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

+ C.A. (COMM.IPD-PAT) 60/2024

DONG YANG PC, INC

.....Appellant

Through: Mr. Pravin Anand, Mr. Ravi
Aggarwal, Advocates
(M:9910696749)

versus

CONTROLLER OF PATENTS AND DESIGNS

.....Respondent

Through: Mr. Ankur Mittal, CGSC with Mr.
Aviraj Pandey, Advocates
(M:8827993500)
Email: aviraj.pandey@outlook.com

CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA

JUDGMENT
01.07.2025

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MINI PUSHKARNA, J:

1. The present appeal has been filed under Section 117A of the Patents Act, 1970 ("Patents Act") against the order dated 12th April, 2024, passed by the respondent, i.e., Controller of Patents and Designs. By way of the impugned order, the respondent rejected the appellant's Indian Patent Application no. 2554/DEL/2013 ("subject application"), under Section 15 of the Patents Act.

2. Brief facts relevant to decide the present appeal, are as follows:

2.1 The appellant filed the subject application on 29th August, 2013 for the invention titled as 'Vertical Rotary Parking System' ("subject



invention”), used as a parking system so as to park as many vehicles as possible in a narrow space.

2.2 A request for examination of the said application was filed on 04th September, 2013. The application was published under the provisions of Section 11A of the Patents Act.

2.3 The application was examined and subsequently the First Examination Report (“FER”) was issued on 14th August, 2018 by the respondent in terms of Sections 12 and 13 of the Patents Act.

2.4 In response to the objections raised in the aforesaid FER, a response dated 11th January, 2019 was submitted by the appellant before the Indian Patent Office.

2.5 The opponent, i.e., M/s. Parkerbot India Private Limited, filed a pre-grant opposition on 15th June, 2019, citing prior documents D-1 to D-4. The Patent Office issued a pre-grant notice on 08th February, 2023. The appellant filed a reply statement and evidence before the Patent Office on 04th May, 2023, in response to the pre-grant opposition.

2.6 Thereafter, the appellant was intimated by the respondent that a hearing was scheduled for 03rd November, 2023. However, few days prior to the scheduled hearing, the opponent informed the respondent about a document D-5. Notably, D-5 was never part of the original pre-grant opposition.

2.7 The appellant attended the aforesaid hearing and filed its submissions before the Patent Office on 18th November, 2023, however, the opponent did not attend the said hearing. In view of subsequent cited D-5, the appellant also filed a Form-13 for amendment in specifications before the Patent Office on 18th November, 2023.



2.8 The respondent by the impugned order dated 12th April, 2024, while disregarding the pre-grant opposition based on cited prior document D-1 to D-4, rejected the patent application of the appellant, citing lack of inventive step in view of the document D-5 and by stating that claimed invention was not an invention as per Section 2(1)(ja) of the Patents Act. Further, the respondent also refused amendment in the Specifications under Section 15 of the Patents Act. Hence, the present appeal has been filed.

3. It is submitted on behalf of the appellant that the respondent has acknowledged that the claimed invention is novel over the prior art document D-5. However, the appellant's application was wrongly dismissed on the ground that the appellant's invention was a mere workshop modification of the cited document D-5.

4. Learned counsel appearing for the appellant submits that even a simple invention, if novel and non-obvious, warrants patent protection. Further, the appellant had voluntarily amended the background of the invention by including a reference to document D-5 as prior art, highlighting the drawbacks of D-5 in comparison to the present invention. However, the Controller erroneously refused to allow the said amendment to the specifications.

5. *Per contra*, on behalf of the respondent, it is submitted that a detailed comparative analysis establishes that the distinguishing feature in the present invention is limited to mere reversal/interchange of the male and female coupling elements of the meshing point between the suspension chain and the pull gear. Further, the said alteration is mechanical in nature and does not result in any technical improvement over the cited prior art document D-5. Moreover, the inversion of coupling components was found to be evident



to a person skilled in the art, and not accompanied by any substantiating data or technical information demonstrating an inventive step or performance advantage.

6. Learned counsel for the respondent relied upon a judgment of Supreme Court in the case of ***Bishwanath Prasad Radhey Shyam Versus Hindustan Metal Industries, (1979) 2 SCC 511***, to submit that as per Supreme Court, mere alterations or predictable variations in known mechanism, do not qualify as inventions. Teachings of D-5, which is a prior art publication belonging to the appellant itself, are sufficient to establish what would be commonly known to a person skilled in the art. Thus, the refusal of the patent application stands justified, as the claimed subject matter is not inventive and is plainly obvious in view of the prior art document D-5.

7. The rejection of the appellant's amendment application has also been justified by the respondent on the ground that the claim of technical advancement over D-5, which is appellant's own prior art, was raised for the first time in the amendment, whereas, as per the statutory requirement, all material facts, including, any asserted technical advancement, must be disclosed in the complete specification at the time of filing.

8. Having heard learned counsels for the parties, this Court at the outset notes that the subject invention is a Vertical Rotary Parking System, which has been explained by the appellant, in the following manner:

“xxx xxx xxx

23. The invention is a vertical rotary parking system, comprising of support plates (140) attached at regular intervals to a circulating main chain (130) with link plates (131) within an endless track. Pallets (120) equipped with pallet plates (125) for vehicle placement



are supported by these support plates (140) and driven by a motorized mechanism. The driving unit comprises a frame (100), a driving motor (200), chain guide rails (111, 112), a rotatable ring gear (150), a support unit, pull blocks (155) with pull grooves (155a), and a pinion (210). The support plates (140) and link plates (131) of the main chain (130) are connected to the pull blocks (155) using first combining protrusions (141) and second combining protrusions (131a), allowing them to cooperate and drive the main chain (130) when the pinion (210) engages the gear of the ring gear (150) powered by the driving motor (200).

xxx xxx xxx”

9. It is to be noted that the appellant had also invented and patented a Vertical Rotary Parking System, earlier, i.e., D-5. However, as per the appellant, the said Vertical Rotary Parking System had issues with complex driving unit structures that involved multiple chains, sprockets and power transmission components, leading to generation of noise due to friction on account of continuous engagement of main chain with the sprockets. Thus, as per the appellant, there was a need for an efficient and quieter Vertical Rotary Parking System for storing vehicles in a limited space.

10. As per the case put forward by the appellant, the subject invention promotes a smoother and more consistent motion with reduced friction and fewer contact points, which help to significantly reduce the noise levels in the Vertical Rotary Parking System. In the subject invention, the female portions of the suspension chain, shown in cited prior art D-5, was replaced with male portions of suspension. The comparison between the old Vertical Rotary Parking System (D-5) and the subject invention, as placed on record, is extracted as below:



Simulation Comparative Results of CHAIN PLATE C0003

OLD DESIGN CHAIN PLATE C0003



Displacement

- The induced Displacement obtained with a given Load of 3000Kg is 2.694mm. Which will effect the profile of the chain plate and weaken the strength of the plate.

