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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

\+ C.A.(COMM.IPD-PAT) 88/2022

SYNTHES GMBH ..... Appellant

Through: Mr. Vineet Rohilla, Mr. Rohit Rangi, Mr. Debashish Banerjee, Mr. Ankush Verma, Mr. Tanveer Malhotra and Mr. Venkatesh Nair, Advs.

versus

CONTROLLER GENERAL OF PATENTS, DESIGNS AND TRADEMARKS AND ANR ..... Respondents

Through: Mr. Harish Vaidyanathan Shankar, CGSC, Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advs.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR

J U D G M E N T (ORAL)

% 12.05.2023

1. This is yet another case in which the manner in which the impugned order dated 8th October 2020, passed by the Assistant Controller of Patents and Designs, shocks the conscience of the court.

2. Application No. 8285/DELNP/2007 was filed by the appellant on 26th October 2007 for grant of a patent in respect of "Bone Fixation Apparatus".

3. Consequent to filing of the application, First Examination Report (FER) was issued by the Office of the Controller of Patents on 30th November 2015. The appellant filed its reply to the FER on 1st July 2016.

4. Consequent thereto, notice of hearing was issued by the Assistant Controller General of Patents (ACGP) on 14th November 2019, and hearing was granted to the appellant on 17th December 2019, whereafter the appellant filed written submissions on 31st December 2019.

5. The impugned order has come to be passed, by the ACGP on 8th October 2020. To appreciate how the impugned order has been written and passed, it would be appropriate that a screenshot of the order is provided:

GOVERNMENT OF INDIA
MINISTRY OF COMMERCE & INDUSTRY

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Patents/Designs/Trademark
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The Patents Act, 1970

(Section15)

Application No: 8285/DELNP/2007

Hearing held on 17/12/2019

1. An application for patent bearing number 8285/DELNP/2007 was filed on 26/10/2007 . The request for examination was filed on 22/04/2009 . The said application was examined under sections 12 and 13 of the Patents Act, 1970 (as amended) and First Examination report was issued. In response to the First Examination Report, applicant's agent submitted its reply.

2. After considering the reply filed against first examination report by the applicant's agent and the report of the examiner on such reply, it was observed that the said patent application was not in order for grant. In order to dispose of the application, hearing was offered to the applicant and accordingly hearing was fixed on 07/12/2019. The intimation of said hearing was sent to applicant's agent vide e-mail dated 14/11/2019 along with the following objections which were found outstanding in the application:

Objections

1. Claims in the instant application are different from those in the corresponding International Application. Hence, Form 13 should be duly filed. Also, Fees for all the 52 claims as filed in International Application should be paid.
2. Without prejudice to above paragraph. (D1) US 2003/149430Date of Publication: 07/08/2003 (D2) US6162223Date of Publication: 19/12/2000 Claim 1 Document D1 discloses an apparatus (figures 2, 4) for engaging first and second bone fixation elements in a bone fixation frame is known, comprising: -a first clamp structure (38, 40, 86) configured to engage a first bone fixation element, and having a first spherically contoured bearing surface (the spherical head of the connector bolt); -a second clamp structure (30, 34) configured to engage a second bone fixation element, and having a second spherically contoured bearing surface (the surface of the piece 30 being in contact with the spherical head (88) of the connector bolt (86)) seated in sliding contact with the first bearing surface; and -a spring-loaded mechanism (80) operative to apply a spring force urging the bearing surfaces together to resist pivotal movement of the clamp structures relative to each other. The invention as set forth in claim 1 does not involve novelty in view of document D1. Claim 15 An apparatus for engaging first and second bone fixation elements in a bone fixation frame, comprising: -a first clamp structure configured to engage a first bone fixation element, and having a first spherically contoured bearing surface (figure 1, claims 1-37); -a second clamp structure configured to engage a second bone fixation element, and having a second spherically contoured bearing surface seated in sliding contact with the first bearing surface (claims 1-37); -a connector bolt having a head engaging the second clamp structure and a screw-threaded stem extending to the first clamp structure (figure 2-5, claims 1-37); -a tightening device in screw-threaded engagement with the stem of the connector bolt (claims 1-37); and -a spring compressed between the first clamp structure and the tightening device, whereby the tightening device can apply a spring force to the connector bolt to tighten the contact of the bearing surfaces (figures 2-5; claims 1-37). The invention as set forth in claim 15 does not involve novelty in view of document D2. Hence, in the view of D1 and D2 the claim 1 and 15 of the alleged invention lacks inventive step as per section 2(1)(j) of The Patents Act,1970. Dependent claims 2-14 and 16-26 define obvious implementation details of the system defined by the independent claims. They do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the inventive step as per section 2(1)(j) of The Patents Act,1970.

