



IPAB Intellectual Property Appellate Board
balancing ip-protection

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OA/14/2020/PT/MUM

THURSDAY, THIS THE 24TH DAY OF DECEMBER, 2020

**HON'BLE SHRI JUSTICE MANMOHAN SINGH
HON'BLE DR. B.P. SINGH**

**CHAIRMAN
TECHNICAL MEMBER (PATENTS)**

4SC AG

FRAUNHOFERSTRASSE 22

82152 PLANEGG-MARTINSRIED

GERMANY,

A GERMAN COMPANY

..... APPELLANT

(Represented by: Mr Mr.Adheesh Nargolkar)



THE CONTROLLER OF PATENTS

THE PATENT OFFICE

MUMBAI

..... RESPONDENT

(Represented by - None)

ORDER

Hon'ble Shri Justice Manmohan Singh, Chairman

Hon'ble Dr. B.P. Singh, Technical Member (Patents)

1. The present appeal is filed under Section 117A of the Indian Patents Act, 1970, against the order dated 14/09/2017, passed by the Respondent, being the Deputy Controller of Patents & Designs, under Section 15 of the Indian Patents Act, 1970, refusing to grant the Appellants' Indian patent application no. 1987/MUMNP/2010.

2. It is the case of the appellant that:

2.1 The decision to refuse the patent application is based on the erroneous finding and conclusion that the double request for examination filed for one invention was in violation of Section 135(3) as stated in paragraphs 6 – 11 of the decision, although remedial/corrective actions were taken by the Appellant's Agent by abandoning one of the applications (Priority Application) and filing a petition under rule 137 requesting condonation of the irregularity of filing double request for examinations.

2.2 The Appellant reiterates that the filing of request for examination in respect of the Priority Application as well as the corresponding National Phase Application was indeed an inadvertent oversight and was unintentional and that it was only a procedural irregularity. The Appellant submits that as soon as the inadvertent error was noticed, immediate corrective/remedial actions were taken by the Appellant on their own by abandoning the Priority Application and filing a petition under Rule 137 to obviate the procedural irregularity of filing double Request for Examinations in both the Applications.

2.3 The Appellant submits that under Rule 137, the Controller is vested with powers to obviate any irregularity in procedure without detriment to the interest of any person. The Appellant submits that disregarding or ignoring the examination request in respect of Priority Application is not detrimental to the interest of any person. The Appellant also refers to a recent decision by the Intellectual Property Appellate Board (IPAB) in Rubicon Research Pty Ltd. V The Controller General of Patents, Designs and Trademarks dated 21 August 2020

(OA/18/2014/PT/KOL) and submits that the IPAB in this matter held that “The reading of the provision under Rule 137 as incorporated earlier in this order makes it crystal clear that the Controller is vested with the power to eliminate any procedural irregularity and accordingly he has obviated the procedural irregularity of the procedure contemplated under Rule 57 as per order dated 21.04.2006. The provision under Rule 137 empowers the Controller to exercise such power without detrimental to the interest of any person.”

2.4 The Appellant further submits that there is no suppression of any material facts and there is no malafide and no ulterior motives in the matter, which is evident from the fact that the Appellant had disclosed the filing details of the Priority Application in the annexure to Form 3, detailing the corresponding applications, filed in respect of National Phase application. Moreover, the fact that the Priority Application was voluntarily abandoned/withdrawn by the Appellant himself, proves the bonafide conduct of the Appellant.

2.5 The Appellant also submits that no petition under Rule 137 was filed for the Application and hence, the question of dismissal of the petition in the Application as stated in the Impugned Order does not arise.

2.6 Regarding the further objections in the hearing notice (not taken into consideration in the decision), the Appellant at the outset submits that the claims of the subject Application was amended to bring it in conformity to the claims granted in the US, during the response to the First Examination Report.

3. The prosecution history of the instant patent application No. 1987/MUMNP/2010 is as under:

Sr.No	Date	Events
1.	24 March 2008	Nycomed GmbH filed a patent application bearing IN patent application number 614/MUM/2008 (hereinafter referred to as " Priority Application ")
2.	31 July 2008	Nycomed GmbH assigned the Priority Application to 4SC AG, the Appellant
3.	23 March 2009	The Appellant filed a PCT application claiming priority from the Priority Application and bearing no. PCT/EP2009/053399
4.	21 September 2010	The Appellant filed a National Phase application, being 1987/MUMNP/2010 (hereinafter referred to as " the Application ") in respect of the above PCT application
5.	31 March 2011	The Appellant's erstwhile patent attorney filed a request for examination of the Priority Application
6.	2 March 2012	The Appellant's erstwhile patent attorney filed a request for examination of the Application.
7.	about June 2012	The Priority Application and the Application were transferred to the present patent attorney
8.	19 April 2013	The present patent attorney received a First Examination Report (hereinafter referred to as " FER 1 ") in respect of the Priority Application
9.	03 September 2013	The present patent attorney wrote a letter explaining the inadvertent error in filing of the requests for examination in respect of both the applications and requested the Respondent to treat the Priority Application as withdrawn/abandoned and to proceed only with the Application. The Appellant/ its present patent attorney also filed a petition under Rule 137 in relation to the Priority Application for condonation/regularization of the procedural irregularity.
10.	05 March 2015	First Examination Report (hereinafter referred to as " FER 2 ") in respect of the Application was received.
11.	02 March 2016	A response to the FER 2 was filed well within the prescribed time limit
12.	20 October 2016	Hearing notice issued in respect of the Application scheduling the hearing for 03 November 2016.
13.	03 November 2016	Date of Hearing in respect of the Application. The Learned Examiner raised a completely new objection viz: "The present application cannot be

