



IPAB Intellectual Property Appellate Board
balancing ip-protection

Delhi Registry –Cum-Bench

G-62 to 67 & 196 to 204, August KrantiBhawan, Bhikaji Cama Place,
New Delhi – 110 066

Tele No: 011-26180613/14 Email: delhiregistryipab@gmail.com Website: <http://www.ipab.gov.in>

OA/3/2015/PT/MUM

TUESDAY, THIS THE 27TH DAY OF OCTOBER, 2020

HON'BLE SHRI JUSTICE MANMOHAN SINGH : CHAIRMAN
HON'BLE DR. B.P. SINGH : TECHNICAL MEMBER (PATENTS)

UCB PHARMA S.A.
60 ALLEE DE LA RECHERCHE,
B-1070, BRUSSELS,
BELGIUM

..... APPLICANT/ APPELLANT

(Represented by: Ms Ranjna Mehta Dutt)

1. THE CONTROLLER GENERAL OF PATENTS & DESIGNS
BOUDHIK SAMPADA BHAWAN
CP-2, SECTOR V, SALT LAKE CITY
KOLKATA-700 091

2. THE ASSISTANT CONTROLLER OF PATENTS & DESIGNS
THE PATENT OFFICE,
BOUDHIK SAMPADA BHAWAN
PLOT NO. 352, NEAR ANTOP HILL POST OFFICE
S. M. ROAD, ANTOP HILL, MUMBAI - 400 037..... Respondents

(Represented by: None)

ORDER

Hon'ble Shri Justice Manmohan Singh, Chairman

Hon'ble Dr. B.P. Singh, Technical Member (Patents)

1. The present appeal has been preferred under Section 117A of the Indian Patents Act, 1970, against the order dated 20/07/2012, passed by Respondent No.2, under Section 15, refusing the Appellant's Indian patent application no. 1765/MUMNP/2007; on the ground that the

claimed subject matter lacks inventive step and does not constitute a valid divisional application under Section 16 of the Act.

2. The subject patent application was divided out of the first mentioned application no. IN/PCT/2002/00019/MUM.(parent application)
3. The parent application number IN/PCT/2002/00019/MUM was initially filed with 84 claims. Later the claims were restricted to 67 to conform to PCT International Application. The First Examination Report (FER) issued on 26/10/2006 in the parent application no. IN/PCT/2002/00019/MUM had the objections *inter alia* as shown below:

1. Invention claimed in claims lacks novelty/inventive step considering the following documents. WO 9825971 A, WO 9211383 A, WO 9964460 A, EP 0380068 A Accordingly they do not constitute an invention under /section 2(1)(j) of the Patents Act 1970 (Amended 2005).
2. Invention claimed in claims 28-41 & 49-55 do not falls within the scope of claim 1.
3. Invention claimed in claim 60 falls within the scope of sub clause of sec 3(e) of the patents act 1970 as amended by 2005. Hence not allowed. Other ingredients of the composition should be given.
4. Invention claimed in claim 56 falls within the scope of sub clause of sec 3(j) of the patents act 1970 as amended by 2005. Hence not allowed.
5. Claims 37, 39 & 41 are redundant.
6. Invention claimed in claims 61-64 are use claims. Hence do not constitute the invention under /section 2(1)(j) of the Patents Act 1970 (Amended 2005).
7. Claims 65 & 66 are not clear where indicated there in.

4. The applicant/appellant herein, submitted their response to these objections on 24/04/2007 and submitted their reply *inter alia* as follows:

With respect to the objection of the Learned Examiner on the ground of lack of clarity and definitiveness in the claims, the claims have been thoroughly revised. The basis of the revised claims is as follows:

Additionally, specific changes have also been made in the claims in light of the specific objections of the Learned Examiner. With respect to paragraph 2, it is respectfully resisted and submitted that the "compound" and the "DNA sequence" comprise the antibody of the preceding claims and may accordingly be allowable under single inventive concept. The Learned Examiner is accordingly requested to reconsider the present objection.