NEW DESIGN CHAIN PLATE C0003

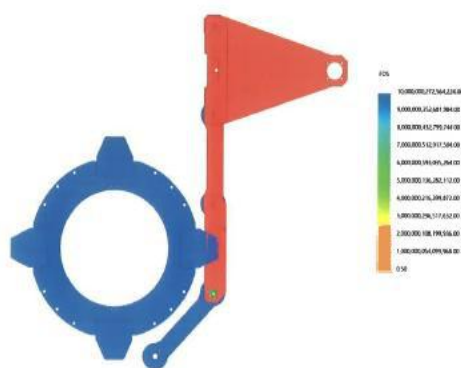


Displacement

- The induced Displacement obtained with a given Load of 3000Kg is 0.951mm. Which will comparatively have no effect on the profile and strength of the plate.

Simulation Comparative Results of CHAIN PLATE C0003

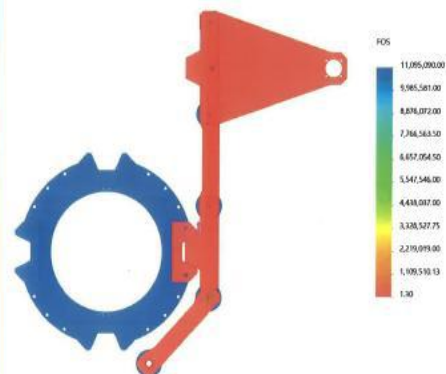
OLD DESIGN CHAIN PLATE C0003



Factor of Safety (FOS)

- The Factor of Safety, which is obtained after the application of 3000Kg is 0.5. Which is lesser than 1. This proves that the design is not safe enough to carry the given Load.

NEW DESIGN CHAIN PLATE C0003



Factor of Safety (FOS)

- The Factor of Safety, which is obtained after the application of 3000Kg is 1.3. Which is higher than 1. This proves that the design is Safe enough to carry the given Load.



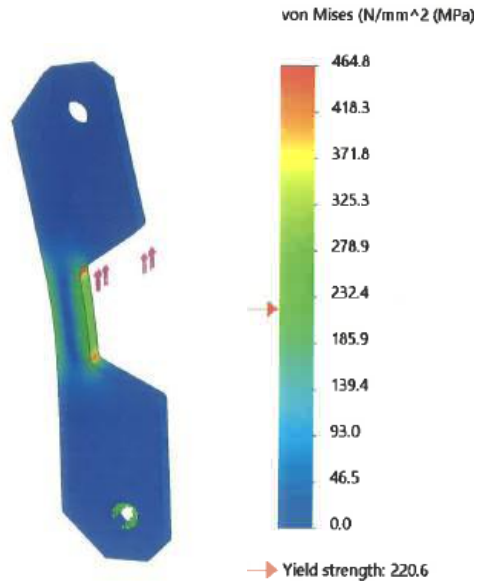
2025:DHC:5124



Simulation Comparative Results of CHAIN PLATE C0003

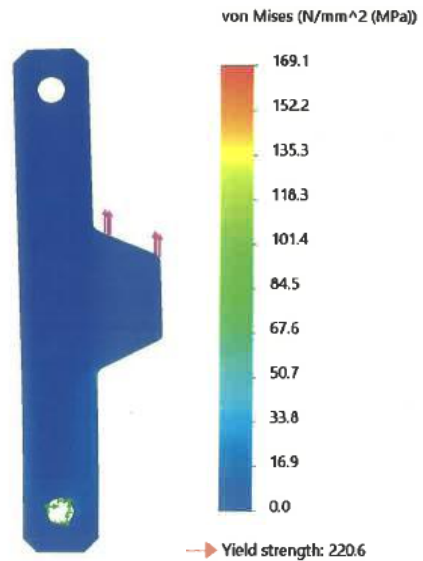
OLD DESIGN CHAIN PLATE C0003

NEW DESIGN CHAIN PLATE C0003



Stress

- The induced Stress is 464.8 N/mm², which is greater than the Yield Strength 220.6 N/mm². Especially in the valley portion of the V-Cut. Hence it proves that the previous design is not sufficient enough to transmit a given load of



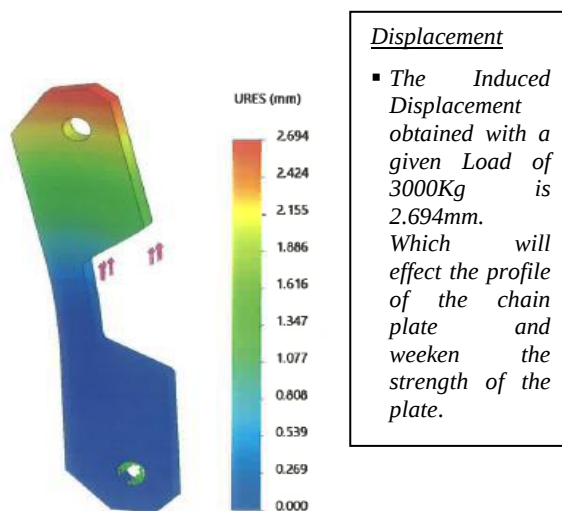
Stress

- The induced Stress is 169.1 N/mm², which is less than the Yield Strength 220.6 N/mm². Hence it proves that the New design is sufficient enough to transmit a given load of 3000Kg.

Simulation Comparative Results of CHAIN PLATE C0003

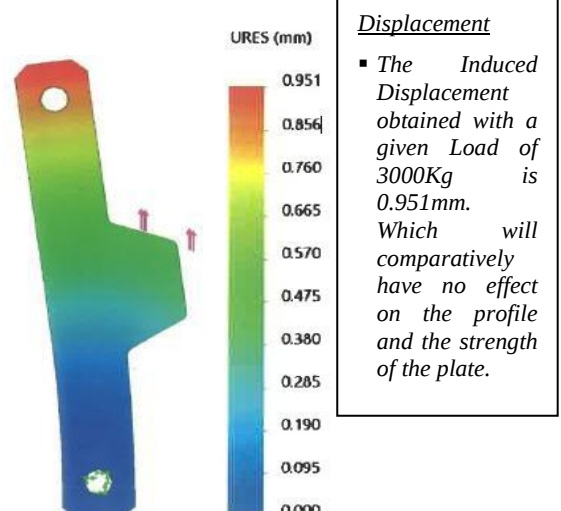
OLD DESIGN CHAIN PLATE C0003

NEW DESIGN CHAIN PLATE C0003



Displacement

- The Induced Displacement obtained with a given Load of 3000Kg is 2.694mm. Which will effect the profile of the chain plate and weaken the strength of the plate.



