



2025:DHC:8256



\$~48

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

Date of decision: 09th September, 2025

+ C.A.(COMM.IPD-PAT) 1/2023

LUOSSAVAARA KIIRUNAVAARA ABAppellant

Through: Ms. Vindhya S. Mani, and Ms.
Vedika Singhvi, Advocates

versus

THE ASSISTANT CONTROLLER OF PATENTS AND DESIGNS

.....Respondents

Through: Mr. Nitinija Chaudhry, SPC with Mr.
Rahul Mourya, Advocates

%

CORAM:

HON'BLE MS. JUSTICE MANMEET PRITAM SINGH ARORA

J U D G M E N T

MANMEET PRITAM SINGH ARORA, J (ORAL):

1. The present appeal has been filed under Section 117-A (2) of the Patents Act, 1970 [‘the Act’] against the impugned order dated 15.09.2022 passed by the Assistant Controller of Patents and Designs, whereby the patent application bearing number 3753/DELNP/2013, and titled “METHOD ARRANGEMENT AND PELLETISING PLANT” [‘subject application’] has been refused.
2. Brief facts leading to filing of the present appeal are that the appellant/applicant filed the subject application at the Patent Office, New



2025:DHC:8256



Delhi on 29.04.2013 through its authorised Patent Agent.

The subject application is based out of PCT¹ International Application PCT/SE2011/051273 having international filing date 26.10.2011 and it claims priority from Sweden10511087 dated 26.10.2010.

3. The request for examination was filed at the Patent Office on 24.09.2014, which was within the 48 months' period from the date of earliest priority. The Patent Office issued First Examination Report ['FER'] on 29.01.2019. The objections raised in the said FER are as under: -

a) The subject matter of claims 1-22 does not constitute an invention under Section 2(1)(ja) of the Act for lack of inventive step in view of the following documents: -

- D1: US6338366B1, published on 15.01.2002 ['D1']
- D2: EP0079264B1, published on 12.03.1986 ['D2']
- D3: US3782888A, published on 01.01.1974 ['D3']

b) The subject matter of the invention claimed in claims 1-22 falls within scope of clause (f) of Section 3 of the Act, and is, hence, not patentable.

c) The subject matter of claims 1, 12 and 21 does not involve a single inventive concept and does not relate to a single invention in view of sub-section (5) of Section 10 of the Act.

d) The subject matter of claims 2-11, and 13-22 is not definitive in view of clause (c) of sub-section (4) of Section 10 of the Act.

4. The applicant/appellant through its authorized agent on 18.10.2019, duly filed its reply to said FER along with the amended claims 1-22.

5. A hearing notice was issued by the Patent Office on 12.05.2022.



2025:DHC:8256



However, after several adjournments, the hearing happened on 28.07.2022 based on re-issued hearing notice dated 14.07.2022. The relevant objections outstanding in the hearing notice are reproduced here below for clarity: -

“Non-Patentability u/s 3

1. Claims 12-20 teaches arrangements of several screens as claimed in Claim 1. Arrangements of no of device which working independently and after arrangements it will also work in same manner only technical affect was output of one unit multiply with no of units arranged falls within scope of section 3 (f) of Patent Act “what are not invention”.
2. Claims 21-22 teaches application or use of device as claimed in Claim 1. Application claim/ used claim of any device falls within scope of section 3 (d) of Patent Act "what are not invention".

Other Requirement(s)

1. Title is not consistent with description and claims.

Reference to co-pending/foreign application(s)

1. There are two applications filed for the same subject matters (Viz. 3755/DELNP/2013 & 3756/DELNP/2013). Clarification is required regarding subject matters of the instant application along with the above mentioned two applications. i.e. How the subject matter is different and why not it should be considered as double patenting.

Unity of Invention u/s 10 (5)

1. Claims 1: a method for heating
Claims 2-11: different method for heating
Claims 12-20: An arrangement for heating
Claims 21-22: A pelletising plant
Claims (sic) describes different constructional features which does not appear to contain any additional features which, in combination with the features of any claim to which they refer, meet the requirement of Act with respect to novelty and/or inventive step. Thus the claims as a whole are not clear and not concise, and the requirement of section 10(5) of the Act is not met.”

