

INTELLECTUAL PROPERTY APPELLATE BOARD

Guna Complex, Annexe-I, 2nd Floor, 443, Anna Salai,
Teynampet, Chennai – 600 018

(CIRCUIT BENCH SITTING AT DELHI)

OA/17/2009/PT/DEL

TUESDAY THIS, THE 29th DAY OF JANUARY, 2013

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

SYGENTA PARTICIPATIONS AG -- Appellants
OF SCHWARZWALDALLEE 215
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Address for service in India

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(By Advocates: Shri Sanjay Jain - Senior Counsel, Shri Shukhdev Khuraijam, Ms. Ranjana Mehta Dutt,
Shri Debashish Banerjee, Ms. Ruchi Jain, Shri Vikram Grover, Shri Mahir Malhotra, and Ms. Namisha
Gupta)

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. 19 of 2013)

HON'BLE SMT. JUSTICE PRABHA SRIDEVAN, CHAIRMAN

The appellants' divisional application was dismissed on the ground that it has not been filed in accordance with the provisions of the Patents Act, 1970. This appeal is against that order.

2. The invention related to 'Microbicide', a fungicidal two component composition based on

metalaxyl and a method of controlling and preventing fungal infestation plants. Claim 1 related to the composition claim 2 to 5 were dependent. Claim 6 was for the method and the other dependent claim 1 to 5 and 13 were objected and not allowable. The divisional application was called a fungicidal composition and specifications are the same as in parent application. Here Claim 1 is a combination of (original) claims 1 and 2. Claim 2 to 5 are really the original claims 3, 4, 5 and 13.

3. We have already decided in two earlier cases that there cannot be any divisional application unless there is a plurality of inventions. Yet the learned Senior counsel Shri Sanjay Jain appearing for the appellant requested us to hear him since there may be certain legal issues that have not been covered in the earlier cases and also since this issue will have a very wide impact on many similar applications. In OA/18/2009/PT/DEL – Order No. 243 of 2012 -- Bayer Animal Health GMBH, Germany Vs. Union of India, the Intellectual Property Appellate Board (IPAB) had held that unless there is a plurality of inventions, there can be no divisional application. We held that S. 16 entitles the applicant to file such an application if he desires to remedy the objection that the claims relate to more than one invention or to file a further application in respect of an invention disclosed in the application already filed. The Act does not empower or give any patent applicant the right to resubmit the same application as a divisional application. We had earlier held in an another case OA/6/2010/PT/KOL – Order No. 111 of 2011 -- LG ELECTRONICS, INC, Republic of Korea Vs. The Controller of Patents and Designs, Kolkata and others this same issue was raised and it was contended that the clause “if he so desires” gave the person who has made a patent application the unconditional freedom to file a divisional application even when there is no plurality of invention. In the above case we held that *“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." We also held that "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."*

4. So we have earlier held that a divisional application can be filed only when there are more than one distinct invention. The learned Senior counsel submitted that prior to the amendment of the Act, this application for a product patent could not have been filed. The Government allowed the Ordinance to lapse, had it not done so then the application would have been intact when the "black box was opened". The learned senior counsel submitted that the doctrine of legitimate expectation would arise and also principle of promissory estoppel. According to the Learned Senior Counsel, Government should have protected cases such as the one on hand. The Learned Senior Counsel submitted that the appellant could not have applied for a patent as in this case, prior to 01/01/1995. The Controller of Patents should not have taken up this application and ought to have examined it only after 01/01/2005. The Learned Senior Counsel submitted that S. 16 does not use the word "divisional application" and S. 16 also should be read in a manner as to allow the inventor to re-submit the application and it was only where division application was filed at the instance of the Controller that plurality of invention was a must.

