



2024:DHC:1945



* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% *Reserved on* : 05th February, 2024
Pronounced on : 05th March, 2024

+ **CS(COMM) 431/2023**

SNPC MACHINES PRIVATE LIMITED & ORS. Plaintiffs

Through: Mr. Anirudh Bakhru, Mr. Nageeb Nawab, Ms. Apurva Bhutani, Ms. Vanshika Bansal, Mr. Yashwardhan Singh, Ms. Neeharika Chauhan, Ms. Setal Tayal, Ms. Vijay Laxmi and Ms. Pragya, Advs.

versus

MR VISHAL CHOUDHARY Defendant

Through: Mr. Adarsh Ramanujan and Mr. P.D.V. Srikar, Advs.

CORAM:
HON'BLE MR. JUSTICE ANISH DAYAL
ORDER

% **I.A. 11490/2023** (*under Order XXXIX Rules 1 & 2, CPC*)

1. This application under Order XXXIX Rules 1 and 2 of Code of Civil Procedure, 1908 (“CPC”) has been filed by plaintiffs as part of the suit seeking permanent injunction restraining defendant and other persons through him from using, making, manufacturing, offering for sale or selling or importing the impugned brick making machines which are protected under the plaintiffs’ patent nos. 353483 and/or 359114 and/or 374814 and/or 385845 and/or any product similar thereto in any manner without the permission, consent, or license of the plaintiffs. Further relief has been sought relating to infringement of copyright of plaintiffs in literature/



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specification/ artistic features related to plaintiffs' brick making machine besides other attendant reliefs.

2. Plaintiff no.1 claims to be a pioneer in revolutionizing one of the world's oldest industries of brickmaking, engineering a shift in the traditionally manual process of making bricks to what is claimed to be world's first patented, fully automated and mobile brick making machine ("*plaintiffs' machines*"). Plaintiff nos. 2 to 4 are promoters/ directors of the plaintiff no. 1 and are *inter alia* inventors, co-applicants, co-patentees of the plaintiff's machines.

3. It is alleged that defendant is manufacturing and selling Brick Making Machines ("*defendant's machine*") which are similar to plaintiffs' machines for which the aforementioned patents have been granted.

4. The following patents have been granted in favour of plaintiffs:

Sr. No.	PATENT No.	TITLE	APPLICATION DATE	DATE OF GRANT	APPLICANT/PATENTEE
1	359114	Brick Making Machine	26.02.2014 (543/DEL/2014)	23.02.2021	-Vilas Chhikara -Satish Kumar -Jagpravesh
2	385845	Brick Making Machine (BMM 150) And The Process Of Making The Brick Thereof	19.02.2015 (472/DEL/2015)	03.01.2022	-Vilas Chhikara -Satish Kumar -Jagpravesh
3	353483	Brick	31.12.2015	11.12.2020	-Vilas Chhikara



		Making Machine (BMM300) And The Process Of Making The Brick There Of.	(4341/DEL/2015)		-Satish Kumar -Jagpravesh
4	374814	Hydraulic-Based Mobile Brick Making And Laying Machine	29.10.2020 (202011047301)	18.08.2021	SNPC Machines Private Limited

5. Additionally, plaintiffs claim copyrights under provisions of the Copyright Act, 1957 in technical literature, data sheets, technical specification, drawings, images, etc. pertaining to the plaintiffs' machines.

6. The history of innovating plaintiffs' machines has been narrated in paragraph nos. 5 to 8 of the plaint. Essentially, plaintiff no. 2 was engaged in the business of conventional brickmaking which was labour-intensive and being aware of the fact that there was no automation in the brick making industry, he conceptualised an idea for developing an automated brick making machine. Pursuant to research and development, together with his brothers, plaintiff nos. 3 and 4, between 2007 to 2014, created several prototypes. In 2013, plaintiff nos. 3 and 4 incorporated plaintiff no.1 company. Plaintiff no.1 claims to be a leading modern player in the age-old brick making industry, not only domestically but worldwide as well. Plaintiffs' machines are exported to various countries *inter alia* Nepal,



Bangladesh, Pakistan, Afghanistan, Uzbekistan, Kyrgyzstan, Sudan, and Kingdom of Saudi Arabia; plaintiffs enjoy approximately 65% of its revenue from its international market and 35% from domestic market (figures pertain to the financial year 2018-19). Plaintiffs' total turnover in financial year 2021-22 is INR 15,81,42,929.20/- and annual advertising and promotional expenses for the same year were INR 8,36,464/-.

7. The first patent **IN 359114** applied for by plaintiffs in 2014 had the following essential features, as submitted by plaintiffs:

a) A mobile brick-making machine comprising:

- i.* A chassis (102) to support various parts and aggregates of the machine;
- ii.* A cabin (101) for an operator of the machine to sit and operate the machine, the cabin having various controls for the operator to drive the machine and control brick making operation;
- iii.* A pair of steered front wheels (122) and a pair of non-steered rear wheels (113) mounted on the chassis (102) through their respective axles (304, 303), one of the pair of the front wheels (122) and the pair of rear wheels (113) driven by a moving motor (121);
- iv.* A raw material stock compartment (106) to hold raw material for making bricks;

b) A roller and die assembly comprising:

- i.* A roller wheel (119); and
- ii.* A die (115) made up of a plurality of circumferentially arranged brick frames (502), the plurality of circumferentially arranged brick frames concentrically fixed to the roller wheel (119);



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wherein the roller and die assembly is configured to rotate as the mobile brickmaking machine moves ahead; and wherein the plurality of brick frames (502) receive the raw material from the raw material stock (106), mould the bricks and lay them on ground as the machine moves ahead, thereby laying a line of moulded bricks on ground.

8. Subsequent patents had technical improvements and additional features over the first patent IN 359114 and detailing them out may not be necessary for the purpose of deciding this application.

9. Plaintiffs' machine was recognised as the Most Preferred Machine of the year 2017 in Construction by ET NOW. Further awards were granted to the plaintiffs *inter alia* the National Start-up Award, 2020 by the Government of India; award by the Department of Science and Technology, Government of India; Make in India Emerging Entrepreneur Award in Construction Category in 2016.

10. Essentially, counsel for plaintiffs pointed out that the uniqueness in the plaintiffs' machine was to engineer a mechanism and create a design by which the traditional manual system of brick making was converted to a mechanised system with mobility of the machine as an essential feature. In common parlance, the machine employed a chassis with wheels on which was mounted, a stock compartment to hold raw material for making bricks, which would dispense the raw material to a roller and die assembly which was mounted on a roller wheel. The die was itself a plurality (sequence) of circumferentially arranged bricks which were concentrically fixed to the



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rotary wheel. This whole contraption was mobile and driven by an operator having a cabin with various controls and the full mechanism was configured to allow the raw material to be dispensed in the mould/ die which then would then, through a hydraulic switch, eject moulded bricks laying them on the ground in sequential pattern as the assembly moved ahead.

11. The inventiveness was in adding mobility to a rotary system of brick making with geometrically arranged dies programmed to eject a moulded brick in a synchronised manner in order to lay them on the ground as the assembly moved on. This would, therefore, obviate the manual process and instead increase efficiency manifold of creating moulded bricks for the purposes of construction.

12. It was stated by counsel for plaintiffs that neither pre-grant nor post-grant opposition was made by any of the party to the said patent applications. However, in April, 2023 one of plaintiffs' clients based in Delhi was approached by defendant for sale of an automated brick making machine and a quotation dated 3rd April, 2023 was received by them from defendant. This led to filing of the present suit on 30th May, 2023.

13. Reference has also been made to an earlier Cease & Desist letter dated 11th April, 2022 which had been issued to the defendant when the plaintiff had come across brochure posted by the defendant relating to the brick making machine of the defendant. It was pointed out that defendant, in its listings on e-commerce sites, was stated to have been incorporated in 2020 and even otherwise were not claiming that they were selling defendant's machines prior to 2022. No response was received to the Cease & Desist letter.

