IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
COMMERCIAL MISCELLANEOUS PETITION NO.7 OF 2022

Chitra Vasant Savangikar and another … Petitioners
Vs.
The Patent Office of India through Controller General of Patents, Designs and Trade Mark and another … Respondents

Mr. Nitesh Bhutekar a/w. Ms. Priyanka Lanke and Mr. Sushant Valimbe for Petitioners.
Mr. Yashodeep Deshmukh a/w. Mr. Ashutosh Misra and Ms. Vaidehi Pradeep for Respondents.

CORAM : MANISH PITALE, J.
DATE : APRIL 21, 2025

P.C. :

. Heard learned counsel for the parties.

2. By this petition, the petitioners have challenged decision / order dated 08.09.2021 passed by respondent No.2 - Controller of Patents. By the said decision, the respondent No.2 has refused to proceed further with a divisional application moved on behalf of the petitioners under the provisions of the Patents Act, 1970 (hereinafter referred to as the 'Patents Act').

3. In the present case, the petitioners filed their application for grant of patent on 23.06.2017 in respect of a *Chlorophyllin* composition concerning treatment of kidney disease patients for decrease in serum creatinine level and a corresponding increase in hemoglobin level. The said application was in active consideration and during this period, on 12.05.2020, the petitioners filed divisional application for *Chlorophyllin*

composition, according to the petitioners, without restricting the same to any specific use and also without limiting the same for treatment of kidney disease patients. The respondent No.2 issued the First Examination Report (FER) granting last date for response to the same as 06.07.2021. The petitioners filed their reply to the FER on 03.07.2021, stating in detail as to why the divisional application of the petitioners could not be objected to in the manner indicated by the respondent No.2.

4. In this backdrop, on 07.07.2021, the respondent No.2 issued hearing notice specifically stating two objections in respect of the divisional application filed on behalf of the petitioners. The hearing was conducted on 10.08.2021 and thereafter, on 21.08.2021, the petitioners submitted their written submissions, again dealing with the objections raised on behalf of the respondent No.2 in detail and indicating as to why according to the petitioners, the statutory requirements of the Patents Act were duly satisfied and that the divisional application deserved to be granted.

5. Thereafter, on 08.09.2021, the respondent No.2 issued the impugned decision holding that the divisional application submitted on behalf of the petitioners did not satisfy the requirements of the Patents Act, particularly Sections 10(5), 16 and 46(2) thereof. On this basis, the respondent No.2 refused to proceed further with the divisional application. The petitioners are aggrieved by the said order.

6. Mr. Nitesh Bhutekar, learned counsel appearing for the petitioners submitted that the respondent No.2 failed to appreciate the true scope of the relevant provisions of the Patents Act and in that context, the contents of the first application for grant of the aforesaid patent and the contents of the divisional application filed subsequent thereto. It was submitted that clear distinction could be made out between the two applications, indicating the distinct inventions and that, in such a

situation, on a proper reading of the definition of the term 'invention' under Section 2(1)(j) of the Patents Act and the true purport of Section 10(4)(c) and (5) read with Section 16 thereof, the respondent No.2 ought to have allowed the divisional application. Attention of this Court was specifically invited to the amended application at exhibit-H to the present application, particularly to the claims made in the amended application, to highlight the distinction and differences with the first application for grant of patent in respect of *Chlorophyllin* composition filed on behalf of the petitioners. It was submitted that a proper appreciation of such differences would clearly show that the statutory requirement was satisfied and that therefore, the impugned order deserved to be set aside. It was submitted that the divisional application ought to have been allowed and that the respondent No.2 erred in refusing to exercise power, as a statutory authority, on a proper reading of the provisions of the Patents Act, particularly Section 16 thereof.

7. On the other hand, Mr. Yashodeep Deshmukh, learned counsel appearing for the respondents submitted that in the facts and circumstances of the present case, the impugned decision passed by the respondent No.2 is justified. It was submitted that the scheme contemplated under the Patents Act pertaining to the divisional application was properly appreciated by the respondent No.2 and in the absence of plurality of inventions in the first application itself, the divisional application was correctly refused by the respondent No.2. A table of comparison was tendered to show the granted claims under the first application and the claims made in the divisional application on behalf of the petitioners. It was submitted that the invention pertaining to *Chlorophyllin* composition was one and the same in both the applications and in the absence of plurality of inventions, there was no question of allowing the divisional application. It was submitted that the petitioners were seeking to broaden the scope and use of their invention,

which they themselves, for reasons best known to them, had restricted in the first application. The facility of filing a divisional application under Section 16 of the Patents Act is not available merely because the applicant intends to broaden the scope or use of the invention. In the first place, the applicant is required to demonstrate plurality of inventions in the first application itself in order to maintain a divisional application. Reference was made to the contents of the written submissions submitted on behalf of the petitioners, in order to support the aforesaid submission and to highlight that the understanding of the position of law on the part of the petitioners was erroneous, and that no flaw can be attributed to the impugned decision passed by the respondent No.2.

