IN THE HIGH COURT OF ALLAHABAD

Judgment dated: 3 May, 1974

CORAM

THE HONOURABLE MR. JUSTICE G.C. MATHUR

THE HONOURABLE MR. JUSTICE J.M.L. SINHA

Special Appeal No. 754 of 1970

Shining Industries ... Appellants

Versus

Shri Krishan Industries ... Respondent

JUDGMENT

J.M.L. Sinha, J.

1. This appeal arises out of the judgment and decree dated 27th August, 1970 passed by a learned Single Judge in a suit under Section 29 of the Indian Patents and Designs Act.

2. The suit out of which the appeal has arisen was filed by Messrs. Shri Krishna Industries, a registered partnership firm (hereafter to be called the respondent), doing business in the manufacture of locks. The respondent's case, briefly stated, was as follows:--

3. In the year 1958 the respondent invented ,a new design of lock and got it registered under the Patents & Designs Act, 1911. The lock was sold under the trade mark of 'Rocket'. In 1965 a new type of lock was invented with improved key operated padlock; and on 1st of May, 1965 the respondent applied for and obtained Patent No. 99371 for the new lock as well. The newly invented lock became popular and earned a good place for itself in the market. The appellant No. 1 is also a registered partnership firm dealing in the manufacture of locks

and the appellant No. 2 is one of the partners thereof. It is alleged that the appellants started manufacturing locks by counterfeiting and imitating the lock invented by the respondent. Since the appellants persisted in imitating the respondent's lock despite their protest, they had to file the suit which has given rise to this appeal. The reliefs claimed by the respondent were permanent injunction restraining the appellants and their partners etc. from manufacturing, selling or otherwise dealing in the locks similar to the design, shape and mechanism of the respondent's lock; of delivery of all finished and unfinished locks of that design in the possession of the appellants for the purposes of destruction; and of a decree for Rupees 1,000 as token compensation for the loss suffered by them.

4. The suit was resisted by the appellants. It was admitted by them that they were manufacturing the lock marked "Narain Lock". They, however, pleaded that the respondent firm was not the first and true inventor of the lock of which it had obtained patent, nor was it the legal representative nor an assign of the first inventor. According to the appellants, the mechanism of the locks manufactured by the respondent was commonly used by other manufacturers as well and that the appellants were manufacturing their locks since much before the respondent obtained the patent. It was also pleaded by the appellants that the mechanism of the lock could not be got patented by the respondent because it was neither an invention nor did it involve any improvement. A number of other pleas were also raised by the appellants, but in view of the contentions raised before us, it is not necessary to refer to them. It may, however, be added that the appellants in their written statement also put in a counter-claim for the revocation of the patent.

5. On the pleadings of the parties as many as 14 issues were framed. Leaving out the issues that were not pressed before the learned Single Judge, they were as follows:--

> 2. Whether the plaintiff had a patent right on the improved key operated padlock, as provided under the Indian Patents and Designs Act, 1911 by Patent No. 99371?

3. Whether the improved key operated padlock designed and mechanised by the plaintiff, the subject-matter of Patent No. 99371, is an invention?

4. Whether the defendant has infringed and counterfeited the above patent right of the plaintiff?

5. Whether the device and mechanism of manufacturing of this padlock was invented by Raghunath Das Kapur? If so, its effect?

6. Whether such types of locks were being manufactured by Raghunath Das Kapur, defendant and others from before 5th May, 1965, and if so, its effect?

7. Whether the plaintiff secured the patent of mechanism of the alleged padlock by misrepresentation and mis-statement of fact?

8. Whether the design and mechanism of the padlocks and locks manufactured by the defendant is different from the design and mechanism of the locks and padlocks manufactured by the plaintiff?

12. Is the plaintiff entitled to bring this suit?

13. Whether the plaintiff has suffered any damages? If so, to what damages is the plaintiff entitled?

14. To what relief is the plaintiff entitled?

6. Issues Nos. 2 to 8 and 12 were answered by the learned Single Judge in favour of the respondent and issue No. 13 was answered against the respondent, in the result, the learned Single Judge decreed the respondent's suit for permanent injunction and for delivery of finished and unfinished locks of the design, shape and mechanism similar to the appellants' lock for destruction. The relief of a decree for Rs. 1,000, claimed by the respondent as token compensation for the loss suffered, was refused.

