OCD-9

IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
[COMMERCIAL DIVISION]

IPDPTA/28/2023

SYSMEX CORPORATION (OA/25/2020/PT/KOL)
VS
THE CONTROLLER OF PATENTS AND DESIGNS AND ORS.

BEFORE:
The Hon'ble JUSTICE RAVI KRISHAN KAPUR
Date : 18th April, 2023

Appearance:

Mr. S Majumdar, Adv.
Mr. P. Sinha, Adv.
Mr. K. K. Pandey, Adv.
Mrs. M. Dasgupta, Adv.
Ms. E. Saha, Adv.

Mr. Indrajeet Dasgupta, Adv.
Mr. Sailendra Tiwari, Adv.

The Court:-

1. This appeal is directed against an order dated 31st January, 2020 whereby, the subject patent application being Application No. 374/KOL/2011 filed at the Kolkata Patent office as Conventional Application claiming priority of application filed in Japan having application no. 2010-069186 dated 25th March, 2010, for grant of patent in respect of *'SAMPLE ANALYZER AND REAGENT INFORMATION OBTAINING METHOD'* has been rejected.

2. The subject invention is a sample analyser for diagnostic purposes and a method for obtaining reagent information. Sample analyser analyses the blood specimen for proteins relating to infectious diseases, antigens, antibodies, thyroid hormone, tumor marker etc., by using a reagent contained in a reagent container mounted on a circular reagent container holder, including an electronic tag on which a reagent information is recorded and obtained.
3. The technical advancement of the present invention over the prior existing automatic analyser lies in being more compact with less number of components resulting in decrease in the size of the body of the analyser device, achieving same results as prior existing analyser devices and making the method of obtaining reagent information easier since the readable range of the antennae are smaller due to their size.
4. By the impugned order, the application has been rejected on the ground of lack of inventive steps/obviousness under Section 2(1)(ja) of the Act.
5. It is contended by the appellant that, the impugned order records that the application was re-examined under Section 13(3) of the Patents Act, 1970 (the Act) and a Report was prepared by Examiner and shared with Controller. However, the gist of the objections were never provided to the appellant as stipulated under Section 14 of the Act. The Examiner after conducting a fresh search in the second round of examination found five new prior arts namely, D5, D6, D7, D8 and D9. However, no Second Examination Report (SER) was issued even though new prior arts were

cited raising fresh objections in the hearing notice which is *ex facie* contrary to sections 13(3) and 14 of the Act read with Rules 28 and 28 A of the Rules framed thereunder.

6. It is further contended that in the hearing notice, it was observed by the Controller that the amended claims 1 to 20 were substantially unchanged with respect to the originally filed claims. It is alleged that, the Assistant Controller erred in citing five new documents at the hearing notice after re-examination. Thus, the application was not examined in accordance with the prescribed mandatory stipulations. Thus, the impugned order is the result of an incomplete examination in terms of the Act and is liable to be set aside.
7. It is further contended that the entirety of paragraph 3 of the impugned order is a copy-paste of the written submissions of the appellant regarding the cited prior arts D1, D2, D3, D4, D6, D7 and D9 and the impugned order has been passed without application of mind and in a mechanical manner.
8. It is also submitted that the order passed is an unreasoned order. In passing the impugned order, the Controller has simply arrived at conclusions without dealing with the facts of this case.
9. Insofar as the respondent authorities had failed to issue the SER even though admittedly new prior arts were cited and objections raised in respect thereof, I find that there has been no compliance with section 13(3) of the Act.

10. The finding that the subject invention lacks inventive steps under section 2(1)(ja) of the Act is also erroneous and contrary to all settled principles. In passing the impugned order, the respondent no.3 has failed to appreciate section 2(1)(ja) of the Act in its true perspective and has in fact, misinterpreted the same. The piecemeal approach adopted by the respondent no.3 by comparing various aspects of the subject invention with chosen portions of the cited prior art documents is impermissible. In passing the impugned order, the Controller also failed to consider the technical advancements made in the subject invention.

11. I also find merit in the submissions made on behalf of the appellant that the entirety of paragraph 3 of the impugned order is a copy paste of the Written Submissions filed by the appellant. This also reflects that the impugned order has been passed in a mechanical manner without any application of mind.

12. There are also no reasons in the impugned order. The impugned order merely arrives at conclusions without any element of 'why' to support the same. It is well settled that reasons are the safeguard against the *ipse dixit* of decision-making process and is an indispensable component of the decision-making process. [*Kranti Associates Private Limited & Anr. Vs. Masood Ahmed Khan & Ors. (2010) 9 SCC 496, Uniworth Resorts Ltd. & Anr. Vs. Ashok Mittal & Ors. 2007 SCC OnLine Cal 535* and *Santanu Ghosh & Ors. Vs. The State Bank of India & Ors. (2013) 3 CLT 486*].

13. In such circumstances, the impugned order is set aside. The subject patent application shall be disposed of by an appropriate Officer in the following manner:-

    a) To issue a Second Examination Report (SER) within three weeks from the date of communication of this order and allow the appellant to submit its Reply to the SER within three weeks thereafter.

    b) Hearing, if any, may be offered within two weeks from the date of filing of the reply to SER by the appellant and to dispose of the application within four weeks from the date of hearing.

14. In case, any prior arts are relied on or cited by the respondent authorities, the respondents shall demonstrate with reasons as to how on a coherent thread of the relevant passages the cited prior arts are relevant. It is clarified that nothing in this order shall be binding on the respondent authorities insofar as the merits of the case are concerned.

15. With the aforesaid directions, IPDPTA /28/2023 stands disposed of.

(RAVI KRISHAN KAPUR, J.)

D.Ghosh