
**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 CHENNAI**

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 DEFENDANT

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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:

3M Innovative Properties Company v. Venus Safety & Health Pvt. Ltd.	2014 SCC OnLine Del 3362
Ajay Industrial Corporation v. Shiro Kanao Ibraki City	AIR 1983 Delhi 496
Asian Electronics v. Havells India Pvt Ltd	MANU/DE/1343/2010
Avery Dennison Corporation v. Controller of Patents and Designs	(2023) 93 PTC 2006
Bayer Corporation v. Union of India	2014 (60) PTC 277 (Bom)
Beloit Technologies Inc v Valmet Paper Machinery Inc	[1995] RPC 705, 739
Biswanathan Prasad Radhye Shyam v. Hindustan Metal Industries	(1979) 2 SCC 511
British Ore Concentration Syndicate Ltd v. Minerals Separation Ltd	27 RPC 47
Chiron Corp v. Murex Diagnostics	[1995] EWCA Civ J1102-9.
Cincinnati Grinders (Inc) v. BSA Tools Ltd.	48 RPC 33
Communication Components Antenna Inc. v. ACE Technologies Corp.	2019 SCC OnLine Del 9123
F. Hoffman-La Roche v Cipla	2016 (65) PTC 1
Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning v. Unichem Laboratories	1968 SCC OnLine Bom 118
General Tire & Rubber Company v Firestone Tyre & Rubber Company Limited	[1972] RPC 457
Henry Brothers (Magherafelt) Ltd v Ministry of Defence	[1999] RPC 442
In re Hardee	223 USPQ 1122, 1123
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
Monasato Company v. Coramandal Indag Products (P) Ltd	1986 AIR SC 712

National Research Development Corporation of India v. Delhi Cloth and General Mills Co. Ltd.	1979 SCC OnLine Del 206
Novartis AG v. Union of India	(2013) 6 SCC 1
Plimpton v. Spiller	(1876) 4 Ch D 286 (CA)
Poysha Industries Ltd v. Deputy Controller of Patents and Designs	AIR 1975 Cal 178
Press Metal Corporation Limited v. Noshir Sorabji Pochkhanawalla	1982 SCC OnLine Bom 121
Rollatainers Ltd. v. Standipack Pvt. Ltd	1999 PTC SC 19 1.
Shining Industries v. Shri Krishna Industries	1974 SCC OnLine All 117
Surendra Lal Mahendra v. Jain Glazers	1980 SCC OnLine Del 219
Tata Chemicals Limited v. Hindustan Unilever Limited	2012 SCC OnLine IPAB 108
University of Southampton's Applications	[2005] RPC 220, 234
V. Manicka Thevar v. Star Plough Works	1964 SCC OnLine Mad 314
V.B. Mohammed Ibrahim v. Alfred Schafranek	1958 SCC OnLine Kar 50

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://sconline.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 Defendant 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. The Defendant has filed a counter-claim under Section 104 of the Patents Act, 1970.

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 **Defendant**

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, 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 FILED 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 and the counter-claim filed by the Defendant is maintainable before this Hon'ble Court as all cases involving counter-claims seeking revocation of a suit patent would stand transferred to the High Court vide Section 104 of the Patents Act, 1970.

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 to be revoked as it is anticipated by prior art and is mere aggregation of known integers functioning in a known manner which does not involve any inventive step. There is no presumption of validity in favor of the suit patent as it lacks novelty, inventive step and is recent. The suit patent also lacks usefulness and is incapable of industrial application due to an insufficiency of disclosure of the entire invention. Further, the patentee does not fulfill the requirement of qualifying as an inventor under the Act.

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

It is respectfully submitted that an invalid patent cannot be infringed. The Suit Patent is anticipated and obvious. Therefore, the question of infringement does not arise in the instant case. In any event, it is submitted that the balance of convenience is in favour of the Defendant and against the Plaintiff. Hence, an injunction ought not to be granted restraining them from selling their prior used and developed product in India.

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 and the counter-claim filed by the Defendant are maintainable before this Hon'ble Court as provided for under Section 104 of the Patents Act, 1970 (hereinafter the 'Act').¹
2. Under Section 104 of the Act, whenever a counter-claim for revocation of the patent is made by the Defendant, both the suit and the counter-claim shall be transferred to the High Court for its decision.² Since the Defendant has made a counter-claim seeking revocation of the Plaintiff's patent (Patent No. 23x481, hereinafter the 'Suit Patent'), this Hon'ble Court has the jurisdiction to hear the matter.

