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

BEFORE:
The Hon'ble Justice Ravi Krishan Kapur

IPDPTA/2/2025

UPL LTD
VS
THE CONTROLLER OF PATENTS DESIGNS AND TRADEMARK

For the appellant	: Mr. Subhatosh Majumdar, Advocate Ms. Mitul Dasgupta, Advocate Mr. K. K. Pandey, Advocate Mr. Teesham Das, Advocate Ms. Pooja Sett, Advocate Mr. Mallika Bothra, Advocate
For the defendant	: Mr. Siddhartha Lahiri, Advocate Ms. Madhu Jana, Advocate
Judgment on	: 30.04.2025

Ravi Krishan Kapur, J:

1. The appellant assails an order dated 24 October 2024 passed by the Joint Controller of Patent and Designs under section 15 of the Patents Act 1970 rejecting Patent Application No.201731008009 dated 7 March 2017 on the ground of lack of inventive steps under section 2(1)(j) and under section 3(e) of the Act.

2. Briefly, the invention is an agrochemical relating to a combination of fungicides comprising of succinate dehydrogenase inhibitor fungicides (SDHI), alongwith at least another fungicide selected from ergosterol biosynthesis inhibitor fungicide, a quinone outside inhibitor fungicide, plus multi-site fungicide so as to improve disease control and make good

the resistance being developed to a combination of a SDHI fungicide alongwith another fungicide. Fungicides are an integral and important tool utilized by farmers to control diseases, as well as to improve yields and quality of the crops. There are various fungicides which have been developed over the years with many qualities such as specificity, systemicity, curative and eradicant action and high activity at low use rates. It has been found that in controlling fungal diseases, the combination of SDHI plus at least one other fungicide(s) is improved by addition of multi-site fungicide. Such combination also makes good the reduction of effectiveness of the combination of SDHI plus one or more other active(s) (ergosterol biosynthesis inhibitor fungicide, quinone outside inhibitor fungicide).

3. It is contended that the technical advancement in the addition of multi-site fungicide to the combination of SDHI with at least another fungicide results in surprising and unexpected advantages which cause an enhancement of the efficacy and a surprising reduction in fungal disease seen only with the combination of succinate dehydrogenase inhibitors with at least multi-site fungicide and at least one other fungicide which is not an SDHI. The invention is exemplified in examples with accompanying Tables.

4. Upon filing of the above application, the First Examination Report was issued on 29 April 2019 raising objections under section 2(1)(j) in the light of prior art documents D1-D3, under section 3(d),3(e) and 3(h) claiming the subject invention to be non-patentable *inter-alia* on the ground of lack of clarity and definitiveness. The appellant duly replied to

the FER and also filed its amended claims on 25 October 2019. Subsequently, an opposition was filed by one Akash Dhyaneshwar Ugale on 16 November 2022 and a pre-grant hearing was fixed on 22 May 2024. Written Submissions were filed on 19 October 2024. The impugned order was be passed on 24 October 2024.

5. It is contended by the appellant that the respondents failed to appreciate the real object and scope of the invention. The invention was to improve the disease spectrum provided by known combinations overcoming the resistance seen with use of such fungicides. The combination of actives allows broader disease control spectrum which combines curative and preventive actives and has a lower dosage requirement for efficacious control of fungi. The invention shows controlled effectiveness by continuous use over successive years. It is further alleged that the respondent authority failed to appreciate the unexpected advantages resulting in an enhancement of the efficacy and the surprising reduction in fungal diseases is seen only with the combination of succinate dehydrogenase inhibitors with at least multi site fungicide and at least one another fungicide which is not a SDHI. In such circumstances, the finding that the invention is a mere aggregation of known components without any synergistic effect is unsustainable and ignores the technical and scientific evidence relied on by the appellant. The respondent unnecessarily relied on numbers without any justification in rejecting the submissions of the appellant. The finding that the disease control increased merely by 4-5% due to addition of a separate fungicide is also without any basis. It is also alleged that the impugned order is cryptic

and unreasoned. There are no reasons in concluding that the invention lacked inventive steps under section 2(1)(j) of the Act. The impugned order does not consider the prior arts D4-D10 as cited in the hearing notice. There has been no consideration of the materials relied on by of the appellant. The respondents had also failed to issue a Second Examination Report notwithstanding the application being re-examined and new documents being D4-D10 being cited in the hearing notice dated 4 October 2024.

