

## IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 23-01-2014

CORAM

THE HON'BLE MR.JUSTICE V.RAMASUBRAMANIAN

Civil Suit No.562 of 2007

M.C.Jayasingh

...Plaintiff

Vs

1. Mishra Dhatu Nigam Limited (MIDHANI)  
rep.by its Managing Director, Kanchanbagh  
Hyderabad 500 058.
2. Apollo Hospitals, Jubilee Hills Road  
Banjara Hills, Hyderabad 500 033.
3. Apollo Hospitals Enterprise Limited  
Ali Towers, IV Floor, 55, Greams Road  
Chennai 600 006.
4. Cancer Institute (W.I.A) (Regional  
Cancer Centre), Canal Bank Road  
Gandhi Nagar, Adyar, Chennai 600 020.

...Defendants

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Plaint under Order VII, Rule 1, CPC, read with Order IV, Rule of the Original Side Rules, Section 108 read with Section 50(1) of the Patents Act, 1970 and Section 22(2)(b) of the Designs Act, 2000.

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For Plaintiff : Mr.M.Sundar  
 For Defendant-1 : Mr.V.Chandrakanthan  
 For Defendants 2&3 : Mr.C.Manishankar  
 For Defendant-4 : Mr.N.L.Rajah

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**JUDGMENT**

This is a suit for infringement of patents and designs and for rendition of accounts and various other reliefs.

2. I have heard Mr.M.Sundar, learned counsel for the plaintiff, Mr.V. Chandrakanthan, learned counsel for the first defendant, Mr.C.Manishankar, learned

counsel for defendants 2 and 3 and Mr.N.L.Rajah, learned counsel for the fourth defendant.

3. The case of the plaintiff is as follows:

(a) that he founded a proprietary concern, originally known as Eagle Engineering Works and now known as Eagle Osteon Technologies, in the year 1968, in the field of

Precision Engineering;

(b) that by tireless efforts and investment for over two decades, the plaintiff invented a wide range of Prosthesis for Limb Salvage surgery, for different parts of the human anatomy, which have been given the name "Custom Mega Prosthesis";

(c) that different types of Custom Mega Prosthesis for different parts of human anatomy were developed by the plaintiff to replace bone defects in the anatomical areas of the shoulder, hip, elbow, wrist, knee, ankle, pelvic region, etc.;

(d) that this Custom Mega Prosthesis (hereinafter referred to as "CMP") is made of titanium alloy or medical grade stainless steel;

(e) that the development and perfection of the technology was achieved by the plaintiff through lot of sacrifices and compromises, and was achieved through surgical Oncology and Precision Engineering expertise;

(f) that the plaintiff got Patents and Designs registered for about 15 kinds of CMPs invented and developed by him;

(g) that there are many unique unparalleled and unprecedented features for the CMPs invented by him, such as (1) the use of polymer components as journal bearings which reduce wear and tear by 90% and give smooth and free articulation of the joints; (2) the use of rotating hinge mechanism, which, by allowing a constrained radial freedom between the two bones which mate with the prosthesis, reduces to a large extent the

stress in the bones and joints due to asymmetrical loading in the normal course of functioning; (3) the use of extending mechanism by which the prosthesis can be made to expand in-situ after surgery to compensate growth of symmetrical bone in the other limb, suitable for young patients and (4) the use of the pivotal hinge and thrust bearing pad mechanism which provide friction free articulation;

(h) that the plaintiff has been manufacturing, marketing and selling various CMPs through another proprietary concern by name Arc Bio-Mechanical Engineers;

(i) that Professor Mayilvahanan Natarajan, who is involved in developing and improvising the concept of limb salvage custom Prosthesis, is a Co-Patentee for the CMPs and the company Arc Bio-Mechanical Engineers has been supplying CMPs since the year 1992;

(j) that Professor Mayilvahanan Natarajan, co-owner of the Patent and Design in "Distal Femoral Prosthesis", has nothing to do with commercial aspects/dealings;

(k) that the total sales of knee joint CMPs in terms of quantity was 57 in 2001-02, 81 in 2002-03, 91 in 2003-04, 89 in 2004-05 and 60 in 2005-06;

(l) that the sales of knee joint CMP in terms of turn over was Rs.21,19,400/- in 2001-02, Rs.31,99,550/- in 2002-03, Rs.38,02,450/- in 2003-04, Rs.34,16,000/- in 2004-05 and Rs.29,43,100/- in 2005-06;

(m) that the plaintiff spent substantial amounts towards research and in reaching out the product;

(n) that the amount so spent was Rs.69,383/- in 2001-02, Rs.53,805/- in 2002-03, Rs.45,310/- in 2003-04, Rs.40,980/- in 2004-05 and Rs.46,046/- in 2005-06;

(o) that the amount spent by the plaintiff in advertisements was Rs.72,779/- in 2001-02, Rs.1,06,595/- in 2002-03, Rs.1,36,376/- in 2003-04, Rs.1,57,905/- in 2004-05

and Rs.33,658/- in 2005-06;

(p) that the plaintiff is the recipient of several prestigious and meritorious awards for his work in the field of CMP;

(q) that these awards include (i) Technology Day Award 2006, conferred by Technology Development Board, Department of Science and Technology, Government of India; (ii) National Award of Excellence presented in IOACON 2003; and (iii) L-Ramp Award of Excellence 2006 by the IIT, Madras and L-Ramp Foundation, USA;

(r) that the plaintiff, along with Professor Mayilvahanan Natarajan was assigned Patent Nos.196333, 198869 and 198872 respectively dated 05.9.2003, 30.12.2002 and 02.11.2001;

(s) that while Patent No.196333 is in respect of "Distal Femoral Prosthesis with Thrust Bearing Pad and Rotating Axis Mechanism", Patent No.198869 is in respect of "Proximal Tibial Prosthesis with Weight Bearing Polymer Pad Mechanism" and Patent No.198872 is for "Proximal Tibial Prosthesis";

(t) that all the above 3 CMPs are different versions of "Knee Joint Prosthesis", since they all pertain to knee joint replacement;

(u) that Distal Femoral Prosthesis, which is a variant of the Knee Joint Prosthesis, is designed to replace that portion of the femoral bone adjoining the knee joint and inclusive of the knee joint;

(w) that the Proximal Tibial Prosthesis, which is another variant of CMP-KJP, is designed to replace a section of tibial bone, along with knee joint;

(x) that these inventions not only mimic the physiological action of the distal part of the femoral bone, but also preserve the same;

(y) that the speciality of CMP-KJP is in its shape, size and configuration, which

match in profile the anatomic region of the distal femur;

(z) that one of the unique features of CMP-KJP is a Pivotal Hinge Mechanism, with a bio-compatible polymer journal bearing, which imparts friction free articulation motion of the knee joint;

(aa) that by the above mechanism, a maximum flexion of about 140° to the dorsal side of the Prosthesis is achieved;

(ab) that the durability of the implant is increased by the Thrust Bearing Pad Mechanism, which reduce the frictional wear between the metallic surfaces and by relocating the load transmitted to the pivot pin and the tibial component on weight bearing;

(ac) that the CMP-KJP have each been registered under the Designs Act, 2000;

(ad) that the plaintiff and Professor Mayilvahanan Natarajan were jointly assigned Design No.191946 dated 24.4.2003 in respect of Distal Femoral Prosthesis, Design No.189140 dated 23.5.2002 for Proximal Tibial Prosthesis and Design No.204684 dated 07.6.2006 for Proximal Tibial Prosthesis with Weight Bearing Polymer Pad Mechanism;

(ae) that the novelty of the design of CMP-KJP lies in its shape and configuration and it is designed in such a way to be a perfect replacement for the bone which is removed;

(af) that the plaintiff and his proprietary concern have been purchasing titanium and its alloy mill products from the first defendant since 1992;

(ag) that the first defendant is the sole producer of titanium and its alloy mill products and they enjoy monopoly status and they are fully aware of the product line of the plaintiff;

(ah) that the plaintiff and his proprietary concern have been supplying CMP to the

fourth defendant, on indent from them and on the clinical specifications of Mayilvahanan Natarajan;

(ai) that the fourth defendant Institute has also published research articles in reputed International and Indian Medical Journals evaluating the plaintiff's CMP, including CMP-KJP;

(aj) that the plaintiff and his proprietary concern have also been supplying CMP to the third defendant through its patients since 1996 and directly to the hospital of the third defendant through purchase indents and purchase orders since 2002, on the clinical specifications provided by Professor Mayilvahanan Natarajan;

(ak) that the plaintiff had been the sole supplier of wide range of CMPs to the fourth defendant, but the demand started declining slowly over the years and also suddenly stopped without any reason;

(al) that the plaintiff then came across a newspaper article dated 13.02.2004 in the Hyderabad Edition of the National Daily "The Hindu", wherein it was claimed that an operation had been performed at the second defendant hospital, removing and replacing the cancer infested bone and knee joint of a 18 year old boy with a Prosthesis developed by Engineers of the first defendant's Bio-medical Division;

(am) that the article claimed that the Prosthesis was developed in India for the first time and named as Apollo-Midhani Prosthesis;

(an) that the plaintiff had no occasion to look into the product, as they are custom made;

(ao) that in such circumstances, a candidate approached the plaintiff in the last week of May 2006, seeking employment;

(ap) that while perusing the credentials of the candidate, it was found that that

candidate did a project titled "Design of Custom Made Hinge Knee Rotational Joint and its Study" during 2005-06, when he was a student of Bio-Medical Engineering;

(aq) that he had done the project under the supervision of one P.Amma Rao, Department Head of Bio-Medical Division of the first defendant and had obtained a certificate for the project from the Deputy General Manager (Training and Development) of the first defendant, by name Mr.C.Sridhar;

(ar) that upon perusing the project papers, the plaintiff was shocked to find that the project was done on a Prosthesis which is an absolute and slavish replica of the DFP invented by the plaintiff and over which the plaintiff has valid subsisting Patent and Design Registration;

(as) that immediately, the plaintiff issued a cease and desist notice dated 01.9.2006 to defendants 1, 2 and 4;

(at) that the first defendant sent a reply dated 22.9.2006 seeking copies of relevant documents, without answering the issues;

(au) that the other defendants did not respond to the notice;

(av) that thereafter, the plaintiff made enquiries and found out that the first defendant has not obtained registration of any Patent or Design for any Prosthesis; and

(aw) that therefore, the plaintiff has come up with the above suit.

4. Before proceeding to look into the written statement, I must bring on record two facts. One is that in paragraph 6 of the plaint, the plaintiff has presented in a tabular form, the various kinds of Prosthesis, in respect of which, he had obtained the registration of Patents and/or Designs. The tabular form contains a list of 15 Prosthesis. Out of those 15 Prosthesis, the plaintiff has obtained registration of both Patent as well as Design only in respect of 5 Prosthesis. In respect of 10 Prosthesis, he has not obtained

registration of Patent. But, he has obtained registration of Design in respect of all the 15 Prostheses.

5. The second thing to be taken note of before taking up the written statements for consideration is the fact that though the plaintiff has patent and design registrations for various types of Prostheses, he has confined the suit only to 3 Patents bearing Nos. 196333, 198872 and 198869 and 3 Designs bearing Nos. 191946, 189140 and 204684.

6. The reliefs sought by the plaintiff, in brief, are as follows:

(i) a decree of perpetual injunction to restrain the defendants from in any manner infringing Patent Nos. 196333, 198872 and 198869 or in any manner using any part of the said Patent specifications for making/manufacturing any prosthesis or using the said Patents for improvements in relation to the manufacture of any prosthesis;

(ii) a decree of perpetual injunction restraining the defendants from using any process within the range, scope or purview of the three Patents;

(iii) a decree of perpetual injunction restraining the defendants from making, manufacturing, selling or offering for sale any Prosthesis which uses the claims in the specifications of the three Patents bearing Nos. 196333, 198872 and 198869;

(iv) delivery of all apparatus relating to the manufacture of any Prosthesis which infringes Patent Nos. 196333, 198872 and 198869 and Design Nos. 191946, 189140 and 204684;

(v) a decree of perpetual injunction restraining the defendants from dealing with any Prosthesis which uses or utilises the claims and representations of the plaintiff's Design Nos. 191946, 189140 and 204684 or which comes within the range, scope and purview of the said designs; and

(vi) directing the defendants to render true, fair and faithful accounts in respect of

the invention manufactured, used and sold by the defendants, which infringed and continue to infringe the Patents of the plaintiff.

7. The first defendant has filed a written statement contending inter alia -

(a) that it is a Public Sector Enterprise registered as a Government Company under Section 617 of the Companies Act, 1956, under the administrative control of the Department of Defence Production, Ministry of Defence, for the manufacture of special metals and super alloys to meet the requirements of Defence, Aero Space, Atomic Energy, electronics and other strategic industries;

(b) that by a Memorandum of Understanding entered into with the Government of India, the first defendant undertook Corporate Social Responsibility to serve the society;

(c) that as part of CSR initiative, the first defendant developed various Prostheses having higher strength and light weight, using titanium material, with a view to provide Prostheses at affordable costs to cancer patients in India;

(d) that the said CSR initiative of the first defendant was undertaken at the instance of Mr.A.P.J.Abdul Kalam, the then President of India, who was its Scientific Advisor before becoming the President of India;

(e) that since Prostheses is used as implant in cancer patients, it is a life saving drug which is out of the purview of Patents regime;

(f) that the first defendant has supplied Prostheses only to cancer patients and to no one else;

(g) that the first defendant is not involved in the manufacture and supply of Proximal Tibial Prostheses covered by Patent No.198872 and Proximal Tibial Prostheses with Weight Bearing Polymer Pad Mechanism covered by Patent No.198869;

(h) that in response to the cease and desist notice issued by the plaintiff, the first

defendant demanded the production of copies of certain documents, but the plaintiff did not supply the same on the ground that they are already in public domain;

- (i) that the Distal Femoral Prosthesis was first developed by Howmedica Inc, Rutherford, New Jersey, USA, way back in 1982;
- (j) that the plaintiff did not invent a wide range of Prostheses;
- (k) that there is no comparison of CMPs referred to by the plaintiff with the Hinged Knee Prosthesis manufactured by the first defendant;
- (l) that the Hinged part is like simple knuckle joint mentioned in the text books on "Theory of Machines";
- (m) that the knuckle part has been modified to the condylar shape of the femoral bone;
- (n) that femoral and tibial bones are provided with collar to seat the knee assembly;
- (o) that the first defendant manufactures femoral and tibial components as an integral part equal to the re-sected bone and matching to the anatomy of the patients;
- (p) that there are distinguishing features between the plaintiff's CMP and the Hinged Knee Prosthesis manufactured by the first defendant, in as much as the first defendant's prosthesis does not contain a polymer component, it does not have a rotating hinged mechanism or mechanism for femoral piece, its condylar head and femoral stem is of monolithic design manufactured as an integral part through a special forging process to ensure superior strength and metallurgical reliability, the joint is hinged through hinge pin and locking hole provided to facilitate locking of the nail on cortex of bone using a locking bolt to prevent rotation in the bone cavity.
- (q) that it is true that the first defendant is supplying titanium and its alloy mill

products to the plaintiff from 1992;

(r) that the first defendant started its own supplies of titanium implants and Prosthesis since 1997, but continued the supply of titanium raw material to the plaintiff till 2004;

(s) that the first defendant developed standard Knee Prosthesis in 1997, based on the inputs made available by hospitals and surgeons;

(t) that the Hinged Knee Prosthesis with titanium metal was developed for a cancer patient of the second respondent with the active involvement of the Orthopaedic surgeons there and hence, it was named as "Apollo-MIDHANI Prosthesis";

(u) that the design of the Prosthesis manufactured by the first defendant is distinct from the design of the plaintiff's product;

(v) that the distinction in the design can be summarised as follows:

*"Condylar Head and Femoral Stem of the 1<sup>st</sup> defendant's prosthesis is of a monolithic design manufactured as an integral part through a special forging process, in order to ensure superior strength and metallurgical reliability. As against this, the plaintiff prosthesis is of a two-piece design, which is easier to fabricate. There are, however susceptible to failure under stresses at the mechanical joint. This is a major design difference between and two, also being reflected in performance".*

(w) that this defendant developed Knee Prosthesis in several variants much before the plaintiff patented the Prosthesis;

(x) that the first defendant has had technical interactions with Dr.Mayilvahanan Natarajan and the surgeons of the fourth respondent Institute, when the first defendant was requested to develop special Prosthesis for the surgeries conducted even by Dr.Mayilvahanan Natarajan;

(y) that on two occasions, the first defendant developed a total Femoral Bone replacement with titanium Prosthesis and 316 LVM Femoral Head, when Dr.Mayilvahanan Natarajan performed surgeries;

(z) that therefore Dr.Mayilvahanan Natarajan was well aware of the manufacture of the Prosthesis by the first defendant and he did not object to the same, despite being the co-owner and Co-Patentee;

(aa) that Prosthesis is treated as a drug by the Drugs Control Department and hence, it would be out of the purview of the Patent regime;

(ab) that while the plaintiff charges about Rs.1,36,000/- for each Prosthesis supplied by him, the first defendant charges only Rs.39,200/- for the Prosthesis supplied to the fourth defendant, clearly showing thereby that the first defendant was not attempting to enrich themselves unjustly, at the cost of the plaintiff;

(ac) that while the first defendant's main line of business is the manufacture and supply of strategic materials to defence, space and nuclear sectors, they undertook the task of developing titanium implants and Prosthesis only as a CSR initiative, so that, they are available to common man at affordable cost;

(ad) that titanium implants, which were earlier available only to the affluent people at Super Speciality Hospitals, have now become available to the common man; and

(ae) that therefore, the suit deserves to be dismissed.

8. The defendants 2 and 3 have filed a brief written statement. Apart from denying all the allegations contained in the plaint, defendants 2 and 3 have claimed in their written statement the following:

(a) that the suit is bad for non-joinder of the Co-Patentee Dr.Mayilvahanan Natarajan;

(b) that defendants 2 and 3 are not engaged in the manufacture of Prosthesis, but allowed Doctors and patients to buy Prosthesis from manufacturers of their choice, since Prosthesis is not something which is available over the counter, but it is custom made for every patient;

(c) that the Custom Made Prosthesis are available in several countries for over several decades and some of the patients, who come to the hospitals of defendants 2 and 3, even import the Prosthesis from foreign countries;

(d) that the choice of the source from which CMP is purchased by the patient or the treating Doctor, is made only by them and not by defendants 2 and 3 and hence, defendants 2 and 3 cannot be accused of committing infringement;

(e) that the Prosthesis supplied to Apollo Hospitals has no Polymer Pad and the mechanisms and designs are completely different;

(f) that since Prosthesis is something which is specially made for every patient to suit his specific conditions, no two Prosthesis could be compared; and

(g) that therefore, there is no cause of action for the plaintiff against defendants 2 and 3.

9. The fourth defendant has filed a written statement contending inter alia:

(a) that limb conservation studies have been going on at the fourth defendant Institute from the late 1970s;

(b) that musculoskeletal tumours of the limb occur commonly in children, adolescents and in young people;

(c) that with the advent of modern chemotherapy, combined with surgical procedures, a revolution in the management and survival rate of patients had gone up to 60% from a mere 20%;

(d) that from 1988, Dr.Mayilvahanan Natarajan, a Co-patentee of the plaintiff had taken charge of Limb Salvation in bone tumours at the fourth defendant's institute with the permission of the Government of Tamil Nadu;

(e) that Dr.Mayilvahanan Natarajan had conducted limb conservation studies at the Institute, after his return from England, after completing a special study of Limb Conservation in Non-metastatic case;

(f) that in his Books, "Principles of Orthopaedic Oncology" and "Custom Mega Prosthesis and Limb Salvage Surgery", Dr.Mayilvahanan Natarajan had acknowledged the fourth defendant's contribution to his studies and all items in question are purchased pursuant to the clearance and approval based upon the design provided by him;

(g) that the Prosthesis supplied in the early stages through Dr.Mayilvahanan Natarajan, by a local company, was made of stainless steel;

(h) that however the Defence Research and Development Organisation took up the task of providing titanium as a replacement for stainless steel, at the behest and advice of the former President of India, Dr.A.P.J.Abdul Kalam;

(i) that Dr.Mayilvahanan Natarajan has mentioned in his second book that titanium was stronger, but lighter than stainless steel;

(j) that the Prosthesis made of titanium alloy, not only proved to be life saving, but also contributed to the improvement of the quality of the patient's life;

(k) that many youngsters who benefited by this treatment pursued higher education and took up jobs and started doing well in their avocations.

(l) that Sri Ratan Tata Trust funded the programme from 1995 to 2004, which enabled even poor people get prosthesis;

(m) that titanium alloy is available only with the first defendant and hence, the

plaintiff continued to purchase the same only from them;

(n) that the prosthesis made out of titanium alloys by the first defendant were based on the design supplied by Dr.Mayilvahanan and they were supplied by the first defendant at affordable rates;

(o) that towards the end of 2006, the first defendant informed the fourth defendant about the notice issued by the plaintiff and indicated that they would not be able to supply prosthesis;

(p) that when this was brought to the notice of Dr.Mayilvahanan, he provided stainless steel prosthesis;

(q) that when the supply was stopped abruptly in May 2007, Dr.Mayilvahanan again made arrangements for alternative source of supply;

(r) that the fourth defendant never made any profit out of the purchase and supply of prosthesis, as it is a philanthropic institution, which received a grant from Ratan Tata Trust;

(s) that the development of hinged femoral component became a popular treatment for bone cancer with two types of products, one custom made and another modular, coming into the market;

(t) that the prosthesis used by the fourth defendant are custom made;

(u) that for a long time, five vendors by name (1) Howmedica, Inc. of Rutherford NJ; (2) Zimmer Inc. of Warsaw, (3) Poleco Inc. of Almeda California, (4) Biomet Inc. and (5) Wright Medical Technologists were supplying limb salvage devices and the main aspects claimed by the plaintiff to be unique to his invention, have already been used by these vendors;

(v) that therefore, there is no inventive step or novelty in the invention of the

plaintiff and the question whether the modifications brought forth by the plaintiff would pass the test of novelty and inventive step has to be decided at the time of trial;

(w) that the grant of a patent is no guarantee of its validity and public interest concerns far outweigh any commercial interests that the plaintiff may have;

(x) that when the plaintiff claims that he is manufacturing, marketing and selling the product in question through a proprietary concern by name Arc biomechanical Engineers, he cannot sustain the suit without making them a party;

(y) that since titanium alloy is available only with Government of India undertakings such as the first defendant, the plaintiff could not have had any access to the same, to develop a wide range of prosthesis as claimed by him;

(z) that the process of a metallic implant known as en-prosthesis in the place of the tumor bearing bone through devices, has been in existence even from late 1980s and 1990s and there is no novelty or inventive step;

(aa) that the concept of a prosthesis has been there for 15 to 17 years and the distinguishing features between the plaintiff's prosthesis and the first defendant's prosthesis are set out in the written statement of the first defendant;

(ab) that the supply of prosthesis from 1992 to 2007 to the fourth defendant, have been made not only from plaintiff but also from other suppliers including the first defendant under instructions and guidance of Dr.Mayilvahanan;

(ac) that therefore, it is clear that Dr.Mayilvahanan had assigned his rights under the patent to the first defendant and others, who supplied CMPs to this defendant;

(ad) that consequently, the fourth defendant would be a 'prior user' and hence, no injunction can be granted against them;

(ae) that in any case, the CMPs implanted on patients at the fourth defendant's

institute are not identical with the prosthesis allegedly developed by the plaintiff;

(af) that the distant femoral prosthesis and proximal tibial prosthesis have been in existence for a long time and the rotating hinge mechanism has also been used widely in medical treatment even prior to the grant of patents;

(ag) that even during the period 2001-2003 when the plaintiff obtained registration of patents, the fourth defendant has been using the prosthesis applications manufactured by the first defendant, very much to the knowledge of the co-patentee;

(ah) that therefore, it should be construed that the co-patentee assigned his rights under the patent to the first defendant;

(ai) that there is no novelty in the design nor inventive skill and in any case, the product is different;

(aj) that it is true that CMPs were purchased by the fourth defendant from the plaintiff from the year 1992, but after visit by the former President of India Dr.A.P.J. Abdul Kalam in the year 2000, the fourth defendant started purchasing CMPs made of titanium alloy from the first defendant;

(ak) that since the CMPs are manufactured to suit the requirements of each patient, according to the design provided by the surgeon, there is no infringement of registered design;

(al) that it was the co-patentee of the plaintiff, who conducts surgery in the fourth defendant institute and he has been instrumental in arranging for supplies; and

(am) that therefore, the suit is liable to be dismissed.

