

11-08-2025
Item No.2
Court No.41
KAUSHIK

IN THE HIGH COURT AT CALCUTTA
INTELLECTUAL PROPERTY RIGHTS DIVISION
Appellate Side

WPA-IPD No.1 of 2024
(Old No. WPA No.21819 of 2024)
Kylin Sanitary Technology (XIAMEN)
Company Limited
-vs-
Union of India & Ors.

Mr. Sayan Roychowdhury, Advocate
Mr. Tanmoy Roy, Advocate
...for the petitioner

Mr. Dhruv Surana, Advocate
...for the respondent

The writ petition is against an order dated June 24, 2024 passed by the Deputy Controller of Patents and Designs rejecting patent application (202034009705) as abandoned under section 21(1) of the Patents Act, 1970 read with Rule 24B of the Patents Rules, 2003. In view of the statutory embargo which provides that there can be no appeal against an order passed under section 21, the petitioner contends that they have no other alternative remedy.

In this background, the petitioner invokes the extra-ordinary jurisdiction of the Writ Court under Article 226 of the Constitution of India.

It is contended that the subject application for patent could not have been rejected on the ground of abandonment primarily due to the fact that the petitioner being a foreign entity incorporated under the

laws to China had engaged the services of a patent attorney to conduct all proceedings.

There was no intentional nor deliberate delay by the petitioner for which the application could have been treated to be abandoned. Any delay caused in pursuing the subject application for patent was primarily due to then prevailing COVID-19 Pandemic. The impugned order has been passed without taking into consideration the impact of COVID-19.

It is also contended that the first communication by and between the petitioner and its Indian patent agent had occurred on December 1, 2022. It is also submitted that any negligence in pursuing this proceeding is solely attributable to the Indian Patent Agent. In the absence of any mala fide or deliberate inaction of the petitioner, this Court should set aside the impugned order which has wrongly treated the application to have been abandoned. In support of such contention, the petitioner relies on the decision in *European Union Vs. Union of India reported in 2022 SCC OnLine Del 1793*.

On behalf of the respondent authority, it is submitted that in view of the mandatory timeline prescribed both under the Act and the Rules which has been violated by the petitioner, the impugned order is sustainable. There has been inordinate and unexplained

delay by the petitioner in pursuing the application before the Registry. There is no justification nor explanation for such deliberate inaction. In view of the statutory embargo and the prescribed fixed timelines, the respondent authorities have no option but to treat the application as abandoned. In support of such contention, the respondent relies upon on the decisions in *Nippon Steel Corporation Vs. Union of India (2011) SCC OnLine Del 669* and *Carlos Alberto Perez Lafuente Vs. Union of India reported in (2019) SCC OnLine Del 7404*.

For convenience, the relevant provisions of both the Act and Rules are set out hereinbelow:

“11-B 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.*

(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) or subsection (3), the application shall be treated as withdrawn by the applicant.*

Provided that -

- (i) *The applicant may, at any time after the 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.”*

Section 21 of the Patents Act: *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.*

“24B. Examination of application -

(1)(i) A request for examination under section 11-B 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 priority, if applicable, or forty eight months from the date of filing of the application;

(iii) the request for examination under sub-section (4) of section 11 B 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 forty 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.

... ..

(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). **(Prior to substitution w.e.f. 15.03.2024)***

In *Nippon Steel Corporation (Supra)* it has been held as follows:

“25. 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.

*28. This Court is of the view that the decisions in *Ferid Allani v. Union of India* and *Telefonaktiebolaget LM Ericsson (Publ) v. Union of India* were rendered in a different factual context and do not aid the Petitioner's submissions. The Petitioners there were in correspondence with the Office of the CoP in relation to the defects pointed out in their respective patent applications and had in fact made requests for oral*

*hearing. In those circumstances, this Court held that those Petitioners could not be held to have abandoned their claims for the purposes of section 21 of the Act. As far as the present case is concerned, the Petitioner missed the deadline of 9th February 2010 for filing an RFE. It realised the error much later and on 28th October 2010, filed an application for amending the priority date by which time the patent application itself ceased to exist. The decisions of the Commissioner of Patents and Trademarks, USA in **Re Katrapat, AG 6 U.S.P.Q. 2 D (BNA) 1863** and **Re Application of Ong, et al** (Application No. 11/754, 832) are also of no assistance since the patent law regime in our country is governed by the Act and Rules which in themselves constitute a complete code.”*

Similar views have been expressed in *Carlos Alberto Perez Lafuente (Supra)*.

