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(T)CMA(PT)/141/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 08.11.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

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(OA/43/2020/PT/CHN)

1. The Board of Trustees of the Leland Stanford
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Through its Authorised Representative
Mr.Prosenjit Chattopadhyay

2. Department of Veterans Affairs
Office of the General Counsel
Washington
District of Columbia-20420
United States of America
Through its Authorised Representative
Mr.Prosenjit Chattopadhyay

... Appellants



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-VS-

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

... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) filed under Section 117-A of the Patents Act, 1970, praying to the Hon'ble Court to allow the present appeal; pass an order setting aside the impugned order of the respondent dated 24th April 2020; pass an order granting a patent on Indian Patent Application No.9445/CHENP/2013 and issue consequential directions to effectuate such grant.

For Appellants : Ms.Vindhya S. Mani
for M/s.Lakshmikumaran
and Sridharan
For Respondent : Mr.S.Diwakar, CGSPC

JUDGMENT

The appellants challenge an order dated 24.04.2020 by which PCT national phase Indian Patent Application No.9445/CHENP/2013 in relation to an invention titled as “A Polynucleotide Library for sequencing, analysing and utilising single samples” was rejected.



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2. The above mentioned application was filed by the appellants on 25.11.2013. Upon examination, the First Examination Report (FER) was issued raising objections under Section 2(1)(ja), Sections 3(c), (d), (e), (i), (j) and Sub-Sections 4 & 5 of Section 10 of the Patents Act, 1970 (the Patents Act). The appellants submitted a reply thereto. By hearing notice dated 01.11.2019, most of the above mentioned objections were maintained. Pursuant to the hearing notice, the appellants filed 17 amended claims, which were considered and rejected by the impugned order.

3. Learned counsel for the appellants invited my attention to the impugned order and, in particular, the manner in which the impugned order dealt with objections 5, 7-8 in the FER. With reference to the objection in paragraph 5 of the FER, learned counsel pointed out that the complete specification contains 69 working examples. Therefore, she submitted that it was incumbent on the Controller to state specifically as to how the working examples



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provided by the appellants do not satisfy the requirements of Section 10(4) of the Patents Act. In this connection, learned counsel pointed out that Section 10(4)(b) only requires the patent applicant to disclose the best method for performing the invention, which is known to the applicant and for which the applicant claims protection.

4. Learned counsel submitted that the Controller has proceeded on the erroneous assumption that a broad claim is impermissible under the Patents Act. Turning to the objections in paragraphs 7 and 8 of the FER, learned counsel pointed out that the Controller has merely recorded conclusions that the amended claims do not meet the requirement of Section 10(5) of the Patents Act with regard to clarity and succinctness. With regard to this objection also, learned counsel submitted that it is incumbent on the Controller to state precisely with reference to specific claims as to why such claims lack clarity or succinctness. With regard to paragraph 8 of the FER, learned counsel pointed out that it is recorded therein that multiple



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independent claims must be avoided, whereas no such limitation is imposed under any of the provisions of the Patents Act. Therefore, learned counsel submitted that the impugned order calls for interference and that the matter be remanded for reconsideration.

5. In response to these contentions, Mr.S.Diwakar, learned CGSPC, referred to the conclusions of the Controller with regard to objections 5, 7 - 8. He pointed out that the Controller took into account the fact that the principal claim relates to a polynucleotide library comprising plurality of compositions. Since the claims were couched in broad terms and use expressions such as comprises, learned counsel pointed out that the Controller was impelled to conclude that these claims are very broad and that the complete specification provides meagre support for such claims. Without making any concession on the merits of the matter, learned counsel submits that the application may be remanded for reconsideration.



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6. In the impugned order, the Controller has recorded, in relevant part, the following conclusions:

“The claims on record are very broad and provide extensive list of permutation combinations, however the complete specification provides support for a meagre handful. Thereby as the claims offer numerous possible permutations and combinations which may or may not show the intended results as they are not amply disclosed or supported as required u/s 10(4) and 10(5) of Patents Act 1970.

.... The instant claims thereby appears to be mere speculative in the absence of ample data and support over the wide spectrum of claimed subject matter. The claims also appear to be 'reach-through' as they attempt to obtain protection for a polynucleotide library components by defining its functionally in terms of its action on a biological target and may cover many undiscovered libraries. The claims must be comprehensible and include all essential features which are necessary to obtain the desired effect. The instant claims include within their scope subject-matter which, in the light of the disclosure in the description lack clarity, support and adequate



disclosure. The present claims 1-17 refer to polynucleotide library comprising a plurality of compositions wherein the library comprises cDNAs encoding immunoglobulin heavy and light chain variable regions from the same clonal family, without giving any technical pointer to the nature of these libraries. These expressions open a wide range of possible molecules that fall within the scope of this vague and broad definition. Thereby claims fail u/s 10(4) and 10(5) of Patents Act 1970."

7. From the above extracts, it follows that the Controller rejected the application on the ground that the claims are broad and that they provide for what the Controller labels as an "extensive list of permutation combinations". As regards sufficiency of disclosure for purposes of Section 10(4) or (5) of the Patents Act, it is necessary that the Controller should state the objection with regard to insufficiency of disclosure with sufficient specificity to enable the patent applicant to effectively address such objections. Put differently, it will not suffice to merely state that the claims are broad or that the support provided for the claims are meagre. In the



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factual context of this case, it would be necessary for the Controller to examine the amended claims in the context of the complete specification, including the 69 working examples provided by the applicant, and then point out as to which claim is unsupported or insufficiently supported. Since the impugned order does not contain such specificity, it calls for interference.

8. For reasons set out above, the impugned order dated 24.04.2020 is set aside and the matter is remanded for reconsideration on the following terms:

(i) In order to preclude the possibility of pre-determination, such reconsideration shall be undertaken by an officer other than the officer who issued the impugned order;

(ii) Upon providing a reasonable opportunity to the appellants, a reasoned decision shall be issued upon such reconsideration within a period of four months from the date of receipt of a copy of this order; and



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(iii) It is made clear that no opinion is being expressed herein
on the merits of the case.

9. Therefore, (T)CMA(PT)/141/2023 is disposed of on the
above terms, without any order as to costs.

08.11.2023

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