

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
INTERIM APPLICATION NO. 1778 OF 2026
IN
COMMERCIAL MISCELLANEOUS PETITION NO. 61 OF 2025

Qualyst Transporter Solutions LLC ...Applicant/Petitioner

Versus

The Assistant Controller of Patents & DesignsRespondent

Mr. Rashmin Khandekar a/w. Mr. Murlidhar Khadilkar, Mr. Anand Mohan, Mr. Chinmay Page, Mr. Ashutosh Pawar i/b. Mr. Murlidhar Khadilkar for Applicant. Mr. Yashodeep Deshmukh a/w. Mr. Rutwik Rao, Vaidehi Pradeep i/b. Mrs. Minal Avinash Vaidya for Respondent.

CORAM : ARIF S. DOCTOR, J.

RESERVED ON : 8th MAY 2026

PRONOUNCED ON : 15th JUNE 2026

JUDGMENT:

1. This Court had, vide an Order dated 15th October 2025, disposed of the captioned Miscellaneous Petition by passing the following order:

“1. Mr. Deshmukh, learned counsel appearing on behalf of the Respondent has very fairly submitted that the impugned order is unsustainable since questions have been raised for the first time in the

impugned order to which the Petitioner did not have an opportunity to deal with. This, he accepts would amount to a violation of the principle of natural justice.

2. Hence, the order would have to be set aside and is accordingly set aside. The matter is remanded back for fresh hearing. Let such fresh hearing be concluded within a period of three months from a date of which a copy of this order uploaded, given the fact that sufficient time has already lapsed.

3. Let the matter be considered afresh before the independent controller.

4. In the event, it is not possible for any reason to conclude within three months an application for extension may be made by the plaintiff.”

For convenience, the above order is referred to as “**the Order of Remand**”

and the parties are referred to as they appear in the captioned Commercial Miscellaneous Petition.

2. Shorn of unnecessary details, it is the Applicant’s case that the Respondent instead of only granting a fresh hearing as directed, is now seeking to proceed *de novo inter alia* by raising fresh objections. It is in these circumstances that the captioned Interim Application has been filed, seeking the following reliefs:

a. Allow the present Application and issue appropriate directions for carrying out the clarification to the Order as prayed for in the present Application, thereby clarifying that the remand order dated

- October 15, 2025, requires that the fresh hearing be confined strictly to objections forming part of the earlier record, and that no new objections or prior art references shall be introduced at this stage;*
- b. Stay the operation and effect of the impugned hearing notice(s), including the hearing scheduled on March 20, 2026, insofar as they introduce fresh objections beyond the scope of the remand;*
- c. Direct the Respondent to proceed in the matter strictly in accordance with the clarified scope of remand ordered by this Hon'ble Court;*
- d. Pass such further orders and directions as deemed proper in the facts and circumstances of the present case.*

Submissions on behalf of the Petitioner:

3. Mr. Khandekar, Learned Counsel appearing on behalf of the Petitioner, submitted at the outset that the Order of Remand was clear and unambiguous and all that the Respondent was required to do was to grant a fresh hearing and nothing more. He, however, submitted that instead of doing so, the Respondent had sought to restart the patent examination process by issuing a hearing notice dated 16th January 2026 which raised entirely new objections. It was thus submitted that the Petitioner was constrained to approach this Court by way of the present Application.

4. Mr. Khandekar submitted that the facts leading up to the filing of the Petition were of considerable relevance. He submitted that the Petitioner had been prosecuting the patent application for almost ten years and that the examination process under the Patents Act, 1970, had also concluded and pointed out that the First Examination Report (“**FER**”) was issued on 22nd December 2020, after which the Petitioner filed a detailed response thereto on 21st June 2021 together with substantive claim amendments. He then submitted that hearing notices were thereafter issued on 25th August 2021 and 21st September 2021, which made plain that the examination stage was over.
5. Mr. Khandekar then placed particular emphasis on paragraphs one and two of the Order of Remand and pointed out that the Respondent had expressly accepted that the impugned order was unsustainable because certain objections had been raised for the first time during the hearing without affording the Petitioner an opportunity to respond to them. He submitted that the Respondent had, in fact, conceded that there had been a violation

of the principles of natural justice, and it was on this basis that the matter was remanded for a fresh hearing.

