

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated : 02.02.2017

CORAM:

THE HON'BLE MR. JUSTICE D.KRISHNAKUMAR

W.P.No.9785 of 2013

and

M.P.No.1 of 2013

Beckman Coulter Biomedical,
LLC, 2200 Pennsylvania Avenue,
NW, Suite 800W, Washington,
District of Columbia 20037,
USA, rep. by its Constituted Attorney,
Neha Srinivastava

...Petitioner

.. Vs ..

1.Union of India,
rep. by its Secretary,
Department of Industry,
Ministry of Industry and Commerce,
Udyog Bhawan, New Delhi.

2.The Controller of Patents & Designs,
Intellectual Property Rights Building,
G.S.T.Road, Guindy,
Chennai - 600 032.

..Respondents

Writ Petition under Article 226 of The Constitution of India praying for the issuance of a Writ of Certiorarified Mandamus quashing the impugned order dated January 09, 2013 passed by the 2nd respondent in returning the documents filed by the petitioner and consequently, direct the second respondent to take the petitioner's subject application PCT/US 2011/035420 on record and proceed further with the subject application as per the Act and the procedure prescribed in the Rules.

For Petitioner : Mr.P.S.Raman,
Senior Counsel
for M/s.Satish Parasaran

For Respondents : Mr.Venkatasamy Babu,
Senior Panel Counsel GOI

O R D E R

According to the petitioner, the petitioner company is a leading company which develops, manufactures and markets products that simplify, automate and innovate complex biomedical testing. The petitioner's diagnostic systems are found in hospitals and other critical care settings around the world and produce information used by physicians to diagnose disease, make treatment decisions and monitor patients. Scientists use the petitioner's life science research instruments to study complex biological problems including causes of diseases and potential therapies or drugs.

2. While so, the petitioner's Indian Counsel viz., Remfry and Sagar, received instructions from the petitioner's attorney in USA to nationalise the PCT Application PCT/US2011/035417 in India (hereinafter referred to as the "first application") and docketed the same for filing on November 28, 2012. The petitioner's US attorneys had also sent instructions for nationalisation of the subject PCT application PCT/US2011/035420, the "subject application". Due to some technical snag beyond the control and comprehension of the petitioner's Indian Counsel, the instructions to file the subject application were not received by the Indian Counsel. In view of the fact that the petitioner's US attorney had not received any acknowledgement from the Indian counsel in respect of the instructions for filing the subject application, the petitioner's US attorneys sent a 'reminder e-mail' requesting for a specific Power of Authority for the subject application. The concerned attorney at the office of the petitioner's Indian counsel, thinking that there was an error in the reference number, sent a specific Power of Authority for the first application (PCT/US2011/035417 Application) and failed to realise that the subject application (PCT/US2011/035420 application) is a separate application which had not been docketed in the system. By the time the docketing error came to the knowledge of the petitioner's Indian agents, the 31 months deadlines to nationalise the application had already expired on December 05, 2012. As soon as the error was discovered, the subject application was filed at the Patent Office in Chennai under the cover of letter dated January 04, 2013, without any further delay. In view of the fact that the normal period for filing the subject application had expired on December 05, 2012, the subject application was filed along with the requisite petitioners under Rules 137 and 138. The subject application was filed as a national phase application under the Patent Co-operation Treaty (PCT) from International Application number PCT/US2011/035420 dated May 5, 2011, claiming priority from US applications dated May 05, 2010. Rule 20 of the Patents Rules and Article 2(xi) of the PCT stipulates that a PCT application can be nationalised in India within 31 months from the priority date. The petitioner filed the subject application along with the requisite

petitions clearly explaining the circumstances leading to the late filing of the subject application. The petitioner also requested for hearing in the event the second respondent was of the opinion that the petitions do not merit allowance and was minded to issue an adverse decision. However, the second respondent rejected the petitioner's application. Hence, the present Writ Petition is filed by the petitioner.

3. Mr.P.S.Raman, learned Senior Counsel, appearing for the petitioner, reiterating the averments made in the Writ Petition submitted that the second respondent committed a grave error in passing non-speaking orders affecting the substantial rights of the petitioner and that the second respondent has erred in returning the petitioner's documents sent under cover of letter dated January 04, 2013 on the hyper technical basis that the time period of 31 months for filing the subject application had lapsed, without applying its mind to the petitioner's case. In support of his contention, the learned Senior Counsel relied on the Judgment of this Court in Nokia Corporation vs. Deputy Controller of Patents and Designs reported in 2011 (46) PTC 70 (Mad), 2011 Writ LR 283.

