

Madras High Court

Chandra Sekar vs The Controller Of Patents And ... on 3 May, 2016

W.P.Nos.12620 & 1

IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON : 28.10.2022

DELIVERED ON : 04.11.2022

CORAM:

THE HONOURABLE MR.JUSTICE N.SATHISH KUMAR

W.P.Nos.12620 & 12621 of 2017
and W.M.P.No.13420 of 2017

Chandra Sekar .. Petitioner in both WPs

Vs.

1. The Controller of Patents and Designs
Patent Office, IPR Building,
SIDCO Plot, GST Road,
Guindy, Chennai - 600 032.

2. The Deputy Controller of Patents and Designs
Patent Office, IPR Building,
SIDCO Plot, GST Road,
Guindy, Chennai - 600 032. .. Respondents in both WPs

Prayer in W.P.No.12620 of 2017: Writ Petition has been filed under Art
226 of the Constitution of India seeking a Writ of Certiorarified Mand
quash the order dated 03.05.2016, passed by the second respondent in t
patent application No.8846/CHENP/2011 and direct the respondent to rec
the Petitioner's Indian Patent Application No.8846/CHENP/2011 along wi

<https://www.mhc.tn.gov.in/judis>

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Form 18 and process the same according to law under Rules 137 & 138 of
Patents Rules, 2003 by condoning the delay in filing Form-18 in the sa
patent application.

Prayer in W.P.No.12621 of 2017: Writ Petition has been filed under Art 226 of the Constitution of India seeking a Writ of Certiorarified Mandamus to quash the order dated 03.05.2016, passed by the second respondent in the patent application No.8907/CHENP/2011 and direct the respondent to receive the Petitioner's Indian Patent Application No.8907/CHENP/2011 along with Form 18 and process the same according to law under Rules 137 & 138 of Patents Rules, 2003 by condoning the delay in filing Form-18 in the said patent application.

For Petitioner in both W.Ps.	:	Mr.K.Muthu Selvam for M/s.K & S Partners
For Respondents in both W.Ps.	:	Mr.S.Makesh CGSC

COMMON ORDER Since both the writ petitions have been preferred on the same set of facts, submissions being common, they are taken up together and disposed of by means of this common order.

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2. These two writ petitions have been filed challenging the orders dated 03.05.2016 passed by the second respondent in Patent Application Nos.8846/CHENP/2011 & 8907/CHENP/2011 respectively, in and by which, the second respondent has dismissed the patent applications filed by the petitioner as the request for examination has been filed beyond the prescribed period of 48 months.

3. The brief facts leading to the filing of these writ petitions are as follows:

(i) The writ petitioner is a US Citizen and he has filed applications in respect of Indian Patent Application 8846/CHENP/2011 and 8907/CHENP/2011 respectively. The patent applications are titled 'Methods for Manufacturing a Paint Roller and Component Parts Thereof'. The patent applications entered the Indian National Phase on 29.11.2011 and 30.11.2011 respectively.

(ii) The petitioner engaged the services of New York based firm of attorney namely Greenberg Traurig for filing and prosecution of the national <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 phase applications in countries outside the US. The petitioner was aware that Greenberg Traurig generally engages the services of the local attorneys/lawyers for filing and

prosecuting the patent application in various countries. Accordingly, the petitioner had no direct connection with any of the attorney prosecuting a national phase application in a country outside the US. In brief, all the activities in relation to examination / prosecution of a patent application outside US including Indian national phase application was duly undertaken by Greenberg Traurig only.

(iii) Greenberg Traurig informed the petitioner that they had engaged and availed themselves of the services of one Evergreen Valley Law Group P.C. (erstwhile attorneys). In the month of May, 2013 the petitioner learned from Greenberg Traurig that Form 18 i.e. statutory form for making request for examination has not been filed by the Evergreen Valley Law Group to the Patent Office. Upon inquiring from Greenberg Traurig, the petitioner was informed that Greenberg Traurig had been constantly following up the matter with Evergreen Valley Law Group. The petitioner was also informed by Greenberg Traurig that the request for examination in the appropriate Form 18 could not be filed due to the negligence on the part of Evergreen Valley Law Group. <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 Group.

