IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON	27.11.2025
PRONOUNCED ON	05.01.2026

CORAM

THE HONOURABLE MR.JUSTICE N.SENTHILKUMAR

CMA(PT) No. 54 of 2024

Steer Engineering Private Limited
Rep by Mr.Lalith Kumar, Constituted
Attorney, 290, 4th Main, 4th Phase,
Peenya Industrial Area, Bangalore,
Karnataka-560 058 ...Appellant

Vs

Joint Controller of Patents and Designs
The Patent Office, Chennai, Intellectual
Property Office Building, G.S.T.Road,
Guindy, Chennai-600 032 ...Respondent(s)

PRAYER: Civil Miscellaneous Appeal filed under Section 117A of the Patents Act, 1970 against the order dated 31-07-2024 passed by The Joint Controller of Patents, Chennai in Patent Application No.202142059972.

For Appellant(s): Mr.Essenese Obhan
for Mr.M.S.Bharath

For Respondent(s): Mr.A.R.Sakthivel, SPCGSC
Ms.J.Meena - Join controller of
Patents & Designs appeared
through VC

JUDGMENT

Aggrieved by the impugned order dated 31.07.2024 passed by the Joint Controller of Patents and Designs, Indian Patent Office, Chennai, refusing the grant of a patent in respect of Patent Application No.202142059972, this application has been filed as a divisional application, divided out of Indian Patent Application No.201741044221, which is the parent application. A First Examination Report (in short 'FER') was issued on 07.03.2022. A response to the FER and an amended set of claims was submitted by the agent of the appellant on 05.09.2022. A hearing notice was issued by the Indian Patent Office on 10.10.2023. A written submission dated 18.12.2023, based on the reply to the first examination report was filed by the appellant. Subsequent to the hearing, the impugned order was passed by the respondent.

2. The Appellant has made the following amended claims:

> ***Claim 1:*** *A fiber reinforced thermoplastic composition comprising: a mixture of first thermoplastic and a second thermoplastic, wherein the first thermoplastic is un-plasticised polyvinyl chloride (PVC) and the second thermoplastic is acrylonitrile-butadiene-styrene (ABS); and at least one wetter continuous fiber uniformly incorporated in the mixture of the unplasticised polyvinyl chloride (PVC) and the acrylonitrile-butadiene-styrene (ABS), wherein the fiber reinforced thermoplastic composition has a density between 1.3 g/cc to 1.7 g/cc and a flexural modulus of at least 4000 MPa.*
>
> ***Claim 2:*** *The fiber reinforced thermoplastic composition as claimed in claim 1, wherein rubber content in the acrylonitrile-butadiene-styrene (ABS) is in a range of 10 to 80 percent by volume.*

Claim 3: *The fiber reinforced theremoplastic composition as claimed in claim 1, wherein volume percent of the continuous and chopped fiber to a total volume of un-plasticised PVC is 10% to 40%.*

Claim 4: *The fiber reinforced thermoplastic composition as claimed in claim 1 having a flexural strength of at least 100 Mpa.*

Claim 5: *The fiber reinforced Thermoplastic composition as claimed in claim 1, wherein the at least one wetted continuous fiber comprises one or more liquids or additives that accumulate over the at least one wetted continuous fiber .*

Claim 6: *The fiber reinforced thermoplastic composition as claimed in claim 1, wherein the one or more liquids or additives encapsulate the at least one wetted continuous fiber.*

Claim 7: *A process of preparing a fiber reinforced thermoplastic, the process comprising:*

melting a first thermoplastic and a second thermoplastic in a melting zone of a twin-screw processor, wherein the first thermoplastic is un-plasticised polyvinyl chloride (PVC) and the second thermoplastic is acrylonitrile-butadiene-styrene(ABC);

feeding at least one continuous fiber downstream of the melting zone into a melted mixture of the unplasticised polyvinyl chloride (PVC) and the acrylonitrile-butadiene-styrene (ABC), Wherein the feeding comprises wetting the at least one continuous fiber before mixing with the melted mixture of the unplasticised polyvinyl chloride (PVC) and the acrylonitrile-butadiene-styrene(ABC); incorporating the at least one wetted continuous fiber into the melted mixture in a mixing zone, the mixing zone including only wave elements having a continuous outer surface in the form of a helical wave such that the at least one wetted continuous fiber is uniformly incorporated into the melted mixture of the unplasticised polyvinyl chloride (PVC) and the acrylonitrile-butadiene-styrene (ABS) with reduction in fiber breakage;and obtaining the fiber reinforced thermoplastic from the twin screw processor.

