

19 March 2019

To,

Dr. Abhijit Das

The Assistant Controller of Patents & Designs,
The Patent Office, CP-2 Sector-V, Salt Lake City,
Kolkata 700091
India**Sub: Revival of the DIVISIONAL APPLICATION 1146/KOLNP/2007 OF MERCK
SHARP A& DOHME CORPORATION (APPLICANT).****Our Ref.: PD031820IN-LP**

Dear Sir,

We act for and on behalf of Merck Sharp & Dohme Corporation, the Applicant in the
captioned application.

We wish to inform you that pursuant to the refusal order dated September 25, 2018 with regard to the subject divisional patent application, 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 was pleased to allow the said writ petition and quash the order dated September 25, 2018. The Hon'ble High Court was further pleased to issue a direction to the effect that the IPO would consider and decide the subject divisional application for grant of patent in accordance with law. A copy of the above-mentioned order passed by the Hon'ble High Court is annexed and marked herewith as "**Annexure A**".

In light of the aforesaid order, we request you to kindly proceed with the captioned application and provide us a hearing at the earliest.

Thanking you,

Yours Faithfully,

Malathi Lakshmikumaran**IN/PA-1433****Agent for the Applicant****Lakshmikumaran & Sridharan, Attorneys.**

Enclosure:

1. Annexure A: Order dated March 13, 2019 passed by the Hon'ble High Court of Calcutta in the Writ Petition, W.P. No. 1519 (W) of 2019.

13.03.2019
Ct. No.8
ML No.264
KS

W. P. No.1518 (W) of 2019

**Merck Sharp & Dohme Corp.
Versus
Union of India & Ors.**

Mr. Parthasarathy R
Mr. Rishi Raju
.....For the Petitioner
Mr. Rabi Prosad Mookherjee
Mr. Sunil Singhania
.....For the U.O.I.

An order dated July 5, 2018 passed by the Assistant Controller of Patents & Designs is under challenge in the present writ petition.

Learned advocate appearing for the petitioner submits that, although, the Patents Act, 1970 allows an appeal against the impugned order, for all practical purposes, the petitioner is unable to prefer an appeal since, the appellate authority is without a technical member and, therefore, does not have the quorum to hear an appeal. He relies upon a judgment and order dated January 28, 2019 passed by the Division Bench in **MAT No.1548 of 2017 with CAN No.9096 of 2017 (*Reata Pharmaceuticals Inc. vs. Union of India*)** and submits that, a similar writ petition was initially disposed of by the learned Single Judge on the ground of existence of statutory alternative remedy and on appeal, the Appeal Court found that, the statutory alternative remedy of an appeal was not available to the petitioner on the date of filing of such writ petition, as the technical member was absent. Consequently, he submits that, following such ratio, the writ petition be entertained.

He also draws the attention of the Court to the impugned order and submits that, the petitioner initially filed an application for grant of patent. Over the years, while considering such application for patent, the Predecessor-in-Office of the adjudicating authority was of the view that, a divisional application ought to be made by the petitioner. The petitioner complied with the same. The divisional application was made. The same was being for consideration. Subsequently, by the impugned order, the adjudicating authority found that, since, the petitioner made the divisional application voluntarily, the application for patent cannot be considered. He submits that, the impugned order proceeds on an erroneous appreciation of fact. The divisional application was made pursuant to an observation made by the Predecessor-in-office of the adjudicating authority. In any event, even if, the divisional application was made voluntarily, then also, the same was a curable defect at best and that, the adjudicating authority ought to have allowed the petitioner to take curative measures while considering the application for grant of patent. Not having done so, the impugned order stands vitiated.

Respondents are represented.

A writ petition is maintainable notwithstanding the existence of statutory alternative remedy, if it is established before the Writ Court that, the impugned order suffers from such perversity as to warrant an interference.

In the facts of the present case, the petitioner applied for patent. The application was considered by the Predecessor-in-Office of the adjudicating authority. It opined that, the petitioner should make a divisional application which the petitioner did. Subsequent to the divisional application being made, the adjudicating authority found that, the divisional application was made voluntarily. Assuming it to be so, the same could not be made the foundational basis for the

purpose of rejecting an application for grant of patent. The adjudicating authority could have allowed the rectification of the so-called mistake.

In the facts of the present case, the petitioner made the divisional application pursuant to the request made by the predecessor in office of the adjudicating authority. It would be appropriate to request the adjudicating authority to consider and decide the divisional application as also the application for grant of patent, in accordance with law. He is at liberty to modulate and formulate his own procedure, in accordance with law while deciding the application for grant of patent. The impugned order dated September 25, 2018 is quashed. All points raised by the parties are kept open.

W. P. No.1518 (W) of 2019 is disposed of.

No order as to costs.

Urgent certified website copies of this order, if applied for, be made available to the parties upon compliance of the requisite formalities.

(Debangsu Basak, J.)