2025:MHC:2659

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on	**28.08.2025**
Pronounced on	**20.11.2025**

CORAM:

THE HONOURABLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

C.M.A.(PT) No. 21 of 2024

M/s.Rallis India Limited
23rd Floor, Vios Tower New Cuffe Parade
Off Eastern Freeway, Wadala,
Mumbai City, Mumbai,
Maharashtra, India, 400 037,
India.

... Appellant

Vs.

1.Deputy Controller of Patents and Designs,
The Patent Office, Intellectual Property Building,
G.S.T.Road, Guindy, Chennai - 600 032, India. ... Respondent 1

2.M/s.Haryana Pesticide Manufactures Association (HPMA)
1307, 13th floor, Vikram Towers, Rajendra Place,
New Delhi - 110 008, India. ... Respondent 2

3.Mr.Chimanbhai Chauhan ... Respondent 3

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Prayer : Appeal filed under Section 117(A)(2) of Patent's Act, 1970 to set aside the order of the first respondent dated 05th March, 2024.

For Appellant	: Mr.Adarsh Ramanujan representing M/s.Khurana & Khurana Mr.Tarun Khurana Mr.Tapan Shah Mr.P.Subburaj
For R1	: Mr.A.R.Sakthivel SPCGSC
For R2	: Mr.Shravan Kumar Bansal Mr.Somnath De
For R3	: Mr.Bhavik Patel assisted by Dr.Heena Patel

J U D G M E N T

The appellant filed Application No. 4135/CHEN/2014 titled *"Stable Herbicidal Composition comprising Pendimethalin and Metribuzin"* at the Indian Patent Office (IPO) , Chennai, on 25th August 2014. A request for examination was filed on 27th September 2017. Pursuant thereto, the First Examination Report (FER) was issued by the IPO on 22nd July 2019. In the

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FER, the first respondent raised objections, *inter alia*, on the grounds that claims 1 to 6, as originally filed, lacked novelty and inventive step in view of three cited documents, namely:

- D1: AU760278B2 ;
- D2: AU2012203353B2 ; and
- D3: O.B HILDEBRAND: Proceedings of the Ninth Australian Weeds Conference, Adelaide, South Australia, August 6–10, 1990.

Objections were also raised on the ground of non-patentability under Section 3(d) and Section 3(e) of the Patents Act, 1970 ("the Patents Act"). The appellant replied to the FER on 21st January 2020 along with a copy of the amended claims and specifications.

2. Meanwhile, an opposition was filed by the second respondent on 10th September 2019, challenging the claims under Sections 25(1)(b) to 25(1)(f) of the Patents Act. The pleadings and evidence in relation to the opposition by the second respondent were completed by 27th August 2021. Thereafter, after a hearing notice was issued, the hearing was concluded on 24th November 2021 and orders were reserved by directing the parties to file

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written submissions. One day prior to the filing of the written submissions by the second respondent, the third respondent filed an opposition challenging the claims under Section 25(1)(b) to 25(1)(g) of the Patents Act. The pleadings and evidence in relation to the second opposition were completed by 13th February 2023. The hearing in relation to the second opposition was concluded on 17th July 2023 and the appellant filed written submissions along with an amended set of claims. At that juncture, the appellant filed an affidavit of Mr.Vairamani Ramanathan, along with the miscellaneous petition with the request to change the legal status of cited document R3 (2243/MUM/2014) from "in force" to "deemed to be revoked". The impugned order herein was issued in the above facts and circumstances on 5th March 2023.

Counsel and their contentions:

3.1. Oral arguments on behalf of the appellant were advanced by Mr. Adarsh Ramanujan, learned counsel, assisted by Mr.Tarun Khurana, learned counsel.

3.2. Oral arguments on behalf of the first respondent were advanced by

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Mr.A.R.Sakthivel, learned Special Panel Counsel.

3.3. Oral arguments on behalf of the second respondent were advanced by Mr.Shravan Kumar Bansal, learned counsel, assisted by Mr.Somnath De, learned counsel.

3.4. Oral arguments on behalf of the third respondent were advanced by Mr.Bhavik Patel, learned counsel, assisted by Dr.Heena Patel, learned counsel.

