

(2019) 09 DEL CK 0391

In the Delhi High Court

Case No : Civil Writ Petition No. 5571 Of 2019, Civil Miscellaneous Application
No. 24540 Of 2019

Mylan Laboratories Limited

APPELLANT

Vs

Union Of India & Ors

RESPONDENT

Date of Decision : 30-09-2019

Acts Referred:

Patents Act, 1970 — Section 25, 25(1), 25(2), 64, 117A

Citation : (2019) 80 PTC 374

Hon'ble Judges : Prathiba M. Singh, J

Bench : Single Bench

Advocate : Rajeshwari H., Swapnil Gaur, Saif Rahman Ansari, Gaurang Kanth,
Varun Sharma

Final Decision : Disposed Of

Judgement

Prathiba M. Singh, J

1. The present petition has been filed, challenging the order of the Deputy Controller of Patents & Designs (hereinafter, "Deputy Controller") dated 14th March, 2019 as the Intellectual Property Appellate Board (hereinafter, "IPAB") is not currently fully constituted and is not functional. The present writ petition was filed seeking setting aside of the impugned order as at that time, the technical member of IPAB had not been appointed. Thereafter, in view of judicial orders, the IPAB commenced its hearings. However, during the pendency of the present writ petition, the Chairperson of IPAB has demitted office.

2. The contention of Ms. Rajeshwari, Id. counsel appearing for the Petitioner is that the Petitioner had filed a pre-grant opposition challenging the grant of a patent to Respondent No.3, which relates to 'Methods of Evaluating Peptide Mixtures'. The Petitioner is stated to have relied upon four prior arts, which, according to the Id. counsel for the Petitioner, have not been considered and no reasons have been given by the Id. Deputy Controller while rejecting the pre-

grant opposition. Her contention is that all the prior arts cited by the Petitioner have been dealt with in one paragraph and the same does not constitute adequate reasons. Hence, according to Ld. Counsel, no proper order has been passed on merits.

3. On the other hand, Id. counsel for Respondent No.3 which is the contesting respondent, submits that hearings in the pre-grant opposition were held in January, 2019 and parties were permitted to file written submissions. It is also submitted that the claims of the patent itself were amended, owing to the prior arts which had been cited by the Petitioner, and that the Id. Deputy Controller has, in fact, examined the matter fully, including the amended claims, as is evident from the last four pages of the impugned order. The order is quite well-reasoned. Ld. Counsel further relies upon the judgment of this Court in *UCB Farchim Sa v. Cipla Ltd. & Ors.*, (2010) 167 DLT 459, which holds that no appeal or writ is maintainable against the order deciding the pre-grant opposition.

4. The Court has considered the impugned order as also the judgment in *UCB Farchim* (supra). The Patents Act, 1970 (hereinafter, "the Act") provides for filing of pre-grant oppositions and post-grant oppositions under Sections 25(1) and 25(2), as also revocation under Section 64, by a person who is challenging the grant of the patent or who is seeking revocation of the patent. Since there are three distinct remedies available under the Act, the scheme of the Act was considered in detail in *UCB Farchim* (supra) wherein a Id. Single Judge of this Court, after analysing the judgment of the Supreme Court in *J. Mitra & Company v. Assistant Controller of Patents & Designs*, (2008) 10 SCC 368, held as under:

"15. In the first eventuality, where the pre-grant opposition is rejected, it is apparent from the decision in *J. Mitra* and from a reading of Section 25 with Section 117A that as long as the person who has filed that opposition happens to be a person interested, he would, after 1st January, 2005 [the date with effect from which Section 25 (2) came into force although the provision was introduced only on 4th April, 2005] have the remedy of filing a post-grant opposition. He can, after 2nd April, 2007, also file an application before the IPAB under Section 64 of the Patents Act for revocation of the patent. In other words, as explained by the Supreme Court in *J. Mitra & Co.* as long as that person is able to show that he is a person "interested", he is not without a remedy after his pre-grant opposition is rejected. He in fact has two remedies. Even if his post-grant opposition is rejected, he can thereafter file an appeal to the IPAB under Section 117A. Against the decision of the IPAB in either event he will have the remedy of seeking judicial review in accordance with law by filing a petition in the High Court. At this juncture it may be noticed that in an order dated 2nd March, 2009 in SLP (C) No. 3522 of 2009 (*Indian Network for People with HIV/AIDS v. F. Hoffman-La Roche*) the Supreme Court permitted the unsuccessful pre-grant opposer, who had challenged the rejection of his opposition by the Controller, to participate in the post-grant stage.

16. The law is well settled that notwithstanding that a High Court has the power

and the jurisdiction under Article 226 of the Constitution to interfere with the orders of any statutory authority which is of a quasi-judicial nature, it will decline to exercise such jurisdiction where there is an efficacious alternative statutory remedy available to the aggrieved person....."

5. In the present case, a perusal of the impugned order shows that the Id. Deputy Collector has considered all the prior arts, though not in detail, and has also considered the amended claims. After considering these documents, the following conclusion has been arrived at:

"In my opinion, none of cited document defines the claimed method of assaying, which is related to detection of diethylamide moiety bound to C-terminus, while in cited art D9 of opposition document and D1 of hearing notice there is step of cleavage of diethylamide moiety from glatiramer acetate. It imparts sensitivity to assaying method. Claim 1 is related to a method of assaying a sample of glatiramer acetate, the method comprising:

- a) providing the sample of glatiramer acetate wherein the sample is suspected of comprising one or more polypeptides having a diethylamide moiety bound to a C - terminus thereof;
- b) determining the amount of polypeptides having a diethylamide moiety bound to a C- terminus thereof in the sample, characterized by detecting diethylamide moieties when present on the Cterminus thereof;
- c) comparing the amount of polypeptides, determined by detecting diethylamide moieties when present on the C-terminus thereof, having the diethylamide moiety bound to a C-terminus thereof in the sample to a predetermined pharmaceutical specification value for glatiramer acetate, wherein the specification value for glatiramer acetate has a range of 7 mol% to 20 mol% polypeptides having a diethylamide moiety bound to a C-terminus thereof; and
- d) classifying the sample based on the amount of polypeptides having diethylamide moieties bound to the C-terminus thereof in the sample, wherein the classifying of the sample comprises releasing the sample for pharmaceutical use.

In view of above facts and finding, hearing proceedings, written submission filed by applicant on 19/01/2019, the Patent Application 9028/DELNP/2008 shall proceed to grant of Patent on amended set of claims filed on 19/01/2019 as there are no technical and formal objections, and the pre-grant opposition stands disposed off."

6. In the opinion of this Court, the pre-grant opposition was, therefore, decided on merits and following the scheme of the Act, as laid down in UCB Farchim (supra), the remedy of the Petitioner would be to either file a post-grant opposition or an application for revocation. Thus, the present petition would not be liable to be entertained.

7. Under Section 25(2) of the Act, the post-grant opposition can be filed by "any person interested" within a period of one year from the date of publication of grant of the patent. Considering that the Petitioner is a "person interested", the Petitioner is permitted to file a post-grant opposition, which shall be decided in accordance with the provisions of Section 25 of the Act, after constituting an Opposition Board.

8. The Petitioner shall file the post-grant opposition within a period of two months from today. Thereafter, the pleadings shall be completed in accordance with the Act. In any event, the post-grant opposition, if filed within a period of two months, shall be decided within a period of one year from today. The parties are permitted to file any additional documents, pleadings and evidence, which they consider appropriate, at the relevant stage. All rights and contentions of the Petitioner and Respondent No.3 are left open.

9. The petition and all pending applications are disposed of in the above terms.