

2024 SCC OnLine Del 3733

In the High Court of Delhi at New Delhi
 (BEFORE ANISH DAYAL, J.)

Honeywell International Inc ... Appellant;

Versus

Controller of Patents ... Respondent.

C.A.(COMM. IPD-PAT) 396/2022

Decided on May 21, 2024, [Reserved on : 14th May, 2024]

Advocates who appeared in this case :

Mr. Ankush Verma, Mr. Tanveer Malhotra, Mr. Debashish Banerjee, Ms. Vaishali Joshi, Mr. Vineet Rohilla, Mr. Pankaj Soni, & Mr. Rohit Rangi, Advs.

Mr. Arnav Kumar, CGSC with Mr. Chetanya Khurana, Adv.

The Judgment of the Court was delivered by

ANISH DAYAL, J.:— This appeal has been filed under Section 117A of the Patents Act, 1970 [*the Act*] assailing order dated 28th April 2017 of the Assistant Controller of Patents and Designs. The appeal was originally filed before the Intellectual Property Appellate Board [*IPAB*] and was transferred to this Court post the abolition of the IPAB in 2021, and thereafter was re-numbered as this appeal.

Background facts

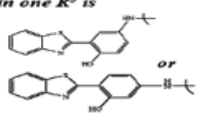
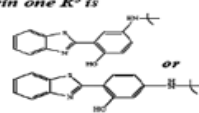
2. The appellant filed a patent application seeking protection for "*Organic Fluorescent Compositions*" on 05th May 2010 which was allotted Application No. 3150/DELNP/2010 [*subject application*].

3. Request for examination was filed by appellant on 3rd November 2011; First Examination Report [*FER*] was issued by respondent on 16th July 2015 wherein a total of 10 objections were taken *inter alia* being lack of inventive step under Section 2(1)(j), and non-patentability under Sections 3(d) and 3(e) of the Act. A response was filed to the FER on 20th November 2015, along with an amended set of claims. The appellant deleted/withdrew claim nos. 4 to 7 and amended claims 1 and 8 to 9. Hearing notice was issued on 01st December 2016, where objections were taken to the amended claims including under Section 3(e) of the Act [*inter alia that the claims define a mere admixture*]. The hearing took place on 20th December 2016. On 26th December 2016, post the hearing, appellant filed written submissions along with a fresh set of amended claims. By the said amendment,

appellant sought to amend the scope of the original claims for 'composition comprising a compound' to just 'the compound', deleting the aspect of composition.

4. The impugned order, considering the amendment, stated that the claims were beyond the scope of originally filed claims and the "claim for composition" was amended to just 'claim for the compound'. Objection in the hearing notice was based on composition claims rather than compound claims and Form-13 filed for amendment in the claims did not fall within the scope of claims 1-3 before the amendment, since the subject matter of the original claims prior to amendment related to composition. It was stated that a 'composition of compound cannot be considered to be same as the compound itself'. The same reasoning was reiterated for addressing the appellant's response to objection under Section 3(e) [that the claim does not include admixture of different compounds but a single claimed compound].

5. For ease of reference, the claims which were on record prior to the amendment and final amended claim set are tabulated as under:

