



IPAB Intellectual Property Appellate Board

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OA/55/2014/PT/MUM

MONDAY, THIS THE 9TH DAY OF NOVEMBER, 2020

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

**CHAIRMAN
TECHNICAL MEMBER (PATENTS)**

1. REAXA LIMITED
A UNITED KINGDOM COMPANY
AT 112 HILLS ROAD, CAMBRIDGE,
CAMBRIDGESHIRE CB2 IPH

---- Applicant

(Represented by - Ms Payal Kalra)

1. THE CONTROLLER GENERAL OF PATENTS & DESIGNS
PATENT OFFICE, INTELLECTUAL PROPERTY
OFFICE BUILDING, CP-2, SECTOR V,
SALT LAKE CITY,
KOLKATA-700 091

2. THE ASSISTANT CONTROLLER OF PATENTS & DESIGNS
PATENT OFFICE, BOUDHIK Sampada Bhavan,
S.M.ROAD, NEAR ANTOP HILL HEAD
POST OFFICE, MUMBAI - 400 037

3. THE EXAMINER OF PATENTS & DESIGNS
PATENT OFFICE, BOUDHIK Sampada Bhavan,
S.M.ROAD, NEAR ANTOP HILL HEAD
POST OFFICE, MUMBAI - 400 037

-- 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 08/09/2011, passed by the

Respondent, being the Assistant Controller of Patents & Designs, under Section 15 of the Indian Patents Act, refusing to grant the Appellant's Indian patent application no. 1135/MUMNP/2003.

2. The invention

The appellant explains their invention as under:

2.1 Object of the Subject Invention

The subject invention relates to a catalyst system comprising a catalyst microencapsulated within a permeable polymer microcapsule shell. In particular, the microencapsulated catalyst has the microcapsule shell formed of a polyurea microcapsule prepared from at least one polyisocyanate with or without at least one tolylene diisocyanate.

2.2 Technical Problem of the Prior Art

Catalysts, such as transition metal catalysts, are widely used in a variety of chemical reactions. Difficulties are frequently encountered on the commercial scale, in recovering and re-using the catalyst, which in turn results in potential contamination of the product and also represents a significant cost burden in terms of usage of expensive catalyst.

2.3 Technical problem Addressed by the Subject Invention

The above technical problems of the prior art are duly addressed by the subject invention. The microencapsulated catalytic system claimed by the Appellant is resistant to the leaching of catalysts from the microcapsule due to the unique morphology of the claimed catalytic system.

3. The case of the Appellant

3.1 It is the case of the Appellant that Respondent no. 2 erroneously refused the application on the ground of lacking inventive step under Section 2(1)(j) in view of prior arts D1 to

D7, which resulted in vitiation of his decision. Respondent No. 2 cited the following documents D1 (US 3954666), D2 (US 4285720), D3 (US 6020066), D4 (US 4564479), D5 (US 6362357), D6 (US 2002/0045775) and D7 (US 5332584) to support his stance on inventive step.

3.2 From the impugned order, it is apparent that Respondent No. 2 has misdirected himself in the appraisal and appreciation of the submissions made by the attorneys for the Appellant during the oral hearing and in their various correspondences addressed to Respondent No. 2, and this resulted in vitiation of the decision.

3.3 **Respondent No. 2 failed to appreciate the notable distinguishing features of the present invention over the prior art-**

1. None of the cited prior art disclose a catalyst encapsulated within a polyurea microcapsule prepared from at least one polyisocyanate with or without at least one tolylene diisocyanate.

2. None of the cited prior art disclose a catalyst system where the catalyst is distributed substantially throughout a polymer matrix bead.

3. None of the prior art discloses a catalyst which is encapsulated in a permeable cross-linked polymer matrix bead, which is a particle having a finely divided solid or liquid distributed throughout the polymeric bead. This feature is distinguished from the systems described in many of the prior art documents (for example D1) where the solid or liquid catalyst is contained within an inner cavity bounded by an integral polymer outer shell.

4. None of the cited prior art discloses a coordination between the catalyst and the polymer forming the bead that retains

the catalyst within the bead for catalytic contact with chemical reactants present in, for example, an organic liquid.

