IN THE HIGH COURT OF DELHI

DATED: 25.08.1980

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THE HONOURABLE MR. JUSTICE J.D. JAIN

Surendra Lal Mahendra ... Plaintiff

Vs.

Jain Glazers and Ors. ... Defendants

JUDGMENT

J.D. Jain, J.

(1) The facts germane to the disposal of this application underorder 39, Rule 1 and 2 read with s. 151 of Code of Civil Procedure for ad interim injunction concisely are that the plaintiff has instituted a suit for permanent injunction restraining the defendants and their ser- vants, or agents etc. from infringing in any manner, patent No. 143964 dated 21st July, 1976 entitled 'Laminating Apparatus' of which he claims to be proprietor and patentee, by manufacture, sale or offering for sale or using any apparatus for producing a laminate according to the said patent and for rendition of accounts. It is averred that the invention known as 'Laminating Apparatus' relates to an apparatus for producing a laminate by wet process as distinguished from dry process; plaintiff being already grantee of patent No. 142811 dated 14th November, 1974 and patent No. 143168 of 1st of October, 1975 which are also in respect of an invention for laminating apparatus but by dry process. He asserts that an object of this invention i.e. patent in question, is to propose a modified construction of a laminating machine using the wet process and another object of thereof is to propose a laminating machine using the wet process and which is efficient.

(2) Claim No. 1 of this patent is reproduced below for ready reference: "Alaminating apparatus comprising a plurality of guide rollers provided between a film feed roll and laminating rollers, means for applying an adhesive on said film. said means disposed between said feed roll and laminating rollers, and such to to provide a coating of an adhesive on one side of said film, said laminating roller being pressure and guide rollers for laminating the film on to a substrate characterised in the one of the said guide rollers constitute a heated roller and is provided in between the adhesive applying means and the laminating rollers in order to dry the applied adhesive on the said film."

It is further contended that the said patent is valid, subsisting and in force and it shall remain in force for a period of 14 years from the date of said patent and as such the plaintiff has exclusive right to the sale, use and manufacture of the construction claimed in the said patent, by virtue of the provision contained in Section 48(1) of ..he Patent Act, 1970 (hereinafter referred to as the Act). The plaintiff has; however, granted a license to manufacture and sell the laminating apparatus to M/s. industrial Plastic Company, a partnership firm and the latter has manufactured several laminating machines for the purpose of laminating substrates for their events. However, defendants 1 and 3, defendant No. 3 being a partner in defendant No.1, used to entrust laminating job by giving their substrates for lamination to M/s. Industrial Plastic Co. like other clients and they used to visit the factory of the said concern in this connection. During his visits to the factory of Industrial Plastic Co., defendant No. 3 somehow managed to get the know-how of the plaintiff's invention and he has mischievously copied the same. It was towards the end of April, 1979 that the plaintiff came to know through M/s. Industrial Plastic Co. that defendants 2 and 3 had manufactured atleast one such apparatus which was identical to that of patent No. 143964 of the plaintiff and that the defendants were using the infringing apparatus for executing job work of their clients who were formerly getting their work done from the plaintiff's licensee M/s. Industrial Plastic Company. Thus according to

the plaintiff, the said manufacture and use of the laminating apparatus by the defendants constitutes an act of infringement of his patent.

(3) "THE suit as well as this petition is resisted by the defendants/ respondents who deny the claim of the plaintiff to be proprietor of the patent in question. They assert that the said patent was already known, published and used in India as well as throughout the world, prior to the date of the application in this case. Even the literature, illustrations and such-like laminating machines were available in India before the priority date. In particular they have averred that Morame Maxibond laminating machines which were,being manufactured by M/s. Morane Plastic CO. Ltd, England and which have exactly the same system of working as that claimed by the plaintiff in his claim were being imported into India much before the priority date of the plaintiff. It is contended that a comparison of patent specifications No. 1181161 of M/s. Morane Plastic Co. Ltd. and that of the plaintiff's No. 143964 . will clearly reveal that the plaintiff is guilty of purloining the laminating system from Morane Maxibond Machine and specification and has falsely claimed to be an inventor of the said appalatus. Further the plaintiff has not disclosed in the patent specification as to what was the laminating apparatus already available and what was the modification and distinct improvement made and utility imparted by the plaintiff to the existing apparatus/device when he applied for registration of the patent. According to them the complete specification furnished by the plaintiff is vogue, unintelligible and jugglery of words. Thus the specification does not state what is the modified construction embodied in the patented apparatus. In other words wet laminating apparatus being already known and used in India previous to priority date there was no inventive step and there was no novelty or utility in the patent and the claim made by the plaintiff was false to his knowledge. The defendants have also lodged a counter claim for revocation of the patent in question on the ground that it is invalid and has been wrongly registered for the reasons mentioned above and as such it is hit by Section 64 of the Act. Lastly the defendants assert that their machine is an indigenous apparatus and does not constitute infringement of

the plaintiff's patent, inasmuch as the actuating components of their machine are entirely different from the plaintiff's machine and have been designed by Subhash Chander defendant No. 3 himself from the well known existing machines available in India before the priority date.

