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

**IN THE HIGH COURT OF HILED
(ORIGINAL JURISDICTION)
COMMERCIAL SUIT NO.6 OF 2023
(WITH PRAYER FOR RELIEF)**

IN THE MATTER OF:

SHRADDHA BHAMBANI

...Plaintiff

VERSUS

BROESHIM (INDIA) PRIVATE LIMITED

...Defendant

MEMORIAL ON BEHALF OF THE DEFENDANT

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INDIAN STATUTES

S. No.	Act Name	Articles/Sections Mentioned
1.	The Patents Act, 1970	2(1), 3, 10 (4), 25(1), 48, 64(1), 83, 84, 104, 122, 146(2),

INDIAN CASES

S. No.	Case Name	Citation Code
1.	Shining Industries and Anr. Vs. Shri Krishna Industries	AIR 1975 All 231
2.	Press Metal Corporation Ltd. vs. Noshin Sorabji Pochkhanawalla and Anr	IR 1983 Bombay 144
3.	Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries	(1979) 2 SCC 511
4.	Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning v. Commissioner of Patents	(1996) SCR 604
5.	Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries	(1979) 2 SCC 511
6.	Aditi Manufacturing Co. v. Bharat Bhogilal Patel	(2014) 5 LW 289
7.	Monsanto Co v. Coramandal Indag Products (P) Ltd	AIR 1986 SC 712
8.	Venkatraman Das vs. V.N.S. Innovations Pvt. Limited and Ors	(2014) 2 LW 874
9.	Cadila Pharmaceuticals Ltd. v. Instacare Laboratories (P) Ltd.	[2001] 21 PTC 472 (Guj.)
10.	Lallubhai Chakubhai Jariwala v Chimanlal Chunilal and Co.	AIR 1936 Bom 99
11.	Standipack Private Limited & Anr. vs M/S. Oswal Trading Co. Ltd	AIR 2000 Delhi 23
12.	Ram Pratap v Bhabha Atomic Research Centre,	(1976) IPLR 28
13.	Spice and Samsung v Somasundar Ramkumar	(2012) 06 IPAB CK 12

14.	G. Srinivasan vs. Voltamp Transformers Limited and Ors,	MANU/TN/0520/20 17
15.	Farbwerke Hoechst Aktiengesellschaft Vormal's Meister Lucius v. Unichem Laboratories	AIR 1969 Bom 255
16.	FDC Ltd., v. Sanjeev Khandelwal & Anr.	IPAB Order No. 30 of 2014 dated 21st March 2014

FOREIGN CASES

S. No.	Case Name	Citation Code
1.	Windsurfing International v Tabur Marine	[1985] RPC 59
2.	British Celanese Ltd. v Courtaulds Ltd	(52) RFC 171

ARTICLES

S. No.	Article
1.	ERIC GREGORSON, Patent Trolls, ENCYCLOPEDIA BRITANNICA, (8 April, 2023 4 P.M.) http://www.britannica.com/EBchecked/topic/1816645/patent-troll .
2.	PRACHI AGARWAL, Patent Troll: The Brewing Storm of Patent Reforms in the United States of America, 15 J. Marshall Rev. Intell Prop. L. (2015)

BOOKS

S. No.	Book Name
1.	Halsbury Laws of England (3rd edn. LexisNexis Butterworths).
2.	Agreement On Trade-Related Aspects of Intellectual Property Rights.
3.	FEROZE ALI KHADER, THE LAW OF PATENTS, (Student Edition, LexisNexis Butterworths Wadhwa Nagpur 2009).
4.	KALYAN C. KANKANALA, ARUN K. NARASANI, VINITA RADHAKRISHNAN, Indian Patent Law And Practice (Oxford India Paperbacks)

WEB SOURCES

S. No.	Website
1.	www.manupatrafast.com (MANUPATRA)
2.	www.scconline.co.in (SCC ONLINE)
3.	www.judis.nic.in (SUPREME COURT OF INDIA OFFICIAL)
4.	www.indiankanoon.org (INDIAN KANOON)
5.	www.aironline.in (ALL INDIA REPORTER)

LIST OF ABBREVIATIONS

S. No.	Abbreviation	Full Form
1.	§/SEC.	SECTION
2.	&	AND
3.	AIR	ALL INDIA REPORTER
4.	ANR.	ANOTHER
5.	ART.	ARTICLE
6.	CO.	COMPANY
7.	HC	HIGH COURT
8.	HON'BLE	HONOURABLE
9.	LTD.	LIMITED
10.	ORS.	OTHERS
11.	PVT.	PRIVATE
12.	SC	SUPREME COURT
13.	SCC	SUPREME COURT CASES
14.	U.O.I.	UNION OF INDIA
15.	V.	VERSUS

STATEMENT OF JURISDICTION

The Petitioner has approached the Honourable High Court of Hiled under Section 104 of the Indian Patent Act, 1970 which read as follows—

*“Section 104. **Jurisdiction**—No suit for a declaration under section 105 or for any relief under section 106 or for infringement of a patent shall be instituted in any court inferior to a district court having jurisdiction to try the suit:*

Provided that where a counter-claim for revocation of the patent is made by the defendant, the suit, along with the counter-claim, shall be transferred to the High Court for decision.

