



IPAB Intellectual Property Appellate Board

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OA/46/2015/PT/KOL
MONDAY, THIS THE 21ST DAY OF DECEMBER, 2020

HON'BLE SHRI JUSTICE MANMOHAN SINGH
HON'BLE DR. B.P. SINGH

CHAIRMAN
TECHNICAL MEMBER (PATENTS)

1. **ALSTOM TECHNOLOGY LIMITED**
A CORPORATION ORGANIZED AND EXISTING UNDER
THE LAWS OF SWITZERLAND, OF BROWN BOVERI
STRASSE 7, 5400 BADEN, SWITZERLAND

...APPLICANT/APELLANT

(Represented by: Mr Deepak Srinivas)

Versus

1. **THE CONTROLLER GENERAL OF PATENTS, DESIGNS,
AND TRADE MARK,**
HAVING THE OFFICE AT BOUDHIK SAMPADA BHAVAN,
NEAR ANTOP HILL POST OFFICE, S.M.ROAD, MUMBAI -
400 037 AND ALSO AT THE HEAD OFFICE OF THE PATENT
OFFICE AT BOUDHIK SAMPADA BHAVAN, DP-2, SECTOR
V, SALT LAKE (BIDHANAGAR), KOLKATA-700 091, INDIA
2. **THE ASSISTANT CONTROLLER OF PATENTS &
DESIGNS**
HAVING HIS OFFICE AT BOUDHIK SAMPADA BHAVAN,
DP-2, SECTOR V. SALT LAKE, (BIDHANAGAR),
KOLKATA - 700 091, INIDA
3. **THE EXAMINER OF PATENTS AND DESIGNS,** HAVING
HIS OFFICE AT BOUDHIK SAMPADA BHAVAN, DP-2,
SECTOR V. SALT LAKE,
(BIDHANAGAR), KOLKATA - 700 091, INIDA

...RESPONDENT

(Represented by - None)

ORDER

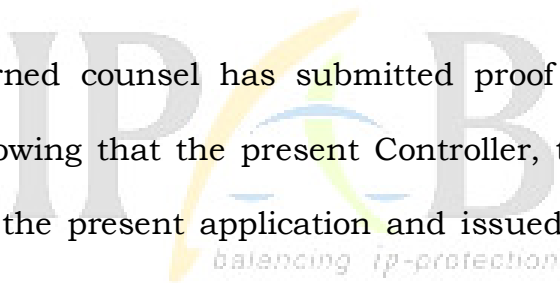
Hon'ble Shri Justice Manmohan Singh, Chairman

Hon'ble Dr. B.P. Singh, Technical Member (Patents)

1. The present appeal is filed under Section 117A of the Indian Patents
Act, 1970, against the order dated 14/12/2012, passed by the

Respondent no.2, being the Assistant Controller of Patents & Designs, under Section 15 of the Indian Patents Act, refusing to grant the Appellants' Indian patent application no. 877/KOL/2005.

2. On compliance of the order of this Board dated 14/12/2020, the appellant has amended of memos of the parties; removing the name of the examiners therefrom. Therefore, the memo of the parties is in order now.
3. The learned counsel for the appellant has submitted his argument before this Board only on one issue; i.e. violation of the principles of natural justice, particularly so, as the learned Controller who has passed the impugned order dated 14/12/2012 in patent application no. 877/KOL/2005, was himself the examiner, who examined the instant patent application and hence it's the case *that no person can be a Judge of his own cause.*
4. The learned counsel has submitted proof of First examination Report showing that the present Controller, then as examiner has examined the present application and issued the report as shown below:



SUB : FIRST EXAMINATION REPORT
REF : PATENT APPLICATION NO : 00877/^{KOL}~~KOL~~/2005. 877/KOL/2005
By ALSTOM TECHNOLOGY LTD.,

With reference to the request no 2355-RQ-Kol/06 made on 18.5.2006 by Alstom Technology Ltd., for examination the above quoted application has been examined under section 12 of the Patents Act, 1970 as amended and the First Examination Report containing a statement of objection is forwarded herewith for compliance thereof.

The document enclosed shall be resubmitted within 12 (Twelve) months from the date of issue of the said report together with your observation if any, in connection with the compliance of the requirements of the First Examination Report.

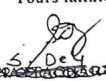
The application referred to will be deemed to have been abandoned under section 21(1) unless all the requirements imposed by the said Act and the rules there under are complied with within the above said prescribed period.

