

**IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Intellectual Property Rights Division)**

BEFORE:

The Hon'ble Justice Ravi Krishan Kapur

IPDPTA/5/2024

BASF SE

VS

JOINT CONTROLLER OF PATENTS AND DESIGNS AND ORS

For the appellant	: Ms. Archana Shankar, Adv. Mr. Devindra Rawat, Adv. Ms .Mini Agarwal, Adv.
For the respondent no.3	: Mr .Arkaprava Sen, Adv. Mr. Sayantan Kar, Adv.
For the respondent no.4	: Mr. Subhatosh Majumdar, Adv. Mr. K.K. Pandey, Adv. Ms. Mitul Dasgupta, Adv. Ms. Amrita Majumdar, Adv. Ms. Pooja Sett, Adv
Judgment on	: 07.03.2025

RAVI KRISHAN KAPUR, J.:

1. This appeal has been filed under section 117A of the Indian Patents Act, 1970 challenging an order dated 4 March 2024 rejecting Patent Application No.4842/KOLNP/2007 titled 'CRYSTALLINE MODIFICATIONS TO PYRACLOSTROBIN'.
2. Briefly, the subject invention relates to a new polymorphic form (Form IV modification) of pyraclostrobin and the process for preparing the same. The polymorphic form has been characterized and defined by its unique X-Ray powder diffraction characteristics. The invention also claimed a process for preparing the crystalline modification IV of pyraclostrobin. It is submitted that there has been undue, inordinate and unexplained delay

in the disposal of the subject application which renders nugatory the purpose and object of the Act. It is urged that only one year of the term of the patent remains out of the stipulated 20 year period. The subject application was filed on 12 December 2007 and has been rejected after a period of approximately 18 years. The term of the subject application is due to expire on 19 June 2026. Thus, the impugned order is liable to be set aside on the ground of delay, being in violation of principles of natural justice.

3. Upon filing of the subject application, three pre-grant oppositions under section 25(1) of the Act were filed by the respondent nos.2, 3 and 4 respectively. The last of such oppositions was filed by the respondent no.4 on 1 March 2024.
4. On merits, it is contended that the impugned order is erroneous and the test to determine the aspect of obviousness has been incorrectly applied. In passing the impugned order, the respondent no.1 has failed to appreciate the technical advantage of the subject invention and has ignored the affidavit filed by the expert and relied on by the appellant.
5. On behalf of the respondent authorities, it is fairly submitted that there is no justification in the delay in disposing of the application. Such an approach by the respondent authorities is destructive of the very purpose and object of having an invention patented and cannot be justified.
6. On behalf of the respondent no.4 it is submitted that, though no appeal has been filed against the impugned order, the objection filed by them has not been considered in accordance with the mandate of the Act.

7. Under section 53 of the Act, the term of any patent is 20 years from the date of filing of an application for the patent. After expiry of the above period any exclusivity attached to such patent ceases to exist and the product or process becomes public property. Delay in such matters is not only violative of the principles of natural justice but also makes a mockery of the entire procedure for grant of patent. Significantly, despite the change in the 2005 amendment being introduced to simplify and rationalize the procedure for grant of patents so that the same could be made more user friendly, delay in such matters cripples the objects of the Act.

