



2026:DHC:981



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IN THE HIGH COURT OF DELHI AT NEW DELHI*Reserved on: 06.11.2025**Date of decision: 03.02.2026**Date of uploading: 05.02.2026*

+ W.P.(C)-IPD 10/2025

YANGTZE MEMORY TECHNOLOGIE
CO LTD

.....Petitioner

Through: Mr. Pradeep Koshti, Ms. Namitha
Prasad, Mr. P Adityan and Mr. Anit
Kumar Singh (through vc)

versus

UNION OF INDIA & ANR.

.....Respondents

Through: Ms. Kangan Roda, Adv.

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CORAM:**HON'BLE MS. JUSTICE MANMEET PRITAM SINGH ARORA****J U D G M E N T****MANMEET PRITAM SINGH ARORA, J****W.P. (C)- IPD 10/2025****Factual Matrix**

1. The Petitioner on 9th May 2021, filed Indian Patent Application No. 202127020980 [‘Parent Application’], claiming priority from PCT/CN2018/119908 dated 7th December 2018, along with a request for examination under Section 11B of the Indian Patents Act, 1970 [‘the Patents Act’], and corresponding rules of the Indian Patent Rules, 2003 [‘Patent Rules’].



2. The bibliographic details of the Parent Application are as follows:

Title:	NOVEL 3D NAND MEMORY DEVICE AND METHOD OF FORMING THE SAME	
Applicant:	YANGTZE MEMORY TECHNOLOGIES CO., LTD.	
ProdyoVidhi Ref. #:	NTD1062IN	
Item:	Number	Date
Indian Patent App. #:	202127020980	09-May-2021
PCT App. #:	PCT/ CN2018/119908	07-Dec-2018
Priority Data #:	PCT/ CN2018/119908	07-Dec-2018
Request of Exam. #:	R20212016205	09-May-2021

3. The Parent Application underwent examination, and Respondent No.2/Assistant Controller of Patents and Designs [‘Controller’], through its Mumbai office, issued a First Examination Report [‘FER’] on 23rd May 2022, where Controller has raised objection to the claims of the Parent Application under Section 10(5) of the Patents Act as containing plurality of inventions which are not linked by single inventive concept. The Petitioner filed its response to FER on 19th September 2022. The Petitioner responded to the objection by stating that the multiple independent claims are linked to a single inventive concept.

4. Following this, the Controller issued a hearing notice, maintaining objections from the FER and scheduled the hearing for 7th June 2024.

5. The Petitioner appeared at the hearing on 8th July 2024, and argued that the claims complied with common inventive features, justifying their allowance as multiple independent claims. Following the hearing, detailed written submissions were filed on 22nd July 2024.

6. In the written submissions, the Petitioner has mentioned its intention



to file a division application if the Controller is not satisfied with their arguments under Section 10(5) of the Patents Act.

7. Since the Controller was satisfied with the submissions made by the Petitioner under Section 10(5) of the Patents Act, the Parent Application was granted on 26th July 2024.

Aggrieved by the order allowing the Parent Application, which consequently closed the window available to the Petitioner for filing a divisional application, the present petition has been filed before this Court.

Submissions by the Petitioner

8. Mr. Pradeep Koshti, learned counsel appearing on behalf of the Petitioner has made the following submissions:

8.1. He states that the Petitioner had duly instructed its representatives to prepare and file a divisional application before the grant of the Parent Application, precisely, on 28th June, 2024.

8.2. He states that the Petitioner had also sought an extended hearing to file a divisional application covering both the disclosed inventions and the claims not allowed by the Controller before deciding the grant of the Parent Application.

8.3. He states that the Petitioner clearly expressed the intent to file a divisional application including claims identified as lacking common inventive features as well as claims pertaining to the invention disclosed in the specification, pursuant to the communication dated 28th June 2024; the Controller agreed, assured further hearings, and directed the Petitioner to file written submissions.

