

## Esco Corporation Vs Controller Of Patents & Designs

**Court:** Intellectual Property Appellate Board, Delhi Registry Cum Bench

**Date of Decision:** Oct. 27, 2020

**Acts Referred:** Patents Act, 1970 " Section 3, 7, 10, 10(5), 117A, 15, 16, 16(1), 16(3), 21

**Hon'ble Judges:** Manmohan Singh, J; Dr. B.P. Singh, Technical Membe

**Bench:** Division Bench

**Advocate:** Archana Shankar

**Final Decision:** Allowed

### Judgement

Manmohan Singh, J, Dr. B.P. Singh, Member (T)

1. The present appeal has been preferred under Section 117A of the Indian Patents Act, 1970 against the order dated 19/04/2016, passed by

Respondent, being the Controller of Patents, under Section 15 of the Indian Patents Act, 1970, refusing the Appellant's Indian patent application no.

8094/DELNP/2008.

2. About the invention

2.1. The appellant submits as under:

2.2 The divisional application 8094/DELNP/2008 relates to a wear member (19) for excavating equipment used in construction sites.

2.3 Said wear member includes a front end, a rear end, converging walls that converge toward the front end, side walls extending between the

converging walls, a socket that opens in the rear end to receive a nose (46) fixed to the excavating equipment, and a hole (23) extending through one

of said walls to communicate with the socket. The wear member (19) is characterized in that a resiliently biased latch (60) projects into the hole (23)

and defines a thread formation (66) to engage a threaded wedge (12) to secure the wear member (19) to the nose (46):

2.4 The figures of the wear member is as under:

2.5 The granted claims of the parent patent no. 240060 relate to a wear assembly (15) for an excavating equipment.

2.6 According to granted claim 1 of the parent patent no. 240060, the wear assembly (15) includes a support structure (17), a wear member (19)

mounted on the support structure (17) and a lock (10) releasably securing the wear member (19) on the support structure (17). The support structure

(17) and the wear member (19) cooperatively define an opening (21) for receiving the lock (10). The lock (10) includes a wedge (12) having a leading

end (18), a trailing end (27), and a length extending between the leading and trailing ends (18, 27). The wedge (12) tapers toward the leading end (18)

along substantially the entire length. The wear assembly (15) is characterized in that the wedge (12) has a rounded cross section and is formed with a

helical thread (22) that extends axially along an exterior surface (16) of the wedge (12). The wear assembly (15) is also characterized in that the

helical thread (22) is threadedly coupled to a thread formation (66) in the opening (21) such that rotation of the wedge (12) moves the wedge (12) into

the opening (21) to tighten the lock (10) in the opening (21).

## 2.7 Figure no. 1

2.8 As can be seen from above, the scope of claims of the divisional application are distinct from that of the parent case and hence the present

divisional application is maintainable.

2.9 For reasons of these submissions, it is asserted that rejection of the claims of the present divisional application due to noncompliance of

requirements of Section 16(1) of the Indian Patents Act is incorrect.

## 3. Facts of the case:

3.1 The Appellant submitted the present divisional application no. 8094/DELNP/2008 for their invention titled ""Releasable Coupling Assembly"", which

was divided out of the previously filed patent application 4702/DELNP/2005, under the Indian Patents Act, 1970.

3.2 The First Examination Report was issued on 06/06/2014. The response thereof was filed on 05/06/2015. A hearing was appointed on 19/04/2016

vide hearing notice dated 04/02/2016.

3.3 The written submission of the hearing was filed on 19/04/2016 and the impugned order was issued by the respondent on the same day i.e.

19/04/2016, refusing the grant of the patent.

4. Aggrieved by the impugned order, the appellant has preferred this appeal.

5. Let's have a look on the order of the respondent with regard to divisional application. The respondent mentions as follows:

Regarding the objection that amended Claims 1-3 do not correspond to any of the originally filed claims and claims 1-3 are not within the scope of

originally claimed claims (See parent application 4702/DELNP/2005, claims 1-56), the learned agent for applicant submitted that amended claims 1-3

fall within the scope of claims 41-52 of originally filed claims 1-56 of parent application. The claims of parent application were amended with form 13

and total numbers of claims were 34 and amended claims 32-34 are verbatim similar to currently filed claims 1-3 of this divisional application. Further

they submitted that claims 20-34 of the amended claims of parent application were deleted from the parent application and this divisional application

was filed with these claims. This divisional application was filed voluntarily by the Applicant as there was multiplicity of inventions in claims 1-19 and

20-34 according to Applicant.

Further, in operating part of his order holds that ""In my opinion these finally amended claims 1-3 do not form multiplicity or distinct invention as they

relate to wear member which is a comprising feature of wear assembly.

