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

Date of decision: 11<sup>th</sup> September, 2025

+ C.A.(COMM.IPD-PAT) 14/2024

OXULAR LIMITED

.....Appellant

Through: Ms. Vindhya S. Mani and Ms. Naina Gupta, Advocates (Through VC)

versus

THE ASSISTANT CONTROLLER OF PATENTS AND DESIGNS

.....Respondent

Through: Mr. Nishant Gautam, CGSC with Mr. Vardhman Kaushik, Mr. Shaurya Mani Pandey Mr. Prithvi Raj Dey and Ms. Srijita Koley, 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 (2) of the Patents Act, 1970 [‘the Act’] against the impugned order dated 09.01.2024 passed by the Assistant Controller of Patents and Designs, whereby the patent application bearing number 201817034819, and titled “*OPHTHALMIC DELIVERY DEVICE AND OPTHALMIC DRUG COMPOSITIONS*” [‘subject application’] has been refused.

2. Brief facts leading to filing of the present appeal are that the



appellant/applicant filed the subject application at the Patent Office, New Delhi on 14.09.2018 through its authorised Patent Agent.

3. The request for examination was filed at the Patent Office on 13.03.2020, which was within the 48 months' period from the date of priority. The Patent Office issued First Examination Report ['FER'] on 27.08.2020. The relevant objections raised in the said FER are as under: -

a) The claims 1-31 are not novel under Section 2(1)(j) of the Act in view of the following documents:

- i) D1: WO 2013/028936 A1
- ii) D2: US2011/238075 A1
- iii) D3: WO2016/042162 A1
- iv) D4: WO2016/042163 A2

b) The subject matter of claims 1-31 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 D4: -

c) The subject matter of the invention claimed in claims 1-31 falls within scope of Section 3 (d) of the Act, and is, hence, not patentable.

d) The subject matter of claims 1-31 does not fulfil requirement under Section 10 (5) of the Act.

4. The applicant/appellant through its authorized agent on 18.02.2021, duly filed its reply to said FER along with the amended claims 1-26.

5. A hearing notice was issued by the Patent Office on 02.08.2023. However, after several adjournments, the hearing happened on 31.10.2023 based on re-issued hearing notice dated 18.09.2023. The relevant objections outstanding in the hearing notice were as follows: -

- i) The two independent apparatus claims (claims 1 and 2) lack



conciseness;

ii) Subject matter of the amended claims 1-26 does not constitute an invention under Section 2(1)(j) of the Act for lack of novelty in view of the following prior arts:

- a) D1: WO 2013/028936 A1
- b) D2: US 2011/238075 A1
- c) D3: WO 2016/042162 A1
- d) D4: WO 2016/042163 A1
- e) D5: WO 2009/089409A2
- f) D6: WO 2012/051575 A2

iii) Subject matter of amended claims 1-26 does not constitute an inventive step under Section 2(1)(ja) of the Act for being obvious in view of the afore-cited prior arts D1 to D6.

6. After hearing, the appellant filed its written submissions on 15.12.2023 along with amended claims 1-26.

7. Thereafter, impugned order was passed by the Assistant Controller refusing the subject application under Section 15 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 below: -

**“Thus, a person having knowledge of D1 is aware of use of flexible cannula deployed from a needle that penetrates the sclera to deploy the cannula to the suprachoroidal space or supraciliary space of human eye without any concern.**

Similarly, D1-D4 and D6 also teaches about the delivery of active agent containing composition into the **suprachoroidal space or supraciliary space** of human eye.

Thus, a person skilled in the art has sufficient motivation of using



**flexible cannula deployed from a needle that penetrates the sclera to deploy the cannula to the suprachoroidal space or supraciliary space** of human eye over the flexible or non-flexible cannula as disclosed in D1 in combination of teaching of D1-D4 and D6. Further, it may be noted that selection of liquid, or semi-solid composition, round shape of cannula etc is routine selection for a person skilled in art and does not involve any inventive skill.

Hence, argument submitted by the applicant regarding the use of **flexible cannula deployed from a needle that penetrates the sclera to deploy the cannula to the suprachoroidal space or supraciliary space** of human eye is not found to involve any inventive skill. Hence, claims 1-26, do not meet the requirement of section 2(1)(ja) of the Patents Act, 1970.

[Emphasis Supplied]

8. Ms. Vindhya S. Mani, learned counsel appearing on behalf of the appellant, submits that the Respondent had failed to appreciate the written submissions dated 15.12.2023 filed by the appellant in response to the hearing notice by the Respondent.

