2023:DHC:4030

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

Judgment Reserved on : 3rd May, 2023.
Judgment Delivered on : 2nd June, 2023.

\+ **C.A.(COMM.IPD-PAT) 477/2022**

AGFA NV & ANR. ..... Appellants
Through: Mr. Essenese Obhan, Ms. Aparna Kareer and Ms.Ayesha Guhathakurta, Advocates.

versus

THE ASSISTANT CONTROLLER OF PATENTS AND DESIGNS & ANR. ..... Respondents
Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr.Alexander Mathai Paikaday, Advocates.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

JUDGMENT

AMIT BANSAL, J.

1. The present appeal under Section 117A of the Patents Act, 1970 (hereinafter 'the Act') has been preferred against the order dated 17th June, 2022 (hereinafter 'impugned order') of the Assistant Controller of Patents and Designs, Indian Patent Office, Delhi (hereinafter 'Controller') refusing the grant of patent in respect of patent application no.201617023479 (hereinafter 'subject patent') filed by the appellants.

BRIEF FACTS

2. Brief facts necessary for deciding the present appeal are set out below:

2.1 The appellants filed the national phase application no. 201617023479 in respect of the PCT Application no.PCT/EP/2015/052030 at the Indian Patent Office titled 'MANUFACTURING OF DECORATIVE LAMINATES BY INKJET' on 8th July, 2016.

2.2 The Patent Office issued a First Examination Report (FER) dated 27th April, 2019 in terms of which, objections under Sections, 2(1)(j), 2(1)(ja) as well as Sections 10(4) and 10(5) of the Act were raised.

2.3 A detailed response along with an amended set of claims was filed on behalf of the appellants to the aforesaid FER on 11th July, 2019.

2.4 On 6th March, 2022, the respondents issued a hearing notice fixing the date of hearing for 21st March, 2022, retaining the objections as mentioned in the FER.

2.5 The appellants filed written submissions dealing with the issues that were discussed during the oral hearing held on 21st March, 2022 along with an amended set of claims on 1st April, 2022.

2.6 The impugned order was passed by the Patent Office on 17th June, 2022 rejecting the subject application.

3. Notice in the appeal was issued on 22nd September, 2022. Pursuant thereto, written submissions have been filed on behalf of the respondents as well as the appellants.

4. The main grounds for refusal were the following:

(i) The amended claims failed to meet the requirements under Sections 10(4)(c) and 10(5) of the Act as they were vague and the scope of claims was indefinite

(ii) The amended claims are not patentable in terms of Section 2(1)(ja) of the Act.

Submissions

5. While assailing the impugned order, counsel for the appellants made the following submissions:

(i) The impugned order records that steps 1 to 4 have been disclosed in the prior art cited as D5. However, it does not make any mention of step 5.

(ii) The impugned order wrongly notes that the characterised feature 5b is disclosed in D5. The prior art cited as D5 teaches "application weight or wet weight" and not "total dry weight" as required by claim 1.

(iii) The impugned order admits that feature 5a is not taught by prior art document D5, but relies on 'common general knowledge' to refuse claim 1. However, it does not provide any reference or basis to establish 'common general knowledge'. In this regard, reliance is placed on the judgment of ***Generics (UK) Ltd.*** v. ***Daiichi Pharmaceuticals Co.Ltd.***, [2009] R.P.C. 4.

(iv) Document D5 was also cited in opposition proceedings against the appellants before the European Patent Office. However, the European Patent was granted in favour of the appellants. The claims granted by the European Patent Office are similar to the claims refused by the impugned order.

(v) The impugned order wrongly states that the terms of the claims are vague and indefinite. The terms of the patent claims held to have been indefinite, have been described in the complete specification and are widely used in the patent specifications and would be clear and definite to a person skilled in art.

6. *Per contra,* counsel for the respondents while defending the impugned order made the following submissions:

(i) Method steps 1 to 4 as well as characterised feature 5b are explicitly disclosed in document D5. In this regard, reliance is placed on paragraph 33 of the document D5 (page 248 of the appellants' documents) which states that, "***The application weight of the ink-receiving layer can be 2 to 25 g/m^2, in particular 3 to 20 g/m^2, but preferably 4 to 15 g/m^2.***"

(ii) In respect of feature 5a, it is related to workshop modification optimization and hence, does not involve any ingenuity. Therefore, it is obvious to the person skilled in art to use the common general knowledge along with teachings of D5 and arrive at characterised feature 5a as claimed in claim 1.

