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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI***Date of Reserved: 9<sup>th</sup> April, 2024**Date of Decision: 04<sup>th</sup> July, 2024*

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**W.P.(C)-IPD 9/2023****SAURAV CHAUDHARY**

..... Petitioner

Through: Mr Neeraj Grover, Ms. Meenakshi Ogra, Mr Tarun Khurana Adv. Mr Samrat S. Kang, Mr. Rishi Vohra Adv. Mr. Hemant Kataria, Ms. Chhavi Pandey & Mr. Amarjeet Kumar, Advs. (M: 9891012029)

versus

**UNION OF INDIA & ANR.**

..... Respondents

Through: Ms. Nidhi Raman, CGSC with Mr. Zubin Singh, Adv. for UOI. (M: 9891088658)  
Mr. Naveen Chaklan, Answering Patent Agent.  
Mr. Chander M Lall, Sr. Adv. with Ms. Nancy Roy, Ms. Archana Sachdeva, Mr. Sushant M. Singh, Ms. Kruttika Vijay, Mr. Raghav Malik, Ms. Ananya Chug & Mr. Sushant Singh, Adv. for Intervenor IPAA. (M: 98117 77625)

**CORAM:****JUSTICE PRATHIBA M. SINGH****JUDGMENT****Prathiba M. Singh, J.**

1. This hearing has been done through hybrid mode.

**BACKGROUND FACTS:**

2. The present writ petition has been filed by the Petitioner challenging the abandonment of its patent application number 201911031496 titled “*Blind-Stitch Sewing Machine and Method of Blind Stitching*”. The prayer in the writ petition is to restore the patent application of the Petitioner. The details of the said application are set out below:

Application Details	
APPLICATION NUMBER	201911031496
APPLICATION TYPE	ORDINARY APPLICATION
DATE OF FILING	03/08/2019
APPLICANT NAME	CHAUDHARY, Saurav
TITLE OF INVENTION	A BLIND-STITCH SEWING MACHINE AND METHOD OF BLIND-STITCHING USING THEREOF
FIELD OF INVENTION	TEXTILE
E-MAIL (As Per Record)	info@khuranaandkhurana.com
ADDITIONAL-EMAIL (As Per Record)	patent@delhiip.com
E-MAIL (UPDATED Online)	
PRIORITY DATE	
REQUEST FOR EXAMINATION DATE	07/03/2022
PUBLICATION DATE (U/S 11A)	05/02/2021

  

Application Status	
APPLICATION STATUS	Reply not Filed Deemed to be abandoned U/s 21(1)



Office of the Controller General of Patents, Designs & Trade Marks  
Department for Promotion of Industry and Internal Trade  
Ministry of Commerce & Industry,  
Government of India





3. The case of the Petitioner is that he had filed a patent application through one firm “*M/s Delhi Intellectual Property LLP*” (hereinafter referred as the ‘firm’) having office at 4-K, 4th Floor, Gopala Tower, 25, Rajendra Place New Delhi-110008. Mr. Naveen Chaklan, Partner at the said firm was dealing with the Petitioner’s patent application. In addition to Mr. Chaklan, two more lawyers are stated to be working in the said firm. The firm provides registration services for trademarks, patents, copyrights and designs.

4. According to the Petitioner, the application was filed on 3rd August, 2019 and a request for examination was filed on 21st February, 2022. Thereafter, the FER in respect of the subject application was issued on 29<sup>th</sup> April, 2022 with a direction by the Patent Office that the response should be filed within a period of six months.

5. It is the case of the Petitioner that repeated follow ups were made by him with the firm and Mr. Chaklan on various dates *i.e.*, 15th March, 2022, 28th August, 2022, 5<sup>th</sup> November, 2022, 19th November, 2022, 14th December, 2022, 22<sup>nd</sup> December, 2022 and 8th January, 2023. However, he did not receive any reply from the Patent Agent. During the process, the Petitioner found out that the application was “*deemed to be abandoned*” due to non-filing of the response to the FER. The Petitioner then engaged a new Patent Agent. Finally, the Petitioner filed a request for restoring the patent application on 28th January, 2023. Hence, the present writ petition. On 31<sup>st</sup> July, 2023, notice was issued to the Patent Agent by this Court. Mr. Chaklan has appeared and made submissions.



**ARGUMENTS:**

6. Notice was issued in this matter on 15<sup>th</sup> February, 2023, and submissions have been heard. The same are captured below:
- i. Mr. Grover, Id. Counsel appearing for the Petitioner relies upon the decision of this Court in *European Union Represented by the European Commission v. Union of India and Ors. 2022:DHC:2301* to argue that in exceptional circumstances High Court can exercise power under Article 226 to condone delay.
  - ii. It is his submission that in the present case, there are exceptional circumstances wherein despite follow ups, the Patent Agent did not respond and thus the Petitioner ought to be given benefit of the said decision.
  - iii. Mr. Grover submits that repeated emails by the Petitioner from 19<sup>th</sup> February, 2022, 15<sup>th</sup> March, 2022, 28<sup>th</sup> August, 2022, 5<sup>th</sup> November, 2022, 19<sup>th</sup> November, 2022 and 14<sup>th</sup> December, 2022 have gone unreplied.
  - iv. On 22<sup>nd</sup> September, 2022, the Petitioner came to know that the status on the website is now being shown as “*reply not filed deemed to be abandoned*” and the query was raised with the Patent Agent, however, there was no reply. The Petitioner then wrote on 8<sup>th</sup> January, 2023 to another partner in the firm Delhi IP, however, received no reply. Thus, it is submitted that the Petitioner cannot be blamed for the abandonment.
  - v. Finally, Mr. Grover, submits that the six months period for replying to the examination report ended on 28<sup>th</sup> October, 2022. The Petitioner had the option of making an application for the three months



extension prior to the expiry of the said six months period, however, after continuously following up finally a revival request form was filed on 28th January, 2023 by the Petitioner. Since on the website there was no option for the Petitioner to file the reply to the FER the same could not be filed. Hence, the Petitioner has availed of the remedy of filing the present writ petition.

7. It is submitted by Mr. Naveen Chaklan-the Patent Agent as under:
  - i. That he was in touch with the Petitioner till the filing of the patent application and, in fact, he has even filed a request for examination and has confirmed the same on 15th March, 2022.
  - ii. Thereafter, the First Examination Report (FER) was issued on 29th April, 2022. The only communication as per him was one incoming telephone call after the issuance of the FER and a second outgoing call on 10th September, 2022 for 57 seconds.
  - iii. According to him, no instructions were given by the Petitioner and hence he could not reply to the FER but he had communicated the issuance of the FER.
  - iv. On a pointed query from the Court as to whether there is any email on record informing the Petitioner about the issuance of a FER, he clearly admits that there has been no written communication or even email except the telephone calls.
  - v. He, further, submits that the Petitioner did not even give the power of attorney in his favour. This is countered by Mr. Grover, Id. Counsel who submits that till February, 2022 the Petitioner has paid the fee for filing of the request for examination of Rs.6,000/- as is evident from the email dated 13th February, 2022.



8. On behalf of the CGPDTM, Ms. Nidhi Raman, Id. Counsel submits that the Petitioner has followed up till March, 2022 and, hence, ought to have been aware that the request for examination has been filed and the next step would have been to file the FER. In fact the FER is available on the internet and the website could have been checked by the Petitioner. So the decision in the *European Union represented by European Commission (supra)*, could not apply for the Petitioner.

### ANALYSIS

9. The Court has considered the matter. The chronology of events in this case would show that the situation is quite unfortunate. The firm-Delhi Intellectual Property LLP has clearly not shown diligence in communicating the issuance of the First Examination Report ('FER') to the Petitioner after the filing of the Request for Examination ('RFE'). The Petitioner was also not informed that the Reply to the FER is to be filed. The matter appears to have been followed up till the RFE, however, after the FER is issued for some reason, the firm and the Patent Agent- Mr. Chaklan did not inform the issuance of the FER to the Petitioner. There is not even a shred of evidence on record to show at any point that the same was informed to the Petitioner. It is unusual that till February, 2022 there has been continuous email correspondence, however, thereafter, there is complete silence. Repeated emails of the Petitioner have gone un-replied and the reason for the same is not forthcoming from the Patent Agent, despite repeated queries. The only submission of the Patent Agent is that there were two telephonic conversations.



10. An FER by its very nature is an extremely technical document which requires detailed discussion with the inventor and the client for preparation of a reply. It is incomprehensible as to how a discussion relating to the FER could have been conducted over one incoming call and one outgoing call in 57 seconds. An FER requires proper application of mind and reply to all the objections. Even if the Patent Agent had informed the client of issuance of the FER, there being no email forwarding of the same or informing next steps, leads to an adverse inference against the Patent Agent.

11. In the present case, the objections that have been raised are quite detailed as is evident from a perusal of the FER itself. There are objections as to novelty, inventive step and patentability *etc.*. Thus, the Patent Agent cannot escape responsibility by simply stating that he had discussed it in a telephonic conversation or has informed the Petitioner over a telephonic call. Prosecution of patents is a technical matter, which requires detailed discussion with clients as also inventors. Patent Agents are now the only persons who can prosecute patents before the patent office and have enormous responsibility on their shoulders to ensure that valuable innovations are properly protected as per the procedures prescribed in law. The record reveals that the emails have been sent continuously by the Applicant and hence the Petitioner himself has been quite diligent.

12. A patent application is a valuable asset for an individual inventor such as the Petitioner. The availability of access to the IP office website cannot be a ground which can be taken, inasmuch as, most inventors and clients may not have the resources to access the IP office website and the technical expertise to understand the same. It is for this reason that Patent Agents are engaged by inventors and applicants. The mere fact that the FER would be



uploaded on the website may not be sufficient to hold that the Petitioner had notice of the FER. The Petitioner at the earliest possible time *i.e.*, between December, 2022 and January, 2023 has taken steps to try and apply for revival of the patent application.

