

INTELLECTUAL PROPERTY APPELLATE BOARD

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(Circuit Bench Sitting at KOLKATA)

OA/6/2010/PT/KOL

WEDNESDAY THIS, THE 10th DAY OF AUGUST, 2011

Hon'ble Smt. Justice Prabha Sridevan
Hon'ble Shri D.P.S. Parmar

-- Chairman
-- Technical Member (Patents)

LG ELECTRONICS, INC
A KOREAN CORPORATION
20 ,YOIDO DONG
YOUNGDUNG PO-GU, SEOUL
REPUBLIC OF KOREA

-- Appellant

(By Mr Samaresh Chakarboty)

Vs.

1. THE CONTROLLER OF PATENTS & DESIGNS
PATENT OFFICE
Bowdhik Sampada Bhavan,
CP-2, Sector-V, Salt Lake City
KOLKATA – 700 091

2. THE ASSISTANT CONTROLLER OF PATENTS & DESIGNS -- Respondents
Bowdhik Sampada Bhavan,
CP-2, Sector-V, Salt Lake City
KOLKATA – 700 091

3. THE THEN EXAMINER OF PATENTS & DESIGNS
Bowdhik Sampada Bhavan,
CP-2, Sector-V, Salt Lake City
KOLKATA – 700 091

(By Dr A Chakarboty , Assistant Controller of Patents & Designs)

ORDER No.111/2011

HON'BLE Shri D.P.S. PARMAR, TECHNICAL MEMBER (PATENTS)

This appeal is filed under section 117A of the Patents Act, 1970 (hereinafter referred to as the Act) against the order dated 10th August,2009, passed by the Assistant Controller of Patents & Designs refusing the appellant's divisional patent application No. 1191/KOL/2005 dated 28.12.2005 under section 15 of the Act.

2. Patent Application No. 1191/Kol/2005 was filed by LG ELECTRONICS, INC, REPUBLIC OF KOREA as a divisional application divided out of the patent application No. 489/KOI/2004 dated 16.08.2004 claiming priority from a Korean Application dated 18.08.2003 for their invention relating to 'Suction Silencer and Compress therewith' on 28.12.2005 for grant of a patent. The Respondent-2 examined the application and the First Examination Report (FER) was issued by the Respondent-2 under Section 12 and 13 of the Act on 27.05.2008. FER dated 27.05.2008 *inter alia* comprises the following technical objections:-

"1. The instant application has been filed as a divisional application out of the mother application 489/KOL/2004, which was abandoned under Section 21(1) of the Act. The same mother application did not contain or claim plurality of distinct inventions. In view of this, the filing of the said divisional application is infructuous and cannot be allowed as a divisional application.

2. Claims 1-16 of the instant application are anticipated by claims 1-16 of the mother application 489/KOL/2004 under Section 13 of the Act.

3. Without prejudice to the objections as above it may be noted that the subject matter of present claims 1-16 does not involve and inventive step because any standard text books or literatures on refrigeration system disclose the features of the "suction silencer" and "compressor" as claimed in present claims 1-16. The same objection was raised regarding claims 1-16 of the mother application 489/KOL /2004. Hence the said claims are not allowable under Section 2(1)(j) of the Act."

3, On 25.02.2009, all the above objections were replied by the Appellant through his counsel. The Respondent-2 vide their letter dated 06.05.2009 informed that

“The observations given in your letter dated 27th May, 2008 have been considered carefully but this office is of the opinion that the same is not acceptable. The objections raised in said letter of 27.05.2008 are still sustained”.

4. Respondent-2 heard the Appellant on 15.05.2008 and issued an impugned order under Section 15 of The Patents Act, 1970 refusing the grant of patent. Aggrieved by the impugned order of the Respondent, the Appellant has filed this appeal.

FACTS

5. The main application for patent No. 489/KOI/2004 out of which the instant application has been divided out, was claiming ‘Suction Silencer and Compress therewith’. This application was examined by the second Respondent and First Examination Report (FER) thereof was issued on 06.01.2005. The examination report *inter-alia* contained technical objections and formal objections. The Appellant did not respond to the objections contained in FER issued by the Respondent-2 and therefore his application was deemed to have been treated as abandoned u/s 21(1).

