IN THE SUPREME COURT OF INDIA

CIVIL APPELLATE JURISDICTION

CIVIL APPEAL NOS. 1630-1631 OF 1969

Bishwanath Prasad Radhey Shyam ... Appellant

Versus

Hindustan Metal Industries ... Respondents

Decided on: December 13, 1978

CORAM

R.S. SARKARIA, J.

V.D. TULZAPURKAR, J.

A.P. SEN, J.

MR. K.B. Asthana, and Mr. M.V. Goswami, Advocates for the Appellant.

Mr. S.K. Mehta and Mr. P.N. Puri, Advocates for the Respondent.

JUDGMENT

R.S. Sarkaria, J.

1. These two appeals on certificate arise out of a common judgment and decree, dated January 18, 1966, of a Division Bench of the High Court of Allahabad. The facts material to these appeals may be set out as under:

2. M/s Hindustan Metal Industries, respondent herein, (hereinafter called the plaintiff) is a registered partnership firm carrying on the business of manufacturing brass and German silver utensils at Mirzapur. M/s Bishwanath Prasad Radhey Shyam appellant herein, (hereinafter called the defendant) is a concern carrying on the business of manufacturing dishes and utensils in Mirzapur.

3. On August 8, 1953, the plaintiffs instituted a suit for injunction and damages, preceded by a notice, served on the defendant on September 9, 1952, in the Court of the District Judge, Allahabad, within whose jurisdiction Mirzapur is situated, with these allegations.

4. The old method of manufacturing utensils, particularly shallow dishes, was to turn scrap and polish them on some sort of headstock without a tailstock, the utensils either being fixed to the headstock by thermoplastic cement or held in the jaws of a chuck fixed to the headstock. This system was, however, fraught with risk to the workers inasmuch as the utensils used to fly off from the headstock. Consequently, with a view to introduce improvement, convenience, speed, safety and better finish, Purshottam Dass, one of the partners of the plaintiffs-firm, invented a device and method for the manufacture of utensils, in 1951. The plaintiff after filing the necessary specifications and claims in the Patent Office, got the alleged invention patented under the Indian Patents and Designs Act, 1911 (hereinafter called the Act), at No. 46368-51 on May 6, 1953 with effect from December 13, 1951 as assignee of the said patent. By virtue of this patent, the plaintiff acquired the sole and exclusive right of using this method and means for the manufacture of utensils. In September, 1952, the plaintiff learnt that the defendant was using and employing the device and method of manufacturing dishes under the former's patent. The plaintiff served a notice upon the defendant asking him to desist from infringing the plaintiff's patent, but the defendant continued to infringe the patent.

5. On the preceding facts, the plaintiff prayed for a permanent injunction restraining the defendant from adopting, imitating, employing or in any manner infringing the device of the plaintiff's patent. The plaintiff further prayed for a mandatory injunction requiring the defendant to destroy the articles used for the infringement of its patent. The plaintiff further claimed a decree for Rs. 3000 as damages.

6. The defendant resisted the suit on various grounds, out of which those which are material for the decision of these appeals are : that the defendant's firm is an old concern carrying on the manufacture of metal wares since long; that the method covered by the plaintiff's patent, namely, that of a lathe (headstock, adapter and tailstock) has been known and openly and commonly in use in the commercial world all over the country for several decades before the plaintiff's patent; that the alleged invention of the plaintiff was not on the date of the patent, a manner of new manufacture or improvement, nor did it involve any inventive step or ingenuity having regard to what was known or used prior to the date of the patent; and that the patent has no utility and therefore it was liable to be revoked.

7. The defendant also filed a counter-claim, praying for revocation of the patent on the same grounds which he had set out in the written statement.

8. On October 13, 1953, the defendant along with three other business concerns, filed a petition under Section 26 of the Act for revocation of the patent that had been granted to M/s Hindustan Metal Industries, Mirzapur on the same grounds which were raised in his counter-claim in the suit for injunction and damages.

