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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ C.A.(COMM.IPD-PAT) 471/2022

SYNGENTA LIMITED

..... Appellant

Through: Mr. Pravin Anand, Ms.  
Archana Shankar and Ms. Geetika Suri,  
Adv.

Versus

CONTROLLER OF PATENTS AND DESIGNS.....Respondent

Through: Mr. Sushil Kumar Pandey and  
Mr. Kuldeep Singh, Adv.

**CORAM:**

**HON'BLE MR. JUSTICE C.HARI SHANKAR**

**ORDER (ORAL)**

**26.07.2023**

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**C.A.(COMM.IPD-PAT) 471/2022**

1. This is an appeal under Section 117-A of the Patents Act, 1970, seeking to impugn the order dated 11 October 2017, passed by the Deputy Controller of Patents and Designs (“Deputy Controller”, hereinafter), whereby Application No. 7059/DELNP/2011, filed by the appellant as a Divisional Application under Section 16<sup>1</sup> of the

<sup>1</sup> 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.

(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.



Patents Act, arising out of Application 6114/DELNP/2005, dated 28 December 2005 (“the parent application”, hereinafter), seeking a patent for an “Agrochemical concentrate comprising an adjuvant and hydrotrope” has been rejected.

2. Mr. Pravin Anand, learned Counsel for the appellant has drawn my attention to Claim 1 in the parent application, which reads thus:

“1. An agrochemical concentrate having a continuous water-containing single phase characterised in that said continuous phase also comprises an oil-based adjuvant and a hydrotrope capable of solubilising said adjuvant in said continuous phase.”

3. As is apparent, Claim 1 includes, as an essential feature of the claimed invention, an oil based adjuvant and a hydrotrope capable of solubilising the adjuvant in the continuous phase. The adjuvant-hydrotrope combination is, therefore, empirical to the claimed invention – as is apparent even from the title of the patent application.

4. In the complete specification accompanying the aforesaid claim, and forming part of the parent application, the appellant proposed three preferred combinations of hydrotrope and oil-based adjuvants, for the purpose of Claim 1. The relevant part of the complete specifications read thus:

“(a) Benzosulphonate hydrotropes such as ammonium cumene sulphonate and ammonium xylene sulphonate in combination with fatty alcohols, fatty acids or fatty amines and simple derivatives thereof such as methyl esters and adjuvant

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(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.



oils derived from plant terpenes.

(b) Anionic alkylaryl carboxylate hydrotropes such as the potassium salt of 5(6)-carboxy-4-hexyl-2-cyclohexene-1-octanoic acid (commercially available under the trade name WESTVACCO H240) in combination with fatty alcohols, fatty acids or fatty amines and simple derivatives thereof such as methyl esters and short chain ethoxylates, especially when these materials are also blended with linear or branched mineral oils.

(c) Phenol type hydrotropes, such as sodium salicylate, in combination with long chain ethoxylate versions of synthetic or fatty acids, alcohols and amines.”

5. Subsequently, on 15 September 2011, the appellant filed a Divisional Application No. 7059/DELNP/2011, in which Claim 1 read thus:

“1. An agrochemical concentrate having a continuous water-containing phase said continuous phase comprising an oil-based adjuvant and a hydrotrope capable of solubilising said adjuvant in said continuous phase; *where the adjuvant is selected from long chain ethoxylate versions of synthetic or fatty acids, alcohols and amines; and the hydrotrope is a phenol type hydrotrope; and the ratio of the adjuvant to the hydrotrope is from 1:10 to 10:1.*”

6. Thus, in the Divisional Application, Claim 1 included the specified combination (c) of the three preferred combinations contained in the complete specifications of the parent application as the adjuvant-hydrotrope combination for Claim 1.

7. Consequent on filing of the aforesaid Divisional Application under Section 16 of the Patents Act, First Examination Report (FER) was issued by the Patent Office on 27 December 2015, the response thereto was filed by the appellant on 14 March 2016, personal hearing was granted to the appellant on 8 February 2017 and, on 11 October 2017, the impugned order came to be passed.