4. On the contrary, the learned Senior Panel Counsel GOI, appearing for the respondents, submitted by referring to Rule 22, contended that on expiry of time under Rule 20, the Application itself is deemed to have been withdrawn, therefore, in the absence of application within the prescribed time under Rule 20, the Application would not be maintainable, in view of Proviso to Rule 138. It is further contended by the learned Government Standing Counsel that Rule 6(5) of the Patents Rule is in consonance with Article 48 and Rule 82 of PCT. Therefore, the second respondent rightly held tat the delay in moving the application could only be condoned if there was postal delay and for no other reason. It was also contended on behalf of the respondents that application under Rule 138 could only be moved within prescribed time under Rule 20 and not thereafter.

5. Heard the learned Senior Counsel for the petitioner and the learned Senior Panel Counsel GOI for respondents and perused the materials available on record.

6. The time prescribed under Rule 20 is 31 months, and the period which could be extended by taking into consideration of facts and circumstances, is one month. It is well settled law that the Courts and statutory authorities are to do substantial justice. The object of Rule 138 is that prescribed time under Rule 20 can be extended by period of one month on showing sufficient cause. It is the discretion of the Controller to extend the period on facts and circumstances of the case, but it was not correct on the part of the Controller to have rejected the application by treating it to be not maintainable, as having been filed after expiry of prescribed time under Rule 20 of the Patents Rules 2003.

The merits of the facts disclosed were to be considered. Rule 6(5) or Article 48 and Rule 82 of PCT Rule do not govern powers under Rule 18 as the Controller under this Rule is to exercise quasi judicial power.

7. In Nokia Corporation vs. Deputy Controller of Patents and Designs reported in 2011 (46) PTC 70 (Mad), 2011 Writ LR 283, this Court has held as follows:-

"28. On consideration, I find force in the contention raised by the learned Senior Counsel for the petitioner. It is not in dispute that PCT Application can only be filled within a period, as stipulated under Rule 20.

29. On expiry of the period of 31 months, defective application or application nor filed, would be deemed to be withdrawn meaning that it would be no application in the eye of law.

30. At the same time, under Rule 138, period for submitting the application can be extended by one month, if a good cause is shown by the applicant.

31. The Controller is vested with power to extend the time by one month by exercising the powers under rules. Rule 138 of the Patents Rule is independent of Rule 6(5) or Article 48 and Rule 82 of PCT.

35. It is a well settled law that the Courts and statutory authorities are to do substantial justice. The object of Rule 138 is that prescribed time under Rule 20 can be extended by period of one month on showing of sufficient cause. As already observed above, it is the discretion of the Controller to extend the period on facts and circumstances of the case, but it was not correct on the part of the Deputy Controller to have rejected the application, by treating it to be not maintainable, as having been filed after expiry of prescribed time under Rule 20 of the Patents Rules 2003. The merits of the facts disclosed were to be considered. Rule 6(5) or Article 48 and Rule 82 of PCT Rule do not govern powers under Rule 138, as the Controller under this rule is to exercise quasi judicial power.

8. In the light of the above decision, I am inclined to interfere with the impugned Order passed by the second respondent on the ground that the impugned order has been passed without any reasons and the same is a non-speaking order. The petitioner has made out a prima facie case. Hence, the impugned order dated January 09, 2013 passed by the 2nd respondent in returning the documents filed by the petitioner, is quashed and the case is remanded back to the second respondent to consider the subject application and pass orders in accordance with law and in the light of the order passed in Nokia Corporation vs. Deputy Controller of Patents and Designs reported in 2011 (46) PTC 70 (Mad), 2011 Writ LR 283, within a period of two months from the date of receipt of a copy of this order, after affording opportunity to the petitioner.

9. The Writ Petition is allowed with the above direction. No costs. Connected Miscellaneous Petition is closed.

Sd/-
Asst.Registrar (CO)

/true copy/

Sub Asst. Registrar

To

1.The Secretary,
Union of India,
Department of Industry,
Ministry of Industry and Commerce,
Udyog Bhawan, New Delhi.

2.The Controller of Patents & Designs,
Intellectual Property Rights Building,
G.S.T.Road, Guindy,
Chennai - 600 032.

+1cc to M/S. Satish Parasaran, SR. 6655

W.P.No.9785 of 2013
and
M.P.No.1 of 2013

NR(CO)
VR(2/03/2017)