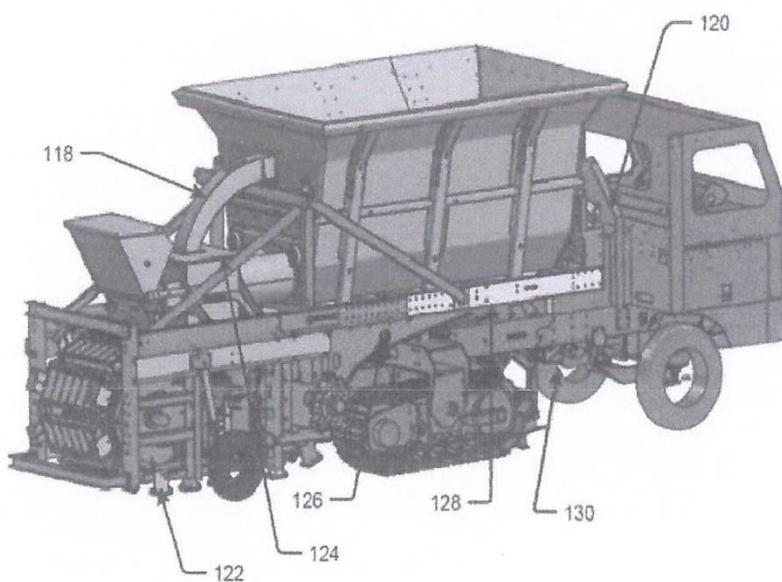


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14. It is submitted by plaintiffs' counsel that the defendant's machine sold under the name of Padma Brick Making Machine was also styled as a mobile brick making machine having substantially the same features as that of plaintiff's machine except that the brick making assembly was pulled by a tractor in defendant's machine as opposed to having an integrated driver's cabin. A comparative pictorial representation of both the products is as under:



Plaintiffs' Drawings	
Defendant's impugned Brick Making Machine	

Submissions of the plaintiffs

15. Plaintiffs' counsel contended *inter alia* as under:

- a) Defendant lifted all the essential elements of the plaintiffs' patent claim;
- b) The differential claimed by defendant from plaintiff's machine was trifling and insignificant in nature and did not impact the result in effect of the machine. In essence, ***'the pith and marrow of the invention'*** has to be looked into and not literal infringement where each and every



component would be copied;

- c) **Purposive construction** ought to be applied rather than literal construction, in that, as long as the substance of the invention was found to be copied, non-essential or trifling variations were not germane;
- d) **Doctrine of equivalents** was to be applied to examine if the substituted element in the infringing product does the same work in substantially the same way to accomplish substantially the same result. On this basis, reference was made to the following tabulation provided by defendant as part of their submissions, same is extracted as under:

S.No.	CLAIMS OF IN 359114	PADMA BRICK MAKING MACHINE [DEFENDANT'S MACHINE]
1	<u>CLAIM 1:</u> A mobile brick making machine comprising: A cabin for an operator of the machine to sit and operate the machine, the cabin having various controls for the operator to drive the machine and control brick making operation.	In Padma brick making machine, no such cabin exists and brick making operation cannot be controlled from cabin.
2	A pair of steered front wheels and a pair of non-	In Padma brick making machine, the machine lacks a steering, and lacks



	steered rear wheels mounted on the chassis through their respective axels, one pair of the front wheels and	steered front wheels.
3	the pair of rear wheels driven by a moving motor.	It has only one set of wheels and these are not driven by a moving motor.

e) It was contended that the differential aspects claimed by defendant were trifling in nature, in that, *firstly*, no such cabin exist in the defendant's machine; *secondly*, defendant's machine lacked a steering and steered front wheels; and *thirdly*, it has one set of wheels and not driven by a moving motor. All these, plaintiff's counsel contended, merely amounted to difference of mounting the brick making assembly on a frame and causing the mechanism to work through a motorised mobile system. This motorised mobile system was an integrated driver's cabin resting on a chassis in plaintiffs' machine as compared to a tractor-pulled chassis in the defendant's machine. The process integrated the movement of the whole assembly to the functioning of the manufacturing mechanism leading to ejecting and laying of moulded bricks in an organised fashion on the ground. A simple comparison showed that plaintiffs' and defendant's machine were achieving the same result through a similar integration.

16. Counsel for plaintiffs, in support of their argument on *balance of convenience*, contended that it was clearly in their favour considering that



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plaintiffs' machine was conceptualised prior to 2014, patent application was filed in 2014 and was granted in 2020. The defendant admittedly had not started selling defendant's machine 2021. As regards *irreparable loss and injury*, it was contended that plaintiffs had heavily invested into research and development and had now gathered a large part of domestic and international market.

17. In response to defendant's submission challenging validity of the suit patent, plaintiffs' counsel relied on the proposition that such a challenge has to raise a serious triable and substantial question that would render the patent vulnerable to challenge. Any such defence, if taken by defendant, would have to be seen at the stage of trial; at this stage of hearing an application under Order XXXIX Rule 1 & 2, CPC, the issue was, *prima facie*, only of balance of convenience and irreversible prejudice. In support, reliance was placed on decision in *F.Hoffman-LA Roche Ltd. & Anr. v. Cipla Ltd.*: 2009 SCC OnLine Del 1074, the relevant paragraphs of which are extracted as under:

“69. Elaborate arguments were addressed on the question of balance of convenience on the ground that the judgment of the House of Lords in American Cyanamid requires such factor to be considered once it is shown that the damages would not provide an adequate remedy to the plaintiff in the event of it succeeding at the trial. In the considered view of this Court, this aspect need not be examined in the present case for more than one reason. First, the plaintiffs have, for the reasons discussed earlier, failed to make out a prima facie case in their favour. Even if it is assumed that they have, in view of the fact that the defendant has raised a credible challenge that renders the patent's validity vulnerable, the question of balance of convenience does not arise because clearly the Court will



not, at the interlocutory stage without the case going to trial, come to the aid of a holder of a patent of doubtful validity seeking to enforce such patent.

...
71. The discussion on this aspect is concluded by concurring with the learned Single Judge that, assuming that the plaintiffs held a patent for the product which was the subject matter of the suit for infringement, the defendant has raised a credible challenge to the validity of the patent by raising a serious triable and substantial question that renders it vulnerable to challenge.”

18. Essential basis of defendant’s objection to validity of the suit patents is that automated brick making machines have been known to exist in the industry since many years and therefore, would be regarded as ‘*prior art*’. Illustration was given of the ‘*Ishantu Brick Making Machine 800*’; an automated brick laying machine existing prior to 2014, as well as ‘*Osaka Rotary Logo Clay Brick Machine*’, which was established in 2005, and a prior art patent ‘*US 750059*’ titled ‘*W.R. Oberdahn Brick Making Machine*’ patented on 19th January, 1904.

19. In this regard, plaintiffs’ counsel contends that plaintiffs’ machine is not just about automated brick production or laying but the inventive step was the combination of mechanised brick production coupled with mobility and, in turn, the mobility triggering the mechanised process. There is no quarrel on behalf of the plaintiffs that automated brick machines are available, but the suit patent was relatable to the unique combination.

Lack of Territorial Jurisdiction

20. To meet this argument, counsel for plaintiffs contended that, at this stage, it is necessary for plaintiffs to make a positive statement that infringing



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goods have found presence with the territorial jurisdiction of Delhi and the Court must proceed assuming the statements to be correct. For the same, he relied upon the following decisions, relevant paragraphs of which are extracted as under:

i. *Tej Ram Dharam Paul and Ors. Vs. Om Shiva Products Inc and Ors.*, 2022 SCC OnLine Del 4745

“22. Admittedly, Plaintiff No. 2 has its principal place of business in Delhi, but it is only a licensee of Plaintiff No. 1, and therefore that may not be material for the purpose of deciding jurisdiction. Plaintiff No. 1, the registered proprietor of mark “COOL LIP”, has its principal/head office at Maur Mandi, Punjab, but it also has a subordinate/branch office in Delhi. Plaintiffs have averred that cause of action arose in Delhi inasmuch as the infringing goods have been found to be sold in various markets and areas of Delhi. It is well-settled that material facts pleaded in the plaint are to be taken as correct and veracity thereof can be conclusively determined only after trial. Since Plaintiffs have made a positive statement that infringing goods have been found within territorial jurisdiction of Delhi, at this stage, the Court must proceed assuming these statements to be correct. Whether in fact such goods have been found in Delhi shall be established through evidence led by Plaintiff, during trial.”

(emphasis added)

ii. *Marico Limited vs. Mukesh Kumar and Ors.*, 2018 SCC OnLine Del 13412

“67. The plaintiff has further asserted in its plaint that the defendants are indulging in online sale of the impugned product in Delhi through another website ‘Indiamart’. Printouts of the ‘Indiamart’ website showing the defendants products range have been filed. A perusal of the ‘Indiamart’ website prima



facie shows that it is an interactive website inasmuch as it permits the viewers to ask for price and specifically states “before dispatching the product, they are firmly tested and checked by the team of quality controllers”. Accordingly, in the present case the “purposeful availment” as well as “sliding scale” and “effects” tests as stipulated in *Banyan Tree Holding (P) Limited v. A. Murali Krishna Reddy, (2010) 42 PTC 361 (Del)* are satisfied.”
(emphasis added)

21. Plaintiffs have provided their sales turnover figures for years between 2014 to 2022 as under:

Financial Year	Total Turnover (In Indian Rupees)
2016-2017	8,69,48,018.46
2017-2018	10,82,71,263.84
2018-2019	24,04,21,768.84
2019-2020	21,00,98,274.25
2020-2021	29,47,34,588.44
2021-2022	15,81,42,929.20

Copy of the Chartered Accountant certificate has also been placed on record.

22. Plaintiff no.1 also claims to have invested percentage of its turnover in the marketing and promotion of its products and the said figures have been tabulated by the plaintiff as under:



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Financial Year	Total Turnover (In Indian Rupees)
2016-2017	1,19,675.00
2017-2018	1,26,036.75
2018-2019	6,65,677.03
2019-2020	6,52,349.77
2020-2021	4,40,237.39
2021-2022	8,36,464.00

23. Plaintiffs have also adverted to a successful enforcement action against the third party from using brick making machines. *CS (COMM) 59/2022* titled as *SNPC Machines Private Limited & Ors. v. Pankaj Rana & Ors.*, was instituted before this Court and a decree was passed in favour of plaintiffs pursuant to a settlement between the parties. Defendant therein, undertook not to manufacture, sell and use the infringing brick making machine and admitted the intellectual property rights of the plaintiffs.

