

**THE PATENTS ACT, 1970**

**SECTION-15**

In the matter of an Application  
for Patent No. 1191/Kol/2005  
dated 16.08.04

LG Electronics, Inc. .... Applicant  
20 Yoido-Dong, Youngdungpo-Gu Seoul, Republic of Korea

Present:

Sri Samaresh Chakraborti and Sri S.K.Guin..... For the Applicant  
of M/s D. P. Ahuja & Co., Kolkata

Dr. Arindam Chatterjee..... Examiner of Patents and Designs

Hearing held before Dr. Amitava Chakraborti,  
Assistant Controller of Patents and Designs  
on 15.05.2009

**Decision**

**Background:**

1. The subject application for patent 1191/Kol/2005 was filed on 28.12.2005 purportedly as a divisional application of 489/Kol/2004 of 16.08.2004. Hereinafter these applications are referred as LG2 (1191/Kol/2005) and LG1 (489/Kol/2004). Both these applications claimed priority from a Korean application dated 18.08.2003.
2. LG1 with the title as "Suction Silencer and Compressor therewith" with 18 claims was published on 24.06.05 and examined duly. The first examination report

alongwith the application, complete specification and drawings were sent to the applicant on 06.01.2005. Claim 1 claims:

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 and 21 instead of 17 and 18) were omnibus claims.

3. In the first examination report of LG1 dated 06.01.2005 certain technical and formal objections were communicated to the agent. Let it be noted that 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.

4. LG2 was filed on 28<sup>th</sup> December 2005 with the same title as of LG1, i.e., "Suction Silencer and Compressor therewith" with 16 claims. These claims were verbally same with those of LG1.
5. The case was examined duly and FER sent on 27.05.2008. The FER, inter alia communicated 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.
6. In response to the FER the agent of the applicant submitted 9 claims along with their observation on 25.02.2009. The amended claim 1 claims that:
  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 to 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 a outlet pipe which is extended toward the inner space of the base.Amended claims 2-9 are dependent on amended claim1.

7. Not being satisfied with the proposed amendments and observations sent vide the covering letter of the agent dated 25.02.2009 this Office offered him an opportunity of being heard vide letter dated 06.05.2009 on 15.05.2009.
8. After the hearing, Learned Agent of the applicant as instructed, submitted written note of arguments on June 03, 2009.

**Issue in the hearing:**

9. The applicant's agent, during the hearing acceded that the claims of LG2 are same or substantially same with those of LG1. Also it was admitted that if LG2 is not allowed the status of divisional application of LG1, it will be anticipated by LG1.
10. The sole issue at the hearing was whether LG2 was a proper divisional application within the meaning of Section 16 of the Patents Act 1970 (herein after referred as the Act).

**Submission of the agent:**

11. The sum and substance of the argument of the Learned Agent was:
  1. An applicant can file a divisional application of his own even when there is no plurality of the distinct inventions or distinct inventive concept (**voluntary division**). The question of distinctness is applicable when the controller mandates the division of the application (**mandatory division**). The only condition for filing a divisional application, suo moto, (according to him) is that the application should not contain anything or not include any matter not in substance disclosed in the parent application. According to him the Controller cannot refuse his application (LG2) on the ground that the Office did not find any distinctness in his subsequent application.
  2. These arguments are based on his interpretation of Section 16(1) of the Act.

He has also argued that the similar provisions exist in other countries. In support of this, he submitted a judgment of Patents Court UK in "Luk Lamellan

und Kupplungsbau GmbH's application", [1997] R.P.C. p 104. Also he has submitted a news item downloaded from the website of the European Patent Office with the title "Time limits to be introduced for divisional applications". The page shows hyperlink to Decision of the Administrative Council of 25 March 2009 amending the Implementing Regulations to the European Patent Convention (CA/D 2/09). The Learned Agent also cited some principles for interpreting statutes as delivered in several judgments of the Honourable Supreme Court of India.

**The law:**

12. I would like to refer the pertinent Sections of the Act which I feel relevant in the present context.

**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 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.]

**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 an 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 principles 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 of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.

**Decision:**

13. According to Sri Chakraborti, the learned agent of the applicant :

“The above quoted Section 16(1) of the Act ought to be construed and read as under:

“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.**”[Emphasis by the Learned Agent]

According to him on proper construction/interpretation of the statutory provision, quoted above, any prudent person should understand that filing of such "further" application by way of "division" of the "parent" application is according to the own option of the applicant OR with a view to remedy any objection raised by the Learned Controller on the ground of "more than one invention" being claimed in the "parent" application. Thus, said "option" of the applicant has no relationship with any "distinct" embodiment being claimed in the "parent" application.