8.4. He states that the written submissions were filed on 22nd July 2024, clearly recording the Petitioner's intent to file a divisional application and



the Controller's assurance of an extended hearing. The submissions summarised the hearing discussions on the divisional application, noted the reservation of decision on the allowability of multiple independent claims in the Parent Application, and emphasised the inclusion of disallowed claims in the divisional application. The Controller acknowledged the submissions, granted the request for an extended hearing, accepted the justification of a single inventive concept, waived objections on claim characterisation, and noted that all formal requirements had been complied with.

8.5. He states that, however, on 26th July 2024, the patent was granted without prior notice or promised hearing, thereby affecting the Petitioner's right to file divisional applications. In this regard, reliance is being placed upon the judgment by the Madras High Court in **BASF SE v The Deputy Controller of Patents and Designs**¹.

8.6. He states that upon noticing the grant of the application, the Petitioner immediately brought the matter to the notice of the concerned authorities and attempted to file a divisional application and a petition under Rules 138/137, demonstrating bona fide intent and due diligence; however, the official e-filing system did not permit such filing, as the relevant options were disabled. Between 26th July 2024 and 23rd September 2024, the Petitioner repeatedly communicated with the Controller regarding the grant and sought acceptance of the divisional application.

8.7. He states that the Petitioner yet again tried to file the divisional application on the IT window of the Controller; however, the IT window did not allow the same to be filed.

¹C.M.A.(PT) No.38 of 2024



8.8. He states that on 1st August 2024, the Petitioner sent an email explaining the circumstances and the powers vested in the Controller to remedy the issue. Thereafter, on 2nd August 2024, the Petitioner made a detailed representation seeking re-opening of the window for filing a divisional application in respect of Parent Application, followed by reminder communications dated 6th August 2024.

8.9. He states that, however, on 6th August 2024, the Controller expressed its inability to accept the divisional application due to insufficient provisions, procedures, and IT infrastructure. It cited limitations of Section 16(1) and acknowledged a significant lacuna in the patent system, noting the absence of established practices, guidelines, or rules regarding the timeline for disposing of applications after written submissions.

8.10. He states that in a communication dated 20th September 2024, the Controller, while deferring judgment to higher authorities, noted that there were no objections in the FER regarding the unity of invention and acknowledged that adherence to proper timelines was followed in issuing the grant order. And that Section 16(1) of the Patents Act allows for divisional applications to be filed before grant.

8.11. He states that on 20th September 2024, the Petitioner sought and was granted leave by the Controller to make more elaborate submissions. Pursuant thereto, the Petitioner informed that a detailed representation was being prepared and subsequently filed the same on 23rd September 2024.

8.12. He states that the Petitioner took all precautionary actions and acted diligently, without abandoning the right, with a clear intent to exercise the right, and in good faith. In this regard, reliance is being placed upon the judgment by a Co-ordinate Bench of the Court in **European Union**



Represented by the European Commission v. Union of India & Ors². The right to file a divisional application was adversely affected, with ‘no opportunity of such hearing’ afforded to the Petitioner, thus violating the principles of natural justice.

Submissions on behalf of the Respondents

9. Ms. Kangan Roda, learned counsel appearing on behalf of the Respondents, has made the following submissions:

9.1. She states that the Parent Application is a National Phase Application that arose out of the Petitioner’s PCT International Application. It is stated that the address provided by the Petitioner for the purpose of the Parent Application was not located in India. The address for service was in Indore, Madhya Pradesh, while the appropriate office for the Petitioner’s application was determined to be Mumbai.

9.2. She states that the Controller’s office has a system of automatic allotment of any patent application for examination and adjudication, without any human intervention. Therefore, when the Petitioner filed a request for examination on 9th May 2021 addressed to the Mumbai office, the application was automatically assigned to the Assistant Controller at Kolkata.

9.3. She states that the FER dated 23rd May 2022 was issued on behalf of the Controller of Patents, Mumbai, directing that all communications be addressed to the Mumbai office. The Petitioner accordingly addressed its replies and subsequent correspondence, including the reply to the FER and the Proof of Right, to the Controller of Patents at Mumbai. Although hearing

²2022 SCC OnLine Del 1793



notices scheduling and adjourning the hearing were thereafter issued by the Delhi office, the Petitioner continued to address its communications to the Mumbai office, and even the written submissions filed on 22nd July 2024 did not specify any particular office of Respondent No.2. While the intimation of grant dated 26th July 2024 mentions the Controller of Patents, Delhi, it is stated that the said intimation was, in fact, issued by the Mumbai office.

