IN THE HIGH COURT AT CALCUTTA
INTELLECTUAL PROPERTY RIGHTS DIVISION
ORIGINAL SIDE

BEFORE:
The Hon'ble Justice Ravi Krishan Kapur

IPDPTA/3/2025

ADVANCED ELECTRIC MACHINES GROUP LIMITED
VS
THE CONTROLLER OF PATENTS DESIGNS AND TRADEMARK

For the petitioner : Mr. Subhotosh Majumdar, Adv.
Ms. Mitul Dasgupta, Adv.
Mr. K. K. Pandey, Adv.
Mr. Teesham Das, Adv.
Ms. Pooja Sett, Adv.
Mr. Mallika Bothra, Adv

For the respondents : Mr. Dhruv Surana, Adv.
Ms. Sumita Sarkar, Adv.

Judgment on : 9 April, 2025

RAVI KRISHAN KAPUR, J.:

1. This appeal is directed against an order dated 28 October 2024 whereby an application for invention relating to an electrical sub-assembly for use in electric/hybrid vehicles has been rejected. The object of the invention was to provide improved electrical sub-assembly so that the suitability of Switched Reluctance Machines(SRMs) as speed drives in order to generate motion for commercial applications, particularly hybrid electric vehicles (HEVs) and electric vehicle (EVs), would improve.
2. It is contended on behalf of the appellant that the technical effect of the invention is reduction in the total components in the SRM to build a motor of type claimed, i.e., fewer busbars, which improves ease of manufacture and allows for lighter more compact motor designs. The subject invention is

targeted to reducing the number of electrical components, e.g. busbars, required to connect the drive configuration to the coils of the stator and enhance the suitability of SRMs for commercial applications.

3. By the impugned order, the application of patent has been rejected on the sole ground of lack of inventive steps under section 2(1)(ja) of the Act having not been complied with.

4. On behalf of the appellant, it is contended that the impugned order is a non-speaking and cryptic order. There are no reasons whatsoever in the impugned order and the same proceeds in a mechanical manner without discussing or taking into account any of the materials relied on by the appellant. The conclusion that the invention is obvious is without any reason and is based on a misconception of the subject invention. In any event, no Second Examination Report had been issued though new document cited in hearing notice and on this ground alone the impugned order is liable to be set aside. The new document D3 cited in the hearing notice for the first time was a Japanese document without any English translation on record and was inadmissible. Though the impugned order primarily refers to figure 1 and figure 5 of the invention and compares it with figure 7 of the prior art D3, there has been no explanation nor any justification as to why the respondent authority has sought to re-draw figures 3 and 5 in the subject invention. The impugned order does not take into account the well established principles laid down in deciding inventive steps. The impugned order also fails to analyse the existing knowledge and how the persons skilled in the art would understand the invention. There has also been no discussion of the prior arts D1 and D2 despite the hearing

notice referring to the same. The respondent has also failed to take into account the fact that the subject invention had been granted in other jurisdictions. In support of such contentions, the appellant relies on the decisions in *Telefonaktiebolaget LM Ericsson (PUBL) vs. The Controller of Patents and Designs and Ors.* order dated 29.11.2021 in AID/8/2021 passed by the High Court at Calcutta, *Guangdong OPPO Mobile Telecommunications Corp. Ltd. vs. The Controller of Patents and Designs,* order dated 13.06.2023 in AID 20 of 2022 by the High Court at Calcutta, *Agriboard International LLC. vs. Deputy Controller of Patents and Designs 2022 SCC OnLine Del 940* and *Sysmex Corporation (OA/25/2020/PT/KOL) vs. The Controller of Patents and Designs and Ors.* order dated 18.04.2023 in IPDPTA/28/2023 by the High Court at Calcutta.

5. On behalf of the respondent it is submitted that the impugned order justifies no interference and the same is adequately reasoned.

6. On a perusal of the impugned order, it appears that the impugned order has merely reproduced the extracts from the hearing notices and failed to consider and discuss the submissions of the appellant. There has also been no discussion of the objections raised in the F.E.R. or the hearing notices. On the contrary, the respondent has proceeded on an erroneous interpretation and misunderstanding of the subject invention. The procedure followed by the respondent in referring to the prior art D3 is also erroneous and contrary to the Act. D3 was cited only after a fresh examination had been carried out and after amendments were made to the F.E.R. As such, before passing the impugned order, the respondent failed to comply with the mandatory legal requirements under the Act of issuing a

Second Examination Report (SER). In any event, the new document D3 was in Japanese and no translation had been provided to the appellant. In this context, the law categorically requires a party to make available English translations in all proceedings where documents are in a foreign language. This fact is not disputed by the respondent authorities. The obligation to make available English translations is also mandated under Rules 20(3)(b), 20(5), 20(6), 21(2) and 61(2) of the Patent Rules, 2002 which ought to apply to respondent authority as well.

7. By the impugned order, the respondent has concluded the shift in the scope of the invention as presented in the previous claim number 1, without clarifying as to how and where the scope of the invention had changed. The respondent failed to appreciate that both independent and dependent claims fell within the scope of the invention. The tests repeatedly reiterated in deciding inventive steps by the Courts have been ignored. In *Avery Dennison Corporation* v. *Controller of Patents and Designs* (2022/DHC/004697), it has been held as follows:

Test for Inventive Step/Lack of Obviousness

10. In order to decide this issue, some of the fundamental principles for determining the existence of an inventive step and the lack of obviousness need to be emphasised.