Mapping

24. Before proceeding further, it would be useful to present a table mapping plaintiffs' products vis-à-vis the defendant's impugned brick making machine, as under:



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Features of the Granted Claims of the Plaintiffs' Patent No. 359114	Images of the Defendant's impugned Brick Making Machine
<p>A mobile brick-making machine comprising:</p> <p>a chassis to support various parts and aggregates of the machine;</p> <p>a cabin for an operator of the machine to sit and operate the machine, the cabin having various controls for the operator to drive the machine and control brick making operation;</p>	
	



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a pair of steered front wheels and a pair of non-steered rear wheels mounted on the chassis through their respective axles, one of the pair of the front wheels and the pair of rear wheels driven by a moving motor



a raw material stock compartment to hold raw material for making bricks



a die made up of a plurality of circumferentially arranged brick frames, the plurality of circumferentially arranged brick frames concentrically fixed to the roller wheel



wherein the roller and die assembly is configured to rotate as the mobile brickmaking machine moves ahead; and wherein the plurality of brick frames receive the raw material from the raw material stock, mould the bricks and lay them on ground as the machine moves ahead, thereby laying a line of moulded bricks on ground





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Features of the Granted Claims of the Plaintiffs' Patent No. 353483	Images of the Defendant's impugned Brick Making Machine
<p>A brick-making machine (BMM-300) comprising</p> <p>chassis to support various parts and aggregates of the machine</p> <p>cabin for an operator of the machine to sit and operate the machine, the cabin having various controls for the operator to drive the machine and control brick making operation</p>	
<p>pair of steered front wheels and a pair of non-steered rear wheels mounted on the chassis through their respective axles, at least one of the pair of the front wheels and the pair of rear wheels driven by a moving motor</p>	
<p>raw material stock compartment to hold raw material for making bricks</p>	



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roller and die assembly comprising:

roller wheel; and

die made up of a plurality of circumferentially arranged brick frames, the plurality of circumferentially arranged brick frames concentrically fixed to the roller wheel; wherein the roller and die assembly is configured to rotate as the mobile brick-making machine moves ahead; and wherein the plurality of brick frames receive the raw material from the raw material stock, mould the bricks and lay them on ground as the machine moves ahead, thereby laying a line of moulded bricks on ground



characterized in that, the die includes a star shape frame in the middle of the die which divides the die in two rows or columns and is configured as a mould for each brick frame and maintains a gap between the bricks ejecting from the brick frame, and a timer for determining the time and place for dropping the brick on the ground, and single or double piston for pushing the brick from inside to outside with the help of timer.



25. Plaintiffs have also provided photographs of their brick laying machine and display of the output as under:



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PHOTOS OF THE PLAINTIFFS' PATENTED BRICK MAKING MACHINES



26. Photographs of defendant's impugned machine are as under:



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PHOTOS OF THE PLAINTIFFS' PATENTED BRICK MAKING MACHINES



27. As regards the first patent No.359114 of the plaintiffs, the following was the abstract adopted in the patent application:



ABSTRACT

MOBILE BRICK MAKING MACHINE

A mobile brick making machine is disclosed, which moves on two steered front wheels (122) and two rear wheels (113), the wheels driven by a motor. A cabin (101) is provided for an operator to sit and drive/operate the machine. Raw material stored in a raw material compartment (106) is moved by three worms (402/110/127) to a roller wheel (119) and die (115) assembly, which rotates and lays a line of bricks as the machine moves ahead. A waste conveyor (117) and a waste worm (118) are provided that carry excess material not used during moulding back to the raw material stock compartment (106). Roller wheel (119) and die (115) assembly moves up and down, and in lowered position roller wheel (119) rests on ground. Diameter of roller wheel (119) is larger than diameter of die (115) to provide gap for ejection of the moulded bricks.

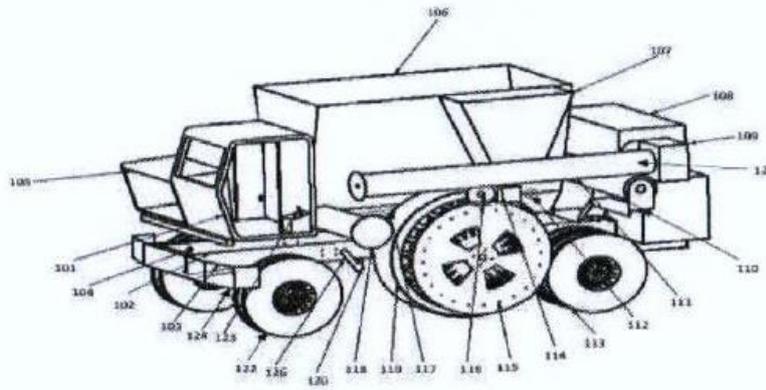


FIG. 2

In relation to patent no. 385845, the abstract adopted by the plaintiffs is as under:



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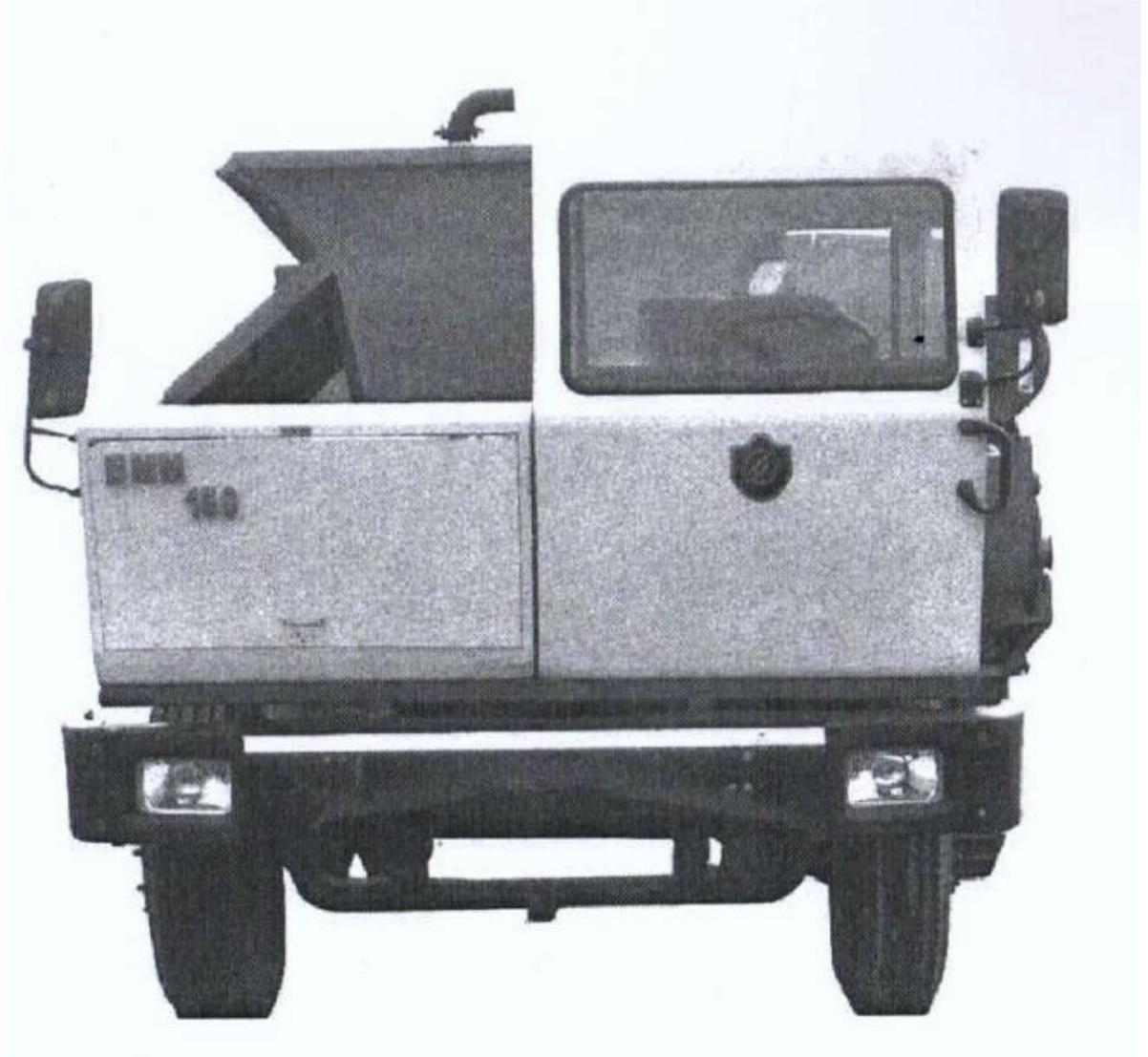
ABSTRACT

BRICK MAKING MACHINE (BMM 150) AND THE PROCESS OF MAKING THE BRICK THEREOF

A mobile brick making machine is disclosed. Raw material stored in a raw material compartment (206) is moved by three worms to a roller wheel (217) and die (214) assembly, which rotates and lays a line of bricks as the machine moves ahead. A waste conveyor and a waste worm (220) are provided that carry excess material not used during moulding back to the raw material stock compartment. Outer face of the moulded brick in the rotating plurality of brick frames (500) is made flat by means of a cutting blade (905) that is moved in radial direction as plurality of brick frames (500) move past cutting blade to scrape excess raw material and generate a flat surface. The cutting blade (905) is moved radially by cutting blade follower (904) following a cam (903) fixed concentric to roller (217) and die (214) assembly for rotation along with die.