[Emphasis Supplied]

¹ Patent Corporation Treaty



6. After hearing, the appellant filed its written submissions on 11.08.2022 along with amended claims 1-20.

7. Thereafter, impugned order was passed by the Assistant Controller refusing the subject application citing Sections 3(f), 10(5) of the Act and “double patenting”. The relevant extracts from the impugned order are set out below: -

“Subject matter of application lacks in unity of invention U/s 10(5) as different constructional features which does not appear to contain any additional features which, in combination with the features of any claim to which they refer, meet the requirement of Act with respect to novelty and/or inventive step. Thus the claims as a whole are not clear and not concise, and the requirement of section 10(5) of the Act is not met.

.....

Regarding identical subject matter of application was filed by applicant in Patent Office in application no 3755/DELNP/2013 & 3756/DELNP/2013. Filing multiple applications for same subject matter and same was granted due to hiding or non disclosure of identical application by applicant or patent attorney. Three application are filed by same attorney/ firm. Attorney who are registered as per Patent Act are well aware about facts that double patenting is not allowable, if same subject matter was filed in Patent Office in India have to be disclosed in other application. Supression of facts were not allowed in patent Act U/s 130(1). Even, Hon’able Courts also not allowing for filing multiple applications for same subject matter from parents to multiple divisional on same subject matters.

3753/DELNP/2013 for subject matter “METHOD ARRANGEMENT AND PELLETISING PLANT” documents is signed by jaya Pandaya.

3755/DELNP/2013 for subject matter “METHOD ARRANGEMENT AND PELLETISING PLANT” documents is signed by jaya Pandaya.

3756/DELNP/2013 for subject matter “METHOD ARRANGEMENT AND PELLETISING PLANT” documents is signed by jaya Pandaya.

Attorney of applicant **hide the facts of filing same subject matter in**



2025:DHC:8256



multiple application in office on same day. Attorney of applicant in his hearing submission describe that do not concern the same subject matter but fails to describe exactly the difference.

In method claims no inventive method step was identified, as per applicant claim inventor contribution lies in arrangement in method i.e. **“arrangement of the combustion arrangement (5), or a part of it, in a region (A) in the inlet (4) that, in turn, is arranged outside of the direct passage of the first medium in and through the inlet (4) such that the 15 ignition of the fuel, the combustion of the fuel and the transfer of combustion heat to the first medium (3) take place in this region (A), followed by onward transport of the heated first medium (3) from the region (A) into the compartment (1) through the inlet (4).”**. which is not method step and multiple sets of arrangements were disclosed in claims 12-20.

Arrangement is not step of process and method.

Arrangement claimed in claims 12-20 are also multiple arrangements of heating of first medium i.e. air in the inlet (4) without any intake of second medium;

preheated first and second medium outside before supplied in inlet(4);

intake (8) for second medium connected innermost side inlet side (4.1a).

Applicant fails to disclose the inventive contribution steps of method in method claims. And also fails to link multiple setup of arrangements as optional features or special technical features or narrow down the scope.

Claims lack(s) unity of invention as the claims do not relate to a single invention or to a group of inventions linked so as to form a single inventive concept. Claims describes different constructional features which does not appear to contain any additional features which, in combination with the features of any claim to which they refer, meet the requirement of Act with respect to novelty and/or inventive step and falls within scope of section 3 (f) of Patent Act “what are not invention”.”

[Emphasis Supplied]

8. Ms. Vindhya S. Mani, counsel appearing on behalf of the appellant,



2025:DHC:8256



submits that one of the grounds raised in the impugned order by which the subject application was refused was based on ‘double patenting’ and alleged suppression of facts regarding two other patents applications, which are barred under Section 130(1) of the Act.

8.1. She states that the aforesaid objection of double patenting is misconceived. She states that the subject application and the other two patent applications referred in the impugned order are pertaining to different subject matters. She refers to the explanation set out at paragraph B of the written submissions filed before the court in the present appeal. According to the written submission, appellant argues that each of the three patent applications are pertaining to different subject matters covered in distinct set of claims, even though they are concerning the same machine. Further, she also brings to the attention of the court that controller had failed to appreciate the three different application numbers of the cited patent applications that are derived from different priority numbers. She states that before arriving at the finding of double patenting, the Respondent ought to have undertaken an inquiry with regards to the claims of invention in the three applications. Therefore, she states that the finding of the double patenting is ex-facie erroneous.

8.2. Regarding the reference to Section 130(1) of the Act, she states that such a reference to Section 130(1) of the Act was made for the first time in the impugned order and finds no mention in the hearing notice. She states that the said provision is inapplicable to the finding of double patenting. She states that scenario of double patenting may only arise in accordance with Section 13(1)(b) of the Act, which however is inapplicable since all the three patent applications were filed on the same date.