11. For determining inventive step or lack thereof, various approaches and tests have emerged over the years from decisions of courts/authorities as also from examination guidelines of patent offices from different jurisdictions. The same include:

i. Obvious to try approach:

• *This approach involves an analysis of whether in view of the teachings/solutions proposed in the prior art, it was obvious to try and arrive at the subject invention.*

ii. Problem/ solution approach:

> *• This approach considers whether in the light of the closest prior art and the objective technical problem, the solution claimed in the invention would be obvious to the skilled person. If the skilled person can decipher the solution being claimed, then the subject matter is held to be obvious.*
>
> *• This test has been discussed by the Division Bench in* F. Hoffmann-La Roche Ltd. *v.* Cipla Ltd., *(2016) 65 PTC 1 (Del).*

iii. Could-Would Approach

> *• In this approach the question that is raised is whether there is any teaching in the prior art as a whole that would and not simply could have prompted a skilled person, with the knowledge of the objective technical problem, to either modify or adapt the closest prior art to arrive at the subject matter of the claims.*

iv. Teaching Suggestion Motivation (TSM test)

> *• This test originated in the USA as per which, if by the Teaching, Suggestion or Motivation from the prior art, an ordinary skilled person can modify the prior art reference or combine prior art references to arrive at the claimed invention, then the subject matter being claimed is obvious.*
>
> *• However, the application of this test ought not to be done in a narrow manner as held by the US Supreme Court in the case of* KSR International *v.* Teleflex, *550 US 398 (2007).*

8. In *Agriboard International LLC vs. Deputy Controller of Patents and Designs 2022 SCC OnLine 940* it has been held:

> *"24. In the opinion of this Court, while rejecting an invention for lack of inventive step, the Controller has to consider three elements-*
>
> *• the invention disclosed in the prior art,*
>
> *• the invention disclosed in the application under consideration, and*
>
> *• the manner in which subject invention would be obvious to a person skilled in the art.*

> *25. Without a discussion on these three elements, arriving at a bare conclusion that the subject invention is lacking inventive step would not be permissible, unless it is a case where the same is absolutely clear. Section 2(1)(ja) of the Act defines 'inventive step' as under:*
>
> *(ja) "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.*
>
> *26. Thus, the Controller has to analyse as to what is the existing knowledge and how the person skilled in the art would move from the existing knowledge to the subject invention, captured in the application under consideration. Without such an analysis, the rejection of the patent application under Section 2(1)(ja) of the Act would be contrary to the provision itself. The remaining prior arts which are cited by ld. Counsel having not been considered in the impugned order, the Court does not wish to render any opinion in this regard."*

9. The impugned order has no reasons to justify the conclusion that the subject invention is obvious. The additional documents sought to relied on during the hearing of this appeal cannot add or supplant the impugned order. The finding in the impugned order that in causing amendments to the first written submission there is a change in scope of the invention is unreasoned and unsubstantiated. On the contrary, an inadvertent typographical error had crept to the characterisation in the Submissions of the appellant before the Controller in respect of "pair of diodes" which ought to have been "214, 314, 414 and 514" instead of "212, 312, 412 and 512" which were also in fact numerals for the coils. This inadvertent error has been mechanically and blindly followed by the respondent authorities. The erroneous numbering is *ex facie* apparent and was corrected after the first hearing in the Written Submission filed by the appellant which has gone unnoticed. The findings in the impugned order are also irreconcilable. The change in the scope of figure no.5 of the invention without any discussion is

erroneous. The attempt of the Controller to improve upon the order is unsustainable and the findings in this regard are contradictory. There is no discussion in the impugned order on the prior arts D1 and D2 and this is glaring infirmity in the order. A conjoint reading of the FER, hearing notice and the impugned order reveals the inconsistencies in the understanding of the scope of the subject invention. The finding that "D3 discloses pairs of antiparallel diodes having three electrical terminals and a point of common coupling" is also without any basis or discussion.

10. In the impugned order the respondent has throughout compared Fig 7 of D3 (a star configuration) with Fig 5 of the invention and found that if the star configuration of Fig 7 of D3 is converted to Delta Configuration as in Fig 5 it would be obvious to person skilled in the art to arrive at the configuration present in Fig 5. There is no explanation as to why a person would convert a star configuration to Delta in the invention when such a change in configuration would result in change in the entire circuit which is not the subject invention. The impugned order is based on surmises and conjectures and this is an inherent flaw in the impugned order. In passing the impugned order, the respondent has taken the prospective of hindsight analysis when the fact remains that document D3 was silent about delta configuration. The subject invention does not disclose the configuration which forms the basis of the rejection of the subject application. It is well settled that an objection to an inventive step can only be raised on the basis of the prior art and not by creating different versions of embodiments of the prior arts with the only aim to reject the subject application. The inconsistent positions taken in the impugned order is further demonstrable

in the finding that "if the figure 3 and 5 are redrawn, a conclusion…". There is also no reference nor mention of the comparison between figure 4 and 5 in the impugned order whereas the attempt to draw a comparison between the two during the hearing of this appeal by the respondent is impermissible.

11. In view of the above, the impugned order is unsustainable and set aside. The matter is remanded to a different Officer for hearing afresh. The above exercise is to be completed within a period of eight weeks from the date of passing of this order.

12. To the above extent, IPDPTA 3 of 2025 stands allowed. It is made clear that there has been no adjudication on the merits of the case. All questions are left open to be decided in accordance with law.

(Ravi Krishan Kapur, J.)