However, this does not alter the fact that the Mumbai Office of the Controller remained the appropriate office for all substantive proceedings, as evident from the intimation of grant and the Petitioner's own conduct. Accordingly, the petition is not maintainable for lack of territorial jurisdiction.

9.4. She states that the Petitioner had filed the patent application on 9th May 2021, and the patent was granted to the Petitioner by the Controller only in 2024. Thus, the Petitioner had ample opportunity to file the request for division of the patent application prior to the grant of the patent as per Section 16 of the Patents Act.

9.5. She states that the Petitioner had never communicated its intent to file for the division of the application prior to the grant of the patent. There was no bar on the Petitioner to file for the division of the application suo moto prior to the grant of the patent by the Controller.

9.6. She states that the Petitioner has heavily relied on correspondence that appears to be internal and doesn't relate to the Controller.

9.7. She states that the Petitioner has misinterpreted various communications exchanged with the Controller. The Petitioner's reliance on its written submissions to showcase its intention to file a divisional application is incorrect and contrary to what has been stated in the said



submissions. On the contrary, the said submissions pray for an expeditious grant of the patent. It stated that the Petitioner cannot be allowed to approbate and reprobate, i.e., it cannot first seek expeditious grant of the patent and then state it is aggrieved by the grant of said action. In fact, the Petitioner had candidly acknowledged that in case the Controller believed that the claims represent distinct inventions, the Petitioner would be willing to remove one set and pursue the same in a divisional application, which substantiates the fact that the Petitioner has no intention to file for the divisional application on a suo moto basis.

She further states that the email dated 6th August 2024 has been wrongly construed, as the Controller neither acknowledged any lacuna in the patent system nor expressed inability to accept a divisional application; rather, the Petitioner was informed that no intent to file a divisional application had been communicated.

9.8. She states that the Petitioner failed to raise any objection regarding the unity of invention during the FER or the hearing notices. The Controller has waived all pending objections prior to the grant of the patent

9.9. She states that since the Controller had waived all pending objections prior to the grant of the Parent Application, no division of the application was required under Section 16 of the Patents Act. Had any such objection existed, the patent would not have been granted. The Parent Application was granted expeditiously on 26th July 2024, in line with the Petitioner's written submissions, and there was no obligation on the Controller to delay its disposal.

9.10. She states that the Petitioner only expressed its intent to file the divisional application on 31st July 2024, i.e., post-grant of the Parent



Application. The correspondences were only post-grant and don't constitute formal submissions during the prosecution phase. She states that the Controller never assured the Petitioner of a definite further hearing as alleged by it.

9.11. She states that once a patent has been granted, the same has attained finality and cannot be subject to a division. Neither does the Patents Act permit post-grant division of applications, nor does this petition call for any exercise of discretionary power by the Controller.

ANALYSIS

10. This Court has heard the learned counsel for the parties and perused the material on record.

11. In the facts of this case, the patent was granted on 26th July, 2024, and the Petitioner admittedly sought to file a divisional application on 31st July, 2024, after the grant of the patent. The Petitioner is aggrieved by the non-acceptance of the divisional application by the Controller and seeks a direction to the Controller to accept the divisional application.

12. The issue arising before this Court for consideration in this matter is whether it is permissible in law for the Petitioner to file a divisional application after the Controller has already granted a patent for the Parent Application.

Filing of Divisional Application

13. For deciding this issue, this Court shall primarily examine the requirements for filing a divisional patent application under Section 16 of the Patents Act. The said section is reproduced below:

“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.]”

