

THE HIGH COURT OF DELHI AT NEW DELHI

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Judgment delivered on: 26.03.2015

+ **W.P.(C) 7798/2014**

ASHIM GHOSH

..... Petitioner

versus

THE CONTROLLER OF PATENTS

..... Respondent

Advocates who appeared in this case:

For the Petitioner : Mr S.K. Bansal and Mr Santosh Kumar.

For the Respondent : Counsel (presence not given).

CORAM:

HON'BLE MR. JUSTICE VIBHU BAKHRU

JUDGMENT

VIBHU BAKHRU, J (ORAL)

1. The petitioner impugns the action of respondent authority treating the petitioner's application (being Application No. 1350/DEL/2007) for patent as "Deemed to be Withdrawn".

2. The relevant facts are briefly outlined as under:

2.1 On 22.06.2007, the petitioner applied for a grant of patent in respect of an invention titled "YOGA YANTRA Y1008" which was allocated the number 1350/DEL/2007 (hereafter "the application").

2.2 On 04.07.2007, the petitioner applied, in the prescribed form (i.e. Form-9), for an earlier publication of the patent under the application.

2.3 On 04.07.2007, the petitioner also filed an application, in the prescribed form (i.e. Form-18), requesting for a substantive examination of

his application in terms of Section 11B (1) of the Patents Act, 1970 (hereafter ‘the Act’). Although there was no error in the Form-18 filed by the petitioner, the covering letter forwarding the said application (Form-18) incorrectly mentioned the application no. as 1350/DELNP/2007 instead of 1350/DEL/2007.

2.4 The petitioner obtained a status report from the official website of the respondent authority which indicated the status of the application as “Deemed to be Withdrawn U/S 11B(4)”. The petitioner immediately sent a letter dated 23.09.2013 protesting against the said status and requested the respondent to correct the same and proceed with the application. Subsequently, the petitioner also filed another application under Section 78(2) and Section 57 of the Act for correction of the aforesaid error. The petitioner also caused a legal notice dated 22.08.2014 to serve on the respondent. As no response was received to either the petitioner’s application for correction of error or the legal notice, the petitioner has filed the present petition, *inter alia*, praying as under:-

“That the Hon’ble Court be pleased to issue an appropriate order, direction or writ including a writ in the nature of certiorari and/or mandamus-

A. directing the Respondent

- (i) to correct the clerical / typographical error in the number of the Patent application in the Form-18 and other documents to read as 1350/DEL/2007;*
- (ii) to restore the application under No. 1350/DEL/2007;*
- (iii) to consider the request of substantive examination on Form 18 (Annexure-A) to be filed in respect of*

application No. 1350/DEL/2007 and thereafter order the examination of the said application ;

(iv) to proceed onward with the application under No. 1350/DEL/2007 in accordance with law as a pending application ;

B. To quash the “deemed to be withdrawn” status of the application under No. 1350/DEL/2007 under Section 11B of the Act and to consequently quash the said report (ANNEXURE-B) and to order the status of the application to be reflected as pending application.”

3. The petition was listed on 09.12.2014 and the respondent was granted three weeks time to file a counter affidavit. The petition was again listed on 29.01.2015 and thereafter, on 06.02.2015. Since the respondent had failed to file a counter affidavit, on 06.02.2015, the respondent was granted a final opportunity to file a counter affidavit within a period of four weeks; the respondent did not avail of this opportunity also and, therefore, the petition was heard in absence of a counter affidavit.

4. Before proceeding further, it would be relevant to refer to Section 11B of the Act which reads as under:-

“11B. Request for examination.- (1) No application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.

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(3) In case of an application in respect of a claim for a patent filed under sub-section (2) of section 5 before the 1st day of January, 2005 a request for its examination shall be

made in the prescribed manner and within the prescribed period by the applicant or any other interested person.

(4) In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under sub-section (1) or sub-section (3), the application shall be treated as withdrawn by the applicant:

Provided that-

- (i) the applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner; and
- (ii) in a case where secrecy direction has been issued under section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction.”

5. Section 11B(1) provides that no application would be examined unless a request is made in the prescribed manner within the prescribed period. Further, Section 11B(4) provides that in case the applicant or any other interested person does not make a request for examination of the application for a patent within the specified period, the application shall be treated as withdrawn. Apparently, the petitioner’s application has been treated as withdrawn on the assumption that the petitioner has failed to make a request for examination within the prescribed period.

6. Rule 24B of the Patent Rules, 2003 prescribes the manner and the period within which the request for examination of an application is to be made. Rule 24B(1) is relevant and is quoted below:-

“24B. Examination of application.-(1)(i) A request for examination under section 11 B shall be made in Form 18

within forty-eight months from the date of priority of the application or from the date of filing of the application, whichever is earlier;

(ii) The period within which the request for examination under sub-section (3) of section 11B to be made shall be forty-eight months from the date of priority if applicable, or forty-eight months from the date of filing of the application;

(iii) The request for examination under sub-section (4) of section 11B shall be made within forty-eight months from the date of priority or from the date of filing of the application, or within six months from the date of revocation of the secrecy direction, whichever is later;

(iv) The request for examination of application as filed according to the 'Explanation' under sub-section (3) of section 16 shall be made within forty-eight months from the date of filing of the application or from the date of priority of the first mentioned application or within six months from the date of filing of the further application, whichever is later;

(v) The period for making request for examination under section 11B, of the applications filed before the 1st day of January, 2005 shall be the period specified under the section 11B before the commencement of the Patents (Amendment) Act, 2005 or the period specified under these rules, whichever expires later.”

7. Concededly, the petitioner filed his request for examination of the application in the prescribed form, that is Form-18, within the prescribed period of 48 months from the date of the application; apparently, the said request was not considered as the covering letter forwarded by the petitioner contained an inadvertent error inasmuch as it referred to the

application number as 1350/DELNP/2007 instead of 1350/DEL/2007. Thus, the limited controversy to be addressed is whether the application could be deemed to be withdrawn under Section 11B(4) of the Act on account of an error mentioning an incorrect application number in the covering letter.

8. The manner and the period within which a request for examination of the application is required to be made is specified under Rule 24B(1) of the Patent Rules, 2003. Concededly, the request for examination was made by the petitioner in the prescribed manner (i.e. in Form-18). Admittedly, there is no error in this Form and the application number is correctly mentioned as 1350/DEL/2007. It is also not disputed that the request in Form-18 was filed within the prescribed period. In this view, the consequences as indicated in Section 11B(4) of the Act are not attracted. Plainly, the provisions of Section 11B(4) of the Act would be applicable only if request for examination of the application is not made within the time specified under sub-section (1) and/or sub-section (3) of Section 11B of the Act. However, Section 11B(1) does not specify any time period within which an examination of an application is to be made; it only specifies that the request ought to be made in the prescribed manner and within the prescribed period; the manner and period for making a request is prescribed under Rule 24B of the Patent Rules, 2003. Undisputedly, Rule 24B of the Patent Rules, 2003 has been complied with as the petitioner had made the request in the manner and within the period prescribed therein. Thus, the necessary conditions for applying the deeming provisions of Section 11B(4) of the Act are absent in this case. The respondent was, thus, clearly

in error in ignoring the Form-18 filed by the petitioner merely because of an apparent error in the covering letter.

9. In the circumstances, the petitioner is entitled to succeed and the petition is allowed. The respondent is directed to restore the petitioner's application for patent i.e. Application No. 1350/DEL/2007 to its original position and consider the request of the petitioner for substantive examination in accordance with law.

MARCH 26, 2015
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VIBHU BAKHRU, J

