IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **25.03.2025**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT)/1/2024

Robert Bosch Limited
Via Anhanguera, KM 98,
Vila Boa Vista 13064-900-
Campinas – SP Brazil ... Appellant

-vs-

The Deputy Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai 600 032. ... Respondent

PRAYER: Civil Miscellaneous Appeal (Patents) is filed under Section 117-A of the Patents Act, 1970, praying that the impugned order passed on 7 August 2023 by the respondent refusing the grant of Patent to the appellant and the appellant submits that the impugned order passed by the respondent in Indian Patent Application No.201944047460 suffers from non application of mind, illogical reasoning and arbitrariness and the impugned order was passed without appreciating all the evidence placed on record and hence is

liable to be set aside.

For Appellant : Mr.Hethav Ramkumar
for M/s.Rahul Balaji

For Respondent : Mr.V.T.Balaji, SPC

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JUDGMENT

This appeal is directed against the order dated 07.08.2023 rejecting Patent Application No.201944047460 for grant of patent for an invention titled "Method of Preheating and Controlling the Temperature of Fuel injected into a Combustion Engine". Upon request from the appellant, respondent issued First Examination Report (FER) dated 14.10.2020. In the FER, objections were raised on grounds for lack of novelty and inventive step by citing prior art documents D1 and D2. In addition, by referring to Section 3(d) of the Patents Act, 1970 (the Patents Act), it was recorded that claims 1 to 6 are excluded from patent protection in terms thereof. The appellant responded to the FER on 29.04.2021. This was followed by multiple hearing notices. In hearing notice dated 02.01.2023, the respondent maintained the objection on the

ground of lack of inventive step. Pursuant to a hearing on 30.01.2023, the appellant filed written submissions on 13.02.2023. The impugned order was issued in the above facts and circumstances.

2. By inviting my attention to the impugned order, learned counsel for the appellant submits that the patent application was eventually rejected solely on the ground that it is excluded from patent protection under Section 3(m) of the Patents Act. He further submits that the claimed invention does not fall within the ambit of Section 3(m).

3. In response to these contentions, learned counsel for the respondent reiterates the findings in the impugned order and states that the claimed invention is in respect of a method claim and is theoretical in nature. Therefore, he contends that no interference is warranted.

4. The current claims of the appellant consist of six claims, namely the above extracted independent claim and 5 dependent claims. In order to decide whether the conclusions in the impugned order call for interference, it

is first necessary to set out independent claim 1, which is as under:

"1. A method of preheating and controlling a temperature of fuel injected into a combustion engine (8), the combustion engine (8) comprising:

an engine control unit (9) in the combustion engine (8),

at least one fuel-heating device (3) positioned in contact with fuel;

at least one fuel-heating control unit (6) connected by means of at least one data connection to the engine control unit (9), and the at least one fuel-heating control unit (6) electrically connected to the at least one fuel-heating device (3), where the at least one fuel-heating control unit (6) controls operation of the at least one fuel-heating device (3);

the method characterized by comprising the successive steps of:

turning on the heating system;

measuring an initial temperature of the fuel (t_{inc}) upstream of the at least one fuel-heating device (3) with a first sensor;

measuring an ambient temperature (t_{amb}) with a second sensor;

reading a target temperature of pre-heated fuel (t_{pre}) downstream of the at least one fuel-heating device (3);

comparing, via the engine control unit (9), the initial temperature of the fuel (t_{inc}) upstream of the at least one fuel-heating device (3) with the target temperature (t_{pre}) of the pre-heated fuel;

calculating, via the engine control unit (9), a preheating power (p_{pre}) required to be applied to the at least one fuel-heating device (3) so that the at least one fuel-heating device (3) heats the fuel to the target temperature (t_{pre});

applying the preheating power (p_{pre}) to the at least one fuel-heating device (3), the application of the preheating power (p_{pre}) being controlled by the at least one fuel-heating control unit (6);

measuring the temperature of the fuel (t_c) downstream of the at least one fuel-heating device (3) with a third sensor;

comparing, via the engine control unit (9), a temperature of the fuel (t_c) downstream of the at least one fuel-heating device (3) with the target temperature (t_{pre}) of the pre-heated fuel;

