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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 07.02.2024

CORAM : JUSTICE N.SESHASAYEE

(T)CMA(PT) No.156 of 2023
(O.A/SR.53/2019/PT/CHN)

NOVOZYMES A/S
(Through its constituted Power of Attorney Holder
Mr.Tanmay Joshi)
KROGSHOEJVEJ 36,
DK-2880 BAGSVAERD
DENMARK ..... Appellant

Vs

The Controller of Patents
The Patent Office
Intellectual Property Building
G.S.T.Road, Guindy
Chennai - 600 032. ..... Respondents

Prayer : Transferred Civil Miscellaneous Appeal filed under Section 117-A of the Patents Act, 1970 praying to issue an order setting aside the impugned order passed by the respondent on January 30, 2019 in connection with Indian patent application 460/CHENP/2013, and direct the respondent to grant a patent on the subject application allowing the present appeal.

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For Appellant : Mr.Debashish Banerjee
Assisted by Mr.D.Subbin
for M/s.Remfry and Sagar

For Respondent : Mr.M.Karthikeyan
Senior Panel Counsel

JUDGMENT

This appeal is directed against an order rejecting the appellant's application for patenting its invention 'Enzyme Dehairing of Skins and Hides'. In its specification, the appellant has indicated that the invention would be useful in the traditional beamhouse processes or wet processing for cleaning the hides or skins of dead animals. The appeal was rejected on two scores :

(a) that it lacks inventive step within the meaning of Sec.2(1)(ja), and

(b) that it is contrary to public order or morality under Sec.3(b) as it is likely to harm animals.

2. Heard both sides. The learned counsel for the appellant submitted that whereas the invention of the appellant is indicated to have its application only on the skins and hides of dead animals for industrial purposes of the tanneries, the Patent Controller had gone wrong in invoking Sec.3(b) of the Act. Developing his arguments further, the learned counsel submitted that so

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far as the objections raised by the Controller under Sec.2(1)(ja) is concerned, he has made short his exercise. Following the application, the Controller came up with its FER, wherein three prior arts D1 to D3 were cited. These D1 to D3 prior arts in essence, relate to the cosmetic process of removing the hairs in human beings or in the process of collecting the collagen from animal skins. In other words, all the three prior arts will have relevance in cosmetic industry, and not in tanneries. The appellant had given its response to the same. Later it was served with a hearing notice where the respondent had restricted his objection only with reference to D1 and D3. It also invoked objections under Sec.3(b), 3(i) and 3(j) of the Act. During hearing, the appellants had amended its claims, and brought down its original claims 25 to a mere 6. Ultimately, the respondent chose to dismiss the appellant's claims citing 2(1)(ja) and 3(b).

3. The learned counsel would further argue that so far as Sec.3(b) is concerned, the very specification is self-explanatory, as the appellant had indicated that it would be used only on hides and skins of dead animals. May be that it had not stated in explicit terms that the hides and skins mentioned therein refers to hides and skins of dead animals. However, inasmuch as it

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has indicated the use of invention in the beamhouse process or wet process, it goes without saying that it would be used only by the tanneries.

4. So far as the objections raised under Sec.2(1)(ja) is concerned, the Controller has not appreciated the entire claims of the appellant. Indeed, in its application, the appellant had explained its inventive step with four tables. The Controller however chose to rely only on Table-II, and cherry-picked only few aspects of Table-III, but not all of them. In short, the Controller did not do a complete job of its responsibility.

5. This Court carefully appreciated the submissions made by the learned counsel, and also verified its correctness by referring to its paper book and material papers. Surely, the Controller could have done a better job.

6. The conclusion is to state the obvious: this appeal deserves to be allowed, and the matter is required to be remanded back to the respondent for *de novo* consideration. The appellant is free to amend the claims, if it considers it necessary to make it clear that its invention is not intended to be applied on live animals, but only on the skins and hides of dead animals. To save

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embarrassment to the Controller who passed the impugned proceedings, this Court directs that the appellant's application is considered by some other Controller. Since the appellant's application is dated in 2013, the Controller who would now be in charge of taking decision on the appellant's application is required to expedite the entire process, and take a decision as expeditiously as possible. No costs.

07.02.2024

Index : Yes / No
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