IN THE HIGH COURT AT CALCUTTA

CIVIL REVISIONAL JURISDICTION

APPELLATE SIDE

Present:-

THE HON'BLE CHIEF JUSTICE T.S SIVAGNANAM

HON'BLE JUSTICE CHAITALI CHATTERJEE DAS

MAT 903 OF 2024

WITH

CAN/2/2024

Gunjan Sinha @ Kanishk Sinha and Anr.

Vs.

Union of India Ors.

For the Appellants	**:**	**Mr. Kanishk Sinha (In-Person)** **Ms. Lipika Das Sinha (In-Person)**
For the Respondent No. 1 & 2	**:**	**Mr. Sukumar Bhattacharyaa, Sr. Adv.** **Mr. Avinash Kankani, Adv.**
Last Heard on	**:**	**12.03.2025**
Judgement on	**:**	**22.04.2025**

CHAITALI CHATTERJEE DAS, J. :-

1. This intra Court appeal has been filed against the judgement and order dated May 7, 2024 passed in WPA No 8691 of 2023 dismissing the writ petition and upholding the validity of Section 53 of the Patent Act 1970 as intra vires the Constitution.

Brief Resume of the case

2. The applicant applied for grant of patent on 2nd May,2025 as enumerated in Section 25 of the Patent Act and said Patent was granted on 28.12.2012 valid for 20 years with effect from the date of application i:e 2nd May, 2005. By virtue of deed of assignment dated July 20 ,2021 the present appellant No.1 assigned the entire share of Patent in favour of Appellant No.2 .Subsequently vide an Addendum Agreement dated June 8,2022 the said share was divided into 50% i:e 50% to Mr. Gunjan @ Kanishka Sinha and 50% is retained with the Appellant No. 1. The writ petitioner initially invoked the extraordinary writ jurisdiction with the prayers inter alia for extension of the Patent for 15years as a penalty for harassing the petitioner who is a citizen of India and for unnecessarily not implementing the order of injunction so that the term of the Patent shall come to an end along with the prayer for withdrawal and / or rescind section 53 of the Patent Act before the Hon'ble Court. The Learned Single Bench vide an order dated June 17,2022 dismissed the said Writ petition being WPA 1963 of2022 giving liberty to the petitioner to claim damages against the Authorities for the delay in granting Patent. The 1st Appellant filed an appeal before the Hon'ble Division Bench and raised the issue of constitutional validity of section 53 of the Patent Act, 1970. The Hon'ble Division Bench vide an order dated September 15,2022 dismissed the appeal with a liberty to the Appellant –in-person to approach the Writ court for Review. Accordingly the Review application was filed being RVW 224of 2022 in WPA no.1963 of 2022 which was also dismissed on March 14, 2023. The Appellant no. 1 then filed the

subsequent Writ petition being WPA no.8691 of 2023 for issuance of the following directions :-

a) A writ in the nature of Mandamus commanding the respondents to decide the petitioner's representation dated February 1, 2022 requesting for withdrawal/amendment and or rescinding Section 53 of the patent Act 1970.

b) A writ in the nature of Mandamus directing the respondents to rescind /cancel/withdraw the impugned Section 53 of the Patents Act 1970 and

c) Writ in the nature of certiorari directing the respondents to produce the entire records of Act 39 of 1970 namely the Patents Act and on being so certified quash the impugned Section 53 of the Patents Act as ultra vires to the Constitution of India.

3. By way of an application for intervention dated April 25,2024 the Appellant No. 2 has been impleaded in the vide an order dated April 30,2024 in the original writ petition . The petitioner has challenged the validity of the procedures ,the decision of the Controller leading to the publication of the grant and the long period of waiting by the patentee who in case of any infringement cannot knock the court of law because of a specific stipulation mentioned in section 11 A(7) of the Patent Act,1970.The further contention of the appellants are they have come before this court by virtue of the liberty granted to him by the Hon'ble Court

4. The Learned Single Bench heard the said writ petition and dismissed the same with the observation that Section 53 of the Patents Act 1970 is intra vires the Constitution. Being aggrieved by the said order of the Hon'ble Single Bench the Appellants have filed the present appeal.

