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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Reserved on: 20.11.2025

Date of Decision: 23.03.2026

Judgment uploaded on: As per digital signature

+ C.A.(COMM.IPD-PAT) 306/2022

WIRTGEN GMBH

.....Appellant

Through: Mr. Rohit Rangi, Mr. Vineet Rohilla,
Mr. Debashish Banerjee, Mr. Pankaj
Soni & Mr. Ankush Verma, Advs.

versus

CONTROLLER GENERAL OF PATENTS, DESIGNS AND
TRADEMARKS AND ORS

.....Respondents

Through: Ms. Nidhi Raman, CGSC with Mr.
Om Ram, Mr. Arnav Mittal and Mr.
Mayank Sansanwal, Advs.

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CORAM:

HON'BLE MS. JUSTICE MANMEET PRITAM SINGH ARORA

J U D G M E N T

MANMEET PRITAM SINGH ARORA, J:

1. This is an appeal under Section 117A of the Patents Act, 1970 ('the Patents Act'), challenging the order dated 25.11.2019 ('impugned order') passed by the Assistant Controller of Patents and Designs/Respondent No. 2 in Indian Patent Application number 2874/DEL/2010 filed on 03.12.2010 ('Subject Patent Application') for the invention titled 'BIT HOLDER AND BASE PART FOR RECEIVING A BIT HOLDER'.



FACTUAL MATRIX

2. Brief facts necessary for deciding the present appeal are set out below:

3. The Appellant/Wirtgen GMBH filed the Subject Patent Application on 03.12.2010 as a convention application claiming priority from the German Patent Application No. 10 2009 059.3-24 dated 17.12.2009. The bibliographic details of the application are given below:

Application No.	2874/DEL/2010
Filing Date	03.12.2010
Request for Examination	03.12.2010
Publication Date	04.10.2013
First Examination Report ('FER')	13.07.2017
Response to FER	05.01.2018
Hearing Notice	30.08.2019
Date of Hearing	18.09.2019
Written Submissions	03.11.2019
Date of Impugned Order of Refusal	25.11.2019

4. The FER was issued on 13.07.2017 after a period of six and a half years. The FER listed various objections raised by Respondent No. 2, wherein the primary objections raised were pertaining to:

- i. Claims are lacking inventive step under Section 2(1)(ja) of the Patents Act and
- ii. Claims do not sufficiently define the scope of the present invention under Section 10(4)(c) of the Patents Act.

5. The Appellant thereafter filed a detailed response complying with all



the requirements raised in the FER on 05.01.2018. Vide the said response, the Appellant clarified the following:

- i. Lack of Inventive Step: The prior art documents fail to disclose ‘a bit holder including a base part for receiving the said bit holder this enables long-lasting and rigid bracing of the bit holder with respect to the base part under high stress. The invention discloses a bit holder in which the supporting and bearing surfaces are arranged at an angle to each other. The longitudinal axis of the bit receptacle and the insertion projection form an obtuse angle, creating a supporting region that helps dissipate transverse loads during tool use.
 - ii. Unity of Inventions: the Claim 1 is directed towards a bit holder, whereas Claim 15 recites a base part for receiving the said bit holder and both sets of claims are linked with each other with a common feature of ‘bit holder’. Claim 20 describes the direction of the supporting surfaces.
 - iii. Clarity and Conciseness, Definitiveness and other requirements: the claims were amended to meet the requirements and the dependency clause ‘according to’ appearing in the sub claim had been replaced with ‘as claimed in claim’.
6. Thereafter, a hearing notice was issued on 30.08.2019 for the official hearing of the Subject Patent Application on 18.09.2019. Certain objections were raised by Respondent No. 2 in the said hearing notice. The official deadline to file written submissions was 03.10.2019; however, pursuant to a telephonic discussion with Respondent No. 2, the Appellant filed a petition under Rule 138 along with the official fee on 30.09.2019, seeking an extension of the official deadline for filing the written submission by one (1)



month. The fresh deadline was extended to 03.11.2019. In view of the extension, the Appellant filed a detailed written submission in response to the objections raised in the hearing notice on 01.11.2019.

7. Respondent No. 2 issued the impugned order on 25.11.2019, which was communicated to the Appellant on 27.11.2019. The Subject Patent Application was rejected on the ground that Claims 1 to 22 lack inventive step in view of prior art documents D1-D4 under Section 2(1)(ja) of the Patents Act, and that the claims are not definite and fail to clearly define the scope of the invention, contrary to Section 10(4)(c) of the Patents Act.