8. Reliance was placed on judgement of the Division Bench of the Delhi High Court in the case of *Syngenta Limited Vs. Controller of Patents and Designs*, **2023 SCC OnLine Del 6392**, to emphasize that plurality of inventions has to be made out in the disclosures given by the applicant in the provisional or complete specifications and that, in the absence of the aforesaid situation, the divisional application cannot be entertained. On this basis, it was submitted that the petition deserved to be dismissed.

9. This Court has considered the rival submissions in the light of the documentary material placed on record. Before appreciating the aforesaid material and the rival submissions in that context, a reference to the relevant statutory provisions is necessary. The relevant statutory provisions for deciding the present petition are as follows:-

> "**2. Definitions and interpretation**.—(1) In this Act, unless the context otherwise requires-
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> (j) '*invention*' means a new product or process involving an inventive step and capable of industrial application;
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> * * * * *
>
> (m) '*patent*' means a patent for any invention granted under

this Act;

10. Contents of specifications.—(1) Every specification, whether provisional or complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates.

* * * * *

(4) Every complete specification shall—

(a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;

(b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and

(c) end with a claim or claims defining the scope of the invention for which protection is claimed;

(d) be accompanied by an abstract to provide technical information on the invention:

Provided that—

(i) the Controller may amend the abstract for providing better information to third parties; and

(ii) if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b), and if such material is not available to the public, the application shall be completed by depositing the material to an international depository authority under the Budapest Treaty and by fulfilling the following conditions, namely:—

(A) the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;

(B) all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository institution and the date and number of the deposit of the material at the institution;

(C) access to the material is available in the depository institution only after the date of the application of patent in India or if a

priority is claimed after the date of the priority;

(D) disclose the source and geographical origin of the biological material in the specification, when used in an invention.

* * * * *

(5) The claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.

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.

(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."

10. Apart from the above-quoted provisions of the Patents Act, it is relevant to note that the form of application for grant of patent under

Section 7 of the Patents Act specifies that such an application shall be for one invention only and that, it shall be made in the prescribed form to be filed in the patent office. The aforesaid provision indicates that filing of a divisional application under Section 16 of the Patents Act appears to be an exception to the rule of filing an application for patent, which can be for one invention only.

11. A perusal of the above-quoted Section 16 of the Patents Act shows that under sub-section (1) thereof, before the grant of patent, the person, who has made the application for grant of patent, can, if he desires or in a situation where an objection that the complete specifications relate to more than one invention raised by the Controller of Patent is to be remedied, file a further application in respect of an invention disclosed in the provisional or complete specification already filed. The aforesaid provision, therefore, makes it clear that for such a divisional application to be filed, the claims already specified in the first mentioned application must relate to more than one invention. In other words, the *sine qua non* for maintaining a divisional application is the existence of more than one invention, spelt out in the first mentioned application.

12. It is crucial to note that under sub-section (2) to Section 16 of the Patents Act, the further application or the divisional application must also be accompanied by a complete specification, but it cannot include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application. In other words, any matter foreign to what is already disclosed in the first mentioned application cannot be introduced by way of the divisional application.

13. Sub-section (3) of Section 16 of the Patents Act further requires that neither of the complete specifications can include a claim for any matter claimed in the other. Thus, Section 16 of the Patents Act in itself

is a complete Code for maintaining a further application or a divisional application under the Patents Act. Unless the requirements specified under the said provision are satisfied, a divisional application cannot be entertained by the Controller of Patents.

14. In this context, as to what should be the contents of specifications is evident from the above-quoted portions of Section 10 of the Patents Act. Sub-section (1) thereof provides that every specification, whether it is provisional or complete, must describe the invention, indicating the subject matter to which the invention relates. Sub-section (4) of Section 10 of the Patents Act gives in detail as to what must be the contents of a complete specification. Clause (a) thereof specifies that such a complete specification must fully and particularly describe the invention and its operation or use and the method by which it is to be performed. Clause (c) thereof, upon which the learned counsel appearing for the petitioners placed much reliance, specifies that every complete specification shall end with claim or claims defining the scope of the invention for which protection is claimed. Sub-section (5) of Section 10 of the Patents Act states that 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 and that this should be stated in a clear and succinct manner. Thus, when an application for grant of patent is moved, the applicant is required to give complete specifications relating to even a group of inventions that may be linked so as to form a single inventive concept. This is crucial for the present case. It is clear from Section 2(j) of the Patents Act that an invention means a new product or process involving an inventive step, which is capable of industrial application. The crucial portion of this definition is the inventive step. It is also relevant to note that definition of ‘patent’ under Section 2(m) of the Patents Act reads as a patent for ‘any invention’ granted under that Act. It is crucial that the expression ‘invention’ is used in singular in the said

definition.

15. As noted hereinabove, a reading of Section 7 of the Patents Act, which specifies the form for an application for grant of patent emphasizes that the application for patent shall be for one invention only. It is in this backdrop that the case of the petitioners needs to be appreciated on the basis of the documentary material placed on record.

