



IPAB Intellectual Property Appellate Board
balancing ip-protection

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OA/7/2016/PT/MUM
MONDAY, THIS THE 12TH DAY OF OCTOBER, 2020

CORAM

HON'BLE SHRI JUSTICE MANMOHAN SINGH : CHAIRMAN
HON'BLE DR.B.P.SINGH : TECHNICAL MEMBER (PT)

PRISM CEMENT LTD

AN INDIAN COMPANY REGISTERED UNDER THE COMPANIES ACT 1956,
HAVING ITS OFFICE AT WINDSOR, 7TH FLOOR,

C.S.T. ROAD, KALINA, SNTACRUZ (E), MUMBAI - 400 098 **APPELLANT**

(Represented by - Mr. Himanshu Kane and Ms. Akshata Kamath of W.S. KANE & CO.)

Versus

THE CONTROLLER OF PATENTS AND DESIGNS BOUDDHIK SAMPADA
BHAVAN, NEAR ANTOP HILL POST OFFICE,

S.M. ROAD, ANTOP HILL, MUMBAI - 400 037 **RESPONDENT**

(Represented by - None)

ORDER

Hon'ble Shri Justice Manmohan Singh, Chairman

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

1. The Appellant has preferred this Appeal under Section 117A of the Patents Act, 1970 against the Order passed by the Respondent dated 18/09/2015, refusing the grant of Patent Application No. 1202/MUM/2005.
2. A brief of various proceedings at Indian Patent office (IPO) are given herein below for reference.

Sl No.	Date / Descriptions	Particulars
1.	27/09/2005	1202/MUM/2005 Filed with Provisional specification
2.	27/09/2006	Complete Specification was filed
3.	Applicant	PRISM CEMENT LTD.
4.	Title	A Process for Manufacturing Isostatic Punch and the Punch Manufactured therefrom
5.	21/08/2008	Request for Examination Date
6.	29/06/2007	Publication Date (U/S 11A)
7.	05/11/2012	First Examination Report (FER) issued
8.	31/10/2013	Reply To FER Date
9.	10/02/2015	Hearing Notice
10.	23/02/2015	Date of Hearing
11.	07/04/2015	Discussion with Controller after hearing (As motioned by the appellant)
12.	18/09/2015	Impugned order
13.	16/12/2015	Appeal to IPAB

3. It is evident that the application was initially filed on 27/09/2005 with provisional specification and the complete specification was filed within the prescribed period of 12 months thereafter, with the following 17 claims:

1. A method of manufacturing an isostatic punch comprising of preparing an inbuilt rubber grid tight-fitting in cavity / cavities of a metal base having opening/s to fill in a viscous liquid at the base of the said inbuilt rubber grid and further rubberizing it with layer/s of rubber.

2. *A method claimed in claim 1 wherein, a mould release spray is applied over the said metal base with the cavity / cavities, before the stage rubberizing the said cavity / cavities making the said inbuilt rubber grid.*
3. *A method claimed in claim 1 wherein, valve/s are provided in the cavities having opening/s used to fill in viscous liquid at their base, to prevent blocking of the said opening/s.*
4. *A method claimed in claim 3 wherein, the valves are adhered to the said inbuilt rubber grid to maintain bi-directional flow, of the viscous liquid.*
5. *A method claimed in claim 3 wherein, the thickness of the said valves is between 0.5 mm and 1 mm.*
6. *A method claimed in claim 1 wherein, the ratio of cavity area to non-cavity area of the said metal base is between 35:65 and 40:60.*
7. *A method claimed in claim 1 wherein, the said inbuilt rubber grid has hardness between 90 and 95 shores.*
8. *A method claimed in claim 1 wherein, adhesive is applied over the metal base prior to subsequent rubberizing process/es.*
9. *A method of manufacturing an isostatic punch substantially as herein described.*
10. *An isostatic punch made by a method claimed in any one of the claims 1 to 8.*
11. *An isostatic punch, comprising of an inbuilt floating rubber grid tight-fitting in one or more cavities of a metal base having opening/s to fill in viscous liquid at the base of the said inbuilt rubber grid and further rubberized with layer/s of rubber.*
12. *An isostatic punch as claimed in claim 11 wherein, valve/s are provided in the cavities of the said metal base having opening/s at*

their base to fill in a viscous liquid, to prevent blocking of the said opening/s.

13. An isostatic punch as claimed in claim 12 wherein, the valve/s are adhering to the said inbuilt rubber grid to maintain bi-directional flow, of the viscous liquid.

14. An isostatic punch as claimed in claim 12 wherein, the thickness of the said valve/s is between 0.5 mm and 1 mm.

15. An isostatic punch as claimed in claim 11 wherein, the ratio of cavity area to non-cavity area of the said metal base is between 35:65 and 40:60.

16. An isostatic punch as claimed in claim 11 wherein, the inbuilt floating rubber grid has hardness between 90 and 95 shores.

17. An isostatic punch substantially as herein described with reference to the drawings accompanying the complete specification.

4. The First examination report (FER) was issued on 05/11/2012 and on submission of the response of the FER by the applicant they amended the claims to retain only 13 claims deleting some of them. However, it has been verified that they retained effectively only 10 claims, as they deleted initially filed claims no. 3,5,6,7,9,10 and 17. Therefore, it was a case of wrong numbering of the claims by the appellant to show it as 13.
5. It is the case of the appellant that vide the said First Examination Report, the Ld. Controller raised objections to the grant of patent inter alia on the ground that the said application prima facie lacks novelty and inventive step in view of the disclosures made in cited prior art documents, D1:US5599566,D2:US5922260,D3:US6558593,andD4:US5330346.

