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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **30.11.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(PT)/90/2023
(OA/16/2017/PT/CHN)

ICAHN SCHOOL OF MEDICINE
AT MOUNT SINAI
One Gustave L.Levy Place,
New York 10029-6574,
New York, USA. ... Appellant

-vs-

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, praying to the Hon'ble Court that the order of the respondent dated 24th November 2016 be set set aside and Application No.3414/CHENP/2008 for patent be allowed to proceed to

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grant.

For Appellant : Mr.P.V.Balasubramanian, Senior Counsel
for Mr.P.Siddharth
for M/s.De Penning and De Penning

For Respondent : Mr.A.R.Sakthivel, SPC
Mr.V.G.Saravana Ramprasad
(Assistant Controller of Patents)

JUDGMENT

The appellant assails an order dated 24.11.2016 by which Patent Application No.3414/CHENP/2008 for the grant of patent for an invention entitled "Chimeric Viruses Presenting Non-Native Surface Proteins And Uses Thereof" was rejected.

2. Upon submission of the above application, the respondent examined the application and issued the First Examination Report (FER) on 17.07.2013. A response to the FER was submitted submitted on 08.07.2014. The hearing notice was issued on 28.09.2016 and pursuant to the hearing, the appellant submitted written submissions. Along with the appeal filed originally before the Intellectual Property Appellate Board (the IPAB), the appellant also submitted Auxiliary Request Nos.1, 2 and 3 for

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amendments to the claims.

3. Learned senior counsel for the appellant submits that the claimed invention relates to a vaccine which targets two viruses, namely, the Newcastle disease virus and the influenza virus. He points out that the Newcastle disease virus belongs to the paramyxoviridae family and the influenza virus belongs to the orthomyxoviridae family. According to him, none of the prior arts cited by the respondent target two viruses from distinct families. With reference to the impugned order, he submits that the said order merely extracts from the cited prior arts and records the conclusion that the claimed invention would be obvious to a person skilled in the art.

4. In response, it is submitted on behalf of the respondent that the original claims were wide in scope and claims were made in respect of multiple viruses. It is further submitted that the request for amendment under Auxiliary Request No.3 whittles down the width of the claims and restricts it to a vaccine targeting the Newcastle disease virus and the influenza virus. On the basis of Auxiliary Request No.3, it is stated that a patent may be granted.

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5. The amended claims made by the appellant as on 09.11.2016 contained the following independent claims:

"1.A chimeric NDV, comprising a packaged genome comprising a nucleotide sequence encoding an F-fusion protein having the transmembrane and cytoplasmic domains of an F protein and at least one epitope of an ectodomain of a protective antigen of a viral antigen or a viral antigen associated with a disease that is anchored by the C-terminus, so that the F-fusion protein is expressed and incorporated into the chimeric NDV, wherein the viral antigen is from an influenza virus, an adenoviridae, a herpesviridae, a leviviridae, a poxviridae, a picornaviridae, a papovaviridae, a reoviridae, a retroviridae, a flaviviridae, a togaviridae, a hepadnaviridae, a rhabdoviridae, an arenaviridae, or a coronaviridae.

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4. A chimeric NDV, comprising a packaged genome comprising a nucleotide sequence encoding an HN-fusion protein having the transmembrane and cytoplasmic domains of an HN protein and at least one epitope of an ectodomain of a protective antigen of a

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viral antigen or a viral antigen associated with a disease that is anchored by the N-terminus, so that the HN-fusion protein is expressed and incorporated into the chimeric NDV, wherein the viral antigen is from an influenza virus, an adenoviridae, a herpesviridae, a leviviridae, a poxviridae, a picornaviridae, a papovaviridae, a reoviridae, a retroviridae, a flaviviridae, a togaviridae, a hepadnaviridae, a rhabdoviridae, an arenaviridae, or a coronaviridae.

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10. A method for propagating a chimeric NDV, comprising propagating the chimeric NDV of any one of claims 1 to 9 in an embryonated egg or a cell line that is susceptible to an NDV infection.

11. An immunogenic formation comprising the chimeric NDV of any one of claims 1 to 9."

6.The amended claims as per Auxiliary Request No.3 are as under:

"Exhibit I - Auxiliary Request No.3
Proposed Claim Amendments (Clean Version)
Indian Application No.3414/CHENP/2008

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1. A chimeric NDV, comprising a packaged genome comprising a nucleotide sequence encoding an F-fusion protein having the transmembrane and cytoplasmic domains of an F protein and at least one epitope of an ectodomain of a protective antigen of a viral antigen or a viral antigen associated with a disease that is anchored by the C-terminus, so that the F-fusion protein is expressed and incorporated into the chimeric NDV, wherein the viral antigen is from an influenza virus.

2.The chimeric NDV of claim 1, in which the genome comprises a nucleotide sequence encoding an F protein, so that the F protein is expressed and incorporated into the chimeric NDV.

3. The chimeric NDV of claim 1, in which the nucleotide sequence encoding the F-fusion protein replaces the nucleotide sequence encoding the NDV F protein and the F-fusion protein supplies the function of the F protein.

4. The chimeric NDV of claim 1, 2, or 3, wherein the antigen is the ectodomain of a hemagglutinin antigen of an influenza virus.

5. The chimeric NDV of any one of claims 1 to 4,

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wherein the chimeric NDV is attenuated."

7. In light of the above submissions, especially by the respondent, the impugned order dated 24.11.2016 is set aside and Application No.3414/CHENP/2008 shall proceed to grant on the basis of the amended claims set out in paragraph 6 above. (T)CMA(PT)/90/2023 is disposed of on the above terms, without any order as to costs.

30.11.2023

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

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