
(2025) 04 DEL CK 1095

In the Delhi High Court

Case No : Writ Petition (C) IPD No. 10 Of 2024, Civil Miscellaneous Application
No. 21 Of 2024

Vertex Pharmaceuticals Incorporated

APPELLANT

Vs

Controller General Of Patents, Design, Trademark And
Geographical Indications & Ors

RESPONDENT

Date of Decision : 30-04-2025

Acts Referred:

Patents Act, 1970 — Section 11A, 14, 25(1), 43(1), 80
Patents Rules, 2003 — Rule 128, 129

Citation : (2025) 04 DEL CK 1095

Hon'ble Judges : Saurabh Banerjee, J

Bench : Single Bench

Advocate : Pravin Anand, Tusha Malhotra, Archana Shanker, Sugandha Yadav

Final Decision : Allowed

Judgement

Saurabh Banerjee, J

Preface:

1. By way of W.P.(C)-IPD 10/2024, the petitioner seeks to challenge the notice dated 08.12.2023 issued by the Assistant Controller General of Patents, Designs, Trademark and Geographical Indications/ respondent no.2 "Controller" in Indian Patent Application no.202017026584 "subject Patent Application". By way of W.P. (C)-IPD 12/2024, the petitioner seeks to challenge the order dated 05.04.2024 passed by the Controller in Miscellaneous Petition under Section 80 of the Patents Act, 1970 "the Act" read with Rules 128 and 129 of the Patents Rules, 2003 "the Rules", in relation to the subject Patent Application.

2. Since both writ petitions are qua the same Patent Application no.202017026584 filed by the petitioner before the respondent no.1, and common issues arose therein, both writ petitions, with consent of the parties, were heard together and are thus being adjudicated vide this common judgment.

3. Succinctly put, an interesting issue has arisen before this Court relating to the effect of filing a Pre-Grant Opposition under Section 25(1) of the Act before the Controller after the Patent Application of the patentee has been allowed and the Patent has been granted by the Controller, particularly, since it has been duly signed and acknowledged so, but yet not uploaded on the official website "ipindia.gov.in" of the Indian Patent Office "the Rules". In effect, the issue pertains to "Whether the Pre-Grant Opposition is maintainable after the grant of the Patent by the Controller under such circumstances?".

Brief Facts:

4. The petitioner is a global biotechnology company engaged in scientific innovation to create transformative medicines for serious and life-threatening diseases and has made significant strides in the area of cystic fibrosis.

5. In continuation of its research efforts, the petitioner developed a compound useful for treating a cystic fibrosis trans-membrane conductance regulator (CFTR) mediated disease such as cystic fibrosis. It is for the process of preparing this compound, the petitioner filed the subject National Phase Application no. 202017026584 on 23.06.2020 arising from a PCT application no. PCT/US2018/063451 with an international filing date of 30.11.2019, claiming priority from European Patent Office application, with a priority date of 01.12.2017 before the IPO.

6. The said Patent Application was published as per Section 11A of the Act on 02.10.2020, whereafter, the petitioner on 29.11.2021 filed a request for examination with the IPO in respect thereof. Resultantly, on 04.01.2022, the IPO issued a First Examination Report, which, upon receiving response, was set down for hearing on 13.11.2023 under Section 14 of the Act.

7. The Controller, after considering the arguments advanced by the petitioner and the written submission filed on record, vide an order dated 28.11.2023 and uploaded later on the same day at around 17:25:16.423 hours as per the affidavit filed by the respondent nos.1 and 2, proceeded with grant of Patent in favour of petitioner holding as under:-

"... ..Based on the above facts, submission and observations in the case, all objections have been met. No further objection is pending with this application. The application is published under section 11A. No pre-grant opposition is filed. I, therefore, hereby proceed with grant of patent for the instant patent application no. 202017026584 with six (1-6) claims given in the written submission filed on 24/11/2023 with heading "202017026584-Written submissions and relevant documents [24-11-2023(online)].pdf".

