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

% Judgment reserved on: 06.05.2026
Judgment delivered on: 12.05.2026

+ C.A.(COMM.IPD-PAT) 483/2022

JFE STEEL CORPORATION

.....Appellant

versus

ASSISTANT CONTROLLER OF PATENTS AND DESIGNS

.....Respondent

Advocates who appeared in this case:

For the Appellant: Mr. Vineet Rohilla and Mr. Ankush Verma,
Advocates.

For the Respondent: Mr. Rohan Jaitley CGSC with Mr. Varun Pratap
Shahi and Mr. Yogya Bhatia Advocates.

CORAM:

HON'BLE MR. JUSTICE TUSHAR RAO GEDELA

J U D G M E N T

TUSHAR RAO GEDELA, J.

1. The present appeal has been filed under Section 117A(2) of the Patents Act, 1970 (hereinafter referred to as "*the Act*") assailing the order dated 14.07.2022 passed by the Assistant Controller of Patents & Designs (hereinafter referred to as "*learned Controller*") refusing the Indian patent application bearing no. 610/DELNP/2015 (hereinafter referred to as "*subject application*"), under Section 10(4)(a) read with Section 10(4)(c) of the Act.

2. The subject application was filed on 23.01.2015 as a National Phase Application out of PCT International Application No. PCT/JP2013/070186 filed on 25.07.2013. This PCT International application claims priority from

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JP Patent Application no. 2012-165519 dated 26.07.2012.

3. The Patent Office issued the First Examination Report (hereinafter referred to as “*FER*”) on 13.05.2019, wherein the respondent raised objections on the grounds of lack of inventive step, lack of sufficiency of disclosure, clarity and conciseness, definitiveness and other requirements. On 08.11.2019, the appellant filed a reply alongwith the amended claims to address the objections raised in the FER.

4. The hearing notice was issued on 01.02.2022 scheduling the hearing for 16.02.2022. Thereafter, the Patent Office issued the second hearing notice on 09.03.2022 scheduling the hearing to 11.03.2022, which was attended by the appellant.

5. The appellant had filed the post hearing written submissions on 26.04.2022 alongwith amended claims.

6. During the arguments before this Court, learned counsel for the appellant submitted that the learned Controller has rejected the subject application solely on the ground of Section 10(4)(a) read with Section 10(4)(c) of the Act without examining the responses to the objections of lack of novelty, lack of inventive step, and non-patentability under Section 3(d) of the Act.

7. It is important to note that the hearing notice raises the objections on the grounds of lack of clarity and conciseness under Section 10(4) of the Act and lack of novelty under Section 2(1)(j) of the Act alongwith formal requirements. Further, it is pertinent to note that the said hearing notice also raises objections on the grounds of lack of inventive step and non-patentability under Section 3(d) of the Act. For clarity, the relevant para of the said hearing notice is reproduced hereunder:



“Invention u/s 2(1)(j)

1. I have carefully considered the submission of the applicant. The subject matter in claims 1, 2 wherein the composition of electrical steel is claimed is not a method claim as such. The same is not allowable.

2. “optionally hot band annealing the steel sheet” in claim 1 cannot be allowed as the same restricts the scope of the claim in a way that the annealing step is optional.

3. The complete specification and the particular disclosures in table 1 were referred to. It was observed that no example of the heating rate at the rate of 10 degrees Celcius per second is endorsed.

Also, I can observe the heating rate of 50, 100, 200 degrees Celcius per second. These heating rates are, however, disclosing a temperature range other than what is claimed in claim 1. Without prejudice, I also observe that mere disclosure of heating at a discrete rate can't entitle an applicant to claim the range of the heating rate especially when the difference is like 50 degrees Celcius per second. The basic knowledge of the heat treatment states how the rate of heating and cooling and going to affects the grain size, physical, mechanical properties, and morphology of the material. No sufficient data or disclosures are at all provided in the specification to understand the same. Further, the range of the time period of heating is not endorsed in the complete specification.