7. Learned counsel for the appellants in his argument before us raised the following points:-- (I) That for claiming patent of an invention it was not sufficient for the respondent to plead that it was in possession of an invention. It should further have been pleaded and proved that the respondent was either a legal representative or assign of the true and first inventor.

(II) That patent rights are property and the firm cannot acquire or hold property. Patent could therefore be granted only in the name of the partners and not in the name of the firm.

(III) That the mechanism used in the lock manufactured by the respondent was not an invention within the meaning of that expression as defined in the Patents and Designs Act, 1911.

8. We shall take each of the above points seriatim.

9. Elaborating his argument on point No. 1, learned counsel invited our attention to Sub-section (3) of Section 3 of the Patents and Designs Act, hereafter to be called the Act. It reads as follows:--

> "The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof, he or, in the case of a joint application, one at least of the applicants, claims to be the true and first inventor or the legal representative or assign of such Inventor and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification and the prescribed fee."

It was pointed out that Bodhraj Anand (P.W. 3) deposed that he was the inventor. It was urged that the respondent firm could not be the legal representative of Bodhraj Anand, in view of the definition of that expression contained in Sub-section (9) of Section 2 of the Act, and consequently the invention should have been assigned to the respondent firm before it could apply and obtain the patent. According to learned counsel, neither such an assignment was pleaded by the respondent nor has it been proved.

10. We have given our careful thought to the contention raised, but we do not find much substance in it. An invention is not a property right unless it has been patented. The assignment of invention can, therefore, be made even by word of mouth. Consequently, if it was stated in the application moved on behalf of the respondent firm, of which Bodhraj Anand was a partner, that the invention was assigned to the respondent firm, it was a valid assignment within the meaning of

Sub-section (3) of Section 3. A photostat copy of the patent was filed along with the plaint and another copy was filed later. It is explicitly stated therein that Raghubir Lal Anand and Bodhraj Anand were the partners of the firm, that they had declared that they were in possession of an invention for improved key operated padlock and that they were the assigns of the true and first inventor. The fact that there is a mention of the assignment in the patent indicates that while making the application an assignment was made by Bodhraj Anand in favour of the firm which constituted of himself and Raghubir Lal Anand as partners. There is a prescribed proforma (Form 1-A) for making application for obtaining patent. There is a specific column in that proforma for mentioning that the applicant is the assign or legal representative of the true and first inventor. Bodhraj Anand during his examination in the trial court stated that he was the inventor of the mechanism of the locks in question, but the application to the Controller of the Patents was made in the name of the firm and not in his name. He further on stated that he had told the attorney who drafted his application that the invention was made by him, that he and Raghubir Lal Anand were the two partners of the firm and that the invention of the mechanism should be patented in the name of Shri Krishna Industries. In view of the fact that a column for mentioning that fact existed in the proforma of the application, the aforesaid statement made by Bodhraj Anand appears to be correct.

11. Therefore the oral statement made by Bodhraj Anand, together with the recital of the fact of assignment in the patent, in our opinion, is sufficient proof of the fact that Bodhraj Anand assigned the invention in favour of the partnership.

12. Some stress was laid by learned counsel for the appellants on the fact that there is no mention in the plaint regarding assignment, and that the respondent also did not file any copy of the application made before the Controller of Patents, in order to prove that assignment had actually been made by Bodhraj Anand in favour of the firm. It is true that there is no clear pleading regarding assignment in the plaint. The fact, however, remains that Bodhraj was cross-

examined on that point. The omission of the fact of assignment from the plaint is, therefore, immaterial. The omission on the part of the respondent to file copy of the application moved before the Controller of Patents is also in our opinion of no consequence, in view of the fact that no specific issue in that connection was framed. It is quite likely that since no issue was framed the respondent believed at the time of adducing documentary evidence that the application will not be relevant under any of the issues and may therefore not be admitted.