Regarding paragraphs 3 and 4, the objected claims have been deleted in light of the objection of the Learned Examiner.

With respect to paragraphs 5, 6 and 7, the claims 37, 39 and 41 (revised claims 44, 46 and 48) have been revised and claims 61 to 64 and 65 and 66 have been deleted in light of the objection of the Learned Examiner.

Regarding paragraph 8, the compound claim has been further revised in light of the objection of the Learned Examiner.

The amendments carried out in the specification have necessitated retyping of pages 47 to 54 as fresh pages 48 to 58. The retyped pages are submitted herewith in duplicate along with former pages which have been cancelled. The remaining pages of the specification have been renumbered.

5. It is the case of the appellant that the marked copy of the claims enclosed with the First Examination Report dated October 19, 2006 of the parent case, claims 8 to 41 were held as falling beyond the scope of principal claim 1, i.e. original claims 8 to 41 were held distinct from the scope of original claim 1.
6. In view of the objections raised in the First Examination Report of the parent application, the Appellant amended the claims of the parent application at the time of filing a response to the First Examination Report. Thereafter, the matter was discussed with the concerned Examiner. During the discussion, the Controller objected to the amended claims on the ground that the amendments were in contravention of Section 59 of the Act. The Examiner also maintained the objection on lack of unity of invention.
7. In view of the above-mentioned objections, the Appellant was constrained to further amend the claims of the parent application. The said amendments were carried out under the cover of the Appellant's letter dated October 16, 2007. The parent application was restricted to the following eight claims as shown in Table 1 herein under:

Table 1:

Claims pursued in the parent application	Basis in original PCT claims
1	12
2	23
3	41
4	49
5	53
6	55
7	56/57
8	58

8. In view of the fact that the claims of the parent application were restricted as shown in Table 1, the Appellant was constrained to file a

divisional application. As per practice, the divisional application was filed with the original claim set and later restricted at the time of filing a response to the First Examination Report. The claims were further restricted during the hearing. Support for the finally amended claims is provided in Table 2 given herein under:

Table 2

Amended Claims of divisional application	Support
Claim 1	Original Claims 3 and 4
Claim 5	Original Claim 22
Claim 6	Original claims 8, 9 and 10
Claim 8	Original Page 8, lines 12 to 17
Claims 13 to 15	Original page 9, lines 30 to 33 and Original page 10, lines 1 to 2
Claims 16, 17, 18 and 21	Refer to "DNA" in place of "DNA sequences"
Claims 24 to 26	Original Page 16, Lines 15 to 25

9. The learned counsel of the appellant submitted that Hon'ble Board will appreciate that the filing of the subject divisional application was necessitated by the objection of distinctiveness raised in the parent application.

10. Analysis

10.1 The parent application was granted on 10/10/2008 and the divisional application was filed on 22/10/2007 with the original set of claims present on record of the parent application, while issuance of its FER.

10.2 Though, there was no explicit objection on to plurality of distinct invention, but we observe that while responding to FER of parent application and particularly in respect of objection at para 2

thereof, which held claims 28-41 and 49-55 out of scope of claim 1, the applicant argued to allow these claims under single inventive concept.

10.3 There is no other evidence to show that claims 8-41 were objected under out of scope category, except the pencil mark on the cancelled pages of the claims of parent application which once corroborated with the objection in FER at para 2 appears as typo error by the examiner. The claims relating to 'compound' and 'DNA sequence' were held to be out of scope of claim of 1 by the examiner and these claims were numbered claims 28-41 and claims 49-55 respectively. Therefore, the contention that the objections on being "out of scope' was taken on claims 8-41, is not correct and appears to have been created by typo error of the examiner.

10.4 We have seen that the instant divisional application was filed with identical set of claims 1-67 as present in the parent application.

