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

% Judgment reserved on: 17.04.2026
Judgment delivered on: 11.05.2026

\+ C.A.(COMM.IPD-PAT) 252/2022

ARTI SRIVASTAVA .....Appellant

versus

THE ASSISTANT CONTROLLER OF PATENTS .....Respondent

**Advocates who appeared in this case:**

For the Appellant: Mr. Essenese Obhan and Ms. Yogita Rathore, Advocates.

For the Respondent: Mr. Kushagara Kansal, SPC alongwith Mr. Abhishek Ranjan Singh, Advocate and Mr. Ravi Shankar, Patent Examiner.

**CORAM:**
**HON'BLE MR. JUSTICE TUSHAR RAO GEDELA**

**J U D G M E N T**

**TUSHAR RAO GEDELA, J.**

1. The present appeal challenges the order (hereinafter referred to as *'impugned order'*) passed by the Assistant Controller of Patents (hereinafter referred to as *"AC"*) dated 31.01.2014, whereby the application no.1774/DEL/2006, titled as "*METHOD AND SYSTEM FOR DETECTING COUNTERFEIT PRODUCTS*" (hereinafter referred to as *'subject application'*) was rejected on the ground of lack of inventive step under Section 2(1)(ja) of the Patents Act, 1970 (hereinafter referred to as *'the Act'*) and lack of sufficiency of disclosure under Section 10(4)(a) of the Act.

2. The subject application was filed on 03.08.2006 before the patent office. The appellant made a request for examination and early publication on 08.03.2007. Thereafter, First Examination Report (FER) was issued on 29.06.2011. Thereafter, the appellant filed the response to the FER on 21.05.2012. The Patent Office issued the hearing notice on 03.06.2013 scheduling the hearing on 16.07.2013. Thereafter the appellant has filed the post hearing written submissions on 02.12.2013.

3. Thereafter the Patent Office issued the impugned order on 31.01.2014 rejecting the subject application on the ground of lack of inventive step under Section 2(1)(ja) of the Act and lack of sufficiency of disclosure under Section 10(4)(a) of the Act. Hence the present appeal.

**CONTENTIONS ON BEHALF OF THE APPELLANT**

4. Mr. Essenese Obhan, learned counsel for the appellant stated that the learned AC has committed a grave error in raising the objections under Section 2(1)(ja) and Section 10(4) of the Act. While referring to the objection raised under Section 2(1)(ja) of the Act, learned counsel contended that the amended claims of the appellant clearly indicate those inventive steps which were not available in any of the prior art. In this regard, the subject package label would contain two kinds of codes, one which would be visual and the other which would be a hidden code beneath a scratchable coating.

5. According to the learned counsel, the process as explained in the amended claim is that a system would comprise of (i) a receiver to receive the product code from the product sent by the User; (ii) a processor to verify and match the received product code with that of the data centre for the purposes of authentication and (iii) a transmitter to report back the results, whereby the User is informed about the authenticity of the product.

6. In claim 2 of the amended claim, it is explained that the system claimed in claim 1, wherein the receiver is connected through a telephone line, facts, cell phone, SMS, internet, e-mail etc. for the purposes of transmission of both the codes as contained in claim 1 by the individual to the receiver for authentication. As per the claim 3 of the amended claim, the transmitter/individual connects to the User through a telephone line, fax, cell phone, SMS, internet, e-mail etc.

7. As per the claim 4 of amended claim, the product code comprises a combination of first (visible) and second (hidden) code that forms a unique number on each of the products, where the first/(visible) code is for identification of the product and the second (hidden) code is used to identify the product.

8. Claim 5 of the amended claim, describes the method of identifying the genuine products for Users comprising steps of sending product code, both visible and hidden, affixed on the product packaging to the date centre for (i) processing the said product code in order to identify its genuineness and (ii) providing results of authenticity to the Users.

9. As per claim 6 of the amended claim, which is a method claimed in Claim 5, the sending of product code from users to the data centre is through a telephone line, facts, cell phone, SMS, internet, e-mail etc.

10. As per claim 7 of the amended Claim, specify the manner of processing the product code has been explained as comparing the product code, both visible and hidden, sent by the User to the data centre with the complete product code already available with the data centre.

11. The aforesaid amended claims form the subject matter of the patent application.

12. It is the assertion of the learned counsel for the appellant that the learned AC ignored the inventive step which comprised two codes being available on the label of the product, (i) which is visible and (ii) which is hidden under a scratchable coating. According to learned counsel, none of the prior arts D1 and D5 disclose two codes being available on the packaging/product. By inviting attention to the prior arts D1 and D5, learned counsel would contend that this novel and inventive step where both codes are available at the same time on the product packaging, one being visible and the other hidden is not found in any of these four prior arts. He contended that the learned AC simply ignored the aforesaid inventive step, which was novel as well, and maintained the objection under Section 2(1)(ja) of the Act.

13. The other limb of the argument of learned counsel for the appellant was in respect of the objection raised under Section 10(4) of the Act regarding non-disclosure, whereby the learned AC objected that the complete specifications do not give specific details about data transmission/reception or how verification takes place during implementing the invention. It is stated that the Patent Office found that there is absence of such specifications and that the disclosure actually provided, hardly goes beyond the objectives.

