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

**Date of Decision: 02<sup>nd</sup> May, 2023**

+ **C.A.(COMM.IPD-PAT) 114/2022**

TITAN UMREIFUNGSTECHNIK GMBH AND CO. KG

..... Appellant

Through: Ms. Neha Chugh and Ms. Purva Chugh, Advocates.

versus

ASSISTANT CONTROLLER OF PATENTS AND DESIGNS AND ANR

..... Respondents

Through: Mr. Nitinjya Chaudhary, Senior Panel Counsel.

**CORAM:**

**HON'BLE MR. JUSTICE SANJEEV NARULA**

**JUDGMENT**

**SANJEEV NARULA, J. (Oral):**

1. The Appellant filed patent application No. 7529/DELNP/2014 as a national phase application arising from PCT application No. PCT/EP2012/069237 dated 28<sup>th</sup> September, 2012, for invention titled “Plastics Material Strapping Band and Method for Producing a Plastics Material Strapping Band” [*hereinafter*, “*subject application*”]. The subject application derives priority from a German patent application No. DE 102012102155.4 dated 14<sup>th</sup> March, 2012.

2. The Assistant Controller of Patents and Designs [*hereinafter*, “*Controller*”], *vide* order dated 20<sup>th</sup> July, 2020, refused the subject



application under Section 15 of the Patents Act, 1970 for non-fulfilment of requirements under Section 2(1)(ja) and Section 10(4) of the said Act [hereinafter, “impugned order”]. The reasoning for this conclusion is as under:

**“Analysis:-**

*The invention relates to plastic strapping for wrapping around one or several objects.*

*D1 discloses boxing or packaging of individual articles or a plurality of articles and, more particularly, to an improved packaging method in which the package is first formed by means of a relatively thin or lightweight or structurally inadequate wrapper and is thereafter coated either in local areas or overall with a resinous substance either with or without fibrous reinforcement for the purpose of imparting the desired strength, tear resistance and wear resistance to the package so that it can be handled thereafter and stored or shipped without disruption or breakage of the contents of the package.*

*D2 discloses polyester strapping made from polyester and less than 3% by weight of a polyolefin additive exhibits improved resistance to longitudinal splitting when the strapping is later placed under tension in packaging reinforcement applications. The polyolefin improves the longitudinal split resistance of the strapping without facilitating the unwanted longitudinal stretch of the polyester strapping when under tension. The polyolefin additive may be combined with other conventional additives or may be used alone in order to minimize costs.*

*Therefore, from the teachings of the combination of prior art documents D1-D2, it would have been obvious to the person skilled in the art to provide an alternative plastic wrapping material with components mentioned in the application (Altering ranges are obvious to a person skilled in the art) of without any inventive skills.*

*Therefore, the subject matter of the claims 1-10 lack inventive step under section 2(1)(ja) of the Patents Act.*

**Order:**

*In view of the above facts and on the circumstances of the case, the undersigned is of the opinion that the application filed in pursuance thereof, does not comply with the requirements of section 2(1)(ja) and section 10(4) of the Patents Act, 1970. Hence, the application no. 7529/DELNP/2014 is refused u/s 15 of the Patents Act, 1970.”*

3. The Court has heard the counsel and perused the record.



*Re: Objection under Section 10(4) of the Patents Act*

4. The impugned order is bereft of any reasoning for refusal of the subject application under Section 10(4) of the Patents Act. The basis for rejection on this ground is only discernible from the objection raised in the second Hearing Notice dated 11<sup>th</sup> May, 2020, which is as follows:

*“Definitiveness*

1. *Section 10(4) of The Patents Act, 1970.*

*The phrase ‘one or more articles’ in the principle claim is not defined to what does it relate and therefore the claim remains unclear.*

*Words such as up to approximately are vague and unclear.*

*The claims need to be supported with the description by the way of working examples.”*

