

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

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W.P.(C) No. 332 of 2010

M/S UCB FARCHIM SA

..... Petitioner

Through: Mr. Sudhir Chandra, Sr. Advocate with
Mr. Sanjay Kumar, Ms. Arpita Sawhney and Mr.
Sukhdev, Advocates.

versus

M/S CIPLA LTD. & ORS

..... Respondents

Through: Mrs. Prathiba M.Singh with Ms. Saya
Choudhary and Mr. Kapil Wadhwa, Advocates for
R-1.

WITH

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W.P.(C) No. 13295 of 2009

COLORCON INC.

..... Petitioner

Through: Mr. Sudhir Chandra, Sr. Advocate with
Mr. Sanjay Kumar, Ms. Arpita Sawhney and Mr.
Sukhdev, Advocates.

versus

IDEAL CURES PVT LTD & ORS.

..... Respondents

Through: Mr. Chetan Sharma, Sr. Advocate with
Mr. Sanjay K. Tiwari, Advocate for R-1.

WITH

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W.P.(C) No. 12006 of 2009

YEDA RESEARCH & DEVELOPMENT CO. LTD. Petitioner

Through: Mr. Sudhir Chandra, Sr. Advocate with
Mr. Sanjay Kumar, Ms. Arpita Sawhney and Mr.
Sukhdev, Advocates.

versus

NATCO PHARMA LTD & ORS. Respondents
Through: Mr. Chetan Sharma, Sr. Advocate with
Mr. Sanjay K. Tiwari, Advocate for R-1.

WITH

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W.P.(C) No. 8393 of 2009

ELI LILLY & CO. Petitioners
Through: Mr. Sudhir Chandra, Sr. Advocate with
Mr. Sanjay Kumar, Ms. Arpita Sawhney and Mr.
Sukhdev, Advocates.

versus

AJANTA PHARMA LTD. ORS Respondents
Through: Mr. Rajeev Kumar Virmani, Sr. Advocate
with Mr. H.V. Chandola, Advocate for R-1.

WITH

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W.P.(C) No. 8392 of 2009

ELI LILLY & CO. Petitioner
Through: Mr. Sudhir Chandra, Sr. Advocate with
Mr. Sanjay Kumar, Ms. Arpita Sawhney and Mr.
Sukhdev, Advocates.

versus

AJANTA PHARMA LTD. Respondent
Through: Mr.
Rajeev Kumar Virmani, Sr. Advocate
with Mr. H.V. Chandola, Advocate for R-1.

AND

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W.P.(C) No. 8388 of 2009

ELI LILLY & CO. Petitioner

Through: Mr. Sudhir Chandra, Sr. Advocate with
Mr. Sanjay Kumar, Ms. Arpita Sawhney and Mr.
Sukhdev, Advocates

versus

RANBAXY LABORATORIES LTD & ORS. Respondents
Through: Mr. Ayush Sharma, Advocate for R-1.

CORAM:
HON'BLE DR. JUSTICE S. MURALIDHAR

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| 1. | Whether Reporters of local papers may be allowed to see the judgment? | Yes |
| 2. | To be referred to the Reporter or not? | Yes |
| 3. | Whether the judgment should be reported in Digest? | Yes |

ORDER
08.02.2010

1. These six petitions raise an important question of law concerning the maintainability of a writ petition under Article 226 of the Constitution to challenge an order passed by the Controller of Patents ('Controller') either allowing or rejecting a pre-grant opposition filed under Section 25 (1) of the Patents Act, 1970 ('Patents Act').

2. Before discussing the facts of the individual cases the scheme of the Patents Act, particularly after the amendment to the relevant provisions by way of Patents (Amendment) Act, 2005 ('Amendment Act') as well as the judgment of the Supreme Court in *J. Mitra & Company v. Assistant Controller of Patents & Designs (2008) 10 SCC 368* require to be examined.

The statutory scheme of the relevant provisions of the Patents Act

3. Section 15 of the Patents Act states that where the Controller is satisfied that the application for grant of patent, or any specification or any other
W.P. (C) Nos. 332 of 2010 & 13295, 12006, 8393, 8392 & 8389 of 2009 *page 3 of 25*

document filed in pursuance thereof, does not comply with the requirement of the Patents Act or the Rules, “the Controller may refuse the application or may require the application, specification or other documents, as the case may be, to be amended to the satisfaction before he proceeds with the application or refuse the application on failure to do so.”

