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

% *Date of Decision : 28.07.2025*

\+ **C.A.(COMM.IPD-PAT) 80/2024, I.A. 40827/2024, I.A. 40829/2024 & I.A. 1445/2025**

BAYER CROPSCIENCE AKTIENGESELLSCHAFT .....Appellant

Through: Mr. L. Badri Narayanan, Ms. Vindhya S. Mani & Mr. Ritwik Sharma, Advocates.

versus

THE DEPUTY CONTROLLER OF PATENTS AND DESIGNS & ANR .....Respondents

Through: Mr. Avshreya Pratap Singh Rudy, Senior Panel Counsel along with Ms. Usha Jamnal & Ms. Harshita Chaturvedi, Advocates for Respondent No.1.

Mr. Hari Subramaniam, Ms. Aditi Subramaniam & Mr. Sanuj Das, Advocates for Respondent No.2.

CORAM:
HON'BLE MR. JUSTICE TEJAS KARIA

TEJAS KARIA, J. (*ORAL*)

INTRODUCTION

1. The present Appeal has been filed under Section 117A of the Patents Act 1970 ("**Act**") challenging the Order ("**Impugned Order**") dated 27.03.2024 passed by Respondent No. 1, the Deputy Controller of Patents

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and Designs ("**Controller**"), revoking the Patent Number IN 369450 ("**Impugned Patent**"), which was earlier granted in favour of the Appellant. It is contended that the Impugned Order passed by Respondent No. 1 is arbitrary, bad in law and violates the principles of natural justice. The Impugned Order adjudicates a Post Grant Opposition ("**PGO**") filed by Respondent No. 2 on 17.06.2022 under Section 25 (2) of the Act.

FACTUAL MATRIX

2. The Impugned Patent is titled "*METHOD FOR THE PREPARATION OF SUBSTITUTED 2-ARYL-ETHANOLS*" and claims a process for the preparation of 2-(4-chloro-2,6-dimethylphenyl) ethanol (compound of the formula (I)) by reacting the corresponding Grignard compound with ethylene oxide in the presence of a copper compound. Copper (I) Iodide, copper (I) bromide, copper (II) bromide or copper (I) chloride is used in the copper compound.

3. A brief of the important Timeline of the Application of the Impugned Patent is as follows:

09.01.2017	Patent Cooperation Treaty ("**PCT**") International filing of Patent No. 369450 bearing PCT International Application No. PCT/EP2017/050325, having priority date of 15.01.2016.
08.06.2018	National filing of Patent No. 369450 as Indian Patent Application No. 201817021524.
23.06.2020	First Examination Report issued by Respondent No. 1.
18.11.2020	Appellant filed Response to FER along with amended

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	claims 1-5.
17.06.2021	Indian Patent Office issued Patent Certificate regarding the grant of Patent to Impugned Patent bearing Patent No. 369450.
18.06.2021	Publication of Patent bearing No. 369450 under Section 43(2) of the Act.
17.06.2022	Post Grant Opposition filed by Respondent No. 2 under Section 25(2) of the Act.
17.08.2022	Reply Statement and Evidence filed by the Appellant.
11.03.2024	Hearing conducted by Respondent No. 1 and was attended by Appellant and Respondent No. 2.
26.03.2024	Written Submission filed by Appellant and Respondent No. 2.
27.03.2024	Impugned Order revoking the Impugned Patent passed by Respondent No. 1.
20.09.2024	Filing of present Appeal.

4. The major substantive objections raised in the First Examination Report ("**FER**") issued by the Indian Patent Office ("**Patent Office**") on 23.06.2020, are as follows:

a) Non-patentable under Section 3(d) of the Act.

b) Claims 1 to 10 are not clearly worded and do not sufficiently define the invention.

5. Thereafter, on 18.11.2020, the Appellant filed a Response to the FER along with amended claims 1-5 before the Patent Office. On 17.06.2021, the

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Impugned Patent was granted over the said Application by the Patent Office, and the grant of the Patent was published in the official journal of the Patent Office dated 18.06.2021.

