

MANU/TN/0520/2017

Equivalent Citation: AIR2017Mad144, (2017)2MLJ571, 2017(70)PTC577(Mad)

IN THE HIGH COURT OF MADRAS

C.S. No. 373 of 2012

Decided On: 14.02.2017

Appellants: **G. Srinivasan**
Vs.

Respondent: **Voltamp Transformers Limited and Ors.**

Hon'ble Judges/Coram:

N. Sathish Kumar, J.

Counsels:

For Appellant/Petitioner/Plaintiff: Party-in-Person

For Respondents/Defendant: Arun C. Mohan and R. Prashanthi

Case Note:

Intellectual Property Right - Infringement - Injunction - Section 146(2) of Patent Act, 1970 - Suit filed for injunction restraining infringement of Plaintiff's patent - Whether Plaintiff entitled to claim infringement of his patent - Held, many companies were manufacturing same type of transformers - Complete specification made by Plaintiff also did not disclose exact product - Plaintiff has not established infringement of his patent by Defendants - Complete specification did not disclose biological material used for invention - Impugned patent was liable to be revoked - Plaintiff failed to disclose nature of herbs out of which alleged solution has been made for dipping and drying same with pure water with Dissolved Salt - Plaintiff also admitted that he has not furnished periodical statements as to extent to which patented invention has been commercially worked in India which was mandatory under Section 146(2) of Act - Failure to disclose method or instruction to use, as mandated under law, itself was a ground to revoke patent granted to Plaintiff - Therefore patent granted to Plaintiff revoked and counter claim made by Defendants allowed - Suit dismissed. [23],[24],[27],[30] and[38]

JUDGMENT

N. Sathish Kumar, J.

1. The plaintiff has filed the present suit against defendants seeking permanent injunction restraining infringement of plaintiff's Patent No. 198725 and for damages, rendition of accounts, etc.

2. The brief case of the plaintiff are as follows:

The plaintiff, who is an Engineer and has been awarded Doctorate from the International University of Contemporary Studies, Washington D.C., had innovated a novel concept of power distribution, wherein, the need of huge and costly transformer has been eliminated by his invention called "midget transformer", which is smaller in size, easier to install and maintain and also reduces power wastage. His invention also employs "star node circuit

breakers' (SNCB), which substitute the costly and conventional switchgear in control applications.

2.1. According to the plaintiff, for his aforesaid innovation, he obtained patent under No. 198725 on 24.01.2006 and the same has been duly renewed from time to time and is valid and subsisting. The plaintiff also supplied 2 Nos. of such transformers to M/s. Bharathi Infor & Power Systems, to demonstrate the same to Bangalore based CPRI and the same is also being shown to various state governments for power production and distribution. He also had discussions with the Tamil Nadu Electricity Board for possible implementation of the said project. According to the plaintiff, in the said patent for "Midget transformers" he has mentioned a particular type of transformer, which is coded as 363 digitally and Ddyn 11 in Vector Group, and the same consists of three winding transformer. His patent also referred to with different models like 363, 369, 433, 436, 463, 466 and 36t3.

2.2. When things are such, while he was visiting a site of M/s. P.V. Technologies India Limited at Sivaganga, Tamil Nadu, he found that his patent "midget transformers" were being used by the 1st defendant. In the display panels in the said site the 2nd defendant is shown as the consultants and the 3rd defendant is shown as the customer for the said project by the 1st defendant. The circuit diagram in the said site would clearly prove that the defendants are using the identical technology as that of the plaintiff's patent. Since the defendants are infringing the plaintiff's registered patent under No. 198725 by copying and using the technology as found in his 363 type of transformers, he has filed the present suit.

3. The case of the defendants, in nutshell, is as follows:

According to the defendants, the suit is not maintainable. The 1st defendant is the manufacturer of various kinds of transformers and had branches in major cities and their service centres also spread all over the country. It is the contention of the defendants that 1st defendant, on the basis of the orders placed and specifications provided by the 3rd defendant, manufactured cast resin transformer for installation at solar photovoltaic generating plant at Sivaganga and there was no infringement of the patent as alleged by the plaintiff and that the defendants were unnecessary dragged into the litigation. It is the case of the defendants that the plaintiff restored the patent only during January 2012 and he has not filed any documents to show that his patent has been worked and commercially exploited. The plaintiff has failed to substantiate his contention that he is an expert in erecting, installing, low tension and high tension transformers substations. The plaintiff has also failed to get technical analysis report comparing the plaintiff's patent specifications with the transformers manufactured and installed by 1st defendant on the orders placed by 3rd defendant. Further, the alleged circuit diagram displayed at the site of 3rd defendant at Sivaganga cannot be a basis for a patent infringement.

3.1. It is stated that though the plaintiff claims titled "Midget Transformers with Built in SNCB and their Inter Network Connections" the said SNCB is not even mentioned in claim I. The plaintiff has used vague terms which would not enable an average person skilled in the art to construct the alleged transformer. Further, 1st defendant has not used SNCB in any of their transformers including the transformers installed at the site of 3rd defendant. Further, the defendants have not dipped and dried the core in any solution and that they have not interlaced the core with amorphous core. It is further stated that though the plaintiff issued a letter during March 2011 with regard to the alleged infringement, the suit was filed only during April 2012, i.e. after a

lapse of more than one year and hence, the suit is liable to be dismissed even on the ground of limitation.

