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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Order reserved on	15.11.2024
Order pronounced on	03.04.2025

CORAM:

THE HON'BLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

(T) OP(PT) No.60 of 2023
(ORA/2/2021/PT/CH)

M/s.STEEL STRIPS WHEELS LIMITED,
 Village Somalheri/Lehi, P.O.Dappar,
 Tehsil Derabassi, Distt.
 Mohali-140506, Punjab.

... Petitioner

v.

1. WHEELS INDIA LIMITED
 Padi, Chennai-600 050, India

Address for service in India:

Senthil Kumar N INTEPAT IP SERVICES Pvt. Ltd
 176 Indra Complex, Sarakki Main Road, JP Nagar,
 Ist Phar Bangalore 560 078.

2. The DEPUTY CONTROLLER OF PATENTS & DESIGNS
 Patent Office Intellectual Property Building
 GST Road, Guindy, Chennai-600 032
 India

... Respondents



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PRAYER: This Transfer Original Petition (Patents) filed under Sections 64 of the Patents Act, 1970, praying to (a) Revocation of the Patent No.269220 *in-toto*, granted on October 12, 2015 in respect of Indian Patent Application No.2492/CHE/2007 under section 64 of the Patents Act, 1970; (b) Leave to file further evidence; and (c) Award cost to the Petitioner.

For Appellant : Mr.Adarsh Ramanujan
Mr. Tarun Khurana & Ms.R.Hemavathi
for M/s.Khurana and Khurana

For Respondents : Mr.T.K.Bhaskar
Mr.P.Aravind
Ms.Pranaya Dayalu for R1
Mr.M.Karthikeyan, SPC for R2

ORDER

Background

The first respondent was granted Patent No.269220 (the Patent) on 12.10.2015 by allowing application No.2492/CHE/2007, which was filed on 01.11.2007. The grant was in respect of the invention titled “Vehicle Wheels Having Non-Constant Thickness Rims”.



WEB COPY 2. By this petition, the petitioner seeks revocation of the Patent under Section 64 of the Patents Act, 1970 (the Patents Act). In the petition, the petitioner has raised four grounds of revocation. These grounds are that the invention lacks novelty; the invention does not involve either a technical advance or involve any inventive step; the complete specification does not sufficiently and fairly describe the invention and the method by which is to be performed; and that the scope of the claims of the complete specification are not sufficiently defined or such claims are not fairly based on matters disclosed in the specification.

3. The assertions in the petition were refuted in the counter statement of the first respondent. The first respondent asserted that the claims satisfied the test of novelty because none of the cited prior arts contain the whole of the invention. The first respondent also contended that there are marked differences between the claims in



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the invention and the disclosures made in the three cited prior arts (D1 to D3). The first respondent also stated that a person skilled in the art (PSITA) would not arrive at the claimed invention on the basis of disclosures made in D1 to D3. The averments with regard to lack of clarity were denied by stating that claim 1 clearly describes the location of the cylindrical section as being between the inner transition section and inner bead seat. As regards claims 8 and 11, the contention that these claims lack clarity in respect of location of the cylindrical section was denied by stating that the cylindrical section in these claims is between the outer flange and the outer bead seat of the rim as per Figure 5 of the claims and page 11 of the specification.

4. Based on the pleadings, this Court framed the following issues:

(i) Whether the Petitioner is a 'person interested' in terms of Section 64 of the Patents Act.



WEB COPY (ii) *Whether the invention under Indian patent No. IN 269220 lacks novelty?*

(iii) *Whether the invention under Indian Patent No. IN 269220 is obvious and/or does not involve an inventive step?*

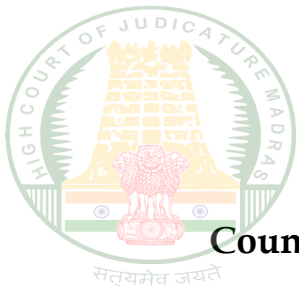
(iv) *Whether the complete specification of Patent IN 269220 does not sufficiently and fairly describe the invention and the methods by which such invention is to be performed?*

(v) *Whether the scope of any claim of the complete specification of Patent IN 269220 is not sufficiently and clearly defined or whether any claim of the complete specification is not based on matters disclosed in the specification?*

(vi) *Whether Indian Patent IN 269220 is liable to be revoked as per Section 64 of the Patents Act, 1970?*

