



2026:DHC:1298



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

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Date of Decision: 9th February, 2026+ **C.A.(COMM.IPD-PAT) 67/2024****PPC BROADBAND INC**

.....Appellant

Through: Mr. Prashant Phillips, Ms. Vindhya S.
Mavi and Ms. Ardra Goodwin, Advocates.

versus

**THE ASSISTANT CONTROLLER OF PATENTS
AND DESIGNS**

.....Respondent

Through: Ms. Nidhi Raman, CGSC with Mr.
Om Ram and Ms. Nikita Singh, Advocates.**CORAM:****HON'BLE MS. JUSTICE JYOTI SINGH****JUDGEMENT****JYOTI SINGH, J. (ORAL)**

1. This appeal is filed on behalf of the Appellant under Section 117A of The Patents Act, 1970 ('1970 Act') challenging order dated 28.03.2024 passed by the Respondent, whereby Respondent has refused to grant patent under Section 15 of 1970 Act in respect of Patent Application No. 202017011789 i.e., 'REEL ENCLOSURES'. Direction is sought to the Respondent to grant the patent as a consequence of setting aside the impugned order.

2. To the extent necessary, the factual matrix as averred in the appeal is that on 11.09.2018, Appellant filed a PCT application PCT/US2018/050536 claiming benefit of priority from Application No. 62/557,139 filed on 11.09.2017, 62/584,647 filed on 10.11.2017 and 62/613,047 filed on



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02.01.2018 in other jurisdictions. On 18.03.2020, Appellant filed the present application bearing Indian Patent Application No. 202017011789 with Claims 1-20 before the Indian Patent Office.

3. It is stated that the application was published in the Patent Journal on 21.08.2020 and on 17.09.2020, Appellant filed Proof of Right before the Controller. On 01.09.2021, Appellant filed a request for examination by filing Form 18. First Examination Report ('FER') was issued on 24.02.2022 and Appellant filed a response to the FER on 23.09.2022 with amended Claims 1-20, amended abstract, updated drawings and other documents. Hearing notice was issued on 25.01.2024 under Section 14 of 1970 Act, scheduling a hearing on 28.02.2024. After the hearing was concluded, Appellant filed written submissions on 14.03.2024 along with complete specification as well as amended claims re-numbered as Claims 1-10. On 28.03.2024, Respondent passed the impugned order and rejected the application for grant of patent under Section 2(1)(ja) of 1970 Act.

4. It is stated that present invention pertains to a reel (100) enclosure includes a base (102) and a panel (110) pivotally coupled with the base. The panel (110) is moveable between a first closed position and a second open position and is configured to hold a reel at an interior surface (130) of the door. The reel (100) is configured to have a cable wound thereon. In the first closed position, the base (102) is configured to prevent the reel (100) from rotating relative to the panel (110) and the base (102). The novel and inventive feature for which protection is sought is that panel (110) when in the second open position is configured to hold the reel (100) outside of an interior of the base (102, 202) and outside of an interior cavity of the panel



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(110, 210) and permits the reel (100) to rotate relative to the door (110) and the base (102). The amended pending Claim 1 is extracted hereunder for ready reference:-

“1. A reel enclosure (100, 200), comprising:

a base (102, 202); and

a panel (110, 210) pivotally coupled to the base (102, 202) and movable between a first closed position and a second open position,

wherein the panel (110, 210) is configured to hold a reel (140, 240) at an interior surface of the panel, the reel (140, 240) being configured to have cable wound thereon,

wherein, in the first closed position, the base (102, 202) is configured to prevent the reel (140, 240) from rotating relative to the panel (110, 210) and the base (102, 202), and

characterize in that:

wherein, in the second open position, the panel (110, 210) is configured to hold the reel (140, 240) outside of an interior of the base (102, 202) and outside of an interior cavity of the panel (110, 210) and to permit the reel (140, 240) to rotate relative to the panel (110, 210) and the base (102, 202).”