3.4 **Respondent No. 2 failed to determine the scope and content of the prior art to which the invention pertains**

D1 (US 3954666) discloses a microcapsule containing a polymeric shell with the catalyst material suspended within a separate phase inside the polymer shell. For example, D1 (column 7, lines 13-22) disclose that the catalyst is disposed in a medium of water or organic solvent inside a semi-permeable polymer skin. This is further illustrated by D1 in column 5, lines 33-35 which disclose that the microcapsules are filled with solvent, with solid catalyst particles contained within the solid inside the polymer shell. D1 does not disclose that the catalyst is or could be distributed throughout the entirety of the microcapsule. Furthermore, D1 does not disclose any coordination between the catalyst and the polymer because the catalysts and the polymer are in separate phases and, therefore, coordination could not occur.

D2 (US 4285720)- Document D2 (US 4285720) differs from the claimed invention in at least the following three ways. Firstly, D2 discloses microcapsules that are used for containing liquid pesticides. In contrast, the microcapsules of the claimed invention comprise catalysts not pesticides. Secondly, the liquid pesticides of D2 are trapped within the microcapsule polymer skin (for example, in D2, figures 4 to 6, which depict that the structure of the microcapsule is of the core-shell type). In contrast, the catalysts of the present invention are distributed throughout the polymeric bead and are not trapped with a core. Thirdly, D2 discloses that the microcapsules are designed to facilitate controlled release of the contents of the microcapsule core (for example, column 5,

lines 26 to 27 and column 8 lines 26 to 29 of D2). This teaching is incompatible with the present invention because the present invention is directed to a polymer that would retain catalyst within the bead through coordination between the catalyst and the polymer bead.

The examples of the encapsulated material in D2 include herbicides and insecticides (as indicated in column 8, lines 14 to 29). It is clear that this document does not relate in any way to the encapsulation of a catalytic material.

D3 (US 6020066)- The Appellant submits that the document D3 (US 6020066) differs from the claimed invention in at least the following two ways. D3 discloses microcapsules containing liquid colour formers. In contrast, the microcapsules of the claimed invention comprise catalysts and not colour formers. Secondly, the microcapsules of D3 are in the form of core-shell microcapsules (for example column 1, lines 18-28 of D1). D3 discloses a number of different formulations of leak-proof microcapsules that exhibit containment of the liquid colour formers (for example column 10, lines 40-48 of D3). These passages teach leak-proof microcapsules that contain liquid colour formers within a polymer shell. In contrast, the catalysts of the present invention are distributed throughout the polymeric bead.

3.5 Accordingly, the Appellant does not believe that the skilled person would have come across document D3 since the skilled person would not have been prompted to search in this unrelated technical field.

3.6 D4 (US 4564479), D5 (US 6362357) and D6 (US 2002/0045775)- It is further submitted that the documents

D4, D5 and D6 do not disclose microcapsules instead they disclose catalytic systems involving palladium catalysts. The documents D4, D5 and D6 do not disclose that the catalyst can be encapsulated and they certainly do not disclose that the catalyst can be distributed throughout the entirety of a microcapsule.

3.7 D7 (US 5332584)- The Appellant submits that D7 differs from the claimed invention in at least the following three ways, Firstly, D7 discloses microcapsules that are used for containing water insoluble liquid material, such as herbicides. In contrast, the microcapsules of the claimed invention comprise catalysts, not herbicides. Secondly, the liquid material of D7 is encapsulated within a porous shell (for example, abstract of D7). In contrast, the catalysts of the present invention are distributed throughout the polymeric bead. Thirdly, D7 discloses that the microcapsules are designed to achieve a slow rate of release of the contents of the microcapsule shell (for example, D7 abstract). This teaching is incompatible with the present invention because the present invention is directed to a polymer that would retain catalyst within the bead.

3.8 As per the submission of the appellant, even the combined teachings of D1 to D7 failed to suggest the present Invention

3.9 As agreed by Respondent No. 2, the closest prior art document is D1 and it differs from the claimed invention in at least three ways. Firstly, the microcapsule of D1 is not a polyurea microcapsule prepared from at least one polyisocyanate with or without at least one tolylene diisocyanate. Secondly, D1 does not disclose a catalyst system wherein the catalyst is distributed substantially

throughout the polymer matrix bead. Thirdly, the microcapsule structure disclosed in D1 has the catalyst and polymer shell in separate phases and therefore, the catalyst and polymer shell cannot be coordinated. There is no teaching in D1 which would incite the skilled person to modify the microcapsules of D1 to arrive at the subject matter of the claimed invention. It is difficult to see why the skilled person would be motivated to modify the microcapsules of D1 in the absence of any teaching to do so. Hence, the amended claims include an inventive step relative to D1.

