

Delhi High Court

M/S. Iritech Inc vs The Controller Of Patents on 20 April, 2017

* IN THE HIGH COURT OF DELHI AT NEW DELHI

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Judgment pronounced on: 20th April, 2017

+ W.P.(C) 7850/2014

M/S. IRITECH INC

..... Petitioner

versus

THE CONTROLLER OF PATENTS

..... Respondents

Advocates who appeared in this case:

For the Petitioners : Mr. S.K. Bansal with Mr. Ajay Amitabh Suman, Advocates.

For the Respondents : Mr. Akshay Makhija, CGSC with Mr. Shivi Sanyam, Advocate.

CORAM: -

HON'BLE MR JUSTICE SANJEEV SACHDEVA

JUDGEMENT

SANJEEV SACHDEVA, J

1. The Petitioner by the present petition seeks quashing of the "deemed to be withdrawn" status of the application No. 5272/DELNP/2008 under section 11B of the Patents Act, 1970 (hereinafter referred to as the Act) and seeks restoration of the said application and for proceeding further with the same. The Petitioner also seeks a direction to the respondents to correct the clerical/typographical error in the number of the Patent application in Form No. 18 and other documents to read as 5272/DELNP/2008.

2. The petitioner on 08.01.2007 filed an application in the Patent Office of the Republic of Korea, in respect of invention titled "IRIS IDENTIFICATION SYSTEM AND METHOD USING MOBILE DEVICE WITH STEREO CAMERA" for grant of Patent under the Patent Co-operation Treaty vide PCT Application No. PCT/KR2007/000099.

3. On 18.06.2008, the petitioner filed the Indian National Phase Application No. 5272/DELNP/2008. The priority date in respect of the Indian National Phase Application was shown to be 07.01.2006 and the PCT international filing date was shown to be the date of the filing of the Korean Patent i.e. 08.01.2007.

4. The Petitioner on 30.06.2008 made a request, under Section 11B (1) of the Act on Form 18 under the Patent Rules 2003 (hereinafter referred to as the Rules) for substantive examination of the said Indian National Phase application.

5. It is contended by the Petitioner that during the follow up actions, it was noticed that in Form 18 as well as in its covering letter, the number of the Indian National Phase application had been

incorrectly typed as 6272/DELNP/2008 instead of 5272/DELNP/2008.

6. On 02.01.2010 (incorrectly dated as 02.01.2009), the petitioner addressed a letter to the Respondent bringing to its notice the aforesaid error of the Patent application number in Form 18 and requested the Respondent to treat the request for substantive examination on Form 18 and the payment made there under, in relation to Patent application No. 5272/DELNP/2008 instead of No. 6272/DELNP/2008. The letter sought correction under Section 78 of the Act and was accompanied with the prescribed fee of Rs. 2,000/- for carrying out the correction under Section 78 of the Act. The Petitioner also enclosed therewith the corrected Form 18 and the covering letter. It is contended that thereafter there was no communication from the side of the Respondents.

7. Subsequently on 02.02.2010, the petitioner obtained the search report of the aforesaid application from the official website of the Indian Patent Office wherein the application was shown as "deemed to be withdrawn" under Section 11B (4) of the Act.

8. By email dated 30.01.2012, the Assistant Controller of Patents and Designs informed the petitioner that the documents filed by the petitioner seemed to relate to the Patent Application No. 5272/DELNP/2008 but had been filed mentioning the application No. 6272/DELNP/2008, which did not belong to the petitioner. The Assistant Controller also informed that the petitioner may face difficulty in meeting the time lines for filing Form 18 and informed that necessary remedial steps be taken.

9. The petitioner by letter dated 13.02.2012 requested the Respondent to make necessary corrections in terms of its aforesaid letter dated 02.01.2010 (sic 02.01.2009). The petitioner also requested that the status of the application be corrected. The Respondents declined to entertain the application of the petitioner leading to the filing of the present petition.

10. The Respondents in their counter affidavit have contended that under Section 78 of the Act, the Power of the Controller to correct clerical errors can only be exercised or made to effect, when the patent application is in examination procedure. It is contended that as the patent application was not in examination on the date of filing of the request under Section 78 i.e. on 02.01.2010, there was no office action possible on the petitioner's patent application.