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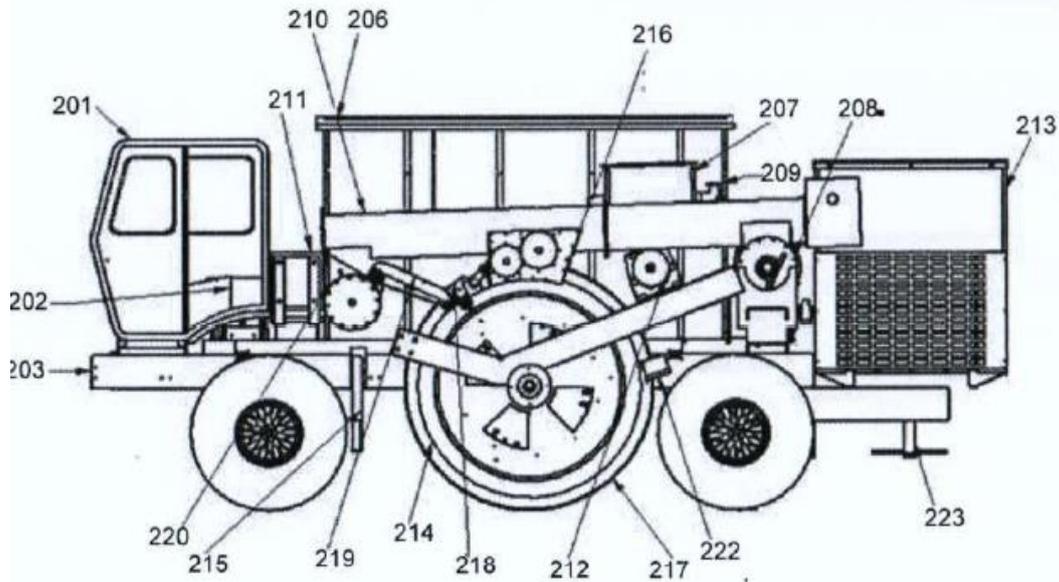


FIG. 2

28. The subsequent patents 353483 and 374814 had further improvements on the original patents as noted above.

29. The claim in the first patent No.359114 adopted by the plaintiffs was as under:

**I Claim:**

1. A mobile brick-making machine comprising:
 - a chassis (102) to support various parts and aggregates of the machine;
 - a cabin (101) for an operator of the machine to sit and operate the machine, the cabin having various controls for the operator to drive the machine and control brick making operation;
 - a pair of steered front wheels (122) and a pair of non-steered rear wheels (113) mounted on the chassis (102) through their respective axles (304, 303), one of the pair of the front wheels (122) and the pair of rear wheels (113) driven by a moving motor (121);
 - a raw material stock compartment (106) to hold raw material for making bricks;
 - a roller and die assembly comprising:
 - a roller wheel (119); and
 - a die (115) made up of a plurality of circumferentially arranged brick frames (502), the plurality of circumferentially arranged brick frames concentrically fixed to the roller wheel (119);
 - wherein the roller and die assembly is configured to rotate as the mobile brick-making machine moves ahead; and wherein the plurality of brick frames (502) receive the raw material from the raw material stock (106), mould the bricks and lay them on ground as the machine moves ahead, thereby laying a line of moulded bricks on ground.
2. The mobile brick-making machine as claimed in claim 1, wherein the roller wheel (119) and die assembly (115) is configured for upward and downward movement relative to the chassis (102), wherein in a lowered position the roller (119) rests on ground.
3. The mobile brick-making machine as claimed in claim 2, wherein diameter of the roller wheel (D_r) is larger than diameter of the die (D_d) to keep the brick frames at level higher than the ground when the roller wheel (119) is lowered to the ground, and wherein the brick frames (502) being at level higher than ground enables ejection of the moulded bricks to the ground.
4. The mobile brick-making machine as claimed in claim 1, wherein each of the plurality of brick frames (502) includes a piston (503) configured to eject moulded brick from the brick frame when the brick frame reaches lowest point during rotation of the roller (119).



5. The mobile brick-making machine as claimed in claim 4, wherein the pistons (503) are driven by a fixed cam (602), wherein the cam pushes the pistons (503) through respective rollers (119) fixed to the pistons as the brick frame (502) rotates along with the roller wheel relative to the fixed cam, to move the corresponding piston (503) to eject the moulded brick out of the brick frame.
6. The mobile brick-making machine as claimed in claim 1, wherein the machine further comprises an arrangement to distribute sand on die frames (502) before the die (115) is filled with raw material over the die frame before filling the raw material on the die frame, wherein the sand is stored in a sand stock compartment (107).
7. The mobile brick making machine as claimed in claim 2, wherein the machine includes a hydraulic power pack (104) to meet hydraulic oil requirement of two hydraulic cylinders; the two hydraulic cylinders comprising a hydraulic lift cylinder (120) used to lower and raise the roller (119) and die assembly (115), and other hydraulic cylinder used to steer the front wheels (122).

Submissions on behalf of the defendant

30. Aside from the written submissions of the defendant, the following points were argued:

- i. *This Court lacks territorial jurisdiction* – Present issue was pressed on the basis that defendant had no business in Delhi; that he resided in Haridwar and where he also had his sole proprietorship firm working for gain. Defendant claimed to have absolutely no business in Delhi and further denied having sold any product within the territorial jurisdiction of this Court. The solitary offer for sale to one Mr. Sumit Dhariwal cited by plaintiffs was supposedly a trap sale arranged by plaintiffs themselves; that said person was never the defendant's customer. It was further averred that listing on *Indiamart* website could not lead to a transaction merely provided information about defendant's product.



- ii. Failure to establish a prima facie case* – It was contended that neither balance of convenience lied in favour of plaintiffs nor any irreparable injury since all aspects would be subject matter of trial, particularly since defendant has been conducting research work since 2002 and selling his machine from 2021. To this effect, counsel for defendant pointed out to *YouTube* videos which were uploaded by defendant since 2020.
- iii. Doctrine of equivalents not applicable:* Counsel for defendant addressed the issue of equivalents and non-applicability thereof in the following manner:
- a. Doctrine of Equivalents was not pleaded by plaintiffs;
 - b. On the argument of demurrer, reliance was placed on *LA Roche (supra)*, in turn on *Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries*, (1979) 2 SCC 511, and in turn on *Arnold v. Bradbury*, (1871) 6 Ch A 706 to contend that claims plus specifications have to be taken into consideration;
 - c. Plaintiffs, in their submissions, only showed part of the claims while five other elements were ignored, claiming it as non-essential;
 - d. Defendant submits that the composite claim has to be considered and is determinative;
 - e. Kinetic energy is not used by plaintiffs' machines but electrical energy is used – Defendant states that they used kinetic energy from the tractor;



- f. Plaintiff is estopped from pleading equivalence on account of prosecution history on account that they cannot take a position, at this stage of suit for infringement, contrary to the position taken by them before Patent Officer;
- iv. Function-Way-Result Test ('FWR test'): It was contended that, without prejudice, doctrine of equivalents for mechanical devices requires plaintiffs to satisfy the triple test i.e. FWR test. Essentially, it ought to be proved that the substituted claim element must perform substantially the same function in substantially the same way to achieve substantially the same result. In such a case, onus to prove the same is on plaintiffs. However, it is contended that in the present case, plaintiffs have merely showed that it is substantially the same result for pleading infringement whereas not only the cabin is absent but also the chassis and control of assembly from the cabin does not exist in the defendant's machine.
- v. All elements rule: Defendant pleads the 'all elements rule' whereby the product must contain every element of claim of the suit patent and if even a single element is missing from the allegedly infringing product, it would not amount to infringement. This is the traditionally followed test across jurisdictions. It was further contended that the doctrine of equivalents does not take away from the *all elements rule*. For this purpose, it was averred that a claim element expressly mentioned is presumed essential for the purpose of determining infringement even under doctrine of equivalents. Plaintiffs have alleged infringement of four different patents in their plaint, however, failure to provide claim mapping of said four patents would render giving up infringement plea



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qua IN 385485 and IN 374814 at the time of institution of the present suit.

