Amendments at PCT National Phase Entry: DHC in Mitsui Chemicals

# Introduction

In a recent judgment dated February 23, 2024, in *Mitsui Chemicals Inc. vs Controller of Patents* [1], the Delhi High Court set aside a patent refusal order issued by the Controller in respect of patent application No. 3877/DELNP/2009, which had been denied on the grounds of non-compliance with Sections 59 and Section 3(h) of the Indian Patents Act, 1970 (“the Act”).

This case sheds light on the procedural intricacies of amending patent claims during the national phase entry of a PCT application into India, particularly distinguishing between patentable inventions and methods of agriculture. Read on to explore a detailed analysis of this case and the implications of this ruling.

# Facts

Mitsui Chemical filed a PCT national phase application before the Indian Patent Office on June 15, 2009. Original PCT claim 1 was as follows:

“*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).”*

However, claim 1 submitted at the time of national phase entry in India, was as follows. There was no formal request filed for amending the claims when filing the national phase application in India.

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

The Indian application was examined, and the Patent Office issued a First Examination Report (FER), objecting that the claims were non-patentable under Section 3(h), as they were deemed to fall under a “method of agriculture.” The Applicant submitted a revised set of claims to address this objection. However, the Patent Office maintained that the claims were non-compliant with Section 3(h) and issued a subsequent examination report. The Applicant once again submitted amended claims. At this stage, Claim 1 recited as follows:

“*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.”*

Next, the Controller issued a hearing, citing that the amendments were impermissible under Section 59 due to a significant shift in the scope of the claims from “*A method of preventing plant disease*” submitted at the time of national phase entry into India, to “*An insecticidal composition*”, essentially transitioning from a process to a product. Additionally, the refusal order maintained the objection under Section 3(h).

The Applicant chose to retain the above claim during the hearing. The Controller was not satisfied with the Applicant’s submissions during the hearing and finally refused the application for non-compliance with Sections 59 and Section 3(h) of the Indian Patents Act, 1970. Mitsui Chemicals (“Appellant”) elected to file the present appeal against the Refusal Order of the Assistant Controller of the Indian Patent Office (“Respondent”).

# Contentions of the Appellant

The Appellant argued that the original claims of the PCT application were directed toward an "insecticidal composition," contrary to the Respondent's statement in the Impugned Order that the pre-amended claims were focused on a "method of treatment of plants." The appellant contended that under Section 138(4) of the Act, an international PCT application designating India functions as a patent application and the specification and claims from the international application become the complete specification under the Act. under specific sections (7, 54, and 135) of the Act. The Appellant contended that the Respondent overlooked the application's origin as a national phase application based on a PCT filing. The Appellant further argued that the amended claims fall within the scope of the original PCT claims (1 & 2) because of the binding nature of Section 138(4) and therefore, the amendments do not violate Section 59 of the Act, which restricts certain types of amendments.

The Appellant further argued that since there was no formal request filed for amending the claims when filing the national phase application in India, the claims on record at that time should be deemed as the original PCT claims. Therefore, Respondent should have compared the amended claims to the original PCT claims, not the initial filed claims in India.

# Respondent’s Submissions

The Respondent argued that the Appellant's initial filed application in India did not include claims for the "*insecticidal composition"* and instead, was focused on "*a method of treatment of plants."* This indicates that the Appellant intentionally narrowed the scope of the claims during the national phase filing.

The Respondent further argued that the Applicant themselves deleted those specific claims (1 & 2) at the national phase entry in India. Since the Appellant chose to delete claims 1 & 2, they cannot reintroduce them through amendments. Thus, the amended claims, which pertain to an "*insecticidal composition*" go beyond the scope of the originally filed claims in India.

# Issues before the Court

1. The procedure for claim amendments when a PCT application enters national phase in India;
2. Whether a method of agriculture can be patented under Section 3(h) of the Indian Patents Act 1970; and
3. The process for claim amendments under Section 59 of the Patents Act.

