IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Intellectual Property Rights Division)

BEFORE:
The Hon'ble Justice Ravi Krishan Kapur

IPDPTA/7/2024

ANDREAS GUTZEIT
VS
THE CONTROLLER GENERAL OF PATENTS
DESIGNS AND TRADEMARK AND ANR.

For the appellant	: Mr. Adarsh Ramanujan, Advocate Ms. Survi Mahajan, Advocate Mr. Abhishek Sikdar, Advocate Mr. Sahil Dey, Advocate Ms. Sayanika De, Advocate
For the respondents	: Mr. Ajay Gaggar, Advocate Ms. Preeti Jain, Advocate
Judgment on	: 15.05.2025

Ravi Krishan Kapur, J.:

1. This is an appeal directed against an order dated 1st April, 2024 rejecting an application for patent titled "Blood Flow Control System and Method for In-vivo Imaging and Other Application" being application no. 201637000002 filed under section 15 of the Patents Act, 1970.
2. Briefly, an application for patent was filed on 1st January, 2016 carrying an international filing date 14 October, 2014 from application no. PCT/CH2014/000151 claiming priority from Switzerland. Thereafter, the

present application being application no. 1787/2013 was filed on 18 October, 2013.

3. The present invention relates to blood flow control systems, devices and methods, in particular to an imaging system for the human body, such as x-ray and related tomographic imaging systems. Images of the interior of the human body have been a long-established tool for providing graphic information in the form of pictures, prints and screen displays for a subsequent interpretation by skilled practitioners. Significantly, the detection of blood flow related conditions is an important part of such images. In order to improve the detection of blood flow conditions it is known that injection of a contrast medium into the blood stream can add information. Moreover, to increase the image quality of the images generated by the CT scanner, it is known that administration of a contrast agent during the scanning process enhances the vascular compartment and other fluids in the body, usually via venous access over the upper extremity such as via the back of the hand or via an elbow vein.

4. A different aspect of the invention is to provide a method of controlling and standardizing the distribution of a substance in the human body comprising the steps of applying a respiratory resistance device to the respiratory system of the body, and injecting the substance into the body and controlling or standardizing the distribution of the substance in the body through the selection of respiratory states characterized by a controlled interaction between the respiratory system of the body and the respiratory resistance device. The invention also provides a method of

acquiring in-vivo a series of images of interior parts of the human body, using an imaging system and including the steps of positioning a body relatively to the imaging system, applying a respiratory resistance device to the respiratory system of the body, and performing the image acquisition step during an inhalation, inspiration or suction phase, during which the body exercises suction against a resistance as provided by the respiratory resistance device.

5. In brief, the appellant claimed the method of operation, the system which applies the method and the use of the system through independent claims nos. 1, 18 and 26 respectively. It is also contended that the subject patent had been granted in five different jurisdictions, namely, EU, China, Brazil, USA and Russia after fulfilling the criteria of novelty, inventive steps etc.

6. The claim was amended and reply to the FER was duly filed. By the impugned order, the application for patent has been rejected solely on the ground of non-compliance with section 59 of the Act.

7. It is contended on behalf of the appellant that in view of the amended FER, the subject application was liable to be re-examined afresh and there had been no compliance with such mandatory requirement. It is also contended that though the impugned order concludes “significant changes” and “new features”, there has been no discussion of the same in the impugned order. In passing the impugned order, the Controller failed to assess whether the amended claims fell within the scope of the unamended claim or not. There is also an apparent inconsistency in the impugned order inasmuch as the Controller though acknowledging that

the contrast dye system was mentioned in the original claim failed to deal with the same in the impugned order. In any event, the original claims 18 and 27 both of which expressly stated that the system was "for use in a method according to any of the preceding claims".

8. On behalf of the respondent Assistant Controller, it is contended that the impugned order is not liable to be interfered with. The appellant by way of amendment was seeking to change the original claim i.e. method claim to a system claim. Such change is expressly prohibited under section 59 of the Act. The claim as originally presented in complete specification related only to a method claim and the amendment to a system claim would radically alter the entire scope of the invention. As such, the proposed amendments were not in conformity with the Act. In the above circumstances, the conversion of a method claim into a system claim was impermissible and broadened the original scope of the claim. Hence, the impugned order does not warrant any interference at all.

9. Section 59 of the Act is as follows:

> *"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.*

(2) Where after the date of grant of patent any amendment of the specification or any other documents related thereto is allowed by the Controller or by the Appellate Board or the High Court, as the case may be,—

(a) the amendment shall for all purposes be deemed to form part of the specification along with other documents related thereto;

(b) the fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and

(c) the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.

