



**IN THE HIGH COURT OF ORISSA AT CUTTACK**

**W.P.(C) No.19128 of 2024**

(In the matter of an application under Article 226 & 227 of the Constitution of India)

**M/s.Green Energy Resources, ... Petitioner**  
**Sambalpur**

-versus-

**Union of India and others ... Opposite Parties**

Advocate(s) appeared in this case:-

For Petitioner : Mr.P.Parija, Advocate

For Opposite Parties : Mr.S.S.Kashyap,  
Senior Panel Counsel

**CORAM: JUSTICE B.P. ROUTRAY**

**JUDGMENT**  
**12<sup>th</sup> February, 2026**

**B.P. Routray, J.**

1. Present Petitioner namely – M/s.Green Energy Resources, Sambalpur has prayed for restoration of the Patent granted in his favour on 22<sup>nd</sup> September 2017 vide Annexure-2, in respect of Patent No.343974. The Patent was in effect till 22<sup>nd</sup> September 2021



and then ceased to effect owing to failure to deposit the renewal fees by the Petitioner.

2. The Patent is in respect of, “*a Novel Method For Detoxification Of Spent Potlining (SPL) By Controlled Head Treatment*”. Admittedly, as per the certificate dated 22<sup>nd</sup> September 2017 under Annexure -2 granted by the authority, the Patent has been registered in favour of the Petitioner and it remains undisputed that said Patent continued to be in effect in favour of the Petitioner till 22<sup>nd</sup> September 2021. Section 60 (1) of the Patents Act, 1970 prescribes the statutory requirement for payment of renewal of fee and failure to the same, to cease the effect of the Patent and it further speaks for renewal of Patent which have been ceased to have effect due to the reason of failure to pay the renewal fees within the prescribed period in terms of Section 53 or Section 142(4), authorizing patentee or his legal representative to apply for restoration of the Patent within a period of eighteen months from the date of which the Patent was ceased to have effect. Sub-section 3 of Section 60 postulates that an application for restoration, as per Sub-section 1, shall fully set out the circumstances which led to the failure to pay the prescribed fee, and the Controller may require such further evidence as he may think necessary from the applicant.



3. In view of the admitted position that the Patent granted in favour of the Petitioner has ceased to effect with effect from 22<sup>nd</sup> September 2017, it is submitted by the Petitioner that the scope of application for restoration of the Patent in terms of Section 60 is now closed for the Petitioner as the dedicated page in the portal could not be opened now after expiry of the prescribe period of eighteen months, which compelled him to approach this Court in present writ petition.

4. Mr.Kashyap, learned Senior Panel Counsel on behalf of the Controller though disputes the contention of the Petitioner that his application was never received by the authority for restoration of the Patent, but he agrees to the submission that for such restoration of the Patent the applicant has no option to submit a hard copy.

5. In view of the contentions made by the Petitioner, the sole question falls for determination that, whether at such belated stage the Petitioner can be allowed to apply for restoration of his Patent, that has expired since 22<sup>nd</sup> September 2021.

It is explained by Mr.Parija, learned counsel for the Petitioner that such failure in depositing the renewal fee within the time stipulated is solely due to the negligence of authorized agent



appointed by the Petitioner for the purpose. The Petitioner relying upon his authorized agent was in the impression that the same has been deposited from time to time in making the Patent effective. But to his surprise he suddenly came to know in June 2024 that his Patent has been ceased to effect due to non-payment of renewal fees by the authorized agent. A further ground is taken by Mr.Parija, learned counsel for the Petitioner, that, when the Patent was ceased to effect on 22<sup>nd</sup> September 2021, the same was within Covid-19 Pandemic period and therefore there were several obstacles to verify the force of the Patent by physically going to the Office of Controller.

6. Delhi High Court in *Bry-Air Prokon Sagi and others vrs. Union of India and another, 2022 SCC OnLine Del 5197* have observed at Para-23 & 28, as follows:-

“23. It is a settled position of law that errors/negligence on part of the patent agent without any contributory negligence on the part of the Applicant, has been liberally considered by the Courts, as the consequences of a patent application being abandoned or the lapsing of a patent due to non-deposit of renewal fee are very serious, where the applicant loses his right of claiming exclusivity to an invention.

