

*[Abstract prepared by the PCT Legal Division (PCT-2012-0001)]*

Case Name:

NOKIA CORPORATION V. DEPUTY CONTROLLER OF PATENTS AND DESIGNS

Jurisdiction:

MADRAS HIGH COURT (INDIA)

Abstract:

The Madras High Court has held that a request for condonation of delay and extension of time filed within one month of the expiry of the timeline for filing a PCT National Phase application must be considered by the Indian Patent Office and decided on merits. Nokia's PCT application, claiming priority from a former US application, was filed under the National Phase in India, one week after the 31 month period for national phase entry had expired. The Indian Patent Office refused to take the application on record. The Judge decided that the Indian Patent Office must decide about the petition for condonation of delay on merit by taking into consideration the facts and circumstances of each case.

PCT Legal References:

- Article 8
- Article 22(1)
- Article 48(2)(b)
- Rule 82*bis*.2

Source: [http://judis.nic.in/judis\\_chennai/qrydisp.aspx?filename=29490](http://judis.nic.in/judis_chennai/qrydisp.aspx?filename=29490)

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 24.01.2011

CORAM:

THE HONOURABLE MR.JUSTICE VINOD K.SHARMA

W.P. No.2057 of 2010 and M.P.No.1 of 2010

Nokia Corporation,

A corporation organized and existing under  
the Laws of Finland,

Keilalahdentie 4, FI-02150,

Espoo Finland,

Rep. by its Power Agent Col.J.K.Sharma

.. Petitioner.

vs.

Deputy Controller of Patents and Designs,

Patent Office,

"IPR Building", G.S.T.Road,

Guindy, Chennai T 600 032.

.. Respondent.

Writ petition is filed under Article 226 of Constitution of India for the issuance of a Writ of Certiorarified Mandamus, calling for the records pertaining to the order of the respondent dated 19.11.2009 in the proposed National Phase Application bearing No.5322/CHENP/2009 and to quash the same and to direct the respondent to take on record and decide in accordance with law, National Phase Application filed by the petitioner.

For Petitioner : Mr.P.S.Raman  
Learned Senior Counsel  
For Mr.Pravin Anand

For Respondent : Mr.M.Ravindran  
Addl. Solicitor General of India

\*\*\*\*\*

O R D E R

The petitioner prays for a writ in the nature of Certiorari to quash the order dated 19.11.2009, passed by the Deputy Controller of Patents and Designs, under Rules 137 and 138 of the Patents Rules, 2003.

2. The facts noted in the impugned order show that Shri. Praveen Anand of M/s. Anand & Anand filed a National Phase application on behalf of their client M/s. Nokia Corporation for the invention titled "Multiple Application Handling" on 18.08.2009.

3. On scrutiny, it was found that PCT National Phase application was for claiming a priority from an earlier US application 11/622, 147 dated 11.01.2007.

4. The Deputy Controller of Patents and Designs held that in accordance with Rule 20(3) of the Patents Rules 2003, an application in respect of an international application, designating India, was required to be filed with prescribed fee within time limit, i.e. 31 months from the date of priority, as envisaged under Article 2(xi) of the PCT and Rule 20(4) of Indian Patents Rules.

5. The Rules 20, 22 and 138, with which we are concerned in this writ petition, are reproduced below for ready reference:  
"20. International applications designating or designating and electing India-

(1) An application corresponding to an international application under the Patent Cooperation Treaty under Section 7(1-A) may be made in Form 1-A.

(2) The Patent Office shall not commence processing of an application filed corresponding to international application designating India before the expiration of the time limit prescribed under sub-rule (4).

(3) An applicant in respect of an international application designating India shall, before the time limit prescribed in sub-rule (4),

(a) pay the prescribed national fee and other fees to the patent office in the manner prescribed under these rules and under the regulations made under the Treaty;

(b) and where the international application was either not filed or has not been published in English, file with the patent office, a translation of the application in English, duly verified by the applicant or the person duly authorised by him that the contents thereof are correct and complete.

Sub-Rule 4 (i) The time limit referred to in sub-rule (2) shall be thirty one months from the priority date as referred to in Article 2(xi);

(ii) Notwithstanding anything contained in clause (i), the patent office may, on the express request filed in Form 18 along with the fee specified in First Schedule, process or examine the application at any time before thirty one months.

