

**BEFORE CONTROLLER OF PATENTS
THE PATENT OFFICE, DELHI**

THE PATENTS ACT 1970
(Section 15)

In the matter of divisional application
No.1427/DEL/1999 (parent
application no. 371/DEL/1997) dated
28th October 1999 filed by M/S
BAYER AKTIENGESELLSCHAFT, D-
51368 LEVERKUSEN, GERMANY

Hearing held on 17th November 2008 at 11:30 A.M.

Present:

1. Ms. Neha Srivastava ----- Agent representing the applicant
2. Dr.Rohit Rathore ----- Examiner of Patents & Designs

O R D E R

M/s Bayer Aktiengesellschaft, D-51368 Leverkusen, Germany, filed their application No. 1427/DEL/1999 dated 28th October 1999 through M/s Remfry & Sagar, the agents for the Applicants for their invention related to "Optionally Substituted 8-Cyano-1-Cyclopropyl-7-[2,8-Diazabicyclo] [4.3.0] Nonan-8-Yl] -6- Fluoro-1,4 Dihydro-4-Oxo-3- Quinolinecarboxylic Acids And Their Derivatives" which is a divisional application out of patent application No. 371/DEL/1997 dated 14th February, 1997.

2. The parent (the first mentioned application) application 2650/DEL/1998 out of which the instant application has been divided out, was claiming "Optionally Substituted 8-Cyano-1-Cyclopropyl-7-[2,8-Diazabicyclo] [4.3.0] Nonan-8-Yl] -6- Fluoro-1,4 Dihydro-4-Oxo-3- Quinolinecarboxylic Acids And their derivatives". This application was examined by the Office and First Examination Report thereof was issued on 2nd July 1999.

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 pharmaceutical product or chemical product 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 deemed to have been abandoned u/s 21(1) of the Act for not complying with the said requirements. It was also noted the said application was not filed as WTO application u/s 5 of the then Patents Act, 1970.

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 (the first mentioned application) 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 “Optionally Substituted 8-Cyano-1-Cyclopropyl-7-[2,8-Diazabicyclo] [4.3.0] Nonan-8-Yl] -6- Fluoro-1,4 Dihydro-4-Oxo-3- Quinolinecarboxylic Acids And Their Derivatives” This application was again examined and First Examination Report was issued on 20th September 2007. The First Examination Report contained objections including the objections that the present application is not a valid application u/s 16 as it is not complying with the requirement of section 16 and claims of the instant application also conflict with the claims of parent application No.371/Del/1997. The applicant re-filed their documents along with the submission on 8th February 2008 replying to the objections raised in the First Examination Report. In their response the applicant argued that examiner has not given a correct interpretation to the provisions of section 16 of the Act. The agent for the applicant also did not inform the Patent Office the facts that the earlier application No. 371/Del/1997 was deemed to have been abandoned u/s 21 (1) of the Act or lapsed due to not filing the response to the office action. The application was again examined and a further report containing the objections was issued vide this office letter No.1427/Del/1999/5225 dated 08.08.2008 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. In response to the above office action, the agents for the applicants vide their letter dated 18 September 2008 again resisted this

objection and reiterated that the instant divisional application has been validly filed as per the provisions of the section 16 of the Act.

4 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. The applicants requested for a hearing u/s 14 on this issue and accordingly, a hearing was held on 17^h November 2008. During hearing, the agents for the applicant reiterated the same arguments and argued that the 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.

5. 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.

6. 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.

7. 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.

8. 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.

9. 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. The applicant intentionally filed the instant application as divisional application without meeting the requirements. In the light of above circumstances, it appears that the instant application appears to have been filed in the disguise 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. Therefore, the attempt of the agent for the applicants in filing the instant application as divisional application is not to divide the subject matter of the invention on the basis of plurality of distinct invention but to revive the abandoned invention which was not protectable at that time which is also not the objective of the provisions of section 16 of the Act.

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 and therefore also refuse the instant application to proceed for grant under the Act. .

Dated, the 08th day of May, 2009

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

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