3.5 All the parties also submitted written submissions. The appellant filed the pleadings and documents in seven volumes, Volume I-VII.

4. Mr.Adarsh Ramanujan advanced several contentions in support of his request to set aside the impugned order. His contentions may be summarised as under:

4.1. The rejection of the claimed invention by reference to IN 2243/MUM/2014 is untenable because the said application does not qualify as prior art. The provisional specification of the said application was filed on 9th July 2014. The provisional specification does not disclose an emulsifiable concentrate (EC) formulation. On the contrary, it discloses a suspo-emulsion

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(SE) formulation and contains an assertion that a SE formulation is superior to an EC formulation. In spite of this objection being raised in the reply statement to the pre-grant opposition (at pages 1026–1028 and pages 1036–1038 of Volume VI) and in the written submissions to the pre-grant opposition hearing of the third respondent (at pages 1184–1191 of Volume VII), no finding was recorded in respect of this objection in the impugned order.

4.2. The appellant had filed a post-grant opposition to the patent granted in IN 2243/MUM/2014. The patentee did not file a reply statement under Rule 58 to such post-grant opposition within the specified time limit. Therefore, the appellant had raised the objection that the patent is deemed to have been revoked under Rule 58(2) of the Patents Rules, 2003. No finding was recorded on this objection also.

4.3. The formulation of IN 2243/MUM/2014 is materially different from the formulation of the claimed invention not only because different classes of excipients are used, but also because IN 2243/MUM/2014 requires

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the use of excipients that remain as insoluble solid particles. By contrast, the EC formulation does not include any insoluble solid particles and, therefore, does not require suspending or dispersing agents. In spite of providing two affidavits from Mr.G.N.Kendapa and Mr.Vairamani Ramanathan to clarify aspects of the claimed invention, including to highlight that EC formulations cannot contain insoluble particles like silica or China clay, these aspects were not addressed in the impugned order.

4.4. The first respondent failed to appreciate that neither prior art D1 nor D2, teaches, motivates or suggests the concentration of pendimethalin and metribuzin in the composition or deals with an EC formulation.

4.5. The first respondent failed to appreciate that the experimental data provided in Table 1 of the as-filed specification demonstrates synergy between the active ingredients. By way of illustration, entry - 1 in Table 1 may be compared with entries 5–7 thereof. Therefore, the conclusion that the claimed invention is non-patentable under Section 3(e) is untenable.

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4.6. The as-filed specification sufficiently describes the claimed composition, the method by which it is to be prepared and its use, including by providing multiple working examples and the best method of working the invention.

5. Mr.A.R.Sakthivel raised several contentions on behalf of the first respondent in support of his request to affirm the impugned order. His contentions may be summarised as under:

5.1. IN 2243/MUM/2014 (D3) was first filed on 9th July 2014, thereby pre-dating the instant application filed on 25th August 2014. The said document discloses the use of pendimethalin (20–50%) and metribuzin (1–10%). The specified ranges completely overlap the ranges claimed in the present application [pendimethalin (25–52%) ; metribuzin (6–12%)]. The marginal difference of 2% in the upper limits is statistically and practically negligible and does not represent technical advancement. There is no specific enabling disclosure in the complete specification to demonstrate how the claimed excipients (solvents, co-solvents and surfactants) provide a distinct

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and improved formulation as compared to D3.

5.2. D1 (AU Conference Proceedings, 1990) and D2 (ACTA Horticulturae) disclose that combinations of pendimethalin and metribuzin have proven herbicidal efficacy on various crops.

5.3. The comparative data provided by the appellant fails to align the concentrations of the premixed formulation of the claimed invention and the tank-mix. For example, Table 1 and Table 2 of the complete specification of the claimed invention compares 40% + 9% EC composition with 30% + 7% tank-mix, which is unscientific.

5.4. The claimed composition is a mere recombination of known herbicides in a known form and no data was submitted demonstrating enhanced therapeutic or technical efficacy across the claimed range.

5.5. The appellant failed to demonstrate any synergistic effect beyond

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the additive properties of pendimethalin and metribuzin.

