

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
COMMERCIAL MISCELLANEOUS PETITION NO. 1 OF 2026

Neon Laboratories Limited

...Petitioner

Versus

Controller Of Patents

...Respondent

Mr. Rashmin Khandekar, Mr. Anand Mohan, Ms. Hemlata Marathe, Ms. Annu Alexander, Mr. Vaibhav Khanna i/b. Jehangir Gulabbhai & Bilimoria & Daruwalla for Petitioner.

Mr. Ashish Mehta a/w. Ms. Seems Gupta i/b. Ethos Legal Alliance for Respondent.

CORAM : ARIF S. DOCTOR, J.

DATE : 7th MARCH 2026

P.C.

1. The matter was argued yesterday i.e. on 6th March 2026, and was stood over to today under the caption ‘for directions’ to bring to the notice of learned counsel for the parties, the decision of this Court in the case of ***Hemant Karamchand Rohera v. Controller General of Patents and Designs & Anr.***¹, in which this Court had decided the very issue in

¹ [Bombay High Court] Order dated 17th November 2025 in Commercial Miscellaneous Petition No. 11 of 2022

respect of which the preliminary objection is raised by Respondent No.

1. Learned Counsel Ms. Gupta, who today appeared on behalf of Respondent No. 1, tendered copies of the decisions upon which Respondent No. 1 was placing reliance and which were referred to in the note of written arguments tendered yesterday and submitted that the Court may proceed to decide the preliminary objection raised and argued by Mr. Mehta yesterday.
2. The captioned Commercial Miscellaneous Petition impugns an order dated 18th December 2018 ("**impugned order**") passed by Respondent No. 1 under the provisions of Section 15 of the Patents Act, 1970 ("**Patents Act**"), by which the the Petitioner's Patent Application was refused.
3. Mr. Mehta, Learned Counsel appearing on behalf of Respondent No. 1, raised a preliminary objection to the maintainability of this Petition. He pointed out that after the impugned order was passed, the Petitioner had, as per the provisions of Section 77(1)(f) of the Patents Act, filed a review of the impugned order, which was dismissed vide an order dated 7th August 2024. Learned Counsel thus submitted that the

Petitioner having availed of the remedy of review and not challenged the order dismissing the review, the present appeal filed under Section 117A of the Patents Act was not maintainable.

4. Mr. Khandekar, Learned Counsel appearing on behalf of the Petitioner, took pains to point out that what was challenged in the present Petition was not the order rejecting the Petitioner's review, i.e., the order passed under Section 77(1)(f) of the Patents Act, but only the order dated 18th December 2018, i.e., the order passed under Section 15 of the Patents Act, which he pointed out was appealable under Section 117A(2) of the Patents Act. He thus submitted that the preliminary objection was entirely misconceived and was not only based on a complete misunderstanding of the provisions of the Patents Act and the law as well settled, but also from a plain reading of the present Petition, which he reiterated did not impugn the order dismissing the review.
5. Given this, I put to Mr. Mehta as to how such a preliminary objection would lie and if he was seriously pressing the same. Mr. Mehta submitted that he had instructions from Respondent No. 1 to urge the preliminary objection since the issue was of serious importance and, if

not addressed, would open a “Pandora's box” for Respondent No. 1.

6. In the aforesaid context, he submitted that the following two issues would arise for determination, viz.
 - i. Whether a party who has availed the review remedy under Section 77(1)(f) of the Patents Act and whose review has been rejected can maintain an appeal under Section 117A of the Patents Act, which only challenges the original order of refusal and not the order passed in review.
 - ii. Whether the statutory scheme under Section 77(1)(f) read with Section 117A of the Patents Act and/or Order XLVII Rule 7 of the Civil Procedure Code, 1908 (“CPC”) permits such an appeal, or whether the appeal must be dismissed as not maintainable.
7. Mr. Mehta then tendered a note of arguments basis which he made the following submissions.
8. Mr. Mehta then invited my attention to the provisions of Order XLVII Rule 7 of the CPC to point out that the same unequivocally provides that an order rejecting an application for review is not appealable. He submitted that this was well settled, and in support of his contention,

he placed reliance upon the decisions in the case of *Rekha Mukherjee v. Ashis Kumar Das*², *Dwarkabai v. State of Maharashtra*³, *Andrews Ponnuraj Vairmani v. Controller of Patents*⁴ and *Caleb Suresh Motupalli v. Controller of Patents*⁵.

