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W.P. No.8451 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON	17.10.2025
PRONOUNCED ON	05.01.2026

CORAM

THE HONOURABLE MR.JUSTICE N.SENTHILKUMAR

W.P. No.8451 of 2023 and
W.M.P. Nos.8647, 8649 & 8650 of 2023

1.E.R.Squibb & Sons LLC
at Route 206 & Province Line Road
Princeton, New Jersey 08540
Represented by its
Constituted Attorney/Authorised Signatory
Mr.Toni Mon George

2.Ono Pharmaceuticals Co. Ltd.
at 1-5, Doshomachi 2-chome
Chuo-ku, Osaka-shi, Osaka 541-8526
Japan
Represented by its
Constituted Attorney/Authorised Signatory
Mr.Toni Mon George

.. Petitioners

Vs.

1.Union of India
Through the Ministry of Commerce
Department of Industrial Policy & Promotion
Udyog Bhawan
New Delhi 110 011

2.The Controller of Patents & Designs
The Patent Office



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Intellectual Property Office Building
G.S.T. Road, Guindy,
Chennai - 600 032

3.Zydus Healthcare Limited
of Zydus Corporate Park
Scheme No.63, Survey No.536
Khoraj (Gandhinagar), Nr.Vaishnodevi Circle
Ahmedabad, Gujarat 382 481
India

.. Respondents

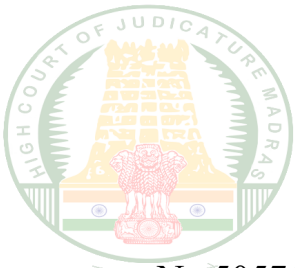
Prayer : Writ petition filed under Article 226 of the Constitution of India for a writ of certiorarified mandamus calling for the records and quashing the recommendation of the opposition board in Patent No.IN340060 (Patent Application No.5057/CHENP/2007) and consequently direct the 2nd respondent to reissue the same after deciding the miscellaneous petition of the petitioner and considering all the documents on record under Rule 57 to 60 of the Patents Rules, 2003.

For Petitioner : Mr.P.S.Raman, Senior Counsel
for Mr.K.Premchandar

For Respondents : Mr.Rajesh Vivekananthan,
Deputy Solicitor General for
Govt. of India for R1 & R2
Mr.C.S.Vaidyanathan, Senior Counsel
and
Mr.P.V.Balasubramanian,
Senior Counsel for
Mr.Adarsh Ramanujan, for R3

ORDER

The present writ petition is filed challenging the recommendation of the
Opposition Board in Patent No.IN340060 (Patent Application



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No.5057/CHENP/2007) dated 31.01.2023 made by the second respondent in Patent No.IN340060 with regard to post grant opposition proceedings, as per Section 25(2) of the Patents Act, 1970, which was initiated by the third respondent herein. Aggrieved by the same, the present writ petition has been filed.

2. The Indian Patent No.340060 was granted in respect of an invention titled as '*Human Monocolonal Antibodies to Programmed Death I (PD-1) for use in Cancer*', which is used for treating cancer. An application was made in A. No.5057/CHEMP/2007, which is a national phase entry of International (PCT) Application No.PCT/JP2006/209606, which was filed on 02.05.2006 and came to be published as International Publication No.WO2006/121168 A1 dated 16.11.2006. The third respondent herein has given a post grant opposition under Section 25(2) of the Patents Act, 1970 as against the grant of patent. Based on which, the opposition Board has made the impugned recommendation.

3. After filing of the reply evidence, the opponent/third Respondent has filed a rejoinder. Thereafter, the petitioners herein filed a Miscellaneous Petition, which questions the maintainability of the rejoinder filed by the Respondent No.3 and also the evidence under Rule, 59. According to the



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Petitioners, as the Opposition Board has to consider all documents under Rule 57 to 60 which are on record, the Respondent No.2 was duty bound to decide the maintainability of the rejoinder filed by the Respondent No.3 and also the evidence under Rule, 59. Only after the maintainability of the rejoinder was decided, the competent authority could decide whether or not to supply such documents to the opposition Board, after which the recommendations of the Board can be formed.

