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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
Date of Decision: 19th October, 2022
 + **C.A.(COMM.IPD-PAT) 482/2022 and I.A. 17130/2022,**
17131/2022

FMC CORPORATION

..... Appellant

Through: Mr. Peeyosh Kalra, Mr. Debashish Banerjee, Mr. Vineet Rohilla, Mr. Ankush Verma & Mr. Rohit Rangi, Advocates. (M:9810948290)

versus

THE CONTROLLER OF PATENTS

..... Respondent

Through: Mr. Harish V. Shankar, CGSC, Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat, Mr. Alexander Mathai Paikaday, Advocates. (M:9810788606)

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J.(Oral)

1. This hearing has been done through hybrid mode.
2. The present appeal under section 117A of the Patents Act, 1970 (*hereinafter 'Act'*) has been filed by the Appellant / Applicant - FMC Corporation (*hereinafter 'Applicant'*), against the order dated 10th May, 2022 passed by the Asst. Controller of Patents & Designs in respect of Applicant's patent application bearing no. 201917036361.
3. The background of the matter is that the Patent Applicant, FMC Corporation, through its predecessor, Bayer Aktiengesellschaft, filed a patent application titled "HERBICIDAL MIXTURES" on 10th September, 2019 in the Indian Patent Office.

4. The patent application, as originally filed, had a total of 13 claims covering a large number of compositions. The First Examination Report (*hereinafter referred as 'FER'*) was issued by the Patent Office on 26th March, 2021. In the FER, objections relating to lack of inventive step under section 2(1)(ja) and non-patentability under Sections 3(d) and 3(h) of the Act as also lack of clarity and definitiveness were raised. The said objections were explained in detail in the FER. The FER also raised objections relating to 'efficacy' of the claimed compositions over the prior art as having not been established.

5. The Applicant filed a Reply to the FER on 24th September, 2021, just before the due date, dealing with the objections raised by the Patent Office in the FER. Along with the response, the Applicant filed an amended set of claims restricting the number of claims to 5.

6. A hearing notice dated 24th February, 2022 was issued by the Patent Office fixing the hearing on 11th March, 2022 for which adjournment was sought by the Applicant. Thereafter, the hearing was rescheduled to 23rd March, 2022 vide hearing notice dated 10th March, 2022 which also reiterated the objections raised in the FER relating to inventive step and non patentability.

7. Hearing was held on 23rd March, 2022 which was duly attended by the patent agent of the Applicant. However, thereafter, the application was completely derailed owing to the non-filing of the written submissions within the stipulated time by the Applicant. First, the Applicant sought extension of time, under Rule 138 of the Patent Rule, 2003 (*hereinafter 'Rules'*), for filing written submissions under Rule 28(7) of the Rules which was granted. Secondly, another extension was sought by the Applicant on

3rd May, 2022 under Rule 137 for obviating irregularities in filing written submissions. However, the second extension was refused.

8. Parallely, the Patent Office passed a separate order rejecting the application on 10th May, 2022. Thirdly, the Applicant preferred a review petition under Sections 77(1)(f) and 77(1)(g) of the Act on 10th June, 2022. Fourthly, the Applicant also filed an application dated 12th July, 2022 for change in the name of Applicant in whose favour the subject patent application was stated to have been assigned. The said assignment is now stated to have been allowed.

9. Fifthly, further submissions were filed by the Applicant in support of the Review on 8th August, 2022 along with an amended set of claims which now consisted of only one claim. However, since the review has not been considered and the patent application stands rejected, the present appeal has been filed challenging the original order dated 10th May, 2022 and praying for consideration of the review application.

10. Mr. Kalra, Id. Counsel appearing for the Applicant submits that the impugned order is completely unreasoned on merits. The Asst. Controller has merely rejected the application on the ground that the written submissions were not filed and the additional data is also not filed within the prescribed period.

11. Mr. Harish V. Shankar, Id. CGSC appearing for the Patent Office on the other hand submits that the Applicant has been given sufficient indulgence by the Patent Office and despite the same the Appellant did not furnish the requisite data of efficacy. In view thereof, the impugned order does not deserve to be interfered with.

12. Heard. A perusal of the impugned order shows that the reasoning given by the Asst. Controller is as under:

“The applicant though attended the hearing did not replied to the objections raised in the hearing notice within the prescribed time period. The additional one month time period offered considering the petition filed under rule 138 of the Patents Act and also adhering the principles of natural justice, is over on 07/05/2022. Moreover the applicant filed petition filed under rule 137 of The Patents Act for further extension of 3 months cannot be considered, as it is against the spirit of the Patents Act and rules. This appears to be an clever attempt by applicant to override the provisions of The Patent Act, as there was ample time for submitting any additional data during the prosecution of the application (i.e.FER was issued in this case on 26/03/2021).”

Based on the above facts and on the circumstances of the case, the objections raised vide Office letter are admitted by the applicant, still outstanding and not met. Therefore, it is hereby ordered that the invention disclosed and claimed in the instant application been refused to proceed further U/s 15 of the Patents Act, 1970.”

13. As per the above order, the Id. Asst. Controller was of the opinion that:

- a) The request of the Applicant for extension of three months for submitting written submissions cannot be considered as it is against the spirit of the Patents Act, 1970.
- b) The attempt of the Applicant was to override the provisions of the Act and additional data during prosecution of the application was not furnished despite ample time having been available since the issuance of the FER in March, 2021.

- c) The objections were not met and hence the invention is not liable to be allowed.

14. The present case is clearly a reflection of how patent applications are being delayed even by the Applicants themselves in the Patent Office. A perusal of the FER would show that all the relevant objections were raised by the Patent Office way back in March, 2021 in the FER itself. The data relating to efficacy ought to have been submitted by the Applicant in response to the FER itself. The Applicant, however, chose to amend the claims. Despite the hearing being held almost one year post the issuance of the FER, efficacy data appears to have not been submitted. In the opinion of the Court, there was sufficient time for furnishing of efficacy or synergistic data by the Applicant.

