



* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
% Judgment delivered on: 31.07.2025
+ **C.A.(COMM.IPD-PAT) 92/2024**

TREIBACHER INDUSTRIE AGAppellant
versus
**THE ASSISTANT CONTROLLER OF PATENTS
AND DESIGNS**Respondent

Advocates who appeared in this case

For the Appellant : Dr. Chitra Arvind & Ms. Rasya
Rawal, Advocates.

For the Respondent : Mr. Sumit Nagpal, SPC with Mr.
Rudra Paliwal, Mr. Tanmay Saini,
Ms. Aakanksha Singh, Advocates.

CORAM:
HON'BLE MR. JUSTICE TEJAS KARIA

JUDGMENT

TEJAS KARIA, J

INTRODUCTION

1. The present Appeal has been filed against the order dated 29.12.2023 (“**Impugned Order**”) passed by the Assistant Controller of Patents and Designs (“**Controller**”) refusing the grant of patent in respect of the Patent Application bearing No. 201917008959 (“**Application**”) on the grounds that the proposed amended claims are beyond the scope of the original claims filed at the time of filing.

2. The learned Controller rejected the Application under Section 59(1) of the Patents Act, 1970 (“**Act**”) and lack of inventive step under Section 2(1)(ja) of the Act, and due to lack of patentability. The invention of the



Appellant was filed in India as a national phase entry of the Patent Cooperation Treaty Application being PCT/EP2017/072893 dated 12.09.2017 (“**PCT Application**”).

FACTUAL BACKGROUND

3. The invention under the Application was titled as “*USE OF VANADATES AS OXIDATION CATALYSTS*” and filed regarding a process of catalytically oxidising carbonaceous compounds from a combustion engine in the presence of a ternary vanadate of Formula(I). The Formula(I) is represented as “*FexMeIyMeIIzVO4(I)*” wherein “*MeI*” and “*MeII*” are different from each other and stand for an element selected from the group of elements consisting of Y, La, Ce, Pr, Nd, Sm, Er, Gd, Tb, Dy, Ho, Tm, Yb, Lu, Al, Bi, Sb, wherein the values of x, y, and Z are 0.05-0.9, 0.05-0.9 and 0.05-0.9 and $x + y + z = 1$.

4. The Appellant, thereafter, *suo moto* amended the claims after entering India as a National Phase Application based on the PCT Application.

5. In the First Examination Report (“**FER**”) dated 25.03.2021, substantive objections were raised by the Patent Office, which are as under:

- (i) Novelty under Section 2 (1)(j) of the Act.
- (ii) Inventive Step under Section 2(1)(ja) of the Act
- (iii) Non-Patentability under section 3(d) and 3(e) of the Act.
- (iv) Sufficiency of Disclosure under Section 10(1) of the Act.
- (v) Clarity and Conciseness under Section 10(5) of the Act.
- (vi) Definitiveness under Section 10(4)(c) of the Act.

6. Responding to the objection raised in FER, the Appellant, on 18.09.2021, filed a Response along with amended claims. Thereafter, *vide* a Hearing Notice dated 22.09.2022, a hearing was scheduled on 27.10.2022,



which, on the request from the Appellant, was adjourned to 21.11.2022. Subsequently, another adjournment was sought by the Appellant on 16.12.2022, and the learned Controller rescheduled the hearing to 21.12.2022. The Appellant, through its agents, attended the hearing on 21.12.2022, at 12:30 pm through video conferencing. The Appellant submitted its defence during the hearing, and thereafter, the Written Submissions (“WS”) were submitted on 20.01.2023.

7. On 19.12.2023, the learned Controller passed the Impugned Order, refusing the Application under Section 59(1) of the Act on the ground that the proposed amended claims were beyond the scope of the claims filed during the time of filing and there was a lack of inventive step under Section 2(1)(ja) of the Act and lack of patentability, in general.

8. Being aggrieved by the Impugned Order of the learned Controller, the Appellant has filed the present Appeal.

SUBMISSIONS ON BEHALF OF THE APPELLANT

9. The Appellant, ‘TREIBACHER INDUSTRIE AG’, is a company incorporated under the laws of Austria, which was established in 1898 by Dr. Carl Auer von Welsbach, who was a world-renowned inventor, discoverer, and entrepreneur.

