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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 14.03.2022

CORAM:

THE HONOURABLE DR.JUSTICE ANITA SUMANTH

W.P.No.22253 of 2021
&W.M.P.No.23629 of 2021

PNB Vesper Life Science Pvt. Ltd,
Represented by its Director
Mr.P.N.Balaram
5th Floor, Amritha Towers,
KPCC JN, M.G.Road,
Kochi,
Kerala - 682 011.

... Petitioner

Vs.

The Controller General of Patents, Designs & Trademarks
The Patent Office,
Intellectual Property Rights Building,
G.S.T.Road, Guindy,
Chennai - 600 032.

... Respondent

PRAYER:- Writ Petition filed under Article 226 of the Constitution of India, praying for the issuance of a Writ of Certiorarified Mandamus, calling for the records of Respondent relating to the impugned order dated 10.04.2018 holding that the petitioners Patent Application No.Poc/P11B/No.1994/CHE/2011 was deemed to be abandoned, and quash the same and direct the respondent to reinstate the petitioners' Patent Application poc/P11-B., No.1994/CHE/2011.

For Petitioner : Mr.Satish Parasaran
for Anand shankar
Senior Counsel

For Respondent : Mr.Rabu Manohar
Government Standing Counsel

O R D E R

The petitioner is a Research-based Bio-Pharmaceutical Organization, incorporated under the Companies Act, 1956 in the year 2011, involved in the business of development of drugs for treatment of serious diseases. The petitioner company holds pharmaceutical patents in various jurisdictions all over the world such as USA, UK, China, Japan, Russia, Thailand, Singapore, Israel, Eurasia, Brazil and Mexico among others.



2. The Petitioner states that its Patent Application bearing No.1994/CHE/2011, titled 'Novel Cholecystokini, Receptor Ligands' was filed by the petitioner on 13.06.2011 before the Patent Office at Chennai. The said patent relates to a novel class of Drugs namely 'novel 5-hydroxy-5-aryl-pyrrol-2-ones' for the preparation of Cholecystokinin Receptor Ligands and Cholecystokinin Antagonist and for medical applications in the treatment of various diseases including colon cancer.

3. The Petitioner states that subsequent to filing the application in India, the petitioner had moved on to the international phase, filing PCT application bearing No.PCT/IN2012/000469 in 2012. Subsequent to the filing of the aforesaid PCT Application, the petitioner entered into the national phase of the patent application in different countries and successfully sought and was granted patent in various jurisdictions as below:-

S.No	Application No.	Country	Status
1.	US8921577B2	US	GRANTED
2.	CN104411683B	CHINA	GRANTED
3.	BR112015000012A2	BRAZIL	GRANTED
4.	EP2867205B1	EUROPEAN UNION	GRANTED
5.	EA027136B1	EURASIA	GRANTED
6.	JP6162799B2	JAPAN	GRANTED
7.	IL236473A	ISRAEL	GRANTED
8.	SG1120140869IXA	SINGAPORE	GRANTED

4. The drug has successfully completed phases I & II of the clinical trials and has obtained approval from the Drug Controller General of India for conducting Phase III clinical trials in India for treating COVID-19 hospitalized patients.

5. The application was thus pending before the respondent, Controller General of Patents, Designs & Trademarks, Chennai and as there was no reply to the communications filed by the petitioner to the agent enquiring about the status of the same, the petitioner enquired with the respondent directly, coming to know that the application had been closed as 'abandoned' by order dated 10.04.2018.

6. Hence the present writ petition, challenging impugned order dated 10.04.2018 treating the petitioner's patent application as abandoned. The reasons assigned are that the petitioner has failed to respond to the First Examination Report (FER) received. Heard Mr.SatishParasaran, learned standing counsel for the petitioner and Mr.Rabu Manohar, learned counsel for the respondent herein.