4. Prior to its amendment in 2005 with effect from 1st January 2005, Section 25 (1) of the Patents Act provided that at any time within four months from the date of advertisement of the acceptance of a complete specification “any person interested may give notice to the Controller of Patents (‘Controller’) of opposition to the grant of patent on the grounds set out in Section 25 (1) (a) to 25(1) (k) of the Patents Act. Section 25 (2), prior to the 2005 amendment, stated that when any such notice of opposition is given, the Controller shall notify the applicant (for a patent) and give to the applicant and the opponent an opportunity of being heard before deciding the case. Therefore, at the pre-grant stage, prior to the amendment in 2005, the Controller could either refuse the patent application or require the applicant to make amendments to the satisfaction of the Controller and if such changes were not made as directed, he would refuse the application. Therefore Section 15 of the Patents Act contemplated either eventuality resulting from a decision of the Controller on a pre-grant opposition under Section 25(1) i.e. the grant of the patent with or without amendments, or the refusal of the patent.

5. Prior to its amendment in 2005, against an order under Section 15 refusing a patent and against an order under Section 25, an appeal lay in terms of Section 116 of the Patents Act to the High Court. Prior to 2005, there was no

provision for a post-grant opposition. However, the 2005 amendments brought a significant change in this scheme.

6. In 2002 amendments were made to the Patents Act to provide for appeals to the Intellectual Property Appellate Board (IPAB) in terms of the newly inserted Section 117 A instead of appeals to the High Court under Section 116. However, these amendments were not notified till 2nd April 2007. Meanwhile another major set of amendments were introduced with effect from 1st January 2005 under the Amendment Act of 2005. For the first time a provision was made, in the form Section 25 (2) to provide for a post-grant opposition. Section 25(1) concerning pre-grant opposition remained more or less the same and sub-clauses (a) to (k) set out the various grounds on which a pre-grant opposition could be filed. It also incorporated the pre-grant opposition procedure which required the Controller to hear the opposer. While under the amended Section 25 (1) 'any person' could file a pre-grant opposition [as against only an 'interested' person under the pre-amended Section 25 (1)], only an 'interested' person could file a post-grant opposition under Section 25 (2) of the Patents Act as amended. The post-grant opposition had to be filed "at any time after the grant of the patent but before the expiry of a period of one year or from the date of publication of grant of the patent." The amended Section 25(2) sets out the grounds on which such post-grant opposition could be made. Under Section 25 (3) when such post-grant opposition notice is given, the Controller simultaneously with notifying the patentee shall also constitute an Opposition Board which would then conduct the examination of such opposition and submit its recommendations to the Controller. Section 25(4) states that thereafter the Controller shall make an

order, after giving the patent holder and the opposer an opportunity of being heard and pass an order either to maintain or to amend or to revoke the patent. Under Section 25(6) in the event the Controller orders that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly.

7. Simultaneous with the introduction of the remedy of a post-grant opposition, the Amendment Act 2005 also amended Section 117A to provide an appeal against an order passed under Section 25(4) by the Controller on the post-grant opposition which could be an order “either to maintain or to amend or to revoke the patent.” Therefore as it presently stands, after the amendment in 2005, while Section 117A provides an appeal to the IPAB against an order under Section 25 (4), it does not expressly provide an appeal against an order in a pre-grant opposition under Section 25(1) of the Patents Act. What is significant however is that Section 117A does continue to provide an appeal to the IPAB against an order of the Controller under Section 15 of the Patents Act.

The decision in J.Mitra & Co. case

8. Before discussing the ratio of the judgment in ***J. Mitra & Co.***, the facts of that case may be noticed briefly. On 14th June 2000 J. Mitra filed an application for the grant of a patent. A pre-grant opposition was filed by Span Diagnostics Ltd. (‘Span’) in 2000. On 23rd August 2006 the Controller rejected Span’s pre-grant opposition. As on that date against an order rejecting the pre-grant opposition under Section 25, an appeal was available to Span before the High Court under Section 116 of the Patents Act (it must be ***W.P. (C) Nos. 332 of 2010 & 13295, 12006, 8393, 8392 & 8389 of 2009*** ***page 6 of 25***

clarified here that although Section 117 A was inserted in the Patents Act in 2002, it was not notified till 2nd April 2007 and therefore as on August 2006 the older regime of an appeal before the High Court under Section 116 continued). Consequently, Span filed FAO Nos. 292 and 293 of 2006 in the High Court on 17th October 2006 to challenge the rejection of its pre-grant opposition by the Controller under Section 25(1) of the Patents Act.