(iv) The petitioner was also informed by Greenberg Traurig that Evergreen has taken steps for filing request/petition for condonation of delay in filing Form 18. He was also informed that the error occurred in not filing the Form 18 within the prescribed time was due to calendaring error on the part of Evergreen and that the request for condonation of delay may be accepted and Form 18 would be taken on record.

(v) As Greenberg Traurig has stated that no further development was reported, the petitioner decided to change the Indian Attorney. Greenberg Traurig then chose another patent attorney firm in India viz., K & S Partners and approached them for their advice and further appropriate action. During the course of interaction with the new attorney, in the month of August/September, 2013, Greenberg Traurig informed the petitioner that Evergreen had filed the petition for condonation of delay and request for examination on 22.05.2013. The reason for the delay is sheer negligence by not filing Form 18 i.e., docketing or calendaring error. <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017

(vi) The petitioner is always interested and willing to prosecute the patent application in India and there is no negligence or default on his part in issuing instructions or authorising Evergreen Valley Law Group for filing Form 18. It is also evident from the email dated 24.05.2013. In fact, on 29.04.2013 probably the last date for filing Form 18, Greenberg Traurig inquired from Evergreen in respect of filing of Form 18. In response thereto, Evergreen responded that the due date for filing Form 18 in the present case is 29.11.2015 and 30.11.2015 respectively. Admittedly, the error was on the part of Evergreen Valley Law Group in calculating the due date for filing Form 18. Further, till the end of September, 2013 there was no positive response from Evergreen Valley Law Group on the request filed by them for condonation of delay before the patent office.

(vii) The fact remains that the petition for condonation of delay was filed on 22.05.2013 with a prayer to condone the delay of 15 days in filing Form 18. When Form 18 was not accepted by the patent office at Chennai after due date, Evergreen made a petition/letter seeking condonation of

delay of 15 days in filing Form 18.

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(viii) The petitioner decided to file another / supplementary petition seeking condonation of delay disclosing true and correct reasons for non-filing of Form 18 within the prescribed period with request to take Form 18 on record. On 04.10.2013, petitioner's new attorney filed a detailed petition under Rule 137 read with Rule 138 explaining the true and correct reasons for delay in filing Form 18.

(ix) The petitioner vide letter dated 04.12.2013, requested the second respondent to accept Form 18. Though the above orders have been challenged before this Court in W.P.Nos.15081 and 15082 of 2014 respectively, this Court vide common order dated 19.01.2015 allowed the said writ petition with a direction to re-present the application before the second respondent along with a copy of the said order.

(x) Thereafter, after fixing the hearing date for hearing, orders have been passed rejecting the applications which has been challenged mainly on the ground that the respondents have erred in holding that the provision of Rule 137 is not applicable to the present case. The said provision empowers the Controller with the power to correct any irregularity in procedure that can <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 be obviated without any detriment to any person.

(xi) The respondents have not considered the fact that it is due to the sheer negligence of the erstwhile Indian attorney. It is the contention of the petitioner that he should not suffer for the negligence on the part of his attorney.

(xii) The respondents failed to appreciate the fact that the petitioner was always willing and intended to prosecute the patent applications. The provisions governing the Rules of Procedure should be construed liberally. It is submitted that no prejudice would be caused to any person if the delay of 15 days in filing Form 18 is condoned. Hence, the petitioner filed these writ petitions challenging the impugned orders.

4. Common counter affidavit has been filed by the respondents contending as follows:

(i) The granting of patent rights is conferring exclusive rights to the applicant upon the scrutinization of the inventions. It is intrinsic that every process of statutory requirements has to be complied within the period of <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 limitation as stipulated under the Patents Act, 1970 and Rules, failing which, the applicant deprives the right to proceed and in consequence of which the rights of others which was restricted based upon the pending application would be revived. Hence the chance of filing the delay condonation to admit the examination request is implausible in as much as for the reason that would prejudice others.

