



2023-DHC: 7473-DB



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

% **Judgment reserved on: 25 September 2023**  
**Judgment pronounced on: 13 October 2023**

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

SYNGENTA LIMITED .... Appellant

Through: Mr. Pravin Anand, Ms. Archana  
Shanker, Ms. Gitika Suri and  
Mr. Ashutosh Upadhyaya,  
Advs.

versus

CONTROLLER OF PATENTS AND DESIGNS

..... Respondent

Through: Mr. Sushil Kumar Pandey and  
Mr. Kuldeep Singh, Advs.  
Mr. Rajiv Kumar Choudhary  
and Mr. Vikram Singh Dalal,  
Advs. for Intervenor.

**CORAM:**

**HON'BLE MR. JUSTICE YASHWANT VARMA**

**HON'BLE MR. JUSTICE DHARMESH SHARMA**

## **J U D G M E N T**

### **YASHWANT VARMA, J.**

1. A learned Single Judge of the Court doubting the correctness of the view expressed in **Boehringer Ingelheim International GMBH vs. The Controller of Patents**<sup>1</sup> has referred the following questions

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<sup>1</sup> 2022 SCC OnLine Del 3777



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for our consideration: -

“(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?”

2. The issue arises in the context of Section 16 of the **Patents Act, 1970<sup>2</sup>** which enables the applicant to file a Divisional Application either of its own motion or consequent to an objection raised by the Controller. The principal contestation centers upon the question whether the plurality of invention is liable to be found in the parent claims or would it also extend to being discerned from the provisional or complete specification that may have accompanied the application for grant of a patent. The aforesaid issue forms the core of question (ii). Question (i) flows from the learned Judge concluding that where a Divisional Application is made to remedy an objection raised by the Controller the plurality of inventions must stand embodied in the claims.

3. For the purposes of answering the questions that stand formulated, the following salient facts may be noticed. The appellant Syngenta is a corporation organized under the laws of the United

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<sup>2</sup> The Act



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Kingdom and is stated to be involved in research and development in varied fields such as chemicals, agriculture, healthcare related products, and engaged in the manufacturing and distribution of those products worldwide.

4. On 28 December 2005, it made an application to the Controller in respect of its invention pertaining to an agrochemical concentrate comprising an adjuvant and a hydrotrope containing 14 claims. Claim 1, as it stood embodied in the original application, read as follows: -

“ 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.”

5. On 15 September 2011, the appellant filed a Divisional Application purporting to amend claim 1 to read as under:-

“ 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. A request for examination of the Divisional Application was filed in terms of Section 11B of the Act read along with the Rule 24 B of the **Patents Rules, 2003**<sup>3</sup>. The original application was granted after examination on 01 May 2012 as IN252191. The Divisional Application thereafter came to be published on 08 February 2013 in the Patents Journal. The said application was examined by the

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<sup>3</sup> 2003 Rules



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Controller and a **First Examination Report**<sup>4</sup> was issued on 27 December 2015.

7. Responding to the FER, the appellant submitted its response on 14 March 2016. After affording an opportunity of hearing to the appellant, the Controller by an order of 11 October 2017, proceeded to refuse the Divisional Application observing as follows: -

“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 15th 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.”

8. As would be evident from a reading of the conclusions as recorded by the Controller, it is apparent that it has proceeded on the

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<sup>4</sup> FER



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premise that for a Divisional Application to be maintainable, the disclosure of more than one invention must necessarily be embodied in the parent application. The Controller took the view that since the parent application did not contain any claims relating to plurality of a distinct invention, the Divisional Application was liable to be refused. The Controller has additionally taken into consideration the fact that the appellant had, while responding to the FER, raised no objection relating to plurality of inventions.

