

(2021) 03 IPAB CK 0002

Intellectual Property Appellate Board, Chennai

Case No: Original Application No. 40 Of 2014/PT/CHN

Tvs Motor Company Limited

APPELLANT

Vs

Controller

RESPONDENT

Date of Decision: March 25, 2021

Acts Referred:

- Indian Patents Act, 1970 - Section 2(1)(ja), 10(4)(c), 15, 117A

Hon'ble Judges: Dr. B.P. Singh, Technical Member; Dr. B.P. Singh, J

Bench: Division Bench

Advocate: Jayaraman

Final Decision: Allowed

Judgement

1. The present appeal has been filed under Section 117A of the Indian Patents Act, 1970, against the order dated 20/03/2014, passed by the

Respondent, being the Assistant Controller of Patents & Designs, under Section 15 of the Indian Patents Act, 1970, refusing to grant the

Appellant's Indian patent application no. 555/CHE/2008.

2. The appellant has submitted that the Respondent has erroneously refused their case on the ground of lack of novelty in respect of document D1

(EP1380449 A2).

3. It's the case of the appellant that:

Â The impugned order improperly applies the settled law in determining lack of novelty and the respondent has failed to realize that in attempting to

establish lack of novelty, it is to be shown that the whole invention is contained in the prior document (D1) which is not the case here. The Appellant

reiterates that the Respondent has not furnished any reasoning for the basis on which it was concluded that the impugned order lacks novelty. Nothing more than mere addition of reference numerals of the cited prior art document D1 in parentheses against the elements of impugned claim 1 was provided in order dated 20th March 2014.

Â The Appellant reiterate that while concluding that the impugned claim 1 lacks novelty in view of the prior art document D1, the decision of the respondent has failed to show that the whole invention claimed in impugned claim 1 is contained in the prior art document D1, which is the basis for establishing lack of novelty.

Â It is pertinent to reiterate herein that the Respondent has rightly held that the claimed invention of the present application does contain an inventive step with respect to prior art document D2-D3 (as cited in the FER and in the first hearing notice). It is further submitted that none of the features of the independent Claim 1 of the present application would have been anticipated in view of existing knowledge in the cited prior art document, D1:

EP1380449 published on 14.01.2004. To support the above argument, Appellant relies on the following comparison of the rejected claims of the present application, in particular, independent claim 1 vis-À - vis the cited prior art document D1.

4. Differentiating features of D1 (EP1380449 A2) with reference to the present invention as claimed in independent claim 1:

Â The impugned claim 1 of the present application has at least three elements which are not disclosed by the document D1:

â€œ|.trailing arm having forward portions secured to the brackets at first pivotal connection by threaded fastenersâ€|.â€

â€œ|.anti-roll bar consisting of tubesâ€|.â€

â€œ|.and reinforcement tubes welded to the trailing arm.â€

Â The antiroll bar of the present invention shown in fig 6 below includes tubes (8) that are connected to the forward portions of the trailing arm (3).

Further, the tubes (8) contain reinforcement tubes (7) provided at the end of tubes (8), which is not disclosed by the cited prior art document D1.

Further, it can be observed that the two tubes (8) run straight between the trailing arms (3), wherein each of the tube (8) has reinforcement tubes (7)

at its ends. The reinforcement tubes (7) provided at the end of each of the tube (8) is secured to the brackets (9) at the forward portion of the trailing arms (3). This construction enables the tubes (8) of present invention to enhance safety and stability of the vehicle without transferring shocking forces to the chassis, thereby providing comfortable ride for the passenger and the rider of the motor vehicle as explained in the complete specification.

Fig. 6 of the present application

Â On the contrary, document D1 discloses "an anti-roll bar (30) having opposite end portions (32) and a central portion (34) transverse to and extending between said end portions". Further, claim 1 of document D1 also clearly states that it includes a single central portion and not "tubes" as claimed in the impugned claim 1.

Â Further, document D1 discloses that the anti-roll bar includes end portions and not the reinforcement tubes as claimed in impugned claim 1. D1 also discloses "a pair of spaced apart trailing arms (16) each including a forward portion (18) pivotally supported by said frame and extending longitudinally to a rearward portion (20); and an anti-roll bar (30) having opposite end portions (32) and a central portion (34) transverse to and extending between said end portions, said end portions respectively arranged longitudinally along a portion of said trailing arms and pivotally secured respectively to said trailing arms."

