



IN THE HIGH COURT OF DELHI AT NEW DELHI

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Judgment delivered on: 20.07.2023

+ **W.P.(C) 12238/2019****HUMANITY LIFE EXTENSION LLC**

..... Petitioner

versus

UNION OF INDIA AND ANR.

..... Respondents

Advocates who appeared in this case:

For the Petitioner : Mr R.K. Aggarwal, Mr Vinay Kumar Padam
and Mr Sourabh Pareek, Advocates.

For the Respondents : Mr Asheesh Jain, CGSC with Mr Gaurav
Kumar, Advocate.

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HON'BLE MR JUSTICE VIBHU BAKHRU**HON'BLE MR JUSTICE AMIT MAHAJAN**

JUDGMENT

VIBHU BAKHRU, J

1. The petitioner (Humanity Life Extension LLC) is, *inter alia*, engaged in the business of manufacturing medical devices and its corporate headquarters is located in the United States of America. The petitioner has filed the present petition, *inter alia*, praying as under:

- “i) This Hon’ble Court may be pleased to declare, by issue of an appropriate writ, order or direction, that the amendment of Rule No. 138 of the Patents Rules, 2003 effective from 16.05.2016, by virtue of which



provision for extension of time to entertain an international patent application by one month has been taken away, as being ultra vires of the rule making power conferred upon the Central Government under Section 159 of the Patents Act, 1970, being in conflict with the Patents (Amendment) Act No. 38 of 2002 and Patents (Amendment) Act No. 15 of 2005 and existing Rule 23 of the Patents Rules, 2003;

- ii) The Hon'ble Court may, further, be pleased to direct the respondent Controller of Patents, by means of issue of a writ of mandamus or certiorari or any other appropriate writ or direction, to entertain the petitioner's National Phase Application and the application for extension of time, whether maintainable under Regulation 49.6 of Patent Cooperation Treaty Regulations and/or Rule 138 of Patents Rules, 2003, and decide the same after affording adequate opportunity of hearing and for presenting its case before the Controller of Patents."

2. The petitioner is, essentially, aggrieved as the Controller of Patents (hereafter '**the Controller**') has declined to entertain the petitioner's National Phase Application.

3. The petitioner claims that on 26.07.2019, its US Patent Attorney had instructed the Indian Patent Attorney to file the petitioner's National Phase Application for registration of its patent for a System and Method for Treating Blood, corresponding to the Patent Cooperation Treaty (hereafter '**PCT**') Application No. PCT/US2018/016797 dated 05.09.2018, claiming priority from US Application No. 15/425,494 dated 06.02.2017 captioned "System and Method for Treating Blood". The petitioner claims that its US Patent Attorney had expressly communicated to its Indian Patent Attorney that the time period of thirty-one months for filing the National Phase



Application will expire on 06.09.2019. The petitioner claims that after the expiry of the aforesaid time period, it contacted its US Patent Attorney to enquire about the status of the National Phase Application in India. On enquiries, the petitioner became aware that the Indian Patent Attorney had not filed the National Phase Application within the stipulated period.

4. The petitioner engaged another attorney in India and on 01.10.2019, its Indian Patent Attorney forwarded the petitioner's National Phase Application under the cover of its letter to the Indian Patent Office (hereafter '**IPO**'). This application was returned by the IPO on 03.10.2019, and received by the petitioner's Indian Patent Attorney on 07.10.2019.

5. Immediately, thereafter on 09.10.2019, the petitioner's Indian Patent Attorney once again forwarded the National Phase Application to the IPO claiming that the application was maintainable in view of Regulation 49.6 of the Patent Corporation Treaty Regulations (hereafter '**the PCT Regulations**'). The IPO did not accept the same and, on 14.10.2019, once again returned the said applications.

6. The petitioner had filed an application in the United States bearing no.15/425,494 captioned "*System and Method for Treating Blood*" on 06.02.2017. It had filed an International Application on 05.02.2018, which is within the period of twelve months as prescribed under the PCT. Admittedly, in terms of Rule 20 of the Patents Rules, 2003 (hereafter '**the Patents Rules**') the National Phase Application



was required to be filed within a period of thirty-one months from the Priority Date; that is, within thirty-one months from 06.02.2017. The last date for filing the National Phase Application was 06.09.2019 and admittedly, the petitioner had missed the said deadline.

7. The only question that arises for consideration is whether the petitioner is entitled to additional time for filing the National Phase Application and whether the amendment to Rule 138 of the Patents Rules, which denudes the Controller of any effective power to condone the delay for an application under Rule 20 of the Patents Rules is *ultra vires* Section 159 of the Patents Act, 1970 (hereafter '**the Patent Act**').

8. It is the petitioner's case that the Central Government can make rules under Section 159 of the Patent Act for carrying out the purposes of the Patent Act. India is a signatory to the PCT and Chapter XXII of the PCT was introduced in the Patents Act for complying with the obligations under the PCT; therefore, the Central Government is not empowered to make any rule, which militates against the provisions of the PCT in exercise of its powers under Section 159 of the Patent Act.

