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

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Date of Decision:29.07.2025+ C.A.(COMM.IPD-PAT) 168/2022
PROPRIETECT L P

.....Appellant

Through: Mr. Ankush Verma, Mr. Debashish
Banerjee, Ms. Vaishali Joshi, Mr.
Pankaj Soni, Mr. Vineet Rohilla, Mr.
Rohit Rangi, Ms. Gurneet Kaur & Mr.
Tanveer Malhotra, Advs.

versus

THE CONTROLLER OF PATENTS

.....Respondent

Through: Ms. Rupali Bandhopadhyia, Mr.
Abhijeet Kumar and Ms. Amisha
Gupta, Advs.**CORAM:****HON'BLE MR. JUSTICE TEJAS KARIA****TEJAS KARIA, J (Oral)****INTRODUCTION**

1. The present Appeal has been filed under Section 117A of the Patents Act, 1970 (“Act”) challenging the Order dated 31.07.2020 (“**Impugned Order**”) passed by the Assistant Controller of Patents and Designs (“**Controller**”) by which the Patent Application No.5706/DELNP/2011 (“**Application**”) was rejected under Sections 2(l)(j), 2(l)(ja), 10(4)(c) and 10(5) of the Act.

FACTUAL MATRIX

2. The Subject Application is titled “*FOAM LAMINATE PRODUCT AND PROCESS FOR PRODUCTION THEREOF*”, and the claimed invention of the Subject Application relates to a foam laminate product for use in the



interior of a vehicle, such as a headliner.

3. The Respondent, issued the First Examination Report (“**FER**”) dated 13.07.2017 and raised objections primarily on the ground of lack of Novelty under Section 2(1)(j) of the Act and lack of Inventive Step under Section 2(1)(ja) of the Act, in view of cited Prior Art documents D1 to D8 filed by the Appellant along with the Subject Application.

4. The timeline of the Subject Application is provided hereinunder:

26.07.2011	Date of filing of the Subject Application by the Appellant.
13.07.2017	Date of issuance of FER by the Respondent.
10.01.2018	Reply to FER filed by the Appellant.
14.06.2019	Issuance of Hearing Notice by the Respondent. Second Hearing Notice issued on 14.08.2019.
12.09.2019	Hearing attended by the Appellant.
12.09.2019	Submission of Written Submissions by the Appellant.
31.07.2020	Impugned Order issued by the Respondent refusing the Subject Application.
27.05.2022	Filing of the present Appeal.

5. Thereafter, the Appellant, *vide* the Reply to the FER dated 10.01.2018 (“**Reply to FER**”), filed a response to the objections raised in the FER along with the amended claims to meet the objections raised.

6. Pursuant to the Reply to FER, the Respondent issued a Hearing Notice dated 14.06.2019 and scheduled a hearing on 12.09.2019, which was duly attended by the Appellant. The Respondent *vide* the Hearing Notice raised objections with respect to the lack of Novelty under Section 2(1)(j) of the Act in the light of Prior Art Documents D1 to D8, and the lack of definitiveness and lack of clarity and conciseness under Section 10(4)(c) of the Act.

7. Thereafter, the Appellant filed its Written Submissions (“**WS**”) along with a further set of Amended Claims on 12.09.2019. The Respondent *issued*



the Impugned Order dated 31.07.2020, refusing the Application under Section 15 of the Act on the grounds that the Application lacks Novelty under Section 2(1)(j), Inventive Step under Section 2(1)(ja), and also fails to fulfil the requirements of Section 10(5) and Section 10(4)(c) of the Act.

8. Being aggrieved by the Impugned Order, the Appellant has preferred the present Appeal under Section 117A of the Act.

SUBMISSION ON THE BEHALF OF APPELLANT

9. The learned Counsel for the Appellant submitted that the Impugned Order rejected the Application on the grounds of lack of Novelty under Section 2(1)(j), Inventive Step under Section 2(1)(ja) and failure to fulfil the requirements of Section 10(5) and Section 10(4)(c) of the Act, however, the objection under Section 10(5) of the Act was not raised by the Respondent at any earlier stage of the proceedings and, therefore, considering this objection for rejecting the Application contravenes the principles of Natural Justice.

10. The learned Counsel for the Appellant submitted that the Impugned Order is a non-speaking Order as the Respondent has failed to address the oral submissions and WS presented by the Appellant and the Respondent has passed a cryptic Order without considering the submissions made by the Appellant. Therefore, the Impugned Order deserves to be set aside, and the matter should be remanded for deciding the Application afresh by the Respondent.

SUBMISSION ON THE BEHALF OF RESPONDENT

11. The learned Counsel for the Respondent submitted that the Prior Art Document D1 discloses implicitly all technical features of the Application and, therefore, in view of D1, the subject matter of claims 1 to 12 does not



meet the requirements of Novelty under Section 2(1)(j) of the Act.