6. The subject application for patent 1191/Kol/2005 was filed by the applicant L.G. ELECTRONICS, INC. A KOREAN CORPORATION on 28.12.2005 purportedly as a divisional application of 489/Kol/2004 of 16.08.2004. Both of these applications claimed priority from a Korean application dated 18.08.2003.

Patent Application No. 489/Kol/2004 with the title as “Suction Silencer and Compressor therewith” with 18 claims was published on 24.06.05 and was examined by Respondent-2. The first examination report was sent to the applicant on 06.01.2005. Claim 1 read as follows:

1. A suction silencer in a compressor comprising a lower shell having an opened top, for drawing refrigerant; and an upper shell fixed to the top of the lower shell to form an inside space for reducing noise of drawn refrigerant, for discharging refrigerant in a direction different from a flow direction of the refrigerant introduced into the lower shell.

Claims 2-8 are dependent on claim 1.

Claim 9 claims:

9. A compressor comprising a compression part for drawing low pressure refrigerant, and compressing the refrigerant to a high pressure refrigerant, and discharging the high pressure refrigerant; and a suction silencer for reducing noise of the refrigerant being drawn, and discharging to refrigerant to the compression part, wherein the suction silencer includes; a lower shell having an opened top, for drawing refrigerant, and an upper shell fixed to the top of the lower shell to form an inside space for reducing noise of drawn refrigerant, for discharging refrigerant in a direction different from a flow direction of the refrigerant introduced into the lower shell.

Claims 10-16, either directly or indirectly, depend on claim 9. Two other claims (wrongly numbered as 20 & 21 instead of 17 & 18) were omnibus claims.

7. In the first examination report certain technical and formal objections were communicated. No objection with respect to the plurality of distinct inventions was raised. The applicant neither responded to the FER nor returned the documents (application, specification and drawings sent to the applicant along with the FER) within the time prescribed under Section 21(1) of the Act, i.e., 06.01.06 and was deemed to be treated as abandoned.

8. Later Patent Application No. 1191/KOL/2005 was filed on 28th December 2005 with the same title as for Patent Application, i.e. “Suction Silencer and Compressor therewith” with 16 claims. These claims were verbally same with those of 489/KOL/2004.

9. The case was examined and FER sent on 27.05.2008. The FER, inter alia stated that:

1. The instant application has been filed as a divisional application out of the mother application 489/KOL/2004, which was abandoned under Section 21(1) of the Act. The same mother application did not contain or claim plurality of distinct inventions. In view of this, the filing of the said divisional application is infructuous and cannot be allowed as a divisional application.
2. Claims 1 to 16 of the instant application are anticipated by claims 1 to 16 of the mother application 489/KOL/2004 under Section 13 of the Act.

10. In response to the FER the agent of the applicant submitted 9 claims along with their observation on 25.2.2009. The amended claim read as:

1. A suction silencer of hermetic compressor comprising a base having an inlet disposed thereon and forming a predetermined space inside the suction silencer; and a head cover on which an outlet is formed for discharging the introduced refrigerant to a compression chamber inside a cylinder coupled with the base of open/close the space of the base, the inside of head cover forming one space with the

inside of the base so that the refrigerant introduced through the inlet expands to the space; wherein the inlet is extended from an outer surrounding of the base to the inner space of the base, and the outlet has an outlet pipe which is extended toward the inner space of the base.

Amended claims 2-9 are dependent on amended claim 1.

11. The applicant's agent, during the hearing, acceded that the claims of Patent Applications are same or substantially the same with those of divisional application. It was admitted that if instant application is not allowed the status of divisional application of Patent Application, it will be anticipated by it.

12. The main issue at the hearing was whether later application was a proper divisional application within the meaning of Section 16 of the Patents Act 1970 (herein after referred as the Act).