10. On a perusal of the original claims filed by the appellant, it appears that the claim was directed towards the steps involved in image requisition and the claim was a method claim which is summarized below:

"1. A system for acquiring in-vivo an image of interior parts of a human body (20) or an image based quantification of blood flow conditions therein, comprising:

- an imaging system (21) and

- a respiratory resistance device (10) to be applied to the respiratory system of the body (20), wherein

- in the human body (20) a substance selected from a contrast fluid, dye or drug is flowing in the blood circulation,

- the human body (20) is positioned relatively to the imaging system (21),

- the respiratory resistance device (10) is applied to the respiratory system of the human body (20), and

- an image acquisition step is performed during an inhalation phase, during which the human body (20) provides suction against a resistance as provided by the respiratory resistance device (10), and/or during an exhalation phase, during which the human body (20) provides exhalation against a resistance as provided by the respiratory resistance device (10), whereby the distribution of the substance in the blood circulation is controlled through the selection of respiratory state by a
controlled interaction between the respiratory system of the human body (20) and. the respiratory resistance device (10) and thereby increasing the

quality of the image obtained by the imaging system (21) in the image acquisition step."

11. The proposed amendment read with the description of the invention is as follows:

"25. An image acquisition system for in-vivo acquisition of images of the interior of the human body (20), comprising:

- an image acquisition apparatus (21), in particular a CT scanner, MRI scanner, Ultrasound machine, Angiography, or a PET/CT or, PET/MRI apparatus,

- an injection system for administering a contrast fluid, dye or drug into a pre-established venous access of the body of a patient, and

- a respiratory resistance device (10),

wherein the respiratory resistance device (10) is comprising a main body (11) with one or more openings (121, 122) which are connected in use with the respiratory system of the human body (20), and a closed inner volume or a inner volume with one or more constrictions (111) blocking partially the flow of air into or out of the respiratory system of the body (20) during an inhalation phase or exhalation phase, respectively,
and the respiratory resistance device (10) is comprising a control signal generator (14) for generating a control signal indicative of a deviation from a desired respiratory state or from a preset pressure value or range of pressure values of the pressure inside the main body (11).

31. A system of acquiring in-vivo an image of interior parts of the human body or an image based quantification of blood flow conditions, using an imaging system, the system comprising:

- an imaging system,

- a respiratory resistance device to be applied to the respiratory system of the body, and

- an administering system for administering a contrast fluid or a dye into a venous access of the human body,

wherein a contrast fluid or a dye, which is administered into a venous access of the human body before and/or during the inhalation phase or before and/or during the exhalation phase by the administering system, is flowing in the blood circulation of the human body, while an image of interior parts of the human body or an image based quantification of blood flow conditions is acquired at least during an inhalation phase, during which the body provides suction against a respiratory resistance provided by the respiratory resistance device, and/or during an exhalation phase, during which the body provides exhalation against a respiratory resistance provided by the respiratory resistance device,

whereby the distribution of the contrast fluid or a dye in the blood circulation is controlled through the selection of specific respiratory states by a controlled interaction between the respiratory system of the human body and the respiratory resistance device, thereby increasing the quality of the image obtained by the imaging system."

12. In *Nippon A & L Inc. vs. Controller of Patents (2022) SCC OnLine Del 1909*, it has been held as follows:

"39. Section 59 has two aspects. Sub-section (1) deals with amendment of a pending application, its specification, claims or any document related thereto. Sub-section (2) deals with amendment after the grant of the patent. In the present case, the Court is concerned with a pending patent application so the amendment has to be tested on the conditions specified in section 59(1) of the Act.

40. A perusal of section 59(1) shows that an amendment of an application, specification or any document related thereto would be permissible only if the following conditions are satisfied:

(1) the amendment has to be by way of disclaimer, correction or explanation;

and

(ii) the amendment has to be for the purpose of incorporation of actual facts;

and

(iii)(a) the effect of the amendment ought not be to amend the specification to claim or describe any matter which was not disclosed in substance or shown in the originally filed specification;

and

(iii)(b) the amended claims have to fall within the scope of claims as originally filed.

41. Thus, for an amendment to be allowed all conditions have to be satisfied. Any amendment falling foul of (i), (ii), (iii) (a) or (iii) (b) above cannot be allowed.

