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MADRAS HIGH COURT CLARIFIED THE ROLE OF PSITA AND IMPORTANCE OF TSM- TEST IN DETERMINING NON-OBVIOUSNESS

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INTRODUCTION:

Section 2(1)(j) of the Patent Act, 1970, defines an 'invention' as a new product or process involving an inventive step and capable of industrial application. Three major factors i.e., novelty, inventive step and industrial applicability are considered while determining the patentability of any invention. The presence of an inventive step in the invention is considered as one of the major requirements for an invention to be patentable. As per Section 2(1)(ja) the "inventive step" means a feature of an invention that involve technical advancement as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.

Out of these three major factors i.e., novelty, inventive step and industrial applicability, proving the inventive step usually plays a critical role in deciding the fate of a patent application, as the examiner is free in combining innumerable prior arts which are closely related to the given invention, and if any of those prior arts end up resulting into disclosing any system or process similar to said invention then the same would be considered into having lack of inventive step.

ASSESSMENT OF THE INVENTIVE STEP

Once the Patent application is considered to be new/novel, the next crucial step is to evaluate if an invention involves an inventive step.

The following factors are considered while assessing the inventive step:

1. **Technical Advancement:** The invention must demonstrate a significant improvement over existing technologies or methods.
2. **Non-Obviousness:** The invention should not be obvious to someone with ordinary skills and knowledge in the relevant field, which is commonly known as person skilled in the art (PSITA).
3. **Economic Significance:** The invention may also be considered inventive if it has substantial economic benefits or meets the need of the common public.

The Patent Act does not formally define the "person skilled in the art", however there are some iconic case studies in India which paved the way for defining the PSITA. The decision in the case of *Bishwanath Prasad Radhey Shyam vs Hindustan Metal Industries* laid down the foundation for evaluating inventive step in India, emphasizing the importance of non-obviousness and PSITA was firstly addressed in this case.

Indian patent law and judiciary have drawn heavily from international standards and practices to define and apply the concept of the PSITA. Decisions like *F. Hoffmann-La Roche Ltd. vs Cipla Ltd. (2008)* have emphasized that the PSITA should be considered with the appropriate level of skill and common general knowledge in the pertinent field at the relevant date.

Thus, "a person skilled in the art" (PSITA) can refer to a person engaged in the relevant field having common general knowledge to which the invention relates to and has the ability to use acquired knowledge effectively, also if required holding capability to do research or experiments in the expertise filed. The PSITA should be able to identify obviousness and non-obviousness in the said invention comprehending all technicalities based on their own knowledge. For example, if the invention is related to machines or any mechanical component then a mechanical engineer is considered as PSITA and if the invention is electrical based then an electrical engineer is considered as PSITA.

ROLE OF PSITA IN EVALUATING THE INVENTIVE STEP

The PSITA plays a vital role in assessing the inventive step. The determination of whether an invention is obvious hinges on whether the PSITA, with access to all prior art, would find the invention obvious. This involves:

1. **Prior Art Knowledge:** Understanding what constitutes prior art and the general knowledge available to the PSITA.
2. **Routine Skills:** Evaluating whether the PSITA could combine prior art references using routine skills to arrive at the invention.
3. **Problem-Solution Approach:** Often, the PSITA is used in the problem-solution approach to determine if the invention solves a problem in a non-obvious way.

In the recent judgement of the Madras High Court (MHC) in *Microsoft Technology Licensing LLC* (Appellant) vs. *Assistant Controller of Patents and Designs* (Respondent), *(T) CMA (PT) No.71 of 2023 (OA/3/2021/PT/CHN),* where the appellant filed an appeal against the refusal order issued by the respondent in the patent application no. 1783/CHENP/2012 titled *"Message Communication of Sensor and other Data"* for being obvious and lacking inventive step under Section 2(1)(ja) of the Patents Act. The MHC has allowed the appeal clarifying the role of person skilled in the art (PSITA) and importance of the Teaching Suggestion, Motivation (TSM)- test while determining non-obviousness.

The appellant had filed a national phase application in India on 27 February 2012 titled *"Message Communication of Sensor and other Data"* derived from PCT Application. The First Examination Report was issued by the respondent on 27 June 2019, following which the appellant filed a detailed response along with the amended set of claims 1 to 14 on 27 December 2019. The hearing was conducted on 14 July 2020 and the appellant filed a written submission thereafter. Eventually, the refusal order has been passed by the respondent on 29 September 2020 on the ground that the claimed invention is obvious to the person skilled in the art over the cited prior art D4.

