



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

COMMERCIAL MISC. PETITION NO. 99 OF 2025

Mohun Nicholas D'Souza and Anr.

... Petitioners.

Versus

The Controller of Patents of Designs and Anr.

... Respondents.

*Mr. Pranshul Dube a/w. Ms. Asma Nadaf and Ms. Maithri Porwal for the
Petitioners.*

*Mr. Prashant Shetty a/w. Aditya Chitale and Narayan Abhishek Singh i/by
RKDewan Legal Services for Respondent No.3.*

Coram : Sharmila U. Deshmukh, J.

Reserved on : July 15, 2025

Pronounced on : July 25, 2025

ORDER :

1. The present Appeal is filed under Section 117A of the Patents Act, 1970 (for short, "Patents Act") challenging the impugned order dated 22nd August, 2023 passed by the Respondent No.2 refusing the Patent Application No.1851/MUM/2015 on the ground of lack of inventive steps / obviousness under Section 25(1)(e) of the Patents Act.

2. The Petitioner filed Patent Application for invention titled "TAMPER EVIDENT TWIST SEAL WITH BREAKAWAY ANCHOR MECHANISM", which was published in the patent journal on 18th November, 2016. On 5th January, 2018, pre-grant opposition was filed

by Respondent No.3. On 10th January, 2020, Respondent No.2 issued first examination report with respect to the patent application. On 8th October, 2020, the Petitioner's agent filed reply to the first examination report and on 30th November, 2021, written statement as reply to the pre-grant opposition dated 5th January, 2018 was filed. On 25th April, 2023 hearing was conducted and prior thereto on 19th February, 2023, the Petitioner's agent filed amended specifications and claim with respect to the patent application. On 9th May, 2023, written submissions were filed by the Petitioner and on 24th May, 2023 the Respondent No.3 filed written submissions. By the impugned order dated 22nd August, 2023, the Respondent No.1 refused registration of the patent leading to the present Petition.

3. The invention which was sought to be patented is described in the impugned order as a twist type seal which comprises of an encapsulated body along with a rotor/insert, a locking mechanism including a wire locking mechanism comprising of said rotor/insert and said encapsulated body, each said rotor/insert and said encapsulated body, having pair of through holes, a top hole, and a bottom hole, for passage of the wire lock there through with said rotor/insert, rotatable only unidirectional with respect to said encapsulated body, to effect the wire locks around axis of said rotor/insert within said encapsulated body forming a complete locking loop and thus blocking

any unwinding of the complete wire locking loop.

4. The pre-grant opposition by the Respondent No.3 was on the grounds of prior publication under Section 25(1)(b), obviousness/lack of inventive steps under Section 25(1)(e) and insufficient disclosure under Section 25(1)(g) of Patents Act. The Controller has rejected the opposition under Section 25(1)(b) and Section 25(1)(g) and has refused the registration on ground obviousness/lack of inventive steps.

SUBMISSIONS:

5. Learned counsel appearing on behalf of the Petitioners submits that the lack of novelty referable to prior art is a ground available under Section 25(1)(b), whereas the obviousness / lack of inventive steps is a ground available under Section 25(1)(e) of the Patents Act. He submits that there has to be an addition to the prior art for purpose of obviousness. He submits that the opposition on the ground of Section 25(1)(b) has been rejected by holding that the same features of the claim as in the present invention are not published in any single cited document and that the opponent has failed to give where the similar claims, features of these claims are located in the cited document. He submits that in stark contradiction to the said finding while accepting the opposition under Section 25(1)(e) of the

Patents Act, the Controller has held that related prior art documents completely anticipate the present patent application and would be obvious to a person skilled in the art. He submits that the Controller has held that similar technical features are already disclosed in cited prior document No.US5782513 and US6390519.

