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(T)CMA(PT) No.153 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 12.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(PT) No.153 of 2023
(OA/29/2020/PT/CHN)

Hygieia, Inc.
2725 South Industrial Highway
Suite 200
Ann Arbor
Michigan - 48104
USA

... Appellant

Vs.

Assistant Controller of Patents and Designs
Government of India, Patent Office
Intellectual Property Rights Building
GST Road, Guindy
Chennai - 600 032

... Respondent

Prayer : Civil Miscellaneous Appeal filed under Section 117A of the Patents Act, 1970, (i) to set aside the impugned order and decision dated 03.12.2019 of the learned Assistant Controller of Patents & Designs, the respondent herein, in connection with Patent Application No.10225/CHENP/2013; and (ii) to direct the Controller of Patents to grant a patent on said Patent Application No.10225/CHENP/2013.



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For Appellant : Mr.P.V.Balasubramaniam,
Senior Advocate for
M/s.Depenning and Depenning

For Respondent : Mr.P.G.Santhoshkumar
for Mr.N.Vijayaram, CGSC

JUDGMENT

This appeal is directed against the order of the respondent dated 03.12.2019 by which the latter had rejected the appellant's invention '*Systems, Methods and Devices for Achieving Glycemic Balance*' under Sections 2(1)(ja), 3(d), 3(k) and 59 of the Patents Act, 1970.

2. The facts are :

- The appellant's invention relates to certain embodiments directed to systems, a device and/or methods for treating a patient's diabetes by providing treatment guidance.
- In its application, the appellant had made 22 claims of which the first claim was cited as its independent claim.
- The appellant claims priority to its application based on an application made under the Laws of United States which permit grant of patent for methods. The appellant filed its application for patenting its invention



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under the Patents Act, 1970 in 2013 and in terms of specifications and the claims as provided in appellant's application for grant of patent in the United States the same is required to be taken as an application made under Sections 7, 54 and 135 of the Act. When the application for grant of patent seeks priority based on its application in other jurisdictions, then the application filed in India may not deviate from such application filed before other jurisdiction.

- In these circumstances, the appellant had preferred his application essentially in conformity with its application filed in the United States. One aspect which the appellant is required to negotiate is that while U.S. laws permit patenting a method, under Indian Law, it is treated as a non invention, and hence non patentable.
- It is in this scenario, the respondent responded with his FER wherein he raised objection to the patentability of the appellant's invention under Section 2(1)(ja), which is backed with two prior arts in D1 and D2 followed by objections under Sections 3(d), 3(i), 3(k) and 10(4) of the Act. The appellant would now respond to the FER, and also introduced certain amendments to its original claim and increased them from 22 to 24. It retained its original independent claim, and it also introduced



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another independent claim in Claim No.10 and the rest of the claims are dependent claims.

- The Patent Controller has now served a hearing notice wherein he retained the same set of objections which he had raised in his FER, and added a new objection under Section 59. The appellant participated in the hearing and also submitted its written submissions. Eventually, the respondent had rejected the appellant's application under Section 59 and chose not to embark on a scrutiny of the patentability on other grounds.

3. Heard both sides. The learned counsel for the appellant made the following submissions:

- The Patent Controller, having raised multiple objections, has chosen to hold against the appellant on only one ground, namely objection under Section 59, but he chose not to consider the sustainability of the other heads of objections in the light of the written submissions given by the appellant.
- Turning to the objection under Section 59 of the Act, for it to be sustained, the Controller must demonstrate how the amended claims of the appellant exceeds the original specifications. The title of the



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appellant's invention itself *inter alia* shows that it involves a device. In the original specification, this is indicated in Claim No.4, which reads '*the method of claim 1, wherein the method is performed without any intervention from a doctor or other healthcare professional.*' It could be derived from this that the method contemplated does not involve any intervention from a doctor or a healthcare professional, and hence the method indicated herein necessarily must mean a device. This is explained in amended Claim No.10 where prominence is given to explain the device as such. Therefore, what is explained in amended claim 10 is readable into the original claim No.4. In other words, what is not directly communicated in the original claim No.4 is explained in amended claim No.10. This apart, the figures 1 to 8 which form part of the original specifications, essentially deal with the device, and inasmuch as these figures form part of the original specification, the Controller ought to have taken them into account. The approach of the Controller herein runs contra to the ratio of the Delhi High Court in ***Allergan Inc. vs. The Controller of Patents dated 20.01.2024*** [C.A. (Comm.IPD-PAT) 22/2021].



