

(2012) 06 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : OA/4/2007/PT/DEL And OA/17/2010/PT/DEL

Magotteaux International S.A. (Belgium), C/o Dr. Ramesh Kumar Mehta, Authorised Registered Patent Agent, Mehta & Mehta Associates, B474, Sushant Lok-I, Sector 27, Gurgaon - 122002, Haryana And Others **APPELLANT**

Vs

Assistant Controller of Patents & Designs, Office of the Controller of Patents & Designs, Intellectual Property Office Building, Plot No. 32, Sector 14, Dwarka, New Delhi - 110075, The Controller General of Patents, Designs, And Trade Marks, Government of India, Ministry of Commerce and Industry, Baudhik Sampada Bhawan, Near Antop Hill Head Post Office S.M.Road, Antop Hill, Mumbai - 400037 and AIA Engineering Ltd., B-5/20, 2nd Floor, Safdarjung Enclave, New Delhi - 110029 And Others **RESPONDENT**

Date of Decision : 01-06-2012

Acts Referred:

Patents Act, 1970 — Section 11A, 78, 78(4)

Citation : (2012) 06 IPAB CK 0002

Hon'ble Judges : Prabha Sridevan, J;D.P.S. Parmar, Technical Member

Bench : Division Bench

Final Decision : Allowed

Judgement

Prabha Sridevan, J

1. These are cross appeals filed by the parties who are both aggrieved by the order dated 30.03.2007. We will refer to the appellant in

OA/4/2007/PT/DEL as the applicant because it is the patent applicant and the appellant in OA/17/2010/PT/DEL will be referred to as the respondent.

The application for patent No. 197257 was filed on 29.09.1997 in the name of the inventor Mr. Hubert Jacques Francois. Form 6 was then filed on

18.07.2002 and the application was allowed to proceed in the name of the

applicant herein. The application was examined and found in order for grant which was published on 03.06.2005. A request under S. 78(4) was filed on 2. 07.2005 to carry out clerical corrections and amendments. Four amendments were sought for in the complete specifications and the claims. In the impugned order all the four were reversed. The applicant has filed an appeal against the reversal of the three amendments and for some reason the respondent has filed an appeal under the impression that the words ""consisting of"" has been amended to ""comprising of"".

2. The invention is a composite wear component. The application for grant of patent was filed on 29.09.1997. The First Examination Report (FER) was sent on 9. 02.2004. The last date for putting the application in order was 09.02.2005. The applicant sent its response on 04.02.2005, and according to the impugned order since the date for putting the application in order for grant was due to expire on the same day, the applicant's agent was allowed to amend the claims on that day. It was found in order on the same day. The application was published u/S 11(A) of the Patents Act, 1970 on 03.06.2005. A request u/S 78(4) was filed on 02.09.2005 to carry out what were called clerical corrections. The then Controller allowed them on 6. 09.2005. The file noting allowing the grant of patent was completed on 2. 12.2005. On 18.01.2006, the respondents filed an application to review this order. It was dismissed on 28.02.2006 holding that it was not maintainable since no fees was paid and that the applicant has only requested for rectification of a clerical error to replace the word ""roller"" with ""pad"" and that the publication in the Indian Patent Journal dated 03.06.2005 the extract uses the word ""consisting of solid solution"" and ""weight"" (already the term ""pad"" is used instead ""roller"" on 03.06.3005). The order also said that the remaining two amendments were called for by him before the grant of patent and therefore, the review petition was dismissed.

3. Then the respondent addressed the Controller of Patents on 12.04.2006. It brought to the notice of the Controller that for the first time it had learnt that amendments were effected at the instance of the Office and that it was seriously aggrieved. This letter also stated that the applicant, taking advantage of the amended specifications, has filed a suit against the respondent for infringement. The respondent, therefore, sought for withdrawal of

the order dated 28.02.2006. On 02.05.2006 an office communication was sent by Mr. Manohar Singh, Assistant Controller of Patents and Designs,

New Delhi to the agent of the applicant marking a copy to the respondent stating that ""upon review of above application for patent by the Office of

the Controller General of Patents, Designs and Trade Marks, it has been observed that large scale technical amendments have been carried out

beyond the scope of the original disclosure and that the patent granted is nullified and the Letters Patent issued stands withdrawn"".

