
(2020) 08 IPAB CK 0001

In the Intellectual Property Appellate Board

Case No : M.P. No. 9/2020, OA/20/2019/PT/DEL

Novertis Ag

APPELLANT

Vs

Controller General Of Patens, Designs And Trade Marks And
Ors.

RESPONDENT

Date of Decision : 28-08-2020

Acts Referred:

Trade Marks Act, 1999 — Section 83, 84, 84(2)
Delhi Value Added Tax Act, 2004 — Section 73(4), 73(9)
Copyright Act, 1957 — Section 11, 31D
Patents Act, 1970 — Section 15, 25(2), 115, 116, 117A
Copyright Rules, 2013 — Rule 3
Constitution Of India, 1950 — Article 14, 21

Citation : (2020) 08 IPAB CK 0001

Hon'ble Judges : Manmohan Singh, J;Dr. Onkar Nath Singh, Technical Membe

Bench : Division Bench

Advocate : Hemant Singh, Mamta Jha, Rajeshwari Hariharan

Final Decision : Dismissed

Judgement

Manmohan Singh, J

1. By this order, we propose to decide the pending application dated 17.2.2020 filed by the respondent No. 3 seeking relief to appoint technical expert to assist the Board mainly on the grounds that the complex issues may arise. Secondly, Section 84(2) of Act provides that the Bench shall comprise a Judicial Member and a Technical Member and the current Technical Member is an expert in plant varieties protection and has a background of agriculture and animal husbandry, therefore, it is in the fitness of things that the Board is assisted by a technical expert with having background of chemistry.

2. The present appeal has been filed against the Order dated 16.8.2019 whereby the Patent No. 276026 granted in favour of appellant was revoked. Along with the appeal, an application for stay of operation of impugned order was also filed.

3. It is matter of fact that the interim application was operating against the respondent No. 3 in a suit for infringement of Patent dated 2.5.2019 filed by the applicant against respondent No. 3. When the impugned order was passed, which was vacated once the impugned order was passed.

4. When the matter was taken up on 10.06.2020 via video conferencing, the counsel for both parties sought two weeks time to file the written arguments in main appeal and to complete the remaining arguments. The matter was adjourned to 09.07.2020 with their consent.

5. It appears that respondent No. 3 on 9.6.2020 filed the writ petition before the High Court inter-alia seeking certain reliefs, including that the application for appointment of scientific expert is not decided before hearing of appeal. Copy of petition was received by the IPAB through Government counsel who addressed the communication to Ministry also. The said petition was disposed of on 1.7.2020 with certain directions, including to decide the pending application for appointment of expert filed by the respondent No. 3. However, the respondent No. 3 filed the application for adjournment of two weeks on the ground that the counsel is not keeping fit. The same was granted despite of objection of the appellant counsel stating that there are other counsel in the matter who can argue the matter. However, both counsel agreed that in the meanwhile the order be passed in the stay application with the consent of parties, the order was reserved which is now pronounced on 20.07.2020.

6. We have heard the present application on 23.07.2020 and have gone through the pleadings of the parties as well as earlier orders passed by IPAB. We have been informed that technical member (Patent) has been appointed who is yet to join.

7. The appeal has now been adjourned to 10/08/2020 at the request of counsel for the respondent No. 3. However she has given her consent to dispose the pending application. Counsel for the appellant has no objection. Thus we have heard both counsel.

8. It is necessary to refer the few paras of Order dated 8.7.2019 passed by the Hon'ble High Court in the Writ Petition No. 558/2019 where the issue in hand was discussed in the case of Mylan Laboratories Limited vs. Union of India and others. Paras 22 to 30 where the Doctrine of necessities was discussed and thereafter discussion and finding were given in para 31 to 39 and conclusion in paras 40-43. The said paras are reproduced below:

Relevant Judgments

31. Given the fact that pronouncements mentioned above have interpreted and understood the word "life" appearing in Article 21 of the Constitution on a broad spectrum of rights considered incidental and/or integral to the right to life, there is no real reason why access to justice should be considered to be falling outside the class and category of the said rights, which already stands recognised as

