

[Abstract prepared by the PCT Legal Division (PCT-2012-0003)]

Case Name:

CARLOS ALBERTO PEREZ LAFUENTE V. UNION OF INDIA AND OTHERS

Jurisdiction:

HIGH COURT OF DELHI (INDIA)

Abstract:

The High Court of Delhi has set aside an order by the patent office treating a PCT application entering the national phase in India as withdrawn because the request for examination was made too late. A request for examination has to be filed within 48 from the date of priority or date of filing, whichever expires earlier (according to Rule 24B(1)(i) of the Indian Patent Rules), respectively whichever expires later (according to the PCT Guidelines IN 09). The applicant argued that there was a conflict between the Rules and the Guidelines, and thus confusion, when the request for examination has to be filed. The Court directed the patent office to reconsider the patent application.

PCT Legal References:

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

Source: <http://lobis.nic.in/dhc/>

Mr. Carlos Alberto Perez Lafuente vs Union Of India And Ors on 23 September, 2011

IN THE HIGH COURT OF DELHI AT NEW DELHI

Date of decision: 23rd September, 2011

+ W.P.(C) 6975/2011 & CM No.16014/2011 (for stay).

MR. CARLOS ALBERTO PEREZ LAFUENTE Petitioner Through: Ms. Prathiba M. Singh & Ms. Saya

Choudhary, Adv.

versus

UNION OF INDIA AND ORS Respondents Through: Mr. Jatan Singh, CGSC & Mr.

Prashant Ghai, Adv.

CORAM :-

HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

1. Whether reporters of Local papers may Not necessary be allowed to see the judgment?
2. To be referred to the reporter or not? Not necessary
3. Whether the judgment should be reported Not necessary in the Digest?

[

RAJIV SAHAI ENDLAW, J.

1. The petition impugns the communication dated 25 th November, 2010 of the respondent no.4, Office Supdt. The Patent Office of Government of India, intimating that Form 18 in respect of the Patent Corporation Treaty (PCT) application preferred by the petitioner could not be taken on record.
2. The counsel for the petitioner has contended that the Form 18, for

W.P.(C)6975/2011 Page 1 of 10 examination of the patent application, filed by the petitioner on 19th

November, 2010 has not been accepted for the reason of the same having been filed beyond the time prescribed in Section 11B of The Patents Act, 1970 r/w Rule 24 B(1)(i) of The Patents Rule, 2003.

4. Though the letter dated 25th November, 2010 does not give any reason for non acceptance thereof but the counsel for the respondents appearing on advance notice admits that the reason for not taking the Form 18 on record is of the same having been filed beyond time.

5. The contention of the counsel for the petitioner is that there is inconsistency between the sub-section (1)(i) of Rule 24B and the PCT Guidelines for National Phase Filing in India published by the World Intellectual Property Organization (WIPO) as to the time for filing Form 18.

6. Being of the view that the contentions of the petitioner (as have been raised in the petition) have not been examined by the respondent no.2 Controller General of Patents, Designs, Trademarks and Geographical Indications and that if a prima facie case is found in favour of the

petitioner, it is appropriate that the matter be remanded for consideration W.P.(C)6975/2011 Page 2 of 10 and for a reasoned order by the authorities concerned, the counsels have been heard.

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

"11B 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 with effect from 1.1.2005. (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 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.]"

8. Section 11B (1) though prohibits making of a request for examination of the application, form whereof is prescribed as Form 18, W.P.(C)6975/2011 Page 3 of 10 after the period prescribed therefor does not prescribe the period for preferring the said application/form. Section 11B(4) provides for the consequence of not preferring the application within the prescribed time i.e. of the application being treated as withdrawn by the applicant.

9. The time for making the application is prescribed in Rule 24B(1) which is as under:-

"24B Examination of application (1)(i)

A request for examination under Section 11B 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 11B to be made shall be forty-eight months from the date of priority if application, or forty-eight months from the date of filing of the application; (iii) The request for examination under sub-section(4) of section 11B 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, W.P.(C)6975/2011 Page 4 of 10 whichever is later;

(v) The period for making request for examination under section 11B, of the applications filed before the 1st day of January, 2005 shall be [the period specified under the section11B before the commencement of the Patents (Amendment) Act, 2005 or] the period specified under these rules, whichever expires later."

10. The date of priority referred to in Rule 24B is defined in Section 2

(w) of the Act as having the meaning assigned to it by Section 11. Section 11 defines the priority dates for various types of applications and according to the counsel for the petitioner, the priority date for PCT applications as per sub Section (6) of Section 11 r/w Section 135 dealing with the

convention applications is the date on which the basic application in any of the convention countries is made.

11. It is stated that the basic application by the petitioner was made first in Europe on 28th March, 2006 and the date of PCT filing abroad is 27th March, 2007 and the date of filing the PCT in India is 28th August, 2008.

12. Rule 24B (1)(i) prescribes that a request for period examination under Section 11B shall be made in Form 18 within forty eight months to be counted from the date of priority of the application or from the date of W.P.(C)6975/2011 Page 5 of 10 filing of the application, whichever is earlier.

