IN THE HIGH COURT AT CALCUTTA
SPECIAL JURISDICTION
ORIGINAL SIDE

BEFORE:
The Hon'ble Justice Ravi Krishan Kapur

AID NO. 15 OF 2022

IN THE MATTER OF

PROTEAN ELECTRIC LTD

VS

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 Defendant	: Ms. Rini Bhattacharya , Adv.
Reserved on	: 19.1.2023
Judgment on	: 06.04.2023

Ravi Krishan Kapur, J.:

1. This is an appeal under section 117A of the Patents Act 1970 (the Act) assailing an order dated 8 April 2022 passed by the Controller of Patents (the order).

2. The appellant had filed Patent Application No 1023/KOLNP/2014 on 13 May 2014 (the subject application) before the Indian Patent Office claiming priority from 19 October 2011 in the National Phase Entry in

India for an invention titled “AN ELECTRIC MOTOR OR GENERATOR”.

3. The appellant is engaged in providing automotive technology specializing in “in-wheel motor technology” which includes an in-wheel, electric-drive system for hybrid, plug-in hybrid and battery electric vehicles. The appellant has a global presence. Patent applications have been filed and granted in various jurisdictions for the subject invention.

4. Briefly, the subject invention relates to an electric motor or generator comprising of a rotor having a first set of magnet poles; a stator having first sensor mounted on the stator and a second sensor mounted in a substantially diametrically opposite position on the stator relative to the first sensor. The first sensor is arranged to output a first signal indicative of a first rotor flux angle associated with the first set of magnet poles as the rotor rotates relative to the stator. The second sensor is arranged to output a second signal indicative of a second rotor flux angle associated with the first set of magnet poles as the rotor rotates relative to the stator. Necessary means are arranged to determine a corrected rotor flux angle by

averaging the first rotor flux angle indicated in the first sensor and the second rotor flux angle indicated in the second sensor.

5. It is contended that the subject invention has the advantage of allowing the correlation between the commutation magnets and the drive magnets to be more accurately determined, thereby allowing the accuracy of an electrical phase angle determination to be increased with a resulting increase in operating efficiency of an electric motor or generator. An electric motor uses magnets to create motion and this motion is the initial source of energy for the engine. In the subject invention, two types of magnets are used namely the commutation magnets and drive magnets. This feature provides the technical advancement of allowing the correction between the commutation magnets and drive magnets to be more accurately determined, thereby allowing the accuracy of the electrical phase angle determination to be increased with a resulting increase in operating efficiency of an electric motoror generator avoiding the errors like loss of torque, torque ripple and acoustic noise decreasing the efficiency of electric motor. The subject invention helps improve the driving experience and generates more power as power goes straight from the motor to the wheel.

6. It is alleged that the respondent authorities have unduly procrastinated the process of examination. After a delay of almost 5 years, the First Examination Report (FER) was issued on 7 January 2019. The response to the FER was filed by the appellant on 3 July 2019. The matter was fixed for hearing on 10 August 2021. Thereafter, the date of hearing was repeated adjourned and finally the publication, examination and re-examination were completed after a delay of almost 8 years. There has been no compliance with the prescribed timelines as stipulated under the Act or the Rules framed thereunder. The entire process of examination has been marred by delay. The requests for multiple examinations and unnecessary requests for amendments are also unjustified and unwarranted.

7. It is also alleged that the Controller in the FER unjustifiably recommended changes with reference to a prior art D1 being US2008025858A1 dated 3 May 1984. Nevertheless, the appellant had responded to the FER on 3 July 2019 and also filed an amended application to deal with the objections raised in the FER. It is further alleged that the respondent authorities have failed to consider the response to the objections raised by them and mechanically forwarded the application for fresh investigation and re- examination instead of

approving the patent. It is also alleged that being unable to make out a case against the appellant's response to the FER, the respondent authorities raised further objections in the hearing notice with reference to 2 other documents being D2 and D3 despite all the amendments having been made in terms of the suggestions in the FER. All these actions unduly delayed the entire examination process.

8. It is also alleged that the Controller failed to appreciate and consider the difference between the claim of novelty and lack of inventive steps. The objections on the ground of lack of novelty and lack of inventive steps could not have coexisted having regard to the same prior art document being D1.

9. Section 14 and 15 of the Act read as follows:

> "14. *Consideration of the report of Examiner by Controller.— Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or other documents to ensure compliance with the provisions of this Act or of the rules made thereunder, the Controller, before proceeding to dispose of the application in accordance with the provisions hereinafter appearing, shall communicate as expeditiously as possible the gist of the objections to the applicant and shall, if so required by the applicant within the prescribed period, give him an opportunity of being heard.*
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> *15. Power of Controller to refuse or require amended applications, etc., in certain case.— Where the Controller is*

satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuses the application on failure to do so."

10. The primary grievance of the appellant is that the Controller of Patents proceeded to re-examine the application of the appellant despite the appellant having made all necessary amendments to the application in view of the objections raised by the Controller of Patents. The appellant also assails the raising of fresh citations being D2 and D3 in the hearing notice against the amended application.