being a part and parcel of Article 21 of the Constitution of India. If "life" implies not only life in the physical sense but a bundle of rights that makes life worth living, there is no juristic or other basis for holding that denial of "access to justice" will not affect the quality of human life so as to take access to justice out of the purview of right to life guaranteed under Article 21. We have, therefore, no hesitation in holding that access to justice is indeed a facet of right to life guaranteed under Article 21 of the Constitution. We need only add that access to justice may as well be the facet of the right guaranteed under Article 14 of the Constitution, which guarantees equality before law and equal protection of laws to not only citizens but non-citizens also. We say so because equality before law and equal protection of laws is not limited in its application to the realm of executive action that enforces the law. It is as much available in relation to proceedings before courts and tribunal and adjudicatory fora where law is applied and justice administered. The citizen's inability to access courts or any other adjudicatory mechanism provided for determination of rights and obligations is bound to result in denial of the guarantee contained in Article 14 both in relation to equality before law as well as equal protection of laws. Absence of any adjudicatory mechanism or the inadequacy of such mechanism, needless to say, is bound to prevent those looking for enforcement of their right to equality before laws and equal protection of the laws from seeking redress and thereby negate the guarantee of equality before laws or equal protection of laws and reduce it to a mere teasing illusion. Article 21 of the Constitution apart, access to justice can be said to be part of the guarantee contained in Article 14 as well.

32. What then is the sweep and content of that right is the next question that must be answered for a fuller understanding of the principle and its significance in real life situations.

33. Four main facets that, in our opinion, constitute the essence of access to justice are:

- (i) the State must provide an effective adjudicatory mechanism;
 - (ii) the mechanism so provided must be reasonably accessible in terms of distance;
 - (iii) the process of adjudication must be speedy; and
 - (iv) the litigant's access to the adjudicatory process must be affordable.
- (i) The need for adjudicatory mechanism

34. One of the most fundamental requirements for providing to the citizens access to justice is to set up an adjudicatory mechanism whether described as a court, tribunal, commission or authority or called by any other name whatsoever, where a citizen can agitate his grievance and seek adjudication of what he may perceive as a breach of his right by another citizen or by the State or any one of its instrumentalities. In order that the right of a citizen to access justice is protected, the mechanism so provided must not only be effective but must also

be just, fair and objective in its approach. So also the procedure which the court, tribunal or authority may adopt for adjudication, must, in itself be just and fair and in keeping with the well-recognised principles of natural justice.

(ii) The mechanism must be conveniently accessible in terms of distance

36. "Access to justice" as a constitutional value will be a mere illusion if justice is not speedy. Justice delayed, it is famously said, is justice denied. If the process of administration of justice is so time-consuming, laborious, indolent and frustrating for those who seek justice that it dissuades or deters them from even considering resort to that process as an option, it would tantamount to denial of not only access to justice but justice itself. In *Sheela Barse case* [*Sheela Barse v. Union of India*, (1988) 4 SCC 226] this Court declared speedy trial as a facet of right to life, for if the trial of a citizen goes on endlessly his right to life itself is violated. There is jurisprudentially no qualitative difference between denial of speedy trial in a criminal case, on the one hand, and civil suit, appeal or other proceedings, on the other, for ought we to know that civil disputes can at times have an equally, if not more, severe impact on a citizen's life or the quality of it. Access to justice would, therefore, be a constitutional value of any significance and utility only if the delivery of justice to the citizen is speedy, for otherwise, the right to access to justice is no more than a hollow slogan of no use or inspiration for the citizen."

(Emphasis Supplied)

23. In *Election Commission of India v. Dr. Subramaniam Swamy*, : 1996 4 SCC 104, one of the members of the Commission was under disability to hear the matter on account of the allegations of bias. The Supreme Court invoked the Doctrine of Necessity and observed that if the choice is between allowing biased person to act or to stifle the action altogether, the choice must fall in favour of the former as it is the only way to promote decision-making. The Supreme Court held that if the two Election Commissioners are able to reach a unanimous decision, there is no need for the Chief Election Commissioner to participate but if the two Election Commissioners are unable to reach a unanimous decision then the doctrine of necessity may have to be he invoked and Chief Election Commissioner would be compelled to express his views so that the majority opinion can be formed, notwithstanding the allegations of biasness. The relevant portion of the said judgment is as under:-

"16. We must have a clear conception of the doctrine. It is well settled that the law permits certain things to be done as a matter of necessity which it would otherwise not countenance on the touchstone of judicial propriety. Stated differently, the doctrine of necessity makes it imperative for the authority to decide and considerations of judicial propriety must yield. It is often invoked in cases of bias where there is no other authority or Judge to decide the issue. If the doctrine of necessity is not allowed full play in certain unavoidable situations, it would impede the course of justice itself and the defaulting party would benefit

therefrom. Take the case of a certain taxing statute which taxes certain perquisites allowed to Judges. If the validity of such a provision is challenged who but the members of the judiciary must decide it. If all the Judges are disqualified on the plea that striking down of such a legislation would benefit them, a stalemate situation may develop. In such cases the doctrine of necessity comes into play. If the choice is between allowing a biased person to act or to stifle the action altogether, the choice must fall in favour of the former as it is the only way to promote decision-making. In the present case also if the two Election Commissioners are able to reach a unanimous decision, there is no need for the Chief Election Commissioner to participate, if not the doctrine of necessity may have to be invoked.