8.3. Regarding the objection under Section 3(f) of the Act, she submits that impugned order has not given appropriate reasons qua objection under Section 3(f) of the Act. She states that Respondent has acknowledged the novelty of the claimed invention in the FER and withdrawn the objection pertaining to lack of inventive step in the hearing notice dated 14.07.2022. Moreover, the impugned order fails to record which of the components as claimed are known and are functioning in a known manner. She states that recording these findings by the Respondent is the requirement of Section 3(f) of the Act.

She refers to the averments in the appeal (paragraphs 45 onwards) and her written submissions in Section C filed before this Court to explain that the invention claimed by the appellant in the subject application is not hit by Section 3(f) of the Act. She states that the Respondent has failed to give any reasons in the order for not accepting the aforesaid explanation of the Respondent.

8.4. Regarding objection under Section 10(5) of the Act, she submits that the Respondent has incorrectly noted that claims 1 to 20 lack unity of invention and the claimed invention does not meet the requirements under Section 10(5) of the Act. She states that this objection was raised in the hearing notice and Petitioner had filed its written submissions and given its response. She states that the said response is not even referred to in the impugned order and merely a conclusion has been recorded by the Respondent.

8.5. She submits that in these facts the Petitioner is seeking a remand.

8.6. Aggrieved by the irregularities in the order, the appellant has also requested for the subject application be placed before a different controller.



2025:DHC:8256



9. In response, learned counsel for the Respondent states that the impugned order records reasons which led the Respondent to hold that the subject matter of the patent application was not an invention as per Section 3(f) of the Act. Further, he relied upon the written submissions filed in the present appeal.

10. This Court has heard the counsel for the parties.

11. A perusal of the impugned order would show that the subject application has refused on the grounds of double patenting, 3(f) and 10(5) of the Act.

Double Patenting

12. The appellant in their written submissions dated 11.08.2022 filed in response to the hearing notice at paragraphs 4.2 and 4.3 has responded to the objection of double patenting. The appellant clarified that the subject matter of the subject application is distinct from both of the patent applications cited in the impugned order. The relevant paragraphs 4.2 and 4.3 read as follows: -

“4.2 The Applicant submits that the present Application and the two cited Applications, namely, Indian patent application nos. 3755/DELNP/2013 and 3755/DELNP/2013, are filed by the same Applicant and **have the same priority dates, i.e., October 26, 2010.** The Applicant submits herewith copies of Form 1 of the cited Applications indicating the details of the priority Application and the priority date. In view of the above, the Applicant submits that the since **the priority date of the claims of the present application under consideration is *not later than* the priority date of the cited Applications,** the Applicant is not required to make any references to the cited Applications in the specification or amend the claims.



4.3 Further, the Applicant also submits that the cited Applications 3755/DELNP/2013 and 3756/DELNP/2013 do not concern the same subject-matter as the present patent application, which is clearly evidenced by the respective patent claims in each of the applications.”

[Emphasis supplied]

13. In the Section B of the written submissions dated 12.10.2023 of the present appeal also, the appellant has set out a comparison table illustrating the distinctiveness of the technical problems addressed, their solutions along with claims of subject application compared to two applications cited in the impugned order.

14. Having perused the written submissions dated 11.08.2022 and the written submissions dated 12.10.2023, this Court finds merit in the submission of the appellant that before returning a finding on double patenting the Respondent ought to have made an inquiry with regard to sameness of the claimed invention in all the three applications.

15. It appears on a perusal of the impugned order that the Respondent has merely perused the titles of the patent applications i.e., 3753/DELNP/2013, 3755/DELNP/2013, 3756/DELNP/2013 for comparing their subject matter without conducting a comparative analysis of the claims therein.

16. Learned counsel for the Respondent was unable to explain the findings of double patenting in the impugned order, especially in view of the comparison and explanation of the claimed invention in each of the three patent applications, set out by the appellant in its written submissions.

17. In the opinion of this Court, the impugned order fails to show any inquiry undertaken by the Respondent vis-à-vis the claimed invention in the three (3) applications, thereby making the conclusion of double patenting



unreasoned.

Section 130(1) of the Act

18. In the hearing notice there was no reference to Section 130(1)² of the Act. The reference to Section 130(1) of the Act has firstly been raised by the Respondent in the impugned order alleging that the patent agent in the present instance has suppressed material facts regarding previous patents obtained on same subject matter.

19. Therefore, no opportunity was given to the appellant and its patent agent to put forth its response vis-à-vis regarding the objection under section 130(1) of the Act.

