
(2020) 12 IPAB CK 0005

In the Intellectual Property Appellate Board

Case No : Original Application No. 8 Of 2017/PT/MUM

Exxonmobil Chemical Patents Inc.

APPELLANT

Vs

Controller Of Patents

RESPONDENT

Date of Decision : 04-12-2020

Acts Referred:

Indian Patents Act, 1970 — Section 5, 10(4), 10(5), 15, 16, 16(1), 117A

Citation : (2020) 12 IPAB CK 0005

Hon'ble Judges : Manmohan Singh, J;Dr. B.P. Singh, Technical Member

Bench : Division Bench

Advocate : Shukadev Khuraijam

Final Decision : Dismissed

Judgement

“

1. The present appeal is filed under Section 117A of the Indian Patents Act, 1970, against the order dated 09/05/2017, passed by the Respondent,,,

being the Assistant Controller of Patents & Designs, under Section 15 of the Indian Patents Act, refusing to grant the Appellantsâ?? Indian patent",,,

application no. 914/MUMNP/2008.,,,

2. It is the case of appellant that:,,

2.1 The refusal on the ground that â?" â??provision of section 16 of the Patents Act does not provide provision for filing divisional application out of,,

earlier divided out of applicationâ? is against several established judicial precedents and is erroneous in as much as it does not appreciate that the,,

subject divisional application complies with all the requirements of Section 16 of the Patents Act.,,,

2.2 The Respondent has failed to give effect to the law laid down in the decision

passed by the Honâ??ble IPAB in the matter of National Institute,,
of Immunology v. The Assistant Controller of Patents and Designs (OA/21/2011/
PT/DEL), which was brought to the attention of the Respondent at",,,
the official hearing and in the written submissions dated August 23, 2016, where
the Honâ??ble IPAB has unequivocally held that",,,
â??A divisional application filed out of another divisional application is valid,
provided the progeny divisional application was filed before the grant of",,,
its immediate predecessor application.â??,,

2.3 Since the Subject Divisional Application was filed on May 7, 2008 i.e. before
the grant of First Divisional Application on December 18, 2008, the",,,
Subject Divisional Application is a valid divisional application.,,,

2.4 The legal principal pertaining to the validity of â??divisional out of divisional
applicationsâ? as clarified by the Honâ??ble IPAB in the National,,
Institute of Immunology case, has been reaffirmed by the Honâ??ble IPAB in the
matter of Teijin Pharma Limited v. Union of India",,,
(OA/72/2012/PT/MUM) and the impugned order is ultra vires since the impugned
order has adopted a contrary stance despite these decisions being,,

brought to the attention of the Respondent at the hearing and written
submissions filed on August 23, 2016, pursuant to attending the hearing.",,,

2.5 Moreover, the impugned order is also contrary to the ratio of the decision
passed by this Honâ??ble Board in the matter of Milliken & Company",,,

Vs. Union of India, (OA/61/2012/PT/MUM). In the Milliken case, the Applicant
had filed a request for voluntary amendment of claims for adding",,,

new claims during the 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 suo
moto second divisional application to protect the scope of said new",,,

claims. This Honâ??ble Board held that the â??second divisional applicationâ??
which was filed suo moto without receiving an objection of lack of,,

unity in the first divisional application, was valid.",,,

2.6 The Appellant submits that the Milliken case upheld the validity of suo moto
divisional applications for multiple inventions and the Respondent,,

ought not to have adopted a contrary stance especially after the Milliken case
was brought to its attention.,,,

2.7 The Appellant submits that the subject divisional application was filed on May

7, 2008 i.e. before the date of grant of the First Divisional",,,

Application on December 18, 2008. Moreover, Section 16 (1) stipulates that a patent applicant may file a divisional application, if he so desires OR in",,,

order to meet the objection on the claims set pertaining to more than one invention. In the instant case, the subject divisional application was filed suo",,,

moto to pursue the scope of the claims scope of invention which is distinct from the invention claimed in the first divisional application as evident from",,,

the table (supra).,,

2.8 The appellant drew the attention of this Board to the fact that the claims in the first divisional application, at the time of filing, included claims of",,,

the subject divisional application along with claims as granted in the first divisional application (directed to the method of production of olefins from",,,

oxygenate feedstock using a catalyst that employs a silicoaluminophosphate molecular sieve). Therefore, the original claims as filed in the first",,,

divisional application related to more than one invention.,,,

2.9 The impugned order is erroneous in as much as it fails to appreciate that Section 16 places no express or implicit bar on filing a divisional out of an",,,

already divided application. Importantly, the Manual of the Patent Office has placed no restriction on filing of such application. The Respondent has",,,

misconstrued the scope of Section 16 resulting in grave violation of the rights of the Appellant.,,,