8. In para 7 of the impugned order, the Deputy Controller identifies the issue arising before him as “whether the application falls within Sections 16 and 2(1)(ja)<sup>2</sup> or not”. [Section 2(1)(ja) is of no particular relevance to the controversy at hand.] The reasoning of the Deputy Controller in arriving at his decision, reads thus:

“The heading of Section 16 reads as "Power of Controller to make orders respecting division of application". A careful reading of section 16 in conjunction with section 7 and Section 10(5) revealed that this heading implies that even if the applicant files an application suo moto which is purportedly an application diverted out of another application. *The Controller is under obligation to see whether the parent application from which the impugned application has been divided truly comprises of plurality of inventive concepts. If not there is no reason that the Controller would exercise his power to divide the application.* Section 16(3) empowers the Controller to ensure that the claims of the parent and divisional application do not consist of claims of same scope, i.e., the Controller is bound to see that the divisional application must not claim the same claims of parent application. This is also supported by IPAB order no.111 of 2011.

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 supported by Narayanan, in paragraph 3-44 of Patent Law by P. Narayanan [4th Edition 2006 page No.60]

It is therefore clearly evident that the intended purpose of the statutory provisions under section relating to division of application is

- 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. The Hon'ble IPAB dealt the divisional application case in the following orders:

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<sup>2</sup> (ja) “inventive step” means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art  
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(1) *LG Electronics INC, Korea vs. Controller of Patents & Designs, Kolkata and others-IPAB Order No.III of 2011*- where it was held that the words "if so desires" in Section 16 **does not mean that even if there is no plurality of invention, the patentee may seek division.**

(2) *Sygenta Participations AG, Switzerland Vs. Union of India and Others-IPAB Order No. 19 of 2013* - Where it was held that plurality of invention is a *sine qua non*. The Controller has the power to make his orders in two situations. One, when the applicant desires it on his own and two, when the Controller raises an objection and the applicant seeks to remedy it. The word "Patent" means a patent for any invention granted under the Patents Act, 1970 (S. 2(m) of the Act). A patent shall be granted for one invention only (S. 46 (2) of the Act). Therefore, if there is a parent application, as in this case, and there is a divisional application, and both the parent application and the divisional application are accepted by the patent office and patents are granted, it logically means that one invention is protected by the parent application and one invention is protected by the divisional application. Without straining the simple language of the Act, without looking for any interpretative aids, it means just this that the applicant claims a patent for one invention under the parent application and for one invention under the division application. It cannot be otherwise.

(3) *Bayer Animal Health GMBH, Germany Vs. Union of India and Others - OA/18/2009/PT/DEL (IPAB Order No. 243 of 2012* - where the same view was taken.

In the present case, *there is no objection on plurality or under Section 10(5) of the Act in the first examination report of parent application.* The applicant has also changed the nature of claimed invention in divisional application after filing of amended claims which are neither part of parent application nor of divisional application.

*Thus if the applicant desires 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 parent application, which was granted, did not contain any claims relating to plurality of distinct invention. Interestingly, no objection relating to plurality of distinct invention was raised in First Examination Report (FER) in respect of the parent application. Instead, without complying with the requirements contained in the FER, applicant filed the instant application as divisional application on 15<sup>th</sup> September, 2011.



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 No7059/DELNP/2011 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.

Therefore I hereby order that the grant of patent is refused under the provisions of Section 15 of the Patents Act.

Dated this 11<sup>th</sup> October, 2017

Sd.  
(Dr. Rajesh Dixit)  
Deputy Controller of Patents & Designs”

9. Mr. Pravin Anand, learned Counsel for the appellant submits that the reasoning of the learned Deputy Controller is contrary to the statute, in the following two respects:

(i) The requirement of the claims of the complete specification in the parent application having to relate to more than one invention applies only where the divisional application is being filed following objections raised by the Controller. In other words, Section 16(1) envisages two circumstances, in which an applicant could file a divisional application, after having filed a parent application. The first is where the applicant does so *suo moto*, as is contemplated from the words “if he so desires”. The second is where the Controller raises an objection. Mr. Anand submits that it is only where the divisional application is based on an objection raised by the Controller that the objection has to be on the ground that the claims of the complete specification in the parent application relate to more than one invention.



(ii) The second error in the impugned order, submits Mr. Anand, is in the observation that the parent application did not contain any claims relating to plurality of inventions. Mr. Anand submits that the requirement of plurality of inventions was not necessarily limited to the claims in the parent application, but would also encompass situations in which the plurality of inventions were disclosed in the complete specifications in the parent application.

In view of the fact that the Deputy Controller has returned a finding that the parent application suffered from want of any plurality of inventions. Mr. Anand submits that both these issues arise for consideration in this case.

