OIPD-17

IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Intellectual Property Rights Division)

IPDAID/42/2024
[OLD NO AID/7/2023]

BIONORICA SE
VS
UNION OF INDIA AND ORS

BEFORE:
The Hon'ble JUSTICE RAVI KRISHAN KAPUR
Date : 11th March, 2025.

Appearance:
Mr. Adarsh Ramanujan, Adv.
Ms. Survi Mahajan, Adv.
Mr. Sonal Mishra, Adv.
Mr. Suryaneel Das, Adv.
Mr. Aditya Mondal, Adv.
Mr. S. De, Adv.
…for the appellant

Mr. Sunil Kr. Singhani, Adv.
Mr. Rini Bhattacharya, Adv.
…for the respondent nos. 2 and 3

The Court: This appeal is directed against an order dated 18th August, 2022 whereby an application for patent has been rejected by the respondent Controller.

Briefly, the appellant had filed an application being 591/KOLNP/2014 titled "METHOD FOR PRODUCING DRY EXTRACTS" on 18th March, 2024 carrying the priority date 19th August, 2011. The subject invention unlocks the huge potential of active ingredients in plants by using cutting-edge research and innovative technologies to produce effective and safe herbal remedies and calls this phytoneering.

It is submitted on behalf of the appellant that the subject invention has been granted registration in at least 19 different countries. Upon filing the subject application for patent, a First Examination Report was issued containing both procedural and substantial objections against the patent. On 18 June 2019 the appellants filed a reply to the First Examination Report alongwith the amended claims. A hearing notice was issued on 23 June 2022 and the matter heard of 22 July 2022. Pursuant thereto, written submissions were filed on 5 August 2022. Thereafter, on 18 August 2022 the impugned order was passed.

By the impugned order, the respondent Controller has rejected the subject application on the ground that the same did no comply with section 10(4)(b) of the Act. The relevant portion of the order reads as follows:-

> *"The affidavit filed by the applicant can be considered as supporting date and not to fulfil the requirements u/s 10(4)(b) of the Patent Act, 1970. The complete specification shall, fully and particularly describe the invention and its operation or use and the method by which it is to be performed and disclose the best method of performing the invention, which is known to the applicant and for which he is entitled to claim protection u/s 10(4)(b) of the Patent Act, 1970.*
> *Hence the objection is retained."*

It is submitted on behalf of the appellant that the impugned order is perverse and without any reasons. There has been no application of mind and the same has been passed in violation of the principles of natural justice.

Section 10(4) of the Patents Act 1970 provides as follows:

> *"10 (4) Every complete specification shall—*
>
> *(a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;*
> *(b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and*

> *(c) end with a claim or claims defining the scope of the invention for which protection is claimed;*
> *(d) be accompanied by an abstract to provide technical information on the invention."*

The obligation to disclose to inventions detail is contained in section 10(4) of the Act. The section mandates that the complete specification must contain enough details i.e. sufficiency of disclosure to enable a person skilled in the art to perform the invention.

Section 10(4)(b) has been reproduced in verbatim in the impugned order which concludes by recording that the objections raised have not been complied with by the appellant. Notwithstanding detailed Written Submissions having been filed by the appellant, the same have been totally disregarded by the respondent Controller without furnishing any reason whatsoever.

The impugned order simply records the precise language of section 10(4)(a) and is completely silent on the subject invention. There is no discussion of the subject invention. There are no reasons in the impugned order. The Controller rejected the application under section 10(4)(b) invoking the language of "best method" but instead cites 10(4)(a) of the Act speaking of "fully and particularly describe the invention". The impugned order is cryptic, unreasoned and *ex facie* in violation of the principles of natural justice.

In an unreported decision in *AID/17/2022, Toyo Engineering Corporation vs. The Controller General of Patents, Design and Trade Marks*, this Court has held as follows:

> *"Orders of such nature need to meet the twin tests of "why" and "what". It is the "why" which sustains the "what". Reasons are the safeguard*

> *against the ipsi dixit of the decision-making process. They discuss how the mind has been applied to the matter in issue and convey the nexus between the matters which have been considered and the conclusion based thereon. The justification and the reasonableness of a conclusion can only depend on the reasons given in support thereof. The order impugned has no element of "why" for the "what" therein to stand on (Uniworth Resorts Limited and Ajay Prkash Lohia Versus Ashok Mittal & Ors. reported in (2008) 1 CalLT 1).”*

In view of the above, the impugned order is unsustainable and is set aside.

The matter is remanded back to the Controller to be heard out on merits after giving an opportunity of hearing to the appellant. The above exercise is to be completed within eight weeks from the date of communication of this order. It is made clear that there has been no adjudication on the merits of the case and all questions are left open to be decided by the Controller.

To the above extent, IPDAID/42/2024 stands allowed.

(RAVI KRISHAN KAPUR, J.)

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