



**IPAB Intellectual Property Appellate Board**  
balancing ip-protection

Guna Complex Annexe-I, 2nd Floor, 443 Anna Salai, Teynampet, Chennai-600 018.  
Tele: 24328902/03 Fax: 24328905 email id: ipab.tn@nic.in Website: http://www.ipab.gov.in

**OA/13/2020/PT/MUM**

**MONDAY, THIS THE 9<sup>TH</sup> DAY OF NOVEMBER, 2020**

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

**CHAIRMAN  
TECHNICAL MEMBER (PATENTS)**

1. TONY MON GEORGE CONSTITUTED ATTORNEY  
OF MAGNETIC AUTOCONTROL GMBH  
A CORPORATION ORGANIZED AND EXISTING UNDER  
THE LAWS OF GERMANY, GRIENMATT 20, 79650  
SCHOPFHEIM, GERMANY.

2. TONY MON GERORGE CONSTITUTED ATTORNEY  
OF L-1, IDENTITY SOLUTIONS AG  
A CORPORATION ORGANIZED AND EXISTING UNDER  
THE LAWS OF GERMANY – UNIVERSITAETSSTRASSE  
160, 44801, BOCHUM, GERMANY.

---- Appellants

(Represented by Ms Archana Shankar)

1. THE ASSISTANT ONTROLLER OF PATENTS & DESIGNS  
GOVT. OF INDIA, PATENT OFFICE  
BOUDHIK SAMPADA BHAWAN, ANTOP HILL, S.M. ROAD,  
MUMBAI – 400037.

---Respondents.

(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 20/02/2020, passed by the Respondent, under Section 15 of the Indian Patents Act, refusing to grant the Appellants' Indian patent application no. 1332/MUMNP/2011.

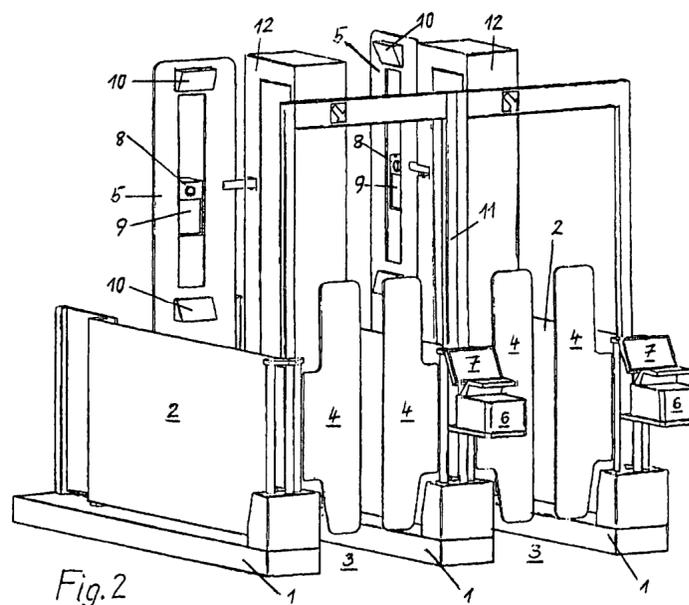
## 2. Brief Description of Invention as submitted by the Appellant

2.1 The present invention, particularly, includes at least the following essential features:

**Feature A:** The biometric unit (8) is arranged frontally opposite the entrance to the lock area (3),

**Feature B:** The exit door (5) of the lock area (3) consists of at least one pivoting wing (5) in a known manner, wherein the biometric unit (8) is integrated in the at least one pivoting wing (5).

2.2 The present invention, in one embodiment according to figures 1-3, shows a two-line apparatus for a checkpoint, in which case “two-line” is used to mean that two identical passage locks are arranged beside and parallel to one another.



2.3 According to the invention, a biometric unit 8 is integrated in the pivoting wing 5 of the exit door 5. The biometric unit 8 may be a camera which is attached, preferably with a display 9, for the biometric recognition, for example face recognition,

the recognition of the face as a whole and/or the iris, of a person who has entered the lock area 3.

2.4 In the apparatus, the biometric unit/camera 8 and display 9 are arranged frontally opposite the entrance of the lock area 3, with the result that a person who enters inevitably assumes the required and correct, namely frontal, position with respect to the camera 8 without any special instructions. The display 9 will cause the relevant person to follow the process of image acquisition for biometric recognition on the display 9, that is to say will cause the person to remain in the required position and not to be distracted, for example turning his head in the process, which would have to result in the process being interrupted.

