

(2021) 01 IPAB CK 0006

In the Intellectual Property Appellate Board

Case No : Original Application No. 13 Of 2016/PT/MUM

United States Gypsum Company

APPELLANT

 V_S

Assistant Controller Of Patents And Designs

RESPONDENT

Date of Decision : 18-01-2021

Acts Referred:

Indian Patents Act, 1970 — Section 15, 57, 57(6), 59, 59(1), 117A

Citation : (2021) 01 IPAB CK 0006

Hon'ble Judges : Dr. B.P. Singh, Technical Member; Manmohan Singh, J

Bench : Division Bench

Advocate : Simran Khalsa

Final Decision : Allowed

Judgement

Counterpart

Applications", Documents,

PCT/US2005/045463

â ? " International Search

Report", "D1- Tonyan (US6620487), D2- She

(US3397497),

D4 - Lindsay (US626032)",

EP1831485,"D1- Tonyan (US6620487),

D2- Shea (US3397497)",

US11/297426,D1- Tonyan (US6620487),

US12/946855,D1- Tonyan (US6620487),

Cited Prior Arts,"NovelÂ Â andÂ Â Â Â Â Â Â Â Â Â Â Â Â Â Â Â

Inventive

Features

of

872/MUMNP/2007",

Prior Art Features

D1 " Tonyan

(US6620487)", "1a) The present invention pertains to non-combustible flooring system comprising lightweight

"Tonyan does not disclose or suggest the use of a metal frame for

attachment of the cementitious panel for use as flooring system.

Tonyan does not disclose or suggest the use of the particular metal

screw fasteners with winged drillers which have been found to

provide the required stiff attachment of

the structural cementitious panel to t

metal frame to provide a shear wall diaphragm.

3a) The cementitious panel of Tonyan is different in

composition and combustible as the use of polymer fillers in

a

Tonyan even at levels of 0.5% will make the diaphragm

combustible as determined by the test of all elements under ASTM

E136. The polymer filler of

, "structural cementitious panels (SCP

panels),

, "mechanically fastened to metal frame

flooring",
,"systems in residential and commercial construction.

1b) The use of SCP panels on a metal frame would produce a floor with the shear strength and stiffness necessary to act as a horizontal shear diaphragm while possessing a combination of unique attributes of being lightweight and non-combustible for use with a metal frame.

2) The fastener used in the present invention is metal screw fastener with winged drillers. Winged driller is located above the point and below the threads of the",
,"screw and protruding laterally from a shaft of the screw to tightly secure the panel to the metal frame and provide the recited structural load bearing flooring system.

3a) The composition of the SCP panel of the present invention differs from that of the Tonyan reference. The SCP Panels of the present invention eliminates the use of polymer fillers.

3b) Claim 1, as amended, emphasizes the use of non-combustible lightweight filler selected from the group consisting of ceramic microspheres, glass microspheres, fly ash cenospheres or perlite.", "Tonyan is combustible lightweight filler since sufficient heat would cause it to lose strength.

3b) Tonyan does not recognize the criticality of using panels having non-combustible filler as the lightweight filler to

maintain non-combustibility in the panel and flooring/ceiling system with metal framing.

3c) Tonyan does not disclose the specific gravity or the average size of the filler or the benefits of the specific composition of the panel now in the amended claims.

D2 â?" Shea

(US3397497)", "1a) The present invention pertains to non-combustible flooring system comprising lightweight

â?"1a) Shea is directed to the use of a metal deck (form), with

projections in each wall, as a support for a pour in place concrete flooring that must be cured. Shea teaches conventional concrete flooring with a metal reinforcing structure.

â?"

1b) Shea at Column. 3, lines 22-27, explains the deck (e.g. form

10) has the projections (e.g. projections

â?"15) simultaneously prevent the vertical and horizontal

displacement of concrete

â?"

when the composite

â?"

, "structural cementitious panels (SCP

panels),

, "mechanically fastened to metal frame

flooring,

, "systems in residential and commercial

construction.

1b) The use of SCP panels on a metal frame would produce a floor with the shear strength and stiffness necessary to act as a horizontal shear diaphragm while possessing a combination of unique attributes of being lightweight and non-combustible for use with a metal frame.