In view of abovementioned reasons this divisional application is illegitimate ab initio. Therefore, this divisional application no. 8094/DELNP/2008 is

hereby refused patent u/s. 15 of The Patent Act 1970 due to non compliance of requirements of section 16(1) of The Patent Act 1970 and anomalies

mentioned.

6. The legal provisions relating to the ""division of application"" is as under:

Section 16 Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps16.html>

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.

[Emphasis added]

Section 7 Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps7.html>

Form of application

(1) Every application for a patent shall be for one invention only and shall be made in the prescribed form and filed in the patent office..

Section 10 Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps10.html>

Contents of specifications

(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.

7. The relevant provisions regarding divisional application in MANUAL OF PATENT OFFICE PRACTICE AND PROCEDURE MANUAL OF

PATENT OFFICE PRACTICE AND PROCEDURE Available at

[http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/Manual\\_for\\_Patent\\_Office\\_Practice\\_and\\_Procedure\\_.pdf](http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/Manual_for_Patent_Office_Practice_and_Procedure_.pdf) is as under:

iii. Examination of a divisional application is always done vis-à-vis the first mentioned application. If two or more divisional applications are filed

based on a first mentioned application, examination of the second or subsequent divisional application(s) shall be done vis-à-vis the first mentioned

application, and other divisional application(s), examined earlier, if any, to avoid double patenting.

iv. The date of filing of a divisional application shall be the same as that of the first mentioned application, from which it has been divided.

v. The term of patent for a divisional application shall be twenty years from the date of filing of the first mentioned application or international filing

date in case the application was divided out of National phase application under PCT.

vi. Claims of divisional application(s) shall be based on the claims of first mentioned (or earlier application for that matter) from which instant

application is divided out and no addition of claims, which do not fall within the scope of said claims, is allowable.'

8. It is pertinent to analyse the recent orders of this Board with regard to "division of application".

8.1. In para 22 of the order in L.G. Electronics case OA/6/2010/PT/KOL this Board held that "Accordingly, on plain reading of the above referred

provisions, it is evident that if the claims of the invention disclosed in one patent application do not relate to single invention or to a group of the

inventions forming a single inventive concept, the applicant can file further application as divisional application out of that application either of his own

(suo moto) or when the objection of disclosure of more than one invention is raised by the Controller. Further, where any overlapping of the claims in

the parent application with the divisional application is observed, the Controller may seek the amendments in the complete specification of the

divisional application to ensure that there is no overlapping of claims between these applications.

8.2. The Board went on to refer and quotes the relevant provisions of Narayanan Patent Law by P. Narayanan [4 Edition 2006 page No. 60], "Where

an application relates to more than one invention the defect may be remedied by filing a further application. This may be done either at the applicant's

own request at any time before the grant of patent (earlier, it was before the acceptance of the complete specification) or with a view to remove the

objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention. It is further stated that

whether the specification cover more than one invention, it is for the Controller to decide.""[Emphasis added]

8.3. We have observed that the word 'cover' is interpreted differently at times. To remove all sort of confusions, paragraphs 138 and 139 of the

Novartis Novartis Ag vs. Union Of India & Ors. Available at <https://indiankanoon.org/doc/165776436/> judgment of Hon'ble Supreme court is quoted

herein below:

138. The submissions of Mr. Andhyarujina and Mr. Subramaniam are based on making a distinction between the coverage or claim in a patent and

the disclosure made therein. The submissions on behalf of the appellant can be summed up by saying that the boundary laid out by the claim for

coverage is permissible to be much wider than the disclosure/enablement/teaching in a patent.

8.4. 139. The dichotomy that is sought to be drawn between coverage or claim on the one hand and disclosure or enablement or teaching in a patent

on the other hand, seems to strike at the very root of the rationale of the law of patent. Under the scheme of patent, a monopoly is granted to a private

individual in exchange of the invention being made public so that, at the end of the patent term, the invention may belong to the people at large who

may be benefited by it. To say that the coverage in a patent might go much beyond the disclosure thus seem to negate the fundamental rule underlying

the grant of patents.

[Emphasis added].

8.5. Therefore the word 'cover' in Narayanan Supra 6 is relating to whether specification claimed more than one invention.

8.6. The Board in LG Electronics Supra 5 also touched upon other aspect of the law when it held that ""We agree with the applicants arguments that

the applicant can file an application as divisional application of his own before the grant of patent. However Respondent-2 is mandated by the law to

ascertain that the divisional application so filed is on account of disclosure of plurality of distinct invention in the parent application. Section 16 pertains

to power of the Respondent to make order respecting division of application. Right to file divisional application indeed rest with the applicant but the

power to ascertain its allowability is vested with the Respondent. The first essential requirement of this provision is the fact of existence of plurality of

invention in the parent application. The provision under section 16 put a bar on filing same claims as it mandates the Respondent to seek such

amendment of the complete specification as may be necessary to ensure that neither of the said complete specifications includes a claim for any

matter claimed in the other. ...In fact the existence of plurality of invention in the parent application is the sine qua non for a divisional application by

the applicant whether it is suo moto as to remedy Controller's objection.