9. He submitted that Section 117A provides for an appeal only in specified circumstances set out therein and that an appeal, being a creature of statute, would not lie absent an express statutory provision. He submitted that Section 117A of the Patents Act must be read as exhaustive in the matters it makes appealable. He pointed out that Section 117A does not provide an appeal against an order passed in review under Section 77(1)(f) and thus an order passed under Section 77(1)(f) was not appealable.
10. Mr. Mehta then submitted that a person may generally elect between remedies available i.e. appeal or review, “*but the election must be made and cannot be abused to keep re-litigating the same order by*

² (2005) 3 SCC 427.

³ (2006) 6 Mh.L.J. 604.

⁴ 2012 SCC OnLine IPAB 158.

⁵ [Madras High Court] Order dated 29th January 2025 in CMA(PT) No. 2 of 2024.

*successive proceedings*⁶”. He submitted that once a party avails of the remedy of a review and the reviewing authority finally adjudicates the matter, permitting the party to ignore that adjudication and challenge only the original order would subvert the bar contained in Order XLVII Rule 7 and “*permit an end-run around statutory limits*⁷”.

11. Mr. Mehta therefore concluded by solemnly submitting that the Applicant, having consciously chosen to invoke the remedy of review under Section 77(1)(f) of the Patents Act and having pursued that remedy to its logical end, was therefore precluded from impugning the order dated 18th December 2018. He submitted that to permit this would effectively result in permitting the Petitioner to reopen the review adjudication indirectly by selectively assailing the original order, thereby defeating the statutory bar and undermining the finality of the review proceedings. This he submitted would amount to re-litigation and would be contrary to the well-established doctrine of election of remedies.

⁶ Paragraph 5 of the written note of Argument of the Respondent.

⁷ Paragraph 5 of the written note of Argument of the Respondent.

12. He thus submitted that the appeal be dismissed at the threshold as not maintainable.
13. *Per contra*, Mr. Khandekar submitted that the preliminary objection raised by Respondent No. 1 was *ex-facie* misconceived, contrary to settled law and contrary to the scheme of the Patents Act. In support of his contention, he made the following submissions.
14. He first pointed out that the contention that no appeal was maintainable under the Patents Act against an order rejecting a review under Section 77(1)(f) of the Patents Act was totally irrelevant for the simple reason that the present Petition did not assail the order passed in review but only challenges the impugned order by which the Petitioner's patent application filed under Section 15 of the Patents Act was refused. He thus submitted that all the decisions upon which reliance was placed by Respondent No. 1 were misconceived and of no relevance.
15. Mr. Khandekar submitted that the Respondent No. 1's contention that the Petitioner was precluded from filing an appeal under Section 117A of the Patents Act since the Petitioner had filed a review petition and would thus have to now challenge the order dismissing the review was

not only contrary to settled law but also to the very scheme of the Patents Act itself.

16. He submitted that it was well settled that when a review is dismissed, the party aggrieved by the rejection of the review petition has to challenge only the decree or order, as the case may be, and not the order of rejection of the review. He thus submitted that a challenge would only lie against the original order, as there is no merger on the dismissal of a review. In support of his contention, he placed reliance upon the following decisions of the Hon'ble Supreme Court *Manohar v. Jaipal Singh & Ors.*⁸, *TK David v. Kuruppampady Service Co-operative Bank Ltd. & Ors.*⁹ and *Satheesh V.K. v. The Federal Bank Ltd.*¹⁰.

17. Basis the above, Mr. Khandekar submitted that since there was no merger on dismissal of the review, the only order which survives for challenge was the impugned order. He therefore reiterated that the very foundation of the preliminary objection was in the teeth of the law as

⁸ 2008 (1) SCC 520.

⁹ 2020 (9) SCC 92.

¹⁰ 2025 SCC Online SC 2046.

well settled.

18. Mr. Khandekar, then, in dealing with the contention that a party must elect between filing a review and appeal, submitted that such a contention was not only misconceived but also does violence to the scheme of the Act, which provides for both review and appeal as separate/distinct remedies under separate and distinct Chapters of the Patents Act. He pointed out that there was nothing in the language of the Patents Act to show that the two remedies were mutually exclusive and that it is trite law that a review and appeal are distinct remedies, the scope of which are also different.
19. He therefore submitted that it was absurd for Respondent No. 1 to suggest that the Petitioner having availed of the narrower remedy of a review, was precluded from exercising the substantive statutory remedy of an appeal. He reiterated that the scheme of the Patents Act itself shows that the two remedies were separate and distinct and both could, in fact, be concurrently availed of. He thus submitted that the question of any election between the filing of a review and an appeal does not arise.