10. The learned Counsel for the Appellant submitted that in the Hearing Notice dated 22.11.2022, the learned Controller had raised objections of invention under Section 2(1)(j) of the Act, scope of the invention under Section 59(1) of the Act and sufficiency of disclosure under Section 10(4) of the Act. However, the Impugned Order passed by the learned Controller is silent on the objections raised under Sections 2(1)(j) and 10(4) of the Act.

11. The learned Counsel for the Appellant also submitted that even



though detailed submissions were made in the WS, the learned Controller passed the Impugned Order, refusing the subject Application on the grounds that the amended claims were beyond the scope of the earlier claims made at the time of filing and, therefore, fall foul of Section 59(1) of the Act, in addition to Section 2(1)(ja) of the Act due to lack of inventive step.

12. The learned Counsel for the Appellant also contended that the learned Controller has failed to appreciate that the subject Application stems from a PCT Application, which is drafted according to the International Standards, taking into account the global Patent requirements. Therefore, the subject Application, when filed as the National Phase Entry of the PCT Application, was entered with the same claims as filed in the PCT Application.

13. The learned Counsel for the Appellant submitted that the learned Controller, in the Hearing Notice dated 22.11.2022, had raised objections to the invention under Section 2(1)(j) of the Act, scope of the invention under Section 59 of the Act and sufficiency of disclosure under Section 10(4) of the Act, while the Impugned Order issued by the learned Controller is silent on the said objections raised under Sections 2(1)(j) and 10(4) the Act.

14. The learned Counsel for the Appellant also submitted that the learned Controller has erred in the interpretation of Section 59(1) of the Act. It is further submitted that the learned Controller has passed the Impugned Order without considering the WS filed by the Appellant.

15. The learned Counsel for the Appellant submitted that during the hearing, the arguments were limited to the objections regarding whether there is an invention under Section 2(1)(j), the scope of the invention under Section 59 and the sufficiency of disclosure under Section 10(4) of the Act. However, the objections regarding inventive step were not raised in the



Hearing Notice or during the hearing. Therefore, the WS forwarded were limited to the arguments made during the hearing, based on which the learned Controller rejected the Application vide the Impugned Order.

16. The learned Counsel for the Appellant also asserted that the learned Controller has failed to appreciate that the amendment of claims during the National Phase Entry and immediately thereafter are routinely permitted and practised in patent prosecution throughout the world, including India.

17. In support of his submissions, the learned Counsel for the Appellant relied on the following cases:

- *Allergan Inc v. Controller of Patents* 2023 SCC OnLine Del 295.
- *Health Protection Agency v. Controller General of Patents & Designs and Anr.* 2020 SCC OnLine IPAB 53.
- *Nippon A&L INC v. The Controller of Patents* 2022 SCC OnLine Del 1909.

SUBMISSIONS ON BEHALF OF THE RESPONDENT

18. The learned Counsel for the Respondent has denied the submission of the Appellant that the objection on the ground of inventive step was not raised in the Hearing Notice or during the hearing, and submitted that the Hearing Notice clearly stated that “*the objections raised with respect to lack of novelty and inventive step raised in the FER is maintained.*”

19. The learned Counsel for the Respondent has submitted that the perusal of the Application shows that the Appellant amended the “USE” claim to a “PROCESS” claim, but has failed to exhibit any steps involved in the process. It is further submitted that the amended claims, instead of



defining the process, are only defining the product / catalyst's "COMPOSITION", which leads to an issue of indefiniteness and does not clarify what has actually been claimed in the Patent Application.

20. It is submitted that the Appellant has tried to mislead this Court by stating that the "USE" is invariably a "PROCESS" since the use of a product / effect must involve a manner of manufacture. It is further submitted that a bare perusal of the amended claims shows that the Appellant has failed to explain the steps / different stages involved in the manufacture of the product / catalyst and that the claims only explain the composition of the catalyst, which cannot be said to fall under the definition of either "PROCESS" claims or "USE" claims.

