allied Metallurgical Products Private Limited,
201/3 12th Main, 3rd Phase,
Peenya Industrial Area,
Bangalore, India - 560 058.

.... Petitioner

Vs.

1. M/s.HI TECH CHEMICALS LIMITED
Represented by its Authorized Representative



C.M.A.(PT) No.43 of 2023

Rajkumar Agarwal
White House, 119,
Park Street, 4th Floor 'D',
Kolkata - 700 016.

2. Deputy Controller of Patents and Designs,
Intellectual Property Office,
Intellectual Property Office Building,
G.S.T.Road, Guindy, Chennai - 600 032.

... Respondents

Prayer : Petition filed under Section 151 of the Code of Civil Procedure to recall the order dated 15.12.2023 in CMP No.28520 of 2023 in CMA (PT) SR. No.152263 of 2023 (now renumbered as CMA (PT) No.43 of 2023 passed by this Hon'ble Court condoning the delay in filing the appeal.

For Petitioner

: Mr.Pramod Nair
Senior Advocate
instructed by
Mr.R.Palaniandavan
Ms.Anjanaa Aravindan
Mr.Hrishikesh Diwakar

For R1

: Mr.Adarsh Ramanujan
Ms.Madhupreetha Elango
Ms.Priscilla Carolyn

For R2

: Mr. J. Madhanagopal Rao, SPC



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COMMON JUDGMENT AND ORDER

A patent was granted to Allied Metallurgical Products Private Limited (patentee or the second respondent) on 30.04.2019 in respect of an invention titled “Anti-stick Coating for Slag Pots” by allowing Patent Application No.382/CHE/2012 on 30.04.2019. The provisional specification was filed along with the application on 01.02.2012, which is the priority date. The complete specification was filed later on 31.11.2013. Hi Tech Chemicals Private Limited (the appellant or Hi Tech Chemicals) filed a post-grant opposition under Section 25(2) of the Patents Act, 1970 ('the Patents Act'). The said post-grant opposition was rejected by order dated 05.07.2023, which is impugned in the appeal.

2. Mr. Adarsh Ramanujan, learned counsel, assisted by Madhupreetha Elango, learned counsel, made oral submissions on behalf of the appellant. The first respondent was represented by Mr. Madhanagopal Rao, learned SPC. Mr. Pramod Nair, learned senior counsel, assisted by Mr. Palaniandavan and Ms. Anjana Aravindan, learned counsel, made oral



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submissions on behalf of the patentee. Both the appellant and the patentee also filed written submissions.

3. Because there was a delay in filing the appeal, the intending appellant filed CMP/28520/2023 to condone the delay of 51 days in filing the appeal. The said petition was allowed by order dated 15.12.2023 and the Registry was directed to number the appeal. Upon receiving notice in the appeal, the patentee opposed the appeal. In course of final arguments, the patentee filed CMP No.17701 of 2025 to recall the order condoning appeal. Both the appeal and the miscellaneous petition to recall the order are being disposed of by this common judgment and order.

Petition to recall order condoning delay

4. I deal with the petition to recall the order first. In the affidavit in support of the recall petition, the patentee stated that notice had not been issued to the patentee in the petition to condone delay. This contention is correct and, therefore, the patentee was permitted to file the recall petition



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although such petition was filed belatedly at the stage of final arguments in the appeal.

5. In addition to non-receipt of notice, learned senior counsel for the patentee contended that the appellant had deliberately and fraudulently misrepresented that the name change procedure resulted in delay in filing the appeal. By pointing out that the name change was effected on 01.02.2022, whereas the appeal was filed only on 23.11.2023, it was contended that delay was condoned on the basis of a deliberate misrepresentation by the appellant. It was also contended by learned senior counsel that sufficient cause had not been shown by the appellant and that delay should not be condoned in the absence of an acceptable explanation merely on the basis that the length of delay is only 51 days. Apart from the above contentions, learned senior counsel also highlighted variations in the email signatures and font to cast doubts on the authenticity of emails filed in response to the recall petition.