9. The plaintiff's suit along with the counter-claim of the defendant, was transferred to the High Court under Section 29 (Proviso) of the Act. Both the suits were consolidated and tried together by a learned Single Judge (V.G. Oak, J.). Issues were framed and evidence were led by the parties. The findings, material for our purpose, of the learned trial Judge, are :

(i) The patent does not involve any inventive step having regard to what was known or used prior to the patent.

(ii) The work of turning or scraping utensils of various designs has been going on at Mirzapur and other places for many years before 1951. The changes introduced by the patentee in Ex. CC are of a minor nature. The alleged

invention was not on the date of the patent, a manner of new manufacture or improvement. It did not involve any novelty.

(iii) The defendant had publicly manufactured goods before the date of the patent, substantially according to the method claimed by the patentee as its invention.

(iv) The alleged invention has got utility.

(v) The patent obtained by the plaintiff was liable to be revoked and the plaintiff was not entitled to any damages.

10. In the result, the learned Judge dismissed the plaintiff's suit (No. 3 of 1955), but allowed the petition for revocation (in Suit No. 2 of 1954) with costs; and revoked the Patent (No. 46368-51) that had been issued to the plaintiff.

11. Aggrieved, the plaintiff preferred two Special Appeals to a Division Bench of the High Court. The Appellate Bench held as under :

(1) That, formerly, plates and dishes were attached to an adapter on the headstock by means of an adhesive-like lac or shellac and, in turning the plates or dishes, they used to fly off, causing injuries to the workmen.

(2) That on account of the risk involved in the process, the work of manufacturing plates and dishes was suspended for about 5 or 6 years at Mirzapur.

(3) That, in 1951, the plaintiff invented the method of mounting which has been patented.

(4) That, immediately after this, the work of manufacturing plates and dishes restarted at Mirzapur and was carried on with success.

(5) That lathes have been well-known for a long time and they consist essentially of a headstock and a tailstock which are used for holding the article to be worked upon.

(6) That the known uses, to which a tailstock has been put, were centering the article, holding along work by a pointed tailstock by pivoting it and holding an article in metal spinning by the pressure of a pad attached to the tailstock.

(7) That the method of holding an article by the pressure of a point of a pointed tailstock was neither used nor known.

12. On these findings, the Appellate Bench concluded :

> In our opinion, the method of mounting patented by the appellant did involve and an inventive step and was a manner of new manufacture and improvement.

In the result, it allowed the appeals, set aside the judgment and decree of the learned trial Judge and decreed the plaintiff's suit with costs.

13. Hence, these appeals.

14. Mr. Asthana, learned Counsel for the appellant, has canvassed these points :

(i) The method and means claimed by the respondent in Patent No. 46368-51 did not involve any inventive step or novelty.

(ii) The Appellate Bench of the High Court was in error in holding that the supporting of an article in a lathe by the pressure of the point of a pointed tailstock constituted the novelty of the invention, inasmuch as it overlooked the fact that the scope of the patented invention in the "claims" in the complete specification does not contain an assertion of novelty for the pointed tailstock, but rather it specifically says that "the pressure spindle may be pointed or blunt".

(iii) The Division Bench of the High Court having held that a tailstock was used for holding the article to be worked upon and that if a pointed tailstock was used always for a very long time prior to the patent for holding an article in metal spinning by pressure, contradicted itself in concluding that holding an article by the pressure of a pointed tailstock was neither used nor known. The High Court thus made out a new case for the plaintiff, which had not been alleged either in the specifications in the subject of the patent or in the pleading.

(iv) The alleged inventor, Purshottam Dass, though he attended the Court on some dates of hearing, did not dare to appear in the witness-box, nor was he called as a witness in the case by the plaintiff to explain in what way, if at all, the method and means patented by the plaintiff, was a novelty or involved an inventive step. The failure to examine Purshottam Dass, who was a partner of the plaintiff-firm, would give rise to an inference adverse to the plaintiff.