5. In their primary claim 1, Appellant has defined the weight of the constituent elements of the plastic strapping band as approximately 90% of polyester, 1% to 5% of polyolefin and 5% to 10% of fibre material. As per the Controller, this claim is vague as it only mentions an approximate value. The ratios/ ranges in the complete specification use the expressions ‘upto’, ‘about’ and ‘approximately’, instead of clearly identifying the specific quantity. Hence, he holds the claims to be non-specific and hit by Section 10(4) of the Patents Act. This objection is however, misconceived. The Appellant, while submitting the complete specification, sufficiently explained the rationale for using approximate values to signify the proportions of constituent elements. Appellant explained that ‘about’ in the weight specification conveys that determination of individual components is typically done with the help of differential scanning calorimetry. Further, dynamic differential calorimetry is associated with systemic uncertainties in determining the respective weight proportion, which is expressed by ‘about’.



The range of maximum length of the fibres of fibrous material used in the strapping material, specified by Appellant, has been decided taking into consideration the ease with which fibres can be embedded in the plastic material. Polyolefin ensures sturdier link between the polymer chains in the plastic strapping band. Thus, more the percentage of polyolefin, stronger is the link. However, 5% by weight of polyolefin has been capped as the upper limit by the Appellant in the complete specification for the desired effect. In order to improve the rigidity of the plastic strapping band, the range of 5-10% for polyolefin has been mentioned. On the proportion/ percentage of weight of polyester, Appellant clarified that due to the addition of fibrous material, higher percentages of polyester are not necessary. As regards use of phrase “one or more articles” in the claim specification, Appellant had explained that the subject application relates to a plastic strapping band used for wrapping around ‘one or more articles’ so as to combine, stabilise and hold the articles and that this phrase is commonly used in the packaging industry. Similarly worded claim specifications have been accepted and patent has been granted to the Appellant for the same invention in the European Union, Australia, Canada and the United States.

6. None of the above factors have been dealt with by the Controller in the impugned order. Therefore, refusal of the subject application under Section 10(4) of the Patents Act is unreasoned and unsustainable.

Re: Lack of working examples

7. An additional objection against the subject application is the absence of working examples to substantiate the claims made to enable assessment



of the required ranges for achieving the desired results. Mr. Nitinja Chaudhary, counsel for Respondents, argues that the subject application must contain examples/ drawings, irrespective of the nature of invention by placing reliance on clause 05.03.09 of the Manual of Patent Office Practice and Procedure dated 26<sup>th</sup> November, 2019, to buttress his submission. The said clause *inter alia* provides as under:

*“a) Description of an invention is required to be furnished in sufficient detail so as to give a complete picture of the invention and follows the Summary of invention. The nature of improvements or modifications effected with respect to the prior art should be clearly and sufficiently described. It may include examples/drawings or both for clearly describing and ascertaining the nature of invention. Examples must be included in the description, especially in the case of chemical related inventions.”*

8. The Court is however, not convinced by Mr. Chaudhary’s submission. Clause 05.03.09 of the Patents Manual provides that the invention must be described in sufficient detail so as to give a complete picture of the invention and for this purpose, an applicant may include examples or drawings in the specification. While assessing the sufficiency of disclosure, it must be ensured that the best method for performing the invention known to the applicant is described. The primary requirement is that the application includes a clear and complete description of the invention, its operation, use and method by which it is performed so that a person skilled in the relevant field can reproduce the invention based on the description in the application. The examples and drawings assist the Patent Office to ascertain the nature of invention. However, the question before Court is whether this condition is to be mandatorily followed in all applications. As pointed out by Ms. Neha Chugh, counsel for Appellant, there is no mandatory requirement to provide examples for non-chemical related inventions. The clause extracted above