3. In response to the said hearing notice, Agent attended the hearing on 17/12/2019 and made written submission on 31/12/2019 .

4 I now turn my attention to the claimed subject matter. The alleged invention is summarized as follows:

A clamp assembly for bone fixation elements including first and second clamp structures configured to engage first and second bone fixation elements, respectively. The first clamp structure may have a first spherically contoured bearing surface. The second clamp structure may have a second spherically contoured bearing surface seated in sliding contact with the first bearing surface. A spring-loaded mechanism may apply a spring force urging the bearing surfaces together to resist pivotal movement of the clamp structures relative to each other. The clamp assembly may be used with an assembly of fixation elements to create an external fixation frame.

Applicant has also emphasized on following points in submitted reply document :

1.
According to the claimed invention, the bone fixation clamps are articulated *to provide a wide range of angular positions for the interconnected parts of the frame* to support bones on opposite sides of a fracture.

Document D1 discloses a device including a first capture member 24 and a second capture member 22 (refer para [0028] of D1). The first capture member 24 includes a planetary member 94 which fits within a cooperating surface 110 of the second capture member 22 (refer para [0034] of D1). The first and second capture members 24, 22 are connected to one another via a connector 86 having a spherical end 88 received in the planetary member 94 and a shaft 90 extending through the second capture member 22 to mate with a second fastener 100.

However, unlike the present invention, *D1 fails to disclose or suggest a spring loaded mechanism that applies a spring force to move any bearing surfaces toward one another to resist pivotal movement of the clamp structures relative to each other*, as recited in independent claim 1 of the present application. Specifically, spring 80 of D1 is in *no way analogous* to the spring-loaded mechanism as recited in the independent claim 1 of the present application.

D1 does not disclose or suggest that the spring 80 applies a spring force which moves

any bearing surfaces toward one another to resist pivotal movement. Instead, in D1, a first fastener 60 threadedly engages an inner surface of the first capture member 24 and is adjacent to the spring 80, which extends between an end of the first fastener 60 and the spherical end 88 of the connector 86 (refer para [0033] of D1).

Figures 4 and 5 of D1 describe only tightening the fastener 60 to lock the first capture member 24 to retain a pin 26. Indeed, to lock the first and second capture members 24, 22 against pivotal movement, D1 describes only tightening the fastener 100 on the second capture member 22 to draw the spherical head into the planetary member 94 (refer para [0034] of D1). When the fastener is loosened, the spherical end 88 of the connector 86 and the planetary member 94 move farther from the cooperating surface 110 so that the planetary member 94 and the cooperating surface 110 do not interface with one another. Thus, the spring 80 does not apply any force moving the planetary member 94 and the cooperating surface 110 toward one another to resist pivotal movement. In contrast, D1 suggests the spring 80 as providing only a biasing force to the first fastener 60 (refer para [0038] of D1).

The Ld. Controller has objected that claim 15 lacks novelty in view of the cited document D2: US6162223.

D2 does not disclose or suggest a connector bolt having a head engaging a second clamp structure and a screw-threaded stem extending to the first clamp structure or a tightening device in screw threaded engagement with the stem of the connector bolt. *D2 also does not disclose or suggest a spring compressed between the first clamp structure and the tightening device whereby the tightening device can apply a spring force to the connector bolt to tighten the contact of the bearing surfaces by moving the bearing surfaces toward one another, as recited in claim 15 of the present application*. Moreover, D2 does not teach or suggest a connector bolt that engages the first and second clamp structures.

5. Without prejudice to the above said, having considered the aforesaid submissions, I do not find the submissions persuasive in view of following:

Claim: 1-5 claims mainly

An apparatus (10) for engaging first and second bone fixation elements (12) in a bone fixation frame, comprising:

a first clamp structure (20), having at least two bores (44) for engaging at least two first bone fixation elements (12), having a first spherically contoured bearing surface (56);

a second clamp structure (22), having at least one bore for engaging at least one second bone fixation element (12), having a second spherically contoured bearing surface (122) seated in sliding contact with the first bearing surface (56); and

a spring-loaded mechanism (150) operative to apply a spring force urging the bearing surfaces (56, 122) together to resist pivotal movement of the clamp structures (20, 22) relative to each other.

