INTELLECTUAL PROPERTY APPELLATE BOARD

Guna Complex Annexe-I, 2nd Floor, 443, Anna Salai, Teynampet, Chennai-600018

(CIRCUIT BENCH SITTING AT MUMBAI)

M.P. NO.73 OF 2011, M.P. NO.7 OF 2012, M.P. No.16/2012 AND M.P. NO.22 OF 2012
IN
ORA/18/2010/PT/MUM
AND
ORA/18/2010/PT/MUM

TUESDAY, THIS THE 12th DAY OF JUNE, 2012

Hon'ble Smt. Justice Prabha Sridevan … Chairman

Hon'ble Shri D.P.S. Parmar … Technical Member (Patents)

Tata Chemicals Limited,
A Company organized and Existing under
the Laws of India, Having its Address at
Bombay House, 24, Homi Modi Street,
Mumbai – 400 001, Maharashtra … Applicant

(By Advocate Shri P.S. Raman, Senior Advocate
and Shri Essenese Obhan)

Vs.

1. Hindustan Unilever Limited,
Now known as Hindustan Unilever Limited,
A Company incorporated under the Companies Act,
1956, Having its Registered Office at Unilever House,
B.D. Sawant Marg, Chakala, Andheri East,
Mumbai – 400 099, Maharashtra

(Respondent Name and address amended as the per the order of the Board dated 12.06.2012 in M.P. No.16 of 2012)

2. The Controller of Patents and Designs,
Intellectual Property Office,
Boudhik Sampada Bhawan,
S.M. Road, Antop Hill,
Mumbai – 400 037,
Maharashtra. …Respondents

(By Advocate - Shri S. Majumdar for R-1)

ORDER (No.166 of 2012)

Hon'ble Smt. Justice Prabha Sridevan, Chairman:

1. The Applicant seeks revocation of the invention of Patent No.195937 titled "Filter Device" filed on August 7, 2002 and granted on August 26, 2005 to the respondent No.1.

2. The impugned patent specification of Indian patent No.195937 titled "Filter Device" (Invention in short) is for a "filter cartridge".

3. The Invention relates to a filter cartridge for use in gravity-fed filtration "in particular to a novel filter cartridge which would facilitate gravity flow filtration at constant flow rate even with increased literage of water through the cartridge maintaining effective filtration characteristics".

4. First we will look at the pleadings relating to the Invention itself.

5. It is admitted that "the use of filter cartridges in water filtration systems including gravity fed filters is well known and extensively in use".

6. This is the summary of the Invention.

"Thus according to present invention there is provided a filter cartridge comprising:

- at least one inlet for the water to be treated communicating with a downwardly extending hollow passage adapted for free

gravity flow of water there through:

- said hollow passage at its lower end operatively connected to at least one filter media such that water flows through said hollow passage and enters the lowermost of said filter media at its lower end to travel upwards through the respective filter media such that any entrapped air in said filter media is easily released out of the filter cartridge along its natural tendency to move up during said passage of water through said filter media in the upward direction;

- at least one outlet means for exiting the thus filtered water from said filter media;"

7. So, "In the above disclosed construction of the invention, the resin bed and filter media are encountered by the water in the filter cartridge only during its upward flow whereby the entrapped air, if any, in the resin/filter bed get released through the top outlet along its natural tendency to move up without facing resistance of any counter flow of the water. On the contrary the flow of water in the upward direction further facilitates such release of entrapped air in the system of the invention. Such a construction provides for controlled uniform flow of the water through the filter cartridge of the invention and generating quality water even after extensive use".

8. The detailed description of the Invention reads thus:

"In accordance with a preferred aspect of the present invention the filter cartridge comprises:

- atleast one inlet for water to be treated operatively connected to a substantially vertical tubular hollow passage for free gravity flow of water there through;

- said tubular hollow passage at its lower end operatively connected to a first annular resin chamber concentrically disposed with respect to said tubular hollow member;

- a second concentrically disposed annular chamber comprising activated carbon filter media provided over said first concentric annular resin chamber and operatively connected to the later;

- said water entering the filter cartridge through the vertically disposed tubular hollow passage adapted to traverse said tubular passage free of any filter media to be forced vertically upwards from its lower end through said resin chamber and thereafter through said activated carbon chamber to finally exit out of the cartridge as the filtered water.".

9. According to the respondent, this invention achieves (a) uniform flow; and (b) avoidance of channelling of the water in the filter media due to entrapped air by providing for a hollow substantially vertical passage of water into the filter cartridge such that the water to be filtered encounters the filtration media only when traversing upward. This facilitates the release of entrapped air if any along with the water at the exit outlet because the entrapped air on its way upward does not meet any counter current of water.

10. According to the respondent, if this configuration is maintained, the upward flow of water can be achieved with various embodiments of filter cartridges and variety of filter media can also be used.

11. The respondent has explained the objects and advantages of the invention by examples, which are stated to be non-limiting. Figure 1 is a sectional view of an embodiment of the filter cartridge in accordance with the present invention and Figure 2 is a sectional view of a conventional filter. Figure 1 and 2 are schematic representations and are not to scale.

12. As illustrated in Figure-1, the filter cartridge of the invention comprises a modified construction whereby the path of ejection of the entrapped air in the filter/resin chambers is achieved in the upward direction along with the flow direction of the water in the resin/filter media keeping in view the natural tendency of air being lighter than water to follow an upward path.

13. The water passes through the hollow central tubular passage (TP) and thereafter near its bottom end it traverses through an "U" path into a first annular concentric chamber (FCC) constituting a resin bed. After passing through the resin bed the water is allowed to travel upward into the second annular activated carbon chamber (SCC), which is again a concentric chamber operatively connected to the annular resin chamber.

14. According to the respondent, by this advantageous construction, the air entrapment and channelling are avoided.

15. Figure 2 is a sectional view of a conventional filter which comprises a resin bed (RB) through which the water to be treated is passed in the downward direction. The water then takes a U turn and then passes through an annular chamber filled with activated carbon (AC); the water there through moving in the upward direction before the filtered water exits the filter through the exit provided.

16. Experiments were conducted to determine the flow rate of the filtered water as it passed through the filter cartridges as per Figure 1 and Figure 2 under identical conditions of gravity water head. The two filter cartridges were filled with equal volumes of resin. They were also filled with equal volumes of activated carbon. The performance of the filter cartridges was quantified by determining the flow rate for a total of 54 liters.

17. The data on the performance of the filter cartridge of the invention as per the embodiment in Figure-1 is compared with the performance of a conventional filter cartridge as depicted in Figure-2 and the data is summarized in Table-1.

Table-1

Cumulative amount of water passed (liters)	Average flow rate of the water (ml/min) as per filter cartridge of Fig.1	Average flow rate of the water (ml/min) as per filter cartridge of Fig.2
6	118	53
30	96	31
54	90	20

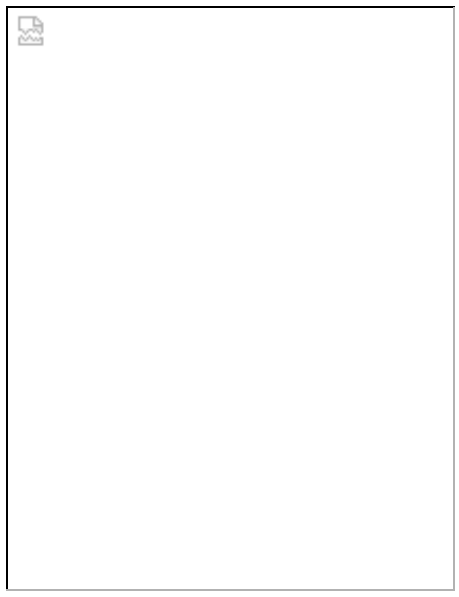


Fig. 1 Schematic presentation of Inventors

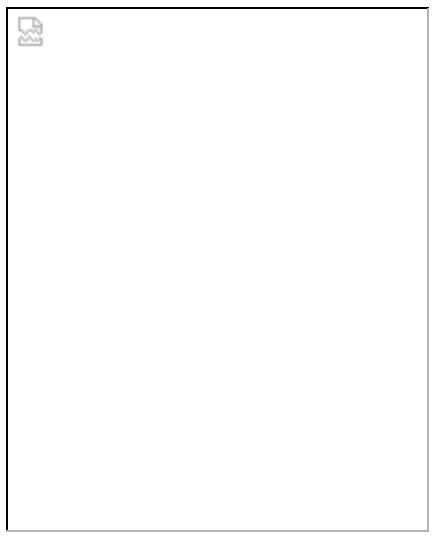


Fig.2 Schematic presentation of Conventional filter

18. What is described as hollow passage is the white rectangular portion with the downward arrow. The filter media are the two shaded portion on each side. The inlet should be at the top of hollow passage from where the water enters the hollow passage. Therefore the water coming down the inlet does not permeate through the hollow passage before reaching the filter media but reaches the bottom of the hollow passage and take the U-turn and enters the filter media from the bottom. Thereafter the water rises upwards, how it flow outwards, is not relevant. According to the counter statement this sequence is what characterized the invention.