11. It is submitted that the priority date of the patent application No.5272/DELNP/2008 was 07.01.2006 and consequently the last date, for filing Form-18 (Request for Examination) was 07.01.2010 and the requisite form-18 was never filed in the said patent application consequently the application had become "deemed to be withdrawn" on the expiry of 07.01.2010.

12. It is submitted that the office action under Section 11B (4) (deemed to be withdrawn) is the outcome of inaction on the part of the petitioner due to non-filing of the request for examination for the relevant application, within the prescribed period of four years. It is contended that the petitioner's authorized patent agent had not acted diligently for the reason that when he submitted Form 18, office issued a CBR (Receipt) indicating the application number in which the request was filed and if he had properly checked, he would have noticed the error and notified the office

immediately to avoid such a situation.

13. It is submitted that the request for correction made by the petitioner by letter dated 02.01.2010 (sic 02.01.2009) was not the proper procedure to make corrections under the Act. It is further submitted that the petitioner made a request for correction of the error only on 13.02.2012 which was beyond the statutory time period and by that time the patent application was already deemed to have been withdrawn under Section 11B(4). It is contended that the petitioner's agent should have filed a request for examination in prescribed manner afresh, within the prescribed period of four years, to seek correction of the mistake.

14. It is further contended that as per Section 11B of the Act any interested person, other than the applicant, can also make a request on Form 18, so there was no reason to doubt that there was any mistake or mismatch in the Form-18 submitted by the petitioner.

15. Reliance is placed by counsel for the Respondent on the decision of a coordinate bench of this court NIPPON STEEL CORPORATION VERSUS UNION OF INDIA: 2011 III AD (Delhi) 226, to contend that the Controller of patents is not competent to allow the application for amendment after the patent application is deemed to have been withdrawn.

16. To resolve the controversy we would need to examine the scheme of Sections 11 B, 12 of the Act, Rules 24 B of the Rules pertaining to making a Request for Examination and Section 78 pertaining to power of controller to correct errors.

17. Section 11B of the Act which deals with request for examination and section 12 which deals with examination of the applications read as under:

"Section 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 by the Patents (Amendment) Act, 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 subsection (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.

12. Examination of application.--

(1) When a request for examination has been made in respect of an application for a patent in the prescribed manner under sub-section (1) or sub-section (3) of section 11B, the application and specification and other documents related thereto shall be referred at the earliest by the Controller to an examiner for making a report to him in respect of the following matters, namely:--

(a) whether the application and the specification and other documents relating thereto are in accordance with the requirements of this Act and of any rules made there under;

(b) whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;

(c) the result of investigations made under section 13;

and

(d) any other matter which may be prescribed.

(2) The examiner to whom the application and the specification and other documents relating thereto are referred under sub-section (1) shall ordinarily make the report to the Controller within such period as may be prescribed.

18. Section 11 B of the Act, inter-alia, prescribes that no application submitted for grant of 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 and if no request is made within the prescribed period the application would be deemed to have been withdrawn.

19. Under section 12 of the Act, when a request for examination is made in respect of an application for a patent under sub-section (1) or sub-section (3) of section 11B, the application and specification and other documents related thereto are to be referred at the earliest, by the Controller, to an examiner for making a report to him, inter-alia, as to whether the application and the specification and other documents relating thereto are in accordance with the requirements of this Act and of any rules made there under. The examiner to whom the application and the specification and other documents relating thereto are referred under sub-section (1) is to make the report to the Controller within such period as may be prescribed.

20. Rule 24B of the Rules that prescribes the respective periods referred to in Section 11B and 12, reads as under:

Rule 24B. 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 11B 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 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, 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 section 11B before the commencement of the Patents (Amendment) Act, 2005 or the period specified under these rules, whichever expires later.

(2)(i) The period within which the Controller shall refer the application and specification and other documents to the examiner in respect of the applications where the request for examination has been received shall ordinarily be one month from the date its publication or one month from the date of the request for examination whichever is later:

Provided that such reference shall be made in order in which the request is filed under sub-rule (1).