**10.** Mr. Sushil Kumar Pandey, learned Counsel appearing for the office of the Controller General of Patents, places reliance on the judgment of a coordinate Bench of this Court in *Boehringer Ingelheim International GMBH v. The Controller of Patents*<sup>3</sup>, rendered by Prathiba M. Singh, J., particularly to the following passages therefrom:

“28. From the above provisions, *it is clear that a divisional application under Section 16 of the Act, has to be an application which arises from a parent application disclosing a “plurality of inventions”. In Section 16(1), the phrase “the claims of the complete specification relate to more than one invention” makes this position clear.* Section 16(3) also makes it clear that there cannot be duplication of the claims in the two specifications i.e., parent specification and the divisional application. This leads us to the question as to how to determine “plurality of inventions”. For this, guidance can be drawn from

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<sup>3</sup> 2022 SCC OnLine Del 3777  
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Section 10 of the Act which elaborates on the meaning of complete specification and scope of claims.

29. Importantly, Section 10 of the Act clearly requires the applicant to define the scope of the invention. It provides that every complete specification has to:

- Begin with a title indicating the subject matter of the invention;
- Fully and particularly describe the invention;
- Fully and particularly describe the operation or use of the invention;
- Fully and particularly describe the manner which the invention has to be performed;
- Disclose the best method of performing the invention, which is known to the applicant and for which the applicant is entitled to claim protection;
- End with a claim or claims – the claims define the scope of the invention for which the protection is sought; and
- Have an abstract of the invention.

30. A perusal of these conditions as stipulated under Section 10 shows that the title indicates the subject matter of the invention. The content of the specification describes the invention. The complete specification also describes the procedures, processes, methods, including the best methods. But what is crucial to note, is the fact that the invention itself is defined in the claims. While such claims do have to be based on the disclosure in the specification, however even if a person does not read the complete specification and wishes to identify the invention, the place to look for it is in the ‘Claims’. The Invention thus resides in the Claims. Accordingly, “unity of the invention”/ “plurality of inventions” and whether they form a “single inventive concept” has to be gleaned from a reading of the claims. This position has been examined and held so by the IPAB as well in *ESCO Corporation v. Controller of Patents & Designs* [OA/66/2020/PT/DEL, decided on 27<sup>th</sup> October, 2020], where the IPAB observed:

“10. Therefore, looking at the provisions of law and the settled practices, we reach the following conclusions that a patent application can only be divided, if it claims





more than ‘one invention’. Now the question therefore is how “one invention” is defined. We look at the provisions of “unity of invention” as provided in section 10(5) of the Patents Act, 1970. It says ‘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’. Means if any specification claims either a single invention or a group of invention linked so as to form a single inventive concept, the requirement of “unity of invention” is satisfied. Hence, if there is no objection on the ground of ‘plurality of distinct inventions’ means the claims of the complete specification, contains either a single invention or a group of inventions linked so as to form a single inventive concept and in such a scenario, no divisional application is allowable.”

31. Using this understanding of how an invention is ascertained in a patent application, it is clear that under Section 16 of the Act, the *“plurality of inventions” should clearly exist in the claims of the original parent application and within the scope of the specification of the parent application.* Therefore, under Section 16, the question of whether the claims of the complete specification relate to more than invention i.e., a “plurality of inventions” *has to be seen from the claims of the parent application.* Obviously, the claims in turn, have to be based on the disclosure in the specification. However, *if the invention is not contained in the claims of the parent application, the divisional application cannot be permitted to be filed solely on the basis of disclosure made in the specification, in respect of alleged inventions.* If applicants are permitted to file such divisional applications on the basis of disclosure in the complete specification, without such inventions being claimed in parent applications, it would defeat the fundamental rule of patent law i.e., ‘what is not claim is disclaimed’. Similarly, Section 59 also makes it clear that amendments beyond the scope of the specification and claims would not be permissible. This is the settled legal position, as also held by this Court in *Nippon A&L Inc. v. The Controller of Patents*<sup>4</sup>, decided on 5th July, 2022]. Thus, the divisional application would be maintainable only when the claims of the parent application disclose “plurality of inventions”.

(Italics supplied; underscoring in original)

## 11. There can be no gainsaying of the fact that the impugned order

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is in tune with the observations and findings contained in the judgment in *Boehringer Ingelheim*<sup>3</sup>.

