IN THE HIGH COURT AT CALCUTTA
SPECIAL JURISDICTION
ORIGINAL SIDE

BEFORE:
The Hon'ble Justice Ravi Krishan Kapur

AID NO. 20 OF 2022

GUANGDONG OPPO MOBILE TELECOMMUNICATIONS CORP., LTD.
VERSUS
THE CONTROLLER OF PATENTS AND DESIGNS

For the Appellant : Mr. S. Majumdar, Adv.
Mr. Paritosh Sinha, Adv.
Mr. K.K. Pandey, Adv.
Mrs. Mitul Dasgupta, Adv.
Ms. Enakshi Saha, Adv.

For the Controller of Patents : Mr. Indrajeet Dasgupta, Adv.
Ms. P. Bhowmick, Adv.

Reserved on : 19.01.2023

Judgment on : 13.06.2023

Ravi Krishan Kapur, J.:

1. This is an appeal under section 117A of the Patents Act, 1970 (the Act) challenging an order dated 24 August 2022 passed by the respondent rejecting Patent Application No. 201737035802 filed in India on 9 October 2017 for an invention titled "CHARGING SYSTEM AND CHARGING METHOD, AND POWER ADAPTER".
2. The appellant is a leading electronics manufacturer inter alia engaged in developing, manufacturing and marketing communication equipment. The major products manufactured by the appellant

include smart-phones, smart devices, audio devices, power banks, and other electronic products. The appellant has a global presence and has been granted patent for the subject invention in different jurisdictions around the world.

3. Briefly, the subject invention relates to a power adapter for a mobile terminal such as smart phone. The subject invention enables a voltage with a pulsating waveform (i.e., third voltage with a ripple waveform) output by a power adapter to be applied to a battery of the mobile terminal directly, thereby realising miniaturization and cost-efficiency of the power adapter while prolonging the service life of a battery. The power adapter has several electronic components including first rectifier, a switch unit, a transformer, a second rectifier, a first charging interface, a sampling unit and a control unit. The device generates a first ripple waveform, thereafter, a second ripple waveform and eventually a third ripple waveform. The arrangement of the components and the generation of ripple waveform in multiple stages enables the elimination of an electrolytic capacitator. The elimination of the capacitator also helps to reduce the size of the power adapter as well as reduce the cost of the adapter. Apart from these benefits, the charger in the subject invention has an additional benefit of maintaining a moderate temperature by not allowing the build-up of temperature and thereby allows reliability, safety and service life of the battery. Such advantages and benefits are achieved by the use of, inter alia, a first rectifier, a switch unit, a transformer, a second

rectifier, a first charging interface, a sampling unit, and a control unit. As a result, the voltage with the ripple waveform output by the power adapter directly applies to the battery.

4. It is contended that the subject invention allows faster charging rate and lowers cost the while maintaining safety. The arrangement of components in the subject invention results in the generation of a ripple waveform of electric current in multiple stages that enables the elimination of an electrolytic capacitor which tends to generate heat by constant voltage supply. Instead, the charging system comprises of rectifiers and charging interfaces resulting in a rippled waveform of electricity. The elimination of the capacitor allows the adapter to be smaller and decreases heat emission by making it cost effective.
5. By the impugned order, the patent application has been rejected on the ground that the same is inter-alia not patentable under section 2(1)(j) and section 10(4) of the Act.
6. It is contended that the impugned order is a non-speaking order inasmuch as there are no reasons. It is also submitted that the respondent has failed to appreciate that the objections on the ground of lack of novelty and lack of inventive steps cannot stem from the same document. It is also alleged that the impugned order uses the words “novel” and “inventive” interchangeably without appreciating the meaning and content thereof. It is also contended that two additional prior arts D5 and D6 were cited for the first time at the hearing notice without giving any opportunity to the appellant to

respond or make amendments to the same. The appellant was also not granted any opportunity to dispute the alleged insufficiency of disclosure under section 10(4) of the Act with regard to the term "transformer" which was only raised for the first time at the hearing.

7. The appellant also contends that the respondent has not given any reasons as to why the prior art D1 to D6 ought to be read together to conclude lack of inventive steps in the subject invention. In this connection, the appellant relies on the decisions of *J. Mitra v. Kesar Mediaments, 2008 SCC OnLine Del 255*, and *Enercon v. Alloys Wobben ([2013] IPAB 87)*, to contend that there has to be a coherent thread leading up from the prior arts to conclude that the subject invention is obvious.

8. Finally, it is contended that no Second Examination Report (SER) was issued even though the appellant amended their claims after the objections had been raised in the First Examination Report. Non-issuance of SER also violates the mandate of section 13(3) of the Act which obliges the respondent authorities to examine the amended specification.

9. On behalf of the respondent it is contended that, an application for patent can only be examined upon a request for examination under section 11B of the Act. Moreover, the Act neither provides nor stipulates for issuance of any SER. It is also contended that when the complete specification of an invention is objected to on the ground of an anticipation, the Act does not contemplate that each and every

component of the subject invention has to be present in the prior art documents. It is further contended that the subject invention lacks technical advancement and that the differentiating claim had been considered and highlighted by the Controller and compared to the prior arts. It is also alleged that the amended claims are an aggregation or rearrangement of existing teachings instead of the same being restricted to a specific invention. The same is also in violation of section 10(5) of the Act.

