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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Date of Decision: 8th December, 2023

+ **C.A.(COMM.IPD-PAT) 268/2022 & I.A. 24364/2023**

PROCTER AND GAMBLE COMPANY Appellant

Through: Mr. Hari Subramaniam & Mr. Sanuj
Das, Advocate.

versus

CONTROLLER OF PATENTS AND DESIGNS Respondent

Through: Mr. Harish Vaidyanathan Shankar,
CGSC, with Mr. Srish Kumar Mishra,
Mr. Alexander Mathai Paikaday &
Mr. Krishnan V., Advs.

CORAM:

JUSTICE PRATHIBA M. SINGH

JUDGMENT

PRATHIBA M. SINGH, J.

1. This hearing has been done through hybrid mode.
2. The present appeal under Section 117A of the Patents Act, 1970 (hereinafter 'the Act') was originally filed by the Appellant- Procter & Gamble Company before the Intellectual Property Appellate Board (IPAB) in the year 2019. Thereafter, consequent upon the abolition of the IPAB, upon the enactment of the Tribunals Reforms Act, 2021, the present appeal stood transferred to this Court.
3. The Appellant patent applicant has filed the appeal challenging the impugned order dated 8th October, 2018, passed by the Respondent-Controller of Patents and Designs. Vide the said order the Appellant's patent application titled 'DETERGENT COMPOSITIONS' bearing Indian Patent



Application No. 5444/DELNP/2007, having a priority date of 22nd February, 2005 was refused. The said patent application was refused, on the ground of lack of inventive step under Section 2 (1)(ja) of the Act, citing two prior art D1- US-5869438 and D2- WO00/60063.

4. Mr. Hari Subramaniam, Id. Counsel for the Appellant submits that the impugned order was passed by the Deputy Controller, four years after the oral hearing of the subject matter which took place on 29th September, 2014.

5. It is also emphasized that on 5th October, 2018, certain clarifications were sought from the Applicant through an e-mail communication. The said email was sent on a Friday and before the Applicant could even respond to the said objection, the decision came on the next working day i.e., on Monday, 8th October, 2018.

6. He further submits that under Section 8(2) of the Act, which was the subject matter of the e-mail notice dated 5th October, 2018, the Applicant had six months' time-period to furnish the requisite details and to respond to the e-mail of the patent office. However, without waiting for the reply of the Applicant, the patent application was refused on the ground of lack of inventive step.

7. It is his submission that the impugned order is not sustainable on these grounds as the same is contrary to the principles of natural justice.

8. Mr. Harish V. Shankar, Id. CGSC has accepted notice in this matter.

9. The Court has considered the impugned order, the documents on record and the grounds raised.

10. Clearly, it is evident from the chronology of events that have transpired before the Patent Office that after the matter was reserved for



orders on 29th September, 2014, a notice under Section 8(2) of the Act was issued by the Patent Office on 5th October, 2018. The said email issued by the Controller is extracted below:

“Dear Sir/Madam,

It has been observed that in application no 5444/DELNP/2007, you have not filed document related to section 8(2) details. Last correspondence is about 5444-delnp-2007-Others-(23-07-2015).pdf.

***Please file the section 8(2) details.** Document related to opposition proceeding in EP is not available. Please, submit the document regarding details under section 8(2) detail, along with petition.*

Please provide the support of claimed enzyme with claimed substitution from working example, if any.

You have filed amended set of claims on 5444-delnp-2007-Claims-(12-11-2014).pdf. You have defined the concentration of component by 0%, which is main component aluminosilicate and phosphate builder. This 0% concentration of ingredient aluminosilicate and phosphate builder make the detergent composition unclear.

In case applicant lost interest, please inform us.

Thank You.

MonikaYadav

Deputy Controller of Patents and Designs.”

11. As per the above e-mail, the Deputy Controller had called for the details of Section 8(2) filings for the corresponding patent applications. In addition, the documents relating to the opposition proceedings in the European Patent Office (*hereinafter, EPO*) were also called for. Certain data and working examples in support of the claimed enzymes were also directed to be submitted. A clarification was also sought in respect of one of the features of the invention. This communication having been issued four years after matter was reserved for orders, the Patent Office ought to have waited



before passing the final order.

12. However, in an unpredictable twist of events, the impugned order was passed on 8th October, 2018 on the next working day itself.

13. The above manner of dealing with a patent application is extremely arbitrary and whimsical. Firstly, when the judgment was reserved on 29th September, 2014, there was an obligation on the Hearing Officer to pass orders within a reasonable period. The time of four years which has been consumed is completely contrary to the scheme of the Act and Rules as also frustrates the purpose of patent filings. This entire period in fact works against the applicant who loses the life of the patent.

