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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **20.03.2025**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

W.P.(IPD)No.29 of 2024
and W.M.P.(IPD)Nos.34353 & 34354 of 2024

Bristol Myers Squibb Company
Route 206 and Province Line Road,
Princeton New Jersey 08543- 4000,
CA 92121, United States of America,
Rep. by its Constituted Attorney Ms.Geeta Bist. ... Petitioner

-vs-

1. Deputy Controller of Patents & Designs,
Patent Office Intellectual Property Building,
G.S.T. Road, Guindy, Chennai- 600 032.

2. Assistant Controller of Patents & Designs,
Intellectual Property Office Building,
Plot No.32, Sector 14, Dwarka,
New Delhi - 110 078.

3. Indian Pharmaceutical Alliance,
115/116 Ground Floor, World Trade Centre,
Babar Road, Connaught Place,
New Delhi - 110 001, India. .. Respondents

Prayer: Writ Petition (IPD) filed under Article 226 of the Constitution of India for issuance of Writ of Certiorarified Mandamus to call for the records

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of the 2nd Respondent pertaining to Patent Application No. 5948/ CHENP / 2014, quash communications dated 13th September 2024 and 19th September 2024 and direct the 2nd Respondent to proceed with the hearing in the pre-grant opposition proceedings based on materials and documents available on record as on 10th July 2024.

For Petitioner : Ms.Archana Shankar
Mr.K.Premchandar
Mr.N.C.Vishal
Ms.S.Yeseswini

For R1 & R2 : Mr.A.R.Sakthivel, SPC

For R3 : Mr.Adarsh Ramanujan

ORDER

In CMA(PT)No.2 of 2023, the petitioner herein had challenged order dated 30.03.2023 rejecting Patent Application No.5948/CHENP/2014. By judgment dated 10.07.2024, the impugned order was set aside and the matter was remanded for reconsideration. Thereafter, the petitioner herein had requested for a clarification by filing C.M.P.No.14512 of 2023. Such clarification was in relation to the scope of remand. Pursuant to order dated 10.07.2024, proceedings were continued by respondents 1 & 2.

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2. The 3rd respondent herein, which is the pre-grant opponent, submitted 17 documents for consideration in the remanded application. These documents were attached to e-mail of 13.09.2024. On the ground that 13 new documents were included in the list of 17 documents, the petitioner herein requested for further time to prepare for the hearing and consequently for rescheduling of such hearing. On the same date, the petitioner also raised an objection that the new documents should not be received at this belated juncture. The present writ petition has been filed in the above facts and circumstances for an order directing that proceedings be concluded on the basis of materials and documents available on record as on 10.07.2024.

3. The first contention of Ms.Archana Shankar, learned counsel for the petitioner, is that the 3rd respondent is not entitled to rely on additional evidence. In this regard, learned counsel contends that any additional evidence may be relied upon only with the leave of the Controller, and that the grant of such leave is subject to sub-rules (2) to (4) of Rule 62 of the Patents Rules, 2003 (the Patents Rules), which have been extended to pre-

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grant opposition proceedings under sub-rule (5A) of Rule 55 thereof. As per sub-rule (4) of Rule 62, learned counsel submits that publications not already mentioned in the notice, statement or evidence may be relied upon only if the counter party and the Controller are provided not less than five days' notice of the intention to rely on such publications.

4. She further submits that such publications should have been electronically communicated in accordance with sub-rule (1) of Rule 6 of the Patents Rules, and that the 3rd respondent failed to do so. By relying upon the judgment of the Delhi High Court in *Pharmacyclics LLC v. Union of India and others, order dated 20.11.2019 in W.P.(C)No.12105 of 2019 (Pharmacyclics)*, learned counsel submits that Rule 62(4) was interpreted therein as applicable only to publications, i.e. documents which would otherwise be publicly available for the parties to examine and verify. She also states that the Delhi High Court held that the publication should have been uploaded five days prior to the hearing after highlighting the exact portion, which is proposed to be relied upon. Since the 3rd respondent has not adhered to relevant rules under the Patents Act, learned counsel submits

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that the 3rd respondent should not be permitted to rely on these documents.

5. Her third contention is that the petitioner did not consent to these documents being received, and that letter dated 16.09.2024 requesting for additional time in view of the filing of 13 new documents cannot be construed as a waiver of the petitioner's right to object thereto.

