

THE PATENTS ACT, 1970
SECTION 25(1)

**In the matter of an application for patent no.
1891/cal/1998 dated October 23, 1998 by
Toyama Chemical Co. Ltd.**

AND

In the matter of a Pregrant Opposition thereto

AND

**In the matter of an Interlocutory Petition
filed by the opponent.**

TOYAMA CHEMICAL CO. LTD. APPLICANT

G.M. PHARMA LTD. OPPONENT

DECISION

1. A representation by way of opposition under section 25(1) was filed on 22nd November, 2006 by M/s G.M. Pharma Ltd. through their agent firm M/s S. Majumdar & Co. against the application for patent no. 1891/cal/1998 dated 23.10.1998 filed by M/s Toyama Chemical Co. Ltd. through their agent firm M/s L.S. Davar & Co. The Patent Office forwarded a copy of the representation to the applicant's agent on 14th February, 2007 for reply within three months as per Rule 55(4) of the Patents Rules, 2003 (as amended). The applicant failed to file its reply statement within the said three months. Instead, filed a petition under rule 138 on May 8, 2007 seeking an extension of time for one month for filing the same. The applicant filed the reply statement on 12th June, 2007. A copy of the reply statement was sent to the opponent's agent on 16th November, 2007 by the Patent Office. The Office also asked the opponent to submit its rejoinder within a fortnight. The opponent's agent submitted the required rejoinder on November 30, 2007.
2. On 13th December, 2007 opponent filed an Interlocutory Petition through its said agent with a copy to the applicant's agent, stating that the applicant's reply statement

could not be taken on record as the same was filed beyond three months and therefore not permitted under rule 55(4) and the Controller had no power to extend that time. Moreover, any extension of time under rule 138 for filing applicant's reply statement and evidence could not also be admissible under the said rule 138. The opponent also requested for a hearing of the Interlocutory Petition.

3. I heard the opponents and the applicants on 15.07.2008. The opponent was represented by Shri Abhishek Sen of S. Majumdar & Co. and the applicant by its agents Dr. (Mrs) S. Banerjee, Dr. (Mrs.) I. Banerjee, Shri P.D. Gupta and Shri Pinaki Mukherjee, Advocate Calcutta High Court.
4. At the hearing Shri Sen, the agent on behalf of the opponent argued on the same line as stated in para 3 ante.
5. Shri Mukherjee represented by the applicant argued that the Interlocutory Petition was not maintainable and bad in law as there was specific provision in the Patents Act to review the Controller's decision. He also argued that the applicant had applied the extension of time under rule 138 which was available without any exception by the Controller. Latest amendment of said rule 138 disallowing grant of any extension of time for filing reply statement under rule 55(4) escaped their sight thereby an irregularity in procedure was committed. Controller was very well within his power to condone this irregularity and take the said reply statement on record and decide the opposition on merit applying principle of natural justice.

I, considering the arguments of both the parties gave my decision that the applicant had committed an irregularity in filing the applicant's reply statement and directed the applicant to file a petition under rule 137 for condoning the irregularity for further proceeding.

However, Shri Sen, the agent for the opponent wished to submit written arguments on behalf of the opponent. I agreed to that and asked the applicant also to submit their written arguments within a week.

6. In the written arguments, submitted by the opponent on 23rd July, 2008, it raised the following issues:-
- i) Failure of the applicants to file their reply statement within prescribed time implied that the invention in question had fallen in public domain and any member of public was at liberty to use the alleged invention by operation of law.
 - ii) Interlocutory Petition by the opponents was maintainable and review of Controller's decision under section 77 argued by the applicants was not applicable here as the Controller did not issue any order on the matter.
 - iii) Question of natural justice was also not applicable as the Controller could not exercise his powers arbitrarily in excess of statutory bindings and stipulations.
 - iv) Controller's direction to file a petition under rule 137 for condoning irregularities in filing the reply statement was beyond the Controller's power as the rules did not permit filing of reply statement beyond a period of three months. The Controller sought to invoke rule 137 to accommodate extension of time which was otherwise specifically excluded by the relevant provision of rule 138.
7. The applicant submitted his written arguments alongwith a petition under rule 137 on 23 July 2008.