The present case arises out of a counterclaim which has been filed by the Defendant seeking revocation of the Plaintiff's patent titled “Sensor Embedded Airless Wheel Structure Technology” (Patent No.-23x4281) granted to her on 3-01-2023.

STATEMENT OF FACTS

1. The current cause of action has arisen between Shradda Bhambani (Plaintiff, a civil engineer) v. Broeshim (India) Private Limited (Defendant, a subsidiary of the parent company, Broeshim BV, Netherlands) within the jurisdiction of the Hon'ble Court of Hiled. From 2017, the defendant is selling tyres with a sensor to collect data and a puncture proof tyre material. It is also being sold in India from January 2021.
2. A patent was filed in India: "Sensor Embedded Airless Wheel Structure Technology" which claims a tyre with an embedded chip to collect data and a novel puncture proof mechanism that optimises rolling resistance, speed, control and noise. Filed on 2-03-2021 based on her intellectual property rights accruing from Patent No. 23x4281; it was published on 3-01-2023 in the Register of Patents as Patent Number 23x4281. The Plaintiff contends that the Defendant had malafidely and arbitrarily infringed her patent rights. Various reliefs, monetary and otherwise were sought by the Plaintiffs in Commercial Suit No. 6 of 2023.
3. A counterclaim was filed. It was also submitted: the claimed invention is also already in public use, which are grounds for revocation of a granted patent under Section 64(1)(a), (e) and (f) of the act. In addition, it must be revoked under Section 3(f) Section 64(1)(d) of the Act. The Defendant submits that the Plaintiff is a patent troll, who does not commercialise any of her patents; she has filed this suit with malafide intentions.
4. Also, as per Section 146(2) of the Patent Act read with Rule 131(1) of the Patent Rules, 2003 every Patentee must submit a statement of working to the controller patent in Form 27 every year after the grant of the Patent till its expiry. Plaintiff states: she got her patent granted in the year 2023 and she plans to commercialise the same.

ISSUES RAISED

ISSUE - 1

WHETHER THE PLAINTIFF'S PATENT RIGHTS HAVE BEEN INFRINGED OR NOT AND WHETHER THE PATENT STANDS TO BE REVOKED BY THIS HONOURABLE COURT?

ISSUE - 2

WHETHER GETTING A PATENT GRANTED WITHOUT SUBSEQUENT COMMERCIALISATION IS A VIOLATION OF THE OBLIGATION OF PATENT HOLDER UNDER THE INDIAN PATENT ACT,1970?

ISSUE - 3

WHETHER SUFFICIENT DISCLOSURE IS A NECESSARY STEP IN THE GRANT OF PATENT?

SUMMARY OF ARGUMENTS

. THAT THE PLAINTIFF'S PATENT RIGHTS HAVE NOT BEEN INFRINGED AND THE PATENT STANDS TO BE REVOKED BY THIS HON'RABLE COURT.

It is humbly submitted before this Honourable Court that firstly, the Plaintiff's patent stands to be revoked by this Honourable Court mainly on the grounds of Section 64(1)(d) along with the Sections 64(1)(a)(e) and (f) of the Indian Patent Act, 1970. Secondly, it is also contended that no patent rights of the Plaintiff have been infringed as the Plaintiff is merely camouflaging a product whose discovery was known throughout the world and are enfolding it in her specification. Hence, the granted Patent is deemed invalid and must be revoked.

II. THAT A PATENT GRANTED WITHOUT SUBSEQUENT COMMERCIALISATION IS A VIOLATION OF THE OBLIGATION OF THE PATENT HOLDER UNDER THE INDIAN PATENT ACT, 1970.

It is respectfully submitted that the Plaintiff currently holds over 200+ patents in her name but the Plaintiff is a 'patent troll', who does not commercialise any of her patents, and she has malafidely filed this suit with the sole intention of harassing and arm twisting the Defendant and to gain monetary benefit.

III. THAT SUFFICIENT DISCLOSURE IS AN ESSENTIAL STEP IN THE GRANT OF A PATENT.

It is humbly submitted that there is insufficiency of disclosure in the Plaintiffs' impugned patent, since there is no data or information provided regarding the connectors between the various parts, how the parts work in tandem to facilitate the working of the entire invention, etc. The entire patent specification describes a theoretical model of a device that is hopscotch of the various long existing products.

ARGUMENTS ADVANCED

1. THAT THE PLAINTIFF'S PATENT RIGHTS HAVE BEEN INFRINGED AND THE PATENT SHOULD NOT BE REVOKED BY THIS HONOURABLE COURT.

1.1 THE PATENT RIGHTS OF THE PLAINTIFF HAVE NOT BEEN INFRINGED.

1. This case relates to a Patent titled “Sensor Embedded Airless Wheel Structure Technology” which was filed in March 2021 by the Plaintiff who is a civil engineer with around 200 patents to her name in various fields of innovation and has filed a patent in India for the said technology.