10. On the basis of the above pleadings, a learned Judge of this Court framed the following issues on 6.1.2010 for consideration :

(i) *Whether the plaintiff is entitled for a decree and permanent*

*injunction against the defendants from in any manner infringing patent Nos. 196333, 198872 and 198869 from using any part or portion of the said patent specification for making any prosthesis by using the said portion or any part or patent thereof for improvement in relating to manufacture of any prosthesis and to infringe the aforesaid patent or parts thereof?*

*(ii) Whether the plaintiff is entitled for permanent injunction restraining the defendants from claiming in any manner for the use of the process within the range, scope and purview of the said patent Nos. 196333, 198872 and 198869?*

*(iii) Whether the plaintiff is entitled for permanent injunction restraining the defendants from in any manner making, manufacturing, using, selling, offering for sale, marketing or advertising any prosthesis as specified in patent Nos. 196333, 198872 and 198869?*

*(iv) Whether the defendants are liable to deliver all apparatus relating to the manufacture of any prosthesis by the defendants through the infringement of the prosthesis in patent Nos. 196333, 198872 and 198869 and the Design Nos. 191946, 189140 and 204684?*

*(v) Whether the plaintiff is entitled for permanent injunction restraining the defendants in any way making, manufacturing, using, selling, offering for sale, marketing or advertising with regard to any prosthesis or any variation thereof by using or utilising the plaintiff's Design Nos. 191946, 189140 and 204684?*

*(vi) Whether the defendants 1 to 4 are liable to render true, fair and faithful accounts in respect of the invention manufactured, used and sold by the said defendants which infringed and continue to infringe patent Nos. 196333, 198872 and 193869 and a preliminary decree has to be passed for taking such account for the loss and damage suffered by the plaintiff?*

*(vii) Whether the suit is liable to be dismissed for non-joinder of necessary parties?*

*(viii) Whether the suit is bad for mis-joinder of the parties, namely defendants 2 and 3?*

*(ix) Whether the suit filed by the plaintiff is maintainable in law?*

(x) Whether the plaintiff is entitled for the custom 'mega' prosthesis invented and manufactured by the plaintiff along with Professor Dr.Mayilvahanan Natarajan under the title "Inventive steps and Novelty?"

(xi) To what relief the plaintiff is entitled to?"

11. After the framing of the above issues, the plaintiff examined himself as PW1 and filed 64 documents and one material object. The documents, about which there was no controversy, were marked as Exx.P-1 to P-58. The material object was marked as M.O.1. Subsequently, five documents were marked as Exx.P-59 to P-63 subject to objections. The supporting affidavit filed by the co-patentee Dr.Mayilvahanan Natarajan was marked as Ex.P.64 subject to objections.

12. Thereafter, one Mr.K.Gurulingam, working as Deputy General Manager in the first defendant company, was examined as DW1. He filed a proof affidavit in lieu of chief examination. He filed a letter of authorisation given to him as Ex.D.1 and one prosthesis manufactured by the first defendant as M.O.2. During cross examination of D.W.1 by the learned counsel for the plaintiff, the print outs of the annual reports of the first defendant company for the financial years 2005-2006 and 2006-2007 were marked as Exx.D2 and D3 subject to objections.

13. During cross examination of D.W.1 by the counsel for the plaintiff, he was asked whether he could dismantle M.O.1. D.W.1 claimed that he could. Hence, D.W.1 was handed over necessary tools in the court hall, to enable him to dismantle M.O.1. He dismantled M.O.1 completely and after cross examination, reassembled the same. Similarly, he also dismantled M.O.2 into its component parts.

14. Subsequently, D.W.1 was recalled at the instance of the counsel for the first defendant and a fax message received by the first defendant from the fourth defendant along with a diagram of the prosthesis, was marked as Ex.D.4. A letter of the Deputy

General Manager (Law and Administration) containing a resolution of the Board of Directors authorising D.W.1, was filed as Ex.D.5.

15. After the completion of the evidence of D.W.1, the learned counsel for the plaintiff requested me to frame an additional issue. After hearing the parties, I allowed the request and framed the following as an additional issue :

*"Whether Mr.R.Thanikachalam who signed and verified the written statement in his capacity as Resident Manager-Marketing of the first defendant, had due authority to represent the first defendant and whether DW1 had necessary authority to depose on behalf of the first defendant and if not, whether the written statement and the evidence of the first defendant has to be eschewed?"*

16. After the framing of the additional issue, the first defendant examined the Deputy General Manager (Marketing) by name R.Thanikachalam as D.W.2. Through him, Exx.D6 to D8 were marked, subject to objections. They were marked for the purpose of showing the authority of D.W.1 and the authority of the person, who signed and verified the pleadings.

17. The defendants 2 to 4 did not adduce either oral or documentary evidence. However, in the course of arguments, the learned counsel on both sides requested me to fine tune and/or recast one of the issues earlier framed by my predecessor on 6.1.2010, so that the question of infringement is decided. The issue to be recast is issue No.10. It originally read as follows :

*"Whether the plaintiff is entitled for the custom 'mega' prosthesis invented and manufactured by the plaintiff along with Professor Dr. Mayilvahanan Natarajan under the title "Inventive steps and Novelty?"*

18. The fact that the plaintiff has obtained registration of his patents, is undisputed. But, the claim of the defendants is that the inventions claimed by the plaintiff

do not qualify for valid patents in the sense that there was no novelty and that there was no inventive step. Therefore, the highlight of issue No.10 should be the very validity of the patents. Hence, the tenth issue is recast as follows :

*"Whether the patents registered in favour of the plaintiff along with Professor Dr.Mayilvahanan Natarajan, qualify as valid patents, fulfilling the requirements of novelty and inventive steps, so as to entitle the plaintiff to prevent the defendants from infringing the same?"*

19. Out of the 11 issues originally framed and the issue additionally framed, issue Nos.7 to 9 relate to the maintainability of the suit. Therefore, I shall take up these issues first. Thereafter, I would take up the tenth issue for a decision, as it would go to the root of the matter. The decision on issues 1 to 6 and 11, would simply follow my finding on the tenth issue and hence, I would take up these issues in the last part of my order.

ISSUE NOS.7, 8 AND 9 (NON JOINDER OF NECESSARY PARTIES, MIS-JOINDER OF UNNECESSARY PARTIES AND MAINTAINABILITY)

20. The non joinder of the co-patentee Dr.Prof.Mayilvahanan Natarajan and the joinder of defendants 2 and 3 as parties to the suit, are raised as objections to the maintainability of the suit. Let me first take up the question of non joinder of the co-patentee Dr. Prof.Mayilvahanan Natarajan.

21. There is no dispute on facts that Dr.Mayilvahanan Natarajan is a co-patentee and that despite being aware of the institution of the suit, he has chosen to keep away. He has given a supporting affidavit filed as Ex.P.64. In his supporting affidavit, he has stated that he had perused the plaint filed by the plaintiff as well as the affidavits filed by the plaintiff in all interlocutory applications. He has claimed that he was a co-patentee along with the plaintiff for the CMPs and that these CMPs were registered both under the Patents Act and under the Designs Act. While five CMPs are registered both for patent

and for design, ten CMPs are registered for design alone.

22. In the supporting affidavit, Dr.Mayilvahanan Natarajan claims that in his opinion, there is an infringement and that he supported the case of the plaintiff. He further claims that under Section 50 (2) of the Patents Act, 1970, it is enough if the suit is filed by one of the co-patentees. Dr.Mayilvahanan Natarajan has also reserved in his affidavit, a right to supply or file additional material in the course of hearing of the suit. But, he did not choose to do so.

23. The marking of the affidavit of Dr.Mayilvahanan Natarajan was objected to by the counsel for the defendants primarily on the ground that he is not a party to the suit. But, I allowed it to be marked as Ex.P-64, subject to objections.

24. Relying upon the decision of this Court in ***Marneedi Satyam Vs. Venkataswami [AIR (36) 1949 Madras 689]*** and the decision of the Supreme Court in ***Smt.Sudha Devi Vs. M.P.Narayanan and Others [1988 (3) SCC 366]***, Mr.V. Chandrakanthan, learned counsel for the first defendant contended that Ex.P.64 is not admissible in evidence.

25. The question that arose in *Marneedi Satyam* was as to the validity of the evidence recorded in the form of affidavit, in the light of the requirement of Order XVIII Rule 4, CPC. But, the said decision was rendered long before the advent of the sweeping amendments made in the Code, by the Amendment Acts of 1999 and 2002. Therefore, the said decision is of no relevance. In any case, the contents of Ex.P.64 are not intended to be a substitute for oral evidence. It is filed for a very limited purpose.

26. In *Smt.Sudha Devi*, the Supreme Court relied upon Section 3 of the Evidence Act to hold that an affidavit is not evidence, unless the court passed an order under Order XIX Rule 1 or 2 of the Code of Civil Procedure. But, as I have said earlier, this

decision also arose before the amendment of the Code by Amendment Act 22 of 2002. By this Amendment Act, Order XVIII Rule 4 stood amended, permitting chief examination to be by affidavit. In any case, the affidavit of Dr.Mayilvahanan Natarajan is not sought to be filed as an examination in chief of a witness. The purpose of filing this affidavit is very limited. Therefore, the decisions relied upon by the counsel for the first defendant would not clinch the issue.

27. In this case, the affidavit Ex.P.64 can be taken into account by me for two purposes, namely (a) to have confirmation that he continued to have interest in the patent and (b) to get it confirmed that he has no conflict of interest with the plaintiff.

28. But I would not be able to take for its face value, the claim made by Dr.Mayilvahanan Natarajan in his supporting affidavit Ex.P.64, that there is an infringement of intellectual property rights. If he wanted to assert such a claim, either as a co-patentee or at least as an expert in the field, he is expected to get into the witness box, so that the defendants have an opportunity to cross examine him. Since he did not choose to do so, I would not accept the contents of Ex.P.64, in so far as they relate to the rights of the plaintiff are concerned. But, Ex.P.64 can certainly be taken to be an indication that the co-patentees have no conflict of interest between themselves.

29. Keeping the above in mind, let me now examine the question whether the non joinder of the co-patentee is fatal to the claim of the plaintiff or not.

30. Sub-Section (1) of Section 50 of the Patents Act, 1970 makes it clear that where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent. After thus ensuring to all the patentees, an equal and undivided share in the patent under Sub-Section (1), the Act also imposed an embargo under Sub-Section (3)

of Section 50 to the effect that a licence under the patent cannot be granted and a share in the patent cannot be assigned by one of those persons except with the consent of the other person or persons. However, this embargo was made subject to the other provisions and subject to Section 51 and to any agreement for the time being in force.

31. But, in so far as the enforcement of the rights conferred by the Act is concerned, Sub-Section (2) of Section 50 enables each of the co-patentees to seek redressal, even without accounting to the other persons. Sub-Section (2) of Section 50 reads as follows :

*"Subject to the provisions contained in this section and in Section 51, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to the rights conferred by Section 48 for his own benefit without accounting to the other person or persons."*

32. The rights conferred by Section 48 of the Act are (i) the exclusive right to prevent third parties from the act of making, using, offering for sale, selling or importing for those purposes that product which is the subject matter of the patent and (ii) the exclusive right to prevent third parties from the act of using that process and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by a process which is the subject matter of the patent.

33. Therefore, it is clear from Sub-Section (2) of Section 50 read with Section 48 that each of the grantees or proprietors of a patent, is entitled by himself or by his agents, to enforce the rights conferred under Section 48, for his own benefit without accounting to the other person or persons. Coupled with the fact that under Section 50(3), a co-patentee cannot even assign or grant a licence in respect of his share,

without the consent of the other persons, the provisions of Section 50(2) makes the suit maintainable at the instance of one of the co-patentees.

34. The learned counsel for the first defendant relied upon the following decisions to contend that the non joinder of the co-patentee is fatal to the case :

- (i) *Kanakarathanammal Vs. V.S.Loganatha Mudaliar and another [1964 (6) SCR 1];*
- (ii) *Loonkaran Sethiya Vs Ivan E.John [1977 (1) SCC 379];*
- (iii) *Shanmugham and Others Vs. Saraswathi and Others [AIR 1997 Madras 226].*

35. The decision in *Kanakarathanammal* arose out of a suit for recovery of possession of the properties inherited by the appellant in terms of the provisions of the Mysore Hindu Law Women's Rights Act, 1933. She did not implead her brothers as parties to the suit. The Supreme Court held that under the Act, the appellant would be entitled exclusively to the property, if one particular provision of the Act was applied and that her brothers would also be entitled to a share if another provision of the Act was invoked. Therefore, the non joinder of her brothers, who would have otherwise become entitled to a share, was held by the Supreme Court to be fatal to the case of the plaintiff.

36. In *Seth Loonkaran Sethiya*, the suit was for recovery of money. But, it was filed by a person claiming to be the sole proprietor of a firm. One of the questions that fell for consideration was as to whether there was a dissolution of a partnership and whether the plaintiff had become the sole proprietor. The Court found that the claim of dissolution of partnership was false. Therefore, the Court eventually held the non joinder of the other partner as fatal to the case.

37. In *Shanmugham*, the suit was for partition and it was found that some of the co-sharers were not made parties. Since they were necessary even for the determination of the quantum of share to which the plaintiff was entitled, this Court held that the non joinder was fatal.

38. Therefore, all these three decisions are not applicable to the case on hand. In the case on hand, I am concerned about a right statutorily conferred upon the plaintiff. This right under Section 48 of the Patents Act, 1970, is conferred upon each of the patentees in terms of Section 50(2). The general principles governing mis-joinder and non joinder of parties falling in the realm of procedural law under the Code of Civil Procedure, cannot supersede or overtake a substantive right conferred by a Special Enactment. Therefore, I hold that the non joinder of the co-patentee Dr.Mayilvahanan Natarajan to the suit is not fatal to the institution of the suit, so long as he does not have a conflict of interest with the plaintiff.

39. The next objection to the maintainability of the suit is on the ground that the defendants 2 and 3 are not necessary and proper parties to the suit. The Apollo Hospitals, which is the second and third defendant herein, claimed that they are not manufacturing prosthesis. Whenever a patient admitted to their hospital requires a prosthesis, the defendants 2 and 3 look up to the market for the supply of prosthesis. In other words, the defendants 2 and 3 claim to be no more than the customers of these products. The defendants 2 and 3 are neither manufacturers nor suppliers, but only consumers. Therefore, the defendants 2 and 3 claim that the suit is bad for mis-joinder of unnecessary parties.

40. The plaintiff has impleaded the defendants 2 and 3 as parties to the suit, in view of the fact that there was a newspaper article in the Hyderabad Edition of The Hindu dated 13.2.2004 to the effect that cancer infested bone and knee joint of a 18 year old boy was removed and replaced at the second defendant hospital with a prosthesis developed by the engineers of the first defendant's biomedical division. The prosthesis was also given the name 'Apollo Midhani prosthesis'. Therefore, the plaintiff gained an

impression that the common mega prosthesis was developed jointly by the first defendant and the defendants 2 and 3.

41. The plaintiff also filed a copy of the online edition of the newspaper of The Hindu dated 13.2.2004 as Ex.P.11. Ex.P.11 contains a reference to the prosthesis named as 'Apollo Midhani prosthesis'.

42. While cross examining P.W.1, the learned counsel for the defendants 2 and 3 pointed out that it was not stated in Ex.P.11 that the product was jointly developed by the Apollo Hospitals and the first defendant. Therefore, it was contended by the defendants 2 and 3 that in the absence of a clear indication that the defendants 2 and 3 were associated with the manufacture and supply of the product, they should not have been impleaded.

43. But, I am not able to sustain the objections of the defendants 2 and 3. Order I Rule 3 of the Civil Procedure Code gives an indication of the persons, who may be joined as defendants. As per Order I Rule 3, all persons may be joined in one suit, where any right to relief in respect of or arising out of the same act or transaction is alleged to exist against such persons and if separate suits were brought, any common question of law or fact would arise. It is not necessary for a plaintiff to succeed against all the defendants. Order I Rule 3(a) uses the expression 'alleged to exist'. There is an allegation that the plaintiff has a right to relief against the defendants 2 and 3. Moreover, Order I Rule 7 gives a leverage for the plaintiff to join two or more defendants, wherever he is in doubt as to the person from whom he is entitled to obtain redress. In any case, no suit can be defeated by reason of mis joinder in view of the provisions of Order I Rule 9 of the Code.

44. Moreover, Section 48(a) of the Patent Act, 1970 entitles the proprietor of a patent, to prevent others not merely from making or offering for sale or selling, but also

from using or importing. The defendants 2 and 3 would certainly be persons using or importing for the purpose of sale, the product in respect of which, the plaintiff alleges and claims patent rights. Therefore, the joinder of the defendants 2 and 3 as parties to the suit, cannot be said to be vitiated. At any rate, such joinder would not make the suit liable to be dismissed. Similarly, the non joinder of the co-patentee also does not make the suit not maintainable.

45. The learned counsel for the defendants 2 and 3 relies upon the decision of the Supreme Court in ***Laxmi Raj Shetty Vs. State of Tamilnadu [CDJ 1988 SC 326]*** in support of the contention that a report in a newspaper is only hearsay evidence and that it is not one of the documents referred to in Section 78(2) of the Evidence Act, 1872, by which, an allegation of fact can be proved. The presumption of genuineness attached under Section 78 of the Evidence Act to a newspaper report cannot be treated as proof of the facts reported therein.

46. There can be no quarrel about the above proposition. But, there is a small distinction. It may not be open to a Court to treat a newspaper report as having conclusively established the infringement of a person's intellectual property rights. But, it will be certainly open to a plaintiff, on the basis of newspaper reports to implead a person as a party to a suit. In other words, the contents of the newspaper reports may be inadmissible in evidence. But, even without relying upon the newspaper reports, it is open to the plaintiff to implead defendants 2 and 3 if he suspected them of committing infringement. Ultimately, the success of the plaintiff as against defendants 2 and 3 depends upon proof of infringement. But the fact that he may not have a chance to succeed against defendants 2 and 3 is no ground to conclude that they cannot be made parties. Hence, the issue Nos.7, 8 and 9 are answered in favour of the plaintiff and

against the defendants.

ADDITIONAL ISSUE :

47. The additional issue hinges upon the question whether the first defendant can be said to have defended themselves in the suit in a manner known to law or not. The written statement on behalf of the first defendant was signed and verified by one R.Thanikachalam, in his capacity as Resident Manager-Marketing. On behalf of the first defendant, Mr.K.Gurulingam gave evidence as D.W.1. The plaintiff questions the authority of Mr.R.Thanikachalam to sign and verify the pleadings and of Mr.K.Gurulingam to depose on behalf of the first defendant. Let me first take up the issue relating to the authority of Mr.R.Thanikachalam to sign and verify the written statement on behalf of the first defendant.

48. Section 26(1) of the Civil Procedure Code mandates every suit to be instituted by the presentation of a plaint. Order VI Rule 1 of the Code defines the expression 'pleadings' to mean the plaint as well as the written statement. Rule 15 of Order VI lays down the procedure for verification of pleadings. Sub-Rule (1) of Rule 15 of Order VI reads as follows :

*"Save as otherwise provided by any law for the time being in force, every pleading shall be verified at the foot by the party or by one of the parties pleading or by some other person proved to the satisfaction of the Court to be acquainted with the facts of the case."*

49. A careful reading of Order VI Rule 15(1) shows that a pleading has to be verified either by the party or by one of the parties pleading or by some other person proved to the satisfaction of the court to be acquainted with the facts of the case. Mr.R. Thanikachalam, who has signed and verified the written statement on behalf of the first defendant was examined as D.W.2. Therefore, all that is required by Order VI Rule 15(1)

stands satisfied. Order VI Rule 15 does not give a list of persons, who alone are competent to sign and verify the pleadings. Therefore, there is no bar for a person, who is acquainted with the facts of the case, to sign and verify the pleadings, unless otherwise the plaintiff establishes that a person, who is more competent and more knowledgeable about the facts of the case had deliberately failed to sign and verify the pleadings, in order to avoid appearance in court.

50. Order VIII of the Civil Procedure Code, which enlists the rules relating to written statement, set off and counter claim, does not anywhere indicate as to who is or who alone is competent to sign and verify the pleadings.

51. Order XXIX, which deals with suits by or against corporations, mandates under Rule 1 that in suits by or against a corporation, any pleading may be signed and verified on behalf of the corporation, by the Secretary or by any Director or other Principal Officer of the corporation, who is able to depose to the facts of the case. Mr.R.Thanikachalam, who signed and verified the pleadings and who gave evidence as D.W.2 produced copies of the approval granted by the Chairman and Managing Director as Ex.D.6. He also produced certified true copy of the extract of the minutes of the 153rd meeting of the Board of Directors of the first defendant as Ex.D.8.

52. The learned counsel for the plaintiff brought out during cross examination of D.W.2 that he had not seen any of the 64 exhibits filed by the plaintiff in this case and had also not seen the Articles of Association of the first defendant company at any point of time. Therefore, the learned counsel for the plaintiff contended that I should treat the first defendant as having remained ex parte in the suit. But I think it is too wide a proposition to be accepted. While Order VI Rule 15(1), which I have extracted above, uses the phrase 'every pleading shall be verified', Order XXIX Rule 1 uses the phrase 'any

pleading signed and verified'. In other words, the leverage given to any person, who is acquainted with the facts of the case to sign and verify the pleadings under Order VI Rule 15(1) cannot be said to be taken away by Order XXIX Rule 1, C.P.C. As a matter of fact, Order XXIX Rule 3 confers power upon the Court to require the personal appearance of any Secretary or Director or other Principal Officer of the corporation, who may be able to answer material questions relating to the suit. Therefore, the authority given to a person, who is acquainted with the facts, to sign and verify the pleadings, cannot be said to be diluted.

53. In ***Wali Mohammed Khan Vs. Ishak Ali Khan and Others [AIR 1931 ALL. 307]***, a Special Bench of the Allahabad High Court went to the extent of holding that the presentation of the plaint even by a person orally authorised to do so would be valid and that the omission to comply with Order III Rule 1 would only be a mere irregularity and not an absence of jurisdiction.

