



Intellectual Property Appellate Board

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OA/45/2015/PT/KOL
TUESDAY, THIS THE 25TH DAY OF AUGUST , 2020

HON'BLE SHRI JUSTICE MANMOHAN SINGH
HON'BLE DR. ONKAR NATH SINGH

CHAIRMAN
TECHNICAL MEMBER (PVPAT)

- 1. OPTIMER PHARMACEUTICALS, INC..**
10110 SORRENTO VALLEY ROAD, SUITE C.,
SAN DIEGO, CA 92121,
UNITED STATES OF AMERICA

...APPLICANT/APPELLANT

(Represented by:ShriR.Parthasarathy)

Versus

- 1. THE CONTROLLER GENERAL OF PATENTS,
DESIGNSAND TRADEMARKS**
BHOUDHIK SAMPADA BHAVAN,
ANTOP HILL, S.M. ROAD,MUMBAI – 400037
- 2. THE ASSISTANT CONTROLLER OF PATENTS
AND DESIGNS**
INTELLECTUAL PROPERTY OFFICE BUILDING,
CP-2 SECTOR V, SALT LAKE CITY,
KOLKATA-700091

...RESPONDENT

(Represented by – None)

ORDER

HON'BLE SHRI JUSTICE MANMOHAN SINGH, CHAIRMAN

1. The present appeal has been filed on behalf of the Appellant, MERCK SHARP & DOHME CORP. (Formerly OPTIMER PHARMACEUTICALS, INC.) against the order dated 21.10.2014. We have heard the learned counsel appearing on behalf of the appellant.
2. The request of earlier hearing of the appeal is allowed in view of the facts explained to us.

3. No counter affidavit has been filed on behalf of the respondents. No one appeared on behalf of the respondents, who have also failed to file the written synopsis.

4. The details of subject Patent Application No. 2945/KOLNP/2007 is as follows:

APPLICATION NUMBER	2945/KOLNP/2007
APPLICATION TYPE	PCT NATIONAL PHASE APPLICATION
DATE OF FILING	10/08/2007
APPLICANT NAME	Originally OPTIMER PHARMACEUTICALS,INC. Proposed to be amended to MERCK SHARP & DOHME CORP.
TITLE OF INVENTION	18-MEMBERED MACROCYCLES AND ANALOGS THEREOF
FIELD OF INVENTION	PHARMACEUTICALS
PCT INTERNATIONAL APPLICATION NUMBER	PCT/US2005/002887
PCT INTERNATIONAL FILING DATE	31/01/2005
PRIORITY DATE	N/A
REQUEST FOR EXAMINATION DATE	19/01/2009
PUBLICATION DATE (U/S 11A)	15/02/2008
FER ISSUED ON	17/01/2012
REPLY TO FER	17/08/2012

5. It has come on record that on 4th June 2013, the Hearing Notice was issued by the Assistant Controller during the course of prosecution of the instant Patent Application no. 2945/KOLNP/2007 and the hearing was scheduled on 21st June 2013.

6. At the request by the Appellant for re-scheduling the hearing, on 17th July 2013, a further Hearing Notice was issued by the Assistant Controller during the course of prosecution of the instant Patent Application no. 2945/KOLNP/2007 and the hearing was scheduled on 26th July 2013.

7. It is the case of appellant that the oral hearing took place before the Assistant Controller on 26th July 2013 and the Appellant, pursuant to the same submitted written submissions on 6th August 2013.

8. The material is placed on record that after a period of more than one year ,*vide* order dated 21st October 2014, another Deputy Controller, Mr. T.V. Madhusudhan issued the refusal order in respect of the instant Patent Application no. 2945/KOLNP/2007, rejecting the said application on the grounds of lack of inventive step and for falling within the scope of Section 3(d) and Section 3(e) of the Patents Act, 1970.
9. It is rightly stated on behalf of the appellant that Mr. Madhusudhan was neither present at the time of the hearing when the submissions were made, nor did he on any occasion seek any clarification from the Appellant or its agents prior to issuing the impugned order.
10. we are of the view that as per facts stated, the impugned order is illegal and it has been passed by the Deputy Controller who never heard the matter. It is further submitted that the impugned order is also in violation of the principles of natural justice, specifically, the principle of *audialterampartem*.
11. The order has to be passed by same officer who had heard the matter. In case, under some reasons, he is not able to pass the order, the matter has to be released by passing the speaking order. Thereafter it is to be re-allotted to another officer who has to conduct fresh hearing from *de novo*, otherwise any order passed in this manner would amount to illegal order. Proper procedure has not been followed in the present case, hence the impugned order is bad and contrary to law and the same is liable to be set-aside.
12. In view of the above, the impugned order is set aside the matter and is remanded in relation to present Patent Application No. 2945/KOLNP/2007 to the Patent office for a fresh hearing by a Controller other than the two controllers involved earlier with a direction that the same be heard and disposed of within a time period of 3 months as the application is of the year 2005.
13. The appeal is allowed.
14. No costs.

-Sd/-

(Dr. Onkar Nath Singh)
Technical Member (PVPAT)

-Sd/-

(Justice Manmohan Singh)
Chairman

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