He argued that an applicant can file a divisional application on his own accord if he so desires, any time before a patent is granted on the already filed application, or before the latter is withdrawn. Section 16(2) of the Act stipulates that the content of the divisional application shall not include any matter not in the substance disclosed in the complete specification filed in pursuance of the first-mentioned application. Section 16(3) of the Act provides that the Learned 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.

The applicant's agent summarized the arguments as herein below:

1. An applicant can file a divisional application on his own accord if he so desires, any time before a patent is granted on the already filed application, or before the latter is withdrawn.
2. Section 16(2) of the Act stipulates that the content of the divisional application shall not include any matter not in the substance disclosed in the complete specification filed in pursuance of the first-mentioned application.
3. Section 16(3) of the Act provides that the Learned 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.

4. Thus, the only restriction about the claims of a divisional application under the prevailing Indian Patents Act is that the two applications, namely the parent application and the divisional application in their final amended form should not have claims with identical scope.
5. The Explanation at the end of Section 16 very categorically mentions that 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. The Learned Examiner is thus bound by the Act to examine a divisional application where a request for substantive examination is filed and give his report to the Learned Controller for its transmission to the applicant.

14. He further argued that the identical provisions are there in foreign jurisdictions like in UK and in European Patent Office. Those being: (i) Voluntary Divisional Application to protect the whole or part matter(s) disclosed in the "parent" specification, so that at the option of the applicant, said voluntary "divisional" application can protect the whole or part of the claimed matter(s) of the parent specification; and (ii) Mandatory Divisional Application with a view to meet/remedy non-unity objection of the Learned Controller/Examiner against the claimed matters of the "parent" specification. He cited Luk Lamellan (supra) pages 112 and 114. Also, as said before he relied on a publication of a notice from EPO.

15. In support of his interpretation of Section 16 he cited certain authorities of the Honorable Supreme Court.

16. I agree with Sri Chakraborti that section 16 of the Act provides two ways for filing Divisional applications (i) voluntary and (ii) mandatory, but I do not agree

with him that such voluntary application is permissible even when the parent application does not consist of any plurality of distinct inventions or inventive concepts. In an application for patent of M/s DE BEERS INDUSTRIAL DIAMOND DIVISION (PROPRIETARY) Limited, 259/DEL/2005, Assistant Controller of Patents and Designs explained the scope of filing divisional applications in his decision under Section 77(f) and (g).

17. "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 claim 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 the 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 [4<sup>th</sup> 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". [Paragraph 8 of the decision] [available at [https://124.124.220.66/patentdecisionsearch/display\\_uploaded.asp?application\\_number=259-DEL-2005-12](https://124.124.220.66/patentdecisionsearch/display_uploaded.asp?application_number=259-DEL-2005-12)]

18. "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 then one invention (plurality of distinct invention) in the earlier application is not essential". [Paragraph 9 of the decision]
19. "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". [paragraph 7 of the decision]
20. In nut shell, there is no dispute that a divisional application can be filed by the applicant on his own accord, but such an application cannot be entertained as a divisional application if there is no distinctness of inventive concepts embedded in the parent application. Also, when such application is filed by the applicant on his own accord, the Office is bound to see whether the condition of plurality is

satisfied or not. Therefore, I agree with the examiner's objection and disagree with the reading of Section 16 by the Learned Agent.

21. The Learned Agent has cited *Manik Lal Majumdar & Ors. Vs Gouranga Chandra Dey & Ors.*, AIR (2005), SC 1090, in connection with the interpretation of statute. "It is a well-settled principle 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, **at what precedes and what succeeds and not merely the clause itself.** [Emphasis added]. The court must ascertain the intention of the legislature by directing its attention not merely to the clauses to be construed, but to the entire statute; it must compare the clause with the other parts of the law and the setting in which the clause to be interpreted occurs (see *State of West Bengal vs. Union of India*, AIR (1963), SC 1241 and *R.S. Raghunath vs. State of Karnataka*, AIR (1992), SC 81)". In my opinion however, the interpretation of Section 16(1) by the Learned Agent is not in line with the principle as laid down in the judgment of Honorable Supreme Court. It appears to me that the interpretation has not taken care of the statute as a whole, and the clause itself has been merely looked into without looking at **what precedes and what succeeds** [Emphasis added]. Section 16(1) appears to have been taken in clinical isolation from other provisions of the Act, but while doing so the true spirit of the statute has not been taken into account and that interpretation has been preferred which is inconsistent with the smooth working of the system. In *Bihar State Council of Ayurvedic and Unani Medicine vs. State of Bihar*, AIR (2008), SC 595 (cited by Learned Agent) the Honorable Supreme Court laid down the following principle: "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". The proposed interpretation introduces an uncertainty, friction or confusion into the working of the system. I would prefer to look into Section 16 from the perspective of other relevant provisions of the Act.