5.6. The complete specification does not provide reproducible examples across the full scope of the claimed composition ranges or any explanation of the role played by the excipients in achieving enhanced homogeneity or stability.

6. The oral arguments of Mr.Shravan Kumar Bansal, on behalf of the second respondent, may be summarised as under:

6.1. The claimed invention is anticipated by prior claiming in view of IN 2243/MUM/2014. The said prior art document relates to liquid compositions of pendimethalin and metribuzin and encompasses compositions in any of the forms selected from SC, EC, Zeon Concentrate (ZC), and oil dispersion (OD).

6.2. The inactive ingredients disclosed in Example 3 of IN 2243/MUM/2014 are the same as those disclosed in claim 2 (as solvent) and

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claim 5 (as surfactant) of the claimed invention.

6.3. The claimed invention is also anticipated by prior claiming in India and Europe through prior art documents D1 and D2. D1 discloses the herbicidal efficacy of metribuzin, linuron and prometrym combined with bentazone, fluazifop-P-buthyil and pendimethalin on potato yield. The highest efficacy is attained by the combination of metribuzin + pendimethalin. D2 discloses that the combination of pendimethalin and metribuzin incorporated by sowing was more effective for bromegrass control than either of the components used alone in 10 of 15 cases.

6.4. Even if the minor differences between D1, D2 and IN 2243/MUM/2014, on the one hand and the claimed invention, on the other, were taken into account, the same would be obvious to a person skilled in the art in view of the said prior arts.

6.5. D4 discloses herbicidal compositions comprising flufenacet, pendimethalin and metribuzin. D5 discloses a composition comprising a

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microencapsulated pesticide selected from a group of compounds like pendimethalin. D6 discloses an aqueous solution of pendimethalin alone and four mixtures, including pendimethalin and metribuzin.

6.6. The claimed invention does not establish synergistic or surprising effect from the ingredients of the composition and, therefore, is not patentable under Section 3(e) of the Patents Act.

7. The arguments of Mr.Bhavik Patel, on behalf of the third respondent, may be summarised as follows:

7.1. The claimed invention is anticipated by prior claiming by IN 2243/MUM/2014. The appellant admits, at page 25 of the appeal, that the provisional specification of IN 2243/MUM/2014 refers to the EC formulation.

7.2. When the claimed invention is compared with IN 2243/MUM/2014, apart from the use of pendimethalin and metribuzin in

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ranges that overlap, IN 2243/MUM/2014 also contains a non-ionic surfactant, namely, octylphenol ethoxylate (in an amount of 5–15% w/w) and ethoxylated polyarylphenol (in an amount of 0.05–5% w/w). The said prior art also contains calcium dodecylbenzene sulphonate, as is evident from claim 10 thereof. This is an ionic surfactant and tallies with the preferred ionic surfactant under claim 5 of the claimed invention.

7.3. The appellant is attempting to obtain a broad scope of protection by using generic terms such as solvent, co-solvent, non-ionic surfactant and ionic surfactant. By contrast, IN 2243/MUM/2014 has disclosed specific non-ionic surfactants, such as octylphenol ethoxylate, and a specific anionic surfactant, such as calcium dodecylbenzene sulphonate. It also discloses solvents such as water, ethylene and glycol.

7.4. The claimed invention would be obvious to a person skilled in the art on the basis of US 201102817331, CA 1049805A, US 6340655 B1 and IN 696/BEL/2011.

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7.5. The EC pre-mix composition of the claimed invention does not show synergistic effect or technical advancement as compared to the tank-mix combination of pendimethalin and metribuzin. This is evident from Table 2. It is also evident on comparing Table 2 with prior art document D1 (AU Conference Proceedings, 1990).

8. Each party also relied on several judgments. These judgments are not being referred to or discussed on account of the course of action adopted in this judgment.

