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

% *Date of Decision : 28th April, 2023*

\+ C.A.(COMM.IPD-PAT) 97/2022

ROSEMOUNT INC ..... Appellant

Through: Ms. Anju Agrawal, Mr. Deepak Singh and Mr. Vardhman Jain, Advocates.

versus

DEPUTY CONTROLLER OF PATENTS AND DESIGNS ..... Respondent

Through: Mr. Nitinjya Chaudhry, Sr. Panel Counsel.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. The present appeal has been filed under Section 117-A of the Patents Act, 1970 impugning the order dated 7th July, 2017 passed by the Assistant Controller of Patents and Designs in the Indian Patent Application No. 1055/DELNP/2009 (hereinafter "subject application") filed on 12th February, 2009 for the invention titled "Process Device with Density Measurement" (hereinafter "subject invention").

2. Brief facts relevant to decide the present appeal are as follows:

2.1 The appellant had filed the subject application on 12th February, 2009 at the Patent Office, New Delhi, claiming priority from 29th August, 2006 based on a US patent application 11/511584, which was

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subsequently granted as US7461562 on 9th December, 2008.

2.2 A request for examination was filed on 18th February, 2009 and the patent application was published under Section 11A of the Act on 31st July, 2009. Subsequently, the Patent Application was examined by the Controller and a First Examination Report (FER) was issued on 22nd August 2014. The FER essentially contained objections, *inter alia*, that claims of the subject application were not patentable in terms of Section 2(1)(j), Section 2(1)(ja) and Section 10(5) of the Act.

2.3 A detailed response was filed on behalf of the appellant to the aforesaid FER on 15th April, 2014 along with a set of amended claims addressing the objections raised in the FER.

2.4 On 10th March, 2017, a hearing notice was issued by the Controller fixing the date of hearing for 24th May, 2017, wherein once again, an objection was taken with regard to lack of inventive steps in view of the cited prior art documents. Response to the aforesaid hearing notice was filed along with a set of amended claims, in respect of the objections raised in the hearing notice, on 22nd May, 2017.

3. On 7th July, 2017, the impugned order was passed by the Controller rejecting the patent application filed by the appellant on the ground of lack of inventive steps under Section 2(1)(j) read with Section 2(1)(ja) of the Act, in view of the cited prior art references, WO0120267 (D1), GB2399641 (D2), US5606513 (D3) and US4677841 (D4). The relevant portion of the impugned order is set out below:

> *"2. Claims 1-24 lack Novelty u/s 2(1)(j) of the Act as being anticipated by following documents:*
> *D-1 WO0120267 (A1), D2 – GB2399641 (A) D3- US5606513 (A)*

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D1 discloses a flow device (100) including a differential flow plate (108) insertable into a flow path between pipe sections (58-1, 58-2) including a flow conduit (110) supporting a flow interrupter (112) and differential pressure taps (114, 116). The flow conduit (110) including a seamless interface (154) between the flow interrupter (112) and the pressure taps (114, 116) to reduce non-attributable pressure loss between differential pressure taps (114, 116) as well as reduce field installation labor including that of pressure testing the various pressure couplings.

D2 discloses a method and apparatus are provided for determining the gas flow rate of a gas-liquid mixture which has a gas volume fraction (GVF) of at least 85% and which is conveyed along a conduit. The conduit is fitted with a differential pressure flow meter and a fluid densitonmeter. The method comprises : measuring the pressure difference across the differential pressure flow meter and measuring the density of the mixture using the densitometer; estimating the GVF of the mixture from the measured density; and calculating the gas flow rate from the measured pressure difference and measured density. A corrective term which comprises the estimated GVF is used in the calculation to correct the gas flow rate for the high GVF value of the mixture.

D3 discloses a two-wire transmitter senses a pressure using an internal pressure sensor. The transmitter includes an input for receiving a process variable from a remote sensor which is separated from the transmitter. Circuitry in the transmitters transmits information on a two-wire process control loop which is related to the sensed pressure and the process variable.

3. Subject matter of claims does not constitute an invention and do not involve an inventive step under sections 2.1(j), 2.1(ja) of Patents Act 1970 in view of US5606513, US4677841, GB2399641, WO01/20267.

4. All essential, novel, inventive and constructive features should be given in Claim 1 and inventive features should be characterized. Reference numerals should be given in claims to enhance intelligibility of the claims.

Regarding objection 1 and 4, the Ld. Agent of Applicant submitted that both claims 1 and 18 relates to single inventive concept claiming method of measuring and transmitter. Further claims

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have been amended and now revised claims are 1-22. The reference numerals has been inserted to enhance the intelligibility of claims.

I agree to the submissions made by Ld. Agent for Applicant and hereby waive off objections 1 and 4.
Upon reading though the cited documents D-1 WO0120267 (A1), D2 – GB2399641 (A) D3- US5606513 (A) carefully in light of the written and oral arguments made by Ld. Agent for Applicant, it is opined that amended claim 1 lacks in inventive step u/s 2(1)(j) read with (ja) as they shall be obvious to a person skilled in the art when taught by the documents.
Therefore, that the amended claims 1-22 produced before me of the impugned application is denied patent u/s 15 of 'The Patent Act 1970'."