6. The appellant further submits that vide the Hearing Notice, the Ld. Controller informed the Appellant that based on the amended claims filed along with the response to the First Examination Report, the Ld. Controller conducted further search and examination and observed that the Appellant's invention lacks inventive step in view of the disclosures made in newly cited prior art documents D5:US5997273 and D6:EP0620089 in addition to prior documents D1 to D4 cited in the First Examination Report, as stated in the Hearing Notice.

7. The appellants submits that they further amended the claims in order to overcome the objections raised in the Hearing Notice which are as follows:

1. *A method of manufacturing an isostatic punch having cavities of required dimensions connected together with channels on the surface of a base metal plate; oil ports at the bottom of the said base metal plate opening into some of the aforesaid cavities; rubber grid of nearly equal dimensions as of the cavities and channels placed therein; and rubber layer on top of the said base metal plate characterized in that the said method inter alia comprises of the following steps:*

a) Making two or more cavities all connected by open channels, on the surface of a base metal plate;

b) Providing oil ports at the bottom of the said base metal plate opening into at least two of the aforesaid cavities and non-return valves, one each at the mouth of the said oil ports;

c) Applying a mould release solution over the said base metal plate;

- d) Rubberizing a first rubber sheet onto the said base metal plate and the said cavities therein;*
- e) Scraping the excess rubber on the said base metal plate after step (d) above;*
- f) Shot blasting the base metal plate with the rubber in the cavities, made in step (e) above; and*
- g) Rubberizing a second rubber sheet on the base metal plate.*
- 2. A method for manufacturing an isostatic punch as claimed in claim 1 wherein, adhesive is applied on the upper face of each of the said non-return valves opening into the cavities before step (d) and on the base metal plate with rubber grid before step (g).*
- 3. A method for manufacturing an isostatic punch claimed in claim 1 wherein, the said first rubber sheet has hardness between 90 and 95 shores.*
- 4. A method for manufacturing an isostatic punch claimed in claim 1 wherein, the second rubber sheet has hardness between 85 and 90 shores.*
- 5. A method for manufacturing an isostatic punch claimed in claim 1 wherein, the ratio of cavity area to non-cavity area of the said metal base is between 35:65 and 40:60.*
- 6. An isostatic punch, made by the method claimed in claims 1 to 5, comprising of two or more cavities all connected together with open channels on the surface of a base metal plate; oil ports at the bottom of the said base metal plate opening into at least two of the aforesaid cavities; an*

inbuilt rubber grid snugly fitting into the said cavities and channels; and a second rubber layer rubberized on the top of the said base metal plate with inbuilt rubber grid.

8. The hearing was held in front of the respondent on 23/02/2015. As submitted by the learned counsel of the appellant, they placed the amended claims before the Ld. Controller at the hearing scheduled for his consideration. During the hearing, the Appellant through its Attorneys also distinguished the invention as claimed in the proposed amended claims from the invention disclosed or claimed in cited documents D1 to D6 and in particular D5 and D6. Pursuant thereto, the Ld. Controller directed the Appellant to file its written submissions, if any, and a request for amendment of the Complete Specification on Form 13 in the above matter.
9. It is further submitted by the appellant that 02/03/2015, they filed the written submissions in response to the Hearing submissions. Along with the written submissions, the Appellant filed a marked copy and a clean copy of the further amended claims that were presented before the Ld. Controller during the hearing for his consideration, as well as a second clean copy of the amended claims with footnotes giving reference to the relevant pages, paragraphs and figures in the original Complete Specification which supported the amendments made to the claims. In view of the amendments to the claims, the Appellant also made consequential amendments to the Complete Specification.
10. It is further submitted by the appellant that the Controller telephonically called them again on 07/04/2015 for further discussions and issued the impugned order on 18/09/2015.
11. Aggrieved the impugned order the appellant has preferred this appeal to this Board.

12. Let's have a look on the operating portions of the order of the respondent:

New set of claims were filed; which were not submitted in-line with the original filed claims by strictly adhering to section 57/59 of The Patent Act. Claims were filed with form-13. New features added which is added to overcome the cited documents like open channel whereas channel was given in specification only but citation for punch having made from channel to overcome the objection open channel was added whereas open channel was not support in specification. Secondly position of non-return valve is defined in step (b) one each at the mouth of the said oil parts. Where as in specification shows non-return valve are placed at the base of the cavity which at their base the oil ports. Position was added which has not supported by specification. The amendments made by applicant are not allowed in view of Section 57 and 59...

13. The Controller quotes the relevant provisions of sections 57 and 59 of the Patents Act, 1970 and Rule 81 of the Patent Rules 2003 and continues his decision as:

"Hence under section 57 & 59 of The Patents Act, the amendments proposed by the applicants are beyond the scope of invention as filed. Further there are large scale amendments of claims. Hence, amendments were not allowed.

Document EP0620089 teaches method of manufacturing and punch having isostatic punch comprising of two or more cavities connected together with channel on metal plate having cavities containing an incompressible fluid, i. e. oil and elastic membrane at top. Which is same as claimed in claim 6 for isostatic punch. The method for manufacturing is also disclosed comprising steps of making cavities on surface of metal plate and drawing is showing it is open type channel and covered with elastic membrane having oil at bottom of plate and membrane is size

with punch so scraping of excess rubber required. The in one layer is not sufficient for die or thickness of elastic material is less than second layer is required for strengthening of die. Hence, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made to modify EP0620089 with other cited document to add rubberizing and scrapping step. In view of the above, claim does not constitute an invention u/s 2(1)(j)(a) for the lack of inventive step. So, in view of the facts and on the circumstances of the case as above, I hereby refuse this application to proceed further for grant of Patent. Difference of address of service was identified in Form-1 filed and form 18 and P.A. No request for change of address was made. Applicant fails to meet the formal and technical requirements.

