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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

\+ C.A.(COMM.IPD-PAT) 148/2022

EPITECH S.P.A ..... Appellant

Through: Mr. Debashish Banerjee, Mr. Ankush Verma. Mr. Pankaj Soni, Mr. Vineet Rohilla, Mr. Rohit Rangi, Mr. Tanveer Malhotra and Ms. Vaishali Joshi, Advocates.

versus

THE CONTROLLER OF PATENTS ..... Respondent

Through: Mr. Varun Mishra, Senior Panel Counsel with Mr. Aranya Sahay, Advocate.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

O R D E R

% 11.01.2024

1. The present appeal impugns order dated 10th August, 2020 ("**Impugned Order**") whereby Appellant's PCT national phase application[1] allotted application no. 6850/DELNP/2014 ("**Subject Application**") has been rejected under Section 2(1)(j) of the Patents Act, 1970 ("**Act**").

2. In the Impugned Order, the Assistant Controller of Patents and Designs ("**Controller**") takes note of objections communicated earlier on 18th June, 2018 and the observations made by the agent during the hearing and comes to the following conclusion:

*"**Controller's Remark**:*

[1] Based on PCT international application number PCT/IT2012/000050 for an invention titled "COMPOSITIONS AND METHODS FOR THE MODULATION OF SPECIFIC AMIDASES FOR N-ACYLETHANOLAMINES FOR USE IN THE THERAPY OF INFLAMMATORY DISEASES".

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The oral argument, the written hearing submission and affidavit along with the response to the First Examination Report filed by the applicant's attorney have been carefully considered.

First it is observed in data is illustrated in table 1 at page 33 and table 2 at page 35 demonstrated data respect to example 1 compound PEA-OXA. It is observed at page 11 of specification example 1 compound is 2-pentadecyl-2-oxazoline (PEA-OXA) but claimed compound is 2-pentadecyl-2-oxazole. Hence, I concluded that agent argument and data not relevant for claimed subject matter.

Therefore, in view of the aforesaid, it is concluded that the subject matter of claim 1 in this instant application lacks inventive step as defined under section 2(1)(ja) of the Patents Act, 1970. Therefore, the claimed subject does not constitute an 'Invention' as defined under section 2(l)(j) of The Patents Act, 1970 (as amended).

Without prejudice, although the hearing submissions have attempted to address the other requirements, yet the substantive requirement of the Act i.e. Sec. 2(1)(j) is not found complied with. Hence, in view of the above and unmet requirements, this instant application is not found in order for grant. Thus, in view of the aforesaid and unsatisfactory submissions made by the Agents in respect of the pertinent requirements as raised in the said hearing notice, this instant application no. 6850/DELNP/2014 does not comply with the requirements of the Act. I, therefore, hereby order that the grant of a patent is refused under the provisions of Section 15 of the Patents Act.

This is to be noted that the aforesaid observations, and decision thereof, are based solely on the electronically uploaded documents to date."

3. The only discernible reasoning is found in aforenoted second un-numbered paragraph wherein the Controller has come to the conclusion that the data furnished by Appellant was for compound PEA-OXA, which was irrelevant as the patent claims pertained to compound PEA-OXLE (2-pentadecyl-2-oxazole).

4. It is argued that this solitary reasoning is based on factually incorrect premise. The data supplied by the Appellant also dealt with the compound PEA-OXLE. The Tab- 1 furnished, is as follows:

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TAB 1

Tested compounds	*Inhibition of NAAA IC50 (after 30 min incubation)*
PEA (Palmitoylethanolamide)	*> 50.0 µm*
SEA (Stearylethanolamide)	*> 50.0 µm*
OEA (Oleoylethanolamine)	*> 50.0 µm*
MEA (Myristoyl ethanolamide)	*> 50.0 µm*
PEA-OXA (example 1 compound)	*24.2 ± 0.018µm*
SEA-OXA (example 2 compound)	*35.0±0.021µm*
MEA-OXA (example 3 compound)	*41.5±0.032µm*
OEA-OXA (example 4 compound)	*38.4±0.034µm*
PEA-OXLE (example 17 compound)	*32.1±0.031µm*
(s) -N- (2-oxo-3-oxetanyl) -3-phenylpropionamide (known example of NAAA exogenous synthetic blocker)	*0.42 µm*

5. This submission is controverted by Respondent's counsel, who argues that the data furnished by Appellant did not correspond to the claimed invention.

6. In the opinion of the Court, the minuscule reasoning in the Impugned Order is insufficient for drawing the conclusion. There is no deliberation of the contentions advanced by Appellant. Moreover, the table extracted above indicates an example (Example 17) which pertains to PEA-OXLE. This has not been noticed by Respondent in the Impugned Order. Respondent has, thus, *ex-facie*, failed to take into consideration the data in respect of compound 2-pentadecyl-2-oxazole (PEA-OXLE) - Example 17 shown in

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Tab-1 at Page 33 of specification. Respondent has apparently considered other entries enumerated in TAB-1, and ignored the data pertaining to compounds PEA- OXLE. This error, in the opinion of the Court, vitiates the Impugned Order.

7. Accordingly, the appeal is allowed with following directions:

7.1 Impugned Order is set aside.

7.2 The application is restored to its original number.

7.3 Respondent is directed to decide the matter afresh after giving hearing to Appellant while also considering the prior arts within a period three months from today.

7.4 Respondent shall obviously take into account the legal proposition applicable for considering the application as enumerated in paragraph 151 of the decision in ***F.Hoffmann-LA Roche Ltd & Anr. V. Cipla Ltd.***[2]

7.5 Assistant Controller is directed to ensure that all contentions urged by Petitioner are taken into account while deciding the application afresh.

8. Registry is directed to supply a copy of the present order to the Controller General of Patents, Designs & Trademarks of India at llc-ipo@gov.in for compliance.

9. With the above directions, the present appeal is disposed of.

10. All rights and contentions of parties are left open.

SANJEEV NARULA, J

JANUARY 11, 2024/*d.negi*

[2] RFA(OS) 92/2012; **judgment dated 27th November, 2015**

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