



2025:DHC:9987



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

Date of decision: 31.10.2025

+ C.A.(COMM.IPD-PAT) 15/2024 & I.A. 8457/2024

ALCON INC

.....Appellant

Through: Mr. Pravin Anand and Mr. Ravi Aggarwal, Advocates

versus

CONTROLLER OF PATENTS AND DESIGNSRespondent

Through: Mr. Nishant Gautam, CGSC, Mr. Vardhman Kaushik and Mr. Prithivi Raj Dey, Advocates.

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CORAM:

HON'BLE MS. JUSTICE MANMEET PRITAM SINGH ARORA

J U D G M E N T

MANMEET PRITAM SINGH ARORA, J (ORAL):

1. The present appeal has been filed under Section 117-A of the Patents Act, 1970 [‘the Act’] against the impugned order dated 15.12.2023 passed by the Assistant Controller of Patents and Designs, whereby the patent application bearing number 201914027377 dated 09.07.2019 and titled ‘INTRAOCULAR LENS INJECTOR’ [‘subject application’] has been refused.

2. The facts, as stated in the appeal, which are relevant for the adjudication of the present appeal are as under: -

2.1. The appellant/applicant filed the subject application at the Patent Office, New Delhi on 09.07.2019 as a conventional application derived from



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Priority Application No. US 62/696,078 dated 10.07.2018.

2.2. The request for examination was filed at the Patent Office on 09.07.2019. The First Examination Report [‘FER’] was issued by the Patent Office 12.02.2021. The relevant objections raised in the said FER were as under: -

a) The claims 1-14 are not novel under Section 2(1)(j) of the Act in view of the following document:

i) D1: WO 1997013476

b) The subject matter of claims 1-14 does not constitute an invention under Section 2(1)(ja) of the Act for lack of inventive step in view of the afore-cited documents D1 to D6: -

i) D1: WO1997013476

ii) D2: US20150066043

iii) D3: US20140257315

iv) D4: US20090112223

v) D5: JP6278701B2

vi) D6: US20140031832

c) The subject matter of claims 1-14 does not fulfil requirement under Section 10(4)(c) of the Act.

2.3. The applicant/appellant through its authorized agent on 02.07.2021, duly filed its reply to said FER.

2.4. A hearing notice was issued by the Patent Office on 05.09.2023. The relevant objections in the hearing notice are as follows: -

i) Subject matter of the amended claims 1-13 does not constitute an invention under Section 2(1)(j) of the Act for lack of novelty and inventive step in view of the following prior arts:

a) D1: WO1997013476



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- b) D2: US20150066043
- c) D3: US20140257315
- d) D4: US20090112223

2.5. After hearing, the appellant filed its written submissions on 17.10.2023.

2.6. Another hearing notice was issued by the Patent Office on 17.10.2023. The relevant objections in the hearing notice were as follows: -

- i) The subject matter of claims 1 does not fulfil requirement under Section 10(4)(c) of the Act.
- ii) Subject matter of the amended claims 1-13 does not constitute an invention under Section 2(1)(ja) of the Act for lack of inventive step in view of the following prior arts:

- D1: WO1997013476
- D2: US20150066043
- D3: US20140257315
- D4: US20090112223
- D5: CN206491899U

2.7. Thereafter, impugned order was passed by the Assistant Controller refusing the subject application under Section 15 of the Act citing lack of inventive step as prescribed under Section 2(1)(ja) of the Act. The relevant extracts from the impugned order are set out hereinbelow: -

“Motivation- Both the documents D1 and D5 are delivery devices aimed at delivering an implantable folded intraocular lens, D1 has all the construction features of the current application except the telescopic arrangement and D5 is also directed in the same domain and also discloses the telescopic arrangement, therefore the undersigned is convinced that there is enough motivation for a person skilled in the art to combine the teachings of the cited documents and arrive at the same subject matter as the current application.

The applicant reasons that “The mere fact that 5 documents are to be



considered by the person skilled in the art in an attempt to arrive the teachings of the present invention, indicates that the present invention is non-obvious.”, however only two of the cited documents are sufficient to disclose the subject matter of the current application.

Further the applicant states “Further, such documents have to be combined by an unimaginative man with no inventive capacity.” However since both the documents are directed at implanting intraocular lens and lack only simple constructional features thence there is sufficient motivation to combine the two documents and thus this reasoning by the applicant is not appropriate.