SUBMISSIONS BY THE PARTIES

Submissions by the Appellant

8. Mr. Rohit Rangi, learned counsel for the Appellant, states that the present invention relates to a bit holder and a corresponding base part in which said bit holder can be installed. The bit holder and the base part are mounted on a milling drum of a machine used for removing road surfaces or surface mining.

9. He states that Respondent No. 2 has rejected the subject application for lack of inventive step in view of documents D1-D4. It is pertinent to mention that the novelty and inventive step of the present invention lie in the alignment and orientation of the support surfaces of the bit holder and the base part. Therefore, Respondent No. 2 has clearly acknowledged that D1-D3 does not provide any disclosure regarding the novel and inventive features of the present invention.

10. He states that it is trite law that in order to lack novelty of a claim, all the features recited in the claim should be present in the cited document. Further, the prior publication should contain a clear description and provide



clear instructions to do or carry out the same, which would infringe the claim in question. Therefore, the claimed invention is clearly distinguishable and not anticipated in view of D4.

11. He states that Respondent No. 2 has only made general statements about the disclosure of D4. Neither any analysis nor any mapping of features has been conducted. Respondent No. 2 has merely reproduced a part of the abstract of D4 in the Impugned Order and has not compared any feature recited in the claims of the subject application with the disclosure of D4, which was required for establishing lack of novelty.

12. He states that Respondent No. 2 has also not explained how and which teachings of D1-D3, in combination with the features disclosed in D4, render the present invention obvious. Any combination of D1-D4 cannot render the present invention obvious since they fail to disclose or suggest the supporting segment comprising two (2) supporting surfaces arranged at an angle to one another, and the longitudinal centre axis of the bit receptacle and the longitudinal axis (L) of the insertion projection enclosing an obtuse angle. In view thereof, the refusal of the Subject Patent Application under Section 2(1)(ja) of the Patents Act is not tenable.

13. He states that Respondent No. 2 has erroneously and arbitrarily refused the subject application under Section 10(4)(c) of the Patents Act on the ground that the claims are not definitive. Several objections, including those relating to “transverse central plane”, “extend locally”, “in front of the longitudinal axis”, and “at least locally with an offset”, were not even raised in the FER or the hearing notice. The objection regarding multiple dependent claims is also untenable as neither the Patents Act nor the Manual of Patent Office Practice and Procedure prohibit such dependency, and the



scope of the invention remains clear when read with the independent claims. Further, the alleged overlap between Claims 9 and 10 is incorrect since both claims relate to different embodiments concerning the orientation of the bearing surfaces. Accordingly, the claims are clear, definite, and fully supported by the specification and drawings. The refusal of the subject application under Section 10(4)(c) is, therefore, unsustainable and liable to be set aside.

Submissions by the Respondents

14. Ms. Nidhi Raman, learned counsel for the Respondents, states that Respondent No. 2's statement has been taken out of context. Respondent No. 2's analysis did not stop at D1-D3. It was a multi-step argument that must be read in its entirety. The argument is not that D1-D3 alone make the invention obvious, but that they establish the background knowledge available to a person skilled in the art. The lack of inventive step arises when the teachings of D4 are combined with this background knowledge.

15. She states that the purpose of citing D1, D2 and D3 was to establish that the general concept of a two-part system, i.e. a base part attached to a machine and a removable holder for a tool, was common knowledge in the field.

16. She states that the prior arts teach the following:

- i. D1 explicitly teaches a holder with a base part for holding a tool.
- ii. D2 explicitly discloses a tool combination having a base part and a bit holder.
- iii. D3 explicitly discloses a cutting element with a base element and a chisel holder.



17. She states that the very next part of Respondent No. 2's analysis introduces the crucial teaching from D4. Respondent No. 2 found that D4 teaches a chisel holder and a base part where a bearing surface (profiles 27, 28.1) is supported on a supporting surface (profile 12-13) of the base part, and the base part comprises a shoulder connected to the supporting surface. This is precisely the concept of using multiple facets and dedicated supporting surfaces that was missing from D1-D3.