(iii) Counsel for the respondents fairly submits that no instructions have been received as to why method step 5 has not been considered in the impugned order. Further, no submissions have been made with regard to the terms used in the claim being indefinite or vague.

7. I have heard the counsels for the parties and perused the record.

<u>Analysis and Findings</u>

8. The first objection is lack of inventive step under Section 2(1)(ja) of the Act and the second objection is on lack of clarity and succinctness under

Section 10(4)(c) and Section 10(5) of the Act. I shall first deal with the second ground first.

9. In the impugned order, the Controller has held that the subject patent application is violating Section 10(4)(c) and Section (10)(5) of the Act. The reasoning for the same is that the claims of the subject patent application are not clear and succinct and the scope for protection of the invention has not been clearly defined. The relevant extract of the impugned order where the said finding has been recorded is reproduced as under:

> *"The **features claimed in the claim with expressions "thermosetting resin, an ink acceptance layer, inorganic pigment, polymeric binder" are neither definite nor succinct**. There are varieties of material/polymers/chemicals available in the market which comes under the category of thermosetting resin, ink acceptance layer, inorganic pigment and polymeric binder. **Applicant failed to pinpoint the particular material in the claims**. These **terms are vague and do not have any definite boundary, this makes scope of claims indefinite.**"*

10. In effect, the Controller has held that some expressions/terms, which have been used in the subject patent application as vague and not having a definitive boundary. The said expression/terms objected to by the Controller are as follows:

i. 'thermosetting resin'
ii. 'ink acceptance layer'
iii. 'inorganic pigment'
iv. 'polymeric binder'

11. I shall now examine if there is any specific definition and clarity on these expressions in the complete specification of the subject patent application.

Objection on Lack of Clarity

12. The expression/term 'thermosetting resin' has been used in the Independent Claim 1 and is also the focus of a specific dependent Claim i.e., Claim 3. The first Independent Claim also contains the other three expressions/terms as well. For the sake of clarity, the said Independent Claim is extracted as under:

> *"1. A method for manufacturing decorative laminates including the steps of:*
>
> *a) impregnating (18) a paper substrate with a* ***thermosetting resin*** *by submersion of the paper substrate in a bath of thermosetting resin;*
>
> *b) applying on the* ***thermosetting resin*** *impregnated paper substrate an* ***ink acceptance layer*** *containing an* ***inorganic pigment*** *P and a* ***polymeric binder*** *B having a weight ratio P/B of* ***inorganic pigment*** *to* ***polymeric binder*** *in the range of 1.5-4;*
>
> *c) jetting on the* ***ink acceptance layer*** *a colour pattern with one or more aqueous pigmented inkjet inks and/or organic solvent based pigmented inkjet inks containing a colour pigment C; and*
>
> *d) heat pressing the thermosetting paper into a decorative laminate, wherein the weight ratio P/C of the* ***inorganic pigment*** *of the* ***ink acceptance layer*** *to the jetted colour pigment in the colour pattern is in the range of 4.5- 9,*
>
> *characterized in that the dry weight of colour pigments jetted by the one or more aqueous pigmented*

inkjet inks and/or organic solvent based pigmented inkjet inks is in the range of 0.3-0.75 g/m^2; and

*wherein the **ink acceptance layer** has a total dry weight between 3 g/m^2 and 6 g/m^2"*

13. The relevant Claim, which is dependent Claim 3, describing the '**thermosetting resin**' is extracted as under:

*"3. The method as claimed in claim 1, wherein the **thermosetting resin** is selected **from the group consisting** of melamine-formaldehyde based resins, ureumformaldehyde based resins and phenol-formaldehyde based resins."*

14. Additionally, the description in the complete specification not only refers to the group of '**thermosetting resins**' but also gives a 'most preferable embodiment' of the group. The relevant extracts referring to the same are extracted as under:

*"The thermosetting resin is preferably selected from the group consisting of melamine-formaldehyde based resins, ureum-formaldehyde based resins and phenol-formaldehyde based resins. Other suitable resins for impregnating the paper are listed in [0028] of EP 2274485 A (HUELSTA). **Most preferably the thermosetting resin is a melamine-formaldehyde based resin, often simply referred to in the art as a 'melamine (based) resin'**.*

The melamine formaldehyde resin preferably has a formaldehyde to melamine ratio of 1.4 to 2. Such melamine based resin is a resin that polycondensates while exposed to heat in a pressing operation. The polycondensation reaction creates water as a by-product. It is particularly with these kinds of thermosetting resins, namely those creating water as a by-product, that the present invention is of interest. …"

15. With respect to the '**ink acceptance layer**', it has to be noted that, in the laminate manufacturing industry, the said layer is given different references, which include 'ink receiving layer' and 'ink coating layer.' In the subject patent application, the 'ink acceptance layer' has been given a definitive dry weight between 3 g/m^2 and 6 g/m^2 in the Independent Claim 1. Further, the said layer is also the given specific limitations in Independent Claim 11, where a characteristic feature of the said layer is that the layer does not include any 'thermosetting resin'. The said Claim 11 is extracted as under:

> *"11. An inkjet printed thermosetting resin impregnated paper including a colour pattern in an ink acceptance layer containing an inorganic pigment and a polymeric binder having a weight ratio P/B of inorganic pigment P to polymeric binder B of larger than 1.5, wherein the weight ratio P/C of the inorganic pigment P of the ink acceptance layer to the jetted colour pigment C in the colour pattern is larger than 4.0; and **wherein the ink acceptance layer is free of thermosetting resin**."*

16. Further, a specific embodiment for preparation of the '**ink acceptance layer**' has also been described in the subject patent application. The said extract from the description in the complete specification is extracted as under:

> *"**Preparation of Ink Acceptance Layers***
> *An 80 g/m2 porous paper used for decor printing was impregnated with an aqueous solution containing 60 wt% of melamine-formaldehyde based resin having a formaldehyde to melamine ratio of 1.7, and dried to a residual humidity of about 8 g/m2.*
>
> *An ink acceptance layer was coated on the impregnated paper in accordance with Table 7 by*

means of a bar coater, providing a wet layer thickness of 20 µm or 40 µm micron. The coated samples were dried in an oven for 1 minute at 125°C."

17. Similarly, two of the other specific expressions/terms i.e., '**inorganic pigment**' and '**polymeric binder**' have been described in other dependent Claims. The relevant dependant Claims are extracted as under:

*"4. The method as claimed in claim 1, wherein the **inorganic pigment** is selected from the group consisting of alumina hydrates, aluminum oxides, aluminum hydroxides, aluminum silicates, and silicas.*

*5. The method as claimed in claim 1, wherein the **polymeric binder** is a water soluble polymeric binder including a hydroxyl group as a hydrophilic structural unit and having a water solubility of at least 1 g/L water."*

18. The relevant extract from the description of the complete specification giving details of the '**inorganic pigment**' is extracted as under:

"The inorganic pigment is preferably selected from the group consisting of alumina hydrates, aluminum oxides, aluminum hydroxides, aluminum silicates, and silicas.

***Particularly preferred inorganic pigments are silica particles, colloidal silica, alumina particles and pseudo-boehmite, as they form better porous structures**. When used herein, the particles may be primary particles directly used as they are, or they may form secondary particles. Preferably, the particles have an average primary particle diameter of 2 µm or less, and more preferably 200 nm or less."*

19. Similarly, the relevant extract of the description highlighting the details and preferred embodiments of the '**polymeric binder**' is reproduced as under:

