

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

% Judgment reserved on : 05.09.2013
Judgment pronounced on : 23.09.2013

+ **W.P.(C) 1631/2013**

PUNEET KAUSHIK AND ANR Petitioners

Through: Mr N.K. Kaul, Sr. Adv with Mr Praveen
Anand, Ms. Divya Vijan, Ms. Ayushi
Kiran & Ms. Neeti Wilson, Advs.

versus

UNION OF INDIA AND ORS Respondents

Through: Mr. Amrit Pal Singh, CGSC with
Mr. Rajnish K. Jha, Adv. &
Dr. Kavita Taunk, Assistant Controller of
Patents.

**CORAM:
HON'BLE MR. JUSTICE V.K. JAIN**

V.K. JAIN, J.

The petitioners before this Court claim to have filed on 14.9.2012, in the Patents Office (India) at New Delhi, an international (PCT) application in terms of Rule 18.3 of the PCT Rules, enclosing therewith (i) Form-25 (in duplicate) on behalf of petitioner no.1 Puneet Kaushik (ii) Power of Attorney for Form-25 (copy) (iii) PCT Request along with Declaration of Inventorship (in duplicate) (iv) PCT Power of Attorney (v)

complete specification along with drawings (in duplicate) (vi) PCT fee calculation sheet and (vii) PCT Easy documents in CD with the transmission fee of Rs.8,000/- and Form-25 fee of Rs.4,000/-. It was stated in the covering letter that since the PCT application was first filed for the invention, they were also enclosing Form-25 as per the practice of Indian Patent Office.

2. An email dated 14.9.2012 was sent by Ms. Neeti Wilson of M/s Anand and Anand, counsel for the petitioners, to the respondent, in relation to the filing of PCT application and seeking clarification regarding validity of the jurisdiction of RO/IN. One of the confirmations sought in the email was that international filing date was independent of the forwarding of the record to IB by RO. The said email was responded on the same date by Eva Schumn of PCT Information Service Section, PCT Legal Division, confirming that their understanding was correct and drawing the attention to the PCT Rule 20.2. and 22.1(a) and (e). This was followed by another email from Neeti Wilson to K.S. Kardam of the Patent Office, with copy to Kavita Taunk and Archana Shanker of the said office, stating therein that though the PCT application was duly submitted to their office on 14.9.2012, that had not been taken on record,

on the ground that the application was not within the jurisdiction of RO/IN and was not accompanied by permission for filing outside India first. It was stated in the said email that RO/IN was the correct jurisdiction for the PCT application since one of the applicants is an Indian resident and RO/IN cannot refuse to accept the first filing PCT application, irrespective of a permission letter being attached or not, though a request for permission in F-25 was duly attached. A request was made to take PCT application on record with international filing date as 14.9.2012. Earlier, another email was sent by Neeti Wilson to Mr. K.S. Kardam of the respondents, on the same date, with copy to Kavita Taunk, stating therein that they had sent a first filing PCT application on that date, seeking allotment of international filing date as of that date. Vide email dated 15.9.2012 M/s Anand and Anand to Mr. K.S. Kardam of Patent Office was requested that the application be taken on record, assigning international filing date of 14.9.2012. On receipt of the said email, Mr. K.S. Kardam of the Patent Office requested Kavita Taunk of the said office to look into the matter. Vide email dated 17.9.2012 from Kavita Taunk of the Patent Office informed Archana Shanker of M/s Anand and Anand that she had asked Neeti Wilson and Cyril to submit

the application on 14.9.2012 and had waited till 6.15 pm on that date, but they had refused to file saying that they would only file Form-25 and, therefore, on 17.9.2012 they could not get the filing date of 14.9.2012. Responding to this, Neeti Wilson of M/s Anand and Anand wrote to Ms. Kavita Taunk clarifying that they never refused to file PCT application and in fact all the documents pertaining to the application were duly submitted along with Form-25 on 14.9.2012 and the only confusion was RO/IN was a valid receiving office which had since been clarified. Replying to the said email, Kavita Taunk wrote of Neeti Wilson on the same date stating therein that she had requested them to submit PCT application and a separate Form-25 from the said application because both had to be processed separately. She further stated that there was only one set of document with Mr. Cyril and he had option to file either Form-25 or PCT International Application, so Mr. Cyril informed her that he had been directed to file Form-25 only.

