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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 24.01.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT)/103/2023
(OA/14/2018/PT/CHN)

F.HOFFMANN-LA ROCHE AG
124 Grenzacherstrasse
CH-4070 Basel
Switzerland ... Appellant

Vs.

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

2.Indian Pharmaceutical Alliance
New Delhi ... Respondents

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 20th July, 2017, issued by the respondent and application No.961/CHENP/2012 for patent be allowed to proceed to grant.

For Appellant : Mr.P.V.Balasubramanian
Senior Advocate
for M/s.De Penning De Penning

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For Respondents : Mr.J.Madhanagopal Rao
Senior Panel Counsel - R1

No appearance - R2

JUDGMENT

The present appeal is preferred challenging the order of the 1st respondent dated 20.07.2017, rejecting the appellant's petition dated 31.01.2012, for patenting its invention entitled 'SUBCUTANEOUS ANTI-HER2 ANTIBODY FORMULATION'.

2.The petitioner's invention involves developing a subcutaneous administrable antibody for treating certain types of cancer, and in the application, the appellant is stated to have made 12 claims. It was opposed by the 2nd respondent herein.

3.According to the 2nd respondent, the product which the appellant had developed lacks inventive step, and the product itself is well known in the market. And this was accepted by the Controller and it formed the basis for his decision.

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4.1 The learned counsel for the appellant submitted hitherto the antibodies are administered intravenously and not subcutaneously, because in the subcutaneous form whatever that were earlier administered were found to be unstable. What the appellant has now invented is a highly concentrated and stable variant of the same known medicine for easy subcutaneous administration.

4.2 Moving further the learned counsel submitted, the same product was patented by the European Patent office, where the post-grant opposition was made, and this was considered, and after entertaining the claims, the patent office sustained the patent it had earlier granted. Notwithstanding the same, the appellant herein had come out with certain amended claims and they have been duly accepted and registered by the European Patent Office, and these developments have happened after the disposal of the present application by the 1st respondent herein. The learned counsel submitted that the appellant is inclined to amend his claims along the lines of amendment he had brought to his claims before the European Patent Office.

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5.This apart, the 2nd respondent had chosen to reject only the first among the 12 claims which the appellant had made, and he is silent as to the fate of claim Nos.2 to 12. In other words, the Controller has not adequately applied his mind to the claims before his individually.

6.The submissions of the appellant requires merit consideration of this Court. First the impugned proceedings of the respondent is silent on 11 out of 12 claims made by the appellant, and the second aspect is the appellant's offer to file amended claims along the lines that it has done before the European patent office.

7.Even dehors the appellant's offer to file amended claim, the matter still may have to go before the Patent Controller, since he has not addressed the claim Nos.2 to 12 of the appellant independently. After all, when the matter has to go before the Patent Controller, and the Patent Controller will be revisiting the whole issue, it will be only appropriate that this Court also permit the appellant to file his amended claims so that any further objections and delay in patenting the product as per law in this country is on delay.

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8.In view of the same, this appeal is allowed. The matter is remanded back to the respondents. To save embarrassment to the Patent Controller who decided the issue earlier, this Court directs that some other Patent Controller would hear the matter, and the appellant is directed to file its amended claim before the patent office within a period of one (1) month from the date of receipt of a copy of this order. There shall be no order as to costs.

24.01.2024

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Index : Yes / No
Neutral Citation: Yes / No

Note:Issue order copy on 31.01.2024

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