
**BEFORE THE HON'BLE
HIGH COURT OF HILED**

COMMERCIAL SUIT NO. 6 OF 2023

**6TH SURANA & SURANA AND SHAASTRA IIT MADRAS, INTELLECTUAL
PROPERTY LAW MOOT COURT COMPETITION, 2023**

SHRADDHA BHAMBANI.....PLAINTIFF

v.

BROESHIM (INDIA) PRIVATE LIMITED.....DEFENDANT

MEMORANDUM ON BEHALF OF THE DEFENDANT

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LIST OF ABBREVIATIONS

SR. NO.	ABBREVIATION	FULL FORM
1.	CPC	Code of civil Procedure
2.	Doc	Document
3.	HC	High Court
4.	Hon'ble	Honorable
5.	Inc	Incorporation
6.	Ltd	Limited
7.	Pvt	Private

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STATEMENT OF JURISDICTION

The Petitioner has filed a Commercial suit before the Hon'ble Court of Hiled in the matter of *Shradda Bhambani v Broeshim (India) Private Limited*, invoking its original jurisdiction under section 104 of The Patents Act, 1970 and Section 20 of the Code of Civil Procedure, 1908. The Rights that are granted for the plaintiff under Section 48 of the Indian Patents Act,19703 have been also infringed by the Defendant. The Defendant further invokes Rule 6 (a) to 6 (g) of Code of Civil Procedure, 1908 for filing a counterclaim for Infringement of Patent under Section 64 of the Patents Act, 1970.

STATEMENT OF ISSUES

- I. WHETHER THE HON'BLE COURT HAS JURISDICTION OVER THE MATTER AT HAND?

- II. WHETHER THE PATENT UNDER THE BEARING NO. 23X4281 IS A VALID PATENT?

- III. WHETHER THE IGNORKUT AGREEMENT DOES NOT VIOLATE THE CONDITIONS OF THE LICENSE AGREEMENT?

- IV. WHETHER THE GROUNDS UNDER SECTION 64(1)(A), (E) AND (F) OF THE PATENTS ACT, 1970 ARE FULFILLED FOR REVOCATION?

STATEMENT OF FACTS

1. Broeshim (India) Private Limited is a subsidiary of Broeshim BV, a company with over 600 patents globally founded in 1998. The company is a pioneering manufacturer of tires in India and is currently the leading supplier of tire and ancillary products in the country. In 2021, Broeshim introduced a puncture-proof tire material with sensors that collect data in India.
2. The Plaintiff, a civil engineer, holds around 200 patents in many fields and filed for the "Sensor Embedded Airless Wheel Structure Technology" in March 2021 and was granted the patent in January 2023 as Patent No: 23x4281. Plaintiff intends to use her invention in India, Germany, and Australia, where her patent is pending.
3. Subsequently, the Plaintiff filed a suit against the defendant in the Hon'ble High Court of Hiled, numbered Commercial Suit No. 6 of 2023, seeking monetary and otherwise reliefs.
4. The Defendants argue that the invention was already patented and in public use before the patent was granted. Therefore, it is revocable under sections 64(1)(a), (e), and (f) of the Patents Act, 1970. They also argue that a mere rearrangement of existing components should not have been granted a patent.
5. The Defendants argue that the Plaintiff lacks technical knowledge and background in commercialization, suggesting that she either does not know how to commercialize the invention or does not want to.
6. The Defendants also raise questions about the insufficient disclosure in the patent, accusing the Plaintiff of being a "Patent Troll" who only seeks to extract money from the Defendants. The case has been brought to the Hon'ble High Court of Hiled for resolution.

SUMMARY OF PLEADINGS

I. THE HON'BLE COURT HAS JURISDICTION OVER THE MATTER AT HAND

The counsel on the behalf of the defendant is filing a counter counterclaim seeking the revocation of the Plaintiff's patent. This counterclaim for revocation of the patent is filed on the basis of the proviso mentioned under section 104 of the Patents Act, 1970. Furthermore the defendant is seeking defense under the suit of infringement under section 107 of the Patents Act, and is pleading for revocation of the patent under section 64(1)(a), 64(1)(d), 64(1)(e), 64(1)(f) of the Patents Act, 1970 which will be contended in further issues.