6. In response to these contentions, Mr.Adarsh Ramanujan submits that there was substantial compliance with the requirements of sub-rule (4) of Rule 62 inasmuch as the petitioner has had more than five days to examine the 13 new documents and respond thereto. He further submits that no prejudice has been caused to the petitioner by virtue of the alleged non-compliance with sub-rule (4) of Rule 62. By relying on *Shree Chamundi Mopeds Ltd. v. Church of South India Trust Association, CSI CINOD Secretariat, Madras, (1992) 3 SCC 1*, he also submits that the implication of quashing or setting aside an order is that proceedings would stand restored to the state such proceedings were at before the issuance of the order that was quashed or set aside. Therefore, he submits that there should be no fetters or restrictions on the scope of the remanded proceedings.

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7. Mr.A.R.Sakthivel, learned SPC, submits that the matter had been adjourned on more than one occasion after the additional documents were filed by the 3rd respondent. Consequently, he submits that the petitioner has had sufficient time to examine these documents and respond thereto. On instructions, he also submits that the Controller is of the view that these documents are relevant for the adjudication of the dispute.

8. In judgment dated 10.07.2024, while examining the order impugned therein, it was noticed and recorded in paragraph 9 thereof that the Controller had rejected objections relating to novelty and inventive step and examined the patent application thereafter only with regard to the objection under Section 3(d). It is pertinent to record that the 3rd respondent did not file an appeal to challenge the rejection by the Controller of Objections relating to novelty or inventive step or even participate in proceedings initiated by the petitioner. Hence, the rejection under Section 3(d) was examined in the appeal lodged by the petitioner herein, and such

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appeal was disposed of by issuing directions in paragraph 29 thereof. Clause (iii) of paragraph 29 captured the scope of remand. Said clause is set out below:

> *"29. .. ..*
>
> *.. ..*
>
> *(iii) Such reconsideration shall be undertaken by taking into account observations set out in this judgment for the limited purpose of examining whether the enhanced bioavailability of the hemisulphate salt of Compound (I) is significant and whether it has the effect of enhancing therapeutic efficacy, albeit not by way of enhanced intrinsic pharmacological activity per unit of API."*

9. As regards the objections of the petitioner to the filing of 13 new documents, it is pertinent to record that the petitioner requested for additional time, by communication dated 16.09.2024, to examine and respond to these additional documents. The record also discloses that an objection to take these documents on record was lodged on the same date. In those circumstances, it cannot be said that the petitioner waived its right to

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object to these documents being received.

10. The situation on ground is that the substantial hearing in the matter has not taken place as on date, and several months have passed since these documents were submitted by the 3rd respondent. The implications of sub-rule (4) of Rule 62 should be considered against the above factual matrix. Rule 62(4) is as under:

> *"62. Hearing-*
>
> .. ..
>
> *(4) If either party intends to rely on any publication at the hearing not already mentioned in the notice, statement or evidence, he shall give to the other party and to the Controller not less than five days' notice of his intention, together with details of such publication. "*

This sub-rule is made applicable to pre-grant opposition proceedings by virtue of sub-rule (5A) of Rule 55. Although Mr.Adarsh Ramanujan contended that the amended rule should not be made applicable to proceedings that were instituted prior to the date of amendment, I am unable to countenance this contention given that the amendments were in place before the matter was taken up on remand.

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11. On examining sub-rule (4) of Rule 62, the statutory prescription is that both the counter party and the Controller should be provided not less than five days advance notice. In the case on hand, the documents were uploaded on or about 13.09.2024 and many months have lapsed thereafter. Therefore, I conclude that sub-rule (4) of Rule 62 has been substantially complied with. As regards the contention, on the basis of *Pharmacyclics,* that the relevant portion of the publications should be highlighted, such obligation is not imposed by statute or rule and the reference thereto in the judgment appears to be in the nature of a guideline to be followed for the efficient conduct of proceedings in opposition.

12. In response to a specific question, on instructions, Mr.Adarsh Ramanujan confirmed that no further documents would be sought to be relied upon in course of the pre-grant opposition proceedings. This statement is recorded.

13. The earlier order of this Court directed that a fresh order be issued

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within six months from the date of receipt of order dated 10.07.2024. The six month period has elapsed from the date of order. In these circumstances, it is just and necessary that these proceedings be concluded expeditiously.

14. For reasons aforesaid, this writ petition is disposed of by declining to interfere with the decision of the official respondents to receive these documents, but by directing that the proceedings be concluded within three months from the date of receipt of a copy of this order. There will be no order as to costs. Consequently, connected miscellaneous petitions are closed.

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Neutral Citation: Yes / No
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