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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 17.10.2023

CORAM

THE HON'BLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(PT) No.32 of 2023

(OA/5/2017/PT/CHN)

University College London,
Gower Street,
London WC1E 6BT,
Great Britain ... Appellant
Nationality : British University

Versus

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 allow the appeal and set aside the order dated 30.08.2016 passed by the respondent in Patent Application No.5924/CHENP/2008 and to grant to proceed the patent in respect thereof.

For Appellant : Mr. P.V.Balasubramaniam,
Senior Counsel
: Mr. P. Siddharth
for De Penning & De Penning

For Respondent : Mr. K. Subbu Ranga Bharathi, CGSC.
: Ms. Resmi C. Senan, Assistant Controller of Patents & Designs

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JUDGMENT

The appellant filed a PCT National Phase Application No.5924/CHENP/2008 for grant of patent to a claimed invention entitled "COLONIC DRUG DELIVERY FORMULATION".

2. Upon request for examination, the Assistant Controller of Patents & Designs (the Controller) issued the First Examination Report (FER) on 20.11.2013. In the FER, the Controller cited prior art documents D1 to D6 and stated that the appellant's claims would be obvious to a person skilled in the cited prior arts. The appellant responded to the FER on 13.11.2014 and pointed out the differences between the cited prior arts and the claimed invention. On such basis, the appellant contended that the claimed invention would not be obvious to a person skilled in the art. By hearing notice dated 13.06.2016, the Controller reiterated that the amended claims lack inventive step in view of prior art documents D1 to D6. Other objections were also raised with regard to the lack of specificity of the claims and under Section 3(e) of the Patents Act, 1970 (the Patents Act). The appellant submitted written submissions and enclosed amended claims 1 to 27. Eventually, by order dated 30.08.2016, Application No.5924/CHENP/2008 was rejected by

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citing prior art documents D1 to D6 and concluding that the claims do not satisfy the requirements of Section 2(1)(ja) of the Patents Act.

3. Learned senior counsel for the appellant, Mr.P.V. Balasubramaniam, contended that the cited prior arts do not lead to the claimed invention, whether viewed separately or in combination. In particular, he submitted that prior arts D1 to D6 dealt with the use of water insoluble polymers. He further submitted that the cited prior arts deal with the use of two coatings over the core drug, whereas the claimed invention is in respect of a single coating over the core comprising two materials. The first material being a polysaccharide material comprising amylopectin and starch with 0.1 wt % to 75 wt % amylose. As regards the second material constituting the coating, he stated that such material is a pH-dependent polymer which is formulated to function when the pH is more than 6. By using such single coating with the two materials stated above, he submitted that it becomes feasible to administer the drug in such a manner that it is received in the colon and not at any point prior thereto in the gastrointestinal tract.

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4. Learned senior counsel also provided a table to distinguish the cited prior arts from the claimed invention. By relying thereon, learned senior counsel submitted that D1 to D6 do not teach, suggest or motivate persons skilled in the art to arrive at the claimed invention comprising a single coating with the two materials referred to above. In fact, he submits that D6 teaches away from using amylopectin or starch having up to 75% of amylose. Learned senior counsel also pointed out that patent was granted for the claimed invention in multiple jurisdictions overseas and the same prior arts were cited therein.

5. In response to these contentions, it was submitted on behalf of the respondent that the use of a polysaccharide coating for delayed release of drugs into the gastrointestinal tract, including the colon, is disclosed in the prior arts. Equally, it was submitted that the use of pH-dependent material for such purpose is also not inventive. Without prejudice to these submissions, the respondent submitted that the impugned order may be set aside and the matter remanded to enable a detailed consideration of the submissions of the appellant, particularly with regard to the prior arts cited in the FER. This submission was made without making any concession on the merits of the case.

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6. Both in the reply to the FER and by way of written submissions, the appellant has provided several reasons as to why the cited prior arts do not lead to the claimed invention. The impugned order is brief. While the said order cannot be construed as unreasoned, the Controller has not engaged with the specific submissions of the appellant and provided reasons for rejecting such submissions. Especially when the same prior arts were cited in other jurisdictions and, upon consideration thereof, the claimed invention was considered inventive, cogent and sufficient reasons should have been provided to substantiate the rejection of the patent application.

7. For reasons set out above, the impugned order calls for interference and is, hereby, set aside. As a corollary, the matter is remanded for reconsideration. In order to preclude the possibility of predetermination, such reconsideration shall be made by an officer other than the officer who passed the impugned order. Upon providing reasonable opportunity to the appellant, a reasoned decision shall be issued within a period of four months from the date of receipt of a copy of this order. It is made clear that no opinion is expressed herein on the merits of the application for grant of patent.

8. (T)CMA(PT) No.32 of 2023 is disposed of on the above terms

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without any order as to costs. Consequently, the connected miscellaneous petition, if any, is also closed.

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Internet : Yes/No

Speaking/Non-Speaking Order

Neutral Citation: Yes/No

klt

To:

The Assistant Controller of Patents and Designs,
The Patent Office, IPR Building,
SIDCO Plot, GST Road,
Guindy, Chennai 600 032.

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