



2024:DHC:7431



* IN THE HIGH COURT OF DELHI AT NEW DELHI

Reserved on: September 11th, 2024

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Pronounced on: September 26, 2024

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W.P.(C)-IPD 17/2024

BRY-AIR (ASIA) PVT. LTD.

..... Petitioner

Through: Ms. Swathi Sukumar, Mr. Naveen
Nagarjuna Ritik Raghwanshi and
Mr. Rishubh Agarwal, Advocates

versus

**UNION OF INDIA, THROUGH ITS SECRETARY,
DEPARTMENT FOR PROMOTION OF INDUSTRY AND
INTERNAL TRADE, MINISTRY OF COMMERCE AND
INDUSTRY & ANR.**

.....Respondents

Through: Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. Srish Kumar
Mishra, Mr. Alexander Mathai
Paikaday, Advocates.

CORAM:

HON'BLE MR. JUSTICE SAURABH BANERJEE

JUDGMENT

1. The petitioner filed Indian Patent Application No. 4154/DEL/2015 (hereinafter referred to as "*subject application*") on 18.12.2015. The said subject application was then published on 19.01.2018. Thereafter, on 18.12.2019, though it was the due date for filing Form 18 of the Patents Act (hereinafter "*Act*") for request for examination of the subject application, despite best efforts, the erstwhile Patent Agent who was handling the portfolio of the petitioner failed to file the said Form 18 (Request for examination of the application for patent). This was also despite that the petitioner was assured that the said erstwhile Patent Agent



had taken all the requisite actions with respect to the subject application and status “*Deemed to be withdrawn u/s 11B(4)*” thereof as reflecting on the official website “<https://ipindia.gov.in/trade-marks.html>” of the respondent no.2 was incorrect and furthermore that the said erstwhile Patent Agent was in contact with Office of the respondent no.2 for rectifying the records pertaining to the subject application.

2. After going through the entire portfolio handled by the erstwhile Patent Agent, the petitioner found that many of its patent applications had been abandoned or had lapsed due to non-renewal. Upon deliberations, with the erstwhile Patent Agent regarding the petitioner’s loss of rights and the matrix of events, the said erstwhile Patent Agent gave/ provided an affidavit dated 26.02.2022 confirming that the petitioner had no fault or intention to abandon any of the applications/ patents, stating therein as under:-

“7. That the non-response to the First Examination Report dated is due to no fault of the Applicants particularly since it was not received either by email or regular post.”

3. Based thereon and the surrounding factors, the petitioner had been able to reinstate various patent application all over the world. In fact, the very same petitioner had also filed ***Bry-Air Prokon SAGL & Ors v. Union of India & Anr.*** [WP (C)-IPD No. 25 of 2022] before this Hon’ble Court which was duly allowed in its favour vide order dated 17.10.2022. As a result, seven of its other similarly situated patent applications as also other patent granted to the petitioner, were reinstated. In fact, it is recorded in the said judgment that the petitioner herein was not negligent or did they have any intention to abandon their patent application.



4. In the interregnum, the European Patent (EP) No. 16845330, which is corresponding to the application that is the subject of the present writ, which was also abandoned for the same reasons, has since been reinstated vide order dated 31.05.2023 passed by the European Patent Office.

5. Now, the instant subject application of the petitioner has been jeopardized for no fault of theirs, more so, since the petitioner has already spent a huge amount of money for the reinstatement thereof.

6. Consequently, faced with the aforesaid situation, the petitioner has filed the present writ petition seeking quashing of the status update of “*Deemed to be withdrawn u/s 11B(4)*” issued by the respondent no.2 for the subject application of the petitioner as it was deemed to be withdrawn under *Section 11B(4)* of the Patents Act (hereinafter “*Act*”) for non-filing of a request for examination of the patent application within the time specified as also a direction to the respondent No.2 to restore the said subject application to its original position and afford an opportunity to the petitioner to file FORM 18 (Request for examination of the application for patent) of the Act, so that the Indian Patent Office can proceed with the examination of the patent application no. 4154/DEL/2015, as the IPO normally would thereafter.

