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

\+ C.A.(COMM.IPD-PAT) 284/2022

LEONHARD KURZ STIFTUNG AND CO. KG ..... Appellant

Through: Ms. Rajeshwari H., Mr. Tahir A.J., Mr. Sudarshan Bansal, Mr. Gaurav Ganesh Singh and Mr. Arpit Dudeja, Advocates.

versus

CONTROLLER OF PATENTS ..... Respondent

Through: Mr. Piyush Beriwal and Mr. Nikhil Kumar Chaubey, Advocates with Mr. Shankar Dyal Bhatnagar, Deputy Controller.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

O R D E R

% 15.05.2024

1. The present appeal under Section 117A of the Patents Act, 1970[1], impugns order dated 26th June, 2016 passed under Section 15 of the Act whereby the Respondent, Controller of Patents & Designs, has refused the Appellant's patent application No. 1364/DELNP/2007[2].

2. Ms. Rajeshwari H., counsel for Appellant, states that subsequent to the Impugned Order, the Appellant filed a review petition, which was also dismissed by the Respondent on 24th July, 2019. Thereafter, the present appeal was filed before the erstwhile IPAB, which has now been transferred

[1] "the Act"
[2] "Impugned Order"

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to this Court consequent to the abolition of the IPAB.

3. At the outset, Ms. Rajeshwari has raised an objection that the Impugned Order has wrongly invoked Sections 57 and 59 of the Act to hold that the amended claims filed by the Appellant are beyond the scope of the originally filed claims. The relevant portion of the Impugned Order wherein a finding has been recorded to this effect is extracted as follows:

> *"D. The amended claims Tied by applicant added new material "at least one injected plastic material (6, 8) in in-mold injection molding operation(s)" which applicant shows his contribution in his reply submission and differentiating from cited documents. But this features was not available in filed claims at date i.e. 20/02/2007 and even support for mechanically fixedly joined to at least one injected plastic material (6, 8) in in-mold injection molding operation(s)" in not as such available in filed specification i.e specification on 20/02/2007. No request for amendments was filed as per provisions of The Patent Act. New set of claims were filed; which were not submitted in-line with the original filed claims by strictly adhering to section 57/59 of The Patent Act.*
>
> *..xx..* *..xx..* *..xx..*
>
> ***Hence under section 57 & 59 of The Patents Act, the amendments proposed by the applicants are beyond the scope of invention as filed. Hence, amendments were not allowed.****"*
>
> [sic.]

4. Ms. Rajeshwari argues that this aforenoted finding is erroneous, as the amendments introduced could be traced to the specifications in respect of the claims as filed originally. To support this contention, reliance is placed on the following comparison chart prepared by the Appellant and annexed along with their written submissions filed before this Court:

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CHART-A

Old Claim	Amended Claim (filed on 17th March, 2016)	Reference in the Complete Specification (pg.17)
1. A decorated Injection molded article (11,11a,11b) which is formed form at least one injected plastic material (6, 8) and at least one decorative (16, 16') which is mechanically fixedly joined thereto and which is formed by a transfer layer of a transfer film (1) and provides a decoration for the Injection molded article(11,11A.11 B) characterised in that a. both sides of at least one first decorative element (16) are at least partially covered with at least one injection molded plastic material (6, 8), or b. a first side of at least one first decorative element (16) is at least partially covered with at least one injection molded plastic material and a second side of the at least one first decorative element (16) is arranged on a thermoplastic auxiliaty film web (12) which is three-dimensionally shaped by deep drawing, wherein the side of the auxiliary film web (2) that is remote from the at least one decorative element (16) is at least partially covered with an injection molded plastic material,	1. A decorated injection molded article (11,11a,11b,11c) which is formed from at least one injected plastic material (6,8) and at least one decorative element (16, 16') formed by a transfer layer of a transfer film (1), wherein said at least one decorative element (16, 16') is mechanically fixedly joined to *at least one injected plastic material (6, 8) in in-mold injection molding operation*(s) and said decorative element (16, 16') provides a decoration for the injection molded article (11, 11 a,11 b, 11 c), wherein that: a. both sides of at least one first decorative element (16) are least partially covered with at least one injection molded plastic material (6, 8); or b. a first side of at least one first decorative element (16) is at least partially covered with at least one injection molded plastic material and a second side of the at least one first decorative element (16) is arranged on a thermoplastic auxiliary film web (12) which is three-dimensionally shaped by deep drawing, wherein the side of the auxiliary film web (2) that is remote from the at least one decorative element (16) is at least partially covered with an injection molded plastic material.	Figure 2 now shows an injection-molded first plastic material 6 which has been decorated with a decorative element 16 in an *inmold Injection molding process*. In this case the first plastic material 6 Is formed from an ABS/PC mixture which is colored opaquely brown. The decorative element 16 is mechanically fixedly joined, with its first layer 15 In the form of an adhesive layer, to a surface of the first plastic material 6, That surface of the first plastic material 6 in this case has a wavy configuration or a three dimensional structuring which is reproduced by the decorative element 16. Figure 2 shows the decorative element 16 of the transfer film of Figure 1 after the carrier film 10 Inclusive of the release layer'12 has been removed from the second layer 13 without any residue, The first plastic material 6 decorated with the decorative element 16 can now be joined to a second plastic material, preferably predominantly in the region of the second layer 13, in which respect that is effected in accordance with the invention in a further *inmold injection molding procedure*. In the case of the first plastic material 6 involved here, the visible side was provided with the decorative element 16, while provided on the side of the first plastic material 6 that is opposite to the decorative element 16, there are the projections 6a, for example for fixing the first plastic material in a vehicle Interior.

5. In light of the above, in the opinion of the Court, the amended claims filed on 17th March, 2016 find reference in the complete specifications

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relating to the originally filed claims, as indicated by the underlined portion in the above tabulation under the respective headings.

6. Mr. Shankar Dyal Bhatnagar, the Deputy Controller of Patents who has joined the proceedings through video conferencing, states that there was no formal application for amendment filed by the Appellant. Further, he states that during the course of hearing, the Appellant had not referenced the amendments in the specifications, and such a contention is being raised for the first time.

7. Be that as it may, Mr. Piyush Beriwal, counsel for Respondent, as well as Mr. Bhatnagar agree that the case as presented today does indicate that the amendments bear reference to the original specifications.

8. In view of the above, the Court is of the opinion that the matter requires reconsideration by the Patents Office. Although the Impugned Order also deals with another objection under Section 3(f) of the Act, nonetheless, in the opinion of the Court, now that amended claims are to be re-examined, all objections should be reconsidered and left open. The Appellant shall within a period of 15 days file the application for amendment/ statutory form.

9. Accordingly, the present appeal is allowed with the following directions:

(i) Impugned Order dated 26th June, 2016, is set aside and the matter is remanded to the Respondents for *de novo* consideration.

(ii) The Appellant's patent application is restored to its original number.

(iii) Prior to deciding the matter afresh, Appellant shall be granted a hearing, and the notice of such hearing must clearly delineate the objection(s), if any.

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(iv) After completion of hearing, the decision thereon shall be rendered within a period of four months from the date of conclusion of hearing.

(v) The Respondent shall decide the application uninfluenced by any observations made in the Impugned Order. It is clarified that the Court has not expressed any opinion on the merits of the case, and accordingly all rights and contentions of the parties are left open.

10. With the above directions, the appeal stands disposed of.

SANJEEV NARULA, J

MAY 15, 2024
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