17. We think that is the only alternative in such a situation. We are, therefore, of the opinion that the proper course to follow is that the Chief Election Commissioner should call a meeting of the selection Commission to adjudicate on the issue of disqualification of Ms. J. Jayalalitha on the groans alleged by Dr. Swamy. After calling the meeting he should act as the Chairman but then he may recuse himself by announcing that he would not participate in the formation of opinion. If the two Election Commissioners reach a unanimous opinion, the Chief Election Commissioner will have the opinion communicated to the Governor. If the two Election Commissioners do not reach a unanimous decision in the Matter of expressing their opinion on the issue referred to the Election Commission, it would be necessary for the Chief Election Commissioner to express his opinion on the doctrine of necessity."

(Emphasis Supplied)

24. In *M/s. Kwaliti Restaurant and Ice Cream Co. v. The Commissioner of VAT, Trade and Tax Department*, (2012) 194 DLT 195 (DB), the Assessee therein had its appeal heard by a two-member Appellate Tribunal at a time when the Appellate Tribunal comprised of three members. The hearing of the appeal was more or less concluded and it was at the stage of final arguments when the third member of the Appellate Tribunal joined the proceedings. An objection was immediately raised by the Assessee therein to the expansion of the Coram of the Appellate Tribunal to include the Member (Technical) who had till then been away on account of leave or absence and had not participated in the hearing. With the Appellate Tribunal negating the objection, the Assessee filed a writ petition in this Court questioning the correctness of the said order of the Appellate Tribunal. This Court took note of the fact that under Regulation 35(3) of the Appellate Tribunal Regulations, there can be a situation where the full Coram of the Appellate Tribunal is not available since one or more members could withdraw on the ground of conflict of interest vis-a-vis the subject matter of the proceedings before the Appellate Tribunal. The relevant portion of the said judgment is reproduced hereunder:-

"8. The Petitioner's grievance is simple enough; it contends that once the Tribunal - which at the relevant time consisted of two functioning members, the

third having gone on leave-heard its appeals, substantially and the arguments of the revenue were scheduled, it was not open, mid-stream, as it were, for a change in composition of that body. Its argument is of prejudice, since the third member joining the proceeding, does not have the benefit of hearing its submissions. The revenue's argument is that the Tribunal is a composite body of three members; whatever its compulsions in hearing the appeals during the absence of one member, the moment she returned, there is no irregularity in all the three members participating in the hearing, so long as the hearing has not concluded. It also argues that there is no power with the Chairman of the Tribunal to constitute benches, or hear appeals in composition of less than the full membership of that body."

The Court further proceeded to observe that the conspectus of the Delhi Value Added Tax Act, 2004 and the Appellate Tribunal Regulations reveal that an Appellate Tribunal discharges judicial functions. Even if there were anomalies in the provisions, anything which tends to undermine the public confidence in the Appellate Tribunal has to be "shunned and wherever necessary, cured". In the facts and circumstances, the Court passed an order forbearing the third Member (Technical) from participating in the proceedings in the appeal in question any further and also directed the appeal to be disposed of by the Appellate Tribunal comprising two members who heard it at the first place. This decision underscores that the legislative intent was that of continuity of the Appellate Tribunal and not its cessation because of a vacancy in its membership. The relevant portion of the said judgment is reproduced hereunder:-

9. Facially, the provisions of the Act and Regulations suggest that the Tribunal, whenever it consists of a plurality of members has to hold sittings en-banc. However, at the same time, Sections 73(4) contemplates a situation where a vacancy might arise in the membership of the Tribunal. This is not perceived to be an impediment in its functioning or cause such a hiatus as to require a separate provision, to enable the existing members to continue with their functioning. Nor does the statute ordain a minimum quorum for the hearing of appeals. It, therefore, appears that the statute is neutral about the consequences which follow in the event of a member's absence from the Tribunal for a temporary period, as in this case. This aspect is important, because the absence of any prohibition either in the negative form, enjoining members from functioning and hearing appeals during the absence of one of them, or absence of a provision mandating a minimum quorum, implies that the Legislature did not contemplate a logjam, in the Tribunal's functioning. The argument of the revenue about a restrictive class of cases which deals with absence of a member, i.e. in terms of Regulation 35, is insubstantial. For one, that Regulation is not part of the statute; secondly, it states an obvious rule, which all members of judicial and quasi judicial bodies have to follow. Its absence would in no whit undermine the principle it gives shape to. It would be useful to recollect that every Tribunal is clothed with incidental and ancillary powers to effectuate its orders, and W.P.(C) 5621/2012 carry out its functions effectively (Ref Union of India v. Paras

Laminates (P) Ltd. AIR 1991 SC 696). Thus, a temporary absence of one of the members of the VAT Tribunal can, by no stretch of the imagination, result in its becoming dysfunctional, or being unable to function.

