

OD-11

IN THE HIGH COURT AT CALCUTTA
Special Jurisdiction
ORIGINAL SIDE

AID/6/2022

I. M. A. INDUSTRIA MACCHINE AUTOMATICHE S. P. A.
VERSUS

THE CONTROLLER OF PATENTS AND DESIGNS

BEFORE:

The Hon'ble JUSTICE RAVI KRISHAN KAPUR

Date : 22nd July, 2022.

Appearance:
Mr. S. Majumder, Adv.
Mr. Paritosh Sinha, Adv.
Mr. K. K. Pandey, Adv.
Ms. Mitul Dasgupta, Adv.
Mr. S. Sen, Adv.
Ms. E. Saha, Adv.

The Court: This appeal is directed against an order dated 19th January, 2022 (the impugned order) passed under Section 15 of the Patent Act, 1970 ("the Act") whereby the patent application being No. 2669/KOLNP/2012 filed by the appellant has been rejected by the respondent.

The operative portion of the impugned order is as follows:

"Considering documents DI: US7134258B2; D2: WO2007013991A2; D3: WO2003105324A1 and D4: EP0708028A1. in combination, present application for patent lacks of in inventive step still stands as the applicant fails to persuade the same. Features of current amended claims are not inventive over cited documents as above and are not an invention u/s 2(1) (ja) of the Act.

Hence present alleged invention cannot be considered as inventive as it has not made any significant technical advancement in the field over the cited documents as above."

Briefly, the appellant is a manufacturer of packaging materials. The appellant was established in 1961 and is a world leader in the design and manufacture of machines in the processing and packaging industry. Pursuant

to extensive research by the appellant, it is alleged that the appellant had caused an invention ("the invention") which relates to a transporting apparatus for packaging of goods. The application follows an international application whereby the appellant has obtained registration of its patent in a number of international countries (Italy, China, Japan, U.S.A and Europe). Thus, the national phase of registration is merely an extension of the international phase and all the documents forming part of the international phase form part and parcel of the national application.

The key elements of construction of the invention are as follows:

- (1) Guide means for supporting and guiding along a movement path
- (2) At least one carriage supporting a support element for receiving objects,
- (3) Movement means for moving the carriage along the movement path, and
- (4) Rolling elements are provided in the carriage.

It is also contended that the main advantages of the invention are the following:

- (i) The precision of movement of the carriers is improved as a result of which the transportation carriages and can be assembled as well as disassembled rapidly in a simple and perfect manner.
- (ii) The arrangement of the rolling elements with respect to the guides helps remove the clearance between the carriages

and the guide which enhance operating precision and stability.

- (iii) The conditions are particularly critical for the packaging of pharmaceuticals, cosmetics, food where at some point of time, in the packaging line, the products are exposed and are prone to contamination before the products are packaged whether in bottles, vials or strips.
- (iv) The construction of the apparatus is simpler, less expensive than the known carriages and does not need precise construction and adjustment of steering elements in order to eliminate clearances and ensure the necessary operating precision besides increased movement precision and flexibility.”

By the impugned order, the respondent under Section 117A of the Act read with Rule 15 has rejected and refused to grant the patent in favour of the appellant. The primary challenge in this appeal is to the fact that the impugned order does not records any reason whatsoever. The application has been rejected primarily on the ground of lack of inventive steps/obviousness.

In a decision reported in 2007(4) CHN 712 (*Uniworth Resorts Limited and Ors. Vs. Ashok Mittal and Ors.*), a Co-ordinate Bench of this Court had held as follows:

‘Judicial orders of such nature need to meet the twin tests of “Why” and “What”. It is the “why” that sustains the “what”, Reasons are the safeguard, against the ipse dixit of the decision-making process. They discuss how the judicial mind has been applied to the matter in issue and convey the nexus between the matters that have been considered and the conclusion based thereon. The justification and the reasonableness of a conclusion depend on the reasons given

in support thereof. The order impugned has no element of “why” for the “what” therein to stand on.’

It appears that the impugned order records the submission and claims made on behalf of the appellant but fails to deal with any matter of substance which had been raised by the appellant. I also find that there is a mere reproduction of Notes of Arguments filed on behalf of the appellant without dealing with the merits of the same. The impugned order merely sets out the amended claims alongwith prior published documents referred to in the selective passages and there is a mechanical reproduction in support of the conclusion of obviousness arrived at in the impugned order.

The impugned order also does not consider any of the decisions cited on behalf of the appellant. The appellant had cited a number of authorities relating to the test of obviousness/inventive steps. I find that none of these authorities have been dealt with or even considered in the impugned order.

It is elementary that the impugned order must speak for itself and cannot be supplemented by the Note of Submissions filed by the respondent which do not reflect in the impugned order. Hence, no reliance can be now placed on the Note of Submissions filled by the respondent.

In view of the aforesaid, I find that there is complete absence of reasons in the impugned order. Hence the impugned order is set aside. The matter is remanded back to the respondent with a direction to dispose of the same after hearing the parties on merits and after giving reasons. The entire exercise is to be completed within a period of eight weeks from the date of communication of this order.

It is submitted on behalf of the appellant that the modality for online hearing before the respondent authority is ineffective since the same does not last for more than a brief period and is not suitable for hearing of such matters.

In view of the aforesaid, the respondent is requested to consider the prayer and request of the appellant for a personal hearing.

It is also made clear that the respondent shall adjudicate upon the merits of the application without being influenced by any observation or finding in this order insofar as the merits of the case are concerned.

With the aforesaid directions, AID/6/2022 stands allowed.

(RAVI KRISHAN KAPUR, J.)