OD-22

IN THE HIGH COURT AT CALCUTTA
Special Jurisdiction
ORIGINAL SIDE

AID/14/2022

DONALDSON COMPANY INC.
VS
THE ASSISTANT CONTROLLER
OF PATENTS AND DESIGNS

BEFORE:
The Hon'ble JUSTICE RAVI KRISHAN KAPUR
Date : 8th May, 2023

Appearance:
Mr. Nikunj Berlia, Adv.
Mr. Sarah Haque, Adv.
Mr. Varun Kothari, Adv.
Ms. Sonali Pal, Adv.
…for the petitioner

Mr. Indrajit Dasgupta, Adv.
Mrs. Priti Jain, Adv.
…for the Controller

The Court:-

1. This appeal is directed against an order dated 27th September, 2021 passed by the respondent whereby Indian Patent Application no. 4394/KOLNP/2011 has been rejected. The appellant had filed an application for grant of a patent titled "LIQUID FILTER ASSEMBLIES; FEATURES; COMPONENTS AND METHODS".

2. Briefly, the present invention relates to a liquid filter assembly having one or more features as disclosed in the amended hearing claims that ensure(s) proper positioning and proper engagement of a filter cartridge within the liquid filter assembly. The filter assembly with said features, is simple to construct and inexpensive to assemble.

3. The technical problem underlying the invention is that during servicing conventional filter assemblies, it is difficult to ensure that the filter

cartridge is properly and sealing-ly positioned in the filter cartridge. If there is improper positioning of the filter cartridge within the filter assembly that shall hamper the performance of the filter assembly. Additionally, the invention of the application solves the dual problems of using only the preferred or standard type of filter cartridge (as against fake or low-quality products) and their alignment during replacement (servicing) that ensures a sealing and proper positioning of said filter cartridge.

4. The application was examined and the First Examination Report (FER) was issued on 1st January, 2019. The FER contained, inter alia, an objection under section 2(1)(ja) i.e., inventive steps in view of the prior art documents being documents D1 to D4. There was also an objection of non-patentability under Section 3(f) of the Act. The appellant filed a detailed reply to the FER on 13th June, 2019 with an amended claim. The respondent issued a hearing notice on 13 May, 2021 fixing the date of hearing for 13 July, 2021 and adding three more prior arts D5 to D7 along with D1 to D4.

5. The short point urged by the appellant is that the impugned order contains no reasons at all. It is further submitted on behalf of the appellant that the impugned order mechanically reproduces the Notes of Arguments as well as the claims of the appellant without any discussion on the facts of the case. The heading “Scientific and Technical Analysis” in the impugned order, has been reproduced verbatim from the prior arts without any attempt at all to combine the same.

6. On behalf of the respondent authorities it is fairly submitted that the impugned order contains no reasons and the matter be remanded back to the Controller.

7. The relevant portion of the impugned order reads as follows:-

> *"Considering documents D1: US5744030A, D2: JP2003053336A, D3: US20040232065A1, D4: WO2008128150A2, D5: DE10052524 A1, D6: WO2005/061073 A1 AND D7: WO 2005/115581 A1 in combination, present application for patent lacks in inventive step still stands as the applicant fails to persuade the same. Features of current amended claims are no inventive over cited documents as above and are not an invention u/s 2(1) (ja) of the Act.*
>
> *Hence the 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 of written submission have been fully considered accordingly."*

8. On a perusal of the impugned order it appears that there has been no application of mind whatsoever and the respondent no.1 has simply arrived at a conclusion without adverting to the facts and circumstances of the case and the arguments made on behalf of the appellant. The respondent authorities had not even followed the mandatory provisions of the Act as well as the Manual of Patent Office Practice and Procedure in determining the obviousness and lack of inventive steps of the subject invention. I also find that the entire reasoning under the heading "Scientific and Technical Analysis" in the impugned order is a replication from the prior arts and has been mechanically reproduced based on similar sounding components by

mosaicing of documents D1 to D7 without explaining the justification in combining the said documents. In *Terrel On the Law of Patents* (17th edition) at page 319, it is stated as follows:

> *"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."*

9. The respondents had not even considered the arguments of the appellant enumerated in the Response to the FER nor in the Written Submissions filed by the appellant. There are also no reasons in arriving at the conclusion that the subject invention lacked inventiveness.

10. The categorical stand taken by the appellant was that none of the cited prior arts were of any relevance at all. The cited documents D1 to D7 neither alone nor in combination were relatable to the replacement of liquid filter cartridges. This aspect of the matter has been completely ignored in the impugned order.

11. In view of the aforesaid, the impugned order is unsustainable and is set aside. The matter is remanded back to the Officer with a direction to dispose of the same within a period of eight weeks from date and after giving a right of hearing to the appellant. It is made clear that the aforesaid findings insofar as the merits of the case are concerned, are not binding on the Controller. The Controller shall be at liberty to adjudicate the matter afresh in accordance with law.

12. With the aforesaid directions, AID/14/2022 stands allowed.

(RAVI KRISHAN KAPUR, J.)

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