4. Counsel appearing on behalf of the appellant submits that detailed submissions were made on behalf of the appellant in response to the FER as well as hearing notice, wherein the subject invention has been distinguished from the prior arts cited by the Controller. However, the Controller has passed a cryptic order without dealing with any of the submissions made on behalf of the appellant and came to the conclusion that the patent application is hit by Section 2(1)(j) and Section 2(1)(ja) of the Act. Reliance in this regard is placed on the order dated 22nd March, 2023 passed by the Coordinate Bench of this Court in C.A.(COMM.IPD-PAT)301/2022 titled as ***Blackberry Limited* v. *Assistant Controller of Patents and Designs***. The relevant portion of the said order is set out below:

"The Controller ought to have disclosed reasons to support his conclusion. Reasoning through a speaking order is a vital aspect of the principles of natural justice and is of utmost importance, which needs to be underscored. If the patent office's orders lack proper reasoning, it may be difficult for the applicant

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> *to identify the grounds for appeal. The legal proposition that an order of such kind should be supported by reasons, needs no reiteration. Not only does this benefit the applicant, whose rights are likely to be affected, but also assists the Court in ascertaining how the concerned officer applied their minds and reached the impugned conclusion, while exercising judicial review. This Court, in an earlier decision of SK Geo Centric Co Ltd. v. The Controller of Patents, observed that such reasoning should be discernible to the Court and in absence thereof, the entire order stands vitiated. In the impugned order, the Court is bewildered as to how the Controller has concluded that subject invention is hit by Section 3(k) of Patents Act and has plainly agreed with the Examiner's opinion that the claimed patent is not an invention."*

5. I have heard the counsels for the parties and examined the record of the present appeal.

6. A reading of the impugned order shows that the Controller has failed to disclose any reason for refusing the grant of patent in the subject application. The subject application has been rejected on the ground of lack of inventive step as required under Section 2(1)(j) and Section 2(1)(ja) of the Act. The impugned order takes note of the prior art documents D1, D2 and D3. However, no reasoning has been given as to how the subject patent is covered by the said prior art documents.

7. In the present case, the appellant filed detailed reply to the FER as well as to the hearing notice, giving explanation as to how the subject invention is novel in the context of cited prior arts. However, the impugned order has been passed in a cryptic manner without going into the explanation/justification offered on behalf of the appellant with regard to the cited prior arts. The impugned order simply arrives at a conclusion that the subject invention lacks inventive steps.

8. A reference may be made to the judgment of a Coordinate Bench of

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this Court in ***Agriboard International LLC v. Deputy Controller of Patents and Designs***, 2022 SCC OnLine Del 940. The aforesaid judgment has been followed by me in ***Auckland Uniservices Limited v. Assistant Controller of Patents and Designs***, ***N.V. Satheesh Madhav and Anr.*** **v.** ***Deputy Controller of Patents and Designs***, 2022 SCC OnLine Del 4568 and the judgment dated 12th January, 2023 in C.A.(COMM.IPD-PAT) 435/2022 titled ***Alfred Von Schukmann*** **v.** ***The Controller General of Patents, Designs and Trademarks and Ors.***, wherein it was held that the Patent Office is required to pass a speaking order analyzing what is the existing knowledge and how the subject invention lacks inventiveness in light of the prior art. The relevant observation of this Court in ***Agriboard international*** (supra) are set out below:

> *"23. The said reasoning has been reiterated by the Supreme Court in Manohar v. State of Maharashtra & Ors. AIR 2013 SC 681 wherein it has been categorically observed that* ***application of mind and recording of reasoned decision are the basic elements of natural justice. There can be no doubt that scrupulous adherence to these principles would be required while rejecting patent applications.***
>
> *24. In the opinion of this Court, while rejecting an invention for lack of inventive step, the Controller has to consider three elements-*
>
> - *the invention disclosed in the prior art,*
> - *the invention disclosed in the application under consideration, and*
> - *the manner in which subject invention would be obvious to a person skilled in the art.*
>
> *25. Without a discussion on these three elements, arriving at a bare conclusion that the subject invention is lacking inventive step*

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would not be permissible, unless it is a case where the same is absolutely clear. Section 2(1(ja) of the Act defines „inventive step" as under:

(ja) "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.

26. ***Thus, the Controller has to analyse as to what is the existing knowledge and how the person skilled in the art would move from the existing knowledge to the subject invention, captured in the application under consideration. Without such an analysis, the rejection of the patent application under Section 2(1)(ja) of the Act would be contrary to the provision itself.*** *The remaining prior arts which are cited by ld. Counsel having not been considered in the impugned order, the Court does not wish to render any opinion in this regard."*

[emphasis supplied]

9. Counsel for the appellant has correctly relied upon the judgment in ***Blackberry Limited*** (supra), wherein it has been held that the Controller ought to have disclose the reasons to support his conclusion. The lack of reasons not only prejudices the right of the appellant to identify grounds of appeal, but also prevents the Court from discerning how the concerned officers have applied their minds and reached the impugned conclusion.

10. In view of the above, the impugned order dated 7th July, 2017 rejecting the patent application of the appellant is set aside and the matter is remanded back to the Patent Office for fresh consideration. The fresh consideration would take into account the material already on record and more particularly, the submissions filed on behalf of the appellant with regard to the cited prior arts.

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11. The Patent Office shall endeavour to pass a reasoned order taking into account all the relevant considerations within four months from today.

12. The Registry is directed to supply a copy of the present order to the Office of the CGPDTM on the e-mail ID- llc-ipo@gov.in for compliance.

13. The appeal stands disposed of in terms of the above.

AMIT BANSAL, J.

APRIL 28, 2023
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