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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **W.P.(C) 8619/2017**

% **Date of Decision: 25th September, 2017**

MICHELE CABONI

..... Petitioner

Through: Mr. Mahesh Kumar with Mr.
Debashis Mukherjee and
Ms. Simran Soni, Advs.

versus

UNION OF INDIA AND ANR.

..... Respondent

Through: Mr. P.S. Singh, Adv. for
respondents.

CORAM:

HON'BLE THE ACTING CHIEF JUSTICE

HON'BLE MR. JUSTICE C. HARI SHANKAR

JUDGMENT (ORAL)

GITA MITTAL, ACTING CHIEF JUSTICE

CM No.35409/2017 (*for exemption*)

Allowed, subject to all just exceptions.

CM stands disposed of.

W.P.(C) No.8619/2017

1. This writ petition lays a challenge to the Constitutional validity of Sections 11(B) and 117A(1) of the Patents Act, 1970 (hereinafter referred to as 'the Act') and Rules 24B and 138 of the Patents Rules, 2003 (hereinafter referred to as 'the Rules') framed therein *inter alia* on the ground that the Rules do not provide an opportunity to the parties of being heard before their rights

regarding an application seeking grant of the patent is closed. The other grounds on which the challenge is premised are to the effect that these provisions are inconsistent with the scheme of the Constitution for the reason that no appeal is prescribed for an order passed under Rule 137 of the enactment.

2. In order to appreciate the submissions made by the petitioner, it is necessary to briefly set down the facts giving rise to this challenge.

3. The petitioner admittedly is an Italian national, who claims to have developed certain technology for which he had filed four Priority Applications, two of which are Priority Application Nos.TO2011A001130 and TO2011A001250 dated 9th December, 2011 and the other two being Priority Application Nos.TO2011A001250 and TO2011A001251 dated 31st December, 2011. The petitioner thereafter filed four International Patent Applications viz. PCT/IT2012/000370 and PCT/IT2012/000371 dated 7th December, 2012; PCT/IT2012/000407 and PCT/IT2012/000408 dated 31st December, 2012 in Geneva corresponding to each of the aforementioned four priority applications.

4. It appears that with the intention of getting his technology patented in India as well, the petitioner filed following four National Phase Patent Applications before the Patent Controller and Designs at Mumbai:

(i) *Indian National Phase Patent Application No.1387/MUMNP/2014 dated 9th July, 2014;*

- (ii) *Indian National Phase Patent Application No.1388/MUMNP/2014 dated 9th July, 2014;*
- (iii) *Indian National Phase Patent Application No.1525/MUMNP/2014 dated 30th July, 2014; and*
- (iv) *Indian National Phase Patent Application No.1526/MUMNP/2014 dated 30th July, 2014.*

5. It is stated by the petitioner that the above applications were based on the International Patent Applications which corresponded to the Priority Applications.

6. The petitioner submits that in terms of Section 11B(1) of the Act and Rule 24B of the Rules, a request for examination of the patent (RFE) is required to be made within 48 months from the date of filing of the priority of the application or the date of filing of the application, whichever is earlier.

7. We extract hereunder Section 11B of the Act and Rule 24B of the Rules:

(i) Section 11B of the Act:

“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;

(2) [Omitted by Patents (Amendment) Act, 2005, section 11].

(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.*

(ii) Rule 24B of the Rules

“Rule 24B: Examination of application –

(1)(i) A request for examination under section 11B 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.

(2) (i) Where the request for examination has been filed under sub-rule (1) and application has been published under section 11A, the Controller shall refer the application, specification and other documents related thereto to the examiner and such reference shall be made in the order in which the request is filed:

Provided that in case of a further application filed under section 16, the order of reference of such further application shall be the same as that of the first mentioned application:

Provided further that in case the first mentioned application has already been referred for examination, the further application shall have to be accompanied by a request for examination, and such further application shall be published within one month and be referred to the examiner within one month from the date of such publication.

(3) A first statement of objections, along with any documents as may be required, shall be issued by the Controller to the applicant or his authorised agent within

one month from the date of disposal of the report of examiner by the Controller: Provided that where the request for examination was filed by a person interested, only an intimation of such examination may be sent to such person interested.

(4) Reply to the first statement of objections and subsequent reply, if any, shall be processed in the order in which such reply is received.

(5) The time for putting an application in order for grant under section 21 shall be six months from the date on which the first statement of objections is issued to the applicant to comply with the requirements.