(ii) According to the respondents, pursuance of the request for examination, the investigation has to be carried out by the respondents to find out whether the invention claimed on a complete specification is anticipated by publication before the date of filing of the applicants complete specification or claimed in any other complete specification on or after the date of filing of the application complete specification and hence if the period of limitation is not complied with, the delay in filing could not be condoned in as much as for the reason that the right accrues to the other applicants in the case of any publication on or after the date of the applicants.

(iii) The applicant being the inventor, as per the requirements of the Patents Act, 1970 the applicant has to directly authorize the Indian Agent and <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 not through the foreign agent, and the averments of the petitioner that because of the sheer negligence of the Indian agent that the request for examination could not be filed within the period of limitation and seeking to condone the delay is unacceptable for the aforementioned reasons.

(iv) As per Rules 137 and 138 of the Patents Rules, 2003 the delay cannot be condoned. The applicant failed to file request for examination (Form

18) within the statutory stipulated period of 48 months from the date of priority of application. The applicant filed the Form 18 on 22.05.2013, after a gap of 22 days after the expiry of the statutory period of 48 months. Therefore, automated computer system of their office did not accept the Form 18 filed by the agent of the petitioner after the prescribed period as it was treated as withdrawn from 30.04.2013.

(v) The object for introducing the request for examination with period of limitation by not allowing the extension of time particularly beyond the period of limitation under Rule 138, is to protect the other inventors who would be prejudiced. Hence, the respondents seeks dismissal of both the writ petitions.

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5. The learned counsel appearing for the petitioner would submit that the delay in filing the patent application is due to the sheer negligence on the part of the Indian agent and the petitioner has been prosecuting his application diligently with his attorney at US, whereas the Indian agent has not filed the application within the period of limitation. The conduct of the petitioner would clearly show that from the very inception, he is very diligent and in fact intended to pursue the same and there was no intention on his part to abandon the patent, whereas the email communications sent between the US attorney and the Indian agent clearly shows that there was an error in calculating the due date and accordingly it is only a clear case of negligence on the part of the Indian Agent, whereas, the petitioner has been prosecuting his application through his patent attorney at US. Therefore, the delay ought to have been condoned by the respondents.

6. In support of his submissions, the learned counsel appearing for the petitioner placed reliance on the judgment of the Delhi High Court in The European Union represented by the European

Commission Vs. Union of India in W.P.(C)-IPD 5 of 2022, dated 31.05.2022 and submitted that as the petitioner has been pursuing his application diligently, it cannot be treated as abandoned. The valuable right of the petitioner should not be defeated due to the negligence on the part of his attorney particularly Indian attorney who failed to submit the application within the period of limitation.

7. It is his further contention that the patent was invented long back and the period of validity of the patent is 20 years and now almost 13 years have been lapsed. It is also stated by the learned counsel that the Parliament Standing Committee on Commerce has also given a report to extend the period of limitation, which has been followed by the Delhi High Court in the above judgment. Hence, the learned counsel seeks to quash the impugned orders and direct the respondents to accept his applications for examination.

8. Whereas, the learned counsel appearing for the respondents would submit that Section 5 of the Limitation Act is not applicable and that the application has to be filed within the specific period and the object behind not allowing extension of time is to protect other investors or otherwise they would be prejudiced. Therefore it is his contention that the limitation period stipulated in the Act is mandatory in nature and the same cannot be extended. Hence, the learned counsel for the respondents oppose the writ petitions and prays for dismissal of both the writ petitions.