Appellant's submissions

13. The learned counsel for appellant submitted that under the provisions of section 16, the applicant can file a divisional application any time before the grant of patent if he so desires or on the directions of the Controller to remedy the objections raised by him on the ground that the claims relate to more than one invention. Accordingly, the appellant is entitled to file a divisional application voluntarily even if parent application does not contain more than one invention. The learned counsel for appellant submitted that the issue of more than one invention is applicable only when the Controller raises such objections. The learned counsel submitted that many such applications have been allowed by the patent office. He cited Supreme Court Manu /SC/2713/2008 to interpret the meaning of the word 'or'

"12. The word 'or' is normally disjunctive and 'and' is normally conjunctive. But at times they are read as vice versa to give effect to the manifest intention of the Legislature as disclosed from the context. As stated by Scrutton, L.J.: "You do sometimes read 'or' as 'and' in a statute. But you do not do it unless you are obliged because 'or' does not generally mean 'and' and 'and' does not generally mean 'or'. And as pointed out by Lord Halsbury the reading of 'or' as 'and' is not to be resorted to, "unless some other part of the same statute or the clear intention of it required that to be done". But if the literal reading of the words produces an unintelligible or absurd result 'and' may be read for 'or' and 'or' for 'and' even though the result of so modifying the words is less favourable to the subject provided that the intention of the Legislature is otherwise quite clear. Conversely if reading of 'and' as 'or' produces grammatical distortion and makes no sense of the portion following 'and', 'or' cannot be read in place of 'and'. The alternatives joined by 'or' need not always be mutually exclusive.

13. In *Fakir Mohd. (dead) by Lrs. V. Sita Ram* 2002 (1) SCC 741 it was held that the word 'or' is normally disjunctive. The use of the word 'or' in a statute manifests the legislative intent of the alternatives prescribed under law.

14. Had the Legislature intended that the reference could be made after the Government or the Specified Authority deals with the review power, it would have said so specifically by specific words. It could have provided for a direct reference. The parameters of review are different from a reference.

15. A plain reading of the provision makes the position clear that two courses are open. Power is conferred on the appropriate Government to either on its own motion or on an application made, review its order or refer the matter to the Tribunal. Whether one or the other of the courses could be adopted depends on the facts of each case, the surrounding circumstances are several other relevant factors.

17. When the words of a statute are clear, plain or unambiguous, i.e. they are reasonably susceptible to only one meaning, Courts are bound to give effect to that meaning irrespective of consequences. [*State of Jharkhand vs. Govind Singh* MANU/SC/1025/2004 : AIR2005SC294, *Nathi Devi Vs, Radha Devi Gupta* : MANU/SC/1071/2004 : AIR2005SC648].

18. In *Sussex Peerage case* (1844) 11 Cl&F, at page 143 Tindal C.J. observed as follows:

If the words of the statute are in themselves precise and unambiguous, then no more can be necessary than to expound those words in their natural and ordinary sense. The words themselves do along in such cases best declare the intent of the lawgiver.

19. When a language is plain and unambiguous and admits of only one meaning no question of construction of a statute arises, for the Act speaks for itself."

14. The learned counsel for appellant submitted that the Respondent did not exercise his own judgment in the assessment of the issue in

question and rather quoted the order of the other Controller.

13. Under Sub-section (6) of Section 25N it is open to the appropriate Government or the Specified Authority to review its order granting or refusing to grant permission under Sub-section (3).

He cited MANU/SC/0128/1958 in support of his argument.

“10. This memorandum was submitted by the first Respondent to the Assistant Commissioner (C.S.) for his opinion.

11. On August 29, 1953, the Assistant Commissioner (C.S.) made a note that the first Respondent should not have made a direct reference to him. He recorded his opinion that the appellants were accountable for all sales in respect of which the goods were delivered in West Bengal and that they were commission agents who received commission on all sales made in West Bengal by the Kanpur Woollen Mills, Kanpur and being the commission agents of the Kanpur Mills were accountable for the transactions. He, therefore, ordered the first Respondent to do the needful. The first Respondent made an entry in the order sheet on September 2, 1953, stating that action was being taken accordingly. He also ordered the appellants to appear with books of account for further examination, and to produce their Agency Contract with Kanpur Mills and a list of the dealers in Calcutta who received goods direct from Kanpur.