7. As per the petitioner, the aforesaid non-filing and the subsequent issuance of order under *Section 11B(4)* of the Act is wrong since the petitioner had every intention of complying with the statutory timelines mandated by the Act. However, it was only because of erstwhile Patent Agent it lost the opportunity leading to the abandonment of subject application. Therefore, since there was no fault/ mistake/ negligence on its part, it cannot be penalized for an error/ negligence on the part of its



erstwhile Patent Agent. On the contrary, the petitioner had done its part by following its erstwhile Patent Agent regarding status of the subject application.

8. This Court, while issuing notice on 11.07.2024 granted time to the respondents, who were present in Court that day, for filing their counter-affidavit. However, the learned counsel for respondents submitted that in view of an earlier pronouncement by a learned Single Judge in ***Bry-Air Prokon SAGL & Ors. (supra)*** regarding similar facts, there is no requirement of filing any counter-affidavit.

9. After hearing the learned counsel for the parties as also going through the pleadings and documents on record, this Court finds that the present writ petition is predicated on the facts involving the deemed withdrawal of a subject application under *Section 11B(4)* of the Act for non-filing of a request for examination of the patent application within the time specified.

10. As admitted by the learned counsel appearing for the parties, the said issue has already been adjudicated by a learned Single Judge of this Court on 17.10.2022 in WP (C)-IPD No.25/2022 entitled ***Bry-Air Prokon SAGL & Ors. (supra)*** holding as under:-

“19. From a reading of the aforementioned judgments, the position of law that emerges is that Courts while exercising writ jurisdiction have extended the time for filing response to the FER in extraordinary situations, where Patent Agents were found to be negligent in prosecuting the Patent Applications, with no contributory negligence of the Applicant and on showing that the Applicant had a positive intent to prosecute. It is equally settled that ‘Abandonment’ requires a conscious act on the part of the applicant, which would manifest the intention to abandon and no presumptions can be drawn in this respect. It also needs no reiteration that deemed abandonment of the application for grant of patent, leads to serious impact on the valuable rights of the patent



applicant, which flow in favour of an invention and this is compounded by the fact that under the statutory scheme, no appeal is provided against an order of deemed abandonment of the application for patent under Section 21 of the Act. Therefore, each case would require examination on its own facts and circumstances to see the intent of the applicant to abandon.

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23. *It is a settled position of law that errors/negligence on part of the patent agent without any contributory negligence on the part of the Applicant, has been liberally considered by the Courts, as the consequences of a patent application being abandoned or the lapsing of a patent due to non-deposit of renewal fee are very serious, where the applicant loses his right of claiming exclusivity to an invention.*

24. *A caveat may, however, be added that the Court must exercise the writ jurisdiction only in extraordinary circumstances. In **European Union Represented by the European Commission (Supra)**, the Court has rightly cautioned that the intention of the Legislature in Rule 138 of the Rules as well as the mandate in Section 21(1) of the Act cannot be ignored and failure to adhere to the timelines must be visited with serious consequences. In the facts and circumstances of the present case, this Court is of the view that there is no fault or negligence on the part of the Petitioners and therefore, they should not suffer for the fault or negligence of the Patent Agent, and the present case fits into the exception of 'extraordinary circumstances'. Petitioners are thus entitled to file a response to the FERs with respect to the six patent applications so that they can be processed further.*

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26. *Relevant would it be to note that in **European Union Represented by the European Commission (Supra)**, patent applications were restored by the Court on account of the negligence of the Agent which coincidentally happens to be the same agent as in this Court and as rightly pointed by the Petitioners in the said case albeit in the case of the patent applications, the writ petition was allowed extending periods of 40 months and 38 months respectively, in respect of two patent applications. In **PNB Vesper Life Science Pvt. Ltd., Represented by its Director Mr. P.N. Balaram v. Controller General of Patents, Designs & Trademarks, 2022 SCC OnLine Mad 3190**, it was held that if there is nothing on*



record which indicates that Petitioner has willfully neglected, benefit of doubt must be given and this is an embodiment of a fact which cannot be gleaned over that valuable rights vest in a patentee on grant of a patent and therefore, if the Applicant is not at fault, he should not be deprived of his rights to enjoy the fruits of his skill, hard work and labour.