13. ***The European Union Represented by the European Commission v. Union of India & Ors., 2022:DHC:2301*** is a similar case as the present one wherein even after continuous follow ups by the Applicant with the Patent Agent about the status of the patent application during the prescribed period, the Patent Agent did not give any response. As a result, the patent application was treated as '*deemed to have been abandoned*' under section 21(1) of the Patents Act, 1970. The Court observed therein that Courts exercising writ jurisdiction ought to be liberal in cases where the mistake is on behalf of the Patent Agent. Any mistakes committed on behalf of the Patent Agents should be treated in a similar manner as that of counsels/advocates. The relevant portion of the judgment has been extracted herein below:

*“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 & Ors. v. Director of Land Records 1984 Supp. SCC 431; Rafiq & Anr 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 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.

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.**



63. There is yet another recent development which the Court notices. The 161st report submitted by the Department Related Parliamentary Standing Committee on Commerce on 23rd July, 2021, titled 'Review of the Intellectual Property Rights Regime in India' has taken note of the enormous prejudice being caused to patent applicants due to 'deemed abandonment' provisions. **The Committee has opined that the abandoning of patents would de-moralize or discourage patentees in India.** The observations of the Committee is set out below:

“vi. It was highlighted that the inflexibilities in Patent Act does not leave any room for errors thereby affecting the filing of patents. It was informed that in countries like US any delay in filing of patents could be condoned with an appropriate petition, fees, timely hearing and disposal. However, in India, once a due date has elapsed for filing request for examination report or a complete specification after a provisional one, there exist no remedy. Hence, as per Section 21(1) of the Patent Act, 1970, an application for a patent shall be deemed to have been abandoned unless the applicant has complied with all the requirements imposed on him by or under this Act within such period as may be prescribed. This inflexibility affects number of patents filed. The Committee opines that the abandoning of patents, without allowing hearing or petition, may demoralize and discourage patentees in the country to file patents. It recommends the Department that certain flexibility should be incorporated in the Act to make for allowance of minor errors and lapses to prevent outright rejection of patents being filed. Hence, a revised petition with penalty or fee may be permitted under the Act for minor or bona fide mistakes that had been committed in the filed patents.”



14. The Court in *The European Union Represented by the European Commission*(*supra*) further observed that the time lines may be mandatory in nature but the same can be considered by the High Court while exercising writ jurisdiction in the following terms:

*“52. From a reading of the aforementioned decisions, insofar as the time period for filing of request for examination is concerned, the decision in Carlos Alberto Perez Lafuente (*supra*) of the Division Bench of this Court has categorically held that the time period is mandatory and cannot be extended even in the facts of a case where the patent agent is found to be negligent. However, this Court notes that in the case of response to the FER is concerned, in Ferid Allani (*supra*), Telefonaktiebolaget Ericsson W.P.(C)-IPD 5/2022 & 6/2022 2022:DHC:2301 (*supra*), and PNB Vesper Life Sciences (*supra*) High Courts while exercising writ jurisdiction have granted extension in filing of the response to the FER including on the ground that the applicant did not have the intention to abandon. In such extraordinary situations, the Court has exercised its writ jurisdiction to ensure that valuable statutory rights of the Applicant are not completely deprived of. Thus, before arriving at a conclusion that an Applicant has abandoned its application, due to non-filing of Reply to the FER/first statement of objections, while the Controller may have no power to extend the deadline within which the application has to be put in order for grant, courts exercising writ jurisdiction, may in rare cases permit the same, after examining the factual matrix to see as to whether the Applicant in fact intended to abandon the patent or not. Any extraordinary circumstances could also be considered by the Court, such as negligence by the patent agent, docketing error and whether the*



**Applicant has been diligent. However, lack of follow-up by the Applicant would be a circumstance which may lead to an inference that the applicant intended to abandon the patent. Thus, the court would have to examine the circumstances in the peculiar facts of each case.”**

15. This position has been further reaffirmed in *Bry-Air Prokon Sagl & Ors. v. Union of India & Anr.*, 2022/DHC/4439 and in *W.P. Nos.12620 & 12621 of 2021* titled *Chandra Sekar v. The Controller of Patents and Designs & Anr.*. In the case of *Bry-Air Prokon Sagl & Ors. (supra)* the Court observed that the Petitioners should not suffer for the fault or negligence committed on behalf of the Patent Agent when they have duly followed up with the Patent Agent and there is correspondence to that effect. The relevant portion of the said judgement is extracted below:

**“23. It is a settled position of law that errors/negligence on part of the patent agent without any contributory negligence on the part of the Applicant, has been liberally considered by the Courts, as the consequences of a patent application being abandoned or the lapsing of a patent due to non-deposit of renewal fee are very serious, where the applicant loses his right of claiming exclusivity to an invention.**

24. A caveat may, however, be added that the Court must exercise the writ jurisdiction only in extraordinary circumstances. In *European Union Represented by the European Commission (Supra)*, the Court has rightly cautioned that the intention of the Legislature in Rule 138 of the Rules as well as the mandate in Section 21(1) of the Act cannot be ignored and failure to adhere to the timelines must be visited with serious consequences. **In the facts and circumstances of the present case, this Court is of the**



**view that there is no fault or negligence on the part of the Petitioners and therefore, they should not suffer for the fault or negligence of the Patent Agent, and the present case fits into the exception of 'extraordinary circumstances'. Petitioners are thus entitled to file a response to the FERs with respect to the six patent applications so that they can be processed further.**

26. Relevant would it be to note that In European Union Represented by the European Commission (Supra), patent applications were restored by the Court on account of the negligence of the Agent which coincidentally happens to be the same agent as in this Court and as rightly pointed by the Petitioners in the said case albeit in the case of the patent applications, the writ petition was allowed extending periods of 40 months and 38 months respectively, in respect of two patent applications. **In PNB Vesper Life Science Pvt. Ltd., Represented by its Director Mr. P.N. Balaram v. Controller General of Patents, Designs & Trademarks, 2022 SCC OnLine Mad 3190, it was held that if there is nothing on record which indicates that Petitioner has willfully neglected, benefit of doubt must be given and this is an embodiment of a fact which cannot be gleaned over that valuable rights vest in a patentee on grant of a patent and therefore, if the Applicant is not at fault, he should not be deprived of his rights to enjoy the fruits of his skill, hard work and labour.**”

16. Moreover, where legal professionals are at fault, the Court has observed that in such cases the parties ought not to suffer the consequences of their Advocates. Considering that the parties have done everything within their limits and they may not even have the requisite resources to follow up their cases, sans the Advocate or Patent Agent. In ***Rafiq and Another v. Munshilal and Another, (1981) 2 SCC 788***, the Court observed that a party



should not suffer for the inaction, deliberate omission, or misdemeanour of his Agent. The relevant portion of the said judgment is set out below:

*“3. The disturbing feature of the case is that under our present adversary legal system where the parties generally appear through their advocates, the obligation of the parties is to select his advocate, brief him, pay the fees demanded by him and then trust the learned Advocate to do the rest of the things. The party may be a villager or may belong to a rural area and may have no knowledge of the court's procedure. After engaging a lawyer, the party may remain supremely confident that the lawyer will look after his interest. At the time of the hearing of the appeal, the personal appearance of the party is not only not required but hardly useful. Therefore, the party having done everything in his power to effectively participate in the proceedings can rest assured that he has neither to go to the High Court to inquire as to what is happening in the High Court with regard to his appeal nor is he to act as a watchdog of the advocate that the latter appears in the matter when it is listed. It is no part of his job. Mr A.K. Sanghi stated that a practice has grown up in the High Court of Allahabad amongst the lawyers that they remain absent when they do not like a particular Bench. Maybe, we do not know, he is better informed in this matter. Ignorance in this behalf is our bliss. **Even if we do not put our seal of imprimatur on the alleged practice by dismissing this matter which may discourage such a tendency,** would it not bring justice delivery system into disrepute. What is the fault of the party who having done everything in his power expected of him would suffer because of the default of his advocate. If we reject this appeal, as Mr A.K. Sanghi invited us to do, the only one who would suffer would not be the lawyer who did not appear but the party whose interest he represented. The problem that agitates us is whether it is proper that the party should*



*suffer for the inaction, deliberate omission, or misdemeanour of his agent. The answer obviously is in the negative. Maybe that the learned Advocate absented himself deliberately or intentionally. We have no material for ascertaining that aspect of the matter. We say nothing more on that aspect of the matter. However, we cannot be a party to an innocent party suffering injustice merely because his chosen advocate defaulted. Therefore, we allow this appeal, set aside the order of the High Court both dismissing the appeal and refusing to recall that order. We direct that the appeal be restored to its original number in the High Court and be disposed of according to law. If there is a stay of dispossession it will continue till the disposal of the matter by the High Court. There remains the question as to who shall pay the costs of the respondent here. As we feel that the party is not responsible because he has done whatever was possible and was in his power to do, the costs amounting to Rs 200 should be recovered from the advocate who absented himself. The right to execute that order is reserved with the party represented by Mr A.K. Sanghi.”*

17. In the above case, the Supreme Court observed that even the costs ought to be recovered from the Advocate who was responsible. A reading of the above mentioned decisions would show that the facts of the present case also fall within the ambit of ‘extraordinary circumstances’ wherein the Petitioner has done his part and has duly followed up with the Patent Agent regarding the status of the patent application. Therefore, in such cases, the Court, while exercising writ jurisdiction, ought to be a little flexible while deciding whether condonation be given or not. In *European Union (supra)*, *Bry-Air Prokon Sagl & Ors.(supra)* and *Chandra Sekar v. The Controller of Patents and Designs & Anr*, the Court has directed the Office of



CGPDTM to take the response to the FER on record and the applications be restored to their original position.

