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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ **C.A.(COMM.IPD-PAT) 54/2024**
BOEHRINGER INGELHEIM INTERNATIONAL GMBH

.....Appellant

Through: Ms. Vaishali Joshi, Mr. Debashish
Banerjee and Mr. Ankush Verma,
Advocates

versus

THE CONTROLLER OF PATENTS

.....Respondent

Through: Mr. Ankur Mittal, CGSC with Mr.
Rakshit Ranjan and Mr. Hrithik
Saxena, Advocates

CORAM:

HON'BLE MR. JUSTICE SAURABH BANERJEE

ORDER

16.04.2025

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1. By virtue of the present appeal under *Section 117A* of the Patents Act, 1970 (*the Act*), the appellant seeks to challenge the order dated 24.04.2024 passed by the learned Assistant Controller of Patents and Designs, as also a direction for the grant of patent on the appellant's Patent Application No.10614/DELNP/2013 (*Divisional Application*).

2. It is the case of the appellant that the impugned order is erroneous in law and is liable to be set aside since the claims of the Divisional Application filed by the appellant have been wrongly interpreted, as well as that there are contradictions apparent in the said order. It is submitted that while the respondent has stated the reason of unity between the intermediate element in the Divisional Application and the final element in the Patent Cooperation Treaty (*PCT*) national phase application (*Parent Application*) to reject the Divisional Application, the same respondent had, in fact, objected in the First Examination Report (*FER*) to the Parent



Application citing the very opposite ground that there was no unity of claims therein. This, it is submitted, is an approach ripe with inconsistency and against the principle of protection of legitimate expectations, good faith and legal certainty, as also other grounds on the erroneous interpretation of *Section 16*. It was also submitted that the impugned order is against what has been held by the Hon'ble Division Bench of this Court *vide* order dated 13.10.2023 in C.A.(COMM.IPD-PAT) 471/2022 titled ***Syngenta Limited vs. Controller of Patents and Designs***.

3. While addressing arguments, it has been primarily contended by the learned counsel for appellant that the impugned order has wrongly held that the Divisional Application of the appellant is not in conformity with the provisions of *Section 16* of the Act, and that same is against the settled principles laid down ***Syngenta Limited (supra)***, wherein it has been held as under:-

“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 moved by the applicant of its own motion or where it comes to be made to remedy an objection raised by the Controller. In either of



those situations, the plurality of inventions would have to be tested based upon the disclosures made in either the provisional or complete specification. The Reference stands answered accordingly.”

4. On the other hand, though the learned CGSC has advanced his submissions in support of the impugned order, however, there is no response from his side *qua* the aforesaid findings by the Hon’ble Division Bench in ***Syngenta Limited (supra)***, despite mentioning which, the Divisional Application of the appellant has been held to be not maintainable in the impugned order, without considering that the claims therein had been disclosed in the complete specifications of the Parent Application.

5. Based on the factual matrix involved as also considering the documents on record alongwith the settled position of law, this Court finds merit in the submissions advanced by the learned counsel for the appellant. More so, since it is evident from the records before this Court that the respondent is guilty of having taken a contrary stand in the present Divisional Application from that which it had taken earlier while issuing the FER in the Parent Application; and since the same is against *Section 16* of the Act; and it is against what has been held by the Hon’ble Division Bench in ***Syngenta Limited (supra)*** under similar circumstances; and none of the aforesaid has been dealt in the impugned order. Therefore, the impugned order is liable to be set aside.

6. Accordingly, the present appeal is disposed of with the following directions:-

a. The impugned order dated 24.04.2024 passed by the Assistant Controller of Patents and Designs rejecting the



Patent Application No.10614/DELNP/2013 of the appellant is set aside and the matter is remanded back to the respondent for *de novo* consideration.;

b. The aforesaid Patent Application No.10614/DELNP/2013 is restored to its original number.; and

c. The learned Controller of Patents, Designs and Trademarks shall ensure the listing of the Patent Application No. 10614/DELNP/2013 for hearing within *two weeks* from today, as also make all possible endeavours for the disposal of the same within a period of *two months* thereafter, after hearing the learned counsel for the appellant, during which period no unnecessary adjournment(s) shall either be sought by the learned counsel for the appellant and/ or be granted by the learned Controller.

7. No order as to costs.

8. A copy of this order be sent to the learned Controller of Patents, Designs and Trademarks, Boudhik Sampada Bhawan, Plot No. 32, Sector-14, Dwarka, New Delhi-110 078.

9. Learned CGSC is also directed to communicate the aforesaid directions to the learned Controller of Patents, Designs and Trademarks.

SAURABH BANERJEE, J

APRIL 16, 2025/akr