5. Learned counsel for the Appellant submits that the impugned order cannot be sustained in law for multiple reasons. The impugned order does not take into account the oral submissions made on 28.02.2024 during the hearing as also the written submissions dated 14.03.2024. During the oral hearing on 28.02.2024, Appellant was directed by the Respondent to narrow down the scope of claims to overcome the objection of lack of inventive step under Section 2(1)(ja) and as instructed, Appellant narrowed down and amended the scope of Claims 1-20 to align the scope with the subject matter of corresponding US Application, on which patent was granted on 13.07.2021. In the written submissions, Appellant submitted amended set of Claims 1-10, however, without assessing the scope of amended claims, the



application was summarily rejected and the objection of Section 2(1)(ja) was maintained. This not only violates principles of natural justice but also reflects non-application of mind by the Respondent.

6. It is argued that the consequences of not considering the amendment to the claims is that while passing the impugned order, Respondent has only considered the unamended Claims 1-20 and there is a repeated reliance on claim elements that were conspicuously present only in the deleted independent Claim 1, which is evident from the quoted claim element *'wherein at least one raised support structure on the interior surface of the panel is configured to cooperate with the hub of the reel to prevent rotation of the hub relative to the panel in both the first and second positions of the panel.'*, in the impugned order. This illegality is not isolated but runs through the analysis of all cited prior art references. This clearly demonstrates a failure to even examine the amended set of claims. In fact, Respondent has overlooked the *'characterised in that'* clause of amended Claim 1 and this has resulted in omission to consider the novel and inventive features.

7. It is contended that Respondent's stand that features recited in dependent claims are sufficient to sustain the impugned order is misconceived. Patentability cannot be assessed bypassing the independent claims and directly relying on dependent claim without a prior and reasoned evaluation of the independent claims. Respondent's contention that claimed amendments filed with written submissions could not be considered for want of Form 13 is equally misconceived. Even assuming that Form 13 was required, impugned order contains no finding on inadmissibility of the



amendments, which would justify their non-consideration on this ground. In any event, this contention of the Respondent is inherently inconsistent with the assertion that amended claim set was considered. Form 13 is required only for voluntary amendments and not when amendments are made in response to objections raised in the FER or hearing notices.

8. While grant of patents in other jurisdictions is not binding on the Respondent, however, the fact that corresponding applications have been granted in USA and Europe, does have a persuasive value but the Respondent has completely ignored this fact. In ***Qualcomm Incorporated v. Controller of Patents and Others, 2023 SCC OnLine Del 4308***, this Court has held that an order, which does not deal with the submissions advanced, suffers from manifest non-application of mind.

9. It is further argued that Respondent has failed to adhere to the five steps test laid down by the Division Bench of this Court in ***F. Hoffman-La Roche Ltd. & Anr. v. Cipla Ltd., 2015 SCC OnLine Del 13619***, and has completely overlooked step 4 and consequently, step 5. The five steps are as follows:-

“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 hideshow approach.”



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10. It is urged that step 4 explicitly requires the identification and assessment of the ‘differences’ if any, between the invention and prior arts. Instead of undertaking this exercise, Respondent has proceeded by merely identifying alleged similarities and has treated the similarities as determinative of the absence of inventive step, which is clearly contrary to the judgment in *F. Hoffman (supra)*. The other apparent error and illegality in the impugned order is that the steps undertaken have not been applied in the required sequence. In *Tapas Chatterjee v. Assistant Controller of Patents and Designs and Another, 2025 SCC OnLine Del 6369*, Division Bench of this Court has held that the steps envisaged in *F. Hoffman (supra)* are not only required to be followed but must be followed sequentially while examining the aspect of obviousness and existence of inventive step.

11. It is further urged that seven prior art documents D1-D7 were cited in respect of lack of inventive step, however, none of these documents when read together or even in different combinations render the present invention obvious. In respect of lack of inventive step, it is required to establish that the claimed invention has been taught and enabled by prior art documents in its entirety such that a person skilled in the art, based on such documents, would have been motivated and capable of reaching at the present invention, without any undue experimentation. In *Agriboard International LLC v. Deputy Controller of Patents and Designs, 2022 SCC OnLine Del 940*, this Court has held that while rejecting an application for lack of inventive step, discussion on prior art, the subject invention and the manner in which the invention would be obvious to a person skilled in the art is mandatory and



merely arriving at a bare conclusion would be contrary to Section 2(1)(ja) of 1970 Act. In *Biomoneta Research Pvt. Ltd. v. Controller General of Patents Designs and Another*, 2023 SCC OnLine Del 1482, this Court observed that lack of inventive step requires a person skilled in the art to be able to jump from the existing prior art to the subject invention. The order impugned herein is totally bereft of any determination of inventive step in accordance with the settled law.