3.2. It is the specific case of the defendants that their transformers are completely different from the patent for which the plaintiff claims monopoly. The 1st defendant has been manufacturing and installing the oil filled transformers since 1967 and dry tape transformers since 1999. The invention claimed in the plaintiff's patent is not useful and is liable to be revoked. According to the defendants, the claim made by the plaintiff is baseless and is not substantiated with documentary proof. Since the plaintiff has not commercially exploited the patent and failed to set out the sale figures and advertisement figures of midget transformers manufactured by him, and that he does not have the plant and machine of manufacture of midget transformers, the plaintiff is not entitled to any damages. The plaintiff patent had lapsed and the same was restored only on 09.1.2012. Therefore, it is clear that the plaintiff had issued legal notice on the basis of the lapsed patent only. Hence, the defendants prayed for dismissal of the suit.

4. The defendants have made counter claim under Order VIII Rule 6(a) CPC read with Section 65 of the Patent Act, 1970, which reads as follows:

According to the defendants, the claim made in the complete specifications are not an invention within the meaning of the Patents Act. Though the plaintiff in his claim 1, claims interlacing Cold Rolled Grain Oriented Steel (CRGO) core with amorphous core, he had miserably failed to disclose what is the ratio or proportion of interlacing Amorphous and CRGO core, which is the basis of the plaintiff's patent. Further the Dimensions of the core are very vague. The complete specifications does not disclose the source or geographical origin of biological material i.e. KK, TS & KV used for the invention. Though the patent was applied and granted, for the past 10 years, the plaintiff has not commercially exploited the patent till date. Thus, the defendants prayed for revocation of the patent granted under No. 198725 and for cost of the counter claim.

5. On the above pleadings, originally, this Court, on 29.07.2003, has framed the following issues:

- 1.** Whether the 1st defendant is a necessary party to the suit?
- 2.** Whether the plaintiff is entitled to claim infringement of his patent under No. 198725 and whether the defendant's transformers are different from the plaintiff's claim in the patent No. 198725?
- 3.** Whether the plaintiff's patent is liable to be revoked on any of the grounds of counter claim filed by the defendant No. 1 under Section 64 of the Patents Act, 1970?
- 4.** Whether any other person/entity has manufactured or used transformers identical to the claims made by the plaintiff before the date on which the plaintiff filed the patent?
- 5.** Whether there has been any public knowledge or use of any invention identical to the claims of the plaintiff in patent No. 198725?
- 6.** Whether any of the plaintiff's patent claims are hit by US patent No. 3747999 or US patent No. 4855541?

7. Whether the transformers are manufactured by the 1st defendant is based on the specification given by the 3rd defendant?

8. Whether the defendants' claim that 3 or 4 legged core is used for centuries and whether the plaintiff's claims are hit by such public use?

9. Whether the plaintiff's claim of STAR NODE CIRCUIT BREAKERS is known or used anywhere in India or abroad prior to the plaintiff's date of application?

10. What are the essential features of the plaintiff's patent?

11. Whether the invention claimed in the plaintiff's patent is obvious to a person skilled in the art?

12. Whether the plaintiff patent is new or novel?

13. Whether the plaintiff's patent involve any inventive step?

14. Whether the claims made in the complete specification is an invention with the meaning of the Patent Act?

15. Whether the plaintiff has worked and commercially exploited the patent No. 198725?

16. Whether the suit is hit by delay and laches?

17. To what other reliefs the plaintiff is entitled to?

6. On the side of the plaintiff, he was examined as P.W. 1 and Exs. P.1 to P25 were marked and on the side of the defendants, D.W. 1 was examined and Exs. D1 to D6 were marked. The details of the documents are hereunder:

Exhibits produced on the side of the plaintiff:

| S.No. | Exhibits | Date | Description |
|-------|----------|-----------------------------------|---|
| 1. | P-1 | --- | Complete specification of patent No.198725 |
| 2. | P-2 | --- | Order of Restoration of Patent under No.198725 issued by the Patent Office |
| 3. | P-3 | ---- | Original communication received from Rashtrapathi Bhavan |
| 4. | P-4 | --- | Photo copy of the Interim report given by the Central research Institute, Bangalore |
| 5. | P-5 | 19/3/2011, 1/4/2011 and 12/6/2011 | E-mail communications from the plaintiff to the 1st defendant |
| 6. | P-6 | ----- | Original Certificate of Patent under No.198725 |
| 7. | P-7 | 18/8/2008 | Photo copy of letter from Moser Beer photo |
| 8. | P-8 | 17/2/2010 | Committee of Four Expert's report |
| 9. | P-9 | 16/2/2010 | Photo copy of letter CCG appointing plaintiff as consultant |
| 10 | P-10 | 3/5/2010 | Original Quotation M/s.Kavika Government Factor |
| 11 | P-11 | 28/4/2010 | Original Quotation of M/s.Bharathi-info Builders |
| 12 | P-12 | 26/4/2001 | Copy of Rating and Diagram plate |
| 13 | P-13 | 1/12/2010 | Original Test report on Transformers Dyny 11 |
| 14 | P-14 | 1/12/2010 | Photograph with Transformers Experts |
| 15 | P-15 | 26/6/2013 | E-mail copy of project review Meeting |
| 16 | P-16 | ---- | Website print out of Apt Samriddhi Consultant Pvt. Ltd., the second defendant |
| 17 | P-17 | ---- | E-mail from Apt Samriddhi Consultant Pvt. Ltd., the second defendant |
| 18 | P-18 | ---- | Website print out of Tamil Nadu Generation and Distribution Corporation - TANGEDCO. |
| 19 | P-19 | ---- | Website print out from M/s.Moser Beer Photo Voltaic P.,V.Industries |
| 20 | P-20 | ---- | Extracts from Website of M/s.Moser Beer Photo Voltaic |
| 21 | P-21 | ---- | Website Extract of M/s.Siemens SIP - 2004 |
| 22 | P-22 | ---- | Website extract from www.siemens.com/energy/transformers |
| 23 | P-23 | 15/5/2010 | Photograph of Name plate of Cast Resin transformer Voltamp transformer Ltd. Vadodhra (India) |
| 24 | P-24 | 18/3/2010 | Original single Line Diagram of M/s.Sapphire Industrial Infrastructure Pvt. LTd. for power flow |
| 25 | P-25 | --- | HR relevant laws |