(ii) The period within which the examiner shall make the report under sub-section (2) of section 12, shall ordinarily be one month but not exceeding three months from the date of reference of the application to him by the Controller;

(iii) the period within which the Controller shall dispose off the report of the examiner shall ordinarily be one month from the date of the receipt of the such report by the Controller.

(3) A first examination report along with the application and specification shall be sent to the applicant or his authorised agent ordinarily within six months from the date of the request for examination or six months from date of publication whichever is later. In case other interested person files the request, for examination, an intimation of such examination may be sent to such interested person.

(4) The time for putting an application in order for grant under section 21 shall be twelve months from the date on which the first statement of objection is issued to the applicant to comply with the

requirements.

21. Under Rule 24B (1) of the Rules, a request for examination under Section 11 B of the Act is to be made in Form 18 within forty- eight months from the date of the priority of the application or from the date of filing of the application, whichever is earlier. In the present case, the last date admittedly was 07.01.2010.

22. Rule 24B (2)(i) of the Rules, inter-alia, prescribes that the Controller shall refer the application and specification and other documents to the examiner, in respect of the applications where the request for examination has been received, ordinarily within one month from the date its publication or one month from the date of the request for examination whichever is later.

23. Under Rule 24B(2)(ii), the examiner is to make a report, under sub-section (2) of section 12, between one month to three months, from the date of reference of the application to him by the Controller.

24. Section 11A of the Act, dealing with Publication of applications, stipulates that an application for grant of patent shall ordinarily not be open to the public for such period as may be prescribed. After the prescribed period, during which it is not open to public, the application is to be published as soon as possible. Rule 24 of the Rules prescribes the period, during which it would not be open to public, as 18 months from the date of filing of the application or the date of priority of the application, whichever is earlier. After the expiry of the said period, the Controller has to publish the application in the journal, within one month.

25. In the present case, the Indian National Phase application, for grant of patent, was made on 18.06.2008. The request for examination under Section 11B(1) of the Act, mentioning an incorrect application number, was made on 30.06.2008. The priority date of the application is 07.01.2006. In terms of Rule 24, the application for grant of patent had to be published within one month of expiry of 18 months of the date of application (i.e. 18.06.2008) or 18 months of the priority dated (i.e. 07.01.2006), whichever is earlier. Under Rule 24B, the request for examination under section 11B had to be referred to the examiner within one month of the publication. In the instant case, the earlier of the two dates is 07.01.2006, so the publication would have had to happen within one to three months of expiry of 18 months thereof. i.e. within three months of 07.07.2007.

26. The request for examination under section 11B was filed on 30.06.2008 so the same under Rule 24B would have had to be referred to the examiner within one month of the receipt i.e. by 30.07.2008. The examiner would thereafter be required to submit the report within one month. If the examiner had examined the application under 11B of the Act, in time and submitted his report to the controller, it would have been brought to the notice of the Petitioner well before the expiry of 48 months prescribed period, that there was an error in the request for examination and the petitioner could have taken steps to remedy the error.

27. The Petitioner on 02.01.2010 filed a letter with the Respondents seeking correction under section 78 of the Act. The request for correction was made prior to the expiry of the prescribed

period of 48 months, which was to expire on 07.01.2010.

28. Section 78 of the Act, which deals with the power of the Controller to correct errors, reads as under:

"S. 78. Power of Controller to correct clerical errors etc.--

(1) Without prejudice to the provisions contained in sections 57 and 59 as regards amendment of applications for patents or complete specifications or other documents related thereto and subject to the provisions of section 44, the Controller may, in accordance with the provisions of this section, correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

(4) Where a request is made under this section for the correction of any error in a patent or application for a patent or any document filed in pursuance of such an application, and it appears to the Controller that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of the proposed correction to be published in the prescribed manner.

(5) Within the prescribed time after any such publication as aforesaid any person interested may give notice to the Controller of opposition to the request, and, where such notice of opposition is given, the Controller shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case."