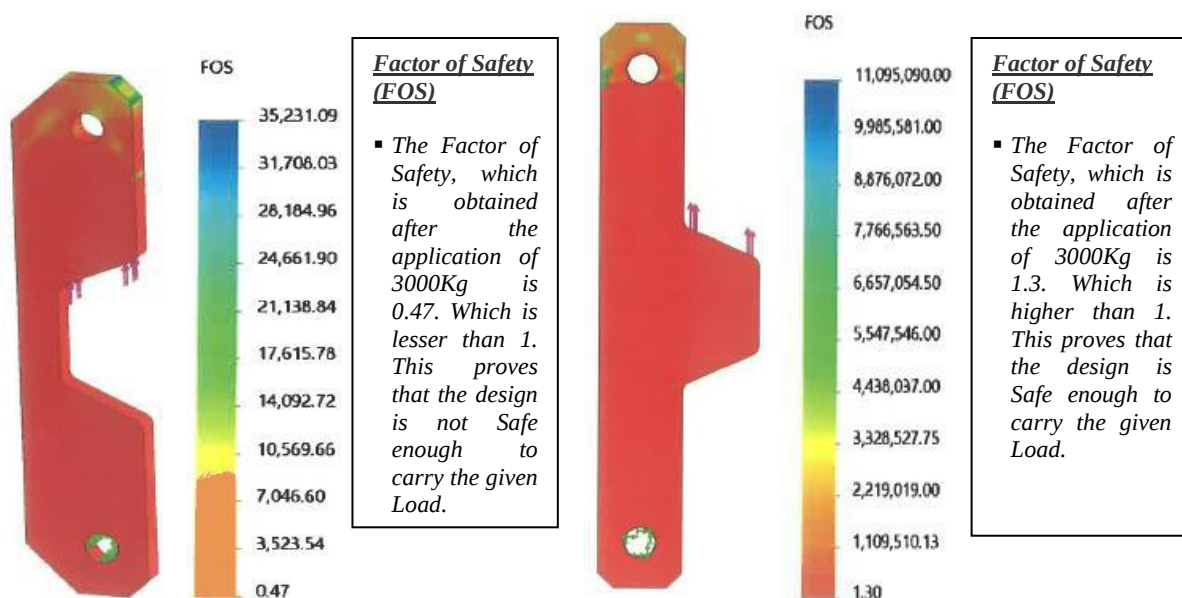
Displacement

- The Induced Displacement obtained with a given Load of 3000Kg is 0.951mm. Which will comparatively have no effect on the profile and the strength of the plate.



Simulation Comparative Results of CHAIN PLATE C0003

OLD DESIGN CHAIN PLATE C0003



11. However, the subject invention was rejected by the respondent on the ground that the claimed invention lacks an inventive step and does not demonstrate any technical advancement over the cited prior art document D-5 and that the same was not inventive, being obvious. Further, it was held that the appellant had done only workshop modification in the Vertical Rotary Parking System by interchanging the male portions with female portions of the pull gear and suspension chain. The relevant portion of the impugned order dated 12th April, 2024 is extracted as below:

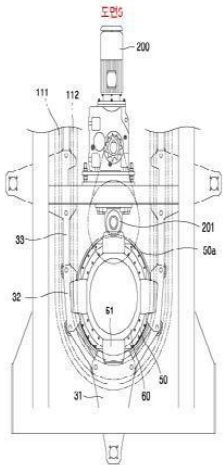
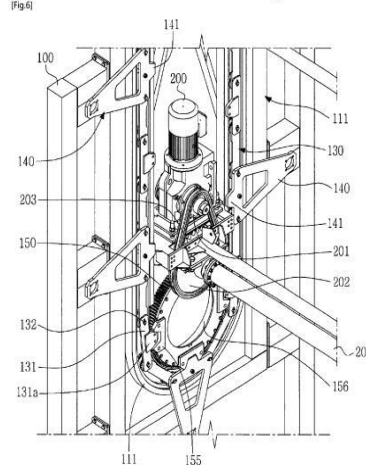
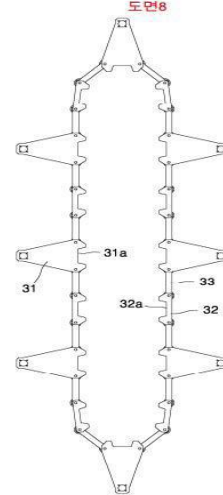
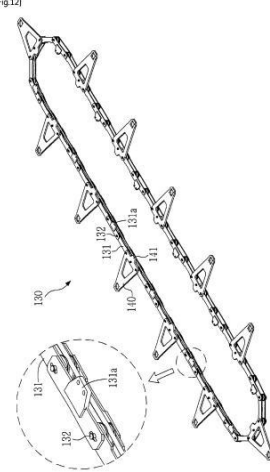


2025:DHC:5124

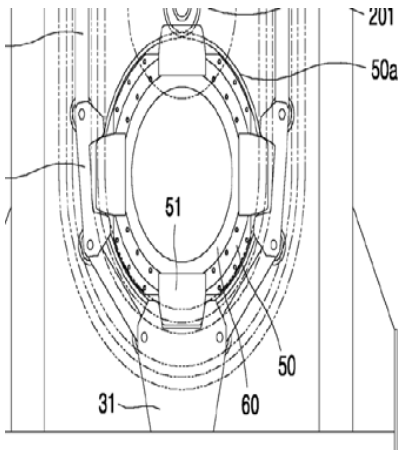
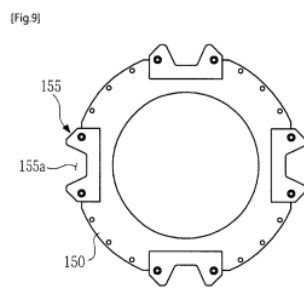


“xxx xxx xxx

Novelty and inventive step analysis with respect to cited document D5

D5: KR200326138Y1 Published on 13/09/2003	2554/DEL/2013present invention	Findings
		In both the documents, The drive motor 200 transmits the power to externally meshed ring gear by means of pinion.
 31a-First coupling groove (let's say it first Female portion) 32a- second coupling groove (let's say it second Female portion)	 141- First combining protrusions member (let's say it male portion) 131a-Second protrusion combining member (let's say male portion)	<u>From this, it can be seen that the FEMALE PORTIONS of suspension chain shown in D5 is replaced with MALE portions of suspension chain as shown in the present invention.</u>



 Four traction blocks 51 (let's say MALE PORTIONS) are fixed to the annular rotary body 50	 Four pull grooves 155a (let's say HAVING FEMALE PORTIONS) are fixed to the pull block 155.	<u>From this, it can be seen that the MALE PORTIONS of rotating body 50 shown in D5 is replaced with FEMALE portions of rotating body i.e. pull block 150 as shown in the present invention.</u>
2554/DEL/2015 present invention	D5: KR200326138Y1 Published on 13/09/2003	Relevant comparison
Claim 1 A vertical rotary parking system, wherein support plates (140) are fixed at regular intervals to a main chain (130) having link plates (131) that is circulated in an endless track, and pallets (120) having pallet plates (125) on which vehicles are mounted are supported by the support plates (140) and are circulated by a driving unit, wherein the driving unit comprises: a frame (100); a driving motor (200) fixed to the frame (100) and generating power; chain guide rails (111,112) supported by the frame (100) and guiding the main chain (130); a ring gear (150) rotatably supported by the frame (100) and having a gear on an outer circumference; a pinion	A drive shaft 230 having a pinion 201 and a drive sprocket 231 engaged with the external gear 50a is provided at an end of the frame 100, and the drive shaft 230 is rotatably driven by connecting the motor sprocket 210 of the drive motor 200 and the chain 220 of the drive sprocket 231.[Para 0040]	Power is getting transmitted from drive motor to pull gear by means of externally meshed by means of pinion in both the documents.



