

Nupur Highlights Importance of National Phase Patent Application Deadline in ABLJ

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The Indian patent regime requires strict compliance with several deadlines where failure to take timely action could result in adverse consequences to patent applicants.

Rule 20(4) of the Patents Rules, 2003 mandates the filing of national phase applications under the Patent Co-operation Treaty (PCT) in India within 31 months from the priority date. According to rule 22, an international application designating India shall be deemed to be withdrawn if the applicant does not comply with rule 20. With the amendment of rule 138, which vests on the controller's discretionary power to extend the time prescribed under the patents rules, the 31-month timeline has oscillated between being extensible and inextensible.

The earliest cases that dealt with failure to timely file national phase applications in India are that of *Nokia Corporation v Deputy Controller of Patents and Designs* (2010), before the *Madras High Court*, and *Tryton Medical Inc v The Controller General of Patents* (2014), before the Intellectual Property Appellate Board. In both cases, delayed national phase filing was permitted and it was held that rule 138 vested the controller with discretionary power to extend the time for filing national phase applications by one month if sufficient cause was shown by the applicant.

The Patents Rules, 2003 was amended on 16 May 2016. Under the 2016 amendment, rule 138 no longer permitted a month's extension for delayed national phase filing. Judgments of the courts from then on show a sterner stance regarding non-compliance with the 31-month deadline.

In *Diebold Self Service Systems v Union of India and Others* (2022), the petitioner challenged the patent office's refusal to permit a national phase application delayed by five months. Their primary contention was that rule 22 of the patents rules contradicts rule 49.6 of the PCT rules. Holding that rule 22 did not contradict the provisions of the PCT, the court stressed that the 31-month deadline for entering national phase in India is mandatory and does not allow any flexibility for the applicant during the initial filing stage.

In *Humanity Life Extension LLC v Union of India and Another* (2023), the petitioner's Indian attorney failed to timely file the national phase application despite receiving timely instructions. Upon learning about the missed deadline, the petitioner transferred the case to another Indian agent who tried to file the national phase application, which the controller refused to take on record.

Here, too, the petitioner argued that rule 138 was ultra vires (beyond the powers of) rule 49.6 of the

PCT regulations. Referring to the decision of Delhi High Court on the Diebold case, the division bench reaffirmed that the 31-month deadline for filing national phase applications in India is mandatory and that the patents rules did conform with the PCT regulations.

Interestingly, unlike recent judgments dealing with delayed national phase filings, the courts have been more liberal in allowing an extension for other mandatory deadlines where an extension under rule 138 is barred.

In *The European Union Represented by the European Commission v Union of India (2022)*, the court held that while the controller may not be able to permit a delayed filing of the reply to the first examination report, the high courts exercising writ jurisdiction could condone such delays in rare cases where the facts of the case reflect that the applicant has no intention to abandon the application, such as negligence by the patent agent, docketing error, and exercise of diligence by the applicant. However, the lack of follow-up by the applicant could be treated as an intent to abandon the application.

The Patents (Amendment) Rules 2024 was published on 15 March 2024. The newly amended rule 138 now entrusts the controller with a broad discretion to condone the delay in doing any act under the rules for a period of up to six months.

Even though the amended rule 138 appears to permit an extension of time prescribed by any rule, the patent office does not appear to concur. Irrespective of whether delayed national phase filings are permitted in the future, it is important to note that rule 138 is a discretionary provision and extensions under the same are considered only if the applicant can establish an intent to pursue the application.

Therefore, negligence is not likely to be condoned. In any event, it is best to be diligent and to comply with the 31-month deadline to avoid adverse consequences.

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