22. Sub-section 1 of Section 7 prescribes that every application for a patent shall be for one invention only. Section 10 stipulates the content of the specification and sub-section (5) of Section 10, requires 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.
23. These two sections, in my understanding provide the pedestal of divisional applications. An application for a patent must not contain more than one invention which is not linked with a common inventive concept. If there is any distinctness that provides the cause of dividing the application for patent.
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) reveals that this heading implies that even if the applicant files an application suo moto which is purportedly an application divided 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.
25. The next question that I would like to ask is whether such a reading of Section 16(1) as proposed by the Learned Agent, creates an **inconsistency or uncertainty and friction in the system.**
26. The Learned Agent has proposed that a divisional application may be filed even when there is no question of more that 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.” At the first place I would like to say that I have no disagreement with the agent regarding such splitting of this sub-section, but I do not accept that the phrase “if he so desires” is totally unconditional, not related with what precedes and what succeeds and endows the applicant an uncontrolled authority to file a purported divisional application at any time and under any situation. I agree that if the applicant finds a plurality of distinct inventions certainly he can split the application of his own and file a divisional application. Instead I believe that the true construction of section 16 should be as follows:

“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,... .... 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”.

or

“A person who has made an application for a patent under this act may, at any time before the grant of patent, ..... 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”.

27. He proposes 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. If this proposition is accepted this may lead to some situations which do not agree with the spirit of the law:

1. The applicant files the parent application and then divides the same to file a divisional application with the same or substantially same set of claims consisting of same single inventive concept and both applications are allowed to proceed.
2. The divisional application has been filed with the same or substantially same set of claims consisting of same single inventive concept and the parent application has been abandoned or withdrawn after the filing of the divisional application.

28. A divisional application is antedated to the date of filing of the parent application. If antedated, the subsequent application can not be questioned on the ground of novelty and lack of inventive step. Situation 1 clearly leads to an absurdity and inconformity with the system in so far as that it conflicts with Section 7(1) and two applications will finally be accorded two patents on same invention. Therefore, the first situation itself stands contrary to the Section 7(1) and should not be allowed by the Controller.

29. In the Second situation (like in the present case) the system suffers from the absurdity and uncertainty for several reasons. At the first place, the filing of divisional application with the same or substantially same set of claims takes place before the withdrawing or abandoning of the parent application. That means two applications with the same or substantially same set of claims filed by the same applicant co-exist at least for time being, which is not a rational act of an applicant and violates the mandate of Section 7 at least for time being. Before we

discuss other consequences let us look at other provisions of the statute. After an application for patent is filed it is published in the Official journal of the Patent Office after 18 months from its date of priority or within one month at the option of the applicant. Once the application is published subject to the filing of the request for examination the application is referred to an examiner (section 12) for making search for novelty, inventive step and other requirements of the Act. The applicant has to comply with the requirements of the Office within one year from the date of First Examination Report (FER). However, if the applicant does not comply with the Office requirement and does not return the documents sent with the FER, the application shall be deemed to be treated as abandoned (section 21). If the documents are resubmitted but if the objections are still outstanding the Controller has to offer the applicant an opportunity of being heard and he may either refuse the application or may require such amendments as he deem fit (section 15). If the application is found in order, a patent shall be issued. The patent confers an exclusive right on the patentee to exclude others from the act of making, using, offering for sale, selling or importing for those purposes that product in India. Section 53 awards a 20 years monopoly to a patentee from the date of filing of application and the patentee can bring an infringement action against the manufacturers from the date of publication of the patent. A patent terminates after 20 years naturally or before 20 years for the non-payment of renewal fee or if it is revoked by the Controller or by the Court.

30. Regarding what is patent, P Narayanan observes "A patent is a monopoly right granted to a person who has invented a new and useful article or an improvement of an existing article or a new process of making an article. It consists of an exclusive right to manufacture the new article invented or manufacture of an article according to the invented process for a limited period. During the term of the patent the owner of the patent, i.e. the patentee can prevent any other person from using the patented invention. After the expiry of the duration of the patent anybody can make use of the invention". [ Patent Law, P.Narayanan, Fourth edition, Eastern Law House, Page 1]



31. Also the England and Welch Court of Appeal says “The patent system is there to provide a research and investment incentive but it has a price. That price (what economists call “transaction costs”) is paid in a host of ways: the costs of patenting, **the impediment to competition**, and the **compliance cost of ensuring non-infringement**, **the cost of uncertainty**, litigation costs and so on”. [Aerotel Ltd vs Telco Holdings Ltd and Macrosan’s application; Neutral Citation Number: [2006] EWCA Civ 1371 at paragraph 20] [Emphasis added]

32. Section 83 of the Act stipulates the general principles applicable to working of patented inventions ;

**83. General principles applicable 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 of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.