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14. In view of the above discussion, this Court hereby directs the Delhi VAT Tribunal to forbear hearing of Appeal Nos. 81-83/ATVAT/11-12 in the composition it had on 29-8-2012 and 7-9-2012, and continue the hearing with the two members (i.e. the Chairman and Mr. D.C. Anand) according to its previous composition, when the matter was part heard, and the petitioner's arguments had been concluded, on 27-8-2012. It is clarified that Ms. Nita Bali, Member (Administrative) shall not participate in the proceedings; she is however entitled to sit and hear all other cases in which she was a participant, either before her leave of absence, or after her re-joining the Tribunal, except in part heard cases or appeals, like in the present instance."

(Emphasis Supplied)

25. In *Talluri Srinivas v. Union of India*, Ministry of Corporate Affairs, the Division Bench of this Court following *Kwality Restaurant (supra)* directed the matters to be heard by four members whereas the Chartered Accountants Act, 1947 provides the Appellate Authority to comprise of five members. The relevant portion of the said judgment is reproduced hereunder:-

"19...The CA Act does prescribe that the Appellate Authority will be a body constitute of five persons, but does not prescribe and does not fix a minimum quorum. The statute is silent on the procedure to be followed and adopted when one or more members cannot participate. In absence of a provision and stipulation to the contrary, quorum in such cases is in order and complete when majority of the members are present and participate. Therefore, if one of the members of the Appellate Authority for valid and good reason has recused and does not want to participate, hearing in the appeal can proceed and would not suffer invalidity on the ground of lack of quorum.

20. In the present case no vacancy has arisen which can be filled up as the said fifth member has neither resigned nor has been removed. There is no provision in the enactment to fill up "vacancy" by recusal in a particular case by any other mode. Temporary absence or recusal of a member in a particular appeal, would not make the Appellate Tribunal dysfunctional till a new member is appointed, which as recorded above as per the CA Act is impermissible....

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33. The rationale behind the Rule is that the litigation cannot be a non sequitur. In other words, there cannot be a litigation system in which it is impossible to litigate a given case. It is on the aforesaid principle that we have examined the statutory provisions of the CA Act and the effect of recusal of one member of the five-members of the Appellate Authority and held that recusal will not stall

hearing and decision of the Appeal. Contention of lack of quorum on account of recusal of one member of the five member Appellate Authority for the aforesaid reasons fails and is rejected."

(Emphasis Supplied)

26. In *Bharat Bijlee Limited v. Commissioner of Trade and Taxes*, (2016) 231 DLT (CN) 2 (DB), the Division Bench of this Court, following *Kwality Restaurant* (supra), directed the hearing to be conducted by two members instead of three members of Appellate Tribunal under Delhi Value Added Tax Act. The relevant portion of the said judgment is reproduced hereunder:-

"...17. Turning to Section 73(4) of the DVAT Act, it is seen that the legislative intent is to ensure continuity of the functioning of the AT even if a vacancy is caused in the membership of the Act. The wording of Section 73(4) of the Act makes this position explicit. It states that the Government will endeavour to fill up the vacancy "as soon as practicable". It does not say that till such time the vacancy is not filled up, the AT cannot function as such. In the absence of any prohibition in the AT functioning as such with the remaining members when a vacancy is caused, it cannot be presumed that an AT with a lesser number of members than those appointed initially cannot function as an AT.

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20. In *Kwality Restaurant & Ice Cream Co. v. Commissioner, VAT* (supra), this Court took note of the fact that under Regulation 35(3) of the AT Regulations, there can be a situation where the full quorum of the AT is not available since one or more members could withdraw on the ground of conflict of interest vis-a-vis the subject matter of the proceedings before the AT. It was observed by the Court as under:"

21. The Court further proceeded to observe that the conspectus of the DVAT Act and the AT regulations reveal that an AT discharges judicial functions. Even if there were anomalies in the provisions, anything which tends to undermine the public confidence in the AT has to be "shunned and wherever necessary, cured". In the facts and circumstances, the Court passed an order forbearing the third Member (Technical) from participating in the proceedings in the appeal in question any further and also directed the appeal to be disposed of by the AT comprising two members who heard it at the first place. The decision in *Kwality Restaurant & Ice Cream Co. v. Commissioner, VAT* (supra) underscores that the legislative intent was that of continuity of the AT and not its cessation because of a vacancy in its membership.