Submission

5. It is submitted by the Appellants –in- person that the grant of the Patent was given being no. 254875 whereby it was mentioned as follows:-

> ***"It is hereby certified that a patent has been granted to the patentee for an invention entitled " A FUEL CELL SUSTEM AND AN EFCEINT ECO-FRIENDLY VEHICLE MOUNTED WITH FUEL CELL SYSTEM" as disclosed in the above mentioned application for the term of 20 years from the 2 day of May 2005, in accordance with the provisions of the Patents Act,1970."***

6. The said Patent was granted on 28.12.12 on the basis of an application filed on 2nd of May, 2005 i:e after a period of 7 years ,with effect from 2nd May, 2005.

7. The bone of contention of the Appellants for challenging such provision is that on one hand under section 53 of the said Act ,the grant is effected from the date of application and on the other hand section 11(A) (7) says that on and from the date of publication of the application for Patent and until the date of grant of a Patent in respect of such application, the applicant shall have the right and privileges as if the a Patent for the invention is granted on the date of publication provided the applicant shall not be entitled to institute any proceeding for infringement until Patent has been granted .

8. Further case of the appellants is that the Rule 80 (i.e.) Renewal Fees payable at the expiration of Second Year from the date of Patent or any succeeding year is contrary to Section 53 of the Act. Government of India took the fees for renewal of the said Patent for 20 years that is 2005 to 2025 when the Patent not received or exploited due to not granting of the

Patent by the Government of India which was granted only after 2012 by issuing the certificate.

9. On perusal of the record it transpires that the petitioner filed a writ petition before the High Court of Judicature at Patna on 17.12.12 whereby direction was given to grant Patent within two months from the date and despite such order the Government of India did not enforce the said order for which a contempt proceeding had to be filed. The delay in granting the patent after 7 years by the Government of India and further demanding renewal fees for the said unused period is a clear case of double jeopardy and such violate Article 22 of the Constitution of India .Accordingly the petitioner submitted representation dated 28th December, 2021 to the Secretary, Department of Industrial Policy and Promotion, Ministry of Commerce and Industry, Udyog Bhawan New Delhi 110011.

10. The appellant has relied upon the decisions of Hon'ble Delhi High Court in ***FERID ALLANI Versus Union of India and others*** in WP (C) 7/2014 and CM 40736/2019 dated 12th December, 2019, ***Proctor and Gamble Company Versus Controller of Patents and Designs***, dated 8th December, of High Court of Delhi, ***Nittoo Denko Corporation Versus Union of India and others*** passed in WP(C) No 3742 of 2013 by the High Court of Delhi .

11. The Learned Senior Advocate appearing for the Respondents contended that claim of the Appellants is barred by the principle of res judicata as earlier writ petition being WPA No 1963 of 2022 was filed seeking similar relief and by an order dated June 17, 2022 the Hon'ble Court was pleased to dismiss the writ petition which fact has been supressed by the petitioner

in the writ petition. Against the order of dismissal of the said writ petition the petitioner also preferred an appeal before Hon'ble Division Bench and vide an order dated September 15, 2022, the Hon'ble Division Bench was pleased to dismiss the appeal and the petitioner further preferred a review before the Hon'ble Court which was also dismissed vide an order dated 14th March, 2023. The Learned Senior Advocate further submitted that the patent application was filed by the 1st appellant on 2nd of May, 2005 and Letter of Patent was issued by the Government of India on 28.12.12, the representation before the Government of India was filed on 25th January, 2022 for extension of validity or tenure of the patent dated 28.12.12. On 1st of February, 2022 representation was filed before the Government of India for withdrawal/amendment and on 2nd February,2022 the writ petition was filed which was dismissed by order dated May 7, 2024 with the specific finding that Section 53 of the Patent Act is Intra vires the Constitution. Therefore the appeal has got no merit and is liable to be dismissed.

Heard the submissions of the Appellants appearing in person and the learned advocate appearing for the respondents and perused the materials placed on record.

