

**(2014) 05 DEL CK 0328**

**Delhi High Court**

**Case No:** I.A. No. 20605/2013 & I.A. No. 1276/2014 in CS(OS) No. 2558/2013

3M Innovative Properties  
Company

APPELLANT

Vs

Venus Safety and Health Pvt. Ltd.

RESPONDENT

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**Date of Decision:** May 30, 2014

**Acts Referred:**

- Civil Procedure Code, 1908 (CPC) - Order 39 Rule 1, Order 39 Rule 2, Order 39 Rule 2A, Order 39 Rule 4, 151
- Patents Act, 1970 - Section 107, 12, 13, 13(4), 2(1)(j)
- Trade Marks Act, 1999 - Section 31

**Citation:** (2015) 215 DLT 317 : (2014) 59 PTC 370

**Hon'ble Judges:** Manmohan Singh, J

**Bench:** Single Bench

**Advocate:** Amit Sibal, Sr. Advocate and Mr. Peeyoosh Kalra, Mr. Vineet Rohilla, Mr. C.A. Brijesh and Mr. Nishant Sharma, Advocate for the Appellant; Neeraj Kishan Kaul, Sr. Adv., Mr. Sagar Chandra and Ms. Harini Niveda, Advocate for the Respondent

**Final Decision:** Disposed Off

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**Judgement**

Manmohan Singh, J.

By this order I propose to decide the two applications, under Order XXXIX Rule 1 & 2 filed by the plaintiff and under Order XXXIX Rule 4 CPC filed by the defendants.

2. The present suit has been filed by the plaintiffs against the defendants for permanent injunction restraining defendants from infringing the registered patent No. 211175 granted by the patent office on 17th October, 2007 registered in respect of "Flat Folded Personal Respiratory Device and process for preparing the same" in favour of plaintiff No. 1(hereinafter referred to as the "suit patent"). The patent is valid in India for 20 years from the date of application made by the plaintiff No. 1 on 26th May, 1999.

3. Plaintiff No. 1 is a company incorporated in the USA. Plaintiff No. 2 is the Indian subsidiary of plaintiff no. 1 having its office at Bangalore. Defendant No. 1 is an Indian company having its office at Navi Mumbai who is manufacturer of respiratory protection devices including particulate filtering masks, half masks, full face masks etc. Defendant No. 2 is a distributor of the products manufactured/offered for sale by defendant No. 1, having its office at New Delhi.

4. Alongwith the suit, an application under Order 39 Rule 1 & 2 read with Section 151 CPC being I.A. 20605/2013 was filed. When both the suit and application were listed before Court on 18th December, 2013, summons were issued in the suit and notice in the application. An ex parte order was passed restraining the defendants in terms of prayer (a) of the application from infringing the patent rights of the plaintiff no. 1 under the suit patent by making, manufacturing, using, offering for sale, selling and importing the respiratory protection device (Model No. V-4410) and/or any other devices covered by the suit patent or otherwise.

5. Upon service, the defendants have filed reply to the interim application and also an application under Order 39 Rule 4 being I.A. No. 1276/2014 seeking vacation of the said interim order dated 18th December 2013. The defendants have also filed written statement and counter claim challenging the validity of the patent. The plaintiff's application under Order 39 Rule 2A read with section 151 CPC for violation of ex-parte order is also pending wherein the notice has been issued and time to file reply is granted to the defendants.

6. By this order I propose to decide the two applications, under Order XXXIX Rule 1 & 2 CPC filed by the plaintiff and under Order XXXIX Rule 4 CPC filed by defendants.

#### Plaintiff's Case

7. The relevant facts germane to the disposal of these applications mentioned above are that the plaintiff No. 1 is the owner of the suit patent granted by the Indian Patent Office on 17th October, 2007. The suit patent is being used in relation to a respiratory protection device adaptable to be worn by a wearer for protection against air pollution specifically for dusts and bears product No. 3M 9004 IN and 3M ID: IA520143149 (hereinafter referred to as the "patented device"). In the plaint it is alleged that the plaintiffs' parent company 3M Company was established in the year 1902 and has been involved in several inventions and discoveries in various markets, from health care to highway safety to consumer and office products, optical films for LCD displays etc. The plaintiff No. 1 operates in five business segments viz. health care, industrial and transportation, consumer and office, safety and graphics, and electronics and energy. The details of its sales, investments in research and development, ranking etc. are given in Para 11 and 12 of the plaint. In India, the 3M company's presence dates back to 1987 with the formation of "Birla 3M Limited", a joint venture which was subsequently changed to plaintiff No. 2 in December 2002. The details of turnover and investments in research and development of plaintiff No.

2 are given in Para 13 and 14 of the plaint. The details of the sales figures of its respirators in the Asia-Pacific countries is given in Para 15, with special reference to India where the sales figures of the same have been stated to be US\$ 1,136,613 for the year 2012.

8. It is averred in the plaint that with a view to overcome the disadvantages in a filtration respirators, also referred to as face masks, particularly, the complexities in manufacturing and the discomfort to the wearer, the patent device was invented. The objective of inventing the patent device was to provide a flat folded personal respiratory protection device that is capable of being flat-folded and yet provides a good respiratory seal with a comfortable fit over the wearer's face. The patented device comprises a non-pleated main body having a first portion, a second portion distinguished from the first portion by a first line of demarcation, a third portion distinguished from the second portion by a second line of demarcation and a bisecting fold extending through the first portion, the second portion and the third portion. The lines of demarcation have been found to improve the flexibility and conformance of the device during wear around the nose and the chin of the wearer. The patented device attains a convex open configuration when unfolded for being worn by a wearer. In this configuration, the main body of the device is substantially off the face of the wearer and yet it is in sealing arrangement with the face of the wearer to provide an air chamber over the nose and mouth of the wearer. The patent device has been granted corresponding patents in as many as 11 countries besides India, details of which have been given in Para 22 of the plaint, out of them, the US patent bearing No. 6,394,090 being the first one to be registered as on 28th May, 2002.

9. It is stated that during the second week of August, 2013, the plaintiffs came across the defendant No. 1's respiratory protection device being commercialized under model No. V-4410 (hereinafter referred to as the "impugned device") that has all the elements of claims 1 and 15 of the suit patent and claims depending from claims 1 and 15.

10. Claim No. 1 and claims No. 15 to 18 of the suit patent which are relevant are reproduced below for ready reference:

Claim 1. A flat folded personal respiratory protection device comprising:

a non-pleated main body comprising:

a first portion;

a second portion distinguished from the first portion by a first line of demarcation;

a third portion distinguished from the second portion by a second line of demarcation;

and a bisecting fold that is substantially vertical when viewed from the front when the device is oriented as in use on a wearer, the substantially vertical bisecting fold extending through the first portion, second portion and third portion; wherein the device is capable of being folded to a first substantially flat-folded configuration along the bisecting fold and is capable of being unfolded to a convex open configuration.

Claim nos. 15 to 18 in respect of the process of manufacturing the product, read as under:

Claim 15. A process for preparing flat-folded personal respiratory protection devices, comprising folding a preformed blank over a bisecting axis to create a perform having a bisecting fold-line and cutting the perform at a first desired angle at a first position relative to the bisecting fold-line, wherein the first desired angle depends on a desired size of the device.

Claim 16. A process as claimed in claim 15, comprising the additional step of cutting the perform at a second position relative to the bisecting fold-line, wherein the second desired angle depends on a desired size of the device.

Claim 17. A flat folded personal respiratory protection device, substantially as hereinabove described and illustrated with reference to the accompanying drawings.

Claim 18. A process for preparing flat folded personal respiratory protection device, substantially as hereinabove described and illustrated with reference to the accompanying drawings.

11. It is alleged by the plaintiffs that the defendants are guilty of infringing the suit patent on account of their manufacturing, offering for sale and selling a device identical to that covered by the subject patent. From the comparison of defendant No. 1's infringing device, Model V4410 (hereinafter referred to as the "impugned device") with the claims of the subject patent, it is crystal clear that the Defendants' device is infringing the claims of the suit patent. Photographs of the parties device covered by the suit are reproduced herein:

Defendant's case

12. The suit as well as the interim application are resisted by the defendants who have denied the claim of the plaintiffs' to be the owner of the patent. They assert that the suit patent was already known, prior published/registered and used in foreign countries and it was known in India prior to the date of application of the patent. Copies of specification of patent already granted to the third parties prior to the date of application of plaintiff No. 1 are filed in order to support their case.

13. The impugned device has been in the market at least since 2011 within the knowledge of the plaintiffs and they have withheld the said information from this

Court and obtained the said injunction by claiming that the product in question came to their knowledge in August, 2013. It is averred by them in this regard that they had advertised the impugned device in the April-June, 2011 edition of magazine titled "Industrial Safety Chronicle" published by the "National Safety Council" along with a free sample. It is also submitted that the page 14 of the said magazine has the advertisement of the Plaintiff No. 2 with the address Concorde Block, UB City 24, Vittal Mallaya Road, Bangalore-560001. Thus the probability of the Plaintiff being aware of a competitor's product is high. The Defendant is the plaintiffs' foremost competitor in the industry in India and therefore it is inconceivable that the Plaintiffs were unaware of the presence of its foremost competitor and the competing product in the market since 2011. The Plaintiffs chose to sleep over their rights for over two years and has approached the Court belatedly and with unclean hands.