6. Mr. Khandekar, submitted that the entire issue in question in the present case turned on the true meaning and scope of the Order of Remand. He submitted that once the impugned order had been set aside, the proceedings were restored to the stage they were at when the impugned order was passed, namely, the stage of hearing. Consequently, all that remained was for the Petitioner to be given a fresh hearing in compliance with the requirements of natural justice.
7. He further submitted that, at the time the Order of Remand was passed, there was no suggestion from the Respondent that any further examination was required, nor was any liberty sought or reserved to raise additional objections or cite new prior art. He submitted that had such liberty been sought or granted, it would have been noted in the Order of Remand. He also pointed out that the direction requiring completion of the fresh hearing within three months was itself a clear indication of the fact that the

examination process had already concluded and that only the hearing remained.

8. Mr. Khandekar then submitted that the Respondent had acted contrary to both the letter and spirit of the Order of Remand and pointed out that instead of convening a fresh hearing on the basis of the existing examination record, the Respondent issued the hearing notice dated 16th January 2026, introducing entirely new objections and new prior art documents D1 to D6, none of which had previously formed part of the record. He submitted that this conduct on the part of the Respondent clearly amounted to reopening the patent examination process, a stage which had already concluded in 2021. He further submitted that the impropriety of the Respondent's conduct was compounded by the fact that the hearing notice, which introduced the new objections, was issued on the very last day of the three-month period within which the fresh hearing itself was directed to be concluded.
9. Without prejudice to his submission that a plain reading of the Order of Remand made its scope clear, Mr. Khandekar submitted that the

Respondent's conduct was also contrary to settled principles governing remand proceedings. In support of his contention, he placed reliance upon the decision of this Court in *Shree Champalal Kothari Trust v. Rajhans Cooperative Housing Society Ltd.*¹, particularly paragraphs 17 to 19 thereof, to point out that a remand does not obliterate prior proceedings and that, where the remand is limited in nature, the authority to whom the matter was remanded was bound to act strictly within the confines of the order of remand and that such authority cannot proceed on the footing that the entire matter stands reopened or permit new pleadings and issues that did not form part of the original dispute.

10. He then also relied upon the judgment of the Hon'ble Supreme Court in *Shivshankara v. H.P. Vedavyasa Char*² to submit that an authority to which a matter is remanded is bound to comply with the remand order in its true spirit and that any departure therefrom is contrary to law and the decision in the case of *Laxman Bapu Berad v. Sudhakar Nanasaheb Jawale*³, to point out that where a remand is for a specific purpose, the

¹ [Bombay High Court] Order dated 11th November 2025 in Writ Petition No. 2110 of 2021.

² AIR 2023 13 SCC 1.

³ 1997 SCC OnLine Bom 319.

authority has jurisdiction only to carry out those directions and cannot reopen the entire case.

11. Mr. Khandekar further relied upon the decisions in *Kiran Thakur v. Krishan Lal*⁴ and *Smt. Ramabai v. Harbilas*⁵ to submit that the jurisdiction of the Court or Authority in question after an order of remand depends entirely upon the terms of the order of remand and that no issue beyond those limits can be reopened. He also relied upon the recent judgment of this Court in *Kapil Satish Phalke v. Sub-Divisional Officer, Koregaon*⁶ to submit that a remand cannot be utilised merely to redo what has already been considered or to fill evidentiary lacunae where the record is otherwise complete.

12. Mr. Khandekar submitted that these principles had also been applied in the context of patent prosecution. In support of this submission, he relied upon the decisions in *Euro-Apex B.V. v. Controller of Patents and Designs*⁷, *Grupo Petrotemex S.A. de C.V. v. Controller of Patents*⁸ and *Kamterter*

⁴ [Himachal Pradesh High Court] Order in Cr. MMO No. 1127 of 2023.

⁵ AIR 1997 Madhya Pradesh 90.