18. She states that a person skilled in the art, starting with the well-known holder systems of D1-D3 and seeking to improve them, would naturally look to other solutions in the field. Upon finding D4, which explicitly teaches the use of multi-faceted support surfaces to improve durability and wear resistance, it would be obvious to apply that teaching to the systems in D1-D3. D4 teaches that a simple flat surface is insufficient and that adding angled geometry improves durability.

19. She states that an independent claim must be clear and define the invention on its own terms, not by relying on external clarification from the description or other claims to resolve its vagueness. The language of Claim 1 is what defines the legal boundary, and as it stands, it fails to specify which of the possible obtuse angles is being claimed, rendering the scope of the monopoly sought indefinite.

20. She states that it is the case of the Appellant that the Respondent No. 2 has introduced new terms in the impugned order. However, Respondent No. 2 has already mentioned the claims in the hearing notice within which these terms fall, and thus have not been introduced for the first time.



ANALYSIS

21. This Court has heard the learned counsel for the parties and perused the material on record.

22. The Subject Patent Application covers an invention that relates to a bit holder and a corresponding base part for cutting tools used in milling or mining machines, wherein angled supporting and bearing surfaces and an obtuse angle between the bit receptacle axis and insertion projection axis provide improved load distribution, rigid bracing, and secure mounting under high operational stresses.

23. This Subject Patent Application has been refused by the Respondent No.2 under Section 10(4)(c) and 2(1)(ja) of the Patents Act. The relevant parts of the impugned order are as follows:

“Scope of Invention

4. I have carefully considered the reply of the applicant and observe following part of the claims being not in accordance with section 10 of the Act:

- i. Axes, L & M as per figure 6 intersect each other at an angle. The form both acute and obtuse angle. The claim is however specific on obtuse angle but does not refer properly.
- ii. **“transverse central plane”** in claim 1, 12 is not defined.
- iii. **“at least locally in front of”** in claim 3 is vague. Also directions of the said surfaces and ‘v’ are not same as in figure 6.
- iv. Claims 3-22 are multiple dependent and as such scope of the invention can not be definitive under section 10 (4) (c) of the Patents Act. For ex. : subject matter in claim 7 talks of the feature of supporting surfaces 29. Said claim is dependent on claims 1-6. Subject matters in claims 4-6 are not relating to supporting surface but bearing surface or pressure surface etc.
- v. Subject matter in claim 14 claims the angle between ‘L’ and ‘M’. Said claim is dependent on all preceding claims, where ‘L’ and ‘M’ are not even referred to. In a similar manner it is difficult to identify the scope of the claims.
- vi. **“at least locally with an offset”** in claim 5 is vague.



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- vii. **“supporting surfaces (29) face toward the free end”** in claim 7 is vague in meaning.
- viii. **“extend locally”** in claim 9 is vague.
- ix. Scope of subject matter in claim 10 overlaps with claim 9.
- x. **“in front of the longitudinal axis”** in claim 18 is vague. **“at least locally with an offset”** in claim 19 is vague.

B. Technical Analysis (with respect to the priori arts cited for Novelty and Inventive Step)

5. After duly considering the reply of the applicant in written submissions (post FER and hearing), I do not find it persuasive to consider the instant patent application novel and inventive for the reason as below:

DE102005017760: D1 explicitly teaches of a holder with a base part for holding a tool. Said holder being held in the box (base part) with the help of a screw.

EP1761682: D2 explicitly discloses a tool combination having a base part and a bit holder.

DE4322401:D3 explicitly discloses a Cutting element with a base element and chisel holder.

Therefore, D1-D3 explicitly teaches a tool combination of base part and a holder. Above documents however fail to disclose as if the base or older part is made in multiple facets and having supporting surfaces.

CN101091037: D4 teaches that the chisel holder and a base part. A bearing surface is supported on a supporting surface of the base part, and the base part comprises a shoulder which is connected to the supporting surface. A replacement chamber is formed between the shoulder and a facing end surface of the chisel holder.

Therefore, considering the disclosure in D4, I am of the opinion that D4 alone would be able to destroy the novelty of the instant application for patent. Also, instant application for patent discloses mechanically equivalent components / parts of tool / features of the tool disclosed in D4. Therefore, a person skilled in the art would be able to combine the teaching of D4 in D1-D3 and reach to the instant invention to provide various supports as in instant application for patent.

C. Decision

In view of my observations in the paragraphs 5 & 6,

- i. I consider the subject matter in set of claims 1-22 submitted is not inventive under section 2 (1) (ja) of the Patents Act, 1970.