4. It is very curious to see that the same officer Mr. Manohar Singh who had earlier by order dated 28.02.2006 rejected the review on the ground that

the amendments were called for by him and the rectification of the word ""roller"" with ""pad"" was allowed by him and has now made a U-turn in this

order observing that ""large scale technical amendments have been carried out"". We are unable to understand how the same officer can pass two such

orders.

5. Be that as it may, the applicant aggrieved by this order, moved the Hon'ble Delhi High Court. The respondent was impleaded as an intervener. The

learned judge held that the principles of natural justice were violated in hearing of both the applications, which were disposed on 28.02.2006 and

02.05.2006. Then, a consent order was passed by the Hon'ble Delhi High Court directing the Assistant Controller to pass orders not later than July

2006 and that the status-quo as was existing on 18. 01.2006 must be maintained. This meant that the nullification of the patent was set aside and the

matter stood as it was on a granted patent with the allegedly illegal amendments.

6. Thereafter there was a hearing on 19.07.2006. The same Assistant Controller now held that the review application filed dated 18.01.2006 was not

maintainable and the second review petition is also not maintainable in view of the pendency of the suit No. 189/2006. Now it was the respondent's

turn to move the Hon'ble Delhi High Court. The learned judge who heard this has recorded that there is a ""confusion whether any order was or was

not passed on 06.09.2005 and the authorities themselves had taken conflicting stands. At first they took a stand that no order was passed on

06.09.2005. Then it was modified to no formal order was passed on 06.09.2005."" The learned judge observed that ""some order was passed but there

had been no real adjudication on merits in pursuance to the order passed on 10.05.2006". Thereafter it was remanded back to the Assistant Controller

for adjudication on merits who has passed this order on 30.03.2007, which is impugned herein. Now the applicant moved the Hon'ble Delhi High

Court, where the Delhi High Court observed that the impugned order relates to only three amendments and the petitioner may move the Intellectual

Property Appellate Board for disallowance of the same. As regards the fourth amendment which relates to ""consisting of"" becoming ""comprising of

the Learned Judge observed that this is not objected to. There was also an issue relating to the then Technical Member being part of the Board and

that was also resolved by the Hon'ble High Court. Then the respondent moved the Division Bench since according to it the fourth amendment should

not be allowed and they had never conceded to it. The learned Judges disposed of the appeal, observing that ""this issue may be raised in a cross

appeal and the IPAB shall decide the issue on its own merits without being influenced by any observation of the High Court."" Therefore, the matter

has come back to us for hearing the challenged order dated 30.03.2007.

7 . According to the learned Senior Counsel Sri Mihir Joshi appearing for the respondent, the four amendments, namely, ""solid solution"" to

homogenous phase"", ""consisting of"" to ""comprising of"", ""weight"" to ""volume"" and ""roller"" to ""pad"" are not clerical errors and they go beyond the

purview of S.78 of the Act. The learned senior counsel explained what is a clerical error and the rectification of terms which change the scope of the

claim cannot be termed as clerical error. The learned senior counsel submitted that errors of translation cannot be called clerical error. The

explanation given by the applicant is that the word used by the inventor in the French version was GALETTE but by a mistake the translator had used

the word which was the meaning for GALET. GALET meant 'wheel' whereas GALETTE is a 'cake' and therefore pad was the correct word and not

roller. According to the learned senior counsel such errors of translation cannot be considered as clerical error and relied on 1962 (RPC) 182 Maere's

Application (Clerical error). The learned counsel also submitted that in a stand alone patent application like the present application there cannot be a

translation error. As regards the amendment of ""consisting of"" to ""comprising of"", the learned counsel submitted that if the invention refers to

substances and that it consisted of two substances, then it excludes all other substances except the two mentioned in the specification whereas if the words "comprising of" the two substances are used, then there could be addition of substances and it is really not restrictive. Therefore, anybody who introduces one or two more substances in addition to the two substances mentioned in the specification would become vulnerable to infringement action. The learned senior counsel submitted that "consisting of" cannot be amended to "comprising of".

8 . The learned senior counsel then submitted that with regard to the change from weight to volume, weight would be more appropriate and in any way what was originally measured by weight and brought together cannot be now changed to measurement by volume.