Claim No.	Claim set on record prior to amendments	Amended claim set
1	A composition comprising an organic fluorophore having a structure according to Formula I	An organic fluorophore compound having a structure according to Formula I
2	The composition as claimed in claim 1 wherein said organic fluorophore is a fluorescent pigment and R ² is independently chlorine, substituted or unsubstituted piperidyl, substituted or unsubstituted pyrrolidyl, substituted or unsubstituted piperazin-1-yl, substituted or unsubstituted morpholin-4-yl, provided that no more than one R ³ is chlorine.	The compound as claimed in claim 1 wherein said organic fluorophore is a fluorescent pigment and R ² is independently chlorine, substituted or unsubstituted piperidyl, substituted or unsubstituted pyrrolidyl, substituted or unsubstituted piperazin-1-yl, substituted or unsubstituted morpholin-4-yl, provided that no more than one R ³ is chlorine.
3	The composition as claimed in claim 1 wherein one R ³ is 	The compound as claimed in claim 1 wherein one R ³ is 
4	An article of manufacture comprising a substrate selected from synthetic polymeric fibers, cellulose, and cellulose derivatives covalently bonded to an organic fluorophore having a structure according to Formula VI	The compound as claimed in claim 1 as and when used for making an article or a fluorescent fibre
5	A method for producing a fluorescent fiber	N/A
6	A method for marking an article comprising contacting at least a portion of said article with a composition according as claimed in claim 1 wherein said contacting produces a detectable residue on said portion of said article	N/A

Submissions on behalf of Appellant

6. Counsel for the appellant submitted that even though the impugned order does not cite Section 59 of the Act, it is evident that reasons for refusal are as per the said provision. Rather than refusing the subject application outrightly, the respondent ought to have first raised an objection vis-à-vis Section 59 in a subsequent hearing notice and afforded the appellant an opportunity to address the said objection.

7. Therefore, the objection of Form 13 was erroneous since the respondent ought to have held a hearing under Rule 129 of the Patent Rules, 2003 before rejecting Form 13. It was submitted that Form 13 was separate from the main matter and, thus, an opportunity of being heard before rejecting the same had to be given.

8. The impugned order, therefore, contravened the principles of natural justice and was arbitrary in nature. Besides, there was no reasoning in the impugned order and merely a single statement in the last line on page 2 stating that "*A composition of a compound cannot be considered to be same as the compound itself.*" forms the basis of the rejection.

9. No further reasoning has been proffered. This observation itself, as per the appellant's counsel, is not valid considering that the scope of the claim set on record prior to amendments and the amended claim set submitted later in December 2016 was essentially the same.

10. The original specification prior to the amendment clearly described both the composition as well as the compound. Page 5 of the specification highlighted that the compound forms an aspect of the invention and that the basis of the invention was the triazine compounds which form the basis of the product claim.

11. The complete specifications, in particular paras [0008], [0009], [0013], and [0014], were replete with references to triazine "*compounds*" with a single or double substituent moiety. Thus, the respondent's conclusion that the amendments fell outside the scope of the originally filed claims was misguided.

12. It is settled law, as per appellant's counsel, that claims and complete specifications have to be put together as a whole and cannot be dichotomized.

Submissions on behalf of the Respondent

13. The respondent's counsel, however, refuted the same and stated that the specifications in para [0001] indicated a composition as also in subsequent paras of the specifications and, therefore, the amendment to a compound could not have been allowed and the impugned order was correct in its approach and conclusion.

Analysis

14. It is evident from the tabulation provided above that the appellant had originally claimed a composition comprising of an organic compound, as part of product patent. The claims were *Markush* claims, claiming composition comprising organic fluorophore having a structure according to formula I. The subsequent claims, as originally filed, further detailed the various components of that structure. As per claim 4, the application was the manufacture of the article selected from synthetic polymeric fibers, cellulose, and cellulose derivatives bonded

to such an organic fluorophore, while claims 5 and 6 were the methods for producing such a fiber.

15. Essentially, the application was to use the organic fluorescent compounds, which when incorporated in fibers, could be used as a security marker.

16. For this purpose, reference may be made to paras [0001] and [0002] of the originally filed specifications which are extracted as under:

Field of Invention:

[0001] This invention relates to organic fluorescent compositions. More particularly, the invention relates to organic fluorescent compositions having a triazine moiety.

