



2024: DHC: 137



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

% Reserved on: 05th January, 2024

Pronounced on: 08th January, 2024.

+ W.P.(C)-IPD 45/2023 & CM 150/2023

HARYANA PESTICIDES MANUFACTURES ASSOCIATION

..... Petitioner

Through: Mr. Shravan Kumar Bansal and
Mr. Ajay Amitabh Suman, Advs.

versus

ASSISTANT CONTROLLER OF PATENTS AND DESIGNS & ANR.

..... Respondents

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

**CORAM:
HON'BLE MR. JUSTICE ANISH DAYAL**

JUDGMENT

ANISH DAYAL, J.

1. This petition has been filed for quashing of impugned order dated 09th January 2023, passed by the Assistant Controller of Patents and Designs, Patent Office, Delhi, in pre-grant opposition under Section 25(1) filed by the petitioner against the impugned application by Respondent no. 2 for grant of patent title as "*Weedicidal Formulation and method of manufacture thereof under No.538/DEL/2010*". Further relief is sought for directions to respondent No.1,



the Assistant Controller of Patents and Designs, to revive the pre-grant opposition filed by the petitioner against the impugned application for grant of patent and dispose of the same after hearing the petitioner.

2. The petitioner is an association of pesticides manufacturers in Haryana whose members are involved in the trading business of pesticides, herbicides, insecticides, fertilizers, fungicides etc. for more than 15 years.

3. The background facts are as under:-

- (i) Respondent No.2 (Crystal Crop Protection Limited) filed the said patent application in 2010 with 11 claims before respondent No.1.
- (ii) On 09th October, 2013, the petitioner filed pre-grant notice of opposition under Section 25(1) of the Patents Act, 1970 (“the said Act”) challenging the said patent application. A request for personal hearing was made in the said opposition. Along with this notice of opposition, the petitioner gave their email for service as unitedpatent_ipr@sify.com and unitedmark@sify.com. Contact numbers, both landline and mobile, were also provided.
- (iii) Respondent No.1 issued first examination report on 30th May, 2017 to respondent No.2. On 05th July, 2017, the petitioner addressed a letter to the Controller of Patents intimating their change of the email ID from unitedmark@sify.com and unitedpatent_ipr@sify.com to patent@unitedipr.com and unitedpatent@unitedipr.com. Respondent No.2 filed their reply on 12th February 2018 to the First Examination Report.



- (iv) On 06th January, 2020, respondent No.2 filed reply and submission to the pre-grant opposition of the petitioner.
- (v) On 07th October, 2020, the petitioner claimed that the notice for hearing the pre-grant opposition on 10th November, 2020 was received by them on the old email ID unitedpatent_ipr@sify.com.
- (vi) On 07th November, 2020, the petitioner filed an adjournment request addressed from its new email ID, namely, unitedpatent@unitedipr.com and consequently the matter was adjourned. This was the first adjournment sought by the petitioner.
- (vii) On 09th November, 2020, notice for hearing the pre-grant opposition scheduled for 15th December, 2020 was served on the petitioner's agent at both the new email address patent@unitedipr.com and the old email address unitedpatent_ipr@sify.com.
- (viii) On 10th December, 2020, the petitioner filed an adjournment request addressed from its new email address unitedpatent@unitedipr.com and consequently the matter was adjourned. This was the second adjournment sought by the petitioner.
- (ix) On 08th September, 2022, a notice for hearing scheduled for 21st November, 2022 was sent on the old email address of the petitioner at unitedpatent_ipr@sify.com, which the petitioner claims he was unable to access.
- (x) On 09th January, 2023, the pre-grant opposition of the petitioner was dismissed *ex parte* the petitioner.
- (xi) On 12th September, 2023, a representation was filed by the petitioner regarding the inability of the petitioner to be present for the hearing



due to the lack of service. The petitioner claimed that they became aware of the rejection of their pre grant opposition only in the second week of September, 2023.

