IN THE HIGH COURT OF JUDICATURE AT MADRAS

Judgment reserved on	07.09.2023
Judgment pronounced on	20.09.2023

CORAM:

THE HON'BLE MR. **JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T) CMA (PT) No.33 of 2023
(OA/6/2017/PT/CHN)

Novozymes
Krogshoejvej 36,
DK 2880 Bagsvaerd,
Denmark
Through its Authorized Representative ... Appellant

Vs.

Assistant Controller of Patents & Designs,
Patent Office Chennai,
Boudhik Sampada Bhawan,
G.S.T.Road, Guindy,
Chennai 600032 ... Respondent

PRAYER : This Civil Miscellaneous Appeal filed under Section 117 A of the Patents Act, 1970, prays (i) to allow the present appeal; (ii) pass an order setting aside the impugned order of the Respondent dated 15th November 2016 and pass an order granting a patent on Indian Patent Application No.5326/CHENP/2008.

For Appellant : Ms.Vindhya S. Mani

Mr.Kiran Manokaran
Mr.Sheerabdhinath G
Mr.Gursimran Narula
for M/s. Lakshmikumaran and Sridharan

For Respondent : Mr.K.Subbu Ranga Bharathi,
Central Govt. Standing Counsel &
Mr.Manoj Madhavan,
Deputy Controller of Patents

JUDGMENT

BACKGROUND

The appellant challenges the order dated 15.11.2016 of the respondent refusing to grant a patent in respect of Indian Patent Application No.5326/CHENP/2008. The said application pertains to an invention that was originally titled as "Phytase Variants" and subsequently amended as "Phytase Variants with Improved Thermostability". The amended claims of the appellant include the following:

> *1. A phytase which has an improved thermostablility, wherein the phytase comprises at least one alteration and no more than 4 alterations as compared to SEQ ID NO:2 wherein at least one of said one to four alterations is selected from the*

following:4P, 46E, 52E, 53V, 76G, 107G, 111P, 119K, 162C, 223E, 241Q, 273L, 276K, 379K, 385D, 91C/46C, 52C/99C, 31C/176C, 31C/177C, 59C/100C, 141C/199C, 162C/247C, 111P/241Q, 31C, 202N, 286Q and 362 K,R.

2. The phytase of claim 1, wherein the phytase has improved thermostability indicated as residual activity determined by dividing a supernatant in two parts, one part is incubated for 30 minutes at 60°, and the other part of 30 minutes at 5°C, following which the activity of both is determined on p-nitrophenyl phosphate at 37° C and pH 5.5, where the residual activity of the phytase is the activity of the sample having been incubated at 60°C divided by the activity of the same sample having been incubated at 5°C where the residual activity of the phytase is at least 105% of the residual activity of the reference phytase SEQ ID NO:2, measured in the same conditions.

....

8. A composition comprising at least one phytase of claim 1, and

(a) at least one fat soluble vitamin;

(b) at least one water soluble vitamin;

and/or

(c) at least one trace mineral.

9. The composition of claim 8 further comprising at least one enzyme selected from the following group of enzymes: amylase, phytase, phosphatase, xylanase, galactanase, alpha-galactosidase, protease, phospholipase, and/or beta-glucanase.

10. The composition of any one of claims 8-9 which is an animal feed additive.

11. An animal feed composition having a crude protein content of 50 to 800 g/kg and comprising the phytase of claim 1 or the composition of any one of claims 8-10.

2. By the impugned order, the claims were rejected primarily on the grounds that the claimed invention is in respect of a known substance which is not patent-eligible under Section 3(d) of the Patents Act, 1970 (the Patents Act), and that the composition claims (claims 8 to 11) fall within the scope of Section 3(e) of the Patents Act because the composition is a substance obtained by the mere admixture of ingredients. It is pertinent, in this regard, to notice and record that there is nothing in the

impugned order that indicates that the claimed invention does not possess the attributes to qualify as an invention under Section 2(1)(j) of the Patents Act or that requisite disclosure was not made to work the invention.