15. Rule 28(7) of the Patent Rules, 2003 permits parties to submit written submissions and relevant documents in cases where hearing is held. The said Rule reads as under:

“28. Procedure in case of anticipation by prior publication-

(7) In all cases of hearing, written submissions and the relevant documents, if any, shall be filed within fifteen days from the date of hearing.”

16. It is noticed by this Court that the provision merely stipulates that written submissions and relevant documents, if any, ought to be filed within 15 days from the date of hearing. The said sub-rule was not present in the Patent Rules, 2003 as originally framed. Rule 28(7) was inserted vide The Patent (Amendment) Rules, 2016. The IPAB in *Hawar Technologies*

Limited v. The Assistant Controller of Patents [OA/56/2020/PT/DEL, decision dated 12th October, 2020] has outlined the purpose of Rule 28(7) of the Rules in the following words:

“23. As regards the violation of the hearing principle, it is clear that the Patent Acts and rules framed thereunder are code in itself and prescribes the contents of the natural justice and hearing principle. The natural justice in the context of the Patents Act is not merely confined to the hearing orally which according to us in the present case was mere formality and was not done a substantial hearing. But in fact the Patent Act and rules framed thereunder also provides for the provisions of the written submissions. The same reads as under:

Rule 28(7) of the Patents Rules 2003 provides as follows:

(7) In all cases of hearing, written submissions and the relevant documents, if any, shall be filed within fifteen days from the date of hearing.”

Therefore, the contents of the natural justice or hearing principle in the context of the Patents Act is prescribed by the delegated legislation which are rules framed thereunder in the form of Rule 28 (7). In such kind of cases, as per Dharampal (supra), the instrument has to be followed and the same cannot be ignored. Therefore, no provisions of the Act or Rules should be rendered superfluous and the interpretation which should make the provisions workable should be followed.

24. The reason for the expanded version of the natural justice is fair and reasonably simple in the context of the Patents Act. The reason is that the Controller of the Patent is dealing with the technical matters which involve application of

scientific principles along with the legal principles. A brief hearing of hour or so may not suffice as the evaluation of the prior arts and understanding requires extensive readings, appreciations as well as the deduction so as to form an opinion on novelty and inventive step. Therefore, so far as the Patent cases are concerned, the rules of procedural fairness including natural justice as per the Patents Act and Rules framed there under do not end with the hearing and in fact the natural justice continues until the filing of the written submissions which is provided under the Rules dealing with the prior arts enabling the controller to have a reading, appreciation and apply the same. So, in the present appeal, the trigger for violation of the procedural fairness is both the unreasoned decision as well as the violation of the expanded hearing principle, the contents of which are prescribed under the Patent Rules in the form of Rule 28 (7) of the Patent Rules. Therefore, the said violations of the procedural fairness vitiate the impugned order warranting interference in an appeal applying the correction standard.”

17. The purpose of Rule 28(7) of the Rules is thus to capture the submissions made during the course of the hearing and to take any steps which the Controller may have directed in terms of filing of forms or amendments, if any. The written submissions and filing of relevant documents under Rule 28(7) of the Rules cannot be used as a tool to reopen the entire debate. It is meant as a sort of primer of the submissions made and discussions agreed upon during the course of hearing. The purpose of Rule 28(7) is to bring the matter to a closure rather than to reopen the consideration of the patent application.

18. In the present case, repeated adjournments were sought by the Applicant and no written submissions were filed within the prescribed period. Finally, when the application itself was rejected, a review application

was filed, and in support of the review application, amended claim was filed. As per Id. Counsel for the Applicant, the Applicant has now restricted the claim to only one claim. Such a decision to restrict or to narrow the claims ought to be usually taken prior to the hearing and not after the hearing. Even if the Applicant wishes to restrict the claims during the course of hearing, the action and the forms *etc.* for filing the amended claims should be usually done within the time prescribed in law. The same cannot be extended indefinitely leading to further delays in finality being arrived at in respect of the patent applications, thereby resulting in pendency in the Patent Office.

19. Be that as it may, if the Applicant failed to file the written submissions in time and the request for extension was rejected by the Id. Asst. Controller, there was also a duty on the Id. Asst. Controller to consider the objections in the FER and the Reply, as also the submissions made orally during the course of hearing and pass a reasoned order. In the present case, the reasoning has been captured in only one paragraph and would not constitute a reasoned order, considering the detailed Reply which has been filed by the Applicant.

20. The Applicant is substantially to be blamed for the delay in consideration of its application. However, since patent rights are valuable rights and rejection of the patent application can have serious consequences on the Applicant, in the peculiar facts of this case, this Court is of the opinion that this is a fit case for remanding the matter to the Controller for fresh consideration.

21. The Controller shall now take into consideration the pleas of the Applicant made in the written submissions dated 8th August, 2022 as also in the review application. The application shall now be examined and a

decision shall be passed on merits on the basis of the amended one claim which has been now filed by the Applicant along with the written submissions. No fresh hearing shall be given in the application. It must be clarified that this indulgence is being given to the Applicant in view of the fact that the impugned order is unreasoned, however, the same shall be subject to payment of costs of Rs.1,00,000/- to the office of the CGPDTM within four weeks.

22. The order shall be passed within two months.

23. The appeal is allowed in the above terms. Pending applications, if any, are disposed of.

24. The present order shall be communicated by the Registry to the Office of CGPDTM at the email llc-ipo@gov.in for compliance.

**PRATHIBA M. SINGH
JUDGE**

OCTOBER 19, 2022

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