



2025:DHC:1233



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

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Date of decision: 18th February, 2025

+ C.A.(COMM.IPD-PAT) 48/2022

VGX PHARMACEUTICALS INCAppellant

Through: Mr. Adarsh Ramanujan, Ms. Krishna
Sarma, Ms. Manisha Singh, Ms.
Rajashree Sharma, Ms. Kameshwari
Sridhur and Mr. Shubhankar Gupta,
Advocates.

versus

THE CONTROLLER GENERAL OF PATENTS,
DESIGNS AND TRADEMARKS

.....Respondent

Through: Mr. P.S. Singh, CGSC with Ms. Annu
Singh and Mr. Rohit Singh Lodhi,
Advocates.**CORAM:****HON'BLE MR. JUSTICE AMIT BANSAL****AMIT BANSAL, J. (Oral)**

1. The present appeal has been filed under Section 117A of the Patents Act, 1970 against the order dated 9th December, 2019 (hereinafter 'impugned order') passed by the Assistant Controller of Patents and Designs (hereinafter 'Assistant Controller'), whereby the patent application bearing no. 2366/DELNP/2009 titled 'ELECTROPORATION DEVICES AND METHODS OF USING SAME FOR ELECTROPORATION OF CELLS IN MAMMALS' (hereinafter 'subject application') has been refused.



2. The present appeal was filed before the erstwhile Intellectual Property Appellate Board (hereinafter 'IPAB'). Pursuant to the abolition of IPAB in terms of the Tribunal Reforms (Rationalisation and Conditions of Service) Ordinance, 2021, the present appeal has been transferred to this Court.

3. Brief facts relevant to decide the present appeal are as follows:

3.1. The appellant filed the subject application at the Patent Office, New Delhi on 13th April, 2009. The subject application is based out of PCT international application bearing no. PCT/US2007/022139 having international filing date 17th October, 2007 and claims priority from US 60/852,149 dated 17th October, 2006 and US 60/978,982 dated 10th October, 2007.

3.2. A request for examination was filed at the Patent Office on 7th October, 2010. The Patent Office *vide* its letter dated 20th December, 2016 issued First Examination Report (hereinafter 'FER').

3.3. The objections raised in the FER pertained to lack of novelty and inventive step in view of the disclosures made in three documents, which are as under:

- i. D1 : US2002010414 A1
- ii. D2 : US2006015147 A
- iii. D3 : US6148232A

3.4. The appellant, through its authorized agent, on 19th June, 2017, filed its detailed reply to the aforesaid FER along with relevant documents including the amended claims.

3.5. A hearing notice was issued by the Patent Office on 23rd August, 2019 which raised various objections including the objection pertaining to lack of



inventive step. The prior arts cited in the hearing notice with regard to lack of inventive step are being reproduced hereunder:

- i. D1 : US2002010414A1
- ii. D2 : US2006015147A1
- iii. D3 : US6148232A
- iv. D4 : WO2005025669
- v. D5 : WO0107583

3.6. The hearing took place on 14th October, 2019. Subsequent to the hearing, written submissions and accompanying documents were filed by the appellant on 29th October, 2019.

4. The impugned order was passed by the Assistant Controller refusing the subject application. The relevant extracts from the impugned order are set out below:

“9. Now, I consider the cited documents viz. D4:WO2005025669, D5:WO0107583 as mentioned in the said hearing notice. It is noted the document has publication date prior to the priority of the instant application.

Here, the instant application differentiates from existing prior arts as: the electroporation component is configured to deliver the pulse of energy through the plurality of skin electrodes to produce the constant current in the desired tissue; at least one of the plurality of skin electrodes is neutral during delivery of the pulse of energy and measures impedance in the desired tissue and communicates said impedance to the electroporation component; and the feedback mechanism can receive the measured impedance and can adjust the pulse of energy delivered by the electroporation component to maintain the constant current in the desired tissue.

Which is well being disclosed by the cited documents D4 in paragraphs 73, 75-77 figure 1 and D5 in page 19, Lines 1-3, figure 7.

10.

11. Therefore, after duly considering the extensive hearing submissions, the cited and existing case laws and anticipation of prior documents



referenced above,

1. The subject matter of claim 1 is not inventive as, at the time of the alleged invention, it would have been obvious to a person skilled in the art to arrive at the said claimed features of the alleged invention in the light of document D4, D5 and common general knowledge. Therefore, subject matter as claimed in claim 1 is not inventive and as such does not constitute an invention u/s 2(1)(j) of The Patent Act, 1970 (as amended).

.....