CONTENTIONS

3. Oral arguments on behalf of the appellant were addressed by Ms.Vindhya S. Mani, learned counsel from M/s.Lakshmikumaran and Sridharan; and on behalf of the respondent by Mr.Subbu Ranga Bharathi, learned Central Government Standing Counsel, and Mr.Manoj Madhavan, Deputy Controller of Patents.

4. The first contention of Ms.Vindhya S. Mani was that Section 3(d) of the Patents Act applies only to pharmaceutical substances. In support of this contention, learned counsel relied upon the judgment of the Division Bench of this Court in *Novartis AG v. Union of India (Novartis DB), Manu/TN/1263/2007,* particularly paragraph 12 thereof, wherein the Division Bench

concluded that the first limb of Section 3(d) is referable only to the field of pharmacology. She also placed reliance on the judgment of the Hon'ble Supreme Court in *Novartis AG v. Union of India (Novartis SC), (2013) 6 SCC 1*. Specifically, she relied on paragraphs 81-82, 87-88 and 157 of *Novartis SC* to contend that the amendment was intended to deal only with chemical substances, more particularly pharmaceutical products.

5. The next contention of Ms.Vindhya S. Mani was that the Explanation to Section 3(d) enumerates several derivatives of chemical substances. After such enumeration, the generic expression "and other derivatives of known substance" is used. After contending that all the enumerated derivatives fall within the genus "derivatives of chemical substances", she relied on the *ejusdem generis* principle and contended that the generic expression "and other derivatives of known substance" should be limited to derivatives of chemical substances and that it should not be extended to biochemical substances such as phytase. Consequently, she contended that the Explanation to Section 3(d)

and, by implication, Section 3(d) does not apply to the claimed invention.

6. Without prejudice to the above contentions, the third contention of Ms.Vindhya S. Mani was that Section 3(d) enables the grant of a patent for a new form of a known substance provided such new form results in the enhancement of the known efficacy of that substance. By drawing reference to the complete specification of the claimed invention, learned counsel submitted that the claimed invention enhances the thermostability of phytase. According to her, such enhanced thermostability improves the overall efficacy of the product by, for example, enabling the product to be produced and marketed in pellet form. In order to substantiate this contention, learned counsel invited my attention to Example 8 of the complete specification, which pertains to temperature stability. By referring to Table 5 therein, she pointed out that various phytase variants are listed in Table 5, starting with the mutation labelled as T410E and ending with the mutation labelled as G52C/A99C, and that all these variants show

an Improvement Factor (IF) in excess of one. Therefore, learned counsel submitted that the claimed invention satisfies the test of enhanced efficacy of the variants of phytase.

7. Turning to the rejection of the application by relying on Section 3(e) of the Patents Act, learned counsel submitted that Section 3(e) does not apply unless the substance is obtained by a mere admixture of known ingredients. Moreover, she contended that Section 3(e) only applies to independent claims and not to dependent claims such as claims 8-11. By referring to Claims 8 to 11, learned counsel pointed out that claim 8 refers to a composition comprising at least one phytase of claim 1; at least one fat soluble vitamin; at least one water soluble vitamin; and/or at least one trace mineral. Since the primary ingredient is a variant of phytase of claim 1, she contended that Section 3(e) is inapplicable.

8. In response, it was submitted on behalf of the respondent that Section 3(d) of the Patents Act uses the expression "known substance" and not "pharmaceutical substance".

Therefore, it was contended that Section 3(d) is not limited to pharmaceutical products. Since phytase is a biochemical substance, the respondent submitted that it falls within the scope of Section 3(d) and, in particular, the Explanation thereto. With reference to the Explanation, the respondent contended that the expression "and other derivatives of known substance" also applies to variants of phytase because phytase and its variants are biochemical substances. It was further submitted that there is nothing in the text of the Explanation that limits the scope thereof to synthesized chemicals.