enabling,via the engine control unit (9), the startup of the combustion engine (8) when the temperature of the fuel (t_c) downstream of the at least one fuel-heating device (3) is greater than or equal to the target temperature of the preheated fuel (t_{pre}), the startup of the combustion engine (8) having been initially disabled;

reading a target temperature of the fuel (t_a) downstream of the at least one fuel-heating device (3);

comparing, via the engine control unit (9), the temperature of the fuel (t_c) downstream of the at least one fuel-heating device (3) with the target temperature of the fuel (t_a) downstream of the at least one fuel-heating device (3);

calculating, via the engine control unit (9), a power (p_{aq}) necessary to be used in the at least one fuel-heating device (3);

applying the power (P_{aq}) to the at least one fuel-heating device (3) controlled by the at least one fuel-heating control unit (6); and

comparing, via the engine control unit (9), the temperature of the fuel (T_c) downstream of the at least one fuel-heating device (3) with the target temperature of the fuel (Ta), and

thereby (i) providing preheated fuel prior to enabling the startup of the combustion engine (8) and thereafter (ii) providing comparison of the temperature of the fuel (T_c) to the target temperature of the fuel (T_a).”

5. The impugned order, in relevant part, is as under:

> *"Decision: The applicant has not developed any part in the fuel system but developed a method of controlling temperature of the fuel before injecting it into the engine in order to raise the efficiency of the engine. The applicant has only developed a methodology but not carried out any modification in the already existing working of the engine. According to him if we can preheat the fuel (based on the temperature difference between fuel in the engine and outside temperature) to a desired temperature, we can increase the efficiency of the engine.*
> *It **may be** the by following step of instructions of the alleged invention one can achieve desired / enhanced efficiency of the fuel engine. Hence industrial applicability may be there, but for getting patent Applicant is not making any product. The method he is claiming is merely theoretical in nature and not getting any product out of this. So Patent application No.201944047460 is being refused u/s 15 read section 3(m) of the Patent Act1970."*

6. On closely examining the operative portion of the impugned order, it follows that the claim was rejected on the ground that it is a pure method claim and does not result in a product. The impugned order also records the conclusion that the claimed invention is excluded from patent protection under Section 3(m) of the Patents Act.

7. Section 3(m) is as under:

"(m) a mere scheme or rule or method of performing mental act or method of playing game."

As is evident from the text thereof, Section 3(m) is intended to exclude the following: mere scheme of performing a mental act; mere rule of performing a mental act; mere method of performing a mental act; or method of playing a game. If the construction placed on Section 3(m) by the respondent is to be accepted, all method claims will stand excluded under Section 3(m). The Patents Act extends patent protection not only to product claims but also to process claims. Upon examining the independent claim 1, it pertains to a method of pre-heating and controlling the temperature of fuel injected into a combustion engine. The method claim is in respect of a claimed inventive process comprising a series or sequence of steps, and cannot be characterized as a mere method of performing a mental act. Therefore, it clearly does not fall within the scope of Section 3(m) of the Patents Act.

8. As noticed earlier, in the hearing notice, an objection in respect of lack of inventive step was maintained. Consequently, notwithstanding the conclusion on Section 3(m), the respondent should examine whether the

claimed invention involves an inventive step. Therefore, a remand is necessary.

9. For reasons set out above, impugned order dated 07.08.2023 is set aside and the matter is remanded for re-consideration on the following terms:

(i) In order to preclude the possibility of pre determination, an officer other than the officer who issued the impugned order shall undertake re-consideration.

(ii) Such re-consideration shall be on the basis of objections, other than the objections under Section 3(m), which were maintained in the hearing notice.

(iii) After providing a reasonable opportunity to the appellant, a reasoned decision shall be issued within a period of ***four months*** from the date of receipt of a copy of this order.

(iv) For the avoidance of doubt, it is made clear that no observations

have been made on the merits of the patent application, except to the limited extent indicated in the order.

10. CMA(PT)/1/2024 is disposed of on the above terms without any order as to costs.

25.03.2025

rna
Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No

To

The Deputy Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai 600 032.

SENTHILKUMAR RAMAMOORTHY,J

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