9. I have heard the learned counsel on either side and also perused the entire materials available on record carefully.

10. The only issue that remains to be decided in these writ petitions is with regard to receiving of the application for examination beyond the period of limitation. It is not disputed that the petitioner is an inventor of patents titled "Methods for Manufacturing a Paint Roller and Component Parts Thereof". The patent application is derived out of PCT application No.PCT/US2009/042143. This fact is also not disputed. The application for examination has not been filed within the time specified in the Patents Act. The main ground on which these writ petitions have been filed is that the delay was not on the part of the petitioner, but due to the sheer negligence on the part of his Indian Attorney. Perusal of the email communications between the Indian Attorney and Foreign Attorney makes it clear that the Indian Attorney in his email communication dated 25.05.2013, has stated that the deadline to file request for examination was due on 29.04.2013, but was docketed as 29.11.2015 in respect of the first case, whereas in respect of the second case the deadline for request for examination was due on 05.05.2013, but was docketed as 30.11.2015. Thus, the communication between the parties makes it very clear that the petitioner is very much interested in prosecuting the application from the very beginning, however the mistake has been committed by the Indian Agent showing wrong due date for filing the application.

11. Section 11-B of the Patents Act makes it very clear that no application for a patent shall be examined unless the application or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.

12. Rule 138 of the Patents Rule, 2003 deals with the power of the Controller to extend the time prescribed, which reads as follows:

"138. Power to extend time prescribed.— (1) Except for the time prescribed in clause

(i) of sub-rule (4) of rule 20, sub-rule (6) of rule 20, rule 21, sub-rules (1), (5) and (6) of rule 24B, sub-rules (10) and (11) of rule 24C, sub-rule (4) of rule 55, sub-rule (1A) of rule 80 and sub-rules (1) and (2) of rule 130, the time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct.

(2) Any request for extension of time prescribed by these rules for the doing of any act or the taking of any proceeding thereunder shall be made before the expiry of such time prescribed in these rules."

13. Rule 24-B deals with examination of application, wherein the application for request for examination under Section 11-B of the Act shall be made in Form 18 within 48 months from the date of priority of the application or from the date of filing of the application, whichever is earlier.

14. Admittedly, the reason for delay, according to the petitioner is only due to the sheer negligence on the part of the Indian Attorney. It is also not the case of the respondents that there was contributory negligence on the part of the petitioner, and he had an intent to abandon the patent. In the absence of any material to show that the petitioner has intended to abandon his right to pursue the application for examination, this Court is of the view that the valuable statutory rights of the petitioner cannot be completely deprived of merely because the patent application for examination has not been diligently presented by the agent. The petitioner being the citizen of US and he is <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 depended on the Indian agent appointed by his attorney at US, the said situation cannot be ignored all together. Therefore, in the absence of any concrete material to show that the petitioner has not taken any steps to pursue his application, it cannot be presumed that he had intention to abandon his right.

15. In *Bry-Air Prokon Sagl Vs. Union of India* in W.P.(C)-IPD 25/2022, dated 17.10.2022 the Delhi High Court in paragraph 19 has held as follows:

"19. From a reading of the aforementioned judgments, the position of law that emerges is that Courts while exercising writ jurisdiction have extended the time for filing response to the FER in extraordinary situations, where Patent Agents were found to be negligent in prosecuting the Patent Applications, with no contributory negligence of the Applicant and on showing that the Applicant had a positive intent to prosecute. It is equally settled that 'Abandonment' requires a conscious act on the part of the applicant, which would manifest the intention to abandon and no presumptions can be drawn in this respect. It also needs no reiteration that deemed abandonment of the application for <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620

& 12621 of 2017 grant of patent, leads to serious impact on the valuable rights of the patent applicant, which flow in favour of an invention and this is compounded by the fact that under the statutory scheme, no appeal is provided against an order of deemed abandonment of the application for patent under Section 21 of the Act. Therefore, each case would require examination on its own facts and circumstances to see the intent of the applicant to abandon."

16. In European Union represented by the European Commission Vs. Union of India in W.P.(C)-IPD 5 of 2022, dated 31.05.2022 in paragraphs 52 and 63 the Delhi High Court has held as follows:

"52. From a reading of the aforementioned decisions, insofar as the time period for filing of request for examination is concerned, the decision in Carlos Alberto Perez Lafuente (supra) of the Division Bench of this Court has categorically held that the time period is mandatory and cannot be extended even in the facts of a case where the patent agent is found to be negligent. However, this Court notes that in the case of response to the FER is concerned, in Ferid Allani (supra), Telefonaktiebolaget Ericsson (supra), and PNB <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 Vesper Life Sciences (supra) High Courts while exercising writ jurisdiction have granted extension in filing of the response to the FER including on the ground that the applicant did not have the intention to abandon. In such extraordinary situations, the Court has exercised its writ jurisdiction to ensure that valuable statutory rights of the Applicant are not completely deprived of.