Claim 8: *The process as claimed in claim 7, wherein the at least*

one continuous fiber includes one or more fiber rovings and each fiber roving includes at least one strand of fiber having a diameter of 10μm.

Claim 9: *The process as claimed in claim 7, comprising feeding chopped fiber downstream of the melting zone into the melted mixture of the first thermoplastic and the second thermoplastic*

Claim 10: *The process as claimed in claim 7, wherein no kneading blocks and elements are present in the mixing zone.*

Claim 11: *The process as claimed in claim 7, wherein the wetting comprises facilitating interaction of the at least one wetted continuous fiber with one or more additives such that the one ore more additives accumulate over the at least one continuous fiber.*

Claim 12: *The process as claimed in claim 7, wherein the one or more additives encapsulate the at least one wetted continuous fiber.*

3. The respondent had denied all the 12 claims made by the Appelllant by stating that the claims does not meet the requirements under section 2(1)(ja), Section 59(1) and 16(2) of the Act and are already covered by the parent application. The Respondent had given the following reasons in the impugned order for rejection of patent application by comparing the prior art with the amended claims of the appellant:

(a) D1 relates to similar technical problems, and though D1 does not disclose the exact thermoplastic blend, it would have been obvious for a person skilled in the art to have used the extruder and process suggested by D1 to prepare fiber reinforced thermoplastic compositions of uPVC and ABS, disclosed in D2, D3, D4, D5 and D6.

(b) The amended claims require wetting of fibers, but D1

and D7 suggest that wetting of fibers in an extruder is an inherent phenomenon. Further, it is a common knowledge in art that the fibers to be incorporated are wetted by the molten polymer to obtain the required properties.

(c) D3 teaches a fiber reinforced thermoplastic composition comprising ABS, PVC, glass fiber and other additives, which has exceptional properties, such as high heat resistance, toughness and strength, and finds various applications. The composition is obtained through extrusion. The resulting product exhibits high flexural strength and tensile strength.

(d) D5 discloses PVC alloy material comprising rigid PVC (uPVC), ABS resin and other additives. The alloy is prepared by feeding the polymers and other components into a twin-screw extruder, followed by melt-mixing. D5 indicates that the composition integrates the advantages that ABS resin is shockproof, low-temperature resistant and easy to mould and process, and PVC resin is fire retarding, rigid, corrosion resistant, low in cost, etc.

(e) D6 discloses uPVC pipe having high impact resistance performance, wherein the pipe if formed from a composition comprising uPVC, ABS resin and other additives.

(f) D7 relates to the mechanisms involved in extrusion process, wherein it states that the mixing in an extruder is complete only if 'wetting'. Wetting is simply chemical union of two or more components involved in the mixing process. D7 indicates that kneading action as a result of shearing action is the predominant way of achieving wetting. D7 suggests that some form of dispersion and forced wetting of fibers are brought about by kneading. Thus, D7 teaches that 'wetting' of fibers in an extrader is an inherent

phenomenon brought about by mixing of the plastic mixture with fibers. Difference between state of the art and the claimed subject matter D1-D3 differs from the present invention in that it does not teach a composition comprising uPVC and ABS. D4 differs from the present invention in that it does not disclose an extruder set up comprising the claimed wave element. D5-D6 differs from the present invention in that they are silent on fiber reinforcement of thermoplastic blends of uPVC and ABS. D7 is a general art relating to mechanisms of extrusion. Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of inventive ingenuity. "

4. The learned Controller, who had appeared through VC, had explained their analysis as to whether these features of the cited art anticipate the claimed invention. The learned controller had made the following submission, which forms part of the impugned order.