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6. In response, the appellant placed on record the email correspondence between the counsel on record for the appellant and the appellant. The emails filed by the appellant include an email of 11.09.2023 from Sayanika De, Senior Legal Associate of L.S.Davar and Co, attaching the memorandum of appeal and related papers. Reply dated 27.09.2023 from the appellant to counsel attaching the affidavit and vakalatnama and stating that a hardcopy is being sent to the office is also on record. A later email dated 05.10.2023 issued by Debolina Karmakar of the appellant to counsel stating that the name of the company is "Hi Tech Chemicals Limited" and not "Hi Tech Chemicals Private Limited" was also filed.

7. On considering the emails, it follows that the appeal and related papers were originally prepared in the original name of the entity and later in the changed name in November, 2023. These documents are accompanied by affidavit dated 14.08.2025 from the partner of the law firm representing the appellant. He has provided an explanation for the discrepancies pointed out by learned senior counsel for the patentee with regard to the use of the full signature of the law firm in some emails, but not



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in all emails. The Senior Systems Engineer of the counsel on record, Mr.Hrishikesh Karmakar, has filed an affidavit affirming that the emails filed by the appellant were downloaded from the server. He has also provided details of the office desktop from which the electronic records were generated.

8. By relying on the aforesaid, Mr.Adarsh Ramanujan, learned counsel for the appellant, submitted that the error in the name of the appellant in the original appeal papers resulted in the delay and that this was stated in the affidavit in support of the miscellaneous petition to condone delay. Upon examining the above mentioned documents, while the affidavit in support of the petition to condone delay was lacking in particulars, I am fully satisfied that no deliberate or fraudulent misstatement was made. I am also satisfied that the explanation qualifies as sufficient cause. Therefore, I find no reason to recall the order condoning the delay of 51 days in filing the appeal. Consequently, by dismissing CMP No. 17701 of 2025, I turn to the merits of the case.



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The Merits

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9. Learned counsel for the appellant raised multiple grounds to contend that the impugned order cannot be sustained. His first contention was that a civil suit was filed before the Bellary District Court by the patentee for infringement of patent and that one of the defendants therein raised a counter-claim challenging the validity of the patent. Therefore, the suit was transferred to the Karnataka High Court and is pending adjudication. Although the appellant contended before the Controller that he should await the decision of the Karnataka High Court, learned counsel contended that the objection was recorded at paragraph 6 of the impugned order, but no finding was recorded thereon.

10. By relying on the judgment of the Supreme Court in *Aloys Wobben and another v. Yogesh Mehra and others*, (2014) 15 SCC 360 (*Aloys Wobben*), particularly paragraphs 24 and 25 thereof, learned counsel contended that the principle laid down therein was that parallel proceedings challenging the same patent should not be entertained. Therefore, he contended that said principle should be extended to the present case



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inasmuch as the validity of the patent was in issue both before the Controller and the Karnataka High Court. In those circumstances, he submitted that the Controller should have stayed his hand and awaited the verdict of the Karnataka High Court so as to have the benefit of the order of the superior court - especially a court adopting a trial, as opposed to summary, procedure - and avoid inconsistent decisions. He also relied on the judgment of the Supreme Court in *State of H.P and others v. Surinder Singh Banolta*, (2006) 12 SCC 484, particularly paragraph 18, in support of this proposition.

11. The next contention advanced by him was that the additional documents filed by the appellant and labelled as “further evidence A” and “further evidence B” were not considered. Dealing first with “further evidence B”, he submitted that this refers to pleadings before the trial court in the infringement suit. By relying on Section 74 of the Indian Evidence Act, 1872 (the Evidence Act), learned counsel contended that these are public, and not private, documents. By relying on the judgment of the Queens Bench Division in *Briston-Myers Company's Application*, (1969



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R.P.C.146) (Bristol Myers), he submitted that a communication to a single member of the public is a publication provided that the recipient is not fettered from disseminating the information or document. Likewise, he contended that the expression “publication” in Rule 62(4) of the Patents Rules, 2003 (the Patents Rules) applies to the invoices and court documents under Rule 62(4) of the Patents Rules.