- ii. The drafted claims are not in compliance of the section 10 (4) (c) of the Patents Act, 1970 for being not definitive in defining scope of the claims.

I, therefore, refuse the application for grant of patent under section 15 of the Patents Act, 1970.”

[Emphasis supplied]

24. From the above extracted paragraphs made by Respondent No. 2 in the impugned order, it is clear that the Subject Patent Application has been refused since the claims of the Subject Patent Application do not define the scope of the invention as per the requirement under Section 10(4)(c) of the Patents Act. Also, the subject matter claimed in the Subject Patent Application does not fulfil the inventive step requirement under Section 2(1)(ja) of the Patents Act. In order to determine that the said requirements have been fulfilled by the Subject Patent Application, this Court deems it appropriate to assess the aforesaid provisions in the facts of the present case.

Section 10(4)(c) of the Patents Act

25. This Court shall first examine the objection raised by Respondent No. 2 in the impugned order under Section 10(4)(c) of the Patents Act. During hearing, as recorded in the written submissions dated 20.07.2023 which was filed before this Court, the Appellant had raised serious concerns over the impugned order over violation of the principles of natural justice since some of the specific terms which Respondent No. 2 had determined in the impugned order to be not fulfilling the requirement under Section 10(4)(c) of the Patents Act was never raised before in the hearing notice or the FER. Therefore, the Appellant had not received any opportunity to address the objection before Respondent No. 2. However, the counsel representing Respondent No.2 has argued that even though specific terms were not referred to in the hearing notice, a reference to the claims that contain those



words was already there in the hearing notice.

26. The objection raised by Respondent No. 2 in FER under Section 10(4)(c) is as follows:

“SCOPE:

(xvi) Claim(s) does/do not define the scope of invention for which the protection is claimed for the following reasons:

Not Applicable

CLARITY AND CONCISENESS:

(xvii) Claim(s) 1,4,5,7,10,15,17 and 19 are not clearly worded in respect of:

Claims not clearly worded and in claim 1,4,5,7,10,15,17 and 19 the word **"comprises/comprising"** should be replaced with word **"consisting of"**.

DEFINITIVENESS:

(xviii) Claim(s) 2-14 and 16-20 do not sufficiently define the invention for the reasons as follows:

The word “according to” in the claims 2-14 and 16-20 is not definitive; it requires amendment by replacing word “as claimed in claim”.

[Emphasis supplied]

27. The objection raised by Respondent No. 2 in the hearing notice dated 30.08.2019 under Section 10(4)(c) is as follows:

“1. Subject matter in claims fails to define the scope of the invention under section 10 (4) (c) of the Patents Act, 1970:

1. Direction 11 in figure 1 and 2 seem different.
2. Holding projection in claims should be replaced with “holder” or “holding part”, since same is part of the insertion projection, which seem to be detachable and holding part seem not to be detachable.
3. **“at least locally” in claim 2 is vague.**
Further supporting surfaces (29) does not seem to be in ‘V’ (which seems to be perpendicular to direction 11 in figure 1) direction in any of the figure but making some angle (<90 degree) to said direction.
“Substantially oppositely to the tool feed direction” in claim 3 is vague. As per figure 5, surfaces 21.5 seem to be at an angle to feed direction ‘v’ but not apparently opposite to the said direction.
4. **“at least locally with an offset”** in claim 4 is vague.



5. **“pressure surface”, “being at an angle”** in claim 5.
6. **“face toward the free end of the insertion projection (21)”** in claim 6.
7. **“consisting of a region that is cantilevered out beyond the insertion projection (21)”, “on the cantilevered region”** in claim 7
8. **“wherein the supporting surface (29) or supporting surfaces (29) and the bearing surface (21.5) or bearing surfaces (21.5) respectively form slide guides”** in claim 10. No technical meaning in claim 10 can be deduced.
9. A. Subject matter in 11 in respect of bearing surface(s) and supporting surface(s) are redundant with respect to claims 1-10. Said claims depicts out the way these surfaces are extended/arranged in the claimed invention. Therefore, these surfaces act as an antecedent basis to the bit holder (20).

In said claim 11 the said surfaces are presented in a way in which they are arranged to bit holder of the invention, where no technical change in the position / arrangement of said surfaces is apparent.