13. Point No. 1 is therefore decided against the appellant.

14. Coming to the second contention raised by learned counsel for the appellants, it was urged that patent rights are property and the firm cannot acquire or hold property. According to learned counsel, patent could therefore be granted only in the names of partners in the firm but not in the name of the firm.

15. On a perusal of the record, we find that no specific plea to the above effect was raised in the court below nor any issue on that point was framed. It was for the first time in appeal before us that this point was sought to be canvassed on behalf of the appellants. Since this point was not raised earlier, it should not be open to the appellants to agitate it now in appeal. That apart, we do not find much substance in that contention as well. Learned counsel for the appellants failed to cite before us any decision or authority lending support to the contention that patent cannot be granted to a firm. On the contrary, from the cases cited on other points it is apparent that patents have been granted in favour of firms. All that was argued was that under the law of partnership a firm has no legal existence apart from its partners, and it is merely a compendious name to describe its partners. Accepting that proposition, it would only mean that the property, which in the instant case is the patent right, shall be deemed to belong to the two partners of the firm, namely Raghubir Lal Anand and Bodhraj Anand. In view, however, of Section 14 of the Partnership Act, the partners will be deemed to hold it for the business of the partnership. In the case of Narayanappa

v. Bhaskara Krishnappa, AIR 1966 SC 1300 the position of the partners vis-a-vis the firm was considered and it was observed :--

> "Section 14 provides that subject to the contract between the partners the property of the first includes all property originally brought into the stock of the firm, or acquired by the firm for the purposes and in the course of the business of the firm. Section 15 provides that such property shall ordinarily be held and used by the partners exclusively for the purposes of the business of the firm. Though that is so, a firm has no legal existence under the Act and the partnership property will, therefore, be deemed to be held by the partners for the business of the partnership."

Further on it was observed:--

> "No doubt, since a firm has no legal existence, the partnership property will vest in all the partners and in that sense every partner has an interest in the property of the partnership During the subsistence of the partnership, however, no partner can deal with any portion of the property as his own. Nor can he assign his interest in a specific item of partnership property to anyone."

16. Therefore, even accepting that the patent granted to the respondent firm did not vest Patent rights in the respondent, it must be held that the rights vested in the two partners and they held those rights for the purposes of the business of the firm. During the subsistence of the partnership none of the two partners could treat and deal with patent right as his individual property. The contention raised by learned counsel for the appellants is hence of no consequence.

17. Point No. 2 is also therefore answered against the appellants.

18. This takes us to the third and the main point involved in the case, namely whether the mechanism used by the respondent in their lock got patented in 1965 is an invention within the meaning of that expression, as defined in the Act.

19. The definition of the term "invention" is contained in Sub-section (8) of Section 2 of the Act, which reads as follows:--

> " 'invention' means any manner of new manufacture and includes an improvement and an alleged invention."

20. Direct cases of the courts in India on the point as to what is an invention are few. In order, therefore, to understand 'what is an invention' help can be taker from other sources.

21. In Hotchkiss v. Greenwood, (1851) 13 L Ed 683 at p. 691, col. 1 it was observed while considering the patent granted regarding the manufacture of a particular type of knob:--

> "It seems to be supposed on the argument that this mode of fastening the shank to the clay knob produced a new and peculiar effect upon the article, beyond that produced when applied to the metallic knob, inasmuch as the fused metal by which the shank was fastened to the knob prevented the shank from acting immediately upon the knob, it being inclosed and firmly held by the metal; that for this reason the clay or porcelain knob was not so liable to crack or be broken, but was made firm and strong, and more durable.
>
> This is doubtless true. But the peculiar effect thus referred to is not distinguishable from that which would exist in the case of wood knob, or one of bone or ivory or of other materials that might be mentioned.
>
> Now if the foregoing view of the improvement claimed in this patent be correct, it is quite apparent that there was no error in the submission of the question presented at the trial to the jury; for unless more ingenuity and skill in applying the old method of fastening the shank and the knob were required in the application of it to the clay or porcelain than were possessed by an ordinary mechanic acquainted with the designs, there was an absence of that degree of skill and ingenuity which constitutes essential elements of every invention. In other words, the improvement is the work of the skillful mechanic, not that of the inventor."