9. In addition, the respondent contended that a new form of a known substance is not patent-eligible unless it results in the enhancement of the known efficacy of the substance. Since the substances in question are variants of phytase, which is an enzyme, the respondent contended that enhancement of efficacy can be claimed only if the appellant successfully demonstrates that the enzymatic activity of the phytase is enhanced by the variants in respect of which the patent is claimed. By pointing out that the

appellant's claims of enhanced efficacy are limited to improved thermostability, it was submitted that unless the variants of phytase - an enzyme that acts as a catalyst for digestion - exhibit greater efficacy in catalysing digestion by the cattle/end-user of the substance, it is not patent-eligible.

10. As regards the applicability of Section 3(e) of the Patents Act, the respondent contended that Claims 8 to 11 are composition claims. In composition claim 8, detailed particulars of ingredients other than phytase are not provided. The respondent further submitted that a composition claim is not patent-eligible unless the applicant for patent demonstrates that there is synergy between the ingredients forming the composition and that, as a result, the composition is more than the sum of its parts.

11. By way of rejoinder, learned counsel for the appellant submitted that the composition claims are dependent on independent claim 1. In such circumstances, she contended that it is not necessary that the ingredients constituting the composition

should have synergistic qualities. As regards the objection under Section 3(d), learned counsel submitted that phytase is a biochemical substance and that all the enumerated derivatives in the Explanation to Section 3(d) are derivative forms of synthesized chemicals. Consequently, she reiterated the contention that the expression "and other derivatives of known substance" should be confined to other derivative forms of synthesized chemicals. As regards efficacy, she contended that thermostability is not an inherent characteristic of phytase. If so, any phytase may be used as a catalyst for digestion. By further contending that thermostability directly enhances the ability to produce the variants of phytase in pellet form and also reduces dosage requirements, she concluded her submissions by submitting that enhanced thermostability, therefore, enhances the known efficacy of the substance.

DISCUSSION, ANALYSIS AND CONCLUSION:

REJECTION UNDER SECTION 3(d):

12. Section 3(d) of the Patents Act is set out below:

> "***3. What are not inventions.*** *- The following are not inventions within the meaning of this Act,-*
>
> ....
>
> *(d)* ***the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance*** *or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.*
>
> *Explanation : For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance* ***shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy****; "(emphasis added).*

As is evident from the opening "the following are not inventions" expression, which applies to all clauses [(a) to (p)] of Section 3, the provision incorporates a legal fiction by which claims for patent

that fall within the clauses of Section 3 will not qualify as inventions, even if such claims meet the requirements of Section 2(1)(j) of the Patents Act, unless they pass through the exemption filters that are built into some of the clauses therein. The principal clause of Section 3(d) contains about three limbs, which are separated by the disjunctive "or". The three limbs are as under:

> *(i) The mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance.*
>
> *(ii) The mere discovery of any new property or new use for a known substance.*
>
> (iii) *Of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.*

While it could be contended that there are four and not three limbs because of the placement of the disjunctive "or " before the phrase "new use for a known substance" in what I labelled above as the second limb, I conclude that the second limb is one limb consisting of two segments because the subject of both segments (i.e. "new

property" or "new use") of said limb is "known substance". The break-up of Section 3(d) also reveals that both the first and second limbs deal with and govern claims relating to known substances. While the first limb deals with and governs claims relating to new forms of a known substance, the second deals with and governs new properties or new uses thereof. For the sake of completion, it may be noticed that the third limb excludes from patent-eligibility, a mere use of a known process, machine or apparatus. It also provides for an exception if such known process results in a new product or employs at least one new reactant.

