



W.P.(IPD)No.23 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 25.03.2025

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

W.P.(IPD)No.23 of 2023
and W.M.P.(IPD)Nos.5 & 7 of 2023

Adiuvo Diagnostics Private Limited,
Represented by its Authorised Signatory Ms. Geethanjali Radhakrishnan
Unit 18, Golden Jubilee Biopark For Woman,
4th Main Road, 2nd cross street,
Inside SIPCOT IT Park,
Siruseri, Chennai - 603 103, India.

... Petitioner

-VS-

1. Union of India,
Representation by its Secretary, Ministry of Finance,
Department of Revenue, New Delhi.
2. Office of Controller General of
Patents, Designs and Trademarks,
Boudhik Sampada Bhawan, S.M. Road,
Antop Hill, Mumbai 400 037.
3. Office of the Deputy Controller of Patents,
and Designs, Patent Office,
Intellectual Property Office Building,
G.S.T. Road, Guindy, Chennai - 600 032.



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4. University Health Network
Suite 150, 101 College Street, Toronto,
Ontario, M5G 1L7, Canada.

.. Respondents

Prayer: Writ Petition (IPD) filed under Article 226 of the Constitution of India for issuance of Writ of Certiorarified Mandamus calling for the records relating to the impugned order dated 19.07.2023 in Patent in respect of Indian Patent Application No. 9067/DELNP/2010, with Patent No. 439474 issued by the 3rd respondent and quash the same and direct the 3rd respondent to revoke the consequential grant of the Patent No.439474 corresponding to Patent Application No. 9067 / DELNP / 2010, and remand the matter back to a different officer of the Indian Patent office to re-hear the pre-grant opposition against Patent Application No. 9067 / DELNP / 2010 on merits, in a time bound manner and in accordance with law after taking into consideration all the submissions and documents filed.

For Petitioner : Ms.Vindhya S. Mani
Mr.Kiran Manokaran
Mr.Sheerabdhinath
for M/s.Lakshmikumaran and Sridharan

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



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For R4 : Mr.P.V.Balasubramaniam, Senior Counsel
for Ms. Archana Shanker
Mr.K.Premchandar
Mr.N.C.Vishal
Mr.Abhishek Kumar
Ms.S.Yeseswini

ORDER

This writ petition raises the question as to whether discretionary jurisdiction under Article 226 of the Constitution of India may be exercised in respect of an order rejecting a pre-grant opposition.

2. The 4th respondent herein filed Indian Patent Application No.9067/DELNP/2010 in respect of the invention titled 'Device and Method for Fluorescence-based Imaging and Monitoring'. The petitioner lodged a pre-grant opposition in respect thereof and such opposition was rejected while granting the patent by impugned order dated 19.07.2023. The present writ petition was filed in the said facts and circumstances.

3. Learned counsel for the petitioner submitted that the impugned order disregards material evidence and is completely unreasoned thereby



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justifying interference under Article 226. The first contention of learned counsel was that evidence placed on record by both parties finds no mention in the impugned order. In particular, learned counsel points out that the petitioner had placed on record the affidavit of Mr. Ananth Krishnan and, subsequently, the affidavit of Dr. Balasubramaniam Pesala. After pointing out that these were affidavits of persons skilled in the art (PSITA), learned counsel contends that it cannot be said that these affidavits were considered in substance merely because the impugned order contains reference to cited prior arts.

4. By inviting my attention to the conclusion in the impugned order with regard to lack of novelty, learned counsel submits that the Controller merely recorded and accepted the contention of the 4th respondent/patent applicant with regard to the alleged difference between the CCD sensor chip of D2 and the image acquisition device used in the impugned invention. She submits that the order contains no reasons either for accepting the submission of the patent applicant or for rejecting the contention of the opponent.



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5. Similarly, with reference to the conclusion on inventive step over D1-D3, learned counsel submits that the contention of the petitioner/opponent that D3 inherently teaches the existence of power supply and portability was noticed, but the Controller recorded the finding that the invention was not obvious merely because D1 and D2 in combination with D3 failed to disclose all the features of the alleged invention. In other words, the contention of learned counsel is that the Controller conflated the requirements of novelty analysis with those of obviousness analysis. With reference to prior art D7, learned counsel submitted that the conclusion that D7 is not portable was reached entirely based on the submissions of the patent applicant and that no independent reasoning is discernible.