stipulates furnishing of working examples as an essential condition only in case of chemical related inventions. Thus, although working examples can be beneficial in assessing the patentability of an application, they are not strictly necessary. Therefore, the Controller's reliance on Clause 05.03.09 of the Patents Manual is flawed as Appellant's invention is not a chemical related invention. Indeed, a patent application can be refused if the invention is not sufficiently disclosed in the complete specification and in order to satisfy himself, the Controller could have asked the Appellant to prove that description in their claims is supported with workings; however, mere absence of working examples does not render the subject application liable for rejection. As per Section 10(4)(b) of the Patents Act, an applicant is required to disclose the best method of performing the invention known to them for which they are claiming monopoly. This requirement was fulfilled as the Appellant cited the best method of performing the invention in the complete specification. Instead of analysing the same, the Controller insisted on working examples in support of subject application and summarily rejected the claimed invention on the ground of Section 10(4) of the Patents Act, without elaborating on the reasons for arriving at such a conclusion. Therefore, refusal on this count is also not sustainable.

*Re: Objection under Section 2(1)(ja) of the Patents Act*

9. Insofar as the objection under Section 2(1)(ja) of the Patents Act is concerned, the Controller concluded that in view of the teachings in D1 and D2, it would be obvious to the persons skilled in the art to provide an alternative plastic wrapping material with components mentioned in the application. The Controller held that the Appellant has failed to demonstrate



any technical advancement in comparison to the closest prior arts. This objection also does not find favour with the Court as the two cited prior arts, referred to as D1 and D2, propose significantly different teachings. D1 pertains to a method of packaging articles using a thin and lightweight wrapper, which is then coated with a resinous substance, potentially reinforced with fibres, to achieve the desired strength and resistance to wear and tear. On the other hand, D2 discusses the production of polyester strapping with the addition of a polyolefin component, providing enhanced resistance to longitudinal splitting when the strapping is subjected to tension in packaging reinforcement applications. Therefore, the combination of aspects/ features of the cited arts by the Controller seems arbitrary or forced. Both D1 and D2 address different problems, and thus, it would not be plausible for a person skilled in the art to realistically combine the teachings of the referenced prior art. It was inappropriate for the Controller to combine or 'mosaic' two substantially unrelated prior arts in order to invalidate the Appellant's claim.

10. That apart, in the reply to the Hearing Notice dated 17<sup>th</sup> June, 2020 the Appellant distinguished the cited prior arts from subject application in following terms:

*“With regard to document D1, the Applicant humbly submits that the said document does not show a plastic strapping band as such. It talks about an invention related to boxing or packaging of article(s). The package is first formed by means of a relatively thin/light weight wrapper and then is coated with a resinous substance. Indeed document D1 first uses a thin inexpensive wrapper made from ordinary kraft paper or the like as disclosed in column 2, lines 37 to 40. This thin wrapper which is not necessarily made from plastics is then completed by coating with a resinous substance as disclosed in column 2, lines 45 to 55.*

*Even if one assumes that the preliminary wrapping is made from plastic foils and the wrapped goods or articles are not covered in total as described in column 2,*



*lines 46 to 50, one has to realize that a plastic strapping band as such ready for wrapping is not disclosed in document D1 because the thin wrapper has to be reinforced. The reinforcement is achieved by coating the thin and first wrapper with a resinous substance.*

*In column 3, lines 1 to 37, it is disclosed in detail how the coating with the resinous substance takes place. Indeed the coating is applied by spraying as column 3, line 1 teaches. This spraying can be done by using thermoplastic resins alone, i.e. without adding additional fibers. Therefore, there is no clear hint in document D1 to imperatively use fibers. Rather, the use of fibers is optional.*