(vii) *Whether the petitioner is entitled to the relief claimed?*

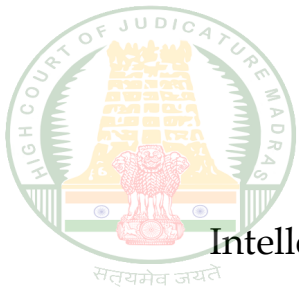
(viii) *Whether the parties are entitled to any other relief?*



Counsel and their contentions

WEB COPY 5. Oral arguments on behalf of the petitioner were advanced by Mr.Adarsh Ramanujan, learned counsel, assisted by Mr.Tarun Khurana. Oral arguments on behalf of the respondent were advanced by Mr.T.K.Bhaskar. Mr.M.Karthikeyan, learned SPC, appeared on behalf of the second respondent. Both the petitioner and the first respondent filed written submissions.

6. The first contention of learned counsel for the petitioner was that the petitioner qualifies as a “person interested” in terms of Section 64 of the Patents Act. By referring to the judgment of the Supreme Court in *Aloys Wobben and another v. Yogesh Mehra and Ors.* ('*Aloys Wobben*'), [2014] 15 SCC 360, particularly paragraph 21 thereof read with Section 2(1)(t) of the Patents Act, he submits that the expression 'person interested' is defined inclusively so as to even include those involved in research in the relevant filed. He also placed reliance on paragraphs 6 and 10 of the judgment of the



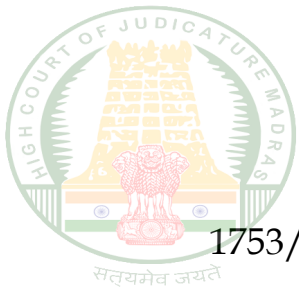
Intellectual Property Appellate Board in *Sankalp Rehabilitation Trust*

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v. F. Hoffmann-la Roche AG and another(' Sankalp Rehabilitation'), 2012

SCC OnLine IPAB 167. By pointing out that even the narrower expression “person aggrieved” was construed liberally in *Hardie Trading Limited and another v. Addisons Paint and Chemicals Ltd.('Hardie Trading')(2003) 11 SCC 92*, learned counsel contended that the expression “person interested”, which is undoubtedly wider in ambit, should receive a wide construction.

7. As regards the petitioner, he submitted that the petitioner is carrying on the business of designing and manufacturing automotive wheels. After further submitting that this is self evident from the name of the petitioner, he also pointed out that the petitioner is active in research and development in this sector and was granted several patents such as IN 258809, EP 327565 and BRP 110046622-4. Apart from the granted patents, he submitted that Patent Application Nos.1653/DL/2012, 1654/DL/2012,



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1753/DL/2010 and 2457/DL/2009 are pending. In view of the aforesaid, learned counsel concluded his submissions on this issue by submitting that the petitioner certainly qualifies as a “person interested” for the purpose of prosecuting the petition under Section 64 of the Patents Act.

8. Before referring to the grounds of revocation, learned counsel provided an overview of the nature of the Patent. After stating that the invention relates to the design of the profile of the rim, he submitted that rims and discs are known components of wheels. In fact, he submitted that it is part of common general knowledge that the disc is attached to the rim. In this connection, he referred to the standardization of configuration of the rim profile by way of the European Tire and Rim Technical Organization (ETRTO) standard. After pointing out that the impugned Patent claims to resolve the problem of fatigue failure due to cyclical stresses, he submitted that the impugned Patent comprises 17 claims. Of these claims, he stated



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that claims 1 to 8 are independent product claims and claims 9, 11 and 13 are independent process claims.

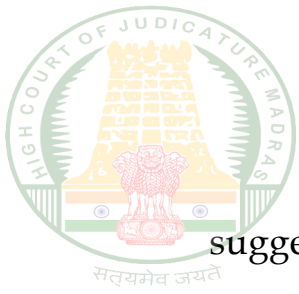
9. With this background, learned counsel proceeded to deal with issue No.5, which pertains to whether the scope of any claim of the complete specification of the Patent is not sufficiently and clearly defined or whether any claim of the complete specification is not based on matters disclosed in the application. His first contention on this issue is that the claims suffer from lack of clarity with regard to the location of the cylindrical section. By relying on the judgment in *Nautilus Inc. v. Biosig Instruments Inc.* ('*Nautilus*'), 572 US 898 at page 12, he submitted that the claim in a patent application would be construed as lacking in clarity, especially if it lacks clarity in relation to an essential feature. Because the monopoly claim of the first respondent is in relation to the thickness of the cylindrical section relative to other sections, such as the inner transition section, the outer transition section and the centre well section, he contended



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that the location of the cylindrical section is an essential feature of the monopoly claim.

