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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ W.P.(C)-IPD 15/2023 & CM No. 34-35/2023

WILLOWOOD CHEMICALS PRIVATE LIMITED Petitioner

Through: Mr. Hemant Singh, Ms. Mamta Rani
Jha, Mr. Siddhant Sharma and Mr.
Abhay Tandon, Advocates.

versus

ASSISTANT CONTROLLER OF PATENTS

AND DESIGNS & ANR.

.... Respondents

Through: Mr. Harish Vaidyanathan Shankar,
Central Government Standing
Counsel with Mr. Srish Kumar
Mishra, Mr. Sagar Mehlawat and Mr.
Alexander Mathai Paikaday,
Advocates.

Mr. Ajay Amitabh Suman, Advocate
for R-2.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA

ORDER

17.03.2023

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1. Petitioner invokes Articles 226/227 of the Constitution of India, 1950 to impugn the Report/ Recommendations of the Opposition Board issued on 29th November, 2022 in respect of post-grant opposition filed by Respondent No. 2 – Safex Chemicals India Ltd. [*hereinafter*, “**Safex**”] to Petitioner’s Indian Patent No. 342004 [*hereinafter*, “**subject patent**”].

2. As per the scheme of the Patents Act, 1970, the impugned Report would now be considered by Respondent No. 1 – Assistant Controller of Patents and Designs for rendering a final decision in terms of Section 25(4)



of the said Act, and for that purpose a hearing has been scheduled for 11th April, 2023.

Petitioner's grounds of challenge

3. Mr. Hemant Singh, counsel for Petitioners, argues as under:

3.1. The Report of the Opposition Board is patently perverse, contrary to the well-settled tests of novelty, inventive step and suffers from manifest errors of law. Opposition Board has, without any convincing reason, departed from Controller's findings.

3.2. Majority of the documents cited by Safex in the notice of post-grant opposition have already been considered by the Controller while deciding the pre-grant opposition and granting the subject patent in Petitioner's favour.

3.3. Opposition Board has committed fundamental error in concluding that subject patent lacks novelty in view of prior art documents. It is well-settled proposition in law that a claim of patent is anticipated only if all elements as set forth therein, are disclosed in a single prior art reference. Subject patent is for a fungicidal composition comprising combination of Hexaconazole and Validamycin in the range of 2.5-5% and 1.5-3%, respectively. D1 only discloses use of these elements in a very broad range, without disclosing the specific amount of the active ingredients. Similarly, D6 merely discloses their percentage but there is no teaching, motivation or suggestion therein to modify the disclosure of D6 by changing the composition of Hexaconazole and Validamycin.

3.4. The objection under Section 3(e) of the Patents Act is unsustainable as the combinatorial effect of the subject patent's components is greater than



the mere sum of their effects alone.

3.5. Expert affidavits submitted by Petitioner were not considered. Further, the Board has erroneously treated coverage of a patent as being equal to disclosure in complete specification.

3.6. As per Rule 56(4) of the Patent Rules, 2003, Board must submit their report within three months from the date on which relevant documents were forwarded to them; however, the impugned Report was delivered after almost one year from the date of filing of all documents.

3.7. Safex filed additional evidence after the hearing date had been fixed by the Assistant Controller, which is not permissible and cannot be considered. It is unclear as to whether these additional documents have been taken into consideration by the Board while giving the impugned findings.

3.8. Apprehending that Respondent No. 1 will be unduly influenced by the misconceived and untenable findings of the Opposition Board and pass an adverse order, Petitioner has been constrained to file the present petition for quashing of the Report and constitution of a new Opposition Board.

Respondents' contentions

4. Mr. Harish Vaidyanathan Shankar, CGSC for Respondent No. 1 and Mr. Ajay Amitabh Suman, counsel for Respondent No. 2, strongly contested maintainability of the present petition on the ground of availability of an efficacious remedy against a final decision of Controller under Section 25(4) of the Act. They argue that Report only makes recommendations and challenge thereto should not be entertained at this stage, particularly since the grounds urged by Petitioner touch upon the merits of Opposition Board's decision. This Court cannot sit in appeal over these recommendations and



Petitioner can urge their grievances before the Controller at the time of hearing/ consideration of the impugned Report.

Analysis

5. The Court has considered the afore-noted submissions advanced by counsel for parties. In *Cipla Ltd. v. Union of India*,¹ the Supreme Court commented upon the relevance of recommendations of the Opposition Board in the following terms:

“11.... Provisions of the Act and Rules, therefore, clearly indicate that the Opposition Board has to make its recommendations after considering the written statement of opposition, reply statement and evidence adduced by the parties with reasons on each ground taken by the parties. Rule 62 also empowers the Controller to take into consideration the reasons stated by the Opposition Board in its report. In other words, the report of the Opposition Board has got considerable relevance while taking a decision by the controller under Section 25(4) of the Act read with Rule 62(5) of the Rules”

6. Indeed, the scheme of the Patents Act and Rules framed thereunder envisage considerable relevance of the recommendations of the Opposition Board while deciding the post-grant opposition under Section 25(4) of the Patents Act read with Rule 62(5) of the Patent Rules. The Controller, nevertheless, retains the prerogative to diverge from the findings of the Opposition Board, should the facts and circumstances justify such an action. While the recommendations carry weight, the Controller is required to employ independent thought in determining whether to uphold, modify, or revoke the patent. Regardless, the legal framework does not permit an appeal against the Opposition Board’s recommendation or scrutinizing the validity of the Report and declaring it unsustainable. The Act, under Section 117A(2), provides for an appeal once the Controller takes a final decision.



Petitioner cannot thus be permitted to challenge the recommendations on merits under Article 226/227 of the Constitution.

7. Petitioner has failed to demonstrate any manifest jurisdictional error. Their allegation of perversity and inconsistency with settled legal principles would require the Court to assume appellate jurisdiction at this stage, which is beyond the scope of the enactment. It is also pertinent to note that Controller has not finally decided Safex's opposition as yet, and therefore, Petitioner has the opportunity to satisfy the Controller on grounds to maintain the patent, at the time of hearing.

8. For the foregoing reasons, the Court is not inclined to entertain the present petition and accordingly, the same is disposed of leaving the Petitioner free to raise all contentions raised in the present petition before the Controller, in accordance with law.

9. It is further clarified that merits of the case have not been examined and no opinion has been expressed thereon. Controller shall adjudicate the post-grant opposition on its own merits after hearing all the stakeholders, and render a decision thereon under Section 25(4) of the Patents Act read with the Patent Rules.

10. With the above directions, the present petition is disposed of, along with other pending applications.

SANJEEV NARULA, J

MARCH 17, 2023

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(Corrected and released on 25th March, 2023)

¹ (2012) 13 SCC 429.