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4. This court carefully weighed the rival submissions. The law on the aspect is well captured by a learned single Judge of the Delhi High Court and this holds a key for resolving the controversy before this court. The relevant paragraphs are extracted hereunder:

"12. Insofar as the failure of the appellant to seek a claim to patent "compositions for intracameral implant" in the PCT application or while entering the national phase, learned Counsel for both sides are ad idem that this discrepancy was owing to a difference in the patentability regime in the US and in India. Method claims are patentable in the US, whereas they are not patentable in India, by virtue of Section 3(i) of the Patents Act. The original PCT claim, as filed in the US, which was for methods for treating ocular ailments using the intracameral implants was, therefore, patentable in the US, but would not have been patentable in India. As Mr. Vaidyanathan himself acknowledges, it is only after the original patent application is filed that the patentee proceeds to file national phase applications for the patent in the countries designated in the original PCT application. Different countries have, however, different patent regimes, and it would be impractical, nay impossible, to expect that the claims in the original PCT application, as filed (in this



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case, in the US), would be patentable in every designated country. This is precisely what happened in the present case. The method claim for treating of ocular ailments using intracameral implants was patentable in the US and was, indeed, granted a US patent. In India, however, such a method claim could not be patented, by virtue of Section 3(i). It was for this reason that the appellant amended its claim to a product patent.

14. The answer, in my view, has to be in the negative. The appellant legitimately sought a method patent in its original international PCT application as patents laws in the US, where it was filed, allowed patenting of method patents. No fault can, therefore, be found with the appellant on that score. Insofar as the filing of the National Phase application is concerned, Section 138(4)3 of the Patents Act deems an international PCT application designating India to have the effect of filing of a patent application for grant of the patent in India and also requires the title, description, claim and abstracted drawings filed in the international application to be taken as the complete specification for the purposes of the Patents Act. At the time of entering the National Phase, therefore, there could be no occasion for the appellant to amend the Claims as originally filed in the PCT application in the US.



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35. *The question which is before this Court, for the present, is whether the appellant should be completely foreclosed from seeking a patent in respect of the said implants merely because the original application, as filed by the appellant, sought a patent not for the implants but for the method in which the implants were to be used, whereas the amended claims seek patents for the implants themselves, rather than the method of their usage, even if all details of the implants, and every particular of the amended claims stand completely disclosed in the complete specifications accompanying the original claims.*

36. *Any such view, in my considered opinion, would be completely contrary to the very ethos of the Patents Act, as well as the most elementary principles of patent claim construction. **Bishwanath Prasad Radhey Shyam** [AIR 2022 SC 4917] spoke thus, on patent claim construction, visà-vis the complete specifications:*

*“43. As pointed out in **Arnold v. Bradbury**²³ the proper way to construe a specification is not to read the claims first and then see what the full description of the invention is, but first to read the description of the invention, in order that the mind may be prepared for what it is, that the invention is to be claimed, for the patentee cannot claim more than he desires to*



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patent. In Parkinson v. Simon²⁴ Lord Esher, M.R. enumerated that as far as possible the claims must be so construed as to give an effective meaning to each of them, but the specification and the claims must be looked at and construed together.

44. The learned trial Judge precisely followed this method of construction. He first construed and considered the description of the invention in the provisional and complete specifications and then dealt with each of the claims, individually. Thereafter, he considered the claims and specifications as a whole, in the light of the evidence on record.”

(Emphasis supplied)

*The principle was enunciated, with even greater precision, in the judgement of the Division Bench of this Court authored by S. Ravindra Bhat, J. (as he then was), in the following passage from **Merck Sharp & Dohme Corporation v. Glenmark Pharmaceuticals** [(2015) 63 PTC 257 (Del-DB):*

“48. At this juncture, the Court notes that: -

“the construction of claims is not something that can be considered in isolation from the rest of the specification, Claims are intended



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to be pithy delineations of the scope of monopoly, and they are drafted in light of the much more detailed text of the description. A specification must be read as a whole, just as any document is. It must moreover be read as having been addressed to a person acquainted with the technology in question. So it must take account of that person's state of knowledge at the time.”

(see, Cornish, Llewelyn and Aplin, Intellectual Property, Seventh Ed, Sweet and Maxwell, pages 182-3). ”

(Italics in original; underscoring supplied)

37. Dichotomizing the claims and the accompanying specifications is, therefore, contrary to the most fundamental canons of patent law. That, however, is precisely what the Court would be lending its imprimatur to, were it to accept the interpretation that Mr.Vaidyanathan seeks to place on Section 59(1).

The facts of the present case fits well within the context of the law, as has been declared in this country, and hence no further discussion is required in the matter.



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5. In conclusion, this court allows the civil miscellaneous appeal and sets aside the impugned order of the respondent dated 03.12.2019 made in Indian Patent Application No.10225/CHENP/2013 filed on 23.12.2013 and remands the matter back to the Controller for a *de novo* consideration. To save embarrassment to the Controller who passed the impugned order, this court, now requires some other controller to consider appellant's application for grant of patent. Since the application was filed some 10 years ago in December, 2013, this court directs the controller, who would now be in-charge of the issue to dispose of the matter, as expeditiously as possible, at any rate not later than six months from the date on which he takes cognizance of the issue. No costs.

12.03.2024

Asr

Index: Yes/No

Speaking Order / Non-Speaking Order

Neutral Citation: Yes / No

To

The Assistant Controller of Patents and Designs
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