19. According to the respondent “It is evident from Table-1 that the flow rate achieved, as per the filter cartridge of the invention is much higher and more sustained over a large volume of water flow as compared to conventional filter cartridges. The quality of water purified with the cartridge as per Figure-1 was comparable to that with the conventional cartridge (Figure-2).”

20. The respondent has claimed that the invention is directed to improve the performance of the filter cartridges especially in achieving controlled constant flow rate with effective filtration even after extended application/use of the cartridge.

21. The claims read as follows:

“We claim:

1. A filter cartridge for the treatment of water which comprises an inlet for the water to be treated, the inlet communicating with a downwardly extending hollow passage adapted for gravity flow of water there through, the hollow passage being connected at its lower end to at least one filter media, and an outlet for exiting treated water from the filter media;

   whereby water flows through the hollow passage and enters the lowermost end of the filter media to travel upwards through the filter media so that entrapped air in the filter media may be released upwards and. out of the filter cartridge during the passage of water through the filter media in the upward direction.

2. A filter cartridge as claimed in claim 1 which comprises a plurality of filter media.

3. A filter cartridge for the treatment of water which comprises an inlet for the water to be treated, the inlet communicating with a substantially vertical tubular hollow passage for gravity flow of water there through, the tubular hollow passage being connected at its lower end to a first annular resin chamber which is concentrically disposed with respect, to the tubular hollow passage, the first annular resin chamber being connected to a second annular chamber provided over the first annular resin chamber and concentrically disposed with respect to the tubular hollow member, the second annular chamber comprising

activated carbon filter media; whereby water to be treated enters the filter cartridge through the tubular hollow passage, is forced vertically upwards from the lower end of the tubular hollow passage through the first annular resin chamber and thereafter through the second annular activated carbon chamber, and exits from the filter cartridge through a water outlet.

22. The Abstract reads as follows:

"FILTER CARTRIDGE FOR THE TREATMENT OF WATER

The present invention relates to a filter cartridge (Fig. 1) for use in gravity-fed water filtration systems. The invention solves the problem of entrapped air in the filter media which has been encountered in prior art filter cartridges (Fig.2). The hollow passage in the construction according to the invention provides for a gravity flow of water into the cartridge which avoids any filter media immediately at the entrance of the water into the cartridge. This facilitates effective free downward flow of the water to be filtered in the cartridge without any pressure drop."

23. In the counter statement filed by the respondent, it is stated that the difference between the prior art and the invention is not only in the upward flow of water through the resin, but also in the presence of hollow space immediately on entrance of water into the cartridge. It is further stated that no invention is claimed in the plurality of filter media, but in the inter play of the hollow passage from the inlet of water to be treated through the filter media and the passage of water through the filter media against gravity and according to the counter statement none of the cited documents teaches a filter cartridge where there is a hollow passage between the inlet and the filter media, such that the water flows under gravity in the hollow passage and against gravity through the filter media to provide improved filtration and to avoid air entrapment.

24. According to the counter statement, the summary clearly states that the hollow passage in the construction provides for a gravity flow of water into the cartridge which avoids any filter media immediately at the entrance of water into the cartridge. This provides efficient down flow without any pressure drop. According to the counter statement, the provision of filter media positioned such that the water meets the filter media only during the up flow solves the problem of the prior art.

25. It is stated that the construction of the device such that water from the inlet does not enter the filter media through the walls of the hollow passage but only from the bottom of the filter media after taking a U-turn after passing through the hollow passage.

26. This revocation is filed by the Applicant which is a public limited company and a reputed business house. It is claimed that it has an Innovation Centre in Pune in 2004 with the objective of developing world class R&D capabilities in new knowledge-based products. The Innovation Centre is said to be currently working on the following areas of activity which *inter-alia* includes Water purification. Clean potable water is a basic human right, but is unfortunately neither conveniently available, nor affordable. Delivering affordable potable water to every citizen is arguably a fundamental challenge of this century. In this context, the Applicant has recently released in the market a unique and innovative water purifier which requires no energy or running water to operate. The purifier, which comes with a replaceable filter, ensures the supply of safe drinking water at an exceptionally low-cost. The Applicant has filed at least 14 patent applications in this regard, including PCT applications, on technology surrounding the water purifier project. Therefore it is stated that the Applicant is a "person interested" and has a *locus standi* in filing the present revocation proceedings.

27. In support of the grounds relied by the Applicant attacking the patent as being anticipated, and obvious and insufficiently described and so on, it also relies on the following documents available in public have been referred to:

No.	Document Number	Filing Date	Title
1.	US 6,387,260	August 20, 1998	Filtration Device for Liquid Purification
2.	US 3,909,402	April 13, 1972	Water Purification Device
3.	US 4,139,473	February 13, 1979	Filter

28. The learned senior counsel Mr. P.S. Raman appearing on behalf of the counsel for the applicant submitted that the invention lacks novelty. According to him the filter inlet, the upward flow through the filter medium were known and anticipated. He referred to the prior arts including US 6387260 (US '260 in short) filed on August 20, 1998. This discloses a filter cartridge that

comprises all the elements present in the Indian patent number 195937 (IN 937 in short), namely,

- an inlet in communication with the lower end of a filter media,

- wherein water travels upwards through the filter media,

- such that air in the filter media may be released upwards during the passage of water through the filter media in an upward direction.

- an outlet for treated water exiting out of the filter media,

29. According to Mr. Raman, the problem solved by US '260 is exactly the same as that identified by the Invention. According to US '260 one of the problems of conventional filters that provide for liquid flow downwardly under gravitational forces is that gas and air bubbles form inside the filtration medium , and cause blocks, making it difficult for liquids to flow through the filter, and sometimes even block the flow of water completely.

30. According to Mr. Raman, it was common general knowledge that if water flowed upwards through the filter media, then the problems faced by the conventional filters which provide for downward flow through the filter medium would be avoided. US '260 already discloses the invention as claimed. There is absolutely no novel contribution to the state of the art by Invention. In fact, as admitted by Respondent No.1, the alleged invention is a modification of a prior system in a manner that has been taught, or an improvement. The information provided by US '260 is for the purposes of practical utility equal to that of the Invention.

31. The learned senior counsel also relied on the US patent number 309402 (US'402 in short) filed on April 19, 1972 which discloses a filter cartridge that also comprises all the elements present in the invention. So according to the applicant, the solution thus provided by both US'402 and the Invention is exactly the same. This prior art also discloses a plurality of filter media, where it says

> "If it is desired to remove both odor -or- color-forming materials and minerals, the granular material may comprise one or more layers of activated carbon followed by one or more layers of ion exchange resins followed by a final layer of activated carbon."

32. So it will be apparent to a person of ordinary knowledge of the subject that US'402 already teaches and discloses the invention as claimed.

33. He relied on the following judgments:

"The notion behind anticipation is that it would be wrong to prevent a man from doing what he has lawfully done before the patent was granted" **[Windsurfing v Tabur (1985) RPC 59 at 77]**.

34. To determine whether a patentee's claim has been anticipated by an earlier publication it is necessary to compare the earlier publication with the patentee's claim in order to see whether the information imparted in the prior document is equal in practical utility to that imparted in the patentee claim **[General Tire & Rubber Co v Firestone Tyre & Rubber Co Ltd., 1972 R.P.C. 457 at 485]**. The process of comparison can be broken down as follows:

> (a) The first step is to construe the prior document as at the date of its publication, in accordance with the normal principles of construction, taking into account of surrounding circumstances, but excluding subsequent documents, information and event, in short, excluding the benefits of hind sight.
>
> (b) The next step is to compare the disclosure in each prior document separately with the disclosure in the patentee's claim, construed in accordance with the principles set out earlier.
>
> (c) The final step is to ask whether, on making the comparison, the prior document discloses the same invention as that disclosed in the patentee's claim.