[Emphasis Supplied]

14. The requirements under Section 16 are as follows:

- a) Sub-section 1 stipulates that the person filing the divisional application should be the same person who filed the first-mentioned application (i.e., the parent application).
- b) Sub-section 1 stipulates that the divisional application should be filed before the grant of a patent on the first-mentioned application (parent application).
- c) Sub-section 1 stipulates that a divisional application can be filed by the patent applicant on his/her own volition *or* with a view to remedying the objection raised by the controller on the ground that the claims of the complete specification in the parent application



related to more than one [1] invention/inventive concept.

- d) Sub-section 1 further stipulates that the divisional application is to be filed in respect of an invention disclosed in the provisional or complete specification, which is already filed in respect of the parent application.
- e) Sub-section 2 stipulates that the divisional application should be filed with a complete specification, but such a complete specification shall not include any matter not in substance disclosed in the complete specification of the parent application.
- f) Sub-section 3 stipulates that the controller may require amendment of the complete specification filed in pursuance of either the parent application or the divisional application, as may be necessary to ensure that both the divisional and parent application(s) have a distinct set of claims.
- g) The explanation to Section 16 seeks to clarify that the divisional application, even if filed later, will be deemed to have been filed on the date on which the parent application was filed.

It further clarifies that the divisional application shall proceed as a substantive application, i.e., a distinct application and be examined when the request for examination is filed, within the prescribed period.

15. In the present case, it is the case of the Petitioner that it intended to file a divisional application; and had *orally*³ intimated the same to the Controller, who *orally* promised an extended hearing. The Petitioner is

³ post hearing dated 8th July 2024



aggrieved that however, the Controller thereafter without awaiting the divisional application proceeded to grant the Parent Application on 26th July, 2024, thereby depriving the petitioner an opportunity to file the divisional application. To substantiate this plea of *oral* request, the Petitioner relies solely upon the written submissions dated 22nd July, 2024.

Burden of filing the Divisional application

16. From Section 16(1) of the Patents Act, it is clear that an applicant can file the divisional application themselves if they so desire, or to overcome any objection raised by the Controller qua the Parent Application as regards plurality of inventions in the claims of the complete specification; however, prior to the grant of the patent.

17. In the present case, the Petitioner was at liberty to file the divisional application within the window between the date of filing of the Parent Application, i.e., 09th May, 2021, and the date of grant of patent, i.e., 26th July, 2024, which exceeds three [3] years. However, the Petitioner at no stage prior to 26th July 2024 filed any divisional application and sought to file the said application only on 31st July, 2024.

18. Now this Court shall examine if the Controller had raised an objection against the claims of the complete specification of the Parent Application, which could give a cause to the Petitioner to consider an option to divide the Parent Application and file a divisional application in order to overcome any objection from the FER or hearing notice.

19. Upon perusal of the FER and hearing notice, it is apparent that the Controller has consistently raised an objection under Section 10(5) of the Patents Act, alleging that the claims of the Parent Application contains plurality of inventions which are not part of a single inventive



concept.

The objection raised by the Controller regarding the plurality of inventions presented in the claims of the Parent Application as barred under Section 10(5) of the Patents Act in the FER dated 23rd May 2022⁴ is as follows:

“The term “further comprising” in dependent claims tends to widen the scope of the subject matter claimed from the preceding claims.

The plurality of independent claims as well as the dependency of claims is such that the scope of protection sought is indefinite and do not satisfy the requirements of sections 10(4)(c),10(5) respectively of the Act. Claims shall be redrafted such that all independent claims shall have a specific inventive embodiment different from all other independent claims, besides the all essential common inventive feature being present in each of them individually as required u/s 10(4)(c),10(5).

Drafting of claims is not proper because of which the nature & scope of the alleged invention cannot be clearly ascertained. **Multiple independent claims claimed in the present set of claims do not relate to group of inventions linked by a single inventive concept fairly based on the matter disclosed in the specification as per Section 10(5) which is a precondition for claiming multiple independent claims. Therefore fresh set of claims should be drafted & all essential features of the invention should be brought in claim 1 while subsidiary features of the invention may be claimed in dependent claims to avoid any ambiguity in the scope of protection.”**

[Emphasis Supplied]

The objection raised by the Controller regarding the plurality of inventions in the claims of the Parent Application, as barred under Section 10(5) of the Patents Act in the hearing notice dated 13th June 2024, is as follows:

“2. Multiple independent claims lack succinctness. Independent claims should be suitably linked with principal claim to make them clear, succinct and substantially definitive in accordance with the requirements of section 10(5) of The Patents Act 1970 as amended.