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

3. It is respectfully submitted that the suit patent ought to be revoked as it is anticipated by prior art **(2.1)** and is mere aggregation of known integers functioning in a known manner which does not involve any inventive step. **(2.2)** There is no presumption of validity in favor of the suit patent as it lacks novelty, inventive step and is recent. **(2.3)** The suit patent also lacks usefulness and is incapable of industrial application. **(2.4)** Further, the validity of the suit patent is affected by Section 83 **(2.5)** and the disclosure in the suit patent is insufficient. **(2.6)** The patentee is not the true and first inventor of the patented invention **(2.7)**

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

² Rollatainers Ltd. v. Standipack Pvt. Ltd., 1999 PTC SC 19 1.

2.1 The Suit Patent is Anticipated By Prior Art

4. It is submitted 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 invention disclosed in the suit patent is part of the state of the art and lacks novelty. (2.1.2) It is further submitted that disclosures made in prior publications are enabling and anticipate the invention claimed in the suit patent. (2.1.3)

2.1.1. History of Puncture-Proof and Non-Pneumatic Tires

5. Non-Pneumatic tires have existed in the industry ever since 1982.³ Non-Pneumatic Tires were however developed primarily for heavy-load commercial vehicles, the military or space rovers. Subsequently, the need to develop non-pneumatic tires for passenger vehicles was felt in order to overcome the shortfalls of traditional pneumatic tires.⁴ Structural characteristics of traditional pneumatic tires exhibit potential safety hazards, including potential safety hazards, including punctures or tire bursts, resulting in loss of mobility and life.⁵ Relevant studies indicate that approximately 70% of highway traffic accidents are caused due to air tire leakages.⁶
6. Subsequently, several tire makers have attempted to address concerns in relation to the use of traditional pneumatic tires by making them ‘puncture-safe’ or ‘puncture resistant’.⁷ These tires are either made using a sealing technology or work as ‘run-flat’ tires which

³ US Patent (1982) Non-pneumatic structurally resilient integrated wheel-tire. United States Patent 4,350,196, Sep 21, 1982.

⁴ Michelin - MICHELIN's airless tire, tested and approved!, Michelin (Sept. 24, 2021), <https://www.michelin.com/en/news/michelins-airless-tire-tested-and-approved/>

⁵ 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/>.

⁶ Yaoji Deng, A Comprehensive Review on Non-Pneumatic Tyre Research, 227 Materials & Design (2023).

⁷ <https://www.ceat.com/content/ceatcampaigns/us/en/bike-tyres/puncturesafe-tyres.html>

allow the tire to run for a specified distance without resulting in haphazard consequences.⁸

Some of these tires are sensor embedded to map road conditions and enhance performance.⁹

7. However, none of these pneumatic tires are wholly puncture-proof. Therefore, in order to develop viable alternatives to traditional 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.¹⁰ Several patents have been filed and granted for inventions in relation to non-pneumatic puncture proof tires in India and abroad.¹¹ In order to develop commercially viable, safe and complaint puncture proof tires, the Defendant launched their sensor embedded tire with a novel puncture proof mechanism in 2017.¹² These tires are also being sold in India ever since 2021.¹³

2.1.2 Invention Disclosed in the Suit Patent Forms Part of the State of the Art

8. State of the art comprises of everything available in patent and non-patent literature found in India or anywhere else in the world.¹⁴ An invention is novel if it does not form a part of the state of the art.¹⁵ The Hon'ble Supreme Court in *Biswanathan Prasad Radhye Shyam v. Hindustan Metal Industries* has held that a patent may be granted only for an invention which is new or novel.¹⁶ The first ingredient for an invention, whether a product or a process, is novelty.¹⁷ Novelty of the patent is the real test of the invention.¹⁸

⁸ <https://www.pirelli.com/global/en-ww/road/puncture-proof-tyres-what-s-behind-them>;

⁹ <https://www.pirelli.com/tyres/en-ww/car/tech-and-knowledge/cyber-tyre>;
<https://www.tiretechnologyinternational.com/news/new-tires-news/embedded-sensor-adds-connectivity-to-michelin-formula-e-tires.html>;

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

¹¹ US Patent No. US7143797B2 (issued Dec. 5, 2006)

¹² Moot Proposition, Para 2.

¹³ Ibid.

¹⁴ Article 54, Convention on the Grant of European Patents, October 5, 1973, 13 INT'L LEGAL MATS. 268 (1974).

