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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **W.P.(C)-IPD 16/2024**

MAGALDI POWER S.P.A

.....Petitioner

Through: Mr. Tarun Gandhi, Ms. Nanki Arneja
and Ms. Gaurvi Arora, Advocates.

versus

UNION OF INDIA & ORS.

.....Respondents

Through: Mr. R. Venkat Prabhat, SPC with Ms.
Kamna Behrani, Advocate along with Mr. Saroj
Kumar, Joint Controller through VC.

CORAM:

HON'BLE MS. JUSTICE JYOTI SINGH

ORDER

09.04.2026

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1. This writ petition is filed on behalf of the Petitioner under Articles 226 and 227 of the Constitution of India for quashing 'abandonment notice' issued by Respondent No. 3 in respect of Indian Patent Application bearing No. 202147008849 under Section 21(1) of the Patents Act, 1970 ('1970 Act') as also for a direction to revive the application and take on record response to examination report filed by the Petitioner and proceed with the application for grant of Patent.

2. To the extent necessary, the facts as pleaded in the writ petition are that Petitioner filed a patent application on 23.07.1990 via the Patent Cooperation Treaty route under International Application No. PCT/IB/2019/056272. On 03.03.2021, First Patent Agent filed the Indian Patent Application No. 202147008849 titled 'DEVICE, PLANT AND METHOD FOR THE STORAGE AND TRANSFER OF THERMAL



ENERGY OF SOLAR ORIGIN'. On 19.07.2022, the Foreign Associates instructed the First Patent Agent to file a request for examination. On 20.07.2022, Form-18 was filed and the same was notified to the Foreign Associates. On 01.09.2023, Foreign Associates followed up the matter with the First Patent Agent regarding issuance of FER followed by a reminder on 11.09.2023.

3. It is stated in the petition that First Patent Agent responded to the e-mails on 12.09.2023 informing that upon reviewing the online records of the patent application on IPOs website (inPASS), it was found that FER was issued by IPO on 16.11.2022, however, the same was not received by the First Patent Agent. It was also informed that the deadline for filing reply to the FER was 16.05.2023, which had lapsed, resulting in the Patent Application being deemed 'abandoned' under Section 21(1) of the 1970 Act. The Agent assured that he was pursuing the matter and taking steps for revival.

4. It is further stated that the Foreign Associates engaged the present Patent Agent on 20.10.2023 to follow up with Respondent No. 3 to ascertain the exact status of issuance of FER. On being engaged, the present Agent contacted the IT Department and Head of Respondent No. 3 on 22.11.2023 to discuss the peculiar situation, but there was no fruitful outcome. On 21.12.2023, present Agent submitted a reply to the FER along with relevant documents and on 01.02.2024 he filed a petition under Rule 137 of the Patent Rules, 2003 ('Rules 2003') along with the requisite fee. *Albeit* Respondent No. 3 was empowered to revive the Patent Application, but no action was taken.

5. Learned counsel for the Petitioner submits that Petitioner had no



intention to abandon the Patent Application and was seriously prosecuting the same so that the invention could be patented. Being a foreign entity, Petitioner had engaged an Indian Patent Agent to prosecute the application and was depending on the inputs given by him. Petitioner was never informed that FER was issued and there was a deadline to file a reply or even the fact that the application was deemed abandoned and closed. Petitioner is a company incorporated in Italy and even the Foreign Associates are based out of Italy and both were unfamiliar with the Indian Patent Law and procedures of IPO. Therefore, in good faith, Petitioner expected the First Patent Agent to take appropriate steps towards grant of Patent and keep the Foreign Associates informed of all the developments including issuance of FER, more particularly, when there was a deadline to file a reply.

6. It is further urged that for the purpose of protecting the invention and obtaining a patent, Petitioner engaged Foreign Associates to coordinate and manage the Patent Applications worldwide and Foreign Associates have indeed taken suitable steps and liaised with Patent Agents globally to secure patents for the Petitioner. With the same level of understanding and trust, Foreign Associates engaged the First Patent Agent to assist the Petitioner in India and if the Agent did not genuinely get information of issuance of FER or was negligent, assuming for the sake of argument, Petitioner should not suffer for his fault. In fact, as a matter of practice, Respondent No. 3 sends a courtesy correspondence a month prior to the deadline as a reminder to the Patent Agent on record of the due date to ensure that response to FER is filed in time. In the instant case, First Patent Agent informed the Petitioner that courtesy communication was never



received from the IPO, apart from taking the consistent stand that he was not aware of the issuance of FER.