⁶ [Bombay High Court] Order dated 5th May 2025 in Writ Petition No. 5672 of 2025.

⁷ [Bombay High Court] Order dated 11th March 2025 in COMMP No. 847 OF 2022.

⁸ 2023 SCC OnLine Del 2485.

*Products LLC v. Assistant Controller of Patents*⁹ to contend that where patent refusals are set aside and matters remanded, the remand contemplates fresh consideration on the existing record and not a reopening of examination through the introduction of fresh prior art.

13. Mr. Khandekar concluded by submitting that (i) a remand confines the subordinate authority to the four corners of the remand order; (ii) a remand cannot be used to revisit matters already concluded; (iii) in patent proceedings, remands contemplate fresh consideration on the existing record and not the introduction of fresh prior art; and (iv) by issuing the hearing notice dated 16th January 2026 and subsequent notices introducing entirely new prior art references, the Respondent had violated each of these settled principles.

Submissions on behalf of the Respondent:

14. Mr. Deshmukh, Learned Counsel appearing on behalf of the Respondent, submitted that the present Interim Application was wholly misconceived and not maintainable in its present form. He submitted that the Petitioner

⁹ [Calcutta High Court] Order dated 26th June 2025 in IPDPTA No. 77 of 2023.

under the guise of seeking a clarification of the Order of Remand, was in reality seeking to introduce a restriction which the Order consciously did not contain, namely, that upon remand the Controller would be precluded from raising any further objections or citing additional prior art in relation to Indian Patent Application No. 201727011198.

15. Mr. Deshmukh submitted that no such restriction was either expressly or impliedly contained in the Order of Remand. He further contended that the Application was premature and was, in substance, an attempt to avoid dealing with the objections on merits before the Patent Office. According to him, it was always open to the Petitioner to respond to the hearing notices, without prejudice to its contentions regarding the permissible scope of the remand, and thereafter invite a decision from the Controller. If such decision were adverse, the Petitioner would have an adequate remedy in accordance with law. He thus submitted that there was no justification for the Petitioner to have moved this Court at this stage. He submitted that the clarification and/or reliefs which the Petitioner was now

seeking would effectively curtail the examination process of under the Patents Act and Rules.

16. Mr. Deshmukh then submitted that upon a plain reading of the Order of Remand it was *ex facie* clear that it had been passed without any adjudication on the merits of the rival contentions and solely on the basis of the Respondents concession that the principles of natural justice had been violated. He therefore submitted that the Order of Remand was passed only on account of the breach of the principle of natural justice and not upon any consideration of the merits of the objections or the permissible future scope of examination.

17. He further submitted that the procedure adopted by the Respondent upon remand was entirely consistent with the settled practice of the Indian Patent Office, which was recognised both administratively and judicially. He submitted that it was well settled that any further objections arising upon consideration of the Applicant's response to the FER, or upon a fresh appreciation by the Controller, may be communicated through a hearing notice together with an opportunity to respond. In support of his contention,

he placed reliance upon Circular No. 4 of 2011, dated 21st September 2011, issued by the Indian Patent Office, titled “Examination of Patent Applications and Consideration of Report of Examiner by Controller”.

18. He then pointed out that clause (k) of the said Circular, specifically provided that where objections remain outstanding or further objections arise upon consideration of the Applicant’s response, such objections may be communicated through a hearing notice, and there is no requirement to issue a second examination report. He therefore submitted that objections not specifically contained in the FER may validly be communicated through a hearing notice, which is the recognised procedural mechanism for doing so. He therefore submitted that the Petitioner’s contention that the hearing notice dated 16th January 2026 was in substance a fresh FER was misconceived and contrary to established Patent Office practice.