14. With regard to validity of patent in question, it is stated that u/s 13(4) of the Patent Act, 1970 there is no presumption of validity in respect of a patent granted under the Act. The Indian Patent Office at the time of examination of the patent application of the plaintiff raised an objection in respect of US Patent No. 5701892 which have till date not been answered by the Plaintiff. In their letter dated 15th September, 2005 that the Plaintiff should clearly project out the distinguishing features of the invention in question from the prior patent specifications, US 5701892A, FR 2457107A and US 3971369. The said objection has not been replied to by the plaintiff no. 1 and the patent has been granted.

#### About the Defendants

15. It is submitted that the Defendant No. 1 was originally established as Visvesvara Enterprises in 1983 and commenced manufacturing respiratory protective filters since 1987. In the year 2007, the said proprietorship concern was incorporated & styled as Venus Safety & Health Pvt. Ltd. with an intention of corporatization. The same has led the defendant No. 1 Company as a progressive manufacturer of Personal Protective Equipments (PPE) providing quality products and services with 100% Indian capital and technology. The defendant No. 1's competitive products and services are well accepted in the National & International markets whose product range caters to the applications for following industries such as: Automobile, Construction, Mines, Power Engineering, Defense, Pharma, Chemicals, Ports & Shipyards, Textiles, Refineries & Others. The said defendant is also the First bona fide holders of the Bureau of Indian Standards certification marks (ISI) license for several respiratory devices. It has since then been granted over Seven ISI Licensees. The Defendants also have obtained European product approvals, certified by BIA, Germany since 1999 with respect to the Flat Fold Series of the Personal Respiratory Devices. The details of the Sales figures of the Defendant No. 1 company and the expenditure in R&D activities for the last ten years has been mentioned in Para 9 of the written statement.

#### About defendants product

16. The defendants have been pioneers and leaders in the Personal Respiratory, Protection Device Industry since 1988 and have been manufacturing the Flat Folded Respiratory Devices which open up into a cup shape at least since 1994. The defendants have obtained various National and International Approvals for their Personal Protection Respiratory Devices as well as the impugned product. Some of the accomplishments of the defendant No. 1 given in Para 10 of the written statement.

The first of such devices manufactured by the defendant were numbered as the V4 series. Over the years the Defendant No. 1 came out with other products as described below.

◆ V4 (without ISI approval)

◆ V40 (Flat folded respirators with exhalation valve with Indian Approval),

◆ V 400 (Flat folded respirators with exhalation valve with European Approval)

◆ V 44-V4 re-introduced in Indian market with ISI approval.

It is alleged by the defendant No. 1 that the only difference between the impugned device, being model number V-4410 and V-4 is that the impugned product has the Lines of demarcation and the single part nose piece is embedded within the device. The lines of demarcation that have been used by the Defendant in the product in question has been used as guiding or reference lines to locate the centre of the single part nose piece, which is embedded inside the mask, that will facilitate the folding of the device and thereby allowing the nose piece to be placed comfortable on the wearer's nose. Claim 1 of the Plaintiffs claim is clearly covered by prior art as well as the Defendant's own product manufactured prior to 1999 i.e. V4 series of masks.

17. Alternative plea is also taken by the defendant that there are many dissimilarities in the Defendants product in question vis-~~à~~-vis the Patent Claims and also their product. The details mentioned are given as under:

(a) A single part nose piece in the Defendants product is embedded inside the first portion of the mask whereas in the Plaintiffs suit patent is to be applied outside. The single part nose piece cannot be embedded inside. On the other hand the defendant has inserted a single part nose piece and therefore the Lines of Demarcation are required as guiding lines.

(b) Defendants' product is divided into only in two portions whereas the Plaintiffs' product and claimed invention has to have three portions. The said style and process of manufacturing in two portions has been adopted by the Defendants at least since 1994. The Plaintiffs product is divided in to three independent portions as the functionality of the three varies with the different fabric layers being present in the three independent portions as claimed by the Plaintiff in the Specification,

whereas the Defendants product is divided into two parts.

(c) The weld line in the Defendants product is present only in the second portion which is continuous and a single line as against the two weld lines present in the first and third portion of the Plaintiffs product. The first portion of the Defendant's product is not a weld line but only a fold. The welding in the second portion prevents collapsing of the product on the wearer's face in the Defendant's product and this functionality is not obtained by the Lines of Demarcation as claimed by the Plaintiff. The joint like function of the Lines of Demarcation performed along with the Stiffener layer can be demonstrated as against the Plaintiff's Indian product which does not perform the function. The claim 1 of the suit patent does not deal with the functionality of the lines of demarcation rather it uses as a line to differentiate the product into three parts.

(d) The Lines of Demarcation that have been used by the Defendant in the product in question has been used as guiding or reference lines to locate the centre of the single part nose piece, which is embedded inside the mask, that will facilitate the folding of the device and thereby allowing the nose piece to be placed comfortable on the wearer's nose. The lines of Demarcation in the Defendant's product are not parallel to the top and bottom edges of the blank and are intersecting. The canons of claim construction mandates the reading of the Claims, followed by the Specification and then any other tertiary literature in case the claims are silent. The prior art indicates that the lines of demarcation are construed to be parallel with respect to the top and bottom edges of the blank. They are present in the Defendants product to only provide a two point reference/guiding for the folding of the single part nose piece from the centre during the manufacturing process of the Defendants product. Whereas, as per the Plaintiffs claim and product the said lines of demarcation are parallel in the body of the mask in the process of manufacturing.

(e) There is no Stiffener Layer present in the Defendants product as is there in the Plaintiffs product between the First and Third portion. The Plaintiffs have also made an averment in their application and plaint that the Defendant's product has a Stiffener layer in addition to the cover layer and the filter media. There is no such stiffener layer present in the Defendants product. The Plaintiffs have actually disclosed the composition of the Stiffener in the suit patent as "Spun Bonded Polypropylene 75 gms/sq. meter" whereas the Filter Medium of the Defendants Product is made of "Needle Punch Non-calendared Polyester 80 gms/sq. meter non woven". The Plaintiffs in their Model No. 9004 does not have the Stiffener layer at all in the Indian market vis-à-vis the International market where the said product is sold with the stiffener layer. The functionality of the Stiffener layer as claimed by the Plaintiff is to prevent the collapse of the device on the wearer's face thereby preventing abrasion caused due to wetness, if at all the device was in contact with the wearer's face. As far as the lines of demarcation are concerned, as claimed by the Plaintiff possesses a joint like function thereby allowing movement only in the

first and third portion of the device and not in the central portion. This advantage claimed in the suit patent is the technical advancement made in the suit patent, which can be achieved only by the presence of the Stiffener layer and the lines of demarcation in combination. The presence of one and the absence of the other will not yield the intended results.

18. It is also alleged that the process of manufacturing of the Defendants product is completely different from that claimed in the suit patent. The major points of difference in the manufacturing process of the Defendants can be demonstrated as under:

(a) That the flow of material while manufacturing the product in question on the machine is horizontal in the Defendants manufacturing process as against the Plaintiffs" which is vertical. It is due to this reason that the Defendants are able to embed the single part nose piece in the mask whereas it is not possible in the Plaintiffs process. The defendants process does not enable them to put a stiffener in the second portion whereas the Plaintiffs manufacturing process allows for the same.

The lines of demarcation are intersecting with respect to the blank in the body of the mask on the Defendants product which is not the case in the Plaintiffs product. Further these lines of demarcation serve the purpose of providing a two point reference/guiding for the folding of the single part nose piece from the centre, which is embedded inside the Defendants product, during the manufacturing process of the Defendants product;

(b) The single part nose piece is present inside the Defendants product which is not possible if the Plaintiffs" process for manufacturing is employed. Only a two part nose piece can be inserted within or alternatively a single part nose piece can be attached on the outside of the product as per the Plaintiffs process which is impossible in the Defendants process. The flow of material while manufacturing the product in question on the machine is horizontal in the Defendants manufacturing process as against the Plaintiffs" which is vertical.

(c) Nowhere in the suit patent of the Plaintiff, it states that the process encompasses both horizontal as well as vertical flow of material while manufacturing the product. The defendant"s process does not fall within the scope of the above claim 15 of the suit patent.

19. It is stated that the process has been the same for manufacturing all the Flat Fold Personal Respiratory Devices since the year 1994 of defendant No. 1. The plaintiffs had not entered either the national or the international market in the year 1994 for Flat Fold Respiratory Devices. There is no infringement of the process or the product patent.



20. Counter claim of the defendant No. 1: The defendant No. 1 has filed a counter claim by challenging the validity of the suit patent. It has been stated that the impugned Patent is liable to be revoked on the following grounds:

(a) OBVIOUS & LACK OF INVENTIVE STEPS

(i) Subject matter of the patent is obvious in nature and does not involve an inventive step keeping in mind what is publicly known and published in India. Therefore is liable to be revoked u/s 64(1)(f) of the Act. The compound claimed in the suit patent is obvious for a person skilled in the art on the basis of the knowledge that was already available in the public domain prior to the filing of the suit patent.

(ii) The suit patent has two independent claims namely Claim 1 and Claim 15. Claims 2-14 are dependent on claim 1, whereas claims 16-18 are dependent on claim 15.

