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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 12.08.2025

CORAM:

THE HONOURABLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA (PT) No.171 of 2023
(SR.No.110/2018/PT/CHN)

Natural Medicine Institute of Zhejiang
Yangshengtang Co. Ltd.
Through its Authorized Representatives
148 Shuguang Road Hangzhou Zhejiang 310 007
China .. Appellant

Vs.

1. The Deputy Controller of Patents and Designs
   The Patent Office
   Intellectual Property Building
   Plot No.32, Sector 14, Dwarka,
   New Delhi-110 075.

2. The Controller of Patents
   The Patent Office
   IPR Building, SIDCO Plot, GST Road,
   Guindy,
   Chennai-600 032. .. Respondents

Prayer : Civil Miscellaneous Appeal (Patent) file under Section 117-A of the Patents Act, 1970 (39 of 1970) and the Patents Rules, 2003 for as

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amended by the Tribunals Reforms Act, 2021) praying to (i) allow the present Appeal and set aside/quash the impugned order dated December 14, 2017 passed by the Respondent in Indian Patent Application No.6275/CHENP/2011; (ii) allow the Appellant an opportunity to amend the claims for allowability; and (iii) direct grant of patent in respect of said Indian Patent Application No.3275/CHENP/2011.

For Appellant : Mr.Shatadal Ghosh
Mr.K.Muthu Selvam for
M/s.K and S Partners

For Respondents : Ms.R.Durgarani, CGSC

JUDGMENT

This appeal is directed against order dated 14.12.2017 rejecting patent application No.6275/CHENP/2011 for grant of patent for a claimed invention titled "A MORDANT AND HAIR COLORING PRODUCTS CONTAINING THE SAME".

2. In response to the above mentioned application, the respondent issued the First Examination Report (FER) on 18.11.2016 raising objections *inter alia* on grounds of lack of novelty and lack of inventive step.

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3. The appellant filed a reply along with the first revised set of claims. This was followed by hearing notice dated 26.07.2017 retaining objections with regard to lack of novelty and inventive step. Shortly after the hearing on 05.10.2017, emails (including an email attaching further amended sets of claims) were exchanged between the applicant's agent and the respondent. Written submissions were also filed by the appellant and the order impugned herein was issued thereafter.

4. Learned counsel for the appellant invited my attention to the complete specification, FER, reply thereto, the written submissions and Form–3 and thereafter made the following submissions:

(i) As attachments to email of 06.10.2017, the agent of the appellant sent two sets of claim amendments. Claim set – A contains 6 claims which match claims 1 to 6 of the rejected claims. Claim set B contains 12 claims which match claims 7 to 13 of the rejected claims. By email of 09.10.2017, the respondent accepted both sets of claim

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amendments by stating "Ok file". Upon receipt of such email, the appellant's agent sent a further email on 10.10.2017 stating that they understand that both the claim sets are ok and that the amended claims would be filed after the applicant provides instructions.

(ii) The claimed invention was granted a patent in multiple jurisdictions such as China, USA, South Korea, Brazil, Malaysia and Japan. After the impugned order was issued, the European Patent Office (EPO) also granted a patent in respect of substantially the same claims as those rejected herein.

(iii) The impugned order does not contain any reasons for rejecting the amended claims of the appellant.

(iv) The counter affidavit is based on either the FER or the hearing notice and does not deal with the rejected claims.

5. In response, learned counsel for the respondent submits that the amended claims were rejected because they travelled beyond the scope of the complete specification, including the claims as originally filed.

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6. In the impugned order, after setting out the points discussed during the hearing, the operative portion is as under:

> *"The agent of applicant before filing final post hearing submission sent amended claims through email on 06.10.2017, which the Controller approved on 09.10.2017 through email. But contrary to approved claims the agent of applicant filed their own claims on 17.10.2017.*
>
> *Decision: The patent application no.6275/CHENP/2011 is refused under section 15 of the Patent Act 1970 for not complying the direction of the Controller."*

It is evident from the above extract that the only reason mentioned for rejecting the patent application is that the claims filed on 17.10.2017 are contrary to claims approved by the Controller on 09.10.2017.

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7. The emails placed on record by the appellant disclose that two sets of claim amendments were attached to email of 06.10.2017 from the appellant's agent to the respondent. In reply, the respondent stated 'ok file' on 09.10.2017. On receipt of such reply, the appellant's agent informed the respondent that she would inform the applicant of the respondent's opinion that both the claim sets are ok and would file the amended claims.

8. On perusal of the rejected claims and on comparison of such rejected claims with the two claim sets forwarded by the appellant's agent to the respondent, it is evident that claims 1 to 6 of the rejected claims tally with claims 1 to 6 of claim set-A. Likewise, claims 7 to 13 of the rejected claims tally with claims 7 to 12 of claim set -B. In effect, upon receiving the green signal from the respondent with regard to both sets of claims, the appellant combined the two sets of claims and filed the same along with the written submissions.

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9. In the impugned order, apart from stating that the amended claims do not tally with those approved by the Controller on 09.10.2017, no other reason has been provided for rejecting the patent application. As contended by learned counsel for the appellant, it appears that the claimed invention was granted a patent in multiple jurisdictions, including the EPO. The claims appended to the EPO grant are virtually the same as those rejected by the Controller. While the decision of the EPO is not binding on the Controller, it is certainly a factor to be reckoned while adjudicating the patent application. In the absence of any reasons in support of the conclusion, the impugned order cannot be sustained.

10. Therefore, the impugned order dated 14.12.2017 is set aside and the matter is remanded for reconsideration on the following terms:

(i) In order to preclude the possibility of predetermination, an officer other than the officer who issued the impugned order shall

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undertake reconsideration.

(ii) It shall be open to the appellant to amend its claims in accordance with Section 59 of the Patents Act, 1970.

(iii) The respondent is directed to issue a hearing notice in terms substantially identical to the earlier hearing notice to fix a date for hearing upon remand.

(iv) Upon providing a reasonable opportunity to the appellant, a reasoned decision shall be issued within a period of four months from the date of receipt of a copy of this judgment.

(v) For the avoidance of doubt, it is made clear that no observations have been made on the merits of the patent application.

11. (T)CMA(PT) No.171 of 2023 is disposed of on the above terms. There shall be no order as to costs.

12.08.2024

Index : Yes/No
Internet : Yes/No
Neutral Citation : Yes/No
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To

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SENTHILKUMAR RAMAMOORTHY J.

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