

Addressing Patent Lapses Due to Agent's Incapacity: A Comprehensive Review of Revival Remedies

A patent, granted for a 20-year period from the date of application, requires timely renewal to remain in force. The Patents Act, 1970 provides stringent timelines for filing renewal applications and fees, exceeding which will result in lapse or deemed abandonment of the patent. This article explores the challenges arising when patent agents fail to pay renewal fees on time, leaving patentees unaware and vulnerable to losing their patents. The need for a robust legislative and judicial framework to address this issue is crucial.

I. Overview of Patent Renewal Requirements:

To maintain a patent, renewal fees must be paid at the end of the second year and subsequently each year. A six-month extension is possible under Rule 80 of the Patents Rules 2003. Companies often appoint agents for filing, leading to complications when renewal fees are not paid promptly.

II. Legislative Framework and Remedies:

Under the Legislative framework, the Indian Patent Law does not specifically deal with the aspect of agent's negligence in filing renewal application/fees but provides remedies that can be availed by the Patentee for saving his patent even after its lapse. Section 60 of the Patents Act, 1970 allows restoration of a lapsed patent within 18 months of expiration. Section 61 outlines criteria such as unintentional failure and timely application. On evaluating such Application, the Controller of Patents exercises discretion and either allows the application, followed by restoration of patent on payment of renewal fees and additional fee (specified in first schedule) within one month or rejects the Application against which the Patentee may file an appeal to the Intellectual Property Appellate Board (IPAB) within three months from the date of the controller's decision. If the IPAB refuses to grant relief to the Patentee, he may directly file a Special Leave Petition (SLP) before the Hon'ble Supreme Court (SC) or invoke Article 226 of the Constitution by preferring a Writ Petition before the Hon'ble High Court (HC) of that State against Orders of the IPAB or



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the Controller (Patent Office) and thereafter, if the Patentee is aggrieved by the Order passed by the HC, he may file an appeal or a SLP before the SC .

III. Judicial Trends and Recent Developments:

Recent trends indicate courts acknowledging and resolving issues caused by patent agent negligence. However, while claiming patent restoration the Patentee needs to prove the following circumstances: (a) Agent's fault/negligence caused the patent lapse/abandonment; (b) No contributory negligence of the Patentee; (c) Absence of Patentee's intention to abandon the patent; (d) Patentee's full diligence (e) Patentee will suffer immensely if patent is not restored. High Courts have emphasized flexibility in extraordinary cases, considering the enormous prejudice caused by deemed abandonment provisions.

IV. Case Law: Rubicon Research Pty Ltd. v. The Controller General of Patents, Designs and Trademarks and Ors (2020):

In this case, the IPAB set aside the Controller's order, allowing restoration beyond the 18-month period. The IPAB considered the appellant's efforts, agent's negligence, and the potential harm to the patentee if the patent were lost. This highlights the need for flexibility in enforcing restoration.

V. Importance of Patents and the Call for Flexibility:

Patents play a vital role in technology, industrial development, and attracting foreign direct investment (FDI) to India. However, the rigid patent regime and inflexible timelines may hinder innovation. To encourage innovation and save patents, there is a need for a more flexible legal framework, urging courts and the IPAB to adopt a nuanced approach.

Addressing patent lapses due to agent incapacity requires a comprehensive review of revival remedies. By enhancing the legislative framework and fostering a flexible approach at the adjudication level, the aim is to protect patentees showing bona fide conduct and contribute to the growth of innovation in India.

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