

INTELLECTUAL PROPERTY APPELLATE BOARD

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(CIRCUIT BENCH SITTING AT DELHI)

OA/18/2009/PT/DEL

MONDAY THIS, THE 29th DAY OF OCTOBER, 2012

HON'BLE SMT. JUSTICE PRABHA SRIDEVAN -- CHAIRMAN
HON'BLE SHRI D.P.S. PARMAR -- TECHNICAL MEMBER

BAYER ANIMAL HEALTH GMBH -- Appellants
D-51368, LEVERKUSEN
GERMANY

Address for service in India

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AT THE MILLENNIUM PLAZA, SECTOR 27
GURGAON – 122 002, NCR.

(By Advocates Shri Jitesh Kumar and Ms. Ranjana Mehta Dutt)

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 - None)

ORDER (No. 243 of 2012)

HON'BLE SMT. JUSTICE PRABHA SRIDEVAN, CHAIRMAN

The basis of a divisional application is the existence of a plurality of invention. This is a *sine qua non* for seeking a division of an application. This appeal has been filed against the order passed in the matter of a divisional application No. 1427/DEL/1999 (Patent Application No. 371/DEL/1997). The invention related to "Optionally Substituted 8-Cyano-1-Cyclopropyl-7-[2,8-Diazabicyclo] [4.3.0] Nonan-8-Y1] -6- Fluoro-1,4 Dihydro-4-Oxo-3- Quinolinecarboxylic Acids And Their Derivatives". The Patent application claims "Optionally Substituted 8-Cyano-1-Cyclopropyl-7-[2,8-Diazabicyclo] [4.3.0] Nonan-8-Y1] -6- Fluoro-1,4 Dihydro-4-Oxo-3- Quinolinecarboxylic Acids And Their Derivatives". The patent application was examined and the First Examination Report was made on 2nd July, 1999. The First Examination Report objected that the invention was not patentable under S. 5(1)(b) of the then existing Patents Act, 1970 and it was a pharmaceutical product with a chemical product base. The Patent Agent for the appellant herein did not respond to the objections and the application was deemed to have been abandoned under S. 21(1) of the Act for not complying with the said requirement. It was also noted that it was not filed as a WTO application under S. 5 of the then Patents Act.

2. After the new Act came into force and chemical substances became patentable, the appellants filed a fresh application for the same invention as a divisional application of the earlier main application. This was again examined and

the First Examination Report was issued on 20th September, 2007 including the objection that the present application was not a valid application under S. 16 and it did not comply with the requirements of S. 16. The appellant replied to the objections stating that the Examiner had not given a correct interpretation to the provisions of S. 16. The appellant's agents also did not inform the Patent Office that the earlier application was deemed to have been abandoned under S. 21(1) of the Act. The application was again examined and a further report containing the objections was issued by the Patent Office vide letter dated 08/10/2008. The appellant was informed that the present application cannot be considered as a divisional application and S. 16 requires the parent application to contain more than one invention for filing a divisional application. To this again, the appellant reiterated that their divisional application has been validly filed. It was again examined and it was again found that the divisional application did not pass the test of S. 16. The appellants requested for a hearing and a hearing was held where the same grounds were raised. According to the appellants, they were entitled to file a divisional application even if the parent application did not contain more than one invention. The Deputy Controller of patents and Designs dismissed the application. In the impugned order he observed that the concept of divisional application is basically to protect multiple inventions disclosed in one patent and if in one parent application, the claims did not relate to a single invention, the Law provides the appellant to file a further application as a divisional application on his own or at the instance of the Controller. He also found that the claims in the parent application and the instant divisional application were exactly the same. They did not disclose more than one invention. He also noted that this application has been filed as a divisional application to protect the same invention as the parent application. Though this was not patentable under the Law prior to 2005, it would have been protected if due care has been taken. He also observed that the appellant cannot revive the parent application, which was not patentable at that time of filing of their application. The learned counsel for the appellant reiterated that it was only because the invention was not patentable under the earlier Law that the original application could not be proceeded with and therefore the present application should not be rejected.

3. The paper book contains both the parent application as well as the present application. The complete specification is identical as per the claims. While there are 11 claims in the parent application, the present alleged divisional application contains 6 claims. Claim 1 is identical in both except for the words "Optionally Substituted" in the beginning of the parent application. Claim 2 of the parent application is the process for preparation of the product described in claim 1. This is omitted in the present application. Claim 3 of the parent application and claim 2 of the divisional application are identical. Claim 4 of the parent application and claim 3 of the divisional application are identical. Claim 5 of the parent application is identical with claim 4 of the divisional application except for the words "the compound as claimed in claim 1" which precedes claim 5 of the parent application. Claim 6 of the parent application refers to medicaments comprising compounds of the formula (I) according to claim 1. Claim 7 is use of compounds of the formula (I) according to claim 1 for the preparation of medicaments. Claim 6 and 7 are not found in the present application. Claim 8 of the parent application is the use of compounds of the formula (I) according to claim 1 in antibacterial compositions. Claim 8 is the same as claim 5 of the divisional application minus the words "Use of". Claim 9 of the parent application is the same as claim 1 except the words "substantially as herein described with reference to the foregoing examples". This is missing in divisional application. Claim 9 of the parent application is identical as in claim 6 of the divisional application. Claim 10 is process and preparation of the product described in claim 9. This is missing in the claim. Claim 11 refers to medicaments.

