

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.33021 of 2014

R.Muralidharan

.. Petitioner

Vs.

1. The Controller General of Patents,
Designs, Trademarks
Intellectual Property Building
GST Road, Guindy
Chennai - 600 032.
2. The Secretary
Department of Industrial Policy
and Promotion,
Ministry of Commerce and Industry
Udyog Bhavan, New Delhi - 110 001.
3. The Secretary
Ministry of External Affairs
South Block, New Delhi - 110 001.

.. Respondents

PRAYER: Petition under Article 226 of the Constitution of India for issuance of a writ of Mandamus to direct the first respondent to use PCT Search Reports as an essential input in the examination of pending National Phase Applications of both Indian and foreign application pending before Patent Office.

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

For Respondents : Mr.Su.Srinivasan
Asst. Solicitor General

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, claims that the time lines for examination of patent under the Patents Act,

1970 read with Rules thereunder are not followed resulting in years of delay. It is his submission that this time period can be reduced if the Patent Co-operation Treaty (PCT) Search Reports already obtained are treated as an essential input in the examination of the pending National Phase Application for patent of both Indian and foreign applicants.

2. With reference to the counter affidavit, the learned counsel for the petitioner submits that the respondents have misunderstood even the prayer made, as the defence is that the patent office has to independently scrutinize the applications. This is once again emphasized by the learned Assistant Solicitor General. In this behalf, he seeks to refer to the PCT Guidelines to contend that it has been observed therein as under:

"While the national and regional Offices may not make further requirements beyond those of the Treaty and Regulations in respect of matters of form and contents, they are not bound by the Treaty to follow the results of any international search or examination which has been performed when the application is examined during the national or regional phase."

3. The learned Assistant Solicitor General, however, concedes that if a PCT search report is already available, certainly that will be taken into account, though it may not be binding. He seeks to support this by the observation of the learned Single Judge of the Delhi High Court in *Ten Xc Wireless Inc and Another v. Mobi Antenna Technologies*, [2012] 187 DLT 632. The learned Single Judge observed that the International Search Reports issued by the World Intellectual Property Organization in respect of PCT application is not binding in view of Article 33(1) of the Patent Cooperation Treaty, which provides that the object of the International Preliminary Examination is to formulate a preliminary and non-binding opinion. Thus, the statutory duties of the Examiner concerned to conduct prior art search cannot be set aside or circumvented by relying on the findings of the International Search Report (ISR) or International Preliminary Report on Patentability (IPRP).

4. On hearing the learned counsel for the parties, we find actually there is no lis inter se the parties on the issue raised in the petition. It is not the plea of the petitioner that the ISR and IPRP are to be treated as final and binding, but only that they should be treated as an essential input, as it would facilitate an early scrutiny by the Examiners, something not disputed even by the learned Assistant Solicitor General. Thus, all that has to be recorded is that such PCT Search Report is being and shall be treated as an essential input in the examination by the Examiner, in pursuance of the

mandate of Section 12 of the Patents Act, 1970 dealing with the question of examination of application.

The petition, accordingly, stands disposed of. No costs.

-s/d-
Assistant Registrar

True Copy

Sub-Assistant Registrar

sasi

To:

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+1 cc to M/s.SU.Srinivasan Advocate sr 49716
+1 cc to M/s.Ramasamy Law Associates sr 49755

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