(4) I have heard the counsel for the parties at length and bestowed my careful thought and consideration on the contentions raised by the respective counsel for the parties. The plaintiff also explained the whole system of his laminating apparatus with the aid of the drawing accompanying the complete specification. Similarly the defendant's counsel elucidated the working of the laminating machine devised by them with the help of the drawing and the photograph filed by them.

(5) It may be stated at the outset that the plaintiff's patent is in respect of an improved version of the existing laminating apparatus. Section 2(1)(j) of the Act defines "invention" which inter alia includes any new and useful improvement of any art, process, method or manner of manufacture or machine apparatus or other article etc. Thus to be patentable an invention besides being a new manufacture must also be useful. The submission made by the learned counsel for the defendants precisely is that the plaintiff's so-called invention .does not satisfy any of these essential prerequisite for a valid patent, inasmuch as it is neither a case of novelty reflecting any skill and ingenuity of the inventor nor is it more useful or beneficial in its working; rather it suffers from obviousness and 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 within the meanings of Clauses (e) and (f) of Section 64(1) of the Act.

(6) Chapter Iv of the Act lays down an elaborate and comprehensive procedure for examination of the application for grant of patent and investigation of the claim. It inter alia envisages a search for anticipation by previous publication or by prior claim among the documents envisaged in Section 13 of the Act. These

documents comprise specifications whether published in India or abroad and the text books and periodicals published any where relating to the art in question, the only limitation being that they should have been published before the date of filing of the applicant's complete specification. It is only after the examination and investigation as contemplated in Sections 12 & 13 of the Act is over that on consideration of the report of the examiner etc. the Controller is supposed to accept the complete specification and give notice thereof, to the applicant and advertise the same in the Official Gazette. Even thereafter the Controller awaits application for opposition to the grant of patent for four months. Significantly, there was no opposition to the grant of the patent to the plaintiff in the instant case as envisaged in Section 25 of the Act. Hence, it has been pervently canvassed by the learned counsel for the plaintiff that an inference will be well warranted that ex facie the Controller did not find the claim in the complete specification submitted by the plaintiff to be invalid on account of anticipation or prior publication or prior claim, as embodied in any complete specification. Further, it can be safely assumed that the complete specification and claim, of patent No. 1,181,161 of M/s. Morane Plastic Co. Ltd., complete specification of which was published on 11th February', 1970 and was received in India on 31st December, 1970 too must have been scrutinised by the examiner in the Patent Office as required by law but the latter evidently did not find the patent of the plaintiff to be an act of purloining as alleged. In other words the Controller before accepting the patent must have satisfied himself that the claim and the specification etc. involved inventive step and that the invention claimed was patent- able under the Act. However, this argument, although specious on its face, is not tenable as it runs counter to the specific provisions contained in sub-section 4 of Section 13 of the Act which clearly lays down that the examination and investigation required under Sections 12 and 13 shall not be deemed in any way to warrant the validity of any patent. Thus despite all the safeguards and .circumspection contemplated in various provisions of the Act against grant of patent in respect of a spurious, purloined or fake invention, the legislature

minced no words in clarifying its intendment that no presumption of validity would attach to a patent granted by the Controller under the Act, notwithstanding examination and investigation made under Sections 12 and 13 thereof.

(7) In Smith vs. Grigg Ld. 41 R.P.C. 149(1), it was observed by Atkin L. J. that : "THEmere fact of the granting of a patent is not in itself an indication that the plaintiff has established to the satisfaction of any authority that he has the right to the monopoly which he claims. In a case of a patent therefore, the mere fact that a patent has been granted does not show that those conditions have been performed which alone entitle a plaintiff to a conclusive right, and therefore, the Courts when they are approached by a. plaintiff who says : "I am the owner of a patent, and the defendant has infringed it," say where the patent is of a recent date; "Your right is not established sufficiently by the mere fact that a patent has been granted to you"; and unless there is some. kind of substantial case evidenced before the Court that there is infact a valid patent, then the Court refuses to grant an injunction."

Scrutton LJ. who constituted the Bench along with Atkin L.J. too observed that: "THEREis in patent cases a well recognised rule of practice in the Courts which deal with patent cases as to interiocutory injunctions and it is this that where the patent which you are seeking to enforce is a recent patent, an interlocutory injunction is not granted where there is a genuine case to be decided".

His Lordship further observed that- "WHENyou find a recent monopoly which there- has not yet been time to challenge sought to be enforced, the Court is inclined to take the view as a general rule, unless there are special circumstances to overcome it, that the tit ie to the monopoly must be established before it interfers by introlocutory injunction."

