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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on:24.07.2024	Pronounced on:23.08.2024

CORAM:

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

(T) CMA (PT) No.2 of 2024

Versalis SPA,
Pizza Boldrini,
1-20097 San Donato Milanese (MI),
Italy represented by its Constituted Attorney,
Mr.Pradeep Yadav.

.. Appellant

..Vs.

The Assistant Controller of Patents,
Intellectual Property Office Building,
GST Road, Guindy,
Chennai – 600 032.

.. Respondent

Prayer: This appeal came to be numbered by transfer of IPAB Case OA SR.No.74/2017/PT/CHN from the file of the Intellectual Property Appellate Board, Chennai praying to allow the present Appeal and set aside the order dated 02.05.2017 of the learned Assistant Controller and present Application being IN7854/CHENP/2011 be granted and to issue directions to the respondent to allow the Appellant to make necessary amendments in the claims, if needed, in order for the Application to be granted and costs be allowed to the Appellant.

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For Appellant : Mr.Arun C.Mohan
for M/s.Chadha & Chadha

For Respondent : Mr.V.T.Balaji,
Central Government Senior Panel Counsel

J U D G M E N T

The Appellant challenges the impugned order dated 02.05.2017 in 7854/CHENP/2011, rejecting the Appellant's patent application for the invention, which relates to "a process of hydrolysis of lignoceullulosic biomass".

2. I have heard Mr.Arun C. Mohan, learned counsel for the Appellant and Mr.V.T.Balaji, learned Central Government Senior Panel Counsel, for the respondent. I have also perused the records including the impugned order. I have also carefully gone through the decisions on which the learned counsel for the Appellant has placed reliance on.

3. The main ground on which the patent has been rejected is that the claims are not inventive under Section 2[1(ja)] of the Patents Act, 1970 (in short 'Act').

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4. The principal grounds of challenge to the said order, as canvassed by the learned counsel for the Appellant are that the Appellant had clearly shown that the claimed invention got over the disadvantages of the conventional method viz., difficulty to hyrdolyze cellulose to its basic sugars, which also consumed a lot of time and effort and resultantly, uneconomical. The claimed invention, apart from the above, did not require high shear and the process was achieved in a much shorter time. That apart, the invention did not require addition of any inorganic acid or any lignin solubilizing organic solvents.

5. The invention consists of a process by which, feedstock comprising of biomass having a high dry content and water is brought in contact with a solvent in the presence of a catalyst and maintaining the contact at a temperature in the range of 20 degrees centigrade to 95 degrees centigrade to create a hydrolyzed product from the biomass in the feedstock.

6. Mr.Arun C.Mohan would also contend that the present invention has been recognised abroad and as many as 23 patents have been granted to the Appellant in countries like Australia, Brazil, China, Europe, New Zealand, USA, South Africa etc. and more importantly all the cited prior arts

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were also cited in the prosecution of the EP application and ultimately, the claimed invention was held to be novel and inventive over the prior arts cited against it.

7. He would also take me through specific prior arts that were held against the Appellant and elaborate his submissions as to how the Controller fell in error in rejecting the patent on the ground of lacking inventive steps over the prior arts. He would also submit that the invention was clearly novel and inventive over prior arts D1, D3, D5, D9 and D10 and would make his submissions regarding these prior arts and distinguish them from the present invention.

8. He would further submit that the subject application met all the requirements of Section 10(4) & 10(5) of the Act and was clearly patentable and not hit by Section 3(d) of the Act. In support of his contentions, the learned counsel for the Appellant would also rely on the following decisions:

1) Enercon India Ltd. v. Aloys Wobben, 2013 SCC OnLine IPAB 91

2) Farbwerke Hoeschst Aktiengesellschaft Vormals Meister Lucius & Bruning, A. Corporation v. Unichem Laboratories, AIR 1969 Bom 255

3) FDC Ltd. V. Sanjeev Khandelwal and another,

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4) Natco Pharma limited v. Pfizer Products Inc. in Patent Application No.537/Del/1996

5) Gandhimathi Appliances Limited v. L.G.Varadaraju and others, 2000 SCC OnLine Mad 1238

6) *Tata Global Beverages Limited, West Bengal Vs. Hindustan unilever Limited, Maharashtra, India and another,* reported in *CDJ 2012 IPAB 136*.

