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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% *Date of Decision: 29th April, 2026*

+ C.A.(COMM.IPD-PAT) 65/2024

ABBVIE IRELAND UNLIMITED COMPANYAppellant

Through: Mr. Pravin Anand, Ms. Archana Shankar and Dr. Sachin Malik, Mr. Shrawan Chopra and Mr. Achyut Tewari, Advocates.

versus

DEPUTY CONTROLLER OF PATENTS DESIGNS

.....Respondent

Through: Ms. Shiva Lakshmi, SPC with Mr. Praver Dennison and Ms. Anugya Gupta, Advocates.

Dr. Sunita Rani, Deputy Controller through VC.

CORAM:

HON'BLE MS. JUSTICE JYOTI SINGH

JUDGEMENT

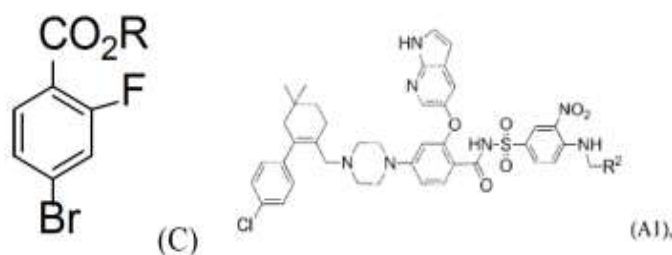
JYOTI SINGH, J. (ORAL)

1. This appeal is filed on behalf of the Appellant under Section 117(A) of the Patent Act, 1970 ('1970 Act') read with Rule 6 of the Delhi High Court Intellectual Property Rights Division Rules, 2022 ('2022 Rules') read with Section 151 CPC challenging impugned order dated 30.03.2024 passed by the Respondent refusing Indian Patent Application No. 201918048639.
2. To the extent necessary, the facts are that the Appellant filed the subject application bearing No. 201918048639 in Indian Patent Office on 27.11.2019 derived from Parent Application No. 8479/DELNP/2015 (Patent No. 328705) titled '*PROCESSES FOR THE PREPARATION OF AN APOPTOSIS-INDUCING AGENT*'. Request for Examination was filed on 27.11.2019 and the application was published on 07.02.2020. The patent



application was filed with PCT claims 1-30 on 15.09.2015 and the application was examined and First Examination Report ('FER') was issued on 31.05.2019 raising objections *inter alia* on ground of lack of inventive step under Section 2(1)(ja) of 1970 Act. Response was filed by the Appellant to the FER on 15.09.2020 along with claim amendment. After the hearing, which concluded on 28.11.2023, Appellant filed post-hearing written submissions on 13.12.2023. By impugned order dated 30.03.2024, Respondent refused the application on the ground that objections raised in the hearing notice were outstanding and Appellant's agent did not comply with technical objections of Sections 16 and 2(1)(ja) of 1970 Act for lack of inventive step.

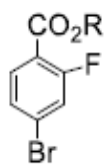
3. Appellant is stated to be a leading pharmaceutical company engaged in manufacture and sale of pharmaceutical and medicinal products and has to its credit several patented inventions. It has grown leaps and bounds with its research and development facility. The claimed invention relates to process for preparing an intermediate compound of formula (C) used in preparation of compound of formula (A1):



4. It is stated in the appeal that several inventions have been disclosed in the PCT Application No. PCT/US2014/024224 *inter alia* a process for preparing the compound of formula (A1) as well as additional invention, including process for preparing an intermediate compound of formula (C).