2) The fastener used in the present invention is metal screw fastener with winged drillers which is used to hydrate concrete-steel form beam is loaded in any manner, thereby reducing concrete slippage, while at the same time and increasing the load capacity for any given combination of projections.

1c) To use the panel of Tonyan with the frame of Shea would defeat the purpose of the Shea projections. Thus, the asserted combination of Tonyan and Shea is, penetrate the dense, structural, cementitious panel without damaging, the panel and then penetrate the

metal frame structure with the screw head while the winged drill is sheared off during the penetration of the metal frame by the screw to securely attach the panel to the metal frame.

The SCP panels of the present invention are tough and ductile which is due to the combination of the blend of matrix materials (cement, gypsum and pozzolans), the fiber reinforcement and the hollow ceramic microspheres. The ductility of the panels results in advantageous lateral fastener resistance.

The ductility and toughness of the panel allows the panels to be rigidly attached to the metal frame with penetrating fasteners at distance of as little as $\frac{1}{4}$ in from the edge of the panels without destroying the shear stiffness and load bearing properties of the panel.",
,, "improper.

The flooring of Shea is not a cementitious panel attached by fasteners to a metal frame as now recited in the amended claim 1 of

the present invention.

The concrete of Shea is hard and brittle and will fracture and chip when a winged driller type screw (fastener) is attempted to be driven in to it. The concrete of Shea is so hard that the wings of the screws are broken off before penetrating into the slab, and if the screw penetrates at all, the concrete chips and the screw does not hold as it is designed to hold.

4a) The poured concrete slab of Shea would not

5a) The SCP panels fastened to metal frames provide a wall with shear strengths and stiffness for both lateral and horizontal shear resistance.

5b) The use of SCP panels on a metal frame would produce a floor which is both light weight and non- combustible at the same time.

5c) Example 8 at page 77 of the present specification shows how, for a given span, the present invention

SCP (strengthened cementitious panels) will

provide a panel/steel frame floor structure which will

meet structural

requirements with less dead load (weight) than

a conventional

Â Â Â Â Â Â Â traditional

corrugatedÂ Â Â Â Â Â Â metal deck/concrete or pre-cast plank system.",permit the use of,

,"winged self-drillingÂ

screwsÂ so close to

its edge because the

screws will not drill

smoothly into the

concrete and instead

damage the concrete

structure. T his is

because the concrete

lacks theÂ

toughnessÂ and

uctural

ductility of the SCP

panels of the present

Â

invention.

4b) It also means that

the edge distance

between where the

fastenerÂ (screw) is

drilled and the edge

ofÂ the concreteÂ

panelÂ needs to be

greater than

Â¼â??â??.

5a) The poured in

place concrete of the

floor of Shea is much heavier and as a result of the increased weight, in seismic design zones, the lateral force resistive structure for the building with the poured in place floors would have to resist a far larger lateral force from a seismic design perspective than the present system.

5b) As result, to resist the much larger force, much larger steel framing members would be required than in the system of the present invention.

This increases costs for material and labor associated with the building with the floors of Shea as opposed to the",

, "system

of

the

present invention.",

that D2- Shea is directed to the use of a metal deck (form), with projections in each wall, as a support for a pour in place concrete flooring that must be cured.",,

that flooring in D2 -Shea is not a cementitious panel attached by fasteners to a metal frame unlike in the present application.,,

that D2 - Shea at Col. 3, lines 22 - 27, clearly explains that the "deck" (e.g. "form",,

10) "has the projections" (e.g. "projections 15) to "simultaneously prevent the vertical and horizontal displacement of concrete when the composite hydrated concrete-",,

steel form beam is loaded in any manner, thereby reducing concrete slippage, while at the same time and increasing the load capacity for any given combination of projections."",,

that to use the panel of D1 - Tonyan with the frame of D2 Shea would defeat the purpose of the D2 - Shea projections.,,

that the specific stiffness, load carrying capacity, absorption rate, and meeting the ASTM standards as well as shear capacity are critical benefits of the panel and metal",,

framing flooring system of the present invention and that these are unexpected advantages of the present invention system over prior art poured concrete flooring systems like,,

that taught in D2 "Shea.,,

"A person skilled in the art would not be motivated to combine D1 Tonyan with D2- Shea to arrive at the present invention.,,