9. It becomes relevant to note that while the Controller does not specifically allude to *Boehringer Ingelheim*, the view as taken by it would appear to be in conformity with the principles that came to be enunciated by a learned Judge of the Court in that decision. This aspect has been duly noticed by the learned Single Judge while proceeding to frame the present reference. In *Boehringer Ingelheim*, the position in law came to be propounded in the following terms: -

“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 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 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 [C.A. (COMM. IMPD-PAT) 11/2022, decided on 5 July, 2022]. Thus, the divisional application would be maintainable only when the claims of the parent application disclose “plurality of inventions”.*

10. As is evident from the aforesaid passages, the Court in *Boehringer Ingelheim* has taken the position that if the plurality of inventions is not contained in the claims of the parent application, the Divisional Application would not be maintainable. The learned Single Judge further proceeded to significantly observe that a Divisional Application would neither be maintainable nor could one be permitted to be filed solely on the basis of disclosures made in the specification.



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In *Boehringer Ingelheim*, the learned Judge further observed that permitting the filing of such Divisional Applications even though plurality of inventions are not mirrored or found in the claims would run contrary to the fundamental rule of patent law, namely, “*what is not claimed is disclaimed*”.

11. The learned Judge while referring the questions for our consideration had taken due note of Article 4G of the Paris Convention for Protection of Industry Property and the said aspect has been also been commended for our consideration and acceptance by Mr. Anand in these proceedings. Article 4G reads as follows: -

“(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.”

12. While differing with the interpretation accorded to Section 16(1) in *Boehringer Ingelheim*, the learned Judge has come to conclude that acceptance of the position as mooted in that decision would amount to Section 16(1) being rewritten and has observed as under: -

“**14.1** Accepting the interpretation placed on Section 16(1) in *Boehringer Ingelheim* 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.”

13. According to the learned Judge, *Boehringer Ingelheim* fundamentally reconstructs Section 16 and essentially erases the phrase “*disclosed in the provisional or complete specification already filed*” and substituting it with the word “claims”. The learned Judge has thus come to conclude that the interpretation accorded to Section 16 in *Boehringer Ingelheim* cannot be countenanced.

14. Mr. Anand learned counsel while supporting the opinion as expressed by the learned Judge while doubting the correctness of *Boehringer Ingelheim*, submitted that the conditions on the basis of which Section 16 may be invoked would be as follows:-

“The said conditions / criteria as provided by the Section 16 of the Indian Patents Act, are as follows:

- a. a time limit (“at any time before the grant of the [parent] patent”, subsection 1), i.e during the pendency of the main/ parent application;
- b. a disclosure requirement (“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”: subsection 1); and
- c. a content limit (“such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application”: subsection 2)”

15. According to learned counsel, bearing in mind the structure of



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Section 16 as explained above, the maintainability of a Divisional Application is a question which must be answered independent of the outcome of the parent application. Mr. Anand highlighted the fact that Section 16, and more particularly the Explanation thereof, is evidence of the statute intending and ordaining the Divisional Application to be treated as a substantive and independent application in its own right. According to Mr. Anand, the only proscription which Section 16 introduces is of there being no duplication of claims between the parent and the Divisional Application. This learned counsel points out would clearly be evident from a reading of Section 16(3) of the Act.

16. We note from the referral order that the learned Judge had attached great significance to the punctuation mark which has been placed after the phrase “if he so desires” and on the basis of which it was opined that if the requirement of claims of the complete specification relating to plurality of inventions were applicable to both contingencies, namely where the Divisional Application is filed suo moto or where it comes to be preferred to remedy an objection raised by the Controller, the provision would have been structured differently. Based on the aforesaid understanding, the learned Judge has proceeded to observe that the issue of plurality of inventions being embodied in the original claim would be a restrictive condition which would only apply in a situation where the Divisional Application comes to be filed based on an objection raised by the Controller.

17. In our considered opinion, the placement of a comma after the



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phrase “if he so desires” pales into insignificance bearing in mind the position which emerges on a plain reading of Section 16(1) and which divides the two contingencies spoken of by using the word “or”. In our considered opinion, therefore, the filing of a Divisional Application either suo moto by the applicant or while meeting an objection raised by the Controller, would have to be answered on identical lines.