35. The test whether the disclosure contained in a prior document is such as to invalidate a subsequent invention was stated by **Lord Westbury L.C. in Hills v. Evans (31 L.J. Ch. 457 at p. 463**, also reported in **(1862) 4 De G.F. & J. 288, 288, 45 E.R. 1193**. See also **Armstrong Whitworth & Co. Ltd. v. Hardcastle, 42 R.P.C 543 at p. 555**) in the following terms: *"The antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments... the information... given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent."*

"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 patent. Where something within the claim has been disclosed it did not matter that the disclosure was less preferred. ***[General Tire & Rubber Co v Firestone Tyre & Rubber Co Ltd. [1972 R.P.C. 457] at 485.]***"

36. The case of the respondent is that none of the prior arts teach the invention.

It is evident from the abstract of US'260 that, *"the device is constructed to intake impure liquid at the bottom of the filter and initially to effect flow by filling liquid to above the filter outlet near the top, and maintaining flow thereafter by virtue of the present of low internal pressure that develops as the liquid passes through the system.:*

37. According to the respondent, US '260 works by the combined effect of gravity and siphon mechanism and if the inventor had removed the siphon mechanism and achieved the same result there was an inventive step in the Invention.

38. According to Mr. S. Majumdar, the learned counsel for the respondent, US'402 is an online device where it is connected to a source of tape water. The water flow is adjusted to a particular rate of about 12 to 20 gallons/hr. On the other hand, the impugned patent does not work under pressure control. The two approaches are different and it was submitted that the impugned patent is not anticipated by US'402. According to the learned counsel the ground of anticipation requires that there would be lack of novelty only if the claimed subject matter was derivable as a whole directly or unambiguously from a prior art disclosure.

39. He relied on the following judgments:

i) T0411/98
ii) The General Tire & Rubber Company vs. The Firestone Tyre & Rubber Co. Ltd and others [1972] R.P.C.
iii) Verathon Medical (Canada) ULC v. Aircraft Medical Limited [2011] CSOH

i) T 0411/98

The Board of Appeal of the European Patent Office in the case of Kimberly Clark Corporation v. Molnlycke AB lays down in paragraph 4.1 as under:

4.1 A claimed subject matter would lack novelty only if it were derivable as a whole directly or unambiguously from a prior art disclosure and if a "clear and unmistakable teaching" of the combination of all claimed features (and not only the essential ones) could be found in said disclosure.

ii) In General Tire & Rubber Co. Ltd., Sachs LJ:

"If the earlier publication, so construed, discloses the same device as the device which the patentee by his claim, so construed asserts that he had invented, the patentee's claim is anticipated, but not otherwise. … To anticipate the patentee's claim the prior publication must contain clear and unmistakeable directions to do what the patentee claims to have invented. … A signpost, however clear, upon the road to the patentee's invention will not suffice. The prior inventor must clearly be shown to have planted his flag at the precise destination before the patentee."

iii) Verathon Medical (Canada) ULC v. Aircraft Medical Limited [2011] CSOH

[130] The notion behind anticipation is that it would be wrong to enable a patentee to prevent a man from doing what he has lawfully done before the patent was granted: Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd (supra), Oliver LJ at p.77.

[131] A challenge to validity based on anticipation requires the court to address two concepts, namely, prior disclosure and enablement. In Arrow Generics Ltd. v. AkzoNV 2008 SC 518, the Lord President (Lord Hamilton) at paragraph 104 stated:

"A party seeking revocation of a patent on the ground that it has been anticipated by the prior art has to satisfy the court on two points, namely, whether the prior art disclosed the invention which had been patented ('disclosure') and whether the ordinary skilled man would be able to perform the disclosed invention if he attempted to do so using the disclosed matter and common general knowledge ('enablement') (see SmithKline Beecham, per Lord Hoffmann, para 14)."

40. The expert evidence in this case are the evidence of Dr. Siddharth Jabade on behalf of the applicant and the evidence of Dr. Nikhileshwar Mukherjee on behalf of the respondent. There are two affidavits of Dr. Siddharth Jabade one dated 14.07.2011 and the other dated 20.01.2012. The evidence of Dr. Nikhileshwar Mukherjee is dated 17.02.2011.

41. Mr.Majumdar submitted that the expert evidence adduced by the applicant cannot be accepted. He relied on Verathon (cited supra) to show what is the qualification of an expert who is called upon to give expert evidence. According to him, the evidence of Dr. Murali Shastri was merely a reproduction of the Statement of Case. The learned counsel submitted that the expert

Dr. Siddharth Jabade had deliberately not mentioned the siphon used in the prior art. He submitted that if siphon is taken into reckoning then there is no anticipation by the prior art. He submitted that the invention depends on the gravity whereas in US '260 unless the vacuum is created, not one drop of water will come out. The learned counsel submitted that neither of the experts even mentioned the vacuum. According to him, if Dr. Siddharth Jabade had mentioned siphon, he would have said that the prior art teaches away from invention. The learned counsel submitted that the expert had not attempted to construct the invention and state how the disclosure was not sufficient. US '260 is not a U-tube. The learned counsel submitted that in the invention, the filter media is always wet and that is why the pure water does not go back. He submitted that the fact that two inventions look alike does not mean that the functionality is same. He states that the US '260 has to be considered as a whole. He submitted that the technical problem solved by the Invention was the air locking and the channelling. He submitted US '260 cannot be distorted to hold it that teaches the invention.

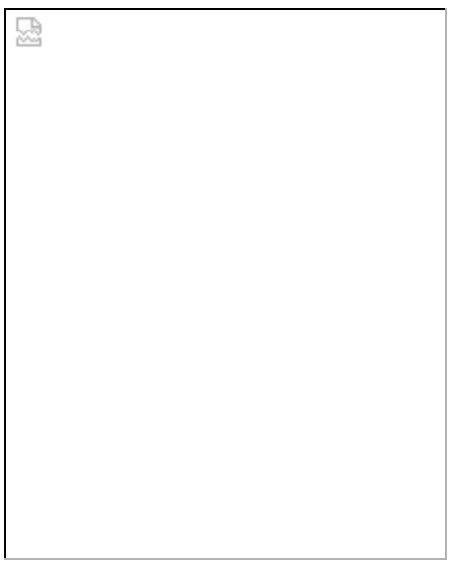
42. The learned counsel for the applicant submitted that the expert had clearly explained how the invention is anticipated and obvious. It was submitted that both the prior art and the invention were clearly explained. Mr. P.S. Raman read out the affidavits of the experts and submitted that Dr. Siddharth Jabade's affidavit clearly shows how the Invention lacks novelty and is obvious apart from being insufficient. He submitted that Dr. Jabade had explained why there was no novelty because of the two prior arts, he also showed the diagrams given by Dr. Jabade which showed how the Invention was anticipated.

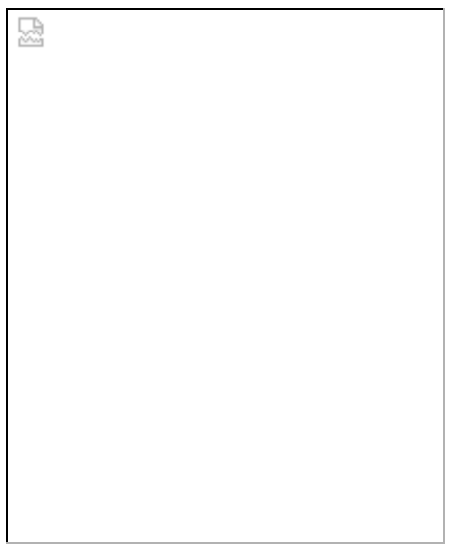
43. Dr. Mukherjee is one of the inventors. His affidavit refers to the air locking which is caused when air is forced to move downwards against the natural flow. He has stated that the inventors of the present invention had understood the problem and devised the filter cartridge where the water from the inlet travels substantially, vertically downwards through the hollow passage by gravity before encountering the filter media wherein the water flows upwards. The invention is in the inter play of the combination of the hollow passage maintaining the pressure and the filter media through which the water passes. According to him there is nothing in the teaching of Exhibit-1 which would have motivated the Invention. According to him in the invention the water flow is totally based on gravity whereas in US '260 the siphoning action is activated by vacuum and created in the sealed cavity which is essential for the out-flow of filter water. He has admitted that the three cited documents at best teach upward flow of water. But none of them teach a filter cartridge operating only on gravity without using any other force and there is no mention in any of the documents either implicitly or explicitly of a hollow passage immediately following the inlet before water comes in contact with the filter media. According to him Ex 1 is constructed based on an entirely different approach and that the invention does not require creation of vacuum and in Ex 1 is the siphoning out of water from cartridge would lead to drying of filter bed. Whereas in 937, the water level is always above the filter media and it has to traverse a hollow passage which leads to the filter media at the bottom. There is no siphoning action. According to him in the invention, the inlet water has been passed through a vertically downward hollow passage and the untreated water takes a U-turn**.** According to him the prior arts do not teach the invention. Here the reference to Ex-1 is US '260 and '937 is the Invention.