Vide email dated 17.9.2012 Neeti Wilson of M/s Anand and Anand again clarified that they had never refused to file PCT application and in fact all the documents pertaining to PCT application were duly submitted at the Patent Office along with Form-25 on 14.9.2012.

3. The grievance of the petitioners is that despite their having submitted international PCT application, the respondents have not given international filing date of the said application to them. The petitioners are therefore before this Court seeking the following reliefs:

- I. Issue a writ of mandamus or such other writ, order or direction of a similar nature directing the respondent authorities to grant the international filing date as 14.9.2012 to the petitioners international application and take the same of record by assigning an international application number; and
- II. Issue a writ of mandamus or such other order or direction of a similar nature directing the respondent authorities to declare that a PCT application filed in India at the Indian Receiving Office (RO/IN) would not require a prior permission under section 39 of the Patents Act, 1970; and
- III. Issue a writ of mandamus or such other writ, order or direction of a similar nature directing the respondent authorities to declare the Indian Receiving Office (RO/IN) as the competent receiving office when an Indian resident / national is an application of the PCT application filed at RO/IN for at least one of any contracting states.

4. In their counter affidavit, the respondents have stated that the petitioners did not file international application for patent under PCT and filed an application for permission for filing outside India under Section 39 of the Patent Act on Form-25. It is further stated in the counter-affidavit that a resident of India cannot file an application outside India without obtaining the aforesaid permission. It is also claimed in the

counter affidavit that filing of request of Form-25 is different from filing of international application under PCT since they are dealt with by two separate counters in the office, the application under Section 39 at the General Cash Counter and PCT Counter application in PCT Division. It is also claimed in the counter affidavit that the documents filed in the PCT Section do not go to EDP Section and come directly to RMID-4 Section and the documents filed in EDM Section relating to Form-25.

5. Rules 19.1 & 19.2 of PCT Regulations deal with offices competent to receive international applications and read as under:

“19.1 *Where to File*

(a) Subject to the provisions of paragraph (b), the international application shall be filed, at the option of the applicant,

(i) with the national Office of or acting for the Contracting State of which the applicant is a resident,

(ii) with the national Office of or acting for the Contracting State of which the applicant is a national, or

(iii) irrespective of the Contracting State of which the applicant is a resident or national, with the International Bureau.

(b) Any Contracting State may agree with another Contracting State or any intergovernmental organization that the national

Office of the latter State or the intergovernmental organization shall, for all or some purposes, act instead of the national Office of the former State as receiving Office for applicants who are residents or nationals of that former State. Notwithstanding such agreement, the national Office of the former State shall be considered the competent receiving Office for the purposes of Article 15(5).

(c) In connection with any decision made under Article 9(2), the Assembly shall appoint the national Office or the intergovernmental organization which will act as receiving Office for applications of residents or nationals of States specified by the Assembly. Such appointment shall require the previous consent of the said national Office or intergovernmental organization.

19.2 Two or More Applicants

If there are two or more applicants:

- (i) The requirements of Rule 19.1 shall be considered to be met if the national Office with which the international application is filed is the national Office of or acting for a Contracting State of which at least one of the applicants is a resident or national;
- (ii) the international application may be filed with the International Bureau under Rule 19.1(a)(iii) if at least one of the applicants is a resident or national of a Contracting State.”

Admittedly, the petitioner no.1 Mr. Puneet Kaushik is a resident of India he being one of the applicants, the international application could certainly be filed with the patent office, New Delhi in terms of Rule 19.1 read with Rule 19.2 (ii) of the PCT Regulations. To this extent, there is no dispute between the parties.

6. The issues which arose for consideration in this writ petition are (i) whether permission under Section 39 of the Patent Act is required before an international application can be filed by an Indian national and (ii) whether documents filed by the petitioner with the patent office at New Delhi on 14.9.2012 can be said to be international (PCT Application) within the meaning of the Regulations under the PCT and if the said documents can be treated as an 'International Application', what would be the date of filing of the said application.

