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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **04.02.2025**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT)/9/2023

Jupeng Bio (HK) Limited
Represented by its constituted Power of Attorney Mr.R.R.Nair,
1/F Hing Lung Commercial Building, 68-74 Bonham Strand,
Sheung, Wan, Hong Kong; Nationality; Hong Kong

... Appellant

-vs-

The Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai – 600 032.

... Respondent

PRAYER: Civil Miscellaneous Appeal (Patents) is filed under Section 117-A of the Patents Act, 1970, pleased to call for the records of the respondent culminating in the Impugned Order dated 06 February 2023 rejecting the grant of patent and set aside the same and consequently direct grant of the

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patent in respect of the Appellant's Application No.20167000108.

For Appellant : Mr.S.Shivathanu Mohan
for M/s.S.Ramasubramaniam and Associates

For Respondent : Mr.K.Subbu Ranga Bharathi, CGSC

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JUDGMENT

The appellant challenges an order dated 06.02.2023 rejecting Patent Application No.201647000108 for grant of patent for a claimed invention titled 'Control of Conductivity in Anaerobic Fermentation'.

2. Upon a request for examination dated 09.05.2017, the respondent issued First Examination Report (FER) dated 28.11.2019. In the FER, objections were raised on the grounds of: novelty by citing prior art documents D1 to D6; non patentability under Section 3(d) of the Patents Act, 1970 (the Patents Act); and on other grounds such as lack of clarity and conciseness. The appellant replied to the objections in the FER on

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08.05.2020 and also filed amended claims. Pursuant to hearing notice dated 17.07.2020, the appellant filed written submissions on 28.09.2020 along with claims that were amended further. Upon consideration thereof, the order impugned herein was issued on 06.02.2023.

3. Learned counsel for the appellant invited my attention to the current claims of the appellant. With reference to independent claim 1, he pointed out that the said independent claim contains two essential elements in respect of which the monopoly claim has been made. The first of these elements is that the fermentation medium has a conductivity of less than 30 mS/cm. The second element is that the conductivity to specific carbon up take (SCU) relationship is maintained according to a formula SCU = SCU max-F*conductivity. By referring to dependent claim 2, he contends that the third element is that the process described in claim 1 is effective for maintaining a yield of at least 10 gram ethanol / (L-day).

4. According to learned counsel, the respondent relied on example 1B of prior art D7 to erroneously conclude that the said example discloses both

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the claimed conductivity and the relationship between SCU and conductivity. With specific reference to the tables set out in the operative portion of the order, learned counsel submits that conductivity is not a parameter explicitly referred to therein. In those circumstances, he submits that the respondent should have explained the basis for the conclusion that conductivity is inherently disclosed in example 1B of D7.

5. He further submits that the conclusion in the impugned order that amended claims 1 to 6 are not patentable under Section 3(d) of the Patents Act is completely unreasoned, and consequently unsustainable. As regards the conclusion on the yield disclosed in prior art D7, learned counsel submits that the claimed invention is in respect of a process which generates a yield of at least 10 gram ethanol / L-day) on the very first day. He points out that this contention is contained in the written submissions filed by the respondent.

6. In response to these contentions, Mr.K.Subbu Ranga Bharathi, learned CGSC, submits that the claimed invention was rejected on the

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ground of lack of novelty in view of prior art document D7. In any event, he contends that the Space Type Yield (STY) disclosed in example 1B of D7 is 26.14 grams per litre on the second day and that this is significantly higher than the yield of at least 10 gram ethanol / (L-day), which is claimed in dependent claim 2.

7. The operative portion of the order with regard to the conclusions on novelty is set out below:

"Table 1: Day 1

Strain	*DSM19630*	*DSM23693*
CO consumption mM/L	*113mM*	*3700mM*
Ethanol Production g/L	*0.48g/L*	*7.98g/L*
Acetate Production g/L	*4.58g/L*	*4.06g/L*
Biomass g/L	*0.29g/L*	*1.83g/L*
Specific uptake	*0.28 CO/min/g biomass*	*1.17 CO/min/ biomass*
Specific ethanol production	*2.5 g/L/g biomass/day*	*4.3g/L/g biomass/day*

Table 2: Day 2

Strain	*DSM19630*	*DSM23693*
CO consumption mM/L	*350mM*	*8150mM*
Ethanol Production g/L	*1.84g/L*	*26.14g/L*
Acetate Production g/L	*4.Sg/L*	*3.47g/L*

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Strain	*DSM19630*	*DSM23693*
Biomass g/L	*0.41g/L*	*5.42g/L*
Specific uptake	*0.54 CO/min/g biomass*	*1.03 CO/min/ biomass*
Specific ethanol production	*3.0 g/L/g biomass/day*	*6.5g/L/g biomass/day*

> *Example 1B of D7 results in a conductivity clearly below 30 mS/cm. Even according to the patent in suit (paragraph [0039]), "controlling" encompasses the use of suitable media which provide a low conductivity. Thereby the parameters conductivity and coefficients of the linear relationship between SCU and conductivity – at least in the context of fermentation – are inherently disclosed in Example 1B of D7. In view of this, example 1B of D2 anticipates the subject matter of claims of the instant application."*

8. On examining the parameters set out in the above table, it appears *prima facie* that the conductivity of the fermentation medium is not one of the specified parameters. Indeed, the conclusion that conductivity is inherently disclosed in example 1B of D7 is itself indicative of the fact that such parameter is not explicitly provided in the tables set out above. In that factual context, the respondent should have set out reasons for the conclusion that the conductivity of the fermentation medium is inherently

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disclosed in example 1B of D7.

9. Turning to the conclusion on non patentability under Section 3(d), the operative portion of the order is as under:

> *"Further the amended claims 1-06 are not patentable u/s.3(d) of the Patents Act, 1970 as the claimed subject matter is well known from the prior published document cited herein."*

Apart from stating that the claimed subject matter is well known from the prior published document cited herein, no reasons are set out as to how the claimed invention falls within the scope of Section 3(d) of the Patents Act. In this regard, it should be noticed that Section 3(d) contains multiple limbs and it is unclear from the conclusion in the impugned order as to which limb of Section 3(d) is attracted.

10. As regards the conclusion on lack of inventive step, it is recorded

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in the impugned order that the parameters of conductivity and the coefficients of the linear relationship between SCU conductivity are inherently disclosed in example 1B of D7. A further conclusion is recorded that example 1B of D7 discloses ethanol STY of 26.14 g / L on the second day. This conclusion cannot be brushed aside. Nonetheless, it appears that the respondent has failed to consider and record findings on the contention of the appellant that the claimed invention results in ethanol STY of at least 10 grams ethanol / (L-day) on the first day.

11. For all the reasons set out above, the appellant's patent application warrants re-consideration. Consequently, this appeal is disposed of on the following terms:

(i) Impugned order dated 06.02.2023 is set aside and the matter is remanded for re-consideration.

(ii) In order to preclude the possibility of pre determination, an officer other than the officer who issued the impugned order shall undertake such re-consideration.

(iii) After providing a reasonable opportunity to the appellant, a fresh

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order shall be issued within ***four months*** from the date of receipt of a copy of this order.

(iv) For the avoidance of doubt, it is made clear that no opinion is expressed herein on the merits of the patent application.

(v) There shall be no order as to costs.

04.02.2025

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

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