9. An objection was taken by J. Mitra & Co. to the maintainability of the appeal before the High Court on the ground that the appeal was required to be transferred to the IPAB in terms of Section 117 G notified with effect from 2nd April 2007. By a judgment dated 1st April 2008 the High Court held that in view of the fact that Section 25 (2) which provided for a post-grant opposition was introduced only on 4th April 2005 and Section 117 A was notified with effect from only 2nd April 2007, the appeal filed by Span in the High Court on 17th October 2006 under Section 116 was maintainable before it. However, even while it noted that no appeal against an order under Section 25 (1) of the Patents Act was maintainable before the IPAB, the High Court transferred the said appeal also to the IPAB because Section 117 G mandated that “all appeals against any order or decision of the Controller” would get transferred to the IPAB.

10. Faced with the above anomalous situation, J. Mitra & Co. filed a Special Leave Petition in the Supreme Court challenging the order of the High Court. After analyzing the various provisions of the Patents Act, the Supreme Court in para 29 (SCC, p. 381) held as under:

“29. In the present case, the Legislature intended to provide for two types of scrutiny followed by one statutory appeal to the Appellate Board against "post-grant proceedings". The Legislature intended to have a dichotomy between "pre-grant opposition" and "post-grant opposition". However, the Legislature intended that there shall be only one statutory appeal against grant of patent. The Legislature intended to obliterate appeal from "pre-grant proceedings", which existed earlier. However, it was left to the Executive to bring the enacted law into force vide notification. For some unknown reasons, the amended Sections 116 and 117A(2) were not brought into force till 2.4.07 whereas the concept of "pre-grant" and "post-grant" oppositions were brought into force w.e.f.1.1.2005. This is where the legislative intent got defeated during the interregnum. It is during this interregnum that respondent No. 3 filed its FAO No. 293/06 in the High Court under Section 116, as it stood on 19.10.06 under the Patents (Amendment) Act, 1999. On that date, the amended Section 117A, suggested by Patents (Amendment) Act, 2005, was not brought into force. On 19.10.06 the old law prevailed under which an appeal lay before the High Court. Respondent No. 3, in both the cases, preferred first appeals to the High Court under Section 116 as it then stood. They are FAO No. 292/06 and FAO No. 293/06. We have to decide the fate of these pending appeals. One more aspect needs to be mentioned. Under the Patents (Amendment) Act, 2005, appeal is provided to the Appellate Board against the order of the Controller under Section 25(4). However, that statutory appeal is maintainable only in "post-grant opposition" proceedings whereas respondent No. 3 herein has instituted first appeals under the law then prevailing, challenging the Order rejecting "pre-grant opposition" dated 23.8.06.”

11. It was noticed by the Supreme Court that there were hardly one or two matters of that nature that were pending in the High Court. It was observed that Span could not be left without a remedy. Consequently, it was ordered that the two appeals filed by Span should be heard and decided by the High Court. An observation in para 31 of the order “**that the Appellate Board after 2nd April 2007 is entitled to hear appeals only arising from orders passed by the Controller under Section 25(4) i.e. in cases of orders passed in “post-grant opposition”**” is what has given rise to the present round of litigation.

12. The challenge in these writ petitions is two types of orders of the Controller in a pre-grant opposition filed under Section 25(1) of the Patents Act. One allowing such opposition and refusing the grant of patent. The other, rejecting the opposition and granting the patent. Arguments have been advanced by learned counsel appearing for the applicants for the grant of patent whose applications have been refused by accepting the pre-grant opposition. Arguments have also been advanced on behalf of those who had filed pre-grant oppositions which have either been allowed or rejected.

