IN THE HIGH COURT AT CALCUTTA
SPECIAL JURISDICTION
ORIGINAL SIDE

BEFORE:
The Hon'ble Justice Ravi Krishan Kapur

AID NO. 11 OF 2021

IN THE MATTER OF

Decco Worldwide Post Harvest Holdings B.V & Anr.
Vs
The Controller of Patents and Designs & Anr.

For the appellants	: Mr. Ranjan Bachawat, Senior Advocate Mr. K.K Pandey, Advocate Mr. Sarosij Dasgupta, Advocate Ms. Mitul Dasgupta, Advocate Ms. Enakshi Saha, Advocate
For the respondents	: Mr. Indrajeet Dasgupta, Advocate Ms. Puspita Bhowmick, Advocate Ms. Rima Biswas, Advocate
Reserved on	: 09.02.2023
Judgment on	: 19.05.2023

Ravi Krishan Kapur, J.:

1. This is an appeal under section 117A of the Patents Act 1970 assailing an order dated 19 July 2021 passed by the Assistant Controller of Patents and Designs rejecting the Patent Application filed by the appellants dated 7 January 2017.
2. Briefly, the appellant applied for grant of patent with regard to an invention titled *"A fungicidal treatment for black sigatoka"* which

provides for a treatment method for black sigatoka, a leaf-spot disease in banana plants, caused by the ascomycete fungus Mycosphaerella fijiensis (Morelet) by use of Ortho-phenyphenol.

3. It is contended that the subject invention is a cost effective and environment friendly method for treatment of black sigatoka which eliminates and reduces synthesised chemical fungicides having a significant environmental impact and leaves high residue in soil and agricultural products. The invention also reduces the risk of resistance (decreased sensitivity requiring large doses) and improves the health and yield of the plant increasing in their economic value. It is further contended that until this invention, there was no disclosure or knowledge of any method involving application of the compound Ortho-phenyphenol (OPP) or a salt thereof to control black Sigatoka in banana plants. In short, the subject invention is for a *"process of treatment of plants to render them free from disease".*

4. The objections raised in the FER dated 21 December 2018 were under Section 2(1)(j), i.e., lack of novelty, 2(1)(ja), i.e., lack of inventive steps, 3(d) & 3(e), i.e., non-patentable invention, 3(h),i.e., method of agriculture and 10(4) i.e., lack of clear and sufficient disclosure. The appellants replied to the said FER on 20 June 2019 following which a hearing notice dated 1 October 2020 was issued fixing the hearing on 5 November 2020. Thereafter, in view of the amendments carried out by the appellants, some of the objections raised were waived by the respondent authorities.

5. The main grounds for rejection of the application are set out as follows:

    a. The invention is not patentable under section 3(h) of the Act.
    b. The invention does not disclose the best way of performing the same and suffers from insufficiency of disclosure under section 10(4) of the Act.
    c. Lack of obviousness and inventive steps under section 2(1)(ja) of the Act. (against prior arts D1 to D7 as mentioned in FER).

6. The appellants contend that the objections raised by the respondent authorities are misconceived and untenable. In passing the impugned order, the respondent no.2 considered the application under section 3(h) of the Act which deals with methods relating to agriculture and horticulture whereas the subject invention pertains to a process of treatment of plants to render them free and prevent diseases. Moreover the Controller failed to provide any reasons in arriving at the finding that the subject invention is not patentable under section 3(h) of the Act and also ignored that similar inventions have been granted patent by the Controller details whereof had been fully enumerated in the petition. Significantly, this point has not even been adverted to nor addressed in the submissions of the respondents.

7. It is further alleged that the Controller erred in holding claim nos. 1 to 4 (initially in the FER and subsequently in the impugned order) and claims 11 to 13 (in the hearing notice) as claims lacking sufficient disclosure was unsubstantiated and bereft of reasoning.

8. The appellants also allege that the refusal of the application by the Controller for lack of inventive steps demonstrates that the Controller

misdirected himself in appreciating the invention and comparing the same with reference to prior arts D1 to D7 without appreciating the teachings of the same. The disclosure or teachings was in no way relatable to black sigatoka.

9. On behalf of the respondents, it is contended that claim 12 of the appellant's invention clearly mentions the use of salt of OPP and OPP to control Black Sigatoka sporulations. The use of OPP as a fungicide and biocide is well known to a skilled person. Hence, there is lack of inventive steps in the subject invention. It is further contended that use of reduced dosage of OPP, i.e., new use of a known substance cannot be considered as an invention under section 3(d) of the Act. The respondents further contend that the appellant's claims are contradictory and inconsistent. Although, the invention claims to eradicate fungus completely by the use of OPP however it is claimed that the invention is only to partially eradicate the fungus.

