



2025:DHC:5338



\$~

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ C.A.(COMM.IPD-PAT) 19/2022, I.A. 10452/2022 & I.A.
35045/2024

ALBEMARLE CORPORATIONAppellant

Through: Mr. Ankush Verma, Mr. Debashish Banerjee, Ms. Vaishali Joshi, Mr. Pankaj Soni, Mr. Vineet Rohilla, Mr. Rohit, Mr. Tanveer Malhotra and Ms. Gurneet Kaur, Advocates
Mob: 9971799662

versus

THE CONTROLLER OF PATENTSRespondent

Through: Ms. Anubha Bhardwaj, CGSC with Ms. Muskan Narang, Advocate
Mob: 9811503304
Email:
anubhabhardwajcgsc@gmail.com

CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA

JUDGMENT
07.07.2025

%

MINI PUSHKARNA, J:

1. The appellant, Albemarle Corporation, a company incorporated in the United States of America, prefers the present appeal under Section 117A of the Patents Act, 1970 ("Patents Act") against the impugned order dated 12th May, 2021, passed by the Controller of Patents, whereby, Indian *Patent Application No. 2897/DELNP/2012* ("subject application"), was refused



under Section 15 of the Patents Act, in respect of the invention, titled as *“SOLVENT SYSTEMS HAVING NO FLASH POINT AND METHODS USING SUCH SOLVENT SYSTEMS FOR DISSOLVING RIGID POLYURETHANE FOAMS”*.

2. The appellant’s patent application has been refused under Section 15 of the Patents Act on the grounds that the subject matter of the claims or inventions in the subject application, lacks novelty over cited document D4, lacks inventive step in view of cited documents, i.e., D1-D4 and does not meet the enablement requirement under Section 10(4) of the Patents Act.

3. The appellant had filed the subject application on 04th April, 2012. The respondent issued a First Examination Report (“FER”) on 26th October, 2017, raising various formal and technical objections. The appellant submitted a detailed response to the FER on 21st March, 2018, and thereafter attended hearings on 19th October, 2020 and 23rd February, 2021. In support of its case, the appellant also filed written submissions on 06th October, 2020, 03rd November, 2020, and 10th March, 2021.

4. The subject application was refused by the respondent, aggrieved by which, the appellant has preferred the present appeal.

5. During the pendency of the present appeal, the appellant filed an application being *I.A. No. 35045/2024*, for filing an auxiliary set of claims. Learned counsel appearing for the appellant submitted that in order to aid expeditious disposal of the present matter, the appellant has filed an auxiliary claim set. It is submitted that this auxiliary claim set restricts the scope of the claims presently on record, solely to the *process* aspect, for cleaning polyurethane foam from an article.



6. *Per contra*, learned counsel appearing for the respondent submitted that no amended claims can be allowed at the appellate stage and justified the impugned order.

7. I have heard learned counsels for the parties and have perused the record.

8. At the outset, this Court notes that the appellant did not press its challenge to the impugned order and confined the submissions only on the aspect of allowing the amendments in terms of the application being *I.A. No. 35045/2024*. By way of the amendment, the appellant sought to restrict the scope of the claims to the *process* aspect for cleaning polyurethane foam from an article.

9. The original claims filed by the appellant, are as follows:

“xxx xxx xxx

We claim

1. A solvent system produced by combining components consisting of: (a) from 20 wt% to 90 wt% of a brominated compound, (b) from 10 wt% to 80 wt% of an alcohol consisting of a primary alcohol and/or a secondary alcohol, and (c) from 0.05 wt% to 6.0 wt% of a stabilizer consisting of an epoxide, a nitroalkane, and/or an ether, wherein the ether is selected from the group consisting of 1, 2-dimethoxyethane, 1,4- dioxane, 1,3-dioxolane, diethyl ether, diisopropyl ether, dibutyl ether, trioxane, alkyl cellosolves in which the alkyl group has 1 to 10 carbon atoms, dimethyl acetal, butyrolactone, methyl t-butyl ether, and tetrahydrofuran, wherein the amounts of the brominated compound, the alcohol, and the stabilizer are selected so that the solvent system has no flash point and when used for removing polyurethane foam from a surface produces a used solvent having essentially no gel formation.

2. The composition as claimed in claim 1, wherein the brominated compound comprises n-propyl bromide.

3. The composition as claimed in claim 2, wherein the alcohol comprises methanol, ethanol, 1-propanol, 1-butanol, 1-pentanol, 2-propanol and/or 2-butanol.