22. As far as the present case is concerned, the Court finds that it is only on account of the vacancies created by the removal of the two of the three members comprising the AT, that the remaining single Member (Judicial) had to function as AT with effect from 1st August 2013. Since he was the only member, there was no question of constituting benches by issuing a notification under Section 73(9)

of the DVAT Act. Also in terms of Section 73(1) of the DVAT Act, since one or more members could function as an AT, there was no illegality attached to the single Member functioning as an AT. This is also in consonance with the legislative intent behind Section 73(4) of the DVAT Act which contemplates continuity of the proceedings before the AT notwithstanding the vacancies created in its membership.

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29. The Court is of the view that on a collective reading of Section 73(1), (4) and (9) of the Act together with the AT Regulations, the position that emerges is that as long as there is only one remaining member of the AT by virtue of the others being either removed or the vacancies not being filled up, such member can, subject to being otherwise qualified, validly function as an AT.

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32. The result of the above discussion is that the Court negatives the plea of the Assessee and holds that the single Member (Judicial) could validly function as the AT between 1st August 2013 and 20th July 2014. Further, even assuming that during the aforementioned period he lacked jurisdiction, the de facto doctrine would apply and the decisions taken by him during the said period shall not be invalidated."

(Emphasis supplied)

27. In *Radio Next Webcast Pvt. Ltd. v. Union of India*, (2018) 254 DLT 660, this Court held that the absence of Member Technical (Copyright), does not in any manner impinge upon the jurisdiction of the Appellate Board as constituted under Section 83 of the Trade Marks Act and a conjoint reading of Section 11 of the Copyright Act and Section 83 of the Trade Marks Act clearly indicates that the Appellate Board as constituted under Section 83 of the Trade Marks Act would also have the jurisdiction to perform the functions under the Copyright Act as well. The relevant portion of the said judgment is reproduced hereunder:-

"1. The petitioner has filed the present petition, inter alia, impugning an Administrative Order dated 16.05.2018 (impugned order) passed by the Registry of Intellectual Property Appellate Board (hereafter "the Appellate Board") declining to place the petitioner's application filed under Section 31D of the Copyright Act, 1957 (hereafter "the Copyright Act") before the Appellate Board. The impugned order indicates that the petitioner's application is declined on the ground that there is no technical member (copyright) to place the application before the Appellate Board and, therefore, till such time that a technical member (copyright) is appointed, the matters relating to Copyright Act would not be listed before the Appellate Board.

2. Ms. Shiva Lakshmi, counsel appearing for the respondents states that steps are being taken for appointing a technical member (copyright) in terms of Rule 3 of the Copyright Rules, 2013 and states that advertisement for such posts have

been issued and is it expected that such appointment would be made shortly.

3. Although, a technical member (copyright) has not been appointed as yet, it is not disputed that the Appellate Board is functional and is hearing the matters with regard to the Trademarks Act, 1999 as well as the Patent Act, 1970.

4. The only question that falls for consideration of this Court is whether the Appellate Board, as presently constituted, has the jurisdiction to examine matters relating to the Copyright Act.

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10. Having stated the above, it may be apposite for the respondent to also appoint a member technical (copyright), however, a vacancy in this regard does not in any manner impinge upon the jurisdiction of the Appellate Board as constituted under Section 83 of the Trade Marks Act.

11. A conjoint reading of Section 11 of the Copyright Act and Section 83 of the Trade Marks Act clearly indicates that the Appellate Board as constituted under Section 83 of the Trade Marks Act would also have the jurisdiction to perform the functions under the Copyright Act as well. There is no dispute that an Appellate Board has been validly constituted in terms of Section 84 of the Trade Marks Act and is now functional. Thus, it is also required to "exercise the jurisdiction, powers and authority conferred on it by or under this Act the Copyright Act".

12. In the aforesaid view, the impugned order is unsustainable and is, accordingly, set aside. It is directed that the petitioner's application be placed before the Appellate Board as is currently constituted. The Appellate Board shall examine the same in accordance with law.

13. The petition is disposed of in the above terms. All pending applications stand disposed of."

28. In *Natco Pharma Limited v. Union of India*, S.L.P.(C) Nos. 1323-1337/2008, there was no Technical Member in the Intellectual Property Appellant Board (IPAB). The Supreme Court vide order dated 01st October, 2008 appointed Dr. P.C. Chakraborti, Deputy Controller of Patents & Designs as Technical Member (Patent) of IPAB for hearing the particular appeal. The relevant portion of the order is reproduced hereunder:-

"A piquant situation has arisen in this case on account of absence of Technical Member in the Intellectual Property Appellant Board (IPAB) constituted under the provisions of Section 116 of the Patents Act, 1970.