"The cited document D1 is the closest prior art and D1 teaches that a conventional extruder modified by the wave element may be used for preparing fiber reinforced thermoplastic composition, wherein such an arrangement allows for mixing of long continuous fibers in the plastic without fiber attrition or breakage, thereby resulting in an improved product. Though D1 does not disclose the exact thermoplastic blend it discloses the similar extraction process. As mentioned in the hearing notice that it is obvious for a person skilled in the art to have modified the

arrangement of D2 using the wave element of D1, with a view to prevent fiber breakage as suggested by D1, or alternately to use the different polymer/fiber combinations provided by D2 in the arrangement of D1. As mentioned in the hearing notice, D4 suggests that uPVC/ABS blends provide improved jetting properties over wider range of operating temperature and also give higher levels of impact resistance compared to other compositions. Further D5 and D6 revealed that it was widely known in the art to use blends of uPVC and ABS to make use of the individual advantageous properties, while avoiding the thermal degradation of uPVC. D6 specifically discloses pipes made from uPVC/ABS blends. D3-D6 suggests that pipes or other articles made from uPVC/ABS have significantly improved properties over other systems. The documents D4-D6 were cited to show that u-PVC/ABC blends were used in the prior art to prepare fiber reinforced articles like pipe using a process employing conventional extruders. The applicants has also not brought out any tehnically significant results attributable to the adoption of these wave elements specifically for u-PVC/ABS composites. Thus, the applicants' argument that the cited prior arts do not teach mixing wetted fibers into plastic mixture is not persuasive. Moreover, the applicant has not provided any support and/or evidence regarding an improved effect achieved by the said feature, compared to the prior arts. The instant specification in pages 7-8 merely mentions that a wetting system may be present to homogeneously distribute the fiber within the matrix. The application does not provide any details/features/attributes of the said wetting system or the effect of the said wetting system over known prior arts, such as D1. Hence the amended claims are 1-12 are not inventive in view of the

teaching of the cited document D1 - D7, and hence an inventive step u/s 2(1)(ja) cannot be acknowledged.

5. The appellant claimed that, as established by settled law, the amendment of claims by incorporating features disclosed in the specification, with an aim of further defining a claimed element, constitutes narrowing of the claims and is permissible under Section 59(1) of the Act. Consequently, the amendment of Claim 1 by incorporating the feature "wetted" and claim 7 by incorporating the feature "wetting of fibers", as disclosed in the specification, merely narrows the scope of the claimed invention by further defining an existing element or adding an additional limitation. Therefore, according to the appellant, this amendment is permissible. The relevant portion of detailed description of the drawing submitted by the appellant is extracted hereunder:

> *"In the embodiment illustrated, the barrel 106 is configured to receive a first thermoplastic 150 and a second thermoplastic 160 through the feeder 108. The first thermoplastic 150 may be fed from a resin source (not shown), through the feeder 108, and may be added in the form of a powder into the input barrel 106. For example, the first thermoplastic 150 i.e., in an embodiment, PVC may include resins of un-plasticized PVC that can be repeatedly melted and solidified by hearing and cooling. The first thermoplastic 150 may include a homo-polymer or a co-polymer. Examples of the first thermoplastic 150 include, but not limited to, polypropylene, polyethylene, polyamides, polyamines, polycarborate, and the like, Such thermoplastics may*

be plasticised or unplasticised. By way of an example, the first theremoplastic 150 is an un-plasticised polyvinyl chloride (PVC).

The second thermoplastic 160 may also be fed through the feeder 108 and may be added in the form of a powder/granules/other form into the input barrel 106. The second thermoplastic 160 may be a homo-polymer or a co-polymer. Examples of the second thermoplastic 160 include, but not limited to, polystyrene, styrene-acrylonitrile copolymers, acrylonitrile-butandiene-styrene terpolymers, polysulphones, polyesters, polyurethanes, polyphenylene sulfides, polyvinyl chloride, polyphenylene ethers, polystyrene, and the like. By way of an example, the second thermoplastic 160 may be a acrylonitrile-butadiene-styrene (ABS) ."

The pipe formed from the mixture of PVC and ABS reinforced with glass fibers exhibits properties and strengths greater than those of normal PVC and chlorinated PVC. For instance, the pipe manufactured in one example from the composition as disclosed above has the following strength and performance parameters in comparison to normal PVC and chlorinated PVC.