10. By starting with claim 8, learned counsel submitted that the first respondent relied on the reference numeral 520 to identify the location of the cylindrical section. By referring to the judgment in *Lufthansa Technik AG v. Astronics Advanced Electronic Systems and two others* ('*Lufthansa Technik*'),[2022] EWCA Civ 20, particularly paragraph 37 thereof, he submitted that claim construction cannot be undertaken by relying on the reference numeral. Specifically, he pointed out that it was held in the cited judgment that reference numerals help orient the reader as to how to read the map by holding it up in the right way, but it cannot be used to identify a location on the map. By applying the said principle, if reference numeral 520 were to be disregarded, learned counsel submitted that claim 8 is completely silent on the location of the cylindrical section. Without prejudice, on a demurrer, he submitted that Figure 5



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suggests that reference numeral 520 is at a tri-junction where the disc is attached to the outer bead. According to learned counsel, the tri-junction point is not cylindrical in shape and cannot be construed as the cylindrical section.

11. With regard to claim 1, he submitted that the plain language of the claim suggests that the cylindrical section is located between the inner transition wall and the inner bead. By further submitting that there is no reference in the entire specification, including the figures, as to the existence of multiple cylindrical sections, learned counsel submitted that there is no support for the cylindrical section being located between the inner transition wall and the inner bead. As regards claim 11, he states that the plain language states that the cylindrical section is located between the centre well section and the inner transition section. Once again, he submits that such location is completely unsupported by the specification. He also submitted that the well section is the



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depression on the rim profile and is certainly not cylindrical. In view of the complete lack of clarity and the inherent contradictions between the claims and the complete specification with regard to the location of the cylindrical section, learned counsel submitted that the Patent is liable to be revoked.

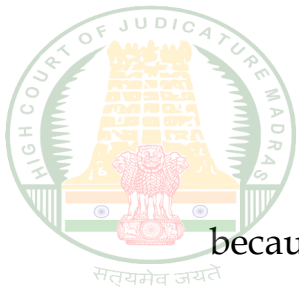
12. With reference to the significance of fair basing, learned counsel relied on *Van Der Lely NV v. Ruston's Engineering Company Limited*, [1985] RPC 461, at pages 8 and 9 of the report, for the proposition that the statutory stipulation of fair basing is intended to ensure that the scope of the claim does not cover prior art. According to learned counsel, fair basing was followed in modern patent law in the UK, as is evident from *Biogen Inc. v. Medeva PLC* ('*Biogen*') [1997] R.P.C. 44 at pages 48, 49 and 50 to 51 and later by the UK Supreme Court in *Regeneron Pharmaceuticals v. Kymab Ltd.* ('*Regeneron*') [2020] UKSC 27, at paragraph 55.



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13. With this backdrop on fair basing, learned counsel turned to claim 13. By referring to the plain language thereof, he submitted that it covers every method for making a wheel having a non-constant rim thickness using the spin forming method and joining the disc thereafter. After pointing out that spin forming is disclosed in prior art and that it is standard to attach the disc to the rim, learned counsel submitted that the only feature that could allegedly differentiate claim 13 is the non-constant rim thickness. While the other claims of the Patent and the complete specification limit the monopoly claim to a rim of a vehicle wheel where the thickness is highest in the cylindrical section relative to the thickness in the transition section and the centre well section, by contrast, he contended that claim 13 is not limited in that fashion.

14. As regards claims 1, 8, 9 and 11, he reiterated that the location of the cylindrical section is not supported by the specification and that even the reference to numeral 520 is misleading



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because it identifies a different location from that disclosed in the above claims.