4. It is the case of the petitioners that the opposition board has made the recommendation without considering the evidence submitted by the patentee, namely the writ petitioner. The petitioners have filed 7 evidence of Dr.Fife, an evidence of Sarah Roques, an evidence of Dr.Feltquate, an evidence of



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Dr.Mark. Many of such evidence and various documents, issues addressed in such evidence; details and data provided have not been considered, and appreciated by the opposition Board while making the recommendation.

5. Mr.P.S.Raman, the learned senior counsel appearing for the petitioner pointed out that in the recommendation of the opposition board, there is no date, therefore, it is a serious lacuna. The recommendations hold that the patent lacks novelty, inventive step, sufficiency and clarity. The learned senior counsel further pointed out that the said drug has been used in 64 countries and the drug has been legally protected. In support of his contention, the learned senior counsel relied on Rule 57 to 60 of the Patents Rules, 2003.

"57. Filing of written statement of opposition and evidence.- The opponent shall send a written statement in duplicate setting out the nature of the opponent's interest, the facts upon which he bases his case and relief which he seeks and evidence, if any, along with notice of opposition and shall deliver to the patentee a copy of the statement and the evidence, if any.

58. Filing of reply statement and evidence. - (1) If the patentee desires to contest the opposition, he shall leave at the appropriate office a reply statement setting out fully the grounds upon which the opposition is contested and evidence if any, in support of his case within a period of two months from the date of receipt of the copy of the written statement and opponent's



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evidence, if any by him under Rule 57 and deliver to the opponent a copy thereof.

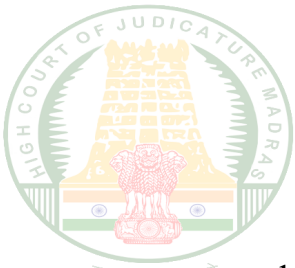
(2) If the patentee does not desire to contest or leave his reply and evidence within the period as specified in sub-rule (1), the patent shall be deemed to have been revoked.

59. Filing of reply evidence by opponent.-The opponent may, within one month from the date of delivery to him of a copy of the patentee's reply statement and evidence under Rule 58, leave at the appropriate office evidence in reply strictly confined to matters in the patentee's evidence and shall deliver to the patentee a copy of such evidence.

60. Further evidence to be left with the leave of the Controller.- No further evidence shall be delivered by either party except with the leave or directions of the Controller.

Provided that such leave or direction is prayed before the Controller has fixed the hearing under Rule 62."

The learned senior counsel contended that the joint recommendation of the Opposition Board [OBR] is a critical document in a post grant opposition proceeding and the same have to be considered when the controller gives a final decision in the proceedings. The importance of the document was also acknowledged by the Hon'ble Supreme Court of India in *Cipla Vs. Union of India* (Civil appeal Nos.8479-8480 of 2012). Therefore, as this document is immensely crucial in determining the rights of a patentee, the same should be



prepared by following the due process of law and the procedure provided under the Act and should take into consideration all important and critical factors, while deciding on any of the grounds of opposition.

6. He further pointed out that the impugned joint recommendation is not as per the scheme of the Act and therefore, should be disregarded and a fresh opposition Board recommendation needs to be issued before the post grant opposition proceedings is finally decided by the controller. The respondents/authorities, however, failed to decide the maintainability of such documents, and proceeded with the issuance of recommendation of the opposition Board. The same are therefore, in violation of the scheme of the Act and the Rules.

7. Further, even in case, it is assumed that the respondent authorities have decided on the miscellaneous petition filed by the petitioner, and a decision has been taken with regard to maintainability of the rejoinder filed by the Respondent No.3 and also the evidence filed under Rule 59, the same is not reflected in the OBR. Therefore, the impugned recommendation is passed in violation of principles of natural justice, as any such decision should not have been formed without giving the patentee, an opportunity of being heard.



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8. Further, secondary considerations are also important when deciding the issues relating to obviousness and technical advancement. Such details have been provided by the petitioners in terms of grant in other countries and also the evidence of Dr.Mark and Dr.Feltquate. The board has not even considered the extensive data on secondary consideration, long felt need, commercial success, regulatory approvals and grant in other jurisdiction.