Subject matter in claim 1 is therefore not allowable.

4. The submission in respect of the inventive step is not persuasive. It is to be noted that the difference in the composition of the steel sheet can't render a process novel or inventive. Further, mere use of the known process which doesn't result in a new product attracts the provision under section 3(d) of the Patents act, 1970.

It is noted that the heating rate at 10 degrees per second and holding for 1-7 seconds are not supported by the experiment. Also, the presentation of data in table 1 is confusing. I am unable to understand the actual heating rate. Also, the iron loss comparison is not significant.

It is observed that the applicant has contended that different heating rates in different temperature ranges are not disclosed in D1 and D2. The applicant is required to clarify the microstructural changes while the primary recrystallization and rapid heating are performed at the stated heating rate in the stated temperature range. The surprising effects of the said process are not clear. In absence of the same, it is difficult to understand any surprising effect.



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Also, since the compositions of the steel sheets in the prior art and the instant application are different, the recrystallization temperature and the critical temperature up to which it can be heated to avoid any phase change would change. It is observed that the difference in the prior art and the contended application for patent, of the temperature range and the holding time are minimal and otherwise, D1 and D2 both are performing recrystallization annealing.

Also, any of the annealing processes can't be considered complete where the cooling or cooling rate is not mentioned under section 10(4) of the Patents Act, 1970.

5. The applicant can guide the controller to the submitted proof of right, if available online, or a copy of the proof of right along with the corresponding letter may be provided.

6. Regarding form- 13 dated 18/02/2015, the applicant may kindly explain how the amendment in paragraphs 8 (change in the plane), 18 (where annealing is replaced with heating) are not changing the scope.

7. The English translation of the priority document has not been filed within 31 months from the date of the earliest priority under rule 20(4) (i)."

[emphasis supplied]

8. On the contrary, the impugned order rejects the subject application only under Section 10(4)(a) read with Section 10(4)(c) of the Act. Further, the said order also notes that a decision on the objection on the grounds of novelty and inventive step is not required to be taken or cannot be taken. For clarity, the relevant part of the impugned order is reproduced hereunder:

vi. In view of my observations in preceding paragraphs iv, and v, I am of the opinion that the experimental data in paragraphs 15, 17 and 36 and in table 2 are to be relied upon for the purpose of understanding the scope of the claims under section 10(4).

These paragraphs in combination of other parts of the complete specification fails to experimentally endorse the end compositions (of a domain) of the alloying elements C, Si, Mn. Also, the claimed range of the composition of Al, S, Se, O, N (which is otherwise not specific) as the disclosures in respect of presence of these alloying elements are vague or discrete i.e. either the



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disclosure is for one composition only and in few cases the disclosure is not specific.

Further, the complete specification endorse experimentally the presence of the elements: Cu, Ni, Cr, Sb, Sn, Mo, Bi, Ti, P, Nb for a single composition only.

Accordingly, I am of the clear view that as far as the compositional domain of the alloying elements are sought for protection are not in accordance with the provision of section 10(4) (a) of the Patents Act, 1970. The subject matter in claim

Regarding the process parts

vii. Regarding the heating rate of the steel sheet at not more than 10° C/s, the applicant has pointed to example 7 of table 1. Further, the applicant has stated in the submission as below:

“Regarding example of heating rate at the rate of 10°C/s, example 7 of Table 1 clearly indicates the heating rate of 10°C/s. □ Regarding examples of heating rates of 50°C/s, 100°C/s and 200°C/s, it is described in paragraph [0036] of the specification that “In the primary recrystallization annealing, the heating is performed by two kinds of patterns as shown in Table 1, i.e. a pattern of continuously heating from room temperature (RT) to 700°C at a constant heating rate of 20~300°C/s (No. 1, 2, 9, 11, 13) and a pattern of heating a zone of T1~T2 on the way of the above heating between the above temperatures at a given heating rate for a given time (No. 3~8, 10, 12).”

