WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 27.02.2024

CORAM :JUSTICE N.SESHASAYEE

CMA(PT) No.36 of 2023

DUKE UNIVERSITY
2812 Erwin Road, Suite 306, Box 90083
Durham, North Carolina 27705, USA
Rep by its POA Holder Mr.Harish Bhandari
703, Tolstoy House, 15-17, Tolstoy Marg
New Delhi - 110 001. ... Appellant

Vs.

Deputy Controller of Patents & Design
Patent Office Intellectual Property Building
GST Road, Guindy
Chennai - 600 032 ... Respondent

PRAYER: Civil Miscellaneous Appeal (Patent) filed under Section 117A of the Patents Act, as amended by the Tribunals Reforms Act, 2021, praying to set aside the order dated 30.08.2022 passed by the learned Controller of Patents, Chennai in Patent Application No.201947017962, and allow the appeal.

For Appellant : Mr.Varun Sharma of M/s.Lexorbis
Assisted by Mr.M.Sudhakar,
Ms.Manisha Singh, Mr.Abhai Pandey

For Respondent : Mr.K.Subbu Rangabharathi, SPC

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

WEB COPY

JUDGMENT

This appeal is directed against the order of the respondent rejecting the appellant's application for patenting its invention which is titled as 'LASOFOXIFENE TREATMENT OF ER+ BREAST CANCER'. The title itself indicates that it is something which is intended for treatment of estrogen receptor positive (ER+) breast cancer.

2. The facts are :

a) In its application for patenting its invention, the appellant has made 34 claims, of which the first claim is its independent claim and the rest are dependent claims. The first claim reads as :

> *"1.A method of treating a female patient suffering from estrogen receptor positive (ER+) breast cancer, comprising :*
>
> *administering to a female patient an effective amount of lasofoxifene, a pharmaceutically acceptable salt thereof, or a prodrug thereof"*

b) The application eventually was responded with a FER by the Patent Controller wherein she raised objection to the patentability of the appellant's invention under Sections 2(1)(ja) on the strength of three

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

WEB COPY

prior arts in D1 to D3, and 3(i) of the Patents Act.

c) So far as the objection under Sec.3(i) is concerned, the Controller took exception to the fact that inasmuch as the appellant's invention declares that it is a method**,** it would fall squarely within Sec.3(i) of the Act.

d) The appellant responded to the same and sought amendment of its independent claim from one of method to composition.

e) This is followed by a hearing notice wherein the Patent Controller had stuck to its earlier objections raised in the FER. The appellant participated in the hearing and filed its written submissions and sought amendments to its claims.

f) Ultimately the Controller of Patent rejected the appellant's application under Sec.3(i). What is significant is that he did not permit the appellant to amend its claims.

g) It is to be stated that the appellant's application was registered in multiple jurisdiction as per the law applicable in jurisdictions such as Korea, Europe etc., and have been patented.

3. Heard both sides. The learned counsel for the appellant submitted that the

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

WEB COPY

Patent Controller, in fitness of things, ought to have allowed the appellant to amend its claims and then to test its merits, and should have ascertained it should have pass the test of Sec.3(i). The Patent Controller appears to have pre-judged the issue and has refused to allow the amendments without citing any reasons for such rejection and proceeded to reject the appellant's application for grant of patent under Sec.3(i).

4. This Court perused the papers. In its cryptic two paged order, (because it spreads over two pages, but effectively it will be only a one paged order), the Patent Controller appears to have approached the issue before him as if he is doing some mental mathematics and has not given any reason whatsoever why he refused the amendment of claims by the appellant. Unless any amendment exceeds the original specification within the meaning of Sec.59, it is obligatory on the part of the Patent Controller to allow the amendment and then to consider why it is not tenable. Indeed, even Sec.59 may not play a role at the point when amendments are sought, but it will have a role to play post-amendment.

5. This Court is left with little option, but to set aside the impugned order of

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

WEB COPY

the Patent Controller, and is constrained to remand the matter back to the Controller for denovo consideration. To save embarrassment to the Patent Controller who have decided the issue, this Court directs the appellant's application be considered by some other Controller. The Patent Controller now incharge of the appellant's application is required to expedite the same and dispose of the same as expeditiously as possible. No costs. Consequently, connected miscellaneous petition is closed.

27.02.2024

ds

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

To:

The Deputy Controller of Patents & Design
Patent Office Intellectual Property Building
GST Road, Guindy
Chennai - 600 032

WEB COPY

N.SESHASAYEE, J.

ds

CMA(PT) No.36 of 2023

27.02.2024

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