9 . The next amendment relates to "homogenous solid solution" to "homogenous phase". According to the learned senior counsel, "homogenous solid

solution" was used all along in the specification and he had also referred to the affidavit by the inventor himself before the US Patent Office. Here he

had claimed that the combination of aluminium oxide (Al_2O_3) and zirconium oxide (ZrO_2) in the form of homogenous solid solution is the invention

itself. Therefore, now the word "homogenous phase" cannot be brought in since they are not interchangeable. These objections were raised with

regard to the merits of the amendment.

10. As regards the procedural errors, the learned senior counsel submitted that there is no documentary evidence to show that the Controller called for

any amendment. On facts the application was put in order on 09.02.2005. The specification as published contained the words "consisting of", "roller",

weight" and "solid solution". Therefore, the changes carried out must be subsequent to 09.02.2005. The learned counsel submitted that the power of

the Controller to call for amendments comes from S.15 and once the Controller had put the application in order for grant, his power to call for

amendment ceases. Any order for amendment thereafter would be subject to S.57 and S.78 of the Act which are amendments sought by application

and power of Controller to collect clerical errors respectively. The learned senior counsel submitted that no amendment on oral application or oral

direction can be justified. He relied on certain judgements.

11. The learned counsel appearing for respondent submitted at the outset the cross appeal had been filed without the requisite court fee and the court fee was paid long thereafter. Therefore, the question of delay may arise and without condonation of delay, the cross appeal could not have been entertained.

12 . The learned counsel then submitted that if the whole specification is read, it would be clear that what was meant was ""pad"". He also showed the sheet where the diagrams were drawn where clearly the word GALETTE was used. He submitted that therefore it is clear this is a pure error that had crept in on account of translation and the documents and the specification only indicate a pad like feature and not a wheel like feature. There is no justification not to allow this correction. As regards ""homogenous solid solution"" and ""homogenous phase"" he pointed out that this really is not an amendment that went beyond the scope of the original specification and therefore must be allowed.

13 . Next he submitted that the same applies to change from the ""weight"" and ""volume"". As regards the change from ""consisting of"" to ""comprising of"", the learned counsel submitted that the specification shows that the combination of Al₂O₃ and ZrO₂ in the ratio 20 to 80% of Al₂O₃ with 80 to 20% ZrO₂. There may be other oxides present namely 3% or 4%. It was only to allow for this that the word ""comprising of"" is used and this was suggested by the Controller to bring it in line with the specifications. The learned counsel further submitted that they do not have any information regarding the order dated 06.09.2005 and that it was only the respondent who moved the Controller for review of order dated 06.09.2005 and therefore obviously there must be some order passed on 06.09.2005.

14. The applicant highlighted the changes undergone as follows: MIIs revised claims in September, 2005:

Claim 1: Composite Wear Component produced by casting and consisting of a metal matrix whose working face or faces include inserts which have a very high wear resistance, characterized in that the inserts consist of a ceramic pad, this ceramic pad being composite, comprising of a homogenous phase of 20% to 80% of Al₂O₃ and 80 to 20% of ZrO₂, the percentages being expressed by weights of the constituents, and the pads then being impregnated with a liquid metal of the kind such as herein described during the

casting wherein the content of ceramic material in the insert is between 35 and 80% by volume.

Claim 2: Composite Wear component according to Claim 1, wherein the ceramic pad has from 55 to 60% by weight of Al_2O_3 and from 38 to 42% by weight of ZrO_2 .

Claim 3: Composite Wear component according to Claim 1, wherein the ceramic pad has from 70 to 77% by weight of Al_2O_3 and from 23 to 27% by weight of ZrO_2 .

Claim 4: Composite Wear component as claimed in any one of the preceding Claims, wherein the content of ceramic materials in the insert is between 35 and 80% by volume and advantageously of the order of 50% by volume.

Claim 5: Composite wear component as claimed any one of the preceding claims, wherein the inserts consist of an aggregate of composite ceramic grains which have a particle size within the range F6 to F22 according to the FEPA standard.

Claim 6: Composite wear component as claimed in any of the preceding claims, wherein the ceramic grains are manufactured by electrofusion, by sintering, by flame spraying.