FASTENER:,,

"The Respondent erred in holding that for fixing panel it is obvious for the person skilled in art to use screw fasteners with drillers for fixing panel over metal frame.,,

"It is not obvious for the person skilled in art to use screw fasteners with drillers for fixing panel over metal frame as alleged by the Respondent in the non-combustible flooring,,

system claimed by the Appellant for the following reasons:,,

that the screw fasteners used in the present "invention" are "winged" self-drilling screws",,

that D1 Tonyan does not teach the importance of using the claimed metal screw fasteners with winged drillers to penetrate the dense structural "cementitious

panel with

the winged drillers without damaging the panel and then penetrate the metal frame structure with the screw head while the winged driller is shear off during the

penetration of the metal frame by the screw to securely attach the panel to the metal frame. D2- Shea, D3- Macleod and D4- Lindsay do not make up for these

deficiencies.

that the wings on the bottom of the screw as claimed in the present invention bore a hole through the structural panel that has a diameter slightly larger than the shaft of the

screw. This enables the screw to drive through the panel with the panel remaining flat on the cold rolled steel and not "ride up" on the shaft of the screw.

that at the point that the screw finishes boring through the panel it pierces the cold rolled steel framing member and engages and grips into the metal framing. As the

wings of the screw reach the metal frame, they shear off. As the underside of the screw head reaches the hole bored out of the panel, the head "seats" in the hole, using

reamer ribs under the head to enable the top of the screw head to sit flat on the surface of the panel.

that the edge distance, between where the winged driller screws is drilled and the edge of the panel, needs to be greater than the $\frac{1}{4}$ ".

that the winged self-drilling screws used in the present invention as mechanical fasteners could not be used with the poured concrete floors of D2-Shea et al,

because they would damage the concrete structure due to its hard and brittle nature.

that the poured slab of D2 - Shea would not permit the use of winged self-drilling screws so close to its edge because the screws would not drill smoothly into the

concrete.

TECHNICAL ADVANCEMENT:

Easier installation and cutability,

Due to their composition the present panels can be easily attached to the metal

frame and can be easily cut while installed in place with normal cement board tools to allow for,,

installation of piping, electrical lines, boxes etc. after the flooring panel is installed. In contrast,Â significantÂ work would be required to install additional piping, electrical lines,",,

boxes etc. in poured concrete floor/ceilingÂ structures, suchÂ as in Shea (D2), while still maintaining the integrity of the structure.",,

Â Improved shear strength, lateral fastener resistance and blow out resistance",,,

As disclosed in the present specification at page 44 (second paragraph), the present cementitious panels have a higher specific stiffness, i.e., a higher unit weight measure in",,,

pounds per square ft, than conventional metal deck and poured in place cement or concrete. Moreover, data shows the present invention achieves advantageous shear strength.",,

The TABLE A (as presented below) shows the results of the test conducted related to the racking shear performance of cold formed steel framed walls using,,

FORTACRETEÂ® brand structural cementitious panels (SCP) for sheathing on cold formed steel wall. The results include both ASTM E 72 wall racking tests and AISI TS-,,

07 Cantilever Tests. The results include nominal shear strengths ranging from approximately 450 lbs/ft to 1069 lbs/ft.,,,

The results demonstrate cold formed steel wall, sheathed with FORTACRETEÂ® brand structural cementitious panels provides sufficient shear capacity to contribute",,,

significantly to resisting lateral and/or shear loads in residential and light commercial buildings. The FORTACRETEÂ® brand structural cementitious panel (SCP) is an,,

embodiment of a panel falling within the present claims.,,,

Â There is an unexpected synergy resulting from fastening the present panels to light gauge steel frames.,,,

