News

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> The Court pointed out that patent examiners must make the subjective determination because the Patents Act does not offer a mechanism for determining clear improvements on prior art.

Concerns regarding the patent office's habitual arbitrary decision-making in patent applications and oppositions were voiced by the Delhi High Court on Monday [Tapas Chatterjee v. Assistant Controller of Patents and Designs & Anr].

A division bench consisting of Justices C Hari Shankar and Ajay Digpaul noted that an invention must be genuinely novel and creative in order to be granted a patent, rather than merely a clear advancement over preexisting work (prior art).

> According to the Court, this obviousness must be assessed through the legendary eyes of a "person skilled in the art," but regrettably, the Indian Patents Act of 1970 offers no rules to govern this procedure.

As a result, the Examiners in the Controller General of Patents, Designs, and Trade Marks' office frequently make decisions about patent registration applications and oppositions to such applications based only on their subjective judgments. This approach is obviously completely unsatisfactory from a legal standpoint," the Court stated.

While resolving a plea by a man named Tapas Chatterjee contesting the denial of a patent application for a method to recover potassium sulphate and other valuable products from the residue left over after the alcohol distillation process, the Bench made the observation. According to the statement, the invention sought to solve environmental issues over water pollution by offering a straightforward and cost-effective method of recovering potassium sulfate, magnesium sulfate, activated carbon, and other by-products from molasses-based alcohol distillery effluent.

> A pre-grant opposition to the patent application was submitted by the Council of Scientific and Industrial Research (CSIR). The process was deemed obvious and not patentable by the Assistant Controller of Patents, who upheld the objections.

In the High Court, Chatterjee contested this order, but the lone judge dismissed it. After that, he appealed to the Division Bench.

After reviewing the case, the Division Bench concluded that the proceedings had been

reduced to a joke by the way the Assistant Controller of Patents & Designs [AC] handled the issue, particularly with regard to CSIR's objection based on the purported absence of innovative step.

It seems that the AC simply reviewed all of the previously mentioned works and concluded that, either by itself or in conjunction with one or more of the others, each of them would allow a skilled practitioner to develop the method that the appellant was attempting to patent. It's anyone's guess how," the Court stated.

> Furthermore, according to the Division Bench, the way the AC issued the order highlights the risks associated with the absence of any guidelines that would allow one to determine the subject invention's obviousness with respect to prior art.

There may be situations where the subject invention's obviousness in comparison to prior art is evident from a cursory review of both the subject invention's and the prior art's full specifications. On the other hand, there can be instances where a person versed in the art would not be able to tell from the previous art and the subject invention's full specifications that the latter is evident from the former. We believe that the Adjudicating Officer in the CGPDTM office, who is making a decision on the patent application, has a responsibility to clearly and explicitly explain why he believes that the prior art document's teachings would be sufficient on their own to allow a person skilled in the art to arrive at the claims in the subject invention. The assertions in the full specification pertaining to the subject invention cannot, as in this instance, be left to the bare conclusion that they are clear from the previous art without any supporting evidence.

> In the end, the Court overturned the patent office's decision and instructed it to make a new decision on the application and the CSIR opposition within six months.

The appellant was represented by attorneys Pravin Anand, Prachi Agarwal, Arpita **Kulshrestha,** and Elisha Sinha.