¹⁵ *Poysha Industries Ltd v. Deputy Controller of Patents and Designs*, AIR 1975 Cal 178.

¹⁶ (1979) 2 SCC 511, at Para 21.

¹⁷ *M.C. Jayasingh v. Mishra Dhatu Nigam Limited*, 2014 SCC OnLine Mad 163 at Para 104.

¹⁸ *Lallubhai Chakubhai Jariwalla v. Chimanlal Chunilal & Co.*, 1935 SCC OnLine Bom 20.

9. The exclusive right of a patentee will not extend to everything he contemplated in the specification and is restricted to the claims.¹⁹ It is submitted that the first claim of the suit patent is restricted to the following:

- A plurality of separate compartments typically and essentially designed to cushion air within themselves;
- A sensor embedded below the said compartments which operate in a fully automatic, as well as optional manual and rest mode;
- Which allegedly function in tandem in a plurality of road conditions.²⁰

10. It is submitted that all the elements of the claim, whether read as a whole or as constituents, are anticipated by prior art which discloses the subject invention of the suit patent. The coverage of the suit patent does not extend beyond what has been disclosed in prior art as on the priority date of the suit patent. As stated earlier, there are several sensor embedded, puncture-proof tire mechanisms and technology which are a part of the state of the art.²¹

2.1.3 Disclosures Made In Prior Publications Are Enabling

11. 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, 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.²³ 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.²⁴ It is submitted that the invention

¹⁹ Communication Components Antenna Inc. v. ACE Technologies Corp., 2019 SCC OnLine Del 9123, at Para 68.

²⁰ Moot Proposition, Para 12.

²¹ Supra Notes 7, 8 & 9.

²² *General Tire & Rubber Company v Firestone Tyre & Rubber Company Limited*, [1972] RPC 457, at Pages 485

²³ *Ibid*.

²⁴ *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.

disclosed in the suit patent is incapable of being distinguished from any other inventions present in the state of the art.

12. It is respectfully submitted that though the suit patent is titled ‘*Sensor Embedded Airless Wheel Structure Technology*’, it claims ‘a plurality of separate compartments typically and essentially designed to cushion air within themselves.’²⁵ Therefore, it is submitted that the novelty in the suit patent renders it being anticipated by prior art as there exist several sensor-embedded pneumatic tires within the industry. In any event, it is submitted that the suit patent is anticipated by the Defendant’s product which has been available in the industry since 2017 and is currently sold in India since 2021.

13. The Hon’ble Apex Court in *Monasato Company v. Coramandal Indag Products (P) Ltd*²⁶ 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”

14. In light of the above, the technology/features as claimed by the Plaintiff in the suit patent are jointly and severally revealed by the prior art and hence the suit patent ought to be revoked.

2.2 The Suit Patent is Obvious and Lacks Inventive Step

15. It is submitted that the suit patent does not satisfy the test of inventive step and is obvious to a relevant person skilled in the art. **(2.2.1)** The suit patent is a mere arrangement of known

²⁵ Moot Proposition, Para 12.

²⁶ 1986 AIR SC 712, Para 6.

integers which function in a known manner and is therefore hit by Section 3(f) of the Patents Act. (2.2.2)

2.2.1 Suit Patent Does Not Satisfy the Test of Inventive Step

16. A division bench of the Hon'ble Delhi High Court in *F. Hoffman-La Roche v Cipla*²⁷ 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

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 hindsight approach.”

17. Recently, in *Avery Dennison Corporation v. Controller of Patents and Designs*²⁸ 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*²⁹), and the Teaching Suggestion Motivation Test.³⁰ It is settled law that the matter of obviousness is to be judged by reference to the state of the art in light of all that was previously known by persons

²⁷ 2016 (65) PTC 1.

²⁸ (2023) 93 PTC 2006.

²⁹ Supra Note 27.

³⁰ Supra Note 28 at Para 11.

versed in that art derived from experience of what was practically employed, as well as from the contents of previous writings, specifications, textbooks and other documents.³¹

18. 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 accordance with the widely laid down tests of inventive step as laid down by Courts, the following is submitted:

- The question ought to be addressed by the person skilled in the relevant art is ‘Was it for practical purposes obvious to a skilled worker in 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?’³² i.e., the invention must not be a mere workshop improvement but must involve the exercise of intellectual ingenuity.³³ It is submitted that there is no improvement in the disclosed invention. Prior art clearly and unequivocally discloses the *In Arguendo*, even if there is an improvement, it is mere workshop improvement as it is obvious to a relevant person skilled in the art.
- Though the Suit Patent claims to optimize rolling resistance, reduce noise, improve speed and control,³⁴ such an improvement is a mere workshop improvement. The Defendant’s products, in any event, already achieve the said objectives as they are in compliance with relevant industry standards.³⁵
- Accordingly, it is submitted that the suit patent lacks inventive step and ought to be revoked under Section 64(1)(f).

