

(2019) 02 DEL CK 0240

In the Delhi High Court

Case No : Civil Writ Petition No. 5022 Of 2017, Civil Miscellaneous Application
No. 21659 Of 2017

ONYX Therapeutics, Inc

APPELLANT

Vs

Union Of India & Ors

RESPONDENT

Date of Decision : 22-02-2019

Acts Referred:

Patents Act, 1970 — Section 7(1A), 14, 25(2), 25(3), 43, 77(a), 77(1)(a), 79
Trade Marks Act, 1999 — Section 129
Patents Rules, 2003 — Rule 55A, 57, 58, 59, 60, 62, 137

Citation : (2019) 78 PTC 189

Hon'ble Judges : Suresh Kumar Kait, J

Bench : Single Bench

Advocate : Anil Dutt, Gunjan Hans, Manish Mohan, Manisha Saroha, J. Sai
Deepak, Afzal B. Khan, Eashan Ghosh

Final Decision : Disposed Off

Judgement

1. The present petition is preferred for quashing the impugned orders dated 12.05.2017 and 11.04.2017 passed by the respondent No. 2 and restore the order dated April 10, 2017. Consequently, enable the petitioner to cross-examine Dr. Surajit Sinha and Dr. Prachi Tiwari prior to a final hearing on merits in the Section 25(2), Patents Act proceeding initiated by the respondent No. 3 against Patent No. 255964.

2. Further seeks direction thereby directing the respondent No. 2 to pass an order on the petitioner's objections/reply dated 05.06.2015 to taking on record the additional testimony of Dr. Prachi Tiwari as filed by the Respondent No. 3 on 17.04.2015, prior to any final hearing on merits in the Section 25(2), Patents Act proceeding initiated by the Respondent No. 3 against Patent No. 255964.

3. The brief facts of this case are that the petitioner is a company incorporated under the laws of the United States, having its registered office now at One Amgen Center Drive, Thousand Oaks, California, 91320-1799, USA and engaged

in the research, development and commercialization of novel therapeutics that target protein degradation pathways for cancer and autoimmune diseases. The respondent No. 2 is an officer under the Office of the Controller General of Patents, Designs and Trade Marks, DIPP, acting on behalf of said Controller General, with respect to granting patents in the Delhi branch of the Indian Patent Office. Respondent No. 3, is a non-government company registered in India and has initiated a post-grant opposition under Section 25(2) of the Patents Act, to invalidate the granted Indian Patent No. 255964, issued to Proteolix Inc., which was subsequently acquired by the petitioner herein. As per the company master data available on the website of the Ministry of Corporate Affairs, the registered address of the respondent No. 3 is in Bhikaji Cama Place, New Delhi. Proteolix Inc. at 225 Gateway Boulevard, South San Francisco, CA 94080 (US), filed an international application under the Patent Cooperative Treaty, bearing No. PCT/US05/012740 dated 14.04.2005 and pursuant thereto, moved an application under Section 7(1A) of the Patents Act on 27 September 2006 bearing No. 5644/DELNP/2006, seeking a patent in India based on aforesaid international application. The said patent application was titled "Compounds for enzyme inhibition" and as the abstract indicates, the invention claimed therein are expected to display therapeutic utilities, including anti-inflammatory properties and inhibition of cell proliferation ("Patent Application"). Said Proteolix Inc. was subsequently acquired by the petitioner herein. The said Patent Application was duly examined under the Patents Act and the office of the Respondent No. 2 issued a first examination report ("FER") under Section 14 of the Patents Act on 13.10.2011, listing out several objections against the grant of a patent on the Patent Application. All said objections were replied to and addressed vide response dated 10.10.2012. The respondent No. 2, after having concluded that the Patent Application has complied with all requirements of the Patents Act, proceeded to grant a patent bearing no. 255964 ("Petitioner's Patent"), on 09.04.2013, which grant was also published under Section 43 of the Patents Act, on 12.04.2017. Petitioner's Patent is annexed herewith as Annexure P-4 (colly).