27. In OA/18/2014/PT/KOL titled as Rubicon Research Pty Ltd. v. The Controller General of Patents, Designs and Trademarks and Ors., decided on 21.08.2020, the patent application was filed on 17.02.2003, which matured into a grant of patent on 02.03.2007. On 24.05.2007, the Patent Agent sent a letter to the Australian Agents of the Appellants therein, intimating the grant of patent and for payment of 3rd-7th annuities, which was a week before the due date. The Agent sought instructions for payment and a debit note was raised, which was cleared by the Appellants within the extendable period of 9 months under Section 142(4) of the Act. After a gap of two and a half years, the Patent Agent informed the Appellants that the patent had lapsed due to non-payment of annuity. The application for restoration was rejected by the Controller. The IPAB, however, held in the facts of the case that prejudice would be caused to the Appellant in case it lost the patent rights for fault and negligence of the Agent and the order of the Controller was set aside, finding the same to be unreasonable. It bears repetition in the present case that on account of the admitted negligence of the Agent, there is no plausible reason why the Petitioners should suffer.

28. There is an added reason why this Court is inclined to permit the Petitioners to file for restoration of the patent. As noted above, the period of three months under Section 142(4) of the Act for payment of annuities expired on 27.05.2018. An extended period of six months from the said date was available to the Petitioners for payment of annuities under Section 142(4) of the Act. Additionally, under Section 60(1) of the Act, Petitioners are entitled to make an application for restoration of the patent within 18 months from the date on which the patent ceased to have effect. If the first Patent Agent had been diligent, the annuities would have been deposited by 27.05.2018 or within the extended period expiring on 27.11.2018, on the extension being sought. As per the provisions of the Act, if the fee was not paid within the extended period, Petitioners were entitled to approach the Controller upto 27.05.2020 under Section 60(1) of the Act. Since the Petitioners were unaware of the non-prosecution by the first Patent Agent and in depositing the annuities, the benefit of the extended period of 6



months was lost. Insofar as the 18 months period available to an Applicant under Section 60(1) of the Act is concerned, as rightly contended by the Petitioners, a part of this period overlapped with the Pandemic COVID-19 and they are entitled to the benefit of the extension of limitation period by the Supreme Court in SMWP (C) No. 3/2020 In Re: Cognizance for Extension of Limitation. Vide order dated 10.01.2022, the Supreme Court directed that in cases where limitation would have expired between 15.03.2020 to 28.02.2022, notwithstanding the actual balance period of limitation remaining, limitation shall extend for a period of 90 days from 01.03.2022. As averred in the appeal, Petitioners have approached the Controller albeit with a representation on 12.05.2022, seeking restoration of the patent and are squarely covered by the said judgment. Looking at the extraordinary facts and circumstances of this case, as aforementioned, in my view, it would be a travesty of justice if on technical grounds the Patent is allowed to lapse. Petitioners are thus held entitled to file an application for restoration, in the prescribed Form along with the prescribed fee, within a period of 4 weeks from today.”

