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

+ **W.P.(C)-IPD 43/2025, CM 192/2025 & CM 193/2025**

PROVIVI, INC.

.....Petitioner

Through: Mr. Hari Subramaniam, Mr. Sanuj Das
and Ms. Aditi Subramaniam,
Advocates.

versus

THE CONTROLLER OF PATENTS AND DESIGNS.....Respondent

Through: Mr. Satya Narain Swain, CGSC with
Mr. Kautilya Birat, Mr. Ankush Kapoor
and Mr. Vishwadeep, Advocates.

CORAM:

HON'BLE MR. JUSTICE TUSHAR RAO GEDELA

ORDER

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30.01.2026

1. The present writ petition under Articles 226 and 227 of the Constitution of India has been filed assailing the order dated 30.05.2023 passed by the Assistant Controller of Patents & Designs in respect of the application of the petitioner titled "*MICRO ORGANISM FOR THE PRODUCTION OF INSECT PHEROMONES AND RELATED COMPOUNDS*" submitted on 17.05.2018.
2. According to the petitioner, on 18.11.2016 PCT International Application No.PCT/US2016/062852 was filed claiming priority from US62/257,054 (18.11.2015) and US62/351,605 (17.06.2016). On 17.05.2018, a National Phase Application was filed in India by the petitioner as Indian Patent Application no.201817018490, the 31 months statutory deadline to enter the National Phase in India concluded on 18.06.2018 whereafter on 07.09.2018 the Patent Applications were published under Section 11A of the Patents Act, 1970.
3. Subsequent to the request for examination, the First Examination Report



(hereinafter referred to as “FER”) was issued on 20.05.2022. The petitioner had submitted its reply to the FER on 19.07.2022. It is stated that the hearing notice was issued by the Controller on 03.05.2023 which according to the petitioner, was never received by its Agents in India. The hearing was scheduled on 19.05.2023 on which date, there was no representation on behalf of the petitioner, ostensibly on the ground that the hearing notice dated 03.05.2023 was not received. It is further stated that, by the order dated 30.05.2023, the Controller refused to accept the Patent Application. The petitioner also further submits that the said impugned order also was never received by the petitioner or its agents.

4. The petitioner claims that subsequently the petitioner, through its agent, filed an updated statement and undertaking on Form-3 as mandated by the statute on 06.07.2023 through online filing portal of the Indian Patent Office. Thereafter, the petitioner’s agent checked the status of the patent to verify the statement. It was at that point of time the agent became aware of the refusal of the patent application by the Assistant Controller.

5. Having obtained the said information, the agent immediately wrote to the respondent on 25.08.2023 informing the office that neither the hearing notice nor any impugned order was received either by the agent or by the petitioner. It is also further stated that the petitioner’s agent kept following up with the Patent’s office either verbally or through the telephonic mode. Since all the efforts made by the agent went in vain, the petitioner wrote yet again to the respondent on 11.10.2024 requesting resolution of the said matter. It was to this communication/e-mail letter, that the respondent vide the reply dated 15.10.2024 informed the petitioner that the office records maintained by the Patent Office clearly indicated that the e-mails in respect of the hearing as also the information in respect of the impugned order were successfully delivered and despatched to the registered e-mail address of the petitioner.



6. It was in these circumstances that the petitioner was constrained to file the present writ petition assailing the impugned order on the aforesaid facts.

7. This Court has heard the arguments of learned counsel for the parties and has also perused the impugned order and the other records available.

8. The Hon'ble Supreme Court in ***Assistant Commissioner v. Shukla and Brothers***, reported in ***(2010) 4 SCC 785***, has held that passing of a reasoned and a speaking order is an integral part of the principle of *audi alteram partem*. The Hon'ble court further held that a person against whom an order is required to be passed must be granted an opportunity of being heard. It is apparent from the recitals of the writ petition that the petitioner has categorically denied having received either the hearing notice dated 03.05.2023 or even the impugned order dated 30.05.2023. Having regard also to the fact that the petitioner claims to have also furnished a reply to the FER on 19.07.2022, there would not be any reason why the petitioner would not participate in the hearing afforded to it on 03.05.2023. That apart, the Patent's office ought to have atleast afforded another opportunity to the petitioner before the Assistant Controller passed the impugned order.

9. This Court has also perused the impugned order which is placed on record and finds that even the said impugned order is bereft of any reasons in the sense that even submissions made in the reply filed by the petitioner in response, do not appear to have been considered on their merits. The findings merely reproduce whatever was presented as an objection under the First Examination Report to the petitioner, and concludes as under:

“Neither, applicant's agent informed the controller whether or not he/she will attend the hearing (Sub-rule 4 of Rule 28 of the Patents Rules), nor anyone attended the hearing on the scheduled date. Further, there was no communication received from applicant's agent regarding adjournment of scheduled hearing OR submit justification to the pending objections raised in the hearing notice.



