
(2012) 04 DEL CK 0032
In the Delhi High Court
Case No : LPA No. 561 of 2011

Dr. Snehlata C Gupte

APPELLANT

Vs

Union of India and Others

RESPONDENT

Date of Decision : 20-04-2012

Acts Referred:

Patents Act, 1970 — Section 11A, 12(1), 17B, 18(2), 2

Citation : (2012) 8 AD 165 : AIR 2012 Delhi 182 : (2012) 189 DLT 342 : (2012) 50 PTC 327

Hon'ble Judges : A.K. Sikri, Acting C.J.;Rajiv Sahai Endlaw, J

Bench : Division Bench

Advocate : Sudhir Chandra with Mr. Sagar Chandra, Ms. Ishani Chandra, Mr. Ankit Rastogi, for the Appellant; Sachin Datta, CGSC for UOI Mr. Mahinder Singh, with Ms. Pratibha M. Singh, for R5 2, for the Respondent

Final Decision : Dismissed

Judgement

A.K. Sikri, Acting Chief Justice

1. Since in all these appeals pure question of law arises for determination, to consider that question, facts of LPA No. 561 of 2010 shall suffice as that would serve the purpose. The respondent No. 5, viz., J. Mitra & Co. Ltd had filed two patent applications in the Office of the Controller of Patents on 14.6.2001. Patent Specifications were published in the official gazette on 20.11.2004 in terms of Section in terms of Section 11A of the Patents Act (hereinafter referred to as "the Act"). As per provisions of Section 25 (unamended) of the Act, which held the field at that time, an opposition to the grant of patent could be filed within four months from the date of publication. Such a period could be extended by one month by the Controller on being satisfied by the reasons given for such delay. One M/s. Span Diagnostics Ltd. (SDL) filed pre-grant opposition. It was considered by the Controller and vide detailed order dated 23.8.2006, the Controller rejected this opposition. On rejection of pre-grant opposition, the Controller ordered grant of patent on the application of the respondent No. 5

putting a particular condition. Since this portion of the order is bone of contention, we would like to reproduce the same hereunder:

In view of the above discussion and in consideration of the submissions of both the parties. I hereby order to grant [Patent No. 194639] on Patent Applicant No. 590/Del/2000 with the following condition:

The Applicants shall give cross reference to the patent application No. 593/Del/2000 on page 2 of the complete specification and submit the amended/retyped page(s) within a week from the date of these order. The Opposition on Patent Application No. 590/Del/2000 (194639) is disposed of in above terms. No order to cost.

2. As per the appellant, she had sent pre grant opposition by currier on 22.8.2006 which was received by the Patent Office on 24.8.2006. As on that date, Section 25 (1) of the Act stood amended by the Patents (Amendment) Act, 2005 with effect from 01.1.2005. As per the amended provision, the time for filing a pre-grant opposition stood extended till the grant of patent. According to the appellant, her pre-grant opposition received on 24.8.2006 was within time as per the Amended provision of Section 25(1) of the Act inasmuch as there was no patent granted by that time. It was her case that the patent is not granted till such time it is not sealed and entered in the Register in terms of Section 43(1) of the Act and such a patent was granted on 22.9.2006. On the other hand, the respondent No. 5 pleaded that when the objections were rejected on 23.8.2006 in terms of Rule 55(6) of the Rules, no application for pre-grant opposition was maintainable.

3. The Controller accepted the plea of the respondent No. 5 and rejected pre-grant opposition of the appellant vide orders dated 16.10.2006. Since this order was passed without hearing the appellant, the appellant challenged the order by filing Writ Petition (C) Nos.3516/2007 and 3517/2007. The Controller thereafter, however, gave hearing to the appellant and passed order dated 22.5.2007 rejecting the pre-grant opposition as time barred. Challenging the aforesaid order, the appellant had filed writ petitions and they have been filed under similar circumstances, viz., after the rejection of the earlier pre-grant opposition, but before the patent was entered into the Register. In this backdrop, the question that arose for consideration in these writ petitions was that when can a patent said to be granted.