11. Additionally, since the petitioner had neither an intention to abandon the subject application nor had committed any mistake on its part, this Court must be liberal in its approach in allowing the present writ petition, especially since the petitioner cannot be saddled with the deemed withdrawal of the subject application. For this, this Court finds support in ***The European Union Represented by The European Commission V. Union of India & Ors.*** [W.P.(C)-IPD 5/2022 & 6/2022, decided on 09.06.2022] wherein a learned Single Judge of this Court held as under:-

“53. The present writ petitions clearly highlight the important role of patent agents in prosecuting patent applications. In these cases, it is seen that the Applicant had no intention to abandon the application at all. Firstly, after the filing of the patent application in 2012, the request for examination was filed within the time prescribed. Secondly, even when there was a change in the law firm in Europe in 2017 which was coordinating the prosecution of the patent, the Indian patent agent was duly notified of the said fact. The first patent agent had even confirmed the receipt of the said instructions. Thirdly, there were repeated attempts through email to contact the first patent agent and follow up was done on the status of the



Petitioner's applications.

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56. It is unclear as to whether the said patent agent in fact informed the Applicant about the issuance of FER on record. The Applicant appears to have been in the dark about the issuance of the FER and subsequently events unfolded which revealed that the first agent may not have acted diligently and a new Patent agent had to be engaged. Until the second patent agent was engaged in February, 2019, the Applicant had no communication of the FER itself or the non-filing of the reply and finally the consequential abandonment. When the second patent agent became aware of the abandonment of the application, steps were taken to file reply to the FER. Clearly, the chronology of the facts and events set out herein above leave no doubt in the mind of the Court that the Applicant was not negligent and was in fact taking all steps within its command to follow up on the prosecution of the patent application. However, for reasons beyond its own control, the consequence of abandonment has now been saddled upon the Applicant.

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58. The decisions discussed above would show that inadvertent errors or errors of patent agents have been liberally considered by the Court. The consequences of patent being abandoned is quite extreme i.e., the Applicant is deprived of exclusivity for the invention completely. In the opinion of the Court, such a consequence ought not to visit the applicant for no fault of the Applicant. In the facts of these cases, the Applicant had no intention to abandon the application. It has taken all measures possible to prosecute these applications. The Applicant was conscious of the fact that the patent may be maturing for examination and took the initiative to keep in touch with the patent agent from the very inception.

59. Therefore, the question that arises is whether this Court while exercising writ jurisdiction under Article 226 and 227 ought to condone the delay and restore the patent applications of the Petitioner.

60. The Court is convinced that there was no intention to abandon on behalf of the Petitioner, instead, the Petitioner's actions indicate that they were actively pursuing the application. Moreover, the judicial opinion in respect of responses to FER or other deadlines seems to suggest that if the Applicant did not have an intention to abandon



and if the Court is convinced that there was a mistake of the patent agent and the Applicant is able to establish full diligence, the court ought to be liberal in its approach.

61. In the opinion of this Court, the mistake of the patent agent would be similar to the mistake of an advocate who may be representing parties in any civil or criminal litigation. Insofar as any mistake committed by counsels/advocates are concerned, the settled legal position is that the litigants ought not to suffer, as has been laid down by the Supreme Court in a number of decisions including **Smt. Lachi Tewari & Ors. v. Director of Land Records 1984 Supp. SCC 431**; **Rafiq & Anr v. Munshilal (1981) 2 SCC 788**; **Mangi Lal v. State of M.P. (1994) 4 SCC 564** and **The Secretary, Department of Horticulture, Chandigarh v. Raghuraj AIR 2009 SC 514**.

62. In view of the fact that no fault can be attributed to the Applicant, this Court is of the opinion that the Applicant ought not to be made to suffer. However, there is a word of caution that this Court would like to add in this regard. The intention of the Legislature in Rule 138 of the Rules cannot be ignored by the Controller, nor can one ignore the express language of Section 21(1) of the Act, which mandates a deemed abandonment in case of non-compliance with the requirements imposed under the Act. It is only in extraordinary cases, while exercising writ jurisdiction, that the Court may consider being flexible, and this would depend on the facts of each case as to whether a condonation ought to be given at all.”

