

IN THE HIGH COURT AT CALCUTTA  
ORIGINAL SIDE  
(Intellectual Property Rights Division)

IPDAID/29/2024

NISSAN MOTOR CO. LTD.  
VS  
THE CONTROLLER OF PATENTS AND DESIGNS AND ANR.

Before:  
The Hon'ble Justice RAVI KRISHAN KAPUR  
Date: 17<sup>th</sup> March 2025

*Appearance:*  
*Ms. Vindhya S. Mani, Adv.*  
*...for appellant.*

*Mr. Indrajeet Dasgupta, Adv.*  
*Ms. Priti Jain, Adv.*  
*...for the Controller*

The Court: This is an appeal under Section 117A of the Patents Act 1970 directed against an order dated 11<sup>th</sup> March 2021, passed by the respondent authorities rejecting patent application number 3623/KOLNP/2013 dated 11<sup>th</sup> December 2013.

The primary ground on which the application has been rejected is under section 2 (1)(ja) of the Act for lack of inventive steps.

The brief summarization of the prosecution history of the proceedings before the respondent authorities is set out below:

|            |                                                                                                                                          |
|------------|------------------------------------------------------------------------------------------------------------------------------------------|
| 11.12.2013 | Filing of Indian patent application on 11.12.2013, claiming priority from Japanese patent application no. JP2011109145 dated 16.05.2011. |
| 03.08.2018 | FER issued by Respondent No. 1 citing prior arts D1,D2,D3 & D4.                                                                          |
| 17.01.2019 | Response to FER filed by Appellant along with amended claims 1-3.                                                                        |
| 03.12.2020 | Hearing Notice issued by Respondent No. 2, scheduling hearing on 08.01.2021, citing prior arts D5, D6, D7[same as D4] & D8.              |
| 23.02.2021 | Written Submissions filed by Appellant.                                                                                                  |
| 11.03.2021 | Impugned order passed by Respondent No. 2 citing prior arts D5,D6, D7 & D8.                                                              |

The primary ground on which the appellant assails the impugned order is violation of the principles of natural justice and the prior art being published post the priority date of the subject application. It is submitted on behalf of the appellant that in passing the impugned order, the respondent no. 2 failed to appreciate the subject patent. It is also contended on behalf of the appellant that there has been no consideration of the submissions made by the appellant.

On behalf of the respondent authorities, it is fairly submitted that in passing the impugned order, the respondent no. 1 erroneously considered the prior art D5 and D8 despite the same having been published subsequent to the subject patent application being filed and as such no reliance could be placed on the same.

In view of the submissions made on behalf of the parties, the impugned order is unsustainable and is set aside on the ground of misplaced and erroneous reliance in treating the document D5 and D8 as a prior art.

Neither D5 nor D8 could be treated as prior art documents for assessing patentability as the date of publication was admittedly after the priority date of the subject patent. Consequently, both D5 and D8 were inadmissible under section 11 of the Act. This also reflects non application of mind by the respondent no.1. The respondent no.1 mechanically and without any application of mind has passed the impugned order. For the above reasons, the entire premise of the impugned order is erroneous and inherently flawed. (*Strix Ltd. vs. Maharaja Appliances Ltd. 2023 SCC OnLine Del 6763*).

In view of the above, IPDAID No. 29 of 2024 stands allowed.

The impugned order is set aside. The matter is remanded to the Controller to be heard positively within a period of eight weeks from the date of communication of this order and after giving a right of hearing to all the parties.

It is made clear that there has been no adjudication on the merits of the case and all questions are left open to be decided in accordance with law.

In view of the instructions forwarded to the Advocate appearing on behalf of the respondent authorities which have been produced in Court i.e. "The patent application was refused consideration the document *D5* as a closest prior art, if the document *D5* is omitted from the patent examination procedure the decision would have been based upon the rest of the relevant cited documents (*D6* & *D7*) and in omission of the document *D5*, document *D6* would become the closest prior art." In view of the above instructions, the matter cannot be remanded to the same Hearing Officer. Such an exercise would be an idle formality.

It is obvious that the concerned Officer has proceeded with a preconceived mind. Accordingly, the Controller is directed to reassign this matter to a different Hearing Officer.

All points on the merits are left open to be adjudicated afresh. The above exercise is to be completed within eight weeks from the communication of this order to the Controller.

(RAVI KRISHAN KAPUR, J.)

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