⁴ The FER has been obtained from INPASS, the open access patent database of Indian Patent office <<https://iprsearch.ipindia.gov.in/PublicSearch/PublicationSearch/Search>>



.....

Scope

1. The plurality of independent claims as well as the dependency of claims is such that the scope of protection sought is indefinite and do not satisfy the requirements of sections 10(4)(c),10(5) respectively of the Act. Claims shall be redrafted such that all independent claims shall have a specific inventive embodiment different from all other independent claims, besides the all essential common inventive feature being present in each of them individually as required u/s 10(4)(c),10(5).

Drafting of claims is not proper because of which the nature & scope of the alleged invention cannot be clearly ascertained. **Multiple independent claims claimed in the present set of claims do not relate to group of inventions linked by a single inventive concept fairly based on the matter disclosed in the specification as per Section 10(5) which is a precondition for claiming multiple independent claims. Therefore fresh set of claims should be drafted & all essential features of the invention should be brought in claim 1 while subsidiary features of the invention may be claimed in dependent claims to avoid any ambiguity in the scope of protection”**

[Emphasis Supplied]

20. Upon examining both the FER dated 23rd May 2022 and the hearing notice dated 13th June 2024, it is evident that the Controller consistently raised the objection that the Parent Application contains claims covering plurality of inventions that are not linked to a single inventive concept, as barred under Section 10(5) of the Patents Act.

In these facts, no doubt the Petitioner could have, at the relevant time, elected to file a divisional application to overcome the said objection. However, the Petitioner consciously elected not to file a divisional application and instead chose to file a response to the FER and the hearing notice, disagreeing with the objections of the Controller. In its response, the Petitioner did not assert any option to file a divisional application.



21. As per the record, after being served with the FER, the Petitioner elected to file amended claims on 19th September 2022 to overcome the objections of plurality of inventions, but it elected *not* to file a divisional application.

The response filed by the Petitioner to the FER overcoming the objection under Section 10(5) of the Patents Act is as follows:

“The Applicant respectfully draws the attention of Honorable Controller towards the MANUAL OF PATENT OFFICE PRACTICE AND PROCEDURE version 3.0 published on 26-Nov-2019 (MPEP), 05.03.17 Structure of Claims item (s) on pp. 45, which clearly mentions that “[t]here may be more than one independent claim in a single application, if the claims fall under a single inventive concept”.

The Applicant respectfully submits, that Amended Claims 12 and 17 are directed towards embodiments of methods of manufacturing of the novel and inventive memory device, thus at least for this reason alone, the subject matter involves a single inventive concept. The Applicant, therefore, submits, that Amended Claims 12 and 17 both are allowable.”

[Emphasis Supplied]

22. Similarly, after being served with the hearing notice 13th June 2024, when the Petitioner elected to appear before the Controller on 8th July 2024, it elected to defend/stand by its amended claims and even at this stage did *not* elect to file any divisional application.

The response in the written submissions dated 22nd July 2024, filed by the Petitioner to the hearing notice for overcoming the objection under Section 10(5) of the Patents Act is as follows:

“3. The Honorable Controller directed Counsel to submit written arguments regarding the allowability of multiple independent claims 12 and 17. The Controller assured Counsel of a further hearing if any issues remain unresolved

.....

7. The Honorable Controller directed the filing of written submissions and assured Counsel of a further hearing if any issues remain unresolved.



.....

Objection: 2. *Multiple independent claims lack succinctness. Independent claims should be suitably linked with principal claim to make them clear, succinct and substantially definitive in accordance with the requirements of section 10(5) of The Patents Act 1970 as amended.*

Reply: During the hearing, the Counsel the two independent method claims (12 and 17). The Counsel submitted that both claims are allowable in this application because they share a single inventive concept: 3D-NAND technology.