Distinction between pre-grant and post-grant opposition

13. In the first instance a distinction has to be drawn between a pre-grant opposition and a post-grant opposition. While a pre-grant opposition can be filed under Section 25 (1) of the Patents Act at any time after the publication of the patent application but before the grant of a patent, a post-grant opposition under Section 25(2) of the Patents Act has to be filed before the

expiry of one year from the date of the publication of the grant of patent. A second significant difference, after the amendment of 2005, is that a pre-grant opposition can be filed by 'any person' whereas a post-grant opposition under Section 25(2) can be filed only by 'any person interested'. It may be noticed that the application for revocation of a patent in terms of Section 64 of the Patents Act can also to be filed only by 'any person interested'. In other words, the post-grant opposition and the application for revocation cannot be filed by just about any person who is not shown to be a person who is 'interested'. A third significant difference is that the representation at the stage of pre-grant is considered by the Controller himself. Rule 55 of the Patents Rules requires the Controller to consider the 'statement and evidence filed by the applicant' and thereafter either refuse to grant the patent or require the complete specification to be amended to his satisfaction. Of course, in that event notice will be given to the applicant for grant of patent who can file his reply and evidence. This Court finds merit in the contention that the pre-grant opposition is in fact 'in aid of the examination' of the patent application by the Controller. The procedure is however different aspect as far as the post-grant opposition is concerned. There in terms of Section 25 (3), the Controller has to constitute an Opposition Board consisting of such officers as he may determine and refer to such Opposition Board the notice of opposition along with other documents for its examination and recommendations. After receiving the recommendations of the Opposition Board, the Controller gives the patentee and the opponent an opportunity of being heard. The Controller then takes a decision to maintain, amend or revoke the patent. The fourth major difference between the pre-grant and the post-grant opposition is that while in terms of Section 117 A an appeal to the IPAB is maintainable against

the order of the Controller in a post-grant opposition under Section 25(4) of the Patents Act, an appeal has not been expressly been made available against an order made under Section 25(1) of the Patents Act.

14. There are two possible situations arising from the order passed by the Controller in a pre-grant opposition. Where the pre-grant opposition is rejected, the aggrieved person would obviously be the person who has filed the pre-grant opposition. Where the Controller accepts the pre-grant opposition and therefore refuses the grant of patent or suggests amendments which are then not carried out by the applicant resulting in the refusal of the grant of patent, the aggrieved person obviously would be the applicant for the patent.

Where the pre-grant opposition is rejected and patent is granted

15. In the first eventuality, where the pre-grant opposition is rejected, it is apparent from the decision in *J. Mitra* and from a reading of Section 25 with Section 117A that as long as the person who has filed that opposition happens to be a person interested, he would, after 1st January 2005 [the date with effect from which Section 25 (2) came into force although the provision was introduced only on 4th April 2005] have the remedy of filing a post-grant opposition. He can, after 2nd April 2007, also file an application before the IPAB under Section 64 of the Patents Act for revocation of the patent. In other words, as explained by the Supreme Court in *J. Mitra & Co.* as long as that person is able to show that he is a person 'interested', he is not without a remedy after his pre-grant opposition is rejected. He in fact has two remedies.

Even if his post-grant opposition is rejected, he can thereafter file an appeal to the IPAB under Section 117A. Against the decision of the IPAB in either event he will have the remedy of seeking judicial review in accordance with law by filing a petition in the High Court. At this juncture it may be noticed that in an order dated 2nd March 2009 in SLP (C) No. 3522 of 2009 (***Indian Network for People with HIV/AIDS v. F.Hoffman-La Roche***) the Supreme Court permitted the unsuccessful pre-grant opposer, who had challenged the rejection of his opposition by the Controller, to participate in the post-grant stage.

16. The law is well settled that notwithstanding that a High Court has the power and the jurisdiction under Article 226 of the Constitution to interfere with the orders of any statutory authority which is of a quasi-judicial nature, it will decline to exercise such jurisdiction where there is an efficacious alternative statutory remedy available to the aggrieved person. See for e.g., ***Special Director v. Mohd. Ghulam Ghouse (2004) 3 SCC 440*** [para 5 at page 443] ***Uttaranchal Forest Development Corp. v. Jabar Singh (2007) 2 SCC 112*** [paras 43-45 at page 137], ***U.P. State Spinning Company Ltd. v. R.S. Pandey (2005) 8 SCC 264*** [paras 11-24 at pages 270-275], ***Titaghur Paper Mills Company Ltd. v. State of Orissa (1983) 2 SCC 433*** [para 6 at pages 437-438; paras 8 & 9 at page 439; para 12 at page 441], ***Karnataka Chemical Industries v. Union of India (2000) 10 SCC 13*** [para 2 at page 14] ***Assistant Collector of Central Excise v. Jainson Hosiery Industries (1979) 4 SCC 22*** [para 1 at page 23] and ***U.P. State Bridge Ltd. v. U.P. Rajya Setu Nigam S. Karamchari Sangh (2004) 4 SCC 268*** [para 11 at pages 275-276; para 17 at page 278].

