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IN THE HIGH COURT OF DELHI AT NEW DELHI

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Reserved on: 29th August 2022**Pronounced on: 12th September, 2022**

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W.P.(C)- IPD 15/2021, CM APPL. 30340/2020, 59/2022**HARYANA PESTICIDES****MANUFACTURES ASSOCIATION**

..... Petitioner

Through : Mr.S.K.Bansal, Mr.Ajay Amitabh
Suman, Advocates.

versus

WILLOWOOD CHEMICALS PRIVATE LIMITED

..... Respondent

Through : Mr.Hemant Singh, Ms.Mamta Jha,
Mr.Saif Rahman Ansari, and
Ms.Surbhi Nautiyal, Advocates.
Mr.Harish Vaidynathan Shankar,
CGSC, Mr.Srish Kumar Mishra,
Mr.Sagar Mehlawat, Mr.Alexander
Mathai Paikaday, Advocates for
R2/DOI.**CORAM:****HON'BLE MR. JUSTICE YOGESH KHANNA****YOGESH KHANNA, J.**

1. This writ petition is filed for quashing of the impugned order dated 20.07.2020 passed by the Deputy Controller of Patents and Designs in Pre-Grant Opposition under Section 25(1) of the Patents Act filed by the petitioner against application for grant of patent titled as "Novel Fungicidal Composition", filed on 31.12.2013 by respondent No.1.

2. It is the grievance of the learned counsel for the petitioner initially the respondent filed an application for grant of patent with complete



specification to the invention viz. “Novel Fungicidal Composition”. The total claims made in such application were from No.1-27, as annexed with the petition at pages No.63-65.

3. The first examination report (FER) was issued on 20.07.2020 by the Deputy Controller of Patents and Designs, Patent Office, Delhi and it required to file a response to the examination report. The petitioner filed objections to the same.

4. Form-13 dated 18.09.2019 was again filed by the respondents thereby amending their claims from 1-27 to 1-25; the amended claims are given at pages No.89 and 90 of the amended writ petition.

5. The hearing was granted to the petitioner qua these amended claims and it concluded on 13.01.2020. Both the parties were directed to file written submissions. The respondents sent a copy of their written submissions to the Controller with a copy to the petitioner herein. However, later at the back of the petitioner on 27.01.2020, the respondents yet again sought to amend their claims from 1-25 to 1-19 but the copy of such amendment application/written submissions were never served upon the petitioner herein and neither any Form-13 was filed. The impugned order was then passed.

6. It is argued the impugned order itself show the arguments were concluded on 23.01.2020, but the amendment application came later and without given any opportunity of being heard to the petitioner, the patent qua claims no. 1 to 19 was granted.



7. The learned counsel for petitioner referred to *Neon Laboratories Pvt. Ltd. vs. Troikaa Pharma Limited and Ors.* 2011 (2) Bom CR 54 wherein the Court held:

“43. It is, therefore, clear that the opportunity provided in Section 25(1) is not an empty formality. The Legislature in its wisdom has specifically conferred on any person a right to make representation in writing, objecting the grant of patent and that is to be made by raising specific grounds. The grounds are also enumerated in the provision. Once the Legislature has devised such a safeguard in public interest and provided for pre grant opposition, so also, set out the manner in which the same has to be dealt with, then, we cannot place a narrow interpretation on the said provision so as to defeat the legislative mandate. The distinction made by Mr. Kadam that opportunity is restricted only to the contents of the original application and there is no requirement of giving further hearing; makes the exercise meaningless and it would be then very easy to defeat Section 25(1). In this context, it must be understood that the opposition under Section 25(1) is to the "grant of a patent". The grant is on an application made in that behalf, which itself is duly published. If the opposition is raised to the grant, then, until the same is dealt with, no patent can be granted. If the original claim/application is amended, as in this case, and the amendments are also opposed, then, a personal hearing to the objector on the amended claims is required to be given if specifically requested. That is the scheme of Section 25(1) and Rule 55 which are to be considered and read together.

