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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
\+ C.A.(COMM.IPD-PAT) 196/2022
MITSUI CHEMICALS INC ..... Appellant

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

versus

CONTROLLER OF PATENTS ..... Respondent
Through: Ms. Nidhi Raman, CGSC with Mr. Zubin Singh, Advocates.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

O R D E R

% 23.02.2024

1. The Appellant's patent application no. 3877/DELNP/2009 has been refused under Section 15 of the Patents Act, 1970 [hereinafter 'the Act'], The refusal order dated 24th February, 2015 [hereinafter 'Impugned order'], passed by the Assistant Controller of Patents, the Respondent, holds that the claims made in the patent application fall within the scope of Section 3(h) of the Act, rendering them non-patentable. Additionally, the Respondent has held that a formal request (Form 13), to amend 'method claims' to 'composition claims', contravene Section 59 of the Act and has accordingly disallowed the same.

2. The subject invention, as found in the amended claims, is stated to be "*An insecticidal composition, comprising penthiopyrad and dinotefuran as active ingredients, wherein the composition is used for applying the*

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composition to plant seeds or contacting plant seeds with the composition, wherein the content of penthiopyrad is 0.1% to 85% by weight, with respect to the total amount of the composition, and the content of dinotefuran is 0.1% to 85% by weight, with respect to the total amount of the composition."

3. At the outset, for clarity, let's compare the original PCT claims with the claims filed when entering the national phase in India. Copies of both are included in the record.

Copy of Original PCT Claims

Claims:

1. A plant disease and insect damage control composition comprising active ingredients of: at least one neonicotinoid compound chosen from the group consisting of dinotefuran, clothianidin, nitenpyram, thiamethoxam, imidacloprid, thiacloprid, and acetamiprid; and
(RS)-N-[2-(1,3-dimethylbutyl)thiophene-3-yl]-1-methyl-3-trifluoromethyl-1H-pyrazo le-4-carboxamide (common name: penthiopyrad).

2. The plant disease and insect damage control composition according to claim 1, wherein the at least one neonicotinoid compound comprises dinotefuran.

3. A method of preventing plant disease and insect damage, the method comprising applying the composition according to claim 1 or 2 to plant seeds.

4. A method of preventing plant disease and insect damage, the method comprising contacting the composition according to claim 1 or 2 to plant seeds.

5. The prevention method according to claim 4, wherein the contact method to plant seeds is spray treatment, coating treatment, dip treatment, or dressing treatment.

6. The method according to any one of claims 3 to 5, wherein the plant seed is selected from the group consisting of: seeds of corn, soya bean, cotton, rice, sugar beet, wheat, barley, sunflower, tomato, cucumber, eggplant, spinach, podded peas, Japanese pumpkin, sugarcane, tobacco, sweet pepper and rape; seed potatoes of taro, potato, sweet potato and konnyaku; and bulbs of edible lily and tulip.

7. A plant seed to which the composition according to claim 1 or 2 has been applied.

8. An agricultural formulation comprising the composition according to claim 1 or 2 selected from the group consisting of a wettable powder, a flowable, a granular wettable powder, a powder formulation, and an emulsion.

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Copy of claims filed at the time of National phase entry

Claims:

1. A method of preventing plant disease and insect damage, the method comprising applying the composition comprising dinotefuran and penthiopyrad as active ingredients.

2. A method of preventing plant disease and insect damage, the method comprising contacting the composition comprising dinotefuran and penthiopyrad as active ingredients.

3. The prevention method according to claim 2, wherein the contact method to plant seeds is spray treatment, coating treatment, dip treatment, or dressing treatment.

4. The method according to claim 1, wherein the plant seed is selected from the group consisting of: seeds of corn, soya bean, cotton, rice, sugar beet, wheat, barley, sunflower, tomato, cucumber, eggplant, spinach, podded peas, Japanese pumpkin, sugarcane, tobacco, sweet pepper and rape; seed potatoes of taro, potato, sweet potato and konnyaku; and bulbs of edible lily and tulip.

5. The method according to claim 2, wherein the plant seed is selected from the group consisting of: seeds of corn, soya bean, cotton, rice, sugar beet, wheat, barley, sunflower, tomato, cucumber, eggplant, spinach, podded peas, Japanese pumpkin, sugarcane, tobacco, sweet pepper and rape; seed potatoes of taro, potato, sweet potato and konnyaku; and bulbs of edible lily and tulip.

6. The method according to claim 3, wherein the plant seed is selected from the group consisting of: seeds of corn, soya bean, cotton, rice, sugar beet, wheat, barley, sunflower, tomato, cucumber, eggplant, spinach, podded peas, Japanese pumpkin, sugarcane, tobacco, sweet pepper and rape; seed potatoes of taro, potato, sweet potato and konnyaku; and bulbs of edible lily and tulip.