Exhibits produced on the side of the defendants:

| S. No. | Exhibits | Date | Description of documents |
|-----------|----------|---------|---|
| 1. | D-1 | /8/2015 | Original Board Resolution passed by the 1st defendant |
| | D-2 | --- | Order copy and specifications provided by 3rd defendant to the 1st defendant for manufacturing of transformer |
| | D-3 | --- | List of Accredited and Recognised Universities published by the US department of Education along with |

| | | | |
|--|-----|---------|---|
| | | | Sec. 65(B) Certificate |
| | D-4 | --- | Test certificate of defendant's transformer |
| | D-5 | /1/1973 | US Patent No. 3747799 along with Sec. 65(B) Certificate |
| | D-6 | /8/1989 | US Patent No. 485541 along with Sec. 65(B) Certificate |

Witnesses examined on the side of the plaintiff:

P.W. 1. - G. Srinivasan

Witnesses examined on the side of the defendants

D.W. 1 - Vallbh N. Madhani

7. Heard, Dr. G. Srinivasan, party in person and Mr. Arun C. Mohan, learned counsel appearing for the defendants and perused the records.

8. According to the plaintiff, he has invented "Midget Transformers with SNCB" and obtained Patent No. 198725 on 24th September, 2003. It is the submission of the plaintiff, party-in-person, that when 1st defendant's secret document titled "RATING AND DIAGRAM PLATE" was revealed to him by his well wisher, he came to know about the infringement of his transformers by 1st defendant. He has also exhibited the same as Ex. P12. It is the further submission of the plaintiff that the infringement has been done by 1st defendant with the connivance of 2nd and 3rd defendants. According to the plaintiff, when he had worked as a consultant in a firm, viz., M/s. Century Consulting group, the defendants used to visit him and at that time, the plaintiff's transformer designs and drawings were probably lifted by 1st defendant without his knowledge. Therefore, it is submitted by the plaintiff that the statement made by 1st defendant in the written statement that the specifications, designs and drawings of the infringed transformer were provided by the 3rd defendant is totally false.

9. It is the specific submission of the plaintiff that, even after filing of the present suit, the defendants would have infringed to the tune of 4000 transformers and the same has not even been denied by D.W. 1 in the cross examination. The plaintiff submitted that the electrical giants like M/s. Siemens have vouched his patent transformer of 2003 by printing its symbol. It is specifically submitted by the plaintiff that the defendants having obtained the same Rating and Diagram Plate, in a diversionary tactics, had added with additional G.A. drawing, transformer topology but the same also turned out against them, as the transformer terminals also match with one another. The plaintiff's patent is specifically coded as 363 digitally and DyyN 11 in Vector Group. The defendants are also using an identical type of small transformers, which are identical to the plaintiff's 363 type transformers with the same vector group.

10. It is submitted by the plaintiff that his patent had been marked to Ministry of Power and other Scientific Organizations and, more particularly, the CPRI has conducted simulation studies on two of his seven type of transformers and also recommended one type of transformers to TNEB for adoption and the same is under progress. It is submitted that in spite of the categorical claim and assertion made by him, the defendants have not stopped their infringing activities. Therefore, the

plaintiff prays for permanent injunction restraining the defendants from in any manner infringing the plaintiff's Patent granted under No. 198725 by making, using, or selling an identical invention as found the plaintiff's patent for Midget Transformers with built in SNCB and their inter network connections as well as damages.

11. Countering the arguments advanced by the plaintiff, party-in-person, the learned counsel for the defendants submitted that 1st defendant is a manufacturer of various kinds of transformers from the year 1967 and had branches and service centres all over the country. Though it is submitted by the plaintiff that 1st defendant manufactured cast rein transformer on 20.08.2010 by copying and infringing his patent, he has not sought for any expert opinion to compare the same. The defendants' transformers are completely different from the patent for which the plaintiff claims monopoly. Further, on the said date, the plaintiff's patent was not valid and the same was renewed by the plaintiff only during January 2012. The learned counsel for the defendants further submitted that though the plaintiff claimed for damages, he has failed to substantiate the fact that his patent has been worked and the same was commercially exploited. It is submitted by the learned counsel for the defendants that even though the plaintiff claims that his patent is titled as "Midget Transformers with Built in SNCB and their Network connections", in the claim 1, the word SNCB is not at all mentioned.

