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

% *Date of decision: 23rd April, 2025*

\+ C.A.(COMM.IPD-PAT) 7/2024

BMI GROUP DANMARK APS (FORMERLY ICOPAL DANMARK APS) .....Appellant

Through: Mr. Essenese Obhan and Ms. Anjuri Saxena, Advocates.

versus

THE ASSISTANT CONTROLLER OF PATENTS AND DESIGNS AND ANOTHER .....Respondent

Through: Ms. Rukhmini Bobde, CGSC with Mr. Jatin Dhamija, Mr. Amlaan Kumar and Mr. Vinayak Aren, Advocates.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. The present appeal has been filed under Section 117A of the Patents Act, 1970 (hereinafter 'Act') and is directed against the order dated 17th November, 2023 (hereinafter 'impugned order') passed by the Controller of Patents and Designs (hereinafter 'Controller'), whereby the Indian Patent Application No. 202017020602 titled *'SEALING WEB'* related to a multilayer sealing web for a region of a structure, such as a roof, cladding, cellar, or tanks (hereinafter 'subject patent application') has been refused.

2. The subject patent application was filed as a national phase application in Indian Patent Office, Delhi on 15th May, 2020 under the

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Patent Cooperation Treaty (hereinafter the 'PCT') with PCT application number PCT/EP2018/080342 dated 6th November, 2018, claiming priority from a German Patent application dated 22nd December, 2017.

3. A First Examination Report ("FER") in respect of the present patent application was issued on 16th December, 2021, raising various objections against the subject application. The relevant objections are as follows:

a) The Claims lack inventive step under Section 2(1)(ja) of the Act in the view of the prior arts D1: EP1664447A1, D2: EP1500493A1, D3: EP2276806B1 & D4: EP2299021A2.

b) Complete specification does not fulfil the requirements under Section 10 of the Act.

4. The Response to the FER was submitted by the agents of the appellant on 23rd May, 2022. Along with the response to the FER, the Appellant also submitted an amended set of claims and requested for a hearing in the matter.

5. Thereafter, a hearing notice was issued by the Indian Patent Office, on 10th August, 2023, following which an extended hearing notice was issued on 1st September, 2023, maintaining the objections raised in the FER under Sections 2(1)(ja) and 10 of the Act. However, a different set of prior arts were cited, which are as follows:

a) D1: DE3150021C1,

b) D2: KR101592047B1

c) D3: JP2612958B2

6. After the hearing, detailed written submissions and further amended set of claims were submitted by the Appellant on 29th September, 2023.

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7. Subsequent to the hearing, the impugned order was passed by the respondent No. 1, refusing the grant of subject patent application under Section 2(1)(ja) of the Act, in light of the prior arts D1 to D3.

8. Mr. Essenese Obhan, counsel appearing on behalf of the appellant submits that the impugned order completely lacks any reasoning for arriving at the conclusion that the claimed invention lacks inventive steps. He has drawn attention of the Court to the technical analysis carried out by the learned Controller in Section F of the impugned order. He submits that the reasoning provided in the impugned order is insufficient to support the conclusions reached therein.

9. The counsel has also submitted that the respondent has failed to provide any reasoning as to how the cited prior arts in combination disclose, teach, suggest or motivate all the features of the subject patent application to a person skilled in the art.

10. It is further submitted that the respondent has failed to understand the teachings of the prior art document D2 and has therefore applied them incorrectly to reach the impugned order.

11. Per contra, Ms. Rukhmini Bobde, counsel appearing on behalf of the respondent defends the impugned order. She submits that the Controller has correctly arrived at the conclusion that the subject patent application is obvious for a person skilled in the art when prior arts D1 to D3 are read in combination and therefore, lacks inventive step.

12. Ms. Bobde submits that D1 specifies the use of glass fibre in the construction industry and states that the multi-layer sealing membrane has a high level of dimensional stability and prevents shrinkage in construction under temperature changes during the summer/winter weathering process.

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13. I have heard the counsel for the parties.