9. To strengthen his arguments, the learned senior counsel relied upon the following judgments:

(i) Cipla Limited v. Union of India reported in (2012) 13 SCC 429;

(ii) Sugen Inc and Anr v. Controller General of Patents, Design, Trademark and Geographical Indication - OA/5/2013/PT/DEL dated 14.05.2013;

(iii) Pharmacyclics LLC v. Union of India - W.P.(C) 12105/2019 dated 20.11.2019;

(iv) Akebia Therapeutics Inc v. Controller General of Patents, Designs, Trademark and Geographical Indication and Ors - W.P.(C) IPD 32/2023 dated 09.08.2023;

(v) Novo Nordisk A S v. Union of India and Ors - W.P.(C)-IPD 19/2022 dated 05.07.2022;



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(vi) Optimus Drugs Private Limited v. Union of India and Ors - W.P.(IPD) 24/2023 dated 12.12.2023;

(vii) Willowood Chemicals Private Limited vs. Assistant Controller of Patents and Designs & Anr - W.P. (C)-IPD 15/2023;

(viii) Pharmacyclics LLC vs. Controller General of Patents, Design, Trademark and Geographical Indications - OA/46/2020/PT/DEL dated 29.09.2020; and

(ix) Ashok Leyland Limited v. The Controller of Patents & Designs and Anr - W.A. No.1181 of 2024.

10. Per contra, Mr.C.S.Vaidyanathan, the learned senior counsel appearing for the third respondent raised a preliminary question with regard to the maintainability of the writ petition by referring to the prayers made in the writ petition. The prayer in the writ petition reads thus:

"For the reasons stated in the affidavit filed in support of the writ petition, it is humbly and respectfully prayed that this Hon'ble Court be pleased to issue a writ of certiorarified mandamus calling for the records and quashing the recommendation of the Opposition Board in Patent No.IN340060 (Patent Application No.5057/CHENP/2007) and consequently direct the 2nd respondent to reissue the same after deciding the Miscellaneous Petition of the petitioner and considering all



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the documents on record under Rule 57 to 60 of the Patents Rules, 2003 and/or pass any other appropriate writ, order and/or direction that this Hon'ble Court deems fit and proper in the facts and circumstances of the case and thus render justice."

11. He further pointed out that the subject matter under challenge in the present writ petition is only a recommendation by the Board and the final decision has to be made only by the Patent Authority as per Section 25(4) of the Act. If at all the petitioners are aggrieved, they have a right of appeal before this court under Section 117A of the Act. The writ petition has been filed in a hurried manner without awaiting the final decision to be taken by the patent authority based on the recommendations made by the opposition Board. He further pointed out that the recommendation may be acted upon or may be rejected by the patent authority, after analysing the materials placed by either side.

12. To examine the notice of opposition along with evidence, the opposition board was constituted by the controller u/R 56 of the Patent Rules on 29 December 2021. The board has considered the material available on record comprising submissions and evidence filed by both parties u/R 57-59 of Patent



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Rules, the appropriate portions of which were referred to in the OBR, and the recommendations were made based on conclusions derived from examination and analysis of facts.

13. The Opposition Board has submitted its recommendations well before 3rd August 2022 and regarding the reply evidence filed by the opponent u/R 59 of Patent Rules on 1 Dec 2021, the opposition board as only considered the said evidence insofar as it was confined to patentee's reply and evidence filed on 1 Oct 2021.

14. Regarding the further evidence filed by the petitioner on 25 August 2022 u/R 60 of Patent Rules, the same is not admissible before the opposition board since the board was already constituted on 29th Dec 2021 and had even submitted its recommendations to the controller by then.

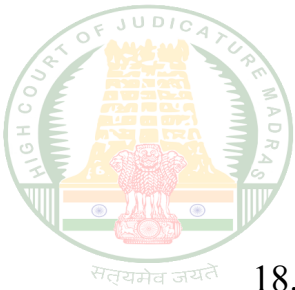
15. The further evidence is admissible u/R 60 of Patent Rules only when it is delivered with the leave and direction of the controller and the same will be considered during the hearing which is still pending before the controller. However, at a pre-matured stage, the petitioners have approached this court through the instant Writ Petition.



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16. The learned senior counsel contended that the Delhi High Court held that a Writ Petition against the recommendations of the opposition board is not maintainable. The legal framework doesn't permit an appeal against the Opposition Board's recommendation or scrutinizing the validity of the Report and declaring it unsustainable. The Act, under Section 117A(2) provides for an appeal once the controller takes the final decision and the petitioners are not permitted to challenge the recommendations of the opposition board on merits under Art 226/227 of the Constitution as held in *WILLOWOOD CHEMICALS PRIVATE LIMITED V Controller of Patents* in W.P.(C) IPD 15/2023.