Description of Related Art:

[0002] Certain fluorescent compounds are useful for securely marking articles, such as documents, wherein the mark does not reflect incident visible light (i.e., is invisible under normal light), but emits a visible mark when subjected to ultraviolet (UV) light. U.S. Pat. No. 4,504,084, for example, discloses a method for marking originals with a fluorescent compound so that copies can be distinguished from their originals. Other methods of applying fluorescent markers to fibers include those of U.S. Pat. No. 6,217,794, which describes a method for marking fibers and fibrous material with near-infrared compositions using cross-linking agents.

17. In the hearing notice, an objection was taken under Section 3(e) of the Act stating that subject matter of claims 1 to 3 defined a mere *admixture* resulting only in aggregation of the properties of the components and it was not clear whether there was any synergistic effect.

18. The hearing was attended on 20th December 2016 and a response was filed on 26th December 2016, where an explanation had been given submitting that the amended claims did not fall under Section 3(e) of the Act. The appellant clearly stated that the organic fluorophore is fluorescent and absorbs light in the ultraviolet region and re-emits that light in the visible region as per para 10 of the specifications. The cited references merely described compounds which would absorb light, but not re-emit that at a different frequency so as to fluoresce.

19. Further, claim 1 describes a single compound by several different moieties of that single compound, described with requisite formulae, and does not include an *admixture* of different compounds. Instead, it is a single compound with various moieties chemically

bound together.

20. As regards technical effect, it was stated that the novel structure of the organic fluorophore compound itself provides the unexpected and surprising technical effect and therefore, the claimed compound was novel and inventive.

21. It is quite clear from the comparison of originally filed claims and the amendment thereto that the original claim of a composition comprising the compound had been simply pared down [*narrowed down*] to the claim in the compound itself.

22. A different compound had not been claimed. The various formulae in claim 1, post the amendment, were merely detailed elements of the compound. The deletion of the word "*composition*" by appellant was merely to provide clarity to the claim and that it does not fall within the vice of Section 3(e) of the Act. For the Assistant Controller to state in the impugned order that "*a composition of a compound cannot be considered to be the same as the compound itself*", is counter intuitive and unsustainable in these facts and circumstances.

23. It could have been a situation where the composition involved many other elements beyond one single compound, or involved a different set of compounds, and the patent applicant amends it to one single compound, which is neither part of the composition earlier, nor forms the basis of the originally filed claims.

24. Both these situations are not present in this case. The originally filed claims were based on a single compound, which was, "*an organic fluorophore having a structure according to formula I*". Various elements of formula I were subsequently expanded in formula II, formula X, formula XI, and formula III.

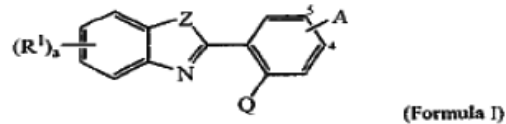
25. This is evident from the original claims, pre-amendment, which are extracted as under for ease of reference:

CLAIMS

What is claimed is:

1. A composition comprising an organic fluorophore having a structure according to

Formula I:



wherein:

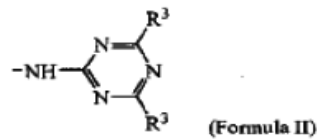
R^1 is independently a $C_1 - C_3$ branched or straight chain alkyl;

a is 0, 1, 2, 3, or 4;

Z is O or S;

Q is an acidic hydrogen moiety selected from OH, NHR^2 , wherein R^2 is a $C_1 - C_3$ branched or straight chain alkyl; and

A is an amino-triazine moiety bonded to the 4th or 5th carbon of the phenol or aniline ring, said amino-triazine moiety having a structure according to Formula II:

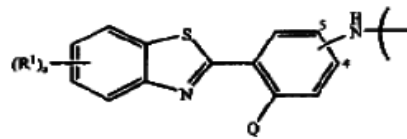


wherein R^3 is independently

a halogen,

a benzothiazole having a structure according to Formula X:

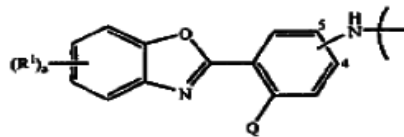
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(Formula X)

wherein Q, R¹, and a are defined as above,

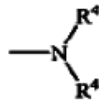
a benzooxazole having a structure according to Formula XI:



(Formula XI)

wherein Q, R¹, and a are defined as above,

or a tertiary amine having a structure according to Formula III:



(Formula III)

wherein R⁴ is independently a C₁ – C₂₀ linear or branched,

substituted or unsubstituted alkyl, alkoxy, hydroxyalkyl, or

carboxylic acid, or a member of substituted or unsubstituted C₁ – C₂₀

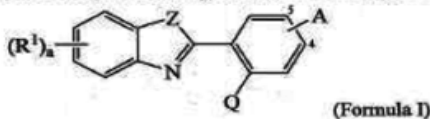
heterocyclic alkyl having the N atom positioned between the two R⁴

groups, and optionally having additional N, O, or S heteroatoms;

provided that no more than one R³ is a halogen and that no more than one R³ is said benzothiazole or said benzooxazole.

We claim:

1. An organic fluorophore compound having a structure according to Formula I:



wherein:

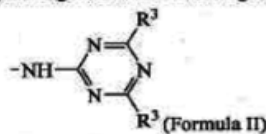
R¹ is independently a C₁ – C₈ branched or straight chain alkyl;

a is 0, 1, 2, 3, or 4;

Z is S;

Q is an acidic hydrogen moiety selected from OH, NH₂, NHR², wherein R² is a C₁ – C₈ branched or straight chain alkyl; and

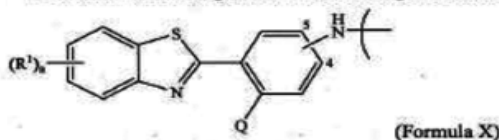
A is an amino-triazine moiety bonded to the 4th or 5th carbon of the phenol or aniline ring, said amino-triazine moiety having a structure according to Formula II:



wherein R³ is independently (i), (ii), (iii), and (iv);

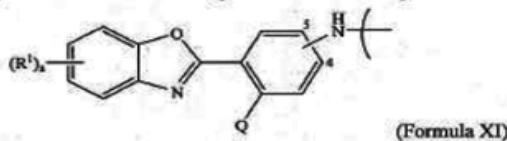
(i) a halogen,

(ii) a benzothiazole having a structure according to Formula X:



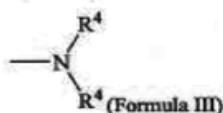
wherein Q, R¹, and a are defined as above,

(iii) a benzooxazole having a structure according to Formula XI:



wherein Q, R¹, and a are defined as above,

or (iv) a tertiary amine having a structure according to Formula III:



wherein R⁴ is independently a C₁ – C₂₀ linear or branched, substituted or unsubstituted alkyl, alkoxy, hydroxyalkyl, or carboxylic acid, or a member of substituted or unsubstituted C₁ – C₂₀ heterocyclic alkyl having the N atom positioned between the two R⁴ groups, and optionally having additional N, O, or S heteroatoms; provided that no more than one R³ is a halogen and that no more than one R³ is said benzothiazole or said benzooxazole.

27. The comparison of claim 1 before and after amendment would show that formula I was the same and therefore, the compound itself, and there was no different compound that had been claimed. Just the word "composition" had been deleted.

28. The other important comparison is between the original claim 4 and the amended claim 4. While the original claim 4 was phrased to claim an article of manufacture comprising a substrate covalently

bonded to an organic fluorophore [*the compound*], the amended claim 4 claimed the compound itself when used for making an article or a fluorescent fiber.

29. Reference was rightly made to para [0020] of the specifications which is reproduced as under:

[0020] In some embodiments, the composition is a pigment and consists essentially of the fluorophore (i.e., the composition does not contain solvents, carriers, or other compounds that would materially affect the composition's luminosity or physical appearance). In certain other embodiments, the composition is a pigment and comprises the fluorophore and further comprises one or more solid additives such as a stabilizing agent, particulate matter, and processing aid including solid lubricants (e.g., magnesium stearate).