<i>(210) engaging with the gear of the ring gear (150) and rotated by power of the driving motor (200), characterized by</i>		
<i><u>a support unit rotatably supporting the ring gear (150) to the frame (100);</u></i>	<i>The suspension chain 30 is circulated by an annular rotating body 50 provided with an external gear 50a which is rotationally driven by the drive motor 200. <u>The annular rotating body 50 is rotatably supported by the frame 100, And is rotatably supported by a fixed annular fixture 60 by a bearing [para 0039]</u></i>	<i>Rings gears supported by frames is disclosed in both D5 and 2554/DEL/2013</i>
<i><u>a plurality of pull blocks (155) fixed to a side of the ring gear (150) at regular intervals and having a pull groove (155a);</u></i>	<i><u>Four traction blocks 51 are fixed to the annular rotary body 50 at intervals of 90 degrees to pull the suspension chain 30. [para 0041]</u></i>	<i>Traction blocks 51 <u>fixed to the annular rotary body 50</u> as shown in D5 perform same function as pull blocks 155 of the present invention.</i>
<i><u>and a first combining protrusion (141) comprised at the support plates (140), and a second combining protrusion (131a) comprised at the link plate (131) of the main chain (130), are coupled to the pull groove (155a) of the pull blocks (155), such that the first combining protrusion (141) and the second combining protrusion (131a) go in and out of the pull groove (155a) for together driving the main chain (130).</u></i>	<i>The first and second coupling grooves 31a and 32a are formed on the hanger support plate 31 and the chain link plate 32 to be coupled with the pulling block 51, respectively. By providing a plurality of the pulling blocks 51, The engagement between the block 51 and the first and second coupling grooves 31a and 32a is minimized to enable precise engagement, thereby greatly reducing vibration and noise of the device. [0054]</i>	<i>First combining protrusion 141 and second combining protrusion (131a) in the present invention (let's say it as male portions) are in meshed with Pull groove 155a (let's say it as female portion) of pull block 155.</i> <i>Similarly in D5, First and second coupling grooves 31a and 32a</i>



		(female portion) meshed with traction blocks 51 (male portion) of rotary annular body 50. <u>From the drawing comparison, it is clear that male and female members of components are only interchanged. So no technical advancement can be considered in view of prior art document D5. So features of claim 1 are not inventive.</u>
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Regarding novelty ground, it can be seen from the above comparison, the applicant has done the workshop modification in the vertical rotary parking system as disclosed in the cited document D5. It can be seen from drawing comparison table that the applicant has only interchanged the male portions with female portions (as assumed in the drawing comparison table) of the pull gear and suspension chain. To challenge the novelty of the invention, it is a well-established matter in law that, each and every feature of the claim shall be found in a single disclosure. In view of this, as the features are having little deviations in comparison to document D5, Novelty ground cannot be considered here.

The closest prior art D5 is relevant here for inventive step analysis as it is the most relevant document for inventive step consideration. The other cited document D1-D4 discloses different configuration of parking system. Document D1 or D3 (same patent family) analysis already explained above. D2 and D4 show different configuration of



parking system and these documents are not suggesting the features of claimed invention.

As the modification made in the existing parking system as disclosed in prior art document D5, we have to see the technical advancement over existing vertical rotary parking system.

From the above comparison table, it is evident that in both the documents, there are four pull groove to transmit the power to suspension chains. The construction of pull gear and suspension chain is also similar. Both the parking system transmits the power from drive motor 200 to pull gear 50,155 by externally meshed ring and pinion gear. The difference can be seen while comparing the document D5 and the present invention, is in the male and female portion (as assumed in the drawing comparison table) mounted on both suspensions chain and pull gear or ring gear.

From the above comparison tables, it can be seen that the applicant has only interchanged the male and female portion of meshing point of the pull gear and suspension chain. There is no major difference found while comparing both the document D5 with the present invention. It can be seen that the by changing the groove i.e. female portion and recess i.e. male portion will not leads to enhance any technical advancement over cited document D5.

The controller disagrees with applicant contentions that by proposed design in present invention over cited document D5, it will lead to smooth and vibration free transmission of power. The controller is of opinion that the mere interchanging the male portions and female portion made on both pull gear and suspension chain would not give such advantages or any technical advancements. Further there is no comparative data analysis or designs of meshing gears or design of protrusion and grooves of mating parts or advantageous solutions proposed in the complete specification or in written submission to support applicant's contentions.

*The applicant has filed form-13 to revise the specification by way of explanation and included summary of document D5: KR200326138Y1 Published on 13/09/2003 in the background of the invention. As document D5 is disclosing almost similar configuration of vertical parking system except male and female portion of pull gear and suspension chain as explain earlier. **As this document is most relevant for inventive step analysis and it is already explained in the decision that changes made over the prior art document D5 are mere workshop modification kind. So in view of this form 13 may not be***



allowed for amendment in the specification.

The controller is having opinion that applicant is trying to take the patent by doing mere workshop modification or slight changes on existing patent i.e. D5: KR200326138Y1 Published on 13/09/2003. It can be seen that there is no technical advancement over cited prior art document D5. The person skill in the art with common general knowledge can identify that the modification done over the disclosed vertical parking system are mere workshop modifications and it will not lead to any technical advancement.

Further it can be observed that the Document D5 (KR200326138Y1 Published on 13/09/2003) belongs to the same applicant and the applicant while filing the present patent application, has not mentioned anything about this document in the background part of complete specification. The problem and its solution provided in the background part of the complete specification belongs to a vertical rotary parking system has a double sprocket structure in which the main sprocket and the drive sprocket are coaxially provided, and has a power delivering structure through the plurality of chains so as to decelerate the driving motor, a structure of a driving unit constituting the vertical rotary parking system is complex and much time and costs are spent to manufacture and install the vertical rotary parking system. When the document D5 (KR200326138Y1) came in the picture, applicant tries to change the background part of the invention by filing the form 13 which is not admissible.

It is important to bear in mind that in order to be patentable on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an inventive step.

So in view of the reason provided in the above analysis, the subject-matter of claims 1 is not inventive over the cited prior art document D5. Further, dependent claims are also obvious at least by virtue of their dependency on the independent claim 1.

It should also be borne in mind that a patent should not be granted for a mere workshop addition as held by the Supreme Court in *Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries*, MANU/SC/0255/ 1978, because it does not satisfy the test of inventiveness.

However Section 2(1)(ja) of The Patents Act,1970 defines inventive



step as: “inventive step means” a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.

