

# Amending Patent Claims

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In *Mitsui Chemicals v. Controller of Patents (C.A. (COMM.IPD-PAT) 196/2022)*, the Delhi High Court adjudicated on issues relating to Section 3(h) and Section 59 of the Patents Act, 1970 ('the Act'). The court held that the interpretation of the Controller on not being able to allow the reintroduction of deleted PCT claims during the prosecution stage of national phase applications amounted to misunderstanding the procedure of amendment of claims. This decision also established that methods of treatment of plants cannot be objected to under Section 3(h) of the Act.



Section 3(h) of the Act bars patenting of inventions relating to a method of agriculture or horticulture. Further, any amendments in the specification and patent claims are governed by the provisions of Sections 57 and 59 of the Act.

Mitsui filed a patent application (3877/DELNP/2009) with national phase claims directing to 'method of preventing plant disease and insect damage'. The claims were subsequently amended to 'an insecticidal composition' to overcome the objection under Section 3(h) of the Act. Pursuant thereto, the Controller refused the patent application on the grounds that the amended claims did not fall within the scope of the original claims directing to a method of treatment of plants as per Section 59(1) of the Act and maintained the objection on the national phase claims for falling under the purview of Section 3(h) of the Act.

Aggrieved, Mitsui approached the Delhi High Court by filing an appeal against the Controller's order. It contended that the Controller's assertion in treating the 'original claims' as 'method claims' was incorrect. The first and second original claims in the PCT application were already directed towards an 'insecticidal composition'. Thus, this directly contradicted the Controller's assertion that the pre-amended claims focused on 'method of treatment of plants'. Mitsui further submitted that since no formal request for amending the claims was filed while filing the national phase application in India, the original PCT claims directing to a insecticidal composition should have been considered for evaluating the scope of the amended claims (directing to insecticidal composition) filed in response to the FER instead of the national phase claims (directing to method of preventing plant disease and insect damage).

The court adjudicating the matter relied on the provisions of Section 138(4) of the Act which indicates that for a PCT application designating India, the claims as filed in the international application are inherently considered to be a part of the complete specification for the purposes of the Act. The court further placed reliance on the provisions of Section 138(6) of the Act which permits applicants to incorporate amendments proposed before the international searching authority or preliminary examination authority into their national phase application in India, should they elect to do so. It was noted that no evidence of an amendment request under Form 13 was filed for the PCT claims at the national phase entry. Hence, the court stated that the Controller mistakenly referenced the modified claims (directing to method of preventing plant disease and insect damage) from the national phase application instead of the original PCT claims. The court even clarified that the pre-existing procedural requirements are applicable in the matter in question in which prior to the 2016 amendment of Rule 20, claim deletion during national phase entry was not permitted.

It was held that not being able to reintroduce deleted PCT claims during the prosecution stage of national phase applications amounted to misunderstanding the procedure of amendment of claims.

The court also clarified that while rejecting an application under Section 3(h) of the Act, a more nuanced and detailed analysis is required to scrutinise whether the invention genuinely constitutes a 'method of agriculture' or embodies an innovative technical solution to agricultural challenges not falling within the ambit of Section 3(h) of the Act. A similar position has also been echoed by the High Court of Calcutta in the matter of *Decco Worldwide Post Harvest Holdings B. V & Anr. v. The Controller of Patents and Designs & Anr* (C.A.(COMM.IPD-PAT) 196/2022).

Accordingly, the court concluded that the impugned order was unsustainable and set the same aside, remanding the matter back to the Patent Office for *de novo* consideration. Mitsui Chemicals was represented by Remfry & Sagar.

This judgement underscores the importance of procedural adherence regarding the evaluation of patent claim amendments during the prosecution stage. The court in this matter has established that methods of treatment of plants cannot be objected to under Section 3(h) of the Act, which covers traditional methods of agriculture. The judgement also made it clear that providing reasoned orders in patent proceedings is of the utmost importance.