



2025:DHC:1615



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

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Date of decision: 07th March, 2025

+ **W.P.(C)-IPD 15/2025 & CM 49-51/2025**

CIENA CORPORATION

.....Petitioner

Through: Mr. Samar Bansal, Mr. K. Rigved
Prasad, Mr. Aman Bajaj,
Mr. Kaustubh Chaturvedi and
Mr. Vedant Kapur, Advocates

versus

UNION OF INDIA & ORS.

.....Respondents

Through: Mr. Gaurav Barathi, SPC with
Ms. Mamta Tiwari, G.P. with
Ms. Rasya Rawal, Advocate for UOI
& CGPDT, R-1 & R-2

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. This writ petition has been filed seeking setting aside of the letter dated 16th February, 2024, passed by respondent No.2 in the PCT National Phase Application No.202017034476, whereby, the patent application filed on behalf of the petitioner has been deemed to be abandoned (hereinafter "Abandonment Letter").

2. In view of the limited issue involved in the present petition, with the consent of the parties, the petition is taken up for disposal at this stage itself.



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3. Brief facts necessary for deciding the present petition are set out below:-

i. The present Indian patent application pertains to ‘Modular Network Element Architecture’, a new type of modular network element invented by the employees of the petitioner in the year 2018. The invention is a physical hardware having networking, computing and storage functions, and is in the nature of a hybrid between a rack-mounted module and a line module which is inserted in a chassis.

ii. On 23rd April, 2018, the petitioner filed the priority Patent Applications bearing no.15/959,746, 15/959,820 and 15/959/869 in the United States Patent and Trademark Office (USPTO).

iii. On 9th April, 2019, petitioner filed the international application no.PCT/US2019/026489 before the World Intellectual Property Organisation (WIPO) seeking international publication of the invention under the Patent Cooperation Treaty (PCT), after which WIPO published the invention on 31st October, 2019.

iv. The national phase application in respect of said invention was filed on 11th August, 2020 by the petitioner before the Indian Patent Office, New Delhi.

v. On 15th April, 2022, relevant forms prescribed under Indian Patent Rules, 2003 were filed by the Indian Patent Agent of the petitioner requesting for examination of the subject patent application and also seeking amendment of the patent application.

vi. On 1st September, 2022, the first examination report (FER) was issued by the patent office to the patent agent of the petitioner. However, the patent agent of the petitioner did not inform the



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petitioner about the said request for examination of the FER and hence, the reply to the aforesaid FER could not be filed by the petitioner.

4. On 16th February, 2024, the Abandonment Letter was passed by the respondent no.2 treating the patent application filed on behalf of the petitioner to be abandoned in view of the fact that the petitioner failed to file a response to the FER within the prescribed statutory time period. The relevant extracts from the Abandonment Letter are set out below:-

“I am to invite a reference to the above mentioned Application, In this regard it has been observed from the records available with this office that you have not submitted the reply to First Examination Report (FER) issued by this Office vide letter No - 202017034476, Dated - 01 Sep 2022. You have failed to put the above mentioned application in order for grant within the prescribed period as stipulated in Section 21(1) of The Patents Act 1970 which expired on 01 Mar 2023. In view of the above circumstances, the said application is treated as deemed to have been abandoned under the provisions of section 21(1) of the said Act.”

5. It is stated that the petitioner came to know about the Abandonment Letter being passed only on 23rd January, 2025, when the petitioner carried out due diligence through a third party.

6. Immediately thereafter, the petitioner contacted its patent agent and inquired about the subject patent application. The patent agent admitted his mistake and informed the petitioner that the FER was inadvertently omitted from being docketed in the system of his firm and hence, the same could not be communicated to the petitioner. In this regard, the petitioner has placed on record an affidavit of the patent agent dated 25th February, 2025.

7. Mr. Bansal, counsel appearing on behalf of the petitioner submits that the petitioner cannot be penalised on account of a *bona fide* mistake committed on the part of the patent agent. He relies upon a judgment of a



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Coordinate Bench of this Court in *European Union Represented by the European Commission v. Union of India and Ors.*, 2022 SCC OnLine Del 1793.

8. Mr. Gaurav Barathi, counsel appearing on behalf of the respondent submits that there has been an inordinate delay in filing the present petition. The FER was issued in September 2022, and was duly served on the patent agent of the petitioner; the Abandonment Letter was issued on 16th February, 2024 and the present petition has been filed only on 25th February, 2025.

9. I have heard the counsel for the parties.

10. It is a settled position of law that a party cannot suffer on account of the mistake of his lawyer, or in the present case, his patent agent. Counsel for the petitioner has correctly relied on the judgment in *European Commission v. Union of India* (supra). The relevant observations from the aforesaid judgment are set out below:-

“58. The decisions discussed above would show that inadvertent errors or errors of patent agents have been liberally considered by the Court. The consequences of patent being abandoned is quite extreme i.e., the Applicant is deprived of exclusivity for the invention completely. In the opinion of the Court, such a consequence ought not to visit the applicant for no fault of the Applicant. In the facts of these cases, the Applicant had no intention to abandon the application. It has taken all measures possible to prosecute these applications. The Applicant was conscious of the fact that the patent may be maturing for examination and took the initiative to keep in touch with the patent agent from the very inception.

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



of the Petitioner.

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

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

62. In view of the fact that no fault can be attributed to the Applicant, this Court is of the opinion that the Applicant ought not to be made to suffer. However, there is a word of caution that this Court would like to add in this regard. The intention of the Legislature in Rule 138 of the Rules cannot be ignored by the Controller, nor can one ignore the express language of Section 21(1) of the Act, which mandates a deemed abandonment in case of non-compliance with the requirements imposed under the Act. It is only in extraordinary cases, while exercising writ jurisdiction, that the Court may consider being flexible, and this would depend on the facts of each case as to whether a condonation ought to be given at all.”



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11. The ratio of the aforesaid judgment is fully applicable in the facts of the present case. In the present case, the petitioner has filed the same patent application in several countries including the Indian application within the prescribed time limits through the PCT route. The petitioner has obtained the registrations in respect of the same patent in various other countries. The petitioner also filed the request for examination of the patent application in the present case within the prescribed time period.

12. The patent agent of the petitioner has admitted its mistake in not communicating the FER to the petitioner and therefore, the reply to the same could not be filed within the prescribed time limit. The aforesaid fact has been admitted by the patent agent on affidavit, which has been placed on record by the petitioner.

13. Rights granted in favour of a patentee are valuable rights and there would be drastic consequences if the said rights are defeated by an inadvertent mistake of the patent agent of the applicant.

14. The petitioner in the present case had no intention to abandon the subject application. It has taken all measures to prosecute this application. Immediately after coming to know about the Abandonment Letter having been passed, the petitioner had promptly filed the present petition.

15. In view of the discussion above, this Court is of the opinion that the petitioner/applicant cannot be made to suffer on account of *bona fide* mistake committed by its patent agent. Accordingly, the present writ petition is disposed of with the following directions:-

- i. The Abandonment Letter dated 16th February, 2024 is set aside.
- ii. The subject patent application filed by the petitioner would stand restored to its original number.



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iii. One final opportunity is given to the petitioner to file reply to FER dated 1st September 2022 within four weeks from today.

16. The Registry is directed to send a copy of the present order to the office of the Controller General of Patents, Designs and Trade Marks at the e-mail '*llc-ipo@gov.in*' for compliance.

AMIT BANSAL, J

MARCH 07, 2024
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