# The Relevant Law

*Section 3(h): What are not inventions.—The following are not inventions within the meaning of this Act: "a method of agriculture or horticulture"*

*Section 59 (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.”*

# Decision of the Court

The Court held that a plain reading of Section 138(4) of the Act 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. Additionally, Section 138(6) permits applicants to incorporate amendments proposed before the International Searching Authority (ISA) or International Preliminary Examination Authority (IPEA) into their national phase application in India, should they elect to do so.

The Court also held that since no voluntary amendment request was filed for the PCT claims at the national phase entry, the Respondent mistakenly referenced the modified claims of the national phase application (that may have been filed mistakenly by the Appellant) instead of the original PCT claims.

The Court further clarified that Rule 20 of the Indian Patent Rules was only amended in 2016 to allow applicants to delete claim(s) at the time of national phase entry. This option for deleting claims does not apply to applications filed before the amendment of the Rules on May 16, 2016. Since the Appellant's application predates the amendment, the pre-existing procedural requirements (that did not allow applicants to delete claims at national phase entry) apply.

The Court further held that when rejecting an application under Section 3(h), a more nuanced and detailed analysis is required to determine whether the invention genuinely constitutes a method of agriculture, or embodies a technical solution to an agricultural challenge(s) that does not fall within the scope of Section 3(h). The Court insisted on re-examination considering the evolving legal landscape and judicial interpretations, particularly considering the significant judgment by the High Court of Calcutta in *Decco Worldwide Post Harvest Holdings B.V. v. The Controller of Patents and Designs* [2]. In *Decco Worldwide,* the Calcutta High Court held that the subject patent application for a fungicidal treatment for black sigatoka in banana plants was improperly rejected under Section 3(h) for being a method of agriculture, emphasizing that treatment of plants to render them disease-free does not fall under this exclusion. Accordingly, the court in the present case concluded that the impugned order was unsustainable and set it aside, remanding the matter back to the Patent Office for de novo consideration.

# Our Analysis

By ruling that claims in an international PCT application should inherently be considered part of the complete specification under Indian law, the court has safeguarded the rights of applicants, ensuring that their claims are not arbitrarily narrowed during the national phase. Additionally, this judgment mandates a detailed and nuanced analysis when rejecting applications under Section 3(h), reminding patent examiners to provide well-reasoned and substantiated decisions,

This ruling serves as a wake-up call for patent applicants to meticulously draft claims, as only deletions and not amendments are permitted at national phase entry of a PCT application into India. Applicants may, however, formally request any amendments after entry to avoid procedural rejections. On the contrary, it must be noted that a Paris Convention application may be amended at the time of entry into India.

The decision also brings into focus broader policy considerations by distinguishing between non-patentable methods of agriculture and innovative technical solutions, paving the way for a more supportive environment for agricultural innovations. This aligns with global trends toward recognizing and protecting technological advancements that address agricultural challenges. Further, it establishes that methods of plant treatment are distinct from traditional agricultural methods and may not be restricted by Section 3(h) of the Patents Act. Drawing from *Decco Worldwide*, the court has reinforced the necessity of a comprehensive and well-reasoned approach to patent application rejections.

Further, it must be noted that for applications filed after the 2016 amendment of Rule 20 of the Indian Patent Rules, the landscape is different. The amendment allows applicants to delete claims at the time of national phase entry. This ruling clarifies that for applications filed before this amendment, the pre-existing procedural requirements apply, which did not permit claim deletions at national phase entry. However, post-2016 applications can benefit from the flexibility to delete claims, which aligns more closely with the procedural expectations set forth by this judgment.

# Conclusion

In conclusion, the Delhi High Court's judgment in *Mitsui Chemicals Inc. vs Controller of Patents* not only clarifies procedural and substantive aspects of patent law in India but also sets a robust framework for future patent applications. This ruling will influence how patent applications, especially those involving agricultural innovations, are handled in India, ensuring a fair and transparent process for all applicants.

# References

[1] C.A. (Comm. IPD-PAT) 196/2022

[2] In AID No. 11 of 2021