15. As against this, Mr. Mehta, appearing for the respondent, submits that whether the process got patented by the respondent involves a method of new manufacture or improvement, is one purely of fact, and should not, as a matter of practice, be disturbed by this Court. Even in cases of doubt--proceeds the argument--the Court should uphold the patent. It is submitted that a patent is granted by the Controller after due inquiry and publication and, unless the contrary is proved, should be presumed to have been duly granted. In the instant case, it is urged, that presumption is stronger because the trial Judge as well as the Appellate Bench of the High Court have concurrently held that the process patented had utility.

16. Before dealing with these contentions, let us have a general idea of the object, the relevant provisions and the scheme of the Act.

17. The subject of Patent Law is to encourage scientific research, new technology and industrial progress. Grant of exclusive privilege to own, use or sell the method or the product patented for a limited period, stimulates new inventions of commercial utility. The price of the grant of the monopoly is the disclosure of the invention at the Patent Office which, after the expiry of the fixed period of the monopoly, passes into the public domain.

18. The fundamental principle of Patent Law is that a patent is granted only for an invention which must be new and useful. That is to say, it must have novelty and utility. It is essential for the validity of a patent that it must be the inventor's own discovery as opposed to mere verification of what was already known before the date of the patent.

19. "Invention, means any manner of new manufacture and includes an improvement and an allied invention". [Section 2(8) of 1911 Act.] It is to be noted that unlike the Patents Act, 1970, the Act of 1911 does not specify the requirement of being useful in the definition of `invention'. But Courts have always taken the view that a patentable invention, apart from being a new manufacture, must also be useful. The foundation for this judicial interpretation is to be found in the fact that Section 26(1) (f) of the 1911 Act recognises lack of utility as one of the grounds on which a patent can be revoked.

20. `Manufacture' according to the definition of the term in Section 2 (11) of the Act, includes not only "any art, process or manner of providing, preparing or making an article" but also "any article prepared or produced by the manufacture".

21. 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 v. Thierry, (1896) 14 Pat Ca 105 `that the purpose is new or that there is novelty in the application, so that the article produced is in 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 v. Lathem, (1888) 6 Pat Ca 184 "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 in reality is a crucial test, has been one of the most difficult aspects of Patent Law, and has Ied to considerable conflict of judicial opinion.

22. This aspect of the law relating to patentable inventions, as prevailing in Britain, has been neatly summed up in Encyclopaedia Britannica, Vol. 17 Page 453. Since in India, also, the law on the subject is substantially the same, it will be profitable to extract the same hereunder :

> A patent can be granted only for `manner of new manufacture' and although an invention may be `new' and relate to a `manner of manufacture' it is not necessarily a `manner of new manufacture'--it may be only a normal development of an existing manufacture. It is a necessary qualification of a craftsman that he should have the knowledge and ability to vary his methods to meet the task before him--a tailor must cut his cloth to suit the fashion of the day--and any monopoly that would interfere with the craftsman's use of his skill and knowledge would be intolerable.
>
> A patentable invention, therefore, must involve something which is outside the probable capacity of a craftsman--which is expressed by saying it must have `subject-matter' or involve an `inventive step'. `Novelty' and `subject-matter' are obviously closely allied.....
>
> Although these issues must be pleaded separately, both are invariably raised by a defendant, and in fact, `subject-matter' is the crucial test, for which there may well be novelty not involving an `inventive step', it is hard to conceive how there can be an `inventive step' without novelty.

23. Whether an alleged invention involves novelty and an `inventive step', is a mixed question of law and fact, depending largely on the circumstances of the case. Although no absolute that is uniformly applicable in all circumstances can be devised, certain broad criteria can be indicated. Whether the "manner of manufacture" patented, was publicly known, used and practised in the country before or at the date of the patent? If the answer to this question `Yes', it will negative novelty or `subject-matter'. Prior public knowledge of the alleged invention which would disqualify the grant of a patent can be by word of mouth or by publication through books or other media. "If the public once becomes

possessed of an invention", says Hindmarch on Patents(Quoted with approval by Fry, LJ. in Humpherson V. Syer, 4 RPC 407) "by any means whatsoever, no subsequent patent for it can be granted either to the true or first inventor himself or any other person; for the public cannot be deprived of the right to use the invention....the public already possessing everything that he could give".

