2023:MHC:5186

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED **: 24.11.2023**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

**CMA(PT)/8/2023**

1.Saint-Gobain Abrasives, Inc.
1 New Bond Street, Worcester
MA 01615-0138, USA; Nationality: USA

2.Saint-Gobain Abrasifs
Rue de 1'Ambassadeur, 78700
Conflans-Sainte-Honorine, France
Nationality: France ... Appellants

-vs-

The Controller of Patents and Designs,
Intellectual Property Office Building,
Plot No.32, Sector 14, Dwarka,
New Delhi - 100 078. ... Respondent

**PRAYER**: Civil Miscellaneous Appeal (Patents) filed under Section 117-A of the Patents Act, 1970, praying to call for the records of the respondent culminating in the Impugned Order dated 02 September



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2022 rejecting the Grant of Patent and Set Aside the same and consequently direct Grant of the Patent in respect of the Appellant's Application No.201941052276.

For Appellants : Mr.S.Shivathanu Mohan
for M/s.S.Ramasubramaniam and Associates

For Respondent : Mr.K.Subbu Ranga Bharathi, CGSC

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**JUDGMENT**

The appellants assail an order dated 02.09.2022 by which Patent Application No.201941052276 for the grant of patent for a claimed invention entitled NONWOVEN ARTICLE was rejected.

2. The above mentioned application was filed by the appellants on 17.12.2019. Upon submitting a request for examination on 09.07.2021, the respondent issued the First Examination Report (FER)



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on 31.08.2021. In the FER, objections were raised *inter alia* on grounds of lack of novelty, inventive step, unity of invention, sufficiency of disclosure and lack of clarity and definitiveness. The appellants replied thereto on 30.04.2022 and submitted amended claims. Pursuant to hearings on 19.06.2022 and 22.08.2022, the appellants filed final written submissions on 01.09.2022. Eventually, the application was rejected by order dated 02.09.2022, which is impugned herein.

3. Learned counsel for the appellant submitted that the claimed invention is in respect of a nonwoven Article. In this connection, he invited my attention to the amended claims at pages 206 to 208 of the paper book. By turning to the impugned order, learned counsel submitted that the application was rejected on the following three grounds:

(i) lack of sufficient disclosure;

(ii) lack of clarity and definitiveness; and



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(iii) obviousness.

With regard to the alleged lack of sufficient disclosure, learned counsel pointed out that the respondent recorded at internal page 3 of the impugned order that the applicant had not disclosed the method to make a nonwoven substrate with higher thickness of the coating of the "exterior surface" and lower thickness of the coating at the "central region". According to learned counsel, this conclusion is completely untenable in view of the disclosures made in paragraphs 79 to 83 of the complete specification (pages 61 and 62 of the paper book). With reference thereto, learned counsel pointed out that the methodology for forming the nonwoven substrate has been explained in detail therein, including the dip and spray coating process.

4. As regards the objection regarding lack of definitiveness, learned counsel referred to the conclusion at internal page 4 of the impugned order that the expression "greater" is a relative term. By



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turning to the claims and, in particular, independent claim-1, learned counsel submitted that the difference in thickness has been expressed by providing the range of at least 1% and not greater than 50%. Therefore, he submits that this conclusion is without merit. He next dealt with the conclusion that the expression "exterior surface" and "central region" are not clearly defined. On this issue, he referred to the written submissions of the appellants and pointed out that the "exterior surface" and "central region" were depicted pictorially. He further submitted that the appellants explained that the central region can be reached by cutting the scrap pad into half as depicted in such written submissions. For such reason, he submitted that both the objections with regard to alleged lack of definitiveness are unsustainable. As regards the alleged lack of inventive step, learned counsel pointed out that no prior art document was referred to in the impugned order while arriving at the conclusion that there is obviousness.



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5. In response to these submissions, learned counsel for the respondent referred to the drawings forming part of the complete specification and submitted that figure 3 thereof discloses that both the first and second coatings are applied to the inner layer. Since lower thickness in the central region is achieved by not subjecting such central region to the same type of coating as the external surface, learned counsel submitted that figure 3 indicates that the thickness of both the external surface and the central region would be the same. On such basis, learned counsel submitted that the conclusion in the impugned order with regard to lack of definitiveness contains no infirmity.

6. The reasons specified in the impugned order for refusing the application relate largely to the alleged insufficiency of disclosure. The first ground on which such conclusion was drawn is that the appellants have not disclosed the technique / method to make a



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nonwoven substrate with higher thickness of the coating at the exterior surface and lower thickness of the coating at the central region. As correctly pointed out by learned counsel for the appellant, in paragraphs [0079] to [0083] of the complete specification, the entire process appears to have been set out by the appellant. The impugned order does not draw reference to these relevant paragraphs of the complete specification. As regards the objection on lack of definitiveness, the first ground for drawing such conclusion is that the expression "greater" is unclear. In response to this, learned counsel for the appellant pointed out that independent claim 1 indicates that the thickness of the exterior surface should be greater than that of the central portion by at least 1% and not more than 50%. This aspect has also not been taken into account in the impugned order. Even if the respondent were of the opinion that the specified range is too wide, it is always possible to call upon the patent applicant to amend the claim and the complete specification suitably. As regards the second ground relating to definitiveness, i.e. the



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conclusion that the expressions "exterior surface" and "central region" were not clearly defined, learned counsel for the appellant responded to this by referring to the written submissions and the diagrammatic representations set out therein. On this issue, it is again possible for the respondent to call upon the patent applicant to incorporate such explanation in the complete specification.

7. The conclusion with regard to the lack of inventive step in the impugned order is completely unreasoned and such conclusion is drawn without any prior art reference.

8. In the above circumstances, the impugned order is unsustainable and is, hereby, set aside. As a corollary, the patent application is remanded for re-consideration on the following terms and conditions:

(i) In order to preclude the possibility of pre-determination, an officer other than the officer who issued the impugned order shall



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undertake such re-consideration.

(ii) After providing a reasonable opportunity to the appellant, including an opportunity to amend the claims or complete specification, as deemed necessary and appropriate, a reasoned decision shall be issued within a period of ***six months*** from the date of receipt of a copy of this order.

(iii) It is made clear that no opinion is being expressed herein on the merits of the application.

9. CMA(PT)/8/2023 is disposed of on the above terms without any order as to costs.

**24.11.2023**

rna
Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes/No



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**SENTHILKUMAR RAMAMOORTHY,J**

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**CMA(PT)/8/2023**



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