WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 26.06.2024	Pronounced on: 05.07.2024

CORAM:

THE HON`BLE MR.JUSTICE P.B.BALAJI

(T) CMA (PT) No.9 of 2023

KYORIN PHARMACEUTICAL CO., LIMITED,
(formerly known as KYORIN HOLDINGS INC),
6, Kanda Surugadai 4- Chome,
Chiyoda-ku, Tokyo 101-8311, Japan,
Nationality: Japan

.. Appellant

..Vs.

Assistant Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy.

.. Respondent

Prayer: This appeal came to be numbered by transfer of IPAB Case OA/2/2019/PT/CHN from the file of the Intellectual Property Appellate Board, Chennai praying that the order dated 24.08.2018 issued by the respondent be set aside and the Application No.5360/CHENP/2010 for patent be allowed to proceed to grant.

For Appellant : Mrs.Karuna Goleria
for M/s.De Penning & De Penning
For Respondent : Mr.K.Subbu Ranga Bharathi,

https://www.mhc.tn.gov.in/judis

WEB COPY

Central Government Standing Counsel
Dr.Rohit Rathore-Deputy Controller.

JUDGMENT

This Appeal has been preferred against the rejection of the Patent Application of the Appellant in Patent Application No.5360/CHENP/2010 dated 24.08.2018.

2. The Patent Application pertains to a claim of an orally, rapidly disintegrating tablet having excellent photostability, thereby having the advantage of being easily administered to elderly people and children. The Application has been rejected on two grounds viz., lack of inventive step under Section 2(1)(ja) of the Indian Patents Act, 1970 and non-patentability under Section 3(e) of the Patents Act, 1970.

3. I have heard Mrs.Karuna Goleria for M/s.De Penning & De Penning, learned counsel for the Appellant and Dr.Rohit Rathore, Deputy Controller for Mr.K.Subbu Ranga Bharathi, learned counsel for the Respondent.

4. The learned counsel for the Appellant would take me through the

https://www.mhc.tn.gov.in/judis

WEB COPY

records as well as the impugned order to fortify her contentions that the respondent has clearly fell in error while examining the Application of the Appellant. She would contend that the reason for rejecting the Application as lacking inventive step was clearly unsustainable in view of the grant of Patent for the process involved in manufacturing the product.

5. The learned counsel for the Appellant would further state that though prior arts D1 and D3 were retained at the hearing stage, a new prior art in D5 was cited, the respondent failed to see that the prior arts D1 and D3 were teaching away from the claim and even a combination of D1 and D3 was different from the invention claimed. She would further state that even prior art D5 pertained to a sustained release which was not the case insofar as the Appellant's product and in any event, the respondent has not even discussed the arguments of the Appellant clearly demonstrating that the prior arts could not be cited against the claim of the Appellant.

6. The Learned Counsel for the Appellant would also contend that the respondent has not even analysed the response of the Appellant in respect of prior arts D1, D3 and D5 as well as the objections raised under Section 3. She would therefore pray for the Appeal being allowed.

https://www.mhc.tn.gov.in/judis

WEB COPY

7. Per contra, the Deputy Controller, Dr.Rohit Rathore would submit that the tablet is only a mixture of two substances and controlled with a polymer and both prior arts D1 and D5 were also nothing but compounds with a polymer added to it. He would further contend that even D5 was rapidly disintegrating only and therefore the claim was not reflecting any inventive step. He would also submit that the Appellant had not shown or proved the photostability claimed and the respondent has therefore passed a reasoned order and there is no necessity to even remit the matter and prayed for dismissal of the appeal.

8. I have carefully considered the rival submissions advanced by the learned counsel for the Appellant and the Deputy Controller. I have also perused the entire records, including the impugned rejection order passed by the respondent.

9. The Appellant had initially made a claim, one independent and two dependant claims. The product for which patent is claimed is a tablet which dissolves in the mouth without requiring water and thus making swallowing easier and thus safe for use by children as well as elderly people. In the First

https://www.mhc.tn.gov.in/judis

WEB COPY

Examination Report, 4 prior arts were cited, i.e. D1 to D4. However, at the hearing, D1 and D3 were alone retained and D2 and D4 were omitted, but a new prior art, D5 was introduced. The respondent has held that there is lack of inventive steps in the claim as prior arts D1 and D5 were both dissolvable and like the Appellant's claim, added with a polymer and similarly D5 prior art was also possessing rapidly disintegrating properties.

