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

+ **C.A.(COMM.IPD-PAT) 56/2024**

DAIKIN INDUSTRIES LTD

.....Appellant

Through: Mr. Tanveer Malhotra and Mr. Vineet
Rohilla, Advocates.

versus

**ASSISTANT CONTROLLER OF PATENTS
AND DESIGNS**

.....Respondent

Through: Mr. Ankur Mittal, CGSC with Ms.
Rabaica Jaiswal and Mr. Hrithik Saxena,
Advocates.

**CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH**

ORDER
26.02.2026

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1. This appeal is filed on behalf of the Appellant under Section 117A(2) of the Patents Act, 1970 ('1970 Act') laying a challenge to order dated 10.04.2024 passed by the Respondent refusing grant of Indian Patent Application filed on 23.06.2022 with priority date from JP Patent Application No. 2020-003842 dated 14.01.2020.

2. As pleaded in the appeal, the subject application is a national phase application of PCT Application No. PCT/JP2020/043546 dated 24.11.2020 with 11 claims. Appellant filed a formal request on Form-13 dated 24.06.2022 for amending the claims along with amended claims 1-5 followed by a request on 08.07.2022 for examination of the application. On 10.11.2022, Patent Office examined the application and issued the First



Examination Report ('FER') *inter alia* raising objection of lack of inventive step under Section 2(1)(ja) of the 1970 Act *qua* claims 1-5 in light of prior art documents D1-D4.

3. Detailed response was filed by the Appellant to the objections raised in the FER along with amended claims and supporting documents on 09.02.2023. The application was further examined looking into the response. In the hearing notice dated 26.02.2024, Respondent cited new prior art document D1: US3840070A and raised an objection that the invention lacked novelty. In the hearing on 20.03.2024, arguments were addressed on behalf of the Appellant on the objections raised and subsequently written submissions were filed. However, vide order dated 10.04.2024, Respondent refused the subject application on the ground that the claimed invention lacks novelty in view of the disclosures in cited prior art D1: US3840070A.

4. At the outset, without entering into the merits of the case that D1: US3840070A is an old patent filed in 1972 and does not disclose the features of claimed invention, learned counsel for the Appellant submits that Appellant has filed proposed amended claim as an Auxiliary Request along with the appeal before this Court, which is based on incorporation of claim 2 into the main claim and the amendment is well supported by original description and claims. Appellant has also filed an additional Auxiliary Request along with the written note of submissions, where proposed amended claims is identical to the claim granted by the United States Patent and Trademark Office ('USPTO'). Prior art D1: US3840070A was also considered by USPTO before grant of US Application. In light of this, it is urged that the proposed amendment be allowed as it falls within the scope of Section 59 of 1970 Act and permission be granted to the Appellant to file



complete amended specifications including amended claim before the Patent Office for fresh examination.

5. Learned counsel for the Respondent, fairly and candidly, does not dispute the position of law that amendments to the claims can be carried out at the appellate stage, if warranted.

6. Heard.

7. The subject invention relates to a Shell-And-Plate Heat Exchanger and the object of invention is to improve the heat exchange efficiency of a shell-and-plate heat exchanger. Claim 1 of the subject application as rejected by the Respondent on ground of lack of novelty in view of cited prior art document D1: US3840070A is as follows:-

- “1. A shell-and-plate heat exchanger comprising:
a shell (10) forming an internal space (15); and
a plate stack (20) housed in the internal space (15) of the shell (10) and including a plurality of heat transfer plates (21) stacked and joined together,
the shell-and-plate heat exchanger allowing a refrigerant that has flowed into the internal space (15) of the shell (10) to be condensed, wherein
a refrigerant channel (24) that communicates with the internal space (15) of the shell (10) and allows the refrigerant to flow through and a heating medium channel (25) that is blocked from the internal space (15) of the shell (10) and allows a heating medium to flow through are alternately arranged between adjacent plates (21) of the plurality of heat transfer plates (21), a meandering portion (28, 29, 31) configured to meander the refrigerant condensed on a surface of each of the plurality of heat transfer plates (21) is provided in at least a lower portion of the plate stack (20), and
the meandering portion (28, 29, 31) is provided by processing the plurality of heat transfer plates (21).”

8. During the pendency of this appeal, Appellant has filed an additional Auxiliary Request and seeks to amend claim 1 and it is urged that proposed



amended claim 1 is identical to claim granted by USPTO, wherein D1: US3840070A was also considered before grant of the US Application.