24. The expression "does not involve any inventive step" used in Section 26 (1) (e) of the Act and its equivalent word "obvious", have acquired special significant in the terminology of patent law. The `obviousness' has to be strictly and objectively judged. For this determination several forms of the question have been suggested. The one suggested by Salmond, L. J. in Radio v. John Two & Son Ltd., (1967) RPC 297 is apposite. It 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 previously known."

25. Another test of whether a document is a publication which would negative existence of novelty or an "inventive step" is suggested, as under :

> Had the document been placed in the hands of a competent draftsman (or engineer as distinguished from a mere artisan), endowed with the common general knowledge at the `priority date', who was faced with the problem solved by the patentee but without knowledge of the patented invention, would he have said, "this gives me what I want ?" (Encyclopaedia Britannica; ibid). To put it in another form : "Was it for practical purposes obvious to a skilled worker, in the field concerned, in the state of knowledge existing at the date of the patent to be found in the literature then available to him, that he would or should make the invention the subject of the claim concerned ?" (Halsbury, 3rd Edn., Vol. 29, p. 42 referred to by Vimadalal, J. of Bombay High Court in Farbwerke Hoechst & B. Corporation v. Unichem Laboratories., AIR 1969 Bom 255.

26. With the aforesaid prefactory survey, we now turn to the 1911 Act. The Act provides various checks to prevent an invalid patent being granted which does not involve any inventive step or a manner of new manufacture or improvement.

The procedure for obtaining an exclusive privilege under this Act (before the Amending Act 39 of 1970), may be described as below.

27. The true and first inventor or his legal representative or assignee submits an application in the prescribed form and manner to the Patent Office. The application must contain a declaration to the effect that the applicant is in possession of an invention, for which he desires to obtain a patent. Such an application must be accompanied, inter alia, by either a provisional or complete specification. A provisional specification must prescribe the nature of the invention. A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed. A specification whether provisional or complete, must commence with the title, and in case of a complete specification must end with a distinct statement of the invention claimed (Section 4).

28. The Controller then considers that application and may require the applicant to supply suitable drawings and such drawings shall be deemed to from part of the complete specification. If a complete specification is not left with the application, the application may leave it at any subsequent time within 9 months from the date of the application. The application is then examined by the Controller of Patents for the patentability of the invention. The Controller then makes a thorough search among his records for novelty. The Controller is bound to refer to an Examiner an application, in respect of which a complete specification has been filed. The Examiner then, after careful and elaborate examination, submits his report to the controller, inter alia, as to whether or not-

> (a) the nature or the invention or the manner in which it is to be performed is particularly described and ascertained in the complete specification ;
>
> (b) the application, specification and drawings have been prepared in the prescribed manner;
>
> (c) the title of the specification sufficiently indicates the subject-matter of the invention;

(d) the statement of claim sufficiently defines the invention;

(dd) the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification ;

(e) the invention as described and claimed is prima facie a manner of new manufacture or improvement ;

(f) the specification relates to more than one invention ;

(g)------ (h)-------

29. If, on perusing the report, the Controller is not satisfied with regard to any of the matters enumerated in clauses (a) to (h) of Section 5(1), he may refuse to accept the application or require that the application, specification or drawings be amended before he proceeds with the application. If the Controller is satisfied with regard to these matters and accepts the application, he shall give notice thereof to the applicant and shall advertise the acceptance; and the application and specifications with the drawings, if any, shall be open to public inspection (Section 6).

30. Within four months from the date of the advertisement of the acceptance of an application, any person may give notice at the Patent Office of opposition to the grant of the patent on any of the grounds mentioned in clauses (a) to (e) of sub-section (1) of Section 9, and on no other ground.

31. After hearing the applicant and the opponent, if desirous of being heard, the Controller renders his decision, which is appealable to the Central Government. If there is no opposition, or if the determination is in favour of the grant of the patent, the patent shall be granted and sealed subject to such conditions as the Central Government thinks it expedient.

32. 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 a presumption in favour of the validity of the patent, cannot be accepted.

