
**6TH SURANA & SURANA AND SHAASTRA IIT MADRAS
INTELLECTUAL PROPERTY LAW MOOT COMPETITION 2022-2023**

Before

**THE INTELLECTUAL PROPERTY DIVISION
OF THE
HON'BLE HIGH COURT OF JUDICATURE AT HILED**

IN THE MATTER OF -

C.O. (COMM. IPD-PAT) No. 6 OF 2023

SHRADDHA BHAMBANI PLAINTIFF

v.

BROESHIM (INDIA) PRIVATE LIMITED DEFENDANT

MEMORANDUM ON BEHALF OF THE PLAINTIFF

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LIST OF ABBREVIATIONS

&	And
§, Sec.	Section
AIR	All India Report
Art.	Article
Edn.	Edition
Eg.	Example
Govt.	Government
Hon'ble	Honourable
i.e.	That is
Id., Ibid.	In the same place
No.	Number
SC	Supreme Court
vs./v.	Versus
CPC	Code of Civil Procedure, 1908
EV	Electric Vehicles

INDEX OF AUTHORITIES

1. CASES REFERRED:

Ajay Industrial Corporation v. Shiro Kanao Ibraki City	AIR 1983 Delhi 496
Anup Engineering Ltd. v. Bharat Heavy Electricals Ltd.	1985 PTC 71
ART Screw Co., Ltd. v. Controller of Patents & Designs	2022 SCC OnLine Del 4429
Asian Electronics v. Havells India Pvt. Ltd.	MANU/DE/1343/2010
Avery Dennison Corporation v. Controller of Patents and Designs	(2023) 93 PTC 2006
Beloit Technologies Inc v Valmet Paper Machinery Inc	[1995] RPC 705, 739
Biomoneta Research (P) Ltd. v. Controller General of Patents Designs	2023 SCC OnLine Del 1482
Biswanath Prasad Radhye Shyam v. Hindustan Metal Industries	(1979) 2 SCC 511
Boehringer Ingelheim Pharma vs. MSN Laboratories	OMP No. 85 of 2022
Bristol-Myers Squibb Holdings Ireland Unlimited Company v. BDR Pharmaceuticals International Pvt. Ltd	2020 SCC OnLine Del 1700
Chiron Corp v. Murex Diagnostics	[1995] EWCA Civ J1102-9
Communication Components Antenna Inc. v. ACE Technologies Corp	2019 SCC OnLine Del 9123
Dashmesh Mechanical Works v. Hari Singh	2009 SCC OnLine Del 4384
Enercon (India) Limited v. Alloys Wobben Argestrasse	2013 SCC OnLine IPAB 128
F. Hoffmann-La Roche Ltd. v. Cipla Ltd.	2016 (65) PTC 1
General Tire & Rubber Company v Firestone Tyre & Rubber Company Limited	[1972] RPC 457
Hindustan Lever Ltd. v. Lalit Wadhwa	2007 PTC 35 377
Hybritech, Inc. v. Monoclonal Antibodies, Inc.	802 F.2d 1367, 1376
J. Mitra and Co. Pvt. Ltd v. Kesar Medicaments	2008 SCC OnLine Del 255
K. Manivannan v. Chairman Intellectual Property Appellate Board	2017 SCC OnLine Mad 37800

K. Ramu v. Adyar Ananda Bhavan	2007 SCC OnLine Mad 25
KCJ Corp v Kinetic Concepts Inc.	223 F 3d 1351, 1359
Kirin-Amgen Inc v Hoechst Marion Roussel	[2005] RPC 9
Lallubhai Chakubhai Jariwalla v. Chimanlal Chunilal & Co.	1935 SCC OnLine Bom 20
M.C. Jayasingh v. Mishra Dhatu Nigam Limited	2014 SCC OnLine Mad 163
Malta v. Schulmerich Carillons, Inc	952 F.2d 1320, 1326
MERCK Sharp & Dohme Corporation v. Glenmark Pharmaceuticals Ltd.	2015 SCC OnLine Del 12580
Metro Plastic Industries (Regd.) v. Galaxy Footwear New Delhi	AIR 2000 Del 117
Monasato Company v. Coramandal Indag Products (P) Ltd.	1986 AIR SC 712
National Institute of Virology vs. Mrs. Vandana Bhide	Patent Application 581 /BOM/ 1999
Parkinson v. Simon	(1844) 11 RPC 463 (CA)
Perkin-Elmer Corp. v. Westinghouse Elec.	822 F.2d 1528
Poysha Industries Ltd v. Deputy Controller of Patents and Designs	AIR 1975 Cal 178
Raj Prakash v. Mangat Ram Chowdhary	AIR 1978 Del 1
S.A Glaverbel v. Dave Rose	2010 Del SCCOnline Del 308
Symed Labs Ltd. V. Glenmark Pharmaceuticals Ltd.	2015 SCC OnLine Del 6745
Synthon BV v SmithKline Beecham Plc	[2006] RPC 10
Telefonaktiebolaget LM Ericsson (Publ) v. Mercury Electronics	2015 SCC OnLine Del 14638
Tucker v. Naito	188 USPQ 260, 263
Warner-Jenkinson Co Inc v Hilton Davis Chem Co.	520 US 17, 29 (1997)

2. STATUTES, ARTICLES, *et al*:

1. Code of Civil Procedure, 1908, No.5, Acts of Parliament, 1908 (India).
2. The Patents Act, 1970, No. 39, Acts of Parliament, 1970 (India).
3. Convention on the Grant of European Patents, October 5, 1973, 13 INT'L LEGAL MATS. 268 (1974).

