



PATENT PROSECUTION IN INDIA

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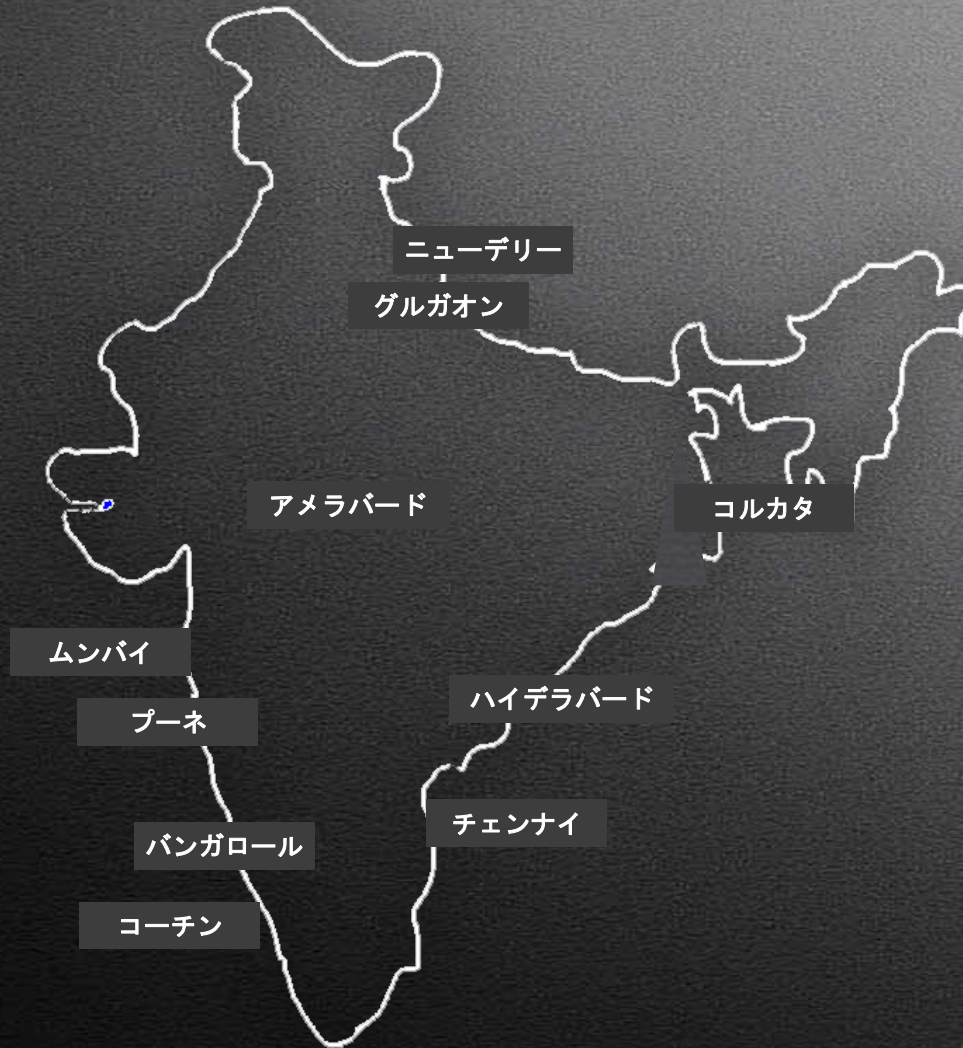
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我が社オフィス -インド全土に展開