54. Similarly, while dealing with a suit instituted by a company incorporated under the Companies Act, 1956, a Division Bench of the Bombay High Court held in ***All India Reporter Limited Vs Ramchandra [AIR 1961 BOMBAY 292]*** that the provisions contained in Order VI related only to procedure and that the better view would be to regard them as mere matters of procedure. In paragraph 20 of its judgment, the Bombay High Court held as follows :

*"In the case of companies the plaint can be signed by either a Secretary or a Director or other Principal Officer under Order 29, Rule 1, Civil Procedure Code, or any person duly authorized by the Company under Order 6, Rule 14. The words "duly authorized" in Order 6, Rule 14, need not be restricted to mean authorized by proper written authority or by power of attorney. There is authority for this view in Bengal Jute Mills v. Jewraj*

*Heeralal, AIR 1943 Cal.13, AIR 1948 Mad 369, ILR 1939 Nag 515 : [AIR 1939 Nag. 242] and AIR 1941 Nag 159. In these cases it was held that a plaintiff can orally authorize another person to sign a plaint for him. The Managing Director of the plaintiff Company in the instant case, who has authority to file suits on behalf of the Company (vide Article 156 of the Company's Articles of Association), can orally authorize another person to sign the plaint for him on behalf of the Company. Plaintiff No. 2, who is the Managing Director of the Company (Plaintiff No.1) has in his deposition deposed that Ghushey signed the plaint under his instructions. "The evidence of Ghushey is to the same effect."*

55. In ***Union Bank of India Vs Naresh Kumar [1996 (VI) SCC 660]***, the Supreme Court, after referring to the provisions of Order VI Rule 14 and Order XXIX Rule 1 of the Code, held that even in the absence of a formal letter of authority or power of attorney having been executed, a person referred to in Order XXIX Rule 1 can sign and verify the pleadings on behalf of the corporation, by virtue of the office he holds. The Court further held that since a corporation is a juristic entity, even de hors Order XXIX Rule 1, the company can duly authorise any person to sign the plaint or written statement. Apart from holding so, the Supreme Court went one step further and held that even in the absence of any specific authorisation or resolution by the Board of Directors, it is always open to a corporation to ratify the action of one of its officers in signing and verifying the pleadings.

56. In the case on hand, the note put up by the Senior Manager - Law seeking the authority of the Chairman and Managing Director to authorise Mr.R.Thanikachalam to sign and verify the pleadings, is marked as Ex.D.6. Ex.D.7 is a letter of the Government of India authorising the delegation of certain powers of the Board to the Chairman and Managing Director, as approved by the Board in its resolution dated 26.3.2004. Ex.D.8 is

the copy of the Board resolution. Therefore, it is clear that R.Thanikachalam had necessary authority to sign and verify the pleadings. In any case, the Board must be deemed to have ratified his action. Therefore, it cannot be said that the person, who signed and verified the written statement on behalf of the first defendant did not have the authority to do so.

57. Coming to the evidence of D.W.1, it is needless to point out that it is open to the party to a proceeding to examine any one they want, as a witness. The first defendant had considered D.W.1 as a person competent to depose. He has demonstrated his competence at least to depose, by dismantling and reassembling in open court, the material objects M.O. 1 and 2. There is no law, which requires a corporation to examine its Managing Director as a witness to a suit. The only impediment that is placed under the Code, could be traced to Order XVIII Rule 3. Under the said provision, a party who wishes to appear as a witness, should do so before any other witness is examined, unless the court permits him to appear at a later stage. Therefore, even the authority of D.W.1 to depose, cannot be questioned.

58. In any case, D.W.1 has filed Ex.D.5 - letter of the Deputy General Manager (Law and Administration) recording the resolution passed by the Board of Directors. Though marking of Ex.D5 was objected to by the learned counsel for the plaintiff, on the ground that it is neither original nor certified copy and also on the ground that the contents of the same are irrelevant without any reflection of the board resolution, I do not think that these objections are well founded. For the limited purpose of finding out whether the first defendant company authorised D.W.1 to adduce evidence or not, Ex.D.5 can certainly be admitted. The last paragraph of Ex.D.5 contains signature and rubber stamp of the Chairman and Managing Director of the first defendant, authorising D.W.1

to depose. Therefore, there was nothing wrong in the deposition of D.W.1.

59. In view of the above, the additional issue is answered against the plaintiff and in favour of the first defendant.

ISSUE NO.10 AS IT IS RECAST :

60. The tenth issue (after it is recast) is as to whether the patents registered in favour of the plaintiff along with Prof.Dr.Mayilvahanan Natarajan qualify as valid patents fulfilling the requirements of novelty and inventive step, so as to entitle the plaintiff to prevent the defendants from infringing the same.

61. As pointed out earlier, the plaintiff is a co-patentee, who has obtained registration along with Prof.Dr.Mayilvahanan Natarajan, of five patents and 15 designs. The products, in respect of which he has obtained patent registration, are also products, for which, he has obtained registration of the design. In other words, out of 15 products, the plaintiff has obtained registration for five under both the Enactments and in respect of the remaining 10, under the Designs Act, 2000 alone.

62. However, the present suit is confined only to three patents and three designs. The three patents to which the suit relates are patent Nos.196333, 198872 and 198869. The certificates of registration of these patents are filed as Exx.P1 to P6.

63. The above three patents correlate to the registration of three designs bearing Nos.191946, 189140 and 204684. The certificates of registration of these designs are filed as Exx.P7 to P9 and Exx.P-7A to 9-A.

64. The first defendant has made a categorical admission that they are not manufacturing the products covered by the patents bearing registration Nos.198872 and 198869. This is borne out by paragraph 3 of the written statement filed by the first defendant.

65. Therefore, the area of dispute is now confined only to the patent bearing registration No.196333, which corresponds to the design No.191946.

66. Ex.P.1 is the certificate issued by the Assistant Controller of Patents and Designs in favour of Prof.Dr. Mayilvahanan Natarajan and the plaintiff, in respect of the invention for 'DISTAL FEMORAL PROSTHESIS WITH THRUST BEARING POLYMER PAD AND ROTATING AXIS MECHANISM.' The patent bearing No.196333 dated 5.9.2003 appears to have been granted on 12.7.2006 under Ex.P.1. It is important to note from Ex.P.1 that the same was granted subject to the condition that the validity of the patent is not guaranteed.

67. Ex.P.2 is the complete patent specification in respect of patent No.196333. The description of the product is found in Ex.P.2 as follows :

*"The present patent application No.707/CHE/2003 is a distal femoral prosthesis with thrust bearing polymer pad and rotating axis mechanism. This invention has a femoral shaft, which comprises femoral anchoring component on one end, and the other end evolves, into the cylindrical femoral component, which corresponds to the anatomy of the normal bone. The lower part of the femoral component mates with the condylar component, which is angled by 6° according to the side of the prosthesis. The interior portion of this condylar component mates with the median component by means of the pivotal pin and collared bushes."*

68. The claims made by the plaintiff and his co-patentee are also listed in Ex.P.2. The claims numbering about 18, are summarised in an abstract in Ex.P.2 as follows :

*"The distal femur prosthesis with thrust bearing polymer pad and rotating axis mechanism comparing of condylar component, median component, femoral shaft, tibial shaft, thrust bearing pad, thrust bearing, 2 collared bushes, sleeve bearing, pivot pin, screws with spring and washers when it assembled. The femoral shaft that anchors to the intramedullary*

*portion of the bone at one end and that expands as the condylar component which mates to the median component. The condylar component is angled by 6 degrees at its mid portion. The UHMWPE thrust bearing pad is provided between the under portion of the distal femoral condylar component and the upper surface of the median component and serves to reduce the friction between the metallic surfaces by relocating the load transmitted to tibial component and pivot pin. The rotating hinge is assembled around the median component and is present in the tibial component and provides 3 degrees of radial rotation between the femoral and tibial components."*

69. Ex.P.2 also contains six drawing sheets providing a cross sectional view of the product and its component parts. The fact that the plaintiff has obtained registration of patent for a product described as above is not disputed by the defendants. But in brief, the defence taken by the defendants is two fold namely (a) that at the outset, the patent is invalid, as there is no novelty and no inventive step; and (b) that in any case, the product of the defendants is not similar to the product of the plaintiff, so as to tantamount to an infringement.

70. In other words, the first defence of the defendants is with regard to the very validity of the patent. The second defence is that there is no infringement. Under Section 107 (1) of the Patents Act, 1970, every ground on which a patent may be revoked under Section 64 is available as a ground for defence in any suit for infringement of a patent. Section 107(1) reads as follows :

*"In any suit for infringement of a patent, every ground on which it may be revoked under Section 64 shall be available as a ground for defence."*

71. Section 64(1) of the Act enables the revocation of a registered patent. Section 64(1) is so comprehensive that it indicates (i) the persons, at whose instance, a patent can be revoked; (ii) the Authorities competent to revoke the patent; and (iii) the grounds

on which a patent could be revoked. The persons, at whose instance a patent could be revoked, are (a) any person interested; and (b) the Central Government. The Authorities competent to revoke the patent are (i) the Appellate Board; and (ii) the High Court on a counter claim in a suit for infringement. The grounds on which a patent can be revoked are provided in Clauses (a) to (q) of Section 64(1). It would be useful to extract Section 64(1) and hence, it is extracted as follows :

*"64. Revocation of patents*

*(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may be revoked on a petition of any person interested or of the Central Government by the Appellate Board or on a counter claim in a suit for infringement of the patent by the High Court on any of the following grounds, that is to say—*

*(a) 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;*

*(b) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;*

*(c) that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;*

*(d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;*

*(e) 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 ;*

*(f) 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;*

(g) that the invention, so far as claimed in any claim of the complete specification, is not useful;

(h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;

(i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;

(j) that the patent was obtained on a false suggestion or representation;

(k) that the subject of any claim of the complete specification is not patentable under this Act;

(l) that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in Sub-Section (3), before the priority date of the claim;

(m) that the applicant for the patent has failed to disclose to the Controller the information required by Section 8 or has furnished information which in any material particular was false to his knowledge;

(n) that the applicant contravened any direction for secrecy passed under section 35 or made or caused to be made an application for the grant of a patent outside India in contravention of section 39;

(o) that leave to amend the complete specification under Section 57 or Section 58 was obtained by fraud.

(p) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

*(q) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere."*

72. As pointed out in the preceding paragraph, the Authorities competent to revoke the patent are (i) the Appellate Board; and (ii) the High Court. But, Section 64(1) uses the phrase '**on a counter claim in a suit for infringement of the patent by the High Court'**.

73. Therefore, it is contended by Mr.M.Sundar, learned counsel for the plaintiff that so long as there is no counter claim on the part of the defendants, the defendants are not entitled to challenge the validity of the patent in a suit for infringement.

74. But, I do not think so. Section 64 is primarily concerned with the revocation of patents. For revoking a patent, there must certainly be an application either by a person interested or by the Central Government, either before the Appellate Board or in a counter claim in a suit for infringement before the High Court. Therefore, if the defendants are actually seeking the revocation of patent No.196333, they could do so only by filing a counter claim.

75. But, what the defendants are now doing is only to set up a defence in terms of Section 107(1). Therefore, it is unnecessary for the defendants to file a counter claim.

76. In other words, there is a distinction between the area of operation of Section 64(1) and the area of operation of Section 107(1). If a defendant wants the plaintiff's patent to be revoked, he must file a counter claim in a suit for infringement. If he is not interested in the revocation of the patent, but is interested only in defending himself against an action for infringement, it is not necessary for him to file a counter claim. Section 107(1) is an enabling provision. This is why it uses the expression 'defence'. A

petition for revocation of patent in the form of a counter claim is an offensive action and not a defensive action. Therefore, to take recourse to Section 107(1), it is not necessary for the defendants to file a counter claim. Consequently, I am entitled to see if any one of the Clauses from (a) to (q) of Section 64(1) would go to the aid of the defendants, by way of defence to the claim for infringement.

#### REQUIREMENTS OF A VALID PATENT :

##### Historical Perspective:

77. Seldom have inventors been law makers or vice versa. But Thomas Jefferson had the privilege of being both and it was perhaps he, who signalled the arrival of a patent regime, exactly about 221 years ago in 1793, despite being opposed personally to monopoly rights. Therefore, the U.S. Supreme court virtually paid a tribute to him while tracing the history of the development of patent law since 1790, in its historic decision in

**Graham vs. John Deere Co. [383 US 1 (1966)]** in the following manner:

*"Thomas Jefferson, who as Secretary of State was a member of the group, was its moving spirit, and might well be called the 'first administrator of our patent system.' See Federico, Operation of the Patent Act, 1790, 18 J.Pat.Off.Soc. 237, 238 (1936). He was not only an administrator of the patent system under the 1790 Act, but was also the author of the 1793 Patent Act. In addition, Jefferson was himself an inventor of great note. His unpatented improvements on plows, to mention but one line of his inventions, won acclaim and recognition on both sides of the Atlantic. Because of his active interest and influence in the early development of the patent system, Jefferson's views on the general nature of the limited patent monopoly under the Constitution, as well as his conclusions as to conditions for patentability under the statutory scheme, are worthy of note."*

*Jefferson, like other Americans, had an instinctive aversion to monopolies. It was a monopoly on tea that sparked the Revolution, and*

*Jefferson certainly did not favor an equivalent form of monopoly under the new government. His abhorrence of monopoly extended initially to patents as well. From France, he wrote to Madison (July, 1788) urging a Bill of Rights provision restricting monopoly, and as against the argument that limited monopoly might serve to incite 'ingenuity', he argued forcefully that 'the benefit even of limited monopolies is too doubtful to be opposed to that of their general suppression,' V Writings of Thomas Jefferson at 47 (Ford. ed. 1895).*

*His views ripened, however, and, in another letter to Madison (Aug. 1789) after the drafting of the Bill of Rights, Jefferson stated that he would have been pleased by an express provision in this form :*

*'Art.9. Monopolies may be allowed to persons for their own productions in literature, & their own inventions in the arts, for a term not exceeding \_\_\_\_ years, but for no longer term & no other purpose.'*

*Id. at 113. And he later wrote :*

*'Certainly an inventor ought to be allowed a right to the benefit of his invention for some certain time.....Nobody wishes more than I do that ingenuity should receive a liberal encouragement.'*

*Letter to Oliver Evans (May, 1807), V Writings of Thomas Jefferson at 75-76 (Washington ed.).*

*Jefferson's philosophy on the nature and purpose of the patent monopoly is expressed in a letter to Isaac McPherson (Aug., 1813), a portion of which we set out in the margin. [Footnote 2] He rejected a natural rights theory in intellectual property rights and clearly recognised the social and economic rationale of the patent system. The patent monopoly was not designed to secure to the inventor his natural right in his discoveries. Rather, it was a reward, an inducement, to bring forth new knowledge. The grant of an exclusive right to an invention was the creation of the society -- at odds with the inherent free nature of disclosed ideas-- and was not to be freely given. Only inventions and discoveries which furthered human knowledge, and were new and useful, justified the special inducement of a limited private monopoly. Jefferson did not believe in granting patents for small*

*details, obvious improvements, or frivolous devices. His writings evidence his insistence upon a high level of patentability.*

*As a member of the patent board for several years, Jefferson saw clearly the difficulty in 'drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not.' The board on which he served sought to draw such a line and formulated several rules which are preserved in Jefferson's correspondence. [Footnote 3] Despite the board's efforts, Jefferson saw 'with what slow progress a system of general rules could be matured.' Because of the 'abundance' of cases and the fact that the investigations occupied 'more time of the members of the board than they could spare from higher duties, the whole was turned over to the judiciary, to be matured into a system under which every one might know when his actions were safe and lawful.'*

*Letter to McPherson, supra at 181, 182. Apparently agreed with Jefferson and the board that the courts should develop additional conditions for patentability. Although the Patent Act was amended, revised or codified some 50 times between 1790 and 1950, Congress steered clear of a statutory set of requirements other than the bare novelty and utility tests reformulated in Jefferson's draft of the 1793 Patent Act."*

78. Keeping in mind the above historic perspective, let us now move over to the question of validity of the patent of the plaintiff. The expression 'patent' is defined under Section 2(1)(m) to mean a patent for any "invention" granted under the Act. The expression 'invention' is defined under Section 2(1)(j) to mean "*a new product or process involving an inventive step and capable of industrial application*". The expression 'inventive step' is defined under Section 2(1)(ja) to mean "*a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes invention not obvious to a person skilled in the art*".

79. Interestingly, the Patents Act, 1970 defines the expression 'new invention'

separately under Section 2(1)(l) to mean "*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*". The subject matter should not have fallen in public domain or should not form part of the state of the art. Therefore, fundamentally, the patented product or process should be shown to be an invention, involving an inventive step and capable of industrial application, to be qualified as a valid patent. Consequently, three things become important to see if a patent is valid or not. They are (i) the existence of a new product or process; (ii) an inventive step that was involved in the development of the new product or process; and (iii) its industrial application.

80. The above three requirements are also addressed by different expressions such as (i) **novelty** in the product or process; (ii) an inventive step that is marked by **non obviousness** to the person skilled in the art due to involvement of a technical advance or having economic significance; and (iii) usefulness. If a new product or process involving an inventive step and capable of industrial application, is also claimed to be a new invention, the claimant should also prove (i) that there was no anticipation; and (ii) that it did not form part of the state of the art or had not fallen in public domain.

81. Before proceeding further, we must also take note of the distinction between an invention and discovery, at least for the purpose of understanding certain elementary principles. This can be better done by referring to the opinion of the Court of Appeal in *Lane Fox Vs. Kensington and Knightsbridge Electric Lighting Company (Limited)* [Vol.IX (37) Reports of Patent, Design and Trade Mark Cases 411]. The Court of Appeal pointed out therein that **when Volta discovered the effect of an electric current from the battery on a frog's leg, he made a great discovery, but no patentable invention.**

Again, a man, who discovered that a known machine can produce effects, which no one knew could be produced by it before, may make a great and useful discovery, but if he does no more, his discovery is not a patentable invention. This is due to the fact that he would not have added anything but knowledge to what previously existed. A patentee should do something more. He must make some addition not only to knowledge but to previously known inventions and must use his knowledge and ingenuity so as produce either a new and useful thing or result or a new method of producing an old thing or result. The Court of Appeal further pointed out that ***it is often extremely difficult to draw the line between patentable inventions and non patentable discoveries.*** Interestingly, the above decision was rendered way back in 1892. The difficulty that was encountered by the Court at that time has since been removed by incorporating a provision in the statute itself as to the inventions that do not qualify for being recognised as inventions, within the meaning of the Act.

82. Section 3 of the Act lists out inventions, which do not qualify for being recognised as inventions within the meaning of the Act. In simple terms, the following are not inventions within the meaning of the Act :

- (i) an invention, which is either frivolous or which claims anything obviously contrary to well established natural laws;
- (ii) an invention, whose use or exploitation, would be contrary to public order or morality or an invention which causes serious prejudice to human, animal or plant life or health or to the environment;
- (iii) the mere discovery of a scientific principle or the discovery of something occurring in nature;
- (iv) the mere discovery of a new form of known substance that does not enhance

the known efficacy of the substance;

(v) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components;

(vi) the mere arrangement or rearrangement of known devices each functioning independently of one another in a known way;

(vii) the method of agriculture or horticulture;

(viii) any process for the treatment of human beings or animals to render them free of diseases or to increase their economic value;

(ix) plants and animals other than micro organisms, but including seeds, varieties and species;

(x) a mathematical or business method or a computer programme per se or algorithms;

(xi) a literary, dramatic, musical or artistic work or any other aesthetic creation including cinematographic works and television productions;

(xii) a mere scheme or rule or method of performing mental act or method of playing game;

(xiii) a presentation of information;

(xiv) topography of integrated circuits; and

(xv) an invention, which is, in effect, traditional knowledge.

83. Clause (i) of Section 3 may be of relevance and hence, it is extracted as follows :

*"Any process for the medical, surgical, curative, prophylactic (diagnostic, therapeutic) or other treatment of human beings or any process for a similar treatment of animals to render them free of diseases or to increase their economic value or that of their products."*

84. Therefore, it is admitted on both sides, at least on principle, that if the patent, of which infringement is alleged, does not satisfy the triple tests of novelty, inventive step and usefulness or if it is an invention, which falls within any of the Clauses of Section 3, the claimant is not entitled to any remedy. In the case on hand, the primary contention of the defendants is that there is no invention in the patent of the plaintiff. According to the first defendant, distal femoral prosthesis was first developed and manufactured by Howmedica Inc., Rutherford, NJ, USA and that the same products are available worldwide from various companies. According to the fourth defendant, there are two types of prosthesis namely custom made and modular and that for a long time, five vendors have been offering limb salvage devices to the fourth defendant. They are (i) Howmedica, Inc. of Rutherford, NJ; (ii) Zimmer Inc. of Warsaw; (iii) Poleco Inc. of Almeda California; (iv) Biomet Inc.; and (v) Wright Medical Technologies.

85. In the light of the defence taken by the defendants, it is contended by Mr.M. Sundar, learned counsel for the plaintiff that whenever an action for infringement is initiated by the registered holder of a patent, the onus of establishing that the patent was not a valid patent would shift to the defendant, who challenges the validity of the patent by taking recourse to Section 107(1) read with Section 64. In the case on hand, the claim of the plaintiff is based upon the certificates of registration issued by the Registrar of Patents. The plaintiff also went into the witness box and contended that he had been constantly developing, improvising and perfecting the technology relating to limb salvage devices by spending his time and money for over two decades. He has claimed in his deposition as PW1 that due to unrelenting and persistent research and experimentation in the field and by combining surgical oncology and precision engineering expertise, he was able to develop about 15 types of prosthesis. According to the plaintiff, the CMP

developed by him has the following unique, unparalleled and unprecedented features :

- (i) the use of polymer components as journal bearings, which reduce wear and tear by more than 90% and which give smooth and free articulation of the joints;
- (ii) the use of rotating hinge mechanism, which allows constrained radial freedom between two bones (which mate with prosthesis) and thereby reduces stress in the bone and the joints due to asymmetrical loading in the normal course of functioning;
- (iii) the use of extending mechanism, by which, the prosthesis can be made to expand in-situ, after surgery, to compensate the growth of the symmetrical bone in the other limb for younger patients; and
- (iv) the use of pivotal hinge and the thrust bearing body mechanisms, which provide friction free articulation.

86. In order to prove the above claims, the plaintiff has not only marked as exhibits the registration certificates along with the Specifications and Claims, but has also filed several other documents. Ex.P.10 series are the certificates and awards given to him for the successful development of the CMP. These certificates were issued by the Ministry of Science and Technology of the Government of India, the Technology Development Board of the Government of India and the Indian Institute of Technology, Madras. The plaintiff has also filed as Ex.P.57, an extract from the book titled Custom Mega Prosthesis and Limb Salvage Surgery. In the preface to the book, its author Dr.Mayilvahanan Natarajan has acknowledged the contribution made by the plaintiff for developing the prosthesis, manufacturing it and keeping its costs to the minimum. He had also acknowledged the magnanimity of the plaintiff in providing free prosthesis for the patients at the Government General Hospital. In the preface written by the Cancer Institute itself (fourth defendant) to the said book Ex.P.56, the fourth defendant had also

acknowledged the fact that the co-patentee Dr.Mayilvahanan Natarajan joined their team in 1988 with a proposal for limb conservation in primary malignant tumours of bones and limbs and that he had also persuaded an orthopaedic company to fabricate stainless steel endo-prosthesis.

87. Therefore, on the basis of the pleadings and the evidence of PW1 read with the documents filed by him, Mr.M.Sundar, learned counsel for the plaintiff contended that the plaintiff has discharged the initial burden cast upon him to show that he had a valid patent. Once this is established, the onus of proving that the patent was invalid, shifted on the defendants. But, the defendants, according to the plaintiff, did not discharge the onus that fell upon them, after the evidence of PW1.

88. In support of his above contention, learned counsel for the plaintiff also invited my attention to the cross examination of PW1 as well as the evidence let in by the defendants. The only question that was put to PW1 by the learned counsel for the first defendant during cross examination was that the CMP was already in use in other countries like U.K. and U.S.A. But, PW1 asserted in response to the said question that different persons make different designs and that there is difference between the CMP made in other countries and the CMP made by the plaintiff.