17. Counsel for the parties have drawn the attention of this Court to a recent decision of the Division Bench of the Bombay High Court in *Glochem Industries Ltd. v. Cadila Healthcare Ltd.* (its decision dated 6th November 2009 in Writ Petition No. 1605 of 2009). Although in that case the petitioner whose pre-grant opposition had been rejected was obviously a person ‘interested’ the High Court overruled the objections as to maintainability since it took the view that the Controller’s order in that case suffered from obvious jurisdictional errors. The Bombay High Court nevertheless noted that “it is a matter of prudence and discretion as to whether this court should entertain the writ petition or not” and that in the facts and circumstances of that case it was “not proper to non-suit the petitioners at the threshold on this count.” To this Court it appears that the settled law as explained in several decisions of the Supreme Court (which incidentally have not been adverted to by the Bombay High Court in *Glochem*) makes it clear that this Court should not entertain the writ petition, not because it does not have the power or jurisdiction, but because the petitioner has an efficacious alternative statutory remedy to exhaust.

18. To summarise this part of the discussion, as regards persons who have not succeeded in the pre-grant opposition stage to prevent the grant of a patent, and are persons ‘interested’ within the meaning of Section 25(2) and Section 64 of the Patents Act, their remedy against the rejection of their pre-grant opposition is to file a post-grant opposition under Section 25(2) and await the decision of the Controller. If they are still aggrieved by that decision under

Section 25(4) of the Patents Act, they can file an appeal before the IPAB in terms of Section 117A of the Patents Act.

Where the pre-grant opposition is by a third party

19. It was contended by some of the counsel appearing for those who filed the pre-grant opposition, that where the pre-grant opposer is a third party and not a person 'interested', then such a person would not have the remedy of either filing a revocation under Section 64 or a post-grant opposition under Section 25(2). In that event the remedy under Article 226 of the Constitution cannot be shut out to such a person. This was countered by learned counsel for the applicants for grant of patent by submitting that the legislature consciously intended not to give persons who are not interested further opportunities to challenge the grant of a patent as that would make the whole process extremely cumbersome for the applicant for a patent. Consequently, it is submitted that the said legislative scheme cannot be substituted by the Court and that there was nothing unreasonable in not entertaining a writ petition at the instance of such person.

20. In the first place this Court would like to observe that none of the applicants who have filed a pre-grant opposition in these cases, and whose applications have either been accepted or rejected, are persons who are not 'interested persons'. Therefore this question is purely academic as far as this batch of petitions is considered. Secondly, prior to the amendment in 2005, a pre-grant opposition could be filed only by an interested person and not a third party. The right of 'any' person to file a pre-grant opposition was granted only with effect from 1st January 2005 when the re-cast section 25 (1)

became effective. Given the differences in the pre-grant and post-grant oppositions, the legislature appears to have consciously denied to a third party a further statutory remedy of a post-grant opposition in the event of such third party not succeeding in the pre-grant stage to prevent the grant of patent. Since there is no challenge to the constitutional validity of the re-cast Section 25 by any third party in these proceedings, this Court is not called upon to decide that issue. Nevertheless, as regards the maintainability of a writ petition by such third party pre-grant opposer against the Controller's order rejecting the opposition, this Court would like to observe that the power under Article 226 of the Constitution is wide and can be exercised on the facts and circumstances of a given case where it appears to this Court that there is no other efficacious remedy available or that the interests of justice require this Court to interfere.

21. Therefore where a pre-grant opposition under Section 25 (1) is filed by a person who is a third party and not a person interested in the sense of the term under Section 25(2) or Section 64 of the Patents Act, and such pre-grant opposition is rejected by the Controller, it would be for this Court when approached by such third party pre-grant opposer under Article 226 of the Constitution to determine if in the facts and circumstances, the petition requires to be entertained.