4. It is further case of the petitioner is that on 07.04.2014, the petitioner received a copy of the post-grant opposition under Section 25(2) of the Patents Act read with Rule 55A of the Patents Rules, 2003 as filed by the respondent No. 3 ("Opposition"), which relied upon, inter alia, an expert affidavit from Dr. Surajit Sinha dated 31.03.2014. Dr. Surajit Sinha's opinion is that the petitioner's Patent No. 255964 is invalid. The contents of Dr. Surajit Sinha's affidavit are strongly relied upon in the opposition. Since the opposition documents are voluminous, after seeking an extension of one month to file a reply to the Opposition, on 03.07.2014, the petitioner filed a reply under Rule 58 to the aforesaid Post-Grant Opposition and among others, sought cross-examination of Dr. Surajit Sinha.

5. The petitioner also challenged the accuracy of the statements made by such expert, the expert's credibility and expertise in the technology at issue. On 01.09.2014, respondent No. 3 filed additional evidence under Rule 59 of the Patents Rules in support of the Opposition, comprising a new affidavit of Dr.

Prachi Tiwari and an additional affidavit of Dr. Surajit Sinha. Dr. Prachi Tiwari is admittedly affiliated with the respondent No. 3 and had expressed her opinion that the Petitioner's Patent No. 255964 is invalid. A copy of said reply under Rule 59, including the affidavit of Dr. Prachi Tiwari and the additional affidavit of Dr. Surajit Sinha, are as Annexure P-7 (Colly). Subsequently, on 17.04.2015, respondent No. 3 filed additional evidence under Rule 60 of the Patents Rules in support of the Opposition, comprising an additional affidavit of Dr. Prachi Tiwari supporting the challenge to the validity of the patent. This reply was responded to on 05.06.2015 by the petitioner, whereby the petitioner opposed the additional evidence from being taken on record. The respondent No. 3 also filed a rejoinder to such reply, on 18.06.2015. On 27.03.2017, vide e-mail, the respondent No. 2 forwarded a copy of the recommendation of the Opposition Board constituted under Section 25 (3) of the Patents Act, a copy of which is enclosed as Annexure P-11. Vide the same email dated 27.03.2017, the respondent No.2 simultaneously notified the hearing date as April 21, 2017 for final disposal of the Opposition. Starting with such email dated 27.03.2017, several email communications were exchanged between the parties to the writ petition, including the impugned orders. In response to the email of 27.03.2017, on 07.04.2017, the petitioner requested cross-examination of Dr. Surajit Sinha and Dr. Prachi Tiwari be deferred until then. The respondent No. 2 accepted such request vide e-mail communications on 08.04.2017 and 10.04.2017, and directed the respondent No. 3 to notify the date on which the witnesses will be made available for cross-examination. However, before the hearing date, based on a response from the respondent No. 3 that the petitioner should move a formal application to this effect on 10.04.2017, the respondent No. 2 directed the petitioner to file a formal petition for cross-examination. However, even before the petitioner could make such a petition, on 11.04.2017, the respondent No. 2 issued one of the impugned orders, denying the request for cross-examination and intimated that the hearing on merits would take place as scheduled on 21.04.2017. In view of the personal difficulty of the lead counsel and agent representing the petitioner, on 17.04.2017, the petitioner moved a request for adjournment of the hearing. A copy of the said request for adjournment and an additional letter dated 18.04.2017 are annexed as Annexure P-13 (colly). Vide several e-mails dated 18.04.2017 exchanged between the petitioner, respondent No. 2 and respondent No. 3, the adjournment request filed by the petitioner was ultimately allowed by the respondent No. 2 and vide an e-mail dated 19.04.2017, accordingly, the respondent No. 2 re-notified the hearing date as 19.05.2017. Though, the order dated 11.04.2017 of the respondent No. 2 appeared to reject the request for cross-examination, based on the direction on 10.04.2017 to move a formal petition/application for cross-examination, on 19.04.2017, the petitioner filed a formal petition under Rule 137 of the Patents Rules, 2003 and Section 77(a) seeking cross-examination of Dr. Surajit Sinha and Dr. Prachi Tiwari. A copy of said petition/application is enclosed as Annexure P-14. The respondent No. 3 filed a response to this petition/application, inter alia, alleging mala fides on the petitioner and objecting to the maintainability of

such a petition, which response is annexed herewith as Annexure P-15. The petitioner filed a short rejoinder to such reply, denying any allegations of mala fides and reiterating its request for cross-examination. The respondent No. 3 further filed a sur-rejoinder to the same.