6. As regards the conclusions with regard to Section 3(d) and 3(f) of the Patents Act, 1970 (the Patents Act), learned counsel submits that the objection under Section 3(d) that the impugned invention involved mere use of a known process, machine or apparatus should not have been rejected merely because it was previously held that the machine passes the novelty



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test. Likewise, she submitted that the objection under Section 3(k) that the impugned invention is a mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way was rejected by stating without basis that the components of the device do not function independently, and by merely recording that the contentions of the patent applicant in paragraph 143 of the reply statement were accepted.

7. Before concluding, learned counsel pointed out that the caveat petition lodged in the Delhi High Court by the 4th respondent was not disclosed in the writ petition because of lack of materiality inasmuch as no appeal lies against the impugned order.

8. Mr.P.V.Balasubramaniam, learned senior counsel, made submissions in response. His first contention was that the Patents Act does not provide for an appeal against an order rejecting a pre-grant opposition. Consequently, he contends that the writ petition cannot be used as an indirect vehicle to present an appeal in disguise. Therefore, as regards the



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contentions of learned counsel for the petitioner on the findings on objections raised by the petitioner, he submits that the correctness of the decision cannot be assailed in a writ petition.

9. His second contention is that the petitioner has several alternative remedies, such as the filing of a post-grant opposition, the filing of a revocation petition and even the filing of an appeal, if the petitioner were unsuccessful in the post-grant opposition. By referring to the impugned order, learned senior counsel submits that sufficient opportunity was provided to the opponent and the order was issued after an extensive hearing. Thus, he submits that principles of natural justice were complied with.

10. In support of the contention that the present writ petition is not maintainable, he referred to and relied upon the following judgments:

(i) *Ucb Farchim Sa v. Cipla Ltd. & Others*, 2010 SCC OnLine Del 523(*Ucb Farchim*), particularly paragraphs 13 – 22 thereof ;

(ii) *Rich Products Corporation v. The Controller of Patents and another*, W.P.(C)-IPD 8/2024, CM 18-19/2024;



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(iii) *Rich Products Corporation v. The Controller of Patents and another*, LPA 257/2024 & CM No.19528/2024(Rich Products Corporation), particularly paragraphs 10, 11, 14 & 15 thereof;

(iv) *Mylan Laboratories Limited v. Union of India and others*, 2019 SCC OnLine Del 10319(Mylan Laboratories), especially paragraphs 2, 6 to 8 thereof.

11. By way of a brief rejoinder, learned counsel for the petitioner contended that the order was opposed by way of a writ petition because it is completely unreasoned and not merely inadequately reasoned. In support of the contention that writ petitions have been entertained at the pre-grant stage, learned counsel referred to and relied upon the following judgments:

(i) *Regents of the University of California v. Union of India & others*, 2019 SCC OnLine Del 8590, particularly paragraphs 32, 42, 43, 50 to 56 thereof;

(ii) *Best Agrolife Limited v. Deputy Controller of Patents & another*, 2022 SCC OnLine Del 1982, particularly paragraphs 28, 51 & 52 thereof;

(iii) *Indian Network for People living with HIV/AIDS and another v.*



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Union of India and others, 2008 SCC OnLine Mad 892, particularly paragraph 55 thereof;

12. As regards the maintainability of a writ petition notwithstanding the existence of alternative remedies, learned counsel referred to and relied upon the landmark judgment of the Supreme Court in *Whirlpool Corporation v. Registrar of Trade Marks, Mumbai & Ors* 1998 AIR SCW 3345, particularly paragraphs 15 to 17 thereof, and the judgment of the Division Bench of the Bombay High Court in *Neon Laboratories Pvt. Ltd. and others v. Troikaa Pharma Limited and others*, 2010 SCC OnLine Bom 1799.

13. At the outset, it should be noticed that the petitioner has approached this Court seeking a discretionary public law remedy. In *Ucb Farchim*, the Delhi High Court examined the question whether a writ petition should be entertained against an order rejecting a pre-grant opposition. After discussing the matter extensively, the Court concluded that if the person approaching the Court qualifies as a person interested



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under Section 2(1)(t) of the Patents Act, the Court would ordinarily decline to exercise jurisdiction in view of the petitioner having an efficacious alternative statutory remedy. On the other hand, if the petitioner is not a person interested as defined in the Patents Act, the Court may exercise jurisdiction if it comes to the conclusion that the person concerned has no other efficacious remedy or that the interest of justice warrants interference. These principles were followed by the Delhi High Court in *Rich Products Corporation* and *Mylan Laboratories*.

