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

% *Date of Decision: 18th May, 2026*

\+ C.A.(COMM.IPD-PAT) 5/2025

NEUROCENTRIA INC .....Appellant

Through: Mr. J. Sai Deepak, Senior Advocate with Mr. Manish Aryan, Mr. Nishant Rai, Ms. Manisha Singh, Mr. Abhai Pandey, Mr. Avi Garg and Ms. Khushi Chauhan, Advocates.

versus

DEPUTY CONTROLLER OF PATENTS AND DESIGNS .....Respondent

Through: Ms. Nidhi Raman, CGSC with Mr. Om Ram, Mr. Zubin Singh, Ms. Nikita Singh and Mr. Arnav Mittal, Advocates.

CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH

JUDGEMENT

JYOTI SINGH, J.

1. This appeal is filed on behalf of the Appellant under Section 117A of the Patents Act, 1970 ('1970 Act') laying a challenge to order dated 29.10.2024, whereby the Respondent has treated Indian Patent Application No. 1015/DELNP/2010 dated 15.02.2010 as withdrawn owing to failure to file the application within 31 months from the first/earliest priority date and failure to file Request for Examination (RFE) within 48 months from the first/earliest priority date. Direction is sought to the Respondent to allow Form-13 filed by the Appellant on 28.06.2024 for amending the priority

date.

2. To the extent necessary, the factual matrix is that Appellant filed the subject application as a National Phase Application of PCT International Application No. PCT/US2008/058073 filed on 24.03.2008, claiming priority from US 60/896,458 dated 22.03.2007, US 60/994,902 dated 20.09.2007 and US 61/066,592 dated 20.02.2008. Subsequent to filing of the PCT application, Appellant filed corresponding National Phase Applications in various other countries like USA, Great Britain, Japan, EPO, New Zealand as also in India bearing no. 1015/DELNP/2010 on 15.02.2010. RFE was filed in Form-18 on 16.09.2011 and on 18.03.2017, Appellant requested for change of name of the Appellant and its place of business in Form-13.

3. It is stated in the appeal that First Examination Report (FER) was received by the Appellant on 14.03.2018 raising objections that Appellant: (a) failed to file Form-18 within 48 months from the date of priority as required under Rule 24(B) of the Patent Rules, 2003 ('2003 Rules'); (b) did not disclose the earliest priority date of 22.03.2007 in Form-1; and (c) under Section 11(B) of the 1970 Act, there was a prohibition in examining the application and the same shall be deemed to be withdrawn. Appellant filed its response to the FER on 14.09.2018 through its First Patent Agent and submitted that RFE was filed calculating the timelines from the second priority as the first priority was disregarded while entering the national phase in India and that taken from the second priority, Form-18 was within 48 months. It was also stated that in case of any discrepancy, personal hearing under Section 14 be granted. It is stated that first hearing notice was issued on 17.07.2019 scheduling the hearing on 02.08.2019, however, first patent agent did not receive the notice and owing to non-appearance, Patent

Office refused the application on 05.08.2019. Representations were sent flagging non-receipt of the hearing notice and extended hearing notice was issued on 09.05.2024, scheduling the hearing for 14.06.2024.

4. It is stated that Appellant changed the patent agent and engaged the present patent agent as the erstwhile agent was not diligent in prosecuting the matter. Second agent attending the hearing on 14.06.2024 and filed written submissions along with Form-13 on 28.06.2024 for voluntary amendment of the date of priority claimed in the subject application. However, vide impugned order, Respondent erroneously refused voluntary amendment and treated the application as withdrawn owing to failure to file the application within 31 months from first priority date as required under Rule 20(4)(i) of 2003 Rules and failure to file RFE within 48 months from the date of priority of the application or from the date of filing of the application, whichever is earlier under Rule 24(B)(1)(i).

5. Learned Senior Counsel for the Appellant contended that Respondent illegally and arbitrarily rejected the request for amendment of earliest priority date under Section 57(5) of 1970 Act and treated the application as deemed withdrawn. Appellant filed subject application through National Phase of its corresponding PCT Application, which had three priority claims, however, while entering, Appellant disclaimed the earliest priority US 60/896,458 dated 22.03.2007 and relied upon second priority of US 60/994,902 dated 20.09.2007, which extended the date of RFE from 22.03.2011 to 22.09.2011 and filed Form-18 requesting for examination on 16.09.2011. Respondent, however, held that Appellant changed the priority claim only to overcome the prescribed timelines provided in Section 11B(1) of 1970 Act and Rule 24B of 2003 Rules, under which application can be

examined only if RFE is filed within 48 months from the earliest date of priority, failing which the application is deemed withdrawn, completely overlooking that Section 57(5) of the 1970 Act permits amendment to disclaim priority claim and amendment cannot be refused only because it results in extending the prescribed period under the 1970 Act.

6. It was urged that reliance by the Respondent on paragraph 27 of the judgement in ***Nippon Steel Corporation v. Union of India, 2011 SCC OnLine Del 669,*** was misplaced as the facts of that case were completely different. Patent applicant in the said case had filed PCT national phase application within 31 months from the priority date mentioned in the PCT application, however, due to technical error in agent's docketing system, the deadline to file RFE within 48 months from earliest priority date was missed. When request was made for voluntary amendment, patent application was already deemed withdrawn and hence, Controller did not entertain Form-13. In contrast, in the present case, Appellant had disclaimed the earliest US priority date at the initial filing stage itself and mentioned only two dates in Form-1 and entered national phase within 31 months from the original second priority as also filed RFE within 48 months from the said date. Moreover, when voluntary amendment was sought in 2024, the application was not deemed withdrawn.

7. It was further argued that Respondent erred in observing that Form-1 filed on 21.08.2011 did not mention any priority details of earliest/first priority US 60/896,458 dated 22.03.2007 and only disclosed two priorities i.e., US 60/994,902 dated 20.09.2007 and US 61/066,592 dated 20.02.2008 and therefore, the amendment sought by Form-13 filed on 28.06.2024 was not an amendment in the said Form on actual basis and was not allowable, in

the teeth of the fact that the request made in Form-13 was not for amendment of Form-1 but for disclaiming the earliest priority claim as: *"We are hereby submitting a request as per section 57(5) for voluntarily amending the date of priority claimed in the present application by way of disclaimer, correction and explanation. We request to allow disclaiming the earliest PCT priority (US 60/896,458 dated 22.03.2007) and consider the earliest priority claimed (i.e., US 60/994,902 dated 20.09.2007) in the present application."*. Respondent ought to have allowed the amendment, in which case the subject application would have fallen within the prescribed timelines of 31 months and 48 months respectively, from the second priority date and obviated refusal of grant of patent of an important invention.

8. It was argued that Appellant should not suffer for the fault and negligence of his patent agent, which is now a settled law. Rule 20(1) of 2003 Rules provides that an application corresponding to an international application under PCT should be made in Form-1. In the instant case, while filing Form-1, earliest priority claim was already removed, however, the first patent agent was negligent and failed to file a request for amending/removing the claim in Form-13 at the time of filing itself. This irregularity was corrected subsequently when the second agent filed Form-13 and a petition under Rule 137 for condoning the irregularity, but the request was arbitrarily rejected by the Respondent. Appellant has always been serious and diligent in prosecuting its patent applications. Appellant is based in State of California, USA and has no option but to rely on Indian Patent Agents for timely filing of applications, replies, objections and/or addressing any irregularities in procedures. As soon as Appellant learnt of the objection raised in the extended hearing notice and negligence of the

first agent came to light, it changed the agent and took remedial measures and cannot be faulted.

9. It was strenuously argued that Appellant had given timely instructions for disclaiming the first date and ought not be made to suffer irrevocable loss of substantial patent right over its invention. Patent is an important right and impugned order has deprived the Appellant of its right to enjoy the fruits of the skill, hard work and labour invested over years. Keeping this in backdrop, this Court in ***European Union Represented by the European Commission v. Union of India and Others, 2022 SCC OnLine Del 1793,*** observed that where no fault can be attributed to the applicant and negligence is found on the part of the patent agent, applicant ought not to suffer, as the consequences of patent being abandoned are extreme. In ***Bry-Air Prokon Sagl and Others v. Union of India and Another, 2022 SCC OnLine Del 5197,*** Court extended the deadline to file response to FER, which was not filed within the prescribed timelines due to an error and negligence of the patent agent. ***Bry-Air (Asia) Pvt. Ltd. v. Union of India, Through its Secretary, Department for Promotion of Industry and Internal Trade, Ministry of Commerce and Industry and Another, 2024 SCC OnLine Del 6956,*** was a case wherein on examining the facts and record of the case, Court found that Petitioner had done its part by duly following up with its erstwhile patent agent and had no intention of abandoning the application and held that since abandonment is a question of intent and should not be presumed *per se*, Petitioner ought not to suffer the consequences of negligence of its erstwhile patent agent. Writ petition was allowed and the status of the application as 'deemed to be withdrawn under Section 11B(4)' was quashed with a direction to the Controller to restore the

application and afford an opportunity to the Petitioner to file Form-18 and proceed with the examination of the patent application. In ***Synertec Pty Ltd v. Union of India & Anr., W.P.(C)-IPD 53/2025*** decided on ***03.11.2025,*** RFE was not filed on time owing to inadvertent error of mentioning the exact date by the agent, as found by the Court. Observing that the Petitioner had no intent of abandoning or withdrawing its application and was not negligent as it took all steps within its control to diligently pursue the prosecution of the application, writ petition was allowed and Petitioner was allowed to submit Form-18.