Claim 7: Composite wear component as claimed in any one of the preceding claims, wherein the ceramic grains are joined integrally with the aid of an inorganic or organic liquid adhesive with a view to the production of ceramic pad.

Claim 8: Composite wear component as claimed in claim 7, wherein the pad does not contain more than 4% of adhesive.

Claim 9: Composite wear component as claimed in claim 1, wherein at least two ceramic pads are placed side by side, leaving a minimum gap between them.

Claim 10: Composite wear component wherein this minimum gap is component as claimed in claim 9 of the order of 10 mm in order to permit the arrival of the liquid metal.

Claim 11: Composite wear component as claimed in Claim 1, wherein the ceramic pad is in the form of a honeycomb structure in which the various cells are of polygonal or circular shape within the ceramic phase.

Claim 12: Composite wear component as claimed in claim 11, characterized in that the thickness of walls of the various cells constituting the ceramic

phase varies from 5 to 25 mm.

Claim 13: Composite wear component substantially as herein described with the help of foregoing examples and with reference to and as illustrated in the accompanying drawings

15. We have the affidavit of Mr. B.P.Singh working as Assistant Controller filed in CM 1152 of 2006 which is the proceedings filed before the

Hon'ble Delhi High court which was disposed of on 20.12.2006. The learned counsel for the respondent submitted that we cannot look at this, since

the impugned order challenged in the CM was set aside. In view of the confusion that prevails over what actually happened we have the affidavit

sworn to by the respondent's officer in a proceeding what may be looked at. In para 3 of his affidavit he has narrated the relevant dates and events.

He has stated that on 02.09.2005, an application for amendments u/S 78 of the Patent Act was received and that it was stated that an amendment

was on account of translation error. The officer has stated that all the four amendments were claimed on 2. 09.2005 and on 06.09.2005 all the four

amendments were allowed by the concerned officer and on 02.12.2005 the patent number was allotted.

16. Claims as originally filed read as follows:

Claim 1: Composite Wear Component produced by casting and consisting of a metal matrix whose working face or faces include inserts which have a

very high wear resistance, characterized in that the inserts consist of a ceramic roller, this ceramic roller consisting of a homogenous solid solution of

20% to 80% of Al_2O_3 and 80 to 20% of ZrO_2 , the percentages being expressed by weights of the constituents, and the roller then being impregnated

with a liquid metal during the casting.

Claim 2: Composite Wear component according to Claim 1, characterized in that the ceramic material includes from 55 to 60% by weight of Al_2O_3

and from 38 to 42% by weight of ZrO_2 .

Claim 3: Composite Wear component according to Claim 1, characterized in that the ceramic material includes from 70 to 77% by weight of Al_2O_3

and from 23 to 27% by weight of ZrO_2 .

Claim 4: Composite Wear component according to any one of the preceding Claims, characterized in that the content of ceramic materials in the insert

is between 35 and 80% by weight, preferably between 40 to 60% and advantageously of the order of 50%.

Claim 5: Composite wear component according to any one of the preceding claims, characterized in that the inserts consist of an aggregate of

composite ceramic grains which have a particle size within the range F6 to F22 according to the FEPA standard.

Claim 6: Composite wear component according to any one of the preceding claims, characterized in that the ceramic grains are manufactured by

electrofusion, by sintering, by flame spraying or any other process.

Claim 7: Composite wear component according to any one of the preceding claims, characterized in that the ceramic grains are joined integrally with

the aid of an inorganic or organic liquid adhesive with a view to the production of ceramic roller.

Claim 8: Composite wear component according to claim 7, characterized in that the roller does not contain more than 4% of adhesive.

Claim 9: Composite wear component produced by casting and composed of a metal matrix including at least one ceramic roller characterized in that at

least two ceramic rollers are placed side by side, leaving a minimum gap between them.

Claim 10: Composite wear component according to claim 9 characterized in that this minimum gap is of the order of 10 mm in order to permit the

arrival of the liquid metal.

Claim 11: Composite wear component produced by casting and made up of a metal matrix including a wear-resistant ceramic roller, characterized in

that the ceramic roller is in the form of a honeycomb structure in which the various cells are of polygonal or circular shape within the ceramic phase.

