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

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

\+ C.A.(COMM.IPD-PAT) 50/2022

VEXIM ..... Appellant

Through: Mr.Nitin Masilamani and Mr.Amritanshu Jha, Advocates.

versus

THE CONTROLLER OF PATENTS ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr.Alexander Mathai Paikaday, Advocates.

**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 (hereinafter 'the Act') impugning the order dated 24th July, 2017 passed by the Assistant Comptroller of patents rejecting the Indian Patent application no. 7174/DELNP/2006 (hereinafter "subject application") titled "Methods and Apparatuses for Bone Restoration" (hereinafter "subject invention").

2. The impugned order was served on the appellant on 28th July, 2017 and the three months period provided for filing an appeal expired on 28th October, 2017. The present appeal was filed on 29th January, 2018 with a delay of 93 days.

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3. For the reasons stated in the application for the condonation of delay, the same is allowed and the delay in filing of the present appeal is condoned.

4. Insofar as the merits of the appeal are concerned, brief facts relevant to decide the present appeal are as follows:

4.1. The appellant had filed the subject application on 29th November, 2006 at the Patent Office, New Delhi. Subsequently, a complete specification with claims was filed with the Patent Office.

4.2. The Patent Office issued a First Examination Report (FER) dated 4th September, 2013 in terms of which, objection was raised that the claims lack inventive step in view of the prior-art documents referred to as D1, D2, D3, D4, D5, D6 and D7 and therefore, do not constitute an invention under Section 2(1)(j) of the Act. Further, claims 2-17, were also objected to. The FER also raised an objection under Section 3(i) of the Act stating that the claims were non-patentable.

4.3. A detailed response was filed on behalf of the appellant to the aforesaid FER by letters dated 6th August, 2014 and 4th September, 2014. Subsequently, various hearing notices were issued by the Patent Office to the appellant. *Vide* hearing notice dated 16th March, 2016 the Assistant Controller of Patents maintained the objections relating to claims 1 to 5, 6 to 13 and 14 to 15 and the subject invention lacking inventive steps in view of the prior art documents, D1 and D2. The notice further maintained that the claims 16-17 were non-patentable under Section 3(i) of the Act.

4.4. The appellant filed written submissions on 6th June, 2016 dealing with the prior art cited by the Patent Office and patentability of the subject invention. Along with the written submissions, the appellant also filed

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revised set of claims.

5. The impugned order was passed by the Patent Office on 24th July, 2017 rejecting the subject application and holding that the amended claims 1 to 5 of the subject invention are not patentable under Section 2(1)(j) of the Act. The relevant part of the impugned order is set out below:

> "*After going through the specification, amended claims 1-5 and the cited documents Dl: WO 03/003951 and D2: WO 01/01895 carefully, I am of the opinion that the amended claims 1-5 shall be obvious to a person skilled in the art in view of the combined teachings of DI and D2.*
>
> *Therefore, the finally amended claims I - 5 nos. of this patent application are not allowed for grant of patent as they lacks in inventive step as defined u/s 2(1)(j) read with 2(1 )(ja).*
>
> *The Application is hereby refused patent ii/s 15 of "The Patent Act 1970".*"

6. Counsel for the appellant submits that the respondent has failed to consider the correct set of claims that were presented by the appellant before the Controller. *Vide* post hearing written submissions dated 6th June, 2016, the appellant had also filed an amended claim set. Out of the five objections raised in the hearing notice dated 16th March, 2016, four objections were waived by the impugned order. However, the subject invention was rejected on the ground of the objection no.1 as raised in the hearing notice. However, the Patent Office has passed a cryptic order without disclosing any reasons for refusal of the patent.

7. I have examined the record and heard the counsels for the parties.

8. There is merit in the submission of the appellant that the impugned

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order does not give any reasoning to arrive at a conclusion that the subject matter of the patent application lacks inventive steps in terms of Section 2(1)(j) and Section 2(1)(j)(a) of the Act.

9. I am in agreement with the aforesaid submission of the appellant. In this regard, a reference may be made to the judgment of a Co-ordinate Bench of this Court in ***Agriboard International LLC* v. *Deputy Controller of Patents and Designs***, 2022 SCC OnLine Del 940, 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 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*

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> *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]*

10. 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***.

11. In the present case, detailed submissions were filed on behalf of the appellant in response to the objections in the hearing notice, showing how the subject invention was patentable under the Act.

12. Despite the above submissions seeking to establish how the subject invention is patentable, the impugned order has been passed in a cryptic manner without going into the explanation offered on behalf of the appellant with regard to the patentability of the subject invention and considering the unamended set of claims.

13. When viewed in light of the proposition of law laid down in the aforesaid judgments, the impugned order is completely cryptic and does not

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give any reasoning or justification to arrive at the finding that the claims of the appellant are non-patentable.

14. In view of the above, the impugned order dated 24th 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 amended claims filed by the appellant along with the written submissions.

15. The Officer shall endeavour to pass a reasoned order taking into account all the relevant considerations within two months from today.

16. 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.

**AMIT BANSAL, J**

**APRIL 28, 2023**
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