10. It was argued that these judgements apply to the present case on all four corners. Appellant through its patent agent had been in continuous communication with the Patent Office ever since the date of filing of the application on 15.02.2010. Appellant was diligently communicating with the first patent agent well before the expiry of the 31-month period from the first priority date on 22.10.2009 and record will further bear testament to the fact that there was no intent to abandon the application. On 12.09.2009, Appellant instructed the first patent agent to file the Indian national phase application, however, the agent missed the deadline of 22.10.2009 and advised the Appellant to file the application disclaiming earliest/first priority and instead adhere to timelines as per the second priority date. Despite the advise being detrimental to Appellant's interest in protecting novelty of its invention through the earliest priority date, in order to protect its interest in securing a patent in India over the drug, Appellant followed the advise and gave instructions to proceed with the filing and the application was filed on 15.02.2010, which was well within 31 months counted from the second date. Critically, when the application was filed it was specifically mentioned in

Form-1 that document PCT form/IB/304 was also filed and this point is significant, since the said document issued by the international bureau specifically mentions all three priority dates and defies the allegation that Appellant supressed the earliest priority date while filing Form-1.

11. It was contended that Indian patent practice allows disclaimer of the earliest priority date to extend the 31 months period for filing national phase application as evident from past cases. Indian Patent Application no. 201647044797 was filed in India disclaiming the PCT priority application after 31 months from the said priority date. The application proceeded towards grant despite disclaiming the PCT priority to extend the 31 months timeline. Notably, the application had the PCT filing date recorded as the priority on IPO portal and not the priority disclaimed. In the instant case, the application shows priority dated 20.09.2007 on record instead of disclaimed priority 22.03.2007. In the past, IPAB has allowed applicant to seek extension by one month to file national phase application to meet the delay caused due to docketing/technical failure of docketing system in ***Tryton Medical Inc., A Delaware Corporation, having head quarters at 1000 Park Forty Plaza, Suite 325, Durham, NC 27713 United States v. The Controller General of Patents and Trade Marks Boudhik Sampada Bhawan, S.M. Road, Near Antop Hill Post Office, Antop Hill, Mumbai - 400 037 and Another, 2015 SCC OnLine IPAB 77***. In ***Nokia Corporation v. Deputy Controller of Patents and Designs, W.P. No. 2057/2010,*** decided on 24.01.2011, the Madras High Court held that Courts and statutory authorities are to do substantial justice. Object of Rule 138 is that prescribed time under Rule 20 can be extended by one month on showing sufficient cause, at the discretion of the Controller and thus it was not correct to reject

the application by treating it to be not maintainable. Even in ***Nippon Steel (supra),*** this Court has held that a party which has been in continuous correspondence with the Patent Office cannot be deemed to have abandoned its patent application.

12. It was urged that Respondent erred in holding that Appellant filed Form-13 for amendment of priority date belatedly i.e., after 14 years of filing the application. Firstly, there is no limitation for filing a request for amendment of the priority date. Secondly, having dropped its reliance on earliest priority date at the time of filing Form-1, there was no occasion or need to move the amendment application at that stage. The issue of amendment came up for the first time when Patent Office issued the FER on 14.03.2018, wherein it raised an objection that RFE ought to have been filed within 48 months from the earliest priority date. It is in response to this that first patent agent informed the Patent Office that first priority date had been disclaimed at the time of filing of Form-1 on 15.02.2010 and later filed for amendment. Appellant would have explained these facts to the Respondent, however, unfortunately owing to negligence of the agent, there was no representation on behalf of the Appellant during the hearing on 02.08.2019 and the application was refused. Detailed submissions were made by the second agent at the time of extended hearing, both orally and in writing, seeking condonation of delay, assuming there was any and petition was also filed under Rule 137 but without looking into the law and genuine reasons cited by the Appellant, the impugned order was passed. The very fact that Appellant sought extended hearing and revival of the application is evidence enough to demonstrate its intent to prosecute the application vigorously and not abandon it.

13. Arguing on behalf of the Respondent, Ms. Nidhi Raman, learned CGSC submitted that the impugned order has been rightly passed treating the patent application as withdrawn and to buttress this plea, she relies on the relevant statutory provisions being Rules 20(4)(i), 22 and 24(B)(1)(i) of 2003 Rules as also Section 11(B) of 1970 Act. It is urged that Appellant filed national phase application on 15.02.2010, approximately after four months from the prescribed timeline of 31 months from first/earliest priority date. Rule 20(4)(i) of 2003 Rules mandates filing of the application within 31 months from priority date as referred to in Article 2(xi) of PCT, which defines 'priority date' for computing time limits to *inter alia* mean: " …..(b) w*here the international application contains several priority claims under Article 8, the filing date of the earliest application whose priority is so claimed*…" . Rule 22 provides consequences of failure to comply with the mandate of the timeline of 31 months and stipulates that: *"An international application in India shall be deemed to be withdrawn if the applicant does not comply with the requirement of rule 20".* It is settled that the prescribed timeline for entry into the national phase is non-extendable. Rule 138 was neither invoked by the Appellant nor is applicable in the instant case, as the delay was more than one month, beyond which the Controller has no discretion to extend the timeline. Similarly, Section 11B(1) read with Rule 24(B)(1)(i) mandates that RFE should be filed within 48 months from first/earliest priority, which in the instant case is 22.03.2007. The request was, however, filed on 16.09.2011 *albeit* it should have been filed on or before 22.03.2011 and consequence of this failure as provided in Section 11B(4), is that the application shall be treated as withdrawn. This provision is mandatory and leaves no scope for discretion with the Controller even for

one day and for no reason, including negligence of the patent agent.

14. It was argued that there was glaring suppression on the part of the Appellant in disclosing the earliest priority. Form-1 requires disclosure of the priority details and as evident in the instant case, while filing the national phase application, Appellant's first patent agent deliberately omitted to specify the first/earliest priority i.e., US 60/896,458 dated 22.03.2007 to mislead the Patent Office into accepting the application, which was otherwise time-barred, having been filed beyond 31 months from this date. The Form was not accompanied by any document indicating the intent of Appellant to disclaim/disregard the first/earliest priority and for the first time Form-13 was filed on 28.06.2024 for voluntary amendment i.e., after 14 years and this is a conceded position in the appeal, paragraph 12.8 whereof reads: *"However, the first agent did not file a request for amending/removing the priority claim on Form-13 at the time of filing the subject application out of negligence"* and the request was rightly disallowed.

15. It was further argued that the entire case of the Appellant is predicated on its request for amendment filed in Form-13 to disclaim/disregard the first/earliest priority, which it perceives is a matter of right. This stand is wholly flawed in law. Rule 22 of 2003 Rules provides consequences of non-compliance with requirements of Rule 20 of 2003 Rules and is couched in a language which shows that it is mandatory and not directory in nature, which means that once an application is non-compliant with the timelines under Rule 20(4)(i), Rule 22 is attracted and the application is deemed to be withdrawn. In this case, Appellant filed a formal request by submitting Form-13 on 28.06.2024 and the amendment was rightly declined and

application was treated as withdrawn. It was strenuously argued that disclaiming/amending earliest/first priority date to extend the deadline for entering national phase and/or filing RFE is not permissible and much less at the discretion of the Respondent and in support reliance was placed on the judgement of this Court in ***Nippon Steel (supra).*** It is clear that Appellant's move to disclaim/disregard the first priority date is only to circumvent the missed deadlines for both: (a) filing national phase application; and (b) filing the RFE, which if permitted, will contravene statutory provisions and judicial precedents. The judgments cited by the Appellant are distinguishable on facts. In judgment of the Madras High Court in ***Nokia Corporation (supra),*** the extension was up to one month under Rule 138, whereas in the present case, the delay is four months for national entry and six months for RFE and no request was or could have been made under Rule 138. Decision in ***European Union (supra)*** supports the Respondent inasmuch as Court held that timelines for national phase entry and RFE are non-extendable.

