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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on :12.07.2024	Pronounced on : 19.07.2024

CORAM:

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

(T) CMA (PT) No.196 of 2023

Regeneron Pharmaceuticals, Inc.,
Office at 777, Old Saw Mill River Road,
Tarrytown, NY 10591,
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, praying for the following reliefs:

a) Set aside the impugned order dated 28.10.2020 issued by the respondent; and

b) Grant the Patent in respect of the appellant's Application No.592/CHENP/2012 in accordance with the provisions of the Act and the Rule.

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For Appellant : Mr.Rahul Balaji
for M/s.De Penning and De Penning.

For Respondent : Mr.S.Janarthanam
Senior Panel Central
Government Standing Counsel

JUDGMENT

This appeal is preferred against the rejection of the appellant's patent application in Application No.592/CHENP/2012, by order dated 28.10.2020.

2.I have heard Mr.Rahul Balaji, learned counsel for M/s.De Penning and De Penning, learned counsel for the appellant and Mr.S.Janarthanam, learned Senior Panel Central Government Standing Counsel for the respondent. I have also gone through the records.

3.Mr.Rahul Balaji, learned counsel appearing for the appellant would submit that the appellant had made an application for grant of patent which has been rejected by the respondent, citing Section 59 of

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the Patents Act. Section 59 of the Patents Act runs thus:

"59.Supplementary provisions as to amendment of application or specification.-(1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(a) Where after the date of grant of patent any amendment of the specification or any other documents related thereto is allowed by the Controller or by the Appellate Board or the High Court, as the case may be, -

(b) The fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and

(c) The right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.

3.In constituting the specification as amended, reference may be made to the specification as originally accepted."

4.The appellant originally made a claim on 17.01.2012.

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Subsequently, the claims were amended by the appellant on 04.06.2013. The First Examination Report was issued on 20.12.2017 and in response to the same, the appellant has given his explanation on 20.08.2018. Subsequently, on the hearing notice, an objection was taken to the amendment of the claim, regarding the requirement of Section 59(1) of the Patents Act. The impugned order also reiterates that there is non compliance of requirement of Section 59(1) of the Patents Act. However, as rightly contended by the learned counsel for the appellant, the Controller has not assigned any reason for arriving at such a conclusion and despite having met the requirements of the Controller as raised in the hearing notice, the respondent has once again held that the final amendments were not in compliance with the mandate of Section 59(1) of the Patents Act.

5.It is the contention of the appellant that no new features have been added or inserted to the claim and therefore, the matter was not hit by Section 59 of the Patents Act. However, the respondent/Controller has not assigned any reasons to uphold the objections under Section 59 of the Patents Act, especially after the position was explained by the appellant before the impugned order came to be passed. The learned counsel for

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the appellant submitted that the appellant would be satisfied if the matter is remitted to the respondent for fresh consideration in accordance with law.

6.Mr.S.Janarthanam, learned Senior Panel Central Government Standing Counsel for the respondent submitted that there is no necessity for remand as Section 59(1) of the Patents Act would clearly apply to the facts of the present case and the order passed by the respondent did not require any interference.

7.Having considered the rival submissions advanced by the learned counsel on either side and after perusal of the records, I find that though the objection regarding Section 59 of the Patents Act was taken at the hearing notice, the appellant has given an explanation as to how the patent application would not be hit by mandate of Section 59(1) of the Patents Act. Despite the same, the Controller, without even discussing the explanation offered by the appellant, has merely endorsed the findings at the hearing notice and upheld the objections with regard to Section 59(1) of the Patents Act. Such an order is unreasoned and hence, not sustainable in the eye of law. For this limited reason, matter is to be

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remitted to the respondent for fresh consideration.

8.In fine, the appeal is allowed and the matter is remitted to the respondent to decide the patent Application No.592/CHENP/2012 afresh, in accordance with law, after affording an opportunity by way of a fresh hearing to the appellant. In order to avoid embarrassment to parties, a different Patent Controller shall be assigned for the scrutiny of the patent application and such exercise shall be completed within a period of four months from the date of receipt of copy of this judgement. There shall be no order as to costs.

19.07.2024

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

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

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P.B.BALAJI,J.

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