OCD-12

IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Commercial Division)

IPDPTA/27/2023

BRITANNIA INDUSTRIES
LIMITED (OA/4/2021/PT/KOL) (SR. 7/2020/PT/KOL)
VS
THE CONTROLLER PATENTS OF PATENT AND DESIGNS AND ANR.

BEFORE:
The Hon'ble JUSTICE RAVI KRISHAN KAPUR
Date : 10th April, 2023

Appearance:
Mr. Ranjan Bachawat, Sr. Adv.
Mr. Paritosh Sinha, Adv.
Mr. K.K. Pandey, Adv.
Mr. Sarosij Dasgupta, Adv.
Mrs. M. Dasgupta, Adv.
Mr. S. Sen, Adv.
Ms. Enakshi Saha, Adv.
…for the appellant

Mr. Indrajeet Dasgupta, Adv.
Mr. Sailendra Tiwari, Adv.
…for the Controller

The Court:-

1. This is an appeal under Section 117A of the Patents Act, 1970 (the Act) impugning an order dated 18 November 2019 rejecting Patent Application No. 1091/KOL/2009 filed by the appellant.
2. Briefly, the subject invention pertains to an improved biscuit baking oven with improved heat transfer rate. The invention relates to a novel oven which employs different combinations of heating mediums like thermic fluid, infrared heaters, infra-red rays and radio frequency rays

to transfer the heat to bake biscuits. The oven comprises of infra-red heaters and a radio frequency heater kept close to the product surface and a thermic fluid heater, thermic heater burner, thermic pump, whereby the distance between the heat emitting surface of all above different combinations and heat absorbing surfaces is reduced. The gap between the heat emitting surface (radiator tubes, heater filaments) and heat absorbing body surface (unbaked biscuit) is reduced to enable efficient heat transfer. Since the fluid is re-circulated within the system, the stack losses are reduced which further helps to increase the efficiency.

3. By the impugned order, the subject application has been rejected on the ground that the same lacks novelty and inventive steps.

4. On behalf of the appellant, it is contended that the impugned order is liable to be set aside for lack of reasons. In passing the impugned order, the Controller has failed to give any reasons whatsoever. Additionally, the submissions of the appellant in response to the First Examination Report (FER) and the Written Submissions by the appellant have not been taken into consideration. The Controller has also erred in rejecting the application on the ground of lack of novelty being guided by the document D7 which admittedly deals with different equipment and not the subject invention. Insofar as the ground of inventive steps is concerned, it is contended that the Controller has given neither reasons nor justification in combining the prior arts. The mandate of section 13(3) of the Act has also not been complied with. Notwithstanding

amendments being filed and the application being re-examined as well as a new document D7 being cited in the hearing notice, there was no Second Examination Report (SER) in terms of section 13(3) of the Act. It is also contended that the impugned order is erroneous and proceeds on a combined reading of the cited documents which is impermissible. The Controller has failed to disclose any reason as to why a combined reading of the documents was necessary. In support of their contentions, the appellant has relied on the following decisions: *Bilcare Limited vs. Amartara Private Limited 2007 (34) PTC 419 @para 52, Avery Dennison Corporation vs. Controller of Patents and Designs, 2023 (93) PTC 26 paragraphs 13-20, and Enercon (India) Limited vs. Aloys Wobben, 2013 SCC Online IPAB 91 paragraphs 43-45*.

5. At the outset, it is pertinent to mention that though the appellant had filed a review petition, the same was disposed of by directing the petitioner to avail of the remedy by way of an appeal. Hence, there has admittedly been no adjudication on the merits of the review petition and the appellant has been granted liberty to proceed by way of this appeal.

6. Each and every patent application depending on the field of technology and the nature of the prior arts may require different approaches or tests to be followed or applied. In the ultimate analysis an Examiner in the patent office adjudicating the issue needs to identify the elements in the prior arts and compare the same with the claims in question from the point of the view of a person skilled in the art. It is now well settled that mosaicing of individual documents of prior arts is not permissible

unless it can be shown that the person confronted with the particular citation would turn to some other citation to supplement the information from the first. One cannot create a mosaic of individual documents or prior use to defeat a claim for patent.