The view expressed above was followed in the case of Cuno Engineering Corporation v. Automatic Devices Corporation, (1941) 36 L Ed 58 at pp. 62 and 63 and it was further observed therein :

> "That is to say, the new device however useful it may be must reveal the flash of creative genius, not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain....."

It was further observed in the abovementioned case:--

"A new application of old device may not be patentable if the result claimed as new is the same in character as the original result, even though the new result had not before been contemplated."

22. In the case of Rado v. John Tye & Sons Ltd., 1967 RPC 297 at p. 305 it was observed:--

"The material question to be considered in a case like this is whether the alleged discovery lies so much out of the track of what was known before as not naturally to suggest itself to a person thinking on the subject; it must not be the obvious or natural suggestion of what was obviously known."

23. In case Great Atlantic & Pacific Tea Co. v. Super-market Equipment Corporation, (1950) 95 L Ed 162 on pp. 166 and 167 the Supreme Court of the United States expressed itself on the point thus :

"Courts should scrutinise combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of patent is to add to the sum of useful knowledge. Patents cannot be sustained, when on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skilful men. This patentee has added nothing to the total stock of knowledge but has merely brought together segments of prior art and claims them in congregation as a monopoly."

24. In Corpus Juris Secundum Vol. 29, p. 268 (para 54) the point has been summed up like this:--

"Not every improvement is invention. While superior utility is a circumstance to be considered in determining the question of invention (as discussed) the attainment of comparative superiority or greater excellence in that which is already known does not of itself amount to invention. There must be something more than a mere carrying forward or more extended application of a known principle or an original idea of another, a better doing of that which has already been done, the attainment of a more perfect result by the same methods, or the correction of a more or less obvious defect or fault, such as might be expected of a skilled mechanic in the particular art. As frequently stated, perfection of

workmanship, however much it may increase the convenience, extend the use, diminish expense, is not patentable. An advance step which would occur to one skilled in the art when investigating is not invention.....

An improvement of old device or method is not patentable merely because it permits a product to be produced more cheaply, or because it produces something which is more merchantable, or more compact or more efficient, or more attractive in appearance. While a greater degree of control may be an improvement, such a change, in the absence of a performance of a new function, generally is not regarded as invention."

25. It will be futile to multiply the cases. The question whether the mechanism used by the respondent in the instant case was or was not an invention should be considered keeping in view the abovementioned principles.

26. The respondent examined four witnesses in support of their case. Out of them, Jamuna Prasad (P.W. 1) is a purely formal witness and Ghazanfar Ali Khan (P.W. 4) only claimed to have done electroplating work on the locks prepared by the respondent. He has not said anything substantial about the mechanism of the lock. The other two witnesses are Banarsi Das (P.W. 2) and Bodhraj (P.W. 3). The latter was partner in the respondent firm and it may therefore be pertinent to first refer to his testimony.

27. It is the common case of the parties that the locks which were manufactured by the respondent firm till before 1965 had been invented by one Raghunath Das Kapur; Bodhraj (P.W. 3) claimed that the lock invented by him is an improvement on the old lock. One lock of each of the two types was produced in Court. The former lock is Exh. 1 and the later lock is Exh. 2. The comparative picture of the two locks given by Bodhraj Anand can more conveniently be described as below:--

Locks manufactured by the respondent till before 1965 (Exh. I)	**Locks manufactured by the respondent after obtaining the patent in 1965 (Exh. II)**
(a) Shackle opened on one end only	(a) Shackle opens on both ends.
(b) There used to be one groove on that end of the shackle which used to open.	(b) There are three grooves on each end of the shackle.

(c) There used to be one moving lever.	(c) Contains two moving levers which fit in two of the grooves on both ends of the shackle.
(d) Contained an inner housing (patti) which stopped the lever from two sides.	(d) Contains an inner housing which stops the lever from all the four sides.
	(e) Even if the shackle is cut in the middle the lock cannot be removed without being opened with the key.