Consequently, it is considered that the applicant has failed to comply with the requirements of objections conveyed with the hearing notice dated 03rd May 2023. The objections in the hearing notice are self-explanatory and no further detailed discussion is required in respect of the same objections. Therefore, I hereby order that the grant of a patent is refused for the patent application No. 201817018490 under section 15 of the Act.”

10. A perusal of the operative portion of the impugned order clearly brings out that the Assistant Controller only noticed that the petitioner’s agent did not inform the Controller as to whether he would or would not afford the hearing. The Controller also observed that there was no communication received from the petitioner’s agent seeking any adjournment of the scheduled hearing and therefore, on that basis concludes that the petitioner has failed to comply with the requirements of the objections conveyed with the hearing notice dated 03.05.2023.

11. To the mind of this Court, even if the Assistant Controller had to refuse the patent application on merits, the application could have been decided by the Assistant Controller, but only by affording reasons in writing after applying his mind to the reply submitted to the objection in the FER. This Court does not find reasons recorded with respect to the reply of petitioner submitted on 19.07.2022.

12. The only reasoning provide in the impugned order is reproduced hereunder:

“E. Reply to FER dated 20.05.2022 was filed within the stipulated time period on 19.07.2022 along with other necessary documents. However, after considering the amendments the objections regarding inventive step are still stand due to the following reasons:

D3 discloses complete eds of H. zea acyl Co A delta 11 desaturase.

D4 discloses that ADH1-ADH7, FADH and FAOI are responsible for the oxidation of fatty alcohols. D4 further discloses that a Yarrowialipolytica strain carrying deletions in all of these genes accumulates more 1-dodecanol and less dodecanoic acid than the wild



type strain.

D5 discloses field of processes for the production of conjugated unsaturated fatty acids from insects, wherein a recombinant microorganism expresses at least one exogenous nucleic acid molecules encoding a fatty acyl conjugases that catalyzes the conversion of a saturated or mono-unsaturated C6-C20 fatty acyl Co A to a corresponding polyunsaturated C6-C20 Fatty acyl Co-A. Therefore, the said claims lack inventive step in view of D3-D5."

The above only notes the disclosure made in the prior art document D3 to D5 and does not identify the inventive features claimed in the subject Application. The learned Controller has to state how the disclosure made in the cited documents renders the claimed invention of subject Application, obvious. In ***Agriboard International LLC vs Deputy Controller of Patents and Designs***, reported in ***2022 SCC OnLine Del 940***, the Court has laid down following three steps to be followed by the Controller while raising the objection of lack of inventive step. The relevant paragraphs are reproduced hereunder:

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.

13. No such steps appear to have been followed in the impugned order.
14. That apart, the respondent vide the communication dated 15.10.2024 claims to have informed the petitioner that their office records indicate that the e-mails have been successfully despatched to the E-mail Id: kevin@groserandgroser.com belonging to the petitioner of the hearing notice dated 03.05.2023 at 12:39:58. However, that would still not suffice the mandate of principles of natural justice and the petitioner in any case, ought to have been afforded another opportunity.
15. It is apparent from the aforesaid that not only is the impugned order unsustainable for the reason that it violates the principles of natural justice but also for the reason that it is bereft of any reason as to why the patent application of the petitioner is refused. Even if this Court were to come to the conclusion that the communication of the hearing notice was indeed despatched to the correct e-mail address, yet, the mandate of the Patents Act that obligates the Assistant Controller to have passed a reasoned order, is still not complied with.
16. In that view of the matter, for the reasons aforesaid, this Court is unable to sustain the impugned order and the same is set-aside.
17. It would be in the interest of justice, to remit the matter for a fresh hearing and a *de-novo* consideration by the Assistant Controller after affording an opportunity of hearing to the petitioner. It is ordered accordingly.
18. The Patent's office is directed to issue a fresh hearing notice to the petitioner upon the petitioner furnishing a fresh e-mail address or any other address of its agent just to ensure that the communication in respect of the hearing notice is delivered at the right address. The petitioner shall furnish the correct details to the Patent's office within one week from date. The Patent's



office is also directed to issue a hearing notice within next two weeks thereafter. The Assistant Controller shall afford a personal hearing to the agent of the petitioner and decide the patent application, in accordance with law.

19. The petition is disposed of in above terms.
20. Pending applications also stand disposed of.

TUSHAR RAO GEDELA, J

JANUARY 30, 2026

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