18. We note that Section 16(1) in unambiguous terms enables the filing of a further application in respect of an invention, provided it is disclosed in the provisional or complete specification already filed. As the learned Judge rightly observes there appears to be no justification to restrict the filing of a Divisional Application only to a situation where the plurality of inventions is found in the claims. The significance of the provision using the expression “*disclosed in the provisional or complete specification*” can neither be ignored nor discarded. While it would have been open for the Legislature to restrict the amplitude of that provision by stipulating that plural inventions must be embodied or be identifiable from the claims as originally filed, it has in unequivocal terms provisioned for the same being discernible from the provisional or complete specification. The provision as structured neither leaves any space of ambiguity nor does the language of the text warrant any doubt being harbored in respect of the clear intent of the provision. We thus find ourselves unable to concur with the interpretation placed upon that provision in *Boehringer Ingelheim*.



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19. We also find merit in the contention of Mr. Anand that the restrictive interpretation that was accorded to Section 16(1) in *Boehringer Ingelheim* would also not sustain when one bears in mind the provisions made in the Manual of the Patent Office Practice and Procedure and which, while dealing with the contents of a provisional specification in clause 05.02.02 provides as follows: -

**“ 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.””

20. As is manifest from a reading of the aforesaid extracts of the Manual, a provisional specification which is tendered to the Controller, may not include any claims at all. It is this significant facet which additionally convinces us to hold that *Boehringer Ingelheim* was clearly decided incorrectly when it held that the existence of plural inventions must be found in the claims. If that were accepted to be the correct interpretation and meaning to be ascribed to Section 16(1), it would lead to an incongruous situation where no Divisional Application could be possibly filed when only a provisional specification has been submitted.

21. We are also inclined to agree with the submission of Mr. Anand, who draws our attention to the fact that Section 16(1) does not employ the expression “disclosed and claimed” or “claimed” in the latter part of that provision. The provision only speaks of inventions



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“disclosed in the provisional or complete specification”. We thus find no justification to read Section 16 of the Act as prescribing that plural inventions must be found or stand reflected in the claims. In fact, such an interpretation would amount to rewriting the provision itself. The view to the contrary as propounded in *Boehringer Ingelheim* is, thus, disapproved.

22. Mr. Anand also sought to buttress his submissions based on Article 4G of the Paris Convention and the obligation of signatory States to amend their independent statutes so as to accord recognition to a right of an applicant to move Divisional applications in addition to a Divisional Application being moved where plurality of inventions is revealed upon examination. Article 4G clearly embodies the concept of Divisional Applications being filed. The said Article had also left it open to signatory States to determine and prescribe the conditions subject to which such applications may be considered. Learned counsel thus clearly appears to be correct in his submission that Section 16(1) corresponds and seeks to accord statutory recognition to Article 4G.

23. Before the learned Judge, it appears to have been urged that the restriction of more than one invention being found in the claims as originally filed, would be applicable only in a situation where the Divisional Application is triggered by an objection that may be raised by the Controller. This submission was accorded prima facie approval with the learned Judge observing thus: -



“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.”

24. However, the appellant has in the written submissions filed before us taken the following position: -

“ **28.** Where the Controller raises an objection 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 complete specification. For a lack of unity objection under section 10(5) to have been triggered, the Controller must have objected that the claims presented for examination in the parent application relate to more than one invention. Even in this case, the Divisional invention need not be based on the claims of the complete specification and in accordance with the wording of Section 16(1) may simply be an invention disclosed in the complete specification.

**29.** The same is true for suo moto (voluntary divisional). That an invention may be disclosed but not claimed is evident from the Indian provisions. Section 10(4) of the Patents Act read with Form 2 accompanying the Patents Act in the Patent Rules 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).”

