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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 20.02.2024

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MR.JUSTICE N.SESHASAYEE

(T)CMA(PT)/167/2023
(OA/SR.56/2021/PT/CHN)

ARATANA THERAPEUTICS, INC.
11400, Tomahawk Creek Parkway, Suite 340
Leawood, Kansas 66211, USA
Nationality: USA ... Appellant

Vs.

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) is filed under Sections 117 A of the Indian Patents Act, 1970, praying to set aside the impugned order dated 28 December 2020 issued by the respondent and allow further amendment of the claims to render the application grantable; Grant the Patent in respect of the Appellant's Application No.201747026233 in accordance with the provisions of the Act and the Rules.

For Appellant : Mr.Karuna Goleria
For Respondent : Mr.S.Janarthanam

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Senior Panel Counsel

JUDGMENT

The appellant herein has approached this Court challenging the order of the respondent dated 28.12.2020 under which the respondent had rejected the appellant's invention under Section 3(i) of the Patents Act, 1970.

2.The facts are as below;

- The appellant has invented a product titled "METHOD FOR CHRONIC USE OF A WEIGHT GAINING COMPOUND". In its specifications it explains its invention as under:

> The present disclosure relates to a weight-gaining compound and methods for chronic use thereof to control weight in animals. In particular, the current disclosure is directed to a novel use of an weight-gaining compound to potentially induce increased food intake, lean muscle growth, and increased weight gain in animals suffering from chronic

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inappetance or other chronic maladies or disorders that induce weight loss, frailty, and wasting for periods of eight days or greater.

In its application, the appellant has made 38 claims of which six are independent and the rest are dependent.

- The Controller would now come out with its First Examination Report (FER) in which it cites two prior arts. The appellant had responded to the FER and made amendment to its claims and brought down the total number of claims from 38 to 27, out of which 5 continued to be its independent claims and remaining are dependant claims. It may have to be said that the FER essentially raised certain resistance on the part of the Controller of the Patents under Section 2(1)(ja) and 3(i) of the Act.

- The respondent would now issue its hearing notice wherein it retained both the grounds under which it raised objections for patenting the invention of the appellant. The appellant participated in the hearing

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and had also filed its written submissions.

- In its cryptic order the respondent had rejected the appellant's application for patenting its invention under Section 3(i) of the Act.

3.Heard both sides. The learned counsel for the appellant submitted that the appellant's invention relates to enhancing the appetite in cats with chronic renal diseases. Indeed, even the title of the invention states that it is a method for using capromorelin-containing composition orally for cats with kidney diseases. So far as the prior arts D1 is concerned, it essentially relates to subcutaneous and intravenous methods of administering the said composition in normal, sick free cats and not cats with kidney ailments. At any rate, the appellant did not claim that it has developed a product to cure any illness in cats permanently, but only claims that it has developed a capromorelin composition for oral administration to sick cats. The Controller, however, appeared to have understood it as a composition for permanent cure of ailing cats. This never has been the invention of the appellant.

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4.This Court carefully perused the submissions of the learned counsel. Under Section 3(i) of the Act only "any process for the medicinal, surgical, curative, prophylactic [diagnostic, therapeutic] or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products" is treated as no-invention. Now, inasmuch as the appellant herein does not even claim it to be any medicine for curing any ailments in animals permanently, the controller has missed the all critical limb of the statutory provision.

5.This Court, therefore, is constrained to set aside the impugned order of the Controller dated 28.12.2020 and remands the matter for denovo consideration vis-a-vis the objection raised under Section 3(i) of the Act alone. To save embarrassment to the Controller who had earlier decided the matter and passed the impugned order, this Court requires that some other controller to consider the petitioner's application and its sustainability vis-a-vis Section 3(i) of the Act. The Controller would now take charge of this issue and comply with all statutory requirements and dispose of the same as

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N.SESHASAYEE, J.

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expeditiously as possible, at any rate not later than six (6) months from the date of receipt of a copy of this order.

6.In the result, this appeal stands allowed. There is no order as to costs.

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Index : Yes / No
Neutral Citation: Yes / No

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