IN THE HIGH COURT OF DELHI

DATED: 25.03.1977

CORAM

THE HONOURABLE MR. JUSTICE PRAKASH NARAIN

AND

THE HONOURABLE MR. JUSTICE B.C. MISRA

Regular First (OS) Appeal No. 2 of 1973

Raj Parkash ... Appellant

Vs.

Mangat Ram Chowdhry and Ors. ... Respondents

Counsel: Mohinder Narain, S.S. Jauhar, Manju Malhotra, B.S.C. Singh, Mohd. Anis, Advs.

JUDGMENT

Prakash Narain, J.

(1) This first appeal is directed against the judgment of a learned single Judge of this Court, who declded the suit between the partics on the Original Side of the High Court. The appeal, preferred against the judgment of the learned single Judge delivered on December 15. 1972. was admitted on February 28, 1973. That appeal came up for hearing before a Bench of this Court (Coram : S. N. Andley. C. J. and Prakash Narain. J.). The Bench by its order of April 30, 1974 framed an additional issue and remanded the case back to the learned single Judge for a finding on the said issue and disposal of the suit thereafter. The second judg-ment in consequence of the remand order was delivered on January 27. 1975. The matter thereafter came up before us.

(2) The plaintiff/appellant produces and markets a toy called a viewer. This viewer uses a 35 mm. medially cut positive film on which are printed one or more pictures viewed through a lens fitted in a viewer specially adapted for use of such medially cm strips of 35 mm. positive films so as to get a virtual image of the same size as the virtual image of a normal frame in a 35 mm. film. The plaintiff obtained a patent bearing No. 111926 for what he calls his invention. We shall presently deal with the patent as granted to the plaintiff in some detail. Suffice it to say at this stage that the toy above-mentioned is attractive enough for children and may be used by even grown-ups for viewing interesting and educative pictures and is said to have had a good sale. It is he plaintiff's case that the defendants have infringed the patent of the plaintiff inasmuch as they are manufacturing and selling in the open market film strip viewers utilising a medially cut 35 mm. cinematograph film in viewers in a manner which is identical to and a copy of the viewers being manufactured and marketed by the plaintiff. Defendant No. 1 is said to be the owner-proprietor of the firm defendant No. 2, and is alleged to be the main offender. Defendant No. 3 is stated to be agent of defendant No. 1 and is only alleged to be selling and marketing the infringing viewers.

(3) Defendants 1 and 2 resisted the suit but defendant No. 3 did not put in appearance and was proceeded ex-parte. The contesting defendants denied that the plaintiff had developed any process which could be called an invention for exposing or manufacturing of film strips made out of standard 35 mm. cinematographic films. It was denied that the defendants were manufacturers of film strip viewers. On the other hand it was contended that they were only sellers of film strip viewers and got, to quote from the written statement, "their 1/2 films strips manufactured from different agencies for the last five years much before the alleged patent claim of the plaintiff". It was contended that the defendants were getting printed four pictures of equal size on a cine standard frame of 35 mm. film so that four pictures of equal size are obtained on each cine standard frame of 35 mm. film and thereafter cutting the printed film

medially into two halves to get two film strips which were capable of being separately used in film strip viewers. The process of printing four pictured on the cine standard frame of 35 mm. film adopted by the defendants was not claimed to be an invention and it was said that that process was common knowledge among photographers. Similarly, the process of dividing and sub-dividing a cine standard frame of 35 mm. film or other different formates of photographic films for purposes of copying prints of pictures and for other purposes, it was said, had been known as an ordinary process in photographic art for 50 years. In short, not only the invention claimed by the plaintiff was disputed but also its worth or value. A counter-claim for revocation of the patent was put in by defendants I and 2. It was pleaded that the plaintiff was not the true and first inventor of the alleged invention; that the defendants had been selling 1/2 film strip viewers for five years much before the plaintiff claims that he invented some- thing or got his patent; that there was pri publication and knowledge of the alleged invention of the plaintiff; that the alleged invention was of no utility; that there were other producers of film strips claimed by the plaintiff as his patent; that the patent was obtained by fraud etc.

(4) After the plaintiff had filed a replication reiterating his case and statements before issues were recorded, a learned single Judge of this Court, V. D. Misra, J., settled the following issues :- "1. Whether V. K. Singhal was the first inventor of the alleged invention covered by patent No. 111926, dated 11-8-1967? O.P.D. 2. Is the invention covered by patent No. 111926 not a new manufacture in view of the sale by the defendants ? O.P.D. 3. Is the invention covered by patent No. 111926 of no utility ? O.P.D. 4. Whether the invention was not at the date of the patent a manner of new manufacture and improvement ? O.P.D. 5. Whether the defendants have a locus standi to claim revocation of the patent by way of a counter-claim"? O.P.D. 6. If Issue No. 5 is proved, whether the patent be revoked ? O.P.D."