21. The learned Counsel for the Respondent has further submitted that as per Section 59 of the Act, if any amendments in the claims are made, it has to be supported by description, in addition to the claims. It is further submitted that the Complete Specification ("CS") as well as the examples mentioned therein, only explain the synthesis of the ternary vanadate catalyst and its properties. It is also contended that the final amended claims nowhere explain the method of catalytically oxidising the carbonaceous compounds from a combustion engine. Therefore, there is an inconsistency between the amended claims submitted by the Appellant and the CS/description.

ANALYSIS AND FINDINGS

22. The subject Application was filed in India on 07.03.2019 as a national phase entry of the PTC Application dated 12.09.2017. The PCT application contains 9 claims, in which the principal claim is as follows:



“Claims:

1. Use of a ternary vanadate of formula (I)



wherein Mel and Mell are different from each other and each stand for an element selected from the group consisting of Y, La, Ce, Pr, Nd, Sm, Er, Gd, Tb, Dy, Ho, Tm, Yb, Lu, Al, Bi and Sb and wherein

$$X = 0.05-0.9$$

$$y = 0.05-0.9$$

$$z = 0.05-0.9$$

$$X + y + Z = 1,$$

as a catalyst for the oxidation of carbonaceous compounds in combustion engines.”

23. While filing the national phase Application in India, the Appellant, on 07.03.2019, filed CS along with an amended set of claims. The principal claims filed with the CS are as follows:

“We Claim:

1. A novel ternary vanadate catalyst used for oxidation of carbonaceous compounds in combustion engines, said ternary vanadate having Formula (I) as shown below:



wherein the Mel and Mell are different from each other and each stand for an element selected from the group consisting of Y, La, Ce, Pr, Nd, Sm, Er, Gd, Tb, Dy, Ho, Tm, Yb, Lu, Al, Bi and Sb and wherein

$$X = 0.05-0.9$$

$$y = 0.05-0.9$$

$$z = 0.05-0.9$$

$$x + y + z = 1.$$

10. A method of oxidising carbonaceous compounds in combustion engines, said method comprising oxidising the carbonaceous compounds in the presence of a novel ternary vanadate catalyst of formula (I) shown below:



wherein Mel and Mell are different from each other and each stand for an element selected from the group consisting of Y, La, Ce, Pr, Nd, Sm, Er, Gd, Tb, Dy, Ho, Tm, Yb, Lu, Al, Bi and Sb and wherein

$$X = 0.05-0.9$$

$$y = 0.05-0.9$$

$$z = 0.05-0.9$$

$$x+y + z=l.”$$

24. The Patent Office released the FER on 25.03.2021 and raised objections to the submitted claims. The objections were, *inter alia*, primarily raised on the ground of novelty under Section 2(1)(j), inventive step under Section 2 (1)(ja), and non-patentability under Sections 3(d) and 3(e) of the Act. Thereafter, on 18.09.2021, the Appellant submitted a response to the FER with the amended set of claims, which are as follows:

“We claim:

1. A method of catalytically oxidising carbonaceous compounds from a combustion engine, said method comprising:

contacting the carbonaceous compound from the combustion engine with a ternary vanadate catalyst of formula (I):



wherein Mel and Mell are different from each other and each stand for an element selected from the group consisting of Y, La, Ce, Pr, Nd, Sm, Er, Gd, Tb, Dy, Ho, Tm, Yb, Lu, Al, Bi and Sb and wherein

$$X = 0.05-0.9$$

$$y = 0.05-0.9$$

$$z = 0.05-0.9$$

$$x + y + z = l,$$

wherein the catalyst catalyses the oxidation of the carbonaceous compounds from the combustion engine.



2. *The method of catalytically oxidising carbonaceous compounds in the combustion engine as claimed in claim 1, wherein the Mel and Mell each stand for an element selected from the group consisting of Y, La, Ce, Pr, Er, Al, Bi.*

3. *The method of catalytically oxidising carbonaceous compounds in the combustion engine as claimed in claim 1 or 2, wherein the Mel and Mell each stand for an element selected from the group consisting of Ce, La, Er, Al and Bi.*

4. *The method of catalytically oxidising carbonaceous compounds in the combustion engine as claimed in any one of the preceding claims, wherein the Mel and Mell are selected from the group of the following combinations:*

Mel = La, Mell = Er

Mel = Ce, Mell = Al

Mel = Ce, Mell = Bi

Mel = La, Mell = Al

Mel = Er, Mell = Al

Mel = Bi, Mell = Al.

