2024:MHC:2118

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated: 04.04.2024

CORAM

THE HONOURABLE **DR. JUSTICE ANITA SUMANTH**

CMA(PT).No.17 of 2024

R.Vishnu Prasad ... Appellant

Vs

The Controller of Patents,
The Patent Office,
Intellectual Property Office Building,
GST Road, Guindy,
Chennai – 600 032. ... Respondent

PRAYER: Civil Miscellaneous Appeal filed under Rule 7 of the Madras High Court Intellectual Property Rights Division Rules, 2022 to direct the learned Controller of Patents to reinstate the status of the Indian Patent Application No.202144035408 of the Appellant from deemed to be abandoned and to take into record the Response to FER filed by the Appellant by condoning the delay of four days.

For Appellant : Mr.Ramesh Ganapathy
for Mr.G.Ramesh

For Respondent : Mr.A.Sakthivel
Senior Panel Counsel

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O R D E R

The appellant claims to be the inventor in an invention entitled *'system and method of converting waste materials into re-usable oil products*' (in short, 'subject patent').

2.An application had been filed seeking grant of the subject patent on 05.08.2021. The processing of the patent was entrusted to a patent attorney. A request had been made on 28.03.2022 in Form–18 for examination along with requisite fee and publication was effected on 06.01.2023. A First Examination Report (in short, 'FER') had been issued by the respondent on 15.03.2023. The report had, in terms of the applicable statutory provisions under the Patents Act, 1970 (in short, 'Act'), granted a period of six months from date of issuance of the FER for the appellant to file a response thereto. The receipt of the FER is not in dispute.

3.The appellant filed a response to the FER, albeit with a delay of four days, on 19.09.2023. An order has come to be passed on 15.09.2023, to the effect that the subject patent is deemed to have been abandoned under Section 21(1) of the Act. The only reason assigned for deeming abandonment is that the petitioner's reply had not been filed within time. It is as against the aforesaid order that the appellant is before this Court.

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4.Mr.Ramesh Ganapathy, learned counsel for Mr.G.Ramesh, learned counsel on record for the appellant would point out that the delay is hardly worthy of such a grave consequence, particularly as the provisions of Section 137 vest in the respondent sufficient power to condone any irregularity in procedure.

5.The appellant has, in fact, made an application before the respondent on 19.09.2023 accompanied by the objections which were filed on that date, seeking condonation of the delay of four days. The delay is attributed to clerical error. While the last date for submission of objection was *15.09.2023*, the date was noted erroneously as *15.10.2023,* leading to the delay.

6.Reliance is placed on a decision of the Delhi High Court in *Europeon Union represented by the Europeon Commission v. Union of India and others* [2022 SCC Online Delhi 1793].

7.Mr.A.Sakthivel, learned Senior Panel Counsel accepts notice for the respondents and does not, very seriously, object to the condonation of delay.

8.Heard learned counsel.

9.The provisions of Section 21 of the Act states that an application for patent shall be deemed to have been abandoned unless, within such period as

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may be required, the applicant has complied with all statutory requirements as stipulated thereunder.

10.The delay in the present case has been occasioned by breach of the timeline as set out under Rule 24B of the Patents Rules, 2003 (in short, 'Rules') which sets out the procedure for examination of the application. Rule 24B(4) provides for a reply to be filed by the patentee to the FER. Sub Rule 5 grants a period of six months from the date on which the FER is issued to the patentee, to either file a reply or comply with the requirements under the FER.

11.Sub Rule 6 provides for a further extension of three months, over and above the six months originally granted, if a request is made in Form-4 for such extension along with prescribed fee prior to the expiry of the six months.

12.In the present case, six months expires on 15.09.2023 and admittedly the patentee has neither filed an application prior thereto seeking extension of time, or a reply to FER. However, Rule 137 which provides for the general powers of the Controller, vests sufficient power in that authority to amend and correct any irregularity in procedure, which in the opinion of the Controller may be obviated without detriment to the interests of any person and upon such terms as he may direct.

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13.The application under Rule 137 has been made on 19.09.2023, along with the reply to the FER. The patent application has been published on 06.01.2023 and does not indicate any application of mind whatsoever to the application under Rule 137 and the reasons set out thereunder.

14.Normally in matters involving condonation of delay, the Court would not intervene as discretion is vested with the authority concerned. The extent of intervention would be limited to an examination of whether such discretion has been exercised in an appropriate manner. However, in the present case seeing as (i) the delay is only four days, (ii) the authority has not dealt with the application under Rule 137 at all, and (iii) finding the reasons for delay acceptable, the delay is condoned and the application restored back to the file of the respondent/Controller to be dealt with in accordance with law.

15.The respondent will issue notices in accordance with the procedure as stipulated under the Rules and conclude the matter in accordance with law.

16.This Civil Miscellaneous Petition is allowed. No costs.

04.04.2024

Index : Yes
Speaking order
Neutral Citation:Yes
vs

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Dr.ANITA SUMANTH, J.

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To

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