On 2nd April, 2007, Central Government appointed S. Chandrasekaran as Technical Member (Patent) of IPAB vide notification of even date. On 3rd April, 2007, notification was issued notifying 2nd April, 2007 as the date for transfer of appeals pending before any High Court to IPAB. The appeals were transferred to the IPAB by the High Court vide its order dated 4th April, 2007. On 16th June, 2007, Misc. Petition Nos. 1 and 2 of 2007 were filed by respondent No. 4 herein

before IPAB praying for the appointment of another Technical Member in place of S. Chandrasekaran on the ground that the said Member had earlier filed an affidavit in the matter taking a particular position in the dispute which has a direct bearing on the case in hand.

It is under these peculiar facts and circumstances of the case and, particularly, in view of the fact that the controversy involved before IPAB is concerning crystal modification of a N-Phenyl-2-Pyrimidineamine derivative and since the dispute is regarding patentability of the process as well as the product that we are of the view that such complicated disputes need to be resolved by IPAB which must have a Technical Member in it.

In the above facts and circumstances of this case only and without making our order a precedent for future cases, we called for a panel/list of Controllers duly qualified under Section 116 of the Patents Act, as amended by the Patents (Amendment) Act, 2006. From that list submitted to us, we have opted for the name of Dr. P.C. Chakraborti, Deputy Controller of Patents & Designs, who holds post-graduate degree of M.Sc.(Chemistry) as well as Ph.D. We, accordingly, direct that all preliminaries will be completed by the parties in the month of October, 2008 and the IPAB duly reconstituted under our orders, which would include Dr. P.C. Chakraborti, would hear and decide the pending Appeal Nos. TA/001/2007/PT/CH to TA/005/2007/PT/CH preferably in the month of November, 2008. We direct the IPAB to list the above Appeals before it for directions on 3rd November, 2008. The matter will be heard and disposed of on day-to-day basis.

As a special case, Dr. P.C. Chakraborti will continue to be the Member of the said Board till the hearing and final disposal of the said appeals. He will be the Member of the IPAB only for the said Appeals."

29. In *Kudrat Sandhu v. Union of India*, W.P.(C) No(s). 279/2017, the Supreme Court vide order dated 11th May, 2018 extended the term of the President and the other members of National Consumer Disputes Redressal Commission (NCDRC) till fresh appointments are made by the Central Government.

30. In *Roger Mathew v. South Indian Bank Ltd.*, S.L.P.(C) 15804/2017. the Supreme Court vide order dated 29th May, 2019 extended the term of a Judicial Member of National Consumer Disputes Redressal Commission by one year or till the process of fresh appointment is completed, whichever is earlier.

Discussions and Findings

31. IPAB was established on 15th September, 2003. IPAB has jurisdiction to deal with the matters under the Patents Act, Trade Marks Act, Copyright Act and Plant Varieties Protection Act. As per Section 84(2) of the Trade Marks Act, the IPAB Bench comprises of one Judicial Member and one Technical Member (Trade Marks). For cases relating to the Patents Act, the Bench shall comprise of a Judicial Member and a Technical Member (Patents); for cases relating to the

Copyright, the Bench shall comprise of a Judicial Member and a Technical Member (Copyright) and for cases relating to the Plant Varieties Protection, the Bench shall comprise of a Judicial Member and a Technical Member (Plant Varieties Protection).

32. This Court is pained to note that no Technical Member (Copyright) has been appointed till date. The post of Technical Member (Patents) is lying vacant since 04th May, 2016 whereas the post of Technical Member (Trade Marks) is lying vacant since 05th December, 2018. IPAB has only one Technical Member relating to Plant Varieties Protection.

33. About 3935 cases are pending adjudication before IPAB across all its Benches. However, cases relating to trademarks, copyrights and patents are not being taken up as there is no Technical Member relating to those specialties. The term of a patent is only 20 years and in many cases, due to lack of Coram, the patents have expired and the matters have become infructuous and rights of parties have been severely prejudiced.

34. Section 84(2) of the Trade Marks Act provides that the IPAB Bench shall comprise of a Judicial Member and a Technical Member. However, the Statute is silent on the procedure to be followed and adopted when there is a vacancy of a Technical Member or a Technical Member is there but he cannot participate.

