

Perkinelmer Health Sciences Inc And Ors vs Controller Of Patents on 4 January, 2023

Author: Sanjeev Narula

Bench: Sanjeev Narula

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IN THE HIGH COURT OF DELHI AT NEW DELHI
C.A.(COMM.IPD-PAT) 311/2022
PERKINELMER HEALTH SCIENCES INC AND ORS

Through: Mr. Debashish Baner
Verma, Mr. Vineet R
Mr. Rohit Rangi, Ad

versus

CONTROLLER OF PATENTS

Through: Ms. Nidhi Raman, CG
Zubin Singh, Advoc

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA
ORDER

% 04.01.2023

1. Issue notice. Ms. Nidhi Raman, counsel for Respondent, accepts notice. Considering the preliminary jurisdictional ground of challenge urged by the Appellant, with the consent of counsel for parties, the matter has been heard for final disposal at the stage of admission itself.

2. The present appeal impugns order dated 08th February, 2019 [hereinafter, "impugned order"] whereby patent application of Appellant has been refused under section 15 of the Patents Act, 1970 [hereinafter, "the Act"], inter alia on the ground of Section 3(f) of the Act.

3. Mr. Debashish Banerjee, counsel for Appellant, argues that impugned order is liable to be set aside due to a jurisdictional error in as much as objection under Section 3(f) of the Act was raised for the first time at the time of hearing held on 08th March, 2018, with no prior notice. This irregularity is evident from the following observation in impugned order:

"5. Based on the above facts of the case, it is observed that the objections raised in paragraphs 4 and 6(a) and (b) of the hearing notice still stand along with the objection u/s 3(f) conveyed at the time of hearing. The instant application is hereby refused for the grant of patent u/s 15 of the Patents Act, 1970."

4. Mr. Banerjee also places reliance upon circular on "Examination of Patent Applications and Consideration of Report of Examiner by Controller" dated 21st September, 2011 [hereinafter, "Circular"]¹ and the judgement of this Court in Otsuka Pharmaceutical Co. Ltd v. The Controller of Patents² to contend that raising new grounds at the time of hearing is impermissible.

5. Per contra, Ms. Raman submits that the Appellant had sufficient opportunity to deal with the objection raised under Section 3(f).

6. The Court has considered the above-noted submissions and examined the impugned order. The Circular lists out obligations of Controller on receipt of objections from Examiner, relevant portion whereof reads as under:

"i. On receipt of the report and the 'draft gist of objections' from the Examiner, the Controller shall consider the report prima facie on the assumption that the Examiner's report is exhaustive.

j. However, from his professional vast experience, if the Controller is of the opinion that any major point on patentability has been inadvertently missed by the Examiner, he may add such objection(s) to the gist of objections (FER). Similarly, the Controller may also over-rule any objection raised by the Examiner. But, the Controller shall justify such addition/deletion in the note sheet.

Circular No. 4/2011 and CG/PG/Circular(Patents)/2011/468.

Neutral Citation: 2022/DHC/004092.

k. If upon Examination of the response submitted by the Applicant. the Examiner reports that some objections are still outstanding or raises further objection(s), such objections shall be communicated along with the notice of hearing, giving reasonable time to the Applicant. It is clarified that there is no need to send a second examination report.

l. At the time of hearing, the Examiner may be present. However, the Examiner shall not communicate with the Applicant and no further objections can be raised at the time of hearing."

Thus, Controller/ Examiner is not permitted to raise new grounds of objection at the time of hearing.

7. The hearing notice dated 12th February, 2018 makes no mention of objection under Section 3(f). Appellant ought to have been made aware of all grounds of objection before the hearing and afforded sufficient opportunity to contest the same at the time of hearing. It was incumbent upon Respondent to have raised this objection in the notice of hearing itself. Albeit the Appellant had submitted written submissions subsequent to the hearing and not given any response qua Section

3(f) of the Act, that does not absolve the Respondent of its obligations under the Circular to communicate objections prior to the hearing and provide reasonable opportunity to the applicant/Appellant. Objection under Section 3(f) of the Act has ex-facie been raised for the first time at hearing stage as is apparent from afore- extracted portion of the impugned order. There is thus merit in the submission of Mr. Banerjee that Respondent has violated the principles of natural justice.

8. Without getting into merits of the case, in the opinion of the Court, the above-noted irregularity vitiates the impugned order and accordingly, impugned order dated 08th February, 2019 is set aside and matter is remanded back to Respondent for fresh consideration. Respondent is directed to issue a fresh notice of hearing raising all objections, within a period of two weeks from today, in accordance with law. A hearing shall be conducted within a period of four months from the date of issuance of notice of hearing.

9. With the above directions, present petition is disposed of. All rights and contentions of the parties are left open.

SANJEEV NARULA, J JANUARY 4, 2023 nk