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Date: 2024.05.06
17:28:54 +0530IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

COMMERCIAL MISCELLANEOUS PETITION NO.8 OF 2022

1. Sonalkumar Sureshrao Salunkhe
having his address at
Plot No.B/12, M.I.D.C.
Islampur, Taluka Walwa,
District Sangli – 415 409.

2. Kunal Sureshrao Salunkhe
having his address at
Plot No. - B/12, M.I.D.C.
Islampur, Taluka Walwa,
District Sangli – 415 409.

... Petitioners

Versus

The Assistant Controller of Patents
having his office at
Boudhik Sampada Bhawan,
IPO Bhavan, Antop Hill,
Mumbai – 400 037.

...Respondent

Mr.Hiren Kamod a/w Mr.Anees Patel, Mr.Prem Khullar, Mr.Aditya
Chitale, Mr.Prashant Shetty i/b M/s.R.K.Dewan Legal Services for the
Petitioners
Mr.Abhishek Bhadang a/w Ms.Carina Xavier for the Respondent

CORAM:	_____	FIRDOSH P. POONIWALLA, J.
RESERVED ON:		24 th April, 2024
PRONOUNCED ON:		6 th May, 2024

JUDGEMENT:

1. The present Petition is an Appeal under the provisions of Section 117A of the Patents Act, 1917 ("The Patents Act") impugning the Order dated 16th September 2021 passed by the Respondent. The relevant parts of the said Order read as under:

“7. I consider that the application shall be considered deemed to have been abandoned for the following reasons :

“I. The applicant has failed to comply with all of the objections in the FER. No attempt to reply to the objections on one to one basis was made.

II. The applicant may have opted for an extension in the timeline to comply with the objections under rule 24-B(6) of the Rules. The unconcerned written submission in reply to the FER is an attempt to circumvent the provision under rule 24-B(5).

III. The controller has no power to extend the timeline under rule 24-B(5), under rule 138 of the Patents Rules.

IV. I have not observed any extraordinary circumstances: national emergency, pandemic, war- like situation etc.

V. If at all, the prosecution of the instant application is allowed, it is going to circumvent the provisions under section 21(1) of the Patents Act, 1970 read with Rule 24-B(5), (6). The same will open a pandora's box and the due time-bound provisions under Rule 24-B(5), (6) will be short-circuited.

8. Technical Analysis

No further technical examination is required as the applicant has failed to comply with the requirement of section 21 (1) of the Patents Act, 1970 read with the relevant rules.

9. Decision

Given my understanding in paragraph 7, I refuse to proceed with the grant of instant application due to the following reasons:

I. The applicant has failed to coruply with all of the objections in the FER. No attempt to reply to the

objections on one to one basis was made.

II. The applicant may have opted for an extension in the timeline to comply with the objections under rule 24-B(6) of the Rules. The unconcerned written submission in reply to the FER is an attempt to circumvent the provision under rule 24-B(5).

III. The controller has no power to extend the timeline under rule 24-B(5), under rule 138 of the Patents Rules.

IV. I have not observed any extraordinary circumstances, national emergency, pandemic, war- like situation etc.

V. If at all, the prosecution of the instant application is allowed, it is going to circumvent the provisions under section 21(1) of the Patents Act, 1970 read with Rule 24-B(5), (6). The same will open a pandora's box and the due time-bound provisions under Rule 24-B(5), (6) will be short-circuited."

2. Mr.Bhadang, the learned counsel appearing on behalf of the Respondent, raised a preliminary objection that the present Petition is not maintainable. Mr.Bhadang pointed out the provisions of Section 117A of the Patents Act and submitted that Section 117A does not provide for an Appeal against an Order passed under Section 21(1) of the Patents Act. He submitted that, since the impugned Order was passed under Section 21(1) of the Patents Act, the present Appeal was not maintainable.

3. In response to this preliminary objection raised by Mr.Bhadang, Mr.Kamod, the learned counsel appearing on behalf of the Petitioners, submitted that, in the present case, the FER was issued on 24th June 2019. He submitted that the Petitioners had responded to the said FER by their reply dated 24th December 2019. In the reply dated 24th December 2019, the

