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

+ C.A.(COMM.IPD-PAT) 30/2023

FILO EDTECH INC Appellant

Through: Mr. Vivek Ranjan, Tiwary, Ms.
Radhika Pareva and Mr. Asavari Mathur,
Adv.

versus

UNION OF INDIA & ANR. Respondents

Through: Mr. Harish Vaidyanathan
Shankar, CGSC with Mr. Srish Kumar
Mishra, Mr. Alexander M. Paikaday, Mr.
Krishnan V, Adv.

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

ORDER

16.11.2023

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1. A fairly ticklish legal issue has arisen in this case, though Mr. Vaidyanathan would submit that stands concluded by the judgment of a Coordinate Bench of this Court in *Dr. Reddys Laboratories v. Controller of Patents*¹.

2. An application for grant of patent was filed by the appellant on 4 February 2022 before the Bombay Patent Office. Apparently, in accordance with an arrangement which has been devised by the Patent Office in the interests of administrative convenience, the application was assigned to a Controller sitting at the Delhi Patent Office to examine the application. It is a conceded position that examination of

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the application took place at Delhi, First Examination Report (FER) was issued at Delhi, the response to the FER was considered in Delhi, notice of hearing was issued by the Delhi Patent Office and the matter was finally heard and the impugned order passed by the Delhi Patent Office. The appellant has appealed against the said order under Section 117A of the Patents Act, 1970 before this Court. The respondent has raised an objection that the appeal would lie before the High Court of Bombay, relying, to a great extent, on the judgment of the Coordinate bench in *Dr. Reddys Laboratories*.

3. A reading of the decision in *Dr. Reddys Laboratories* reveals that the Court was, in that case, considerably influenced by Rule 4 of the Patent Rules, 2003. Rule 4 defines “appropriate office” as the office where the application seeking grant of patent is filed. The Coordinate Bench in *Dr. Reddys Laboratories* has held, in para 89, that “at the time of filing of a patent application, the appropriate office in respect of the said patent application, ordinarily, is frozen, i.e.

- it is decided on the basis of either the place where the applicant or one of the applicants normally resides or has domicile or has a place of business or the place where the invention originated or;
- it is decided on the basis of the address for service of the applicant in India in case of a foreign applicant.”

4. I have queried of Mr. Vaidyanathan as to whether, if in fact the appropriate office was frozen as Bombay, because the application seeking grant of patent was filed before the Patent Office at Bombay, the entire examination of the patent application, from scratch till the



passing of the impugned order, could have taken place at Delhi. If indeed, it could have taken place at Delhi, it appears, subject to Mr. Vaidyanathan disabusing me in that regard, that there is no provision by which an application filed before one Patent office (treating it as the appropriate office) could be assigned to a Controller sitting in another Patent Office at a geographically different location for examination. Mr. Vaidyanathan submits that this arrangement was made only for the sake of convenience in order to expedite hearing and disposal of patent applications.

5. To my mind, this raises an important and somewhat complicated issue. The stand of the respondent is that, as the appellant's application was originally filed at Bombay, the Bombay Patent Office was the "frozen" appropriate office. In that case, the question that arises is whether it was open to the respondent, in the absence of any statutory provision to that effect, to delegate the entire examination of the application, conducting of hearing and passing of final order to the Delhi Patent Office.

6. If, in fact, it was permissible for the respondent to do so, the next question that would arise is whether, when the unsuccessful applicant, whose application was rejected, seeks to appeal against the decision of the Controller, he can be foreclosed from approaching this Court on the ground that the appropriate office was Bombay, even though the Bombay Patent Office did not, at any stage, from start to finish, deal with the petitioner's application in any manner.

7. As these issues are somewhat involved, re-notify for further



hearing on 21 November 2023 as part heard.

8. Both sides are also not very clear as to why this matter was, in fact, transferred to the Delhi Patent Office. As such, Mr. Vaidyanathan is requested to have with him the record disclosing why the petitioner's application, though filed at Bombay, was examined, and all proceedings thereafter conducted, at Delhi.

C.HARI SHANKAR, J

NOVEMBER 16, 2023

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[Click here to check corrigendum, if any](#)