13. The counsel for the respondents contends that the Form 18 preferred by the petitioner has not been taken in record for the reason of the date of priority in the case of the petitioner being 28th March, 2006 and the Form 18 filed on 19th November, 2010 being beyond the time of 48 months therefrom. However, if the period of forty eight months is to be counted from the date of filing of the application, then the Form 18 filed on 19th November, 2010 was within time. Form 18 filed by the petitioner has thus been rejected because of the words "whichever is earlier" in Rule 24B(1)(i).

14. However Rule 24B(1)(iii) prescribes the period for filing request for examination under Section 11B(4) as 48 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.

14. Though at first blush it appears that there is a conflict between Rule 24B(1)(i) & Rule 24B(1)(iii) since Section 11B(4) as aforesaid does not provide for filing of any application different from that prescribed in

Section 11B(1) and only provides the consequences of non-filing within the W.P.(C)6975/2011 Page 6 of 10 prescribed time, but on further consideration it is found that Rule

24B(1)(iii) provides for an application under proviso (ii) to Section 11B(4), i.e. for cases where a secrecy direction under Section 35 had been issued - in these cases, Form 18 is to be filed either within time prescribed in of

Rule 24B1(i) or within six months from the date of revocation of the secrecy direction, whichever is later.

15. The argument of the counsel for the petitioner however as aforesaid is of conflict between Rule 24B(1)(i) and the Guidelines. The said guideline is as under:-

"IN.09 REQUEST FOR EXAMINATION. A

patent application shall not be examined unless the applicant or any other interested person makes a request for such examination in the prescribed manner within 48 months from the date of priority of the application (if applicable) or from the date of filing of the patent application, whichever is later. Such a request must be made on Form 18 (see Annex IN.XI) and be accompanied by the prescribed fee."

16. The counsel for the petitioner contends that the petitioner as per the Guideline, treated the period for filing Form 18 as 48 months from date of priority or filing the application for patent, "whichever is later" and the filing of Form 18, in terms of Guidelines is within time. She further W.P.(C)6975/2011 Page 7 of 10 contends that even through the Act and Rules do not provide for condonation of delay in filing Form 18 but benefit of apparent conflict should be given to the petitioner.

17. The counsel for the respondents contends that the respondents are concerned with and are to abide by the provisions of the Act and the Rules only and not by the Guidelines published by WIPO.

18. The counsel for the petitioner rejoins that the Guidelines are a part of the PCT and the persons desirous of filing the patent, particularly the foreigners are guided thereby and the same cannot be ignored and the provisions of the Act and the Rules have to be in consonance therewith.

Reliance is placed on Rule 23 which is as under:-

"Rule 23 - The requirement under this Chapter to be supplemental of the regulations, etc. under the Treaty. (1) The provisions of this Chapter shall be

supplemental to the PCT and the regulation and the administrative instructions made thereunder. (2) In case of a conflict between any provisions of the rules contained in this Chapter and

provisions of the Treaty and the regulations and the administrative instructions made thereunder the provisions of the Treaty and the regulations and the administrative instructions made

thereunder shall apply in relation to international applications."

W.P.(C)6975/2011 Page 8 of 10

19. There is an apparent conflict between the Guidelines and Rule 24B(1)(i) while one provides for the time of 48 months to be counted from the two alternative commencement dates, "whichever is later", the other uses the expression "whichever is earlier". The possibility of being misguided cannot be ruled out. Though the argument of the counsel for the respondents of the respondents being bound by the Act and Rules is attractive and application of Rule 23 is by express words found limited to Chapter III of the Rules only and not to Chapter IV in which Rule 24B is to be found but since the matter of conflict with the Guidelines does not appear to have been considered by the respondent no.2 Controller General, rather than this Court hearing the counsels in first instance, it is deemed expedient that the matter be remanded to the respondent no.2 Controller General of Patents, Designs, Trademarks and Geographical Indications for consideration thereof after hearing the petitioner and such other persons as may be found to be concerned therewith.

20. The petition is therefore disposed of setting aside the communication dated 25th November, 2010 and directing the respondents

W.P.(C)6975/2011 Page 9 of 10 to consider the Form 18 preferred by the petitioner after hearing the

petitioner. Since it is informed that a large number of other applicants are also likely to be affected, it is directed that a speaking order be passed within three months of today. Needless to state that if any inconsistency is found, the respondents to take remedial steps at the earliest and if the petitioner remains aggrieved from the order to be so made, the petitioner shall have remedies in law.

21. This Court having taken only a prima facie view of the matter, the observations herein not to affect the case of either of the parties.

No order as to costs.

Dasti.

CM No.16015/2011 & CM No.16069/2011 (for exemption). Allowed, subject to just exceptions.

RAJIV SAHAI ENDLAW

(JUDGE)

SEPTEMBER 23 , 2011

pp..

W.P.(C)6975/2011 Page 10 of 10