5. The learned senior counsel gave a chronological list of relevant dates. India become a member of WTO on April 15, 1994. Between January 1, 1995 to March 25, 1995 the Patents Amendment Ordinance 1994 was enforced, which enabled filing and handling applications under Article 70.8 of

TRIPS. The Ordinance lapsed on March 26, 1995. The Amendment Bill was introduced but it lapsed on March 10, 1996 with the dissolution of the Tenth Lok Sabha. United States of America filed a complaint before the Dispute Settlement Body (DSB) of the WTO against India for not providing patent protection for pharmaceutical and agricultural chemical products in India. On February 5, 1997 the appellant filed parent application (304/DEL/97). On April 22, 1998 India undertook to comply with the recommendations of the DSB within the implementation period. On March 26, 1999 The Patents Act, 1970 was amended retrospectively from January 01, 1995. The amendment incorporated Section 5(2) in the Act in respect of mail box / black box applications. On April 16, 2001, the First Examination Report was issued on the parent application. The Patents (Amendment) Act, 2002 notification in the Gazette of India was on June 25, 2002. On July 16, 2002 the divisional application was filed while the parent application was still pending. On January 1, 2005 product patent was allowed in all fields of technology. On May 3, 2005 and July 18, 2006, the Controller General issued two clarificatory notifications which we will deal with later. On April 25, 2008, the First Examination Report was issued for the divisional application No. 748/DEL/2002. The Patent Office maintained the invalidity of the divisional application and gave an opportunity of hearing the appellant after which the impugned order was passed.

6. The learned senior counsel submitted that the appellants' conduct cannot be faulted. If the patent has been granted for the further application of the same claims though the appellant had not withdrawn the parent application then the question of conduct will come into play. In the present case, parallel patenting could not arise. The appellant will not obtain extension of life of the patent since the priority date and the expiry date are fixed.

7. The learned senior counsel submitted that the words "if he so desires" would imply reasons unforeseen. The learned senior counsel referred to (1) AIR 1966 Supreme Court 882 (V 53 C 166) – Mongibai Hariram and another Vs. The State of Maharashtra and another; (2) MANU/MP/0432/1992 – Govindarao and Others Vs. Bhavarlal and Others.

8. The learned senior counsel read out the relevant paragraphs from the Paris Convention for the Protection of Industry Property.

9. Article 4.G of the Paris Convention for the Protection of Industry Property reads as follows:-

(1) If the examination reveals that an application for a parent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the

benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorised.

10. Section 16 deals with the power of the Controller to make orders respecting division of application. Section 16 reads as follows:-

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 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.

[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.]

11. The Controller has the power to make his orders in two situations. One, when the applicant desires it on his own and two, when the Controller raises an objection and the applicant seeks to remedy it. The word "Patent" means a patent for any invention granted under the Patents Act, 1970 (S. 2(m) of the Act). A patent shall be granted for one invention only (S. 46(2) of the Act). Therefore, if there is a parent application, as in this case, and there is a divisional application, and both the parent

application and the divisional application are accepted by the Patent Office and patents are granted, it logically means that one invention is protected by the parent application and one invention is protected by the divisional application. Without straining the simple language of the Act, without looking for any interpretative aids, it means just this that the applicant claims a patent for one invention under the parent applicant and for one invention under the division application. It cannot be otherwise.

12. In this particular case, the appellant had withdrawn the parent application and therefore if he had succeeded there would have been only one grant. We cannot construe the section keeping the appellants case alone in mind. We have to see what the section means and how it has to be applied in all cases. The section says that the applicant can at any time before the grant of patent on his own or set right the Controller's objections that the claims relate to more than one invention file further application. This further application is in respect of an invention disclosed in the already filed application. According to the appellant, the words indicating plurality of invention will govern only the Controller's objection and not *suo moto* applications. According to him, the words "at any time if he so desires" is one situation and the words beginning with "relate to more than one invention" is the alternative situation and they are distinctive. If the Law was meant to enable the applicant to file consecutive applications for the same invention, then the Law would have used the words "further application in respect of the invention" but it uses the words "an invention".

13. In AIR 2001 SC 1161 -- Shri Ishar Alloys Steels Ltd., Vs. Jayaswals NECO Ltd., the Hon'ble Supreme Court held that while considering the provisions of S. 138 of the Negotiable Instruments Act that the use of the words "a bank" and "the bank" indicates intention of the legislature that "one is the indefinite article and the other is definite article". If you examine the various provisions of Chapter IV which relates to examination of applications, we see that in S. 30, the Examiner will ascertain whether "***the invention***" is anticipated again S. 18, which deals with the powers of the Controller with case of anticipation the words used are "the invention". In S. 19, which deals with Powers of Controller in case of potential infringement, the words used are "an invention in respect of which an application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public, unless within such time as may be prescribed."