[Emphasis added]

33. As discussed before a situation arises (as it arises here) where the FER has been sent to the applicant and the applicant instead of returning the documents within 12 months from FER, choose to file a divisional application and then abandon the parent application even when there is no plurality of distinct inventions. That means that the Office has to further examine the case, further send the FER and do all the needful. The net effect of this action of the applicant will allow him to enlarge the time limit beyond the statutory period of one year given to him under section 21(1) to comply with the requirements of the Office. This process may be repeated and thus a total uncertainty may be created in respect of the grant or refusal of the application. This action of the applicant **creates hardship and**

**serious inconvenience to the public at large** because the public will not be able to guess as to when the matter shall be granted and refused. This is clearly not the intent of statute as it creates an **impediment to competition by creating uncertainty in respect of the access to the technology** [Aerotel, supra] and is **not advantageous from the point of view of users of the technology** [Section 83(c), supra]. “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 that result 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”. [Bhatia International vs. Bulk Trading S.A., AIR (2002), SC 1432] [Cited by the applicant]. Also, it frustrates the system in that it goes against the basic principles of the statute that if a patent is not granted on an invention that invention becomes the public property [Narayanan, page 1, supra]. Therefore I feel that the interpretation offered by the Learned Agent of the phrase “if he so desires” is not acceptable because the interpretation is against the scheme of the Patents Act. [emphases added].

34. The Learned Agent has referred to the judgment of Cable Corporation of India Limited Vs. Commissioner of Labour, AIR (2008), SC 2386. It has been held by the Hon'ble Supreme Court of India that 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”. With this citation he emphasizes that the word “or” used in Section 16(1) ought to be construed disjunctive, and there is no scope to construe the said word “OR” as “conjunctive, because, the preceding words “if he so desires” cannot be construed to mean that the applicant will suo moto file a “divisional” application, IF HE FINDS/THINKS HIMSELF THAT THE CLAIMS OF THE “PARENT” APPLICATION INVOLVE MORE THAN ONE INVENTION. Such

construction/ interpretation could be possible if the word “or” would not have been there between “, if he so desires,” and “with a view to remedy .....” in Section 16(1) of the Act.

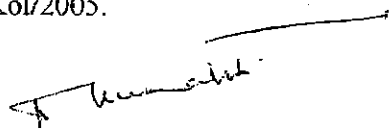
35. I reiterate that I do not agree with the Learned Agent that the phrase “if he so desires” gives him an unconditional freedom to file a divisional application even when that act would lead to a situation of absurdity and creates a friction with the other preceding and succeeding provisions of the Act. In my opinion this is not a correct interpretation and construction and “if he so desires” is contingent upon the condition of “one application for patent is for one invention” only as laid down in Section 7.
36. In my understanding the first part of section 16(1) simply says that a divisional application can be filed when the applicant finds that there is distinctness in the parent application. This may arise when the corresponding application is prosecuted in foreign jurisdiction, e.g., through PCT. Also, it may happen when the applicant himself finds this anomaly on his own accord. The other part of this section mandates the Controller to divide the application when distinctness is detected in the parent application.
37. The Learned Agent has further cited [State of H.P. vs. Surinder Singh Banolta, AIR (2007), SC 903] “Literary construction giving rise to anomalous or absurd situation where two parallel proceedings may continue at the same time and two tribunals may render contradictory decisions on the same question – Held, such construction should be avoided. In case of obscurity statute should be read in the light of the constitutional scheme - Doctrine of purposive construction should also be applied”. In the same judgment the Honourable Supreme Court held “It is well-settled that the entire statute must be read as a whole. The relevant provisions of the constitution as also those in the statute must, thus, be read harmoniously”. It appears to me that the pronouncement of the Honourable Court is in the context of the interpretation of a statute vis-à-vis the Constitution of India. The present citation, in my understanding is not applicable in the present context.

38. The Learned Agent has cited a decision of the UK Court wherefrom he has tried to establish that in UK divisional application can be filed by the applicant suo moto. Similarly by the EPO paper as cited he tried to establish that in EPO also there is provision for filing divisional application suo moto. I have already said that there is no dispute with his submission that he can file the application suo moto, but this is not established that such action is permissible in foreign jurisdiction even when there is no question of distinctness.

39. Considering all these factors I decide that the application (LG2) does not deserve the merit of a divisional application. As LG2 does not get the divisional status the invention as claimed in LG2 is anticipated by LG1.

40. I therefore refuse the application for patent 1191/Kol/2005.

Dated: 10<sup>th</sup> of August 2009

  
(DR. A. CHAKRABORTI)

ASSISTANT CONTROLLER OF PATENTS & DESIGNS

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