*Even if fibers are used and one looks at the coated kraft paper as being a plastics strapping band according to the invention it is clear that the specifically requested content of the fibers inside the plastics strapping band in the content of approximately 5% by weight up to 10% by weight in maximum is neither disclosed in document D1 nor rendered obvious. Because column 3 (lines 28 to 36) describes the known practice using a double nozzle spray gun with one nozzle spraying the resinous coating and the other spraying the fibers for reinforcing the said coating. Due to this procedure one can expect that the content of a resinous coating and the fibers is approximately 50% each. It is totally unusual that when using a double nozzle spray gun that the different sprayed elements form a coating where one element is present in approximately 90% by weight and the other element only in 10% by weight in maximum. This can only be achieved when using for example nozzles with a diameter which is for example 9 times as high concerning the resinous coating compared with the nozzle diameters used for the fibers. Document D1 does not give any hint to such an assumption.*

*In contrast the double nozzle spray gun as such leads to the only conclusion that the resinous material and the fibers are balanced in the coating. This however is in contrast to what is claimed in the invention.*

*With regard to document D2, the Applicant humbly submits that the said document discloses a strapping with the exception of the fiber material and its content. As already outlined in the past, the content of the fibers inside the plastics strapping band is critical. On the one hand the content of the fibers has to be sufficient in order to observe the desired effect of reinforcement at all. On the other hand, the content may not be too high. Otherwise it is not possible to stretch the plastics strapping band in order to realize the desired strength. This is described in detail in paragraph 2 on page 5 of the complete specification of the instant application (corresponding to paragraph 16 of the European patent specification EP 2 658 790). Additionally, last second paragraph on page 6 of the complete application explains why the content of 10% per weight of the fibers has to be recognized in order to allow the stretching of the plastics strapping band due to the necessary mobility of the fibers inside the resinous material.”*

11. Appellant’s invention relates to a plastic material strapping band used for wrapping one or more articles. This plastic band is constituted of



polyester, polyolefin and fibre material. In contrast, D1 uses a thin layer/wrapper and does not talk about a plastic band for wrapping of material. D1 suggests use of an inexpensive wrapper, which is not necessarily made of plastic (as is the case with Appellant's invention) and thereafter, this wrapper has to be reinforced with resinous substance. There is merit in Ms. Chugh's contention that even if one were to assume that the preliminary wrapping is made from plastic foil and the wrapped goods and articles are not covered, D1 still does not disclose the plastic strapping band for wrapping because the thin wrapper has to be reinforced. As regards D2, it has been explained that the invention in question has quantified the content of fibre material in the plastic strapping band, which gives the desired tensile strength to the plastic strapping band by permitting stretching of the band. This aspect has not been discussed in D2. The objections relating to D1 and D2 raised in the second Hearing Notice dated 11<sup>th</sup> May, 2020 has been verbatim reproduced in the impugned order, without referring to afore-noted response of the Appellant. There is no discussion as to how the teachings of the combination of D1 and D2 would be obvious to a person skilled in the art, who would foresee altering of ranges to achieve the Appellant's invention.

12. For the foregoing reasons, the present appeal is allowed with the following directions:

- (i) Impugned order dated 20<sup>th</sup> July, 2020, is set aside.
- (ii) The matter is remanded back to the Controller, who shall, within a period of three months from the release of this order, reassess the detailed specifications pertaining to the subject application and decide the same



afresh, keeping in mind the observations made hereinabove.

13. With the above directions, the appeal is disposed of.

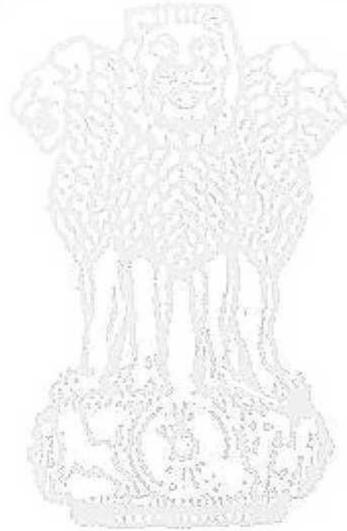
**SANJEEV NARULA, J**

**MAY 02, 2023**

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*(Corrected and released on 29<sup>th</sup> May, 2023)*

HIGH COURT OF DELHI



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