

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
COMMERCIAL MISCELLANEOUS PETITION NO. 11 OF 2022

Hemant Karamchand Rohera

...Petitioner

Versus

Controller General of Patents and Designs & Anr.

...Respondents

Prashant Shetty a/w Narayan Abhishek Singh, Aditya Chitale, Sumedh Ruikar & Saikiran Mergu i/by RKDewan Legal Services for Petitioner.

Mr. Niranjan Shimpi a/w Ms Rivaa Kadam for Respondents.

CORAM : ARIF S. DOCTOR, J.

DATE : 17th NOVEMBER 2025

P.C.:

1. The captioned Commercial Miscellaneous Petition impugns an order dated 18th February 2021 ("the Impugned Order") by which Respondent No. 1 ("the Controller") has rejected Patent Application No. 201921036412 ("the said Application") filed by the Petitioner seeking a patent in respect of "A MEDICAL THERAPEUTIC DEVICE" ("the said invention/device").

Submissions on behalf of the Petitioner

2. Mr. Shetty, Learned Counsel appearing on behalf of the Petitioner, submitted that the Impugned Order is liable to be set aside and the matter be remanded for fresh adjudication before a different Controller since (A) the order was passed in breach of the mandatory procedure prescribed under Sections 14

and 15 of the Patents Act, 1970 **(B)** the order is cryptic and unreasoned, since (i) the order failed to establish any coherent analytical link between the prior art cited and the claimed invention/device and (ii) the order failed to consider the FAQ, credential files, and other material placed on record with the post-hearing written submissions and **(C)** the Controller had adopted an inconsistent approach and rendered contradictory findings.

A. Impugned Order Contrary to Sections 14 and 15 of the Patents Act

3. Mr. Shetty submitted that a combined reading of Sections 14 and 15 of the Patents Act, 1970, read with Rules 28(1), 28(2) and Rule 129 of the Patent Rules, mandates a fair, consultative, and sequential process before a patent application can be refused. He pointed out that where the Examiner or Controller identifies any defect, the Controller must first communicate the gist of specific objections to the Applicant and, if requested, afford a hearing to such Applicant. He pointed out that thereafter, if the Controller remains unsatisfied, the Applicant could in terms of Section 15 be granted an opportunity to amend the application and only upon failure to do so or after doing so, if the same still was lacking, the Controller may reject the Application. He thus submitted that rejection/refusal of any Application must always be preceded by clear communication of objections and a reasonable opportunity to cure them.

4. Mr. Shetty then submitted that in the facts of the present case, the Controller had not acted in accordance with the mandate of Sections 14 and 15 of the Patents Act. He pointed out that the oral hearing had concluded on a positive note, with an exchange of “*Thanks*” and taking on record the Petitioners written submissions without identifying any deficiency thus making it implicit

that the Petitioner Application was not lacking in sufficiency. He submitted that despite this the Controller had dismissed the Application *inter alia*, by recording that the disclosure was insufficient. Mr. Shetty took pains to point out that at no stage prior to the passing of the Impugned Order did the Controller indicate to the Petitioner that the said Application was lacking in sufficiency, much less afford an opportunity to the Petitioner to rectify/cure the same. It was thus that he submitted that the Controller had acted contrary to the mandate of Sections 14 and 15 of the Patents Act by dismissing the said Application on the ground of “insufficient disclosure” without ever specifying the nature of the insufficiency or communicating it to the Petitioner.

B. Cryptic and Unreasoned Order

5. Mr. Shetty then submitted that any order rejecting a patent application must contain a clear and reasoned link between the prior art references relied upon and the claimed invention. He submitted that the Controller was required to identify the existing state of knowledge i.e. the prior art and explain how a person skilled in the art would be able to arrive at the claimed invention based on such prior art, or to demonstrate why the invention lacked inventive step or sufficiency. He submitted that rejection of an application for patent in the absence of such clear and cogent reasoning would render such refusal as arbitrary. In support of his contention, he placed reliance upon the decision of the Delhi High Court in the case of *Coca-Cola Company v. Controller of Patents & Anr*¹ which held that the Controller shall pass a reasoned order and demonstrate how prior art renders the claimed invention as non-inventive. In the present case he

¹ 2025 SCC OnLine Del 3397

pointed out that the Impugned Order only contained final conclusions absent any cogent reasoning.