2.5 In accordance with an implementation of the apparatus of the present invention, an image is recorded with the camera/biometric unit 8 or another suitable recording apparatus and is visible on the display 9 to be evaluated in an electronic unit. The electronic unit generates a signal which is forwarded to a control unit via which the pivoting wing 5 of the exit door 5 is opened. Similarly, the electronic unit can also generate a signal which is forwarded to a control unit via which the pivoting wing 5 of the exit door 5 is closed if a particular person is not intended to pass through.

2.6 When the pivoting wing 5 is pivoted open, the camera/biometric unit 8 and the display 9 are also pivoted out of the person's field of view, with the result that the person is not tempted to continue to look at the display 9 but rather will quickly leave the lock area 3. The arrangement of

the camera/biometric unit 8 with display 9 in the pivoting wing 5 of the exit door 5 thus also avoids unnecessary delays at the checkpoint and expedites the process of scanning, which is particularly advantageous with passage locks having a high footfall, for example at airports.

2.7 Further, the apparatus includes the biometric unit 8 that is a recording apparatus 8 for detecting biometric features or the face as a whole or the iris, of a person desiring passage. In such a scenario, a display 9 for the image recorded by the recording apparatus 8 is provided. The recording apparatus 8 and the display 9 are integrated in the pivoting wing 5 of the exit door 5 of the lock area 3.

2.8 In order to obtain images which are suitable for biometric face recognition, the recording apparatus 8 should, as far as possible, be at the eye level of the person to be recorded, which naturally depends on the height of a person and varies greatly from person to person.

2.9 By virtue of the fact that the biometric unit 8 is arranged frontally opposite the entrance to the lock area, a person is inevitably in the correct position frontally opposite the biometric unit upon entering the lock area without relevant instructions having to be given to the person and followed by the latter. This arrangement of the biometric unit frontally opposite the entrance to the lock area also makes it possible to arrange a plurality of passage locks beside and parallel to one another without increasing the space requirement in the longitudinal directional of the locks; the length of the locks remains the same throughout the arrangement of even a

plurality of locks, with the result that the above-mentioned predefined dimensions can be reliably complied with.

2.10 The exit door of the lock area preferably consists of at least one pivoting wing 5, and the biometric unit 8 is integrated in this at least one pivoting wing 5. In this case too, the person is virtually inevitably in the correct position and stance with respect to the biometric unit 8 after entering the lock area 3. When the pivoting wing 5 is pivoted into the position which enables passage, the optical unit is concomitantly pivoted out of the pathway and field of view of the person and the person can quickly leave the lock area; the person is also not tempted to continue to still look at the biometric unit 8 in the process. Unnecessary delays are avoided.

2.11 The technical advancement of the present invention are:

- ✓ Much reliable recognition of the user;
- ✓ High accuracy in recognition of the user;
- ✓ Enhancement in security features;
- ✓ Avoiding undue delay;
- ✓ Substantial reduction in error rate;
- ✓ Enhanced turn-around time
- ✓ Reduced cost

### **3. The case of the Appellant:**

3.1 The learned counsel of the appellant has submitted that the Respondent refused to grant a patent on Application no. 1332/MUMNP/2011 on the ground that the claims of the present invention do not involve an 'inventive step' as being 'obvious' over the teachings of the cited prior art documents D1 to D5, particularly a combination of D1, D4 and D5 and,

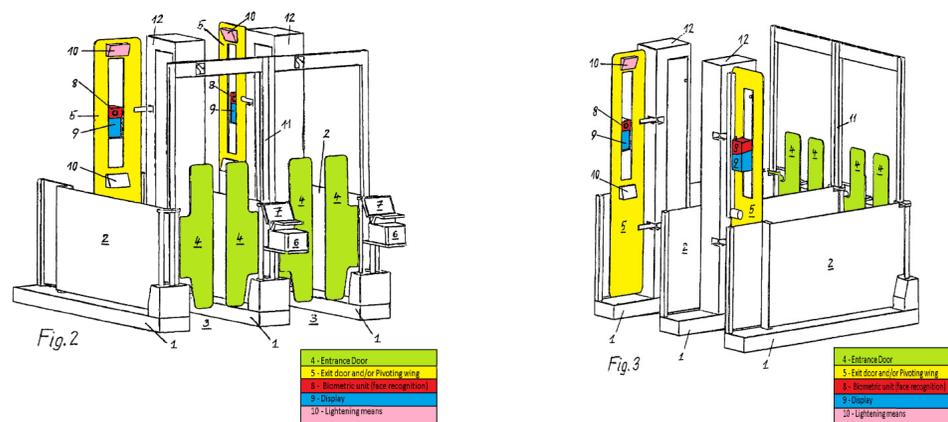
therefore, are not patentable under Section 2(1)(ja) of the Act on the ground of lack of inventive step.

