

IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Intellectual Property Rights Division)

IPDPTA/2/2024

UPL LIMITED
VS
ASTEC LIFE SCIENCES LIMITED AND ANR

Before:

The Hon'ble Justice RAVI KRISHAN KAPUR

Date: 20th February 2025

Appearance:
Mr. Subhatoosh Majumdar, Adv.
Mr. Paritosh Sinha, Adv.
Mr. K.K. Pandey, Adv.
Ms. Mitul Dasgupta, Adv.
Mr. Dominic Alvares, Adv.
Ms. Pooja Sett, Adv.
Mr. T. Das, Adv.
...for appellants.
Mr. Debnath Ghosh, Sr. Adv.
Mr. A. Narholkar, Adv.
Ms. Nisha Austine, Adv.
Ms. Vaibhavi Pandey, Adv.
Mr. Sharjit Ahmed, Adv.
...for respondent no. 1
Mr. Nandalal Singhania, Sr. Adv.
Mrs. Sarda Sha, Adv.
...for respondent no. 2

The Court: This appeal is directed against an order dated 9 March, 2024 whereby the pre grant objection filed under section 25 of the Patents Act, 1970 has been allowed.

It is fairly submitted on behalf of all the parties that there is a gross infraction of the principles of natural justice and fairness in the passing of the impugned order. The manner in which the impugned order has been passed reflects not only non-application of mind but can only be described as *a travesty of justice*. The serious allegations which have been levelled by the appellant go to the root of the fairness and transparency which is expected and required in any adjudicatory process. There has been a verbatim reproduction of portions of the Note of Submissions filed by the private respondent which includes the typographical errors and also the page numbers of the Note. In view of the above,

the impugned order is unsustainable and is set aside. The matter is remanded to a different Officer for expeditious hearing of the same. This exercise should be completed within a period of eight weeks from the date of communication of this order. It is made clear that there has been no adjudication on the merits of the case and all points are left open to be adjudicated by the Controller in accordance with law.

A discerning feature in many such matters is the manner in which proceedings under sections 14 and 15 as well as section 25(1) of the Patents Act, 1970, are being dealt with by the Patents Office. Patents are only granted after a series of formal procedures have been complied with. Consequently, the process of registration plays a key role in defining many aspects of patent law and practice. A decision to reject or allow a patent application or an opposition carries significant ramifications for the parties.

For convenience, section 14, 15 and 25(1) of the Act are set out below:

14. Consideration of report of examiner by Controller.—*Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or other documents to ensure compliance with the provisions of this Act or of the rules made thereunder, the Controller, before proceeding to dispose of the application in accordance with the provisions hereinafter appearing, shall communicate as expeditiously as possible the gist of the objections to the applicant and shall, if so required by the applicant within the prescribed period, give him an opportunity of being heard.*

15. Power of Controller to refuse or require amended applications, etc., in certain cases.—*Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.*

25. Opposition to the patent.—*(1) Where an application for a patent has been published but a patent has not been granted, any person may, in writing,*

represent by way of opposition to the Controller against the grant of patent on the ground—

(a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim—

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document:

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of Section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

Explanation.—For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the applicant has failed to disclose to the Controller the information required by Section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground and the Controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and within such period as may be prescribed.

As far as section 14 of the Act is concerned, it is evident that the objections require to be brought out and explained in an unambiguous manner in the First Examination Report so that an applicant may be able to comprehend as to what is the objection and requirement of the respondent authorities. The applicant should be given a chance to *effectively* address the objections raised.

If while conducting re-examination of the application, there is a requirement to cite new prior arts and raise other objections not contained in the First Examination Report, the same should be done in the form of a Second Examination Report (SER). In the event, the applicant fails to address the objection in a manner which is not to the satisfaction of the respondent authorities, the same should be made known to the applicant and the applicant should be given an opportunity of hearing, if so required.

Insofar as proceedings under section 25(1) of the Act are concerned, after the filing of the Statement and Evidence by an applicant under Rule 55(4), any further reply or documents, if filed and taken on record by the Controller must be informed promptly to the applicant, so that the applicant has an adequate opportunity to deal with the same.

Needless to mention, orders which are passed while dealing with applications either under section 14 or section 15 or section 25(1) of the Act must be reasoned and reflect proper application of mind. The orders must speak for themselves. The orders should reflect that the issues and contentions raised by the parties have been adequately dealt with. Each and every aspect raised by the

applicant and considered to be important by the Registry should be properly dealt with in the impugned order. There must be a '*why*' to justify the '*what*'. Reasons form the soul of any decision making process and reflects the basis on which the Controller has arrived at a conclusion.

The reproduction of the Submissions of either of the parties must be italicized or within quotes or highlighted to differentiate what is being set out or reproduced from the Submissions. An order of the Controller which is a mechanical reproduction of the Note of Submissions or a mere cut and paste is *non est* in the eye of law. Experience shows that some of these orders are a *verbatim* reproduction of the Note filed by a party without any independent application of mind. Such a practice is in violation of the principles of natural justice.

Both the Act and the Rules also contemplate prescribed timelines which should be strictly complied with. There must be a conscious effort to dispose of an application for grant of patent within the stipulated time frame. The incalculable damage which is caused to any applicant in keeping such applications pending for years nullifies the very objective and purpose of the Act. With the above directions, IPDPTA/2/2024 stands allowed.

(RAVI KRISHAN KAPUR, J.)

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