2. It is humbly submitted before this honourable court that the Defendant Company, Broeshim BV is a leading manufacturer of tyres with headquarters at the Netherlands. They manufacture various kinds of tyres and have an R&D driven company development plan. Towards the end of the 1960s, the Original Defendant had already created a presence in the global market due to their repeated developments and innovations in the manufacturing of tyres.

3. The Defendant i.e. Broeshim (India) Private Limited is a subsidiary of the Broeshim BV and was incorporated in 1998. It is a pioneer in tyre manufacturing in India and caters to customers throughout. In 2023, it is the leading manufacturer and supplier of tyre and ancillary products in India. The Defendant has introduced various path breaking products in the Indian tyre industry which became synonymous within the tyre industry. From 2017, the defendant is selling tyres with a sensor to collect data and a puncture proof tyre material. The product has also been sold in India since January 2021.

4. A Patent when is sealed or granted, it is not always the case that the Patent should stay unobstructed by any person or third party throughout the life of the Patent. Certain people can challenge the Patent on several grounds, and the way by which the Patent can be challenged is by Revocation of Patent.

The Patent Act does not assume that the Patents granted to be valid; hence, the rights granted on such granted Patents cannot be absolute. The third parties which are required to seek consent from the Patentee of the granted Patent for practising any exclusive rights bestowed upon him/her are also given an opportunity to challenge the validity of the Patents.

5. Section 64 of the Patent Act, 1970, does not restrict the grounds of Patent Revocation to only those provided in Section 64, whereas section 25 (2) also sets out grounds that are used in post-grant opposition proceedings is restrictive in nature. Hence, it can be said that Section 64 is not exhaustive.

6. To be patentable in India, an invention should satisfy patentability requirements. The Patentability criteria in India are—(i) Patentable Subject Matter (ii) Industrial Applicability (iii) Novelty (iv) Inventive Step (v) Specification

7. Patent will be granted only if an invention satisfies all the patentability requirements. Grant of a patent is the cumulative effect of all the requirements and non-satisfaction of even one of the requirements will make an invention ineligible for a patent grant.

1.2 THAT THE PATENT SHOULD BE REVOKED UNDER SECTION 64(1)

1.2.a Section 64(1)(d) provides that the subject of any claim of the complete specification is not an invention within the meaning of this (Patent) Act.

9. It is humbly submitted that as per Section 2(1)(j) an "invention" means a new product or process involving an inventive step and capable of industrial application. The Defendant urges the Court to note that the patented product of the Plaintiff involves no inventive step whatsoever. It uses a simple mechanism of various components which perform their ordinary functions, independently. This means that there is no new product or process arising out of the patented product.

10. Inventive step is the toughest and ambiguous patentability requirement. An invention should possess an inventive step in order to be eligible for patent protection. As per Section 2(1)(ja) "inventive step" means a feature of an invention that involves technical advance as

compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art. As per this section, an invention will have inventive step only if it satisfies two conditions—

- First, the invention should be technically advanced in the light of the prior art or should have economic significance
- Second, the invention should be non-obvious to a person with ordinary skill in the art of the prior art.

11. Inventive step is a step forward in the process of manufacture that involves novelty, utility and distinctiveness in a way that the resultant manufactured article has not been used before. However, the test of inventive step must stand the scrutiny of one who is skilled in the art to which the invention relates. Any further improvement in or modification of another invention is also patentable subject to its qualifying the test of invention or inventive step.

12. In *Shining Industries and Anr. Vs. Shri Krishna Industries*¹, the court held that minor addition in manufacturing old locks by another person cannot be treated as an invention. Not every improvement is an invention. There must be something more than a mere carrying forward or more extended application of a known principle or an original idea of another. An improvement of an old device or method is not patentable merely because it permits a product to be produced more cheaply or is more compact or efficient.

13. In *Press Metal Corporation Ltd. vs. Noshin Sorabji Pochkhanawalla and Anr.*², the court observed that in considering whether the claim made by the inventor is an invention will have to be assessed by looking whether such an invention is obvious in which case it will not be an invention. Obviousness is to be judged by the standard of a man skilled in the art concerned. If the invention is obvious, there can be no inventive step whatsoever.

¹ *Shining Industries and Anr. v. Shri Krishna Industries*, AIR 1975 All 231.

² *Press Metal Corporation Ltd. v. Noshin Sorabji Pochkhanawalla and Anr.*, AIR 1983 Bombay 144.

14. The meaning of patentable invention was later discussed in *Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries*³ where the Supreme Court took the view that an "invention must be inventor's own discovery as opposed to mere verification of what was already known before the date of the patent. A patentable invention apart from being a new manufacture must also be useful"? In 1989, the Delhi High Court in *Thomas Brandt* stated:

“the principle is that every simple invention that is claimed, so long as it is something novel and new, is an invention and the claims and the specifications must be read in that light and a new invention may consist of a new combination of all integers so as to produce a new or important result or may consist of altogether new integers. The invention for which a patent is claimed may be a product or an article or a process, and in the case of an article, the patent is in the end product or the article, and in the case of a process, the patent does not lie in the end product but only in the process by which it is arrived at”

15. The scope of the term "invention" came up for consideration again in the case of *Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning v. Commissioner of Patents*⁴, where the Bombay High Court came to the conclusion that there are three stages involved in an invention:

- (1) the definition of the problem to be solved, or the difficulty to be overcome;
- (2) the choice of the general principle to be applied in solving the problem overcoming the difficulty; and
- (3) the choice of the particular means to be used.