As far as Claim 1 is concerned the same is clearly covered by Prior Art. Firstly, a "Flat Folded Personal Respiratory Device comprising a non-pleated flat body which is capable of being unfolded to a convex open configuration" is covered by the Defendants own product that is being manufactured and sold since 1994. Secondly, a flat folded respiratory device which can open into a cup shape device has been disclosed in US patent No. 3971369 dated June 23, 1975. Thirdly, as regards the Lines of Demarcation, the division of the device in three parts and the bisecting fold has already been covered by and is explained in US Patent No. 3971369 and 5701892 dated June 23, 1975 and December, 1, 1999, respectively.

Therefore the Claim 1 is covered by prior art and is anticipated and obvious to a person skilled in the Art. Claim 1 is covered by prior art, the other Claims 2 to 14, dependent on claim No. 1 are also ipso facto anticipated. Thus there is no infringement on the part of the Defendant in respect of Claim 1.

(iii) The US Patent No. 5701892 dated 1st December, 1999 relates to multipurpose face mask that maintains an airspace between the mask and the wearer's face. This prior art patent discloses the use of a main body which is non-pleated, has already been employed for the same purpose. The present invention is an improvement which avoids inadequacies of the prior art in numerous kinds of masks.

(iv) Flat folded personal respiratory devices which open into a cup shaped configuration are disclosed in the US Patent No. 3971369. The US Patent No. 3971369 dated June 23, 1975 explains a personal respiratory protection device comprising of a main body comprising a first portion, a second portion distinguished from the first portion by a first line of demarcation, a third portion distinguished from the second portion by a second line of demarcation and a bisecting fold extending through the first portion, second portion and third portion wherein the device is capable of being folded to a first substantially flat-folded configuration along the bisection fold and is capable of being unfolded to a convex open configuration. By the plaintiff's own admission the lines of demarcation are

guiding lines for folding of mask to form pleats and in the Defendant's product the lines of demarcation are mere guiding lines used for encasing a SINGLE PART NOSE PIECE at the centre of the device. Thus, Defendant's product falls squarely within the ambit of the prior art. It is submitted that the US Patent No. 5701892 discloses a flat folded personal respiratory device which is opened in to a cup shaped configuration and possesses a non pleated main body for the same objective as that of the suit patent. This patent also possesses a bisecting fold and can be rolled up in addition to being flat folded.

(v) The International publication WO 96/28217 which was granted in 1996, discloses a personal respiratory protection device which possesses the cover layer, filter media and stiffener layer as disclosed in claims 1, 23, 25 and 38 of the suit patent.

(vi) From the combined study of US Patent No. 3971369 and US Patent No. 5701591 it would be obvious to a person skilled in the art namely when the same result is to be achieved, to apply this solution with corresponding effect to the personal respiratory protection device according to US 3971369, thereby arriving at a personal protection device according to claim 1 of the suit patent. The International Publication No. 96/28217 discloses all the essential features of the suit patent and the suit patent does not discuss the drawbacks of the International publication No. 96/28217 which are being overcome in the suit patent.

(vii) For a person skilled in the art reading the three US patents together will provide him sufficient impetus to reach to the conclusion of the flat folded personal respiratory device as claimed in the suit patent. The plaintiffs being persons skilled in the art have cleverly joined the prior arts, came up with the product and on the basis of false pretext got the patent.

#### **(b) PRIOR ART AND OBVIOUSNESS**

(i) The product of the Defendant is bigger than that of the Plaintiff which clearly shows that the angle used is different. The distinction of the single part nose piece as against a two part nose piece is essential as the Plaintiff's process does not allow encasing a single part nose piece. The defendant's previous models in flat folded personal respiratory devices did not contain the encased single part nose piece and also the lines of demarcation. These lines of demarcation have been introduced by the Defendants as guiding or reference lines to locate the centre of the single part nose piece which will facilitate the folding of the device and thereby allowing the nose piece to be placed comfortable on the wearer's nose.

(j) The process as claimed under Claim 15 is also covered by Prior Art WO96/28217 as it teaches the process which is identical to suit patent and it also discloses the Stiffener layer in claim 25 which plays an important role in the technical advancement of the suit patent.

(k) Therefore it is not an invention as envisaged in Section 2(1)(j) of the Act which says an invention means a new product or process involving an inventive step and capable of industrial application.

(c) THE PATENT IS NOT NOVEL

The subject matter of the suit patent is not novel. Firstly, flat folded personal respiratory devices which open into a convex configuration have been manufactured by the defendant since the year 1994. The process involved in the manufacture of these has also been the same. Secondly, all the essential features of the present invention and the purposes for which they have been used has been disclosed in the prior art.

(d) INSUFFICIENT DESCRIPTION

(i) The suit patent claims certain features which are essential to the invention to be optional. The lines of demarcation which as claimed by the plaintiff to be a welded line hold the various fabric layers and acts like a joint thus preventing the collapse on to the wearer's face thereby providing comfort. The said functionality will exist only if the Stiffener layer is present in the central portion. The said Stiffener layer as claimed in the suit patent is optional. The method and processes described in the complete specification are not by themselves clear enough for any person skilled in this art to be able to produce the respiratory device.

(e) PATENT OBTAINED ON FALSE SUGGESTION OR REPRESENTATION

The patent office in it's first examination report has raised an objection regarding the non-mentioning of the prior art US 5701892. The said objection with respect to the prior art US patent No. 5701892 was not cleared before the grant of the patent as the plaintiff No. 1 was aware about the said prior art, there was no answer, hence, the suit patent ought not to have been granted.

(f) THE SUBJECT MATTER IS NOT PATENTABLE

The subject matter of the claims falls within the ambit of section 3(t) of the Act. The mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way is not an invention. The suit patent merely combines the features as already known in the previous prior art and is thus liable to be revoked.

21. It is submitted that the two products are not identical. Assuming though not admitting it is identical, the process ought to be same as the one used in the manufacture of V4 of the defendant as the products of the Defendants are mere improvements of each other from V4 to V 4410.

22. I have heard the learned counsel for the parties at length. Relevant submissions made by the learned counsel for the plaintiffs are outlined as under:

(a) That the suit patent was granted in favour of Plaintiff No. 1 with effect from May 26, 1999 and the plaintiffs have been continuously manufacturing the product as claimed in the suit patent since 2002. The defendants, after analyzing the suit patent, have dishonestly started manufacturing the infringing product which is identical to that covered by the suit patent. Each element of claim 1 of the suit patent is present in the Defendants' infringing device. While determining infringement of a patent, the infringing device is to be compared with the claims of the patent in question. Even one claim of a patent amounts to infringement of the whole patent.

(b) That a nose piece is not claimed in claim 1 or any other claim of the suit patent. Therefore, the distinction on the basis of said single part nose piece is immaterial and does not prevent Defendants' mask from infringing at least claim 1 of the suit patent. It is of no legal relevance while determining infringement of the suit patent. It is argued that the Defendants' product has three portions and there are two lines of demarcations in the Defendants' product, the first line of demarcation distinguishes the second portion from the first portion and the second line of demarcation distinguishes the third portion with that of the second portion. The presence of these features in the infringing device is admitted by the Defendants through the drawings provided by Defendants' expert, Mr. Ashok R. Saraf in his report.

(c) That the Defendants have deliberately misconstrued the claims in an effort to divert this Court's attention from the similarity of the infringing device vis-à-vis claim 1 of the suit patent. The weld lines mentioned in the claims are in fact the first and second line of demarcation represented by "A" and "B" respectively in the drawings of the suit patent. The presence of each of these weld lines in the infringing device is clear from the visual inspection of the impugned device. The same is admitted by the Defendants through the drawings provided by Defendants' expert, Mr. Ashok R. Saraf, in his report. This purported distinction does not distinguish the impugned product with the main claim no. 1 of the suit patent at all. The lines of demarcation of the defendant No. 1's product is reproduced hereunder: It is argued that the Defendants' assertion that the weld line is present only in second portion of their product is incorrect. It is immaterial for what purpose the said feature has been provided in the infringing device even if the Defendants' assertion is assumed to be true. The purpose of providing lines of demarcation is clearly illustrated in complete specification of the suit patent and it states that "these lines of demarcation have a joint-like function that imparts movement to the first and the third-portions relative to the second portion and imparts structural integrity to the second portion during wear. It was found that these lines of demarcation improve flexibility and conformance of the device during wear around the nose and the chin of the wearer. In one preferred embodiment, the personal respiratory device includes a multi-layer construction. In this embodiment, the lines of

demarcation can prevent delamination of the multi-layers such that the inner layer does not collapse during use. Preferably, the lines of demarcation are welds, because welds impart good structural integrity and prevent delamination."

(d) It is argued that the lines of demarcation in the suit patent not only give an advantage, but the patented device performs joint-like function that imparts movement to the first and the third-portions relative to the second portion and imparts structural integrity to the second portion while wearing on one hand and provide improved flexibility and conformance of the device while wearing around the nose and the chin of the wearer on other hand, are clearly elaborated in the complete specification. The lines of demarcation in the mask of suit patent are not mere workshop improvement and have been added to serve the specific benefits.