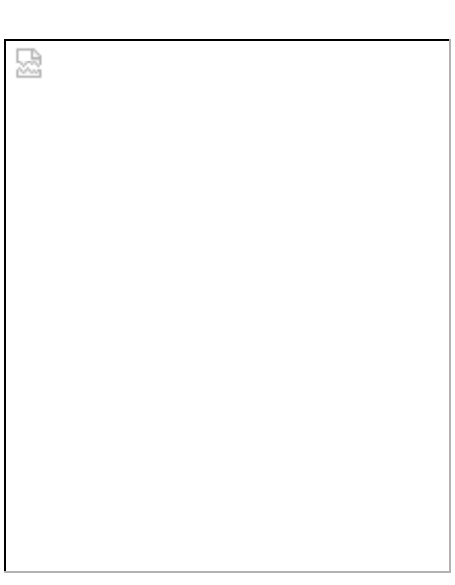
44. On the side of the applicant one Dr. Siddharth Jabade has given his expert opinion. He has compared the European Patent 1106578 (EP'578 in short) and US '260 with the Invention. According to him, the EP ' 578 teaches the construction wherein a centre tube is used for water inflow avoiding filter media immediately under the water inlet, and it teaches the construction in which there is a hollow passage through which the feed water flows downwards without flowing through filter media and then changes direction to enter the filter cartridge from the bottom of the cartridge to flow upwards through the media to exit the cartridge from the top of the cartridge.

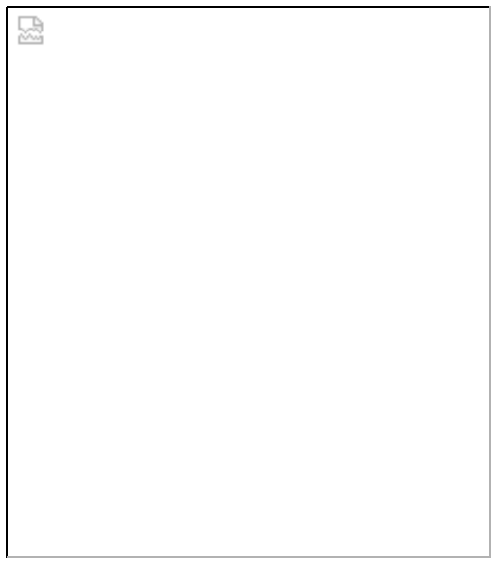
45. According to him US '260 teaches the construction in which water flows in the downwards direction under gravity without being intercepted by filter media through an external hollow passage (annularly constructed around the filter media) then making a U turn to change the direction of the flow at the bottom of the filter to flow through the filter media in the upward direction. The role of the hollow passage would be same whether the passage is placed in the cartridge between the filter media or is annularly constructed around the filter media. According to him a person skilled in the art looking at both the cited documents would arrive at the invention. According to the Dr. Siddharth Jabade, both EP-578 and US Patent 260 are relevant literature. This affidavit also shows that the disclosure is not sufficient and the example does not support the invention. This additional affidavit, he has explained that the Kozeny-Carman equation has been used to analyse two-phase flow in particle-gas drive model and that he

states that the difference in the two intercept values arrived at using patentee's own experimental parameters clearly show is that the intercepts are different, thereby implying that the resistance of the filter medium was not maintained constant in the comparative example. Therefore the conclusion stated in the Invention that *"the flow rate achieved with the filter cartridge of the invention described in Figure 1 is much higher and more sustained over a large volume of water flow as compared to the prior art filter cartridge described in Figure 2, is not technically in order*









46. The applicant has also filed the expert evidence of Dr. Murali Sastry.

47. Next we come to the ground of obviousness.

48. According to Respondent No.1 the inventive concept in the patent is, the flow of water in the upward direction through the filter media that facilitates the removal of entrapped air from the filter media and provides for the uniform flow of water through the filter media.

49. To attack the patent on the ground of obviousness the applicant again relied on US '260

50. The problem addressed by US '260, is that of the non uniform flow of water through the filter medium in conventional downward flowing filters due to the presence of air.

51. According to the applicant, the solution given by US '260 for the problem of non uniform flow due to presence of air is to allow the water to flow through the filter medium in an upward direction such that the air is released in an upward direction.

52. According to the learned senior counsel, the inventor had taken prevaricating stands before the Hon'ble Calcutta High Court and the IPAB. He submitted that the principle that when water flows upwards through the filter media, it overcomes the problem of air entrapment and channelling, is part of common general knowledge. And all the four prior arts contains these features and are based on the principle that when water flows upwards through the filter media air entrapment and channelling would be avoided.

53. The learned senior counsel for the applicant submitted that if US '260 is manufactured in India, it would infringe the present patent then the present patent is hit by the prior art. The learned counsel submitted that the hollow passage is an integral part of an invention and if it is contended that it is not then it should not be part of claim-1. The learned counsel explained that water filter is genus and US 260 is species.

54. According to the applicant US '402 filed in April 13, 1972 discloses a filter cartridge that comprises of a filter medium enclosed in a cartridge, the cartridge having an inlet, a diffusion space at the bottom of the filter pack in communication with the lower end of the filter media, an outlet for treated water exiting out of the filter media, wherein water travels upwards through the filter media, such that air in the filter media may be released upwards during the passage of water through the filter media in an upward direction. US '402 further discloses that the filter may comprise of multiple filter medium.

55. According to the applicant US '473 filed on September 12, 1977 discloses a filter. The filter comprises of a filter housing holding a filter media. The filter housing includes an liquid inlet (22) connected to a feeding chamber present at the bottom end of the filter medium and an outlet (40) present at the upper end of the filter media. During operation the water to be filtered enters into the bottom end of filter media through the inlet and travels up the filter medium to exit from the outlet.

56. It was submitted that Respondent No.1's alleged invention (Indian patent 195937) is clearly lacking in inventive step and therefore the patent ought to be revoked.

57. The following decisions were cited :

The court must make finding of facts as to what was included in the state of the art at the priority date, and whether having regard to the state of the art, the alleged inventive step would be obvious to a person skilled in the art. **(PLG Research Ltd v Ardon International Ltd (1995) RPC 116(CA) and Molnlycke v Procter & Gamble (1994) RPC 49.)**

In **Morgan & Co. v. Windover & Co. (7 RPC 131 at pp. 137, 138)**, the invention amounted to the ~ use in the front part of a carriage of springs of a type formerly used in the rear part. The patent was held invalid in the House of Lords. Lord Herschell said: *"...the mere adaptation to a new purpose of a known material or appliance, if that purpose be analogous to a purpose to which it has already been applied, and if the mode of application be also analogous so that no inventive faculty is required and no invention is displayed in the manner in which it is applied, is not the subject-matter for a patent.. .once it is admitted that all that can be claimed as new is the idea of putting it (the springs in the front instead of at the back and that when once that idea was entertained, any workman told to do it would, without any instructions or any special mechanical skill, be able at once to do it, it seems to me that that really concludes the case..."*

In **Harwood v. Great Northern Ry. (35 L.J.B.Q. 27)**, the patentee used a "fish plate" for joining together the ends of rails. The evidence showed that this particular form of joint had been applied in various mechanical contrivances, and notably in the joining together of pieces of timber used in bridge building. Lord Wesbury L.C. said (at p. 38) *"No sounder or more wholesome doctrine, I think, was ever established namely, that you cannot have a patent for a well-known mechanical contrivance, merely because it is applied in a manner, or to a purpose which is analogous to the manner, or to the purpose in or to which it has been hitherto notoriously used."*

58. The learned Counsel for the respondent submitted that the issue of obviousness should be judged by a person skilled in the art and that Dr. Jabade is not such a person. He submitted that Dr. Jabade sidesteps the features of US'260 like siphon and has failed to see that EP '578 does not deal with air. According to him the drawings created by Dr. Jabade are incorrect and the experts cannot isolate features of prior art while dealing with questions of novelty and obviousness. According to him US'260 does not contain any teaching as to how to solve the problem of airlock, though it has addresses it. , and while it touches upon the aspect of air lock and channelling, the device addresses it in a very different way.