> *"In a preferred embodiment, the ink acceptance layer includes a polymeric binder selected from the group consisting of hydroxyethyl cellulose; hydroxypropyl cellulose; hydroxyethylmethyl cellulose; hydroxypropyl methyl cellulose; hydroxybutylmethyl cellulose; methyl cellulose; sodium carboxymethyl cellulose; sodium carboxymethylhydroxethyl cellulose; water soluble ethylhydroxyethyl cellulose; cellulose sulfate; polyvinyl alcohol; vinylalcohol copolymers; polyvinyl acetate; polyvinyl acetal; polyvinyl pyrrolidone; polyacrylamide; acrylamide/acrylic acid copolymer; polystyrene, styrene copolymers; acrylic or methacrylic polymers; styrene/acrylic copolymers; ethylene-vinylacetate copolymer; vinyl-methyl ether/maleic acid copolymer; poly(2-acrylamido-2-methyl propane sulfonic acid); poly(diethylene triamine-co-adipic acid); polyvinyl pyridine; polyvinyl imidazole; polyethylene imine epichlorohydrin modified; polyethylene imine ethoxylated; ether bond-containing polymers such as polyethylene oxide (PEO), polypropylene oxide (PPO), polyethylene glycol (PEG) and polyvinyl ether (PVE); polyurethane; melamine resins; gelatin; carrageenan; dextran; gum arabic; casein; pectin; albumin; chitins; chitosans; starch; collagen derivatives; collodion and agar-agar.*
>
> ***In a particularly preferred embodiment, the ink acceptance layer includes a polymeric binder, preferably a water soluble polymeric binder (> 1 g/L water), which has a hydroxyl group as a hydrophilic structural unit, e.g. a polyvinyl alcohol.****"*

20. The terms of the patent claims ('**thermosetting resin**', '**an ink acceptance layer**', '**inorganic pigment**', '**polymeric binder**') that have been held to be vague, have been sufficiently described in the description of the complete specification. Further, even preferred embodiments for the said terms or expressions are given. Therefore, it is clear that the aforesaid expressions/terms have been adequately explained. It is also observed that the impugned order fails to take into account that the patents specification is addressed to a person skilled in the art to whom the aforesaid terms of Claims would be quite clear in any case.

21. Therefore, I do not find merit in the objection on lack of clarity or that the Claims are indefinite.

Objection on Lack of Succinctness

22. Next, I shall deal with the specific observation of the Controller that the Claims are not succinct. There is no specific reasoning given for the lack of succinctness in the Claims. I observe that even the Manual of Patent Office Practice and Procedure, dated 26th November, 2019, issued by the Office of the Controller General of Patents, Designs and Trademarks does not give any guidance on what constitutes succinctness or how to identify lack of succinctness. The references to the requirements for succinctness in the said Manual are set out below:

> *"**Unity of invention and Clarity of claims***
>
> *xxxx xxxx xxxx*
>
> *b) Claims shall be clear and **succinct** and fairly based on the matter disclosed in the specification.*
>
> ***Structure of Claims***
>
> *xxxx xxxx xxxx*

*d) Each claim should be clear and **succinct.**"*

23. In the absence of definite guidance for ascertaining succinctness, in the said Manual, reference is made to the Patent Manual of Practice and Procedure issued by the IP Office of Australia, which gives guidance on when Claims can lack succinctness. In the Australian Manual, it is stated that under the following two conditions, lack of succinctness arises:

- *an individual claim is considered unnecessarily lengthy; or*
- *the statement of claims as a whole is considered unnecessarily lengthy due to the repetitious nature of the claims.*

24. In the present case, the first Claim is lengthy but by no means unnecessarily lengthy as it is defining specific features and expressions that are interlinked to each other. Considering that it is the right of the patentee to draft Claims so as to protect all the aspects and features of the invention sought to be protected, the present set of Claims, in my opinion, cannot be said to lack succinctness.

25. In this regard, the Australian Manual also makes a reference to the Australian judicial precedent on the meaning or scope of the term 'succinct' in ***Doric Products Pty Ltd v Lockwood Security Products Pty Ltd***, [2001] FCA 1877. The relevant extract of the said judgement highlighted by the Australian Manual is set out below:

> *"I accept that **it takes patience, time and effort to unravel all of the claims of the Patent**. Subject to the expenditure of that time and effort, there is no alleged ambiguity in the claims. The problem is not with prolixity, but with attempted compression, and the multitude of claims. That, however, falls short of*

establishing that the claim or claims are not clear and succinct."

