

**IN THE HIGH COURT OF DELHI AT NEW DELHI****W.P. (C) 801 of 2011**

NIPPON STEEL CORPORATION Petitioner
Through: Mr. Sudhir Chandra, Senior Advocate with
Mr. Pravin Anand, Ms. Tusha Malhotra and
Mr. Aditya Gupta, Advocates

versus

UNION OF INDIA Respondent
Through: Mr. Sunil Kumar with
Mr. Rajiv Ranjan Mishra, Advocate.

CORAM: JUSTICE S. MURALIDHAR

- | | |
|---|-----|
| 1. Whether Reporters of local papers may be
allowed to see the judgment? | No |
| 2. To be referred to the Reporter or not? | Yes |
| 3. Whether the judgment should be reported in Digest? | Yes |

ORDER
08.02.2011

C.M. APPL No. 1695/2011

Exemption allowed subject to all just exceptions.

The application is disposed of.

WP (Civil) No. 801/2011 & CM APPL No. 1694/2011

1. An interesting question of law involving the interpretation of Section 11-B
(1) and (4) of the Patents Act, 1970 ('Act') and Rule 24 B of the Patents
Rules 2003 ('Rules') arises in this writ petition.



notice for the Respondent, this petition has been heard finally.

3. The Petitioner is a Corporation organized under the laws of Japan. It is stated that the Petitioner has the world's top class technology in the field of medium-high grade steel where high workability, rust prevention performance and weld strength are required. The Petitioner is engaged in the steel industry and is involved in intensive research and development in relation to it. The Petitioner is also involved in comprehensive engineering, from the construction of steelmaking plants and plants related to environment and energy, to the construction of long bridges, buildings etc.

4. On 9th February 2007, the Petitioner filed an application being PCT/JP2007/052796 under the Patent Cooperative Treaty ('PCT') that designates India as a member. The said application claimed priority date of 9th February 2006 from a Japanese Patent application No. 2006-031911. The Petitioner filed an Indian National Phase Patent application under No. 6123/DELNP/2008 in respect of an invention entitled "TINNED STEEL SHEET EXCELLENT IN CORROSION RESISTANCE" on 11th July 2008 within the time period of 31 months from the priority date as prescribed by Rule 20 (4) (i) of the Rules as amended by the Patents (Amendment) Rules, 2006.

5. Under Rule 24-B of the Rules, as amended by the Patents (Amendment) Rules 2006, a Request for Examination ('RFE') has to be made in terms of



earlier. Since the priority date in respect of the Petitioner's patent application was 9th February 2006, being the date of filing of the Japanese Patent application, the RFE had to be made on or before 9th February 2010.

6. It is stated that on 22nd August 2008, the Petitioner made a request for amendment in the patent application in terms of Section 57 of the Act to correct certain typographical errors that had crept into the complete specification. The Petitioner states that the said request for amendment was made in Form No. 13. It is further stated that owing to visual similarity of the digits '3' and '8', a docketing error occurred in the office of the Petitioner's attorney, Anand & Anand. It is stated that the person in charge of docketing in the Petitioner's attorney's office, by mistake, entered the date for filing request for amendment (Form 13) as the date of filing of the RFE (Form 18). Due to this accidental docketing error in the computer maintained by the Docketing-in-charge Mr. Tony Mon George at the office of the Petitioner's attorney, the deadline for filing the RFE in India was inadvertently missed.

7. It is stated that on 25th October 2010 the Petitioner asked its attorneys for an update on the status of the patent application. It is stated that it was only then that the Petitioner's attorneys realized, on 26th October 2010, that the deadline for filing the RFE had been inadvertently missed. Enquiries were made with the Docketing in-charge on 27th October 2010. Steps were immediately taken on 28th October 2010 to rectify the said error by filing an application for amendment of the priority date of the subject application under



priority date to the international filing date of the PCT application i.

February 2007. The idea was that by making this amendment, the deadline for filing the RFE would stand extended to four years (48 months) from 9th February 2007 and would expire on 9th February 2011.

8. Thereafter, on 1st November 2010, the Petitioner's attorney filed a RFE in Form 18. It is stated that the said application was returned due to "the 'RIGID' configuration of the software module at the Indian Patent Office" which did not accept the said RFE because the amendment to the priority date had not been modified in the said module.

9. The Petitioner's attorney filed another RFE application on 18th January 2011 on the presumption that the amendment to the priority date would have been carried out in the Office of the Controller of Patents (CoP) since neither the Petitioner nor its counsel was informed of its refusal. However, the request for amendment was not recorded in the software module and, therefore, the RFE was once again returned.

10. On 1st February 2011, the Assistant Controller of Patents & Designs (ACoP) sent the following letter to the Petitioner's attorneys:

"To
M/s. Anand & Anand,
B-41, Nizamuddin East,
New Delhi – 110 013.

Sub: Patent application No. 6123/Delnp/2008-Request for amendments in the priority date.



this office on 29th October 2010 submitting therewith a request on form 13 requesting to change the priority date of Japanese application No. 2006-031911 dated 9th February 2006 to International filing date 9th February 2007 of PCT/JP/2007/052796 as amendments under Section 57 (5) of the Act.