Â D1 further discloses in claim 2 that "wherein said rearward portions of said trailing arms includes a pocket (36) opening downward away with at least a portion of said end portions received in said pockets." Here, D1 discloses the rearward portion of the trailing arm to include pockets for receiving the end portions of anti-roll bar and not to the front portion of the trailing arm as claimed in the impugned claim 1. In the impugned claim 1 of present invention, anti-roll bar is mounted at the front portion of the trailing arm that helps in achieving more torsion and is not subjected to high bending loads which is not disclosed in prior art document D1 where the anti-roll bar is connected through end portions to the rearward portion of the

trailing arm and hence is subjected to higher bending loads.

Â Fig.2 of the cited prior art document D1 shows an anti-roll bar 30 arranged laterally between the trailing arm 16 and is connected between the rearward portion 20 of the trailing arm

16. Further, as can be seen in Fig.2 of the cited prior art document D1, the anti-roll bar 30 is a single bar and does not contain two tubes as claimed in the present invention.

Â Further, D1 does not disclose reinforcement tubes provided at the end of the anti-roll bar tubes as claimed in the present invention. On the other hand, D1 merely discloses the end points 32 receiving the anti-roll bar 30. The anti-roll bar 30 is C-shaped and pivotally connected using second pivotal connection 44, and additional bushings 52 that are supported using brackets 50 and fastened using fasteners 54.

Fig. 2 of cited prior art document D1: EP1380449 A2

Hence, from the above explanation, it is abundantly clear that the three features of independent claim 1 of the present invention as indicated in paragraph 4, are not disclosed in cited prior art document D1. Thus, the subject matter of D1 cannot be considered as a novelty destroying prior art.

Â In the present invention, an anti-roll bar consists of tubes and reinforcement tubes which helps in improving bending stiffness of antiroll bar and enhance the safety and stability of vehicle without transferring shock forces to the chassis whereas in D1, the end portions are not supplied with reinforcement tubes.

Â In the present invention, the anti-roll bar provided with plurality of tubes each provided with reinforcement tubes at its end, the anti-roll bar achieves improved stiffness with less weight due to plurality of tubes and reinforcement tubes connected to the trailing arm through brackets help in reducing stress at the welding junction whereas in D1, the anti-roll bar is bended in C-shape and provided with the end portions connected pivotally to the trailing arm using second pivotal connection, and additional bushings are supported using brackets and fastened using fasteners which increases the weight of the suspension system and requires more number of components to sustain additional load.

Â In the present invention, anti-roll bar is mounted at the front portion of the trailing arm that helps in achieving more torsion by not being subjected to high bending loads whereas in cited prior art document D1, anti-roll bar is connected through end portions to the rearward portion of the trailing arm and hence is subjected to higher bending loads.

5. The First Examination Report (FER) contained the following main objections:

Â âœœObjections :

Claim 1 is to be duly characterized in order to delineate the inventive part from the known features.

Invention claimed in claims Prima facie lack novelty. See for instance EP1380449 that discloses a trailing arm (16) secured to brackets(50) by threaded fasteners(54) and an anti-roll bar (30) welded to the trailing arm.

Without prejudice to the above objections the alleged invention does not appear to meet the requirement of section 2(1) (ja) of The Patent Act,

because the claimed subject matter does not constitute an Inventive step in view of documents

D1: JP62134309

D2: KR20030006340

DI teaches, To absorb the resisting force against the breaking action maintaining antilift effect by pivotably mounting a knuckle on a trailing arm,

connecting them to the front and rear ends of a link and interposing a rubber bush between the pivotable fitting part and the connecting part. The front

end of a trailing arm 1 is pivotably supported on a pivotably fitting shaft 11 provided in the side direction of a vehicle body, by means of a rubber bush

12. An upper arm 6 is connected by a ball joint 13 in the upward direction of a knuckle 2 having axis 3 while in front and the rear of the upper arm 6,

lower arms 7, 8 are respectively coupled with pivotably fitting shafts 14, 15 in the front and rear directions by means of respective rubber bushes 21-

23 equipped with tubes.; Respective arms 6-8 are pivotably supported on a vehicle body by respective pivotably fitting shafts 24-26 through respective

rubber bushes 21-23 having tubes. And, the arm 1 and a tension link 33 are coupled with each other to the upper and lower bosses 4, 5 provided at the

knuckle 2 by pivotably fitting shafts 28, 32 in the side direction through rubber bushes 27, 31, respectively.

D2 teaches, A trailing arm mounting bush of a vehicle is provided to improve the traveling experience by damping the vibration transferred to the

interior of the vehicle. Semicircular deformation spaces(15,16) are formed in the front and rear portions of a shaft hole(14) formed in the center of a

shock absorbing member(13). Tubes(17,18) having the shape the same as that of the deformation spaces are embedded in the deformation spaces. In

the front tube, a valve(19) for easily discharging air is installed. In the rear tube, a valve(20) for easily flowing in air is installed. When a trailing arm

moves forward and backward, the deformation spaces are deformed. Then, a difference is generated in the damping forces of each direction. Thus,

the shock is damped efficiently.