4. The Patent Office issued a First Examination Report (FER) dated 31st May, 2013 objecting to the national phase claims under Section 3(h) of the Act. The applicant responded with a revised set of claims on 12th November, 2013. After examining the revised claims, the patent office found them to still running afoul Section 3(h) and issued a subsequent report on February 26th, 2014. In response, the Appellant submitted amended claims along with

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Form 13 on 12th May, 2014 which are as follows:

1. An insecticidal composition, comprising penthiopyrad and dinotefuran as active ingredients, wherein the composition is used for a method of preventing insect damage, the method comprising:

applying the composition to plant seeds; or

contacting plant seeds with the composition,

wherein the content of penthiopyrad is 0.1% to 85% by weight, with respect to the total amount of the composition, and the content of dinotefuran is 0.1% to 85% by weight, with respect to the total amount of the composition.

2. The insecticidal composition as claimed in 1, wherein the amount of the composition is 0.1% to 30%, with respect to the dry weight of plant seeds.

3. The insecticidal composition as claimed in 1, wherein the contacting plant seeds is by spray treatment, coating treatment, dip treatment, or dressing treatment.

4. The insecticidal composition as claimed in 1, wherein the plant seed is selected from the group consisting of: seeds of corn, soya bean, cotton, rice, sugar beet, wheat, barley, sunflower, tomato, cucumber, eggplant, spinach, podded peas, Japanese pumpkin, sugarcane, tobacco, sweet pepper and rape; seed potatoes of taro, potato, sweet potato and konnyaku; and bulbs of edible lily and tulip.

In the Impugned Order, the Respondent emphasizes a significant shift in the scope of the claims. The original application focused on a "Method of Treatment of Plant," while the amended version claims an "insecticidal composition." This alteration changes the focus from a process to a product. Consequently, the Respondent ruled that these amendments were inadmissible under Section 59 of the Act. The relevant extract of the Impugned order is reproduced herein below:

> *"[D] Discussion on pending objections: First I would like to discuss the objection raised In paragraph 3 regarding amendment of claims. As per the section 59 "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"*** *Here section 59 clearly says that scope of*

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amended claim should fall wholly under the scope of the claim before the amendment. In the instant application the claims before amendments were directed to 'A method of preventing plant disease and insect damage" whereas amended claims were directed to "An insecticidal composition". Here it can be seen that scope of both the claims is entirely different. Therefore the amendment of the claim by the way of Form-13 is not allowable. The reply given by agent of the paragraph 3 of the hearing letter is not acceptable. The decision is being given on the originally filed claim. Since the method of preventing plant disease and insect damage falls under the category of method of agriculture, the objection raised by examiner in paragraph 1 is maintained and claims are not allowable under section 3(h). Since the claims are not patentable under section 3(h), the objection of the learned examiner regarding paragraph 2 is need not to be considered. Objections 3 and 4 have been complied by the agent.

[E] In view of all the above discussion I am of the opinion that the claims of the present application are not patentable u/s 3(h) of the Patents Act. Therefore instant application is being refused for further processing of grant. A Pre-grant opposition u/s 25(1) has been filed by the M/s Haryana Pesticides Manufacturers' Association against the instant application on 30/01/2015. In view of refusal of the present application the pre-grant opposition automatically stands disposed off."

5. Mr. Ankush Verma, counsel for Appellant, contests the Assistant Controller's characterization of the 'original claims' as 'method claims.' He argues that the original claims (1 & 2) in the PCT application were already directed towards an "insecticidal composition." This directly contradicts Respondent's assertion in the Impugned Order that the pre-amended claims focused on a 'method of treatment of plants.' Mr. Verma cites section 138(4) of the Act to argue that under this provision, an international PCT application, designating India, functions as a patent application under specific sections (7, 54, and 135) of the Act. He emphasizes that the specifications and claims from the international application become the complete specification under the Indian Patents Act, 1970. Mr. Verma argues that the Respondent overlooked the application's origin as a national

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phase application based on a PCT filing (bearing application no. PCT/JP2007/072526). He contends that the amended claims fall within the scope of the original PCT claims (1 & 2) because of the binding nature of Section 138(4) of the Act. This, according to him, demonstrates that the amendments do not violate Section 59 of the Act, which restricts certain types of amendments. Therefore, he asserts that the amendments don't violate Section 59 of the Act. To further strengthen his argument, Mr. Verma references Controller General's notification dated 2nd July 2012, which likely clarifies the interpretation of Section 138(4). The relevant excerpt from the notifications reads as under:

Instructions

1) a. For filing a PCT National Phase Application in India, which does not claim priority of any PCT National Phase Application filed previously in India, only the following contents are required to be populated in Form 2:
   i) Column 1, 2 and 3; and
   ii) The last page of claims (first page, if claims comprise of only one page) with date and signature.

   b. It is clarified that if an Applicant, for the aforementioned category of Applications, submits a Form 2 in which columns other than 1, 2 and 3 are also populated, the IPO will consider the contents accessed from IB.
   c. All other applicable documents are still required to be filed.

