

(2023) 01 DEL CK 0081

In the Delhi High Court

Case No : C.A.(COMM.IPD-PAT) No. 435 Of 2022

Alfred Von Schukmann

APPELLANT

Vs

Controller General Of Patents, Designs And Trademarks And
Ors

RESPONDENT

Date of Decision : 12-01-2023

Acts Referred:

Patents Act, 1970 — Section 2(1)(j), 2(1)(ja), 117A

Citation : (2023) 01 DEL CK 0081

Hon'ble Judges : Amit Bansal, J

Bench : Single Bench

**Advocate : Rohit Rangi, Debashish Banerjee, Vineet Rohilla, Ankush Verma,
Asheesh Jain, Gaurav Kumar, Vishal Kumar**

Judgement

Amit Bansal, J

1. The present appeal has been filed under Section 117-A of the Patents Act, 1970 impugning the order dated 3rd August, 2017 passed by the Assistant Controller of Patents in Indian Patent Application No.3845/DELNP/2007 (hereinafter "subject application") filed on 10th May, 2007 for the invention titled "Step-Action Indexing Mechanism" (hereinafter "subject invention").

2. Brief facts relevant to decide the present appeal are as follows:

2.1 The appellant had filed the subject application on 10th May, 2007 at the Patent Office, New Delhi.

2.2 The subject application was filed as a national phase application under the Patent Cooperation Treaty (PCT) claiming priority date of 10th November, 2004.

2.3 The Patent Office issued a First Examination Report (FER) on 22nd November, 2013 and raised various objections, particularly an objection relating to lack of novelty and inventive step in terms of Section 2(1)(j) of the Patents Act, 1970.

2.4 A detailed response was filed on behalf of the appellant to the aforesaid FER,

wherein the appellant distinguished the subject invention from the prior art. Subsequently, various hearing notices were issued by the Patent Office to the appellant, wherein once again an objection was taken with regard to lack of inventive steps in view of the prior art, D1, D2 and D3.

2.5 The appellant filed written submission on 15th May, 2017 dealing with the prior art cited by the Patent Office and it was explained how the subject invention is discernible from the prior art. It was also stated that the subject invention has been granted patent in China, Mexico, Canada, USA and EPO.

3. The impugned order was passed by the Patent Office on 3rd August, 2017 rejecting the subject application on the ground of lack of inventive steps under Section 2(1)(j) read with Section 2(1)(ja) of the Patents Act, 1970. The relevant observations of the impugned order are set out below:

"I opine as follows:

1. Objection 2 be waived off.

2. Amended claims 1-11 lacks in inventive step u/s 2(1) (j) read with 2(1) (ja) as they shall be obvious to a person skilled in the art when taught by the cited documents in combine D1, D2 and D3.

Therefore, this application is refused patent over amended claims 1-11, u/s 15 of "The Patent Act 1970".

The Application stands disposed off."

4. Counsel appearing on behalf of the appellant submits that detailed submissions were made on behalf of the appellant in response to the FER as well as the written submissions, wherein the subject invention has been distinguished from the prior art cited by the Patent Office. However, the Patent Office has passed a cryptic order without dealing with any of the submissions made on behalf of the appellant. In this regard, reliance is placed on 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 and the judgment dated 27th September, 2022 in C.A.(COMM-IPD-PAT) 8/2022 titled Auckland Uniservices Limited v. Assistant Controller of Patents and Designs to submit 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 subject art.

5. Per contra, counsel appearing on behalf of the respondent submits that the appellant has failed to provide any justification or grounds for distinguishing the subject invention from the prevailing prior art. He further submits that additional grounds have been taken in the appeal which were not a part of the written submissions filed earlier.

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

7. At the outset, reference may be made to the relevant observations of this Court in *Agriboard International* (supra), which 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 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 Id. Counsel having not been considered in the impugned order, the Court does not wish to render any opinion in this regard."

[emphasis supplied]

8. The judgment in *Agriboard International* (supra) has been followed by a Coordinate Bench of this Court in *Auckland Uniservices* (supra) and also by me in *N.V. Satheesh Madhav and Anr v. Deputy Controller of Patents and Designs*, 2022 SCC OnLine Del 4568.

9. 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 different from the prior art. The relevant portion of the written submissions is as under:

"Regarding objection 1, we respectfully resist the objection and at the outset, submit that claimed step-action indexing mechanism is novel and inventive and

not a modification of the prior art indexing mechanisms.