17. He further pointed out that the dates and events assume significance. A post grant opposition was filed on 01.07.2021. Reply statement and evidence was filed by the petitioners to the post grant opposition on 01.10.2021. On 30.11.2021, leave was sought and rejoinder in the form of evidence was filed by the third respondent. Miscellaneous petition for dismissal of the rejoinder and reply evidence was filed by the petitioner on 03.08.2022. After all these proceedings, recommendation of the opposition board was made on 31.01.2023. Notice for attending hearing and adjournment request was filed on 23.02.2023.



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18. In support of his contention, the learned senior counsel appearing for the respondents, relied on the following judgments:

- (i) *State of Tamil Nadu and Ors. v. S.K.Sharma***
reported in **(1996) 3 SCC 364;**
- (ii) *Dr.G.Sarana v. University of Lucknow & Ors.***
reported in **(1976) 3 SCC 585;**
- (iii) *Union of India v. Nisar Pallathukadavil Aliyar***
reported in **(2020) 20 SCC 252;**
- (iv) *Panacea Biotec Limited v. Union of India and others*** reported in **(2019) SCC Online Bom 5316; and**
- (v) *Willowood Chemicals Private Limited v. Assistant Controller of Patents and Designs & Anr. [Order dated 17.03.2023 in W.P.(C) IPD 15/2023].***

19. Mr.P.V.Balasubramanian, learned senior counsel appearing for the third respondent made the following submissions in addition to the arguments advanced by Mr.C.S.Vaidyanathan, the learned senior counsel. The present petition is not maintainable as the final decision on the post grant opposition filed by the respondent No.3 is yet to be taken by the learned controller. The opposition board recommendations are not binding on the learned controller. As per Rule 62 of the Patent Rules, 2003, both the parties are provided an opportunity of being heard before a final order is passed. Pertinently, the



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learned controller may also require the members of the opposition board to be present in the hearing as per Rule 62(1). Therefore, the petitioner cannot raise the objection of violation of principles of natural justice as no prejudice has been caused. He lamented that as regards the Miscellaneous petition, it is to be noted that the reply evidence under Rule 59 was filed by the 3rd respondent on 30.11.2021, and the same was served on the petitioners. However, no justification is forthcoming as to why the miscellaneous petition came to be filed only on 03.08.2022 i.e. with an unexplained delay of almost 1 year.

20. The petitioners have merely stated that they were not aware of the date of constitution of the Opposition Board. However, the same does not justify the inaction on the part of the petitioners, who were not prevented or precluded in any manner from objecting to the filing of rejoinder by the Respondent No.3 immediately upon obtaining a copy of the same, if the said objections were bona fide. Filing of the miscellaneous petition was not contingent on the constitution of the opposition board as the said petition was to be filed, and was in fact filed before the learned controller. The petitioners alleged that the rejoinder filed by Mr.Sachin Sangre cannot be taken on record since a 'reojinder' cannot be filed under the Rules - However no such 'rejoinder' has been filed at all. The filing done by Mr.Sachin Sangree is an affidavit under



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Rule 59 of the Rules. Further no prejudice is being caused to the petitioner, since it is open to the petitioner to take the said arguments at the time of hearing before the learned controller who will decide the question in accordance with law.

21. The point that arises for consideration in this writ petition is, *whether the writ petition is maintainable or not?*

22. The main contention of Mr.P.S.Raman, learned senior counsel appearing for the petitioners is that the Opposition Board has not applied its mind with regard to the evidence produced by the petitioner. The recommendation made by the Board without considering the material evidence is an absolute procedural irregularity. He referred to the judgment of the Division Bench of this court in ***Ashok Leyland Limited v. The Controller of Patents & Designs and Anr - W.A. No.1181 of 2024***. The relevant paragraphs of the judgment are as follows:

"4. We carefully considered the rival submissions. As the main WA was taken up with the consent of both sides as alluded to supra, this court is of the view that the procedure adopted by the said Board in making said recommendation and the correctness of the same or testing the same cannot



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be left to the said Controller in final hearing as said Board vide Rule 56(4) of 'The Patents Rules' 2003' (hereinafter 'said Rules' for the sake of convenience and clarity) has to give a report i.e., submit a report and recommendations with reasons on each ground after examining the documents and learned counsel on both sides i.e., learned counsel for ALL and TML in this case agreed that term 'documents' occurring in sub-rule (4) of Rule 56 includes/means 'documents and evidence' when read in the light of Rules 57 to 60 of said Rules which talk about 'evidence'. Though said recommendation is not binding on said Controller, it is a determinant qua post grant opposition cannot be tested and sent back by reconstituting the Board in the final hearing proceeding itself as that would tantamouont to testing a parameter on which the drill is pivoted in the drill itself.