89. In the light of the evidence on record, the learned counsel for the plaintiff contended that the onus that shifted to the side of the defendants for showing that the patent registered in favour of the plaintiff was an invalid one, was not discharged by them either during cross examination of PW1 or by way of other evidence in the form of independent witnesses. What is worse, according to the plaintiff, is that the first defendant made an abortive attempt to get a similar patent registered in their favour. Ex.P.42 is an application made by the first defendant for patenting a knee joint assembly

for body implant. But, the application was admittedly abandoned by the first defendant. The application Ex.P.42 contains Specifications, Claims and an Abstract apart from a drawing of the proposed knee joint assembly. Therefore, the learned counsel for the plaintiff contended that the defendants miserably failed to discharge the onus upon them to prove that the patent registered in favour of the plaintiff was not a valid one.

90. In support of the above contention, the learned counsel for the plaintiff relied upon the decision in ***Anchor Building Products Limited Vs Redland Roof Tiles Ltd.***

**(1990 RPC (11) 283).** In that case, which arose out of an action for infringement of patent, the defendants claimed that the plaintiff was actually guilty of infringement of one of its own patents. By a 2:1 majority, the Court of Appeals held that it was for the party alleging infringement to put before court some evidence, on which the court could fairly conclude that he had an arguable case of infringement, once the alleged infringer had put before the court the evidence, which on its face, showed there had been no infringement.

91. I have carefully considered the above submissions. It is true that the plaintiff has come up with a suit for infringement of a registered patent. He has filed the patent registration certificate as one of the exhibits. He has also gone to the witness box to testify to the contents relating to the Specifications, Claims and Teachings, which form part of the certificate of registration of patent. Therefore, it is necessary to see whether he has discharged the initial burden cast upon him and as to whether the onus now lies upon the defendants to show that the patent was an invalid one, for the reasons stated by them.

92. Section 101 of the Evidence Act, 1872 states that whoever desires any court to give judgment as to any legal right or liability dependent on the existence of facts, which he asserts, must prove that those facts exist. Section 101 also states that when a person

is bound to prove the existence of any fact, it is said that the burden of proof lies on that person.

93. On the question as to the person on whom the burden of proof lies, Section 102 of the Evidence Act states that the burden of proof lies on that person, who would fail, if no evidence at all were given on either side. On the question as to where the burden of proof relating to the existence of a particular fact would lie, Section 103 gives an indication. It says that the burden of proof as to the existence of any particular fact lies on that person, who wishes the court to believe in its existence, unless law fixes responsibility upon some other person to prove that fact. Section 106 makes it clear that when any fact is especially within the knowledge of any person, the burden of proving that fact is upon him.

94. Sections 101 to 110 of the Evidence Act lay down general propositions that would govern the question of burden of proof. Of them, Section 106 may be of particular relevance, since it deals with the question of burden of proving any fact 'which is especially within the knowledge of any person'. But, there is a distinction between burden of proof and onus of proof. The distinction is brought out well by the Supreme Court in ***Anil Rishi Vs. Gurbaksh Singh [2006 (5) SCC 588]***. The Supreme Court held therein that '***the right to begin follows onus probandi and that it assumes importance in the early stage of a case***'. The question of onus of proof has greater force where the question is which party is to begin. But, the burden of proof is used in three ways, namely (a) to indicate the duty of bringing forward evidence in support of a proposition at the beginning or later; (ii) to make that of establishing a proposition as against all counter evidence; and (iii) an indiscriminate use, in which, it may mean either or both of the others.

95. One of the earliest cases where the distinction between onus of proof and burden of proof was brought out was the one in ***A.Ragavamma Vs. A.Chenchamma (AIR 1964 SC 136)***. The Supreme Court pointed out therein that '***burden of proof lies upon the person, who has to prove a fact and that it never shifts, while, on the contrary, the onus of proof shifts.***'

96. However, it was pointed out by the Supreme Court in ***Kalwa Devadattan Vs. Union of India (AIR 1964 SC 880)*** that the question of onus probandi is important in the early stages of a case and in cases where no evidence at all is led. But ***where evidence has been led by the contesting parties, on the question in issue, it was pointed by the Supreme Court that the abstract considerations of onus are out of place and that truth or otherwise of the case must always be adjudged on the evidence led by the parties.***

97. In ***Narayan Govind Gavate Vs. State of Maharashtra [1977 (1) SCC 133]***, the Supreme Court highlighted the fact that a question relating to burden of proof is not always free from difficulty and that '***apparent simplicity of a question relating to presumptions and burden of proof is often deceptive.***' Over simplification of questions relating to presumptions and burden of proof, according to the Supreme Court, leads to erroneous statements and misapplications of law. After extracting an interesting passage from Phipson on evidence, where the phrase 'burden of proof' was often used in two distinct and frequently confused meanings, the Supreme Court pointed out in paragraph 19 of the report that '***the effect of evidence has to be distinguished from the duty or burden of showing to the court, what conclusions it should reach***'. This duty, which is termed as onus probandi is placed upon one of the parties in accordance with the provisions of law applicable to various situations. But, the effect of

evidence is a matter of inference and it is determined at the end of the proceeding not merely by considering the general duties imposed by Sections 101 and 102, but also the special and particular onus imposed by other provisions such as Sections 103 and 106 of the Evidence Act. In the same case, the Supreme Court pointed out further that in judging whether a general or particular or special onus had been discharged, the court will not only consider the direct effect of the oral and documentary evidence, but also what may be indirectly inferred because of certain facts having been proved or not proved.

98. In so far as the patent rights are concerned, the facts pleaded are specially within the knowledge of the person staking a claim. ***Though the Controller of Patents examines the patentability of a product or process, with reference to the Teachings, Claims and Specifications and also makes an investigation about anticipation by previous publication, he does not guarantee the validity of the patent.*** This is due to the fact that ***a patent specification is actually a unilateral statement made by the patentee in words of his own choosing.*** This principle referred as the '***doctrine of pith and marrow of the claim***', was summarised by Lord Diplock in ***Catnic Components Ltd & another Vs. Hill & Smith Ltd. (1982 RPC 183)*** as follows :

*'...a patent specification is a unilateral statement by the patentee, in words of his own choosing, addressed to those likely to have a practical interest in the subject matter of his invention (i.e 'skilled in the art'), by which he informs them what he claims to be the essential features of the new product or process for which the letters patent grant him a monopoly. It is those novel features only that he claims to be essential that constitute the so called 'pith and marrow' of the claim. A patent specification should be given a purposive construction rather than a purely literal one derived from*

*applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge. The question in each case is : whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked....The question, of course, does not arise where the variant would in fact have a material effect upon the way the invention worked. Nor does it arise unless at the date of publication of the specification it would be obvious to the informed reader that this was so. Where it is not obvious, in the light of the then existing knowledge, the reader is entitled to assume that the patentee thought at the time of the specification that he had good reason for limiting his monopoly so strictly and had intended to do so, even though subsequent work by him or others in the field of the invention might show the limitation to have been unnecessary. It is to be answered in the negative only when it would be apparent to any reader skilled in the art that a particular descriptive word or phrase used in a claim cannot have been intended by a patentee, who was also skilled in the art, to exclude minor variants which, to the knowledge of both him and the readers to whom the patent was addressed, could have no material effect upon the way in which the invention worked.'*

99. Echoing the same sentiments in ***Glaverbel SA vs. British Coal Corporation {1994 (13) R.P.C. 443}***,

the Patent Court of U.K., elicited the following principles on the question of construction of the patent. The principles laid down are (i) the complete specification, a unilateral document, must be read as a whole in the light of the surrounding circumstances, as at the date of the publication of the specification and with regard to the alleged subsequent infringement; (ii) in reading the specification as a whole

the different functions of the claim and the rest of the specification should be observed, although the claims are construed in the context of a specification as a whole, it is not permissible to restrict, expand or amend the clear language of a claim by reference to a limitation or gloss in the language used in the earlier part of the specification; (iii) the Court should read and construe the specification objectively through the eyes of the person to whom it is addressed and to whom common general knowledge is imputed; (iv) the specification should be given a purposive construction and not a purely literal one; (v) it is for the Court and not for any witness, however expert to decide the question of construction in accordance with the meaning of the language used.

100. It appears that in U.S., there is a statutory presumption of validity under 35 U.S.C. § 282. But even then the courts in U.S. appear to have exercised caution as seen from the decision of the ***Court of Appeals for the Federal Circuit in Pfizer Inc., Vs. Apotex, Inc.,*** (decided on March 22, 2007). When Apotex filed a new drug application seeking the approval of the Food and Drug Administration to commercially sell Amlodipine besylate tablets (a generic version of Pfizer's drug Norvasc)) before the expiry of Pfizer's Patent, Pfizer filed a suit. Apotex not only denied infringement but also counterclaimed that the patents are invalid for anticipation and obviousness. The District Court rejected the counter claim and found infringement. When Apotex appealed, the Circuit court pointed out that ***a court is never bound by an examiner's finding in an ex parte patent application proceeding.*** The Circuit Court also pointed out that in view of the presumption of validity of a patent in the United States, the patent challenger bears the burden of proving the factual elements of invalidity by clear and convincing evidence. After pointing out that the presumption of validity remains intact and that the burden of proof remains on the challenger through out the litigation, the Court also held

in *Pfizer*, that once a challenger has presented a prima facie case of invalidity, the patentee has the burden of going forward with the rebuttal evidence. After listing out the Graham factors, the Court also held that there is a subsidiary requirement subsumed within the Graham factors to the effect that where all claim limitations are found in a number of prior art references, the burden falls on the challenger of the patent to show by clear and convincing evidence that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention and that the skilled artisan would have had a reasonable expectation of success in doing so.

101. But, in so far as India is concerned, even the certificate of registration contains a stipulation that the validity of the patent is not guaranteed. Therefore, it is clear that it is not enough for the plaintiff in a suit for infringement of patent, just to produce the certificate of registration and pray for the grant of remedy. As I have earlier pointed out, the certificate of registration itself (Ex.P.1) contains a stipulation that the validity of the patent is not guaranteed by the certificate. This is why the plaintiff has let in evidence. But, the question to be considered is as to whether the evidence let in by the plaintiff is sufficient to prove the three fundamental requirements namely (i) novelty; (ii) non obviousness; and (iii) usefulness.

102. In ***Mariappan Vs. A.R.Safiullah [2008 (5) CTC 97]***, a Division Bench of this Court held that after its amendment with effect from 20.5.2003, Section 48 of the Patents Act, 1970 conferred a right upon the patentee to have some weight on the basis of registration. But, it does not mean that a presumption as to the validity of the patent was created. The Division Bench made it clear that there is no presumption of validity of patent, even after the amendment of Section 48. Therefore, let me see if the plaintiff's patent passes the triple tests of novelty, no-obviousness and usefulness.

NOVELTY :

103. The first ingredient for invention is novelty, whether it be a product or process. As observed by **Cotton,L.J.** in **Blakey & Co. Vs. Lathem & Co., [1889 (6) RPC 184 (CA)]**, "to be new in the patent sense, the novelty must be shown in the invention". It is not enough that the purpose is new or that there is novelty in the application, so that the article produced is in that sense new. There must be novelty in the mode of application.

104. When an application for registration of a patent is filed, the Controller of Patents examines the application on the basis of (i) teachings; (ii) specifications; and (iii) claims with reference to certain parameters including anticipation. The expressions "teachings", "claims" and "specifications" are not defined in the Act. But, under Section 7(4) of the Act, every application for the grant of a patent should be accompanied by a provisional or a complete specification. The procedure for filing such specifications is prescribed in Section 9. Section 10, which lists out the contents of specifications, requires under Sub-Section (4) that every complete specification should (i) describe the invention, its operation/use and the method by which it is to be performed; (ii) disclose the best method of performing the invention; (iii) end up with a claim or claims defining the scope of invention, for which, protection is claimed; and (iv) be accompanied by an abstract to provide technical information on the invention. The requirements of Sections 7(4) read with 10(4) are what are known in simple terms as (i) teachings; (ii) specifications; and (iii) claims.

105. Rule 13 of the Patent Rules, 2003 requires every application for the grant of a patent submitted in Form-1 to be accompanied by a provisional/complete specification in Form-2. As part of Form-2, the applicant should submit his "claims" regarding the

invention. Once an application for the grant of a patent, containing complete specifications incorporating the claims and technical information is submitted and it is found to be complete in all respects, the application is examined by the Examiner in terms of Section 13, for finding out whether the invention, as claimed in the claim of the complete specification has been anticipated by publication. Though Section 13(1) statutorily obliges the Examiner to make an investigation into the question of anticipation by publication, Sub-Section (4) makes it clear that the examination and investigation will not be deemed in any way to warrant the validity of any patent.

106. Though Section 13(1) refers repeatedly to "anticipation", the expression "anticipation" is not defined in the Act. But, Chapter VI containing Sections 29 to 32 deals with anticipation by previous publication. Here again, there is an element of confusion. Sections 29 to 32 do not stipulate as to what constitutes anticipation by publication. Rather, these Sections merely point out as to what would not constitute anticipation. While Section 29 indicates what is not anticipation by previous publication, Section 30 indicates that a mere communication of the invention to the Government may not constitute anticipation. Similarly, Section 31 indicates as to when a public display would not constitute anticipation and Section 32 indicates when the public working of a patent would not constitute anticipation.

107. But, there is a clue in the definition of the expression "new invention" found in Section 2(1)(l) as to how one could understand the term "anticipation". The definition of the expression "new invention" under Section 2(1)(l) is as follows :

*"'New Invention' means 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 has not fallen in public*

*domain or that it does not form part of the state of the art."*

108. Therefore, one has to understand anticipation by publication to mean that the subject matter had either fallen in the public domain or had become part of the state of the art. But, what we understand by anticipation by publication in view of what is stated in Section 2(1)(l) is further fine-tuned or circumscribed by the exclusions indicated in Sections 29 to 32.

109. Keeping the above in mind, let me now see the tests developed by judicial precedents over the years as to how one could judge the novelty.

110. In one of the earliest cases that came up before the U.S. Supreme Court in ***Magowan vs. New York Belting and Packing Co. {141 US 332 (1891)}***, it was indicated that to be an inventive step, the claimant should have supplied what was obviously wanting and not simply the display of the expected skill of the calling. It should exhibit the creative work of inventive faculty and not simply the exercise of the ordinary faculties of reasoning upon the materials supplied by a special knowledge and the facility of manipulation which results from its habitual and intelligent practice.

111. In ***McClain vs. Ortmayer {141 US 419 (1891)}***, the U.S. Supreme Court was concerned with a patent claim for a pad for horse collars. The Court held that if the patentee chooses to describe and claim only a part, he is presumed to have abandoned the residue to the public and that the ***object of the patent law in requiring the patentee to particularly point out his claim, is not merely to secure to him all that he is entitled, but to appraise the public of what is still open to them. The claim is the measure of his right to relief.*** In fact, the U.S. Supreme Court held in that case that the curved hook of the defendant is not an infringement of the double spring described in the plaintiff's specification and claim. An interesting passage in the

said judgment reads as follows:-

*"What shall be construed as invention within the meaning of the patent laws has been made the subject of a great amount of discussion in the authorities, and a large number of cases, particularly in the more recent volumes of reports, turn solely upon the question of novelty. By some, "invention" is described as the contriving or constructing of that which had not before existed, and by another, giving a construction to the patent law, as "the finding out, contriving, devising, or creating something new and useful, which did not exist before, by an operation of the intellect." To say that the act of invention is the production of something new and useful does not solve the difficulty of giving an accurate definition, since the question of what is new, as distinguished from that which is a colorable variation of what is old, is usually the very question in issue. To say that it involves an operation of the intellect, is a product of intuition, or of something akin to genius, as distinguished from mere mechanical skill, draws one somewhat nearer to an appreciation of the true distinction, but it does not adequately express the idea. The truth is, the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case, we may be able to say that there is present invention of a very high order. In another, we can see that there is lacking that impalpable something which distinguishes invention from simple mechanical skill. Courts, adopting fixed principles as a guide, have by a process of exclusion determined that certain variations in old devices do or do not involve invention, but whether the variation relied upon in a particular case is anything more than ordinary*

*mechanical skill is a question which cannot be answered by applying the test of any general definition."*

112. In **C & A Potts & Co. Vs. Creager et al (155 US 597)**, that came up before the U.S. Supreme court, the products in question were a clay disintegrator and an improvement over the same. Stating that the often-recurring question, which had taxed the ingenuity of courts ever since the passage of Patents Act is as to what an invention really is, the Court pointed out that a patentee is entitled to every use which his invention is susceptible, whether such use be known or unknown to him. But, when a person who has taken this device makes improvements thereon and adapts it to a different industry, he may also draw to himself, the quality of the inventor. Listing out instances of this nature, the Court pointed out as follows :

*"If, for instance, a person were to take a coffee mill and patent it as a mill for grinding spices, the double use would be too manifest for serious argument. So, too, this Court has denied invention to one who applied the principle of an ice-cream freezer to the preservation of fish (Brown v. Piper, 91 U.S. 37); to another who changed the proportions of a refrigerator in such manner as to utilise the descending instead of the ascending current of cold air (Roberts v. Ryer, 91 U.S. 150); to another who employed an old and well-known method of attaching car trucks to the forward truck of a locomotive engine (Pennsylvania R. Co. v. Locomotive Engine Safety Truck Co., 110 U.S. 490, 4 Sup. Ct. 220); and to still another who placed a dredging screw at the stem instead of the stern of a steamboat (Atlantic Works v. Brady, 107 U.S. 192, 2 Sup. Ct. 225). In Trucker v. Spalding, 13 Wall. 453, the patent covered the use of movable teeth in saws and saw plates. A prior patent exhibited cutters of the same general form as the saw teeth of the other patent, attachable to a circular disk, and removable as in the other, for the purpose of which patent was for the cutting of tongues and grooves, mortises, etc. The court held that if what it actually did was in its nature the*

*same as sawing, and its structure and action suggested to the mind of an ordinarily skillful mechanic this double use, to which it could be adapted without material change, then such adaptation to a new use was not new invention, and was not patentable.*

*Upon the other hand, we have recently upheld a patent to one who took a torsional spring, such as had been previously used in clocks, doors, and other articles of domestic furniture, and applied it to telegraph instruments, the application being shown to be wholly new. Electric Co. v. La Rue, 139 U.S. 601, 11 Sup. Ct. 670. So, also, in Crane v. Price, Webster, Pat. Cas. 409, the use of anthracite coal in smelting iron ore was held to be a good invention, in as much as it produced a better article of iron at a less expense, although bituminous coal had been previously used for the same purpose. See, also, Steiner v. Heald, 6 Exch. 607.*

*Indeed, it often requires as acute a perception of the relations between cause and effect, and as much of the peculiar intuitive genius which is a characteristic of great inventors, to grasp the idea that a device used in one art may be made available in another, as would be necessary to create the device de novo. And this is not the less true if, after the thing has been done, it appears to the ordinary mind so simple as to excite wonder that it was not thought of before. The apparent simplicity of a new device often leads an inexperienced person to think that it would have occurred to any one familiar with the subject; but the decisive answer is that, with dozens and perhaps hundreds of others laboring in the same field, it had never occurred to any one before. The practiced eye of an ordinary mechanic may be safely trusted to see what ought to be apparent to every one. As was said by Mr. Justice Bradely in Loom Co. V. Higgins, 105 U.S. 580, 591 : 'Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit. It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination an arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention'."*

Eventually, the U.S. Supreme Court summarised the position to the effect that "*If the new use be so nearly analogous to the former one that the applicability of the device to its new use would occur to a person of ordinary mechanical skill, it is only a case of double use.*"

113. In ***Diamond Rubber Co. Vs. Consolidated Tyre Co. [220 US 428 (1911)]***, the United States Supreme Court held that where a device possesses such amount of change from the prior art, as to receive approval of the patent office, it is entitled to the presumption of invention. It was held therein that "***law regards a change as a novelty and the acceptance and utility of the change as further evidence, even as a demonstration of novelty***". An invention may even be the successor of all that went before and a step only in the march of improvement. The Court indicated that ***many things seem obvious after they have been done and that in the light of an accomplished result, it is often a matter of wonder, how they so long eluded the search of the discoverer and set at defiance, the speculations of inventive genius***. Summarising the opinion of the Court, Justice Mc Kenna pointed out that "***knowledge after the event is always easy and that problems once solved present no difficulties.***" After the problems are resolved, they may even give a signal as though such problems never existed. Therefore, in so far as the case on hand is concerned, the fact that prosthesis was already known in prior art, does not by itself disentitle the plaintiff to claim novelty. In other words, it may not be open to the defendants to contend that the product of the plaintiff was merely a successor of all that was already available in prior art and that therefore, he is not entitled to establish novelty.

114. In ***Concrete Appliances Co. Vs. Gomery [269 US 177 (1925)]***, the

validity of a claim for patent in respect of a combination of apparatus designed for transferring wet concrete or other plastic materials from a source of supply to working points on a building or other structure in course of construction, came up for consideration. The Supreme Court of the United States applied the test "progressive adaptation" developed in ***Hollister Vs Benedict Manufacturing Co. [113 US 59]*** and held that progressive adaptation of well known devices to new but similar uses is nothing but the display of expected skill of the calling and involves only the exercise of ordinary faculties of reasoning upon the materials supplied by a special knowledge and the facility of manipulation, which results from its habitual and intelligent practice. Therefore, if what the plaintiff claims in this case is only a progressive adaptation of the existing devices, the same would not qualify as a new invention, in view of the fact that the ultimate product is nothing but the display of the expected skill of the calling.

115. In ***Pope Appliance Corporation vs. Spanish River Pulp and Paper Mills Ltd {AIR 1929 Privy Council 38}***, the House of Lords indicated the test to determine infringement. A simple test is whether anticipation solved the problem solved by the patent attacked. As to what constitutes an invention, the Privy Council said as follows:-

*"After all, what is invention? It is finding out something which has not been found out by other people. This Pope in the present patent did. He found out that the paper would so stick, and the practical problem was solved. The learned Judges below say that all this might have been done by anyone who experimented with "doctors" and air blasts already know. That is that someone else might have hit upon the invention. There are many instances in various branches of science of independent investigators making the same discovery. That does not prevent the one who first applies and gets a patent*

*from having a good patent, for a patent represents a quid pro quo. The quid to the patentee is the monopoly; the quo is that he presents to the public the knowledge which they have not got. That knowledge the other inventor has kept sealed in his own breast, and he therefore cannot complain that his rival got the patent. And if this is the case when a person can show that he actually made the discovery, surely that is a much stronger case than the present, when the objector does not say that he did discover, but only that if he had experimented he would have discovered. The real invention often may be and is just the last element of the combination. In his address last September to the British Association, Sir William Bragg described how the location of the German guns was discovered. The problem was to find out the exact moment at which the wind puff caused by the explosion arrived at the British lines. It was known that a wire electrically heated would if even slightly cooled show a changed resistance. Would a gun puff cool it? To an officer listening to the whistling noise which the gun puffs made in the fissures of his tent it occurred that it might. It was tried and it did, on which Sir William says:*

*"It may be the last little adjustment that turns the scale, and the last step is the one that counts".*

116. In **Cuno Engineering Corp. Vs. Automatic Devices Corp. [314 US 84 (1941)]**, claims for improvements in lighters (commonly used in automobiles) for cigars, cigarettes and pipes were held invalid for want of invention on the ground that a mere addition to the wireless or cordless lighter of a thermostatic control, was not invention, but a mere exercise of the skill of the calling and an advance plainly indicated by the prior art. The Court held that the new device, even if it performs a new and useful function, must reveal the flash of creative genius, not merely the skill of the calling. Even if

ingenuity was required to effect the adaptation, it cannot become an invention if it was no more than that to be expected of a mechanic skilled in the art. Cautioning that the heavy hand of tribute be not laid on each slight technological advance in an art, the Court quoted the opinion of Mr.Justice Bradley in *Atlantic Works Vs. Brady* (107 US 192), on the consequences of the alternative course, as follows :

*"Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement and gather its firm in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country without contributing anything to the real advancement of the art. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to law suits and vexatious accountings for profits made in good faith."*

Before 1952, invention or an exercise of the inventive faculty was long regarded, as an absolute pre-requisite to patentability, by judicial test. But, in the interest of uniformity and definiteness, the Congress articulated the requirement in a statute, by incorporating Section 103 in the Patent Act, 1952. This requirement was termed as non obviousness and the scope of Section 103 was considered in detail in *Graham Vs. John Deere Co.* [383 US. 1 (1966)]. In other words, the test of "flash of genius" was replaced by the test of non obviousness, about which, I shall deal with later.