59. He relied on the following decisions:

An invention in fact may also lie in the provisions of an alternative process which brings about comparable results to a known process chosen as the starting point for the evaluation of inventive step (see T92/92, point 4.5 of the reasons for the decision and point T 588/93, point 6.1 of the reasons for the decision, both unpublished in OJ EPO).

In T 0359/99, the Board of Appeal of the EPO held:

"8.1 *It should be recalled that the technical teaching in a prior art document should be considered in its entirety and that it is not justified arbitrarily to isolate parts of such document from their context in order to derive there from technical information which would differ from or even be in contradiction with the integral teaching of that document.*

*In **General Tyre & Rubber Company vs. The Firestone Tyre & Rubber co. Ltd. And others [1972] R.P.C.** the following passages are relevant:*

"…. Has been held from the earliest times that a new manufacture may be created, although such manufacture when dissected may consist of individual items all of which formed part of public knowledge"

"It seems to me to be very dangerous and in law not permissible to asses' obviousness in the light of carefully selected pieces of prior knowledge only."

"Nobody, however, has told me, and I do not support anybody ever will tell me, what is the precise characteristic or quality the presence of which distinguishes invention from a workshop improvement …. The truth is that, when once it had been found …. That the problem had waited solution for may years and that the device is in fact novel and superior to what had gone before and has been widely used, and used in preference to alternative devices, it is, I think, practically impossible to say that there is not present that scintilla of invention necessary to support the patent."

*In **Verathon Medical (Canada) ULC against Aircraft Medical Limited [2011]CSOH (cited supra)** the following passage is relevant:*

"[133] The philosophy behind obviousness is that a patent is granted only for an invention and that which is obvious is not inventive"……

In T 0868/05, the Board of Appeal of the EPO held:

"2.4.3…. Therefore, the Board is convinced that, by following the teaching of document (AI), when read as a whole and in context without knowledge of the invention, the skilled addressee would have arrived at a formulation containing HFA134a and a surfactant, specifically oleicacid."

"It is however clear from the above that this passage was read outside the context of the rest of the document and that the document in fact provides no indication as to how any substitution is to be made and what modifications to the formulation would be necessary in order to move from a CFC to an HFC 134 a product, except the mention of a formulation containing HFA134a and a surfactant, specifically oleic acid."

It was submitted that the principle based on which a device functions may be well known but that does not matter when there is a device having a new construction which solved a problem in a unique way. In this regard, the respondent No.1 relied on Diamond Rubber Company of New York vs. Consolidated Rubber Tire Company – 220 US 428.

The respondent No.1 submits that the law does not require that a patented product should be superior to all prior devices. Also, a patent will be valid even if it is a simplified version of a complicated construction avoiding the use of additional components.

60. We have considered the evidence and the materials before us.

The prior arts described in the specification are US 5273650 and US 5562824.

61. Now let us see the two prior arts cited by the applicant.

US '260 is an invention for purification of liquids. The filtration is effected while the liquid flows upwardly. The device is constructed to intake impure liquid at the bottom of the filter. The field of invention of US '260 shows that

a) the liquid flows initiated by gravity

b) the flow continues "without use of any additional sources of external pressure and use of the impure device causes of flow pattern which enhances purification".

62. This prior art refers to the typical water filtration system where water flows through the filter cartridge downward by gravity. It has addressed the problem of air bubbles forming inside the filtration material because of the downward gravitational flow of the liquid. Another significant drawback which the US '260 addressed was the complete drying out of the filter at the end of the filtration process. A third drawback which it addressed was the non uniform flow of liquid, whereby, some of the filtered liquid moved faster than required for effective purification. Therefore the object of US '260 was to eliminate channelling, removing the air and gases, and maintaining the filter element fully filled with liquid. **These are exactly the same defects that the inventor claims he has addressed in the Invention**

63. Another object of the US '260 was to provide liquid filtration by liquid flow in the upward direction. The summary of the invention shows that there is a liquid inlet at the bottom of the housing which permits liquid to flow from the container into filter cartridge upwardly to the filter chamber into a sealed cavity. According to the invention, the purification process will continue until all of the liquid has been filtered. It says that this result is obtained because once flow through the conduit begins the hermetic nature of cavity causes a vacuum to be formed therein and this is in turn causes siphoning action to be initiated.

64. It is this feature of US '260 which is pointed to by the respondent to show that US '260 has a siphon whereas the invention does not and that it is futile for the applicant to state that once you remove the siphon from US '260 it is the invention and what remains there is where the invention lies and the novelty. Therefore according to the respondent US '260 is not a prior art as far as, the invention is concerned. We do not agree as the claimed invention is for a constructional feature of filter cartridge where water is fed through gravity flow and it meet the filtering material at the bottom and then moves upward and the filter water flows out. These being the essential constructional features of the alleged invention they are wholly and squarely anticipated by US '260.

65. The table below lists the similarities between the filter cartridge of Invention and US '260

S.No.	Indian Patent Number 195937	US 6387260
1	Claim 1.A filter cartridge for treatment of water which comprises an inlet for water to be treated;	Claim 1 (a) A filter cartridge for liquid purification comprising a housing…a filtration chamber….a liquid inlet in said housing to permit liquid to flow from an unpurified source…..
2	Claim 1.the inlet communicating with a downwardly extending hollow passage adapted for gravity flow of water there through, the hollow passage being connected at its lower end to at least one filter media; and an outlet for exiting treated water from the filter media.	Claim 2 (b)..the said liquid inlet being adapted to receive liquid from the lower portion of the container at its bottom…and elongated fluid conduit The path for the flow of liquid …proceeding from said liquid inlet upwardly through said filtration chamber …..and out of said filter cartridge
3	Claim 1. whereby water flows through the hollow passage and enters the lowermost end of the filter media to travel upwards through the filter media so that entrapped air in the filter media may be released upwards and out of the filter cartridge during the passage of water through the filter media in the upward direction.	Col 7.l.41.As it will be shown in the examples below, these inventions allow not only to provide liquid filtration in the filter in the upward direction with liquid flowing by itself……..allow to increase significantly quality of the filtration due to the automatic air and/or gas removal form the filtration material keeping the filter filled with liquid after the end of the filtration

The above table will show how the Invention is fully taught by US '260. The terminology is different, but the hollow passage is there, the upward flow of fluid through the filter media is there and how they are constructed is the same.

66. In fact, this is the reason why we have referred to the passages from the counter statement as well as the affidavit of Dr. Mukherjee to show where the invention actually lies. According to them, the invention lies in the interplay of the hollow passage and the filter media. A primary object of US '260 is to provide a "method that entails upward flow of the liquid during filtration", a further object is to use natural gravitational force for achieving the upward flow. An additional object is to provide automatic air or gas removal . This is exactly what is done in the invention. In the example cited in US '260, liquid is filtered as it flows by itself upward through the filter cartridge and it is removed through the cavity. We are not really concerned with how it is removed because the Invention itself says that the water can be removed in a desired manner. The US '260 also states that the filter material remains filled with fluid and does not dry out during the time intervals between the filtration cycles. So every feature that is claimed by the inventors as its essential feature are already disclosed in US '260.

67. The next prior art is EP '578. The object of this invention is to clean and partially soften hard water. There is the hard water inlet and a clean water outlet. The specially preferred embodiment of this invention is one in which the filter material is essentially in cylindrical form but could be in any other form. Here through a central tube the hard water can be directed to the bottom layer where it is distributed and it ascends into layer of the filter material or it is pushed up by the hard water. Therefore there is a central tube here which is the hollow passage in the Invention. The hard water comes through it to the bottom and it turns up the filter material and outwards in EP '578, this is the U-turn mentioned in the Invention.

68. Therefore it is clear that the invention is not new, nor is there any inventive step. EP '578 proves non-obviousness. It is common general knowledge, that water flowing upward through filter material avoids channelling and air locking. Both the prior arts teach the structure of the invention as claimed, and there is no invention and it is obvious. As Dr. Jabade had rightly observed, it does not matter how the filter material is constructed around the hollow passage whether it is annularly or to a side the principle is the same. And how the water is collected at the bottom of the hollow passage is not relevant for the purpose of deciding the patentability. The learned counsel for respondent submitted that Dr. Jabade's diagrams are inaccruable. We do not think so, the diagrams are simplistic representation of the prior arts to show how the prior art teaches the inventions. It is not correct to say that the parts of prior arts have been isolated in order to derive the alleged anticipation or obviousness. The documents have been read as a whole. In the Invention the water enters with the gravitational force down the hollow passage and meets the filter material at the bottom and turns upwards making a U-turn. According to the inventor and the respondent, this interplay is the invention. If so the person skilled in the art who looks at US '260 and EP '578 will not find it difficult to construct this cartridge.