12. Moreover, where the petitioner had done its part by duly following up with its erstwhile Patent Agent regarding its status and since it had no intention of abandoning the same, the petitioner ought not to suffer the consequences of its erstwhile Patent Agent. For this, this Court finds support in **Saurav Chaudhary v. Union of India & Anr. [W.P.(C)-IPD No. 9 of 2023 decided on 04.07.2024]** wherein recently a learned Single Judge of this Court under similar facts and circumstances held as under:-

“15. This position has been further reaffirmed in **Bry-Air Prokon Sagl & Ors. v. Union of India & Anr., 2022/DHC/4439** and in **W.P. Nos.12620&12621 of 2021 titled Chandra Sekar v. The Controller of Patents and Designs & Anr..** In the case of **Bry-Air Prokon Sagl & Ors. (supra)** the Court observed that the Petitioners should not suffer for the fault or negligence committed on behalf of the Patent



Agent when they have duly followed up with the Patent Agent and there is correspondence to that effect. The relevant portion of the said judgement is extracted below:

“23. It is a settled position of law that errors/ negligence on part of the patent agent without any contributory negligence on the part of the Applicant, has been liberally considered by the Courts, as the consequences of a patent application being abandoned or the lapsing of a patent due to non-deposit of renewal fee are very serious, where the applicant loses his right of claiming exclusivity to an invention.

24. A caveat may, however, be added that the Court must exercise the writ jurisdiction only in extraordinary circumstances. In *European Union Represented by the European Commission (Supra)*, the Court has rightly cautioned that the intention of the Legislature in Rule 138 of the Rules as well as the mandate in Section 21(1) of the Act cannot be ignored and failure to adhere to the timelines must be visited

with serious consequences. **In the facts and circumstances of the present case, this Court is of the view that there is no fault or negligence on the part of the Petitioners and therefore, they should not suffer for the fault or negligence of the Patent Agent, and the present case fits into the exception of ‘extraordinary circumstances’. Petitioners are thus entitled to file a response to the FERs with respect to the six patent applications so that they can be processed further.**

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neglected, benefit of doubt must be given and this is an embodiment of a fact which cannot be gleaned over that valuable rights vest in a patentee on grant of a patent and therefore, if the Applicant is not at fault, he should not be deprived of his rights to enjoy the fruits of his skill, hard work and labour.”

16. Moreover, where legal professionals are at fault, the Court has observed that in such cases the parties ought not to suffer the consequences of their Advocates. Considering that the parties have done everything within their limits and they may not even have the requisite resources to follow up their cases, sans the Advocate or Patent Agent. In ***Rafiq and Another v. Munshilal and Another, (1981) 2 SCC 788***, the Court observed that a party should not suffer for the inaction, deliberate omission, or misdemeanour of his Agent. The relevant portion of the said judgment is set out below:

“3. The disturbing feature of the case is that under our present adversary legal system where the parties generally appear through their advocates, the obligation of the parties is to select his advocate, brief him, pay the fees demanded by him and then trust the learned Advocate to do the rest of the things. The party may be a villager or may belong to a rural area and may have no knowledge of the court's procedure. After engaging a lawyer, the party may remain supremely confident that the lawyer will look after his interest. At the time of the hearing of the appeal, the personal appearance of the party is not only not required but hardly useful. Therefore, the party having done everything in his power to effectively participate in the proceedings can rest assured that he has neither to go to the High Court to inquire as to what is happening in the High Court with regard to his appeal nor is he to act as a watchdog of the advocate that the latter appears in the matter when it is listed. It is no part of his job. Mr A.K. Sanghi stated that a practice has grown up in the High Court of Allahabad amongst the lawyers that they remain absent when they do not like a particular Bench. Maybe, we do not know, he is better informed in this matter. Ignorance in this behalf is our bliss. Even if we do not put our seal of imprimatur on the alleged practice by dismissing this matter which may discourage such a tendency, would it not bring justice delivery system into disrepute. What is the fault