On a plain reading of the above sections along with the relevant Rules, it appears that a structure and time bound mechanism for prosecution of a patent application has been laid down both under the Act and the Rules. A combined reading of section 21(1) read with Rule 24(B), (5) and (6) makes it clear that on failure to comply with the stipulated time, the application shall be deemed to be abandoned. Such prohibition is mandatory and not merely procedural nor technical.

In the above decisions, the Courts have repeatedly held that fixed timelines have to be strictly complied with and that the Court cannot provide relaxation to such time limits nor can read down the provision.

The facts of this case demonstrate that the subject application was filed as far back as on 6th March, 2020. A request for examination was filed on 18th April, 2020.

On 16th August, 2021, the First Examination Report was issued. On 16th February, 2022 the time frame of six months expired for putting an application for grant in order under section 21 of the Act. Thereafter, an additional period of three months in terms of Rule 24(B)(6) also expired. It was only on December 1, 2022 the petitioner had communicated with the Indian Patent Agent through its international patent attorney. On December 29, 2022, the application was deemed to have been abandoned under section 21(1) of the Act of 1970 read with the relevant Rules. Such extended period takes into account the fact of COVID-19.

On May 23, 2023, the petitioner for the first time communicated with the Controller by filing a representation. This was followed by a prior writ petition wherein this Court had directed the respondent to consider the representation of the petitioner. Ultimately, the impugned order came to be passed on June 24, 2024.

The relevant section read with the Rules clearly suggests that the time for putting an application in order for grant shall be within six months from the date of issuance of first statement of objections. A further extension of three months may be granted by the Controller upon an application being filed in the prescribed format upon payment of the requisite fees

prior to the expiry such period specified in (5).

In the present case, no application was filed to put the application in order for grant in terms of section 21 read with Rule 24(B) was filed by the petitioner within the stipulated period of six months nor was any extension application filed. These Rules are mandatory in nature and the prescribed mandatory timelines should be complied with in order to achieve the object of the Act. The scheme of the Act contemplates time bound steps being taken by applicants for grant of a patent at various stages.

In the instant case, it is evident that it was for the first time on May 23, 2023 from the admitted documents on record that a grievance letter was issued to the Controller. Any power exercised by the Writ Court is discretionary in nature. It is well settled that equity does not encourage the indolent. The provision for abandonment as contemplated under section 21 of the Act was triggered only after giving notice to the petitioner in terms of the Act and the Rules framed thereunder. There is nothing to suggest that the petitioner had acted within the prescribed mandatory time period or within the extended period. In such circumstances, the Writ Jurisdiction cannot be involved to circumvent the rigours of the Act.

The representation of the petitioner to the Controller dated May 23, 2023 is insufficient to explain the delay. So is the excuse of COVID-19. The petitioner has demonstrated an indolent and lackadaisical attitude in pursuing the proceedings. Equity aids the vigilant and not the indolent. This is the foundation of the doctrine of laches, whereby a party who has delayed cannot obtain equitable relief. In such view of the matter, there is no question of exercising any discretion in favour of the petitioner.

The decision cited on behalf of the petitioner in *European Union Vs. Union of India (Supra)* is distinguishable and inapposite. In the said decision, a Co-ordinate Bench of the High Court at Delhi had found that as a matter of fact there was no intention to abandon the application filed by the petitioner. In fact, it was found that there were sufficient steps taken by the petitioner to indicate that they were actively pursuing the application. In this background, the mistake of the Patents Act was held as a fact be excusable.

In view of the above, WPA-IPD 1 of 2024 stands dismissed without any order as to costs.

[Ravi Krishan Kapur, J.]

