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(T) CMA (PT) No.170 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 26.11.2024

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THE HONOURABLE MR. JUSTICE ABDUL QUDDHOSE

(T) CMA (PT) No.170 of 2023

The Research Foundation for the
State University of New York
(through its constituted power of attorney
holder Mr.Tanmay Joshi)
of Albany, New York 12201-0009,
United States of America.

.. Appellant

Vs.

The Controller of Patents,
The Patent Office,
Boudhik Sampada Bhawan,
G.S.T. Road, Guindy,
Chennai - 600 032.

..Respondent

Transferred Civil Miscellaneous Appeal Patents Act filed
Section 117-A of the Patent Act, 1970, against the order communicated by
the respondent to the appellant on 19.09.2019 with respect to subject
application 5455/CHENP/2008 and direct the respondent to grant a patent
on the subject application.



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For Appellant : Mr. Debashish Banerjee
for M/s. Remfry and Sagar

For Respondent : Mr. J. Madanagopal Rao
Senior Panel Counsel

JUDGMENT

This appeal has been filed challenging the order dated 19.09.2019 passed by the respondent rejecting the appellant's patent application as well as the amendment application filed under Section 59(1) of the Patents Act on the ground that the application filed by the appellant has not been filed within the prescribed time limit under Rules 20(3)(a) and 20(4)(i) of the Patent Rules.

2. The appellant has challenged the impugned order on the following grounds:

The respondent has erroneously rejected the amended claims filed under Form-13 dated 12.09.2019 by total non-application of mind by holding that the amended claims filed *vide* Form-13 dated 12.09.2019 is beyond the scope of the original claims. According to the appellant, the original dependent claims 11 and 16 as well as the complete specification



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submitted by the appellant before the respondent clearly disclosed the composition that has been claimed in the amended independent claim 1.

According to the appellant, the respondent, under the impugned order, miserably failed to appreciate the amendments carried out by the appellant to the original claims and has erroneously rejected the appellant's application filed under Section 59 of the Patents Act. According to the appellant, as seen from the amended claims filed by the appellant under Sections 57 to 59 of the Patents Act, the amendment is legally permissible since the dependent claims 11 and 16 fully disclosed the composition, which satisfies the requirement of Section 59 of the Patents Act. Learned counsel for appellant also placed on record the comparison chart between the original claims, amended claims and claim support. The details of the same are hereunder:

Original Claims	Amended Claims	Claim Support
<u><i>Claim 11</i></u> The method according to claim 1, wherein the purified collagenase comprised of collagenase I and collagenase II.	<u><i>Claim 1</i></u> A composition comprising a purified collagenase I and II derived from Clostridium histolyticum in a mass	<u><i>Page 6 lines 19 -23</i></u> A preferred collagenase composition mixture of collagenase I and collagenase II in a mass ratio of about 1 to 1 and having specific activity



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Original Claims	Amended Claims	Claim Support
<u>Claim 16</u> The method according to claim 1, wherein the purified collagenase is injected in a dose comprising from about 500 SRC units/mg to about 15,000 SRC units/mg, applied in one or more injections.	ratio of 1 to 1 and 1 pharmaceutically acceptable liquid carrier for treating cellulite, wherein the collagenase I and II has a specific activity selected from the group consisting of at least about 500 SRC units/mg, at least about 700 SRC units/mg, at least about 1000 SRC units/mg, and at least 1500 SRC units/mg, wherein the said composition is injected to the collagenous septa network of cellulite in one or more injections.	from about 500 SRC units/mg to about 15,000 SRC/mg, preferably of at least about 700 SRC units/mg, more preferably of at least about 1000 SRC units/mg, even more preferably at least about 1500 SRC units/mg.

3. Relying upon the aforestated comparison chart, learned counsel for appellant would submit that the amendment filed by the appellant merely constitutes incorporation of actual facts, which were clearly disclosed in the original claims as well as in the complete specification. According to him, the original claims 11 and 16 when read in conjunction with the complete specification will clearly disclose the



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composition claimed in the amended claims. Therefore, according to him, the amendment submitted by the appellant will not fall outside the purview of the permissible amendments as stipulated under Section 59 of the Patents Act. According to him, by total non-application of mind to the aforesaid facts, the respondent, under the impugned order, has erroneously rejected the claim amendments sought for by the appellant under Section 57 of the Patents Act.

