



WEB COPY

W.P. (IPD) No.1 of



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 25.09.2023

CORAM

**THE HONOURABLE MR.JUSTICE SENTHILKUMAR
RAMAMOORTHY**

W.P. (IPD) No.1 of 2023

and

W.M.P.No.12055 of 2023

BL Technologies, Inc.,
a US Company having office at
5951, Clearwater Drive,
Minnetonka, MN 55341,
United States of America.
Email: remfry-sagar@remfry.com

...Petitioner

Vs.

1.Union of India,
Represented by its Secretary,
Department of Industrial Police and Promotion,
Ministry of Commerce and Industry,
Udyog Bhawan, New Delhi - 110011.

2.The Controller General of Patents,
Designs & Trade Marks,
Boudhik Sampada Bhavan,
Antop Hill, S.M. Road,
Mumbai - 400037.
Email: cgooffice-mh@nic.in



3. Shri. C N Shashidhara,
Joint Controller of Patents & Designs,
Patent Office Intellectual Property Building,
G.S.T. Road, Guindy, Chennai - 600032.
Email: chennai-patent@nic.in

...Respondents

Prayer: Writ Petition filed under Article 226 of the Constitution of India praying to issue a writ of *certiorarified mandamus* to quash the deeming abandonment of the Indian Patent Application No.201948027517 and issue directions to the respondents to revive the said application to allow the petitioner to file response to the First Examination Report issued in Indian Patent Application No.201948027517 and further process and examine the Indian Patent Application No.201948027517 for patent grant procedure.

For Petitioner : Mr. Satish Parasaran, Senior Counsel
for Mr. Vineet Rohilla
Mr. P. Rajkumar Jhabakh,
D. Subbin,
Preeti Mohan,
Sagarika Shankar

For Respondents : Mr. S. Janarthanam,
Senior Panel Counsel

ORDER

The petitioner challenges the deemed abandonment of Indian Patent Application No.201948027517 and also seeks consequential directions for the revival of the said application by permitting the petitioner to file a response to



the First Examination Report (FER) issued by the Controller of Patents in response to the application.

WEB COPY

2. The writ petitioner applied for a patent under the above mentioned patent application number in relation to a method and system for measuring carbon dioxide in aqueous stream. The said application was filed on 09.07.2019. The FER in response thereto was issued on 01.02.2022. Consequently, the petitioner was required to respond thereto and put its application in order on or before 01.08.2022. A request for extension of time was submitted on 26.07.2022. Although the relevant rule enables the petitioner to seek an extension of up to three months, an extension of one month was requested for. Such extension was granted up to 01.09.2022. On 01.09.2022, instructions were issued to the petitioner's agent to submit a response. The petitioner's agent informed the petitioner that it is no longer possible to revive the application or submit the response since the time limit for the same had expired on 01.09.2022. The status of the application was *ipso facto* reflected as abandoned upon expiry of the extended period on 01.09.2022. The writ petition was filed in these facts and circumstances.



3. Mr.Satish Parasaran, learned senior counsel for the petitioner, invited my attention to the communications between the petitioner and its patent agent and pointed out that these communications provide clear evidence that the petitioner did not intend to abandon its application. On the contrary, he submitted that these communications provide evidence that the petitioner wanted the response to be filed to the FER before the expiry of the time limit. He also pointed out that the petitioner was entitled to seek an extension of three months from 01.08.2022 and that the response could not be submitted because of the failure to meet the deadline of 01.09.2022 by a day.

4. In support of the contention that an extension of time may be granted by this Court under Article 226 of the Constitution, learned senior counsel referred to and relied on the judgment of the Delhi High Court in *European Union v. Union of India and Others, (European Union) 2022 SCC OnLine Del 1793*, particularly paragraphs 17, 26, 49 to 52 and 58 to 63 thereof. With specific reference to paragraph 50, he pointed out that the Delhi High Court referred to the timelines for putting an application for grant in order and thereafter pointed out that an extension of time was granted for such purpose in cases such as *Ferid Allani v. Union of India and others, 2019 SCC OnLine Del*



11867, and *Telefonaktiebolaget LM Ericsson (PUBL) v. Intex Technologies (India) Limited*, 2015 SCC OnLine Del 8229. He then referred to the judgment in *PNB Vesper Life Science Pvt. Ltd., v. Controller General of Patents, Designs & Trademarks*, 2022 SCC OnLine Mad 3190, wherein this Court granted extension of time in similar circumstances. In conclusion, learned senior counsel submitted that it cannot be concluded that the petitioner abandoned its application and the petitioner would be deprived of its invaluable and substantive right to the grant of a patent unless this Court exercises discretion in favour of the petitioner.

