

IN THE HIGH COURT AT CALCUTTA
Intellectual Property Rights Division
Appellate Side

BEFORE:

The Hon'ble Justice Ravi Krishan Kapur

WPA-IPD No.3 of 2024
(Old No. WPA No.28887 of 2023)

UPL Limited
Vs
Union of India & Ors.

For the petitioner : Mr. Subhatosh Majumder, Advocate
Mr. Paritosh Sinha, Advocate
Mr. Sarosij Dasgupta, Advocate
Mr. Amitava Mitra, Advocate
Ms. Mitul Dasgupta, Advocate
Mr. Manosij Mukherjee, Advocate
Mr. Teesham Das, Advocate
Ms. Urmi Sengupta, Advocate
Ms. Namaan Agarwal, Advocate

For the respondent : Ms. Rashmi Bothra, Advocate

Judgment on : 16.09.2025

Ravi Krishan Kapur, J.:

1. The petitioner challenges an order dated 3 November 2023 passed by the respondent no 3 rejecting an application for patent based on the pre-grant opposition filed by the respondent no 4 under section 25 of the Act. The primary grounds for dismissal are lack of novelty under section 25(1)(b), lack of inventive steps under section 25(1)(e) and the subject patent being a mere admixture and not an invention under section 25(1)(f) of the Patents Act 1970.
2. Briefly, the invention is aimed at unexpected advantages like reduction in fungal diseases delayed senescences leading to better greening and ultimately better yield of crops.

3. The invention claims a fungicidal combination for controlling a broad spectrum of fungal diseases comprising of ternary or quaternary combination of fungicides:
 - a. At least one succinate dehydrogenase inhibitor (SDHI)
Fungicide selected from Benzovindiflupyr, Bixafen, Boscalid, fluindapyr, and Fluoxapyroxad;
 - b. At least one dithiocarbamate fungicide consisting of macoze and
 - c. At least another fungicide selected form at least one of ergosterol biosynthesis inhibitor fungicide and quinone outside inhibitor fungicide.

4. The petitioner filed the subject application being Patent Application No. 201631037704 with a provisional specification on 4 November 2016 for grant on patent. Thereafter, the complete specification was filed on 1 November 2017 with a request for examination. On 30 April 2019, the respondent authorities issued the First Examination Report (FER). On 28 October 2019, a reply was filed in response to the FER. Subsequently, on 20 July 2020 a pre-grant opposition was filed by the respondent no 4 against the subject invention and the petitioner filed its Statement of Reply in respect thereof. The pre grant opposition hearing was held on 2 May 2023. After the completion of the hearing, the parties filed their written submissions on 17 May 2025. On 3 November 2023, the impugned order came to be passed.

5. The primary grievance of the petitioner is that the impugned order was passed in violation of the principles of natural justice. It is alleged that the expert evidence which had been adduced during the proceeding in the form of an affidavit was not taken on record. Despite

making extensive submissions based on the analysis and opinion produced in the expert affidavit, the respondent no 3 chose to ignore the same and *suo moto* presented his own analysis and opinion based on independent calculations, incorporating elements in Table 5 all of which was neither furnished by an expert nor the petitioner. In addition, the Controller held that the petitioner was unaware of the effectiveness of the claimed ternary/quaternary combinations as claimed in the specification and that the advanced effectiveness was knowledge later accrued. In this background, it is contended that there has been a violation of the principles of natural justice. None of the information, data nor scientific analysis relied on by the Controller was made available to the petitioner. It is also contended that no separate hearings were conducted in disposing of the pre grant opposition and the application respectively. On the contrary, a common order was passed without affording an opportunity of separate hearing to the petitioner as contemplated under the combined sections 14 and 15 of the Act read with Rule 55(5) of the Patent Rules.

6. It is also contended by the petitioner that the expert evidence adduced by the petitioner demonstrates that the claimed combination involved technical advancement which is not obvious to a person skilled in the art and hence the same satisfied the requirement of inventive steps under section 2(1)(ja) and 3(e) of the Act. The synergism of the combination is evident from the data contained in the specification and from the results shown in the expert affidavit. Though the Controller, was well within his jurisdiction to request for expert

evidence under section 77 of the Act and to take on record the expert opinion no opportunity was granted to the petitioner to deal with the same. In such circumstances, the Controller had acted in violation of the principles of natural justice in passing the impugned order.

7. On behalf of the respondents, it is contended that non-acceptance of the expert opinion does not impact the finding of the Controller on the grounds of novelty, inventive steps or under section 3 of the Act. The subject claim of the petitioner is a combination of mere admixtures in ratios within various ranges. The expected data must demonstrate that the formulations are effective at very low concentrations near the claimed lower range to justify the lower limit. Similarly, examples of formulations at higher concentrations near the claimed upper range are necessary to validate the upper limit. In addition, data for intermediate ranges are essential to establish that the formulation works consistently across all proportions. The expert declaration attempts to establish the effectiveness of specific ternary combination with a particular weight percentage ratio. This is ineffective. Upon a review of the complete specification and the initial claim it is found that the original claims were arbitrary. It is further contended that the subject invention is neither novel nor involves any inventive steps in respect of the prior arts D1, D2, D3, D4 and D5. It is contended that the complete specification filed by the petitioner provides the “mean percent disease control” but fails to provide any evidence of a “synergistic effect”. Hence, in the absence of any such evidence the Controller was of the opinion that the claims filed in the subject

invention were not patentable under section 3(e) of the Act 1970. In view of the above, the impugned order warrants no interference.