4. Yaoji Deng, A Comprehensive Review on Non-Pneumatic Tyre Research, 227 Materials & Design (2023).
5. Reports of Patent, Design and Trade Mark Cases, Volume 1, Issue 4, 11 April 1884, Pages 29–41.

3. WEB SOURCES:

1. <https://casemine.com/>
2. <https://indiankanoon.org>
3. <https://legalserviceindia.com>
4. <https://manupatra.com>
5. <https://scconline.com>
6. <https://tirereview.com>

4. BOOKS REFERRED:

TITLE AND PUBLISHER	AUTHOR
Patent Law, 2017 Eastern Law House (4 th Edn.)	P. Narayanan
Patent Law & Practice, 2022 Bharat Law House (1 st Edn.)	Rajiv Kumar Choudhary

STATEMENT OF JURISDICTION

The counsels for the Plaintiff most respectfully showeth:

The Plaintiff has approached this Hon'ble High Court under Section 48 read with Section 104 of the Patents Act, 1970 read with Section 20 of CPC read with Rules 4 and 7 of the Delhi High Court Intellectual Property Rights Division Rules, 2021 for a patent infringement suit.

It is humbly submitted that this Hon'ble Court has jurisdiction to entertain the suit.

All of which is respectfully submitted.

Sd/-

Date: ___ January 2023

Counsels for the **Plaintiff**

Place: Hiled

STATEMENT OF FACTS

The Defendant, Broeshim (India) Private Limited, is a subsidiary of Broeshim BV- a Netherlands-based company, which was incorporated in 1998. The Plaintiff is a civil engineer, with around 200 patents to her name. In March 2021, the Plaintiff filed a patent in India for the technology titled “Sensor Embedded Airless Wheel Structure Technology”. The patent claims a tyre with an embedded sensor to collect data and a novel puncture proof mechanism that optimizes rolling resistance, speed, control and noise. The patent was filed in an expedited mode and was granted on 3rd January 2023- (Patent No: 23x481)

The Defendant has introduced various path breaking products in the Indian tire industry which has become synonymous with the tire industry. Since 2017, the Defendant is selling a tire with a sensor to collect data and a puncture proof tire material worldwide and has been selling the tire in India since 2021.

In January 2023, the Plaintiff instituted infringement proceedings against the Defendant before the Hon’ble High Court of Hiled alleging infringement of her patent rights subsisting in Patent No: 23x481. The Defendant, in turn, filed a counter-claim seeking revocation of the Plaintiff’s patent. Revocation of the Plaintiff’s patent is sought under Sections 64(1)(a),(d),(e) and (f) of the Patents Act, 1970. The Defendant claims that the Plaintiff’s invention, apart from being what is already patented, is also already in public use. The Defendant further submitted that the Plaintiff’s patent is a mere rearrangement of known integers and is therefore hit by Section 3(f) of the Act. Revocation is also sought on the ground that the Plaintiff’s patent insufficiently discloses the working of the entire invention. Further, the Defendant submits that the Plaintiff is a patent troll who does not commercialise any of her inventions. The Defendant contends that the grant of the Plaintiff’s patent is in violation of Section 83 of the Act.

STATEMENT OF ISSUES

- 1) WHETHER THE HILED HIGH COURT IS THE APPROPRIATE COURT BEFORE WHICH THE SUIT LIES?**
- 2) WHETHER THE COUNTER-CLAIM FILED BY THE DEFENDANT SEEKING REVOCATION OF THE SUIT PATENT IS TENABLE?**
- 3) WHETHER THE DEFENDANT'S PRODUCT INFRINGES THE SUIT PATENT?**

SUMMARY OF PLEADINGS

1) WHETHER THE FILED HIGH COURT IS THE APPROPRIATE COURT BEFORE WHICH THE SUIT LIES?

It is respectfully submitted that the suit filed by the Plaintiff is maintainable before this Hon'ble Court as the cause of action arose within the jurisdiction of this Court. Further, since the Plaintiff resides within the jurisdiction of this Court and since there exists a legitimate threat that extends to the place where the Plaintiff resides, the suit is maintainable.

2) WHETHER THE COUNTER-CLAIM FILED BY THE DEFENDANT SEEKING REVOCATION OF THE SUIT PATENT IS TENABLE?

It is respectfully submitted that the Suit Patent ought not to be revoked as it is neither anticipated by prior art nor obvious to a relevant person skilled in the art which creates a presumption in favour of the validity of the Suit Patent. It is further submitted that the Suit Patent is useful and capable of industrial application. The Suit Patent also sufficiently discloses the invention and the Patentee is the true and first inventor of the invention.