6. He submits that for applying Section 25(1)(e), the prior art has to be combined with common general knowledge. Drawing support from the decision of Delhi High Court in the case of **AGFA NV and Anr. vs. The Assistant Controller of Patents and Designs and Anr.**¹, he submits that the Delhi High Court has held that the theory or principal or knowledge has become common knowledge needs to be substantiated by some evidence which could be in the form of references to the 'common general knowledge' textbooks or research articles or standard of documents. He submits that the common general knowledge cannot be a prior art which is a ground available under Section 25(1)(b) of the Patents Act. He submits that as held by the Calcutta High Court in the case of **Guangdong Oppo Mobile Telecommunications Corp. Ltd. vs. The Controller of Patents and Designs**², the grounds of lack of novelty cannot work in tandem with the lack of inventive steps in opposing grant of patent. He would further submit that though substantial written submissions were filed

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by the Petitioner the impugned order would disclose that the submissions have not been considered. He submits that alongwith the written submissions, the Petitioner had also relied upon judicial pronouncements which have also not been considered by the Respondents. Pointing out to the written submissions, he submits that the Petitioner has shown the differences between his patent and the cited prior art which has not been considered. He submits that this is therefore a fit case for remand.

7. *Per contra*, learned counsel appearing for Respondent No.3 submits that there is no requirement of remand as the written submissions of the opponent clearly point out the obviousness/lack of inventive steps by comparing the patent application with the prior art. He submits that there is no material to show inventive steps in respect of the claimed invention. He would further submit that under Section 25(1)(e) of the Patents Act, the Controller has considered that there is no technical advancement in the present invention and that there is slight construction changes in the seal which is obvious. He submits that the Petitioner has combined two to three prior art and arranged it which does not amount to any inventive ingenuity. He would further submit that the decisions relied upon are not applicable as in the decision of the Calcutta High Court, the patent application was rejected on the ground of not being patentable under Section 2(1)(j)

and Section 10(4) of the Patents Act. He would further submit that as far as the decision in the case of Delhi High Court is concerned, Section 2(1)(j) refers to novelty and Section 2(ja) refers to an inventive steps for which technical advancement is required.

REASONS AND ANALYSIS :

8. The submissions canvassed by Learned Counsel for Petitioner seeks remand of the patent application for fresh consideration and not for Patent to proceed for registration. The issue to be considered is whether case for remand is made out. The Controller has rejected the opposition under Section 25(1)(b) and has accepted the ground of Section 25(1)(e) of Patents Act. Section 25(1)(b) is opposition on the ground of lack of novelty, whereas Section 25(1)(e) refers to obviousness/lack of inventive step.

9. The test for determining the existence of inventive steps and lack of obviousness were noted in the decision of the Delhi High Court in the case of ***Avery Dennison Corporation Vs. Controller of Patents and Designs***³, in paragraph 11 as under:

“11. For determining inventive step or lack thereof, various approaches and tests have emerged over the years from decisions of courts/authorities as also from examination guidelines of patent offices from different jurisdictions. The same include:

i. Obvious to try approach:

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- This approach involves an analysis of whether in view of the teachings/solutions proposed in the prior art, it was obvious to try and arrive at the subject invention.

ii. Problem/solution approach:

- This approach considers whether in the light of the closest prior art and the objective technical problem, the solution claimed in the invention would be obvious to the skilled person. If the skilled person can decipher the solution being claimed, then the subject matter is held to be obvious.
- This test has been discussed by the Division Bench in ***F. Hoffmann-La Roche Ltd. and Ors. v. Cipla Ltd., 2016(65) PTC 1 (Del).***

iii. Could-Would Approach

- In this approach the question that is raised is whether there is any teaching in the prior art as a whole that would and not simply could have prompted a skilled person, with the knowledge of the objective technical problem, to either modify or adapt the closest prior art to arrive at the subject matter of the claims.

iv. Teaching Suggestion Motivation (TSM test)

