



IPAB Intellectual Property Appellate Board

Guna Complex Annexe-I, 2nd Floor, 443 Anna Salai, Teynampet, Chennai-600 018.
Tele: 24328902/03 Fax: 24328905 email id: ipab.tn@nic.in Website: <http://www.ipab.gov.in>

OA/1/2020/PT/CHN

TUESDAY, THIS THE 08TH DAY OF DECEMBER, 2020

HON'BLE SHRI JUSTICE MANMOHAN SINGH
HON'BLE DR. B.P. SINGH

CHAIRMAN
TECHNICAL MEMBER (PATENTS)

HETTICH-ONI GMBH & CO. KG
INDUSTRIESTRASSE 11-13, 32602 VLOTHO,
GERMANY

... APPELLANT

(Represented By –Mr. Solomon J. David)

VS

CONTROLLER OF PATENTS AND DESIGN
GST ROAD, GUINDY
CHENNAI-600032



... RESPONDENT

(Represented by -None)

ORDER

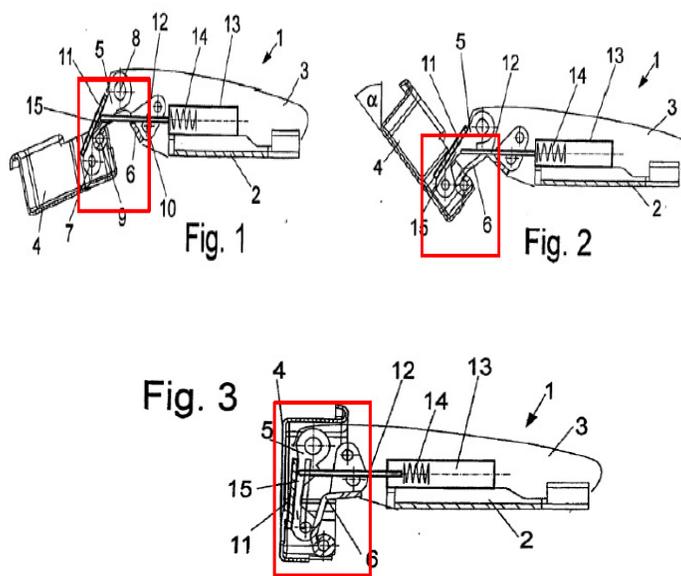
Hon'ble Shri Justice Manmohan Singh, Chairman

Hon'ble Dr. B.P. Singh, Technical Member (Patents)

1. The present appeal is filed under Section 117A of the Indian Patents Act, 1970, against the order passed by the Respondent, being the Assistant Controller of Patents & Designs on 27/08/2019, under Section 15 of the Indian Patents Act, 1970; refusing to grant the Appellants' Indian patent application no. 1128/CHENP/2009.
2. The Present Invention, as explained by the learned counsel of the appellant, is under:
 - 2.1 The claim 1 on record, is as follows:

“A furniture hinge (1), comprising a mounting plate (2) on which a side part (3) is arranged, and a cup-shaped hinge part (4) mounted pivotably on the side part (3) via a support lever (5) and a guide lever (6), with a damper (12, 13) comprising a damper housing (13) and a linearly movable piston rod (12) being provided to dampen the movement of the hinge part (4) relative to the side part (3), whereby the housing (13) comprising the piston rod (12) is arranged in the side part (3) and the damper housing (13) or the piston rod (12) is fixed to the side part (3) or the mounting plate (2), whereby a contact surface (15) on the support lever (5) or the guide lever (6) acts directly on the damper housing (13) or the piston rod (12) for damping during a closing movement of the hinge part (4), **characterized in that** the contact surface (15) will touch the piston rod (12) or the damper housing (13) only when the hinge part (4) is arranged between a closed position and an opening angle of 10° to 40°, preferably 15° to 30° and the damper is pretensioned through a spring (14) to the extended position.”

2.2 The construction and working of the furniture hinge claimed in claim 1 has been explained by the Appellant with the help of Figures 1, 2 and 3 of the specification, with added emphasis on the working of the components, which was also presented during the oral hearing, as submitted by them.



2.3 The distinguishing features of the present invention over cited prior art D1: WO2006042344 A1 has been shown by the appellant in the table given herein below:

Table: 1

The present invention	D1 : WO2006042344A1 (also cited by EPO)
<p>In the present invention, the contact surface (15) will touch the piston rod (12) or the damper housing (13) only when the hinge part (4) is arranged between a closed position and an opening angle of 10° to 40°, preferably 15° to 30° and the damper is pre-tensioned through a spring (14) to the extended position.</p>	<p>D1 (WO2006042344A1) discloses a damping arrangement, in particular for displaceable furniture parts, comprising a damper (1) which is provided with a tappet (2) which can be impinged upon, and which can be supported by a support element (3).</p>

2.4 The construction of D1 is completely different from that of the present invention. **D1 discloses that that the damper (1) is held on the hinge part which is the moveable part.**

To the contrary, as can be seen in Figures 1 to 3 of the present application, the damper is provided in the side part (fixed part), and due to a closing movement of the hinge part the linear damper is compressed or extended. This leads to a compact construction and high damping forces. The tappet (2) shown in D1 protrudes from the hinge and does not have the same compact structure. Moreover, this tappet (2) shown in D1 is not a linear damper with a damper housing and a moveable piston rod.