13. The first question that falls for consideration is whether the expression "known substance" in Section 3(d) is confined to pharmaceutical substances as contended by learned counsel for the appellant. Learned counsel for the appellant relied on *Novartis DB* and *Novartis SC* to substantiate said contention. In *Novartis DB*, in the factual context of a claimed invention for the beta crystalline form of Imatinib Mesylate, Section 3(d), as amended by the Patents (Amendment) Act, 2005, was challenged

on the grounds that it violates the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement) and Article 14 of the Constitution of India. While upholding the validity of Section 3(d), the Division Bench held as follows, in relevant part, in paragraph 12 of the Manupatra publication:

> *".... The amended section is not confined only to drugs as it deals with machines and apparatuses as well. But however, we are clear in our mind that the portions of the amended section and the Explanation under attack is definitely referable only to the pharmacology field namely, drugs."*

By relying on the above extract, learned counsel for the appellant contended that the first limb of Section 3(d) read with the Explanation thereto applies only to pharmaceutical products. In *Novartis DB*, at paragraph 13 of the Manupatra publication, the Division Bench also held, in relevant part, as under:

> *"....The amended section not only covers the field of pharmacology but also the other fields. As we could see from the amended section, it is made applicable to even machine, apparatus or known process with a rider that*

mere use of a known process is not an invention unless such a known process results in a new product or employs at least one new reactant. Therefore the amended Section is a comprehensive provision covering all fields of technology, including the field of pharmacology. In our opinion, the Explanation would come in aid only to understand what is meant by the expression "resulting in the enhancement of a known efficacy" in the amended section and therefore we have no doubt at all that the Explanation would operate only when discovery is made in the pharmacology field...."

While the above extracted paragraph 12 appears to indicate that certain portions of the main clause and Explanation apply only to pharmaceutical products, when read with the above extracted paragraph 13, the conclusion that emerges is that it was held in *Novartis DB* that Section 3(d) is not limited in its application to pharmacology but that the Explanation is limited thereto. It was further held therein that the expression "efficacy" in Section 3(d) means therapeutic efficacy in the context of pharmaceutical products. Since the Supreme Court pronounced a detailed judgment in *Novartis SC*, such judgment should be considered before drawing conclusions.

14. *Novartis SC* was a judgment pronounced in appeals against the decision dated 26.06.2009 of the Intellectual Property Appellate Board (the IPAB) rejecting the application by Novartis for grant of patent. In paragraphs 82, 87 and 157 of the SCC publication, the Supreme Court held, in relevant part, as under:

> "82...*the amendment is primarily in respect of medicines and drugs and, to some extent, agricultural chemical substances.*"
>
> "*87....We have, therefore, no doubt that the amendment/addition made in Section 3(d) is meant especially to deal with chemical substances, and more particularly pharmaceutical products....*"
>
> "*157. What is "efficacy"? Efficacy means "the ability to produce a desired or intended result". Hence, the test of efficacy in the context of Section 3(d) would be different, depending upon the result the product under consideration is desired or intended to produce. In other words, the test of efficacy would depend upon the function, utility or the purpose of the product under consideration. Therefore, in the case of a medicine that claims to cure a disease, the test of efficacy can only be "therapeutic efficacy....".*

15. Thus, it was held in *Novartis SC* that the amendment of Section 3(d) by the Patents (Amendment) Act, 2005 was primarily and especially intended to deal with pharmaceutical products and agro-chemical products. It does not, however, follow from the above that it only applies to pharmaceutical and agro-chemical substances and not to biochemical substances. It was further held by the Supreme Court that the test of efficacy under Section 3(d) would vary depending on the product under consideration and that, in the context of pharmaceutical products, it means therapeutic efficacy. Against this backdrop, Section 3(d), including the Explanation thereto, is analysed from the perspective of applicability to variants of phytase.

