

(2019) 12 DEL CK 0399

In the Delhi High Court

Case No : Civil Writ Petition No. 12105 Of 2019

Pharmacyclics Llc

APPELLANT

Vs

Union Of India And Ors.

RESPONDENT

Date of Decision : 17-12-2019

Acts Referred:

Citation : (2019) 12 DEL CK 0399

Hon'ble Judges : Prathiba M. Singh, J

Bench : Single Bench

Advocate : Pravin Anand, Archana Shanker, Dhruv Anand, Udit Patro, Kaya, Rohan Anand, Rajeshwari, Saif Rahman Ansari

Final Decision : Disposed Of

Judgement

Prathiba M. Singh, J

CM APPL. 54097/2019

1. The main writ petition has been disposed of vide judgment dated 20th November, 2019.

2. In the present application, the Petitioner/Patentee (hereinafter, 'Patentee') seeks relief to the effect that the further facts, arguments and

evidence, which have been cited by Respondent No.3/Opponent (hereinafter, 'Opponent'), in their written submissions dated 9th December, 2019

and in their presentation dated 22nd November, 2019, ought not to be taken on record, inasmuch as it is impermissible to raise fresh arguments during

the course of hearing.

3. In support of the application, Id. counsel for the Patentee has placed on record the original statement of opposition, the additional evidence of Mr. B.

M. Choudhary dated 19th September, 2019, the power point presentation dated

22nd November, 2019 and the written submissions dated 9th

December, 2019, to submit that there is a great variance in the manner in which the prior art documents are sought to be interpreted in these versions

being filed by the Opponent.

4. It is submitted that the original notice for opposition cited few molecules which have been dealt with by the Patentee in its reply statement.

However, as the case is progressing, the Opponent is citing more and more molecules and varied molecules, without giving any opportunity to the

Patentee to rebut the same. It is thus the submission of the Id. counsel for the Patentee that such fresh arguments and evidence ought not to be taken

on record.

5. In response, Id. counsel for the Opponent submits that the new molecules which are being objected to by the Patentee are contained in the

document titled WO/2018/0868 and the said family of patents. She submits that the original submission in the notice of opposition is that the compounds

exemplified by this patent and the family have phenoxyphenyl group attached at C-3 position and substituted heterocyclic moiety at N-1 position of 4-

amino pyrazolo [3,4-d] pyrimidine nucleus.

6. She submits that even in the new documents i.e., the written submission and the power point presentation, all that the Opponent has done is highlight

the same argument through illustrative depictions of various molecules. Nothing fresh is argued, according to the Id. counsel for the Opponent.

7.] This Court has perused the above four versions of the Opponent's case which has been presented. The fundamental submission of the Opponent

is as under:

Table 4: Representative Compounds of WO/2018/0868

It can be seen from the above Table, that the compounds exemplified by WO/2018/0868 have phenoxyphenyl group attached at C-3 position and

substituted heterocyclic moiety at N-1 position of 4-amino pyrazolo [3,4-d] pyrimidine nucleus. Therefore, it can be clearly seen that compounds

having phenoxyphenyl group attached at C-3 position of pyrazolo [3,4-d] pyrimidine nucleus are already well established and well known in prior art

for tyrosine kinase inhibitory activity.

Thus it is well established that the compounds having pyrazolo [3,4-d]

pyrimidine nucleus attached at N-1 position with substituted piperidine ring, C-3 position with phenoxy phenyl group and C-4 position an amino group are already known for their tyrosine kinase inhibitory activity for the treatment of autoimmune diseases, inflammatory conditions and cancer.

Hence, all aspects of compounds of the impugned Patent as claimed in claims 1 and 2 are obvious by disclosure in prior art and do not have any inventive merit.â??

8. The above extract is from the original notice of opposition which was filed by the Opponent. According to the Opponent, the molecules extracted in tabular form are representative of the phenoxyphenyl attachment at the C-3 position, as stated in the opposition itself. The same has been further illustrated by citing various examples in the additional affidavit of Mr. B. M. Choudhary, as also the power point presentation and the written submissions.

9. Since the Opponent specifically submits before the Court that all the molecules which have been objected to as being fresh evidence are only in support of the above argument made in the original notice of opposition, as extracted above, this Court is of the opinion that the same does not constitute fresh evidence. However, since the molecules have been exemplified in the written submissions and in the powerpoint presentation, the

Patentee is granted an opportunity to rebut the same, on or before 10th January, 2019. The Patentee may file written submissions or deal with these

molecules in the form of a note and file the same before the Patent Office. It is submitted that the hearing already stands concluded on 22nd

November, 2019. Upon the filing of the written submissions/note by the Patentee, the Patent Office shall decide the post-grant opposition

expeditiously, in accordance with law.

10. With these observations, the application is disposed of.