12. On November 21, 1952, the representative of the appellants submitted a statement to the first Respondent clarifying the whole position. It was pointed out that the appellants acted as agents of M/s. Lalimili Mills of Kanpur and got a commission once at the end of every year on all the sales effected by the Mills in the State of West Bengal. The orders were placed directly by the customers of the Mills with the Mills; the Mills executed the orders and consigned the goods direct to those customers; recording the said customers as the consignees; the said customers negotiated bills through the banks, cleared the goods from the carriers and sold them as they liked. The Mills only maintained a personal account of the appellants in which the commission at the end of the year was credited. The Mills never debited the appellants with the value of the goods; neither did the appellants credit the Mills with the value of the goods nor debited their goods account. At no stage of these transactions was the property in the goods either transferred to or acquired by the appellants, and nobody could transfer any goods which he did not acquire or possess. Besides, the accounts of the said customers of the Mills did not indicate any transactions at all with the appellants in the State of Bengal. It was therefore submitted that the appellants could not be deemed or held in law or in fact to be the dealer qua those sales in West Bengal much less liable to pay any sales tax on those sales. It was also pointed out that the appellants had earned the maximum commission of 2.4% which was less than even the sales tax which worked out to about 4.2% and this could never have been intended by the law.

15. On September 23, 1954, the then Assistant Commissioner (C.S.) wrote that his predecessor had already advised the first Respondent on this matter and if the appellants were aggrieved they might prefer a regular revision or appeal petition before the competent authority as provided under the law. The first Respondent made an entry on September 30, 1954, stating that he had seen the notes and that action was being taken accordingly.

18. From the detailed narration of the facts regarding this particular assessment it is quite clear that the first Respondent did not exercise his own judgment in the matter of the assessment in question. Even though he was convinced to the contrary, he asked for the instructions of the Assistant Commissioner (C.S.) and followed the same and assessed the appellants to sales-tax in respect of the disputed transactions. The order which he ultimately passed on January 15, 1955, further showed that he was merely voicing the opinion of the Assistant Commissioner (C.S.) without any conviction of his own and the only thing he had to say in regard to the various grounds mentioned in the letters dated November 21, 1953, and June 19, 1954, was that they appeared to him to be “not at all satisfactory”. This was hardly a satisfactory way of dealing with the matter. If the Assistant Commissioner (C.S.) had been dealing with the same he could have by all means given in the assessment order which he made his reasons for doing so and these reasons would have been open to scrutiny in further proceedings taken by the appellants either by way of appeal or otherwise. The Assistant Commissioner (C.S.) however, had delegated this work of assessment to the first Respondent and then it was the duty of the first Respondent to make the assessment order giving his own reasons for doing so. The file of the assessee, however, shows that even though the 1st Respondent was satisfied on the materials placed by the appellants and their representative before him that the appellants were not liable to pay sales-tax in regard to these transactions, he referred the matter first for instructions and then for obtaining the “valued opinion” of his superior, the Assistant Commissioner (C.S.) and the latter expressed his opinion that the appellants were liable in respect of these transactions. All this was done behind the back of the appellants and the appellants had no opportunity of meeting the point of view which had been adopted by the Assistant Commissioner (C.S.) and the first Respondent quietly followed these instructions and advice of the Assistant Commissioner (C.S.). “

15. The learned counsel argued that by dividing the application only the processing time of the application is being enlarged without extending the term of the patent. The learned counsel argued that section 16 shall be interpreted in such a way that

“26. A divisional application may be filed even when there is no question of more than one group of inventions not linked by a single inventive

concept. His proposition is based on the phrase "if he so desires" and "or" as in Section 16(1). I would like to quote his reading of Section 16(1) again as herein below.

"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, 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."

OR

"A person who has made an application for a patent under this Act may 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."

16. He contented that the clause "if he so desires" empowers him an unconditional freedom to file a divisional application even when there is no plurality of distinct inventions or inventive concepts.

17. Therefore the learned counsel argued that Respondent 2 erred in refusing the grant of divisional status to the application the application and hence the impugned order shall be set aside.

Submission by the Respondent:

18. Respondents represented by Dr. A. Chakraborti in his counter statement submitted that section 16 shall be interpreted in such a manner to avoid any inconsistency uncertainty and friction in the system and if the interpretation as suggested by learned counsel for appellant is applied it would allow the applicant to enjoy unfettered time limits to put his application in order as opposed to the provisions of section 21(1) of the Act.