12. As regards the documents labelled as “further evidence A”, he submitted that this includes invoices, consignment notes, permits issued by the Commercial Taxes Department and test certificates. After submitting that Rule 62(4) should be construed in the context of the statute, he pointed out that Section 25(2)(d) and 25(2)(e) enable a challenge on the grounds of lack of novelty and inventive step, respectively, *inter alia*, if the invention was publicly used in India, implying that secret documents or secret use cannot be considered. According to him, the expression “publication” should be understood from that frame of reference as excluding only private or secret documents. On account of non-consideration of statutory context,



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he urged this Court to depart from the principle laid down in the judgment of the Delhi High Court in *Pharmacyclics LLC v. Union of India*, order dated 20.11.2019 in W.P.(C) 12105 of 2019 (*Pharmacyclics*). He also pointed out that the additional documents were filed on 30.01.2023 and that the hearings were held on 21.02.2023 and 20.03.2023. Therefore, he submitted that the second respondent had more than five days to examine the documents and make submissions thereon.

13. The next contention was that the grant was liable to be revoked on the ground of sale by the patentee even before the priority date. In support of this contention, he relied upon the statement by the patentee's customer on 23.01.2015 at page 259 of Volume – II to the effect that the second respondent had been supplying Slag Pot Coating Material (SLAG KOTE) for the past four years. Learned counsel contended that the certificate was issued on 23.01.2015 and, if the supply period of the previous four years were to be calculated, the supply would have commenced from 24.01.2011, which is earlier than the priority date of 01.02.2012. He also relied upon the post hearing written submissions in



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support of this contention. On this issue also, he contended that no finding was recorded.

14. By referring to prior arts D6 and D7, Mr.Adarsh Ramanujan next contended that the patent lacks an inventive step. He pointed out that both these prior arts deal with anti-slag coating. In spite of citing these prior arts, learned counsel contended that these prior arts were rejected in paragraph 27 of the impugned order as irrelevant. In reaching the said conclusion, he submitted that it was erroneously recorded that the said prior arts deal with an anti-adherent slag pigment. He also attacked the conclusion in the impugned order that the composition claim is not hit by Section 3(e) of the Patents Act. He pointed out that no evidence of synergy was provided by the patentee. He concluded his submissions by also contending that the grant was liable to be revoked for insufficiency by relying on paragraphs 49 to 51 of the post hearing written submissions.

15. In response, Mr.Pramod Nair contended that the patent infringement suit was filed two years after the post-grant opposition, and



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that the counter-claim in the said suit challenging the validity of the patent was made by a different defendant and not by the appellant. On account of the proceedings before the Controller being earlier in point of time as also because it is a specialist forum, he submitted that the Controller did not commit any error in proceeding with the post- grant opposition. By referring to *Aloys Wobben*, he submitted that the principle laid down therein was that the same individual should not avail of the remedies of a post-grant opposition and revocation. According to him, the said principle is completely inapplicable in the present context.

16. As regards the additional documents filed by the appellant before the Controller, he pointed out that Rules 55 to 62 of the Patents Rules govern the admissibility of additional documents. He submitted that the Rules do not permit any additional documents to be filed after the hearing notice is issued. In this case, he submitted that the hearing notice was issued on 11.10.2022, whereas the additional documents were filed on 30.01.2023 without the prescribed 5 day notice. He contended that these documents, i.e. “further evidence A” and “further evidence B”, do not qualify as



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publications as per Rule 62(4). With specific reference to the invoices and consignment notes, Mr.Pramod Nair contended that they are documents issued by a seller/supplier to a buyer and not documents made available to the public. Likewise, learned senior counsel submitted that the test reports are private documents. As regards the court orders and pleadings, by referring to Ex.P.34, he pointed out that even the relevance of the volume of documents was not stated in the application for permission to rely on those documents.

17. On the merits, learned senior counsel contended that the prior art documents (D1-D10) were available with the appellant when the opposition was lodged but were uploaded after the final hearing date was fixed. Without prejudice, he relied on a note to differentiate the claimed invention from cited prior art documents. As regards the alleged non-consideration of the affidavits of Mr. Ranjit Kumar Bagchi and Mr. Raj Kumar Agarwal, he submitted that these affidavits were considered by the Opposition Board and that the opposition proceedings should be viewed in totality.