(5) The parties went to trial on the above issues. As noticed earlier, the suit was disposed of by a learned single Judge of this Court (Coram : D. K. Kapur, J.) by

his judgment dated December 15, 1972. The learned single Judge partly upheld the patent of the plaintiff but dismissed the suit for infringement of the patent. He came to the conclusion that neither the manufacture of the viewers nor the cutting nor the exposing of the film are by themselves an essential part of the combination of the methods in claim 3 for use in the viewers which is the essential feature of the plaintiff's patent and the production of the film was done by the plaintiff by massing. The defendants, according to the learned Judge, did not use this process in manufacturing their films used in viewers marketed by them. The suit for grant of injunction and claim of infringement was dismissed by the learned single Judge because, according to him, there was no issue on that point. As noticed earlier, an additional issue was framed and the case remanded. This finding was recorded by the learned single Judge by his judgment dated January 27, 1975. In this judgment the learned single Judge notices that by his earlier judgment only part of the claim of the plaintiff had been upheld by him. Our learned brother once again went into the detailed specifications of the patent granted to the plaintiff and came to the conclusion that the specifications showed that the plaintiff only claims as his patent the process for printing photographic films for use in film strip viewers and also in respect of the films made thereby for viewers. He did not claim any patent for a film strip viewer. He rejected an alleged claim made by the plaintiff of patent in the viewers themselves. The learned Judge observed that according to the specifications and descriptions in the patent the plaintiff has a patent restricted to a process for making a film for a film strip viewer. After dilating at great length on various types of frames in divers types of cameras the learned single Judge took the view that the whole case was one of technique used in film making and processing the films. He again recorded a finding that there was no infringement by the defendants. The validity of the patent this time was upheld on the basis of the technique used by the plaintiff inasmuch as he collected previous well-known processes in a combination.

(6) The patent that was granted to the plaintiff on August 11, 1967 reads as under :-"Government of India The Patent Office No. 111926 of 1967. Whereas Raj Prakash, of B1/154, Lajpat Nagar, New Delhi, an Indian National hath declared that he is in possession of an in-vention for a process for printing picture films for use in film-strip viewer and the films made thereby and that he is the true and first inventor thereof, and that the same is not in use in India by any other person to the best of his knowledge, information and belief. And whereas he hath by and in his complete specifically parti- granted to him for the said invention; And whereas he hath by and in his complete specifically particularly described and ascertained the nature of the invention and the manner in which the same is to be performed. The Central Government is pleased to order by these presents that the above said petitioner (s) (including his legal representatives) and assigns or any of them shall, subject to the provisions of the Indian Patents and Designs Act, 1911, as patentee(s) have the exclusive privilege of making, selling and using the invention throughout India and of authorising others so to do for the term of sixteen years from the 11th day of August. 1967, subject to the conditions that the validity of this patent is not guaranteed by Government and also provided that the fees prescribed for the continuation of the patent are duly paid. In witness whereof the Central Government has caused this patent to be sealed as of the 11th day of August, 1967. sd/- S. Vedaraman Controller of Patents and Designs, Date of sealing 14th March 1969/23 phn. 1890 (Saka) P. & D.87. MGIPO-84-32 Patent/63-12-5-64-1,000 Renewal fees will be due on this patent, if it is to be maintained, on the 11th day of August 1971 and on the same day in each year thereafter."

(7) The specifications submitted by the plaintiff for grant of the patent read as under :- "A Process For Printed Picture Films For Use In Film Strip Viewer And The Films Made THEREBY. Raj Prakash, resident of B I/I 54, Lajpat Nagar, New Delhi, an Indian National. The following specifications particularly describes and ascertains the nature ..... of the invention and the manner in which it is to be performed :- This invention relates or move films of

35 mm. size particularly for use in film strip viewers and has it principle object to economics in the quantity of film to be used in the film viewers is cut down to practically half. The film as generally used in film strip viewers is mostly obtained from imports. Due to the present import restrictions its cost has gone up so that it has become increasingly difficult to have it available in sufficient quantities for use in the strip viewers for cheap production in the field of toys. Same is also the case ragarding the availability and price situation of the coloured films required for use in the film strip viewers. After carrying out extensive experimental work I have devised a method by which the standard size film (cinematographic) whether coloured or black and white which is usually available in a standard sire of 35 mm. with perforations on both the sides can be cut into half size of 17/2 mm. The negative is exposed on a standard 35 mm. coloured or black and white film negative by masking as required in such a manner that 2 pictures of equal size appear in the standard movie frame. Thereafter this negative film is printed on 35 mm. positive film so that the two pictures come on the positive film. At this stage the final print is ready and thereafter the said print is cut into wo halves medially to separate out the two film strips. Such cutting of the film into two halves does not disturb the perforation on each side of the film and the cut film thus can be operated in the improved film strip viewers. This method enables getting two pictures of equal size in one single frame of silent movie standard frame in such a way that after cutting the complete film medially into two halves, two film strings are obtained from a single standard film of 35mm. size for use in the film strips viewers. This accordingly, reduces the cost of the film to be used in the film strip viewers to practically half. The principal object therefore of the method of printing picture film for use in film strip viewers according to the present invention is to utilise a 35 mm. standard film ingetting two Pictures in one single frame of silent movie standard frame and to view the same by increasing the magnification of the object lens of the strip viewer to obtain the same size picture as would normally be obtained from a full Size standard silent movie frame. In view of the