6. The oral arguments and the written submissions of the agent of the applicant have been carefully considered. However without prejudice, although the hearing submissions have attempted to address the other requirements, yet the substantive requirement of the Patents Act, 1970 i.e. Section 2(1)(j) is not found complied with.

Examiner's observation regarding novelty and inventive step

Without prejudice to above paragraph. (D1) US 2003/149430Date of Publication: 07/08/2003 (D2) US6162223Date of Publication: 19/12/2000 Claim 1 Document D1 discloses an apparatus (figures 2, 4) for engaging first and second bone fixation elements in a bone fixation frame is known, comprising: -a first clamp structure (38, 40, 86) configured to engage a first bone fixation element, and having a first spherically contoured bearing surface (the spherical head of the connector bolt); -a second clamp structure (30, 34) configured to engage a second bone fixation element, and having a second spherically contoured bearing surface (the surface of the piece 30 being in contact with the spherical head (88) of the connector bolt (86)) seated in sliding contact with the first bearing surface; and -a spring-loaded mechanism (80) operative to apply a spring force urging the bearing surfaces together to resist pivotal movement of the clamp structures relative to each other. The invention as set forth in claim 1 does not involve novelty in view of document D1. Claim 15 An apparatus for engaging first and second bone fixation elements in a bone fixation frame, comprising: -a first clamp structure configured to engage a first bone fixation element, and having a first spherically contoured bearing surface (figure 1, claims 1-37); -a second clamp structure configured to engage a second bone fixation element, and having a second spherically contoured bearing surface seated in sliding contact with the first bearing surface (claims 1-37); -a connector bolt having a head engaging the second clamp structure and a screw-threaded stem extending to the first clamp structure (figure 2-5, claims 1-37); -a tightening device in screw-threaded engagement with the stem of the connector bolt (claims 1-37); and -a spring compressed between the first clamp structure and the tightening device, whereby the tightening device can apply a spring force to the connector bolt to tighten the contact of the bearing surfaces (figures 2-5; claims 1-37). The invention as set forth in claim 15 does not involve novelty in view of document D2. Hence, in the view of D1 and D2 the claim 1 and 15 of the alleged invention lacks inventive step as per section 2(1)(j) of The Patents Act,1970. Dependent claims 2-14 and 16-26 define obvious implementation details of the system defined by the independent claims. They do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the inventive step as per section 2(1)(j) of The Patents Act,1970.

Hence, in view of the above and unmet requirements, this instant application is not found in order for grant **Also I agree with the findings of the examiner that the subject matter as described and claimed attract the provisions of sections 2(1)(j) of the Patent Act, 1970.**

Further , this application also does not comply with Section 10(4) in The Patents Act, 1970 as amended additional claims 27 to 32 does not have support from the description .

Additional matter of claims also attracts **Section 59 in The Patents Act, 1970 as** No amendment of an application for a patent or a complete specification or any document related 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 .

7. Thus, in view of the aforesaid and unsatisfactory submissions made by the Agents in respect of the pertinent requirements as raised in the said hearing notice, this instant application does not comply with the requirements of the Act. I, therefore, hereby order that the grant of a patent is **REFUSED** under the provisions of Section 15 of the Patents Act.

8. This is to be noted that the aforesaid observations, and decision thereof, are based solely on the electronically uploaded documents to date.

Dated this 08/10/2020

(ASHLESH MAURYA)

Asst. Controller of Patents & Designs

6. Clearly, instead of taking the trouble of typing out the order, the ACGP has merely cut and paste paragraphs from documents.

7. Though such cutting and pasting is itself disquieting, the Court would not have taken serious note thereof, had the ACGP condescended to supplement the cut and pasted paragraphs with his own reasoning, displaying some minimal application of mind.

8. Sadly, that is lacking.

9. Mr. Vineet Rohilla, learned Counsel for the appellant points out that the objections contained in the FER were reproduced, verbatim, in the notice of hearing dated 14th November 2019 and again stand reproduced, verbatim, in paras 2 and 6 of the impugned order. There has been no consideration, whatsoever, of the reply filed by the appellant either in response to the FER or consequent to the notice of hearing issued by the ACGP.

10. If one were to de-construct the impugned order, the following position emerges:

(i) Paras 1 and 2 are directly cut and pasted from the FER dated 30th November 2015. It may be noted that the appellant's application has come to be rejected on the basis of objections contained in para 2 i.e. for want of inventive step *vis-a-vis* prior art D1 and D2, and not on the basis of the objection contained in para 1.

(ii) Para 3 is a formal paragraph noting the fact that the hearing was conducted and written submissions were filed.