Analysis

12. On careful perusal of the materials on record and considering the rival contentions, the seminal issue which falls for consideration appears to be, whether enough ground has been established to call for interference with the impugned judgement and order passed and/ or whether the applicant

has been able to make out any case for declaring section 53 of the Patent Act as ultra vires

13. The issue espoused before this court by the petitioner is that there should be a specific time for grant of the patent when the grant is for a stipulated period and the patentee will have to pray for renewal on payment of renewal fees, when Section 11(7) of the Patent Act 1970 speaks otherwise. The petitioner is aggrieved by Section 53 of the Patents Act 1970 read with Section 11(A)(7), as in view of the rights given under Section 11(A)(7) i.e. privileges and rights as if a patent for the intervention had been granted on the date of publication of the application. It is strenuously contended that Letter of Patent issued by the Government of India is merely a piece of paper until it was not enforced by way of an infringement suits, so the words in section 11(A)(7) at pre-grant stage is superfluous and redundant. It further transpires from the written notes of argument filed before this court in the Paper Book that this writ petition has been filed pursuant to a liberty granted by the Hon'ble court in a Review petition ,to challenge the vires of section 53 of the Patent Act. On perusal of the impugned order a clear observation has been made to the following effect t "*it is made clear that nothing of this order shall preclude the petitioner to independently challenge the vires of section 53 of the Patents Act , 1970 before the appropriate Bench having determination to hear such matter.*"

However as it appears the argument made in the writ petition followed by the Review Application regarding the validity or vires of such provision when no such prayer was made in the writ petition.

14. The contention of the Learned Senior Advocate for the respondent that there cannot be any comparison between Section 11(A) (7) and Section 53 of the Patent Act 1970 as both sections are independent of each other and applicable at different stage of the Patent process. Section 11(A)(7) reads as follows:-

> *(7) On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application ,the applicant shall have the ……privileges and rights as if a patent for intervention had been granted on the date of the publication of the application:-*

Provided that the applicant shall not be entitled to institute any proceeding for infringement until the patent has been granted:-

Provided further that the rights of a patent in respect of applicant made under Sub Section (2) of Section 5 before the 1st day of January 2025 shall accrue from the date of grant of the patent:-

Provided also that patent is granted in respect of applications made under sub Sections (2) of Section 5 the patent holder shall only be entitled to receive reasonable royalty form such enterprises which have made significant Investment and were producing and marking the concern product prior to the 1st day of January 2005 and which continue to manufacture the product by the patent on the date of grant of the patent and no infringement proceedings shall be initiated against such enterprises.

15. The above provision was introduced by way of an Amendment Act, 2005 and the proviso to the said Section 11(A)(7) clearly states that the applicant shall not be entitled to institute in proceedings for infringement until the patent has been granted. Therefore it is clear that from the object and intent of the said provision is to provide some rights to an applicant whose application has been published. Section 53 on the other hand deals with the term of patent which shall be applicable from the date of application of the patent. In terms of the said provision a patent shall cease to have effect notwithstanding anything before or in the Act on the expiration of the period prescribed for the payment of any renewal fee if that fee is not paid within the prescribed period.

Sub Section (4) of section 53 reads as:-

> *' notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal Fee or on expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection'.*

16. Therefore by no stretch of imagination it can be said that the scope and purport of Section 53 of the Patent Act 1970 is similar to that of Section 11-A (7) .Unless the right of an applicant is crystallised , Section 53 of the Patents Act will not come into play. The object to introduce section 11 (A)(7) as it appears is that the same seeks to provide provisional rights to the applicant till publication of the Patent. It is pertinent to mention that prior to the Amendment Act 38 of 2002 the term of Patent granted in respect of any invention was 14 years from the date of Patent. After the amendment the term has been extended for a period of 20 years from the date of filing of