Â Based upon the results of the testing in above TABLE A, the SCP panels (structural cementitious panels) fastened to cold rolled metal frames provide a wall with shear",,,

strengths and stiffness for both lateral and horizontal shear resistance. Accordingly, the use of the SCP panels on a metal frame would produce a floor with the shear strength",,,

and stiffness necessary to act as a horizontal shear diaphragm by possessing a

combination of the unique attributes of being lightweight and non-combustible for use with a,,

metal frame construction.,,

^ The data shows that the present invention can provide adequate shear strength with light weight. In contrast, the poured in place concrete of^ the floor of Shea et al would",,,

be much heavier. As a result of the increased weight, in seismic design zones, the lateral force resistive structure for the building with the poured in^ place^ floors^ would",,,

have to resist a far larger lateral force from a seismic design perspective than the^ present^ system. As result, to resist the much larger force, much larger steel framing",,,

members would be required than in the^ present^ system.^ This increases costs for material and labor associated with the building with the floors of Shea et al as opposed,,

to the system^ of^ the^ present^ invention. As a further illustration of this advantage, hypothetical Example 8 beginning at^ page^ 77^ of the present application shows",,,

how, for a^ given span, the present invention SCP (structural cementitious panel) panel/steel frame floor structure will meet structural requirements with less dead load",,,

(weight) than a^ traditional corrugated metal deck/concrete or pre-cast plank system.,,

The structural cementitious panel employed in the present invention provides flexible handling properties. The load versus deflection results for Samples A through D in the,,

above TABLE A, for shear stiffness for ^3/4 in. FORTACRETE^® horizontal mounted SCP panels, Samples A through D, fastened to 3 and 5/8 in. 16 gauge steel studs at 24",,,

in. on center fasteners at 6/12, show the load increases with deflection up to almost maximum load and remains at that maximum load over an extended range of deflection",,,

before failure. This demonstrates the unexpected ductility and toughness of the present SCP panels fastened to the steel stud frame.,,

It is further submitted that, ductility of the panels results in advantageous lateral fastener resistance, as shown in TABLE B below, and allows the panels to be rigidly attached",,,

to the metal studs with penetrating fasteners at distances of as little as ¼ inch from the edge of the panels without destroying the shear stiffness and load bearing properties of,

the panel.,,

TABLE B (as presented below) shows the nominal composition of all of the FORTACRETE® brand structural cementitious panels.,,

This is especially the case with the recited bugle head screw fasteners with winged drillers of amended claims and the winged self-drilling screws of claim 1. The wings,

on the bottom of the screw bore a hole through the structural panel that has a diameter slightly larger than the shaft of the screw. This enables the screw to,

drive through the panel with the panel remaining flat on the cold rolled steel and not "ride up" on the shaft of the screw. At the point that the screw finishes boring through,

the panel it pierces the cold rolled steel framing member and engages and grips into the metal framing. As the wings of the screw reach the metal frame, they shear off. As",,

the underside of the screw head reaches the hole bored out of the panel, the head "seats" in the hole, using reamer ribs under the head to enable the top of",,

the screw head to sit flat on the surface of the panel.,,

The winged driller screws are not as effective in cement bonded particle boards, or surface reinforced cement boards, since these materials lack the toughness and ductility of",,

the SCP panels of the present invention. This toughness and ductility in the SCP panel come from the combination of the blend of matrix materials (cement, gypsum, and",,

pozzolans), the fiber reinforcement and the hollow ceramic microspheres. The cement bonded particle boards have less toughness because they have a more brittle matrix,",,

larger aggregate (which tends to cause fractures in the material), and a lack of strong tough fiber reinforcement through the full panel thickness. As a result, when the winged",,

self-drilling screws are used in cement bonded particle boards or surface reinforced cement boards, the panel material fractures and "blows out" around the fastener hole,",,

reducing the holding strength of the screw. This also means the edge distance, between where the fastener is drilled and the edge of the panel, needs to be greater than the",,

¼" that the SCP panel has unexpectedly demonstrated it can maintain.,,

The resulting assembly has the screw engaged securely in the metal framing member, with the head of the screw pressing down right and flat on the surface of the panel. The",,

combination of the use of this screw and the strength and ductility in the panel, creates exceptional lateral fastener holding strength in the diaphragm, comparable to wood",,

panels such as plywood and OSB fastened to wood framing (Refer to TABLE B). This enables wall or floor assemblies with exceptional shear diaphragm strength and allows,,

the screws to be driven very near the edge of the panel without "blowing out" or breaking the panel edge.,,

