OIP-30

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

IPDPTA/12/2025

STROMAG GMBH
VS
THE CONTROLLER GENERAL OF PATENTS
DESIGNS AND TRADE MARK AND ANR

BEFORE:
The Hon'ble JUSTICE RAVI KRISHAN KAPUR
Date : 4th September, 2025.

Appearance:
Mr. Adarsh Ramanujan, Adv.
Ms. Yamini Mookherjee, Adv.
Mr. Divyashi Bansal, Adv.
Ms. Ruchira Manna, Adv.
Ms. Kaushiki Roy, Adv.
Mr. Sonal Mishra, Adv.
…for the appellant

Mr. Siddhartha Lahiri, Adv.
Mr. Debraj Dutta, Adv.
Mr. N. Mullick, Adv.
…for the respondents

The Court: The grievance of the appellant is directed against an order dated 31st January, 2023 rejecting an application for patent titled "HYDRAULICALLY ACTUATABLE DISK BRAKE AND AZIMUTH DRIVE" filed on 18th February, 2013 being application no. 179/KOL/2013.

Upon filing of the above application on 18th January, 2013, the respondent no. 1 issued a First Examination Report (FER), raising objections regarding the lack of inventive steps under section 2(1)(j) of the Patents Act 1970, under section 3(f) of the Act for lack of patentability and under section 10 of the Act for lack of sufficiency of disclosure.

On 14th May, 2019, the appellant filed its response to the FER alongwith its amended claim. On 18th July, 2022, a hearing notice was issued, wherein

the Controller has objected to the invention on the ground that in combining the seven prior arts, the claimed invention could be achieved. On 11th August, 2022, the final hearing was held and the appellant was directed to file their written submissions. On 26th August, 2022, the appellant submitted its written submissions alongwith the amended claims and its defence arguments against the seven prior arts to establish inventive steps. Ultimately, the impugned order came to be passed rejecting the application primarily on the ground of lack of inventive steps.

The principal ground urged by the appellant is that the impugned order has been passed in violation of principles of natural justice.

On a perusal of the impugned order, it appears that after narrating the background of the invention, the impugned order reproduces and summarizes the extracts of the seven prior arts for an additional 24 pages. Thereafter, the impugned order records the submission made on behalf of the appellant and concludes as follows:

> *"Hence, as above, considering documents D1, D2, D3, D4, D5, D6 and D7 in combination only, present application for patent is not inventive step.*
>
> *Further 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 and submissions in written submission filed as 26.08.2022 have been fully considered accordingly.*
>
> *Based on the above, I am of the opinion that present alleged invention does not constitute as invention under section 2(1)(ja) of the Patents Act, 1970 (as amended) because it does not involve an inventive step. Therefore, I hereby refuse to grant monopoly and dispose this application."*

In short, the application filed by the appellant has been rejected in a single sentence i.e., that the invention claimed is merely a combination of prior arts. There is no analysis as to how the prior arts rendered the subject invention or any of the claims obvious. There are no other reasons in the impugned order.

The respondents are represented and submit that the application was liable to be dismissed on the ground of suppression. It is further contended on behalf of the respondent that the impugned order deals with all the contentions in the FER.

It is trite knowledge that the impugned order must speak for itself. There cannot be any addition or supplementation of the impugned order at this stage. In *Kranti Associates (P) Ltd. v. Masood Ahmed Khan*, (2010) 9 SCC 496 the Hon'ble Supreme Court had held as follows:

> ***"15.*** *This Court always opined that the face of an order passed by a quasi-judicial authority or even an administrative authority affecting the rights of parties, must speak. It must not be like the "inscrutable face of a sphinx".*
> ***24.*** *In Siemens Engg. and Mfg. Co. of India Ltd. v. Union of India [(1976) 2 SCC 981 : AIR 1976 SC 1785] this Court held that it is far too well settled that an authority in making an order in exercise of its quasi-judicial function, must record reasons in support of the order it makes. The learned Judges emphatically said that every quasi-judicial order must be supported by reasons. The rule requiring reasons in support of a quasi-judicial order is, this Court held, as basic as following the principles of natural justice. And the rule must be observed in its proper spirit. A mere pretence of compliance would not satisfy the requirement of law (see SCC p. 986, para 6 : AIR p. 1789, para 6).*
> ***27.*** *In Rama Varma Bharathan Thampuram v. State of Kerala [(1979) 4 SCC 782 : AIR 1979 SC 1918] V.R. Krishna Iyer, J. speaking for a three-Judge Bench held that the functioning of the Board was quasi-judicial in character. One of the attributes of quasi-judicial functioning is the recording of reasons in support of decisions taken and the other requirement is following the principles of natural justice. The learned Judge held that natural justice requires reasons to be written for the conclusions made (see SCC p. 788, para 14 : AIR p. 1922, para 1*
> ***28.*** *In Gurdial Singh Fijji v. State of Punjab [(1979) 2 SCC 368 : 1979 SCC (L&S) 197] this Court, dealing with a service matter, relying on the ratio in Capoor [(1973) 2 SCC 836 : 1974 SCC (L&S) 5 : AIR 1974 SC 87] , held that "rubber-stamp reason" is not enough and virtually quoted the observation in Capoor [(1973) 2 SCC 836 : 1974 SCC*

(L&S) 5 : AIR 1974 SC 87] to the extent that : (Capoor case [(1973) 2 SCC 836 : 1974 SCC (L&S) 5 : AIR 1974 SC 87] , SCC p. 854, para 28)

"28. … Reasons are the links between the materials on which certain conclusions are based and the actual conclusions." (See AIR p. 377, para 18.)