- (xii) The instant writ petition was filed before this Court and was listed on 30th October, 2023. This Court noted the sequence of dates as submitted by the petitioner as also the submissions of Mr. Harish Vaidyanathan Shankar, Central Government Standing Counsel who placed reliance on the provisions of the patent rules stating that there was a specific protocol which was required to be followed if a person sought change of address for service. The matter was re-notified for 31st January, 2024 and no interim order was passed by the Court.
- (xiii) On 18th December, 2023, pursuant to an application moved by the petitioner for advancing the date of hearing in the matter pleading that the time for filing post grant opposition would expire on 09th January, 2024, this Court fixed 05th January, 2024 as the date of hearing and the matter was heard and submissions of counsel for the petitioner as well as respondent Nos.1 and 2 were noted and judgment was reserved.

4. The submissions of the parties focused on three aspects:

- I. The actual sequence of events relating to the communications exchanged between the petitioner and respondent No.1 relating to notice of hearings. While the petitioner claims that their communications ought to have been sent on the new email address in 2022, the respondents draw attention to the fact that respondent No.2



was not obliged to send it to the new email address, since a proper communication for change of email address in accordance with the Act and the Rules had not been sent.

- II. The relevance and applicability of specific provisions of the Act and the Rules was contested. While the petitioner claims that there is no specific provision in Act and the Rules mandating communication for change of address in a particular form, the respondents submit that certain specific provisions do necessitate that a formal and proper communication be sent, and the respondent No.2 is not obliged to keep a track of a changed email address.
- III. The possibility of an alternative remedy in the form of post-grant opposition which subsists in favor of the petitioner. The petitioner claims that having not adhered to principles of natural justice at the stage of pre-grant opposition hearing, they had a vested right to seek a remedy and mere availability of post-grant opposition would not preclude them from doing so. The respondents claimed that the alternative remedy of post-grant opposition is fully available to the petitioner, and that the patent has now been granted after a substantial lapse of time, and respondent No.1 has only 6 years to enjoy the patent which was filed as far back as in 2010.

Analysis

I. Sequence of Events

5. As regards issue No.1, it was necessary to peruse the record in relation to the sequence of events. It is noted that the first communication by the



petitioner was the pre-grant opposition filed by them in October, 2013. The said opposition was signed off by Mr. S.K. Bansal, Advocate, registered Patent Agent and as an Agent for the petitioner. The following details were provided for address of service with the said opposition :-

Sudarshan Kumar Bansal
Advocate & Regd. Patent Agent
M/s United Overseas Patent Firm
52, Sukhdev Vihar, Mathura Road
New Delhi-110025
Telephone No.: (011)-2684-3455; 3295-9881
Fax No.: (011)-2682-8578; 2693-6783
Mobile No.: 9810132015
Email: unitedpatent_ipr@sify.com; unitedmark@sify.com

The letter which as per the petitioner communicated their change of emails was dated 05th July, 2017 and was addressed to the Controller of Patents and is extracted below for easy reference:

Dear Sir

I wish to state as under:

1. I am a registered patent agent with No. 353/INPA and have filed numerous patent applications for our clients in India and overseas.
2. We came across the office order No. 23 about updating the email ids by applicants which was not notified to public.
3. We request you to kindly update your records for files /Patent Applications with details as in appended Excel sheet for change in email ID from unitedpatent@sify.com to unitedpatent@unitedipr.com and patent@unitedipr.com

Please acknowledge safe receipt.

Thanking you,

6. The hearing notice by the respondent No.1 dated 07th October, 2020 was addressed to unitedpatent_ipr@sify.com, the old email address. The reference to the said email address is also found in the array of the opponents in the said



notice, as well as in the field “*Emails sent to*” in the notice. In relation to this notice, the petitioner states in para 16 of the petition that “*it was revealed to the petitioner*” that the hearing notice was sent to their old email address. On what basis was this discovery made is not clear from para 16 averments of the petitioner.

7. In the first adjournment sought by the petitioner on 07th November, 2020, the request was sent from unitedpatent@unitedipr.com and letterhead is seen to mention the new emails. The second hearing notice dated 09th November, 2020 was sent on the old as well as the new email addresses of the petitioner as evident from the list of emails mentioned in the field “*Emails sent to*” of the said notice. In the array of opponents of the said notice, however, only the old email is mentioned. In relation to this notice, the petitioner has averred in para 18 of their writ petition that the said notice was served on both the old email address and the new email address. In this regard while the petitioner claimed that he had reason to believe that the patent office had registered the new email addresses, the respondents submitted that the fact that it was also received on the old email address, would lead to a conclusion that they still had access to the old email. Subsequent emails dated 09th November, 2020 and 17th November, 2020 were also sent from the patent office at the old and the new email addresses. In respect of the same, the petitioner avers in para 19 that they were indeed received on both these addresses. The subsequent adjournment request dated 10th December, 2020 was then sent by the petitioner from the new email address along with the letterhead which noted the new email address as well.