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28. There is an added reason why this Court is inclined to permit the Petitioners to file for restoration of the patent. As noted above, the period of three months under Section 142(4) of the Act for payment of annuities expired on 27.05.2018. An extended period of six months from the said date was available to the Petitioners for payment of annuities under Section 142(4) of the Act. Additionally, under Section 60(1) of the Act, Petitioners are entitled to make an application for restoration of the patent within 18 months from the date on which the patent ceased to have effect. If the first Patent Agent had been diligent, the annuities would have been deposited by 27.05.2018 or within the extended period expiring on 27.11.2018, on the extension being sought. As per the provisions of the Act, if the fee was not paid within the extended period, Petitioners were entitled to approach the Controller upto 27.05.2020 under Section 60(1) of the Act. Since the Petitioners were unaware of the non-prosecution by the first Patent Agent and in depositing the annuities, the benefit of the extended period of 6 months was lost. Insofar as the 18 months period available to an Applicant under Section 60(1) of the Act is concerned, as rightly contended by the Petitioners, a part of this period overlapped with the Pandemic COVID-19 and they are entitled to the benefit of the extension of limitation period by the Supreme Court in *SMWP (C) No. 3/2020 In Re : Cognizance for Extension of Limitation*. Vide order dated 10.01.2022, the Supreme Court directed that in cases where limitation would have expired between 15.03.2020 to 28.02.2022, notwithstanding the actual balance period of limitation remaining, limitation shall extend for a period of 90 days from 01.03.2022. As averred in the appeal, Petitioners have approached the Controller *albeit* with a representation on 12.05.2022,



seeking restoration of the patent and are squarely covered by the said judgment. Looking at the extraordinary facts and circumstances of this case, as aforementioned, in my view, it would be a travesty of justice if on technical grounds the Patent is allowed to lapse. Petitioners are thus held entitled to file an application for restoration, in the prescribed Form along with the prescribed fee, within a period of 4 weeks from today.”

7. Further, in another case of Delhi High Court in *European Union Represented by the European Commission vrs. Union of India and others, 2022 SCC OnLine Del 1793*, it has been explained while dealing with the similar issue that the mistake of a Patent agent would be similar to the mistake of an Advocate representing the parties in the litigation, and it is settled legal position that the litigant ought not to suffer for any mistake committed by the concerned Advocates. The relevant observations with regard to the question of restoration of the Patent after expiry of prescribed time period in terms of provisions of the Patents Act has been considered, as follows:-

“49. It is clear that in the prosecution of patent applications, deadlines fixed in the Act read with the Rules fall into two categories:

- i. Deadlines which can be extended.
- ii. Deadlines which cannot be extended.



**50.** In the opinion of this Court, patent agents are expected to know of which deadlines are extendable and which are not extendable. Non-extendable deadlines include *inter alia*-

- deadlines relating to entry of the application into the national phase,
- timelines for filing of request for examination,
- timelines for putting an application in order for grant etc.,

**51.** The provisions of the Act and the Rules are abundantly clear as to which deadlines can be extended and which cannot be extended.

**52.** From a reading of the aforementioned decisions, insofar as the time period for filing of request for examination is concerned, the decision in *Carlos Alberto Perez Lafuente* (supra) of the Division Bench of this Court has categorically held that the time period is mandatory and cannot be extended even in the facts of a case where the patent agent is found to be negligent. However, this Court notes that in the case of response to the FER is concerned, in *Ferid Allani* (supra), *Telefonaktiebolaget Ericsson* (supra), and *PNB Vesper Life Sciences* (supra) High Courts while exercising writ jurisdiction have granted extension in filing of the response to the FER including on the ground that the applicant did not have the intention to abandon. In such extraordinary situations, the Court has exercised its writ jurisdiction to ensure that valuable statutory rights of the Applicant are not completely deprived of. Thus, before arriving at a conclusion that an Applicant has abandoned its application, due to non-filing of Reply to the FER/first statement of objections, while the Controller may have no power to extend the deadline within which the application has to be put in order for grant, courts exercising writ jurisdiction, may in rare cases



permit the same, after examining the factual matrix to see as to whether the Applicant in fact intended to abandon the patent or not. Any extraordinary circumstances could also be considered by the Court, such as negligence by the patent agent, docketing error and whether the Applicant has been diligent. However, lack of follow-up by the Applicant would be a circumstance which may lead to an inference that the applicant intended to abandon the patent. Thus, the court would have to examine the circumstances in the peculiar facts of each case.

**53.** The present writ petitions clearly highlight the important role of patent agents in prosecuting patent applications. In these cases, it is seen that the Applicant had no intention to abandon the application at all. Firstly, after the filing of the patent application in 2012, the request for examination was filed within the time prescribed. Secondly, even when there was a change in the law firm in Europe in 2017 which was coordinating the prosecution of the patent, the Indian patent agent was duly notified of the said fact. The first patent agent had even confirmed the receipt of the said instructions. Thirdly, there were repeated attempts through email to contact the first patent agent and follow up was done on the status of the Petitioner's applications.