12. It is argued that even on merits, the impugned order is unsustainable. Respondent has *inter alia* failed to consider the elements recited in the ‘characterised in that’ clause and consequently did not assess the novel and inventive features. The cited prior art references D1-D7 pertain to entirely different technical fields, including audio-cassette cover and fire hose enclosures and address distinct technical problems. Learned counsel has taken the Court through a comparative table evidencing absence of key features of independent Claim 1 of the subject application, which according to the Appellant are not disclosed by the cited prior art as follows:-

Prior art	What the prior art discloses	What the prior art fails to disclose
D1	- D1 only discloses a storage container with unique ribs structure for storing a cassette in such a manner that on closing the container the rotation of the tape hubs can be effectively prevented when the magnetic recording tape cartridge is enclosed in the storage container. - D1 discloses a lid (alleged base) and a body (alleged panel). The body holds a reel within an interior of the body. The body is not configured to hold the reel outside of an interior of the lid and outside of an interior cavity of the body. Indeed, if the reel extended out from the interior cavity	- “a base, and a panel pivotally coupled with the base, wherein the panel is movable relative to the base between a first closed position and a second open position, wherein the panel is configured to hold a reel at an interior surface of the panel...” - “wherein, in the second open position, the panel (110, 210) is configured to hold the reel (140, 240) outside of an interior of the base (102, 202) and outside of an interior cavity of the panel (110, 210) and to permit the reel (140, 240) to rotate relative to the panel (110, 210) and the base (102, 202)”.



	of the body, the storage container would not be able to close.	
D2	- D2 discloses a housing which can receive a tape cassette in such a manner that the rotation of reel of the cassette will not rotate when enclosed within the housing. - <u>D2 does not include a base and a panel which is pivotally coupled with the base and where the panel can be moved relatively to the base between a first closed position and second open position and panel holding a reel at an interior surface of the panel which helps in secure storage of spool.</u>	- <u>"a base, and a panel pivotally coupled with the base, wherein the panel is movable relative to the base between a first closed position and a second open position, wherein the panel is configured to hold a reel at an interior surface of the panel..."</u> - <u>"wherein, in the second open position, the panel (110, 210) is configured to hold the reel (140, 240) outside of an interior of the base (102, 202) and outside of an interior cavity of the panel (110, 210) and to permit the reel (140, 240) to rotate relative to the panel (110, 210) and the base (102, 202)"</u>
D3	- D3 discloses an optical fiber distribution terminal assembly which enables rotation of reel for paying out the fiber cable in any of the position, i.e., either closed or open. Such rotation of reel in any position may result in dislocation of reel when closed or free payout of cable from the reel. - <u>Owing to the ambiguity with respect to the rotation of the reel, the position cannot be ascertained. This can further result in dislocation of reel when closed or free payout of cable from the reel.</u>	- <u>"a base; and a panel pivotally coupled with the base, wherein the panel is movable relative to the base between a first closed position and a second open position, wherein the panel is configured to hold a reel at an interior surface of the panel, the reel being configured to have cable wound thereon, wherein, in the first closed position, the base is configured to prevent the reel from rotating relative to the panel and the base..."</u> - <u>"wherein, in the second open position, the panel (110, 210) is configured to hold the reel (140, 240) outside of an interior of the base (102, 202) and outside of an interior cavity of the panel (110, 210) and to permit the reel (140, 240) to rotate relative to the panel (110, 210) and the base (102, 202)"</u>
D4	- D4 discloses a case which effectively stores a tape cassette in such a manner that the rotation of reel is prevented when the cassette is enclosed within the case. - <u>D4 does not include a panel that is coupled with the base and where the panel is movable between a first</u>	- Owing to the case preventing the rotation of the reel as and when the cassette is closed within the case, the cited prior art fails to disclose the claimed feature of the subject application i.e., <u>"wherein, in the second open position, the panel (110, 210) is configured to hold the reel (140, 240) outside of an interior of the base (102, 202) and outside of an interior cavity of</u>