**12.** Mr. Anand, however, submits that *Boehringer Ingelheim*<sup>3</sup> may require a revisitation, as the findings of the Court therein appear to be contrary to the express statutory provisions. He has also placed reliance, in this context, on Article 4(G) of the Paris Convention for Protection of Industrial Property, which reads thus:

“(1) *If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.*

(2) *The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.*”

Mr. Anand submits that, thus, the Paris Convention envisages submission of a divisional application by an applicant either in the event of the examination of the parent application by the authority revealing that it contains more than one invention, or on his own initiative. The stipulation of the parent application containing more than one invention does not find any place in Article 4(G)(2), which deals with *suo moto* filing of divisional applications. Section 16(1) of the Patents Act, submits Mr. Anand, is in sync with Article 4(G) of the Paris Convention.

## **Analysis**



**13.** Having heard Mr. Anand, learned Counsel for the appellant and having perused the relevant statutory provisions, I must regretfully express my inability to agree with the view expressed by my learned sister in her judgment in *Boehringer Ingelheim*<sup>3</sup>, though I hold her expertise in the domain of intellectual property in the highest regard.

**14.** Is the requirement of the parent application containing a plurality of inventions applicable even where the divisional application is filed *suo motu* by the applicant, without any objection raised by the Controller?

**14.1** Accepting the interpretation placed on Section 16(1) in *Boehringer Ingelheim*<sup>3</sup> would, in my opinion, require us to rewrite the provision to read thus:

“(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 claims already filed in respect of the first mentioned application.”

We would, therefore, have to add a comma after the words “raised by the Controller” and replace the words “provisional or complete specification” with the word “claims”. Why, would become apparent hereinafter.

**14.2** To my mind, Section 16(1) of the Patents Act clearly envisages two circumstances in which a Divisional Application can be filed. A Divisional Application may be filed by the applicant of the parent application, *if he so desires*. The second circumstance in which a



Divisional Application is filed, is where the applicant seeks to remedy an objection raised by the Controller *on the ground that the claims of the complete specification relate to more than one invention.*

**14.3** I find this interpretation to be more in tune with the exact structure of Section 16(1), as though the section incorporates a comma after “if he so desires”, there is no such comma after “raised by the Controller”. If such a comma had been contained in the section after the words, “raised by the Controller”, then it might have been possible to hold that the requirement of the claims of the complete specification relating to a plurality of invention, was applicable both to cases where the Divisional Application was filed *suo moto* as well as where the Divisional Application was filed on an objection raised by the Controller. Where there is no comma after the words “the objection raised by the Controller”, however, it is plain that the requirement of the claims of the complete specification relating to plurality of invention is only relatable to the objection raised by the Controller.

**14.4** The oft-repeated aphorism that judgments cannot be read like statutes is a recognition of the equally settled position that statutes have to be read as they stand. Punctuation, in a statute, is often determinative of its construction. In its urge to accord, to a statutory provision, what the Court feels the legal position *ought to be*, the Court cannot ignore the syntactical structure in which the legislature has crafted the provision. While it is true that Courts have, of late, accorded primacy to the principle of purposive interpretation of



statutory provisions<sup>5</sup>, the Court cannot, in doing so, rewrite the statute. In *Indore Development Authority v. Manoharlal*<sup>6</sup>, while stressing on the importance of the placement of a colon in the statutory provision, the Supreme Court observed that there were “several other decisions, which support the proposition that punctuation marks, especially colons have a significant role in interpretation of words in a statute.”

**14.5** The importance of a comma – or rather its absence – stands underscored in the judgment of the Supreme Court in *Commissioner of Central Excise v. Indian Petrochemicals Corporation Ltd*<sup>7</sup> in which, while dealing with a Notification which granted partial exemption from payment of Central Excise duty to “liquefied petroleum gases and other gaseous hydrocarbons other than natural gas, ethylene, propylene, butylene and butadiene”, the Supreme Court, speaking through A.K. Sikri, J., approved, in its entirety, the following finding of the Customs, Excise and Service Tax Appellate Tribunal while interpreting the Notification:

“In the aforesaid Sl. No. 24 of Notification No. 5/2000, there is no comma after the words ‘gaseous hydrocarbons’. Therefore, the expression ‘other than’ appearing after the words ‘gaseous hydrocarbons’ and before the words ‘natural gas’ would qualify only the words ‘natural gas’.”

