



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

% Judgment Reserved on: 25th September, 2025
Judgment pronounced on: 24th December, 2025
Date of uploading: 29th December, 2025

+ **C.A.(COMM.IPD-PAT) 465/2022**

EMITEC GESELLSCHAFT FUR EMISSIONSTECHNOLOGIE

MBHAppellant
Through: Mr. Manish Aryan, Ms. Manisha
Singh, Mr. Abhai Pandey, Mr. Nishant
Rai and Mr. Gautam Kumar,
Advocates

versus

CONTROLLER GENERAL OF PATENTS, DESIGNS
& TRADEMARKS & ANR.

.....Respondents
Through: Mr. Rohan Jaitley, Mr Dev Pratap
Shahi, Mr. Varun Pratap Singh and
Mr. Yogya Bhatia, Advocates

CORAM:

HON'BLE MS. JUSTICE MANMEET PRITAM SINGH ARORA

JUDGMENT

MANMEET PRITAM SINGH ARORA, J.

1. The present appeal has been filed under Section 117A of the Patents Act, 1970 (hereinafter 'Patents Act'), against the order dated 07th March, 2022 (hereinafter 'impugned order') passed by the Assistant Controller of Patents and Designs (hereinafter 'the Controller'), whereby the Indian Patent Application No. 5222/DELNP/2012 titled 'Tank Assembly And Metering System For A Reducing Agent' (hereinafter 'Subject Patent Application') has



been refused.

BRIEF FACTS

2. Brief facts necessary for deciding the present appeal are set out below:

2.1. The appellant/EMITEC Gesellschaft für Emissionstechnologie mbH has its principal place of business at Hauptstraße 128, 53797 Lohmar, Germany.

2.2. The Subject Patent Application was filed as International Application No. PCT/EP2010/063824 (hereinafter the 'PCT application') on 20th September 2010, claiming priority from the German Patent Application No. 102010004614.0 filed on 13th January 2010. The bibliographic details of the Subject Patent Application are given below:

Application No.	5222/DELNP/2012
Filing Date	13/06/2012
Publication Date	23/10/2015
Request for Examination	19/06/2012
First Examination Report ('FER')	08/03/2018
Response to FER	26/03/2018
Date of HearingNotice	01/07/2020
Date of FinalHearing	16/07/2020
Date of Written Submissions	31/07/2020
Date of ImpugnedOrder of Refusal	07/03/2022

2.3. A request for examination of the said application was filed by the appellant on 19th June 2012, and thereafter theSubject Patent Application was published on 23rd October 2015.

2.4. A First Examination Report (hereinafter 'FER') was issued by the



Controller on 8th March 2018. The relevant objections communicated to the appellant via the said FER are as follows:

A. The claims 1-18 are not inventive under Section 2 (1)(ja) of the Patents Act in view of the following documents:

D1: DE102004051746A1

D2: WO1998028070 A

D3: EP1925354 A1;

B. The subject matter of claims 1-18 lacks sufficient disclosure, clarity and conciseness as per Section 10 of the Patents Act.

2.5. Pursuant to the objections raised in the FER, the appellant submitted a detailed response along with amended claims vide letter dated 26th March 2018. The appellant clarified that the present invention is inventive since:

- i. The cited prior arts D1-D3, individually or in combination, do not disclose or teach the features claimed in the Subject Patent Application.
- ii. The differentiating features of the Subject Patent Application ensure accurate filling-level determination and complete evacuation of the reducing agent tank, thereby achieving technical advancement and economic significance, rendering the claims non-obvious to a person skilled in the art as required under Section 2(1)(ja) of the Patents Act.

2.6. Vide hearing notice dated 1st July 2020, the following relevant objections were raised:

A. Claims 1-18 of the Subject Patent Application lack inventive steps as per Section 2(1)(ja) of the Patents Act, citing the following documents:

D1: EP 1 925 354 A1

D2: JP 2009 243331 A

D3: DE 10 2008 031052 A 1



D4: WO 2007/141312 A1

D5:JP 2009144644 (A)

D6:WO2006/134641

2.7. The appellant, through its authorised representative, attended the hearing on 16th July 2020 and made submissions regarding the objections raised by the Controller in the hearing notice dated 1st July 2020. Subsequently, the appellant filed a detailed written submission on 31st July 2020. The appellant clarified that the present invention is inventive since:

- i. The feature of the invention claimed in the Subject Patent Application, i.e., reducing-agent delivery device with a separate chamber formed in the tank bottom above the main bottom plane, constituting a sub-volume not filled with reducing agent, and housing a dosing unit with a pump that extracts the reducing agent at an extraction point, is absent from all cited documents D1-D6.
- ii. The claimed configuration eliminates extraction pipes and negative-pressure requirements, reduces cost, enables easy maintenance and replacement of the dosing unit, improves accessibility, and enhances operational efficiency, amounting to technical advancement with economic significance.
- iii. Applying settled principles on inventive step, no coherent or motivated path exists for a person skilled in the art to combine D1–D6 to reach the claimed invention. Accordingly, claims 1–18 of the Subject Patent Application fulfil the requirement under Section 2(1)(ja) of the Patents Act.

2.8. Thereafter, the impugned order was passed by the Controller, refusing the subject application under Section 15 of the Patents Act, on the ground



that the claims lack inventive step under Section 2(1)(ja) of the Patents Act (as amended). The relevant extracts from the impugned order are set out below: -

“Reason for refusal

During the hearing on 16.07.2020 & upon perusal of record it is observed subject matter of claims

1-18 is obvious to a person skilled in the art and hence lacks inventive step u/s 2(1)(ja) of The Patents Act, 1970 (as amended).

Reference is made to following documents;

D1: EP 1 925 354 A1

D2: JP 2009 243331 A

D3: DE 10 2008 031052 A1

D4: WO 2007/141312 A1

D5: JP 2009144644 (A)

D6: WO2006/134641

Regarding claim 1;

Document D2 discloses a device (1) for providing liquid reducing agent, comprising a reducing agent tank (20) for storing reducing agent ("urea water") with a tank bottom (21), the one having a separate chamber (32, R) and having a dosing unit (40, 50) for removing reducing agent from the reducing agent tank (20) at one located at the partitioned chamber (32, R). Removal point (61), wherein the dosing unit (40, 50) within the separated chamber (32, R) is arranged, wherein the separated chamber extending towards the inside of the tank represents partial volume, which is preferably not filled with reducing agent.

Furthermore, the subject matter of claim 1 from documents D3 and D4 known. D3 undoubtedly shows a chamber in the sense of the Claim 1 (see paragraph [0039] to [0040] and Figure 1 of D3). Therefore a pump and its control (PCB 9) in a separate chamber are arranged. The entire base 10 is intended to be in one containers of urea to be immersed.

Further document D2 shows a separate chamber R according to the wording of Claim 1. In addition,

Figure 1 shows a pump 40 of a housing part 32 and 60 is surrounded. The electrical connections of the pump sit in an area (part where the reference numeral 32c indicates) that is associated with the seals 44 and 45 is sealed against reducing agents. From the Figure 1 shows implicitly that this area for connecting the electrical wiring is connected to the partitioned chamber. The area mentioned can therefore be paid for in addition to the separate chamber.

The subject matter of claim 1 differs from that document D2 only in that the pump is not completely in the separated chamber sits because



the seal 44 is in the center of the pump is located and not at the left end of the pump.

In a modification of the component 60, so that the seal 44 at the left end of the pump sits and this completely in the separated chamber, no inventive step can be seen.

On the other hand, if one sticks to a realistic interpretation of claim 1, then document D3 is still considered closed citation. The separate chamber in the D3 by a cover 4 and a cylindrical wall 10 is formed. The lid 4 has an upward continuation which is still seen as part of the segregated chamber. In this continuation where the mechanical pump element 2 of the pump is located, at the upper end of the continuation is an inlet opening to the pump.

Therefore claim 1 is not inventive.

Further dependent claims 2-18 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of therein respect of inventive step.

Other documents are found relevant to claimed subject matter.

Therefore, this application is refused for want of compliance of aforementioned objections u/s 15 “The Patent Act 1970”.

SUBMISSIONS ON BEHALF OF THE PARTIES

SUBMISSIONS ON BEHALF OF APPELLANT

3. Learned counsel appearing on behalf of the appellant has made the following submissions:

3.1. The present invention relates to a device for providing a liquid reducing agent, wherein the reducing agent tank has a separate chamber formed in the tank bottom above the main bottom plane, the chamber being a subvolume not filled with reducing agent, and housing a dosing unit with a pump for extraction. This structural configuration is central to the invention.