6. Learned counsel for the petitioner submits that since no order was passed on the said petition/ application for cross-examination and the hearing date of 09.05.2017 was fast approaching, the petitioner, vide e-mail dated 12.05.2017, sent a reminder to the respondent No. 2 concerning the petition for cross-examination filed on April 19, 2017. On the very same day, without any opportunity of hearing being granted to the petitioner, the respondent No. 2 issued the second impugned order of 12.05.2017, denying the request for cross-examination made in the petition filed on 19.04.2017.

7. Learned counsel further argued that the issue involved in the present petition is "whether the Patentee can cross-examine the expert witness(es) of the Opponent in a post-grant opposition under the Patents Act, 1970 and the rules framed thereunder". The petitioner is aggrieved by two communications of respondent No.2 dated 11.04.2017 and 12.05.2017, whereby the said Respondent has *Suo moto* withdrawn the permission granted to the patentee (the petitioner herein) vide communications dated 08.04.2017 and 10.04.2017, to cross-examine the expert witnesses of the Opponent (Respondent No. 3 herein). Learned counsel further submitted that neither under the provisions of the Patents Act, 1970, nor under the Patent Rules, 2003, the respondent No. 2 has the *suo moto* power of reviewing its decision. Since the permission granted by the Respondent No. 2 vide its communications dated 08.04.2017 and 10.04.2017 to cross-examine the witnesses of the Opponent was pursuant to Section 79 of the Act, the same cannot be referred to as a clerical error, which could have been reversed/undone *suo moto* by the respondent No. 2. Hence, once permission was granted by the Respondent No. 2, the said decision could not have been reviewed and the permission withdrawn. Section 79 of the Act confers express power upon the respondent No. 2 to take oral evidence in addition to evidence by way of an affidavit or allow a party to be cross-examined on the content of his/her affidavit. Section 79 of the Act is reproduced below for reference:-

"79. Evidence how to be given and powers of Controller in respect thereof. - Subject to any rules made in this behalf, in any proceeding under this Act before the Controller, evidence shall be given by affidavit in the absence of directions by the Controller to the contrary, but in any case in which the Controller thinks it right so to do, he may take oral evidence in lieu of, or in addition to, evidence by an affidavit, or may allow any party to be cross - examined on the contents of his affidavit."

8. Learned counsel further submitted that Indian Patent No. 255964 (hereinafter referred to as the "Petitioner's patent") was granted on 09.04.2013. A post-grant opposition under Section 25(2) of the Act, read with Rule 55A of the Rules was

filed by the Respondent No. 3 on 07.04.2014. The said opposition was supported by an affidavit of an expert, Dr. Surajit Sinha dated 31.03.2014 which was filed as evidence in the opposition proceedings. Dr. Sinha in his affidavit has analyzed the Petitioner's patent, compared the same with prior arts and has thereafter given his opinion that the invention claimed therein is allegedly "obvious based on knowledge already available". In response to the post-grant opposition, the reply statement under Rule 58 of the Rules on behalf of the Petitioner was filed on 03.07.2014, wherein, at paragraph 42 which is at page 221, the petitioner categorically sought cross-examination of Dr. Surajit Sinha on his evidence by way of an affidavit. It may be pertinent to mention that the Petitioner did not file any evidence along with its reply statement.

