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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated: 27.02.2025

CORAM

The Hon'ble Mr. Justice **SENTHILKUMAR RAMAMOORTHY**

(T) CMA (PT) No.152 of 2023
(OA/48/2020/PT/CHN)

Magneti Marelli S.P.A.
An Italian company,
of CORBETTA (ITALY)
Viale Aldo Borletti, 67/63,
Italy. ... Appellant

-vs-

The Assistant Controller of Patents & Designs.
The Patent Office,
IPR Building, SIDCO Plot,
GST Road, Guindy,
Chennai-600 032. ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) filed under Section 117A of the Patents Act, 1970, praying to (i) allow the present Appeal and set aside/quash the impugned order dated 18/03/2020, passed by the Respondent in Indian Patent Application No.420/CHE/2009; (b) direct grant of patent in respect thereof said Indian Patent Application No.420/CHE/2009; and ; (c) pass any other further order as this Hon'ble Court may deem fit and proper based on the facts of the case.

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For Appellant : Ms. Sarah Haque
Mr.K.Muthuselvam
for M/s.K & S Partners

For Respondents : Mr.N.Vijayaraman, SPC

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JUDGMENT

This appeal is directed against an order dated 18.03.2020 rejecting Patent Application No.420/CHE/2009 for grant of patent for an invention titled "CONTROL METHOD OF AN ELECTRONIC INJECTION FUEL FEEDING SYSTEM". Upon request by the appellant, the respondent issued the First Examination Report (FER) on 04.12.2017. In the FER, the respondent raised objections on the ground of lack of inventive step by citing three prior arts. The appellant responded to the FER on 16.01.2018 and submitted amended claims. By hearing notice dated 01.01.2020, a hearing was fixed on 15.01.2020. After the hearing, the appellant filed written submissions dated 28.01.2020. A further hearing notice dated 12.02.2020 was issued for a hearing on 26.02.2020. After attending the

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hearing, the appellant filed further written submissions dated 09.03.2020. The impugned order was issued thereafter.

2. Learned counsel for the appellant invited my attention to the current claims of the appellant comprising claims 1 to 15 (pages 154 to 157 of the paper book). By referring to paragraph 7 of the appeal, she pointed out the problem that the claimed invention seeks to solve. She also pointed out the nature of monopoly claim of the appellant with reference to paragraphs 12 and 13 of the appeal. By referring to the impugned order, learned counsel submitted that the order merely sets out the observations in the FER, the reply thereto and subsequent events, and that the operative portion thereof is confined to a few lines at page 40 of the appeal paper book. In effect, the contention of learned counsel for the appellant is that the submissions made by the appellant to establish that the claimed invention would not be obvious from prior arts D1 to D3 were not discussed in the impugned order. She also submits that the

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impugned order is bereft of reasons in support of the conclusion that prior arts D1, D2 and D3 disclose all the elements and features of the claimed invention.

3. Learned counsel for the respondent reiterates the conclusions recorded in the impugned order. In any event, the respondent cannot improve on the impugned order by way of a counter affidavit or otherwise. Therefore, the limited issue that falls for consideration is whether the conclusions recorded in the impugned order were drawn after taking into account the contentions of the appellant and whether the said order contains reasons in support of the conclusion that the claimed invention would be obvious from prior arts D1 to D3.

4. The operative portion of the impugned order is set out below:

"Apart from the document D2, document D1 and

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D3 also discloses the other elements and features of the claimed subject matter as mentioned in the hearing notices.

Therefore based upon the above facts and submission, it is concluded that the objection regarding inventive step is still pending, hence the claims 1-15 do not constitute an inventive step u/s.2(1)(ja) of the Patents Act.

Moreover no representation has been filed U/S 25(1) of the Patents Act, therefore I hereby refuse the grant of patent for the instant Patent application No.420/CHE/2009 with FIFTEEN (15) claims."

Thus, it is clear that the respondent concluded that prior arts D1 to D3 disclose all the elements and features of the claimed invention. Whether this conclusion warrants interference is required to be examined.