II. THAT THE PATENT UNDER THE BEARING NO. 23X4281 IS A VALID PATENT

The Counsel on the behalf of the Defendant most humbly submits before this Hon'ble Court that the patent acquired by the Plaintiff fails to qualify as a valid patent because the claimed invention is not novel, is obvious and falls under the ambit of non-patentable inventions. Therefore, if the patent does not hold validity there lies no scope for infringement of the said patent. The authority has erred in granting the patent to the plaintiff. The product which sought a patent was already in the public domain and the technical advancement claimed appeared to be obvious to the skilled person. Hence, the Defendants plead for revocation of the said patent.

III. THAT THE GROUNDS UNDER SECTION 64(1)(A), (E) AND (F) FOR REVOCATION ARE NOT FULFILLED

The counsel on behalf of the defendant humbly submits that plaintiff does not even have a valid patent and even fails to commercialize the product thus failing to balance between the rights of the patent holder and the obligation on the patent holder to keep the commercial scale to the fullest extent for development of society It even fails to sufficiently disclose the complete specifications of the product thus failing the basic essential of the validity and thus the patent must be revoked under section 64(1)(a), 64(1)(d), 64(1)(e), 64(1)(f) of the Patents Act, 1970.

PLEADINGS

CONTENTION I

THAT, THE HON'BLE COURT HAS JURISDICTION OVER THE MATTER AT HAND

The defendant is filing a counter-claim seeking the revocation of the Plaintiff's patent. This action is being taken as per Section 104 of the Patents Act, 1970,¹ which provides for filing a suit for a declaration or relief concerning a patent.

1.1 THE HIGH COURT HAS ORIGINAL JURISDICTION

As per Section 104 of the Patents Act, such suits cannot be instituted in any court inferior to a District Court with jurisdiction to try the case. However, the section also includes a proviso that if a defendant files a counter-claim for revocation of the patent, the suit and the counter-claim will be transferred to the High Court for its decision.

The defendant has argued that once a counter-claim for revocation has been filed, only the High Court has the authority to determine the merits of the plea of revocation. The defendant relies on the Proviso to Section 104 of the Patents Act to support their assertion that once a counter-claim has been filed in a suit for infringement, it must be transferred to the High Court for determination.

1.2 COUNTER-CLAIM AT HIGH COURT

Another contention advanced by the Defendants emerges from Section 64 of the Patents Act. This section deals with the grounds on which a patent can be revoked.

¹ Section 104 of The Patents Act, 1970, 39, 1970 (India).

Section 64(1)² of the Patents Act specifies that a patent can be revoked on any interested person or the Central Government petition by the Appellate Board or on a counter-claim in a suit for infringement of the patent by the High Court. This means that a patent can be revoked through a petition to the Appellate Board or a counter-claim in a suit for infringement in the High Court. The Defendants contend that Section 64(1) of the Patents Act clarifies that a patent can be revoked through a counter-claim in a suit for infringement in the High Court. They argue that this provision indicates that the High Court has the authority to revoke a patent in such cases and that the Proviso to Section 104 of the Patents Act only deals with the transfer of the suit and counter-claim to the High Court for determination, not the jurisdiction of the High Court to hear and decide the case.

1.3 EVERY GROUND UNDER SECTION 64 SHALL BE AVAILABLE AS A DEFENCE

Section 107(1) of the Patents Act provides that in any suit for patent infringement, every ground on which the patent may be revoked under Section 64 shall be available as a defence. This means that a defendant in an infringement suit can raise any ground for revocation available under Section 64. While there is a distinction between raising a defence to an infringement suit and seeking revocation of a patent, the same grounds may apply to both.

The case of *Cadila Pharmaceuticals Ltd. v Instacare Laboratories Pvt. Ltd*³. established that a defendant has the right to defend an infringement action on any ground available for revocation under Section 64 of the Patents Act, even if they have not given notice of opposition or applied for revocation under Section 25 or 64 of the Act. Section 107 expressly empowers a defendant to defend any suit for patent infringement on any ground for revocation available under Section

² Section 64 of The Patents Act, 1970, 39, 1970 (India).