Obvious means “...something which lies in the way, and in the context of the Act is used in its normal sense of something which is plain or open to the eye or mind something which is perfectly evident to a person thinking on the subject” [Graham, J.in Olin Mathieson Chemical Corporation v Biorex Laboratories Limited (1970) RPC 157 at 188 and in General Tire and Rubber v Firestone Tyre and Rubber (1971) RPC 173 at 238; (1972) RPC 457 at 497].

What is obvious can not be inventive and what is inventive can not be obvious” [Beecham Group Ltd.’s (Amoxycillin) Appln.(1980) RPC 261 at 290] [quoted both in Patent Law, P.Narayanan, fourth edition, Eastern Law House, p. 403.]

Hence after studying the tabular comparison followed by further analysis it is concluded that the present invention is mere workshop improvement over document D5 and it will not lead to any technical advancement and I do not think that any degree of invention is required for a person skilled in the art having common general knowledge to achieve the claims of the present application after the teachings of the document D5.

Hence I conclude that claims of the present application are lacking in inventive step in view of the document D5 and thus the claimed invention is not an invention according to Section 2(1)(ja) of The Patents Act.

I therefore refuse the application for Patent under Section 15 of The Patents Act, 1970.

xxx xxx xxx”

(Emphasis Supplied)

12. A perusal of the aforesaid impugned order dated 12th April, 2024, shows that the respondent has rejected the patent application of the appellant on the ground that the claimed invention lacks an inventive step and the distinguishing feature in the claimed invention is limited to the mere reversal



of the male and female coupling elements between the suspension chain and the pull gear. At the time of recording such a finding, the Controller failed to adjudicate as to how the invention did not involve technical advancement. The determination that the claimed invention was merely a workshop modification, has not been supported by any authoritative documents, except the finding that slight changes have been made on the existing patent, i.e., D-5.

13. The Controller's finding of obviousness lacks foundation, as nothing has been brought on record to demonstrate that the appellant's reconfiguration of the male and female coupling elements, was an obvious modification.

14. It needs no emphasis that simplicity is no bar to patentability and even simple changes can introduce discernible and substantive differences, leading to a new invention. The respondent has failed to give any specific reasons as to how the specific structural optimization of the male and female portions in the claimed invention, did not involve technical expertise and as to how it was an obvious solution. Thus, dismissal of the appellant's patent application on the ground that the subject invention was a mere workshop modification, cannot be held to be tenable.

15. Further, it is to be noted that the prior art document D-5 belongs to the appellant itself. The prior art document D-5 was published on 13th September, 2003, whereas, the patent application for the subject invention was filed before the Controller of Patents and Designs on 29th August, 2013. The appellant, in its amendment and subsequent documents, has explained and set out in clear terms the various advantages of the subject invention over prior art D-5. Thus, if the subject invention was so obvious, any third



party could have made modifications to the prior art D-5, to arrive at the subject invention, however, the same has not happened in the present case.

16. Holding that one of the sure tests in analyzing the existence of an inventive step would also be the time gap between the prior art document and the invention under consideration, this Court in the case of ***Avery Dennison Corporation Versus Controller of Patents and Designs***¹ has held as follows:

“XXX XXX XXX

36. One of the sure tests in analysing the existence of inventive step would also be the time gap between the prior art document and the invention under consideration. If a long time has passed since the prior art was published and a simple change resulted in unpredictable advantages which no one had thought of for a long time, the Court would tilt in favour of holding that the invention is not obvious.

37. Terrel on Law of Patents (16th Edition) opines that the age of the prior art and why it was not done before is one of the factors to be considered while deciding on obviousness. The observations made in the judgment *Brugger v. Medic-Aid Ltd.*, [1996] R.P.C. 635 delivered by the UK Patents Court has been cited to substantiate the consideration of this factor. The relevant portion reads:

“The fact that a piece of prior art has been available for a long time may indicate, contrary to first impressions, that it was not obvious to make the patented development from it. It is useful to bear in mind in this regard the concept of long felt want. This is a particularly efficient expression. An apparently minor development which meets a long felt want may be shown to be non-obvious because, although the prior art has long been available, the development was not hit upon by others notwithstanding that there was a need for improvement (the ‘want’) and an appreciation of that need (the ‘felt’). In other words the age of prior art may be an indication that a development from it is not obvious if it can be shown that the circumstances in the relevant trade were such that a failure of the development to appear earlier is surprising.”

¹2022 SCC OnLine Del 3659



38. In the present case, the distinction between the prior art and the subject patent primarily resides in the shape, position, and engagement with the notch as also with the manner in which the detachment takes place when the fastening happens. The prior art document D2 belongs to this very Applicant, and the subject patent application was filed almost 18 years after the filing of D2. The Complete Specification explains clearly the disadvantages of the prior art and sets out in clear terms the various advantages of the subject invention. The said advantages are logically decipherable while one understands the invention. No other prior art has been cited between the period 1992 till 2010 which has dealt with fasteners in this manner and has even come close to suggesting changes in the prior art fastener stock. **If the invention was so obvious, fasteners and fastener stock being products used in bulk in industries, any third party could have made the changes in the prior art to arrive at the subject invention - which obviously has not happened.**

39. **The improvement in the present case between the prior art and the subject invention is clearly decipherable. The same does not lack inventive step. The fact that it was not obvious to a person skilled in the art is clear from the lack of any other prior art document addressing the problems in the prior art and suggesting any solutions close to the invention despite the gap of more than 18 years.** D1 and D3 are of a period prior to D2, though, dealing with fastening guns and fasteners. The closest prior art identified is D2 and **the subject application discloses a technical advancement in comparison with the closest prior art and the features comprising inventive step are not obvious to a person skilled in the art and therefore, the subject patent application satisfies the test of inventive step.**

xxx xxx xxx”

(Emphasis Supplied)

17. Similarly, respondent’s invocation of ‘common general knowledge’ to dismiss the inventive step is substantially flawed, as such assertion of ‘common general knowledge’ has not been substantiated, rendering the said finding of the Controller, as speculative and unsustainable.

18. The respondent has given a finding that a person skilled in the art, with “common general knowledge”, can identify the modifications made to



the earlier vertical parking system, i.e., D-5. In view of the said finding, the patent application of the appellant has been rejected. However, the impugned order does not provide any reference to the ‘common general knowledge’ and gives no such finding as to why a person skilled in the art would apply such ‘common general knowledge’, to arrive at the subject invention. There is nothing on record to suggest as to which ‘common general knowledge’ has been considered along with the cited prior art, rendering the subject invention obvious, thereby leading to the finding of lack of inventive step.

19. Elucidating on the aspect of requirement of proof for ‘common general knowledge’, this Court in the case of **AGFA NV and Another Versus Assistant Controller of Patents and Designs and Another**², has held as follows:

“xxx xxx xxx

39. In this regard, reference may be made to a passage from Terrell on Law of Patents, 16th Edition, which specifically discussed the aspect of proof for ‘common general knowledge’. The relevant extract of the said passage is reproduced as under:

*“Proof of common knowledge is given by witnesses competent to speak upon the matter, who, to supplement their own recollections, may refer to standard works upon the subject which were published at the time and which were known to them. **In order to establish whether something is common general knowledge, the first and most important step is to look at the sources from which the skilled addressee could acquire his information.**”*

The publication at or before the relevant date of other documents such as patent specifications may be to some extent prima face evidence tending to show that the statements contained in them were part of the common knowledge, but is far from complete proof as the statements may well have been discredited or forgotten or

²2023 SCC OnLine Del 3493



merely ignored.” Evidence may, however, be given to prove that such statements did become part of the common knowledge.”

