**IN THE HIGH COURT OF DELHI**

DATED: 20.12.2006

**CORAM**

**THE HONOURABLE MR. JUSTICE SANJAY KISHAN KAUL**

Aia Engineering Ltd. ... Petitioner

Vs.

Controller of Patents and Anr. ... Respondents

**JUDGMENT**

**Sanjay Kishan Kaul, J.**

1. A patent application bearing number 2769/DEL/1997 was filed by one Hubert Francois on 29-09-1997. On 16-07-2002, a letter of assignment was given in favor of Respondent No. 2 by Hubert Francois. Respondent No. 2 requested the Controller of Patents to examine the application vide letter dated 9-01-2004 The First Examination Report was issued by the Controller of Patents to the representative of Respondent No. 2 on 9-02-2004 The India Patent Application was published in the Patent Journal on 3-06-2005.

2. Respondent No. 2 is stated to have requested the Controller of Patents, vide letter dated 02-09-2005, to carry out certain corrections/clerical errors in the claims of the patent. The same are stated to have been allowed by the Assistant Controller on 06-09-2005. Patent No. 197257 was granted in favor of Respondent No. 2 on 2-12-2005.

3. Petitioner submitted that on coming to know of the patent granted in favor of respondent No. 2, inquiries were made and the file relating to the said patent was inspected. It was found that vide a noting dated 06-09-2005, certain amendments were carried out to the original specifications of the patent published on 3-06-2005. Aggrieved by the same a review application was filed by the petitioner on

18-01-2006 to recall the order of Respondent No. 1 dated 06- 09-2005 on the ground that such amendments were not clerical errors and the grant of such amendments amounted to fraud on the patent office and on the public at large. The amendments questioned by the petitioner were the substitution of the words "homogenous phase" instead of "homogenous Solid Solution" in Claim 1 ; substitution of "pad" in place of "roller" in Claim 1 and other claims; and the substitution of "by volume" in place of "by weight" in claim 4.

4. The application dated 18-01-2006 was rejected vide order dated 28-02-2006 without an opportunity of hearing being afforded to the petitioner. The Assistant Controller of Patents (hereinafter referred to as Assistant Controller) observed that no orders were issued on 6th September 2005 which are sought to be reviewed/recalled. The application was not found to be maintainable under Section 77(1)(f) of the Patents Act, 1970 (hereinafter referred to as the said Act) on the ground that the petitioner was not a "person interested" on the records on the date on which the application for amendments was received and on the date when they were heard and the review/recall application was neither in the prescribed form nor with the prescribed fee. The Assistant Controller also observed that nothing appears on record that the applicant had obtained the amendments by misrepresentation. The applicant had only requested for rectification of obvious and clerical errors under Section 78 of the said Act to replace the word "roller" with "pad" and the same had been allowed after due consideration of the records including the corresponding PCT application and European and US patents and the remaining amendments were called for by the Assistant Controller before the grant of patent on the application.

5. In the mean time, on 27-01-2006, a civil suit No. 189/2006 was filed in this Court by Respondent No. 2 against the Petitioner alleging infringement of Patent No. 197257. On 03-04-2006, the petitioner filed a counter claim in the form of a revocation petition challenging the validity of patent No. 197257 with a specific averment that an application was filed before the Controller to recall the earlier order dated 28-02-2006 allowing the amendment without hearing the petitioner

and another application for re-hearing as well as recalling the order allowing certain other amendments which had come to the notice of the petitioner.

6. On 12-04-2006, the petitioner again made a request to the Controller to withdraw the order of 28-02-2006 on the ground that no opportunity of hearing was provided to the petitioner. It was contended that the amendments made to the claims substantially changes the scope and subject of the patent and reflects the fraud and misrepresentation made by Respondent No. 2 to the Controller of Patents.

7. The Assistant Controller, on 2-05-2006 found that upon a review of patent application No. 2769/DEL/97, it has been observed that large scale technical amendments which have been carried out appear to be beyond the scope of the original disclosure. The subject patent granted was nullified and the letter patent issued was withdrawn.