The test results of TABLE C (as presented below) unexpectedly show the FORTACRETE® panels fastened to steel framing with the GRABBER fasteners provides a,,

shear diaphragm with structural capacity comparable to wood sheathed diaphragms, with the ability to screw the FORTACRETE® structural panels very close to the edge",,

of the panel, and not have a "blow out" or have a weak connection found when other cement based panels are fastened to framing.",,

Excellent fire performance,,

Table 2 on page 41 of the specification reported 2 hour fire resistance rating for embodiments of floor systems made with the SCP panels (structural cementitious panels),,

fastened to metal frames with the recited screw fasteners with winged drillers under ASTM E-119 (effective 2003).,,

At the time of development of the present noncombustible shear load bearing floor system, those of ordinary skill in the construction art were aware of both (1) shear wall",,

systems such as plywood and OSB panels and panels with cross supporting members which are combustible which do not retain their strength when exposed to fire for a,,

significant time period and (2) cement and gypsum based panels which meet conventional fire test ratings but are not shear diaphragms which cannot handle

the shear loads of,,

structural walls and floors.,,

This unexpected shear strength obtained with cementitious panels on metal frames is not taught or suggested by the cited references. Those skilled in the relevant construction,,

field did not believe a non-combustible gypsum based panel wall or floor system mounted on a metal frame would function as a shear diaphragm without an additional shear,,

diaphragm system such as plywood or OSB. They were therefore reluctant to use the panel of the present invention on a metal frame in shear diaphragm systems.,,

Unexpectedly, the present noncombustible shear wall system with fire resistance ratings of 2 hours or more have enabled SCP panel based walls to be used in Type I and Type",,,

II construction in a broad range of building occupancies in many applications previously only obtained with concrete and structural steel. In particular, the lightweight and ductile",,,

shear walls of the present invention have the racking strength and light weight for providing improved seismic performance.,,

Refused claims 3, 4 and 8, reciting high levels of calcium sulfate hemihydrate which would become gypsum in the final panel, are particularly unexpected and further",,,

commensurate in scope with the data and specification.,,

One skilled in the art would not expect to provide a shear load bearing floor system from a metal frame with an SCP panel mounted on one side with metal screw fasteners,,

with winged drillers, the winged drillers located above the point and below the threads of the screws and protruding laterally from the shaft of the screw.",,,

The combination of D1 to D4 neither teaches nor suggest the unexpected advantages of the present invention viz.: excellent fire performance, easier installation and cutability",,,

improved shear strength, lateral fastener resistance and blow out resistance.",,,

SECTION 57 & 59:,,

The Respondent erred in holding that amended claims filed on 12/09/2013 with new claims are method of providing a building structure with non-combustible flooring in,,

claims 18-20. Whereas in filed claims it was method of making the non-combustible flooring. Which is totally different?,,

Â The Respondent failed to appreciate that there is no change in the scope of the claims as filed and claims as amended, as both set of claims are for non-combustible flooring",,,

system for construction and a method for the same.,,,

Â The Respondent failed to appreciate that during the hearing claim 18 (present claim 17) was made dependent on claim 1 and claims 19 and 20 were deleted. Claim 18,,

(present claim 17) shares the entire features of claim 1 and is restrictive in nature. The change in preamble is definitive which is followed by â??method of making the non-,,,

combustible flooringâ?? as main feature of claim 18 (present claim 17).,,

Â The Respondent ought to have appreciated that:,,

the amended claims are properly supported in the description and claims as filed.,,,

the support for the amendments was clearly presented in the Annexure 1 enclosed in the written submissions to the hearing being Exhibit H.,,,

the amendments have in fact narrowed the scope of the claims without sacrificing the original intended object of the present invention.,,,

no new matter has been added to broadenÂ the scope of the present invention by way of amendment.,,,

Â The Respondent ought to have appreciated that the amendment carried out in the claims was made under the rights available to the Appellant under Section 57(6) of the Act,,

in order to overcome the various objections raised in the First Examination Report, especially to overcome the novelty and inventive step objection, particularly based on the",,,

cited prior art documents viz. D1- Tonyan, D2 â?"Shea, D3-Macleod and D4-Lindsay.",,,