15. Mr. Adarsh Ramanujan proceeded to address arguments on Issue 4 which relates to whether the complete specification of the Patent fails to sufficiently and fairly describe the invention and the method by which such invention is to be performed. On this issue, he placed reliance on the judgment of the House of Lords in *Kirin-Amgen Inc. and others v. Hoechst Marion Roussel and others* ('*Kirin-Amgen*'), [2004] UKHL 46, at paragraph 126, wherein it was held that in cases of serious ambiguity and where the claim lacks clarity with regard to a central/essential feature, the claim will *ipso facto* fail for lack of sufficiency. Since the claims lack clarity on the location of the cylindrical section, which is an essential feature, he submitted that the claimed invention is liable to be revoked on account of ambiguity. He distinguished the judgment of the Court of appeals in *Anan Kasei Co. Ltd. v. Neo Chemicals and Oxides Ltd Limited and another* [2019]



EWCA Civ 1646 (*Anan Kasei*), paragraphs 22 and 23, in this regard, by

pointing out that the Court of Appeals concluded that some uncertainty at the edges or the fuzzy boundaries of a claim will not automatically invalidate the invention for lack of sufficiency. According to him, the said principle will not apply to the present case because it only applies in situations where the claim uses words of approximation such as 'about', 'approximately' or when ranges are specified in relation to certain parameters.

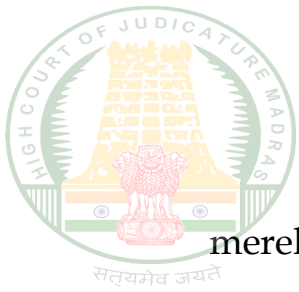
16. As regards issue 2 pertaining to lack of novelty, learned counsel submitted that claims 8 and 13 and claims dependent thereon lack novelty. With regard to claim 8, by comparing the same with prior art D1, learned counsel submitted that prior art D1 shares the same field of technology. He also pointed out that it addresses the same problem of optimizing the weight of the wheel while maintaining the strength thereof. He also pointed out that D1 discloses a wheel with non-constant thickness of the rim, and that



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the thickness is highest in the flange parts relative to the thicknesses of the disc close fitted part, the drop parts, bead seat parts and the side wall parts. According to him, it cannot be said that the impugned patent is novel merely because it uses the expression cylindrical section, which is not found in D1. He also submitted that a comparison of the problem that the impugned Patent and D1 set out to resolve and any differences in such regard cannot be the sole basis to conclude that the impugned Patent is novel.

17. By comparing prior art D3 with claim 13, learned counsel contended that claim 13 is lacking in novelty. In this connection, he submitted that the general presumption is that the steps of a method claim are presumed to be non-sequential. For this proposition, he relied on the judgment in *Interactive Gift Express Inc. v. Compuserve Inc.* 256. F. 3d 1323 (*Interactive Gift Express*) at inner page 8, and pointed out that this presumption is intended to benefit patentees because it prevents an infringer from circumventing the patent by



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merely changing the sequence of steps. As regards the reliance by the first respondent on *Mantech Environmental Corp. v. Hudson Environmental Services Inc. and another*, 152 F.3d 1368, learned counsel submitted that the presumption that a method claim is non-sequential can be rebutted only if the language of the claims itself requires the method to be performed in a specific sequence. According to him, the impugned Patent and, in particular, claim 13, does not contain any disclosure or recital that it is required to be performed in a specific sequence.

18. Revocation for lack of inventive step was dealt with thereafter by learned counsel. On this issue, he submitted that Section 2(1)(ja) of the Patents Act imposes two requirements, namely, technical advance or economic significance and inventive step. After further submitting that both D1 and D3 state that non-uniform thickness is a mechanism to optimize wheel weight while maintaining the strength thereof, he submitted that the underlying



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idea is that thickness should be increased in areas of maximum stress and reduced in areas where stress is less. According to him, there is clear teaching to this effect both in D1 and D3. Consequently, he submitted that the impugned Patent does not disclose any technical advance or economic benefit over D1 and D3.

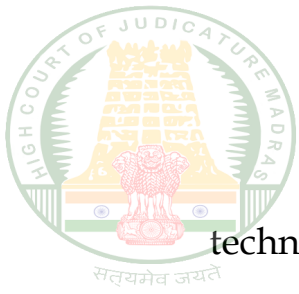
19. According to learned counsel, the above argument also applies to claims 1, 8 and 11. By stating that the PSITA would be a researcher/practitioner in the field of rim making, he submitted that deciding on the areas of the wheel rim, which should be thicker or thinner, on the basis of the stress likely to be imparted to those areas falls within the ordinary course of development of a PSITA equipped with common general knowledge. With regard to this principle, he relied upon the judgment of the Supreme Court in *Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries* [1979] 2 SCC 511 ('*Bishwanath Prasad*') at page 517.