18. Under such circumstances, this Court is inclined to hold that the filing of the revival request on 28th January, 2023, ought to be entertained by the Patent Office within the extended period of three months. Accordingly, the abandonment order is set aside and reflection of the same shall be made on the website by the Office of CGPDTM within a period of two weeks from now. The Patent Office shall accept the physical/online reply to the FER which shall be filed within four weeks after the reflection of the said abandonment order on the website and, thereafter, proceed with the patent application of the Petitioner in accordance with law.

**Role of Patent Agents and Regulation of their conduct:**

19. The directions given above are in the context of revival of the patent application, only insofar as the Petitioner is concerned. However, the matter would not end here, as it is noticed by the Court on many occasions, that there is lack of diligence by Patent Agents which is resulting in valuable patent applications being abandoned or lapsed. Such dereliction by Patent Agents is noticed at various stages of the patent application including, *inter alia*, –

- i. Non-filing of request for examination within the prescribed period;
- ii. Non-communication of issuance of FER to the client/applicant;
- iii. Non-filing of reply to the FER and further follow-up;
- iv. Non-communication of hearing notice(s) issued by the Controller





- v. Failure to file written submissions, within the requisite period, after hearing before the Controller
  - vi. Non- communication of notice of pre/post-grant opposition
  - vii. Failure to respond to pre/post-grant opposition within the timelines prescribed
  - viii. Non- communication of notice of revocation of patent application
  - ix. Failure to respond to notice of revocation of patent application within the timelines prescribed
  - x. Failure to file information about corresponding patent applications in other jurisdictions as per section 8 of the Patents Act, 1970
  - xi. Non filing of working statement(s) under Form 27 in terms of the period prescribed under Patent Rules, 2003
  - xii. Failure to submit annuities for renewal of the patent.
20. Such lack of diligence which could either be due to simple negligence, accident, or incorrect logging of dates in a database *etc.* may trigger the mandatory provisions of the Act, thereby resulting in abandonment of the application itself, without further scope for revival. It is only in rare circumstances that in a writ petition, while exercising extraordinary jurisdiction, High Courts may permit revival.
21. Patent Agents have an important function in the system of granting patents. Prior to the amendments in 2003, advocates could register themselves as Patent Agents even without any qualifications in scientific or technical subjects. However, the framework for Patent Agents has undergone a substantial change since 2003. In order to qualify as a Patent



Agent, it is compulsory for a candidate to hold a qualification in any science subject. In addition, candidates have to undertake an examination which tests their knowledge of the Act, Rules, patent prosecution procedures etc. The examination consists of a written test and an interview. Candidates are even made to draft a patent specification, in the said test. Thus, stringent thresholds, have been set for any person to qualify as a Patent Agent.

22. Patent Agents, after being granted registration, are entitled to draft, file and prosecute patent applications on behalf of their clients. As part of this process, Patent Agents may receive information which is extremely confidential in nature for a business or applicant, as the agent could be contacted even when the invention is under conception and development. At that stage, the Patent Agent has to duly advise the client on the maintenance of records. The Agent has to maintain utmost confidentiality and preserve the trust of the client/applicant. Prior art search may be required to be conducted. The drafting of the patent specification, bearing in mind the state of the art, prior art and the invention of the client is an art which involves expertise – both technical and legal, on the part of the Patent Agent.

23. The filing of the patent application has to be properly timed in accordance with the needs of the client. Some clients may want to seek funding after filing of an application. Other clients may be timing the commercial launch of the product. Thus, the Patent Agent's role goes hand-in-hand with the inventor/applicant. Even after filing of the application, considering that most procedures take place online, the Patent Agent will require to maintain constant vigil and periodically check the website of the IPO to ensure that all procedural formalities are completed, if any objections are raised. The stage of issuance of the FER and the reply thereto is also



extremely crucial. Considering the expanse of the duties and functions of Patent Agents, any carelessness, professional negligence or misconduct, unless accidental or inadvertent, deserves to be dealt with in a stringent manner. Some of the provisions of the Acts and Rules dealing with Patent Agents are as under:

***Statutory regime for patent agents under the Patents Act, 1970***

24. Patent Agents are defined under Section 2(1)(n) as under:

*“2(1)(n) "patent agent" means a person for the time being registered under this Act as a patent agent;”*

Chapter 21 of the Act is dedicated to Patent Agents. Under Section 125, a register of Patent Agents is maintained by the Controller General which contains the particulars of all Patent Agents who are qualified. The qualification of Patent Agents are also prescribed in Section 126 as under:

***“126. Qualifications for registration as patent agents.—(1) A person shall be qualified to have his name entered in the register of patent agents if he fulfills the following conditions, namely:—***

*(a) he is a citizen of India;*

*(b) he has completed the age of 21 years;*

*(c) he has obtained a degree in science, engineering or technology from any university established under law for the time being in force in the territory of India or possesses such other equivalent qualifications as the Central Government may specify in this behalf, and, in addition,—*

*(i) [Omitted by the Patents (Amendment) Act, 2005]*

*(ii) has passed the qualifying examination prescribed for the purpose; or*

*(iii) has, for a total period of not less than ten years, functioned either as an examiner or discharged the functions of the Controller under section 73 or both,*



*but ceased to hold any such capacity at the time of making the application for registration;*

*(d) he has paid such fee as may be prescribed.*

*(2) Notwithstanding anything contained in sub-section (1), a person who has been registered as a patent agent before the commencement of the Patents (Amendment) Act, 2005 shall be entitled to continue to be, or when required to be re-registered, as a patent agent, on payment of the fees as may be prescribed.”*

25. Previously any degree from the University was sufficient, which was amended with effect from 20<sup>th</sup> May, 2003. However, a perusal of the extant provisions would show that a degree in science, engineering and technology is a mandatory condition for being eligible to be a Patent Agent. In addition, a qualifying examination has to be passed. Any person who was either an ex-controller or an ex-examiner for a total period of not less than 10 years is also qualified to be a Patent Agent.

26. Patent Agents have the right to practice before the patent office and prepare all documents and discharge functions as prescribed as per Section 127 of the Act. All documents and communications to the patent office may be signed by Patent Agents who are authorized by the client. Under the Rules presently, a Patent Agent can only enter into a partnership with another Patent Agent. Practicing as a Patent Agent includes the right to apply for patents in India or abroad, prepare specifications and advising clients on scientific and technical aspects relating to validity or infringement. Section 130 contemplates that the name of a Patent Agent can be removed by the Controller in the following circumstances:

- i. If the name is entered in the register by error or if the name has been entered by resorting to misrepresentation or suppression.



- ii. If the agent has been convicted of any offence or has been held guilty of misconduct in a professional capacity which renders him unfit.
- iii. The Controller also has the power to restore the name of the Patent Agent on sufficient cause.

27. A perusal of the above provisions shows that the Act does not define as to what constitutes misconduct for Patent Agents in professional capacity. Section 132 makes it clear that, though, Patent Agents can file and prosecute patents this would not bar applicants on their own from drafting and filing specifications, appearing or acting before the patent office. Advocates who are not Patent Agents can only take part in a hearing before the Controller, thus, in effect Patent Agents have an exclusivity in addition to the inventor or applicant in drafting, filing, prosecuting patent applications.

28. For the present purposes, however, it would be relevant to note that the name of a Patent Agent can be removed if the Patent Agent is guilty of misconduct in his professional capacity. Such a disqualification also exists in Rule 114 of the Patents Rules 2003 which reads as under:

***“114. Disqualifications for registration as a patent agent.—A person shall not be eligible to be registered as a patent agent, if he—***

*(i) has been adjudged by a competent court to be of unsound mind;*

*(ii) is an undischarged insolvent;*

*(iii) being a discharged insolvent, has not obtained from the court a certificate to the effect that his insolvency was caused by misfortune without any misconduct on his part;*

*(iv) has been convicted by a competent court, whether within or outside India of an offence to undergo a term of imprisonment, unless the offence of which he has*



*been convicted has been pardoned or unless on an application made by him, the Central Government has, by order in this behalf, removed the disability;*

*(v) **being a legal practitioner has been guilty of professional misconduct; or***

*(vi) being a chartered accountant, has been guilty of negligence or misconduct.”*

29. It is, therefore, relevant to note that the Controller is empowered both under the Patent Act and Patent Rules to remove the name of the Patent Agent if it is found that the Agent is guilty of professional misconduct. As can be seen from above there are no Rules of Conduct for Patent Agents. This term being not been defined either under the Patent Act or the Patent Rules, the said term would need to be defined and a proper framework would have to be put in place for dealing with professional misconduct by Patent Agents.