52. In our view, in this case, it is not necessary to examine in further details, the aspect as to whether the breach of principles of natural justice would vitiate the proceedings to such an extent as would render the final order void. As far as our Courts are concerned, the settled view is that if the principles of natural justice are Violated, the order is procedurally ultra vires and therefore, suffers from a jurisdictional error. Such an error is required to be corrected and is capable of being corrected by a writ of certiorari under Article 226 of the Constitution of India. The power of judicial review is conferred precisely to set right such errors. Therefore, we can safely conclude that in this case the impugned order does not create any right in favour of the Respondent No. 1 and the grant of patent, therefore, cannot be said to be valid.

54. The argument of Mr. Kadam that the patent is granted for 20 years and substantial period has been lapsed, so also, the Respondent No.1 has in furtherance of grant, extensively applied for and has been granted the patent for 29 countries; need not



detain us. The argument that the procedural rules create difficulties for persons like the Respondent No. 1 to apply and seek the patent, also cannot be of any assistance. Once we find that the statutory mandate has been breached and violated, then, the Respondent No. 1 will suffer prejudice if the clock has to be set back, is indeed no answer. Mr. Kadam then submits that we should not set aside the grant even if we conclude that the same is issued without adherence to the principles of natural justice. In other words, while remitting the matter back to the Patent Controller we should not disturb the patent granted in favour of the Respondent No.1 because that would have serious consequences on the trade operations. We are unable to accede to this request. If the grant does not confer any legal right as it is vitiated by non observance of the principles of natural justice, then, to continue the patent as granted, would put a premium on the illegality of the authorities. That can never be the intention of the legislature. Hence, we have no hesitation in rejecting this plea of the learned Advocate General.”

8. In *Ghanashyam Mishra and Sons Private Limited through the Authorized Signatory vs. Edelweiss Asset Reconstruction Company Limited Through the Director and Others* 2021 SCC Online SC 313 the Court held:-

*“129. As held by this Court in catena of cases including in the cases of Babu Ram P k Chandra Maheshwari v. Antarim Zilla Parishad Muzaffar Nagar, Whirlpool Corporation v. Registrar of Trade Marks, Mumbai, Nivedita Sharma v. Cellular Operators Association of India, Embassy Property Developments Pvt. Ltd. v. State of Karnataka and recently in the case of Kalpraj Dharamshi (supra), that non-exercise of jurisdiction under Article 226 is a rule of self-restraint. It has been consistently held, that the alternate remedy would not operate as a bar in at least three contingencies, namely, (1) where the writ petition has been filed for the enforcement of any of the Fundamental Rights; (2) **where there has been a violation of the principle of natural justice**; and (3) where the order or proceedings are wholly without jurisdiction or the vires of an Act is challenged.”*

9. In *Glochem Industries Ltd. vs. Cadila Healthcare Ltd.* order dated 06.11.2009 passed in W.P.1605/2009 by the High Court of Judicature at Bombay, it was held:



“7. Having considered the rival submissions, we would deal with the last objection first. Although the Petitioners may have remedy of post grant opposition or of seeking suo moto revocation as well as filing of a counter claim as is suggested by the Respondents that by itself can be no basis to non-suit the Petitioners, if the Petitioners were right in their grievance that the authority has committed manifest or jurisdictional error while considering the representation by way of opposition or for that matter decided the objections on palpable misreading and misapplication of the relevant provisions of law. This is so because the law provides for remedy of pre-grant opposition by virtue of Section 25(1) of the Act. If such a remedy is provided, the authority is obliged to consider the representation by way of pre-grant opposition under Section 25(1) keeping in mind the parameters of law by observing principles of natural justice. It is not necessary for us to examine the argument of the Petitioners that the remedy of pre-grant opposition is qualitatively different than the remedy of post-grant opposition. According to the Petitioners, in the pre-grant opposition, the onus is on the patent applicant to show that the alleged invention would result in enhancement of the known efficacy of the stated substance; whereas in the post-grant opposition, the onus will be on the objector to show that the alleged invention does not result in enhancement of the known efficacy of the stated substance. Suffice it to observe that the preliminary objection raised by the Respondent No. 1 does not mean that this Court has no jurisdiction to entertain writ petition under Article 226 of the Constitution of India against the decision of the authority on the opposition under Section 25(1) of the Act. It is a matter of prudence and discretion as to whether the Court should entertain the writ petition or not. In the facts of the present case, we think that it would not be proper to non-suit the Petitioners at the threshold on this count.”