In *Mohd Shabir v. State of Maharashtra*<sup>8</sup>, the Supreme Court, dealing with the expression “manufacture for sale, or sell, or stock or exhibit for sale, or distribute any drug or cosmetic, except under, and in accordance with the conditions of, a licence issue for such purpose

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<sup>5</sup> Refer *Shailesh Dhairyawan v. Mohan Balkrishna Lulla*, (2016) 3 SCC 619 and *Richa Mishra v. State of Chhatisgarh*, (2016) 4 SCC 179

<sup>6</sup> (2020) 8 SCC 129

<sup>7</sup> (2015) 15 SCC 783

<sup>8</sup> (1979) 1 SCC 568



under this Chapter”, figuring in Section 18(c) of the Drugs and Cosmetics Act, 1940, emphasized the effect of the absence of a comma after the words “stocks or exhibits for sale” thus, in para 4 of the report:

“4. On an interpretation of Section 27, it seems to us that the arguments of Mr Singh are well founded and must prevail. The words used in Section 27, namely, “manufacture for sale”, “sells”, have a comma after each clause but there is no comma after the clause “stocks or exhibits for sale”. Thus the section postulates three separate categories of cases and no other: (1) manufacture for sale; (2) actual sale; (3) stocking or exhibiting for sale or distribution of any drugs. The absence of any comma after the word “stocks” clearly indicates that the clause “stocks or exhibits for sale” is one indivisible whole and it contemplates not merely stocking the drugs but stocking the drugs for the purpose of sale and unless all the ingredients of this category are satisfied, Section 27 of the Act would not be attracted.”

**14.6** That said, however, it is equally true that the Court should not allow itself to be swayed by punctuation in a statute where blind adherence would result in the statute being interpreted in a manner which is contrary to the plain legislative intent. In the present case, however, there is no reason to hold that, if the *absence* of the critical comma after the words “by the Controller” in Section 16(1) is accorded due importance, the statutory intent would be defeated. Rather, such a construction would, as I would presently observe, bring Section 16(1) in tune with the parallel provision in the Paris Convention, as Mr. Anand correctly submits.

**14.7** Plainly grammatically read, the requirement of the claims of the complete specification relating to more than one invention apply only to the second of these exigencies, i.e. where the Divisional Application is with a view to remedy an objection raised by the



Controller. In other words, if the applicant is seeking to file a Divisional Application to remedy of objection raised by the Controller, such an application would be maintainable only if the Controller's objection is on the ground that the claims of the complete specification related to more than one invention. If, however, the Divisional Application is being filed *suo moto* "if he so desires", this requirement, *prima facie*, does not apply.

**14.8** This interpretation is also in line with Article 4(G) of the Paris Convention, which does not appear to have brought to the notice of the Coordinate Bench in *Boehringer Ingelheim*<sup>3</sup>. Article 4(G) also envisages two distinct circumstances in which a divisional application may be filed. Article 4(G)(1) envisages such an application being filed on the FER revealing that the original application contains more than one invention. Article 4(G)(2) envisages *suo moto* filing of a Divisional Application by the parent applicant. The provision is clear and categorical in incorporating the requirement of plurality of inventions in the application only with respect to Article 4(G)(1). No such requirement is contained in Article 4(G)(2).

**14.9** *Prima facie*, the decision of the legislature not to incorporate a comma after "raised by the Controller" in Section 16(1) appears to be with a view to bring the provision in sync with Article 4(G) of the Paris Convention.

**14.10** As such, Mr. Anand appears to be correct in his submission that the requirement of a plurality of inventions being present in the original application would apply only to cases where the Divisional



Application is filed to remedy an objection raised by the Controller, and would not apply where the Divisional Application is filed *suo moto* by the applicant.

**15.** Assuming the parent application is required to contain a plurality of inventions, do the plurality of inventions have to be contained in the claims in the parent application or is it sufficient if they are disclosed in the disclosures forming part of the complete specifications in the parent application?

**15.1** The second objection raised by Mr. Pravin Anand also seems to be in tune with the statutory intent. Mr. Anand submits that assuming that the requirement of a plurality of inventions was necessary for a Divisional Application to be filed, that plurality could also be contained in the complete specifications accompanying the claims in the parent application, and was not necessarily required to be contained in the claims themselves.

**15.2** Section 16(1) uses two distinct expressions; “relate to” and “disclosed in”, and the significance of the use of these two distinct expressions cannot be overlooked.

**15.3** Where the Controller raises an objection on the ground that the claims of the complete specification in the parent application *relate to* more than one invention, the applicant may file a further application in respect of an invention *disclosed in* the provisional or complete specifications. While, therefore, the claims in the parent application must *relate to* a plurality of inventions – assuming, as the impugned order holds, this requirement to indeed be a *sine qua non* for a divisional application to be maintainable – it would suffice if the





divisional application is filed in respect of an invention (forming part of the plurality) *disclosed in the provisional or complete specifications*. The provision does not, as it stands, appear to require the plurality of inventions to form part of the claims in the parent application.