40. From the above extract, for the Controller to rely on ‘common general knowledge’ as a ground for refusing a patent application, it is essential to specify the source of the said knowledge. It would be essential that the said source of the ‘common general knowledge’ would have been published before the priority date of the patent application. In addition, the fact that a theory or principal or knowledge has become common knowledge needs to be substantiated by some evidence. The said evidence could be in the form of references to the ‘common general knowledge’ textbooks or research articles or standard documents.

41. The judgment of the UK Patents Court in Generics (UK) Ltd. v. Daiichi Pharmaceuticals Co. Ltd., [2009] R.P.C. 4, has also given some guidance on what subject matter forms part of the ‘common general knowledge’. In the said judgment it has also been clarified that there is no requirement for the knowledge to be at the forefront of the mind of the person skilled in the art. The relevant extract of the said judgment is set out below:

“Thus the common general knowledge is the common knowledge in the field to which the invention relates. The notional skilled addressee is the ordinary man who may not have the advantages that some employees of large companies may have and information does not form part of the common general knowledge simply because it is known to some persons in the art. It must be generally known and generally regarded as a good basis for further action by the bulk of those engaged in that art before it becomes part of their common stock of knowledge relating to the art, and so part of the common general knowledge. That is not to say the skilled person must have it at the forefront of his mind. As Laddie J. explained in Raychem Corporation’s Patents [1998] R.P.C. 31 at 40, it includes all the material which he knows exists and which he would refer to as a matter of course if he cannot remember it and which he generally understands is sufficiently reliable to use as a foundation for further work.”

42. Recently, vide judgment dated 18th January, 2023, the Calcutta High Court, in Groz-Beckert KG v. Union of India, 2023 LiveLaw (Cal) 17 held that for considering inventiveness, the invention as a whole has to be considered and not broken down into isolated elements. In the said judgment it has also been specifically highlighted that there needs to be preciseness about what constitutes



‘common general knowledge.’ The relevant extract of the said judgment is set out below:

“7. Thus, in determining inventive steps, the invention should be considered as a whole. In other words, it is not sufficient to draw the conclusion that a claimed invention is obvious merely because individual parts of the claim taken separately are known or might be found to be obvious. The contention that an invention is obvious in relation to a particular item must be treated with care and caution. In doing so, the whole picture presented should be taken into consideration and not a partial one. There should be an element of preciseness about what is asserted to be common general knowledge. The “obviousness” must also be strictly and objectively judged. (Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries (1979) 2 SCC 511 paras 24 & 25, F. Hoffman La Roche Ltd. v. Cipla Ltd. PTC 1 paras 13, 143).”

43. In the present case, however, the Controller has failed to give any source of the common knowledge that has been considered. Therefore, it cannot be construed as to what precise element of ‘common general knowledge’ has been considered along with the cited prior art to claim that the combination of the teachings of the prior art and the ‘common general knowledge’ led to a finding of lack of inventive step.

xxx xxx xxx”

(Emphasis Supplied)

20. It is to be noted that since the prior art document D-5 was not cited in the FER, the appellant sought to amend the specifications by way of providing an explanation and incorporating a summary of the document D-5. However, the application of the appellant for amendment of the specifications was rejected by holding that document D-5 belongs to the appellant itself, and the appellant had not made any reference about the said document in the background part of complete specifications.

21. This Court agrees with the submission made by learned counsel for the respondent that the appellant was enjoined upon to disclose the prior art D-5 at the time of filing of its patent application, which is appellant’s own



prior art, since it is now the claim of the appellant that the present invention has technical advancement over the prior art D-5. It is to be noted that if by suppressing any prior art, an applicant is able to obtain patent undeservingly, then, such prior art can certainly be relied even at a later stage to challenge the grant of patent to such an applicant or to revoke such patent, under Section 64 of the Patents Act.

22. However, if a prior art comes to the notice of the Controller during the pendency of a patent application, though not disclosed by the applicant, and if objection in that regard is raised by the Controller, the applicant would have a right to address such issues by way of amending the specifications, within the norms of amendment that are allowed as per law. The Controller has the authority to consider such amended specifications in order to adjudicate the patent application of the applicant.

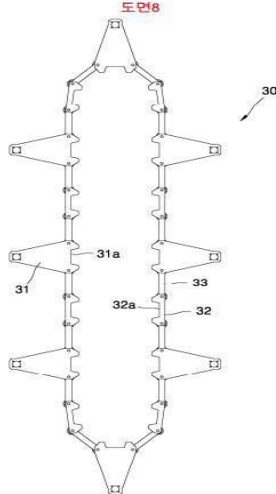
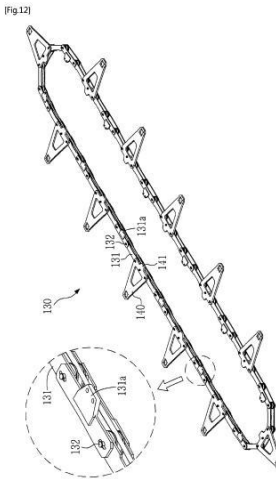
23. Nevertheless, on the basis of such non-disclosure of prior art, the Controller cannot refuse to consider the application for amendment of specifications on merits, especially, when such prior art is relied by the Controller to raise objections to patent application of such applicant.

24. A perusal of the subject invention shows that the appellant has reconfigured the coupling mechanism in the subject invention, by reversing the male and female portions between the suspension chain and pull gear, in the following manner:



2025:DHC:5124



D5: Published on 13/09/2003	KR200326138Y1	2554/DEL/2013 invention	present	Findings
	31a-First coupling groove (<i>let's say it first Female portion</i>) 32a- second coupling groove (<i>let's say it second Female portion</i>)		141-First combining protrusions member (<i>let's say it male portion</i>) 131a-Second protrusion combining member (<i>let's say male portion</i>)	From this, it can be seen that the FEMALE PORTIONS of suspension chain shown in D5 is replaced with MALE portions of suspension chain as shown in the present invention.

