OCD-3

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

IPDPTA/11/2023

SOUTHWIRE COMPANY, LLC (SR/07/2021/PT/KOL)
VS.
THE CONTROLLER GENERAL OF PATENTS AND DESIGNS AND ORS.

BEFORE:
The Hon'ble JUSTICE RAVI KRISHAN KAPUR
Date : 2nd May, 2023

Appearance:
Mr. S.Majumdar, Adv.
Mr. P. Sinha, Adv.
Mr. K. K. Pandey, Adv.
Mr. S. Sen, Adv.
Ms. Enakshi Saha, Adv.
…for the appellant

Mr. Indrajeet Dasgupta, Adv.
Mr. Sailendra Kumar Tiwari, Adv.
…for the respondents

The Court:-

1. This is an appeal against an order dated 13th August, 2020 passed by the Assistant Controller of Patents and Designs whereby the application being Patent Application No.3784/KOLNP/2010 filed by the appellant had been rejected.

2. Briefly, the subject application pertains to a system for porosity detection in metals while casting metal products. By the process involved in the subject invention, flaws in the casting can be monitored real time and corrected. Porosity in casting affects its mechanical properties and leads to breakage and wastage. Accordingly, the present invention seeks to correct

the chemistry and environmental conditions before molten metal solidifies in the casting process by use of software.

3. The subject invention has been titled as “Porosity Detection”. It is contended that when continuously casting metal products it is important to obtain the correct chemistry and environmental conditions before molten metal associated with the continuously casting process solidifies. During solidification, if the metal’s chemistry or cooling is incorrect, voids are ultimately formed in the casting process’ product. These voids may be detrimental to the product and may lead to ruptures at the time of manufacture. The mechanical attributes may also be subjected to adverse impact of the original product. Primarily, the subject invention comprises of a memory storage for maintaining a database and a processing unit coupled with the memory storage. Firstly, a natural temperature profile of the metal is created by the processing unit for casting from a first edge to a second edge. Subsequently, a second order polynomial is fitted to the natural temperature profile. Thereafter, the natural temperature profile may be compared to the fitted polynomial. It is then indicated that a void exists in the casting when in response to the comparison, a peak value of the natural temperature profile is less than a peak value of the second order polynomial. A porosity detection software code for use in the subject invention provides for the exact specification which may be ultimately required.

4. By the impugned order, the subject patent application has been rejected under section 2(1)(j) read with section 2(1)(ja) of the Patents Act, 1970 (the

Act). The impugned order has been passed on the basis that the claim does not constitute an invention and the same lacks inventive steps.

5. It is contended by the appellant that there are no reasons recorded in the impugned order and that the same has been passed ignoring the facts and circumstances of the case. There has been no regard to the specification of the subject patent and the submissions contained in response to the FER and the Written Submissions filed by the appellant. Furthermore, the First Examination Report and the hearing notice question the invention on the basis of prior arts D1 and D2. In the FER it has been observed as follows:

> *"D1 inherently discloses fitting a mathematical function but does not explicitly disclose fitting a mathematical function. However, D2 discloses fitting a mathematical equation that is more particularly a second order polynomial (e.g. col.7, lines 1-25). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to fit data with a mathematical function."*

6. It is also contended by the appellant that, the impugned order is silent insofar as the document D2 is concerned and the rejection of the subject application is only on the basis of D1 although the obviousness objection in the FER and the hearing notice were based on both D1 & D2. Thus, the impugned order ignores D2 in its totality and is *ex-facie* contrary to the records of the respondents in particular the hearing notice and the FER insofar as D1 is concerned. It is further contented that having waived the objection under section 3(k) of the Act and acknowledging that the invention is not a computer programme *per se* or algorithm, the impugned

order concludes that the submissions of the appellant are simply not persuasive and arrives at the conclusion of obviousness and lack of inventive steps under section 2(1)(ja) of the Act without giving any reasons. It is also contended that the finding in the impugned order on the basis of the document D1 is without application of mind. There has been a complete failure on the part of the respondent no.2 in not appreciating the inventive steps nor the economic significance of the subject patent. The impugned order does not consider the distinguishing feature of the invention with respect to cited prior arts D1 which is on the basis of reaching the conclusion of invention lacking inventive steps. The impugned order also does not take into consideration that a number of foreign countries have granted the subject patent. In such circumstances, the impugned order is liable to be set aside.

7. At the outset, I find that notwithstanding the fact that the respondent authorities had relied on two prior documents i.e., D1 and D2 as prior arts both in the hearing notice and FER, the impugned order is silent insofar as the D2 is concerned in the impugned order. Moreover, insofar as the reliance on D1 is concerned, it appears that there were major and significant differences between the present invention and D1 relied on by the respondent authorities and those have not been dealt with nor considered in the impugned order.

8. The operative portion of the impugned order reads as follows:-

> *9. The oral argument and the written submission of the agent of the applicant have been carefully considered. However without*

prejudice, although the hearing submissions have attempted to address the other requirements, yet the substantive requirement of the Patents Act, 1970 i.e. requirements of section 2(1)(ja) are not found complied with. Hence, in view of the above and unmet requirements, this instant application is not found in order for grant.

10. Therefore, keeping in view the above facts, the submissions of the agents during hearing and subsequently through the written submissions, as well as the outstanding official requirements, instant application no.3784 / KOLNP /2010 dated 11/10/2010 does not comply with the requirements of The Patents Act, 1970 (as amended). I, therefore, hereby order that the grant of a patent for application no. 3784/KOLNP/2010 is refused under the provisions of Section 15 of The Patents Act, 1970 (as amended).

9. I also find that there are no reasons in the impugned order. The impugned order has been passed in a mechanical manner without discussion of the facts and circumstances of the case. Insistence on recording of reasons is meant to serve the wider principle of justice that justice must not only be done, it must also appear to be done as well. Reasons also reassure that discretion has been exercised by decision maker on relevant grounds and by disregarding extraneous considerations.(*Kranti Associates Private Limited & Anr. Vs. Masood Ahmed Khan & Ors. (2010) 9 SCC 496)*

10. In view of the aforesaid, the impugned order is unsustainable and is set aside with the following directions:–

    a) Offer a fresh hearing in the matter to the appellant within four weeks from the communication of the order.

b) Consider and permit the appellant to make amendments, if any, in the application/specifications in accordance with law.

c) Permit the appellant to rely upon additional documents, if any and consider such documents while deciding the application.

d) Dispose of the application within eight weeks from the date of communication of this order.

11. It is clarified, that in case the appellant is directed to furnish a response with respect to D1 and the inapplicability of the same to the present invention, both as a standalone document or in conjunction with D2, the same shall be considered in accordance with law.

12. With the aforesaid directions, IPDPTA/11/2023 stands allowed.

13. It is made clear that the aforesaid findings are *prima facie* in nature and shall not bind the Officer when disposing of the subject application on merits.

(RAVI KRISHAN KAPUR, J.)

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