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IN THE HIGH COURT OF DELHI AT NEW DELHI

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C.A.(COMM.IPD-PAT) 34/2024

NORDSON CORPORATION

.....Appellant

Through: Mr. Debashish Banerjee and Ms.
Gurneet Kaur, Advocates.

versus

THE CONTROLLER OF PATENTS

.....Respondent

Through: Mr. Jagdish Chandra, CGSC with Mr.
Sujeet Chaudhary and Ms. Maanya Saxena,
Advocates.

CORAM:

HON'BLE MS. JUSTICE JYOTI SINGH

ORDER

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08.04.2026

1. This appeal is filed on behalf of the Appellant under Section 117A of the Patents Act, 1970 (hereinafter '1970 Act') laying a challenge to order dated 11.01.2024 passed by the Respondent in Indian Patent Application No. 8083/DELNP/2013 (hereinafter 'subject patent application'). The subject patent application, titled "*System Nozzle and Method for Coating Elastic Strands*", was filed before the Patent Office, Delhi on 16.09.2013 as a national phase application entering India from PCT International Application No. PCT/US2012/032893 dated 10.04.2012. The subject patent application claims priority from United States Provisional Application No. 61/474129 dated 11.04.2011.
2. Appellant filed a Request for Examination dated 16.02.2015 under Section 11B and Rule 24B of the 1970 Act and the Patents Rules, 2003 respectively. The subject patent application was published on 22.04.2016.



Pursuant to the Request for Examination, the Patent Office examined the subject patent application, and a First Examination Report (hereinafter “*FER*”) dated 20.11.2018 was issued by the Respondent. The primary objections raised in the FER related to lack of novelty and inventive step under Sections 2(1)(j) and 2(1)(ja) of the 1970 Act in view of cited prior art document D1: GB 1455469A, as well as objections pertaining to clarity and conciseness under Section 10(4)(c) of the 1970 Act.

3. Appellant filed a response to the FER dated 17.05.2019, along with an amended set of Claims, attempting to address all the objections raised therein. During the pendency of the application, Appellant also complied with the requirements under Section 8(1) of the 1970 Act by filing Form 3 on multiple occasions. Thereafter, vide communication dated 07.11.2023, Respondent issued a Hearing Notice scheduling a hearing under Section 14 of the 1970 Act on 08.12.2023. The objections maintained in the Hearing Notice pertained to clarity and conciseness of claims under Section 10(4)(c) of the 1970 Act and a fresh objection under Section 2(1)(ja) of the 1970 Act alleging lack of inventive step in view of newly cited prior art documents, namely D2: US2004144494A1, D3: US20030173018, and D4: US20100024987, was raised.

4. Appellant’s agent attended the hearing on 08.12.2023 and contested the objections raised in the Hearing Notice. Post the hearing, Appellant filed written submissions on 18.12.2023 along with an amended set of Claims comprising Claims 1 to 68, addressing the objections raised in the Hearing Notice and requesting that in case of any further objection or outstanding requirement, an opportunity of hearing be granted before any adverse decision was taken. However, Respondent passed the impugned order dated



11.01.2024 refusing the subject patent application under Section 15 of the 1970 Act on the ground that the amended Claims 1-68 filed on 18.12.2023 did not satisfy the requirement of Section 10(4)(c) of the 1970 Act owing to lack of clarity and consequently, analysis of inventive step under Section 2(1)(ja) of the 1970 Act was “*unwarranted at this stage and cannot be analyzed.*” Aggrieved by the said order, the Appellant has preferred the present appeal.

5. Learned counsel for the Appellant submits that impugned order dated 11.01.2024 is liable to be set aside on multiple grounds including flagrant violations of principles of natural justice and required procedure and merits and the matter deserves to be remanded to the Respondent for a fresh decision. It is urged that the Hearing Notice dated 07.11.2023 raised a specific and narrow objection under Section 10(4)(c) of the 1970 Act to the effect that the use of the phrase “*further comprising*” in the identified dependent claims rendered those claims vague and unclear. Appellant responded directly and precisely to this objection by deleting the word “*further*” from each of the identified dependent claims and filed an amended set of claims on 18.12.2023. By the impugned order, the application is refused on an entirely new ground that the deletion of “*further*” had the consequence of converting previously optional features into essential features of the principal claim, thereby impermissibly widening the scope of the invention, but this objection was never communicated to the Appellant in any prior written communication and was raised for the first time in the final refusal order under Section 15 of the 1970 Act. Therefore, clearly Appellant had no notice of this ground and no opportunity to address it. Reliance is placed on the decision of a Coordinate Bench of this Court in