8. At the outset, a point of maintainability is raised by the respondents. It is contended that there being a statutory remedy by way of an appeal against the impugned order under the Act, the instant writ petition is not maintainable. While a High Court would not ordinarily exercise its jurisdiction under Article 226 of the Constitution if an effective and efficacious alternative remedy is available, it is well settled that the existence of an alternative remedy does not by itself bar the High Court from exercising its jurisdiction in certain circumstances. This principle is well settled [*Whirlpool Corporation vs. Registrar of Trade Marks* (1998) 8 SCC 1, *Harbanslal Sahnia vs. Indian Oil Corporation Ltd.* (2003) 2 SCC 107].
9. The grievance of the petitioner is one of violation of natural justice. In *Radha Krishan Industries vs. State of H.P* (2021) 6 SCC 771, it has been held as follows:

27. *The principles of law which emerge are that:*

27.1. *The power under Article 226 of the Constitution to issue writs can be exercised not only for the enforcement of fundamental rights, but for any other purpose as well.*

27.2. *The High Court has the discretion not to entertain a writ petition. One of the restrictions placed on the power of the High Court is where an effective alternate remedy is available to the aggrieved person.*

27.3. *Exceptions to the rule of alternate remedy arise where : (a) the writ petition has been filed for the enforcement of a fundamental right protected by Part III of the Constitution; (b) there has been a violation of the principles of natural justice; (c) the order or proceedings are wholly without jurisdiction; or (d) the vires of a legislation is challenged.*

27.4. *An alternate remedy by itself does not divest the High Court of its powers under Article 226 of the Constitution in an appropriate case though ordinarily, a writ petition should not be entertained when an efficacious alternate remedy is provided by law.*

27.5. *When a right is created by a statute, which itself prescribes the remedy or procedure for enforcing the right or liability, resort must be*

had to that particular statutory remedy before invoking the discretionary remedy under Article 226 of the Constitution. This rule of exhaustion of statutory remedies is a rule of policy, convenience and discretion.

27.6. *In cases where there are disputed questions of fact, the High Court may decide to decline jurisdiction in a writ petition. However, if the High Court is objectively of the view that the nature of the controversy requires the exercise of its writ jurisdiction, such a view would not readily be interfered with.*

10. In view of the grievance of the petitioner i.e. violation of the principles of natural justice and the pendency of the writ petition, there is no merit on the issue of maintainability raised on behalf of the respondents and the same stands rejected.
11. Drug development is a lengthy process and the data to demonstrate its efficacy can be filed after filing of the specification. The Act contemplates no time bar which prevents an applicant from filing additional documents even after filing of its claim. Any evidence demonstrating any technical advancement deserves to be considered and ought to be taken into account while deciding on the technical advancement or synergistic efficacy of the claimed invention. [*Oyester Point Pharma Inc v. Controller of Patents and Designs, 2023 SCCOnline Cal 1214 and AstraZenca v. Intas Pharmaceutical Ltd, 2020 SCC Online Del 2765*].
12. On a reading of the Act, it is evident that a pre grant opposition and an application upon examination are both required to be heard separately i.e., under section 25(1) and section 14 respectively. These are distinct compartments as stipulated under the Act. The respondent no 4 is not to be impleaded as a party to the original proceeding under the Act. Rule 55(5) of the Rules provides that the

Controller may either reject the representation or require the complete specification and other documents to be amended to his satisfaction before the patent is granted or refused by passing a speaking order in the opposition proceeding which is to be simultaneously decided alongwith the proceedings under section 14 and 15 of the Act.

13. Since the objections raised in the FER are different from those raised in the representation under section 25(1), the Controller was obliged to provide separate hearings i.e.(i) to deal with the pre-grant opposition and (ii) to deal with the application under examination and then pass separate orders dealing with all the aspects in both cases.
14. In any event, in passing the impugned order the Controller erred in not considering the expert affidavit filed by the petitioner nor dealing with the technical evidence raised by the petitioner. The entire exercise of providing independent scientific analysis without granting an opportunity to the petitioner is a serious infirmity in the impugned order and in violation of the principles of natural justice. The observation made by the Controller that the petitioner was unaware of the synergistic effects of the claimed invention is unsupported and without any basis. The Controller could not consider that the petitioner had no prior knowledge of the synergistic effect on the ground that the expert relied on by the petitioner was not taken into consideration after the filing of the specifications.
15. In view of the above, the writ petition succeeds. The impugned order dated 3 November 2023 is set aside. The matter is remanded back to the Controller for reconsidering the application and after considering the expert affidavit relied on by the petitioner. In carrying out the

above exercise, the Hearing Officer shall provide two separate hearings under sections 14 and 25 respectively and after providing an opportunity of hearing and then pass separate reasoned orders in both proceedings respectively. In view of the allegations made against the Hearing Officer who passed the impugned order, the matter be reassigned to a different Hearing Officer. It is made clear that there has been no adjudication on the merits of the case and all questions are left open to be decided in accordance with law. To the above extent, WPA IPD 3 of 2024 stands allowed.

(Ravi Krishan Kapur, J.)