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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 09.07.2024	Pronounced on: 06.09.2024

CORAM:

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

(T) CMA (PT) No.219 of 2023
(OA/SR.226/2015/PT/CHN)

Bayer CropScience AG
Alfred-Nobel-Strasse 50,
40789 Monheim,
Germany, a German Company. .. Appellant

..Vs.

The Assistant 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, prays that the order dated 30.01.2015 issued by the respondent on 03.02.2015 be set aside and the Application No.4574/CHENP/2007 for patent be allowed to proceed to grant.

For Appellant : Mrs.Archana Shankar
for M/s Anand & Anand

For Respondent : Mr.K.Subbu Ranga Bharathi
Central Government Standing Counsel

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J U D G M E N T

This Appeal has been preferred challenging the order dated 30.01.2015, passed by the Respondent, refusing to grant a patent in respect of the Patent Application No.4574/CHENP/2007.

2.The patent application pertains to an invention relating to Long-chain-inulin and its preparation from artichoke roots for use in food stuffs and cosmetic preparations.

3.The Respondent has rejected the Appellant's patent application on the grounds that it lacks novelty and inventive step.

4.I have heard Mrs.Archana Shanker for M/s.Anand & Anand, learned counsel for the Appellant and Mr.K.Subbu Ranga Bharathi, learned Central Government Standing Counsel for the Respondent, assisted by Mrs.Anita, learned Controller who appeared through Video Conferencing.

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5.The learned Counsel for the Appellant would first and foremost contend that the present invention was finally limited to only 6 claims and the Respondent erroneously rejected the same citing D1, prior art and also holding that the invention was lacking any inventive step as the benefit of using purified inulin restricted to a particular fraction of higher DPw instead of using naturally occurring inulin was obvious.

6.According to the learned Counsel for the Appellant, the invention displayed a much higher degree of polymerization as well as molecular weight distribution over D2, prior art as well as lower pH and good storage which would ideally help in foodstuff. She would also invite my attention to the technical advantages in the present invention by way of stronger prebiotic effect, increasing the presence of good bacteria and lower bad bacteria and very good beneficial viscosity properties as well as good stability. In this regard, the Counsel for the Appellant would refer to the comparative tables available in the typed set of documents.

7.The learned Counsel for the Appellant would also contend that

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there has been total non-application of mind by the Controller who failed to refer to already deleted claims and despite the same, finding that the claims are disguised use claims. The Learned Counsel would also submit that corresponding patents have been granted in several jurisdictions where the same prior art documents had been cited and the invention claimed by the Appellant displayed higher DPn over D1 as well.

8.Per contra, the learned Central Government Standing Counsel for the Respondent would submit that the invention claimed by the Appellant was not even a new compound, but only a mixture of different polymers. According to the Respondent and the Controller, the Appellant had merely isolated the inulin and shown some benefits. According to the Respondent, inulin itself had beneficial properties and at best it was amounting to a discovery and not an invention, shoeing any novelty or inventive steps.

9.The learned Central Government Standing Counsel for the Respondent would further contend that the Appellant's claims also did not get over the teachings of prior arts D1 and D2. There was nothing inventive over the prior arts according to the Controller. According to the Respondent, even Section 3(c) was an impediment for the Appellant to

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be entitled to grant of patent.

10.In reply, the Learned Counsel for the Appellant would submit that Section 3(c) objection was never taken at the hearing notice and therefore it cannot be now put against the Appellant.

11.I have carefully considered the arguments advanced by the Counsel on either side. I have also factored the submissions made by the learned Controller, assisting the learned Central Government Standing Counsel for the Respondent.

12.The Appellant put forth 6 claims seeking grant of a patent for ‘long-chain inulin’ and its preparation from artichoke roots with its use in foodstuff as well as cosmetic preparations. The specific case of the Appellant was that the invention under consideration exhibited technical advantages by way of high stability on heat or acid treatment, a stronger prebiotic effect, beneficial viscosity properties, high gel strength and good stability and all these had a very good result in food stuffs and cosmetics preparation.

13.The Controller has rejected the same mainly on the ground that

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there is actually no invention since the Appellant has merely isolated inulin already present and shown benefits accruing and therefore there is not only obviousness but also no novelty or inventive steps, entitling the Appellant to grant of a patent.