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20. Without prejudice, he submitted that prior arts D2 read with D1 render claim 13 obvious. According to learned counsel, the only difference between claim 13 and D3 is that the disc is joined in claim 13 after formation of the rim, whereas the disc is joined before formation of the rim in D3. Since there are only two realistic options in this regard, learned counsel submitted that it would be obvious to PSITA.

21. Before concluding, learned counsel refuted the contention that the petition is liable to be rejected in view of the lack of expert evidence. By relying on the judgments in *Rockwater v. Technip France SA and another*, [2004] RPC 919 ('*Rockwater*') at paragraph 11 to 13, and *Glaverbel SA v. British Coal Corporation*, [1993] R.P.C. 90, paragraph 6 at internal page 25, he submitted that expert evidence cannot be relied upon for purposes of reaching any conclusion with regard to obviousness. At best, according to him, expert evidence may be used only to assist the Court with regard to background



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technology and scientific concepts or terms. Therefore, in the case at hand, he submitted that expert evidence was unnecessary since the matter boils down to claim construction and an examination of whether there is clarity in the claims and whether the claims are novel or obvious over cited prior arts.

22. In response to these submissions, Mr.T.K.Bhaskar opened his contentions by stating that the first respondent is one of the largest wheel manufacturers in India. At the outset, he submitted that the problem identified and resolved by the invention is dealing with fatigue failures by using a wheel with a rim of non-constant thickness.

23. With this preamble, learned counsel first addressed the issue of whether the petitioner qualifies as a 'person interested' by referring to the pleadings in the petition, counter statement and rejoinder. By referring to the judgment in *Aloys Wobben* and the

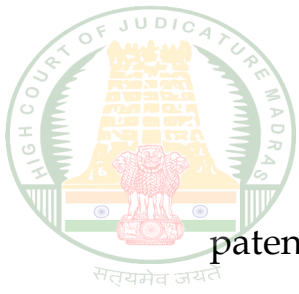


judgment of the Delhi High Court in *Ajay Industrial Corporation v.*

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Shiro Kanao Ibaraki City, AIR 1983 Del 496, he submitted that the expression 'person interested' is broad in amplitude, but is dependent on the facts and circumstances of each case. Therefore, he submitted that the onus was on the petitioner to adduce evidence to establish that it falls within the scope of the expression 'person interested'. Upon denial of the petitioner's assertions in this regard, he submitted that the petitioner was under an obligation to establish that it is a 'person interested' by submitting documents to substantiate such assertions, and that the petitioner failed to do so.

24. On this issue, he also submitted that the principle laid down by the Hon'ble Supreme Court in *Muddasani Venkata Narsaiah v. Muddasani Sarojana*, [2016] 12 SCC 1288 (*Muddasani Narsaiah*), is inapplicable because the first respondent cannot be expected to have any knowledge about the petitioner's asserted involvement in wheel making or the further assertion that the petitioner has obtained



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patents. In those circumstances, he submitted that the first respondent was fully justified in denying the assertion and putting the petitioner to strict proof thereof. By relying on the judgments of the Hon'ble Supreme Court in *Gopal Krishnaji Ketkar v. Mohamed Haji Latif and Ors.* AIR 1968 SC 1413 and *Anil Rishi v Gurbaksh Singh*, AIR 2006 SC 1971, he submitted that pleadings do not qualify as evidence, far less proof.

25. He proceeded to distinguish the judgment in *Sankalp Rehabilitation* and *Hardie Trading* by pointing out that *Sankalp Rehabilitation* related to a life-saving drug and the initiation of proceedings by a non-governmental organization, which had been set up for the benefit of HIV-afflicted persons. Therefore, he concluded his submissions on this issue by stating that the petition is liable to be dismissed at the threshold in view of the petitioner's failure to establish that he is a 'person interested'.



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26. Without prejudice to this contention, he addressed arguments on issue 5 relating to lack of clarity. After pointing out that claims 1, 8, 9, 11 and 13 are independent claims, he first referred to claims 1 and 9. In these claims, he submitted that the thickness of the cylindrical section is greater than the thickness of other sections. He also pointed out that the centre disc is joined to the rim adjacent to the centre well section. If the claim is examined along with Figures 3 and 4, he submitted that the claims are clear and do not suffer from the alleged lack of clarity.