In the applicant's said written arguments he reiterated that the Interlocutory Application of the opponents was bad in law and not maintainable when section 77 of the Patents Act was available for review of Controller's decision which was to be preferred within one month from the date of communication of such decision. Further, the opponent had not preferred any Interlocutory Petition after the knowledge of filing of petition by the applicant under rule 138 but waited for the reply statement of the applicant and after reviewing the same preferred to file the Interlocutory Petition with malafide intention to harass the applicant which

were evident from the prayers of the Petitioner. The opponent by their act and conduct waived their right, if any, to oppose the extension of time granted by the Controller at the relevant time as such now estoppels from challenging the extension under the law of Estoppels and principal analogous thereto.

The applicant also referred to two cases in respect of power of Controller in extension of time for sake of natural justice.

1. The state of Punjab and Anr. Vs. Shamlal Murari and Anr. (AIR 1976 C 1177) (Para 8).
2. UCB Vs Torrent Pharmaceuticals Ltd. and Ors. 2007(35) PTC 820(IPAB).

Applicants further requested to reject the interlocutory petition filed by the opponent and hear the application on merit.

8. I have considered the interlocutory petition and the written arguments of both the parties and circumstances of the pregrant opposition of this application vis-à-vis the corresponding provisions of law. Opposition to the grant of a patent by way of representation under section 25(1) (before grant) specifies the grounds of opposition. How such a representation is to be disposed of has been provided in rule 55(1) to (6). According to rule 55(5) the Controller is required to consider the statement and evidence filed by the applicant before a patent is refused or required the complete specification to be amended to his satisfaction before the patent is granted. Rule 55(6) provides that after considering the representation and submission made during the hearing if so requested, the Controller shall proceed further simultaneously either rejecting the representation and granting the patent or accepting the representation and referring the grant of patent on that application, ordinarily within one month. Rule 55(4) mandates filing of the applicants statement and evidence within three months from the date of notice, if he so desires.

In the instant case the applicant could not file the applicant's statement and evidence within three months. Instead filed a petition under rule 138 before the expiry of the three months for the extension of time for one month for filing the required reply statement and evidence and filed the same before the expiry of the extended period.

As can be seen from the above provision of rules the Controller cannot refuse an application without considering the statement and evidence filed by the applicant. In the circumstances only available provision in the Patent Rules is to invoke, rule 137 by which the Controller has a general power to condone any irregularity in procedure which in the opinion of the Controller may be obviated without detriment to the interests of any person. Further, it has also been an established practice in the Patent Office , allowing delayed submission of information of foreign filing particulars by an applicant under section 8 of the Act on petition under rule 137. If the Controller does not invoke the said rule many patent applications originating from abroad would have to be refused. Further, under section 25(1) the opponent can oppose only on 11 specified grounds but no other grounds. So the opponent cannot make any more ground of opposition. So, the interlocutory petition is not maintainable. Further, the opponent's arguments that Controller has no power under section 137 to condone the irregularity or invoking rule 137 for granting extension of time or failure of the applicant to file the reply statement within prescribed time implying the invention fell in the public domain (argument not clear when application is not refused or abandoned) or the Controller has no power to apply natural justice is not justified or acceptable to me. I do not agree with the opponent's other arguments also in the written arguments. A Controller has to apply natural justice whenever applicable. In the instant case the applicants have established that they have desired to contest the opposition. Accordingly, the Controller cannot shut his eyes when a document (Or evidence) is filed for contesting the opposition on its merit. There are several decided cases where merit got priority over procedural lapses. The applicant also has quoted one as stated above.

9. In view of my above findings on the arguments of both the parties and all the circumstances of the case, I dismiss the Interlocutory Petition filed by the opponent, allow the applicant's petition under rule 137, condoning the irregularity in delayed filing of the reply statement and order that the said reply statement filed on 12-07-2008 shall be taken on record and the opposition be decided on merit.

Dated the fifteenth day of October 2008.

(DR. P.C. CHAKRABORTI)

Dy. Controller of Patents & Designs

To

- 1. M/s S. Majumdar & Co., Kolkata.**
- 2. M/s L.S. Davar & Co, Kolkata.**