9. Rule 59 of the Rules reads as follows:-

"59. Filing of reply evidence by opponent. - The opponent may, within one month from the date of delivery to him of a copy of the patentee's reply statement and evidence under rule 58, leave at the appropriate office evidence in reply strictly confined to matters in the patentee's evidence and shall deliver to the patentee a copy of such evidence."

10. Learned counsel for the petitioner submits that according to Rule 59 of the Rules, the evidence which may be filed on behalf of the opponent upon receiving the patentee's reply statement must be strictly confined to matters in the patentee's evidence. In the present case, since the petitioner had not filed any evidence along with its reply statement, there was no occasion or reason for the respondent No. 3 to file reply evidence under Rule 59. However, the respondent No. 3 filed an application dated 01.09.2014, whereby the said respondent prayed to place on record additional evidence by way of affidavit of a new expert namely Dr. Prachi Tiwari and a second affidavit of Dr. Surajit Sinha. In the said application, the respondent No. 3 has admitted that the evidence of the experts are beyond the scope of Rule 59 of the Rules. Admittedly, the said application dated 01.09.2014 for taking the evidence by way of an affidavit is yet to be heard by the respondent No. 2.

11. Learned counsel further submitted that without prejudice to the fact that the said affidavits are yet to be taken on record, it is submitted that in his second affidavit, while responding to paragraph 42 of the reply statement, Dr. Surajit Sinha has not objected to the request to be cross-examined. In particular, Dr. Sinha has not stated that he would be prejudiced in any manner if he is called for cross-examination, rather, Dr. Sinha states that he will show as to how the Patentee is himself denying certain facts.

12. Learned counsel further submitted that despite the pending adjudication of abovementioned application for filing of reply evidence under Rule 59 by the respondent No. 2, the respondent No. 3 on 17.04.2015 filed a petition for filing additional evidence under Rule 60 of the Rules. In the said petition under Rule 60, the respondent No. 3 has sought to place on record a second evidence of its

expert Dr. Prachi Tiwari by way of an affidavit supporting the invalidity of the petitioner's patent. The petitioner vide its reply dated 05.06.2015 vehemently opposed the respondent No. 3's request of filing additional evidence under Rule 60. Admittedly, the said petition of the respondent No. 3 under Rule 60 of the Rules is yet to be decided by the respondent No. 2.

13. The pleadings on behalf of the parties stood completed in the year 2015, admittedly, there was no communication between the parties until 27.03.2017, on which date the petitioner received an e-mail notice from the respondent No. 2 intimating the petitioner about the hearing fixed in the post grant opposition on 21.04.2017. Thereafter, vide email dated 31.03.2017, the petitioner made a request to the respondent No. 2 for cross-examination of Dr. Surajit Sinha and Dr. Prachi Tiwari prior to the final hearing. Accordingly, the respondent No. 2 vide email dated 08.04.2017 granted request of the petitioner and deemed it proper to direct the respondent No. 3 to call upon the expert witnesses of the respondent No. 3 for being cross-examined. Further vide order dated 10.04.2017, the respondent No. 2, while relying on Section 79 of the Act, reiterated its order and called upon the respondent No. 3 to present the said witnesses for cross-examination. Thereafter, based on an email dated 10.04.2017 sent by the respondent No. 3, the respondent No. 2, in a reply email recalled its earlier orders dated 08.04.2017 and 10.04.2017 and directed the petitioner to file a formal petition for seeking cross-examination of the respondent No. 3's witnesses. However, before the petitioner could file the said application, the respondent No. 2 issued the impugned order dated 11.04.2017. Moreover, on 19.04.2017, the petitioner filed an application requesting the respondent No. 2 to allow the petitioner to cross-examine the witnesses of respondent No. 3, which was denied by the respondent No. 2 vide order dated 12.05.2017.