- vi. Contributory infringement:* Defendant pleaded contributory infringement which is not in Indian statute; this is in context that the defendant was making a static machine and the farmer was using his tractor to make it mobile. Thus, *arguendo*, if there were any infringement, two parties were potentially infringing the patent.
- vii. Delay and laches:* It was pointed out that plaintiffs sent a legal notice on 11th April, 2022; thereafter, there was a gap of almost 14 months before present suit was instituted. Plaintiffs had started their commercial production in the year 2021 and were aware of defendant's efforts in developing said brick making machine prior thereto. Thus, plaintiffs cannot seek any relief in equity as they allegedly manoeuvred provisions of law i.e. institution of pre-litigation mediation to make out an urgent case of interim relief.

Rejoinder Submissions on behalf of plaintiff

31. Counsel for the plaintiffs presented the following submissions in rejoinder:

- a)** On territorial jurisdiction it was contended that it has to be based on a cumulative analysis of materials on record. The defendant issued a quotation letter to Mr. Dhariwal (for the plaintiffs) upon offer of a transaction. Defendant itself stated that they did so on the belief that Mr. Dhariwal was carrying on business in the name of VJR Machines. It was, therefore, evident that defendant was carrying on business in



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the territorial jurisdiction of this Court and intending to make a complete commercial transaction. Further, the defendant's listings of the impugned machine were on *Indiamart* which is interactive in nature and consumer can initiate and conclude a commercial transaction on the website itself.

- b) The arguments of defendant that the doctrine of equivalents was not applicable, was vehemently refuted by plaintiff's counsel. Reliance was placed on *FMC Corporation & Ors. v. Natco Pharma Ltd.* (2022) SCC OnLine Del 4247.
- c) Defendant had only made minor changes in the machine which substantially performed the same function, in the same way, to yield the same result. These minor changes were mainly on the issue of mobility, where the defendant claimed he was selling a stationery machine and it is the user (farmer) which makes it mobile using the tractor. However, the defendant's machine performed absolutely no function while it was stationery and also included wheels to ensure mobility. Reliance was placed on defendant's own demonstrations to show that the machine was mobile. **Secondly**, it was claimed that the cabin, control from cabin and chassis was not part of the defendant's impugned machine. However, what the defendant had effectively done was to replace the cabin, chassis and control with the tractor achieving exactly the same result by performing exactly the same function. As regards the chassis, the defendant's impugned machine was obviously configured on base supporting various parts on aggregate of the machine. Defendant also does not claim lack of existence of the chassis (which is effectively a steel frame). **Thirdly**, defendant claimed that the timer was an electronic device which was



not correct. A timer in a brick laying machine is a mechanical device having a profile which enabled laying of bricks at specific intervals, which is the same feature as defendant's impugned machine. **Fourthly**, the star shaped frame was effectively a spoke configuration which was also in the defendant's machine. **Fifthly**, that the plaintiffs' machine used electric energy rather than kinetic energy as was used in defendant's machine, was not a stand in the written statement.

- d) Defendant had only vaguely mentioned the differences in the pleadings and were contrary to the videos uploaded by it.
- e) Defendant's stand that claims in specifications should be read together and all the elements of the claim should be met, is untenable. Relying on patent jurisprudence, it was contended that the specification is supposed to enable a '*person skilled in the art*' to replicate the invention once it comes into public domain, however, the claims are the basis of the protection. Reliance was placed on *Novartis AG & Ors. v. Natco Pharma Limited*, (2021) SCC OnLine Del 4849 of this Court to point out that claims have to be read as ordinary English sentences and patent assessment cannot be diluted or cut down by reference to rest of the specifications.
- f) Defendant had mis-read the specifications of the plaintiffs' machine and constructive reading would show that it is through mobility that plaintiffs' machine is able to make 100 bricks a minute.
- g) It was reiterated that doctrine of equivalents was made out in the case since the comparison of the different elements of both the machines was glaring. Moreover, the pith and marrow of the patent had to be seen for the purposes of patent infringement. Reliance was placed on *Sotefin SA v. Indraprastha Cancer Society & Research Center &*



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Ors., 2022 SCC OnLine Del 516 and *Rxprism Health Systems Private Limited and another v Canva Pty Limited and Ors.*, 2023 SCC OnLine Del 4186.

- h) On estoppel adverting to prosecution history, plaintiffs' counsel stated that there was no inconsistency with what was stated before the Patent Office and what was being claimed.
- i) It was submitted that no counter claim for revocation had been filed by the defendant also the defendant had failed to site any prior art that was similar to plaintiff's mobile brick making machine. Defendant had not filed any certified document from a financial expert or Chartered Accountant; the original invoices had not been put on record and even the invoices filed by the defendant did not show a particular configuration of the brick laying machine.
- j) In any event, delay in taking action is not sufficient to defeat grant of injunction and in that regard, an application under Section 12A, Commercial Courts Act, 2015 ("*CC Act*") was also decided by this Court.

Analysis

Establishment of a prima facie case

32. As regards establishment of *prima facie* case of infringement, reliance has been placed on the following judgments, the relevant portions of which are extracted below for ease of reference:

- i. Sotefin SA v. Indraprastha Cancer Society & Research Center & Ors.*, 2022 SCC OnLine Del 516

“18. Infringement is to be adjudged objectively and defendant's intention may not be a material criterion to determine this question. However, intent to infringe can



be a relevant and significant factor for the purpose of deciding the relief of injunction to restrain infringement. In this light, facts of the case become pertinent. Plaintiffs stand as set out in the plaint has already been taken note of in the preceding paragraphs and need not be recounted. The defendants obviously controvert the allegations and no doubt adjudication thereof would require evidence. However, at this juncture, a prima facie view can be taken on the basis of the pleadings before the court.

...

“29. However, the emphasis must be on mapping of “essential elements”. Thus, the crux of the matter lies in the answer to the question as to whether the two elements viz. hinging and immobilisation of rear wheels, which are admittedly found missing in the Smart Dollies, are so essential or substantial that their absence would disentitle the plaintiff to an injunction :

Whether the claim specifications are to be seen as a whole, or can the sub-elements be seen individually?”

...

“32. This aforementioned decision is strongly relied upon by Mr Saikrishna to contend that there is no infringement in the instant case, as all elements of Claim 1 are not found in the infringing product. In the opinion of the court, the afore noted legal proposition canvassed by Mr Saikrishna is not entirely correct, although there is some merit in this submission. For patent infringement analysis, comparison of elements of the suit patent's claims is to be done with the elements/claims of the infringing product. On comparison, there can be a case of non-literal infringement, where each and every component of patent specification is not found in the infringing products. In other words, all the elements of a claim may not entirely correspond in the infringing product, as has been pointed by the experts, in the instant case. However, it does not inevitably mean that there can be no infringement. It is the pith and marrow of the invention claimed that is required to be looked into, and we do not have to get lost into the detailed specifications and do a meticulous verbal analysis which the parties have engaged into the court.”



...

*“33. The critical question is whether the elements not found in the Smart Dollies, are essential or not, so as to construe an infringement. For determining the question of infringement, it must be borne in mind that the non-essential or trifling variations or additions in the product would not be germane, so long as the substance of the invention is found to be copied. Pure literal construction is not to be adopted, rather, doctrine of purposive construction should be applied. The court shall also apply doctrine of equivalence to examine if the substituted element in the infringing product does the same work, in substantially the same way, to accomplish substantially the same result. On this aspect, let's first take note of the judicial precedence. In *Raj Parkash v. Mangat Ram Chowdhry* [*Raj Parkash v. Mangat Ram Chowdhry*, 1977 SCC OnLine Del 33 : ILR (1977) 2 Del 412.] a Division Bench of this Court held that a minor variation cannot be treated as a shield from piracy, in the following words :*

*“12. We have, therefore, to read the specifications and the claims from the point of view of the persons in the trade manufacturing film strip viewers. It is the pith and marrow of the invention claimed that has to be looked into and not get bogged down or involved in the detailed specifications and claims made by the parties who claim to be patentee or alleged violaters. (See *Birmingham Sound Reproducers Ltd. v. Collaro Ltd.* [*Birmingham Sound Reproducers Ltd. v. Collaro Ltd.*, 1956 RPC 232] ”*

...

“42. In view of the foregoing discussion, it manifests that the two elements missing in the Smart Dollies do not indicate that the additional features enhance functionality, as asserted by the defendants. The reports indicate identical input/out functions and identical method of operation in Smart Dollies. Thus, prima facie, it manifests



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that this variation is insignificant, and the substance of the suit patent has been copied.”

(emphasis added)

ii. *Rxprism Health Systems Private Limited and another v Canva Pty Limited and others*, 2023 SCC OnLine Del 4186

“62. The plaintiff has also attempted to demonstrate not just the manner in which the defendant’s “Present and Record” feature functions, but also tried to establish identity by showing the manner in which the plaintiff’s product “My Show and Tell” compares with the defendant’s “Present and Record” feature. For the present, however, the court is merely focusing on the defendant’s product feature in comparison with the claims of the patent specification, rather than comparing the two products directly.”