16. In the Explanation to Section 3(d), several derivatives such as salts, esters, ethers, polymorphs, metabolites and the like are enumerated. Learned counsel for the appellant asserted that all the enumerated derivatives are derivatives of synthesized chemicals and not of biochemicals or chemicals found in living

organisms. The respondent was unable to refute this contention but maintained that the scope of the Explanation is not limited to synthesized chemicals. Biochemicals broadly fall within the following four classes, which have the illustrative derivative forms set out in parenthesis against the relevant class: carbohydrates (amino sugars, deoxy sugars); proteins (peptones, peptides); lipids (phospholipids, glycolipids); and nucleic acids (nucleotides, nucleosides). Significantly, these derivative forms are distinguishable from the derivatives of synthesised chemicals, including those listed in the Explanation to Section 3(d). The inference that flows from the above discussion is that the enumerated derivatives fall within the scope of a common genus, namely, derivatives of synthesized chemicals. The interpretive principle of *ejusdem generis* applies when two or more specific words that fall within a common class (i.e. two or more species of a common genus) are used expressly in a statute and are followed by a generic word. By application thereof, the generic word would be limited in its application to other words/species that form part of the same genus. For example, if the list runs: cars, buses,

scooters and other modes of transport, the generic expression 'other modes of transport' would be construed as limited to other modes of road transport such as motorcycles or autorickshaws but would not extend to trains or aircraft. Likewise, the principle of *ejusdem generis* is clearly applicable to the construction of the expression "and other derivatives of known substance". If so construed, the Explanation becomes inapplicable to the claimed invention, which is for variants of phytase, i.e. an enzyme/biochemical. This conclusion is also in consonance with *Novartis DB.*

17. The question that follows is: what is the sequitur of the inapplicability of the Explanation to the claimed invention? The Explanation to Section 3(d) incorporates a legal fiction by which all chemical derivatives of a known substance would be considered as the known substance unless such derivatives cross the hurdle or pass through the filter prescribed therein. This is evident from the expression "shall be considered to be the same substance unless they differ significantly in properties with regard

to efficacy". In effect, the sequitur of the claimed invention not falling within the scope of the Explanation is that it qualifies as a new form of a known substance even if it does not cross the hurdle prescribed in such Explanation. This, however, does not mean that Section 3(d) becomes inapplicable to the claimed invention. Indeed, it should be noticed that the Explanation does not apply to Section 3(d) in entirety, as underscored by its undoubted inapplicability to the third limb of Section 3(d), which deals with known processes, known machines and known apparatuses and not with known substances.

18. The limited fall out of the above discussion is that the appellant may claim that the phytase variants for which it seeks a patent are new forms of a known substance. Even so, the appellant would not be entitled to a patent unless the appellant passes the filter of "result in the enhancement of known efficacy of that substance" prescribed in the substantive provision *de hors* the Explanation. I turn to the said issue next.

19. The appellant asserted that the claimed invention results in improved thermostability and that such improved thermostability should be construed as an enhancement of the known efficacy of phytase. By way of substantiation, the appellant relied on Example 8 and Table 5 of the complete specification. The respondent does not dispute the improved thermostability of the variants of phytase of the appellant, but the respondent contends that thermostability is an inherent or at least desirable characteristic of phytase and that enhanced thermostability is insufficient to establish enhanced efficacy.

20. From the data set out in Table 5 of the complete specification, it is discernible that the thermostability of the reference phytases was much lower than the thermostability of the variants. While Section 3(d) uses the expression "the enhancement of the known efficacy of that substance", there is nothing in the text that limits such enhancement to any specific type of efficacy. As discussed earlier, in *Novartis SC,* the Supreme Court concluded that the test of efficacy would be different depending on the

function, purpose or utility of the product. The respondent contended that phytase is an enzyme and that, therefore, the enhancement of efficacy means no more than enhancement of the enzymatic activity of the variant of phytase.

