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(T)CMA(PT)No.121 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated : 25.06.2024

CORAM:

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

(T)CMA(PT)No.121 of 2023

Rhodia Operations
40, rue de la Haie Coq
F-93300 Aubervilliers
France, Nationality:French

.... Appellant

VS

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

.... Respondent

Appeal filed under Section 1170A of the Patents Act, 1970 against the order passed by the Controller of Patents and Designs dated 15.06.2018 in Indian Patent Application No.458/CHENP/2012.

For Appellant : Mr.Shivathanu Mohan
For M/s De Penning and De Penning

For Respondent : Mr.K.Subbu Ranga Bharathi
SPCGSC



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JUDGMENT

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This appeal has been preferred challenging the refusal for grant of Patent in Patent Application No.458/CHENP/2012.

2. I have heard Mr.Shivathanu Mohan, learned counsel for the appellant and Mr.K.Subbu Ranga Bharathi, learned Senior Panel Central Government Standing Counsel for the respondent.

3. The appellant filed an Application on 12.01.2012. The claim of the appellant is in respect of a composition comprising Cerium Oxide and Zirconium Oxide having a specific porosity, preparation method thereof and use of same in catalysis.

4. Learned counsel for the appellant would submit that the patent application was rejected on two grounds viz., under section 2(1)(j) of the Patents Act citing lack of inventive steps and under section 3(e) of the Act stating that the substance was obtained by mere admixture alone.

5. In this regard, the learned counsel for the appellant would take me



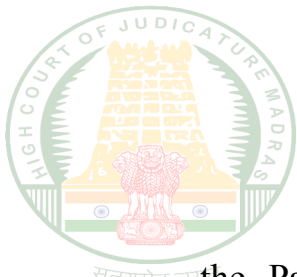
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through the impugned order of the respondent and contend as follows:-

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(i) In respect of lack of inventive steps, he would submit that two prior arts viz., D.1 and D.2 were cited. Subsequently, after the notice of hearing, D.3 and D.4 were added. The appellant filed his written submissions on 02.02.2018. It is the specific contention of Mr.Shivathanu Mohan, learned counsel for the appellant that the crucial inventive claim by the appellant was the formation of a double population and in none of the prior arts D.1 to D.4 there is any such double population achieved and therefore, without any reference, whatsoever to the claim of the appellant, the prior arts D.1 to D.4 have been merely put against the appellant on the ground of lack of inventive steps and the application has been rejected. He would therefore submit that the matter may have to be remitted to the respondent for fresh consideration.

(ii) With regard to Section 3(e), learned counsel Mr.Shivathanu Mohan would state that originally at the time of First Examination Report, an objection was raised that the claims attract provision of Section 3(e) of



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the Patents Act as it seeks to be a composition containing a mere admixture and no synergistic effect has been shown in the complete specification, through comparative data.

6. In this regard, learned counsel for the appellant would invite my attention to the original claim and also the reply to the First Examination Report/written submission of the appellant. Subsequently, at the time of hearing notices, this objection of synergistic effect was virtually given up and not considered. The respondent has held that the claims do not meet the requirements under Section 3(e) of the Patent Act, 1970 and hence non-patentable since the catalytic composition is a composition containing mere admixture of known substances disclosed in documents D1-D4. Therefore, the issue of synergistic effect was not even gone into by the respondent at the time of hearing. However, while passing the impugned order, the respondent cites lack of proof of synergistic effect against the appellant. Therefore, the procedure adopted by the respondent is clearly one taking the appellant by surprise by referring to synergistic effect being put against the appellant in order to deny the patent as claimed by the



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appellant.
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7. Learned Senior Panel Central Government Standing Counsel Mr.K.Subbu Ranga Bharathi, appearing for the respondent would submit that the order is a speaking order and valid reasons have been assigned for refusing the patent application and the same does not require any interference.

8. I have carefully considered the rival submissions advanced on either side.

9. As rightly pointed out by the learned counsel for the appellant, though the respondent has disallowed the patent application on two grounds viz., lack of inventive step and the component being a mere admixture as set out under Section 3(e) of the Patents Act, 1970, I find that in order to deny the patent, the respondent has not referred to the highlight of the invention claimed by the appellant, which is achieving a double population containing two sets of pores – large and small, which



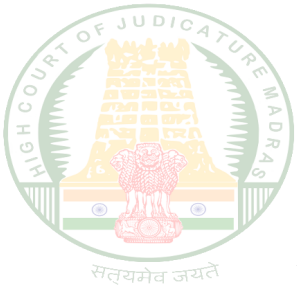
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has not even been considered by the respondent, though it will have a crucial bearing on inventive steps claimed by the appellant.

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10. Even with regard to Section 3(e) of the Act, the Controller does not even discuss or examine what are all the chemicals that are used to form the mere admixture. Moreover, as rightly pointed out by the learned counsel for the appellant when the synergistic effect issue has been virtually given up at the time of hearing, the respondent ought not to have put the same against the appellant and thereby deprived the appellant of a fair opportunity to explain or put forth his argument with regard to such objection.

11. Therefore, on both these grounds, I deem it a fit case for being remitted to the respondent for fresh consideration of the Patent Application No.458/CHENP/2012, within a period of four months. To avoid embarrassment for both the appellant and the respondent, a different Patent Controller shall take up the application.



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12. In the result, the appeal is allowed and the matter is remitted to the respondent for fresh consideration of the Patent Application No.458/CHENP/2012 and a different Controller of Patents and Designs shall be assigned for deciding the same. Such exercise shall be completed within a period of four months from the date of receipt of a copy of this order, after affording a fair opportunity to the appellant to canvass all his submissions. No costs.

25.06.2024

Index:yes/No
Speaking Order/Non-Speaking Order
sr

To

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

P.B.BALAJI,J.,

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