5. *The method of catalytically oxidising carbonaceous compounds in the combustion engine as claimed in any one of the preceding claims, wherein*

X = 0.1-0.8

y = 0.1 -0.8

z = 0.1-0.8

x + y+z= 1.

6. *The method of catalytically oxidising carbonaceous compounds in the combustion engine as claimed in claim 5, wherein*

X = 0.2-0.6

y=0.2-0.6

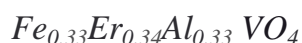
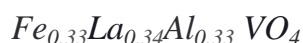
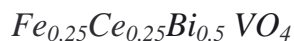
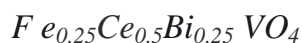
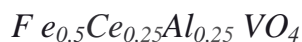
z = 0.2-0.6

x+y+z= 1.

7. *The method of catalytically oxidising carbonaceous compounds in the combustion engine as claimed in any one of the*



preceding claims, wherein the ternary vanadate is selected from the group consisting of



8. The method of catalytically oxidising carbonaceous compounds in the combustion engine as claimed in any one of the preceding claims, wherein the ternary vanadate is employed in combination with another compound selected from oxides or oxide precursors of Al, Ti, Ce, Zr and mixtures thereof.

9. The method of catalytically oxidising carbonaceous compounds in the combustion engine as claimed in any one of the preceding claims for soot oxidation.”

25. In the Hearing Notice issued by the Patent Office, objections were raised on the grounds of invention under Section 2(1)(j), scope of the invention under Section 59 of the Act and sufficiency of disclosure under Section 10(4) of the Act. Thereafter, the Appellant attended the hearing on 21.12.2022 and submitted a WS on 20.01.2023.

26. *Vide* the Impugned Order, the learned Controller refused the grant of patent under section 59(1) of the Act. The Impugned Order records that the claims do not constitute a “*disclaimer, correction or explanation*” as provided for under Section 59(1) of the Act, and that the amended claims are not within the scope of the initially filed claims. Therefore, they were held as impermissible under this provision. The relevant extract of the Impugned



Order is reproduced as under:

“ • *The objection w.r.t scope of the claims w.r.t Section 59 raised in the hearing letter dated 22/22/2022 issued by this office is reiterated herewith. The relevant para of section 59 of Patents Act, 1970 is provided below:*

(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.

• *The filed claims do not fall within any of the provisions as laid-out in Section 59(1) i.e the amendment carried -out is neither “by way of disclaimer, correction or explanation”, the amended claims are not within the scope of claim of the first filed specification and the filed claims are not allowed under the said section.*

xxxxxx

• *In view of the above, it is evident that applicant has to meet both the requirement u/ s 59 while making amendments in claims i.e. any amendment to claims has to be supported by description as well as claims hence the amendment of claims is not allowable if the claim would not fall wholly within the scope of claim before amendment.”*

27. In the Impugned Order, the learned Controller relied upon this Court’s decision in the case of ***Nippon A And L Inc. vs The Controller of Patents*** 2022 SCC OnLine Del 1909, wherein it was held that the following four conditions have to be fulfilled in order to make any amendment permissible under Section 59(1) of the Act.

“40. A perusal of Section 59(1) shows that an amendment of an application, specification or any document related thereto would be permissible only if the following conditions are satisfied:

(i) *The amendment has to be by way of disclaimer, correction or*



explanation;

(ii) The amendment has to be for the purpose of incorporation of actual facts;

(iii)(a) The effect of the amendment ought not be to amend the specification to claim or describe any matter which was not disclosed in substance or shown in the originally filed specification.

(iii)(b) The amended claims have to fall within the scope of claims as originally filed.”

28. However, the Impugned Order does not explain how the amended claims are beyond the scope of the claims as originally filed, as required by the conditions laid down in the above-quoted judgment. The Impugned Order does not point out any specific claim or step thereof that is not described in the CS.