10. The subject application has been rejected by the respondent for want of novelty. The test for novelty, as formulated in Halsbury's, Laws of England [(3rd Edition) Vol. 29, at p. 27)] is as follows:

> *"To anticipate a patent, a prior publication or an activity must contain the whole of the invention impugned; i.e., all the features by which the particular claim attacked is limited."*

In other words, the prior art document must disclose the whole of the invention which enables the invention. Thus, the prior art document must deal with the subject invention in completeness. An anticipating prior art must also contain sufficient information to allow the invention to be put into practice (*F. H. & B. Corporation v. Unichem Laboratories*, AIR 1969 Bom 255 at paragraph 15). By the impugned order, the respondent has failed to demonstrate how the prior art D1 contains all the elements and deals with the subject invention in its entirety. In finding that the document D1 rendered the subject invention obvious as well as was as an anticipating document the

respondent has erred in law. The same document cannot be said to be rendering an invention obvious in combination with other documents where it is supposed to deal with every feature of the subject invention and its mode of operation. There are no reasons in the impugned order which demonstrate why the subject invention lacks novelty.

11. Moreover, the impugned order records that D1 features a fixed voltage applied to the battery in contrast with a "second rectifier configured to apply the third voltage with the third ripple waveform to a battery". In arriving at such conclusion, the respondent has created a mosaic of the prior arts D1 and D2 and also D1-D6 to conclude that the subject invention is obvious. While mosaicing in patents is permissible, the reasons for doing so must be clearly spelt out. Although, D1 was stated to have all features of the subject invention, on a reading of the impugned order, I find that the respondent has not been able to demonstrate how D1 destroys the novelty of the subject invention. In any event the prior art D1 having been claimed as an anticipated prior art leading to the subject invention, the same could not have simultaneously rendered the subject invention obvious when read with documents D1 to D6. In fact, the grounds of lack of novelty cannot work in tandem with the lack of inventive steps in opposing grant of any patent. The tests for novelty and obviousness are different and cannot coexist in connection with the same document. Thus, an invention cannot be considered to involve an inventive step if it is obvious to a person skilled in the art whereas an invention would

lack novelty if a single prior art document contains an enabling disclosure of the claimed invention. In such circumstances, the impugned order erroneously finds that the prior art D1 contains all features of the subject invention whilst also finding that the claims of the subject invention are obvious when read with D1 to D6.

12. Moreover, any claim passes the test of inventive steps if it discloses a technical advancement in comparison with the closest prior art and the features comprising inventive steps are not obvious to a person skilled in the art (*Avery Dennison Corporation v. Controller of Patents and Designs*, 2022 SCC OnLine Del 3659). If several prior art documents are to be read in combination, there must be some common thread linking the claim with the prior art documents obvious to a person skilled in the art. It must be shown that the skilled person when faced with the claim would turn to some other citation to supplement the claim. Otherwise, the combined reading of the prior art documents or mosaicing of the same is impermissible.

13. In *Enercon (India) Limited v. Aloys Wobben (ORA/08/2009/PT/CH*) Order No.123 of 2013, it has been held as follows:

> *"**43**. The mere existence in the prior arts, of each of the elements in the invention, will not ipso facto mean obviousness. For after all most inventions are built with prior known puzzle-pieces. There must be a coherent thread leading from the prior arts to the invention, the tracing of the thread must be an act which follows obviously. We must apply this reasoning to test if indeed it is obvious, or if it seems to us to be obvious to the person skilled in the art because of what we know now. If it is the latter, it is*

hindsight deduction and is not acceptable, but if it is the former, then the patent must go."

Reasons are the links between the facts and the conclusion. Reasons indicate the basis on which a conclusion is arrived at on a given set of facts. There is simply no reasoning on this aspect of the matter in the impugned order.

14. On the question of issuance of the Second Examination Report, section 13(3) of the Act makes it apparent that upon amendment of the claims, the amendment application ought to be examined in a manner similar to the original application. When a complete specification is amended, such amended specification should be re-examined and a Report issued in the manner stipulated under section 12 of the Act. In passing the impugned order, there has been a violation of the statutory provisions in issuing the hearing notice citing additional objections and relying on the same in without granting an opportunity to the appellant to amend its claim and without issuance of a Second Examination Report.

15. For the foregoing reasons, the impugned order is unsustainable. AID 20 of 2022 stands allowed. The subject patent application is remanded back to the Controller for reconsideration afresh within a period of three months from the date of communication of this order. The respondent is directed to issue an SER upon examination of the amended claims of the subject invention and provide the appellant with an opportunity to deal with objections, if any, raised in the said

SER. The respondent is further directed to provide the appellant with an opportunity of being heard before disposing of the said application. For the purposes of adjudication afresh, the Controller is not bound by any of the findings on merits made in this order and shall consider the matter afresh in accordance with law.

(Ravi Krishan Kapur, J.)