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Discussion, analysis and conclusions on the merits

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18. The first ground on which the appellant assailed the order was the refusal of the Controller to suspend proceedings until conclusion of the suit. The Patents Act provides for the filing of a pre-grant opposition by any person and a post-grant opposition by a person interested provided the same is filed within one year from the date of grant of patent. Upon filing of a post-grant opposition, the manner in which such post-grant opposition should be dealt with is specified in the Patents Act read with the Patents Rules. In effect, a statutory duty has been imposed on the Controller to consider and dispose of the post-grant opposition in the manner prescribed. In the absence of an order staying the proceedings before the Controller, the Controller was required by statute to discharge his functions by proceeding with and concluding proceedings.

19. As contended by learned senior counsel for the second respondent, the principle laid down in *Aloys Wobben* is that a specific opponent cannot avail of more than one forum to challenge the grant of patent and seek the revocation thereof. Therefore, the opponent concerned



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should opt to either file a post-grant opposition or lodge a revocation petition before the jurisdictional High Court. In the case at hand, the counter-claim seeking a declaration that the patent is not valid was admittedly not made by the appellant herein. Given that the statute confers the right on every intending opponent to choose between these options and the appellant herein chose to file a post-grant opposition before the Controller, the principle laid down in *Aloys Wobben* cannot be extended to impose a fetter on the performance of the statutory obligation by the Controller of deciding the post-grant opposition. Although I do not accept the contention of learned senior counsel for the second respondent that the exercise of jurisdiction by the High Court in deciding on a challenge to the patent (either under or by applying the grounds under Section 64) is subject to the exercise of the power of the Controller under Section 25(2), I reject this ground of challenge on the ground that the *Aloys Wobben* principle cannot be extended to shackle the Controller in this context.

20. The next ground of challenge that I propose to deal with relates to the lack of novelty and inventive step. The contention with regard to lack of



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novelty was raised by the appellant by relying on letter dated 23.01.2015 from JSW Steel. In the said letter, JSW Steel stated as under:

"This is to certify that an Allied Metallurgical Product Private Limited, Bangalore, is a regular supplier of Slag Pot Coating Material (SLAG KOTE) for past four years at J.S.W.Steel, Toranagallu Plant (10 Million Tons Steel Complex) "

By working backwards from the date of such letter over the previous four years, it was contended that the said letter establishes that the second respondent had commenced commercial sale on or before 23.01.2011, which is before the priority date, i.e. 01.02.2012. The appellant also contended that no finding was returned on this contention.

21. Learned senior counsel for the second respondent countered this contention by stating that the letter from JSW Steel does not prove prior commercial sale of the product for which patent was granted to the second respondent. In other words, it was contended that there is nothing in the said communication that would enable a person to conclude that it is a reference to the same product. The appellant responded to this contention by stating



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that the product sold by the second respondent is called SLAG KOTE. The letter mentioned that SLAG KOTE had been sold for the past four years by the second respondent to JSW Steel at its Toranagallu Plant. In those circumstances, it was contended that the burden of proof is on the second respondent to demonstrate that the composition is different.

22. Merely on the basis of this letter, it cannot be concluded that the second respondent had commercially sold the product forming the subject of the patent before the priority date. Many factual details are unclear: for instance, was the expression “past four years” used loosely or accurately? Was it a reference to the same product? In the absence of further evidence in relation to such sale, such as by way of purchase orders, specifications, invoices or delivery challans, a rational conclusion cannot be drawn. Nonetheless, as contended by learned counsel for the appellant, a finding should have been rendered on this issue by the Controller. On perusal of the impugned order, I accept the contention of learned counsel for the appellant that no finding was rendered. Because this is an important issue pertaining to alleged lack of novelty, reconsideration is warranted.