7. Section 39(1) of the Patents Act reads as under:

“39. Residents not to apply for patents outside India without prior permission.(1) No person resident in India shall, except under the authority of a written permit granted by or on behalf of the Controller, make or cause to be made any application outside India for the grant of a patent for an invention unless-

(a) an application for a patent for the same invention has been made in India, not less than six weeks before the application outside India; and

(b) either no directions have been given under sub-section (1) of section 35 in relation to the application in India, or all such directions have been revoked.”

Admittedly, no application for the invention, subject matter of the documents, submitted on 14.9.2012 was made in India, not less than six weeks prior to 14.9.2012 in terms of clause (a) of sub section (1) of Section 39. Therefore, since the petitioner no.1 is a resident of India, permission in terms of section 39 of the Patents Act would be necessary before he can make an application outside India for grant of a patent for an invention. Therefore, the question would be whether the application submitted on 14.9.2012 was an application outside India or not. The contention of the learned counsel for the petitioner was that since the application was being submitted to patent office in India, it cannot be said to be an application made outside India. On the other hand, the contention of the learned counsel for the respondent was that an international application is an application outside India and the patent office in India only collects such application on behalf of international organization and forwards the same to it as a transmitting office.

8. Article 4(1)(ii) of the PCT provides that the request shall contain inter alia the designation of the contracting State or States in which

protection for the invention is desired on the basis of an international application. Article 11(3) of the PCT provides that the international application fulfilling the requirements stated therein and accorded the international filing date shall have the effect of regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State. Therefore, the international application serves the purpose of a regular national application in each of the States which is a party to PCT and in which protection in respect of the invention is desired. Therefore, an international application serves the purpose of applying not only for the State in which it is received, but in all the contracting States mentioned in the request. A perusal of the request made by the petitioner would show that protection for the invention was sought by the petitioners in all the designated States. It appears that Dell Products L.P. was applicant in all the designated States except U.S., whereas Puneet Kaushik was the applicant only in U.S.A. Article 12 of PCT provides that one copy of the international application shall be kept by the receiving office, one copy shall be transmitted to the International Bureau which means the International Bureau of the World Intellectual

Property Association and another copy shall be transmitted to the competent International Searching Authority, which is required to carry out international search and which in terms of Article 16 of PCT can either be a national office or Inter-Governmental Association such as the International Patent Institute, whose tasks include the establishing of documentary search report on prior art, with respect to inventions which are the subject of applications. The procedure before the International Searching Authority is to be governed by the provisions of the Treaty, regulations and agreements which the International Bureau is to conclude with the International Searching Authority. If the International Searching Authority considers that the description, the claims or the drawings fail to comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out, it is required to declare so and notify the applicant as well as the international Bureau that no international search report would be established. The international search report, as provided in Article 18(2) of PCT, is to be transmitted to the applicant as well as the International Bureau. Article 19 of PCT permits the applicant to amend his claims before the International Bureau after receipt of the International Search Report. As provided in Article 22, the

international application along with international search report is to be communicated to each Designated Office. Thus, the International Searching Authority functions independently of the Receiving Office.

As noted earlier, one copy of the international application is required to be transmitted by the receiving office to the International Bureau. Article 21 of PCT enjoins upon the International Bureau to publish international applications. Article 55 of the PCT provides that the administrative task concerning the union shall be performed by the International Bureau, which is required to function in accordance with the directions of the Assembly constituted under Article 53 and is to consist of delegates of each contracting State.

In terms of Rule 24.2 of PCT Regulations, on receipt of copy of the international application, the International Bureau is required to notify the applicant the Receiving Office and the International Searching Authority of such receipt along with the date of receipt of the record copy. Such notification is to identify the international application by its number filing date and name of the applicant.