28. Bodhraj P.W. 3 also stated that there were complaints about the working of the lock manufactured till before 1965 and that the new invention removed those defects. He, however, did not give details of the complaints nor the manner in which those complaints were removed.

29. Banarsi Das (P.W. 2) is, on his own admission, a nephew of Bodhraj Anand and worked for the respondent firm. In his deposition he gave a comparative picture of the locks manufactured by the respondent till before 1965 and thereafter he also tried to make a statement about the defects with which the old locks suffered. The comparative picture given by Banarsi Das of the two locks can be described thus:--

Locks manufactured by the respondent till before 1965.	**Locks manufactured by the respondent after obtaining the patent in 1965.**
(a) The shackle could be opened from one end. It was fixed on one side and could be opened from the other side.	(a) The shackle opens on both sides and both arms of the shackle can come out of the lock.
(b) Part of the arm of the shackle which remains fixed to the lock used to be thinner than the other.	(b) Both the arms of the lock are of the same thickness.
(c) There used to be one groove, and in that arm of the shackle which came out of the lock.	(c) There are three grooves on both arms of the shackle.

30. Making a statement about the defects, he stated that the shackle of the locks manufactured till before 1965 were not very durable and could be easily opened; that the arms of the shackles could break if the lock fell down and that the former lock could be opened by a combination of 7 or 8 keys, while the present lock will require a combination of 70 to 100 keys to open it.

31. So far as Banarsi pas (P.W. 2) is concerned, he is not an independent witness and also does not appear to be wholly reliable. As already stated, he is nephew of

Bodhraj Anand. Though he stated that he did not work for the respondent firm and that he maintained a challan-book in which he noted down the job work undertaken by him, he could neither produce the challan-book nor the bill book in proof of the fact that he had really done any work like preparation of shackles for the respondent firm. Since, however, the comparative picture of the two locks as given fay Banarsi Das is not very different from the comparative picture given by Bodhraj Anand, his statement in that regard can be accepted. That point, however, is whether the changes made in the later lock (Exh. II) vis-a-vis the previous lock (Exh. I) will amount to any invention.

32. Bodhraj Anand himself admitted in cross-examination that locks manufactured by Raghunath Das had key operated levers as in the lock (Exh. II). He also admitted that coil springs were used in the old lock (Exh. I) and are also being used in the new lock (Exh. II). He said that there were defects in the placement of the springs in the locks manufactured by Raghunath Das, which have now been removed. He also admitted that in the lock manufactured by Raghunath Das as well as in the lock invented by him levers move out to lock the shackle, but since there was only one groove in the former lock, one lever alone got into that groove. The lock (Exh. II), claimed to have been invented by Bodhraj Anand, carries three slots on each end. According to Bodhraj Anand, two of the slots on other side get locked, and it would therefore follow that four of the moving levers get into those slots. Bodhraj Anand also admitted that the system used in the earlier lock continues to exist in the lock manufactured by him. Banarsi Das (P. W. 2) admitted that the shackle of the new lock was prepared with the help of the same dye with which the shackle of the old lock was manufactured.

33. In view of the above statement made by Bodhraj Anand and Banarsi Das P.Ws., it is difficult to accept that the lock claimed to have been invented by Bodhraj Anand contains any novelty. The mere fact that the shackle of the old lock contained one groove and the shackle of new lock contains three grooves, or that in the old lock one arm of the shackle remained attached to the lock with

a pin on opening it, while in the new lock both the arms of the shackle come out, or that the old lock contained an inner housing only on two sides, while the new lock contains an inner housing on all the four sides does not bring about any new change in the lock. The system remains the same. It may not be out of place to add that Bodhraj Anand (P.W. 2) did not amplify in his statement as to what were the substantial defects in the working of the old lock and how and in what manner did he remove those defects in the present lock. So far as the statement of Banarsi Das (P.W. 2) regarding the defects is concerned, as already stated earlier, he is not an independent and reliable witness. That apart, on the basis of the defects stated by him it cannot be held that the improvement made in the lock manufactured by Bodhraj Anand amounts to an invention. He only said that the shackle of the old lock could break if it fell down. He did not state having ever seen the shackle breaking as a result of the lock falling down. He further stated that the previous lock could be opened with a combination of 7 or 8 keys, but the lock invented by Bodhraj Anand would require a combination of 70 or 80 keys to open it. That obviously was so because of the increase in the grooves and this difference in the working of the two locks cannot amount to an improvement which may constitute an 'invention'.