Pre-grant opposition is accepted and the grant of patent is refused

22. In the second eventuality where the pre-grant opposition is accepted and the grant of patent is refused by the Controller, although the decision is one taken under Section 25(1), it is in effect a decision relatable to and under

Section 15 of the Patents Act. An appeal is provided under Section 117A of the Patents Act against the decision of the Controller under Section 15 of the Patents Act. It appears to this Court that the observation in *J. Mitra* in para 24 that “the Appellate Board after 2nd April 2007 is entitled to hear appeals **only** arising from orders passed by the Controller under Section 25(4) i.e. in cases of orders passed in post-grant opposition” has to be understood in the context of that case where the Court was only considering whether against the rejection of a pre-grant opposition an appeal lay to the High Court or to the IPAB. Considering that the appeal in that case had been filed in the High Court on 17th October 2006 prior to Section 117A being notified, the Supreme Court in *J. Mitra & Co.* held that the said appeal would continue before the High Court. The question whether an appeal would lie against the refusal by the Controller to grant a patent after accepting the pre-grant opposition under Section 25(1) of the Patents Act did not arise for consideration in *J. Mitra & Co.* The further question whether such refusal to grant patent would in fact be relatable to Section 15 of the Patents Act also did not arise for consideration. Consequently, there was no occasion for the Supreme Court in *J. Mitra & Co.* to decide whether in such event an appeal would be available to the applicant for patent before the IPAB.

23. In the considered view of this Court where the grant of patent is refused by the Controller after accepting a pre-grant opposition under Section 25(1) of the Patents Act, the applicant for a patent will have a remedy by way of an appeal to the IPAB under Section 117A of the Patents Act. The refusal to grant patent is in fact relatable to and should be understood as an order by the

Controller under Section 15 of the Act which order is in any event appealable to the IPAB under Section 117 A.

24. Now this Court proceeds to deal with each of the individual cases.

W.P. (Civil) No. 8388 of 2009

25. In this petition the Petitioner Eli Lilly & Co. filed an application on 23rd January 1995 for a patent in respect of 'Tetracyclic Derivatives.' Exclusive Marketing Rights were granted to it on 26th August 2004. The first examination report was issued by the Patent Office on 12th April 2005. On 23rd September 2004 Ranbaxy Laboratories Limited ('RLL') filed a pre-grant opposition. On 22nd March 2007 the Assistant Controller of Patents and Designs, New Delhi gave a decision on the pre-grant opposition allowing the process claims 11 to 25 and 28 and declined the product claims. On 22nd May 2007 Eli Lilly & Co. filed a review petition as regards the rejection of its product claim. The Assistant Controller dismissed the review petition on 20th June 2008 on the ground that it was not maintainable. Further, Eli Lilly & Co. was directed to comply with the directions in the impugned order dated 22nd March 2007 deleting the products and retaining the process claims by 20th June 2008. Since this was not done by Eli Lilly, by a decision dated 1st July 2008 the Assistant Controller passed an order refusing to grant patent. On 4th July 2008 Eli Lilly & Co. requested the Assistant Controller to reconsider the order dated 1st July 2008. Thereafter, the present petition was filed by Eli Lilly & Co under Article 226 challenge the orders dated 22nd March 2007, 20th June 2008 and 1st July 2008 passed by the Assistant Controller and for a direction to him to grant a patent.

26. In the counter affidavit filed by RLL it has been urged that the petition should be dismissed both on the ground of maintainability as well as on merits.

27. In view of the decision of this Court as detailed hereinbefore, this Court declines to exercise its jurisdiction under Article 226 to entertain this petition, not because it does not have the power to do so, but because in the considered view of this Court, the Petitioner has an efficacious remedy by way of an appeal under Section 117 A of the Patents Act before the IPAB. The order refusing the grant of patent is in fact an order under Section 15 of the Patents Act which in terms of Section 117 A is an appealable order. If the appeal before the IPAB is filed by Eli Lilly & Co within a period of two weeks from today, accompanied by an application for condonation of delay in filing the appeal, the IPAB will consider and decide such application, after hearing RLL. The IPAB will take into account the period during which Eli Lilly & Co.'s review application against the order dated 22nd March 2007 and thereafter the present writ petition were pending. All contentions of both Eli Lilly & Co. and RLL are left open to be urged before the IPAB which will be dealt with such contentions in accordance law. The petition is disposed of in the above terms.