16. Arguing in rejoinder, learned Senior Counsel for the Appellant reiterated that the Appellant had no intent to abandon the patent application, which is evident from the correspondence exchanged with the first patent agent and it is judicially recognised that if the patent agent is negligent and no fault can be attributed to the applicant, Court should be liberal in condoning the default since the right of a patentee to seek grant of patent for his years of hard work and skill is an important right. In fact, statutorily also right to amend priority date is recognised in the form of Section 57(5) of the 1970 Act. It was asserted that there is no timeline prescribed for filing an amendment application and thus there is no impediment in allowing the

same, even considering that it was filed belatedly in 2024 *albeit* there is no delay since the Patent Office itself raised this issue only in the FER dated 14.03.2018. The allegation of suppression and misrepresentation due to non-disclosure of first/earliest priority date was vehemently denied and it was submitted that the subject application is based on PCT application and all details of PCT are publicly available. The date was not mentioned in Form-1 only because the first date was disclaimed. It is wrong for the Respondent to take a position that Appellant waited for 14 years to seek amendment. After the objection was raised in the FER, a hearing was scheduled on 30.03.2015 and Appellant informed the Patent Office in 2015 first and then in 2018 when response was filed to the FER on 14.09.2018. Most importantly, no third-party rights will be impacted if the amendment is allowed and if it all, the disadvantage will inure to the Appellant as some of its claims may be excluded, if disclaimer of priority is allowed. On the other hand, if Form-13 is not accepted and application is not revived, it will cause grave and irreparable loss to patentee's substantial rights.

17. Heard learned Senior Counsel for the Appellant and learned CGSC for the Respondent and examined their submissions.

18. An interesting question has been raised by the Appellant in the present case but, in my view, the answer is not far to find. Before proceeding further, it would be useful and relevant to capture a few dates and events as also the applicable provisions. Appellant filed PCT International Application on 24.03.2008 claiming priority from US 60/896,458 dated 22.03.2007, US 60/994,902 dated 20.09.2007 and US 61/066,592 dated 20.02.2008. National phase application was indisputably filed in India on 15.02.2010 and the deadline of 31 months for filing of this application is one of the bone of

contentions between the parties. While Appellant contends that at the time of filing the application, the earliest priority date of US 60/896,458 dated 22.03.2007 was intended to be disclaimed and which is why only second and third priority dates were mentioned in Form-1, Respondent takes a position that at the time of filing the application the earliest/first priority date was deliberately concealed and suppressed and no document was filed voluntarily disclaiming the said priority date *albeit* there is no dispute that owing to priority claimed in the international PCT application from the US patents, the prescribed timeline to enter the national phase in India was 31 months from the first/earliest priority date i.e., 22.03.2007. Appellant banks on the second priority date of US 60/994,902 dated 20.09.2007 to count the 31 months for entering national phase as also 48 months for REF by claiming disclaimer of earliest date through Form-13 filed under Section 57(5) of 1970 Act for amendment of the priority date. Respondent counts both the timelines from first/earliest priority date i.e., 22.03.2007 and submits that these timelines are non-extendable and owing to non-compliance with applicable timelines of 31 and 48 months respectively, the application has been deemed withdrawn and there can be no revival of an application which is no longer valid.

19. Coming back to the chronology of events, Appellant received the FER on 14.03.2018 and filed its response on 14.09.2018. First hearing notice was issued on 17.07.2019 scheduling a hearing on 02.08.2019. Due to non-representation of the Appellant on the scheduled date, Respondent refused the application on 05.08.2019 but on a request from the Appellant, extended hearing notice was issued on 09.05.2024, scheduling the hearing for 14.06.2024, which was attended by second patent agent engaged by the

Appellant after discharging the first patent agent, who according to the Appellant had been negligent in prosecuting the matter and had rendered incorrect advise at the time of filing the Indian phase application. Written submissions were filed by the Appellant on 28.06.2024 along with Form-13 for voluntary amendment of first priority date so as to extend the deadlines of 31 and 48 months, respectively. By impugned order dated 29.10.2024, Respondent treated the patent application as withdrawn owing to failure to file the national phase application within 31 months from first/earliest priority date as required under Rule 20(4)(i) of the 2003 Rules as also for failure to file RFE within 48 months from the first/earliest priority date as required under Section 11B read with Rule 24(B)(1)(i). Both sides have addressed extensive arguments and to appreciate them, it is incumbent to look at the scheme of the applicable provisions.

20. Rule 20(1) of the 2003 Rules provides that an application corresponding to an international application filed under PCT may be made in Form-1 and Rule 20(2) proscribes processing of this application before expiry of time limit prescribed in Rule 20(4)(i), which provides that time limit referred to in sub-Rule (2) shall be 31 months from the priority date as referred to in Article 2(xi) of PCT. Rule 22 provides consequences of non-compliance and stipulates that an international application designating India shall be deemed to be withdrawn if the applicant does not comply with the requirements of Rule 20. Section 11B concerns RFE and sub-Section (1) provides that no application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period and the period for making RFE under Section 11B is provided under Rule 24B, which is 48

months from the date of priority of the application or from the date of filing of the application, whichever is earlier. Relevant provisions are extracted hereunder for the ease of reference:-

> *"**Rule 20.** International applications designating or designating and electing India. —*
>
> *(1) An application corresponding to an international application filed under Patent Cooperation Treaty may be made in Form 1 under sub-section (1A) of section 7.*
>
> *Explanation.—For the purpose of this rule, "an application corresponding to an international application means" an international application as filed under Patent Cooperation Treaty which includes any amendments made by the applicant under Article 19 and communicated to Designated Office under Article 20 or any amendment made under sub-clause (b) of clause (2) of Article 34 of the Treaty:*
>
> *Provided that the applicant, while filing such application corresponding to an international application designating India, may delete a claim, in accordance with the provisions contained in Rule 14.*
>
> *(2) The Patent Office shall not commence processing of an application filed corresponding to international application designating India before the expiration of the time limit prescribed under sub-rule (4)(i).*
>
> *(3) An applicant in respect of an international application designating India shall, before the time limit prescribed in subrule (4)(i),—*
>
> > *(a) pay the prescribed national fee and other fees to the patent office in the manner prescribed under these rules and under the regulations made under the Treaty;*
> >
> > *(b) and where the international application was either not filed or has not been published in English, file with the patent office, a translation of the application in English, duly verified by the applicant or the person duly authorized by him that the contents thereof are correct and complete.*
>
> *(4)(i) The time limit referred to in sub-rule (2) shall be thirty-one months from the priority date as referred to in Article 2(xi);*
>
> *(4)(ii) Notwithstanding anything contained in clause (i), the Patent Office may, on the express request filed in Form 18 along with the fee specified in First Schedule, process or examine the application at any time before thirty-one months…*
>
> ***Rule 22.** — Effect of non-compliance with certain requirements. – An international application designating India shall be deemed to be*

withdrawn if the applicant does not comply with the requirements of Rule 20.

"Section 11B—

Request for examination:

(1) No application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.

(2) (Omitted)

(3) In case of an application in respect of a claim for a patent filed under sub-section (2) of section 5 before the 1st day of January, 2005 a request for its examination shall be made in the prescribed manner and within the prescribed period by the applicant or any other interested person.

(4) In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under sub-section (1) or sub-section (3), the application shall be treated as withdrawn by the applicant:

Provided that—

(i) the applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner; and

(ii) in a case where secrecy direction has been issued under section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction."

***"Rule 24B.** Examination of application. —*

(1) (i) A request for examination under section 11B shall be made in Form 18 within forty-eight months from the date of priority of the application or from the date of filing of the application, whichever is earlier."

"Article 2(xi) of the PCT –

(xi) "priority date," for the purposes of computing time limits, means: (a) where the international application contains a priority claim under Article 8, the filing date of the application whose priority is so claimed;

(b) where the international application contains several priority claims under Article 8, the filing date of the earliest application whose priority is so claimed;

(c) where the international application does not contain any priority claim under Article 8, the international filing date of such application."