Hence a person skilled in the art will be motivated to combine both the knowledge and come to a conclusion similar to present alleged invention.

The dependent claim [s] also do not provided any new feature with respect to the prior art. Hence the present claim[s] are not allowed u/s 2(1)(ja).

Claim 6 is not sufficiently definitive and does not meet the requirement of section 10(4)(c) of the Patents Act, 1970.

[Emphasis added]

6. The operating portion of the order of the Respondent is as follows:

“ I agree with the contentions of the applicant regarding the inventive step in view of the documents D2 & D3 as the arrangement of the antiroll

bar as claimed is not apparent from neither of the documents. However the document D1 which is cited for lack of novelty is found relevant. D1

relates to an antiroll bar suitable for a heavy duty trailing arm suspension system. It comprises a trailing arm (represented by reference numeral 16)

having a forward portion (18) secured to brackets (14) at first pivotal connections (22) by threaded fasteners (column 2, lines 27 to 30). It also

discloses an antiroll bar (30) consisting of tubes (34) and reinforcement tubes (32) welded to the trailing arm (column 3, lines 8 to 11). Hence the

alleged invention claimed lacks novelty in view of the document D1- EP1380449 A2 dtd 14/1/2004.

Having considered all the facts, submissions made by the agent during the hearing and as well as all the documents on record and also in view of my

above findings, as the alleged invention claimed lacks novelty I hereby refuse the application for Patent number 555/CHE/2008 under section 15 of the

Patents Act 1970.â€

7. It is evident that the respondent has held that the objection of lack of inventive step originally contained in FER, was considered to have been

satisfied as the features of the invention was not apparent from any of the cited documents i.e. D1: JP62134309 and D2: KR20030006340. However,

the Respondent could hold that the invention lacks novelty in respect of document D1 i.e. EP1380449 A2. There appears some confusion herein when

the Respondent holds the invention as lacking in novelty but passing the test of inventive step.

8. It is also noted from the FER that the first objection was relating to the characterization of the inventive feature(s). The appellant while submitting

their response to FER submitted that

However, there is no evidence of such amendments of claims produced before us. Further with regard to objection at para 6, the appellant have

submitted as under:

9. It is evident that the respondent in his order narrated the features of the claim 1 of the instant invention and supplemented reference numerals in

parenthesis, taking from the cited document. The comparison has been made in such a way that it appears that all the features of the instant invention

are identical to the cited document, which not the case. Further, the instant invention has also suffered with poor prosecution skills wherein after

submitting that the claims are amended, actually they were not amended. If the claims were amended at the stage of prosecution, as required by the

first official action, probably the outcome could have been different.

10. I have verified the cited document and found that the claim 1 of the cited prior art, though relating to anti-roll bar, has distinguishing features when

compared with the instant invention and hence we agree with the contention of the appellant.

11. After considering the submission of the appellant and reviewing the document it is ascertained that the cited prior art is similar but not an identical

document. It is evident that not all the features of the instant inventions are anticipated by the prior art. It is well known that a prior art is considered as anticipating novelty if all the features of the invention under examination are present in the cited prior art document.¹ Clearly it is not the case and hence the Respondent's contention that the invention is not novel cannot be accepted.

12. However, looking at the claims of the instant invention on record and the submission of the appellant, quoted in para 4.1, 4.2, 4.10- 4-12 ante,

showing some distinguishing feature(s) of the invention, it is wondered that why the appellant didn't amend the claims as required by the office

action during prosecution, in line with their submission herein. As such the appellant are directed to amend the principal claim so as to

characterize the inventive feature(s) of the invention over the cited prior art and the feature(s) be supplemented with the reference numerals

in parenthesis based on the relevant figures of the drawings. The appellant are also directed to delete the omnibus claim no. 6 in view of the settle

practice narrated in para 05.03.17 of the MANUAL OF PATENT OFFICE PRACTICE AND PROCEDURE²

v) The practice of including an omnibus claim does not have any legal basis under the Patents Act. In fact, such a claim cannot be allowed as per

Section 10(4)(c) of the Act, being non-definitive with respect to scope of invention for which the protection is claimed

13. I, therefore, direct the appellant to submit amended set of claims 1-5 as narrated above in para 12 ante, to the respondent within 3 weeks of

issuance of this order.

14. I set aside the impugned order of the Respondent dated 20/03/2014 and direct the respondent to grant the patent on the amended set of claims 1-5,

strictly within 3 week from the submission of amended set of claims by the respondent.

15. Keeping in view the above, the instant appeal is allowed. No cost.