

Sharayu Khot.

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

COMMERCIAL MISCELLANEOUS PETITION NO. 1247 OF 2022

Amogreentech Co. Ltd.

...Petitioner

Versus

Assistant Controller of Patents & Designs

...Respondent

Mr. Hiren Kamod a/w Ms. Vibha Joshi i/by Abhishek Adke for the
Petitioner.

Mr. Rajshekhar Govilkar, Senior Counsel a/w A.K. Kotecha for the
Respondent.

CORAM : R.I. CHAGLA J

DATE : 26 June 2023

ORDER :

1. By this Commercial Miscellaneous Petition, the Petitioner is seeking the quashing and setting aside of the impugned order dated 28th December 2021 issued by the Respondent.

2. Mr. Hiren Kamod, learned Counsel appearing for the Petitioner has referred to the notice of objection which has been issued by the Respondent. There are certain provisions of the Patents

Act quoted in the Examination Reports and the inventive steps over disclosures of the cited prior arts D1-D4 have been indicated. He has submitted that in response to these objections in the Examination Reports, the Petitioner had filed a detailed Reply dated 24th September 2021 and subsequent Reply dated 15th December 2021, wherein the Petitioner has distinguished the Claim 1 – invention from the prior arts.

3. Mr. Kamod has submitted that in the impugned order, there is non consideration of the Claim 1 – invention as a whole and this is can be seen from the paragraph 1 of the Analysis at internal page 4 of the impugned order. A comparison between the analysis of the Respondent in the impugned order and that of principal Claim 1 of the subject patent Application is as under :-

EXCERPT FROM THE IMPUGNED ORDER	PRINCIPAL CLAIM 1 OF THE SUBJECT PATENT APPLICATION
<u>“1. Instant subject matter refers to the graphite complex (101) in which nanoparticles (20) coated with a catecholamine layer (30) and a polymer layer (40) are fixed on the surface of a graphite (10), wherein the graphite (10) is a plate shaped graphite as</u>	<u>“A graphite composition, consisting of: a graphite complex (101) in which nanoparticles (20) coated with a catecholamine layer (30) and a polymer layer (40) are fixed on the surface of a graphite (10), wherein the graphite (10) is a plate shaped</u>

<u>claimed in claim 1.”</u> (Emphasis Added by the Petitioner)	graphite; and an expanded graphite (102), or a combination of an expanded graphite (102) and a graphite flake (103), or a combination of an expanded graphite (102) and a spherical graphite (103), wherein the graphite complex (101) and the expanded graphite (102), or the combination of an expanded graphite (102) and a graphite flake (103), or the combination of an expanded graphite (102) and a spherical graphite (103) are having a weight ratio of 1:1 to 15.” (Emphasis Added by the Petitioner)
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4. Mr. Kamod has submitted that the Respondent has erred in analyzing and considering only part of the Petitioner’s principal claim 1 as can be seen from the comparison. He has further drawn reference to the Manual of Patent Office Practice and Procedure and in particular paragraph 09.03.03.02 of the said manual wherein under Determination of Inventive Step, it is inter alias provided as under :-

“Invention as a whole shall be considered. In other words, it is not sufficient to draw the conclusion that a claimed invention is obvious merely because

individual parts of the claims taken separately are known or might be found to be obvious.”

5. Mr. Kamod has submitted that the said Manual of Patent Office Practice and Procedure is required to be followed by the Controller of Patents in their impugned orders and that it is necessary for the Controller of Patents to consider the invention as a whole. Further, it is not sufficient to draw a conclusion that the claimed invention is obvious merely because individual parts of the claims taken separately are known or might be found to be obvious. Thus, the novelty aspect of the invention as a whole is required to be considered.

6. Mr. Kamod has submitted that from bare perusal of the impugned order, the Respondent has failed to consider the invention as a whole in arriving at a finding that “*in view of teaching form the D1 and D2 the amended claim 1 renders to obvious to the person skilled in art, therefore no inventive step is acknowledged, therefore, subject matter claimed in claim 1 is not meeting requirement of Section 2(1)(j) of Patents Act*”.

7. Mr. Kamod has submitted that the further finding in the impugned order that the subject matter claimed in claim 1 is falling within scope of Section 3(d) of the Patents Act could not have been arrived at had the Claim 1, considered as a whole, been compared with the cited prior arts i.e. D1 and D2. There is only reproduction of D1 and D2 without an analysis on how the cited prior arts i.e. D1 and D2 at all can be compared with Claim 1 - invention of the Petitioner as a whole.

8. Mr. Kamod has accordingly, submitted that the impugned order be set aside and remanded back to an officer other than the officer who passed the impugned order.

