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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**% *Date of decision: 11th March, 2025*+ **C.A.(COMM.IPD-PAT) 15/2023****MILLIKEN AND COMPANY**

.....Appellant

Through: Mr. Pravin Anand, Ms. Archana
Shanker & Ms. Arpita Kulsheshtra &
Mr. Ashutosh Upadhyaya, Advocates.

versus

**CONTROLLER OF PATENTS AND DESIGNS
& ANR.**

.....Respondents

Through: Ms. Nidhi Raman, CGSC with Mr.
Jubin Singh, Mr. Akash Mishra,
Advocates for R-1 with Ms. Ragini,
Assistant Controller of Patents and
Designs (through VC).

CORAM:**HON'BLE MR. JUSTICE AMIT BANSAL****AMIT BANSAL, J. (Oral)**

1. The present appeal has been filed under Section 117(A) of the Patents Act, 1970 impugning an order dated 17th February, 2023 (hereinafter 'impugned order') passed by the Assistant Controller of Patents and Designs (hereinafter 'Assistant Controller') refusing the grant of Indian patent application no. 6093/DELNP/2013 titled '*Additive Compositions and Thermoplastic Polymer Compositions Comprising the Same*' (hereinafter 'subject application').

2. The relevant dates of the subject application are as follows:



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S. NO.	DATE	EVENT
1.	January 25, 2011	Priority application US 13/013,277 filed
2.	December 20, 2011	PCT Application (PCT/US2011/065987) filed
3.	July 08, 2013	IN 6093 filed in India
4.	July 08, 2013	Request for examination filed
5.	December 12, 2014	The application was published under the provisions of Section 11(A) of the Patents Act, 1970 as amended in 2005.
6.	August 03, 2016	Pre-grant Opposition filed by the Opponent
7.	November 10, 2017	First examination report (FER) issued by the Indian Patent Office
8.	November 10, 2017	Notice of the Opposition to the Applicant
9.	May 01, 2018	Response to First Examination Report filed.
10.	February 08, 2018	Reply Statement filed by the Appellant
11.	December 01, 2022	Hearing notice issued
12.	January 06, 2023	Hearing Date
13.	January 19, 2023	Written submissions filed by the Applicant both under section 14 and section 25(1)
14.	February 17, 2023	Decision under Section 15 of the Indian Patents Act issued refusing the grant of patent on the application
15.	May 16, 2023	Hence the present Appeal

3. Notice in this appeal was issued and accepted by Ms. Nidhi Raman,



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counsel appearing on behalf of the respondent no.1, on 1st June, 2023.

4. The matter was heard on 13th November, 2024 and 11th March, 2025.

5. Mr. Pravin Anand, counsel appearing on behalf of the appellant, submits that the Assistant Controller has not taken into account the statement of Dr. Nathan A Mehl, which was filed by the appellant along with the post-hearing written submissions.

6. He submits that Dr. Nathan A Mehl, in his statement, has dealt with the objections raised by the Controller of Patents and the grounds of refusal in the impugned order. Therefore, the matter should be remanded back to the respondent no.1 so that it can consider the statement of Dr. Nathan A Mehl and pass a *de novo* order.

7. Pursuant to the order passed by this Court on 24th January, 2025, Ms. Ragini, Assistant Controller, is also present through video-conferencing.

8. Ms. Raman submits that the subject application was filed in 2013 and the statement of Dr. Nathan A Mehl was filed only on 16th March, 2021.

9. She further submits that the statement of Dr. Nathan A Mehl does not deal with the objection raised in the subject application regarding lack of inventive step and only deals with the objection regarding insufficiency of disclosure.

10. It is also submitted that Dr. Nathan A Mehl is an employee of the appellant, and therefore he cannot be treated as an independent expert.

11. Ms. Raman also places reliance on a decision of the Board of Appeals of European Patent Office dated 1st February, 2024, whereby the Board of Appeals had rejected the statement of Dr. Nathan A Mehl, by observing as under:



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“10. ...Declaration D45 is signed by an employee of the appellant, who is not an inventor of the patent in suit, but is said to be familiar with the development work leading to the claimed invention. Moreover, that declaration is dated 16 March 2021, i.e. more than 9 years after the date of filing of the patent in suit. That declaration cannot, therefore, be considered to reflect the view of the skilled person at the filing date of the patent in suit.

In any event, that declaration rather underlines the difficulty for the skilled person in attempting to put generally into practice the method defined in operative claim 1. It is referred to point 7 of D45 in which it is highlighted that the colour space defined in granted claims 1 and 2 of the patent in suit (whereby the colour space defined in granted claim 2 corresponds to that of operative claim 1, see points 1.2 and 1.4 above) would define a very subtle degree of coloration, while a wide range of "strengths" (i.e. different coloring power for a given mass of coloring agent) are exhibited by different colouring agents.