4. The composition as claimed in claim 1, wherein the nitroalkane is nitromethane and/or nitroethane, and the epoxide is 1,2-epoxybutane.



5. A process for cleaning polyurethane foam from an article, said process consisting of:

- (i) contacting the polyurethane foam with a solvent system produced by combining components consisting of: (a) from 20 wt% to 90 wt% of a brominated compound, (b) from 10 wt% to 80 wt% of an alcohol consisting of a primary alcohol and/or secondary alcohol, and (c) from 0.05 wt% to 6.0 wt% of a stabilizer consisting of an epoxide, a nitroalkane, and/or an ether, wherein the amounts of the brominated compound, the alcohol, and the stabilizer are selected so that the solvent system has no flash point and when used for removing polyurethane foam from a surface produces a used solvent having essentially no gel formation; and
- (ii) thereby producing used solvent, wherein there is essentially no gel formation in the used solvent.

6. The process as claimed in claim 5, wherein the brominated compound comprises n-propyl bromide.

7. The process as claimed in claim 5, wherein the alcohol comprises methanol, ethanol, 1-propanol, 1-butanol, 1-pentanol, 2-propanol and/or 2-butanol.

8. The process as claimed in claim 5, wherein the nitroalkane is nitromethane and/or nitroethane, and the epoxide is 1,2-epoxybutane.

9. The process as claimed in claim 5, wherein the article is a nozzle or a pipe being used in a polyurethane foaming process.

xxx xxx xxx”

10. The amended auxiliary claims, as filed by the appellant before this Court, are as under:

“xxx xxx xxx

We Claim

1. A process for cleaning polyurethane foam from an article, said process consisting of:

- (i) contacting the polyurethane foam with a solvent system produced by combining components consisting of: (a) from 20 wt% to 89.05 wt% of a brominated compound, (b) from 10 wt% to 79.05 wt% of an alcohol consisting of a primary alcohol and/or secondary alcohol, and (c) from 0.05 wt% to 6.0 wt% of a stabilizer consisting of an epoxide, a nitroalkane, and/or an ether, wherein the amounts of the brominated compound, the alcohol, and the stabilizer are selected so that the solvent system has no flash point; and



(ii) thereby producing used solvent, wherein there is essentially no gel formation in the used solvent.

2. The process as claimed in claim 1, wherein the brominated compound is *n*-propyl bromide.

3. The process as claimed in claim 1, wherein the alcohol comprises methanol, ethanol, 1-propanol, 1-butanol, 1-pentanol, 2-propanol and/or 2-butanol.

4. The process as claimed in claim 1, wherein the nitroalkane is nitromethane and/or nitroethane, and the epoxide is 1,2-epoxybutane.

5. The process as claimed in claim 1, wherein the article is a nozzle or a pipe being used in a polyurethane foaming process.

6. The process as claimed in claim 1, wherein the brominated compound of (a) is *n*-propyl bromide, the alcohol of (b) is 1-propanol and/or 2-butanol, and the stabilizer of (c) is (i) 1,2-epoxybutane and (ii) nitromethane and/or nitroethane.

xxx xxx xxx”

11. Perusal of the aforesaid original claims and the amended claims shows that the appellant has reduced the scope of its claim from a *solvent system* for cleaning polyurethane foam from an article, to only a *process* for cleaning polyurethane foam from an article.

12. This Court further notes that the appellant did not press any challenge to the impugned order passed by the Controller of Patents and pressed for only the amended claims, which had been reduced in scope.

13. In considering the maintainability of the appellant's application being I.A. No. 35045/2024 to introduce an auxiliary claim set at the appellate stage, it is relevant to note that the Patents Act, does not impose any express bar on the amendment of a patent application or specification, during the course of appellate proceedings. This legal position has been elaborately clarified by this Court in the case of *Societe Des Produits Nestle SA Versus*



*Controller of Patents and Design and Another*¹, wherein, it was held as follows:

“xxx xxx xxx

29. Therefore, it would have to be considered whether an amendment can be allowed at the stage of appeal or not.

30. There is no provision in the Act, which specifically bars the amendment of a patent specification at the appellate stage. Amendment of patent applications and specifications are covered in Chapter X of the Act. Sections 57 to 59 of the Act are the provisions that govern the same.

31. A reference to Sub-Section 3 of Section 57 of the Act would show that an amendment application can be made even after the grant of patent.

