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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 07.12.2023

CORAM

THE HON'BLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(PT) No.138 of 2023
(OA/9/2017/PT/CHN)

Helix Biomedix Inc.
22121 - 17th Ave SE #112
Bothell, WA 98021
USA; Nationality: USA ... Appellant

Versus

Assistant 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, prays that the order dated 7 November 2016 and issued by the Respondent on 7 November 2016 be set aside and the application No.4583/CHENP/2009 for patent be allowed to proceed to grant.

For Appellant : Mr. S.Shivathanu Mohan for
M/s.De Penning and De Penning

For Respondent : Mr. Rajesh Vivekananthan, DSG
Mr.Manoj Madhavan
Deputy Controller of Patents
(Present in VC)

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JUDGMENT

The appellant assails an order dated 07.11.2016 by which Patent Application No.4583/CHENP/2009 for grant of patent to an invention entitled "Short Bio-Active Peptides for Cellular and Immunological Modulation" was rejected.

2. The appellant submitted the above mentioned application on 04.08.2009. Upon a request for examination, the First Examination Report (FER) was issued on 07.10.2013. In the FER, the respondent raised objections *inter alia* on the grounds of lack of inventive step and under Section 3 of the Patents Act, 1970 (the Patents Act). The appellant responded to the FER on 11.04.2014. Thereafter, amended claims were submitted. Pursuant to a hearing on 04.04.2016, the appellant made oral submissions and also submitted written submissions on 18.04.2016. Eventually, by order dated 07.11.2016, the application for grant of patent was rejected. The present appeal arises under the above facts and circumstances.

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3. Learned counsel for the appellant submitted that the claimed invention relates to chemically synthesized peptides, which do not exist in nature and were not isolated from a natural source. Merely because the parent protein, cecropin-B, originates in a type of moth, he submitted that the application was rejected by citing Section 3 (c) of the Patents Act. In this connection, he referred to internal page 16 of the appeal and pointed out that the respondent had overlooked the enumerated significant differences between the claimed invention and peptides occurring in nature.

4. In response to these submissions, it was submitted on behalf of the respondent that independent claim 1 of the appellant relates to sequence ID No.1, comprising SEQ ID Nos.2,3,5,6,7,8,9,10,11,12 or 15. It was further submitted that all the claimed sequences are obtained from *hyalophora cecropia*, which is known as the cecropia moth.

5. From the response to the FER and the written submissions of the appellant, it appears that the appellant asserted that the peptides

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in respect of which an invention is claimed are chemically synthesized using particular methods. Reference may be made in this regard to paragraph 4.5 at internal page 16 of the appeal.

6. The impugned order is brief and the operative portion thereof is as under:

> *"The claims related to this application primarily relate to short bio-active peptides that are useful for promoting wound healing in mammals. To this end, instant application has claimed isolated peptides derived from Cecropin B.*
>
> *Claims relating to these isolated peptides referred to Sequence ID no.1 comprising Sequences 2,3,5,7,8,9,10,11,12 or 15. Upon scrutiny of the pages describing sequence listing, it was established that all the claimed sequences are obtained from Hyalophora cecropia also known as the Cecropia moth.*
>
> *In view of this finding, the isolated sequences claimed in amended claims 1-11 are not patentable under Section 3(c) as they relate to a substance occurring in nature."*

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7. The above extract discloses that the respondent recorded the conclusion that all the claimed sequences are obtained from *hyalophora cecropia*. It also appears that such conclusion was recorded by examining the sequence listing. However, the submissions of the appellant that the peptides are synthesized chemicals and that they do not occur in nature were not dealt with. It is of paramount importance that an order of adjudication in respect of an application for grant of patent should contain cogent reasons for the conclusions recorded therein and that such conclusions should be reached after engaging with the contentions of the party applying for patent. Since the impugned order does not meet the above requirements, the order is set aside and the matter is remanded for re-consideration.

8. Accordingly, (T)CMA(PT)No.138 of 2023 is disposed of by directing the respondent to re-consider Patent Application No.4583/CHENP/2009 on the following terms:

(i) In order to preclude the possibility of pre-

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determination, such reconsideration shall be made by an officer other than the officer who passed the impugned order.

(ii) After providing a reasonable opportunity to the appellant, a reasoned decision shall be issued 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 expressed herein on the merits of the application for grant of patent.

There shall be no order as to costs.

07.12.2023

Internet : Yes/No

Speaking/Non-Speaking Order

Neutral Citation: Yes/No

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To:

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SENTHILKUMAR RAMAMOORTHY J.

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