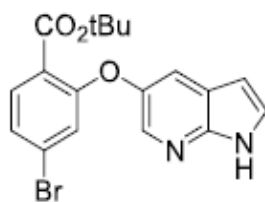


Divisional Application was filed by the Appellant with claims 1-16, which were directed to a process of preparing compound of formula (C)



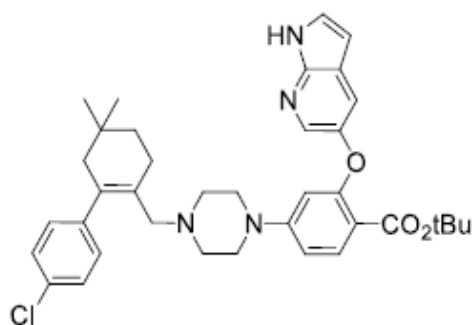
(C)

(claims 1-6); a compound for formula D



(D)

(claims 7-10); and a compound of formula (3)



(3)

and process for preparation of

the same (claims 11-16).

5. It is stated that on 28.11.2019, Appellant filed claim amendment to delete claims 7-16 and retain claim set 1-6. FER was issued by the Respondent on 16.03.2020, in which the substantive objections were:

- (a) The instant divisional application of claims 1-6 was not allowable under Section 16 of 1970 Act as the same claims were already granted in parent application; and
- (b) The claimed invention lacked inventive step in view of prior art documents: **D1**: WO2011/150016 A1; **D2**: ARRENDONDO ET AL, "Preparation of 1-5 t- Butyl-3- Bromo-5- Formylbenzoate Through



Selective MetalHalogen Exchange y Reactions, ORGANIC SYNTHESSES, vol. 89, 1 January 2012 (2012-01-01), page 460; D3: T. RAUSIS ET AL, "The Basicity Gradient- Driven Migration of Iodine: Conferring Regioflexibility on the Substitution of Fluoroarenes", EUR. J. ORG. CHEM., (20020101), pages 3351–3358; and **D4:** V. BAVETSIAS ET AL, "Synthesis of N-substituted derivatives of tert-butyl 4- aminobenzoate via a palladium catalysed reaction", J. CHEM. RESEARCH (S), (20000901), pages 418-419.

6. It is stated that Appellant filed response to the FER on 15.09.2020 distinguishing the claimed invention from prior arts D1-D4 and also contesting the objection that the divisional application was not maintainable. In the hearing notice dated 23.11.2023, Respondent maintained the ground of maintainability of the divisional application in view of IN 328705, the parent application as also objection with regard to lack of inventive step of claims 1-6. Post-hearing submissions were filed by the Appellant on 13.12.2023. Respondent refused the application under two heads: (a) each and every feature of present invention was obvious from the teachings of D1-D4; and (b) claims of divisional application were not maintainable under Section 16 of 1970 Act as the same claims were granted as claims 14-18 in IN'705.

7. Challenging the impugned order, Mr. Pravin Anand, learned counsel for the Appellant submits that finding of the Respondent with regard to maintainability of the divisional application under Section 16 is wholly erroneous. Respondent failed to appreciate that claim 26, which relates to process for preparing the intermediate C was held as being related to distinct



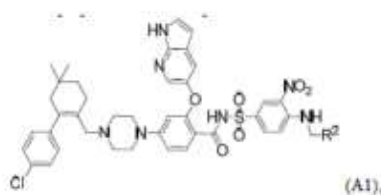
invention in the FER of Parent Application No. 8479/DELNP/2015. Having raised an objection of unity of invention, Appellant cannot be denied a right to file divisional application for the subject matter. Reference is made to orders passed by the Intellectual Property Appellate Board ('IPAB') in *Milliken & Company v. Union of India through the Secretary Department of Industry, Ministry of Industry and Commerce and Others*, 2016 SCC OnLine IPAB 7; *Syntonix Pharmaceuticals, Inc., (A United States Corporation) of 9 Fourth Avenue, Waltham MA 02451 United States of America v. The Controller of Patents & Designs, Bouddhik Sampada Bhavan Near Antop Hill Post Office S.M. Road, Antop Hill, Mumbai-400037 and Another*, 2014 SCC OnLine IPAB 28; and *National Institute of Immunology Aruna Asaf Ali Marg, New Delhi - 110 067 v. The Assistant Controller of Patents & Designs, The Patent Office, Boudhik Sampada Bhawan Plot No. 32, Sector-14, Dwarka, New Delhi - 110 075*, 2015 SCC OnLine IPAB 80, where it was held that once the Applicant files a divisional application owing to an objection raised by the Patent Office, it cannot be denied the right to file a divisional application and be left in a lurch. Hence, on this ground alone, the impugned order deserves to be set aside.

