

Patent | Case Law Update

Delhi High Court Critiques Non-Speaking Patent Refusal

By Vidyasaral Murugan

In late May, the Delhi High Court issued an order that yet again condemned a non-speaking refusal decision by the Controller of Patents and Designs (the Controller). The Court was hearing an appeal filed by Huhtamaki Oy and ANR (Huhtamaki) against the refusal decision, which merely reproduced information already on record. Allowing the appeal, the Court emphasized the need for reasoned orders and application of mind, calling out the cut-and-paste job in this specific refusal decision.

Additionally, the Court criticised the laconic manner in which Controllers are deciding patent applications, forcing patent applicants to approach the Court thus wasting precious time of the limited patent term otherwise available for the patentee.

The Court, therefore, issued the following directions to be strictly complied with by the adjudicating Controllers, while granting or refusing patent applications:

1. Reasoned and Speaking Orders: Every order which either (a) rejects an application seeking grant of a patent, or (b) accepts, or rejects, any pre- or post-grant opposition to such applications, shall be reasoned and speaking. These orders should systematically and sequentially deal with each objection that requires consideration, whether contained in the First Examination Report (FER), the hearing notice, or in any pre- or post-grant opposition. Furthermore, reasons must be provided as to why the objection is sustained or rejected.
2. Acknowledging Applicant's Response: If there is no pre- or post-grant opposition to the patent, and the objections raised by the Controller in the



FER or hearing notice are overcome by a worthy response, the order granting the patent should briefly state why the applicant's reply is accepted. This would facilitate any post-grant opponent, who seeks to oppose the grant of the patent or request its revocation.

3. Exemption for Unopposed Patents: The requirement of a reasoned and speaking order would not apply if the patent is granted without objections in the FER or hearing notice, or pre- or post-grant opposition.

The Court directed the Controller General to circulate these directions to all adjudicating officers through an official circular. Further, the Court also emphasized that disciplinary action may be taken against the officers who continue to issue non-speaking orders, despite said directions. Further, in view of the high stakes and public interest in patent matters, the Court also requested the Controller General to consider imparting training to adjudicating officers on writing of quasi-judicial orders.

Accordingly, the Court set aside the Controller's refusal decision and remanded the case back to the IPO for fresh adjudication by a Controller other than the one who has passed the refusal decision.