4. Learned Single Judge vide detailed judgment has taken the view that when the pre-grant opposition filed by SDL was rejected on 23.6.2006, that would be the date which is to be reckoned for grant of patent and the opposition filed by the appellant on 24.8.2006 was not maintainable as a pre-grant opposition since it was time barred as the patent had already be granted.

5. Submission of Mr. Sudhir Chandra, learned Senior Counsel appearing for the appellant is that order dated 23.8.2006 was not an order of grant of patent itself. It simply rejected the pre-grant opposition filed by the SDL. Thereafter, certain

formalities were to be fulfilled and therefore, pre-grant opposition was subject to fulfillment of those conditions. It was submitted that the respondent No. 5 was given a chance to rectify the same. It is only on this rectification that the patent could be granted and the order dated 23.8.2006 itself mentions these conditions. Therefore, application was not even valid on that date and treating 23.8.2006 as the date of grant of patent was wrong. Learned counsel also referred to the definition of patentee u/s 2(p) of the Act which reads as under:

2. Definitions and interpretation. - (1).....

xxx xxx xxx

(p) "patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent.

6. He also referred to the following provisions in respect of his submission that 23.8.2006 cannot be the date of grant of patent which is to be 22.9.2006:

Section 21. Time for putting application in order for grant -

(1) An application for a patent shall be deemed to have been abandoned unless, within such period as may be prescribed, the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objections to the application or complete specification or other documents related thereto is forwarded to the applicant by the Controller.

Explanation.-Where the application for a patent or any specification or, in the case of a convention application or an application filed under the Patent Cooperation Treaty designating India any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has re-filed it or the applicant proves to the satisfaction of the Controller that for the reasons beyond his control such document could not be re-filed.

(2) If at the expiration of the period as prescribed under sub-section (1),-

(a) an appeal to the High Court is pending in respect of the application for the patent for the main invention; or

(b) in the case of an application for a patent of addition, an appeal to the High Court is pending in respect of either that application or the application for the main invention, the time within which the requirements of the Controller shall be complied with shall, on an application made by the applicant before the expiration of the period as prescribed under sub-section (1), be extended until such date as the High Court may determine.

(3) If the time within which the appeal mentioned in sub-section (2) may be

instituted has not expired, the Controller may extend the period as prescribed under sub-section (1), to such further period as he may determine:

Provided that if an appeal has been filed during the said further period, and the High Court has granted any extension of time for complying with the requirements of the Controller, then the requirements may be complied with within the time granted by the Court.

Rule 14. Amendments to specifications. - (1) When a provisional or complete specification or any drawing accompanying it has been received by the applicant or his agent for amendment, and amendment is duly made thereon, the page incorporating such amendment shall be retyped and submitted to form a continuous document. Amendments shall not be made by slips pasted on, or as footnotes or by writing in the margin of any of the said documents.

(2) The amended documents shall be returned to the Controller together with the superseded pages or drawings, if any, duly marked, cancelled and initialed by the applicant or his agent. Copies of any pages that have been retyped or added and of any drawing that has been added or substantially amended shall be sent in duplicate.

Rule 31. Form of reference to another specification.- When in pursuance of rule 30, the Controller directs that a reference to another specification shall be inserted in the applicant's complete specification, such reference shall be inserted after the claims and shall be in the following form, namely:-

Reference has been directed, in pursuance of section 18(2) of the Patents Act, 1970, to the specification filed in pursuance of application No."

7. He also referred to the objects and reasons behind Amendment of Section 25(1) of the Act which according to him, was to give sufficient opportunity to any objectors to come forward and file the objection before its grant. It is submitted that such an opportunity could not be taken away and the law of implementation is to be read as it is. His further submission was that while interpreting the provisions of law relating to limitation, the purposive interpretation would not have any role to play and those provisions are to be given their literal meaning.

8. He also questioned the observations of the learned Single Judge that entertaining pre-grant opposition in the manner in which filed by the appellant would lead to misuse of such a provision. His submission was that insofar as frivolous objections are concerned, those could be ignored and sufficient safeguard is provided in Rule 55 of the Rules.

