WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 22.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT)//181/2023
(OA/SR.65/2017/PT/CHN)

Toyota Jidosha Kabushiki Kaisha
1, Toyota-cho, Toyota-shi
Aichi 4718571, Japan ... Appellant

Vs.

The Assistant Controller of Patents and Designs
The Patent Office
Intellectual Property Office Building,
G.S.T.Road, Guindy
Chennai 600 032 ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) is filed under Sections 117 A of the Indian Patents Act, 1970, praying to set aside the impugned order dated 26th April 2017 passed by respondent in respect of Indian Patent Application No.6305/CHENP/2010 and an order granting a patent on Indian Patent Application No.6305/CHENP/2010 in favour of the Appellant.

https://www.mhc.tn.gov.in/judis

WEB COPY

For Appellant : Mrs.Archana Shankar
Mr.N.C.Vishal
Mr.N.Shrivatsav
for Anand and Anand

For Respondent : Mr.G.Ilangovan
Central Govt. Standing Counsel

JUDGMENT

Having lost its application for patenting its invention titled "***Gene For Increasing the Production of Plant Biomass and/ or Seeds and Methods for Use thereof***", the applicant before the Patent Office is now before the Court with this appeal.

2.The other facts which are relevant for the current purposes are:

- The appellant had filed its international application before the Japan Patent Office sometime in 2008 with 39 claims. When it was filed in India subsequently in 2009, the total claims were brought down from 39 to 15, of which 3 are independent claims.
- The respondent eventually came out with its FER where it

https://www.mhc.tn.gov.in/judis

WEB COPY

essentially raised three objections:

a) that the application filed before it is not in conformity with Sec. 7(1)(a) of the Patents Act as there is variance between the specifications and claims made in its application before the Japan Patent Office and that which it has filed in India;

b) 3(j) that the invention relates to plants; and

c) 2(1)(ja) that the invention lacked inventive step and tried to fortify it with five citations namely the prior arts in D1 to D5.

- The appellant responded to the same and brought certain amendments to the claims it had made and brought down the same from 15 to 9 claims, of which 1st claim alone is its independent claim.

- In the hearing notice the Controller dropped her objection under 7(1)(A), retained its earlier objection under Section 2(1)(ja) (based on the same set of prior arts and Section 3(j) and also added Section 10(5).

https://www.mhc.tn.gov.in/judis

WEB COPY

- The appellant participated in the hearing and filed its written submissions. However, the Controller does not appear to have been convinced by the efforts of the appellant, and she eventually chose to reject the appellant's application on all the grounds under Section 10(5), 2(1)(ja) and 3(j), on which she raised objections in her hearing notice. The appellant participated in the hearing and also filed his written submissions. Along side, it also introduced a one word amendment to its independent claim by inserting the word '*in vitro*'. This according to the appellant was done during hearing on a suggestion made by the respondent.

The respondent, however, remained unconvinced and chose to reject the appellant's application under Sections 59, 10(5), 3(j); and 2(1)(ja) of the Act. This order of the respondent is now under challenge.

4. Heard both sides. The learned counsel for the appellant submitted:

a) the invention of the appellant involves artificial creation of a gene

https://www.mhc.tn.gov.in/judis

WEB COPY

sequence and injecting it in the genome of the plant to increase in the production of its biomass, which in turn would produce genetically modified seeds from the said plant, which will enable the growth of plants with higher biomass. The learned counsel proceeded to argue that there are two aspects involved in the appellant's invention: (i) the preparation of the gene sequence and (ii) injecting the same into the genome of the plant cell. This process of transferring or injecting the gene into a genome of a plant cell will be achieved only physically and it is done after the preparation of the gene sequence. Inasmuch as this is done outside, the word '*in vitro*' was used almost akin to the IVF which the fertility clinics ordinarily do. The word '*in vitro*' is superfluous in the context of the appellant's invention, since a modified gene prepared cannot find its expression in a plant unless it is injected into its genome by a physical process, which necessarily implies that there is a need for human intervention, at least till such time AI takes over this job. The finding of the Controller that the insertion of the word '*in vitro*' (something done at his instance), as exceeding the scope of the original specification within the meaning

https://www.mhc.tn.gov.in/judis

WEB COPY

of Section 59 is an erroneous understanding of the concept.