30. In order to understand what constitutes professional misconduct, guidance can be taken from the framework that exists for other professionals such as Advocates, Chartered Accountants, *etc.*

### **Advocates**

31. Insofar as the advocates are concerned, a person with a law degree who enrolls with the Bar Council of India is called an advocate under the Advocates Act, 1961. Under Section 35 in Chapter V, professional or other misconduct can result in, reprimand of the advocate, suspension of the advocate from practice and also removal of the advocate from state rolls. The disciplinary powers are vested with the concerned State Bar Council. The relevant sections of the Advocates Act, 1961, are set out below:



*“35. Punishment of advocates for misconduct.—(1) Where on receipt of a complaint or otherwise a State Bar Council has reason to believe that any advocate on its roll has been guilty of professional or other misconduct, it shall refer the case for disposal to its disciplinary committee.*

*3 [(1A) The State Bar Council may, either of its own motion or on application made to it by any person interested, withdraw a proceeding pending before its disciplinary committee and direct the inquiry to be made by any other disciplinary committee of that State Bar Council.]*

*(2) The disciplinary committee of a State Bar Council \*\*\* shall fix a date for the hearing of the case and shall cause a notice thereof to be given to the advocate concerned and to the Advocate-General of the State.*

*(3) The disciplinary committee of a State Bar Council after giving the advocate concerned and the Advocate-General an opportunity of being heard, may make any of the following orders, namely:— (a) dismiss the complaint or, where the proceedings were initiated at the instance of the State Bar Council, direct that the proceedings be filed; (b) reprimand the advocate; (c) suspend the advocate from practice for such period as it may deem fit; (d) remove the name of the advocate from the State roll of advocates.*

*(4) Where an advocate is suspended from practice under clause (c) of sub-section (3), he shall, during the period of suspension, be debarred from practising in any court or before any authority or person in India.*

*(5) Where any notice is issued to the Advocate-General under sub-section (2), the Advocate-General may appear before the disciplinary committee of the State Bar Council either in person or through any advocate appearing on his behalf.*

*5 [Explanation.—In this section, 3 [section 37 and section 38], the expressions “Advocate-General” and “Advocate-General of the State” shall, in relation to*



*the Union territory of Delhi, mean the Additional Solicitor General of India.]*

*36. Disciplinary powers of Bar Council of India.—(1) Where on receipt of a complaint or otherwise the Bar Council of India has reason to believe that any advocate 6 \*\*\* whose name is not entered on any State roll has been guilty of professional or other misconduct, it shall refer the case for disposal to its disciplinary committee.*

*(2) Notwithstanding anything contained in this Chapter, the disciplinary committee of the Bar Council of India may, 7 [either of its own motion or on a report by any State Bar Council or on an application made to it by any person interested], withdraw for inquiry before itself any proceedings for disciplinary action against any advocate pending before the disciplinary committee of any State Bar Council and dispose of the same.*

*(3) The disciplinary committee of the Bar Council of India, in disposing of any case under this section, shall observe, so far as may be, the procedure laid down in section 35, the references to the Advocate-General in that section being construed as references to the Attorney-General of India.*

*(4) In disposing of any proceedings under this section the disciplinary committee of the Bar Council of India may make any order which the disciplinary committee of a State Bar Council can make under sub-section (3) of section 35, and where any proceedings have been withdrawn for inquiry 1 [before the disciplinary committee of the Bar Council of India], the State Bar Council concerned shall give effect to any such order.”*

32. Advocates Act, 1961 also provides Appellate remedies which are vested with the Bar Council of India under Section 37 and thereafter with Supreme Court under Section 38. A perusal of the above section 35 would also show that the Advocates Act, 1961 provides with the mechanism of





filing complaints, punishments but does not define what professional and other types of misconducts are. However, an effort has been made by Courts to define the same through various precedents after analysing multifarious unprofessional behaviour committed by Advocates.

33. The Bar Council of India Rules provides in Part VI Chapter II, the standards of professional conduct and etiquettes for advocates. The same is broadly categorized in the following Sections:

- i. Section I- Duty to the Court.
- ii. Section II-Duty to the Client.
- iii. Section III-Duty to Opponent.
- iv. Section IV-Duty to Colleagues.
- v. Section V-Duty in imparting training.
- vi. Section VI-Duty to render legal aid.
- vii. Section VIII- Restriction on other employments
- viii. Duty towards society and bar.
- ix. Code of conduct and disqualification.

34. Failure to adhere to the aforementioned etiquettes and standards of professional conduct will constitute misconduct on the part of the Advocates. The Bar Council of India Rules prescribe in detail the manner in which Advocates conduct themselves and if any person has a complaint against the Advocates conduct, such a complaint can be lodged with the State Bar Council and the same would be proceeded with, in accordance with the provisions of the Act. Similar punishments ought to be introduced with respect to the trademark/patent agents. However, no such mechanism or framework exists in respect of Patent Agents who perform crucial functions in the innovation ecosystem.



35. In the context of Advocates, professional misconduct has been dealt with in various decisions of the Supreme Court. In *Noratanmal Chouraria v. M.R. Murli and Another*, (2004) 5 SCC 689, the Court made an effort to determine quantum of punishment and define ‘Misconduct’ in the context of Advocates, which constitute wrongful omission or commission of an act whether done or omitted either intentionally or unintentionally. The relevant portion of the said judgement has been set out below :

**“Misconduct**

*7. Misconduct has not been defined in the Advocates Act, 1961. Misconduct, inter alia, envisages breach of discipline, although it would not be possible to lay down exhaustively as to what would constitute conduct and indiscipline, which, however, is wide enough to include wrongful omission or commission whether done or omitted to be done intentionally or unintentionally. It means, “improper behaviour, intentional wrongdoing or deliberate violation of a rule or standard of behaviour”.*

*8. Misconduct is said to be a transgression of some established and definite rule of action, where no discretion is left except what necessity may demand; it is a violation of definite law.*

*9. In Delhi Cloth & General Mills Co. Ltd. v. Workmen [(1969) 2 LLJ 755 : AIR 1970 SC 919 (SC)] Shah, J. stated that misconduct spreads over a wide and hazy spectrum of industrial activity; the most seriously subversive conducts rendering an employee wholly unfit for employment to mere technical default covered thereby.*

*10. This Court in State of Punjab v. Ram Singh, Ex-Constable [(1992) 4 SCC 54 : 1992 SCC (L&S) 793 : (1992) 21 ATC 435] noticed: (SCC pp. 57-58, paras 5-6)*



“5. Misconduct has been defined in Black's Law Dictionary, 6th Edn. at p. 999 thus:

‘A transgression of some established and definite rule of action, a forbidden act, a dereliction from duty, unlawful behaviour, wilful in character, improper or wrong behaviour, its synonyms are misdemeanour, misdeed, misbehaviour, delinquency, impropriety, mismanagement, offence, but not negligence or carelessness.’

Misconduct in office has been defined as:

‘Any unlawful behaviour by a public officer in relation to the duties of his office, wilful in character. Term embraces acts which the office-holder had no right to perform, acts performed improperly, and failure to act in the face of an affirmative duty to act.’

Aiyar, P. Ramanatha: Law Lexicon, Reprint Edn., 1987, at p. 821 defines ‘misconduct’ thus:

‘The term misconduct implies a wrongful intention, and not a mere error of judgment. Misconduct is not necessarily the same thing as conduct involving moral turpitude. The word misconduct is a relative term, and has to be construed with reference to the subject-matter and the context wherein the term occurs, having regard to the scope of the Act or statute which is being construed. Misconduct literally means wrong conduct or improper conduct. In usual parlance, misconduct means a transgression of some established and definite rule of action, where no discretion is left, except what necessity may demand and carelessness, negligence and unskilfulness are transgressions of some established, but indefinite, rule of action, where some discretion is necessarily left to the actor. Misconduct is a violation of definite law; carelessness or abuse of discretion under an



*indefinite law. Misconduct is a forbidden act; carelessness, a forbidden quality of an act, and is necessarily indefinite. Misconduct in office may be defined as unlawful behaviour or neglect by a public officer, by which the rights of a party have been affected.'*

6. Thus it could be seen that **the word 'misconduct' though not capable of precise definition, on reflection receives its connotation from the context, the delinquency in its performance and its effect on the discipline and the nature of the duty. It may involve moral turpitude, it must be improper or wrong behaviour; unlawful behaviour, wilful in character; forbidden act, a transgression of established and definite rule of action or code of conduct but not mere error of judgment, carelessness or negligence in performance of the duty; the act complained of bears forbidden quality or character. Its ambit has to be construed with reference to the subject-matter and the context wherein the term occurs, regard being had to the scope of the statute and the public purpose it seeks to serve. The police service is a disciplined service and it requires to maintain strict discipline. Laxity in this behalf erodes discipline in the service causing serious effect in the maintenance of law and order.**

(See also *Probodh Kumar Bhowmick v. University of Calcutta* [(1994) 2 Cal LJ 456] and *B.C. Chaturvedi v. Union of India* [(1995) 6 SCC 749 : 1996 SCC (L&S) 80 : (1996) 32 ATC 44] .)

11. Section 35 of the Advocates Act, however, refers to imposition of punishment for professional or other misconduct. **A member of the legal profession which is a noble one is expected to maintain a standard in a dignified and determined manner. The standard required to be maintained by the member of the legal**



**profession must be commensurate with the nobility thereof.** A lawyer is obligated to observe those norms which make him worthy of the confidence of the community in him as an officer of the court. This Court in *Bar Council of Maharashtra v. M.V. Dabholkar* [(1976) 2 SCC 291 : AIR 1976 SC 242] observed: (SCC p. 300, para 20)

“The high moral tone and the considerable public service the Bar is associated with and its key role in the developmental and dispute-processing activities and, above all, in the building up of a just society and constitutional order, has earned for it a monopoly to practise law and an autonomy to regulate its own internal discipline.”

**12. Although the power of the Bar Council is not limited, the thrust of charge must be such which would necessitate initiation of disciplinary proceedings. A professional or other misconduct committed by a member of the profession should ordinarily be judged qua profession. To determine the quantum of punishment which may be imposed on an advocate, the test of proportionality shall be applied which would also depend upon the nature of the acts complained of. No universal rule thus can be laid down as regards initiation of a proceeding for misconduct of a member of the profession.**”

36. The Court in *Noratanmal Chouraria (supra)* observed that a member of the legal profession should maintain professional standards in a dignified manner and they should abide by the norms which makes the community think that they are worthy of confidence.



### Chartered Accountants

37. Chartered Accountants Act, 1949 also prescribes the scope of professional misconduct in relation to Chartered Accountants in the Second Schedule to the Act. The same is divided into three different parts:

PART I: Professional misconduct in relation to chartered accountants in practice.

PART II: Professional misconduct in relation to members of the Institute generally.

PART III: Other misconduct in relation to members of the Institute generally.