12. The learned counsel for the defendants further submitted that though the plaintiff disclosed that his core is dipped and dried alternatively in a herbal solution, he has failed to disclose the part of herbs used for such process. It is submitted by the learned counsel for the defendants that the impugned patent is liable to be revoked, as the complete specifications does not disclose the source or geographical origin of biological material i.e. KK, TS, and KV used for plaintiff's invention. Further, the vague terms used in the specification would not enable an average skilled person in the field to construct such transformer. It is submitted by the learned counsel for the defendants that the plaintiff has obtained patent, without disclosing any inventive steps, in order to prevent the others from carrying on their legitimate business in the same field. Therefore, the learned counsel for the defendants submitted that the plaintiff's patent is unsustainable and contrary to the provisions of the Patent Act, 1980. Hence, the learned counsel for the defendants prayed for dismissal of the suit.

13. In the light of the above submissions, this Court recast the issues as follows:

- (1) Whether the plaintiff is entitled to claim infringement of his patent under No. 198725 and whether the defendants transformers are different from the plaintiff's claim in the patent No. 198725.
- (2) Whether the plaintiff failed to disclose the complete specification in the claim?
- (3) Whether the patent given to the plaintiff is liable to be revoked?
- (4) To what other relief the plaintiff is entitled to?

Issue No: 1

14. It is the contention of the plaintiff, party-in-person, that the defendants had committed infringement of his patent under No. 198725 as the defendants transformers are also similar to that of his patent. To prove the same, the plaintiff has marked 25 documents. Ex. P1 is the certified copy of the patent application with complete specifications filed by the plaintiff. On a careful perusal of Ex. P1, it is seen

that the title to the plaintiff patent is Midget Transformers with Built in SNCB and their inter networking connections. Ex. P2 is the application for restoration of patent and the same would clearly reveal the fact that in fact, patent No. 198725 was restored on the basis of the application given by the plaintiff on 17.09.2011. In fact, the plaintiff patent was originally ceased and on the basis of the application given by the plaintiff, it was restored on 06.1.2012 on condition that the plaintiff shall not be entitled to commence or prosecute any action or other proceeding, and to recover any damages, (i) in respect of making, selling, exercising using and distributing the invention in infringement of the Patent between the date of the lapsing of the Patent and the date of the advertisement of the application for restoration or (ii) in respect of selling or using at any time hereafter any article made in infringement of the Patent between the date of the lapsing of the Patent and the date of advertisement of the application for restoration.

15. Ex. P3 reveals that the plaintiff's letters dated 30.11.2002 to 02.12.2005, which were given to the then President of India during his visit to Tamil Nadu, were forwarded to the Ministry of Power, Government of India, National Research Development Corporation, New Delhi and to the Chief Secretary, <http://www.judis.nic.in> Government of Tamil Nadu for taking appropriate action. Ex. P4 is the letter dated 13.4.2007 addressed to the plaintiff by the Central Power Research Institute stating that the Institute conducted study over the plaintiff's transformer and that actual application of scheme can be ascertained only after detailed study. In the said letter, a reference was also made, directing the TNEB to fabricate 4 Nos. of 63 KVA Midget Transformers and to watch the performance. Ex. P5 is the email communications sent by the plaintiff to the 1st defendant. Ex. P6 is the patent certificate issued in the name of the plaintiff for his invention for Midget Transformers with SNCB and their inter network connections. The said patent was given only on 24.01.2006. Ex. P7 is the letter dated 18.08.2008 sent by the Moser Baer Photo Voltaic Ltd., to the Century Consulting Group to participate in the tender for Solar PV Projects through TEDA tender of 10 MW. Ex. P8 is the report of the Professors of Electrical and Electronic Engineer, IIT Madras and the Managing Director of TBI University of Madras, who satisfied the plaintiff's progress of work and recommended disbursement of Rs. 4.5 lakhs as next instalment to carry further work on the project. They also recommended extension of the project duration till September 2010 to enable him to complete the above works. Ex. P9 is the letter addressed by one Century Consulting Group to the plaintiff offering him for empanelment as Domain Experts in their company. Ex. P10 is the offer made by one Kavika, a Karnataka Government Undertaking company to the plaintiff in respect of 50/20 KVA 5500/5500/433 Star - Star/Star 3 phase copper Winding Midget Transformer.

16. Ex. P11 is the quotation for the manufacture of 50+20 KVA Midget Transformer by one Bharathi Infobuilders private Limited to the plaintiff. Ex. P12 is the drawing of the Voltamp Transformers Limited, Vadodara. Ex. P13 is the test certificate given by Bharathi Info & Power Systems Pvt. Ltd., Ex. P14 is the photograph without any negatives. Ex. P15 is the xerox copy of the email communication sent to the plaintiff by eHealth Technology Business Incubator, Bangalore. Ex. P16 is the Brochure of APT Samriddhi Consultants Pvt. Ltd., Ex. P17 is the email communication to show that two plants designed for Moserbaer were successfully completed and commissioned by the plaintiff. Ex. P18 is the print out relating to the solar energy while Ex. P19 is the xerox copy of the Moserbaer company's another office details. P.20 shows the details of the Moserbaer projects relating to the solar energy. Exs. P21 is filed to show differential protection Relay relating to transformer. P22 are the details about the transformer solutions for the harvest of solar energy. Ex. P23 is the drawing of the Voltamp Transformers Limited, Vadodara. Ex. P24 is the xerox copy of the drawing.

Ex. P25 is the IPR relevant laws.