33. The term limited in every patent, for the duration thereof, save as otherwise expressly provided by this Act, is 16 years from its date (Section 14). The term can be extended if a petition is made to the Central Government in accordance with Section 15.

34. Section 29(1) of the Act entitles a patentee to institute a suit against any person who, during the continuance of the plaintiff's patent, infringes it. Sub-section (2) of the section provides that every ground on which a patent may be revoked under Section 26 shall be available by way of defence to a suit for infringement. The material part of Section 26 reads as under:

> (1) Revocation of a patent in whole or in part may be obtained on petition to or on a counter-claim in a suit or infringement before a High Court on all or any of the following grounds, namely:
>
> (a) that the invention has been the subject of a valid prior grant of a patent in India;
>
> (b) that the true and first inventor or his legal representative or assign was not of the applicant or one of the applicants for the patent;
>
> (c) that the patent was obtained in fraud of the rights of the person applying for the revocation or of any person under or through whom he claims;
>
> (d) that the invention was not, at the date of the patent, a manner of new manufacture or improvement;
>
> (e) that the invention does not involve any inventive step, having regard to what was known or used prior to the date of the patent;
>
> (f) that the invention is of no utility;
>
> (g) that the complete specification does not sufficiently and fairly describe and ascertain the nature of the invention and the manner in which the invention is to be performed;

(h) that the complete specification does not sufficiently and clearly ascertain the scope of the invention claimed;

(i) that the patent was obtained on a false suggestion or representation.

(j) to (n).....

35. the ground is now clear for dealing with the problem in hand.

36. Although the defendant had both in his defence and in the counter-claim for revocation of the patent pleaded six grounds mentioned in clauses (d), (e), (f), (g), (i) and (b) of Sec. 26(1), yet, in this appeal before us the controversy has narrowed down into two issues: (i) whether the patent was not at the date of the patent, a manner of new manufacture or improvement; (ii) whether the invention does not involve any inventive step, having regard to what was known or used prior to the date of patent?

37. At the trial, M/s Bishwanath Prasad Radhey Shyam had examined 9 witnesses to show that the method of manufacture described in the patent has been publicly known and in use at Mirzapur and elsewhere long before 1951. On the other hand, the patentee firm, M/s Hindustan Metal Industries, examined 4 witnesses to prove that the work of scraping and polishing of utensils formerly done at Mirzapur, was on crude machines and that the machines (Ex. CC) developed by the patentee is a distinct improvement over the machines of the old type.

38. The learned trial Judge, after a careful appraisal of the evidence produced by the parties, found that the following facts have been established:

I. The manufacture of utensils is an old industry at Mirzapur and at other places in U.P. and in other parts of India;

II. lathe is a well-known mechanism used for spinning and a number of other processes;

III. adaptors were in use for holding turnably articles of suitable sizes, for holding plates and dishes, also, were in use before 1951;

IV. the tailstock was probably used in this industry before 1951;

V. no bracket or angle, as used in the defendant's machine (Ex. CC) appears to have been used in this industry before 1951;

VI. work on plates and dishes were suspended at Mirzapur for a few years before 1951.

39. The trial Judge then found that mere addition of a bracket did not amount to a novelty. He further observed that circumstance VI was of a neutral character because it could not be definitely held that the work had been suspended due to a defect in the contrivance which was then in use. It might well be due to labour trouble as the witnesses examined by the appellant had deposed. From Circumstances I, II, III and IV, inspection of the machines (Ex. CC and Ex. XVI), produced by the appellant and the other material on record, the trial Court found both the issues, set out above, against the patentee-firm.

40. We have ourselves examined the evidence on record with the aid of the learned Counsel for the parties, and have ourselves compared the machine (Ex. CC and Ex. XVI) which were produced before us. We do not want to rehash the evidence. Suffice it to say, we do not find that any piece of evidence has been misread, overlooked or omitted from consideration. The view taken by the trial Court was quite reasonable and entitled to due weight. In our opinion, it did not suffer from any infirmity or serious flaw which would have warranted interference by the Appellate Bench.