30. It is clearly stated here in the specifications that the composition was a pigment and consisted essentially of the fluorophore composition and some solid additives such as a stabilizing agent particulate matter and processing aids. The inventiveness claimed was in the unexpected result obtained with the said compound, the organic fluorophore, which could be used for an industrial application.

31. It is indeed settled law that while interpreting "scope of a claim" as mentioned in Section 59(1) of the Act, claims have to be read along with the complete specifications, together and as a whole. For this purpose, reference may be made to *Allergan Inc. v. The Controller of Patents*, 2023 : DHC : 515, relevant portions of which are extracted as under:

"42. The exact ambit of the scope of a claim in a patent has been the subject of judicial decisions, to which I have already adverted. As I have already noted, the claims and complete specifications in a patent have to be read together and as a whole. The claims have to be understood in the light of the complete specifications. They form an integrated whole, and cannot be treated as two distinct parts of one document. The claim by itself, and de hors the complete specifications which accompany it, cannot convey, to the Court, the exact scope of the claim.

43. The very use of the expression "scope of a claim" in the concluding part of Section 59(1) would, therefore, in my considered opinion and keeping in mind the avowed purpose of the Patents Act, require taking into consideration the complete specifications of the pre-amended claim, and not merely a textually cabined reading of the pre-amended claims themselves, de hors the complete specifications.

44. While, therefore, examining whether the amended claim falls wholly within the scope of the specification in the pre-amended

claim, therefore, the Court, in my opinion, cannot eschew, from consideration, the complete specifications in the pre-amended claim."

(emphasis added)

32. It is also pertinent to note that in *Allergan* (supra), this Court relied upon the landmark decision of the Supreme Court in *Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries*, (1979) 2 SCC 511, wherein the following observations were made:

"43. As pointed out in Arnold v. Bradbury [[L.R.] 6 Ch. App. 706] 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 patent. In Parkinson v. Simon [(1894) 11 RPC 483] 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 added)

33. As regards the amendment itself, there was no reason that it ought to have been rejected under Section 59(1) of the Act. For ease of reference, Section 59(1) is extracted as under:

"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."

(emphasis added)

34. It is quite evident from the very provision that amendments to be disallowed are those where the specifications, as amended, would

claim or describe a matter, not in substance disclosed or shown in the specifications before the amendment, and any claim did not fall within the scope of the original claim(s).

35. Essentially, it provides that the amendment ought to be a subset of the original claim and not beyond the original claim. In this case, it is quite evident that the amended claim was of the compound which was a subset of the original claim, which was of composition containing the compound.

36. In any event, the Courts have very clearly held, as rightly pointed out by appellant's Counsel that the amendments have to be read expansively before acceptance.

37. In *Nippon A&L Inc. v. The Controller of Patents*, 2022 : DHC : 2434 it has been observed that a broader and wider permissibility for amendment of claims prior to the grant has to be given. Relevant paragraphs of this decision are extracted under for reference:

53. The import of these paragraphs of the Ayyangar Committee Report has been considered by the IPAB in Tony Mon George (supra) and it has held that the Report favours wider scope of amendment before acceptance to that after acceptance. The IPAB concluded that if the amended claims define any 'new' features, hitherto not defined in the body of the claims, then they should not be allowed but if they are clarificatory or disclaim earlier claimed features, they can be allowed. The relevant observation of the IPAB is as under:

"36. Keeping in view the settled principles of law, on amendments of the claims, we agree that no new claim may be allowed. But the whole question is whether the claim inserted in "new". Does it define any "new" feature(s) hitherto not defined in the body of the claims?