(e) The Plaintiff No. 1 is the owner of the suit patent which was granted by the Patent Office after detailed scrutiny and examination of the Plaintiff No. 1's application for patent u/s 12 and 13 of the Act. The invention covered under the suit patent has been rigorously scrutinized and tested by at least two Patent Offices of the world, i.e. India and US vis-à-vis the same prior arts as cited by the Defendants. The prior arts cited by the Defendants are substantially different from the subject invention and the Defendants have failed to bring to light any reasoning as to how the subject invention is obvious in view of the cited documents and accordingly there is no tenable or credible challenge to the validity of the suit patent.

23. It is also argued that by merely mosaicing three prior arts, it cannot be stated that it would be obvious for a skilled person to combine the teachings and arrive at the invention of the subject patent, especially when the prior art teaches in the opposite direction. There is no teaching, suggestion or motivation from the cited prior arts regarding arriving at the solution taught by the subject patent, nor is the problem solved by the subject patent are intended to be solved by any of the prior arts. Thus, the invention claimed under the subject patent is non-obvious in view of the cited prior arts or any combination thereof. By reading the cited prior art document, any person ordinarily skilled in the art will not reach to the solution provided by the subject patent without use of inventive ingenuity. Counsel has also provided the chart in order to distinguish the suit patent with the previously registered patents in favour of third parties.

24. The chart provided by the plaintiff contained very comprehensive details in which the plaintiffs tried to say that the subject matter of patent is not covered under any prior art and the suit patent is a valid invention. In order to distinct the plaintiffs patent with prior art patents of third parties referred by the defendants, in substance it is alleged by the plaintiffs that those do not help the case of the defendant. In sum and substance such details of each patent(prior art) as under:

(i) US Patent No. 3971369:

The lines of demarcation in the subject patent are provided with an aim to render the structure rigid and provide axis of rotation for one or more portions around the said lines of demarcation. The lines of demarcation of the subject patent are therefore different. Any person would not be motivated to develop a mask having rigid lines of demarcation of the subject patent that help in providing rigidity to the structure and at the same time separate various portions of the mask. To the contrary, the mask of subject patent does not have any complex structure and thus the manufacturing process is simple and cost-effective.

(ii) US Patent No. 5701892:

The mask is devoid of any lines of demarcation. The said mask, which is made of supple material, would not have desired rigidity so as to have an off-the-face configuration such that the said mask would have the tendency of touching the wearer's cheeks when the wearer breathes in. The mask is not divided into first, second and third portions that are movable about the lines of demarcation that create such portions. Thus, the said mask is unable to make available the benefits of the mask of the present invention. The mask is folded along bisecting fold and cut in the desired shape. The method does not involve complex steps of forming two symmetrical pieces and then joining them separately in a manner to create a seam in a vertical fold. The mask is not easily portable as the same is flat folded and required to be rolled up to be carried. The mask of the present invention is not required to be rolled up to be carried.

(iii) International application WO96/28217:

The mask is not a monolithic structure in contradiction to the mask of subject patent, which has a monolithic structure. The mask would involve cutting different symmetric portions and thereafter joining the same so as to form the final structure and thus, the process is not as simple as that of the subject patent that does not involve any cutting and joining of pieces. The joints cannot be considered equivalent to lines of demarcation of the subject patent that render substantial rigidity to face of the mask of subject patent. It is submitted that the mask in the absence of lines of demarcation and bisecting fold, fails to provide the beneficial effects of the mask of subject patent, viz. rigid structure, structural integrity, off-the-face configuration at the same time enabling good facial seal and easily manufacturability.

The mask does not include lines of demarcation or the bisecting fold and hence the process flow does not include the relevant steps, as in process of subject patent, to create the same. The process of the subject patent is thus completely different, at least, in terms of the essential steps towards creating lines of demarcation and bisecting folds of the subject patent.

It is submitted that by merely mosaicing three prior arts, it cannot be stated that it would be obvious for a skilled person to combine the teachings and arrive at the invention of the subject patent, especially when the prior art teaches in the opposite

direction. There is no teaching, suggestion or motivation from the cited prior arts regarding arriving at the solution taught by the subject patent, nor is the problem solved by the subject patent are intended to be solved by any of the prior arts. Thus, the invention claimed under the subject patent is non-obvious in view of the cited prior arts or any combination thereof. By reading the cited prior art document, any person ordinarily skilled in the art will not reach to the solution provided by the subject patent without use of inventive ingenuity.

25. In view of above said reasons, it is argued by the plaintiffs that the patent granted is prima facie innovative and the patent certificate is evidence in so far as the validity of the suit patent is concerned. The Defendants are misconstruing the legal position regarding the presumption of validity of a granted patent. Section 13(4) of the Act and this Court's decision in [F. Hoffmann-LA Roche Ltd. and Another Vs. Cipla Ltd.](#), do not suggest that there is a per se rule that a granted patent is not presumed to be valid. Rather, the legal position, as stated by this Court in F. Hoffman-La Roche is that the "registration of the patent does not guarantee its resistance to subsequent challenge", clearly noting that a granted patent may be found to be invalid only if the defendant raises a credible challenge to the patent. Defendants have utterly failed to raise a credible challenge as to validity of the suit patent and, therefore, the suit patent was valid when granted, and remains valid even today.

The Defendants' contention that the six year rule with respect to the presumption of validity has been diluted by this Court is erroneous. To the contrary, the Courts have found that given the short lifespan of new inventions, a new product is losing its significance and market very quickly; therefore, the effective life of a patent has become short which makes the adherence to any six years rule unnecessarily limiting. A patent can therefore be considered to be presumptively valid well before six years from grant.

It is submitted that a careful reading of the order dated December 18, 2013, passed by this Court would show that there was no formulistic reliance on a six year rule with respect to the presumption of validity. The suit patent was granted in 2007 and remained unchallenged for many years (incidentally for more than six years), and that the suit patent has been commercialized in India since 2002 (more than 11 years) which attaches a stronger presumption of validity of the suit patent. The Courts have also supported this position and held that the most cogent evidence for establishing prima facie validity of the patent, would be to establish that the patentee has worked and enjoyed the patent for many years without dispute. Accordingly, it follows that if a patent has been valid, unchallenged and reduced to practice for several years the presumption of prima facie validity and the consequent irreparable harm as a result of infringement heavily weighs in favour of the patentee. The Court did not grant the ex parte injunction order solely on the basis of the six year rule as portrayed by the Defendants. The underlying principle

relied upon by the Plaintiffs in the case of [National Research Development Corporation of India Vs. The Delhi Cloth and General Mills Co. Ltd. and Others](#), is that if the patent is sufficiently old and has been worked, the Court would for the purpose of temporary injunction presume the patent to be a valid one.

26. With regard to the objection about delay for bringing an action in the Court by the defendants, it is argued that Plaintiffs came across the Defendants' respiratory production device in the second week of August, 2013 and thereafter the Plaintiffs lost no time in instituting the present suit of infringement of the suit patent before the Court. It is further submitted that the Plaintiffs have no knowledge about the fact that the impugned product was advertised in April-June 2011 edition of magazine titled "Industrial Safety Chronicle" published by the "National Safety Council". Neither the edition of magazine nor the free samples of the impugned product as alleged by the Defendants were ever received by the Plaintiffs. The Defendants' averments are vague and ambiguous in as much as they have failed to specify the office to which the magazine was delivered or the list of its members. Plaintiffs have 13 offices in India and a global presence in more than 70 countries.

## 27. PRESUMPTION OF VALIDITY

I shall take the issue of presumption of validity and 6 year rule. In view of Section 13(4) of the Act, it mandates that there is no presumption of validity in respect of a patent granted under the Act. The Supreme Court in the case of [Bishwanath Prasad Radhey Shyam Vs. Hindustan Metal Industries](#), has observed that the grant and sealing of the patent, or the decision rendered by the Controller in case of opposition, does not guarantee the validity of the patent, which can be challenged before the High Court on various grounds in the revocation or infringement proceedings.