7. The petitioner would admit to the position that there has been a violation of the time lines set out under the statute for responding to the FER. Attention in this regard is drawn to the provisions of Rule 24B entitled Examination of Application falling under Chapter IV of the Publication & Examination of Applications under the Patents Rule, 2003 (Rules) that reads as follows:-

"24B. Examination of application.-(1)

(i) A request for examination under section 11B shall be made in Form 18 within forty-eight months from the date of priority of the application or from the date of filing of the application, whichever is earlier;

(ii) The period within which the request for examination under sub-section (3) of section 11B to be made shall be forty-eight months from the date of priority if applicable, or forty-eight months from the date of filing of the application;

(iii) The request for examination under sub-section (4) of section 11B shall be made within forty-eight months from the date of priority or from the date of filing of the application, or within six months from the date of revocation of the secrecy direction, whichever is later;

(iv) The request for examination of application as filed according to the 'Explanation' under sub-section (3) of section 16 shall be made within forty-eight months from the date of filing of the application or from the date of priority of the first mentioned application or within six months from the date of filing of the further application, whichever is later;

(v) The period for making request for examination under section 11B, of the applications filed before the 1st day of January, 2005 shall be the period specified under the section 11B before the commencement of the Patents (Amendment) Act, 2005 or the period specified under these rules, whichever expires later. (2) (i) Where the request for examination has been filed under sub-rule (1) and application has been published under section 11A, the Controller shall refer the application, specification and other documents related thereto to the examiner and such reference shall be made in the order in which the request is filed:



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Provided that in case of a further application filed under section 16, the order of reference of such further application shall be the same as that of the first mentioned application: Provided further that in case the first mentioned application has already been referred for examination, the further application shall have to be accompanied by a request for examination, and such further application shall be published within one month and be referred to the examiner within one month from the date of such publication. (ii) The period within which the examiner shall make the report under sub-section (2) of section 12, shall ordinarily be one month but not exceeding three months from the date of reference of the application to him by the Controller; (iii) the period within which the Controller shall dispose off the report of the examiner shall ordinarily be one month from the date of the receipt of the such report by the Controller. (3) A first statement of objections, along with any documents as may be required, shall be issued by the Controller to the applicant or his authorised agent within one month from the date of disposal of the report of examiner by the Controller: Provided that where the request for examination was filed by a person interested, only an intimation of such examination may be sent to such person interested. (4) Reply to the first statement of objections and subsequent reply, if any, shall be processed in the order in which such reply is received. (5) The time for putting an application in order for grant under section 21 shall be six months from the date on which the first statement of objections is issued to the applicant to comply with the requirements. (6) The time for putting an application in order for grant under section 21 as prescribed under sub-rule (5) may be further extended for a period of three months on a request in Form 4 for extension of time along with prescribed fee, made to the Controller before expiry of the period specified under sub-rule (5)."

8. A FER is to be issued by the Controller to the patent applicant or authorized agent within a period of one month from the date of Examination of Report. In the present case it appears that the FER has been issued to the patent agent, seeing as the address for communication in the patent application was that of the agent.



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9. There is admittedly a grey area concerning facts at this juncture. While the petitioner claims to have been dependent upon the patent agent for communication with the patent office, the Agent has for his part, responded to the emails sent by the petitioner indicating that his services had been dispensed with, the petitioner agreeing to pursue the application on its own.

10. Mr.Rabu Manohar, learned counsel for the respondent, confirms, upon verification of the delivery report of the IT division of the patent office, that the e-mails of the patent office communicating the FER, have been delivered on 04.10.2018 itself. The record of delivery states 'sent successfully'. It is thus unclear as to who was at fault for the inaction, whether the petitioner or the agent.

11. Be that as it may, bearing in mind the purpose for which the application is being pursued as well as the fact that the petitioner had applied for and had been granted the patent for the identical product in other jurisdictions, it does not stand to reason that a company engaged in Pharma research and for whom commercially expediency is paramount, will not pursue the applications in right earnest.