3) WHETHER THE DEFENDANT'S PRODUCT INFRINGES THE SUIT PATENT?

It is respectfully submitted that the Plaintiff has been granted a valid patent that has to be liberally constructed. The Plaintiff has sufficiently established a prima facie case of infringement against the Defendant as the infringing products and the Suit Patent both contemplate similar objects. Further, since a prima facie case has been established, the burden of proof shifts onto the Defendant to establish that there is no infringement by providing information on the infringing product and the process behind it.

ARGUMENTS ADVANCED

1) Whether the Hiled High Court is the Appropriate Court before which the Suit lies?

1. It is respectfully submitted that the suit filed by the Plaintiff is maintainable before this Hon'ble Court as the cause of action arose within its jurisdiction as provided for under Section 20 of the CPC¹. In addition, the Plaintiff resides within the jurisdiction of this Hon'ble Court.
2. It is respectfully submitted that the cause of action in cases of patent infringement arises where the act of infringement occurs.² The Hon'ble Delhi High Court in *Hindustan Lever Ltd. v. Lalit Wadhwa*³ dealt with a similar issue where it held that when the infringing product is sold nationwide, the plaintiff is vested with the right to institute action in any court. Since the Defendant's products that infringe the Plaintiff's patent (Patent No. 23x481, hereinafter the 'Suit Patent') are sold nationwide, including within the jurisdiction of this Hon'ble Court, sufficient cause of action exists to make the suit maintainable under Section 20(c) of the CPC.
3. In arguendo, even if the Defendant's products are not sold within the jurisdiction of this Hon'ble Court, there exists a persistent threat of the Defendant infringing the Suit Patent or seeking its revocation, as done in the instant case. Since the Plaintiff resides within the jurisdiction of this Hon'ble Court, and since the threat of the Defendant's actions has been extended to the place of the Plaintiff's residence, the Plaintiff as the *Dominus Litis* is entitled to choose the forum best suited to her. This follows the rationale laid down by the

¹ Code of Civil Procedure, 1908, §20, No.5, Acts of Parliament, 1908 (India).

² *Symed Labs Ltd. V. Glenmark Pharmaceuticals Ltd.*, 2015 SCC OnLine Del 6745.

³ 2007 PTC 35 377.

Hon'ble Delhi High Court in *Dashmesh Mechanical Works v. Hari Singh*, making the suit maintainable.⁴

2) Whether the Counter-Claim filed by the Defendant seeking revocation of the Suit Patent is tenable?

4. It is respectfully submitted that, contrary to the averments of the Defendants, the Suit Patent ought not to be revoked as it is neither anticipated by prior art **(2.1)** nor obvious to a relevant person skilled in the art **(2.2)** which creates a presumption in favour of the validity of the Suit Patent. **(2.3)** It is further submitted that the Suit Patent is useful and capable of industrial application. **(2.4)** The Suit Patent sufficiently discloses the invention **(2.5)** and the Patentee is the true and first inventor of the invention. **(2.6)**

2.1.The Suit Patent is Not Anticipated By Prior Art

5. It is submitted, as provided under Sections 2(1)(j) and 2(1)(l) of the Patents Act, 1970, (hereinafter the 'Act') that a perusal of the state of the art **(2.1.1)**, as it stands on the priority date of the Suit Patent, establishes that the Suit Patent does not form a part of the state of the art. **(2.1.2)** It is further submitted that disclosures made in prior publications are not enabling so as to anticipate the Suit Patent. **(2.1.3)** *In Arguendo*, it is submitted that the lack of novelty in the Suit Patent cannot be demonstrated with reference to a single document. **(2.1.4)**

2.1.1 History of Non-Pneumatic Tires

6. It is uncontested that non-pneumatic tires have been present in the industry ever since 1982.⁵ However, non-pneumatic tyres were developed primarily for heavy-load commercial vehicles, the military or space rovers. Subsequently, the need to develop non-

⁴ 2009 SCC OnLine Del 4384.

⁵ US Patent (1982) Non-pneumatic structurally resilient integrated wheel-tire. United States Patent 4,350,196, Sep 21, 1982.

pneumatic tires for passenger vehicles was felt in order to overcome the shortfalls of traditional pneumatic tires.⁶ Structural characteristics of traditional pneumatic tires exhibit potential safety hazards, including punctures or tire bursts, resulting in loss of mobility and life.⁷ Relevant studies further indicate that approximately 70% of highway traffic accidents are caused due to air tire leakages.⁸

7. Therefore, to provide and develop the only viable alternative to pneumatic tires, leading tire manufacturers have been developing prototypes of non-pneumatic tires in order to determine their commercial viability for passengers in real-world conditions. However, during testing, these tires have proven to exhibit certain limitations and disadvantages. For instance, Goodyear's senior program manager for non-pneumatic tires highlighted that these tires increase noise and vibration.⁹ Owing to a larger area of contact with the road, airless tires also increase drag. Consequently, airless tires require a higher rolling resistance given the rise of Electric Vehicles since the battery life and range of these vehicles will be affected due to the increased drag.¹⁰ There has also been a strong felt need to develop sensor embedded airless tires that are capable of mapping road conditions.¹¹

2.1.2 Suit Patent Does Not Form A Part of the State Of The Art

8. State of the art comprises of everything available in patent and non-patent literature found anywhere in the world.¹² An invention is novel if it does not form a part of the state of the

⁶ Michelin - MICHELIN's airless tire, tested and approved!, Michelin (Sept. 24, 2021), <https://www.michelin.com/en/news/michelins-airless-tire-tested-and-approved/>.

