

Speaking Roses International Inc. Vs. Controller-general of Patents and anr.

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Court : Mumbai

Decided On : Feb-12-2007

Reported in : (2007)109BOMLR630; LC2007(2)75

Judge : Roshan Dalvi, J.

Acts : [Patents Act, 1970](#) - Sections 3; Patents (Amendment) Act, 2002

Appeal No. : Ordinary Original Civil Jurisdiction Misc. Petition No. 13 of 2006

Appellant : Speaking Roses International Inc.

Respondent : Controller-general of Patents and anr.

Advocate for Pet/Ap. : Murlidharan and ;Smita Vora Advs., i/b., Shantilal & Co.

Judgement :

Roshan Dalvi, J.

1. The Petitioners applied for grant of Patent by an application dated 19 th September, 2002 for providing an image on an Organic Product, being flowers. The Respondent rejected the Petitioners' application by the impugned order dated 19 th April, 2006.

2. The Petitioners' application details the description of their invention, their claim and the summary of their inventions along with several annexures showing the

illustrations, their method of providing the image on the Organic Product, being flowers. The Petitioners have also annexed the step-by-step method of providing the image on the flowers as well as the illustrated flowers with the images made by the method shown by the Petitioners.

3. It may atonce be mentioned that the Petitioners' claim for Patent is for the method of providing the image on the organic product and not for the organic product itself.

4. After undergoing the usual procedure prescribed by law of being given the first examination report (FER), which the Petitioners replied to and complied with, the Petitioners were issued the second examination report (SER) which also the Petitioners replied to and complied with. By virtue of said procedure the Petitioners have applied for amendment to their application for their Patent, but which need not be considered for the reasons set out hereinafter.

5. The impugned order dated 19 th April, 2006 shows the details of the claims filed by the Petitioners which includes their product claim as well as method claim (Systems Claim) and the consideration of their submissions. The order necessarily rejects the Petitioners' application for Patent on 5 main grounds; the other ancillary and wholly technical grounds which need not be considered in detail.

6. The rejection of the claim is essentially based on the fact that it falls within the mischief of Section 3(j) of the [Patents Act, 1970](#) as amended by the Patents (Amendment) Act, 2002 and that it is not an inventive step taken by the Petitioners in as much as 3 other patentees are stated to have been granted patents for the same purpose. It is also rejected on the ground that the Petitioners' claim does not sufficiently define the invention, the title of the patented product is not clear and the title is inconsistent with the given claims. It is only these aforesaid 5 reasonings which need be adverted to.

THE PROVISIONS OF SECTION 3(j) OF THE PATENTS ACT, 1970

(i) Section 3 of the Patents Act enumerate what are not inventions in Sub clauses (a) to (p).

(ii) Sub section (j) runs thus:

Plants and animals in whole or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals.

Accordingly under this Section no Patent can be granted inter alia for plants or for any biological processes for production or propagation of plants.

7. It has to be seen whether the Petitioners claim is in respect of any plant or for any biological processes relating to any plant. The application of the Petitioners makes it very clear that the Patent that is required by the Petitioners is not for or in respect of any flowers or any such organic product. Hence, their Patent is not for plants. Their Patent is for providing an Image on an organic product. Such organic product may be plants. The Petitioners require a Patent for providing an image on flowers. The illustration setting out the method as well as the instrument thereof by which an image can be brought about on the flower or any such organic product is a mechanical process. It is not a biological process. There is no bar to the grant of patent for making an image of an organic product by a non-biological process. Hence, the Petitioners' claim falls completely outside the preview of Section 3(j) of the Patent Act. Rejection of the Petitioners' submission in paragraph 5 (1A) of the impugned order is therefore, completely misconceived and must be rejected.

INVENTIVE STEP

8. The three earlier Patents for processes upon an organic product including a flower have been considered by the Respondent to reject the Petitioners' claim of novelty. These are of one SKONECKI, one CRONER and one JONES.

9. The Petitioners' Advocate has shown how the products of the aforesaid three patentees are diametrically different from that of Petitioners. The Patent granted to SKONECKI is for the method of putting a message or a drawing by means of applicator such as a pen which contains a pigmented oil based paint and requires pressure to be put on the flowers causing an indentation of the flowers and cellular damage. The Petitioners' method involves the use of a pad or a roller as a transfer

medium.