- ◆ インドに10オフィス
- ◆ 総勢社員数: 135
- ◆ 在籍プロフェッショナル数: 75



我が社の組織体制



インド国外のデスク

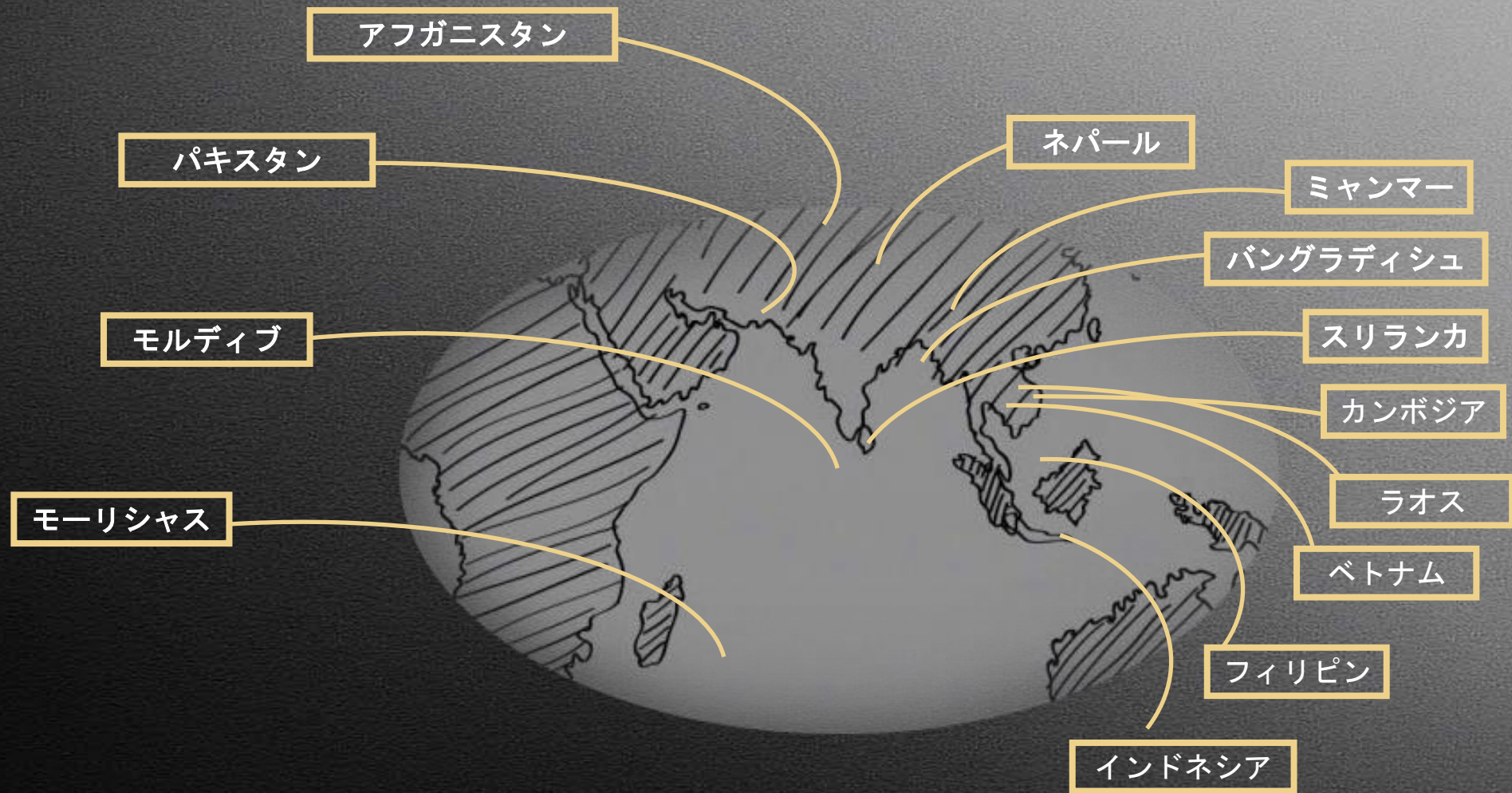


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VOLUNTARY AMENDMENTS

WHICH STAGE?

- i. National Phase Entry
- ii. Pre grant (Request for Examination (RFE) Stage)
- iii. Post grant

National Phase Entry

- ✓ Earlier no amendments were allowed at the time of national phase entry.
- ✓ **Present Scenario**: Deletion of claims is allowed at the time of national phase entry under the proviso to Rule 20(1) of The Patent Amendment Rules, 2016.
- ✓ **Restriction**: Only the deletion of claims is permissible, and any other amendment (addition, revision, merger or modification) is not allowed.
- ✓ **Advantages**:
 1. Allows deletion of claims that would otherwise fall under Section 3 or Section 4 of the Indian Patents Act, 1970 or that would be of no commercial value in India.
 2. Reduction of costs while entering national phase.
 3. Bring conformity with patent claims filed or granted in other jurisdictions.