8. Respondent. No. 2 filed a writ petition No. 7841-7842/2006 in this Court against the order dated 02-05-2006. The petitioner was not joined as a party in the said proceedings and filed an application in this Court to be made an intervening party which was allowed. On 10-05-2006, learned Single Judge of this Court quashed the orders of the Assistant Controller dated 2-05-2006 and 28-02- 2006. It was found that the order dismissing the first review application was passed without affording an opportunity of being heard to the petitioner (applicant in the writ petitions) and that the principles of natural justice have been fatally ignored by the Assistant Controller in disposing of both the review applications in the absence of the parties. Learned Single Judge directed the Assistant Controller to decide the application of the petitioner dated 18-01-2006 in accordance with law after granting Respondent No. 2 (the petitioner in the said writ petitions) and the petitioner an opportunity of being heard. The Assistant Controller was required, while doing so, to also address the question of whether the said review application was maintainable in view of the pendency of

suit no 189/2006 on the original side of this Court. Status qou as existing on 18-01-2006 was directed to be maintained till a decision on the application.

9. On 19-07-2006, the Assistant Controller heard the parties and in terms of order dated 28-07-2006, rejected the review application of the petitioner. In the impugned order the Assistant Controller considered two questions- the decision of the review application in accordance with law and the maintainability of the review petition in view of civil suit no 189/2006 pending at the original side of this Court. In so far as the first aspect is concerned, it was found that the review application was not filed in the prescribed manner and with the prescribed fee as statutorily required under Section 77(1)(f) of the Act read with Rules 130 (1) and 7 (2) (c) of the Patent Rules, 2003 (hereinafter referred to as the said rules) and nor within the period of one month from the date of filing as prescribed under Rule 7 (2) (c). Further, it was observed that the petitioner had not established his locus standi under the provisions of the said Act and Rules. It was further held that no formal order was issued on 06-09-2005. Also, the Assistant Controller observed that since there is no provision in the said Act or Rules to accept the fee after the stipulated time, the same cannot be accepted and further petitions taken on record.

10. In the context of the maintainability of the review petition in view of the pendency of civil suit No. 189/2006, the Assistant Controller found the review petition not maintainable. The Assistant Controller observed that this Court being seized of the petitioner''s written statement in response to Respondent No. 2''s suit as well as the petitioners revocation petition filed under Section 64 of the said Act by way of a counter claim, the entire matter including the amendments in question is now sub judice. All grounds of objection taken in the review application dated 18-01-2006 have also been taken in the written statement and counter claim. The provisions of Section 117(A)(2) r/w Section 117C and 117D of the said Act clearly prohibit the Controller of Patents from exercising any authority on appeal or review of any decision, order or directions of the Controller under various provisions of the said Act including Sections 15,

57 and 78. The Assistant Controller noted that as per the judgment of the Apex Court in Whirlpool Corporation v. Registrar of Trademarks, Mumbai and Ors. , it is clear that the validity of amendments allowed on 02-09-2005 should be determined by the High Court. Also, it was observed that in view of the proviso to Section 57(1) of the said Act, the Assistant Controller is prohibited from passing any order allowing or refusing any amendments when a suit for infringement of patent or proceeding before the High Court for revocation of the patent is pending and in the present case, both suit for infringement and proceeding for revocation of the patent are pending before this Court. Aggrieved by the said order and the order dated 06-9-2005, the petitioners have filed the present proceedings.

11. Learned Senior Counsel for the Petitioner submitted that a reading of the order dated 10-05-2006 of learned Single Judge of this Court makes it clear that the intention of this Court in remanding the matter back to the Controller was to ensure that the review be decided on merits whereas the impugned order dated 28-07-2006 passed by the Assistant Controller is completely opposite and based on purported procedural infirmities and the learned Assistant Controller has erred in not complying with the order of learned single judge of this Court. Learned senior counsel submitted that as on 10.05.2006 learned Single Judge of this Court was aware of the pending suit, revocation petition and other proceedings.

12. Learned Counsel contended that while according to Respondent No. 2, the amendments were carried out due to errors that arose on account of translation of PCT/EP97/04762, admittedly Indian application No. 2769/DEL/1997 was a stand alone application which claimed no priority.

13. Learned Senior Counsel for the petitioner contended that while according to Respondent No. 2 only one amendment i.e. the change of the word "roller" to "pad" was sought, the letter dated 2-09-2005 prays for more than one amendment.