10. The Patent granted to JONES as for a method of etching, cutting and/or altering the surface of the flower or the organic material with computer-controlled laser energy. The image is marked by cutting and altering over the surface of the flower by way of a laser beam. It results in alterations of the material of the organic product and causes quick deterioration. The Petitioners' method of pad printing does not alter the material on which the message is printed.

11. The Petitioners' patent is more temporary, less permanent, lighter and does not involve either writing with a pen, applying thermal pressure, or cutting the organic product resulting in a more temporary and less permanent image put lightly on the surface without causing any damage, cut or indentation on the delicate petals on which the image is pad printed. The entire method is, therefore, wholly different from the methods adopted by the earlier patentees. The earlier patentees have also not used any biological process on the organic product and hence, have stayed clear of the mischief sought to be prevented by Section 3(j), as do the Petitioners, albeit by a completely different mechanical process. There is no patentee who has used a similar process of pad printing as that of the Petitioners. Consequently the Petitioners Patent shows an inventive step and conforms with that the requirement of novelty of a patent.

12. TITLE OF THE INVENTION

Since what the Petitioners require to Patent is the mechanical process or the method of imprinting the message by pad printing on an organic product, their application is for Providing an image on an Organic Product . The title is precise, concise and definite. The step-by-step method shown in the application of the Petitioner is in respect of providing an image on an Organic Product, without more. The objections in the impugned order that Product is claimed in Claims is entirely incorrect. The Petitioners have not claimed any Patent for the product being a flower or any other such organic material. The method which is claimed in the title is, therefore, correct as the Patent that is applied for is for that method and not for the Product. In fact the objection shows the complete mis-understanding of written claim of the Petitioners.

13. DEFINITION OF THE INVENTION

The objection relates to the inconsistency of the title with the claim of the Petitioners. This objection is similar to the objection about the non-clarity of the title. The Petitioners' patent being not for a product, but for a method, its title shows that it is for providing an image on an organic product. The method explained by the Petitioners along with the illustrations provided by the Petitioners annexed to their Application shows complete consistency with their claim for a patent for a method as against the patent for a product. The Petitioners have detailed their invention in the summary of the invention stated in their application. The very first sentence of the Summary makes their application clear. It shows that the invention relates to Systems and Methods for providing an image on an item . It recites the kinds of images that could be imprinted upon specifically illustrated organic products. It sets out the object of the entire exercise. It also shows the method of the said exercise. Scanning the Application of the Petitioners makes interesting reading of the well defined invention of the Petitioners. The objection that the claims do not sufficiently define the invention, therefore, has to be rejected.

14. It can, therefore, be seen that the basic objections raised by the Respondents as shown in paragraph 5(1) and (1A) of the impugned order cannot be sustained, as completely lacking substance. The Petitioners have made out a case for grant of the patent applied for as per their original application.

15. In view thereof though the Petitioners have submitted an amendment to their claim, it is seen that no amendment is called for. The Respondents' further objection, that the scope of the claim is increased in the amendment need not be considered.

16. The Petitioners' application does not suffer from any laches. Their amended claim has been filed within the statutory period.

17. The Assignment Deed in respect of the patent is in the name of the Petitioner and another party. The Patent has been applied for by the Petitioners alone. Only that party would have a locus to challenge the Patent, which right has not been

exercised. The patent is not rejectable on the ground that only the Petitioners, who are one of the assignees of the patent, made the application.

18. The other objections are hyper-technical and deserve to be rejected.

19. For all the aforesaid reasons the impugned order is seen to be misconceived and entirely erroneous. In fact it proceeds on a fundamental error relating to the bar under Section 3(j) of the Patent Act as well as the title and the definition of the Petitioners' Patent applied for. The impugned order, therefore, deserves to be set aside.

20. It may be mentioned that the Petition came up on board in the normal course. The Respondents failed to appear despite service and notice given by the Petitioners' Advocates. After hearing the Petitioners' Counsel the Court directed notice to be issued upon the Respondents for the specific date for hearing the Respondents contentions. Despite specific notice in that behalf as per the Court's directions the Respondents have failed to appear. The Petitioners' case as well as the Respondents' objections have been considered on merits. Hence, the following order.

ORDER

(i) The Petition is made absolute in terms of prayer (a).

(ii) The order dated 19 th April, 2006 of the Respondents is set aside.

(iii) The Petitioners shall be granted the Patent as applied for by them being providing an the image on Organic Product as per their application No. 00183/MUM/MP/2004 dated 19 th September, 2002.