

HELLO

Series of brief newsletters released by Bharucha & Co. on latest development of IP predominantly in Pakistan.

PATENTS – CONTROLLER’S POWER TO EXTEND TIME IS RESTRICTED TO SITUATIONS

Appellant: Pakistan Pharmaceutical Manufacturers’ Association and others

Respondents: The Controller of Patents and others

Decision: Appeals Dismissed

Miscellaneous appeals were filed against a single order passed by the Controller of Patents whereby several patent applications filed by 32 entities were opposed by the Appellants on the prescribed Form P-7 but without filing statement as required under Rule 18(1)(c) of the Patents Rules, 2003 (“**the Rules**”). All Appellants were represented by the same patent attorneys firm before the Controller of Patents and in the High Court.

Brief facts of the case are that the Respondents filed several patent applications for grant of patents under Section 13 of the Patents Ordinance, 2000 (“**the Ordinance**”). All applications were examined, accepted and were advertised in Part-V of the Gazette of Pakistan for inviting opposition under Section 23, which reads as:

23. Opposition to the grant of patent: (1) *At any time within four months from the date of advertisement of the acceptance of a complete specification under this Ordinance, any person may give notice to the Controller of opposition to the grant of patent on any of the following grounds.....*

A plain reading of the aforementioned provision will show that opposition is to be filed within four months from the date of advertisement whereas Rule 18 requires that such opposition shall be given on the prescribed Form P-7 accompanied by a statement setting out fully the nature of the opponent’s interest, the facts upon which he relies and the relief which he seeks. In all the cases under appeal the Appellants filed oppositions on the prescribed Form P-7 but those were not accompanied with the requisite statements which is mandatory. Later on when the deficiency was noted, the Appellants filed statements along with extension requests. However, the learned Controller of Patents refused to consider the statements and dismissed the applications filed on Form P-7 for opposition for deficiency in the opposition filed initially.

The Appellants while admitting the fact that the requisite statements were not accompanied with Form P-7, submitted that these were filed along with the applications for extension of time on Form P-4 based on Rule 62 which reads as:

62. General powers to extend time:- *The time prescribed by these rules for doing any act or taking any proceeding thereunder may be enlarged by the Controller if he thinks fit and upon such terms as he may direct. Provided that no such extension of time granted under this rule shall exceed a period of more than one month at a time, provided that total period of such enlargements shall not exceed three months against the statutory period prescribed. Every application for extension of time under this rule shall be made in the form as set out in Form P-4.*

Relying on earlier judgements of the superior courts the Respondents submitted that once the statutory limit of four months has expired, right of the applicant for patent is cemented and the window for intervention is closed. It was further submitted by the Respondents that the law as laid down in earlier judgements establishes that anything required by law has to be done in the manner as prescribed otherwise it has no legality in the eyes of law, therefore, the act of filing documents, required under Rule 18(1)(c), after the expiry of statutory period of four months were rightly considered as nullity by the Controller of Patents.

A detailed analysis was made on Form P-4 as referred to in Rule 62 for the possibility of extension of time beyond the term of four months prescribed under Section 23 in opposition cases and it was concluded that there is no possibility for extension of time beyond four months for filing of opposition under the said section. The driving factor for this decision was that the Rules are subservient to an Act/Ordinance and since Section 23 of the Ordinance mentions no extension period after four months Controller of Patents had no powers to grant extension of time beyond the statutory time prescribed under Section 23.

The Appellants drew the court's attention to the fact that Controller of Patents has initially accepted extension of time applications filed on Form P-4 and allowed the Appellant to file statements under Rule 18(1)(c). However, the court observed that the Controller's power to extend time are only restricted to situations which do not fall under the heading of Form P-7 wherefrom it could be seen that there is no power to extend the requirement of Rule 18(1)(c). Therefore, the Controller refused the oppositions filed by the Appellant.

Consequently, the appeals filed by all the Appellants were dismissed. However, the said decision is subject to appeal.