32. The said provision reads as under:

57. Amendment of application and specification or any document relating thereto before Controller.—

(1) Subject to the provisions of section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification or any document relating thereto to be amended subject to such conditions, if any, as the Controller thinks fit : Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification or any document relating thereto under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend.

(2) Every application for leave to amend an application for a patent or a complete specification or any document relating thereto under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made.

¹ 2023 SCC OnLine Del 582



(3) Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent and the nature of the proposed amendment may be published.

33. Further, a reference to Sub-Section (1) of Section 58 of the Act would show that an amendment to the specification can be allowed in the proceedings before the High Court at the stage of revocation of a patent. The relevant provision reads as under:

58. Amendment of specification before Appellate Board or High Court.—

(1) In any proceeding before the High Court for the revocation of a patent, the High Court, as the case may be, may, subject to the provisions contained in section 59, allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the High Court may think fit, and if, in any proceedings for revocation the High Court decides that the patent is invalid, it may allow the specification to be amended under this section instead of revoking the patent.

34. In view of the above, there is no specific bar for the amendment even at a subsequent stage. Only requirement under the Act is that the amendment has to fulfil the requirements under Section 59 of the Act and the consideration that has to be kept in mind is that the amended Claims are not inconsistent with the earlier Claims in the original specification.

xxx xxx xxx”

(Emphasis Supplied)

14. At this stage, it is pertinent to reproduce Section 59 of the Patents Act, which governs the amendment of patent applications. The said Section 59 is reproduced as under:

“Section 59. Supplementary provisions as to amendment of application or specification.

(1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of



incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Where after the date of grant of patent any amendment of the specification or any other documents related thereto is allowed by the Controller or by the Appellate Board or the High Court, as the case may be,—

(a) the amendment shall for all purposes be deemed to form part of the specification along with other documents related thereto;

(b) the fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and

(c) the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.”

(Emphasis Supplied)

15. Thus, it is evident that amendments in claims are allowed, even at the appellate stage, with the rider that the amended claims are not inconsistent with the earlier claims. This Court notes that the appellant, by way of the amendments, seeks to reduce the scope of the earlier claims. Further, the auxiliary claim set does not introduce any new matter which was not already disclosed in substance in the originally filed specification. The claims, as amended by the appellant, fall wholly within the scope of the originally filed claims, and the same have been narrowed to a *process*.

16. It is a well-settled position in law that amendments that narrow down or restrict the scope of the claims to address objections raised by the Patent



Office, or facilitate grant, are permissible, if the amendments are within the scope of the patent specification, and the originally filed claims. [*See: Nippon A & L Inc. Versus Controller of Patents*² and *W R Grace and Co. Conn. Versus Controller of Patents*³]

17. There is no material before this Court to show that the auxiliary claim set violates the conditions laid down under Section 59 of the Patents Act.

18. Therefore, considering the facts and in line with the decisions of this Court in *Nippon A & L Inc. Versus Controller of Patents (supra)*; *Societe Des Produits Nestle SA Versus Controller of Patents and Design and Another (supra)* and *W R Grace and Co. Conn. Versus Controller of Patents (supra)*, the appropriate course is to allow the auxiliary claim set to be taken on record and to remand the matter for a fresh examination limited to the amended claims.

19. Accordingly, *I.A. No. 35045/2024* is allowed. The auxiliary claim set filed by the appellant is taken on record as part of the proceedings.

20. The present appeal is allowed to the extent that the amended claims filed by the appellant have been taken on record. Since the appellant did not press its challenge to the impugned order dated 12th May, 2021, this Court has not interfered with the merits of the said order, passed on the basis of the original claims before the Patent Office. However, in view of the auxiliary claim set filed by the appellant, that has been taken on record, the *Patent Application No. 2897/DELNP/2012* of the appellant is hereby revived, in order to consider the application of the appellant in light of the auxiliary claim set.

² 2022 SCC OnLine Del 1909

³ 2023 SCC OnLine Del 5456



2025:DHC:5338



21. Accordingly, the matter is remanded to the Patent Office for fresh consideration of the patent application of the appellant, in view of the amended auxiliary claim set, in accordance with law.
22. The Controller is directed to complete the re-examination, expeditiously, within a period of six months from the date of receipt of this order.
23. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trade Marks of India on the Email: llc-ipo@gov.in for compliance.
24. With the aforesaid directions, the present appeal, along with pending applications, stands disposed of.

**(MINI PUSHKARNA)
JUDGE**

**JULY 07, 2025
KR**