[Emphasis supplied]

8. Interestingly, on 28.11.2023 itself, however, after passing of the aforesaid order by the Controller, i.e. after grant of the Patent in favour of the petitioner, the respondent no.3 at around 17:18:17.813 hours, as per the affidavit filed by

the respondent nos.1 and 2, filed a Pre-Grant Opposition against the subject Patent application. This resulted in issuance of the impugned notice dated 08.12.2023, which is under challenge before this Court in W.P.(C)-IPD 10/2024.

9. Prior thereto, and aggrieved thereby, the petitioner filed a Miscellaneous Petition under Section 80 of the Act read with Rules 128 and 129 of the Rules before the Controller. After hearing and considering the arguments advanced as well as taking note of the written submissions in support thereof by both petitioner and respondent no.3, the Controller passed the impugned order on 05.04.2024 holding as under:-

"... ..(V) Upon meticulous review of the MP and subsequent response to the MP, the Controller is now in a position to make a decision on the matter. As stated earlier, it was mentioned that there is a system limitation in generating the letter patent certificate, despite the Controller's intention to grant this application. In the present scenario, it was not feasible to bypass or overcome this problem as the system restriction still persists. Consequently, the Controller had no choice but to view this as a pre-grant opposition.

It is noteworthy that the instant application was intended to be granted after thorough examination of all references (prior art) cited in the Examination reports. Typically, patent applications are granted after a careful assessment of inventive step based on prior arts available in the public domain. The same procedure was followed in this instance. However, it was discovered that the opponent had submitted a pre-grant opposition with three new prior art references. These reference were not cited/retrieved by the Examiner at the time of intention to grant. Therefore, it is crucial to re-examine the patentability of the subject-matter of the current application in light of newly cited references.

Based on the facts and the arguments presented, it is evident that a decision on this application should be made following a conclusion of pre-grant opposition proceedings. The Controller holds the view that the pre-grant opposition is valid and it should be acknowledged."

[Emphasis supplied]

10. In effect, the Controller upheld the maintainability of the Pre-Grant Opposition filed by respondent no.3 and held that the subject Patent Application was liable for re-examination. The said order dated 05.04.2024 of the Controller is also under challenge before this Court in W.P.(C)-IPD 12/2024.

Submissions of petitioner:

11. Mr. Pravin Anand, learned counsel for the petitioner, has primarily commenced his arguments by contending that the order dated 28.11.2023 passed by the Controller allowing the subject Patent Application of the petitioner thereby granting Patent in its favour is final and binding. More so, whence, as per the Controller, all the objections were satisfied and no

12. Mr. Anand then contended that since the Controller had signed the order dated 28.11.2023, the Patent stood granted. Any subsequent acts, including entering the subject Patent Application in the Register of Patents or uploading it on the IPO website, are just ministerial acts evidencing the grant of the Patent. For substantiating his submission, the learned counsel placed reliance upon Dr. (Miss) Snehlata C. Gupte v. Union of India & Ors. 2010 SCC OnLine Del 2374 and Dr. Snehlata C. Gupte v. Union of India & Ors. 2012 SCC OnLine Del 2259.

13. Mr. Anand also contended that the Pre-Grant Opposition of respondent no.3 was ex-facie illegal and an abuse of the process of law,. As per Mr. Anand, in the present case, the Patent already stood granted by the Controller and, admittedly, there was no Pre-Grant Opposition filed/ pending till then, as is apparent from the impugned order dated 05.04.2024 wherein the Controller has categorically recorded that "during the period between the decision upload and certificate generation, an opposition was filed" by any party like the respondent no.3, herein. Consequently, the Pre-Grant Opposition filed by the respondent no.3 was liable to be dismissed in limine.

14. Lastly, Mr. Anand contended that after passing the order of grant of Patent on 28.11.2023, the duties of the Controller stood discharged and being functus officio, could not have taken the note of Pre-Grant Opposition filed by respondent no.3, and certainly, could not have issued the impugned notice to the petitioner. In view thereof, as per Mr. Anand, the impugned notice is ex facie illegal, arbitrary, and in contravention of Rule 55(3) of the Rules. In support of his contention, he placed reliance on Dhaval Diyora v. Union of India and Ors. 2020 SCC OnLine Bom 2550.