20. The counsel representing appellant has illustrated the difference in the subject matter claimed in two cited patent applications from that of the subject application.

21. In this Court's opinion, the aforesaid differences pointed out by the appellant in the three applications need to be considered by the Respondent before making an observation against the patent agent vis-à-vis Section 130(1) of the Act; as it has ramifications.

Section 3(f) of the Act

22. This Court also finds merit in the submission of the appellant that the impugned order fails to record reasons for returning the finding that the subject matter falls within the scope of Section 3(f). For a subject matter to fall under Section 3(f), it has to be concluded that the invention covered in

² Section 130. **Removal from register of patent agents and restoration.** — (1) The Controller may remove the name of any person from the register when he is satisfied, after giving that person a reasonable opportunity of being heard and after such further inquiry, if any, as he thinks fit to make—

(i) that his name has been entered in the register by error or on account of misrepresentation or suppression of material fact;

(ii) that he has been convicted of any offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity which in the opinion of the Controller renders him unfit to be kept



the subject claim is: -

- i. A mere arrangement/rearrangement/duplication of known devices;
- ii. Each of the known devices therein are capable of functioning independently in a known manner

23. The impugned order fails to demonstrate how the components of the subject claims are functioning independently or in a known manner. While referring to Section 3(f), Respondent has also concluded that the claims of the subject application lack novelty and/or inventive step. However, the impugned order fails to cite any document/prior art based on which the Respondent has concluded that the subject matter lacks novelty and/or inventive step.

24. The impugned order therefore suffers from lack of reasons to enable this Court to appreciate the merits of the findings in the impugned order on Section 3(f) of the Act.

25. With respect to the finding of the Respondent on Section 10(5) of the Act, this Court finds merit in the submission of the Petitioner that its response to the said objection in its written submission filed prior to the hearing have not been noticed or dealt with by the Respondent in the impugned order.

26. In the considered opinion of this Court, the impugned order fails to deal with the submissions of the Petitioner on the objections raised in the hearing notice and record reasons for its conclusions; thus, meriting a remand as prayed for by the Petitioner. A reference may be made to the judgment of a Coordinate Bench of this Court in **Agriboard International**

in the register.



LLC v. Deputy Controller of Patents and Designs³. The relevant extracts of the said judgment are reproduced as under: -

“22. The Supreme Court in **Assistant Commissioner v. Shukla and Brothers (supra)**, has categorically held that passing of a reasoned and a speaking order is an integral part of the principle of audi alteram partem. The relevant paragraph reads as under:

“9. The increasing institution of cases in all Courts in India and its resultant burden upon the Courts has invited attention of all concerned in the justice administration system. Despite heavy quantum of cases in Courts, in our view, it would neither be permissible nor possible to state as a principle of law, that while exercising power of judicial review on administrative action and more particularly judgment of courts in appeal before the higher Court, providing of reasons can never be dispensed with. The doctrine of audi alteram partem has three basic essentials. Firstly, a person against whom an order is required to be passed or whose rights are likely to be affected adversely must be granted an opportunity of being heard. Secondly, the concerned authority should provide a fair and transparent procedure and **lastly, the authority concerned must apply its mind and dispose of the matter by a reasoned or speaking order.** This has been uniformly applied by courts in India and abroad.”

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.

[Emphasis supplied]

27. In the aforementioned facts, the impugned order is set aside and the matter is remanded back to the Controller for a *de-novo* consideration.

28. The Controller would afford a fresh opportunity of hearing the appellant before deciding the subject application after giving a hearing notice to the appellant. If any new material comes 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.

³ 2022 SCC OnLine Del 940



29. Accordingly, the appeal is allowed and the following directions are passed: -

- i. The impugned order is set aside and the matter is remanded back to the Patent Office for a fresh consideration.
- ii. Prior to deciding the matter afresh, the Controller shall issue a fresh hearing notice clearly delineating the objections.
- iii. The applicant shall have the liberty to file fresh written submissions with amended claims.
- iv. The Patent Office shall endeavour to decide the subject application in an expeditious manner, preferably within three (3) months from today.

30. Considering the irregularities in the impugned order, let the matter be placed before an Officer other than the one who had passed the impugned order.

31. The appeal stands disposed of in the aforesaid terms.

32. The Registry is directed to send a copy of the present order to the office of the Controller General of Patents, Designs and Trade Marks at the e-mail - *llc-ipo@gov.in* for compliance.

MANMEET PRITAM SINGH ARORA, J
SEPTEMBER 9, 2025/hp/FV/MG