XXX XXX XXX

Additionally our comments on the cited documents vis-a-vis the present inventions are as follows:

US 2003/0178020 A1

US'020 A1 shows a completely different gear mechanism than claimed in the present application. The drive member 86 has a toothed wheel 82, which is the only drive means for all the embodiments shown. Upon pressure on the cap part 220 (by means of a hand of a user) the drive means 238 do put pressure on a tooth 88 and thereby do turn the wheel 82. The part 48 is only to avoid anti-return. There is no sun gear seated on a disk which is toothed on underside. In fact, there is no planet gear mechanism.

It seems that the Learned Controller is referring to figure 56 which seems to show something like a planet gear mechanism, there is no description that the parts indeed function as a planet gear. The part 2500 is described in the description in paragraph 161 as being a usage indicator member having a hub (which however is only shown in figure 50) and being connected with the rib 2526 with the hub 2520 (paragraph 162).

However, there are no indexing fingers extending from a central hub and being directed obliquely upward in the form a secant which indexing fingers at the occasion of an actuation movement would be sliding upward with rotary action in lateral wall slots of a ring in order to cause the stepwise rotary advancement of a saw toothed disc.

US 2004/ 0211420 A1

US'420 A1 shows also two rounded parts intermeshing like a gear. The one part is a tens wheel 34 having the teeth 62 and the other part is the transmission wheel 74 having below teeth and above a kind of teeth. This transmission wheel, called slave wheel 32, has a fixed axle on the cover 36 and is moved by the unit wheel 30 in order to move the tens wheel 34 one digit upon respective revolution of the unit wheel 30.

There is neither a sun gear nor a planet gear radially outside the sun gear which would be driven by the sun gear. Rather the transmission wheel 32 is driven by the unit wheel, see protruding part 88, upon respective turning of the unit wheel.

A number of features of present claim 1 are missing from this reference, especially the plurality of indexing fingers extending from a central hub and being directed obliquely upward in the form of a secant. Further is missing a planet gear as outlined and of course the specific features concerning the sun gear with the toothed underside etc. Especially also are missing the features concerning the slots in a lateral wall of a ring part in which the indexing fingers are sliding upward with rotary action upon actuation.

The still further cited reference EP'488 A1 is possibly cited because there are some kind of fingers 16. However these parts are unitary, see reference numeral 20, with the indicating member 17. These fingers are flexed upon actuation in vertical direction of the part 8 such that they bend as shown in dashed lines in figure 4. The upper extension 14 is therefore jumping some teeth further and, upon return movement of the upper part in the starting position, the indicating member 17 is turned thereby.

Comparing the disclosure of this reference now with claim 1, it may seem that the parts maybe qualifying as indexing fingers, however, they are not directed obliquely upward in the form of a secant. Further, the planet gear mechanism with all the details mentioned in the claim is missing There is further missing the ring part in terms of its slots and these slots being in diametrically opposite regions.

Further there are no slots extending obliquely upward in the indexing direction and opening downward in the direction of the angular edge of said ring part. Still further the indexing fingers are not sliding upward with rotary action in the lateral wall slots of the ring to (thereby) cause the stepwise rotary advancement of the saw toothed disc.

Due to the very different embodiments and functionalities, no combination of these references would have been obvious at the priority date of present application.

Moreover, even if one would make such combination, such combination would not have led to the combination of the features now in claim 1."

10. Despite the above submissions seeking to distinguish the prior art from the subject invention, 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 prior art. The impugned order simply runs to a conclusion that the subject invention lacks inventive steps. However, there is no discussion as to why the subject invention would be hit by the prior art D1, D2 and D3. When viewed in light of the proposition of law laid down in the aforesaid judgments, the impugned order is completely cryptic and does not give any reasoning or justification to arrive at the finding that the claims of the appellant lack inventive steps.

11. In view of the above, the impugned order dated 3rd August, 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 submissions filed on behalf of the appellant with regard to the prior art.

12. At this stage, counsel for the appellant submits that upon remand, the matter be placed before a different Officer and in this regard places reliance on

the judgment dated 14th December, 2022, passed by a Co-ordinate Bench of this Court in Art Screw Co. Ltd v. Assistant Controller of Patents and Designs, 2022 SCC OnLine Del 4429.

13. In the facts and circumstances of the present case and in order to obviate the possibility of any apprehension of pre-determination, I deem it appropriate that the matter be placed before an Officer other than the Officer who has passed the impugned order.

14. The Officer shall endeavor to pass a reasoned order taking into account all the relevant considerations within four months.

15. 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.