

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

IPDPTA/12/2022

ATLAS COPCO AIRPOWER NAAMLOZE
VENNOOTSCHAP (SR. NO. 62/2020/PT/KOL)
VS
THE CONTROLLER GENERAL OF PATENTS AND DESIGNS AND ANR

BEFORE:

The Hon'ble JUSTICE RAVI KRISHAN KAPUR

Date : 26th February, 2025.

Appearance:

Mr. Adorsh Ramanujan, Adv.

Mr. Abhishek Sikdar, Adv.

Mr. S. Mahajan, Adv.

Ms. S De, Adv.

Mr. S. Dey, Adv.

...for the appellant

Mr. Indrajeet Dasgupta, Adv.

Ms. Priti Jain, Adv.

...for the Controller

The Court: This appeal is directed against an order dated 17th December, 2019 rejecting an application for patent being no. 3305/KOLNP/2010, titled "A SYSTEM AND METHOD FOR REGENERATING HEAT".

The principal ground for dismissal of the application is on the ground of lack of inventive steps under Section 2(1)(ja) of the Patents Act, 1970. Significantly, the subject claim has been granted registration in three different countries i.e., China, Japan and South Africa after fulfilling the same criteria of novelty and inventive steps.

The grievance of the petitioner on the ground that there are no reasons and the impugned order has been mechanically passed in violation of all principles of nature justice. In passing the impugned order, the Controller has

introduced a new prior art at the stage of the hearing notice which had not been cited in the First Examination Report (“FER”). In any event, the Controller was obliged to specify the basis or the relevance of the prior art in order to effectively adjudicate upon the subject application. The prior art marked D-2 being CN85104889A which has been elaborately discussed in the impugned order does not find any mention in the FER. It is contended on behalf of the appellant that on this ground alone the impugned order is liable to be set aside. In support of such contention the appellant relies on an unreported decision in *Guangdong Oppo Mobile Telecommunications Corp. Ltd. vs. The Controller of Patents And Designs AID No.20 of 2022* dated 13.06.2023 passed by the High Court at Calcutta.

In this context, the relevant portion of the impugned order reads as follows:

“Considering documents D1:DE102005039270A1 and D2:CN851048891 in combination, present application for patent lacks of in inventive step still stands as the applicant fails to persuade the same. Features of the current amended claims are not inventive over cited documents as above and are not allowable 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.

Response/arguments made under other para and other submissions of written submission have been fully considered accordingly.”

In view of the above, it is contended that the impugned order is liable to be set aside and the matter remanded back to the Controller.

The respondent authorities are represented and fairly submit that in view of lack of reasons in the impugned order, there are no grounds to sustain the

same. Insofar as the submission pertaining to reliance on the prior art D-2 is concerned, the respondent does not make any submissions.

From a bare perusal of the impugned order, it appears that the conclusion arrived at by the Controller does not contain any reasons. The impugned order mechanically takes into consideration the prior arts by reproducing the same. There is no discussion as to how the Controller has applied his mind. There is also nothing to demonstrate the nexus between the matters which have been considered and the conclusion based thereof. In brief, there are no reasons in the impugned order.

In view of the clear mandate under sections 13, 14 and 15 of the Act, it is clear that the Controller was obliged to grant the applicant a *real* opportunity to deal with the prior arts as contemplated under the Act. The procedure framed under the Act has not been carried out in this case. The reliance on the prior art in the hearing notice is in violation of the mandate of the Act. In such circumstances, the impugned order is unsustainable and set aside.

IPDPTA/12/2023 is allowed. The matter is remanded back to the Controller to adjudicate upon the subject application afresh within a period of three months from the date of communication of this order and after giving a right of hearing to all parties. It is made clear that all questions are left open to be adjudicated upon afresh in accordance with law.

(RAVI KRISHAN KAPUR, J.)