



IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
Intellectual Property Rights Division

BEFORE:
The Hon'ble JUSTICE RAVI KRISHAN KAPUR

IPDPTA/34/2022

OCV INTELLECTUAL CAPITAL LLC (SR. NO.246/2016/PT/KOL)
VS
THE CONTROLLER GENERAL OF PATENTS, DESIGNS AND TRADEMARKS

For the appellant	: Mr. Adarsh Ramanujan, Adv. Ms. Yamini Mookherjee, Adv. Mr. Sonal Mishra, Adv. Ms. Kaushiki Roy, Adv. Ms. Garima Mehta, Adv. Mr. Suryaneel Das, Adv.
For the Controller	: Mr. Swatarup Banerjee, Adv. Mr. Shankharit Chakraborty, Adv.
Heard on	: 06.01.2026
Judgment on	: 06.01.2026

Ravi Krishan Kapur, J.:

1. This is an appeal under section 117A of the Patents Act 1970 challenging an order dated 30 March, 2016 rejecting an application for patent No. 1733/KOLNP/2008 titled "COMPOSITION FOR HIGH PERFORMANCE GLASS, HIGH PERFORMANCE GLASS FIBER AND ARTICLES THEREFROM.
2. Briefly, the invention claimed is for a special glass fiber with specific components having specific weight ratios. There are three known varieties of glass fibres, namely, E-Glass, R-Glass and S-glass, with S-Glass having superior properties. However, such higher-grade requires special platinum-lined furnaces making it more expensive to produce. By the invention, the



applicant seeks a patent in respect of a glass fiber composition which can achieve the same properties of S-glass but at a lower manufacturing cost (without having to use platinum-lined furnace).

3. By the impugned order, the application for patent has been rejected on three grounds i.e., (a) lack of novelty under section 2(1)(j) of the Act; (b) lack of inventive steps under section 2(1)(ja) of the Act; and (c) non-patentable subject matter under section 3(e) of the Act.
4. On behalf of the appellant, it is contended that the impugned order is perverse and unreasoned and has been passed ignoring well settled legal principles. In arriving at the finding on novelty and inventive steps, the Controller has ignored and disregarded the principles of *teaching away*. The Controller has relied on a prior art document D1 which is also of the applicant inventor and reveals that the maximum quantum of Magnesium Oxide (MgO) in the composition in terms of the D1 is 4.5%. On the other hand, the invention claimed requires that the composition comprises at least 5% MgO. To this extent, the appellant contended that D-1 discouraged or *teaches away* from increasing the MgO concentration because it adversely affects the making of high-temperature glass fibers. As such, the claimed invention overcomes its disadvantages of increasing MgO%. There has also been no consideration of synergism under section 3(e) of the Act. The impugned order rejects the invention as a mere admixture ignoring the technical and economic advancement over the prior arts. To this extent, all the contentions including the technical and scientific data relied on by the appellant have been overlooked. In support



of such contentions, the appellant relied on *General Tyres vs. Firestone (1972) RPC 457*; *Sulphur Mills Ltd. vs. Dharamaj Crop Guard Ltd. & Anr. (2021) 87 PTC 567*; *Toyo Engineering Corporation & Anr. Vs. The Controller General of Patents, Designs and Trade Marks & Anr.; Uniworth Resorts Limited and Ajay Prakash Lohia vs. Ashok Mittal & Ors. (2008) 1 CalLT 1 and Stempeutics Research Pvt. Ltd. vs. Assistant Controller of Patent & Designs (2020) SCC OnLine IPAB 16*).

5. On behalf of the respondent Controller, it is submitted that impugned order justifies no interference and is adequately reasoned. The Controller has considered the contentions of both parties. On the aspect of novelty, the Controller has fully examined the prior art document D1 and arrived at a specific finding that the present invention falls within the knowledge of the prior art document. The miniscule increase in the weight of MgO is neither novel nor does the same constitute any variation resulting in inventiveness. The entire contention on account of D1 *teaching away* is unsubstantiated and without any basis. There is substantial overlap between D1 and the subject invention and this does not constitute any change. The composition of the subject invention is identical to the prior arts D1 and D2. There was no technical advancement in the invention when compared with the existing knowledge of the same. Prior arts D1-D4 makes it easy for the person skilled in the art to attract the limitation of obviousness and thereby warrants rejection of the subject invention. Insofar as the objection under Section 3(e) is concerned, the experimental data alongwith the comparative study as provided by the appellant in its claim does not demonstrate any synergistic effect to overcome the limits under section 3(e)



of the Act. There was no comparative study and all the results relied on by the applicant were predictable thereby justifying the rejection under section 3(e) of the Act. In view of the above, the appeal is liable to be dismissed.