(8) Only recently a similar question cropped up before the Supreme Court in M/s. Bishwanath Prasad Radhey Shyam vs Hindustan Metal Industries, and it was contended that there was a presumption in favor of the validity of the patent but this argument was spumed by their Lordships with the observations that : "IT

is noteworthy that the grant and sealing of the patent, or the decision rendered by the Controller in the case . of opposition, does not guarantee the validity of the patent, which can be challenged before the High Court on various grounds in revocation or infringement proceedings. It is pertinent to note that this position, viz. the validity of a patent is not guaranteed by the grant, is now expressly provided in Section 13(4) of the Patents Act, 1970. In the .light of this principle, Mr. Mehta's argument that there is a presumption in favor of the validity of the patent, cannot be accepted."

(9) Thus, it is manifestly clear that the plaintiff has to make out a prima facie case about the existence of his monopoly right and its infringement by the defendant independently of the grant of patent as such to him. So it matters little that under Section 48 of the Act the patentee has the exclusive right by himself, his agents or licensee to make use, exercise, sell or distribute the patented article in India.

(10) Coming to the merits of the case, it may be pertinent to mention that the plaintiff was called upon personally to explain, what novelty or inventive step was involved in his patent vis-a-vis the apparatus of Maxibond Laminating machine manufactured by Morane. A perusal of complete specification furnished by the plaintiff in conjunction with the drawing of the patented apparatus would illustrate the process of producing a laminate with it. Broadly speaking, it consists of two parts. A glance at the drawing would show that the laminating machine comprises a substrate feeding means consisting of a conveyor belt adapted to traverse on an idle roller B1 and a drive roller B2. Eventually the substrate say, a sheet of paper, is fed into the nip of a pair of laminating rollers D1 and D2. Of these, the latter is a pressure roller and heating means may be provided with the sams. D1 is a' fixed roller. The other constituent of the laminate is a plastic film which is adapted to have a coating of a wet adhesive applied thereon prior to being fed into the nip of the laminating rollers. As the illustrative drawing would show the film marked H traverses from film loading roller G. It passes by an adhesive tank marked J and adhesive solution stored

therein is applied to the surface of the film with the help of adhesive applicator roller marked M and pressure applying rollers K1 and K2. Roller M is adapted to rotate in the anticlock-wisc direction, when tha film H traverses towards the right hand direction. The coated film H then traverses over heated drum roller marked P so as to dry the surface having adhesive coating and it then passes through a bow roller Q which is designed to remove any sag present in the film and thus prevent the possibility of creasing in the lamination. The bow roller 0 effects a proper stretching of the film as a tensioning device. Thus the coated film together with the substrate is fed into the nip between rollers Dl and D2 in order to cause a lamination. The lamination in the form of a continuous sheet is then wound on receiver drum R.

(11) A juxta-position of this drawing, with the drawing of Morane Maxi machine would reveal that the art/process of manufacture of a laminate thereby is almost identical. A comparison of working system of both these machines has been aptly made on the sheet bearing page No. 53 of the documents file. It would be seen that conveyor belts and the laminating rollers etc. are shown at points 14, 37, 41, 42, 43, 34 and 33. Similarly the film loading roller, plastic film, adhesive solution tank, adhesive applicator roller and the heated drum are indicated at points 9, 10, 28, 12 and Ii etc. However, as pointed out by the learned counsel for the plaintiff there is no such thing as bow roller Q in the Morane machine. It is not disputed that both these machines deploy wet-process for producing laminate. On a visual comparison of the drawings etc. and reading the salient features and the technology involved in the process of producing laminates by both these machines, I am unable ex facie to find any fundamental or glaring difference in the two. The learned counsel for the plaintiff has laid great stress on the fact that there is no such contrivance as bow roller Q (provided in the patented apparatus of the plaintiff) in the Morane machine. However, I have grave doubts if the provision of the bow roller would make even the slightest difference. As claimed in the complete specification, the bow roller is designed to prevent the possibility of creasing in the lamination and it effectes a proper

stretching of the film. To me it apears that a provision for such a device is necessary in the patented apparatus because it is rectangular in shape and the traverse of the film is both horizontal as well as vertical before it reaches the nip of the laminating rollers. This may entail sagging of the film at some stage due to application of wet adhesive. However, necessity for such a device is completely obviated in Morane Machine because the traverse of the film from the heated drum to the nip of the laminating rollers is straight and downwards. Hence, the tension in the film can be well maintained and its path regulated by sheer centrifugal force of the heated drum, and there is no likelihood of the. film sagging before reaching the nip of the laminating rollers. Indeed, the plaintiff impliedly concedes this proposition when he states in the specification that "any suitable adjustment means may be used" while referring to the role played by the bow roller.