³ *Cadila Pharmaceuticals Ltd. v Instacare Laboratories Pvt. Ltd* 2001 (2) PTC 541 SC

64. Regarding the jurisdiction of the courts, the Proviso to Section 104 of the Patents Act stipulates that when a defendant files a counter-claim for revocation of a patent, the suit and the counter-claim shall be transferred to the High Court for determination.

The case of *Fabcon Corporation vs Industrial Engineering*⁴ states that the proviso to Section 104 of the Patents Act provides that if the defendant files a counter-claim seeking revocation of the patent, the suit and the counter-claim shall be transferred to the High Court for decision. The court held that the mere fact that the patent may be held invalid in an appeal would not constitute a counter-claim seeking revocation of the patent. It was emphasized that the proviso to Section 104 is only triggered when there is an actual counter-claim seeking revocation of the patent, and it is only then that the jurisdiction of the District Court is ousted and the suit is to be transferred to the High Court for decision.

Based on these provisions, the defendants argue that only their counter-claim seeking revocation of the patent would allow the case to be brought to the High Court, and the plaintiffs have not exhausted the jurisdiction of the District Court.

⁴ *Fabcon Corporation vs Industrial Engineering* AIR 1987 All 338

CONTENTION II

THAT THE PATENT ACQUIRED BY PLAINTIFF IS NOT A VALID PATENT

It is most humbly submitted before the Hon'ble Court that the patent acquired by plaintiff under the bearing no. 23x4281 absolutely does not stand as a valid patent under the scheme of law. The Patents Act of 1970 (hereinafter referred as 'Act') certainly provides that a patent is the one which is granted to an invention⁵. The Counsel on the behalf of Defendants herby have elaborated on the aforementioned contention under Four limbs, namely- (i) Not an invention (ii) lack of non-obviousness (iii) It is a non-patentable invention. The Patent granted to the plaintiff fails to qualify as an invention on the following grounds:

2.1 IT IS NOT AN INVENTION

In order to qualify as valid patent, the foremost criterion is to fulfil the definition of invention embodied under Section 2(1)(j) of the Act, the claimed product should be new product or process involving an inventive step and capable of industrial application⁶. Thus, on bare perusal of scope of what constitutes an invention, it is distinctly established that a product or process which claims patent shall be new product or at least shall inculcate some inventive step differentiating the already existing product. It is however, not required that the product to be completely new. Even if the product is substantially improved by an inventive step, it would be termed as an invention⁷. The Hon'ble Apex Court while deciding on the significance of novelty, in *Biswanath Prasad Radhey Shyam v. Hindustan Metal industries*⁸ observed that-

⁵ Section 2 (1)(m) of The Patents Act, 1970, 39, 1970 (India).

⁶ Section 2(1)(j) of The Patents Act, 1970, 39, 1970 (India).

⁷ *Dhanpat Seth v. Nil Kamal Plastic Crates Ltd*, 2008 (36) PTC 123 (HP) (DB) at p. 127.

⁸ *Biswanath Prasad Radhey Shyam v. Hindustan Metal industries* AIR 1982 SC 1444

‘The fundamental principle of Patent Law is that a patent is granted only for an invention which must be new and useful. That is to say, it must have novelty and utility. It is essential for the validity of a patent that it must be the inventor's own discovery as opposed to mere verification of what was already known before the date of the patent’.

‘Whether an alleged invention involves novelty and an inventive step’ is a mixed question of law and fact, depending largely on the circumstances of the case. Although no absolute test uniformly applicable in all circumstances can be devised, certain broad criteria can be indicated, whether the manner of manufacture” patented. was publicly known, used and practised in the country before or at all the date of the patent? if the answer to this question is Yes’, it will negative novelty or subject matter’.