117. In **A. & P. Tea Co. Vs. Supermarket Corp. [340 US 147]** decided way back in 1950 by the U.S. Supreme Court, a device known as cashier's counter equipped with a three sided frame or rack, with no top or bottom, which when pushed or pulled, will move groceries deposited within it by a customer, to the checking clerk and leave them there when it is pushed back to repeat the operation, was the subject matter of an

invention, on which patent claims were made. The District Court and the Court of Appeals sustained the validity of the patent claims. Interestingly, the District Court found each element in the device to be known to prior art, but yet it held that the conception of a counter with an extension to receive a bottomless self loading tray, was decidedly a novel feature and hence constituted a new and useful combination. For considering the correctness of the decisions of both the courts below, the U.S. Supreme Court framed an important question for consideration namely as to what indicia of invention should the courts seek in a case where nothing tangible is new and invention, if it existed at all, is only in bringing old elements together ? While answering this question, the U.S. Supreme Court pointed out the following :

- (i) the key to patentability of a mechanical device that brings old factors into cooperation, is the presence or lack of invention;
- (ii) in course of time, the profession came to employ the term "combination" to imply its presence and the term "aggregation" to signify its absence, thus making antonyms in legal art of words, which in ordinary speech are more nearly synonyms.
- (iii) the concept of invention is inherently elusive when applied to a combination of old elements.
- (iv) the mere aggregation of a number of old parts or elements, which in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them is not patentable invention.
- (v) the conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts, is the accumulation of old devices patentable.
- (vi) though in chemistry or electronics, elements take on some new quality or

function, when brought into concert, it is not the case with mechanics.

(vii) Courts should scrutinise combination of patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old patents. The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained, when on the contrary, their effect is to subtract from former resources freely available to skilled artisans.

(viii) a patent for a combination, which only unites old elements with no change in their respective functions, obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.

(ix) a patentee, who has added nothing to the total stock of knowledge, but has merely brought together, segments of prior art and claims them in congregation as a monopoly, cannot sustain his claim.

On the above principles, the Supreme Court reversed the decisions of both the courts below.

118. In ***Anderson's Black Rock Inc. Vs. Pavement Co. [369 US 57 (1969)]***, the Court was concerned with a case where an action for infringement of a patent for "Means for Treating Bituminous Pavement" was brought before court. The patent sought to solve the problem of a cold joint on blacktop paving by combining known elements, a radiant-heat burner, a spreader and a tamper and screed, on one chassis. The Court of first instance held the patent invalid on the ground that the inventor had merely constructed known elements in the prior art on a single chassis. But, the Court of Appeals reversed and the matter was taken to the Supreme Court. Two things were agreed on facts namely (a) that the patentee had combined four elements which were known in the prior art and (b) that the presence of a radiant heat burner was a distinctive feature of

the patent. Though the Court found that the combination of putting the burner together with the other elements in one machine, was a matter of great convenience, the Court refused to accept that it produced a new or different function. Ultimately, the Court held that though the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant heat burner already patented and that something more than mere commercial success was needed for holding it to be an invention. The Court pointed out that even if a combination of elements results in an effect greater than the sum of the several effects taken separately, a synergistic result ought to have been produced, to make it patentable. The Court also held that even if the combination filled a long felt need and enjoyed commercial success, it will not make it patentable, unless there was an invention. Quoting from *Graham*, the U.S. Supreme Court indicated that Congress may not authorise the issuance of patents, whose effects are to remove existence knowledge from the public domain or to restrict free access to materials already available.

119. In ***Raj Parkash vs. Mangat Ram Choudhary {AIR 1978 Delhi 1}***, a Division Bench of the Delhi High Court pointed out that 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 and the claim for anticipation by the defendant had to be either by prior user or by prior publication.

120. In ***Monsanto Vs. Merck & Co. Inc. [2000 RPC 709]***, the English Patents Court was concerned with an infringement action brought forth by the manufacturer of a new class of non steroidal anti inflammatory drug that could also have low gastric irritancy. The defendant denied infringement and also challenged the validity on grounds of anticipation, obviousness, insufficiency and added matter. Following the decision in

**General Tire & Rubber Co. Vs. Firestone Tyre & Rubber Co. [1972 RPC 457]**, the Patents Court held that for a claim to be anticipated, the prior disclosure must contain a clear description of something or clear and unambiguous directions to do or make something that would infringe the claim, if carried out after the grant of the patents. The Court pointed out "**a sign post, however clear, upon the road to the patentee's invention will not suffice. The prior inventor must be clearly shown to have planted his flag at the precise destination before the patentee.**"

121. In **Dhanpat Seth Vs. Nil Kumar Plastic Creates Limited [2008 (36) PTC 123 (HP)(DB)]**, the right to patent in respect of a device developed for manual hauling of agricultural produce came up for consideration. It was found that the patented device was an improvement over a local product known as Kulta made of bamboos by the hill tribes. Therefore, the Court held that it was already known to the trade.

122. In **Asian Electronics Limited vs. Havells India Limited {2010 (6) R.A.J. 589 (Delhi)}**, the plaintiff was granted patent in respect of a conversion kit to change the fluorescent lighting units inductive operation into electronics operation. Pending suit for a permanent injunction and for damages, the plaintiff sought an interim injunction. While dismissing the application for temporary injunction, the Delhi High Court took note of Section 3(d) of the Act and held that in the absence of an explanation as to how the new product had any significant improvement in function or efficiency, it had to be held that the patent was hit by anticipation. The Delhi High Court further indicated, following the decision in *British Celanese Ltd vs. Courtaultds {1935 (52) R.P.C. 171}*, that **a mere placing of old integers side by side, so that each performs its own proper function independently of any of the others is not a patentable combination.**

123. In **TVS Motor Company Limited vs. Bajaj Auto Limited {2009 (6)**

**R.A.J. 184 (Mad.)},** a Division Bench of this Court held that there can be no infringement if the opponent has proved the same result by a different combination of different elements. The Court also pointed out that the patent specification should be read by a person skilled in the relevant art, but their construction is for the Court. In construing an allegation of infringement, what is to be seen is whether the alleged infringement has taken the substance of the invention ignoring the fact as to omission of certain parts or addition of certain parts.

124. From an analysis of the various principles evolved by courts over a period of time, it can be safely concluded that sometimes a mere addition of various factors was considered by courts to have no novelty. But, sometimes, a combination of existing factors, as distinct and different from a mere aggregation of several things, was looked at with favour. Keeping these principles in mind, if we have a look at the case on hand, it could be seen that though a Custom Mega Prosthesis cannot be said to be a completely new product, it represented the next stage in the development of the device as a sophisticated one. But, the rotating hinge mechanism and the thrust bearing pad, which form essential components of the plaintiff's product are claimed to be unique, novel and an inventive step. Though the defendants have claimed that the rotating hinge mechanism was already in existence, the defendants do not speak about the thrust bearing pad or even a combination of rotating hinge mechanism and thrust bearing pad. The combination of these two, are not mere additions, which produce no result, such as addition of bicycles and cars. The plaintiff has claimed that the combination (not aggregation) of rotating hinge mechanism and thrust bearing pad has resulted in (i) biocompatibility; (ii) flexibility; and (iii) comfort. In other words, a patient, into whose body, the plaintiff's device is planted, is said to have the flexibility of the limb as merely as

possible to its original nature. This aspect is not questioned or challenged by the defendants. Therefore, I am of the view that the plaintiff's product certainly has novelty. Hence, let me now move over to the next test namely that of non obviousness.

NON OBVIOUSNESS :

125. As pointed out by the United States Court of Appeals for the Federal Circuit in *DyStar*, obviousness is a complicated subject requiring sophisticated analysis and no single case lays down all facets of the legal test. There is danger inherent in focussing on isolated dicta rather than gleaning the law of a particular area from careful reading of the full text of a group of related precedents, for all they say that is dispositive and for what they hold. When parties do not engage in such careful, candid and complete legal analysis, much confusion about the law arises and through time can be compounded.

126. If we have a careful look at the history of the development of the law of patents, it could be seen that until the advent of Section 103 of the Patent Act of 1952 (USA), there were only two statutory requirements namely that of novelty and utility under the 1790 Act as well as 1836 Act. But, ***Earle Vs. Sawyer [8 F.CAS.254 (1825)]***, was perhaps the first reported patent case where the U.S. Supreme Court used the word "obvious". The Circuit Judge Story denied a motion for a new trial, after the Jury found the plaintiff's patent valid and infringed, rejecting the defendant's contention that the substitution of a circular saw for a perpendicular saw was "so obvious to mechanics". After rejecting the contention that the 1793 Act required the Court to undertake a mode of reasoning upon the metaphysical nature or the abstract definition of an invention, the Court pointed out that "if it is new, if it is useful, if it has not been known or used before, it constitutes an invention". But, this approach was rejected in ***Hotchkiss Vs Greenwood [52 US 248 (1850)]*** where the Supreme Court introduced an additional

requirement namely that the invention should also be non obvious. This decision in *Hotchkiss* actually sowed the seeds for the standard of non obviousness. Scholars consider *Hotchkiss* to be an important milestone for three reasons namely (a) that it was only in *Hotchkiss* that the Supreme Court formally disagreed with the notion that novelty and utility are sufficient; (b) that it was *Hotchkiss* which spoke about the subjectivity inherent in evaluating an invention popularly known as hindsight; and (c) that it was this case that demonstrated the underlying reason, which affects the decision whether a particular invention is patentable or not. *It was held in Hotchkiss that "[U]nless more ingenuity and skill . . . were required . . . than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skillful mechanic, not that of the inventor."*

127. After the introduction of the standard of non obviousness in *Hotchkiss*, the Court introduced the test of "inventive genius" to determine non obviousness, in ***Reckendorfer Vs. Faber [92 US 347 (1875)]***. Then came the decision in ***C & A Potts & Co. Vs. Creager [155 US 597 (1895)]***, which highlighted the importance of secondary factors such as commercial success in determining non obviousness. But, from 1930 to 1952, the trend of invalidating a lot of patents, surfaced in the U.S. Supreme Court. It was during this period that the Court developed the test of "flash of creative genius" in the year 1941 in *Cuno Engineering Corp. Vs. Automatic*, by holding that a "flash of creative genius" should be present in the device.

128. After *Cuno Engineering Corp.* came the decision in ***Good Year Tyre and Rubber Co. Inc. Vs. Ray-O-Vac [321 US 275 (1944)]***. In the said case, the Court was concerned with the validity and infringement of a patent claim for a leak proof dry

cell for a flash light battery. Admittedly, the claim was in respect of a patent, which was a very narrow one in a crowded art, as dry cells had been in use in flash lights for many years. While affirming the concurrent findings of the Courts below, holding the patent to be valid and infringed, the Supreme Court pointed out that the means adopted by the patentee may appear simple, when viewed after the event (after the invention). Post event, they may appear obvious to those who worked in the field, but it was not enough to negative the invention. But, the Court came to this conclusion in view of the fact that for over half a century, the use of flash light batteries increased enormously, despite which no manufacturer devised a method of curing the defects that were felt for a long time.

129. Articulating what the Court would expect in such cases, the Supreme Court observed in ***Great Atlantic and Pacific Tea Co. Vs. Supermarket Equipment Corp. 340 U.S. 147 (1950)*** that "the invention must serve the ends of science .... to push back the frontiers of chemistry, physics and the like; to make a distinctive contribution to scientific knowledge". In this case, the Supreme Court struck down a patent for an invention that was a combination of a rack type device for collecting and moving groceries at the counter of a supermarket.

130. Since non obviousness was developed by Courts as an additional requirement not traceable to the statute, there was no uniform standard. This gave rise to lot of anomalies and hence, the Congress thought fit to codify the requirement of non obviousness in the statute, while bringing the new enactment in 1952.

131. After the new enactment in 1952, came an important decision. It was in ***Graham Vs. John Deere Co., 383 US 1, 13-14 (1966)***. The factual inquiries underlying the question of obviousness, were developed in *Graham*. In *Graham*, the U.S.

Supreme Court was concerned with the patentability of a device designed to absorb shock from plow shanks in rocky soil to prevent damage to the plow. The device was only a combination of old mechanical devices. In 1955, the Fifth Circuit held the patent valid, on the ground that the combination produced an old result in a cheaper and otherwise more advantageous way. But, in 1964, the Eighth Circuit held the patent to be invalid on the ground that there was no new result in the patented combination. There were also two companion cases before the Supreme Court (***Calmar Inc. Vs. Cook Chemical Co. and Colgate Palmolive Co. Vs Cook Chemical Co.***), which concerned the validity of patent claims in respect of finger operated sprayers with a "hold-down" cap of the type commonly seen on grocers' shelves inserted in bottles of insecticides and other liquids prior to shipment. These cases were the first of their kind that came up before the Supreme Court after the advent of the Patent Act of 1952. Therefore, the Supreme Court pointed out that by Section 103 of the Patent Act of 1952, a third statutory dimension namely that of obviousness was added to the two requirements of novelty and utility that had been the sole statutory tests ever since the old Patent Act of 1793. After pointing out that the federal patent power stems from a specific Constitutional provision that authorises the Congress to promote the progress of useful arts, the Court held that "***innovation, advancement and things which add to the sum of useful knowledge are inherent requisites in a patent system for promoting the progress of useful arts.***" But, the Court warned that one must be guarded against hindsight and that the "*motivation-suggesting-teaching*" requirement protects against the entry of hindsight into the obviousness analysis. In other words, the court should resist the temptation to read into the prior art, the teachings of the invention in issue. The court defined "*motivation-suggesting-teaching*" test as one in which the court should ask "whether a person of

ordinary skill in the art, possessed with the understanding and knowledge reflected in the prior art and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.

132. In *Graham*, the Court outlined a ***four-factor test*** for determining obviousness. They are (i) the Court must determine the scope and content of the prior art; (ii) the Court must ascertain the differences between the prior art and the claims at issue; (iii) the Court must resolve the level of ordinary skill in the pertinent art; and (iv) the Court must evaluate the evidence of secondary considerations, which should include commercial success, a long felt but unmet need for a device and the failure of others to solve the particular problem addressed by the invention in question.

133. In ***Dann vs. Johnston {425 US 219 (1976)}***, the U.S. Supreme Court was concerned with the patentability of a machine system for automatic record keeping of bank cheques and deposits under which cheques and deposits are customer labelled with code categories which are "read" and then processed by a data processor, such as a programmable electronic digital computer, having data storage, files and a control system. The patent examiner rejected the claims of the applicant on the ground that they were anticipated by the prior art. The Patent and Trademark Office Board of Appeals confirmed the said decision on various grounds including obviousness. The applicant went before CCPA, which reversed the decision of the Board in a 3:2 ruling and held the invention to be patentable. While reversing the decision of Court of Customs and Patents Appeal, the U.S. Supreme Court pointed out that "***as a judicial test, invention, that is the exercise of the inventive faculty, has long been regarded as an absolute pre-requisite to patentability and that it was only in 1952 that the Congress, in the interest of uniformity and definiteness articulated the requirement in a***

**statute, framing it as the requirement of non-obviousness in Section 103".** The Court further pointed out that as per the decision in *Graham*, Section 103 (of the U.S. Act of 1952), was not intended to change the general level of patentable invention, but was meant merely as a codification of judicial precedents. The Court also held that **the criterion of obviousness is measured not in terms of what would be obvious to a lay man, but rather what would be obvious to one reasonably skilled in the art.**

134. Another test for determining non obviousness, which had held the field for several decades is the "**teaching-suggestion-motivation" test**". After the advent of the 1952 Patent Act, the Courts initially developed only the suggestions test. But, **In Rinehart, Re.**, the test of teachings was indicated. The "motivation" part of the test was later developed **In Helin, Re.** In **A.C.S.Hospital Systems, Inc. Vs Montefiore Hospital [732 F.2d 1572 (Fed.Cir. 1984)]**, the Court combined all the three and held that "**obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination**". The Court was convinced that without applying the TSM test, **Courts would fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher**. The Court felt that TSM test is the best test to avoid hindsight bias.

135. In **Alza Corporation Vs Mylan Laboratories, Inc. {464 F. 3d. 1286 (Fed.Circuit 2006)}**, the United States Court of Appeals for the Federal Circuit, was concerned with the validity of a claim made by the appellant in respect of a drug which they were already marketing and the question of infringement of the same, by the respondent, who filed new drug applications for a generic version of the once a day

extended release formulation of the anti incontinence drug by name oxybutynin. While holding the claim to be invalid, the Court of Appeals pointed out that "*a claimed invention is unpatentable, if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art*". The Court of Appeals further enlisted the following underlying factual inquiries, that would enable the court to answer the question of "obviousness" :

- (i) the scope and content of the prior art;
- (ii) the level of ordinary skill in the prior art;
- (iii) the differences between the claimed invention and the prior art;
- (iv) objective evidence of non obviousness.

136. Though scholars believe that the decision in **Graham** did not directly support the TSM test, the Federal Courts continued to apply TSM test for more than two decades until **K.S.R. International Co.** case arrived. But before the arrival of K.S.R., the United States Court of Appeals for the Federal Circuit indicated in **Pfizer, Inc. vs. Apotex, Inc., decided on 22.3.2007**, the development of two principles namely (i) reasonable expectation of success for a skilled artisan and (ii) obvious-to-try. On the first principle, the Court held that obviousness cannot be avoided simply by showing some degree of unpredictability in the art, so long as there was a reasonable predictability of success. The Court indicated that a rule of law equating unpredictability to patentability is not a proper standard. On the second principle, the Court held that to be sure, to have a reasonable expectation of success, one must be motivated to do more than merely to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result where the prior art gave either no indication of which parameters were

critical or no direction as to which of many possible choices is likely to be successful. In fact, the Court pointed out that it is difficult to strike a balance between the seemingly conflicting truisms between the fact that obvious to try is not the proper standard by which to evaluate obviousness and that absolute predictability of success is not required.

137. The courts were clear that good science and useful contributions do not necessarily result in patentability. Courts also developed secondary considerations for determining obviousness. They are (i) commercial success (ii) long felt but unsolved needs (iii) failure of others etc.

138. In **K.S.R. Vs. Teleflex [550 US 398 (2007)]**, K.S.R. patented an adjustable accelerator pedal system for automobiles with cable-actuated throttles. Two years later, Teleflex Inc. obtained exclusive licence to a product, which was described as an adjustable accelerator pedal system for automobiles with electronically actuated throttles that also included an electronic sensor fixed to the pivot of the pedal. When K.S.R. was selected by General Motors to supply adjustable pedal systems and they submitted a design, Teleflex put K.S.R. on notice that its proposal may infringe their patent. It was followed by an infringement case filed by Teleflex. K.S.R. filed a motion for summary judgment of invalidity of the patent of Teleflex on the ground that its design was obvious in the light of prior art in existence. For invalidating the patent, the company applied Graham Framework and TSM test. Accepting them, the District Court granted summary judgment of invalidity of the patent of Teleflex. The Federal Circuit reversed the decision of the District Court, by mainly relying on the TSM test. When the matter was taken to the Supreme Court, the Supreme Court of U.S. granted certiorari on the question as to whether a patent could be held obvious without proven teaching, suggestion or motivation. While reversing the decision of the Federal Court and upholding

the decision of the District Court, the U.S. Supreme Court pointed out that one of the ways in which a patent's subject matter could be proved obvious, was by noting that there existed, at the time of invention a known problem, for which, there was an obvious solution. The Court also pointed out that granting patent protection to advances that would occur in the ordinary course without any real innovation would hinder progress and might deprive prior inventions of their value and utility. More importantly, the Supreme Court held that there was no inconsistency between the idea underlying the TSM test and the Graham analysis. But, the Court cautioned that the general principles cannot be transformed into a rigid rule that limited any enquiry dealing with obviousness. In other words, the TSM test is not meant to supplant a fulsome obviousness analysis.

139. Having seen the development of law in the U.S., from *Earle Vs. Sawyer* of the year 1825, which underwent a drastic change in *Graham* in the year 1966 and which took a leap in *K.S.R International* in 2007, let me now look at the developments that had taken place in England.

140. In ***Bristol-Myers Company (Johnson's) Application [1975 RPC 127]***, the House of Lords was concerned with a patent application that was rejected on the ground of prior use. By a majority decision (3:2), the House of Lords drew ***a distinction between "an accidental prior use" and "a habitual prior use"***. The majority held that prior use, which defeats a patent need not be habitual - one single instance is enough; nor need it be for the purposes of trade, if it is use from which the user derives a practical benefit. The House of Lords pointed out that ***intention to do something is a "chameleon-like concept", which takes its colour from the nature of what it is that is to be done***. Therefore, before considering the question of prior art, the Court should keep in mind that the prior use need not be habitual to defeat a patent.

141. In ***Windsurfing International Inc. Vs. Tabur Marine, Great Britain Limited [1985 RPC 59]***, the plaintiffs claimed patent in a wind propelled vehicle having an unstayed spar connected through a universal joint and a sail attached along one edge to the spar. The defendants resisted the action on the ground that it was obvious in view either of the prior user or of a printed publication. The Patents Court found the claims to be invalid as anticipated by the prior user and obvious in view of a printed publication. But, the Patents Court did not make any findings of obviousness based on prior user. The plaintiffs appealed to the Court of Appeals and the defendants lodged a notice on the question of obviousness over the prior user. The Court of Appeals upheld the claim of obviousness over prior user and held as follows :

*"(1) The philosophy behind obviousness must take into account the same concept as anticipation, namely that it would be wrong to prevent a man from doing something which was merely an obvious extension of what he had been doing or what was known in the art before the priority date..."*

*(3) The question of obviousness was not to be answered by looking with the benefit of hindsight at what was now known and what had been known at the priority date and asking whether the former flowed naturally and obviously from the latter, but by hypothesising what would have been obvious at the priority date to a person skilled in the art who had access to what was known in the art at that date....*

*(5) The man skilled in the art must be assumed to be sufficiently interested to address his mind to the subject and to consider the practical application of the information which he was deemed to have.*

*(6) Answering the question on obviousness required four steps to be taken :*

- (i) identifying the inventive concept embodied in the patent;*
- (ii) imputing to a normally skilled but unimaginative addressee what was common general knowledge in the art at the priority date;*

*(iii) identifying the differences if any between the matter cited and the alleged invention; and*

*(iv) deciding whether those differences, viewed without any knowledge of the alleged invention, constituted steps which would have been obvious to the skilled man or whether they required any degree of invention."*

142. In ***Sabaf SpA vs. MFI Furniture Centres {2005 R.P.C. 10}***, the House of Lords pointed out that two inventions do not become one invention because they are included in the same hardware. The House of Lords gave it the term "Law of Collocations", where a claimed step might involve the combination of two inventions.

143. The test for obviousness laid down by the Court of Appal in *Windsurfing*, which was decided under the 1949 U.K. Act, was adopted to the language of the 1977 Act. Though several cases were decided after *Windsurfing*, one of them is of significance and that was by the Court of Appeal in ***Pozzoli Spa Vs. Bdmo SA and Moulage Industriel De Perseigne SA [2007 EWCA Civ.558]***. In this case, the Court of Appeal stated the principles as follows :

- (i) identify the notional person skilled in the art and identify the relevant common knowledge of that person;
- (ii) identify the inventive concept of the claim in question or if that could not be readily done, construe it;
- (iii) identify what, if any, differences existed between the matter cited as forming part of the state of the art and the inventive concept of the claim;
- (iv) viewed without any knowledge of the alleged invention as claimed, did those differences constitute steps that would have been obvious to the person skilled in the art or did they require any degree of invention.