B. In a similar manner supporting surface 29 is presented to be parallel to the longitudinal center axis ‘M’ in claim 12. It is noted that the earlier claims 1-11 where the position / arrangement of these surfaces were disclosed were vague. Therefore, the positioning of supporting surface 29 should be discloses taking reference of ‘M’ only. Any other claim is not able to bring clarity to the position of surface 29 which otherwise intend to reveal or seek protection of same position/arrangement.

C. Claims 2,4,8,10,11, 14 (without prejudice to any other claims) disclose the position / arrangement of bearing surface(s) and supporting surface(s). These claims are vague in respect to drafting and fail to define the scope of the invention. The proper positioning of these surfaces are required to be presented taking reference of ‘L’ and ‘M’. Further relation of these axes with ‘11’, ‘V’ may be added in same claim in order to bring clarity to the scope of the invention.

10. The multiple dependencies of the dependent claims 3-12 & 14, 17-19 (as claims X or Y, Claims X to Y, any of the preceding claim, etc.) makes it difficult to correlate the disclosed technical feature of said claims with other dependent / independent claims. The scope of said claims is not definite under section 10 (4) (c) of the Patents Act, 1970.”

[Emphasis supplied]

28. It is a settled principle of law that the examination process under the Patents Act is required to conform to the principles of natural justice,



particularly the rule of *audi alteram partem*, which mandates that an applicant must be afforded a fair opportunity to meet the objections that may ultimately form the basis of refusal of the application. The Supreme Court in **Assistant Commissioner. Commercial Tax Department v. Shukla and Brothers**¹ has held as follows:

“10. The increasing institution of cases in all Courts in India and its resultant burden upon the Courts has invited attention of all concerned in the justice administration system. Despite heavy quantum of cases in Courts, in our view, it would neither be permissible nor possible to state as a principle of law, that while exercising power of judicial review on administrative action and more particularly judgment of courts in appeal before the higher Court, providing of reasons can never be dispensed with. The doctrine of audi alteram partem has three basic essentials. Firstly, a person against whom an order is required to be passed or whose rights are likely to be affected adversely must be granted an opportunity of being heard. Secondly, the concerned authority should provide a fair and transparent procedure and lastly, the authority concerned must apply its mind and dispose of the matter by a reasoned or speaking order. This has been uniformly applied by courts in India and abroad.”

[Emphasis supplied]

29. The scheme of the Patents Act contemplates that objections are first communicated through the FER as required under Section 12 of the Patents Act, and where necessary, clarified through a hearing notice, thereby enabling the applicant to address the concerns of the controller through written submissions or amendments as prescribed under Section 14 of the Patents Act.

30. In the present case, an analysis of the FER and hearing notice in the context of the impugned order shows that some objections under Section 10(4) were raised for the first time in the impugned order. Consequently, the applicant was not put on notice that these aspects would form the basis of

¹ (2010) 4 SCC 785



the final decision. The objections which appeared for the first time in the impugned order are as follows:

- i. “at least locally with an offset” in claim 19 is vague.
- ii. “in front of the longitudinal axis” in claim 18 is vague.”
- iii. “Scope of the subject matter of claim 10 overlaps with claim 9.”
- iv. "extend locally" in claim 9 is vague
- v. "transverse central plane" in claims 1, 12 is not defined.

31. The Appellant, during the course of the hearing, has endeavoured to satisfy this Court on all of these specific terms, which are very well defined and have been sufficiently backed by the drawings and detailed description of the Complete Specification of the Subject Patent Application.

32. The submission made by the Appellant regarding these terms under Section 10(4)(c) of the Patents Act is as follows:

Terms/phrases from claims of Subject Patent Application	Explanation by Appellant under Section 10(4)(c)
"transverse central plane" in claims 1, 12 is not defined	“The Respondent No. 2 did not raise this objection in the First Examination Report (FER) or the Hearing notice. Moreover, the final claims 12 does not have term "transverse central plane". Nevertheless, the term "transverse central plane", finds sufficient support from last para at page 4 and para 3 of page 11 of the specification. The longitudinal axis of the insertion projection and the bit receptacle longitudinal centre axis define a transverse central plane of the bit holder”



