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

+ **C.A.(COMM.IPD-PAT) 72/2024**

MITSUBISHI MATERIALS CORPORATIONAppellant

Through: Ms. Vindhya S. Mani 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

ORDER
30.03.2026

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1. This appeal is filed on behalf of the Appellant under Section 117A of the Patents Act, 1970 ('1970 Act') for setting aside the impugned order dated 29.05.2024 passed by the Respondent refusing grant of patent in respect of Indian Patent Application No. 10548/DELNP/2015 for invention titled "*Copper Alloy Wire*".

2. Indisputably, Appellant filed a PCT Application No. PCT/JP2014/063564 on 22.05.2014 with claims 1-5 originally, claiming benefit of priority from Japan Application No. 2013-110079 filed on 24.05.2013 and 2014-068368 filed on 28.03.2014. On 17.11.2015, Appellant filed the present application with originally 1-5 claims and after the Appellant filed Request for Examination on 27.12.2016, the application was published in the Patent Journal on 19.02.2016. First Examination Report



(FER) was issued on 14.01.2020 to which Appellant filed a response on 06.07.2020 with amended claims 1-3 along with petition under Rule 137 of Patent Rules, 2003 to condone the delay in filing verified Indian translation of PCT application. After the hearing concluded on 12.10.2023, post-hearing written submissions were filed by the Appellant with amended claims 1-3 and by impugned order dated 29.05.2024, Respondent rejected the application and refused the grant of patent under Section 2(1)(ja) for lack of inventive step and in respect of claim 3 for non-sufficiency of disclosure.

3. Learned counsel for the Appellant submits that the impugned order has been challenged on multiple grounds raised in the appeal, however, without entering into the merits, the most glaring illegality in the order is that Respondent has failed to apply the five step tests laid down by the Division Bench of this Court in ***F. Hoffmann-La Roche Ltd. & Anr. v. Cipla Ltd., 2015 SCC OnLine Del 13619*** and erroneously held that the application lacks inventive step and this becomes significant since the patent has been granted on corresponding applications with similar claims in other jurisdictions such as Japan, USA, China and Europe, which may not be binding on the Respondent but certainly evidences and demonstrates the inventive merit and patentability that the claimed invention posits. Most importantly, Respondent has not even identified the person skilled in the art which is the first step required to be followed, as laid down in the aforesaid judgment.

4. Appearing on behalf of the Respondent, Ms. Nidhi Raman, learned CGSC submits that the grant of patent has been correctly refused by the Respondent and seeks to place reliance on the impugned order, the prior arts as also written submission to buttress her pleas.



5. Having perused the impugned order, I am of the view that there is merit in the contention of the Appellant that Respondent has failed to identify the person skilled in the art, which is the first step in the five step tests laid down by the Division Bench in ***F. Hoffman (supra)***. In ***Tapas Chatterjee v. Assistant Controller of Patents and Designs and Another, 2025 SCC OnLine Del 6369***, another Division Bench of this Court has reaffirmed that the five step test must be followed mandatorily and sequentially. It needs no reiteration that if the Respondent has not identified the person skilled in the art, the other four steps which are a sequel have not been correctly followed. Ms. Raman is unable to dispute this fact.

6. Accordingly, without entering into the merits of the case and on the sole ground that Respondent has not followed the five step test laid down in ***F. Hoffman (supra)***, this appeal is allowed quashing impugned order dated 29.05.2024 and remanding the matter for fresh consideration of patent application no. 10548/DELNP/2015 in respect of invention titled “*Copper Alloy Wire*”. Needless to state that the consideration will be after following the law laid down by the Division Benches in the aforementioned judgments as also looking into the merits in the said backdrop and after giving opportunity of hearing to the Appellant.

7. The order shall be passed by the Respondent within three months from today. It is made clear that this Court has not expressed any opinion on the merits of this case. It be also noted that the Appellant will not be permitted to file any additional document and the application will be decided on the basis of documents/reply/written submissions already on record before the Controller.



8. Appeal stands disposed of.

MARCH 30, 2026/VP

JYOTI SINGH, J