6. Thereafter, a PGO was filed by Syngenta Crop Protection AG, Respondent No. 2, on 17.06.2022. Respondent No. 1, through the Impugned Order dated 27.03.2024, while assessing the Impugned Patent under Section 25(2) of the Act, revoked the Impugned Patent on the following grounds:

a) The Impugned Patent is obvious and does not involve any Inventive Step, under Section 25(2)(e) of the Act.

b) The subject matter claimed under the Impugned Patent is not patentable under Section 3(d) of the Act, and therefore, falls under Section 25(2)(f) of the Act.

c) The subject matter claimed under the Impugned Patent is not fully and particularly disclosed, and, therefore, falls under Section 25(2)(g) of the Act.

7. Thereafter, the Appellant filed the Reply Statement on 17.08.2022, along with amended claims 1 to 5 and a duly executed affidavit of Dr. Peter Brüchner before the Patent Office . Respondent No. 2 on dated 14.09.2022, filed a Petition under Rule 138 of the Patents Rules, 2003 ("**Rules**"), seeking an extension for a month in filing its reply evidence under Rule 59 of the Rules. Respondent No. 2, on 14.10.2022, also filed reply evidence by way of the affidavit of Dr. Prabir Chandra Chakraborti. In response to the same, on 15.12.2022 and 05.04.2022, the Appellant filed further evidence under Rule 60 of the Rules.

8. Pursuant to receiving the joint recommendation report dated

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25.09.2023 from the Opposition Board ("**OB**"), a hearing was conducted on 11.03.2024, under Rule 62 of the Rules. Pursuant to the hearing, on 26.03.2024, the Appellant and Respondent No. 2 filed their respective Written Submissions ("**WS**") and, on the very next day on 27.03.2024, the Patent Office passed the Impugned Order revoking the Impugned Patent under Section 25(4) of the Act.

9. Aggrieved by the Impugned Order, the Appellant, on 13.06.2024, by way of a Writ Petition under Article 226 of the Constitution of India, challenged the same before this Court. The said Writ Petition, bearing No. W.P. (C) IPD 21/2024 was listed for the first time before this Court on 19.07.2024, wherein the Court *vide* Order dated 19.07.2024 gave liberty to the Appellant to file an Appeal against the Impugned Order under Section 117A of the Act. Hence, this Appeal.

SUBMISSIONS ON THE BEHALF OF APPELLANT

10. The Counsel for Appellant submitted that pursuant to the hearing held on 11.03.2024, the Respondent No. 1 passed the Impugned Order on 27.03.2024, only a day after the Appellant and Respondent No.2 filed their WS, resulting in the revocation of the Impugned Patent under Section 25(4) of the Act.

11. The Counsel for Appellant also submitted that Respondent No.1 has grossly erred in issuing the Impugned Order, as the Impugned Order is in total violation of principles of natural justice. If the Impugned Order is not quashed, the Appellant would suffer irreparable harm, injury, and damage. The Impugned Order passed by Respondent No.1 is illegal and liable to be

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set aside inasmuch as the same has been passed without the application of mind and is an unreasoned and non-speaking order.

12. The learned Counsel for Appellant submitted that the Respondent No. 1 has erroneously observed that the Impugned Patent is obvious and lacks inventive step and, therefore, has erroneously concluded that the same is liable to be revoked under Section 25(2)(e) of the Act. The learned Counsel submitted that Respondent No. 1 has erroneously observed that the Impugned Patent is barred under Section 3(d) of the Act, and hence liable to be revoked under Section 25(2)(f) of the Act.

13. The learned Counsel of the Appellant submitted that none of the cited Prior Arts suggested the process claimed under the Impugned Patent. Additionally, it was also submitted that the WS of the Appellant before the Patent Office was not considered before passing the Impugned Order.

14. As per the Appellant, Respondent No.1 has merely copied and pasted multiple paragraphs from the submissions of Respondent No. 2 and the recommendations of the OB and failed to consider the Affidavits filed by the Appellant and the comparative data adduced by the Appellant. It was also submitted that Respondent No. 1 has failed to consider the submissions of the Appellant on disclosure under 25(2)(g) of the Act.