increased cost and difficulty in the availability of the imported films particularly the coloured films, another object in proposing the method of printing picture films for use in film strip viewers according to the present invention is to cost practically to half for use in the strip viewers. This also effects a considerable saving in the foreign exchange. The film cut into two halves medially and having perforations only on one side to be used in the film strip viewers according to the present 9 HCD/77-4 invention is illustrated in the accompanying drawings throughout which like reference numerals indicate corresponding parts in the various figures. Figures 1 and 3 show the standard film of 35 mm. size having perforations 1 and 2 on either side and the middle line along with the film is out. Figures 3 and 4 show the standard film cut into two halves having the perforations only on one side for use in the film strip viewers according to the present invention. The standard silent movie frame is shown at 3 in Figure I. The same half frame obtained after cutting the film in two halves is shown at 4 (Fig. 3) and 5 (Fig. 4). It is clear that film strip cut in this manner and having its perforations undisturbed on one side can be used in the film strip viewers for getting two pictures of equal size instead of one as in the conventional type of film strip viewers, in one single frame of silent standard frame. In order to obtain the same size picture as is normally obtained from a full frame the magnification of the object lens of the film strip viewer is increased so that the same effect is obtained. It would be appreciated that the half cut positive film strips to be used in the film strip viewer, have perforations only on one side of the strip. The perforations, on one side of the half cut film strip, support the film and also facilitate its free and smooth movement in the strip viewer. Thus according to the present invention the photographic process for picture film for use in film strip viewers comprises the steps of exposing two pictures of equal size on a standard 35 mm. negative cinematographic films by making as required printing the same on standard 35 mm. positive film so that two pictures of equal size are obtained on each frame of the standard film thereafter cutting the printed film medially into two halves to get two picture film strips each of which is capable of being

separately used in the film strip viewers. Since each picture of the half cut film strip is of a reduced size. It is adopted to be viewer in the film strip viewer of which the object lens has increased magnification to provide the same size picture as is normally obtained from a full size standard sine movie frame.".

(8) On the basis of the above specifications, the claims made by the plaintiff which were incorporated in the patent read as under :-

> "1.A photographic process of printing picture films for use in film strip viewers comprising the steps of exposing two pictures of equal size on standard 35 mm. negative cinematographic films by masking as required, printing the same on standard 35 mm. positive film so that two pictures of equal size are obtained on each frame of the standard film thereafter cutting the printed film medially into two halves to get two pictures film strips each of which is capable of being separately used in the film strips viewers. 2. A printed picture film for use in film strip viewers consisting of a half portion of the standard 35 mm. cinematograph film in the picture frame of which a plurality of picture are printed according to the method claimed in claim 1. 3. A combination of film as claimed in claim 2 with a film strip viewer capable of using a standard 35 mm. cinematograph film cut into half as claimed in any of the above claims characterised in that each picture of the half cut positive film strip, which is of reduced size, is adopted to be viewed in the film strip viewer of which the object lens has increased magnification to provide the same size picture as is normally obtained from a full size standard silent movie frame. 4. A process for printing picture film for use in film strip viewers as claimed in claim (1) substantially as described and illustrated in the specification. 5. A cinematographic film of 35 mm. standard size for use in the film strip viewer made according to any of the above claims substantially as described and illustrated in the specification.".

(9) After prolonged hearing, when called upon, the counsel for the plaintiff/appellant and defendants 1 and 2 (respondents 1 and 2 herein) gave almost similar construction to the claims in patent No. 111926. The plaintiff/appellant and defendants 1 and 2 also entered into an agreement for supply of the patented viewers by the plaintiff/ appellant to defendant No. 2. The statements made by the counsel for the parties were duly recorded in court. Though defendant No. 3 (respondent No. 3 herein) was ultimately represented

by counsel, it did not enter into any arrangement with the plaintiff/appellant. Even defendants 1 and 2 entered into an agreement which is operative only for one year. Hence, it is necessary that we lay down the correct law not only on the basis of statement made by the parties but necessitated by the limited period for which the agreement has been entered into between the plain-tiff on the one hand and defendant No- I on the other.

(10) Although defendants I and 2 have admitted the patent, as claimed by the plaintiff, and have also admitted infringement of such patent, it would be necessary to clearly set out what is the invention that the plaintiff claims and what has actually been patented. Invention, as is well-known, is to find out something or discover something not found or discovered by anyone before. Whether a patent sets out an invention is to be determined by a true and fair construction of the specifications on the basis of which an inventor claims that he is the first inventor of an invention which is to be patented. In order to properly construe the specifications, one should give ordinary meaning to the words but where necessary the words must be construed in the sense in which they are used at a particular trade or sphere in which the invention is sought to have been made. The grant of patent, no doubt, creates a monopoly in favour of the patentee but then law throughout the free world recognises that an inventor must first get the benefit of his invention even if it means creating a monopoly. Nearer home, the Patents and Designs Act was first passed in 1911. In 1970 this Act was amended so as to apply only to designs and Act 39 of 1970 was passed by the Parliament confined exclusively to patents. Inasmuch as the patent claimed by the plaintiff was granted in 1967, we are really concerned with the Act of 1911. According to Clause (8) of Section 2 of the Act of 1911 an invention means any process of new manufacture and includes an improvement in an alleged invention. Clause (11) of Section 2 defines patent to mean one granted under the provisions. of the Act. We shall presently deal with the other provisions of the law as we proceed to deliver our judgment. For the time being

we shall restrict ourselves to the exposition of law and its application to the facts of the present case.