³¹ 3M Innovative Properties Company v. Venus Safety & Health Pvt. Ltd., 2014 SCC OnLine Del 3362, at Para 47.

³² Supra Note 27.

³³ Supra Note 16.

³⁴ Moot Proposition, Para 12.

³⁵ Govt. of India, Ministry of Road Transport and Highways, G.S.R. 479(E) (June 28, 2022)

2.2.2 The Suit Patent is Hit By Section 3(f)

19. It is submitted that the features as claimed by the plaintiff in his patent are nothing but a mere arrangement of various features and technologies which have been present and utilized in the industry over the years. It is submitted that the plaintiff herein has merely combined various known features and technologies available and used in the industry and is claiming novelty over the said arrangement which is invalid. 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.³⁶ 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.³⁷ It is submitted that the suit patent is a mere re-arrangement of know integers i.e., the sensors and compartments which function in a known manner. Hence, it is submitted that the suit patent does not disclose a patentable combination is therefore hit by Section 3(f) of the Act.

2.3 There is no Presumption As Regards The Validity Of the Suit Patent

20. The mere registration of a patent does not guarantee its resistance to subsequent challenges.³⁸ In case the legislature had intended to provide prima facie evidence of validity in the case of patents, then a provision similar to Section 31 of the Trademarks Act would have been incorporated under the Patents Act, 1970. In *3M Innovative Property v. Venus Safety*³⁹, it was held that:

³⁶ *Ajay Industrial Corporation v. Shiro Kanao Ibraki City*, AIR 1983 Delhi 496.

³⁷ *Supra* Note 19.

³⁸ *Supra* Note 27.

³⁹ *Supra* Note 31.

“The scheme of the Act clearly permits to raise the challenge to the patent by the defendant in an infringement proceeding filed by the plaintiff before the court. Thus, in no way the said challenge can be brushed aside by the court by attaching some kind of presumptive approach when the statute provides none.”⁴⁰”

Accordingly, it is submitted that there is no presumption attached to the validity of the suit patent. In fact, this has been specifically excluded under Section 13(4) of the Act. Therefore, the suit patent ought to be revoked for want of novelty and inventive step.

2.4. The Suit Patent is incapable of Industrial Application

21. It is respectfully submitted that the suit patent is incapable of industrial application, for the reason that proper disclosure of the specification was not done by the plaintiff, and further the patent product is said to be useless if not put for commercial use. In *Chiron Corp v. Murex Diagnostics*,⁴¹ It was held that the phrase capable of industrial application must carry with it a meaning of trade or manufacture in the broadest sense, and there must be profit to be made since no industry would make use of something which would be useless. Since, no profit would be generated without commercially using the patented product, such a patent can be deemed to be useless. Under the scheme of a patent, a monopoly is granted to a private individual in exchange of the invention being made public so that at the end of the patent term, the invention may belong to the people at large who may be benefited by it. To say that the coverage in a patent might go much beyond the disclosure thus seems to negate the fundamental rule underlying the grant of patents.⁴² Monopoly over the patented product is granted to the patentee subject to the fact that the product is industrially applicable and available on a commercial scale.

⁴⁰ Ibid at Para 32.

⁴¹ [1995] EWCA Civ J1102-9.

⁴² *Novartis AG v. Union of India*, (2013) 6 SCC 1.

22. Furthermore, It is respectfully submitted before the Hon'ble court that from the language of Section 146 of the Act read with Rule 131 of the Patent Rules, 2003, it is amply clear that commercial working of the patented invention is the basis on which patent is granted.

2.5. Section 83 affects the validity of the Suit Patent

23. It is humbly submitted that the Patents Act strikes a delicate balance between the rights and obligations of a patentee. The general obligations of the patentee are given under Section 83 of the Patents Act. Section 83(a) postulates that patents are granted to encourage inventions and to ensure that the inventions are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay. It is pertinent to note that the plaintiff is a patent troll who does not intend on commercializing her invention. The plaintiff has erred in her obligation to use the product on commercial scale.

