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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 24.07.2024	Pronounced on: 02.08.2024

CORAM:

THE HON`BLE MR.JUSTICE P.B.BALAJI

(T) CMA (PT) No.125 of 2023
(OA/6/2019/PT/CHN)

CELGENE CORPORATION
86, Morris Avenue,
Summit,
NJ 07901,
USA
Nationality : USA .. Appellant

..Vs.

The Assistant Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai – 600 032. .. Respondent

Prayer: This Civil Miscellaneous Appeal filed under Section 117-A of the Patents Act, 1970, prays that the order dated 01.03.2019 and issued by the respondent on 01.03.2019 be set aside and the Application No.8064/CHENP/2010 for patent be allowed to proceed to grant.

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

For Respondent : Mr.K.Subbu Ranga Bharathi
Central Government Standing Counsel

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JUDGMENT

The Appellant, aggrieved by the rejection of its Patent Application No. 8064/CHENB/2010 by order dated 26-03-2018, has preferred the present appeal.

2.I have heard Mr.Shivadhanu Mohan for M/s.Depenning and Depenning Counsel for the Appellant and Mr.K.Subbu Ranga Bharathi, learned Central Government Standing Counsel for the Respondent.

3.It is the case of the appellant, that they have applied for "Oral Formulation of Cytidine Analogs and Methods of use thereof" for Grant of Patent on 13-12-2010.

4.The First Examination Report was issued on 20th December 2016. In response to the same, the explanation was offered by the appellant on 11.04.2017. Thereafter, notice of hearing under Section 14 was held on 22.02.2018. Subsequent to the said hearing, the appellant also filed written submissions on 10.04.2018. Thereafter, the respondent

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has proceeded to examine the patent application and rejected the same in and by the impugned order.

5. According to the learned counsel for appellant Mr.Shivadhanu Mohan, the invention related to a tablet treating Cancer and the inventive step insofar as the claimed invention was that there was no enteric coating which made the tablet dissolvable, besides also resulting in a higher concentration and late release. He would further submit that the prior arts, D1 and D2 were both enteric coated tablets which did not dissolve and therefore, the appellant had shown novelty and also synergistic effect. However, according to the learned counsel for the appellant, the respondent, without any reference to the written submissions, has proceeded to hold that the claimed invention lacks inventive step and that it was only a mere admixture of components.

6. In this regard, the learned counsel for the appellant would take me through the written submissions, where comparative data has also been provided to differentiate the claimed invention as against the prior arts, D1, D2, D3 and D5. In this background, I examined the impugned order and as rightly pointed out by the counsel for the appellant, I find

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that the controller has held that the appellant has failed to establish any technical advancement of the present invention as compared to disclosures of prior art and therefore, there was lack of any inventive step in terms of section 2(1)(ja) of the Patents Act,1970.

7. The above finding is clearly contrary to record. As part of the written submissions, the appellant has clearly drawn a comparison between the claimed invention and the prior arts to show technical advancement. However, the respondent has not even acknowledged the said explanation offered by the appellant. Therefore, the finding arrived at by the controller is clearly faulty on this account alone.

8. With regard to Section 3(e), the respondent has held that the claimed invention is a mere admixture resulting only in aggregation of properties of components and no synergistic composition showing unexpectedly new property or better efficacy has been proved or established by the appellant. In this connection, the controller has referred to prior arts, D1 and D2 tablets and found that the claimed invention inherently has the same pharmaceutical properties as independent compound and that the same ingredients, namely

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Azacitidine is used even in the prior arts, D1 and D2.

9. Even for arriving at this finding, the controller has stated that the submissions of the appellant has not established any data to show synergistic effect and therefore, the application was hit by Section 3(c) in the Patents Act,1970.

10. Even in this regard, I find that the respondent has clearly fell in error without adverting to the foundation of the claim of the appellant that the claimed invention was a dissolvable tablet without enteric coating which consequently resulted in a higher concentration leading to better results, at the same time not compromising on the requirement of a late release.

11. Therefore, the approach of the respondent is found to be highly improper and though the learned Standing Counsel for the respondent would submit that the order is a detailed and well reasoned order, I am unable to countenance the said argument. Despite, the appellant providing an explanation with regard to both Section 2(1)(ja) of Patents Act, 1970, namely regarding inventive step and also in respect of Section 3(e) of Patents Act, 1970, to show synergistic effect, the respondent,

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without applying its mind to the submissions made by the appellant in the written submissions, has proceeded to reject the patent application.

12. In fine, the appeal is allowed and the matter is remitted to the respondent for a denovo examination of the Patent Application of the appellant. To avoid embarrassment to the parties, a different controller shall be assigned to the task of scrutiny of the application and after affording an opportunity to the appellant, the respondent shall pass final orders within a period of three months from the date of receipt of a copy of this judgment. There shall be no order as to costs.

02.08.2024

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

The Assistant Controller of Patents and Designs,
Government of India, Patent Office,
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P.B.BALAJI,J.

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