

Code Of Conduct For Patent And Trademark Agents

Exercising its writ jurisdiction in *Saurav Chaudhary v. Union of India & Anr. (2024:DHC:4946)*, the Delhi High Court reinstated a patent application that was deemed to be abandoned. More significantly perhaps, for the first time in Indian IP jurisprudence, the court also directed the Controller General to come up with a draft Code of Conduct to regulate Patent and Trademark Agents.

In the case at hand, the petitioner filed a patent application in 2019 through a law firm in India. Despite repeated communication from the applicant, the law firm did not apprise the petitioner of the status of his application. The application was ultimately deemed to be abandoned because the reply to the first office action was not filed within the prescribed time. The applicant then filed a writ petition before the Delhi High Court.

Subsequent to hearing extensive arguments, the court opined that the present case was similar to the landmark case of *The European Union Represented by the European Commission v. Union of India & Ors. (2022:DHC:2301)* wherein the Delhi High Court had ruled that a high court can exercise its writ powers to condone delay in cases where the abandonment of an application is caused due to inaction or mistake on the part of the applicant's agent. Though the Controller General contended that the first examination report (FER) was available on the internet and the petitioner ought to have checked it, the court opined that a patent application is a valuable asset and most inventors and clients may not have the resources or technical expertise to access the IP office website; hence, the availability of access to the IP office website could not be considered as a valid and sufficient defence. Accordingly, the court directed the Patent Office to take on record the applicant's reply to the first office action. The court also ruled that the patent agent of the applicant was intentionally negligent and directed the Controller General to hold an enquiry against the erring patent agent.

Furthermore, after considering the stand of the Controller General, it was noted that the current framework of the Patents Act, 1970 and Trademarks Act, 1999 does not prescribe rules of conduct for patent agents and trademark agents respectively. The Court referred to corresponding provisions in US and UK law that do regulate the conduct of agents. In this context, the Court also took note of the misleading promotion practices employed by certain patent and trademark agents in India which are not in the best interests of the applicants.

Accordingly, it has directed the Controller General to conduct stakeholder consultations and finalise a Code of Conduct to regulate patent and trademark agents by December 31, 2024.

We shall follow the developments and keep you updated!

