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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **C.A.(COMM.IPD-PAT) 136/2022**

JANSSEN SCIENCES IRELAND UC

..... Appellant

Through: Mr. Debashish Banerjee, Mr. Ankush Verma, Ms. Vaishali Joshi, Mr. Pankaj Soni & Mr. Vineet Rohilla, Advocates.

versus

CONTROLLER OF PATENTS

..... Respondent

Through: Ms. Pratima N. Lakra, CGSC with Mr. Chandan Prajapati & Ms. Kashish Baweja, Advocates.

**CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA**

ORDER
29.04.2024

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1. The present appeal impugns order dated 20th April, 2015¹, whereby the Deputy Controller of Patents has refused the Appellant's Indian Patent Application No. 5461/DELNP/2008 titled as "LONG TERM TREATMENT OF HIV-INFECTION WITH TMC278"², filed on 24th June, 2008 under the Patents Act, 1970³.

2. The Subject Application was filed as an international application before WIPO and accorded PCT Application No. PCT/EP2007/050516. The

¹ "Impugned Order"

² "Subject Application"

³ "the Act"



Appellant has secured patents in Europe, USA and other host countries. The national phase application was filed in India on 24th June, 2008 and allotted the aforementioned Indian Patent Application No. The Subject Application was processed and has been refused on the ground of lack of inventive step under Sections 2(1)(ja), Section 3(i) and 3(e) of the Act.

3. The Court has noticed that there is an incongruence between the amended Claim No. 1 and the description and summary of the invention. While the amended Claim No. 1 is for a formulation, however, the specifications/ summary of the invention indicates that the Appellant has also made claims regarding the method of treating a subject infected with HIV and asserted the claims embodied in the invention as a use or method specified therein. Further, the later part of Claim No. 1 covers a dosage regime, which can also be understood as a method of treatment.

4. In light of the above, Mr. Debashish Banerjee, counsel for Appellant, states that the Appellant is open to amending their application to remove any such ambiguities. Accordingly, he requests that the Appellant be permitted to file an application for amendment before the Patent Office. Ms. Pratima Lakra, CGSC, states that in case such an application is filed, the same shall be considered on its own merits and thus the Court need not express any opinion on the merits of the case at this stage.

5. In view of the above, the present appeal is disposed of with the direction that the Appellant is permitted to file a fresh application within a period of four weeks from today. As and when the same is filed, the application shall be considered on its own merits by the by the Deputy Controller of Patents, who shall, upon processing such an application, issue a hearing notice specifying all the objections that the Appellant would be



required to meet.

6. With the above application direction present appeal is disposed of.

7. It is clarified that the Court has not examined the merits of the present case. All the grounds and contentions raised by the Appellant in the present appeal shall be permitted to be raised before the Deputy Controller in case the same survive and are relevant after filing of the amended application.

SANJEEV NARULA, J

APRIL 29, 2024

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