PerkinElmer Health Sciences Inc. and Ors. v. Controller of Patents, C.A.(COMM.IPD-PAT) 311/2022, decided on 04.01.2023, in support of the proposition that raising a fresh objection for the first time in a refusal order, without prior notice to the applicant violates principles of natural justice and vitiates the order. Reliance is further placed on the decision of the Supreme Court in ***Competition Commission of India v. Steel Authority of India Limited and Another, (2010) 10 SCC 744***, wherein it was held that the twin ingredients of natural justice require, firstly, that the person likely to be adversely affected be given notice and an opportunity of hearing and secondly, the order passed must give reasons reflecting proper application of mind and that violation of either of the two shall vitiate the order. It is additionally submitted that Appellant had expressly requested in its post-hearing written submissions dated 18.12.2023 that if the Respondent found any further objection and/or needed clarification, an opportunity of hearing be granted before taking a final decision adverse to the Appellant. However, this request was completely overlooked.

6. Learned counsel further submits that Claim 1, being the principal claim of the subject patent application, was not objected to under Section 10(4)(c) of the 1970 Act in the Hearing Notice. The objection pertaining to “*further comprising*” was directed at specific dependent claims only. The impugned order, however, purports to find the entire claim set including Claim 1 unclear under Section 10(4)(c) of the 1970 Act, thereby raising a fresh objection against Claim 1 for the first time in the refusal order without affording the Appellant any opportunity to address it. It is submitted that Claim 1 stands in an allowable form under the scheme of Sections 12 to 15 of the 1970 Act.



7. On the merits of the finding under Section 10(4)(c) of the 1970 Act, learned counsel submits that Respondent's conclusion that deletion of 'further' from the dependent claims widened the scope of the principal claims, is legally and technically erroneous. Expression 'comprising' is universally recognised as an open-ended transitional phrase meaning "including but not limited to," and presence or absence of the word 'further' preceding 'comprising' does not alter this character or the scope of the claim. Reliance is placed on *F. Hoffmann-La Roche Ltd. & Anr. v. Cipla Ltd., 2015 SCC OnLine Del 13619* and *Novartis AG and Others v. Natco Pharma Limited, 2021 SCC OnLine Del 4849*, both decisions of this Court, in support of the open-ended character of the word 'comprising'. It is pointed out that Patent Office's own *Manual of Patent Office Practice and Procedure* recognises 'comprising' as a permissible transition phrase, rendering Respondent's objection contrary to his own office's practice.

8. It is urged that the impugned order places the Appellant in an unenviable position where the neither the language of pre-amendment claims nor post-amendment claims survives legal scrutiny, as per the Respondent and that too without identifying the formulation that would satisfy the requirement. Respondent's direction to consolidate all process steps into a single method claim has no foundation either under the 1970 Act or the Patents Rules, 2003 and his informal oral suggestion to conform the Claims to corresponding European Patent Claims has no statutory basis and is even otherwise not understood, considering that the corresponding European Claims which stand granted, themselves employ the phrase "further comprising" in the dependent claims.

9. Learned counsel further submits that Sections 10(4)(c) and 2(1)(ja) of



the 1970 Act are independent statutory requirements and no provision of the 1970 Act permits the Controller to decline examination of one on account of the other being contentious. Appellant had placed on record detailed technical submissions on inventive step demonstrating that the combination of prior art documents D2, D3 and D4 does not disclose the feature of “*encompassing at least a portion of the periphery of the first elastic strand,*”, which is central to each of the independent claims. It is pointed out that D3 is a non-contact spray nozzle whose tip is expressly described as being spaced at a distance from the strand, rendering it structurally and functionally incapable of encompassing any portion of the strand’s periphery. The complete failure to engage with these submissions is an independent ground vitiating the order, in light of the decisions in ***CCI v. SAIL (supra)*** and ***Allergan Inc. v. Controller of Patents, 2023 SCC OnLine Del 295***.

10. In view of the foregoing, learned counsel for the Appellant prays that the impugned order dated 11.01.2024 be set aside and the matter be remanded to the Respondent for a fresh decision, with a direction to issue a fresh hearing notice identifying any remaining defects in the amended claims, afford the Appellant an opportunity to respond thereto and pass a fresh speaking order, addressing both Section 10(4)(c) and Section 2(1)(ja) independently and with reasons.