The pages of the complete specification should be freshly typed wherever corrections or interpolation are made. The typed pages in duplicate should be on white pages in order that clear photocopies of the specification can be prepared. The original pages in that case should be returned to this office duly cancelled.

It is in the interest of the applicant to comply with the requirements at the earliest.

Enclosures :-
Appln.,
Specn.,
Drgs.,
Form-3.,
Form-5.,
Power of Attorney.,
Annexure to Form-3..

Yours faithfully,


(S. De)
EXAMINER OF PATENTS & DESIGNS.
For DY./ASST. CONTROLLER OF PATENTS & DESIGNS.

- 4.1 During issuance of the Second Examination Report (SER) dated 15/09/2008, the concerned examiner was the same

person as is evident from the report shown below:


Sub : Patent Application No. 877/KOL/2005.

Sir,

With reference to your office letter dt. 18/07/08 as the above subject, I would like to inform you as follows :-

1. Requirement of Para 2 of this office letter dated 10/3/08 has still not been met. In this context your attention may kindly be drawn the claims of EP specification (application No-EP05 021227) (to be granted).
2. In view of proposed amended claims description should be amended accordingly.
3. Without prejudice closest art WO 2004/108254 should be referred to in the prior art & explain the distinguishing feature.
4. Last date will expires on 10.03.2009.

Thanking you,

Yours faithfully,

(S. DEY)
Examiner of Patents & Designs.
For Asstt. Controller of Patents & Designs.

4.2 Again a subsequent examination report was prepared by the same examiner as indicated below:

u P

No. : 877/KOLNP/2005 - F. Date : 2.12.2008

To
Dr.(Mrs.) S. Banerjee
C/o.M/s. L. S. Davar & Co.,
Kolkata.

Sub : Patent Application No. 877/KOLNP/2005.

Madam,

With reference to your office letter dtd. 24/9/08 on the above subject, I would like to inform you as follows :-

1. On further scrutiny it has been found that submitted claims is still lacking in novelty in view of document WO 2004/108254. On page 14 of the said document it discloses a carbonaceous sorbent which is injected into the flue gas of a solid fuel plant for the purpose of capturing of mercury. Moreover page 8 discloses the temperature of the flue gas at the injection point is around 600° to 800° F and the temperature of the flue gas at the removal location, The PSD/fabric filter, is in the range of 200° -370° F. Hence claims 1, 2, 3, 6, 7, 8 & 9 are not novel.
2. Subject matter of claims can not be considered to involve with inventive step in view of document WO 2004/108254 & US 2004/003716.
3. Claim 10 is not clear as there is mentioned that the enhancement of the deposition of carbon sorbent takes place, but how it is achieved is not clear.

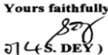
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: Page 2 :

877/KOLNP/2005 - F.

4. If you further like to discuss this matter you may call on me on any working day during office hours.
5. Last date will expires on 10.03.2009.

Thanking you,

Yours faithfully,

(S. DEY)
Examiner of Patents & Designs.
For Asstt. Controller of Patents & Designs.

(8)
05/12/08

4.3 The impugned order dated 14/12/2012, against which this appeal has been filed, is also issued by the same person as Assistant Controller of Patents and Designs. The last page of the impugned order is quoted herein below:

Hence all the issues of the written arguments submitted by the agent of the applicant are discussed and I am therefore convinced that the alleged invention as described and claimed as claims 1 to 17 in the complete specification are not allowable under U/S 2(1)(j) of The Patents Act.

I therefore refuse the application for Patent under Section 15 of The Patents Act, 1970.



(Santanu Dey)

Assistant Controller of Patents and Designs

Dated: 14/12/2012

C.C. to:

- 1] Sri P.D. Gupta,
C/o. M/s. L.S. Davar & Co.
32, Radha Madhab Dutta Garden Lane,
Kolkata-700 010.
- 2] The Head of the Office,
The Patent Office,
Bouddhik Sampada Bhawan,
CP-2, Sector-V,
Salt lake, Kolkata-700 091

4.4 The learned counsel of the appellant submits that it becomes very much evident that the person, who has passed the impugned order and the author of First Examination Report, the Subsequent Examination Report (1), and the Subsequent Examination Report (2) are one and the same.