⁷ Tire Review Staff, 75% of Indian Drivers on Improperly Inflated Tires, Tire Review Magazine (Jan. 28, 2010), <https://www.tirereview.com/75-of-indian-drivers-on-improperly-inflated-tires/>.

⁸ Yaoji Deng, A Comprehensive Review on Non-Pneumatic Tyre Research, 227 Materials & Design (2023).

⁹ 'Puncture-proof' airless tyres: Soon a reality, International Finance (Sept. 27, 2022), <https://internationalfinance.com/puncture-proof-airless-tyres-soon-reality/>.

¹⁰Goodyear's Airless Tire Solution, <https://corporate.goodyear.com/us/en/responsibility/blog/advanced-mobility-beyond-tires-journey/airless-tire-solution.html/> ; <https://michelinmedia.com/michelin-uptis/>

¹¹ Supra Note 10.

¹² Article 54, Convention on the Grant of European Patents, October 5, 1973, 13 INT'L LEGAL MATS. 268 (1974).

art.¹³ The Hon'ble Supreme Court in *Biswanath Prasad Radhye Shyam v. Hindustan Metal Industries*¹⁴ has held that a patent may be granted only for an invention which is new or novel. The first ingredient for an invention, whether a product or a process, is novelty.¹⁵ Novelty of the patent is the real test of the invention.¹⁶

9. It is respectfully submitted that the Suit Patent does not form of the state of the art for three reasons. Firstly, the state of the art in relation to puncture-proof tyres (pneumatic and non-pneumatic) do not disclose novel features present in the Suit Patent. Pneumatic tires are inherently susceptible to tire bursts and punctures. Therefore, any prior art in relation to pneumatic tires would be inapplicable to the Suit Patent inasmuch as the Suit Patent is for a '*Sensor Embedded Airless Wheel Structure Technology*'.¹⁷ Secondly, insofar as sensor embedded pneumatic tires are concerned, these are not puncture proof. At best, such tires attempt to limit the consequences of a puncture but do not prevent punctures per se.¹⁸ Third, the Suit Patent addresses relevant problems present in the state of the art in relation to non-pneumatic tires. The Suit Patent involves a novel process and technology which uses a sensor embedded to chip to collect data, while using a polyurethane (airless) tire material. It is submitted that the said sensor chip analyses road conditions on a real-time basis, thereby optimizing rolling resistance, speed control and noise by adapting to road conditions.¹⁹ Accordingly, it is submitted that the Suit Patent is novel and does not form a part of the state of the art.

¹³ Poysha Industries Ltd v. Deputy Controller of Patents and Designs, AIR 1975 Cal 178.

¹⁴ (1979) 2 SCC 511, at Para 21.

¹⁵ M.C. Jayasingh v. Mishra Dhatu Nigam Limited, 2014 SCC OnLine Mad 163 at Para 104.

¹⁶ Lallubhai Chakubhai Jariwalla v. Chimanlal Chunilal & Co., 1935 SCC OnLine Bom 20.

¹⁷ Moot Proposition, Para 4.

¹⁸ Cyber™ Tyre, Pirelli <https://www.pirelli.com/tyres/en-ww/car/tech-and-knowledge/cyber-tyre/> ; Also at <https://www.tiretechnologyinternational.com/news/new-tires-news/embedded-sensor-adds-connectivity-to-michelin-formula-e-tires.html>; <https://www.continental-tires.com/us/en/b2b/truck/Solutions/digital-tire-monitoring/intelligent-tire.html>.

¹⁹ Moot Proposition, Para 4.

10. The Hon'ble Apex Court in *Monasato Company v. Coramandal Indag Products (P) Ltd*²⁰ held:

“To satisfy the requirement of being publicly known as used in clauses (e) and (f) of Section 64(1), it is not necessary that it should be widely used to the knowledge of the consuming public. It is sufficient if it is known to the persons who are engaged in the pursuit of knowledge of the patented product or process either as men of science or men of commerce or consumers.”

11. It is respectfully submitted that the said invention does not satisfy the requirement of being publicly known within the meaning of clauses (e) and (f) and Section 64(1). The patented process and technology which address problems present in the state of the art in a novel manner is not known to those who are skilled in the relevant art or to consumers. It is accordingly submitted that the patent ought not to be revoked on these grounds.