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	<u>closed position and second open position.</u>	<u>the panel (110, 210) and to permit the reel (140, 240) to rotate relative to the panel (110, 210) and the base (102, 202)".</u>
D5	- D5 pertains to fire hose and like reels, driven by the idea of providing an improved mounting for a hinged hose reel whereby to avoid the objections above referred to while <u>permitting the free withdrawal of the hose from the reel in any direction.</u>	- D5 discloses a reel which is located inside a recess provided on the wall and the brackets carrying the vertical hinge of the reel are mounted thereon so that there will be no objection while paying out the fire hose. Thereby, it can be made out that not even one feature of the claimed independent claim 1 stands disclosed by this very prior art. - D5 specifically fails to disclose the feature pertaining to " <u>second open position</u> ", let alone " <u>wherein, in the second open position, the panel (110, 210) is configured to hold the reel (140, 240) outside of an interior of the base (102, 202) and outside of an interior cavity of the panel (110, 210) and to permit the reel (140, 240) to rotate relative to the panel (110, 210) and the base (102, 202)".</u>
D6	- D6 relates generally to a storage container for storing magnetic tape and more particularly, to such a container having hinged walls and that includes a self-aligning mechanism which serves to align the front edges of the container and thus <u>assure its complete closure</u> when the side wall matingly engages the bottom wall.	- D6 merely discloses a storage container whose top and bottom components are designed in such a manner that when closing, will align with each other. D6 fails to disclose the feature as claimed in independent claim 1 of the subject application i.e., " <u>wherein, in the second open position, the panel (110, 210) is configured to hold the reel (140, 240) outside of an interior of the base (102, 202) and outside of an interior cavity of the panel (110, 210) and to permit the reel (140, 240) to rotate relative to the panel (110, 210) and the base (102, 202)".</u>
D7	- D7 relates to tape cassette cases and, specifically, relates to <u>a tape cassette latch mechanism that prevents the case from inadvertent openings.</u>	- D7 discloses such a tape cassette case which has a locking mechanism for locking the tape cassette to prevent unauthorized or unwarranted opening of the case. Therefore, D7 also fails to disclose the as claimed feature of the instant invention " <u>wherein, in the second open position, the panel (110,</u>

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		<i>210) is configured to hold the reel (140, 240) outside of an interior of the base (102, 202) and outside of an interior cavity of the panel (110, 210) and to permit the reel (140, 240) to rotate relative to the panel (110, 210) and the base (102, 202)".</i>
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13. Ms. Nidhi Raman, learned CGSC defends the impugned order and submits that the order is a well-reasoned and speaking order. Respondent has carried out a detailed technical analysis of the claims in the subject application and compared the same with the cited prior arts D1-D7. Step by step similarities have been highlighted meticulously. As an illustration, Ms. Raman has taken the Court to the analysis with D1 and points out that the Respondent has found that similarity between the given invention and D1 lies in the mechanism employed to prevent rotation of the stored material when the enclosure or container is closed. In the given invention, this is achieved through features such as raised supports and engagement structures as stated in Claim 1; *'wherein at least one raised support structure on the interior surface of the panel is configured to cooperate with a hub of the reel to prevent rotation of the hub relative to the panel in both the first and second positions of the panel.'* Similarly, in D1, the hub locking members are designed to prevent rotation of the tape hubs as stated in Claim 1: *'a pair of hub locking members disposed in either the receptacle container body or the lid member so as to lock said hubs against rotation.'* It is submitted that comparing the similarities, Respondent came to a conclusion that both inventions focused on providing stability and preventing movement of the stored material within their respective enclosures or containers. She submits



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that a similar analysis has been done between the given invention and cited arts D2-D7 and similarities have been highlighted against each one of them. Therefore, no infirmity can be found with the conclusion of the Respondent that the patent cannot be granted owing to lack of inventive step and the appeal deserves to be dismissed.