29. *In a Constitution Bench decision of this Court in H.H. Shri Swamiji of Shri Amar Mutt v. Commr., Hindu Religious and Charitable Endowments Deptt. [(1979) 4 SCC 642 : 1980 SCC (Tax) 16 : AIR 1980 SC 1] while giving the majority judgment Y.V. Chandrachud, C.J. referred to (SCC p. 658, para 29) Broom's Legal Maxims (1939 Edn., p. 97) where the principle in Latin runs as follows:*

"Cessante ratione legis cessat ipsa lex."

30. *The English version of the said principle given by the Chief Justice is that : (H.H. Shri Swamiji case [(1979) 4 SCC 642 : 1980 SCC (Tax) 16 : AIR 1980 SC 1] , SCC p. 658, para 29)*

"29. … 'reason is the soul of the law, and when the reason of any particular law ceases, so does the law itself'." (See AIR p. 11, para 29.)

32. *In Ram Chander v. Union of India [(1986) 3 SCC 103 : 1986 SCC (L&S) 383 : (1986) 1 ATC 47 : AIR 1986 SC 1173] this Court was dealing with the appellate provisions under the Railway Servants (Discipline and Appeal) Rules, 1968 condemned the mechanical way of dismissal of appeal in the context of requirement of Rule 22(2) of the aforesaid Rules. This Court held that the word "consider" occurring in Rule 22(2) must mean that the Railway Board shall duly apply its mind and give reasons for its decision. The learned Judges held that the duty to give reason is an incident of the judicial process and emphasised that in discharging quasi-judicial functions the appellate authority must act in accordance with natural justice and give reasons for its decision (SCC pp. 106-07, para 4 : AIR p. 1176, para 4)."*

In *UPSC v. Bibhu Prasad Sarangi*, (2021) 4 SCC 516 it has been held as follows:

"5. *Cutting, copying and pasting from the judgment of the Tribunal, which is placed in issue before the High Court, may add to the volume of the judgment. The size of judicial output does not necessarily correlate to a reasoned analysis of the core issues in a case. Technology enables Judges to bring speed, efficiency and accuracy to judicial work. But a prolific use of the "cut-copy-paste" function should not become a substitute for substantive reasoning which, in the ultimate analysis, is the defining feature of the judicial process. Judges are indeed hard pressed for time, faced with burgeoning vacancies and large case-loads. Crisp reasoning is perhaps the answer. Doing what the High Court has done in the present case presents a veneer of judicial reasoning, bereft of the substance which constitutes the heart of the judicial process. Reasons constitute the soul of a judicial decision. Without them one is left with a shell. The shell provides neither solace nor satisfaction to the litigant. We are constrained to make these observations since what we have encountered in this case is no longer an isolated aberration. This has become a recurring phenomenon. The National Judicial Academy will do well to take this up. How Judges communicate in their judgments is a defining characteristic of the judicial process. While it is important to keep an eye on the statistics on disposal, there is a higher value involved. The quality of justice brings legitimacy to the judiciary."*

In an unreported decision *in Toyo Engineering Corporation vs. Controller General of Patent, AID 17/2022* dated 19 December 2022 it has been held as follows:

> *"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 Prkash Lohia Versus Ashok Mittal & Ors. reported in (2008) 1 CalLT 1)."*

In any event, in view of the settled position of law, the claimed invention must be judged as a whole. As a general rule mosaicing of multiple prior arts for inventive steps analysis cannot be arbitrarily undertaken by the Controller. All elements of the claimed invention including configuration and functionality specified in the claim must be independently assessed. In *Generic UK Limited vs Daiichi Pharmaceutical Co Ltd, (2009) EWCA Civ 646* it has been held as follows:

> *"27. I agree with that although I personally do not find the point of principle "subtle". It would be wholly subversive of patents and quite unfair to inventors if one could simply say "piece of information A is in the standard literature, so is B (albeit in a different place or context), so an invention consisting of putting A and B together cannot be inventive." The skilled man reads each specific piece of prior art with his common general knowledge. If that makes the invention obvious, then it does. But hedoes not read a specific citation with another specific citation in mind, unless the first causes him to do so or both are part of the matter taken to be in his head."*

For the above reasons, the impugned order is unsustainable and set aside. The matter is remanded back to a different Hearing Officer to adjudicate the application afresh within a period of four months from the date of communication of the order.

It is made clear that there has been no adjudication on the merits of the case and all questions are left open for the Hearing Officer to adjudicate upon in accordance with law.

With the above directions, IPDPTA/12/2025 stands disposed of.

(RAVI KRISHAN KAPUR, J.)

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