8.1. She states that the Respondent has not considered the distinguishing feature of the subject application, i.e., the self-actuated deployment mechanism of the device in comparison with prior arts D1 to D6. She further states that the Controller has failed to demonstrate that how it is obvious for a person skilled in the art to reach subject invention, i.e., self-actuating deployment mechanism regardless of the thickness of the overlying sclera or the orientation and speed of the needle insertion; whether examined independently or in combination. She also argued that the Respondent has also not applied five steps test to examine inventive step laid down in the case of **F. Hoffmann- La Roche Ltd & Anr. vs. Cipla Ltd. ((2016) 65 PTC 1 (DB))** or as prescribed under **Agriboard International LLC v.**



**Deputy Controller of Patents & Designs (2022 SCC OnLine Del 4786).**

9. She states that the contents of the impugned order [at pages 126-127 of the paper-book] is a reproduction of Claim 1 of the EP claims dated 01.02.2021 and Figure 2 referred to in the impugned order is also from the corresponding EP application. She states that however the Controller failed to take into consideration that Petitioner has already been granted Patent by the European Patent office. She states that the impugned order appears to have been collated to a process of copying and pasting significant portions from various sources and bereft of any substantive reasoning.

10. In response, 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. Further, he relied upon the written submissions filed in the present appeal.

11. This Court has heard the counsel for the parties.

12. A perusal of the impugned order would show that the subject application has been refused on the ground of lack of inventive step as per Section 2(1)(ja) of the Act.

13. It is clear from the impugned order that the Respondent has gone on to discuss prior arts and decided on the obviousness of the subject invention based on them. However, in the impugned order Respondent has failed to consider the detailed arguments dated 05.12.2023 submitted by the appellant in response to the hearing notice issued by the Respondent. Moreover, the Respondent has failed to satisfy the Court that they have applied tests approved in **F. Hoffmann- La Roche Ltd & Anr. vs. Cipla Ltd. (Supra)** or in **Agriboard International LLC v. Deputy Controller of Patents &**



**Designs (supra).** For clarity, the said tests are reproduced hereinbelow:

13.1 The test prescribed in **F. Hoffmann- La Roche Ltd & Anr. vs. Cipla Ltd. (Supra)** is:

“151. From the decisions noted above to determine obviousness/lack of inventive steps the following inquiries are required to be conducted:

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 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 hideshow approach.”

13.2 The test prescribed in **Agriboard International LLC v. Deputy Controller of Patents & Designs (supra)** is as 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.”

14. In the considered opinion of this Court, the impugned order fails to



deal with the submissions dated 05.12.2023 of the Appellant on the objections raised in the hearing notice and record reasons for its conclusions; thus, meriting a remand as prayed for by the Appellant. 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**<sup>1</sup>. The relevant extracts of the said judgment are reproduced as under: -

“22. The Supreme Court in **Assistant Commissioner v. Shukla and Brothers (supra)**, has categorically held that passing of a reasoned and a speaking order is an integral part of the principle of audi alteram partem. The relevant paragraph reads as under:

“9. The increasing institution of cases in all Courts in India and its resultant burden upon the Courts has invited attention of all concerned in the justice administration system. Despite heavy quantum of cases in Courts, in our view, it would neither be permissible nor possible to state as a principle of law, that while exercising power of judicial review on administrative action and more particularly judgment of courts in appeal before the higher Court, providing of reasons can never be dispensed with. The doctrine of audi alteram partem has three basic essentials. **Firstly, a person against whom an order is required to be passed or whose rights are likely to be affected adversely must be granted an opportunity of being heard.** Secondly, the concerned authority should provide a fair and transparent procedure and **lastly, the authority concerned must apply its mind and dispose of the matter by a reasoned or speaking order.** This has been uniformly applied by courts in India and abroad.”

23. The said reasoning has been reiterated by the Supreme Court in *Manohar v. State of Maharashtra & Ors.* AIR 2013 SC 681 wherein it has been categorically observed that **application of mind and recording of reasoned decision are the basic elements of natural justice. There can be no doubt that scrupulous adherence to these principles would be required while rejecting patent applications.**”

[Emphasis supplied]

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<sup>1</sup> 2022 SCC OnLine Del 940



15. In the aforementioned facts, the impugned order is set aside and the matter is remanded back to the Controller for considering the written submissions dated 05.12.2023 filed by the Appellants in response to the hearing notice and also pass a reasoned order applying the aforementioned tests for analysing inventive step as prescribed in **F. Hoffmann- La Roche Ltd & Anr. vs. Cipla Ltd. (Supra)** or **Agriboard International LLC v. Deputy Controller of Patents & Designs (supra)**.

16. 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 the Patent Office for passing a fresh order after giving a hearing to the Appellant.
- ii. The Patent Office shall endeavour to decide the subject application in an expeditious manner, preferably within three (3) months from today.

17. 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. 201817034819 and the same shall be decided in accordance with law.

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

19. 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 11, 2025/hp/FV/MG**