14. At the outset, it may be relevant to refer to claim 1 of the subject invention which is set out below:-

> *"1. A multi-layer sealing web (10) for a region of a structure, such as a roof, cladding, cellar or tanks, the outer layers (14, 22, 24) of which contain a base polymer such as polyvinyl chloride or a polyvinylchloride-copolymer, and a plasticiser, as well as combination carrier insert (16) between the outer layers,* ***characterized in that the combination carrier insert contains a glass nonwoven (20) and a glass reinforcement (18), wherein the glass reinforcement consists of or contains a knitted fabric.*** *"*

15. From the above-extracted independent claim, the characteristic feature of the claim 1 is the 'carrier insert' with a combination of the following:

i. A glass nonwoven (20); and

ii. A glass reinforcement (18) which consists of or contains a knitted fabric.

16. The impugned order has analysed the independent claim 1 as outlined in the section F in the following manner : -

> *"F. The instant application (202017020602) a multi-layer sealing web with following features:-*
>
> - *sealing web comprising outer layers which contains a base polymer (polyvinyl chloride or a polyvinylchloride-copolymer) and a plasticizer.*
> - ***combination carrier insert provided between the outer layers and has a glass nonwoven.***
> - ***a glass reinforcement that consists of a knitted fabric (weft-knitted fabric or a warp-knitted)***
> - *outer layers connected by means of a binding agent.*

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- *Other features such construction of the layers, use of binding agent to attach glass reinforcement and glass nonwoven, construction parameters of nonwoven, reinforcement etc., mechanical properties of the web, corresponding process and equipment to produce the web etc."*

17. The bullet points 2 and 3 set out above seem to suggest that the Controller has taken the 'nonwoven membrane' and the 'glass reinforcement' as separate elements of the claim and not in a combination. Therefore, the Controller has failed to appreciate the invention as claimed in the subject patent application. It is clear from the above analysis that the characteristic feature of the claimed invention requires the carrier insert to comprise a combination of 'glass nonwoven' and a 'glass reinforcement, which consists of or includes knitted fabric', and not merely a 'glass nonwoven' as noted in paragraph F of the impugned order

18. At this juncture, reference may also be made to the table in the impugned order providing the technical analysis: -

"Technical Analysis:

S.No.	***Technical Feature (Instant application)***	***Disclosed in***
1.	*Multi-layer sealing web*	*DI (claim 1), D3 (claim 1); Examples*
2.	*Base polymer such as polyvinyl chloride or a polyvinylchloride-copolymer,*	*DI (Description: Paragraph [0024]-[0026])*
3.	*Carrier insert-glass nonwoven,*	*DI (Description: Paragraph [0025]*
4.	*Knitted fabric (reinforcement)*	*D2 (claim 1)*

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5.	*Binding agent (styrene-butadiene, acrylate, EVA (ethylene-vinyl acetate) etc*	*D2 (Description: Paragraph [0075])*
6.	*Linking yams (polyester, polypropylene, polyamide, glass*	*D2 (Description: Paragraph [0015]-[0018])*
7.	*Tensile strength*	*DI (Description: Paragraph [0018]-[0026])*
8.	*Tear resistance*	*Same as above*
9.	*Additives*	*DI (Description: Paragraph [0050]-[0054], [0092])*
10.	*Process for producing a sealing web*	*DI (Description: Paragraph [0092]-[0094])*
11	*Equipment for producing a sealing web*	*DI (Description: Paragraph [0095]-[0096])*

G. Thus, it is evident that by combined teachings of documents D1-D3, a person skilled in the art would arrive at the construction mentioned in the instant application. Other features, if any, not mentioned above are mere parameters which any skilled person would achieve in an industrial setup."

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19. A perusal of the aforesaid table would show that only claim 1 of the prior art D2 deals with ‘knitted fabric (reinforcement)’. None of the other prior arts D1 and D3 deals with ‘knitted fabric (reinforcement)’.