(5) The translation of the international application referred to in sub-rule (3) shall include a translation in English of,

- (i) the description;
- (ii) the claims as filed;
- (iii) any text matter of the drawings;
- (iv) the abstract; and

(v) in case the applicant has not elected India and if the claims have been amended under Article 19, then the amended claims together with any statement filed under the said Article;

(vi) in case the applicant has elected India and any amendments to the description, the claims and text matter of the drawings that are annexed to the international preliminary examination report.

(6) If the applicant fails to file a translation of the amended claims and annexures referred to in sub-rule (5), even after invitation from the appropriate office to do so, within a time limit as may be fixed by that office having regard to the time left for meeting the requirements, the amended claims and annexures shall be disregarded in the course of further processing the application by the appropriate office.

(7) The applicant in respect of an international application designating India shall when complying with sub rule (3), preferably use Forms set out in the Second Schedule before the appropriate office as designated office.

22. Effect of non-compliance with certain requirements:

An international application designating India shall be deemed to be withdrawn if the applicant does not comply with the requirements of Rule 20.

138. Power to extend time prescribed:

(1) Save as otherwise provided in the rules 24, 55 and 80(1-A0), the time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct.

(2) Any request for extension of time made under these rules shall be made before expiry of prescribed period."

6. By interpreting these rules, the Deputy Controller of Patents and Designs, concluded that Rule 22 of the Patents Rules 2003, restricts the filing of a National Phase application, after the prescribed time, as Rule 22 stipulates that on expiry of the time under Rule 20, it would be deemed to have been withdrawn, as it would mean that the application does not comply with requirement of Rule 20.

7. Admittedly, in the case of the petitioner, date for the application to enter National Phase expired on 11.08.2009, i.e. on expiry of 31 months, as stipulated in Rule 20. The office, accordingly, returned the filed documents to M/s. Anand & Anand on 21.08.2009.

8. Admitted position is that the petitioner, thereafter, filed an application through online on 10.09.2009, which was registered as application No.5322/CHENP/2009.

9. The advantage was taken by the petitioner, as online filing procedure was introduced by the department. Along with the application No.5322/CHENP/2009, the petitioner also filed a petition under Rule 137 and 138 for condoning the delay in filing National Phase application, and also made a request for personal hearing.

10. In pursuance to the request, made by the petitioner, an opportunity of hearing was given to him. The petitioner also filed a written submission.

11. The Deputy Controller of Patents and Designs, keeping in view of the admissions made in the application that PCT International application was moved on 11th day of August 2009, held that it could not be entertained.

12. The learned Deputy Controller of Patents and Designs held that the petitioner admitted in the representation, that his client had instructed the petitioner in time, but, due to drafting error in the computer, there was delay for filing the application.

13. The contention of the petitioner to challenge the impugned order is that the time is provided under the Rules, not under the Act. Therefore, National Phase application could be filed within 31 months, along with the request for one month extension of time, under Rule 138, if necessary petition under Rule 137 for condonation of irregularity was filed before expiry of prescribed period of one month.

14. The other contention raised by the petitioner was that under Rules 137 and 138, the discretionary power is given to the Controller to condone the delay for one month after the time prescribed to do substantial justice, to the parties by deciding the application on merits.

15. The learned Deputy Controller rejected the contentions of the petitioner by holding that Article 48 and Rule 82 of PCT Regulations gives immunity only in case of delay in mail service or for unavoidable loss or interruption in mail whereas remaining provisions in Article 48 leave it to the discretion of the National offices to decide on merits.

16. The learned Deputy Controller in view of Article 48 and Rule 82 of PCT regulations, interpreted the Patents rule, to conclude that the Controller could only condone the delay in case of delay in mail service in view of Rule 6(5) of the Patents Rules 2003, therefore, delay on account of docketing error could not be condoned.

17. This finding of the Deputy Controller cannot be sustained. Article 48 and Rule 82 of PCT Regulations could be binding only on its adoption by enactment in India, under Article 253 of the Constitution of India.

18. These could be applied in absence of any rule to the contrary, in the statute or rules. In the case in hand, statutory rules have been framed, therefore, Deputy Controller was to decide the case as per rules and could not have rejected the application by applying Article 48 and Rule 82 of PCT Regulations.

