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

+ **C.A.(COMM.IPD-PAT) 1/2024, I.A. 128/2024**

KAO CORPORATION

..... Appellant

Through: Mr. Debashish Banerjee, Mr. Ankush Verma and Ms. Vaishali Joshi,
Advocates.

versus

THE CONTROLLER OF PATENTS & ANR.

..... Respondents

Through: Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. Srish Kumar Mishra,
Mr. Alexander Mathai Paikaday,
Mr. Lakshay Gunawat and
Mr. Krishnan V., Advocates.
Mr. Praveen Singh and Mr. Durgesh
Nandan, Advocates for R-2.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA

ORDER

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24.04.2024

1. The present appeal under Section 117A of the Patents Act, 1970¹ impugns order dated 20th September, 2023², whereby the Controller of Patents has refused the Appellant's Indian Patent Application No. 5945/DELNP/2009³ titled "*Hair Dyeing Or Bleaching Method*".
2. Without getting into the merits of the matter, Mr. Debashish Banerjee, counsel for the Appellant, had raised a ground of procedural infirmity in the

¹ "the Act"

² "Impugned Order"

³ "Subject Application"



Impugned Order, which has been taken note of in previous orders. The Court had asked for the Controller's view on the same, however, no response in this regard has been received.

3. Be that as it may, in absence of any categorical stand from the Controller's Office, the Court has proceeded to consider whether the matter deserves to be remanded for reconsideration by the Controller's Office on account of lack of adherence to the principles of natural justice.

4. On this issue, Mr. Banerjee has raised the following contentions:

(a) The objection under Section 3(a) of the Act, which forms the basis of the Impugned Order, was never raised in the hearing notice;

(b) The objection relating to industrial applicability under Sections 2(1)(ac) read with 25(1)(f) of the Act was indicated to be met by the Appellant, however, the Impugned Order erroneously records that the Appellant has not filed any rebuttal to the said objection; and,

(c) The expert affidavit of Mr. Toshio Ogawa, which was filed along with the Appellant's written submissions, has not been considered in the Impugned Order.

5. The Court has perused the hearing notice dated 31st March, 2023. The same does not specify any objection under Section 3(a) of the Act. The Court has, in several decisions, held that the hearing notice must make mention of all the objections so as to afford the Appellant an opportunity to adequately contest the same at the time of the hearing. It was thus incumbent on the Controller to have raised all objections in the hearing notice, which plainly has not been done. Thus, there is merit in the submissions advanced by Mr. Banerjee regarding the violation of principles of natural justice.

6. As regards the objection *qua* industrial applicability, the aforementioned



hearing notice categorically states as follows:

“6. xx xx xx

(3) Industrial applicability (Under Section 2(1)(ac) of the Indian Patents Act, 1970): Claims 1-8 fulfill the requirements of Section 2(1)(ac) of the Indian Patents Act, 1970 in respect to their industrial applicability.”

7. As pointed out by Mr. Banerjee, the aforementioned observation is contrary to the stand delineated in the Impugned Order, wherein the Controller has held that the Appellant had not addressed the point of industrial applicability. Additionally, it is noted that the Impugned Order does not contain any discussion pertaining to the aforementioned affidavit of Mr. Ogawa which had been relied upon by the Appellant.

8. In view of the above, the Court is of the opinion that this is a fit case for reconsideration by the Controller of Patents. Accordingly, the following directions are issued:

- (i) Impugned Order dated 20th September, 2023 is set aside and the matter is remanded to the Controller of Patents for *de novo* consideration.
- (ii) The Subjection Application is restored to its original number.
- (iii) Prior to deciding the matter afresh, the Controller shall issue a hearing notice to the Appellant clearly specifying the objections, if any, that are required to be met.
- (iv) The final decision shall be rendered within a period of four months from the date of conclusion of the hearing.
- (v) The Controller shall decide the application uninfluenced by any observations made in the Impugned Order. It is clarified that all rights and contentions of Respondent No. 2, the pre-grant opponent, are left open.



9. With the above directions, the appeal stands disposed.

SANJEEV NARULA, J

APRIL 24, 2024

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