29. As the Impugned Order has not given any justification as to how the amended claims are not supported by the earlier filed claims, the Impugned Order is not a reasoned decision.

30. Further, the Impugned Order states that since the claims related to the “*use of a ternary vanadate of formula (I)*”, the subject matter falls under Section 2(1)(j) of the Act, and since no product or process is defined, the said claims do not fall within the definition of “invention” under the said provision. The claims mentioned in the Impugned Order are the initially filed claims, not the amended claims. The relevant extract of the Impugned Order is reproduced as under:

*“1.2. With respect to the other objections raised in the hearing letter and discussed during the hearing such as invention falls u/s 2(1)(j), the objection is maintained since the filed claims have not been allowed u/s 59(1) of Patents Act, 1970 and no claim can be granted. It is reiterated since claims relate to **“use of a ternary vanadate of formula (I)”** the subject matter falls u/s 2(1)(j) of Patents Act, 1970 since no product or process is*



defined and such claims do not fall within the definition of an invention of the said section.

[Emphasis supplied]

31. Although the Impugned Order acknowledges the WS submitted by Appellant dated 20.01.2023, the learned Controller has not considered the WS in the Impugned Order. The Appellant in the WS submitted a detailed table of claims providing support/references in the specification. Additionally, the Appellant also submitted another table providing a comparison of the PCT Claims and amended claims to illustrate that the amended claims do not fall outside the scope of the PCT claims. The Impugned Order has not provided any reason to reject the said submissions.

32. In ***Agriboard International LLC v. Deputy Controller of Patents and Designs***, 2022 SCC OnLine Del 940, a Coordinate Bench of this Court observed that application of mind as well as recording of a reasoned decision are the basic elements of the principles of natural justice. The relevant extract of the said decision is reproduced as under:

*“23. The said reasoning has been reiterated by the Supreme Court in **Manohar v. State of Maharashtra & Ors.** AIR 2013 SC 681 wherein it has been categorically observed that application of mind and recording of reasoned decision are the basic elements of natural justice. There can be no doubt that scrupulous adherence to these principles would be required while rejecting patent applications.”*

33. In ***Blackberry Limited v. Assistant Controller Of Patents And Designs***, 2023 SCC OnLine Del 5502, this Court held that a speaking order is an important aspect of the principles of natural justice and therefore, the learned Controller must provide reasoning to support its decision of the



rejection. The relevant extract of the said decision reads as follows:

“12. ...The Controller ought to have disclosed reasons to support his conclusion. Reasoning through a speaking order is a vital aspect of the principles of natural justice and is of utmost importance, which needs to be underscored. If the patent office’s orders lack proper reasoning, it may be difficult for the applicant to identify the grounds for appeal. The legal proposition that an order of such kind should be supported by reasons, needs no reiteration. Not only does this benefit the applicant, whose rights are likely to be affected, but also assists the Court in ascertaining how the concerned officer applied their minds and reached the impugned conclusion, while exercising judicial review. This Court, in an earlier decision of SK Geo Centric Co Ltd. v. The Controller of Patents, observed that such reasoning should be discernible to the Court and in absence thereof, the entire order stands vitiated. In the impugned order, the Court is bewildered as to how the Controller has concluded that subject invention is hit by Section 3(k) of Patents Act and has plainly agreed with the Examiner’s opinion that the claimed patent is not an invention.

34. As the Impugned Order does not provide any reason to support the conclusion, the Impugned Order cannot be considered as a speaking order. Further, the learned Controller has not considered the WS filed by the Appellant, which ought to have been done. In view of the same, the Impugned Order is against the principles of natural justice.

35. For the aforesaid reasons, the Impugned Order passed by the learned Controller is hereby set aside. The Application is remanded back to the learned Controller of Patents for reconsideration to be decided afresh by another learned Controller within a period of six month from the date of this decision. The Appeal is allowed and a copy of the order be brought to the



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notice of the learned Controller General of Patents, Designs and Trademarks for the necessary administrative action.

JULY 31, 2025/ 'K'

TEJAS KARIA, J