6. He submitted that in the present case, despite the fact that the Petitioner had, in the post-hearing, submitted the written submissions which specifically placed reliance on (i) the FAQ explaining the functioning and operation of the invention/device and (ii) the credential files including test reports of users. However, none of this material was even referred to, let alone was considered in the Impugned Order. Conversely, he pointed out that in paragraph 23 of the Impugned Order, the Controller had recorded that no experimental data was submitted, despite detailed explanations had been provided in the specification and additional test reports, photographs, videos, treatment data and certifications having been furnished through a hyperlink in the post-hearing written submissions none of which was considered.

7. Mr. Shetty then submitted that the finding of insufficiency was wholly unsustainable. He submitted that the complete specification, annexed as Exhibit F to the Petition, clearly set out the best method of performing the said invention, and clearly satisfied all the requirements of Section 10(4)(b). He thus submitted that the functioning of the said invention/device, including regulation of blood pressure, influence on glucose levels, and specific frequency ranges were fully disclosed and explained during the hearing.

8. Mr. Shetty then pointed out that under Section 10(4) of the Patents Act, the requirement was that the complete specification must “*fully and particularly describe the invention and its operation or use and the method by which it is to be performed*”, i.e., it must set out the best method of performing the invention

known to the Applicant. He submitted that the statute does not mandate the production of a working example along with the specification, nor does it require the submission of experimental or clinical data unless such material is indispensable for enabling a person skilled in the art to perform the invention. He pointed out that despite this, the Controller had rejected the said Application solely on the ground that no working examples had been furnished. Mr. Shetty submitted that if the Controller required working examples to be submitted, it was incumbent upon the Controller to have called upon the Petitioner to provide the same and to grant reasonable time for compliance. He submitted that instead, of doing so, the Controller had summarily rejected the said Application without affording any such opportunity to the Petitioner to furnish a working example. In support of his contention that working examples were not mandatory and that the Controller must, if required, seek clarifications rather than reject the Application outright, he placed reliance on the decision of the Delhi High Court in *Titan Umreifungstechnik GmbH & Co. KG v. Assistant Controller of Patents*². He submitted that the Controller's failure to seek a clarification, coupled with the summary rejection of the Application for want of working examples, was contrary both to Section 10(4)(b) and to the principles laid down in *Titan Umreifungstechnik GmbH*.

C. Inconsistent Approach and Contradictory Findings

9. Mr. Shetty then submitted that in addition to the above, the impugned order was also vitiated on the ground that the same suffered from an inherent inconsistency in the Controller's approach. He pointed out that the Controller

² 2023 SCC OnLine Del 3369

had, on the one hand, found that the disclosure was insufficient, the Controller had simultaneously cited several prior art references based on that very disclosure. He submitted that if the disclosure was indeed insufficient, the Controller could not have related it to the prior art. Conversely, if the disclosure was relatable to prior art, then the same could not be said to be insufficient. He submitted that in either event, the Controller was required under Sections 14 and 15 to grant the Petitioner an opportunity to rectify any perceived insufficiency which admittedly was not done.

10. Mr. Shetty pointed out that the Controller appeared to have formed and proceeded on the basis of a preconceived notion since the Controller had held that the device “*may not be practical*” and “*may prove fatal to humans*” when the device was not even examined by him. He also pointed out that in the post-hearing written submissions, the Petitioner had specifically sought (i) an extended hearing under Section 14 if any objection persisted, (ii) an opportunity to amend the Application under Section 15, and (iii) a further hearing under Section 80 before any adverse order could be passed. He submitted that despite which the Controller had proceeded to pass the Impugned Order.

12. Basis the above Mr. Shetty submitted that the Impugned Order suffered from procedural irregularity, non-consideration of material on record, absence of a speaking reasoning, and internally inconsistent findings and was thus required to be set aside and the matter be remanded for a *de novo* consideration before a different Controller. He submitted that failure to remand would result in grave and irreparable prejudice to the Petitioner, who had spent years developing the said invention, the benefit of which would be lost to the Petitioner and years of

hard work would go in vain.