8. Two years passed since the assessment of the patent application was delayed for reasons not connected to the petitioner, and when the matter was to be heard again on 21st November, 2022, the impugned notice was sent on 08th September, 2022. In this notice while the description of the petitioner in the array of opponents contains the same old email address, the list of emails to which the notice was sent to does not have the new email addresses of the petitioner, as it did earlier in 2020 and instead has only the old email address. In this regard, the petitioner claims in its writ petition that the old email had by the time become non-functional and the said notice never came to the attention, and they discovered the rejection of the opposition *ex parte* after making an inquiry in the patent office.

9. From the above conspectus of facts, it is quite evident that; *firstly*, as per the petitioner, change of the email address was communicated in July, 2017, and the communication was addressed to the Controller of Patents but was not in any particular form. Whether it was received or not was not clarified by respondent No.1; *secondly*, that new email addresses were used by respondent no. 1 in communications dated 09th November, 2020 (the hearing notice) and follow-up emails of 17th November, 2020 and 24th November, 2020; *thirdly*, the old email continued to be consistently mentioned by respondent no. 1 as part of the array of opponents in their notices.

10. The issue, therefore, arises whether the communication sent by the petitioner in 2017 amounted to a formal acceptable notice to the patent office of the change of address.



II. Rules and Provisions

11. What has been argued against the petitioner was that Rule 5 of the Patent Rules mandates every person concerned in any proceedings under the Act to furnish to the Controller an address for service which includes a postal address in India and an email address and which would be treated for all purposes of the proceedings as the address of the person concerned. There is no dispute between the parties that by virtue of giving an address and an email (as also a mobile number) in the notice of opposition by the petitioner the said condition was satisfied. As per Rule 6(2), a written communication to an applicant/opponent in a proceeding is deemed to be properly addressed if it is sent at the postal or email address appearing on the application or notice of opposition. The extract of Rules 5 & 6 of the Patent Rules, 2003 is extracted as under:

“5. Every person, concerned in any proceedings to which the Act or these rules relate and every patentee, shall furnish to the Controller an address for service, including a postal address in India and an e-mail address, and such address for service shall be treated for all purposes connected with such proceedings or patent as the address of the person concerned in the proceedings or of the patentee. Unless such an address for service is given, the Controller shall be under no obligation either to proceed or deal with any proceeding, or patent or to send any notice that may be required to be given under the Act or these rules and the Controller may take suo motu decision in the matter:

Provided that a patent agent shall also be required to furnish to the Controller a mobile number registered in India.



6. Leaving and serving documents.—(1) Any application, notice or other document authorised or required to be filed, left, made or given at the patent office, or to the Controller or to any other person under the Act or these rules, may be tendered by hand or sent by a letter addressed to the Controller at the appropriate office or to that person through post or registered post or speed post or by electronic transmission duly authenticated. If it is sent by post or registered post or speed post or by electronic transmission duly authenticated, it shall be deemed to have been filed, left, made or given at the time when the mail containing the same would have been delivered in the ordinary course of post or registered post or speed post, or by electronic transmission duly authenticated, as the case may be. In proving such sending, it shall be sufficient to show that the mail was properly addressed and transmitted: (1A) Notwithstanding anything contained in sub-rule (1), a patent agent shall file, leave, make or give all documents only by electronic transmission duly authenticated, including scanned copies of documents that are required to be submitted in original:

Provided that the original documents that are required to be submitted in original, shall be submitted within a period of fifteen days, failing which such documents shall be deemed not to have been filed.

(2) Any written communication addressed to a patentee at his postal address or e-mail address, as it appears on the register of patents or at his address for service given under rule 5, or to any applicant or opponent in any proceedings under the Act or these rules, at the postal address or e-mail address, appearing on the application or notice of opposition, or given for service, shall be deemed to be properly addressed.

(3) All notices and all written communications addressed to a patentee, or to any applicant or opponent in any proceedings under the Act or these rules, and all documents forwarded to the patentee or to the said applicant or opponent, shall, except when they are sent by special



messenger, be sent by registered post or speed post or by electronic transmission duly authenticated.