16. Basing its decision on the criteria of novelty and inventiveness, the Supreme Court in the case of *Hindustan Metal Industries*, held "judged objectively, the patent in question lacked novelty and invention as there had been no substantial exercise of the inventive power or innovative faculty. Further, there was no evidence that the patented machine was the result of

³ *Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries*, (1979) 2 SCC 511.

⁴ *Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning v. Commissioner of Patents*, (1996) SCR 604.

any research, independent thought, ingenuity and skill". The same is very much applicable to this case as well.

1.2.b SECTION 64(1)(A)

17. That sec. 64(1)(a) provides that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India.

18. The Defendant humbly submits that the product has already been in public use since 2017 elsewhere and it was introduced and sold in India from January, 2021 as well. It is peculiar to note that the Plaintiff only applied for a patent 2 months later in the same country as well. It must also be noted that the patented invention has various other grounds to be revoked as it does not fulfil all the patentability criteria in the Indian Patent Act, 1970.

19. The Defendant completely denies and refutes the suit of infringement on the basis that firstly, both the products are different and secondly, the Defendant would like to submit the evolutionary history involved in the technology and their active role in the same. There was a slew of patents in the late 2000s concerning developments in intelligent and puncture proof tyres.

20. Patent holders have constantly understood the requirements of the industry to ensure that tyre mechanism innovates in tandem with road conditions Therefore, innovation can only be with respect to the finer elements in the working of the tyre, whereas the overall structure, working and specifications are well established and well known. Further, while one can claim ownership over a minor improvement or advancement, the entire design of a tyre cannot be claimed to be an invention in the year 2022 as claimed by the Plaintiff.

21. It is again iterated that all the components claimed by the Plaintiff in the said patent are just a mere arrangement and rearrangement of known devices which function independently and there is a clear lack of inventiveness, various degrees of obviousness and hence, the patent obtained by the Patent must be revoked.

22. In the case of *Aditi Manufacturing Co. v. Bharat Bhogilal Patel*⁵, the respondent held two patents, Patent No.189027 granted for a process of manufacturing engraved design articles on metals or non-metals and Patent No. 188787 granted for an improved laser marking and engraving machine. The applicant sought to revoke the patent on the ground that inventions related to laser technology and engraving machines are not novel and it was already a part of the prior art. The invention also lacks an inventive step as per the requirement of Section 2(1) (ja). The applicant provided the IPAB with extensive evidence to establish prior art. Some of this prior art included US patents, Japanese patents, trade magazines, expert witnesses' affidavits of one professor & one engineer and bills and invoices to show how similar inventions were being transacted in the Indian marketplace even prior to the patent applications filed by the patentee.

23. While the said patent does not have any component which has been claimed in any previous patent granted in India, the Defendant contends that the Plaintiff should not have been granted a patent in the first place as it does not qualify all the patentability criteria as laid down by the Indian Patent Act, 1970. Furthermore, the Plaintiff is clearly a patent troll who does not commercialise any of her inventions and she is clearly trying to gain various advantages, mainly monetary among others, from this suit.

1.2.b Section 64(1)(e)

24. Section 64(1)(e) provides that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the, documents referred to in section 13.

25. It is humbly submitted that public knowledge about the invention of public use of an invention before the filing date of the patent application will anticipate the invention and negate its novelty. In order to anticipate an invention, the knowledge in the prior art must

⁵ *Aditi Manufacturing Co. v. Bharat Bhogilal Patel*, (2014) 5 LW 289.

enable a person to work the invention without any experimentation or overcoming any problems.

26. Here, it is pertinent to note that a process will be considered to be publicly known or used in India, if a product made by such process is imported into India before the priority date of the patent application.

27. In the case of *Monsanto Co v. Coramandal Indag Products (P) Ltd*⁶, one of the grounds on which the patent was liable to be revoked was that to satisfy the requirement of being publicly known as used in clauses (e) and (f) of [s 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.

28. To decide whether an alleged invention involves novelty and an inventive step, certain broad criteria can be indicated. Firstly, if the "manner of manufacture patented, was publicly known, used or practised in the before or at the date of patent, it will negate novelty or "subject matter". Prior public knowledge of the alleged invention can be by word of mouth or by publication through books or other media. Secondly, the alleged invention discovery must not be the obvious or natural suggestion of what was previously known.

29. In the case of *Venkatraman Das vs. V.N.S. Innovations Pvt. Limited and Ors.*⁷ it was held that—

“Therefore, the party claiming the patent should specify as to what particular features of his device distinguish it from those which had gone before and show the nature of improvement which is said to constitute the invention. The improvement should affect a new and very useful addition to the existing state of knowledge.”

30. In the current case, the Defendant humbly submits that firstly, the invention so patented by the Plaintiff is just a mere arrangement of known devices in such a way that they work

⁶ *Monsanto Co v. Coramandal Indag Products (P) Ltd*, AIR 1986 SC 712.