Pre-Grant: Request for Examination Stage

- ✓ When the Applicant wants the Controller to examine a particular set of claims - Mostly when PCT Article 19 or Article 34 claims amendments are filed with WIPO.
- ✓ Amend claims that would otherwise fall under Sections 3 or Section 4 of the Indian Patents Act, 1970 or that would be of no commercial value in India.
- ✓ Amendments in addition to deletion permitted at this stage.
- ✓ Support for each claim amendment must be provided.
- ✓ Support for the amendments refers to the identified portion(s) of a disclosure (can be from the specification, claims or figures of the present application such as "Page x- line xx-yy" or Figure 000, page xx or claim x and likewise) which confirms that the amendments being carried out are already present in the disclosure and no new matter is being added.
- ✓ Support for each amendment is essential in order to ascertain that there is no addition of subject matter and for comprehending the deviation from the originally disclosed claims.
- ✓ We observe that Examiners have started refusing the amendments where appropriate support and marked version of claims are not provided.
- ✓ The Examiners usually intimate regarding such a rejection in the form of objection in the Examination Report.

Post-Grant

- ✓ Section 57 (3) of the Act.
- ✓ Amendments at the post-grant stage are uncommon and subject to restrictions.
- ✓ Allowance of the amendment at the discretion of the Controller. He may or may not give an opportunity to the Applicant to be heard.
- ✓ After the amendment is allowed, the same may be published along with the nature of the proposed amendment (in case of substantial amendment).
- ✓ After publication – open to opposition (within 3 months from the date of the publication) may be initiated by a person interested (similar to post grant opposition proceedings).
- ✓ Re-issuance of patent certificate on allowance of post-grant amendment is not stipulated under the Act.

AMENDMENTS DURING EXAMINATION

WHICH STAGE?

- i. **Response To First Examination Report (FER) / Subsequent Examination Report / Oral Hearing**
- ii. **Divisional Applications**

Response To FER/Subsequent ER/ Oral Hearing

- ✓ Section 57 (6) : The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any other document related thereto to *comply with the directions of the Controller issued before the grant of a patent.*

- ✓ Section 59 (1): Amendments must only be by way of:
 1. Disclaimer, to limit the scope of the claim;
 2. Correction of an error; or
 3. Explanation or description of a term, feature, drawing or a unique characteristic to explain the claim in a better way.

- ✓ The proposed amendments should be within the scope of the original claims and/or the specification.

Usual amendments

- ✓ Amendments with regard to the name and address of the inventor/applicant, or the priority date of a claim or title;
- ✓ Substitution of a term in a claim with a narrower term to restrict the scope of the claim;
- ✓ Combining a dependant claim into an independent claim or merging two claims;
- ✓ Incorporation of feature from specification considering that amendment is within scope of original claims;
- ✓ Amendments in the specification to incorporate an actual fact (acknowledging prior art), correction of typographical errors translation-related errors, and amendments in line with claim amendments;
- ✓ Incorporation of reference numerals in claims;
- ✓ Providing uniformity in claims across jurisdictions; and
- ✓ Clarifying the meaning of a claim.