34. In order to show that the system used in the lock claimed to have been invented by Bodhraj Anand is not a new invention, the appellants filed patents of some other firms. One of them is Patent No. 2080 dated 30th March, 1915 granted in favour of Jagannath Prasad, Proprietor, Special Metal Works Factory, Aligarh, and the second is Patent No. 3938 dated 21st October, 1918 granted in favour of Raghubir Prasad and Bedram. The specification contained in the former patent of 1915 and diagrams contained therein show that the working of the lock for which that patent was granted was similar to the working of the lock claimed to have been invented by Bodhraj Anand. That lock too had an inner casing and a shackle with two legs. The shackle could be pulled out, though one of the legs thereof remained attached to the lock with a screw. The shackle used in that lock also had three slots on each side, as in the instant case. The inner

casing of that lock as well contained two holes through which two legs of the shackle passed downwards. In the patent of the year 1918, the diagram shows that the shackle in that case could also be pulled out, though one arm of it remained attached to the lock with a pin. There were two slots in that lock on both arms of the shackle which got engaged on the key being moved.

35. It will, therefore, appear that the mechanism used by Bodhraj Anand in the lock claimed to have been invented by him was known from before and that he adopted the same mechanism with slight changes and no appreciably different results.

36. Bodhraj Anand (P.W. 3) also stated that one result of the mechanism used in the lock (Exh. II) is that even if the shackle is cut it cannot be taken out without the assistance of the key. The shackle of the lock of the nature of Exh. I was also cut in Court to demonstrate that fact before us and we could see that, on the shackle being cut in a locked state, the two parts did not move appreciably. This characteristic will however be present in every lock in which both arms of the shackle have grooves which get engaged with the moving of the key. As already stated earlier the locks specified in the patent of 1915, 1918 have grooves on both the arms of the shackle and they get engaged with the moving of the key. Therefore, if the shackles of those locks be cut from the top, the two pieces thereof may also not move. It is worthy of notice that in the specifications mentioned in the patent obtained for the lock (Exh. II) it was not mentioned that one of the characteristics thereof was that even if the shackle was cut on the top, the shackle will not turn and the lock cannot be removed. Presumably, this was not mentioned because there was nothing new in it.

37. Therefore the mere fact that if the shackle of the lock (Exh. II) is cut from the top, the two pieces thereof shall not turn appreciably, was by no means an improvement falling within the definition of 'invention'.

38. In fact the appellants also produced oral evidence in order to prove that the lock in question is not a new invention. With the same end in view the appellants

also produced in the case a number of locks alleged to have been manufactured by other firms which carried mechanism of the same nature as in lock Exh. II. The learned Single Judge has, however, not considered that evidence to be worthy of reliance and he has given cogent reasons for the same. We also, therefore, do not propose to take that evidence into consideration.

39. In view of all that has been said earlier, our conclusion on point No. 3 is that the mechanism of the lock (Exh. II) was not a new invention on the date its patent was applied for and that neither the respondent nor Bodhraj Anand was the first and true inventor thereof.

40. In view of the conclusion reached by us on point No. 3, this appeal should succeed and the suit filed by the respondent should fail.

41. The question that next falls for consideration is whether the counterclaim made by the appellants for the revocation of the patent granted in favour of the respondent should succeed. The appellants' case in that connection is that the mechanism of the lock (Exh. II) was not a new invention on the date on which the application for obtaining patent was moved and that the respondent is not the true and first inventor thereof and, consequently, the patent is liable to be revoked under Clauses (b) and (c) of Subsection (1) of Section 26 of the Act.

42. In reply to the above the learned counsel for the respondent has invited our attention to Sub-section (2) of Section 26 and has urged that a person cannot move for revocation of patent on any of the grounds specified in Sub-section (1) of Section 26 without being authorised in that behalf by the Advocate-General. Learned counsel further urged that since the appellants had obtained no authority from the Advocate-General the counter-claim of the appellants should not succeed.