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23. Learned counsel for the appellant also contended that prior commercialization of the product forming the subject of the patent is established by the affidavit of Mr.Raj Kumar Agarwal, Director of the appellant (Volume 3 at pages 377 to 383), and the affidavit of Mr.Ranjit Kumar Bagchi, the Inventor (Volume 3 at pages 371 to 376). On perusal of the impugned order, I find no reference to these affidavits in the findings of the Controller.

24. As regards lack of inventive step, the appellant relied strongly on prior art documents D6 to D10. These documents were admittedly filed along with the post-grant opposition. Learned counsel for the appellant contended that these documents were rejected on the ground that they are not relevant. Learned counsel contended that D6 to D8 are patents relating to anti-slag coating. He also pointed out that D10 is a patent directed at an anti-stick slag spraying. In response, learned senior counsel for the second respondent referred to the post-hearing written submissions of the second respondent in Volume 8 at pages 1817 to 1823 (paragraph nos. 56 to 64).



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25. In order to determine whether the contentions of the appellant on this issue are liable to be accepted, it is necessary to closely consider the findings in the impugned order. At paragraph 27, after discussing prior art documents D1 to D5, the impugned order dealt with prior art documents D6 to D10 as follows:

"D6 relates to an anti-adherent slag pigment and totally different from impugned patent. D7 an unformed sticky slag-proof flame-resistant material used in steel making that can be sprayed on parts with heavy slags, such as the water-cooling furnace cover of a LF furnace, the fume hood of a converter, a steel ladle, steel slag pot, etc., the flame-resistant material as a coating can avoid the damage on equipment in the course of slag cleaning, thus perfectly protecting the equipment, lowering production cost and increasing the production efficiency of the equipment. D8-D10 disclosed entirely different from the present invention. Most of the prior art documents relied upon by the opponent are paint compositions Thus subject matter of D1-D10 neither individually nor jointly disclosed the subject matter of the present invention.



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Even if the test guarantee certificate is considered the range of SiO₂ 55-60%, Carbon 40-50% and binder 7-13% of the impugned patent is not overlapping with the details in the said certificate for SiO₂ 55.5%, Carbon 40.3% and binder 7.6%. The prior art documents cited by the opponent are irrelevant and not related to the present invention. Therefore the opposition filed under section 25(2)(e) of the Patents Act is not valid."

26. As is noticeable from the extract, after recording that D6 relates to an anti-adhesive slag pigment, a conclusion is recorded that it is totally different from the impugned patent. No reasons are mentioned as to why it is different from the impugned patent. The nature of D7 is set out and the benefits of D7 are also set out. The reason why D7 would not render the claimed invention obvious is not stated in the impugned order. D8 to D10 are brushed aside in a single sentence by stating that "D8 - D10 disclosed entirely different from the present invention". Thus, the quality of obviousness analysis leaves much to be desired. Given that inventive step determination is at the heart of the present challenge to the patent, a case is made out to interfere with the impugned order on this ground. I, however,



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clarify that no opinion is being expressed on the merits of the challenge on this ground. Therefore, I have not discussed the differentiating note submitted on behalf of the second respondent.

27. The impugned order was also challenged on the ground that documents filed by the appellant and labelled as “further evidence A” and “further evidence B” were not taken into consideration. “Further evidence A” consists of tax invoices, consignment notes, permits issued by the State Commercial Tax Department and test certificates on the composition of slag pot coating commercialised by the appellant before the priority date of the impugned invention. In the impugned order, such further evidence was rejected on the ground that it had been submitted in contravention of the Patents Rules. Such conclusion was drawn by relying on the judgment of the Delhi High Court in *Pharmacyclics*. Learned counsel for the appellant contended that the Patents Rules should be interpreted in the context of the statute. By referring to Section 25(5) of the Patents Act, learned counsel submitted that personal documents are not permitted to be relied upon in opposition proceedings. According to him, the expression 'publication' in



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Rule 62(4) should be understood in the context of Section 25(5) as relating to a personal document. He also relied upon the judgment in *Bristol-Myers* to contend that any document or product which is made available to any member of the public without imposing any restrictions or fetters on the said person is a publication. Applying the said principle, learned counsel contended that the tax invoices, consignment notes and the like would qualify as publications.