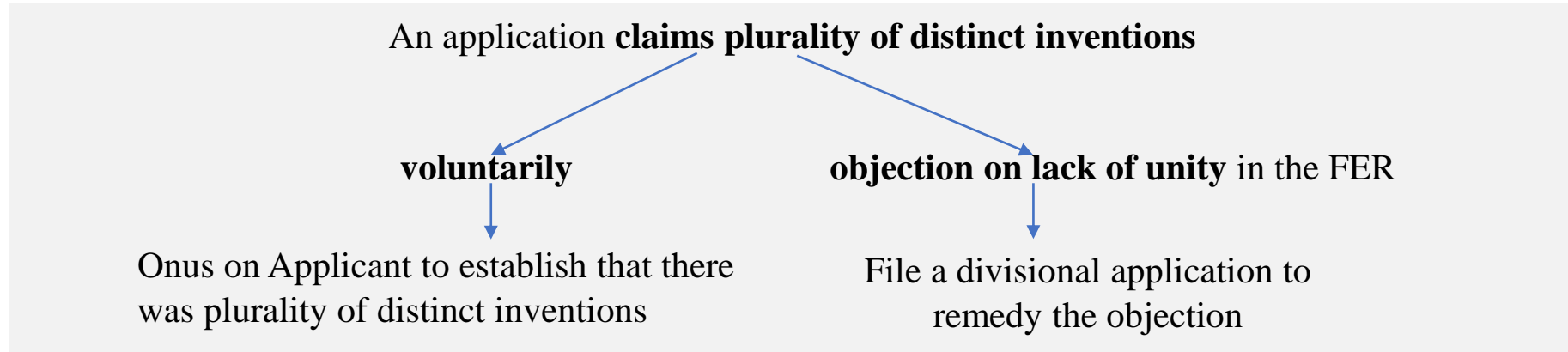
Tony Mon George v. Controller General Of Patents, Designs & Trademarks And Ors. (OA/48/2020/PT/DEL)

- ✓ The Intellectual Property Appellate Board (IPAB) observed that: “*What is not claimed is disclaimed... A patentee who describes an invention in the body of a specification obtains no monopoly unless it is claimed in the claims (Electric and Musical Industries Ltd. v. Lissen Ltd.)*.”
- ✓ IPAB observed that ‘...the contents of claim 4 just narrow down the scope of claim 1, further defining its feature(s) clearly, which is essential as per the teaching of the Patents law. ... **each of the words have their reference in the description.** Therefore, **holding that this claim is just an addition, is not an objective reading of the requirements of the law.** If claim 4 is not allowed to be retained, claim 1 will be left totally non- definitive and wider which is not allowed as per the teaching of the law, either.’
- ✓ In the said case, the IPAB allowed two of the three claims in question and held: *‘the said claims could “not be construed as ‘new’ claim insertions, since they were just qualifying and limiting the scope of the already defined subject matter of the independent claim. No new feature(s), which was present in description but not claimed earlier, is being claimed through these claims.’*

Takeaways

- ✓ Claim amendments should be made only for the purpose of incorporating actual facts.
- ✓ Also, an amended specification should not claim a matter which in substance is not supported by the original specification. Otherwise, it will be considered as added subject matter.
- ✓ More often than not, Section 59 of the Indian Patents Act is quoted if there is a slightest hint of addition of subject matter beyond the scope of the originally disclosed claims.
- ✓ A strict interpretation of Section 59 requires the amended claims to be within the scope of originally disclosed specification as well as within the scope of the originally disclosed claims.
- ✓ Further clarity in respect of amendments from the IPO and high courts are needed to develop a fully uniform practice.

DIVISIONAL APPLICATIONS

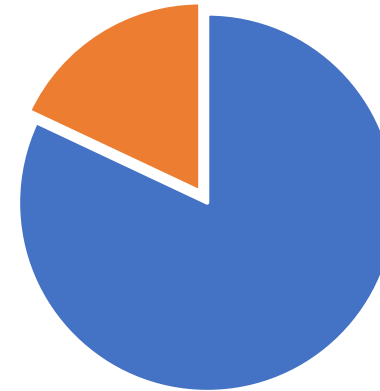
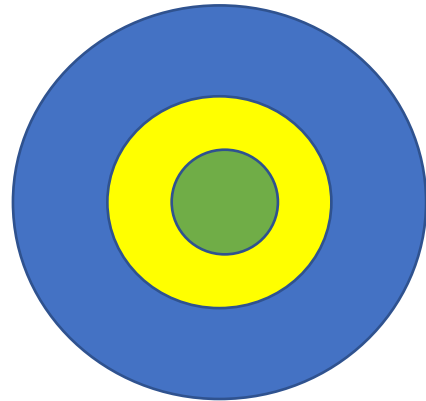