7. In *Terrel On the Law of Patents* (17th edition) at page 319, it is stated as under:

> *"MOSAICING*
> *Each document must be interpreted on its own in order to determine the information it contains. It is not legitimate to piece together a number of prior documents in order to produce an anticipation of the invention.*
> *In Lowndes' Patent [(1928) 45 R.P.C. 48 at 57], Tomlin J. said:*
> *"It is not open to you to take a packet of prior documents and… by … putting a puzzle together produce what you say is a disclosure in the nature of a combination of the various elements which have been contained in the prior documents. I think it is necessary to point to a clear and specific disclosure of something which is said to be like the patentee's invention."*
> *Equally, it may be impermissible to "cherry-pick" different aspects of the disclosure of a single document and seek to combine them in such a way as to produce an end result falling with the later claim; this does not necessarily demonstrate that such a combination is itself disclosed to the skilled addressee."*

8. The mere existence in the prior arts of each of the elements in the invention does not *ipso facto* mean obviousness. There must be a coherent thread leading from the prior arts of the invention, the tracing of the thread must be an act which follows obviously. The validity of a patent cannot be questioned on the ground that it is a combination of

prior existing things. *[Bilcare Limited vs. Amartara Private Limited (2007) 34 PTC 419].*

9. The approach followed by the Controller in adjudicating the question of obviousness and inventiveness is also untenable both in law and on facts. The impugned order records that on a combined reading of the documents being D1 to D4, the Controller has arrived at a conclusion that there is no inventiveness nor obviousness in the subject patent. The tests to determine if a patent has satisfied the requirement of inventive steps and lack of obviousness have been reiterated in *Avery Dennison Corporation vs. Controller of Patents and Designs 2022 SCC Online Del 3659*:

> *"**14**. In Windsurfing International Inc. vs. Tabur Marine Ltd., [1985] RPC 59, the Court laid down a four-step test to determine whether a patent satisfied the requirement of inventive step and lack of obviousness. The said steps are as under:*
>
> *"1. Identifying the inventive concept embodied in the patent;*
>
> *2. Imputing to a normally skilled but unimaginative addressee what was common general knowledge in the art at the priority date;*
>
> *3. Identifying the differences if any between the matter cited and the alleged invention; and*
>
> *4. Deciding whether those differences, viewed without any knowledge of the alleged invention, constituted steps that would have been obvious to the skilled man or whether they required any degree of invention."*
>
> ***15**. The tests laid down in Windsurfing (supra) were again considered by the England and Wales Court of Appeals in Pozzoli Spa v. BDMO SA, [2006] EWHC 1398 (Ch) and modified by Jacob LJ as under:*
>
> *"1. (a) Identify the notional "person skilled in the art"*
>
> *(b) Identify the relevant common general knowledge of that person;*

> *2. Identify the inventive concept of the claim in question or if that cannot readily done, construe it;*
>
> *3. Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;*
>
> *4. Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?"*
>
> ***16**. F. Hoffmann-La Roche Ltd. vs. Cipla Ltd. (2016) 65 PTC 1 (Del) added a further step as elaborated below:*
>
> *"Step No. 1 To identify an ordinary person skilled in the art,*
>
> *Step No. 2 To identify the inventive concept embodied in the patent,*
>
> *Step No. 3 To impute to a normal skilled but unimaginative ordinary person skilled in the art what was common general knowledge in the art at the priority date.*
>
> *Step No. 4 To identify the differences, if any, between the matter cited and the alleged invention and ascertain whether the differences are ordinary application of law or involve various different steps requiring multiple, theoretical and practical applications,*
>
> *Step No. 5 To decide whether those differences, viewed in the knowledge of alleged invention, constituted steps which would have been obvious to the ordinary person skilled in the art and rule out a hindside approach"*

10. In passing the impugned order, reliance has also been placed on a new document being D7. Even though amendments were filed and the application was re-examined, no Second Examination Report was issued. This is *ex facie* contrary to the mandate of section 13 (3) of the Act. The re-examination of a re-filed application is a mandatory procedure and the Controller was statutorily bound to follow the same. Thus, even on this ground the impugned order is not sustainable.
11. Significantly, the impugned order repeatedly reiterates that the respondent no.2 was not *persuaded* by the arguments of the appellant.

However, there has been no discussion either of the facts or the merits of the case in repeatedly arriving at this conclusion. The impugned order simply fails to record any reasons. In *Uniworth Resorts Limited & Anr. vs. Ashok Mittal & Ors. 2007 SCC OnLine Cal 532* 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."*

12. For the foregoing reasons, the impugned order is unsustainable and is set aside. In view of the fact that the application for patent was filed as far back as in 2009, the following directions are also passed:

> a) To issue a Second Examination Report (SER) preferably within 3 weeks from the date of communication of this order and allow the appellant to submit its Reply to the SER within 3 weeks thereof.
>
> b) Hearing be offered preferably within 2 weeks from the date of filing of the Reply to Second Examination Report (SER) by the appellant. Thereafter, the Controller is requested to

dispose of the application within 4 weeks from the date of hearing.

c) In view of the fact, that the very same Deputy Controller has passed three separate orders dated 18th November, 2019, 30th September, 2020 and 9th June, 2021 respectively rejecting the subject patent application, the application shall be decided by any other Officer except the Deputy Controller who has passed the impugned order.

13. With the aforesaid directions, IPDPTA/27/2023 stands allowed.

(RAVI KRISHAN KAPUR, J.)

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