3.10 D3 discloses microencapsulation of colour formers for use in the production of carbonless copying paper. In order to produce carbonless copying paper, a coating of microencapsulated colour former is applied to a sheet of paper, and a developer is applied to the subsequent sheet. When pressure is applied by writing, the microcapsules break and the colour former is released. Accordingly, it is important that the microcapsules are leak proof so that the colour former inside of the microcapsules cannot contact the paper until the microcapsule breaks and releases it. D3 teaches that it is important that the microcapsules disclosed therein are leak-proof. In this regard, the attention of the Hon'ble Board is invited to column 10, lines 53-58 which state:

3.11 Examples 3 to 11 demonstrate that leak-proof, non-agglomerated microcapsules may be produced using the interfacial polyaddition process from the isocyanates to be used according to the invention alone or mixed with other isocyanates, which microcapsules are particularly suitable for the production of carbonless copying papers”.

3.12 Accordingly, the skilled person would not be motivated to modify the microcapsules of D1 with the teaching of D3, since D3 teaches that the microcapsules are leak proof. As such, the skilled person would expect that the microcapsules are impermeable to reaction mixture. These teachings of the prior art are incompatible and cannot be combined.

3.13 D2 discloses microencapsulation of herbicides or insecticides. The attention of the Hon'ble Board is invited to D2 column 1, lines 11-14 and lines 33-35, which state:

“This invention relates to encapsulation and particularly to the production of small or minute capsules constituted by a skin or a thin wall of organic composition enclosing a body of material such as a liquid”.

3.14 D2 teaches that the herbicides or insecticides are preserved inside the microcapsule until the microcapsule breaks. Accordingly, the skilled person would not be motivated to modify the microcapsules of D1 with the teaching of D2 since D2 teaches that the catalyst could only make contact with the reaction mixture in the event that the microcapsule were to break. This is incompatible with the present invention where the catalyst is retained inside the microcapsule and the reaction mixture can enter and leave the microcapsule.

3.15 In light of the above comments, it is clear that there is a prejudice in the art against using a polyurea microcapsule prepared from at least one polyisocyanate and/or tolylene diisocyanate in combination with a catalytic system. This is because the skilled person is lead to believe that such a microcapsule would be impermeable to reaction mixture and,

therefore, incompatible with a catalytic system where the catalyst is encapsulated inside the microcapsule. Thus, the skilled person would not contemplate modifying the polymer shell of D1 with the teaching of D3 or D2 since there would be no reasonable expectation of success.

3.16 There is further no teaching in any of the cited prior art that would incite the skilled person to combine D1 with any of D2 to D7, since D2 to D7 are not directed to encapsulated catalysts. Even if the skilled person were to combine D1 with any of D2 to D7, such a combination would not result in the subject matter of the claimed invention.

3.17 **The impugned order passed by Respondent no. 2 contravenes the well-established juridical precedents -**

3.18 The appellant has referred to the case law and submits that the test of obviousness is set out by the Hon'ble High Court of Delhi in the matter of Hoffmann-La Roche Limited & Anr. Vs. Cipla Limited [I.A. 642/2008 IN CS (OS) 89/2008], wherein the Court held, "the test of obviousness is: (i) whether, in the light of prior art, it was possible for a normal, but unimaginative person skilled in the art, to discern the inventive step of the invention on the basis of general common knowledge of prior art on the priority date, (ii) whether the difference between the prior art would, without knowledge of the alleged invention, constitute steps that could have been obvious to the skilled man or whether they required any degree of the answer to the question is yes, then the invention is said to have inventive step."

3.19 Hence, the knowledge at the date of priority should be considered to ascertain whether the prior references give any direction or motivation to reach the claimed invention, rather than reading the invention first, and then deriving a reverse

path to bridge the gap between the existing knowledge and the alleged invention. The allegation of lack of an inventive step should not be based on the hindsight of disclosure of the subject invention after the priority date. In this regard, Respondent No. 2 has picked and choose certain elements from prior references based on the hindsight. Accordingly, refusal of the subject invention on the ground of lack of inventive step is erroneous and should be rejected.

