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Unravelling the divisional conundrum:
present imperfect and future tense

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Unravelling the divisional conundrum: present imperfect and future tense

By Shukadev Khurajam and Debashish Banerjee, Remfry & Sagar

This chapter explores how the law and jurisprudence pertaining to divisional applications in India have evolved and whether existing interpretations do justice to statutory provisions.

The concept of divisional applications for patent applications may be traced back to Article 4G of the Paris Convention for the Protection of Industrial Property 1883. As the seminal provision, the language of this article assumes great significance for understanding divisional applications in general. Article 4G(1) provides a mechanism for dividing a patent application, which on examination reveals more than one invention, into one or more further applications. Article 4G(2) envisages a divisional application at the applicant's initiative, empowering each signatory country to determine the conditions under which voluntary divisional applications may be filed.

Statutory evolution

To provide sufficient background, a study of the evolution of the law in relation to divisional applications in India over the past century is helpful. Interestingly, the Patents and Designs Act 1911 contained no provision to facilitate the filing of divisional applications. Section 5(1)(b) of the 1911 act empowered a controller to refuse a patent application *in toto* or call on the applicant to delete the distinct inventions if a patent application comprised multiple inventions. There was no mechanism in the 1911 act for filing a further application to protect the scope of an invention disclosed in the specification, but not claimed in the first application.

This inadequacy was rectified by the promulgation of the Patents and Designs

(Amendment) Act 1930, which enshrined the principle of Article 4G(1) of the Paris Convention by introducing divisional patent applications into the Indian patent framework. Amended Section 5(1)(f) of the 1911 act stipulated that “when a specification comprises more than one invention, the application shall, if the Controller or the applicant so requires, be restricted to one invention and the other inventions may be made the subject-matter of fresh applications; and any such fresh application shall be proceeded with as a substantive application”. However, the category of voluntary divisional applications envisaged under Article 4G(2) of the Paris Convention was still conspicuous by its absence.

In 1957 the government appointed a committee headed by Justice N Rajagopala Ayyengar to review the patent laws and suggest any changes that may be required. The committee submitted its report in 1959 and suggested several amendments to the law, including amendments to the provisions on divisional applications. The report took the view that “the applicant would naturally be desirous of covering his invention which is disclosed in the specification already filed but which is excluded from the earlier complete specification, by filing a further application”. Due to administrative and political hindrances, the committee's recommendations saw the light of day only much later, when in 1970 a revamped patent statute came into force as the Patents Act 1970.

The provision pertaining to divisional applications was significantly revised in the 1970 act. Under Section 5(1)(f) of the 1930 amendment act, the phrase “the applicant so requires” was qualified by the precondition that a divisional application can be filed “when a specification

comprises more than one invention". On the contrary, in the 1970 act the phrase "if he so desires" was not qualified with the expression "the claims of the complete specification relate to more than one invention". On contra-distinguishing the 1970 amendment from the earlier act, it is evident that it provided leeway for filing a voluntary divisional application as expounded in Article 4G(2) of the Paris Convention, which was not available under the 1911 act.

In principle, the Patents Amendment Act 2005 retained the essence of the 1970 statutory provision on divisional applications. By virtue of this amendment, Section 16 is now the operative provision governing divisional applications in India. It states:

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 provision 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 16(1) envisages that an applicant may file a divisional application at any time before the grant of a parent application if it so desires or may file a divisional application in order to meet an objection raised by the controller on the grounds that the application contains more than one invention. Section 16(2) requires that the divisional application not include any matter which was not disclosed in substance in the parent application. Section 16(3) stipulates that there must be no overlap in the scope of the claims of the parent and divisional application and empowers the controller to call on the applicant to amend the claims to ensure as such.

Examining jurisprudence

Prevailing jurisprudence on this important issue has largely been steered by the 2011 decision of the IP Appellate Board (IPAB) in *LG Electronics Inc v Controller of Patents & Designs* (OA/6/2010/PT/KOL). This decision radically changed divisional application practice in India by holding that the existence of a plurality of distinct inventions is a *sine qua non* for grant of divisional status. The IPAB held that while a patent applicant may file a divisional application of its own volition, the controller is mandated by law to ascertain that the divisional application is filed on account of a plurality of distinct inventions in the parent application. In other words, the "or" in Section 16(1) after the expression "if he so desires" is used conjunctively, not disjunctively.

The facts of *LG* were such that a divisional application was filed with the same set of claims as that of the parent application and the parent application was ultimately abandoned. Further, the claims did not disclose a plurality of inventions. The IPAB thus refused the validity of the divisional application and reasoned that the intention of the legislature could not have been to allow an applicant to extend the time limit for prosecuting a patent by abandoning an application and filing a divisional application for the same claim scope. Most importantly – and perhaps unwittingly so – the IPAB read Section 16 with Section 10(5) of the Indian patent statute (dealing with contents of a patent specification), which stipulates that "claims or claims of a complete specification shall relate to a single invention or

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"An applicant may file a divisional application at any time before the grant of a parent application if it so desires or may file a divisional application in order to meet an objection raised by the controller on the grounds that the application contains more than one invention"

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to a group of inventions linked so as to form a single inventive concept". This led to the present restriction of the existence of a plurality of distinct inventions being a *sine qua non* for grant of valid divisional status.