21. The subject patent application relates to "MAGNESIUM

COMPOSITIONS AND USES THEREOF". The moot question that arises for consideration is whether Appellant can be permitted to disclaim and/or amend the earliest priority date to claim priority from the original second date of US 60/994,902 dated 20.09.2007, which will result in extending the deadlines for entering national phase and filing RFE. Parties are *ad idem* that international PCT application bearing no. PCT/US2008/058073 was filed on 24.03.2008 claiming three priorities: US 60/896,458 dated 22.03.2007 (earliest/first), US 60/994,902 dated 20.09.2007 (second) and US 61/066,592 dated 20.02.2008 (third). As per Rule 20(4)(i) national phase application was to be filed within 31 months from the earliest priority date 22.03.2007 i.e., on or before 22.10.2009. However, Appellant filed the national phase application on 15.02.2010 and consequently, exceeded the time limit by nearly four months. Respondent alleges that Appellant deliberately suppressed the first/earliest priority date in Form-1 at the time of filing the national phase application in India on 15.02.2010 with an intent to mislead the Patent Office into accepting the application which was otherwise time barred and the mischief is reinforced by the fact that no document was filed with Form-1 to disclose that Appellant had disclaimed the earliest/first priority date.

22. On a fact check, Respondent is right in urging that Appellant did not disclose the earliest priority date of 22.03.2007 in Form-1 and mentioned only the second and third priority dates i.e., US 60/994,902 dated 20.09.2007 and US 61/066,592 dated 20.02.2008. It is equally established that at that stage, first patent agent did not inform the Patent Office of Appellant's intent to disclaim/disregard the first date. Respondent's counsel claims this to be a deliberate concealment while Appellant has attempted to

explain that the erstwhile applicant/Magceutics, Inc. through its attorneys based in California, USA instructed the first patent agent on 12.09.2009 to file a national phase application in India and on a follow up, it was informed that the agent had not received any instructions to do so and accordingly, advised that since 31 months deadline had lapsed, the only option was to enter the national phase by claiming the second and third priorities of US 60/994,902 dated 20.09.2007 and US 61/066,592 dated 20.02.2008. Accepting this advise, erstwhile patent applicant instructed the agent to file the application with these two priorities. For reference Form-1 is filed as follows:

5. PRIORITY PARTICULARS OF THE APPLICATION(S) FILED IN CONVENTION COUNTRY

Country	Application Number	Filing Date	Name of the Applicant	Title of the Invention
US	60/994,902	20.09.2007	LIU, Guosong; MEISTER, MAO, Fei	MAGNESIUM COMPOSITIONS AND USES THEREOF
US	61/066,592	20.02.2008		

23. Appellant also endorsed in Form-1 that the declaration in the form was to the best of its knowledge, information and belief and the facts and matters stated therein were correct. The application was entertained taking 31 months from second priority date i.e., 20.09.2007 and basis this RFE filed on 16.09.2011 was also accepted being within 48 months. Ms. Raman rightly urged that had the Appellant disclosed the first/earliest priority date at the outset, the application would not have been entertained, being time barred. Whether the omission to disclose the earliest date to overcome the missed deadlines was deliberate or not can be discerned only from surrounding circumstances. Unquestionably, Appellant knew that it was

required to disclose the earliest priority date but chose not to do so as it was strategically advantageous to take the second date which extended the timelines to enter the national phase and file RFE. Question is who benefited from the omission and the answer to this is a strong indicator that non-disclosure of the earliest date was to overcome the timelines and perhaps a well thought of initiative. In fact, there was no disclosure till the objection was raised in the FER in 2018 and it was only in 2024 that Form-13 was filed to seek amendment of the date along with a petition under Rule 137 to condone the irregularity.

24. Arguendo, even if the earliest date was not mentioned on the advise of the first patent agent and Appellant acted under a *bona fide* belief that it could disclaim the first date and claim priority from the second, this cannot aid the Appellant for more than one reason. It is trite that timelines for filing national phase applications as also RFEs are mandatory and non-extendable. Rule 20(4)(i) of 2003 Rules provides 31 months for filing an application corresponding to an international application filed under PCT from the priority date referred to in Article 2(xi) of PCT, which defines 'priority date' and stipulates that priority date for computing time limits means *inter alia* filing date of the earliest application whose priority is so claimed, where the international application contains several priority claims under Article 8. Rule 22 provides consequences of non-compliance with the deadlines and in no uncertain terms provides that if the timeline is not met, the application will be 'deemed to be withdrawn' by a deeming fiction of law. The *vires* of Rule 22 was challenged before a Division Bench of this Court in ***Diebold Self Service Systems v. Union of India and Others, 2022 SCC OnLine Del 4555.*** In the said case, Petitioner filed the Indian phase application after a

delay of 5 months 04 days from the first priority date *albeit* along with petition under Rule 137 of 2003 Rules and an affidavit explaining the delay. When the application was refused, Petitioner approached the Court for declaring Rule 22 as *ultra vires* to the provisions of the 1970 Act as also to quash the impugned communications and take the national phase application on record. The Division Bench dismissed the petition holding that Rule 22 was not only in consonance with the object and reasoning of 1970 Act but also with PCT Rules and Regulations. Significantly, it was held that perusal of Section 7(1A) of 1970 Act reveals that for grant of patent in India, applicant has to mandatorily file a corresponding application before the IPO for all international applications under the PCT designating India within the prescribed period of 31 months in compliance of Section 21 of the 1970 Act or else the same shall be deemed to be abandoned. It was also noted that although 31 months were provided under Rule 20(4)(i) but Section 21 provided extension for one month to file the application. For the purposes of this case, it is important to note that the Division Bench held that the word 'shall' in Rule 22 is mandatory and not directory and an applicant like the Petitioner was bound by the statute and the laws of land. Having failed to file the requisite application within time, Petitioner is seeking to make a belated challenge and flog a dead horse. Under the garb of the writ petition, Petitioner was trying to claim pardon for not adhering to stipulated timelines which could not have been the intention of the legislature. It was also observed that filing of an application for a patent within the stipulated time frame is of utmost importance and contention of the Petitioner that some leeway be granted in the form of a remedy beyond the statutory period of 31 months holds no merit on two counts. Firstly, only one extra month has been

granted for filing national phase application in India and secondly, the benefit cannot be extended at the initial stage i.e., at the time of filing. Relevant paragraphs are as follows:-

> *"19. Before proceeding any further, for the purposes of better elucidation of the facts involved in present petition, it is imperative to reproduce few of the relevant provisions of the Act(s) and Rule(s) involved in the present petition, which are as under:—*
>
> ***Patent Cooperation Treaty, Washington, June 19, 1970:***
>
> ***"Article 20 : Communication to Designated Offices***
>
> *(1)(a) The international application, together with the international search report (including any indication referred to in Article 17(2)(b)) or the declaration referred to in Article 17(2)(a), shall be communicated to each designated Office, as provided in the Regulations, unless the designated Office waives such requirement in its entirety or in part. (b) The communication shall include the translation (as prescribed) of the said report or declaration. (2) If the claims have been amended by virtue of Article 19(1), the communication shall either contain the full text of the claims both as filed and as amended or shall contain the full text of the claims as filed and specify the amendments, and shall include the statement, if any, referred to in Article 19(1)."*
>
> ***"Article 21 : International Publication***
>
> *(1) The International Bureau shall publish international applications.*
>
> *(2)(a) Subject to the exceptions provided for in subparagraph (b) and in Article 64(3), the international publication of the international application shall be effected promptly after the expiration of 18 months from priority date of that application. (b) The applicant may ask the International Bureau to publish his international application any time before the expiration of the time limit referred to in subparagraph (a). The International Bureau shall proceed accordingly, as provided in the Regulations. (3) The international search report or the declaration referred to in Article 17(2)(a) shall be published as prescribed in the Regulations. (4) The language and form of the international publication and other details are governed by the Regulations. (5) There shall be no international publication if the international application is withdrawn or is considered withdrawn before the technical preparations for publication have been completed. (6) If the international application contains expressions or drawings which,*

in the opinion of the International Bureau, are contrary to morality or public order, or if, in its opinion, the international application contains disparaging statements as defined in the Regulations, it may omit such expressions, drawings, and statements, from its publications, indicating the place and number of words or drawings omitted, and furnishing, upon request, individual copies of passages omitted"

"Article 22 : Copy, Translation, and Fee, to Designated Offices

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 301 months from priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for the State not later than at the expiration of 301 months from priority date. (2) Where the International Searching Authority makes a declaration, under Article 17(2)(a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be the same as that provided for in paragraph (1). (3) Any national law may, for performing the acts referred to in paragraphs (1) or (2), fix time limits which expire later than the time limit provided for in those paragraphs."

