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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED **: 30.10.2023**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(PT)/43/2023
(OA/23/2020/PT/CHN)

New York University
70 Washington Square,
New York, 10012
United States of America. ... Appellant

-vs-

The Assistant Controller of Patents and Designs
Patent Office, Intellectual Property Building,
GST Road, Guindy, Chennai 600 032. ... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) filed under Section 117-A of the Indian Patents Act, 1970, praying that the order of the Assistant Controller of Patents and Designs, at Chennai dated 28.11.2019 in patent Application No.9210/CHENP/2011 be set aside; hold that the amended claims are valid and the claimed subject matter involves inventive step; and to direct the Controller to grant the Patent and publish the grant in the journal.

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For Appellant : Ms.Vindhya Mani
for M/s.Lakshmi Kumaran and Sridharan

For Respondent : Mr.Rajesh Vivekananthan
Deputy Solicitor General

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JUDGMENT

The appellant assails an order dated 28.11.2019 by which Application No.9210/CHENP/2011 for the grant of patent for an invention entitled "Immunological Targeting of Pathological Tau Proteins" was rejected.

2. The appellant submitted the above mentioned application on 09.12.2011. The First Examination Report (FER) in relation thereto was issued on 29.12.2017. In the FER, objections were raised under several provisions of the Patents Act, 1970 (the Patents Act) in relation to lack of inventive steps, unity of invention, insufficiency of disclosure, etc. By response dated 05.06.2018, the appellant

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submitted amended claims 1 to 18. Pursuant to a hearing notice dated 29.01.2019, written submissions were submitted on 27.03.2019 along with amended claims 1 to 14 and relevant annexures. Eventually, the application was rejected by the above mentioned order dated 28.11.2019.

3. Learned counsel for the appellant submitted that the invention relates to peptides which effectively target only pathological tau proteins. In spite of submitting evidence distinguishing the claimed invention from the cited prior arts, learned counsel contended that the impugned order was issued on the basis that the amino acid sequences are similar. As regards the rejection under Section 59 of the Patents Act, learned counsel submitted that the composition claims were within the scope of the original claims and the complete specification. However, without assigning any cogent reasons, the amended claims were rejected by referring to Section 59 of the Patents Act.

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4. Mr.Rajesh Vivekanandan, learned Deputy Solicitor General, submits that the matter may be remanded for re-consideration since the impugned order does not contain detailed reasons for rejecting the amended claims under Section 59 of the Patents Act. This submission was made without making any concession on the merits of the application for grant of patent.

5. In the impugned order, in relevant part, amended claims 2 to 11 were rejected by recording as under:

> "*The amended claim 2-11 filed in response to FER changes the scope from method to composition are not allowable u/s 59 of the Patents Act, 1970 as no amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and in not in way of addition. Therefore, finally amended corresponding claims in written submission are not allowed u/s 59 of the Patents Act, 1970.*"

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6. From the above extract, it is evident that the Controller of Patents has recorded the conclusion that amended claims 2 to 11 are not permissible under Section 59 of the Patents Act without providing any basis for such conclusion. For such reason, the order cannot be sustained.

7. Even as regards the conclusions on lack of inventive step, some reasoning is provided to the effect that the claimed invention is within the scope of a skilled person, without engaging with the submissions of the appellant as to how the cited prior arts did not lead to the claimed invention and recording cogent reasons for rejecting such submissions.

8. For reasons set out above, the impugned order is set aside and the matter is remanded for re-consideration on the following terms:

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(i) In order to preclude the possibility of pre-determination, the re-consideration of the application shall be made by an officer other than the officer who issued the impugned order.

(ii) After providing a reasonable opportunity to the appellant, the application for grant of patent shall be disposed of by a reasoned order within a period of ***four months*** from the date of receipt of a copy of this order.

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

9. Therefore, (T)CMA(PT)/43/2023 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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