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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **28.11.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(PT)/114/2023
(OA/1/2019/PT/CHN)

LIPOTEC, S.A.
Poligono Industrial Cami Ral,
C/Isaac Peral, 17,
Barcelona-08850, Gava
Spain. ... Appellant

-vs-

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

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) filed under Section 117-A of the Patents Act, 1970, praying to the Hon'ble Court that the order dated 10th August 2018 be set aside and Application No.7314/CHENP/2009 for patent be allowed to proceed to grant.

For Appellant : Mr.P.V.Balasubramanian, Senior Counsel

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for Mr.P.Siddharth
for M/s.De Penning and De Penning

For Respondent : Mr.P.R.Ramesh Babu, SPC

JUDGMENT

The appellant impugns an order dated 10.08.2018 by which Indian Patent Application No.7314/CHENP/2009 for the grant of patent for an invention entitled "Regulatory Compounds For Pigmentation" was rejected.

2. The above mentioned application was filed by the appellant on 14.12.2009. The complete specification contained about 15 claims consisting of both substance and process claims. In the First Examination Report (FER), objections were raised *inter alia* under Section 3(d) and Section 2(1)(ja) of the Patents Act, 1970 (the Patents Act), the latter on the ground that the claimed invention lacked an inventive step. The appellant responded thereto and asserted that the substance claims are in respect of a novel compound and that, in any event, the compound exhibited enhanced therapeutic efficacy. As regards the objections on the ground of obviousness, the appellant differentiated the cited prior arts and contended that the cited prior arts would not lead to the claimed invention. The appellant also

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amended its claims. Eventually, pursuant to a hearing on 10.10.2017, the application was rejected on the same grounds that were set out in the FER and the hearing notice.

3. Learned senior counsel for the appellant referred to the impugned order and pointed out that the operative portion thereof is contained only in paragraphs 4 and 5 of the order. As regards paragraph 4, learned senior counsel submitted that the Controller has recorded the conclusion that the claimed compound is the mere discovery of a new derivative of known compounds disclosed in prior art documents D1 and D4. Learned senior counsel submits that the said conclusion has been reached without engaging with the experimental results set out in the complete specification, particularly at pages 138 to 151 of the paper book. He also submits that the appellant's response to the FER and written submissions were completely disregarded.

4. As regards the conclusion in paragraph 5 of the impugned order that the claimed invention lacks an inventive step, learned senior counsel

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submits that each of the cited prior arts were distinguished in detail in the written submissions. By referring to pages 166 to 171 of the paper book, learned senior counsel submits that the reasons set out therein were not considered by the Controller in paragraph 5. By submitting the comparative extracts from the FER and hearing notice *vis-a-vis* the impugned order, learned senior counsel submits that for the most part, the impugned order is a reproduction of the FER and hearing notice. Therefore, he concluded by submitting that the impugned order is liable to be set aside.

5. Mr.P.R.Ramesh Babu, learned SPC, submits that the impugned order was issued on the basis of prior arts D1 to D6, which were referred to therein. In addition, he submits that the claimed invention falls squarely within the prohibition in Section 3(d) of the Patents Act.

6. As contended by learned senior counsel for the appellant, the entire discussion in the impugned order is confined to paragraphs 4 and 5 thereof. In paragraph 4, a conclusion is drawn that the claimed compound is the mere discovery of a new derivative of compounds disclosed in prior arts D1

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and D4. In the complete specification, the appellant has set out the details of the studies carried out with regard to the claimed compound, including the enhanced therapeutic effect with regard to depigmentation. In the light of such data, the conclusion that there is absence of experimental data is unfounded.

7. As regards the conclusion on obviousness, the appellant has differentiated the cited prior arts in considerable detail in response to the FER and, particularly, in the written submissions filed after the hearing. Paragraph 5 does not engage with the said submissions and record reasons for rejecting such submissions.

8. Therefore, the impugned order calls for interference and is hereby set aside. Consequently, (T)CMA(PT)/114/2023 is remanded for reconsideration on the following terms:

(i) In order to preclude the possibility of pre-determination, an officer other than the officer who issued the impugned order shall undertake reconsideration;

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(ii) Upon providing a reasonable opportunity to the appellant, a reasoned decision shall be issued upon such reconsideration within a period of four months from the date of receipt of a copy of this order; and

(iii) It is made clear that no opinion is being expressed herein on the merits of the case.

9. Therefore, (T)CMA(PT)/114/2023 is disposed of on the above terms, without any order as to costs.

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

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