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IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON	PRONOUNCED ON
14.07.2026	18.11.2026

CORAM

THE HON'BLE MR.JUSTICE K.KUMARESH BABU

CMA(PT) No. 40 of 2023

Omega SA
Jakob-Stampfli-Strasse 96,
CH-2502,
Biel/Bienne, Switzerland

..Appellant(s)

Vs

The Controller of Patents & Designs,
Government of India, Patent Office Chennai,
Intellectual Property Rights Building,
G.S.T.Road, Guindy,
Chennai – 600 032.

..Respondent(s)

PRAYER:- Civil Miscellaneous Appeal filed under Section 117A of the Patents Act, 1970 against the order of the respondent, dated 12.06.2023. The order was passed rejecting the grant of patent to the Appellant in respect of Patent Application No.5932/CHE/2013.

For Petitioner(s): Mr.Rahul Balaji

For Respondent(s): Mr.A.R.Sakthivel (SPCGSC)

JUDGMENT

The present Civil Miscellaneous Appeal has been filed to call for records of the Respondent culminating in the Impugned Order dated 12.06.2023 rejecting the Grant of Patent and Set Aside the same and to direct Grant of the Patent in respect of the Appellant's Application No. 5932/CHE/2013.

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2. The facts giving arise to the instant Appeal is that the Appellant who is a well known Swiss Luxury Watchmaker represented herein by its authorized Power Agent, had filed a filed an application in Application No.5932/CHE/2013 dated 18.12.2013 before the respondent, the Controller of Patents, seeking registration of its invention for the grant of Patent. The application *supra* contained about 30 claims in respect of an invention titled "*Decorative piece Produced by setting on Amorphous Metal*" (hereinafter referred to as 'present invention'). The First Examination Report (FER) had been filed on 20.06.2019, wherein *inter-alia* it had stated that the present invention is Non-Patentable for the lack of Inventive Step. Thereafter the response to the FER from the appellant was received on 18.03.2020 and subsequently hearing letter was issued on 13.01.2023, wherein the objections were communicated and the hearing was conducted. Consequently, the Respondent, *vide* order dated 12.06.2023, rejected the grant of the Patent, *inter alia*, on the ground of the objections recorded therein and held that Claims 1 to 30 lacked inventive step and were obvious to a person skilled in the art in view of the teachings of the cited prior-art documents, namely documents D1 to D4. Aggrieved by the aforesaid order dated 12.06.2023, the Appellant had filed the present Appeal seeking to set aside the said impugned order and grant patent to present invention.

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3. Heard Mr.Rahul Balaji, learned counsel appearing on behalf of the Appellant and Mr.A.R.Sakthivel learned Senior Panel Counsel for Central Government appearing on behalf of the sole respondent.

4. Mr.Rahul Balaji, learned counsel appearing on behalf of the appellant submits that the present invention had been based upon novel and inventive which has also been claimed on United Sates of America, Europe, Korea, Russia, China, Hong Kong, Japan and Germany. He submits that prior arts documents D1 to D4, which were cited in the Hearing Notice as the base of refusal of patent application, were also considered in the corresponding proceedings in USA. Similarly documents D1, D3 and D4 were considered in the European proceedings. Both the USA and Europe proceedings had granted the patent publication for the present invention. He submits that the present invention relates to a decorative piece and its production method which allows setting of an aesthetic element on a piece made of materials which do not have sufficient plastic deformation. He further submits that the inventive step of the present invention lies in setting an aesthetic element on a support lacking a plastic deformation by introducing in between a partially amorphous alloy.