11. Learned counsel appearing for the Respondent submits that the impugned order dated 11.01.2024 has been passed in consonance with the scheme of 1970 Act after affording an opportunity of hearing to the Appellant to address the outstanding objections and refusal under Section 15 of the 1970 Act is fully justified. It is wrong to allege that there are



violations of principles of natural justice inasmuch as Hearing Notice was issued, pursuant to which authorised agent of the Appellant attended the hearing and also filed post-hearing written submissions, which were duly considered before the impugned order was passed.

12. It is submitted that refusal is not premised on a new ground but as a direct consequence of Appellant's own amendment to the claims. The objection in the Hearing Notice was to lack of clarity caused by the phrase '*further comprising*', and Respondent's finding that deletion of '*further*' converted previously optional dependent claim features into essential features, without incorporating them into the principal claim is a finding *qua* the same objection and is not a fresh one. It is further contended that the post-amendment claims dated 18.12.2023 are broader and more ambiguous than the pre-amendment claims dated 17.05.2019 and Appellant's minimalist response of deleting one word rather than undertaking substantive redrafting reflects a failure to comply with the requirements of Section 10(4)(c) of the 1970 Act.

13. On lack of inventive step, it is submitted that clarity of claims under Section 10(4)(c) of the 1970 Act is a pre-condition to the analysis under Section 2(1)(ja) of the 1970 Act and since amended claims failed to satisfy the requirements of Section 10(4)(c), the inventive step analysis could not have been meaningfully conducted. No foreign grant confers any right to grant in India and Indian examination is a wholly independent process. In view of the foregoing, learned counsel for the Respondent prays that the present appeal be dismissed and impugned order be upheld.

14. This Court has considered the submissions of learned counsel for both parties and has perused the record. The only question that falls for



consideration in the present appeal is whether the impugned order passed by the Respondent under Section 15 of the 1970 Act is sustainable in law.

15. The undisputed factual position is that in the Hearing Notice dated 07.11.2023, Respondent raised a specific objection under Section 10(4)(c) of the 1970 Act to the use of the phrase '*further comprising*' in identified dependent claims on the ground that the said phrase rendered those claims vague and unclear. Appellant responded to this objection by deleting the word '*further*' from each of the identified claims and filed an amended set of claims on 18.12.2023. The impugned order then refused the application on the ground that deletion of '*further*' had converted previously optional dependent claim features into essential features of the principal claim, thereby widening and obscuring the scope of the invention.

16. It is manifest from a comparison of the Hearing Notice and the impugned order that the ground on which refusal was ultimately ordered i.e deletion of '*further*' impermissibly widened the claim scope, was never raised in the Hearing Notice and indisputably, never communicated to the Appellant in any prior written communication and indeed surfaced for the first time in the final order passed under Section 15 of the 1970 Act. Appellant had no notice of this ground and no opportunity to address it. It is also relevant to note that the authorised agent of the Appellant was not in a position to seek and obtain instructions from the Appellant in real time on any new ground that may have been orally discussed during the course of the proceedings. This constraint renders it even more imperative that any new ground emerging from the hearing ought to have been formally communicated to the Appellant in writing, affording it a proper opportunity to respond before any adverse decision was taken.



17. In my view, this is a textbook case of violation of the principle of *audi alteram partem*. A coordinate bench of this Court in ***PerkinElmer (supra)***, has categorically held that raising a fresh objection for the first time in a refusal order, without prior notice to the applicant, vitiates the order. The Supreme Court in ***CCI v. SAIL (supra)***, has also held that the twin requirements of notice and reasoned decision are essential ingredients of natural justice, violation of either of which can vitiate an order. The impugned order falls squarely within the vice identified in these decisions.

18. The violation of natural justice is further compounded by the fact that Appellant had expressly requested in its post-hearing written submissions that if any further objection remained, an opportunity of hearing be granted before any adverse decision is taken. However, Respondent passed the impugned order without acknowledging, let alone acting upon, this request. This constitutes an independent denial of natural justice. This position stands judicially recognised in a plethora of decisions of this Court, including in ***Best Agrolife Limited v. Deputy Controller of Patents & Another, 2022 SCC OnLine Del 1982***, wherein this Court remanded an order passed by the Controller on the ground that the original order lacked reasoning, thereby violating the principles of natural justice, as not all grounds raised by the party had been considered and addressed before the adverse order was passed.