In addition to this, it was also observed that the novelty in desired product is one among the fundamental essentials for valid patent however, there is no uniformly accepted test to prove the novelty rather shall be determined from case-to-case basis. Moreover, the term invention was again interpreted in *Raj Parkash v. Mangat Ram Chowdhary*⁹, wherein the Court held that-

‘Invention is to find out or discover something not found or discovered by any one before and it is not necessary that the invention should be anything complicated and the essential thing is that the inventor was the first one to adopt it and the principle therefore is that every simple invention that is claimed, so long as it is something novel or new, would be an invention’.

It is thus submitted that in order to tag a certain product as novel it should not be known or publicly known at the date of applying for patent. However, in the instant case the plaintiff

⁹ Raj Parkash v. Mangat Ram Chowdhary AIR 1978 Delhi 1

applied for alleged invention in March 2021 but the product for which she claimed patent had already made its presence in the market since January of 2021, hence it established that the product was publicly known on the priority date. The alleged invention was not a novel product since its application and thus is not a valid invention.

It is further contended that the alleged invention of plaintiff also fails to fall under the definition of *new invention* which has been enshrined under Section 2(1)(l) of the Act, a product or process shall be recognised as *new invention* only if the invention has not been used in the country or elsewhere in the world and was not anticipated through publication, moreover, if the product with specification is not in the public domain¹⁰. It is submitted that the term new invention has not been explicitly used in the Act, however, the Supreme Court in *F. Hoffmann-La Roche Ltd v. Cipla*¹¹ had stated that-‘*On reading Section 2(1)(j) in conjunction with Section 2(1)(l) it gives a flavour of the intention of the Legislature and also clarifies as to what is considered to be not new in the terms of the Act. Further, the provision lays down that the invention or technology must not have been previously made or used in India*’.

It is contended that one of the ways to determine the presence of product in the market is through its presence in the public domain. The definition also lays down that even if the claimed product is used in country or anywhere in world shall not be invention. In the instant case, the Defendants are leading manufacturers of tyres and have consistently developed newer technologies into tyres. The defendants had already brought this technology prior to plaintiff filing for the one, and also the Defendants parent company had developed the technology back then in 2017. As there was global presence of the same technology, hence it

¹⁰ Section 2(1)(l) of The Patents Act, 1970, 39, 1970 (India).

¹¹ *F. Hoffmann-La Roche Ltd. v. Cipla Ltd.*, 2015 SCC OnLine Del 13619

is not a valid invention. It has been established that, if a claimed invention is replica of a product existing in the market than it shall be a clear ground for showcasing the invalidity of patent, therefore it is pertinent to understand the term public domain. The Courts have from time and again interpreted the term public known or public domain. The Court in one of the oldest landmark judgments, *Lallubhai Chakubhai Jariwalla v. Chimanlal Chunilal & Co.*¹², while interpreting a prior user or public use had observed that-

'If the invention is being put into practice before and at the date of the grant, the grant will not be for a new invention or manufacture, and this applies equally whether the invention is being practised by the patentee himself or by others. A use of the invention for the purposes of trade may constitute a prior user which invalidates the patent, and the prior public sale of goods or articles treated according to the invention is a public user of the invention, for the sale is strong evidence that the user was really commercial and not experimental'

It is further submitted that if the invention is so presented that no subsequent person from public can claim it as his own invention, however, if anyone does so shall be presumed to be in prior use¹³. The Hon'ble court in the landmark case of *Cadila Pharmaceuticals Ltd. v. Instacare Laboratories Pvt. Ltd.*¹⁴, observed that- *the process which the appellant claims to have developed after years of research and development is really in use for decades. The appellant, therefore, prima facie, cannot be said to have evolved a new process hitherto unknown to the pharmaceutical world and if prima facie, the process evolved by the appellant is not found to be patentable, the defendants cannot be restrained from using the said process for its products and for marketing them.*

¹² Lallubhai Chakubhai Jariwalla v. Chimanlal Chunilal & Co AIR 1936 Bom 99

¹³ Canadian General Electric Co. Ltd. v. Fada Radio, Ltd., 1929 SCC OnLine PC 75

¹⁴ Cadila Pharmaceuticals Ltd. v/s Instacare Laboratories Pvt. Ltd. 2001 (21) PTC 472 (Guj)

The Counsel on the behalf of Defendant humbly submits before the Hon'ble court that the alleged invention is not an appropriate invention to be patented and as the patent has been already awarded to the plaintiff, thus pleads for revocation of such patent. The Hon'ble Supreme Court in *Monsanto Company v. Coromandal Indag Products (p) Ltd*¹⁵, pertaining to the question on publicly known and use has observed that-

'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 consumer 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.'