- ✓ An applicant may file a divisional of his own accord, but the discretion to allow the same rests with the Controller (IPAB in the LG Electronics case).
- ✓ A divisional application should be filed at the earliest opportunity and before the grant/ refusal of the parent application.
- ✓ The claims of divisional application shall have the same priority date as that indicated in the first mentioned application (Ante-dating) [Section 11(4)].
- ✓ **Term**: Twenty years from the date of filing of main application.
- ✓ **Fee**: Same as during filing of main patent except any excess claims and pages.

Scope of a Divisional Application

- ✓ Claims must sufficiently **define all the novel and inventive essential technical features** of the present invention.
- ✓ Claims of the divisional application should be **distinct** from those of the parent application and shall not be in conflict with those of parent application.
- ✓ The complete specification of the divisional application should not include any matter not in substance disclosed in the complete specification of the parent application.

Parent Complete Specification – must disclose more than one invention



Claims – No overlap with the parent application

Restrictive Approach - Intellectual Property Appellate Board (IPAB) in the case of *UCB Pharma S.A. v. The Controller General of Patents & Designs & The Assistant Controller of Patents & Designs* (OA/3/2015/PT/MUM): *'addition of new claims from the description, which were not present in the body of the parent claims, cannot form part the divisional application, as per the teachings of section 16 of the Patents Act.'*

Examination of a Divisional Application

- i. Differ in inventive concept from the parent, i.e., different invention; and
 - ii. Novel and inventive over the prior art and not over parent application.
- ✓ The first and foremost requirement, is that the divisional application should lead to a different invention i.e., differ in inventive concept from the parent application.

Unity of Invention

- ✓ Section 10(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.
- ✓ Independent claims should be **tied together by a single inventive concept** and complement each other, and work together to constitute a single inventive concept are allowed.
- ✓ There are no limits to the number of divisionals filed for one application.
- ✓ Section 16 provides the **remedy** for an application containing more than one inventions.

What was the source of claims filed in the divisional application?

- Patent Application No. 1191/KOL/2005 was filed as a divisional application out of the parent application 489/KOL/2004, which was abandoned under Section 21(1) of the Act.
- The claims were verbatim same as that of 489/KOL/2004.

Whether the divisional was maintainable or not?

- In FER of the parent application certain technical and formal objections were communicated.
- No objection with respect to the plurality of distinct inventions was raised.
- The Applicant did not respond to the FER, therefore the application was deemed to be treated as abandoned.
- Claims 1 to 16 of the instant application were anticipated by claims 1 to 16 of the parent application 489/KOL/2004 under Section 13 of the Act.
- In view of this, the divisional application was not allowed as a divisional application.

What was the order of IPAB?

- ✓ The existence of plurality of invention in the parent application is the *sine qua non* for a divisional application.
- ✓ **The phrase ‘if he so desires’ of Section 16 is not unconditional, but is contingent upon the fact of presence of plurality of distinct inventions in the parent application.**
- ✓ A divisional application filed to remedy the objection raised by the Controller, the grounds of the divisional application should be due to dividing multiple inventions in the parent application only - ***“The divisional application cannot be used to exercise the revival of subject matter in the parent application that has been abandoned, refused, or withdrawn.”***

What was the source of claims filed in the divisional application?

- A patent for parent application no. 8/DEL/1997 was granted on 14/06/2002.
- A first divisional application No. 346/DEL/2001 was filed on 23/03/2001 and the same was granted on 31/03/2008 under patent no. IN 217322.
- A second divisional application no. 264/DEL/2005 was filed on 08/02/2005 as a result of FER issued in the first divisional application wherein objection for plurality of inventions was raised.

Whether the divisional was maintainable or not?

- The Controller rejected the second application as the application is derived from a divisional application and the application is time barred as per Section 16(1) of the Patents Act, 1970 as it has been filed after grant of Patent for parent application no. 8/DEL/1997.
- However, **IPAB held the second application as maintainable.**

What was the order of IPAB?