9. The petitioner contends that in terms of Regulation 49.6 of the PCT Regulations, the designated office is required to reinstate rights in respect of the International Application if it finds that the delay in meeting the time lime was unintentional. Thus, the amendment to Rule 138 of the Patents Rules is *ultra vires* the Patent Act and beyond the powers conferred on the Central Government.



10. Before proceeding further, it would be relevant to refer to Rule 138 of the Patents Rules as in force prior to 16.05.2016:

“138. Power to extend time prescribed.— (1) Save as otherwise provided in the Chapter III of these rules, rule 24B, sub-rule (4) of rule 55 and sub-rule (1A) of rule 80, 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 made under these rules shall be made before the expiry of prescribed period.”

11. Rule 138 of the Patents Rules was substituted by GST 523(E) dated 16.05.2016 and as currently in force 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.”

12. Whereas, prior to the amendment, the Controller had the power to extend the period prescribed under Rule 20(4)(i) of the Patents Rules by a period of one month. It ceased to have such power with effect from 16.05.2016.



13. In terms of Article 22 of the PCT, the applicant is required to furnish a copy of the International Application and translation thereof and pay the national fee to each designated office not later than expiry of thirty months from the Priority Date. In terms of paragraph (3) of Article 22 of the PCT, any national law may, prescribe time limits for performing the acts referred to in paragraphs (1) or (2) of Article 22 of the PCT, which expire later than the time limit as provided in those paragraphs.

14. In conformity with the said Article, Rule 20(4)(i) of the Patents Rules expressly provides the time limit of thirty-one months from the Priority Date as referred to in Article 2(xi) of the PCT. In terms of Article 2(xi)(a) of the PCT, the Priority Date for the purpose of computing time limits would mean the filing date of the International Application whose priority is so claimed.

15. The petitioner's case rests on the Patents Rules being contrary to Regulation 49.6 of the PCT Regulations. The said Regulation is reproduced below:

“49.6 Reinstatement of Rights after Failure to Perform the Acts Referred to in Article 22

(a) Where the effect of the international application provided for in Article 11(3) has ceased because the applicant failed to perform the acts referred to in Article 22 within the applicable time limit, the designated Office shall, upon request of the applicant, and subject to paragraphs (b) to (e) of this Rule, reinstate the rights of the applicant with respect to that international application if it finds that any delay in meeting that time limit was unintentional or, at the option of the designated Office, that the failure to meet that time limit



occurred in spite of due care required by the circumstances having been taken.

(b) The request under paragraph (a) shall be submitted to the designated Office, and the acts referred to in Article 22 shall be performed, within whichever of the following periods expires first:

(i) two months from the date of removal of the cause of the failure to meet the applicable time limit under Article 22; or

(ii) 12 months from the date of the expiration of the applicable time limit under Article 22;

provided that the applicant may submit the request at any later time if so permitted by the national law applicable by the designated Office.

(c) The request under paragraph (a) shall state the reasons for the failure to comply with the applicable time limit under Article 22.

(d) The national law applicable by the designated Office may require:

(i) that a fee be paid in respect of a request under paragraph (a);

(ii) that a declaration or other evidence in support of the reasons referred to in paragraph (c) be filed.

(e) The designated Office shall not refuse a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

(f) If, on October 1, 2002, paragraphs (a) to (e) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that designated Office for as long as they continue not to be compatible with that law, provided that the said Office informs



the International Bureau accordingly by January 1, 2003. The information received shall be promptly published by the International Bureau in the Gazette.”

16. According to the petitioner, since Rule 138 of the Patents Rules do not provide for condonation of delay in filing the National Phase Application as contemplated under Regulation 49.6 of the PCT Regulations, Rule 138 of the Patents Rules (as amended) is liable to be set aside.

17. We are unable to accept the aforesaid contention. The question raised by the petitioner are no longer *res integra*.

18. In ***Diebold Self Service Systems v. Union of India and Ors.*** **2022/DHC/005743**, a Co-ordinate Bench of this Court had after referring to various decisions held that the time period for filing the application is mandatory. The contention that the Patents Rules are not in conformity with Regulation 49 of the PCT Regulations is also squarely covered by the aforesaid decision.

19. The Court had noted that in terms of Regulation 49.6(f) of the PCT Regulations, if any of the other clauses of the said Rules (49.1 to 49.5 of the PCT Regulations) are not compatible with the National law applied to the designated office, the said clauses would not apply for as long as they continue not to be compatible with that of the PCT, provided that the designated office informs the International Bureau accordingly by 01.01.2003. India has expressed its reservations in respect of Regulation 49.6(f) of the PCT Regulations. It is also not disputed that the IPO had communicated its reservations towards



Regulation 49.6 of the PCT Regulations. The designated office of some of the other countries have also done so.

20. In *Diebold Self Service Systems v. Union of India and Ors.* (*supra*), the Co-ordinate Bench of this Court had also rejected the said contention that any reservation under Regulation 49.6(f) of the PCT Regulations, was not permissible.

21. In view of the above, the present petition is unmerited and accordingly, dismissed.

VIBHU BAKHRU, J

AMIT MAHAJAN, J

JULY 20, 2023
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