The Defendants further submit that the claimed invention is not new and fails to clear the criterion on novelty, furthermore, the sensor embedded technology is not new to the market. The Product was sold by the Defendants even prior to plaintiff applying for patent and thus cultivate something called as prior use. It is also submitted that the parent company of Defendants have been in the business of tyre since decades and are known as leading manufactures worldwide. The parent company have significantly evolved and have turned the market by developing new technologies in association with tyres in the market. The alleged invention is concerning a technology which was introduced worldwide in 2017 that constitutes 4 years prior to plaintiff filling for the technology. Moreover, concerning the publicly known aspect of the technology, the Defendants are leading manufacturers and brand in tyre in the country. They have well established network of trade and market chain, thus as soon as the technology was launched in India it was available in the market and every other known person in the filed was well-versed with the presence of such an technology in

¹⁵ Monsanto Co. v. Coramandal Indag Products (P) Ltd., (1986) 1 SCC 642

the market. Therefore, the alleged invention was part of public knowledge on date of applying for patent by plaintiff, and hence, qualifies to be revoked under Section 64(1)(e) of the Act.¹⁶

2.2 LACK OF NON-OBVIOUSNESS

The fundamental requirement for a product or process to qualify as an invention demands some sense of inventive step in its development. The patentee is thus obligated to prove that the claimed invention is not something publicly known rather involves inventive step. An inventive step has been defined under the Act as a feature of an invention that involves technical advances as compared to existing knowledge and the invention is not obvious to person skilled in the art. Thus, it is humbly submitted that every invention should showcase involvement of inventive step which necessitates non-obviousness, and if the person skilled in the field concludes that the invention was obvious then such invention shall dilute in its inventiveness. The term obviousness has not been defined anywhere in the Act, but forming a part of inventive step it entails that if an invention is not obvious such shall not be patentable. The Hon'ble Court while addressing the issue pertaining to obviousness in the case of *Press Metal Corporation Ltd v. Noshir Shorabji*,¹⁷ observed that -

'In considering whether the claim as made by the inventor is an invention, it will have to be considered whether the subject matter is not obvious. Obviousness is to be judged by the standard of a man skilled in the art concerned'.

'If the invention was obvious, there could be no inventive step whatsoever'.

¹⁶ Section 64 (1)(e) of The Patents Act, 1970, 39, 1970 (India).

¹⁷ *Press Metal Corporation Ltd v. Noshir Shorabji* AIR 1983 Bom 144

It is further submitted that, as an inventive step is essential ingredient of an invention and the claimed invention involving technical advancement should not be obvious to a person skilled in the field. In *Mariappan v. A.R.Safiullah*¹⁸ the Court observed that- '*A patent must have characters of novelty, non-obviousness and enablement, out of which, enablement being the concept of putting the novelty into action and all the above said ingredients must consecutively be present to have a valid patent*'. In order to determine whether an invention is obvious or not, should be attained from the position of a skilled person in the field, hence involves objective determination. A test to adjudge whether an invention is obvious or not was addressed through a test of obviousness was laid in a famous case *Windsurfing v. Tabur*¹⁹-

In answering the question of obvious there are four steps to be considered. The first is to identify the inventive step embodied in the patent in suit. Thereafter the court has to assume the mantle of a normally skilled but unimaginative addressee in the art at the priority date and to impute to him what was, at that date, common general knowledge in the art in question. The third step is to identify what, if any, differences exist between the matter cited as being 'known or used and the alleged invention Finally the court has to ask itself whether viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention.

It is further submitted that the Hon'ble Court in *Farbwerke Hoechst & B. Corporation v. Unichem laboratories*²⁰ laid that for the purpose of person skilled in the art, the state of knowledge on existing date is to be found in the literature available to him, that he would or

¹⁸*Mariappan v. A.R.Safiullah* 2008 (38) PTC 341 (Mad).