19. Mr. Deshmukh then placed reliance upon the decision of the Delhi High Court in *Perkinelmer Health Sciences Inc. v. Controller of Patents*¹⁰ to point out that the Court in that case had considered a refusal order founded

¹⁰ [Delhi High Court] Order dated 4th January 2023 in C.A.(COMM.IPD-PAT) No. 311 of 2022.

upon a Section 3(f) objection raised orally for the first time at the hearing without prior written notice. He pointed out that the Delhi High Court extracted clauses (i) to (l) of the 2011 Circular and directed the Controller to issue a fresh hearing notice setting out all objections. He submitted that this decision clearly distinguished between objections raised orally for the first time during a hearing, which is impermissible, and objections communicated in advance through a written hearing notice, which is expressly permissible.

20. Mr. Deshmukh then submitted that the Respondent had followed precisely the course approved in the case of *Perkinelmer* by issuing the hearing notice dated 16th January 2026 and setting out all objections and prior art references in advance. The objections under Sections 2(1)(ja), 3(i), 10(4)(c) and 10(5), together with prior art references D1 to D6, had all been disclosed in writing before the hearing, thereby fully satisfying the requirements of natural justice. Learned Counsel pointed out that the approach taken in the case of *Perkinelmer* was subsequently affirmed in

*Otsuka Pharmaceutical Co. Ltd. v. Controller of Patents*¹¹ and *Bayer Pharm Aktiengesellschaft v. Controller General of Patents and Designs*¹².

21. Mr. Deshmukh, then in dealing with the authorities cited by the Petitioner, submitted that the Petitioner had fundamentally misconstrued the nature of jurisdiction involved since they dealt with the powers exercised by Civil Courts in private disputes. He, however, pointed out that Patent prosecution stands on an entirely different footing since the grant of a patent creates a statutory monopoly enforceable against the world at large and therefore involves rights in rem and significant public interest considerations. He submitted that the Patent Office acts as a statutory gatekeeper charged with ensuring that only inventions satisfying the requirements of the Patents Act are granted protection and that which would apply to private civil disputes cannot ipso facto be mechanically transplanted into the public law framework that govern patent examination. Mr. Deshmukh thus submitted that the reliance placed by the Petitioner upon Section 151 of the Code of

¹¹ 2022 SCC OnLine Del 4982.

¹² 2024 SCC OnLine Del 2044.

Civil Procedure, 1908, and decisions concerning breach of natural justice were misplaced and could not operate to restrict the Patent Office from discharging its statutory obligations under Sections 12 to 15, 18 and 43 of the Patents Act.

22. He further submitted that the decisions in *Euro-Apex*, *Grupo Petrotemex* and *Kamterter Products* were distinguishable on facts since, in each of those cases, the refusal orders had been set aside because they were founded upon grounds that had never been communicated to the Applicant. According to him, the infirmity identified in those cases was the absence of proper notice and hearing. He submitted that none of these decisions held that, upon remand, the Patent Office ceased to possess the statutory authority to examine patentability in accordance with law.

23. Mr. Deshmukh further pointed out that even in *Euro-Apex*, the Division Bench of this Court observed that material already on record before the Controller could not be ignored merely because a pre-grant opposition had subsequently been withdrawn. He submitted that this observation itself demonstrated that the Controller's obligation to consider relevant material

in discharge of statutory duties continues notwithstanding procedural developments.

24. Mr. Deshmukh submitted that the Order of Remand merely recorded that certain questions had been raised for the first time without affording the Petitioner an opportunity to respond and, on that basis, directed that the matter be considered afresh by an independent Controller after granting a fresh hearing. He submitted that the Order of Remand did not impose any limitation on the future course of examination and was entirely silent as regards the scope of the fresh hearing. According to him, this omission, and the absence of any express fetter upon the Respondent, was of considerable significance. He submitted that the Respondent had conceded only the issue of breach of natural justice and, therefore, there was no occasion for this Court to examine the merits of the record, the examination history, or the specific objections raised, much less to define or restrict the future scope of examination. He submitted that, applying the principle of *expressio unius est exclusio alterius*, the absence of any restrictive language in the Order of Remand was itself determinative of the fact that

no limitation or restriction had been imposed upon the Respondent. According to him, where a Court intends to circumscribe the scope of a remand, it does so expressly. Since no such restriction had been incorporated in the present case, the Petitioner could not invoke Section 151 of the Civil Procedure Code, 1908, to effectively rewrite the Order of Remand by introducing limitations which the Court had consciously chosen not to impose.