10. Insofar as the objection under section 3(h) of the Act is concerned, i.e. that the subject invention was not patentable, the case of the appellant that the invention was for a "process for treatment of plants to render them free from disease" has been rejected by the Controller. Instead it has been held that the invention claimed is for a method of agriculture which cannot be an invention under section 3(h) of the Act. Sections 3(h) and 3(i) of the Act cover different categories of invention. Section 3(h) is method of agriculture or horticulture which does not contemplate treatment of plants to render them free of disease whereas section 3(i) deals with the process of treatment or

prevention. The Amendment Act 38 of 2002 amended section 3(i) to remove "or plants" from its scope. A comparison of the unamended and amended provisions of section 3(i) is set out hereinbelow:

Section 3(i) originally under Patents Act, 1970	Section 3(i) under Patents Act, 1970 after amendment by Act 38 of 2002 (with effect from 20.05.2003)
(i) *any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals* ***or plants*** *to render them free of disease or to increase their economic value or that of their products.*	*(i) any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.*

11. In passing the impugned order the Controller has failed to explain why the subject patent application falls within the category of "agriculture". In fact, no reasons have been given by the Controller as to why a method of treatment of plants to treat fungal diseases would fall within section 3(h) which covers traditional methods of agriculture. The Controller has also failed to explain why prevention of disease or treatment would fall under agriculture, when there is a separate provision under section 3(i) of the Act. It is evident from section 3(i) of the Act that, the treatment of plants do not fall within the purview of non patentability and the Manual being a mere guiding factor to the statutory provisions of the Act cannot have an overriding effect over the Act. Thus, the finding that the subject invention falls within the definition of "agriculture" does not deal with the submissions of the appellants. In this connection, reliance was also

placed by the appellants on the numerous inventions dealing with treatments of plants enumerated in the petition which have been totally ignored in the impugned order. Reasons are the foundation of any order passed by any judicial or quasi judicial authority. The main objective of providing reasons in any order is to provide clarity to the reader and to understand how and why and how the matter has been proceeded and dealt with by the Authority *[Kranti Associates Private Limited & Anr. vs. Masood Ahmed Khan & Ors. (2010) 9 SCC 496, Uniworth Resorts Ltd. & Anr. vs. Ashok Mittal & Ors. 2007 SCC OnLine Cal 535* and *Santanu Ghosh & Ors. Vs. The State Bank of India & Ors. (2013) 3 CLT 486]*.

12. Moreover, in arriving at the finding that the subject patent lacked sufficiency of disclosure under section 10(4) of the Act, no adequate opportunity was afforded to the appellants. Significantly, at the hearing before the Controller there was no whisper about any objection concerning the disclosure being insufficient for not fully or particularly disclosing the adjuvants as recited in claims 1 to 4. The finding on insufficiency of disclosure also ignores the complete specifications provided by the appellant where the adjuvants have been clearly mentioned.

13. I also find that the finding that the subject invention lacked inventive steps is unreasoned and without appreciating the facts. The Controller has misdirected himself in appreciating the invention and comparing them with reference to the prior arts without understanding and appreciating the teachings thereof. The Written Submissions filed on

behalf of the appellants which highlighted the data provided in the prior arts, which focuses mainly on combined use of two actives has not been considered in the impugned order and is silent about the use of Ortho-phenyphenol *per se*. Each of the prior arts relied on by the Controller had been distinguished to contend that D1 to D7 either alone or read in combination would not lead to the subject invention for treatment of black sigatoka caused by Mycosphaerellafijiensis and are not relevant to the point in issue. This aspect of the matter has also not been considered in the impugned order. In this connection, it has been held that the proper way to construe a specification is to first read that description of the invention and then see the claims [*Bishwanath Prasad Radhey Shyam vs. Hindustan Metal Industries (1979) 2 SCC 511* paragraphs 43-44].

14. There has also been no combination of the prior arts which would help in determining whether the claimed invention was lacking in inventive steps. I also find that in combining the prior arts D1 to D7, the Controller failed to appreciate the teachings thereof. It is important to read the claims of a patent application with their specifications. Thus, it is necessary to read the description of the invention before examining the claims. In *Enercon vs Alloys Wobben (ORA/08/2009/PT/CH*) Order no.123 of 2013, (Paragraph 43) the IPAB has observed that there has to be coherent thread leading from prior art to obviousness or there has to be reasonable expectation of success embedded in the prior art which motivates the skilled person. The tests for deciding inventive steps have been elaborately dealt in

Avery Dennison Corporation vs. Controller of Patents and Designs (2022) SCC OnLine Del 3659 (Para 10-20), and the Controller has ignored the same in deciding the question of inventiveness.

15. For the foregoing reasons, the order dated 19 July 2021 is unsustainable and set aside. The matter is remanded to the respondent authorities to adjudicate the subject patent application afresh including the question of patentability, after giving an opportunity of hearing to the appellant. It is made clear that the aforesaid findings insofar as the merits of the case are concerned, are *prima facie* and not binding on the Controller.

16. With the aforesaid directions, AID 11 of 2011 stands allowed.

(Ravi Krishan Kapur, J.)