2.10 The impugned order is vitiated since the objection on the ground of â?? LACKING PLURALITY OF INVENTIONâ?? was raised for the first",,,

time only in the impugned order. Therefore, the impugned order has been passed in violation of the principles of natural justice.",,,

2.11 The learned counsel of the appellant further invited Attention of the Board to the fact that the refusal on the ground that â??instant claims do not",,,

constitute plurality of inventions with in provision of section 16 of the Patents Act;â?|â? (paragraph 1 on page 7 of the Impugned Order) was raised",,,

for the first time only in the impugned order.,,,

2.12 The Respondent did not raise any objection regarding lack of distinctness of the claims of the subject divisional application vis-Ã -vis its",,,

immediate predecessor (first divisional application) in the FER or the hearing notice.,,,

2.13 The objection under Section 16 in the hearing notice was restricted to:",,,

â??The further application can be filed at any time before the grant of the patent to the original or first-mentioned application but there is no provision,,

to file the further application to already filed further application. Hence, the instant application does not qualify as a further application as per Section",,,

16(1) of the Patent Act, 1970. Further, the particulars for filing divisional application provided at paragraph 7 on Form-1 is not correct as the",,,

application number 145/MUMNP/2006 is not the original or first application. In view of the above, the instant application cannot be accorded as a",,,

divisional application and further examination is not carried out.â??,,

2.14 Since the issue of lack of distinctness between the invention claimed in the subject divisional application and the first divisional application was,,

raised for the first time only in the impugned order, the Appellant was deprived of the opportunity to suitably rebut this objection. This is in gross",,,

violation of the principles of natural justice.,,,

2.15 Reliance is placed on the judgment passed in the matter of Competition Commission of India v. Steel Authority of India Ltd. and Anr., wherein",,,

the Apex Court held that:,,

The principles of natural justice has twin ingredients; firstly the person who is likely to be adversely affected by the action of the authorities should be,,

given notice to show cause thereof and granted an opportunity of hearing and secondly, the orders so passed by the authorities should give reason for",,,

arriving at any conclusion showing proper application of mind. Violation of either of them could in the given facts and circumstances of the case,",,,

vitate the order itself.,,,

2.16 The Appellant submits that the stance taken by the Respondent contravenes the doctrine of audi alteram partem which stipulates that no man,,

shall be condemned unheard. The order is vitiated on this ground alone.,,,

2.17 The Appellant submits that the conduct of the Respondent in raising an objection which was not communicated in the hearing notice is in,,

contravention of the directions laid down by this Honâ??ble Board in the matter of Resprotect GmbH vs. The Controller of Patents & Designs &,,

Anr., OA/23/2010/PT/DEL (hereinafter referred to as â??the Resprotect Caseâ??) 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.,,

2.18 The impugned order is manifestly arbitrary and discriminatory since the Respondent has not given due consideration to the fact that by raising the,,

objection on lack of distinctness at the last step of the proceedings (i.e. at the time of rendering a final order), it has deprived the Appellant of the",,,

opportunity to present its defense.,,

2.19 In the instant case, the objection on lack of distinctness was never made known to the Appellant thus depriving the appellant of a fair opportunity",,,

to present its case before the Respondent.,,

2.20 In view of the foregoing, the impugned order has clearly been passed in breach of the principles of natural justice and is also in contravention of",,,

the directions laid down by this Honâ??ble Board in the Resprotect Case.,,

2.21 The Respondentâ??s refusal on the premise that â??instant claims do not constitute plurality of invention with in provision of section 16 of the,,

Patents Act;â?|â?? (paragraph 1 on page 7 of the Impugned Order) is erroneous.,,

2.22 The impugned order is erroneous since the Respondent did not consider the circumstances which necessitated the filing of the divisional,,

application,,

2.23 The impugned order failed to appreciate that the Appellant has not derived any unfair advantage by filing a divisional application.,,

2.24 Without prejudice, it is submitted that the impugned order is erroneous since it has erroneously held that the claims of the divisional application are",,,

not distinct from the immediate predecessor application when in fact the claims of subject divisional application ARE CLEARLY DISTINCT vis-Ã -,,

vis claims of first divisional application.,,

2.25 The impugned order has failed to appreciate that the crystalline silicoaluminophosphate molecular sieve claimed in the subject divisional,,

application is distinct from the method of conversion of oxygenate to olefins claimed in the first divisional application which has resulted in vitiation of,,

the impugned order.,,

2.26 The Respondent ought to have provided an 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.,,

2.27 The Respondent has failed to appreciate that the interest of justice has been seriously jeopardized by passing of the impugned order, particularly",,,
since it was technically unfeasible to pursue the claims of the subject divisional application (which are directed towards â??a crystalline,,
silicoaluminophosphate molecular sieve and its application as a catalystâ??) in the parent application itself (which was directed towards â??method of,,
converting oxygenate to olefinsâ??) by making the same dependent on the main claim of the parent application.,,