		processed under section 135(3) since double RQ's were filed in the present application as well as its priority application no. 614/MUM/2008 and it was processed" and added the said objection 'by hand' in the hearing notice dated 20 October 2016 and adjourned the hearing to 30 November 2016.
14.	30 November 2016	Date of Hearing in respect of the Application.
15.	15 December 2016	Written submissions towards the Hearing held on 30 November 2016 in respect of the Application were filed.
16.	14 September 2017	An order (hereinafter referred to as " Impugned Order ") was passed by the Respondent under Section 15 of the Act whereby the Respondent has disallowed the petition and refused to grant Patent, predominantly on the ground of multiple requests for examination.
17.	12 February 2018	Hence the present appeal.

4. The operating portion of the order of the respondent is as follows:

4.1 *Mrs.Nisha Austine, M.A Jose, both an authorized patent agent on behalf of the applicant had attended a scheduled hearing, she has argued the matter with respect to objection maintained in the hearing notice, followed by post hearing valid objection that an alleged patent application is Nationalized Patent Application based on the PCT Application No.PCT/EP2009/053995 claiming the priority from Indian Application bearing no.614/MUM/2008, in the priority application the agent had filed the Request for examination on 31/03/2011 and the RQ No, assigned as 1198/RQ-Mum/2011. Consequent upon filing the request for Examination the Application 614/MUM/2008 was examined and generated a First Examination report on 19/04/2013, thereupon, the agent failed to response to FER and consequently, the priority application was deemed to have been abandoned u/s 21(1) of the Patents Act, 1970, on*

28/11/2014. The agent of the applicant had filed one more Request for Examination for the National Phase patent application of the alleged application no. 1987/MUMNP/2010 bearing the Rq no. 865/RQ-MUM/2012 dated.02/03/2012, upon a RQ an alleged patent application was examined and issued a FER on 05/03/2015. 6.

4.2 It is clear that the agent in his post hearing written submissions at para no.6 (1) & (2) wherein it is mentioned that the patent application no.614/MUM/2008 for the invention was first filed with the Patent office on 24/03/2008 by Nycomed GmbH, Germany, in compliance with Section 39(1) as some of the inventors in respect the invention were person residing in India. At para (2) it is stated that 614/Mum/2008, wherein a form 6 was filed with the patent office on 5/12/2008 recording 4SCAG, Germany, as assignee of Nycomed GmbH and subsequent proprietors of application no.614/MUM/2008.

4.3 On filing application no.1987/MUMNP/2010, the applicants had not withdrawn priority application No.614/MUM/2008 as the priority application was filed to create a priority date for the invention and as both the applications claimed the same invention, in both the application agent had filed the request for examination and both application have been processed accordingly.

4.4 Section 135(3) provides that in the case of an application filed under the PCT designating India and claiming priority from a previously filed application in India, Examination request should be filed only for one of the application filed in India.

4.5 On realization of the above fact the agent had filed a petition under Rule 137 with a prescribed fee on 03/09/2013 for condonation and regularization of the 17 procedural

irregularity, the Petition was carefully examined but it is not allowed since filing a double Request for examination of one invention such as to Priority application and its corresponding national phase application is a violation of Section 135(3).

4.6 *In view of above the subject patent application bearing no.1987/MUMNP/2010 is invalid patent application.*

4.7 *Upon consideration of all the documents available on record and in view of above agents submission thereof, and under the circumstances of the case, I hereby refuse to proceed further on this Patent application No. 1987/MUMNP/2010.*

5. Now the relevant statutory provisions are referred to as below:

Section 135¹

Convention applications

“.....

(3) In case of an application filed under the Patent Cooperation Treaty designating India and claiming priority from a previously filed application in India, the provisions of sub-sections (1) and (2) shall apply as if the previously filed application were the basic application:

Provided that a request for examination under section 11B shall be made only for one of the applications filed in India.”

[Emphasis Added]

Rule 137²

Powers of Controller generally

Any document for the amendment of which no special provision is made in the Act may be amended and any irregularity in procedure which in the opinion of the Controller may be obviated without

¹ Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps135.html>

² Available at <http://ipindia.nic.in/writereaddata/Portal/ev/rules/pr137.html>

detriment to the interests of any person, may be corrected if the Controller thinks fit and upon such terms as he may direct.