12. The learned Counsel for the Respondent submitted that the Claim Nos. 1 to 12 are obvious to a person skilled in the art in view of the subject matter of the cited Prior Arts and cannot be considered as an Invention under Section 2(1)(ja) of the Act. The subject matter of D1 in combination with the utilisation of laminate products used for automobile headliners that comprise a foam core having a cover layer on its opposed surfaces and a fibrous reinforcement layer, which is encapsulated by a polymer binder / adhesive polymer with respect to D3 to D8.

13. The learned Counsel for the Respondent further submitted that the subject matter of D2 includes the incorporation of fibrous reinforcement layers encapsulated within the polymeric substrate from D1 and their use as automobile headliners from D3 to D8, resulting in Claim Nos. 1 to 12 being obvious.

14. The learned Counsel for the Respondent further submitted that the objections under Sections 10(4)(c) & 10(5), the independently amended Claim No.1 is broad and does not particularly and sufficiently define the Invention with respect to which specific polymers are used, their composition percentages and other technical features. Therefore, the Respondent submits that the Appellant is required to characterise all-essential technical features for which protection is sought under Section 10(4)(c) of the Act.

ANALYSIS AND FINDING

15. The claimed invention is directed to a laminate product comprising a foam core containing a pair of opposed major surfaces and a cover layer secured with respect to each major surface. The cover layer comprises a fibrous reinforcement layer characterised in the fibrous reinforcement layer is



substantially encapsulated by a melted polymer scrim, in which the fibrous reinforcement layer consists of fibre glass and wherein the polymer comprises a polyolefin. The polyolefin is selected from the group consisting of a homopolymer, a copolymer, and a terpolymer derived from the polymerisation of at least one olefin monomer. The invention claimed under the Application relates to a foam laminate product for use in the interior of a vehicle, such as a headliner.

16. The Application was rejected *vide* the Impugned Order on the following grounds:

- i. Lack of Novelty under Section 2(1)(j) of the Act
- ii. Lack of Inventive Step under Section 2(1)(ja) of the Act
- iii. Objections under Sections 10(5) & 10(4)(c) of the Act

17. Under the FER, the objection on the ground of lack of definiteness, clarity, and conciseness was under Section 10(4)(c) of the Act. The objections under Section 10(5) of the Act were not raised. Thereafter, the Appellant filed the amended claims and the number of claims was reduced to 11. *Vide* the Hearing Notice the objection raised under Section 10(4)(c) of the Act in the FER was maintained, but no new objections were raised under Section 10(5) of the Act. On the contrary, the learned Controller, in the Impugned Order, has raised a new objection under Section 10(5) of the Act, which was not raised earlier with respect to the Application. The relevant paragraph of the Impugned Order is reproduced hereinunder:

*“The hearing under section 14 of the Act was held to give an opportunity to the applicant to comply the objections of FER and Objections communicated in Hearing Notice but applicant has failed to do so as concluded in above para hence considered as not met the requirements of the Patents Act, under section 2(1)(ja), **section 10(5)** and section 10(4)(c) therefore Controller is satisfied that the application, specification and other documents filed in pursuance thereof does not comply with the requirements of sections of Patents Act 1970.*”



[*Emphasis supplied*]

18. The question arises whether the learned Controller can raise any new ground in the final Order if they are not raised earlier? The coordinate bench of this Court in ***Perkinelmer Health Sciences Inc.and Ors vs Controller Of Patents***, 2023 SCC OnLine Del 8590 has held that the learned Controller cannot raise new grounds during the hearing as it does not provide sufficient opportunity to the Applicant to contest the same. The relevant extract is reproduced hereinunder :

“7. The hearing notice dated 12th February, 2018 makes no mention of objection under Section 3(f). Appellant ought to have been made aware of all grounds of objection before the hearing and afforded sufficient opportunity to contest the same at the time of hearing. It was incumbent upon Respondent to have raised this objection in the notice of hearing itself. Albeit the Appellant had submitted written submissions subsequent to the hearing and not given any response qua Section 3(f) of the Act, that does not absolve the Respondent of its obligations under the Circular to communicate objections prior to the hearing and provide reasonable opportunity to the applicant/ Appellant. Objection under Section 3(f) of the Act has ex-facie been raised for the first time at hearing stage as is apparent from afore- extracted portion of the impugned order. There is thus merit in the submission of Mr. Banerjee that Respondent has violated the principles of natural justice.”

19. Therefore, raising new grounds in the Hearing Notice or, as in this case, in the final Order is not permissible as it does not provide a reasonable opportunity to the applicant to be heard.