. Considering the scheme of PCT, as discussed hereinbefore, it would be difficult to accept the contention that the international

application received by Indian Patent Office is an application made in India. Under the scheme, such an office primarily acts as an office which receives such application, gives filing date to it and then transmits its copies to the concerned authorities such as International Bureau and International Searching Authority for further processing. The entire processing thereafter is to be carried out outside India, either by the International Bureau or by the International Searching Authority. Therefore, in my view, the provisions of Section 39 are necessarily attracted to such an application, thereby necessitating a written permit to be granted by the Controller, in terms of Section 39 of the Patents Act. No such application, in my view, can be processed by the Indian Patent Office, unless it is accompanied by such a permit. In fact, this also appears to be the understanding of the petitioners who actually applied for such permit by submitting Form 25, whereby a request was made to the Controller of the Patent for permission for making patent application outside India.

The learned counsel for the petitioner submitted that they had to submit Form-25 since as per the practice adopted by it, the Patent Office does not accept any international application unless it is accompanied by

such a form. The practice adopted by Indian Patent Office, in my view, is correct and an international application must necessarily be accompanied by a request under Section 39 of Patents Act unless such a permission has already been obtained or an application for a patent for the same invention had been made in India not less than six weeks before the international application is made.

10. Relying upon Section 138 (4) and Section 35 of the Patents Act, 1970, the learned counsel for the petitioner contended that an international application submitted to the Indian Patent Office cannot be treated as an application made outside India. I, however, do not agree with the learned counsel. What sub-section (4) of Section 138 read with Section 7 (1A) and (1B) really means is that once the application in terms of the provisions of PTC is made and India is one of the designated States mentioned in the application, there would be no need to make a separate application in India and the international application would serve the requisite purpose. The aforesaid provision in the Patents Act, 1970 was necessitated on account of the provisions contained in PCT which stipulate that an international application would be termed as an application made in all the States designated in such an application,

thereby obviating the necessity of filing separate applications in each designated State in terms of the requirement of domestic laws of such States. This provision has no bearing on the issue as to whether an international application can be said to be an application made in India or is to be treated as an application made outside India.

It was also contended by the learned counsel for the petitioner that a PCT application filed in India would be subject to scrutiny and clearance under Section 35 and not under Section 39 of the Act. Again, I find no merit in the contention. Section 35 and Section 39 operate in altogether different fields. Section 35 deals with the cases where the controller is of the view that the invention in respect of which patent is sought is one of a class notified to him by the Central Government as the class relevant for defence purposes or where the invention otherwise appears to the controller to be relevant for the defence purposes. Section 35 also gives power to the Central Government to invite the controller where it finds that the invention subject matter of the patent application is relevant for defence purposes and on receipt of such notification, the provisions of sub-section (1) of section 35 are to apply to such an invention. Section 39, on the other hand, applies only to the applications

made outside India by an Indian resident, irrespective of the nature of the patent and requires a written permit unless the invention is covered by clause (a) of sub-section (1) of the said Section.

It was also contended by the learned counsel for the petitioner that Section 39 has to be read in the light of Section 35, 36 and 38 and if so read, Section 39 would apply to only those inventions which are relevant for defence purposes or atomic energy and national security considerations arise to the invention on account of its nature. The contention was that the legislative intent was to ensure that no technology conceived and developed in India should leave its shore without scrutiny from the point of view of defence and atomic energy related purposes. However, the provisions of Section 39 contain no such qualification with respect to the applications made outside India and in view of the unambiguous expressions used in Section 39 the scope of the Section cannot be restricted only to the inventions of a particular nature.

11. Admittedly, the written permit in terms of Section 39 of the Patents Act, 1970 came to be granted to the petitioner only on 27.09.2012, though the international application was delivered in the Patent Office on 14.09.2012. Since written permit in terms of Section 39 was a mandatory

requirement for such an application, the international application, even if complete in all other respects cannot be given a filing date earlier than the date on which the written permit in terms of Section 39 is issued. Therefore, the respondents could not have acceded to the request of the petitioners to give 14.09.2012 as the international filing date.

12. The next question which comes up for consideration is as to whether the petitioners had submitted only an application under Section 39 of Patents Act by filling up Form 25 or they had also simultaneously submitted an application to the Indian Patent Office on 14.09.2012. Article 11 (1) and (2) of the PCT, to the extent it is relevant, reads as under:-

(1) (i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office,

(ii) the international application is in the prescribed language,

(i) the international application contains at least the following elements:

(a) an indication that it is intended as an international application,

(b) the designation of at least one Contracting State,

- (c) the name of the applicant, as prescribed,
- (d) a part which on the face of it appears to be a description,
- (e) a part which on the face of it appears to be a claim or claims.