14. Heard learned counsels for the parties and examined their rival submissions.

15. Appellant challenges order dated 28.03.2024 passed by the Respondent refusing to grant patent in respect of Patent Application No. 202017011789 for invention titled 'REEL ENCLOSURES'. The amended Claim 1 is extracted in the earlier part of this judgment. The first ground raised by the Appellant is that the substantial issues raised during oral hearing as also brought forth in the written submissions have not been taken into consideration by the Respondent. Most importantly, Respondent has overlooked a crucial fact that during oral hearing on 28.02.2024, Appellant was directed to narrow down the scope of the claims to overcome the objection of lack of inventive step under Section 2(1)(ja) of 1970 Act, which the Appellant did. Record bears testimony to the fact that Appellant had amended the original claims and narrowed the scope and the amended Claims are 1-10. Impugned order reflects that Respondent was completely oblivious of the fact that claims were amended inasmuch as reliance is placed on the unamended Claims 1-20 and this error consistently and repeatedly appears in many parts of the impugned order. As an illustration, counsel for Appellant points out reliance on the deleted independent Claim 1, which is '*wherein at least one raised support structure on the*



interior surface of the panel is configured to cooperate with the hub of the reel to prevent rotation of the hub relative to the panel in both the first and second positions of the panel.' The consequence of this omission is that Respondent has overlooked the '*characterised in that*' clause of amended Claim 1 and thus the novel and inventive features. As rightly flagged, there is no finding on the admissibility of amended claim and yet they were not even considered.

16. Counsel for the Appellant is also right in his submission that Respondent has failed to follow the steps laid down by this Court in ***F. Hoffman (supra)*** for determining obviousness/lack of inventive steps, which are enumerated in the earlier part of this judgment. Step 4 mandates the Controller to identify the differences, if any, between the cited matter and alleged invention and ascertain whether the differences are ordinary application of law or involve various different steps requiring multiple, theoretical and practical applications. After the differences are identified, step 5 mandates that the Controller would decide whether the differences, viewed in the knowledge of alleged invention, constitute steps, which would have been obvious to the ordinary person skilled in the art and rule out a hideshow approach. In the instant case, the impugned order clearly reflects that the Respondent has laboured hard to identify alleged similarities between the invention and the cited prior arts but has made no effort to follow steps 4 and 5. It is also settled law that the five steps cannot be followed randomly and must be followed in the laid down sequence and for this, I may allude to the judgment of the Division Bench in ***Tapas Chatterjee (supra)***.



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17. Appellant is right in its submission that if issues are raised, they must be dealt with by the concerned authority and if this is not done, the order will be manifestly erroneous in law. [*Ref.: Qualcomm (supra)*]. There is yet another facet of this case, Appellant brought to the notice of the Respondent that corresponding applications have been granted patent in USA and Europe, however, even this fact has not been dealt with. While it is true that this fact will not have any binding effect on the Respondent, however, it may be persuasive and may point to the inventive merit, patentability, commercial interest and industrial application of the claimed invention for grant of patent in India and ought to have been at least considered.

18. Considering that the Respondent has *inter alia* not taken into consideration the amended claims and has not followed the five steps elucidated in *F. Hoffman (supra)* sequentially, this is a fit case for remand to the Respondent. Since the matter is being remanded, this Court is not delving into the merits of non-grant of the patent, which is left to be decided by the Respondent, in accordance with the law on the subject.

19. Accordingly, the impugned order dated 28.03.2024 is quashed and set aside and Patent Application No. 202017011789 in respect of 'REEL ENCLOSURES' is remanded to the Respondent for consideration and determination afresh. Consideration shall be restricted to the objections already raised and following the steps elucidated in *F. Hoffman (supra)* as also observations of the Division Bench in *Tapas Chatterjee (supra)* and taking into account the response given by the Appellant to the FER and arguments put forth, both orally and in writing. Respondent shall afford an opportunity of hearing to the Appellant before taking a decision in the



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matter and needless to state, the order will be a reasoned and speaking order. Decision will be taken by the Respondent within three months from the date of receipt of this judgment.

20. Appeal stands disposed of in the aforesaid terms.

JYOTI SINGH, J

FEBRUARY 9, 2026/YA