3.2. The claimed arrangement eliminates the need for conventional extraction pipes extending from the tank top and for negative suction pressure. It enables easy maintenance and replacement of the dosing unit without dismantling the tank, even when the tank is full. These constitute clear technical advancement and economic significance.



3.3. None of the cited documents D1 to D6, either individually or in any possible combination, disclose or suggest:

i.a separate chamber in the tank bottom that is free of reducing agent,
and

ii.a dosing unit with a pump fully disposed within such a chamber.

3.4. The objection relies on six (6) prior art documents without identifying any motivation for selecting or combining them. An unimaginative person skilled in the art would not be led to consult or combine these documents to arrive at the claimed configuration. Such an approach amounts to impermissible hindsight reconstruction.

3.5. The respondent no.2 has not demonstrated that the claimed invention satisfies any recognised test of obviousness, such as predictable results, simple substitution, or obvious-to-try. There is no coherent technical thread leading from the prior art to the present invention.

3.6. Settled law requires that obviousness be assessed without hindsight and with clear motivation to combine prior art. That requirement has not been met.

3.7. In conclusion, the subject matter of independent claim 1, and consequently dependent claims, clearly satisfies the requirements of Section 2(1)(ja) of the Patents Act. Therefore, the impugned order is unsustainable and deserves to be set aside.

SUBMISSIONS ON BEHALF OF THE RESPONDENT NO. 2

4. The learned counsel appearing on behalf of the respondent no.2 has made the following submissions:



4.1. Claims 1-18 lack inventive step in view of prior art documents D1 to D6, particularly D2 and D3, which were examined in detail and also relied upon in the corresponding EP examination.

4.2. Document D2 discloses a reducing agent tank having a separate chamber, a partial volume preferably not filled with reducing agent, and a dosing unit with a pump arranged within the separated chamber to extract the reducing agent at an extraction point. The respondent no.2 submits that the proximity between amended claim 1 and D2 is apparent, and the alleged difference relating to the complete placement of the pump within the chamber amounts to a minor design modification, not involving any inventive step.

4.3. Document D3 also discloses a separate chamber formed by a cover and cylindrical wall, with pump components and controls arranged therein. The respondent no.2 submits that the advantages claimed by the applicant, including compact installation and electrical integration, are already known from D3.

4.4. A person skilled in the art would find it obvious to relocate the seal or housing in D2 to place the pump entirely within the separated chamber. Such modification does not involve technical advancement but is a routine workshop variation.

4.5. Dependent claims 2-18 do not add any technical feature which, in combination with claim 1, could confer inventive step. They merely relate to obvious design variations.

4.6. Documents D1, D4, D5, and D6 are also relevant and further support the conclusion of obviousness. However, detailed reliance on these documents is unnecessary given the clear disclosures in D2 and D3.



4.7. Amended claim 1 is obvious to a person skilled in the art in view of D2 and D3, and claims 1-18 do not satisfy Section 2(1)(ja) of the Patents Act.

4.8. Therefore, the present appeal may be dismissed, and the impugned order may be upheld.

ANALYSIS AND FINDINGS

5. This Court has heard the learned counsel for the parties and perused the material on record.

6. It is clearly discernible from the impugned order and the submissions made by the counsel that the Subject Patent Application has been refused under Section 2(1)(ja) of the Patents Act for alleging a lack of inventive step.

According to the appellant, the impugned order does not satisfy the procedural requirement for the assessment of inventive step as prescribed by the Division Bench of this Court in **Cipla Ltd. v. F. Hoffmann-La Roche Ltd. & Anr.**¹ However, according to the respondent no.2, the impugned order fulfils the touchstone of Section 2(1)(ja) of the Patents Act in assessing the Subject Patent Application.

7. Therefore, the issue in the present appeal is whether the impugned order procedurally satisfies the test as prescribed by the Division Bench of this Court in **Cipla Ltd. v. F. Hoffmann-La Roche Ltd. & Anr.** (supra) while returning a finding of lack of inventive step under Section 2(1)(ja) of the Patents Act.

8. The assessment of inventive step under Section 2(1)(ja) of the Patents Act primarily requires enquiring into the following aspects in a subject

¹2015 SCC OnLine Del 13619



matter claimed in a patent application:

1. Whether well-defined feature(s) claimed in a patent application demonstrate technical advancement over the existing knowledge and/or involve economic significance?
2. Whether the feature(s) claimed in a patent application make the invention not obvious to a person skilled in the art?