144. Coming to the Indian scenario, the Indian Supreme Court had an occasion to consider what would constitute an invention or an inventive step in ***Bishwanath Prasad Vs. Hindustan Metal Industries [1979 (2) SCC 511]***. This case was decided under the Patents and Designs Act of 1911, under which, there were only two requirements namely novelty and utility to constitute an invention. After pointing out that in order to be patentable, an improvement on something, which is already known, should be something more than a mere workshop improvement, the Court pointed out that it must independently satisfy the test of invention or an inventive step. It must produce a new result or a new article or a better and cheaper article than before. ***Mere collocation of more than one integers or things not involving the exercise of any inventive faculty, would not qualify for the grant of a patent.***

145. If we carefully look at the tests adopted by the Supreme Court *Bishwanath Prasad*, we may see that the said case arose under the 1911 Act, which was replaced by the later 1970 Act. The 1970 Act itself had undergone significant changes, under the Patents (Amendment) Act, 2005, with a view to meet India's obligations under TRIPS. Therefore, it is essential to take a wholesome approach, in view of the developments upto 2005.

146. Keeping the above principles in mind, if we look at the case on hand, it is seen that Distal Femoral prosthesis is a device, which is already in existence. There is no doubt that the contribution of the plaintiff is certainly an improvement over the existing device. Therefore, what is required to be considered is whether or not the improvement made by the plaintiff is only a workshop improvement that is so obvious to a person skilled in the art. I must also remember that while attempting to find an answer to this question, I must cautiously remove the hindsight bias, if any, in the sense that today, the

improvement made by the plaintiff may be so obvious to any one that it could have been obvious even at the time of adoption of such a step by the plaintiff.

147. According to the plaintiff, the unique features of his product are (i) use of polymer components as journal bearings, which tend to reduce the normal wear and tear by more than 90% and give smooth and free articulation of the joints; (ii) use of rotating hinge mechanism, which allows a constrained radical freedom between two bones and reduces to a large extent, the stress in the bones and joints due to asymmetric loading in the normal course of functioning; (iii) the use of extending mechanism that enables the prosthesis to expand in-situ after surgery to compensate the growth of symmetric bone in the other limb; (iv) the use of pivotal hinge and thrust bearing pad mechanisms, which provide friction free articulation.

148. Though the defendants contend (i) that the use of polymer component is not an invention, but what is recommended for surgical application is only Ultra High Molecular Weight Poly Ethylene; (ii) that the rotating hinge mechanism was originally developed in 1980s by M/s.Howmedica, USA; and (iii) that the use of pivotal hinge is a standard concept, the defendants have not produced any evidence to establish these.

149. What is worse is that DW1 contradicted himself seriously on the first aspect. In paragraph 7(i) of the proof affidavit of PW1, he claimed that his product contained several unique features, one of which was the use of polymer components as journal bearings. In paragraph 20 of his proof affidavit, DW1 claimed that the use of polymer component is not an invention and that what was recommended was UHMWPE, which was a time tested bio material. But, during cross examination, DW1 stated that the non metallic white portion in the middle of MO1 was made up of UHMWPE and that it was a polymer. Therefore, it is clear that DW1 did not even know whether what was used in

MO1 was actually a polymer or UHMWPE.

150. Therefore, it is clear that the defendants did not know the nature of the improvements made by the plaintiff to the existing stock of knowledge. The defendants did not also establish that the improvements claimed to have been made by the plaintiff were anticipated by prior art or at least that they represented what was so obvious to a person skilled in the art. Not a scrap of paper was produced to show that any other company has already used such distinctive features as claimed by the plaintiff. Therefore, I am of the view that the plaintiff's product would also pass the test of non obviousness.

UTILITY/INDUSTRIAL APPLICATION :

151. Now, let me move on to the third test namely that of utility.

152. Utility/industrial application has always been one of the requirements for patentability of a product. This was recognised by the Supreme Court in *Bishwanath Prasad*. The usefulness of an invention is to be judged with reference to the state of things at the date of filing of the patent application. If the invention was useful at that time, the fact that subsequent improvements made it obsolete would not be of any concern.

153. Keeping the above principles in mind, if we have a look at the plaint, it can be seen that according to the plaintiff, the pivotal hinge mechanism with a bio-compatible polymer journal bearing, imparts friction free articulating motion of the new joint. Consequently, a maximum flexion of about 140 degree to the dorsal side of the prosthesis is achieved. The plaintiff has claimed that the durability of the implant is increased by the thrust bearing pad mechanism which reduces the frictional wear between the metallic surfaces and by relocating the load transmitted to the pivot pin and the tibial component on weight bearing. He also claims that the rotating axis mechanism

decreases the stress at the bone implant junction.

154. In other words, the plaintiff has listed out various functional uses and the usefulness of his invention in graphic details in the plaint. These claims made in paragraph 12 of the plaint are not denied by the first defendant in their written statement. In paragraph 9 of their written statement, the first defendant has simply stated that they have no knowledge as to the correctness of the claims so made by the plaintiff in paragraph 12 of the plaint. Therefore, I have to conclude that the claim of the plaintiff with regard to utility/usefulness of his invention, has gone unchallenged. Even the written statement of defendants 2 and 3 do not contain a challenge to these claims of the plaintiff.

155. However, the fourth defendant, in paragraph 19 of their written statement, has dealt with the claims of the plaintiff in paragraph 12 of the plaint. But, they have not denied the usefulness/utility of the invention of the plaintiff. All that the fourth defendant has stated in paragraph 19 of their written statement is that the distal femoral prosthesis and the proximal tibial prosthesis have been in existence for a longtime. Therefore, it is clear that the usefulness of the plaintiff's product is not challenged by the defendants. On the contrary, the utility value of the product is established by the information provided in the book published by the co-patentee, who is himself an Orthopaedic-Surgeon of repute. Hence, the product of the plaintiff also passes the third test, namely that of utility/industrial application.

156. In view of the above, I hold on issue No.10 that the patents registered in favour of the plaintiff along with his co-patentee, qualify as valid patents, fulfilling the requirements of novelty, non obviousness and usefulness.

ISSUE Nos.1 to 3:

157. Issue Nos.1 to 3 deal with the entitlement of the plaintiff to a decree for permanent injunction restraining the defendants from infringing patent Nos.196333, 198872 and 198869. But as I have pointed out in paragraph 65, the area of dispute is now confined only to the product, whose patent number is 196333, which corresponds to design No.191946. Therefore, the answer to these 3 issues viz., whether the plaintiff is entitled to a decree of permanent injunction in respect of 3 patents, has to be considered in two parts. The first would relate to patent Nos.198872 and 198869. The second would relate to patent No.196333.

158. In so far as patent Nos.198872 and 198869 are concerned, the admission made by the first defendant in paragraph 3 of their written statement is recorded and I hold that it is sufficient to record on issue Nos.1 to 3 that the first defendant is not engaged in manufacturing products covered by patent Nos.198872 and 198869.

159. Coming to patent No.196333, the question of infringement has to be decided primarily with respect to two questions viz., (i) whether the first defendant is engaged in the manufacturing, making or use of a prosthesis that is identical to the registered patent of the plaintiff and (ii) whether the same tantamounts to an infringement.

160. In paragraph 8 of the written statement, the first defendant has given a chart indicating the special features of the plaintiff's product and the features of the first defendant's prosthesis. The tabular column can be usefully extracted as follows:-

<i>S.No.</i>	<i>Features of Plaintiff's CMP</i>	<i>Features of first defendant's Hinged Knee Prosthesis</i>
I	Polymer Component as Journal Bearing	No Polymer Component, in general
II	Rotating hinged mechanism	No Rotating hinged mechanism, in general
III	Use of extending mechanism for femoral piece	No such mechanism for femoral piece
IV	Assembled condylar Head and Femoral	Condylar Head and Femoral Stem is of

<b>S.No.</b>	<b><i>Features of Plaintiff's CMP</i></b>	<b><i>Features of first defendant's Hinged Knee Prosthesis</i></b>
	Stem Fixed with 2 screws and 2 washers i.e., 6 parts being used to make one assembly.	Monolithic design (single piece) manufactured as an integral part through a special forging process, in order to ensure superior strength and metallurgical reliability.
V	Use of pivotal hinge and thrust bearing mechanism	Joint has to be hinged using hinge pin, no thrust bearing pad in general.
VI	Straight Tibial Stem	Tibial stem with bend to 5 to 7 degree. To match the anatomy of Tibial Bone.
VII	No locking provision at the end of Tibial Stem.	Locking hole provided to facilitate locking of the nail on cortex of bone using a locking bolt to prevent rotation in the bone cavity.

161. The distinguishing features that the first defendant has pleaded in its written statement, have not been challenged by the plaintiff by filing any reply to the written statement.

162. In the course of evidence, PW-1 has stated, in paragraph 20 of the proof affidavit, that he only reliably learnt that the defendants 1 to 4 were making, using, exercising, selling and distributing the patented CMP, thus infringing the monopoly rights. In other words, the entire claim of the plaintiff is based upon what he "reliably learnt" and not what he actually saw. In fact, after stating in paragraph 20 that it had reliably come to his knowledge that the defendants were infringing his patent rights, the plaintiff, as PW-1, has spoken about the cease and desist notice in paragraph 21 of the proof affidavit. In paragraph 22, he has spoken about the reply given by the first defendant, calling for information and the rejoinder issued by the plaintiff. In paragraph 23 of the proof affidavit, the plaintiff speaks about the fact that the first defendant had not obtained any registration with regard to any prosthesis under any patent. After stating so, the plaintiff, as PW-1, has jumped to a conclusion, in paragraph 24, that there was infringement. The relevant portion of paragraph 24 of the proof affidavit of PW01 is as

follows:-

*"From all that has been stated supra, it will be evident that all the essential features of the patented knee joint prosthesis, in particular "DFP", have been used in the infringing apparatus and the infringing apparatus is the absolute replica of the patented prosthesis."*

163. From paragraphs 1 to 23, of the proof affidavit, there is no reference to the actual physical examination of the prosthesis manufactured by the first defendant and a comparison of the features between the products of both.

164. During the cross-examination of the counsel for the second and third defendants, one question was put to PW-1 namely as to whether he had seen the product used by defendants 2 and 3, as referred to in Ex.P-11. PW-1 stated that he had not seen the product. It is only from the report and the sketches that the plaintiff came to the conclusion that the second and third defendants were also infringing his patents.

165. The Officer of the first defendant, who was examined as DW-1, produced a prosthesis manufactured by the first defendant as MO-2. He is a Mechanical Engineer by qualification and he stated that he is acquainted with the manufacture of Bio-Medical products like prosthesis. He claimed that the prosthesis manufactured by the plaintiff and the prosthesis manufactured by the first defendant, do not have one-to-one similarity.

166. DW-1 was extensively cross-examined by the counsel for the plaintiff. During cross-examination, DW-1 admitted that MO-2 is also a distal femoral prosthesis and that it is manufactured of Titanium Alloy.

167. During cross-examination, DW-1 dismantled MO-1 manufactured by the plaintiff. After dismantling, the counsel for the plaintiff asked DW-1 whether the dismantled parts of MO-1 tallied with Figure-3 in Ex.P-2, which contained the exploded

view of MO-1. But DW-1 replied that there were some differences. The differences pointed out by DW-1 between the dismantled parts of MO-1 and the parts shown in Figure-3 of Ex.P-2, are as follows:-

*"In Figure-3 of Ex.P-2, there is a component identified as No.14. It is not found in MO-1. The component indicated as item No.5 in Figure 3 of Ex.P-2 is shown to be a single piece. But in MO-1, it consists of two pieces, one metallic and one polymer. All the other components in Figure 3 of Ex.P-2 are found in MO-1. Item No.13 in Figure 3 of Ex.P-2 comprises of two screws. Item No.14 which I earlier said to be not there, are only two washers for Item No.13, which are two screws. Component No.5 comprises of two parts in MO-1, while it is shown in Figure 3 of Ex.P-2 as one single part."*

168. Thereafter, the counsel for the plaintiff asked DW-1 to dismantle MO-2. Accordingly, it was dismantled by DW-1. Thereafter the learned counsel for the plaintiff cross-examined DW-1 on the nature of the component parts of MO-2. The upper portion of MO-2 after dismantling was identified by DW-1 as distal femoral piece, though the counsel for the plaintiff claimed it as condylar component and femoral shaft. Similarly, he identified the distal femoral piece in MO-1, but stated that in MO-1, it is a combination of six parts together with washers rather than a single part and that they are given serial Nos.1, 3, 3A, 13 and 14 in Figure-3 of Ex.P-2. But in MO-2, it is a straight piece. MO-1 has a valgus angle piece for left limb and a grooved collar near the stem, which is not there in MO-2. He also pointed out that in MO-1, there are 3 longitudinal grooves in the stem which are not there in MO-2. Similarly, DW-1 pointed out that the contour of the gaps between the two condyles is different in MO-1 and MO-2.

169. When the lower part of MO-2 was shown by the counsel for the plaintiff to

DW-1, he agreed that it was a tibial component. After identifying the tibial component in MO-1, which was shown at No.4 in Figure-3 of Ex.P-2, the witness stated that there are differences between the tibial components of MO-1 and MO-2 and that in MO-1, the tibial stem is straight whereas in MO-2 it is tilted at an angle. Similarly, in MO-1, there are longitudinal grooves on the stem for the purpose of locking. But in MO-2, the grooves are not there. However, a hole is provided for locking with a stem.

170. The learned counsel for the plaintiff then proceeded to cross-examine DW-1 on one component which acted as the connecting link between the tibial component and the distal femoral piece in MO-1 and MO-2. After identifying the said component, DW-1 again pointed out the difference between them. While in MO-1, the oval shape plate with a grooved portion was in the middle with protrusions on both sides to hold what is slid in between, there were no such protrusions in MO-2. Similarly, the locking holes on both MO-1 and MO-2 were different. There was also a difference in the cylindrical projecting pin. In fact, DW-1 admitted that MO-1 contained a better feature in so far as the polymer pad is concerned.

171. The learned counsel for the plaintiff then focussed attention on the UHMWPE in MO-1 and MO-2 and questioned DW-1 as to whether there were any functional differences. DW-1 pointed out that in MO-1, the horse shoe shaped polymer pad is slid into the grooves of the link component and held tightly by the clip shaped protrusions. But in MO-2, the pad is thrust from the top without anything to hold it tightly. Therefore, the movement in MO-2 is from the top to the bottom. Here again, DW-1 conceded that the pad in MO-1 is superior to the one used in MO-2.

172. The focus then shifted to the hinge pin in both MO-1 and MO-2. DW-1 replied that the hinge pin in MO-1 is different from the hinge pin in MO-2. While the hinge pin in

MO-2 is a solid one which had two slots on both ends, the hinge pin in MO-1 is a hollow one. PW-1 also agreed that the function of the hinge pin in MO-1 is to bear the load.

173. When questioned, DW-1 agreed that MO-2 was manufactured for a specific patient in 2006 at the instance of the fourth defendant and it was not supplied in view of the notice received from the plaintiff. He also conceded that the supply was stopped since it was found that there were some similarities between both products, both functionally and by shape.

174. More importantly, DW-1 stated two things which are of great significance viz., (i) that though the first defendant is a Defence Organisation not engaged in the business of manufacturing prosthesis, they undertook this as corporate social responsibility in view of the fact that most of the applications handled by the first defendant are used only for destructive purposes; and (ii) that the first defendant manufactured a total of only 4 prosthesis of the type MO-2, out of which 3 had already been supplied to patients. The first defendant is not actually manufacturing a stereo type of prosthesis, but are manufacturing different types. After having said this, DW-1 denied the suggestion made by the counsel for the plaintiff that they manufactured MO-2 after dismantling MO-1 and by adopting a process of reverse engineering.

175. Therefore, on a careful consideration of the evidence let in by the plaintiff and the evidence let in by the first defendant, the following inferences become inevitable:-

- (i) that apart from producing a project report of a student/Research Assistant at the Sathyabama Institute of Science and Technology (Ex.P-13) and providing a comparative chart with sketches as Ex.P-62, the plaintiff could not produce any evidence to show actual infringement by the first defendant or by any other defendants;
- (ii) that on the contrary, the first defendant adopted a very fair and reasonable

approach by producing the prosthesis manufactured by them as MO-2 and by dismantling through DW-1 both MO-1 and MO-2 and demonstrating the distinguishing features of both. Therefore, all that the plaintiff has been able to establish is only his suspicion that the first defendant might be infringing is patent. But the air of suspicion is cleared by DW-1 by producing their own prosthesis, dismantling the same, pointing out the differences and by showing that they were not competitors in the industry to the plaintiff. The first defendant is admittedly a Defence Organisation involved in completely different type of business. They are not competitors to the plaintiff in the business of manufacture of prosthesis. The claim of the first defendant that they charge patients on cost-to-cost basis and that they manufacture this as part of corporate social responsibility, is not challenged by the plaintiff. Therefore, I am of the view that the factum of infringement of patent has not been established clearly by the plaintiff.

176. In **Rodi and Wienenberger AG vs. Henry Snowell Ltd {1969 (12) RPC 367}**, the House of Lords indicated that there could be two types of infringement viz., (i) direct infringement which is otherwise known as textual infringement; and (ii) indirect infringement which is otherwise understood as infringement in substance. In the case on hand, there is no textual infringement, in view of the dissimilarities pointed out by DW-1 during cross-examination. Therefore, all that the plaintiff can claim is that there was an infringement in substance. But what constitutes an infringement in substance was articulated in **Birmingham Sound Reproducers Ltd v Collaro Ltd {(1956) RPC 232 (CA)}**, as follows:-

*"The question therefore appears to be whether the allegedly infringing apparatus consists of substantially the same parts acting upon each other in substantially the same way as the apparatus claimed as constituting the invention. It is not*

*enough to find that the parts comprised in the defendants' apparatus individually or collectively perform substantially similar functions to those performed individually or collectively by the parts comprised in the apparatus claimed as the plaintiffs' invention, or that the defendants' apparatus produces the same result as the plaintiffs' apparatus. It must be shown that the defendants' selection and arrangement of parts is substantially the same as the plaintiffs' selection and arrangements of parts, for it is in such selection and arrangement that the plaintiffs' invention resides."*

177. Section 271(c) of the U.S. Patent {Patent Act 35 U.S.C.} speaks of contributory infringement. Under the said provision, whoever offers for sale or sells a component of a patented machine, manufacture, combination or composition or a material or apparatus for use in practicing a patented process constituting a material part of the invention, shall be liable as a contributory infringer. In fact, prior to the 1952 Patent Act (U.S.), the statute did not define contributory infringement. Therefore, it was only by judicial precedents that infringement was divided into two categories viz., (i) direct infringement and (ii) contributory infringement. But the 1952 Act, divided the judicially created category of contributory infringement into two statutory sub-sections viz., Section 271(b) dealing with inducement of infringement and Section 271(c) speaking of contributory infringement.

178. But in the case on hand, even the test of indirect infringement as articulated in *Birmingham* and reaffirmed in *Rodi*, cannot be applied for one simple reason. It is admitted by the plaintiff that distal femoral prosthesis itself is not his invention. The plaintiff also admits that there are various types of prosthesis available in the market for the past more than five decades. The fact that there are various types of prosthesis

available in the market and the fact that there has been a stage-by-stage improvement of different types of prosthesis, is a knowledge that is actually in public domain and hence, I can take note of the developments that have taken place in this field for the past five decades.

179. If we look at the history of development of prosthesis it can be seen that till the year 1952, every patient with a primary malignant tumour of musculo skeletal system, had to undergo only an amputation and they had no surgical treatment. The conventional treatment for bone tumours was just surgical removal of the affected part of the body. With the advancement of medical science, the technique of removing only the tumour and saving the limb, which came to be known as Limb Salvage, was developed over the years. The early methods of reconstruction after Limb Salvage, used patient's own bone from another part of the body. But, nothing could be done about the knee motion. (refer the article "Distal Femoral Replacement by Custom Made Prosthesis" by C.R.Bradish and others from the Royal National Orthopaedic Hospital, Stanmore)

180. However, it appears that the replacement of the distal femur and knee joint was first performed at the Royal National Orthopaedic Hospital in 1952 on a 24 year old man suffering from hydatid disease. It appears that clinical aspects of the design and use of CMP were discussed by Scales and others way back in 1965 and then in 1973, 1982 and 1984. Jackson Burrows Wilson and Scales also came up with their own suggestions in 1975 and Sim and Chao did so in 1979 and 1983. Watts made his own contribution in 1983. As a matter of fact, an International Symposium was held, way back on 1985 on Limb Salvage in Musculo Skeletal Oncology. It appears that the first three prosthesis, inserted in 1952, 1954 and 1957 were fixed by extra medullary plates.

181. The first of them was made of acrylic dental polymer, but it failed due to a

combination of medial skin necrosis. Since the prosthesis was too wide, a seizure of the joint was caused by swelling of the nylon axle. Consequently, the limb was amputated. The second prosthesis, according to the paper, was made of cobalt-chromium-molybdenum alloy with fixation by integrally cast slotted plates. It was used for a woman with a giant cell tumour. This prosthesis functioned satisfactorily for 21 years, until fracture of one of the femoral plates necessitated its removal and replacement. The replacement was with intermedullary stemmed prosthesis. The third prosthesis was used for a woman with rheumatoid arthritis. But, the design that was in use at that time necessitated removal of 58 mm of distal femur and proximal tibia. It appears that thereafter, the surgeons started using standard Stanmore knees modified by the addition of an extension femoral shaft and stem. The femoral stem is either bolted or heat shrunk into the shaft. It is D-shaped in cross section. Interestingly, the above paper presented by Bradish and others shows that all prostheses are custom made, with dimensions being determined by measurement from the patient's radiographs. One paragraph from the said paper is of interest and hence, it is reproduced as follows :

*"The standard Stanmore knee replacement is made from a cobalt-chromium-molybdenum alloy whilst extension shaft and stem were at first made from T5 (commercially pure titanium), but following two stem fractures and the realisation that this material was mechanically inadequate, all subsequent stems were made from TA1 (a titanium alloy containing 6% aluminium and 4% vanadium). Patients have routine patch testing, and any who were found to be sensitive to the constituents of Co-Cr-Mo alloy were given prosthesis manufactured entirely from titanium alloy".*

182. The paper also shows that several design modifications were made during the period 1970-78. In 1970, a metal/high density polyethylene hinge was introduced. In 1978, a ceramic coated axle for the titanium alloy prosthesis was introduced. Though I

have collected these details from the article referred to above, their authenticity is not in doubt. This is in view of the fact that the above facts are corroborated even by the contents of the book titled "Custom Mega Prosthesis & Limb Salvage Surgery" authored by Dr.Mayilvahanan Natarajan. This book is marked as Ex.P56 by PW1 himself. In the introductory chapter, Dr.Mayilvahanan Natarajan has traced the history of the dawn of chemotherapy and prosthesis. In Chapter II of Ex.P56, under the title "Review of Literature", Dr.Mayilvahanan Natarajan has referred to Burrows, Wilson and Scales (1975) and to Bradish, Kemp et al (1987) as well as to Ross and Wilson (1987) and Khong, Chao, Sim (1987). This is why I have also chosen to refer to those pioneers in the field.

183. In order to understand the above developments, the pictorial representations of the distal femoral prosthesis, developed stage-by-stage from 1951 onwards, are presented in pictorial form as follows:-



Evolution of the distal femoral endoprosthesis.

**Composite No. 1:** The Waldius knee mechanism, introduced in 1951, had a fixed metal on hinge.

**No. 2** The Spherocentric distal femoral endoprosthesis was developed by Harry Matthews, MD, in 1975 and first implanted in 1977. A metal ball and polyethylene cupola connected the tibial and femoral components.