In the appeal proceeding, the appellant explained the purpose of the invention and how the application is not obvious to the person skilled in the art. The appellant argued that the invention aims towards a simple light weight messaging system that provides a sensor readings in the form of lightweight messages to multiple applications running on a computer device. The appellant further submitted that the invention envisages a sensor service, the application can receive the sensor value after subscribing to the sensor notification through the sensor service which determines that the messages should be generated on the basis of triggers such as changes in sensor values or passage of time. The appellant also claimed that these light weight messages do not require the writing and use of code. The appellant argued the respondent failed to perform proper analysis and also failed to consider the problem and the solution provided by the claimed invention. The appellant further argued that the order passed by the respondent rejecting the appellant's patent application does not even contain any findings with regard to identification of the person skilled in the art.

On the other side, the respondent argues that the appellant's invention is similar to the prior art D4, and the only difference is in the terminology used. The respondent further states that the respondent had covered the entire claimed invention and concluded that claimed invention lacks inventive step and that no interference is warranted with the impugned order.

COURT'S CONTENTION

The Madras High Court analyzed the refusal order and observed that the evaluation of the inventive step is to be made by two-step process,

"(I) identification of feature(s), if any, that involve technical advancement over prior knowledge or having economic significance or both; and

(ii) determination of whether the technical advance or economic significance or both of said feature(s) makes the invention not obvious to a person skilled in the art."

The Hon'ble Court considered Section 2(1)(ja) of the Patents Act, which defines an inventive step, and stated that evaluating the inventive step of a claimed invention involves a two-step process. This highlights the importance of the person skilled in the art (PSITA). To identify the PSITA, one must start with the field of invention, which in this case involves enabling applications in computers to receive sensor data through lightweight messages. Thus, the PSITA would be a software engineer knowledgeable in hardware and computer electronics.

The Madras High Court identified and noted that, the problem statement that the claimed invention solves itself to is the reduction of complexity by converting raw sensor data into lightweight messages which are transmitted or communicated to the subscribing application. Thus, the problem statement of the cited prior art document was different from the problem statement of the invention of the appellant.

Since the contested order relied solely on prior art D4, the Court conducted a comparison with this prior art. The Court noted that the claimed invention's solution involves converting raw sensor data into messages that can be transmitted to and easily read by the subscribing application. In contrast, the cited prior art does not contemplate the conversion of raw sensor data into easily readable messages. The Court has observed that even though cited prior art and the claimed invention provide for the transmission of sensor data to a subscribing application, the difference lies in how such data is transmitted.

Regarding whether prior art D4 contains teachings, suggestions, or motivation leading the PSITA to the claimed invention, the Court examined the complete specification of D4. The Hon'ble Court stated that prior art D4 does not address the complexity of data communication from sensors to subscribing applications. Therefore, not only are the problems addressed by the prior art and the claimed invention different, but the recitals and disclosures in D4 also do not suggest, motivate, or teach PSITA to arrive at the claimed invention.

The Hon'ble Court further directed to amend the independent claim 1 and 9 to confine the scope of the monopoly of the claim. Based on this the Hon'ble Court has concluded that the claimed invention would not be obvious from cited prior art, thus proceeding the application to grant subject to amendment of the independent claims.

CONCLUSION

The Hon'ble Madras High Court, in its decision, set aside the refusal order, highlighting the distinct problem-solution approach of the invention compared to prior art. The Hon'ble Court clarified the critical role of the Person Skilled in the Art (PSITA), emphasizing that determining the inventive step requires relevant expertise.

Additionally, the decision underscored the importance of the TSM (Teaching-Suggestion-Motivation) test, stating that prior art should provide sufficient motivation or suggestion to the PSITA to reach the claimed invention, thereby ensuring a rigorous assessment of non-obviousness

IP SNIPPETS:

PATENT CASES:

PFIZER INC & ANR. (Plaintiffs) vs. EVEREST PHARMACEUTICALS LIMITED & ORS (Defendants)

Case Number: I.A. 9668/2024
Decided on: May 01, 2024

In the present case, the plaintiffs have filed an application to restrict the defendants from infringing plaintiffs patent bearing no. IN 298989 titled *'Macrocyclic Derivatives for the Treatment of Proliferative Diseases'* and commercially dealing with plaintiff's 'LORLATINIB' . The plaintiffs' argued that their patent has been granted and has been approved for manufacturing and the following compound is marketed and sold commercially under the tradename 'LORBRIQUA®', of which 'LORLATINIB' is the active pharmaceutical ingredient. The plaintiffs argued that the defendants were found to be selling the 'LORBREXEN' containing the same compound as 'LORLATINIB' without any granted registration, certificates and import licence for that drug.
The Hon'ble Delhi High Court decision lies in favour of plaintiff. The Hon'ble Court have made out a prima facie case for grant of an *ex-parte ad interim injunction* restraining the defendants and all those acting for and on their behalf from manufacturing, selling, distributing, promoting, dealing with in any manner of the pharmaceutical product 'LORLATINIB' either as an API or the same under any brand name that infringes IN 298989.