All the reasoning provided by the applicant in his written submissions dated 12/12/2023 were based on the fact that multiple documents are cited and therefore the application is inventive and that the cited documents offer different solutions altogether and therefore what motivation would the person skilled in the art have to even look for these documents in any order or combination, whatsoever. However in view of the above analysis it is clear that only two cited documents are enough to fully disclose the subject matter of the current application and both are directed towards the same subject matter and thence any person skilled in the art will consider these citations while judging the inventiveness of the current application.”

[Emphasis Supplied in the impugned order itself]

3. Mr. Praveen Anand, learned counsel appearing on behalf of the appellant, made the following submissions: -
 - 3.1. The Respondent’s reasoning that a person skilled in the art would combine D1 and D5 to arrive at the claimed invention is untenable.
 - 3.2. D1 discloses an intraocular lens injector employing a threaded (screw-in) piston mechanism, while D5 discloses an injector utilizing either a screw-in or a telescoping (push-in) drive mechanism - both being alternative, mutually exclusive configurations. Neither reference teaches or suggests integrating these two mechanisms into a single device. A skilled person, faced with D1 and D5, would at best replace the screw-in drive of



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D1 with the telescoping drive of D5, not combine them.

3.3. Moreover, in both D1 and D5, the plunger moves relative to the main body, whereas claim 1 of the instant application specifically requires that the plunger remains stationary while a collapsible portion moves between un-collapsed and collapsed configurations. Thus, the proposed combination made by the controller by reading D1 and D5 is purely on hindsight reconstruction. It is stated that D5 does not clearly or explicitly teach a combination of both mechanisms in a single injector device, as claimed in the present invention.

3.4. Consequently, the combination of D1 and D5 cannot render the claimed subject matter obvious, and the invention therefore satisfies the requirement of inventive step under Section 2(1)(ja) of the Act.

3.5. The Respondent has also not applied any test to examine inventive step laid down in the case of **F. Hoffmann- La Roche Ltd & Anr. vs. Cipla Ltd.**¹ or as prescribed under **Agriboard International LLC v. Deputy Controller of Patents & Designs**².

3.6. Appellant relies upon the written submission dated 03.09.2024 filed in response to the written submission dated 03.08.2024 filed by the Controller. It also relies upon the short Note handed over during the course of the hearing.

4. In response, Mr. Nishant Gautam, learned counsel for the Respondent states that the impugned order records reasons which led the Respondent to hold that the subject matter of the patent application lacks inventive step as per Section 2(1)(ja) of the Act. He relied upon the written submissions filed

¹ 2015 SCC OnLine Del 13619

² 2022 SCC OnLine Del 4786



03.08.2024 in the present appeal.

5. This Court has heard the counsel for the parties and perused the record.

6. According to the impugned order, the subject application was refused on the ground of lack of inventive step as per Section 2(1)(ja) of the Act.

7. Inventive step is one of the three [3] essential requirements, i.e., novelty, inventive step and industrial application, for an eligible subject matter to be an invention under Section 2(1)(j)³ of the Act.

8. The elements of inventive step requirement under Section 2(1)(ja) of the Act have been laid down by the Supreme Court of India in **Novartis AG v. Union of India**⁴. The relevant paragraph of the said judgment is reproduced hereinbelow:-

“76. On a combined reading of clauses (j), (ac) and (ja) of Section 2(1), in order to qualify as “invention”, a product must, therefore, satisfy the following tests:

(i) It must be “new”;

(ii) It must be “capable of being made or used in an industry”;

(iii) It must come into being as a result of an invention which has a feature that:

(a) entails technical advance over existing knowledge;

or

(b) has an economic significance;

and

(c) makes the invention not obvious to a person skilled in the art.”

[Emphasis supplied]

³ (j) “invention” means a new product or process involving an inventive step and capable of industrial application;

⁴ (2013) 6 SCC 1



9. According to **Novartis AG v. Union of India**⁵ an eligible subject matter should satisfy the following elements of inventive step to fulfil the inventive step requirement:-

1. Well-defined feature(s), that demonstrate technical advancement over the existing knowledge and/or involves economic significance; and
2. The feature(s) make the invention not obvious to a person skilled in the art.