20. Basis the above, he submitted that there was no merit in the preliminary objection raised by the Controller and that such objection was infact contrary to the settled law and to the scheme/provisions of the Patents Act. He thus submitted that the appeal may accordingly be expeditiously heard on merits.

21. After having heard learned counsel for the parties and having perused the Petition, in particular the relief that has been sought for, I find that the preliminary objection raised by the Controller is not only misconceived and untenable but has also resulted in a complete waste of judicial time. I say so for the following reasons:

A. It is not in dispute that the Petitioner has only impugned the order dated 18th December, 2018, passed under Section 15 of the Patents Act, by which the Petitioner's Patent was refused, and has not impugned the order dated 7th August, 2024, passed under Section 77(1)(f) of the Patents Act, by which the Petitioner's review was dismissed.

B. It is also not in dispute that orders passed under Section 15 of the Patents Act are specifically appealable under Section 117A

of the Patents Act. A perusal of the Patents Act makes it clear that the provisions for appeal and review are contained in two different chapters of the Patents Act and are, on the face of it, separate and distinct remedies under the Patents Act. Furthermore and crucially, there is nothing in the Patents Act to even remotely suggest that (i) a party would have to elect between filing a review and an appeal, and (ii) after having so elected, the party would have to forgo the other.

- C. The preliminary objection of the Controller proceeds on the fundamentally flawed and legally untenable basis that on the dismissal of a review, the doctrine of merger would apply and the order passed under Section 15 would merge with the order passed in review. Such contention is not only contrary to the plain scheme of the Patents Act but also to the settled law, as laid down in a catena of decisions of the Hon'ble Supreme Court, all of which unequivocally hold that on a dismissal of a review petition, there is no merger. In this context it is useful to quote the findings of the Hon'ble Supreme Court, in the case of

TK David v. Kuruppampady Service Co-operative Bank Ltd. &

Ors., which has in paragraph 14 *inter alia* held as follows viz.

“3. We find ourselves unable to agree with the views expressed by this Court in Eastern Coalfields Ltd. In our view, once the High Court has refused to entertain the review petition and the same was dismissed confirming the main order, there is no question of any merger and the aggrieved person has to challenge the main order and not the order dismissing the review petition because on the dismissal of the review petition the principle of merger does not apply.” (emphasis supplied)

- D. While the entire preliminary objection of the Controller is based on the provisions of Order XLVII Rule 7 of the CPC, there is really no quarrel with the proposition that an appeal is not maintainable from an order dismissing a review. However, as already noted above in ‘(A)’ above, the present Petition does not impugn the order dismissing the Petitioner’s review but is confined solely to impugning the order dated 18th December, 2018 i.e. the order of refusal passed under Section 15. Thus, on the face of it, the bar under Order XLVII Rule 7 of the CPC is

not attracted in the present case and hence none of the decisions upon which reliance has been placed by the Controller would infact apply.

- E. To accept the contention of the Controller would effectively mean to defeat and take away the statutory right of appeal under Section 117A of the Patents Act of a party whose patent application has been refused under Section 15.
- F. Also, crucially, this Court had, in the case of ***Hemant Karamchand Rohera v. Controller General of Patents and Designs & Anr.***, already negated the identical objection raised by the Controller by *inter alia* holding as follows, viz.

“21. (G)..... (i) there is no bar under the Patents Act on pursuing the remedies of review and appeal either simultaneously or sequentially. The statutory scheme of the Patents Act does not treat the filing of a review as an election of remedies which would foreclose the right of an aggrieved party to subsequently file an appeal; (ii) the doctrine of merger does not apply since the review petition was dismissed at the threshold.”

22. Regrettably, despite the above, the Controller has once again raised the

same objection, which has resulted in a sheer waste of judicial time. Such conduct would have ordinarily resulted in an order of costs, which I am not imposing in the hope that going forward, the Controller does not seek to repeatedly re-agitate issues which have been decided, leaving aside the sheer frivolity of the nature of the objections taken. It is really this “Pandora’s Box” which the Controller must ensure remains shut tight.

23. Hence, for the reasons set out in (A) to (F) above, the preliminary objection raised by Controller to the maintainability of present Petition is rejected.
24. The Petition therefore, shall proceed on merits.
25. Stand over to **13th March 2026** under the caption ‘for hearing’.

[ARIF S. DOCTOR, J.]