(4) The date of a notice or a written communication addressed to a patentee or to any applicant or opponent in any proceedings under the Act and these rules shall be the date of dispatch of the said notice or written communication, by registered post or speed post or fax or electronic transmission duly authenticated, as the case may be, unless otherwise specified under the Act or these rules.”

(emphasis added)

12. The issue, therefore, arises whether the impugned communication of 08th September 2022 sent to the old email address would suffice as “*deemed to be properly addressed*” under Rule 6(2). It is to be seen whether the change/update of the old email address to the new email address, was done as per procedure. For this, the respondents point to Form 13 to canvass that any amendment to an existing position ought to have been communicated by the petitioner through this form. However, the petitioner refutes this vehemently by stating that the said form relates to Section 57 of the Act which is for amendment of an application for a patent by a patentee which is accompanied by a complete specification, or any document related thereto. The said form also refers to Rule 81(1) which uses the same language and relates to a patent’s applicant only. The petitioner’s contention is that Section 57, Rule 81(2) and Form 13 all exclusively to an application for patent, the complete specification or any document related thereto. The expansive meaning sought to be assigned by the respondent to the phrase “*any document related thereto*”, as per the petitioner is not in context and unsustainable.



13. Having viewed these provisions carefully, this Court is of the view that Form 13 may not strictly be the form or process by which a change of address/email is communicated by an opposer. This is so since the Form 13 read with Section 57 and Rule 81(1), does seem to apply to a patentee applicant for amendments they may seek to their application. The respondents' contention that Form 13 has been used as a matter of practice for filing changes by the parties before the patent office cannot be verified.

14. The issue then which confronts this Court is what would be the appropriate Form which would allow an opposer to send a change of postal address/email already communicated in their notice of opposition in compliance of Rule 5(2). Even though parties did not refer to it, it is noticed that the Patent Rules do include Form 30 which is "*to be used when no other form is prescribed*" and is to be read with Rule 8(2). The said Form does allow an applicant/patentee/other to communicate address including email, telephone number, mobile and fax number along with the purpose of the request, details of the request and signatures of the person applying. Form 30 and Rule 8(2) is extracted hereunder for ease of reference:

"8. Forms.—(1) The Forms set forth in the Second Schedule with such variations as the circumstances of each case may require shall be used for the purposes mentioned therein.

(2) Where no Form is so specified for any purpose, the applicant may use Form 30 specified in the Second Schedule."

(emphasis added)



FORM 30				
THE PATENTS ACT ,1970				
(39 of 1970)				
and				
THE PATENTS RULES,2003				
TO BE USED WHEN NO OTHER FORM IS PRESCRIBED				
[See sub-rule (2) of Rule 8]				
1. Name of the Applicant/Patentee/Other	I/We			
2. Complete address including postal index number/code and State along with e-mail ID, telephone, mobile and fax number.	House No.	--	Telephone No.	--
	Street	--	Mobile No.	----
	City	--	Fax No.	--
	State	--		
	Country	--		
	Pin code	--	E-mail ID	--
3. Application No. / Patent No.				
4. Relevant section / rules				
5. Purpose of request				
6. Details of request				
7. To be signed by applicant	Signature.....			
8. Name of the natural person who has signed along with designation and official seal, if any.	(.....)			
	To, The Controller of Patents, The Patent Office, at"			

15. Whatever the modus may be, having not sought to use a formalized method of communicating their changed email address, it cannot be accepted that the petitioner had taken the requisite steps to ensure that the email addresses were indeed updated with the patent office. Merely relying upon 2017 communication, which was a mere generic letter to the Controller of Patents (without reference to the impugned patent application), would not, in