COMPARISON OF PVC PIPE TEST RESULTS				
Test Parameters->	***Units***	***C-PVC Pipe***	***Normal PVC Pipe***	***Current Disclosure Pipe***
Tensile Strength at yield	MPa*10	5.2	4.7	5.9
Flexural Strength	MPa*10	6.8	6	15.845
Flexural Modulus	MPa*1000	2.472	1.735	8.488
Density	g/cc	1.56	1.4	1.46

In another example, the process was utilized to produce a fiber reinforced PVC composition and a pipe was formed using the said fiber reinforced PVC composition. In the example, the PVC composition was formed by using PVC resins from Owens Corning Korea (K67 resin), ABS and continuous fibers. The formed pipe had the following properties, strength parameters and dimensions:

	Outer Diameter (mm)	***Wall Thickness (mm)***	***Wt. of piper per meter (gms)***	***Deflection with 18.5 Kg load (mm)***	***PSDC TS/FS/FM (MPa)***
Plain PVC	32	2.0	253	60 (3.2 Kg load)	47/60/1588
C-PVC	28.6	2.8	336	75	47/63/2422
Current Disclosure	25	2.8	303	45	42/76/4141

6. In support of his contention, the learned counsel appearing for the appellant has relied on the decision of this court in ***Rhodia Operations v. Assistant Controller of Patents and Designs, Government of India*** reported in ***(2024) 1 HCC (Mad) 140***. In this decision, in paragraphs 18 to 29, this court has held as follows:

> *18. In Avery Dennison, the Delhi High Court surveyed the different approaches to obviousness analysis, such as the obvious to try approach; problem/solution approach; the could~would approach; and the teaching, suggestion and motivation (TSM) approach. Thereafter, the Court set out the tests formulated by the House of Lords in Windsurfing International Inc. v. Tabur Marine Ltd, [1985] RPC 59, as modified by the Court of Appeals in Pozzoli Spa v. BDMO SA, [2006] EWHC 1398 (Ch.), which are referred to as the Windsurfer Pozzoli tests and are as under:*
>
> *"□1.(a)Identify the notional □person skilled in the art□ (b)Identify the relevant common general knowledge of that person;*
>
> *2. Identify the inventive concept of the claim in question or if that cannot be readily done, construe it;*
>
> *3. Identify what, if any, differences exist between the matter cited as forming part of the □state of the art□ and the inventive concept of the claim or the claim as construed;*
>
> *4. Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention.□*
>
> *19. In Agriboard International, the Delhi High Court held that the Controller, while carrying out inventive step analysis, should consider the invention disclosed in the prior art, the invention disclosed*

in the application under consideration, and then examine whether and, if so, in what manner the subject invention would be obvious to a person skilled in the art. The Division Bench of the Delhi High Court, in paragraph 153 of Hoffmann-La Roche, formulated five steps to determine obviousness/lack of inventive step, and the said paragraph is set out below:

> *"153. 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 these 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 hideside approach.*

20. In Actavis, the UK Supreme Court identified nine relevant considerations to be taken into account while assessing obviousness and these, in relevant part, are captured in paragraph 19 of Avery Dennison by the Delhi High Court. The said paragraph is extracted below:

> *" 19. The relevant considerations are:*
> *(1) First, it is relevant to consider whether something was obvious to try at the priority date, in other words, whether it is obvious to undertake a specific piece of research which had a reasonable or fair prospect of success.*
> *(2) Secondly, it follows the routine nature of the research and whether there is an established practice of following the research through to a particular point may be a relevant consideration which is weighed against the consideration that the claimed process or product was not obvious to try at the outset of a research programme.*
> *(3) Thirdly, the burden and cost of the research programme is relevant. But the weight to be attached to this factor will vary depending on the particular circumstances.*
> *(4) Fourthly, the necessity for and the nature of the value judgments which the skilled team would have in the course of a testing programme are relevant considerations*
> *(5) Fifthly, the existence of alternative or multiple paths of*

research will often be an indicator that the invention contained in the claim or claims was not obvious. If the notional skilled person is faced with only one avenue of research, a □one way street□, it is more likely that the result of his or her research is obvious than if he or she were faced with a multiplicity of different avenues. But it is necessary to bear in mind the possibility that more than one avenue of research may be obvious □.

(6) Sixthly, the motive of the skilled person is a relevant consideration. The notional skilled person is not assumed to undertake technical trials for the sake of doing so but rather because he or she has some end in mind. It is not sufficient that a skilled person could undertake a particular trial; one may wish to ask whether in the circumstances he or she would be motivated to do so. The absence of a motive to take the allegedly inventive step makes an argument of obviousness more difficult□.

(7) Seventhly, the fact that the results of research which the inventor actually carried out are unexpected or surprising is a relevant consideration as it may point to an inventive step□

(8) Eighthly, the courts have repeatedly emphasised that one must not use hindsight, which includes knowledge of the invention, in addressing the statutory question of obviousness. That is expressly stated in the fourth of the Windsurfing/Pozzoli questions□.

