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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% *Date of decision: 28th February, 2025*

+ C.A.(COMM.IPD-PAT) 6/2023 & I.A. 10451/2024

CELLECTISAppellant

Through: Ms. Vindhya S. Mani and
Ms. Harshita Agarwal, Advocates.

versus

THE ASSISTANT CONTROLLER
OF PATENTS AND DESIGNSRespondent

Through: Mr. Nitinjya Chaudhry, Senior Panel
Counsel with Mr. Rahul Mourya,
Advocate.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

I.A. 10451/2024 (u/S 59 of the Patents Act, 1970)

1. This application has been filed on behalf of the appellant under Section 59 of the Patents Act, 1970 (Patents Act) for filing amended complete specification in respect of patent application no.10437/DELNP/2015.

BRIEF FACTS

2. Brief facts necessary for deciding the present application are set out below:

I. Appellant filed Indian patent application no. 10437/ DELNP/



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2015 titled “*Method for Engineering Allogenic and Highly Active T-Cell for Immunotherapy*” on 12th November, 2015 with original 1-28 claims as the national phase application of the PCT application no.PCT/IB2014/061409 in India.

II. The application was published in the Patent Journal on 12th February, 2016.

III. The appellant filed a request for examination on 17th April, 2017.

IV. The First Examination Report (FER) was issued by the Patent Office, New Delhi on 13th December, 2019, raising objections of lack of inventive step under section 2(1)(ja) and non-patentability under Sections 3(d) and 3(h) of the Patents Act.

V. The appellant filed a response to FER along with amended claims 1-18 before the Patent Office, New Delhi on 11th September, 2020.

VI. A hearing notice was issued by the Patent Office, New Delhi, on 19th May, 2021 and the first hearing took place on 23rd July, 2021.

VII. Pursuant to the aforesaid hearing, the appellant filed written submissions along with amended claims 1-13 on 6th September, 2021. Thereafter, pursuant to telephonic discussions with the respondent, the appellant filed amendments to claim 1 on 21st January, 2022 and deleted claims 3 & 12, thereby filing amended claims 1-11 on 25th February, 2022.

VIII. The impugned order was passed by the respondent on 23rd November, 2022 rejecting the appellant’s patent application stating that the claims in the said application are drawn to a method of



diagnosis/treatment of human and therefore the subject matter of the claimed invention is not patentable as it falls under the purview of Section 3(i) of the Patents Act.

3. Aggrieved by the aforesaid decision, the appellant filed the present appeal under Section 117A of the Patents Act on 21st February, 2023.

PROCEEDINGS IN THE PRESENT APPEAL

4. Notice was issued by this Court in this appeal *vide* order dated 27th February, 2023.

5. To be noted, the order passed by the Joint Registrar on 29th January, 2024, records that counsel for the respondent does not wish to file any reply.

6. On 9th April, 2024, the following order was passed by the Predecessor Bench:-

“1. During the course of the hearing, certain aspects of the detailed description of the invention as mentioned in the patent application, has been discussed. This description, at certain places indicates to the Court that the present invention concerns ‘method of treating or preventing cancer or infections in the patients.’ However, in contrast, the modified claims, as worded, do not give such an indication.

2. In light of the above, on the query of the Court Ms. Vindhya S. Mani, counsel for the Appellant, states that she will have to consult her client as to how these issues can be resolved. She states that, if need be, they would consider applying to the Court for modification.

3. In case, Ms. Mani is instructed by her client to apply for modification, the said application be served on the Controller at least a week in advance before the next date of hearing indicating the proposed amendments.”

7. Pursuant to the aforesaid order, the appellant has applied for



modification of the complete specification, including the description and claims in patent application no.10437/DELNP/2015. The complete amended description and the amended claims have been filed along with the present application.

8. I have heard the counsel for the parties.

9. The Appellant's patent application was refused by the learned Controller, *inter alia*, on the ground that the invention is not patentable in terms of Section 3(i) of the Patents Act.

10. Counsel for the appellant submits that the proposed amendments have been made to overcome the objections raised by the respondent under section 3(i) of the Patents Act.

11. The issue to be considered is whether the aforesaid amendments to the complete specification and the claims can be made at the appellate stage before this Court.

12. In *Societe Des Produits Nestle SA v. Controller of Patents and Designs and Anr.*, 2023 SCC OnLine Del 582, I have held that the High Court, while hearing an appeal against a refusal order passed by the Controller, would have the same powers as given to a Controller under Section 15 of the Act, which includes the powers to require amendment. Therefore, the Court is within its power to direct the appellant to amend the complete specification of the patent application including claims at this stage.

13. The aforesaid observations made in *Nestle SA v. Controller of Patents* (supra) were also relied on by another Coordinate Bench of this Court in *Opentv Inc. v. Controller of Patents*, 2023 SCC OnLine Del 2771 wherein it was noted that irrespective of the amendments to the claims or



complete specification of a patent application being made at the behest of the applicant or the Court, amendments are allowed at the appellate stage before Court. The relevant paragraph of the said judgment is given below:

“54. Thus, amendments having been held to be permissible at the appellate stage, this Court is of the opinion that irrespective of whether the amendment is directed by the Court or is at the instance of Patent Applicant, so long as the requirements as laid down under Section 59 of the Act are fulfilled such that the amended claims are within the scope of original claims, is not breached, the amendment is permissible.” “61. Therefore, though there is no embargo on permitting a Patent Applicant to amend claims even at the appellate stage, the amendment sought in this particular case intends to widen the scope of the original claims as filed. It is due to this reason that the same cannot be allowed.”

14. Section 59 of the Patents Act, which deals with amendment of patent applications, has the following three requirements:

- i. An amendment to a patent application, including the complete specification, can be made only by way of ‘disclaimer’, ‘correction’ or ‘explanation’.
- ii. The amendment cannot be in respect of matters not disclosed in the specification prior to the amendment.
- iii. The claims in the amended complete specification would have to fall wholly within the scope of the claims prior to the said amendment.

15. As mandated under Section 59 of the Patents Act, no new subject matter has been added by way of the proposed amendment in the subject application. The said amendments to the complete specification have been done by way of ‘disclaimer’ wherein references to “*method of treating or*



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preventing cancer or infections in the patients” have been deleted; and the amendments to the proposed claims are made by way of ‘correction’, wherein the phrase “*derived from a healthy donor*” has been incorporated in claims 1 and 2. The scope of the amended specification and amended claims fall wholly within the scope of the specification and claims before the amendment.

16. In light of the aforesaid, in my considered view, the amendment is squarely within the ambit of Section 59 of the Patents Act. Accordingly, the amendment application is allowed and the amended complete specification and amended claims 1-11 filed with the application are taken on record.

17. The application stands disposed of.

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18. Let the amended complete specification along with the amended claims 1-11 be filed before the Patent Office, New Delhi as well.

19. The issue that remains for consideration in the present appeal would be whether, in light of the aforesaid amendments to the complete specification and the claims, the appellant has been able to overcome the objection raised under Section 3(i) of the Patents Act.

20. List the appeal for consideration on 11th August, 2025.

21. Both the parties shall file their respective written submissions with respect to the amended complete specification and amended claims 1-11 within four (4) weeks from today.

AMIT BANSAL, J

FEBRUARY 28, 2025

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