14. Learned counsel further submitted that at the very first instance of responding to the opposition filed by the respondent No. 3, the petitioner in its reply statement had explicitly stated its intention to cross-examine the expert witness whose testimony was relied upon by the respondent No. 3. The application under Rule 59 of the Rules dated 01.09.2014, whereby the respondent No. 3 was trying to place on record the affidavit of a new witness i.e. Dr. Prachi Tiwari and additional affidavit of Dr. Surajit Sinha was yet to be adjudicated upon by the respondent No. 2, and hence no response to the same was filed by the petitioner. Even otherwise, the rules do not prescribe for any such response. Thereafter, to the petition filed by the respondent No. 3 under Rule 60, the petitioner has already filed its response, objecting thereto.

15. It is further submitted that cross examination is an integral part of the principles of natural justice. In a case wherein the credibility of a person who has testified is in doubt, right to cross-examination is inevitable, except if real prejudice is caused to the complainant. In the present case, admittedly no prejudice has been alleged by the respondent No. 3.

16. Section 79 of the Patent Act is reproduced as under:-

"79. Evidence how to be given and powers of Controller in respect thereof. - Subject to any rules made in this behalf, in any proceeding under this Act before the Controller, evidence shall be given by affidavit in the absence of directions by the Controller to the contrary, but in any case in which the Controller thinks it right so to do, he may take oral evidence in lieu of, or in addition to, evidence by an affidavit, or may allow any party to be cross - examined on the contents of his affidavit."

17. Learned counsel submits that the explicit power has been conferred upon the respondent No. 2 to call upon witnesses for cross-examination in appropriate cases. In the facts of the present case, if no permission is granted to the petitioner to cross-examine the expert witnesses, the said provision would be rendered redundant. No averment has been made by the opponent that any prejudice will be caused if the witnesses are called for cross examination.

18. He further submitted that case of Swastick Pipes Ltd. v. T.T. Industries & Ors: (2000 PTC 66) and Financial Times Ltd v. Times Publishing House Ltd.: [234 (2016) DLT 305] are not applicable in the present case for the reason that the said two judgments relate to provisions of the Trade Marks Act, 1999, wherein admittedly there is no provision to cross-examine the witnesses. Section 129 of the TMA referred to in the judgment of Financial Times Ltd (supra) is reproduced herein below for the "ready reference" as under:-

"129. Evidence before Registrar. - In any proceeding under this Act before the Registrar, evidence shall be given by affidavit: Provided that the Registrar may, if he thinks fit, take oral evidence in lieu of , or in addition to, such evidence by affidavit."

19. Accordingly, the petition deserves to be allowed.

20. Merely because the petitioner has not filed its evidence, which is also directory under Rule 58 of the Rules, will not ipso facto mean that the petitioner would be disentitled to cross-examine the witnesses of Respondent No. 3. The deposition of the witnesses are not on the facts of the case but is an opinion dealing with the technical nature of the invention.

Therefore, the cross-examination is part & parcel of principles of natural justice and denial of an opportunity to cross-examine the witnesses of respondent No. 3 would cause grave prejudice to the petitioner, wherein, no prejudice shall be caused to the respondent No. 3, if said cross-examination is allowed.

21. On the other hand, learned counsel appearing on behalf of respondent No. 3 submits that it is settled law that the right to cross examine in any proceedings before any IP Tribunal, including the Patent Office, is not an inherent or statutory right. In patent proceedings it is available under Section 79 of the Patents Act, 1970 only at the discretion of the Controller of Patents provided the Controller is satisfied that there exists a sufficient cause to warrant cross examination.

Keeping in view, the facts of the present petition, the Controller has applied his mind and concluded that there is no need for a cross-examination. In the present petition, the petitioner seeks a direction to respondent No. 2 to allow cross-examination of the witnesses of respondent No. 3 mentioned above. Seeking such a direction, the petitioner has based its prayers on the premise that there exists, as part of principles of natural justice, an inherent right of cross-examination in its favour merely because the respondent No. 3 has led expert evidence. This premise is fundamentally erroneous in view of the express provisions and scheme of the Patents Act, 1970 which are in parimateria with the provisions of the Trademarks Act, 1999 and have been interpreted in landmark decisions in case of Swastick Pipes Ltd (supra) and The Financial Times Ltd. And Ors.(supra).