35. This Court is of the view that the doctrine of necessity has to be invoked in the present case. The legislative intent is of the continuity of IPAB and not its cessation because of a vacancy in its technical membership. If the post of the Technical Member is lying vacant, IPAB can proceed to hear the urgent matters and the orders passed would not suffer invalidity on the ground of lack of Coram.

36. Applying the doctrine of necessity and following the principles laid down in Election Commission of India (supra), Kwaliti Restaurant (supra), Talluri Srinivas (supra) and Bharat Bijlee Limited (supra), this Court holds that the Chairman, IPAB and the Technical Member (Plant Varieties Protection) are competent to hear the urgent matters relating to the Patents, Trade Marks and Copyright till the vacancies of other Technical Members are filled up and the orders passed would not suffer invalidity on the ground of lack of Coram.

37. If the Technical Member (Plant Varieties Protection) is not available for any reason or recuses, Chairman, IPAB can proceed to hear the urgent matters.

38. In Patent matters, the Chairman, IPAB is at liberty to take the expert opinion of a scientific advisor from the panel of scientific advisors notified under Section 115 of the Patents Act.

39. The Chairman, IPAB shall ensure compliance of these directions to ensure continuity of the functioning of the IPAB. Conclusion

40. The Chairman, IPAB and the Technical Member (Plant Varieties Protection) are directed to take up the stay application of the petitioner for hearing in terms

of this order and endeavor to decide the same within a period of six weeks.

41. The Chairman, IPAB and the Technical Member (Plant Varieties Protection) are at liberty to take up other urgent matters relating to the Patents, Trade Marks and Copyright.

42. List for directions on 20th August, 2019.

43. The petitioner's submission mentioned in paras 8.2 and 8.3 and the suggestions of the learned amicus curiae shall be considered on the next date of hearing.

In para-38 of the above-mentioned guidelines, IPAB is at liberty to take the expert opinion.

9. The present appeal has been filed under Section 117-A read with Section-15 of the Patents Act, 1970 against the impugned order dated 16.08.2019 passed by the Deputy Controller of Patents & Designs, Patent Office, New Delhi revoking the Patent in 276026 granted on the Patent Application No. 3951/DELNP/2009 in the Post Grant Opposition under Section 25(2) of the Patents Act, 1970 filed by M/s. Natco Pharma Limited, who is the respondent No. 3 (hereinafter to be referred as 'Natco').

10. It is claimed by the appellant inter alia that Ceritinib is a novel and inventive compound which has been given International Non-proprietary Name (INN) of Ceritinib being a New Chemical Entity (NCE). None of the prior arts disclose Ceritinib, subject matter of the patent IN 276026. The claims in the patent are limited to pyrimidine compounds having two phenyl rings attached to 2nd and 4th position to the pyrimidine ring via amine groups wherein the phenyl group attached to Pyrimidine ring at the second position is tri-substituted (i.e. R6, R8 and R9 may not be hydrogen atom) and one of R8 and R9 is pyrrolidinyl, piperidinyl or azetidiny, each of which is attached to the phenyl ring via a carbon atom. This combination of tri-substituted phenyl ring and heterocyclic group attached to the phenyl ring via a carbon atom is one of the novel features of the presently claimed compound.

It is stated on behalf of appellant that the novelty and inventive step of the compound subject matter of EST 276026 was stated as under:

"The present Patent claims novel pyrimidine compounds having two phenyl rings attached to the pyrimidine ring via amine groups wherein the phenyl group attached to pyrimidine ring at the 2-position is tri-substituted (i.e. R6, RB and R9 may not be hydrogen atom) and one of RB and R9 is pyrrolidinyl, piperidinyl or azetidiny, each of which is attached to the phenyl ring via a carbon atom. This combination of the tri-substituted phenyl ring and the heterocyclic group attached to that phenyl ring via a carbon atom is one of the distinctive features of the presently claimed compounds".

11. In the appeal, the respondent No. 3/Natco has filed the counter-affidavit of

Madineedi Adinarayan, where the case of the appellant was denied. On merit, inter-alia, the case of Natco is that from the documents on record, the Controller has correctly arrived at the conclusion that Ceritinib is disclosed by prior art, especially IN'653 which was published as WO'980. The appellant alleges that the novelty or inventive step lies in pyrimidine compounds having two phenyl rings attached to 2nd and 4l position to the pyrimidine ring via amine groups wherein the phenyl group attached to pyrimidine ring at the second position is tri-substituted (i.e. R6, R8 and R9 may not be hydrogen atom). It was also claimed that the combination of trisubstituted phenyl ring and heterocyclic group attached to phenyl ring via carbon atom is one of the novel features of the claimed compounds. However, this feature is already found in IN'653 as well as IN'650. The Controller correctly appreciated the fact that these features are found in the prior art and revoked the patent.