21. The contention of the respondent that thermostability is an inherent characteristic of phytase is not in consonance with the data on record if construed as meaning that all phytases, including the reference phytase, would exhibit identical or substantially similar thermostability. If construed as meaning that the variants engineered by the patent applicant have inherently greater thermostability, the follow-on question is: would that satisfy the requirements of Section 3(d)? The reasoning in the impugned order with regard to efficacy is as under:

> *"Phytase (myo-inositol hexakisphosphate phosphohydrolase) is any type of phosphatase enzyme that catalyzes the hydrolysis of phytic acid (myo-inositol hexakisphosphate) – an indigestible, organic form of phosphorus that is found in grains and oil seeds – and releases a usable form of inorganic*

phosphorus. While phytases have been found to occur in animals, plants, fungi and bacteria, phytases have been most commonly detected and characterized from fungi. Phytases are widely used in animal feed industry to increase availability of phosphorous in animal diets.

Instant claims relate to variants or modifications of known phytases.

....

As is evident from the prior art, phytaase is a phosphatase enzyme whose efficacy lies in catalyzing enzymatic reactions resulting in break-down of indigestible form of phosphorus to form a usable form which can be easily digested by animals.

In order to overcome non-patentablity under Section 3(d), the new form of known phytase would be expected to exhibit enhancement of the known efficacy of the phytase enzyme.

However instant application does not substantiate anything in this regard. All efforts have been directed towards obtaining increased thermostability of the claimed variant.

Now, as far as animal feed is concerned, properties like thermostability, increased storage time i.e. shelf life, particle size, better flowability are all desirable

characteristics, however this does not impart efficacy to the claimed phytase variant used in the feed.
As there is no support in the description for increased phytase activity resulting in enhanced hydrolysis of phytates, instant amended claims 1, 2 pertaining to phytase variant are not patentable under Section 3(d) of the Act."

The above extracts from the impugned order indicate conclusively that the claimed invention was rejected on the ground that the expression "enhancement of the known efficacy of the substance" should be construed as limited to enhanced hydrolysis of phytate resulting in improved breakdown of the indigestible form of phosphorus to a digestible form.

22. Without doubt, the primary function of phytase is to act as a catalyst that aids digestion. That does not mean that enhanced hydrolysis of phytate by the variants of phytase should be established as an essential pre-requisite to pass through the filter of enhancement of the known efficacy of phytase. An increase in thermostability admittedly means the enzyme can

resist and survive exposure to higher temperature. As a consequence, it enables pelletization without de-activation or denaturation of enzymatic activity. The application of molecular techniques to prospect thermostable phytases appears to be critical for the animal feed and fuel industries and reference may be made, in such regard, to the article by *Ushashree Mrudula Vasudevan, Amit K.Jaiswal, Shyam Krishna, Ashok Pandey,* "*Thermostable phytase in feed and fuel industries"*in *Bioresource Technology, Volume 278, 2019, pages 400-407*. Since increased thermostability precludes denaturation and enables production, storage and sale in pellet form, it enhances the known efficacy of the enzyme in aiding digestion especially when used in animal feed. In my view, there is nothing in the text or context of Section 3(d) which supports the interpretation that enhancement of known efficacy of the substance should be restricted to engineering or prospecting variants of phytase with inherently greater enzymatic activity over the reference phytase.

23. Another aspect, however, should be taken note of: would even a marginal improvement in efficacy suffice? In cases where the Explanation applies, the derivative should exhibit significant difference in properties with regard to efficacy to not be construed as the same substance. The substantive provision, by contrast, only requires enhancement of the known efficacy with no indication as regards margin of enhancement. Given that Section 3(d) applies to new forms of a range of known substances, even by way of guidelines, it may not be possible to fix a numerical value or percentage of enhancement that applies across the board, and this appears to be the position taken by the Patent Office in its guidelines. The only workable solution appears to be for the patent applicant concerned to establish that there is reasonable enhancement of efficacy to the satisfaction of the Controller of Patents, and reasonable enhancement may be defined as enhancement that is material from an improvement of efficacy perspective. In the case at hand, numerical values were assigned to the claim of enhanced efficacy by adopting measurement units such as IF, and no objections were raised as regards materiality by

the respondent. For reasons set out above, it is concluded that the claimed invention of the appellant satisfies the requirement of enhancement of known efficacy of phytase.