the application of the Patent. In the instant case the date of filing of the application was May 2nd, 2005 and the date of grant was 28.12.2012 which is admittedly after 7 years. The contention of the applicant in his representation before the Secretary Industrial Policy and promotion, Ministry of Commerce and Industry Uttyayog Bhawan , New Delhi dated December 2021 was to withdraw or rescind section 53 of the Patents Act since it violates Article 22 of the Constitution of India which was not considered and after which the writ petition was filed. The petitioner never gave representation expressing his concern about the long delay in granting the certificate which will in way affect his right of Patent since the Certificate was granted 28.12.12. The Appellants never approached the writ Court immediately after the Patent was granted on 28.12.2012 .The written representation or the writ petition is absolutely silent about any ground as to why such Section 53 will have to be rescinded or withdrawn or amended more so that is the intention of the legislature and by way of amendment of the Patent Act in the year 2005, section 11(A) has been incorporated giving certain privileges to the applicant as if a patent for the intervention had been granted on the date of publication of the application. Even if it is construed that the said provision has barred the applicant to institute any proceedings for infringement until the Patent has been granted, no such case of infringement has been made out in the body of the petition or that because of such clause the petitioner's right has been prejudiced. The applicant has principally challenged the vires of section 53 of the Patent Act and therefore a definite ground ought to have been given in order to establish that any such ground exits to challenge the *Vires.*

17. In the case of **Proctor and Gamble** the patent was refused on the ground of lack of inventive step under section 2 (1) (ja) of the Act long after 4 years when the notice under section 8(2) was issued. The Hon'ble Court in such circumstances observed that pursuant to the Patent Rules the intention of the legislature appears to ensure to avoid unnecessary delays in the progress of grant of patent and in absence of any specific time period it is expected the Patent officer will pass the order within a reasonable period of hearing .The Hon'ble Court thereby remanded of the matter for fresh reconsideration.

18. In ***Freid Allani vs Union of India*** also the writ petition was filed challenging the order of refusal to grant patent as per the application of the applicant. The patent office raised objection as to the Novelty and Patentability of the invention and the Hon'ble Court remand the matter for re-examination.

19. The aforementioned judgements are not applicable in the instant case in view of the different facts and circumstances.

20. In the other case which the appellants had relied upon the Report submitted by the Learned Central Government Standing Counsel in ***Nittoo Denko Corporation vs Union of India*** on 27.002.2014 which shows constitution of a committee pursuant to the direction of Hon'ble Delhi High Court in the writ petition to examine certain issues touching the feasibility of expedited examination. However nothing has been placed before this

court by either of the parties regarding the acceptance of such report by the court followed by any specific direction. Be that as it may nothing has been placed to establish such situation where a provision framed by the legislature after following innumerable procedure as enshrined in the Constitution of India should have to be declared as Ultra Vires which otherwise means beyond one's legal power or authority .

21. So far the issue of not having locus standi by the petitioner the same was set at rest in the judgement delivered by the Learned Single Judge where it was considered that the petitioner/Appellant the assignee of the patent has been impleaded in favour of whom the said Patent was assigned.

22. The Learned Single Judge observed that *"the amended section 53 is an improvement in as much as the term of patent has been increased substantially in tune with TRIPS Agreement ,hence there cannot be found any irrationality in the Legislature ,in its discretion ,having extended the term of Patent uniformly for all types of patent to 20 years from the date of application ,while on the other hand ,conferring certain limited additional rights to an applicant for patent from the date of publication to the grant of patent under section 11-A(7) of the Act thus there is no conflict between the two sections ."*

23. The appellant while seeking to declare Section 53 of the Act as ultra vires also seeks for a direction upon the Union of India to suitably amend Section 53 in consonance with Section 11A(7). To legislate or to recommend the Government to legislate in a particular manner or otherwise is not