⁷ *Venkatraman Das v. V.N.S. Innovations Pvt. Limited and Ors*, (2014) 2 LW 874.

independently. Secondly, the patented product has already been in use elsewhere by the Defendant company since 2017 and has been sold from 2021 in India. This shows that the product has already been publicly known and used since 2021 in India and the Plaintiff is merely a patent troll who does not commercialise any of her patents. The conduct of the Plaintiffs shows that she never had any intention to manufacture or market the patented invention and her sole purpose seems to be to extort money through the present legal proceedings.

31. Thus, it is clear, the ingredients are known; the process used is known to the trade. The product is therefore known to the trade. Thus as per ruling in *Monsanto*⁸ and *Cadila Pharmaceuticals Ltd. v. Instacare Laboratories (P) Ltd.*⁹, the process claimed in the impugned patent and the product manufactured by the said process is fully anticipated by the public knowledge and public use in India.

32. In *Monsanto Co.*¹⁰, it was also held, that, “a patent may be revoked, if the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step having regard to what was publicly known or publicly used in India. The plaintiffs were merely camouflaging a substance whose discovery was known through the world and trying to enfold it in their specification relating to the patent.” Hence, the patent product of the Plaintiff stands to be revoked on the ground that it already existed in India before the filing date of the application for a patent by the Plaintiff.

1.2.c Section 64 (1)(f)

33. Sec. 64(1)(f) provides that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim.

⁸ *Supra* note 6.

⁹ *Cadila Pharmaceuticals Ltd. v. Instacare Laboratories (P) Ltd.*, [2001] 21 PTC 472 (Guj.).

¹⁰ *Supra* note 6.

34. Novelty and Non-obviousness are the criteria which provide different functions and add to different characteristics of intellectual products. Novelty is needed for a patent claim to be patentable and to rearrange the concept in the intellectual property. The basic aim for novelty and originality is to get preserved just like non registered designs. For a patent primary novelty and obviousness is key concept and an invention will not be part of it because invention is not new and it's already known to the public, that is why the aim of the novelty requirement under patent laws is to prevent prior art from being patented gain or it has not fallen in public domain or that it does not form part of the state of the art.

35. Invention is novel when it is not in a public domain as mentioned sections 2(1) (l) and 2(1) (j) of the Patents Act highlighted a 'New invention' in a following way:

"Any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i.e., the subject matter."

36. Two basic features for patent i.e. Novelty and Utility is observed in the case of *Lallubhai Chakubhai Jariwala v Chimantal Chunilal and Co.*¹¹, wherein it was observed that real test for patentability is novelty for patent and its essentials. In India the test of novelty is in inclusion with new inventions. Novelty is unused and unknown information which sets competitive advantage in a business field as a "sweet spot" for accessibility of patent.

37. To prove novelty in India, an essential element is that the invention must fall under the state of the art, which encompasses prior art, prior knowledge, and prior use that would infringe on the patentee's claim if carried out, and would have been anticipated. Although the Indian Patent Act 1970 does not define "state of the art," it has been established through various case laws. In contrast, under English law, the state of the art refers to an invention comprising all matter, such as a product, process, or information that has been available to the

¹¹ *Lallubhai Chakubhai Jariwala v Chimantal Chunilal and Co.*, AIR 1936 Bom 99.

public in any way before the invention's priority date. The concept of the state of the art originated from European/English standards of novelty.

38. Patent publicly known or considered as prior art is not limited to published documents although it must be part of the common knowledge of public.⁸ The novelty and non-obviousness of a patent must be observed and determined through 'skilled in art' because a skilled person has experience of the field in question and he must have the necessary information for the same. That is why the concept of 'Novelty' formulated as a uniform test for determination of inventive steps as well as non-obviousness.

39. In the UK the "Windsurfer"¹² approach was adopted to assess inventive steps in a patent. In this approach, the following four steps were taken:

1. The first is to identify the inventive concept embodied in the patent in suit.
2. Assume the mantle of the normally skilled but unimaginative addresses in the art at the priority date and impute to him what was, at the date, common general knowledge in the art in question.
3. Identify what, if any, differences exist between the matters cited as forming part of the state of the art and the alleged invention.
4. Finally, the court has to ask itself whether, viewed without any knowledge of the alleged invention, those differences constitute steps to which would have been obvious to the skilled man or whether they required any degree of invention.

40. In the current case, there exists no inventive concept as it is just a mere arrangement and rearrangement of known devices. Further, any person who is evaluating the invention (such as a patent examiner or judge) is required to imagine themselves in the shoes of a skilled person in the relevant field and in this case, it is certainly sure that any person in the relevant field could come up with the patented invention since its components are relevant in the industry and known by all in terms of the functions they perform; it can hence, also be anticipated.

¹² Windsurfing International v Tabur Marine, [1985] RPC 59.

1.2.d Section 3(f)

41. Sec. 3(f) provides that the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way.

42. The mere arrangement or rearrangement or duplication of known devices, each functioning independently of one another in a known way, is not patentable. Mere compilation of known devices in which each device functions in a known way is not patentable as long as they are not interdependent.