19. The learned Deputy Controller also wrongly applied rule 6(5) of the Patents Rules, which operate on different field. Rule 138 of the rules gives power to extend the time by one month, whereas rule 6(5) deals with acceptance of application by giving benefit of mail delay. Under rule 6(5), no order is required to be passed, whereas under rule 138, the Controller exercises quasi judicial power to extend time by taking into consideration the facts set out in the application.

20. The learned Deputy Controller in the circumstances wrongly held that it would be wrong precedence to condone delay under Rule 137 and 138, as it will be detrimental to the public at large.

21. The reason for coming to this conclusion was that the learned Deputy Controller was not empowered to contravene the provisions of the Act or the Rules. This finding besides

being wrong is outcome of misinterpretation of rule 138, which gives power to extend the time by one month on such terms as directed.

22. Learned Senior Counsel for the petitioner, in support of the writ petition, vehemently contended, that the Deputy Controller wrongly read the proviso to rule 138 by ignoring the settled law, that proviso is to be read harmonious with the Act and the rules, to make it workable and to overcome any procedural or clerical overights.

23. The application, moved within a period of one month after expiry of stipulated time under Rule 20, was required to be considered on merit and by recording a finding as to whether the period was liable to be extended in terms of Rule 138. The application under Rules 137 and 138 could not be rejected, by holding that the Controller did not have power to extend time, on application moved after expiry of time prescribed under rule 20.

24. The object of Rule 138 is to give power to Controller to extend the time by another one month, if sufficient cause is shown by the applicant.

25. Learned Additional Solicitor General of India, on the other hand, by referring to Rule 22, contended that on expiry of time under Rule 20, the application itself is deemed to have been withdrawn, therefore, in absence of application within the prescribed time under rule 20, the application would not be maintainable, in view of proviso to rule 138.

26. The learned Additional Solicitor General of India, further contended that rule 6(5) of the Patents rule is in consonance with Article 48 and Rule 82 of PCT. Therefore, learned Deputy Controller rightly held that the delay in moving application could only be condoned, if there was postal delay and for no other reason.

27. It was also contended on behalf of the respondents that application under rule 138 could only be moved within prescribed time under rule 20 and not thereafter.

28. On consideration, I find force in the contention raised by the learned Senior Counsel for the petitioner. It is not in dispute that PCT application can only be filed within a period, as stipulated under Rule 20.

29. On expiry of the period of 31 months, defective application or application not filed, would be deemed to be withdrawn meaning that it would be no application in the eye of law.

30. At the same time, under Rule 138, period for submitting the application can be extended by one month, if a good cause is shown by the applicant.

31. The Controller is vested with power to extend the time by one month by exercising the powers under the rules. Rule 138 of the Patents Rule is independent of rule 6(5) or Article 48 and rule 82 of PCT.

32. The learned Deputy Controller was also not right in coming to the conclusion that in view of proviso to rule 138, the application for extension of time could only be moved within the period stipulated under rule 20 i.e. 31 months, as reading of Rule 138 would show that the rule making authority has used two terms 1) prescribed time under the rules 2) period for which time could be extended.

33. The time prescribed under Rule 20 is 31 months, and the period, which could be extended by taking into consideration of facts and circumstances, is one month.

34. The application for extension is required to be made within the period prescribed. Therefore, proviso would come into operation for the purpose of calculating period of one month. On true interpretation of rule 138, it is held that application for extension is to be filed within one month after expiry of prescribed time under rule 20. In case, an application is moved for extension of time by one month or shorter period, it is required to be decided on merit by taking into consideration facts and circumstances of each case.

35. It is a well settled law that the Courts and statutory authorities are to do substantial justice. The object of Rule 138 is that prescribed time under rule 20 can be extended by period of one month on showing of sufficient cause. As already observed above, it is the discretion of the Controller to extend the period on facts and circumstances of the case, but it was not correct on the part of the Deputy Controller to have rejected the application, by treating it to be not maintainable, as having been filed after expiry of prescribed time under rule 20 of the Patents Rules 2003. The merits of the facts disclosed were to be considered. Rule 6(5) or Article 48 and rule 82 of PCT rule do not govern powers under rule 138, as the Controller under this rule is to exercise quasi judicial power.

36. For the reasons stated above, the impugned order is quashed and case is remanded back to the Deputy Controller to decide the application moved under Rules 137 & 138 in accordance with law, by treating it be filed within the period of one month, as provided under rule 138 and take a decision on merit in accordance with law. No costs. Connected Miscellaneous petition is closed.