(11) As observed by us a little earlier, the first thing to do is to determine what the invention is. According to the learned single Judge it means one thing, according to the plaintiff quite another. A careful reading of the claims put in by the plaintiff and understanding the same in their ordinary meaning would clarify the whole situation. Indeed, one can get bogged down by the techniques of photography, the diverse frames used in a still camera or in a movie camera. We are. however, really not concerned with all that. As was said by Heald K. C. in Electrical and Musical Industries, Ld. and Boonton Research Corporation Ld. v. Lisson Ld. and another, 1937 (54) R.P.C. 307(1) and affirmed by Romer, J. in the same case :-

> "AS in all patent actions in which the validity of the patent is put in issue, the first thing to be determined is the proper construction of the specification ; but the specification must be construed with a proper appreciation of the meaning that it would convey to persons engaged in the art to which it relates, for it is to those persons that it is addressed and it must be read with their eyes."

(12) We have, therefore, to read the specifications and the claims from the point of view of the persons in the trade manufacturing film strip viewers. It is the pith and marrow of the invention claimed that has to be looked into and not get bogged down or involved in the detailed specifications and claims made by the partics who claim to be patentee or alleged violaters. (See Birmingham Sound Reproducers Ld. v. Collaro Ld. and Collaro Ld. v. Birmingham Sound Reproducers Ld.. 1956 R.P.C. 232)(2). It is not necessary that the invention should be anything complicated. The essential thing is that the inventor was the first one to adopt it. The principle, therefore, is that every simple invention that is claimed, so long as it is something which is novel or new, it would be an invention and the claims and specifications have to be read in that light, as, was observed in the famous hair-pin case, reported as Hinde v. Osberne, 1885 R.P.C. 65(3). To quote from another well-known decision of the Court of Appeal in

R.C.A. Photo- phone Ld. v. Gaumont-British Picture Corporation Ld. and British Acoustic Films Ltd., 1936 R.P.C. 167(4). 'The specification must be construed in the first instance as a written instrument and without regard to the alleged infringement: ....".

(13) Sometimes people fall into error in construing specifications by relying too much on the title given to the specifications of the invention. It is settled law that the title of the specifications of an invention claimed does not control the actual claim. A misleading title similarly is of little consequence. It is on a proper construction of the specifications and the claims that the true nature of the invention claimed is to be determined and the patent granted has to be construed. Rule 33 of the Indian Patents and Designs Rules, 1933, inter alia, lays down that the title should give a fair indication of the art or industry to which the invention relates. It should be brief, free from fancy expression. free from ambiguity and as precise and definite as possible but it need not go into the details of the invention itself. Thus, the rule itself indicates that the title of the specifications does not govern the specifications or the claims. In Breraton and Another v. Richardson, 1884 R.P.C. 165(5), Field, J. put the proposition rather succinctly and if we may be allowed the liberty to quote,

> "THEREFORE, as I said just now, let us sec what the Plaintiffs' invention is. The title is certainly somewhat misleading. Mr. Macrory did not put it as anything serious, nor is it serious, because after all you must read the title by the mcans of the specification. The title is that it is for 'A new or improved tricycle. that is per se, as a machine. The complete specification and the provisional specification do not altogether agree with each other. .... .At first that seemed to threaten a technical ground that they had claimed by their complete specification more than was covered by their provisional specification; but, very fairly and very prudently, I think, the defendant did not proceed upon that, because, after all, the great object to both parties must be to have their rights settled for the future, without reference to any question of that sort, that being a comparatively immaterial question....."

(14) In Osram Lamp Works Ld. v. Pope's Electric Lamp Company Ld., 1915 R.P.C. 538(6) the above aspect is further highlighted by Joyce, J. who

emphasised that the essential part of the specifications have to be carefully read and held as an invention, if novel, without getting mixed up in the unessential and the usual parts of processes which are well-known. Therefore, in the present case also it is the essential aspect which has to be looked into in construing the patenr without being misled by the title or being carried away by the usual processes known to photography.

(15) The patentee is obliged under Rule 34 of the aforesaid Rules to describe means of performing the invention in the best manner known to him and disclose the same. The law in this behalf has long been settled. In Westinghouse v. The Lancashire and Yorkshire Railway Company, 1884, R.P.C. 229(7) Grove, J. observed as under:-

> "IT would seem to me that the better way of looking at a patent ..... is to read the specification of the Plaintiff's patent, and sec, without reference to any infringement at all, in the first instance, what the real claim of the patentee is. By the proviso in the letters patent a patentee is obliged to do two things. He is obliged to particularly ascertain and to describe the nature of the invention, and the means of perfcrming the same. Now, those two requisites apply to different contingencies. The object of stating, or rather, I should say, particularly ascertaining and describing-for the words are strong-the nature of his invention, is in order to tell the public what inventions they arc prohibited from using, during the period of his monopoly, without his licence. The public aught to be properly and explicitly informed of that, otherwise nobody would know whether they were infringing a patent or not. It is, therefore, incumbent upon the patentee to let the public know in clear terms, or as clear as the nature of the case will permit, the nature of his invention. .....".