2.1.3 Disclosures Made in Prior Publications are not Enabling

12. For an invention to be anticipated, a prior inventor's publication must contain a clear description of, or clear instructions to do or make something that would infringe the patentee's claim.²¹ To anticipate the patentee's claim, the prior publication must contain clear and unmistakable directions to do what the patentee claims to have invented.²² In other words, the prior art is said to be enabling if it is available to the public and a person skilled in the relevant art is able to reproduce the invention without undue burden.²³ It is submitted that prior publications in relation to non-pneumatic tires do not, in any manner, anticipate the invention disclosed by the Suit Patent as prior disclosures do not address

²⁰ 1986 AIR SC 712, Para 6.

²¹ *General Tire & Rubber Company v Firestone Tyre & Rubber Company Limited*, [1972] RPC 457, 485.

²² *Ibid*.

²³ *Beloit Technologies Inc v Valmet Paper Machinery Inc.*, [1995] RPC 705, 739; *Asian Electronics v. Havells India Pvt Ltd.*, MANU/DE/1343/2010 at Para 21.

problems present in the state of the art in the manner that the Suit Patent does. Therefore, it is submitted that disclosures in prior publications are not enabling.

2.1.4 In Arguendo, Lack of Novelty Cannot be Demonstrated With Reference to a Single Publication

13. Mosaicking of multiple prior publications to demonstrate lack of novelty is impermissible.²⁴ It is reiterated that the Suit Patent is not anticipated as there is no single prior publication that discloses the invention made by the Suit Patent whilst tackling multiple problems present in the state of the art simultaneously.

2.2 The Suit Patent Involves an Inventive Step and is Non-Obvious

14. A division bench of the Hon'ble Delhi High Court in *F. Hoffmann-La Roche Ltd. v. Cipla Ltd.*,²⁵ had laid down the test to determine inventive step and lack of obviousness as follows:

“Step No. 1 To identify an ordinary person skilled in the art.

Step No. 2 To identify the inventive concept embodied in the patent.

Step No. 3 To impute to a normal skilled but unimaginative ordinary person skilled in the art what was common general knowledge in the art at the priority date.

Step No. 4 To identify the differences, if any, between the matter cited and the alleged invention and ascertain whether the differences are an ordinary application of law or involve various different steps requiring multiple, theoretical and practical applications

²⁴ J. Mitra and Co. Pvt. Ltd v. Kesar Medicaments, 2008 SCC OnLine Del 255 at Para 102; S.A Glaverbel v. Dave Rose, 2010 Del SCCOnline Del 308.

²⁵ 2016 (65) PTC 1

Step No. 5 To decide whether those differences, viewed in the knowledge of the alleged invention, constituted steps which would have obvious to the ordinary person skilled in the art and rule out a hindside approach.”

Recently, in *Avery Dennison Corporation v. Controller of Patents and Designs*²⁶ the Hon’ble Delhi High Court highlighted various approaches that Courts take to determine inventive step and lack of obviousness including the could-would approach, obvious to try approach, problem/solution approach (as laid down in *Roche*²⁷), and the Teaching Suggestion Motivation Test.²⁸

2.2.1 Suit Patent Addresses Relevant Problems Present in the State of The Art

15. It is submitted that the invention of the Suit Patent is a patentable combination of sensor embedded tires with a non-pneumatic tire material that optimizes rolling resistance, speed, control and reduces noise.²⁹ For an invention to satisfy the test of inventive step, it must constitute a technical advancement over what is already known in the state of the art. In the instance case, it submitted that what would be obvious to a person skilled in the relevant art are the problems present in state of the art, as discussed above.³⁰

16. In accordance with the widely accepted test to determine inventive step as laid down by the Hon’ble Delhi High Court,³¹ the following is submitted:

- A relevant person skilled in the art is one who belongs to the industry in India and has the knowledge of such person should be a cumulative result of various factors i.e. publication, know-how, manufacturing, planning and marketing etc.³² The question that ought to be addressed is ‘Was it for practical purposes obvious to a skilled worker in

²⁶ (2023) 93 PTC 2006.

²⁷ Supra Note 26.

²⁸ Supra Note 27, Para 11.

²⁹ Moot Proposition, Para 4

³⁰ Supra Note 21.

³¹ Supra Note 26.

³² *Enercon (India) Limited v. Alloys Wobben Argestrasse*, 2013 SCC OnLine IPAB 128, at Para 57.

the field concerned, in the state of knowledge at the date of the patent to be found in the literature then available to him, that he would or should make the invention the subject of the claim concerned?’³³

- It is submitted that the Suit Patent is not obvious to a person skilled in the art. Even if one were to mosaic all prior art documents to test the obviousness of the Suit Patent, it would be non-obvious. Prior art documents reveal the problems inherent in developing non-pneumatic tires for real world conditions. The Suit Patent addresses these problems through its patented combination thereby establishing that it is non-obvious to a person skilled in the relevant art.
- Lack of inventive step requires a person skilled in the art to ‘jump’ from the prior art to the patented invention.³⁴ A hindsight reconstruction of the patent in question as a guide through the maze of the prior art references in the right way so as to achieve the result of the claim in the suit, is required to be avoided.³⁵ It is submitted that the differences between the prior art and the invention in the Suit Patent lie in the solution provided for problems in the prior art by the patented combination in the invention. It is therefore humbly submitted that such a ‘jump’ would be impossible thereby making the patented invention non-obvious.
- If the subject invention addresses various disadvantages present in the prior art, it is a secondary consideration which tilts the Court to hold that the invention is not a result of a mere combination but involves an inventive step.³⁶ Since the Suit Patent does

³³ Supra Note 32.

