



2025:DHC:2789



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

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*Date of decision: 16<sup>th</sup> April, 2025*+ **C.A.(COMM.IPD-PAT) 21/2024 & I.A. 9314-9317/2024****MARELLI EUROPE S.P.A.**

.....Appellant

Through: Mr. Ranjan Narula, Ms. Suvarna  
Pandey, Mr. Shakti Nair and  
Mr. Parth Bajaj, Advocates

versus

**THE DEPUTY CONTROLLER OF  
PATENTS AND DESIGNS**

.....Respondent

Through: Mr. Jagdish Chandra, CGSC with  
Mr. Shubham Kumar Mishra,  
Mr. Ramnik Mishra and Mr. Tushar  
Arora, Advocates for UOI**CORAM:****HON'BLE MR. JUSTICE AMIT BANSAL****AMIT BANSAL, J. (Oral)**

1. The present appeal has been filed against the order of the respondent dated 28<sup>th</sup> December, 2023, refusing the grant of the Indian Patent Application No. 495/DEL/2013 (hereinafter 'subject patent application') filed on 21<sup>st</sup> February, 2013, having priority date of 22<sup>nd</sup> February, 2012 from an application filed in Italy bearing no. ITBO20120085A1 in respect of the invention titled '*HYDRAULIC SERVO-CONTROL OF A SERVOCONTROLLED GEARBOX*'.

2. The subject patent application was published under Section 11A of the



Patents Act, 1970 on 16<sup>th</sup> January, 2015. The First Examination Report was issued by the respondent on 6<sup>th</sup> February, 2019, which was replied to by the appellant on 6<sup>th</sup> August, 2019. Thereafter, a hearing was held before the respondent on 10<sup>th</sup> January, 2023, and post hearing submissions were filed on 24<sup>th</sup> January, 2023.

3. The respondent, *vide* order dated 28<sup>th</sup> December, 2023 (hereinafter ‘impugned order’), has rejected the subject patent application on the ground of lack of inventive step under Section 2(1)(ja) of the Patents Act, 1970 in view of prior art documents D1 to D5, which are,

D1: (US4875665A)

D2: (US3875748A)

D3: (US20020035832A1)

D4: DE 10143830

D5: US 3537357

4. The grievance of the appellant is that the respondent has passed the impugned order in a mechanical manner without providing any reasoning or justification for the same. It is submitted that in the section of the impugned order ‘*why present alleged invention is not inventive*’, the respondent has simply copied the extracts from the prior art documents. The respondent has not given any reasoning as to how the subject invention is covered by the cited prior art documents D1 to D5.

5. It is also the grievance of the appellant that in the section of the impugned order ‘*My observation/opinion*’, no reasons have been given as to why the subject patent application lacks inventive step.

6. The respondent has simply given his conclusion that the subject patent



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application cannot be considered as inventive under Section 2(1)(ja) of the Patents Act, 1970.

7. At this stage, reference may be made to the judgment of a Coordinate Bench of this Court in ***Agriboard International LLC v. Deputy Controller of Patents and Designs***, 2022 SCC OnLine Del 940. The relevant observations are set out below:

*“23. The said reasoning has been reiterated by the Supreme Court in Manohar v. State of Maharashtra & Ors. AIR 2013 SC 681 wherein it has been categorically observed that **application of mind and recording of reasoned decision are the basic elements of natural justice. There can be no doubt that scrupulous adherence to these principles would be required while rejecting patent applications.***

*24. In the opinion of this Court, while rejecting an invention for lack of inventive step, the Controller has to consider three elements-*

- *the invention disclosed in the prior art,*
- *the invention disclosed in the application under consideration, and*
- *the manner in which subject invention would be obvious to a person skilled in the art.*

*25. Without a discussion on these three elements, arriving at a 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. Section 2(1)(ja) of the Act defines „inventive step“ as under:*

*(ja) “inventive step” means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.*

*26. **Thus, 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. Without such an analysis, the rejection of the patent application under Section 2(1)(ja) of the Act would be contrary to the provision itself.** The remaining prior arts which are cited by Id. Counsel having not been considered in the impugned order, the Court does not wish to render any opinion in this regard.”*

[emphasis supplied]



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8. The Court has carefully perused the impugned order. A perusal of the impugned order shows that in the section of the impugned order dealing with '*why present alleged invention is not inventive*', the respondent has simply copied extracts from the prior art documents. The respondent has not given any reasoning as to how the subject invention is covered by the cited prior art documents D1 to D5. The appellant had filed detailed submissions before the respondent seeking to distinguish cited prior arts from the subject invention, however, the impugned order has not analysed the reasoning offered by the appellant.

9. Mr. Ranjan Narula, counsel for the appellant, has relied upon the judgment of a Coordinate Bench of this Court dated 14<sup>th</sup> December, 2022 in *Art Screw Co., Ltd. v. The Assistant Controller of Patents and Designs, 2022/DHC/005571*, wherein a similar order was passed rejecting the patent application, in which the Court had observed that the respondent has simply set out the disclosures contained in the prior arts therein. The relevant observations made in *Art Screw* (supra) are set out below:

*"7. A finding that an invention for which a patent is sought, lacks in inventive step is a serious finding. It compromises, seriously, even the inventive integrity of the applicant-inventor. The assessment of whether, in inventing the invention, any inventive steps was involved, has to be examined after taking into account a variety of factors in respect of which there are several authoritative pronouncements, including many of the Supreme Court."*

10. Counsel for the respondent submits that after the impugned order was passed, some additional material has come to the knowledge of the respondent which according to the respondent, the appellant has failed to disclose.

11. However, a reference to new material as well as the alleged suppression by the appellant has been made for the first time by the respondent in the



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counter affidavit filed before this Court. There is no reference to such additional material or the element of suppression in the impugned order.

12. This Court in the present appeal is examining the correctness of the impugned order passed by the respondent and the appeal has to be decided on the basis of the material on record before the Patent Office when the subject patent application was adjudicated.

13. Clearly, at this stage, the Court cannot look into the aspect of new material which has come to the knowledge of respondent and in respect of which averments have been made for the first time in the counter affidavit. It is a settled position of law that the impugned order cannot be improved by the averments made in the counter affidavit.

14. In the present case, this Court is satisfied that the impugned order has been passed in a mechanical manner without proper application of mind. The impugned order does not contain reasoning which can withstand the judicial scrutiny.

15. Accordingly, the impugned order is set aside and the matter is remanded back to the Patent Office for a fresh consideration.

16. The Controller would afford a fresh opportunity of hearing both sides before deciding the subject patent application after giving a hearing notice to the appellant. If any new material has come to the knowledge of the respondent, the same would be put to the appellant in the hearing notice so that the appellant has an opportunity to deal with the same.

17. In the peculiar facts and circumstances of the case, let the matter be placed before an officer other than the one who had passed the impugned order.



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18. Taking into account that the subject patent application was filed as far back on 21<sup>st</sup> February, 2013, the respondent is directed to take a decision in the matter as expeditiously as possible and in any event within three months from today.

19. All contentions of the parties are kept open.

20. The present appeal stands disposed of.

21. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trade Marks of India on the e-mail- [llc-ipo@gov.in](mailto:llc-ipo@gov.in) for compliance.

**AMIT BANSAL, J**

**APRIL 16, 2025**

**ds**