14. Further, learned Counsel submitted that while according to Respondent No. 2, the change from "roller" to "pad" was the only amendment sought under Section 78(4) of the said Act and the rest had been called for by the learned Assistant Controller, according to Respondent No. 1, all the amendments sought were technical in nature and had been sought by Respondent No. 2 vide letter dated 2- 09-2005.

15. Learned senior counsel also submitted that even if assuming but not admitting that the only amendment sought is the change of the word "roller" to "pad", the word "pad" already appears in the abstract published in the Patent journal on 03-06-2005. Also, the words "consisting of" also appears in the said abstract while the amendments sought includes substitution of the word "comprising" by "consisting of". Learned senior counsel submitted that while according to respondent No. 1 the application seeking permission for making amendments was filed by respondent No. 2 on 02.09.2005 and the case was put up and allowed by the Patents Office on 06.09.2005, it is a mystery as to how the Controller called for the amendments even prior to application having been filed.

16. Learned senior counsel submitted that while as per respondent No. 2 all the amendments were called for by respondent No. 1 under Section 15 of the said Act, there is nothing on record reflecting such consideration or an order under Section 15 of the said Act. Learned senior counsel thus submits that it is apparent that all the amendments were allowed without application of mind and the amendments whether under the garb of clerical errors or otherwise have not been properly considered by the learned Assistant Controller and deserve interference by this Court since the amendments are impermissible in law.

17. Learned Senior Counsel submitted that while according to Respondent No. 2, the amendments were allowed after considering all other corresponding applications, there is nothing in the records reflecting such consideration.

18. Learned Senior Counsel for the petitioner submitted that the Petitioner had the locus standi to file the review application and this has been admitted by

Respondent No. 2 in their reply where there is a specific admission that the petitioner was its erstwhile licensee and had certain patents which were opposed by Respondent No. 2.

19. Learned Counsel further submitted that the non-payment of fees and non-filing of the review petition in the prescribed form is a mere procedural infirmity which should not stand in the way of substantive justice. It was submitted that learned Single Judge of this Court felt that there was substance in the objections of the petitioner and had thus directed the Controller to look into the review on merits and not on procedural issues and by adverting to the procedural infirmities, the learned Assistant Controller had not complied with the said order.

20. Learned senior counsel also contended that the reliance placed by the learned Assistant Controller on the judgment in the case of Whirlpool Corporation v. Registrar of Trademarks, Mumbai and Ors., supra is misplaced as the same was delivered under the old trademark law. The said law has now changed and no equivalent provisions exist under the said Act as amended in the year 2005.

21. Learned Counsel for Respondent No. 1 submitted that the First examination report for IP 2769/DEL/1997 was issued by the patent office on 9-02-2004 On 4-02-2005, Respondent No. 2 (applicant for the grant of patent) re-filed the documents together with a reply to the examination report and petition under Rules 137 and 138 of the said rules and an abstract with title. On 9-02-2005, the agent of respondent No. 2 amended the claims and met all technical and formal objections after discussion with the examiner. The examiner noted in file that the case was in order for the grant of patent and it may be granted. The abstract of Indian Application 2769/DEL/1997 was published in the Patent Office Journal under Section 11(a) on 03.06.2005. The office waited for three months i.e. till 3-09-2005 so that third party representations could be received as per statutory provisions.

22. Learned Counsel for Respondent No. 1 submitted that an application under Section 78 of the said Act was received on 2-09-2005. On 6-9-2005 pursuant to

the scrutiny of the application under Section 78 of the said Act was allowed by the learned Assistant Controller.

23. Learned Counsel submitted that the petitioner filed yet another application on 12.04.2006 for reviewing the order of the learned Assistant Controller dated 28.02.2006 and on 01.05.2006 the Assistant Controller sought guidance from the Controller as to how the situation has to be dealt with. Learned Counsel further submitted that on 02.05.2006, the Assistant Controller informed the parties that the grant of patents stood withdrawn since respondent No. 2 had carried out large scale technical amendments which are beyond the scope of the original disclosure.

