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

\+ C.A.(COMM.IPD-PAT) 241/2022 & I.A. 9960/2022

SK GEO CENTRIC CO LTD ..... Appellant

Through: Mr. Debashish Banerjee, Advocate.

versus

THE CONTROLLER OF PATENTS ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC, Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advocates for the Controller of Patents along with Mr. Ashok Kumar, Joint Controller of Patents and Designs.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

O R D E R

% 08.02.2023

1. Pursuant to order dated 03rd February, 2023, Mr. Ashok Kumar, Joint Controller of Patents and Designs has joined the proceedings through video-conferencing mechanism and he has been heard.

2. Appellant has impugned order dated 06th January, 2022 passed by the Joint Controller of Patents and Designs whereby Appellant's Patent Application No. 201617034667 has been refused [hereinafter "*impugned order*"]. Operative portion of the said order reads as under: -

> "*Decision: The submission made by the agent of applicant in respect of inventiveness of invention is not accepted. The subject of the claimed invention is similar to cited prior art D4 with difference in ratio of terpolymer and copolymer in binder composition of bitumen which is a part*

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of routine experimentation for a person skilled in the art and person skilled in the art may arrive at the technical features of the current application by using the teachings of document D4. Therefore the application does not involve an inventive step as per section 2 (1) (ja) of The Patents Act, 1970.The patent application no. 201617034667 is being refused under section 15 of the Patent Act 1970."

3. Without going into the merits of the impugned order, Mr. Debashish Banerjee, counsel for Appellant argues that the impugned order is liable to be set-aside as it is bereft of any reasoning. He points out that in the impugned order, after narration of facts and contentions urged by Appellant, the concluding paragraph abruptly rejects the application, without providing reasoning to support the conclusion.

4. During the course of hearing, Mr. Ashok Kumar, Joint Controller of Patents and Designs, has attempted to explain the basis for his decision, but the same is not discernible from the decision rendered by him.

5. Indeed, the impugned order from para No. 3 notes the facts and *verbatim* reproduces contentions urged by Appellant from para No. 3 unnumbered sub-paras No. 4 to 12 and then tersely, the impugned decision follows. While the decision may be brief and to the point, it must still reveal the logic and reasoning behind it. Reasons, in support of a decision, must be cogent, clear and indicate that the authority has given due consideration to the points in controversy.[1] The impugned decision also does not conform to the guidelines outlined in the Manual of Patent Office Practice and Procedure,[2] which, *inter alia*, requires that 'obviousness' must be strictly and objectively judged. The Manual provides that for determining 'inventive

[1] **See**: *S.N. Mukherjee v. Union of India*, (1990) 4 SCC 594, *Kranti Associates Pvt. Ltd. & Anr. v. Masood Ahmed Khan & Ors.*, (2010) 9 SCC 496, *The Siemens Engineering & Manufacturing Co. of India Ltd. v. The Union of India & Anr.*, (1976) 2 SCC 981.
[2] Version 3.0 dated 26th November, 2017.

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step', it is important to look at the invention as a whole and not merely individual parts taken separately are known or might be found to be obvious. The Manual outlines following points for evaluating 'inventive step' in a claimed invention: -

> "*1. For determination of inventive step, the prior art as a whole, revealed during the search process, is relied upon to assess if such prior art(s) disclose(s) the claimed invention.*
> *2. Invention as a whole shall be considered. In other words, it is not sufficient to draw the conclusion that a claimed invention is obvious merely because individual parts of the claims taken separately are known or might be found to be obvious.*
> *3. If an invention lies merely in verifying the previous predictions, without substantially adding anything for technical advancement or economic significance in the art, the inventive step is lacking.*
> *4. For the purpose of establishing obviousness of the invention to a person skilled in the art, mosaicing multiple documents of prior arts is permissible, if the cited prior art provides lead to the skilled person to combine the teachings thereunder, at the time of filing or priority date of patent application.*
> *5. If the invention is predictable based on the available prior art, merely requiring workshop improvement by a person skilled in the art, the inventive step is lacking.*"

6. In the instant case, the Joint Controller has recognized two disparities, but has not shown how they make the invention easily recognizable to someone with expertise in the field. There is no elaboration or justification given by the Joint Controller for his findings. To determine absence of 'inventive step' the Joint Controller was required to explain how the prior art would make the invention obvious to someone skilled in the field. This Court in the case of *Agriboard International LLC. v. Deputy Controller of Patents & Designs*,[3] has held that while rejecting an application for lack of 'inventive step', discussion on prior art, the subject invention as well as the

[3] DHC Neutral Citation – 2022/DHC/001206.

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manner in which the subject invention would be obvious to a person skilled in the art, is mandatory. Merely arriving at a bare conclusion that the subject invention lacks 'inventive step' would be contrary to Section 2(1)(*ja*) of the Patents Act, 1970 itself.

7. Given the aforementioned issues, the impugned order is invalid as it lacks reasoning and must therefore, must be revoked. The matter is remanded back to the Joint Controller of Patents and Designs to reconsider the same, after providing a fresh hearing to the Appellant. The Joint Controller must render a decision with clear justification, within a time frame of one month post-conclusion of hearing.

8. The appeal is disposed of in the above terms. All pending application(s) also stand disposed of. It is made clear that the Court has not reflected any opinion on the merits of the case and all rights and contentions of the parties are left open.

9. Registry is directed to supply a copy of the present order to the e-mail - llc-ipo@gov.in for compliance.

SANJEEV NARULA, J

FEBRUARY 8, 2023
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