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5. The learned counsel submits that the prior Art document D1 discloses an invention that is entirely made of amorphous alloy comprising of precious metals as a form of jewellery which does not disclose any of the features of the present invention. He further submits that the respondent had considered the prior art D1 as the most-closest prior art which had been held as a non-relevant prior art in the corresponding European Application. He also submits that the prior Art D2 does not relate to the present invention but merely pertains to a physical mechanism by which an aesthetic element may be held in place. He also submits that the D3 relates to integrating aesthetic elements, such as enamel, into a support by hot-forming, which has no relevance to the present invention. The learned counsel further submits that the respondent in its impugned order, has failed to provide any reasons with regard to the relevance of the Prior Arts D2 and D3 to the present invention. It is further submitted that prior Art D4 is of the same patent family as that of D1 and is substantially the same prior art dealing with the same subject matter. Therefore citing both the D1 and D4 as independent Prior Arts constitutes a double Citation which indicates the lack of diligence on part of the respondent.

6. He vehemently contends that the respondent had failed to consider the materials on record properly and has erroneously concluded that by applying the teachings of the D1 in combination of the Prior Arts D2 to D4, a person skilled

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in the art (hereinafter referred to as 'PSITA') can arrive at the Claim No.1 of present invention and therefore arriving at the conclusion that the present invention lacks inventive step as per the section 2(1)(ja) of the Patents Act, 1970 (hereinafter referred to as 'the Act'). In this regard, with respect to both inventive step and PSITA, the learned counsel places reliance upon the judgments made by this court in the cases, namely, ***AB Initio Technology LLC Vs Controller of Patents and Design*** reported in ***2025 SCC online Mad 15082***, ***Rhodia Operations Vs. Assistant Controller of Patents and Designs*** reported in ***2024 SCC Online Mad 309*** and ***Microsoft Technology Licensing LLC Vs Assistant Controller of Patents*** reported in ***2024 SCC Online Mad 285.*** He further submits that the respondent without taking due cognizance of the Prior Arts D2 and D3 had relied upon the Prior Art D1 alone to arrive at the said conclusion, thereby evincing that the respondent had engaged in the hindsight analysis. In regard of such hindsight analysis, reliance has been placed upon the Delhi High Court's judgment made in the case of ***Lava International Vs Telefonktiebolaget LM Ericsson*** reported in ***2024:DHC:2698***.

7.The learned counsel submits that the Respondent failed to adjudicate the Appellant's Patent Application in accordance with the principles laid down by the Hon'ble Apex Court in the judgment in ***Bishwanth Prasad Radhey Shyam Vs Hindustan Metal Industries Ltd***, which was further reaffirmed in

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F.Hoffman La Roche Vs Cipla, wherein a five-point test was laid down for determining lack of inventive step, which the Respondent failed to apply. The learned counsel submits that the refusal of the patent under the section 3(d) of the Act, which deals with the '*known substance'*, is inapplicable to the present invention. The learned counsel further submits that the refusal under Section 3(e) of the Act, which deals with substance obtained by a mere admixture, is inapplicable to the present invention, as the decorative piece cannot be produced merely by placing the aesthetic element, wearable object and amorphous alloy together. He further submits that Section 3(f), which excludes mere arrangement or re-arrangement of known devices functioning independently in a known manner, is equally inapplicable, as the element, amorphous alloy and support are interdependent and cooperate to form the decorative piece. He further submits that apart from the independence of functionality under the sec 3(f) of the Act, the present invention further satisfies the commercial significance which is another factor. Hence the learned Counsel submits that the refusal of the appellant's patent application under section 3(e) and (f) of the Act, ought to be negated. The learned counsel further contends that the claims 15-31 under the patent application of the appellant ought to be read with the as a whole with all its claims and specification, which results in the present invention. Therefore it is illogical to state that the claims under the patent application lacks unity of invention as required under section 10(4)(2) or section 10(5) of the Act, after taking into consideration of the claims in-part manner. He also submits that

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without prejudice to the other submissions, for the sake of the argument assuming the technical advancement of the present invention, would still satisfy the requirement of the "inventive step" under section 2(1)(ja) of the Act. In this regard reliance has been placed upon the judgment of Hon'ble Delhi High Court in the case of ***Avery Dennison Vs Controller of Patents and Design***. In view of the above the learned counsel submits that the impugned Order dated 12.06.2023 made by the respondent suffers from non-application of mind and several inconsistencies, apart from devoid of reasoning which warrants intervention of this court. Accordingly prays this court to allow the present Civil Miscellaneous Appeal.