28. On the contrary, learned senior counsel for the second respondent contended that publications should be confined to documents that are made available to the public. While the Patents Act does not define the word 'publication', the said word is defined in the Copyright Act, 1957 (the Copyright Act) in Section 3 as “making available to the public by issue of copies or by communicating the work to the public”. Section 3, like typical definitions in statutes, defines the expression “publication” for the purposes of the Copyright Act. Nonetheless, at a minimum, it provides a cue to the sense in which the word is ordinarily used. Whether the context supports a departure calls for consideration next.



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29. The procedure relating to opposition proceedings is contained in Chapter VI of the Patents Rules. Rule 55A enables the opponent to file a post-grant opposition. The opponent is permitted to file a written statement of opposition and evidence in support thereof under Rule 57. Rule 58 enables the patentee to file a reply statement and evidence. Within one month of the receipt of such reply statement and evidence under Rule 58, the opponent is permitted to file reply evidence under Rule 59. Once reply evidence has been filed under Rule 59, no further evidence is permitted to be adduced by either party, except with the leave or directions of the Controller under Rule 60. Rule 60 is as follows:

"60. Further evidence to be left with the leave of the Controller.—No further evidence shall be delivered by either party except with the leave or directions of the Controller:

Provided that such leave or direction is prayed before the Controller has fixed the hearing under rule 62."

30. The proviso to Rule 60 makes it clear that any request for leave or direction under Rule 60 should be made before the Controller fixes the



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hearing under Rule 62. Rule 62 deals with the hearing. Sub-rule (1) of Rule 62 envisages that the hearing would take place on a date fixed by the Controller upon the completion of the presentation of evidence and on receiving the recommendation of the opposition. Sub-rule (4) thereof enables either party to the proceeding to provide not less than five days' notice of his intention to rely on any publication at the hearing not already mentioned in the notice, statement or evidence. Sub-rules (1) and (4) of Rule 62 are as follows:

"62. Hearing.—(1) On the completion of the presentation of evidence, if any, and on receiving the recommendation of Opposition Board or at such other time as the Controller may think fit, he shall fix a date and time for the hearing of the opposition and shall give the parties not less than ten days' notice of such hearing and may require members of Opposition Board to be present in the hearing.

...

(4) If either party intends to rely on any publication at the hearing not already mentioned in the notice, statement or evidence, he shall give to the other party and to the Controller not



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less than five days' notice of his intention, together with details of such publication."

(emphasis added)

31. From the above Rules, the conclusion that emerges is that evidence is permitted to be adduced in terms of Rules 57 to 59. Thereafter, further evidence cannot be adduced except with the leave or direction of the Controller under Rule 60. The proviso to Rule 60 does not permit an application for such leave after the Controller fixes the hearing under Rule 62. Rule 62 comes into play on the completion of presentation of evidence. At that juncture, once the Controller has fixed the hearing, if either party intends to rely on a publication, which is not mentioned in the notice, statement or evidence, such party is required to provide not less than five days' notice of the intention to rely on such publication along with details thereof.

32. The statutory intent not to permit parties to adduce further evidence, even with the leave of the Controller, after the hearing has been fixed, is clear from Rules 57 to 60. Therefore, the expression 'publication' in



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Rule 62(4) cannot be equated with evidence. As briefly discussed earlier, the said word has not been defined in the Patents Act or the Patents Rules.

The definition in the Copyright Act refers to documents made available to the public by communication. In my view, the statutory context supports limiting the expression “publication” in Rule 62(4) to documents that are accessible to the public by virtue of being made available. Undoubtedly, the expression 'documents made available to the public' would include patent literature published by the patent office concerned. It would also include non-patent literature provided such literature has been published in on-line or physical journals to which the public has access.

33. The documents filed as “further evidence A” includes invoices, consignment notes and the like. Both invoices and consignment notes are documents issued by the seller to the buyer. A permit issued by the State Commercial Tax Department is issued to a particular person. Test certificates also fall in the same category. None of these documents may be construed as 'documents made available to the public'. Learned counsel for the appellant contended that this provision should only apply to private



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documents and that all other documents will qualify as publications. I am unable to countenance such contention. If construed in this manner, the procedure prescribed in Rules 57 to 60 would be rendered *otiose*.