8. It is further urged that even otherwise, Respondent failed to appreciate that claims of parent application as granted and claims 1-6 in the present divisional application relate to two distinct inventive concepts. Claims of parent application are directed to a process of preparing a compound of formula (A1), whereas claims of divisional application are directed to a process for preparing intermediate compound for formula (C). The error is writ large when Respondent refers to claims of present application as falling



within the scope of claims 14-18 of the parent application. Claim 14 is a dependent claim and part of the process of preparing compound of formula (A1) as detailed below:-

- (i) Parent IN328705 is directed to a process for preparing the compound of formula A1



which comprises:

- (a) combining a compound of formula (K) with a tert-butoxide salt, an aprotic organic solvent, and water to provide a compound of formula (L):

And

- (b) combining the compound of formula (L) with 1-ethyl-3-(dimethylaminopropyl)carbodiimide hydrochloride, 4-dimethylaminopyridine, an organic solvent, and either a compound of formula (N), to provide a compound of formula (A1) or a compound of formula (P), to provide a compound of formula (A1):

wherein the compound of formula (K) is prepared by:

- (c) combining a compound of formula (D) with a compound of formula (I): a source of palladium, a tert-butoxide salt and a phosphine ligand in an aprotic organic solvent to provide the compound of formula (K).

9. It is urged that the process as claimed in any one of claims 1-6 and



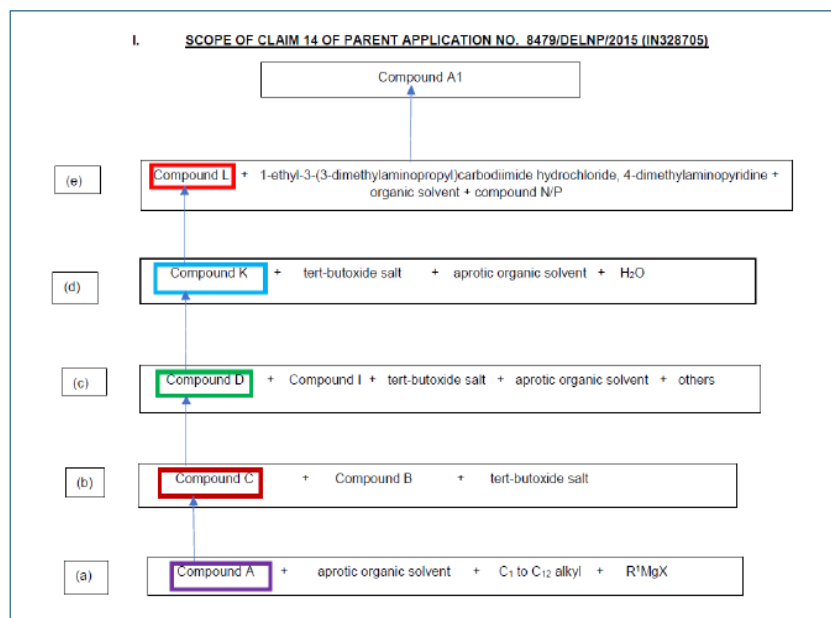
7-12 is where the process further comprises combining a compound of formula (B) with a compound of formula (C) and a tert-butoxide salt in an organic solvent to provide the compound of formula (D) and the process as claimed in claim 13 is where the compound of formula (C) is prepared by: (a) combining a compound of formula (A) with R^1MgX in an aprotic organic solvent; and (b) combining a C_1 to C_{12} alkyl chloroformate or a di- (C_1 to C_{12} alkyl) decarbonate with the product of step (a), to provide the compound of formula (C). It is thus clear that invention involved in the parent application was in relation to preparation of compound of formula A1 (final product) whereas the claims of the present divisional application claims 1-6 is directed to a process for preparing intermediate i.e., a compound of formula (C):