b) So far as the objection under Sec. 10(5) of the Act is concerned, the Controller seems to take exception to grouping SEQ ID Nos.5, 7, 36, 42, 48 and 59 - 65 together, and overlooked the fact that they form a group of inventions to form a single inventive step, something very similar to a *Markush claims,* though may not be exactly the same. Claim 1(a) reads that it is a protein comprises of an amino acid sequence selected from the group consisting of SEQ ID Nos.5, 7, 36, 42, 48 and 59 - 65. Now each of this sequence though may indicate certain apparent dissimilarities in their properties, will also have certain common features, and they could be aligned in a certain way to enable it to exhibit the common features more than the dissimilarities that they may otherwise posses. In other words, each of the sequence can be independently used with certain aligning process to obtain the same result. In this regard, the appellant even produced the affidavit of the inventor Dr.Satoshi Kondo.

c) Vis-a-vis the objection raised by the Controller under Sec. 3(j) of the

https://www.mhc.tn.gov.in/judis

WEB COPY

Act, the Controller has again got it incorrectly. The appellant has only invented a gene sequence to transform the biomass of plant without altering the basic character of the plant. To state it differently, the invention does not produce a plant nor an animal nor a new plant but only aims to increase the biomass of the existing plants etc., to achieve greater productivity. This will fall squarely outside 3(j).

d) Turning to 2(1)(ja), the Controller has placed over reliance on D1 to D5, but the inventor himself has explained it in his affidavit from paragraph No.7 to paragraph No. 13. He had also explained how his invention is different from D1 to D5, but the Controller has not chosen to consider the explanations of the inventor, and seems to have developed an unifocal attachment to her citations.

e) The present invention of the appellant has been patented in at least seven jurisdictions.

https://www.mhc.tn.gov.in/judis

WEB COPY

5. The submissions made on behalf of the appellant are carefully weighed. And these submissions made on each of the grounds of objections by which the respondent has chosen to reject the appellant's application do not find any convincing justification in the impugned order. More particularly, as regards the objection raised under Sec.10(5), the Controller has not referred to the explanation offered by the inventor, and was steadfast in sticking on to certain misconceptions that she had entertained, and had attempted to treat each gene sequence with an eye on emphasising the dissimilarities and not with an eye to understand the similarities they posses. And this Court is also convinced that the use of the expression '*in vitro*' in its claim has not exceeded the specification within the meaning of Sec.59 of the Act. The Controller is under an obligation to explain how a gene sequence invented by the appellant could be injected into a plant to improve its biomass. The expression '*in vitro*' generally relates to fertilisation, where mature eggs are collected from the ovaries and fertilised by a sperm in a laboratory. In this context, the expression may be superfluous in the context in which it is used, implying thereby that the appellant has only attempted to explain the

https://www.mhc.tn.gov.in/judis

WEB COPY

method by which the gene sequence is implanted in the genome of the plant. It would have been appreciable if the Controller had understood the use of the expression contextually. A student of science, which both the inventor and the Controller are, may not be an expert in language. However if someone chooses to discharge the responsibility of a Patent Controller, then a reasonable familiarity with the language may be necessary for the Controller to concentrate more on the science part of the invention, and not on the semantics of the language employed in describing them. And in the instant case the appellant states that the expression '*in vitro*' itself was inserted only at the suggestion made by the Controller, for which there may not be any proof. But this expression '*in vitro*' was not there in the original specification. And to the rest of the objections, this Court is convinced about the merit of the submissions.

6. The conclusion is to state the obvious. This matter has to go through the filters of the Patent Act yet another time, and hence remanding the matter emerges as an automatic choice.

https://www.mhc.tn.gov.in/judis

WEB COPY

7. In the result, this appeal stands allowed. The impugned order dated 26.04.2017 passed by the respondent is hereby set aside. The matter is remanded back. This Court does not consider that the Patent Controller who had already passed the order is good enough to consider it again, and hence it directs that another Controller may now consider the application of the appellant denovo. Since the international filing was on 13.03.2009, in the eventuality of appellant obtaining a patent it will have a shelf value of mere 5 years. Hence, this Court requires such Patent Controller who may now be in charge of the matter to dispose of the matter within a period of six (6) months from the date on which he or she takes cognizance of this matter. There is no order as to costs.

22.03.2024

kas

Index: Yes / No
Neutral Citation

https://www.mhc.tn.gov.in/judis

WEB COPY

N.SESHASAYEE, J.

kas

(T)CMA(PT)//181/2023
(OA/SR.65/2017/PT/CHN)

22.03.2024

https://www.mhc.tn.gov.in/judis