In the case of [J. Mitra and Co. Pvt. Ltd. Vs. Kesar Medicaments and Another](#), , decided by this court at page 581, Para 51, it was observed that:

Although the examiner looks into various aspects and makes a rigorous examination of the patent application and opposition thereto, in view if the decisions in Biswanath Prasad Radheyshyam and Standipack Private Ltd. the ordered of the patent controller granting the patent and the decision on the opposition cannot in itself give rise to a presumption of validity of the patent notwithstanding the investigation and examination made and the same can be challenged Insofar as the decision in M/s. National Research Development Corporation of India case (supra) is concerned while the actual user and duration of the patent may be one of the factors that may be taken into account, I am of the view that that factor alone cannot give rise to a presumption of validity of the patent

28. It is well established law (refer [F. Hoffmann-La Roche Ltd. and Another Vs. Cipla Limited](#), ) that at the stage of considering an application for interlocutory injunction, the Defendant has to show that its challenge is genuine one and not vexatious or



set up to merely play for time. This Court remarked that the Defendant must put forth a substantial question of invalidity to show that the claims at issue are vulnerable. The Court must consider whether the Defendants have been able to raise a "credible" challenge to the patent. It was highlighted that the test of obviousness is that having regard to the existing state of prior art or the published material, was it possible to a normal but unimaginative person skilled in the art to discern the steps disclosed in the patent on the basis of the general common knowledge of the art at the priority date of the patent. In para 63 of the said judgment, the learned Single Bench on this aspect has held as under:

One must confess bafflement at the "six-year" rule preventing courts in India from granting interim injunction. No provision of law or rule was brought to the notice of the court in support of this practice. The six-year rule appears to have crept in Manicka Thevar, and subsequently picked up in other judgments to be developed into a universal rule. The rule can be explained as one cautioning the courts that patent infringement actions stand on a slightly different footing, (from other cases) where the courts should not automatically grant injunction on prima facie satisfaction of infringement, since patents can be challenged, even in defense. It has to be seen as a rule of caution and prudence rather than a rigid, ritualistic formula of mathematical application. In the context of the amended Act, where no less than five layers of scrutiny are inbuilt, what can be said is that the courts should examine the claim for interlocutory injunction with some degree of circumspection, even while applying all the tests that normally have to be satisfied when granting (or refusing) such relief. This view accords with the trend in the United States, where in *eBay v. MercExchange*, 547 US 388 (2006) the Supreme Court of United States rendered a significant judgment relevant in the present context. eBay was found to be infringing a patent held by MercExchange. The latter sought to enjoin eBay from using its product. Under the Federal Circuit rulings prevailing at the time, an injunction was granted automatically once infringement was discerned. Courts used to refuse it in exceptional circumstances, holding that injury could be presumed if prima facie case was established. The Supreme Court in an appeal by eBay, (against which injunction was issued), however, held that courts should consider the traditional four-factor test for issuance of an injunction, (i.e. existence of prima facie case, balance of convenience, irreparable injury and public interest) and should not issue injunctions automatically. Such an approach has been also favored by two decisions of This Court i.e. *Franz Zaver Huemer* and *Standipack Pvt. Ltd.* The Calcutta High Court too has endorsed this view, in *Godrej Soaps Ltd.*

29. The view taken by the single bench was confirmed by Division Bench of this Court in [F. Hoffmann-LA Roche Ltd. and Another Vs. Cipla Ltd.,](#) hearing an appeal against the aforesaid Order and it was clarified that if the challenge by the Defendants is on the same grounds considered and rejected by the Controller of Patents, then the burden on the Defendants to show the credibility of their challenge would be considerably of a higher degree. In para 52, it has been

observed by the Division Bench as under:

Given the scheme of Patents Act it appears to this Court that it does contemplate multiple challenges to the validity of a patent. Unlike Section 31 of the Trade Marks Act which raises a prima facie presumption of validity, Section 13(4) of the Patents Act 1970 specifically states that the investigations u/s 12 "shall not be deemed in any way to warrant the validity of any patent." Section 48 of the Act also is in the form of a negative right preventing third parties, not having the consent of the patent holder, from making, selling or importing the said product or using the patented process for FAO (O.S.) No. 188/2008 Page 34 of 57 using or offering for sell the product obtained directly by such process. It is also made subject to the other provisions of the Act. This is very different from the scheme of the Trade Marks Act as contained in Section 28 thereof. Section 3(d) itself raises several barriers to the grant of a patent particularly in the context of pharmaceutical products. It proceeds on the footing inventions are essentially for public benefit and that non-inventions should not pass off as inventions. The purpose of the legal regime in the area is to ensure that the inventions should benefit the public at large. The mere registration of the patent does not guarantee its resistance to subsequent challenges. The challenge can be in the form of a counter claim in a suit on the grounds set out in Section 64. Under Sections 92 and 92A the Central Government can step at any time by invoking the provision for compulsory licencing by way of notification. Therefore, the fact that there is a mechanism to control the monopoly of a patent holder (Section 84 and Section 92) and to control prices (by means of the drug price control order) will not protect an invalid grant of patent.

30. In *Smith vs. Grigg* Ld. 41 R.P.C. 149(1), it was observed by Atkin L.J. that:

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

Scrutton L.J. who constituted the Bench along with Atkin L.J. too observed that:

there is in patent cases a well recognized rule of practice in the Courts which deal with patent cases as to interlocutory injunctions and it is this that where the patent which you are seeking to enforce is a recent patent, an interlocutory injunction is not granted where there is a genuine case to be decided.

His Lordship further observed that:

when you find a recent monopoly which there has not yet been time to challenge sought to be enforced, the Court is inclined to take the view as a general rule, unless there are special circumstances to overcome it, that the title to the monopoly must be established before it interferes by interlocutory injunction.

31. Even under the scheme of the Act, it provides by way of Section 107 that the Defendant may raise as a defense in a suit for infringement of a patent on all the grounds on which a patent may be revoked u/s 64. In case the Legislature had intended to provide prima facie evidence of validity in the case of patents then a provision similar to Section 31 of the Trademarks Act would have been incorporated under the Patents Act, 1970.

Before the Supreme Court in [Bishwanath Prasad Radhey Shyam Vs. Hindustan Metal Industries](#), and it was contended that there was a presumption in favour of the validity of the patent but this argument was spurned by their Lordships with the observations that:

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

The Supreme Court further observed

It is important to bear in mind that in order to be patentable an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an "inventive step". To be patentable the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. The combination of old, known integers may be so combined that by their working inter-relation they produce a new process or improved result. Mere collection of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent. It is not enough, said Lord Davey in *Rickmann vs. Thierry* that the purpose is new or that there is novelty in the application, so that the article produced is that sense, new but there must be novelty in the mode of application. By that, I understand that in adopting the old contrivance to the new purpose, there must be difficulties to be overcome, requiring what is called invention, or there must be some ingenuity in the mode of making the adoption. As Cotton, L.J. put it in *Blackey vs. Lathem*, "to be new in the patent sense, the novelty must show invention". In other words, in order to be patentable, the new subject-matter must involve "invention" over what is old.

Determination of this question, which is really a crucial test, has been one of the most difficult aspects of Patent Law, and has led to considerable conflict of judicial opinion.

32. From the reading of the judgments of Bishwanath Prasad (supra) passed by Supreme Court and Hoffman (supra) of this court, it is clear that there is no presumption of the validity attached to the patent. The scheme of the Act clearly permits to raise the challenge to the patent by the defendant in an infringement proceedings filed by the plaintiff before the court. Thus, in no way the said challenge can be brushed aside by the court by attaching some kind of presumptive approach when the statute provides none. The court has to test the challenge raised by the defendants on merits in order to evaluate as to whether the defendant has raised some serious triable issue or a substantially tenable or credible challenge or not. Depending on the answer to the said enquiry rests the prima facie view on the validity of the patent and grant or non grant of the injunction.

33. Thus, Six Year rule as enumerated in various said judgments cannot be applied in general in patent matters. In earlier few cases, it was applied when the question of balance of convenience was discussed by the courts. It is actually one of the factors to be considered at the time for granting or not granting injunction or at the time striking balance between the parties. The basic law is that if the patent is found to be prima facie valid and the court finds that it has been infringed by the defendant, the case of passing the interim order is made out, even if the patent is used for a smaller period of time. But at the same time, if the patent is challenged in the written statement and by filing of counterclaim, the said period of six years does not give any benefit to the owner of patent in case court after having gone into material found that the patent is otherwise prima facie invalid. Under those circumstances, the interim order may not be passed even if the patent is six year old.

The said issue can be examined from another angle, where if the patentee has taken action for the first time after the expiry of 6 years. It does not mean that the doors of defendant to raise the defence to challenge the patent are closed, otherwise, it amounts to rejection of the defence available u/s 107 and 64 of the Act. However, it is correct that in case the patent in question has been tested in earlier cases and before the patent office in favour of the patentee, in those type of cases, the burden on the Defendant to demonstrate credibility would be of a higher degree. Thus, rule of presumption of validity after six years is not to be applied strictly in every case. It depends upon case to case basis and its merits, nature of defence raised and the evidence available on record which is produced by the defendant.

34. In view of facts in the present case, pleading and documents filed by both the parties let me now discuss the issues involved in the matter.

35. The following documents are filed by the defendants:

- ❖ V4 (without ISI approval), advertisements of V4 prior to 1999, CLI report of V4. CLI report of V4-A (Customer variation)
- ❖ V40 (Flat folded respirators with exhalation valve with Indian Approval,
- ❖ V 400 (Flat folded respirators with exhalation valve with European Approval)-European Approval for V-400
- ❖ V 44-V4 re-introduced in Indian market with ISI approval.

36. As far as Claim 1 is concerned, it is the case of the defendant no. 1 that same is clearly covered by Prior Art. Firstly, a "Flat Folded Personal Respiratory Device comprising a non-pleated flat body which is capable of being unfolded to a convex open configuration" is covered by the Defendants own product that is being manufactured and sold since 1994. Secondly, a flat folded respiratory device which can open into a cup shape device has been disclosed in US patent No. 3971369. Thirdly, as regards the Lines of Demarcation, the division of the device in three parts and the bisecting fold has already been covered by and is explained in US Patent No. 3971369 and 5701892.

37. One of the product of the defendant No. 1 Company was being manufactured since the year 1994 being model number V-4. It is argued by the defendants that the difference between the impugned product, being model number V-4410 and V-4 is that the impugned product has the Lines of demarcation and the single part nose piece is embedded within the device. It is the case of the defendants that the lines of demarcation that have been used by the Defendant in the product in question has been used as guiding or reference lines to locate the centre of the single part nose piece, which is embedded inside the mask, that will facilitate the folding of the device and thereby allowing the nose piece to be placed comfortable on the wearer's nose.