14. The principles laid down in *Ucb Farchim* and subsequent judgments regarding the existence of an alternative remedy should be borne in mind while examining a challenge to the rejection of a pre-grant opposition, but they do not lead to the conclusion that this Court's power under Article 226 is ousted or even whittled down in such circumstances. The power under Article 226 is undoubtedly wide in amplitude and is exercisable whenever a statutory authority fails to exercise the jurisdiction vested in such authority or exceeds its jurisdiction or even exercises jurisdiction perversely. Being a discretionary power, the existence of an alternative remedy would be a material, albeit not necessarily conclusive,



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factor to be reckoned in deciding whether to exercise or decline to exercise jurisdiction. Given the nature of jurisdiction, ordinarily, the decision making process and not the decision is reviewed under Article 226. Whether the order impugned herein warrants interference on the basis of principles governing the exercise of this jurisdiction falls for consideration next.

15. On closely examining the impugned order, any reference to the affidavits of Mr.Ananth Krishnan, Dr. Balasubramaniam Pesala or Dr.Ralph DaCosta is conspicuous by its absence. Although Mr.P.V.Balasubramaniam contended that the affidavit of Mr.Ananth Krishnan merely referred to cited prior arts, as contended by Ms.Vindhya Mani, the reference to cited prior arts in the impugned order cannot be equated with the consideration of affidavits by way of evidence. This is especially true with regard to obviousness analysis since such analysis is required to be undertaken by donning the mantle of PSITA. When affidavits are presented by persons professing to be skilled in the art, it is incumbent on the Controller to consider such affidavits and thereafter record reasons for accepting or rejecting the opinions expressed therein.



16. As regards the conclusions on inventive step, it is pertinent to set out the following paragraph of the impugned order with regard to the comparison between prior arts D1 to D3 and the invention:

“In view of the above disclosure, it is submitted that in an attempt to manufacture a “portable, compact apparatus” with “Monochromatic light sources of low power laser”, a person skilled in the art will necessarily be taught to include the power source for such light source having power of at least 1mW within the device itself. Therefore, D3 inherently teaches a power supply contained within the device housing without which there cannot be any portability. The applicants have submitted in their written statement para 60 that the image acquisition device is not mere sensor chip. Further in para 63 the applicants have submitted that D1 and D2 in combination with D3 also fails to disclose all the features of the alleged invention. In the absence of power supply, as stated and accepted as inherently disclosed by the opponents, the teaching of D1 and D2 in combination with D3 fails to result in the alleged invention. ”

From the above extract, it follows that the contention with regard to D3 of the opponent has been recorded. Thereafter, the contentions of the patent



applicant with regard to D1 to D3 are recorded, including with regard to all features of the invention not being disclosed in prior arts D1-D3. This is followed by the conclusion that the teaching of D1 and D2 in combination with D3 fails to result in the alleged invention. As contended by learned counsel for the petitioner, it appears *prima facie* that no obviousness analysis was undertaken and the Controller has, without independent reasoning, proceeded to accept the contention of the patent applicant while rejecting that of the opponent.

17. The conclusion with regard to prior art D7 also merits reproduction. The said conclusion is as under:

“Further the applicants have submitted that in D7, a lens is used which has to be integrated with the device during manufacturing. In addition to this in para 75, the applicants have stated that the requirement for a physical link such as a serial bus between the handheld portion of D7's device and the stationary portion of D7's device means that the overall device of D7 is not portable.

With the above facts it is concluded that the teachings of D1 and D2 in combination with D7 cannot



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result in the claim 1 of the alleged invention.

Documents D6 and D8-D9 are used for dependent claims. When objection to claim 1 cannot be established these arguments stands invalid. ”

Once again, as in the case of prior arts D1 to D3, the Controller has merely accepted the contention of the patent applicant and rejected that of the opponent without providing any reasons in support of such conclusions.

