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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 11.01.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT)/99/2023
(OA/44/2020/PT/CHN)

H.Lundbeck A/S
9, Ottiliavej DK-2500
Valby, Denmark

Through its Authorized Representative
Mr.Prosenjit Chattopadhyay ... Appellant

Vs.

1.The Deputy Controller of Patents and Designs,
The Patent Office,
Intellectual Property Building,
G.S.T. Road, Guindy,
Chennai – 600 032.

2.Indian Pharmaceutical Alliance,
115/11, Ground Floor, World Trade Center,
Babar Road, Connaught Place,
New Delhi – 110 001. ... Respondents

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) is filed under Section 117A of the Indian Patents Act, 1970, seeking the following prayer;

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a) Allow the present Appeal and pass an order setting aside the impugned order dated 04.08.2020 wherein it has been held that subject matter of Claims 1-5 lack inventive step and are not patentable under Section 3(d) and Section 3(e) of the Patent Act, 1970;

b) Pass an order granting a patent on Indian Patent Application No.7699/CHENP/2011 and issue consequential directions to effectuate such grant; in any case hold that Claims 1-5 are patentable and a patent be granted for these Claims and issue consequential directions to effectuate such grant; and

c) Pass any other or further order(s) which the Hon'ble Appellate Board may deem fit in the interest of justice.

For Appellant	:	Ms.Vindhya S.Mani for M/s.Lakshmikumaran and Sridharan
For R1	:	Mr.J.Madanagopal Rao, Senior Panel Counsel
For R2	:	No appearance

JUDGMENT

This appeal is directed against the order of the first respondent dated 04.08.2020.

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2.The core contention of the appellant is more legal then technical.

3.The invention which the appellant herein required the first respondent to patent relates to liquid pharmaceutical formulations of 1-[2-(2,4-dimethylphenylsulfany1)phenyl1]piperazine.

4.As per the procedure of the First Examination Report was made, which cited as many as 8 prior documents and they were responded to by the appellant. This was followed by a hearing notice from the first respondent which retained only 2 of the prior documents as was disclosed in the FER but, gave up its initial objection on the remaining 6 prior documents.

5.In between, the second respondent entered its opposition, wherein it relied on the 8 prior documents as disclosed in the FER and added one more to it. However, in its final submissions, it limited its reliance only to 3 of the 9 prior documents to sustain its opposition.

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6.However, the first respondent, in his proceedings has relied on all the three documents which the second respondent ultimately chose to rely on and also added 2 more prior documents, which are not part of even his hearing notice.

7.Heard both sides.

8.The learned counsel for the appellant submitted that the appellant was particularly aggrieved since the first respondent had chosen to rely on certain documents, for meeting which the appellant never had an opportunity when he responded to the notice of hearing. Secondly, notwithstanding the fact that the second respondent had given up its reliance on 6 out of the 9 documents that it relied on at the first instance (which includes the list of prior documents enclosed in the FER), the Controller had chosen to rely on something that even the second respondent has given up.

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9.Indeed, as soon as the second respondent gave up its contention as regards 6 prior documents, the appellant had filed a letter dated 31.01.2020 requiring the Controller of patents/first respondent to record the said affidavit. The first respondent however, has neither chosen to record this communication of the appellant dated 31.01.2020 nor has opted not to rely on the prior documents, which were never put for contest.

10.This Court weighed the rival submissions and also perused the records and is convinced about the merit of the submissions made by the counsel for the appellant.

11.The conclusion is to state the obvious. This appeal deserves to be allowed and the matter is required to be heard *de novo*.

12.This Court allows this appeal and remands the matter back to the first respondent for a *de novo* consideration of the petitioner's claim. There shall be no order as to costs.

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13.To save embarrassment for the Controller of Patents, who passed the impugned order, this Court requires that it be heard by another Controller of Patents.

14.This Court finds that the Application for Patent was filed sometime in 2010 and since the registration of patent will date back to the date of application, in the eventuality of the appellant's invention being patented, it will have a shelf value of only 6 years. Hence, this Court requires the Controller of Patents, who is now required to decide the matter, to dispose of the matter as expeditiously as possible, at any rate, not later than six (6) months from now.

11.01.2024

Tsg

Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No

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N.SESHASAYEE, J.

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