24. The Hon'ble Bombay High Court in the case of Bayer Corporation v. Union of India,⁴³ observed that the object of a patent is not to grant a monopoly for the importation of the patented article. The court further observed that Section 83 presupposes some efforts on the part of the patentee to manufacture the patented invention in India coupled with the transfer of technology for the mutual advantage of the producer and user. Section 83 impliedly and positively enlists the burden of the applicant and obligations to be fulfilled after the grant of patent. Such obligations have not been fulfilled by the plaintiff.

2.6. The Suit Patent does not sufficiently disclose the invention

25. It is humbly submitted that it is the duty of the patentee to state clearly and distinctly the nature and limits of the claims.⁴⁴ Furthermore, in the *Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning v. Unichem Laboratories*,⁴⁵ where the court stated

⁴³ 2014 (60) PTC 277 (Bom).

⁴⁴ *Press Metal Corporation Limited v. Noshir Sorabji Pochkhanawalla*, 1982 SCC OnLine Bom 121.

⁴⁵ 1968 SCC OnLine Bom 118

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."

26. In addition to the above, Guidelines for Examination of Patent Applications in the field of pharmaceuticals issued by the Indian Patent Office state:

"Sufficient disclosure of the invention in the patent specification is the consideration for which a patent is granted. While assessing the sufficiency of disclosure, it must be ensured that the best method for performing the invention known to the applicant is described so that the whole subject-matter that is claimed in the claims, and not only a part of it, must be capable of being carried out by a skilled person in the relevant art without the burden of an undue amount of experimentation or application of inventive ingenuity".

".... The description in the specification should contain at least one example or more than one example, covering the full breadth of the invention as claimed, which enable(s) the person skilled in the art to carry out the invention";

27. The aforementioned principle has been affirmed in various decisions at the Indian Patent Office and the Intellectual Property Appellate Board (IPAB). For example, in an order dated 12 June, 2012⁴⁶, the IPAB, acting on a petition filed by Tata Chemicals, revoked Indian Patent No. 195937 granted to Hindustan Unilever Ltd. (HUL) for the invention of a 'filter cartridge' used in HUL's Pureit brand of water-filtration devices wherein one of the grounds for revocation was based on not meeting sufficiency of disclosure requirements. The IPAB concluded that *'the sufficiency requirement is met if at least one way of working the invention is clearly described enabling a skilled person to carry out the invention.'* It

⁴⁶ Tata Chemicals Limited v. Hindustan Unilever Limited, 2012 SCC OnLine IPAB 108.

was further stated by the IPAB that for the purposes of Section 10(4), *'it is not necessary for a patent specification to enable the skilled artisan to carry out all conceivable ways of operating the invention. If the best method known to the applicant is disclosed in the specification, it satisfies the requirement of sufficiency of disclosure.'*

28. In *Press Metal Corporation*⁴⁷, 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 person versed in the art and who intend to act upon the specifications.”
29. Since disclosure of the invention is the consideration in return for which the applicant is granted a monopoly, the highest degree of good faith is called for. The disclosure should be clear, precise, honest and open. A designedly ambiguous description or one that is wanting in distinctness, either by negligence or unskillfulness, will invalidate a patent.⁴⁸

2.7. The Patentee is not an Inventor

30. It is humbly submitted that the plaintiff in the instant case does not qualify as an inventor within the meaning of Section 6 of the Patents Act. The threshold question in determining inventorship is who conceived the invention. Unless a person contributes to the conception of the invention, he is not an inventor. One must contribute to the conception to be an inventor.⁴⁹ Invention requires conception. Furthermore, it is pertinent to note that an inventor must provide technical contribution for the invention of the product⁵⁰. The plaintiff

⁴⁷ Supra Note 44

⁴⁸ *British Ore Concentration Syndicate Ltd v. Minerals Separation Ltd*, 27 RPC 47; *Cincinnati Grinders (Inc) v. BSA Tools Ltd*, 48 RPC 33.

⁴⁹ *In re Hardee*, 223 USPQ 1122, 1123 (Comm'r Pat. 1984).