41. Be that as it may, from the discussion that follows, the conclusion is inescapable that the invention got patented by M/s. Hindustan Metal Industries, respondent herein, was neither a manner of new manufacture nor a distinctive improvement on the old contrivance, involving any novelty or inventive step having regard to what was already known and practised in the country for a long time before 1951.

42. Let us now have a look at the invention described in the specifications and the 'claims' in the patent in question. In the provisional specification, the title or subject of the patent is described as follows :

> Method of and means for mounting metallic utensils or the like on lathe for turning them before polishing.

The title of the patent mentioned in the complete specification is as under:

> Means for holding utensils for turning purposes.

Then follows a description of the old method of manufacture, and it is stated:

> This invention relates to means for mounting metallic utensils for the purpose of turning the same before polishing and deals particularly, though not exclusively, with utensils of the type which cannot be conveniently and directly gripped by the jaws of the chucks and where the utensil tends to slip off the chuck and a certain amount of risk is involved in applying the tool in the turning operation.

Thereafter, the new method of manufacture is described with reference to three figures of sketches. The crucial part of this specification runs as below:

> According to a preferred feature of this invention the pressure end of the pressure spindle is rotatably mounted and for this purpose it comprises an independent piece engaged by a hollowed end in a spindle, said hollowed end being preferably fitted with ball bearings to enable the said independent piece to revolve with friction when it is in contactual relationship with the utensil. This independent piece may have a forward pointed end or said forward end may be a blunt end, the pointed end or the blunt end as the case may be, being firmly held against the utensil. The blunt end may, e. g. be of 1 cm. in diameter.

That at the foot of the complete specification, 9 claims are set out, which read as under :

> 1. Means for mounting and holding metal utensils more particularly of the shallow type for the purpose of turning before polishing comprising a shaft or spindle carrying at its one end an adapter having a face corresponding to the shape of the article or utensil to be held, the utensil being maintained in held position by an independent pressure on the utensil when seated on the adapter.
>
> 2. Means for the purpose herein set forth and as claimed in claim 1 in which the pressure spindle is adapted to pass through a guide block and has a regulating

handle at the outer end, the inner end of the spindle pressing against the utensil, means being provided to set and lock the pressure spindle in any desired position.

3. Means as claimed in Claims 1 and 2 in which the pressure end of the pressure spindle is rotatably mounted and for this purpose it comprises an independent piece engaged by a hollowed end in a spindle, said hollowed end being preferably fitted with ball bearings to enable the said independent piece to revolve with friction when it is in contactual relationship with the utensil.

4. Means as claimed in previous claims in which the pressing or inner end of the pressure spindle is pointed or blunt.

5. Means as claimed in claim 1 in which the pressure spindle passes through a bracket or the like and said bracket may comprise the arm of an angle-shaped bracket whose other arm may be fixed to a stand or the like.

6. Means as claimed in claims 1, 2 and 3 in which the pressing end of the spindle may be a fixed end or a revolving end.

7. Means as claimed in claim 1 in which the adapter is shaped to suit the utensil.

8. Means as claimed in claim 1 in which the adapter is made of wood or any other material.

9. Means for holding the utensil for the purpose herein set forth and substantially as described and illustrated and utensils so turned.

43. As pointed out in Arnold v. Bradbury, (1871) 6 Ch A 706, the proper way to construe a specification is not to read the claims first and then see what the full description of the invention is, but first to read the description of the invention, in order that the mind may be prepared for what it is, that the invention is to be claimed, for the patentee cannot claim more than he desires to patent. In Parkinson v. Simon, (1894) 11 RPC 483, Lord Esher, M. R. enumerated that as far as possible the claims must be so construed as to give an effective meaning to each of them, but the specification and the claims must be looked at and construed together.

44. The learned trial Judge precisely followed this method of construction. He first construed and considered the description of the invention in the provisional

and complete specifications and then dealt with each of the claims, individually. Thereafter, he considered the claims and specifications as a whole, in the light of the evidence on record.