**15.4** Applying this principle to the case at hand, therefore, Claim 1 in the parent application relates to a plurality of inventions, as it would cover all cases where the single continuous phase comprises an oil based adjuvant and a hydrotrope. There could, therefore, be a multitude of adjuvant-hydrotrope combinations which could be encompassed by the claim. Three such combinations were disclosed in the complete specifications accompanying the claim. The divisional application of the appellant was filed in respect of one of such adjuvant-hydrotrope combinations and, therefore, “in respect of an invention disclosed in the provisional or complete specifications”.

**15.5** To my mind, the application could not have been rejected solely on the ground that the plurality of inventions was not specifically contained in the *claim*, and only in the *disclosure* contained in the complete specifications. Though *Boehringer Ingelheim*<sup>3</sup> supports this view, the interpretation would, in my opinion, be plainly contrary to the words used in Section 16(1) and cannot, therefore, *prima facie* sustain.

**15.6** In this context, Mr. Anand has also cited Section 10(4) of the Patents Act read with Form 2 accompanying the Patents Act in the Patent Rules which sets out the form both of provisional and complete



specifications. In respect of Serial No. 5, which deals with claims, the form specifically states thus:

“5. **CLAIMS** (*not applicable for provisional specification.* Claims should start with the preamble –“ **I/we claim**” on separate page).”

Mr. Anand has also invited my attention in this context to the Manual of the Patent Office Practice and Procedure which, in Clause 05.02.02, specifically states thus:

**“Contents of Provisional Specification**

a) A Provisional Specification shall essentially contain the title and description of the invention and shall start with a preamble “The following Specification describes the invention.” *Claims may not be included in the Provisional Specification* as the purpose of filing a Provisional Specification is to claim a priority date.”

Thus, submits Mr. Anand, a provisional application is not required to contain claims. Section 16(1) of the Patents Act permits a divisional application to be filed even in respect of an invention disclosed in the provisional specification filed in respect of the parent application. If the requirement of plurality of inventions being *claimed* in the parent application were to apply, therefore, no divisional application could ever be filed where the parent application contains only provisional specifications, as provisional specifications are not to include claims. Inasmuch as Section 16(1) permits divisional applications to be filed in respect of inventions disclosed *in provisional or complete specifications* in the parent application, the specification of plurality of inventions in the claim can never be an imperative.



**15.7** I find substance in the submission. It is apparently for this reason that Section 16(1) concludes with the words “filed a further application in respect of an invention *disclosed in the provisional or complete specifications* already filed in respect of the first mentioned application”. As such, the invention in respect of which the Divisional Application is filed is required to be disclosed only in the provisional or complete specification filed in respect of the parent application. The view, expressed in *Boehringer Ingelheim*<sup>3</sup> to the effect that the plurality of inventions must form part of the *claims* in the parent application, therefore, in my view, requires a revisitation.

**16.** The Coordinate Bench, in the paragraphs extracted hereinabove, however, has taken a view that (i) a divisional application can be filed only if the claims in the parent application relate to more than one invention and (ii) the plurality of inventions is required to be contained in the claims in the parent application and it is not sufficient if the plurality of inventions are to be found in the complete specifications accompanying the claims in the parent application.

**17.** As, for the reasons elucidated hereinabove, I am not able to convince myself that this is the correct position, I deem it appropriate to refer the following questions for consideration by a Division Bench of this Court to be constituted by and subject to orders of Hon’ble the Chief Justice:

- (i) Does the requirement of a plurality of inventions being contained in the parent application, in order for a Divisional



Application to be maintainable, apply even where the Divisional Application is filed by the applicant *suo moto*, and not on the basis of any objection raised by the Controller?

(ii) Assuming that the requirement of a plurality of inventions in the parent application *is* necessary for a Divisional Application to be maintainable, does the plurality of inventions have to be reflected in the *claims* in the parent application or is it sufficient if the plurality of inventions is reflected *in the disclosures in the complete specifications* accompanying the claims in the parent application?

**18.** The Registry is directed to place this matter before Hon'ble the Chief Justice for constituting an appropriate Division Bench to examine the aforesaid issues and return its view thereon, as they affect a large number of cases.

**C.HARI SHANKAR, J**

**JULY 26, 2023**

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