Claim 12: Composite wear component according to claim 11, characterized in that the thickness of walls of the various cells constituting the ceramic

phase varies from 5 to 25 mm.

Claim 13: Composite wear component substantially as hereinabove described with reference to the accompanying drawings.

It is relevant to note that the words ""roller"" is also found in claim 7, claim 8, claim 9, and claim 11.

17. There is a confusion regarding whether any order was passed on 06.09.2005. The Hon'ble Judge of the Delhi High Court has said that some order

was passed but there was no adjudication on merits. We are unable to comprehend how an officer who is discharging a quasi-judicial power can pass an order which is not found in the records. It was not communicated to the applicant herein. The only clue that we have that some order must have been passed is because a review application was filed by the respondent. The order of the Delhi High Court states that the officer in the Patent Office are approbating and reprobating. The amendment of the specifications has a vital importance on the grant and on the invention itself. Therefore, any order by which amendments are granted must be found in the records and must be communicated to the parties concerned. The records shall also indicate whether the amendment was at the instance of the Controller or sought for by the applicant. Putting these facts down on record cannot be difficult. But it will definitely contribute to greater transparency and more importantly prevent the kind of litigation that this patent has generated.

18. This matter has gone to the High Court several times and mainly because no one including the Patent Office knew what was happening. There is uncertainty regarding any order being passed on 06.09.2005. There is no clarity regarding the number of amendments sought for by the applicant. There is no clarity as to which were the amendments suggested by the Controller or the Examiner. There is no certainty regarding the dates on which these applications were made or the suggestions were given.

19 . According to the applicant, the only amendment that they sought for on the ground of clerical error is the amendment from the 'roller' to 'pad', whereas the affidavit filed by Mr. B.P. Singh before the Hon'ble Delhi High Court appears to suggest that they placed all the four amendments under the clerical error category. We earnestly hope that this vagueness and uncertainty will not shroud the proceedings in the Patent Office hereafter. It will not contribute to the health of the institution.

20. The order of amendment herein appears to indicate to us that ""consisting of"" cannot be arbitrarily changed to ""comprising of"". Therefore we really do not understand why the respondent has filed the appeal. Even at the end, the officer has said that the application for patent will proceed on the basis of whatever was found in order for grant except for the phrase ""comprising of"" which will be substituted by ""consisting of"". This is what the respondent wants. In any event, we shall now deal with each of the amendments

sought for.

21. The first amendment relating to change from ""roller"" to ""pad"". The annexure to the complete specification where the figures are depicted we find

the words ""GALETTE CERAMIQUE INFILTREE"". Fortunately for us, this phrase has not been translated. So we have at least this to guide us what

the original French specifications by the inventor would have contained. The dictionary has been produced to show that this means cake, something

like a pad or flat surface. GALET, on the other hand, means a wheel which may be translated as roller. Further, at page

6 of the specification as originally filed and page 7 of the specification as granted we find in the para starting ""In the particular case"", a sentence which

is extracted below:

In the particular case where the thickness of the roller made of a ceramic material becomes considerable, two or more superposed based rollers made

of ceramic material will be proposed, according to a first embodiment, these being separated by a minimum gap of the order of 10 mm in order to

permit the arrival of the liquid metal. This makes it possible thus to obtain the correct infiltration of the various rollers.

22 . Wherever the word ""roller"" appears was changed to ""pads"". Now the words superposed ""rollers"" clearly show that what the inventor must have

meant is GALLETTES i.e. pads, layers or pads kept superposed over each other allowing the liquid material to infiltrate them. It cannot be rollers. It

has to be only pads. This is clearly a clerical error in the sense that it is a wrong translation and we do not see how this correction would change the

scope of the invention. The Figures shown are also not of rollers, but only flat pad like features. Therefore, the amendment changing ""the ceramic

rollers"" to ""pads"" must be granted.

23. Next comes the amendment changing ""solid solution"" to ""homogenous phase"". The original complete specification speaks only of solid solution.

Though in the main characteristic element of the invention it is stated that the inserts will be of a ceramic material consisting of a solid solution or

homogenous phase, in the claim what is mentioned is homogenous solid solution. In addition we have the affidavit of the inventor Hubert Jaques

Francois as declared before the US Patent Office. The relevant portions of which are extracted hereunder:

4 . In the prior art, metal salts precursors are used to impregnate metal oxides (Larmie), in a preparation process for abrasive grains, used on abrasive machine tools. In Tamura Akira and Wahl, no mention is made of any impregnation or infiltration. The particles are coated and not impregnated.