10. First and foremost, I have noticed that a European Patent has been granted to the Appellant considering the prior arts D1, D3 as well as D5. The fulcrum of the invention claimed by the Appellant is that the tablet is orally, rapidly disintegrating within the oral cavity and yet photostable because of the employment of gastric juice-soluble polymer used as a coating agent.

11. The reference to co-pending Application also assumes relevance. Admittedly, for the process in a co-pending Application in No.5364/CHENP/2010 a Patent has been granted on 28.07.2017 in Patent No.285816 to the Appellant. When the method for preparing an orally rapidly disintegrating tablet has been granted a patent, I am unable to see how the respondent can come to a conclusion that the tablet, which is only the result of such an inventive process for which a patent has already been

https://www.mhc.tn.gov.in/judis

WEB COPY

granted, lacks inventive step. The process for which Patent granted is definitely distinct and different from the resultant product arising from the employment of the process and therefore as rightly contended by the learned counsel for the Appellant, once the Patent has been granted for the process involved itself, the respondent ought not to have rejected the Patent Application on the ground o lack of inventive steps. The respondent, in my considered opinion, was estopped from even examining 'lack of inventive steps' in the first place and having come to a conclusion that the invention claimed was well known to a person skilled in the art.

12. Product Patents and Process Patents are different and merely because the Appellant had successfully obtained a Patent for the process, the Application for Patent for the product cannot be refused. No doubt, an owner of a Patent for a process cannot claim monopoly rights over the product of the process and such Patent holder also cannot stop a person from claiming a different process which may result in even the same product. But, here, in this case, after having granted a Patent for the process to manufacture the tablet, the Patent Controller has non-suited the Appellant citing the process involved alone in coming to the conclusion that there is no inventive step and there is no teaching away from the prior arts D1, D3 & D5. Such an

https://www.mhc.tn.gov.in/judis

WEB COPY

approach is totally erroneous as once the process has got a green signal from the respondent, the Respondent is estopped from even scrutinizing the process or steps and come to a conclusion that the process does not involve any inventive steps, thereby disentitling the Appellant from the grant. In such view of the matter, the respondent has erred in citing the prior arts D1, D3 & D5 against the claim of the Appellant, especially discussing the process involved, having already granted a Patent for the said process. In any event, while coming to the conclusion that '*As obvious from the disclosure of said prior art documents coated tablets comprising granules or particles of imidafenacin coat are well known to a person skilled in the art that before the present invention*', the respondent does not even cite the relevant document before arriving at such a conclusion.

13. Further, the Respondent has also not discussed and deliberated on the reasons given by the Appellant with regard to the prior arts that were put against the Appellant. Therefore, for all the above reasons, I am constrained to set aside the findings and conclusions of the respondent regarding 'lack of inventive steps.' In view of the process Patent already granted to the Appellant, the respondent was estopped from even reopening the said process and picking holes therein to conclude that the process/steps involved

https://www.mhc.tn.gov.in/judis

WEB COPY

were no different from the prior arts.

14. With regard to the objection regarding Section 3(e), non-patentability, despite the Appellant having given explanations for the objections raised by the respondent, the respondent, without even discussing the same has summarily and erroneously held that the objections raised at the hearing notice are still pending and not met. In such view of the matter, I deem it fit to remit the matter to the respondent for fresh consideration of this issue alone.

15. In fine, the Appeal is allowed and the decision of the respondent insofar as 'lack of inventive steps' is set aside and the Appellant is entitled to get a Patent grant, subject of course, to the decision regarding 'non-patentability' for which the matter is remitted to the respondent for fresh consideration, in accordance with law and after affording an opportunity, by way of a hearing to the Appellant, by a different Patent Controller and such exercise shall be completed within a period of three (3) months from the date of receipt the copy of this judgment. No costs.

05.07.2024

https://www.mhc.tn.gov.in/judis

WEB COPY

Index : Yes/No
Speaking/Non-speaking order
rkp

To

Assistant Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy.

P.B.BALAJI,J.
rkp

https://www.mhc.tn.gov.in/judis

WEB COPY

(T) CMA (PT) No.9 of 2023

05.07.2024

https://www.mhc.tn.gov.in/judis