
(2020) 07 IPAB CK 0004
In the Intellectual Property Appellate Board
Case No : OA/47/2020/PT/DEL

Procter & Gamble Company	Vs	APPELLANT
Controller Of Patents And Designs		RESPONDENT

Date of Decision : 20-07-2020

Acts Referred:

Patents Act, 1970 — Section 12, 13, 14, 16, 16(1), 16(I), 117A

Citation : (2020) 07 IPAB CK 0004

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

Bench : Division Bench

Advocate : Hari Subramaniam

Final Decision : Allowed

Judgement

Manmohan Singh, J

1. The present appeal has been filed under Section 117A of The Patents Act, 1970 against the order passed by the Respondent on 02 January 2020

('Impugned Order'). Whereby the Respondent refused the Appellant's Indian Patent Application No. 5912/DELNP/2015 for lack of a distinct

invention from the parent application i.e., Indian Patent Application No. 4614/DELNP/2010.

The present invention relates to a laundry detergent composition comprising a combination of specific enzyme with a specific random-graft copolymer.

Specifically, the present invention is a combination of specific components (i) a glycosyl hydrolase, (ii) a random graft copolymer, and (iii) deterative

surfactant that have been combined in specific amounts as claimed in amended claim 1 filed on 07 May 2015. As opposed to the present invention, the

invention claimed in the parent application, i.e., Indian Patent Application No. 4614/DELNP/2010 relates to a composition comprising (i) a glycosyl

hydrolase, (ii) amphiphilicalkoxylated grease cleaning polymer and (iii) detergent surfactant.

2. Indian Patent Application No. 4614/DELNP/2010 ('parent application') filed on 25 June 2010 and now granted as Indian Patent No. 279837 on 31

January 2017.

3. Admittedly, the parent application No. 4614 was initially filed with 20 (twenty) claims by Form 13 dated 01 March 2011, the Appellant amended the total number of claims to 18 (eighteen).

4. The parent application No. 4614 was examined and First Examination Report (FER) was issued on 19 September 2014. It was held by the

Respondent that there were two sets of distinct inventions:

Group I: Claims 1 to 9

Group II: Claims 10 to 17

5. The appellant herein admittedly deleted the Claims 10 to 17 were deleted from the parent application at the time of filing the response to the FER

dated 19 September 2014 to overcome the objection raised by the Respondent who thereafter filed the present divisional application No.

5912/DELNP/2015 was filed on 06 July 2015 with eleven (11) claims corresponding to claims 10 to 17 deleted from the parent application as per the case of the appellant.

6. The divisional application was examined under Section 12 and 13 of the Act and a first examination report (FER) was issued on 16 November

2018. The Respondent raised the objection that claims 1 to 11 of the divisional application to be in conflict with claims 1 to 10 of the parent application.

7. The Respondent filed a response dated 07 May 2019 to the first examination report (FER) dated 16 November 2018 on the divisional application

The claims of the divisional application were subsequently amended on 07 May 2019 to comprise 09 (nine) claims.

The Respondent did not raise any objection on novelty, inventive step or patentability of the invention claimed in Indian Patent Application No.

5912/DELNP/2015. The said application as per appellant was examined under Section 12 and 13 of the Act and the only objection which remained

was with respect to the conflict of the claims of the Indian Patent Application No. 5912/DELNP/2015 with those of Indian Patent Application No.

4614/DELNP/2010.

8. The hearing was fixed on 18 November 2019 by notice dated 06 November 2019 the Respondent maintained the objection even after amended

claims 1 to 9 of the divisional application and observed that they are conflicting with claims 1 to 10 of the parent application during the course of hearing.

9. The Appellant filed post-hearing written submissions on 01 January 2020 where the Appellant tried to explain the law on Section 16 of the Act by

referring judicial precedents; Ultimately the Respondent passed the Impugned Order on 02 January 2020 whereby the Respondent, refused to grant a

patent on the divisional application on the ground that the claims of the divisional application were in conflict with those of the parent application;

10. Notice of the appeal was issued to the respondent who did not file the counter affidavit. Mr. H. Subramaniam appeared on 10.07.2020 and argued

the main appeal. After hearing, the order was reserved.

11. There is no dispute about the grant of patent bearing No. 279837 on 31.01.2017 of nine claims of Group-I but divisional application was rejected

after the amendment of claims 1 to 9 on 09.05.2019. The contention of the appellant is that these are allowable under Section 16(1) of the Act which

reads as under:-

12. Section 16(1) of the Act 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

provisional or complete specification already filed in respect of the first mentioned application....

13. It is obvious that Section 16 of the Act provides that a divisional application may be filed to remedy the objection of lack of unity raised by the

Respondent, with regard to the claims of a parent application, there are several judicial precedents which clearly lay down the law.

14. The appellant has placed its reliance upon Order No. 16 of 2016 in Milliken & Company vs. Union of India & Ors. (OA/61/2012/PTVMUM)

passed by IPAB which held:

...16. It is also pertinent to note that in the First Examination Report dated 20/06/2004 relating to the mother application, the Controller himself has raised an objection that there is plurality of invention and multiple independently worded claims viz., claims 9, 17, 26, 35, 48, 54 and 63, which are not allowable as they fall beyond the scope of the main claim. The contrary view is taken by the Controller in the impugned order that ""the parent application did not contain any claims relating to plurality of distinct invention"", which is also contrary to the facts of the case...