3.2 The Respondent has incurred an error while adjudicating section 2(1)(ja). The Respondent does not consider all the features of claim 1, in his impugned order while assessing inventive step, since at least one of the novel and inventive feature of claim 1 has been omitted from the impugned order to the Respondent.

3.3 **Claim 1 of the Instant Patent Application 1332/MUMNP/2011**

“1. An apparatus for a checkpoint having a passage lock whose exit is closed by an exit door (gate) which opens in response to a signal from at least one biometric unit which is arranged in the lock area and is intended to detect biometric features of a person desiring passage, characterized in that [FEATURE A] *the biometric unit (8) is arranged frontally opposite the entrance to the lock area (3),* [FEATURE B] *wherein the exit door (5) of the lock area (3) consists of at least one pivoting wing (5) in a known manner, and in that the biometric unit (8) is integrated in the at least one pivoting wing (5).”*

3.4 The appellant submits the following figures (corresponding to that on records, only colours added) for further clarity in the matter:



### **3.5 Reasoning of the Respondent in Impugned Order**

*The difference of the present application over the cited documents is, the placing of biometric unit and the arrangement which is placed frontally opposite the entrance to the lock area, the feature claimed is obvious to the person skilled in the art at the time of the present invention to place the biometric unit face-on against the entrance.*

*Hence the subject matter of claims as claimed in instant invention falls under Section 2(1)(j) of The Patents Act, 1970 (as amended).*

3.6 It is submitted that the Respondent has considered only FEATURE A while assessing inventive step u/s 2(1)(j)(a) of the Indian Patents Act. The Respondent has held that only FEATURE A is obvious to a person skilled in the art and has nowhere mentioned FEATURE B in his entire impugned order.

3.7 That the Respondent has based his impugned order on incorrect findings with respect to Inventive Step u/s 2(1)(j)(a) since at least one or the novel and inventive feature, i.e., FEATURE B has been omitted while assessing inventive step of the present invention.

3.8 Therefore, for the aforesaid reasons alone, the impugned order should be set aside.

4. It's important to have a look in the prosecution history of the instant application at Indian Patent office (IPO). We have reviewed the First Examination Report (FER) issued on 20/03/2017, in this application, by the respondent.

5. The FER finds mention of three citations namely, 1. WO 1999006928 A1, 2. EP 1347420 A2 and 3. HK 1053528 A1 and shows the following main objections:

*A. Novelty*

*(i) Claim(s) 1-3 lack(s) novelty, being anticipated in view of disclosure in the document cited above under reference for the following reasons:*

*1. D1 is found as closest prior art to the alleged invention which discloses an apparatus for a checkpoint (see 102 in fig.1a, para [0042] and abstract of D1) having a passage lock whose exit is closed by an exit door (gate) which opens in response to a signal from at least one biometric unit which is arranged in the lock area (see 122 in fig.1a, para [0050] and abstract of D1) and is intended to detect biometric features of a person desiring passage, characterized in that the biometric unit (8) (see 112 in fig.1a and para [0043] of D1) is arranged frontally opposite the entrance to the lock area (3) (see 122 in fig.1a para [0050] and abstract of D1). Also see figures 1b, 7-8b, 9c; page 3, lines 27-29; page 9 of D1). Since all the essential features of claim 1-3 are disclosed by the cited document D1 hence alleged invention lacks novelty under section 2(1)(j) of The Patent Act, 1970 (as amended).*

*2. It is furthermore pointed out that even if the aforementioned novelty objections above were disputed based on minor differences of interpretation between some of the features of claim 1 and the features of document D1, the subject-matter of claim 1 would still not involve the required inventive step, considering that document D1 aims at the same object as the present application and discloses the same type of solution.*