3.20 Reliance is also placed in the matter of Enercon (India) Limited, v. Aloys Wobben, ORA/08/2009/PT/CH, ORDER (No. 123 of 2013). The Hon'ble IPAB in paragraph 43 held:

Para 43: "The mere existence in the prior arts, of each of the elements in the invention, will not ipso facto mean obviousness. For after all most inventions are built with prior known puzzle-pieces. There must be a coherent thread leading from the prior arts to the invention, the tracing of the thread must be an act which follows obviously. We must apply this reasoning to test if indeed it is obvious, or if it seems to us to be obvious to the person skilled in the art because of what we know now. If it is the latter, it is hindsight deduction and is not acceptable, but if it is the former, then the patent must go"

3.21 Thus, framing a case of obviousness fully on hindsight analysis is prohibited in law.

3.22 In contravention of the above-mentioned juridical precedents, Respondent No. 2 has refused the subject application stating that

"One having ordinary skill in the art at the time the invention was made would have found it obvious to utilize the catalyst of D1, D2, D3 in the processes as taught by D4, D5 and D6, since

microencapsulated catalysts are expected to have the same utility as their nonmicroencapsulated version”.

3.23 Such an opinion of Respondent No. 2 is based on hindsight analysis and does not justify or take into account the knowledge that a person of ordinary skill would have at the time of conception of the invention. Respondent No. 2 has failed to appreciate the technical advantages and technical effect achieved by the subject invention as mentioned hereinabove.

3.24 **Grant of the corresponding Foreign Applications**

Respondent No. 2 failed to appreciate the fact that patents have been granted in the several countries such as Japan, China, Singapore. Also, the patents have been granted in US and EP which are considered as jurisdictions with strict and advanced patent regimes. It is respectfully submitted that Respondent No. 2 has failed to discharge the burden to show that the grants of Patents in the aforementioned jurisdictions were wrong. Moreover, it is emphasized that when the Appellant has advanced persuasive submissions towards the inventive step of the invention further supplemented by the grant of corresponding applications in various countries, Respondent No. 2's conclusion that the application does not involve an inventive step is not tenable and ought to be set aside.

4. The prosecution of patent application at IPO is briefly shown herein below:

4.1 The First Examination Report (FER) was issued on 11/07/2007 with following objections:

1. *As per ISR and IPER, claims 1, 2, 6-11, 17, 22-26 lack in novelty and inventive step and hence are not allowable u/s 2 (1) (j) of The Patents Act, 1970.*

2. *Claims 11 and 17 should be made dependent on claim 1.*

3. *Characterization part in claim 16 does not relate to the main inventive concept.*

4.2 The applicants/appellant submitted the response to the FER on 23/01/2008 with amended set of claims as showed the consistency of the amended claims as shown below:

- Revised claim 1 is supported by original claims 2 and 3
- Revised claim 2 is supported by original claim 3
- Revised claim 3 is supported by original claim 4
- Revised claims 4 to 9 are supported by original claims 5 to 10 respectively
- Revised claim 10 is supported by original claims 12 and 13
- Revised claim 11 is supported by original claim 12
- Revised claim 12 is supported by original claim 13
- Revised claim 13 to 16 are supported by original claims 14 to 17
- Revised claims 17 to 20 are supported by original claims 22 to 25
- Revised claims 21 to 26 are supported by original claims 27 to 32

4.3 A hearing notice having the following objection was sent by the respondent no. 2 on 14/03/2011 :

“1. Invention claimed in any of the claims is not novel and does not involve an inventive step.

Documents of particular relevance are (i) D1: US 3, 954, 666; (ii) D2: US 4, 285, 720; (iii) D3: US 6,020,066; (iv) D4: US 4,564,479; (v) D5: US 6,362,357; (vi) US 2002/0045775 and (vii) D7: US 5332584. The claims are so generic that a number of documents overlap with the scope of the claim available in

the file. The applicant is advised to get a thorough report with detailed explanation from USPTO wherein prosecution corresponding to the instant application is under way.

2. The applicant is advised to furnish the information relating to the objections, if any, in respect of the novelty and patentability of the invention including the claims of the application allowed of the corresponding application prosecuted before European Patent Office and USPTO within prescribed period under Rule 12(3) of Patents Rule 2003, as amended.”

5. The requirement of foreign filing particulars at IPO is governed by section 8 of the Patents Act, 1970. Let's look at the relevant provisions of the law:

Section 8¹

Information and undertaking regarding foreign applications

....

(2) At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of a patent made thereon, the Controller may also require the applicant to furnish details, as may be prescribed, relating to the processing of the application in a country outside India, and in that event the applicant shall furnish to the Controller information available to him within such period as may be prescribed.

“Rule 12

Statement and undertaking regarding foreign applications

....