15. The Appellant has relied on the following cases to support the submissions:

a) ***Stempeutics Research Pvt. Ltd. v. The Controller of Patents*** 2020 SCC OnLine IPAB 16.

b) ***Otsuka Pharmaceuticals Co. Ltd. v. Controller of Patents*** 2022 SCC OnLine Del 4982.

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16. The Appellant has relied upon a Table comparing the Impugned Order with the Appellant's WS, WS of Respondent No. 2, PGO, Reply Statements of both parties and the recommendation of the OB to submit that none of the submissions made by the Appellant in the WS was considered by Respondent No. 1 before passing the Impugned Order.

17. In view of the above submissions, it was submitted that the Appeal deserves to be allowed.

SUBMISSIONS ON THE BEHALF OF RESPONDENTS

18. Responder No. 2 in Reply to the Appeal has relied on several Prior Arts and submitted that the common general knowledge described in these Prior Arts indeed provides a very clear teaching and motivation for the skilled person to use a copper catalyst to suppress the formation of undesired 1-arylethanols.

19. Under the argument of Lack of Inventive Step under Section 25(1)(e) of the Act, Respondent No.2 submitted that based on the individual or combined disclosure of the cited documents, it would have been obvious to a person skilled in the art to arrive at the inventive features of Impugned Patent.

20. The Learned Counsel for Respondent No. 2 submitted that under the objection of Non-Patentable Subject Matter under Section 25(1)(f) of the Act, the Impugned Patent is not patentable under Section 3(d) of the Act for the following reasons:

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a) Mere use of a known process which does not employ any new reactant or result in any new product.

b) Mere discovery of a new use of a known substance.

21. Learned Counsel for Respondent No. 2 further submitted that the inclusion of the starting compound where X equals Cl in Claim 1, in the absence of those essential features that would allow the skilled artisan to prepare the initial compound, let alone to perform the claimed reaction selectively, and in the absence of any teaching in the Impugned Patent, renders the claimed process and the teaching of the whole description, insufficiently disclosed for a skilled person to be carried out over the whole ambit of the claim. Citing Rule 62(5) of the Rules, Respondent No. 2 argued that after the hearing the Parties and after taking into consideration the recommendation of the OB, Respondent No. 1 passed the Impugned Order.

22. Learned SPC for Respondent No. 1 supported the Impugned Order and submitted that the same does not require any interference by this Court.

ANALYSIS

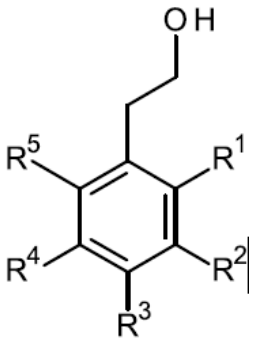
23. The Impugned Patent relates to a process for the preparation of substituted 2-aryl-ethanols. The process of preparation of compound of Formula (1) comprises the reaction of a compound of Formula (II) in the presence of a copper compound with ethylene oxide.

24. The amended Claims 1 to 5 of the Impugned Patent are reproduced hereinunder:

"***We claim***

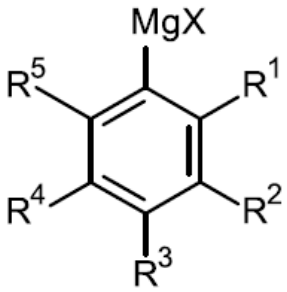
1. Process for preparing compounds of the formula (I)

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(I)

In which R^1 represents methyl, R^2 represents hydrogen, R^3 represents chlorine, R^4 represents hydrogen R^5 represents methyl, characterized in that a compound of the formula (II)



(II)

in which the radicals R^1 to R^5 have the meanings given above and X represents chlorine, bromine or iodine, is reacted in the presence of a copper compound with ethylene oxide, in that the copper compound used is copper (I) iodide, copper (I) bromide, copper (II) bromide or copper (I) chloride-dimethyl-4-trifluoromethoxyphenyl) ethanol, 2-(2-ethyl-4,6-dimethylphenyl)ethanol, 2-(2,4-diethyl-6-methylphenyl)ethanol, 2-(3-chloro-2,6-dimethylphenyl)ethanol.