*63. The manner in which infringement is to be assessed has been the subject-matter of several decisions. In *Raj Parkash v. Mangat Ram Chowdhry* [*Raj Parkash v. Mangat Ram Chowdhry*, 1977 SCC OnLine Del 33 : AIR 1978 Del 1], the learned Division Bench of this Court considered the issue in a case where the plaintiff was a producer and marketer of a toy called a “viewer”, which used a 35 mm medially cut positive film to display pictures through a lens. The plaintiff had obtained a patent for this invention. It was alleged that the defendant infringed on their patent by manufacturing and selling similar film strip viewers in the market. The defendant claimed that they were only sellers of film strip viewers, not manufacturers. They also argued that the process used by the defendant to print four pictures on a cine standard frame of 35 mm film, and then cut it into two halves was not an invention but a common knowledge among photographers. The court held that there was infringement of the plaintiff’s patent, and observed as follows:*

“25. The patented article or where there is a process then



the process has to be compared with the infringing article or process to find out whether the patent has been infringed. This is the simplest way and indeed the only sure way to find out whether there is a piracy. This is what was done in the hairpin case, above referred to, and is, indeed, always done. Unessential features in an infringing article or process are of no account. If the infringing goods are made with the same object in view which is attained by the patented article, then a minor variation does not mean that there is no piracy. A person is guilty of infringement if he makes what is in substance the equivalent of the patented article. Some trifling or unessential variation has to be ignored. There is a catena of authority in support of this view.

We need not cite all those cases which were brought to our notice at the Bar. Suffice it to quote the words of Lord Denning, M.R. in *Beecham Group Ltd. v. Bristol Laboratories Ltd.* [*Beecham Group Ltd. v. Bristol Laboratories Ltd.*, (1967) 16 RPC 406] :

'The evidence here shows that in making hetacillin in the United States the defendants use a principal part of the processes which are protected here by the English patents. The importation and sale here is prima facie infringement.

There is a further point. A person is guilty of infringement, if he makes what is in substance the equivalent of the patented article. He cannot get out of it by some trifling or unessential variation.... On the evidence as it stands, there is ground for saying that hetacillin is medically equivalent to ampicillin. As soon as it is put into the human body, it does, after an interval, by delayed action, have the same effect as ampicillin. In these circumstances, I think there is a prima facie case for saying there was an infringement. The process is so similar and the product so equivalent that it is in



substance the same as ampicillin.’

26. We have seen the viewers marked by the defendants and the viewers produced by the plaintiff. The viewers marked and kept on record as (1), (1-A) Mecorama and a fourth viewer are definitely objects produced by piracy of the plaintiff's patent. The defendants have made certain variations in its viewers but these are unessential; and what the defendants market is substantially the same thing, as was conceived by the plaintiff. By trifling variations if the effect obtained by the defendants is the same, and we hold that it is the same, then according to the rule enunciated in the Ampicillin case, referred to above, there is a clear piracy. The idea of the plaintiff which is a novelty is clearly infringed. In any case, the infringement is admitted by Defendants 1 and 2. We have dealt with this matter in detail because Defendant 3 has put in appearance at the last stage but does not admit infringement. Therefore, we hold that there is clear infringement of the plaintiff's patent, which we have delineated above.

66. Therefore, in a patent infringement suit, the broad settled position is—

(a) That the claims have to be construed in a purposive manner. On the basis of the claims of the patent specification the defendant's product is to be compared for assessing infringement;

(b) In the process of comparison, trivial variations would not matter and the court has to assess if the defendant's product is producing the same effect or is “equivalent”, to the invention claimed and disclosed in the patent.

(c) The comparison between the plaintiff's product and the defendant's product can only lend support for the purposes of understanding of the technology and the features of the two products. However, the product v. product comparison shall not be



determinative of infringement. It is the granted claims v. product comparison that is determinative of patent infringement.”

(emphasis added)

iii. FMC Corporation & Ors. V. Natco Pharma Ltd., 2022

SCC OnLine Del 4249

“24. The doctrine of equivalents is applicable where a product or process is not identical to the claim granted in a patent but its essential elements are sufficiently similar to the patented claim, so as to construe the product or process as infringing the patent.

25. In Clark v. Adie, [L.R.] 2 App. Cas. 315, the House of Lords considered an appeal where the plaintiff had claimed that horse clippers or horse clipping machines being manufactured by the defendant had violated a patent that related to “improvement in apparatus for clipping or shearing horses”. The patented invention related to improvement in construction of the apparatus for clipping horses and for shearing and clipping of other animals. The patentee claimed that the use of the patented device had significant advantages in the means of adjusting the cutter to a variety of positions. Several components of the defendant's machine were somewhat similar to those used in the patented device but certain other parts were not. The defendant claimed that there was no infringement, as various parts of clipping machine were already disclosed by the prior art. This was apparent as the patented invention was merely an improvement of known devices. Although the appeal preferred by the patentee



was dismissed, Lord Cairns, in his opinion, had referred to the test of 'pith and marrow' as relevant in cases where the infringer had not copied the entire instrument but had made colourable changes. The relevant extract of the said decision referring to such kind of infringement is set out below:—

“One mode of infringement would be a very simple and clear one; the infringer would take the whole instrument from beginning to end, and would produce a clipper made in every respect like the clipper described in the specifications. About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument described, he might make an instrument which in many respects would resemble it in all its parts. And there the question which would be either for a jury or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. And it might well be, that if the instrument patented consisted of twelve different steps, producing in the result the improved clipper, an infringer who took eight, or nine, or ten of these steps might be held by the tribunal judging of the patent to have taken in substance the pith and marrow of the invention, although there were one, two, three, four, or five steps which he



might not actually have taken and represented on his machine.”

26. *In Beecham Group Ltd. v. Bristol Laboratories Ltd. (supra), Lord Diplock had referred to the decision in the case of Clark v. Adie (supra) and other decisions to explain the import of doctrine of equivalents. The relevant extract of the said decision is set out below:*

“Contemporaneously with the rise of the doctrine of infringing importation there was developing another doctrine known by the phrase adopted by Lord Cairns, L.C. in Clark v. Adie, [L.R.] 2 App. Cas. 315 as that of “pith and marrow”. It first arose in connection with mechanical patents for machines or processes which made use of novel combinations of known mechanical principles. Regarded separately each element or integer in the machine or process might not be new; the novelty and accordingly the invention lay in the particular combination of them. When Clark v. Adie was in the Court of Appeal [L.R.] 10 Ch. App. 667) James, L.J. was able to say: “In fact, every, or almost every, patent is a patent for anew combination”. The doctrine which, in the case of mechanical patents to which it has principally been applied, is also known as the doctrine of “equivalents”, which lucidly stated by Lord Parker, then Parker, J., in Marconi v. British Radio Telegraph and Telephone Co. Ltd., (1911) 28 R.P.C. 181 at 217, where he said: “Where ... the combination or process, besides being itself new, produces new and useful results, everyone



who produces the same results by using the essential parts of the combination or process is an infringer, even though he has, in fact, altered the combination or process by omitting some unessential part or step and substituting another part or step which is equivalent to the part or step that he has omitted.”

The increasing particularity with which the claims are drafted and multiplied in modern specifications may have reduced the scope of application of the doctrine of pith and marrow, but I am unable to accept the argument advanced by Bristol that this has made the doctrine obsolete. It still remains a part of patent law as is acknowledged in speeches delivered in this House as recently as C. Van der Lely N.V. v. Bamfords Ltd., [1963] R.P.C. 61 ; Rodi & Weinenberger A.G. v. Henry Showell Ltd., [1969] R.P.C. 367. Directed as it is against colourable evasion of a patent it is not in my view confined to mechanical inventions or to claims for new combinations of integers, but in appropriate cases, though they may be rare, is applicable to claims for new products.”

27. In Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 US 605 (1950), the Supreme Court of the United States applied the doctrine of equivalents. The following passages from the said judgment, delivered by Justice Jackson, that explain the said doctrine and its applicability, are relevant:

“4. But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a



hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.

5. The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent. Originating almost a century ago in the case of Winans v. Denmead, 15 How. 330, 14 L.Ed. 717, it has been consistently applied by this Court and the lower federal courts, and continues today ready and available for utilization when the proper circumstances for its application arise. 'To temper unsparing logic and prevent an infringer from stealing the benefit of the invention' a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result.' Sanitary Refrigerator Co. v. Winters, 280 US 30 (1929), 42, 50 S.Ct.



9, 13, 74 L.Ed. 147. The theory on which it is founded is that 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape.' *Union Paper-Bag Machine Co. v. Murphy*, 97 US 120 (1877), 125, 24 L.Ed. 935. The doctrine operates not only in favor of the patentee of a pioneer or primary invention, but also for the patentee of a secondary invention consisting of a combination of old ingredients which produce new and useful results, *Imhaeuser v. Buerk*, 101 US 647 (1879), 655, 25 L.Ed. 945, although the area of equivalence may vary under the circumstances. See *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 US 405, 414-415, 28 S.Ct. 748, 749, 52 L.Ed. 1122, and cases cited; *Seymour v. Osborne*, 11 Wall. 516, 556, 20 L.Ed. 33; *Gould v. Rees*, 15 Wall. 187, 192, 21 L.Ed. 39. The wholesome realism of this doctrine is not always applied in favor of a patentee but is sometimes used against him. Thus, where a device is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used to restrict the claim and defeat the patentee's action for infringement. *Westinghouse v. Boyden Power Brake Co.*, 170 US 537 (1898), 568, 18 S.Ct. 707, 722, 42 L.Ed. 1136. In its early development, the doctrine was usually applied in cases involving devices where there was equivalence in mechanical components.