10. To explain the point further, Mr. Anand draws the attention of the Court to a chart as follows and also relies on the judgment of the Division Bench of this Court in *F.Hoffmann-La Roche Ltd. & Anr. v. Cipla Ltd., 2015 SCC OnLine Del 13619*, wherein while elucidating principles of claim construction, the Court observed that where the claims are ‘dependent’, they incorporate by reference ‘everything in the parent claim and add some further statement, limitations or restrictions and submits that claim 14 of the parent application is an integral part of the entire scheme and process for preparing compound of formula (A) and in contrast, the divisional application is only for a process for preparing the intermediate. He further



submits that a process for preparing compound of formula (A1) and process for preparing intermediate are two different inventions. For instance, a patentee may not be able to file a law suit for infringement against the third party, which only prepares the intermediate according to claim 14 of the parent case unless the third party also uses the same process to prepare a compound of formula (A1) but on the other hand, the process of preparing the intermediate as claimed in the divisional application, as and when granted, may entitle the patentee to file a law suit against manufacture of intermediate even though the third party is not making the final product i.e., compound of formula (A1). Claim 1 of divisional application is a single step process unlike the scope of claim 14 of parent application. For ready reference, scope of claim 14 under parent application and scope of claim 1 of divisional application as brought forth by Mr. Anand is referred below:-





Claim 1 of divisional application

Compound A + aprotic organic solvent + C₁ to C₁₂ alkyl + R'MgX

11. Without prejudice to the preliminary contention that matter deserves to be remanded on the sole ground that the divisional application has been held to be non-maintainable, Mr. Anand submits that there is another fallacy and grave error in the impugned order inasmuch as Respondent has neither carried out any inventive step analysis with regard to prior arts D1-D4 before refusing the application on ground of lack of inventive step. Respondent has simply reproduced the objection under the head of inventive step in the hearing notice and FER. There is non-consideration of submissions made by the Appellant in response to the FER and in relation to D1, Respondent has simply reproduced pages 73 and 74 of document D1. Insofar as D3 is concerned, Respondent has simply pasted the abstract and representation of the said document and even in the comparative table, paragraphs from D3 have been simply copied and pasted. In any event, there is no teaching in D1 relating to process for preparing compound of formula (C) as the said compound is distinct from formula (26) of D1 in terms of structure since the latter contains -F at para-position to ester group in contrast to the -F at ortho position. D1 also does not disclose or suggest any method of preparing methyl 2,4-difluorobenzoate, much less by the method recited in claims 1-6. Interestingly, there is no finding in the impugned order as to how D1 renders the claim of the present application lacking in inventive concept.

12. It is urged that D2 is directed to a process for preparation of t-Butyl-3-Bromo-5-Formylbenzoate through selective Metal-Halogen Exchange



Reactions and does not disclose or suggest any reaction starting with a reactant having formula (A). Objective of D2 is to prepare t-butyl-3-bromo-5-formylbenzoate (2) using t-butyl-3,5-dibromobenzoate (1) through metal-halogen exchange reactions as also to make use of t-butyl esters as a protecting group for the ester functionality in subsequent Grignard chemistry instead of using methyl or ethyl esters and this objective is exemplified by reaction of t-butyl-3,5 dibromobenzoate obtained by method with isopropylmagnesium chloride with addition to dimethylformamide. Process of compound (C) does not proceed using transition metal-catalyzed carbonylation reactions. There is no reason to modify compounds disclosed in D2 to arrive at compound of formula (A) since none of the compounds in the cited reference comprise an iodo substituent. Further an ordinary skilled person will have no reason to modify the reaction disclosed in D2 in view of the disclosure therein that prior authors showed '*good reactivity and very high selectivity for metal-halogen exchange reactions of dibromoarenes using lithium tri-n-butylmagnesium complex*'. D3 also does not disclose or suggest any reaction starting with reactant having formula (A). The method in D3 starts with compound 14, which comprises three halo substituents and further discloses reacting intermediate compound with carbon dioxide and does not disclose or suggest C1 to C12 alkyl chloroformate or di-(C1 to C12 alkyl) carbonate required by the claims. D4 does not correct the deficiencies of prior arts D1-D3. In fact, reason for reference to prior art D4 is not known inasmuch as it discloses techniques for coupling a substituted phenyl compound and an amino compound by replacing a bromine atom, which is a para position relative to a butoxide ester group. For all these reasons, contends Mr. Anand that the matter deserves to be remanded for