10. Further, the Division Bench of this Court in **F. Hoffmann-La Roche Ltd. v. Cipla Ltd.** (supra) had set out a five [5] step approach to determine obviousness or lack of inventive step. Recently, in **Tapas Chatterjee v. Controller of Patents & Designs**,⁶ a Division Bench of this Court has reaffirmed those five [5] steps and the relevant paragraph reads as under:

“21.4.1 The learned Single Judge has, in para 25 of the impugned judgment, relied on the pronouncement of the Division Bench of this Court in *F. Hoffmann La Roche Ltd. v. Cipla Ltd.*, and we are in agreement with him that the said decision lays down principles which, for the present, may be regarded as the gold standard to determine whether a later invention is obvious from the teachings contained in an earlier patent. The Division Bench has identified the following steps, in this regard:

“Step No. 1 To identify an ordinary person skilled in the art,

Step No. 2 To identify the inventive concept embodied in the patent

Step No. 3 To impute to a normal skilled but unimaginative ordinary person skilled in the art what was common general knowledge in the art at the priority date

Step No. 4 To identify the differences, if any, between the matter cited and the alleged invention and ascertain whether the differences are ordinary application of law or involve various different steps

⁵ (2013) 6 SCC 1

⁶ 2025 SCC OnLine Del 6369



requiring multiple, theoretical and practical applications,

Step No. 5 To decide whether those differences, viewed in the knowledge of alleged invention, constituted steps which would have been obvious to the ordinary person skilled in the art and rule out a [hindsight] approach.”

Having thus reproduced the steps that **Hoffman** envisages as being required to be followed, sequentially, while examining the aspect of obviousness and the existence of inventive step, the learned Single Judge, in para 26 of the impugned judgment, proceeds to observe that he would “start at Step 4 and identify the differences, if any between the prior art as identified by the Controller and the subject patent application”.

21.4.2 There are obvious errors in the manner in which the learned Single Judge has applied the procedure outlined in **Hoffmann**.

21.4.3 We are of the opinion that the learned Single Judge could not have commenced applying the principles in **Hoffmann** from Step 4. The error in starting from Step 4 is self-evident. It bypasses the person skilled in the art who, statutory and legally, is the person, from whose point of view the aspect of inventive step and obviousness has to be determined. Identification of the person skilled in the art is, therefore, the fundamental first step while examining a plea of obviousness and lack of inventive step.

21.4.4 Steps 2 and 3 are no less significant. To ascertain whether a later invention, that is sought to be patented, on which already stands patented, is obvious vis-à-vis prior art, the inventive concept of the prior art has to be understood and identified. It is only once the inventive concept of the prior art-as well as, we may add, the inventive concept of the later invention-are identified, that it would be possible to gauge the distance that would be required to be scaled, to leap from one to the other.

.....

21.6 The sequitur

The sequitur would not, however, be that the subject process, that the appellant desires to patent, would ipso facto be entitled to be treated as inventive, or not obvious, vis-à-vis the prior art documents D1 and D2. It is only an invention which is inventive, and is not obvious to a person skilled in the art possessed with common general knowledge and the teachings contained in the prior art documents, that can be patented. Whether the subject process satisfies this requirement would have to be determined by



strictly following the tests laid down by the Division Bench in *Hoffmann*, and the principles outlined earlier in this judgment. While all the Steps identified in Hoffmann are important, we would lay particular emphasis on Steps 1, 2 and 5.

....

Conclusion

23. We, therefore, allow the present appeal in the following terms and to the following extent:

...

(iv) The *de novo* consideration would be carried out strictly in terms of the principles enunciated in *Hoffmann* as well as in the present judgment. There shall be implicit adherence to the said principles.

[Emphasis supplied]

11. Therefore, upon considering the decision by the Division Bench of this court in **F. Hoffmann-La Roche Ltd. v. Cipla Ltd.** (supra) and **Tapas Chatterjee v. Controller of Patents & Designs** (supra) and also considering the spirit of Section 2(1)(ja) of the Act as enunciated in **Novartis AG v. Union of India** (supra), it is clear that, for returning a finding under Section 2(1)(ja) of the Act, the Controller is required to examine all the elements of section 2(1)(ja) of the Act and is also required to follow the assessment test of inventive step or obviousness as prescribed by Division Bench of this court in aforesaid judgements explicitly or implicitly.

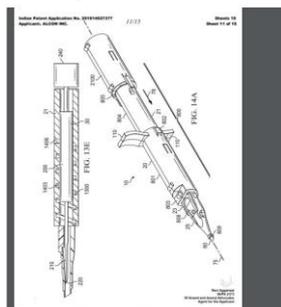
12. However, upon perusal of the impugned order, it is evident that the analysis of the Controller does not completely comply with the requirements of the Act or follow the steps prescribed by the Division Bench of this Court explicitly or implicitly.