16. This Court has perused the 'first mentioned application' of the petitioners, which refers to the claim made on their behalf in respect of the patent claimed for *Chlorophyllin* composition. The claims specifically mentioned are ten in number and the invention pertains to the composition of *Chlorophyllin* as specified at claim No.10. It is relevant to note here that claim No.10 opens with the words '*the Chlorophyllin as claimed in one of the claims 1-9 composition comprising*'. The contents of the aforesaid claims are to be juxtaposed and appreciated in the context of the amended application placed at exhibit-H (divisional application) to the present petition. The claims being made by the petitioners are specified towards the end of the said document. In this application, it is found that reference is made to five claims and claim No.1 in terms of giving the details of *Chlorophyllin* composition are identical to what is stated in claim No.10 of the first mentioned application. The only difference in the case of this divisional application is that the above-quoted words mentioned in claim No.10 of the first mentioned application are missing. Other than the said definition, by and large, the other contents appear to be similar to that in the first mentioned application. The petitioners are heavily relying upon the said definition, emphasizing that the words mentioned in claim No.10 of the first mentioned application have been deleted in claim No.1 of the divisional application, which otherwise is identical in terms of describing the *Chlorophyllin* composition. It is the case of the petitioners

that absence of reference to claims 1 to 9 is crucial and therefore, the divisional application is maintainable. It is emphasized that the Controller can have no objection to the petitioners broadening the scope of their patent and therefore, the objections raised by the respondent No.2, which have formed the basis of the impugned decision are wholly unsustainable.

17. This Court finds the aforesaid contention raised on behalf of the petitioners to be unsustainable, for the simple reason that the *sine qua non* for maintaining the divisional application under Section 16 of the Patents Act is the existence of more than one invention. Plurality of inventions is the basic requirement and the further requirement is that, such plurality of inventions or more than one invention must be stated in the first mentioned application itself, either in the provisional or in the complete specifications. In the present case, this Court finds that the invention is only one, the details of which are found in claim No.10 of the first mentioned application, wherein the *Chlorophyllin* composition has been specified. This very composition is stated in claim No.1 in the divisional application. In other words, it is one and the same 'invention' that forms part of the first mentioned application and the divisional application. The absence of plurality of inventions is fatal to the divisional application moved on behalf of the petitioners in the present case. A perusal of the written submissions submitted on behalf of the petitioners shows that their understanding of the law pertaining to divisional application is erroneous. In fact, while responding to the two specific objections mentioned in the hearing notice issued by respondent No.2, in the aforementioned submissions, the petitioners themselves have placed much emphasis on their desire to broaden the scope or use of the invention. While dealing with the said objections, the petitioners themselves claim that by deleting claims 2, 3, 6, 7 and 8 from the first mentioned application, they are in a position to maintain the divisional

application and justify their prayer for grant of the divisional application. This Court is of the opinion that even in the said submissions, the petitioners have failed to deal with the basic requirement of there being more than one invention to justify filing of the divisional application.

18. In this context, when the judgement of the Delhi High Court in the case of **Syngenta Limited Vs. Controller of Patents and Designs** *(supra)* is perused, it is found that the position of law has been clarified with reference to the relevant provisions of the Patents Act, particularly Section 16 thereof. The said Division Bench judgement of the Delhi High Court is rendered on the basis of a reference in the light of conflict of opinions between two learned Single Judges of the Delhi High Court. Two specific questions were referred for consideration. The first question pertained to the issue as to whether an applicant could *suo motu* file a divisional application, in the absence of an objection raised by the Controller. The said question is not relevant for the present case. The second question pertained to the issue as to whether the plurality of inventions, while considering the divisional applications, are to be reflected in the claim in the first mentioned application i.e. the parent application or such disclosures can be made even in the complete specifications accompanying the claims in the parent application. The aforesaid question is strictly not relevant in the present case. But while discussing the same and rendering findings thereon, the Division Bench of the Delhi High Court has emphasized upon the requirements under Section 16 of the Patents Act. It is held therein that plurality of inventions must find mention in disclosures either in the provisional or the complete specifications. This further indicates, as noted hereinabove, that existence of more than one invention or plurality of inventions is *sine qua non* for maintaining a divisional application under Section 16 of the Patents Act.

19. This Court also finds substance in the contention raised on behalf of the respondents that in the present case, the petitioners have also failed to satisfy the requirement of Section 16(3) of the Patents Act, which provides that neither of the complete specifications should include a claim for any matter claimed in the other. This is in the context of the first mentioned application as compared to the divisional application made by the applicant for grant of patent. In the present case, the divisional application not just copiously refers to the contents of the first mentioned application, but it virtually copies and repeats the details of the only invention, which pertains to *Chlorophyllin* composition. Thus, on this count also, the petitioners have failed to indicate as to how their divisional application was maintainable.

20. In this backdrop, a perusal of the impugned decision of respondent No.2 shows that all these factors were taken into consideration and after referring to the relevant provisions of the Patents Act, the respondent No.2 - Controller of Patents correctly refused to proceed further in the divisional application. No error can be attributed to the approach adopted by the respondent No.2, while rendering the impugned decision and therefore, the present petition must fail.

21. In view of the above, the petition is dismissed.

(MANISH PITALE, J.)

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