

Landmark Ruling On Patent Amendment Claims

In a landmark ruling on the allowability of claim amendments under Section 59 of the Patents Act, the Delhi High Court set aside a refusal order of the Indian Patent Office that had rejected a patent application on the grounds that the amended claims did not fall wholly within the scope of the originally filed claims (*Allergan Inc v. The Controller Of Patents C.A.(COMM.IPD-PAT) 22/2021*). The amendment in question related to converting claims directed to a method for treating an ocular condition using an intracameral implant, to the intracameral implant itself.



The applicant, Allergan (represented by the Firm), assailed the refusal order on the grounds that sufficient and proper reasoning had not been provided for rejecting the amendments and, therefore, the patent application. Allergan's position was that there was overwhelming support in the specification and the original claims for the intracameral implant aspect of the invention. Allergan emphasised that although the preamble of the claims was directed to a method of treatment, that, by itself, could not be the basis of the Patent Office's position regarding the scope of the amendments. Since the original claims recited a method of treating an ocular condition using an implant, the amendments to claim the implant itself could not be construed as claiming an invention which was beyond the scope of the claims as originally applied for.

On the other hand, the Patent Office's position was that the provision governing amendments, viz., Section 59, should be interpreted narrowly and that amendments should be construed within the confines of the original claims only. The description cannot be relied upon for the purposes of establishing support for any amendments. Accordingly, it was their position that since the original claims were directed to a process, i.e., a method of treating an ocular condition, the applicant should not be permitted to amend the claims in such a manner so as to claim exclusivity over a product, namely, an intracameral implant, and only amendments relating to a process would fall within the scope of the original claims.

The court disagreed with the Patent Office's position and espoused the view that the object of patent law is to foster innovation, research, technology, and industrial progress. Accordingly, the provisions of the Patents Act should not be interpreted in an unduly restricted manner that would discourage innovation and entrepreneurship. In the court's considered opinion, the claims and the specification should be read as a whole when evaluating the scope of the amendments. Going a step further, the court observed that in arriving at any decision, it "*is also required to keep in mind public interest, being one of the cardinal aims of patent law, especially where the patent is pharmaceutical or therapeutic in nature.*" Therefore, if the Patent Office's interpretation was accepted, then "*the result would be that [Allergan] would be foreclosed from seeking a patent in respect of the implants which, according to it, are a result of the [Allergan's] own inventiveness and which are intended to cure a wide variety of ocular ailments.*" The court also opined that the amendments sought by the applicant were based on restrictions mandated by India's Patents Act. Accordingly, since a method of treating a condition was non-patentable in India (under Section 3(i)), amending such claims to a product claim was not improper. Further, the court, after exhaustive analysis, held that sufficient proof had been put forth by the applicant to establish that the amendments were supported by the originally filed description and encompassed within the scope of the original claims. Therefore, the amendments fell adequately within the confines of Section 59. Rejecting the application based only on the allowability of the proposed amendments was considered erroneous. Accordingly, the matter has now been remanded back to the Patent Office to accept the amendments and pronounce a decision on merits.