(iii) Para 4 first cuts and pastes the claim contained in the appellant's application and, thereafter, cuts and pastes the response filed by the appellant to the FER.

(iv) Para 5 is incomprehensible. It starts by saying that the ACGP did not find the submission of the appellant persuasive in view of what is supposed to be following thereafter. Thereafter,

however, the ACGP has merely cut and pasted Claim 1 from the appellant's application.

(v) Ironically, para 6 of the impugned order starts with the recital that the oral argument and written submission of the appellant were carefully considered. Thereafter, the impugned order declares, without prelude or preface, that the claim of the appellant did not comply with Section 2(1)(j)[1] of the Patents Act. Why, is left for anybody to guess. The paragraph thereafter once again cuts and pastes the objection contained in the FER. The objection, therefore, has been cut and pasted twice, firstly in

(vi) The impugned order, thereafter, again states that the claim of the appellant was deficient in respect of Section 2(1)(j) of the Patents Act.

11. Thereafter, somewhat strangely, the impugned order states that the appellant's application was also liable to be rejected under Section 10(4) and Section 59 of the Patents Act, neither of which provision was ever raised as an objection to the appellant either in the FER or in the hearing notice.

12. The impugned order, thereafter, proceeds to reject the appellant's application for grant of patent.

[1] **2. Definitions and interpretation**. –
(1) In this Act, unless the context otherwise requires, -
(j) "invention" means a new product or process involving an inventive step and capable of industrial application;

13. This Court is seriously disturbed at the impugned order. The order is nothing less than a total mockery of the functions which are vested in the quasi-judicial authorities in the office of the Controller General of Patents.

14. This Court has personally interacted with the learned Controller General of Patents, and is aware that he has his heart in the right place, and is sincerely interested in ensuring that the patent office functions properly. "The best laid schemes of mice and men", as the poet Robert Burns however lamented, "gang aft agley"[2], and, if the lower functionaries in his office persist in passing orders such as the one before me, the best intentions of the learned Controller General will fail to bear fruit.

15. The Court, therefore, sincerely requests the learned Controller General of Patents to advise the functionaries in his office, discharging quasi-judicial functions such as grant or refusal of patent applications, to make every effort to see that such orders are not passed, as they do discredit not only to the duty vested in the officer passing the order, but in the ultimate eventuate, would also reflect on the functioning of the office of the learned Controller General of Patents itself.

16. Mr. Harish Vaidyanathan, learned Central Government Standing Counsel appearing for the Controller General of Patents, with customary fairness, agrees to the matter being remanded for a fresh consideration.

[2] In the poet's immortal "To A Mouse, (On Turning up in her Nest with The Plough), November 1785". "Gang aft agley" is the Scottish equivalent of "go often awry".

17. This Court notes the fact that the application for grant of patent was filed as far back as in 2007. We are already in 2023. A patent, once granted, has a life of only 20 years. The period is counted not from the date of grant of the patent but from the date of the application. 13 of the said period of 20 years, therefore, have already lapsed. Even if, today, the appellant's applications were to be granted, the life of the patent would only be a residual period of 3 years.

18. If inventors, who seek to invent patents, are going to suffer such treatment, it would ultimately disincentivise persons from exercising their inventive faculties and coming with new and innovative technologies which would ultimately be deleterious to the national interest as well.

19. It would be well if adjudicating authorities in the office of the Controller General of Patents keep these realities in mind. To the knowledge of this Bench, this is the fourth case where such an order has come up before this Court. If the passing of such orders persists, the Court may be constrained to take more drastic steps, which might in the end result impact the officer who passes the order personally. For the present, however, the Court is desisting from doing so.

20. Needless to say, in the aforesaid facts and circumstances, the impugned order dated 8th October 2020 is quashed and set aside. It is directed that the *de novo* proceeding shall conclude and the decision be communicated to the appellant within the time period of three months.

21. Application No. 8285/DELNP/2007 is remanded for a fresh

consideration. The learned Controller General of Patents is requested to assign the matter to an officer other than the officer who has passed the impugned order.

22. The learned Controller General of Patents is also requested to depute the officer who has passed the impugned order Mr. Ashlesh Mourya, ACGP to undergo a course in passing of judicial orders, to be conducted by the Delhi Judicial Academy.

23. Let a copy of this order be also marked to the Delhi Judicial Academy for compliance.

24. This appeal stands allowed in the aforesaid terms.

C. HARI SHANKAR, J.

MAY 12, 2023
dsn