RICH PRODUCTS CORPORATION (Appellant) vs. THE CONTROLLER OF PATENTS & ANR. (Respondents)

Case Number: LPA 257/2024 & CM No.19528/2024
Decided on: May 01, 2024

The appellant has filed an intra-court appeal at Hon'ble Delhi High Court challenging the rejection of the pre-grant opposition filed by the appellant and granting the patent titled *"An artificial liquid cream for utilization in unsweetened cooking and whipping applications"* to respondent 2, Tropilite Foods Pvt. Ltd. The appellant filed the pre-grant opposition under clauses (b) to (g) of Section 25(1) of the Act.
The appellant submitted that the respondent 2's invention was already covered by the earlier patent (D1) granted in favour of appellant, yet the Controller of patent office has rejected the appellant's contentions and also failed to consider the writ petition filed by the appellant against an order of rejecting the pre-grant opposition, on the ground of availability of alternative remedies. Respondent 2 argued that the cited prior art (D1) does not disclose the specific composition of the stabilizer system and the method for preparing the same as disclosed in respondent 2's invention. The respondent 2 also submitted that the if pre-grant opposition is rejected then the opponent can file a post-grant opposition under Section 25(2) of the Act and if unsuccessful, they can file an appeal against an order rejecting its post-grant opposition under Section 25(4) of the Act.

The Hon'ble Delhi High Court stated that the pre-grant opposition is a part of the examination process and also an aid for the controller for considering the grant of patent application. The Hon'ble Court observed that the controller had rejected the pre-grant opposition and granted the application only after performing detailed examination and considering the objection raised by the appellant. The Hon'ble Court concluded the matter rejecting the opposition and stating that the Patent office did not suffer from any jurisdictional error, which would warrant any interference under Article 226 of the Constitution of India.

SONALKUMAR SURESHRAO SALUNKHE AND KUNAL SURESHRAO SALUNKHE (Petitioners)vs. THE ASSISTANT CONTROLLER OF PATENTS (Respondent)

Case Number: 14 COMMP8-22.DOC
Decided on: May 06, 2024

The current petition has been filed by the petitioners under the provisions of Section 117A of the Patents Act, 1917 ("The Patents Act") against the respondent for abandoning the petitioners patent application. The respondent state that the petitioner failed to submit reply to all the objections raised during the First Examination Report (FER), the petitioners did not even apply for extension of time to complying with the requirements of the FER, therefore no further technical examination was required as the petitioner failed to comply with the requirement of section 21 (1) of the Patents Act, 1970. The respondent further objected the present petition as not maintainable because the impugned order was passed under Section 21(1) of the Patents Act. The petitioner argued that they had responded to all the requirements under the FER and

further stated that even if the application was to be rejected as the response of the petitioner was not satisfactory the order is still an order passed under Section 15 of the Patents Act, which is appealable under Section 117A, purposing the petition to be maintainable.

The Hon'ble Bombay High Court observed the following issue and stated that since the petitioner failed to comply with the requirements raised in the FER within the prescribed time period the order has been correctly passed under the provisions of Section 21(1) and not under Section 15 of the Patents Act. The Hon'ble Court further concluded upholding the objections raised by the respondents and dismissing the present petition as section 117A does not provide for an Appeal against an Order passed under Section 21(1).

SYNGENTA PARTICIPATIONS AG & ANR. (Appellant) vs. CONTROLLER OF PATENTS AND DESIGNS & ANR. (Respondent)

Case Number: C.A.(COMM.IPD-PAT) 7/2023
Decided on: May 14, 2024

The present appeal has been filed by the appellant against an order for rejecting the patent application no. 872/DELNP/2011 titled *"Crop Safeners"* on the ground that the claims filed by the appellant lack the reference to the amounts/ratio of pesticide and the safener being used as well as the application lack the inventive step. The appellant had amended the claims, providing composition to meet the objections raised during the opposition to which the respondent states that the proposed amendments may have to be considered de novo by the Patent office due to the introduction of the specific composition. The appellant further claimed that the invention was based on a unique formulation of an insecticidal composition comprising *diafenthiuron* and a crop safener which was already a part of the specification and claims.