Order:

In view of the above and as discussed here objections raised vide this office letter 1202/MUM/2005/MECH/GR/4/966 dated 10/02/2015 remain pending; hence I hereby refuse this application to proceed further for grant of patent.”

14. A close scrutiny of the order of the respondent will reveal that the he has basically raised two issues in his order: (a) that whether the filing of new sets of claims can be allowed under the teachings of Section 57 read with 59 of the Patents Act, 1970 and (b) claim does not constitute an invention u/s 2(1)(ja) for the lack of inventive step.

15. We would like to address these issues in seriatim.

15.1 **Amendment under section 57 read with 59:** Under this sub-heading the respondent specifically mentions two features:

15.1.1 New features added which is added to overcome the cited documents like **open channel** whereas **channel** was given in specification only but citation for punch having made from

channel to overcome the objection **open channel** was added whereas **open channel** was **not support in specification**. [Emphasis Added] and

15.1.2 Secondly **position of non-return valve** is defined in step (b) one **each at the mouth of the said oil parts**. Where as in specification shows **non-return valve are placed at the base of the cavity which at their base the oil ports. Position was added which has not supported by specification**. [Emphasis Added].

16. Learned counsel of the appellant have submitted their argument on these issues which is summarized herein below:

16.1 One the issue to amendments from “channel” to “open channel” they submit as “the feature of open channels is supported by the Complete Specification as originally filed and the same was clearly highlighted by the Appellant by way of footnotes in the clean copy of the amended claims filed along with the written submissions dated 23rd February, 2015. It is submitted that reference to the channels referred to in amended claim 1 can be found in paragraph 1 on page 7 of the Complete Specification as originally filed. The description of channels on the said page is provided with reference to Figs. 1 to 4 as were filed along with the Complete Specification. The relevant lines i.e. 1 to 3 of the said paragraph read as under:

“Referring to the aforesaid figures 1 to 4 a base metal plate (1) has cavities (2)-(2) connected by channels (3)-(3) together forming the cavity network....”

The aforesaid description ought to be read along with Figs. 1 to 4 filed with the Complete Specification.

Further, paragraph 2 on page 9 of the Complete Specification, describes the punch with reference to Fig. 7 wherein the final inbuilt rubber grid (8) is obtained by machining/scraping the excess rubber (9), so that the inbuilt rubber grid (8) tight fits in the cavity network, thereby avoiding any mismatch.

It is submitted that a combined reading of the description of paragraph 1 on page 7 along with Figs.3 and 7 clearly reveal that the channels referred to therein are open channels. Reference may also be given to Figs. 5, 6 and 8 which show that the channels on the base metal plate (1) are open channels. It is submitted that because the channels (3)-(3) are open channels, when the rubber sheet (6) is pressed over the metal base (1) having cavities (2)-(2) connected by channels (3)-(3) in the 1st stage of rubberization of the cavity network, in addition to the cavities (2)-(2), the rubber gets pressed inside the channels (3)-(3) connecting the cavities as well (Ref. Fig. 7). It is submitted that if the channels (3)-(3) were not open channels, the rubber would have been pressed only into the cavities (2)-(2) and not the channels (3)-(3).

It is submitted that since only some of the cavities (2)-(2) are provided with oil ports (4)-(4) at their base (Ref. last paragraph on page 8 and Fig.4 of Complete Specification), the channels (3)-(3) are provided on the base metal plate (1) for interconnecting the cavities (2)-(2) on the plate so as to allow the liquid to flow to all the cavities and help to maintain equal level of oil to all cavities. Owing to the said design of the punch, the isostatic effect is expressed on the entire surface of the rubber grid . It is humbly submitted that this is possible only because the channels are open channels. It is submitted that the open

channels were therefore always an essential feature of the invention as originally claimed in the said application. It is submitted that the word “open” was added to the word “channels” in Claim 1 only by way of explanation and for incorporation of an actual fact and to make Claim 1 clear and unambiguous. It is submitted that the addition of the word “open” does not broaden the scope of the invention as originally claimed. In fact, the said amendment narrows the scope of the claim and makes it definitive. It is submitted that on a combined reading of the Complete Specification and the Figures filed along with it, a person skilled in the art would understand the channels to be open channels and not otherwise.

It is submitted that the Ld. Controller failed to appreciate that the drawings were an integral part of the specification and disclosure of the feature of the open channels in the drawings sufficiently supported the amended claims. The same was also clearly highlighted in the amended copy of the claims containing footnotes which was filed as an enclosure to the Appellant’s written submissions/response dated 23rd February, 2015. It is submitted that the Ld. Controller ought to have applied the settled principle of construction of claims that features described in the drawings filed along with the Complete Specification formed part of disclosure in the specification. It is submitted that instead, the Ld. Controller construed the claims and specification in a strict and narrow sense rather than construing the elements of the specification including drawings as one complete whole. It is humbly submitted that it is settled law of construction of claims that while adjudging the nature of an amended claim, the correct test is to ascertain whether a skilled

person would, upon looking at the amended specification/claims be able to derive, using common general knowledge and seen objectively and relative to the date of filing from the whole of the document as filed, the added matter. It is humbly submitted that on reading the description of the Complete Specification along with the drawings as originally filed and the amended claims as a whole, the invention so claimed by the Appellant in the said application would enable a person skilled in the art to derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the document as filed, the added matter;

It is submitted that in view of the above the Ld. Controller wrongly observed that the Complete Specification only referred to “channels” and not to “open channels.”