45. With regard to claim 1, the learned Judge commented :

> The pressure spindle in a lathe is a well-known contrivance. Pressure spindle or a tailstock was in use in this industry much before 1951. So neither the means for mounting and holding metallic utensil nor the independent pressure spindle can be said to be an invention.

46. In claims 3, 4, 6 and 7, also, he found no novelty or inventive step having regard to the fact that these were well-known and were in use long before 1951. Regarding claim 5, he found that the use of bracket was new ; but the end bracket can hardly be said to be an invention.

47. The learned trial Judge then noted that Purshottam, who was stated to be the inventor, and, as such, was the best person to describe the invention, did not appear in the witness-box, though, as admitted by Sotam Singh (DW 3), Purshottam had attended on some dates of hearing. Sotam Singh tried to explain Purshottam's disappearance from the Court without appearing in the witness-box, by saying that he had gone away due to illness. The learned Judge found this explanation unsatisfactory and rejected it--and in our opinion rightly--with the remark that recording of evidence lasted for several days and it was not difficult to secure Purshottam's attendance. Apart from being the best informed person about the matter in issue, Purshottam was not a stranger. He was a partner of the patentee-firm and a brother of Sotam Singh (DW 3). He was the best informed person who might have answered the charge of lack of novelty levelled by the opponent side, by explaining what was the novelty of the alleged invention and how and after what research, if any, he made this alleged `discovery'. Being a partner of the respondent-firm, and personally knowing all the circumstances of the case, it was his duty as well as of the respondent-firm, to examine him as a witness so that the story of the particular invention being a new manufacture or improvement involving novelty, could, in all its aspects, be

subjected to cross-examination. By keeping Purshottam away from the witness-box, the respondent-firm, therefore, took the heavy risk of the trial Court accepting the charge of lack of novelty made by the appellant herein.

48. The trial Judge further noted that the witnesses examined by the patentee-firm had given a garbled account as to the patented invention. The witnesses were speaking with discordant voices as to the alleged `inventive step' involved in the patent. Mata Parshad (DW 2) stated the invention lies in fixing the Charhi on the pointer on the same iron base. In variance with it, Sotam Singh (DW 3) said that the patent covers three factors--the side-supporting iron plate, the pointer with the nut, and the adapter. In this connection, we may add that Lakshmi Dass (DW 1), another witness examined by the patentee-firm, had admitted that machines like Ex. XVI (which was the machine produced by Bhagwati Prasad and was alleged by the patentee to be an imitation of the patented one) were in use even before 1951-52.

49. After a critical appraisal of the evidence produced by the parties, the learned trial Judge found that manufacturers in the industry have been using adapters of various sizes and shapes to suit the article handled ; that tailstock or pointer was also in use; that it was a common practice to fix the headstock and tailstock permanently to a single framework. In regard to the use of the bracket or angle Ex. CC, the learned Judge held that although it was new, it was not a new idea, and concluded :

> There is hardly any difference between fixing the headstock and tailstock to a common base (as the case in the machine Ex. XVI produced by Bhagwati Prasad) or fixing the tailstock in a bracket which is connected with the framework on which the headstock is fixed. Whether we consider Ex. CC as a whole or look at the invention in its separate parts, we do not find any novelty in the alleged invention.

50. In our opinion, the findings of the learned trial Judge to the effect that the patent is not a manner of new manufacture or improvement, nor does it involve any inventive step having regard to what was known or used prior to the date of

patent, should not have been lightly disturbed by the Appellate Bench. These were, as already observed, largely findings of fact, base on appreciation of the evidence of witnesses and the trial Court had the initial advantage of observing their demeanour in the witness-box. Moreover, the approach adopted by the trial Court was quite in conformity with the basic principles on the subject, noticed in an earlier part of this judgment. The patented machine is merely an application of an old invention, known for decades before 1951, for the traditional purpose of scraping and turning utensils, with a slight change in the mode of application, which is no more than a workshop improvement', a normal development of an existing manner of manufacture not involving something novel which would be outside the probable capacity of a craftsman. The alleged discovery does not lie outside the track of what was known before. It would have been obvious to any skilled worker in the field, in the state of knowledge existing at the date of patent, of what was publicly known or practised before about this process, that the claim in question, viz., mere addition of a lever and bracket did not make the invention the subject of the claim concerned. There has been no substantial exercise of the inventive power or innovative faculty. There is no evidence that the patented machine is the result of any research, independent thought, ingenuity and skill. Indeed, Sotam Singh frankly admitted that he did not know whether Purshottam had made any research or any experiments to produce this combination. Nor does this combination of old integers involve any novelty. Thus judged objectively, by the tests suggested by authorities, the patent in question lacked novelty and invention.

