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W.P.(IPD)No.2 of 2025

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 20.03.2025

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

W.P.(IPD)No.2 of 2025
and W.M.P.(IPD)No.1 of 2025

AMST – SYSTEMTECHNIK GMBH
Lamprechtshausener-Strasse 63,
5282 Ranshofen, Austria.

Represented by the Authorised Signatory
Mr.S.Anadan, De Penning & De Penning,
120, Velacherry Main Road, Guindy,
Chennai – 600 032.

... Petitioner

-VS-

1. Government of India,
Ministry of Commerce & Industry,
The Patent Office,
Intellectual Property Building,
S.M.Road, Near Antop Hill Post Office,
Antop Hill, Mumbai-400 037.

2. The Controller General of Patents & Designs,
Patent Office, Intellectual Property Building,
GST Road, Guindy,
Chennai-600 032.



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3. Deputy Controller of Patents & Designs,
Patent Office, Intellectual Property Building,
G.S.T. Road, Guindy, Chennai- 600 032.

.. Respondents

Prayer: Writ Petition (IPD) filed under Article 226 of the Constitution of India for issuance of Writ of Certiorarified Mandamus to call for the records relating to the order dated 21.12.2023 in Patent Application No.3022/CHENP/2011/2269 passed by the 3rd respondent and quash the same as illegal and consequently direct the respondents to take the petitioner's request for examination on record and proceed further with the Patent Application No. 3022/CHENP/2011 filed by the petitioner in accordance with law.

For Petitioner : Mr.S.Shivathanu Mohan
for M/s.S.Ramasubramaniam and Associates

For Respondents : Mr.K.Subbu Ranga Bharathi, CGSC

ORDER

By this writ petition, the petitioner assails order dated 21.12.2023 rejecting Patent Application No.3022/CHENP/2011 as withdrawn under



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Section 11-B(4) of the Patents Act, 1970 (the Patents Act).

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3. Learned counsel for the petitioner referred to the above sequence of dates and events. He submits that the request for examination is within



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the 48 month period, if reckoned from the date of filing the national phase application. If reckoned from the priority date specified in the PCT application, he submits that the request is beyond the 48 month limit prescribed in Rule 24B of the Patents Rules, 2003. By referring to a judgment of this Court in *Chandra Sekar v. The Controller of Patents and Designs and another*, order dated 04.11.2022 in W.P.Nos.12620 and 12621 of 2017 (*Chandra Sekar*), learned counsel submits that in substantially similar facts and circumstances, this Court concluded that the patent application cannot be treated as withdrawn. Learned counsel places reliance on paragraphs 14, 17 and 18 of the said judgment. He also relies on the judgment of this Court in *France Telecom v. Union of India and 2 others*, order dated 30.10.2024 in W.P.No.4958 of 2012 (*France Telecom*), where the judgment in *Chandra Sekar* was followed.

4. In reply, learned counsel for the respondents submits that Section 11-B(4) prescribes that the application for grant of patent shall be treated as withdrawn by such applicant, if the applicant does not make a request for examination within the period prescribed under the Rules. By referring to



Rule 24B, she submits that the prescribed period is 48 months from the priority date of the application or from the date of filing of the application, whichever is earlier. In this case, the priority date being 09.10.2008, she submits that the request for examination dated 12.09.2013 is beyond the prescribed period of 48 months from the priority date. Consequently, it is submitted that no interference is warranted.

5. Section 11-B of the Patents Act is as under:

“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.

