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IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

IN ITS COMMERCIAL DIVISION

COMMERCIAL MISCELLANEOUS PETITION (L) NO. 19258 OF 2024

Medipack Global Ventures Private Limited ...Petitioner

Versus

Assistant Controller Of Patents and Designs ...Respondent

Mr. Hiren Kamod, Mr. Abhishek Adke and Ms. Deepali Joshi, Priyank Gupta and Mr. Abhishek Shrivastava for Petitioner.

Mr. Ashish Mehta and Mr. Ashutosh Misra a/w. Mr. Raj Dani i/b. Ethus Legal Alliance for Respondent

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CORAM : ARIF S. DOCTOR, J.

RESERVED ON : 4th MARCH 2026

PRONOUNCED ON : 23rd MARCH 2026

JUDGMENT

1. The present Commercial Miscellaneous Petition has been filed under the provisions of Section 117A of the Patents Act, 1970 ("**Patents Act**") and

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impugns an order dated 4th March 2024 by which the Respondent, i.e., the Assistant Controller of the Patents has refused the Petitioner's Patent Application No. 202221047021 ("**the Patent Application**") titled "A Syringe With Breakable Plunger" ("**the Petitioner's invention**").

2. Mr. Kamod, Learned Counsel appearing on behalf of the Petitioner at the outset, submitted that the Petitioner's invention relates to a single-use safety syringe aimed at preventing reuse so as to reduce health risks, such as infection spread from shared syringes. He pointed out that the Petitioner's invention includes (i) a barrel with inner tear-off notches; (ii) a plunger featuring a base, head, and breakable section between them, plus outer locking grooves; and (iii) a spacer that stops the plunger from fully entering the barrel, which is removed after filling the syringe with medication.

3. He then also pointed out that the plunger breaks at its frangible point once the locking grooves catch the barrel's notches and that this breakable point is a seal at the plunger's bottom, with the base shaped oblong to serve as a

lever for snapping the plunger in two after use. He submitted that the oblong part has a flange extending outward from the plunger's center axis and that this setup ensures that the plunger locks and breaks after injection, making the syringe unusable again. He submitted that, despite this, the Petitioner's patent application had been rejected on the ground of lack of inventive step and novelty.

4. Mr. Kamod then pointed out that the impugned order suffers from the following fundamental defects:

   i. The impugned order contains no independent reasoning or analysis of the Petitioner’s invention, the cited prior art, or the Petitioner’s detailed submissions.

   ii. The impugned order merely reproduces portions of prior art documents and concludes that the Petitioner’s submissions are not persuasive, without explaining how the amended claims were anticipated or rendered obvious.

iii. The impugned order records that the patent application has been refused on the grounds of lack of novelty and lack of inventive step, even though the hearing notice dated 20th October 2023 did not raise the novelty objection.

5. Basis the above, he submitted the Petition therefore raised a narrow but important question of law as to whether a patent application can be refused through a non-speaking order which does not disclose any reasoning or application of mind but merely sets out the conclusion reached by the Controller.

6. However, before adverting to the rival contentions, it is useful for context to set out the following facts viz.

i. The patent application was filed on 18th August 2022, after which the Petitioner filed a request for examination on 10th November 2022 under Rule 24B of the Patents Rules, 2003 (as amended).

ii. The patent application was published on 18th November 2022 in Journal No. 46/2022.

iii. After an examination under Sections 12 and 13 of the Patents Act, a First Examination Report (FER) was issued on 24th November 2022, in which the prior art documents, i.e., D1 (US2004039334A1) and D2 (US2014155826A1) were cited and objections were raised under the provisions of Sections 2(1)(j) (novelty) and 2(1)(ja) (inventive step), as well as under Sections 10(4)(c) and 10(5) for lack of clarity, conciseness, and sufficient definition of the invention.

iv. The Petitioner on 11th December 2022 submitted a detailed reply to the FER, including amendments to the claims and specifications contained therein.

v. A hearing notice was thereafter issued on 20th October 2023, scheduling a hearing for 16th November 2023. The hearing notice however, was limited only to objections with regard to inventive step under Section 2(1)(ja) and did not contain any objection with regard to novelty.

vi. At the hearing held on 16th November 2023, the Petitioner's authorised agent made submissions restricted only to the aspect of inventive step

and on 30th November 2023 filed written submissions, along with amended Claims 1 to 4.

vii. However, vide the impugned order the Petitioner's Patent Application was refused on the ground of lack of both novelty and inventive step.

viii. Hence the present Petition.