"extend locally" in claim 9 is vague	The Respondent No. 2 did not raise this objection in the hearing notice or the FER. Nevertheless, it is clear from Figures 4 and 5 and their corresponding description provided in the specification that the bearing surfaces (21.5) extend locally, in the direction of the longitudinal axis of the insertion projection (21), beyond supporting surfaces (29) as stated in claim 9.
Scope of the subject matter of claim 10 overlaps with claim 9	The Respondent No. 2 did not raise this objection in the hearing notice or the FER. Nevertheless, Claim 9 recites that the bearing surface (21.5) or bearing surfaces (21.5) extend locally, in the direction of the longitudinal axis of the insertion projection (21), whereas claim 10 is directed towards different embodiment of the present invention, wherein the bearing surface (21.5) or bearing surfaces (21.5) extend <i>parallel</i> to the longitudinal axis of the insertion projection (21) or extend substantially in the direction of the longitudinal axis. The aforesaid claims do not have an overlapping scope.
"in front of the longitudinal axis" in claim 18 is vague	The Respondent No. 2 did not raise this objection in the hearing notice or the FER. Nevertheless, it is clear from Figure 7 in combination of Fig. 3 and their corresponding description provided in the



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	specification that supporting surfaces (18.1) are in front of the longitudinal axis of the insertion receptacle (15) in the tool feed direction (v) as stated in claim 18.
“at least locally with an offset” in claim 19 is vague.	The Respondent No. 2 did not raise this objection in the hearing notice or the FER. Nevertheless, it is clear from Figure 7 and its corresponding description provided in the specification that supporting surfaces (16.1) of the projection (17) consisting of surface regions that are arranged at least locally with an offset, transversely to the tool feed direction (v), with respect to the supporting surface (18.1) or supporting surfaces (18.1) of the supporting projection (12) as stated in claim 19.

33. This Court is of the view that the technical objections, particularly those relating to the scope of claims under Section 10(4)(c) of the Patents Act, must be clearly communicated to the applicant at the examination stage. If Respondent No. 2 introduces new grounds for refusal for the first time in the final order, the applicant is effectively deprived of an opportunity to clarify the claims, amend the specification, or address Respondent No. 2’s concerns through submissions. Such a course of action runs contrary to the fundamental requirement of fairness and transparency embedded in quasi-judicial decision-making.

34. It is also pertinent to note that patent examination is inherently an interactive process, where deficiencies identified during prosecution are



ordinarily cured through amendments or clarifications. When objections are raised for the first time in the impugned order without prior notice, the applicant is denied the procedural opportunity that the statute guarantees.

35. In the present matter, while some objections relating to clarity of claim language had indeed been mentioned in the FER and the hearing notice, the impugned order proceeds to introduce additional technical objections and interpretative concerns that were not previously communicated to the applicant. These newly introduced grounds appear to have materially influenced the Respondent's conclusion that the claims fail to define the scope of the invention. The reliance on such uncommunicated objections renders the decision procedurally infirm.

36. Thus, this Court is of the opinion that the objection under Section 10(4)(c) of the Patents Act requires fresh analysis considering the submissions of the Appellant. This Court also does not think it appropriate to interfere with the compliance with the terms that were already raised in the hearing notice. However, the argument of Respondent No. 2 that the Appellant shall not rely on the description or drawings for claim interpretation does not stand merit. It is now a settled legal principle, as a Coordinate Bench of this Court and this Court has recently noted in **AGFA NV v. Controller of Patents & Designs**², and in **Resham Priyadarshini v. Controller of Patents & Designs**³ and also as is evident from the reading of Sections 10(4)(c) and 10(5) of the Patents Act, that the claims must be fairly based on the disclosure made in the specification. Hence, the claims, or any ambiguous terms in the claims, are to be read with the specification.

² 2023 SCC OnLine Del 3493

³ 2025 SCC OnLine Del 9655



Therefore, Respondent No. 2 shall give a fresh opportunity to the Appellant to respond to the objections to the satisfaction of Respondent No. 2 and thereafter reconsider the claims in light of the Complete Specification and the submissions of the Appellant.

Section 2(1)(ja) of the Patents Act

37. Now, this Court shall examine the objection of Respondent No. 2 that the Subject Patent Application does not have an inventive step as per Section 2(1)(ja) of the Patents Act.