15. Lastly, Mr. Anand contended that both the writ petitions, in view of the aforesaid position, are liable to be allowed.

Submissions of respondent nos.1 and 2:

16. Per contra, Ms. Radhika Biswajit Dubey, learned counsel for respondent nos.1 and 2 did not dispute that the Controller allowed the subject Patent Application of the petitioner and granted the Patent in its favour. But, based on the timelines involved, Ms. Dubey contended that in view of passing of the order as also the filing of Pre-Grant Opposition by respondent no.3, particularly, as the same was filed during the period of uploading of the order passed by the Controller and generation of Certificate thereupon and that there was, admittedly, a delay due to systemic restrictions which prevented generation of Patent Certificate apropos the order of 28.11.2023, the Controller had no other option but to accept Pre-Grant Opposition of respondent No.3 and issue the impugned notice therein.

Submissions of respondent no. 3:

17. Mr. J. Sai Deepak, learned senior counsel for the respondent No.3, refuting the arguments of Mr. Anand, contended that the order dated 28.11.2023 passed by the Controller to proceed with grant of Patent cannot be construed as final,

and unless such order is published/ uploaded on the IPO website, it cannot be said that there has been a grant of a Patent.

18. As per Mr. Deepak, the grant of a Patent must be the date and time of uploading or publication of the order passed by the Controller on the IPO website, and not the date and time when the same is signed by the Controller. More so, since the order intending grant of the Patent by the Controller is a digital order with no physical signature of the Controller, the said order only becomes effective when the order is published/ uploaded.

19. Consequently, Mr. Deepak contended that the Pre-Grant Opposition filed by the respondent no.3 was valid as it was filed before the grant was effectuated. If this was not the case, the said Pre-Grant Opposition would not have been considered by the e-filing portal of IPO.

20. Mr. Deepak then contended that Section 25(1) and Section 43(1) of the Act only mention the 'date of grant' and not the 'time of grant' as the cut-off for filing a Pre-Grant Opposition. Therefore, since Pre-Grant Opposition was filed by the respondent no.3 on the same date of passing of the order dated 28.11.2023 before uploading, the same is valid and thus needed to be heard and considered by the Controller.

21. Lastly, Mr. Deepak contended that no pre-grant opponent like the respondent no.3 herein, or for that matter the general public had any recourse to know in advance about an order intending to grant of Patent in a pending Patent Application unless it was uploaded on the IPO website. Therefore, the systemic lapse on the part of the IPO cannot be held against any pre-grant opponent like the respondent no.3 herein, to render the opposition non-maintainable.

Analysis and Findings:

22. This Court has heard learned (senior) counsels for all the parties as also perused the pleadings along with the relevant documents filed in support thereof and has also gone through the relevant case law cited in support thereof.

23. As evident from the order dated 28.11.2023, admittedly, at the time of the Controller appending signatures thereon, there was/ were also no Pre-Grant Opposition by the respondent no.3 pending till then. So much so, it is also categorically recorded in the subsequent impugned order dated 05.04.2024 that the respondent no.3 had filed no Pre-Grant Opposition "... ..during the period between the decision upload and certificate generation... ..". In effect, the subject Patent Application of the petitioner already stood allowed and the Patent was deemed to have already been granted in favour of the petitioner for all purposes.