38. There is material placed on record by the defendants that they had been manufacturing and selling the impugned product at least since the year 2011. The Defendants had advertised the impugned product in the April-June 2011 edition of magazine titled "Industrial Safety Chronicle" published by the "National Safety Council" along with a free sample. At page 14 of the said magazine the advertisement of the Plaintiff No. 2 with the address Concorde Block, UB City 24, Vittal Mallaya Road, Bangalore-560001.

It is the case of the defendants that that defendant's product is similar to the prior art. Defendants relied on Gillette Defense as held in [Ravi Raj Gupta Vs. Acme Glass Mosaic Industries, :](#)

The learned counsel for the defendant has placed reliance on the law laid down in Gillette Safety Razor Co. Vs. Anglo-American Trading Co., 30 Rpc 465 which has come to be known as "Gillette defense" in patent in fringement cases. Terrell on the Law of Patents (1982 edition, at pages 170171) sums up the law of Gillette defense

vide para 6.41 as under:-

6.41 "Infringement not novel" (Gillette defense) Since no relief could be obtained in respect of an invalid patent, if the defendant could prove that the act complained of was merely what was disclosed in a publication which could be relied on against the validity of the patent, without any substantial of patentable variation having been made, he had a good defense. This is the so-called Gillette defense arising out of the world of Lord Moulton in *Gillette Safety Razor Co. VS. Anglo American Trading Co.* where he said: "I am of the opinion that in this case the defendant's right to succeed can be established without an examination of the terms of the specification of the plaintiff's letters patent. I am aware that such a mode of deciding a patent case is unusual, but from the point of view of the public it is important that this method of viewing their fights should not be overlooked. In practical life it is often the only safeguard to the manufacturer. It is impossible for an ordinary member of the public to keep watch on all the numerous patents which are taken out and to ascertain the validity and scope of their claims. But he is entitled to feel secure if he knows that that which he is doing differs from that which has been done of old only in non-patentable variations such as the substitution of mechanical equivalents or changes of material, shape or size. The defense that "the alleged infringement was not novel at the date of the plaintiff's letters patent," is a good defense in law, and it would sometimes obviate the great length and expense of patent cases if the defendant could and would put forth his case in this form, and thus spare himself the trouble of demonstration on which horn of the well-known dilemma the plaintiff had impaled himself, in validity or non-infringement.

39. The claim of the plaintiffs is that they were the first ones to come out with a "Flat Folded Personal Respiratory Device comprising a non-pleated flat body which is capable of being unfolded to a convex open configuration" is patently false and incorrect. Also, Flat folded personal respiratory devices which unfold to a convex open configuration are disclosed in US patent No. 3971369. Furthermore, the fact that Masks could also be non-pleated is already explained in US Patent No. 3971369 dated 23rd June, 1975 and that the Plaintiffs claim to distinguish the said prior art in their patent on the said factor is irrelevant and provided to confuse the Patent Office.

40. It is admitted by the plaintiff in their pleading that the lines of demarcation in the suit patent not only give an advantage, but the patented device performs joint-like function that imparts movement to the first and the third-portions relative to the second portion and imparts structural integrity to the second portion during wear on one hand and provide improved flexibility and conformance of the device during wear around the nose and the chin of the wearer on other hand, are clearly elaborated in the complete specification. The lines of demarcation in the mask of suit patent are not mere workshop improvement and have been added to serve the specific benefits.

41. The defendants submit that the defendants product has the upper portion which is not welded and the lower portion is welded thereby demonstrating that the face mask is divided into two parts alone. This has been followed by the Defendant since 1994. It is the case of the defendant that the welding in the second portion prevents collapsing of the product on the wearer's face in the Defendant's product and this functionality is not obtained by the Lines of Demarcation as claimed by the Plaintiff.

42. In order to show the prior art and obviousness of the suit patent, the defendants have filed number of documents including copies of two US patents and copy of International publication. Let me now discuss the said alleged prior art and refer the relevant part of specification of patents which are admittedly registered prior to the date of registration of the plaintiff no. 1 patent which is the subject of the suit.

43. US 3971369: The flat folded personal respiratory devices which open into a cup shaped configuration is disclosed in the US Patent US 3971369. The US Patent no. US 3971369 dated 23rd June, 1975 explains a personal respiratory protection device comprising of a main body comprising a first portion, a second portion distinguished from the first portion by a first line of demarcation, a third portion distinguished from the second portion by a second line of demarcation and a bisecting fold extending through the first portion, second portion and third portion wherein the device is capable of being folded to a first substantially flat-folded configuration along the bisection fold and is capable of being unfolded to a convex open configuration.

The abstract mentioned in the said patent specification is referred to as under:

A generally cup-shaped surgical facemask and a method for folding the body portion thereof, said body portion comprising a filtration medium, the method comprising (1) providing a blank of said filtration medium; (2) establishing a longitudinal fold line on said blank; (3) establishing first, second, and third transverse lines of demarcation on said blank, said second and third lines being on opposite sides of said first line; (4) establishing first and second points on one side edge and third and fourth points on the other side edge of the blank; (5) establishing angularly disposed fold lines which connect said points with said longitudinal fold line; (6) creasing said blank along said longitudinal fold line; and (7) moving said first and second points on one of said side edges and said third and fourth points on the other side edge to new positions lying between said second and third transverse lines of demarcation.

The scanned copy of the device in the said specification is reproduced below:

#### Summary of the invention

In accordance with the present invention there is provided an improved surgical face mask which greatly reduces the above-mentioned problems associated with prior art masks.

The improved mask of the invention comprises a body portion and means for securing the mask over the nose and mouth of the wearer. The mask also includes an elongated deformable member (referred to as a "nose clip") that conforms the upper portion of the mask, and holds it in place, over the bridge of the wearer's nose. The periphery of the mask has binding tapes which, if desired, may be extended to provide tie strings for securing the mask while being worn. Alternatively, an elastic band running from one side of the mask to the other may be provided in order to secure the mask in place.

The body portion of our new mask comprises a filtration medium for filtering bacteria and other matter from inhaled air or exhaled breath. The filtration medium may be any material, such as a woven or nonwoven fabric, a perforated film or paper, known to those skilled in the art provided it may be readily creased and folded in the manner to be hereinafter disclosed. In a preferred embodiment the body portion comprises a fibrous filtration medium both major surfaces of which are covered by a lightweight, air pervious facing material.

The body portion of our mask has an upper part and a lower part with a generally central part there between. The central part of the body portion is folded backwardly about a vertical crease or fold line which substantially divides it in half, this fold or crease line, when the mask is worn, being more or less aligned with an imaginary vertical line passing through the center of the forehead, the nose, and the center of the mouth. The upper part of the body portion extends upwardly at an angle from the upper edge of the central part so that its upper edge contracts the bridge of the nose and the cheekbone area of the face. The lower part of the body portion extends downwardly and in the direction of the throat from the lower edge of the center part so as to provide coverage underneath the chin of the wearer.

A mask in accordance with the present invention thus overlies, but does not directly contact, the lips and mouth of the wearer. Inhaled and exhaled breath is filtered and problems with abrasion and wetting are largely eliminated inasmuch as the mask does not directly contact the wearer's lips and mouth.

In accordance with another aspect of the present invention, there is disclosed a method for folding the body portion to achieve the desired cup-shaped configuration. This method broadly comprises providing a blank of the material from which it is desired to make the body portion of the mask, establishing on the blank a number of fold lines of demarcation, partially folding or creasing the blank around the fold lines so established, and securing the body portion in its thus folded, cup-like configuration.

Body portion 22 comprises an upper part 24, a lower part 26, and a generally central part 25 there between. Central part 25 is folded backwardly about a vertical crease or fold line 52 which divides it in half, this fold line, when the mask is worn, being in substantial alignment with an imaginary vertical line passing downwardly through



the centre of the wearer's forehead, his nose, and the centre of this mouth.

A method for forming the body portion of a generally cup-like facemask comprising a body portion and means for holding the mask over the nose and mouth of a wearer, said body portion comprising a filtration medium, said method comprising:

1. Providing a blank of said filtration medium, said blank having top and bottom edges and a pair of opposed side edges;
2. establishing on said blank a longitudinal fold line running from top to bottom thereof;
3. establishing a first transverse line of demarcation on said blank, said first line being substantially parallel to the top and bottom edges of said blank and extending from side to side thereof;
4. establishing a third transverse line of demarcation on said blank, said second transverse line extending from side to side of said blank, said second line being between, and generally parallel to, said first transverse line and one of said top and bottom edges of the blank;
5. establishing a third transverse line of demarcation on said blank, said third line extending from side to side blank, said third line being between, and generally parallel to, said first transverse line and the other of said top and bottom edges of the blank;
6. establishing first and second points on one of said side edges of said blank, said first point being between the point at which said second transverse line of demarcation meets said one of said side edges, and said one of said top and bottom edges, said second point being between the point at which said third transverse line of demarcation meets said one of said side edges and said other of said top and bottom edges, the distance between said second line of demarcation and said third line of demarcation.
7. establishing third and fourth points on the other of said side edges of said blank, said third point being between the point at which said second transverse line of demarcation meets said third transverse line of demarcation meets said other of said top and bottom edges, the distance between said third point and said second transverse line of demarcation, and the distance between said fourth point and said third transverse line of demarcation being not greater than the distance between said second line of demarcation and said third line of demarcation.
8. establishing four angularly disposed fold lines on said blank, one of said four fold lines connecting said first point with a fifth point on said longitudinal fold line:  
  
a second of said four fold lines connecting said fourth point with said sixth point on said longitudinal fold line, provided, however, that none of said four fold lines meets said longitudinal fold line at that portion of said longitudinal fold line lying between

said second transverse line of demarcation and said third transverse line of demarcation and said third transverse line of demarcation, and further provided that the distance between the intersection of said longitudinal fold line with said second transverse line of demarcation does not exceed about 75% of the distance between said first and second transverse lines of demarcation and the distance between the intersection of said longitudinal fold line with said third transverse line of demarcation and said sixth point does not exceed about 75 % of the distance between said first and said third transverse lines of demarcation.