10.5 It is very important to note that in para 22 of the order in L.G Electronics case¹ this Board held that *"The provision under section 16 put a bar on filing same claims as it mandates the Respondent to seek such amendment of the complete specification as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other. In the present case same application with same claims have been filled which is not the purpose of this provision.*

10.6 A look at the provisions of section 16

"Section 16²

*Power of Controller to make orders respecting division of
application*

¹ OA/6/2010/PT/KOL

² Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps16.html>

(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.—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.” [Emphasis added]

10.7 The appellant admits that ‘In view of the fact that the claims of the parent application were restricted as shown in Table 1, the Appellant was constrained to file a divisional application. The provisions of section 16 does not give any scope for filing divisional

application just because of the reason that the claims of the parent applications were restricted on any other ground. It allows only for filing divisional application, if there are claims relating to more than one invention in the parent application and if these claims cannot be linked to form a single inventive concept.

10.8 Let's consider that though not explicitly, but the objection was relating to scope of claims 28-41 and 49-55 as communicated vide para 2 of the FER in parent application. The appellant argued also in the response of FER to allow these claims under 'single inventive concept' category. But if the same was not agreed upon by the respondents, the appellant could have filed divisional application in respect of the claims 28-41 and 49-55 relating to 'compound' and 'DNA sequence' respectively. Further, claims 60, 56, 61-64, 65 and 66 were deleted by the appellant as evident from their response to FER to meet the requirements of the FER, in parent application.

10.9 Hence, claiming again all the claims 1-67 after deletion of some of them during prosecution of earlier application can be seen as attempt to revive these claims again. The ratio of LG Electronics³ hold good in this case wherein this Board held *"we feel that further application for same invention with same claims is an attempt not to divide the subject matter of the application but an exercise to revive the subject matter of the application by enlarging the time for securing the grant of patent using the provisions of section 16. This in fact is not the purpose of section 16. This section does not include such ground for division of application."*

10.10 Further the appellant have submitted through table 2 above that only claims 1,5 and 6 of the amended divisional application had their routes in the claims of parent application; the other claims

³ Supra 1

such as 13-15,16,17,18,21,24 and 26 were newly added in the body of the claim and their basis in the description is shown in the table.

10.11 This is again not the teachings of section 16 which clearly stipulates in sub section (1) that ‘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.’

10.12 In this regard, the relevant provisions of Narayanan⁴, “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’s own request at any time before the grant of 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.”[Emphasis added]

10.13 It is well settled that the word ‘cover’ and ‘claim’ are used synonymously. Hon’ble Supreme Court in Novartis⁵ when it held that ‘The dichotomy that is sought to be drawn **between coverage or claim on the one hand and disclosure or enablement or teaching in a patent on the other hand....**’ [Emphasis added]

10.14 Therefore, addition of new claims from the description, which were

⁴ Patent Law by P. Narayanan [4 Edition 2006 page No.60]

⁵ Novartis Ag vs Union Of India & Ors Available at <https://indiankanoon.org/doc/165776436/>

not present in the body of the parent claims, cannot form part the divisional application, as per the teachings of section 16 of the Patents Act, 1970.

10.15 The Respondent has refused the instant application mainly on the ground of non-maintainability of application under section 16 of the Act and *without prejudice* thereof, on lack of inventive step as well. On the issue of maintainability, the instant application is not passing the test of section 16 of the Patents Act, 1970; hence consideration of inventive step becomes infructuous at this stage.

11. We find that the contention of the appellant that *‘the filing of the subject divisional application was necessitated by the objection of distinctiveness raised in the parent application.’* is not correct based on our findings in the above paragraphs.

12. In view of the above quoted facts and circumstances, we order that instant divisional application no. 1765/MUMNP/2007 is not maintainable under the provisions of section 16 of the Patents Act, 1970.

13. The appeal is, therefore, dismissed.

14. No cost.

- Sd/-

(Dr. B.P. Singh)
Technical Member (Patents)

-Sd/-

(Justice Manmohan Singh)
Chairman

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