15. Reliance is also placed upon Order No. 1010 of 2014 in Syntonix Pharmaceuticals, Inc., vs. The Controller of Patents & Designs & Anr.

(OA/26/2013/PTVKOL) passed by IPAB, which states:

...6. On the perusal of the impugned order, it is crystal clear that the Assistant Controller has given a finding to the effect that the inventions under Group-1 are similar and identical to that of the patent granted in respect of Group-IV claims 61-84 which is self contradictory to the findings and objections raised in the First Examination Report. Therefore, we have no hesitation to hold that the appellant filed the divisional application only on the basis of the objection and on the basis of the finding given in the First Examination Report and there is absolutely no fault on the side of the appellant...

16. Reliance is also placed upon Order No. 83 of 2015 in National Institute of Immunology vs. The Assistant Controller of Patents & Designs

(OA/21/2011/PT/DEL) passed by IPAB, which states:

...6. ...the second divisional application No. 264/DEL/2005 was filed by the appellant only on the basis of the office objection issued in the first divisional application No. 346/DEL/2001 dated 17/08/2004 wherein it is specifically stated under Sl. 3. ""Claim 7 to 17"" defines multiplicity of distinct inventions"". Thereafter the said objection only necessitated and compelled the appellant herein to prefer the second divisional application No.

264/DEL/2005, the subject application herein was filed on 08/02/2005 is even prior to the grant of first divisional application on 31/03/2008. There is a sequence of events and the relevant dates makes it crystal clear that even in respect of divisional application namely the second divisional application

No. 264/DEL/2005 was filed well within the time of limitation contemplated under

Section 16(1) of the Patents Act, 1970

8. We are also constrained to state that the affected party like appellant herein should not be left in lurch mainly on the basis of the objection raised by

the office which necessitated the appellant to take resort to filing divisional application as the subject application in the instant case without any

remedial measures available in accordance with law. In view of the aforesaid reasons the appeal is allowed and the impugned order dated 31/03/2010

passed by the Assistant Controller of Patents & Designs, Patent Office, New Delhi is hereby set-aside...

17. Para 3 of the impugned order which are the only findings of Deputy Controller of Patents and Designs are reproduced hereunder:-

(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 the neither of said complete specification includes a claim for any matter claimed in other.

Thus, in my view divisional application must be filed only when the claims of the complete specification in parent application relate to more than one

invention and divisional application should not include a claim for any matter claimed in parent application. In present application, essential technical

feature of a laundry detergent composition comprising glucosyl hydrolase having enzymatic activity towards both xyloglucan and amorphous cellulose

substrates and a random graft co-polymer, which are already claimed in claim 1.5 of parent application. Claim 1 of present application conflict with

claim 6 of parent application. No distinct component of composition has been claimed in divisional application, while technical feature of random graft

co-polymer has already been defined in claim 5 of a parent application.

In view of above facts and findings and hearing proceedings under section 14 held on 18/11/2019. Claims of 5912/DELNP/2015 conflict with claims of

4614/delno/2010 as essential technical feature of a laundry detergent composition comprising glycosyl hydrolase having enzymatic activity towards

both xyloglucan and amorphous cellulose substrates and a random graft co-polymer, has already claimed in parent application. No distinct component

of composition has been claimed in divisional application, while technical feature of divisional application a laundry detergent composition comprising

glycosyl hydrolase having enzymatic activity towards both xyloglucan and

amorphous cellulose substrates and a random graft co-polymer has already been claimed in claim 1.5 parent application. In my opinion, all the essential technical feature of a laundry detergent composition comprising glycoxyl hydrolase having enzymatic activity towards both exloglucan and amorphous cellulose substrates and a random graft co-polymer is already claimed in parent application. Thus, parent application is not fit for divisional under section 16(I)(3) of the Patent Act, 1970.

18. In view of plain reading of section-16 and the decision referred by counsel for the appellant, there is no dispute that second divisional application is maintainable if the few claims are deleted because of distinct inventions from the patent application. The only remedy available with the party to file divisional application.

19. Under sub-section (2) of Section 16 no doubt restrict the party to file further application with complete specification not to include any matter in substance disclosed in the complete specification in the parent application.

20. In the impugned order, it is held that the divisional application can only be filed when the claims of complete specification in parent application relate to more than one invention and divisional application should not include a claim for any matter claimed in parent application.

21. As far as these findings are concerned, there is no dispute as the said findings are in accordance with law. But situation in the present case is different as when the parent application was examined, in the first examiner report issued on 19.09.2014 it was held by the respondent that there were two sets of distinct inventions. Therefore, the claims 10 to 17 were deleted.

22. Now in the divisional application, it is held that claiming in the present application conflict with claiming of the parent application so as the essential technical feature are no distinct components of composition has been claimed in divisional application. The said findings are not acceptable. In view of examination of parent application. The examiner report is clear in this regard.

23. We are of the view that once the parent application is already examined it is permissible to raise such type of issues unless, it is found that substantial amendments are made in the divisional application which enlarge the scope of invention claimed in the parent application.

24. The Impugned order erred in concluding that the claims of the Indian Patent Application No. 5912/DELNP/2015 are not fit for being filed as a

divisional application under Section 16 of the Act and is contrary to the same decision already rendered by IPAB. The hearing officer is not sitting

over the appeal of the finding given by the officer when parent application was examined.

25. In the light of above, the impugned order is set-aside by allowing the appeal.

26. No costs.