



2025:DHC:1361



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\* IN THE HIGH COURT OF DELHI AT NEW DELHI

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Date of decision: 24<sup>th</sup> February, 2025

+ C.A.(COMM.IPD-PAT) 40/2023

ARCTURUS THERAPEUTICS INC

.....Appellant

Through: Mr Pravin Anand, Mr. Devinder  
Rawat and Mr Ashutosh Upadhyaya,  
Advocates

versus

ASSISTANT CONTROLLER OF  
PATENTS AND DESIGNS

.....Respondent

Through: Mr. Rohan Jaitley, CGSC with  
Mr. Dev Pratap Sahani & Mr Varun  
Pratap Singh, Advocates for UoI with  
Mr. Ravikumar Battini, Assistant  
Controller of Patents**CORAM:****HON'BLE MR. JUSTICE AMIT BANSAL****AMIT BANSAL, J. (Oral)**

1. The present appeal has been filed under Section 117A of the Patents Act, 1970 against the impugned order dated 25<sup>th</sup> July, 2023, refusing the Indian patent application no.201617019205 titled "Ionizable Cationic Lipid For RNA Delivery".

2. The relevant dates of the aforesaid patent application are as follows:

| Sr. No. | DATE              | EVENT                                                 |
|---------|-------------------|-------------------------------------------------------|
| 1.      | November 18, 2013 | Priority Application (US 61/905,724) was filed in USA |



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|     |                   |                                                                                                                       |
|-----|-------------------|-----------------------------------------------------------------------------------------------------------------------|
| 2.  | November 18, 2014 | PCT Application (PCT/US2014/066242) was filed taking priority from the US Application No. 61/905,724.                 |
| 3.  | May 21, 2015      | The PCT Application was published bearing International Publication Number of WO2015/074085.                          |
| 4.  | June 2, 2016      | PCT National Phase Application was filed in India and Indian Application Number 201617019205 has been assigned to it. |
| 5.  | February 15, 2019 | First examination report (FER) was issued by the Indian patent office.                                                |
| 6.  | August 13, 2019   | The Appellant has filed response to the FER.                                                                          |
| 7.  | March 8, 2022     | Hearing notice was issued by the Respondent appointing a hearing (1 <sup>st</sup> ) for March 29, 2022.               |
| 8.  | March 29, 2022    | The Appellant attended the hearing (1 <sup>st</sup> ).                                                                |
| 9.  | April 12, 2022    | The Appellant filed petition u/r 138 seeking one month extension for filing the written submissions.                  |
| 10. | May 13, 2022      | The Appellant filed Written Submissions at the Patent office (1 <sup>st</sup> written submissions).                   |
| 11. | January 11, 2023  | Extended hearing notice (2 <sup>nd</sup> ) was issued by the Respondent appointing a hearing for January 30, 2023     |
| 12. | January 27, 2023  | Hearing adjournment was filed.                                                                                        |
| 13. | January 30, 2023  | Extended hearing notice issued appointing a hearing for                                                               |



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|     |                   |                                                                                                                             |
|-----|-------------------|-----------------------------------------------------------------------------------------------------------------------------|
|     |                   | February 28, 2023.                                                                                                          |
| 14. | February 27, 2023 | Hearing adjournment filed.                                                                                                  |
| 15. | February 27, 2023 | Extended hearing notice issued appointing a hearing for March 27, 2023.                                                     |
| 16. | March 24, 2023    | Hearing adjournment filed.                                                                                                  |
| 17. | March 27, 2023    | Extended Hearing notice issued appointing a hearing for May 2, 2023.                                                        |
| 18. | April 19, 2023    | Hearing adjournment filed.                                                                                                  |
| 19. | April 27, 2023    | Extended Hearing notice issued appointing a hearing for May 2, 2023.                                                        |
| 20. | May 2, 2023       | The Appellant attended the hearing (2 <sup>nd</sup> )                                                                       |
| 21. | May 12, 2023      | The Appellant filed petition u/r 138 seeking one month extension for filing the written submissions.                        |
| 22. | July 25, 2023     | The Appellant filed Written Submissions at the Patent office (2 <sup>nd</sup> written submissions).                         |
| 23. | July 25, 2023     | The Respondent issued decision under Section 15 refusing the grant of a patent against Indian Application No. 201617019205. |

3. It is stated that the aforesaid application was the national phase application in India under the Patent Co-operation Treaty which was filed by the appellant on 2<sup>nd</sup> June, 2016.