In this connection, it may noted that your request on Form 13 to change the priority date of Japanese Application (9th February 2006) to International filing date (9th February 2007) has become time barred since, the said application is deemed to have been withdrawn under Section 11 B (4) of the Act due to non-filing of the request for examination within the prescribed period which was due on 9th February 2010 and your request on form 13 was filed on 29th October 2010.

Accordingly, your documents along with cheque (No. 149467 for Rs. 10,000/-) returned herewith.”

11. On 1st February 2011 the Petitioner’s attorney wrote to the CoP giving the details of the patent application and enclosed an affidavit dated 5th January 2011 of Mr. Toni Mon George explaining the ‘docketing error’ that led to the deadline for filing the RFE being missed. In response thereto the Deputy Controller of Patents and Designs (DCoP) sent the following e-mail to the Petitioner’s attorney on 2nd February 2011:

“This office has already replied your letter yesterday by letter. In this mail you are stating about the facts if the form 13 would have been allowed. Since the application became withdrawn on 9th February 2010 the consideration of form 13 has become



declaration is available on WIPO PCT site and also PCT hand book. Please examine your PCT deadlines carefully in future to avoid such problems.”

12. Thereafter, when the Petitioner’s request to the CoP to allow the amendment did not succeed, the present writ petition was filed seeking *inter alia* a writ of certiorari to quash the decisions dated 1st and 2nd February 2011 issued by the office of the DCoP which declared the Petitioner’s application as deemed to be withdrawn; a writ of mandamus directing the Office of CoP to take on record the request made in Form 13 on 28th October 2010 for amendment regarding change in priority date to 9th February 2007; a direction to the CoP to take on record the RFE filed in Form 18 on 1st November 2010 and issue an examination report on the subject application in accordance with the Act and Rules.

13. Mr. Sudhir Chandra, learned Senior counsel appearing for the Petitioner referred to the various provisions of the Act and Rules and submitted that a hyper-technical view was taken by the Office of the CoP on the time-limits set out in Section 11-B (1) of the Act read with Rule 24-B of the Rules for filing an RFE. He submitted that the CoP had committed a serious error in treating the patent application of the Petitioner as deemed to have been withdrawn on 11th February 2010 in terms of Section 11-B (4) of the Act. According to him, in terms of Section 57 (5) of the Act there was no limitation for filing a request for amendment of the priority date of the patent. The Petitioner filed such a request on 22nd August 2008. Once the amendment



respect of an application for grant of a patent that was 'deemed to be withdrawn' in terms of Section 11-B (4) of the Act. Once the amendment was allowed at any time thereafter it would revive the application.

14. Mr. Chandra next submitted that the reason for the Petitioner failing to file RFE on or before 9th February 2010 was bonafide. The computer system of the Petitioner's attorney did not show any warning as regards the expiry of the deadline for filing the RFE since it had wrongly docked the application for amendment as an RFE. It is submitted that the CoP ought to have accepted the explanation offered in the affidavit of Mr. Tony Mon George. Relying extensively on the decision of the Supreme Court in ***Kailash v. Nanhku (2005) 4 SCC 480*** Mr. Chandra argued that rules of procedure were handmaids of justice and could not be rigidly applied so as to defeat justice. He repeatedly urged that only where substantive rights of parties would be affected, the time limits set by a statute had to be rigidly applied. Since in this case no prejudice would be caused to the office of the CoP there should have been no difficulty in allowing the Petitioner's request for amendment of the priority date to 9th February 2007 which, although to the Petitioner's detriment, would in turn have shifted the deadline for the filing of the RFE to 9th February 2011. On the other hand, the Petitioner would be subject to tremendous loss and hardship in the event the amendment was not allowed since its application for grant of patent in India would not be able to be revived thereafter.



the Act if an RFE was not filed within 48 months of the priority date in 1 of Rule 24-B of the Rules. Those provisions, according to him, were only directory. He submits that even in a worse case of deemed ‘abandonment’ in terms of Section 21 of the Act, this Court had in *Ferid Allani v. Union of India 2008 (37) PTC 448 (Delhi)* and *Telefonaktiebolaget LM Ericsson (PUBL) v. Union of India 168 (2010) DLT 461* adopted a realistic and practical approach and accepted the explanation offered by the Petitioners as to why their respective patent applications should not be so treated. According to him, the facts of the present case were far better than the facts of those cases.

16. Fourthly, developing on the above points, Mr. Chandra submitted that where no substantive right of anyone was going to be affected by extending the time limit for doing an act, the CoP ought to take liberal view and condone the delay in the interests of justice. He referred to Rule 137 of the Rules. The abandonment of a claim would amount to giving up of the claim, which was not true in the present case. It is submitted that there was no basis for the CoP to contend that there was no patent application existing as on 9th February 2010 in respect of which the amendment could be allowed. According to Mr. Chandra the patent application was “physically there” in the Office of the CoP, and could be amended at any time.

