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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 02.02.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT) No.111 of 2023

Paratek Pharmaceuticals, Inc.
75 Park Plaza, 4th Floor Boston
MA 02116, USA
Nationality: USA ... Appellant

Vs.

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

Prayer : Civil Miscellaneous Appeals filed under Section 117-A of the Patents Act, 1970 to set aside the order dated 16.01.2018 and issued by the respondent on 19.01.2018 in Application No.8287/CHENP/2010.

For Appellant : Mr.S.Shivathanu Mohan
for M/s.Depenning and Depenning

For Respondent : Mr.P.R.Ramesh Babu

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JUDGMENT

This appeal is filed challenging an order of the respondent dated 16.01.2018, rejecting appellant's application for grant of patent dated 26.05.2009. The appellant's invention in relation to which it seeks patent relates to certain chemical compound which has therapeutic effects. The compound concerned is 'SALTS AND POLYMORPHS OF A TETRACYCLINE COMPOUND'. The compound is available prior to appellant's invention and the invention *per se* relates to making it in a stable crystalline form.

2. The respondent came out with its First Examination Report (FER) dated 15.02.2017 wherein it cited that D1 and D2 are prior inventions. The appellant responded to the same with its evidence. Three hearing notices were subsequently issued of which this court is concerned only with the third notice. The appellant participated in the hearing and has also submitted his written submissions. On considering the same, the respondent thought it fit not to grant patent and rejected it vide the impugned order. This is now under challenge.

3. Heard both sides and perused the materials available in the form of typed set

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of papers.

4. Learned counsel for the appellant submitted that in its application, the appellant had made 29 claims and in its response to the FER, it raised it to 33 claims. In the third hearing notice, the respondent has raised objections to claims 2, 23, 27 and 31 as hit by Section 10(4)(c) of the Act. The appellant had responded to the same and in its written submissions, which followed the hearing, the respondent had deleted claims 2, 23, 27 and 31. Now, the final order passed overlooks what is stated in the written submissions vis-a-vis those claims, which according to the respondent are hit by Section 10(4)(c) of the Act.

5. The order of the respondent is bad in law for the following reasons:

- The order captures D1 and D2, the two paragraphs relied on by the respondent in the FER, but does not discuss either the response given by the appellant to the FER nor the submissions, which include the written submission of the appellant during the hearing of the matter.
- While the hearing notice mentions that claim Nos.2, 23, 27 and 31 may not qualify for patent in view of lack of clarity and conciseness within the meaning of Section 10(4)(c) of the Act, the impugned order mentions

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claims 9 to 24 would fall within Section 10(4)(c).

- The present invention of the appellant has been patented by the European Patent Office. This fact has already been brought to the notice of the respondent. Indeed, the European Patent Office has considered two paragraphs which the respondent had relied on to reject the application of the appellant and chose to grant patent. In fitness of things, the respondent ought to have considered the effect of the patent granted by European Patent Office.

6. This court perused the entire typed set of papers and satisfied itself about the correctness of the statement or submissions made by the learned counsel for the appellant. The order of the respondent now under challenge is bad for two reasons:

a) that it did not discuss anything about the response of the appellant to the objections raised by the Controller; and

b) that it has chosen to deny patent under Section 10(4)(c) vis-a-vis claims 9 to 24, all of which are not made known to the appellant in the hearing notice. This appellant however, was not granted an opportunity to defend the same during hearing;

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7. For the aforesaid reasons, this court deems it appropriate to set aside the impugned order of the respondent and remands the matter back to the respondent for a *de novo* consideration. To save embarrassment to the Patent Controller who decided the matter, this court requires that some other Controller of Patent can hear the matter. Since the application is of the year 2009 and inasmuch as this is the 15th year since the date of application, it is important that such controller, who may now consider the application of the appellant for patent, dispose of the matter, as expeditiously as possible, at any rate, not later than six months from the date he or she assumes charge of the matter.

8. In fine, the appeal is allowed in the above lines. No costs.

02.02.2024

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Index: Yes/No
Speaking Order / Non-Speaking Order
Neutral Citation: Yes / No

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N. SESHASAYEE, J.

Asr

To

The Assistant Controller of Patents and Designs
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