Submissions on behalf of the Respondent

13. At the outset, Mr. Shimpi Learned Counsel appearing on behalf of the Respondent submitted that the present Petition was wholly devoid of merit and liable to be dismissed in limine. He submitted that the Petitioner had not approached this Court with clean hands since the Petitioner had suppressed the fact that the Petitioner had filed a Review Petition and falsely stated that “*No petition, appeal or application before any court or tribunal or authority*” was pending. Mr. Shimpi submitted that the filing of a review against the very order that is challenged in the present proceeding and concealing the fact that the review proceeding is dismissed amounted to a material suppression, and for this sole reason, the present Petition was required to be dismissed.

14. Mr. Shimpi then submitted that the Review Petition was ultimately rejected on 10th January 2023, despite which the Petitioner had neither amended the Petition nor sought to impugn the order passed in Review which had attained finality. He submitted that the present challenge, which was confined only to the original order, was therefore now infructuous. Mr. Shimpi then placed reliance upon the decision of the Madras High Court in the case of ***Caleb Suresh Motupalli vs Controller of Patents***³ to point out that no appeal would lie against an order passed in review.

15. Mr. Shimpi submitted that the Petitioner had been afforded full opportunity of hearing. He pointed out that a hearing notice was issued on 7th

³ C.M.A. (PT) No. 2 of 2024 (Madras High Court)

April 2021, the hearing was conducted on 11th May 2021, and the impugned order dated 26th May 2021 was passed only after considering both the oral submissions and the Petitioner's written submissions. He further justified the rejection of the said Application by contending that the Application was rightly refused since the same did not satisfy the mandatory requirements under Section 10 of the Patents Act, 1970. The refusal under Section 15, he submitted, was based entirely on the ground of insufficient disclosure under Section 10(4). He submitted that it was well settled that where a complete specification was vague, incomplete, or incapable of enabling a person skilled in the art to perform the invention without undue experimentation, the Application must necessarily be rejected.

16. Mr. Shimpi then submitted that the Petitioner's specification failed to provide any supporting data or working examples to demonstrate the efficacy or reproducibility of the invention. He pointed out that although the Petitioner claimed that the therapeutic effect of the device arises from the generation of specific electrical or electromagnetic waveforms, no experimental, clinical, or empirical data had been furnished to substantiate these assertions. He further submitted that the Petitioner merely provided hyperlinks referring to FAQs and credentials but did not file any substantive written material containing such data before the Controller.

17. Mr. Shimpi then submitted that the deficiency in the Petitioner's specification was not one of ambiguity but one of inherent insufficiency, which went to the very root of the patentability of the said invention/device. He

submitted that while an ambiguity could be clarified, an inherent insufficiency could not and would thus warrant rejection of the said Application. In support of his contention, he placed reliance upon the decision of the IPAB in *Spice Mobiles Ltd. v. Somasundaram Ramkumar*⁴. On this basis, he submitted that the Petitioner, having filed an insufficient specification and not merely an ambiguous one, the same was rightly met with rejection by the Controller. He then also placed reliance upon the decision of the Delhi High Court in the case of *OpenTV Inc. v. Controller of Patents and Designs & Anr.*⁵ to submit that it was unnecessary to undertake a detailed examination of novelty or inventive step if the application itself lacked patentability under Section 3 of the Patents Act. He thus submitted that once the Controller had found that the application failed to satisfy the basic statutory requirements under Section 10(4) of the Patents Act, the Controller was not required to examine anything else.

18. Mr. Shimpi further submitted that, despite being afforded an opportunity and having undertaken to do so, the Petitioner had failed to produce a working model of the said invention/device. He pointed out that this, coupled with the absence of any evidence demonstrating the therapeutic results purportedly achieved by the said invention, reinforced the conclusion that the disclosure was inadequate and incapable of practical verification. He submitted that production of a working model and detailed drawings were primary requirements under Section 10(3) of the Patents Act read with Rule 16 of the Patent Rules, and that the Petitioner had neither produced such material before the Controller nor sought leave in the written submissions or in review to place the working model or

4 2012 SCC OnLine IPAB 10

5 2023 SCC OnLine Del 2771

drawings on record. He therefore submitted that the Petitioner had failed to comply with the statutory requirements of Section 10(3).