2.5 In addition, D1 also does not disclose, teach or suggest that the contact surface will touch the piston rod or the damper housing only when the hinge part (4) is arranged between a closed position and an opening angle of 10° to 40°, preferably 15° to 30° and the damper is pre tensioned through a spring (14) to the extended position.

2.6 Further, the distinguishing features of the present invention over cited prior art D2: DE10159140 A1 has been explained by the appellant with the help of table 2 given below:

Table: 2

The present invention	D2: DE10159140A1 (also cited by EPO)
<p>In the present invention, the contact surface (15) will touch the piston rod (12) or the damper housing (13) only when the hinge part (4) is arranged between a closed position and an opening angle of 10° to 40°, preferably 15° to 30° and the damper is pre tensioned through a spring (14) to the extended position.</p>	<p>In D2 (DE10159140A1), a linear damper 9 is mounted on a side part and can be contacted by the hinge part 1 during a closing movement. Thus, there is a risk that some elements might come between the hinge element and the damper which is problem for a proper function.</p>

2.7 The construction and functioning of D2 is totally different.

The entire hinge arrangement of D2 will be bulky.

D2 does not disclose that the housing comprising the piston rod is arranged in the side part. The damper according to the present invention is arranged in the side part and contacts the support lever or the guide lever of the hinge, and thus there is no risk that other elements get in between the damper and the hinge part.

2.8 D2 also does not disclose, teach or suggest that the contact surface will touch the piston rod or the damper housing only when the hinge part is arranged between a closed position and an opening angle of 10° to 40°, preferably 15° to 30° and the damper is pre tensioned through a spring to the extended position.

2.9 The appellant submits that the Controller has failed to analyze the teaching of D1 and D2 and provide the reasoning how a person skilled in the art can arrive at the claimed invention in an obvious manner.

3. The case of the appellant is that:

3.1 In the hearing notice the Controller had raised objections 1 to 5. In the order, the Controller records that objections 1, 4 and 5 are waived off as the same were compiled by the applicant. The Controller also agrees that prior art D3, D4 & D5 are not relevant and teaches away from the present invention.

The Controller refused the Application on following grounds:

- a. Lack of inventive step in view of the cited prior art documents: D1: WO2006042344 A1 and D2: DE10159140A1.
- b. Non submission of Verification certificate for English translation of the corresponding PCT application.

- 3.2 The learned counsel of the appellant has shown that the patents on corresponding patent applications have been granted in many other jurisdictions even though the identical prior arts documents were cited but they could succeed, based on their submissions, at IPO.
4. We have reviewed that the hearing notice dated 01/08/2019 contained the following objections:

“Clarity and Conciseness

1. *Claims not clearly worded and in claim 1 the word "comprises" should be replaced with word "consisting of".*

Invention u/s 2(1)(j)

1. *The applicant's reply dated 23/03/2017 has been duly considered, but not persuasive due to following reasons- As per the applicant, none of the cited document discloses the “linear damper with a damper housing and a moveable piston rod”. However, the claimed invention still lacks inventive step in view of earlier cited documents D1-D4 and newly cited document US6874829(D5). D5 discloses an inner door lock actuator, comprising, a rotational shaft adapted to be fixed to an automobile door; a handle formed as a lever pivotably mounted on said rotational shaft; a reset spring for biasing said handle into a rest position. D5 also discloses a linear damper for damping a movement of said handle into the rest position, said linear damper having opposite ends one of which is adapted to be linked to the automobile door and the other is linked to said handle. Moreover, DE10159140A1(D2) also discloses that a fluid damper 9 is fixed to the hinge arm 2, which is designed as a piston-cylinder unit with a fixed*

cylinder 13 and a piston linearly displaceable with the piston rod 14. So, a person skill in the art can easily combine the documents D1-D5 to achieve the claimed invention.

Formal Requirement(s)

- 1. Duly verified English translated international application should be submitted, to meet the requirements of Rule 20 (3) (b) of The Patents Rule, 2003 as amended by The Patents Amendment Rules, 2006.*
 - 2. Figure number should be mentioned in the Claims.*
 - 3. Abstract should not be the part of claim 1.”*
5. We have reviewed the order of the learned Controller and the operating portion of the order is as under:

“The Ld. Agent for Applicant complied objections 1, 4 and 5 and therefore these objections are waived off.