11. Significantly, clause 9.04 of the Manual of Patent Office Practice and Procedure, provides that when an applicant re-files the documents post amendment, the application must be examined in a fresh manner by the Examiner and a Report with his observation must be forwarded to the Controller of Patents upon further examination of such application. If thereafter an application is found to comply with all the requirements of the Act and Rules, the Controller is expected to grant the patent.

12. From the provisions of the Manual, I find that the Controller has failed and neglected to adhere to the procedure for consideration of a re-filed application which is stipulated under the Act and Rules framed thereunder. The re-examination of a re-filed application is a mandatory procedure and the Controller was statutorily bound to follow the same.

13. I also find that the examination request was filed on 20 September, 2014. The First Examination Report was issued on 7 January, 2019. Despite affidavits, the respondent Controller has taken approximately 8 years to complete the entire process of examination. This is unacceptable and renders nugatory the sprit and object of the Act. There is also blatant violation of the statutory timelines provided under Rule 24 B of the Patent Rules 2003 for examination which has caused inordinate delay in the entire examination process. Moreover, the process of examination and subsequent steps leading to disposal of the application have been given a go-bye. The application had been re-examined and further examination reports were not issued to the appellant. The two new prior art documents cited in the hearing notice are in violation of the mandate of section 13(3) of the Act and alters the entire character of the examination.

14. Furthermore, the objection on the ground of novelty which inter alia concludes that in view of the prior art D-1, the subject invention lacked novelty and inventive steps also demonstrate non-application of mind by the Controller. The tests to determine novelty and obviousness are entirely different and can never co-exist with respect to the same document. The novelty of an invention can be questioned only when a single document which is prior published would contain a clear description of the claimed invention and the manner in which it has to be performed. In other words, when an objection is raised under lack of novelty it implies that each and every feature of the claimed invention is disclosed in a single prior art document and such prior art also contains an enabling disclosure of the invention. On the other hand, an invention shall not be considered to involve an inventive step if it is obvious to a person skilled in art. In passing the impugned order, the Controller has also disregarded the Written Submissions filed by the appellant under Rule 28 (7) of the Patent Rules 2003.

15. Moreover, in case where the Controller suggests or recommends amendments in respect of any prior art, it is natural to assume that the Controller is well versed with all such recommendations as

suggested so that the same do not coincide with any other prior art. Upon the necessary amendments being carried out, in accordance with the provisions of the Act and Rules, there is little room for further re-examination and for raising of fresh citation. In other words, the Controller ought to advice any applicant with a view to having the application made eligible for grant of the patent rather than with the aim of rejecting the same.

16. In this case, it is found that the necessary amendments as suggested by the Controller were duly carried out by the appellant and thereafter the application was re-filed for consideration. When an application is rectified in conformity with the recommendations of the Controller, it is fair to assume that such application would be allowed unless the application filed by the applicant fails to satisfy the requirements of the Act and the Rules framed thereunder. It is fundamental to the scheme of the Act that suggestions for amendments should not be made with a view to harass and persecute an applicant by raising new prior arts simply to deny the right of the applicant of being granted a patent as has been done in this case.

17. I find that the Controller of Patents erred in making unnecessary recommendations on the basis of the FER dated 7 January 2019.

Moreover, there has been undue, inordinate and unexplained delay in the matter by the office of the Controller which borders on being ill-motivated.

18. The impugned order is also liable to be set aside on the ground that the same is unreasoned. In *The State Bank of India & Anr. Vs. Ajay Kumar Sood 2022 SCC OnLine SC1067* it was held as follows:

> *"A judgment culminates in a conclusion. But its content represents the basis for the conclusion. A judgment is hence a manifestation of reason. The reasons provide the basis of the view which the decision maker has espoused, of the balances which have been drawn. That is why reasons are crucial to the legitimacy of a judge's work. They provide an insight into judicial analysis, explaining to the reader why what is written has been written. The reasons, as much as the final conclusion, are open to scrutiny. A judgment is written primarily for the parties in a forensic contest. The scrutiny is first and foremost by the person for whom the decision is meant - the conflicting parties before the court. At a secondary level, reasons furnish the basis for challenging a judicial outcome in a higher forum. The validity of the decision is tested by the underlying content and reasons. But there is more. Equally significant is the fact that a judgment speaks to the present and to the future. Judicial outcomes taken singularly or in combination have an impact upon human lives. Hence, a judgment is amenable to wider critique and scrutiny, going beyond the immediate contest in a courtroom. Citizens, researchers and journalists continuously evaluate the work of courts as public institutions committed to governance under law. Judgment writing is hence a critical instrument in fostering the rule of law and in curbing rule by the law."*

19. I find from the impugned order that the same is bereft of any reason. The impugned order simply arrives at conclusions without analysing the relevant facts pertaining to the subject patent. In such circumstance, the impugned order is unsustainable and liable to be set aside.

20. In view of the aforesaid, AID 15 of 2022 stands allowed. The matter is remanded back to the Controller for consideration afresh within a period of three months from the date of this order and after giving a right of hearing to the parties. It is made clear that the aforesaid findings insofar as the merits of the case are concerned, are not binding on the Controller.

(Ravi Krishan Kapur, J.)