*(3) When so required by the Controller under sub-section (2) of section 8, the applicant shall furnish information relating to objections, if any, **in respect of novelty and patentability of the invention** and any other particulars as the Controller may require which may include*

¹ Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps8.html>

claims of application allowed within six months from the date of such communication by the Controller.” [Emphasis Added]

6. We would also like to refer to the relevant portion on Information and undertaking regarding foreign applications of Hon’ble Justice Ayyangar Committee Report on Patents² based on which the Patents Act. 1970 was formulated:

“Clause 7A—Information and undertakings regarding foreign applications

350. In addition to the documents set out in Clause 7 (2) it would be useful to require the applicant to furnish the following further information. The majority of the applicants for patents in India are foreign nationals and in several cases the application in India is for the same or substantially the same invention as that for which an application for patent has already been made by them in other countries. It would be of advantage therefore if the applicant is required to state whether he has made any application for a patent for the same or substantially the same invention as in India in any foreign country or countries, the objections, if any, raised by the Patent Offices of such countries on the ground of want of novelty or unpatentability or otherwise and the amendments directed to be made or actually made to the specification or claims in the foreign country or countries upto the date of acceptance of the application. This matter acquires added importance by reason of the change which I have suggested in the content of the publications which should constitute anticipation to deprive an invention of novelty. As publication abroad before the relevant date would also constitute anticipation, this information would be of great use for a proper examination of the application.”

² Available at

http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/1959_Justice_N_R_Ayyangar_committee_report.pdf

7. The whole concept of calling for this information, as envisaged in the report, is that *“this information would be of great use for a proper examination of the application.* Further failure to provide proper information was included as a ground of refusal under section 25(1) & section 25(2) and revocation of patents under section 64 of the Patents Act, 1970.
8. The whole idea for asking for this report from the applicant was for proper examination of a patent application and if failure on the part of the applicant attracts refusal or revocation, what if the report is favorable to the applicant in those jurisdictions on “novelty” and “inventive step”?
9. It is worth noting that the respondent no.2 has relied on 7 citations for proving lack of ‘inventive step’ and asked the appellant to get a thorough report with detailed explanation from USPTO and also submit the details of patent prosecution in EPO and USPTO.
10. We have reviewed the prosecution history of the corresponding application in USPTO. We found that all these citations were relied for inventive step determination at USPTO, as evident from the details shown below:
11. Documents cited by the Controller
 - D1. US000003954666A –ISR; Also Indicated by the applicant (Information Disclosure Statement IDS)
 - D2. US000004285720A – Indicated by the applicant
 - D3. US000006020066A - Indicated by the applicant
 - D4. US000004564479A –US Search Report
 - D5. US000006362357B1 – US search Report
 - D6. US020020045775A1 – US Search Report
 - D7. US000005332584A – Indicated by the applicant
12. While the citations D4-D6 were searched by USPTO, the rest were indicated to them by the applicant themselves. All these documents were referred to, during the search and finally the US patent was

granted with Patent No. US8828902B2 on identical citations that referred to in the instant case here. Further the instant patent was granted in EPO as well with patent no. EP1409125B1.

13. We have also noted that the applicant also indicated prior art documents US Patent 4,956,129 , US Patent 5,332,584, U.S. Patent 4,285,720 and U.S. Patent No 6,020,066 at IPO too, in their complete specification and narrated how they differ from the teaching of the their invention.

14. As every patent office performs the examination independent to each other, there may be possibility that they find different citations for determination of novelty of inventive step. If the information in respect of other office is available, the possibility of missing out some important document is eliminated. The idea is not to ignore any of the citations and arrive at a better search and examination report, considering every available record.

15. We fully affirm that the report of other jurisdiction has no binding effect on the examination and search conducted by Indian Patent Office. Let's confine our discussion to determination of "novelty" and "inventive step" alone. If the documents searched are different and the facts considered are different, the assessment of 'novelty' and 'inventive step' may be different. Further, if the documents are same but cited portions of the documents vary; still there is possibility of different opinion at different jurisdictions. But if the identical citations are referred to, in various jurisdictions, the decision of 'novelty' and 'inventive step' is ordinarily not expected to differ widely unless some other facts are also in the consideration zone. However, in case of identical citations, if the examiners/Controllers have a different view, than that taken in other jurisdiction, which

they are at liberty to have, as per the law, the reason for such difference is expected to be mentioned in the order for ensuring fairness. This is somehow lacking in this case.