The above proposition is codified in India in the form of Rule 34 of the aforesaid Rules. Form No. 3A, inter alia, requires :-

> "DESCRIPTION.-THE description of the invention should be preceded by the following preamble : The following specifica- tion particularly describes and ascertains the nature of this invention and the manner in which it is to be performed.' "THE description in the Complete Specification should satisfy the following requirements :- (i) The Complete Specification must be framed with the ut- most good faith and must not contain any false represen- tation or misdescription of the invention or any material part of it, or otherwise mislead

> the public. (ii) The Complete Specification must not be framed in ambi- guous language but must be as clear and concise as the nature of the subject will admit. (iii) ..... (iv) The Complete Specification must describe the best method known to the patentee of performing the invention and all his knowledge relating thereto, including that which he may have acquired during the period of provisional protection prior to the date of filling the complete speci- fication."

(16) The invention for which patent is claimed may be a product or an article or a process. In the case of an article the patent is in the end product or the article; in the case of a process, the patent docs not lie in the end product, but only in the process by which it is arrived at. Section 5 of the Patents Act, 1970, speaks of inventions where methods or processes of manufacture are patentabic but also speaks of inventions claiming substances intended for the use, or capable of being used, as food or as medicine or drug which may also be patentable. Regarding other substances the law continues to be the same as before and any invention so long as it does not fall within Section 3 of the Patents Act, 1970, is patentable. Vimada- lal, J in Farbwerke Hoechst Aktiengesellschaft vormals Meister Lucius and Bruning a Corporation etc. v. Unichem Laboratories and others, AIR 1969 Bombay 255, held that the main function of the c'ourt is to construe the claims (stated at the end of specifications in the patent) which are alleged to have been infringed without reference lo the body of the specifications and to refer to the specification only if there is any ambiguity or difficulty in the construction of the claims in question. He further observed that where one of the claims in respect of which infringement is alleged is wide enough to cover all methods for achieving partidular result, the question is not as to the method actually followed by the plaintiffs but is whether the method followed by the defendants is covered by the claim in the plaintiffs' patent. The onus as to the invalidity of a plaintiff's patent and the grounds of insufficiency of description, want of novelty, absence of inventive steps and want of utility was rightly placed on the defendants. The learned Judge further observed that in an action for infringement of patent to meet the defence under Section 29(2) read with Section 26, that the patent was invalid due to insufficieney of description, the claim in

the specifications of the patent need only be as clear as the subject admits, and the patentee need not so simplify his claim as to make it easy for infringers to evade it. The patentees duty is not to prevent all possible argument as to whether there is or is not infringement in particular cases, but to enable the courts lo formulate the questions of fact to be answered. The complete specification must describe "an embodiment" of the invention claimed in each of the claims, and the description must be sufficient to enable those in the industry concerned to carry it into effect "without their making further inventions", and the description must be fair i.e. it must not be unnecessarily difficult to follow. We arc in revpectful agreement with these observations.

(17) It is in the light of the above law that the patent in the prosent case has to be determined. Our task is made easier by the statement of the plaintiff/appellant made before us which we set out below :-

> "THE patent that the appellant claims as already submitted is not in the process of exposing of a film. use of any particular type of camera or any type of technique including masking in exposing a film, in processing a film. in developing the negative film and printing the positive films. The patent that he claims as having been granted to him is in a medially cut positive 35 mm. printed film. (which one or plurality of picture) and its use in combination with viewers specially adapted for the use of such medially cut strips, so as to get a virtual image of the same size as the virtual image of normal 35 mm. frame. The half strip thus used may also contain a plurality of picture and that is part and parcel of appellant's patent. . .".

(18) Though there was spirited contest put in by the defendants I and 2 to the specifications and claims of the plaintiff/appellant, belore us they admitted the patent, as claimed by the plaintiff and set out above. In our view, the plaintiff/appellant has rightly construed the scope of his patent as in claim 1 to 5. The learned single Judge, and we say it with great respect, went wrong in holding that the patent lay in the process of filming by masking. To quote the words of the judgment dated December 15, 1972: "I find that taking two photographs on one film by using half the film at one time is nut an unusual

idea. . . . .(After dealing with the demonstration given in court and referring to .encyclopaedia of photography) I, therefore, cannot uphold the plaintiff's case that he had a patent for making two pictures in a single cine-frame. .... However, the third claim, which is the claim for a combination, is novel in the sense that no one before had thought of making a viewer using a half-cut film by the method used by the plaintiff." In the judgment dated January 27. 1975. after remand, the learned single Judge observed :-