9. Mr. Govilkar, learned Counsel appearing for the Respondent has submitted that the impugned order has considered the cited prior arts i.e. D1 and D2. The Respondent is having the requisite technical knowledge to arrive at a finding that the prior arts i.e. D1 and D3 would render the amended Claim - 1 to be non inventive and accordingly, the Claim 1 – invention of the Petitioner does not meet the requirement of Section 2(1)(j) of the Patents Act and / or falls within the scope of Section 3(b) of the Patents Act.

10. Mr. Govilkar has submitted that though the Claim 1 – invention of the Petitioner has been para phased and not reproduced in total, that would not be sufficient to set aside the impugned order, as there would have been application of mind by the Respondent to Claim – 1 as a whole in passing of the impugned order. He has submitted that the impugned order has provided reasons and hence cannot be contended to be an unreasoned order and / or in violation of the principals of natural justice.

11. Having considered these submissions, in my view, it was necessary for the Respondent/Assistant Controller of Patents to pass the impugned order by taking into consideration the Manual of Patent Office Practice and Procedure and in particular, paragraph 09.03.03.02 thereof i.e. the determination of Inventive Step which provides that the invention as a whole shall be considered. From the face of the impugned order, it is apparent that the Claim 1 -invention has not been considered as a whole. Further, the impugned order lacks any form of analysis, though it is sub-titled as analysis, which would satisfy this Court as to the existence of an independent application of mind exercised by the Assistant Controller of Patents in passing the impugned order. There is a mere reference to the cited

prior arts in the impugned order i.e. D1 and D2, without an analysis on how the cited prior arts are comparable with Claim 1 of the Petitioner when taken as a whole.

12. It has been held in the decision of the Delhi High Court in **Dolby International AB Vs. The Assistant Controller of Patents and Designs**¹ 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 the light of the prior art. In the case of **Impact Selector International LLC Vs. Controller of Patents**² the Delhi High Court has referred to prior decision of a Co-ordinate Bench in **Agriboard International LLC Vs. Deputy Controller of Patents and Designs**³, which in turn has referred to the reasoning of Supreme Court in **Manohar Vs. State of Maharashtra & Ors.**⁴ that the application of mind and recording of reasoned decision are basic elements of natural justice. There can be no doubt that scrupulous adherence to these principles would be required while rejecting the Patent Application. The Supreme Court in aforementioned decision

1 C.A.(COMM.IPD-PAT) 10/2021 and I.A. 13552/2021 (Stay) dtd. 14.03.2023

2 2023 SCC OnLine Del 211

3 2022 SCC OnLine Del 940

4 AIR 2013 SC 681

has considered the three elements, i.e. :-

- (i) the invention disclosed in the prior art;
- (ii) the invention disclosed in the application under consideration;
and
- (iii) the manner in which subject invention would be obvious to a
persons skilled in the art.

13. The Supreme Court has held that without the discussion of these three elements, arriving at the 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.

14. Thus, where the impugned order simply jumps to a conclusion that the subject invention lacks inventive steps, the impugned order will be without discussion as to why the subject invention would be hit by the prior art.

15. I have considered the aforementioned decisions of

the Supreme Court and Delhi High Court as well as settled law on the aspect of a reasoned order to be passed by the patent officers in determining whether the invention of the Applicant is hit by the provisions of the Patents Act, as in the present case viz. Section 2(1)(j), 3(b) of the Patents Act. There is a requirement of exercise of independent application of mind on the part of the Patent Officer for refusal of the Patent, which must be reflected in the decision.

16. In my view, the present impugned order has been passed without considering the whole of the Claim 1 - invention of the Petitioner as can be seen from reproduction of only part of Claim 1 – invention and there being no proper analysis in determining whether the cited prior arts would render the claim 1 invention to be non inventive.

17. In view thereof the following order is passed :-

- (i) The impugned order dated 28th December 2021 is quashed and set aside and remanded back for de novo hearing to the Controller of Patents. Needless to state that the matter would not be decided by the officer

who has passed the impugned order. This will obviate the possibility of any apprehension of predetermination.

- (ii) The Officer appointed to determine the Petitioner's case shall pass a reasoned order taking into account all relevant consideration and after granting hearing to the Petitioner and the order shall be passed within a period of 12 weeks from the date of this order.
- (iii) It is made clear that the appointed Officer in determining the Petitioner's case shall consider the case independently and without being influenced by this order.
- (iv) Further it is clarified that this order has not considered the merits of the Petitioner's patent application.
- (v) Commercial Miscellaneous Petition is accordingly, disposed of. There shall be no order as to costs.

[R.I. CHAGLA J.]