10. In *Tata Chemicals Ltd. vs. Union of India and Ors.* order dated 08.10.2013 passed in W.P.6561/2013 by the High Court of Judicature at Bombay, it was held:

“11. After taking into consideration the rival submissions, in our view, prima facie case is made out for grant of interim relief by the Petitioner. It is an admitted position that after preliminary hearing was given to Respondent No.4 under sections 14 and 15, a publication was made under section 11A (3) of the said Act on 15/8/2008. The First Examination Report was issued by the Indian Patent Office under sections 12 and 13 on 20/10/2010 and the Petitioner thereafter filed representation by way of opposition



under section 25(1) on 7/4/2011. Thereafter, various applications for amendment were made by Respondent No.4. It is alleged that no hearing was given to the Petitioner when the amendment applications were allowed and even thereafter the Petitioner was not given an opportunity of being heard in respect of the said four amendment applications. During the period between the filing of application and grant of patent, Respondent No.4 applied for four amendments, as follows:-

It is an admitted position that after 13/12/2011, no further hearing has been given to the Petitioner. Office of Respondent No.3 wrote a letter dated 24/12/12 and para 1 and 2 of the said letter it has been mentioned as under:-

“27. The question to be asked in the ultimate analysis would be whether the person aggrieved was given a fair deal by the authority or not? Could a reasonable person, under the circumstances in which Tribunal was placed, pass such an order? Answer to these questions would determine the fate of the case.”

In the present case, after 13th December, 2011, further hearing was given to the applicant. They were permitted to rely on additional affidavit, however, no opportunity was given to the Petitioner to give their say and they were not heard. Similarly on the two crucial amendments viz (ii) and (iv), no opportunity was given to the Petitioner to give their reply nor were they heard. Ratio of these judgments, therefore, would squarely apply to the facts of the present case and, therefore, in our view, prim facie there is clear breach of principles of natural justice.

13. Interim order is therefore granted in terms of prayer clauses (c) and (e) of the Petition.”

11. The learned counsel for the petitioner had argued in *Best Agrolife Limited vs. Deputy Controller of Patents and Anr.* in W.P.(C)-IPD11/2022 decided on 07.07.2022, wherein the controller had allowed the amendment to the claims two days prior to passing of impugned order without notifying the petitioner which is in complete violation of the principles of natural justice and also in *Indian Network for People living with HIV/AIDS vs. Union of India & Ors.* 2009 (39) PTC 468 (Madras) (DB), the Court held as under:

“55. The remedy at the post-grant stage cannot be equated with the remedy at the pre-grant stage. The insufficiency of the opportunity



of hearing at the pre-grant stage cannot be made good by grant of opportunity at the post-grant stage. Since, statute has given remedy at both the stages, it must be made available at both the stages. One cannot be a substitute for the other. An unfair trial cannot be cured by a fair appeal. (See Institute of Chartered Accountants of India Vs. L.K.Ratna, AIR 1987 SC 71).”

12. It is thus alleged the arguments before the Comptroller of Patent were concluded on 13.01.2020 and the matter was listed for orders but on 27.01.2020; an amendment was filed without Form-13 wherein claims were reduced from 1-25 to 1-19 and it was allowed vide the impugned order and the patent was granted.

13. It is argued per Section 57(4) of the Patents Act notice of the amendment need to be given to the opposite party. Section 57(4) of the Patents Act is as under:

“57 Amendment of application and specification 132 [or any document related thereto] before Controller. –

(1) to (3) xxxx

(4) Where an application is published under sub-section (3), any person interested may, within the prescribed period after the [publication] thereof, give notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.”

14. It is argued based on the patent so granted the respondent have filed various suits and sought exemption of caveats filed by the petitioner herein during the COVID time and got ex-parte stays as once the patent is granted the infringement starts.

15. Heard.



16. The questions involved in this petition are *a)* if the notice qua amendment of the claims from 1-25 to 1-19 ought to have been given by the Controller; *b)* if any prejudice is caused to the petitioner; *c)* if there exist an alternative remedy with the petitioner.