The Ld Agent for applicant submitted that documents D3, D4 And D5 are not relevant and teaches far away from the inventive features of the present invention, which is agreed.

Upon reading through the cited documents D1 and D2,it is understood that D2 is closest prior art and after having taught by the D2 and D1 a person skilled in the art can arrive at the claimed features of the present invention which are another embodiments.

Therefore, the amended claims 1-5 are not allowed and the application is refused patent for want of compliance of aforementioned objections 2 and 3, u/s 15 of “The Patent Act 1970”.

The Application stands disposed off.” [Emphasis added]

6. Therefore, it is evident that the Respondent, through his utter subjective statement held that the invention lacks inventive step when he holds *“after having taught by the D2 and D1 a person skilled in the art can arrive at the claimed features of the present invention which are another embodiments.”* He has neither stated facts not applied law and reached the above conclusion. The determination of ‘inventive step’ is mixed question of law and fact, depending on the facts and circumstances of each case¹. Therefore, the impugned order is not sustainable.
7. In recent past, Indian Patent Office has developed very many Guidelines² and Manuals³ to help improve the quality of patent examination. These Guidelines and Manuals are also encompassing the methods by which the ‘inventive step’ is required to be determined. The Indian Courts have also made such determination amply clear through various judicial pronouncements. The efforts of the IPO towards development of these literatures, combining the essence of all these judicial pronouncement, is to make the job of examiners and Controllers easy, so that they can improve the quality of patent examination and grant. This Board has also emphasized the need for application of settled law in determination of “inventive step’ in a very recent order in PHARMACYCLICS, LLC⁴. For the sake of brevity, we are inclined not to reproduce it again. We would, however, emphasis that the following passage from land

¹ Cipla Ltd. vs F.Hoffmann-La Roche Ltd. & Anr. Available at <https://indiankanoon.org/doc/57798471/?type=print>

² Available at <http://www.ipindia.nic.in/resources.htm#Manuals>

³ ibid

⁴ OA/46/2020/PT/DEL

mark judgment of Hon'ble Supreme Court of India⁵ must be kept in mind while determination of inventive step to keep 'subjectivity' at bay.

"The 'obviousness' has to be strictly and objectively judged. For this determination several forms of the question have been suggested. The one suggested by Salmond L. J. in Rado v. John Tye & Son Ltd. is apposite. It is: "Whether the alleged discovery lies so much out of the Track of what was known before as not naturally to suggest itself to a person thinking on the subject, it must not be the obvious or natural suggestion of what was previously known."

Another test of whether a document is a publication which would negative existence of novelty or an "inventive step" is suggested, as under:

"Had the document been placed in the hands of a competent craftsman (or engineer as distinguished from a mere artisan), endowed with the common general knowledge at the 'priority date', who was faced with the problem solved by the patentee but without knowledge of the patented invention, would he have said, "this gives me what I want?" (Encyclopaedia Britannica; ibid). To put it in another form: "Was it for practical purposes obvious to a skilled worker, in the field concerned, in the state of knowledge existing at the date of the patent to be found in the literature then available to him, that he would or should make the invention the subject of the claim concerned ?" Halsbury, 3rd Edn, Vol. 29, p. 42 referred to by Vimadalal J. of Bombay High Court in Farburke Hoechst & B. Corporation v. Untchan Laboratories."

8. We urge the Respondents to issue strict instructions so that set procedural practices enshrined in the Guidelines and Manuals and

⁵ Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries. Available at <https://indiankanoon.org/doc/1905157/>

relevant Court orders are adhered to by all concerned, so that cases of the instant nature could be avoided.

9. We also note that not only the Controller has violated the set procedure of determination of 'inventive step' but also totally disregarded the teachings of Rules 28(7)⁶ of the Patents Rules, 2003; which says that "(7) In all cases of hearing, written submissions and the relevant documents, if any, shall be filed within fifteen days from the date of hearing." We observe that the hearing was held on 27/08/2019. The appellant filed their written submission in accordance with this Rule on 11/09/2019, when the impugned order was already issued on 27/08/2019 without considering the written submission of the appellant. Such cases may be seen as implied bias on the part of the respondent and should be avoided.
10. We have considered the submissions of the learned counsel of the appellant and are inclined to accept their argument that none of the prior art documents cited in the impugned order i.e. D1 and D2 make the invention 'obvious' to a person skilled in the art.
11. We, therefore, set aside the impugned order of the respondent dated 27/08/2019 and direct the respondent to grant the patent on the basis of the claims on record to the appellant, strictly within 2 weeks from the issuance of this order.
12. The appeal is allowed. No cost.

-Sd/-

(Dr. B.P. Singh)
Technical Member (Patents)

-Sd/-

(Justice Manmohan Singh)
Chairman

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⁶ Available at <http://ipindia.nic.in/writereaddata/Portal/ev/rules/pr28.html>