

* IN THE HIGH COURT OF DELHI AT NEW DELHI

% *Judgment Reserved on: 15th December, 2022*
Judgment Delivered on: 23rd December, 2022

+ **C.A.(COMM.IPD-PAT) 111/2022**

N.V. SATHEESH MADHAV AND ANR Appellants
Through: Ms.Meenakshi Ogra, Mr.Tarun
Khurana and Mr.Vikramaditya Singh,
Advocates.

Versus

DEPUTY CONTROLLER OF PATENTS AND
DESIGNS Respondent
Through: Mr.Manish Mohan, CGSC and
Mr.Jatin Teotia, Advocates.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

JUDGMENT

AMIT BANSAL, J.

1. The present appeal under Section 117A(2) of The Patents Act, 1970 (*hereinafter "the Act"*) impugns the order dated 14th September, 2018 passed by the Deputy Controller of Patents and Designs, whereby the appellant's application for grant of the patent bearing no.2924/DEL/2008 has been refused.

Brief Facts

2. The brief facts necessary for deciding the present appeal are set out hereinafter:

- I. The aforesaid patent application was filed with provisional specification on 23rd December, 2008 at the Delhi Patent Office. Subsequently, a complete specification with ten claims was filed with the Patent Office. Along with the complete specification, the appellants also filed a duly filled Form 18 as the Request for Examination of the said patent application on 23rd December, 2009.
- II. A First Examination Report (FER) was issued on 30th March, 2017, in terms of which, an objection was raised that the claims lack inventive step in view of the prior-art documents referred to as D1, D2, D3, D4, D5 and D6 and therefore, do not constitute an invention under Section 2(1)(j) of the Act. The FER also raised an objection under Section 3(h) of the Act stating that the subject matter claimed in claims 1-6, claim 9 and claim 10 relates to a method of agriculture and, therefore, not patentable.
- III. In addition to the objections of inventive step and non-patentable subject matter, the FER also raised objections on the scope and clarity & conciseness of the claims. The said objections are extracted below:

“SCOPE:

(xvi) Claim(s) 1-10 does/do not define the scope of invention for which the protection is claimed for the following reasons:

(a) The expression ‘nutrients’ [claim 1] is broad in scope. Use of said expression makes the scope of claims unclear.

(b) Claim 1 is oriented to the preparation of bio bed from non-absorbent cotton. The claim does not clearly define the bio bed preparation steps.

(c) Claim 6 recites 'the growth was registered during the study period'. However, the claim does not define the steps needed to be performed in order to register the growth.

(d) Claims 9 and 10 define the results achieved using the claimed method and the advantages of said method but do not define any technical feature of the claimed method necessary to achieve the claimed results and thus fail to clearly define the scope of protection sought."

CLARITY AND CONCISENESS:

(xvii) Claim(s) 1-10 are not clearly worded in respect of:

(a) Claim 2 fails to clearly convey the claimed subject matter. It is not clear how a method can be treated with purified water. Similar objection applies to claim 6 also.

(b) Claim 5 recites 'controlled manner'. The technical features represented by said expression are unclear.

(c) It is not clear how much quantity of hydrant is being referred to as 'small quantity' in claim 6.

(d) The expression 'TS' in claims 8 and 9 is unclear in meaning.

(e) The claims are not in proper format. A typical patent claim consists of the following parts:

(a) **THE PREAMBLE** (identifies the category of the invention e.g., an apparatus, device, article, composition, a method or process...etc.),

(b) **TRANSITIONAL PHRASE** (comprising or containing) and

(c) **THE BODY** (recites elements and limitation of the claim and explains how the different elements exist in relationship to one another).

Claims shall be re-drafted so as to clearly bring out

the technical features of the claimed subject matter.

- IV. Objections with respect to Formal Requirements were also raised in the said FER. It was stated that as per Section 6 of the Biological Diversity Act, 2002 permission needs to be obtained from the National Biodiversity Authority before the grant of a patent for subject matter involving biological material from India. Additionally, it was stated in the FER that the drawings need to be filed as per Rule 15(6) of the Patent Rules, 2003 (as amended).
- V. Pursuant thereto, the claims were amended by the appellants and amended claims were filed. In view of the objections raised in the FER under Section 3(h) of the Act, the appellants, vide their reply dated 26th September, 2017 to the FER, amended their claims and submitted amended claims 1 to 3. Amended claim 1 is in respect of the bio-bed with layers of non-absorbent cotton. Amended claims 2 and 3 are in respect of method for preparation of the aforesaid bio-bed. The amended claims read as under:

1. A bio-bed for growing Vigna radiata (Linn.) Wilczek plants, comprising a plurality of layers of non-absorbent cotton obtained from seeds of Gossypium herbaceum, wherein the plurality of layers of non-absorbent cotton have a combined total thickness of 3 cm.