*3. D2 provides an another solution for the same type of problem, discloses a device is arranged at the narrowest point of each stadium entrance and has left and right posts (3) with a rotary gate (2) between them controlled by a scanner (5) on one post with a recess (6) for inserting a finger and a*

slot (7) for a chip card and the ability to identify the finger and/or the fingerprint stored on the card. This is the reverse process of checkout from a station or stadium and same type of authentication method is used as in alleged invention. Hence alleged invention is not novel with respect to D2 also (abstract and claims).4. D3 also discloses another solution of the same type of problem a system and a method for automatically controlling the crossing of a border, comprising a personal data acquisition device, a biometric data acquisition device, a personal data transfer device, a data storage device, a pass-through system (10), a separating device, a data reading device, an authenticity checking device, a data manipulation checking device, a device for opening the entrance (12) of the pass-through system (10), a biometric data acquisition device, a comparing device, a device for triggering an alarm, a personal data transfer device and a device for opening the exit of the pass-through system (10). Hence claim 1-3 alleged invention are not novel with respect to D3 (abstract and claims

**B. INVENTIVE STEP:**

(ii) Claim(s) 1-19 lack(s) inventive step, being obvious in view of teaching (s) of cited document(s) above under reference for the following reasons:

Dependent claims 4-19 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the inventive step in respect of cited documents D1-D3.

**C. NON PATENTABILITY:**

(iv) Claim (s) 1-19 are statutorily non-patentable under the provision of clause (3(f)) of Section 3 for

Alleged invention claimed in claims 1-19 in prima facie appears as mere arrangement or rearrangement of known devices each functioning independently of one another in a known way. Hence it

*fall u/s 3(f) of The Patents Act, 1970 (as amended), thus not patentable.*

*D. SUFFICIENCY OF DISCLOSURE:*

*(viii) Claim(s) 1-19 are not fairly based on the matter disclosed in the specification or not supported by the disclosure in the specification for the following reasons:*

*The claims fail to disclose the interaction among the devices and interfacing with each other to obtain the relevant result.*

6. The hearing Notice issued on 09/09/2019 shows the following objections:

*A. Invention u/s 2(1)(j)*

*1. Objections regarding novelty and inventiveness of claims are still valid as no compliance has disclosed by the applicant.*

*2. Amended claims 1-19 are not novel and not patentable under section 2(1)(j) of The Patent Act. Amended claims 1-19 are not inventive therefore not patentable under section 2(1)(ja) of The Patent Act (as amended) in the view of the following documents:*

*D1:WO9906928;D2: EP 1347420 A2; D3: HK 1053528 A1;*

*D4:WO2005119601 (abstract \*\* figure 1 \**

*\* page 2, line 1 - page 6, line 8 \*); D5:US2007122011(\**

*abstract \*\* paragraph [0032] - paragraph*

*[0059]; figures 1-13 \*)*

*B. Formal Requirement(s)*

*1. 1. The requirement of filing proof of right as required under section 7(2) of the Patents Act has not been met.*

7. Let's now look at the operating portion of the order of the respondent:

*“On 10/10/2019 hearing was attended by Mr. Sachin Manocha patent agent for the applicant. During hearing the agent argued for the application and sought permission to file written submission*

*which was allowed. Accordingly the agent filed a written submission on 19/11/2019. Having considered the submission, I find that, some of the requirements (reg: Inventive step) of hearing notice are not considered met.*

*Therefore, it is hereby decided to proceed for the refusal of a patent for application no. 1332/MUMNP/2011 based on the following decision.*

*The difference of the present application over the cited documents is, the placing of biometric unit and the arrangement which is placed frontally opposite the entrance to the lock area, the feature claimed is obvious to the person skilled in the art at the time of the present invention to place the biometric unit face-on against the entrance.*

*Hence the subject matter of claims as claimed in instant invention falls under Section 2(1)(ja) of The Patents Act, 1970 (as amended).*

*Having considered the amended claims and aforesaid submission, I find the amendments and submission did not meet the requirements. I find that amended claims submitted along with hearing written submission dated 19/11/2019 do not meet the requirement of section 2(1)(j) of the Act.*

*In view of aforesaid, the objections raised vide the hearing notice dated 10/10/2019 have not been met. Hence, I hereby proceed for refuse with the patent application no 1332/MUMNP/2011 under section 15 of the Patents Act, 1970 (as amended).”*

8. The instant application was filed at Indian Patent Office as National Phase application based on Patent Cooperation Treaty (PCT) International Application No. PCT/DE2009/000014.
9. As evident from the FER that claims 1-3 of the instant application were objected to for lack of ‘novelty’ based on three documents D1. WO 1999006928 A1, D2. EP 1347420 A2 and D3. HK 1053528 A1. With regard to ‘inventive step’, the FER mentioned that “*Dependent claims 4-19 do not contain any features which, in combination with*