6. The spirit of the law is to avoid double patenting. It ensures that no two patents can be granted for the same invention and objects filing request for examination in both the applications. However, if by inadvertence or by oversight any irregularity occurs, it is not the intention of legislation to initiate punitive actions or deny even a single patent if found patentable otherwise.
7. We have reviewed the prosecution history of patent application no. 614/MUM/2008 the priority application herein. We have seen that no sooner the appellant discovered the irregularity; they have not only informed the Controller through their letter dated 03/09/2013 but also filed a petition under Rule 137 of the Patents Rules, 2003. They have mentioned that inadvertently they filed the Request for examination in 614/MUM/2008 and intended to proceed with examination of only 1987/MUMNP/2010. They requested Controller to condone such irregularity. The excerpts of the letter dated 03/09/2013 filed in patent application no. 614/MUM/2008 is quoted herein below:

We submit that we have also filed as a PCT national phase application, patent application no 987/MUMNP/2010 based on PCT Application No PCT/EP2009/053995 claiming priority from the above application no 614/MUM/2008. On 31 March 2011, we inadvertently filed a request for examination for above application no 614/MUM/2008. It was our intention to only proceed with the examination of application no 1987/MUMNP/2010 for which we have separately requested for examination on 2 March 2012. We humbly request the Learned Controller to condone the irregularity in procedure relating to our unintentional filing of a request for the examination of the application no 614/MUM/2008 at a time when application no 1987/MUMNP/2010 for substantially similar invention was pending. We submit herewith the enclosed petition under Rule 137 herewith for condonation of the irregularity in procedure. Our cheque for Rs 4000 on the petition is also enclosed herewith.

We request the Learned Controller to disregard the said request for examination filed in respect of the application no 614/MUM/2008 and to treat the patent application no 614/MUM/2008 as abandoned and to proceed to examine the patent application no 1987/MUMNP/2010 instead for which a separate request for examination has already been filed.

8. The respondent in para 9 of his order quotes *On realization of the above fact the agent had filed a petition under Rule 137 with a prescribed fee on 03/09/2013 for condonation and regularization of the 17 procedural irregularity, **the Petition was carefully***

examined but it is not allowed since filing a double Request for examination of one invention such as to Priority application and its corresponding national phase application is a violation of Section 135(3). [Emphasis added]

9. It is a fact that no petition was filed in the instant application no. 1987/MUMNP/2010. This means that the respondent went on to disallow the petition u/r 137 filed on 03/09/2013, in respect of previous priority application i.e. 614/MUM/2008, while deciding the present case no. 1987/MUMNP/2010.

10. It is noted that the present Controller was also the Controller for patent application no. 614/MUM/2008. When the letter informing the irregularity was received and the petition u/r 137 was filed to that effect, what action did he take? He could have taken appropriate action in accordance with the law, while adjudicating that application no. 614/MUM/2008; but certainly not while adjudicating some other patent application.

11. Here again, we appreciate that it couldn't have been possible for the respondent to inform the appellant about this fact of double Request for examination, while issuance of FER in case of 1987/MUMNP/2010, and also while issuing hearing notice. Even he could inform them only on the date of hearing and adjourned the hearing for a later date; same analogy holds good in case of the appellant also that no sooner they came to know about the double request for examination, they informed the Controller and took remedial action. Hence, the intention of the applicant/appellant cannot be doubted.

12. The learned Controller also makes a statement in his order that *Consequent upon filing the request for Examination the Application 614/MUM/2008 was examined and generated a First Examination report on 19/04/2013, thereupon, **the agent failed to response to FER and consequently, the priority application was deemed to***

have been abandoned u/s 21(1) of the Patents Act, 1970, [Emphasis added]. It is worth noting that the last date for putting the application in order of grant in 614/MUM/2008 was 21/04/2014, as per the First Examination Report issued by none other than the present Controller on 19/04/2013. The learned counsel of the appellant has informed them about their intention as early as 03/09/2013 that they filed the request for examination in that case inadvertently and wish to proceed with only PCT National phase application only. Therefore, the statement of the leaned Controller is factually incorrect.

13. It is also surprising that how the Controller has held that *patent application no. 1987/MUMNP/2010 is invalid patent application.*

We find this statement as not supported by the patent law.

14. We have analyzed the whole case and are of the view that the irregularity caused inadvertently deserves to be condoned. Here the case of double patenting is not occurring as the initial application has been abandoned already under section 21(1) of the Patents Act, 1970. Hence we set aside the order of the Respondent. We note that the respondent has not considered the application on merit.

15. While arguing the matter in front of us, the learned counsel has requested about the change of Controller, in case the Board choose to remand back the case.

16. We are inclined to agree with their submission and direct the respondents to refer the instant application to some other Controller, who shall decide the matter on merit in accordance with law, within 3 months from the issuance of this order, giving a fair opportunity to the appellant of being heard.

17. Keeping in view the above facts and circumstances, the instant appeal is allowed. No cost.

-Sd/-

(Dr. B.P. Singh)
Technical Member (Patents)

-Sd/-

(Justice Manmohan Singh)
Chairman

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