Objection on lack of Inventiveness

26. With regard to rejection on the ground of lack of inventiveness under Section 2(1)(ja) of the Act, the impugned order observes that feature 5b claimed in claim 1 comes within the range disclosed in prior art document D5. The relevant extract of the impugned order is set out below for reference:

> *"A method for manufacturing decorative laminates including the steps of:*
>
> 1. *Take paper substrate and impregnate it in thermosetting resin bath.*
> 2. *Apply ink acceptance layer which consist of inorganic pigment (P) and polymeric binder (B), wherein P/B ratio is 1.5 to 4.*
> 3. *Spray/jetting the pigmented inkjet ink (aqueous or aqueous pigmented) which consist colour pigment (C).*
> 4. *Heat pressing*
> 5. *Weight ratio of P/C is in range of 4.5 to 9.*
>
> *Characterized in that,*
>
> a. *Dry weight on colour pigment is in the range of 0.3 to 0.75 g/sq meter.*
> b. *Total dry weight of ink acceptance layer 3 g/sq meter to 6 g/sq meter.*
>
> *The Characterization part of claim-I has following main features:*
>
> a. *Dry weight on colour pigment is in the range of 0.3 to 0.75 g/sq meter.*

b. *Total dry weight of ink acceptance layer 3 g/sq meter to 6 g/sq meter.*
Method steps 1 to 4 as mentioned in above are explicitly disclosed in document D5. Further, characterized feature 5.b is also explicitly disclosed in the document D5, Paragraph [0033] of the Document D5 states that, "The application weight of the ink-receiving layer can be 2 to 25 g/m2 , in particular 3 to 20 g/m2 , but preferably 4 to 15 g/m2 .". The feature 5.b claimed in the claim 1 comes within the range disclosed in the document D5. Further, the weight of the ink receiving layer is depending of the type of binder/pigment/adhesive/chemical used and it varies with respect to the requirement of the final product. It is a matter of workshop modification and result of the process, and it does not involve any ingenuity."

27. However, counsel for the appellant correctly points out that D5 relates to 'application weight' and not 'total dry weight' as required by the Independent Claim 1. The respondent has placed reliance on paragraph 33 of the complete specification of the prior art document D5, which is set out below:

> *"**[0033]**. **The application weight of the ink-receiving layer can be 2 to 25 g/m^2, in particular 3 to 20 g/m^2, but preferably 4 to 15 g/m^2.** The ink receiving layer can be applied with the usual application methods such as roller application, slotted nozzle application, gravure or nip methods, curtain coating, airbrushing or metering bar."*

28. In this regard, reference may be made to paragraphs 37, 40 and 49 of the complete specification of document D5 that states that 'application weight' includes moisture content. The aforesaid paragraphs are extracted below:

> *"**[0037]** In the next step a coating mixture was prepared for the ink receiving layer having the following composition:*
>
> | ***Water*** | ***80% by weight*** |
> |---|---|
> | *Boehmite* | *10% by weight* |
> | *Polyvinyl alcohol* | *5% by weight* |
> | *Polyvinyl acetate* | *4% by weight* |
> | *Quat. polyammonium salt* | *1% by weight"* |
>
> *"**[0040]**. **The pre-dried core-impregnated paper** was then coated with the inkjet ink receiving layer described in detail above with an application weight of 6g/m^2 and dried to a final moisture of 6.3%."*
> *"**[0049]**. The decorative paper impregnate according to Example 2 was printed in an inkjet printer (HP 2500 with pigmented inks) and divided into DINA4 sheets. These sheets were placed on a chipboard, covered with an overlay film as in Example 1 and hot pressed. The pressing was carried out at a temperature of 140°C. and a pressure of 25 bar."*

29. Therefore, upon perusal of the above extracts, it cannot be said that D5 relates to 'total dry weight', which is specifically required under the Independent Claim 1 of the subject patent application.