Â The Respondent ought to haveÂ appreciatedÂ that the Appellant had amended the claims toÂ distinguish over the cited references D1 to D4 and include the following,,

features:,,

Metal screw fasteners with winged drillers,,

A very specific composition of the SCP panel,,

A horizontal design shear capacity of the floor shear diaphragm of 300 to 1000 pounds per linear foot,,

The cementitious panel has a thickness of 1/4 to 1 1/2 inches,,

The amendment was madeÂ by way ofÂ explanation to further define and explain the distinguishing features of the invention over the closestÂ priorÂ arts, satisfying the",,,

first condition of Section 59(1).,,

Â The invention is described in the entire complete specification and its legal boundaries are definedÂ by the claims. The â??actual factâ?Â that was included is provided in,,

the enclosed Annexure 1 and thus satisfies the second condition of Section 59(1).,,

Â The Respondent failed to appreciate thatÂ as pointed out in the Annexure 1 of Exhibit H, the amendment in fact added limitations which were supported by the originally",,,

filed specification and thus meeting the third requirement of SectionÂ 59(1).,,

The Respondent failed to appreciate that by amendment the scope of the claims was in fact limited in that the composition of the SCP panel is now very specific and narrow,,

with respect to what was already claimed in original claim 1 and that the SCP panel is fastened to metal frame (already claimed in original claim 1) by a very specific fastener,,

(i.e. metal screw fasteners with winged drillers) and thus meeting the fourth requirement of Section 59(1). No new matter was introduced/added in the claims or the,,

specification. ,,

Â The amendments carried out in claims were (a) Fully within the scope of the original claims; (b) Fully supported by the original description; and (c) Fully within the scope of,,

theÂ inventionÂ asÂ originally conceived. ,,

Â The Respondent erred in holding that new composition data was added in table 2A and 18A of the specification. The Respondent failed to appreciate that in earlier,,

composition in table were filed as weight proportion (%) and single data was given for each component; whereas after amendments tables were modified only to the extent that,,

earlier data was converted from weight proportion wet basis (%) to weight proportion dry basis (%) only for ceramic microspheres,,

microspheres mentioned in Table 2A and 18 A, and explained in annexure I of Exhibit H.",,,

The weight proportion was recited in dry basis (%) format in the original claims and therefore, in order to maintain consistency in the claims throughout the weight proportion",,,

in wet basis (%) for ceramic microspheres was converted to weight proportion in dry basis (%).,,

The amendments find its support in the description when read with the drawings and are well within the scope of original disclosure.,,,

5. The operating portion of the order of the respondent is as follows:,,

Conclusion Amended claims filed on 12/09/2013 with new claims method of providing a building structure with non- combustible flooring in claims 18-20. Whereas in filed,,

claims it was method of making the non-combustible flooring. Which is totally different? Which were not submitted in-line with the original filed claims by strictly adhering to,,

section 57/59 of The Patent Act. Amendments made are not allowable U/s 57 and 59. No request for voluntary amendments (form-13) as per provisions of The Patent Act,,

was filed with reply submission by applicant. It is not supported by specification (as filed on 11/06/2007) also. After hearing given by controller U/s 14 on dated 18/05/2015 the,,

agent files submission of hearing with 17 no.s of claims along with form-13 for technical amendments. The amended claims submitted with hearing submission also contains,,

some more new features which was also not supported by specification as filed on 11/06/2007. New composition data was added in table 2A and 18A of specification.,,,

Earlier composition in table were filed as weight proportion (%) and single data was given for each component; whereas after amendments tables were modified and earlier,,

data was converted as weight proportion wet basis(%) and new data was added as weight proportion dry basis (%) for each component. Which was not supported by,,

specification filed on 11/06/2007. The amendments made by applicant are not allowed in view of Section 57 and 59. Hence under section 57 & 59 of The Patents Act, the,,

amendments proposed by the applicants are beyond the scope of invention as filed. Hence, amendments with new features were not allowed.",,,