¹⁹ *Windsurfing v. Tabur* [1985] RPC 59 at 73(CA)

²⁰ *Farbwerke Hoechst & B. Corporation v. Unichem laboratories* AIR 1969 Bom 255

should make the invention the subject of the claim concerned . It is therefore essential that the skilled person in the field having requisite knowledge, if able to reproduce the same invention it shall be obvious. The intention for having such criterion is to encourage and protect the invention which is truly out of the box achievement. As the question revolves around the knowledge possessed by skilled person, in *K. Manivannan v. M. Mani*²¹ it was observed that- *‘Knowledge available in a country for a long time, which every skilled worker in that field is, expected to know would be sufficient to invalidate a patent ’*

In the instant case, plaintiff have acquired patent which does not qualify for non-obviousness. The Defendants contend that the authority have erred in evaluating the claimed invention on the scale of obviousness. The claimed technology which is merely an extension to the evolved technology concerning the tyre industry. The Product identical to the patented product was available in public domain and right from the date of application for the said patent the product had already made its presence in the global market. Hence, even if the plaintiff claims the said invention to be an improved form of the existing product, the product still has to pass through the test of obviousness. As the obviousness is determined from the standpoint of ordinary skilled personnel working in the tyre industry. As the product was in market since long time thus every skilled personnel in the tyre was having knowledge of the product.

It is further contended that every skilled personnel was aware of the deficiencies involved in the product that is pertaining to the unwanted noise and no resistance on the speed. Therefore, every other technical expert in the tyre industry was anticipating the said improvements which could be brought to the technology. The mere optimization of rolling speed, noise and control does not make it an out of the box advancement instead every technically skilled

²¹ K. Manivannan v. M. Mani 2009 (41) PTC 561 (IPAB)

person in the tyre industry or a person who dwells in tyre would be endeavours to optimize and thus it is no where non-obvious to the person in the field. In addition to this, as the patented product fails to show non-obviousness in its advancement or any inventive step thus makes it eligible to be revoked under Section 64(f) of the Act. Therefore, the defendants acquiring right under Section 64 pleads for revocation of the patent granted to the plaintiff on the grounds of deceptive title.

2.3 IT IS A NON-PATENTABLE INVENTION

It is humbly submitted that the patent law entails tests for obviousness and novelty, however merely by qualifying in such test is not enough for a claimed invention to be patented. Apart from the conditions mentioned above, Section 3 of the Act outlines several inventions which are not patentable whatsoever. The Hon'ble court in *F. Hoffmann-La Roche Ltd v. Cipla Ltd*²². stated that- '*non-patentable inventions relate to inventions that may otherwise meet the tests of invention and inventive step but may still not be granted patents as a matter of policy*'. One among such non-patentable inventions under Section 3 of the Act is, a mere re-arrangement or arrangement or duplication of known devices each functioning independently of one another in a known way²³. Any invention which indicates a mere juxtaposition of known devices working independently should not be considered for patent. It is contended that the question of mere- arrangement of devices shall be devised from case- to case basis. However, the Hon'ble court in several judgments formulated few requisites which shall determine if the invention falls under Section 3(f). it is further submitted that The Hon'ble Court in *Asian Electronics Ltd. v Havells India Limited*²⁴ held that- '*An invention cannot be patentable by virtue of mere use of a known process. machine or apparatus unless such known process*

²² F. Hoffmann-La Roche Ltd v. Cipla Ltd 2015 SCC OnLine Del 13619

²³ Section 3(1)(f) of The Patents Act, 1970, 39, 1970 (India).

²⁴ Asian Electronics Ltd. v Havells India Limited MIPR 2010 (2)1

results in a new product or employs at least one new reactant. Moreover, a patent cannot sustain, as being an obvious one, and also hit by the exclusions in Section 3(d) and (e)'.