38. If there is any complaint against a Chartered Accountant the Institutes of Chartered Accountant of India is the body which oversees Chartered Accountants which has a Disciplinary Directorate, a Board of Discipline, a Disciplinary Committee and finally the Council. Section 22 seeks to define professional or other misconduct as under:

### Amended

*“22. Professional or other misconduct defined For the purposes of this Act, the expression “professional or other misconduct” shall be deemed to include any act or omission provided in any of the Schedules, but nothing in this Section shall be construed to limit or abridge in any way the power conferred or duty cast on the Director (Discipline) under sub-section (1) of Section 21 to inquire into the conduct of any member of the Institute under any other circumstances.”*

### Unamended

*“22. Professional misconduct defined For the purposes of this Act, the expression “professional misconduct” shall be deemed to include any act or omission provided in any of the Schedules, but nothing*



*in this Section shall be construed to limit or abridge in any way the power conferred or duty cast on the Council under sub-section (1) of Section 21 to inquire into the conduct of any member of the Institute under any other circumstances.”*

39. This read with Schedule II of the Chartered Accountants Act lays down clear guidance as to what constitute misconduct by Chartered Accountants and a proper system has been put in place for dealing with any misconduct.

**Professional Misconduct in the context of Patent Agents**

40. The Patent Act and the Rules do not define professional misconduct. In fact, Patent Agents are conferred a number of privileges apart from appearing before the patent office and filing patent applications. The Delhi High Court IP Division Rules, 2022 for example, recognize that Trademark and Patent Agents can appear before the Court for assisting the Court. Rule 34 of the IP Division Rules read as under:

***“34. Patents/Trade Mark Agents***

*Before the IPD, Agents who are registered as Patent agents or Trade Mark agents, as also any professional/academician having knowledge of the said subject matter of the dispute shall have a right of audience, when permitted by the Court, to appear along with the counsels/legal practitioners representing the parties to assist the Court.”*

41. Thus, Patent Agents wherever permitted have also been given the right of audience before Courts. Patent Agents need not have a law degree and may not even be enrolled with the Bar Council, thus, any misconduct by Patent Agents cannot be subjected to any disciplinary action under the Advocates Act, 1961 or Bar Council of India Rules.



42. Patent Agents are granted registration only by the Controller General of CGPDTM. The only authority which can, therefore, regulate the conduct of Patent Agents is the office of the CGPDTM which is the administrative head of IP office. There is no prescribed procedure for dealing with misconduct by Patent Agents.

43. Section 114 under Chapter XV of the Patents Rules, 2003, mentions about circumstances where the Patent Agents can be disqualified. However, no specific definition has been given as to what all acts will constitute “misconduct” and “negligence” on behalf of the Patents Agents. Moreover the definition needs to be given a broader ambit with the evolution of various types of unprofessional behaviour that agents are adopting by not accepting the liability of their acts, and the consequences of which are being dealt by their clients.

44. Similarly, under the Trademark Rules, 2017, section 151(2)(b) also provides that the Registrar can take action in case of negligence, misconduct or dishonesty committed in professional capacity of Trademark Agents. Overall, the responsibility of Trademark Agents and Patent Agents in protecting the intellectual property of applicants and individual inventors, individual trademark owners, brand owners *etc.*, is governed by the Trademarks Act 1999 and the Patent Act, 1970. There needs to be proper mechanism and framework that should be put in place for taking action against Trademark and Patent Agents. Rule 151 of the Trademark Rules, 2017 has been extracted below for a bare perusal:

***“151. Removal of agent's name from the register of Trade Marks agents.— (1) The Registrar shall remove from the register of trademarks agents the name of any registered trademarks agent-***





*(a) from whom' a request has been received to that effect; or*

*(b) from whom the annual fee has not been received on the expiry of three months from the date on which it became due.*

*(2) The Registrar shall remove from the register of trademarks agents, the name of any registered trademarks agent—*

*(a) who is found to have been subject at the time of his registration, or thereafter has become subject, to any of the disabilities stated in clauses (i) to(vii) of rule 145;or*

*(b) whom the Registrar has declared not to be a fit and proper person to remain in the Register by reason of any act of negligence, misconduct or dishonesty committed in his professional capacity;*

*(c) whose name has been entered in the register by an error or on account of misrepresentation or suppression of material fact:*

*Provided that before making such declaration under clauses (b) and (c) the Registrar shall call upon the person concerned to show-cause why his registration should not be cancelled and shall make such further enquiry, if any, as may be consider necessary.*

*(3) The Registrar shall remove from the register of trademarks agents the name of any registered trademarks agent who is dead.*

*(4) The removal of the name of any person from the register of trademarks agents shall be notified in the Journal and shall, wherever possible, be communicated to the person concerned.”*



45. In order to create a framework for regulating the conduct of Patent Agents it would, also be useful to look at certain other jurisdictions which regulate the conduct of such professionals.

### USPTO

46. As per the USPTO Rules of Professional Conduct (hereinafter referred as ‘USPTO Rules’) an Agent also falls within the ambit of the term Practitioner in the following terms:

*“Practitioner means:*

*(1) An attorney or agent registered to practice before the Office in patent matters under § 11.6;”*

47. As per 11.804 of USPTO Rules of Professional Conduct, Misconduct has been defined in the following terms:

*“It is professional misconduct for a practitioner to:*

*(a) Violate or attempt to violate the USPTO Rules of Professional Conduct, knowingly assist or induce another to do so, or do so through the acts of another;*

*(b) Commit a criminal act that reflects adversely on the practitioner's honesty, trustworthiness, or fitness as a practitioner in other respects, or be convicted of a crime that reflects adversely on the practitioner's honesty, trustworthiness, or fitness as a practitioner in other respects;*

*(c) Engage in conduct involving dishonesty, fraud, deceit or misrepresentation;*

*(d) Engage in conduct that is prejudicial to the administration of justice;*

*(e) State or imply an ability to influence improperly a government agency or official or to achieve results by*



*means that violate the USPTO Rules of Professional Conduct or other law;*

*(f) Knowingly assist a judge, hearing officer, administrative law judge, administrative patent judge, administrative trademark judge, or judicial officer in conduct that is a violation of applicable rules of judicial conduct or other law;*

*(g) Knowingly assist an officer or employee of the Office in conduct that is a violation of applicable rules of conduct or other law;*

*(h) Be publicly disciplined on ethical or professional misconduct grounds by any duly constituted authority of:*

*(1) A State,*

*(2) The United States, or*

*(3) A country having disciplinary jurisdiction over the practitioner; or*

*(i) Engage in other conduct that adversely reflects on the practitioner's fitness to practice before the Office.”*

48. As per Subpart D of USPTO Rules, Client- Practitioner Relationship has been explained and what are the duties of the Practitioner towards its Clients. The relevant rules have been extracted hereinbelow for a bare perusal:

*“Client-Practitioner Relationship*

*§ 11.101 Competence.*

*A practitioner shall provide competent representation to a client. Competent representation requires the legal, scientific, and technical knowledge, skill, thoroughness and preparation reasonably necessary for the representation.*



### § 11.102

*Scope of representation and allocation of authority between client and practitioner.*

*(a) Subject to paragraphs (c) and (d) of this section, a practitioner shall abide by a client's decisions concerning the objectives of representation and, as required by § 11.104, shall consult with the client as to the means by which they are to be pursued. A practitioner may take such action on behalf of the client as is impliedly authorized to carry out the representation. A practitioner shall abide by a client's decision whether to settle a matter.*

*(b) [Reserved]*

*(c) A practitioner may limit the scope of the representation if the limitation is reasonable under the circumstances and the client gives informed consent.*

*(d) A practitioner shall not counsel a client to engage, or assist a client, in conduct that the practitioner knows is criminal or fraudulent, but a practitioner may discuss the legal consequences of any proposed course of conduct with a client and may counsel or assist a client to make a good-faith effort to determine the validity, scope, meaning or application of the law.*

### § 11.103

*Diligence.*

***A practitioner shall act with reasonable diligence and promptness in representing a client.***

### § 11.104

*Communication.*

*(a) A practitioner shall:*

*(1) Promptly inform the client of any decision or circumstance with respect to which the client's informed consent is required by the USPTO Rules of Professional Conduct;*



(2) *Reasonably consult with the client about the means by which the client's objectives are to be accomplished;*

(3) *Keep the client reasonably informed about the status of the matter;*

(4) *Promptly comply with reasonable requests for information from the client; and*

(5) *Consult with the client about any relevant limitation on the practitioner's conduct when the practitioner knows that the client expects assistance not permitted by the USPTO Rules of Professional Conduct or other law.*

(b) *A practitioner shall explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation.”*

### **United Kingdom**

49. In the UK, Part V of the Copyright, Designs and Patents Act deal with Patent Agents and Trade Mark Agents. Section 276 of the Act, defines persons who are entitled to describe themselves as Patent Agents.