[Emphasis added].

8.7. The Board in THE PROCTER & GAMBLE COMPANY OA/47/2020/PT/DEL held that

21. In the impugned order, it is held that the divisional application can only be filed when the claims of complete specification in parent application

relate to more than one invention and divisional application should not include a claim for any matter claimed in parent application.

22. As far as these findings are concerned, there is no dispute as the said findings are in accordance with law. But situation in the present case is

different as when the parent application was examined, in the first examiner report issued on 19.09.2014 it was held by the respondent that there were

two sets of distinct inventions. Therefore, the claims 10 to 17 were deleted.

24. We are of the view that once the parent application is already examined it is permissible to raise such type of issues unless, it is found that

substantial amendments are made in the divisional application which enlarge the scope of invention claimed in the parent application.

9. IPAB further decided on second divisional application in the National Institute of Immunology Case OA/21/2011/PT/DEL stating that the applicant

should not be left in lurch mainly on the basis of the objection raised by the office which necessitated the applicant to take resort to file divisional

application as the subject in the instant case without any remedial measures available in accordance with law.

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.

11. So, the theme of filing any divisional application basically lies with section 7 which mandates every application for one invention only. It was

further defined in sec. 10(5) as a group of inventions linked so as to form a single inventive concept. Thus it is very clear that no two invention 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.

12. A look at the provisions of ""unity of invention"" enshrined in Patent Cooperation Treaty (PCT)

Rule 13

Unity of Invention

13.1 Requirement

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept

(""requirement of unity of invention"").

13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall

be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical

features. The expression ""special technical features"" shall mean those technical features that define a contribution which each of the claimed

inventions, considered as a whole, makes over the prior art.

13.3 Determination of Unity of Invention Not Affected by Manner of Claiming

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the

inventions are claimed in separate claims or as alternatives within a single claim.

13.4 Dependent Claims

Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific

forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in

themselves an invention.

13. The issue of divisional applications has drawn much attention in recent past and we have noted different practices adopted by the applicants or by

the Patent Office. We, therefore, opine that in the best interest of justice and in order to bring uniformity of practices, the following guiding principle

may help to address the issue. Considering the above legal provisions of Indian Patent law, the Manual Of Patent Office Practice and Procedure, the

PCT to which India is a member since 1998 and the previous decisions, we are of the view that the following points need be adhered to while dealing

with divisional applications:

#### 14. Formal Grounds:

##### 14.1 Filing of divisional application

Ã¢â¬Â¢ Either by the applicant (suo-moto), if he so desires or

Ã¢â¬Â¢ To remedy the objection raised by the Controller on the ground of plurality of invention.

Ã¢â¬Â¢ In either case the existence of plurality of invention in the parent application is the sine qua non for a divisional application.

14.2 The claims of divisional application shall have their route in the first mentioned (parent) application. This is true even for divisional to divisional

application as well. The routes of subsequent divisional application also should be from the first mentioned application. The divisional application shall

not be filed with the same set of claims as the first mentioned application.

14.3 The applications need be divided only on the ground of 'plurality of invention' as envisaged under section 16. If any claim is held to be non-

patentable due to any other provisions of the law such as the requirements section 3 or otherwise, it should not be proper for filing a divisional

application for such claims.

14.4 For division of an application, the primary requirement is that the application shall exist. Meaning thereby that no divisional application can be

filed, if the application is either ""deemed to be abandoned"" or 'withdrawn' or ""refused"". However, the divisional application once filed, no such

subsequent action will have any bearing on that divisional application, which shall continue as substantive application.

14.5 The time of filing the divisional application is also an important factor. Prior to the Patent(Amendment) Act, 2005, the divisional could be filed till

the date of putting the application in order for acceptance under the provisions of section 16 read with section 21 as it existed then. After the Patents

(Amendment) Act, 2005 the provisions ""before the grant of the patent"" was introduced in section 16(1) for the phrase "" before the acceptance of the

complete specification"". Similarly the heading of Section 21 was amended to read "" Time for putting the application in order for grant"" in place of

Time for putting application in order for acceptance"", under the said Amendment Act 2005. Through this amendment, though the applicant has got the

time for filing divisional application till the grant of patent, but since the date of grant is uncertain and differs from case to case, the applicants are not



certain for the date till which they can file the divisional application. An intimation to grant, if introduced, may bring certainty for the date of filing

divisional applications.

