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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **13.02.2025**

CORAM

THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT)/59/2024
and C.M.P.No.27473 of 2024

1.Shimadzu Corporation
1, Nishinokyo-kuwabaracho,
Nakagyo-ku, Kyoto-shi,
Kyoto 6048511,
Japan.

2.National Center for Geriatrics and Gerontology
7-430, Morioka-cho, Obu-shi,
Aichi 4748511,
Japan. ... Appellants

-vs-

The Assistant Controller of Patents and Designs,
The Patent Office,
Intellectual Property Building,
G.S.T.Road, Guindy, Chennai – 600 032. ... Respondent

PRAYER: Civil Miscellaneous Appeal (Patents) is filed under Section 117A of the Patents Act, 1970, pleased to allow the present appeal and pass

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an order setting aside the Impugned Order dated 23.04.2024 passed by the Respondent in respect of the Indian Patent Application No.201647043103, and hold that the subject matter of Claims 1 to 4 of the Indian Patent Application No.201647043103 falls outside the scope of Section 3(i) of the Patents Act, 1970, and is thus liable to proceed to grant, and direct the Controller to grant the patent and publish the grant in the journal.

For Appellants : Ms.Vindhya S.Mani
for M/s.Lakshmi Kumaran
and Sridharan Attorneys

For Respondent : Mr.S.Janarthanam, SPC

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JUDGMENT

An order dated 23.04.2024 rejecting Indian Patent Application No.201647043103 is challenged in this appeal. The said patent application was for a claimed invention titled SURROGATE BIOMARKER FOR EVALUATING INTRACEREBRAL AMYLOID β PEPTIDE ACCUMULATION AND METHOD FOR ANALYSIS THEREOF.

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Pursuant to a hearing by video conference on 29.03.2023, the impugned order was issued. By such order, the respondent concluded that the claimed invention is excluded from patentability under Section 3(i) of the Patents Act, 1970 (the Patents Act).

2. Learned counsel for the appellants submits that the impugned order relies on the earlier order of this Court in the *Chinese University of Hong Kong v. The Assistant Controller of Patents and Designs 2023:MHC:4616 [The Chinese University of Hong Kong]*, which was pronounced on 12.10.2023. Since the virtual hearing was held on 29.03.2023, learned counsel submits that the appellant was unable to deal with the judgment and endeavour to convince the respondent that the claimed invention does not per se disclose pathology. She relies upon an earlier judgment of this Court in *Somalogic Operating Company INC. v. The Assistant Controller of Patents and Designs, CMA(PT)/25/2024 [Somalgic Operating Company]*, judgment dated 03.09.2024, to contend that it applies squarely.

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3. In response to these submissions, Mr.S.Janarthanam, learned SPC, submits that the claimed invention relates to a method of diagnosing diseases, such as Alzheimer's disease. Consequently, it is contended that it clearly discloses pathology and qualifies as a diagnostic method under Section 3(i) of the Patents Act.

4. The chronology of events in this case is substantially similar to that prevalent in *Somalogic Operating Company*. As contended by learned counsel for the appellants, the hearing by video conference took place on 29.03.2023, which was prior to the judgment in the *Chinese University of Hong Kong* on 12.10.2023. Consequently, the appellants did not have the opportunity to endeavour to establish that the claimed invention does not qualify as a diagnostic method under Section 3(i), as interpreted in the said judgment. In the interest of justice, it is necessary that such opportunity be provided to the appellants. Consequently, interference with the impugned order is warranted.

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5. Therefore, impugned order dated 23.04.2024 is set aside and the matter is remanded for re-consideration on the following terms:

(i) In order to preclude the possibility of pre determination, such re-consideration shall be undertaken by an officer other than the officer who issued the impugned order.

(ii) After providing a reasonable opportunity to the appellants, including a personal hearing, a fresh order shall be issued within a period of ***four months*** from the date of receipt of a copy of this order.

(iii) It is made clear that no opinion is expressed herein on the merits of the application.

6. Therefore, CMA(PT)/59/2024 is disposed of on the above terms without any order as to costs. Consequently, C.M.P.No.27473 of 2024 is closed.

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Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No

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and C.M.P.No.27473 of 2024

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