29. Section 78 of the Act, inter-alia, empowers the controller to correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register. The correction can be made either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

30. The rules prescribe various forms for different actions under the Act and the Rules. The First Schedule read with Rule 7 rules provides for the forms and the fee to be paid for various actions under the Act and the Rules. With regard to an application under section 78 for corrections, the First Schedule stipulates as under:

The First Schedule (See rule 7) FEES Number On what payable Number Amount of fee (in rupees) of Entry of the relevant form For natural persons(s) For other than natural persons(s) either alone or jointly with natural persons(s)

1. 2. 3. 4. 5.

*	***	*	*	*
37.	On a request for correction of clerical error under section 78(2).	-	500	2,000
*	***	*	*	*

31. It may be noted that there is no form prescribed for making a request for correction of clerical error under Section 78 of the Act. The fee prescribed is Rs. 500/- for natural persons and Rs. 2,000/- for other than natural persons.

32. The petitioner, on 02.01.2010, had given a letter requesting for correction, under Section 78 of the Act, of the clerical error in the Form 18, wherein the petitioner had mentioned the number of the Indian National Phase application as 6272/DELNP/2008 instead of 5272/DELNP/2008. It may be noted that, in the originally filed request for examination, the date of the application for grant of patent was correctly mentioned as 18th June 2008 and the description of the patent was correctly mentioned as "IRIS IDENTIFICATION SYSTEM AND METHOD USING MOBILE DEVICE WITH STEREO CAMERA". Along with the request for correction, the petitioner also paid the requisite fee of Rs. 2,000/-.

33. Since there is no form prescribed by the Act or the Rules for seeking correction under Section 78 of the Act, even a letter would be sufficient. The petitioner along with the letter had enclosed the corrected Form 18 and the corrected covering letter. The request was made prior to the expiry of the period of 48 months. The requisite fee was also paid thereon. There is no reason as to why the Respondents should not have considered the same.

34. The reason given in the counter affidavit, that the Power of the Controller to correct clerical errors can only be exercised or made to effect, when the patent application is in examination procedure and on the date of filing of the request under Section 78 i.e. on 02.01.2010, there was no office action possible on the petitioner's patent application, is not tenable, in view of what has been noticed hereinabove with reference to Sections 11 B, 12 of the Act and Rules 24B of the Rules.

35. If the Respondents had stuck to the timelines for examination, the patent application would have been in the examination procedure.

Further, a request under Section 78 is not dependent on the examination procedure or any office action on the patent application. If the request of the petitioner for correction under Section 78 had been considered by the respondents, there is no reason as to why the same was not liable to be granted.

36. The request for correction under Section 78 of the Act was made before the expiry of the 48-month period, was accompanied with the requisite fee and sought correction of what was clearly a clerical error. Thus the action of the Respondents, in not considering the request for correction, cannot be sustained.

37. The contention, that the request for correction made by the petitioner by letter dated 02.01.2010 (sic 02.01.2009) was not the proper procedure to make corrections under the Act, is also not tenable in view of what has been noticed hereinabove with reference to Section 78 of the Act. Further contention that the request for correction made on 13.02.2012 was beyond the statutory time period and by that time the patent application was already deemed to have been withdrawn under Section 11B(4) is of no consequence as by letter dated 13.02.2012, the petitioner had only reiterated the earlier request dated 02.01.2010. The letter of 13.02.2012 was not even accompanied with any fee, which fee had already been paid along with the request dated 02.01.2010.

38. Further contention that as per Section 11B of the Act any interested person, other than the applicant, can also make a request on Form 18, so there was no reason to doubt that there was any mistake or mismatch in the Form-18 submitted by the petitioner, is also not substantiated from the record.

39. Form 18 which is prescribed by the rules is as under:

FORM 18
THE PATENTS ACT, 1970
(39 of 1970)
&
The Patents Rules, 2003
REQUEST/EXPRESS REQUEST FOR
EXAMINATION OF APPLICATION FOR
PATENT

(FOR OFFICE USE ONLY)

RQ.No:
Filing Date:
Amount of Fee Paid:
CBR No:
Signature:

(See section 118 and rule 20(4)(ii), 248(1)(i)]

1. APPLICANT (S)/OTHER INTERESTED PERSON

(a) NAME:

(b) NATIONALITY:

(c) ADDRESS:

(d) date of publication of the application under section 11A

2. Statement In case of request for examination made by the applicant(s) I/We hereby request that my/our application for patent no. _____ filed on _____ for the invention titled _____ shall be examined under sections 12 and 13 of the Act.