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**58.** The decisions discussed above would show that inadvertent errors or errors of patent agents have been liberally considered by the Court. The consequences of patent being abandoned is quite extreme i.e., the Applicant is deprived of exclusivity for the invention completely. In the opinion of the Court, such a consequence ought not to visit the the applicant for no fault of the Applicant. In the facts of these cases, the Applicant had no intention to abandon the application. It has taken all measures possible to prosecute these applications. The Applicant was



conscious of the fact that the patent may be maturing for examination and took the initiative to keep in touch with the patent agent from the very inception.

**59.** Therefore, the question that arises is whether this Court while exercising writ jurisdiction under Article 226 and 227 ought to condone the delay and restore the patent applications of the Petitioner.

**60.** The Court is convinced that there was no intention to abandon on behalf of the Petitioner, instead, the Petitioner's actions indicate that they were actively pursuing the application. Moreover, the judicial opinion in respect of responses to FER or other deadlines seems to suggest that if the Applicant did not have an intention to abandon and if the Court is convinced that there was a mistake of the patent agent and the Applicant is able to establish full diligence, the court ought to be liberal in its approach.

**61.** In the opinion of this Court, the mistake of the patent agent would be similar to the mistake of an advocate who may be representing parties in any civil or criminal litigation. Insofar as any mistake committed by counsels/advocates are concerned, the settled legal position is that the litigants ought not to suffer, as has been laid down by the Supreme Court in a number of decisions including *Smt. Lachi Tewari v. Director of Land Records*, 1984 Supp SCC 431; *Rafiq v. Munshilal*, (1981) 2 SCC 788; *Mangi Lal v. State of M.P.*, (1994) 4 SCC 564 and *The Secretary, Department of Horticulture, Chandigarh v. Raghu Raj*, (2008) 13 SCC 395 : AIR 2009 SC 514.

**62.** In view of the fact that no fault can be attributed to the Applicant, this Court is of the opinion that the Applicant ought not to be made to suffer. However, there is a word of caution that this Court would like to add in this regard. The intention of the Legislature in Rule 138 of the Rules cannot be ignored by the Controller, nor can one ignore the express language of Section 21(1) of the Act, which mandates a deemed abandonment in case of non-compliance with the requirements imposed under the Act.



It is only in extraordinary cases, while exercising writ jurisdiction, that the Court may consider being flexible, and this would depend on the facts of each case as to whether a condonation ought to be given at all.

63. There is yet another recent development which the Court notices. The 161<sup>st</sup> report submitted by the Department Related Parliamentary Standing Committee on Commerce on 23<sup>rd</sup> July, 2021, titled '*Review of the Intellectual Property Rights Regime in India*' has taken note of the enormous prejudice being caused to patent applicants due to '*deemed abandonment*' provisions. The Committee has opined that the abandoning of patents would de-moralize or discourage patentees in India. The observations of the Committee is set out below:

*“vi. It was highlighted that the inflexibilities in Patent Act does not leave any room for errors thereby affecting the filing of patents. It was informed that in countries like US any delay in filing of patents could be condoned with an appropriate petition, fees, timely hearing and disposal. However, in India, once a due date has elapsed for filing request for examination report or a complete specification after a provisional one, there exist no remedy. Hence, as per Section 21(1) of the Patent Act, 1970, an application for a patent shall be deemed to have been abandoned unless the applicant has complied with all the requirements imposed on him by or under this Act within such period as may be prescribed. This inflexibility affects number of patents filed. **The Committee opines that the abandoning of patents, without allowing hearing or petition, may demoralize and discourage patentees in the country to file patents. It recommends the Department that certain flexibility should be incorporated in the Act to make for allowance of minor errors and lapses to prevent outright rejection of patents being filed. Hence, a revised petition with penalty or fee may be permitted under the Act for minor or bona fide mistakes that had been committed in the filed patents.**”*



8. In the given facts of the present case, as stated by the Petitioner, the non-payment of renewal fee within the time due to the fault of authorised agent is found convinced taking note of the averments made in the writ petition and secondly, it is admitted that the date of expiry of the Patent on 22<sup>nd</sup> September 2021 was within the Covid-19 Pandemic period. Further, the direction of the Hon'ble Supreme Court in S.M.W.P(C) No.3 of 2020 having been taken note to benefit of the petitioner, no difficulty is seen by this Court for considering the application of the Petitioner for restoration of the Patent by the Controller.

9. In the result, the writ petition is allowed and the Petitioner is permitted to make his application for restoration within a period of thirty days from today before the concerned authority and in such event the authority shall consider the same in accordance with law within a period of two months from the date of application.

**( B.P. Routray )**  
**Judge**