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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **13.03.2025**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

CMA(PT)/48/2024

The Chinese University of Hong Kong
Shatin, New Territories
Hong Kong China. ... Appellant

-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 (as amended by the Tribunals Reforms Act, 2021), praying that the present appeal be allowed and the order of the Assistant Controller of Patents & Designs dated 31.05.2021 in Patent Application No.5000/CHENP/2013 be set aside and the Hon'ble Court may be pleased to hold that the subject matter of Claims 1-16 of the Patent Application No.5000/CHENP/2013 fall outside the scope of Section 3(i) and

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Section 3(k) of the Patents Act, 1970 and is thus liable to proceed to grant and the Hon'ble Court may be pleased to hold that the subject matter of Claim 16 of the Patent Application No.5000/CHENP/2013 complies with the requirements laid down under Section 10(4)(c) of the Patents Act, 1970 and is thus liable to proceed to grant and the Hon'ble Court may be pleased to direct the Controller to grant the patent and publish the grant in the journal.

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

For Respondent : Mr.S.N.Parthasarathi, SPC

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JUDGMENT

This appeal is directed against order dated 31.05.2021 rejecting Indian Patent Application No.5000/CHENP/2013 dated 26.06.2013.

2. The above mentioned application was filed for grant of patent for

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an invention titled "DETECTION OF GENETIC OR MOLECULAR ABERRATIONS ASSOCIATED WITH CANCER". Upon request from the patent applicant, First Examination Report (FER) dated 15.06.2018 was issued by the respondent. In the FER, objections were raised *inter alia* on grounds of lack of inventive step and non patentability under Section 3(i) and (k). The appellant replied to the FER on 13.12.2018 and submitted amended claims 1 to 16. Pursuant to hearing notice dated 30.07.2019, a hearing was fixed on 28.06.2019. The appellant filed written submissions thereafter on 11.09.2019. The order impugned herein was issued in the above facts and circumstances.

3. Learned counsel for the appellant invited my attention to the above mentioned documents. With particular reference to the impugned order, learned counsel submits that the claimed invention was refused *inter alia* under Section 10(4)(c) of the Patents Act, 1970, although no objection on this ground was raised either in the FER or the hearing notice. As regards the rejection under Section 3(k), learned counsel submits that a conclusion that amended claim 16 is a computer programme *per se* was recorded

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without providing any reasons in support of the conclusions. As regards the conclusion on Section 3(i), learned counsel submits that the respondent did not have the benefit of the judgments of this Court in the two decisions, namely *The Chinese University of Hong Kong v. Assistant Controller of Patents and Designs 2023:MHC:4616; 2023-5-LW 310 ['The Chinese University of Hong Kong – I'] and The Chinese University of Hong Kong v. Assistant Controller of Patents & Designs 2023:MHC 4617, 2023-5-LW-289 [The Chinese University of Hong Kong – II]* on *12.10.2023*. Equally, she submits that the appellant did not have an opportunity to rely thereon and established that the claimed invention does not *per se* disclose pathology. She seeks a remand for all these reasons.

4. Learned counsel for the respondent contends that the claimed invention pertains clearly to a diagnostic method and falls within the ambit of Section 3(i) of the Patents Act. He also submits that amended claim 16 qualifies as a computer programme *per se*.

5. On examining the FER and hearing notice, it is noticeable that no

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objection was raised therein on the ground that the claimed invention does not meet the requirement under Section 10(4)(c) of the Patents Act. The recording of a conclusion to this effect in the impugned order, therefore, clearly contravenes the requirements of natural justice. As regards the conclusion on Section 3(k), several judgments have been pronounced by the Delhi High Court and by this Court with regard to the principles underlying the analysis and conclusion on whether claims would fall within Section 3(k). The conclusion in the impugned order, in this regard, is as under:

> *"Regarding the **amended claim 16,** A **computer system** to implement the methods as claimed in any of the claims 1 to 15 is not defined and not patentable u/s 3(k). In general the term computer system refers to a set of integrated device and in this application the computer system includes processors that are programmed to implement the claimed method (Para 0233-0239)."*

6. The above mentioned extract indicates that there has been no discussion on relevant principles to determine whether the computer related invention falls within the scope of Section 3(k).

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7. As regards Section 3(i), as per judgments referred to earlier, it is necessary for the respondent to examine whether the claimed invention is a method of diagnosing diseases, disorders or conditions. While the claimed invention appears to relate to measuring Chromosomal deletions or amplification by analyzing DNA fragments in plasma, it appears that the respondent has not examined whether it, consequently, *per se* discloses pathology. The appellant also did not have the benefit of the principles formulated in the judgments referred to above while making submissions on this issue. For all these reasons, re consideration is necessary.

8. Therefore, impugned order dated 31.05.2021 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 appellant, including in respect of the objection under Section 10(4)(c), a reasoned order shall be issued within a period of ***four months*** from the date of receipt of a

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copy of this order.

(iii) For the avoidance of doubt, it is made clear that no observation has been made on the merits of the patent application.

9. CMA(PT)/48/2024 is disposed of on the above terms without any order as to costs.

13.03.2025

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

To

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

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