OIP-4

IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Intellectual Property Rights Division)

IPDPTA/84/2023

OTSUKA PHARMACEUTICALS CO.LTD. (OA/15/2017/PT/KOL)
VS
CONTROLLER GENERAL OF PATENTS, DESIGNS
AND TRADEMARKS AND ANR.

BEFORE:
The Hon'ble JUSTICE RAVI KRISHAN KAPUR
Date : 15th July, 2025

Appearance:
Mr. Debnath Ghosh, Sr. Adv.
Mr. SourojitDasgupta, Adv.
Mr. S. Prasad, Adv.
Mr. N. Banerjee, Adv.
...for the appellant

Ms. Rajashree Roy, Adv.
...for the respondent

The Court : - This appeal is directed against an order dated 28 February, 2017, rejecting an application for patent 4208/KOLNP/2009 filed on 4th December, 2009.

Briefly the subject invention relates to microspheres containing aripiprazole, a process for producing the same and an injectable aqueous suspension formulation. The complete specification of the invention would morefully appear from the application for patent.

Pursuant to the filing of the above application the First Examination Report (FER) was issued to the appellant's agent on 24 March, 2015. The appellant filed his response to the FER through acommunication dated 28 August, 2015. The appellant also amended his claim in Form 3. Thereafter, the appellant also amended claim nos.1 to 13 in Form 3 and filed the same before the Hearing Officer. Pursuant to the above, a hearing notice was issued and the matter was finally heard on 14th February, 2017.

By the impugned order dated 28th February, 2017, the Deputy Controller of Patents and Designs rejected the application for grant of patent on the ground that the same lackedany inventive steps and there was insufficiency ofclarity in respect of the subject application under Sections 3(d) and 3(e) of the Patents Act, 1970.

On behalf of the appellant it is contended that the impugned order is liable to be set aside primarily on the ground that the same has been passed in violation of the principle of natural justice. In passing the impugned Order the Deputy Controller of Patents and Designs has not furnished any reasons whatsoever.There has been no discussion of the subject invention nor are there any reasons as to why the prior arts were relevant.

On behalf of the respondentsit is contended that, notwithstanding the revision of claim, the subject application did not reflect any technical advancement over prior knowledge or art. The invention lacked inventive steps with respect to the prior arts under section 2(1)(ja) of the Act. The claimed invention is merely a new formulation without any reflection of higher efficacy and hencenot patentable under section 3(d) of the Act.In such circumstances, the application was dismissed for lack of inventive steps in view of the prior art documents under Section 2 (I) (ja) of the Act and neither was the same patentable under Section 3(d) of the Act. In support of such conclusion the Deputy Controller of Patents and Designs had relied on three prior artsbeing D1, D2, D3.

On behalf of the Controller, it is submitted that the impugned order is adequately reasoned. In support of such contention the respondent Controller has also relied on the Written Notes of Arguments filed in this proceeding.

On a consideration of the impugned order it appears that the Deputy Controller of Patents and Designs has arrived at a conclusion that the application did not reflect any technical advancement over any of the prior knowledge or arts. There are no reasons whatsoever in arriving at such conclusion. Similarly, the conclusion that the subject invention lacked inventive step and was not patentable under section 3(d) of the Act has also not been discussed. The impugned order is totally bereft of any reasoning with regard to the above two aspects. It is well-settled that an order of such nature must be supported by reasons. [*Uniworth Resorts vs. Ashok Mittal (2008) 1 CLT 1* and *UPSC vs. Bibhu Prasad (2021) 4 SCC 516*]

In such circumstances, the impugned order is unreasoned and unsustainable. There is no discussion of the invention nor has the relevance of prior arts D1, D2 and D3 been discussed. There are also no reasons insofar as the finding that the subject inventionlackedinventive steps. The Notes of Arguments which were filed on behalf of the respondent Controller cannot be a substitute for the inadequacy or non-furnishing of reasons in the impugned order.

In view of the above, the impugned order dated 28th February, 2017 is set aside. The matter is remanded back to the concerned authorities for adjudication afresh within a period of two months from the date of communication of this order.It is made clear that the there are no findings insofar as the merits of the matter are concerned and the respondent Controller would not be bound by any observation or findings in this regard.

To the above extent, IPDPTA/84/2023 stands allowed.

(RAVI KRISHAN KAPUR, J.)

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