The Counsel for defendant submits that the plaintiff has claimed for patent in invention which is merely a re-arrangement of devices which were otherwise working independently. It is also an established fact that mere re-arrangement clearly restrains an invention from getting patented, however, the plaintiff could have showed an increment in its efficacy to tackle the restrictive invention, which the plaintiff in the instant case have failed to do so. In line to this the Hon'ble Court in *M/s. Standipack Private Limited v Oswal Trading Co.*²⁵, while showing how an admixture or rearrangement of known material fails as invention, observed that-

Thickness of the plastic film/layer depends upon the tolerance of the contents of the pouch. Thus the same is merely an arrangement and re-arrangement of the mixture of the material and cannot be termed as a novel concept and does not have any novelty. Such arrangement and re-arrangement of mixture of the materials cannot become an invention.

It is further submitted that if devices are being used since long time and are composite of the main device, although producing individual results but such a combined effect shall fail to pursue invention. The criterion for a product to fall out of the ambit of Section 3(f) the devices clubbed together or mere rearrangement should produce results differently. In furtherance to this the Hon'ble Court in *Franz Zaver Huemer v. New Yesh Engineers*²⁶ observed that the plaintiff shall not be deemed to be an inventor of patent device as device is already being used in machines for many years and if the existing device can amount to arrangement or rearrangement of the already known devices which does not amount to an invention.

Counsel for defendant hereby draws a parallel interpretation of what exactly means by mere re-arrangement and shows that all the materials or devices which contribute for the sensor embedded technology work independent to each other. The tyre provides for the framework upon which all the

²⁵ M/s. Standipack Private Limited v Oswal Trading Co 1999 (190) PTC 479 (Del)

²⁶ Franz Zaver Huemer v. New Yesh Engineers 1996 SCC OnLine Del 243

devices which work independently have been fixed. The character of these devices independent of the product produces same result. It is contended that if the same sensor is attached to an another device it would perform the same and emit similar results. If the technology is merely placed in a pattern and the combined effect of all the devices produces same results, thus there is no enhancement in their working nor is there any efficacy, it is just mere aggregation of devices which are meant to emit similar results when equipped individually. The plaintiff being an engineer was possessed with the basic working and application of these devices and as she was aware of the technology which already existed in the market, merely to show some level of technical advancement which was otherwise obvious developed such product. It is thus humbly submitted that, the plaintiff in acquiring patent did not involve any inventive step nor technical advancement, if is also the fault of authority to grant a patent to a product which existed in the market. Therefore, the patent granted in not a valid patent and the said patent does not qualify as patentable invention. Hence, if the patent is not a valid patent no question of infringement of patent shall arise.

CONTENTION III

**THAT THE AMBIGUOUS SPECIFICATIONS OF A PATENT LEADS TO REVOCATION
UNDER SECTION 64(1)(A), (D), (E) AND (F) OF THE PATENTS ACT, 1970**

The counsel here humbly submits that plaintiff in this case had no intention to manufacture or market her so-called patented invention and it can be observed from certain facts. Since 2005 to 2022, we have observed that she has not even commercialized any of her inventions and she is just merely doing this as a sole purpose and intention to extort money through present legal proceedings like any other 'patent troll'.

The counsel here observes that the plaintiff has work experience only in the marketing department of companies and not in the Research and Development department which is a crucial sector to work for any kind of an invention, but in this particular case, the plaintiff neither have technical knowledge or qualification nor have any experience to become an inventor as there is no evidence in terms of documents ever produced to show skill or knowledge in the relevant field.

As contended in issue 2, how so called patent of plaintiff is mere-arrangement of known devices functioning in a known manner, independent of each other, performing such functioning as they may perform individually, is a direct violation of section 3(f) of the Patents Act, 1970, thus there is no innovation as well as novelty in this product. Despite being aware of these facts, our parent company has already been working and selling this type of tyre with sensor to collect data and a puncture proof type material since 2017 and specifically in India since January 2021 and did not even applied for the patent because of the nature of re-arrangement of technology. So commercialization of such innovation has already been achieved in society. The counsel humbly submits that section 83 of the Patents Act,1970 should be taken into account while dealing with such issues where it strikes the balance between rights of the patent

holder and obligations of the patent holder towards the government and society. As commercialization plays an important role in society and same has been followed in this case by the defendant by obeying the obligation of securing this invention on a commercial scale and to the fullest extent possible since 2017 but now the plaintiff wants to hinder the same by not just creating a false patent but also not commercializing it and now just trying to extort money as any other patent troll.

