

IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
Ordinary Original Civil Jurisdiction

BEFORE:
The Hon'ble JUSTICE RAVI KRISHAN KAPUR

IPDAID/39/2024
[OLD NO AID 21/2022]

TRUTZCHLER GMBH AND CO KG LIMITED
VS
THE CONTROLLER GENERAL OF PATENTS
DESIGN AND TRADE MARK CGPDTM AND ANR

For the appellant : Mr. Adarsh Ramanujan, Adv.
Ms. Yamini Mookherjee, Adv.
Ms. Kaushiki Roy, Adv.
Mrs. Garima Mehta, Adv.
Ms. Sonal Mishra, Adv.
Mr. Suryaneel Das, Adv.

For the Controller : Mr. Sunil Shinghania, Adv.
Mrs. Priti Jain, Adv.

Heard on : 12.12.2025

Judgment on : 12.12.2025

Ravi Krishan Kapur, J.:

1. This appeal is directed against an order dated 17 August 2021, rejecting an application for patent no. 1250/KOL/2009, titled "APPARATUS IN A SPINNING ROOM PREPARATION, GINNING OR LIKE INSTALLATION FOR THE DETECTION AND SEPERATION OF FOREIGN MATTER IN OR BETWEEN FIBRE MATERIAL ESPECIALLY COTTON". The sole ground

for rejection is the alleged lack of inventive steps under Section 2(i)(ja) of the Patents Act, 1970.

2. Briefly, the invention relates to an apparatus in a spinning room preparation, ginning or like installation for the detection and separation of foreign matter in or between fibre material. On 13 November 2017, the respondent issued the First Examination Report raising objections regarding lack of inventive steps. Thereafter, on 11 May 2018, the appellant filed its response to the FER along with its amended claims. On 8 January 2021, a hearing notice was issued in which no objection relating to lack of novelty or inventive steps were raised. The objections raised were limited to clarity and conciseness of the claims. On 29 January 2021, a hearing was held and the appellant filed their Written Notes of Submissions with the amended claims addressing the issues of clarity and conciseness of the claims. On 5 March 2021, an extended hearing notice was issued in which the Controller reintroduced the objections under inventive steps and proceeded to pass the impugned order rejecting the application.

3. It is submitted on behalf of the appellant that the impugned order has been passed in violation of the principles of natural justice. The approach of the Controller in passing the impugned order i.e. claims 1 and 2 are granted subject to amendment and that claim 3 can be allowed while observing on the other hand that the mentioned lack of inventive steps is irreconcilable and inconsistent to the prior notices issued by the Controller.
4. On behalf of the appellant it is contented that, in the scheme of the Act, once the application was amended, section 13(3) was automatically triggered and the amended specification would have to be examined and investigated in a like manner as the original specification. In any event, the inventive step objection had been waived in the light of the hearing notice. In such circumstances, introducing the objection of inventive steps *suo moto* without granting an opportunity to the appellant is in violation of the principles of natural justice and contrary to the scheme of the Act. The extended hearing notice is clearly perverse and irreconcilable to the earlier notices which had been issued by the

Controller. The invention claimed has been granted in five other jurisdictions namely China, Switzerland, Italy, Brazil and UK after having fulfilled the same criteria of novelty and inventive steps.

5. On behalf of the respondent Controller, it is submitted that the impugned order is not liable to be interfered with on the basis of the materials on records and in the light of the prior documents being D1 and D2, the invention was not inventive and has been rightly rejected.

6. The ground on which the impugned order has been passed i.e. inventive steps was admittedly withdrawn and given a go-by in the prior hearing notices. In such circumstances, the objection of inventive steps stood waived in the hearing notice issued under section 14 of the Act.

Regardless of the procedure adopted in re-introducing the objection by way of second hearing notice, once the application was amended the amended specification has to be examined and investigated in the like manner as the original specification (*Guangdong Oppo Mobile Telecommunications Corp., Ltd. vs. Controller of Patents and Designs 2023 SCC OnLine Cal 6650*).

7. The applicant was entitled to know of the grounds and have an adequate opportunity for dealing with the objection of inventive steps prior to the passing of the impugned order. The procedure followed in passing the impugned order is against the scheme of the Act and has admittedly not been adhered to in the facts and circumstances of the case.
8. In view of the above, the impugned order has been passed in violation of the principles of natural justice and is liable to be set aside. IPDAID/39/2024 stands allowed. The matter is remanded back to the Controller to hear the matter afresh in accordance with law after giving a full and complete opportunity to the applicant.
9. It is made clear that nothing in the impugned order or in this order is binding on the Controller insofar as the merits of this case are concerned and the Controller is at liberty to conduct a *de novo* hearing of the entire application in terms of the scheme of the Act.

(RAVI KRISHAN KAPUR, J.)