22. A reading of the said judgments which were rendered in the similar provisions in other IP legislations leads to the following well-settled principles in respect of the right to cross-examine. (a) the proceedings before IP Tribunals are largely inquisitorial in nature and cannot be compared to the adversarial nature of the proceedings before a Civil Court. Critically, Courts have accepted that the Evidence Act has no application to enquiries conducted by Tribunals, even though they may be judicial in character as held in Financial Times (Supra). It is further held that the proceedings before IP Tribunals are summary and are, therefore, largely decided on the basis of documentary evidence and evidence affidavits, as opposed to conventional recordal of oral evidence. (b) there is no provision in IP legislations which expressly provides for the right of cross-examination of one party when expert evidence is filed by the other party. As a consequence, there is no inherent right of cross examination in favour of one merely because the other party to the proceedings had tendered affidavits by way of evidence. Such a procedure would not be in violation of principles of natural justice given the object of the proceedings, namely expeditious disposal. A party seeking cross-examination of experts of the other party must at the very least file evidence affidavits of its experts in reply to counter the evidence led by the other party. Even after such expert evidence is filed by the party seeking cross-examination, the Controller can exercise his discretion disallowing cross-examination, should he conclude that there is no sufficient cause to warrant the same.

23. It is further submitted that right to allow cross-examination must be used sparingly for strong and bonafide reasons and must not be treated as a norm in each case where expert evidence affidavits are filed, since that would defeat the object of expeditious disposal of such proceedings as held in Financial Times (Supra) and Swastick Pipes (Supra).

24. It is further submitted that the scheme of entire Patents Act, including and especially the provisions that apply to the conduct of Post Grant Opposition proceedings would reveal that each of the above positions of law squarely applies to the conduct of proceedings before the respondent No. 2 as well. The principal function of the Controller and other officers under the Act is to discharge duties

as a specialized tribunal towards addressing questions of validity of patents granted under the Act. The scheme of provisions under Sections 25(2), 77 and 79 of the Act read with Rules 55A-62 and 137 of the Patent Rules, 2003 clearly reveals the following:

- a) Rule 55A- Any interested person (the Opponent) may within one year of the grant of the patent file opposition to the grant of the patent in the prescribed manner;
- b) Rule 57- The opponent shall, along with the notice of opposition, file a written statement setting out its challenge along with any evidence;
- c) Rule 58- The Patentee shall file a reply statement setting out the grounds upon which the Patentee intends to contest the challenge as raised by the Opponent along with evidence if any, within two months from the date of receipt of copy of the opponent's written statement and evidence;
- d) Rule 59 - The Opponent may then respond to the patentee's reply statement and evidence by evidence in reply within one month from the date of delivery of the reply statement and evidence;
- e) Rule 60 - Either party may, with the leave of the Controller and before the date of hearing is fixed under Rule 62, file further evidence;
- f) Rule 56 - Upon receipt of the notice of opposition the Controller shall constitute an Opposition Board of three members to examine the notice of opposition and all the documents filed under Rules 57 to 60. The Opposition Board shall submit a report with its reasons on each ground taken in notice of opposition along with its joint recommendation within three months from the date on which the documents were forwarded to them;
- g) Rule 62 - On the completion of the presentation of evidence and on receiving the recommendation of the Opposition Board or at such other time as the controller may fix a date and time for the hearing of opposition. The parties desirous of being heard shall inform the Controller in the prescribed form, failing which the Controller shall without hearing or, in the event parties notify the Controller, after such hearing and taking into consideration the recommendations of the opposition board, decide the opposition and notify his decision giving reasons thereof;
- h) The use of the term Evidence in Rules 55A - 62 must be understood in light of the special provision which exists in and applies to the conduct of proceedings before the Controller, namely Section 79. The said provision expressly states that evidence in any proceeding under the Act shall be given on affidavit. It further provides that the Controller may take oral evidence or may allow any party to be cross examined on the contents of his affidavit. Clearly, the allowance of a cross-examination is not mandatory and is subject to the exercise of the Controller's discretion.