   Note:
   i. For the applications of the type referred to above, columns 7 and 8 of Form 1 need not be populated in any case.
   ii. It is clarified that the IPO does not allow an Applicant to amend the specification or the related documents before he actually enters National Phase in India. These directions are in consonance with the aforementioned practice.

2) The documents filed by the Applicant should exactly correspond with the up-to-date information available on the record of IB on the date of filing of the PCT National Phase Application in India. The said information must have been notified / published by the IB in accordance with the PCT and the Regulations made thereunder. Any request pending with the IB shall be of no consequence and should not be reflected in the documents. If any such request is reflected in the documents, the information notified/published by IB shall prevail.

3) The requirement of filing complete specification and abstract in Form 2 at the time of filing of a PCT National Phase Application in India is being dispensed with for the Applications under reference, as explained in (1) above. However, where the international application was either not filed or has not been published in English, the Applicant shall file translation of the Application in English, duly verified by the Applicant or the person duly authorized by him that the contents thereof are correct and complete.

4) The Applicants will be required to comply with all other requirements in accordance with the Patents Act, 1970 and the Patents Rules, 2003.

5) These instructions shall come into effect on 6th July, 2012.

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6. Mr. Verma further argues that the Assistant Controller overlooked a key detail. Since there was no formal request for amending the claims when filing the national phase application in India, the claims on record at that time were the original PCT claims. However, the Respondent stated their decision was based on "the originally filed claim," which appears to reference the national phase application, not the original PCT claims. This, according to Mr. Verma, renders the Impugned Order flawed. He argues that the Respondent should have compared the amended claims to the original PCT claims, not the initial filing in India. By using the wrong reference point, Mr. Verma contends, the Respondent applied the incorrect standard when evaluating whether the amended claims fall within the scope of the original claims.

7. Ms. Nidhi Raman, CGSC for Respondent, counters the arguments made by Mr. Verma. Firstly, Ms. Raman highlights that the Appellant's initial filing in India did not include claims for the "insecticidal composition." Instead, the focus was on a "method of treatment of plants." This suggests that the Appellant intentionally narrowed the scope of the claims during the national phase filing. Secondly, Ms. Raman argues that Mr. Verma's contention regarding the amended claims falling within the scope of the original PCT application is unfounded. She points out that the Appellant themselves deleted those specific claims (1 & 2) while filing the application in India. According to Ms. Raman, Rule 20 of the Patent Rules, 2003, clearly allows applicants to delete claims from their PCT application during the national phase filing process. Since the Appellant chose to delete claims 1 & 2, Ms. Raman argues they cannot reintroduce them through amendments. In conclusion, Ms. Raman emphasizes that the amended

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claims pertain to an "insecticidal composition," which goes beyond the scope of the originally filed claims in India ("method of treatment of plants").

Analysis and findings

8. The crux of the contentions urged by both parties concern the procedural adherence regarding the treatment of claims during the national phase entry of a PCT application into India. In evaluating the submissions put forth by the counsel for both parties, the Court's analysis revolves around the interpretation of Section 138 of the Act, as well as the amendments to the Patents Rules, specifically Rule 20, and the clarifications offered in the revised Manual of Patent Office Practice and Procedure.

9. A plain reading of Section 138(4) of the Act unmistakably indicates that for a PCT application designating India, the claims as filed in the international application are inherently considered to be part of the complete specification for the purposes of the Indian Patents Act. Furthermore, Section 138(6) of the Act 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. This provision underscores that the Indian Patent Office, within the legal framework, adopts a nuanced approach towards amendments during the national phase entry, allowing a degree of flexibility, while ensuring that any such changes are explicitly sought by the applicant and formally integrated into the application process.

10. During the national phase entry of a PCT application, amendments can be requested under Section 57 of the Act by filing Form 13. However, in the absence of such a request, the Respondent's examination should be

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confined to the original PCT claims. In the present case, the record reveals no evidence of an amendment request (Form 13) being filed for the PCT claims at the national phase entry. This leads us to the inevitable conclusion that any amended claims introduced at this stage using Form 13 must have been compared against the original PCT claims. However, it appears that the Respondent mistakenly referenced the modified claims from the national phase application (which perhaps were filed mistakenly by the Appellant) instead of the original PCT claims.