16.2 Then on the issue of positioning of the non-return valve they submit that the Ld. Controller has wrongly observed that the position of non-return valves (5)-(5) as defined in step (b) of amended Claim 1 was added which was not supported by the specification. It is submitted that reference to the non-return valves (5)-(5) and their position referred to in amended claim 1 can be found in paragraph 1 on page 7 of the Complete Specification as originally filed. The description of non-return valves (5)-(5) is provided with reference to Figs. 1 to 4 as were filed along with the Complete Specification. The relevant lines i.e. 3 to 5 of the said paragraph read as under:

“...The said base metal plate (1) is provided with oil ports (4)-(4) connected to the base of pre-selected cavities. Valves (5)-(5) are placed inside the cavities having oil ports (4)-(4)...”

The aforesaid description ought to be read along with Figs. 1 to 4 filed with the Complete Specification.

Further, the last paragraph on page 8 of the specification states that non-return valves (5)-(5) are placed at the base of only those cavities which have at their base the oil ports (4)-(4). The relevant lines of the said paragraph are reproduced herein below:

“As shown in fig.3 and 4 metal discs acting as non-return valves (5)-(5) preferably having a shape and dimension nearly equal to those of cavities (2)-(2) and thickness preferably ranging from 0.5mm to 1mm, are placed at the base of only those cavities which have at their base the oil ports (4)-(4)....”

It is submitted that a reading of the above description along with Fig. 4 as filed with the original Complete Specification shows that the mouth of the oil port (4)-(4) is at the base of the cavity (2)-(2) having such oil port at its base. It is submitted that the Ld. Controller has therefore wrongly considered the mouth of the oil port (4)-(4) and the base of the cavity (2)-(2) which have the oil ports at their base as being two different positions. It is submitted that the mouth of the oil port (4)-(4) is at the base of the cavity (2)-(2) having the said oil port and hence the two refer to the same position. It is submitted that the Appellant amended Claim 1 so as to refer to the position of the non-return valves (5)-(5) with reference to its position on the oil port (4)-(4), instead of its position at the base of the cavity (2)-(2), as the function of the non-return valve (5)-(5) is to prevent the rubber from the 1st rubberization step from entering and thereby blocking the oil ports (4)-(4). Thus, the said amendment was made to make the position of the non-return valve (5)-(5) clear and unambiguous. It is submitted that a person skilled in the art, on a combined

reading of the description of the Complete Specification along with the Figures would clearly understand that the position of the non-return valves (5)-(5) each at the mouth of the oil port (4)-(4) and the position of the non-return valve (5)-(5) at the base of the cavity (2)-(2) having oil port mean the same thing.

17. Learned counsel of the appellant has relied upon the case laws in support of his arguments quoted herein below:

It is submitted that the fact that drawings are deemed to form part of the Complete Specification has also been confirmed by the Hon'ble Supreme Court in *Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries* reported in (1979) 2 SCC 511 wherein the Hon'ble Court observed that:

“27. ..A specification whether provisional or complete, must commence with the title, and in case of a complete specification must and with a distinct statement of the invention claimed. (Sec. 4)

The Controller then considers that application and may require the applicant to supply suitable drawings and such drawings shall be deemed to form part of the complete specification. *If a complete specification is not left with the application, the applicant may leave it at any subsequent time within 9 months from the date of the application. The application is then examined by the Controller of Patents for the patentability of the invention. The Controller then makes a thorough search among his records for novelty. The Controller is bound to refer to an Examiner an application, in respect of which a complete specification has been filed....”*

18. Before we proceed with the analysis of the issue, let's have a reference of the relevant provisions of the Patents Act and the Rules made thereunder relating to amendments:

Section 57¹

*Amendment of application and specification or any document relating thereto
before Controller*

(1) Subject to the provisions of section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification or any document relating thereto to be amended subject to such conditions, if any, as the Controller thinks fit:

Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification or any document relating thereto under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend.

(2) Every application for leave to amend an application for a patent or a complete specification or any document relating thereto under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made.

(3) Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent and the nature of the proposed amendment may be published.

(4) Where an application is published under sub-section (3), any person interested may, within the prescribed period after the publication thereof, give

¹ Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps57.html>

notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

(5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim.

(6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any other document related thereto to comply with the directions of the Controller issued before the grant of a patent.

Section 59²

Supplementary provisions as to amendment of application or specification

(1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Where after the date of grant of patent any amendment of the specification or any other documents related thereto is allowed by the Controller or by the Appellate Board or the High Court, as the case may be,—

(a) the amendment shall for all purposes be deemed to form part of the specification along with other documents related thereto;

(b) the fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and

² Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps59.html>

(c) the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.

Rule 81³

Amendment of application, specification or any document relating thereto

(1) An application under section 57 for the amendment of an application for a patent or a complete specification or any document related thereto shall be made in Form 13.

(2) If the application for amendment under sub-rule (1) relates to an application for a patent which has not been granted, the Controller shall determine whether and subject to what conditions, if any, the amendment shall be allowed.

(3) (a) If the application for amendment under sub-rule (1) is made after grant of patent and the nature of the proposed amendment is substantive, the application shall be published.