of the party who having done everything in his power expected of him would suffer because of the default of his advocate. If we reject this appeal, as Mr A.K. Sanghi invited us to do, the only one who would suffer would not be the lawyer who did not appear but the party whose interest he represented. The problem that agitates us is whether it is proper that the party should suffer for the inaction, deliberate omission, or misdemeanour of his agent. The answer obviously is in the negative. Maybe that the learned Advocate absented himself deliberately or intentionally. We have no material for ascertaining that aspect of the matter. We say nothing more on that aspect of the matter. However, we cannot be a party to an innocent party suffering injustice merely because his chosen advocate defaulted. Therefore, we allow this appeal, set aside the order of the High Court both dismissing the appeal and refusing to recall that order. We direct that the appeal be restored to its original number in the High Court and be disposed of according to law. If there is a stay of dispossession it will continue till the disposal of the matter by the High Court. There remains the question as to who shall pay the costs of the respondent here. As we feel that the party is not responsible because he has done whatever was possible and was in his power to do, the costs amounting to Rs 200 should be recovered from the advocate who absented himself. The right to execute that order is reserved with the party represented by Mr A.K. Sanghi.”

13. In any event and particularly for the aforesaid reasons, in cases of the present nature, the benefit of doubt ought to be extended to the suffering party like the petitioner. For this, this Court finds support in ***PNB Vesper Life Sciences v. Controller General of Patents*** [W.P. No. 22253 of 2021 decided on 14.03.2022] wherein recently a learned Single Judge of this Court under similar facts and circumstances held as under:-

“10. It is thus unclear as to who was at fault for the inaction, whether the petitioner or the agent.

11. Be that as it may, bearing in mind the purpose for which the



application is being pursued as well as the fact that the petitioner had applied for and had been granted the patent for the identical product in other jurisdictions, it does not stand to reason that a company engaged in Pharma research and for whom commercially expediency is paramount, will not pursue the applications in right earnest.

12. Nothing would indicate why the petitioner would willfully neglect to respond to an objection received from the patent office. Thus, the benefit of doubt in such circumstances must be given to the petitioner and I proceed on this basis.”

14. Also, abandonment *per se* ought not to be presumed as it is a question of intent. Therefore, in a situation like the present one where the express intentions and implied actions coupled with the overall conduct of the petitioner reflect that the petitioner was ever willing to pursue its subject application, the petitioner should not be made to suffer and benefit ought to be extended to it. For this, this Court finds support in ***Ferid Allani v. Union of India*** 2008 (37) PTC 448 wherein recently a learned Single Judge of this Court under similar facts and circumstances held as under:-

“41. It has been urged by the petitioner that the abandonment requires a conscious act on the part of applicant which would manifest his expressed intention to abandon the application and that there can be no presumption as has been drawn by the respondents in the facts of the instant case.

*42. My attention has been drawn to the observations in *Browning Manufacturing Co. v. Brothers Inc.*, 134 USPQ 231, wherein it was observed that the question of abandonment is fundamentally a question of intent, though express or implied by action or conduct. Abandonment is never presumed.”*

15. Accordingly, in view of the factual matrix involved as also the foregoing legal position, the present writ petition is allowed and the status



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update of “**Deemed to be withdrawn u/s 11B(4)**” issued by the respondent no.2 for the subject application of the petitioner as it was deemed to be withdrawn under *Section 11B(4)* of the Patents Act for non-filing of a request for examination of the patent application within the time specified is quashed and the respondent No.2 is directed to restore the said subject application to its original position and afford an opportunity to the petitioner to file FORM 18 (Request for examination of the application for patent) of the Act, so that the Indian Patent Office can proceed with the examination of the patent application no.4154/DEL/2015, as the IPO normally would thereafter.

16. Accordingly, the present writ petition is allowed in the aforesaid terms.

SAURABH BANERJEE, J.

SEPTEMBER 26, 2024

So