2. Process for preparing compounds of the formula (I) as claimed in claim 1, wherein the copper compound is used in amounts of from 0.1 to 50 mol per cent, based on the compound of the formula (II).

3. Process for preparing compounds of the formula (I) as claimed in claim 1, wherein the copper compound is used in amounts of from 0.5 to 15 mol per cent, based on the compound of the formula (II).

4. Process for preparing compounds of the formula (I) as claimed in claim 1, wherein ethylene oxide is used in amounts between 0.9 and 3 mol equivalents, based on the compound of the

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formula (II).

5. Process for preparing compounds of the formula (I) as claimed in claim 1, wherein ethylene oxide is used in amounts between 1 and 2 mol equivalents, based on the compound of the formula (II)."

25. As per the Appellant, the Impugned Order does not refer to any submissions made by the Appellant and, therefore, liable to be set aside on the ground that it has been passed by non-application of mind. The paragraphs of the Impugned Order not dealing with the WS of the Appellant are as follows:

Impugned Order	**Reply Statement By Appellant**	**Written Submissions by Appellant**
Para 23 (d), Page 20	2nd Paragraph, Page 16	_
Para 25, Page 26	-	_
Para 7.2 Page 30, 31 and 32	Para 7.2. Page 17 and 18	_
Para 7.3 Page 34 and 35	Para 7.3, Page 18 to 20	_

26. The WS of the Appellant is not even mentioned in the Impugned Order. The Appellant in the WS filed on 26.03.2024, at paragraphs 5 to 8 has argued against the recommendation of the OB and has stated that as the references relied on by the OB are the same as those relied on by Respondent No. 2. The submissions of the Appellant in the WS are reproduced hereinunder:

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> *"8. It is submitted that the rationale of the Opposition Board with respect to analyzing the precise nature of the subject matter fails to take into account the scope of the claimed subject matter and the teachings of the references that have been relied on in their assessment. The Patentee submits that the cited prior art references fail to describe one or more elements as recited in the claimed subject matter and fail to provide any guidance as to how a person skilled in the art would be able to arrive at the claimed invention based on teachings of these relied references.* ***Considering that the references relied on by the Opposition Board are the same as those relied on by the Opponent, it is submitted that the claimed subject matter is patentable and that the present Opposition ought to be dismissed based on reasoning provided in considerable detail, in the sections that follow****."*
>
> ***[Emphasis supplied]****"*

27. Therefore, the arguments of the Appellant against the recommendations of OB are also applicable to the submissions of Respondent No. 2 as well. The Impugned Order at Page 26 states that the arguments of both Respondent No. 2 and the Appellant have been considered. However, a bare perusal of the Impugned Order shows that the arguments of the Appellants have not been considered by Respondent No. 1.

28. The Impugned Order, at page 26, reads as "*After considering the arguments of opponent and patentee it appears that there are four point of discussion namely:"* As none of the Appellant's arguments made in WS were referred / considered, the Impugned Order recording to the contrary is not tenable.

29. The Impugned Order has substantially considered the submissions of Respondent No. 2 made in its WS and PGO. The consideration of the WS of Responder No. 2 that was submitted on 26.03.2024 is at paragraph Nos. 22, 23, 24, 27, and 7.3 of the Impugned Order, however there is no reference to

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the WS submitted by the Appellant, although both the WS of the Appellant and Respondent No. 2 were submitted on the same day, that is on 26.03.2024. Despite that, the submissions made in the WS of the Appellant are not considered in the Impugned Order, which was passed on 27.03.2024, just a day after the filing of WS of Appellant and Respondent No. 2 on 26.03.2024.