25. Learned counsel appearing on behalf of the respondent No. 3 further submitted that in application dated 19.04.2017 under Section 77(1)(a) and Rule 137, the petitioner has failed to furnish strong and bonafide reasons for the respondent No. 2 to have exercised its discretion in favour of the petitioner. In an application dated 26.05.2014 filed by the petitioner seeking extension of time to file expert evidence and submitted that it was in the process of identifying an expert. However, the petitioner never filed any expert evidence. Instead, the petitioner made its request for cross-examination of the respondent No. 3's expert Dr. Surajit Sinha for the first time in its written statement dated 03.07.2014 under Rule 58. The respondent No. 3, in its evidence in reply dated 01.09.2014 under Rule 59, objected to the petitioner's request for cross-examination. Thereafter, the respondent No. 3 filed an application for further evidence under Rule 60 for an additional affidavit of Dr. Prachi Tiwari on 17.04.2015, regarding another patent application of the Petitioner under No. 768/DELNP/2007. The said further evidence was objected to by the petitioner on 05.05.2015 and was responded to by the respondent No. 3 on 18.06.2015. Subsequently to the completion of pleadings in June 2015, the Controller constituted the Opposition Board, and forwarded all the material filed by both Parties to the Board for its recommendations. From July 2015 until March 2017, there were no reminders or follow-ups from the petitioner to the respondent No. 2 seeking to cross-examine the experts of the respondent No. 3.

26. It is evident from the above that the petitioner's request for cross-examination which was made vide email dated 07.04.2017 was subsequent to the recommendation of the Board when the matter was poised for final hearing. Even the said request was made via a cryptic email to the Respondent No.2 without marking the Respondent No.3 with a view to prevent objections from the Respondent No.3 to the said request. Based solely on the said email, the Respondent No.2 vide email dated 08.04.2017 directed the Respondent No.3 to produce its witnesses for cross-examination. A reminder was sent to the Respondent No. 3 on 10.04.2017, which is the order sought to be restored by the petitioner in prayer (a) of the petition. The respondent No.3 objected to the said direction on 10.04.2017 giving detailed reasons for disallowing the request for cross-examination. On the same date, the Respondent No.2 directed the petitioner to file a formal application setting out sufficient reasons to allow cross-examination. Subsequently, pursuant to the said reasoned objection raised by the Respondent No.3, the Respondent No.2 disallowed the request for cross-examination vide email dated 11.04.2017 and fixed the matter for hearing on 21.04.2017.

27. It is pursuant to the said disallowance of 11.04.2017 and without preferring an appeal against the said order that the Petitioner filed its application under Section 77(1)(a) read with Rule 137 seeking cross-examination of both experts of the Respondent No.3. In other words, by filing the said application without preferring an appeal or reserving its rights to challenge the order of 11.04.2017, the Petitioner had effectively accepted the finality of the order dated 11.04.2017.

Pursuant to the application the Respondent No.3 filed its reply dated 20.04.2017 and pleadings on the subject were completed as on 25.04.2017. Therefore, the petitioner's prayer (a) which challenges the order of 11.04.2017 and seeks restoration of the Order dated 10.04.2017 has been rendered infructuous pursuant to its own subsequent application dated 19.04.2017, coupled with the fact that the Order of 11.04.2017 was reasoned and hence not challenged.

28. Further, by seeking to cross-examine both experts on all their affidavits and without raising any further objections to the further affidavit of Dr. Prachi Tiwari filed under Rule 60, the Petitioner has effectively given up its objection to the filing of the further affidavit by Dr. Prachi Tiwari. This results in rendering prayer (b) of the Petitioner infructuous.