25. He then submitted that the entire Application proceeded on the erroneous assumption that procedural doctrines developed in private inter partes disputes could be imported into a statutory regime involving public interest considerations. He submitted that the authorities relied upon by the Petitioner, when properly understood, in fact supported the procedure adopted by the Respondent.

26. Mr. Deshmukh accordingly submitted that the Application was devoid of merit and deserved to be dismissed with costs, particularly in view of the unnecessary multiplicity of proceedings occasioned by the Petitioner instead of responding to the hearing notices on merits before the Controller.

Submissions on behalf of the Petitioner in Rejoinder:

27. Mr. Khandekar submitted that the Respondent's reliance upon the Circular dated 21st September 2011 was misplaced. He submitted that the issue before this Court was not what a Controller may generally do under the statute or the powers of the Controller in general but was confined to the scope of the Order of Remand only. He submitted that since by the Order of Remand, the Respondent was only required to grant a fresh hearing, the scope was plainly clear and the Respondent could not, in the guise of the general powers of the Controller or the said Circular, travel beyond the plain letter and spirit of the Order of Remand.

28. He further submitted that the Respondent had itself admitted in paragraph 6 of its written submissions that the objections now sought to be raised were fresh and had never previously formed part of the record. According to him, this admission itself demonstrated that the Respondent was attempting to enlarge the scope of the remand and effectively recommence the examination process.

29. As regards the decisions in *Otsuka* and *Bayer*, Mr. Khandekar submitted that they were both distinguishable since neither of the said cases concerned the interpretation of an existing order of remand. He then submitted that the said decisions in fact supported the Petitioner's case since the order of remand made therein was expressly confined to objections already raised and forming part of the record. He pointed out that in *Bayer*, the remand order specifically directed *de novo* "consideration", whereas no such language was employed in the present case, which was expressly confined to a "fresh hearing".

30. Mr. Khandekar therefore submitted that, at the highest, the Respondent could proceed only on the basis of objections already existing as of the date of the Petition, namely, the objections contained in the FER and those raised during the hearing held on 25th October 2021. He submitted that the suggestion that the Order of Remand conferred a *carte blanche* authority upon the Respondent to continuously raise fresh objections and recommence examination proceedings in a matter where the Petitioner had

succeeded was wholly misconceived and contrary to both the letter and spirit of the Order of Remand.

Reasons and conclusions:

31. Having perused the Order of Remand and having considered the rival contentions of Learned Counsel, as also the case law upon which reliance has been placed, I find that the Application would have to be allowed. I say so for the following reasons.

A. While there can be no dispute to the law laid down in *PerkinElmer Health Sciences Inc., Otsuka Pharmaceutical Co. Ltd.* and *Bayer Pharm Aktiengesellschaft* upon which reliance was placed by the Respondent, wherein it was held that the Controller possesses the power to raise further objections during the course of examination proceedings and that such objections must be communicated through a hearing notice, as contemplated under Clause (k) of Circular No. 4 of 2011. The question, which falls for consideration in the present case, is whether those principles would apply in the

facts of the present case, given the remit and scope of the Order of Remand. In my view, they would not.

B. A plain reading of the Order of Remand makes it clear that the earlier Order was set aside solely because certain questions had been raised for the first time at the hearing without having been previously communicated to the Petitioner, thereby depriving the Petitioner of an opportunity to address them. The impugned Order thus stood vitiated since there was a breach of the principles of natural justice, to which the Respondent had specifically conceded, and the matter was remanded for a fresh hearing. Significantly, when the Order of Remand was passed, the Controller did not suggest that any further objections were required or that the objections raised during the hearing were justified, nor was any liberty to raise fresh objections on remand even sought for. It was thus, and in this context, that the matter was directed to be heard and decided afresh within three months of the Order of Remand, as it was common ground that the stage of examination was well over.