43. In the case of *Standipack Private Limited & Anr. vs M/S. Oswal Trading Co. Ltd.*¹³, there was an invention relating to a pouch where the patent holder claimed rights over the thickness of the films that have been used in the manufacture of the pouches. The Court stated in the case that the claim relating to thickness of the pouch amounts to a mere arrangement and rearrangement of existing materials because the thickness of the plastic film/layer depends upon the tolerance of the contents in the pouch and the thickness may be altered based on the contents. The Court concluded that such alteration amounts to a mere rearrangement of materials, making the invention unpatentable under Section 3(f) of the Patent Act.

44. In *Ram Pratap v Bhabha Atomic Research Centre*¹⁴, it was held that a mere juxtaposition of features already known before the priority date, which have arbitrarily been chosen from among a number of different combinations which could be chosen, was not a patentable invention. It has further held that when two or more features of an apparatus or device are known and juxtaposed without any interdependence on their functioning of the apparatus or device should be held to have been already known.

45. In *Biswanath Prasad Radhey Shyam*¹⁵, the court held that it is important to bear in mind that, in order to be patentable an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an inventive step. To be

¹³ *Standipack Private Limited & Anr. v. M/S. Oswal Trading Co. Ltd.*, AIR 2000 Delhi 23.

¹⁴ *Ram Pratap v Bhabha Atomic Research Centre*, (1976) IPLR 28.

¹⁵ *Supra* note 3.

patentable the improvement or combination must produce a new result or a new article or a better article than before. The court further held that mere collocation of more than one integer or things, which not involving the exercise of any inventive faculty, does not qualify the grant of patent.

46. In a landmark judgement *British Celanese Ltd. v Courtaulds Ltd*¹⁶, section 3(f) of the Act has been explained very clearly, wherein Lord Tomlin laid down the law as follows: A mere juxtaposition of known devices in which each device functions independently is not considered patentable. It is accepted as sound law that merely placing, side-by-side, old integers so that each integer performs its function independently of the other/s, is not a patentable combination.

47. In the present case, the Defendant humbly submits the evolutionary history involved in the technology and their active role in the same. There was a slew of patents in the late 2000s concerning developments in intelligent and puncture proof tyres. Further, patent holders have constantly understood the requirements of the industry to ensure that tyre mechanism innovates in tandem with road conditions.

48. The wrongly patented technology as devised by the plaintiff claims a tyre with an embedded chip which collects data and a novel puncture proof mechanism that optimises rolling resistance, speed, control and noise. The entire patent specification describes a theoretical model of a device that is hopscotch of the various long existing products. It is vital to note here that the so-called patented product of the Plaintiff involves a simple arrangement of already known devices that exist independently of each other. Let us take note of the Plaintiff's first claim, post grant of the patent—

“In accordance with the present application, Sensor Embedded Airless Wheel Structure Technology essentially consists of the following.

¹⁶ British Celanese Ltd. v Courtaulds Ltd, (52) RFC 171.

A plurality of separate compartments (2A,2B,2C,2D,2E & 2F) typically & essentially designed to cushion air within themselves.

A sensor chip embedded below the said compartments, provided with a circuit board which operates in a fully automatic as well as an optional manual mode and rest mode.

Characterised in that the sensor chip is connected to said compartments to operate in a plurality of road conditions.”

49. With respect to this claim, firstly, the separate compartments just perform the function of cushioning air within themselves. Secondly, the chips perform an independent function of collecting data; the circuit board in addition to this, operates in a separate way as well as mode (automatic or manual). Additionally, a novel puncture proof mechanism aims to optimise rolling resistance, speed, control and noise. Leaving this aside, these components already perform known functions and operate independently in the said product. Hence, innovation can only be with respect to the finer elements in the working of the tyre, whereas the overall structure, working and specifications are well established and well known. Therefore, the Defendant humbly submits that the Plaintiff's patent ought not have been granted and refused under section 3(f) of the Patent Act and further, it stands to be revoked by this Honourable Court.

2. THAT GETTING A PATENT GRANTED WITHOUT COMMERCIALISATION IS A VIOLATION OF THE OBLIGATION OF PATENT HOLDER UNDER THE PATENT ACT, 1970

50. The Plaintiff is a civil engineer, with around 200 patents who does not commercialise any of her patents. As per the Patents Act, 1970 one of the patentability criteria is ‘the invention should have industrial application’. The patents’ rights conferred to the patentee are merely not to enjoy the monopoly over the invention¹⁷, but the patentee must ensure the use of technology for the societal and economic benefit of the country. Once the patent is granted, the patentee

¹⁷ Sec. 2(1)(j), The Patents Act, 1970, No. 39, Acts of Parliament, 1970.

must ensure the working of the patent in India on a commercial scale. In return, the patentee gets his due amount for his hard work and efforts rendered for intellectual creativity.

51. Section 83 states that the grant of patents is not solely intended to enable patentees to enjoy a monopoly on the import of patented articles. The goal of granting a monopoly to patentees is to encourage invention and ensure that patented inventions are fully worked in India on a commercial scale and reasonably practical without undue delay. The patent rights should serve to promote technological innovation and enable the dissemination of technology to the advantage of producers and consumers, in a manner that is conducive to their social and economic welfare.