24. Learned Counsel submitted that as per the order of this Hon"ble Court, Respondent No. 2 (applicant for the patent) and the petitioner were intimated about the date of hearing before the patent office i.e. 19-07-2006. The parties were asked to submit the relevant documents and the parties were heard on that day by the concerned officer who had dealt with the case earlier.

25. Learned Counsel for respondent No. 1 stated that respondent No. 1 would be willing to reconsider the application of the petitioner on merits especially as the large scale technical amendments carried out by Respondent No. 2 are beyond the scope of the original disclosure.

26. Learned Senior Counsel for Respondent No. 2 submitted that the petitioner has an effective and efficacious remedy under Section 64 of the said Act for revocation of patent and the same has been availed by the petitioner by filing a counter claim No. 652/2006 for the revocation of patent no 197257 in C.S. (OS) 189/2006 on 3-4-2006. In the said counter claim, the Petitioner has invoked Section 64(1)(c), (d), (h), (i), (j), (k) and (m) and revocation has been sought in para 12 specifically on the ground that "the complete specification as patented is not patentable under the Act since the same has been amended prior to the grant, to claim or describe matters not in substance disclosed or shown in the specification before the amendment". The amendments are challenged as being

contrary to the provisions of the said Act in particular, Section 59. Learned Senior Counsel also submitted that the Petitioner has challenged the same amendments in the written statement filed by the Petitioner in infringement suit C.S. (OS) 189/2006.

27. Learned Senior Counsel for Respondent No. 2 submitted that the said Act is a complete code in itself and Section 77 of the said Act confers certain powers of a civil court on the controller including the power of "reviewing his own decision on application made within prescribed time or in the prescribed manner". The Controller as per Section 15 of the said Act "may require the application, specification of the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application" and "where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made there under" Section 78 of the said Act empowers the Controller to correct clerical errors and Section 57(1) empowers the Controller to allow by an application, an amendment of a patent or the complete specification or any other document related thereto subject to conditions. Further Section 13(3) recognises this power in the course of search and makes it clear that where such specification is amended, the amended specification shall be examined and investigated. Learned Counsel submitted that the action of the Controller is thus in consonance with the said Act and the Petitioner has no right to complain against the same.

28. Learned Senior Counsel for Respondent No. 2 submitted that the petitioner did not raise any objection to the grant of the patent at any stage. Under Section 25 of the said Act, any person is entitled to represent in writing by way of opposition to the Controller against the grant of patent on any of the grounds specified in clauses (a) to (k) under sub-section 1 of Section 25. The ground under clause (g) i.e. "that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed" is the case set up by the petitioner in its application for revocation. It is submitted

that the petitioner failed to file any opposition within the prescribed period of three months while the Controller in fact waited for a period of six months from 3.06.2005 till the grant of the patent on 02-12-2005. Learned Counsel thus contended that the petitioner has forfeited its right and the jurisdiction of this Court under Article 227 is not available to the petitioner on account of its acquiescence.

29. Learned Counsel submitted that the power of superintendence of this Court under Article 227 does not vest this Court with unlimited prerogative to correct inter alia wrong decisions made within the limits of the jurisdiction of the court or tribunal and this Court would interfere only where the order of the Court below or Tribunal is without jurisdiction.

30. I have given thoughtful consideration to the rival submissions of the learned Counsels for the parties.

31. In my considered view the nature and scope of the impugned order was required to be in conformity with the directions passed in Writ Petition (Civil) 7841- 2/2006 decided on 10.05.2006 filed by respondent No.2 against respondent No.1. The petitioner was an intervening party in the said proceedings. The primary reason for passing the order, as apparent from the order itself, is the failure of principles of audi alteram partem by the Assistant Controller whereby the petitioner did not get an opportunity of being heard. Thereafter the petition was disposed of on the consent terms.

32. There were really two aspects which had been examined by the Assistant Controller. Firstly the application filed by the petitioner dated 18.01.2006 seeking review of the order dated 06.09.2005 whereby correction of the alleged typographical errors arising from a problem of translation in an application for patent of respondent No. 2 had been allowed.

33. The second aspect was whether the pendency of suit No.189/06 on the Original Side of this Court would come in the way of maintainability of such an

application as filed by the petitioner.