- ✓ **The second application filed out of the first divisional application was valid.** As it was filed prior to the grant of first divisional application **within the time of limitation contemplated under Section 16(1)** of the Patents Act, 1970, and **in response to objection for plurality of inventions raised in the first divisional application.**

What was the source of claims filed in the divisional application?

- In FER of the parent application 4614/DELNP/2010, it was stated that there are two sets of distinct inventions, Group I, Claims 1 to 9 and Group II, Claims 10 to 17.
- In the response to FER, claims 10 to 17 were deleted.
- A divisional application 5912/DELNP/2015 was filed initially with 11 claims corresponding to the deleted claims 10 to 17 of the parent application, which were then amended to comprise 9 claims in response to the FER issued for the divisional application.

Whether the divisional was maintainable or not?

- The Deputy Controller of Patents & Designs held that claims of the present application were in conflict with claims of the parent application as claims of divisional application include essential technical features which were already claimed in parent application, therefore the divisional application was not maintainable.
- ***However, the IPAB reversed this decision and held that the divisional application is maintainable.***

What was the order of IPAB?

- ✓ A divisional patent application filed from parent application on the basis of ‘unity of invention’ objection cannot be rejected on the basis that the same is based on the parent application or on the ground of lack of distinct inventions in the parent application.

*UCB PHARMA S.A. v. THE CONTROLLER GENERAL OF PATENTS & DESIGNS &
THE ASSISTANT CONTROLLER OF PATENTS & DESIGNS (2020)*

What was the source of claims filed in the divisional application?

- The divisional application was filed in response to the FER of parent application IN/PCT/2002/00019/MUM to cover the scope of distinct claims in accordance with provisions of Section 16 and to **meet the objection of ‘distinctiveness’ raised.**
- The divisional application was filed with the original claim set, however, was further restricted in view of the FER issued and during the oral hearing.

Whether the divisional was maintainable or not?

- The divisional application was not maintainable.

What was the order of IPAB?

- ✓ Section 16 provides for filing of a divisional application **only when an objection is raised regarding unity of invention** in the subject matter is raised. **Divisional application can not be filed in response to objections raised on other grounds.**

What was the source of claims filed in the divisional application?

- The parent application no. 4702/DELNP/2005 (IN 240060) was initially filed with 56 claims.
- **Form 13 was filed for voluntary amendments.** The amended claim set had 34 claims.
- The FER of the parent application stated that the claims 20-34 were inconsistent with claim 1 and **plurality of independent claims existed.**
- Therefore, the Appellant filed a divisional application (8094/DELNP/2008) with amended claims 20-34.

Whether the divisional was maintainable or not?

- The Controller, was of the opinion, that amended claims 1-3 (within the scope of amended claims 32 to 34 of the voluntary amended claim set) did not form multiplicity or distinct inventions, and thus the divisional application was illegitimate, *ab initio*, leading to the refusal of the application no. 8094/DELNP/2008.
- **However, IPAB held that the scope of claims of the divisional application were distinct from that of the parent and hence the divisional application was maintainable.**

What was the order of IPAB?

- ✓ An assessment of the parent application revealed that amended claims 1-34 related to a single inventive concept category. However, the divisional application was filed in the response to the objection raised in FER of the parent application. Allowing of the divisional application would not lead to 'double patenting'.
- ✓ Therefore, considering 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'**.
- ✓ **'One invention'** – directed to either a single invention or a group of invention linked so as to form a single inventive concept - '*no two inventions can be allowed in a single patent application, unless it conforms to a single inventive concept. Hence, either way, it is a single inventive concept which is allowable in one application, as per the statutory provisions. We may like to call it as "One Application One Inventive Concept (OAOIC)" which is allowable in a single application.*'
- ✓ IPAB concluded that a patent application can only be divided if it claims more than 'one invention'.