4. Learned counsel for appellant, by referring to the impugned order, would submit that the respondent has erroneously and by total non-application of mind, has held that the National Phase Application submitted by the appellant does not fulfil the criteria as per Rules 20(3)(a) and 20(4)(1) of the Patent Rules with respect to the time limit for applying National Phase Application. According to him, by total non-application of mind, the respondent, under the impugned order, has erroneously held that the filing date of the application was 10.10.2008 and has erroneously held that the application has been filed beyond the prescribed time period of 31 months from the earliest priority date.



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5. Learned counsel for appellant would submit that due to the circumstances beyond the control of the appellant, the application was received at the Chennai patent office 18 days later than the expected date because of the postal delay. According to him, since the delay occurred within a month of 22 September, 2008, deadline, it was deemed condonable in accordance with the then prevailing Rule 138 and Rule 6(1) of the Patents Rules, 2003.

6. Referring to Rule 138 of the Patent Rules, as it stood at the time of filing the subject application by the appellant, learned counsel for appellant would submit that the respondent has the power to condone the delay up to a period of one month. Therefore, according to him, the Patent Rules, as they stood at the time of filing of the patent application by the appellant clearly permit the respondent to condone the postal delay of 18 days. Learned counsel also drew the attention of this Court to Rule 6(1) of the Patent Rules, as it stood at the time when the subject application was filed by the appellant before the patent office. Relying upon the said Rule, learned counsel for appellant would submit that the respondent is



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empowered to condone the postal delay. According to him, the respondent failed to exercise the discretion vested in it properly in terms of Rule 138 and Rule 6(1) of the Patent Rules as referred to supra and if the said discretion was exercised properly, learned counsel would submit that the respondent ought to have condoned the delay, which is permissible under law. According to him, in view of the impugned order, the appellant's valuable rights of seeking patent has been extinguished.

7. Learned counsel for the appellant also drew the attention of this Court to a decision rendered by a learned Single Judge of this Court in the case of *Nokia Corporation vs. Controller of Patents & Designs [2011 (46) PTC 70 (Mad)]*. According to the learned counsel, in an identical matter almost involving identical facts, this Court had set aside a similar impugned order and remanded the matter back to respondent for fresh consideration. Learned counsel for appellant would submit that the appellant should not be penalised when they never had the intention to abandon their patent application.



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8. On the other hand, learned Standing Counsel appearing for the respondent reiterated the contents of the impugned order and submitted that only in accordance with Rule 20(3)(a) and Rule 20(4)(i) of the Patent Rules, the respondent had refused to accept the application submitted by the appellant for grant of patent as the said application has been filed beyond the statutory period.

Discussion:

9. Admittedly, the contentions raised by the appellant before this Court have not been considered in the impugned order. Before this Court, the appellant has placed on record the comparison chart between the original claims, amended claims and claims support. However, under the impugned order, the respondent has not considered the same. The appellant has categorically contended before this Court that the respondent has failed to appreciate that the amendments carried out in the claims are statutorily permissible under Section 59 of the Patents Act as seen from the comparison chart placed before this Court. A categorical assertion has been made by the appellant that the amendment merely constitutes incorporation of actual



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facts, which was clearly disclosed in the original claims as well as in the complete specification. According to the appellant, the original claims 11 and 16 when read in the light of the complete specification will clearly disclose the composition claimed in the amended claims. Therefore, according to them, the said amendment does not fall outside the purview of the permissible amendments under Section 59 of the Patents Act.

10. The Honourable Supreme Court has consistently held in its various decisions including the decision in *State of Punjab v. Shamlal Murari [AIR 1976 SC 1177]* that "procedural law is not to be a tyrant but a servant, not an obstruction but an aid to justice. It has been wisely observed that procedural prescriptions are the hand-maid and not the mistress, a lubricant, not a resistant in the administration of justice". The ratio laid down by the Hon'ble Supreme Court has to be necessarily applied to the case of the appellant herein.



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11. Rule 138 of the Patents Rules, as it stood at the time of

filing the application by the appellant, reads as follows:

"Rule 138. Power to extend time prescribed.-

(1) Save as otherwise provided [in the rules 24B, sub-rule (4) of rule 55 and sub-rule (1A) of rule 80], the time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct."