8. For convenience, the relevant dates summarizing the proceedings under the Act are set out hereinbelow:

Event	Date
FIRST EXAMINATION REPORT	
PCT Application no. PCT/EP2006 /005869 International filing date	19th June 2006
India Filing Date	12th December 2007
Publication under Section 11A	2nd May 2008
Request for examination filed on	5th May 2009
First examination report	20th February 2012
Response to First examination report	27th November 2012
Respondent No. 2	
Date of Opposition by Respondent No. 2. (Gujarat Insecticides Limited)	22nd April, 2016
Reply Statement by Appellant	2nd September, 2016
Date of hearing in Pre grant Opposition filed by Respondent No. 2	23rd March, 2017
Date of filing written submission by Appellant	10th April, 2017
Written Submissions by Respondent No. 2.	5th April, 2017
RESPONDENT NO. 3	
Date of Opposition by Respondent No. 3 (GSP Crop Science Pvt. Ltd.)	15th November, 2018
Reply Statement by Appellant.	7th November, 2019
Hearing date of Pre Grant-Opposition filed	2nd June, 2022
Date of filing written submission by Appellant.	16th July, 2022
Written Submissions by Respondent No. 3	15th June, 2022
Hearing under Section 14.	17th April ,2023
Date of Opposition by Respondent No. 4	1st March, 2024
Date of refusal under Section 15.	4th March 2024

9. A perusal of the above dates would reflect that there has been a travesty of sorts in disposing of the subject application. The respondent authorities have been sitting over the application till the 18th year of its term. The delay is so obvious that the same can only be described as deliberate and intentional. In particular, there has been delay caused by the particular Hearing Officer at every stage of the proceeding which would be evident from the fact that the response to the First Examination Report was disposed of only after a period of four years. Thereafter, despite the hearing having concluded on 31 March 2017, no order was passed for more than a year. Subsequently, though the pre-grant opposition had been filed and concluded on 2 June 2022, it was not until 17 April 2023 that the respondent issued a Hearing Notice under section 14 of the Act. Later, even after the hearing had been concluded on 17 April 2023 no order was passed until 4 March 2024. In view of the above, on the ground of delay *per se* the impugned order is liable to be set aside being in violation of the principles of natural justice.
10. The impugned order is also unsustainable on merits. In passing the impugned order, the respondent no.1 failed to apply the well settled tests to determine inventive steps. In *Avery Dennison Corporation Vs. Controller Of Patents and Designs (2022/DHC/004697)*, it has been held as follows:

Test for Inventive Step/Lack of Obviousness

10. *In order to decide this issue, some of the fundamental principles for determining the existence of an inventive step and the lack of obviousness need to be emphasised.*

11. *For determining inventive step or lack thereof, various approaches and tests have emerged over the years from decisions of courts/authorities as also from examination guidelines of patent offices from different jurisdictions. The same include:*

i. Obvious to try approach:

- *This approach involves an analysis of whether in view of the teachings/solutions proposed in the prior art, it was obvious to try and arrive at the subject invention.*

ii. Problem/ solution approach:

- *This approach considers whether in the light of the closest prior art and the objective technical problem, the solution claimed in the invention would be obvious to the skilled person. If the skilled person can decipher the solution being claimed, then the subject matter is held to be obvious.*

- *This test has been discussed by the Division Bench in F. Hoffmann-La Roche Ltd. v. Cipla Ltd., (2016) 65 PTC 1 (Del).*

iii. Could-Would Approach

- *In this approach the question that is raised is whether there is any teaching in the prior art as a whole that would and not simply could have prompted a skilled person, with the knowledge of the objective technical problem, to either modify or adapt the closest prior art to arrive at the subject matter of the claims.*

iv. Teaching Suggestion Motivation (TSM test)

- *This test originated in the USA as per which, if by the Teaching, Suggestion or Motivation from the prior art, an ordinary skilled person can modify the prior art reference or combine prior art references to arrive at the claimed invention, then the subject matter being claimed is obvious.*

- *However, the application of this test ought not to be done in a narrow manner as held by the US Supreme Court in the case of KSR International v. Teleflex, 550 US 398 (2007).*

11. Similarly, in *Groz-Beckert KG vs. Union of India and Others (2023 SCC OnLine Cal 111)*, it has been held as follows:

7. *Thus, in determining inventive steps, the invention should be considered as a whole. In other words, it is not sufficient to draw the conclusion that a claimed invention is obvious merely because individual parts of the claim taken separately are known or might be found to be obvious. The contention that an invention is obvious in relation to a particular item must be treated with care and caution. In doing so, the whole picture presented should be taken into consideration and not a partial one. There should be an element of preciseness about what is asserted to be common general knowledge. The “obviousness” must also be strictly and objectively judged. (Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries, (1979) 2 SCC 511 paras 24 & 25, F. Hoffman La Roche Ltd. v. Cipla Ltd. PTC 1 paras 13, 143).*

