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**Brian Hinman, Royal Philips,
gives advice on the matter**



PLUS

**Novelty as criteria for patentability: Trends and positions
in the US, Europe, and India by Swatika Taneja from KP&S&A**



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Rahul Sharma

A disclaimer to disclaim under the Indian patent system

Rahul Sharma, from LexOrbis, clarifies the rules and regulations around disclaimers under Indian Patent Law, looking at current case examples from the High Court.

A amendment to a pending patent application or a granted patent under the Indian Patents Act, 1970 is implanted in accordance with Section 59. One of the permissible ways of entering the amendment, as per the Indian Patents Act, is incorporating 'Disclaimers'. Disclaimers are usually incorporated within the claims or written description of the specification during the prosecution or post-grant stage to either cause removal of doubts with respect to a particular aspect/feature of the claimed subject matter, or 'disclaim'/'give-up' a certain portion of the originally claimed scope.

'Disclaimers' may be aimed at disclaiming such type of subject matter from claims that are non-statutory in nature and yet fall under the purview of the as-filed claimed subject matter. A recent order by the Indian Patent Office highlights the application of such disclaimers by a patent applicant. In an Order dated January 10th, 2017 in respect of Indian Patent Application No. 302/DEL/2004, the Controller upheld the claim amendments as 'disclaimer' and accordingly held them permissible. The Controller *vide* said Order accepted the amendment of the preamble of the claims from "computer program product" to "computer system". Further, the Controller affirmed the scope of "computer system" based claims (amended) as being 'entirely' inline within the scope of the "computer-program product" based claims (originally filed) and held such amended claims as being in compliance with the Section 59 of the Indian Patents Act.

Accordingly, the amendments as allowed *vide* said Order successfully led to disclaiming of "computer readable storage medium" and "a computer readable program code", as otherwise falling within the scope of originally filed

claims (i.e. computer program product). The Order clearly refers as to how a disclaimer may be used by a patent applicant/patentee to enter amendments to overcome non-statutory subject matter based objection. More specifically, the Controller relied on and applied the 'disclaimer doctrine' as propounded by Delhi High Court in AGC Flat Glass Europe SA vs Anand Mahajan (CS (OS) No. 593/2007). The 'disclaimer doctrine' entitles a right holder to delimit 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 judicial precedent also recognized that a patentee stands entitled towards adopting this recourse to clarify the exact scope of the invention, upon having been confronted with the invalidity of its patents.

This Doctrine of Disclaimer is analogous to practice at the United States Patent and Trade Office (USPTO), wherein it is permissible to amend the preamble of the claimed subject matter from "a computer readable medium" to a "non-transitory computer readable media" in order to disclaim "transitory propagating signals". As may be understood, such practice at USPTO is also aimed at disclaiming the 'non-statutory subject matter' from the claims. Also, as per the European Patent Office (EPO), the disclaimer refers to any claimed-feature which is added to the patent specification during patent prosecution or post-grant stage and excludes specific embodiments from a general feature in the patent document.

Another category of disclaimers may be aimed at restoration or clarification of novelty of the claimed subject matter by delimiting a claim against a cited prior art. A Patentee may disclaim certain claims within a patent as part of a settlement agreement during patent litigation. If a claim or claims are considered to be too broad or otherwise invalid, the patent holder may want to disclaim those claims to avoid or close litigation or to remove such claims from a lawsuit.

Such 'other' type of disclaimers pertaining to the novelty of the invention have been considered in AGC Flat Glass Europe SA vs Anand Mahajan, wherein the High Court decided upon a post-grant amendment that

Résumé

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brought a limitation into the claims from the description. The plaintiff (AGC Flat Glass Europe) proposed insertion of a phrase in the principal claim during pendency of patent infringement suit, on the grounds that said phrase was: a) an explanation to clarify the scope of the invention in light of prior art and, b) pertained to a matter already disclosed in the description in the as-filed specifications.

The High Court held in this case that the amendment 'clarified' the scope of one of the method step of the as-filed claims and did not lead to a new invention and that the amendment was only clarification or elaborative in nature, and at best, a disclaimer, and did not alter the scope of the invention. The Court's remarks were that the law operates differently when it comes to narrowing down or crystallizing the claim and apportioning those claims/subjects which are irrelevant. The High Court held that an amendment under these circumstances is 'allowed' and the excluded portion is disclaimed. The overall amendment became what is called a "disclaimer". This clearly concludes that a limitation from the description may be brought into the claims so long as it does not broaden the scope of the invention. The High Court judgement was further referred by Intellectual Property Appellate Board (IPAB), India in *Solvay Fluor GmbH. v. E.I. Du Pont de Nemours and Company* (M.P.No.36/2009 in TRA/7/2007/PT/KOL), wherein an amendment to the description of 'granted' patent was allowed as a 'disclaimer' by IPAB in revocation proceedings filed against the granted patent. The disclaimer as allowed was aimed at clarifying the synergistic effect of components within the invention and depicting a resulting-efficacy in order to overcome the objections made under sections 3(d) & 3(e) of the Indian Patents Act under the revocation proceedings.

Based on aforesaid judicial precedents, the applicant/patentee

may indeed resort to incorporating disclaimers within the patent specification as and when required at various relevant stages of the patent life cycle. However, in order to ensure that amendments are held permissible, disclaimers shall be drafted so as to not dilute the existing technical contribution of the invention, since the disclaimers are authorized to only cause removal of doubts or clarification with respect to said contribution. While usage of new terms and phrases (not used before in the patent specification) may be permissible as a part of 'disclaimer' to illustrate the technical contribution, the essence of the technical contribution as originally captured through the as-filed subject matter shall remain undisturbed.

Likewise, a disclaimer shall never become a yardstick for determining as to by what extent the claim is supported from the as-filed specification. In other words, disclaimers shall be drafted in a manner such that they are not considered as relevant for determining the requirement of 'sufficiency of disclosure'.

As far as the restoration of novelty of the claimed subject matter through disclaimers is concerned, incorporation of the disclaimer in claims shall not remove more than is necessary to restore novelty. In other words, the disclaimer shall be skilfully drafted by the patent applicant/patentee so as to exclude only such subject matter that constitutes the prior art for the invention and not beyond that. Likewise, during the course of drafting such disclaimers that are aimed at excluding the non-statutory subject matter from the claims or projecting the invention as 'patentable', one shall keep in mind 'only' the excluded categories as defined under the corresponding legislation.

Last but not the least, the claims or the written description of the patent as amended through the incorporation of the disclaimers shall remain clear and definite.

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