(2)(a) If the receiving Office finds that the international application did not, at the time of receipt, fulfill the requirements listed in paragraph (1), it shall, as provided in the Regulations, invite the applicant to file the required correction.

(b) If the applicant complies with the invitation, as provided in the Regulations, the receiving Office shall accord as the international filing date the date of receipt of the required correction.”

A perusal of the documents submitted by the petitioners to the Patent Office on 14.09.2012 would show that they had submitted documents for an International PCT application and enclosed PCT request, PCT power of attorney, specification along with drawings, PCT free calculation sheet and PCT easy documents in CD. The aforesaid request duly complied with all the requirements of clause (iii) of Article 11(1) of PCT. The application admittedly was in prescribed language and the applicants had the right to file an international application in India since one of them Puneet Kaushik is a citizen and resident of India.

13. The following, according to the respondents, were the deficiencies in the documents of the petitioners due to which the request made by them cannot be treated as PCT international application:-

- i) the agent for the petitioners did not have power of authority required under Article 135 of the Patent Regulations;
- ii) the petitioners did not possess written permission in terms of Section 39 of Patent Act;
- iii) required number (3) of copies of the specifications were not submitted;
- iv) the required fee was not paid

14. As regards written permit required in terms of Section 39 of the Patents Act, though such an permission is mandatory before an international filing date by Indian Patent Office since the requisite written permit admittedly was granted to the petitioners on 27.09.2013, the PCT application, if it otherwise confirms to the mandatory requirements of the Articles and Regulations of the PCT can be given 27.09.2013 as the international date.

As regards number of the copies of specifications, to my mind, it would not be a mandatory requirement to file the copies in requisite

number, while submitting the PCT request, since the Receiving Office is required to invite the applicants to comply with the requirements of PTC by submitting copies of the specifications in requisite number and it is only on failure of the petitioners to provide copies in requisite number that the PCT application can be treated as withdrawn, on account of failure of furnish the requisite number of such copies. A reference in this regard may be made to Article 14 of the PTC which mandates the Receiving Office to invite the applicants to correct certain defects in the international application, within the prescribed time limit, failing which the application is to be treated as withdrawn. Rule 19 of the Patent Rules, on which the reliance is placed by the respondents, does provide for filing international application in triplicate, but sub-rule (3) of the said rule also provide that where the specified number of international applications are not filed, the applicant can request the appropriate office to prepare the additional copies on his paying such fee in this regard as may be required by the said office for making such copies. This clearly indicates that requirement to submit an application in triplicate is not mandatory and additional copies can be obtained at a later date.

As regards the contention that the petitioners did not pay the requisite fee, reference in may be made to Rule 16 *bis.* of Regulations under the PCT. Clause (a) of the said Rule provides that where the fee are not paid to the Receiving Office by the time stipulated in Rule 14.1 (c), 15.4 and 16.1 (f) or the fee, so paid, is insufficient, the Receiving Office shall invite the applicants to pay the required amount to cover those fee, together with the late payment fee under Rule 16 *bis.*2, within one month from the date of the invitation. It is only where the applicant, despite such an invitation, does not pay the requisite amount of fee/late payment fee within the time limit referred above, that the application can be declared to be withdrawn in terms of Article 14(3) of the PCT.

15. The last defect pointed out by the respondents in the PCT application filed by the petitioners is that the said application was not accompanied by a valid Power of Attorney. Article 14 of PCT, to the extent it is relevant, provides that the Receiving Office shall check whether the international application is signed, as provided in the Regulations or not. Rule 26.2 *bis* of PCT Regulations provides that for the purpose of providing 14(1)(a)(i) and (ii) if there is more than one applicants, it shall be sufficient that the request be signed by one of them.