13. In the impugned order, while rejecting the appellant's subject application, the Controller has identified the features of the invention as



below:-

“The invention can be summarized as: An intraocular lens (IOL) injector comprising: an injector body comprising: a main body comprising: a bore; and an interior wall defined by the bore, the interior wall including a distal portion and a proximal portion;; a nozzle coupled to a distal end of the main body, the nozzle comprising: a passage in fluid communication with the bore; and a distal opening in fluid communication with the passage; and a plunger received in the bore and comprising: a plunger body; a plunger rod coupled to a distal end of the plunger body; a plunger tip formed at a distal end of the plunger rod and adapted to contact an IOL, one of the interior wall and the plunger body including a threaded surface and the other of the interior wall and the plunger body including a feature adapted to engage the threaded surface to produce axial movement of the plunger in response to axial movement or rotation of the plunger body; and a collapsible portion disposed between the main body and the nozzle, the collapsible portion moveable between a collapsed configuration and an uncollapsed configuration, the collapsible portion comprising: a first sleeve; and a second sleeve telescopingly received into the first sleeve, the collapsible portion moveable from the uncollapsed configuration in which the first sleeve is at a first position relative to the second sleeve to the collapsed configuration in which the first sleeve is at a second position relative to the second sleeve and the plunger tip moveable from a first plunger tip location to a second plunger tip location distal of the first plunger tip location when the collapsible portion is moved from the uncollapsed configuration to the collapsed configuration, and wherein the plunger remains stationary relative to the main body when the collapsible portion is moved from the uncollapsed configuration to the collapsed configuration.



Briefly it can be put together that a telescopic arrangement instead of a commonly used hollow cylinder with piston for delivering an intraocular

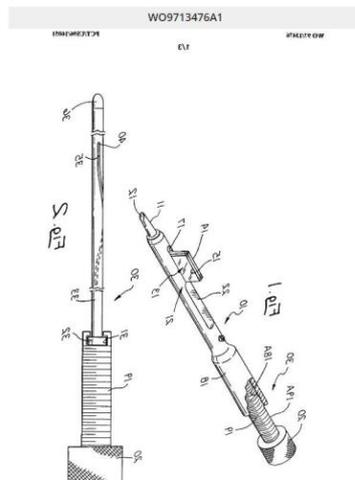


lens, thus in the present invention there are two concentric sleeves that move telescopically while the piston remains stationary.”

[Emphasis supplied]

14. The Controller also identifies the features of the prior arts D1 and D5 as below: -

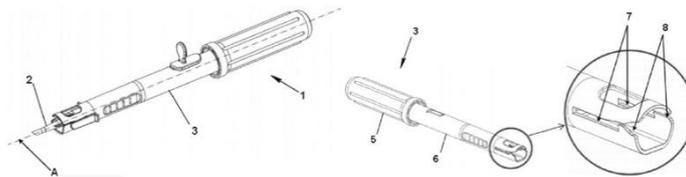
“The cited prior art D1 (WO1997013476) discloses an apparatus for inserting a folded intraocular lens through an incision into an eye comprising: a tube defining a hollow passage, said tube having an ejection port through which said intraocular lens is passed from said hollow passage into an eye; an injector rod longitudinally movable within said hollow passage of said tube, said injector rod having a distal portion adapted to contact the folded intraocular lens within said hollow passage of said tube to urge the folded intraocular lens distally through said hollow passage; and a rotation assembly located relative to said injector rod so that said injector rod is axially rotated a controlled amount as said injector rod is moved distally through said tube.



D1 discloses a very similar construction but the telescopic arrangement is not disclosed.



The cited document D5 (CN206491899U) discloses an intraocular lens implanting device (1), its characterized in that, intraocular lens implanting device (1) includes: implant head (2), implantation head (2) is the folding type implantation head that presses from both sides of non - ,injection part (3), the injection part (3) with implant the components of a whole that can function independently part of head (2) for supporting use, injection part (3) assembles actuating mechanism (6) including outer tube (5) and with outer tube (5) together, wherein, it is the disposable part to implant head (2) and inject part (3).



D5 discloses the same telescopic arrangement, an outer tube sliding over the inner tube wherein the inner pushing pin remains stationary and when the outer tube is pushed the volume inside is decreased thereby the push pin pushes the lens out through the implant head.”

[Emphasis supplied]

15. The Controller, in the impugned order has considered the motivation for the person skilled in the art to combine the prior arts since D1 and D5 on the premise that the prior art belongs to the same domain and therefore, Controller has concluded that the impugned invention made in the subject application would be obvious for a person skilled in the art (see para 2.7 of this judgement).