9. creasing said blank along said longitudinal fold line;

10. moving said first and second points to positions on said one of said side edges lying between said second and said third transverse lines of demarcation; and

11. moving said third and fourth points to positions on said of said edges lying between said second and said third transverse lines of demarcation.

44. US 5701892: The US patent US 5701892 discloses a flat folded personal respiratory device which is opened in to a cup shaped configuration and possesses a non pleated main body for the same objective as that of the subject patent. It is submitted that this patent also possesses a bisecting fold and can be rolled up in addition to being flat folded. The abstract of the said patent is reproduced as under:

A multipurpose face mask made of supple material covers the nose, mouth, and chin with a two sided chamber held away from the entrance of the nostrils and the mouth by a rigid support attached inside the vertical front fold. This rigid support makes possible the use of a wide variety of soft materials in one or more layers, which may serve to filter dust, pollen, mold, dander, powder, and other common airborne particles, and/or to warm and humidify cold, dry air. For versatility in purpose, a disposable version may fit inside a reusable version. The cold weather version may have air holes in the outer layer. This device of supple material can be made in several sizes and rolled to fit in a pocket or purse and has an attractive, lean appearance with potential for embellishment. This invention in its many forms enhances the lives of people with respiratory disorders or professions which require respiratory protection

Scanned copy of the device which is part of the registered patent is reproduced herein below:

A multipurpose face mask for covering the nose and mouth of a wearer comprising:

a chamber having two sides connected by a top seam and bottom seam and a vertical front fold, the top seam extending cover the ridge of the nose of the wearer to beyond the tip of the nose of the wearer, the bottom seam extending from in front of the chin of the wearer towards the neck of the wearer, the vertical front fold positioned between the top seam and bottom seam; means for fastening the mask to the head of the wearer; and means for holding the vertical front fold away from a

wearer's nose and mouth, said means comprising a rigid support attached to the vertical front fold and extending substantially along its entire length.

45. US 6,394,090: The US patent US 6,394,090 had been granted on May 28, 2002 in relation to flat-folded personal respiratory protection devices and processes for preparing same. Abstract of the same reads as under:

Respiratory devices having first and second lines of demarcation bisected by a fold. The devices are capable of being folded in a first substantially flat configuration for storage (e.g., in a pocket) and are being capable of being unfolded in a second ready-to-wear configuration so that a portion of the device covering the nose and the mouth is off-the-facie. Processes for making such devices include folding a perform over a bisecting axis and cutting the perform at desired angles and sealing the cuts together to form the mask.

International publication WO 96/28217

46. The International publication WO 96/28217 which was granted in 1996, discloses a personal respiratory protection device which possess the cover layer, filter media and stiffener layer as disclosed in claims 1, 23, 25 and 38. The abstract of the same reads as under:

Fold-flat personal respiratory protection devices are provided. The devices have a flat central portion having first and second edges, a flat first member joined to the first edge of the central portion through either a fold-line, seam, weld or bond, said fold, bond, weld or seam of the first member being substantially coextensive with said first edge of said central portion, and a flat second member joined to the second edge of the central portion through either a fold-line, seam, weld or bond, the fold, bond, weld or seam of the second member being substantially coextensive with said second edge of said central portion. At least one of the central portion and first and second members are formed from filter media. The device is capable of being folded flat for storage with the first and second members being in at least partial face-to-face contact with a common surface of the central portion and, during use, is capable of forming a cup-shaped air chamber over the nose and mouth of the wearer with the unjoined edges of the central portion and first and second members adapted to contact and be secured to the nose, cheeks and chin of the wearer. The outer boundary of the unjoined edges which are adapted to contact the nose, cheeks and chin of the wearer are less than the perimeter of the device in the flat folded storage state. Also provided are processes for preparing such devices.

47. It is settled law that the matter of obviousness is to be judged by reference to the "state of the art" in the light of all that was previously known by persons versed in that art derived from experience of what was practically employed, as well as from the contents of previous writings, specifications, textbooks and other documents". There may be invention in a "combination". The question of

obviousness is seldom easy to decide. It must be decided objectively by taking into consideration all the relevant circumstances of the case."

In answering the question of obviousness there are four steps to be considered. The first is to identify the inventive step embodied in the patent in suit. Thereafter the court has to assume the mantle of a normally skilled but unimaginative addressee in the art at the priority date and to impute to him what was, at that date, common general knowledge in the art in question. The third step is to identify what, if any, differences exist between the matter cited as being "known or used" and the alleged invention. Finally the court has to ask itself whether viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention."

48. It has been held in many cases that where all the integers which formed part of an invention were part of common general knowledge, and had been used for the purpose stated in the specification, the mere combination into one container of those said devices was not such an inventive step as to constitute a valid patent." For new innovative patent there must be the exercise of intellectual activity the patented invention which had not occurred to anyone before. A slight trivial or infinitesimal variation from a pre-existing invention would not qualify as a valid invention. Meaning thereby the change introduced should be substantial and the newness may be confined to only a part of that portion. There must be a mental contention expressed.

49. A mere commercial success of the patented article is not conclusive on the question of whether the patent involves an inventive step. In *Longbottom v. Shaw*, Lord Herschell observed: "Great reliance is placed upon the fact that when this patent was taken out and frames were made in accordance with it there was a large demand for them..... My Lords, I do not dispute that that is a matter to be taken into consideration; but again, it is obvious that it cannot be regarded in any sense as conclusive. I think that its value depends very much upon certain other circumstances. If nothing be shown beyond the fact that the new arrangement results in an improvement, and that this improvement causes a demand for an apparatus made in accordance with the patent, I think it is of very little importance."

50. It is accepted as sound law that a mere placing side by side of old integers so that each performs its own proper function independently of any of the others is not a patentable combination, but that where the old integers when placed together have some working inter-relation producing a new or improved result then there is patentable subject-matter in the idea of the working inter-relation brought about by the collocation of the integers. Almost every patent is for a new combination.

In [Bishwanath Prasad Radhey Shyam Vs. Hindustan Metal Industries](#), it was observed: "In order to be patentable an improvement on something already known

before or a combination of different matters already known, should be something more than a mere workshop improvement, and must independently satisfy the test of invention of an inventive step. To be patentable the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. The combination of old, known integers may be so combined that by their working inter-relation they produce a new process or improved result. Mere collection of more than one integer or things, not involving the exercise of any inventive faculty does not qualify for the grant of patent".

51. The combined study of US Patent No. 3971369 and US Patent No. 5701591 it would be obvious to a person skilled in the art namely when the same result is to be achieved, to apply this solution with corresponding effect to the personal respiratory protection device according to US 3971369, thereby arriving at a personal protection device according to claim 1 of the suit patent. The international Publication No. 96/28217 discloses many essential features of the subject patent.

52. The US Patent No. US 3971369 and US 5701892 as well as International Application No. WO 1996/28217 also teaches many elements mentioned as claimed in the subject patent by the Plaintiff.

53. There is force in the submissions of the defendants that the Lines of Demarcation that have been used by the Defendant in the product in question has been used as guiding or reference lines to locate the centre of the single part nose piece, which is embedded inside the mask, that will facilitate the folding of the device and thereby allowing the nose piece to be placed comfortable on the wearer's nose. The said lines of Demarcation in the Defendant's product are not parallel to the top and bottom edges of the blank and are intersecting.

54. The prior art clearly teaches a multipurpose face mask made of supple material covers the nose, mouth, and chin with a two sided chamber held away from the entrance of the nostrils and the mouth by a rigid support attached inside the vertical front fold. This device of supple material can be made in several sizes and rolled to fit in a pocket or purse and has an attractive, lean appearance with potential for embellishment. A method for folding the body portion thereof, said body portion comprising a filtration medium, the method comprising (1) providing a blank of said filtration medium; (2) establishing a longitudinal fold line on said blank; (3) establishing first, second, and third transverse lines of demarcation on said blank, said second and third lines being on opposite sides of said first line; Respiratory devices having first and second lines of demarcation bisected by a fold. The devices are being capable of being unfolded in a second ready-to-wear configuration so that a portion of the device covering the nose and the mouth is off-the-facie. Processes for making such devices include folding a perform over a bisecting axis and cutting the perform at desired angles and sealing the cuts together to form the mask.

