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W.P No.15578 of 2017

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated : 09.06.2023

C O R A M

The Hon'ble Mr. Justice **SENTHILKUMAR RAMAMOORTHY**

Writ Petition No.15578 of 2017

Monsanto Technology LLC,
800 North Lindbergh
BLVD, ST.Louis,
Missouri-63167.

... Petitioner

vs.

1. Union of India
Represented by its Secretary
Ministry of Finance,
Department of Revenue
New Delhi.
2. Office of the Controller General of
Patnts, Dsigns & Trade Marks,
Boudhik Sampada Bhawan, S.M.Road, Antop
Hill, Mumbai-400 037.
3. Office of the Assistant Controller of Patents &
Designs, Patent Office,
Intellectual Property Office Building,
G.S.T.Road, Guindy, Chennai-600 032.

... Respondents

PRAYER : Petition filed under Article 226 of the Constitution of India
praying to issue a writ of Certiorarified Mandamus, quashing the impugned
order dated 28th February 2017 issued by the Respondent No.3 which



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rejected the Patent Application No.6560/CHENP/2008 under Section 15 of the Patents Act and directing the Respondent No.3 granting the patent on Patent Application No.6560/CHENP/2008 take appropriate action to effectuate the recordal of the patent and re-hear the matter on merit, in a time-bound manner.

For Petitioners : Ms.Vindhya S.Mani & Mr.Bharat Srinivas

For Respondents : Mr.R.Rajesh Vivekananthan,
Deputy Solicitor General of India

ORDER

The petitioner has assailed an order dated 28.02.2017 of the third respondent. The petitioner submitted an application for grant of patent in relation to a transgenic event, i.e. the insertion of specific DNA molecules and the method relating thereto in relation to a corn plant. Such application was pursuant to an international application under the Patent Cooperation Treaty. In response thereto, a First Examination Report (FER) was issued by the Controller of Patents on 24.09.2013. Several observations were made in relation to the application in the said FER. The petitioner responded to the FER by submitting amended claims. On receipt thereof, a hearing notice was issued by the Controller of Patents on 14.10.2016. In the hearing notice, specific objections were raised only in respect of some of the matters dealt



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with in the FER. These specific objections were dealt with by the petitioner at the time of hearing. Eventually, the proceedings culminated upon issuance of the impugned order dated 28.02.2017.

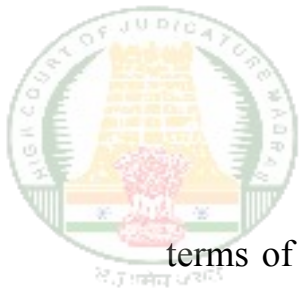
2. Learned counsel for the petitioner invited my attention to the FER and, in particular, Observation - 5 as set out therein. According to learned counsel, Observation – 5 pertains exclusively to claim - 1. The said claim 1 was completely modified when the amended claims were submitted upon receipt of the FER. In spite of such amended claims rendering Observation – 5 infructuous, learned counsel points out that Observation – 5 has been reiterated in the impugned order by making a statement that the explanation and the amendment of the claims are not sufficient to overcome the objections raised. Learned counsel emphasized that the statement is in the nature of *ipse dixit*, i.e. without any reasoning supporting the same. Learned counsel next referred to the objections raised in paragraph – 15 of the FER with regard to the claims not being in compliance with the requirements of Section 10(4) of the Patents Act, 1970 (the Patents Act). On this issue, she submits that Section 10(4) deals with the requisite contents of a complete specification. For instance, the complete specification is



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required to disclose the best method of performing the invention. Unless the Controller of Patents specifies the reasons for concluding that the best method was not disclosed, learned counsel submits that it is impossible for the petitioner to deal with the objection. By drawing reference to the impugned order, learned counsel points out that the impugned order has gone beyond both the FER and the hearing notice by alleging that the claims are not in conformity with Section 10(4)(a), (b) and (c) of the Patents Act. She also points out that the impugned order refers to paragraph 53 of the specification, which was not referred to either in the FER or the hearing notice. According to learned counsel, the impugned order is unsustainable for these reasons.

3. In response, learned Deputy Solicitor General submits that these contentions are liable to be rejected. By drawing reference to paragraphs 9 and 15 of the FER, learned counsel submits that the FER contains reasons for stating that the claims do not comply with the requirements of Section 10(4), especially Section 10(4)(c) of the Patents Act. He also refers to Observation - 2 with regard to non-patentability in



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terms of Section 3(j) of the Patent Act. Therefore, learned counsel submits that the writ petition is liable to be rejected.

4. On examining the FER, it is noticeable that the same contains about 23 observations by the Controller of Patents. These observations include observation – 5 relating to claim 1. As regards observation – 5, learned counsel for the petitioner pointed out that the claim 1 was amended substantially while submitting the amended claims and that observation – 5 ceased to be relevant thereafter. The respondents are unable to refute this contention. Nonetheless, the impugned order refers to observation – 5 and sets out the conclusion that the amendment is insufficient to overcome the objection without providing any basis for such conclusion.

5. As discussed earlier, the petitioner submitted amended claims upon receipt of the FER and the hearing notice was issued thereafter on 14.10.2016. As against the 23 observations in the FER, the hearing notice consists of only about 9 paragraphs. Thus, upon examining the hearing notice, it appears that the Controller of Patents has narrowed down the scope of the hearing to the issues set out in the hearing notice. Apart from



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the reference to the alleged non-conformity with Section 10(4)(ii)(D), the hearing notice does not draw reference to the other clauses of Section 10(4).

By contrast, the impugned order draws reference to Section 10(4)(a), (b) and (c) of the Patents Act. As a consequence of the failure of the Controller of Patents to set out the scope of inquiry in the hearing notice, the petitioner was denied the opportunity of meeting the objections at the hearing. As correctly contended by learned counsel for the petitioner, the impugned order draws reference to paragraph 53 of the specification and records a finding, on such basis, that the subject matter of the claims is the discovery of naturally existing DNA molecules which were isolated. The said paragraph 53 of the specification is not referred to either in the FER or in the hearing notice. These factors have resulted in the breach of principles of natural justice. For this limited reason albeit without recording findings on the merits, the impugned order calls for interference.

6. For reasons set out above, this writ petition is allowed and the impugned order is quashed. Consequently, the matter is remanded to the third respondent for re-consideration. The third respondent shall issue a fresh hearing notice to the petitioner setting out all the objections in respect



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of which the hearing is to be conducted. After providing a reasonable opportunity to the petitioner to respond to the same, the third respondent may proceed to pass a reasoned order. The third respondent shall complete this exercise by passing final orders within a maximum period of six months from the date of receipt of a copy of this order. No costs.

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Index : Yes

To

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