W.P. (Civil) Nos. 8392 & 8393 of 2009

28. In both these petitions the Petitioner is Eli Lilly & Co. and subject matter is the same as in WP (Civil) 8388 of 2009 except that the pre-grant opposition in this case was filed by the Respondent Ajanta Pharma Limited ('APL').

29. Aggrieved by the decision dated 23rd February 2007 by the Assistant Controller allowing the process claims of Eli Lilly & Co., APL filed an appeal in this Court being FAO No. 136 of 2007 on 3rd April 2007 i.e. one day after coming into force of Section 117 A of the Patents Act. By an order dated 1st May 2007 this Court transferred the appeal to the IPAB. It is stated by APL that at that point of time Eli Lilly & Co. did not challenge the order of this Court and participated in the proceedings before the IPAB. However, after waiting more than 13 months, on 11th June 2008 Eli Lilly & Co. filed an interlocutory application before the IPAB seeking dismissal of the APL's appeal on the ground of maintainability. The IPAB by its order dated 13th August 2008 rejected Eli Lilly's interlocutory application. In its order the IPAB held that the right of APL to file an appeal in this Court had accrued even on the date when APL had filed a pre-grant opposition and that right could not be taken away only because Section 117 A had been notified with effect from 2nd April 2007. Secondly, since the High Court had itself transferred the appeal to it, the IPAB was bound to hear the appeal.

30. Mr. Rajiv Kumar Virmani, learned Senior counsel appearing for the APL vehemently opposed the plea of the Petitioner that it should be permitted to file an appeal before the IPAB on the ground that by not challenging the earlier order dated 1st May 2007 passed by this Court, Eli Lilly should be deemed to have waived its right to file an appeal or to oppose APL's appeal before the IPAB.

31. This Court has difficulty in accepting the above submissions on behalf of APL. It is also unable to concur with the views expressed by IPAB for the following reasons:

(i) The earlier order dated 1st May 2007 passed by this Court and the decision dated 13th August 2008 by IPAB did not have the benefit of the later decision dated 21st August 2008 of the Supreme Court in *J.Mitra & Company* (supra) which clears the anomalous situation concerning the maintainability of an appeal in this Court after the notification of Section 117 A of the Patents Act. It is plain now that since APL's appeal was filed in this Court after 2nd April 2007, its appeal cannot be maintained in this Court.

(ii) It is not possible to agree with the view of IPAB that since the right to file an appeal had accrued on the very date that APL had filed its pre-grant opposition, and on which date Section 117 A of the Patents Act had not come into effect, the appeal would be maintainable in the High Court, and by virtue of Section 117 G, before the IPAB. As clearly explained by the Supreme Court in *J.Mitra* the remedy for an interested person whose pre-grant opposition has been rejected is to file a post-grant opposition.

(iii) Since in this case APL filed its appeal in the High Court after the coming into force of Section 117 A, it cannot take advantage of the direction in *J Mitra & Co.* to continue with its appeal before the IPAB.

(iv) It is not the contention of APL that it is not an interested party. Therefore, to the extent that the pre-grant opposition has been rejected and the process claims of Eli Lilly have been entertained, it is in the same position as an interested party whose pre-grant opposition has been refused. As already explained hereinbefore, APL had two remedies in such

eventuality. Either to file a post-grant opposition under Section 25 (2) of the Patents Act or file an application under Section 64 before the IPAB for revocation of the patent. In any event no appeal is maintainable in this Court or the IPAB at the instance of APL against the Controller's order dated 22nd March 2007.

32. APL's appeal before the IPAB is not maintainable and is liable to be dismissed as such. In any event it has been rendered infructuous since in the meanwhile Eli Lilly's patent has itself been refused. Therefore, as and when Eli Lilly succeeds in getting the Controller to grant its patent (either the product or the process patent or both), two courses are open to APL. It can file an application under Section 64 of the Patents Act before the IPAB for revocation of the patent. It can also file a post-grant opposition under Section 25 (2) of the Patents Act.