6. On behalf of the respondent, it is contended that the impugned order is adequately reasoned and clearly states that any person skilled in the art would easily understand that the increase in disease control for about 4-5% is due to addition of a separate fungicide chlorothalonil and such combination has nothing surprising nor does it disclose any synergism. The results obtained due to addition of chlorothalonil and TBCS in the mixture of other fungicides in a comparative high dose as an effect of aggregation is a mere admixture and the same is not patentable under section 3 of the Act. It is further contended that failure to issue a Second Examination Report despite the application being re-examined cannot be considered as fatal since the objections raised in the FER were ultimately dismissed.

7. From a perusal of the impugned order, it appears that there are no reasons in arriving at the conclusion that the subject invention lacked inventive steps. Insofar as the prior art documents D4-D10 are concerned, the Controller was obliged to discuss as to what is the existing knowledge and how the person skilled in the art would move

from the existing knowledge to the subject invention. In the absence of any such analysis, the rejection of the application under section 2(1)(j) of the Act ignores the well settled principles followed in adjudicating inventiveness.

8. In *Avery Dennison Corporation vs. Controller of Patents and Designs 2022 SCC OnLine Del 3659,* it has been held as follows:

> *"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):*
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> *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).

14. In Windsurfing (supra) the Court laid down a four-step test to determine whether a patent satisfied the requirement of inventive step and lack of obviousness. The said steps are as under:

"1. Identifying the inventive concept embodied in the patent;

2. Imputing to a normally skilled but unimaginative addressee what was common general knowledge in the art at the priority date;

3. Identifying the differences if any between the matter cited and the alleged invention; and

4. Deciding whether those differences, viewed without any knowledge of the alleged invention, constituted steps that would have been obvious to the skilled man or whether they required any degree of invention."

9. The impugned order also fails to consider the subject invention as a whole. There has been no discussion of the experimental data provided with the application. Tables 1, 2 or 3 which were relied on by the appellant have not been taken into account in passing the impugned order. The impugned order evaluates only Table 4. The impugned order also fails to explain how on a combination of prior arts D4 to D10, if at all, it could be concluded that the invention lacked inventive steps. There is nothing in the impugned order to suggest that Tables 1 and 2 relating to TBCS and Table 3 relating to Chlorothaonil were considered at all by the respondent. These tables present significant data in support of the invention and ought to have been considered and dealt with in the order itself so that the basis of rejection was reflected in the order. The reliance on selective data furnished by the appellant and disregarding of other scientific and technical evidence relied on by the appellant is also a serious infirmity in the impugned order. The impugned order is also irreconcilable inasmuch as that though it records that objections

regarding novelty and unity of invention are considered waived, the order proceeds to reject the application on the ground of lack inventive steps as also under section 3(e) of the Act.

10. In *Stempeutics Research Pvt. Ltd. Vs. Assistant Controller of Patent & Designs 2020 SCC OnLine IPAB 16 it has been held as follows:*

> *"17. Section 3(e) states - What are not inventions: The following are not inventions within the meaning of this Act: ...." a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance". It is stated on behalf of appellant that understanding on the said clause is provided by the 'Guidelines for Examination of Biotechnology Applications for Patent'(hereinafter referred to as the "Guidelines") issued by the Indian Patent Office, which at paragraph 10.12 states that when "old integers placed together has some working interrelation producing a new or improved result, then there is patentable subject matter in the idea of the working inter relations brought about by the collocation of the integers". The Guidelines further clarify this by referring to 'Ram Pratap v. Bhaba Atomic Research Centre, 1976 IPLR 28 at 35', and stating that "...it was held that a mere juxtaposition of feature already known before the priority date which have been arbitrarily chosen from among a number of different combinations which could be chosen was not a patentable invention", Further, Hon'ble High Court of Bombay in the matter of Lallubhai ChakubhaiJariwala v. Chimanlal Chunilal and Co.; AIR 1936 Bom 99 held that "In the case of a combination the inventor may have taken a great many things which are common knowledge and acted on a number of principles which are well-known. If he has tried to see which of them when combined produce a new and useful result, and if he succeeds in ascertaining that such a result is arrived at by a particular combination, the combination will, generally speaking, afford subject matter for a patent. Thus, it appears to us that the applicability of Section 3(e) is valid only in scenarios where a claimed product is obtained by combining known or already existing ingredients, and the burden of showcasing synergistic effect for such product is therefore necessary. Meaning thereby, a product or composition comprising a novel ingredient cannot fall under the ambit of Section 3(e) of the Act. The legislative intent behind Section 3(e) of the Act can further be traced in the Judgment by Hon'ble Supreme Court of India as passed in the matter of Novartis AG v. Union of India; Civil Appeal Nos, 2706-2716 of 2013 wherein it has been held at paragraph 92 that: "The Chapter has the Heading "Inventions Not Patentable" and section 3 has the marginal heading "What are not inventions. As suggested by the Chapter heading and the marginal heading of section 3, and as may be seen simply by going through section 3, it puts at one place provisions of two different kinds: one that declares that certain things shall not be deemed to be "inventions" [for instance clauses (d) & (e) and the other that provides that, though resulting from invention, something may yet not be granted patent for other considerations [for instance clause (b)]."*
>
> *18. Thus, it is settled that most invention are a combination of old elements. The mere existence in the prior arts of each of the elements will not ipso facto means that the invention offend under section 3e of the Act.*