17. Whereas it is the contention of the defendants that their transformers are different from the plaintiff's transformers and that, the alleged transformers of the plaintiff have already been ceased and, hence, question of infringement does not arise. To substantiate their contention, the defendants have marked Exs. D1 to D6. Ex. D1 is the Original Board Resolution of the 1st defendant company. Ex. D2 is said to be order copy and specification given by the 3rd defendant. Ex. D3 is the certificate showing similar products, which have been invented in various parts of the world. Similarly, Ex. D4 is the test certificate of defendants' transformers. Exs. D5 and D6 are filed to show that similar transformers have been patented in United States long back.

18. It is the specific case of the plaintiff that he has invented Midget transformers with SNCB and obtained patent under Patent No. 198725 on 24.01.2006. No doubt, Ex. P6, certificate, proves the fact that the patent has been issued in the name of the plaintiff for Midget Transformers with SNCB and their inter-network connections. Further Ex. P4 shows that the so called invention of the plaintiff has also been tested by the Central Power Research Institute. Though this document shows that the plaintiff is also an expert in the field of construction of transformers, burden of proof lies on the plaintiff in respect of the alleged infringement by the defendants. It is the definite case of the defendants that the 1st defendant, which is a company incorporated in the year 1967, is the manufacturer of various kinds of transformers based on the orders placed by various customers. It is the contention of 1st defendant that in the year 2010 itself, they manufactured Cast resin transformer for installation at solar photovoltaic generating plant at Sivaganga. It is also admitted fact that the plaintiff's patent was not valid from September 2010 till January 2012 and that the patent was restored only on 09.01.2012.

19. The plaintiff has pleaded that his particular type of transformers were copied and manufactured by the defendants and thereby infringed the plaintiff's patent. In paragraph 14 of the plaint, the plaintiff has made comparison between the features of his invention and the defendants' product to establish his case. But, the plaintiff has failed to get any expert opinion to prove the said comparison before the Court of law. From the documents filed on the side of the plaintiff, it could be seen that except two (2) transformers, which have been supplied for research aspect, the plaintiff has not regularly manufactured the transformers and commercially exploited the same. The plaintiff has relied upon only the copies of the drawings to prove the so called infringement by the defendants. Unless and until the technical expert's report is filed in that aspect, the alleged infringement cannot be taken into consideration. The plaintiff, merely on the basis of the copies of the diagrams, cannot succeed his case. That apart, a Circuit diagrams allegedly displayed on the side of the 3rd defendant cannot be a basis for patent infringement. To find out any infringement, technical report and expert opinion is necessary.

20. To be noted that though the plaintiff claim that there was an infringement by the defendants, while giving application with complete specification, in claim 1, he has not at all mentioned the word SNCB and the same is evident from Ex. P1. The claim of the plaintiff as stated in his application is as follows:

"I CLAIM

) The Midget transformer wherein the core is cold rolled grain oriented (CRGO) and treated under 'Uniform @/V process for high efficiency and interlaced with Amorphous core where the secondary

output voltages and their phase angles of all the Midget transformers in a given group tends to be the same with the least losses. The core is alternately dipped and dried in a solution of 'KK', 'TS', 'KV' that is diluted in pure water with Total Dissolved Salt (TDS) of 40 and then used for manufacture.

) The Midget transformer as claimed in claim 1) above is built with (more than 2 sets) multi sets of supply terminals on 3 or 4 legged core and referred as models '363', '369', '433', '436', '463', '466' and '36t3' where for three phase supply with absentee neutral, the 4-legged core only is employed for the unbalanced flux to pass through the fourth leg.

) The Midget transformer as claimed in claims 1) & 2) above but the one pertaining to model '36t3' has taps in its winding either at its primary or secondary to suit the site conditions' The alphabet 't' in this model number signifies that variation.

) The Midget transformer '36t3' as claimed in claims in 1) & 2) & 3) above has taps on its secondary if the in between distance from Midget to Midget of a group is in the order of kilometers.

) The Midget transformer '36t3' as claimed in claims 1) & 2) & 3) above the taps on its primary if the Midget-to-Midget distance is in the order of a few meters. 6) The Midget transformer as claimed in claims 1) & 2) above except model '36t3' that has an option is invariably with built in Star Node Circuit Breaker (SNCB). The Midget transformer's output secondary side and that neutral side terminals denoted as Ro, Yo, Bo, are terminated on the cylindrically shaped Star Node Circuit Breaker. The SNCB at its concentric center inside the chamber has a insulated rotating shaft fitted with conducting contacts arrangement and the neutral side of the breaker with three terminals shorted and fitted with three current transformers (Cts); By externally applied force the inside shaft can be rotated clockwise or anti clockwise, the circularly sweeping straight copper bars have a provision for spark-less switching facility that may or may not need solid-state device.

) The Midget transformer's Star Node Circuit Breaker as claimed in claim 1) to claim 6) above is either in open execution involving air interruption type ('A1) for 415 v applications or in closed execution involving vacuum interruption type ('VI') for 11 kv to 33 kv applications and involving SF6 interruption type ('SI') for still higher voltage.

) The Midget transformer as claimed in claim 1) to claim 7) above excepting the '363' model's twin version of two power input versus one output mode (ie) its stand alone mode for UPS purpose, shall function only as a team mate in a group that is network connected amongst them to one another either in delta primary mode of connect or in star primary mode of connection and in combination of models as shown in drawings of figures three to ten (3-10).