**No. 3:** The original kinematic rotating-hinge knee was introduced in 1980. The vitallium hollow body was casted by the lost-wax method, and a custom Zickle nail stem was welded to it.

→ **No. 4:** Circumferential porous ingrowth beads were introduced in 1985 to allow for bone incorporation. In reality little bone ingrowth occurred, but protective soft tissue ingrowth did.

**No. 5:** Modularity was introduced in 1988. The condyles and femoral stems were forged and were coupled to titanium segments by Morse taper locks. Since its introduction in 1980 by Peter Walker for Howmedica, the kinematic rotating-hinge knee mechanism has remained virtually unchanged except for a slight increase in the diameter of the axle and the polyethylene bushings. The rotating-hinge knee concept has now been universally adopted as the preferred knee mechanism for distal femoral endoprosthetic reconstructions.

**Source:** "Distal Femoral Resections with Endoprosthetic Replacement",  
By Jeffrey J. Eckardt, Martin M. Malawer, Jacob Bickels, and Piya Kiatisevi  
([http://sarcoma.org/publications/OTOS\\_Book/13282\\_ON-25.pdf](http://sarcoma.org/publications/OTOS_Book/13282_ON-25.pdf))

Picture No.1



Picture No.2

A Guepar prosthesis (simple hinge), which was used in the early 1970s before the development of the rotating-hinge prosthesis.

Source: "Distal Femoral Resections with Endoprosthetic Replacement", by Jeffrey J. Eckardt, Martin M. Malawer, Jacob Bickels, and Piya Kiatisevi ([http://sarcoma.org/publications/OTOS\\_Book/13282\\_ON-25.pdf](http://sarcoma.org/publications/OTOS_Book/13282_ON-25.pdf))



Picture No.3 (Now manufactured by a Pune based company)



Picture No.4

Overall view of M.O.1 and M.O.2

M.O.1



M.O.2



Picture No.5

Overall view of M.O.1 and M.O.2

184. A careful look at the pictures would show that every advancement made to the existing knowledge, was actually slender. I do not know whether these small adjustments and alterations, which offered better flexion and movement to patients, were patented and if patented, whether their validity was tested. But, one thing is clear, namely that every advancement or development, was aimed at making the prosthesis sync with human anatomy, so that it becomes a perfect replacement for the natural bone and knee joint. This is why the defendants set up the plea of obviousness on the ground that these developments were known or at least expected in prior art, for persons skilled in the art. But I rejected that argument with a view to give the benefit of some innovation to the plaintiff. Therefore, as a corollary, the defendants are also entitled to the benefit of the dissimilarities that exist between their prosthesis and the plaintiff's prosthesis.

185. The plaintiff claims that his patent has to be seen with specific reference to the teachings, claims and specifications, which constitute an inventive step or in other words, an advance of technology. Therefore, unless the plaintiff establishes that the distinguishing features of the first defendant's product are so trivial or merely cosmetic, the plaintiff cannot make out a case of infringement. Just as the plaintiff is entitled to every substantial advancement of an existing product and claim that there was an inventive step involved, other people are also entitled to make similar claims.

186. But there is one fundamental difference. The claims as the teachings and specifications that a patentee makes, stand on a different footing than the claims made by another competitor in defence to an action for infringement. While the test for finding out whether there was an inventive step in the product of a patentee, is very rigid, the

test for determining whether there was an infringement of such a right, is not so rigid.

***To put it differently, the distinguishing features of the product of the first defendant as seen from MO-2 may not qualify their product for a valid patent registration. But they will certainly provide a shield for a defendant against an action in infringement.*** In other words, every change made by a defendant in an action for infringement need not necessarily pass the test of inventive step, even to escape liability of infringement.

187. There is one more reason as to why I would accept the distinguishing features pointed out by the first defendant between MO-1 and MO-2, to hold that there was no infringement. Though the superficial appearance of MO-1 and MO-2 is misleading, as can be seen from pictures 4 and 5 in paragraph 183 above, I am obliged to see whether the individual components or the integers that constitute the whole product, also have similarities. This is what the plaintiff himself demands. Therefore, DW1 dismantled both MO-1 and MO-2 and showed, to my naked eye, though not considered to be skilled in the art in question, that these distinguishing features do exist.

188. Actually, the plaintiff had a better chance to convince me that these distinguishing features are very trivial and that there was an "***infringement in substance***". The plaintiff was only one of the two patentees, the other being a very reputed orthopaedic surgeon by name Dr.Mayilvahanan Natarajan. The co-patentee did not show any interest either in joining the plaintiff and seeking reliefs against the defendants, or in coming forward at least to give evidence as a person actually in the field.

189. What is more interesting is that the co-patentee Dr.Mayilvahanan Natarajan has been performing surgeries both for his own patients as well as for the patients of the

defendants 2 to 4 hospitals. The first defendant has stated clearly in their written statement that they had interactions with the co-patentee Dr.Mayilvahanan Natarajan and developed two prosthesis, for the surgeries conducted by the very patients of the co-patentee.

190. If the co-patentee Dr.Mayilvahanan Natarajan himself allowed the first defendant to manufacture prosthesis for the surgeries conducted by him, despite the plaintiff having his own factory for the manufacture of the product, there are two inferences possible. They are: (i) either the co-patentee acquiesced in the infringement of his patent rights by the first defendant, or (ii) the co-patentee who actually had the benefit of seeing the prosthesis manufactured by the first defendant with his own eyes and with his own expertise, was convinced that there were distinguishing features, that kept the case out of the mischief of infringement.

191. The plaintiff filed the affidavit of the co-patentee Dr.Mayilvahanan Natarajan as Ex.P64. I have already indicated in paragraphs 21 to 28, the extent to which this affidavit could be relied upon. The co-patentee's assertion in Ex.P64 that there was infringement, cannot be accepted as he did not offer to be a witness. If he had come to the witness box, I would have had the benefit of his cross examination by the defendants, to see whether there were such striking similarities between the two products, as to constitute infringement. This is why I indicated in paragraph 28 that his affidavit Ex.P64 can be accepted only for the limited purpose of showing that he had no conflict of interest with the co-patentee, namely the plaintiff.

192. Once it is clear that every prosthesis, the oldest of which came into existence in 1951-1952, was only an advancement, stage-by-stage, the first defendant is entitled to the same benefit as the plaintiff has had. As a matter of fact, the first defendant is not

seeking the very same benefit as the plaintiff has sought. This is seen from the following 3 factors:

(i) The modifications made by the plaintiff to the then existing prosthesis, is patented by the plaintiff. The first defendant is not even seeking a patent right, but merely pointing out that they were also entitled to make modifications on the basic features of a product in existence for five decades.

(ii) While the very business of the plaintiff is to manufacture and sell prosthesis, the business of the first defendant is completely different. There is no serious dispute about the fact that the manufacture and supply of distal femoral prosthesis by the first defendant, is on a cost-to-cost basis, undertaken as part of their Corporate Social Responsibility. This is why the plaintiff's product is priced at Rs.1,36,000/-, while the first defendant's product is priced at Rs.39,200/-.

(iii) At least in two aspects, DW1 conceded that MO-1 manufactured by the plaintiff had better features. Despite this knowledge, the first defendant did not make a slavish re-production of the patented product. Therefore, it is clear that there was neither an intention nor a desire on the part of the first defendant to commit infringement of the registered patent of the plaintiff. The first defendant does not stand to benefit out of such infringement, as they are not in this business.

193. I will be failing in my duty if I do not point out one important aspect about the conduct of the first defendant. I have already noted that the plaintiff could not produce any evidence to prove actual infringement, but produced some material only to show suspicion of a possible infringement. The defendants did not take advantage of this. The first defendant produced MO-2 and established the distinguishing features, despite not being called upon through any notice to produce the same.

194. In view of the above, I hold on Issue Nos.1 to 3 that the plaintiff has failed to establish infringement of their patent No.196333. The distinguishing features pointed out by the first defendant in their written statement as well as in evidence and also demonstrated before me by dismantling MO-1 and MO-2, convince me that there is no infringement. Hence, Issue Nos.1 to 3 are to be answered against the plaintiff.

195. One argument advanced by Mr.N.L.Rajah, learned counsel appearing for the fourth defendant is that the prosthesis, in respect of which, the plaintiff is claiming patent protection, is actually a drug and that therefore, the principles behind the provisions of Section 83(d) and (g) of the Patents Act, 1970 are to be taken note of. In support of his contention that the prosthesis in question is a drug, the learned counsel relies upon a decision of the Supreme Court in ***Chimanlal Jagjivandas Sheth Vs. State of Maharashtra [AIR 1963 SC 665]***.

196. Since I have recorded a finding that the plaintiff has not established infringement, it may not be necessary for me to consider whether the prosthesis in question is a drug or not. However, I shall proceed to test the said argument, in view of the fact that it is a legal issue.

197. As I have indicated elsewhere, the Patents Act, 1970, is divided into 23 Chapters. Chapter XVI containing Sections 82 to 98, deal with the "*working of patents, compulsory licences and revocation*". Section 83, which is found in Chapter XVI states that while exercising powers under Chapter XVI, due regard should be had to certain general considerations, which are listed out in Clauses (a) to (g) therein. Section 83(d) and (g) read as follows :

*"83. General Principles applicable to working of patented inventions :-*

*Without prejudice to the other provisions contained in this Act, in*

*exercising the powers conferred by this Chapter, regard shall be had to the following general considerations, namely:-*

.....

*(d) that patents granted do not impede protection of public health and nutrition and should act as instrument to promote public interest specifically in sectors of vital importance for socio-economic and technological development of India;*

.....

*(g) that patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public."*

198. In *Chimanlal Jagjivandas Sheth*, the Supreme Court took note of the definition of the word "drug" appearing in Section 3(b) of the Drugs Act, 1940 and held that the definition is comprehensive enough to take in, not only medicines, but also substances intended to be used for or in the treatment of diseases of human beings or animals. The Court held that the artificial definition introduced a distinction between medicines and substances, which are not medicines strictly so called. Therefore, the Supreme Court came to the conclusion in the said case that absorbent cotton wool, roller bandages, gauze and other things, used during surgery would fall within the definition of drug.

199. But, as rightly contended by Mr.M.Sundar, learned counsel for the plaintiff, even if prosthesis happens to be a drug, the prescriptions contained in Clauses (d) and (g) of Section 83 are intended to be applied only while exercising the powers under Chapter XVI for compulsory licences. Today, no one has applied under Section 84(1) to the Controller for the grant of compulsory licences for the prosthesis, for which, the plaintiff has obtained a patent. ***The question of application of the provisions of Section 83 would come only when any person interested had filed an***

**application for compulsory licensing under Section 84(1). Section 83 is very specific to the effect that the general considerations indicated in Clauses (a) to (g) therein are to be applied only while exercising the powers conferred by Chapter XVI.** The case on hand falls under Chapter XVIII, to which, those considerations do not apply. Therefore, the argument that the patent in question is a drug and that therefore, public health considerations should play a vital role, while adjudicating the dispute, is of no relevance.

200. On the same issue, Mr.V.Chandrakanthan, learned counsel for the first defendant relied upon the decision of a Division Bench of the Delhi High Court in **F.Hoffmann LA Roche Limited Vs. Cipla Limited [2009 (40) PTC 125 (Del.)(DB)].** From paragraphs 76 to 83 of the said decision, a Division Bench of the Delhi High Court considered the effect of Section 83(g) and also considered the question of public interest in low cost general drugs. According to the defendants, the prosthesis manufactured by the first defendant, as part of Corporate Social Responsibility, is priced at nearly one third (1/3rd) of the price charged by the plaintiff. It appears that the price of the prosthesis sold by the plaintiff is about Rs.1,36,000/-, while the price charged by the first defendant is about Rs.39,200/-. Therefore, it is contended that this Court should take note of public interest before adjudicating upon the questions raised.

201. In **Bayer Corporation vs. Union of India {2010 (6) R.A.J. 103 (Delhi)},** a Division Bench of the Delhi High Court quoted from an article written by Sean A.Pager on the title "Patent on a Shoestring:making patent protection work for developing countries", about the complexity of factors that should be taken into account. The article quoted by the Division Bench of the Delhi High Court highlighted that top 10 industrialised countries accounted for 94% of patents granted worldwide and hence the

benefits of patent protection are heavily skewed.

202. However, I am unable to sustain the objection raised by the learned counsel for the first defendant. The decision of the Division Bench of the Delhi High Court arose out of the rejection of an application for interim injunction pending suit. Therefore, the question of public interest as propounded in Section 83(g) was taken into account as part of the "balance of convenience consideration". But, now, I am dealing with a suit after trial. Even if I hold that the plaintiff is entitled to a decree of declaration and injunction as prayed for, it would not preclude any of the defendants as "persons interested" to approach the Controller under Section 84(1) for the grant of compulsory licence. In fact, the defendants could have done this even during the pendency of this suit. The Division Bench of the Delhi High Court did not take into account the fact that the general considerations indicated in Section 83 are applicable only for the exercise of the powers conferred by Chapter XVI.

203. Therefore, I hold on Issue Nos.1 to 3 that the plaintiff has failed to establish infringement of their patent No.196333. Insofar as the other two patents are concerned, the defendants have made an assertion that they are not manufacturing the same and hence, the question of adjudication of Issues 1 to 3 does not arise, in respect of the other two patents.

**ISSUE No.5:**

204. The fifth issue is as to whether the plaintiff is entitled for permanent injunction restraining the defendants from in any way making, manufacturing, using, selling, offering for sale, marketing or advertising with regard to any prosthesis or any variation thereof by using or utilising the plaintiff's design Nos.191946, 189140 and 204684.

205. The plaintiff has filed as Exx.P-7, P-8 and P-9, the Certificates of Registration of Designs Nos.191946, 189140 and 204684. The Certificate of Registration of Design No.191946 dated 24.4.2003 shows that it was in respect of the application of the design to custom prosthesis. The Certificate of Registration pertaining to Design No.189140 is in respect of the application of design to prosthetic articles. The third certificate relating to design No.204684 is in respect of the application of design to prosthetic article proximal tibial prosthesis.

206. All the 3 Certificates of Registration have been issued jointly in the names of Professor Dr.Mayilvahanan Natarajan and M.C.Jayasingh. All the 3 Certificates indicate that the product in respect of which the designs were registered, fall under Class 24-03.

207. Under Section 6(1) of the Designs Act, 2000, a design may be registered in respect of any or all of the articles comprised in a prescribed class of articles. Rule 10 of Designs Rules 2001 stipulates that for the purpose of registration of designs, articles shall be classified as specified in The Third Schedule. The Third Schedule under the Designs Rules 2001, contains the list of classes and sub-classes with Explanatory Notes. Class 24 deals with "medical and laboratory equipment". This Class 24 contains 5 sub-classes, one of which is 24-03, which relates to prosthetic articles.

208. Exx.P-7, P-8 and P-9 contain as annexures, the Representation of the prosthesis manufactured by the plaintiff, with their shape and configuration being projected from the front view, back view, right side view and left side view. The shape and configuration of the designs relating to each of the Certificates filed as Exx.P-7, P-8 and P-9 have been marked respectively as Exx.P-7A, P-8A and P-9A.

209. A careful look at Exx.P-7A, P-8A and P-9A would show that the plaintiff claims novelty in the "shape and configuration" of the product. This is also reiterated by the

plaintiff in paragraph 13 of the plaint, wherein he has claimed that the novelty of the design lies in their shape and configuration.

210. In so far as the averment of the plaintiff in paragraph 13 of his plaint with respect to the design and its novelty is concerned, the first defendant has stated in paragraph 9 of their written statement that they have no knowledge about the correctness of the details. The defendants 2 and 3 in their written statement have simply said that they are not concerned with the allegations in paragraph 13 of the plaint. In so far as the fourth defendant is concerned, they have simply stated in paragraph 21 of their written statement that the plaintiff is put to strict proof of the averments in paragraph 13. Therefore, it is clear that the validity of the 3 registered designs of the plaintiff are not challenged by the defendants in their written statement.

211. In a suit for injunction, damages and the like, for the infringement of a registered design, the defendants are at liberty, by virtue of section 22 (3), to raise every ground on which the registration of a design may be cancelled under Section 19, as a ground of defence. Therefore, it is contended by Mr.M.Sundar, learned counsel for the plaintiff that inasmuch as the defendants have not taken advantage of the gateway available under Section 22(3), the defendants are not entitled to question the validity of the design.

212. Before considering the said contention, it is necessary to have a look at the scheme of the Designs Act, 2000. The Patents and Designs Act, 1911 was a composite enactment that took care of both patents and designs. Immediately after India attained independence, a Patents Enquiry Committee was constituted to review the working of the Patent Law in India. The Committee submitted its report in 1950. Thereafter, the Patents Bill 1953, based largely upon the U.K. Patents Act, 1949 was introduced in the Lok Sabha

in December 1953. But the Bill lapsed on the dissolution of the first Lok Sabha.

213. Thereafter, a second Committee was constituted in 1957 which submitted a report in September 1959. On the basis of those recommendations, the Patents Bill 1965 was introduced in the Lok Sabha in September 1965. It was referred to a Joint Committee. The Joint Committee submitted a report suggesting lot of amendments. The Bill was again re-presented to the Lok Sabha, but it lapsed for a second time, with the dissolution of the third Lok Sabha in March 1967.

214. Eventually, the Patents Bill 1970 was moved and the same came into effect in April 1972. By Section 162(1) of the Patents Act, 1970, the Indian Patents and Designs Act, 1911 was repealed only in so far as it related to patents. Consequently, the 1911 Act continued to govern the law relating to designs for a period of nearly 89 years, until the advent of the Designs Act, 2000.

215. Therefore, if we have a look at the Statement of Objects and Reasons, it is seen that the object of the Designs Act, 2000 was to ensure effective protection of registered designs and at the same time to promote the design activity in order to promote the design element in an article of production. It is stated in the Objects and Reasons that the Designs Act, was essentially ***aimed to balance both the interests and to ensure that the law did not unnecessarily extend the protection beyond what is necessary to create the required incentive for design activity while removing the impediments to the free use of the available designs.***

216. Interestingly, what is actually conferred by the The Designs Act, is a copyright in the registered design. The Act defines both a copyright and a design. Copyright is defined in Section 2(c) to mean "the exclusive right to apply a design to any article in any class in which the design is registered". The expression design is defined under Section

2(d) as follows:-

*"(d) 'design' means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of Section 2 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) {now see the Trade Marks Act, 1999 (47 of 1999)} or property mark as defined in Section 479 of the Indian Penal Code (45 of 1860) or any artistic mark as defined in clause (c) of Section 2 of the Copyright Act, 1957 (14 of 1957)."*

217. Since the definitions of both the expressions "copyright" and "design" speak about the application of certain features to an "article", we must also take note of the definition of the expression "article", appearing in Section 2(a) as follows:-

*"(a) 'article' means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately."*

218. Therefore, it is clear from Section 2(d) that **to constitute a design, it should have the features of shape, configuration, pattern, ornament or composition of lines or colours. Those features could be applied to any article in two dimensional or three dimensional or in both forms by any industrial process or means, whether manual, mechanical or chemical. But eventually,**

**these features applied to any finished article, should appeal to and be judged solely by the eye.**

219. Section 2(d) specifically excludes two things from the definition of the expression "design". They are (i) any mode or principle of construction or anything which is in substance a mere mechanical device and (ii) any trade mark or property mark or any artistic work. In other words, the right conferred by the Designs Act is as to the application of the features such as shape, configuration, pattern, ornament or composition of lines or colours to any article, which is not a mere mechanical device or a trade mark in an artistic work. This is why, what exists in a design is actually a copyright in that design. This is made clear by Section 22(1) of the Designs Act, 2000.

220. Section 22(1) of the Designs Act, 2000, reads as follows:-

**"22. Piracy of registered design.**---(1) During the existence of copyright in any design it shall not be lawful for any person--

(a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or

(b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or

(c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of

*the registered proprietor, to publish or expose or cause to be published or exposed for sale that article."*

221. According to the plaintiff, the first defendant is guilty of applying to the prosthesis manufactured by them, the registered design of the plaintiff, for the purpose of sale. Therefore, the plaintiff claims that the first defendant is doing something unlawful as per Section 22(1)(a). Similarly, it is the plaintiff's contention that the other defendants are exposing for sale, the prosthesis manufactured by the first defendant, thereby committing what is declared as unlawful under Section 22(1)(c).

222. Section 4 of the Designs Act, 2000, prohibits the registration of a design, (i) if it is not new or original (ii) if it had been disclosed to the public by publication in tangible form or by use in any way prior to the filing date (iii) if it is not significantly distinguishable from known designs or combination of known designs and (iv) if it comprises or contains scandalous or obscene matter. Once a design is registered, Section 11(1) confers a copyright in the design, for a period of 10 years from the date of registration. But the period can be extended by 5 years under Section 11(2) if an application for extension is made before the expiry of 10 years.

223. The registration of a design can be cancelled at any time, at the instance of any person interested, on any of the following grounds viz.,:-

- (i) that the design has been previously registered in India;
- (ii) that it has been published in India or in any other country prior to the date of registration;
- (iii) that the design is not a new or original design;
- (iv) that the design is not registerable under the Act; and
- (v) that it is not a design as defined in Section 2(d).

224. A comparison of Sections 4 and 19 would disclose that at least two grounds are common to both of them. They are (i) novelty and originality and (ii) disclosure in prior art. Therefore, it is clear that these two requirements are very fundamental to the existence of a copyright in the registered design. It may be of interest to note that while the Patents Act, 1970, gives a clear indication under Section 48, of the rights conferred upon the patentee, the Designs Act, 2000, does not contain a similar prescription, indicating the rights conferred upon the registered proprietor of a design. Section 11(1) of the Designs Act, merely indicates that the registered proprietor of a design, shall have copyright in the design, subject to the provisions of the Act. Section 2(c) defines copyright as "the exclusive right to apply a design to any article in any class in which the design is registered". But by virtue of Section 11(1), the copyright so conferred, is subject to the provisions of the Act.

225. Interestingly, Section 11(1) of the Act, confers a copyright in the registered design, upon the "**registered proprietor of the design**". Though the expression "design" is already defined in Section 2(d), the statute also defines the phrase "proprietor of a new or original design", in Section 2(j). Section 2(j) of the Designs Act, 2000, reads as follows:-

**"(j) 'proprietor of a new or original design',---**

*(i) where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed;*

*(ii) where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and*

*(iii) in any other case, means the author of the design; and where the property in or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person."*

Since the registration of a design which is not new or original is prohibited by virtue of Section 4, I do not know why the phrase "proprietor of a new or original design" should be defined at all, in Section 2(j), especially when Section 11 also talks only about "registered proprietor of the design" and not about the "registered proprietor of a new or original design".

226. One of the important provisions of the Act that should be taken note of, before we proceed further, is sub-section (2) of Section 22, which reads as follows:-

*"(2) If any person acts in contravention of this section, he shall be liable for every contravention---*

*(a) to pay to the registered proprietor of the design a sum not exceeding twenty-five thousand rupees recoverable as a contract debt, or*

*(b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly:*

*Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed fifty thousand rupees:*

*Provided further that no suit or any other proceeding for relief under this sub-section shall be instituted in any Court below the Court of District Judge."*

227. Another comparison between the Patents Act, 1970 and the Designs Act, 2000, may also be seen. The Patents Act, 1970, lists out (i) the rights of patentees under Section 48; (ii) the power of Court to make a declaration as to non-infringement under

Section 105; (iii) the power of Court to grant relief in cases of groundless threats of infringement proceedings under Section 106; (iv) defences in suits for infringement under Section 107; (v) acts which do not constitute infringement under Section 107-A; (vi) reliefs in suits for infringement under Section 108; and (vii) restriction on power of Court to grant damages or accounts of profit for infringement. Thus, the Patents Act, 1970, is very exhaustive, inasmuch as it covers all areas such as the rights of the proprietor, the remedies available to him, the defence available to the opposite party and the parameters on which a Court can grant or refuse relief.

