
(2020) 08 IPAB CK 0003

In the Intellectual Property Appellate Board

Case No : OA/6/2015/PT/MUM

Bayer Aktiengesellschaft

APPELLANT

Vs

Controller Of Patent & Designs

RESPONDENT

Date of Decision : 25-08-2020

Acts Referred:

Patents Act, 1970 — Section 3(d), 3(d),14, 15, 16, 16(1), 16(2), 16(3)

Citation : (2020) 08 IPAB CK 0003

Hon'ble Judges : Manmohan Singh, J;Dr. Onkar Nath Singh, Technical Membe

Bench : Division Bench

Advocate : Debashish Benerjee

Final Decision : Allowed

Judgement

Manmohan Singh, J

1. The present appeal has been filed against the order passed by the Respondent on 12 August, 2014 and communicated to the Appellant on 19 August, 2014 (hereinafter referred to as the 'impugned order'), whereby the appellant's application being in Indian Patent application number 507/MUM/2008 filed on 12 March, 2008 (hereinafter referred to as the 'subject application') under the patents Act, 1970 (hereinafter referred to as 'the Act') was rejected, by this order, we propose the decide the same.

2. No Counter-affidavit has been filed by the respondent who has also failed to appear before us we the appeal was follow up for hearing.

3. The brief facts of the case are as under:

i) The subject application was filed at the Mumbai Patent Office on March 12, 2008 as a divisional application out of parent application number 591/MUM/2001. The First Examination Report (hereinafter referred to as "FER") was issued in the parent application on March 13, 2007.

ii) That, in paragraph 3 of the FER of the parent application, the Respondent had

raised the following objection:

"Claims 4-6 & 7-10 appears to be independent claims should be made dependent on claim 1"

iii) The Appellant deleted claims 1-3 and elected to pursue claims 4-6 of the parent application directed towards compounds of formula (III), (IIIa) and (IIIb) in the parent application along with their processes for preparation.

iv) the Appellant filed a divisional application to pursue the scope of compounds of formula (I) based on distinct and independent claim 10 of the parent application.

v) official letter dated September 24, 2008, the Respondent communicated that the parent application was in order for grant. On September 29, 2008 a patent was granted on the parent application and allocated patent number 224084. The Respondent issued an FER in the subject divisional application on January 04, 2012. The Appellant was required to comply with the requirements raised in the FER of the subject divisional application within twelve months from the date of issuance of the FER, thus the final date for placing the subject application in order for grant was January 4, 2013;

vi) The response to the said FER was filed by the Appellant within such stipulated period, under the cover of the Appellant's letter dated August 01, 2012.

vii) Allow pursuant to filing a response to the FER, the Respondent issued a further office action (Second Examination Report) on October 22, 2012 which was dispatched from the Patent office on November 05, 2012 and received by the Appellant on November 12, 2012.

viii) On January 02, 2013, the Appellant filed a reply to the further official action. Thereafter, the Respondent issued an official letter on February 19, 2013, notifying the Appellant of the appointment of an official hearing under Section 14 of the Act on March 15, 2013. The official hearing under Section 14 of the Act was duly attended by the Appellant on March 15, 2013. The Appellant filed written submissions under the cover of its letter dated April 3, 2013.

ix) The Respondent vide impugned order communicated on August 19, 2014 (under Section 15 of the Act) refused the subject application on the ground that the claims of the subject application violates Section 3 (d) of the Act and does not constitute a valid division under Section 16 of the Act;

4. Being aggrieved by the impugned order, the Appellant has filed the present appeal.

5. It is settled position that when an independent sub-claim cannot be made dependent on the main claim, the subject matter of such claim would be distinct from the subject matter of the main claim.

6. Admittedly the claims as filed in the parent application comprised distinct

inventions. The Respondent had raised the following objection in paragraph 3 of the FER.

"Claims 4-6 & 7-10 appears to be independent claims should be made dependent on claim 1"

7. It is alleged on behalf of appellant that due to the technical scope of claims 4-6 and 7-10, it was not viable to amend these claims to make it dependent on the main claim. Therefore, the Appellant elected to pursue claims 4-6 of the parent application directed towards compounds of formula (III), (IIIa) and (IIIb) in the parent application along with their processes for preparation. Concurrently, the Appellant filed a divisional application to pursue the scope of compounds of formula (I) based on distinct and independent claim 10 of the parent application. As already mentioned when an independent sub-claim cannot be made dependent on the main claim, the subject matter of such claim would be distinct from the subject matter of the main claim.