> "I must point out that there is an essential difference between the technique relied upon by the plaintiff in his specifications and the technique relied upon by the defendants' witness in making the same type of photograph. Accord- ing to the plaintiff, the film is placed in a cine camera and half the film is masked so that only half of the film is exposed and a second photograph is taken on the other half of the film. According to the defendant, a single exposure can be taken at one time with a leica camera using four photographs on the leica frame as 1/4th portion of the leica camera frame. As the leica camera frame, is twice the size of a cine camera frame, it means that each of these 1/4th size pictures will be equal to half size pictures in a cine camera frame ...,...." ". . . . I cannot scc that the process deseri-bed by the defendants is at all the one which lias been patented. In fact, a practical demonstration of the two methods was given in Court at the stage "of the original trial. I woirld like to describe the process used b" the two parties. ....""..... The masking is brought about by putting an object between the lens of the camera and the film. That object was mattalie strip. It is possible that the masking may be done in other ways also. The essential part of the description given by the plaintiff in his patent has the use of masking. . . . ." "......In fact, I have upheld the patent on the ground that the plaintiff has used a new technique, in as much as he has connected previously well-known process in a combination. If all techniques arc covered by this patent, then of course, there will be nothing inventive about it. I have upheld the patent on the ground that the plaintiff docs not use masking in the sense that he shuts off the light from half the frame of his camera in a particular way, I must hold that defts method is different from this means that I must come to the conclusion that what is stated in the written statement does not amount to being an admission on the plaintiff's case."

(19) Photography and its various techniques are known to those interested in and indulging in this art lor a long time. The various developments are well-publicised in photographic magazines. Therefore, use of a particular type of film

or camera or taking plurality of pictures on one film or in one frame is neither novel nor new. The technique of masking, super-imposing etc. are also well-known. Therefore, the trial Court fell in error in being confused by the defendants. who put up a case of cine-frames, leica frames, technique of photography etc. as defence to their infringement. The patent consisted, inter alia, in the novel idea mentioned in the statement of the counsel for the appellant recorded by us earlier. In the claims put forward by the plaintiff in the Patent Office the entire process was described. From this process the essential and the unessential parts have to be separated and the same stand separated in discerning and finding out the invention of the plaintiff, when we read his counsel's statement set out hereinabove. The patent in its entirety is, therefore, upheld as valid.

(20) Having determined the nature of the invention and having up- held the validity of the patent, as set oirt above, the next aspect is to determine whether the invention is new with reference to (a) prior publication, and (b) prior use. The defendants did not disclose any case of prior publication in the written statement. It was only in the statement before issues that Mangat Ram, defendant No. 1, said that the first inventor of the alleged invention was Shri V. K. Singhal, Medical Photographer in the Willingdon Hospital, New Delhi. Reading the statement of V. K. Singhal, who appeared as D.W. 3, we have no hesitation in rejecting the contention of the defendants. All that he deposed about was that he took plurality of pictures on a 24 mm. X 35 mm. frame, known as leica frame. He then put the said negative in an enlarger and took pictures 1 cm. X 1 cm. and prepared slides from the film strips in which he had taken plurality of pictures in a leica frame. This is something quite different from preparing medially cut strips of 35 mm. films having plurality of pictures for use in viewers specially adapted for these half-strips to give a virtual image of a full cine-frame. In any case. Singhal's process is not claimed even by him to have been made public prior to the claim of patent filed by the plaintiff. There is no evidence of prior

user and the rule enunciated in Pope Appliance Corporation v. Spanish River Pulp and Paper Mills Ltd., 1929 (18) R.P.C. 23(9) is clearly attracted.

(21) In the written statement defendants had pleaded that they do not manufacture the infringing cine-strips themselves but arc getting the same manufactured in Bombay from various agencies. In the statement before issues Mangat Ram stated that he was getting half film-strips manufactured from M/s. H. P. Films, Motion Picture Producers, Karol Bagh, New Delhi, since 1965. Prem Sharma, Public Witness . 5, of H. P. Films stated in court that he used to get film strips with a full leica frame of 35 mm. prepared from Bombay Film Laboratories. He did not speak of any half-cut films. The plaintiff also examined Gordhanbhai G. Patel of Bombay Film Laboratories on commission at Bombay. He stated that the film strips of the plaintiff were half the cinema size films while the film strips brought by Prem Shurma to him were of full size. Therefore, it is obvious that at no stage were film strips, as claimed by the plaintiff to be his patent, produced or got produced by the defendants prior to 1967. Therefore, on tins. point also, the plaintiff's patent is valid.

(22) It was urged on behalf of the defendants that although full films were got produced by him, these could be medially cut and used. In other words, the defendants had anticipated what has been claimed by the plaintiff as his invention. To establish this it had to be proved by the defendants that in some prior publication there is found information about the alleged invention more or less similar to what is claimed by the plaintiff. Mere possibility of such a thing being made is of no consequence. A new invention may consist of a new combination of all integers so as to produce a new or important result or may consist of altogether new integers. The claim for anticipation has to be either by prior user or by prior publication. As was held in Martin and Biro Swan Ltd. v. H. Milwood Ltd., 1956 R.P.C. 125 (10) by the House of Lords, the defendants must show that in some prior publication there is to be found information about the alleged invention

> "EQUAL for the purposes of practical utility to that given by the patent in suit. It is not enough, to use the familiar metaphor which has perhaps been run to death, to make a mosaic of prior publications and to say that thus the whole invention has been already disclosed. This is particularly the case wherthe invention is said to consist of a novel combination, or as is sometimes said, a new functional inter-relation of integers. . ."

(23) The process of photography mentioned in the specifications and the claims, in our view, unduly prolific, does not detract from the essential features of the plaintiff's invention of which, as has already been held by us, there is neither anticipation nor prior user.