7. It is further submitted that Petitioner was diligently prosecuting the application. Initially, applications were filed in several foreign jurisdiction followed by National Phase Entry in India within the prescribed period. Petitioner responded to all office objections/actions in all jurisdictions and also filed the Request for Examination in India within the prescribed period and thereafter continuously followed up with the Foreign Associates. After becoming aware of the abandonment, immediate steps were taken to engage the present Patent Agent and file a reply to the FER along with a petition under Rule 137. It is thus urged that looking to the facts and circumstances of the case, which were beyond the control of the Petitioner, a direction be issued to Respondent No. 3 to revive the Patent Application and proceed further after accepting the reply to the FER.

8. Learned SPC for the Respondents submits that FER was issued in the present matter on 16.11.2022 but due to callous attitude of the Petitioner, reply was not filed within the stipulated period and hence, the application was rightly treated as deemed abandoned under Section 21(1) of 1970 Act. It is urged that the First Patent Agent was informed through an e-mail that FER was issued and hence, Respondents cannot be blamed for inaction. Respondent No. 2 does not have power to extend the time for filing reply to the FER and this Court in ***European Union Represented by the European Commission v. Union of India and Others, 2022 SCC OnLine Del 1793*** and ***Ferid Allani v. Union of India and Others, 2008 SCC OnLine Del 1756***, has held that delay in filing reply to FER can only be condoned when negligence cannot be attributed to the Petitioner and in the present case, the



delay in filing the reply is entirely attributable to the Petitioner and his Patent Agents. As per Section 21(1) read with Section 80 of the 1970 Act, Controller has the discretionary power to grant hearing to any party provided the party makes a request at least 10 days in advance of the time limit specified, which was not made by the Petitioner and in any event, Legislative mandate cannot be violated.

9. Heard counsels for the parties and examined their submissions.

10. Indisputably, Petitioner did not file response to the FER within the time prescribed and the patent application was deemed abandoned under Section 21(1) of the 1970 Act. The main plank of the argument of the Petitioner is that it had engaged Foreign Associates to coordinate and manage the patent applications worldwide including in India, who in turn in good faith engaged First Patent Agent for prosecuting the instant patent application in India. Being based in Italy, Petitioner was completely banking upon the First Patent Agent to take steps towards filing response to the FER and further follow up of the application and had no idea that the FER was issued on 16.11.2022 and/or there was a deadline in filing response to the FER. In fact, Petitioner was also unaware that the patent application had been deemed abandoned. It is also asserted by the Petitioner that the First Patent Agent consistently maintained that he was unaware that FER was issued. Assuming for the sake of argument that the First Patent Agent was aware of the issuance of the FER and was negligent in fulfilling his obligations, Petitioner should not suffer.

11. In *European Union (supra)*, patent applications were restored by this Court after finding that the negligence was of the Patent Agent and Petitioner could not be blamed. In *PNB Vesper Life Science Pvt. Ltd.*,



Represented by its Director Mr. P.N. Balaram v. Controller General of Patents, Designs & Trademarks, 2022 SCC OnLine Mad 3190, it was held that if there was nothing on record which indicated that Petitioner was wilfully negligent, benefit of doubt must be given. In the present case, Petitioner has satisfied this Court that it had taken all necessary steps to prosecute the patent application by engaging Foreign Associates, who in turn engaged the First Patent Agent to prosecute the application. Initially, the National Phase Entry was filed in India within the prescribed period and even the Request for Examination was filed within time. Petitioner has prosecuted corresponding applications globally and has secured patents in several jurisdictions such as Australia, Argentina, South Africa etc., which is a pointer to the fact that Petitioner has no intent of deliberately abandoning the application. *Albeit* there is a controversy with regard to whether FER was sent to the First Patent Agent, inasmuch as while Respondents contend that email was sent duly informing the Agent, the latter claims otherwise. Be that as it may, even assuming that the First Patent Agent was aware of the issuance of FER, Petitioner should not suffer *sans* any contributory negligence of the Petitioner. The conduct of the Petitioner in pursuing the applications in all other jurisdictions as also the swiftness with which corrective measures were taken in respect of the present application, reflects that Petitioner was neither negligent nor intended to abandon the application. In ***Bry-Air Prokon Sagl & Ors. v. Union of India & Anr. (W.P.(C)-IPD 25/2022)***, decided on 17.10.2022, this Court held that: “*It is a settled position of law that errors/negligence on part of the patent agent without any contributory negligence on the part of the Applicant, has been liberally considered by the Courts, as the consequences of a patent application being*



abandoned or the lapsing of a patent due to non-deposit of renewal fee are very serious, where the applicant loses his right of claiming exclusivity to an invention.”.

12. Accordingly, for the aforesaid reasons, this petition is partially allowed, quashing the impugned communication deeming the patent application as abandoned. Patent application bearing no. 202147008849 is restored to its original position. Respondent No. 3 shall take the response to the FER on record and proceed to examine the application in accordance with law.

13. Writ petition stands disposed of in the aforesaid terms with no expression on the merits of the case.

JYOTI SINGH, J

APRIL 9, 2026
S.Sharma