27. As regards claims 8 and 11, he pointed out that the centre disc is joined to the rim adjacent to the cylindrical section. By referring to Figure 5, he submitted that the location of the cylindrical section is evident therein. He also referred to the complete specification and explanation with regard thereto in the second paragraph at page 95 of the typed set filed by the petitioner. As regards claims 11 and 13, he submitted that these are method claims.



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He refuted the contentions of learned counsel for the petitioner with regard to the location of the cylindrical section in claim 8 by pointing out that the invention provides for two configurations, whereby the cylindrical section in claim 8 is at the place where the centre disc joins the rim. By further submitting that Figure 5 corresponds to claim 5, he contended that the location of the cylindrical section would be clear to a PSITA.

28. With regard to the reference numeral 520, learned counsel submitted that the claims and the specification disclose that reference numeral 520 denotes the cylindrical section where the thickness is more than the centre well section, the inner transition section and the outer transition section. As regards claim 13, learned counsel submitted that a bare reading of claims 14 to 17 and the reference numerals would lead to the conclusion that the claim relates to the formation of a rim of varying thickness, as claimed in claims 1, 8, 9 and 11, by spin forming and thereafter joining the centre disc.



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29. Learned counsel proceeded to deal with issue 4 relating to the alleged lack of sufficient disclosure. After pointing out that all the elements and the working of claims 1, 8, 9, 11 and 13 are disclosed in the specification from pages 95 to 100 of the petitioner's typed set, learned counsel submitted that claims 1 and 9 are based on Figures 3 and 4 and the working is disclosed and explained in the specifications at pages 96 to 101 of the petitioner's typed set. As regards claims 8 and 11, he submitted that they are based on Figure 5 and the working is disclosed and explained in the specification in the second paragraph at page 101 of the typed set. Likewise, according to him, claim 13 is based on Figure 2 and the working is disclosed and explained in the specification at pages 99 to 101 of the petitioner's typed set.

30. For reasons aforesaid, learned counsel submitted that the judgments in *Regeneron* and *Biogen* are of no assistance to the



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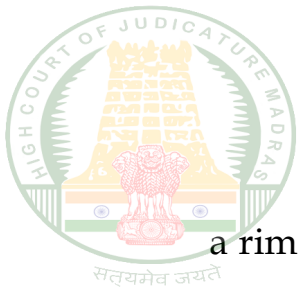
petitioner. In this regard, by relying on the judgment of the House of Lords in *Generics UK Ltd. and others v. H. Lundbeck A/S*, [2009] UKHL 12, particularly paragraph 26 to 28 thereof, learned counsel submitted that *Biogen* dealt with a case where there were a large number of embodiments. By contrast, he submits that the present invention discloses the best method of performing or working the invention. By relying on the judgment of the Court of Appeals in *No-fume Limited v. Frank Pitchford Company Ltd.*, [1935] 52 RPC 231 ('No-Fume') at page 238, learned counsel submitted that precise description is not necessary. By relying on *Anan Kasei*, at paragraphs 22 and 23, learned counsel distinguished *Kirin-Amgen* by contending that it dealt with a case where there was conceptual uncertainty. By further relying on the judgment in *Unwired Plant International Ltd and another v. Google* [2016] EWHC 576 (Pat), learned counsel submitted that *Kirin Amgen* was distinguished in paragraphs 157 to 160 thereof.



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31. As regards the contention that expert evidence is unnecessary, by relying on *Molnlycke AB v. Proctor and Gamble Limited and others* [1994] RPC 49 (*Molnlycke*), learned counsel submitted that the primary evidence in such matters is that of an expert witness as to whether, in such expert's opinion, the relevant step would have been obvious to a PSITA. He also pointed out that the burden of proof is on the petitioner in this regard.