4.5 In support of his argument he also refers to an earlier order of this Board in OA/23/2011/PT/DEL wherein this Board held:

“11. The next contention is that the first examination report as well as the author of the impugned order are one and the same and the perusal of the first examination report and the impugned order substantiate the contention of the learned counsel for the appellant as it is very much evident that the person, who has passed the impugned order and the author of first examination report are one and the same. It is against the well-established principle that no man can be a Judge for his own cause....”

5. The scheme of the Patents Act, 1970 and the role of the examiner and the Controller is statutorily defined in sections 12-15 quoted herein below for reference:

Section 12¹

Examination of application

*(1) When a request for examination has been made in respect of an application for a patent in the prescribed manner under sub-section (1) or sub-section (3) of section 11B, the application and specification and other documents related thereto shall be referred at the earliest **by the Controller to an examiner for making a report** to him in respect of the following matters, namely:—*

(a) whether the application and the specification and other documents relating thereto are in accordance with the requirements of this Act and of any rules made thereunder;

(b) whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;

(c) the result of investigations made under section 13; and

(d) any other matter which may be prescribed.

*(2) **The examiner to whom the application** and the specification and other documents relating thereto are referred under sub-section (1) **shall ordinarily make the report to the Controller** within such period as may be prescribed. [Emphasis added]*

Section 13²

¹ Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps12.html>

Search for anticipation by previous publication and by prior claim.

*(1) **The examiner to whom an application** for a patent is referred under section 12 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification—*

(a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in India and dated on or after the 1st day of January, 1912;

(b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

*(2) **The examiner shall, in addition, make such investigation** for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by publication in India or elsewhere in any document other than those mentioned in sub-section (1) before the date of filing of the applicant's complete specification.*

(3) Where a complete specification is amended under the provisions of this Act before the grant of patent, the amended specification shall be examined and investigated in like manner as the original specification.

² Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps13.html>

(4)The examination and investigations required under section 12 and this section shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon.[Emphasis added]

Section 14³

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.*

Section 15⁴

*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

³ Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps14.html>

⁴ Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps15.html>

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 refuse the application on failure to do so.

6. Therefore, it is amply clear that the roles of the examiner and the Controller are uniquely defined in the statute and it is never expected that same person will prepare the examination report after conducting the examination and will receive the report himself as per the teachings of section 14 and take final action in accordance with provisions of section 15 as well. If this was done, it is a clear violation of principle of natural justice.
7. Hon'ble Supreme Court in *Canara Bank vs V.K. Awasthy*⁵ held that *"Over the years by a process of judicial interpretation two rules have been evolved as representing the principles of natural justice in judicial process, including therein quasi-judicial and administrative process. They constitute the basic elements of a fair hearing, having their roots in the innate sense of man for fair-play and justice which is not the preserve of any particular race or country but is shared in common by all men. The first rule is 'nemo judex in causa sua' or 'nemo debet esse judex in propria causa sua' as stated in (1605) 12 Co.Rep.114 that is, 'no man shall be a judge in his own cause' Coke used the form 'aliquis non debet esse judex in propria causa quia non potest esse judex at pars. (Co.Litt. 1418), that is, 'no man ought to be a judge in his own case' because he cannot act as Judge and at the same time be a party' The form 'nemo potest esse simul actor et judex', that is, 'no one can be at once suitor and judge' is also at times used."*
8. The Patent office follows this practice and tries referring the matter to some other Controller in case of his/her promotion from the post

⁵ Available at <https://indiankanoon.org/doc/1086058/>

of examiner. Somehow, in the instant application the practice hasn't been followed.

9. The Controller, herein, must have acted and written his order in complete fairness but the principle of natural justice demands that the element of biasing, as raised by the appellant, must be totally removed from the minds of the appellant.
10. Therefore, in the interest of justice, and to remove all short of confusion from the mind of the appellant, we are of the opinion that the order of the Controller is to be set aside.
11. It is also pertinent to mention that since the matter was not argued on technical merit of this case, this order restrict itself to the lone issue of natural justice.
12. We, therefore, set aside the impugned order dated 14/12/2012 issued by the respondent no 2, and direct the respondents to refer the matter to some other Controller, who may decide the matter in accordance with law; giving fair opportunity of being heard to the applicant, within 3 months from the issuance of this order.
13. Keeping in view the above facts and circumstances, the instant appeal is allowed. No cost.

-Sd/-

(Dr. B.P. Singh)
Technical Member (Patents)

-Sd/-

(Justice Manmohan Singh)
Chairman

Disclaimer: This order is being published for present information and should not be taken as a certified copy issued by the Board