5. A perusal of said recommendation brings to light that the question as to whether said Board has considered the evidence is clearly debatable and requires an exercise by itself to take a call on this aspect of the matter. At this juncture, with the intention of giving quietus to the simmering disputation and with the furhter larger objective of expanding the opposition to patent legal drill, both sides agreed that it will be desirable to have the Board reconstituted and have the drill of the Board giving a recommendation done de novo. Before we write operative



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part on the basis of this consensus, we make it clear that judicial review qua procedure to be followed by said Board is an aspect which this Constitutional Court is not denuded of and we deem it appropriate to answer the 'larger question' propounded by Hon'ble single Judge in paragraph 5 of the impugned order in this matter."

By referring to the above judgment, the learned senior counsel contended that the present case is a fit case for a direction to give a denovo recommendation.

23. In the case of ***Optimus Drugs Private Limited vs. Union of India and another in W.P.(IPD) NO.24 of 2023 dated 12.12.2023***, this court has observed that if there is a procedural violation at the time of making a recommendation, then it affects the right of the parties especially, the patentee. Such a procedural violation vitiates the entire recommendation made by the Board. By relying upon the above judgment, the learned senior counsel argued that a fresh Opposition Board has to be re-constituted and all the materials has to be considered by the Board. Only then, the recommendations made therein, has to be placed before the competent authority. For the purpose of brevity and clarity, the relevant portion of the judgment is reproduced hereunder:

"6. Turning to the facts of this case, learned counsel submits that the intention of the petitioner is to scuttle the



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opposition proceedings in view of the recommendations issued by the Opposition Board. By referring to such recommendations, learned counsel points out that the Opposition Board concluded that the patent is liable to be revoked on the ground of obviousness. Learned counsel also relied upon a judgment of the Delhi High Court in Willowood Chemicals Private Limited v. Assistant Controller of Patents and Designs and another, W.P. (c)No.12105/2019, order dated 17.03.2023, in support of the contention that the legal framework of the Patents Act and rules framed thereunder do not permit parties to challenge the recommendations of the Opposition Board because the Controller is not bound by such recommendations. For the same principle, learned counsel also relied upon the judgment of the Delhi High Court in Novo Nordisk AS v. Union of India and others, 2022 (92) PTC 315[Del].

Discussion, analysis and conclusions

7. The admitted position is that the recommendations of the Opposition Board were issued on 17.05.2019. From the sequence of dates and events, it is clear that the petitioner was permitted to file the affidavit of Dr.S.K.Mitra as evidence on 12.11.2020. In response thereto, the 4th respondent filed an affidavit by way of evidence on 04.03.2021. In effect, both parties were permitted to and submitted evidence subsequent to the issuance of the recommendations of the Opposition Board. As contended by learned counsel for the 4th respondent, the Patents Rules envisage that evidence submitted under Rules 57 to 60 would be placed before the Opposition Board. On the facts



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of this case, however, pursuant to the writ petition filed by the petitioner before this Court earlier, the Controller agreed to receive further evidence and such evidence was not by way of publications. Sub~rule (5) of Rule 62 directs the Controller to decide the opposition after taking into consideration the recommendations of the Opposition Board.

8. In light of these developments, which are subsequent to the earlier recommendations of the Opposition Board, it would be meaningless for the Controller to take a decision based on the recommendations issued by the Opposition Board in May 2019, and natural justice clearly requires that the additional evidence placed on record by both parties should be considered by the Opposition Board.