[emphasis supplied]

12. Mr. Anand submits that the statement of Dr. Nathan A Mehl was filed by the appellant along with the post-hearing written submissions. He submits that just because the expert is an employee of the appellant would not undermine his status as an expert and the Assistant Controller should have considered his statement on merits.

13. He further submits that both the grounds of rejection, i.e., lack of inventive steps and lack of sufficiency of disclosure are interlinked and the statement of Dr. Nathan A Mehl covers both these grounds.

14. Lastly, it is submitted that the decision of Board of Appeals of the European Patent Office is not binding on the Indian Patent Office. The subject application, though refused in Europe, has been granted in various other jurisdictions such as Japan, Australia, U.S.A, etc.

15. I have heard counsel for the parties and perused the material on record.



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16. In terms of Rule 28(7)¹ of the Patent Rules, 2003, fifteen days' time from the date of hearing is granted to an applicant to file written submissions along with the relevant documents. It is not in dispute that the statement of Dr. Nathan A Mehl was filed by the appellant along with the post-hearing written submissions within the prescribed period.

17. Therefore, in my opinion, it cannot be stated that the statement of Dr. Nathan A Mehl was filed in a belated manner.

18. The fact that Dr. Nathan A Mehl was an employee of the appellant cannot by itself be a ground for non-consideration of his statement. The appellant, being involved in the development and manufacturing of chemical products, would have in its employment technical experts who would be knowledgeable on the subject matter. Therefore, I do not find any merit in the objection of the respondent no.1 that the statement of Dr. Nathan A Mehl cannot be considered since he is an employee of the appellant.

19. It is also a settled position that merely the fact that a patent has been granted or refused in another jurisdiction by itself cannot be a ground for its grant or refusal in India.

20. In this regard, a reference may be made to the judgment of a Co-ordinate Bench of this Court in ***Communication Components Antenna Inc. v. Ace Technologies Corp. and Ors.***, 2019 SCC OnLine Del 9123. The relevant observations are set out below:

“41. The language of the claims in different jurisdictions of the same convention application after it is granted in the various domestic jurisdictions, would usually never be identical. This is due to the subjectivity that exists in the prosecution process of the application, as discussed above. While determining infringement in India, the variation

¹ (7) In all cases of hearing, written submissions and the relevant documents, if any, shall be filed within fifteen days from the date of hearing.



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in the language of the claims in different jurisdictions, cannot be examined in a minute fashion. For the purposes of ascertaining infringement of a patent granted in India, the claims of the patent granted in India, need to be seen along with the complete specification. The language of the claims in corresponding foreign patents can be looked at to ensure that broadly the invention is the same and no substantive claims have been either deleted or withdrawn. International patents relating to the same patent can also be referred to in order to establish 'evergreening' of an invention. However, the granted claims in foreign jurisdictions cannot be read as though they are etched in stone. Insofar as an Indian Court are [sic] concerned, while determining the question of validity of a patent, it would be concerned primarily with the claims that have been granted in India. The unique nature of grant of patents in various jurisdictions or the wording of claims in various jurisdictions would only have a broad impact on the Indian claims, and not more.

[emphasis supplied]

21. Therefore, merely because the statement of Dr. Nathan A Mehl has not been accepted by the European Patent Office cannot by itself be the basis for the same not being considered by the Indian Patent Office. The Assistant Controller ought to have considered the aforesaid statement and taken an independent view on the merits of the averments made in the statement of Dr. Nathan A Mehl.
22. Counsel for the appellant submits that the statement of Dr. Nathan A Mehl deals with both the issue of lack of inventive steps as well as insufficiency of disclosure.
23. The aforesaid submission is rebutted by Ms. Raman.
24. In the facts and circumstances of this case, I am not required to go into this aspect. This aspect would have to be considered by the Assistant Controller.
25. Accordingly, in my view, the present appeal can be disposed of by remanding back the matter to the Assistant Controller for a *de novo*



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consideration, with the following directions:

- i. The Assistant Controller shall consider the statement of Dr. Nathan A Mehl filed on behalf of the appellant on merits;
 - ii. The Assistant Controller shall grant a fresh hearing to the appellant by issuing a hearing notice;
 - iii. After the hearing, the Assistant Controller shall pass a speaking order.
26. The appeal is disposed of in the aforesaid terms.
27. The Registry is directed to supply a copy of the present order to the Office of the Controller General of Patents, Designs & Trade Marks on the e-mail ID – llc-ipo@gov.in, for compliance.

AMIT BANSAL, J

MARCH 11, 2025

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