(24) The effect of the grant of a patent is quid pro quo. quid is the knowledge disclosed to the public and quo is the monopoly granted for the term of the patent. Section 12 of the Patents and Designs Act, 1911 sets out that a patent once granted confers on the patentee the exclusive privilege of making, selling and using the invention throughout India and of authorising others so to do. This is the quo. The quid is compliance with the various provisions resulting in the grant of the patent. The very simple device upheld in John Lord Hinde v. Osborne Garrett, and Co., 1884(1) R.P.C. 221. (11) and an infringing hair-pin was held as piracy of the plaintiff's invention with the following observations :--

> "THE inventor says, I ask you, the public, or rather I ask the Crown, to give me a monopoly for a certain number of years, and in consideration of their giving me that monopoly I will tell them in my specification the nature and manner of using the invention I claim, and therefore, at the expiration of the time that is guaranteed for my mono-poly the public will be the gainers because they learn how to do this. If a man obtains a patent, and thus obtains a monopoly, it makes no difference that somebody clse who has not got a patent has thought of the same thing and has used it. He is not permitted to do that where the monopoly has been secured to an inventor."

This law is codified in India by the provisions already ferred to.

(25) The patented article or where there is a process then the process has to be compared with the infringing article or process to find out whether the patent has been infringed. This is the simplest way and indeed the only sure way to find out

whether there is piracy. This is what was done in the hair-pin case. above-referred lo, and is. Indeed, always done. Unessential features in an infringing article or process are of no account. If the infringing goods are made with the same object in view which is attained by the patented article, then a minor variation does not mean that there is no piracy. A person is guilty of infringement if he makes what is in substance the equivalent of the patented article. Some trifling or unessential variation has to be ignored. There is a catena of authority in support of this view. We need not cite all those cases which were brought to our notice at the Bar. Suffiee it to quote the words of Lord Denning, M. R. in Beecham Group Limited v. Bristol Laboratories Ltd. and another, 1967 (16) R.P.C. 406 (12) :-

> "THE evidence here shows that in making hetacillin in the United States the defendants use a principal part of the processes which are protected here by the English patents. The importation and sale here is prima facie an infringement. There is a further point. A person is guilty of infringement if he makes what is in substance the equivalent of the patented article. He cannot get out of it by some trifling or unessential variation..... On the evidence as it stands, there is ground for saying that hetacillin is medically equivalent to ampicillin. As soon as it is put into the human body, it docs, after an interval, by delayed action, have the same effect as ampicillin. In these circumstances, I think there is a prima facie case for saying there was an infringement. The process is so similar and the product so equivalent that it is in substance the same as ampicillin."

(26) We have seen the viewers marketed by the defendants and the viewers produced by the plaintiff. The viswers marked and kept on the record as (1), (1A) Mecorama and a fourth viewer arc definitely objects produced by piracy of the plaintiff's patent. The defendants have made certain variationsn its viewers but these are unessential; and what the defendants market is substantially the same thing, as was conceived by the plaintiff. By trifle variations if the effect obtained by the defendants is the same, and we hold that it is the same, then according to the rule enunciated in the Ampicillin case, referred to above, there is a clear piracy. The idea of the plaintiff which is a novelty is clearly infringed.

In any case, the infringement is admitted by defendants 1 and 2. We have dealt with this matter in detail because defendant No. 3 has put in appearance at the last stage but does not admit infringement. Therefore, we hold that there is clear infringement of the plaintiff's patent, which we have delineated above.

(27) The infringement having been proved and admitted by defendants 1 and 2, an order of injunction and accounts must follow. The law on this point must first be noticed.

(28) Section 20 of the Act of 1911 laid down that there will be a Register of Patents maintained in the Patent Office wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents and of amendments, extensions and revocations of patents and such other matters affecting the validity or proprietorship of patents as may be prescribed. The Register of Patents shall be prima facie evidence of any matters by that Act directed or authorised to be inserted therein. Section 32 of the Act provided as under :-

> "32.Certificate of validity questioned and costs thereon.-in a suit for infringement of a patent the Court may certificate that the validity of the patent came in question and if the Court so certifies, then in any subsequent suit in that Court for infringement of the same patent the plaintiff, on obtaining a final order or judgment in his favour, shall, unless the Court trying the suit otherwise directs, have his full costs, charges and expenses of and incidental to the .said suit properly incurred."

Section 33 reads as follows :-

> "TRANSMISSION of decrees and orders to the Controller.-A Court making a decree in a suit under section 29 or an order on a petition under section 26 shall send a copy of the decree or order, as the case may be, to the Controller, who shall cause an entry thereof and reference thereto to be made in the register of patents."

Section 151 of the Patents Act, 1970 reads as under :-

> "151.Transmission of orders of Courts to Controller.-(1) Every order of the High Court on a petition for revocation including orders granting certificates of

> validity of any claim shall be transmitted by the High Court to the Controller, who shall cause an entry thereof and reference thereto to be made in the register. Where in any suit for infringement of a patent or in any suit under section 106 the validity of any claim or a specification is contested and that claim is found by the Court to be valid or not valid, as the case may be, the Court shall transmit a copy of its judgment and decree to the Controller who shall on receipt thereof cause an entry in relation to such proceeding to be made in the prescribed manner in a supplemental record. (3) The provisions of sub-sections (1) and (2) shall also apply to the Court to which appeals are preferred against decisions of the Court referred to in those sub-sections."