Discussion, analysis and conclusions:

9. The rejected claims of the claimed invention are set out below:

"*1. A Stable Herbicidal emulsifiable concentrate (EC) pre-mix composition comprising:*

i. Pendimethalin Technical in the range from 25 to 52 w/w%;

ii. Metribuzin Technical in the range from 6 to 12 w/w%;

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iii. Solvent in the range from 24 to 55w/w%;

iv. Co-solvent in the range of 4 to 6w/w%;

v. Non-ionic surfactant in the range of 3 to 5w/w% and

vi. Ionic surfactant in the range of 3 to 5w/w%.

2. An emulsifiable concentrate (EC) composition as claimed in claim 1 wherein the solvent is selected from the group consisting of Aromatic hydrocarbons, aliphatic hydrocarbons, diethylene glycol dialkyl ether, esters of plant oils-or mixture thereof. Preferred solvent is C-IX solvent.

3. An emulsifiable concentrate (EC) composition as claimed in claim 1 wherein the Co-solvent is selected from the group consisting of N-alkyl Pyrolidones, preferably N-methyl pyrolidone.

4. An emulsifiable concentrate (EC) composition as claimed in claim 1 wherein the Non-ionic surfactant is selected from the group consisting of Alkoxylated alcohols, ethoxylated alcohols, ethopropoxylated alcohols, alkylphenolethoxylates, alkoxylated tristyrylphenols, alkoxylated tributylphenols, alkylaminethoxylates, ethoxylated propoxylated polyaryl phenol, poly adducts of ethylene oxide and propylene oxide, ethoxylated fatty acids, sorbitan esters and their ethoxylates, sorbitol esters, propylene glycol esters of fatty acids and polyglycerol esters. Preferred Non-ionic surfactant is Ethoxylated propoxylated polyaryl phenol.

5. An emulsifiable concentrate (EC) composition as

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claimed in claim 1 wherein the Ionic surfactant is selected from the group consisting of calcium salt of alkylaryl sulfonates, ethoxylated and/or propoxylated di- or tri-styrylphenol phosphate, ethoxylated and/or propoxylated di- or tri-styrylphenol sulfate, phenyl sulfonate, alkynaphtalenesulphonate, ethoxylated and/or propoxylated alcohol phosphate ester, ethoxylated and/or propoxylated alkylaryl phosphate ester, taurate, suphosuccinate, or polycarboxylate. Preferred ionic surfactant is Calcium dodecylbenzene sulfonate.

6. A process for preparation of Pendimethalin and Metribuzin emulsifiable concentrate (EC) as claimed in any one of the preceding claim comprising the steps of:

i. Weighing the Solvent and adding N-alkyl Pyrolidone under stirring to obtain a reaction mixture;

ii. Adding Non-ionic surfactant and ionic surfactant under stirring to the mixture of step (i) to obtain a reaction mixture;

iii. Adding Metribuzin technical and Pendimethalin technical to the reaction mixture obtained in step (ii) and stirring to dissolve the active ingredients."

10. As is noticeable from the narration of the contentions of the respondents, the principal ground on which the claimed invention was rejected by the impugned order was that it is both anticipated and obvious in

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view of IN 2243/MUM/2014. This document is referred to as D3 in the impugned order and in the written arguments of the first respondent. In the written arguments of the appellant, it is referred to either as D3 or R3. In the written arguments of the second respondent, it is referred to as D7 and in the written arguments of the third respondent, it is referred to as D1. In order to avoid confusion, the said document is either referred to as IN 2243/MUM/2014 or as D3 in the remainder of this judgment.

11. In response to the contention that the claimed invention is anticipated or obvious in view of D3, the appellant raised two preliminary objections. The first objection is the weightier objection. This objection was raised on the ground that the date of filing of the provisional specification of D3 should not be taken into consideration to decide whether it qualifies as prior art as regards the claim for an EC formulation. Learned counsel relied on Section 11(2) of the Patents Act as the statutory foundation of this contention by submitting that the EC formulation of D3 is not fairly based on disclosures made in the provisional specification thereof. If the date of filing of the provisional application of D3 were to be disregarded, it was submitted

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that D3 would not qualify as prior art, as regards the EC formulation, because the complete specification of D3 was filed on 30th December 2014, whereas the provisional application of the claimed invention was filed earlier on 25th August 2014 (i.e. the priority date). Learned counsel for the appellant contended that this objection was raised categorically in the reply statement to the pre-grant opposition (at pages 1026–1028 and pages 1036–1038 of Volume VI) and in the written submissions to the pre-grant opposition of the third respondent (at pages 1184–1191 of Volume VII). This contention warrants close examination.

