

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

% *Date of decision: 28th April, 2023*

+ **C.A.(COMM.IPD-PAT) 189/2022**

GRUPO PETROTEMEX S.A. DE C.V. Appellant
Through: Mr.Rohit Rangi, Mr.Vineet Rohilla,
Mr.Ankush Verma and Mr.Debashish
Banerjee, Advocates.

versus

CONTROLLER OF PATENTS Respondent
Through: Ms.Arunima Dwivedi, CGSC with
Ms.Pinky Pawar and Mr.Aakash
Pathak, Advocates for UOI.

**CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL**

JUDGMENT

AMIT BANSAL, J. (Oral)

C.A.(COMM.IPD-PAT) 189/2022

1. The present appeal has been filed impugning the order dated 7th June 2016, whereby the application, being Patent Application No.965/DELNP/2006, filed on behalf of the appellant was rejected by the Patent Office.
2. The patent application was filed before the Indian Patent Office on 24th February, 2006 as a national phase application under the Patent Corporation Treaty (PCT), claiming priority from the corresponding US Application bearing number US10/666415, filed on 19th September, 2003.

3. The Patent Office examined the subject application and issued a First Examination Report (FER) on 6th August, 2009, wherein the primary objection taken by the patent office pertained to lack of novelty. In view of the prior art document US 4436782 [hereinafter “D1”] cited in the FER, the appellant filed detailed response on 14th April, 2010.

4. In the hearing notice dated 5th February, 2016, the following objections were taken:

<i>Serial Number</i>	<i>Objections</i>
1.	<i>Subject matter as described lacks novelty view of the following prior art document US 4436783. Therefore, the claims do not constitute an invention under section 2[1 (j)] of Patents Act 1970.</i>
2.	<i>Power of authority for this specific application should be filed.”</i>

5. The hearing in the matter was held on 7th June, 2016. In the hearing, appellant made oral submissions with regard to the objection of lack of novelty and inventiveness as raised in the hearing notice.

6. On the very same day, the impugned order was passed rejecting the subject application on the ground that the application lacks inventive step with regard to prior art D1.

7. Counsel for the appellants submits that the objection raised by the respondent in the hearing notice only pertain to lack of novelty in the subject invention and not inventive step and therefore, the Assistant Comptroller should not have refused the claims 1 to 16 on the ground that the subject matter was lacking inventive step. It is further submitted that the impugned order was passed without giving an opportunity to the appellant to file

written submission in terms of the Rule 28(7) of the Patent Rules, 2003.

8. Despite opportunities having been granted, no reply filed on behalf of the respondent.

9. I have heard the counsel for the parties.

10. A perusal of the hearing notice would show that the only objection taken therein was with regard to novelty. However, the impugned order proceeds beyond the objection of lack of novelty and refused grant of patent under Section 2(1)(ja) of the Patent Act, which provides for lack of inventive step. In fact, on the aspect of inventive step, the impugned order specifically records that claims 1 to 16 are novel. The relevant extract of the impugned order recording the same is extracted as under:

*“It is observed that having taught by the document US 4436782 a method of preparation of ethylene terephthalate oligomer pellets where pelletizing head temperature is controlled by to provide an oligomer melt viscosity of less than 3 poises , and molten droplets fall through inert gas and are quenched/solidified into oligomer pellets in quenching tank water; this shall be obvious to a person skilled in the art to arrive at the claimed process for minimizing energy consumption during the production of polyethylene terephthalate where amorphous pellets are crystallized at elevated temperature and subsequently introduced into a solid state polymerization reactor, characterized in that removing heat from hot pellets from the solid state polymerization reactor, transferring heat removed to heat cool pellets which constitute a feed to a crystallizer and so lacks inventive step. **Although, it is agreed that claims 1-16 are novel.***

Therefore, claims 1-16 of this instant application are refused patent u/s 15 for non compliance of the requirement u/s 2(1)(ja) of the Patent Act 1970.”

11. In view of the above, the appeal is allowed and the impugned order dated 7th June 2016 rejecting the patent application of the appellant is set

aside.

12. The matter is accordingly remanded back to the Patent Office for fresh consideration. The fresh consideration would take into account the material already on record and more particularly, the submissions filed on behalf of the appellant with regard to the prior art document D1. The Patent Office is permitted to give a fresh hearing to the appellant, in case the same is required.

13. The Officer shall pass a reasoned order and decide the application taking into account all the relevant considerations within four months from today.

14. The Registry is directed to supply a copy of the present order to the Office of the CGPDTM on the e-mail ID- llc-ipo@gov.in for compliance.

APRIL 28, 2023

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AMIT BANSAL, J

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