Subsequently, however, the same principles were also applied to compositions, where there was equivalence between chemical ingredients. Today the doctrine is applied to mechanical or chemical equivalents in compositions or devices. See discussions and cases collected in 3 Walker on Patents (Deller's ed. 1937) §§ 489—492; Ellis, Patent Claims (1949) §§ 59—60.

6. What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose and in every respect. In determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes be equivalents. Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform. An important factor is whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was.

7. A finding of equivalence is a determination of fact. Proof can be made in any form : through testimony of experts or others versed in the technology; by documents, including texts and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final



determination requires a balancing of credibility, persuasiveness and weight of evidence. It is to be decided by the trial court and that court's decision, under general principles of appellate review, should not be disturbed unless clearly erroneous. Particularly is this so in a field where so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience.”

28. In Warner-Jenkinson Co., INC v. Hilton Davis Chemical Co. (supra), the Supreme Court of the United States expressed the concern that the doctrine of equivalents, as it had come to be applied since the decision of Graver Tank & Mfg. Co. v. Linde Air Products Co. (supra), has “taken on a life of its own unbounded by patent claims”. The Court also observed that the doctrine of equivalents when applied broadly “conflicts with the definitional and public-notice functions of the statutory claiming requirement.”

29. The Court also observed that in a case where an invention is expressed as a combination of elements, the doctrine of equivalents would refer to equivalency of each element or part of the invention, which is substituted in the allegedly infringing product or process. The relevant extract from the judgment reads as under:

“.....Each element contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a



whole. It is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety.....”

30. The Court also discussed whether equivalents are required to be determined by applying the triple test - the function served by a particular element; the manner in which the function is performed; and the results obtained by the element - or by applying the test whether the differences are substantial. In this context, the Court observed as under:

“All that remains is to address the debate regarding the linguistic framework under which “equivalence” is determined. Both the parties and the Federal Circuit spend considerable time arguing whether the so-called “triple identity” test— focusing on the function served by a particular claim element, the way that element serves that function, and the result thus obtained by that element—is a suitable method for determining equivalence, or whether an “insubstantial differences” approach is better. There seems to be substantial agreement that, while the triple identity test may be suitable for analyzing mechanical devices, it often provides a poor framework for analyzing other products or processes. On the other hand, the insubstantial differences test offers little additional guidance as to what might render any given difference “insubstantial.”

In our view, the particular linguistic framework used is less important than whether the test is probative of the essential inquiry :



Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention? Different linguistic frameworks may be more suitable to different cases, depending on their particular facts. A focus on individual elements and a special vigilance against allowing the concept of equivalence to eliminate completely any such elements should reduce considerably the imprecision of whatever language is used. An analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element.”

31. The doctrine of equivalents has been accepted in the jurisprudence to protect patent rights from being infringed by infringers using colourable method of making some minor, insubstantial variations to escape the reach of the patent. The doctrine of equivalents, in essence, seeks to address infringers who introduce minor variations as subterfuge to defeat patent rights. The doctrine is applied to ascertain whether there is an infringement by excluding any insubstantial, minor or trivial changes that are designed to deprive the patentee of the benefits of his invention.

32. The doctrine of equivalents is applicable only in cases where the variation or difference between the product or process and the patented claim is insignificant, insubstantial and not essential to the patented claim. In order to



determine whether, on the basis of doctrine of equivalents, a product or process infringes the patent, it is essential to determine the essence and scope of the patent. It is important to understand as to what is the invention that is patented. If the invention is infringed by a product or process, the minor differences in the non-essential trappings of the product or process would be irrelevant.

33. This Court is unable to accept the contention that the doctrine of equivalents is only relevant in case of a product patent and not a process patent. If an innovation - whether it is a product or a process - is pirated, an action to prevent such infringement cannot fail solely for the reason that the offending product or the process has certain minor and insubstantial variations or differences as compared to the patent.

34. The triple test - substantially the same function, in substantially the same way and to yield the same result - is applied primarily to products or devices. A device which substantially performs the same function, in substantially the same way, and accomplishes the same result, may infringe the patent rights. However, when it comes to a process or a method, this test may require to be suitably adapted. In a case where a method of achieving a result is the essence of the patent, achieving substantially the same result would clearly not be relevant. The method with which the result is obtained would be material to determining whether the patent has been infringed. The test of substantial identity of the competing methods



must necessarily be viewed by identifying the essential elements and steps of the said process and then examining the manner in which the key elements interact in each essential step that the process/method entails to yield the given result. The essential elements of the given process; the necessary steps of that process; and the manner in which the essential elements interact at each step must be substantially similar to the patented process or method to sustain a claim of infringement. The variations in the competing methods require to be compared to ascertain whether they are minor/trifling and inessential and have been introduced only to camouflage piracy.

(emphasis added)

33. The three decisions of this Court cited by plaintiffs and defendant, of which relevant extracts have been reproduced above, are *Sotefin* (*supra*) a decision of Single Judge of this Court of February, 2022, *FMC Corporation* (*supra*) a decision of Division Bench of December, 2022 and *RxPrism* (*supra*) a decision of Single Judge of July, 2023. All these decisions have extensively relied upon earlier decisions of the Indian Courts as well as Courts of foreign jurisdictions. Our analysis is contoured on the test which needs to be used for assessing a *prima facie* infringement of the suit patent. The following principles can be culled out collectively from the aforementioned decisions, since all of them rely upon the same previous sources while articulating them from different perspectives:

- A) Infringement is to be adjudged objectively and defendant's intention may not be material to determine this question; the emphasis however has to be on mapping of 'essential elements'.



- B) Whether elements which are missing in the defendant's products are so essential or substantial that the absence would entitle the plaintiff to an injunction.
- C) Patent infringement analysis, comparison of elements of the suit patent's claims is to be done with the elements/claims of the infringing products.
- D) There can be a case of *non-literal infringement* where each and every component of patent specification is not found in the infringing products i.e. all elements of a claim may not entirely correspond with the infringing product, but it still can be a case of infringement.
- E) It is the *pith and marrow* of the invention claimed that is required to be looked into. This test had been referred to in *Clark v. Adie*, [LR] 2 App Cas 315 [House of Lords].
- F) Non-essential or trifling variations or additions in the product would not be germane, so long as substance of the invention is found to be copied.
- G) Pure literal construction is not to be adopted, *rather doctrine of purposive construction* should be applied.
- H) *Doctrine of equivalents* is to be examined and applied if the substituted element in the infringing product does the same work, in substantially the same way, to accomplish substantially the same result. The source of this doctrine traces its origin to an old decision in *Winans v. Denmead*, 15 How. 330, 14 L.Ed. 717 which was cited with approval in *Graver Tank and Manufacturing Co. v. Linde Air Products Co.*, 339 US 605 (1950) (Supreme Court of United States).
- I) The essential feature in an infringing article or process are of no account. If the infringing goods are made with the same object in view,



which is attained by the patented product, then a minor variation does not mean that there is no piracy. Some trifling or unessential variation has to be ignored. This principle was cited by the Division Bench of this Court in ***Raj Prakash v. Mangat Ram***, ILR (1977) 2 DEL 412.

J) While product versus product comparison shall not to be determinative of infringement as opposed to the granted claim versus product comparison, an essential comparison between the products of the plaintiffs and the defendants may be necessary.

K) The triple identity test is important - focusing on function, way the elements serve the function and the result obtained is suitable for analyzing mechanical device (cited in ***Warner-Jenkinson Co. Inc. v. Hilton Davis Chemical Co.***, 520 US 17 (1997) (Supreme Court of United States)).

34. It is quite evident from these assessments that the '*all elements rule*' has since to be used in a qualified manner. On an overall forensic assessment of these principles, it is quite clear that the doctrine of equivalents is alive and applicable and inclusive of the triple identity test. The essence of the doctrine is that one may not practice a fraud on the patent and an infringer should not be able to get away by merely arguing that some elements of the plaintiff's products are not present in that of the defendant. If so accepted, it would be very easy for any infringer to deploy minor variations in a product which employs multifarious elements and argue that it does not infringe, even though it performs the same function in substantially the same way to obtain the same result.

35. In this regard it has to be seen that the primary objective and mission



of the infringer is to produce a product which competes with product of the plaintiff in the market, therefore, the FWR or the triple identity test becomes so critical. Ultimately, in patents jurisprudence, the essential idea of applying for a patent and being granted so is the commercial exploitation of the patent. If a patentee's product is ambushed by an infringer's product albeit with minor variation(s), it defeats the very purpose of the patent. Therefore, the pith and marrow test ought to be used alongside the triple identity test in establishing a possible infringement. In this regard the following statement from **Graver Tank** (*supra*) stands out: “outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form; it would deprive him of the benefit of invention and would foster concealment rather than disclosure of invention, which is one of the primary purposes of patent system”.