42. Section 59(1) of the Act as it exists presently in the statute came into effect vide Patent (Amendment) Act, 2002 with effect from 20-5-2003. Prior to the said amendment, Section 59(1) read as under:

"(1) No amendment of an application for a patent or a complete specification shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed except for the purpose of correcting an obvious mistake, 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 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."

43. A perusal of the provision as it existed prior to the amendment and as it exists today shows that the phrase "except for the purpose of correcting an obvious mistake" has been substituted to read "except for the purpose of incorporation of actual fact". A reading of the unamended provision and the provision post the amendment shows that the power to amend has not been abridged or curtailed or narrowed but has been expanded."

13. In *Open TV Inc. vs. The Controller of Patents and Designs and Ors.* [Unreported decision dated 11 May 2023 passed by the High Court of Delhi in C.A.(COMM. IPD-PAT) 14/2021], it has been held as follows:

"50. The fundamental principle governing amendment of claims is therefore, that amendments are permissible in the claims so long as the said amendments are within the scope of the originally filed Claims as filed and do not expand the said claims. Thus, reduction or narrowing down a claim is permissible, but broadening, widening or expansion of claims is not permissible."

14. In *AGC Flat Glass Europe SA vs. Anand Mahajan and Ors. 2009 SCC OnLine Del 2826*, it has been held as follows:

13. In support of the plaintiff's contention as regards the scope of the amended claim, the plaintiff has cited Baker Perkins Ltd.'s Application (1958) RPC 267 decided by Mr. Justice Lloyd-Jacob. While deciding whether or not the amendment of the patent ought to be allowed, it was observed as follows (at page 273):
"As regards the first point, Mr. Lochner referred to a number of reported cases in which an amendment which imported into a claim a limiting feature from the description was refused on the ground that the amended claim would claim a new combination — an invention different from that originally claimed. These cases were decided under the Acts prior to the 1949 Act, when one provision was that an amended claim must not claim an invention substantially larger than or different from that of the original claim, a provision not to be found in Section 31 of the 1949 Act…
The section is clear that an amended claim may not be larger than the original claim — it must fall wholly within its scope — but so long as it does this, there is no requirement that it shall not be different…

A very common form of amendment when a claim for a piece of mechanism proves to have been drawn too widely is the addition to the claim of some additional feature of construction so that the scope of the original combination is cut down to that of a sub-combination. For example, amendments which allow an appendant claim to be combined with the main claim are constantly allowed provided that the sub-combination is, in truth, a narrowing down of the original combination and not the formulation of an entirely different one…

If limitation to a sub-combination, properly falling within the scope of the original wider combination, discards or eliminates from the invention claimed everything except this sub-combination, I think such amendment must come within the meaning of disclaimer…"

25. The law which emanates from the authorities cited is quite akin to the law of amendment. The jurisdiction necessary to allow the amendment of a claim in the specification vests with the High Court, once the validity of the patent has been challenged in a patent infringement suit. The claims can be amended and such amendment may be allowed provided that is it clarificatory or elaborative in nature and also, that it does not alter the scope of the claim or introduce any new claim in the invention which was not present in the original invention. Thus, the scope of enquiry in relation to amendments in the patent claim is limited to the extent as to whether it introduces any new claim which extends the scope of the monopoly rights of the patentee.

26. Of course, the law operates differently when it comes to narrowing down or crystallizing the claims and apportioning those claims/ subjects which are irrelevant and ultimately making it narrow and limiting the scope of the invention. An amendment under these circumstances is allowed and the excluded portion is disclaimed and the amendment becomes what is called a 'disclaimer'. The disclaimer doctrine thus means that a right holder is delimiting the scope of the invention by narrowing down the claims to its inconvenience in a way which makes the amended claims not inconsistent with the earlier claims in the original specification. This recourse of disclaimer is adopted by the right holders in order to clarify the exact scope of the invention, once they are faced with the invalidity of their patents.

15. In *Tony Mon George vs. The Controller General of Patents* passed by the IPAB in OA/48/2020/DEL dated October 27, 2020, it has been held as follows:

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 is "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".

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16. In this context, the Ayyangar Committee Report reads as follows:

553. Having considered the matter carefully, have reached the conclusion that there is no need to change the scope of the existing provision as regards the power of amendment and that where the invention which emerges as a result of an amendment is different from that which was the subject-matter of the specification as originally accepted, such an amendment should not be permitted. 1 might add that Section 50 of the Canadian Patents Act restricts reissue of patents to 'the same invention as that for which the original patent was issued, and though that Act has been amended from time to time, even as late as 1953-1954, no change has been made in the wording of this provision.