4. The learned counsel for the appellant explained in detail the history and background of the present Act and how India was requested by the Dispute Submission Body to bring its transitional regime for patent protection for pharmaceutical, agricultural and chemical products in conformity with TRIPS Agreement. The First Examination Report relating to the parent application was issued on 2nd July, 1999. It referred to claim 6 and claim 11 as it relates to invention distinguished from the rest and it also objected that claims 1 to 6, 9 and 11 are not allowable under S. 5A. On 10/09/2001, the Examiner of Patent Office addressed a letter to the agents of the appellants that the Patent Application No. 371/DEL/1997 was not in order and

cannot be accepted. Therefore, under S. 21(3) of the Act, the application is deemed to have been abandoned and it was open to the appellant to make a fresh application for the same invention provided it is not open to the public. But in the meanwhile, on 28/10/1999, the divisional application had been filed i.e. before the date when the parent application had been abandoned. When the alleged divisional application was filed, the First Examination Report was issued on 20/09/2007 stating that the present application does not comply with S. 16 and almost the same set of claims in a divisional application with the priorities of the abandoned patent application appears to be against public interest. The learned counsel referred to two instructions issued by the then Controller General. One, dated 03/05/2005 and the other dated 08/07/2006. The instructions are extracted below:-

u No. CG/F/14/5/8(B)/2005/29 dated 03/05/2005. CG'S INSTRUCTION NO. 3/2005: It has been observed that divisional applications are being filed with respect to claims which were not allowable under S. 5 of the Act before 01/01/2005 without following the provisions of S. 16 read with S. 10(5) of the Act. It is hereby ordered that such divisional application shall be examined under the above said provisions of the Act. No division of such application shall be allowed which are not qualifying for more than one invention or satisfying the provision of single inventive concept under S. 10(5) of the Act. (Sd/-) (S. Chandrasekaran) Controller General of patents, Designs & Trade Marks.

v No. CG/F/2006/ dated the 18th July, 2006. Camp: Delhi. Addressed to: All the Head of Offices, parent Office, Kolkata, Mumbai, Chennai & Delhi. Subject:- Clarification in respect of CG's Instruction No. 3/2005 dated 03/05/2005. Gentlemen, Kindly refer to the Instruction No. 3/2005 dated 03/05/2005 in respect of divisional application. In this connection, it is to clarify that any divisional application filed under the provisions of Section 16 claiming product claims which were not allowable under S. 5 of the Act before 01/01/2005 shall be allowed in accordance with the patents Act, 1970, as amended by the patents (Amendment) Act, 2005. All the Controllers are hereby direction to ensure that ll the divisional applications abandoned as per the Instruction No. 3/2005 should also be reviewed. Yours faithfully, (Sd/-) (S. Chandrasekaran) Controller General of patents, Designs and Trade Marks.

5. The learned counsel for the appellant stressed on this to support their case. No office instruction issued by the Controller General can over ride the provisions of the Act. The first instruction issued on 03/05/2005 was in cognizance of the Act i.e. divisional applications relating to inventions not allowable under S. 5 of the Act before 01/01/2005 shall be allowed, if they have been filed without following the provisions of S. 16. The next instruction, which specifically mentions product claims directs review of the divisional application. Reading both the instructions and provisions of Law relating to divisional applications, the instructions issued by the Controller General only mean that there might have been applications filed prior to 01/01/2005. Those applications might have consisted of plurality of inventions and one of the multiple invention in the said application may have related to a product which was not patentable under the earlier Act. These can now be processed as a divisional application subject to satisfying all the criteria for grant of patent and also the criterion for treating it as a divisional application. It cannot be construed to mean the re-submission of the same claims that were made in the parent application disguising it as a divisional application will be entertained. It still has to satisfy the requirements of S. 16. The letter submitted by the respondent on 20th September, 2008 is interesting. According to them "the Controller had disallowed the product claims 1, 6, 9 and 11 and therefore they had no choice but to delete the above claims and file a black box claim". The original objection was not to just "claim 1, 6, 9 and 11" but to "claim 1 to 6, 9 and 11". We have already extracted how all those claims still find a place in the present application. Except to state that it has been validly filed under the provisions of S. 16 it does not state how it conforms with S. 16. Now let us read S. 16 of The Patents Act, 1970:-

16. Power of Controller to make orders respecting division of application.-- A person who has made an application for a patent under this Act may, at any time before the grant of the patent, if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.

(2) The further application under sub-S. (1) shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.

(3) The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other.

Explanation.-- For the purposes of this Act, the further application and the complete specification accompanying it shall be deemed to have been filed on the date on which the first mentioned application had been filed, and the further application shall be proceeded with as a substantive application and be examined when the request for examination is filed within the prescribed period.

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 and 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.

8. What the appellant wants is that this application should be treated as a divisional application with the priority date of the parent application. The impugned order correctly holds that unless the divisional application satisfies the test under S. 16, it cannot be entertained. We see no cause to interfere. O.A. is dismissed.

(D.P.S. PARMAR)
Technical Member

(JUSTICE PRABHA SRIDEVAN)
Chairman

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