Objection based on 'Common General Knowledge'

30. The next ground for refusal is that the feature 5a, though not taught by prior art document D5 alone but when combined with the teachings of 'common general knowledge', merely becomes a workshop modification. The relevant extract of the impugned order in this regard is set out below:

> *"Regarding characterized feature 5.a; it claims that the "Dry weight on colour pigment is in the range of 0.3 to 0.75 g/sq meter". The dry weight of the colour pigment in g/m2 is dependent on the multiple technical, material and operational parameters such as density of the colour, number of the colours used in the design,*

> *the type of the design, density of the ink used, type of the ink and solvent/carrier used. The dry weight of the ink varies with the requirement of the customer/user of the laminate (final product). The claimed feature is related to the result to be achieved. Further, it is related to the workshop modification and optimization, hence it does not involve any ingenuity. It is obvious to the person skilled in the art to use the common general knowledge along with the teachings of the document D5 and arrive at the characterized feature 5.a claimed in the claim-1."*

31. While rejecting the aforesaid feature of the Claim on the ground of 'common general knowledge', the impugned order does not provide any reference of the 'common general knowledge' or the fact as to why the persons skilled in art would apply such 'common general knowledge' to the aforesaid feature.

32. There is nothing to show that the characteristic feature 5a would vary as per the customer's requirement. 5a is an essential technical feature of Claim 1. Since the object is to produce a dark wood laminate of desired quality, a range as prescribed under 5a of the color pigment is necessary. The appellant has provided sufficient data as well as examples in Table 8 of the complete specification that demonstrates that the features claimed in Claim 1 produce the desired result.

33. In this regard, reference may be made to a passage from **Terrell on Law of Patents, 16th Edition**, which specifically discussed the aspect of proof for 'common general knowledge'. The relevant extract of the said passage is reproduced as under:

> *"Proof of common knowledge is given by witnesses competent to speak upon the matter, who, to*

> *supplement their own recollections, may refer to standard works upon the subject which were published at the time and which were known to them.* ***In order to establish whether something is common general knowledge, the first and most important step is to look at the sources from which the skilled addressee could acquire his information****.*
> *The publication at or before the relevant date of other documents such as patent specifications may be to some extent prima facie evidence tending to show that the statements contained in them were part of the common knowledge, but is far from complete proof, as the statements may well have been discredited or forgotten or merely ignored."* ***Evidence may, however, be given to prove that such statements did become part of the common knowledge****."*

34. From the above extract, for the Controller to rely on 'common general knowledge' as a ground for refusing a patent application, it is essential to specify the source of the said knowledge. It would be essential that the said source of the 'common general knowledge' would have been published before the priority date of the patent application. In addition, the fact that a theory or principal or knowledge has become common knowledge needs to be substantiated by some evidence. The said evidence could be in the form of references to the 'common general knowledge' textbooks or research articles or standard documents.

35. The judgement of the UK Patents Court in ***Generics (UK) Ltd.*** v. ***Daiichi Pharmaceuticals Co.Ltd.***, [2009] R.P.C. 4, has also given some guidance on what subject matter forms part of the 'common general knowledge'. In the said judgement it has also been clarified that there is no requirement for the knowledge to be at the forefront of the mind of the

person skilled in the art. The relevant extract of the said judgment is set out below:

> *"Thus the common general knowledge is the common knowledge in the field to which the invention relates. The notional skilled addressee is the ordinary man who may not have the advantages that some employees of large companies may have and information does not form part of the common general knowledge simply because it is known to some persons in the art. It must be generally known and generally regarded as a good basis for further action by the bulk of those engaged in that art before it becomes part of their common stock of knowledge relating to the art, and so part of the common general knowledge.* ***That is not to say the skilled person must have it at the forefront of his mind.*** *As Laddie J. explained in Raychem Corporations' Patents [1998] R.P.C. 31 at 40, it includes* ***all the material which he knows exists and which he would refer to as a matter of course if he cannot remember it and which he generally understands is sufficiently reliable to use as a foundation for further work.****"*

36. Recently, vide judgment dated 18th January, 2023, the Calcutta High Court, in ***Groz-Beckert KG* v. *Union of India & Ors.*, *2023 LiveLaw (Cal) 17*** held that for considering inventiveness, the invention as a whole has to be considered and not broken down into isolated elements. In the said judgment it has also been specifically highlighted that there needs to be preciseness about what constitutes 'common general knowledge.' The relevant extract of the said judgment is set out below:

> *"7.* ***Thus, in determining inventive steps, the invention should be considered as a whole.*** *In other words, it is not sufficient to draw the conclusion that a claimed invention is obvious merely because individual*