14.There is no second opinion on the fact that inulin is also present in prior art D1. However, it is the case of the Appellant that the inulin present in the claim of invention is not the same inulin present in prior art D1 as it has a special chain length, not only fractionalised but also having a different degree of polymerization. Natural or native inulin is admittedly found in artichoke. Prior art D1 talks about the said native inulin being isolated from artichoke, like in the case of curcumin being isolated from turmeric. The Controller has failed to see that the novelty claimed by the Appellant is only achieving a higher molecular weight by fractionalising inulin and thus achieving a different degree of polymerization and a special chain length profile which is expressed by a DPw defined in the range of 54-61 which is claimed to be novel. The results achieved were also demonstrated by a comparative table in Exhibit A which clearly indicated a much higher DPn / longer chain length. Therefore, in the light of the discussions hereinabove, I am of the

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considered opinion that it is not a mere case of isolation of inulin alone as contended by the Respondent, but a case where the Appellant has satisfactorily shown novelty and invention with beneficial results as well.

15.In so far as prior art, D2 also the Appellant has compared the inulin in D2 and shown not only beneficial properties but also unexpected results. However, the Controller, on mere surmises, concludes that there is nothing inventive as the beneficial properties of the invention can be derived from prior art D2 also.

16.It is to be noted that compared to D2, the invention shows much better solubility which enables the same to be easily and productively introduced or added to food stuff. Slow fermentation, a stronger prebiotic effect, high gel strengths shown in the invention are clearly not exhibited by the prior arts.

17.The Respondent also failed to see that the same prior arts were also considered before grant of patents in US, Australia and Europe as well. Though the grant of patents in other jurisdictions may not be strictly binding on the Controller, at least, the least expected of the

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Controller is to distinguish the other grants and state as to why the grant of such patents in other countries did not compel the Controller to consider the patent in question for grant, especially when the same prior arts were pitted against the Appellant in the other jurisdictions.

18.The Counsel for the Appellant also placed reliance on the following decisions:

i) Asthristis Relied Plus Ltd. v. Controller of Patents & Designs, reported in MANU/IC/0001/2021.

ii) Willowood Chemicals Private Limited v. Assistant Controller of Patents & Designs, reported in MANU/IC/0009/2011.

19.In ***Asthristis' case***, the Intellectual Property Appellate Board held that when various other jurisdictions, after relying on similar prior arts had granted patent, though it was not binding on the Indian Patent office, it was against the principles of equity and fair play to question the novelty and / or inventive step. The said ratio would squarely apply to the present case as well.

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20.In ***Willwood's case***, the Intellectual Property Appellate Board held that obviousness had to be objectively and strictly judged and merely coming to a conclusion that there is or is no inventive step. The Controller is not expected to subjectively assess and render opinion without a reasonable basis.

21.Even with regard to the Controller finding that there is sufficient disclosure in the Specifications, I have examined the Specifications of the claim. The Appellant, has illustrated by providing examples that the claim has clearly disclosed several fronts on which it is inventive and there is also no disguised use claim as found by the Controller as it has been sufficiently explained by the Appellant that the inulin present in the invention is novel due to a specific chain length achieved and it is just not something which is isolated from artichoke and hence cannot be merely categorized as a mixture of different polymers.

22.It is well settled law that in considering a patent application, a hindsight construction adopted by the Controller is impermissible. The Controller cannot use the subject patent as a guide through the mazer of prior arts and there ought to be no teachings away from the patent in

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question in the prior art. Equally settled is the law that even a minute change in structure of a compound can throw up new and unpredicted results and therefore mere structural similarity is not sufficient. Even if obviousness is put against the claim, unless it established that a person ordinarily skilled in the art would have been able to, from a mosaic of the prior arts, achieve by combining the relevant components, the result that is shown in the invention. In the present case, the Respondent has not been able to show how the prior arts, either on their own or by any combination, leads to such obviousness in order to deny grant of patent to the Appellant.

23.For all the above reasons, the findings arrived at by the Respondent are not sustainable and are consequently liable to be set aside.

24.In fine, the Appeal is allowed and the impugned order passed by the Respondent is set aside and resultantly, the Appellant is entitled to a grant of patent in Indian Patent Application No.4574/CHENP/2007. However, there shall be no order as to costs.

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Index : Yes/No

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Speaking/Non-speaking order
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To

The Assistant 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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