Claim 12 lays the foundation by creating the memory itself, focusing on the manufacturing process.

Claim 17 utilizes the memory for a specific function, focusing on data manipulation (erasing).

The claim 12 and 17 of address different aspects of manufacturing and data manipulation and that they are inherently linked by the underlying 3D-NAND technology.

The Counsel respectfully points towards section 05.03.17 of the Patent Office Practice and Procedure (MPEP) version 3.0 (published November 26, 2019), which allows for multiple independent claims in a single application as long as they share a single inventive concept.

However, if the Honorable Controller believes these claims represent distinct inventions, the applicant is willing to remove one set and pursue it in a divisional application under Section 16(3). The Honorable Controller directed that written submissions regarding claim allowability and assured of a further hearing if any issues remain unresolved.

[Emphasis Supplied]

23. Upon perusal of the responses filed by the Petitioner to the FER and hearing notice, it is clear that the Petitioner, before the patent office, has clearly responded to the objection under Section 10(5) of the Patents Act to assert that the independent claims clearly of the Parent Application form part of a *single* inventive concept and had pleaded for waiver of the said objection in light of their arguments/submissions.

24. In the order dated 26th July 2024 granting the patent, the



Controller has recorded the responses filed by the Petitioner in written submissions dated 22nd July 2024, accepting all the arguments of the Petitioner and waiving all the objections, including objection no. 2. The relevant paragraphs from the impugned order are as follows:

“7. After hearing the arguments during hearing and reasoning provided by the applicant in written submission, I agree that amended independent claims 1, 12 and 17 have inventive step over cited documents.

Dependent claims 2-11, 13-16 and 18-20 also have inventive features over the cited documents. During the hearing, I also discussed other issues of claims 1-20 dated 19/09/2022. I also carefully read the written submission about all other objections and found that all objections are fulfilled by the applicant.

Since the applicant has also deleted/merged the claims and suitably amended in view of under section 59 of the Indian Patents act 1970 (as amended), thus claims 1-20 are allowable u/s 2(1)(i).

Order:

8. Hence, in view of the above, the requirements of objections raised through the said hearing notice are met and in absence of any other objection of substantive nature, claims 1-20 dated 19/09/2022 are found to be novel, inventive, clear, definitive and in order, and thereby allowed.

9. Therefore, keeping in view the facts on record, the submissions of the agents during hearing and subsequently through the written submissions, the said patent application no. 202127020980 complies with the requirements of The Patents Act, 1970 (as amended). I, therefore, hereby order the grant of the said patent application 202127020980 u/s 43(1) of The Patents Act, 1970 (as amended) with claims 1-20 as uploaded on 19/09/2022 under the document named “202127020980-AMMENDED DOCUMENTS [19-09-2022(online)].pdf”. There is no pre-grant opposition request filed u/s 25(1).

10. This is to be noted that the aforesaid observations, and decision thereof, are based solely on the electronically uploaded documents to date.”

[Emphasis Supplied]

25. The order dated 26th July, 2024, shows that the Controller accepted the Petitioner’s reply to objection no. 2 raised in the hearing notice to the effect that the amended set of claims filed on 19th September 2022, addressed the



objection of the Controller raised under Section 10(5) of the Patents Act. As noted above, the Petitioner has relied upon its *oral* request for filing divisional application to the Controller for alleging illegality. The *oral* request is recorded in the post-hearing written submissions dated 22nd July 2024, filed with the Patent Office, while responding to objection no. 2 of the hearing notice. In this written submission, Petitioner refers to an *intention* to file a divisional application and extended hearing by the Controller, *if* the issues are unresolved.

26. The willingness of the Petitioner to file a divisional application as recorded at paragraph '5' of the written submissions dated 22nd July 2024 of the Petitioner was clearly an alternative reserved by the Petitioner in response to objection no. 2 to be exercised by it in case of non-resolution of the objection raised by the Controller under Section 10(5) of the Patents Act. Thus, the Petitioner even as on 22nd July 2024, consciously did not proceed to file a divisional application suo motu, but left the matter to the discretion of the Controller, contingent upon the outcome of the Parent Application.

