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WP(IPD)/24/2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 12.12.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

W.P.(IPD)/24/2023
and WMP(IPD)/6/2023

Optimus Drugs Private Limited,
A company registered under the Companies Act 2013,
Represented by its Authorised Signatory,
Mr.Sridhar Prasangi, having its
Registered Office at Signature Towers,
Sy.No.37/ A & 37/P,
Plot No.6, 2nd, Kothaguda,
Hyderabad, Telangana 500 084.

... Petitioner

-VS-

1.Union of India, through the Secretary,
Department for Promotion of Industry
and Internal Trade,
Ministry of Commerce and Industry,
having its Office at Udyog Bhavan,
New Delhi-110 001.

2.The Controller of Patents and Designs,
Government of India, Patent Office,
Intellectual Property Building,
G.S.T.Road, Guindy,
Chennai-600 032, Tamil Nadu.



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3.The Joint Controller of Patents and Designs,
On behalf of the subordinate Officers,
Government of India, Patent Office,
Intellectual Property Building,
G.S.T.Road, Guindy,
Chennai-600 032, Tamil Nadu.

4.Symed Labs Limited, a company
registered under the Companies Act, 2013,
carrying on business at #8-2-293/174/3,
Beside BN Reddy Colony,
Road No.14, Banjara Hills,
Hyderabad-500 034, Telangana.

... Respondents

PRAYER: Writ Petition (IPD) filed under Article 226 of the Constitution of India, pleased to issue a Writ of Certiorarified Mandamus calling for the records of the 3rd respondent that culminated in the hearing notice dated August 9, 2023, bearing No. POC/ Post Grant-Oppn./201641013830/C2120 in the post grant opposition proceedings against Patent No.281489 and quash the same and consequently, direct the respondents 2 & 3 to take steps to have Form 13 dated 29.10.2020 disposed off by the competent official, with due intimation to the petitioner and direct the respondents 2 & 3 to constitute a fresh Opposition Board to give fresh recommendation in the post grant opposition proceedings against Patent No. 281489 after disposal of the Form 13 dated 29.10.2020, with copies to the petitioner, considering all evidence on



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record.

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For Petitioner : Mr.P.V.Balasubramaniam, Sr. Counsel

For R1 to R3 : Mr.J.Madanagopal Rao, SPC

For R4 : Ms.S.Suba Shiny

ORDER

Background

The petitioner challenges the hearing notice dated 09.08.2023 and also seeks a direction for the constitution of a fresh Opposition Board to give fresh recommendations in the post grant opposition proceedings relating to Patent No.281489.

2. The petitioner filed an application in April 2016 for the grant of patent to an invention entitled "An improved process for the preparation of Linezolid". The patent was granted on 20.03.2017 under Patent No.281489. On 05.03.2018, the 4th respondent herein, which is a competitor of the petitioner, filed post grant opposition to the patent. Along with the post grant opposition, evidence was adduced by the 4th respondent. While filing the reply statement to the



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opposition, the petitioner did not submit evidence. However, the 4th respondent submitted additional evidence along with the rejoinder to the reply in August 2018. On 17.05.2019, the Opposition Board constituted by the Controller of Patents submitted its recommendations.

3. Thereafter, on 17.06.2020, the petitioner filed the expert affidavit of Dr.S.K.Mitra as further evidence. Such further evidence was rejected. In those circumstances, W.P.No.70559 of 2020 was filed by the petitioner. While the said writ petition was pending, the Controller of Patents issued a communication on 15.10.2020 permitting the filing of additional evidence. In those circumstances, the writ petition was closed and the petitioner refiled the evidence of Dr.S.K.Mitra on 12.11.2020. In response thereto, the 4th respondent filed further evidence on 04.03.2021. On 03.02.2023, the petitioner filed a request for amendment of claims and the same was notified in the Patent Office Journal on 11.07.2023. The impugned hearing notice dated 09.08.2023 was issued thereafter. The present writ petition is



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filed in the above facts and circumstances.

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Contentions of counsel

4. Learned senior counsel for the petitioner submitted that the petitioner did not file evidence along with the reply statement to the opposition. Therefore, he submits that the 4th respondent was not entitled to file additional evidence along with its rejoinder as per Rule 59 of the Patents Rules, 2003 (the Patents Rules). He further submits that both parties filed evidence subsequent to the receipt of the recommendation of the Opposition Board. In these circumstances, learned senior counsel contends that the Opposition Board is under an obligation to consider the additional evidence and issue fresh recommendations. Instead, by drawing reference to both the hearing notice dated 11.07.2023 and the impugned hearing notice dated 09.08.2023, he submits that the recommendation of the Opposition Board was not enclosed therewith and that the Patent Office merely stated that the earlier recommendations are being maintained. Therefore, learned senior counsel submits that the Opposition Board



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is liable to be reconstituted and called upon to issue fresh recommendations after considering the complete evidence on record.