2.28 The Appellant submits that the Respondent has grossly erred in refusing divisional application status to the subject divisional application since the,,
same complies with all the requirements of Section 16.,,

2.29 The Respondent misdirected himself in the appraisal and appreciation of the oral submissions presented by the Appellant at the hearing on August,,
22, 2016 as well as the written arguments and amended claims presented on August 23, 2016, which resulted in vitiation of the decision.",,,

2.30 The impugned order of the Respondent in refusing the Appellantâ??s subject divisional application on the ground that a second divisional,,
application (grandchild application) is not allowed under Section 16 is erroneous in law and is liable to be set aside. The Appellant submits that the,,
Respondent has not comprehended and appreciated the Appellantâ??s submissions and the provision of Section 16 of the Act.,,

3. Facts of the case,,

3.1 The instant patent application no. 914/MUMNP/2008 dated 07/05/2008 was divided out of an earlier patent application no. 145/MUMNP/2006,,
filed on 06/02/2006 which was divided out from IN/PCT/2002/1027/MUM dated 30/07/2002.,,

3.2 It is important to have a look on the claims of the first mentioned application. The first mentioned application no. IN/PCT/2002/1027/MUM was,,
filed with 30 claims, listed as under:",,,

3.3 This first mentioned application no.,,
IN/PCT/2002/1027/MUM was examined in accordance with the law prevailing then and a First examination Report (FER) containing the following,,

main objection was issued on 06/05/2005:,,

3.4 It is pertinent to note that claims 1 to 9 and 17 as mentioned in objection at paragraphs 3 in FER were relating to "A crystalline,,

silicoaluminophosphate molecular sieve" and "An olefin product" respectively.,,

3.5 The applicant/appellant herein submitted the response to this FER on 25/10/2005 as follows:,,

3.6 As is evident, the originally filed claims 1-17 were deleted to meet the official requirements of FER and only claims 18-30 were retained in the",,

amended specification filed on 26/10/2005. Only 13 claims relating to "A method of making an integrated hydrocarbon co-catalyst" were,,

retained in that application after the response of the First Examination Report.,,

3.7 The normal last date for putting the application in order for grant was expiring on 06/11/2005 and on 07/11/2005 the applicant sought extension of,,

time thus the final last date was 06/02/2006. On this date, the applicant filed the first divisional application no. 145/MUMNP/2006, with the original set",,

of all 30 claims of first mentioned application i.e. even including the claims which were already deleted to meet the examiner's objection that those,,

claims were not found to be patentable then.,,

4. Now let's have a look on the first divisional application 145/MUMNP/2006.,,

4.1 It's First Examination Report (FER) carried the following main objections:,,

4.2 The appellants had submitted their reply to the said FER on 05/05/2008 and the relevant portion thereof is quoted herein below for reference:,,

Claims of

divisional

application

145/MUMNP/200

6", "Claims of First

mentioned application

IN/PCT/2002/1027/MU

M", "Claims of First

mentioned

application

IN/PCT/2002/

1027/MUM

deleted to

meet the

requirements

of FER

Claim 1, Claim 10, Deleted

Claim 2, Claim 11, Deleted

Claim 3, Claim 12, Deleted

Claim 4, Claim 14, Deleted

Claim 5, Claim 13, Deleted

Claim 6, Claim 15, Deleted

Claim 7, Claim 16, Deleted

Claim 8, "No corresponding claim in
parent application",

Claim 9, Claim 20,

Claim 10, Claim 23,

Claim 11, Claim 24,

Claim 12, Claim 25,

5.2 It is worth noting that the claims which were deleted to meet the requirements of FER in the first mentioned application IN/PCT/2002/1027/MUM,,

as found to be not patentable, were made subject matter of this divisional application. Further a close look at the last claim 10 is classic example of",,,

non- application of mind by the appellants wherein they make claim 10 depended on â??any of the claims 10 to 16â? while there are only 10 claims,,

herein.,,

5.3 One more important point need attention is timing of this divisional application.,,

5.4 The First Examination Report in the instant divisional application states as follows:,,

â?? The instant application 914/MUMNP/2008 is filed as a divisional application (further application) out of 145/MUMNP/2006 (Patent no. 226537),,,

and which in turn divisional application (further application) out of IN/PCT/2002/1027/MUM [original or first application].,,

â?|â?|,,

The further application can be filed at any time before the grant of the patent to the original or first-mentioned application but there is no provision to,,

file the further application to already filed further application. Hence the instant application does not qualify as a further application as per sec 16(1) of,,

the Patent Act, 1970. Further, the particulars for filing divisional application provided at paragraph 7 on Form-1 is not correct as the application no.",,,

