

THE PATENT ACT, 1970

(Amended by the patents Act, 2005)

Under Section,14,&15

AND

THE PATENTS RULES, 2003

(Amended by the Patent Rules, 2006)
the matter of an application
for Patent No. 2042/DEL/2004
filed on 19th oct. 2004 by Laboratoires
Des Ethiques Ethypharm

Present:-

Ms.Swati Pahuja-----Agent for applicant.

Dr. R.K.Lohiya-----Examiner of Patent & Designs

Hearing held on 15-12-2010

Decision

1. M/s LABORATOIRES DES PRODUITS ETHIQUES ETHYPHARM 21 RUE SAINT-MATHIEU,78550 HOUDAN,FRANCE , Filed their application No 2042 DEL 2004 dated 19th October 2004 for their invention related to “SUSTANED-RELEASE MORPHINE SULPHATE MICROGRANULES” which is a divisional application out of Patent applicationNo.IN/PCT/2001/01143/DEL dated 10th December 2001.
2. The main application IN/PCT/2001/01143/DEL out of which the instant application has been divided out, was claiming “MORPHINE SULPHATE MICROGRANULES,PREPARATION PROCESS AND COMPOSITION CONTAINING THEM”. This application was Examined by the office and first Examination report thereof was issued on 28/04/2004. The Examination report inter-alia contained an objection that the invention is not allowing u/s 5(1)(b) of the then existing Patents Act 1970. In other words, the invention was Pharmaceutical compound per se and hence was not Patentable under the Act before 1st January 2005, However, the

agent for the applicant did not respond to the objection contained in first Examination report issued by the Patent office and the application was abandoned u/s 21(1) of the Act for not complying with the requirements.

3. The applicants knowing the fact that product Patent for substances "MORPHINE SULPHATE MICROGRANULES, PREPARATION PROCESS AND COMPOSITION CONTAINING THEM" per se would be possibly made available from 1st January 2005 opted to file a fresh application for the same invention as divisional application out of the earlier application. The set of claims of the so called divisional application was same as that of the parent application including claims which the application intended to claim again. This Div. application No 2042/DEL/2004 was examined and it was communicated vide office letter dated 30/10/2009 that this application is divisional application of IN/PCT/2001/01143/DEL which was abandoned and the claims of this application are identical to the claims of parent application and hence not allowable under section-16. The applicant refilled their documents along with the submission on 20/08/2010 replying to the objection raised in the FER. In their response, the applicants Agent admitted that the earlier application No. IN/PCT/2001/01143/DEL was allowed to lapse by not filing the response to the office action. The agent further submitted that since subject matter of the claims of the parent application were not allowed under then section 5 they had no option but to file the preset divisional application to cover the scope hereof they have also requested for being heard in this matter accordingly the matter was heard on 15/12/2010
4. Submission of the agents during hearing
 - a) During the hearing the agent for applicant argued that under the provisions of section 16, the applicant can file a divisional application any time before the grant of patent if he so desires or on the direction of the controller to remedy the objections raised by him on the ground that the claims relate to more than one invention. According to the agent for the applicant they are entitled to file divisional application for their own even if parent application does not contain more than one invention. According to them the issue of

more than one invention is applicable only when the controller raises such objections.

- b) They relied on the instruction issued by Controller General on 18th July 2006 stating that this instruction superseded the instructions issue on 3rd May 2005.

5. Finding and conclusions

- (i) Before considering the issue of divisional application, let me quote the instruction No.3/2005 dated 3rd 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 1st January 2005 in accordance with the provision of section 16 read with section 10(5) of the Act. According 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 through the communication 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. This instruction did not supersede the instructions issued on 3rd May 2005 as contended by the agent for the applicant.
- (ii) The concept of divisional application in the Patent law basically addresses the issues of allow ability of protection of multiple inventions disclosed in one patent application, where these multiple inventions do not constitute a single inventive concept the protection of multiple invention through divisional application is available in the Patents Act 1970 under the provisions of section 16 and section 10(5) 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 claim for any matter claimed in the other.

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.

(iii) Accordingly on plain reading of the above referred provisions, it is evident that 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. Further, where any overlapping of the claims in the parent application with the divisional application is observed, the controller may seek the amendments in the complete specification of the divisional application to ensure that there is no overlapping of claims between these applications. In other words the later application should not include any claim already claimed in the parent application. Moreover, 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, it is primarily essential that the parent application out of which the divisional application is filed, should disclose more than one invention and not just the same invention. This is also support by Narayanan, in paragraph 3-44 of Patent Law by Narayanan [4th Edition 2006 page No.60]

“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 own request at any time before the grant of the 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 amply evident that the intended purpose of the statutory provisions relating to division of application was

- a) To cure any defect relating to multiplicity of invention in one application,
- b) To enable filing of division application to protect the multiple inventions disclosed in one application,
- c) To allow the priority date of the parent application for the divisional application.

(iv) Although, I agree with the applicants arguments to the extent that the applicant can file an application as divisional application of his own before the grant of the patent as there is no provision in the patent law to stop him from doing so. However the controller is mandated by the law to ascertain that the divisional application so filed is on account of disclosure of plurality of distinct invention in the parent application. Section 16 pertains to power of the controller to make order respecting

division of application. Right to file divisional application indeed rest with the applicant but the power to ascertain its allow ability is vested with the controller. The first and the foremost essential requirement of this provision is the existence of plurality of invention in the parent application. Therefore , I am inclined to disagree with the applicants argument that they can file divisional application on the ground that divisional application is relating to the subject matter of the claims of the parent application which were not allowed under then section 5. I think this is an attempt not to divide the subject matter of the application for securing the grant of patent on product which was not hitherto allowable at the time of filing of the application which in fact is not the purpose of section 16. This section does not include such ground for division of application .Thus if the applicant requires to file a divisional application for his invention, disclosure of more than one invention (plurality of distinct invention) in the parent application is essential. The instructions as referred above issued by the controller General are also very clear in allowing the divisional application in accordance with the provisions of the Patents Act meaning thereby that only the eligible application shall be allowed to be divided as per the provision of section 16 and section 10(5).

- (v) On analysis of the claims it is found that the set of claims in the parent application and the instant divisional application are exactly same. The parent application, Which was then abandoned, did not contain any claim relating to plurality of distinct invention. Interestingly, no objection relating to plurality of distinct invention was raised in first examination Report (FER) issued on 9th April 2001. Instead, without complying with the requirements contained in the FER, applicant chooses to file instant application as divisional application. Thus the instant application appears to have been filed in the guise of divisional application to revive the claims for product in the parent application which were found to be

not allowable under section 5(a) when the parent application was examined.

6. Having considered all the circumstances, submissions made by the agent for applicant during the hearing including all the documents on the record and 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.

N.R.MEENA

ASSISTANT CONTROLLER OF PATENTS & DESIGNS

Dated 19/07/2011

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