

**The Patents Act, 1970
(AS AMENDED)
(Section 15)**

**In the matter of the application for
Patent Application No. 1146/KOLNP/2007 filed on 03/04/2007.
Merck Sharp & Dohme Corp. - Applicant.**

Hearing held on – 11/10/2019

Present: Dr Prosenjit Chattopadhyaya of Laxmikumaran & Sridharan, New Delhi - On behalf of Merck Sharp & Dohme Corp.

Decision

The instant application was filed on 03/04/2007, bearing number 1146/KOLNP/2007 as divisional application to original application 105/KOLNP/2005 [of PCT national phase application of PCT/US2003/021977, international filing date 15/07/2003 and claiming U.S.A. priority dated 29/07/2002]. The application was filed by S. Chakraborty of D. P Ahuja & Co., Kolkata on 03/04/2007 on behalf of Optimer Pharmaceuticals INC. The application was published under section 11A on 01/08/2008 and request for examination (Form 18) was filed on 01/10/2007. The application was examined and First Examination Report (FER) was issued on 09/09/2009. Form 6 was filed on 11/01/2016 for change in applicant from Optimer Pharmaceuticals INC to Merck Sharp & Dohme Corp. Form 13 was filed on 01/03/2017 for change in address of service from D. P Ahuja & Co., Kolkata to Laxmikumaran & Sridharan, New Delhi. During the prosecution of the said application, it was found that objections were outstanding after expiry of last date for putting the application in order of grant. In order to dispose the application and as last date was expired, the applicant was given an opportunity of being heard and accordingly, a hearing under section 14 of the Patents Act was held on 05/07/2018. The applicant's agent attended the same. During the hearing applicant submitted their observations in respect of the objections and subsequently submitted the written note of arguments and other required documents on 19/07/2018. The application was refused under section 15 on 25/09/2018 as the instant application was not considered as a divisional application under section 16 of the Patents Act.

Subsequently a writ petition, W.P. No. 1519 (W) of 2019, was preferred by the Applicant before the Hon'ble High Court of Calcutta. *Vide* order dated March 13, 2019, the Hon'ble High Court of Calcutta allowed the said writ petition and quash the order dated 25/09/2018. The Hon'ble High Court issued a direction to consider and decide the divisional application as also the application for grant of patent, in accordance with law.

The applicant was given an opportunity of being heard and accordingly, a hearing was held on 11/10/2019.

To overcome the objection raised in paragraph 1 of the hearing notice the applicant has submitted that an updated Form-3 was filed at the Indian Patent Office (IPO) on 19/07/2018 and a petition to condone the irregularity in filing Form-3 was filed at the IPO on 26/07/2018.

To overcome the objection raised in paragraph 2 of the hearing notice the applicant has submitted that the source and geographical origin of the microorganism as recited in the pending claim 1, i.e., subculture of *Dactylosporangium aurantiacum* subspecies *hamdenensis* used in the present invention is the Northern Regional Research Centre, the United States Department of Agriculture, 1815 North University Street, Peoria, IL. 6604, U.S.A. The applicant further confirmed that all the experiments were carried out in the instant application were performed in the United States of America. Further, the applicant specified the same in the beginning of the as-filed specification of the instant application and submitted an updated page 2 of the as-filed specification of the instant application.

After carefully considering the submission made by the applicant's agent during the hearing & written submission and the amended claims on record meet the objections communicated in the hearing notice. Therefore instant application with claim 1 – 10 submitted on 21/10/2019 is allowed for grant of patent.

23/10/2019

(Dr. Abhijit Das)

Assistant Controller of Patents & Designs.