Based on the above submission, I am of the understanding that in example 7 the room temperature to 700°C, the heating rate was to be at 50°C/s and, for a temperature range of 530-550°C the heating rate would be 10°C/s for 2 seconds. This doesn't go in line with the portion of claim 1 reiterated as below:

“the primary recrystallization annealing by heating a heating rate of not more than 10°C/s for a period of 1-7 seconds within a temperature zone of 250-550°C”

Apparently, the temperature range doesn't fall between 250-550. Without prejudice, in any other example where the two kinds of heating pattern is used for a heating rate of <10°C/s (either heating stopped or heating rate has changed, in examples 3-8 10, 12), the lower range of 250°C is not satisfied. Also, time for 1 second where the heating rate has changed is not satisfied. The said states: time and temperature are vital as the holding of 2-7 seconds at the given temperature range is claimed to have a technical effect



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on the electrical property.

Similarly, a heating rate of 40°C/s is not endorsed by way of the technical examples in table 1 or 2 in the range of 550°C-700°C.

In view of the above, I am of the opinion that the subject matter in claim 1 in respect of the process step is not within the scope of the technical disclosures in the complete specification under sections 10(4)(c) read with 10(4)(a) of the Act.

viii. The applicant has further referred to example 1 of paragraph 63 for disclosure relating to endorse the heating rate of 10 degrees per second and holding for 1-7 seconds. I have noted that the specification ends in 46 paragraphs, so the applicant is probably pointing towards paragraph 36. Paragraph 36 however in respect of process steps is merely pointing to table 1 for which I have given explicit opinion in the previous paragraph.

ix. For, the claims being not filed in accordance with the provisions under section 10(4) (a) read with (c) of the Act, I am of the opinion that a decision on novelty / inventive step is not required to be taken or can't be taken.

****”

[emphasis supplied]

9. In ***C.A.(COMM.IPD-PAT) 167/2022*** titled “*Adama Makhteshim Ltd. vs The Controller of Patents*” decided on 01.05.2023, all the objections raised in the hearing notice were not addressed by the Controller in the order in question. In those circumstances, this Court emphasised that, while exercising appellate jurisdiction, it cannot examine matter further as no reasoning is provided on the other grounds of objections. The relevant paras are reproduced as follows:

“10. Before parting, the Court would like to address an issue that has been observed in several other appeals arising from the refusal of patent applications. It is well-known that patent applications have a limited term, a substantial portion of which is spent in the office of the Controller of Patents and Designs. In the instant case, the application for the subject invention was filed in 2016, and nearly half of the life of the patent has already elapsed. Although the Hearing Notice raised objections under several sections of the Act, the application has been rejected only on one ground, without addressing the other objections. Therefore, while exercising appellate jurisdiction at this stage, the Court cannot delve further into the matter as



no reasoning is discernible on the other grounds of objections, and the matter must be remanded back for fresh consideration.

11. Thus, it must be observed that since the orders of the Controller under Section 15 of the Act are subject to judicial review in appeal, it would be advisable for the Controller to examine all grounds of objection while deciding an application, even if the application is found to be non-patentable on any one of the preliminary or technical grounds. This approach would expedite the process of granting patents by allowing the Courts to assess the patentability of inventions if the technical objection is overruled. Only if the merits of the claims and issues relating thereto are interlinked with technical grounds, this approach may not be feasible, and an observation should be recorded to that effect. However, in situations where the grounds of refusal mentioned in the Hearing Notice are independent and can be examined as such, a comprehensive order should be passed addressing all of the objections.

12. With the above observations, the present appeal is disposed of.”

[emphasis supplied]

10. Additionally, this Court in **C.A.(COMM.IPD-PAT) 16/2024** titled “Medilabo RFP Inc vs The Controller of Patents” decided on 24.11.2025, further reaffirmed this position in the following language:

“55. It is important to note that the hearing notice had other objections under Sections 2(1)(ja), 59 and 3(d) of the Act. These objections are not addressed in the Impugned Order. In Adama Makhteshim Ltd v. The Controller of Patents & Designs, C.A. (Comm IPD-PAT) 167/2022, it is held that the Controller should examine all grounds of objection while deciding an application, even if the application is found to be nonpatentable on any one of the preliminary or technical grounds.

