

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

IPDAID/38/2024
[OLD NO AID/19/2022]

DAIKIN INDUSTRIES LTD
VS
UNION IF INDIA AND ORS

Before:
The Hon'ble Justice RAVI KRISHAN KAPUR
Date: 26th February 2025

Appearance:
Mr. Adarsh Ramanujan, Adv.
Ms. Sonal Mishra, Adv.
Mr. Suryaneel Das, Adv,
Mr. Aditya Mondal, Adv.,
Ms. S. Dey, Adv.
...for appellant.
Mr. Indrajeet Dasgupta, Adv.
Ms. Priti Jain, Adv.
...for respondent.

The Court: This appeal is directed against an order dated 22 October, 2021 whereby an application for grant of patent being 1481/KOLNP/2014, titled "AIR CONDITIONING APPARATUS" has been rejected on the ground of lack of inventive steps *inter-alia* under section 2(1)(ja) of the Patents Act, 1970.

Significantly, the subject invention had been granted patent registration in over seven different countries after fulfilling all necessary pre-conditions.

It is contended on behalf of the appellant that the impugned order is unreasoned, cryptic and unsustainable.

A perusal of the impugned order reflects that the Controller in passing the impugned order has relied on five prior arts labelled D1-D5 which have been mechanically reproduced without any discussion as to how any of the prior arts are relevant or germane insofar as the subject product is concerned. Significantly,

D5 was never mentioned in the FER. It was introduced as a new document in the hearing notice dated 14 June 2021. The procedure followed in passing the impugned order is not only contrary to the Act but also in violation of the principles of natural justice.

The relevant portion of the impugned order concluding that the subject application lacked inventiveness is reproduced below :

“Therefore, it would have been obvious to the person skilled in art to impart the technical features of D5 D3, D4 and D1 such as heat exchanger body of the aluminum heat exchanger with plate fins has a meandering heat exchanger tube and a straight tube portion thereof when viewed from the front”

“Considering documents DI: JP2009092274A; D2: WO2012120554A1; D3: JPH03211398A; D4: JP2009068785A and D5: JPH04359797A 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.”

A bare perusal of the impugned order suggests that there has been no discussion of the facts and circumstances of the case and the impugned order simply reproduces the prior art documents without any independent application of mind. The identical reproduction of the contents of the prior arts by the Controller reflect non-application of mind and has been passed without furnishing any reasons.

In *Toyo Engineering Corporation & Anr. vs. The Controller General of Patents, Designs and Trade Marks & Anr. [AID/ 17/2022]*, this Court has held as follows:

“I find from the impugned order that the conclusion arrived at by the Controller does not contain any reasons whatsoever. The impugned order takes into consideration certain documents but does so in a cursory and casual manner.

Orders of such nature need to meet the twin tests of "why" and "what". It is the "why" which sustains the "what". Reasons are the safeguard against the ipsi dixit of the decision-making process. They discuss how the mind has been applied to the matter in issue and convey the nexus between the matters which have been considered and the conclusion based thereon. The justification and the reasonableness of a conclusion can only depend on the reasons given in support thereof. The order impugned has no element of "why" for the "what" therein to stand

on (Uniworth Resorts Limited and Ajay Prakash Lohia Versus Ashok Mittal & Ors. reported in (2008) 1 CalLT 1).”

The respondents are represented and make no submission insofar as the contentions of the petitioner.

In view of the above, the impugned order is unsustainable. There has been violation of the principles of natural justice in passing the impugned order. An order which merely concludes that the subject invention lacks inventive steps is contrary to section 2(1)(ja) of the Act, there being no discussion of any of the ingredients to conclude as to *why* that the subject invention lacks inventive steps. The matter is remanded back to the Controller for hearing the application of the appellant afresh within a period of four months 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.

With the above directions, IPDAID/38/2024 stands allowed.

(RAVI KRISHAN KAPUR, J.)

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