12. As a first step, it is apposite to set out Section 11(1), (2) and (6) of the Patents Act. The said provisions are as under:

> *"11.**Priority dates of claims of a complete specification**.-*
> *(1) There shall be a priority date for each claim of a complete specification.*
> *(2) Where a complete specification is filed in pursuance of a single application accompanied by-*
> *(a) a provisional specification; or*
> *(b) a specification which is treated by virtue of a direction under sub-section (3) of section 9 as a provisional specification,*

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and the claim is fairly based on the matter disclosed in the specification referred to in clause (a) or clause (b), the priority date of that claim shall be the date of the filing of the relevant specification.

(6) In any case to which sub-sections (2), (3), (3A), (4) and (5) do not apply, the priority date of a claim shall, subject to the provisions of Section 137, be the date of filing of the Complete Specification."

13. The next step is to examine whether the appellant raised this objection in the pre-grant opposition. On perusal of the statement and evidence of the appellant to the pre-grant opposition of the third respondent, the contention that the priority date of D3 cannot be reckoned from the date of filing of the provisional specification has been raised at internal pages 9-11 thereof (pages 1026-1028 of Volume VI). In the written submissions of the appellant in relation to the pre-grant opposition of the third respondent, at internal page 23 thereof (page 1186 of Volume VII), it is stated as follows:

"*Document D1 (IN2243/MUM/2014) cannot validly claim the priority date of the provisional specification (July 09, 2014). The provisional specification of the cited document only discloses a Suspo-emulsion (SE) formulation of Pendimethalin and*

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Metribuzin, wherein one of the active ingredients remains suspended (remains as an insoluble/dispersed particle) in the formulation."

14. I turn next to the impugned order to verify whether this contention was noticed and, if so, whether a finding was recorded in relation thereto. At paragraph 10 of the impugned order, while discussing the appellant's response to prior arts D1 to D3, in relevant part, it is recorded as under:

> "*D3 published on 15/01/2016 (Publication under section 11A is annexed herewith as Annexure A) which is after the date of filing of the instant application (i.e. 25/08/2014) and therefore D3 is not a valid prior art under the ground of 25(1)(e)*."

Thus, the contention of the appellant was noticed in the impugned order. The impugned order contains findings from paragraphs 17 to 20 thereof and the conclusion at paragraph 21 thereof. Conspicuous by its absence is any finding with regard to the objection that D3 cannot be construed as prior art for the

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reasons discussed above.

15. The provisional specification of D3 warrants examination so as to decide whether there is at least *prima facie* merit in the contention of the appellant. The provisional specification of D3 sets out the background of the invention. Thereafter, the summary of the invention is as follows:

> *"Present invention relates to a novel composition in suspo-emulsion (SE) form comprising a) pendimethalin b) metribuzin c) dispersant d) anti freezing agent c)anti foaming agent f) suspending agent g) anti microbial agent h) thickener and i) buffering agent.*
>
> *Present invention also relates to process for preparing the suspo-emulsion composition comprising pendimethalin and metribuzin."*

16. The detailed description of the invention provides, in relevant parts, as under:

> *"A suspo-emulsion (SE) formulation is essentially a*

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mixture of a suspension concentrate with an oil-in-water emulsion."

....