(29) Therefore, a proper order has to be drawn up in the present case and transmitted to the Patent Office.

(30) Apart from admitting the patent, as claimed by the plaintiff, defendants 1 and 2 also admitted infringement thereof and prayed that a decree declaring the validity of the patent of the plaintiff with an injunction against the defendants be passed prohibiting them from infringing such patent. With regard to the claim for accounts and damages the plaintiff and defendants 1 and 2 agreed that out of the sum of Rs. 15,000 deposited by defendants 1 and 2 by way of security in this court a sum of Rs. 5,000 be refunded to defendants 1 and 2 with proportionate interest thereon and the balance be paid to the plaintiff in full and final satisfaction of all claims of damages and accounts for the past period. We, accordingly, hold that the plaintiff is entitled to the balance of the amount in deposit in this court after payment of Rs. 5,000 and proportionate interest thereon to defendants 1 and 2 by way of full and final satisfaction of all claims of damages and for accounts against defendants 1 and 2. As against defendants No. 3 who has been proved to be a seller of infringing viewers a decree for accounts is passed. A preliminary decree for accounts is passed. The final decree will be made up after a Local Commissioner has gone into the accounts and submitted a report. Against all three defendants a declaration is given about the validity of the patent of the plaintiff, as claimed and set out by us hereinabove, and an injunction is issued restraining the defendants from in any way infringing the said patent of the plaintiff during its turn or extension thereof. The

plaintiff/appellant would also be entitled to delivery up order of infringing articles and dies in accordance with the delivery up order to be made by the court.

(31) The patent law being rather technical, it will be but proper that we set out the formal final order in our judgment itself. We can do no better than to refer to Dunlop Pneumatic Tyre Co. Ltd. v. Cliton Rubber Co. Ltd., 1903 (2) R. P. C. 393 (13) for the correct form of the order. This order will be communicated to the Patent Office by the Registry of this Court, as required by Section 151 of the Act of 1970, along with copies of the judgment and decree. Before we draw up the order, we would like to clearly state that the case of revocation of the patent put up by the defendants stands disproved, not only by the admissions but in view of the discussion of evidence hereinabove.

(32) We might also notice that once defendants 1 and 2 admitted the validity of the patent of the plaintiff/appellant and violation thereof at the hearing before us, the plaintiff/appellant as a matter of gesture of goodwill towards defendants 1 and 2 agreed to enter into an agreement with them to supply film strip viewers manufactured by his patented process and defendants 1 and 2 agreed to take such viewers only from the plaintiff/appellant and market the same. They entered into an agreement in this behalf dated January 17, 1977, which was recorded by his. This agreement, however, is only for one year but the effect of it is that defendants 1 and 2 admit the patent of the plaintiff/appellant and earlier violation thereof by them. they have also agreed to market the viewers manufactured by plaintiff/appellant or in other words become distributors of viewers manufactured by the plaintiff. This aspect needs also to be recorded in the formal order and com-municated to the Patent Office. We, therefore, draw up the formal order as under :-

> "THIS court does order that R.F.A. (CS) 2 of 1973 is allowed, and the judgments of the trial Court dated December 15, 1972 and January 27, 1975 are discharged. The plaintiff having raised the question of the enforcement of his patent, the same being upheld, the defendants by themselves or through their

servants and agents are restrained during the continuance of patent No. 111926 dated August 11, 1967, or any extension thereof from infringing the said patent of which the plaintiff is the owner. The patent claimed by the plaintiff and construed by this Court, is that the plaintiff/appellant is the owner of the patent which is in a medially cut positive 35mm printed film (with one or plurality of picture) and its use in combination with viewers specially adapted for the use of such medially cut strips, so as to get a virtual image of the same size as the virtual image of normal 35mm frame. The patent thus is also in a half cut 35mm positive film and the viewers with such film fitted therein. It is further ordered that an enquiry be made what damages have been sustained by the plaintiff by marketing of the infringing viewers by defendant No. 3, the claim of damages and accounts against defendants 1 and 2 having been satisfied in accordance with what is stated in our judgment hereinabove; and it is further ordered that defendants 1 and 2 do within 10 days hereafter make a full and sufficient affidavit slating what infringing viewers, films, dies arc in their possession, custody or power; and it is ordered that the defendants do within 10 days after filing of the said affidavit deliver upto the plaintiff the infringing viewers, films and dies in consonance with the court proceedings and orders passed on January 24, 1977. Costs of the proceedings will be borne by the parties themselves. This court hereby certifies, pursuant to Section 151 of the Patents Act, 1970, that the plaintiff has proved the particulars of breaches and defendants 1 and 2 have failed to prove their claim for revocation of the patent. And it is further ordered by this court the agreement between the plaintiff and defendants 1 and 2 executed on January 17, 1977 has been recorded by court, copy of which is Annexure 'A' to the formal order."

(33) The appeal is disposed of in terms of the above order.