

THE PATENTS ACT 1970
(Section 77 (f) & (g))

In the matter of application No.259/DEL/2005
In the matter of review petition filed u/s 27(f) & (g) of the Act

Hearing held on 7th February 2008 at 11.30 A.M.

Present:

1. Shri Vineet Rohilla ---- - Agent representing the applicant
- 2., Smt. Rishu Bharti ----- Examiner of Patents & Designs

O R D E R

M/s DE BEERS INDUSTRIAL DIAMOND DIVISION (PROPRIETARY) Limited, a company registered according to the laws of the Republic of South Africa, of Debid House, Corner Amethyst Street & Crownwood Road, Theta Johannesburg, South Africa, filed their application No.259/Del/2005 dated 8th February 2005 for their invention related to “a diamond product” which is a divisional application out of patent application No.2866/Del/1998 dated 23rd September, 1998.

2. The main application for patent No.2866/Del/1998 out of which the instant application has been divided out, was claiming “*a diamond product comprises a diamond core, and a coating of diamond completely enclosing the diamond core, the coating diamond being different to that of the core diamond and both the core diamond and the coating diamond influencing the characteristics of the product.*” This application was examined by the Office and First Examination Report thereof was issued on 15th March 2004. The examination report *inter-alia* contained a objection that the invention is not allowing u/s 5(1)(b) of the then existing Patents Act 1970. In other words, the invention was a chemical per se and hence was not patentable under the Act before 1st January 2005. However, the agent for the applicant did not respond to the objections contained in First Examination Report

issued by the Patent Office and the application was abandoned u/s 21(1) of the Act for not complying with the requirements.

3. The applicants, therefore knowing the fact that product patent for chemical substances per se including pharmaceutical and drug compounds is to be made available from 1st January 2005, chose to file a fresh application for same invention as divisional application out of the earlier main application. The set of claims of the so called divisional application were same as of the earlier application including the claim 1 which was again claiming "*a diamond product comprises a diamond core, and a coating of diamond completely enclosing the diamond core, the coating diamond being different to that of the core diamond and both the core diamond and the coating diamond influencing the characteristics of the product.*" This application was again examined and First Examination Report was issued on 1st March 2006. The First Examination Report *inter-alia*, contained all those objections which were raised in respect of earlier main application including the objections that claims conflict with the claims of parent application No.2866/Del/1998. The applicant re-filed their documents along with the submission on 5th May 2006 replying to the objections raised in the First Examination Report dated 1st March 2006. In their response, the applicants themselves admitted that the earlier application No.2866/Del/1998 was allowed to lapse by not filing the response to the office action and argued that since the prior application has lapsed, the claims on file for the present application cannot be considered to be conflicting with the same. The application was again examined and a further report containing the objections was issued vide this office letter No.259/Del/2005/8465 dated 13.2.2007 informing the applicant that the instant application cannot be considered as divisional application as the same does not meet the requirement of the provisions of section 16 of the Act which requires to have more than one invention in the parent application for filing divisional application out of that.

4. In response to the above office action, the agents for the applicant submitted that they had the opportunity of discussion with the then Controller General of Patents, Designs & Trade Marks regarding the grant of divisional status to such applications filed to cover the scope of the product claims not allowed under the old

law and given the understanding that internal instruction would be issued to allow the divisional application claiming product claim which were not allowable u/s 5 of the old Act. The agent for the applicant vide their letter dated March 1, 2007 further submitted that in change circumstances where the invention complied with all the requirements of patentability and was still not being allowed u/s 5, the applicants were left with no option to safeguard their interest being jeopardized but to allow said parent application to lapse and file the divisional application along with all the claims of the parent application in order to protect their invention. In the light of submissions made by the agents for the applicant and also the instructions issued by the Controller General of Patents, Designs and Trade Marks 3rd May 2005 and also dated July 18, 2006, the application was further examined and it was found that the said application did not meet the requirement of section 16 of the Act to qualify as divisional application but by that time due date to meet the requirement expired. Accordingly, the instant application was treated as abandoned u/s 21 of the Act for not complying with the requirement of objection and accordingly, the applicant were informed vide this office letter No.259/Del/2005/7264 dated 20th November, 2007.