14. Therefore, though the last mentioned section uses the word "an", the indirect article, the following words indicate that the reference is to the invention for which patent has been applied for. When you contrast with this, with S. 16, it is clear especially since the words "an invention" is preceded by words which indicate plurality of inventions, the Legislature clearly intended that the further application is for

one of the inventions disclosed in the first mentioned application.

15. In 1970WLN436, the Hon'ble Rajasthan High Court held that phrases should be interpreted according to their grammatical meaning unless it leads to absurdity. In that case, the provision of the Bye-laws made by Nasirabad Cantonment Board where the words used were “within 100 yards of a public building having a thatched roof and if a portion of the place does not lie within 100 yards of such building the prohibition will not apply to that part of the place.” Here it was contented that the words having “thatched roof” qualify only the word “buildings” and the words “public buildings”. This was accepted because the Court said that provision was made for two types of buildings. This does not help the appellant because if we have to accept his case, then it would mean that a person can file two applications, one with the parent application and other with further application in respect of a single invention. This would be an absurdity and cannot be accepted.

16. Next, we refer to AIR 1963 Supreme Court 1464 (V 50 C 213) – K.S. Ramamurthy Reddiar Vs. Chief Commissioner, Pondicherry and another. Here the question was whether words in Article 12 of the Constitution under the control of Government of India qualify “authorities” and not the words “territory”.

17. AIR 1966 Supreme Court 882 (V 53 C 166) – Mongibai Hariram and another Vs. The State of Maharashtra and another. This relates to the Bombay Land Requisition Act (33 of 1948).

18. The Hon'ble Madhya Pradesh High Court Judgement in Govindarao and Others Vs. Bhavarlal and Others (MANU/MP/0432/1992) deals with the interpretation of the words “a member of the family” in the Accommodation Control Act, 1961. Here, the Court considered the culture of joint families in India and held that the persons in one category who are naturally supposed to live together in one family and then brother's son or unmarried daughter and the term any other person “dependent on him” shall be applicable in the case of only any other relations. The court has further held that interpretation of any term should be made in the context in which it is used should be consistent with the policy of Legislature.

19. This in fact should be the spirit of interpretation of any Act. One should understand the main context of the Act and here the Patents Act, 1970 governs the Law relating to patents and every patent is for one invention only. This cannot be given a go by while interpreting any of the provisions. The appellant has enclosed several documents in the paper book. One of them is the report of Panel of Dispute Settlement Body (DSB). It says “The Indian executive authorities decided, in April 1995, to instruct the patent offices in India to continue to receive patent applications for pharmaceutical and

agricultural chemical products and to store them separately for processing as and when the change in the Indian patent law to make such subject matter patentable would take effect. No record of this decision or of any administrative guidelines issued to or within the patent offices of India to this effect was made available to the Panel.” The First Examination Report for the parent application does not indicate any plurality of invention.

20. Now we come to the two notifications. In our order in Bayer Animal Health GMBH, Germany Vs. Union of India and others OA/18/2009/PT/DEL (Order No. 243 of 2012) we have already referred to the two notifications and we have observed,

“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.”

21. It is not the case of the appellant that his original specifications and claims refer to plurality of applications. This is seen from the letter written by the Learned Counsel for the appellant to the Controller General of Patents. We extract the relevant paragraphs:-

“In this regard, it is submitted that question of the subject divisional application comprising distinct subject matter over the parent application for the present application to be considered a valid division does not arise as the parent application was not pursued and allowed to become abandoned.”

“Therefore, under Section 16(1) of the Act, an applicant may file a divisional application under

two conditions namely, (1) If he so desires (*suo-moto*) or (2) In case of plurality of inventions.

22. In the present case, the appellant seems to plead that even if there are no plurality of inventions, he could if he chooses to file what is called a divisional application provided it is done before the grant or abandonment of the parent application and it satisfies the requirements of non-inclusion of matters not disclosed in the parent application and absence of double patenting. While all the other criteria may have been met, the basis on which division is granted is itself plurality of invention alone and by passing that criterion, no division can be granted. Here, the word "division" cannot mean split one invention into splinters, it can only mean splitting one application into more than one so that each application is for a separate invention. That is how the word "division" can be understood.

23. In view of the reasons stated above, the appeal is dismissed. No costs.

(S. USHA)
Vice-Chairman

(JUSTICE PRABHA SRIDEVAN)
Chairman

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