17. Few dates are relevant to decide the issues:-

- (i) 31.12.2013- when the patent application was moved by respondent before the controller;
- (ii) 03.07.2015- when such application was published by the controller;
- (iii) 10.01.2017- pre-grant opposition filed by the petitioner;
- (iv) 13.01.2020- hearing concluded by Controller;
- (v) 20.07.2020- it was rejected by the controller;
- (vi) 28.07.2020- post grant opposition was filed;
- (vii) 19.10.2020- four suits were filed and the injunction is still operating;
- (viii) 03.11.2020- the defendant filed an application under Order XXXIX Rule 4 CPC in such suits;
- (ix) 09.11.2020- the Writ Petition is filed.

18. Few Sections and Rules of the Act are also relevant as under:

“14. Consideration of the report of examiner by Controller: Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or other documents to ensure compliance with the provisions of this Act or of the rules made thereunder, the Controller, before proceeding to dispose of the application in accordance with the provisions hereinafter appearing, shall communicate as expeditiously as



possible the **gist of the objections to the applicant** and shall, if so required by the applicant **within the prescribed period, give him an opportunity of being heard.**

15. Power of Controller to refuse or require amended applications, etc., in certain case.-Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or **may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.**

25. Opposition to the patent. –

(1) xxx

(2) At any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely:-

(a) to (k) xxxx

57 Amendment of application and specification or any document related thereto before Controller. -

(1) Subject to the provisions of section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification or any document related thereto to be amended subject to such conditions, if any, as the Controller thinks fit:

Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification or any document related thereto under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend.

(2) Every application for leave to amend an application for a patent or a complete specification or any document related thereto under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made.

(3) xxx.

(4) Where an application is published under sub-section (3), any person interested may, within the prescribed period after the publication thereof, give notice to the Controller of opposition



thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

(5) xxx.

(6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any other document related thereto to comply with the directions of the Controller issued before the grant of a patent.

59 Supplementary provisions as to amendment of application or specification. -

(1) No amendment of an application for a patent or a complete specification or any document related thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

OPPOSITION PROCEEDINGS TO GRANT OF PATENTS

Rule 55

Opposition to the patent

(1) to (4) xxx

(5) On consideration of the statement and evidence filed by the applicant, the representation including the statement and evidence filed by the opponent, submissions made by the parties, and after hearing the parties, if so requested, the Controller may either reject the representation or require the complete specification and other documents to be amended to his satisfaction before the patent is granted or refuse to grant a patent on the application, by passing a speaking order to simultaneously decide on the application and the representation ordinarily within one month from the completion of above proceedings.

(6) [omitted]

81. Amendment of application, specification or any document relating thereto. - (1) An application under section 57 for the amendment of an application for a patent or a complete specification or any document related thereto shall be made in Form 13.

(2) xxx



(3) (a) to (b) xxx

(c) *The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 57 as they apply to the hearing of an opposition proceeding.*

82 Preparation of amended specifications, etc.-- Where the Controller allows the application for a patent or the complete specification or any other document to be amended, the applicant shall, if the Controller so requires and within the time to be specified by him, leave at the appropriate office an amended application or the specification or the other document, as the case may be, in accordance with the provisions of these rules.

19. Admittedly, claim nos.1-27 were initially lodged by the respondent with the Controller. As per the case of the respondent it was the Controller who had asked the respondent to amend its claims so as to restrict its scope. Following notices of the Controller are relevant. Notice date 20.06.2019 read as under :

“(5) *SCOPE:*

Claims: 1-27 does/do not define the scope of invention for which the protection is claimed for the following reasons:

a. The compositions stated in claims should be clearly defined w.r.t the ratio/percentage of the components used.

b. The expressions “of 2.50-5.00% w/w.”, “1.50-3.00% w/w. “preferably” alone or in combination thereof “,” group consisting of combination products “,” natural polysaccharides. “are broad in scope and make the scope of claims broader than is justified by the description.

*c. The scope of claims 1-27 is **unclear and indefinite** with respect to the expressions “present in an effective amount, plurality of anti freezing agents, fillers, anti-foaming agent, dispersing/wetting agents, viscosity modifiers, biocide and solvents alone or in combination thereof selected from the group consisting of combination products....etc” which are not all supported and disclosed in the present application. The extremely large number of possibilities which are covered by the claims make it impossible to determine the **exact scope of the invention**. Therefore, the above claims **should be redrafted to clearly define the scope of protection***



sought to restrict the scope of the invention as per requirement u/s 10 of the Act.

d. Claims 27 define a product (novel fungicidal composition) in terms of the process (known procedure) used to produce that product. The technical features of that product will be the same when compared to the same product produced by a different process. The instant claims are not allowed."

