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**IN THE HIGH COURT OF JUDICATURE AT MADRAS**

DATED: 09.02.2024

CORAM

**MR.JUSTICE N.SESHASAYEE**

(T)CMA(PT) No.182 of 2023

1.Intercontinental Great Brands LLC
100 Deforest Avenue, East Hanover
New Jersey - 07936, USA; Nationality : USA

2.Friesland Campina Nederland B.V.
Stationsplein 4, 3818LE Amersfoort
The Netherlands; Nationality: The Netherlands ... Appellants

Vs.

Assistant Controller of Patents and Designs
Government of India, Patent Office
Intellectual Property Rights Building
GST Road, Guindy
Chennai - 600 032 ... Respondent

Prayer : Civil Miscellaneous Appeals filed under Section 117-A of the Patents Act, 1970 to set aside the order dated 21.11.2016 passed by the respondent and the Application No.1122/CHENP/2007 for patent be allowed to procced to grant.

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For Appellants : Ms.Karuna Goleria
for M/s.Depenning and Depenning

For Respondent : Mr.P.K.Ganesh, CGSC

**JUDGMENT**

This appeal is preferred by the unsuccessful appellants before the Patent Office, whose application for patent was rejected for lack of inventive step under Section 2(1)(ja), 3(e) and 10(4) of the Patents Act, 1970.

2.1 The appellants claim that they have invented 'a soluble foaming composition, and in particular, a foaming protein-free composition'. This Court is informed that this composition when added to beverages such as coffee, soup and certain categories of food products, can produce froth or foam. Indeed, the applicants/appellants claim that this invention has been patented by several countries across the world. However, for patenting the same in India under Patents Act, 1970, the appellants have made an application in 2006.

2.2 The appellants applied for examination, following which the respondent came out with its First Examination Report (in short FER), wherein it cited four

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prior art inventions, viz., D1 to D4. The appellants offered their explanation and made certain amendments to their claims. It may be stated that the appellants have made as many as 46 original claims, of which Claim Nos.1, 18, 21, 26 and 37 are independent claims, and the rest of the claims are dependant claims. The amendments made however, retained the total number of claims that were originally made. Subsequently, the Controller issued a hearing notice, which again cited D1 to D4.

2.3 The appellants participated in the hearing, and also filed their written statement. Along with it, they have also filed a second set of amendments. These amendments also deal with certain internal amendments to the previously made claims. In essence, notwithstanding the earlier amendment, in the last of the amendments made, it also retained the total number of claims originally made at 46.

3. As earlier outlined, the respondent refused to patent appellants' invention on three scores :

(a) that it was not adequately explained how the invention will not be obvious to the person skilled in the art;

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(b) that the respondent also has stated that notwithstanding the appellants' claim that claim Nos.1, 18, 21, 26 and 37 are its independent claims, chose to treat claim Nos.21 and 26 are but extended characterisation of claim Nos.1 and 18 and cannot be termed as independent claims;

(c) that the invention is a mere discovery of a scientific principle of the formulation within the meaning of Sec.3(e) of the Act; and

(d) that the specification is neither sufficiently described nor adequately disclose the nature of the invention made as required under Sec.10(4).

4.1 The learned counsel for the appellants submitted that the Controller has not adequately appreciated the explanations offered by the appellants both to the FER and to the hearing notice, wherein it has not distinguished how the prior arts cited by the Controller has little relevance to the invention of the appellants. The learned counsel submitted that both the prior arts D1 and D2 contain high percentage of protein, whereas prior arts D3 and D4 has little to do with the nature of invention made by the appellants. In particular, D4 deals with an aromatic agent to be added to a foaming agent, while D3 deals with a gasified coffee glass, etc prepared by forming a mixture of 3% to 12% of water,

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and 88% to 97% of coffee derived solids etc., The counsel for the appellants submitted that in Claim No.1, the appellants have described its invention as below :

> *"1. A foaming composition comprising :*
>
> *a foaming powdered protein-free soluble composition comprising carbohydrate particles;*
>
> *having a plurality of internal voids within the carbohydrate particles;*
>
> *containing entrapped pressurized gas within the plurality of internal voids,*
>
> *said composition comprising greater than 98% carbohydrate and less than 1% protein, both on a dry-weight basis and said composition being formed by subjecting said particles to an external gas pressure exceeding atmospheric pressure prior to or while heating said particles to a temperature of at least the glass transition temperature."*

Indeed, the claim itself indicates that the appellants' invention involves only less than 1% protein whereas prior art-1 uses anywhere between 5% to 10% protein, and prior art-2 deals with compounds which also uses about 5% to 50% protein.

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4.2 The learned counsel for the appellant added that the finding of the Controller that amended claim 21 and 26 cannot be termed as independent claim is concerned, claim No.21 in essence deals with a food product composition, and claim No.26 deals with a powder form of foaming composition, whereas 1 and 18 deal with foaming composition. While the composition made remains the same, still the product form through which the composition is expressed is different. But the bottom line here is that the prior arts which made some relevance in the context of the case, both used excessive proteins, whereas the appellants' invention is literally free of proteins, since it will use only less than 1% of protein and this has not been adequately appreciated by the respondent. Here, the explanation offered by the appellant to the FER as well as the written submission becomes critical. But the Controller has not explained why these explanations and whatever that are conveyed to him through the written submissions are not tenable.

5. This court carefully weighed the submissions of the learned counsel for the appellant and perused the impugned proceedings as well as the appellants' specifications and claims and this court finds that the Patent Controller has not held himself with an opportunity to consider the submissions or the

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explanations provided by the appellant to the prior arts even though they are filed before him. In other words, the Patent Controller appears to be unifocal and seems to have focused only on the prior arts and not the explanations offered against them. This necessarily requires to be rectified, which implies that this matter has to necessarily go back to the Patent Controller.

6. In conclusion, this appeal is allowed. The matter is remanded back to the respondent. To save embarrassment to the Controller who had earlier passed the order, this court now requires that the appellants' application be considered by some other patent controller. Since the appellants had filed their application sometime in 2006, this court requires such Patent Controller who would now be in-charge of appellants' application to expedite the entire process and dispose of their application within a period of four months from the date of receipt of a copy of this judgment, which implies that in the eventuality of the appellant obtaining a patent for its invention, it may have a shelf life of barely two years. No costs.

09.02.2024

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Index: Yes/No
Speaking Order / Non-Speaking Order
Neutral Citation: Yes / No

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N. SESHASAYEE, J.

Asr

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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