

Patent | Case Law Update

Court Emphasizes Reasoning and SER Requirement

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In June, Guangdong Oppo Mobile Telecommunications Corp., Ltd (Oppo), a leading electronics manufacturer, approached the Calcutta High Court to appeal the rejection of their patent application in August 2022 by the Controller of Patents and Designs (Controller). The invention related to a charging system, method, and power adapter for mobile terminals. It used a pulsating ripple waveform to achieve faster charging, cost-efficiency, and longer battery life while eliminating the need for an electrolytic capacitor in the adapter. The Court identified four key issues in this case and set aside the Controller's order:

- The validity of the rejection of a patent under the Act,
- Lack of reasoning and absence of reasons for rejection in the impugned order,
- Did the Controller err in considering prior art documents in combination and finding a lack of novelty and inventive steps, and
- Violation of statutory provisions under the Act due to the failure to issue an SER?

Oppo had argued that the rejection lacked reasoning and that the terms "novel" and "inventive" had been used interchangeably despite specific definitions outlined for each term in the Indian Patents Act, 1970 (the Act). Oppo also claimed that additional prior art documents were cited at the hearing stage, without providing them with a chance to respond. It also emphasized that the Controller had failed to establish any logical connection and the common thread between the prior art and claims. Oppo also criticized the absence of a Second Examination Report (SER), thus eliminating a stage to examine amended claims. Oppo further highlighted the importance of

a comprehensive examination process that includes the evaluation of amendments made to the claims.

Agreeing with Oppo, the Court held that the impugned order lacked reasoning and failed to establish how the prior art document cited by the Controller contained all the features of the subject invention. The Court also observed that the Controller improperly combined multiple prior art documents without establishing a coherent thread connecting them. Citing *Enercon (India) Limited v Aloys Wobben* and *Avery Dennison Corporation v Controller of Patents and Designs*, the Court emphasized that a combination of prior art documents is impermissible unless there is an obvious common thread linking the claim and the prior art documents, as ascertained by a person skilled in the art. The Court reiterated the distinction between novelty and inventive steps and clarified that they cannot coexist in connection with the same document.

Additionally, the Court deemed the Controller's failure to issue an SER, as non-compliance and violation of statutory provision under section 13(3) of the Act, which mandates the examination of amended claims and the issuance of an SER.

Based on these findings, the Court set aside the impugned order and remanded the patent application back to the Controller for reconsideration. The Controller was instructed to issue an SER. The Court granted Oppo the opportunity to respond to any objections raised in SER besides, being given the right to be heard before the final disposal of the application.