- This test originated in the USA as per which, if by the Teaching, Suggestion or Motivation from the prior art, an ordinary skilled person can modify the prior art reference or combine prior art references to arrive at the claimed invention, then the subject matter being claimed is obvious.
- However, the application of this test ought not to be done in a narrow manner as held by the US Supreme Court in the case of ***KSR International v. Teleflex, 550 U.S. 398 (2007).***"

10. The Delhi High Court further considered some English decisions on the test to be applied for determining the existence of inventive

steps in paragraph Nos.13, 14, 15 and 16 which reads as under:

"13. One of the seminal tests for determining inventive step and lack of obviousness was first laid down by the House of Lords in ***Windsurfing International Inc. v. Tabur Marine Ltd., [1985] RPC 59.***

14. In ***Windsurfing (supra)*** the Court laid down a four-step test to determine whether a patent satisfied the requirement of inventive step and lack of obviousness. The said steps are as under:

- "1. Identifying the inventive concept embodied in the patent;*
- 2. Imputing to a normally skilled but unimaginative addressee what was common general knowledge in the art at the priority date;*
- 3. Identifying the differences if any between the matter cited and the alleged invention; and*
- 4. Deciding whether those differences, viewed without any knowledge of the alleged invention, constituted steps that would have been obvious to the skilled man or whether they required any degree of invention."*

15. The tests laid down in ***Windsurfing (supra)*** were again considered by the England and Wales Court of Appeals in ***Pozzoli Spa v BDMO SA, [2006] EWHC 1398 (Ch)*** and modified by Jacob LJ as under:

- "1. (a) Identify the notional "person skilled in the art"
(b) Identify the relevant common general knowledge of that person;
2. Identify the inventive concept of the claim in question or if that cannot readily done, construe it;
3. Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;

4. Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?"

16. The Id. Division Bench of this Court in ***F. Hoffmann-La Roche Ltd. (Supra)*** added a further step as elaborated below:

"Step No.1 To identify an ordinary person skilled in the art,

Step No.2 To identify the inventive concept embodied in the patent,

Step No.3 To impute to a normal skilled but unimaginative ordinary person skilled in the art what was common general knowledge in the art at the priority date.

Step No.4 To identify the differences, if any, between the matter cited and the alleged invention and ascertain whether the differences are ordinary application of law or involve various different steps requiring multiple, theoretical and practical applications,

Step No.5 To decide whether those differences, viewed in the knowledge of alleged invention, constituted steps which would have been obvious to the ordinary person skilled in the art and **rule out a hindsight approach**."

11. In paragraph No.19, Delhi High Court has held as under:

"19. The decision of the UK Supreme Court in Actavis (supra) identified the ten relevant considerations to be made while assessing obviousness. The Court mentioned that the factors identified in the list are not exhaustive. The relevant considerations are:

"(1) First, it is relevant to consider whether **something was "obvious to try" at the priority date**, in other words, whether it is **obvious to undertake a specific piece of research which had a reasonable or fair prospect of success** ...;

(2) Secondly, it **follows the routine nature of the research** and whether there is an established practice of following the research through to a particular point may be a relevant consideration which is weighed against the consideration that the claimed process or product was not obvious to try at the outset of a research programme. ...

3) Thirdly, the **burden and cost of the research programme is relevant**. But the weight to be attached to this factor will vary depending on the particular circumstances....

(4) Fourthly, the **necessity for and the nature of the value judgments** which the **skilled team would have in the course of a testing programme** are relevant considerations

(5) Fifthly, the **existence of alternative or multiple paths of research will often be an indicator that the invention contained in the claim or claims was not obvious**. If the notional skilled person is faced with only one avenue of research, a "one way street", it is more likely that the result of his or her research is obvious than if he or she were faced with a multiplicity of different avenues. But it is necessary to bear in mind the possibility that more than one avenue of research may be obvious ...