24. Thus, what was left was a mere act of ministerial formality for uploading it on the IPO website, which, in the opinion of this Court, is immaterial, as the 'date of order' can only be the actual date of passing of the said order and not the date of uploading. The 'date of order' being the relevant date, remains unchanged and unaffected by the subsequent date/ act of uploading. The Division Bench of this

Court, while dealing with a similar situation, in Dr. Snehlata C. Gupte (supra) has held as under:-

"... ..17. Prima facie we agree with the aforesaid submissions of Mr. Maninder Singh. Be as it may, we are at pains to reiterate that the date on which the patent is granted cannot be the date of issuance of certificate but has to be the date on which orders are passed by the Controller. Certificate is in the nature of execution of that order and is proof of fact that the patent has been granted which is the date on which the Controller passed the order. It is the date on which the decision is taken by the Controller on file in respect of a pre-grant opposition (either rejecting or accepting the representation) which is the determining event ascertaining the date of grant of patent. The sealing of patent and entering of the same in the register are ministerial acts which follow the Controller's act of grant of patent. The onus is on the person instituting the pre-grant opposition to be vigilant about the date of publication of the application under Section 11A of the Act and take appropriate steps for filing the representation... .."

[Emphasis supplied]

25. In these circumstances, it has only to be seen if the order dated 28.11.2023 had actually been signed by the Controller prior to filing of Pre-Grant Opposition by the respondent no.3, i.e. which was/ is prior in point of time. Since, it is undisputed as per the respondent nos.1 and 2 themselves that the order dated 28.11.2023 had already been signed by the Controller prior to the filing of Pre-Grant Opposition by the respondent no.3, and the only case made out by them is qua the uploading thereof, the same has to take precedence. Therefore, the order dated 28.11.2023 passed and also signed by the Controller prior in point of time to the filing of the Pre-Grant Opposition by the respondent no.3, was final and, the non-uploading thereof cannot take away the statutory right of the petitioner by a subsequent filing of a Pre-Grant Opposition by the respondent no.3.

26. In any event, the same and/ or the non-generation of the Patent Certificate in favour of the petitioner cannot alter the position and negate the grant of the Patent in favour of the petitioner or taking away its rights therein, more so, since the same was due to some delay on the part of respondent nos.1 and 2 in uploading of the order owing to systemic restrictions/ technical glitch at their end and not at the end of the petitioner and the petitioner cannot be made liable to suffer for the delay or faulted or blamed therefor. Furthermore, the respondent no.3 had filed the Pre-Grant Opposition on the very same day of passing of the said order dated 28.11.2023, is thus immaterial.

27. Even otherwise, after signing of the order dated 28.11.2023, the Controller had become functus officio and thus was not seized of the subject Patent Application filed by the petitioner anymore. Resultantly, the impugned notice is ex facie illegal and arbitrary. While dealing with similar circumstances, the

Bombay High Court in Dhaval Diyora (supra), held as under:-

"... ..In the present case admittedly when the petitioner filed his pre-grant opposition, there was no application pending before the Controller Therefore the Controller could not have entertained the pre-grant opposition as there was no application for grant of a patent before it. The respondents are right in contending that the Controller had become functus officio... .."

28. As such, even the IPO could not have accepted the Pre-Grant Opposition filed by the respondent no.3 and/ or issued the impugned notice to the petitioner since it was against the order dated 28.11.2023 passed by the Controller itself. Doing so, would be against the very letter and spirit of the Act. Thus, accepting the Pre-Grant Opposition filed by respondent no.3, in view of the aforesaid, was/ is not statutorily permissible and the wrongful acceptance thereof against the provisions of the Statute cannot give any right in favour of the respondent no.3. Allowing so, will result in an abuse of the process of law.

29. On a cumulative consideration of the factual matrix as also the legal position involved, reliance upon Section 25(1) and Section 43(1) of the Act by the learned senior counsel for respondent no.3 is misconceived and cannot be considered, particularly, since the time for filing a Pre-Grant Opposition already stood over as the Patent had already been granted by the Controller in favour of the petitioner.

Conclusions:

30. For the afore-going reasonings and analysis, the present writ petitions are allowed and both, the impugned notice dated 08.12.2023 and order dated 05.04.2024, issued/ passed by the Assistant Controller General of Patents, Designs, Trademark and Geographical Indications are quashed, leaving all the parties involved herein to bear their respective costs.

31. Accordingly, both the writ petitions, along with pending application(s) are disposed of.