Or I/We hereby make an express request that my/our application for patent no. _____ filed on. _____ based on Patent Cooperation Treaty (PCT) application no. _____ dated _____ made in country _____ shall be examined under sections 12 and 13 of the Act, immediately without waiting for the expiry of 31 months as specified in rule 20(4)(ii).

3. Statement in case of request for examination made by any other interested person I/We the interested person request for the examination of the application no. _____ dated _____ filed by the applicant _____ titled _____ under sections 12 and 13 of the Act. As an evidence of my/our interest in the application for patent following documents are submitted.

(a) _____

4. ADDRESS FOR SERVICE Dated this ____ day of ____ 20 Signature Name of the signatory To, The Controller of Patents The Patent Office, at _____.

NOTE:

*To be signed by the applicant(s) or by his authorized registered patent agent *Strike out the column which is/are not applicable *For fee: See First Schedule

40. Perusal of Form 18 shows that where a request is made by the applicant, then the statement is to be filled in terms of Para 2 and if the request is made by any other interested person then the statement is to be filled in terms of Para 3.

41. The Petitioner had filled up Form 18 and had given the statement as prescribed by Para 2. When the petitioner had specifically stated, in Form 18, that the request for examination is being made by the Applicant and gave a statement in terms of Para 2 thereof, so how can the respondents contend, that as any interested person other than the applicant can also make a request on Form 18, there was no reason to doubt that there was any mistake or mismatch in the Form-18 submitted by the petitioner. This contention is further controverted by the email dated 30.01.2012 written by the Assistant Controller of Patents to the Advocates of the Petitioner as under:

"This has come to my notice that there is some discrepancy in documents filed in respect of patent application 5272/delnp/2008. I find it necessary to bring the same in your knowledge. Correspondence dt 27.06.2008; dt 18.07.2008. Request in F-18

dt 30.06,2008, Form-5 which seems to related your patent application 5272/deinp/2008 has been filed mentioning patent application No 6272/delnp/2008, This application No 6272/delnp/2008 does not belong to your firm.

As such your client/applicant may have to face difficulty in meetings the timelines for filing of F-18. This is for your information as to take necessary remedy at your end."

42. The email dated 30.01.2012 clearly shows that the error in Form 18 was an apparent clerical error and was writ large.

43. Further, the reliance placed by counsel for the Respondent on the decision of a coordinate bench of this court in NIPPON STEEL CORPORATION (supra), to contend that the Controller of patents is not competent to allow the application for amendment after the patent application is deemed to have been withdrawn, is misplaced. In NIPPON STEEL CORPORATION, the petitioner failed to file a request for examination under section 11 B within forty-eight months from the date of priority of the application. Thereafter the Petitioner, therein, filed an application seeking to amend the date of priority. It was held that the amendment could not be granted as the application for amendment was filed after the original priority date had already expired and the application for grant of patent had already been deemed to have been withdrawn.

44. The said judgment is not applicable in the facts of the present case. In this case, the request for examination was filed within the 48- month period and even the request for correction of the clerical error was made prior to the expiry of the period of 48 months and prior to the application for grant of patent being deemed to have been withdrawn.

45. In view of the above, the action of the Respondents in deeming the Indian National Phase application No. 5272/DELNP/2008 as deemed to be withdrawn, is set aside. The "Deemed to be withdrawn"

status of the application is accordingly quashed. The application is restored and shall be treated to be pending. The clerical error in the Request for Examination and its supporting documents, submitted by the petitioner, shall be corrected and the Indian National Phase application number referred therein shall be read as 5272/DELNP/2008. Any reference made therein to Indian National Phase application No. 6272/DELNP/2008 shall be read as Indian National Phase application No. 5272/DELNP/2008. The Respondents shall proceed further with the application in accordance with law. There shall be no orders as to costs.

April 20, 2017/ HJ

SANJEEV SACHDEVA, J