14. In order to explain that the amended claim 1 was sufficiently supported by complete specifications, which provided complete disclosure of the manner and methodology of how the invention would operate and be used as also the method by which it was to be performed, learned counsel stated that the amended Claim 1 clearly and categorically described the invention and its operation while the complete specifications along with the diagrams and figures explained the best method of performing the invention. He would contend that so far as the first step of providing two codes i.e. one visual and two hidden, is concerned, that by itself is

a novel and inventive step which was not provided in any of the earlier prior arts documents. The manner in which the said codes were to be transmitted i.e. through a telephone line, fax, cell phone, SMS, internet, e-mail etc. was also categorically provided in the complete specifications. Moreover, the methodology and the manner in which the transmitted codes were to be compared and verified by the data centre were also clearly specified in the complete specifications and also supported by the figures/diagrams.

15. He would contend that the first step of invention in amended claim is the provision of having two codes i.e. one visible and the other hidden under a scratchable coating whereafter, the transmission of the said codes by various modes specified in the amended claim would be put to use to transmit the code to the data centre and thereafter, the manner and methodology by which the codes are processed, compared and verified would be obvious to a person skilled in the art. Thus, according to learned counsel, the objection under Section 10(4) of the Act of non-disclosure cannot be raised against the appellant as the only inventive step in amended claim 1 is in respect of the provision of two sets of code numbers one of which would be visible and the other would be hidden beneath the scratchable coating. He would contend that as the steps subsequent to the aforesaid inventive step would fall within the purview of obviousness to the persons skilled in the art (hereinafter referred to as *"PSITA"*), the objection of non-disclosure of operation or performance of the invention subsequent thereto, would not stand to any reasoning.

16. In order to meet the said objection on merits, learned counsel referred to various figures and flow charts annexed to the claim subject patent application as also the complete specifications to assert that the objection under Section 10(4) of

the Act even otherwise is not sustainable. Apart from relying on the figures and flow chart enclosed with the complete specifications, learned counsel also invited attention to the detailed description of the invention provided in the complete specifications. In particular, he relied on the following paragraphs:

> *"Figure I illustrates an example of a product code on the label of the product. It involves pasting the label on the desired product. This comprises of two coded alphanumeric text. They are pasted on the product by the manufacturer/appointed agency (called, 'corporate manufacturer') either at the time of production or packaging or at any time prior to delivery of the product in the market. The labels are designed in such a way that one of the codes will be visible to the buyer while other code will be hidden below a easily removable (scratch) coating. The visible code will be the identification code for the manufacturer and the product. Whereas, the code in the hidden part will be used to identify the products. Matching of these two numbers at Data Centre for first time will throw up results for the User/ buyer about the genuineness of the product.*
>
> *After connection the user will be asked to send the codes in sequence to the center through specified means of communication. If the codes matches with record at centre, then it will return a message to the buyer that the product is actually produced by the producer it claims. Otherwise in all other cases, the centre will send a message to the buyer that the authenticity of the product he/she is going to buy can not be confirmed and he/she should decide next course of action.*
>
> *The Data centre will also keep a record of the enquiries and codes sent to it for confirmation. This record will help in identifying, when second or multiple enquiries are made with same codes. It will also identify the region/location/identity of the sender to a reasonable degree for the manufacturer to take appropriate necessary action deemed fit by him to check production of unauthorized products in its name.*
>
> *Figure 3A and 3B is a flow chart that illustrates different communication mode for transmittal of product Code from User to Data Centre. The User will send communication to the Data Centre (Figure 3A) of the First and Second Code. Similarly it will also receive the information from the Data Centre regarding the genuineness of the product. This communication to the Data The User will send an electronic communication either by Landline/WMM/Mobile phone /PDA/computer in the form of voice/fax/sms/mms/email/internet to a predefined number/address/website provided by the Data centre.*
>
> *Various modifications and changes may be made to the invention as would be obvious to a person skilled in the art having the benefit of this disclosure. It is*

*intended that the following claims be interpreted to embrace all such modifications and changes and, accordingly, the specifications and drawings are to be regarded in an illustrative rather than a restrictive sense."*

17. Learned counsel also states that the amended claim comprises claim 1 which is the system claim and claim 5 which is the method claim. He would contend that, read together with the figures, flow charts as also the complete specifications, the objection under Section 10(4) of the Act would be unsustainable.

18. In other words, learned counsel for the appellant asserted that the only invention in the entire claim being the provision of two separate codes, the non-disclosure of the operation and performance of the invention subsequent thereto cannot be a subject matter of an objection under Section 10(4) of the Act.

19. On the aforesaid basis, learned counsel for the appellant states that the impugned order be set aside.

**CONTENTIONS ON BEHALF OF THE RESPONDENT**

20. *Per contra*, Mr. Kushagra Kumar, learned counsel for the Controller General of Patent refutes the submissions of the appellant.

21. The learned counsel submitted that when a patentee seeks a grant for a system claim, it is necessary that the patentee disclose exactly what the drawings and corresponding specifications are required to be disclosed. Learned counsel states that the objection on insufficiency of disclosure is apparent from a cursory study of the figures provided in prior art D-1 and D-5, which sufficiently explain that in order for the patent to be granted, it is necessary that, (a) the internal components of the transmitter, the receiver and other components which work in tandem with the transmitter, the receiver and the processor and (b) a flow chart describing how the genuineness is being checked or verified be disclosed.

According to learned counsel, the complete specifications of the subject invention do not disclose any such material requirements under Section 10(4) of the Act.

22. Dilating on the above, learned counsel would contend that the data centre specified in Figures 2 and 3 of the subject patent application would not have intellect like a human being, therefore, any code that is being entered or transmitted as an input by the User has to be necessarily converted into a digital form. However, there is no such disclosure of the means for conversion in the subject patent application. It is further stated that similarly, the input code has to be compared for authenticity in the data centre. Learned counsel contends that there is no disclosure at all in the subject patent application as to how the data centre would check the authenticity of the product by digital processing of the code. There is further non-disclosure as to how the physical components involved for such a process would reach their logical end or how they are to be managed.