19. Mr. Shimpi then submitted that the requirement under Section 10(4) was not a mere procedural formality but a substantive mandate. He submitted that an Applicant must clearly, precisely, and fully describe the invention and the manner in which it is to be performed. He submitted that it has been consistently held that an Applicant seeking a patent is under a strict obligation to distinctly state the scope of the claimed invention so that the public is adequately informed of its scope and enablement. In the present case, he submitted that the Petitioner's Application failed to meet this fundamental requirement, and the Controller was therefore justified in rejecting the said Application.

20. In conclusion, Mr. Shimpi submitted that the impugned order was well reasoned and was passed after due consideration of all factors. He submitted that the Petitioner's attempt was to reopen the matter, which was misconceived and impermissible. He therefore submitted that the Petition be dismissed with costs.

Findings

21. Having heard Learned Counsel for the parties and upon considering the material upon which reliance was placed as well as the case law cited, I find that the Petition deserves to be allowed for the following reasons:

- A) At the outset, it is important to note that the scheme of the Patents Act, 1970, particularly Sections 14 and 15 read with Rules 28(1), 28(2) and

Rule 129 of the Patent Rules, requires the Controller to adopt a corrective and consultative approach before refusing a patent application. Section 14 mandates that whenever any objection or deficiency is identified, the Controller must communicate the same to the applicant and, if requested, grant a hearing. Section 15 further provides that even if the Controller remains unsatisfied after such communication, he must first afford the applicant an opportunity to amend the application to the Controller's satisfaction before proceeding to reject it. Rules 28(1) and 28(2) reinforce this framework by requiring that the "*gist of specific objections*" be conveyed and that a hearing be granted if the objections are contested. Thus, the statutory framework contemplates a two-stage process (i) communication of objections and an opportunity to cure them, followed by (ii) consideration of compliance, and only if compliance is not achieved, a patent can be refused under Section 15. A direct rejection without following this process defeats the very object and procedural safeguards provided for in the Patents Act.

- B) In the facts of the present case, it is crucial to note that the said Application was uncontested, and the proceedings before the Controller were, therefore, non-adversarial. Despite this, the Controller proceeded to reject the Application on the ground of alleged insufficiency of disclosure without ever communicating such deficiency to the Petitioner in terms of Section 14. As held by the Delhi High Court in ***Titan Umreifungstechnik GmbH***, if the Controller was of the view that the patent application

suffered from insufficient disclosure, it was incumbent upon the Controller to call upon the applicant to furnish additional material, clarifications, or workings to cure the defect/insufficiency. In the present case, the record makes it clear that at the time of the oral hearing, the Controller did not indicate any deficiency in disclosure, nor was any further objection raised in respect of the said Application. Thus, the Petitioner was fully justified in carrying the impression that all the queries of the Controller had been satisfactorily addressed and that the Application did not suffer from any deficiencies. It was only for the first time in the Impugned Order that the Controller held that the disclosure fell short of sufficiency and thus did not satisfy the requirements of Section 10 of the Patents Act.

- C) Also it is well settled that when rejecting a patent application, the Controller must pass a speaking and reasoned, order. The law, as crystallized in *Coca-Cola Company v. Controller of Patents* and *Titan Umreifungstechnik GmbH v. Assistant Controller of Patents*, requires that such an order must at the very least set out (i) the existing state of knowledge or the specific prior art relied upon; (ii) how the claimed invention is mapped to, or distinguished from, such prior art; and (iii) why, in light of that prior art and the material on record, the claimed invention is found to lack inventive step, sufficiency of disclosure, or other statutory requirements. In *Coca-Cola*, the Delhi High Court held that an order that merely reproduces objections or records conclusions without

analysing the prior art or the applicant's submissions fails the test of a "speaking order" and is liable to be set aside. Likewise, *Titan Umreifungstechnik* reiterates that where the Controller perceives a deficiency, particularly in relation to sufficiency of disclosure, he is duty-bound to call upon the applicant to furnish further workings or clarifications, and the refusal of a patent without such an opportunity is contrary to the scheme of the Act.

