

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

THE PATENTS ACT 1970  
(Section 15)

In the matter of divisional application  
No.633/DEL/1998 (parent application  
no.880/DEL/1994) dated 12<sup>th</sup> March 1998  
filed by M/S Otsuka Pharmaceutical Factory,  
Inc and Otsuka Pharmaceutical Co Ltd.

**Hearing held on 15<sup>th</sup> October 2008**

Present in hearing:

1. Dr. Deepa K. Tiku ----- Agent representing the applicant
2. Dr.Rohit Rathore ----- Examiner of Patents & Designs

**O R D E R**

1. M/s Otsuka Pharmaceutical Factory Inc., 115, Aza-Kuguhara, Tateiwa, Myua-Cho, Naruto- Shi, Tokushima 772, Japan and Otsuka Pharmaceutical Co Ltd., 9 Kandatsukasa -Cho 2-Chome, Chiyoda-Ku, Tokyo 101, Japan filed their application No. 633/DEL/1998 on 12<sup>th</sup> March 1998 for their invention titled “A Medical Material ” which is a divisional application out of patent application No. 880/DEL/1994 dated 12<sup>th</sup> July 1994.

2. The parent application (first mentioned application) for patent No. 880/DEL/1994 out of which the instant application has been divided out was claiming both process and product claims. The claims directed towards the product were not found allowable under section 5 of the Patents Act 1970 when the said parent application was examined, consequent to this objection the agent for the applicants deleted these claims from the said application and filled a divisional application for the said deleted claims for the product. The divisional application was examined by the Patent Office and found that instant application did not qualify as divisional application as per section 16 of the Patents Act 1970 which was maintained until the last date to put the application in order for grant which was due on 13<sup>th</sup> August 2008 and therefore on the request of the agent for the applicant for being heard, a hearing was fixed on 15<sup>th</sup> October 2008.

3. Before considering the issue of divisional application let me quote the instruction No.3/2005 dated 3<sup>rd</sup> 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 Ist 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.

4. 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.

5. 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 [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.

6. 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.

7.. 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 a set of claims originally filed in the parent application and the instant divisional application are exactly same and related to product claims and not found patentable under section 5 of the Act. Further it has also been observed that, had there been the intention of the applicant to claim medical material as a product patent they would have filed the parent application as WTO application u/s 5(2) which was already introduced in 1995, under which the agent have also filed many applications using the said provisions in the past. Since the applicant choose to file the said parent application u/s 7(without mentioning as WTO application u/s 5) it cannot be presumed that the said application was filed for that purpose as the product claim was not allowed to be granted as patent upto 1<sup>st</sup> January 2005, hence the said application was restricted to the process patent. 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 file the parent application as a WTO application particularly in view of the fact that such provisions for filing WTO application under section 5 have been used by them in other applications. Therefore the attempt of the agent for the applicants in filing the instant application as divisional application is not to divide the subject matter on the basis of plurality of distinct inventions but to revive the abandoned invention which was not protectable at that time which is also not the objective of the provisions of section 16of the Patents Act, 1970.

Having considered all the circumstances, submission made by the agent for the applicant during the hearing 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 1970 and therefore also refuse the instant application to proceed for grant under the act..

Dated, the 7<sup>th</sup> day of August, 2009.

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

Copy to M/s Remfry & Sagar,  
Gurgaon.,Haryana