



CMA (PT) No.30 of 2023

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on :12.07.2024

Pronounced on : 19.07.2024

CORAM:

THE HON'BLE MR.JUSTICE P.B.BALAJI

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Sakata Seed Corporation,
2-7-1, Nakamachidai Tsuzuki-ku,
Yokohama-shi kanagawa 224-0041 Japan,
Nationality: Japan
Rep. by its Authorized Representative
Mr.Raghavan Ravindran Nair,
De Penning & De Penning, having office at
No.120, Velachery Main Road,
Guindy, Chennai – 600 032.

.. Appellant

.Vs.

The Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai - 600 032.

.. Respondent

Prayer: This Civil Miscellaneous Appeal filed under Section 117-A of the Patents Act, 1970, praying to call for the records of the Respondent culminating in the impugned order dated 10.10.2022 rejecting the Grant of Patent and set aside the same and consequently, direct Grant of the Patent in respect of the appellant's Application No.1221/CHENP/2015.



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For Appellant : Mr.S.Shivathanu Mohan for
M/s.S.Ramasubramaniam & Associates

For Respondent : Mr.S.Janarthanam
Senior Panel Central
Government Standing Counsel

J U D G M E N T

The appellant, aggrieved by the decision of the Controller, rejecting the patent application of the appellant, citing Section 3(j) of the Patents Act, 1970, has preferred the present appeal.

2.I have heard Mr.S.Shivadhanu Mohan for M/s.S.Ramasubramaniam and Associates and Mr.S.Janarthanam, learned Senior Panel Central Government Standing Counsel for the respondent. I have also gone through the records.

3.Mr.S.Shivadhanu Mohan, learned counsel for the appellant would submit that the invention pertains to “Eustoma having Cytoplasmic Male Sterility and method for producing said Eustoma”. The appellant made an



application for “Eustoma having Cytoplasmic Male Sterility and method for producing said Eustoma”. The said claim has been rejected by the Controller on the ground that it is essentially a biological process and hence, not patentable. The learned counsel for the appellant would also submit that the respondent/Controller has failed to see the claim made by the appellant, which was clearly not a biological process and but for human interventions at relevant points of time which was giving surprising results, the same alone was sought to be patented.

4.The learned counsel for the appellant would take me through the impugned order and submit that the Controller has erred in holding that the amended claims 1 to 4 were hit by Section 3(j) of the Patents Act and without noticing that the surprise element was the human intervention and therefore, it cannot be termed as a biological process. He would further submit that the finding of the Controller that the method to produce a Cytoplasmic Male Sterile Eustoma plant was not found in the claims 1 to 4 is again erroneous and in this connection, he would take me through the claim itself where the appellant has specifically set out the method to produce the new Cytoplasmic Male Sterile Eustoma plants. He would further submit that even though the Controller has discussed the submission of the appellant that back crossing



involves human intervention, he would take me through the discussion made by the Controller in that regard and state that the Controller has failed to give a specific finding as to how the human intervention did not set apart the claim from being a mere biological process. The learned counsel would also invite me to European Patent Control Rules 26(5), which runs as follows:

“A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomenon such as crossing or selection.”

5.1. With reference to said Rule 26(5) of EPC, the learned counsel for the appellant would invite my attention to six steps in the claimed intervention where there is a clear deviation from Rule 26(5) of EPC which contemplates natural phenomenon. However, at more than one step, the appellant introduces human intervention by way of screening of hybrid seeds subjected to mass crossing and the checking of different characteristics of the seeds under cultivation, which springs up an unexpected individual male sterile character. He would therefore pray for the matter being remitted to the respondent for fresh consideration.

5.2. Mr. S. Shivadhanu Mohan, learned counsel for the appellant also



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placed reliance on the decision of the Intellectual Property Appellate Board in O.A/02/2012/PT/DEL dated 05.07.2013, where the Intellectual Property Appellate Board dealing with the method that requires several steps which put together provide the claimed solution, held that when the method that includes an act of human intervention on the plant cell cannot be termed as an essentially a biological process.

6.Mr.S.Janarthanam, learned Senior Panel Central Government Standing Counsel for the respondent would submit that the impugned order passed by the Controller is well reasoned and a considered order and he would justify the findings arrived at by the Controller and seek for dismissal of the appeal.

7.I have carefully considered the rival submissions advanced by the learned counsel on either side.

8.The only ground on which the appellant's invention has been rejected is that it is only essentially a biological process. The European Patent Conventions, especially Rule 26(5) defines what is essentially biological process, i.e., where the process is for production of plants and animals and it



consists of entirely a natural phenomenon. Therefore, the test in the instant case is as to whether the claimed invention is merely a natural phenomenon or otherwise, a biological process, as defined by the European Patent Conventions or whether any intervention has been shown by the appellant.

9.From the specifications as well as the patent applications, it is clear that the patent sought for by the appellant is not a mere biological process. The screening and checking of the hybrid seeds and its characteristics clearly move it away from the realm of natural phenomenon. Therefore, it is the human intervention at particular points of time which are claimed to throw up unexpected male sterile characteristics. However, the respondent/Controller, despite taking up the argument that there is human intervention, has not concluded on this issue by sufficient reasoning as to how the human intervention claimed by the appellant would not be sufficient to take it away from still being essentially a biological process. For these limited purpose, the matter is required to be remitted to the respondent.

10.In fine, the appeal is allowed and the matter is remitted to the respondent to decide the patent Application No.1221/CHENP/2015 afresh, in accordance with law, after affording an opportunity by way of a fresh hearing



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to the appellant. In order to avoid embarrassment to parties, a different Patent

Controller shall be assigned for the scrutiny of the patent application and such exercise shall be completed within a period of three months from the date of receipt of copy of this judgement. There shall be no order as to costs.

19.07.2024

Index : Yes/No
Speaking/Non-speaking order
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To

The Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai - 600 032.



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P.B.BALAJI,J.

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