14. Thereafter, the patent office, after having sought a clarification and certain documents on 5th October, 2018 suddenly proceeds to pass orders rejecting the patent application on 8th October, 2018 without giving an opportunity to the Appellant to deal with the issues raised in the communication of 5th October, 2018.

15. Such a course of action by the Patent Office would be contrary even to the Patent Rules, 2003 (*hereinafter, the Rules*) which require the office to give at least a period of six months in respect of information sought under Section 8(2) of the Act. The said Rule i.e., Rule 12 of the Rules is extracted below:

“12. Statement and undertaking regarding foreign applications.—

.....

(3) When so required by the Controller under sub-section (2) of section 8, the applicant shall furnish information relating to objections, if any, in respect of novelty and patentability of the invention and any other particulars as the Controller may require which may include claims of



application allowed within six months from the date of such communication by the Controller”

16. Further, this court refers to Sections 14 and 21 of the Act and Rule 24(B) of the Rules to ascertain the timelines for completion of the patent prosecution. The said provisions are reproduced herein below:

“14. Consideration of the report of examiner by Controller.—Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or other documents to ensure compliance with the provisions of this Act or of the rules made thereunder, the Controller, before proceeding to dispose of the application in accordance with the provisions hereinafter appearing, shall communicate as expeditiously as possible the gist of the objections to the applicant and shall, if so required by the applicant within the prescribed period, give him an opportunity of being heard.

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 subsection (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

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 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) Where the request for examination has been filed under sub-rule (1) and application has been published under section 11A, the Controller shall refer the application, specification and other documents related thereto to the examiner and such reference shall be made in the order in which the request is filed:

Provided that in case of a further application filed under section 16, the order of reference of such further application shall be the same as that of the first mentioned application:

Provided further that in case the first mentioned application has already been referred for examination, the further application shall have to be accompanied by a request for examination, and such further application shall be published within one month and be referred to the examiner within one month from the date of such publication.

(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 statement of objections, along with any documents as may be required, shall be issued by the Controller to the applicant or his authorised agent within one month from the date of disposal of the report of examiner by the Controller:

Provided that where the request for examination was filed by a person interested, only an intimation of such examination may be sent to such person interested.

(4) Reply to the first statement of objections and subsequent reply, if any, shall be processed in the order in which such reply is received.

(5) The time for putting an application in order for grant under section 21 shall be six months from the date on which the first statement of objections is issued to the applicant to comply with the requirements.

(6) The time for putting an application in order for grant under section 21 as prescribed under sub-rule (5) may be further extended for a period of three months on a request in Form 4 for extension of time along with prescribed fee, made to the Controller before expiry of the period specified under sub-rule (5).

17. A perusal of Sections 14, 21 of the Act along with Rule 24(B) of the Rules would show that there are strict timelines which are prescribed both in the Act and the Rules right from the filing of request of examination, preparation of the examination report by the examiner of patent, consideration of the examiner's report by the Controller, issuance of statement of objections, reply to statement of objections and the time for putting the application in order for grant.

18. The said timelines reflect the intention of the Legislature to ensure that no unnecessary delays are caused in the process of grant of patents. Though no specific time period has been prescribed for passing of orders



after concluding oral hearings, the Patent Office is expected to pass the same within a reasonable period. Such a reasonable period cannot be beyond three to six months in any case, depending on the complexity of the case.

19. In the present case, a period of four years has elapsed after the hearing when the order was passed finally by the Patent Office, that too after issuing a notice under Section 8(2) of the Act for which adequate time for reply was not granted.

20. In these circumstances, the impugned order is set aside and the following directions are issued:

- i) The Patent Office shall reflect the change of status of the present application on its website and show the same as pending within two weeks.
- ii) Upon the same being reflected as pending, the Appellant shall, by 15th January, 2024 respond to the notice dated 5th October, 2023 and furnish all the requisite information by 15th January 2024.
- iii) Thereafter, hearing be held in the first week of February, 2024 and upon conclusion of the hearing, within three months the final order may be passed.

21. The matter is remanded for fresh consideration. A fresh hearing shall be held on all the objections which are already raised in the hearing notices. No fresh objections shall be raised. The matter shall be heard afresh and a final decision shall be taken within three months.

22. The Controller General of Patents, Designs and Trade Marks shall appoint a different officer for hearing of the present matter.

23. List the matter for directions before the Patent Office on 23rd December, 2023.



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24. The appeal is disposed of in the above terms. All pending applications are also disposed of.

25. Let the Registry communicate a copy of the present order to the office of the Controller General of Patents, Designs & Trademarks of India on the e-mail- llc-ipo@gov.in for compliance of this order. The record of the present appeal be also emailed or despatched to the said office.

PRATHIBA M. SINGH
JUDGE

DECEMBER 08, 2023

Rahul/bh

(corrected & released on 12th December, 2023)