The counsel also submits that according to the section 146(2) of the Patents Act, 1970, Every licensee and patentee must inform the Controller on a regular basis on the extent to which the patented invention has been used on a commercial basis in India. Moreover such statements should be provided in accordance with Form 27 under Rule 131(1) of the Patent Rules, 2003. Thus, it is necessary to provide a statement about how the patented innovation functions on a commercial basis in India and false information submission is also punishable by a fine or both a fine and a jail sentence of up to six months. As Plaintiff has not even commercialized any of her inventions, keeping in mind her 200 inventions as well as patents, this conduct of plaintiff is strictly against the jurisprudence of commercialization of patents.

The counsel humbly submits that the plaintiff showed complete insufficiency of disclosure in the impugned patent, as there is no data or information provided regarding connectors between various parts. It is very ambiguous to understand how this tandem connection between parts facilitates an entire new invention to society. The plaintiff does not obey the requirements mentioned under section 10(4)(a) of the Patents Act, 1970.

As contentions under issue 2, explains how this plaintiff's so-called invention of "Sensor Embedded Airless Wheel Structure" is nothing but just an arrangement of chip to collect data and a novel puncture proof technology in an ordinary tyre. Three of these things has their individual functions also and thus its mere a re-arrangement of technology and nothing else. Only a new way of connectors could form a new invention out of this tyre and the plaintiff is

silent on this very subject while disclosing their specifications. Thus, the plaintiff's product is just a hopscotch of the various long existing products. Even in the case of *Anup Engineering Ltd. v. Controller of Patents Office, New Delhi*²⁷, application regarding flexible metallic bellows was rejected just because specifications did not sufficiently described the invention. As patent's first claim, post grant of the patent only talks about the separate compartments to cushion air in tyre and its connection in a sensor chip and is completely silent on what type of connections or connectors have been used and what is the total structure of the tyre. Even the first claim only has this much information, then what complete specification will patentee give under Form 27 under section 146(2) of the Patents Act, 1970, when they did not even mention the same in their first claim, post grant the patent.

Even in the case of *Franz Xaver Humer v. New Yash Engineers*²⁸, the defendant contends that the patent specification must provide sufficient details to enable a person skilled in the art to reproduce the invention without undue experimentation. An arrangement or rearrangement of a known device also does not amount to the invention and thus becomes grounds for revocation of the Patent. The defendant argues that the current specification does not provide enough information on the construction of the compartments within the tyre, the circuit board design, or the embedded chip technology. This lack of crucial details makes it difficult for a skilled person to reproduce the invention without extensive trial and error. Moreover, the defendant argues that the Patent is also vulnerable to challenge under Section 64(1)(h) of the Patents Act, which provides for the revocation of a patent on the grounds of its vagueness.

Thus the counsel finally appeals that the patent no. 23x4281 of "Sensor Embedded Airless Wheel Structure Technology" of plaintiff is merely a re arrangement of technology, neither it is used or commercially accessible to the people yet nor its specifications have been disclosed

²⁷ *Anup Engineering Ltd. v. Controller of Patents Office, New Delhi*, 1982 SCC OnLine Guj 15

²⁸ *Franz Xaver Humer v. New Yash Engineers*, 1996 SCC OnLine Del 243

properly, thus this patent just has a broad protection and there is no as such scientific advancement to be called a new inventions and therefore, counsel pleads under section 104 of the Patents Act, 1970 and the patent must revoked under section 64(1)(a), 64(1)(d), 64(1)(e), 64(1)(f) of the Patents Act, 1970.

PRAYERS

Wherefore in light of the 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 High Court of Hiled is an appropriate forum for filling of counter claims
2. The patent granted to the plaintiff is not a valid patent and the authority was erred in granting the patent
3. The patent granted to plaintiff be revoked

*Any other order as it deems fit in the interest of equity, justice and good conscience. For
This Act of Kindness, the Defendant Shall Duty Bound Forever Pray*

Sd/-

(Counsel for the Defendants)