WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 30.07.2024

CORAM:

THE HONOURABLE MR.JUSTICE P.B.BALAJI

CMA (PT) No.26 of 2023

Memorial Sloan Kettering Cancer Center
1275 York Avenue, New York,
NY 10065, USA.
Nationality : USA
Represented by its constituted Power of Attorney
Mr.Raghavan Ravindran Nair,
De Penning & De Penning, Having office at
No.120, Velachery Main Road, Guindy,
Chennai – 600 032. ... Appellant

Vs.

Assistant Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Rights Building,
G.S.T Road, Guindy,
Chennai – 600 032. ... Respondent

PRAYER: Appeal filed under Section 117-A of the Patents Act, 1970, praying to call for the records of the respondent culminating in the Impugned Order dated 29.07.2022 rejecting the Grant of Patent and set aside the same and consequently direct Grant of the Patent in respect of the Appellant's Application No.201747015867.

https://www.mhc.tn.gov.in/judis

WEB COPY

For Appellant : Mr.Shivathamu Mohan
for Mr.S.Ramasubramaiam & Associates

For Respondent : Mr.J.Madanagopal Rao
Senior Panel Central
Government Standing Counsel

- - - - -

JUDGMENT

The appellant, aggrieved by the rejection of its Patent Application No.201747015867 dated 29.07.2022, is before this Court by way of the above appeal.

2.The invention claimed by the appellant is a method identifying allogenic T-cell, allogenic donors for T-cell for therapeutic use. The respondent has rejected the patent application on the ground that it is a method of treatment and therapeutic use and hit by Section 3(i) of the Patents Act, 1970.

3.I have heard Mr.Shivathanumohan, learned counsel for M/s.S.Ramasubramaniam and Associates, for the appellant and Mr.J.Madanagopal Rao, learned Senior Panel Central Government Standing Counsel for the respondent.

https://www.mhc.tn.gov.in/judis

WEB COPY

4.The learned counsel for the appellant would invite my attention to the impugned order itself where after discussing the claim, the respondent has erroneously held that the appellant seeks patent for the method of treatment and therefore not patentable under Section 3(i) of Patents Act.

5.In support of his contention, the learned counsel for the appellant would place reliance on the decision of the High Court of Delhi in the case of ***Arthrogen Gmbh Vs. Controller General of Patents, Designs and Trademarks and Others*** reported in ***MANU/DEOR/26213/2024***, where the High Court of Delhi, in similar circumstances held that when the invention does not claim a "method of treatment" but rather a "method of producing" a specific substance, it would be a significant distinction which would affect its patentability. The High Court of Delhi also found that the respondent has failed to take recognize the distinction between the method of treatment and the method of producing a specific substance and which led to the erroneous application of Section 3(i) of the Patents Act to the facts of those case. The ratio laid down by the High Court of Delhi would squarely apply to the facts of the present case.

https://www.mhc.tn.gov.in/judis

WEB COPY

6.Though Mr.J.Madanagopal Rao, the learned Senior Panel Central Government Standing Counsel submitted that the order is well reasoned order and does not call for any remand, I am unable to accept the said submission of the learned counsel for the appellant.

7.The specific claim even in the original claim and as amended on 27.08.2021 states that the invention claimed was "*an in vitro method of selecting an allogenic T cell line for therapeutic administration to a human patient having or suspected of having a pathogen or cancer, comprising:*

selecting a T cell line allogenic to the patient that recognizes at least one epitope of an antigen of the pathogen or the cancer, using a representation that (i) identifies a plurality of HLA alleles and optionally HLA allele combinations, and (ii) discloses indications of relative activities of T cell lines, each recognizing at least one epitope of an antigen of the pathogen or cancer, and restricted to different ones of the HLA alleles or HLA allele combinations in the plurality; wherein in the representation each identified indication of relative activity of the T cell line restricted to the HLA allele or HLA allele combination,

https://www.mhc.tn.gov.in/judis

WEB COPY

the relative activities being relative measures of known activity against the pathogen or against the cancer exhibited by the T cell lines; wherein

(A) the T cell line selected has in common with the patient or diseased cell in the patient the HLA allele or HLA allele combination identified by the representation to which the recognition of the T cell line is restricted; and

(B) the HLA allele or HLA allele combination, to which the T cell line selected is restricted, is associated in the representation with an indication of the highest relative activity among the HLA alleles and HLA allele combinations in the representation that are known to be in common with the patient or the diseased cell in the patient and are not otherwise disqualified."

8.Thus, it can be seen that the claim comprises of identifying T-cell lines which was not the product itself, but only the process which was sought to be patented as an inventive step. Unfortunately, the respondent has failed to appreciate the actual claim of the appellant and erroneously proceeded to hold that they were seeking patent for the method of treatment alone and therefore it was not patentable under Section 3(i) of

https://www.mhc.tn.gov.in/judis

WEB COPY

Patents Act. However, considering the nature of the order being limited only to Section 3(i) on an erroneous application of the claim itself to provisions of law, the matter requires to be remitted to the respondent for fresh consideration.

9.For these above reasons, I deem it fit to remand the matter to the respondent / Assistant Controller of Patents and Designs for fresh consideration. However, the respondent shall assign the task of scrutinizing the patent application of the appellant to a different Patent Controller to avoid any embarrassment to the parties, after affording a personal hearing to the appellant and the application shall be decided, within a period of three months from the date of receipt of a copy of this order.

10.In fine, the appeal is allowed with the above directions. There shall be no order as to costs.

30.07.2024

ata

https://www.mhc.tn.gov.in/judis

WEB COPY

P.B.BALAJI, J.

ata

To

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

CMA (PT) No.26 of 2023

30.07.2024

https://www.mhc.tn.gov.in/judis