23. Apart from the above, and in continuance of the aforesaid, learned counsel would also contend that there is no disclosure as to how the outcome of comparison, would be required to be communicated to the User by phone/SMS/e-mail. He would contend that since the appellant has mentioned that the comparison would be conducted at the end of the data centre, it would be logical to presume that the comparison is being processed by digital means. Therefore, whether the said outcome is converted from a digital signal to either voice signal or to text is not clearly disclosed. Moreover, even the components/circuits involved in such conversion too have not been disclosed. Thus, on the anvil of the aforesaid contentions, learned counsel for the respondent stoutly contends that the objection raised under Section 10(4) of the Act is sustainable.

24. Insofar as the objection raised under Section 2(1)(ja) of the Act in respect of lack of inventive step, which was raised and found sustainable by the learned AC and challenged by the appellant in the present appeal is concerned, learned counsel under instructions, submitted that the respondent is not sustaining the said objection and that the respondent is only objecting to the lack of disclosure under Section 10(4) of the Act.

**ANALYSIS AND CONCLUSION**

**The invention:**

25. At the outset, this Court observes, though the objection was technically raised under Section 2(1)(j) of the Act, however impugned order proceeded on the basis of lack of inventive step/obviousness under Section 2(1)(ja) of the Act, bearing that in mind, the Court now shall proceed to analyse the impugned order.

26. The invention under the subject application broadly pertains to counterfeit detection mechanisms and more particularly relates to a method as well as a device for detecting counterfeit products attaching labels to the goods with special identification codes. The field of invention given under the Complete Specification (hereinafter referred to as *"CS"*) of the subject application is reproduced hereunder:

> *"FIELD OF INVENTION*
> *This invention relates broadly to counterfeit detection mechanisms. More particularly this invention relates to a method and device of detecting counterfeit products by having labels attached to goods with special identification codes."*

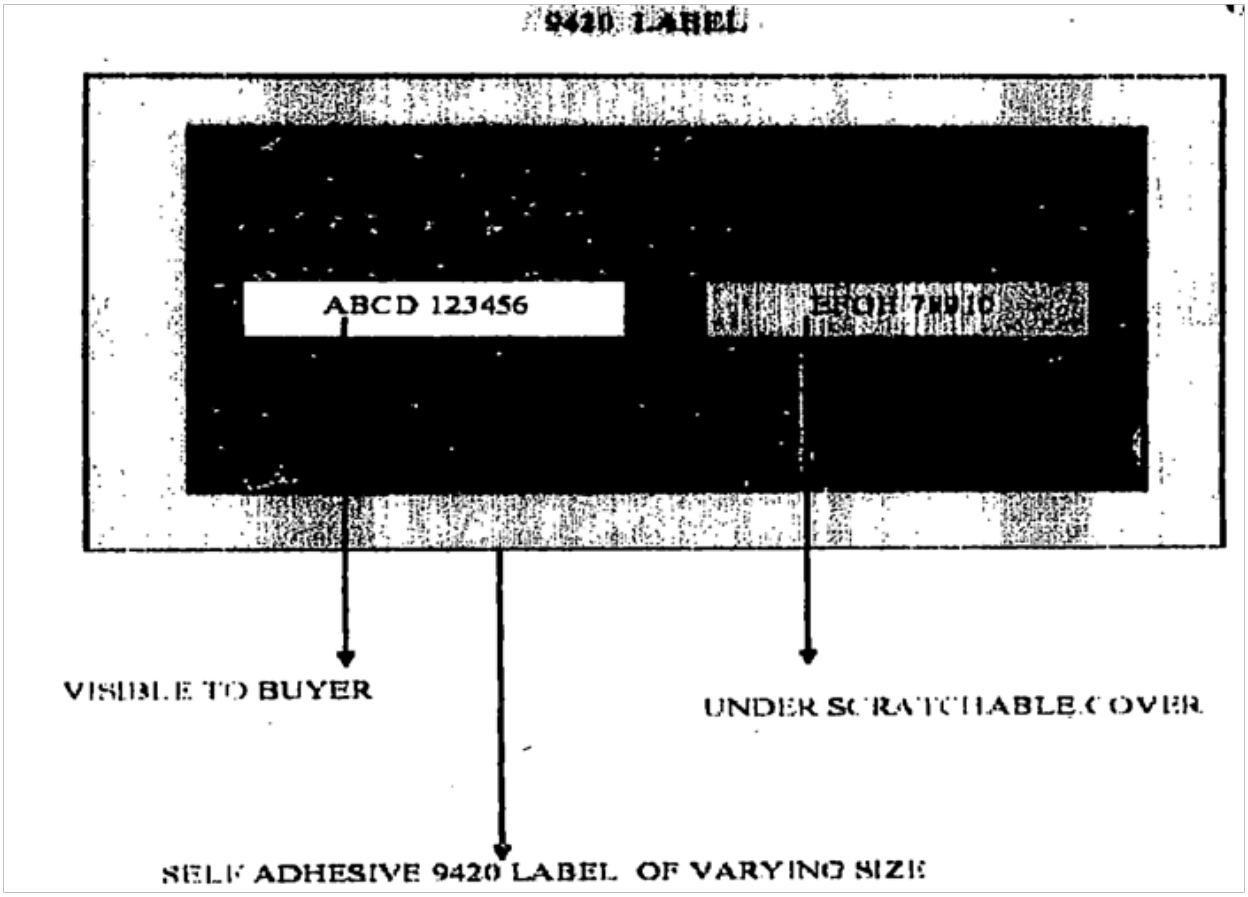
27. As per the description of the prior art given under the CS of the subject application, the fake products are causing losses of revenue to many genuine manufacturers across the globe. This problem becomes of serious nature in case of medicines and drugs because the life of a person is at stake apart from monetary

loss. In such cases, the user is not aware as to whether the product purchased by the User is a fake or pirated product. Thus, the invention claims a simple solution to verifying and authenticating a genuine product from a fake or pirated one.