16. However, in the impugned order, the Controller fails to identify the person skilled in the art as required under Section 2(1)(ja) of the Act and in



step 1 of the five-step test proposed by the Division Bench of this Court. Further, the impugned order also fails to consider the invention as a whole including the technological advancements achieved by the ‘inventive concept’ of the subject application while comparing the features of the invention claimed in the subject application with relevant prior arts (D1 and D5) as per the Step 2, 4 and 5 of the five-step test proposed by the Division Bench of this Court. Recently a Co-ordinate Bench of this Court in **Crystal Crop. Protection Ltd. v. Safex Chemicals India Ltd.**,⁷ while examining the inventive concept of the invention of the patent therein after referring to the judgments of the English Courts cited therein⁸ observed that to comprehend the inventive concept it would be relevant for the Court to examine what is the problem underlying in the prior arts and how does the patent solve that problem. In the impugned order, the Controller has not identified the inventive concept of the subject application which is the step no. 2 required to be followed as per the Division Bench judgment in **F. Hoffmann-La Roche Ltd. v. Cipla Ltd.** (supra).

The technical advancements sought to be achieved as per the Appellant in the subject application through claimed intraocular lens (IOL) injector, as per the description of the complete specification of the subject application are as follows:

“[0092] Advantages of the IOL injectors described herein include but are not limited to the following. The IOL injectors described herein include a combination push and screw drive that is operable to advance plunger both by pushing and by rotating the plunger. This combination brings

⁷ 2025 SCC OnLine Del 2981

⁸ Edwards v. Meril [2020] EWHC 2562 (Pat)



with it the benefits of a threaded engagement, which adds smoothness and controlled motion throughout the delivery of an IOL out of the IOL injector due to the mechanical transfer of force through the threads. IOL injectors having a threaded engagement typically require the use of two hands during the procedure, which can result in the user having more control during the procedure. The IOL injectors described herein are also compatible with both single handed and two-handed operation due to the ability to advance the plunger by applying an axial force to the plunger.

[0093] The combination push and screw drives described herein provide a solution to generate axial forward motion for an IOL in a smooth and controlled manner. The threads provide a built-in damping as the threads limit a speed with which the IOL can be advanced.

[0094] The IOL injector described herein offers flexibility to the user such that the user is able to choose whether to advance the IOL to the dwell location using an axial push and then advance the IOL to ejection from the IOL injector using either an axial push or a rotation applied to the plunger. This IOL injectors as described herein provide flexibility and are compatible with users who utilize different techniques and skills while operating an IOL injector.”

17. The Controller identified the physical features of the subject application in the impugned order (at para 13 of this judgement). However, the Controller returned a finding regarding lack of inventive step without analysing the assertion of technical advancement/inventive concept in the subject application in light of identified prior arts. The test of inventive step has to be considered keeping in view of the claim of technical advancement/inventive concept set up in the subject application as the Controller would have to return a finding whether the prior arts contain a teaching based on which the person skilled in art will combine the teachings to arrive at the claimed technical advancement/inventive concept achieved by the intraocular lens (IOL) injector claimed herein.



18. In light of the aforesaid observations, with respect to absence of findings by the Controller on the requirements of five step approach prescribed by the Division Bench of this Court, and more specifically step 1 and step 2 therein i.e., identifying relevant person skilled in the art as well as assessment of the inventive concept/technical advancement of the subject application in comparison with that of the prior arts D1 and D5, the impugned order rejecting the patent application on the basis of lack of inventive steps under Section 2(1)(ja) of the Act cannot be sustained.

19. The impugned order is set aside and the subject application is remanded back to the Patent Office for passing a reasoned order by considering all the aspects of the inventive step, especially step 1 as well as step 2 i.e., identification of relevant person skilled in the art and the technical advancement/inventive concept of the subject application as prescribed under Section 2(1)(ja) of the Act and its examination in light of the inventive concept of the prior arts D1 and D5.

20. The appeal is allowed, the impugned order is set aside and the following directions are passed: -

(a) The matter is remanded back to the Patent Office for passing a fresh order after giving a hearing to the Appellant.

(b) The Patent Office shall endeavour to decide the subject application in an expeditious manner, preferably within four [4] months from today.

21. It is made clear that nothing said in this order shall be construed as an expression of opinion on the merits of the subject patent application no. 201914027377 and the same shall be decided in accordance with law.

22. In view of the aforesaid, this appeal stands disposed of.



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23. The Registry is directed to send a copy of the present order to the office of the Controller General of Patents, Designs and Trade Marks at the e-mail - *llc-ipo@gov.in* for compliance.

MANMEET PRITAM SINGH ARORA, J
SEPTEMBER 9, 2025/hp/FV/MG