12. Rule 138 of the Patent Rules empowers the respondent to condone any delay up to a maximum of one month. In the instant case, even according to the respondent, as seen from the impugned order, the delay on the part of the appellant in filing the application is just 18 days. Despite availability of Rule 138 of the Patent Rules, as it stood at the time of filing the application by the appellant, the respondent under the impugned order has refused to exercise its discretion properly considering the contentions of the appellant as to the reasons for the delay and by total non-application of mind, has rejected the appellant's application erroneously on the ground of delay.



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13. Rule 6(1) of the Patent Rules, as it stood when the subject application was filed by the appellant before the patent office, also allow for postal delays to be condoned. The said rule as applicable at the time of filing of the application by the appellant is extracted hereunder:

"Leaving and serving documents.- (1) Any application, notice or other document authorized or required to be filed, left, made or given at the patent office, or to the Controller or to any other person under the Act or these rules, may be tendered by hand or sent by a letter addressed to the Controller at the appropriate office or to that person through post or registered post or speed post or courier service or by electronic transmission duly authenticated. If it is sent by post or registered post or speed post or courier service or by electronic transmission duly authenticated, it shall be deemed to have been filed, left, made or given at the time when the mail containing the same would have been delivered in the ordinary course of post or registered post or speed post or courier service, or by electronic transmission duly authenticated, as the case may be. In proving such sending, it shall be sufficient to show that the mail was properly addressed and transmitted."

14. Neither Rule 138 of the Patent Rules nor Rule 6(1) of the Patent Rules, as it stood at the time of filing of the subject application by the appellant, has been considered under the impugned order. The appellant's valuable right of obtaining patent for their claimed invention has been totally extinguished by passing of the impugned order. Since several contentions have been raised in this appeal to show that their applications



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have been filed on time and that they have satisfied the requirements of

Section 59 of the Patents Act, necessarily, this Court is of the considered view that by total non-application of mind to Rule 138 and Rule 6(1) of the Patent Rules, as applicable on the date of filing of the applications by the appellant before the patent office, the respondent, under the impugned order, has rejected the appellant's application by relying upon Rule 20(3)(a) and 20(4)(1) of the Patent Rules. As per the said rules, *viz.*, Rule 20(3)(a) and 20(4)(1) of the Patent Rules, which the respondent has relied upon, makes it clear that the National Phase Application submitted by the appellant has to be filed within a period of 31 months from the earliest priority date. However, the respondent failed to appreciate that as per Rule 138 of the Patent Rules and Rule 6(1) of the Patent Rules, as it stood at the time of filing of the applications by the appellant, the respondent was empowered to condone the delay upto a maximum period of one month by exercising its discretion. However, the respondent has failed to take note of the said contention of the appellant in the impugned order. Since the rights of the appellant has been extinguished under the impugned order, this Court, after giving due consideration to the aforementioned facts and on account of the



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fact that the impugned order is a non-speaking order with regard to Rule 138 of the Patent Rules and Rule 6(1) of the Patent Rules, as it stood at the time of appellant filing the said applications, the impugned order has to be quashed and the matter has to be remanded back to the respondent for fresh consideration after giving due consideration to Rule 138 of the Patent Rules and Rule 6(1) of the Patent Rules, as it stood at the time of filing of the applications by the appellant before the respondent.

15. Accordingly, the impugned order dated 19.09.2019 passed by the respondent is hereby quashed and the respondent is directed to consider the applications submitted by the appellant under Sections 57 to 59 of the Patents Act afresh on merits and in accordance with law after giving due consideration to the observations recorded by this Court in this order and in the light of Rule 138 and Rule 6(1) of the Patent Rules, as it stood at the time of filing of the application by the appellant before the respondent. The respondent is directed to pass final orders within a period of three (3) months from the date of receipt of a copy of this order. In the interest of justice and to avoid a pre-determination, this Court directs the respondent to



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ABDUL QUDDHOSE, J

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appoint a different Controller than the one, who had passed the impugned order.

In the result, this appeal is allowed. No costs.

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Neutral Citation: Yes/No

Index: yes/no

Speaking Order/Non-Speaking Order

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