- D) In the present case, however, the Impugned Order does not satisfy any of these requirements. It merely records certain conclusions regarding alleged lack of workable disclosure, impracticality of the device, and absence of supporting data, without undertaking any analysis of the prior art or demonstrating how the claimed invention is rendered deficient in light of such prior art. *Crucially*, the very deficiency alleged the material upon which the Petitioner has placed reliance in the post-hearing written submissions namely (i) FAQs explaining the functioning and operational mechanism of the device and (ii) credential files containing the before-and-after test reports of individuals who had used the device has not been mentioned, much less dealt with. On the contrary, paragraph 23 of the Impugned Order incorrectly records that no experimental data was furnished.
- E) Consequently, the submission of Mr. Shimpi that the said Application lacks patentability under Section 3 cannot be accepted, as the Controller has failed even to consider the material relevant to the foundational

question of sufficiency. In this context, reliance on *Spice Mobiles Ltd.* and *OpenTV Inc.* is misplaced. Issues of patentability, novelty, and inventive step would arise only after the Controller complies with the principles of natural justice and affords an Applicant a meaningful opportunity to cure any defects. Since that foundational safeguard was not observed in the present case, the secondary objections regarding patentability are at this stage untenable.

- F) Also, there is merit in the contention that the Controller's reasoning and approach is inherently contradictory. On the one hand, the Controller has rejected the said Application on the ground that the specification suffers from insufficient disclosure and does not adequately explain the functioning of the invention/device. However, on the other hand, the Controller has simultaneously cited multiple prior art references which, according to him, sufficiently disclose or explain the very same invention/device. This reasoning is plainly inconsistent since if the Petitioner's disclosure was deficient to the extent that the invention could not be understood or performed, it is inexplicable how the Controller could meaningfully relate that very disclosure to several prior art documents. Conversely, if the Controller was in fact able to map the claimed invention to prior art, it necessarily follows that the disclosure was sufficiently detailed to enable such an analysis.
- G) The objection to the maintainability of the present Petition on the ground that the Petitioner has approached this Court with unclean hands by

failing to disclose the filing of a Review Petition is equally untenable. While, as a matter of propriety, the Petitioner ought to have disclosed the Review Petition, such omission cannot be treated as material suppression warranting dismissal of the Petition since (i) there is no bar under the Patents Act on pursuing the remedies of review and appeal either simultaneously or sequentially. The statutory scheme of the Patents Act does not treat the filing of a review as an election of remedies which would foreclose the right of an aggrieved party to subsequently file an appeal; (ii) the doctrine of merger does not apply since the review petition was dismissed at the threshold. Consequently, in the facts of the present case, the original order passed under Section 15 continues to independently subsist and is amenable to challenge by way of appeal; (iii) for suppression to be fatal to a proceeding, the suppression must be material to the adjudication or must confer an undue advantage on the litigant guilty of such suppression i.e. the Applicant in this case. In the facts of the present case, the existence or dismissal of the Review Petition has no bearing on the substantive issues raised, namely, the legality, sufficiency of reasoning, and procedural correctness of the impugned order. Thus, by failing to disclose the Review Petition, no undue advantage has been conferred upon the Petitioner, nor has any prejudice been caused to the Respondent.

H) Lastly, the Respondent's reliance upon the decision of the Madras High Court in the case of ***Caleb Suresh Motupalli*** is entirely misplaced and has

no bearing to the facts of the present case since the said decision merely holds that no appeal lies from an order passed in review. In the present case the Petition does not challenge the order passed in the review order but challenges only the original order under Section 15. Thus, clearly the said judgment is of no assistance to the Respondent.

22. In the aforesaid circumstances, I pass the following order:

ORDER

i) The Order dated 18th August 2021 passed by Respondent No.2, Assistant Controller of Patents & Designs upon the Patent Application No. **201921036412** for grant of Patent titled "**A MEDICAL THEURAPUTIC DEVICE**" is hereby set aside.

ii) Patent Application No.**201921036412** for grant of Patent titled "**A MEDICAL THEURAPUTIC DEVICE**" is hereby remanded back for fresh consideration before another Controller.

iii) Learned counsel for the Respondents at this stage prays for the stay of the order. At his request, the operation of the order shall remain stayed for a period of two weeks from today.

23. Commercial Miscellaneous Petition accordingly stands disposed of.

(ARIF S. DOCTOR,J.)