2. A method for preparing a bio-bed useful for growing Vigna radiata (Linn.) Wilczek plants, the method comprising the steps of:

effecting preparation of a non-absorbent cotton from seeds of Gossypium herbaceum by bleaching;

producing a plurality of layers of the non-absorbent cotton; and

stacking the plurality of layers of the non-absorbent cotton to form the bio-bed,

wherein the plurality of layers of the non-absorbent cotton have a combined total thickness of 3 cm.

3. The method as claimed in claim 2, wherein each of the plurality of layers of the non absorbent cotton is stacked in a china dish or glass beaker.

- VI. In the response to the FER, the appellant provided detailed submissions highlighting the differences between the prior-arts and the claimed invention, apart from dealing with the other objections raised by the Controller in the FER.
- VII. In the hearing notice dated 9th April, 2018, the Deputy Controller dropped the objection pertaining to non-patentability under Section 3(h) of the Act. However, the Deputy Controller maintained the objection relating to lack of ‘inventive steps’ and ‘scope of claim 2’ while raising a new objection in respect of non-patentability in terms of Section 3(d) of the Act. The said objection reads as under:

“Non-Patentability u/s 3

1. Claims fall under scope of section 3(d) of The Patents Act, 1970 as it is mere application of cotton bed for germination of seed. Efficacy data should be provided while non absorbent cotton are already in market. It is mere use of such cotton in germination of seed by making bed of cotton.”

3. The impugned order was passed by the Deputy Controller refusing the grant of patent under Section 15 of the Act on the following grounds:

- i. Lacking inventive step in terms of Section 2(1)(ja) of the Act and;
- ii. Not-patentable subject matter under Section 3(d) and 3(j) of the Act.

Submissions

4. Counsel appearing on behalf of the appellants submits that none of the prior-arts, D1 to D5 has been discussed in the impugned order passed by the Controller. The appellant in its reply/written submissions had made detailed submissions with regard to how the claim is different from the prior-art. However, while rejecting the patent, the impugned order does not make any reference to the aforesaid prior-art.

5. There is no analysis as to the similarity between the cited prior-art and the subject invention of the appellant. It is submitted that none of the prior arts discusses 'non-absorbent cotton', which is the subject matter of the present application.

6. It is further submitted that the objection under Section 3(j) of the Act was not one of the grounds taken in the hearing notice. Further, the objection under Section 3(j) is not applicable in the present case as the subject matter of the invention is neither plants nor animals or parts of them thereof or seeds.

7. The impugned order refuses the grant of the patent application taking objections under Section 3(d) of the act. The relevant extract of the impugned order reads as under:

"It seems that invention lies in use of bio-bed of non

absorbent cotton in growing Vigna radiata (Linn.) Wilczek plants, which is mere use of already known non-absorbent cotton/bleached cotton in growing plants, hence not patentable under section 3(d) of The Patents Act, 1970.”

8. In respect of the refusal under Section 3(d) of the Act, it is submitted that the claims of the subject patent application are in respect of a new product, i.e., ‘a bio-bed with non-absorbent cotton’. Therefore, it was not a discovery of a new form of a known substance but an entirely new product.

9. Counsel for the respondent has handed over short submissions in support of his argument in which the objections under Section 3(h) of the Act have been reiterated. It is further submitted that the patent claimed is not an invention and there is no inventive step involved. He submits that the Patent Office does not give a monopoly over growing seeds on such bio-beds of already known non-absorbent cotton.

10. I have heard the rival submissions and perused the record of the case.

Analysis and Findings

11. A perusal of the impugned order shows that the Controller seems to have proceeded on the basis that application was in respect of technique describing growing of *Vigna radiata (Linn.) Wilczek* plants on the bio-bed prepared using non-absorbent cotton, whereas the amended claims were in respect of an invention with regard to method of preparing bio-bed for growing *Vigna radiata (Linn.) Wilczek* plants.