145/MUMNP/2006 is not the original or first application. In view of the above, the instant application cannot be accorded as a divisional application",,,

and further examination is not carried out.,,,

6. The above discussions have proved that at no point in time there was any objection from the IPO on the ground of â??plurality of inventionsâ?.,,,

Certain claims were objected in the first mentioned application and the appellant have filed the divisional application to revive the non-patentable,,

claims. It is also evident from their response to FER of first divisional application 145/MUMNP/2006 that the subject matter of parent claims were,,

objected under section 5 and they do not have any option than to file the divisional application.,,,

7. Further, they deleted the claims relating to â??productâ?? from the first divisional as well, without any objection and choose to file the fresh",,,

divisional application to keep the case alive.,,,

8. The provision of section 16 of the Indian Patents Act, 1970:",,,

â??Section 16 Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps16.html> 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.â?"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.,,

9. It is well settled practice that the section allows to divide a patent application, if the applicant 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. The law does not give any liberty,,

to the applicant to keep filing divisional applications to revive the otherwise objected claims, as in the instant application.",,

10. The Board in BAYER ANIMAL HEALTH GMBH OA/18/2009/PT/DEL while dismissing the appeal has categorically held that â??But still,,

before us they have to show the existence of more than one invention and what each of those inventions related to. The learned counsel did not do,,

that but on the other hand it was submitted again and again that the invention sought to be patented earlier was not patentable under the earlier Act.,,

But now with the change in the Act, this application must be received and examined. Therefore, the learned counsel is not really advancing the case",,,

of a divisional application but of a fresh application.â??.,,

11. This Board has deliberated on the issue of divisional application in details in a very recent order in ESCO CORPORATION OA/66/2020/PT/DEL,,

and the issue of divisional to divisional was also clarified therein. This Board has no problem in allowing a genuine deserving divisional to divisional,,

application which is based on the plurality of â??distinct inventionâ??. But the issue herein is totally different. The learned counsel of the appellant has,,

tried to confine his argument on to divisional to divisional issue without indicating that the claims of instant applications were deleted from the body of,,

the claims in the first mentioned application, holding them not patentable then.",,,

Section 16 never mandate revival of any deleted claim held not patentable otherwise. It does mandate to divide an application on the ground of,,

â??plurality of the inventionsâ?? determined in accordance with the teachings of section 10(5) of the Patent Act, 1970.",,,

12. We have also analyzed the order of the learned Controller, the relevant portion of his order is quoted herein below:",,,

â??The product and process claimed in earlier filed application do not constitute plurality of subject matter thus it is not necessary to file divisional,,

application for the same, however when first divisional application filed by applicant, it could be possible to examine the product claims as provision of",,,

the allow ability of the product claims is in the Patents Act since amendment of Act in 2005;,,

Thus, instant claims do not constitute plurality of the invention with in provision of section 16 of the Patents Act; however, provision of section 16 of",,,

the Patents Act does not provide provision for filing divisional application out of earlier divided out of application, and the same may not be allowed as",,,

it leads to the confusion for the interested parties as it delays the decision on the patentability of the invention claimed more than one invention; as it,,

leads to prolong examination period by delaying tactics.,,,

2. The subject matter claimed in instant application (claim 1?2) does not fulfill requirement of section 10 (4) of Patents Act as it is not clear from the,,

claims for which protection is desired, as the claim is defined by the effect of the product, Therefore, instant application 914/MUMNP/2008 does not",,,

qualify the divisional status of the application over the 145/MUMNP/2006, as 145/MUMNP/2006 is divided out of the IN/PCT/2002/1027/MUM,",,

further claims of the instant application 914/MUMNP/2008 does not satisfy requirement of section 10 (4) of Patents Act; thus it is refused to take,,

further.â??,,

13. We are inclined to partially agree with the contention of the learned Controller. The subject matter of the instant application does not qualify for,,

the status of a divisional application since here there was no issue with regard to â??plurality of inventionâ?? and the claims sought be patented,,

through this divisional application 914/MUMNP/2008 were held to be non-patentable in the first mentioned application IN/PCT/2002/1027/MUM and,, were deleted by the appellant themselves. Even in first divisional application 145/MUMNP/2006 these claims were deleted by the appellant.,,

14. Learned counsel of the appellant kept on harping that they have right to divide the application under section 16, without ascertaining that the claims",, sought to be patented in this divisional does not qualify the test of plurality of invention.,,

15. In LG Electronics⁴ this Board held that "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 or to remedy Controller's objection.,,

16. Keeping in view the above facts and circumstances, the instant appeal is dismissed. No cost.",,