the opinion of this Court, amount to a formal request for change of email addresses for the purposes of the impugned patent application. There was no attempt made since 2017 by the petitioner to send a specific communication of change of email address relatable to the impugned patent. Even if the petitioner's contention is accepted that the 2017 communication had been noticed by the patent office since the 09th November, 2020 notice was sent to the new email address as well, it cannot be ignored that all the notices (including the impugned notice) were also sent to the old email address consistently and that in the array of opponents, only the old email address has been mentioned throughout by the patent office as being the formal address associated with the petitioner. Besides, the 2020 notices were, as admitted by the petitioner, received also on the old email address. Having taken no steps since 2017 or even after 2020 till 2022 (a long span of two years) to ensure that their old email address was excluded and excised from the record of the patent office, they cannot be seen to be taken advantage of the situation which has arisen. It is also noticed that the petitioner is represented through a registered patent agent and an advocate, and it cannot pass muster with the Court that proper steps were not taken, with diligence and punctiliousness to ensure that the records in the patent office excluded their old email address and included their new email address in all manners possible and by whatever mode acceptable to the patent office. They chose to await a notice from the office of the Controller of Patents, rather than being diligent and inquiring into the matter and ensuring that for the purposes of this impugned patent their new e-mail address was placed on record and could then fall within the purview of the official e-mail address as per Rule 5(2). The 2017 letter written by the



Petitioner to the Controller of Patents for change of email address did not specify any patent application that it pertained to. Further, this assumes importance, as in the very same letter to the Controller it was mentioned that the patent agent had filed multiple patent applications for his various clients and his change of e-mail be therefore recorded. In this respect, the letter did not conform to the provisions of Rule 5(2), which would have required a patent application specific communication/application, but was rather an open-ended generic communication. An experienced patent agent with stake involved in various proceedings before the patent office ought to have followed a more specific protocol.

III. Conclusion and Natural Justice

16. Having been either negligent, lax, casual, inertial or tardy in taking such steps, particularly when they had already sought and exhausted the two adjournments and there was a lapse of two years since between 2020 and 2022, the petitioner cannot be entitled to extraordinary relief from this Court under Article 226 of the Constitution of India. Besides, it is not as if the petitioner is remediless, since it could have moved for a post-grant opposition ever since January, 2023 or even in September 2023 (when they claim that they found out about the rejection of their opposition and grant of patent). Although the petitioner claims that they became aware of since September, 2023, they could have easily filed a post-grant opposition in the time which was available to them as per the Act. The petitioner in this regard relies upon the decision of the Madras High Court in *Indian Network for People Living with HIV/AIDS v. Union of India* 2008 SCC OnLine Mad 892 and the Hon'ble Supreme Court's



decision in *Mariamma Roy v. Indian Bank & Ors*, (2009) 16 SCC 187, to advocate the appoint that if the principles of natural justice have been violated, and they were entitled to a remedy which would take them back to the pre-grant stage of patent.

17. However, it is worth noting in this context, what the Hon'ble Supreme Court in the case of *K.L. Tripathi v. State Bank of India*, (1984) 1 SCC 43, observed:

“29. So whether a particular principle of natural justice has been violated or not has to be judged in the background of the nature of charges, the nature of the investigation conducted in the background of any statutory or relevant rules governing such enquiries.

31. Wade in his Administrative Law, 5th Edn. at pp. 472-475 has observed that it is not possible to lay down rigid rules as to when the principles of natural justice are to apply: nor as to their scope and extent. Everything depends on the subject-matter, the application of principles of natural justice, resting as it does upon statutory implication, must always be in conformity with the scheme of the Act and with the subject-matter of the case. In the application of the concept of fair play there must be real flexibility. There must also have been some real prejudice to the complainant; there is no such thing as a merely technical infringement of natural justice. The requirements of natural justice must depend on the facts and the circumstances of the case, the nature of the inquiry, the rules under which the tribunal is acting, the subject-matter to be dealt with, and so forth.”



This decision had also been noted by a coordinate Bench of this Court in *Haryana Pesticides Manufactures Assn. v. Willowood Chemicals (P) Ltd.*, (2022) 5 HCC (Del) 467.

18. It is to be noted that during arguments as part of deliberations in the Court, the possibility of a post decisional hearing without revocation of grant of patent arose, if at all the petitioner's pleas in the petition would be accepted. However, as per the discussion and analysis given above, and post a careful perusal of the record, this Court is of the opinion that the petitioner is not entitled to the relief as sought in the petition; therefore, the question of considering that possibility does not arise.

19. The writ petition, therefore, is dismissed. Petitioner would be at liberty to pursue their post-grant opposition if they so desire. It is made clear that this Court has not made any observations on the merits of the petitioner's opposition to the patent.

20. Copy of this judgment be uploaded on the website of this Court.

(ANISH DAYAL)
JUDGE

JANUARY 08, 2024/MK