Furthermore, no solid solutions of Al_2O_3 / ZrO_2 are used. The use of pure Al_2O_3 leads to "hot tearing", which means a crack appearing in the last section of the casting to solidify in which constraints are present. This is due to differential thermal expansion of the metal and the ceramic padding (insert). Pure Al_2O_3 padding leads to high hardness but, unfortunately, also high brittleness and fragility. The use of pure ZrO_2 increases the tenacity but decreases the resistance to wear because of a low hardness.

5 . In our invention homogenous solid solution of both ceramics meets the advantages of both Al_2O_3 and ZrO_2 without exhibiting the inconvenient hot tearing and grain peeling. An unexpected synergy is the result of this solid solution which exhibits better results than each single component contribution especially when embedded in the cast iron or steel matrix.

6. In practice, a lot of combinations of Al_2O_3 / ZrO_2 have been experienced by me and factors like expansion and shrinking, during the cooling phase, are of major importance in this field. The optimum proportions has been obtained empirically. Only solid solutions of Al_2O_3 / ZrO_2 in proportions of 80/20 to 20/80 presents no "microspalling" effects. Other proportions as those defined in the invention was not able to work spalling free in the day to day business. The proportion which is finally used in practice is dependent of the specific application for which the composite wear component is intended. If tenacity is the preferred characteristic, the concentration of ZrO_2 versus Al_2O_3 will be higher, if resistance to wear is the priority, the concentration of Al_2O_3 versus ZrO_2 will be higher. Furthermore, even the balance between the $\text{Al}_2\text{O}_3/\text{ZrO}_2$ proportions are adapted to the casting metal-mix to reach more or less the same shrinking coefficients and avoid the above described tearing phenomenon in this way.

24. The inventor asserts that "only solid solutions of $\text{Al}_2\text{O}_3/\text{ZrO}_2$ in proportions of 80/20 to 20/80 presents no microspalling effects. When the inventor himself has categorically stated that the invention is the solid solution by mixing Aluminium hydroxide and zirconium oxide we cannot permit the applicant to expand their claims by substituting "homogenous phase" for "solid

solution"". So this amendment is rejected.

25. Next we come to the substitution of words ""weight"" by ""volume"". We have two complete specifications before us one marked as Annexure B (not

a certified copy of the complete specifications) and other as Annexure C (being certified copy of complete specifications). Annexure B is the

publication in the Patent Office Journal dated 03.06.2005. The application was found in order for grant on 09.02.2005 and the abstract under the head

Publication of Application found in Order for Grant read as follows:

(57) Abstract:

Composite wear component produced by casting and consisting of a metal matrix whose working face or faces include inserts which have a very high

wear resistance, characterized in that the inserts consist of a ceramic pad(s), this ceramic pad(s) consisting of a homogeneous solid solution of 20 to

80% of Al_2O_3 and ZrO_2 , the percentages being expressed by weights of the constituents, and the pad(s) then being impregnated with a liquid metal

during the casting.

This is followed by complete specifications without any marking of the Patent Office (Annexure B).

26. On that date when it was found in order for grant, the words used in the abstract are"" pads"" ""consisting of"" ""solid solution"" and the abstract stops

with the words ""during the casting"". The claim 1 as originally filed also stops with the words ""during the casting"" which read as follows:

Composite wear component produced by casting and consisting of a metal matrix whose working phase or phases include insert which have a very

high wear resistance, characterized in that the inserts consist of a ceramic roller, this ceramic roller consisting of a homogenous solid solution of 20 to

18% of Al_2O_3 and 80 to 20 % of ZrO_2 , the percentage being expressed by weight of a constituents, and the roller than being impregnated with a

liquid metal during the casting.

27. In the complete specification with Annexure B claim 1 is exactly same as abstract reproduced above upto the words ""during the casting"" and

thereafter this is followed by additional phrase which reads as follows:

Wherein the content of ceramic roller in the insert is between 35 to 80% by weight of Al_2O_3 and ZrO_2 "" and in Annexure C which is a certifies copy

of Patent under 19725 as granted by the Patent Office, the phrase after ""during the casting"" has become ""where in the content of the ceramic material

in the insert is between 35 to 80% by volume.