20. Another again notice dated 25.11.2019, sent by the Controller alleging objections raised are still outstanding, read as under:

"Scope

*1. a. The expressions "alone or in combination thereof "," group consisting of combination products" ,"natural polysaccharides."are **broad in scope** and make the scope of claims **broad**er than is justified by the description.*

*b. The scope of claims 1-25 is **unclear** and **indefinite** with respect to the expressions plurality of anti freezing agents, fillers, anti-foaming agent, dispersing/wetting agents, viscosity modifiers, biocide and solvents alone or in combination thereof selected from the group consisting of combination products....etc" which are not all supported and disclosed in the present application. The **extremely large number of possibilities** which are covered by the claims **make it impossible to determine the exact scope of the invention**. Therefore, the above claims should be redrafted to clearly define the scope of protection sought to restrict the scope of the invention as per requirement u/s 10 of the Act."*

It was only thereafter these claims were redrafted from 1-27 to 1-25 and then to 1-19.

21. Admittedly claim no.1 was an independent claim and even after amendment no change was made in this claim. Claim nos. 2-25 were connecting claims and were directed to be made *concise/ narrower* by the Controller vide the above notices. The respondent clarified this aspect in para 6 of its counter affidavit as under:

" 6.xxxxxxxx

ii. The pre-grant opposition was filed by the Petitioner opposing claims 1-27 which were originally filed as part of the



patent application no.3839/DEL/2013. The amended claims 1-19 as granted originate from and form part of the original claims 1-27. These claims 1-27 were amended pursuant to the objection raised by the Controller vide examination report dated 20.06.2019 on the ground that they are broad in scope and make the scope of claims broader than is justified by the description. The Respondent no.1 was further directed to submit redrafted claims defining the scope of protection so as to be restricted to the scope of the invention claimed. Hence, the claims were amended to the satisfaction of the Controller in accordance with the provisions of the Section 12-15 read with Section 57(6) of the Patents Act, 1970."

22. I have gone through claim nos.1-27 at page no.93; then claims no.1-25 at page 96 and lastly claim nos. 1-19 at page 101. A bare perusal of claim nos.1-19 would show some of the claims, independently made were infact added/joined in earlier claims thus making the list *concise*. Some claims independently made were thus deleted. Suffice is to say no *additional claims* was ever made and only *re-adjustment* of claim nos.1-25 was done and were brought down to claims no.1 to 19. It is an admitted fact claim nos. 1-27 and then claim nos.1-25 were opposed by the petitioner since the petitioner had its notice, as claim nos. 1-25, were annexed with reply of the respondent to the application for pre-grant opposition.

23. Claim nos.1-25 were already on record and claim nos.1-19 were only *reconstructed* claims 1-25, filed on 27.01.2020. In its impugned order dated 20.07.2020 the Controller has dealt with all the issues raised by the petitioner after giving a hearing under Section 14 and 25 of the Patents Act i.e., on examination as well as on objections/oppositions to claims nos.1-27; hence there was no violation of natural justice and *no prejudice* is caused to the petitioner. The amendments in independent



claim were opposed to its fullest extent and in the connecting claims *no expansion* was claimed. Admittedly *no new constituent* was brought in claim nos.1-19. Moreso, alleged amendment was never sought by the petitioner but was *per* directions of the Controller to concise its claims, its number was reduced from 1-25 to 1-19.

24. The amendment from 1-27 to 1-25 claims were made pursuant to objections raised by the Controller in the first examination report dated 20.06.2019 under Section 14 of the Patents Act, 1970. However, the Controller continued his objections; notified it to both the parties vide notice of hearing dated 25.11.2019 issued by the Controller for hearing of objections as well as pre-grant opposition. Thus amended claim nos. 1-25 and subsequently 1-19 were submitted pursuant to the directions of the Controller *per* examination report dated 20.06.2019 and hearing notice dated 25.11.2019 under Section 15 read with Rule 55(5) of Patents Act. No form-13 was submitted. Even otherwise, there is no requirement to submit form-13 as amendment was made pursuant to the directions of the Controller in exercise of his power and discretion under Section 15 read with Rule 55(5).