Submissions on behalf of the Petitioner:

7. Mr. Kamod first pointed out that despite the fact that the Hearing Notice was confined to only to the aspect of inventive step under Section 2(1)(ja), the impugned order proceeded to reject the Petitioner's Application on both, novelty and inventive step. He thus submitted that the Controller, in travelling beyond the grounds taken in the hearing notice, had acted in complete breach of the principles of natural justice since the Controller had decided the Application on a ground which did not form part of the hearing notice, i.e. novelty.

8. He then, without prejudice to the above, submitted that the impugned order was a non-speaking order since the same was devoid of any independent

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reasoning by the Respondent. To illustrate this contention, Mr. Kamod pointed out that paragraphs 1 to 6 of the impugned order merely recorded the procedural history, referenced the hearing, and recorded the filing of amended claims, and thereafter, from paragraph 7 onwards, merely cited the prior art documents D1 to D4 and thereafter summarily concluded that the claimed invention lacks novelty and inventive step.

9. Mr. Kamod took pains to point out that there was no analysis, much less independent reasoning, of the Petitioner's detailed written submissions distinguishing the prior art cited. He pointed out that the impugned order merely reproduced the Petitioner's claims and extracts from the prior art without in any manner mapping the specific claim elements to the cited disclosures or explaining how the invention is anticipated or rendered obvious from the cited prior art. He thus submitted that the Respondent had merely, in a mechanical manner, only reproduced the Petitioner's claims and the prior art cited and simply concluded by finding that the Petitioner's

submissions as "*not persuasive*" without so much as any independent analysis or reasoning as to why this was so.

10. Mr. Kamod then submitted that in assessing whether the Petitioner's invention lacked inventive step, the Controller was duty-bound to undertake a structured analysis in accordance with the principles governing the determination of inventive step which were set out in the Patent Office Manual of Practice and Procedure (Chapter on Determination of Inventive Step). He pointed out that the Manual clarified that the assessment of inventive step must be undertaken by considering the invention as a whole in light of the prior art as a whole revealed during the search process. He submitted that it was not sufficient for the Respondent to conclude that the claimed invention was obvious merely because individual elements of the claim, when taken separately, were known in the prior art.

11. He clarified that while the combination or mosaicing of prior art documents may be permissible, such combination must be supported by clear reasoning demonstrating why a person skilled in the art would be

motivated to combine the teachings in the prior art documents to arrive at the claimed invention. He submitted that the exercise therefore requires a reasoned analysis identifying the distinguishing features of the claimed invention, examining whether those features were disclosed or suggested in the cited prior art, and should explain how a person skilled in the art would be able to arrive at the claimed invention based on such teachings. He pointed out that in the present case, the impugned order did not undertake any such analysis and that the Respondent had neither examined the invention as a whole nor provided any reasoning as to why a person skilled in the art would be able to, by combining the cited prior art documents, arrive at the Petitioner's invention, to sustain the finding of lack of inventive step.

12. Mr. Kamod submitted that the Petitioner's reply to the FER was exhaustive and pointed out therefrom that the Petitioner had addressed why the invention was not hit by novelty or inventive step, with submissions distinguishing the claimed features from the cited prior art. He further

pointed out that the Reply included a table comparing elements of independent Claim 1 against the cited documents, followed by individual analyses, differences with the cited prior art and amendments to incorporate distinguishing features without adding new matter. Similarly, he pointed out that the hearing submissions were confined only to inventive step and not novelty and since inventive step was the only objection contained in the hearing notice the Petitioner had included in the written submission further amendments supported by specifications and a detailed table comparing each feature of the amended Claim 1 against the cited prior art in detail. He submitted that despite these detailed responses, the impugned order did not provide any independent analysis of the claims made and merely reproduced portions verbatim from the cited prior art without considering or dealing with the Petitioner's tables, distinctions, or submissions. It was thus he submitted that the impugned order was a non-speaking order.