27. However, the Controller waived all its objections, including the objection no.2 that the claims of the complete specification of the subject application does not fulfil Section 10(5) of the Patents Act, based on the Petitioner's written submissions dated 22nd July 2024 and hearing dated 8th July 2024, and proceeded to grant the Parent Application on 26th July 2024. Therefore, the reserving of right to file divisional application documented in the written submissions dated 22nd July 2024 lost relevance and was not triggered. Therefore, this Court finds no error in the decision of the Controller; and is unable to appreciate the grievance of the Petitioner in this writ petition.



28. The Petitioner has neither, during the course of arguments nor in the writ petition, demonstrated any prejudice caused to it on account of the non-filing of the divisional application.

29. The onus/discretion to file a divisional application under Section 16(1) of the Patent Act lies exclusively with the Applicant, i.e., the Petitioner herein, which was consciously not exercised by it at any time prior to 26th July 2024.

Section 16(1) of the Patents Act is very clear and it stipulates that the divisional application is to be filed before the Parent Application has been granted. The Petitioner however, sought to file the divisional application only on 31st July 2024 which is beyond the stipulated period under Section 16(1) of the Patent Act and therefore, it has rightly not been accepted by the Patent Office.

The Petitioner cannot be permitted to agitate and assert a right to file a divisional application after the grant of the Parent Application, particularly when no such step was taken at the relevant stage before the Controller, as examined in the facts of this case. Therefore, the Petitioner's submission alleging a violation of the principles of natural justice is wholly devoid of merit.

30. Also, it is the argument of the Petitioner that the Parent Application was granted abruptly without any notice to the Petitioner, which in effect closed their window period to file a divisional application. The process for granting a patent is as per Section 43 of the Patents Act. The said section is as follows:

“43. Grant of patents.—(1) Where an application for a patent has been found to be in order for grant of the patent and either—



(a) the application has not been refused by the Controller by virtue of any power vested in him by this Act; or

(b) the application has not been found to be in contravention of any of the provisions of this Act, **the patent shall be granted as expeditiously as possible to the applicant or, in the case of a joint application, to the applicants jointly, with the seal of the patent office and the date on which the patent is granted shall be entered in the register.**

(2) On the grant of patent, the Controller shall publish the fact that the patent has been granted and thereupon the application, specification and other documents related thereto shall be open for public inspection.”

[Emphasis supplied]

31. According to Section 43 of the Patents Act, a patent application found to satisfy all the pending objections is to be proceeded to grant as expeditiously as possible. There is no statutory provision under the Act obligating the Controller to communicate a notice to the applicant indicating the grant of a patent prior to the grant of the same. Hence, the Petitioner's contention of lack of notice prior to the grant of the Parent Application is without any merit.

32. The Petitioner has relied on **BASF SE v The Deputy Controller of Patents and Designs**(supra), a recent judgment by the High Court of Madras, for seeking a direction to the Controller to accept its divisional application. In the facts of the said case, the High Court concluded that the divisional application was filed by the applicant prior to acquiring knowledge regarding the grant of the patent application and therefore held the same to be maintainable. The said judgment is not applicable to the facts of this case, as admittedly the Petitioner herein attempted to file a divisional application on 31st July, 2024, much after the grant of the patent.

33. Before closing the matter, it is noted that the Respondents, in their



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counter-affidavit, have raised an objection regarding the lack of territorial jurisdiction. However, the Respondents themselves have admitted that a part of the cause of action arose in Delhi, inasmuch as two [2] hearing notices dated 10th June 2024 and 13th June 2024 were issued by the Delhi Office of the Controller. In addition, the Controller's decision dated 26th July 2024 was issued on the letterhead of the Controller of Patents, Patent Office, Delhi. Therefore, this Court has jurisdiction to entertain the present petition.

34. On merits, however, this Court is unable to find any merit in this petition; hence, the same is dismissed.

35. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trade Marks of India on the e-mail- llc-ipo@gov.in.

MANMEET PRITAM SINGH ARORA
(JUDGE)

FEBRUARY 03, 2026/aa/fv