fresh consideration.

13. Arguing on behalf of the Respondent, Ms. Shiva Lakshmi, learned SPC submits that subject matter of claims 1-6 of instant divisional application are not allowable under Section 16 of 1970 Act as these very claims stand granted in parent application from 14-18 claims. Additionally, the subject matter of the divisional application lacks inventive step under Section 2(1)(ja) of 1970 Act as the revised claims 1-6 are disclosed in all four cited prior documents D1-D4 either alone or in combination and the cited prior arts make the present claimed invention obvious to a person skilled in the art. Compound 26 of D1 is having similar substituents as claimed in present invention and have been derived from compounds of formula (C), which are derived from compound A using similar process as disclosed in present invention. D2 discloses the same chemical compound and preparation process using same reactants under similar chemical conditions employing same product i.e., compound (C), as in the claimed invention. D3 also discloses similar product and preparation process as detailed in the written submissions. Appellant has failed to provide any advanced technical effect or significant distinguishing features over prior arts. In fact, Appellant admitted in the original complete specification in paragraphs [00108] to [00110] that compound (C) may be prepared by a known method.

14. It is reiterated that Respondent has carried out detailed comparative analysis between the claimed invention and the prior arts in the impugned order before coming to a conclusion that each and every feature of present invention is obvious from the teachings of D1-D4 and there is no technical advancement pointed out. It is also urged that Appellant is under a



misconception that the divisional application has been refused as not maintainable contrary to the impugned order, which shows that application has been refused on merits owing to lack of inventive step in view of prior arts D1-D4.

15. Heard learned counsels for the parties and examined their submissions.

16. In light of the argument made in Court on behalf of the Respondent that the application has not been refused on maintainability, the first and foremost question that needs to be considered is whether the instant divisional application has been refused as not maintainable and on merit or only on merit allegedly, owing to lack of inventive step. Contrary to the submission made on behalf of the Respondent, a plain reading of the impugned order shows that Respondent has captured two objections raised in the FER: (a) subject matter of claims 1-6 of divisional application are not allowable under Section 16 of 1970 Act as they are already granted in parent application from 14-18 claims; and (b) lack of inventive step due to prior arts D1-D4. In the first part of the order, Respondent referred to the objection under Section 16 of 1970 Act and decided the objection in paragraph 6.1 of the order as follows:-

“6.1. The subject matter of claims 1-6 of the instant divisional application are not allowable u/s 16 of the Act, as the same claims are already granted in parent application No. 8479/DELNP/2015 (Patent No. 328705) from 14-18 claims. The process steps, reactants used, reagents used and the product formed as given in the divisional application completely conflicts with the already granted parent application No. 8479/DELNP/2015 (Patent No. 328705). Hence the claims 1-6 of instant divisional application are not allowable as per the provisions of Section 16(3) of the Act, 1970.”