25. Since the amendments were made at the asking of the Controller and in the course of examination of application under Section 14, hence no notice was issued by the Controller to the petitioner. Further it is important to note *petitioner never raised any objection to the amended claim nos.1-25 when it submitted its written submissions dated 28.01.2020*. The amended claim nos.1-25 were subject matter of hearing



notice dated 25.11.2019 issued to both the parties, fixing the hearing of Controller's objection as well as pre-grant opposition.

26. The Patents Act, 1970 and Patents Rules, 2003 envisage: **a)** voluntary amendment sought to be made by an applicant in a specification or a patent document and **b)** the amendment of the specification required to be made by the Controller to his satisfaction. For a voluntary amendment the procedure prescribed is under Section 57(1) and 57(2) of the Patents Act, 1970 which involve filing of application in the manner prescribed in Rule 81 and 82 of the Rules of Form-13 with payment of prescribed fee vide entry no.20 of Table-1 of the first schedule of the Patents Rules 2003. Such procedure does not apply to the amendment made in the specification to comply with the direction of the Controller issued before the grant of Patent under Section 14, 15 and Rule 55(5).

27. A bare perusal of the claims would reveal there was never any addition nor expansion to the **scope** of claim nos.1-25 while bringing it down to claim nos.1-19. Rather six claims were **deleted** and rest were only **merged** in claim nos.1-19, hence, there appears to be no violation of principles of natural justice.

28. In *Natco Pharma Limited vs Union of India & Others* W.P.(C) IPD 91/2021 decided on 12.07.2022 para No.22, notes:-

*"22. The observations made in respect of amendments in the present order **shall not be** applicable to amendments directed by the Controller under Section 15 of the Act."*



29. In *Sulphur Mills Limited vs. Dharamaj Crop Guard Limited and Anr.* 2021 (87) PTC 567 (Del.), the Court held as under:

*“84. The Defendants have also argued that the Controller ought not to have permitted the amendments to the claims of IN'429. It is seen that the Plaintiff has amended IN'429 on four occasions during the examination and oppositions process. The consistent view of the Controller, except in order dated 24th October, 2009 which is no longer in operation, has been that the said amendments were well within the scope of the originally filed claims and the Plaintiff only sought to restrict the claims and not broaden them. The view having been that the amendments are in accordance with Section 59 of the Patents Act, 1970, the mere fact that the Plaintiff has amended the claims would not weigh against the Plaintiff. It is usual for patent applicants to edit, amend, modify and vary the claims during the examination and opposition process. **So long as the amendments sought are within the scope of the claims originally filed, no adverse conclusion can be drawn on the basis of the said amendments.**”*

30. In *Nippon A&L Inc. vs. The Controller of Patents* C.A.(COMM.IPD-PAT) 11/2022 decided on 05.07.222, it was held:

(2) to (3) xxxx

*58. By applying the principles laid down in the above discussed provisions and decisions, it is clear that in the present case, the **Applicant is amending and narrowing the scope of the claims and not expanding the same.** The process sought to be claimed in the amended claims has been clearly disclosed in the patent specification. **The said process is not sought to be added newly by way of an amendment. The amendment is, thus, within the scope of the patent specification and claims as originally filed.** In the opinion of the Court, the amended claims of the Appellant satisfy the conditions of Section 59(1) of the Act as specified above. Thus, the objection under Section 59(1) of the Act is not sustainable.”*

31. Thus, the amendment made during opposition stands on a different footing than the amendment required at the instance of the Controller. In *Best Agrolife Limited* (supra) the impugned order was set aside not only because of an amendment but also on merits. It was held the impugned order was **a)** without any reasoning and **b)** the scope of claim was



increased in the amendment as range of thickness was increased from 0.025-05% to 0.05-0.25%. However, the scope of the claims in this case has rather been *reduced/merged*. Hence to my mind *no prejudice* is caused to the petitioner with reduced claim from nos.1-25 to 1-19.

