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

+ **W.P.(C) 1469/2018**

SPHAERA PHARMA, PTE. LTD AND ANR. Petitioners
Through Mr Rajeshwari M., Advocate.

versus

UNION OF INDIA AND ANR. Respondents
Through Mr Vinod Diwakar, CGSC with
Mr Akshaya Agarwal, Advocates.

CORAM:

HON'BLE MR. JUSTICE VIBHU BAKHRU

ORDER

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16.02.2018

VIBHU BAKHRU, J

1. The petitioners have filed the present petition, *inter alia*, praying that directions be issued to respondent no. 2 to restore the Indian Patent Application No. 3584/DELNP/2015 for examination on merits. The said application has been treated as abandoned as the petitioners had failed and neglected to file the request for examination within the prescribed time.
2. The petitioners claim that they are fully integrated drug discovery and development companies and have developed several new compounds useful in treatment of cancer. In order to consolidate its rights in respect of such compounds, the petitioner no.1 (hereafter 'the petitioner') filed an application – Indian Patent Application no.3114/DEI/2012 – with the patent office on 05.10.2012.
3. The petitioner claims that since the said invention had global

potential, it filed a Patent Corporation Treaty (PCT) application being PCT/IN2013/00607, claiming priority on the basis from the earlier Indian Patent Application (Application No. 3114/DEL/2012 dated 05.10.2012).

4. Thereafter, in furtherance of the PCT Application, the petitioner filed an Indian Patent Application being Indian Patent Application No. 3584/DELNP/2015 titled “*Novel compounds their synthesis and use*”.

5. Admittedly, the petitioner was required to file a request for examination of the said application within a period of 48 months from the initial date of filing the Indian Patent Application No. 3114/DEL/2012; that is, on or before 05.10.2016.

6. The petitioner filed Form 30 in respect of the said application for taking on record its request for examination. However, the said request could not be uploaded because of some technical reasons. The petitioners state that the status of the Indian Patent Application No. 3584/DELNP/2015 is reflected on the website of the Indian Patent Office as “*Application abandoned under Section 11B*”.

7. In view of the above status, the petitioner has been disabled from filing its request for examination. Aggrieved by the same, the petitioner filed a petition requesting that the status of its Indian Patent Application be reviewed. However, the same has not been considered.

8. This has led the petitioner to file the present petition.

9. Before proceeding further, it would be relevant to refer to Section 11B of the Patents Act, 1970 (hereafter ‘the Patents Act’), which is set out below:-

“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) 4[***] 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.”

10. It is apparent from the language of Section 11B(1) of the Patents Act that the consideration of any application for examination beyond the *prescribed period* is not proscribed. The said period within which the application has to be made is prescribed under Rule 24B of the Patents Rules, 2003 (hereafter ‘the Rules’) which reads as under:-

“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 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 forth-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, whoever expires later.”

11. A plain reading of Section 11B(1) of the Patents Act and Rule 24B of the Rules clearly indicates that there is no scope for considering a request for examination beyond the prescribed period of 48 months from the date of application. Concededly, the petitioner's request was beyond this period.

12. The learned counsel appearing for the petitioner referred to Rule 138 of the Rules and contended that the Controller of Patents retained the power

to extend the time for a period of one month in certain cases. This contention is also unmerited. Rule 138 of the Rules reads as under:-

“138. Power to extend time prescribed.—(1) Except for the time prescribed in clause (i) of sub-rule (4) of rule 20, sub-rule (6) of rule 20, rule 21, sub-rules (1), (5) and (6) of rule 24B, sub-rules (10) and (11) of rule 24C, sub-rule (4) of rule 55, sub-rule (1A) of rule 80 and sub-rules (1) and (2) of rule 130, the time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct.

(2) Any request for extension of time prescribed by these rules for the doing of any act or the taking of any proceeding thereunder shall be made before the expiry of such time prescribed in these rules.”

13. It is at once apparent that recourse to Rule 138 of the Rules is not available to extend the time prescribed under Rule 24B of the Rules. This is clear from the plain language of Rule 138 of the Rules, which expressly excludes its application to Sub-rules (1), (5) and (6) of Rule 24B of the Rules. Moreover, in terms of Rule 138(2) of the Rules, any request for extension of time prescribed has to be made before the expiry of such time as prescribed in the Rules. Therefore, even if the express language of Rule 138 of the Rules is ignored, the benefit of Rule 138 would not be available to the petitioner as no such application for extension of time was made prior to expiry of the prescribed time (that is, prior to 05.10.2016)

14. A Coordinate Bench of this Court has also considered the aforesaid issue in *Nippon Steel Corporation v. Union of India: 2011 (46) PTC 122 (Del)*. After considering the rival contentions, this Court observed as under:-

“There is a logic to the time limits set out under the Act. The scheme of the Act and the Rules require time-bound steps to be taken by applicants for grant of patent at various stages. The provisions of the Act and the Rules have to expressly reflect the legislative intent to permit relaxation of time limits, absent which such relaxation cannot be ‘read into’ the provisions by a High Court exercising powers under Article 226 of the Constitution. In other words, it is not possible for this Court to accept the submission of the learned Senior counsel for the Petitioner that the time-limits under Section 11-B(1) of the Act read with Rule 24-B of the Rules, notwithstanding Section 11-B (4) of the Act, are merely ‘directory’ and not mandatory. In fact, the wording of Section 11-B (4) of the Act underscores the mandatory nature of the time limit for filing an RFE in terms of Section 11-B (1) of the Act read with Rule 24-B of the Rules.”

15. In view of the above, the present petition is unmerited and accordingly dismissed. The parties are left to bear their own costs.

VIBHU BAKHRU, J

FEBRUARY 16, 2018

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