Patent Cooperation Treaty Regulations

"Rule 48 International Publication

48.2 Contents (a) The publication of the international application shall contain : (i) a standardized front page; (ii) the description; (iii) the claims; (iv) the drawings, if any; (v) subject to paragraph (g), the international search report or the declaration under Article 17(2)(a);

(vi) any statement filed under Article 19(1), unless the International Bureau finds that the statement does not comply with provisions of Rule 46.4; (vii) where the request for publication under Rule 91.3(d) was received by the International Bureau before the completion of the technical preparations for international publication, any request for rectification of an obvious mistake, any reasons and any comments referred to in Rule 91.3(d); (viii) the indications in relation to deposited biological material furnished

under Rule 13bis separately from the description, together with an indication of the date on which the International Bureau received such indications; (ix) any information concerning a priority claim referred to in Rule 26bis.2(d);

(x) any declaration referred to in Rule 4.17, and any correction thereof under Rule 26ter.1, which was received by the International Bureau before the expiration of the time limit under Rule 26ter.1; (xi) any information concerning a request under Rule 26bis.3 for restoration of the right of priority and the decision of the receiving Office upon such request, including information as to the criterion for restoration upon which the decision was based."

"Rule 49 Copy, Translation and Fee under Article 22

49.6 Reinstatement of Rights after Failure to Perform the Acts Referred to in Article 2210 (a) Where the effect of the international application provided for in Article 11(3) has ceased because the applicant failed to perform the acts referred to in Article 22 within the applicable time limit, the designated Office shall, upon request of the applicant, and subject to paragraphs (b) to (e) of this Rule, reinstate the rights of the applicant with respect to that international application if it finds that any delay in meeting that time limit was unintentional or, at the option of the designated Office, that the failure to meet that time limit occurred in spite of due care required by the circumstances having been taken. (b) The request under paragraph (a) shall be submitted to the designated Office, and the acts referred to in Article 22 shall be performed, within whichever of the following periods expires first : (i) two months from the date of removal of the cause of the failure to meet the applicable time limit under Article 22; or (ii) 12 months from the date of the expiration of the applicable time limit under Article 22; provided that the applicant may submit the request at any later time if so permitted by the national law applicable by the designated Office. (c) The request under paragraph (a) shall state the reasons for the failure to comply with the applicable time limit under Article 22. (d) The national law applicable by the designated Office may require : (i) that a fee be paid in respect of a request under paragraph (a); (ii) that a declaration or other evidence in support of the reasons referred to in paragraph (c) be filed. (e) The designated Office shall not refuse a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. (f) If, on October 1, 2002, paragraphs (a) to (e) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply

in respect of that designated Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by January 1, 2003. The information received shall be promptly published by the International Bureau in the Gazette."

The Patent Act, 1970

***"Section** 7. Form of application.—(1) Every application for a patent shall be for one invention only and shall be made in prescribed form and filed in The Patent office.*

(1A) Every international application under The Patent Cooperation Treaty for a patent, as may be filed designating India shall be deemed to be an application under this Act, if a corresponding application has also been filed before the Controller in India.

(1B) The filing date of an application referred to in sub-section (1A) and its complete specification processed by The Patent office as designated office or elected office shall be the international filing date accorded under The Patent Cooperation Treaty"

***"Section 21**. Time for putting application in order for grant.—(1) An application for a patent shall be deemed to have been abandoned unless, Within such period as may be prescribed, the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objections to the application or complete specification or other documents related thereto is forwarded to the applicant by the Controller. Explanation.—Where the application for a patent or any specification or, in the case of a convention application or an application filed under The Patent Cooperation Treaty designating India any document filed as part of the application has been returned to the applicant by the Controller in the course of proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has re-filed it or the applicant proves to the satisfaction of the Controller that for the reasons beyond his control such document could not be re-filed. (2) If at the expiration of the period as prescribed under sub section (1)— (a) an appeal to the High Court is pending in respect of the application for The Patent for the main invention; or (b) in the case of an application for a patent of addition, an appeal to the High Court is pending in respect of either that application or the application for the main invention, the time within which the requirements of the Controller shall be complied with shall, on an application made by the applicant before the expiration of the period as prescribed under sub-section (1), be*

extended until such date as the High Court may determine. (3) If the time within which the appeal mentioned in sub-section (2) may be instituted has not expired, the Controller may extend the period as prescribed under subsection (1), to such further period as he may determine : Provided that if an appeal has been filed during the said further period, and the High Court has granted any extension of time for complying with the requirements of the Controller, then the requirements may be complied with within the time granted by the Court."

***"Section 159**. Power of Central Government to make rules. — (1) The Central Government may, by notification in the Official Gazette, make rules for carrying out the purposes of this Act. (2) Without prejudice to the generality of the foregoing power, the Central Government may make rules to provide for all or any of the following matters, namely:— (i) the form and manner in which any application for a patent, any specifications or drawings and any other application or document may be filed in The Patent office; (ia) the period which the Controller may allow for filing of statement and undertaking for in respect of applications under sub-section (1), the period within which the details relating to processing of applications may be filed before the Controller and the details to be furnished by the applicant to the Controller under sub-section (2) of section 8; (ib) the period within which a reference to the deposit of materials shall be made in the specification under sub-clause (A) of clause (ii) of proviso to subsection (4) of section 10; (ic) the period for which application for patent shall not be open to the public under sub-section (1) and the manner in which the applicant may make a request to the Controller to publish his application under sub-section (2) of section 11 A; (id) the manner of making the request for examination for an application for patent and the period within which such examination shall be made under sub-sections (1) and (3) of section 11B; (ie) the manner in which an application for withdrawal of an application for grant of a patent shall be made and the period within which a request for examination from the date of revocation of secrecy directions shall be made under proviso to sub-section (4) of section 11B. (ii) the time within which any act or thing may be done under this Act, including the manner in which and the time within which any matter may be published under this Act; (iii) the fees which may be payable under this Act and the manner and time of payment of such fees; (iv) the matters in respect of which the examiner may make a report to the Controller; (v) the manner in which and the period within which the Controller shall consider and dispose off a representation under sub-section (1) of section 25; (va) the period within which the Controller is required to dispose of an application under section 39;(vi) the form*

and manner in which and the time within which any notice may be given under this Act; (vii) provisions which may be inserted in an order for restoration of a patent for protection of persons who may have availed themselves of the subject-matter of The Patent after The Patent had ceased; (viii) the establishment of branch offices of The Patent office and the regulation generally of the business of The Patent office, including its branch offices; (ix) the maintenance of the register of patents and the safeguards to be observed in the maintenance of such register in computer floppies, diskettes or any other electronic form and the matters to be entered therein; (x) the matters in respect of which the Controller shall have powers of a civil court; (xi) the time when and the manner in which the register and any other document open to inspection may be inspected under this Act; (xii) the qualifications of, and preparation of a roll of, scientific advisers for the purpose of section 115; (xiia) the salaries and allowances and other conditions of service of the officers and other employees of the Appellate Board under subsection (2) and the manner in which the officers and other employees of the Appellate Board shall discharge their functions under subsection (3) of section 117; (xiib) the form of making an appeal, the manner of verification and the fee payable under sub-section (3) of section 117A; (xiic) the form in which, and particulars to be included in the application to the Appellate Board under sub-section (1) of section 117D; (xiii) the manner in which any compensation for acquisition by Government of an invention may be paid; (xiv) the manner in which the register of patent agents may be maintained under subsection (1) of section 125 and the safeguards to be observed in the maintenance of such register of patent agents on computer floppies, diskettes or any other electronic form under subsection (2) of that section; the conduct of qualifying examinations for patent agents; and matters connected with their practice and conduct, including the taking of disciplinary proceedings against patent agents for misconduct; (xv) the regulation of the making, printing, publishing and selling of indexes to, and abridgements of, specifications and other documents in The Patent office; and the inspection of indexes and abridgements and other documents; (xvi) any other matter which has to be or may be prescribed. (3) The power to make rules under this section shall be subject to condition of the rules being made after previous publication : Provided that the Central Government may, if it is satisfied that the circumstances exist which render it practically not possible to comply with such condition of previous publication, dispense with such compliance."

***"Section 160**. Rules to be placed before Parliament.—Every rule made under this Act shall be laid, as soon as may be after it is made,*

before each House of Parliament while it is in session for a total period of thirty days which may be comprised in one session or in two or more successive sessions, and if, before the expiry of the session immediately following the session or the successive sessions aforesaid, both Houses agree in making any modification in the rule or both Houses agree that the rule should not be made, the rule shall thereafter have effect only in such modified form or be of no effect, as the case may be; so, however, that any such modification or annulment shall be without prejudice to the validity of anything previously done under that rule."