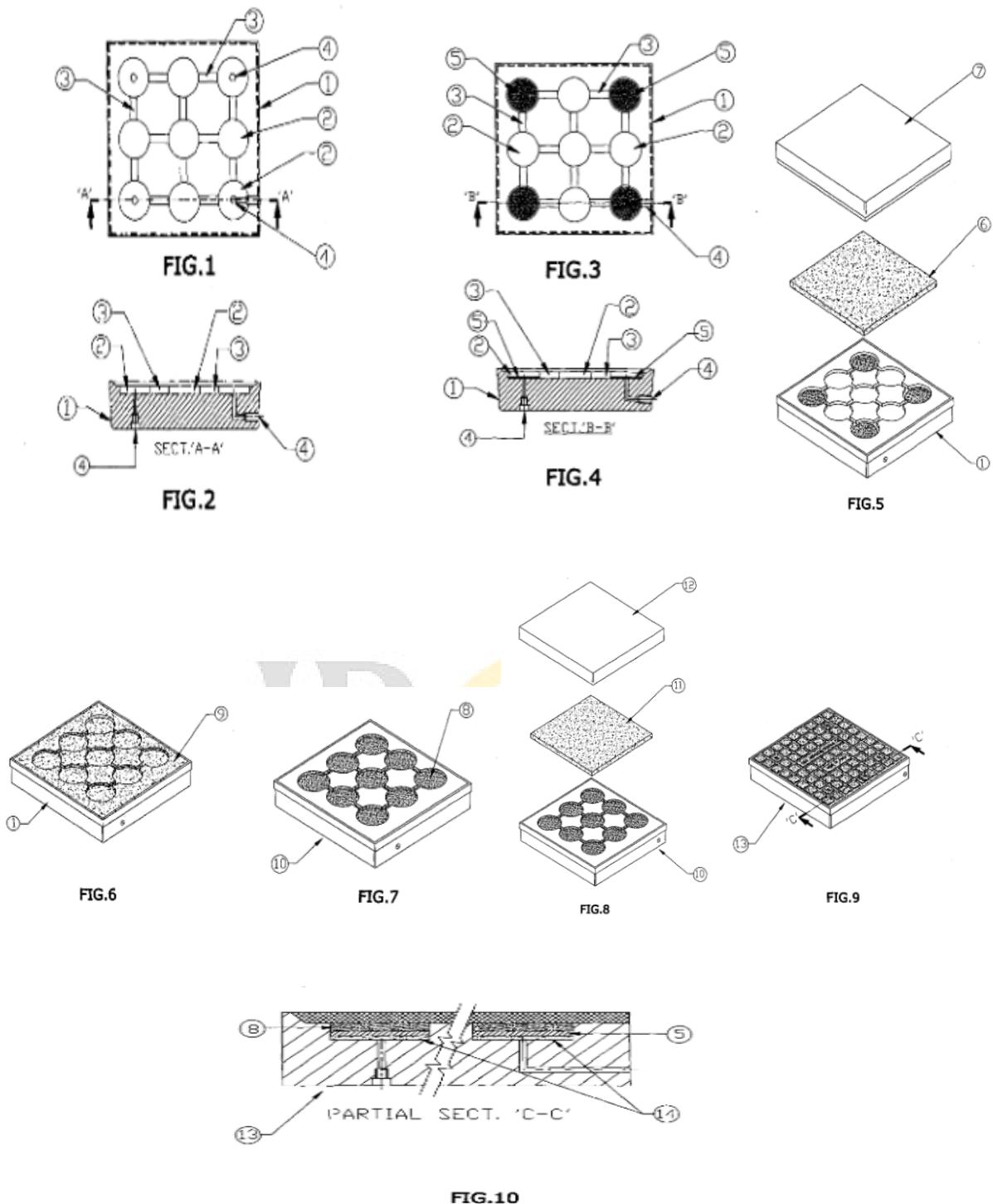
(b) Any person interested in opposing the application for amendment shall give a notice of opposition in Form 14 within three months from the date of publication of the application.

(c) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 57 as they apply to the hearing of an opposition proceeding.

19. During the course of his argument in front of us, learned counsel of the appellant explained about both these features of “open channels” and the “positioning of non-return valve” and their support in the

³ Available at <http://ipindia.nic.in/writereaddata/Portal/ev/rules/pr81.html>

description and drawings. We have reviewed the relevant portions of the complete specifications. Let's look at the drawings:



20. We have seen that paragraph 1 on page 7 of the Complete Specification mentions about channel as “Referring to the aforesaid figures 1 to 4 a base metal plate (1) has cavities (2)-(2) connected by channels (3)-(3) together forming the cavity network....”. Further once we refer to the drawings and particularly Fig1-4 we see that channels referred to in the description are ‘open’ in nature. Though the word “open” is not found explicitly mentioned in the description but once the

description and the drawings are read together, it is clear that the “channel (3)-(3)” as explicitly mentioned in the description, is in fact “open channel”. Therefore, if the appellant has amended “channel” to “open channel”, the amendment is well supported by the description when read with the drawings and if the adjective ‘open’ is added to “channel” in the claims, the scope of the word “channel” is narrowed. Further, the view of the respondent that appellant added the word “open” to escape the inventive step objection; we will deal when we analyze the inventive step. For now it is clear that the appellant while supplementing the word “channel” with the word “open” and amending the claims with the phrase “open channel”, have support in the complete specification when the description is read with the help of drawings.

21. Let’s analyse the “positioning of non- return valve” now. While reviewing the complete specification as filed originally, we find at para 1 of page 7 the description mentions about Valves (5)-(5) *are placed inside the cavities having oil ports (4)-(4)....*. Further page 8 of the specification mentions “As shown in fig.3 and 4 metal discs acting as non-return valves (5)-(5) preferably having a shape and dimension nearly equal to those of cavities (2)-(2) and thickness preferably ranging from 0.5mm to 1mm, are placed at the base of only those cavities which have at their base the oil ports (4)-(4)....”. Hence looking at the drawings and specially fig 4 thereof, it is clear that the mouth of the oil port (4)-(4) and the base of the cavity (2)-(2) which have the oil ports at their base are in fact the same positions. As submitted by the appellant, they amended Claim 1 so as to refer to the position of the non-return valves (5)-(5) **with reference to its position on the oil port (4)-(4)**, instead **of its position at the base of the cavity (2)-(2)**, as the function of the non-return valve (5)-(5) is to prevent the rubber from

the 1st rubberization step from entering and thereby blocking the oil ports (4)-(4).