9. Per contra, Mr.V.T.Balaji, learned counsel for the Respondent would first and foremost submit that, the Appellant was given a full and fair opportunity and there was no violation of the principles of natural justice. He would secondly submit that, all the prior arts anticipated the subject matter of the claimed invention and therefore, in terms of Section 2(1)(ja) of the Act, the Appellant's invention did not involve any technical advancement. He would also contend that there was a clear lack of inventive step as the teachings of the prior arts D1, D3, D5, D9 and D10 clearly made it obvious for the person skilled in the art to arrive at the present invention.

10. The learned counsel for the respondent would also contend that the invention did not meet the requirements of Section 10(4) and 10(5) of the Act as the claim lacks clarity, support and ample disclosure (Section 10(4)) and the claims were also not supported by the description with working

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examples (Section 10(5)). The learned counsel would also invite my attention to Section 3(d) of the Act and submit that the claims, even post amendment, were only a use of a known process for hydrolysis and it did not produce any unknown technical effect. The learned counsel for the respondent would therefore pray for dismissal of the appeal.

11. The moot point is whether the cited prior arts, especially D1, D3, D5, D9 and D10 teach away from the present invention and whether it has shown any technical advancement over the said prior arts, for it being termed as novel or inventive. Prior art D1, discloses a free-fall mixing based on gravity. It involves a process where biomass is loaded continuously into a liquefaction reactor. The teaching of D1 is thus recycling of the liquid fraction back into the liquefaction step. However, the Appellant's invention is very different as the composition of the matter being recycled is not the same. The Appellant reintroduces the hydrolyzed solution which has shown dramatic results, especially in terms of lesser time consumption. This aspect has not been dealt with in prior art D1 and hence, I find that D1 teaches away from the present invention, which shows an inventive step over D1.

12. Regarding prior art D3, it is an apparatus for enzymatic hydrolysis

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and fermentation of pre-treated lignocellulosic material, in the form of a tower bioreactor. In this prior art, it is only the enzymes that are recycled whereas, in the present invention the biomass is brought in contact with a solvent which contains a hydrolyzed species and hence, I am unable to countenance the argument of the learned counsel for the respondent that this prior art also comes in the way of the claimed invention.

13. The next prior art is D5. D5 involves a process where ethanol is obtained from milled grain which is a substrate deprived of lignin. However, the present invention involves process where the substrate is itself different and hence the finding of the respondent that the teachings of D5 are obvious, cannot be sustained.

14. Prior art D9 involves a process where reactor is used for hydrolysis of the lignocellulosic feedstock and recycling the mixture in an extended loop which is returned to the reactor. D9 does not teach that the resultant hydrolysed feedstock itself can act as a solvent for hydrolysing the raw feedstock.

15. Insofar as prior art D10 is concerned, it discloses a continuous

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hydrothermal pre-treatment without addition of acids to the feedstock and according to the Respondent, it anticipates the subject matter of invention and enzymatic hydrolysis of biomass is obvious to a person skilled in the art. However, according to the present invention, the water soluble hyrdrolysed species of the same feedstock itself acts as a solvent for the fresh feedstock of same species. Thus, the teachings of D10 also do not suggest that it anticipates the present invention.

16. In view of the above, I am unable to sustain the findings of the respondent that the invention is obvious to a person skilled in the art.

17. Coming to the objections regarding Sections 10(4) and 10(5) of the Act, according to the Controller, which is also reaffirmed by the learned counsel for the respondent, the claims lack clarity and ample disclosure and the complete specification shows deficit support for the range of 50:50 to 90:10 and are therefore, hit by Section 10(4). Insofar as Section 10(5), it is contended that the Claims 1 to 19 are not supported by the description with working examples. The contention of the learned counsel for the Appellant, in reply, that the statute does not require examples to be provided over the entire range claimed, is acceptable. The complete specification has to only

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indicate the best method which, according to the Controller is absent in the present case. However, it is seen from the complete specification that the invention is all about contacting the feedstock with the solvent and maintaining optimised conditions.

18. In *FDC Ltd. V. Sanjeev Khandelwal and others,* (referred herein supra), it has been held that Section 10(4) requires the complete specification to fully as well as particularly describe the invention and disclose the best method to perform the invention and that it is not mandatory that the claims should be representative of the best method.

