

### Patent | Case Law Update

## Delhi High Court to address conflicting views on Divisional applications in India

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The Delhi High Court referred its order of July 2023 in *Syngenta Limited v Controller Of Patents And Designs* to a two-judge bench (Division Bench or DB) to review the issue of filing divisional patent applications in India. Specifically, the DB will determine:

- *Does the requirement of a plurality of inventions being contained in the parent application apply even where the Divisional Application is filed by the applicant on its own, and not based on any objection raised by the Controller?*
- *Assuming that the requirement of a plurality of inventions in the parent application is necessary, does the plurality of inventions have to be reflected in the claims of the parent application or is it sufficient if they are reflected in the disclosures of the complete specifications of the parent application?*

In the order, the Court expressed disagreement with the finding in a 2022 verdict of the same Court in *Boehringer Ingelheim International GmbH v The Controller Of Patents & Anr* (Boehringer case). In the *Boehringer* case, the Court had held that *if the invention is not contained in the claims of the parent application, the divisional application cannot be permitted to be filed solely based on disclosure made in the specification*. Moreover, amendments changing the scope of claims as originally filed in the parent application are not permissible for divisional applications.

Syngenta Limited's (Syngenta) divisional application for a patent on an agrochemical concentrate was



declined by the Controller. The reason stated was that it did not adhere to the requisites stipulated in Section 16 of the Indian Patents Act, 1970. Specifically, the parent application related to the divisional application did not disclose multiple distinct inventions as required.

Syngenta appealed before the Court and presented two pivotal arguments:

- The parent application must have multiple inventions only if the Controller raises objections, and the decision to submit a divisional application shouldn't solely hinge on the patentee's preferences or be made arbitrarily.
- Secondly, the judgment in the *Boehringer* case was incorrect in stating that an invention claimed in the parent application can't be included in the

divisional application's claims.

Further, Syngenta placed reliance on Article 4(G) of the Paris Convention for Protection of Industrial Property, which allows for two ways to divide a patent application.

- First, if an examination finds multiple inventions in one application, it can be split into separate divisional applications.
- Second, the applicant can voluntarily divide the application, even without an examination.

Both options let the new applications keep the original filing date, but individual countries may have their own rules for allowing such divisions. Additionally, Article 4(G) also notes that the requirement for the original application to contain multiple inventions is not necessary when the applicant chooses to divide the application voluntarily.

In this context, Section 16(1) of the Act aligns with the dictates of Article 4(G) of the Paris Convention, cementing Syngenta's claim that the judgement of 2022 might need to be reconsidered.

Analysing the structure of Section 16(1), the Court observed that it includes the phrase "if he so desires" between two commas and noted the absence of a comma after the phrase "raised by the Controller". In view of the analysis, the Court opined that applicants could independently file divisional applications and there is no need for the claims to include multiple inventions, contrary to the Boehringer case's ruling.

Recognizing the need for a clear interpretation of the law in this regard, the Court referred the matter to the DB.