If the answer is 'yes', then such claims are not allowed to be inserted. We refer to the body of the claims as originally filed, and amended subsequently, in both these sets the claim relating to "A composition comprising an isolated antibody or antigen-binding fragment thereof ..." are present. The dependent claims inserted to qualify the features already covered in the principal claims and having sufficient basis in the description cannot be held to be "new". Therefore, we allow the amended set of claims by the appellant except claim 5. We also allow claim 8 for reasons explained in earlier paragraphs."

54. A perusal of the paragraphs of the Ayyangar Committee Report clearly shows that the purport and intention of this Report was to give broader and wider permissibility for amendment of claims and specification prior to the grant and restrict the same post the grant and advertisement thereof. The Report is also categorical in its observation that the invention before and after amendment

need not be identical in case of amendment before acceptance “so long as the invention is comprehended within the matter disclosed”.

(emphasis added)

38. Similarly, in *Allergan* (supra), in reference to Section 59(1) of the Act, it has been noted that when amended claim did not fall within the scope of the pre-amended claim only in those cases the amendment would be disallowed. Relevant portions of the said decision are extracted as under:

“41. Referring back to Section 59(1), what the Section proscribes is permitting of an amendment of the claim where the amended claim would not fall wholly within the scope of the pre-amended claim. Interestingly, even this last part of Section 59(1) uses two expressions. It states that “no amendment of a complete specification shall be allowed, the effect of which would be ... that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.” What the Section compares, therefore, is the amended claim with the scope of the pre-amended claim. Where the amended claim does not fall within the scope of the pre-amended claim, the amendment would not be allowed.

42. The exact ambit of the scope of a claim in a patent has been the subject of judicial decisions, to which I have already adverted. As I have already noted, the claims and complete specifications in a patent have to be read together and as a whole. The claims have to be understood in the light of the complete specifications. They form an integrated whole, and cannot be treated as two distinct parts of one document. The claim by itself, and de hors the complete specifications which accompany it, cannot convey, to the Court, the exact scope of the claim”

(emphasis added)

39. It had been articulated in a prior decision of this Court in *The Regents of the University of California Address for Service In India Lexorbis v. Controller General of Patents, Designs & Trademarks*, 2024 : DHC : 882, where reference was made to Section 59(1) of the Act, reproduced as under:

“10. It is, therefore, evident that amendments to the original application can be made only by way of the following:

- (i) Disclaimer; or*
- (ii) Correction; or*
- (iii) Explanation.*

Additionally, the proposed amendments are tested against the following parameters:

- (iv) Amendment should serve the purpose of incorporation of*

actual facts;

- (v) Effect of the amendment should not allow matter not in substance, disclosed originally or shown in the specification;
- (vi) Amended claim of the specification should fall within the scope of the original claim of the specification.

11. What needs to be, therefore, assessed is whether the Controller was correct in its assessment of the amended claims on these six benchmarks and parameters. For this purpose, the Court must systematically assess the amendments, in particular, amendments to Claim No. 1, whether they fall within the rubric of Section 59(1) of the Act or not.”

40. Thus, in the opinion of this Court, amendments are only a paring down/narrowing down/chiseling down of the original claims, and do not disclose any matter which was not disclosed in the original claims or specifications. Therefore, the impugned order will not be sustainable, in that, it seeks to disallow the amendments presented by appellant post the hearing.

41. The impugned order is, therefore, set aside, the appeal is allowed, and the subject application of the appellant is remanded back for fresh consideration of the claims as amended, to be assessed on their own merits.

42. Subject application of the appellant shall now be examined afresh/*de novo* along with the amendment, on its own merits. It is directed that the application should be examined within three months from the date of the receipt of the order. A hearing is to be provided to the appellant within the said period.

43. Registry is directed to supply a copy of the order to the Office of the Controller General of Patents, Designs and Trademarks of India on the email llc-ipo@gov.in for compliance.

44. Judgment be uploaded on the website of this Court.