9. Mr. Maninder Singh, learned Senior Counsel appearing for the respondent No. 5 refuted the aforesaid arguments and submitted that the learned Single Judge had, in a well reasoned judgment, countered these very arguments. He made additional submissions in support of the view taken by the learned Single Judge which we shall advert to while analyzing the plea raised by the appellant.

10. First question that arises for consideration is as to what is the nature and effect of the order dated 23.8.2006, viz., whether this order grants patent as a whole or it is conditional order and the patent would be treated as granted only when the purported conditions are satisfied. As pointed out above, pre-grant opposition of SDL was rejected by the aforesaid order. A perusal of the order would show that various contentions in opposition to grant of patent claimed by the respondent No. 5 were considered threadbare by the Controller. Order runs into 11 pages. Each and every objection of SDL was dealt with, but no merit was found therein. After rejecting the said objections, the Controller stated, "I hereby order to grant patent (Patent No. 194638) on the patent's application....." However, this sentence is followed by the words "with the following conditions". Counsel for the respondent No. 5 submits that vide aforesaid orders, patent had been granted. On the contrary, it is the submission of the appellant that this order was conditional and the respondent No. 5 was ordered to give the cross reference to the patent application on page 2 of the complete specification. This order could not be read as granting patent on the date of passing the order.

11. We are unable to accept the submission of the learned counsel for the appellant. The condition imposed was only in the nature of giving routine information, i.e., to give complete specification and submit the amended retyped page(s) within a week from the date of these orders. It had no substantial bearing on the issue which had already been decided. Even the opposition application had been disposed of by that order. The plea of the appellant that it was incomplete application in the absence of those particulars is to be countenanced inasmuch as had there been a material of irregularity, the Controller would not process that application at all. This was in the nature of a formality to be completed.

12. It is rightly pointed out by Mr. Maninder Singh that as per the schemes of the Act, the application is filed u/s 5 of the Act and after 18 months, there is a publication of patent application u/s 11A of the Act and it takes 48 months to examine the request u/s 17B of the Act. Examination takes place as per Section 12(1) of the Act. It is thereafter stage of filing of application takes place in terms of Section 25(1) of the Act. Thus, by that time, opposition is received, Controller has examined the feasibility of grant of the application at that level and the same is found to be in order. Otherwise, the Controller could reject the application at that stage also. Once the opposition is filed, hearing on the said opposition is in terms of Rule 55 of the Rules. Therefore, the moment the pre-grant opposition is rejected, the Controller is empowered to pass the order of grant of patent which in fact, happened in the present case. It was not a conditional order as contended by the appellant.

13. It is in this backdrop we determine as to whether the date of grant of patent is 23.8.2006 when the order was passed by the Controller or it is the date when grant of patent certificate was issued in terms of Section 43 of the Act. Here also, we agree with the view taken by the learned Single Judge. We have already

indicated the scheme of the Act with reference to various provisions which is taken note of by the learned Single Judge as well in greater details. From the filing of the application till its examination and publication thereafter minimum 18 months time is taken. The patent cannot be granted before the expiry of six months u/s 11A of the Act. This so is provided under Rule 24 of the Rules. It means that at least for a period of two years from the date of application, no patent can be granted. Though this is the minimum period. We can judicially take note of the fact that actual time can be much more. The patent's life is 15-20 years. However, the date from which the patent is granted is the date of application. Thus, the period from date of application till the date of grant of patent stands reduced. Provisions have to be read keeping in view the aforesaid position in mind. It is also pertinent to mention that even after patent is granted, remedies are available to any person opposing the said grant inasmuch as post-grant opposition can be filed u/s under Section 25(2) of the Act and revocation application can be filed u/s 64 of the Act. Sequence of various proceedings involved under the Patents Act, 1970 related to grant of patent is as under:

Sections

Rules

Section 7 Application for grant of patent

Section 11A Publication of the application for the purposes of inviting opposition u/s 25(1) of the Act.