The Patent Rules, 2003

***"Rule 20**. International applications designating or designating and electing India. — (1) An application corresponding to an international application filed under Patent Cooperation Treaty may be made in Form 1 under sub-section (1A) of section 7. Explanation.- For the purpose of this rule, "an application corresponding to an international application" means" an international application as filed under Patent Cooperation Treaty which includes any amendments made by the applicant under Article 19 and communicated to Designated Office under Article 20 or any amendment made under sub-clause (b) of clause (2) of Article 34 of the Treaty : Provided that the applicant, while filing such application corresponding to an international application designating India, may delete a claim, in accordance with provisions contained in rule 14.". (2) The Patent Office shall not commence processing of an application filed corresponding to international application designating India before the expiration of the time limit prescribed under sub-rule (4)(i). (3) An applicant in respect of an international application designating India shall, before the time limit prescribed in sub-rule (4)(i),— (a) pay prescribed national fee and other fees to The Patent office in the manner prescribed under these rules and under the regulations made under the Treaty; (b) and where the international application was either not filed or has not been published in English, file with The Patent office, a translation of the application in English, duly verified by the applicant or the person duly authorised by him that the contents thereof are correct and complete. (4) (i) The time limit referred to in sub-rule (2) shall be thirty one months from priority date as referred to in Article 2(xi); (ii) Notwithstanding anything contained in clause (i), The Patent Office may, on the express request filed in Form 18 along with the fee specified in First Schedule, process or examine the application at any time before thirty one months. (5) The translation of the international application referred to in sub-rule (3) shall include a translation in English of,— (i) the description; (ii) the claims as filed; (iii) any text matter of the*

drawings; (iv) the abstract; and (v) in case the applicant has not elected India and if the claims have been amended under Article 19, then the amended claims together with any statement filed under the said Article; (vi) in case the applicant has elected India and any amendments to the description, the claims and text matter of the drawings that are annexed to the international preliminary examination report. (6) If the applicant fails to file a translation of the amended claims and annexures referred to in sub-rule (5), even after invitation from the appropriate office to do so, within a time limit as may be fixed by that office having regard to the time left for meeting the requirements, the amended claims and annexures shall be disregarded in the course of further processing the application by the appropriate office. (7) The applicant in respect of an international application designating India shall when complying with sub-rule (3), preferably use Forms set out in the Second Schedule before the appropriate office as designated office."

***"Rule 22**. Effect of non-compliance with certain requirements. — An international application designating India shall be deemed to be withdrawn if the applicant does not comply with the requirements of rule 20."*

***"Rule 137**. 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 detriment to the interests of any person, may be corrected if the Controller thinks fit and upon such terms as he may direct."*

***"Rule 138**. Power to extend time prescribed.— (1) Except for the time prescribed in clause (i) of sub-rule (4) of rule 20, sub-rule (6) of rule 20, rule 21, sub-rules (1), (5) and (6) of rule 24B, sub-rules (10) and (11) of rule 24C, sub-rule (4) of rule 55, sub-rule (1A) of rule 80 and sub-rules (1) and (2) of rule 130, the time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct. (2) Any request for extension of time prescribed by these rules for the doing of any act or the taking of any proceeding thereunder shall be made before the expiry of such time prescribed in these rules."*

20. A bare perusal of Article 22 of PCT Rules hereinabove reveals that it is incumbent upon an applicant to furnish a copy of the international application (unless the communication provided for in Article 20 of PCT Rules has already taken place) along with a translation thereof, if required, with payment of National fee, to each designated National Office not later than at the expiration of thirty months from priority date. Not

only that, the same Article 22 of PCT Rules also provides that where the National Law of the designated State requires the indication of the name and other prescribed data concerning the inventor and allows that these indications be furnished at a time later than that of the filing of a National Phase application, the applicant shall, unless the said details were contained in the request, furnish the said indications to the National Office of or acting for the State not later than at the expiration of thirty months from priority date. Thus, in essence, as expressly provided, the time for filing a National Phase application before the IPO in India is to be thirty months.

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22. Filing of an application for a patent (at different levels-initial application before country, another application before the WIPO and lastly a National Phase application before the Designation Office), within the stipulated time frame is of utmost importance. It is for this reason that the whole purpose of the patent regime worldwide is to recognize an applicant after according due chance of filing and letting the said applicant enjoy complete protection for the entire period but, at the same time it does not provide for enabling the said applicant to enjoy an overall monopoly for any 'extended' period beyond the expiry of the mandatory recognized life of a patent. It is in view of the aforesaid that there is no provision for extension of a stipulated life of a patent as it becomes the part of the public domain after its expiry.

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28. The same issue came for consideration before a learned Single Judge of this Court in the case of Nippon Steel (Supra) wherein it has been observed as under:

> *"25. There is a logic to the time limits set out under the Act. The scheme of the Act and the Rules require time-bound steps to be taken by applicants for grant of patent at various stages. provisions of the Act and the Rules have to expressly reflect the legislative intent to permit relaxation of time limits, absent which such relaxation cannot be 'read into' provisions by a High Court exercising powers under Article 226 of the Constitution. In other words, it is not possible for this Court to accept the submission of the learned Senior counsel for the Petitioner that the time-limits under Section 11-B(1) of the Act read with Rule 24-B of the Rules, notwithstanding Section 11-B(4) of the Act, are merely 'directory' and not mandatory."*

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30. The Hon'ble Supreme Court in the case of State of Haryana v. Raghubir Dayal while interpreting the word "shall" has observed as under:—

"5. The use of the word 'shall' is ordinarily mandatory but it is sometimes not so interpreted if the scope of the enactment, on consequences to flow from such construction would not so demand. Normally, the word 'shall' prima facie ought to be considered mandatory but it is the function of the court to ascertain the real intention of the legislature by a careful examination of the whole scope of the statute, the purpose it seeks to serve and the consequences that would flow from the construction to be placed thereon. The word 'shall', therefore, ought to be construed not according to the language with which it is clothed but in the context in which it is used and the purpose it seeks to serve. The meaning has to be ascribed to the word 'shall' as mandatory or as directory, accordingly. Equally, it is settled law that when a statute is passed for the purpose of enabling the doing of something and prescribes the formalities which are to be attended for the purpose, those prescribed formalities which are essential to the validity of such thing, would be mandatory. However, if by holding them to be mandatory, serious general inconvenience is caused to innocent persons or general public, without very much furthering the object of the Act, the same would be construed as directory.

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7. Therefore, the word 'shall' used in Section 4(1) should be construed to be mandatory because the requirement of Section 4(1) of the publication of the notification in the Gazette followed by their publication in the newspapers perhaps in some cases may not meet the needed purpose of notice to the owner or person claiming interest in the land proposed to be acquired. For instance, in rural areas most agriculturists may not read even the vernacular newspapers. Their fields are their world and work therein is their breadwinner. They would come to know only if the substance of the notification is published (announced) in the village by beat of drum. Therefore, publication of the substance of the notification of Section 4(1) and in the locality is mandatory but it is not the requirement of the law that it be done simultaneously with the publication in the Gazette or newspapers. Though there is a time gap of more than six months between the date of the notification under Section 4(1) in the State Gazette and the date of the publication of the substance of the notification in the locality, the delay by itself does not render the notification under Section 4(1) published in the State Gazette, invalid."

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33. Though the main shape and form of the patent law in India was taken from the patent law in England, however, with time, numerous changes have been brought. There are some inventions for which a patent can or cannot be granted in India and situation may not be the same in other countries. In any event, the patent laws of India are made best suited to the laws of this land, which cannot be similar in all aspects to the laws of the other lands (countries). Having said that, it should not be inferred from the above that the patent laws of India are not in conformity with the provisions of Patent Laws of the World. At best, the steps involved and the criteria laid down therein maybe be inferred to be different.

34. We wish to note that, though the petitioner has cited plethora of judgments, few of which are specified hereinabove, we are afraid they do not and in fact, cannot come to the aid of the petitioner as they have no application to the facts of the present case. In fact, few of those judgments strengthen the findings of this Court that the provision of Rule 22 of Patent Rules is not against the provisions of Patent Act and is rather in consonance with provisions of the said Act. In view of the aforesaid, it is quite abundantly clear that Rule 22 of Patent Rules is not only in consonance with the object and reasonings of the Patent Act but also with the PCT Rules and PCT Regulations and there are no Pari Materia provisions in the PCT Rules or the PCT regulation even otherwise. Further, the contention of the petitioner that it was not provided with an opportunity of hearing and thus, there was a violation of principles of natural justice holds no water, since it was the petitioner who failed to comply with the statutory provisions of the Patent Act and Patent Rules to file the application within the stipulated time. Having not done so, by operation of law, there was no occasion for the respondents to give any hearing and/or reason as it was in common knowledge of all applicants like the petitioner herein that as there was no application before the Controller (IPO) of any kind, therefore there was no occasion of it being heard.