The Hon'ble Delhi High Court is of the opinion that after considering the primary objection by the respondents, new suggested amendments to the claims by the appellant can be considered. The Hon'ble Court further ruled that the patent application is to be remanded back for a *de novo* consideration by the respondent. The Hon'ble Court further ordered them to issue a fresh notice of hearing and give an opportunity to the appellant to place their amended claims before the Patent Office.

ALIMENTARY HEALTH LIMITED (Appellant) vs. CONTROLLER OF PATENTS AND DESIGN (Respondent)

Case Number: C.A.(COMM.IPD-PAT) 458/2022
Decided on: May 14, 2024

The present appeal has been filed by the appellant before the Hon'ble Delhi High Court against the order of refusal issued by the respondent on the ground of inventive step under section 2(1) (ja) and non-patentability under Section 3(c), 3(d) and 3(i) of the Act. The present application bearing the application No. 3989/DELNP/2012 involving formulation of a probiotic bacterium i.e., specifically the strain of *Bifidobacterium longum* designated as NCIMB 41676 (AH1714). Objections were raised in the First Examination Report (FER) to which the appellant submitted the detailed response by amending and limiting the claims. Following to which hearing was fixed objecting the application under Section 2(1) (ja) for lack of inventive step and under section 3 (c), (d) and (e) of the Act for non-patentability, subsequently a written submission was filed by the appellant along with amended claims to strengthen the patentability of the invention further to which the respondent rejected the invention. The appellant argued that the respondents had quoted paragraphs without analysing the different strains of *Bifidobacterium* from cited prior arts. The Appellant also states that the respondent had disregarded the experimental data in the specification of the invention consisting technical advancement of *Bifidobacterium longum* NCIMB 41676 (AH 1714) over other strains and also failed to acknowledge the formulation. The respondent defends and argues that invention is already known in the prior art, lacking inventive step and also the patent application are obvious to a person skilled in the art. The Hon'ble Delhi High Court observes the following issue and states that the order lacks a substantive examination of how the specific *Bifidobacterium longum* NCIMB 41676 strain is obvious or lacks an inventive step w.r.t. the prior art documents. The Hon'ble Court further states that the order was non-speaking and hence reminded back for a fresh examination and evaluating the raised issues to decide on the grant or refusal of the subject patent application.

TRADEMARK CASES

PUNAM FLUTES (Petitioner) vs MAHESH CHAND GUPTA AND ANR (Respondents)

Case Number: C.O. (COMM.IPD-TM) 162/2021
Decided On: April 23, 2024

The present petition has been filed by the petitioner to seek cancellation of registration of the respondent's trademark "PUNAM" granted in class 15.
The petitioner in its submission has stated its adoption and prior extensive, long use along with existence on the Register of Trademarks in class 15, 42, 45. Relying on submissions of petitioners it can be observed that they are well-known manufacturers of musical instruments in the country and also export to other countries. The respondent has registered its mark "PUNAM" on proposed to be used basis which is deceptively similar to the petitioner's mark " ". Both the marks are having similar goods being musical instruments included in class 15, thus increasing the possibility of consumer confusion. On the other hand respondent no. 1 has refrained from joining the proceedings.

Petitioner's mark	*Respondent No. 1's mark*
	PUNAM

The Hon'ble Delhi High Court analysed that inclusion of descriptive components that are typical in trade clearly suggests that the word "PUNAM" serves as the prominent feature of Petitioner's mark, intended to identify them as the source of the products. The comparison drawn above demonstrates that the impugned mark wholly entails the essential element of Petitioner's mark i.e., "PUNAM". The Hon'ble court has allowed the rectification/ cancellation petition.

PFIZER PRODUCTS INC. (Plaintiff) vs RENOVISION EXPORTS PVT. LTD. AND ANR. (Defendants)

Case Number: CS(COMM) 378/2018
Decided On: May 01, 2024

The Plaintiff filed lawsuit seeks to protect their trademark in "VIAGRA," a well-recognized drug, by seeking permanent injunction and other ancillary reliefs to prevent the defendants from marketing their homeopathic medicine under a confusingly similar trademark "VIGOURA," used allegedly for curing sexual disorders.