The IPAB's interpretation of Section 16(1) in *LG* did not take into account the various changes in the law with respect to this issue – from the 1911 act (as amended in 1930) to the language of the 1970 act (as amended in 2005) and pertinent developments such as the 1959 Ayyengar Committee Report, the 1966 Joint Parliamentary Committee Report and parliamentary debates which took place before the passage of the Patents Bill in 1970.

The outright view as espoused by the applicant in *LG* was that the law has provided the right to file a voluntary divisional application, which is

completely without bounds as it arguably would make no logical sense to allow an applicant to file a divisional application only to be denied a patent later on. Another view is that the interests of justice would have been better served had the IPAB adopted a median approach by ruling that the disclosure of a plurality of inventions (and not a plurality of distinct inventions) is the essential prerequisite for a valid divisional status. The language of Section 16(1) of the patent statute reflects Article 4G of the Paris Convention, as it does not specify the existence of non-unity of invention as a prerequisite for the validity of a divisional application. If disclosure of only a plurality of inventions (and not a plurality of distinct inventions) were the requirement, there would be harmony with a divisional application claiming a different invention and no unreasonable

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fetter on the applicant’s desire to file divisional applications voluntarily where there is more than one invention.

The language of Section 10(5), when read in the context of the divisional provision, essentially embodies Rule 13.1 of the Patent Cooperation Treaty Regulations. However, it is noteworthy that laws in other jurisdictions (including the United Kingdom and Australia, whose patent statutes were greatly relied on by the Ayyengar Committee) do not restrictively read the requirement of a plurality of distinct inventions as a prerequisite for filing a valid divisional application. Voluntary divisional applications in these jurisdictions are considered valid, as long as the subject matter is disclosed in the parent application. The IPAB’s interpretation therefore appears to be an overreach, which was not the intention of the legislature.

In deciphering why this legal conundrum occurred, it can be seen that the premise of *LG* was not the best one for laying down divisional jurisprudence, as there was no plurality of inventions in the application and the divisional application was in essence a mere refiling of the parent application, which led to the IPAB’s sweeping and unbridled judgment. Unfortunately, the reasoning of *LG* has been reaffirmed by the IPAB in subsequent matters – in particular, *Bayer Animal Health GmbH v Union of India* (OA/18/2009/PT/DEL) and *Syngenta Participations AG v Union of India* (OA/17/2009/PT/DEL), where again the facts were unfavourable for the applicants to challenge the earlier reasoning, as these cases also dealt with parent applications that were not pursued. In the IPAB’s defence, it may be said that the median approach mentioned above could not have been taken practically, as there was no plurality of inventions in these applications. Therefore, both a wrong premise and a lack of a fertile premise thus far seem to be why the jurisprudence is at

its current position. Unsurprisingly, the Indian Patent Office has embraced the reasoning of *LG* to the letter and in spirit due to the present circumstances.

The way forward

However, on a different aspect of the divisional issue, the IPAB provided much-needed clarity on divisional application practice in *Syntonix Pharmaceuticals, Inc v Controller General of Patents & Designs* (OA/26/2013/PT/KOL) by holding that if a divisional application is filed on the basis of a lack of unity objection raised in the parent application, the controller cannot directly refuse the divisional application by adopting the position that its earlier opinion on lack of unity of invention in the parent application was erroneous. In this case, the IPAB held that even if the validity of such divisional application is questioned, the applicant should be afforded an opportunity to amend the claims of the divisional application.

Syntonix was the bedrock on which another element of divisional applications – that of the validity of “divisional applications derived out of another divisional application” (so-called ‘grandchild’ applications) was decided. In *National Institute of Immunology v Assistant Controller of Patents & Designs* (OA/21/2011/PT/DEL) the IPAB unequivocally held that a divisional application filed out of another divisional application was valid, provided that the progeny divisional application was filed before the grant of its immediate predecessor application and there was a plurality of inventions in the latter.

In what could be a step in the right direction, the IPAB recently held in *Milliken & Company v Union of India* (OA/61/2012/PT/MUM) that the applicant’s second divisional application, which was filed voluntarily without receiving an objection of lack of unity in the first divisional application, was valid. In this case, the applicant had filed a request for voluntary amendment of

claims for adding new claims during prosecution of the first divisional application. The Patent Office disallowed the request. In the absence of any other efficacious remedy to pursue the scope of the disallowed claims, the applicant filed a second divisional application to protect the scope of these claims. The IPAB upheld the validity of the voluntary second divisional application, thus supporting a broader interpretation of Section 16 that envisions allowing patent protection for multiple inventions that may not necessarily be distinct from one another.

It is hoped that *Milliken* is an indication of a more liberal interpretation of Section 16 in future. At present, there is a clear dichotomy between the letter and spirit of the statute pertaining to divisional applications and the jurisprudence laid down by the Indian Patent Office and the IPAB. While the decisions of the Indian Patent Office and the IPAB clearly specify their intent behind the restrictive interpretation of Section 16(1), the deeper question is whether the current interpretation is correct, keeping in mind the intent of the legislature as reflected in successive, progressive amendments to Indian patent law.

In an interesting parallel, in a series of recent judgments the Delhi High Court read down another statutory provision that has long been a thorn in the side of patent applicants – the duty of

disclosure (of details of all corresponding patent applications filed abroad) under Section 8 of the Patents Act, which until recently was interpreted strictly by the IPAB. It is hoped that the day will come soon when a fitting case involving divisional applications will reach the high courts, allowing jurisprudence on the subject to be revisited and statutory provisions to be interpreted in a manner suited to the true intent behind their promulgation. **iam**



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