20. I have examined the prior art D2, which has been filed along with the appeal as Document -9.

21. An examination of D2 would show that the same is purely in the context of a decorative fabric. The prior art D2 discloses textile fabric materials for visually appealing applications with resistance to fingerprints, sweat stains, and moisture, and a pleasant tactile feel. In this regard, reference may be made to paragraph 0006 and paragraph 0016 of the prior art D2, which are set out below:-

> *“[0006] Textiles are not only used for apparel but also at numerous places which serve partly or predominantly decorative purposes. Examples are drapes, textiles on seats such as for example automotive seats or sitting furniture, interior trim of vehicles such as for example automobiles, textile wall coverings and so on and on. An appealing appearance is therefore essential.*
> *[0016] Textile (A) preferably comprises wovens, formed-loop knits or drawn-loop knits.”*

22. In contrast, the subject patent application relates to a multi-layer sealing web for structures like roofs and tanks, offering high stability, low shrinkage, and smoother outer structure. In this regard a reference can be made to the paragraphs of the complete specification of the subject patent application:

> *“The invention is for a multi-layer sealing web for a region of a structure, such as a roof, cladding, cellar or tanks; the sealing web features outer layers which contain a base polymer such as polyvinyl chloride or a polychloride-copolymer, and a plasticiser, as well as a combination carrier insert which is located between the outer layers and features a glass nonwoven and 5 glass reinforcement.*
> ***
> *The invention at hand is based on the task of further developing a sealing*

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web of the type mentioned above in such a way that it can be produced cost-effectively, has high dimensional stability and low shrinkage characteristics. A problem-free mechanical attachment should be made possible."

23. It is the settled position of patent law that, while analysing inventive step of an invention, mosaicing of prior arts are permitted only if they are analogous to the claimed invention. If a reference is not analogous art to the claimed invention, it can not be used for rejecting a patent application on the ground of lack of inventive step .

24. A reference in this regard can be made to ***Bristol-Myers Squibb Holdings Unlimited Company and Others v. BDR Pharmaceuticals International Pvt. Ltd. 2020 SCC OnLine Del 1700***. The relevant extract from this judgment is reproduced here below:

"36. From the judgments as noted above, some of the principles which govern the field to find out whether an invention is obvious or not can be summed up as under: —
(i) A hindsight reconstruction by using the patent in question as a guide through the maze of prior art references in the right way so as to achieve the result of the claim in the suit, is required to be avoided.
(v) Though mosaic of prior art documents may be done in order to claim obviousness, however, in doing so, the party claiming obviousness must be able to demonstrate not only the prior art exists but how the person of ordinary skill in the art would have been led to combine the relevant components from the mosaic of prior art.
(vii) Though it would be tempting to put together a combination of prior arts but this requires a significant degree of hindsight, both in selection of relevant disclosures from these documents and also in disregarding the irrelevant or unhelpful teachings in them."

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25. The Intellectual Property Appellate Board (IPAB) in ***Pharmacyclics LLC vs. Controller General of Patents***, OA/46/2020/PT/DEL has also made this proposition clear, that there cannot be any determination of inventive step based on non-analogous prior art.

26. In the present case, the reliance placed by the Controller on the non-analogous prior art D2, along with D1 and D3, for assessing inventive step is misplaced.

27. On an independent analysis of inventive step in light of prior art D1 and D3, it is clear that D1 discloses a multilayered sealing sheet of elastomeric synthetic resin. The sealing sheet consists of three layers, namely two outer layers (1) and (3) and a reinforcing insert (2). The reinforcing insert consists of glass fabric and there are no further details of the reinforcing insert as recited in claim 1. Moreover, D3 is directed towards polymer waterproofing membrane, where the web has a carrier material, which can be a woven fabric, a texture or a fleece, or any combination thereof, made of plastic material, fibers and/or glass fibers.

28. Thus, D1 and D3 in combination does not disclose, teach, suggest or motivate a person skilled in art to reach at the subject patent application related to multi-layer sealing web, which comprises of a combination carrier insert that contains a ‘glass nonwoven’ (20) and a ‘glass reinforcement’ (18), wherein the ‘glass reinforcement’ which consists of or contains a ‘knitted fabric’, which will result in the required properties.

29. Hence, the subject patent application will not be obvious for a person skilled in the relevant art in light of prior art D1 and D3.

30. Accordingly, the appeal is allowed and the impugned order dated 17th November, 2023 is set aside. The Patent Office shall proceed to grant the

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patent in favour of the appellant.

31. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trademarks of India on the e-mail- *llc-ipo@gov.in* for compliance.

AMIT BANSAL, J

APRIL 23, 2025
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