Thus, before arriving at a conclusion that an Applicant has abandoned its application, due to non-filing of Reply to the FER/first statement of objections, while the Controller may have no power to extend the deadline within which the application has to be put in order for grant, courts exercising writ jurisdiction, may in rare cases permit the same, after examining the factual matrix to see as to whether the Applicant in fact intended to abandon the patent or not. Any extraordinary circumstances could also be considered by the Court, such as negligence by the patent agent, docketing error and whether the Applicant has been diligent. However, lack of follow-up by the Applicant would be a circumstance which may lead to an inference that the applicant intended to abandon the patent. Thus, the court would have to examine the circumstances in the peculiar facts of <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 each case.

63. There is yet another recent

development which the Court notices. The 161st report submitted by the Department Related Parliamentary Standing Committee on Commerce on 23rd July, 2021, titled 'Review of the Intellectual Property Rights Regime in India' has taken note of the enormous prejudice being caused to patent applicants due to 'deemed abandonment' provisions. The Committee has opined that the

abandoning of patents would de-moralize or discourage patentees in India. The observations of the Committee is set out below:

“vi. It was highlighted that the inflexibilities in Patent Act does not leave any room for errors thereby affecting the filing of patents. It was informed that in countries like US any delay in filing of patents could be condoned with an appropriate petition, fees, timely hearing and disposal. However, in India, once a due date has elapsed for filing request for examination report or a complete <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 specification after a provisional one, there exist no remedy. Hence, as per Section 21(1) of the Patent Act, 1970, an application for a patent shall be deemed to have been abandoned unless the applicant has complied with all the requirements imposed on him by or under this Act within such period as may be prescribed. This inflexibility affects number of patents filed. The Committee opines that the abandoning of patents, without allowing hearing or petition, may demoralize and discourage patentees in the country to file patents. It recommends the Department that certain flexibility should be incorporated in the Act to make for allowance of minor errors and lapses to prevent outright rejection of patents being filed. Hence, a revised petition with penalty or fee may be permitted under the Act for minor or bona fide mistakes that had been committed in the filed patents.” "

17. Considering the facts and circumstances of this case and keeping in mind the above judgments of the Delhi High Court as well as the Report of <https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 the Parliamentary Standing Committee, this Court is of the view that no delay or fault can be attributed to the petitioner. The delay was mainly caused by the Indian agent who failed to present the application for examination diligently in time. In fact, the Indian agent has informed in the email communications referred above that due to docketing error, he has given wrong due dates for filing of the applications for examination. These fact cannot be ignored altogether. Therefore, for the negligence on the part of the agent, the valuable statutory rights of the petitioner cannot be completely deprived of.

18. Therefore, this Court is of the view that the present two applications would fall in the category of exceptional circumstances and therefore the impugned common order dated 03.05.2016, passed by the second respondent, refusing to accept the applications for examination are liable to be set aside and accordingly set aside. Both the writ petitions are allowed and the application Nos.8846/CHENP/2011 and 8907/CHENP/2011 shall be restored to their original position. The examination of the said patents shall now be proceeded with by the respondents in accordance with the Act and the Rules. The same shall be concluded within a period of six months from the date of receipt of a copy of this order. Consequently, the connected miscellaneous petition is closed. No costs.

<https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 04.11.2022 Index : Yes / No kk To

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<https://www.mhc.tn.gov.in/judis> W.P.Nos.12620 & 12621 of 2017 N.SATHISH KUMAR, J.

kk PRE DELIVERY COMMON ORDER in W.P.Nos.12620 & 12621 of 2017 and W.M.P.No.13420 of 2017 RESERVED ON : 28.10.2022 DELIVERED ON : 04.11.2022 <https://www.mhc.tn.gov.in/judis>