25. We, on due consideration of Section 16, fail to find or perceive an intended distinction or dichotomy with respect to the filing of Divisional Applications based on whether the same is filed suo moto or is activated by an objection that may be raised by the Controller. Section 16(1) does not appear to warrant any such distinction being carved out. We are thus of the firm opinion that irrespective of



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whether the Application is filed by the applicant suo moto or to remedy an objection raised by the Controller, the Divisional Application could well be maintained in either of those situations, subject to the plurality of inventions being evidenced from the disclosures made in either the provisional or the complete specification.

26. Mr. Anand had also drawn our attention to the decision rendered by the High Court of Justice Chancery Division Patents Court in **Koninklijke Philips Electronics NV v. Nintendo of Europe GmbH**<sup>5</sup> where the issue of a Divisional Application being maintained had fallen for consideration. The contention of the respondents as urged before the High Court were noticed as under: -

“**106.** Nintendo contends that the proposed amendments to the claims should not be allowed as they would introduce added matter contrary to s76(2) of the 1977 Act. It submits that the approach to be taken is the one set out by Aldous J in *Bonzel v Intervention* [1991] RPC 553 and *Vector v Glatt (CA)* [2008] RPC 10. There was no dispute about the general approach to be taken. One has to compare the disclosures of the application and the patent and ask if anything relevant to the invention has been added. The documents are read through the eyes of a person skilled in the art, imbued with the common general knowledge. The documents are read as a whole. When looking to see what is disclosed in the application one needs to consider not only what is expressly disclosed but what is necessarily implicit but obviousness is not the test. The fact an idea is obvious over the application does not permit its addition to a patent. The test is strict in that matter disclosed in the patent which is not clearly and unambiguously derivable from the application is added matter.

**107.** However, as Philips emphasised, the English Courts have long recognised a distinction between an amendment which merely

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<sup>5</sup> [2014] EWHC 1959 (Pat)



broadens the coverage but does not disclose any new matter and one which discloses new matter (see *AC Edwards v Acme* [1992] RPC 131, *Texas Iron Works* [2000] RPC 207 and *AP Racing v Alcon* [2014] EWCA 40). The principle is not in dispute but its application can be tricky. Take the facts of *AP Racing*. The claim as granted included a feature (asymmetric peripheral stiffening band (PSB)) which was a generalisation from the disclosure of the application. The application included a clear and unambiguous disclosure of PSBs which would fall within the claim but it did not describe them in that general way. Floyd LJ held that although the claim covered asymmetric PSBs in general, it did not disclose any configuration of PSB which is not disclosed in the application. This does not mean that any generalising amendment is allowable but it emphasises that the fact an amendment is a generalisation does not necessarily mean it is unallowable.

**108.** Nintendo referred to the discussion of a particular kind of added matter known as "intermediate generalisation" described by Pumfrey J in *Palmaz* [1999] RPC 47 and approved in the Court of Appeal in *LG Philips v Tatung* [2007] RPC 21 and in *Vector v Glatt*. The passage from Pumfrey J's judgment is as follows:

If the specification discloses distinct sub-classes of the overall inventive concept, then it should be possible to amend down to one or other of those sub-classes, whether or not they are presented as inventively distinct in the specification before amendment. The difficulty comes when it is sought to take features which are only disclosed in a particular context and which are not disclosed as having any inventive significance and introduce them into the claim deprived of that context. This is a process sometimes called "intermediate generalisation."

27. In the said decision, the prohibition against double patenting was explained in the following terms: -

**“290.** I have dealt above with the various language objections to the proposed amendments to the claims of the 498 and 650 patents and identified which sets of claims are formally allowable. That leaves the issues of novelty and inventive step but also a further objection to the amendments taken by Nintendo. It submitted that even if the amendments to the 498 patent were formally allowable, they should not be permitted by this court in the exercise of its discretion, because they would lead to double patenting. If the





matter was before the EPO they would be refused by the EPO for double patenting. The submission that they would be refused in the EPO is important because the court's discretion to allow amendments under s75 of the 1977 Act is now limited. Section 75(5) requires the court to have regard to the relevant principles applied in the EPO.