14.6 The divisional application may be filed before the grant of the first mentioned patent application. However, in case of filing divisional to divisional,

the applicant shall not be left without any remedy.

14.7 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. Therefore, the contention that some additional claim(s) can also be allowed, which never formed part of the originally filed

claims, is negated as the provisions of law need to be read in totality. A plain reading of sub -section (1) of section 16 reveals that the very ground to

accept divisional application is ""on the ground that the claims of the complete specification relate to more than one inventions. Sections 10(5) further

qualifies ""more than one invention"" to only such invention or group thereof which cannot be linked to make a single inventive concept.

Substantive Grounds:

14.8 At the stage of examination, care should be exercised that merely by the presence of different embodiments in the specification, which are

claimed as independent set of claims, it does not necessarily attract the provisions of lack of 'Unity of invention'. If the unity of invention is not

ascertained, the amendment of the claims can overcome the ""scope"" or ""definitiveness"" requirements, and this option could well be exercised

beforehand.

14.9 Further, if there exists the lack of ""unity of invention', the group of distinct inventions need to identified in the First Examination Report (FER)

itself so as to minimise the chance of filing divisional to divisional applications. It is the non-clarity of objections, which is one of the cause of multiple

divisional applications. If there are more than two sets of claims and if each sets are identified clearly in the examination report, the applicant can file

all divisionals at one go; rather than waiting for the examination report of second divisional application, which creates unnecessarily legal implications.

14.10 As explained in the Manual Supra the examination of a divisional application is always done vis-À-vis the first mentioned application. If two or

more divisional applications are filed based on a first mentioned application, examination of the second or subsequent divisional application(s) shall be

done vis-à-vis the first mentioned application, and other divisional application(s), examined earlier, if any, to avoid double patenting.

14.11. Though, the Controller possesses statutory power to orders regarding divisional applications, such power shall be utilised keeping in view the

complete statutory provisions in mind, on case to case basis. If the objections on unity of invention is taken in the first mentioned application, the

divisional application shall not be disallowed, if it fulfills other the statutory requirements and the applicant is ready to remove the conflict, if any, by

amending the same.

15. Coming back to the instant case, the learned Controller held that these claims are not allowed as divisional claims as he puts ""In my opinion these

finally amended claims 1-3 do not form multiplicity or distinct invention as they relate to wear member which is a comprising feature of wear

assembly.

16. We have analysed both first mentioned application as well as further application, their examination reports and the order of the learned Controller.

The findings are as under:

16.1 The claims of the first mentioned patent application no. 4702/DELNP/2005 had 56 claims as originally filed. Claims 1-40 were oriented towards

Wear assembly"", claims 41-52 related to ""Wear Member"" and claims 53-56 were oriented towards ""a method of attaching a wear member to a

support branch.

16.2 Subsequently, these claims were amended to retain only 34 claims. Claims 1-14 of which oriented towards ""A wear Assembly"", claims 15-19

towards "" A method..", claims 20-28 towards "" A Lock"", claims 29-31 towards ""A wedge.." and finally claims 32-34 towards ' A wear Member..

16.3 The First Examination Report (FER) issued on 16/05/2008 at its paragraphs 7 mentioned the objection as follows:

7. Claims 20-34 are inconsistent to claim 1. In view of the plurality of independent claims the nature of the invention is not fairly ascertained in the

specification. The claims should be revised with a view to indicate precisely the broad features of invention common to all the claims.

16.4 On this objection, the appellant filed this further application no. 8094/DELNP/2008 (the instant divisional application) with claims 20-34.

16.5 The examination report of this divisional application No. 8094/DELNP/2008 also mentioned that:

Claims 13 to 15 are not in accordance with section 16(3) of Patents Act 1970.

16.6 Claims 13 to 15 related to the ""Wear Member"".

16.7 Subsequently, the appellant revised the claims to retain only claims 32-34 (as originally filed) or claims 13-15 (of the divisional application) as

claims 1-3 in the instant application.

17. A logical assessment of the parent application reveals that it was a fit case for allowing all the claims 1-34 in the same application, with suitable

amendments, as they relate to a single inventive concept category. But based upon the objection of the Controller, the appellant has moved and filed

this divisional application with the set of claims held to be out of scope of the principal claim. We notice that it won't be a case of 'double patenting'

once this divisional application is allowed.

18. We, therefore, allow the instant application as divisional application of the first mentioned application no 4702/DELNP/2005 (Granted as patent no.

240060), under section 16 of the Patents Act, 1970.

19. Keeping in view the above facts, we set aside the impugned order of respondent no 2 and direct respondent no. 2 to grant the patent in respect of

the invention described and claimed in claims 1-3 of the instant application no. 8094/DELNP/2008; strictly within 2 weeks from issuance of this

orders.

20. Appeal is allowed. No cost.