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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on:26.10.2026	Pronounced on:30.10.2026

CORAM

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

CMA (PT) No.26 of 2024

KOBELCO COMPRESSORS CORPORATION,
9-12, Kita-Shinagawa 5-Chome,
Singnagawa-ku, Tokyo, 141-8688, Japan,
Nationality; Japan.

..Appellant(s)

Vs

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

..Respondent(s)

PRAYER: This Civil Miscellaneous Appeal is filed under Section 117-A of the Patents Act, 1970, to call for the records of the respondent culminating in the Impugned Order dated 27.02.2024, rejecting the grant of patent and set aside the same and consequently, direct grant of patent in respect of the appellant's application No.202147013337.

For Appellant(s): Mr.Rahul Balaji
For Respondent(s): Mr.K.R.Samratt,
Senior Panel Counsel

JUDGEMENT

The patentee, challenging the Impugned Order dated 27.02.2024 passed by the Respondent, has preferred the present appeal. By the Impugned order dated 27.02.2024, the Appellant’s patent application for an invention under the

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name and title "SOUND INSULATING PACKAGE" came to be rejected by the Respondent on two grounds:

i) Lack of inventive step under Section 2(1)(ja) of the Patents Act, and

ii) The application was not in a two-part claim format.

2. I have heard Mr. Rahul Balaji, learned counsel for the Appellant and Mr.K.R.Samratt, Senior Panel Counsel for the Respondent. I have also gone through the records, including the Impugned Order.

3. Mr. Rahul Balaji, learned counsel for the Appellant, taking me through the Impugned Order would contend that the principles laid down by the Delhi High Court in *F. Hoffmann-La Roche Ltd. and another v. Cipla Limited*, reported in *2016(65) PTC 1(Del)*, have not been followed, and that the Courts having held the steps to be mandatory, an irregular procedure has been adopted by the Respondent. Mr. Rahul Balaji, learned counsel for the Appellant, therefore prays for remand, so that the petitioner can have a fair and reasonable opportunity of putting forth his claimed invention for patent. He would also request that the examination on remand may be made by a different patent controller since the controller who passed the impugned order may have some prejudice and may not be open to reverse his earlier decision.

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4. Per contra, Mr.K.R.Samratt, learned counsel appearing for the respondent, would submit that there is no infirmity in the impugned order, warranting interference in appeal. Taking me through the counter filed in the present appeal, the learned counsel contends that the Appellant has not shown any technical advancement over prior arts D1, D3 and D7, and that the alleged invention is already well known in view of the priority date of the present application of the Appellant. He would further state that the alleged inventive features are obvious in view of the features found in prior arts D1, D3 and D7. He would also place reliance on the decision of the Bombay High Court in *Lallubhai Chakubhai v. Chimanlal and Co.,* reported in *AIR 1936 Bom 99* and the decision of the Delhi High Court in *Gogoro Inc. v. Controller of Patents and Designs and another* in *CA (Comm. IPD-PAT) 25 of 2021*, to contend that the refusal of the application is supported by reasoning and therefore there is no merit in the appeal.

5. At the outset, as rightly contended by Mr.Rahul Balaji, counsel for the Appellant, on going through the impugned order, I do not find any discussion whatsoever to reject the application of the Appellant and reasons are also lacking. Mere reference to prior arts and the invention claimed by the Appellant alone would not suffice. The Controller has to test the invention in the light of the statutory requirements which have been elaborately laid down by the Delhi High Court in *Hoffmann's* case (referred herein supra). In fact, I had an occasion in

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Cornell Research Foundation Inc. v. Assistant Controller of Patents and Designs in *(T) CMA (PT) No. 187 of 2023*, judgment dated 05.07.2024, where I held that when the controller has not assigned any reasons and there is no discussion regarding the response to the hearing notice, the patentee is entitled to an order of remand. In *Pinnacle Engines Inc. and another v. Assistant Controller of Patents and Designs*, reported in *2024 SCC Online Mad 1052*, this Court found that when the Controller had merely set out the various elements of the claimed invention, without any discussion on the claimed invention, the order is unsustainable on the ground that it is effectively unreasoned.

6. In the light of the above, this Civil Miscellaneous Appeal is ***allowed*** and remitted to the Respondent for fresh consideration. The said exercise shall be carried out by a fresh Patent Controller, who shall decide the Appellant's application afresh, after affording an opportunity to the Appellant to offer such explanation as may be necessary in support of his claimed invention, and pass final orders, within a period of four (4) months from the date of receipt of a copy of this order. No costs.

30-10-2026

Index: Yes
Speaking order
Neutral Citation: Yes/No

RKP

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To

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

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P.B.BALAJI J.

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Pre-delivery Order in

CMA (PT) No.26 of 2024

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