25. This Court notes the submission of the appellant that the subject invention has resulted in reduced friction, lower noise, and enhanced safety. For this purpose, the appellant has submitted a Technical Evidence Affidavit before this Court. Further, the appellant had sought to amend the claim specifications in order to incorporate prior art D-5, into the specifications of the subject application. However, the said amendment was wrongly rejected by the Controller on the ground that, since the said document D-5 belonged to the appellant itself, the appellant ought to have mentioned about the said document as part of complete specification. Though the cited prior art D-5 belonged to the appellant itself, however, merely because the appellant did not cite D-5 at the time of filing the subject application, cannot be held against the appellant as a failure to disclose a complete specification. The



appellant had duly explained the subject invention in the specifications filed with the subject application. The fact remains that document D-5 was not cited in the FER. Therefore, when the same was cited for the first time prior to the hearing date before the Patent Office, the appellant sought to amend the specifications with a view to clarify the technical advancement of the subject invention, such as reduced friction and noise over configuration disclosed in document D-5. However, the Patent Office rejected the amendment application, thereby, denying the appellant a fair opportunity to respond to the cited prior art, i.e., document D-5, in violation of the Principles of Natural Justice. Thus, the rejection of the amendment application for amending the specifications, clearly amounted to a deprivation of a fair opportunity to the appellant to address the objections raised by the respondent on the basis of the cited prior art, i.e., document D-5.

26. The Controller's refusal of the amendment in the specifications, premised on Section 59 of the Patents Act, ignores the fact that document D-5 was not cited in the FER, and was introduced only in the Hearing Notice dated 29th September, 2023. The provisions pertaining to '*Amendment of Applications and Specifications*', are detailed in Sections 57 to 59 of the Patents Act. As per the said provisions, there exists no specific bar for amendment to the specifications even at a subsequent stage, and the only requirement is that the amendment must satisfy the conditions provided under Section 59 of the Patents Act, and the amendment in the specifications is not inconsistent with the claims made in the original specifications. Thus, the respondent erred in rejecting the amendment application of the appellant and in not allowing the amendment in the specifications, which sought to



explain the technical advancement in the subject invention over the prior art, i.e., document D-5. In view of the aforesaid, the Controller's refusal to allow the amendment application was unjustified.

27. Elucidating on the concept of amendments in the specifications, and holding that the amendments in claims and specifications, can be allowed subsequently, even at the stage of appeal, so long as the same are in consonance with the earlier claims and original specifications, this Court in the case of ***Opentv INC Versus Controller of Patents and Designs and Another***³, has held as follows:

“xxx xxx xxx

51. **The fundamental principle governing amendment of Claims is therefore, that amendments are permissible in the Claims so long as the said amendments are within the scope of the originally filed Claims as filed and do not expand the said Claims. Thus, reduction or narrowing down a Claim is permissible, but broadening, widening or expansion of Claims is not permissible.**

52. The only issue remaining is whether at the appellate stage amendments to the Claims are permissible at the instance of patent applicant. In a recent decision of a Coordinate Bench of this Court in ***Nestle (supra)***, the Court was considering the question as to whether amendments can be directed at the appellate stage. The Court, after considering the law of amendments of Claims, observed as under:

“30. **There is no provision in the Act, which specifically bars the amendment of a patent specification at the appellate stage.** Amendment of patent applications and specifications are covered in Chapter X of the Act. Sections 57 to 59 of the Act are the provisions that govern the same.

xxxx xxxx xxxx

33. **In view of the above, there is no specific bar for the amendment even at a subsequent stage. Only requirement under the Act is that the amendment has to fulfil the requirements under Section 59 of the Act and the consideration that has to be kept in mind is that the amended Claims are not inconsistent with**

³2023 SCC OnLine Del 2771



the earlier Claims in the original specification.”

53. In the above case of *Nestle (supra)*, the Court permitted the Appellant to revert to the originally filed claims which had been given up due to objections raised by the Patent Office. After considering Section 15 of the Act, the Court held that since the Controller has the power of directing amendment to a patent application, a High Court in appeal would also have similar powers. It also observed that the **appeal is a continuation of the proceedings before the original forum and thus, amendments are permissible at the appellate stage.** The relevant paragraphs of the judgment are set out below:

“34. Now, a reference may also be made to Section 15 of the Act, i.e., where a Controller has been given the power to require an application to be amended to his satisfaction. The said provision reads as under:

“[15. Power of Controller to refuse or require amended applications, etc., in certain cases.-Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.]”

35. **It is axiomatic that if the Controller has been given the power to direct an amendment to the patent application, the High Court, which is sitting in appeal over the decision of the Controller, should also have similar powers to direct the patent applicant to amend Claims to its satisfaction.**

36. Further, it is a settled position of law that an appeal is a continuation of the proceedings of the original court. The appellate jurisdiction involves a rehearing on law as well as on facts. Reference in this regard may be made to a recent judgement of the Supreme Court in *Ramnath Exports Pvt. Ltd. v. Vinita Mehta & Anr*, (2022) 7 SCC 678.

xxx xxx xxx

39. **Thus, in conclusion, I observe that if the High Court, in appeal is considering the issue of grant of patent, it should necessarily have the same powers as given to the Controller under Section 15 of the Act, which includes power to require amendment. Further, the appellate proceedings challenging the refusal of grant of a patent, questions of facts need to be re-**



examined comprehensively and therefore, a liberal view has to be taken with regard to amendment of Claims”

54. Thus, amendments having been held to be permissible at the appellate stage, this Court is of the opinion that irrespective of whether the amendment is directed by the Court or is at the instance of Patent Applicant, so long as the requirements as laid down under Section 59 of the Act are fulfilled such that the amended claims are within the scope of original claims, is not breached, the amendment is permissible.

xxx xxx xxx”

(Emphasis Supplied)

28. It is apparent that the appellant’s application for amendment was neither an attempt to shift the invention’s foundation, nor a violation of Section 59 of the Patents Act. The proposed amendment by the appellant, in its specifications, was a legitimate response to the Controller’s subsequent introduction of document D-5, as prior art. Thus, the Controller’s refusal to allow the appellant’s application for amendment of the specifications, is not justified. Once a new prior art has been introduced, even though it may belong to the applicant itself and was not part of the FER, then, also an applicant has the right to respond to the said newly introduced prior art. Therefore, refusal to allow the amendment to the specifications, which was sought to provide clarification regarding the technical advancements of the subject invention over the newly cited prior art, amounts to a clear violation of the Principles of Natural Justice.

29. The subject patent seeks to address the challenges and inefficiencies in the prior art system, i.e., the Vertical Rotary Parking Systems by interchange of the male and female portions of the coupling elements between the suspension chain and the pull gear. It is a settled law that simplicity does not defeat an invention and even simple inventions are



patentable.

30. Holding that a simple invention, if novel and non-obvious, warrants patent protection when it addresses a technical problem with ingenuity, in the case of *Avery Dennison Corporation Versus Controller of Patents and Designs*⁴, it has been held as follows:

“xxx xxx xxx

32. Some of the fundamental principles while analysing inventive step and whether an invention is obvious or not are:

i. **That simplicity does not defeat an invention - even simple inventions are patentable.**

ii. The inventive step has to be assessed on the basis of the date of priority of the subject patent and not after the publication of the same i.e., it is not permissible to do a hindsight analysis or an ex-post facto analysis.