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37. Having come to the aforesaid conclusion, according to us, there is no violation of any international treaty. Thus, reliance placed upon Commissioner of Customs (supra) by learned counsel for petitioner is misconceived. Moreover, Rule 22 of Patent Rules is not ultra-vires in view of Section 138 of Patent Act, and is not beyond the purview of Section 159 of Patent Act. Further, the same does not involve any sub-delegation and the existing situation in India is neither short of, nor in contradiction with the international position/PCT."

25. Therefore, once the Appellant did not enter the national phase within 31 months from the earliest priority date and neither sought the one month

extension nor expressed its intent to disclaim and seek change of date at the relevant time, it cannot be permitted to seek a change after 14 years by filing Form-13 on 28.06.2024 when the deadline was missed years ago. Similarly, Section 11B(1) read with Rule 24(B)(1)(i) provides that RFE is required to be filed within 48 months from the first/earliest priority date and consequences of this failure is explicitly provided in Section 11B(4), which postulates that the application 'shall be treated as withdrawn'. Taking strength from judicial precedents, there is no doubt that 48 months is a mandatory timeline and the consequence that non-adherence will result in the application being 'deemed to be withdrawn', is a statutory consequence and this Court cannot come to the rescue of the Appellant. In ***Carlos Alberto Perez Lafuente v. Union of India and Others, 2019 SCC OnLine Del 7404,*** the Division Bench of this Court was concerned with condonation of delay in filing RFE and it was held that when the language of the Rule is as clear as it could be, Petitioner could not have ignored the same and go by his logic. Howsoever *bona fide* may have been in his conduct, he cannot seek to evade the rigour of law. Relevant passages are as follows:-

> *"50. It is not in dispute that the petitioner, who is a Spanish national, made his prior application for a patent in a convention country and, therefore, Section 135 of the Act is attracted. As noticed above, the petitioner made his first application to seek patent as the European Patent Application on 28.03.2006 bearing No. 06111804.8. Since, in respect of a Convention Application, the date of making the "basic application" is treated as the "priority date", on a plain reading of Rule 24-B(1)(i), the request for examination under Section 11-B of the Act in Form-18 was required to be made within 48 months from the date of priority, i.e. 28.03.2006 since that is the earlier of the two dates i.e. the "date of priority", and the date of filing of the application under the Act, which was 28.08.2008. The period of 48 months, computed from 28.03.2006, expired on 27.03.2010. However, the request for examination was made on 19.11.2010.*

51. No doubt, it appears that the petitioner, who is a foreign national, may have, bona fide, believed that the time for making request for examination of the patent application had not expired and was available when he did make the said request under Section 11B read with Rule 24B. It does appear that he was mislead into believing that time was available for him to make such a request till the date when he actually made the request, in view of the communications received by him from his Indian agent, as well as on account of the interpretation of Rule 24B published in the publication of WIPO. His common sense would have led him to think that the examination of his application could be sought within forty eight months of the date of his application - which was later in point of time than his date of priority. However, when the language used in the Rule is as clear as it could be, the petitioner could not have ignored the same and gone by his own logic. Howsoever bona fide he may have been in his conduct, he cannot seek to evade the rigor of the law, which is so clear and explicit in its enunciation."

26. In ***European Union (supra),*** which is heavily relied upon by the Appellant, Coordinate Bench of this Court divided the judicial precedents on the subject in four broad categories being: (a) decisions relating to entry of international application into the national phase; (b) decisions relating to delay in filing RFE; (c) decisions concerning response to FERs; and (d) decisions concerning regular payments of annuities once patents have been granted. Under the first category, reference was made to the decision in ***Nokia Corporation (supra)*** and for the second category, to the decisions in ***Nippon Steel (supra), M/s Iritech Inc v. The Controller of Patents, 2017 SCC OnLine Del 7983*** and ***Carlos Alberto (supra).*** Court then divided the deadlines under the 1970 Act read with the Rules in the context of prosecution of patent applications into two categories: (a) deadlines which can be extended; and (b) deadlines which cannot be extended. Non-extendable deadlines were held to include *inter alia:-*

(i) Deadlines relating to entry of the application into the national phase;

(ii) Timelines for filing of requests for examination; and

(iii) Timelines for putting an application in order for grant etc.

27. Having so categorized, Court observed that provisions of the 1970 Act and 2003 Rules are abundantly clear as to which deadlines can be extended and which cannot be and insofar as time for filing RFE is concerned, Division Bench in ***Carlos Alberto (supra),*** has categorically held that the time period is mandatory and cannot be extended even if in the facts of a given case, patent agent is found to be negligent.

28. In ***Nippon Steel (supra),*** this Court held that there is a logic to the time limits set under the 1970 Act. The provisions of the 1970 Act and 2003 Rules have to expressly reflect the legislative intent to permit relaxation of time limits, absent which, such relaxations cannot be read into the provisions by a High Court exercising power under Article 226 of the Constitution of India. It was also held and this is relevant for the present case that merely because there is no time limit prescribed for filing an application for amendment of the priority date, it does not mean that such application can be filed even after a patent application ceases to exist in law. Once an application is deemed to have been withdrawn in terms of Section 11B(4), Controller cannot entertain an application for amendment. The contention of the Petitioner that where no substantive right of anyone was going to be affected by extending the time limit, Controller ought to take a liberal view, did not appeal to the Court. Court also negated the contention that Controller could have exercised powers under Rule 137 and observed that Rule 137 only applies to amendment of a document for which there is no special provision in the 1970 Act. Section 57(5) does provide for amending the priority date, however, Petitioner's request for amending the date was with a

view to indirectly get the time for filing the RFE extended for which power under Rule 137 cannot be invoked so as to permit an amendment of an application, which stands withdrawn by operation of Section 11B(4) of the 1970 Act. Relevant passages are as follows:-

> "*14. Mr. Chandra next submitted that the reason for the Petitioner failing to file RFE on or before 9th February 2010 was bonafide. The computer system of the Petitioner's attorney did not show any warning as regards the expiry of the deadline for filing the RFE since it had wrongly docked the application for amendment as an RFE. It is submitted that the CoP ought to have accepted the explanation offered in the affidavit of Mr. Tony Mon George. Relying extensively on the decision of the Supreme Court in Kailash v. Nanhku (2005) 4 SCC 480 Mr. Chandra argued that rules of procedure were handmaids of justice and could not be rigidly applied so as to defeat justice. He repeatedly urged that only where substantive rights of parties would be affected, the time limits set by a statute had to be rigidly applied. Since in this case no prejudice would be caused to the office of the CoP there should have been no difficulty in allowing the Petitioner's request for amendment of the priority date to 9th February 2007 which, although to the Petitioner's detriment, would in turn have shifted the deadline for the filing of the RFE to 9th February 2011. On the other hand, the Petitioner would be subject to tremendous loss and hardship in the event the amendment was not allowed since its application for grant of patent in India would not be able to be revived thereafter.*
>
> *15. Thirdly, it is submitted by Mr. Chandra that there was no rigidity to the deemed withdrawal of the patent application in terms of Section 11-B(4) of the Act if an RFE was not filed within 48 months of the priority date in terms of Rule 24-B of the Rules. Those provisions, according to him, were only directory. He submits that even in a worse case of deemed 'abandonment' in terms of Section 21 of the Act, this Court had in Ferid Allani v. Union of India 2008 (37) PTC 448 (Delhi) and Telefonaktiebolaget LM Ericsson (PUBL) v. Union of India 168 (2010) DLT 461 adopted a realistic and practical approach and accepted the explanation offered by the Petitioners as to why their respective patent applications should not be so treated. According to him, the facts of the present case were far better than the facts of those cases.*
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> *xxx xxx xxx*
>
> *21. Mr. Chandra referred to Rule 137 of the Rules to urge that CoP does have powers in that regard. Rule 137 reads as under:*
>
> *"**137. 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 detriment to the interests of any person; may be corrected if the Controller thinks fit and upon such terms as he may direct."

22. This Court is unable to agree with the above submission of Mr. Chandra. Rule 137 only applies to the amendment of a document for which there is no special provision in the Act. Section 57(5) of the Act does provide for amending the priority date. However, the Petitioner's request for amending the priority date is with a view to indirectly get the time for filing the RFE extended. In the considered view of this Court, the power under Rule 137 cannot be invoked by the Office of the CoP in the circumstances of the present case to permit an amendment to a patent application that has already been 'withdrawn' by operation of Section 11-B(4) of the Act.

xxx xxx xxx

24. While an applicant can seek to amend even the priority date of a patent application in terms of Section 57(5) of the Act, such request for amendment can be made only in relation to an application that exists in law. To recapitulate the facts in the present case, the request for amendment filed by the Petitioner in Form 13 on 22nd August 2008 was not for amending the priority date. It was only for correcting typographical errors. It was wrongly docked as Form 18 in the computer of the Petitioner's attorney. As far as the Office of the CoP was concerned, that application would have been treated as one under Form 13. Going by the affidavit of Mr. Tony Mon George, the Petitioner's attorney knew that it had, on 22nd August 2008, only filed an application for amendment of typographical errors. Even if that application had been allowed, the priority date of the application would have remained as 9th February 2006. Therefore, the deadline for filing the RFE would have continued to be 9th February 2010. Since, in any event, no RFE was filed before the expiry of the deadline in terms of Section 11-B(4) of the Act, the patent application stood withdrawn after 9th February 2010.