228. But unfortunately, the Designs Act, 2000, is very hollow. It merely confers a copyright on the registered proprietor of a design, to have the exclusive right to apply it to any article, subject to the other provisions of the Act. The remedies available to the registered proprietor, in the case of piracy, the defence available to the opposite party in such cases and the nature of the reliefs that could be granted by the Court, are all indicated in a confusing manner in one provision viz., Section 22. More particularly, the area of coverage in sub-section (2) of Section 22 is much less than the area of confusion.

229. As a matter of fact, I had an occasion to consider the effect of Section 22 (2) in ***Greaves Cotton vs. Autus Motors Private Limited (A.Nos.3097 to 3099 of 2007 in O.A.No.293 of 2007 in C.S 216 of 2007 dated 7.11.2007)***. In the said case, it was argued that under Section 22(2), the maximum that a Court could do, is to award compensation in a sum not exceeding Rs.25,000/- for every contravention subject to a maximum of Rs.50,000/- for one design. While rejecting the said contention, I held as follows:-

*"Section 22(2)(a) and the proviso contained thereunder, is not to be construed as a license for contravening the*

*provisions of the Act, prescribing a License Fee of Rs.50,000/- for getting away with the contravention. If such an interpretation is accepted, it would lead to absurd consequences. A person, who deliberately contravenes Section 22(1), will be emboldened to continue merrily with such contravention, if such an interpretation is accepted, since the only consequence that would befall upon him for all the contraventions put together in respect of one design, is to pay a total sum of Rs.50,000/-. Instead of discouraging infringement, the interpretation advanced by defendants 1 and 4 would encourage infringement.*

*28. Be that as it may, it is seen that the language employed in clause (a) and clause (b) as well as the proviso under Section 22(2), by itself, contains an answer to the contention of the defendants 1 and 4. Section 22(2)(a) merely prescribes the liability of a person acting in contravention of Section 22(1), to pay to the registered proprietor of a design, a sum not exceeding Rs.25,000/-, recoverable as a "contract debt". In contrast, Section 22(2)(b) entitles the proprietor of a design, to two kinds of reliefs viz., (i) an injunction against repetition of the contravention and (ii) for recovery of damages. Thus, Section 22(2)(b) uses the word "damages". In order to avoid any confusion with regard to the scope and ambit of clauses (a) and (b), the first proviso makes it clear that the total sum recoverable in respect of any one design under clause (a) shall not exceed Rs.50,000/-. In other words, the restriction under the proviso, is only in respect of the money recoverable as a "contract debt" under clause (a). The proviso does not restrict the quantum of damages that can be awarded under clause (b).*

*29. Therefore, if a person comes to Court seeking relief under Section 22(2)(a), for recovery of money prescribed*

*therein, the quantum of money that could be awarded to him, is restricted to Rs.50,000/- under the proviso. But if a person seeks damages, it is covered by Section 22(2)(b) and the quantum of damages that could be awarded to him, is not restricted by the proviso."*

230. In **Dunlop Rubber Co. Ltd vs. Golf Ball Developments Ltd {1931 RPC (Vol. XLVIII No.7) 268}**, Farwell, J., of the High Court of Justice - Chancery Division summarised the law as follows:-

- (a) Design means only the feature of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye;
- (b) Therefore, there are two things viz., (i) it is the finished article which is the thing to be looked at in order to see how the design appeals to the eye; and (ii) the test of the design is the eye and eye alone;
- (c) The phrase, "eye" in the Statute means eye of the Court because the Court has ultimately to determine these questions. However, the Court is entitled to be assisted and instructed by evidence, so that when it applies its eye to the test, it may have a mind to direct its eye which is instructed by the proper evidence;
- (d) Such instructions may certainly be given by persons who are competent to do it with regard to the prior art;
- (e) The Court is not entitled to listen to evidence of gentlemen, however they may be in the game.

231. In the aforesaid case, the learned Judge agreed with the counsel for the plaintiffs that the registered design as well as the alleged infringing design were similar.

But the learned Judge found that the outstanding salient features of both were not one and the same. Therefore, the learned Judge held that if a design has in it a striking feature which catches and holds the eyes and which is the one thing that strikes the eye when one looks at the design, a design which otherwise may be like a registered design, but it eliminates the striking feature or alters it so that it is not recognisable, in such a case, it is impossible to say that one is an imitation of the other.

232. In that case, the Court also drew a distinction between a fraudulent imitation and an obvious imitation. An obvious imitation is one which, when looked at, struck one at once as being so like the original design, the registered design as to be almost unmistakable. An obvious imitation is something very close to the original, with the resemblance being immediately apparent to the eye looking at the two. In contrast, the word "fraudulent" presupposes a knowledge of the registered design. Therefore, a fraudulent imitation is an imitation based upon and deliberately based upon the registered design. Such an imitation may be less apparent than the obvious imitation, with a subtle distinction from the original. Therefore, the Court held in that case that though fraudulent imitation may be different in some respects from the original and may render it not obviously an imitation, may yet be an imitation, perceptible when the two designs are closely scanned. Therefore, Mr.M.Sundar, learned counsel for the plaintiff contended that the product manufactured by the first defendant and used by the other defendants, was a fraudulent imitation of the registered design.

233. In ***Microfibres Inc. vs. Girdhar & Co. {2009 (6) R.A.J. 106 (Delhi)}***, a Division Bench of the Delhi High Court pointed out, quoting from *Interlego A.G. vs. Tyco Industries Inc.,{(1988) R.P.C. 343}*, that the primary concern in a case of infringement of design is what the finished article is to look like and not with what it does. The

emphasis is upon the visual image conveyed by the manufactured article.

234. In ***Veeplast Houseware Private Ltd vs. M/s.Bonjour International {CS(OS) No.1181 of 2011 decided on 2.6.2011}***, the Delhi High Court pointed out that to ascertain whether the impugned design infringes another design, the two products need not be placed side by side and that the matter has to be examined from the point of view of a customer with average knowledge and imperfect recollection. The Court pointed out that a person coming across the impugned product may not have on hand, the product of the plaintiff, at the time when he goes to the market. Therefore, infringement is not to be found out by comparing similarities and dissimilarities. To find out whether two designs are identical, the main consideration is whether the broad features of shape, configuration, pattern etc., are similar to each other or not.

235. But I do not think that I should strictly follow the ratio laid down by the Delhi High Court in *Veeplast*. The said decision arose out of an action for infringement of design of a consumer product. But in the case on hand, the product is a prosthesis, which is actually custom made. It is not a product which is available across the counter. It cannot even be compared to ordinary drugs. Therefore, I would keep aside the test applied by the Delhi High Court in *Veeplast*.

236. But the above decision actually followed an earlier decision of the same High Court in ***Alert India vs. Naveen Plastics {1997 PTC (17) 15 (Delhi)}***. In the said case, the product in question was the sole of footwear. One of the two questions that arose for consideration was whether the design of the product manufactured by the defendant was same or similar to the product of the plaintiff. While dealing with the said question, the Delhi High Court indicated that one of the practical tests to find out the identity or sameness of the design, is to find out whether there are substantial

differences. These differences cannot be based on purely subjective or utilitarian or aesthetic considerations. The differences must be objective in essential features. A general view of the features of both the designs should be looked into to find out whether one design is as good as the other and the conclusion is to be arrived at by visual examination of the two products.

237. More importantly it was pointed out in the said case that similarity of device in external appearance may be a relevant factor in considering the substantial differences between the two, but it is certainly not a determining factor. The main consideration to be applied is whether the broad features of shape, configuration, pattern etc., are the same or nearly the same. If they are substantially the same, then it is a case of imitation.

238. In ***Castrol India Ltd vs. Tide Water Oil Co. (I) Ltd {1996 PTC (16) Calcutta 202}***, the Calcutta High Court pointed out that under Section 2(5) of the 1911 Act, the operative words are shape, configuration, pattern or ornament and that they are not protected in the abstract, but protected when applied to an article. Therefore, after comparing the containers of the plaintiff and the defendant, the Calcutta High Court came to the conclusion that the defendant's container bore a family resemblance to the petitioner's design. Therefore, the Court held that the sequence to the obligation of the Court in considering an application for infringement is first to consider whether protection is claimed in respect of a design or the mode of manufacture. The Court is then to consider whether the design is, in fact, novel and if so to what extent. But all novel designs are not protected. Citing a decision in *In Re : Lamson Industries Ltd., {(1978) RPC 1}* case, the Court held that novel designs which are purely functional, cannot be the basis for an action for infringement. The Court also held that it is not every resemblance in respect of the same article which would be actionable. The copy must be a fraudulent

or obvious imitation. Again imitation does not mean duplication. Following the decision in *Best Products Ltd.*, *{(1964) IX RPC 215}*, the Court held that it was necessary to break the article down into integers for descriptive purposes, but in the ultimate result it is the article as a totality that must be compared and contrasted with the features of a shape and configuration.

239. In ***The Pilot Pen Co. (India) Private Ltd vs. The Gujarat Industries Private Ltd {AIR 1967 Madras 215}***, this Court was concerned with the alleged infringement of a design, relating to the clips of fountain pens. Though no evidence was let in by the plaintiff to show that apart from novelty claimed for the design, he had any proprietary right in the design, the Court held that the registered proprietor has a copyright in the design. Eventually, the Court held in paragraph 22 as follows:-

*"(22) A registration cannot be deemed effective unless the design or configuration, sought to be protected, is new and original and not of a pre-existing common type. Where the evidence indicated that the designs in question were in use from long before the date, when the registration of the patent was applied for by the plaintiff, it is not possible to say that the designs were new or original and that the plaintiff was entitled to protection which he sought : Vide Ram Sahai v. Angnoo, AIR 1922 All 496."*

240. From paragraph 22 extracted above, it is clear that a registration cannot be deemed effective unless the configuration or shape sought to be protected is new and original and not of a pre-existing common type. Therefore, it appears that registration, *per se*, does not entitle the plaintiff automatically to a decree of injunction.

241. Therefore, taking clue from the legal position defined in *The Pilot Pen Co.*, the defendants contend that the plaintiff is bound to prove that the configuration and shape,

which form the basis for his claim, are new and original. The defendants also contend that the prosthesis manufactured by the plaintiff does not even qualify as a design within the meaning of Section 2(d). According to the defendants, the prosthesis manufactured by the plaintiff is in substance, a mere mechanical device. Therefore, according to the defendants, it is not a design within the meaning of the Act, so as to entitle the plaintiff to be protected.

242. Similarly in ***Indiana Gratings Private Limited vs. Anand Udyog Fabricators Private Limited {2009 (4) R.A.J. 281 (Bom.)}***, the Delhi High Court pointed out that if the plaintiff's drawings do not qualify as design under the Designs Act, they are not registerable as such and that consequently, the copyright in registered designs, which is available to the designs of the final product under Section 11 could not be available to the plaintiffs. The Bombay High Court drew a distinction in that case between the drawing of an industrial product which would qualify only as a copyright in an artistic work and a design that would qualify under the Designs Act. The Court held that if the drawing of an industrial product is not a design and not registered as such, it would not enjoy the monopoly that is conferred under the Act, but only the right to prevent its infringement conferred under the Copyright Act. Consequently, the Court also pointed out that the design would be embodied in a sketch illustrative of a model which would be multiplied or the model itself that is the finished article. If that is not so, it would not be required to be registered as a design. If the plaintiff's drawings are not of a final product, capable of being manufactured again and again, that would not qualify as design.

243. More importantly, the Bombay High Court in *Indiana Gratings*, relied upon a decision of the House of Lords in ***AMP Incorporated vs. Utilux Proprietary Limited***

**{1971 FSR 572}**, where the plaintiffs claimed infringement of two registered designs in electric terminals, consisting of a receptacle, a transition portion and a connecting channel specifically manufactured for use in washing machines of a certain customer. In that case, the House of Lords found that the function of the terminals was the sole cause for the choice of their shape and not the eye appeal. The shape was chosen only to make the article work. Neither the purpose nor the result of the product was to appeal to the eye, but to do the job. The design had no shape, feature or configuration that appealed to the eye. The shape was applied by an industrial process to make the end product more useful. Therefore, relying upon the observation of Lord Porter in the case of **Stenor Limited vs. Whitesides {1948 A.C. 107}**, the House of Lords held that the primary object of the Act is to protect shape and not function and not to protect functional shape. Therefore, it is the contention of the defendants in this case that the prosthesis manufactured by the plaintiff is a mere mechanical device whose shape was solely intended to perform a function. Hence, according to Mr.N.L.Rajah, learned counsel for the fourth defendant, the plaintiff cannot seek any relief in respect of the design.

244. In **Bharath Glass Tubes Vs. Gopal Glass Works Limited [CDJ 2008 SC 810]**, which arose out of an application for cancellation of registration under Section 19 of the Act, the Supreme Court pointed out that the burden was on the complainant to show that the design was not original or new. The Court also pointed out in that case, what the concept of a design is. A design capable of registration is that which is conceived as an idea of a shape or a configuration or ornament or pattern in the mind of the originator and which is applied to any article physically. Quoting from **Buckley, J** in **Dover Limited Vs. Nurnberger Celluloid Waren Fabrik [(1910) 27 RPC 498]**, the Supreme Court pointed out that the object of the Designs Act was intended to protect

designs, which really have some merit by way of novelty or originality and not to give colour to such paltry and trivial claims. In fact, in the decision of *Buckley*,<sup>J</sup> relied upon by the Supreme Court, the learned Judge rejected the claim of infringement on the ground that the project in question had nine panels as against six panels in the registered design and also on the ground that the grooves in the defendant's product were more shallow than the plaintiff's grooves.

245. I have carefully considered the rival submissions.

246. From the rival submissions, I think two issues arise. The first is as to whether I can be called upon to record a finding on the validity of the design, especially when the defendants have not raised any substantial pleadings. The second is as to whether there was any infringement, even assuming that the plaintiff had a design which is valid.

247. On the first question, as I have already pointed out, the defendants have not chosen to challenge the validity of the registered design of the plaintiff, despite the fact that Section 22(3) enables the defendants to raise, as a defence, any of the grounds available under Section 19. Therefore, I have to take it that the validity of the plaintiff's design is not under challenge.

248. The defendants also have one more disadvantage. Under Section 13(4) of the Patents Act, there is no warranty of validity of the patent, merely because the Examiner of Patents conducts an examination and investigation for anticipation by previous publication and by prior claim. This is why the certificates of registration of patent (Ex.P1 etc.) also contain a disclaimer to the effect that the validity of the patent is not guaranteed. Therefore, *onus probandi* is on the plaintiff, who claims to be the registered proprietor of the patent, to establish before court, novelty, non obviousness and usefulness, before seeking a decree of declaration and injunction.

249. But, the Designs Act, 2000 stands in contrast to the Patents Act, 1970. First of all, there is no provision in the Designs Act, 2000, which is analogous to Section 13(4) of the Patents Act, 1970. Similarly, the certificates of registration of design Ex.P7, Ex.P8, Ex.P9 and Ex.P.7A, Ex.P.8A and Ex.P.9A also do not contain any disclaimer as is found in the certificates of registration of patents (Ex.P1, Ex.P2 Ex.P3, etc).

250. Therefore, it is clear that the strict rigours contained in the Patents Act, 1970 with regard to the validity of a patent, are not to be found in the Designs Act, 2000. In the background of this legal position, in the absence of any averment in the written statement of the defendants challenging the validity of the registered design of the plaintiff, it is not possible for me to call upon the plaintiff to establish that the registered design in his favour is also valid.

251. I must also take note of the fact that every application for registration of a design is scrutinised by an Examiner, under the proviso to Section 5(1) of the Act, to see whether such design is capable of being registered under the Act and the Rules made thereunder. Section 5 of the Designs Act, 2000 does not contain a provision, which is analogous or similar to Section 13(4) of the Patents Act.

252. Therefore, on the first question, I have no option but to conclude that the registered design of the plaintiff is valid. This is despite the fact that in paragraph 22 of its decision, this Court held in *The Pilot Pen Co.*, that registration cannot be deemed effective unless the design or configuration sought to be protected is new and original and not of the pre-existing common type. The decision in *The Pilot Pen Co.* arose under the 1911 Act that was common for both patents and designs. The law has travelled a long way from the said decision and hence, I hold on the first issue that the design of the plaintiff is valid. Therefore, I shall move on to the next question namely as to whether

there was infringement.

253. To prove that there was infringement, the plaintiff should establish (i) that the shape and/or configuration of the prosthesis manufactured by the first defendant is similar to the shape and/or configuration of the registered design of the plaintiff's product; and (ii) that the similarities between the features of both products in terms of shape and configuration strike the eye of the observer. This is in view of the fact that though a registered design can be in respect of an application to an article, of various features such as shape, configuration, pattern or ornamentation or composition of lines, the plaintiff's claim of novelty is restricted only to shape and configuration and not to others. This is seen from Ex.P.7A, Ex.P.8A and Ex.P.9A, all of which contained a pictorial representation of the prosthesis. While Ex.P.7A contains front, back, right side and left side view of the custom prosthesis, Ex.P.8A contains similar pictorial representation of the prosthetic articles and Ex.P.9A contains pictorial representations of proximal tibial prosthesis.

254. In order to show that the shape and configuration of the prosthesis manufactured and used by the defendants bear similar features of shape and configuration, the plaintiff filed in chief examination, Ex.P.46, Ex.P.50, Ex.P.51 and Ex.P.52. Ex.P.46 is the surgical photograph of the prosthesis manufactured by the first defendant and allegedly applied to a patient by name P.V.Sadiya at the Cancer Institute, which is the fourth defendant. Ex.P.50 is also a similar surgical photograph of the prosthesis manufactured by the first defendant and applied to a patient Shah Naway through the fourth defendant. Ex.P.51 is also a similar photograph of a prosthesis applied to a patient by name Master M.Naresh. Ex.P.52 is a diagram allegedly prepared by a doctor for a patient.

255. But, the marking of Ex.P.46, Ex.P.50 and Ex.P.51 were objected to, by the learned counsel for the defendants on the ground that these photographs were not accompanied by the negative. The marking of Ex.P.52 was objected on the ground that it was not at all legible. Therefore, while recording evidence on 9.2.2010 (in my presence), I passed an order that these documents were marked subject to objections. Hence, it is my duty to consider the admissibility of those four documents at present.

256. In so far as Ex.P.46, Ex.P.50 and Ex.P.51 are concerned, they are surgical photographs allegedly taken at the time of surgeries conducted on 26.5.2005, 3.3.2006 and 31.3.2006 respectively at the Adyar Cancer Institute, which is the fourth defendant. At the outset, there is no explanation as to how the plaintiff came into possession of these surgical photographs. The plaintiff could have obtained these photographs either from the patients themselves or from the fourth defendant or from the surgeons, who operated upon the patients. The plaintiff has not given any indication as to how he obtained these photographs. The fourth defendant could not have parted with these photographs, since the plaintiff had issued a cease and desist notice on 1.9.2006 itself. The only possibility is that Dr.Mayilvahanan Natarajan, who was also associated with the fourth defendant and who happens to be a co-patentee, could have handed over these photographs to the plaintiff.

257. In any case, there is no authentication that these photographs relate to the prosthesis manufactured by the first defendant and used on patients at the fourth defendant institute. These photographs are not even accompanied by the negatives. Therefore, I cannot take these exhibits namely Ex.P.46, Ex.P.50 and Ex.P.51 as conclusive evidence of the fact that the first defendant manufactured prosthesis containing the same or similar features of shape and configuration as that of the

plaintiff's product and that they were also used on patients by the fourth defendant. Coming to Ex.P.52, I cannot accept it as a piece of evidence worth any consideration. Apart from the fact that the drawings contained therein are incapable of being deciphered, it is so illegible that a finding of infringement on the basis of Ex.P.52 would be disastrous.

258. Keeping the above in mind, if we look at the pleadings and evidence let in by the plaintiff, it is clear that there is no evidence on record to show that the shape and configuration adopted by the plaintiff in his designs, have been copied by the defendants. As a matter of fact, the proximal tibial prosthesis or distal femur prosthesis, are supposed to be a replacement for the cancer affected bones that are connected by the knee joint. Therefore, every prosthesis takes its shape and configuration only from the human anatomy. There is no other shape that a distal femoral prosthesis could actually take, if it is intended to replace the bone affected by the tumour. If different types of prosthesis, as seen from the pictorial representations given in paragraph 183, take the shape and configuration of the bones and the knee joint, the plaintiff cannot successfully establish infringement, merely by showing broad and over all similarities.

259. As I have pointed out earlier, the plaintiff had never seen the product of the first defendant physically. He claims to have seen only the photographs and the sketches. It was only DW-1 who produced MO-2. But he maintained that the first defendant manufactured different types of prosthesis, of which MO-2 was one. Therefore, I did not have the benefit of seeing the prosthesis manufactured on regular basis by the first defendant (except MO-2) to see whether the shape and configuration of both looked alike to my eye.

260. From paragraphs 166 to 174 above, I have extracted in detail the evidence of

DW-1 indicating the differences between the products, both in terms of specifications and in terms of shape and configuration. Therefore, (i) when the plaintiff himself has not seen the product of the first defendant; (ii) when the plaintiff could not produce the infringing material before me; and (iii) when the first defendant produced only one stray item and indicated the differences, it is not possible for me to conclude that the first defendant is actually manufacturing prosthesis of the same or similar shape and configuration as the prosthesis manufactured by the plaintiff. Hence, I hold that the plaintiff has failed to prove infringement.

261. In view of the above, I hold on issue No.5 that the plaintiff has failed to establish infringement and that therefore, he is not entitled to a permanent injunction restraining the defendants in any way making, manufacturing, using, selling, offering for sale, marketing or advertising with regard to any prosthesis or any variation thereof by using or utilising the plaintiff's Design Nos.191946, 189140 and 204684.

**ISSUE Nos.4 and 6:**

262. The fourth issue is as to whether the defendants are liable to deliver all apparatus relating to the manufacture of any prosthesis by the defendants through the infringement of the prosthesis in patent Nos.196333, 198872 and 198869 and the design Nos.191946, 189140 and 204684. The sixth issue is as to whether the defendants 1 to 4 are liable to render true, fair and faithful accounts in respect of the invention manufactured, used and sold by the defendants which infringed and continue to infringe patent Nos.196333, 198872 and 193869 and whether a preliminary decree has to be passed for taking such account for the loss and damage suffered by the plaintiff.

263. These two issues are actually consequential to issue Nos.1 to 3 and 5. I have already recorded a finding on issue Nos.1 to 3 and 5 that the plaintiff has not established

an infringement of patent No.196333 and design No.191946. Consequently, I rejected the prayers for decrees of permanent injunction under issue Nos.1 to 3 and 5.

264. Therefore, as a corollary to the findings on issue Nos.1 to 3 and 5, issue Nos.4 and 6 have also to be found against the plaintiff. Once it is found that there was no infringement and once it is found that the plaintiff is not entitled to decrees of permanent injunction, it follows as a corollary that the defendants are not liable to deliver all apparatus relating to the manufacture of any prosthesis through the infringement of the registered patents and designs of the plaintiff. Similarly, defendants are also not liable to render true, fair and faithful accounts. Accordingly, issue Nos.4 and 6 are answered against the plaintiff.

265. Therefore, in the result, the suit is dismissed. However, there will be no order as to costs.

23-01-2014

Index : Yes.  
Internet: Yes.  
kpl/Svn/RS

**V. RAMASUBRAMANIAN, J.**

kpl/Svn/RS

Judgment in  
C.S.No.562 of 2007

23-01-2014