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W.P.No.4958 of 2012

IN THE HIGH COURT OF JUDICATURE AT MADRAS

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DATED : 30.10.2024

THE HONOURABLE MR.JUSTICE K.KUMARESH BABU

W.P.No.4958 of 2012

and M.P.No.1 of 2012

France Telecom
Rep., by its Power of Attorney,
Neha Srivastava
Place d'Alleray,
75015 Paris,
France

... Petitioner

Vs

- 1.Union of India
Rep., by its Secretary,
Department of Industry,
Ministry of Industry and Commerce,
Udyog Bhawan, New Delhi.
- 2.The Controller General of Patents & Designs,
The Patent Office,
Boudhik Sampada Bhawan,
CP-2, Sector V, Salt Lake City Kolkata – 700091.
- 3.Deputy Controller of Patents & Designs,
Intellectual Property Rights Building,
G.S.T., Road, Guindy,
Chennai – 600 032.

... Respondents

PRAYER:- This Writ Petition has been filed under Article 226 of Constitution of India, to issue a Writ of Certiorarified Mandamus to call for the records of the third respondent pertaining to the subject application and quash the impugned orders dated May 03, 2011 and October 13, 2011 passed by the third respondent in returning the request for examination filed by the petitioner, and consequently direct the third respondent to take the petitioner's request for examination of application on record and proceed



W.P.No.4958 of 2011

further with the subject application as per the Act and the procedure prescribed in the Rules.

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For Petitioner :- Mr.Madhan Babu

For Respondents : Mr.D.Simon CGSC for R1 to R3

ORDER

The present writ petition has been filed to call for the records of the third respondent pertaining to the subject application and quash the impugned orders dated May 03, 2011 and October 13, 2011 passed by the third respondent in returning the request for examination filed by the petitioner and consequently direct the third respondent to take the petitioner's request for examination of application on record and proceed further with the subject application as per the Act and the procedure prescribed in the Rules.

2. Heard Mr.Madhan Babu, learned counsel appearing for the petitioner and Mr.D.Simon, learned Central Government Standing counsel appearing for the respondents.

3. Mr.Madhan Babu, learned counsel appearing for the petitioner would submit that the petitioner is a World leading telecommunication

<https://www.mhc.tn.gov.in/judicial> Operator and that it holds patent in various countries in respect of



W.P.No.4958 of 2022

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determination of list of preferred mobile access network. They had made an application with the second respondent herein for registration of their patent within the territory of India and that they had made a request for examination in respect of the identified application. However, the said application was returned by holding that the period of 48 months had lapsed. Thereafter, a request to amend priority date had also been made by the petitioner and the said application was also returned holding that the same was also beyond the prescribed period. Hence, the petitioner had filed the present Writ Petition challenging the impugned communication returning the petitioner's application on the ground that it had been made beyond the prescribed period. In that context, he would rely upon the judgment of the learned Single Judge of this Court in W.P.Nos.12620 & 12621 of 2017, dated 04.11.2022 and would submit that the case of the petitioner is squarely covered by the aforesaid judgment. Further he would submit that the learned Single Judge in the aforesaid judgment, had held that the facts of the case would fall under the category of exceptional circumstances and therefore, set aside the similar orders passed by the respondent therein with direction to restore the application and proceed in accordance with Acts and Rules. He would submit that the present facts of the case, also it was due to the error on the part of the agent, the application could not be filed in time, which would also fall under the exceptional circumstances and prays this Court to set aside

<https://www.mhc.tn.gov.in/judis>

the orders impugned and restore the said application on file and take the



W.P.No.4958 of 2017

petitioner's request for examination and proceed further with the subject application as per the provisions of the Act and Rules prescribed thereunder.

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4. Mr.D.Simon learned Central Government Standing counsel appearing on behalf of the respondents on the other hand would contend that it is an admitted case that the applications have been made by the petitioner beyond the prescribed period of 48 months and that the statute does not provide for entertaining such application beyond the period of 48 months. When that being so, the statute also provides such patent application filed by the petitioner should be deemed to have been withdrawn under Section 11(b)(4) of the Act. Therefore, he would contend that the application cannot be entertained and had been rightly returned by the respondent. He would further submit that the claim of the petitioner that the case would fall under exceptional circumstances as held by the learned Single Judge in a judgment relied upon by the petitioner is a fallacy. The petitioner had not been diligent enough in following up the application that he had filed and when that being so, the claim of the petitioner cannot be entertained and therefore, he prays this Court to dismiss the Writ Petition.

5. I have considered the rival submissions made by the learned counsels appearing on either side and perused the materials available on <https://www.mhc.tn.gov.in/judis> record.



W.P.No.4958 of 2022

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6. It is an admitted case that the request of the petitioner for examination had been made beyond the period of 48 months as prescribed under the Act. The only question that is now to be decided is whether the judgment of the learned Single Judge relied upon by the petitioner would apply to the facts and circumstances of this case. The learned Single Judge in the judgment referred supra, relied upon a judgment of the Delhi High Court in the case of ***European Union Represented by the European Commission vs. Union of India*** in W.P.(C)-IPD 5 of 2022, dated 31.05.2022 had also referred to the observations of the Parliamentary Standing Committee on commerce dated 28.07.2021 titled “Review of Intellectual Property Rights Regime in India” in holding that if there was a bonafide mistake that had been committed in the filed patents, allowance could be made. The learned Single Judge taking note of the judgment of the Delhi High Court as well as the Parliamentary Standing Committee report was of the view that no delay or fall can be attributed to the petitioner, since the delay was mainly caused by the Indian agent, who failed to present the examination diligently. Further, the learned Single Judge had also held that the valuable statutory rights of the petitioner cannot be completely deprived of merely because the patent application for examination had not been diligently presented by the agent. I am in complete acceptance with the view taken by the learned Single Judge. It is also further to be noted that an invention had been made by the petitioner and if such invention could not be



W.P.No.4958 of 2024

patented for technical reasons, the petitioner would lose their valuable rights of protecting their invention. Hence, by applying the principles upon which the learned Single Judge had held that the error that had been committed by the Indian agent cannot be put against the petitioner can also be applied to the present facts of the case, since it is the case of the petitioner that it was an Indian agent, who had failed to make necessary application for examination, inspite of the instructions given by the petitioner to its Indian agent.

7. In such view of the matter, I am of the considered view that the impugned orders dated 03.05.2012 and 13.10.2011 cannot be sustained and accordingly the impugned orders are set aside. There shall be a further direction to the second respondent to receive the application of the petitioner which had been returned by it under the impugned orders and process the same in accordance with law.

8. In fine, this Writ Petition is allowed and the impugned orders are set aside. There shall be no order as to costs. Consequently, connected Miscellaneous Petition is closed.

30.10.2024

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<https://www.mhc.tn.gov.in/> Index : Yes/ No

Speaking Order/ Non-speaking Order



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W.P..No.4958 of 2017



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W.P.No.4958 of 2012

K.KUMARESH BABU,J.

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The Controller of Patent,
Patent Office Intellectual Property Building,
G.S.T.Road, Guindy,
Chennai – 600 032.

W.P.No.4958 of 2012
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