(6) The time for putting an application in order for grant under section 21 as prescribed under sub-rule (5) may be further extended for a period of three months on a request in Form 4 for extension of time along with prescribed fee, made to the Controller before expiry of the period specified under sub-rule (5)."

8. It is evident from a bare reading of the provisions of the statute as well as the rules that the timeline stipulated is mandatory and has to be strictly abided by. It is clarified from the statutory provisions that the applicant or any other interested person must make a request in the prescribed manner for such examination within the prescribed period. It is further clarified 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 period as specified under sub-section (1) or sub-section (3), the application shall be treated as withdrawn by the applicant.

9. Given the clear mandate of the statutory provisions, the

petitioner cannot be heard to say that the Office of Patent and Designs was additionally required to serve another notice. The petitioner before us admits that no application for request for examination was made on his behalf for a long period of over five years. We may note that the period of 48 months from the date of applications submitted by the petitioner admittedly expired on or before 9th December, 2015 for two applications and 31st December, 2015 for the other two applications.

10. The petitioner did not file the request for examination in terms of Section 11B of the Act within the stipulated period of 48 months as required under Rule 24B from the earliest priority date i.e. 9th December, 2015 for two applications and 31st December, 2015 for the other two applications.

11. It is disclosed in the writ petition that the requests for examination along with applications for regularization and condonation of delay in filing of RFE was made vide communication dated 2nd May, 2017 by the petitioner's agent through Patent office. These requests were considered and rejected by the impugned order/letter dated 5th June, 2017 clearly informing the petitioner that *"48 months period for filing of Form – 18 in this case expired on December, 2015. As per Section 11B your request is not filed within prescribed period. Your letter with Form 18 and cheques are received in this officer on 30/05/2017 i.e. after the expiry of due date, therefore, your Form 18 cannot be taken on record."*

12. It is stated by the petitioner that he had suffered a severe

heart attack on 3rd November, 2015 and that he was hospitalized from 3rd November, 2015 to 20th November, 2015 and after being discharged from the hospital, the petitioner was advised complete rest by the doctor. He was also advised to stay away from his work and also from any kind of stress or strain at least for a period of one year.

In these circumstances, he was unable to give instructions to his patent agent to file the request for examination.

13. It is contended that therefore, the petitioner has given a reasonable explanation for the circumstances in which he was prevented from making a request for examination within the stipulated period and delay in this submission has to be condoned.

14. Before examining the position which subsists in law, we may also consider the medical certificate dated 20th November, 2015 which has been filed by the petitioner in respect of the above submissions. This medical report issued by the Health Agency of Nuoro, Hospital San Franscesco, Division of Cardiology details that the petitioner had been experiencing various signs of arrhythmias and acute pain the chest and left arm mainly attributed to his work related stress and consequently he was advised intervention of coronary angioplasty.

This certificate states that the petitioner is advised to refrain from exposing himself to work related stress and avoid exerting himself for additional six months.

15. Another medical certificate dated 25th October, 2016 issued by the same Hospital has been placed on record, referring to similar

complaints from the petitioner. However, this time the only treatment which is prescribed is the continuous monitoring by medical experts. We may note that there is no whisper that the petitioner was not attending his work during this entire period. This would not have precluded the petitioner to enable him for processing the applications which have been filed by him, as noted above.

16. So far as the spirit of the timeline stipulation in the statute is concerned, the same is apparent from the scheme that there is a stipulation so far as validity of extension of the patent is concerned. If this Court was to urge permissibility of the extension of the application, it would tantamount to extension of the period of the patent which would be completely contrary to the intendment of the legislation.

17. Certainly, the challenge to the constitutionality of the legislation premised on the ground that it does not permit such extension, cannot be entertained. The petitioner lays no challenge to the legislative competence to make the prohibition contained in the Patent Act, 1970 and the Rules made therein.

18. No violation of fundamental right is made out in the present case. The petitioner having challenged the statutory provisions on the ground that no appeal is envisaged is completely misconceived. The right to file an appeal is a right which has been expressly conferred by the statute against an order passed in Rule 138 of the Rules. No appeal is permitted under Section 117A of the Act.

19. In view of the above reasons, we find no merit in this

petition which is accordingly dismissed.

CM No.35408/2017 (*for stay*)

In view of the order passed in the writ petition, this application is dismissed as infructuous.

ACTING CHIEF JUSTICE

C.HARI SHANKAR, J

SEPTEMBER 25, 2017/pmc