29. Learned counsel appearing on behalf of the respondent no.3 submits that the petitioner's application dated 19.04.2017 was dismissed by a reasoned order by the Respondent No.2 on 12.05.2017, which is the second order challenged in prayer (a) of the Petition. It is submitted that in passing the order of 12.05.2017 the Respondent No.2 has exercised his discretion and has applied his mind to the application and has come to the clear conclusion that there is no case made out for cross-examination of either expert. Further, the Respondent No.2 had already assured both parties via email dated 12.04.2017 that during the course of the final hearing, if any new issue arises will be addressed during the hearing in accordance with law, thereby preserving the right of both parties to air their respective grievances. It is further submitted that cross examination in proceedings before the Patent Office is a right subject to the discretion of the Controller of Patents. The exercise of such discretion disallowing the Petitioner an opportunity to cross examine would not render such order to be susceptible to challenge since it is not mandatory for witnesses to be cross examined. The orders passed by the Respondent No.2 have been exercise of its discretion which is within the scope of statute. Accordingly, the writ petition deserves to be dismissed.

30. I have heard learned counsel for the parties in length and perused the record on file.

31. In case of Financial Times Ltd. (supra), it has been recorded that since the affidavits are required to contain only the facts and not opinions expressed, the request for cross-examination is to be sparingly granted. Even in such a case, there is no absolute bar for cross-examinations. Likewise, in case of Swastick Pipes Ltd. (supra), it has been held that under the Trade Mark Act, there is no exclusive and vested right to cross-examine a deponent.

32. In contrast, under the Act, Section 79 categorically grants the discretion to the respondent No. 2 to permit the parties to cross-examine the witnesses. The present case is highly technical in nature, wherein the expert witness of the respondent No. 3 has provided his/ her view/ opinions/ analysis of different prior art documents/ literature relied upon him/ her to opine that the invention

claimed under the Petitioner's patent is not novel and is obvious in light of the prior art. Such technical analysis conducted by the expert witness(es) and his opinion thereto, cannot constitute facts per se. Therefore, in such cases wherein the request of cross-examination is prayed for, the same ought to be granted.

33. In the present case, the petitioner has challenged the validity of the analyses of the said witnesses at the very outset, and thereafter at every opportunity provided to it under law. Therefore, in a proceeding where in the facts and circumstances of the case the credibility of the witnesses is in question or in doubt or its statement is in dispute, the denial of an opportunity for cross-examination shall amount to violation of principles of natural justice and vitiate the entire proceeding.

34. Vide emails dated 08.04.2017 and 10.04.2017, while relying on Section 79, the respondent No. 2 had exercised its discretion and held that cross-examination of witnesses of respondent No. 3 was required. Once the respondent No. 2 had conclusively held that cross-examination was required, the respondent No. 2 could not have, in the absence of any new documents/ developments/ evidence suggesting so, formed a completely opposite prima facie view that it is not required. It is a settled position in law that if the law provides for a particular manner in which a particular thing is to be done, it should be done in that way only and none other. Admittedly, in the present case, no application was filed by the respondent No. 3 for review of said orders, and thus, the action of the respondent No. 2 in reviewing its own decision suo moto, is without jurisdiction and a manifest error of law, as held in the case of *Dipak Babaria and Another v. State of Gujarat and Others*: (2014) 3 SCC 502.

35. I note, the petitioner had filed application dated 26.05.2014 seeking extension of time to file expert evidence, however, nothing has been filed whereas the respondent no.3 has filed two affidavits of two experts named above.

36. In view of above discussion, settled position of law and facts and circumstances of this case, I hereby pass directions as under:

i. Orders dated 12.05.2017 and 11.04.2017 are set aside. Consequently, restored order dated 10.04.2017.

ii. Respondent no.2 shall allow the petitioner to cross examine the two expert witnesses of respondent no.3, but after the petitioner filed affidavits of experts by controverting the opinion of expert witnesses of respondent no.3.

iii. Respondent no.2 shall also give right of cross examination, if sought by respondent no.3, to cross examine the expert witness(es) of the petitioner.

iv. The petitioner shall file affidavit of expert(s) within four weeks, from the receipt of this order.

37. In view of above directions, the writ petition is allowed.

CM APPLN. 21659/2017

38. In view of the order passed in the present writ petition, this application has been rendered infructuous and is accordingly, disposed of such.