56. Accordingly, the Impugned Order dated 21.12.2023 is set aside and the Subject Application is remanded back to the Respondent for fresh consideration including the amended Claims.”

[emphasis supplied]

11. It needs to be underscored that a patent application has to be considered as a whole. While objections may be raised and sustained till the stage of Hearing Notice, the final decision of the learned Controller if



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rendered only on one or more objections, rather than all of them together, it would lead to injustice and unfairness. This is for the reason that a patent has a shelf life of only 20 years from the priority date and if the final adjudication is not based on consideration of all objections and their responses, the patent applicant will be compelled to approach this Court for every objection not considered and remanded by this Court for fresh consideration. Possibly, the entire patent term may get consumed in this process, which is clearly avoidable.

12. As an example, even in Civil Courts, when the issues are framed, it is incumbent upon the Court to decide all issues as far as possible, so that the Appellate Court has a reasoned decision on every issue for its consideration. Similarly, the Controller also ordinarily ought to give decision on all the objections raised and responded to by the Patent Applicant.

13. Unlike the provision of Order XLI of Code of Civil Procedure, 1908, there is no provision or jurisdiction with the Appellate Court in the context of the Patents Act, 1970 for it to remand the matter back to Controller for issues not determined, separately, or where the Appellate Court can direct additional evidence to be recorded so as to receive a decision containing reasons with evidence on issues not so determined. Thus, even for these reasons, the impugned order seems to be unsustainable.

14. It is crucial to bear in mind and it bears repetition, that the patent applications have a limited shelf life. It is also known and accepted that the patent applications involve a time-consuming process and sometimes take years at stretch to reach the stage of final hearing before the Controller. In such circumstances, it would not be fair to the patent applicants to be remanded back to the Controller for *de novo* consideration on objections raised, however not dealt with by the Controller.



15. Another relevant aspect to consider is that even if this Court comes to a conclusion that objections under Section 10(4)(a) and Section 10(4)(c) are unsustainable, yet due to lack of examination and consideration of objections under Section 2(1)(j) of the Act and Section 2 (1)(ja) of the Act by the learned Controller, this Court cannot place itself in the position of the Controller nor can it arrogate to itself the power to consider such objections without a proper determination on those objections at the stage of the Controller's consideration. This Court, as an Appellate Court, is not a "person skilled in the art" (PSITA) to arrive at a decision as if it has donned the role of the Controller.

16. In the present case, the learned Controller under the impugned order, rejected the subject application solely based on the objection under Section 10(4) of the Act, while the hearing notice includes the additional objections of lack of novelty under Section 2(1)(j) of the Act, lack of inventive step and non-patentability under Section 3(d) of the Act.

17. As discussed above, the learned Controller himself notes that the other objections raised in the hearing notice were not required to be considered in the light of objections having been considered under Section 10(4)(a) and Section 10(4)(c) of the Act, having been considered. This may not be appropriate.

18. Therefore, based on the above discussion, this Court is of the view that the matter must be remanded back for fresh consideration.

19. Accordingly, the impugned order dated 14.07.2022 passed by the learned Controller is set aside, and the matter is remanded back for fresh consideration.

20. The learned Controller shall decide the matter on merits in accordance with law, uninfluenced by any observations in this decision. The learned



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Controller shall reconsider the matter within a period of six months from the date of this decision.

21. The learned Controller shall afford a fresh opportunity of hearing to the appellant before deciding the subject application.

22. A copy of the Order also be brought to the notice of the learned Controller General of Patents and Designs for necessary administrative action.

23. The appeal is disposed of in the aforesaid terms.

**TUSHAR RAO GEDELA
(JUDGE)**

MAY 12, 2026

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