Guiding Principles – Formal Grounds

1. A divisional application can be filed by an applicant either *suo motu* or **to remedy an objection** raised by the Controller **on grounds of plurality of inventions** (existence of plurality of inventions in the parent application is essential to file a divisional application) if the parent application claims more than 'one invention'. **Existence of plurality – sine qua non.**
2. Further, the **claims of divisional application** shall have their **route in the first mentioned application**, and that the same is applicable for **divisional-to-divisional application** as well. The route of subsequent divisional application also should be from the first mentioned application.
3. A divisional application can be **filed only on grounds of plurality of invention**. If the claim is held non-patentable due to **any other provisions**, it is **not proper to file a divisional application** for such claims.

Guiding Principles – Formal Grounds

4. The primary requirement to file a divisional application is the existence of a **valid parent application**. Meaning thereby that no divisional application can be filed, if the application is either ‘deemed to be abandoned’, ‘withdrawn’, or ‘refused’.
5. The **complete specification** of the divisional application **shall not include any matter not in substance disclosed in the complete specification of first mentioned application**. The teaching of sub section (2) of section 16 *‘doesn’t refer to the matter disclosed but not claimed*. This relates to the fact that since both the applications are given the same date of filing, the latter shall not include any further subject matter which was not disclosed in the first mentioned application.
6. A divisional application **may be filed before the grant of the first mentioned application**. The IPAB recommended the introduction of ‘Intimation to Grant’ to bring certainty in the date of filing divisional applications. However, in case of filing divisional to divisional, the applicant shall not be left without any remedy.

Guiding Principles – Substantive Grounds

1. At the stage of examination, it should be kept in mind that the presence of different embodiments in the specification, which are claimed as multiple independent claims, would not necessarily attract the provisions of lack of ‘unity of invention’. If unity of invention is not ascertained, the amendment of claims can overcome the ‘scope’ or ‘definitiveness’ requirements.
2. In case of plurality of inventions, the First Examination Report of the first application should identify all such distinct inventions to minimize the chance of filing divisional-to-divisional applications.
3. Examination of a divisional application should be done in relation to the parent application, and any subsequent divisional applications must be examined in relation to the parent application and first divisional application in order to avoid double patenting.
4. When an objection on the unity of invention is raised in the examination of the parent application, the divisional application shall not be disallowed, if it fulfills other statutory requirements and the Applicant is ready to remove the conflict, if any, by amending the same. The Board has opined that the discretionary powers of the Controller shall be utilized keeping in view the complete statutory provisions and then discharging the same on a case-to-case basis.

Prosecution Pointers

- ✓ Positive foreign prosecution holds persuasive value.
- ✓ Multiple dependency not statutorily prohibited; usually allowed if similar scope accorded a patent in corresponding applications.
- ✓ Use of ‘or’ & ‘and’ separately are generally accepted; Use of ‘and/or’ usually objected.
- ✓ ‘Comprising’ objected; usually overcome with thorough submissions.
- ✓ Amendments to overcome objections under Section 3 (non-patentable subject matter) of the Indian patents Act, 1970 should be carefully reworded to find support from original claims (preferably) or verbatim support from the complete specification.
- ✓ Claim and complete specification amendments not to include new subject matter.
- ✓ Additional experimental data along with notarized affidavit generally accepted (discretionary powers of Controller).
- ✓ To overcome ‘unity of invention’:
 1. Establish single inventive concept; or
 2. Delete claims and preferably file divisional with deleted claims in case of plurality of distinct inventions claimed in the parent application.

RECENT DEVELOPMENTS

✓ Proposed Creation of Intellectual Property Division (IPD):

1. On July 06, 2021, the High Court of Delhi issued a press release stating that an exclusive Intellectual Property Division (IPD) will be created in the High Court of Delhi to deal with all matters related to Intellectual Property Rights.

✓ New Category Of Applicant:

1. The Indian Patent Office has notified the Patent (Amendment) Rules, 2021 introduce “EDUCATIONAL INSTITUTION” as a new category of applicant that may seek benefits of reduced official fee.
2. A concession of 80% in the official fee can be availed by an educational institution as compared to the second category of Others.

THANK YOU FOR YOUR TIME