30. While addressing the objection under Section 25(2)(g) of the Act, the Impugned Order merely replicated the Recommendation of the OB verbatim. Additionally, while addressing this ground raised by Respondent No. 2, the Impugned Order has not considered the submission made in the Reply Statement and the WS of the Appellant.

31. Therefore, the Impugned Order is merely a reproduction of the submissions of Respondent No. 2 and the Recommendations of OB. The Impugned Order does not provide any independent reasoning / analysis of the submissions made by the Parties and the Recommendation of OB, which clearly shows non-application of mind as is evident from the only two paragraphs containing the reasons in the Impugned Order reproduced hereinunder:

> *"Para 26, Page 37*
> *Thus in view of above discussed facts and findings all the grounds of opposition are found valid and sustained after considering the recommendations of opposition board on the facts of the case."*
>
> *"Para 27, Page 37*
> *The Opponents have succeeded in the grounds under sections 25(2)(e), 25(2)(f) and 25(2)(g) of the Patents Act, 1970. Having considered all the relevant documents and pleadings of both the parties, recommendations of the opposition Board and in view of findings above, as per Section 25(4) of the Patents Act 1970 It is*

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hereby ordered to revoke the Patent number 369450 granted on the Patent Application No. 201817021524 and Post-grant Opposition under Section 25(2) filed by opponent, SYNGENTA CROP PROTECTION AG of ROSENTALSTRASSE 67 4058 BASEL SWITZERLAND Through Mr. H. SUBRAMANIAM, [IN/PA-93] of Subramaniam & Associates, ATTORNEY FOR THE OPPONENT stands disposed of. There is no order as to the costs."

32. A bare perusal of the operative portion of the Impugned Order shows that there is no independent appreciation of the submissions made by the Appellant by Respondent No. 1 for accepting the Recommendation of the OB. In ***Quakcomm incorporated v. Controller Patents*** 2023 SCC OnLine Del 4308, this Court has held that an order passed by an authority without application of mind cannot sustain, either in law or on facts. The relevant paragraph is reproduced hereinunder:

"4. An order which does not deal with the submissions advanced before the authority passing the suffers from manifest non-application of mind and is also, that extent, ex facie unreasoned. It cannot sustain, either in law or on facts.

5. Orders such as that impugned in the present appeal reduce the exercise of the examination of the patent application, raising of objections thereto, and grant of an opportunity to the applicant to respond to the objects, to an empty paper formally."

33. In ***Willowood Chemicals Private Limited v Assistant Controller Of Patents And Designs & Anr,*** W.P.(C)-IPD 15/2023, this Court noted that while the recommendations of OB carry weight, the Controller is required to employ independent thought to decide the issue. The relevant paragraph of the decision is reproduced hereinunder:

"5. The Court has considered the afore-noted submissions advanced by counsel for parties. In Cipla Ltd. v. Union of India, 1 the

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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.*
>
> ***[Emphasis supplied]****"*

34. Respondent No. 1 has failed to employ any independent thought / reasoning and has entirely relied on the Recommendations of the OB and failed to consider the Reply Statement and the WS submitted by the Appellant. Therefore, the Impugned Order cannot be sustained.

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35. In the facts and circumstances of the present case, the Impugned Order revoking the Impugned Patent is liable to be set aside. Accordingly, the Impugned Order is quashed and set aside, and the matter is remanded back to Respondent No. 1 for deciding afresh after independently considering all the submissions made by the Appellant.

36. It is clarified that this Court has not gone into the merits of this case, and, therefore, the recommendation of the OB would be independently considered by Respondent No. 1 in context of submissions made by the Appellant while making the decision. Respondent No. 1 shall decide the matter on merits and in accordance with law without being influenced by any observations made in the present Order.

37. It is directed that the matter would be adjudicated by any Controller other than one who passed this Impugned Order preferably withing six months from the communication of this Order.

38. A copy of the Order be also be brought to the notice of the learned Controller General of Patents, Designs and Trademarks for the necessary administrative action.

39. The present Appeal is allowed in the aforesaid terms. No order as to costs.

TEJAS KARIA, J

JULY 28, 2025
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Click here to check corrigendum, if any

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