32. In *K L Tripathi vs State Bank of India & Others* 1984 (1) SCC 43, it was noted:-

*“31. Wade in his ‘Administrative Law’, 5th Edition at pages 472-475 has observed that it is not possible to lay down rigid rules as to when the principles of natural justice are to apply: nor as to their scope and extent. Everything depends on the subject-matter, the application of principles of natural justice, resting as it does upon statutory implication, must always be in conformity with the scheme of the Act and with the subject-matter of the case. In the application of the concept of fair play there must be real flexibility. **There must also have been some real prejudice to the complainant**; there is no such thing as a merely technical infringement of natural justice. The requirements of natural justice must depend on the facts and the circumstances of the case, the nature of the inquiry, the rules under which the tribunal is acting, the subject-matter to be dealt with, and so forth.”*

33. Qua (c) Now I come to the fact as to if there exist any alternative remedy with the petitioner or not. Admittedly this petition has been filed by the petitioner after filing of its post grant opposition. At an initial stage of this Writ Petition, the petitioner did not take a plea qua violation of natural justice but when an objection was taken by the respondent qua the maintainability of this petition, it was added as a new ground **K** in the amended Writ Petition. The orders dated 25.11.2020 and 06.04.2021 of the Court reveal an issue of maintainability being raised by respondent and it led to filing of this amended Writ Petition.



34. In *Mylan Laboratories Limited vs. Union of India and Ors.* 2019 (80) PTC 374 (Del.), which read as under:

*“6 . In the opinion of this Court, the pre-grant opposition was, therefore, decided on merits and following the scheme of the Act, as laid down in UCB Farchim (supra), the remedy of the Petitioner would be to **either file a post-grant opposition or an application for revocation.** Thus, the present petition would not be liable to be entertained.*

35. In *UCB Farchim SA vs. Cipla Limited and Ors.* 2010 (42) PTC 425 (Del.) it was held:

*18. To summarise this part of the discussion, as regards persons who have not succeeded in the pre-grant opposition stage to prevent the grant of a patent, and are persons "interested" within the meaning of Section 25(2) and Section 64 of the Patents Act, **their remedy against the rejection of their pre-grant opposition is to file a post-grant opposition under Section 25(2) and await the decision of the Controller. If they are still aggrieved by that decision under Section 25(4) of the Patents Act, they can file an appeal before the IPAB in terms of Section 117A of the Patents Act. Where the pre-grant opposition is by a third party**”*

36. In *Alloys Wobben and Anr. vs. Yogesh Mehra and Ors.* 2014 (59) PTC 1(SC), it was held as under:

“18. xxxxxx This is because, Section 25 of the Patents Act, inter alia, provides for the procedure, for the grant of a patent. The procedure commences with the filing of an application. The second step contemplates publication of the details of the patent sought. The next step envisages, the filing of representations by way of opposition (to the grant of the patent). This advances into a determination by the “Controller”, to grant or refuse the patent. The decision of the “Controller”, leads to the publication of the grant (of the patent). This process finalises the decision of the grant of the patent. All the same, it does not finally crystallise, the right of the patent holder. After the grant is published, “any person interested”, can issue a notice of opposition, within one year of the date of publication of the grant of a patent. If and when, challenges raised to the grant of a patent are disposed of favourably, to the advantage of the patent holder, the right to hold the patent can then and then alone, be stated to have crystallized. Likewise, if no notice of opposition is preferred, within one year of the date of publication



NEUTRAL CITATION NO: 2022/DHC/003562

of the grant of a patent, the grant would be deemed to have crystallized. Thus, only the culmination of procedure contemplated under Section 25(2) of the Patents Act, bestows the final approval to the patent. Therefore, it is unlikely and quite impossible, that an “infringement suit” would be filed, while the proceedings under Section 25(2) are pending, or within a year of the date of publication of the grant of a patent.”

37. Thus, this Writ petition is not maintainable since the petitioner has already availed of an *alternative remedy* of filing post grant opposition; has taken a plea of invalidity under Order XXXIX Rule 4 CPC in civil suits. This petition was filed *admittedly* without pleading alleged violation of natural justice and it was only when an issue of maintainability was raised, a new ground was added, to maintain this Writ.

38. In view of the above discussions, there is no merit in the Writ. The petition thus stands dismissed. Pending application(s) also stand disposed of. However, it shall not limit the right of petitioner to take all objections, he is entitled to, in litigations (s) pending.

YOGESH KHANNA, J.

SEPTEMBER 12, 2022

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