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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 27.09.2023

CORAM:

THE HON'BLE MR. **JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT).No.19 of 2023

IDORSIA PHARMACEUTICALS LTD
of Hegenheimermattweg 91,
4123 Allschwil, Switzerland,
Nationality. Switzerland,
Rep. by its Athorized Rep.
Mr. Raghavan Ravindran Nair,
De Penning and De Penning,
having office at No.120,
Velachery Main Road, Guindy,
Chennai-600032 ... Appellant

Vs.

The ASSISTANT CONTROLLER OF PATENTS AND DESIGNS
Government of India,
Patent Office,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai - 600 032. ... Respondent

PRAYER : This Civil Miscellaneous Appeal filed under Section 117-A of the Patents Act, 1970 prays to call for the records of the Respondent culminating in the impugned order dated 25.08.2021 rejecting the grant of patent and set aside the same and

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consequently direct grant of the patent in respect of the Appellant's Application No.201847022229.

For Appellant : Mr.S.Shivathanu Mohan
Ms.V.Nithyasri, for
M/s. S.Ramasubramaniam and Associates

For Respondent : Mr.M.Karthikeyan, SPC

JUDGMENT

The appellant submitted its national phase application for grant of a patent for an invention titled "N-substituted indole derivatives as PGE2 receptor modulators". Upon examining the application, the Controller of Patents issued the First Examination Report (FER) on 16.06.2020. The response thereto was filed on 16.12.2020. A hearing was conducted on 07.05.2021. Thereafter, the appellant received a telephonic call on 05.08.2021 directing the appellant to carry out further amendments to its claims by deleting the expression "pharmaceutically acceptable salts" from its claims. Eventually, by order dated 25.08.2021, the application was rejected by a terse order, the operative portion whereof is as under:

"After hearing submissions, the office has

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intimated to the agent for the applicant that claims 1-3 are not supported by the description in view of the term" pharmaceutically acceptable salts thereof.

In view of the above, the applicant failed to meet the requirements of section 10(4) of the Patents Act, 1970."

2. Learned counsel for the appellant submits that the appellant was not provided an opportunity to justify the inclusion of the above expression in its claims and that the objection was communicated after the hearing.

3. Without making any concession on the merits, Mr.M.Karthikeyan, learned SPC, submits that the matter may be remanded so as to provide an opportunity to the appellant to justify the inclusion of the said expression.

4. In the above circumstances, it is unnecessary to adjudicate the matter on merits. Without expressing any opinion on the

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merits of the matter, the order dated 25.08.2021 is set aside and the matter is remanded for reconsideration. The respondent is directed to provide a reasonable opportunity to the appellant, including for purposes of explaining the reason for the inclusion of the expression "pharmaceutical acceptable salts". After providing such opportunity, a reasoned decision shall be issued within a period of four months from the date of receipt of a copy of this order.

5. Consequently, CMA (PT) No.19 of 2023 is disposed of on the above terms. There shall be no order as to costs.

27.09.2023

Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No

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SENTHILKUMAR RAMAMOORTHY, J.

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