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13. Basis above, Mr. Kamod submitted that the impugned order was liable to be set aside and the matter be remanded for fresh consideration on the following grounds:

i. First, it improperly revives the novelty objection under Section 2(1)(j), which was waived in the Hearing Notice, without giving the Petitioner an opportunity to address the issue of novelty. Thus, the principles of natural justice were violated.

ii. Second, there was a complete absence of any independent analysis or reasoning and the impugned order merely reproduces verbatim disclosures from prior art documents as purported "reasoning", without engaging the Petitioner's detailed oral as well as written submissions, tables comparing features, or distinctions.

iii. Third, the concluding paragraphs contained only generic, boilerplate statements such as "*hence all features... are well disclosed*" and "*there is no evidentiary proof...*" reflecting non-application of mind to the specific invention as a whole, contrary to the Patent Office Manual

(Chapter 4 on Inventive Step), which mandates that the prior art and the claimed invention must be considered holistically, prohibits mere mosaicing of individual features, and requires objective assessment of obviousness to a person skilled in the art.

14. Mr. Kamod then placed reliance upon the decision of the Delhi High Court in the case of ***Huhtamaki OYJ v. Controller of Patents***[1] to point out that the Delhi High Court had lamented on the "*endemic problem*" of non-speaking orders passed by the Respondent. He pointed out from the said decision that the Delhi High Court had repeatedly criticised similar copy-paste refusal orders and had made strong observations, noting that such orders reflect a systemic issue in the Patent Office and had also noted that the refusal of a patent is a serious matter, particularly since a patent, once granted, subsists for twenty years from the date of application and not from the date of grant. He also pointed out that every order rejecting a request for grant of a patent must be a reasoned and speaking order, dealing

[1] 2023 SCC OnLine Del 3272.

systematically and sequentially with each objection that requires consideration.

15. Mr. Kamod then also placed reliance upon the decision of the Delhi High Court in ***Biomoneta Research Pvt. Ltd. v. Controller General of Patents***[2] to point out that the use of generic, boilerplate reasoning vitiates an order. He pointed out that the Court had, in that case, specifically reproduced the standardised language used by the Controller, such as "*considered but is not fully persuasive*", "*arguments of the applicant/agent are not found satisfactory and persuasive*", and "*oral arguments and written submissions have been carefully considered; however, without prejudice… the substantive requirements are not complied with*". He took pains to point out that in the present case, as well, the Controller had used identical language/phrases.

16. Basis the above, Mr. Kamod submitted that the impugned order would have to be set aside, and the matter remanded back for consideration afresh

[2] [Delhi High Court] Order dated 13th March 2023 in C.A.(COMM. IPD-PAT) 297/2022.

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since, absent any independent analysis, the Petitioner was left without any specific reasoning to assail before this Hon'ble Court on the merits of the patent application. He submitted that the total absence of a speaking order deprived the Petitioner of any meaningful opportunity to demonstrate the flaws in the Controller's approach, and thus the order must be set aside and the matter remanded to the Patent Office for fresh adjudication by a different Controller.

Submissions on behalf of the Respondent:

17. Mr. Mehta, learned counsel appearing on behalf of the Controller, submitted that the order must be read and construed as a whole and not in the manner that the Petitioner seeks to do. He then took me through the order to point out that the Respondent had carefully considered the Petitioner's claims as a whole and had, after applying the established principles to determine inventive step under the Patent Act, arrived at a conclusion that the said invention lacks inventive step and novelty.

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18. He submitted that the impugned order was based on a thorou5gh review of the application, the prior art and the Petitioner's submissions. He further submitted that the Controller had provided clear and concise reasoning for the decision arrived at and that each of the Petitioner's arguments stood addressed, including by citing the relevant legal provisions. He therefore denied that the impugned order was passed without considering the individual claims of the Petitioner.

19. In the aforesaid context, he submitted that the application was not refused without due consideration, as the Petitioner had sought to contend, but had been passed after a thorough assessment of the prior art cited. He reiterated that the impugned order would have to be construed as a whole and not in the myopic manner in which the Petitioner was attempting to view it. He submitted that the principles of natural justice had also been fully complied with and the Controller had refused the patent application because no inventive step, as claimed by the Petitioner, was found by the Controller, as reflected in the impugned order.

20. When Mr. Mehta was asked to point out from the order the reasoning by which the Controller had independently considered the Petitioner's claims and juxtaposed the same with the prior art, Mr. Mehta was unable to do so. He reiterated that the conclusion reached by the Controller was after duly considering all the claims of the Petitioner and the prior art, and therefore the fact that the Controller had carried out a thorough examination was implicit. He was also unable to explain why the Controller addressed the issue of novelty in the impugned order, even though the hearing notice did not raise the issue.

