

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 01.09.2016

CORAM

The HON'BLE MR.SANJAY KISHAN KAUL, CHIEF JUSTICE
AND

The HON'BLE MR.JUSTICE R.MAHADEVAN

W.P.No.13840 of 2015

R.Muralidharan

.. Petitioner

Vs.

1. The Secretary
Ministry of Law and Justice
4th Floor, A-Wing, Shastri Bhawan
New Delhi - 110 001.
 2. The Secretary
Ministry of Commerce and Industry
Department of Industrial Policy
and Promotion, Udyog Bhawan
New Delhi - 110 001.
 3. The Secretary
Ministry of External Affairs
Administration Division
Jawaharlal Nehru Bhawan
23-D, Janpath
New Delhi - 110 001.
 4. The Controller General of Patent
and Designs and Trademark
Intellectual Property Office Building
GST Road, Guindy
Chennai - 600 032.
- .. Respondents

(Respondents 1 and 3 deleted
vide order dated 30.4.2015
in W.P.No.13840 of 2015)

PRAYER: Petition under Article 226 of the Constitution of India for issuance of a writ of Certiorarified Mandamus to call for the records relating to the impugned notice of the fourth respondent bearing No.CG/Public notice/PO/2012/15, dated 2.7.2012, quash the same and consequently direct the respondents to allow the amendment of original application while entering PCT (Patent Co-operation Treaty) National Phase Application in India as per Articles and Regulations prescribed under the PCT (Patent Co-operation Treaty).

For Petitioner : Mr.R.Palaniandavan
forM/s.RamasamyLaw Associates

For Respondents : Mr.Su.Srinivasan
Asst. Solicitor General
for respondents 2 and 4

ORDER

(Order of the Court was made by the Hon'ble Chief Justice)

The petitioner, who is stated to be an Advocate, Law Teacher, Mediator and Registered Patent, seeks to assail the impugned notice dated 2.7.2012 with a direction to the respondents to allow the amendment of original application while entering Patent Co-operation Treaty (PCT) National Phase Application in India as per Articles and Regulations prescribed under the PCT.

2. The public notice deals with filing of PCT National Phase Applications in India and is stated to have been issued to simplify the process of filing of the said application. It is issued by the Office of the Controller General of Patents, Designs and Trade Marks and is stated to be a coordinating effort between the Indian Patent Office (IPO), International Bureau (IB) of the World Intellectual Property Organization (WIPO) to acquire online access to PCT International Applications and relating documents available with the IB. The objective of this is stated to be that redundant processes would be eliminated qua the stakeholders and, thus, multiple copies of documents already available with the IB can be utilized by the IPO. Thus, instructions have been issued as per the circular, but are to apply only to the PCT National Phase Applications entering India, which do not claim priority of any PCT National Phase Application filed previously in India.

3. The grievance of the petitioner is with Note (ii) to paragraph (1), which reads as under:

"ii. It is clarified that the IPO does not allow an Applicant to amend the specification or the related documents before he actually enters National Phase in India. These directions are in consonance with the aforementioned practice."

4. The aforesaid provision has to be read along with Paragraph (2), which reads as under:

"2) The documents filed by the Applicant should exactly correspond with the up-to-date information available on the record of IB on the date of filing of the PCT National Phase Application in India. The said information must

have been notified / published by the IB in accordance with the PCT and the Regulations made thereunder. Any request pending with the IB shall be of no consequence and should not be reflected in the documents. If any such request is reflected in the documents, the information notified/published by IB shall prevail."

5. The aforesaid is in the context of Chapter II of the Patents Act, 1979 (hereinafter to be referred to as "the said Act"), which deals with inventions not patentable. Section 3 of the said Act stipulates what are not inventions, while Section 4 provides inventions relating to atomic energy are not patentable.