He referred to the pertinent sections of the Act which are reproduced below

"Section 7 : Form of application

7(1) Every application for a patent shall be for one invention only.

Section 10 : Contents of specification

.....

10 (5): 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. Power of Controller to make orders respecting division of application

(1) A person who has made an application for a patent under this Act may, at any time before the grant of 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-Section (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 specification 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 has 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.]

Section 21(1): An application for a patent shall be deemed to have been abandoned unless, within such period as may be prescribed, the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objections to the application or complete

specification or other documents related thereto is forwarded to the applicant by the Controller.

Explanation:- Where the application for a patent or any specification or, in the case of a convention application or any application filed under the Patent Cooperation Treaty designating India any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has re-filed it or the applicant proves to the satisfaction of the Controller that for the reasons beyond his control such document could not be re-filed.

83. General principle applicable for to working of patented inventions:-

Without prejudice to the other provisions contained in this Act, in exercising the powers conferred by this chapter regard shall be had to the following general considerations, namely:-

.....

(C) That the protection and enforcement of patent rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage or producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.”

19. He further submitted that

“24. The heading of Section 16 reads as **“Power of Controller to make orders respecting division of application”**. A careful reading of section 16 in conjunction with section 7 and Section 10(5) revealed that this heading implies that even if the applicant files an application suo moto which is purportedly an application diverted out of another application. The Controller is under obligation to see whether the parent application from which the impugned application has been divided truly comprises of plurality of inventive concepts. If not there is no reason that the Controller would exercise his power to divide the application. Section 16(3) empowers the Controller to ensure that the claims of the parent and divisional application do not consist of claims of same scope, i.e., the Controller is bound to see that the divisional application must not claim the same claims of parent application.

20. He cited rulings which have been given by the Hon'ble Supreme Court of India on interpretation of statutes, and the following propositions of the Hon'ble Supreme Court ought to be considered in coming to right and lawful conclusion in the instant matter :-

i) In Bihar State Council of Ayurvedic and Unani Medicine vs. State of Bihar, AIR (2008) SC 595 Hon'ble Supreme Court held that “Interpretation which would frustrate the statute to be avoided--

Interpretation consistent with smooth working of the system which the statute purports to be regulating should be preferred to that which would introduce uncertainty, friction or confusion into the working of the system (Para 51),

In Bhatia International vs. Bulk Trading S.A. AIR 2002 SC 1432 Hon'ble Supreme Court held that “If a language used is capable of bearing more than one construction, in selecting the true meaning, regard must be had to the consequences, resulting from adopting the alternative constructions. A construction those results in hardship, serious inconvenience, injustice absurdity or anomaly or which leads to inconsistency or uncertainty and friction in the system which the statute purports to regulate has to be rejected and preference should be given to that construction which avoids such results”.

21. He argued that any uncertainty in the rights and obligation of the patentee shall be avoided. As applicant has himself allowed his application to be abandoned under section 21(1) and the application falls in the public domain. Allowing filing of divisional application will create an uncertainty around the application which otherwise had fallen in public domain. Filing of divisional application is an attempt to revive the abandoned application

DECISION

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22. The concept of divisional application in the patent law basically addresses the issues of allowability of protection of multiple inventions disclosed in one patent application, where these multiple inventions do not constitute a single inventive concept. The protection of multiple inventions through divisional application is available in the Patents Act 1970 under the provisions of section 16 and section 10(5) reproduced below.

“16(1).- 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-section (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.

10(5).- 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.

Accordingly, on plain reading of the above referred provisions, it is evident that if the claims of the invention disclosed in one patent application do not relate to single invention or to a group of the inventions forming a single inventive concept, the applicant can file further application as divisional application out of that application either of his own (*suo moto*) or when the objection of disclosure of more than one invention is raised by the Controller. Further, where any overlapping of the claims in the parent application with the divisional application is observed, the Controller may seek the amendments in the complete specification of the divisional application to ensure that there is no overlapping of claims between the these applications. In other words the later application should not include any claim already claimed in the parent application. Moreover, the matter disclosed in the divisional application should not include any matter not disclosed in substance in the complete specification of the parent application. Therefore, in order to become eligible as a divisional application u/s 16, it is primarily essential that the parent application out of which the divisional application is filed, should disclose more than one invention and not just the same invention. This is also supported by Narayanan, in paragraph 3-44 of Patent Law by P. Narayanan [4th Edition 2006 page No.60]

“Where an application relates to more than one invention the defect may be remedied by filing a further application. This may be done either at the applicant’s own request at any time before the grant of patent (earlier, it was before the acceptance of the complete specification) or with a view to remove the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention. It is further stated that whether the specification cover more than one invention, it is for the Controller to decide.”