³⁴ *Biomoneta Research (P) Ltd. v. Controller General of Patents Designs*, 2023 SCC OnLine Del 1482, at Para 69.

³⁵ *Bristol-Myers Squibb Holdings Ireland Unlimited Company v. BDR Pharmaceuticals International Pvt. Ltd.*, 2020 SCC OnLine Del 1700.

³⁶ *Ibid.*

indeed address various disadvantages present in the prior art, the subject invention involves an inventive step and ought not be revoked under Section 64(1)(f).

2.2.2 Suit Patent is a Patentable Combination Which is Not Hit By Section 3(f)

17. A patentable combination is one in which the component elements are so combined as to produce a new result or arrive at an old result in a better or more expeditious or more economical manner.³⁷ If the invention is not a mere rearrangement of known integers functioning in a known manner but a change in the manner in which the Suit Patent functions over existing prior art leading to greater efficiency without compromising quality, objections under Section 3(f) are not tenable.³⁸ In other words, it must not be a mere workshop improvement but rather involve the exercise of intellectual ingenuity.³⁹ It is submitted that the patentable combination, combines known integers i.e., the sensor chip and the non-pneumatic tyre material, in order to make such tires user-friendly, safe, commercially viable and do away with current limitations present in the use of non-pneumatic tires. When known integers are placed together and have some working interrelation producing a new or improved result then there is a patentable subject matter in the idea of the working interrelation brought out by a collection of integers.⁴⁰ It is accordingly submitted that the Suit Patent does not violate Section 3(f). A finding that an invention lacks inventive step seriously compromises the integrity of the inventor.⁴¹ Therefore, the Suit Patent sought ought not to be revoked under Section 64(1)(d) of the Act.

³⁷ Ajay Industrial Corporation v. Shiro Kanao Ibraki City, AIR 1983 Delhi 496.

³⁸ Communication Components Antenna Inc. v. ACE Technologies Corp., 2019 SCC OnLine Del 9123, at Para 67.

³⁹ Supra Note 15.

⁴⁰ K. Manivannan v. Chairman Intellectual Property Appellate Board, 2017 SCC OnLine Mad 37800, at Paras 33-34.

⁴¹ ART Screw Co., Ltd. v. Controller of Patents & Designs, 2022 SCC OnLine Del 4429.

2.3 There Is A Presumption of Validity In Favour of the Suit Patent

18. There exists a presumption of validity in favour of the Suit Patent once it has been granted and the Plaintiff thus discharges its initial responsibility of establishing the strength of its case.⁴² Merely because a registration is recent, it by itself is no ground that an injunction ought not to be granted.⁴³ Despite the Suit Patent being filed in an expedited mode, the patent was granted only after nearly two years on 3rd January 2023.⁴⁴ It is submitted that having gone through a rigorous procedure seeking grant of the Suit Patent, there is a presumption in favour of its validity. Courts have held that the rigorous application of the six year rule ought to be cautioned against.⁴⁵ Furthermore, the rule under Section 13(4) prevents drawing any inference as to the validity of the patent only to the extent of preventing any suit lying against the Central Government. It is therefore submitted that once novelty and inventiveness of the patent have been established, there is nothing from preventing courts from presuming the validity of the Suit Patent while determining an infringement action. In any event, such presumption merely flows from the scheme of the Patents Act and cannot be dissuaded solely by relying on Section 13(4) once novelty and inventive step have been established.

2.4. The Suit Patent is capable of Industrial Application

19. It is submitted that the Suit Patent is capable of industrial application as necessitated by Section 2(1)(ac). The phrase capable of industrial application must carry with it a meaning of trade or manufacture in the broadest sense.⁴⁶ Under the erstwhile Patent Law in India, with utility being the main requirement of patentability, Courts have described industrial

⁴² K. Ramu v. Adyar Ananda Bhavan .

⁴³ Metro Plastic Industries (Regd.) v. Galaxy Footwear New Delhi, AIR 2000 Del 117.

⁴⁴ Moot Proposition, Paras 4-5.

⁴⁵ Supra Note 26.

⁴⁶ Chiron Corp v. Murex Diagnostics, [1995] EWCA Civ J1102-9.

application in terms of an invention that better the industry's preceding knowledge about a particular invention.⁴⁷ But it was in *F. Hoffmann-La Roche*⁴⁸ that the court gave a comprehensive understanding of the term, stating that rerequirement necessitates an invention to have commercial use, and even though the invention for which an application is made is not in its final form, the patent can only be granted in cases where there is some commercial viability to the patent. Thus, this requirement's focus is not on the product itself but on its potential. That is, it has to be commercially viable.