38. The Court has considered the reasoning recorded by Respondent No. 2 in the impugned order, in relation to the findings on inventive step based on prior art documents DE102005017760 (D1), EP1761682 (D2), DE4322401 (D3), and CN101091037 (D4). Respondent No. 2 has concluded that the claims of the Subject Patent Application lack inventive step under Section 2(1)(ja) of the Patents Act when the teachings of D4 are combined with those of D1-D3.

39. It is pertinent to note that the Subject Patent Application has two (2) independent claims, Claims 1 and 16. Claim 1 relates to a bit holder comprising an insertion projection and a holding projection, wherein the supporting segment includes two supporting surfaces arranged at an angle to one another, and further wherein the longitudinal centre axis of the bit receptacle and the longitudinal axis of the insertion projection enclose an obtuse angle. The claim further specifies that the supporting surfaces are arranged on both sides of a transverse central plane extending in the tool feed direction.

Independent Claim 16 relates to a base part configured to receive the bit holder, wherein the base part includes supporting projections with prism-



shaped supporting surfaces arranged at an angle to one another, and wherein these surfaces also form an obtuse angular relationship with the longitudinal axis of the insertion receptacle.

40. Thus, the claims of the Complete Specification of the Subject Patent Application reveal that the invention lies in a specific geometric and structural arrangement of supporting and bearing surfaces between the bit holder and the base part, intended to create a stable support and guided engagement between the two (2) components.

41. According to the Respondent No. 2's reasoning in the impugned order, a person skilled in the art would combine the teachings of D4 with D1-D3 to arrive at the claimed invention.

42. However, the impugned order does not follow the five-step test prescribed by the Division Bench of this Court in **F. Hoffmann-La Roche Ltd. v. Cipla Ltd.**⁴, as reaffirmed by another Division Bench of this Court in **Tapas Chatterjee v. Controller of Patents & Designs**⁵.

43. Patent law requires that the conclusion of lack of inventive step as required under Section 2(1)(ja) of the Patents Act is to be supported by a reasoned analysis demonstrating why the Person Skilled in the art would have arrived at the claimed invention without inventive effort. The impugned order merely states that such a combination would be possible, without explaining why the skilled person would be led to modify the structures disclosed in D1-D3 in light of D4 to produce the particular angular and symmetric supporting surface arrangement claimed in the present invention.

⁴ 2015 SCC OnLine Del 13619

⁵ 2025 SCC OnLine Del 6369



The conclusions recorded therein with respect to inventive step are not supported by a proper feature-wise analysis of the claims vis-à-vis the cited prior art, nor do they disclose a reasoned basis explaining how a person skilled in the art would arrive at the claimed invention by combining the teachings of the cited documents.

44. In the absence of such reasoning, the finding of a lack of inventive step cannot be said to satisfy the analytical threshold ordinarily required in patent examination.

45. In light of the above analysis, the Court finds that the impugned order suffers from both analytical and procedural deficiencies and cannot be sustained in law.

46. Therefore, the impugned order does not stand merit and is liable to be set aside. The matter is remanded back to Respondent No. 2 for a *de novo* consideration in accordance with the law, after affording the applicant an adequate opportunity to address the objections under Sections 10(4)(c) and 2(1)(ja) of the Patents Act.

47. This Court clarifies that it has not expressed any binding opinion or view on the issues dealt herein. No observation made in this judgment is to be understood as expressing any view in that regard, as would bind the adjudicating authority.

48. The Controller would afford a fresh opportunity of hearing the Appellant before deciding the Subject Patent Application after giving a hearing notice to the Appellant. If any new material comes to the knowledge of the Respondent, the same would be put to the Appellant in the hearing notice so that the Appellant has an opportunity to deal with the same.

49. Accordingly, the appeal is allowed, and the following directions are



passed:

- i) The impugned order is set aside, and the matter is remanded back to the Patent Office for a fresh consideration of the objections under Sections 10(4)(c) and 2(1)(ja) of the Patents Act.
 - ii) A fresh hearing may be issued for the Appellant, demarking all the objections, including those which were freshly mentioned in the impugned order.
 - iii) The applicant shall have the liberty to file fresh written submissions along with an amended set of claims, if required.
 - iv) The Patent Office shall endeavour to decide the subject application in an expeditious manner, preferably within four (4) months from today.
50. The appeal stands disposed of in the aforesaid terms.
51. Pending application stands disposed of.
52. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trade Marks of India on the e-mail- llc-ipo@gov.in.

MANMEET PRITAM SINGH ARORA, J

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