22. After reviewing the description and the drawings, we are convinced that the position of the non- return valves remains unaltered. It's basically when defining the position with reference to oil ports (4)-(4) the position of the non- return valves is at "the mouth of the said oil ports" and while defining with respect to cavity, it is at "the base of the cavity". The oil ports are at the base of cavities and on the mouth of the oil ports, the non return valves are placed. Either way, it is explained the position of the valve remains the same. Therefore, these amendments also find its support in the description when read with the drawings and well within the scope of original disclosure.

23. Now as both the amendments are not forming part of any newly introduced matter in the specification rather they are part and parcel of the original disclosure in the complete specification, they do not attract the provisions of section 57 read with section 59; as they do not go beyond the originally filed specification and were made as 'explanation' fulfilling the criterion of amendments as per the teachings of section 57 read with section 59 of the Patents Act, 1970.

24. Inventive step determination:

24.1 The respondent in his order held that Document EP0620089 teaches method of manufacturing and punch having isostatic punch comprising of two or more cavities connected together with channel on metal plate having cavities containing an incompressible fluid, i. e. oil and elastic membrane at top. Which **is same as claimed in claim 6** for isostatic punch. The method for manufacturing is also disclosed.... **Hence, it would have been obvious to a person having ordinary skill in the art, at**

the time the invention was made to modify EP0620089 with other cited document to add rubberizing and scrapping step.

In view of the above, claim does not constitute an invention u/s 2(1)(j)(a) for the lack of inventive step. [Emphasis added]

24.2 The appellant has submitted their argument that since each of the cavities in D6 is provided with oil ports at their base, there is scope of excess oil being spilled out from the cavities. Further, in the absence of interconnected cavities on the surface of the die means of D6, the isostatic effect is limited only to the area of the cavities. It is therefore submitted that the feature of open channels interconnecting the cavities on the surface of the base metal plate is an essential integer of the Appellant's invention which is neither disclosed nor taught nor suggested by the disclosure in D6. Further, a person skilled in the art on studying D6 will be taught away from the Appellant's invention as in D6 each of the cavities is provided with an oil port/water inlet at its base and the channels are provided below the oil port/water inlet, all of which are provided under the cavity and not on the surface. Thus, D6 also does not motivate a person skilled in the art to arrive at the Appellant's invention as claimed in the amended claims.

24.3 The appellant further submits that D6 does not disclose or teach or suggest a method for manufacturing inbuilt rubber grid as claimed in amended Claim 1 proposed by the Appellant. In fact in Col.1, lines 49 to 58 D6 acknowledges that it is difficult to manufacture isostatic punch having an in-built rubber grid. It states that the lattice in the mould cannot be provided with a membrane obtained by vulcanized elastomeric substance, such as rubber or resin, since when liquid elastomeric substance is

poured on the lattice, the cavities become completely filled with elastomeric substance and no room is therefore available for the incompressible fluid. It is submitted that D6, however, does not provide a solution to overcome the said problem. It is submitted that the said problem faced by the prior art is overcome by the Appellant's invention by applying a mould release spray to the base metal plate (1) before the first stage of rubberization. This ensures that the vulcanized rubber does not stick permanently to the base metal plate. Further, non-return valves (5)-(5) are provided at the mouth of the oil ports (4)-(4) to prevent entry of the rubber into the oil ports.

24.4 The appellant further submits that apart from making a passing reference to the other cited documents, the Ld. Controller has failed to identify which of the documents D1 to D5 disclose the other features of the Appellant's invention, which can be introduced into the die means disclosed or claimed in D6 to arrive at the Appellant's invention. It is submitted that neither of the cited documents D1 to D5 disclose a method of manufacturing inbuilt rubber grid or an isostatic punch as prepared by the said method.

24.5 The appellant has relied upon various case laws in support of their arguments. The relevant ones are given herein below:

Hon'ble Bombay High Court in CTR Manufacturing Industries Ltd. vs. Sergi Transformer Explosion Prevention Technologies Pvt. Ltd. & Ors. reported in 2016 (65) PTC 262 (Bom) dated 23rd October, 2015 wherein the Hon'ble Court has made similar observations. The relevant paragraphs of the said judgment are reproduced herein below:

Paragraph 48 on page 285 of the said judgment,

“In short, to succeed, the charge of mosaicing must itself be self-evident and plain, one that can be put together by “an unimaginative man with no inventive capacity”. (J. Mitra & Co. Pvt. Ltd. v Kesar Medicaments & Anr., 2008 (36) PTC 568 (Del.), per Sanjay Kishan Kaul J (as he then was), citing Terrell on Patents, 16th ed., 2006, in turn quoting Reid LJ in Technograph v Mills & Rockley, [1972] RPC 346 at 355)”

Paragraph 49 on page 285 of the said judgment,

“For combination patents, the issue for determination is whether the combination of the integers was at the relevant time obvious, not whether each integer regarded in isolation was obvious. (Davison, Mark J, Ann L. Monotti and Leanne Wiseman; Australian Intellectual Property Law, Cambridge University Press, paragraph 13.8.1)”

Paragraph 50 on page 286 of the said judgment,

“In M/s Bishwanath Prasad Radhey Shyam v Hindustan Metal Industries, (1979) 2 SCC 511 (under the Patents & Designs Act, 1911) the Supreme Court dealt with this question in a patent infringement action relating to a new device and method of manufacturing utensils. There too, as here, the defence of mosaicking was raised. The Court held that to be patentable, an improvement on what was previously known, or a combination of matters previously known, must be more than mere workshop improvement. It must be an ‘inventive step’. It must produce a new result, a new article or a better or cheaper article (or result) than before. It is permissible to combine old, known integers such that in the new combination and their inter-dependency or interrelation

they produce a new process or an improved result. A mere collection of old integers that does not involve an inventive faculty does not qualify. It is not the ‘new-ness’ of purpose or the novelty of application that is relevant; there must be novelty in the mode of application. That mode must display some ingenuity. When it is said that the patent is precisely such a non-inventive, self-evident mosaic, and that what it does is ‘obvious’, then that defence of ‘obviousness’ must be construed strictly and objectively. It must be shown to be something that does not naturally suggest itself; it must not be the obvious or natural suggestion of the previously known.”