Petitioners had responded to all the requirements under the FER. He further drew the Court's attention to a letter dated 15th September 2020 issued by the Petitioner as a follow up to the reply dated 24th December 2019. Mr.Kamod submitted that, since the Petitioners had responded to the requirements in the FER, the Petitioners could not have been said to have abandoned their application under Section 21(1) of the Patents Act. Mr.Kamod submitted that, if the Respondent found that the Application was required to be rejected as the response of the Petitioners was not satisfactory, then the Order is an Order passed under Section 15 of the Patents Act, which is appealable under Section 117A. Mr.Kamod submitted that, therefore, the present Petition was maintainable. In support of his submissions, Mr.Kamod relied upon the judgements of the *Delhi High Court in Merck Serono S.A. vs. Union of India*¹, *Telefonaktiebolaget LM Ericsson (PUBL) vs. Union of India (UOI) and Ors.*² and *Ferid Allani vs. Union of India (UOI) and Ors.*³

4. In rejoinder, Mr.Bhadang submitted that the impugned Order clearly showed that it had been passed under Section 21(1) of the Patents Act, and, therefore, no Appeal could be filed under Section 117A of the Patents Act against the same. This Court, as the Appellate Court, had no jurisdiction to decide whether the Order was passed under Section 21 (1) or under Section 15. He submitted that, since the said Order itself showed that it was passed under Section 21(1), this Court would have no jurisdiction to entertain this Petition.

5. Mr.Bhadang also relied upon the judgement of the Delhi High Court in *The European Union Represented by the European Commission vs. Union of India & Ors.*⁴

1 MANU/DE/2440/2014

2 MANU/DE/0683/2010

3 MANU/DE/2762/2008

4 W.P.(C) – IPD 5/2022

6. I have heard the learned counsel for the parties and perused the documents on record.

7. The provisions of Section 117(A) of the Patents Act read as under:

“117A. Appeals to High Court.—(1) Save as otherwise expressly provided in sub-section (2), no appeal shall lie from any decision, order or direction made or issued under this Act by the Central Government, or from any act or order of the Controller for the purpose of giving effect to any such decision, order or direction.

(2) An appeal shall lie to the High Court from any decision, order or direction of the Controller or Central Government under section 15, section 16, section 17, section 18, section 19, section 20, sub-section (4) of section 25, section 28, section 51, section 54, section 57, section 60, section 61, section 63, section 66, sub-section (3) of section 69, section 78, sub-sections (1) to (5) of section 84, section 85, section 88, section 91, section 92 and section 94.

(3) Every appeal under this section shall be in the prescribed form and shall be verified in such manner as may be prescribed and shall be accompanied by a copy of the decision, order or direction appealed against and by such fees as may be prescribed.

(4) Every appeal shall be made within three months from the date of the decision, order or direction, as the case may be, of the Controller or the Central Government or within such further time as the High Court may, in accordance with the rules made by it allow.”

8. It is clear from the provisions of Section 117A that no Appeal lies against an Order passed under Section 21(1) of the Patents Act. Mr. Bhadang may be quite right in submitting that, since the Order dated 16th September, 2021 itself shows that it has been passed under Section 21(1) of the Patents Act, this Court

would have to hold that it has no jurisdiction to entertain an Appeal against the same under the provisions of Section 117A as Section 117A does not provide for an Appeal against the said Order. He may also be right in contending that it is not open for an Appellate Court, like this Court, to consider whether the Order would fall under the provisions of Section 15 of the Patents Act once the Order clearly shows that it falls within the provisions of Section 21(1) of the Patents Act. For this reason itself, the present Petition may not be maintainable.

9. As far as the submissions of Mr.Kamod that the impugned Order is passed under Section 15 of the Patents Act is concerned, it must be seen that the FER issued to the Petitioners made detailed observations on the requirements under the Patents Act in respect of (i) Inventive Step (ii) Sufficiency of Disclosure (iii) Definitiveness and (iv) other requirements.

10. The reply dated 24th December 2019 of the Petitioners does not comply with all the said requirements. A perusal of the said reply shows that, except in respect of the requirement regarding inventive step, in respect whereof the Petitioners have made some comments, the reply does not at all deal with the other requirements of the FER. In this factual scenario, it would have to be considered as to whether Section 21(1) is applicable and whether the impugned Order is passed under Section 21(1) or under Section 15.

11. Sections 15 and 21(1) of the Patents Act read as under:

“Section 15 – Power of Controller to refuse or require amended applications, etc., in certain cases -

Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to

his satisfaction before he proceeds with the application and refuse the application on failure to do so.”

Section 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.

Explanation.—Where the application for a patent or any specification or, in the case of a convention application or an application filed under the Patent Cooperation Treaty designating India any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has re-filed it or the applicant proves to the satisfaction of the Controller that for the reasons beyond his control such document could not be re-filed.”

