

Divisional Application Practice in India



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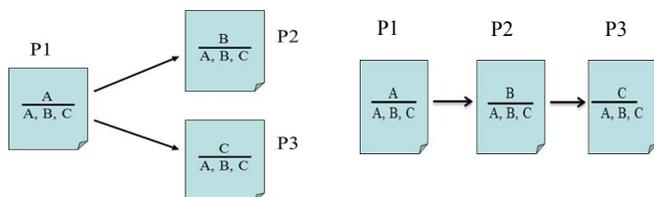
May 2015

In India there are 5 types of patent applications. These applications are:-

1. Ordinary Application
2. Convention application
3. PCT national phase application
4. Patent of addition
5. Divisional application

A divisional application is filed when the parent application contains plurality of inventions relating to more than one inventive concepts. If multiple inventions are disclosed in a single application, the applicant may pursue claims to one of the multiple inventions in the parent application, and pursue the other inventions in subsequent divisional applications. The divisional applications claim the priority date of the parent, contains generally same specification as the parent application, but have a different set of claims.

Example of Divisional Applications



In the example as above, the document P1 is a parent application which discloses three inventive concepts, namely concepts A, B and C, however, claims relate to only one inventive concept A. Now in such a case, to claim other inventive concepts B and C, the applicant can file further applications P2 and P3, respectively. The further applications P2 and P3 filed are called as divisional applications. These further applications are allowed to claim the priority date of parent application P1.

The legal premise of divisional application is derived from section 16 of the Indian patent act. According to section 16:

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.

Further, Section 16 sub-section 2 and Section 16 sub-section 3 provide the conditions applicable to the further application. According to Section 16 (2), the divisional application shall not include any matter which hasn't been disclosed in the parent application. Section 16 (2) is as follows:

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(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.

Section 16 (3) specifies that an examiner is entitled to ask for amendments which ensure distinction of claims that are included in the original and further applications.

16. Power of Controller to make orders respecting division of 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.

If we look back at section 16 (1), there is an interesting dichotomy. Section 16 (1) says that a patent applicant at any time before the grant of a patent is entitled to file a further application. The noticeable aspect in the wording of section 16 is the situations in which the patent applicant is entitled to file the patent application. In this regard, two situations are derivable from section 16 (1).

The first situation is highlighted by the clause: *if he so desires*. This suggests that a patent applicant may unconditionally file a divisional application any time before the grant of a patent. Since this clause seems to be unrestricted with respect to the multiplicity of the invention, on a bare reading of the provision, it can be concluded that the patent applicant can file claims relating to the same invention as in the parent application in the further divisional patent applications.

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The second situation is highlighted by the clause: 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. This suggests that the patent applicant is required to file a divisional patent application when he/ she is told to do so by the examiner during prosecution of the application, in cases where the examiner finds out that the claims of the specification relate to more than one invention.

Since both the situations are added by the conjunction “or”, a literal word by word interpretation of the section gives an impression that a patent applicant is free to file divisional application in the following situations:-

1. Voluntarily with or without the presence of plurality of invention in the parent application,
OR
2. Once there is an objection by the examiner as to the plurality of the invention.

This loose construction of law has led to abuse of divisional applications over years. For over two decades, it was a generally thought that divisional applications could be filed at any time before the grant of the patent, if the applicant so desired, even in cases where there is an absence of multiple inventions in the parent application. This practice was misused by the patent applicants wherein they submitted the same claims in the divisional patent application as in the parent patent application. The malpractice was resorted to by the applicant in one of the following situations:

1. In situations where the acceptance period¹ under section 21 is going to lapse, and the applicant is unable to file the response within the statutory time period. In such situations the applicants used to file a divisional application from the parent application to get a second attempt at the examination for the same invention;
2. In situations where the applicant believed that he will not get a grant, then in such case, the applicant refiled the claims in a divisional application before the order of rejection is issued. This used to give another attempt at the examination for the same invention;
3. In situations where the acceptance period has gotten over, and the applicant has not heard the patent office about the acceptance or rejection of the patent application. In such situations, the applicant filed a divisional application to ensure that their patent application is safe by having a second attempt at examination;

4. In situations where the application got abandoned due to procedural/ technical issues, and the applicant wants to revive the application; and
5. In situations where the applicant wanted to change the examiner on record.

All these practices used to give a second attempt at patenting an invention. This strategy was specially used by patent applicants in pharmaceutical product patenting cases to get a second attempt at patenting the inventions which were refused because of the restrictive laws before the 2005 patent amendment². In such situations, many applicants filed divisional applications after the new laws which allowed product patenting came into force. There was ambiguity in the practice being followed at the IPO: divisional applications filed as continuation applications were allowed or rejected, with little consistency and this lead to abuse of divisional application system.