If either of the two (2) enquiry answers negatively, the requirement under Section 2(1)(ja) of the Patents Act stands unfulfilled.

9. As of now, the only test in India for answering these queries is a five (5)-step test put forward by the Division Bench of this Court in **Cipla Ltd. v. F. Hoffmann-La Roche Ltd. & Anr.** (supra). Recently, in **Tapas Chatterjee v. Controller of Patents & Designs**,² a Division Bench of this Court has reaffirmed those five (5) steps, and the relevant paragraph reads as under:

“21.4.1 The learned Single Judge has, in para 25 of the impugned judgment, relied on the pronouncement of the Division Bench of this Court in *F. Hoffmann La Roche Ltd. v. Cipla Ltd.*, and we are in agreement with him that the said decision lays down principles which, for the present, may be regarded as the gold standard to determine whether a later invention is obvious from the teachings contained in an earlier patent. The Division Bench has identified the following steps, in this regard:

“Step No. 1 To identify an ordinary person skilled in the art,

Step No. 2 To identify the inventive concept embodied in the patent

Step No. 3 To impute to a normal skilled but unimaginative ordinary person skilled in the art what was common general knowledge in the art at the priority date

Step No. 4 To identify the differences, if any, between the matter cited and the alleged invention and ascertain whether the differences are ordinary application of law or involve various different steps requiring multiple, theoretical and practical applications,

Step No. 5 To decide whether those differences, viewed in the knowledge of alleged invention, constituted steps which would have been obvious to the ordinary person skilled in the art and rule out a [hindsight] approach.”

²2025 SCC OnLine Del 6369



Having thus reproduced the steps that **Hoffman** envisages as being required to be followed, sequentially, while examining the aspect of obviousness and the existence of inventive step, the learned Single Judge, in para 26 of the impugned judgment, proceeds to observe that he would “start at Step 4 and identify the differences, if any between the prior art as identified by the Controller and the subject patent application”.

21.4.2 There are obvious errors in the manner in which the learned Single Judge has applied the procedure outlined in **Hoffmann**.

21.4.3 We are of the opinion that the learned Single Judge could not have commenced applying the principles in **Hoffmann** from Step 4. The error in starting from Step 4 is self-evident. *It bypasses the person skilled in the art who, statutory and legally, is the person, from whose point of view the aspect of inventive step and obviousness has to be determined. Identification of the person skilled in the art is, therefore, the fundamental first step while examining a plea of obviousness and lack of inventive step.*

21.4.4 *Steps 2 and 3 are no less significant. To ascertain whether a later invention, that is sought to be patented, on which already stands patented, is obvious vis-à-vis prior art, the inventive concept of the prior art has to be understood and identified. It is only once the inventive concept of the prior art-as well as, we may add, the inventive concept of the later invention-are identified, that it would be possible to gauge the distance that would be required to be scaled, to leap from one to the other.*

.....

21.6 The sequitur

The sequitur would not, however, be that the subject process, that the appellant desires to patent, would ipso facto be entitled to be treated as inventive, or not obvious, vis-à-vis the prior art documents D1 and D2. It is only an invention which is inventive, and is not obvious to a person skilled in the art possessed with common general knowledge and the teachings contained in the prior art documents, that can be patented. Whether the subject process satisfies this requirement would have to be determined by strictly following the tests laid down by the Division Bench in **Hoffmann**, and the principles outlined earlier in this judgment. **While all the Steps identified in Hoffmann are important, we would lay particular Emphasis on Steps 1, 2 and 5.**

....

Conclusion

23. We, therefore, allow the present appeal in the following terms and to the following extent:

... (iv) The *de novo* consideration would be carried out strictly in



terms of the principles enunciated in *Hoffmann* as well as in the present judgment. There shall be implicit adherence to the said principles.”

[Emphasis supplied]

10. A reference may also be made to **Alimentary Health Ltd. v. Controller of Patents & Design**,³ **Mahesh Gupta v. Controller of Patents & Designs**,⁴ **Saint Gobain Glass France Versus Assistant Controller of Patents and Designs and Another**,⁵ **Novo Nordisk AS v. Dr. Reddys Laboratories Ltd.**,⁶ which are some of the recent decisions wherein this Court or coordinate benches of this Court have followed the above said test directly or in essence for determining inventive step of an invention claimed in a patent application as per Section 64(1)(f) or 2(1)(ja) of the Patents Act.