25. There is a logic to the time limits set out under the Act. The scheme of the Act and the Rules require time-bound steps to be taken by applicants for grant of patent at various stages. The provisions of the Act and the Rules have to expressly reflect the legislative intent to permit relaxation of time limits, absent which such relaxation cannot be 'read into' the provisions by a High Court exercising powers under Article 226 of the Constitution. In other words, it is not possible for this Court to accept the submission of the learned Senior counsel for the Petitioner that the time-limits under Section 11-B(1) of the Act read with Rule 24-B of the Rules, notwithstanding Section 11-B(4) of the Act, are merely 'directory' and not mandatory. In fact, the wording of Section 11-B(4) of the Act underscores

the mandatory nature of the time limit for filing an RFE in terms of Section 11-B(1) of the Act read with Rule 24-B of the Rules.

xxx *xxx* *xxx*

27. Merely because there is no time limit prescribed for filing an application for amendment of the priority date, it does not mean that such application can be filed even after a patent application ceases to exist in law. Once an application is deemed to have been withdrawn by an applicant in terms of Section 11-B(4) of the Act, the CoP cannot entertain an application for amending any portion of such application. It is not possible to accept the submission of the learned Senior counsel for the Petitioner that the CoP is bound to allow an amendment at any time, even after the deemed withdrawal of such application, and that once such amendment is allowed it would relate back to the date of the filing of the application and thereby revive the application. This submission is contrary to the scheme of the Act and Rules. Also, in view of what has been stated by the DCoP in the email of 2nd February 2011 there is a doubt whether an applicant can seek to amend the priority date at its sweet will to any date of its choice. However, for the purposes of the present case, it is beyond doubt that the CoP could not have, after the deemed withdrawal of the Petitioner's patent application on 9th February 2010, permitted it to amend the priority date of such application.

28. This Court is of the view that the decisions in Ferid Allani v. Union of India and Telefonaktiebolaget LM Ericsson (Publ) v. Union of India were rendered in a different factual context and do not aid the Petitioner's submissions. The Petitioners there were in correspondence with the Office of the CoP in relation to the defects pointed out in their respective patent applications and had in fact made requests for oral hearing. In those circumstances, this Court held that those Petitioners could not be held to have abandoned their claims for the purposes of Section 21 of the Act. As far as the present case is concerned, the Petitioner missed the deadline of 9th February 2010 for filing an RFE. It realised the error much later and on 28th October 2010, filed an application for amending the priority date by which time the patent application itself ceased to exist. The decisions of the Commissioner of Patents and Trademarks, USA in Re Katrapat, AG 6 U.S.P.Q. 2 D (BNA) 1863 and Re Application of Ong, et al (Application No. 11/754, 832) are also of no assistance since the patent law regime in our country is governed by the Act and Rules which in themselves constitute a complete code."

29. The argument that Appellant had disclaimed the first/earliest priority date at the threshold stage and which is really the heart of the dispute in this case, is flawed and cannot be accepted. At the time of filing the application,

as noted above, Appellant did not file any document or formal request to disclaim the first priority date and in fact this date does not even find mention in Form-1 on a presumption and/or advise that there is an automatic disclaimer. Respondent has categorically stated that no request was made to seek disclaimer at the time of filing the application and Appellant has not placed on record even a shred of material to traverse this stand. The first request for claiming disclaimer and amendment of first priority date came only through Form-13 on 28.06.2024 along with a petition under Rule 137. Respondent has rightly held that Form-1 does not mention the first PCT priority i.e., US 60/896,458 dated 22.03.2007 and thus there is no scope of amendment and consequently, for condoning irregularity in filing Form-13 wherein the Appellant stated: " *We are hereby submitting a request as per section 57(5) for voluntarily amending the date of priority claimed in the present application by way of disclaimer, correction and explanation. We request to allow disclaiming the earliest PCT priority (US 60/896,458 dated 22.03.2007) and consider the earliest priority claimed (i.e US 60/994,902 dated 20.09.2007) in the present application* ". Hence, in my view, Appellant cannot be permitted to disclaim the first date and seek amendment of priority date in the given facts and circumvent the missed deadlines for: (a) filing national phase application; and (b) filing RFE. It is trite that what cannot be done directly cannot be done indirectly and the impugned decision cannot be faulted.

30. Furthermore, Respondent has rightly distinguished the judgments relied upon by the Appellant. Case of ***European Union (supra)*** deals with condonation of delay in filing responses to FERs, owing to which the patent applications were deemed to have been abandoned under Section 21(1) of

1970 Act. Exercising writ jurisdiction under Articles 226 and 227 of the Constitution under exceptional circumstances, Court held that if there was negligence on the part of patent agents, delay in filing responses to FERs in given facts and circumstances can be condoned. Respondent has correctly captured the applicable part of the judgment, where it was held that timelines for entry into national phase and for filing RFEs fall under the category of 'non-extendable deadlines' and in this context referred to some passages from the judgment, which are extracted hereunder:-

> *"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.,*
>
> *xxx xxx xxx*
>
> *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.*
>
> *xxx xxx xxx*
>
> *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.*

xxx *xxx* *xxx*

64. In view of the judicial decisions cited above as also in the spirit of the Parliamentary Standing Committee's report dated 23rd July, 2021, this Court is of the opinion that the present two applications would fall in the category of exceptional circumstances, owing to the peculiar facts where the response to the FERs deserve to be taken on record. Accordingly, it is directed that the response to the FER shall be taken on record by the patent office. The application nos. 11123/DELNP/2013 and no. 3466/DELNP/2013 shall be restored to their original position. The examination of the said patent shall now be proceeded with by the patent office in accordance with the Act and the Rules. The same shall be concluded within a period of six months."

31. Respondent referred to the cited judgment in ***Bry Air prokon (supra)*** and distinguished the same on facts and rightly so, as in that case the Court permitted the Petitioners to file requests for restoration of the patents for the extraordinary circumstances shown therein. This judgement has nothing to do with extending timelines for entry in national phase and/or filing RFEs, which is the case here. Respondent also correctly distinguished the judgment in ***Nokia Corporation (supra),*** which essentially dealt with interpretation of Rule 138 and Court held that application for extension is to be filed within one month after expiry of prescribed time under Rule 20 and in case an application is moved for extension of time by one month or shorter period, it is to be decided on merit taking into consideration facts of the case. In the instant case, Rule 138 was neither invoked nor is applicable with a delay of over four months. The cited judgment in ***Tryton Medical Inc. (supra),*** passed by IPAB was also dealt with and it was held that the case pertained to extension by one month only to file national phase application to meet the delay caused due to docketing/technical failure of docketing system. Having distinguished these judgments, Respondent followed the right path and referred to and relied on the judgment in ***Nippon Steel (supra),*** where this

Court has categorically proscribed entertaining an application for amendment of priority date after the patent application is deemed to be withdrawn by force of Section 11B(4) of the 1970 Act.

32. Appellant's reliance on one patent application which was allowed in the past is also misconceived as the facts therein were different from this case, especially, on omission of full disclosure and amendment being sought after 14 years. Ms. Nidhi Raman rightly urges that permitting the Appellant to disclaim the first/earliest priority date basis the Form-13 filed on 28.06.2024 would be against the provisions of the 1970 Act and 2003 Rules as also the aforementioned judicial precedents on the subject and would open floodgates and encourage parties to follow the path of seeking disclaimers years after mandatory deadlines are missed. Respondent has treated the patent application as deemed withdrawn by the impugned order, owing to non-filing of the application within 31 months from first/earliest priority date and non-filing of RFE within 48 months and this Court finds no infirmity in the order, warranting interference. The argument of the Appellant that the invention is an important invention in public interest and moreover, non-revival of the application by a disclaimer will seriously prejudice the Appellant's right, while no prejudice will be caused to any other party, appeals on the first blush but cannot be accepted in light of statutory proscriptions, mandatory timelines and the judgments aforementioned.

33. The appeal is accordingly dismissed being devoid of merits.

JYOTI SINGH, J.

MAY 18 ,2026*/YA*