12. The impugned order is irreconcilable and inconsistent inasmuch as on the one hand, the respondent no.1 has found that the invention is obvious to a person skilled in the art and simultaneously concluded that there was lack of inventive steps and insufficiency of disclosure. In such circumstances, the entire basis of the impugned order to assess the subject invention on the ground of inventive steps under section 2(1)(ja) of the Act has been misapplied and is erroneous.
13. The conclusion that the subject invention was not patentable under section 3(d) of the Act is also untenable. The impugned order does not deal with any of the materials relied on by the appellant to sustain the aspect of technical advantage of the subject invention. Significantly, the impugned order does not deal with any of the documents being A1(WO2004072039), A2(US3272706), A3 (*Solvent Effect on Crystal Polymorphism: Why Addition of Methanol or Ethanol To Aqueous Solutions Induces the Precipitation of the Least Stable B Form of Glycine, Angewante Chemie International Edition, Volume 44, Issue 21, pages 3226-3229, May 20, 2005*), A7 (*Journal of Structural Biology 142, page no.66-76, 2003*) and A8 (*Organic Process Research and Development 2000, 4, 372-383*) which were relied on by the appellant to contend that there was technical advancement in the subject invention and none of the above has been adverted to in the impugned order. The impugned order is *ex facie* erroneous in concluding that the subject invention failed in providing therapeutic efficacy in comparison to crystalline Form-I by disregarding the data which was submitted during the pendency of the application and considered the subsequent developments. The comparative data to

establish inventive steps and section 3(d) demonstrating enhanced fungicidal activity ought to have been dealt with in the impugned order and has been ignored as a known substance with known efficacy of a commercially available amorphous pyraclostrobin.

14. In *Oyester Point Pharma Inc. vs. Controller of Patents and Designs and Another*, 2023 SCC OnLine Cal 2141 it has been held as follows:

12. *Drug development is a lengthy and complex process. It may not be possible to provide all data at the time of filing of the application. Further screening may be required to be carried out before a prospective compound ultimately makes it to clinical trials. Appendix C included the data which showed the activity of the mono-citrate salt at different nAChR subtypes which provides for structural and functional flexibility to play different roles and enhance the efficacy of the compound. In fact, Appendix A, B, C contained data to show that the claimed compound possesses efficacy. The Controller has without assigning any reasons rejected Appendix C and has failed to deal with Appendix A and Appendix B. The object of the present invention was to obtain a stable salt for the preparation of a pharmaceutical formulation. The stability data was provided in Appendix A which has not even been dealt with nor considered in the impugned order.*

15. The findings in the impugned order are also irreconcilable and contradictory to the extent that on the one hand, the respondent no.1 alleged that the invention was obvious to a person skilled in the art and on the other hand held that, based on documents A1, A2 and A3, the use of the solvent and seeding techniques based on A7 and A8, the person skilled in the art could clearly arrive at the process as claimed in claims 4 and 8. This finding is *ex facie* inconsistent. Lack of inventive step and insufficiency of disclosure are antithesis to one another. In this context, it has been observed that:

“We would add one further comment here: there is an interrelationship between obviousness and insufficiency. At first blush one might suppose that an idea which requires masses of work to implement would be more readily rejected by, or less likely to occur to, the notional

unimaginative skilled person/team who is the addressee than one which can be readily put into practice. This produces an apparent paradox: the less sufficient the description, the less is an idea likely to be obvious.” [Terrell On The Law Of Patents’ Sweet & Maxwell]

16. In *Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning a Corporation etc. Vs. unichem Laboratories & Ors.* [AIR 1969 Bom 255] it has been held as follows:

“14. Dealing first with the ground of insufficiency of description it is stated in Halsbury, (3rd edn.) Vol. 29, p. 64, para 131 that the claim need only be as clear as the subject admits, and that a patentee need not so simplify his claim as to make it easy for infringers to evade it. It is further stated in that passage in Halsbury that the patentee's duty is not to prevent all possible argument as to whether there is or is not infringement in particular cases, but to enable the Court to formulate the questions of fact to be answered. It is further stated in the same volume of Halsbury (p. 66, para 138) that insufficiency of description has two branches, (1) the complete specification must describe “an embodiment” of the invention claimed in each of the claims, and that the description must be sufficient to enable those in the industry concerned to carry it into effect “without their making further inventions”; and (2) that the description must be fair i.e. it must not be unnecessarily difficult to follow. Turning first to claim No. 11 in the present case in the light of these principles, the reference in the body of the specification to “a conventional manner” of eliminating sulphur cannot really create any difficulty, and it is in fact unnecessary to import this from the body of the specification into claim No. 11 in view of the fact that claim No. 11 is unambiguous and clear in terms, being wide enough to include all methods of eliminating sulphur. As stated earlier in this judgment, it is permissible to refer to the body of the specification only when there is some difficulty or ambiguity in the construction of a claim as it stands. In any event, hydrogen peroxide as a desulphurising agent would be an obvious chemical equivalent of heavy metal oxides or a salt thereof in an aqueous or alcoholic solution which are also used for desulphurising in “a conventional manner”. Moreover, the secret or discovery essential to the validity of the Plaintiffs' invention as claimed and forming the very basis of it is not the method, but is the previously undiscovered fact of a new class of chemical compounds having hitherto unsuspected blood sugar lowering properties, twenty-one methods of synthesis of sulphonylureas being already known at the material time as is apparent from p. 27 of Kurzer's article on sulphonylureas and sulphonylthioureas in Vol. 50 of the Chemical Review (exh. 1). There is no evidence led by the defendants to show that the statement in the body of the specification that the synthesis of the desired sulphonylurea may be obtained by eliminating sulphur with a heavy metal oxide or a salt thereof in an aqueous or a alcoholic solution would present any difficulty. The specification and claims are addressed to those with a high degree of knowledge of the field of science to which they relate, particularly when they relate to chemistry and allied subjects. It is not necessary to describe processes in the claims to a specification when they are part of the common knowledge available to those skilled in the science who can, after reading them, refer to the technical literature on the subject for the purpose of carrying them into effect. “An embodiment” of the invention is, therefore, in my opinion, sufficiently described in the Plaintiffs' patent and that description is not unnecessarily difficult to follow, it being sufficient to enable the invention to be carried into effect “without...making further inventions.” As far as claim No. 1 is concerned, there are as many as forty examples of it in the specification (exh. A) and there would, therefore, be no difficulty in carrying the same into effect. The ground of insufficiency of description alleged by the defendants must, therefore, fail.

17. In view of the above, the impugned order is unsustainable and set aside.

The appeal stands allowed. In view of the peculiar facts and circumstances and the inordinate delay in disposing of the subject application, the following directions are passed:

- a. To issue a hearing notice within two weeks from the date of this order and dispose of the subject application alongwith all objections within four weeks from the date of communication of this order;
- b. As the documents filed by respondent no.4 in their objection are the same and have been relied upon by respondent no.2, the requirement for issuing notice under Rule 55(3) and the filing of Reply Statement is dispensed with;
- c. The appellant shall address the opposition filed by respondent no.4 at the hearing.
- d. In order to obviate any apprehension of predetermination, the Controller who has passed the impugned order shall not rehear the matter and the subject application alongwith all the objections are to be considered by any other Controller or Appropriate Officer.

18. With the above directions, IPDPTA/5/2024 stands allowed. It is made clear that there has been no final adjudication on merits and all questions are left open to be decided in accordance with law.

(Ravi Krishan Kapur, J.)