69. The field of invention shows that US '260 is an improved purification device wherein liquid flow is initiated by gravity through a filter and the flow continues without using any additional sources of external pressure. US '260 refers to the prior art where water flows downwards through filter material and is removed from the bottom and mentions that in such configuration air bubbles form which make the water flow difficult and further in the known filter designs because filtration takes place in the downward flow there is complete drying out of the filter material. These are the same problems addressed by the invention. Dr. Nikhileshwar Mukherjee admits that "In '937, the liquid and air move upwards through the filter media along the preferred and natural path of air and exit the cartridge. While in Ex-1 though the water and air travel in upward direction through the filter media initially, the rout takes a U-turn and water and air go down before they exit." As already mentioned Ex-1 mentioned here is US '260 and '937 is the Invention. Now, where the impure water meets the filter material in US' 260 it has to make a U-turn to travel upward. The object of invention of US '260 shows that the filtration in the filter is ordered in such a way that liquid is flowing by itself in the upward direction. The presence of the siphon mechanism in US '260 does not change the position. The respondent claimed that the invention is exactly the removal of the siphon and allow the water to flow on its own. But US '260 itself uses only the natural gravitational force to achieve the upward flow. This is why Dr. Jabade has given his opinion that the skilled person will be taught by US '260 because this is the same as the Invention. All the features in the Invention are there in US '260. Dr. Jabade rightly reasons that it is not relevant how the outward chamber is created annularly or otherwise. It is clear that from the prior art US '260 the invention can be wholly derived. Infact, if the invention had preceeded US '260 and there have been a challenge to US '260 on the ground of obviousness, US '260 may have contended that while all the features are the same, their siphoning mechanism is the inventive step and they may have succeeded. But we do not think, we can accept the case of the respondent that removal of the siphoning mechanism is the inventive step, when it is clear from a reading of US '260 and invention that the drawbacks in the prior arts were the same, the object addressed was the same and the manner in which they are addressed are also the same. The U-turn and the upward movement of the fluid are also found in the other prior art. The invention is not concerned with how the water enters the inlet nor how the filtered water is collected. It is collected in 'a desired manner'. The respondent is not correct in stating that US'260 does not solve the problem of airlock and channelling in the way the Invention does. If we read the prior art we find that the object is to remove air lock and channelling and also the drawback of complete drying out, and to achieve improved quality of filtration for which it has provided a method that entails upward flow of liquid during filtration. **What is the crux of the invention is the impure water hitting the bottom, turning upward through filter media and out**.

70. It is not the simplicity of the invention that makes us hold it is not patentable It is not patentable because it is not new as seen from US '260, and it is obvious as seen from US '402 which provides for "the vertical upward flow through the absorbent cartridge" which was also addressed to remove the tendency of water to flow in channels leaving portion of absorbent untouched because air remains in the cartridge. The problems of air bubbles, channelling and non-uniform flow are all mentioned here. We are unable to see either novelty or inventive step in the invention.

71. In **re Ludke and Sloane 169 USPQ 563**. The invention was a parachute canopy which will sequentially open and gradually decelerate. The prior art Menget possessed all the claimed characteristics including the capability of sequential opening of the

invention canopy. Therefore it was held that Menget inherently possessed all the characteristics of the invention. The Court affirmed the view in In **re Swinehart (169 USPQ 226)**" …Where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." Here too the respondent only insisted that even the removal of the siphon mechanism from US '260 may be an invention. But it could not be denied that what is claimed to be the invention , both in the pleadings and in the expert evidence namely the interplay, is found in the prior art.

72. It is obvious from what is seen in US 260 that anyone who tries to manufacture the filter, according to US 260 would be infringing the Invention. Because the basic principles are the same namely the inlet through which impure water enters by gravitational force, the turning upwards through the filter media without any external force. Therefore what was held in ***Windsurfing International Inc.*** (cited supra) applies. Even if we apply the ***General Tire & Rubber Co. Ltd.*** **(**cited supra), it is clear that US 260 discloses the same device as the Invention and it has planted the flag at the precise destination. There is no doubt that the Invention is derivable wholly from US 260. If we construe US 260 and compare it with the Invention, it is clear that the Invention is disclosed. In our discussion above, it will be seen that we have not dissected the Invention, but we have taken it as a whole to decide the grounds of objection and as held in **Morgan & Co.** (cited supra) we hold that from the prior art any person skilled in the art would have constructed the Invention. So the invention is anticipated and obvious and the patent is liable to be revoked.

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73. Next we take up the ground of revocation on the ground of non compliance of the provisions of Section 8. The present application which is the Patent Application No.709/MUM/2002 was filed on 7.8.2002. Form-3 was filed on the same day. In this, there was no information regarding foreign filing. The respondent had filed an application in Great Britain as a domestic application. This was on 28.03.2003 then they filed the PCT Application on 21.07.2003. On 25.07.2003, the details of the Great Britain filing were submitted but nothing else. On 04.08.2003, the respondent was filed an application in Thailand. The International Search Report dated 31.10.2003. The First Examination Report issued by Respondent 2 was on 05.12.2003. On 08.12.2003, the Great Britain application had been terminated. On 29.01.2004, the respondent filed further particulars of corresponding foreign filings. The details of Thailand and PCT application were submitted that the Great Britain Application No.0307146 was shows as pending. Filing of application in Japan is on 21.07.2003. The International Search Report was not submitted. On 01.04.2004, in the response to the first examination report, the respondent stated that no search report was available. The second examination report was communicated on 07.07.2004. The International Preliminary Examination Report (IPER) was available on 27.07.2004. In response to the second examination report on 19.11.2004, the International Preliminary Examination Report was not submitted, though the Patent Office had requested for the same. The respondent had assured the Patent Office that as soon as available, it would be submitted. The International. Preliminary Examination Report was also not submitted. The Great Britain application was still shown as pending. No other filing details were provided.

74. 05.12.2004 was the last date for placing the application in order. The counsel for the respondent sent a letter on 05.04.2005 to Indian Patent Office. Even then the ISR and IPER were not submitted, the status of the Great Britain application was not updated. The patent was granted on 26.08.2005. Withdrawal of Japan application was dated 07.07.2006.

75. According to the learned senior counsel for the applicant, the PCT application ought to have been disclosed and when the respondent in Form-3 dated 29.01.2004 had submitted the details of PCT application in compliance with the Section 8(1), It should have also given the details of processing of the said application under Section 8(2).

76. The learned senior counsel submitted that it would be the duty of the respondent to furnish the International Search Report and IPER and irrespective of whether they are transmitted to the Indian Patent Office. It cannot obviate the duty of the respondent to furnish the same.

77. The learned counsel submitted that the Indian Patent Office could obtain the IPER only on request after February 2005 and the importance of IPER lies in the fact that it gives an opinion on the patentability of an application of the patent and the patent applicant makes suitable amendments based on the ISR and IPER.

78. The learned counsel for the respondent referred to the relevant sections in the UK Rules and when the Great Britain application had been terminated which is seen from the website of the Patent Office, UK and that the respondent could not have furnished wrong information to the Indian Patent Office as though the application was still pending.

79. The learned senior counsel submitted that the Great Britain application was filed as a Convention application and if the request of search examination was filed it can be terminated only on account of withdrawal by the applicant or terminated by the UK Patent Office. The learned senior counsel submitted that the respondent could not have treated the Great Britain application as pending. In view of the subsequent PCT application, the learned counsel submitted under the UK Patent Law in respect of the application of national phase entry a new application number and filing date is allotted and therefore when originally the number of Great Britain patent application was furnished No.0307146, it had got terminated. The fact that it was a later, which was pending should have been made clear. To merely say 'pending' as though 0307146 was pending was a copious misstatement.

80. The learned senior counsel then referred to the response of the respondent that no such report was available. According to the learned senior counsel both the International Search Report and the IPER were in the possession of the respondent No.1, but were deliberately not submitted by the Indian Patent Office. The learned senior counsel submitted that the Indian Patent Office was not informed whether the corresponding application was filed in Japan.