19. This Court also finds merit in the Appellant's submission that Claim 1, the principal claim, was not objected to under Section 10(4)(c) of the 1970 Act in the Hearing Notice. The term "*further comprising*" objection was directed at specific dependent claims only and the sole objection against Claim 1 was under Section 2(1)(ja) of the 1970 Act. The



impugned order, however, finds the entire claim set including Claim 1 unclear under Section 10(4)(c) of the 1970 Act, raising a fresh objection against the principal claim for the first time at the stage of passing the refusal order. This is squarely impermissible, as it is well-settled that an applicant must be given prior notice of every ground on which an adverse order is proposed to be passed and Controller cannot, under the guise of Section 15 of the 1970 Act, travel beyond the objections communicated in the examination process. As held by this Court in *PerkinElmer (supra)*, an order of refusal founded on grounds not previously notified to the applicant cannot be sustained.

20. On the merits of the finding under Section 10(4)(c) of the 1970 Act, this Court refrains from expressing any opinion on whether the deletion of ‘further’ from the dependent claims did or did not alter the scope of the claims. That is a question which must be examined afresh by the Respondent with proper notice to the Appellant and after granting hearing. Appellant is also right that the impugned order is non-speaking order in respect of the inventive step objection under Section 2(1)(ja) of the 1970 Act. Sections 10(4)(c) and 2(1)(ja) of the 1970 Act are independent statutory requirements and no provision of the said Act permits the Controller to decline examination of inventive step on the ground that a clarity objection remains unresolved. Appellant had placed on record technical submissions on inventive step which were acknowledged but not engaged with at all. The complete absence of reasoning on an independently raised statutory ground is a further infirmity in the impugned order.

21. It is well settled, as held by the Supreme Court in *CCI v. SAIL (supra)* and followed by this Court in *Allergan Inc. (supra)*, that reasons are



the soul of an order and that an order devoid of reasoning on a material ground cannot be sustained. This Court in *Agriboard International LLC v. Deputy Controller of Patents and Designs, 2022 SCC OnLine Del 940*, held that rejection of a patent application for lack of inventive step without detailed analysis violates natural justice and that the Controller must consider three essential elements: (1) the invention disclosed in the prior art; (2) the invention disclosed in the application under consideration; and (3) manner in which the subject invention would be obvious to a person skilled in the art. An order that entirely declines to conduct this analysis, as in the present case, is on an even weaker footing than one that conducts it inadequately. This view finds further support in the recent decision of the Bombay High Court in *JFE Steel Corporation v. The Controller of Patents & Designs, 2026:BHC-OS:4866*, wherein it was held that rejection of a patent application solely on the ground of non-compliance with Section 10(4) of the 1970 Act, without any independent analysis or finding on the substantive requirements of novelty and inventive step, is clearly bad in law and cannot be sustained.

22. For all the foregoing reasons, the impugned order dated 11.01.2024 cannot be sustained and is hereby set aside. This Court, however, refrains from expressing any opinion on the merits of the patentability of the subject patent application, as the same falls entirely within the domain of the Respondent to examine afresh. The matter is remanded to the Respondent with the following directions:

- (i) Respondent shall issue a fresh Hearing Notice to the Appellant clearly identifying all pending objections with respect to the subject patent application, including objections, if any, under Section 10(4)(c)



and Section 2(1)(ja) of the 1970 Act;

(ii) Upon receipt of the fresh Hearing Notice, Appellant shall be entitled to file written submissions in response thereto prior to the hearing, within a period of four weeks from the date of receipt of such notice;

(iii) Hearing shall thereafter be conducted by the Respondent giving an opportunity of hearing to the Appellant and it will be open to the Appellant to file post-hearing written submissions within two weeks from the date of the hearing;

(iv) Respondent shall thereafter pass a fresh and reasoned order addressing all pending objections independently and on their own merits, including both Section 10(4)(c) and Section 2(1)(ja) of the 1970 Act, within twelve weeks from the date of the hearing; and

(v) The fresh order shall be a speaking order, setting out the Respondent's reasoning on each ground raised.

23. The appeal is partially allowed and disposed of in the above terms.

JYOTI SINGH, J

APRIL 8, 2026/RW