(emphasis added)

36. Essentially on an analysis of the precedents in this regard, it clearly seems that various aspects which need to be considered for potentially infringing patent claims are:

- a) *Claims have to be construed in a particular manner and not merely literal;*
- b) *Trivial variations may not itself be relevant;*
- c) *Assessment has to be made whether alleged infringing product is producing the same equivalent effect as that of suit patent;*
- d) *A product versus product comparison cannot be determinative of infringement but of claims versus product comparison;*
- e) *The pith and marrow of invention is to be looked at;*
- f) *Detailed specification and analysis may not be necessary;*



g) It has to be seen whether the infringing product does the same work, in substantially the same way, to accomplish substantially the same result.

37. From the claims it is apparent that the patents in question have the following relevant features:

- a) It was a mobile brick making machine;*
- b) It comprised of a chassis to support various parts and aggregates of the machine;*
- c) It has a cabin for operator to sit and operate the machine and controls;*
- d) It has pair of steered front wheels and non-steered rear wheels mounted on the chassis;*
- e) It has a raw material stock compartment to hold the raw material for making bricks;*
- f) It has roller and die-assembly comprising of roller wheel and a die made of a plurality of circumferentially arranged brick frames;*
- g) The roller and die assembly is configured to rotate as the machine moves ahead;*
- h) The motion of the machine with plurality of circumferentially arranged brick frames receives the raw material, mould the bricks and lay them on the ground in an organized line of bricks.*

38. From what has been stated by the defendant and is evident from the photographs of the defendant's machine, is that it was also a mobile brick laying machine with a raw material stock compartment, roller and die-assembly and a plurality of circumferentially arranged brick frames fixed on the roller wheel which would perform the same function of receiving the raw



material, moulding the bricks and laying them on ground in an organized line of bricks. This whole assembly was admittedly mounted on a frame with a pair of wheels. This aggregate of machine was put on to a tractor by the user and by using the kinetic energy of the movement, the assembly operated and lay bricks on the ground.

39. The issues on which defendant claimed difference was:

- a) *Lack of a cabin which was integrated to the assembly and used as an operating and controlling place;*
- b) *No steering;*
- c) *No steered front wheels;*
- d) *Rear wheels not driven by motor.*

40. At first blush, it would seem that these are differences which would secure the defendant from an infringement action; however, if one looks closely at the differences cited, all the four differences are really parts of the same fundamental issue, i.e., *the mobility and the mechanism to ensure mobility of the assembly*. The plaintiffs' invention had an integrated cabin which would make the assembly mobile whereas defendant's machine required to be hooked up to a tractor or any mobile vehicle. All aspects such as cabin, steering, steered front wheels and the operation of the rare wheels was all completely relatable to the issue of mobility of the assembly.

41. For appreciating the dispute, it is important to assess as to what really is the invention and pith and marrow of the invention. The pith and marrow of the invention is really the assembly which ensures brick making through mobility. It is not the defendant's case that the brick making machine was a stationery brick making machine and did not require mobility at all. In fact,



the defendant's machine necessarily required to be hooked up to a mobile automative vehicle in order to ensure its operation. The fundamental aspect of these machines was of ensuring that the system of brick making was integrated on to one frame /chassis right from the hopper containing the raw material for bricks to the feeder into the roller and die assembly and then through the circumferential motion the ejection of the moulded brick on the ground. Without mobility defendant's machine would serve no purpose considering it had a roller and die mechanism as well.

42. All elements of the hopper, feeder, roller and die assembly, mould and ejection were similar in both the plaintiffs' and the defendant's machine. The only difference was that the defendant had severed the aspect of mobility and left it to the user for using their own automative vehicle whereas the plaintiffs had integrated the mobility with the machine itself.

43. The innovativeness was clearly in ensuring continuous brick laying in an organised sequence over an expanse of a field or a road. This could only be done with mobility of a brick laying assembly. Therefore, the assertion that there were fundamental changes in the defendant's machine would possibly not be correct and difficult to countenance.

44. Reliance of the defendant on '*all elements rule*' would therefore, not be correct, at least for the purposes of interim injunction and establishment of a *prima facie* case by the plaintiffs. The all-elements rule cannot be adopted to the exclusion of the pith and marrow rule. Here, as we have observed, that the essential part of the patent was brick making assembly, the variation between plaintiffs' product and defendant's product, was not essential as long as mobility was provided to the brick laying assembly.



Moreover, using the triple test of ‘*Function-Way-Result*’ it would further buttress the claim of the plaintiff in that the substituted element performed substantially the same function in substantially the same way to achieve substantially the same result.

45. On the issue of territorial jurisdiction, this Court is of the opinion that the objection of the defendant is not made out, particularly at this stage when the trial is still to progress. The plaintiff has placed evidence of the defendant attempting to conclude a transaction in Delhi and that the said defendant’s machine was available for sale in the jurisdiction of this Court. The objection of the defendant that it was a trap purchase and it was approached by a decoy client of the plaintiffs, will not take away from the fact that quotation letter dated 3rd April, 2023 was received with price listings. Moreover, the plaintiffs have also filed brochure posted by the defendant that they were involved with the manufacturing and selling of the machines and listings on **Indiamart** where defendant’s business was also listed and was accessible in Delhi. It would be difficult at this stage, without further evidence being led, that the defendant had not purposely availed of the jurisdiction in Delhi for concluding a sale.

46. On the issue of estoppel, reference has been made to the response to the examination report dated 7th January, 2020 on the patent application No.543/DEL/2014, in referent to the prior arts D1-D3 which has been cited by the examiner. In its response, the focus of the plaintiffs is on the mobility of the brick making machine and integration into a mobile vehicle of the brick laying assembly. The plaintiffs have not pleaded anything different before this Court to be estopped from doing so. Plaintiffs’ claim here, in order to



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establish a *prima facie* case, is based on the doctrine of equivalents and in particular the patent substance test.

47. As regards delay and laches, it may not been an issue in the present case. It is noted that plaintiff came to know about defendant's allegedly infringing activities for the first time in April, 2022, pursuant to issuance of the Cease & Desist letter by plaintiffs to the defendant on 11th April, 2022, no reply was received. In this light, plaintiff conducted a market survey whereafter, no allegedly infringing machines were found by them. Only after the plaintiff's client was approached by the defendant in April, 2023 did the plaintiffs approach this Court.

48. In this regard, it was stated that the cause of action arose in the first week of April 2023 when plaintiffs' clients were approached by the defendant for supplying his impugned brick making machines. Cause of action to institute the present suit first arose in April, 2022 when the plaintiffs became aware of the fact that the Defendant is manufacturing and selling the impugned brick making machines. Cause of action further arose on 11th April, 2022 when the plaintiffs issued a Cease & Desist letter to defendant.

49. Contention of the defendant regarding Section 12A, CC Act has already been decided in disposal of *I.A. 11495/2023* moved by plaintiffs *vide* order of this dated 3rd July, 2023.

50. As regards the reference to the Angora Cat Principle cited with approval in *European Central Bank v. Documents Security Systems Incorporated* [2008] EWCA Civ 192 (Supreme Court of England), decision dated 19th March, 2008 to contend that the patentee in defence, i.e., its patent



to argue infringement states that its patent is expansive. However, this principle may not have immediate relevance considering it was metaphorical formulation persuading that infringement and validity cases ought to be tried together. This argument was made in the context of conventional prosecution history estoppel by defendant's counsel to contend that plaintiffs, in response to examiner's report, contended that only roller and die assembly matters whereas now the integrated mobility is also being argued.

51. In view of the foregoing, this Court finds that plaintiffs have made out a *prima facie* case of infringement. Balance of convenience lies in favour of the plaintiffs and irreparable injury would be caused if the injunction, as prayed for, is not granted. Accordingly, an interim injunction during the pendency of present suit is granted in favour of plaintiffs and against the defendant in the following terms:

- A.** Defendant and all those acting on his behalf are restrained from using, making, manufacturing, offering for sale or selling or importing for those purposes the impugned brick making machine or otherwise infringing the plaintiffs' patent nos., being – **353483, 359114, 374814, 385845** and/or any product similar thereto in any manner whatsoever without consent, permission, or authorised license from plaintiffs.
- B.** Defendant and all those acting on his behalf are restrained from infringing plaintiffs' copyright in literature/ detail/ specification/ artistic features/ information/ get-up/ layout/ arrangement or any other literature or specification which is a substantial reproduction of plaintiffs' literature/ detail/ specification/ artistic features/ information/ get-up/ layout/ arrangement pertaining to plaintiffs' brick making machine or of the drawings of plaintiffs' patented brick



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making machines, in any manner whatsoever.

52. Application is allowed and disposed of in the above terms.
53. Judgment be uploaded on the website of this Court.

ANISH DAYAL
JUDGE

MARCH 05, 2024/sm/sc