REJECTION UNDER SECTION 3(e):

24. Section 3(e) is as under:

> *"(e) 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;"*

Section 3 (e) applies to a substance obtained by merely mixing two or more components/ingredients. From the text of Section 3(e), it is clear that it is intended to prevent the grant of patents to a claimed invention for a substance that merely combines components unless the substance produced by such combination is more than the sum of its parts.

25. The objection on the ground of Section 3(e) is confined to amended claims 8 to 11, all of which are composition claims. The contention of the respondent is that a composition claim in

respect of a substance obtained by the mere admixture of two or more ingredients cannot be granted unless the applicant for patent establishes that, as a result of synergy between the ingredients, the composition exhibits properties which are not limited to the aggregation of the properties of the individual ingredients thereof.

26. Claim 8 is a composition claim comprising the following:

(a) at least one phytase of claim 1;

(b) at least one fat soluble vitamin;

(c) at least one water soluble vitamin; and/or

(d) at least one trace mineral.

Thus, claim 8 is founded on and dependent on claim 1 and the principal ingredient is the variant of phytase forming the subject of claim 1. Claim 9 goes beyond claim 8 and embraces not only phytase but all the following group of enzymes: amylase, phytase, phosphatase, xylanase, galactanase, alpha-galactosidase, protease, phospholipase, and/or beta-glucanase. Claims 10-11 are for animal feed compositions.

27. On examining the text of Section 3(e) and, indeed even by placing such text in context, I find that there is nothing therein that limits its application to a composition claim formed by the aggregation of known ingredients. By way of context, I notice that the adjective "known" is used as a qualifier in the following clauses of Section 3: Section 3(d)["known substance"]; Section 3(f) ["known devices"]; and Section 3(p)["known properties of traditionally known component or components"], but is conspicuous by its absence in Section 3(e). I recognise that this view does not accord with that reached by the Intellectual Property Appellate Board in *Stempeutics Research Pvt. Ltd. v. Assistant Controller of Patent & Designs,* 2020 SCC OnLine IPAB 16, but in the absence of textual or contextual support I decline to read the adjective "known" into Section 3(e) and place it before the noun "components" therein. The consequence of this conclusion is that, as in this case, if any of the ingredients of the composition independently satisfies the requirements for an invention under the Patents Act, a patent may be applied for and granted in respect thereof notwithstanding Section 3(e).

28. Equally, Section 3(e) does not appear to be limited in its application to independent claims. Instead, the object and purpose, as gleaned from text and context, appears to be to exclude from patent-eligibility any composition claim for a substance that merely exhibits the aggregate properties of its constituents. Learned counsel for the appellant contended that the composition claims would not expand the scope of the patent, if granted, because the appellant would be in a position to institute infringement proceedings against any person who infringes its patent as regards independent claims, including by producing a composition containing the said variant of phytase. This contention does not appear to be correct as regards claim 9, and, as regards truly dependent claims, patent protection for the independent claim serves the purpose of protecting against infringement even against unauthorised use of the patented substance as an ingredient in a composition. And, in any event, a patent cannot be granted for a composition claim solely for that reason. Therefore, the rejection of composition claims 8-11 is

justified in the absence of evidence that the composition is more than the sum of its parts.

29. In view of the above analysis, the impugned order is liable to be and is, hereby, set aside partly as regards the rejection of claims 1-7. Since the respondent did not raise any objections as regards the requirements of novelty, inventive step, capability of industrial application or completeness of disclosure and the objections were limited to Section 3(d) and 3(e), the application shall proceed to grant on the above modified terms. The appeal stands disposed of on the above terms. There shall be no order as to costs.

20.9.2023

Index : Yes/No

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SENTHILKUMAR RAMAMOORTHY J.

Pre-delivery judgement made in

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