20. The capability of industrial application of the Suit Patent cannot be challenged because of the lack of commercialisation of the '*Sensor Embedded Airless Technology*' in the market at this stage. The promise of usage of the invention commercially in the future is sufficient and merely based on its lack of commercial use at this juncture, it cannot be said that the Suit Patent is not fit for industrial application or is not commercially viable.⁴⁹

21. Further, in *Boehringer Ingelheim Pharma vs. MSN Laboratories*,⁵⁰ the Himachal Pradesh High Court opined that in case of a breakthrough research, even if the subject matter of a patent is at a conceptualization stage and may not be commercially viable at that stage, it is nonetheless useful and industrially applicable.

2.4.1 Section 83 does not affect the validity of the Suit Patent.

22. Section 83 provides only 'Guiding Principles', and all the relevant factors will have to be taken into consideration when deciding 'whether a patent has been worked'. Therefore no single factor ought to be considered alone to arrive at the decision on whether a patent has been worked or not. It is pertinent to note that the provision only imposes obligations and

⁴⁷ ROBERT ALFRED YOUNG AND ROBERT NEILSON V. ROSENTHAL AND CO., Reports of Patent, Design and Trade Mark Cases, Volume 1, Issue 4, 11 April 1884, Pages 29–41, <https://doi.org/10.1093/rpc/1.4.29>.

⁴⁸ Supra Note 26.

⁴⁹ MERCK Sharp & Dohme Corporation v. Glenmark Pharmaceuticals Ltd., 2015 SCC OnLine Del 12580

⁵⁰ OMP No. 85 of 2022, In COMS No. 07 of 2022 (Himachal Pradesh High Court).

is subject to the rights provided under Section 48 and the other provisions of the Act, and cannot be treated as cardinal.

23. Section 146 (2) read with Rule 131 of the Patent Rules, 2003, provides for the statement of working and other necessary information with regard to the commercial usage of the patented product that is mandatorily required to be submitted by the patentee to the Controller, as envisaged by Section 83. A bare perusal of the language used in Rule 131(2), would sufficiently enlighten that the Patentee is mandated to submit the statement of working in accordance to Rule 131(1) starting from the financial year commencing immediately after the financial year in which the patent was granted. Since, the period of one financial year has not lapsed from the date of grant of the Suit Patent, there is no default on part of the Plaintiff.

2.5. The Suit Patent sufficiently discloses the invention

24. It is submitted that there is sufficiency of disclosure in Suit Patent in accordance with Section 10(4). An ordinary skilled person must be able to perform the invention to satisfy the requirement of disclosure.⁵¹ Whether the specification is sufficient or not is highly sensitive to the nature of the invention. To determine this question, the first step is to identify the invention and decide what it claimed to enable the skilled man to do. Only then is it possible to ask whether the specification enabled him to do it.⁵²

25. In Anup Engineering Ltd. v. Bharat Heavy Electricals Ltd.,⁵³ with regard to the ground of 'unfair description', the argument was that certain important measurements such as those belonging to the bellows produced by the invention were not produced. The Court held that such information is not essential since the claim is for the apparatus that produces the bellows, and as long as the claim is clear in explaining the invention itself, minor defects

⁵¹ Synthon BV v SmithKline Beecham Plc, [2006] RPC 10.

⁵² Kirin-Amgen Inc v Hoechst Marion Roussel, [2005] RPC 9.

⁵³ 1985 PTC 71.

cannot harm its validity. It is humbly submitted that the Suit Patent had the complete specification of all the relevant information essential for a skilled man in art to replicate and understand the patent product. Omission of specifications such as the connectors between the various parts or any such alleged vagueness claimed by the Defendant would not render the disclosure as insufficient.

2.6. The Patentee is an Inventor

26. It is humbly submitted that the Plaintiff is an inventor, within the meaning given under the Act. The plaintiff is a Civil Engineer, who holds more than 200 patents. Merely on the basis of the Plaintiff having a background in marketing, the genuinity of the Plaintiff as an inventor cannot be challenged or questioned. In arguendo, even if it is assumed that the Plaintiff does not have the required technical know-how, as long as the Plaintiff has had some intellectual contribution in the work that led to the Suit Patent, the validity of the Plaintiff as an inventor cannot be questioned. An individual who provides ideas to produce the invention need not personally carry out the experiments.⁵⁴

27. It is pertinent to note that the “Conception is the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.”⁵⁵ The inventors, therefore, need not “personally construct and test their invention.”⁵⁶

3) Whether The Defendant’s Product Infringes The Suit Patent?

29. It is submitted that the Defendant has infringed the Suit Patent. The Plaintiff was granted the Suit Patent on 03.01.2023 after due process was followed by the Patent Office and there

⁵⁴ National Institute of Virology vs. Mrs. Vandana Bhide, Pre-grant Opposition before the Controller of Patents in the matter of Patent Application 581 /BOM/ 1999.