6. The learned counsel for the petitioner states that the grievance with the circular is that though Section 57 read with Section 59 of the said Act permit amendment of application and specification or any document relating thereto and provide supplementary provisions as to amendment of application or specification, that right is being denied at the entry stage into the National Phase in India. The relevant portion of Section 59 of the said Act reads as under:

"Section 59. Supplementary provisions as to amendment of application or specification.-

(1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment."

(emphasis supplied)

7. The submission, thus, is when Section 59 of the said Act permits disclaimer, correction or explanation, there is no reason why this should not be permitted at the entry stage. It is the submission of the learned counsel for the petitioner that the result of the circular is that in respect of a patent application at entry stage into National Phase in India, fee would be liable to be paid on all the claims, even if some of them are not patentable in view of Sections 3 and 4 of the said Act. It is only thereafter would disclaimer, correction or explanation be permitted by paying the requisite fee. Thus, what the petitioner claims is that the disclaimer, correction or

explanation should be permitted prior to the entry stage, so that those aspects of patent which are not patentable in India will not be required to be included in application and fee paid on the same. Thus, the endeavour is really a fee saving effort on behalf of foreign clients, who seek to enter National Phase in India.

8. The learned Assistant Solicitor General has pointed out that the fee payable is as per Section 142 of the said Act and may be prescribed by the Central Government as it deems fit.

9. The learned counsel for the petitioner seeks to plead that the Patent (Amendment) Rules, 2016 have been issued on 16.5.2016 and are to be made applicable from the date of their notification. The learned Assistant Solicitor General, on instructions, states that the said Rules were published in the gazette on the same date. In terms of the amendment to sub-rule (1) to Rule 20, the proviso now permits deletion of a claim while filing of an application corresponding to an international application in accordance with the provisions contained in Rule 14. This is stated to be with the objective that since some claims are not patentable in India, those claims can be deleted at the stage of filing of the application.

10. The learned Assistant Solicitor General also does not dispute the aforesaid position, but states that this is only to subserve the objective of non-necessity of inclusion of non patentable claims at the application stage, which would thus obviously obviate the requirement of paying of fee at the entry point stage itself if it is not patentable in India.

11. The learned counsel for the petitioner, however, states that a second limb survives, i.e., according to him, this amendment, in a sense, permits disclaimer, but not correction or explanation. On the other hand, the learned Assistant Solicitor General submits that it is not the same thing and the supplementary provisions as to amendment of application by way of disclaimer, correction or explanation is different from permitting deletion at the entry point stage on account of Sections 3 and 4 of the said Act.

12. On hearing the learned counsel for the parties, we are of the view that the matter does not brook judicial scrutiny. It is a procedural aspect as to how the application should be filed at the entry point and as observed by us, the rub is only the fee to be paid at the entry point. To the extent that an invention is not patentable in India, the benefit of deleting the same at entry point has already been granted. The application of disclaimer, correction or explanation as envisaged under Section 57 read with Section 59 of the said Act would not entitle the applicant to inherently claim a right to

do so at the entry point, a procedural aspect. As to what fee has to be paid is to be determined by the Central Government under Section 142 of the said Act. Thus, really speaking, there is no challenge to any provision of the Act or statutory rule, but only to a procedure, which is best left to the experts and that too when the question is only of payment of fee, the power of which is vested with the Central Government under Section 142 of the said Act.

13. We may note the submission of the learned Assistant Solicitor General in this behalf that what has been done is in accordance with international practices and the fee prescribed is Rs.4,000/- for international companies and Rs.2,000/- for medium and small companies.

14. We see no reason to exercise the jurisdiction under Article 226 of the Constitution of India.

This writ petition is dismissed. No costs.

-s/d-
Assistant Registrar

True Copy

Sub-Assistant Registrar

sasi

To:

1. The Controller General of Patent
and Designs and Trademark
Intellectual Property Office Building
GST Road, Guindy
Chennai - 600 032.

+1 cc to M/s.Su.Srinivasan Advocate sr 49717

W.P.No.13840 of 2015

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