17. Having so held, Respondent decided the objection under Section



2(1)(ja) of 1970 Act in paragraphs 7.1 to 7.12 and 8. Therefore, it is clear that the Respondent has refused the divisional application both on maintainability and for lack of inventive step under Section 2(1)(ja) of 1970 Act. Mr. Anand has referred to a host of points, which according to him carve out a clear distinction between claims 14-18 of the parent application and 1-6 of the claimed invention. None of these points have been analysed and discussed by the Respondent for determining whether the claims of the divisional application were granted under the parent application and in one paragraph, which is unreasoned and non-speaking, maintainability has been decided by observing that process steps, reactant use, reagents use and product formed as given in the divisional application, completely conflict with the already granted parent application. It has been consistently held by Courts that reasons form the heart and soul of an order as a reasoned order not only enables the party to know what factors weighed with the concerned authority to take a decision against the party but also assists the Court, examining the order, in adjudicating the legality of the order under challenge. In any event, once the divisional application was filed at the instance of the Controller, it was not open to the Respondent to reject the same on the ground that the claims under the divisional application stood granted under the parent application. In light of the decisions of IPAB cited by Mr. Anand, which Respondent is unable to distinguish, the finding on maintainability cannot be sustained in law.

18. Mr. Anand has taken pains to draw up what he considers are the differences between claims 1-6 of the divisional application and claim 14 under the parent application and attempted to demonstrate the inventive step for the purpose of Section 2(1)(ja) of the 1970 Act, by pointing out that



claim 14 is a dependent claim and part of the process for preparing compound of formula (A1), while process claimed in claims 1-6 is directed to a process for preparing intermediate i.e., a compound of formula (C). He has taken the Court through a flow chart which shows the five steps involved in the scope of claim 14 and the single step process in claim 1 of divisional application. No doubt, Respondent has examined the objection under Section 2(1)(ja) of 1970 Act with respect to prior arts D1-D4, but even here the Appellant urges that teachings of D1-D4, either standalone or combined, do not lead to the claimed invention as these teachings are not obvious to the person skilled in the art. It is also highlighted that detailed submissions were made on behalf of the Appellant for alleged lack of inventive step but they have not been dealt with in the impugned order, more particularly, with respect to D1 and D4. It is urged that the objectives of D2 and claimed invention are completely distinct and that process of preparation of compound (C) does not proceed using transition metal-catalyzed carbonylation reactions, while one of the objectives of D2 was to make use of t-butyl esters as a protecting group for the ester functionality in subsequent Grignard chemistry instead of methyl or ethyl esters. In respect of D3, it is urged that it does not disclose or suggest any reaction starting with a reactant having formula (A) and the method to prepare compound 15 therein starts with a compound which comprises three halo substituents which is not the same as compound of formula (A) recited in claims 1-6.

19. Court finds from the documents on record that Appellant has elaborately brought forth what it perceived were the differences and dissimilarities in the claimed invention and cited prior arts, some of which have been captured above and in order to deal with the objection of lack of



inventive step, Respondent has made comparative tables between present invention and prior arts separately giving their objective, structure, reaction scheme, reactants and product yield and concluded under each table that the prior art disclose the claimed invention, however, there is no analysis of similarities alleged nor any discussion on dissimilarities/differences, if any, pointed out by the Appellant. Refusing a patent application is a serious matter as it not only takes away the hard work, labour and skill of applicant invested over years but may also result in an important invention being lost in the process, which would be detrimental to public interest and hence, the least that is expected is that all points raised in response to objections are noted, discussed and analysed and a reasoned order is passed. I am not delving into any further details on merits lest it may prejudice the case of either side, since the matter is being remanded back for all the aforesaid reasons.

20. Accordingly, impugned order dated 30.03.2024 is quashed and set aside directing the Respondent to consider the divisional application being Indian Patent Application No. 201918048639 afresh, after granting opportunity to the Appellant and taking into account the written response to the FER and hearing submissions filed before the Respondent on the objection of lack of inventive step under Section 2(1)(ja) of the 1970 Act.

21. The decision will be taken as expeditiously as possible and not later than four months from today. It is made clear that Court has not expressed any opinion on the merits of the case.

22. Appeal is disposed of.

JYOTI SINGH, J

APRIL 29, 2026/RW/S.Sharma