*the features of any claim to which they refer, meet the requirements of the inventive step in respect of cited documents D1-D3.”*

10. The Hearing notice further added two more citations to those shown in FER, i.e. D4.WO2005119601 & D5. US2007122011 and objected all the claims for lack of “inventive step”. However, the order/decision of the respondent only relies on D1, D4 and D5 i.e. D1. WO 1999006928 A1, D4.WO2005119601 and D5. US2007122011 for lack of ‘inventive step’. His order is silent on lack of “novelty”, which was mentioned in hearing notice. It is indicative that he found the invention to be ‘novel’. Since the application has been refused only on the ground of ‘inventive step’, we will confine our discussion to this aspect alone.
11. We have scrutinized the International Search Report (ISR) issued by the International Searching Authority (ISA) in the instant application in International Phase. We find that all the 3 documents cited herein the order of the respondent, i.e. D1. WO 1999006928 A1, D4.WO2005119601 and D5. US2007122011 are also part of the International Search Report (ISR).
12. As informed by learned counsel of the appellant the patent has been granted in respect of the corresponding foreign applications in major countries with similar claims such as United States, Australia, Canada, Russia, and Malaysia. They also submit that the details of all these grants have been provided on Form-3 filed on 03/10/2019 at the Indian Patent Office.
13. While it is true that the grant of patents in respect of identical inventions, in some other jurisdiction, has no binding effect on the Indian Patent Office; it is equally true that the consideration of “inventive step” based on identical citations may not vary widely from one jurisdiction to another.

14. We have noted that the respondent while assessing the 'inventive step' just hold that *'The difference of the present application over the cited documents is, the placing of biometric unit and the arrangement which is placed frontally opposite the entrance to the lock area, the feature claimed is obvious to the person skilled in the art at the time of the present invention to place the biometric unit face-on against the entrance.'*

*Hence the subject matter of claims as claimed in instant invention falls under Section 2(1)(ja) of The Patents Act, 1970 (as amended)."*

15. It is evident that this 'inventive step' assessment by the respondent is by no way an objective assessment and appears to be a passing comment. He has neither given any reasoning nor applied the test of determination of 'inventive step' as provided even in the Manual of Patent Office Practice and Procedure<sup>1</sup>, leave aside the various judicial pronouncement on the subject.

16. It is well settled principle of the law that *"The 'obviousness' has to be strictly and objectively judged."*<sup>2</sup>. As the order of refusal on the ground of lack of 'inventive step' fails on objective assessment.

17. It is further noted that on receipt of non- favorable International Search Report (ISR) the appellants have amended the claims. The appellant while amending the claims incorporated the originally filed feature of claim 2, in claim 1. Further, they added one new claim 19, making it dependent on claim 1.

---

<sup>1</sup> Available at <http://www.ipindia.nic.in/manual-patents.htm>

<sup>2</sup> Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries on 13 December, 1978 ; Available at <https://indiankanoon.org/doc/1905157/>

18. There is no indication that the respondent did not allow these amendments. He has based his order on the amended set of claims, which is indicative that he allowed the amendments. The patent has been refused on the sole ground of lack of inventive step. It is apparent vide his assertion in his order that *“Having considered the submission, I find that, some of the requirements (reg: Inventive step) of hearing notice are not considered met.”*

19. Amended claim 1 has two features in its “characterized” clause as explained in earlier paragraphs. The respondent has commented, though not objectively, on only the first one, ignoring the other completely. The invention has to be considered as a whole for consideration of inventive step. It is thus not sufficient to draw the conclusion that a claimed invention is obvious merely because individual parts of the claim taken separately are known or might be found to be obvious. Therefore arriving at the conclusion that the invention lacks ‘inventive step’ based on incomplete facts and being void of any reasoning is not sustainable in the eye of law.

20. Therefore, keeping in view the above facts and circumstances, we set aside the impugned order of respondent dated 20/02/2020.

21. The respondent is directed to grant the patent on the invention as described and claimed in claims 1-19, strictly within 3 weeks from the issuance of this order.

22. Appeal is allowed. No cost.

-Sd/-

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

-Sd/-

**(Justice Manmohan Singh)**  
**Chairman**

Disclaimer: This order is being published for present information and should not be taken as a certified copy issued by the Board