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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 04.10.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(PT)/14/2023
(ORA/41/2020/PT/CH)

1.Commonwealth Scientific and
Industrial Research Organization,
Scientific and Industrial Research of Limestone Avenue,
Campbell, Australian Capital Territory, 2612,
Australia.

2.University of Zurich of Unilectra,
Technology Transfer Office,
Scheuchzerstrasse 21, Ch-8006 Zurich,
Switzerland

... Appellant

vs.

The Assistant Controller of Patents and Designs,
The Patent Office, IPR Building,
SIDCO Plot, GST Road,
Guindy, Chennai - 600 032.

... Respondent

PRAYER: Transfer Civil Miscellaneous Appeal (Patents) filed
under Section 117-A of the Patents Act, 1970, praying to (i) allow
the present Appeal and set aside/quash the impugned order dated



24.01.2020 passed by the respondent in Indian Patent Application No.2072/CHENP/2011;(ii) allow the said Indian Patent Application No. 2072/CHENP/2011 and direct grant of patent in respect thereof.

For Appellant : Mr.Shatadal Ghosh
Mr.Abhishek Jan
Mr.K.Muthuselvam
for M/S.K and S Partners

For Respondent : Mr.Rajesh Vivekanandan
Deputy Solicitor General

JUDGMENT

The appellants impugn an order dated 24.01.2020 by which amended claims 1 to 11 were rejected on the ground that they are beyond the scope of Section 59 of the Patents Act, 1970 (the Patents Act) and, consequently, Indian Patent Application No.2072/CHENP/2011 was rejected.

1. The above mentioned patent application was submitted by



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the appellant along with 39 original claims. Under the First Examination Report (FER), objections were raised under Section 2(1)(j), various clauses of Section 3, and Sections 10(4) and 10(5) of the Patents Act. In response, the appellant amended its claims and submitted amended claims 1 to 26 (the first set of amended claims). Significantly, original claim 1 relating to a transgenic plant and claims dependent thereon were deleted. The first set of amended claims were based largely on original claims 13, 14, 18 and 20. In the hearing notice, objections were raised, once again, under Sections 2(1)(j), 3 and 10(4) and 10(5) of the Patents Act. Thereafter, the appellant submitted 11 further amended claims (the current set of amended claims). These claims were rejected as being beyond the scope of Section 59 of the Patents Act. Hence, this appeal.

2.

3. Learned counsel for the appellant submitted that the current set of amended claims fall squarely within the scope of the



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original claims. By inviting my attention to original claims 13, 14, 18 and 20, learned counsel contended that the current set of amended claims are not only within the scope of the above mentioned original claims but have considerably narrowed down the width of the original claims. In addition, learned counsel submitted that the said claims are well within the scope of the complete specification. By inviting my attention to the summary of the invention at page 43 of the appeal paper book, learned counsel pointed out that the amended claims are described therein in substance. Similarly, by drawing reference to page Nos.45, 53 and 65 of the appeal paper book, learned counsel contended that all the elements of the current set of amended claims are described in substance in the complete specification. In particular, learned counsel pointed out that nucleic acid constructs and elements which operably connect a promoter or enhancer element to a transcribable polynucleotide were referred to expressly at page 65 of the paper book.



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4. Consequently, learned counsel submitted that the rejection of the current set of amended claims by referring to Section 59 of the Patents Act is completely untenable. With regard to the interpretation of Section 59, learned counsel relied upon a judgment of the Delhi High Court in *Allergan Inc v. The Controller of Patents (Allergan)*, 2023/DHC/000515.

5. In response to these contentions, Mr.Rajesh Vivekanandan, learned Deputy Solicitor General, contended that amended claim 1 of the current set of amended claims expands the scope of original claim 18 by drawing reference to nucleic acid construct comprising a polynucleotide. By comparing and contrasting amended claim 1 with claim 18 of the original set of claims, Mr.Rajesh Vivekanandan submitted that original claim 18 was limited to an isolated and/or exogenous polynucleotide whereas amended claim 1 pertains to a nucleic acid construct comprising a polynucleotide. Besides, Mr.Rajesh Vivekanandan submitted that the original set of claims were amended pursuant



to the FER by deleting reference to the promoter, whereas the rejected claims make reference to the polynucleotide being linked to a heterologous promoter. Therefore, learned counsel submitted that the impugned order contains no infirmity and that it is in conformity with Section 59 of the Patents Act.

6. By way of rejoinder, learned counsel for the appellant pointed out that amended claim 1 should be read as a whole. If so read, it is evident that the monopoly claim is restricted to a nucleic acid construct comprising a polynucleotide, wherein the polynucleotide is operably linked to a promoter and wherein the pathogens (*puccinia graminis f. sp. tritici*, *puccinia striiformis* or *puccinia recondita f. sp. Tritici*) are named. Thus, learned counsel submitted that the monopoly claim has been considerably whittled down in amended claim 1.

7. The case turns largely on the interpretation of sub-section (1) of Section 59, which is set out below:



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59. *Supplementary provisions as to amendment of application or specification-*

(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.*

Sub-section 1 may be divided into three limbs. The first limb contains the overarching limitation that an application for a patent or a complete specification or any document relating thereto shall not be amended except by way of disclaimer, correction or explanation subject to the further caveat that it shall be permitted



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only for the purpose of incorporation of an actual fact. The ambit of the first limb is wide and applies to all amendments relating to a patent application, including to documents filed in relation thereto. The second limb is focused on amendments to the specification and does not permit amendments which claim or describe matter not in substance disclosed or shown in the specification prior to the amendment. The third limb is focused on the claims in the specification and restricts amendments to those that would fall wholly within the scope of the claims prior to such amendment.