19. We agree with the submissions made on behalf of appellant that applicability of Section 3(e) cannot be looked from the prism of assessing novelty and inventiveness but same has to be looked from the perspective of matter of policy. Further, it shall be applicable only when a claimed product is obtained by combining known or already existing ingredients, and not when integers of the claimed product is itself not known."

11. The impugned order has been passed without considering all the experimental data and Tables before arriving at the conclusion that the invention was merely an admixture of known substances. The respondent also failed to acknowledge the successive increase in the effectiveness of the invention over crops and the reversal of percentage of gradual decay of the same over the years which appeared from the data provided in Table 2 of the application thus overlooking the synergistic effect provided by the invention.
12. The impugned order fails to appreciate that even a minimum of 4-5% increase in therapeutic efficacy of an invention could have a significant long term impact when considered on a larger scale. This also demonstrates a significant increase in disease control. The finding that the entire invention as a mere admixture of known substances is based only on numbers without considering the experimental data as a whole and the therapeutic efficacy of the invention. There has been no discussion of the data furnished in Table 1, Table 2 and Table 3 relied on by the appellant. This also clearly showed surprising as well as synergistic effect of the invention.
13. In *British Celanese Ltd. vs. Courtaulds (1935) 52 R.P.C. 171,* it has been held as follows:

It is accepted as sound law that a mere placing side by side of old integers so that each performs its own proper function independently of any of the others is not a patentable combination, but that where the old integers

> *when placed together have some working inter-relation producing a new or improved result then there is patentable subject matter in the idea of the working inter-relation brought about by the collocation of the integers.*
> *In truth and in fact there is no inter-related working between the integers in the sense that any one of the integers is doing something which it could not do without the presence of one or more of the others. Each integer is in fact performing its own part and is not functionally dependent upon the presence of any other integer at all. I think therefore that the invention lacks subject matter.*

14. From a perusal of the proceedings, it would also appear that the documents D4-D10 were cited in the FER and the hearing notice. Despite the amended claims, the respondent authorities failed to issue a Second Examination Report (SER). The failure to issue a SER is also a procedural infirmity in passing the impugned order. In an unreported decision passed in *Oyster Point Pharma Inc. Vs The Controller of Patents and Designs & anr. AID NO.10 of 2022,* this Court had held as follows:

> "*14. There is also no merit in the contention that the Second Examination Report (SER) was not necessary to be issued and that non-issuance could not prejudice the rights of the appellant. The statutory mandate of section 13(3) must be followed regardless of the consequences and the ultimate result thereof. Hence, the Assistant Controller also erred in not issuing the SER in compliance with section 13(3) of the Act."*

15. In view of the above, IPDPTA no 2 of 2025 stands allowed. The impugned order is set aside. The matter is remanded to the respondent no.1 for consideration afresh after affording the appellant an opportunity of hearing. It is made clear that all questions on the merits are left open for the Hearing Officer to decide afresh in accordance with law. The above exercise is to be completed within 4 (four) months from the date of communication of this order to the respondent authorities.

(Ravi Krishan Kapur, J.)