within the domain of a Court exercising jurisdiction under Article 226 of the Constitution of India. The appellant would contend that while Section 53 of the Act grants patent from the date of filing the application Section 11A(7) states that on and from the publication of application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of application. Therefore, it is contended by the appellants that both these provisions are contrary to each other and consequently, Section 53 has to be struck down and both the provisions have to be brought in consonance with each other. The argument put forth by the appellant is devoid of substance. Chapter IV of the Patents Act, 1970 deals with Publication and Examination of Applications. Section 11A as inserted by Act 38 of 2002 with effect from 20.05.2023, deals with Publication of Application. The various sub-sections namely Sub-sections (1) to (6) deal with the procedural aspect and the consequences pursuant to publication of applications. Sub-Section (7) was inserted by Act 15 of 2005 with retrospective effect from 01.01.2005. The said sub-section states that on and from the grant of patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for invention had been granted on the date of publication of the application. At this juncture, it is to be noted that the patent rights are statutory rights and no common law rights are available in patents. Hence, an action for infringement would be maintainable only if the patent is granted and the patent is live. Apart from Section 11A(7) making the position clear if we look into Section 62 of the Act which deals with right of patentees of lapsed patents which have been

restored, Sub-section(2) states that no suit or other proceedings shall be commenced or prosecuted in respect of an infringement of a patent committed between the date on which the patent ceased to have effect and the date of publication of the application for restoration of patent ("*date of publication" submitted by Act 15 of 2005 with effect from 01.01.2005 for "date of advertisement*").

Conclusion

24. The mandate of the statute is that an action of infringement may be brought about only if a patent has been granted though damages can be sought with effect from the date of publication. Section 53 falls in Chapter VIII of the Act which deals with "Grant Of Patents and Rights Conferred Thereby". Therefore, both provisions namely Section 11A(7) and Section 53 operate in two different fields and the rights flowing from those provisions cannot be superimposed nor read together to give a different meaning than what is intended by the statute.

As rightly observed by the Hon'ble Single Bench the rights conferred under Section 11A (7) provides for interim protection from the publication date to the grant date, safeguarding the applicant's interest without prematurely granting full patent rights. Hence, the decision rendered by the Hon'ble Single Bench lays down the correct legal principle by rightly taking note of the legal framework.

25. Upon hearing the appellants who were appearing in person and perusing the pleadings in the writ petition as well as the notes of arguments,

the grievance of the appellant seems to be regarding their pre-grant rights. In USA, Patent Term Adjustment (PTA) has been introduced which compensates the patentee for delay in the approval process. This issue was considered by the High Court of Delhi in ***Nittoo Denko Corporation (Supra)*** and by order dated 9th October, 2015 a committee was constituted to consider several aspects in relation to examination of patent application in India. Among several issues which were considered the Committee examined the aspect that if expedited examination is not considered feasible, whether waiver of maintenance fees for the delayed period or other measures to be considered in order to compensate the patentees for the time consumed in the examination process. The committee so constituted observed as regards the patent term extension for the time lost in the process of the application in the patent office, such provision exists only in the USA and the proposal is not conducive to India where the monopoly of 20 years itself is considered too long to block genuine competition.

26. Further, the committee observed that in today's world, technologies covered by inventions/ patents become obsolete too fast and encouraging obsolete technologies and protecting them with longer patent term is not advisable. It was further observed that nothing prevents applicant/ inventor from taking steps for regulatory approvals and commercialization in the meantime, while the patent application is pending. Therefore, the committee which was constituted by the Court in ***Nittoo Denko Corporation*** has opined that the USA model regarding Patent Term Extension (PTA) for the time lost in processing of the application in the patent office is not conducive

to India. In any event, these are all issues which are best left to the legislative minds to ponder upon and it is not for the Court to suggest as to how the legislation is to be drafted. In the event, the legislation is drafted and the same comes up for judicial scrutiny then the Court would consider the validity of such legislation and in all other cases the duty of the Court is to interpret the law and not to enact the law.

27. In view of the above discussions and considering the factual aspects with the relevant provisions of the Constitution of India this court finds no merit in the instant appeal to interfere with the judgement and order passed by the Learned Single Judge.

28. Hence the instant appeal stands dismissed.

29. No order as to the costs.

30. Urgent certified copy be supplied at once on the prayer of the Appellants.

I Agree

(CHAITALI CHATTERJEE DAS, J.) **(T.S. SIVAGNANAM, CJ.)**