8. In *Allergan*, the Delhi High Court interpreted this provision and concluded that the second and third limbs, as described above, should not be interpreted as water-tight compartments. In effect, the Delhi High Court concluded that an application for amendment should be allowed provided the amended claims fall in substance within the scope of the complete specification.



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9. Turning to the facts of the present case, original claims 13,

14, 18, and 20 are as under:

"13. A substantially purified and/or recombinant adult plant pathogen resistance polypeptide.

14.The polypeptide of claim 13 which comprises amino acids having a sequence as provided in SEQ ID No:1, a biologically active fragment thereof, or an amino acid sequence which is at least 40% identical, or at least 80 % identical, or at least 90% identical, to SEQ ID No:1.

18.An isolated and/or exogenous polynucleotide comprising nucleotides having a sequence as provided in SEQ ID No:2, a sequence which is at least 40 % identical to SEQ ID No:2, a sequence encoding a polypeptide according to any one of claims 17 to 23, and/or a sequence which hybridizes to SEQ ID No:2.

20.The vector of claim 19, wherein the polynucleotide is operably linked to a promoter."



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10. The current set of amended claims, include independent claim 1, which is as under:

"1. A nucleic acid construct comprising a polynucleotide encoding an adult plant pathogen resistance polypeptide which comprises amino acids having a sequence as provided in SEQ ID No.1, or an amino acid sequence which is at least 95% identical to SEQ ID No.1, wherein the polynucleotide is operably linked to a heterologous promoter, and wherein the pathogen is Puccinia graminis f. sp. tritici, Puccinia striiformis or Puccinia recondita f. sp. tritici."

11. Both from the impugned order and the contentions of Mr.Rajesh Vivekanandan, it is clear that the objection is focused on



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the above amended claim; therefore, it is necessary to compare and contrast current amended claim 1 with original claims 14, 18 and 20. In addition, it is also necessary to consider relevant portions of the complete specification. Original claim 13 pertained to a substantially purified and/or recombinant adult plant pathogen resistance polypeptide. Original claim 14 dealt with the polypeptide of claim 13 which comprises amino acids having a sequence as provided in SEQ ID No.1, a biologically active fragment thereof, or an amino acid sequence which is at least 40% identical, or at least 80 % identical, or at least 90% identical, to SEQ ID No:1. Original claim No.18 pertained to an isolated and/or exogenous polynucleotide comprising nucleotides having a sequence as provided in SEQ ID No:2, a sequence which is at least 40 % identical to SEQ ID No:2, a sequence encoding a polypeptide according to any one of claims 17 to 23, and/or a sequence which hybridizes to SEQ ID No.2. Original claim 20 pertained to the vector of claim 19, wherein the polynucleotide is operably linked to a promoter.



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12. The summary of the invention at lines 20 to 25 of page 43 of the paper book refers to an embodiment of the invention, namely, polypeptide comprising amino acids having a sequence as provided in SEQ ID No.1. At page 45 of the paper book, the said summary draws reference to an isolated and/or exogenous polynucleotide comprising nucleotides having a sequence as provided in SEQ ID No.2. The expressions polypeptides/peptides are described at pages 53 and 54 of the paper book and, at page 65, the specification deals with nucleic acid constructs, including operably connecting a promoter or enhancer element to a transcribable polynucleotide.

13. The current amended claim 1 refers to a nucleic acid construct comprising a polynucleotide. Without the insertion of particulars that constrict its scope, it could have been contended that it is wider than the original claims. Current amended claim 1 specifies, however, that the polynucleotide encodes a polypeptide



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which comprises amino acids with a sequence identical to or at least 95% identical to SEQ.ID No.1. The target pathogens are also expressly named. Thus, the specificity incorporated in current amended claim 1 curtails rather than expands the scope of the original claims. Consequently, it cannot be said that the amendments go beyond disclaiming, correcting or explaining the original claims. When the above original claims and descriptions in the complete specification are compared to the current amended claim 1, it certainly cannot be concluded that current amended claim 1 is beyond the scope of the original claims read with the complete specification. In fact, in substance, it appears that it falls wholly within the scope of and, indeed, whittles down the width of the original claims. Thus, even if the second and third limbs of sub-section 1 of Section 59 of the Patents Act were to be construed as distinct compartments, the appellant has satisfied the requirements thereof.

14. The impugned order of rejection was entirely on the



ground that the current set of amended claims are beyond the scope of Section 59. As a consequence of the above discussion, such conclusion is untenable and, therefore, the impugned order is hereby set aside. It is needless to say that no opinion is being expressed on the merits of the claimed invention. As a corollary, the matter is remanded for reconsideration of the patent application on the basis of the current set of amended claims (i.e. claims 1 to 11). In order to preclude the possibility of pre-determination, such reconsideration shall be undertaken by an officer other than the officer who issued the impugned order by providing a reasonable opportunity to the appellant. A reasoned decision shall be issued within a period of four months from the date of receipt of a copy of this order.

15. T(CMA)(PT)/14/2023 is disposed of on the above terms. Consequently, the connected miscellaneous petition, if any, is also closed.



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Index : Yes/No

Internet : Yes/No

Neutral Citation: Yes/No

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To:

The Assistant Controller of Patents and Designs,
The Patent Office, IPR Building,
SIDCO Plot, GST Road,
Guindy, Chennai 600 032.



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SENTHILKUMAR RAMAMOORTHY, I
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