(9) Ninthly, it is necessary to consider whether a feature of a claimed invention is an added benefit in a context in which the claimed innovation is obvious for another purpose□.□

21. The precedents on record suggest that the inventive step inquiry should be carried out in the following manner: (1) identify the person skilled in the art; (2) identify the common general knowledge to be imputed to the person skilled in the art; (3) identify the inventive concept embodied in the claimed invention; (4) identify the differences between the prior arts and the claimed invention; and (5) decide whether those differences would be obvious to a person skilled in the art. I intend to start my analysis with identifying the inventive concept embodied in the invention because the technical advance or economic significance requirement is an essential pre~requisite in obviousness analysis under Section 2(1)(ja).

What is the inventive concept embodied in the claimed invention?

22. The claimed invention is described at internal page 3 of the complete specification as under:

"INVENTION

The Applicant has quite suprisingly demonstrated that the use, in a polyamide matrix, of a novolac resin and of a polyolefin made it possible to obtain a material suitable for the manufacture of single~layer or

multilayer articles having an excellent level of impermeability to gases and to liquids, in a simple manner and without negatively altering the other properties of said materials. The solution of the invention makes it possible not only to avoid the drawbacks known from the prior art, but also to obtain hitherto unheard of fluid barrier properties, that are in any case much higher than the systems used commercially."

From the above description, it is evident that the claimed invention identifies the problem to be solved as the need to develop single or multi~layer articles with high fluid barrier properties or excellent levels of impermeability. As a solution to such problem, the claimed invention recites that a composition comprising a novolac resin and a polyolefin in a polyamide matrix, when used for the manufacture of single-layer or multi-layer articles, has an excellent level of impermeability to gases and liquids. As per embodiments of the claimed invention, the composition may be used for the manufacture of articles, such as pipes, ducts, or tanks, intended to contain or transport a fluid. The industrial application of the invention is elucidated in the experimental section in internal pages 13 to 15 of the complete specification. Table 1 thereof recites that a polyamide pipe comprising novolac resin has excellent impermeability to gasoline.

23. Out of the two prior arts on which reliance was placed by the Controller in the impugned order, prior art D5 does not disclose or teach the use of novolac resin either as a composition or as a layer in a multi-layered article and prior art D6 does not disclose or teach the use of polyolefin in the composition. Therefore, undoubtedly, the claimed invention discloses features not found in any of the prior arts cited by the Controller in the impugned order. Consequently, the technical advance requirement is satisfied. The next step is, therefore, to identify the person skilled in the art before determining whether the technical advance would be obvious to such person.

Person skilled in the art

24. The person skilled in the art is a hypothetical person created by law. The law requires that obviousness analysis be carried out by slipping into the shoes of this notional person. In spite of the significance of this notional person, the Patents Act does not define the person skilled in the art or prescribe the attributes of such person. Section 3 of the Patents Act, 1977 of the United Kingdom (the UK Patents Act), which is the provision corresponding to Section 2(1)(ja), defines inventive step as under:

Inventive step 3.

An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 2(2) above (and disregarding section 2(3) above).

When Section 2(1)(ja) of the Patents Act is compared and contrasted with Section 3 of the UK Patents Act, it is noticeable that the first requirement under Section 2(1)(ja), i.e. technical advancement over

existing knowledge or economic advantage or both, is not expressly prescribed in Section 3 of the UK statute. Turning to the perspective from which obviousness analysis should be carried out, both statutes use the identical expression □person skilled in the art□. Against this backdrop, it is useful to examine the manner in which courts in the UK define or describe the person skilled in the art.

24. Speaking for the UK Patents Court, Justice Laddie elaborated on the general characteristics of the skilled but non-inventive person in paragraph 62 of Lilly Icos LLC v. Pfizer Ltd. (Lilly Icos), (2001) FSR 16, which is set out below:

□The question of obviousness has to be assessed through the eyes of the skilled but non-inventive man in the art. This is not a real person. He is a legal creation. He is supposed to offer an objective test of whether a particular development can be protected by a patent. He is deemed to have looked at and read publicly available documents and to know of public uses in the prior art. He understands all languages and dialects. He never misses the obvious nor stumbles on the inventive. He has no private idiosyncratic preferences or dislikes. He never thinks laterally. He differs from all real people in one or more of these characteristics. A real worker in the field may never look at the piece of prior art- for example he may never look at the contents of a particular public library- or he may be put off because it is in a language he does not know. But the notional addressee is taken to have done so. This is a reflection of part of the policy underlying the law of obviousness. Anything which is obvious over what is available to the public cannot subsequently be the subject of valid patent protection even if, in practice, few would have bothered looking through the prior art or would have found the particular items relied on. Patents are not granted for the discovery and wider dissemination of public material and what is obvious over it, but only for making new inventions. A worker who finds, is given or stumbles upon any piece of public prior art must realise that that art and anything obvious over it cannot be monopolised by him and he is assured that it cannot be monopolised by anyone else.□

25. In the United States of America, Title 35 of the United States Code governs patents and Section 103 thereof, which deals with non-obvious subject matter, is as under:

□A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in Section 102 if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.□

Thus, under US law, obviousness is required to be determined from the perspective of □a person having ordinary skill in the art□. The acronym □Mr.PHOSITA□ or □PHOSITA□ is often used for this

notional person. In this statutory context, in Graham v. John Deere Co. (Graham)383 U.S.1 (1966), the US Supreme Court formulated the following four steps in obviousness analysis:

Obviousness depends on (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unresolved needs; failure of others and unexpected results.

Level of skill of person skilled in the art

26. As is evident from the above survey, the definition of inventive step in the Patents Act is closer to that in the UK Patents Act because both statutes use the expression person skilled in the art unlike the US Patents Act which uses the expression person having ordinary skill in the art. That said, what is the level of skill: is it average, good, very good, excellent, or extraordinary? The text of Section 2(1)(ja) does not place any of the above qualifiers or any analogous variant before the adjective skilled. Is there contextual guidance regarding the level of skill? On scanning the Patents Act, I find that Section 64(1)(h), which provides for revocation of patents for failure to enable, prescribes as under:

(1)Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may be revoked on a petition of any person interested or of the Central Government or on a counter~claim in a suit for infringement of the patent by the High Court on any of the following grounds, that is to say - (h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection. (emphasis added).

The words to which emphasis was added in the above provision indicate that the statute posits a different notional person for determining whether the invention had been sufficiently enabled. This person, in contrast to the hypothetical person in Section 2(1)(ja), is a person in India possessing average skill in and average knowledge of the art to which the invention relates. The absence of the words in India in Section 2(1)(ja) indicates that the person could be based anywhere in the world, including India.

27. Section 2(1)(ja) uses the word skilled as an adjective qualifying the noun person. Most standard dictionaries define the adjective skilled as referring to a person having the ability to do a job, task or activity well. I am mindful of Judge Learned Hand-s wise

counsel in Markham v. Cabell, 326 U.S. 404 (1945), that one should not make a □fortress of the dictionary□. So, I remind myself of the context: to determine whether the technical advance or economic significance or both would be obvious to a person skilled in the art. By reckoning that such skilled person could be from a range of disciplines depending on the field of invention, I ask myself what level of ability comes to mind if a person were to be described in any of the following ways: skilled medical doctor; skilled automobile engineer; skilled physicist; skilled carpenter; or skilled immunologist. In each case, the straightforward answer is a person possessing the necessary attributes to do the job well. I bear in mind statutory context, i.e. the absence of the qualifier □average□ in Section 2(1)(ja) in contrast to its use in Section 64(1)(h). I recognise that the statute neither uses words that indicate enhanced levels of skill such as □highly□, □outstandingly□ or □extraordinarily□ nor words that indicate a low or average level of skill such as □low□ or □ordinary□ or □average□ to further qualify the □skilled□ person. By taking into account all of the above, on balance, in my view, the □person skilled in the art□ as per Section 2(1)(ja) is a person whose skill level is good/greater than average. Because most disciplines/arts require a range of skills or skill set, this person should possess the skill set to do the job well. These aspects were considered in a judgment dated 12.06.2013 of the Intellectual Property Appellate Tribunal (the IPAB) in Enercon (India) Ltd. v. Aloys Wobben (Enercon), ORA/08/2009/PT/CH. In Enercon, the IPAB, speaking through Mrs.Justice Prabha Sridevan, held as under in two memorable paragraphs:

> *□35. It is true that the Roche extract is specifically with regard to the obviousness issue, but the Novartis extract is not. But it is clear from both the judgments that we should understand the concepts based on the sections as they are in our Act, and also contextualize it in our country. Roche v. Cipla also speaks of a person skilled in the art and not a person with ordinary skill in the art or average skill in the art. The respondent wants us to imagine a person of ordinary skill, conservative, unimaginative, will not go against established prejudice, and is in India. The law has not used the word ordinary. It had the laws of other jurisdictions before it and yet it eschewed the word □ordinary□. So it is very important for us while deciding obviousness not to conjure up a dullard or a moron. Why should we proceed as if □ordinariness□ is inherent in the hypothetical person? If it makes the obviousness bar a bit higher, we must bear that in mind, for This is Our Law.□*
>
> *□37. In this case the art is wind energy. Since this obviousness test is the most frequently debated issue in patent litigations, it may be better if in the future, the pleadings or evidence tells us who this person is. This person is skilled in*

> *the art. This person is presumed to know the state of that art at that time, and to have the knowledge that is publicly available. The Act is quite clear and free from ambiguity. The person is skilled in the art and has more than average knowledge of the state of the art and also has common sense. Indian law expects the non~obviousness to be tested against this person and not the person who is the touchstone in U.S. Law. She is Ms.P.Sita (Person Skilled in the Art) and not Mr.Phosita or Mr. Posita who are both ordinary by definition.*

Attributes of a person skilled in the art

28. I turn next to the attributes of a person skilled in the art. Depending on the art, educational/ academic or vocational qualifications are likely to be required. Work experience would certainly be required because one does not ordinarily describe a person with the requisite educational qualifications but no work experience as skilled in the art. What about ability to use the tools of trade? Clearly, a person skilled in the art would be adept at using the tools of trade. With regard to knowledge, as held in Lily Icos, on account of the underlying public policy requirement that no monopoly right should be granted over matters previously known in the art or obvious to a person with knowledge of prior art, a level of knowledge that a real person skilled in the art is unlikely to possess is imputed to the hypothetical person. Such imputation of knowledge is not, however, unqualified and is restricted to matters previously known in the art in which such person or team of persons is skilled. The legislative intent, as gleaned from text, is certainly not that this person should be omniscient. This leads to the question: in what respects should this notional person be different from a real person skilled in the art?

29. For instance, is it necessary that this person should be forgetful of other prior art once she identifies the closest prior art? I do not think that it is necessary to impute such trait although it is necessary to be mindful of the risk of hindsight~based mosaicing. Should this person be lacking in imagination? While the extent of imaginativeness varies from person to person, imagination is an inherent human quality and the underlying public policy of fostering inventiveness does not justify banishing imagination in the notional person. What about inventiveness? Plainly, the text of the statute requires a patent applicant to establish the existence of an inventive step and, if obviousness is examined from the perspective of a skilled person with ingenuity and inventive capacity, every patent application would fail as would the public policy of fostering genuine invention. Indeed, even de hors the public policy justification, the expression "person skilled in the art" does not ordinarily connote a person with inventive capability. Thus, except to the extent that statutory prescription or the underlying public policy call for a departure from the characteristics of a real person skilled in the art, the notional person should, in my view, mirror a real

person as closely as possible. Adopting such approach has the benefit of enhancing the quality of obviousness analysis by ensuring that it remains rooted in the real world. In sum, other than the unreal levels of knowledge imputed to the notional person, such person should possess all the qualities that a real person proficient in the art would possess. "

By relying upon the aforesaid judgment, the learned counsel argued that the interpretation of the claim amendments in the impugned order is flawed as it disregards the established legal precedents.

7. This court has taken note of the guiding principles on identifying the presence of inventive step in an invention, which are observed in the above judgement. At the risk of repetition, for the sake of clarity, the said observation is extracted hereunder:

> *21. The precedence on record suggest that the inventive step inquiry should be carried out in the following manner: (1) identify the person skilled in the art; (2) identify the common general knowledge to be imputed to the person skilled in the art; (3) identify the inventive concept embodied in the claimed invention; (4) identify the differences between the prior arts and the claimed invention; and (5) decide whether those differences would be obvious to a person skilled in the art. I intend to start my analysis with identifying the inventive concept embodied in the invention because the technical advance or economic significance requirement is an essential prerequisite in obviousness analysis under Section 2(1)(ja).*

8. The appellant vehemently contended that the claim made by the

Appellant is squarely covered under the conditions and requirements of the Patents Act.