50. The Act *per se* does not define what all acts constitute misconduct, however it describes the procedure for dealing with such misconducts. It provides with cases wherein the Controller has power to refuse to deal with certain Agents who are found to be guilty on ground of misconduct as per Section 281. In furtherance to this there is The Register of Patent Agents Rules, 1990, which lays down the procedure followed in dealing with such cases of misconduct in the following manner:

#### **“Erasure of registration after due inquiry into misconduct**

*14. Where the Secretary of State is satisfied, after due inquiry in accordance with rule 15 below, that a*



*person has been guilty of misconduct, that is to say, conduct discreditable to a registered patent agent, he may at his discretion, having regard to the circumstances of the misconduct, direct that the name of that person be erased from the register, and he may further direct that the name shall remain erased during such period as he may specify; and upon a direction under this rule the Registrar shall erase the name and particulars of that person from the register accordingly.*

**Inquiry by Secretary of State**

*15.—(1) Where it appears to the Secretary of State under rule 10(3) or rule 14 above that a person may have been guilty of misconduct he shall serve on that person (hereinafter referred to as the person affected) a notice—*

*(a) informing him of the grounds on which it so appears to the Secretary of State and the substance of any allegations of misconduct made against him, and*

*(b) inviting him to submit to the Secretary of State, within such period (being not less than 21 days) as may be specified in the notice, his representations in writing and requiring him to serve notice, if he wishes, of his intention to make oral representations.*

*(2) A copy of the notice served on the person affected under paragraph (1) above and a copy of any written representations submitted by him to the Secretary of State shall be served by the Secretary of State on the Institute.*

*(3) Where the person affected has served notice under paragraph (1)(b) above of his intentions to make oral representations, the Secretary of State shall give him not less than 21 days notice, or such shorter notice as the person affected may request or consent to accept, of the date, time and place at which his representations will be heard.*



(4) If the Secretary of State considers that he should proceed with his inquiry but for a reason which differs or on grounds which differ from those set out in the notice served under paragraph (1) above he shall give a further notice under that paragraph.

### **Hearing of representations**

16.—(1) At the hearing of oral representations held pursuant to rule 15(3) above the Secretary of State shall, at the request of the person affected, permit any other person (in addition to the person affected) to make representations on his behalf or to give evidence or to introduce documents for him.

(2) The Secretary of State shall not refuse to admit evidence solely on the grounds that it would not be admissible in a court of law.

(3) The hearing may be adjourned at the discretion of the Secretary of State and if adjourned he shall give the person affected reasonable notice of the date, time and place at which the hearing is to be resumed.

(4) The Secretary of State shall inform the Institute of the date, time and place appointed for any hearing and the Institute shall be entitled to be represented at the hearing and to make submissions touching on the matters in issue.

### **Decision**

17. The Secretary of State shall, in deciding whether to issue a direction, take into account any written or oral representations made in accordance with rules 15 and 16 above and shall—

(a) if he decides not to issue a direction, give notice of that decision to the person affected, the Institute and, where the decision relates to any allegations of misconduct made by any person against the person affected, to that person (if known), but nothing in this



*rule shall require the Secretary of State to state the reasons for that decision;*

*(b)if he decides to issue a direction, give notice of his decision, the terms thereof and his reasons for the decision to the person affected, the Institute and, where the decision relates to any allegations of misconduct made by any person against the person affected, to that person (if known).”*

51. If a person feels aggrieved by the decision of the Secretary of State the aggrieved person can appeal to Comptroller against the decision of the Institute or Registrar within one month from the date of decision and the Comptroller shall therein give not less than 14 days’ notice to the Appellant and the Institute or the Registrar for hearing of the appeal. As per Rule 19, the Comptroller’s decision shall be final and backed up with proper reasoning. The relevant portion has been extracted below:

*“Appeal to Comptroller from decision of the Institute or Registrar*

*19.—(1) A person aggrieved by any decision of the Institute or the Registrar under these Rules may appeal to the Comptroller by serving on the Comptroller, within one month from the date of the decision, a notice of appeal, stating the grounds of appeal with a statement of his case in support thereof. A copy of the notice with a copy of the statement of case shall, at the same time, be served by that person (the appellant) on the Institute or the Registrar, as appropriate.*

*(2) The Comptroller shall, on receipt of the notice of appeal, give such directions as he thinks fit for the purpose of hearing the appeal and shall give the appellant and the Institute or the Registrar, as the case may be, not less than 14 days notice, or such shorter notice as the appellant and the Institute or Registrar*





*may consent to accept, of the date, time and place appointed for the hearing of the appeal.*

*(3) At the hearing the Comptroller shall, at the request of any party, permit any other person (in addition to that party) to appear on his behalf.*

*(4) The Comptroller shall give his decision on the appeal in writing with a statement of his reasons and shall serve a copy thereof on the appellant and the Institute or Registrar.*

*(5) The Comptroller's decision on the appeal shall be final and for the purposes of giving effect to it he may give such directions to the Institute or Registrar as he thinks fit."*

52. Thereafter Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons were made under Section 275 A of the Copyright Designs and Patents Act 1988 and under Section 83 A of the Legal Trade Marks Act, 1994. The said Rules give guidance with respect to the conduct of the Patent Agents/Attorneys with respect to following conducts:

- i. **Rule 5 – Integrity**- *Regulated persons shall at all times act with integrity putting their clients' interests foremost subject to the law and any overriding duty to any Court or Tribunal.*
- ii. **Rule 6 – Client Care and Service**- *Regulated persons shall carry out their professional work in a timely manner and with proper regard for standards of professional service and client care.*
- iii. **Rule 7 – Conflicts**- *A regulated person must not act where his interests conflict with those of a client or of a former client, or where he knows or has reasonable grounds for suspecting that the interests of any partner or regulated person or staff of his firm, conflict with those of a client or of a former client. Provided in all the circumstances it is reasonable to do so, a*



*regulated person may act for two or more clients, or for a client as against a former client, in relation to the same or a related matter in a situation of conflict, or possible conflict but only if all of the parties have given their informed consent in writing. Regardless of consent a regulated person must, however, refuse to act on behalf of conflicting or potentially conflicting parties in contentious matters, in circumstances where the regulated person's actions would not be seen to be neutral or where accepting instructions from both parties would risk a breach of Rule 5 or if Rule 8 cannot be observed.*

- iv. **Rule 8 – Confidentiality and Disclosure** *Regulated persons must keep the affairs of clients and former clients confidential except where disclosure is required and permitted by law or by the client or former client. Subject to this duty of client confidentiality and any circumstance where disclosure of information is prohibited by law, unless a client expressly agrees that no duty to disclose arises or a different standard of disclosure applies, a regulated person should disclose all relevant information of which he is aware to a client. Regulated persons must not put any client's confidential information at risk by acting, or continuing to act for another client where that information may be material, unless both clients provide informed consent and in all of the circumstances it is reasonable to do so.”*

### **Ireland**

53. In the Irish Patents Act, 1992, Part X specifically defines who all fall in the definition of Patent Agent, their qualifications, removal from register or suspension of registration of Patent Agents and rules relating thereto. The relevant provisions of the said act are hereinbelow:



105.—(1) Subject to rules under section 109 (2) or 114, whenever under this Act any act has to be done by or to any person in connection with a patent or any procedure relating to a patent or the obtaining thereof, the act may be done by or to an agent (in this Act referred to as a “patent agent”) of such person duly authorized in the prescribed manner.

(2) A person duly authorized by another person under subsection (1) to act as his patent agent may (subject to any provision to the contrary in any agreement between the patent agent and that person) on giving notice to the Controller and the other person, cease to act as patent agent for the other person.

xxxx

107.—(1) Any person who—

(a) resides in the State or in such other state as may be prescribed,

(b) has a place of business in the State,

(c) possesses the prescribed educational and professional qualifications, and

(d) complies with the prescribed conditions,

shall be eligible to be registered in the register and a partnership shall be so eligible if every partner thereof is registered in accordance with the provisions of this section and a person or partnership so eligible shall on application in the prescribed form and manner and on payment of the prescribed fee be so registered.

(2) Persons and partnerships whose names were entered in the register under the Act of 1964 immediately before the commencement of this Act shall be deemed to be registered in the register.

108.—(1) Any person registered in the register who applies to the Controller to be removed from the register may be removed by the Controller.

(2) Where, in the opinion of the Controller, a person registered in the register ceases to be eligible to be



**registered or has been guilty of conduct disgraceful to that person in his capacity as a patent agent the Controller may decide that the name of that person should be erased from the register or that during a period of specified duration registration of his name in the register should not have effect, but no such decision shall be made without giving that person an opportunity of being heard.**

(3) On making a decision under subsection (2), the Controller shall forthwith send by post to the person to whom the decision relates, at his address as stated in the register, a notice in writing stating the decision, the date thereof and the reason therefor.

(4) On giving notice to the Controller in the prescribed manner, a person to whom a decision under this section relates may, within the period of 21 days, beginning on the date of the decision, apply to the Court for cancellation of the decision and if he so applies—

(a) the Court, on hearing the application, may either—

(i) cancel the decision, or

(ii) declare that it was proper for the Controller to make a decision under this section in relation to such person and either (as the Court may consider proper) direct the Controller to erase his name from the register or direct that during a specified period (beginning not earlier than 7 days after the decision of the Court) registration of his name in the register shall not have effect.