8. The compound of formula (I), (Ia) and (Ib) as claimed in the divisional application is structurally distinct from the compound of formula (III), (IIIa) and (IIIb) granted in the parent application. The Respondent erred in not appreciating that it was technically impracticable to make compound of formula (I) dependent on the main claim of the parent application, which was directed towards compound of formula (III). The claims directed towards compound of formula (I) could not be made dependent on the claims directed towards compound of formula (III), the claims of the divisional application were distinct from the claims of the parent application.

9. By refusing the subject divisional application on the erroneous presumption that the claims of the subject divisional application are linked with the claims of the parent application under a single inventive concept. The Appellant submits that the compound of formula (I) as claimed in the subject divisional application can be prepared from compound of formula (III) claimed in the parent by first carrying out hydrolysis of compound of formula (III) and then esterifying the same but not vice versa. The compound of formula (I) cannot be considered to be an intermediate of the compound of formula (III). Accordingly, the Respondent's finding that compound of formula (III) claimed in the parent application is linked with compound of formula (I) under a single inventive concept is erroneous.

10. Paragraphs 1 and 2 of the impugned order, the Respondent has observed that "The whole specification of the present patent application and claims directed for General formula (I) and (III) isomers which pertains to obtain in its predominate CIS isomer over Trans isomers ratios along with high yield and purity.....

Therefore, the claims directed only for obtaining the high ratio of CIS isomer with high yield, in view of above findings I could not find any structural distinctiveness for filing divisional application. Hence the divisional status is not allowable."

11. The Appellant submits the subject divisional application as well as the parent rightly that parameter taken into account by the Respondent is not relevant in the context of deciding whether the claims of the subject divisional application are distinct with respect to the claims granted in the parent application. In the present case the Respondent has introduced a fresh objection during the hearing questioning the validity of the divisional application notwithstanding that the said objection was not listed in the hearing notice.

12. The Appellant submits that the stance taken by the Respondent contravenes the doctrine of *lex non cogit ad impossibilia* which stipulates that the law does not require a man to perform an impossible act. In the instant case, it was impossible for the Appellant to record the claims in the dependent format since the same was technically unfeasible. Therefore, the Appellant has been severely prejudiced by the impugned order which has refused divisional application status to the Appellant's application on the presumption that the scope of the subject matter pursued in the divisional application ought to be pursued in the present application by rewording the claims in the dependent format.

13. The requirement has not appreciate that the subject divisional application complies with all the requirements of Section 16 of the Patents Act. The Appellant submits that Section 16 of the Indian Patents Act stipulates that.

"(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 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."

14. It appears to us that the Respondent has committed a grave procedural irregularity by reintroducing the objection on the validity of the divisional application during the official hearing, without prior notice was in contravention of the directions laid down by this Hon'ble Board in the matter of *Resprotect GmbH vs. The Controller of Patents & Designs & Anr.*, OA/23/2010/PT/DEL (hereinafter referred to as 'the Resprotect Case') wherein it was clarified that,

A quasi-judicial authority is not an adversary of the patent applicant.

Therefore any objection that may arise in this regard, any prior art that will be

relied on must be made known to the applicant before the date of hearing.

15. The impugned order violates the principles of natural justice inasmuch as the Respondent refused the divisional application status under Section 16 of the Patents Act notwithstanding that such objection was not communicated in the hearing notice. The Appellant submits that the conduct of the Respondent is contrary to the directions laid down by this Board in the Resprotect Case and in the case of Otsuka Pharmaceutical Co. Ltd. Vs. The Controller General of Patents & Designs and Anr. (OA/24/2010/PT/DEL) wherein this Board has held that if the objections which are to be relied upon by the Controller are not communicated in the hearing notice, the same results in violation of principles of natural justice.

16. The Appellant has not derived any unfair advantage by filing a divisional application. On the contrary, the Appellant has only been disadvantaged in pursuing the scope of the compounds of formula (I), (Ia) and (Ib) in the divisional application as opposed to pursuing the same in the parent application since the Appellant has lost almost six and a half years in prosecution of the divisional application besides incurring additional official fees and attorney fees.

17. The Respondent ought to have considered the circumstances which necessitated the filing of the divisional application instead of refusing the application on hyper technical grounds based on a premeditated intention of refusing the subject divisional application. No mala fide/negligence could be presumed against the Appellant for filing the divisional application.

18. the Appellant was penalized for not carrying out a technically unfeasible amendment in the parent application. The Respondent has erred in refusing the subject divisional application on the ground that the scope of the subject matter pursued in the divisional application ought to have been pursued in the parent application by rewording the same in the dependent format.