He further submits that the amended claims should also be placed before such Opposition Board.

5. In response to these contentions, learned counsel for the 4th respondent submits that the Opposition Board is required to examine the evidence submitted under Rules 57 to 60, but not any evidence submitted subsequent to the date of fixation of the hearing. In this connection, she referred to the proviso to Rule 60 which stipulates that leave may be granted for the production of further evidence under Rule 60 provided such leave is requested for before the Controller fixes the hearing under Rule 62. As regards Rule 62, with reference to sub-rule (4) thereof, learned counsel submits that the said sub-rule permits either party to rely on publications by giving notice as prescribed in the said sub-rule. Other than publications, she submits that no other evidence may be relied on as per Rule 62.



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6. Turning to the facts of this case, learned counsel submits that the intention of the petitioner is to scuttle the opposition proceedings in view of the recommendations issued by the Opposition Board. By referring to such recommendations, learned counsel points out that the Opposition Board concluded that the patent is liable to be revoked on the ground of obviousness. Learned counsel also relied upon a judgment of the Delhi High Court in *Willowood Chemicals Private Limited v. Assistant Controller of Patents and Designs and another*, W.P.(c)No.12105/2019, order dated 17.03.2023, in support of the contention that the legal framework of the Patents Act and rules framed thereunder do not permit parties to challenge the recommendations of the Opposition Board because the Controller is not bound by such recommendations. For the same principle, learned counsel also relied upon the judgment of the Delhi High Court in *Novo Nordisk AS v. Union of India and others*, 2022 (92) PTC 315[Del].

Discussion, analysis and conclusions

7. The admitted position is that the recommendations of the



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Opposition Board were issued on 17.05.2019. From the sequence of dates and events, it is clear that the petitioner was permitted to file the affidavit of Dr.S.K.Mitra as evidence on 12.11.2020. In response thereto, the 4th respondent filed an affidavit by way of evidence on 04.03.2021. In effect, both parties were permitted to and submitted evidence subsequent to the issuance of the recommendations of the Opposition Board. As contended by learned counsel for the 4th respondent, the Patents Rules envisage that evidence submitted under Rules 57 to 60 would be placed before the Opposition Board. On the facts of this case, however, pursuant to the writ petition filed by the petitioner before this Court earlier, the Controller agreed to receive further evidence and such evidence was not by way of publications. Sub-rule (5) of Rule 62 directs the Controller to decide the opposition after taking into consideration the recommendations of the Opposition Board.

8. In light of these developments, which are subsequent to the earlier recommendations of the Opposition Board, it would be



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meaningless for the Controller to take a decision based on the recommendations issued by the Opposition Board in May 2019, and natural justice clearly requires that the additional evidence placed on record by both parties should be considered by the Opposition Board.

9. What remains to be considered is whether the same Opposition Board which undertook this exercise earlier may be called upon to issue fresh recommendations or whether the Opposition Board should be reconstituted for this purpose. Learned senior counsel for the petitioner relied on a decision of the Intellectual Property Appellate Board in *Sugen Inc. and another v. Controller General of Patents, Design, Trademark and Geographical Indications, Patent Office and another*, 2013 SCC OnLine IPAB 76 to contend that the Opposition Board should be reconstituted. Upon considering the evidence on record at that point of time, which consisted largely of the further evidence filed by the 4th respondent by way of Exs.R1 to R6, the Opposition Board recommended revocation of the patent. Additional evidence has been placed on



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record by both parties subsequently. Moreover, the petitioner has voluntarily submitted amended claims which have been published.

By taking into consideration all these facts and circumstances, in order to preclude the possibility of confirmation bias, I am of the view that the Opposition Board should be reconstituted.

10. Learned counsel for the 4th respondent also contended that the two writ petitions filed by the petitioner were aimed at scuttling the opposition proceedings or, at least, protracting such proceedings. This contention cannot be disregarded. Therefore, it is necessary that the opposition proceedings are proceeded with on an expedited basis.

11. For reasons set out above, WP(IPD)/24/2023 is disposed of without any order as to costs, on the following terms:

(i) The 2nd respondent is directed to constitute a fresh Opposition Board comprising officers other than the officers who formed the previous Opposition Board. The fresh Opposition Board



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shall be constituted within a maximum period of 30 days from the date of receipt of a copy of this order.

(ii) The newly constituted Opposition Board shall examine the entire evidence and the amended claims of the petitioner and provide its recommendations within a maximum period of two months from the date of constitution of such board.

(iii) Upon receipt of such recommendations, the 2nd respondent is directed to fix and conclude the hearing in the opposition proceedings as expeditiously as possible. Consequently, connected Miscellaneous Petition is closed.

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Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes / No

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