The contentious abusive practice was challenged by various stake holders in recent years in various appeals to the Intellectual Property Appellate Board or the IPAB, the body which adjudicates the decisions of the patent office. In all these cases, the respected Appeal board has brought an end to the contentious practice and has set the record straight with respect to divisional patent practice in India.

In a first case, namely, Bayer Animal Health Case³, the applicant (Bayer Animal Health GMBH) had filed an application in the year 1999 at the Indian patent office with application number: 1427/DEL/1999 (hereafter the 1427 application). The 1427 application was examined and a first examination report (FER) was issued on 2nd July, 1999 and the FER contained an objection that the invention was not patentable under the then existing section 5 sub section 1 clause (b)⁴ of the Patents Act, 1970 of the pre 2005 law. The applicant did not respond to the objections and accordingly the application was abandoned under the Act for not complying with the requirements.

After the new Act (post 2005 law) came into force and chemical substances became patentable, the applicant filed afresh, another application for the same invention as a divisional application of the earlier main application. This fresh application was again examined and a FER was issued on 20th September, 2007 including the objection that the application was not a valid application under Section 16 and it did not comply with the requirements of section 16.

¹According to section 21, the statutory time period is one year from the receipt of the first examination report

²Please note that the Indian patent laws were amended in the year 2005 to make them compliant with TRIPS. Before 2005 product patents in chemical and pharmaceutical fields were unallowable, however, post 2005 the laws allow product patenting in these fields.

³BAYER ANIMAL HEALTH GMBH V. THE CONTROLLER GENERAL OF PATENTS & DESIGNS, IPAB, OA/18/2009/PT/DEL

⁴5. Inventions where only methods or processes of manufacture patentable

(1) In the case of inventions-

a. claiming substances intended for use, or capable of being used, as food or as medicine or drug, or

b. relating to substances prepared or produced by chemical processes (including alloys, optical glass, semi-conductors and inter-metallic compounds).

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In response, on being unsuccessful in convincing the examiner, the applicant went to the IPAB under appeal. The IPAB has held the following:

“The basis of a divisional application is the existence of a plurality of invention. This is a sine qua non for seeking a division of an application.”

In other words, the IPAB held that a divisional application is only valid once there is an existence of plurality of invention, irrespective of the fact whether the divisional application is filed voluntarily or on being asked by the examiner, and turned down the appeal.

In another case, called LG electronics case⁵, the applicant LG Electronics Inc., entered the national phase of an international patent application in the year 2004. The application got abandoned as the applicant was unable to convince the examiner as to the objections raised in the examination reports. The applicant then proceeded to file a divisional application, from the original patent application. The examiner raised certain objections that, the parent application did not contain a plurality of inventions to give cause to the divisional application.

In appeal, the applicant, LG Electronics, argued that the word ‘or’ in Section 16 (1) of the Act allows voluntarily filing of divisional applications by the applicant in even situations where there is a single invention.

The IPAB, while negating this argument stated that the usage of the word ‘or’ was conjunctive in its aim, i.e., even if the applicant wished to divide the patent application suo motu, it would have to be primarily based on the fact that the application contains a plurality of inventions not linked by a single inventive concept.

The IPAB set aside the above appeal and stated that the phrase ‘if he so desires’ in Section 16(1) of the Act is not unconditional, and does not give the applicant an unqualified liberty to file a divisional application even when there is no situation of plurality of distinct inventions contained in the parent application.

As it can be observed from the cases above, the filing of divisional applications for inventions which were not granted patents earlier is a misuse of section 16. To get one more chance for the grant of patent, applicants and agents fraudulently file divisional applications for inventions which were previously rejected.

Therefore, according to the new practice, an applicant is entitled to file a divisional application in one of the following scenarios:

1. Voluntarily with ~~or without~~ the presence of plurality of invention in the parent application,
OR
2. Once there is an objection by the examiner as to the plurality of the invention.

For a divisional application, it is important to keep in mind: (a) the parent application should contain subject matter which can be claimed in a divisional application; (b) the claims of the divisional application should be supported by the parent application; (c) the parent and divisional applications should not claim the same subject matter; (d) the divisional application should not include any matter which is not substantially disclosed in the parent application; and e) the divisional application should be filed before the grant of the parent application.



⁵LG ELECTRONICS, INC V. THE CONTROLLER OF PATENTS & DESIGNS, IPAB, OA/6/2010/PT/KOL