28. The CS further discloses the prior art such as holograms and lab testing. It also discloses the US Patent No 6,996,543 which provides for a smart tag attached to the goods which contains encrypted authentication information like a serial number, a description of the goods physical appearance/chemical decomposition/ its color/digital images of the goods etc. Another prior art is US Patent No 6,361,079 which provides for a label to help detect counterfeit versions of the product. The next prior art is US Patent No 6,069,955 provides for a visible seal/label containing a serial number which is placed in plain view on the product packaging.

29. The CS of the subject application specifies that all existing prior arts are having a major disadvantage that an ordinary purchaser, who may not be equipped with specialized tools, would not be able to instantly verify the genuineness of the products. Thus, the present CS emphasises the need to have a simple system, whereby, the detection of counterfeit products is capable of being completed by the User himself, resulting in removing the disadvantages associated with the existing methods disclosed under the prior arts.

30. The detailed description of the CS of the subject application discusses Figure 1, which illustrates an example of a product code on the label of the product. For better understanding, the figure 1 is reproduced hereunder:




It involves pasting the label having the product code on the product. The said product code comprises two coded alphanumeric texts which are pasted on the product by the manufacturer at the time of production/packaging/at any time prior to delivery of the product in the market. The labels containing the product codes are designed in such a way that one of the codes will be visible to the buyer and the other code will be hidden below an easily removable or scratchable coating.

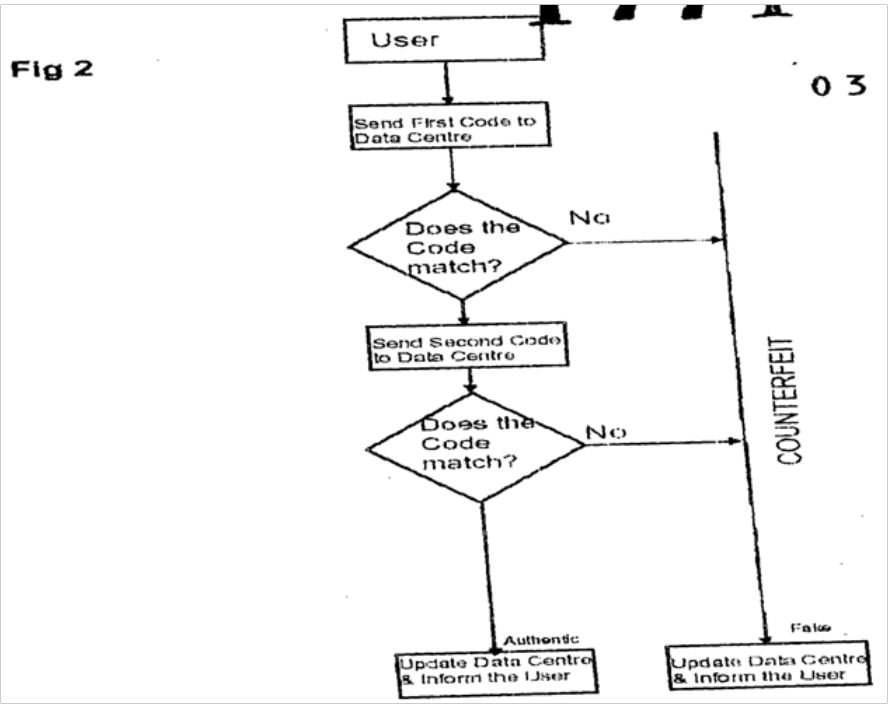
31. The purpose behind the visible code is claimed for identification of the manufacturer and the product, while the hidden code is proposed to be for identification of the product itself.

32. Thereafter, according to the CS, matching of the two said numbers at the Data Centre for the first time will show results for the User/buyer about the

genuineness of the product. The relevant para of the detailed description of the CS is reproduced as follows:

> *"……. The labels are designed in such a way that one of the codes will be visible to the buyer while other code will be hidden below a easily removable (scratch) coating. The visible code will be the identification code for the manufacturer and the product. Whereas, the code in the hidden part will be used to identify the products. Matching of these two numbers at Data Centre for first time will throw up results for the User/ buyer about the genuineness of the product."*

33. As a second step to the above, the CS of the subject application discusses Figure 2 which is a flow chart illustrating an overview of the system in accordance with one embodiment of the present invention. The figure 2 is reproduced hereunder:




As per the CS, once the connection is established, the User will be asked to send the first code to the Data Centre and consequent upon the code matching with

the record, the centre will prompt the User to send the second code after removing the (scratch) coating.