9. What remains to be considered is whether the same Opposition Board which undertook this exercise earlier may be called upon to issue fresh recommendations or whether the Opposition Board should be reconstituted for this purpose. Learned senior counsel for the petitioner relied on a decision of the Intellectual Property Appellate Board in Sugen Inc. and another v. Controller General of Patents, Design, Trademark and Geographical Indications, Patent Office and another, 2013 SCC OnLine IPAB 76 to contend that the Opposition Board should be reconstituted. Upon considering the evidence on record at that point of time, which consisted largely of the further evidence filed by the 4th respondent by way of Exs.R1 to R6, the Opposition Board recommended revocation of the patent. Additional evidence has been placed on record by both parties subsequently. Moreover, the petitioner has voluntarily



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submitted amended claims which have been published. By taking into consideration all these facts and circumstances, in order to preclude the possibility of confirmation bias, I am of the view that the Opposition Board should be reconstituted.

10. Learned counsel for the 4th respondent also contended that the two writ petitions filed by the petitioner were aimed at scuttling the opposition proceedings or, at least, protracting such proceedings. This contention cannot be disregarded. Therefore, it is necessary that the opposition proceedings are proceeded with on an expedited basis.

11. For reasons set out above, WP(IPD)/24/2023 is disposed of without any order as to costs, on the following terms:

(i) The 2nd respondent is directed to constitute a fresh Opposition Board comprising officers other than the officers who formed the previous Opposition Board. The fresh Opposition Board shall be constituted within a maximum period of 30 days from the date of receipt of a copy of this order.

(ii) The newly constituted Opposition Board shall examine the entire evidence and the amended claims of the petitioner and provide its recommendations within a maximum period of two months from the date of constitution of such board.

(iii) Upon receipt of such recommendations, the 2nd respondent is directed to fix and conclude the hearing in the opposition proceedings as expeditiously as possible. Consequently, connected Miscellaneous Petition is closed.



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24. In the judgment of **Ashok Leyland**, which is relied upon by the learned senior counsel for the petitioners, both the parties have consented for re-constitution of the Board. In the judgment of **Optimus Drugs** referred supra, the opposition Board is re-constituted for the reason that both parties involved in the said case were permitted to and submitted evidence subsequent to issuance of the recommendation by the Board. Therefore, as it would be meaningless for the Controller to take a decision based on the said recommendation and in order to preclude the possibility of confirmation bias, the Board was re-constituted. However, in the present case, the recommendation is issued after considering the evidence already placed on record. Therefore, the writ petitioners cannot maintain the above writ petition by relying upon a judgment, wherein the Board was reconstituted with the consent of both the parties.

25. It is useful to refer to Section 25(3) & (4) of the Act and Rules 55A, 56(4), 57, 58 and 59 of the patents rules, 2003. Section 25(3) of the Act, reads thus:

(3) (a) Where any such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee.



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(b) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller.

(c) Every Opposition Board constituted under clause (b) shall conduct the examination in accordance with such procedure as may be prescribed.

(4) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent.

26. Rules 55A, 56(4), 57, 58 and 59 of the patents rules, 2003, are as under:

Rule 55A. Filing of notice of opposition.

The notice of opposition to be given under sub-section (2) of section 25 shall be made in Form 7 and sent to the Controller in duplicate at the appropriate office.

Rule 56. Constitution of Opposition Board and its proceeding (1) *On receipt of notice of opposition under rule 55A, the Controller shall, by order, constitute an Opposition Board consisting of three members and nominate one of the members as the Chairman of the Board.*



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(2) *An examiner appointed under sub-section (2) of section 73 shall be eligible to be a member of the Opposition Board.*

(3) *The examiner, who has dealt with the application for patent during the proceeding for grant of patent thereon shall not be eligible as member of Opposition Board as specified in sub-rule (2) for that application.*

(4) *The Opposition Board shall conduct the examination of the notice of opposition along with documents filed under rules 57 to 60 referred to under sub-section (3) of section 25, submit a report with reasons on each ground taken in the notice of opposition with its joint recommendation within two months from the date on which the documents were forwarded to them.*

Rule 57. Filing of written statement of opposition and evidence *The opponent shall send a written statement in duplicate setting out the nature of the opponent's interest, the facts upon which he bases his case and relief which he seeks and evidence, if any, along with notice of opposition and shall deliver to the patentee a copy of the statement and the evidence, if any.*

Rule 58. Filing of reply statement and evidence (1) *If the patentee desires to contest the opposition, he shall leave at the appropriate office a reply statement setting out fully the grounds upon which the opposition is contested and evidence, if any, in support of his case within a period of two months from the date of receipt of the copy of the written statement and Opponent's evidence, if any by him under rule 57 and deliver to the opponent a copy thereof.* (2) *If the patentee does not desire to contest or*



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leave his reply and evidence within the period as specified in sub-rule (1), the patent shall be deemed to have been revoked.

