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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 03.07.2024

CORAM:

THE HONOURABLE MR.JUSTICE P.B.BALAJI

(T)CMA(PT) No.1 of 2024

UNIVERSITAT ULM
Helmholtzstrasse 16,
89081 Ulm,
Germany,
Nationality: Germany. ... Appellant

Vs.

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

PRAYER: Appeal filed under Section 117A of the Patents Act, 1970, praying to set aside the order dated 30.08.2019 and A.No.645/CHENP/2011 for patent be allowed to proceed to grant.

For Appellant : Mr.Shivathamu Mohan
for M/S.De Penning and De Penning

For Respondent : Mr.J.Madanagopal Rao
Senior Panel Central
Government Standing Counsel

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JUDGMENT

The present appeal is preferred against the rejection of the patent application in Application No.645/CHENP/2011 filed on 31.01.2011, claiming patent for the use of Opioids or Opioid Mimetics for the Treatment of Resistant Cancer Patients.

2.I have heard Mr.Shivathanu Mohan, learned counsel for M/S.De Penning and De Penning for the appellant and Mr.J.Madanagopal Rao, learned Senior Panel Central Government Standing Counsel for the respondent.

3.Mr.Shivathanu Mohan, learned counsel for the appellant would take me through the impugned decision of the respondent and submit that the respondent has not discussed the prior arts and also the explanation offered by the appellant by way of written submissions. He would also point out that US patent granted was after considering the prior art, D6 and the same was also brought to the notice of the respondent in Form-3, which also went unnoticed by the respondent. The learned counsel for the appellant would therefore pray for remand of the matter.

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4.Per contra, Mr.J.Madanagopal Rao, learned Senior Panel Central Government Standing Counsel would submit that the order is a speaking order and there is a clear finding that the patent is obvious to a person skilled in art which are combined teachings of D1 to D5 and D7 to D10 and therefore, there is no requirement to remit the matter to the respondent.

5.I have carefully considered the arguments advanced by the learned counsel on either side.

6.Admittedly, the order impugned decision appears to be a very cryptic decision. While dealing with the prior arts, I do not find any discussion whatsoever as to how the patent application of the appellant is obvious to a person skilled in the art and none of the prior arts are discussed in this regard. Equally and as rightly pointed out by the learned counsel for the appellant, despite Form-3 being filed by the appellant bringing it to the notice of the respondent that a US patent has been granted after noting D6, the respondent has not even discussed the same in the impugned decision.

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7.With regard to synergistic effect also, the appellant even in his written submissions has specifically made reference to the same and has exhibited as to how there is a synergistic effect. However, the same has not been considered or discussed by the respondent while arriving at the impugned decision.

8.For these above reasons, I deem it fit to remand the matter to the respondent/Assistant Controller of Patents and Designs for fresh consideration. However, the respondent shall assign the task of scrutinizing the patent application of the appellant to a different Patent Controller to avoid any embarrassment to the parties, after affording a personal hearing to the appellant and the application shall be decided, within a period of three months from the date of receipt of a copy of this order.

9.In fine, the appeal is allowed with the above directions. There shall be no order as to costs.

03.07.2024

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P.B.BALAJI, J.

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To

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Chennai – 600 032.

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