Proposed amended claim 1 is as follows:-

“1. *A shell-and-plate heat exchanger comprising:*
a shell (10) forming an internal space (15); and
a plate stack (20) housed in the internal space (15) of the shell (10), ~~the plate stack (20) and~~ including a plurality of heat transfer plates (21) stacked and joined together,
the shell-and-plate heat exchanger being configured to allow ~~allowing~~ a refrigerant that has flowed into the internal space (15) of the shell (10) to be condensed, ~~wherein~~
a refrigerant channel (24) ~~that communicates~~ communicating with the internal space (15) of the shell (10) and being configured to allow ~~allows~~ the refrigerant to flow through, ~~and~~ a heating medium channel (25) ~~that is~~ blocked from the internal space (15) of the shell (10) and being configured to allow ~~allows~~ a heating medium to flow through, and the refrigerant channel (24) and the heating medium (25) being ~~are~~ alternately arranged between adjacent plates (21) of the plurality of heat transfer plates (21), and
a meandering portion (28, 29, 31) being provided in a lower portion of the plate stack (20) but no meandering portion being provided in an upper portion of the plate stack, the
~~a~~ meandering portion (28, 29, 31) being configured to meander the refrigerant condensed on a surface of each of the plurality of heat transfer plates (21), ~~is provided in at least a lower portion of the plate stack (20),~~
~~and~~
the meandering portion (28, 29, 31) ~~is~~ being provided by processing the plurality of heat transfer plates (21).”

9. Parties are *ad idem* that amendments can be carried out even at the appellate stage. In this context, I may refer to the decision of this Court in ***Fresenius Medical Care Deutschland GmbH v. Controller General of Patents, Designs and Trademarks and Another, 2025 SCC OnLine Del 2721***, wherein the Court allowed the amendment relying on two earlier decisions of this Court. Relevant passages are as follows:-



“11. In Societe Des Produits Nestle SA v. Controller of Patents and Designs, 2023 SCC OnLine Del 582, I have held that the High Court, while hearing an appeal against a refusal order passed by the Controller, would have the same powers as given to a Controller under Section 15 of the Act, which includes the powers to require amendment. Therefore, the Court is within its power to direct the Appellant to amend the complete specification of the patent application including claims at this stage.

12. The aforesaid observations made in Nestle SA v. Controller of Patents (supra) were also relied on by another Coordinate Bench of this Court in Opentv Inc. v. Controller of Patents, 2023 SCC OnLine Del 2771 wherein it was noted that irrespective of the amendments to the claims or complete specification of a patent application being made at the behest of the applicant or the Court, amendments are allowed at the appellate stage before Court. The relevant paragraph of the said judgment is given below:

“54. Thus, amendments having been held to be permissible at the appellate stage, this Court is of the opinion that irrespective of whether the amendment is directed by the Court or is at the instance of Patent Applicant, so long as the requirements as laid down under Section 59 of the Act are fulfilled such that the amended claims are within the scope of original claims, is not breached, the amendment is permissible.”

“61. Therefore, though there is no embargo on permitting a Patent Applicant to amend claims even at the appellate stage, the amendment sought in this particular case intends to widen the scope of the original claims as filed. It is due to this reason that the same cannot be allowed.”

[Emphasis supplied]”

10. Section 59 of 1970 Act deals with amendment of patent applications and provides that: (a) an amendment to a patent application, including the complete specification, can be made only by way of ‘disclaimer’, ‘correction’ or ‘explanation’; (b) amendment has to be for the purpose of incorporation of actual facts; and (c) amendment cannot be in respect of matters not disclosed in the specification prior to the amendment and the amended claims have to fall within the scope of claims as originally filed. Having considered the proposed amendment to claim 1, I am of the view



that the amendment sought does not broaden the scope of unamended claim in any manner and its subject matter is disclosed in the specification.

11. Therefore, the proposed amendment to claim 1 is allowed being within the scope of Section 59 of 1970 Act and amended claim is taken on record. Appellant shall file the complete amended specification including amended claim before the Patent Office and as and when the needful is done, Patent Office shall proceed to examine the matter afresh taking into account the amended claim.

12. Accordingly, this appeal is partially allowed setting aside the impugned order dated 10.04.2024 and remanding the matter back to the Respondent for taking a fresh decision after giving a fresh hearing notice to the Appellant. It is expected that the Respondent shall endeavour to take the decision as expeditiously as possible and in any event not later than two months from the date the amended specification and claim are filed.

13. The appeal stands disposed of, making it clear that this Court has not expressed any opinion on the merits of the case.

JYOTI SINGH, J

FEBRUARY 26, 2026/YA