34. Thereafter, as per the detailed description of the CS, the Data Centre will then check and verify the second code with the record available with it. In case the code matches with the record at centre, it will return a message to the buyer that the product is produced by the manufacturer it claims. On the other hand, in all other cases, the centre will send a message to the buyer that the authenticity of the product he/she is buying cannot be confirmed. Additionally, the Data Centre is also required to keep a record of the enquiries as well as the codes sent to it for confirmation so as to enable the Data Centre in identifying second or multiple enquiries that may be made with the same codes. That apart, the Data Centre is required to also identify the region/location/identity of the User/sender for the genuine manufacturer to take appropriate necessary action regarding the manufacture/production of the unauthorized products in its name. The relevant portion of the said para is reproduced below:

> *"**After connection the user will be asked to send the first code to the center. If the code matches with the record, then the center will prompt the user to send the second code after opening the removable (scratch) coating. The center will then check the second code with the record available.** If the code matches with record at centre, then it will return a message to the buyer that the product is actually produced by the producer it claims, Otherwise in all other cases, the centre will send a message to the buyer that the authenticity of the product he/she is going to buy can not be confirmed and he/she should decide next course of action.*
> *The Data centre will also keep a record of the enquiries and codes sent to it for confirmation. This record will help in identifying when second or multiple enquiries are made with same codes. It will also identify the region/location/identity of the sender to a reasonable degree for the manufacturer to take appropriate necessary action deemed fit by him to check production of unauthorized products in its name."*

(emphasis supplied)

35. The Figure 3A and 3B of the CS illustrates different modes of communication for transmitting the product code from user to data centre. The Figures 3 A and 3 B are reproduced below:

FIG 3A

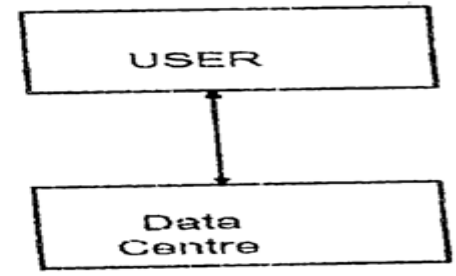
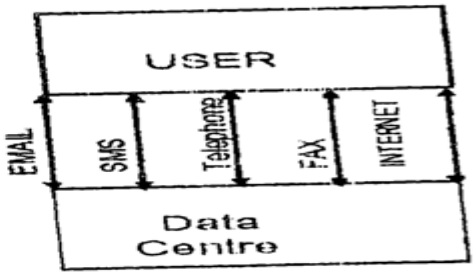



FIG 3B




As illustrated in Figure 3A, the user will send communication to the Data Centre, of the First and Second Code. The user will also receive the information from the Data Centre regarding the genuineness of the product.

36. The electronic communication is sent either by Landline/WMM/Mobile phone/PDA/computer in the form of voice/fax/sms/mms/email/internet to a predefined number/address/website provided by the Data Centre. The relevant part of the said para is reproduced below:

> *"……**The User will send an electronic communication either by Landline/WMM/Mobile phone /PDA/computer in the form of voice/fax/sms/mms/email/internet to a predefined number/address/website provided by the Data centre.** Various modifications and changes may be made to the invention as would be obvious to a person skilled in the art having the benefit of this disclosure. It is intended that the following claims be interpreted to*

*embrace all such modifications and changes and, accordingly, the specifications and drawings are to be regarded in an illustrative rather than a restrictive sense."*

(emphasis supplied)

37. The appellant submitted its amended claims on 02.12.2013 alongwith its written submissions post the hearing held on 20.11.2013. The same are reproduced hereunder:

*"We claim:*
*1. A system to identify genuineness of products by using labels affixed with visible and hidden codes on a scratchable coating, such system comprising;-*
*a receiver to receive the product code from the product sent by the User;*
*a processor to verify and match the received product code from the data centre for the purposes of authentication; and*
*a transmitter to report back the results, whereby the User is informed about the authenticity of the product.*

*2. A system of claim 1, wherein the receiver is connected through a telephone line, fax, cell phone, SMS, internet, email, etc.*

*3. A system of claim 1, wherein the transmitter connects to the User through a telephone line, fax, cell phone, SMS, internet, email, etc.*

*4. A system of claim 1, wherein the product code further comprises a combination of the first (visible) and second (hidden).code that forms a unique number on each of the product, where first (visible) code is for Identification of the product and second (hidden) code will be used to identify the product.*

*5. A method of identifying genuine products for Users, such method comprising the steps of:-*
*sending product code (visible and hidden code), said code affixed on product packaging, from the Users to data centre;*

*processing the said product code in order to Identify its genuineness, and*
*providing results of authenticity to the Users.*

*6. A method of claim 5, wherein the sending of product code from Users to data centre is through a telephone line, fax, cell phone, SMS, internet, email, etc. .*

*7. A method of claim 5, wherein the product code processing further comprises the step of comparing product code (visible and hidden code) send by User to that of already present in data centre."*

38. In the above backdrop and having regard to the objection raised by the respondent, it would be relevant to extract Section 10 of the Act. The same reads thus:

*"Section 10(4)*
*(4) Every complete specification shall—*

*(a) **fully and particularly describe the invention** and its **operation** or **use** and **the method by which it is to be performed;***

*(b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and*

*(c) end with a claim or claims defining the scope of the invention for which protection is claimed; (d) be accompanied by an abstract to provide technical information on the invention: Provided that—*

*(i) the Controller may amend the abstract for providing better information to third parties; and*

*(ii) if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b), and if such material is not available to the public, the application shall be completed by depositing the material to an international depository authority under the Budapest Treaty and by fulfilling the following conditions, na*

*mely:—*

*(A) the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;*

*(B) all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository*

*institution and the date and number of the deposit of the material at the institution;*

*(C) access to the material is available in the depository institution only after the date of the application of patent in India or if a priority is claimed after the date of the priority;*

*(D) disclose the source and geographical origin of the biological material in the specification, when used in an invention."*