52. The main objective of the Patent Act has been identified by the Supreme Court in *Bishwanath Prasad Radhey Shyam*¹⁸ as “*The main aim of Patent law is to promote scientific research, new technology and industrial progress. Providing exclusive privilege to own, use or sell the method or the product patented for a limited period, stimulates invention of commercial utility.*” The plaintiff, despite possessing a significant number of over 200 patents, has yet to engage in any commercial activities with respect to them, and relying solely on a statement regarding potential future commercialization efforts is insufficient, given the plaintiff's prior inaction in this regard, thereby raising the possibility that the plaintiff may be engaging in patent trolling practices, which may potentially violate the provisions of Section 83.

53. Britannica Encyclopaedia defines “Patent troll”, also called non-practicing entity or non-producing entity (NPE) as a “pejorative term for a company, found most often in the American information technology industry that uses a portfolio of patents not to produce products but solely to collect licensing fees or settlements on patent infringement from other companies”¹⁹ Most patent trolls do not use their patents, that is, they do not manufacture any goods or services based on the patents they own. Rather, they acquire patents solely to pressurise

¹⁸ *Supra* note 3.

¹⁹ ERIC GREGORSON, Patent Trolls, ENCYCLOPEDIA BRITANNICA, (8 April, 2023 4 P.M.) <http://www.britannica.com/EBchecked/topic/1816645/patent-troll>.

companies to pay licensing fees. The modus operandi of these patent trolls is to acquire patents with no intention of practising the invention or developing their products and with the sole purpose of instituting lawsuits against infringers.²⁰

54. The Intellectual Property Appellate Board (IPAB) revoked three patents, one belonging to Ram Kumar in the case of *Spice and Samsung v Somasundar Ramkumar*²¹ and two belonging to Bharat Bhogilal Patel in the case of *M/s Aditi Manufacturing Co. Vs. M/s Bharat Bhogilal Patel*²². Both patentees can be regarded as classic patent trolls, not only in the sense of non-practicing entities but in the context of patentees who seek to exploit the weaknesses in the legal system to enforce equally weak patents.

55. In this case, the Plaintiff has repeatedly patented around 200 inventions and has not bothered to commercialise any of them yet. In the case of *G. Srinivasan vs. Voltamp Transformers Limited and Ors.*²³, it was held that—

“37. In view of the fact that similar transformers have already been in use and that the plaintiff has also failed to disclose the complete source of use and furnishing complete specification in his claim, he is not entitled to retain the patent. It is needless to point out that the unused patent would result in economic crisis also. Mere obtaining patent, without commercially exploiting the same, itself will not be a ground to prevent others from doing the same business. If such scenario is allowed by this Court, it would lead to serious consequences and also affect the development of the economy and new inventions.

38. Be that as it may, the failure to disclose the method or instruction to use, as mandated under law, itself is a ground to revoke the patent granted to the plaintiff. Therefore, the patent granted to the plaintiff is revoked and the counter claim made by the defendants is allowed.”

3. THAT SUFFICIENT DISCLOSURE IS AN ESSENTIAL STEP IN THE GRANT OF A PATENT

²⁰ PRACHI AGARWAL, Patent Troll: The Brewing Storm of Patent Reforms in the United States of America, 15 J. Marshall Rev. Intell Prop. L. (2015)

²¹ *Spice and Samsung v Somasundar Ramkumar*, (2012) 06 IPAB CK 12.

²² *M/s Aditi Manufacturing Co. v. M/s Bharat Bhogilal Patel*, (2014) 5 LW 289.

²³ *G. Srinivasan v. Voltamp Transformers Limited and Ors*, MANU/TN/0520/2017.

56. The Defendant respectfully submits that the current case calls for attention towards the fact that the Plaintiff has failed to sufficiently satisfy the disclosure made in its application regarding the patented “invention”. The Defendant further states that there is insufficiency of disclosure in the Plaintiffs’ impugned patent, since there is no data or information provided regarding the connectors between the various parts, how the parts work in tandem to facilitate the working of the entire invention, etc. The entire patent specification describes a theoretical model of a device that is hopscotch of the various long existing products.

57. As per the Indian Patent Act, 1970, the sufficient disclosure of the invention in patent specification acts as a vital requisite while drafting the patent application, because applicants are given rights to exclude others from making use of the patent in lieu of complete disclosure of the invention at the time of filing the patent application. The burden lies on the applicant(s) to ensure that the best mode of performing the invention is provided in the specification.