The filed claimed does not constitute an invention u/s 2(1)(j)(a) for the lack of inventive step. In present application flooring system is nothing but a combination of panel,,

and metal frame which is part of flooring. The cited document US6620487 discloses reinforced panel for resisting shear loads when fastened to framing comprising: a,,

continuous phase resulting from the curing of an aqueous mixture of reactive powders comprising, on a dry basis, 35 to 75 wt. % calcium sulfate alpha hemihydrate, 20",,,

to 55 wt. % hydraulic cement, 0.2 to 3.5 wt. % lime, and 5 to 25 wt. % of an active pozzolan, said continuous phase being uniformly reinforced with alkali-resistant glass fibers",,,

and containing uniformly distributed ceramic microspheres, said spheres having an average diameter of about 10 to 500 microns (micrometers), said panel having a shear",,,

rating of at least 720 lbs/ft (1072 kg/m) when a 0.5 inch (12.7 mm) thick panel tested according to ASTM E72 test method using 8d common nails as fasteners",,,

with a fastener spacer of 6 inches (152 mm) on center at the perimeter and 12 inches (304 mm) on center on the intermediate studs. US3397497 discloses metal panels for,,

flooring or deck system. It is obvious for person skilled in the art in the field of construction to use the panels as disclosed in US6620487 with metal panel as disclosed in,,

US3397497 for achieving the flooring system of present application (as filed). For fixing panel it is obvious for the person skilled in art to use screw fasteners with driller for,,

fixing panel over metal frame. All of the cited documents are of particular relevance to the claimed invention of this application and the subject-matter of claims is not new with,,

respect to cited documents and cannot be considered to involve an inventive step. In view of the above, claim does not constitute an invention u/s 2(1)(j)(a) for the lack",,,

of inventive step.,,

So, in view of the facts and on the circumstances of the case as above, I hereby refuse this application to proceed further for grant of Patent. Order: In view of the",,

above and as discussed here objections raised vide this office letter 872/MUMNP/2007/MECH/GR/4/54 dated 21/04/2015 remain pending; hence I hereby refuse,,

this application to proceed further for grant of patent. [Emphasis supplied],,

6. It could be seen that the amended set of claims were objected to as being attracting the provisions of section 57 read with 59 of the Patents Act, 1970 and secondly",,

the claimed invention as lacking inventive step though in concluding line the respondent has also stated that the subject-matter of claims is not new; though apparently,,

there was no objection on novelty,,

7. First of all, let us discuss the issues relating to section 57 read with section 59 of the Patents Act, 1970. Let us have a",,

look on the statutory provisions:,,

CHAPTER X,,

AMENDMENT OF APPLICATIONS AND SPECIFICATIONS,,

Section 57,,

Amendment of application and specification or any document relating thereto before Controller,,

(1) Subject to the provisions of section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee",,

allow the application for the patent or the complete specification or any document relating thereto to be amended subject to such conditions, if any, as the Controller thinks fit:",,

Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification or any document relating thereto,,

under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending",,

whether the suit or proceeding commenced before or after the filing of the

application to amend.,,

(2) Every application for leave to amend an application for a patent or a complete specification or any document relating thereto under this section shall state the nature of the,,

proposed amendment, and shall give full particulars of the reasons for which the application is made.",,,

(3) Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent,,

and the nature of the proposed amendment may be published.,,

(4) Where an application is published under sub-section (3), any person interested may, within the prescribed period after the publication thereof, give notice to the Controller",,,

of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and",,,

shall give to that person and to the opponent an opportunity to be heard before he decides the case.,,

(5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim.",,,

(6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any other document related thereto to,,

comply with the directions of the Controller issued before the grant of a patent.,,

Section 592 Supplementary provisions as to amendment of application or specification,,

(1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or",,,

explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed",,,

the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the,,

amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.",,,

(2) Where after the date of grant of patent any amendment of the specification or any other documents related thereto is allowed by the Controller or by the Appellate Board or,,

the High Court, as the case may be,",,

(a) the amendment shall for all purposes be deemed to form part of the specification along with other documents related thereto;,,

(b) the fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and,,

(c) the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.,,

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.",,

8. Now considering the case at hand, the Respondent has taken objections mainly on two amendments (i) the preamble of claim",,,