The plaintiff submitted that the defendants intentionally deceptively use the "VIGOURA" mark, which is similar to Pfizer's "VIAGRA" trademark, to capitalize on the goodwill and reputation. On the contrary, defendants contended that the impugned products were distinct medicines, as the difference in the composition and nature of the two medicines coupled with the fact that both were prescription drugs, reduced the likelihood of confusion for consumers.
The Hon'ble Delhi High Court opined that it is essential for any entity seeking to introduce a new trademark into the market to conduct thorough due diligence, which includes searching the national trademark database for any pending applications or registrations that could conflict with the proposed mark. It further submits that the trademarks "VIGOURA" and "VIAGRA" shows a high degree of phonetic similarity by underlining phonetic resemblance especially in the pharmaceutical industry, where the precise identification of products is crucial for consumer safety and confidence.
The Hon'ble Court permanently restrained the defendants or anyone acting on their behalf from manufacturing, selling, or offering for sale, marketing, advertising, or using the mark 'VIGOURA' in any manner or any mark deceptively similar to the plaintiff's trade mark 'VIAGRA' in relation to any of their goods as would amount to infringement or passing off of the plaintiff's registered mark.

TESLA INC. (Plaintiff) vs TESLA POWER INDIA PRIVATE LIMITED & ORS. (Defendants)

Case Number: CS(COMM) 353/2024
Decided On: May 02, 2024

The present suit has been filed by the plaintiff seeking permanent injunction and damages for infringement of trademark, passing off, and unfair trade competition. Grievance is against defendants who are using the impugned trademark/ trade name TESLA POWER / TESLA POWER USA, and

The plaintiff has asserted that it came across defendant no.1 and its counterpart, defendant no.2 (a company registered in USA) using the impugned marks which included plaintiff's trademark 'TESLA' in its entirety, in addition to the descriptive phrase 'POWER USA'. On the other hand, defendant has contended that it deals with lead acid batteries for electric vehicle and further clarified that it has no plans to enter in the electric vehicle sector.

THE INDIAN HOTELS COMPANY LIMITED (Plaintiff) vs SHIVGYAN DEVELOPERS PRIVATE LIMITED (Defendant)

Case Number: CS(COMM) 361/2024
Decided On: May 03, 2024

The present suit was filed by the plaintiff against the defendant to protect its trademark from infringing and passing off activities of the defendant. The plaintiff is engaged in the hospitality industry and owns a chain of reputed hotels across many countries. The Plaintiff has registered the trademarks/logos "VIVANTA", "VIVANTA BY TAJ" VIVANTA and VIVANTA and has gained substantial amount of goodwill and reputation among the industry. Plaintiff asserted that defendant's use of an identical mark "VIVANTA" in relation to their goods and services is clear infringement of plaintiff's marks. The defendant has not appeared before this court to present their case despite receiving advance notice of the present lawsuit.

The Hon'ble Delhi High Court observed that the plaintiff has made out a prima facie case of infringement and passing off in their favour; and in case an *ex-parte ad-interim injunction* is not granted by this court, the Plaintiff will suffer irreparable loss of reputation and goodwill.

The Hon'ble Court directed that, till the next date of hearing defendant and/or anyone acting on their behalf, are restrained from unauthorizedly using the plaintiff's registered trademark "VIVANTA" or any other identical or deceptively similar mark, in any manner or form (both online and offline), thereby amounting to infringement and/or passing off.

COPYRIGHT CASE:

M/S REFLECT SCULPT PRIVATE LTD. & ANR (Plaintiffs) vs ABDUS SALAM KHAN (Defendant)

Case Number: CS(COMM) 278/2024
Decided On: April 03, 2024

The present suit has been filed by the plaintiffs against defendant for infringing its copyright and creating, manufacturing, advertising, and selling counterfeit garments which are replicas/ substantial imitations of the Plaintiffs' unique and artistic garments, at low/ cheap prices.
The plaintiffs alleged that defendants are operating a business on YouTube under the name 'Designer Salam', with uploaded videos featuring 'Gaurav Gupta', causing people searching for 'Gaurav Gupta' to be directed to the defendants' channel. Additionally, the defendant is infringing on the plaintiff's copyrights and registered designs by sharing videos and interacting with the public on social media, like Instagram and Facebook, and providing its contact number to place orders for impugned products, thus affecting the goodwill and reputation of the plaintiffs.
The Hon'ble Delhi High Court has found that the plaintiffs have made out a prima facie case in their favour for grant of an *ex-parte ad-interim injunction,* as in absence of such an injunction, irreparable harm would be caused to the plaintiffs; balance of convenience also lies in favour of the plaintiffs and against the defendant. The court has ordered the defendant to refrain from manufacturing, reproducing, selling, advertising, or promoting counterfeit garments that are colourable imitations or substantial reproduction of the plaintiffs' drawings, garments, and styles. The defendant is also prohibited from using the plaintiffs' trademark and plaintiff No. 2's name 'GAURAV GUPTA' in designs or promoting impugned products to unfairly exploit the plaintiffs' reputation and goodwill. The defendant is also directed to remove content on social media platforms.

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