19. divisional application was filed on March 12, 2008 i.e. before the date of grant of the parent application i.e. September 29, 2008. Moreover, Section 16(1) stipulates that a patent applicant may file a divisional application, if he so desires (suo motu) OR in order to meet the objection on the claims set pertaining to more than one invention. In the instant case, the divisional application has been filed suo motu AND comprises of an invention which is distinct from the invention claimed in the parent application since the compounds of Formulae (I),(Ia) and (Ib) and compounds of formulae (III), (IIIa) and (IIIb) claimed in the parent application do not come under a single inventive concept. Admittedly the claims of the subject divisional application are wholly within the scope of the invention disclosed in specification of the parent application the subject divisional application does not include any matter which was not disclosed in the parent application. Therefore, the subject divisional application also fulfills the requirements of Section 16(2) of the Indian Patents Act.

20. In addition, the subject divisional application does not include any claim which has been claimed in the parent application i.e. there is No overlap in scope

of the claims of the parent and divisional application. Therefore, the subject divisional application also fulfills the requirements of Section 16(3) of the Indian Patents Act.

21. It is wrongly held that the claimed compound of formula (I), (Ia) and (Ib) fall under the scope of Section 3 (d) of the Patents Act. When the Respondent himself acknowledged that the compound of formula (I) is prepared from compound of formula (III) claimed in the parent application by conducting hydrolysis followed by esterification. As compound of formula (III) is a novel compound, which is evidenced by grant of a parent application, compound of formula (I) cannot be considered to be a derivative/new form of a known compound.

22. The requirement for submission of efficacy data was immaterial when the Respondent acknowledges in the impugned order that formula (I) is an intermediate in the preparation of other compounds. Thus the Respondent has incorrectly held that the subject matter of the claims fall under the scope of Section 3 (d) of the Act without considering the efficacy data submitted during the official hearing and under cover of its letter dated April 07, 2013. Infact the compounds of formulae (I), (I-a) and (I-b) claimed in the subject divisional application are novel intermediates for the preparation of plant protection products and as such does not fall within the ambit of Section 3(d) of the Act. In this regard, the Appellant submitted comparative data (without prejudice) at the official hearing and under cover of its letter dated April 07, 2013 showing that the resultant compounds which used compounds of formula (I), (I-a) and (I-b) as an intermediate showed good pesticidal and herbicidal activity when compared with closest known similar or strikingly similar compounds.

23. The comparative data clearly evidences that products with R1 = Alkoxy show a higher activity than products with R1=Alkyl. To be precise, the main structural element, the alkoxy substitution of the claimed compounds of formula (I), (I-a) and (I-b), leads to a higher activity. Apart from compounds of formula (I), the said structural element is also found in the intermediates of formula (I-a) and (I-b). Therefore, the claimed compounds of formula (I), (I-a) and (I-b) are novel intermediates and do not fall within the ambit of Section 3(d) of the Patents Act. Once it is acknowledged by the respondent itself.

24. The Respondent has failed to address the efficacy data submitted under the cover of its letter dated April 03, 2013 in the context of Section 3 (d) of the Patents Act. The impugned is completely silent on why the efficacy data submitted by the Appellant is insufficient. The valid discussion are available in the impugned order.

25. The impugned order is erroneous inasmuch as the same has been passed on the incorrect assumption made by the Respondent in paragraph 2 of the First Examination Report that the "...claims filed in this application were not objected for plurality of invention as these are intermediates to prepare formula (III)

claimed & granted in parent application (591/MUM/2001)". It is reiterated that while the compounds of formula (I), (Ia) and (Ib) are intermediate compounds, they are not the intermediate compound for preparing compounds of formula (III), (IIIa) and (IIIb).

26. The Respondent ought to have provided the opportunity to the Appellant to pursue the scope of the claims of the divisional application by filing a post-grant amendment in the parent patent, if it was of the opinion that the claims of the divisional application are linked with the claims of the parent patent under a single inventive concept.

27. Once the fact that the novelty and inventive step of the claims of the divisional application have been acknowledged by the Respondent and Section 3 (d) of the Act does not apply to the claimed subject matter of the case.

28. It is rightly alleged that the Appellant has incurred considerable expenses and has made huge investments of time and money in the Research and development of the claimed invention and therefore, should not be penalized in arbitrary manner by the Respondent.

29. In the light of above the impugned order dated 12 August, 2014 is set by allowing the appeal and we direct the Respondent to grant a patent on the subject divisional application.

30. No cost.