12. In my view, the impugned Order is clearly passed under Section 21(1). As stated hereinabove, in its reply dated 24th December 2019, the Petitioners did not deal with many of the requirements of the FER. The Petitioners also did not seek extension of time for complying with the requirements of the FER. In such circumstances, after considering the written submissions of the Petitioners and after giving a hearing, the impugned Order clearly holds that the Petitioner is deemed to have abandoned the application and that it has failed to comply with the requirements of Section 21(1) of the Patents Act. In these circumstances, the impugned Order refuses to proceed with the Application for a Patent of the Petitioners.

13. In these circumstances, in my view, since the Petitioners have not complied with the requirements of the FER within the time prescribed, the provisions of Section 21(1) would be applicable and the impugned Order has been correctly passed under the provisions of Section 21(1) of the Patents Act and not under Section 15 of the Patents Act, as alleged by the Petitioners.

14. As far as the judgements relied upon by the Applicants are concerned, paragraph nos.10 to 15 of the judgement in *Telefonaktiebolaget LM Ericsson (PUBL)* (Supra) are relevant and read as under:

“10. The question that arises in the present case is whether, in the facts and circumstances of the case, it could be said that the Petitioner has 'abandoned' its patent application in terms of Section 21(1) of the Act.

11. Section 21(1) of the Act reads 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.

Explanation. - Where the application for a patent or any specification or, in the case of a convention application or an application filed under the Patent Cooperation Treaty designating India any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has re-filed it or the applicant proves to the satisfaction of the Controller that for the reasons beyond his control such document could not be re-filed.

12. The above provision has to be read in the context of Section 12 of the Act, which reads as under:

12. Examination of application:

When a request for examination has been made in respect of an application for a patent in the prescribed manner under Sub-section (1) or Sub-section (3) of Section 11B, the application and specification and other documents related thereto shall be referred at the earliest by the Controller to an examiner for making a report to him in respect of the following matters, namely:

(a) whether the application and the 3 [specification and other documents relating thereto] are in accordance with the requirements of this Act and of any rules made there under;

(b) whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;

(c) the result of investigations made under Section 13, and

(d) any other matter which may be prescribed.

(2) The examiner to whom the application and the specification and other documents relating thereto are referred under Sub-section (1) shall ordinarily make the report to the Controller within such period as may be prescribed.

13. A collective reading of the above provisions shows that the applicant is required to deal with the objections raised in the reports that emerge as a result of the examination of the application. Whether the applicant has satisfactorily met the objections is another matter. In the context of Section 21 an applicant should be deemed to have "abandoned" his application only when such applicant fails to comply with all the requirements imposed on him or under this Act. This can be contrasted with Section 15 which talks of the satisfaction of the Controller. Section 15 of the Act reads as under:

15. *Power of Controller to refuse or require amended applications, etc., in certain cases. Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.*

14. *Where in response to an examination report, an applicant does nothing by way of meeting the objections raised therein within the time stipulated, and does not seek extension of time for that purpose only then it can be said that such application should be "deemed to have been abandoned". If he has replied but such reply is not found satisfactory, even after a further opportunity if any is given, then the Controller should proceed to take a decision in terms of Section 15, after complying with Section 14 of the Act.*

15. *As pointed out in Ferid Allani "abandonment" requires a conscious act on the part of the Petitioner which would manifest the intention to abandon the application. That judgment also refers to Section 80 of the Act and Rule 138 of the Patents Rules which gives discretionary powers to the Controller to extend the time for complying with a requirement. In the instant case the Petitioner responded to each of the objections set out in the examination report in writing within the time prescribed. It cannot, therefore, be said that it failed to respond to the objections and, therefore, did not comply with the requirements imposed on it under the Act. In other words, the basic factual condition for attracting the deemed fiction of "abandonment" in terms of Section 21(1) of the Act, was non-existent in the instant case."*

15. Further, paragraph nos.10 to 15 of the judgement in ***Merck Serono S.A.*** (Supra) are also relevant and read as under:

"10. The controversy that is to be addressed is whether in the given circumstances where the petitioner had responded to the FER as well as the SER, the application could be stated to be abandoned.

11. *Before proceeding further, it would be relevant to refer Section 21(1) of the Act, which reads 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.

Explanation.-Where the application for a patent or any specification or, in the case of a convention application or an application filed under the Patent Cooperation Treaty designating India any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has re-filed it or the applicant proves to the satisfaction of the Controller that for the reasons beyond his control such document could not be re-filed."

12. *Plainly, an order under Section 21(1) of the Act is to be passed where an applicant fails to comply with the requirements imposed on him under the Act. Provisions of Section 21(1) of the Act have to be read harmoniously with the provisions of Section 15 of the Act which reads as under:-*

"15 " Power of Controller to refuse or require amended applications, etc., in certain case.

Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so."

13. *It is seen that under Section 21(1) as well as Section 15 of the Act, an application filed by an applicant is liable to be rejected if it does not comply with the requirements of the Act. The said provisions can be harmoniously read if they are considered to operate in distinct and separate circumstances. The scope of Section 21(1) of the Act is clearly indicated by the expression "abandon". This Court in Telefonaktiebolaget (supra) examined the scheme of the aforesaid two Sections and following the decision in Ferid Allani (supra), held that abandonment would require a conscious act on the part of the petitioner, which would manifest the intention to abandon the application. The relevant extract from the said decision is quoted below:-*

"15. As pointed out in Ferid Allani "abandonment" requires a conscious act on the part of the Petitioner which would manifest the intention to abandon the application. That judgment also refers to Section 80 of the Act and Rule 138 of the Patents Rules which gives discretionary powers to the Controller to extend the time for complying with a requirement. In the instant case the Petitioner responded to each of the objections set out in the examination report in writing within the time prescribed. It cannot, therefore, be said that it failed to respond to the objections and, therefore, did not comply with the requirement imposed on it under the Act. In other words, the basic factual condition for attracting the deemed action fiction of "abandonment" in terms of Section 21(1) of the Act, was non-existent in the instant case.

16. Importantly, the intention of the Petitioner not to abandon its application was evident in its response dated 22nd September 2008 where it requested that in the event the Controller was not inclined to grant its patent, it may be afforded an opportunity of being heard. Such an opportunity is clearly envisaged in Section 14 itself. This is further provided for in Section 80 of the Act and Rule 129 of the Patent Rules. While discussing the above provisions, this Court in Ferid Allani held that there was a duty of the Controller to give a hearing to an applicant before exercising any discretionary power which was likely to adversely affect an applicant's claim for registration of patent."

14. It follows from the aforesaid decision that an application can be stated to be abandoned only in cases where the applicant fails and neglects to pursue its application. In the present case, the petitioner has provided the explanations in respect of the objections that were raised in the FER and SER. The question whether the explanations have any merit or not would be a subject matter of decision by the respondent no. 2. The impugned order dated 13.08.2008 also clearly indicates that there were certain discussions between the petitioner's agent and respondent no. 3, which were heard by the respondent no. 2. In the circumstances, it would not be open to respondent no. 2 to avoid a decision on the issues raised by taking recourse to Section 21(1) of the Act. As indicated in Telefonaktiebolaget (supra) the proper course available to respondent no. 2 would be to pass a speaking order under Section 15 of the Act.

15. The distinction sought to be drawn by the learned counsel for the respondent between facts of the present case and those in Telefonaktiebolaget (supra) and Ferid Allani (supra) is of little relevance. The crucial question to be addressed is whether an applicant had persuaded its application. In the present case, the said question must be answered in the affirmative.”

16. A perusal of the findings of the said judgements shows that it has been held that, if the Applicant complies with all the requirements imposed on it under the Act, the basic factual condition for attracting the deemed fiction of abandonment in terms of Section 21(1) of the Act would be non-existent. Further, it is held that what is required is compliance with the requirements and the question as to whether the explanations have any merit or not would be a different question. If the requirements are complied with, or, in other words, if the objections in the FER are responded to, then the case would not fall under Section 21(1) of the Patents Act.

17. In the present case, it is not the case that the Petitioners have dealt with all the objections raised in the FER as stated hereinabove. The Petitioners have cursorily dealt with one of the objections and have not dealt with the other objections in the FER. It is for this reason that the impugned Order has held

that the Application of the Applicants shall be considered deemed to have been abandoned and that no further technical examination was required as the Applicant had failed to comply with the requirements of Section 21(1) of the Patents Act. In my view, this is definitely an Order under Section 21(1) of the Patents Act and not under Section 15 of the Patents Act.

18. Since Section 117A does not provide for an Appeal against an Order passed under Section 21(1), the preliminary objection raised by the Respondent will have to be upheld and the present Petition will have to be dismissed.

19. In the light of the aforesaid discussions and for the aforesaid reasons, following Orders are passed:

- a. Petition is dismissed as being non-maintainable under the provisions of Section 117A of the Patents Act.
- b. In the facts and circumstances of the case, there will be no order as to costs.
- c. It is made clear that this Court has not dealt with the merits of the matter and all contentions of the parties in that regard are hereby expressly kept open.

(FIRDOSH P. POONIWALLA, J.)