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

\+ C.A.(COMM.IPD-PAT) 209/2022

NRIPENDRA KASHYAP ESCO CORPORATION ..... Appellant

Through: Mr. Pravin Anand, Adv.

versus

ASSTT. CONTROLLER OF PATENTS AND DESIGNS ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Alexander Mathai Paikaday and Mr. Krishnan V., Advs.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR

JUDGMENT (ORAL)

% 24.11.2023

1. This appeal is preferred against the order dated 20 March 2017, passed by the Assistant Controller of Patents and Designs ("Assistant Controller"), rejecting Application No. 737/DELNP/2009 dated 30 January 2009 for grant of a patent in respect of an innovation titled "WEAR ASSEMBLY FOR THE DIGGING EDGE OF AN EXCAVATOR". The application was filed as a divisional application arising out of patent Application No. 4703/DELNP/2005.

2. The concluding paragraphs of the impugned order which

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summarize the reasons why the application was rejected read thus:

> "It is observed that wear assembly claims 1-4 filed in this divisional application do not relate to distinct invention as compared to allowed wear assembly claims 1-10 in parent application 4703/DELNP/2005.
>
> In view of abovementioned reasons this divisional application is illegitimate ab initio.
>
> Further I find that the document D2 US5765301 is closest prior art and discloses the tooth assembly similar to the disclosed in the application. However, it differs in locking arrangement. This cannot be considered inventive as being other embodiment obvious to a person skilled in the art. Therefore claims 1-4 above lacks inventive step.
>
> Therefore, this divisional application no. **737/DELNP/2009** is hereby refused patent u/s 15 of The Patent Act 1970 due to noncompliance of requirements of section 2(1)(j) lead with 2(l)(ja) and section 16(1) of The Patent Act 1970."

3. Mr. Pravin Anand submits that the objection regarding Claims 1 to 4 in the divisional application not relating to a distinct invention as compared to Claims 1 to 10 in the parent application, relatable to Section 16 of the Patents Act, was neither raised in the First Examination Report (FER) dated 24 July 2014 nor in the hearing notice dated 1 December 2016.

4. Mr. Vaidyanathan submits that, though the specific objection to that effect may not have been raised in the FER or in the hearing notice, it is a matter of common practice that, at times, during hearing that is granted consequent to the hearing notice, new objections are raised to which the patent applicant is then given an opportunity to respond.

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5. In my opinion, such a procedure is not sustainable in law. Objections have necessarily to be restricted to those which are provided in writing to the patent applicant whether in the FER or in the hearing notice. If any additional objections arise during the course of hearing, the patent office would, at the very least, have to set out the said objections in writing and grant the patent applicant an opportunity to respond, in writing, thereto.

6. Mr. Vaidyanathan very fairly states that, in view of Mr. Anand's objection, the application may be remanded for a fresh consideration on all aspects, as the aspect of inventiveness would also be taken up as a consequential issue after the issue of maintainability of the divisional application is decided.

7. Mr. Anand, while agreeing to the said suggestion, prays that the exercise may be made time bound, as only six months remain for the life of the patent to expire.

8. In view thereof, the impugned order dated 20 March 2017 is quashed and set aside. Application No. 737/DELNP/2009 is remanded to the Controller of Patents to assign the application to a competent Assistant Controller for *de novo* adjudication. The appellant shall be granted an opportunity of hearing prior thereto. Let a *de novo* decision be positively taken and communicated to the appellant within a period of eight weeks from today.

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9. The appeal stands allowed to the aforesaid extent.

10. Let the order be issued *dasti*.

C.HARI SHANKAR, J

NOVEMBER 24, 2023
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Click here to check corrigendum, if any

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