They are present in the defendants product to only provide a two point reference/guiding for the folding of the single part nose piece from the centre during the manufacturing process of the Defendants product. As per the Plaintiffs claim and product the said lines of demarcation are parallel in the body of the mask in the process of manufacturing.

55. The process as claimed under Claim 15 seem prima facie to some extent similar and is covered by Prior Art WO96/28217 as it teaches the process which is similar to subject patent and it also discloses that the device is capable of being folded flat for storage with the first and second members being in at least partial face-to-face contact with a common surface of the central portion and, during use, is capable of forming a cup-shaped air chamber over the nose and mouth of the wearer with the unjoined edges of the central portion and first and second members adapted to contact and be secured to the nose, cheeks and chin of the wearer. The outer boundary of the unjoined edges which are adapted to contact the nose, cheeks and chin of the wearer are less than the perimeter of the device in the flat folded storage state. Also provided are processes for preparing such devices.

With regard to the welding of the Lines of Demarcation, the same does not involve any inventive step, is obvious to a person skilled in the art and not does it improve the efficiency of the mask. It appears to be a trade variant.

56. Prima facie, from the material documents available on record, it is indicated that the Lines of Demarcation are already known in the Art through US Patent No. US Patent No. 3971369 dated 23rd June 1975. They can be used to divide the mask into different portions has also been explained in detail in the said patent. The shape of the mask as also the case with which it can be folded is also available in the masks of the Defendant that have been available prior to the date of application of the Plaintiff at least from the year 1997. The lines of demarcation as claimed by the Plaintiff possesses a joint like function thereby allowing movement in the first and third portion of the device and not in the central portion. Such a claim can be seen from the demonstration of the Plaintiffs own product and secondly the said fact has not been claimed by the Plaintiff in their claims.

57. PRINCIPLES GOVERNING THE GRANT OF INJUNCTION IN PATENT MATTER It is settled law that at an interim stage the Defendant need not prove actual invalidity to show that the claims at issue are vulnerable and that a substantial question of invalidity can be sufficient to defeat the grant of an interim injunction. A mere showing of a substantial question of invalidity is sufficient at this stage.

58. In Hoffman (supra), the Division bench observed that the court has to see the tenability and the credible nature of defence while deciding the grant or non-grant of injunction. If the defendant's case is found to be tenable and there are serious questions as to validity to be tried in the suit, then the interim injunction in this case may not be granted. This practice is prevalent in the patent infringement cases

where patentee always presses for injunction either interim or permanent and the defendant always attempts at the interim stage to raise a question on the validity so as to cast doubt in the mind of the court on the validity aspect and seeks refusal of interim injunction

59. Even the principles of grant of injunction in the cases relating to patent infringement are no different from that of ordinary civil cases which are normally prima facie case, balance of convenience and irreparable loss. Lord Denning M.R. in his famous speech in the case of *Hubbard and Another v. Vosper and Another* (1972) 1 All ER 1023 at 1029, had observed in considering whether to grant an interlocutory injunction, the right course for a Judge is to look at the whole case and form a holistic view of the matter. In the words of Lord Denning, it was observed thus:-

In considering whether to grant an interlocutory injunction, the right course for a judge is to look at the whole case. He must have regard not only to the strength of the claim but also to the strength of the defence, and then decide what is best to be done. Sometimes it is best to grant an injunction so as to maintain the status quo until the trial.

60. I have seen the entirety of the case in the present matter in order to form a prima facie view, I am of the view the patent which is subject matter of the present proceeding rests on few essential features which form the essence of the patent. The same is a respiratory device capable of being folded, having non pleated body and is unfolded to convex open configuration. Further, the said device contains the demarcation line which divides the said apparatus in to three portions which according to the patentee makes the invention useful. The cited prior arts by the defendants in the instant case have been able to prima facie demonstrate the existence of similar cup shape device which are used for respiratory use, the prior arts also have been filed to show the existence of the folds, non pleated body and the respiratory devices unfolded to convex. The prior art also suggest that there exists demarcation line on the devices which divides the device into three portions. The plaintiff disputes the said position by not saying that the lines do not exist in prior art but attempts to argue that the demarcation line is there in the prior arts which divide the device in three portions but for different reasons and purpose. All this would mean that there existed all the integers which form the essence of the invention in the state of the art in the prior art. In such cases, any person skilled in the art may make the workshop improvement by merely arriving at the same result with some usefulness which would make the result or the usefulness to the person obvious without applying innovative faculties.

61. In the similar situation in the case of *Bishwanath Prasad (supra)* case, the Supreme court culled out the law relating to obviousness by observing that when most of the integers are proved to be on record to be preexisting in the state of the art, then the resultant product or process is stated to be obvious unless it is shown

that there exists a novelty of the substantial degree. The mere substitution few things here and there would not make the product novel. In this context, the Supreme Court quoted the observation of the Lord Blackburn from the case decided by House of Lords titled as Harwood v. Great Northern Dy co, [1864-65] XI HLC 654. In the words of the Supreme Court, it was observed thus:

We will close the discussion of trial Court's Judgment by referring to a decision of the House of Lords in Harwood v. Great Northern Dy. Co. as, in principle, that case is analogous to the one before us. In that case, a person took out a patent, which he thus described: "My invention consists in forming a recess or groove in one or both sides of each fish (plate), so as to reduce the quantity of metal at that part, and to be adapted to receive the square heads of the bolts, which are thus prevented from turning round when the nuts are screwed on." His claim was "for constructing fishes for connecting the rails of railways, with a groove adapted for receiving the ends of the bolts employed for securing such fishes; and the application of such fishes for connecting the ends of railways in manner hereinbefore described. The constructing of fish joints for connecting the rails of railways with grooved fishes fitted to the sides of the rails, and secured to them by bolts or nuts, or rivets, and having projecting wings firmly secured to and resting upon the sleepers or bearers, so as to support the rails by their sides and upper flanges." It was proved that before the date of his patent, fish-joints had been used to connect and strengthen the rails of railways. In some cases, the fishes were flat pieces of iron, with round holes for bolts, the heads of the bolts being held in their places by separate means. In others the extreme ends of the holes were made square and the bolt-heads square, to put into them, and, in some, square recesses were made in the flat pieces of iron for the same purpose; but till the time of the patent, fishes for connecting the railways had never been made with a groove in their lateral surfaces so as to receive the square heads of the bolts, and render the fish lighter for equal strength, or stronger for an equal weight of metal.

On these facts, it was held that what was claimed as an invention was not a good ground to sustain a patent. Blackburn L.J., succinctly summed up the rule of the decision, thus:

In order to bring the subject-matter of a patent within this exception, there must be invention so applied as to produce a practical result. And we quite agree with the Court of Exchequer Chamber that a mere application of an old contrivance in the old way to an analogous subject, without any novelty or invention in the mode of applying such old contrivance to the new purpose, is not a valid subject-matter of a patent

(Emphasis supplied)

62. In this case, the plaintiff in order to dispute this position provides for the usefulness of the articles and the advantages which were not pre-existing in the



prior art. I find that prima facie, the said reasonings given by the plaintiff as inadequate as what is required to be shown that the invention is applied to produce a practical result not merely from the point of the utility but there should also exist novelty in the application of substantial degree. In such circumstances, prima facie doubts can be expressed on the novelty and inventive step involved in the suit patent. Thus, prima facie, it appears that there exist credibility attached to defence set up by the defendants as a challenge to the suit patent and doubts can be expressed on the novelty aspect and inventive step of the patent in view of the challenge raised by the defendant to the patent.

63. To sum up, therefore, as mentioned above, I am of the considered view that the plaintiffs have failed to make out a prima facie case entitling them to grant of injunction during the pendency of suit. That no prima facie case is made out by the plaintiffs. It is admitted position that the defendant no. 1 has been using the impugned device since April, 2011 and are manufacturing and supplying device to various parties in India and they have made considerable investment for the same. If an injunction order is continued then the defendants would suffer irreparable loss and injury. The balance of convenience is in favour of the defendants and against the plaintiff. As a result, the ex-parte interim order under these circumstances passed on 19th December 2013 is vacated. But, the defendants are directed to furnish correct quarterly statement of account to this Court with regard to the business in relation to the device/apparatus already manufactured by them. The said statement of account shall be furnished positively by 1st July, 2014. The subsequent statement of each quarter shall be furnished within the next succeeding month.

In order to secure the interest of the plaintiffs, the defendant No. 1 shall furnish the bank guarantee for a sum of Rs. 10 lac as security with the Registration General of this Court within six weeks. The defendant No. 1 shall also give an undertaking to pay the damages, if at the final stage and after detailed evidence, in case Court comes to the opinion upon the merits of the case to decide the issue against the defendants. The undertaking would be filed by the defendant No. 1 by 15th July, 2014.

64. The applications, being IA No. 20605/2013 (O 39 R 1 & 2 CPC) and IA No. 1276/2014 (O 39 R 4 CPC), are disposed of accordingly.

CS(OS) No. 2558/2013

List this matter before Joint Registrar for admission/denial of documents on 30th July, 2014 and before court for framing of issues of 11th August, 2011 and direction of trial and disposal of pending application I.A. No. 1842/2014 (Order 39 Rule 2A CPC).