The aforementioned claim 1 of the plaintiff shows that the core is alternately dipped and dried in a solution of "KK", "TS", "KV" and the same is diluted in pure water with Total Dissolved Salt (TDS) of 40 and then used for manufacture. When such vague

terms used in his claim, it is very difficult for the average skilled person in the same field to construct a transformer without knowing the exact mixture solution. Therefore, unless and until the plaintiff establish the fact that claim specifications have been similar and the same have been copied and manufactured by the other side, the infringement cannot be inferred merely on the basis of the patent certificate alone. Having pleaded that the defendants have copied and manufactured the similar type of transformer, it is the duty of the plaintiff to establish before the Court as to the nature of the comparison between the two transformers.

21. It is the specific case of the defendants that they have engaged in manufacturing of transformers since 1967, that too, even before the patent was issued in the name of the plaintiff. Further, according to the defendants, the core of 1st defendant transformer is not dipped and dried in any solution as has been done in the plaintiff's core. That apart, they have not used SNCB in any of the site including the site of the 3rd defendant at Sivaganga. Therefore, without establishing the infringement, the plaintiff, merely on the basis of some photocopy of the diagram, cannot claim that there is an infringement of patent. As already stated above, he has not even sought any expert opinion to compare the two transformers to prove the alleged infringement. Without expert's opinion comparing the plaintiff's specification with the transformer manufactured and installed by the defendants, this Court, only on the basis of the oral evidence as well as some diagrams, cannot come to the conclusion that the defendants have committed infringement of the plaintiff's patent.

22. It is pertinent to note that P.W. 1, though claims to be the technical Engineer and Expert in the said field, in his cross examination, he has admitted that while obtaining the patent, he has not followed the procedure contemplated under Section 146(2) of the Patents Act. He has also admitted in his evidence that Ex. P1 does not refer to the patent No. 198725. Similarly, he has also admitted that there is no reference to the treatment of the Core with pure water with total dissolved salt (TDS) of 40 in the defendant's transformer and, the manufacture of CRGO is an industrial practice. It is also admitted by the plaintiff, in his evidence, that there is no specific reference made in the plaint that the defendant's core being made out of such CRGO core. Moreover, he has also admitted that the term Dyn11 is an industry standard term to describe winding connection designations. It is also admitted that 3 ph inputs and 3ph output are used to describe the characteristics of a transformer. UPS mode of operation is also admitted in Ex. P13. It is also admitted by the plaintiff that there is no reference to SNCB in Ex. P13. It is the admitted fact that Siemens also manufactured all the kinds of transformers.

23. From the entire evidence of P.W. 1, it could be seen that many companies are manufacturing the same type of transformers. Though the plaintiff claims that the defendants have infringed his invention, i.e. Midget transformers, to prove the alleged infringement by the defendant, he did not sought for any technical expert opinion to find out the comparison. Complete specification made by the plaintiff also does not disclose the exact product used for Dipping and drying up the core. Unless and until the complete disclosure is made by the plaintiff in his claim, he cannot plead that such claim is infringed by the defendants merely on the basis of the certificate. The plaintiff cannot succeed in patent case, particularly, when such transformers are available even before the patent obtained by the plaintiff. Further, he has not established the fact that his patent is commercially exploited. It is not in dispute that the plaintiff's patent was renewed only in the year 2010 and that there was a specific clause in the application to the effect that the plaintiff is debarred from making any action for damages and for infringement etc. during the lapse period. Moreover, failure to disclose the complete specification in the claim itself shows that the defendants could not have copied the alleged design of the plaintiff. Therefore,

from the evidence of P.W. 1 and the documents adduced on his side, this Court hold that the plaintiff has not established the alleged infringement of his patent by the defendants. The issue No. 1 is answered accordingly.

Issue Nos. 2 to 4:

24. One of the main contention raised by the defendants is that the various claims made in the complete specifications are not an invention within the meaning of the Patent Act and the alleged invention was publicly known and publicly used all over the world including India. Similarly, specifications also does not sufficiently and fairly describe the invention and method by which it is to be performed. Claim 1 of the plaintiff does not disclose what is the ratio or proportionate or having CRGO core which is the basis for the plaintiff's patent. The plaintiff in his claim 2, mentioned that the midget transformer is built with multi - sets of terminals on 3 or 4 legged core. The use of terminals on 3 to 4 legged core is a known prior art which is being used for centuries in the transformer and as such, there is novelty in the same. Similarly, the use of Circuit breaker in transformers is also prevalent in the industry much prior to the impugned patent. Likewise, the complete specification does not disclose the biological material i.e. KK, TS, & KV used for the invention and hence, the impugned patent is liable to be revoked. As already discussed in issue No. 1, the plaintiff has not commercially exploited the patent till date, event though the patent was obtained by him.

25. In these circumstances, it is useful to refer Section 10 of the Patents Act, which reads as follows:

"10 Contents of specifications. (1). Every specification, whether provisional or complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates.

(2) Subject to any rules that may be made in this behalf under this Act, drawings may, and shall, if the Controller so requires, be supplied for the purposes of any specification, whether complete or provisional; and any drawings so supplied shall, unless the Controller otherwise directs be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.

(3) If, in any particular case, the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished [before the application is found in order for grant of a patent], but such model or sample shall not be deemed to form part of the specification.

