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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 08.07.2024

CORAM:

THE HON`BLE MR.JUSTICE P.B.BALAJI

(T) CMA (PT) No.108 of 2023

BIA SEPARATIONS D.O.O.,
Teslova 30, 1000 Ljubljana,
Slovenia,
Nationality: a Slovenian Company.

.. Appellant

..Vs.

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

.. Respondent

Prayer: This appeal came to be numbered by transfer of IPAB Case OA.No.11/2018/PT/CHN from the file of the Intellectual Property Appellate Board, Chennai praying that the order dated 28.07.2017 issued by the respondent on 30.07.2017 be set aside and the Application No.185/CHENP/2009 for patent be allowed to proceed to grant.

For Appellant : Mrs.Karuna Guleria,
for M/s.De Penning & De Penning

For Respondent : Mr.P.R.Ramesh Babu,
Senior Panel Counsel

J U D G M E N T

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This Appeal has been preferred against the rejection of the Patent Application of the appellant in Patent Application No.185/CHENP/2009 dated 28.07.2017 for "*METHOD FOR INFLUENZA VIRUS PURIFICATION*".

2. I have heard Mrs.Karuna Goleria, learned Counsel for M/s.De Penning and De Penning and Mr.P.R.Ramesh Babu, learned Senior Panel Counsel for the respondent.

3. Mrs.Karuna Guleria, learned counsel for the appellant would submit that the respondent has rejected the Patent Application only on the ground of lack of inventive step under Section 2(1)(ja) of the Patents Act, 1970. She would however submit that the written submissions of the Appellant are clearly explaining the objections taken by the respondent/Controller, but the same has not been considered while passing the impugned decision. She would also submit that the prior arts, though discussed, have not been discussed in a manner distinguishing the claimed invention.

4. The learned counsel for the appellant would also bring to my notice

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that the US Patent and European Patent have been granted for the claimed invention before the respondent. It was also brought to the notice of the respondent however, the same has also not been considered. She would therefore pray for remand of the matter for fresh decision, in accordance with law.

5. Per contra, the learned counsel for the respondent would submit that the respondent has clearly held that for lack of inventive step, the appellant's Patent cannot be entertained and has rightly therefore, rejected the Application and he would therefore submit that there is no case made out for remand.

6. I have carefully considered the rival submissions advanced by the learned counsel on either side and I have perused the documents available on record.

7. Admittedly, the respondent while discussing the prior arts, has not taken into account the Patents granted by the US Patent as well as European Patent for the same invention and discussing some of the prior arts which were before the respondent/Controller. The impugned order does not

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discuss the distinguishing features of the claimed invention which has been clearly spelt out in the written submissions of the appellant. The respondent has erred in holding that the explanation given for the prior arts were misinterpreted, without stating as to how it is misinterpreted.

8. The learned Controller has also not held as to how it was obvious for a person skilled in the art to use the modified influenza virus and the conventional methods like pre-purification, concentration, ultrafiltration and subsequent purification using monolith columns as it was made a routine optimization to improve the yield. Therefore, the findings of the respondent Controller and the explanation that claims are obvious and lack inventive steps under Section 2(1)(ja) of the Patents Act, 1970 is misconceived and without proper appreciation of the written submissions placed by the Appellant.

9. In fact, the first respondent also failed to consider the auxiliary claim request for amendment which was filed alongwith written submission. Though the hearing notice was issued on 17.03.2017, a detailed response was given by the appellant vide its written submission dated 01.05.2017 which have also not been discussed at all.

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10. I therefore deem it fit to remit the matter to the respondent for fresh consideration, in accordance with law and after affording an opportunity, by way of a hearing to the Appellant, by a different Patent Controller. Such an exercise shall be completed within a period of four (4) months from the date of receipt of the copy of this judgment. No costs.

08.07.2024

Index : Yes/No
Speaking/Non-speaking order
rkp

To

Assistant Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy.

P.B.BALAJI,J.
rkp

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