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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **03.09.2024**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT)/25/2024
and C.M.P.No.12411 of 2024

Somalogic Operating Co., INC.
2945 Wilderness Place Boulder, Colorado
80301 United States of America ... Appellant

-vs-

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

PRAYER: Civil Miscellaneous Appeal (Patents) is filed under Section 117-A of the Indian Patents Act, 1970 (as amended by the Tribunals Reforms Act, 2021), praying the order of the Assistant Controller of Patents & Designs dated 11.01.2024 in Patent Application No.1970/CHENP/2014 be set aside and to hold that the subject

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matter of Claims 1-7 of the Patent Application No.1970/CHENP/2014 falls outside the scope of Section 3(i) of the Patents Act, 1970 and direct the Controller to grant the patent and publish the grant in the journal.

For Appellant : Ms.Vindhya S.Mani
Mr.Kiran Manokaran
for M/s.Lakshmi Kumaran and
Sridharan Attorneys

For Respondent : Mr.M.Karthikeyan, SPC

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JUDGMENT

The appellant had applied for grant of patent for a claimed invention titled "CARDIOVASCULAR RISK EVENT PREDICTION AND USES THEREOF". The first examination report was issued by the respondent on 26.02.2019. The appellant responded thereto on 25.10.2019. Pursuant to a hearing notice, oral arguments were advanced by the appellant on 31.03.2023. Thereafter, the appellant

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filed written arguments on 14.04.2023. Impugned order dated 11.01.2024 was issued thereafter.

2. Learned counsel for the appellant submits that this Court pronounced orders in *The Chinese University of Hong Kong v. Assistant Controller of Patents and Designs 2023:MHC:4616; 2023-5-LW 310 ['The Chinese University of Hong Kong – I']* on *12.10.2023*. Consequently, she submits that the said judgment was not considered while making oral submissions or in the written submissions. By referring to internal pages 5 to 17 of the impugned order, learned counsel submits that the respondent relied entirely on the judgment of this Court to conclude that the claimed invention is a diagnostic method as per Section 3(i) of the Patents Act, 1970 (the Patents Act). If provided an opportunity to deal with the judgment, learned counsel contends that the appellant would have established that the claimed invention does not *per se* disclose pathology.

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3. In response to these submissions, Mr.M.Karthikeyan, learned SPC, submits that the claimed invention relates to a method of predicting cardiovascular risk events. Consequently, it is contended that it clearly discloses pathology and qualifies as a diagnostic method as per Section 3(i) of the Patents Act.

4. The significant dates and events are not in dispute. The record discloses that oral arguments were heard on 31.03.2023 and that written submissions filed by the appellant on 14.04.2023. The earlier judgments of this Court in *The Chinese University of Hong Kong – I and The Chinese University of Hong Kong and Sequenom Inc v. Assistant Controller of Patents and Designs 2023:MHC:4617; 2023-5-LW 289* were pronounced on *12.10.2023*. The ratio of such judgments was that a claimed invention which *per se* discloses pathology would qualify as diagnostic under Section 3(i), whereas if it is merely related to diagnosis, it would not qualify as diagnostic. The impugned order discloses that the said judgment was relied upon extensively for

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concluding that the claimed invention is a diagnostic method. Since the appellant did not have the opportunity to endeavour to establish that the claimed invention does not qualify as a diagnostic method under Section 3(i), it is just and appropriate that such opportunity be provided to the appellant. For such reason, interference with the impugned order is warranted.

5. Therefore, impugned order dated 11.01.2024 is set aside and the matter is remanded for re-consideration on the following terms:

(i) In order to preclude the possibility of pre determination, such re-consideration shall be undertaken by an officer other than the officer who issued the impugned order.

(ii) After providing a reasonable opportunity to the appellant, including a personal hearing, a fresh order shall be issued within a period of ***four months*** from the date of receipt of a copy of this order.

(iii) It is made clear that no opinion is expressed herein on the merits of the application.

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6. Therefore, CMA(PT)/25/2024 is disposed of on the above terms without any order as to costs. Consequently, C.M.P.No.12411 of 2024 is closed.

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

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