(4) Every complete specification shall-

(a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;

(b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and

(c) end with a claim or claims defining the scope of the invention for which protection is claimed;

[(d) be accompanied by an abstract to provide technical information on the invention:

Provided that-

(i) the Controller may amend the abstract for providing better information to third parties; and

(ii) if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b), and if such material is not available to the public, the application shall be completed by depositing 42 [the material to an international depository authority under the Budapest Treaty] and by fulfilling the following conditions, namely:-

[(A) the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;]

(B) all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository institution and the date and number of the deposit of the material at the institution;

(C) access to the material is available in the depository institution only after the date of the application of patent in India or if a priority is claimed after the date of the priority;

(D) disclose the source and geographical origin of the biological material in the specification, when used in an invention.]

[(4A) In case of an international application designating India, the title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of this Act.]

[(5) The claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.]

(6) A declaration as to the inventorship of the invention shall, in such cases as may be prescribed, be furnished in the prescribed form with the complete specification or within such period as may be prescribed after the filing of that specification.

(7) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification may include claims in respect of developments of, or additions to, the invention which was described in the

provisional specification, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent."

26. On a reading of the above section, it is clear that the complete specification is the essential document while filing the patent application. The complete specification shall fully describe the invention and its operation or use and the method. The specification must be written in such a manner that the person of average skilled in the relevant field should understand the invention. Without disclosing the manner in which the transformer is to be used, one cannot say that he has also complied with the complete specification as prescribed under the Act. Similarly, as far as Patent Law is concerned, such properly drafted claim is important part of complete specification. The complete specification must have made at least one claim. The claim-1 is the main claim. Supplementary claim with reference to the main claim includes disclaimer, correction or explanation and no amendment thereof shall be allowed except for the purpose of incorporation of actual facts. The claim is a statement of technical facts expressed in legal terms denying the scope of the invention sought to be directed. When the plaintiff's claim is carefully perused, in Ex. P1 Claim 1, it is seen that he has made 8 claims. The main claim is the first claim, which reads as follows:

"1. The Midget transformer wherein the core is cold rolled grain oriented (CRGO) and treated under 'Uniform @/V process for high efficiency and interlaced with Amorphous core where the secondary output voltages and their phase angles of all the Midget transformers in a given group tends to be the same with the lease losses. The core is alternately dipped and dried in a solution of 'KK', 'TS', 'KV' that is diluted in pure water with Total Dissolved Salt (TDS) of 40 and then used for manufacture."

27. In the first claim, though, it is mentioned that core is alternatively dipped and dried in a solution of KK, TS, KV and that is diluted in pure water with Total Dissolved Salt (TDS) of 40 and then used for manufacture, the materials used for making solution have not been properly disclosed in the claim. Even in the cross examination, the plaintiff did not disclose the nature of herbs used for making such solution and whether those herbs are available for exploitation. All these facts have not even been disclosed in the claim. In fact, such a disclosure is mandatory for complete specification. Section 10 of the Patent Act mandates the complete disclosure as to the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection. Furthermore, as per Section 10 of the Patent Act, all the available characteristics of the materials required for it to be correctly identified or indicated are included in the specification including the name. But the plaintiff has not disclosed the above said complete specification in his claim. Even in his evidence, as already stated above, the plaintiff failed to disclose the nature of herbs, out of which, the alleged solution has been made for dipping and drying the same with pure water with Dissolved Salt.

28. It is significant to point out that use of transformers are not new in India and other parts of the country. The plaintiff, who is claiming to be the inventor of the Midget transformer, has to come out with definite case that he has invented the specific transformer other than the transformers, which were publicly known in India and other parts of the World. To claim the same as a new invention, it should be established by the plaintiff that it has not been exploited publicly or used in the country or elsewhere in the world before the date of filing of the patent application with complete specification. Furthermore, mere arrangement or re-arrangement or

duplication of known devices each functioning independently of one another in a known way cannot be termed as a new invention.

29. The plaintiff's so called transformer as per his introduction in Ex. P1 shows that if many small conductors are put in parallel in the place of one and current carried instead, then the conduction ratio improves, saving in area of conductor. The entire Ex. P1 clearly shows that already available devices have been re-arranged. It is a known fact that the arrangement of the devices itself will not amount to new invention. Even assuming that the same is a new invention of the plaintiff, it is the duty of the plaintiff to disclose about the use of the transformer and its complete specification in his claim. Whereas in the plaintiff's claim, he has totally failed to disclose the nature of herbs used and the mode of preparation of making the so called solution from the herbs etc., As per Section 64(h) of the Patent Act, when the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection, the impugned patent is liable to be revoked.

30. The defendants have also filed Exs. D1 to D6 to show that the transformers were worked and used in many parts of the world and patented by the US Government. When similar transformer was already publicly used in other parts of the Country, the plaintiff cannot claim any monopoly over the said transformer. Similarly, in the application, since the plaintiff had failed to disclose the information prescribed under Section 8, and had furnished false information, his patent is liable to be revoked, as per Section 64(m). The case underlined the fact that Section 8, though held to be a procedural formality, could solely be a ground for revocation under Section 64 of the Patent Act. It points out requirement of Section 8 are continuous obligation and should be done on a periodic basis. Similarly, the plaintiff, in his evidence, also admitted that he has not furnished periodical statements as to the extent to which the patented invention has been commercially worked in India, which is mandatory under Section 146(2) of the Act.