28. We are unable to understand how and when the complete specification which was found in order for grant on 09.02.2005 was changed. In any

event both in claims 1 of Annexures B and C, the composite wear component as claimed in claim 2 and 3 refer only to weight even though in

Annexure C in Claim 1, the insert has ceramic material content which has been changed to volume. Claims 2 and 3 remain the same and there is no

explanation for the change except to state that the Controller suggested the change. In the impugned order, this amendment is rejected on the ground

that when the two elements are both solids the appropriate way to measure the proportion of the two elements would be by weight rather than

volume. We do not think this reasoning is wrong and we too find that there is no justification for the change from ""weight"" to ""volume"", when in the

Claim 4 as originally filed states that ""... the content of ceramic material in the insert is between 35 and by 80% by weight ... 40 and 60% ... order of

50% and the applicant claims to have merged claim 4 with claim 1 and reworded the claim 4 to specify the preferred activity and ranges. Therefore

we reject this amendment in Claim 1 and Claim 4.

29. Lastly we come to changing of ""consisting"" to ""comprising"". We have already extracted the affidavit of Mr. Hubert Francois and in this he has

only referred to those two elements namely, Aluminium Oxide and Zirconium Oxide and the main characteristic of the invention shows that the

invention is based on the finding that Aluminium Oxide and Zirconium Oxide have different properties and this makes it possible to adjust the hardness

and toughness by a judicious choice within the above mentioned ranges. Zirconium Oxide has the advantage of an expansion co-efficient and it

contributes to good toughness and thereby reducing the risk of brakeage. Aluminium Oxide on the other hand contributes to hardness and therefore,

both in combination obtain a toughness corrosion that of each of the components considered in isolation namely zircon oxide and aluminium oxide.

Therefore, it is clear that the inventor has thought of only these two elements and nothing else and therefore, if we allow the patentee to bring in the

phrase ""comprising of"" it would expand the scope of the invention. The counsel

for the respondent has produced several judgements to show when amendments can be allowed and what nature of amendments can be allowed and specifically in Ex parte Davis and Tuukkanen, 80USPQ 448 (BdPatApp&Int 1949) where it is held that ""comprising"" and ""comprising essentially"" leaves the claim open for the inclusion of unspecified ingredients even in major amounts while ""consisting of"" closes the claim to the exclusion of materials other than those recited except for impurities originally associated.

30. Now though they have sought for substituting ""consisting of"" with ""comprising of"", the learned counsel for the applicant would try to persuade us that this is included only because there might be minimal percentage of other materials whereas the above judgment in Ex parte Davis and Tuukkanen, 80 USPQ 448 (BdPatApp&Int 1949) indicates that if comprising of is used then it might leave the claim open even for major amounts of unspecified ingredients. This is why the respondent objected to this amendment because it is on this ground that he has become vulnerable to attack.

31. As regards the technical objection regarding payment of court fee for the cross-appeal, we find there is some confusion. But we are bound by the direction of the judgement of the Hon'ble Delhi Court to consider the cross-appeal. And in any event the fees has also been paid.

32. To conclude, we allow amendment of the patent specifications as follows:

- (i) Wherever the word ""roller"" is found, it shall be amended to ""pad"";
- (ii) The prayer for changing ""homogenous solid solution"" to ""homogenous phase"" is rejected;
- (iii) The prayer for changing the word ""weight"" to ""volume"" in the last sentence of Claim 1 and Claim 4 is rejected and
- (iv) The prayer for amendment of the word ""consisting of"" to ""comprising of"" in Claim 1 is rejected.

33. The application for patent is allowed to proceed on the basis of complete specifications found in order for grant on 09.02.2005 with substitution of words ""roller"" with ""pad"" which we have found to be a translation error as per para ante. The order of the Controller, therefore, stands modified to that extent. The respondent No. 3 is directed to amend the patent specification and claims accordingly and publish the same. OA/4/2007/PT/DEL is therefore, partially allowed. OA/17/2010/PT/DEL is allowed. No order as to costs.