21. After having perused the record, heard learned counsel for the parties and having considered the case law upon which reliance was placed, I find that the Petition deserves to be allowed. I say so for the following reasons:

A. Despite the fact that the issue of novelty was not raised in the hearing notice, the impugned order has rejected the Petitioner's application both on the ground of novelty and inventive step. The Controller has therefore rejected the Petitioner's Application on a ground which

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was not raised in the hearing notice and therefore one to which the Petitioner did not have the opportunity to respond. The Controller has therefore clearly travelled beyond the hearing notice and proceeded to determine an issue to which the Petitioner was never given an opportunity to respond. Therefore, the Controller, in adjudicating upon the aspect of novelty without giving the Petitioner notice thereof, has acted in violation of the principles of natural justice.

B. Additionally, a perusal of the impugned order makes plain that it is entirely unreasoned. All that the Controller has done is simply reproduce the Petitioner's claims and portions from the prior art cited and has gone on to conclude on the basis of the prior art that the Petitioner's claims are not persuasive without in any manner explaining how the Petitioner's amended claims were anticipated or rendered obvious from the prior art cited. The Controller has not provided any independent reasoning as to how the Petitioner's

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invention lacks inventive steps or, for that matter, novelty. The Controller has simply reproduced the Petitioner's claims and portions from the prior art cited and has concluded that the prior art renders the Petitioner's claims unpersuasive. There is absolutely no reasoning and/or explanation as to how the Petitioner's amended claims were anticipated or rendered obvious from the prior art cited.

C. Additionally, and crucially, Section 117A of the Patents Act specifically provides for an appeal against any order passed by the Registrar under Section 15. It is well settled that reasons form the heart and soul of an order, more so when such orders are appealable. It was therefore incumbent upon the Controller to have given independent reasons to support the rejection of the Petitioner's Patent Application, which, as already noted above, the Controller has failed to do.

D. The Petitioner's reliance on the decision of the Delhi High Court in the case of ***Huhtamaki OYJ v. Controller of Patents*** in which the

Delhi High Court has lamented on the endemic problem of non-speaking orders being passed by the Controller, is entirely apposite to the facts of the present case. Sadly, the Delhi High Court's lament seems to have fallen on deaf ears since the problem very much persists to date, as is evident from a perusal of the impugned order. The Controller has also clearly turned a blind eye to the following directions issued by the Delhi High Court to be followed when deciding a patent application viz.

> *"12. This Court, therefore, is constrained to issue the following directions:*
> *(i) Every order which either*
> *(a) rejects an application seeking grant of a patent, or*
> *(b) accepts, or rejects, any pre-or post-grant opposition to such applications,*
> *shall be reasoned and speaking, and shall deal systematically and sequentially with each objection that requires consideration, whether contained in the FER, or the hearing notice, or in any pre- or post-grant opposition, and provide reasons as to why the objection is sustained or rejected.*
> *(ii) If there is no pre-or post-grant opposition to the patent, and objections are raised only by the office of the Controller itself, in the FER or Hearing Notice, and the reply of the applicant in response thereto is found to be worthy of acceptance, then, too, the order granting the patent should briefly state why the applicant's reply is accepted, as this would facilitate*

any postgrant opponent, who seeks to oppose the grant of the patent, or seek its revocation, after the patent is granted.

(iii) The requirement of a reasoned and speaking order would obviously not apply if the patent, as sought, is granted, and there is no objection in the FER or hearing notice, or pre-or post-grant opposition thereto."

E. The Controller has also completely ignored the procedure laid down in the Patent Office Manual of Practice and Procedure (Chapter on Determination of Inventive Step), which *inter alia* lays down that the assessment of inventive step must be undertaken by considering the invention as a whole in light of the prior art as a whole revealed during the search process. Thus, in assessing whether the Petitioner's invention lacked inventive step, the Controller was duty-bound to undertake a structured analysis in accordance with the principles governing the determination of inventive step as set out in the Patent Office Manual, and therefore it is not sufficient for the Controller to conclude that the claimed invention was obvious merely because individual elements of the claim, when taken separately, were known in the prior art.

22. Therefore, in my view, the impugned order would have to be set aside. Hence the following order:

(i) The impugned order dated 4th March 2024 passed by Respondent Controller is set aside.

(ii) The matter is remanded back for fresh consideration before a different Controller who shall adjudicate the application in accordance with law. Needless to state that all the rights and contentions of the parties are kept open.

(iii) It is clarified that this order should not be construed to mean that this Court has cast any aspersion on the Controller who passed the impugned Order.

(iv) Petition is accordingly disposed of.

(v) There shall be no order as to costs.

[ARIF S. DOCTOR, J.]