34. The first question has been dealt with in para 6 of the impugned order. There are five reasons why a finding has been arrived at against the petitioner The first three are technical defects in the application filed by the petitioner about the fee to be paid and the prescribed mode of the application. It is gainsay to state that such defects could easily have been directed to be cured and ought not to have been the grounds to reject the application, more so in view of the directions passed on 10.05.2006. The object and spirit of the order was to see adjudication of the application on merits. In respect of the fourth aspect, it is to be noticed that the order passed on 10.05.2006 was a consent order and it had been agreed to by respondent No. 2 that the application would be considered on merits. There was of course the second aspect about whether such an application would be maintainable in view of the pendency of the suit. Thus this aspect also could not come in the way of adjudication on merits of the application.

35. The fifth point in this behalf is a confusion over whether any order was or was not actually passed on 06.09.2005. In this behalf, the concerned authority/respondent No. 1 has been approbating and reprobating taking conflicting stands. Initially a stand was taken that there was no order dated 06.09.2005. Thereafter this stand was modified to state that no formal orders were passed on 06.09.2005. The fact, however, remains that there was some order passed on the file whether formal or not. The result is that there has actually been no real adjudication of the merits in pursuance to the order passed on 10.05.2006. Insofar as the effect of the pendency of the suit is concerned, all that has been stated is that since High Court is a superior judicial authority, it would not be appropriate for the Assistant Controller to exercise the jurisdiction in this behalf. The Assistant Controller has also observed that in view of the proviso to Section 57(1) of the said Act he is not to pass any order allowing or refusing the amendments since a suit for infringement of the patent as well as a proceeding for revocation of the patent are pending before this Court.

36. Another aspect which has weighed with the Assistant Controller is the ramifications of provisions of Section 117(A) r/w Sections 117(C) and 117(D) of the said Act and the prohibition contained therein from the Controller of Patents exercising any authority on an appeal or review in respect of Orders passed inter alia under Section 15, 57 and 78 of the said Act.

37. Learned senior Counsel for the petitioner has pointed out that Section 78 which deals with power of Controller to correct clerical errors is distinct from the powers to be exercised under Section 57 of the said Act. Section 78 of the said Act only confers power to correct any clerical error in any patent or any specifications or other documents. Section 57 of the said Act refers to the amendment of an application made by a patentee. The Assistant Controller had exercised his powers purportedly under Section 78 of the said Act and thus the proviso to Section 57 of the said Act would have no application.

38. This aspect is clear from the reading of the said provisions which are as under:

> 57. Amendment of application and specification before Controller
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> 1) Subject to the provisions of Section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification to be amended subject to such conditions, if any, as the Controller thinks fit:
>
> Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend.
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> 78. Power of Controller to correct clerical errors etc (1) Without prejudice to the provisions contained in Sections 57 and 59 as regards amendment of applications for patents or complete specifications and subject to the provisions of Section 44, the Controller may, in accordance with the provisions of this section, correct any clerical error in any patent or in any specification or other

> document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.

39. An important aspect in the present proceedings is the stand taken by the Controller of Patents himself. It is the stand now taken in the affidavit that on scrutiny, it has been found that the amendments could not be categorized really as clerical errors.

40. In the communication dated 02.05.2006 also a stand was taken by respondent No. 1 while nullifying the ground of patent that large scale technical amendments which have been made appear to be beyond the scope of the original disclosure. The amendments were carried out after the original application was published in the Patent Journal.

41. It is trite to say that while purporting to exercise powers under Section 78 of the said Act, there cannot be any amendment of the application as in that eventuality the procedure of Section 57 r/w Section 59 of the said Act must be followed. There appears to be also absence of any power of the Controller to make any amendment suo motu. The scrutiny has to take place whether really speaking the plea of respondent No. 2 that it was a mistake in translation can be accepted by finding out the correct translation as compared to the original.

42. In view of the aforesaid position, I am of the considered view that the impugned order cannot be sustained as it suffers from a patent error and improper exercise of jurisdiction by the Assistant Controller and is liable to be set aside and the matter remanded back to respondent No. 1 for adjudication on merits in accordance with the letter and spirit of the order dated 10.05.2006.

43. Petition is allowed leaving the parties to bear their own costs.