18 -20 (now existing claim 17) being as "method of providing a building structure with non-combustible flooring"; in place of "A method of making the non-,,

combustible flooring system of claim 1 initially claimed in claim no. 29. We have reviewed the description and found that the support exist only for method of making,,

the non-combustible flooring system. As the appellant has discussed about the grant in other jurisdiction, we find that EP granted claims 1-18 are all oriented towards "A",,,

non-combustible flooring system for construction comprising"; .. ; the US granted claims " method of making the non-combustible flooring system is only claimed in single,,

application US 000007849648 B2 together with "A non-combustible flooring system for construction. "A method of providing a building structure with a non-combustible,,

flooring system" is subject matter of other patent US 000008069633 B2. Therefore, we do not find any reason for such an amendment and inclined to accept the",,,

contention of the respondent. Hence, the appellant is directed to amend the preamble of claim 17 towards "method of making the non- combustible flooring system.. which",,,

has support in the description.,,,

9. Secondly, the Respondent has objected to addition of the certain data in table

no 2A and 18A. We have reviewed the assertion and found that while the appellant has",,,

retained the weight proportion wet basis (%) as provided earlier, they have also given weight proportion dry basis (%). In fact, this was essential as all other data is given in",,,

proportion dry basis (%) and in order to bring uniformity with other data being compared, this conversion was needed. They have neither deleted nor added something new; but",,,

given conversion on the formula quoted below the table as shown:",,,

the

the

10. Hence, the amendments are well within the teachings of section 57 read with section 59, being explanatory in nature which are essential to incorporate actual facts",,,

retaining the original scope of the disclosure.,,,

11. Further, the respondent also holds that all of the cited documents are of particular relevance to the claimed invention of this application and the subject-matter of claims is",,,

not new with respect to cited documents and cannot be considered to involve an inventive step. We find that all the features(s) of the claimed invention are not present in any of",,,

the citations and hence the contention that the subject matter of claim is not new does not hold water.,,,

12. We now look at the objection with regard to lack of inventive step. It is found that the order of the respondent is not based on proper reasoning to sustain the objection on",,,

inventive step. This Board has time and again emphasized that the method of determination of inventive step has been elaborately described in the Manual of Patent Office",,,

Practice and Procedure -2019 Available at <https://ipindia.gov.in/manual-patents.htm> with the help of several judicial pronouncements on the subject. This Board has also",,,

explained the procedures in its recent order in *Pharmacyclics, LLC* OA/46/2020/PT/DEL and for the sake of brevity; we are not inclined to repeat it here.",,,

13. We also find that identical citations have been used as prior arts in many other jurisdictions and the patents have been granted. This Board has, on many occasions",,,

reiterated that while the grant of patents in other jurisdiction has no binding effect at IPO, but refusal of the case exactly on identical citation(s) without any new document or",,

any new findings, negate the principle of equity and fair play.",,

14. This Board held in STEMPEUTICS RESEARCH PVT. LTD OA/03/2017/PT/CHN 12.1 â??36. The question is what would be happen if the claims rejected by the IPO,,

is identical to the granted claims in major jurisdictions like EPO, USPTO and the rejection in India has happened on the basis of identical set of prior arts over which other",,

jurisdictions have already granted patent.,,

37. No doubt, we agree if cited prior arts by the IPO are different from the cited prior arts inÂ USPTO,Â EPOÂ itÂ may be justified that IPO has done its examination as",,

per the provision but in the situation where identical claims are grantedÂ inÂ majorÂ jurisdictionÂ andÂ stillÂ suchÂ patent claims are rejected in India, the same may be",,

in contradiction to the statements and objects of the Patents Amendment Act, 2005. It amounts to injustice and against the principles of equity and fair play.",,

15. In light of above discussion, the impugned order cannot be sustained. The appellants are directed to file the amended set of claimÂ rewordingÂ claimÂ 17Â towardsÂ",,

â??methodÂ ofÂ makingÂ theÂ non- combustible flooring systemÂ|.â?? maintaining its dependency on claim1 within 3 week from issuance of this order.,,

16. We, therefore, set aside the impugned order dated 30/09/2015 issued by the respondent, and direct the respondent to grant patent on the amended set of claims to the",,

appellant, within 3 weeks from the date of submission of the amended set by the appellant.",,

17. Keeping in view the above facts and circumstances, the instant appeal is allowed. No cost.",,