594. As I have already pointed out, Clause 34(6) applies to cases of applications for amendments both before and after acceptance, and adopts the same rule, as regards the nature and scope of permissible amendments I consider that the scope of an amendment before acceptance ought to be wider than that after acceptance because at the former stage the specification is not disclosed to the public. It is then wholly a matter between the applicant for the patent and the office, and such amendments as are necessary to afford to the applicant, the benefit of the invention which he has disclosed in his complete specification ought to be available to him. On the other hand, after the acceptance of the application, and its advertisement, the contents of specification become open to public inspection, and the rights of third parties who have started work on the basis of the claims made or not made, by the applicant in the published specification should be taken into account in defining the scope of the amendment which the applicant or the patentee might be permitted to effect. After a complete specification has been accepted two limitations not applicable to amendments at the earlier stage should be imposed. The first is in regard to the formulation of new claims which were not found in the original specification. Where a complete specification has not been advertised, there would be no question of a dedication of the unclaimed portion of the invention to the public and hence there cannot be any objection

> *to a claim being formulated in respect of an invention disclosed in the specification if by error the claim has not been properly made or formulated. But where the specification has been accepted and advertised, the position is entirely different. In that case unless the claim after amendment would fairly fall within the claim before amendment it should not be permitted. In other words, it should be presumed that all claims not made, except by reason of obvious mistake, in the specification before acceptance are abandoned.*

17. As a general rule, patent applications, complete specification or any other document, can be amended only if it is in the form of a disclaimer, correction or explanation. Any addition or amendment beyond the scope of the original claim ought to be supported by a disclaimer. The crucial question being whether any subject matter relevant to the invention has been added whether by deletion or addition. Thus, great care has to be taken when formulating and seeking amendments, in view of the danger that the patent may be invalidated by adding matter or by a widening amendment.

18. In *Bishwanath Prasad Radhey Shyam vs. Hindustan Metal Industries*, *(1979) 2 SCC 511* it was held as follows:

> *43. As pointed out in Arnold v. Bradbury [(1871) 6 Ch A 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.*

19. In passing the impugned order, the Assistant Controller though aware of the fact that the original claim mentioned contrast dye failed to discuss whether the same fell within the scope of the original specification or not.

The impugned order does not decide whether the invention is comprehended within the matter disclosed or not. There can be no straight jacket formula in such cases. Nor can the label or nomenclature be treated as the sole indicator. Whether system to method or product to process, one has to examine the original specification and ascertain the intrinsic worth of the invention *vis-a-vis* the proposed amendment. The question of addition or deletion has to be examined in this background. How any of the features or elements of the proposed amendments broaden the scope of the original claim has not even been adjudicated upon nor elaborated upon in the impugned order. That is a serious infirmity in the impugned order.

20. In *Richardson – Vick Inc's Patent (1995) RPC 568 at 576,* Jacob. J, observed as follows:

> *"I think the test of added matter is whether a skilled man would, upon looking at the amended specification, learn anything about the invention which he could not learn from the unamended specification."*

The reason behind this rule was identified and examined in *Vector Corp vs. Glatt Air Techniques Ltd. (2007) EWCA Civ 805.* A third party must be able to look at an application and be able to draw a conclusion with respect to the subject matter that is available for supporting a claimed monopoly. A subject matter if added subsequently, the patentee could obtain a different monopoly to that which the application originally justified. The impugned order simply fails to deal with this aspect of the matter. The conclusion that the methods claims had changed to a system

claims and hence were beyond the scope of the original claims is unsubstantiated and bereft of any reasoning. There are no reasons in concluding as to how the proposed amendments broadened, expanded or widened the claims. [See:*Societe Des Produits Nestle SA vs. Controller of Patents and Design and Anr. 2023 SCC OnLine Del 582, Regents of the University of California vs. Controller General of Patents, Desings & Trademarks and Anr. 2024 SCC OnLine Del 753, Ovid Therapeutics, INC vs. Assistant Controller of Patents and Designs 2024 SCC OnLine Del 875* and *Techpolymers Industria E Comercio LTDA vs. The Deputy Controller of Patents and Designs 2024 SCC OnLine Mad 189*].

21. In view of the above, the impugned order is unsustainable and is set aside. The matter is remanded to the Controller to be decided afresh in accordance with law within a period of eight weeks from the date of communication of this order and after granting an opportunity of hearing to the appellant. It is made clear that there has been no adjudication on the merits of the claim and all points are left open.

22. To the above extent, IPDPTA 7 of 2024 stands allowed.

(Ravi Krishan Kapur, J.)