9. *Per Contra*, countering the above arguments, Mr.A.R.Sakthivel learned Senior Panel Counsel for Central Government appearing on behalf of the respondent would submit that the impugned order dated 12.06.2023 issued by the Respondent is in accordance with the well-established principles of law, having been passed after hearing the Appellant, considering the submissions made and the objections raised in the hearing notice. He further submits that, notwithstanding the grant of patent for the present invention in other countries, the provisions of the Indian Patents Act differ in certain respects. In particular, the subject matters such as use claims of known devices, mere arrangements or re-arrangements and substances obtained by mere admixture resulting in an

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aggregation of properties, may be patentable in other jurisdictions, but are expressly excluded from patent protection in India under Section 3 of the Act.

10. The learned counsel further submits that the appellant during the submission of hearing submitted that the claim No.1 of the Patent application teaches about a decorative piece, wherein setting an aesthetic element on a support which do not have plastic deformation by introducing an at least partially amorphous alloy in between. He submits that the Prior art D1 teaches an article of jewellery (decorative piece) with amorphous alloy and also teaches gemstones (aesthetic element) casted in the amorphous alloy, which is the same technical effect of the subject matter claim No.1 of the appellant. It is also submitted that the said decorative piece might be any items, such as jewellery, watches, cell phones, etc. He further avers that the Prior Art D2 deals with the conical trapezoid as shown it the documents therein, D3 teaches about a decorative piece in which support was made of amorphous material and D4 teaches jewellery with a gemstone. The learned counsel vehemently contends that by applying the teachings of the prior art document D1, namely, use of the amorphous alloy for retaining the aesthetic element securely as shown in the prior art documents D2 to D4, a person who is skilled at art without being inventive can easily arrive at the claims of the Appellant. In view of the *supra* the respondent had rightly held that the patent application pertaining to the

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present invention of the appellant was rightly denied the grant of patent on the basis lack of inventive step under the section 2(1)(ja) of the Act.

11. It is submitted that the subject matter of the present application relates to a decorative piece having at least one hollow or catching means for holding a diamond or other aesthetic element. The learned counsel contends that the method of setting such an aesthetic element in a decorative piece is a known arrangement, as commonly seen in watches, pens, pandels and similar articles. Such type of aforementioned arrangement falls within the scope of section 3 of the Act which deals with 'What are not inventions'. He contends that the claims 15-31 of the present application teaches about well known method of setting gem stones, namely, diamond, pukaraj, etc in different types of decorative pieces, namely, rings, pendant or other type of decorative pieces which falls under the scope of section 3(d) of the Act. The learned counsel further submits that the invention lies not in the product, namely, the decorative piece, but in the step of setting the aesthetic element on the support. He contends that such a process amounts to a mere admixture, resulting only in an aggregation of the properties of the components and therefore falls within the scope of Section 3(e) of the Act. Therefore the learned counsel submits that the impugned order dated 12.06.2023, issued by the respondent, rejecting the Grant of Patent with respect of the Appellant's Application No. 5932/CHE/2013 has been rightly made and

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does not warrant any intervention from this court. Accordingly he prays the dismissal of the present Civil Miscellaneous Appeal.