**291.** I start with identifying what double patenting is. Section 18(5) of the 1977 Act provides that:

"Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the comptroller may on that ground refuse to grant a patent in pursuance of more than one of the applications."

**292.** Thus the Comptroller is able to stop an applicant with two effectively identical patent applications from getting two identical patents. At first sight the logic of this is simple enough. It is hard to see why an applicant might want two such patents anyway but one can see that if an applicant did file two truly identical applications then it could lead to trouble and confusion for third parties. The Comptroller is therefore authorised to prevent it and refuse to grant more than one of them.

**293.** Where the double patenting question becomes more significant is when it is applied to cases in which the two patents are not identical to each other in form but are found as a matter of substance to be for the same invention. An example of the application of s18(5) by a Hearing Officer for the Comptroller is IBM's (Barclay and Biggar's) Application [1983] RPC 283.

**294.** Section 18 is in Part 1 of the 1977 Act and applies to national (i.e. UK) applications being dealt with by the Comptroller. It does not apply to applications pending before the EPO. However Art 139(3) EPC permits but does not require contracting states to enact a similar double patenting prohibition dealing with parallel national and EP patents. The United Kingdom has implemented such a provision in s73(2) of the Act. It deals with double patenting when an EP (UK) patent and a national UK Patent have been granted for the same invention with the same priority date with the same applicant. In that case the Comptroller will revoke the national UK patent but before doing so the patentee is given the chance to make amendments to the claims to remove the problem.

**295.** Section 73(2) was considered by the Court of Appeal in



Marley's Roof Tile [1994] RPC 231. In that case Aldous J at first instance had decided that while the words "same invention" did not require identity they did require practical similarity. He held that the purpose of the section was not to prevent overlapping monopolies since that was dealt with by s2(3) of the 1977 Act and so the fact that a product might infringe claims of both patents did not mean the section applied. On the facts Aldous J found for the patentee. On the Comptroller's appeal to the Court of Appeal the court (Balcombe, Butler Sloss and Mann LJ) overturned Aldous J's decision. They noted that the argument that the purpose of s2(3) was to prevent double patenting had been rejected by the House of Lords in *Asahi* [1991] RPC 485. They held that the judge's construction that the section was not to prevent overlapping monopolies would make it easy to evade and that the correct construction was what the Court identified as the literal one. If the claims of the two patents cover the same invention then the section is engaged regardless of whether other linked inventions are also covered by the claims of either patent. Thus the Court of Appeal's judgment held that this double patenting provision in s73(2) applied to overlapping claims and not only to claims which were or the same (or practically the same) scope.

**296.** In the EPO the question of double patenting arises in the context of divisional applications. The EPO examiner may raise a double patenting objection to the claims of a later divisional application. The objection may be taken as a ground for refusing proposed claim amendments. The objection can be overcome by appropriate amendments. Many issues relating to divisional applications were reviewed by the Enlarged Board of Appeal in a decision on 28 June 2007 based on two references *G1/05 Divisional/ASTROPOWER* and *G1/06 Sequences of Divisionals/SEIKO*. At paragraph 13.4 the EBA said:

"13.4 The Board accepts that the principle of prohibition of double patenting exists on the basis that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor. Therefore, the Enlarged Board finds nothing objectionable in the established practice of the EPO that amendments to a Divisional application are objected to and refused when the amended Divisional application claims the same subject-matter as a pending parent application or a granted parent patent. However, this principle could not be relied on to prevent the filing of identical applications as this would



run counter to the prevailing principle that conformity of applications with the EPC is to be assessed on the final version put forward (see point 3.2 above)."

(My emphasis. The last sentence of the quoted paragraph relates to a different point – whether the objection could be taken to prevent even the filing of an application from the outset. The EBA held it could not.)

