OIPD-20

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

IPDPTA/10/2024

FIACRE TELEMATICS PRIVATE LIMITED
VS
THE CONTROLLER GENERAL OF PATENTS
DESIGNS AND TRADE MARK AND ANR

Before:
The Hon'ble Justice RAVI KRISHAN KAPUR
Date: 20th May 2025

Appearance:
Mr. Adarsh Ramanujan, Adv.
Ms. Yamini Mookherjee, Adv.
Mr. Abhishek Sikdar, Adv.
Ms. Sonal Mishra, Adv.
Ms. Kaushiki Roy, Adv.
…for petitioner.

Mr. Ranjan Kr. Sinha, Adv.
Mrs. Sanjukta Gupta, Adv.
..for respondent.

The Court: This is an appeal filed under Section 117A of the Patents Act, 1970 against an order dated 17th April, 2024 passed by the Assistant Controller of Patents and Designs, Kolkata under section 15 of the Act in Patent Application No. 201731012587.

On behalf of the appellant, it is contended that the impugned order has been passed in violation of the principles of natural justice. There are no reasons in the impugned order. The impugned order simply records the submissions of the parties gives a detailed analysis of the subject invention and concludes that the application was liable to be rejected without taking into account any of the relevant facts and circumstances of the case.

On behalf of the appellant, it is contended that the two prior arts being D4 and D5, which were added in the hearing notice were not cited in the FER. It is further contended that the impugned order fails to demonstrate any application of mind. The impugned order simply reproduces the submissions of the appellant without any analysis of the inventive steps at all. The submissions made on behalf of the appellant have neither been adverted to nor considered in the impugned

order. None of the differentiations claimed by the appellant insofar as the prior arts were considered have even been addressed. A serious ground of bias is made against the Officer who had passed the impugned order. It is contended on behalf of the appellant that a complaint had been lodged against the particular Officer, which had led to the Officer issuing the impugned order one day after becoming aware of the complaint. In view of the above and primarily on the ground of the order being unreasoned, the appellant seeks setting aside of the same.

On behalf of the respondent authorities, it is contended that the apprehensions of the appellant are misplaced in as much as the prior art D4 and D5, which were added in the hearing notice, have not been taken into consideration in passing the impugned order and there can be no grievance in respect thereof.

A plain reading of the impugned order makes it evident that the impugned order simply narrates the submissions made on behalf of the appellant and the subject invention in detail without any analysis of the arguments which have been made by the appellant. The conclusion which is arrived at that claim numbers 1 to 10 did not have “inventive steps” under section 2(1)(ja) of the Act is unreasoned and without any consideration of the relevant materials relied on by the appellant. The appellant had differentiated the claimed invention from each prior art. In particular, the appellant had contended as follows:

a. The Examiner undertakes the prior art search and examination under Section 12(1).
b. The Examiner sends a detailed report under Section 12(4) to the Controller.
c. If the Examiner's report is adverse to the Applicant, the Controller communicates the "gist of the objections" to the Applicant and calls for a hearing under Section 14.
d. Thus, the communication under Section 14 inviting a reply and a hearing can only be confined to objections arising from the Examiner's Report under Section 12(2).

e. At the Section 14 stage, where the Controller applies his/her mind, the statute does not envisage the addition of new prior arts.

f. Adding new prior arts at the Section 14 stage takes away at least one stage of the right' to respond, i.e., written reply before hearing.

None of the above have even been remotely dealt with in the impugned order. There are no reasons in the impugned order and this is a serious infirmity in the order. The Hearing Officer in passing the impugned order has not even considered the submissions made on behalf of the appellant. In *Uniworth Resorts Limited vs Ashok Mittal, (2007) 4 CHN 712* it has been held as follows:

> *"12. Judicial orders of such nature need to meet the twin tests of "why" and "what". It is the "why" that sustains the "what". Reasons are the safeguard against the ipsi dixit of the decision-making process. They discuss how the judicial mind has been applied to the matter in issue and convey the nexus between the matters that have been considered and the conclusion based thereon. The justification and the reasonableness of a conclusion depend on the reasons given in support thereof. The order impugned has no element of "why" for the "what" therein to stand on."*

The grounds sought to be urged by the Assistant Controller for the first time during the hearing of this appeal are not reflected in the impugned order. An impugned order cannot be improved upon in the Written Submissions or affidavits and any attempt to do so is impermissible *Mohinder Singh Gill & Anr. vs. The Chief Election Commissioner (1978) 1 SCC 405.*

In any event, it is well settled that the claimed invention must be judged as a whole. As a general rule, the mosaicking of multiple prior arts for inventive steps analysis cannot be arbitrarily undertaken. All elements of the claimed invention including configuration and functionality specified in the claim must be assessed. As observed by Jacobs LJ in *Generics (UK) Ltd v. Daiichi Pharmaceutical Co Ltd., [2009] EWCA Civ 646*:

> *"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 he*

does 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."

To the above extent, IPDPTA/10/2024 stands allowed. The matter is remanded to a different Hearing Officer to be heard within three 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 expression on the merits of the case and all questions are left open to be decided in accordance with the law.

(RAVI KRISHAN KAPUR, J.)

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