5. In response to these contentions, Mr.S.Janarthanam, learned Senior Panel Counsel, submitted that time limits are prescribed by the Patents Act, 1970 (the Patents Act) read with the Patents Rules, 2003 (the Patents Rules). Such time limits are mandatory and non-adherence thereto cannot be condoned on the grounds raised by the petitioner. In support of these contentions, Mr.Janarthanam relied upon the judgment of the Delhi High Court in *Sphaera Pharma Pvt. Ltd. v. Union of India*, (Sphaera Pharma) 2018 02 DEL CK 0414, particularly paragraph 14 thereof, wherein the Delhi High Court referred to an earlier decision in *Nippon Steel Corporation v. Union of India*, 2011 (46) PTC



122 (Del) and concluded that the time limits prescribed in the Patents Act and the rules framed thereunder are mandatory as they reflect legislative intent and that such time limits cannot be extended in exercise of jurisdiction under Article 226 of the Constitution. Therefore, he submitted that the writ petition is liable to be dismissed.

6. At the outset, the relevant provisions of the Patents Act and the Patents Rules should be noticed. Section 21(1) is as under:

"21. Time for putting application in order for grant. -

(1) An application for a patent shall be deemed to have been abandoned unless, within such period as may be prescribed, the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objections to the application or complete specification or other documents related thereto is forwarded to the applicant by the Controller."

7. Section 21(1) of the Patents Act is required to be read with Rule 24-B of the Patent Rules. Sub-Rules 5 and 6 of Rule 24-B are relevant and the same



are set out below:

"24-B. Examination of application.

(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. The other rule of relevance is Rule 138, which is set out below:

"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 24-B, sub-rules (10) and (11) of rule 24-C, sub-rule (4) of rule 55, sub-rule (1-A) 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."



9. On a combined reading of sub-section 1 of Section 21 and sub-rules 5 and 6 of Rule 24-B, it is clear that the applicant for a patent is given six months time to put the patent application in order and that this time limit is reckoned from the date on which the first statement of objections is issued to the patent applicant. Under sub-rule 6 of Rule 24-B, the patent applicant is entitled to seek an extension by a further period of three months from the expiry of the six month period referred to above.

10. Turning to the facts of this case, the six month period expired on 01.08.2022. Prior thereto, on 26.07.2022, the patent applicant requested for an extension of time. The patent applicant could have requested for an extension up to about 01.11.2022. Instead, an extension of one month was requested for and such extension was granted. As a result, the time limit for responding to the FER was extended up to 01.09.2022. The writ petitioner has placed on record the communications exchanged between the petitioner, through its advisor, and the petitioner's patent agent in India. These communications indicate beyond all doubt that the petitioner did not intend to abandon its application for patent and that the applicant intended to respond to the FER and prosecute the application.



WEB COPY

11. The question that arises for consideration is whether the legal fiction in sub-section 1 of Section 21 is triggered notwithstanding the evidence placed on record by the petitioner of its intention to prosecute and not abandon the application. Learned senior counsel for the petitioner placed great emphasis on the judgment of the Delhi High Court in *European Union*. After noticing that the Patents Act read with the Patents Rules prescribe both extendable and non-extendable deadlines, the Delhi High Court recorded in paragraph 52 of the judgment that there is authority for the proposition that the time limit for filing a request for examination cannot be extended. In this connection, it should be noticed that the judgment relied on by Mr. Janarthanam, *Sphaera Pharma*, pertains to a request for extension of time for filing a request for examination. By contrast, in the said paragraph 52, the Delhi High Court referred to three decisions, including a decision of this Court, wherein the time limit for filing a response to the FER was extended in exercise of writ jurisdiction. Thereafter, in paragraphs 59 to 63, the Delhi High Court recorded the following observations and conclusions:

"59. Therefore, the question that arises is whether this Court while exercising writ jurisdiction under Article 226 and 227 ought to condone the delay and restore the



patent applications of the Petitioner.

60. *The Court is convinced that there was no intention to abandon on behalf of the Petitioner, instead, the Petitioner's actions indicate that they were actively pursuing the application. Moreover, the judicial opinion in respect of responses to FER or other deadlines seems to suggest that if the Applicant did not have an intention to abandon and if the Court is convinced that there was a mistake of the patent agent and the Applicant is able to establish full diligence, the court ought to be liberal in its approach.*

61. *In the opinion of this Court, the mistake of the patent agent would be similar to the mistake of an advocate who may be representing parties in any civil or criminal litigation. Insofar as any mistake committed by counsels/advocates are concerned, the settled legal position is that the litigants ought not to suffer, as has been laid down by the Supreme Court in a number of decisions including Smt. Lachi Tewari & Ors. v. Director of Land Records, 1984 Supp SCC 431; Rafiq v. Munshilal, (1981) 2 SCC 788; Mangi Lal v. State of M.P., (1994) 4 SCC 564 and The Secretary, Department of Horticulture, Chandigarh v. Raghu Raj, (2008) 13 SCC 395 : AIR 2009*



WEB COPY



SC 514.