12. I have considered the submissions made on either side and perused the materials placed on record.

13. A claim for invention relating to a decorative piece to support atleast one aesthetic element was made and the same has been rejected with reference to prior cited documents D1 to D4. The order of rejection also comprises reasons that the said invention in conjunction with prior art cited documents would be obvious to a person skilled in the art and hence, cannot be claimed to be an invention. It is the claim of the appellant that the prior art cited documents D1 to D4 are similar documents, which deal with the invention relating to an amorphous alloy, which comprises of precious metals as a form of jewellery. It is the contention of the appellant that prior art D2 relates to a physical mechanism by which an aesthetic element may be held in a place in a decorative piece. It is the further contention that prior art D3 relates to an integrative of aesthetic element by a support of hot-forming.

14. On the contrary, it is the claim of the respondent that D1 teaches a usage of amorphous alloy for placing an aesthetic element, D2 deals with the

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manner in which such element is being placed. According to the respondent, D3 document teaches a decorative piece in which a support is made using amorphous materials and D4 teaches a jewellery with gemstones.

15. Under the impugned order, document D1 was understood to be teaching an article of jewellery of placing a gemstone casted in the amorphous alloy, which according to the respondent, is same as the claim No.1 made by the appellant as it involves the same technical effect of the subject matter under D1. Hence, it is obvious to a person skilled in an art.

16. A reading of claim No.1 which is sought to be rejected as a non-inventive step would disclose that the claim of the invention was a decorative piece which comprises of a support with a material which do not include plastic deformation placed in one hollow, which is being filled with a material being atleast partially amorphous alloy to hold an aesthetic element to be kept in place by a catching means. Even under the impugned order, it is the respondent's finding that the technical effect of claim No.1 is the same under document D1. Admittedly, D1 teaches an article of Jewellery with an amorphous alloy in which a gemstone is a casted.

17. On the other hand, claim No.1 supposes a placement of a gemstone on

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an amorphous alloy which do not include a plastic deformation in hollow and in that regard, the prior art document D1 cannot be said to be teaching a prior art as claimed by the respondent.

18. The understanding of the respondent with regard to prior art document D2 is that it teaches a method of manufacturing a decorative item comprising of jewel consisting of crown part in a pyramid trapezoid and a pavilion part in a conical shape which acts as a retaining tool and the claw of the retaining tool consisting of at least three claws to hold the gemstone, whereas the claim of invention is setting of the gemstone on a partially amorphous alloy which is placed in a hollow space and is held by a casing. Hence, the teaching under prior art D2 can be safely said to be not the same invention as claimed by the appellant.

19. As regards prior art D3, the understanding is that the decorative element is made to be held by a inlaying process through hot-forming. No such process has been claimed by the appellant and in that regard reliance placed upon the prior cited document D3 was also improper.

20. The understanding of the respondent over prior cited document D4 was that it discloses that the jewellery made on precious amorphous alloy

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metals and method of making such article comprising the fabrication and finishing of jewellery articles. The claim made under the present invention was a partial amorphous alloy which did not use the precious metals and in that regard, reliance placed upon D4 document is also wholly improper.

21. The further reasonings assigned that the combined reading of prior cited document D1 to D4 would make it obvious to a person skilled in the art to conceive such an invention is also not supported by the reasonings as to how a person skilled in the art would be able to conceive such an invention. As discussed above, prior art document D1 to D4 do not have any relation to the claimed invention art and none of the prior cited art is based upon a partially amorphous alloy and in that regard such finding is also perverse. It is to be noted that the claim was also approved by the authorities and patent had been granted in USA and Europe. Even though the same was sought to be contested by the respondent that the requirements under the Indian Patent Law to substantiate an invention is more rigorous than the other countries, the impugned order do not spell out such rigour or the distinction between the foreign and Indian law to refuse the registration. In that regard, this Court is of the view that the impugned order is liable to be interfered with.

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22. In fine Civil Miscellaneous Appeal stands allowed, the impugned order is set aside and the respondent is directed to grant patent registration for the invention claimed. However, there shall be no order as to costs.

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Index: Yes/No
Speaking/Non-speaking order
Neutral Citation: Yes/No
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To

The Controller of Patents & Designs,
Government of India, Patent Office Chennai,
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