34. I turn next to “further evidence B”. “Further evidence B” relates to court orders, pleadings and counter statements. All these documents relate to the patent infringement suit (COM OS 4 of 2022). By relying on Section 74 of the Evidence Act, learned counsel for the appellant contended that court records qualify as public documents. Section 74 deals with acts of the sovereign, including acts of the judiciary. It also covers a public record of private documents. Thus, all the documents forming part of “further evidence B” (Volume 7) would qualify as public documents. Any party to the relevant litigation has direct and unfettered access to such public documents. As regards non-parties, it becomes necessary to obtain leave of the court and, thereafter, apply for certified copies thereof. In my view, such public documents, which are not readily accessible by the public, do not fall within the scope of the expression “publication” in Rule 62(4). As discussed earlier, the said provision is intended to enable a party to rely upon



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documents that are publicly accessible, even though such documents were not part of the evidence adduced earlier.

. 35. Notwithstanding the above observations on these additional documents, in view of the conclusions recorded earlier on the findings of the Controller on lack of novelty and inventive step and the consequential remand, the respondent is now required to issue a fresh hearing notice. All these documents were uploaded by the appellant on 30.01.2023. Therefore, the first respondent is directed to reconsider the request to rely on these additional documents as a request for leave under Rule 60 of the Patents Rules. While reaching this conclusion, I accept the contention of learned counsel for the appellant that Rule 60 of the Patents Rules envisages the consideration of evidence by the Controller even if the Opposition Board has not had the benefit of examining such evidence.

36. The appellant also assailed the order on the lack of any evidence of synergy. This contention was raised by relying on Section 3(e) of the Patents Act. Section 3(e) is as follows:



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"(e) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance."

The patent was admittedly granted in respect of a composition. Therefore, Section 3(e) is relevant. The appellant herein raised an objection on the ground of lack of synergy. This is noticeable from the post-grant written submissions of the appellant, particularly at pages 1741 to 1743 of Volume 8.

37. On examining the impugned order, I find that the said objection has been dealt with merely by recording that the anti-sticking coating composition is suitable for all of the plant operation conditions and remains in rheophytic conditions for six months. The basis for recording the above conclusion is not discernible from the complete specification or the order. Given the settled legal position that synergy between the ingredients is necessary to overcome the objection under section 3(e), the matter warrants reconsideration on this ground also.



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38. In order to enable reconsideration of the post-grant opposition primarily on the ground of failure to record findings on, or provide reasons for rejection of, material grounds of opposition, I intend to set aside the impugned order. I hasten to add, however, that I have not expressed any opinion on the merits of the grant or indeed on the merits of the post-grant opposition. The patent was granted on 30.04.2019. Given the basis for interference, the interest of justice warrants that the grant not be interfered with at this juncture, albeit subject to the qualification that it will abide by the outcome of the remanded proceeding.

39. For reasons stated above, the recall petition and appeal are disposed of as under:

(i) CMP No. 17701 of 2025 is dismissed without any order as to costs.

(ii) Order dated 05.07.2023 of the first respondent is set aside. As a corollary, the matter is remanded for reconsideration subject to the observations in this order and on the terms set out below.



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(iii) In order to preclude the possibility of predetermination, an Officer other than the officer who issued the impugned order shall undertake reconsideration.

(iv) After providing a reasonable opportunity to the appellant and the second respondent, a speaking order shall be issued within four months from the date of receipt of a copy of this order.

(v) For the avoidance of doubt, it is clarified that no opinion has been expressed on the merits of the post-grant opposition.

(vi) Notwithstanding the impugned order being set aside, therefore, the patent continues to be valid but would abide by the outcome of the remanded proceedings.

18.11.2025

Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No

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SENTHILKUMAR RAMAMOORTHY J.

PKN

Pre-delivery judgment made in
C.M.A.(PT) No.43 of 2023

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