⁵⁰ *V.B. Mohammed Ibrahim v. Alfred Schafranek*, 1958 SCC OnLine Kar 50; *Shining Industries v. Shri Krishna Industries*, 1974 SCC OnLine All 117.

in the instant case is a civil engineer working in the marketing department, who does not have the requisite technical capability to invent a ‘Sensor embedded, puncture proof tyre’. The inventor must have made an intellectual contribution in achieving the final result of research work leading to a patent to be termed as an inventor. The inventor, for the purpose of patent law, is the actual deviser of what is being claimed.

31. The word "actual" denotes a contrast with a deemed or pretended deviser of the invention; it means, as Laddie J said in *University of Southampton's Applications*⁵¹, the natural person who "came up with the inventive concept." It is not enough that someone contributed to the claims, because they may include non-patentable integers derived from prior art.⁵² A dictionary definition of "deviser" is "a person who devises; a contriver, a planner, an inventor".⁵³

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

32. It is humbly submitted that there can be no infringement of a patent whose invention is covered by a lapsed patent or an invalid patent. The Suit Patent is invalid due to the presence of prior art (3.1) and since the Defendant has been in continuous use of the prior art no action for infringement can lie (3.2.)

3.1. There exists prior art for the Suit Patent

33. In the case of **Gillette Safety Razor Company v. Anglo American Trading Company Limited**,⁵⁴ the Gillette defence was established whereby a Defendant can show that there exists prior art for the suit patent in a suit for infringement. Furthermore, the Hon’ble High Court of Delhi in Roche⁵⁵ laid down a standard test for the grant of an injunction :

⁵¹ [2005] RPC 220, 234

⁵² *Henry Brothers (Magherafelt) Ltd v Ministry of Defence*, [1999] RPC 442.

⁵³ *Shorter Oxford English Dictionary*, 5th edition, Oxford University Press, 2002

⁵⁴ GILLETTE SAFETY RAZOR COMPANY V. THE ANGLO-AMERICAN TRADING COMPANY LD. AND BENT AND PARKER LD., *Reports of Patent, Design and Trade Mark Cases*, Volume 29, Issue 17, 12 June 1912, Pages 341–356, <https://doi.org/10.1093/rpc/29.17.341>

⁵⁵ *Supra* Note 27.

- a. In patent infringement actions, the courts should follow the approach indicated in American Cyanamid, by applying all factors;
- b. The courts should follow a rule of caution, and not always presume that patents are valid, especially if the defendant challenges it;
- c. The standard applicable for a defendant challenging the patent is whether it is a genuine one, as opposed to a vexatious defence. Only in the case of the former will the court hold that the defendant has an arguable case."

It is therefore humbly submitted that the Suit Patent is neither novel nor inventive, and is afflicted by the fact that the Defendant's products constitute a prior art.

3.2. The action for infringement is bound to fail

34. In *Plimpton v. Spiller*⁵⁶, the court held that time of usage of the product by the defendant had to be taken into consideration before granting injunction or declaring infringement. If the patented product was used for a longer duration by the defendant than the patentee, injunction should not normally be granted. In granting or refusing an interlocutory injunction the court will consider the balance of convenience. It will also consider whether the plaintiff has made out a prima facie case. Where the plaintiff has not made out a strong prima facie case of infringement, and a strong prima facie case of validity of the patent, where it is challenged, interim injunction will not be granted.⁵⁷

35. It is further contended that the present case can be well envisaged under the peculiarities which come in the way of the grant of such an injunction. In a suit alleging patent infringement, the court ought not to grant any interim injunction in cases where the defendant presents a "credible" challenge to the validity of the patent.⁵⁸ Neither has the

⁵⁶ (1876) 4 Ch D 286 (CA).

⁵⁷ *Surendra Lal Mahendra v. Jain Glazers*, 1980 SCC OnLine Del 219.

⁵⁸ *V. Manicka Thevar v. Star Plough Works*, 1964 SCC OnLine Mad 314; *National Research Development Corporation of India v. Delhi Cloth and General Mills Co. Ltd.*, 1979 SCC OnLine Del 206.

Plaintiff established the validity of the Suit Patent, nor has the Plaintiff established a prima facie case of infringement. In such light, no relief can be granted to the Plaintiff, especially when a credible challenge to the validity of the Suit Patent is mounted by the Defendant.

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 valid and revoke the Suit Patent.
3. The Defendant's product infringes does not the Suit Patent and grant punitive damages in favour of the Defendant.
4. The threats of infringement are unjustifiable and order an injunction restraining the Plaintiff from making such threats under Section 106 of the Act
- 5.
6. The Defendant is entitled to recover costs from the Plaintiff.

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 Defendant 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 Defendant