12. Therefore, in view of the aforesaid, it is concluded that the subject matter of claims 1 through 5 in this instant application lacks inventive step. As such, the substantive objection in heading “Invention u/s 2(1)(j), Para 2” of the said hearing notice still holds good. Therefore, the claimed subject does not constitute an ‘Invention’ as defined under section 2(1)(j) of The Patents Act, 1970 (as amended).”

[Emphasis supplied]

5. Mr. Adarsh Ramanujan, counsel appearing on behalf of the appellant, submits that the subject application was refused on the basis of prior arts D4 and D5 mentioned above. He submits that an objection with reference to the aforesaid prior arts D4 and D5 was raised for the first time in the hearing notice dated 23rd August, 2019 and no reasoning as to the relevance of the aforesaid prior arts was put forth in the said hearing notice.

6. Mr. Ramanujan further submits that impugned order is completely unreasoned and does not give any basis for refusing the subject application or as to how the subject application is covered by the prior arts D4 and D5.

7. I have heard the counsel for the parties and perused the material on record.

8. The record of the case bears out that an objection with regard to prior arts D4 and D5 was not taken by the respondent in the FER. The said prior arts and documents were referred to for the first time only in the hearing notice



dated 23rd August, 2019.

9. A perusal of the aforesaid hearing notice would show that while the Assistant Controller has given the relevance of prior arts D1, D2 and D3 with regard to the subject application, no basis or reasoning has been given to justify the objection pertaining to lack of inventive step in view of the prior arts D4 and D5.

10. On the other hand, in the impugned order passed by the Assistant Controller, there is no mention of the prior art documents D1, D2 and D3 at all, which were relied upon in the hearing notice. However, the subject application has been refused placing reliance on the prior art documents D4 and D5.

11. As is evident from the impugned order, the only reasoning provided by the Assistant Controller to refuse the subject application was that the claim 1 therein is not inventive as *'it would have been obvious to a person skilled in the art to arrive at the said claimed features of the alleged invention in the light of document D4, D5 and common general knowledge'* and consequently dependent claims 2 to 5 therein involve no inventive step as they are also covered within the scope of the independent claim 1.

12. While reliance in the impugned order has been placed on prior arts D4 and D5, neither any reasoning nor any justification has been given as to how the aforesaid prior arts would cover the subject invention. The impugned order also does not provide any linkage between the subject application for the aforesaid invention and the prior art documents D4 and D5 so as to make out a case for lack of inventive step.

13. A reference may be made to the judgment of a Coordinate Bench of



this Court in *Agriboard International LLC v. Deputy Controller of Patents and Designs*, 2022 SCC OnLine Del 940, the relevant extract of which is set out below:

24. *In the opinion of this Court, while rejecting an invention for lack of inventive step, the Controller has to consider three elements-*

- *the invention disclosed in the prior art,*
- *the invention disclosed in the application under consideration, and*
- *the manner in which subject invention would be obvious to a person skilled in the art.*

25. *Without a discussion on these three elements, arriving at a bare conclusion that the subject invention is lacking inventive step would not be permissible, unless it is a case where the same is absolutely clear. Section 2(1)(ja) of the Act defines „inventive step“ as under:*

(ja) “inventive step” means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.

26. **Thus, the Controller has to analyse as to what is the existing knowledge and how the person skilled in the art would move from the existing knowledge to the subject invention, captured in the application under consideration. Without such an analysis, the rejection of the patent application under Section 2(1)(ja) of the Act would be contrary to the provision itself.** *The remaining prior arts which are cited by Id. Counsel having not been considered in the impugned order, the Court does not wish to render any opinion in this regard.”*

[emphasis supplied]

14. The impugned order, in a blanket manner and without giving any justification, concludes that the hearing submissions do not address the substantive requirement of Section 2(1)(j) of the Patents Act, 1970 and refuses grant of patent in the subject application. The impugned order is completely unreasoned and has been passed in a cryptic manner by the Assistant Controller.

15. Accordingly, the appeal is allowed and the following directions are passed:

- i) The impugned order is set aside and the matter is remanded back to



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the Patent Office for a fresh consideration.

- ii) Prior to deciding the matter afresh, the Assistant Controller shall issue a fresh hearing notice clearly delineating the objections regarding inventive step addressing prior arts D4 and D5.
- iii) The applicant shall have the liberty to file fresh written submissions with amended claims.
- iv) Considering that the subject application was filed in 2009, the Patent Office shall endeavour to decide the subject application in an expeditious manner, preferably within three (3) months from today.

16. The appeal stands disposed of in the aforesaid terms.

17. The Registry is directed to supply a copy of the present order to the Office of the Controller General of Patents, Designs & Trade Marks on the e-mail ID – llc-ipo@gov.in, for compliance.

AMIT BANSAL, J

FEBRUARY 18, 2025

Vivek/-