(2) Omitted by the Patents (Amendment) Act, 2005

(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



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person does not make a request for examination of the application for a patent within the period as specified under sub-section (1) or sub-section (3), the application shall be treated as withdrawn by the applicant:

Provided that—

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

Sub-section (4) stipulates that the application for grant of patent shall be treated as withdrawn by the applicant, if the applicant or any other interested person does not make a request for examination of the application within the period prescribed in the Rules. The above provision has been amended on more than one occasion. The relevant rule prescribing the time limit is Rule 24B. Rule 24B earlier prescribed a time limit of 48 months from the date of priority of the application or from the date of filing of the



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application, whichever is earlier. By Patent (Amendment) Rules, 2024, the 48 month period was replaced by 31 months. Nevertheless, clause (vi) of sub-rule (1) of Rule 24B clarifies that the amendment would not apply to applications filed before the commencement of the Patent (Amendment) Rules, 2024. Therefore, as regards the application filed on 03.05.2011, the period of 48 months continues to apply.

6. The documents on record disclose that the national phase application was filed on 03.05.2011, and that no priority date was mentioned therein. If the 48 month period had been computed from the date of filing of the application, which is one of the factors specified in Rule 24B, the request for examination dated 12.09.2013 would have been within time. Rule 24B, however, prescribes that the priority date is the other factor and that the 48 month period should be computed from the earlier of the two dates. The priority date, in the present case, is 09.10.2008. If calculated from this date, the 48 month period had elapsed even before the request for examination was submitted.



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7. Section 11-B incorporates a legal fiction by which the application is treated as withdrawn by the applicant, if the request for examination is not made within the prescribed period. The settled legal position is that a legal fiction is intended to fulfil a specific purpose and that it should not be interpreted expansively so as to extend its application beyond such object and purpose.

8. The documents on record disclose that the petitioner/patent applicant requested for the examination of the application on 12.09.2013. This request did not elicit a response for about 9 years. After waiting for the FER for the said period, by communication dated 26.09.2022, the petitioner requested for the FER. Only thereafter, by e-mail of 17.08.2022, the Patent Office informed the petitioner that the e-mail was being forwarded to the examination unit. The impugned order was issued thereafter on 21.12.2023, i.e. about 15 months later. The present writ petition warrants consideration by keeping these facts and circumstances in mind.

9. As discussed earlier, the documents on record indicate that the



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petitioner/patent applicant intended to prosecute the patent application and not withdraw or abandon the same. It bears repetition that in about two years from the date of lodging the national phase application, the patent applicant requested for examination. The said request could have been responded to within a reasonable time by stating that such request was made beyond the 48 month period, if reckoned from the priority date. The respondents failed to respond until the petitioner reached out again about nine years later. In these facts and circumstances, I conclude that the petitioner did not intend to withdraw the application. Unless the impugned order is interfered with, the petitioner will not have the opportunity to prosecute the patent application. Therefore, the interest of justice warrants that such application be considered on merits. Reference may also be made to the earlier judgments of this Court in *Chandra Sekar* and *France Telecom*, wherein, in substantially similar facts and circumstances, this Court directed the Patent Office to consider the relevant patent application on merits.

10. For reasons set out above, impugned order dated 21.12.2023 is set



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aside and the Patent Office is directed to consider Patent Application No.3022/CHENP/2011 on merits. In view of the fact that about 16 years have elapsed from the priority date, the application shall be considered and disposed of within six months from the date of receipt of a copy of this order after providing a reasonable opportunity to the petitioner.

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

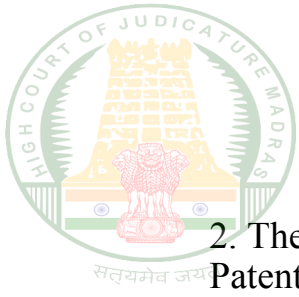
20.03.2025

Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No
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To

1. Government of India,
Ministry of Commerce & Industry,
The Patent Office,
Intellectual Property Building,
S.M.Road, Near Antop Hill Post Office,
Antop Hill, Mumbai-400 037.

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2. The Controller General of Patents & Designs,
Patent Office, Intellectual Property Building,
GST Road, Guindy,
Chennai-600 032.

SENTHILKUMAR RAMAMOORTHY,J

kj

3. Deputy Controller of Patents & Designs,
Patent Office, Intellectual Property Building,
G.S.T. Road, Guindy, Chennai- 600 032.

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