16. Let's look at the operating part of the order of the Respondent no. 2

“Contrary to the submission of Applicants there is a reasonable expectation of success, since D1 teach that known polymer materials may be utilized (see for example column 2, lines 39-58). D2 and D3 teach polymer materials which are useful for encapsulation.

Thus, one having ordinary skill in the art at the time of the invention was made would not expect the microcapsule of D1 made with the materials of D2 and D3 to rupture upon use.

....

After having considered the submissions submitted by the applicant in the hearing, the written submission and amended claims on record, in view of the above discussions and findings of the undersigned, it is hereby ordered that the invention disclosed and claimed in the instant patent application possessing the title "MICROENCAPSULATED CATALYSTS, METHODS OF PREPARATION AND METHODS OF USE THEREOF " is lacking an inventive step and obvious to a person skilled in the art and I therefore, hereby refuse this Application No. 1135/MUMNP/2003 to proceed further.”

17. In Biswanath Prasad Radhey Shyam³ case Hon'ble Supreme Court held that *“Whether an alleged invention involves novelty and an 'inventive step', is a mixed question of law and fact, depending largely on the circumstances of the case.”* . The provisions of law is well defined in section 2(1) (ja) of the Patents Act, 1970. Which reads as *“(ja) "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or*

³ Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries cited as AIR 1982 SC 1444

having economic significance or both and that makes the invention not obvious to a person skilled in the art;”.

18. The procedures of determination of “inventive step” are well developed in India both through previous orders of this Board, through judicial pronouncements and also through various guidelines and Manual formulated by the Indian Patent Office. The case of Enercon (India) v. Alloys Wobben⁴, F. Hoffmann-La Roche Ltd, vs Cipla Ltd⁵, Guidelines for examination of patent applications in the field of Pharmaceuticals⁶, Guidelines for Examination of Computer-related Inventions (CRIs)⁷ and Manual of Patent Office Practice and Procedure⁸ are some of the documents in which test of inventive step has been widely discussed.

19. Hon’ble Supreme Court in Biswanath Prasad Radhey Shyam⁹ further held that:

“Another test of whether a document is a publication which would negative existence of novelty or an “inventive step” is suggested, as under: —“Had the document been placed in the hands of a competent craftsman (or engineer as distinguished from a mere artisan), endowed with the common general knowledge at the ‘priority date’, who was faced with the problem solved by the patentee but without knowledge of the patented invention, would he have said, “this gives me what I want?” (Encyclopedia Britannica; ibid). To put it in another form: “Was it for practical purposes obvious to a skilled worker, in the field concerned, in the state of knowledge existing at the date of the patent to be found in the literature then available to him, that he

⁴ M.P.Nos. 14/10,34/10 and 79/10 in ORA No.11/2009/PT/CH &ORA No.11/2009/PT/CH

⁵ Available at <https://indiankanoon.org/doc/123231822/?type=print>

⁶ Available at <http://www.ipindia.nic.in/guidelines-patents.htm>

⁷ ibid

⁸ Available at <http://www.ipindia.nic.in/manual-patents.htm>

⁹ Supra 3

would or should make the invention the subject of the claim concerned ?"

20. We have analyzed the order of respondent no.2 and found that "inventive step" has not been assessed as a mixed question of law and facts and in accordance with the teachings of the previously quoted settled practices. The facts are chosen selectively and such facts do not suggest that the "person skilled in the art" will arrive at the invention with the individual or combined teachings of the prior art D1 to D7. Hence the impugned order of the respondent no. 2 is not sustainable.

21. We have analyzed the claims 1-19 in the amended stage and that suggested by the appellant through their auxiliary request through claims 1-19. We find that some of the features such as "*wherein the polyurea microcapsule has a pore structure and wherein through the pore structure of the microcapsule*" is incorporated in the principal claim which are essential and will surely add up to define the invention in a better way. Further, the steps of **process for the preparation of a microencapsulated catalyst** as mentioned in page 12 of the complete specification is also required to be incorporated in the principal claim, suitably, for proper definition of the process defined therein.

22. We, therefore, set aside the order of respondent no.2 dated 08/09/2011 and direct the learned counsel of the appellant to file amended set in accordance with the requirements, narrated in the previous paragraphs 21 above, to the respondent no. 2, within 2 weeks from the issuance of this order.

23. The respondent no. 2 is directed to grant the patent on amended claims 1-19, strictly within two weeks from the date of filing of the amended set of claims by the appellant.

24. Appeal is allowed with above conditions. No cost.

-Sd/-

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

-Sd/-

(Justice Manmohan Singh)
Chairman

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