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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **C.A.(COMM.IPD-PAT) 315/2022**

APPALETTE TOURTELLIER SYSTEMSAppellant

Through: Mr. Peeyoosh Kalra, Mr. Rohit Rangi,
Mr. Tanveer Malhotra, Mr. Vineet
Rohilla, Mr. Pankaj Soni, Mr.
Debashish Banerjee, Mr. Ankush
Verma, Mr. Gurneet Kaur, Ms.
Vaishali Joshi, Advocates
(M:9833397587)

versus

**CONTROLLER GENERAL OF PATENTS, DESIGNS AND
TRADEMARKS AND ORS**Respondents

Through: Mr. Piyush Beriwal, Mr. Sandip
Munian, Ms. Jyotsna Vyas,
Advocates for R-1 (M:9910396352)
Mr. Avinash K Sharma, Advocate for
R-3

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA

ORDER

14.02.2025

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1. The present appeal has been filed against the order dated 18th November, 2020, passed by the Controller of Patents, whereby, appellant's patent application number *10244/DELNP/2012* was rejected under Section 25(1) on the grounds that the subject matter of the claims lack an inventive steps in view of the prior published documents, i.e., D-1, D-2, D-3, D-4, D-5. Further, it was held that there was insufficiency of description in the invention of the subject application.

2. Learned counsel for the appellant submits that the appellant has already filed an amended claim before this Court, wherein, the appellant has



merged claim nos. 1 and 3 together and has further merged claim nos. 10 and 11 together. He, thus, submits that the amended claims narrow down the scope of original claims, which is permissible under law. He, thus, submits that in view thereof, the matter be remanded back for consideration of the amended claims of the appellant.

3. On previous date, this Court had directed the Controller of Patents to examine as to whether the amended claims filed by the appellant are within the scope of the original claim. However, learned counsel appearing for Controller of Patents submits that this position cannot be ascertained, without considering the said documents in detail.

4. Learned counsel for Controller of Patents further submits that there is no case made out for remanding of the matter.

5. This Court records the statement of respondent no. 3, who had filed opposition before the Controller of Patents against the application of the appellant herein, that respondent no. 3 has no objection if the amendments to the claim by the appellant are allowed. He, however, submits that respondent no. 3 be granted liberty to raise its objections before the said authority and file additional documents, in support of its opposition.

6. This Court is of the view that on account of the amendment of the claims by the appellant, wherein, it is the case of the appellant that the amended claims narrow down the scope of the original claims, the matter can be remanded back to the Controller of Patents for re-consideration.

7. Accordingly, considering the submissions made before this Court and the appellant having amended its claim to narrow down the scope of the original claim, the matter is remanded back to the Controller of Patents. However, Controller of Patents is granted liberty to assess and analyze as to



whether the amended claims actually narrows down the scope of the original claim and then deal with the amended claims, and dispose of the application of the appellant on the basis of amended claims, in accordance with law.

8. This Court notes that on the earlier occasions also, this Court has accepted the amended claims and remanded back the matter to Controller of Patents for examination of the amended claims. Thus, this Court in the case of *W R Grace and Co. Conn. Versus Controller of Patents, 2023 SCC OnLine Del 5456*, has directed as follows:

“xxx xxx xxx

6. Ld. Counsel for the Appellant has now moved an application being I.A. 17000/2023 as per which they have filed an amended claim set as per which the scope of the claims would be restricted to the method aspect of preparing a Crystalline Form II of nicotinamide riboside chloride and hence deleted claims 1 to 11.

7. The Court has perused the amended claims and is of the view that the refusal to grant subject patent application in the impugned order primarily is in respect of the product claims. The deletion of the product claims would completely change the nature of the patent application itself. After having perused the amended claims, this Court is of the view that the same appear to be within the overall scope of the patent application filed.

8. Under such circumstances, the amended claims are taken on record and the same shall now be examined by the Patent office, in accordance with law. The amended claims be now filed before the Patent Office and the same shall be re-examined on merits by the Patent Office. The decision in this matter be rendered within a period of four months from today.

9. Ld. Counsel for the Appellant submits that the novelty in the patent application having been acknowledged, the process deserves to be granted a patent. This submission shall be considered by the Patent Office.

10. Accordingly, under these facts and circumstances the present appeal is disposed of and the matter is remanded to the Patent Controller for a fresh consideration of the amended claims.



xxx xxx xxx”

(Emphasis Supplied)

9. Accordingly, considering the submissions made before this Court and in the facts and circumstances of the present case, the following directions are issued:

I. The present appeal is allowed and the impugned order dated 18th November, 2020, passed by the Controller of Patents, is hereby set aside.

II. The patent application number *10244/DELNP/2012* filed by the appellant, is hereby revived and the matter is remanded to the Controller of Patents.

III. The appellant shall file the amended claims before the Patent Office, which shall be re-examined on merits.

IV. Any observations, as made in the impugned order dated 18th November, 2020, shall not come in the way of the amended claims being examined afresh by the Patent Office.

V. Respondent no. 3 shall be allowed to file documents and other submissions before the Controller of Patents in support of its opposition, if any, to the amended claims of the appellant.

VI. Upon remand, the matter shall be placed before a different officer, other than the one, who passed the impugned order.

10. It is clarified that this Court has not expressed any opinion on the merits of the amended claims of the appellant.

11. The present appeal stands disposed of, with the aforesaid directions.

MINI PUSHKARNA, J

FEBRUARY 14, 2025/au