12. Nothing would indicate why the petitioner would willfully neglect to respond to an objection received from the patent office. Thus, the benefit of doubt in such circumstances must be given to the petitioner and I proceed on this basis. Enough said on this.

13. I now come to the merits of the matter. The legal position that obtains is that with the amendment of Rule 138 on 16.05.2016, in terms of which power was granted to extend the limitation in various situations, the power that vested in the respondent/authority to condone delay in objecting to an FER, stands obliterated.

14. Thus no fault can be attributed to the respondent/authority in passing the impugned order stating that the delay in objecting to the FER is not liable to be condoned. Be that as it may, this Court under Article 226 of the Constitution of India, can certainly consider situations causing delay and, if convinced, direct the authority to take on board the application and consider the same on merits.

15. In light of the narration of facts in the preceding paragraphs, I believe that this is an appropriate case for exercise of such discretion. Support is forthcoming in the form of two decisions, one of the Madras High Court in NTT DoCoMO Inc. Vs. The Assistant Controller of Patents and Designs and Ors. (2014 SCC Online MAD 789: (2014) 4 MAD LJ 168) and the



other the Calcutta High Court in the case of Rubicon Research Pvt. Ltd .Vs. The Assistant Controller of Patents and Designs Trademarks and Anr., (OA/18/2014/PT/KOL dated 21.08.2020).

16. Learned Single Judge of this Court was concerned with a clerical mistake, wherein the patent agent had given up a valuable patent which the applicant intended to pursue, instead retaining the pursuit for a patent in which the applicant had no interest. After looking into the facts and circumstances, this Court held that the error was clearly clerical and attributable to the patent agent and that the applicant must not suffer in such circumstances.

17. In the case of Rubicon Research (supra) the Intellectual Property Appellate Board ('Board') considered a situation where the opportunity of hearing extended to the applicant, in their view, was insufficient. Ultimately, it was held that there should be a revisiting of the matter by the authority, in line with the principles of natural justice.

18. The Board had considered a factual matrix similar to the matter before me. In that case as well, there appeared to be a breakdown of the in-built mechanism for consideration of a patent application. The Board considers the fate of an application where the solicitor engaged had failed to carry out his duties in a proper manner, at great prejudice to the applicant. In such circumstances, the Board held that the dereliction of duty by a solicitor appointed by the party must not stand in the way of the patent application being considered in proper perspective.

19. The Bombay High Court in Universidad Politecnica De Valecia and Ors. Vs. Union of India and Ors. (W.P.No.1435 of 2007 dated 26.02.2010), also had occasion to consider the violation of principles of natural justice, restoring the matter to the file of the concerned Authority to be heard afresh.

20. I clarify at this juncture, that no fault is being attributed to either the patent agent/the petitioner or the respondent and my decision turns upon the nature of the patent being sought as well as the factual circumstances that commend themselves to me.

21. In light of the discussion as aforesaid, the application stands restored to the file of the respondent. Learned Senior counsel confirms, based upon instructions from the learned Counsel on record, that the petitioner has received the First Examination Report and is fully prepared to respond to the same, within any time frame fixed by this Court and this Court fixes a time frame of two weeks from today for the purpose.



22. Let the petitioner be heard by the respondent who shall consider the application, follow due procedures as laid down under the applicable Rules, Act and pass orders thereupon, within a period of four weeks from the date of personal hearing afforded to the petitioner. This writ petition stands disposed with the above observations. Connected writ miscellaneous petition is closed, with no order as to costs.

Sd/-

Assistant Registrar(CS V)

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Sub Assistant Registrar

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To

The Controller General of Patents, Designs & Trademarks
The Patent Office,
Intellectual Property Rights Building,
G.S.T.Road, Guindy,
Chennai - 600 032.

+1cc to Mr.Rabu Manohar, Advocate, S.R.No.17082

+1cc to M/s.Ganesh Raj, Advocate, S.R.No.17675

W.P.No.22253 of 2021 &
W.M.P.No.23629 of 2021

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