12. The Controller committed an error in invoking Section 3(j) of the Act on the ground that the application was in respect of biological process for production or propagation of plants and animals. The patent was sought in respect of invention, i.e., ‘bio-bed’ and the method of making the bio-bed

and not in respect of the method for growing the ‘*Vigna radiata (Linn.) Wilczek* plant’.

13. In the Examination Report as well as the hearing notice issued by the Patent Office, prior art referred to as D1 to D5 was the basis of the objections that the patent application is not an ‘invention under Section 2(1)(j) of the Act’. Detailed submissions were filed on behalf of the appellant showing how the subject of the patent application was different from the prior art. However, the impugned order has been passed in a cryptic manner without going into the explanation offered on behalf of the appellant with regard to the prior-art. The impugned order simply runs to a conclusion that the invention lacks inventive steps. However, there is no discussion as to why the subject invention would be hit by prior-art D1 to D5.

14. A Coordinate Bench of this Court in its judgment dated 31st March, 2022 in ***Agriboard International LLC v. Deputy Controller of Patents and Designs***, 2022/DHC/001206, while relying upon the judgments of Supreme Court in ***Assistant Commissioner. Commercial Tax Department v. Shukla and Brothers***, (2010) 4 SCC 785 and ***Manohar v. State of Maharashtra And Ors.***, AIR 2013 SC 681, has observed that the principles of *audi alteram partem* have to be followed by the Patent Office while rejecting a patent application. The relevant observations of the Court are set out below:

“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 Id. Counsel having not been considered in the impugned order, the Court does not wish to render any opinion in this regard.”*

15. In the present case also, the Controller has failed to analyse as to how the invention that is the subject matter of the present application is lacking inventive step and obvious in the light of the prior arts.

16. In view of the discussion above, the impugned order dated 14th September, 2018 rejecting the patent application of the appellant is set aside and the matter is remanded back to the IPO for a fresh consideration.

17. The fresh consideration would take into account the objection of lack of inventive step in the light of prior-art referred in the FER/hearing notice.

18. In view of the fact that the objection under Section 3(j) of the Act was not a part of the hearing notice, in the event the Controller wishes to raise an objection under Section 3(j), a fresh hearing notice be issued to the appellant so that the appellant is accorded a chance to meet the Section 3(j) objection.

19. The relevant finding on the aspect of non-patentability under Section 3(d) in the impugned order is set out below:

“It is mere scientific finding/discovery that the growing plant of Vigna radiata(Linn.) on bio-bed of already known non absorbent cotton, by fulfilling requirement of growth, from the seed composition itself, while it was allowed to grow, as growing Vigna radiata(Linn.) requires nano and pico nutrients, which are provided by natural in situ extraction process from the seed and in presence of meager amount of water, which is non patentable subject matter under section 3(d) of The Patents Act, 1970, being mere standardization of water condition during germination of seed and growth of plant, by spraying hydrant.”

20. Counsel for the appellant has drawn attention of the Court to the data provided from pages 123 to 133 of the appeal paper book to submit that sufficient data has been given showing comparative data in respect of *Vigna radiata (Linn.) Wilczek* plants growing on the bio-bed as invented by the appellant and on normal soil.

21. In view thereof, the controller ought to have considered the data provided by the appellant and assess if sufficient data has been provided by the appellant to overcome the objection of Section 3(d). If required, the appellant may be granted a fresh hearing by the Id. Deputy Controller for consideration of the data provided. Thereafter, the Controller shall pass a reasoned order.

22. The appeal is allowed in the above terms. The impugned order is set aside, and the matter is remanded back to the IPO for fresh consideration in terms of discussion above and more particularly the observations given in paragraphs 17, 18 and 21. All pending applications stand disposed of.

23. Nothing stated in the impugned order or in the present order would bind the Controller on the merits of the objections, which are to be dealt with under Section 3(d), Section 3(j) or under Section 2(1)(ja) of the Act.

24. The Controller shall endeavor to pass a reasoned order considering all the relevant considerations within 4 months.

25. The Registry is directed to supply a copy of the present order to the Office of the CGPDTM on the e- mail ID– llc-ipo@gov.in for compliance.

DECEMBER 23, 2022

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AMIT BANSAL, J.

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