(emphasis supplied)

39. It is important to note that the impugned order rejected the subject application on the ground of lack of inventive step on the basis of prior art document D1 and D5 and lack of sufficiency under Section 10(4)(a). However, it was found that the document D1 was published on 10.08.2006, while the present application was filed on 03.08.2006. Therefore, D1 cannot be cited in the present application. The cited document D1 pertains to "*METHOD AND SYSTEM FOR DETERRING PRODUCT COUNTERFEITING, DIVERSION AND PIRACY*". The D1 is primary prior art. The D5 is titled "*ELECTRONIC VERIFICATION MACHINE FOR VALIDATING A MEDIUM HAVING CONDUCTIVE MATERIAL PRINTED THEREON*", and pertains to the determination of the authenticity and integrity of different types of documents like lottery tickets, accomplished by using an electronic validation machine to compare data kept in electronic circuits printed on the document to the document data printed on the document. The learned AC rejected the subject application on the ground of lack of inventive step citing the prior Art D1 read with the D5, which discloses the use of scratchable coating for hiding the verification code. Therefore, in the absence of D1 the objection of lack of inventive step under Section 2(1)(ja) of the Act does not stand.

40. As discussed above, the CS, through the flow chart given under Figure 3A and 3B, discusses the different communication modes for sending the code from

the User to the data centre and the working of the present invention claimed under the subject application. The mode of communication disclosed under the CS is by Landline/WMM/Mobile phone/PDA/computer in the form of voice/fax/sms/mms/email/internet to the desired number, address or the website provided by the Data Centre. For clarity, the paragraph disclosing the above-mentioned communication mode is reproduced hereunder:

> *"Figure 3A and 3B is a flow chart that Illustrates different communication mode for transmittal of product Code from User to Data Centre The User will send communication to the Data Centre (Figure 3A) of the First and Second Code. Similarly it will also receive the information from the Data Centre regarding the genuineness of the product. This communication to the Data The User will send an electronic communication either by Landline/WMM/Mobile phone /PDA/computer in the form of voice/fax/sms/mms/email/internet to a predefined number/address/website provided by the Data centre."*

41. Here, the question arises whether the above mentioned disclosure regarding the Figure 3A and 3B is sufficient for transmission under the present invention. It is important to note that in order to implement the claimed invention, implementation details such as uniform processing, error handling, security etc. needs to be discussed.

42. Similarly, for the output from the Data Centre, the CS simply specifies that the "data centre will return a message" that the product is genuine or actual product produced by the producer it claims.

43. However, it is important to note that in order to execute the same, protocol, security, format, and delivery mechanism etc. need to be disclosed.

44. Additionally, the CS of the subject application does not disclose any other diagram. The CS does not include any diagram to illustrate the detailed system architecture and workflow describing the step by step verification procedure and authentication logics in order to execute the claimed invention. The Figure 2 as

discussed above is not sufficient. Apart from the above mentioned lack of disclosure, the CS also lacks the necessary information about the generation of visible and hidden codes. The CS does not disclose/illustrate the generation logic, metadata linkage and encryption safeguards etc.

45. Clause (a) to sub-section (4) of Section 10 of the Act specifies that the complete specifications of the invention, patent whereof is sought, must clearly and completely describe the invention apart from describing its operation or use and the method by which it is to be performed. The clause makes it apparent that not only the invention is to be described fully so as to enable the PSITA to assess the invention, but it must also clearly specify the process by which it operates or is put to use and additionally explain clearly the methodology by which such invention is proposed to be performed. After all, a patent of a claimed invention can be granted only if it can be put to practical usage.

46. That said, the question which arises in the present case is whether the PSITA is able to perform the disclosed invention without any further research/tests that go beyond routine trial. In the opinion of this Court, the answer would be negative. This is for the reason that some essential and relevant embodiments are missing, which would be required to guide the PSITA to implement the invention.

47. It is trite that in case the best method is known to the inventor, it must necessarily be disclosed. In the present case, though various modes of transmission of the two alphanumeric codes from the user to the server/Data Centre are provided, however, the best suitable method is conspicuous by its absence.

48. Before considering the question raised to the facts, it would be important to appreciate the law in respect of what would constitute "insufficiency of description". In ***Farbwerke Hoechst vs Unichem Laboratories And Ors., 1968***

***SCC OnLine Bom 118***, the court while evaluating what would constitute "insufficiency of description", emphasised that it has two branches, first, which comprises (i) the complete specification must describe "an embodiment" of the invention in question in each of the claims and; (ii) that the provided description must be sufficient to enable those in the industry concerned to implement it without their making further inventions. And the second branch requires that the description must be fair. In other words it must not be unnecessarily difficult to follow. The relevant paragraph of the decision is reproduced as under:

> *"13.* ***Dealing first with the ground of insufficiency of description it is stated in Halsbury, (3rd edn.) Vol. 29 p. 64 para 131 that the claim need only be as clear as the subject admits, and that a patentee need not so simplify his claim as to make it easy for infringers to evade it. It is further stated in that passage in Halsbury that the patentee's duty is not to prevent all possible argument as to whether there is or is not infringement in particular cases, but to enable the court to formulate the questions of fact to be answered. It is further stated in the same Volume of Halsbury (p. 66 para 138) that insufficiency of description has two branches, (1) the complete specification must describe "an embodiment" of the invention claimed in each of the claims and that the description must be sufficient to enable those in the industry concerned to carry it into effect "without their making further inventions"; and (2) that the description must be fair i.e. it must not be unnecessarily difficult to follow.*** *Turning first to claim No. 11 in the present case in the light of these principles, the reference in the body of the specification to "a conventional manner" of eliminating sulphur cannot really create any difficulty, and it is in fact unnecessary to import this from the body of the specification into claim No. 11 in view of the fact that claim in terms, being, wide enough to include all methods of eliminating sulphur. As stated earlier in this judgment, it is permissible to refer to the body of the specification only when there is some difficulty or ambiguity in the construction of a claim as it stands. In any event, Hydrogen peroxide as a desulphurising agent would be an obvious chemical equivalent of heavy metal oxides or a salt thereof in an aqueous or alcoholic solution which are also used for desulphurising in "a conventional manner". Moreover, the secret or discovery essential to the validity of the plaintiffs' invention, as claimed, and forming the very basis of it is not the method, but is the previously undiscovered fact of a new class of chemical compounds having hitherto unsuspected blood-sugar-lowering properties, twenty-one methods of synthesis of sulphonylureas being already known at the material time as is apparent from p. 27 of Kurzer's article on sulphonylureas and sulphonylthioureas in Vol. 50 of the Chemical Reviews (Ex. 1). There is no*

*evidence led by the defendants to show that the statement in the body of the specification that the synthesis of the desired sulphonylurea may be obtained by eliminating sulphur with a heavy metal oxide or a salt thereof in an aqueous or alcoholic solution would present any difficulty. The specification and claims are addressed to those with a high degree of knowledge of the field of science to which they relate, particularly when they relate to chemistry and allied subjects. It is not necessary to describe processes on the Claims to a specification when they are part of the common knowledge available to those skilled in the science who can, after reading them, refer to the technical literature on the subject for the purpose of carrying them into effect. "An embodiment" of the invention is, therefore, in my opinion, sufficiently described in the plaintiffs patent and that description is not unnecessarily difficult to follow, it being sufficient to enable the invention to be carried into effect "without making further inventions". As far as claim No. 1 is concerned, there are as many as 40 examples of it in the specification (Ex. A) and there would, therefore, be no difficulty in carrying the same into effect. The ground of insufficiency of description alleged by the defendants must, therefore, fail."*

(emphasis supplied)

49. It is important to note that the para 05.03.09(a) & (b) of ***"MANUAL OF PATENT OFFICE PRACTICE AND PROCEDURE" (Version 3.0, 26.11.2019),*** also requires the application to furnish the sufficient detail so as to give a complete picture of the invention. For better understanding, the said provision is reproduced below:

*"05.03.09 Detailed Description of invention*

*a) Description of an invention is required to be furnished in sufficient detail so as to give a complete picture of the invention and follows the Summary of invention. The nature of improvements or modifications effected with respect to the prior art should be clearly and sufficiently described. It may include examples/drawings or both for clearly describing and ascertaining the nature of invention. Examples must be included in the description, especially in the case of chemical related inventions.*

*b) Disclosure of invention in a complete specification must be such that a person of average skill and average knowledge in India should be able to perform the invention based on what is disclosed in the specification."*

(emphasis supplied)

50. In C.A.(COMM.IPD-PAT) 114/2022 titled **"*Titan Umreifungstechnik GMBH and Co. KG v. Assistant Controller of Patents and Designs & Anr.*"** decided on 02.05.2023, this Court while discussing the standards under Section 10(4)(a) of the Act, emphasised that while assessing the sufficiency of disclosure, the applicant must ensure that the best method for performing the invention is described. The applicant is primarily required to include a clear and complete description of the invention/its operation/use and method by which it is performed so that PSITA can reproduce the invention based on the description in the application. For better understanding, the relevant para is reproduced hereunder:

> *"8. The Court is however, not convinced by Mr. Chaudhary's submission. Clause 05.03.09 of the Patents Manual provides that the invention must be described in sufficient detail so as to give a complete picture of the invention and for this purpose, an applicant may include examples or drawings in the specification. While assessing the sufficiency of disclosure, it must be ensured that the best method for performing the invention known to the applicant is described.* ***The primary requirement is that the application includes a clear and complete description of the invention, its operation, use and method by which it is performed so that a person skilled in the relevant field can reproduce the invention based on the description in the application. The examples and drawings assist the Patent Office to ascertain the nature of invention. However, the question before Court is whether this condition is to be mandatorily followed in all applications.*** *As pointed out by Ms. Neha Chugh, counsel for Appellant, there is no mandatory requirement to provide examples for non-chemical related inventions. The clause extracted above stipulates furnishing of working examples as an essential condition only in case of chemical related inventions. Thus, although working examples can be beneficial in assessing the patentability of an application, they are not strictly necessary. Therefore, the*

*Controller's reliance on Clause 05.03.09 of the Patents Manual is flawed as Appellant's invention is not a chemical related invention. Indeed, a patent application can be refused if the invention is not sufficiently disclosed in the complete specification and in order to satisfy himself, the Controller could have asked the Appellant to prove that description in their claims is supported with workings; however, mere absence of working examples does not render the subject application liable for rejection. As per Section 10(4)(b) of the Patents Act, an applicant is required to disclose the best method of performing the invention known to them for which they are claiming monopoly. This requirement was fulfilled as the Appellant cited the best method of performing the invention in the complete specification. Instead of analysing the same, the Controller insisted on working examples in support of subject application and summarily rejected the claimed invention on the ground of Section 10(4) of the Patents Act, without elaborating on the reasons for arriving at such a conclusion. Therefore, refusal on this count is also not sustainable."*

(emphasis supplied)