> *parts of the claim taken separately are known or might be found to be obvious. The contention that an invention is obvious in relation to a particular item must be treated with care and caution. In doing so, the whole picture presented should be taken into consideration and not a partial one.* ***There should be an element of preciseness about what is asserted to be common general knowledge.*** *The "obviousness" must also be strictly and objectively judged. (Bishwanath Prasad Radhey Shyam vs. Hindustan Metal Industries (1979) 2 SCC 511 paras 24 & 25, F. Hoffman La Roche Ltd. Vs. Cipla Ltd. PTC 1 paras 13, 143)."*

37. In the present case, however, the Controller has failed to give any source of the common knowledge that has been considered. Therefore, it cannot be construed as to what precise element of 'common general knowledge' has been considered along with the cited prior art to claim that the combination of the teachings of the prior art and the 'common general knowledge' led to a finding of lack of inventive step.

38. It may be relevant to note that document D5 was also cited before the European Patent Office in the opposition proceedings against the appellants in the corresponding European application. Yet, the claims were found novel and innovative over document D5, other prior art documents and other documents.

Refusal of Independent Claim 11

39. The respondent, in the impugned order claims that the features claimed in Claims 11-13 are explicitly disclosed in prior art Document D5. The relevant portion is set out below:

> *Regarding claims 11-13: The technical features of the product claimed in the claim 11-13 are* ***explicitly disclosed in Document D5***

40. With regard to Independent Claim 11, the said Claim is directed towards an 'inkjet printed thermosetting resin impregnated paper'. The Claim 11 is set out below:

> *"11. An inkjet printed thermosetting resin impregnated paper including a colour pattern in an ink acceptance layer containing an inorganic pigment and a polymeric binder having a weight ratio P/B of inorganic pigment P to polymeric binder B is in the range of 1.5-4, wherein the weight ratio P/C of the inorganic pigment P of the ink acceptance layer to the jetted colour pigment C in the colour pattern is in the range of 4.5-9; and wherein the ink acceptance layer is free of thermosetting resin."*

41. The appellant has given the following features of the aforesaid Claims:

> *"i. Color pattern in the ink acceptance layer having P/B weight ratio of inorganic pigment (P) to polymeric binder (B) in the range of 1.5-4,*
>
> *ii. Weight ratio P/C is in the range of 4.5-9, i.e. the weight ratio of the inorganic pigment P of the ink acceptance layer to the jetted colour pigment C,*
>
> *iii. The ink acceptance layer is free of thermosetting resin."*

42. The impugned order fails to give any reasoning with regard to novelty or the inventive feature of the aforesaid Claims and merely concludes that the '*technical features of the product claimed in claim 11 to 13 are explicitly disclosed in D5'*. D5 does not make any teaching that the ink receiving layer is free of thermosetting resin.

43. This Court also notes that corresponding patent application has been granted in various jurisdiction, details of which are given at page no.109 of

the appellants' documents and which includes USA, UK, Australia, China and various countries in Europe.

44. In view of the discussions above, the impugned order dated 17th June, 2022 is set aside and the Patent Office shall proceed to grant the patent, subject to completion of necessary formalities.

45. List before the Patent Office on 14th June, 2023 for completion of necessary formalities.

46. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trademarks of India on the e- mail- llc-ipo@gov.in for compliance of this order.

Post Script

47. As the number of Patent filings in India are rapidly increasing and there is an imminent need to update the Manual of Patent Office Practice and Procedure so that Examiners and Controllers can get better guidance on dealing intricate matters like objections of lack of clarity and succinctness. This would be particularly useful when dealing with complex patents involving Artificial Intelligence systems, machine learning functions, agro-chemicals, pharmaceuticals and manufacturing methods. It is often observed that patent applications in these domains either have a large number of Claims or involve a lot of features, which are interlinked to each other. Therefore, I would recommend to the Office of the Controller General of Patents, Designs and Trademarks to update or revise the Manual for Practice. This would ensure that Examiners and Controllers can be better equipped to ascertain aspects like clarity and succinctness of inventions. It

may also be appropriate to consider giving adequate technical and patent analytics trainings to Examiners and Controllers.

48. A copy of this order be sent by the Registry to the Office of the CGPDTM on the following email: cgoffice-mh@nic.in.

AMIT BANSAL, J.

2nd June, 2023
at