

(2014) 06 IPAB CK 0009

In the Intellectual Property Appellate Board

Case No : OA/26/2013/PT/KOL

Syntonix Pharmaceuticals, Inc.Vs Controller Of Patents & Designs

Date of Decision : 27-06-2014

Acts Referred:

Patents Act, 1970 — Section 16, 16(3)

Citation : (2014) 06 IPAB CK 0009

Hon'ble Judges : K.N. Basha, J;D.P.S. Parmar, Technical Member

Bench : Division Bench

Advocate : Shukadev Khuraijam

Final Decision : Disposed Of

Judgement

K.N. Basha, J

1. Challenge in this appeal is the order passed by the Assistant Controller of Patents & Designs dated 21.03.2013 dismissing the divisional application preferred by the appellant herein seeking for the relief of patent in respect of Group-1 claim consisting of 1 to 28 claims.

2. Shri. Shukadev Khuraijam, the learned counsel for the appellant would vehemently contend that the impugned order of the Assistant Controller is liable to be set-aside on the sole ground of illegality to the effect that in the First Examination Report it is clearly and categorically stated that the claims numbering 1 to 28 under group 1 are distinct inventions and the same contains plurality of invention and as such on the basis of the original patent application, the patent was granted by the Controller only in respect of the Group-IV claims from No. 61 to 84. The learned counsel would point out that only because of the objection raised by the Controller and more particularly the patent was granted only for Group-IV claims No. 61 to 84, the appellant has been compelled and necessitated to file a divisional application as per the provisions of Section 16 of the Patents Act, 1970.

3 . It is contended that instead of rejecting the application, the Assistant Controller ought to have directed the appellant to file an amended application as

per the Provision under Section 16(3) of the Patents Act. Therefore it is contended that the divisional application was filed only at the instance of controller and it is not open to the Assistant Controller to reject the divisional application on the ground that the inventions for which the patent was granted already under Group-4 are similar and identical to Group-1 which is self contradictory.

4. The learned counsel would also submit that the principles of estoppel is applicable in this matter as the Assistant Controller himself raised objection earlier holding that Group-1 Claims 1 to 28 are distinct and now he is estopped from holding that both the inventions namely under Group-1 claims 1 to 28 and under Group-IV claims 61-84 are identical.

5 . We have given our careful and anxious consideration on the contentions put forward by the learned counsel for the appellant and also perused the impugned order coupled with the documents available namely the First Examination Report and other materials.

6. On the perusal of the impugned order, it is crystal clear that the Assistant Controller has given a finding to the effect that the inventions under Group-1 are similar and identical to that of the patent granted in respect of Group-IV claims 61-84 which is self contradictory to the findings and objections raised in the First Examination Report. Therefore, we have no hesitation to hold that the appellant filed the divisional application only on the basis of the objection and on the basis of the finding given in the First Examination Report and there is absolutely no fault on the side of appellant. The Assistant Controller instead of throwing away the application by passing an order of refusal, should have exercised power under Section 16(3) and given an opportunity to the appellant to file an amendment.

7 . At the out set, we are constrained to state the undisputed fact that as per First Examination Report dated 16.07.2010 it is specifically stated in Para 7 hereunder:

Claim 7-Claims define a plurality of distinct inventions. Group-1 claims 1-28, 54 (part), 91, 102, 103 (A chimeric protein comprising a first and a second polypeptide chain wherein the first chain comprises a biologically active molecule and a portion of immunoglobulin constant region with FcRn binding site and wherein the second chain comprises only a portion of immunoglobulin constant region with FcRn binding site or immunoglobulin variable region.

In the same para it is further stated as Group IV is hereunder:

Group IV-Claims 61-84, 106-111 (A chimeric protein of formula...having a biologically active molecule, a linker, a portion of immunoglobulin constant region with FcRn binding site.

8. The above said specific categorical statement made in the First Examination Report makes it crystal clear that the objection was raised by the Assistant

Controller itself to the effect that Group-1 Claims 1-28 are distinct and different and therefore on the basis of the original patent application, the appellant was granted patent under Group-IV viz. claims 61 to 84. The said finding of the objection raised by the Controller only necessitated the appellant to file the divisional application as per provision of Section 16 of the Patents Act, 1970.

9. It is also pertinent to note that the perusal of the impugned order reveals that the Assistant Controller has given only vague finding to the effect that claims have already been granted without specifying the exact claim.

10. In view of the aforesaid reasons, we are constrained to set-aside the impugned order dated 12 March 2013. Consequently, it is open to the appellant to file an amended claims and the appellant shall be given reasonable opportunity to put forth his case in order to avoid embarrassment to the learned Assistant Controller to pass the impugned order. We are of the view the amended application shall be considered by some other Assistant Controller. It is made clear that the Assistant Controller shall dispose of the matter within a time frame of six months.