

(2021) 02 IPAB CK 0015

Intellectual Property Appellate Board, Mumbai**Case No:** Original Application No. 57 Of 2014/PT/MUMNuevolution A/S Rennegade 8,
5th Floor,

APPELLANT

Vs

Assistant Controller Of Patents
And Designs,RESPONDENT

Date of Decision: Feb. 13, 2021**Acts Referred:**

- Indian Patents Act, 1970 - Section 15, 16, 57, 59, 117A

Hon'ble Judges: Dr. B.P. Singh, Technical Member; Manmohan Singh, J**Bench:** Division Bench**Advocate:** Amrita Majumdar**Final Decision:** Allowed

Judgement

1. The present appeal is filed under Section 117A of the Indian Patents Act, 1970, against the order dated 09/08/2011, passed by the Respondent,

being the then Assistant Controller of Patents & Designs, under Section 15 of the Indian Patents Act, 1970, refusing to grant the Appellant's

Indian patent application no. 178/MUMNP/2007.

2. The invention as explained by the appellant is as under:

The invention relates to a nascent bifunctional complex, a method for producing the complex and a composition comprising the complex. The nascent

bifunctional complexes comprise a chemical reaction site linked by a linking moiety to a first oligonucleotide tag identifying the chemical reaction

site. This novel feature greatly improves the applicability of the nascent bifunctional complexes as the chemical reaction site can be determined by

identifying the first oligonucleotide tag in question and is important for library synthesis applications wherein numerous different reaction sites are used.

The invention further relates to a method for synthesizing the nascent bifunctional complex. It further relates to compositions comprising the complexes.

3.Â The instant application no.178/MUMNP/2007 was filed as divisional application to the first mentioned application no. 503/MUMNP/2005 filed based on the PCT International application no. PCT/DK2003/000739.

4. The first mentioned application was examined and patent was granted with patent no. 213390.

5. This divisional application was filed with 87 claims and the First Examination Report was issued with the following main objections:

Â Subject matter of claims 1-52 (nascent bifunctional complex), 53 (method for synthesizing nascent bifunctional complex), 54 (library of nascent bifunctional complex), 55 (method for identifying nascent bifunctional complex), 56-57(composition comprising nascent bifunctional complex), 58-85

(composition) and 86-87 (use of nascent bifunctional complex) is not allowable U/s. 16(1) of the Patents Act, 1970 (as amended), as the scope of

above said claims does not fall within the scope of original claims 1-37 (method for obtaining a bifunctional complex, method for generating a library of

bifunctional complexes & method for identifying display molecule) filed in the main application (503/MUMNP/2005). Therefore, claims 1- 52, 53, 54,

55, 56-57, 58-85 and 86-87 are not allowable U/s. 16(1) of the Act.

Subject matter of claims 1-87 lacks novelty and inventive step, required U/s. 2(1)(j) of the Act, as being anticipated and obvious over document, US

5723598 (D1). The method for obtaining bifunctional complex of the present invention differs from the method disclosed in D1 only in the way how

the tag is added to the priming site. Once the tag is added to the priming site, the resulted bifunctional complex will have the same chemical structure,

independently whether the tag is added enzymatically or chemically. Therefore, the nascent bifunctional complex or a library of nascent bifunctional

complexes obtained by the method of present invention is not distinguishable from a library obtained by the method disclosed in D1.

Subject matter of claims 86 and 87 does not constitute an invention within the meaning of definition of invention U/s. 2(1)(j) of the Act, as being directed to second medical use.

Claim 54 does not characterise novel and inventive features of the invention (library) in the absence of explicit statement of the invention in respect of a library of nascent bifunctional complexes as such.

Claim 56 does not sufficiently define types of an enzyme capable of ligating first and second oligonucleotide tags, which are further defined in claim 57 that should be incorporated into the claim 56 to make it sufficient.

Subject matter of independent claim 58 and dependent claims 59-85 appears to be redundant with the subject matter of the independent claims 1 and dependent claims 2-52.

Claims 58-85 and 87 (group 1) define plurality of distinct invention, since the subject matters of inventions defined in claims 1-52, 53, 54, 55 & 56-57

(group 2) and (group 1) are not so linked to form a single general inventive concept. The single general inventive concept underlying the inventions of

group 1 and 2 can be seen as the provision of a nascent bifunctional complex comprising a chemical reaction site and a priming site. However, this

single general inventive concept is not novel because, any solution of any oligonucleotide comprises a chemical reaction site and priming site.

Therefore, this cannot serve as the special technical feature.

Claims 1-87 are not clearly worded as indicated therein and should be corrected accordingly.

6. The response of FER was considered and an opportunity of being heard was given to the applicant on 09/12/2010.

7. The following passage of the order of the respondent is worth mentioning :

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8. We have noticed that the International application was filed with claims 1-37 originally and the first mentioned application was granted with 1-146

claims; probably based on the submissions of the applicants.

9. Further, this divisional application was filed with claims 1-87 initially and the objection under section 16 inter alia on the ground of lack of

“novelty” and “inventive step” were taken. The respondent on considering the submissions of the applicant held existing claims

54 and 56 as allowable, numbering them as claim 1 and 2 respectively.

10. It is evident that the claims were not amended as per the discussions in hearing and on the contrary additional claims 1-112 were added to the

body of the claims. The respondent issued refusal order on two grounds:

that the additional claims are not allowable under section 59 of the Patents Act 1970.

the applicant failed to meet the outstanding objections by not filing the amended set of claims as agreed during the hearing.

11. We considered the submissions and the refusal order and found the respondent’s order is reasoned in the given circumstances on both

the counts. Firstly, the addition of claims 1-112 naturally attract the provision of section 57 read with section 59 of the Patents Act, 1970

and secondly any such addition of claims after the hearing, opens the whole examination process afresh; wherein the “novelty”

“inventive step” and other warranted objections as per the law, need be viewed afresh. This is against the scheme of the law. Hearing was

based on certain existing official objections and any attempt to go beyond such scope either by the Controller or by the applicant is against the spirit

of the law particularly in absence of proper reason therefor. In several cases we have noticed that it is the Controller who takes up an additional

ground, thereby violating the principle of natural justice. Here, in the instant case, the flaw is on the applicant’s side. This is very rare to notice

such a situation wherein the applicant goes on theory of regression after hearing. But it is important to note that after hearing before us,

the applicant agreed to file the amended set of claims retaining only 2 claims; Claim 1 based on claim 54 and claim 2 based on claim 56 on records at

the time of hearing in front of the Controller and as agreed during the hearing by the applicant.

12. In such a scenario, we find that the official's requirement as imposed by the respondent will be fulfilled and there will not be any ground for sustaining his order.

13. We, therefore, direct the applicant to file the amended set of claim within 4 weeks from issuance of this order.

14. In view of such an amendment, we set aside the impugned order of the respondent dated 09/08/2011 and direct him to grant the patent within 4 weeks from the date of submission of the amended set of claims by the applicant.

15. Keeping in view the above, the instant appeal is allowed. No cost.