6. The impugned order concludes that invention lacked novelty because of the prior art D1. The order itself recognizes that the maximum percentage of MgO is 4.5% whereas the invention required at least 5% MgO. The fact that even a 0.5% difference in MgO would confer novelty has not been considered. The contention that the present invention achieved a certain technical advantage despite increase of MgO has not even been dealt with in the impugned order. In *General Tyres v. Firestone*, [1972] RPC 457, it has been held:

...If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated. The prior inventor, however, and the patentee may have approached the same device from different starting points... but if carrying out the directions contained in the prior inventor's publication will inevitably result in something being made or done which, if the patentee's patent were valid, would constitute an infringement of the patentee's claim, this circumstance demonstrates that the patentee's claim has in fact been anticipated.

If, on the other hand, the prior publication contains a direction which is capable of being carried out in a manner which would infringe the patentee's claim, but would be at least as likely to be carried out in a way which would not do so, the patentee's claim will not have been anticipated, although it may fail on the grounds of obviousness. To anticipate the patentee's claim, a prior publication must contain clear and unmistakable directions to what the patentee claims to have invented... A signpost, however clear, upon the road to the patentee's invention will not suffice. The prior inventor must be clearly shown to have planted his flag at the precise destination before the patentee.

7. In *Bristol-Myers Squibb Holdings Ireland Unlimited Company and Others vs. BDR Pharmaceuticals Pvt. Ltd. and Another* 2020 SCC OnLine Del 1700, it has also been held as follows:

36. From the judgments as noted above, some of the principles which govern the field to find out whether an invention is obvious or not can be summed up as under:— (iii) There should be no teachings away from the patent in question in the prior art.



37. The Court of Appeals in *'The General Tire & Rubber Company v. The Firestone Tyre & Rubber Company Limited'* 1972 R.P.C. held that to find out what is obvious one does not have to look upon beyond the primary dictionary meaning of it which says 'very plain'. Thus, the requirement for an invention to be obvious under Section 64(1)(f) should involve that the complete specification should be obvious, or it does not involve any inventive step, having regard to what was publically known or publically used in India or what was published in India or elsewhere before the priority date of the claim. Even accepting the fact that for a person ordinarily skilled in the art of average intelligence, publications prior to the prior art were known to him, in most of the documents there are teachings away from lactam ring much less a terminal lactam and even by mosaicing the relevant documents by an unimaginative man with no inventive capacity they do not lead to the suit patent being obvious.

8. In *Sulphur Mills Limited vs. Dharamaj Crop Guard Limited and Another* 2021

SCC OnLine 3874, it has been held as follows:

81. In the order of the Controller dated 24th October, 2009, as also the order of the IPAB dated 4th April, 2012, a mere comparison is made between the particle size and granule size of IN'429 and D-1 and it is concluded that the range in D-1 would include the range given in IN'429. In the opinion of this Court, this is an incorrect approach inasmuch as the main sulphur range is itself different. Moreover, D-1 is actually teaching away from what is contained in IN'429. D-1 encourages use of larger particle size whereas IN'429 shows a shift in the opposite direction i.e., use of smaller particle size to enable better absorption. The mere presence of standardised agents such as wetting agent, dispersing agent, filler and binding agent would not make the two compositions identical in as much as the nature of the composition and the loading of sulphur, the utilisation of the same etc., are different.

82. D-1 does not defeat the novelty of IN'429 due to the range of active ingredient itself being different. Thus, the main claim 1 is not anticipated by D1. On an analysis of the two patent specifications, this Court is of the opinion that the process disclosed in D-1 relates to sulphur of a lower concentration but with a bigger granule and particle size. In IN'429, however, the patented product is a composition which has a much higher sulphur loading/concentration and, surprisingly, a lower granule and particle size than what is taught and suggested in D-1. Thus, when a person skilled in the art analyses D-1, there is no motivation for the said person to explore the opposite of what it teaches i.e., to use a higher loading of sulphur with lower granule and particle size.

9. The doctrine of *teaching away* is well recognized and applies whenever the inventor researches in a direction opposite to the direction predicted in the prior art. In other words, the doctrine applies when the prior art discouraged the persons skilled in the art from doing what the invention



did. The case of the appellant before the Controller was that the prior art discourages the person skilled in the art from increasing the MgO concentration because it reduces the high temperature resistance of the glass has not been adverted to in the impugned order. The finding in the impugned order that the concentration is almost *same* is insufficient and does not deal with the contentions of the appellant.