"Advantage of suspo-emulsion in comparison of wettable powder (WP) & emulsifiable concentrate (EC) formulation is outline below;

- *The particle size (less than 5 micron) of Suspo-emulsion formulation is smaller than particle size (30 - 50 micron) of WP formulation.*
- *SE formulation is eco-friendly formulation as it is water based where as WP formulation is dusty.*
- *SE formulation has contains no organic solvent where as EC formulation has contains organic solvent.*
- *As non-ionic surfactants are used in SE formulation, so it gives better bio-efficacy than EC & WP formulation."*

17. As is evident from the above extracts, even the detailed description deals only with a SE formulation, and the only references to EC formulation appear to be confined to the references extracted above. Against this

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backdrop, recognising the statutory prescription in Section 11(2) that priority may be reckoned from the date of filing of the provisional specification provided the claim is fairly based on a matter disclosed in the provisional specification, it is pertinent to examine the granted claims of D3 to test whether there is an arguable case to say that the priority of the claim in D3 regarding the EC formulation should be reckoned from the date of filing of the complete, and not provisional, specification. For this purpose, I set out below independent claim 1 and dependent claim 17 (which deals with an EC formulation) of D3:

> *"1. A liquid composition of bioactive amounts of Pendimethalin and Metribuzin along with inactive excipients wherein, the ratio of Pendimethalin to Metribuzin is in the ratio from 1:1 to 25:1.*
>
> *17. A liquid composition of Pendimethalin and Metribuzin as claimed in claims 1 to 5 wherein the formulation may be in the form of suspo emulsion (SE), emulsifiable concentrate (EC), zeon concentrate (ZC) and Oil Dispersion (OD)."*

18. On examining dependent claim 17 of D3 in the light of the provisional specification thereof, I find that the objection raised by the

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appellant cannot be rejected outright as untenable and warranted careful consideration and a finding. After noticing the contention in the impugned order, as recorded earlier, there is neither discussion nor finding on this issue in the impugned order. Especially in view of the emphasis placed on D3 both in the impugned order and in the oral and written arguments of all the respondents, the failure to record such finding vitiates the impugned order.

19. Under these circumstances, one option would have been for me to record a finding on this issue and, thereafter, dispose of the appeal on merits. Not only because it is more appropriate for the forum of first instance to record a finding on a significant issue, but also in view of the manner in which other issues were dealt with in the impugned order, I am not resorting to that course of action.

20. Both in the opposition proceedings before the first respondent and in the course of submissions in these proceedings, the second respondent has referred to seven prior art documents, including D3. The third respondent has

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referred to nine prior art documents, including US 201102817331, CA 1049805A, US 6340655B1 and IN 696/BEL/2011, which were labelled as D2, D4, D6, and D9, respectively, by the third respondent. The third respondent has also mapped these prior arts against the claimed invention. The discussion in the impugned order regarding these prior arts calls for consideration next.

21. Paragraphs 17 and 18 of the impugned order, which discuss the prior arts, are set out below:

> *"17. I agree with the opposition and concluded that the range of the active ingredients Pendimethalin 25-52% and Metribuzin 6-12% is already disclosed in the prior filed application 2243/MUM/2014 as Pendimethalin 20-50% and Metribuzin 1-10%. The entire range of both the active substances claimed in the composition of the present invention is fall within the disclosed range of 2243/MUM/2014 where the difference in the upper range of Pendimethalin and also Metribuzin is only 2% but such a range cannot be a workable range and the upper range 2% is negligible as there is no significant activity for that range provided in the specification. There is no specific disclosure or enabling disclosure provided in the specification*

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pertaining to the effect of excipients in the composition for the enhanced activity. Thus the workable range and the range claimed in the present application is not novel under the provision of section 25(1)c of the Act as the identical range is claimed in the prior filed application 2243/MUM/2014.

18. The Pendimethalin and Metribuzin combination is known in the art. Different proportion of said active substances where workable and improved results producing proportion is also known in the art. The object of the present applicant as stated in the application is to provide a homogeneous, stable, premixed with an enhanced herbicidal effectiveness on wheat, barley, soyabeen and potatoes which results in good yield. D1 disclosed combinations of pendimethalin and metribuzin incorporated by sowing (IBS) were more effective for bromegrass control than either of the components used alone in 10 of 15 cases. Pendimethalin .594 Kg/ha + metribuzin 100 Kg/ha and pendimethalin .660 Kg/ha + metribuzin .200 Kg/ha resulted in the greatest reduction in bromegrass numbers. D1 discloses the workable proportion 49.5:15, 59.4:10 and 33:10. D2 disclosed that the highest efficacy were attained by the combination of metribuzin + pendimethalin (88.1). The applicant failed to provide comparative experiment with data for the effect of excipients in the pre-mix composition comprising pendimethalin and metribuzin of the present invention with

