

# INTELLECTUAL PROPERTY APPELLATE BOARD

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**(CIRCUIT BENCH SITTING AT DELHI)**

**OA/9/2009/PT/DEL**

FRIDAY THIS, THE 22<sup>nd</sup> DAY OF FEBRUARY, 2013

**HON'BLE SMT. JUSTICE PRABHA SRIDEVAN -- CHAIRMAN**  
**HON'BLE MS. S. USHA -- VICE-CHAIRMAN**

BAYER AKTIENGESELLSCHAFT -- Appellants  
D-51368, LEVERKUSEN  
GERMANY

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(By Advocate - Ms. Sanjana Mehtha )

**Vs.**

1. UNION OF INDIA THROUGH THE SECRETARY.  
DEPARTMENT OF INDUSTRY,  
MINISTRY OF INDUSTRY AND COMMERCE -- Respondents  
UDYOG BHAWAN, NEW DELHI.

2. THE CONTROLLER GENERAL OF PATENTS & DESIGNS  
BAUDHIK Sampada Bhavan, CP-2, SECTOR-V  
SALT LAKE CITY, KOLKATA – 700 091.

3. THE DEPUTY CONTROLLER OF PATENTS & DESIGNS  
THE PATENT OFFICE, BAUDHIK Sampada Bhavan  
PLOT No. 32, SECTOR 14, DWARKA  
NEW DELHI – 110 075.

(By Advocate – Shri Debashish Banerjee)

**ORDER (No. 30/2013)**

**HON'BLE SMT. JUSTICE PRABHA SRIDEVAN, CHAIRMAN**

This appeal is filed against the order which held the appellant's application is not a divisional application as per S. 16 of the Patents Act, 1970.

2. In recent times, we have come across several appeals against orders passed under S. 15 refusing to consider the patentee's application as a divisional application. The general grievance expressed by the Bar Members is that similar divisional applications had been accepted earlier and it is unfortunate that the Controller should now take a different stand and refuse to grant such division. All issues raised herein have already been dealt with by us in the case of

(1) LG Electronics INC, Korea Vs. Controller of Patents & Designs, Kolkata and others – IPAB Order No. 111 of 2011 – Where it was held that the words “if he so desires” in S. 16 does not mean that even if there is no plurality of invention, the patentee may seek division.

(2) SYGENTA PARTICIPATIONS AG, Switzerland Vs. Union of India and Others – IPAB Order No. 19 of 2013 – Where it was held that plurality of invention is a *sine qua non*. The Controller has the power to make his orders in two situations. One, when the applicant desires it on his own and two, when the Controller raises an objection and the applicant seeks to remedy it. The word “Patent” means a patent for any invention granted under the Patents Act, 1970 (S. 2(m) of the Act). A patent shall be granted for one invention only (S. 46(2) of the Act). Therefore, if there is a parent application, as in this case, and there is a divisional application, and both the parent application and the divisional application are accepted by the Patent Office and patents are granted, it logically means that one invention is protected by the parent application and one invention is protected by the divisional application. Without straining the simple language of the

Act, without looking for any interpretative aids, it means just this that the applicant claims a patent for one invention under the parent application and for one invention under the division application. It cannot be otherwise.

(3) BAYER ANIMAL HEALTH GMBH, Germany Vs. Union of India and Others – OA/18/2009/PT/DEL (IPAB Order No. 243 of 2012 – Where the same view was taken.

6. *Section 10(5) of The Patents Act, 1970 explains that the claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification. Section 16 entitles the applicant if he desires to remedy the objection that the claims relate to more than one invention file a further application in respect of an invention disclosed in the application already filed. Therefore, the Act does not empower or give the appellant right to resubmit the same application as a divisional application.*

7. *The learned counsel submitted that there have been other cases identical, where similar divisional application has been granted a patent and they also produce those applications. This can hardly advance the case of the appellant. We also do not know the exact facts in all those other applications and whether they have been wrongly or rightly granted. We are only concerned with the matter before us. At no point did the learned counsel submit that the parent application contains more than one invention and the divisional application related to one of the inventions for which the separate application has been made. The fact that in the First Examination Report, there is mention of “plurality of the invention” may be a point in their favour. But still*