9. The learned counsel for the appellant relied upon the decision in ***Dura-Line India Pvt. Ltd. vs. Jain Irrigation Systems Ltd.*** reported in ***2025 SCC OnLine Del 3467*** and argued that the patent is mechanically rejected. The learned counsel contended that the findings given by the respondent is influenced by Hindsight Bias. The relevant portion is extracted hereunder:

> *"100. Obviousness is not a license to dissect an invention into known parts and reassemble them retrospectively. The prohibition against hindsight bias, repeatedly emphasised in judicial decisions, guards precisely against such mechanical analysis. In evaluating whether the Suit Patent is obvious, this Court must remain vigilant against the use of hindsight bias, a cognitive trap that distorts legal analysis by judging the state of prior art with knowledge of the invention already in hand.*
>
> *101. Hindsight bias refers to the tendency to view past events as having been more predictable than they actually were. In the context of patent law, it manifests when the claimed invention is dissected into known components, and then those components are re-combined with the benefit of knowing the invention's outcome, thereby undermining the statutory requirement of a true inventive step. Thus, the test for inventive step must not be applied in a retrospective manner.*
>
> *102. In the present case, the Defendant's approach, while tenacious, ultimately reflects an ex-post reconstruction rather than a credible roadmap that a PSA would have followed on the priority date. The Defendant's approach leans dangerously close to reconstructing the invention with full awareness of the claims in the Suit Patent. The reliance on disparate documents, none of which individually suggest or motivate the claimed configuration of a co-extruded tracer cable on the outer surface of a fluid-carrying pipe, seeks to piece together a mosaic that only takes shape with the end result in view. Such retrospective rationalisation fails the legal threshold for obviousness.*

> *103. To avoid hindsight, the correct inquiry is not whether the invention can be deconstructed into known parts, but whether a person skilled in the art, without knowledge of the invention, would have had any reason, motivation, or expectation of success in combining the teachings of the cited prior art documents in the claimed manner. On this test, the Defendant's challenge falls short. None of the prior art references provide any teaching or suggestion that a co-extruded tracer cable on the outer surface of a non- metallic pipe for fluid transport, encased in polymer, would address known problems of traceability and leakage detection. Nor do they offer insight into the structural and functional benefits that such a configuration would deliver. In fact, as noted earlier, some prior arts such as Exhibit DW2/1 actively discourage surface-mounted elements due to coupling complications, suggesting a technological trajectory contrary to what the Plaintiff's invention adopted.*

10. The learned counsel for the appellant contended that the authority has to examine whether the appellant has complied with the mandatory legal requirements. To strengthen his case, the learned counsel further relied upon the judgment of the Delhi High Court in ***Nippon A & L Inc. vs. Controller of Patents*** reported in ***2022 SCC OnLine Del 1909***, wherein, the Delhi High Court has held in paragraph 55 as under:

> *"55. A perusal of the paragraphs of the Ayyangar Committee Report clearly shows that the purport and intention of this report was to give broader and wider permissibility for amendment of claims and specification prior to the grant and restrict the same post the grant and advertisement thereof. The report is also categorical in its observation that the invention before and after amendment need not be identical in case of amendment before acceptance "so long as the invention is comprehended within the matter disclosed".*

The learned counsel argued that as held in the above judgment, the inclusion of features disclosed in the specification to narrow down claims should be

ordinarily allowed.

11. However, all these contentions are disputed by the respondent on technical reasons, which are stated supra. The main reason putforth by the Respondent for rejection of the patent application filed by the appellant is that the appellant has not disproved the overlapping features in the present application and the parent application. A comparison of the present application and the parent application would show that the amended claims are nothing but the features covered under the patent application which was originally filed by the appellant. The key finding rendered by the respondent while rejecting the claims is that the scope of the amended claims 1 to 12 are already covered by the parent application and the said application is not granted patent rights. The respondent has in detail analysed the amended claims and the prior art. That apart, the reasoning given by the respondent for their finding that the amended claims do not meet the requirements under Section 2(1)(ja), 59(1) and 16(2) of the Patents Act is also satisfactory. In view of the above, the impugned order passed by the respondent does not suffer from any lacuna and hence the civil miscellaneous appeal is liable to be dismissed.

12. Accordingly, this appeal is dismissed. However, there is no order as to costs.

05-01-2026

Asr
Index:Yes/No
Speaking/Non-speaking order
Internet:Yes
Neutral Citation:Yes/No

N.SENTHILKUMAR J.

Asr

To

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