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Divided on divisional patents

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Introduction

Divisional patent applications refer to such patent applications which have been divided out from a first filed patent application, also called a parent application. Section 16 of the Patents Act, 1970 (Act) lays down the principle for filing of a divisional application. Divisional patent applications can be filed anytime before the grant (or refusal) of the parent application. Generally, a divisional application is filed with a view to remedy a plurality of invention objection raised by the Controller in the Examination Report. However, a divisional application may also be filed by the applicant of the parent application 'if he so desires'.

The Act allows the applicant himself to file a divisional application. But in such an instance the burden shifts on the applicant to prove that there is a plurality of invention in the parent application. It is observed that the Intellectual Property Appellate Board (IPAB) of India has stated multiple times that the basis of a divisional application is the existence of a plurality of invention. Plurality of invention is a *sine qua non* for seeking a division of an application.

Ruling of IPAB

In *LG Electronics Inc v. The Controller of Patents & Designs* (Order 111/2011), the IPAB held that the phrase 'if he so desires'

is not unconditional and it does not give the applicant an unjustified liberty to file a divisional application even when there is no plurality of invention in the parent application. In *Bayer Animal Health GmbH, Germany v. Union of India* (Order 243/2012), the IPAB again stated that a divisional has to satisfy the test of Section 16 of the Act which means that more than one invention in the parent application has to be shown. The IPAB reiterated this requirement again in *Syngenta Participations AG v. Union of India* (Order 19/2013).

What is the position if a plurality of invention is disclosed but not claimed? An interesting question that arises is whether an issue of plurality of invention can arise for inventions which are disclosed in the parent application but are not claimed.

A recent decision by the Controller with respect to Indian application 985/KOL/2007 has provided a fresh insight to the above unanswered issue on divisional applications. On 12th July 2007, the Applicant filed a divisional application 985/KOL/2007 pursuant to the parent application 17/CAL/1999 filed on 11th January 1999 (granted in 2008 with Patent Number 226916). Claims of the divisional application were directed to an apparatus for condensing a drafted fibre strand whereas claims of the granted parent

application were directed to an arrangement for condensing fibre strand.

On 24th June 2011 the First Examination Report (FER) was issued wherein the Examiner raised an objection that the claims filed in the divisional application were not claimed in the parent application originally filed. The Examiner went on to state that ‘what is not claimed is disclaimed and is open to public use, even if the matter is disclosed in the description of the parent application’; therefore filing of the divisional application was ‘an attempt to cure the defect, of not claiming the full scope of the invention, which has been incurred at the time of drafting the claims of the parent application’. The applicant responded by stating that the subject matter of the claims is within the scope of the claims originally filed in the parent application and is supported by the description. The Examiner maintained the objection in the Second Examination Report (SER) issued on 11th June 2012. The divisional application proceeded to hearing as the submissions made in response to the SER were not found satisfactory by the Examiner. Further to the hearing held on 22nd August 2012 and a final interview before the Controller on 15th May 2013, the Applicant submitted the written submission on 28th May 2013. In the written submission the Applicant again rebutted the objection stating that there is no provision in the Patents Act, 1970 reciting

‘that claims of a divisional application need to be arithmetically divided from the claims filed in the Parent Application.’

The divisional application was refused on 6th October 2015 on the ground that it was not a proper divisional application under Section 16. The Controller dismissed the divisional application stating that the scope of the claims of the divisional application was not within the scope of the claims of the parent application. He further stated that the Controller who had granted the parent application did not raise an objection for more than one invention. The Controller stressed that an applicant can file a divisional application only if distinctness is detected in the claims of the parent application. According to the Controller, the interest of a third party is prejudiced if the applicant files a divisional application based on plurality of invention in the description of the parent application when the claims of the parent application relate to a single invention. The Controller observed that when a patent application is published, the public at large becomes aware of the scope of protection and they determine their boundaries of operation accordingly and if divisional applications are divided from the description of the parent application, the boundary of operation will be uncertain for the public. The Controller in his decision opined that the scope of protection of the invention is defined by the claims, and that what is to be divided is this scope of protection, that is the claims. A reference to Section 57

of the Act read with Section 59 of the Act was also made in the decision. Section 57 of the Act states that amendments can be made to a patent application and Section 59 of the Act defines the boundaries of an amendment such that, if an amendment is made, the amended claim should fall wholly within the scope of any of the claims existing before the amendment. The Controller mentioned in his decision that the Applicant did not file amendments to the parent application knowing that the amendments would not be allowed u/S 57 read with 59 of the Act and instead opted for filing a divisional application bypassing Sections 57 and 59 of the Act to claim subject matter not under the scope of originally filed claims in the parent application. The Controller emphasised that ‘Section 16 cannot have any overriding effect on section 59.’ The Controller thus held that for a divisional application to be allowed under Section 16 of the Act, the scope of the claims in the divisional application should be traceable in the scope of the originally filed claims of the parent application.