*before us they have to show the existence of more than one invention and what each of those inventions related to. The learned counsel did not do that but on the other hand it was submitted again and again that the invention sought to be patented earlier was not patentable under the earlier Act. But now with the change in the Act, this application must be received and examined. Therefore, the learned counsel is not really advancing the case of a divisional application but of a fresh application. If we treat this as a fresh application it would require to be tested as such on the grounds of prior use, prior knowledge etc. But obviously the appellant does not want that.*

3. In the present case, the parent application is numbered as 2849/DEL/98 dated 22<sup>nd</sup> September, 1998. In 2001, the present divisional application was filed as No. 832/DEL/2001. The main application or the parent application was examined by the office on 9<sup>th</sup> April, 2001. The First Examination Report contained the objection that the claim for pesticides and herbicides are not allowed under S. 5(1)(a) of the Patents Act, 1970. There was no response from the appellant and so it was deemed to have been abandoned. The appellants then filed a fresh application which is the present one. Then a request for examination was filed on 14<sup>th</sup> December, 2005. The Examination Report was communicated on 17<sup>th</sup> May, 2007 stating that the parent application was abandoned and the claims of this application are identical to the claims of the parent application and not allowable under S. 16 of the Act. During the hearing, the applicant's Agent relied on the Controller General's instructions issued on 03/05/2005 and 18/07/2006 and also submitted that the issue of plurality of invention would arise only when the Controller raises objection and not when the patentee himself exercises the option to amend the claims. The impugned order found on facts that the set of claims in the parent application and the instant divisional application were exactly the same. The impugned order also noted that the parent application did not

contain any claims relating to plurality of distinctive invention and that no objection in this regard had also raised. As stated earlier, all the grounds raised before the Controller in the impugned order have been addressed by us in our previous orders.

4. The learned counsel submitted that in the present application, in the First Examination Report, there is a reference to distinct claims and therefore the appellant must be permitted to divide the application accordingly. The usual argument before us in divisional application appeals is that there the patentee obtains no advantage by filing a division since the division application will have the same term as the parent application. While this is true, the divisional application also gets the same priority as the parent application. This gives to the applicant a great advantage. The divisional application also cannot be granted by the Controller for the asking since by the proviso of S. 57, the Controller's discretion to amend is taken away in a suit or proceedings pending before the Hon'ble High Court. Once the divisional application has been held to be identical to the parent application, it deserves to be dismissed *in limine* and the applicant cannot seek any indulgence with regard to the application which is im-permissible in Law.

5. In 1995 (1) SCC 745 – Chandigarh Administration & Another Vs. Jagjit Singh & Another – The Hon'ble Supreme Court held that “because in one case a particular order has been passed or a particular action has been taken, the same must be repeated, irrespective of the fact whether such an order or action is contrary to law or otherwise.” The Hon'ble Supreme Court had further held that because the authority has passed an illegal order in the past “does not entitle the Hon'ble High Court to compel the authority to repeat that illegality over again and again.” It is also said that illegal orders cannot constitute the basis for a legitimate complaint of discrimination.” This answers all the grounds of legitimate expectation, promissory estoppel or unfair

discrimination. An order or grant for a divisional application without a plurality of invention is contrary to law. So if there are prior orders, they are contrary to law and cannot be followed.

6. We also noted in this case that in the complete specification, some pages are missing. For example, p.136 to p.140 are missing. Greater care must be taken especially while filing appeal against similar orders. We request the Members of the Bar to file the correct copy of the parent application and a correct copy of the alleged divisional application.

7. In this case, since the divisional application is identical to the parent application, we see no reason to interfere. This OA/9/2009/PT/DEL is dismissed.

**(S. USHA)**  
**VICE-CHAIRMAN**

**(JUSTICE PRABHA SRIDEVAN)**  
**CHAIRMAN**

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