It is therefore clearly evident that the intended purpose of the statutory provisions under section relating to division of application is

- a) to cure any defect relating to multiplicity of invention in one application,
- b) to enable filing of division application to protect the multiple inventions disclosed in one application,
- c) to allow the priority date of the parent application for the divisional application.

We agree with the applicants arguments that the applicant can file an application as divisional application **of his own** before the grant of patent. However Respondent-2 is mandated by the law to ascertain that the divisional application so filed is on account of disclosure of plurality of distinct invention in the parent application. Section 16 pertains to power of the Respondent to make order respecting division of application. Right to file divisional application indeed rest with the applicant but the power to ascertain its allowability is vested with the Respondent. The first essential requirement of this provision is the fact of existence of plurality of invention in the parent application. The provision under section 16 put a bar on filing same claims as it mandates the Respondent to seek such amendment of the complete specification as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other. In the present case same application with same claims have been filled which is not the purpose of this provision. Since the appellant admittedly stated that the mother application has been allowed to be treated as abandoned under section 21(1), we feel that further application for same invention with same claims is an attempt not to divide the subject matter of the application but an exercise to revive the subject matter of the application by enlarging the time for securing the grant of patent using the provisions of section 16. This in fact is not the purpose of section 16. This section does not include such ground for division of application. Thus if the applicant desires to file a divisional application for his invention, disclosure of more than one invention (plurality of distinct invention) in the parent application is essential. In fact the existence of plurality of invention in the parent application is the sine qua non for a divisional application by the applicant whether it is *suo moto* as to remedy Controller’s objection.

On comparison of the set of claims in the parent application and the instant divisional application, it is found that they are exactly the same. The parent application, which was then abandoned, did not contain any claims relating to plurality of distinct invention. Interestingly, no objection relating to plurality of distinct invention was raised in First Examination Report (FER) issue on 06.01.2005 in respect of the mother application.

Instead, without complying with the requirements contained in the FER, appellant filed the instant application as divisional application. Thus, the instant application appears to have been filed in the guise of divisional application to revive the claims in the parent application which the appellant *suo moto* allowed to be treated as abandoned under section 21(1).

23. We do not agree with the reading/interpretation of section 16 by the appellant as it is not wise to consider Section 16 in a clinical way by leaving other portion of the section. Such interpretation is also not in line with well-settled principle of Law “that the intention of the legislature must be found by reading the statute as a whole and in order to ascertain the meaning of a clause in a statute, the court must look at the whole statute”.

24. Further, if the argument of the appellant that the he may file a divisional at his unconditional “desire” then a situation may arise (as in the present case) when the FER is sent to the applicant by Respondent-2, the applicant instead of returning the documents within 12 months from FER under Section 21 may choose to file a divisional application and then abandon the parent application even with no plurality of distinct inventions. This would mean that the Respondent-2 has to further re-examine such cases and send the FER. The net result of this action of the appellant will enlarge the time limit beyond the statutory period of one year given to him under section 21(1). This would result in uncertainty in respect of the grant or refusal of such applications which will be not in the interest of **public at large** as they will not be able to find when the patent will be granted, refused or abandoned. They will be in dark as to when the invention would fall in public domain. This in fact is not the desired purpose of Section 16. hence his argument is not acceptable.

25. We are convinced that the phrase “if he so desires” used in Section 16 is not unconditional and it does not give the applicant an unqualified liberty to file a divisional application even when there is no situation of plurality of the distinct inventions contained in the mother application. In view of above finding we do not find any reasonable ground to differ from the conclusion drawn by Respondent-2. The appeal is dismissed.

(D.P.S. PARMAR)
TECHNICAL MEMBER (Patents)

(JUSTICE PRABHA SRIDEVAN)
CHAIRMAN

AVN

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