18. Nonetheless, while exercising discretionary jurisdiction under Article 226 in respect of an order against which the statute does not provide for an appeal, it is important to bear in mind that the writ petition should not be resorted to as an appeal in disguise. Therefore, especially in the factual context of the petitioner being a competitor in the same line of business as the 4th respondent and, consequently, a person interested within the meaning of Section 2(1)(t) of the Patents Act, the petitioner undoubtedly had an alternative remedy by way of a post-grant opposition and continues to have the alternative remedy of a petition for revocation under Section 64 of the Patents Act. In these circumstances, it is necessary to strike the appropriate balance.



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19. On the one hand, the petitioner has established that evidence by way of affidavits was not considered in the impugned order and that the impugned order records conclusions on certain issues without providing reasons in support thereof. On the other, as indicated above, the petitioner has an alternative remedy and the patent was granted to the 4th respondent on 19.07.2023 with the priority date of 20.05.2008. In effect, only a little over three years remain in the life of the patent. Hence, any interference with the patent for reasons recorded in this order will cause grave prejudice to the 4th respondent, and would not be justified in the facts and circumstances. Consequently, a workable and balanced alternative warrants consideration.

20. Within one year from the date of publication of grant, a notice of opposition may be filed before the Controller by any person interested under Section 25(2) of the Patents Act. In the present case, the grant was on 19.07.2023. Therefore, the one year period expired on 18.07.2024. Much prior thereto, in August 2023, this writ petition was filed. If the time taken in prosecuting this writ petition were to be excluded, the petitioner would be



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in a position to lodge a notice of opposition. In my view, this approach strikes the appropriate balance on a holistic consideration of the facts and circumstances. One final issue remains.

21. When the writ petition was listed for hearing on 30.08.2023, after concluding that the petitioner had made out a *prima facie* case, in relevant part, it was held as under:

“3. On examining the impugned order, I find that a prima facie case is made out. By taking into account the fact that both the petitioner and the fourth respondent carry on similar business and are competitors in the market place, there will be an interim order restraining the fourth respondent from prosecuting the petitioner on the basis of Patent No.439474 provided that the petitioner uses devices and methods for fluorescence based imaging and monitoring based on its patent IN323440. This order shall operate until the next date of hearing.”

Learned counsel for the petitioner submitted that the petitioner should be provided the benefit of the above interim order in case the Court is inclined to decline to set aside the grant and instead relegate the petitioner to a



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post-grant opposition. Learned senior counsel for the 4th respondent opposed this request by submitting that it would tantamount to granting an anti-suit injunction in favour of the petitioner. He further submits that the 4th respondent would put the petitioner on prior notice if it intends to sue the petitioner for infringement.

22. In the interim order extracted above, it was noticed that the petitioner had obtained a grant in patent IN323440, and the interim order was restricted to actions for infringement on the basis of patent no.439474 in a situation wherein the petitioner works the patent granted under IN323440. One of the grounds on which this petition has been prosecuted is the wide amplitude of the grant. In the specific factual context of the petitioner filing a pre-grant opposition, challenging the order passed therein by way of this writ petition and the above interim order of this Court having continued in force from 30.08.2023 till date, I find merit in the request for continuation of this interim order until disposal of the post-grant opposition.



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23. For reasons aforesaid, W.P.(IPD)No.23 of 2023 is disposed of on the following terms:

(i) The petitioner is permitted to lodge a post-grant opposition within 30 days from the date of receipt of a copy of this order.

(ii) If the post-grant opposition is received within the said time limit, the Patent Office is directed to receive and dispose of the said post-grant opposition on merits and in accordance with law.

(iii) The interim order issued on 30.08.2023 shall continue in operation until disposal of the post-grant opposition. Thereafter, such order shall cease to operate and shall abide by the outcome of the post-grant proceedings before the Patent Office.

(iv) The continuation of the interim order is also subject to the outcome of opposition proceedings relating to IN323440. For the avoidance of doubt, it is clarified that if the opposition were to be allowed, the petitioner will no longer be entitled to the benefit of the interim order.



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(v) There will be no order as to costs.

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(vi) Consequently, connected miscellaneous petitions are closed.

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Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes / No

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To

1. Union of India,
Representation by its Secretary, Ministry of Finance,
Department of Revenue, New Delhi.

2. Office of Controller General of
Patents, Designs and Trademarks,
Boudhik Sampada Bhawan, S.M. Road,
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