297. Historically the general approach of the EPO was that the objection was taken to ensure that the subject matter of the Divisional differed from the parent. The objection had not been taken if all that had happened was that a claim in a parent patent and a claim in a Divisional overlapped in their coverage. However Nintendo cited the decision of Board of Appeal 3.3.07 in **T307/07 (ARCO/Double Patenting)** on 3rd July 2007. In that case the Board deduced from Art 60 that the EPC prohibits double patenting. The first sentence of Art 60 provides that the "right to a European patent shall belong to the inventor or his successor in title" (my emphasis)."

28. Proceeding then to explain the objectives sought to be achieved by permitting the patentee to apply for division, the High Court observed as follows: -

“308. Seventh, a patentee may have a legitimate interest in obtaining a divisional patent with claims which are broader than but encompass the scope of a parent patent. During prosecution of the parent the examiner may object to a broad claim but indicate that a narrower claim would be accepted. The patentee may not agree but may recognise that to win the point will need many more months or even years of proceedings and possibly appeals. This is true in both the EPO and UKIPO. However in the meantime the patentee may want to obtain an early grant because a competitor has launched an infringing competitive product. The infringing product may be very close to the patentee's invention and within the narrow claim on offer. At an early stage in this new market for a new product the patentee's business may be particularly vulnerable and the loss caused by the infringement may well not be fully compensatable in damages under s69 of the 1977 Act (Art 67 EPC). Thus the patentee decides to take what is on offer and obtain grant of the parent patent with a narrow claim. Under s76 of the Act and Art 123(3) EPC post grant amendments are not permitted



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to widen the scope of monopoly so, in order not to give up scope to which the patentee is entitled, a divisional application is filed. If the Divisional is granted with a broader scope than the parent then the patentee's stance has been entirely vindicated.”

The aforesaid position would also commend acceptance in the context of our Act also.

29. We also agree with the submission of learned counsel appearing for the intervener when he contended that the precept of “*what is not claimed is disclaimed*” has no application to drafting of claims. The aforesaid principle was first formulated by Lord Russel who in his opinion in **Electric and Musical Industries Ltd. et al vs. Lissen, Ltd. et al.**<sup>6</sup> had held as under: -

“The function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed. The claims must undoubtedly be read as part of the entire document, and not as a separate document; but the forbidden field must be found in the language of the claims and not elsewhere. It is not permissible, in my opinion, by reference to some language used in the earlier part of the specification to change a claim which by its own language is a claim for one subject-matter into a claim for another and a different subject-matter, which is what you do when you alter the boundaries of the forbidden territory. A patentee who describes an invention in the body of a specification obtains no monopoly unless it is claimed in the claims. As Lord Cairns said, there is no such thing as infringement of the equity of a patent (*Dudgeon v. Thomson*, L.R. 3 App. Cas. 34).”

30. As is manifest from the above, while the aforesaid doctrine may be relevant for infringement analysis, it has no application to the subject of divisional filing and claim drafting. There thus does not

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<sup>6</sup> (1939) 56 R.P.C. 23



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appear to be any justification to impute the principle of “what is not claimed is disclaimed” for the purposes of discerning the scope of Section 16. This more so when the language of Section 16 in clear terms requires the plurality of inventions to be gathered from disclosures made either in the provisional or the complete specification.

31. We find ourselves unable to subscribe to the view expressed in *Boehringer Ingelheim* and when it seeks to base its conclusions on the precept as formulated by Lord Russel for the following additional reasons. It would be apposite to recall that Section 16 speaks both of a provisional or a complete specification. However, in the case of a provisional filing, claims need not be specified at all. If the view as expressed in *Boehringer Ingelheim* were to be accepted no Divisional Application would be maintainable in a case where a provisional specification has been presented. This since the decision bids us to discover the invention solely in the claim.

32. We thus find ourselves unable to concur with the view as expressed in *Boehringer Ingelheim* and the said judgment shall consequently stand overruled. We hold that a Divisional Application moved in terms of Section 16 of the Act would be maintainable provided the plurality of inventions is disclosed in the provisional or complete specification that may have been filed. We are further of the considered opinion that Section 16 does not suggest or conceive of a distinction between the contingency of a Divisional Application when