20. Furthermore, the Appellant, after the hearing was concluded, filed a WS with the Amended Claims. Claim No. 1, which was considered by the learned Controller in the Hearing Notice, was submitted in the Reply to FER. The Amended Claim No. 1 that was submitted in response to FER is as follows:

“We Claim:

1. A laminate product comprising a foam core having a pair of opposed



*majorsurfaces and a cover layer secured with respect to each major surface, the coverlayer comprising a fibrous reinforcement layer characterized in that the fibrousreinforcement layer is substantially encapsulated by a melted polymer scrim, the laminate product having an air flow resistance as measured in accordance withASTM C522 of less than 6000 Pa * s/m (6,000 mks Rayls).”*

21. Thereafter, to overcome the objections raised in the Hearing Notice, the Appellant again amended the Claims, including Claim No. 1 in the WS submitted after the hearing had happened. The Amended Claim No. 1 in the WS submitted after the hearing was attended is as follows:

“WE CLAIM:

*1. A laminate product comprising a foam core having a pair of opposed majorsurfaces and a cover layer secured with respect to each major surface, the coverlayer comprising a fibrous reinforcement layer characterized in that the fibrousreinforcement layer is substantially encapsulated by a melted polymer scrim,wherein the fibrous reinforcement layer comprises fiberglass and wherein the polymer comprises a polyolefin, the polyolefin being selected from the groupconsisting of a homopolymer, a copolymer, and a terpolymer derived from thepolymerization of at least one olefin monomer, the laminate product having an airflow resistance as measured in accordance with ASTM C522 of less than 6000 Pa * s/m (6,000 mks Rayls). of the said section.*

[Emphasis supplied]”

22. *Vide* the Impugned Order, the Respondent has reproduced the objection on the ground of Section 10(4)(c) of the Act. Verbatim from the Hearing Notice is reproduced hereinunder:

“The independent amended claim 1 is very broad and does not particularly and sufficientlydefine the invention with respect to the specific polymers used, composition percentages andother technical features. Therefore it is required to characterize the all essential technicalfeatures for which protection is sought but failed to comply with requirements of 10(4)(c) ofThe Patents Act, 1970.”

23. In respect of Claim No. 1, no further reasoning has been provided in the Impugned Order. The learned Controller has neither considered the claims filed in the Reply to FER nor considered the amended claims filed in WS by



the Appellant after the hearing. Furthermore, the later Amended Claim No. 1 introduces new specific elements to the Original Claim No. 1, thereby further clarifying the scope of the invention as compared to the Original Claim No. 1. The layers and surfaces have been specifically defined in the later Amended Claims, along with the materials used in the formation of said layers / surfaces. The characteristics of the claimed laminate product that may represent an advancement over the art and, therefore, the objections raised in the earlier submitted claims, i.e., the objections raised in the Hearing Notice, may not apply to the Amended Claims as submitted in the WS after the hearing.

24. The coordinate bench of this Court in ***Boehringer Ingelheim VetmedicaGmbh vs The Controller of Patents*** 2024 SCC OnLine Del 8578 observed that the Controller had passed the impugned order without going into the explanations / justifications offered by the Applicant, and the impugned order has also substantially reproduced the contents of the Hearing Notice. Accordingly, the Court set aside the impugned order, and the matter was remanded back to the patent office. The relevant paragraphs of the judgment are reproduced hereinunder:

“9. Despite the above submissions seeking to distinguish the prior arts from the subject invention, the impugned order has been passed without going into the explanation/justification offered on behalf of the appellant with regard to the prior arts. The impugned order, in a blanket manner, concludes that the arguments made by the appellant in written submissions or on the date of oral hearing are "not fully persuasive" without giving any justification for the same.

10. As noted above, the impugned order has substantially reproduced the contents of the hearing notice. In the judgment passed in Huhtamaki OYJ and Anr. v. Controller of Patents, 2023 SCC OnLine Del 3272, this Court had expressed concerns about the tendency in the Office of Controller of Patents and Designs to reject patent applications by relying on the objections issued to the applicant without considering the submissions of the applicant filed in response thereto.”



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25. By raising a new ground i.e. objection under Section 10(5) of the Act, in the final Order, the Respondent has not given sufficient opportunity to the Appellant to present its case. Additionally, by passing the Impugned Order without considering the explanations / justifications offered by the Applicant, it vitiates the process followed by the Respondent. Accordingly, the Impugned Order is liable to be set aside, and the matter is required to be remanded back to the learned Controller for a de-novo consideration.

26. Accordingly, the Impugned Order is hereby set aside and the learned Controller shall afford a fresh opportunity of hearing to the Appellant before deciding the Application after giving a Hearing Notice to the Appellant and considering all the oral and written submissions of the Appellant. The learned Controller shall decide the Application as expeditiously as possible and preferably within a period of six months from the date of receipt of this order.

27. It is clarified that the above observations do not reflect any opinion on the merits of this Appeal. The Appeal is allowed in the aforesaid terms.

TEJAS KARIA, J

JULY 29, 2025/ 'K'