43. An answer to the above question should in our opinion rest on the interpretation of Sections 26 and 27 of the Act.

44. According to Sub-section (1) of Section 26, revocation of a patent in whole or in part may be obtained on petition to or on a counter-claim in a suit for infringement before a High Court on all or any of the grounds specified in Clauses (a)-(n) of that sub-section. Section 26, Sub-section (2) reads as follows :

> "A petition for revocation of a patent may be presented- (a) by the Advocate-General or any person authorised by him; or (b) by any person alleging (i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or (ii) that he, or any person under or through whom he claims, was the true and first inventor of any invention included in the claim of the patentee; or (iii) that he, or any person under or through whom he claims an interest in any trade, business or manufacture, had publicly manufactured, used or sold, within India, before the date of the patent, anything claimed by the patentee as his invention."

45. Section 29, under which suits for infringement of patents fall, reads as follows:--

> "29 (1) A patentee may institute a suit in a District Court having jurisdiction to try the suit against any person who, during the continuance of a patent acquired by him under this Act in respect of an invention, makes, sells or uses the invention without his licence, or counterfeits it, or imitates it :
>
> Provided that where a counter-claim for revocation of the patent is made by the defendant, the suit, along with the counter-claim, shall be transferred to the High Court for decision.
>
> (2) Every ground on which a patent may be revoked under Section 26 shall be available by way of defence to a suit for infringement."

46. It is apparent on a perusal of the two provisions that if a person files an application for revocation of a patent, he will have to confine himself to the grounds stated in Sub-section (2) (b) of Section 26 but if he appears as a defendant in a suit for infringement of patent, each of the grounds mentioned under Section 26 shall be available to him by way of defence to the suit. It is further significant to find that in Sub-section (1) of Section 26 it has been stated that patent can be revoked on any of the grounds mentioned therein on a petition as well as a counter-claim but Sub-section (2) of Section 26 only makes a

mention of 'petition for revocation' and not 'counter-claim', if it were the intention of the Legislature that neither a petition nor a counter-claim for revocation of patent be made by any person without the consent of the Advocate-General, except on the ground stated in Sub-section (2) (b) of Section 26, they would not have inserted the word "counter-claim" in Sub-section (1) and would not have omitted to mention that ward in Sub-section (2).

47. We, therefore, feel inclined to accept that if a person files an independent petition for revocation of patent without obtaining the sanction from the Advocate-General, he will have to confine himself to the three grounds mentioned in Clause (b) of Sub-section (2) of Section 26. But if a suit for infringement of patent has already been filed and the Court becomes seized of the matter, 3 counter-claim can be made for revocation on the grounds specified in Sub-section (1) of Section 26 without the intervention of the Advocate-General. Normally limitations of the nature contained in Sub-section (2) of Section 26 are imposed so that, before the case is put in Court, it may be examined by some outside agency to find whether it contains any substance, and to withhold permission for its institution in Court if it has no substance, so that the time of the Court may not be wasted in unnecessary and frivolous litigation. But once the Court is already seized of the matter, there can be no point in the matter being examined by any other agency outside the Court. This fortifies the interpretation that we seek to put on Section 26 read with Section 29 of the Act. We accordingly hold that a counter-claim for revocation of patent can be made on any of the grounds specified in Sub-section (1) of Section 26 of the Act without the intervention of the Advocate-General.

48. We have already recorded a finding earlier that the mechanism of the lock (Exh. II) was not a new invention on the date its patent was obtained and that the respondent is not the first and true inventor thereof. Clauses (b) and (c) of Sub-section (1) of Section 26 are clearly attracted on this finding and the counter-claim should therefore succeed.

49. In the result, this appeal is allowed, the judgment and decree passed by the learned Single Judge are set aside and the suit filed by the respondent is dismissed. The counter-claim made by the appellants for revocation of Patent No. 99371 dated 5th of May, 1965 granted in favour of the respondent is allowed and the patent is revoked. The appellants shall get their costs of both the courts from the respondent.