33. Way back in 1890, the House of Lords, in *Vickers v. Siddell*, (1890) 7 R.P.C. 292 while considering simplicity in an invention observed:

“If the apparatus be valuable by reason of its simplicity, there is a danger of being misled by that very simplicity into the belief that no invention was needed to produce it. But experience has shown that not a few inventions, some of which have revolutionised the industries of this country, have been of so simple a character that when once they were made known it was difficult to understand how the idea had been so long in presenting itself, or not to believe that they must have been obvious to everyone.”

34. A similar sentiment was echoed almost 100 years ago in *Pope Appliance Corp. v. Spanish River Pulp & Paper Mills Ltd.*, (1929) 46 R.P.C. 23 when the Privy Council while deciding an appeal arising from the Supreme Court of Canada observed as under:

“The principal objection seems to be that the invention is too simple, but that is not an objection that a practical paper-maker would take. It ought to be looked upon as a bold conception. Although air has been used, it has not been applied in the particular way in which it was applied by Pope. The man who

⁴ 2022 SCC OnLine Del 3659



correlated the elements of a forty-year old problem is entitled to a patent.”

35. It is thus clear that simplicity in the invention should not deter the Court from granting a patent.

xxx xxx xxx

40. Applying any of the judicially recognised tests or the settled approach towards such cases, as discussed above, the Controller's finding that any person skilled in the art could make the variation and modifications in D2 to arrive at the subject invention, is not tenable. The differences which the Controller describes as 'superficial' may appear simple but clearly have an impact on the product concerned. The description of the said differences as superficial would, therefore, be misplaced. This Court also notes the fact that the corresponding patent applications in various jurisdictions have already been granted in the USA, Japan, South Korea and China. The issue of evergreening raised in the submissions would not arise in these facts.

xxx xxx xxx”

(Emphasis Supplied)

31. The appellant has also placed on record a Technical Evidence Affidavit dated 05th July, 2024 to provide a stress analysis report, in order to confirm the technical advancements over prior art document D-5, and to address the Controller’s concern regarding the absence of comparative data. In this regard, reference may be made to the judgment of the U.S. Court of Appeals, Federal Circuit in the case of **Knoll Pharmaceutical Company, Inc. Versus Teva Pharmaceuticals U.S.A., Inc.**⁵, wherein, it has been held that evidence developed after the grant of patent is not excluded from consideration, when it supports in understanding the invention’s full range of advantages. Thus, in the said case, it was held as follows:

“xxx xxx xxx

**1385 [1] To further demonstrate the unexpected activity of the claimed combination, Knoll submitted additional data directed to*

⁵367 F.3d 1381, 70 U.S.P.Q.2d 1957



similar showings of efficacy. Three of the later studies submitted to the district court concerned the synergistic interaction of hydrocodone and ibuprofen when administered together for pain relief. The fourth study reported enhanced muscle repair after exercise following administration of the combination of hydrocodone and ibuprofen, an aspect not unrelated to pain relief. Evidence developed after the patent grant is not excluded from consideration, for understanding of the full range of an invention is not always achieved at the time of filing the patent application. It is not improper to obtain additional support consistent with the patented invention, to respond to litigation attacks on validity. There is no requirement that an invention's properties and advantages were fully known before the patent application was filed, or that the patent application contains all of the work done in studying the invention, in order for that work to be introduced into evidence in response to litigation attack. Nor is it improper to conduct additional experiments and provide later-obtained data in support of patent validity.

xxx xxx xxx”

(Emphasis Supplied)

32. In the present case, the Technical Evidence Affidavit dated 05th July, 2024, filed by the appellant, seeks to corroborate the technical advancements disclosed in the specifications, such as reduced friction and enhanced safety, and directly responds to the Controller's concern regarding the absence of comparative evidence. Accordingly, there is no impediment in considering the said document.

33. Similarly, the U.S. Federal Circuit's decision in the case of **Genetics Institute, LLC, Versus Novartis Vaccines and Diagnostics, Inc.**⁶, reinforces the relevance of post-filing evidence, when it aligns with the invention's disclosed properties. Thus, it has been held as follows:

“xxx xxx xxx

Although non obviousness analysis remains properly focused at the time the invention was made, it is error to prohibit a patent applicant or patentee from presenting relevant indicia of non obviousness, whether or not this evidence was available or expressly contemplated

⁶655 F.3d 1291, 99 U.S.P.Q.2d 1713



at the filing of the patent application. 35 U.S.C.A. § 103.

xxx xxx xxx

1317 In Knoll, the district court refused to consider evidence showing the greater analgesic effect of a combination of drugs over the prior art, concluding that "the unexpected benefits or results were discovered after the ... patent had been issued." 367 F.3d at 1384 (internal quotation marks omitted). We reversed, finding that, "[c]ontrary to the district court's perception, the specification expressly acknowledge[d] that the efficacy of the combination [was] 'surprising' " and stated that the combination of the drugs obtained "an analgesic effect greater than that obtained by increasing the dose of either [analgesic] alone." Id. **To demonstrate the unexpected activity of the claimed combination, the patentee submitted additional data from experiments conducted after the patent had been filed. Id. at 1385. In concluding that the district court erred in rejecting this after-acquired data, we simply held that it was "not improper to obtain additional support consistent with the patented invention" because "understanding of the full range of an invention [was] not always achieved at the time of filing the patent application." Id. at 1385 (emphases added). **Thus, where there was already support showing that the inventor contemplated the unexpected result at the time the patent was filed, it was not improper to supplement this evidence of unexpected results with evidence obtained at a later time. Knoll is therefore consistent with a requirement that unexpected results be tied to what the inventor knew at the time of the invention.***

xxx xxx xxx”

(Emphasis Supplied)

34. The reliance placed by the respondent on the judgment in ***Bishwanath Prasad Radhey Shyam (supra)*** is totally misplaced. The said judgment is clearly distinguishable on account of the fact that in the said case it was established that the *‘patented machine was neither a manner of new manufacture or novel improvement, nor did it involve any inventive step, having regard to what was publicly known or used prior to the date of the patent’*. In the said case, it had been averred that the method of manufacture described in the patent therein, had been publicly known and in use in various places, long prior to the patent. However, no such factual



circumstances exist in the present case, rendering the reliance on the said judgment inapposite.

35. Considering the detailed discussion hereinabove, the impugned order is not found to be tenable. Accordingly, this Court considers it appropriate to direct that the appellant's patent application be re-examined in the light of the observations made hereinabove.

36. Accordingly, the following directions are issued:

36.1 The impugned order dated 12th April, 2024, is set aside.

36.2 The matter is remanded to the Controller of Patents and Designs for *de novo* consideration.

36.3 The patent application for the subject patent is restored to its original number.

36.4 The appellant shall be granted a hearing prior to deciding the matter afresh.

36.5 The matter would be decided by an officer other than the one who has passed the impugned order.

36.6 The aforesaid exercise shall be completed and an order be passed, within four months from today.

37. It is clarified that the Controller of Patents and Designs shall proceed with the *de novo* consideration, and decide the matter, uninfluenced by the impugned order.

38. Accordingly, with the aforesaid directions, the present appeal is disposed of.

**(MINI PUSHKARNA)
JUDGE**

JULY 1, 2025/au