11. Therefore, for returning a finding of lack of inventive step under Section 2(1)(ja) of the Patents Act, the Controller should follow the afore-referred five-step test directly or in essence.

12. Now this Court shall examine the impugned order, if the same has followed the afore-referred test directly or in essence to return a finding regarding lack of inventive step under Section 2(1)(ja) of the Patents Act.

13. The impugned order, as extracted in paragraph ‘2.8’ of this judgment, returns a finding in the following manner:

- i. Lists prior arts D1-D6;
- ii. Straight away discusses the invention, i.e., liquid reducing agent, disclosed in the prior art D2;
- iii. Refers to paragraphs and drawings of D3 and D4 and states that the

³ 2024 SCC OnLine Del 3473

⁴ 2024 SCC OnLine Del 4000

⁵ 2025 SCC OnLine Del 5919

⁶ 2025 SCC OnLine Del 8702



subject matter claimed in claim 1 of the Complete Specification of the Subject Patent Application is known in those prior arts.

- iv. Identifies the difference of Claim 1 of the Complete Specification of the Subject Patent Application from D2.
- v. States that Claim 1 is also implicitly disclosed in the D3.
- vi. Concludes Claim 1 is not inventive and dependents claim 2-18 are also absent any feature possessing inventive step.

14. From the above analysis, it is clear that, in the impugned order while assessing inventive step, the Controller has not identified the person skilled in the art relevant for the inventive step assessment in the present case (Step No. 1) or has not identified the inventive concept embodied in the Complete Specification of the Subject Patent Application (Step No. 2); instead Controller straight away is identifying the relevant prior arts D1 to D6, constituting the common general knowledge, without even discussing how they relate to the Subject Patent Application (Step No. 3).

Thereafter, the invention claimed in the Subject Patent Application is differentiated from the prior arts D2, D3 and D4. (Step No.4) and concludes the invention claimed in the Subject Patent Application lacks inventive step (Step No.5).

15. According to **Tapas Chatterjee v. Controller of Patents & Designs (supra)**, Steps 1, 2 and 5 of the five-step test proposed by the **Cipla Ltd. v. F. Hoffmann-La Roche Ltd. & Anr.** (supra) are of more importance, which evidently have not been followed in the impugned order.

16. Without identifying the inventive concept of the Subject Patent Application, the impugned order fails to address what technical problem the Subject Patent Application is trying to solve, what technical features are



claimed to solve the technical problem, and the technical advantages achieved by the invention claimed in the Subject Patent Application.

Also, the failure of the impugned order to identify the person skilled in the art in whose perspective the inventive step is to be assessed, clearly fails to depict the threshold of inventive step, by illustrating whether the invention claimed in the Subject Patent Application is obvious for the person skilled in the art possessing the common general knowledge in terms of prior arts D1-D6. The impugned order fails to address these essential questions.

17. Thus, in light of the findings above, the impugned order fails to comply with the procedural requirement while returning a finding regarding lack of inventive step under Section 2(1)(ja) of the Patents Act. Therefore, the impugned order is liable to be set aside and requires a fresh analysis in accordance with the five [5]-step test set out by the Division Bench of this Court in **F. Hoffmann-La Roche Ltd. v. Cipla Ltd.** (supra) to determine the inventive step.

18. The Controller would afford a fresh opportunity of hearing the appellant before deciding the Subject Patent Application after giving a hearing notice to the appellant. If any new material comes to the knowledge of the respondent no.2, the same would be put to the appellant in the hearing notice so that the appellant has an opportunity to deal with the same.

19. Accordingly, the appeal is allowed, and the following directions are passed:

- i) The impugned order is set aside, and the matter is remanded back to the Patent Office for a fresh consideration of the objection under Section 2(1)(ja) of the Patents Act.
- ii) Prior to deciding the matter afresh, the Assistant Controller shall



issue a fresh hearing notice clearly delineating the objections.

- iii) The Applicant shall have the liberty to file fresh written submissions.
 - iv) The Patent Office shall endeavour to decide the subject application in an expeditious manner, preferably within three (3) months.
20. The appeal stands disposed of in the aforesaid terms.
21. Pending application stands disposed of.
22. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trade Marks of India on the e-mail- llc-ipo@gov.in.

MANMEET PRITAM SINGH ARORA
(JUDGE)

DECEMBER24, 2025/fv