81. According to the learned counsel for the respondent there was no breach of Section 8. According to the learned counsel besides the application in India, an application was made in the Great Britain and thereafter a PCT application was filed claiming priority of the said Great Britain Application and the Indian Application. When filing the PCT application, European Patent Office was selected for ISR and IPER, there was no other foreign application made by the respondent.

82. The learned counsel submitted that in accordance with the Patent Law in force in India any PCT Application is filed it shows up in the JPO. But that cannot be construed as an application being processed by the patentee.

83. The learned counsel also referred to an email from Japanese attorney firm clarifying the decision. Therefore, according to the learned counsel, this application of the Japanese Patent Office was not prosecuted by the respondent by itself or from someone else and therefore no obligation was cast upon the respondent to give the details.

84. Japanese Application is shown as non entry information. According to the respondent they had no knowledge under Section 8 of the Patents Act with regard to the Japanese Application. The reference to the Japanese and Australian application was generated automatically. According to the learned counsel, the same is the case with European Patent Office and when the applications were not made by the respondent Section 8 (1) cannot be attracted by such application.

85. According to the learned counsel, the Great Britain Patent Application was not suppressed and since the PCT Application designating Great Britain was pending with European Patent Office, the applicant treated the Great Britain application as pending. According to the respondent, the PCT application designating the Great Britain is equivalent to Great Britain National Application and therefore the Great Britain application remained valid through the PCT application. According to the learned counsel, the Great Britain application No.0307146 was treated as terminated not on merits, but because of non prosecution and the respondent had indicated the status of the application is pending without making it clear that it was the Great Britain application pending through PCT. According to the learned counsel at best it was a procedural irregularity and not a lap.

86. According to the learned counsel that there was no duty cast upon the respondent No.1 to provide ISR and IPER since the PCT is an inter governmental body and not a country falling under the definition under Section 8 (2).

87. According to him the Act does not define a country and there is nothing in the language of Section 8(1) and (2) which obligates the applicant to disclose the search report pursuant to a PCT application. The learned counsel submitted that the application filed under PCT was neither refused nor granted. They are examined the search report and preliminary examination report are issued. Then upon the payment of requisite fees those applications are proceeded with in the country of the choice of the applicant.

88. According to the respondent, the Great Britain application was withdrawn prior to publication, there was no examination of the application. The learned counsel for the respondent read the First Examination Report with regard to the patent herein and submitted that it would be apparent from this that though the word “foreign filing particulars” are used what was required from the respondent was only compliance with Section 8(1) and not 8(2). According to the learned counsel the Section 8(2) mentioned was only a typographical error, if the entire sentence is read as above. According to him, the FER required him to file the foreign particulars and it was done. The learned counsel submitted that to comply with Section 8(2), the Controller has to specifically request the applicant to furnish the details relating to processing of the application in a country outside India.

89. The learned counsel submitted that when the Indian Patent Office itself cited EP-1106578 as a prior art, the object of Section 8 was served. The object of Section 8(2) is that the Controller should have information with respect to a document that would constitute anticipation.

90. According to the learned counsel since the search and examination report, are anyway accessible freely to all and also to the Patent Office and since the sole cited prior art EP-1106578 was duly considered, the Section 8(2) should not and ought not to be invoked to bring to an end a patent for an invention that has enjoyed a wide market for so many years.

Section 8(1) and (2) read as follows:

Information and undertaking regarding foreign applications

(1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application [or subsequently 5[within the prescribed period as the Controller may allow

(a) a statement setting out detailed particulars or such application; and

(b) an undertaking that, [up to the date of grant of patent in India,] he would keep the Controller informed in writing, from time to time, of [detailed particulars as required under] clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.

(2) At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of a patent made thereon, the Controller may also require the applicant to furnish details, as may be prescribed, relating to the processing of the application in a country outside India, and in that event the applicant shall furnish to the Controller information available to him within such period as may be prescribed.

91. The history of the provision is seen from the Report on the Revision of Patents Law by Shri Justice N. Rajagopala Ayyangar (the Report in short). It speaks of the necessity to remove geographical limitation as to anticipation. I note of the ground reality that in India the availability of books and literature is not the same as in UK. The public libraries are few and they are not well equipped. The learned author of the Report felt that a rule on the lines of the U.K. enactment would be contrary to public interest for it would enable a person to obtain a valid patent in India when information in regard to that is available in foreign publications.

92. It is noted in the Report that the majority of the applications for patents in India are from foreign nationals and therefore it would be an advantage if the applicant is required to state whether he has made any application for a patent for the same in any foreign country or countries and the objections raised by the Patent Offices of such countries on the ground of want of novelty or unpatentability and the amendments directed to be made or actually made to the specification or claims in the foreign country up to the date of acceptance of the application. The learned author felt that this information would be of great use for a proper examination of the application.

93. The Report has also referred to Commonwealth Conference on Patents and Trade Marks at Canberra, where it was recommended that countries of the Commonwealth which undertake novelty search should provide in their legislation measures whether applicants may be required to furnish the result of searches in other patent offices.

94. In order to secure compliance with this provision as to the disclosure of information regarding foreign applications for the same invention, the Report recommended the addition of words to include “failure to communicate information in possession of an

applicant as constituting a ground of opposition and revocation respectively." This is the background of Section 8. In fact S. 64(1) (m) & (j) are perhaps the only ground in the Section where the revocation of patent is on a ground which is not directly concerned with the invention itself. But it is based on the conduct of the patent applicant and whether the applicant had disclosed all information bound to be disclosed before the applicant secures a monopoly against the rest of the world. It is a ground basis.

95. The PCT makes it possible for the PCT applicant to obtain patent protection simultaneously in a number of countries by filing an international patent application. They are absolved of the requirement to file application separately. Then an international search is made, this is issued as an international search report which gives a list of citations which may affect patentability of the invention. A separate opinion is also written prepared by the ISA on Patentability. These are communicated to the applicant who then will take a decision whether to proceed with the application or not. There are many advantages that a PCT applicant has, firstly he has 18 months more, next by IPER, the search and examination work of the patent office is considerably reduced because of the international search report, the written opinion and the international preliminary examination report.

96. The PCT Applicant's Guides, Chapter-4 contains some relevant paragraphs which are useful for us.

> 4.017. An international search report (and any supplementary international search report) which is favourable from the applicant's view point strengthens his position vis-à-vis the various national or regional Patent Officers and his arguments for the grant of a patent by those Offices are likely to be more convincing.
>
> 4.018. This is even more true in the case of a favourable international preliminary report on patentability under either Chapter I or II, which contains far more material on which to base an opinion on the chances of obtaining patents than does an international search report.
>
> 4.019. If the international search report and the written opinion of the International Searching Authority are partly favourable and partly unfavourable, the applicant can modify his claims so as to maintain only those which are likely to result in the grant of a patent. If the international search report and the written opinion are unfavourable, and the applicant consequently decides not to proceed any further, he saves the cost of having the application processed in the various countries. The same applies to supplementary international search report(s).
>
> 4.026. A further advantage of the Euro-PCT route is the possibility of making use, where available, of the procedure for extension of European patents. Agreements on extending the protection conferred by European patents have been concluded between the European Patent Organisation and a number of States which are not party to the European Patent Convention. Provided that the international application contains a designation for a national patent of the State concerned and also a designation for a European patent the applicant may avail himself of the Euro-PCT route with a view to extending to that State a European patent subsequently granted on the basis of the international application (see paragraph 5.054 and Annex B(EP), as well as National Chapter Summery (EP)).

97. The First Examination Report issued to the respondent contains Paragraph 12 which reads as follows:

> Foreign filing particulars should be filed as required under Section 8(2) of the specification along with necessary petitions if required.

98. We are not convinced by the submissions that Section 8(2) is a typographical error. It is no doubt true that the words used are "particulars" but that will not determine the question what is sought for is a statement setting out the detailed particulars and or an undertaking on the furnishing of details relating to the processing of application outside India.

99. The section 8(1) compliance is the voluntary compliance by the applicant, Section 8(2) is information furnished upon the Controller requiring the applicant to do so. Therefore once the Controller had called upon the applicant to furnish foreign particulars under Section 8 (2), it becomes the duty of the applicant to furnish those details that are required under Section 8(2) and not to treat as the office had committed typographical error.