In light of this decision, the interpretation of Section 16 becomes critical for all future divisional applications. Section 16 (1) recites: 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. The language used in Section 16 is that a ‘further application’ can be filed ‘in respect of an invention disclosed in the provisional or complete specification’. The scope of the disclosure of the provisional or complete specification may be broader than the scope of the claims of the complete specification. Since, the statute clearly says that a ‘further application’ can be divided from the disclosure of the provisional or complete specification, it may be argued that it will be unnecessarily restrictive if the divisional application has to be divided only from the claims. Additionally, provisional specification may not always include claims. However, the language also says ‘the claims of the complete specification relate to more than one invention’. Thus the question as to whether a divisional application can be filed for an invention that is disclosed in the parent application but not claimed or whether a divisional can be filed only in respect of an invention claimed in the parent application remains to be tested in higher judicial forum.

Conclusion

There is no settled jurisprudence that a divisional application can be filed only based on the invention claimed in the parent application. The aforementioned case is one such case where this issue has been addressed for the first time. It will now be interesting to see

as to how the IPAB and the Courts interpret Section 16 of the Act. Meanwhile, for filing any divisional application the following ruling by the IPAB has to be kept in mind: ‘the word ‘division’ cannot mean split one invention

into splinters, it can only mean splitting one application into more than one so that each application is for a separate invention.’

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Ratio Decidendi

Trademarks – Fraudulent registration and adoption

Delhi High Court has granted interim injunction restraining the defendants from using the trademark SENGE with the device of fearless lion and or any other mark which is identical with and/or deceptively similar to the plaintiff’s trademark. Noting that the plaintiff was the prior user of the mark, it was held that use by the defendant violated the plaintiff’s rights and thereby passing off their impugned goods and business as that of the plaintiff. Discussing the established principles of law with respect to passing off, prior user and the first to market test, it was held that the defendant is not the proprietor of the impugned mark and was dealing with it in the course of trade without the leave and license of the plaintiff. The Court in this regard also observed that in case, on the date of adoption, it is found, that the party was aware about the mark of the rightful owner, the using of the mark and filing of application in the Trade Marks office is fraudulent, and that there is not much difference, if the registration is obtained on the basis of non-filing of opposition. It was noted that it is immaterial if the defendant has filed the

application prior in time or owner of the mark has claimed user as proposed to be used if the mark is already known and used in overseas countries. [*Senge Himalayan Ceramics v. Shri Ram & Company - I.A. No.13443/2015 in CS(OS) 1929/2015, decided on 7-12-2015*]

Patent for process of testing – Use in ‘manufacture’

The Court of Appeals of the Federal Circuit, in respect of a process patent for testing a drug, has held that infringement only occurs under 35 U.S.C. § 271(g), as a result of “making” a product, and does not extend to testing to determine whether an already synthesized drug substance possesses existing qualities. Section 271(g) prohibits the unauthorized importation into the United States, or sale or use within the United States, of a “product which is made by a process patented in the United States”. The patentee here was of the view that “made” means “manufactured,” and that its patented method is “a crucial interim step used directly in the manufacture of defendant’s product”. The Court however held that it is more consonant with the language of the statute to limit § 271(g) to

the actual “making” of a product, rather than extend its reach to methods of testing a final product or intermediate substance to ensure that the intended product or substance has in fact been made.

It was however held that routine quality control testing of each batch of a generic drug as part of the commercial production process, after FDA approval, is not protected by the Hatch-Waxman Safe Harbor provision of 35 U.S.C. § 271(e)(1). The said provision states that there is no infringement in use of a patented invention “solely for uses

reasonably related to the development and submission of information under a Federal law which regulates the manufacture, use, or sale of drugs”. It was held that the routine quality control testing of each batch of generic drug as part of the post approval, commercial production process is not “reasonably related to the development and submission of information” to the FDA. [*Momenta Pharmaceuticals Inc. v. Teva Pharmaceuticals USA Inc.* - 2014-1274, 2014-1277, decided on 10-11-2015, United States Court of Appeals for the Federal Circuit]

Patent Office decisions

Patents – Solubility and hygroscopicity are no criteria to overcome objections under Section 3(d)

Controller, Kolkata Patent Office has rejected a patent application for an anti-diabetic compound teneligliptin on account of a pre-grant opposition filed for predominantly lack of inventive step and violation of Section 3(d) of the Patents Act. The Assistant Controller was of the view that solubility and hygroscopicity *per se* which are the physical properties of the claimed compound should not be the criteria to overcome Section 3(d), which

stipulates an incremental invention based on already existing substance. It was noted that stability *per se* cannot be considered as patentable subject matter unless and until it has substantial therapeutic efficacy as substantiated by comparative clinical data. It was also noted that the patent application did not provide any comparative data to show any technical advancement of the salt over prior art. [*Mitsubishi Pharma Corporation – Patent application No. 3176/KOLNP/2007*, decided on 23-9-2015, Assistant Controller, Patents and Designs, Kolkata]

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