Rule 24 & Rule 24A After 18 months from the date of filing of the application. However, it is open to the applicant to move an application seeking early publication.

Section 11B Request for examination of the patent application by the applicant or a person interested.

Rule 24B A request for examination is required to be made within 48 months from the date of filing of the application or priority whichever is earlier.

Section 12 Examination of the patent application by the examiner and preparation of First Examination Report.

Rule 24B(3) FER is to be issued within six months from the date of publication of the patent application or the date of request for examination whichever is later.

Section 15 Controller can refuse the grant of patent to an application when it fails to comply with the provisions of the Patents Act, 1970 or require amendment of the application.

Section 25(1)

Rule 55

Pre-grant opposition by way of a representation by any person after publication u/

s 11A but prior to the grant of a patent.

Deals with the procedure of pre-grant opposition. Rule 55(1A) No patent shall be granted within six months from the publication of application u/s 11A. Rule 55(2) Representation to be considered only after a request for examination has been filed. Therefore, proceedings u/s 25(1) related to pre-grant opposition and u/s 12 related to examination are co-terminus. Rule 55(6) After considering the representation and submissions made during the hearing, the Controller shall proceed further simultaneously either rejecting the representation and granting the patent or accepting the representation and refusing the patent on the application.

Section 25(2) Post-grant opposition by a person interested any time after the grant of patent till the time of expiry of 1 year of the publication of the factum of grant of patent u/s 43(2).

Rule 55A Filing of pre-grant opposition notice. Rule 56 Constitution of the opposition board. Rules 57-61 Completion of pleadings and filing of docs.

Section 25(4) Controller has the power to maintain, amend or revoke the grant of a patent in a post-grant opposition.

Rule 62 Hearing in a post-grant opposition and decision of the Controller.

Section 43(1) Deals with the grant of a patent

Rule 37 On the grant of patent, the application shall be accorded a number, which shall be the number of the granted patent. Rule 74(1) Patent certificate having the patent number as accorded under Rule 37 shall be prepared. Rule 74(2) Patent certificate shall be issued within 7 days of grant of a patent.

Section 43(2) Publication of the fact that a patent has been granted

Rule 74A Inspection of the patent documents after the publication of a grant of patent.

Section 45(2) No infringement proceedings can be initiated after the grant of patent for acts done prior to the publication of patent application u/s 11A

Section 48 Rights of patentee

Section 53 Term of patent.

Section 57

Amendment of application and specification or any related document before the Controller including both pre-grant and post-grant

Rule 81(2) Amendment of specification prior to grant of patent. Rule 81(3)(a)

Amendment of specification after the amendment

grant of patent.

Section 64 Revocation of patents

Section 67 Register of patents

Rule 88(1) Upon the grant (SEAL omitted) of patent, particulars of the patentee, date of grant etc. shall be entered into the register. Rule 88 (2) Controller shall enter into the register of patents particulars regarding proceedings under the Act of before the Controller/IPAB/High Court.

Section 153 Information related to patents

Rule 134(g) Information as to whether a patent has been granted in respect of an application can be obtained.

Rule 142 (4) Fee payable within 3 months from the date of recording the patent in the register.

14. We, thus, agree with the conclusion of the learned Single Judge that when the pre-grant opposition is rejected and no other opposition is pending on that date and the order is passed granting patent, patent stands granted on that date, which is 23.8.2006 in the present case. It is also to be kept in mind that as per the unamended provisions of Section 25 of the Act, a person interested in opposing the grant of patent has to necessarily file such an opposition within four months. This period now stands extended and in opposition can be filed before the grant of patent. Though theoretically, minimum period is six months, in any case, in practice, the period is much larger as new opposition can emerge at any time during the pendency of one or other pre-grant opposition. If the contention of the appellant is accepted, it would lead to misuse of the provisions inasmuch as once the pre-grant opposition of one person is rejected, before a certificate u/s 43 is issued, other person at the behest of the first objector can file the objection and adopting such methodology the proceedings can be delayed endlessly. In fact, this very case demonstrates this misuse. Mr. Maninder Singh had highlighted the following sequence of events to establish nexus between the appellant and SDL:

Date

Appellants

SDL

14.6.2000

Applications (590/Del/2000 & 593/Del/2000) for grant of patent filed by respondent No. 5 in respect to its products HCV TRI-DOT (Third Generation and Fourth Generation)

Applications (590/Del/2000 & 593/Del/2000) for grant of patent filed by respondent No. 5 in respect to its products HCV TRI-DOT (3rd Generation and

4th Generation)

14.6.2001

In pursuance to its patent applications related to HCV TRI-DOT (Third and Fourth Generation), J Mitra filed the Complete Specifications as per the provisions of the Patent Act, 1970.

In pursuance to its patent applications related to HCV TRI-DOT (Third and Fourth Generation), J Mitra filed the Complete Specifications as per the provisions of the Patent Act, 1970.

20.11.2004

Date of publication of patent applications in the Official Gazette of the Government

Date of publication of patent applications in the Official Gazette of the Government

21.3.2005

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Span files an opposition against the said patent applications.

26.6.2006

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Pleadings completed. Hearing held in the opposition to 590/Del/2000 (HCT TRI-DOT 3rd Generation)

30.6.2006 & 12.7.2006

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Pleadings completed. Hearing held in the opposition to 593/Del/2000 (HCV TRI-DOT 4th Generation).

23.8.2006

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Order rendered by the Assistant Controller of Patents dismissing the aforesaid Oppositions and granting patents in favour of J. Mitra.

24.8.2006

Snehlata Gupte files a letter and Statement of case before Patent Office opposing the two patent application of the Respondent No. 5. The timing is

interesting inasmuch as the said representation is filed the very next day of the order passed by the Asst. Controller of the Patents dismissing Span's opposition.

05.9.2006

Girish Rindani files a letter and Statement of case before Patent Office opposing the two patent application of the Respondent No. 5. The timing is interesting inasmuch as the said representation is filed a few days after the passing of the order by the Asst. Controller of the Patents dismissing Span's opposition.

15. Mr. Singh also argued that the present appeals have been filed by the appellants at the behest of Span Diagnostics Limited (a business rival of the respondent No. 5) as they are connected to each other. It is of importance to note that Dr. Snehlata Gupte runs Surat Raktadan Kendra, whose Chairman is the main promoter of Span Diagnostics. Further, she is also a member of Span Diagnostics part-time research team and Dr. Girish Rindani is a consultant for Span Diagnostics. It is imperative to state herein that there has been no denial on part of Appellants to the effect that they are not related or associated with Span Diagnostics. In fact, in the rejoinder affidavit it has been stated on behalf of the appellants that:

..... I further say that the same (the relationship between them and Span Diagnostics limited) has no bearing on the present case. It is immaterial for the purposes of the present writ petition whether the person who files a pre-grant opposition is related or not related to a party who is interested in the concerned patent being granted.....

16. Prima facie we agree with the aforesaid submissions of Mr. Maninder Singh. Be as it may, we are at pains to reiterate that the date on which the patent is granted cannot be the date of issuance of certificate but has to be the date on which orders are passed by the Controller. Certificate is in the nature of execution of that order and is proof of fact that the patent has been granted which is the date on which the Controller passed the order. It is the date on which the decision is taken by the Controller on file in respect of a pre-grant opposition (either rejecting or accepting the representation) which is the determining event ascertaining the date of grant of patent. The sealing of patent and entering of the same in the register are ministerial acts which follow the Controller's act of grant of patent. The onus is on the person instituting the pre-grant opposition to be vigilant about the date of publication of the application u/s 11A of the Act and take appropriate steps for filing the representation.

17. We find that the learned Single Judge has issued various directions. The Government has even implemented the direction relating to previous announcement of the date of pronouncement of the order. These directions would go a long way in discouraging frivolous petitions and checking misuse. We command the Patent Office to issue directions/instructions in terms of Paras 55 to 58 of the order of the learned Single Judge. Finding no merit in these appeals, we dismiss the same with cost quantified @ Rs. 25,000/- each.