10. In this context, the appellant had also relied on scientific and technical data to substantiate the above fact. The subject invention was to manufacture high temperature resistance glass at lower cost so that any person skilled in the art reading D1 would be discouraged from increasing the MgO concentration. In such circumstances, it was contended that the appellant had truly overcome a prejudice in the art and researched in a direction which the prior art suggested was disadvantageous. This required investigating into the prejudices of the prior art. (*Terrell on the Law of Patents 20th Edition* @ Paras 12-97 to 12-102 and *Pratibha M. Singh on Patent Law*, 1st Edition, Thomson Reuters @ paras 3-092). This issue has been specifically raised by the appellant in the Written Submissions and technical and scientific data in support thereof made available. Nevertheless, the Controller in passing the impugned order ignores the contention of *teaching away* and does not deal with this issue at all. This was a factor to be considered in the non-obviousness analysis. This is a serious infirmity in the impugned order and vitiates the entire finding both on inventiveness and lack of novelty.

11. The next ground for rejection of the application was lack of inventive steps. The impugned order relies on four prior art documents D1 to D4. The



teachings of each of the prior art documents have been verbatim reproduced in the impugned order. In effect, the Controller merely summarized the four prior arts and arrived at the conclusion that subject application lacked inventive steps. In this context, the operative portion of the impugned order reads as *“Upon consideration of disclosure of the cited documents DI, D2 and teachings of D3 and D4, I am of the opinion that a person skilled in the art would arrive the present invention with the knowledge of the above cited documents. Hence the alleged invention is obvious and does not involve an inventive step over the cited documents.”* The conclusion arrived at in the impugned order is unsupported by any reasons at all. Reasons are the safeguard against the *ipse dixit* of the decision making process. The justification and the reasonableness of the conclusion can only depend on the reasons given in support thereof. Reasons disclose how the mind has been applied to the matters in issue.

12. The contention of the appellant that the present invention is an improvement over the appellant's prior art D-1 invention by achieving a certain technical effect despite increasing MgO% has not even been considered. Equally, the appellant had argued that the claimed invention is vastly different from D-2, because D-2 requires a higher concentration of Iron/Iron Oxide as well as a higher concentration of Boron/Boron Oxide. Similarly, *qua* D-3, there was a difference in the quantity of CaO as compared to the claimed invention, and *qua* D-4 it was contented that D-4 taught away from using CaO in the composition, whereas the claimed invention requires at least 6.9% of CaO. There is no discussion on any of the above contentions in the impugned order. Neither is there any



explanation how each of the alleged disclosures maps to the specific claim elements. The bare conclusion *dehors* reasons makes the impugned order unsustainable. It is now well-settled that in the absence of any reasons as to how each of the prior art documents disclosed lack of inventive steps and on the touchstone of the principles of *mosaicing* without demonstrating precisely how one document logically leads to another makes the conclusion of lack of inventive steps unsupportable. (*Toyo Engineering Corporation & Anr. Vs. The Controller General of Patents, Designs and Trade Marks & Anr.*; *Uniworth Resorts Limited and Ajay Prakash Lohia vs. Ashok Mittal & Ors.* (2008) 1 CalLT 1 and *Stempeutics Research Pvt. Ltd. vs. Assistant Controller of Patent & Designs* (2020) SCC OnLine IPAB 16).

13. The next ground of rejection of the application was under section 3 of the Act. It is well-settled that section 3 of the Act is attracted only in those cases there is no synergetic effect. Synergetic effect means that the individual components have some working interrelation producing a new or improved result. The contention of the appellant before the respondent authorities insofar as the aspect of the synergetic effect is concerned was as follows:

“R-Glass and S-Glass are produced by melting the constituents of the compositions in a platinum-lined melting container. The costs of forming R-Glass and S-Glass fibers are dramatically higher than E-Glass fibers due to the cost of producing the fibers in such melters. Thus, there is a need in the art for glass compositions useful in the formation of high performance glass fibers from a direct-melt process in a refractory-lined furnace and fibers formed from such compositions.

The invention, in part, is a glass composition for the formation of continuous glass fibers that are suitable for use in high-strength applications. The composition of the present invention may be inexpensively formed into glass fibers using low-cost, direct melting in refractory-lined furnaces due to the



relatively low fiberizing temperature of the glass fibers. Once formed into fibers, the glass composition provides the strength characteristics of higher-priced glass fibers such as S-Glass....”

14. Despite the above contention raised by the appellant, there has been total non-consideration of the same in the impugned order. It was contended that such synergism results in both technical and economic advancement. The contention that the claimed composition produces lower-cost high-performance glass that and is a direct melt process in a refractory lined furnace has not even been dealt with in the impugned order.
15. In the above circumstances, the impugned order is unsustainable and set aside. IPDPTA 34 of 2022 stands allowed. The matter is remanded to the Controller to be decided afresh within a period of three months from the date of communication of this order. It is made clear that there has been no expression on the merits of the case and all issues are left open to be decided afresh in accordance with law.

(RAVI KRISHAN KAPUR, J.)