5. Independent claim 1 of the appellant is as under:

"1. A control method of an electronic injection fuel feeding system (12) for an internal combustion engine (1) and including at least one injector (13) and a non-continuous flow rate fuel pump (14) actuated by an actuator device (27); the control

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method including the steps of:

determining the desired fuel amount (Mfuel) which must be injected at each cycle of the internal combustion engine (1);

driving the injector (3) for injecting the desired fuel amount (Mfuel) at each cycle of the internal combustion engine (1) and at an injection frequency (Finj) depending on the rotation speed of the internal combustion engine (1);

determining an optimal pumping frequency (Fpump) of the actuator device (27) of the fuel pump (14) according to the desired fuel amount (Mfuel) which must be injected at each cycle of the internal combustion engine (1); and

actuating the actuator device (27) of the fuel pump (14) at the optimal pumping frequency (Fpump);

the control method is characterized in that it includes the steps of:

determining in a design phase, a lower threshold value (Th1) and a higher threshold value (Th2); comparing the desired fuel amount (Mfuel) with the two threshold values (Th1, Th2);

assigning to the optimal pumping frequency (Fpump) a value which is independent from the injection frequency (Finj) when the desired fuel amount (Mfuel) is lower than the lower threshold value (Th1) or when the desired fuel amount (Mfuel) is higher than the higher threshold value

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(Th2) in order to drive the fuel pump (14) in an asynchronous manner with respect to the driving of the injector (3); and

assigning to the optimal pumping frequency (Fpump) the same value of the injection frequency (Finj) when the desired fuel amount (Mfuel) is comprised between the two threshold values (Th1, Th2) in order to drive the fuel pump (14) in a synchronous manner with respect to the driving of the injector (3).”

6. Both in the written submissions and in the appeal, the appellant has distinguished each of the prior arts. For purposes of disposing of this appeal, it is sufficient to set out the following contentions with regard to prior arts D1, D2 and D3.

“15.4 Thus, document D1 completely fails to disclose to determine an optimal pumping frequency of the actuator device of the fuel pump according to the desired fuel amount.

15.5 Furthermore, document D1 fails to disclose:

- *to assign to the optimal pumping frequency a fixed value when the desired fuel amount is lower than the lower threshold value or when the desired fuel amount is higher than*

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the higher threshold value: and

- *to assign to the optimal pumping frequency the same value of the injection frequency when the desired fuel amount is comprised between the two threshold values.*

....

16.2 It is submitted that Document D2 discloses calculating the pumping frequency of the actuator device of the fuel pump 8 (i.e. driving frequency of the fuel pump 8) only as a function of the engine rotation speed (i.e. the engine rpm). Please see paragraphs [0029]-[0032] of D2.

....

17.2 Document D3 discloses modifying the optimal pumping frequency of the actuator device of the fuel pump as a function of the delivery capacity of the fuel pump (which can be correlated to the desired fuel amount). In particular:

I. when the delivery capacity of the fuel pump (the desired fuel amount) is high then the optimal pumping frequency is a lower fixed value (as shown in region I of Figure 2 of D3),

II. when the delivery capacity of the fuel pump

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(the desired fuel amount) is medium then the optimal pumping frequency is a medium fixed value (as shown in region II of Figure 2 of D3).

III. When the delivery capacity of the fuel pump (the desired fuel amount) is low then the optimal pumping frequency is a higher fixed value (as shown in region III of Figure 2 of D3)

17.3 Accordingly, it is clear that D3 also fails to disclose at the features as emphasized of claim 1 of the patent application. Therefore, D1, D2 and D3, whether read singularly or in combination, fail to disclose the features as recited in claims of the Patent Application. Thus, claims of the Patent Application are novel and inventive over documents D1-D3."

7. On closely examining the impugned order, it is abundantly clear that the respondent failed to consider the contentions of the appellant with regard to the distinction between the claimed invention and prior arts D1 to D3. Instead, the recitals from the said prior arts have been extracted in part and a conclusion (unsupported

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by reasons) has been reached that the claimed invention would be obvious from prior arts D1 to D3. In particular, the respondent failed to indicate why a person skilled in the art would be led to the claimed invention upon examining prior arts D1 to D3. Therefore, the impugned order calls for interference.

8. Hence, impugned order dated 18.03.2020 is set aside and the matter is remanded for reconsideration on the following terms:

(i) In order to preclude the possibility of pre-determination, an officer other than the officer who issued the impugned order, shall undertake such re-consideration.

(ii) After providing a reasonable opportunity to the appellant, a reasoned order shall be issued within a period of four months from the date of receipt of a copy of this order, after taking into account the observations contained in this order.

(iii) For the avoidance of doubt, it is made clear that no opinion has been expressed herein on the merits of the patent application.

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9. Consequently, (T)CMA(PT)/152/2023 is disposed of on the above terms without any order as to costs.

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Index : Yes/No
Internet : Yes/No
Neutral Citation: Yes/No
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To

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