



**IPAB Intellectual Property Appellate Board**

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**OA/5/2016/PT/KOL**

**THURSDAY, THIS THE 07<sup>TH</sup> DAY OF JANUARY, 2021**

**HON'BLE SHRI JUSTICE MANMOHAN SINGH  
HON'BLE DR. B.P. SINGH**

**CHAIRMAN  
TECHNICAL MEMBER (PATENTS)**

**LG CHEM LTD**

(A COMPANY OF REPUBLIC OF KOREA) OF 20, YOIDO-DONG,  
YOUNGDUNGPO-GU, SEOUL 150-721,

REPUBLIC OF KOREA

.....APPELLANT

(Represented by: Mr Debashish Banerjee)

Versus

**1. CONTROLLER GENERAL OF PATENTS & DESIGNS**

THE PATENT OFFICE, BOUDHIK SAMPADA BHAWAN,  
S.M. ROAD, NEAR ANTOP HILL POST OFFICE,  
ANTOP HILL, MUMBAI – 400 037

**2. ASSISTANT CONTROLLER OF PATENTS & DESIGNS**

BOUDDHIK SAMPADA BHAWAN  
CP-2, SECTOR V  
SALT LAKE CITY  
KOLKATA 700 091 INDIA

.....RESPONDENT

(Represented by - None)

**ORDER**

**Hon'ble Shri Justice Manmohan Singh, Chairman**

**Hon'ble Dr. B.P. Singh, Technical Member (Patents)**

1. The present appeal is filed under Section 117A of the Indian Patents Act, 1970, against the order dated 07/07/2015, passed by the Respondent NO. 2, being the Assistant Controller of Patents &

Designs, under Section 15 of the Indian Patents Act, 1970, refusing to grant the Appellant's Indian patent application no. 3288/KOLNP/2008.

2. It is the case of the appellant that the order of the Respondent No. 2 refusing the Appellant's patent application is manifestly erroneous in law & facts and is liable to be set aside. The Respondent has misdirected himself in the appraisal and appreciation of the submissions made by the Attorneys for the Appellant at the official hearing on May 29, 2015 and in the written submissions dated May 29, 2015, which resulted in vitiation of the decision.

3. The Appellant submits that the following issues were framed by the Respondent No. 2 while rendering the impugned order:

- (Issue No. I): Whether the amended claims are conflicting with the Indian patent Application numbers 3402/KOLNP/2008 AND 3418/KOLNP/2008 or not?
- (Issue No. II): Whether the amended claims are still lacking in novelty & inventive step or not?
- (Issue No. III): Whether amended claims still attract the provisions of Section 3(e) and Section 3(f)?

4. Issue No. I was decided in favour of the Appellant in paragraph 9 of the impugned order, in the following terms:

*“After hearing the Agent amended the claims and changed the wt% range of compound of Formula (1) and aliphatic nitrile compound in such a way that those wt% ranges of the above-mentioned compounds are not conflicting with the same as taught in the other two Patent applications.”*

5. Issue No. III was decided in favour of the Appellant in paragraph 13 of the impugned order, in the following terms:

*“For objection raised under para 4 and 5 of the hearing letter, the Agent has amended the claims and also deleted the*

*objected claims. In view of this, the objections raised under para 4 and 5 are now met.”*

6. Accordingly, only Issue No. II was decided against the Appellant.
7. As shown herein after, the Respondent No. 2's determination of Issue No. 2 (which is the sole ground of refusal) is erroneous on the face of the record in as much as the very premise upon which the invention has been considered to lack inventive merit under Section 2(1)(ja) of the Indian Patents Act is out rightly flawed since the Respondent No. 2 has incorrectly considered Indian Patent application nos. 3402/KOLNP/2008 and 3418/KOLNP/2008 as PRIOR ART. This is evident from paragraph 9 of the impugned order wherein it is observed as under:

*“After hearing, the Agent amended the claims and changed the wt% range of compound of Formula (1) and aliphatic nitrile compound in such a way that those wt% ranges of the above mentioned compounds are not conflicting with the same as taught in the other two Patent applications. Now, the question is whether the revised wt% ranges of the compounds make this instant invention inventive? According to me the answer is “no”..... If we go through the granted specification (3402/KOLNP/2008) it is clear that all the components are same with this instant patent application, only the wt% ranges are different.....”*

8. In paragraph 10 of the impugned order, the Respondent No. 2 goes on to conclude that:

*“So from the above said discussion it is amply clear that all the components used in this instant alleged invention are already disclosed in the said Indian patent applications. Only difference is in the wt% range of the compounds.....”*

*In this present application the wt% ranges of the compounds has been changed and due to this amendment wt% ranges of the compounds in electrolytes not conflicting with said Indian patent applications, so the claims are novel, but it is clear that claims of this instant alleged invention (3288/KOLNP/2008) are lacking in inventive step with respect to the said Indian Patent applications, and not allowable under section 2(1) (ja) of the Act.”*

9. We have reviewed the facts of all the three applications and summarized it in the table shown below:

Application No.	Date of Application	Title	Applicant	Priority No	Priority Date	Publication Date
3288/KOLNP/2008	11/08/2008	NON-AQUEOUS ELECTROLYTE AND ELECTROCHEMICAL DEVICE WITH AN IMPROVED SAFETY	LG CHEM, LTD	KR10-2006-0003675	12/01/2006	13/02/2009
3418/KOLNP/2008	21/08/2008	NON-AQUEOUS ELECTROLYTE AND ELECTROCHEMICAL DEVICE WITH AN IMPROVED SAFETY	LG CHEM, LTD.	KR10-2006-0014650	15/02/2006	13/02/2009
3402/KOLNP/2008	21/08/2008	NON-ACQUEOUS ELECTROLYTE AND ELECTROCHEMICAL DEVICE WITH AN IMPROVED SAFETY	LG CHEM, LTD.	KR-2006-0014640	15/02/2006	13/02/2009

10. We have also seen that patents were granted to both Patent application Nos. 3418/KOLNP/2008 and 3402/KOLNP/2008 with Patent Nos. 269208 and 263787 respectively.

11. We have also reviewed that in case of co-lateral application 3418/KOLNP/2008 similar citations, were relied upon as in the instant application. Though, after the amendments of the claims, the patents were granted in both the applications.

12. It is evident from the table above that the Respondent no. 2 has clearly misdirected himself to rely on documents which must have been co-laterally filed but had later priority dates than that of the instant case. These documents, by no means, could have been cited as prior arts, as they neither qualify for prior- publication nor prior claiming. Further, other citations relied upon in the instant case were also successfully countered in the appellant's co-lateral applications.

13. These cases and likes thereof are suitable examples that as far as practicably applicable, such cases should be referred to a single examiner-Controller pair for examination to remove such confusions. We understand that this case must have been referred for examination, well before the implementation of auto- allotment module of IPO. **It is, therefore, recommended that Auto-Allotment module at IPO should be suitably fine-tuned to ensure that cases falling under this category i.e. same applicant, same title, common inventors, similar but not identical subject matter, should be referred to same examiner-Controller pair for improvement in quality of examination and grant of the Patents.**

14. We are fully convinced that the impugned order is flawed for relying on improper documents and not giving proper chance to the appellant to put forward their counter arguments and hence cannot be sustained.

15. We set aside the order of the Respondent No.2 dated 07/07/2015 and remand back the case to the Respondent no. 2 who shall decide the matter in accordance with law, relying on valid and relevant prior arts, strictly within 3 months from the issuance of this order

and after giving the appellants a fair opportunity of being heard, if so required.

16. Keeping in view the above, the instant appeal is allowed. No cost.

-Sd/-

**(Dr. B.P. Singh)**  
Technical Member (Patents)

-Sd

**(Justice Manmohan Singh)**  
Chairman

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