Paragraph 52 on page 286 of the said judgment,

“In Gandhimati Appliances Ltd v L. G. Vardaraju, (2000) 3 MLJ 85; per R. Jayasimha Babu and Mrs. Prabha Sridevan JJ; paragraph 29 of the MLJ report; A Division Bench of the Madras High Court said in the context of a patent-claim contest about wet grinders that it is accepted as sound law that a mere juxtaposition of old (meaning known) integers so that each performs its own proper function independently of any of the others is not a patentable combination; but where these old, known integers are so placed together as to have a working interrelation producing a new or improved result, then there is patentable subject matter in the idea of the working interrelation brought about by such a collation of these integers.”

And, paragraph 57 on page 288 of the said judgment,

“In Canadian Electric Co Ltd v Fada Radio Ltd, (AIR 1930 PC 1) the Privy Council said...

that sometimes it is the combination itself that is the invention; if the invention requires independent thought, ingenuity and skill, producing in a distinctive form a more efficient result, there is the subject matter of a patent. A new combination of well known devices, and their application to a new or more useful end, may require invention to produce it and may be good subject matter for a patent. If all of this, including that combination and that result, are shown convincingly to be in the public domain, of course no patent can result.”

24.6 The Division Bench of the Hon’ble Delhi High Court in F. Hoffman La-Roche Ltd. and Anr. v. Cipla Ltd. reported in 2016 (65) PTC 1[Del][DB] has also made similar observations. In the said decision, the Hon’ble Court further observed that care must be taken to avoid hindsight reconstruction to arrive at the conclusion that the invention claimed by a party lacks inventive step. The relevant paragraphs of the said decision are reproduced hereinbelow :

“144. Obviousness has to be strictly and objectively judged. In the decision reported as (1979) 2 SCC 511: 1950-2000 (22) PTC(Suppl) (1) 731 (SC) Bishwanath Prasad Vs. Hindustan Metal Industries (para 25) the Supreme Court laid down the principles to test inventive step' as under:-

25. 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 draftsman (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?"(Encyclopaedia 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 would or should make the invention the subject of the claim concerned?" [Halsbury, 3rd Edn., Vol. 29, p. 42 referred to by *Vimadala, J. of Bombay High Court in Farbwerke Hoechst & B. Corporation v. Unichem Laboratories* [AIR 1969 Bom 255 (Bom HC)] .]"

25. We shall now take a look at the objections at the stage of first examination report(FER):

“Objections :

Invention claimed in claims prima facie lacking in Novelty and in Inventive steps over cited documents as follows:

D1:US5599566,D2:US5922260,D3:US6558593,D4:US5330346

Document D1 discloses floating plane for press punches comprising an isostatic support or base 1 on which a punch 2 is fixed by means of an intermediate partition 3, filled with non-compressible operating fluid such as oil or another equivalent fluid. The intermediate partition 3 is delimited, on the base side, by a metal wall 4 that may be constituted by the lower part of the same base; along its perimeter, it is delimited by elastic walls 5 that fit the edge 6 of the same base; on the punch side, by an elastic wall 7 which is coupled with the whole bottom 8 of the punch and with the elastic peripheral walls 5 with extension 20 on the external surface 9 of the edge 6 of the isostatic base 1. The elastic walls 5, 7 and 20 are coupled with the metal walls 4, 6, 8 and 9 by

vulcanization or other adapted and conventional adhesion means. The elastic material which constitutes the walls 5, 7 and 20 may be rubber or any other material having a good degree of elastic deformability and resistance to the high working pressures caused by the operating fluid. The punch 2 and the isostatic base 1 are connected to each other and to the elastic walls of the intermediate partition 3 by several orthogonal means 10, which are slideable in the direction of its longitudinal axis of symmetry 11.

D1 further discloses that the means 10 are constituted by pistons 12 that are slideable in sleeves 13 with a rear stop 14 provided in the base 1. In the front part the pistons 12 are linked to the bottom 8 of the punch 2 by means of screws 15 and are embedded into the same elastic material 5 constituting the elastic walls 5 and 7, so as to realize a perfect hydraulic seal with respect to the non-compressible operating fluid present in the intermediate partition 3. (Col. 2, 3, Line 49-68, 1 to 4 respectively)

Hence alleged invention is not Novel.

D2 discloses method of making a die set for forming ceramic tiles, having at least one shaped side, with said die set having at least an upper punch (3) and a lower punch (2), said lower punch (2) being of a "Bullnose" or "Step Edge" configuration, comprising the steps of machining the upper surface of said lower punch (2) to form a shaped impression (22), inclusive of a horizontal cutout (24"); applying a layer or coating (23) thereon of synthetic resin or rubber that completely covers the impression (22), and cutout (24"), and whose upper surface defines the surface form of the front face of the ceramic

tile;

applying a coating (33) to the upper punch (3) and whose lower surface defines a forming surface (30) to form the backside of the tile; said layer or coating (23) is continuous and completely covers the lateral portion (22") of impression (22) that forms a general shape, which continues on the upper most part, and into the cutout (24") the layer 23 having a horizontal edge (23") turned toward the exterior with respect to the impression (22) in the cutout (24"), on an upper lateral surface (24) of the body (21) of the punch (2), and providing a rigid part (11), in contact with the upper lateral (24) of the body (21) of the punch, to clamp the horizontal edge (23") in the cutout (24") against the surface (24) of the body (21) of the punch. (Claim 1 of D2)