33. As far as Eli Lilly is concerned, it has a remedy by way of an appeal before the IPAB against the impugned orders dated 22nd March 2007 (to the extent of refusal of the grant of a product patent) and the consequential order of 1st July 2008 refusing the grant of patent. If such appeal is filed within a period of two weeks accompanied by an application for condonation of delay it would be considered by IPAB in accordance with law after hearing APL as well.

34. The petitions are disposed of in the above terms.

WP (Civil) No. 332/2010

35. The Petitioner M/s. UCB Farchim SA filed an application on 9th January 2007 in the patents office for grant of patent. A pre-grant opposition was filed by the Respondent No.1 Cipla Limited ('Cipla') on 4th December 2008. On 24th July 2009 the Assistant Controller passed an order allowing the pre-grant opposition and refusing the grant of patent. It is the said order which has been challenged in the present petition under Article 226 of the Constitution.

36. Cipla has filed a note of arguments which have been reiterated by its counsel Ms.Pratibha Singh. It is contended that after the decision of the Supreme Court in *J. Mitra & Co.* (supra) "the correct course of action to be followed by the Petitioner would be that of preferring an appeal to the IPAB under Section 117 A of the Patents Act and not filing of the present writ petition."

37. This Court has held hereinabove that the correct course of action for an applicant for grant of patent who is aggrieved by the refusal to grant patent is to file an appeal before the IPAB.

38. Accordingly, this Court declines to entertain the present writ petition and permits the Petitioner to file an appeal within a period of two weeks before IPAB accompanied by an application for condonation of delay. The IPAB will consider such application, after hearing Cipla, and after accounting for the period during which the present writ petition was pending.

39. The petition is disposed of.

WP (Civil) No. 12006/2009

40. The Petitioner M/s. Yeda Research & Development Co. Limited ('YRDCL') has filed an application for grant of patents on 5th February 2003. The Respondent Natco Pharma Limited ('NPL') filed a pre-grant opposition on 15th November 2007. By the impugned order dated 3rd March 2009 the Assistant Controller of Patens rejected the application of YRDCL for grant of patents. The said order has been challenged in the present petition.

41. This Court heard the submissions of Mr.Sudhir Chandra, learned Senior counsel appearing for the Petitioner and Mr. Chetan Sharma, learned Senior counsel appearing for the Respondent No.1.

42. In view of what has been held hereinbefore, the appropriate course for the Petitioner would be to file an appeal before the IPAB under Section 117 A of the Patents Act against the order dated 3rd March 2009 passed by the Assistant Controller of Patents. If such an appeal is filed within two weeks, accompanied by an application for condonation of delay in filing the appeal, the IPAB will consider such application on merits in accordance with law after accounting for the period during which the present writ petition has been pending. Needless to say that IPAB will hear NPL before passing such order.

43. The petition is disposed of.

WP (C) 13295/2009

44. The Petitioner M/s. Colorcon Inc. filed an application for grant of patents on 4th January 2002. The Respondent Ideal Cures Pvt. Limited ('ICPL') filed a pre-grant opposition on 6th February 2006. By the impugned order dated 9th August 2006 the Assistant Controller of Patents rejected the application for grant of patent. The Petitioner did not immediately challenge the said order. It filed a review petition under Section 77 (f) of the Patents Act. The said review petition was also dismissed by the Assistant Collector of Patents by an order dated 16th March 2009. It is the said order which has been challenged in the present writ petition.

45. This Court heard the submissions of Mr.Sudhir Chandra, learned Senior counsel appearing for the Petitioner and Mr. Chetan Sharma, learned Senior counsel appearing for the Respondent No.1.

46. In view of the law as explained hereinbefore, the correct course of action for the Petitioner, would be to file an appeal before the IPAB under Section 117 A of the Patents Act against the order dated 16th March 2009 passed by the Assistant Controller of Patents. If such an appeal is filed within two weeks, accompanied by an application for condonation of delay in filing the appeal, the IPAB will consider such application on merits in accordance with law after accounting for the period during which the present writ petition has been pending. The IPAB will hear the Respondent ('ICPL') before passing such order. The petition is disposed of.

47. Order dasti to the parties. A certified copy of this order be delivered to the IPAB within five days.

S. MURALIDHAR, J

February 08, 2010

dn/rk