C. While it is true that the Order of Remand records that the matter was to be “*considered afresh before an independent Controller*”, use of such nomenclature must be read in the context of the facts in which the Order of Remand was passed and cannot be read in isolation. The remand was directed because the Petitioner had been denied an opportunity of meeting certain objections; it was not founded on any perceived deficiency in the examination process itself. Equally, and as already noted in (B) above, there was no suggestion from the Controller that the examination was incomplete, defective, or otherwise required to be reopened. The direction that the matter be “considered afresh” must therefore be understood as requiring a fresh hearing after granting the Petitioner an opportunity to deal with the objections already raised and not as starting the examination process afresh or reopening the same. In the context of these facts, which are really beyond the realm of dispute, I find the Petitioner's reliance on the decisions in *Shri Champalal Kothari Trust*, *Shivshankara* and *Laxman Bapu Berad* to be entirely apposite.

D. In the context of what has been noted above, it is also crucial to note that the examination process had commenced as far back as 2020. The FER was issued in December 2020, detailed responses and amendments were filed in June 2021, and hearing notices followed in August and September 2021. Also, as already noted in **(B)** and **(C)** above, when the Order of Remand was passed, there was not even the slightest indication on the part of the Controller that further examination was required or that additional prior art references or fresh objections would have to be raised. On the contrary, the matter proceeded on the basis that the only defect requiring correction was the breach of the provisions of natural justice, and it was thus that the Respondent accepted the direction that a fresh hearing be given and the matter decided within three months.

E. I am conscious that patent prosecution stands on a somewhat different footing from ordinary civil litigation and that considerations of public interest necessarily inform the grant of patent rights. However, that distinction does not materially assist the

Respondent in the facts of the present case since the issue at hand, as already noted in (A) above, is not whether the Controller, as a matter of statutory power, may generally raise further objections during prosecution but whether the Controller can now exceed and go beyond the specific terms and limited purpose of the Order of Remand. In light of what is already noted in (B), (C) and (D) above, the answer, in my view, in the facts of the present case must be in the negative since the Controller's jurisdiction on remand was confined to curing the procedural defect identified in the Order of Remand, i.e., by giving the Petitioner a fresh hearing. It did not extend to reopening the examination process *de novo* by introducing fresh objections or new prior art references that had admittedly never been raised before. Therefore, the Petitioner's reliance upon the decisions in *Euro-Apex B.V.*, *Grupo Petrotemex S.A. de C.V.* and *Kamterter Products LLC* is apposite. Furthermore, the Petitioner's reliance upon the decision of *Kiran Thakur*, *Smt. Ramabai* and

Kapil Satish Phalke, wherein the scope of remand was discussed, would squarely apply to the facts of the present case.

32. Hence, for the reasons set out in (A) to (E) above, I find that the present Application deserves to be allowed. At the same time, it is clarified that this Order shall not preclude the Respondent from elaborating upon, clarifying, or further developing objections that already emerge from the examination record and the prior art references forming part of the proceedings as they stood when the Impugned Order was passed. What is impermissible, however, having regard to the peculiar facts of the present case and the limited scope of the Order of Remand, is the introduction of entirely new prior art references or wholly new grounds of objection. To permit such a course would, in effect, amount to reopening the examination process itself, which is beyond the remit of the Order of Remand.

33. Given the inordinate amount of time already spent, the hearing is to be completed and the order passed within a period of 8 weeks from the date on which a copy of this order is uploaded.

34. The Application is disposed of on the above terms.

35. It is clarified that this Order has been passed only in the peculiar facts of the present case and considering the Order of Remand which was earlier passed.

[ARIF S. DOCTOR, J.]

37. After the Order was pronounced, Mr. Deshmukh, appearing on behalf of the Respondent, sought a stay for a period of four weeks. This was strongly opposed by Mr. Khandekar, who submitted that sufficient time had already elapsed and that this Court had specifically clarified that the Order was passed only in the peculiar facts of the present case. However, Mr. Deshmukh submitted that he had instructions to press for a stay, submitting that ramifications of this could be very wide. I am therefore inclined to grant a stay as prayed. Hence, the effect of this order shall remain stayed for a period of four weeks from today.

[ARIF S. DOCTOR, J.]