(6) Sixthly, the **motive of the skilled person is a relevant consideration**. The notional skilled person is not assumed to undertake technical trials for the sake of doing so but rather because he or she has some end in mind. It is not sufficient that a skilled person could undertake a particular trial; one may wish to ask whether in the circumstances he or she would be motivated to do so. The **absence of a motive to take the allegedly inventive step makes an argument of obviousness more difficult** ...

(7) Seventhly, the fact that the **results of research which the inventor actually carried out are unexpected or surprising is a relevant consideration** as it may point to an inventive step...

(8) Eighthly, the courts have repeatedly emphasised that **one must not use hindsight**, which includes knowledge of the invention, in addressing the statutory question of obviousness. That is expressly stated in the fourth of the

Windsurfing/Pozzoli questions ...

(9) Ninthly, it is necessary to consider whether a feature of a claimed invention is **an added benefit in a context in which the claimed innovation is obvious for another purpose ...**"

12. The decision of Delhi High Court succinctly summarized the steps to be undertaken while assessing the claimed invention for obviousness. In the present case, the Respondent No.3 referred to D1 US57825313 to assert that the teachings presented in the cited prior art D-1 makes it evident that the features claimed in the seal of the impugned application can be readily anticipated and the claims 1-2 of impugned application fails to meet the test of novelty. D-1 and D-2 US6390519 were referred to assert that by combining the teachings of the cited D-1 and D-2 obviousness can be established for the claimed features in the impugned application. The Controller while rejecting the opposition on ground of prior art held that the same features as claimed in the present invention are not located in the cited documents and while deciding the opposition under Section 25(1)(e) arrived at a contrary finding that cited prior art D-1 discloses the same technical features.

13. While allowing the opposition under Section 25(1)(e), the Controller created a mosaic of D-1 and D-2 to come to finding that related prior art documents completely anticipate the present patent application and would be obvious to a person skilled in the art. The

Calcutta High Court in **Guangdong Oppo Mobile Telecommunications Corp. Ltd. vs. The Controller of Patents and Designs** (supra) noted the decision in **Enercon (India) Ltd vs Aloys Wobben (ORA/08/2009/PT/Ch)** that mere existence in the prior arts of each of the elements in the invention will not *ipso facto* mean obviousness. There must be a coherent thread leading from the prior arts to the invention, the tracing of the thread must be an act which follows obviously and should not be a hindsight deduction.

14. The Controller has failed to apply the steps as laid down in **F. Hoffmann-La Roche Ltd.** (supra) while arriving at the conclusion of lack of inventive ingenuity. The findings of the Controller does not identify the inventive concept as claimed by Applicant nor does it consider the differences between the claimed invention and prior art as pointed by the Applicant. It is not sufficient to arrive at a conclusion about the invention lacking inventive steps without discussion on the manner in which the invention was obvious to a person skilled in the art. As held in **Avery Dennison Corporation**(supra), the Controller has to analyse as to what is the existing knowledge and how the person skilled in the art would move from the existing knowledge to the subject invention captured in the application under consideration and without such analysis, the rejection would be unsustainable.

15. Perusal of the impugned order would indicate that the Controller has failed to consider the written submissions filed by the Petitioner in order to differentiate the prior art from the claimed invention and neither the judgments cited in support has been considered. Though it is sought to be contended that by learned counsel appearing for the Respondent No.3 that there is no material to show inventiveness, the impugned order does not demonstrate the necessary discussion on obviousness as laid down in ***F. Hoffmann-La Roche Ltd.*** (supra). For the said purpose, the written submissions of the Petitioner which referred to the differences in the claimed invention and the prior art were required to be taken into consideration which has not been done in the present case.

16. In light of the above, the Petitioner has made out a case for remand of the matter. The impugned order dated 22nd August, 2023 is quashed and set aside. The subject patent application is remanded to the Controller for reconsideration afresh after providing afresh opportunity of hearing to both the parties. As the matter is being remanded, the Controller is requested to decide the same as expeditiously.

17. The Petition is allowed in above terms.

[Sharmila U. Deshmukh, J.]