58. In the matter of the Indian Patent Application No.396/DEL/1996 filed by Gilead Science Inc., lead controller K.S. Kardam passed an order dated March 23, 2009, to refuse the application based on the pre-grant opposition filed by Cipla Limited. One of the grounds of refusal was insufficient disclosure. The controller stated—

“In order to satisfy the requirement of sufficiency of description, the applicant for patent is under public duty to satisfy at least following three conditions, namely:

- 1. The complete specification must describe an embodiment of the invention claimed in each of the claims,*
- 2. The description must be sufficient to enable those in the industry concerned to carry it into effect without making further invention or experiments and*
- 3. The description must be fair, i.e., it must not be unnecessarily difficult to follow.”*

59. Since the sufficient disclosure of the invention to the public through the specification is the basis of the patent grant, the controller [being the custodian of the public rights] has to consider the rights of the public so that the public can exploit the invention commercially

[without doing further experiments] after the expiry of the term of patent. Therefore, the controller has to ensure that the description and claims provided in the specification are clear and succinct but not ambiguous to be understood by the ordinary skilled person.

60. A patent is granted based on the sufficient disclosure of the invention in the specification, which is the basis for allowing the public to access and use the invention once the patent term has expired. As the controller of patent rights, it is important to consider the public's rights to commercially exploit the invention without the need for further experimentation after the patent has expired. This requires the controller to ensure that the description and claims in the specification are clear, concise, and not ambiguous, so that an ordinary skilled person can easily understand the invention.

61. In the case of *Press Metal Corporation Limited v. Noshir Sorabji Pochkhanawalla*²⁴, it was held that: *"It is the duty of a patentee to state clearly and distinctly the nature and limits of what he claims. if the language used by the patentee is obscure and ambiguous, no patent can be granted and it is immaterial whether the obscurity in the language is due to design or carelessness or want of skill"*. It is undoubtedly true that the language used in describing an invention would depend upon the class of persons versed in the art and who intend to act upon the specification. In the present case as already stated above, the invention is described in an obscure and ambiguous language, and on the ground also the patent is liable to be refused under Section 25(1)(g).

62. The requirement of 'sufficiency of disclosure' under the Patents Act, 1970 has been statutorily laid down in Section 10 of the Act read with Rule 13 of the Indian Patent Rules 2003 under the head 'Content of specification'. Particularly, Section 10 (4) of the Act provides that any complete specification shall (a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed; (b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim

²⁴ *Press Metal Corporation Limited v. Noshir Sorabji Pochkhanawalla*, AIR 1983 Bom 144.

protection; (c) end with a claim or claims defining the scope of the invention for which protection is claimed; (d) be accompanied by an abstract to provide technical information on the invention.

63. Since the complete specification is a techno-legal document and being an extremely important document as the disclosure made in this document would define the subsequent stages following the filing of the patent application. Thus, it becomes extremely important that drafting of a complete specification meets all the requirements of Section 10 (4) of the Act.

64. The concept of sufficient disclosure was explained in *Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius v. Unichem Laboratories*²⁵, where the court stated Halsbury's two branches of insufficiency of description: (i) the complete specification must describe "an embodiment" of the invention claimed in each of the claims and that the description must be sufficient to enable those in the industry concerned to carry it into effect "without their making further inventions"; and (ii) that the description must be fair, i.e. it must not be unnecessarily difficult to follow. It was also stated that any information or process may not be required to be described separately in the specification as an embodiment, which is a part of the common knowledge available to the person skilled in the art. The person skilled in the art can refer to the available literature related to the common knowledge for the purpose of carrying the invention into effect.

65. The IPAB in another case of *FDC Ltd., v. Sanjeev Khandelwal & Anr*²⁶, held as follows: "115. *As per sec 10(4), every complete specification shall fully and particularly describe the invention and disclose the best method of performing the invention which is known to the applicant. However, it is not mandatory that the claims should be representative of the best method*".

66. It is further stated that the conduct of the Plaintiffs shows that they never had any intention to manufacture or market the patented invention and their sole purpose seems to be to extort

²⁵ *Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius v. Unichem Laboratories*, AIR 1969 Bom 255.

²⁶ *FDC Ltd., v. Sanjeev Khandelwal & Anr*, IPAB Order No. 30 of 2014 dated 21st March 2014.

money through the present legal proceedings. The Original Defendant further humbly submits that these types of wrongfully obtained patents are a menace and an impediment to the innovative environment in the country.

PRAYER FOR RELIEF

WHEREFORE, in light of the issues raised, arguments advanced and authorities cited it is most humbly and respectfully requested that this Hon'ble Court may be pleased to adjudge and declare that:

(I) THAT THE PLAINTIFF'S PATENT RIGHTS HAVE NOT BEEN INFRINGED AND THE PATENT SO GRANTED SHOULD BE REVOKED ON THE GROUNDS MENTIONED BY THE DEFENDANT.

(II) THAT A PERMANENT INJUNCTION MAY BE PASSED AGAINST THE PLAINTIFF IN TERMS OF SALE OR MARKETING THE PATENTED PRODUCT.

(III) THAT THE PLAINTIFF MUST BE HELD LIABLE FOR THE DAMAGES CAUSED TO THE DEFENDANT AND COMPENSATE THE DEFENDANT FOR ANY LOSS CAUSED TO THEM IN THE COURSE OF THE PENDENCY OF THE SUIT.

And further pass any order as it may deem fit in equity, justice and good conscience.

For this the act of kindness, the Counsels as in duty bound, shall forever pay.

All of which is most humbly prayed

Counsels on behalf of the Defendant