(b) If at any time the Controller satisfies the Court that such person has delayed unduly in proceeding with the application, the Court shall, unless it sees good reason to the contrary, declare that it was proper for the Controller to make a decision under this section in relation to such person and either (as the Court may consider proper) direct the Controller to erase his



*name from the register or direct that during a specified period (beginning not earlier than 7 days after the decision of the Court) registration of his name in the register shall not have effect.*

*(5) The Controller shall not be awarded or be ordered to pay costs on an application under this section.*

*(6) Where a person to whom a decision of the Controller under this section relates does not, within the period of 21 days beginning on the date of the decision, apply to the Court for cancellation of the decision, the Controller may apply ex parte to the Court for confirmation of the decision and, if the Controller so applies, the Court on the hearing of the application shall, unless it sees good reason to the contrary, declare accordingly and either (as the Court may consider proper) direct the Controller to erase the name of such person from the register or direct that during a specified period (beginning not earlier than 7 days after the decision of the Court) registration of his name in the register shall not have effect.*

*(7) The decision of the Court on an application under this section shall be final, save that, by leave of the Court or the Supreme Court, an appeal, by the Controller or the person concerned, from the decision shall lie to the Supreme Court on a specified question of law.*

*(8) (a) On erasing the name of a person from the register the Controller shall forthwith send by pre-paid post to such person, at his address as stated in the register, notice in writing of the erasure.*

*(b) Where a direction is given under this section that during a specified period registration of the name of a person in the register shall not have effect, the Controller shall, before the commencement of that period, send by prepaid post to such person, at his address as stated in the register, notice in writing of such direction.*



*(9) The name of any person which has been erased from the register may at any time be restored to the register by direction of the Controller but not otherwise, and when a person's name is so restored to the register, the Controller may attach to the restoration such conditions (including the payment of a fee not exceeding the fee which would be payable by such person for registration if he was then being registered for the first time) as he thinks fit.*

*(10) Where the registration of a person in the register has ceased to have effect under this section for a period of specified duration, the Controller may, if he so thinks fit, on application made to him by such person, by direction terminate the suspension.*

*109.—(1) The Minister may make rules for the management of the register and may by such rules prescribe any matter or thing referred to in section 107 or 108 as prescribed, and in particular may so prescribe the educational and professional qualifications and the conditions (including conditions relating to nationality or citizenship) for eligibility for registration in the register, and the maximum fees which may be charged by any person registered in the register for such services in connection with the obtaining of patents as may be specified in such rules.*

*(2) Rules under this section may authorize the Controller to refuse to recognise as agent in respect of any business under this Act any person who does not satisfy the requirements of section 106 .*

*(3) Rules under this section may authorize the Controller to refuse to recognise as agent in respect of any business under this Act a company or firm of which any director or manager or any partner (as the case may be) is an individual whom the Controller could refuse to recognise as an agent.”*

54. A perusal of the above statutes, Rules and Codes shows that the conduct of Patent Agents and similar professionals is accorded enormous



significance and detailed provisions exist to regulate their conduct. A reading of these Rules help in understanding to some extent, the nature of relationship between patent applicants/ trade mark applicants and their clients.

### **Stand of the CGPDTM**

55. Insofar as the stand of the CGPDTM is concerned, an affidavit has been filed by Dr. Kumar Kartikey Yadav, Assistant Controller of Patent and Designs that under Section 131(2) of the Patent Act, 1970, if there is any misconduct in professional capacity action can be taken for removal of the name of such patent agent from the register. However, a perusal of the said affidavit makes it clear that there is no specific framework provided for the manner in which complaints can be entertained and the timelines within which action can be taken, if required. Section 131 of the Patents Act, 1970 merely describes situations wherein the Controller has power to refuse to deal with certain agents. The relevant section has been extracted below:

*“131. Power of Controller to refuse to deal with certain agents.—*

*(1) Subject to any rules made in this behalf, the Controller may refuse to recognise as agent in respect of any business under this Act—*

*(a) any individual whose name has been removed from, and not restored to, the register; (b) any person who has been convicted of an offence under section 123;*

*(c) any person, not being registered as a patent agent, who in the opinion of the Controller is engaged wholly in acting as agent in applying for patents in India or elsewhere in the name or for the benefit of the person by whom he is employed;*



*(d) any company or firm, if any person whom the Controller could refuse to recognise as agent in respect of any business under this Act, is acting as a director or manager of the company or is a partner in the firm.*

*(2) The Controller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in India.”*

56. A review of the applicable conduct for Advocates and Chartered Accountants as also review of rules that are being followed by some international IP offices would show that there is an imminent need for a proper system/ framework to be established for regulating the conduct of Patent Agents. Patent Agents owe different levels of duties –

- duties to their clients/applicants of patents;
- duties towards the IP office;
- duty to society in general; and
- duty to Courts if and when they appear and exercise the right of audience.

57. The Code of Conduct has to be separately prescribed for all four situations. Any breach of the Code of Conduct or any alleged misconduct could attract a complaint. A mechanism for filing of a complaint in the office of the CGPDTM has to be established. The manner in which the complaint has to be dealt with is also to be put in place. A Disciplinary Committee would have to be constituted for dealing with the complaints from which an appeal could also lie to the Controller General. The Disciplinary Committee ought to have members from the patent office and at least one patent agent/IP practitioner. The scope of misconduct has to be





defined towards all the concerned sections to which the Patent Agents caters to. Penalties and punishments have to be prescribed.

58. There is thus an urgent need for the following –

- For preparing and notifying a proper code of conduct for trade mark/  
Patent Agents;
- For providing a mechanism for lodging of a complaint against a trade  
mark/patent agent;
- For prescribing factors that would constitute misconduct;
- For setting out the manner in which the complaint is to be dealt with;
- For prescribing penalties that can be imposed.

59. Needless to add, in all such proceedings, principles of natural justice would have to be followed in cases involving misconduct. While examining these issues, the growth of the professionals, Patent Agents also needs to be borne in mind as more and more Patent Agents are required for providing services and for catering to growing demand. Such Patent Agents may have to work closely both with persons having scientific qualifications such as scientists, engineers, inventors as also lawyers, advocates and other professionals such as Chartered Accountants, Company Secretaries. Thus, the restrictions that are currently imposed, as to the persons with whom Patent Agents can enter into partnerships, may also have to be relooked. Most law firms dealing with intellectual property issues and even general practice law firms have lawyers who work under them in their IP departments. Such firms also employ Patent Agents. Individual Advocates and Patent Agents also come together to form partnerships to provide comprehensive IP services. These practical realities would also have to be borne in mind while dealing with regulation of the Patent Agents.



60. In the context of Patent Agents, misconduct could include:

**“the commission or omission of an act that constitutes a breach of ethical or professional obligations –**

- **wherein such behavior, whether intentional or negligent, contravenes established standards of practice.**
- **If the same causes harm to clients, diminishes their trust, compromises the patent agent’s integrity including failure to uphold the principles of honesty, morality, accountability, and professionalism.”**

### **Advertising**

61. Another area which required urgent attention is solicitation. While Patent Agents and Trademark Agents may be entitled to declare the kind of services they are offering, recent trend point towards misleading promotion on the part of companies, entities including IP professionals. This has been brought to the notice of the Court by the Intellectual Property Attorneys' Association (IPAA) who is represented by Mr. Lall, Senior Advocate, which has highlighted the following issues:

*“a) Rampant solicitation and advertising of services. Illustrative instances of messages forwarded by agents, advertising their services and / or soliciting clients, are annexed as ANNEXURE A.*

*b) Offering 100% results / success rates or money back guarantees while processing trade mark and patent applications.*

*c) Offering to obtain trade mark registrations in 1 day.*

*d) Violation of privacy rights as unsolicited calls are received by attorneys / clients, the mobile numbers and email ids of whom are provided for the purposes of filing and communication during the prosecution of the trade mark / patent applications.*

**TRADE MARKS AGENTS:**



a) S.145 of the TM Act recognizes a 'Trade Mark Agent' and permits any person to authorize inter alia a Trade Marks Agent to do such act on his behalf (other than making an affidavit) as is required to be done under different provisions of the TM Act and the Rules framed thereunder.

b) S. 157 of the TM Act, which is the Rule making provision, pertinently under S. 157(xxxvii), authorizes the Central Government to frame rules regarding the manner of authorizing any person to act and the manner of registration as a trade mark agent under S. 145.

c) Part IV, Rules 142-156 of the Trade Marks Rules, 2017 pertains to registration of trade marks agents. For the purpose of the present lis, reliance is placed on the following Rules:

(i) R. 143 pertains to registration of existing registered trade marks agents, code of conduct etc. R. 143(2) authorizes the Registrar to publish in the Journal a code of conduct for registered trade mark agents.

(ii) R. 144, which enumerates the qualifications for registration of trade mark agents, stipulates one of the qualifications as any person who is considered by the Registrar to be fit and proper.

(iii) R. 145 is concerning persons who are debarred from registration and R. 145(vii) specifically debars 'a registered trade mark agent who has been held guilty of professional misconduct by the Registrar'.

(iv) Pertinently, Rules 151(2)(a) and 151(2)(b) empower the Registrar to remove from the register of trade mark agents, the names of such agents, who:

- Falls in any of the categories of R.145; or
- Whom the Registrar has declared not to be fit and proper person by reason of any act of



negligence, misconduct or dishonesty committed in his professional capacity.

*Needless to add, the Rule mandates that prior to removing the name of a trade mark agent from the register under the aforesaid provisions, the said agent would be given an opportunity to show cause why his registration ought not to be cancelled.*

*(v) Lastly, R. 156 provides for an appeal provision against any decision of the Registrar made under Part IV of the Rules.*

*d) Thus, as is evident from the aforementioned Rules, the conduct of a trade marks agent, including but not limited to issues concerning professional misconduct, negligence etc. are governed under the relevant provisions of the TM Act, read along with the Rules framed thereunder.*

*e) However, while the statutory mandate to govern the conduct of trade mark agents is in place, what appear to be missing are the following:*

*(i) Rules stipulating the manner in which a trade mark agent ought to conduct himself / herself;*

*(ii) Rules identifying conduct which could amount to professional misconduct;*

*(iii) Rules providing the manner of filing complaints against registered trade mark agents with the Registrar and the process as well as timelines for resolving such disputes.*

*f) Thus, it is the IPAA's submission that the Registrar be directed to exercise powers under R. 143 of the Trade Marks Rules 2017 and draft a code of conduct encompassing the aforementioned lacunae and to publish the draft code of conduct and invite comments from stake holders, in a time bound manner.'*

**PATENT AGENTS:**

*h) Chapter XXI, Sections 125 to 132 of the Patents Act, 1970 ('Act'), are provisions relating to Patent Agents.*



*For the purposes of the present dispute, IPAA only wishes to place reliance on the following provisions which inter alia govern the conduct of the patent agents:*

*(i) S.130(1)(ii) of the Act empowers the Controller to remove the name of any person from the register, if such person has been convicted of any offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity which in the opinion of the Controller renders him unfit to be kept in the register.*