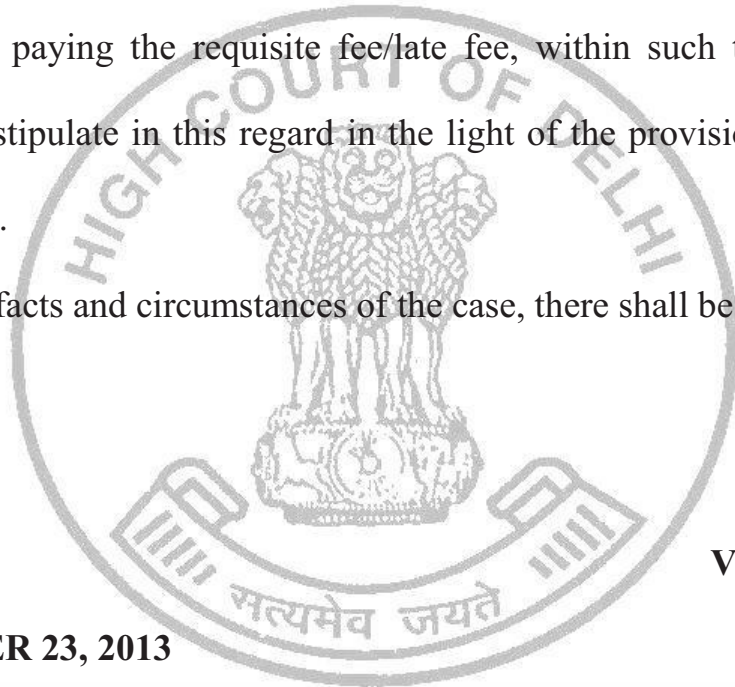
Therefore, the PCT application submitted by the petitioners could be signed by either of them or by duly constituted attorney of either of them. Assuming that the PCT application submitted by the petitioners was not signed, as required in terms of Article 14, the Receiving Office is required, under Rule 26 of PCT Regulations, to invite the applicants to rectify the defect by furnishing the required corporation within two months from the date such an invitation is issued. The time to make corrections can also be extended by the Receiving Office at any time before taking a decision on the application (Rule 26.2 of PCT Regulations). In fact, Article 14(1)(b) of PCT also mandates the Receiving Office to invite the applicant to correct the international application within the prescribed time limit and it is only on the failure of the applicant to do so that the application can be considered and declared to be withdrawn. In any case, the petitioners have now placed on record a PCT power of attorney dated 14.09.2012 duly signed by petitioner No. 1 Shri Puneet Kaushik in favour of Neeti Wilson, Archana Shankar and Vishisha Garg of M/s. Anand and Anand as his agents for the purpose of filing a PCT application with Patent Office in India. They have also placed on record a General Power of Attorney dated 01.12.2006,

executed by petitioner No. 1 Dell Products L.P., authorizing *inter alia* Praveen Anand, Archana Shankar, Jaya Bhatnagar, etc. The said power of attorney authorized the persons named therein to act jointly or individually in connection with granted patents and pending applications or any future cases, their renewals and maintenance objections, oppositions, etc. and the executants has ratified and agreed to ratify and confirm all acts done by the attorneys mentioned therein in respect of the matters and proceedings stated in the said documents.

In terms of the power of attorney dated 14.09.2012, the PCT application on behalf of petitioner No. 1 Puneet Kaushik could be signed by any of the persons appointed as attorney in the said document. In terms of the power of attorney dated 01.12.2006, the application could be signed by any of the attorneys, mentioned in the document on behalf of petitioner No.2 Dell Products L.P. A perusal of the documents submitted by the petitioners on 14.09.2012 would show that PCT application was signed by Neeti Wilson. She was competent to sign the said application on behalf of both the petitioners though her authority to sign it on behalf of either of them would be sufficient compliance with the requirements of PTC Regulations.

16. For the reasons stated hereinabove, the writ petition is disposed of with a direction to the respondents to grant within six (6) weeks from today, 27.09.2012 as the international filing date in respect of the PCT application submitted by the petitioners to the Indian Patent Office on 14.09.2012 and assign an international number to the said application subject to their submitting the copies of specifications in required number, and paying the requisite fee/late fee, within such time as the respondents stipulate in this regard in the light of the provisions of PCT in this regard.

In the facts and circumstances of the case, there shall be no order as to costs.



V.K.JAIN, J

SEPTEMBER 23, 2013

Rd/BG