51. The Madras High Court in C.M.A. (PT) No. 2 of 2024 titled ***"Caleb Suresh Motupalli vs Controller Of Patents"*** decided on 29.01.2025, if the CS lacks any technological enablement of the features in the claim, it is barred under Section 10(4)(a) of the Act. The relevant para is reproduced hereunder:

*"30. As for the working of the CNSOA as provided for in Claim Nos. 19, 24 and 30, the complete specification in Page 14, merely mentions the usage of standard "Object Oriented Analysis and Design" techniques for integration but glaringly lacks any teachings or working examples regarding its usage in achieving the integration as claimed.* ***Apropos the decussation of the pyramids, the description found in pages 16-17 of the complete specification contains an elaboration of the proposed decussation and biblical and natural element analogy but is devoid of any technological enablement of the features in the claim. For the aforementioned lack of technical criteria in the complete specification to work***

***the claims for achieving the intended result, the claimed invention fails the enablement test under Section 10(4)(a) of the Patents Act.***

(emphasis supplied)

52. It is indeed imperative to examine whether the CS fulfils the requirement of section 10(4)(a) of the Act. Although the CS provides for two alphanumeric codes for verification of the manufacturer as also the product to ascertain the genuineness of the product purchased by the User, however, lacks in clarity and complete description of the method by which the said alphanumeric codes are to be transmitted, for one, and the manner and methodology by which the said codes would be processed at the end of the Data Centre, for the other. From the CS, the amended claims, the Figures and Flow Chart it is apparent that the codes can be transmitted in one of the modes as provided (voice/fax/sms/mms/email/internet) to the Data Centre and the response received by the User by similar modes, however how the Data Centre is to process the information, having regard to the fact that it would be a digital information, is unknown and not specified. The transmission of alphanumeric codes to and from the Data Centre after processing is taken to be an aspect, left completely to the PSITA. Moreover, the CS also does not describe in proper detail how the secondary steps of processing the information and reversion of the "processed information" to the User. The description also lacks in detail as to how the "processed information" is to be stored by the Data Centre and further used for curbing misuse of the alphanumeric codes which have already been disclosed by fraudsters who may attempt several times after the first genuine entry to push through the counterfeit or infringing products. All these essential elements of the invention, for operation and/or use with the best method has not been

disclosed, and left for the PSITA to construe, hence the "insufficiency of disclosure" within the Section 10(4)(a) of the Act.

53. It is also important to note that the independent claim 1 also claims a "transmitter" to report back the results, and a "processor" to verify and match the received Product Code. On the other hand, as discussed above, no such disclosure is made in the specification. Therefore, in addition to the objection under Section 10(4)(a) of the Act as raised by the learned AC, the subject application is also barred under the Section 10(5) of the Act as it is not fairly based on the matter disclosed in the CS. The Madras High Court in ***Caleb Suresh Motupalli*** *(supra)* emphasised that the principle underlying the second part of the provision, the fair basing rule, requires that the disclosure under the specification must enable the invention in question to be performed to the full extent of the monopoly claimed. For better understanding the relevant paras are reproduced here:

> *"32.* ***Section 10(5) of the Patents Act requires the claims of the invention to be clear and succinct and to be fairly based on the matter disclosed in the specification.*** *Elucidating the rule of clarity and succinctness, the UK Court of Appeal in The General Tire & Rubber Company v. The FirestoneType and Rubber Company Limited and Others [1972] R.P.C. 457, posited that the rule requires the patentee to provide "as clear a definition as the subject matter admits of" and the question of definition has to be decided as a "practical matter" and the puzzles set out at the edge of the claim carry little weight.* ***The principle underlying the second part of the provision, the fair basing rule, was formulated in Biogen Inc v https://www.mhc.tn.gov.in/judis Medava Plc, [1997] R.P.C. 1. The rule requires that the specification must enable the invention to be performed to the full extent of the monopoly claimed. Further, in Van Der Lely, it was held that a claim covering an unimplementable or an unworkable embodiment is not fairly based on the specification.***
>
> *33. The impugned order has rejected the application under Section 10(5) on the ground that claims are lengthy, vague and do not represent a technical characteristic. In addition to the unintelligible wording of the claims and the specification, I find that the definition, i.e., the claims pertaining to persona-extension, augmentation, and black-box modernization when read along with the description, especially the paragraphs relating to DOT, middleware, Object*

*Oriented Analysis and Design in pages 13 and 14 of the complete specification, do not represent a workable embodiment for achieving the subject matter of the invention, i.e., persona extension, integration and a method for super-* *augmentation to manifest a pan-environment super-cyborg for global governance by way of wearing a necktie.* ***Therefore, I conclude that the claimed invention fails to meet the requirements of Section 10(5) of the Patents Act on grounds of ambiguity and failure to fairly base the claims on the disclosures in the complete specification.****"*

(emphasis supplied)

54. Hence claim 1 of the subject application is also barred under the Section 10 (5) of the Act.

55. Therefore, as discussed above, the description under the CS of the subject application is not sufficient to enable the PSITA to make the invention work. In the absence of the above-mentioned required information, the PSITA has to further research to make the claimed invention work. Apart from the description of the necessary information, the CS also lacks the figures and diagrams to understand the system architecture and workflow which bar it under the Section 10(4)(a) of the Act.

56. Therefore, based on the above discussions and judgement cited, this Court is of the view that the subject application suffers from an insufficiency of disclosure and a lack of adequate direction provided by the inventor.

57. In view of the aforesaid, the appeal is dismissed alongwith pending applications, if any.

**TUSHAR RAO GEDELA**
**(JUDGE)**

**MAY 11, 2026**/*anj/rl*