62. *In view of the fact that no fault can be attributed to the Applicant, this Court is of the opinion that the Applicant ought not to be made to suffer. However, there is a word of caution that this Court would like to add in this regard. The intention of the Legislature in Rule 138 of the Rules cannot be ignored by the Controller, nor can one ignore the express language of Section 21(1) of the Act, which mandates a deemed abandonment in case of non-compliance with the requirements imposed under the Act. It is only in extraordinary cases, while exercising writ jurisdiction, that the Court may consider being flexible, and this would depend on the facts of each case as to whether a condonation ought to be given at all.*

63. *There is yet another recent development which the Court notices. The 161st report submitted by the Department Related Parliamentary Standing Committee on Commerce on 23rd July, 2021, titled ‘**Review of the Intellectual Property Rights Regime in India**’ has taken note of the enormous prejudice being caused to patent applicants due to ‘deemed abandonment’ provisions. The Committee has opined that the abandoning of patents would de-moralize or discourage patentees in India. The*



WEB COPY



observations of the Committee is set out below:

"vi. It was highlighted that the inflexibilities in Patent Act does not leave any room for errors thereby affecting the filing of patents. It was informed that in countries like US any delay in filing of patents could be condoned with an appropriate petition, fees, timely hearing and disposal. However, in India, once a due date has elapsed for filing request for examination report or a complete specification after a provisional one, there exist no remedy. Hence, as per Section 21(1) of the Patent Act, 1970, an application for a patent shall be deemed to have been abandoned unless the applicant has complied with all the requirements imposed on him by or under this Act within such period as may be prescribed. This inflexibility affects number of patents filed. The Committee opines that the abandoning of patents, without allowing hearing or petition, may demoralize and discourage patentees in the country to file patents. It recommends the Department that certain flexibility should be incorporated in the Act to make for allowance of minor errors and lapses to prevent outright rejection of patents being filed. Hence, a revised petition with penalty or fee may be permitted under the Act for minor or bona fide mistakes that had been committed in the filed patents."



WEB COPY

From the above paragraphs of the Delhi High Court's judgment, it is clear that the Delhi High Court concluded that the time limit for filing a response to the FER may be extended in exercise of writ jurisdiction in cases where the Court is able to draw the clear conclusion that there was no intention on the part of the patent applicant to abandon the application and where fault cannot be attributed to such patent applicant.

12. As discussed earlier, the petitioner/patent applicant was statutorily entitled under sub-rule 6 of Rule 24-B to seek an extension of three months. If such extension had been sought, the extended period would have run up to about 01.11.2022 and the petitioner would have been in a position to file the response. The documents on record clearly provide evidence that the petitioner/patent applicant made efforts to file a response in early September 2022 and appears to have narrowly missed the bus. When these facts and circumstances are considered in the statutory context of a provision for deemed abandonment, I am of the view that this is a fit case for exercising discretionary jurisdiction in favour of the petitioner. It is needless to say that such discretion is being exercised in view of the specific facts and circumstances of this case.



WEB COPY

13. For reasons set out above, the deemed abandonment of Indian Patent Application No.201948027517 is quashed and respondents 2 and 3 are directed to receive the response of the petitioner to the First Examination Report provided such response is sent within two weeks from the date of receipt of a copy of this order. For purposes of receiving such response, respondents 2 and 3 are directed to take necessary steps to provide access for e-filing or otherwise enable the filing of and receipt of such response.

14. The writ petition is disposed of on these terms without any order as to costs. Consequently, the writ miscellaneous petition is closed.

25.09.2023

Index:Yes
Speaking order
Neutral Citation:Yes
hvk



To

1. The Secretary,
Union of India,
Department of Industrial Police and Promotion,
Ministry of Commerce and Industry,
Udyog Bhawan, New Delhi - 110011.
2. The Controller General of Patents,
Designs & Trade Marks,
Boudhik Sampada Bhavan,
Antop Hill, S.M. Road,
Mumbai - 400037.
Email: cgooffice-mh@nic.in
3. Shri. C N Shashidhara,
Joint Controller of Patents & Designs,
Patent Office Intellectual Property Building,
G.S.T. Road, Guindy, Chennai - 600032.
Email: chennai-patent@nic.in



WEB COPY



W.P. (IPD) No.1 of

SENTHILKUMAR RAMAMOORTHY,J.

hvk

W.P. (IPD) No.1 of 2023
and
W.M.P.No.12055 of 2023

25.09.2023