⁵⁵ Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1376 (Fed. Cir. 1986).

⁵⁶ Tucker v. Naito, 188 USPQ 260, 263 (Bd. Pat. Inter. 1975).

lies a presumption of validity.⁵⁷ The scope of the Suit Patent would inherently be based on the way the claim is constructed. A specification must be construed impartially, and Courts are generally reluctant to construe the claims against the Patentee. Such construction should not just be 'benevolent' but also reasonable.⁵⁸ It is humbly submitted that there is enough evidence to determine that the Defendant has infringed on the Suit Patent, (3.1) and that the burden of proof has shifted onto the Defendant as under Section 104A of the Act. (3.2)

3.1. Sufficient Evidence Exists To Establish Infringement

30. A device infringes if it "*performs substantially the same overall function or work, in substantially the same way, to obtain substantially the same result as the claimed invention*" as per the Graver Tank "function-way-result" test.⁵⁹ A product may conceivably infringe under the doctrine of equivalents, even though it does not literally infringe, if it 'performs substantially the same overall function or work, in substantially the same way, to produce substantially the same overall result as the claimed invention.' The doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole.⁶⁰

31. Another consideration of the doctrine of equivalents is the insubstantial differences test, where a 'substantial equivalent' may be found if a person of ordinary skill in the art would have considered the differences between the claim element and the accused device to be 'insubstantial' at the time of infringement.⁶¹ In *Raj Prakash v. Mangat Ram Chowdhary*,⁶² the Delhi High Court observed that while ordinary meanings should be imputed to words, wherever necessary words should be construed in the sense in which they are used in the relevant trade. The Court, additionally, held that minor variations are inconsequential if the

⁵⁷ *Telefonaktiebolaget LM Ericsson (Publ) v. Mercury Electronics*, 2015 SCC OnLine Del 14638.

⁵⁸ *Supra* Note 17.

⁵⁹ *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320, 1326, 21 U.S.P.Q.2d 1161, 1164 (Fed. Cir. 1991); *Perkin-Elmer Corp. v. Westinghouse Elec.*, 822 F.2d 1528, 3 U.S.P.Q.2d at 1332 (Newman, J., dissenting).

⁶⁰ *Warner-Jenkinson Co Inc v. Hilton Davis Chem Co*, 520 US 17, 29 (1997).

⁶¹ *KCJ Corp v Kinetic Concepts Inc*, 223 F 3d 1351, 1359 (Fed Cir 2000).

⁶² AIR 1978 Del 1 at 9.

infringing goods are made with the same object in view as the patented article. The comparison should, therefore, be based on only the core object of the two articles and not based on every single characteristic.

32. In *Parkinson v. Simon*⁶³, the Court held that the claim must be so construed as to give an effective meaning of each of them, but the specification and the claim must be looked at and construed together. The Suit Patent is a process patent for “Sensor Embedded Airless Wheel Structure Technology” where the process by which an airless wheel is to be manufactured with intricate and specially positioned compartments.

33. It is humbly submitted that the Defendant’s product, appears to prima facie mimic the outcomes of the Suit Patent as both the infringing product and the Suit Patent provide for airless tyres that employ sensors to prevent punctures and enhance performance. In doing so, the Defendant’s products inexplicably infringe upon the Suit Patent as any person of ordinary skill would be able to derive the similarities between the products.

3.2. That the burden of proof has shifted onto the Defendant

34. It is humbly submitted that Section 104A imposes a reverse burden on the Defendant to prove that the process used by them is different from that of the Suit Patent. This is contingent on the Plaintiff proving that the products are similar, which has been clearly established herein. Therefore, the Defendant cannot merely hide behind the defences available under Section 64 of the Act and has to provide sufficient evidence to satisfy its burden failing which an adverse inference against the Defendant that it has infringed based on the prima facie case made out by the Plaintiff would have to be drawn.⁶⁴

⁶³ (1844) 11 RPC 463 (CA).

⁶⁴ Supra Note 38 at Para 66.

PRAYER

Wherefore, in the light of the facts presented, issues raised, arguments advanced, and authorities cited, it is humbly prayed that this Hon'ble Court may be pleased to adjudge and declare that:

1. The suit is maintainable before this Hon'ble Court.
2. The counterclaim filed by the Defendant seeking revocation of the Suit Patent is untenable and dismiss the counterclaim with punitive and legal costs in favour of the Plaintiff.
3. The Suit Patent is valid and certify the same under Section 113 of the Patents Act, 1970.
4. The Defendant's product infringes on the Suit Patent and grant an injunction and punitive damages in favour of the Plaintiff.
5. The Plaintiff is entitled to recover costs from the Defendant.

This Hon'ble Court may pass any such other order as it deems fit and proper in the interest of justice, equity and good conscience.

And for this act of kindness the Plaintiff shall as duty-bound ever humbly pray.

Place: Hiled

All of which is respectfully submitted

Date: 15.04.2023

S/d _____

Counsel(s) for the Plaintiff