4. The first examination report (FER) was issued by the Indian patent office on 15<sup>th</sup> February, 2019. In the FER, objections relating to lack of inventive step under section 2(1)(ja) and non-patentability under Sections 3(d) and 3(h) of the Patents Act were raised, to which the appellant filed a response



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on 13<sup>th</sup> August, 2019.

5. A hearing notice was issued by the respondent was issued on 8<sup>th</sup> March 2022 and the first hearing took place on 29<sup>th</sup> March, 2022. Subsequently, the appellant filed their written submissions on 13<sup>th</sup> May, 2022. Thereafter, the appellant was granted a second hearing on 2<sup>nd</sup> May, 2023.

6. After the aforesaid hearing, on 12<sup>th</sup> May, 2023, the appellant filed a petition under Rule 138 of the Patents Amendment Act, 2005 seeking one month's extension for filing the written submissions.

7. The appellant was granted time till 17<sup>th</sup> June, 2023, to file the additional written submissions. However, the written submissions could be filed by the appellant only on 25<sup>th</sup> July, 2023, by when the impugned order had already been passed by the Assistant Controller of Patents.

8. Mr. Pravin Anand, counsel for the appellant submits that that the impugned order does not deal with the merits of the case. The Assistant Controller has merely rejected the application on the ground that the additional written submissions and the additional data was not filed within the prescribed period.

9. Mr. Anand further submits that the delay in filing the written submissions was on account of the lengthy process of conducting empirical studies to provide the comparative data as directed by the respondent in the second hearing notice dated 11<sup>th</sup> January, 2023.

10. The reasoning given by the Assistant Controller in the impugned order is set out below:-

*“Applicant is provided with many opportunities to present the case and submit the evidence in support of the pending claims. Applicant appeared for the last hearing on 02/05/2023 and*



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*subsequently filed a petition u/r 138 on 12/05/2023 to file the return submissions on/before 17/06/2023. Petition u/r 138 is allowed and granted time till 17/06/2023. Applicant failed to submit his written submissions along with the data required by the office in the hearing notice on/before 17/06/2023.*

*In view of the written submissions not filed, I am not satisfied that objections of the hearing notice dated 27/04/2023 are still stands. Since objections are outstanding, and since no pre/grant representation u/s 25(1) is filed as per the records, proceeding to refuse the grant of patent on the basis of pending claims u/s 15 and 43 of the act.”*

11. A perusal of the impugned order would show that the patent application has been refused only on the basis of the appellant not having filed his additional written submissions in a timely manner. The impugned order does not examine the merits of the matter.

12. I have heard the counsel for the parties and also the Assistant Controller of Patents who appears through video conferencing.

13. In my considered view, the rejection of the appellant's patent application due to a mere procedural deficiency can have serious consequences on the appellant's invention. The principles of natural justice would require that the patent application filed on behalf of the appellant is considered on merits. Patent rights are valuable rights and rejection of the patent application can have serious consequences on the Applicant.

14. Even if the Appellant failed to file the additional written submissions in time, the Asst. Controller should have passed a reasoned order dealing with the merits of the case and taking into consideration the objections raised in the FER, the reply thereto, the earlier written submissions filed on behalf of the appellant on 13<sup>th</sup> May, 2022 and the submissions made orally during the



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course of the two hearings.

15. Taking into consideration the peculiar facts of the present case and in the interest of justice, I am inclined to remand the matter back to the Asst. Controller of Patents so that the patent application of the appellant can be considered on merits taking into consideration the material on record, including the additional written submissions filed by the appellant on 25<sup>th</sup> July, 2023.

16. Accordingly, the present appeal is allowed and the impugned order is set aside and the matter is remanded back to the Assistant Controller of Patents.

17. Counsel for the appellant submits that they do not wish to file anything further in support of their patent application and the same may be decided on the basis of the material which is already on record.

18. Accordingly, it is directed that a fresh notice for hearing be given to the appellant and the appellant's patent application be decided on merits.

19. Considering this is an old application, the Learned Asst. Controller is requested to decide the same in an expeditious manner, preferably within three months from today.

20. The Registry is directed to send a copy of the present order to the office of the Controller General of Patents, Designs and Trade Marks at the e-mail *llc-ipo@gov.in* for compliance.

21. It is made clear that the aforesaid order has been passed in the peculiar facts and circumstances of the present case and will not be treated as a precedent.

**AMIT BANSAL, J**

**FEBRUARY 24, 2025/ds**