Rule 12(3) which deals with Section 8(2) reads as follows:

> When so required by the Controller under sub-section (2) of section 8, the applicant shall furnish information relating to objections, if any, in respect of novelty and patentability of the invention and any other particulars as the Controller may require which may include claims of application allowed within six months from the date of such communication by the Controller.

100. Therefore the fact that the word used "particulars" will not determine what the applicant was in law bound to furnish under section 8(2). The respondent understood what was sought for and had answered by the letter dated 1.4.2004 that no search report was available at present and as soon as the same is received it will be forwarded.

101. On 19.11.2004, they had filed the petition under Rule 13. In the counter filed by the respondent and in the written

submission, the grounds raised by the applicant are not denied. The first is that Great Britain application is shown as pending, though it had been terminated. The next is that the ISR and IPER were not furnished. The answer of the respondent is that the Great Britain application was shown as pending because by that time, the PCT application designating Great Britain was filed and in any event the first Great Britain conventional application was terminated not on merit, therefore according to the respondent this was only an irregularity and nothing more. They have also taken the stand that since the PCT application had been filed designating Great Britain as a country of application they could justifiably have stated that the Great Britain application was pending.

102. The statement that Great Britain 0307146 was pending, it is clearly not a correct statement. The Great Britain application No.0307146 had been terminated, and the termination was also duly advertised in the Gazette. The PCT application was a different number. When, on 25.07.2003 the details of the Great Britain filing was given as No.0307146 application and it had actually been terminated for whatever reasons, it is the duty of the respondent (i.e. the patent applicant) to inform the Patent Office of the correct fact. The respondent could very well have disclosed that it had a PCT application pending in which Great Britain was designated as the country of applicant. The statement which seemed to indicate that Great Britain 0307146 was pending was an incorrect one.

103. Next we come to the IPER. This is dated 27 July, 2004. The request for preliminary examination was filed on 1.3.2004 and the completion of this report was made on 27.07.2004. There is no reason for us to presume that this report was not communicated to the respondent. In the International Preliminary Examination Report, the office had given opinions on novelty, inventive step and industrial applicability and held against the respondent. Then in the reasoned statement with regard to novelty, inventive step they have referred to EP-1106578 as the cited document and held that the subject matter claims 1 to 3 are not novel and that there is no inventive step in claims 1-3.

104. When the IPER was communicated to the applicant, he did not pay the fees. EPO informed the applicant that the application is deemed to have withdrawn since filing fee/such fee was not paid in time. We have to see whether the words “relating to the processing of the application” in a country outside India would include processing of application in EPO where Great Britain is designated as a country. When the question of non disclosure of the termination of the Great Britain convention application was raised, the respondent took the stand that since the PCT application designating Great Britain as the country was pending, the respondent had stated that Great Britain application was pending. According to respondent it was only a technical distinction but not a real one. So, for the purpose of Section 8(1) he would treat the PCT application as a country application which would render the non disclosure of termination of the other application irrelevant. But when it comes to Section 8(2), the PCT application is not an application in a country. This prevarication cannot be accepted. This is as regards the respondent turning like a weathervane on this issue. On the question whether the respondent was processing an application or not, we note the following facts. In the PCT application the extract from the register of European Patent for WO-2004014803 discloses the priority dates of the Indian Patent Application which is impugned herein which is dated 07.08.2002 and the Great Britain convention application which got terminated. The application shows the several countries which are the designated countries. The Report which we have extracted above states that it would be an advantage if the applicant discloses whether he had applied for a patent in a foreign country or countries.

105. In the present case, the respondent had made a request for preliminary examination which is the first step in processing of the application. The IPER disclosed to him the negative results and thereafter he did not proceed further. But definitely the request for the IPER report related to processing an application in a country outside India. If the respondent had paid the fees that application would have become a Great Britain application. The word ‘processing’ is an all encompassing word, it would take within it the series of actions or steps to be taken in order to achieve a particular end. In the instant case it is to obtain a patent in Great Britain which is the designated country. And when we consider the purpose for which this provision was introduced, the difficulty that was sought to be addressed, we cannot narrowly construe the words “relating to the processing of an application.” Any one who has taken steps which when completed successfully will secure to him a patent in a country outside India, is doing something relating to the processing of an application. Not to do so, and to treat PCT applications as outside the purview of S.8(2) would be to render the provision almost otiose. The object can easily be scuttled. Further, if the respondent had filed the

application and not done anything further, the position may be different. Here the respondent had obtained the IPER and appraised itself of the adverse results. If the respondent had paid the search fee/filing fee and patent was granted then he would have obtained the patent rights in each of the designated countries. **Therefore it is clear that what he had done thus far was "relating to processing of an application in the country outside India".**

106. The respondent cannot be heard to say that since European Patent No.1106578, the prior art was anyway considered by the Controller and no prejudice was caused by not disclosing the ISR or IPER. It is not enough that the Examiner knew that this prior art was there, the respondent ought to have disclosed the results of the IPER. The IPER rejected the claims 1 to 3 on both the grounds of novelty and inventive step. It is not for us to conjecture what effect this might have had on the examiner here if he had the benefit of the IPER. This is the object and purpose of enacting Section 8. The Report says that this information would be of great use for a proper examination of the application. It is no answer to say anyway the office looked at EP'578. The Patent Office did not see the IPER. The learned counsel for the respondent submitted that this lapse is of a de-minimis nature, we do not think that honestly furnishing the information or particulars allows a de-minimis qualification.

107. The Act requires compliance with Section 8(1) and 8(2) and the patent applicant must comply with the same. Otherwise the patent is liable to be revoked.

108. The knowledge of the prior art is not the same as the opinion of the EPO . In this case, we sustain the objection raised by the applicant regarding Section 64(1)(m). The patent is liable to be revoked on this ground also

109. **Role of the Expert**

We come to the role of the expert witness. The expert witness assists the court by explaining the technology, the state of the art, the meaning of the technical step etc. In Verathon (cited supra), it is clearly held that the expert can opine on questions such as obviousness, which are questions of fact and not of law. "But the view of an expert cannot bind the court on issues which it is the task of the court to determine. He is not and need not approximate the notional skilled addressee". In that case there were three experts and in their submissions both the counsel criticized the evidence of the other side expert. The Court of Session in a very proper and gracious way observed that it is inevitable that experts wander into prohibited evidential territory, but that "The court can deal with that relatively easily by keeping in mind the purpose and limitations of such experts' evidence". The words "purpose and limitations" are words which have been deliberately chosen. An expert is a witness of fact and his evidence is in the nature of an advice. It is not his opinion but the reasoning with which he supports his opinion, that is the principal contribution of the expert. The learned counsel for the respondent repeatedly said that the expert who had testified for the applicant was not an expert in this field. But Verathon clearly says that the expert is not and need not be the notional skilled addressee and that the Court is persuaded by the reasoning and not the opinion. Both the witnesses are respected experts and they have given their reasons for the opinions they have arrived it. We have assessed their evidence and the materials on record to arrive at our conclusion.

110. We find as a rule the experts called upon by the parties before us file affidavits. These affidavits are naturally drafted by the respective advocates. So they read almost like the statement of case or counter statement depending on who has called the witness. Instead it may be better to just get their opinion in the form of an affidavit. This opinion will deal with the prior art, the common general knowledge, this invention and why the expert is of the opinion that it is anticipated or not, it is obvious or not. Even when the affidavit has to counter the opinion of the other side expert, it is better merely to say that the expert disagrees with the opinion and for what reason. Instead the affidavits contain attacks on the expertise of the experts. This must be eschewed. Each expert gives his opinion and the reasons therefor and the Court / Board will apply its mind and decide how relevant the evidence is for proving the case. The experts are respected academicians in their fields and such attacks may discourage the best minds from offering to assist us. It will be then a loss to the development of IP jurisprudence. The expert evidence is one of the relevant facts which the court has to consider and while deciding the patentability of some inventions, this may be very crucial. We hope the members of the Bar will bear this in mind, when they request experts to assist us. Whether they appear in the witness box or file affidavits in lieu thereof, the witnesses deserve our respect.

111. In view of the above, ORA/18/2010/PT/MUM is allowed and the patent is revoked with cost of Rs.5000/-.

112. Miscellaneous Petitions are for receiving additional documents. We have taken them into account as those documents are necessary and Miscellaneous Petition Nos.73/2011, 7/2012 and 22/2012 are ordered. Miscellaneous Petition No.16/2012 filed to amend the cause title has also allowed.

(D.P.S. Parmar) **(Justice Prabha Sridevan)**
Technical Member (Patents) **Chairman**