

Pfizer Products Inc Vs Controller Of Patents

Court: Intellectual Property Appellate Board, Chennai

Date of Decision: Oct. 31, 2014

Acts Referred: Patents Act, 1970 " Section 3(d), 3(k)

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

Bench: Division Bench

Advocate: Archana Shanker

Final Decision: Disposed Of

Judgement

K.N. Basha, J

1 . The challenge in this appeal is the order dated 27/03/2014 passed in the review application filed by the appellant as well as the original order passed

by the Assistant Controller of Patents and Designs dated 09/06/2011 in Indian Patent Application No. 991/MUMNP/2003 for a patent for ""CHIRAL

SALT RESOLUTION"" ""3-({3R, 4R)-Methyl-3-[methyl-(7H-pyrrolo[2,3-d]pyrimidin-4-yl)-amino]-piperidin-1-yl}-3-oxo-propionitrile"".

2. Mrs. Archana Shanker, the learned counsel for the appellant raised several grounds both on merits as well as on the violations of principles of

natural justice. The first and foremost contention put forward by the learned counsel for the appellant is that the learned Controller has not at all raised

the objections under section 3(d) of the Patents Act in the first examination report and as well as in the hearing notice and stated that the objection

was raised for the first time during the date of hearing and as such the non communication of the said objections caused grave prejudice as the

appellant was not in a position to respond to such objection. The learned counsel would contend that in view of the above said lapse on the part of the

learned Controller, the appellant has been compelled to file a review application pointing out the said factor of non furnishing the objections raised

under section 3(d) of the Act which would amount to error apparent on the face of the record.

3 . It is contented that the learned Controller rendered his findings mainly revolving around the objections under section 3(d) of the Act and even in the

review order the learned Controller has rendered his findings that there is no error apparent on the face of the record while passing the order dated

09/06/2011. The learned counsel would contend that in view of the above said lapse the impugned orders are vitiated on the ground of violation of

principles of natural justice. The learned counsel would also contend that there are other grounds available to the appellant in respect of the merits of

the case and pointed out that the learned Controller wrongly placed reliance on WO01/42246 cited by the European Patent Office and the same was

considered relevant in original claim classified under the category PX. The learned counsel would formally submit that the appellant has claimed only

in respect of claim 1 and 2 out of 26 claims. Therefore, it is submitted that the impugned orders are liable to be set aside and the appellant should be

granted patent as claimed by them.

4. We have carefully considered the contention put forward by the learned counsel for the appellant coupled with the materials available on the record

including the impugned orders dated 09/06/2011 and 27/03/2014 passed by the learned Assistant Controller, Patent and Designs, Mumbai.

5. The undisputed fact remains that the objections raised under section 3(d) of the Act was neither contained in the first examination report nor

mentioned in the hearing notice and the same was taken for consideration at the time of actual hearing and relied on by the Assistant Controller while

passing the impugned orders. In view of this serious lapse on the part of the learned Assistant Controller we are of the considered view that the

impugned orders are vitiated on the sole ground of flagrant violation of the principles of natural justice.

6 . Though in the impugned order the learned Controller also rendered the findings both on novelty as well as under section 3(d) of the Act, the fact

remains that the entire findings revolve around the objections raised under section 3(d) of the Act. Such being the position, we cannot go into the

merits of the case at this stage as it is desirable to give reasonable opportunity to the appellant to give their response to the objections raised under

section 3(d) of the Act which includes the right of the appellant to put forward their claims to prove the novelty also.

7 . It is well settled by the Catena of decisions rendered by this Bench that the applicants should be furnished with all the objections enabling them to

respond to such objections.

(i) This Bench has rendered decision as per order No. 74 of 2014 dated 06/06/2014 in OA/18/2011/PT/DEL- Telefonaktiebolaget LM Ericsson

(Publ). v. The Controller General of Patents, New Delhi & Anr. -- holding hereunder:--

This Board in a judgment OA/23/2010/PT/DEL Resprotect GMBH v. The Controller of Patents and Designs has held, ""it is better that the notice of

hearing indicate what are the prior art that the Controller will be referring to which the inventor has to explain and prove the patentability of the

invention.

The Controller has not given any reason. That apart, the appellant had written to the Controller on 18/06/2009 requesting to issue a gist of objections.

The First Examination Report nor the hearing notice dated 16/06/2009 raise the objection under section 3(k) of the Act.

We think the appellant should have been given an opportunity to place his submissions. The appellant should have been given an advance notice of the

objections. Having not done so there is definitely violation of principles of natural justice. We think it fit to remand the matter back to the Controller for

deciding the matter afresh in accordance with law.

(ii) In yet another decision rendered by this Bench by the order No. 42 of 2013 dated 08/03/2013 in OA/38/2011/PT/KOL - Thomson Reuters Global

Resources v. The Controller General of Patents, Designs & Trade Marks, Mumbai & Others. - holding hereunder:--

But the appellant is entitled to know what the objections are clearly, so that he can defend his patent against the objections and thereafter, it is up to

the Controller to pass appropriate orders. This is procedural fairness. The appellant must have a fair opportunity to defend his case, and for this he

must know what exactly are the objections.

8. The same view was also taken by Hon'ble High Courts. Therefore, it is crystal clear that the non furnishing of the objections raised under section

3(d) of the Act vitiates the impugned orders passed by the learned Controller on the ground of flagrant violation of the principles of natural justice. The

learned Controller failed to consider such lapse which certainly amount to error apparent on the face of the record. It is pertinent to note that in the

ground for the review application the learned counsel also press for the same stating that there is error apparent on the face of the record.

9 . In view of the aforesaid reasons, we are constrained to set aside the impugned orders dated 09/06/2011 in patent application No.

00991/MUMNP/2003 and order dated 27/03/2014 made in the review application. Consequently the Assistant Controller, Patents and Designs shall

reconsider the matter afresh by furnishing the objections well in advance to the appellant enabling the appellant to give their response both in respect

of section 3(d) of the Act and as well as in respect of novelty. The Controller shall also consider the claims of appellant which are limited to claims 1

and 2 alone out of 26 claims and the appellant shall also put forward their final claims once again. It is made clear that some other Assistant

Controller, Patents and Designs other than the Assistant Controller who passed the orders impugned shall reconsider the entire matter afresh by

affording reasonable opportunity to the appellant as stated above. It is made clear that the above said exercise shall be completed within a period of

three months from the date of receipt of this order. Consequently the Miscellaneous Petition No. 86/2014, 87/2014 and 94/2014 are closed.