17. Mr. Sunil Kumar, learned counsel for the Respondent on the other hand supported the stand of the CoP by pointing out that once the deadline of 9th



permitting the Petitioner thereafter to amend a non-existing patent applica-

In any event, the amendment sought on 22nd August 2008 was not with reference to the priority date and even if that amendment had been allowed, it could not have saved the patent application. He submitted that it is not for the Court to rewrite the time limits set out in the Act and the Rules.

18. The above submissions have been considered. It is necessary to examine the scheme of Section 11-B of the Act as amended by the Patents (Amendment) Act 2005 and the corresponding Rule 24-B of the Rules as amended by the Patents (Amendment) Rules 2006 which read 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.

(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 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



(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."

19. The relevant portion of Rule 24-B of the Rules reads as under:

“24-B 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 11 B 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.”

20. It is not in dispute that in terms of the above provisions, given the fact that



nothing in either Section 11-B of the Act or Rule 24-B of the Rules that the power to CoP to condone the delay in the filing of the RFE.

21. Mr. Chandra referred to Rule 137 of the Rules to urge that CoP does have powers in that regard. Rule 137 reads as under:

“137. Powers of Controller generally – Any document for the amendment of which no special provision is made in the Act may be amended and any irregularity in procedure which in the opinion of the Controller may be obviated without detriment to the interests of any person; may be corrected if the Controller thinks fit and upon such terms as he may direct.”

22. This Court is unable to agree with the above submission of Mr. Chandra. Rule 137 only applies to the amendment of a document for which there is no special provision in the Act. Section 57 (5) of the Act does provide for amending the priority date. However, the Petitioner’s request for amending the priority date is with a view to indirectly get the time for filing the RFE extended. In the considered view of this Court, the power under Rule 137 cannot be invoked by the Office of the CoP in the circumstances of the present case to permit an amendment to a patent application that has already been ‘withdrawn’ by operation of Section 11-B (4) of the Act.

23. Section 57 of the Act deals with amendment of application and specification or any document relating thereto before the CoP. Section 57 (5), which permits amendment to the priority date, reads as under:



24. While an applicant can seek to amend even the priority date of a patent application in terms of Section 57 (5) of the Act, such request for amendment can be made only in relation to an application that exists in law. To recapitulate the facts in the present case, the request for amendment filed by the Petitioner in Form 13 on 22nd August 2008 was not for amending the priority date. It was only for correcting typographical errors. It was wrongly docked as Form 18 in the computer of the Petitioner's attorney. As far as the Office of the CoP was concerned, that application would have been treated as one under Form 13. Going by the affidavit of Mr. Tony Mon George, the Petitioner's attorney knew that it had, on 22nd August 2008, only filed an application for amendment of typographical errors. Even if that application had been allowed, the priority date of the application would have remained as 9th February 2006. Therefore, the deadline for filing the RFE would have continued to be 9th February 2010. Since, in any event, no RFE was filed before the expiry of the deadline in terms of Section 11-B (4) of the Act, the patent application stood withdrawn after 9th February 2010.

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



of the Act, are merely ‘directory’ and not mandatory. In fact, the words

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.

26. No comparison can be drawn between Order VIII Rule 1 of the Code of Civil Procedure, 1908 (‘CPC’) which prescribes the time-limit for filing a written statement in a suit and the provisions of the Act and the Rules which prescribe time limits for steps at various stages of a patent application. Even in ***Kailash v. Nanhku***, the Supreme Court cautioned that power to condone the delay in filing a written statement beyond the statutory outer limit of 90 days had to be exercised very sparingly. In the later decisions in ***R.N. Jadi & Brothers v. Subhashchandra (2007) 6 SCC 420*** and ***Mohammed Yusuf v. Faij Mohammad (2009) 3 SCC 513*** the Supreme Court has further clarified this position.

27. Merely because there is no time limit prescribed for filing an application for amendment of the priority date, it does not mean that such application can be filed even after a patent application ceases to exist in law. Once an application is deemed to have been withdrawn by an applicant in terms of Section 11-B (4) of the Act, the CoP cannot entertain an application for amending any portion of such application. It is not possible to accept the submission of the learned Senior counsel for the Petitioner that the CoP is



back to the date of the filing of the application and thereby revive the application. This submission is contrary to the scheme of the Act and Rules. Also, in view of what has been stated by the DCoP in the email of 2nd February 2011 there is a doubt whether an applicant can seek to amend the priority date at its sweet will to any date of its choice. However, for the purposes of the present case, it is beyond doubt that the CoP could not have, after the deemed withdrawal of the Petitioner's patent application on 9th February 2010, permitted it to amend the priority date of such application.

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



29. For the aforementioned reasons, this Court finds no error whatsoever in the impugned decisions of the CoP to decline the Petitioner's request for amendment of the priority date. The writ petition is without merit and it is dismissed as such. The pending application also stands dismissed.

S. MURALIDHAR, J.

FEBRUARY 08, 2011

rk