31. The defendants had assailed patent granted to the plaintiff on the ground that there was no complete specification and that, there was no disclosure about the nature of herbs used for making the alleged solution. According to the defendants, as per Section 64 of the Patent Act, they are entitled to counter claim assailing the patent granted in favour of plaintiff, in a suit for infringement.

32. Admittedly, the claim of the plaintiff does not describe the invention and the method by which it is to be performed. The description of the method or instructions for working of the invention, as contained in the complete specification, are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which invention relates. In the absence of particulars about the use of specific herbs mentioned in the claim 1, viz., KK, TS, and KV, the plaintiff is not entitled for patent. Furthermore, the plaintiff, in his evidence, has not even disclosed about the nature of herbs used for making solution. The above failure on the part of the plaintiff, certainly, disentitle him to continue the same patent. Further, there is no evidence to show that by use of such patent certificate, the plaintiff has commercially exploited the said patent. The alleged transformers, which are either big or small, are easily available across the India and World. The plaintiff, who has come forward with the suit, without exploiting the

patent, and having failed to disclose the manner, in which it has to be worked out, certainly, not entitled to retain the patent.

33. As already discussed above, the alleged patent has already been registered across the world. Further, as discussed in issue No. 1, there was no expert assistance sought for by the plaintiff to compare the features between the two transformers i.e. Plaintiff transformers and the defendants transformers. In this context, it is useful to extract the complete specification of the plaintiff as well as Voltamp make transformer specifications used in PV Techno-logies Ltd., which reads as follows:

Complete specification of the plaintiff:

| S.No. | Claim of the plaintiff as per the complete specification |
|-------|---|
| 1 | The Midget transformer wherein the core is CRGO and treated under Uniform @/V process for high efficiency and interlaced with amorphous core The core is alternatively dipped and dried in a solution of "KK", "TS", "KV" that is diluted in pure water with TDS of 40 and then used for manufacture. |
| 2 | The midget transformer as claimed in claim 1) and 2) above -----has an option invariably with BUILT IN STAR NODE CIRCUIT BREAKER (SNCB) ---- |
| 3 | "The Entire core of all Midgets of ALL models undergo the above described special treatment process called 'uniform @/v' that ensures equal induced secondary voltages of same phase angels" |
| 4 | "To separate the two secondary outputs, equalizer windings are added to the midgets as shown in Fig (5). Its conclusion is one Vital parta of this invention" |
| 5 | One of the main points of the patented method is the segmentation of the primary of conventional big transformer into 2 or more HV windings of the 'midgets'. |

Complete specification of the Voltamp make transformer specifications used in PV Techno-logies Ltd:

| S.No. | Voltamp make transformer Specifications - used in PV Techno-logies Ltd. |
|-------|--|
| 1 | Voltamp Transformer Ltd. (herein after called VTL) does not even interlace the core with amorphous core. The core is NOT dipped and dried in any Solution |
| 2 | VTL does not use and has never used any SNCB in any of their transformers |
| 3 | VTL has never acquired the knowledge of the said treatment, nor applied that on any core |
| 4 | VTL has NOT used any equalizer winding on the transformer |
| 5 | VTL has NOT used such segmentation of HV winding on the transformer |

34. From the above, it is clear that, without examining the two transformers by an

expert, merely on the basis of some drawings, which are said to be the drawings of the plaintiff, this Court is not in a position to come to the conclusion that there was an infringement. Similarly, the plaintiff, in the plaint has clearly indicated that he came to know about the alleged use of his invention by the defendants in the year 2011. But he has filed the suit only in the year 2012. This itself clearly indicate that the plaintiff is unnecessarily dragged the defendants into the litigation.

35. It is also one of the main contention of the defendants that the plaintiff has not come to the Court with clean hands. According to the defendants, the plaintiff's patent is not valid from 24.09.2010 till January 2012. Ex. P2 clearly shows that at the time of renewal of the application, there was a barrier for the plaintiff to claim any infringement, which occurred during the lapsed period. But the defendant manufactured Cast resin transformer on 20.08.2010. Therefore, at the relevant time, i.e. on 20.08.2010, the plaintiff's patent certificate was not in subsistence, since the same was lapsed.

36. In any event, the non disclosure of the method of use and non-disclosure of complete specification are also one of the ground to revoke the patent under Section 64(h) of the Patent Act. Apart from that, the plaintiff has failed to establish that his transformer is commercially exploited. That apart, except two transformers, which are allegedly sent by the plaintiff for research, he has not established that his invention has been commercially exploited from the very inception. Since, he failed to establish that his transformer is commercially exploited and the defendants have infringed his patent, damages, as sought for by the plaintiff, cannot be granted.

37. In view of the fact that similar transformers have already been in use and that the plaintiff has also failed to disclose the complete source of use and furnishing complete specification in his claim, he is not entitled to retain the patent. It is needless to point out that the unused patent would result in economic crisis also. Mere obtaining patent, without commercially exploiting the same, itself will not be a ground to prevent others from doing the same business. If such scenario is allowed by this Court, it would lead to serious consequences and also affect the development of the economy and new inventions.

38. Be that as it may, the failure to disclose the method or instruction to use, as mandated under law, itself is a ground to revoke the patent granted to the plaintiff. Therefore, the patent granted to the plaintiff is revoked and the counter claim made by the defendants is allowed. Accordingly, these issues are answered.

39. In the result, the suit is dismissed by allowing the counter claim made by the defendants. However, there shall be no order as to costs.

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