Document D3 discloses method for pressing ceramic powder within a mold cavity to form ceramic tiles, which comprises: subjecting the powder to a compacting pressure; and subjecting the powder to close together pressure pulses while maintaining the compacting pressure, the pressure pulses having the same pressure value over a whole surface of the mold cavity, the pressure pulses being transmitted to the powder through a flexible membrane in contact with the powder and directly resting on a layer of pressurized hydraulic incompressible liquid.(Claim 1 of D3)

Document D4 discloses die for ceramic tiles: a first half die and a second half die, at least one of said half dies comprises a rigid, concave base to define a cavity, an incompressible fluid being disposed in said cavity, said cavity being closed by an elastic wall, said elastic wall having an external face on which an imprint of a face of a tile to be realized is

inscribed, a lattice being disposed within the cavity, said lattice dividing said cavity into a plurality of chambers, said lattice defines a supporting surface for said elastic wall said elastic wall being fixedly connected to said supporting surface, said imprint being made at a position corresponding to a position of said lattice. (claim 1 of D4)
Hence considering documents D1 to D4 in combination, the present claimed invention is not Novel and not inventive u/s 2(1)(j) of the Patents Act, 1970 (as amended).

26. Looking at the impugned order of the Learned Controller we note that it starts with outstanding objections communicated for hearing as “Further search and examination have been carried out on the basis of amended claims 1 to 13 and reply received on 31/10/2013 herein.**Invention claimed in claims is lacking in Inventive steps over cited documents as follows:D5:US5997273;D6: EP0620089; D1: US5599566; D2: US5922260; D3: US 6558593; D4: US5330346. Therefore, it is clear that the respondent dropped the objection of ‘novelty’ after submissions of the appellant at examination stage. Further two more documents D5:US5997273;D6: EP0620089 are added in support of their objection of inventive step at stage of hearing notice.

27. This indicates that the earlier cited four documents D1 to D4, were neither sufficient to destroy the “novelty” nor ‘Inventive step’ of the invention. While attracting the provisions of the section 2(1)(ja) of the Patents Act, 1970, learned Controller relies only on single document D6: EP0620089 and holds that “Hence, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made to modify EP0620089 with other cited document to **add rubberizing and scrapping step**. In view of the above, claim does not constitute an invention u/s 2(1)(j)(a) for the lack of inventive step.

28. The steps of rubberizing and scrapping are in the opinion of learned Controller are obvious which could added to the teachings of **EP0620089 with other cited document**. While doing so he finds that it would have possible for **a person having ordinary skill in the art**. It may be noted that the term **“ordinary”** has never been attached to the phrase **“person skilled in the art”** the addressee to assess the non-obviousness in the entire Patents Act 1970. Further, the impugned order holds that *D1 to D6 in combination, the present claimed invention is not inventive* but it is silent on which feature(s) of the citations are so combined to arrive at the invention or which feature(s) present in them suggest that once combined the inventive step of the invention will be destroyed.

29. The combination⁴, substitution or modification of the teachings of one or more items of prior art may only lead to a lack of inventive step/obviousness where a person skilled in the art would have been motivated by the prior art or his general knowledge, with a reasonable likelihood, to combine, substitute or modify one or more items of prior art. Conversely, where such combination could not have been expected from a person skilled in the art, the requirement of inventive step (non-obviousness) would be met, even if each single item would have been obvious if taken individually. Further, it is well settled principle that Obviousness has to be strictly and objectively judged⁵. Also whether an invention is 'obvious' is a mixed question of law and fact⁶, depending on the facts and circumstances of each case.

⁴ Available at <https://www.wipo.int/export/sites/www/pct/en/texts/pdf/ispe.pdf>

⁵ Bishwanath Prasad Vs. Hindustan Metal Industries (1979) 2 SCC 511

⁶ ibid

30. It is not permissible to combine teachings of two or more documents except where one of these directs the reader to study the other⁷.
31. The mere fact that the separate features of the claimed invention are known or obvious does not signify the obviousness of the claimed invention combining those features that mutually support each other in their effects⁸
32. There is no simple rule as to whether information from different documents, or from different parts of a single document, can properly be combined as a “mosaic” to provide a case that an invention is obvious. The greater the number of documents which must be so combined to reach the invention, the more likely on the whole that there is an inventive step, but regard must be paid to the nature of the features which are combined⁹.
33. Here, in the instant application, the analysis of determination of inventive step has not been done. The features of prior arts are never identified other than holding that the teachings of *EP0620089 with other cited document will make the invention obvious to the person having ordinary skill in the art*. We have analyzed the order of respondent and the arguments of the appellant and are of the opinion that the findings in the order are not tenable in the eye of law and thus cannot be sustained.
34. We, therefore, allow the amendment of the claims so far as it relates to “open channel” and ‘positing of the non- return valve”, as

⁷ Institute Pasteur &Anor v Genelabs Diagnostics & Anor [2000] SGHC 53

⁸ The Guidelines for Examination in the EPO explain that a set of technical features is regarded as a combination of features if the functional interaction between the features achieves a combined technical effect which is different from (for example, greater than) the sum of the technical effects of the individual features.

⁹ <https://www.gov.uk/guidance/manual-of-patent-practice-mopp/section-3-inventive-step>

sought for by the appellant.

35. We also conclude that the order of the learned Controller that the invention lacks “inventive step”, in view of the documents D1-D6 is erroneous, being void of reasonable assessment and thus cannot be sustained.

36. We, therefore, order that the impugned order of the learned Controller dated 18/09/2015 is set aside forthwith, by allowing the present appeal.

37. The Controller of Patents, Patent office Mumbai, is hereby directed to grant the patent as claimed by the appellant and proceed further with the case in accordance with law.

38. No cost.

- Sd/-

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



-Sd/-

(Justice Manmohan Singh)
Chairman

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