11. The legislative and procedural backdrop discussed above, particularly the amendment of Rule 20 of the Patents Rules in 2016, further reinforces Court's conclusion. Rule 20 of the Patent Rules was amended in the year 2016 to allow patent applicant(s) to delete claim(s) at the time of national phase entry. This modification allowed for the deletion of claims at the national phase entry, an option which was previously not available. This modification empowers applicants with the choice to tailor their patent application as they enter the national phase. This provides flexibility without compromising the core procedural rules for amendments enshrined in Section 57 of the Act. Nonetheless, it's imperative to distinguish between permissible deletions and other forms of amendments – the latter, including additions, revisions, or modifications of claims, remain outside the purview of allowable actions, without the formal process of amendment prescribed by the Act. The revised Manual of Patent Office Practice and Procedure (2019) reaffirms this, explicitly stating that while claim deletions are allowed to align with the procedural framework, no other alterations are permissible. It provides thus:

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"*However, at the time of filing the national phase application corresponding to international application designating India, the applicant may delete a claim as provided in rule 20 (1), in accordance with the provisions contained in Rule 14, without filing an application for amendment. It is clarified that only deletion of claims is allowable and no other amendment, such as addition, revision or modification of claims, is allowable.*

However, this option as to deletion of claims is not applicable for the applications filed prior to amendments of the Patents Rules 2003 implemented w.e.f. 16-05-2016."

12. However, prior to the 2016 amendment of Rule 20, claim deletion during national phase entry was not permitted. As Appellant's application predates the amendment, it is the pre-existing procedural requirements that are applicable.

13. Based on the above, it becomes evident that the Respondent have erred in their assessment. They should have focused their analysis on the original PCT claims and disregarded the modified claims submitted during the national phase entry. The Respondent's argument that the Appellant has 'deleted' claims 1 and 2 of the PCT claims, and thus cannot reintroduce them, is misunderstanding of the procedure of amendment of patent claims during the national phase entry under the Patent Cooperation Treaty (PCT).

14. In addressing the Respondent's objection under Section 3(h) of the Patents Act, the Court finds the Impugned Order lacking in substantive rationale. The order merely reiterates the Examiner's objection that the claimed method of preventing plant diseases and insect damage falls within the non-patentable realm of 'method of agriculture' under Section 3(h) of the Act. However, the order lacks any substantive analysis or justification explaining precisely why the specific subject matter of the claims falls

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squarely within the ambit of Section 3(h) of the Act. The relevant excerpt of the Impugned Order on this issue reads as follows:

> *"Since the method of preventing plant diseases and insect damage falls under the category of method of agriculture, the objection raised by Examiner in paragraph 1 is maintained and claims are not allowable under Section 3(h)"*

15. The Impugned Order, devoid of any reasoning for classifying the subject matter of the claims under Section 3(h) of the Act, is thus liable to be set aside. The Court emphasizes the necessity for a more nuanced and detailed analysis of the claimed invention. This analysis must scrutinize whether it genuinely constitutes a 'method of agriculture' or embodies an innovative technical solution to agricultural challenges that might not fall within the exclusions of Section 3(h) of the Act. Crucial to this assessment is a clear distinction between purely agricultural methods and those with technical or scientific foundation addressing agricultural problems. Moreover, the Court directs the Respondent to re-evaluate their objection under Section 3(h), considering the evolving legal landscape and judicial interpretations. This re-examination must draw upon a comprehensive understanding of relevant case law, particularly the significant judgment by the High Court of Calcutta in ***Decco Worldwide Post Harvest Holdings B. V & Anr. v. The Controller of Patents and Designs & Anr.***[1] This judgment may offer valuable insights into the interpretation of 'methods of agriculture' and the patentability of innovations addressing agricultural problems using scientific principles.

16. It is clarified that since the Impugned order is being set aside for the foregoing reasons, the court has not gone into the other contentions urged by

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the Mr Verma on the scope of section 59 of the Act.

17. In light of the above, in the opinion of the Court, the matter should be re-considered by the Respondent *de novo*. Accordingly, following directions are issued:

(i) The impugned order is set aside, and the matter is remanded to the Respondents for de novo consideration.

(ii) The patent application for the subject patent is restored to its original number.

(iii) Prior to deciding the matter afresh, Appellant shall be granted a hearing, and the notice of such hearing must clearly delineate all the objection(s).

(iv) After completion of hearing, the decision thereon shall be rendered within a period of four months from the date of conclusion of hearing.

(v) The Respondent shall decide the application uninfluenced by any observations made in the impugned order and all rights and contentions of the parties are left open.

18. With the above directions, the appeal stands disposed of along with pending applications, if any.

SANJEEV NARULA, J

FEBRUARY 23, 2024
as
[Corrected and released on 11th March, 2024]

[1] In AID No. 11 of 2021.

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