



(T) CMA (PT) No. 82 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

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DATED: 01.04.2026

CORAM

**THE HONOURABLE MR. JUSTICE SETHILKUMAR RAMAMOORTHY**

(T) CMA(PT) No. 82 of 2023

Srinivas Jegannathan,  
10, V.K. Flats, First Cross Street,  
Sundaram Colony, Tambaram,  
Sanatorium,  
Chennai 600 047.

..Appellant

Vs.

The Controller of Patents,  
Patent Office, Chennai,  
Intellectual Property Building,  
GST Road, Guindy,  
Chennai 600 032.

..Respondent

Prayer: Transfer Civil Miscellaneous Appeal (Patents) filed under Section 117-A of the Patents Act, 1970, praying that the order of the Controller dated 27.03.2014 refusing Patent Application No. 123/CHE/2006 be dismissed and Patent Application No. 123/CHE/2006 be allowed to proceed for grant.

For Appellant

::

Mr.Surya Senthil for  
M/s. Surana & Surana



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For Respondent :: Mr.Rajesh Vivekananthan  
Deputy Solicitor General

## J U D G M E N T

This appeal is directed against the order dated 27.3.2014 rejecting Indian Patent Application No. 123/CHE/2006. The said application was filed for grant of patent for an invention titled ‘COMPOSITION OF CEFOTAXIME WITH BETALACTAMASE INHIBITOR PREFERABLY SUBLACTAM OR TAZOBACTAM AND/OR LINEZOLID FOR EXTENDED SPECTRUM OF ACTIVITY IN CONVENTIONAL AND MODIFIED DOSAGE FORMS’

2. Upon request by the appellant, the first examination report dated 07.01.2013 (the ‘FER’ ) was issued by the Patent Office raising objections labelled Objections 1 to 8. This was followed by second examination report (the ‘SER’) dated 29.11.2013. The said SER recorded that objection 9 of the FER had not been met. The appellant responded to the SER belatedly on 18.02.2014 by filing an amended complete specification along with amended claims. The order impugned herein was issued in the above facts and circumstances.



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3. Adverting to the impugned order, learned counsel for the appellant submits that the said order refers to objection 9 of the FER whereas the FER does not contain 9 objections. He also points out that the application was rejected on the ground that the amended claims pertain to a pharmaceutical composition comprising CEFPIROME whereas the provisional specification disclosed a composition comprising CEFOTAXIME. In cases wherein the disclosure in the complete specification is at variance with the disclosure in the provisional specification, learned counsel contends that the Controller could have resorted to Section 9(4) of The Patents Act, 1970, (the 'Patents Act') by granting the appellant the option of requesting for cancellation of the provisional specification. Instead, he submits that the application came to be rejected.

4. In response to these contentions, learned counsel for the respondent submits that the appellant failed to respond to the SER within the 30 day time prescribed in such regard. He also submits that the provisional specification did not fairly disclose matters disclosed in the complete specification.



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5. As contended by learned counsel for the appellant, both the SER and the impugned order refer to objection 9. The said objection is said to have been raised in the FER. On a perusal of the FER, I am unable to find objection 9. The principal objection raised in the impugned order is that the complete specification and the amended claims are directed at a pharmaceutical composition comprising CEFPIROME whereas the provisional specification discloses a composition comprising CEFOTAXIME. Under Section 11(3) of the Patents Act, where a complete specification is filed after filing the provisional specification and the claim is fairly based on a matter disclosed in the provisional specification, the priority date would be the date of filing the provisional specification. On the other hand, if the provisional specification did not fairly disclose matters disclosed in the complete specification, the date of filing of the complete specification would be the priority date as per Section 11(6) of the said Act. In addition, the patent applicant has an option under Section 9(4) of the said Act to request that the provisional specification be cancelled and that the date of complete specification be treated as the date of filing. The Controller



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did not take note of these provisions while rejecting the application on the grounds adverted to above. Therefore, reconsideration is warranted. In order to facilitate the same, the impugned order is set aside.

6. As a corollary, the matter is remanded on the following terms and conditions:

- (i) In order to preclude the possibility of pre-determination, an officer, other than the officer who issued the impugned order, shall undertake re-consideration;
- (ii) After providing a reasonable opportunity to the appellant, a speaking order shall be issued within *four months* from the date of receipt of a copy of this order; and
- (iii) For avoidance of doubt, it is clarified that no opinion has been expressed on the merits of the patent application.

7. (T)CMA(PT) No.82 of 2023 is disposed of on the above terms with no order as to costs.

Neutral Citation: Yes/No

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**SENTHILKUMAR RAMAMOORTHY,J.**

nv

To  
The Controller of Patents,  
Patent Office, Chennai,  
Intellectual Property Building,  
GST Road, Guindy,  
Chennai 600 032.

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