(12) Another improvement claimed on behalf of the plaintiff is that traverse of the film from the loading roller is from the bottom in the patented contrivance while it is from the top in Morane machine. I wonder if that would make any difference whatsoever and would constitute a distinct improvement. The learned counsel for the plaintiff, however, frankly conceded that the art of applying adhesive to one side of the film is almost the same in both the. apparatuses. He also admitted that the liquid based adhesive is used in both these machines. However, he has pointed out that the base in the case of Morane apparatus is a solvent which does not dissolve in water without the help of a Chemical and not water as in the case of plaintiff's machine. I again fail to see what difference would it make. In this context I may also add that Morane machine appears to be much more advanced in technology inasmuch as it has many sophisticated appliances and its mechanism is somewhat intricate. For this instance it has an automatic hot air blower for drying process .which does 'not exist in plaintiff's patent. Further, Morane has an electrically heated oil filled roller at the laminating point but the same does not exist in the plaintiff's machine. Still further Morane has got all speed variable drive motor for operating automatic

feeder and speed adjustment. On the other hand the plaintiff has used a U-belt pulley for reducing the speed of the motor i.e. by using one big and one small pulley. Thus it would appear that the plaintiff's patent is nothing more than an indigenous combination of certain integers which form part of Morane machine designed to be a less expensive and cheaper apparatus. No doubt it may be termed as simplification of the apparatus to some extent but it is difficult ex facie to say that it involves an exercise of inventive step or inventive faculty. No doubt, he has produced a workable machine but it incorporates almost all the integers and components of Morane machine. So it cannot be said that .he has added a scintilla of invention, to produce the same. On his own showing, the plaintiff had to handle a couple of Morane machines which were not found to be workable in India and therefore, his services had to be secured by the parties concerned as a skilled technician to put the same in working order. It is thus no wonder that having tried his hand on Morane machines, he was able to devise an apparatus of his own by virtually copying the same process and making some alterations and adjustments here and there so as to obviate the necessity of sophisticated and costly integers used by Morane.

(13) As observed by the Supreme Court in M/s. Biswanath Prasad Radhey Shyam's case (Supra) : "IT is important to bear in mind that in order to be patentabic an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; ana must independently satisfy the test of invention or an 'inventive step'. To be patentable the improvement or the combiniation must produce a new result, or a new article or a better or cheaper article than before. The combination of old, known integers may be so combined that by their working inter-relation they produce a new process or improved result. Mere collection of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent. It is not enough, said Lord Davey in Rickmann vs Thierry that the purpose is new or that there is novelty in the application, so that the article produced is in that sense, new but

there must be novelty in the mode of application. By that, I understand that in adopting the old contrivance to the new purpose, there must be difficulties to be overcome, requiring what is called invention, or there must be some ingenuity in the mode of making the adoption. As Cotton, L. J. put it in Blackey vs. Lathem, 'to be new in the- patent sense, the novelty must show invention'. In other words, in order to be patentable, the new subject-matter must involve 'invention' over what is old. Determination of this question, which in realty is a crucial test, has been one or the most difiicult aspects of Patent Law, and has led to considerable conflict of judicial opinion.'

(14) From a conspectus of foregoing facts, it cannot bo held by any stretch of reasoning at this stage that the invention claimed by the plaintiff involves something which is outside the probable capacity of skilled craftsman having regard to what was already known in the country. Certainly, it cannot be said to be either anew manner of manufacture or a distinctive improvement on the old contrivance involving novelty or inventive step, having regard to what was already known and practiced in the country.

(15) To sum lip, therefore, I am of the considered view that the plaintiff has failed to make out a prima facie case entitling him to ad interim injunction asked for. The learned counsel for the defendant has candidly conceded that the defendants are not manufacturing any laminating machine for sale and they are simply using it for their own business. So it can be taken for granted that the defendants are not going to manufacture any laminating apparatus for sale to anyone else and they shall be using the apparatus already manufactured by them for their own business. Hence, ends of justice would be well met if status quo is maintained, subject of course to the condition that the defendants are put to terms on equitable basis.

(16) As a result, the ex parte injunction granted vide order dated 6th of June, 1979 is hereby vacated but the defendants and directed to maintain status quo and furnish accurate and correct quarterly statement of accounts to this Court

with regard to their business vis-a-vis laminating apparatus already manufactured by them. However, they shall not manufacture any new laminating apparatus. The first statement of accounts shall be furnished by or before 30th of September, 1980. covering the entire period uptil 30th June, 1980. The subsequent statements for each quarter shall be furnished within the next succeeding month. The defendants shall also furnish security /indemnity bond in the sum of Rs. 50,000.00 to the satisfaction of the Registrar for payment of damages to the plaintiff, if any, which he may be eventually found to be entitled.