The Controller correctly appreciated the facts on record and concluded that the claims especially the compounds of IN'026 are found in IN'560 and as such, the claims of IN'026 lack novelty and inventive step.

It is denied by the respondent No. 3 that the novelty of the invention claimed in IN 276026 ("IN'026") lies in combination of tri-substituted phenyl ring and the heterocyclic group of either R6 or R9 attached to phenyl ring via carbon atom. It is submitted that this feature already exists in the prior art. An example compound from the prior art IN 232653 ("IN'653") is shown.

It is stated by the respondent No. 3 that the prior art does not disclose the Ceritinib compound. It is also denied that the prior art is limited to pyrimidine compounds having 2 phenyl rings attached to the 2n and 4l position of the pyrimidine ring via amine groups. It is denied that the combination of trisubstituted phenyl ring and heterocyclic group attached to the phenyl ring via carbon atom is the novel feature of the compounds claimed in IN'026. To the contrary, such compounds were already available in the prior art.

12. These only few facts which are mentioned in order to give overall picture about the dispute pending between the parties and to decide the present application.

13. By the impugned order dated 16.08.2019, the Controller has revoked the patent IN'026 on the ground of "lack of novelty". In view of finding of lack of novelty, the Controller has also held that the patent lacks inventive step and is also not patentable under Section 3(d) of the Act as far as merit of the case is concerned.

14. It is also alleged on behalf of appellant that the respondent No. 2 has allowed Rule 138 application and the evidence while allowing the opposition without taking into account the evidence in rebuttal filed by the patentee on 9th July, 2019. It is also a matter of fact that in the two affidavits filed by the appellant in order to rebut the additional evidence filed by the Natco has not been considered at all.

15. In the present case, firstly it is admitted position that the Hon'ble High Court of Delhi after discussing the law, particularly on the issue of doctrine of necessity, in the case of Mylan (supra) has allowed to hear the urgent Patent matters by the Chairman and Technical Member, who was appointed under the Plant and Varieties Act. The relevant paras already reproduced. It was also ordered that in the absence of Member due to certain reasons, even the appeal can be heard by the Chairman alone. Secondly, two scientific experts' opinions of the parties from the recognized board are already placed on record by both parties. The said fact has not been denied by the counsel for the respondent No. 3. It is true that in para-38 of the Mylan order (supra), IPAB was granted liberty to take the expert opinion of a scientific advisor. Thirdly, the Hon'ble High Court in the Writ Petition on 29.1.2020 has issued the directions to decide the appeal expeditiously.

16. Section 115 of the Act provides that in any suit for infringement or in any proceedings before a court may at any stage to appoint an independent scientific advisor to assist the court or to enquire and report upon any such question of fact or if opinion as it may formulate for the purpose. The said provision applies in the cases of infringement of Patent or any other proceedings pending before the court. IPAB is not the court.

17. Suit for infringement of Patent is being heard by the Single Bench of the Hon'ble High Court. The chairman of IPAB is the retired judge of the High Court. During his tenure, he had dealt with large number of enforcement actions for infringement of Patents.

18. It appears that in Mylon case (supra), the Hon'ble Court was not dealing with the facts of present case nor aware that two expert opinions are already on record. In fact the present appeal was filed on 16th August, 2019, the Mylon order was passed on 08/07/2019 even before passing the impugned order. The order dated 29.01.2020 does not direct the IPAB to appoint another expert despite of two expert opinions are already on record.

19. It is admitted by both parties that two reports of independent scientific advisers are already obtained by the parties and are placed on record which have to be gone through while passing the orders after hearing both parties. Section 115 of the Act does not mandate that in every case scientific adviser is to be appointed, rather it says that the court may appoint, if so needed.

20. In the present case, many issues involved are of civil nature. As far as interpretations of claims of the patent in hand are concerned, the law is quite settled. IPAB has already got two expert opinions of advisors.

21. It is a matter of fact that two opinions of individual scientific advisers are already placed on record. Another scientific advisor is not necessary at this stage. We are directed by the order dated 29/01/2020 to decide the appeal on urgent basis. It appears to us that the respondent No. 3 is trying to delay the hearing of the appeal.

22. Considering the overall facts and circumstances, we are not inclined to grant the relief sought in the present application. The same is devoid any merit and is dismissed. It is clarified that during the course of hearing if any more expert opinion is required (apart of two opinions already available) the appropriate order would be passed.

23. list on 10.08.2020 by video conference.