51. We will close the discussion of the trial Court's judgment by referring to a decision of the House of Lords in Harwood v. Great Northern Rly. Co., (1864-65) XI HLC 654 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 or 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.

52. 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 are 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.

The above enunciation squarely applies to the facts of the present case.

53. We will now consider the judgment of the Appellate Bench, which, it may be recalled, has found that the novelty and invention of the patent lay in the "the method of holding an article by the pressure of a point of a pointed tailstock (which) was neither used or known".

54. This finding, if we may say so with respect, is inconsistent with the Appellate Bench's own findings (5) and (6) the consolidated substance of which is to the effect, that lathe consisting of headstock and a tailstock and its uses for centering the article, holding along work by a pointed tailstock by pivoting it and holding an article in metal spinning by the pressure of a pad attached to the tailstock, have been well known for a long time. Finding (7) of the Appellate Bench goes beyond the scope of the specifications and claims made by the patentee himself, in the subject of the patent. From a perusal of the specifications and the `claims', extracted earlier, it is evident that there is no assertion therein, of novelty for the pointed tailstock; rather it is stated that "the pressure spindle may be pointed or blunt". Furthermore, this finding of the Appellate Bench stands in contradiction to what Sotam Singh (DW 3) patentee himself has admitted in the witness-box. In cross-examination, Sotam Singh (DW 3) said : "I am not using any other pointer than that of Ex. CC. I never used pointer of any other type. I have not used any rotating pointer either at Banaras or at Mirzapur..... If anybody uses a wooden adapter in a chuck and does scraping work on a katera in such a wooden chuck without a pointer, there would be infringement of my patent.....I conducted no experiments before obtaining the patent, I do not know what kind of experiments Purshottam carried out. I have got no apparatus for scraping utensils except like Ex. CC". Sotam Singh further admitted that machines like Ex. XVI (the one which was produced by the appellant and is said to infringe the patent of the respondent-firm) are sold in the market and one can purchase a pointer like Ex. XI in a lathe.

55. In the face of the admissions of the representative of the patentee, it was not possible for the Court to work out finding (7) on its own, without allowing itself to get into the unenviable position of appearing more Royalist than the King. We have ourselves examined and compared the machines (Ex. CC and Ex. XVI). We find that the tailstock in each of these machines has a blunt end of slightly above 1 cm. in diameter. It may be re-emphasised that according to Sotam Singh

himself, his patented machine has no other end of tailstock excepting of the (blunt) type in Ex. CC.

56. For all the reasons aforesaid, we have no hesitation in holding that the learned Judges of the Appellate Bench were in error in reversing the findings of the trial Court on Issues 1 and 1-A. The learned trial Judge was right in holding that the patented machine was neither a manner of new manufacture or novel improvement, nor did it involve any inventive step, having regard to what was publicly known or used prior to the date of the patent. The grant of the patent in question was therefore, invalid and was liable to be revoked on the grounds mentioned in clauses (d) and (e) of Section 26 (1) of the Act.

57. Before parting with this judgment, we will like to dispose of another argument of Mr. Mehta. The argument is that since the Courts below have concurrently held that the invention had utility the patent should be sustained. We are unable to accept this contention. As pointed out already, the crucial test of the validity of a patent is whether it involves novelty and an `inventive step' ? That test goes against the patentee.

58. In the result, the appeals are allowed, the judgment of the Appellate Bench is set aside and that of the trial Court restored. In the peculiar circumstances of the case, the parties are left to bear their own costs throughout.