*i) Further, S. 159 of the Act, which is the Central Government's rule making power, pertinently under S. 159(xiv) authorizes the Central Government to frame rules about the manner in which the register of patent agents may be maintained under subsection (1) of section 125 and the safeguards to be observed in the maintenance of such register of patent agents on computer floppies, diskettes or any other electronic form under subsection (2) of that section; the conduct of qualifying examinations for patent agents; and matters connected with their practice and conduct, including the taking of disciplinary proceedings against patent agents for misconduct.*

*j) Lastly, Part XV, Rules 108 to 120 of the Patent Rules 2003 pertain to Patent Agents, and Rule 114 specifically provides grounds for disqualification for registration as a patent agent.*

*k) Thus, as is evident from the aforesaid provisions of the Act, read with the Rules framed thereunder, it is submitted that while the statutory framework to regulate the conduct of a patent agent, including but not limited to cases of professional misconduct, negligence etc. is present, the code of conduct / specific rules governing various aspects of operation of patent agents is not present.”*



62. It has also been highlighted by members of the IPAA who are regular practitioners before this Court, that recently the mushrooming of various websites is seen, which are operational, for applying and for prosecuting trademarks which are making representations that could be misleading and misrepresentative in nature. Some such representations are set out below:

**Vyaapar Seva Kendra**  
Sponsored -

Get Your Trademark Registered Tod... See more

Chat with us

**Vyaapar Seva Kendra**  
— COMPLETE BUSINESS SOLUTIONS —

**GET TRADEMARK REGISTRATION IN 1 DAY**

Easy Process | Legal Assurance | 100% Online

**PRICE - 2999/-**  
(Government Fees Extra)

Trustpilot  
★★★★★ 4.7  
Customer Review

For More Information  
**+91 9359784485**  
[www.vyaaparsevakendra.com](http://www.vyaaparsevakendra.com)

WHATSAPP  
Chat with us

WhatsApp

**REGISTERED TRADEMARK REGISTERED**

**TRADEMARK SPECIAL OFFER**

NeuSource

GET YOUR BRAND NAME RECOGNISED  
LEGALLY PROTECT YOUR BRAND NAME

Service	Step	Price
TRADEMARK RENEWAL	06	₹13999 - ₹12999
TRADEMARK SEARCH	01	₹499 - FREE
TRADEMARK FILING	02	₹6499 - ₹5999
RESPONSE TO OBJECTION	03	₹2999 - ₹2499
TRADEMARK HEARING	04	₹7999 - ₹6999
TRADEMARK OPPOSITION	05	₹6999 - ₹5999



63. While it may not be illegal for Patent Agents, Trademark Agents and other similar agents to have a website giving contact details and other material relating to their services - the pamphlets and messages as captured above have a larger bearing on clients and applicants who may be availing services. The Controller General ought to be able to curb such misleading and misrepresentative advertising in the larger interest of the profession and the applicants.

64. The Supreme Court in *Bar Council of Maharashtra v. M.V. Dabholkar and Others, (1976) 2 SCC 291* observed that soliciting, advertising, scrambling and other obnoxious practices, subtle or clumsy, for betterment of legal profession, will be considered as a taboo. In this case advocates tried to secure clients by means of solicitation, physical fight, undercutting of fees *etc.* Relevant observations of the Court are as under:

*“18. How can a disciplinary authority, aware of its accountability to the Indian Bar, functioning as the*



*stern monitor holding the punitive mace to preserve professional purity and promote public commitment and appreciative of what is disgraceful, dishonourable and unbecoming, judged by the standards of conduct set for this noble calling and deviations damaging to its public image, find its way to hold such horrendous misbehaviour as snatching, catching, fighting and undercutting as not outraging the canons of conduct without exposing itself to the charge of dereliction of public duty on the trisection of Rule 36 and blind to the “law for lawyers”?*

*19. It has been universally understood, wherever there is an organised Bar assisting in administering justice, that an attorney, solicitor, barrister or advocate will be suspended or disbarred for soliciting legal business. **And the “snatching” species of solicitation are more revolting than “ambulance chasing”, advertising and the like. If the learned profession is not a money-making trade or a scramble for portorage but a branch of the administration of justice, the view of the appellate Disciplinary Tribunal is indefensible and deleterious. We, as a legal fraternity, must and shall live up to the second and live down the first, by observance of high standards and dedication to the dynamic rule of law in a developing country.***

xxxxxx...

*23. The rulings in *In the matter of ‘P’, an Advocate [AIR 1963 SC 1313 : (1964) 1 SCR 697 : (1963) 2 Cri LJ 341]* ; *In re: Shri M, Advocate of Supreme Court of India [AIR 1957 SC 149 : 1956 SCR 811 : 1957 Cri LJ 300]* ; *In the matter of ‘N’, an Advocate [AIR 1936 Cal 158 : ILR 63 Cal 867]* ; *Government Pleader v. Siddick [AIR 1929 Bom 335 : 31 Bom LR 625 : ILR 53 Bom 640]* were cited before us and no Judge, nor lawyer will be in doubt, even without study of case-law, that snatching briefs by standing at the door of the courthouse and in-fighting for this purpose is too dishonourable, disgraceful and*





*unbecoming to be approved even for other professions. Imagine two or three medical men manhandling a patient to claim him as a client. The law has suffered at the hands of the Appellate Tribunal. Lest there should be lingering doubts, **we hold that the canons of ethics and propriety for the legal profession totally taboo conduct by way of soliciting, advertising, scrambling and other obnoxious practices, subtle or clumsy, for betterment of legal business. Law is no trade, briefs no merchandise and so the leaven of commercial competition or procurement should not vulgarise the legal profession.** Canon 27 of Professional Ethics of the American Bar Association states:*

*“It is unprofessional to solicit professional employment by circulars, advertisements, through touters or by personal communications or interviews not warranted by personal relations.”*

65. Though, some basic details of the firm, its lawyers and the services offered is usually specified on the website of lawyers and law firms, the images set out above reveal that deceptive and illusory claims are being made and applicants may fall prey to the same. This Court has noticed that in yester years, there were situations when a lawyer would simply collect money for registering a trade mark and send back a notarised certificate on some stamp paper, confirming that the mark is registered. Such sharp practices are now capable of being conducted through online portals now. Whenever there is any offering of service for trade mark or patent registration, it should be compulsory for the name of the registered Agent and the registration number to be mentioned so that the promotional material can be linked back to the person who is responsible. Without such safeguards, there is in effect no accountability whatsoever and genuine applicants and their rights may be severely jeopardised.



66. While it may not be illegal for Patent Agents, Trademark Agents and other similar agents to have a website giving contact details and other material relating to their services - the pamphlets and messages as captured above have a larger bearing on clients and applicants who may be availing services. The Controller General ought to be able to curb such misleading and misrepresentative advertising in the larger interest of the profession and applicant.

**CONCLUSION & DIRECTIONS:**

67. The Office of CGPDTM shall look into all these issues which have been raised even in the written submissions of the IPAA and after conducting proper stakeholder consultation shall put in a proper mechanism in place including guidelines for regulating the conduct of Patent Agents and Trademark Agents as to what would constitute professional misconduct, professional negligence as also the framework for any complaints that can be filed. Moreover, there also appears to be some requirement to put in guidelines w.r.t. solicitation and advertising as well.

68. Accordingly, the following directions are issued:

- a) the abandonment order is set aside and the reflection of the same shall be made on the website within a period of two weeks from now.
- b) the Patent Office shall accept a physical/online reply to the FER by the Petitioner, which shall be filed within four weeks after the abandonment order is reflected on the website and, thereafter, proceed with the patent application of the Petitioner in accordance with law.
- c) in the present case the omission on behalf of the Patent Agent, of not informing his client/Petitioner about the reply to the First



Examination Report despite repeated emails on behalf of the Petitioner *prima facie* constitutes professional misconduct. This is nothing but intentional negligence on behalf of the Patent Agent as due to his omission of non-filing of the response to the FER, the status of the patent application has been reflected as “*deemed to be abandoned*”. This is a clear act of misconduct as the Petitioner with utmost trust had relied upon the Patent Agent to fulfil his duties and obligations towards the Petitioner. The Petitioner had no intention to abandon his patent therefore the repeated mails and follow ups.

- d) In this case, insofar as the Patent Agent himself is concerned, this Court is convinced that the Patent Agent was not diligent and kept silent all along when the applicant sent him emails. Accordingly, the office of the CGPDTM is directed to hold an enquiry against the Patent Agent and take action in accordance with law. The enquiry shall be conducted and concluded within a period of four months from now. The present order shall be deemed to be a notice to the Patent Agent to explain to the CGPDTM’s office his stand. A personal hearing shall also be afforded and an order shall be passed within a period of four months from now.

### **Regulating the conduct of Patent Agents**

- A draft Code of Conduct to regulate Patent and Trademark Agents be prepared and put up by the CGPDTM on its website within two months for stakeholder consultation. The Code of Conduct be then, thereafter, be notified within a period of 6 months from now i.e., latest by 31<sup>st</sup> December, 2024.



- Within the said period, a framework be also put in place for dealing with complaints against Trademark Agents and Patent Agents, until then if any complaint is filed against any Trademark or Patent Agent before the office of the CGPDTM the same shall be considered and decided by *ad-hoc* Committee consisting of at least two officials from the trademark/patent office and one senior IP practitioner with at least 15 years of practise as also registered as a Patent/Trademark Agent. The *ad-hoc* Committee be notified within two months.

69. The present order be communicated to the CGPDTM on the e-mail-llc-ipo@gov.in for compliance of this order, along with the copy of the written submissions on behalf of the IPAA for him to take action in accordance with law.

70. Accordingly, the petition along with all the pending applications are disposed of.

**PRATHIBA M. SINGH  
JUDGE**

**JULY 04, 2024**  
*dj/ks*