5. The applicants therefore filed a review petition on 7th December, 2007 against the said abandoned letter dated November 20, 2007. Accordingly, a hearing was held on 7th February 2008 to consider the review petition. During hearing, the agents for the applicant reiterated the same arguments including that the applicants were not given the opportunity of being heard before taking adverse actions in accordance with the section 15 of the Act. During the hearing the agent for applicant argued 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. According to the agents for the applicant they are entitled to file divisional application of their own even if parent application does not contain more than one invention. According to them the issue of more than one invention is applicable only when the Controller raises such objections. The agent for applicant also relied upon the order dated 24th December 2007 issued by one of the Controller of Patents, Patent Office Mumbai allowing the divisional application in respect of application No.386/MUMNP/2005.

6. Before considering the issue of divisional application let me quote the instruction No.3/2005 dated 3rd May 2005 issued by the Controller General of Patents, Designs and Trade Marks. These instructions were issued to consider the divisional applications being filed with respect to the claims which were not allowable u/s 5 of the Act before 1st January 2005 in accordance with the provisions of section 16 read with section 10(5) of the Act. According to these instructions divisional application shall be examined under the provisions of section 16 and no divisional application shall be allowed which are not qualifying for more than one invention or satisfying the provisions of single inventive concept u/s 10(5) of the Act. The Controller General vide his letter dated July 18, 2006 further clarified that all the divisional application abandoned as per the above mentioned instructions should be reviewed and allowed in accordance with the Patents Act 1970.

7. The concept of divisional application, in most statutes across the world is basically to protect the multiple inventions disclosed in one patent application, if such multiple inventions do not constitute a single invention concept. A similar provision to protect multiple inventions is also available in the Patents Act 1970. The provisions of section 16 and section 10(5) are 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.

Section 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.

8. Accordingly, on plain reading of the above referred provisions, it appears to me 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 and in case of overlapping of the claims in the earlier parent application as well as in the further application as divisional application, the Controller may also allow the amendments of the complete specification so as to ensure that neither of the said complete specifications includes a claims for any matter claimed in other. However, 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 out of parent application, it is necessary that parent application out of which is divisional application is filed, should disclose more than one invention and not just the same invention. This is also supported in the paragraph 3-44 of Patent Law by P. Narayanan [4th Edition 2006 page No.60] which is also considered to be an authority and followed in India in respect of patent. According to Narayanan, 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 clear that the intended purpose of the statutory provisions is to protect the multiple inventions disclosed in one application by enabling to file further application as divisional application based on the priority date of the earlier application so that the applicant who has disclosed more than one invention in his

application is not deprived of his rights for protecting all inventions, since the provisions of section 10(5) allow claims only for single invention in one application.

9. Although, I agree with the applicants arguments to the extent that applicant can file an application of his own before the grant of patent as divisional application as nobody can stop him from doing so but it is the duty of the Controller to see that whether the divisional application so filed is due to disclosure of plurality of distinct invention in the parent application. This is also somewhat clear from the heading of the section 16 which reads “Power of the Controller to make order respecting division of application”. Therefore I do not agree with the applicant’s argument that in case the applicant files a divisional application for his invention, disclosure of more than one invention (plurality of distinct invention) in the earlier application is not essential.

10. The instructions as referred above issued by the Controller General are very clear in allowing the divisional application in accordance with the provisions of the Patents Act. On analysis of the claims it is found that the set of claims in the parent application and the instant divisional application are exactly same. The parent application, which is now abandoned, did not contain any claims relating to plurality of distinct invention. In other words the parent application did not disclose more than one invention (plurality of distinct invention) in the complete specification. Interestingly, it has also been noticed that the due date for complying the objections raised by the Patent Office in respect of parent application (2866/Del/98) was to expire on 15th March 2005 i.e. after 1st January 2005 when the provisions of the Patents (Amendment) Act 2005 allowing the product patent in respect of pharmaceuticals, food and chemical substances were already introduced and operational and I think the applicants could have taken necessary action to comply with requirements contained in the First Examination Report to put the parent application in order for grant within the stipulated time. However, instead of complying with the requirement applicant filed the instant application as divisional application without meeting the requirements. Therefore, the instant application appears to have been filed in the guise of divisional application to protect same invention of parent application which was although not allowable prior to 2005 but would have been protected ,had the agents for the applicant

taken due care to meet the objections in the parent application. The circumstances under which application No.386/MUMNP/2005 was allowed, are different than the present application.

Having considered all the circumstances, submission made by the agent for the applicant during the hearing and as well as in the review petition including all the documents on record and also in view of my above findings, I hereby refuse to consider the instant application as a divisional application u/s 16 of the Act as the same has not been filed in accordance with the provisions of the Patents Act. Accordingly, the review petition is disposed off.

Dated, the 14th day of February, 2008.

(Dr. K.S. Kardam)
Assistant Controller of Patents & Designs.

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