19. In *Tata Global Beverages Limited, West Bengal*, (referred herein supra), the IPAB in and by its order dated 18.10.2012 held that it was not necessary to provide examples over the entire range claimed and reiterated the law that it is mandatory only for the specification to disclose the best working example. In fact, in the instant case, the Appellant has provided working examples for the range claimed, even in the complete specification.

20. The Bombay High Court, in *Farbwerke Hoeschst Aktiengesellschaft Vormals Meister Lucius & Bruning, A. Corporation*,

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(reffered herein supra) held that since the specification and claims are addressed to only those who possess a high degree of knowledge in the field of science to which they relate, it is not necessary to describe the processes when they are part of common general knowledge available to persons skilled in the art, who can refer to technical literature on the subject for the purposes of carrying them into effect.

21. The law is therefore quite well settled on this issue. Disclosure of 'at least one way' is sufficient as long as it is clearly indicated in the specification as it would enable the person skilled in the art to carry out the invention. In this regard, I have examined the complete specification putforth by the Appellant and I find it to be clearly disclosing adequate information that would be sufficient to a person skilled in the art to carry out the invention without undue experimentation. Hence, the argument of the learned counsel for the respondent that the invention is hit by Section 10(4), cannot be countenanced.

22. Insofar as the objection pertaining to Section 10(5), it is sufficient if the claims are fairly and not exactly based on the description. Therefore, on an erroneous interpretation of the statutory provision, the Controller has

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come to a conclusion that the description does not support the claim as mandated under Section 10(5) and therefore, this finding is also liable to be set aside.

23. Lastly, Section 3(d) is cited and put against the Appellant on the ground that the invention is a mere use of a known process of hydrolysis, especially in the light of the prior art and hence, non- patentable. It is easy for one to state, on hindsight that, this process is well known and therefore a patent has to be refused. The fact that the invention claimed was never thought of earlier, though it is stated to be so obvious, itself carves out as a case for patent.

24. In *Natco Pharma'*s case (referred herein above), it has been held that when a particular solution itself was not known prior to the invention then it cannot be termed as a mere use of a known process.

25. In *Enercon India Ltd*., (referred herein supra), the Intellectual Property Appellate Board held that, where an invention seems obvious to a person skilled in the art because of what he knows now is a clear case of hindsight deduction and that the same is not acceptable. The Courts have consistently upheld the 'could-would' approach. The crucial aspect is not

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whether the person skilled in the art could have carried out the invention, but whether he would have done so in the expectation of either solving the problem or showing some improvement or advantage.

26. In *Gandhimathi Appliances* (referred hereinabove), a Division Bench of this Court held that, when the invention is dissected and seen separately, it may not show any inventiveness however, a combination if shows a new use, even if of known integers, the ingenuity and skill shown in bringing about such a combination renders the invention patentable. It was further held in this decision that despite pre-existing knowledge, when the person who claims invention was the first to visualise the use of known integers in a combination, then it cannot be regarded as obvious.

27. Thus, applying the ratio laid down in the above decisions to the facts of this case, it is clear that the Controller fell in error in denying the patent to the Appellant. The drawing of a comparison to curd is also really improper. Curd is made through a chemical process called fermentation which is caused by a bacteria, Lactobacillus and that has got nothing to do with the present claim and the two are entirely in different zones, warranting no comparison at all.

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28. Yet another important aspect which cannot be lightly brushed aside is the fact that all the cited prior arts have been cited in the EP application with the same objections and yet the present invention was held to be inventive over the cited prior arts. In fact, the Appellant has been granted a patent for the same invention in as many as 23 jurisdictions. Thus, taking this into account, it is amply clear that the present invention is inventive, novel and has shown benefits/advantages over the prior arts cited and hence, patentable.

29. For all the above reasons, I am constrained to allow the appeal, setting aside the order of the respondent/Assistant Patent Controller, rejecting the Appellant's patent application. However, there shall be no order as to costs.

23.08.2024

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

To
The Assistant Controller of Patents,
Intellectual Property Office Building,
GST Road, Guindy,

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Chennai – 600 032.

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P.B.BALAJI,J.
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