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the same concentration of avtive ingredientstank mix or same concentration without any excipient in Table 1 and Table 2. Table 1 and 2 provided for the effect of the herbicides Pendimethalin 40% and Metribuzin 9% on the growth of the wheat crop and on weed count at different intervals after application with same concentration could not provided any to understand the surprising effect of the premix composition and data provided in the table. Comparing pre-mix composition (pendimethalin 40% and metribuzin 9%) of the present invention with different tank mix composition (pendimethalin 30% and metribuzin 70%) is unscientific and it is not clear how the 40% and 30% pendimethalin in combination with 9% and 70% metribuzin respectively expected to produce similar activity, such a comparison cannot be considered as improved effect. There is no support in the specification for the homogeneous, stable and an enhanced herbicidal activity. In the absence of any support in the specification the claimed result achieved is considered as a mere statement without any improvement in the work. It appears that the applicant submitted with certain formulation with permutation and combination, where such a combinations proved as a suitable combination for achieving more efficacious effect as per the prior art. For claiming any specific pre-mix combination, there must be a comparative study with the tank mix combination having same concentration of active ingredient. Different

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concentration of active ingredients in pre-mix and tank mix produce different results, such a comparison cannot be acceptable and considered as unscientific. Pendimethalin and metribuzin is a preferred combination in the prior art D1 and D2. Excipients used in the premix composition are also known for using premix combination. Person skilled in the art motivated with the teaching and suggestion in the prior art for preparing different workable range of pendimethalin and metribuzin combination with expcipients which are routinely used for preparing premix composition. Preparing certain composition which is already suggested in the prior art D1 and D2 along with routinely used excipients for preparing premix composition is obvious to the person skilled in the art unless such a combination exhibits improved effect. Thus claims of the impugned application do not involve inventive step and there is no technical advancement u/s 25(1)(e) of the Act."

22. The conclusion that follows from the above paragraphs is that, apart from a discussion on prior art document D3 in paragraph 17, the impugned order takes note of prior documents D1 and D2 in paragraph 18. No other prior art documents have been discussed in the impugned order. As regards D1 and D2, the appellant contended that these prior arts do not

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disclose an EC formulation. On examining D1 and D2, there is *prima facie* merit in this contention. In these circumstances, for the primary reason that the impugned order does not record any finding on whether D3 qualifies as prior art as also on account of non-consideration of several prior art documents relied upon by the second and third respondents, the matter warrants reconsideration. An ancillary reason would be the failure to discuss and record any findings in relation to the affidavits of Mr.G.N.Kendapa and Mr.Vairamani Ramanathan, including as to whether these documents are liable to be considered or disregarded. Because of these conclusions, it is unnecessary to deal with the second objection regarding D3, namely, that the grant stands revoked under Rule 58 of the Patents Rules for non-filing of a reply to the post-grant opposition within the prescribed time. All contentions are kept open to all parties in this regard.

23. For the reasons set out above, the impugned order dated 5th March 2024 is set aside and the matter is remanded for reconsideration on the following terms:

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23.1. In order to preclude the possibility of predetermination, an officer other than the officer who issued the impugned order shall undertake reconsideration.

23.2. After providing a reasonable opportunity to the appellant and the opponents, a speaking order shall be issued within four months from the date of receipt of a copy of this order.

23.3. The first respondent shall decide the matter on remand uninfluenced by any observations herein, including the *prima facie* observations in relation to the provisional specification of IN 2243/MUM/2014 (D3).

20.11.2025

Index : Yes/No
Internet : Yes/No
Neutral Citation : Yes/No
PKN

To

1.Deputy Controller of Patents and Designs,
Intellectual Property Office,
Intellectual Property Office Building,
G.S.T.Road, Guindy,

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Chennai - 600 032.

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SENTHILKUMAR RAMAMOORTHY J.

PKN

Pre-delivery judgment made in
C.M.A.(PT) No.21 of 2024

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