Rule 59. Filing of reply evidence by opponent *The opponent may, within one month from the date of delivery to him of a copy or the patentee's reply statement and evidence under rule 58, leave at the appropriate office evidence in reply strictly confined to matters in the patentee's evidence and shall deliver to the patentee a copy of such evidence."*

27. A conjoint reading of the abovesaid rules clarifies the procedure to be followed by the Opposition Board, while making the recommendation. The judgments cited by Mr.P.S.Raman, learned senior counsel, involves the question of dealing with the procedural violation, if any, while making the recommendation. Though, it is the contention of the petitioner that there is a procedural violation in the present recommendation as the evidence of the patentee are not considered, a reading of the recommendation would show the discussions on the materials placed before the Board. At the same time, what has been challenged is only a recommendation and a final decision is not yet taken by the authorities. It is to be noted that after the recommendation has been made, an opportunity of hearing will be given as per Rule 62(1) of the Patents Rules, 2003. For the sake of convenience, it is necessary to extract Rule 62(1) of the Patents Rules, 2003, as under:



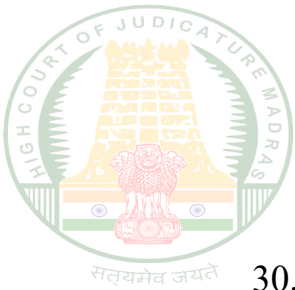
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"Rule 62. Hearing (1) On the completion of the presentation of evidence, if any, and on receiving the recommendation of Opposition Board or at such other time as the Controller may think fit, he shall fix a date and time for the hearing of the opposition and shall give the parties not less than ten days' notice of such hearing and may require members of Opposition Board to be present in the hearing."

28. Therefore, even if the petitioners are aggrieved by the recommendation, it is always open to the petitioners to place all their objections before the competent authority including the contention of non-application of mind or non-consideration of patentee's evidence by the opposition Board and any other objections to be raised could be placed before the patent authority.

29. The next point to be considered is whether any prejudice will be caused to the petitioner in the event, the impugned recommendation is not set aside by this court. As discussed supra, when there is an opportunity of hearing under Rule 62, the petitioner is entitled to place all the submissions and objections during the hearing.



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30. Thus, as the petitioners are challenging the recommendation only on the ground that the documents were not considered by the Opposition Board, the same can also be raised before the controller while a final decision is made. Looking at any angle, it is only a recommendation and it is only for the patent authority to decide the post grant opposition on its own merits. The patent authority may concur with the recommendations or may reject the recommendations and even call for a fresh constitution of the Board. When such being the case, there is no impediment for the petitioner in taking part in the final decision making process conducted by the patent authority and raise these objections. There is also an appeal provision to challenge the said final order to be passed by the competent authority under Section 117A of the Act. This Court does not find any merit in the prayer sought by the petitioners to re-issue the recommendation. Therefore, this Court is not inclined to quash the recommendation.

31. Accordingly, the Writ Petition is dismissed as not maintainable. No costs. Consequently, the connected writ miscellaneous petitions are closed.

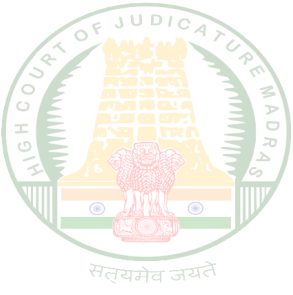
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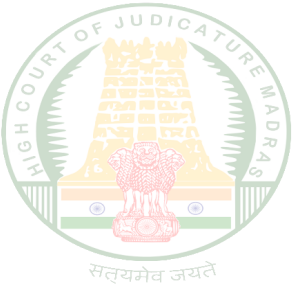
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Index : Yes/No
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- 1.Union of India
Through the Ministry of Commerce
Department of Industrial Policy & Promotion
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New Delhi 110 011
- 2.The Controller of Patents & Designs
The Patent Office
Intellectual Property Office Building
G.S.T. Road, Guindy,
Chennai - 600 032
- 3.Zydus Healthcare Limited
of Zydus Corporate Park
Scheme No.63, Survey No.536
Khoraj (Gandhinagar), Nr.Vaishnodevi Circle
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