32. With regard to alleged lack of novelty [issue (ii)], by relying on the judgment of the Bombay High Court in *Farberwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & others v. Unichem Laboratories & others* ('*Farberwerke*'), AIR 1969 Bom 255, learned counsel contended that the petitioner can succeed with regard to the objection on the ground of lack of novelty only if it discharges the onus of showing that the prior publication contains the whole of the invention. With this backdrop, by referring to claim 8 vis-a-vis D1, learned counsel submitted that D1 does not teach a wheel comprising



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a rim of non-constant thickness and centre disc attached to the rim as claimed in the present invention. He further submitted that the disc fitting part is not characterized as the thickest in D1, wherein the flange portion is the thickest. Likewise, by comparing D3 and claim 13, he pointed out that the centre portion is first attached to the pre-formed rim in D3. By contrast, he submitted that the centre disc is not attached during wheel formation in the impugned Patent. Therefore, he submitted that the objection on the ground of lack of novelty is untenable.

33. As regards the alleged lack of inventive step (Issue (iii)), learned counsel referred to the judgment of this Court in *Rhodia Operations v. the Assistant Controller of Patents and Designs*, 2024 MHC:449, wherein the steps in obviousness analysis were set out. By comparing D1 with claims 1 and 8, learned counsel pointed out that the problem resolved by D1 is arriving at an optimal balance between weight and strength. By contrast, learned counsel submitted that the



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problem addressed by the impugned invention is to resolve the issue of fatigue failure caused due to cyclical loads. He also pointed out that the thickness in the flange portion is highest in D1, whereas the cylindrical section is of highest thickness in the claimed invention. Consequently, he submitted that D1 does not teach, motivate or suggest a wheel with a rim of non-constant thickness, wherein the disc fitting part is thicker relative to the other parts.

34. By comparing D2 and claim 13, learned counsel submitted that D2 addresses the problem of bead seat eccentricity, which is completely different from the problem addressed by the impugned Patent. As regards claim 13 in comparison to D3, as stated earlier, learned counsel submitted that in D3, the centre disc is attached to the rim pre-form and spin forming is done thereafter. Since spin forming is done in the impugned Patent prior to the attachment of the centre disc to the rim, learned counsel submitted that D3 teaches away from the impugned Patent.



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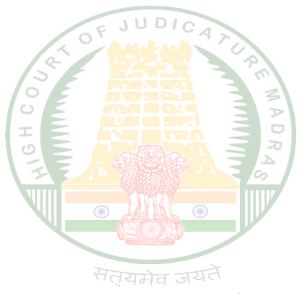
35. Before concluding, learned counsel submitted that the Court is empowered to amend the specification under Section 58 of the Patents Act instead of revoking the patent. For this proposition, learned counsel referred to and relied upon several judgments including the judgment of this Court in *Galatea v. The Controller of Patents and another*, ('Galatea') 2024:MHC:1802 and the judgment of the Division Bench of the Delhi High Court in *Sukesh Behl v. Koninklijke Philips Electronics*, ('Sukesh') 2015 (61) PTC 183 (Del).

Discussion, Analysis and Conclusion:

Issue (i):

36. The first issue that falls for consideration is whether the petitioner qualifies as a 'person interested'. The expression 'person interested' is defined in Section 2(1)(t) of the Patents Act as follows:

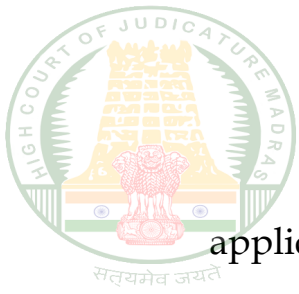
“(t) 'person interested' includes a person engaged in, or in promoting, research in the same



field as that to which the invention relates.”

The above definition discloses that the expression has been defined inclusively and not exhaustively. In *Aloys Wobben*, the Supreme Court concluded that the expression 'person interested' would embrace any person with reasonable and tangible interest in the matter. Effectively, this expression is wider than the expression “person aggrieved” in other intellectual property statutes but narrower than the expression “any person” in Section 25(1) of the Patents Act. The petitioner is an entity under the name and style of “Steel Strips Wheels Limited”, and this corporate name is, at a minimum, suggestive of the nature of business. In the revocation petition, the petitioner asserted that it is engaged in the manufacture of wheels and has applied for and obtained patents relating to automotive products.

37. The petitioner also provided information on granted and applied for patents along with particulars such as patent or



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application number. The information provided is sufficient for cross-checking the veracity and controverting, if necessary, on the basis of data in the public domain. The petitioner is a listed company and, consequently, apart from information provided in the petition, substantial information about the petitioner is available in the public domain. The 1st respondent is admittedly engaged in the automotive wheel industry as one of the largest players. In these facts and circumstances, as held in *Muddasani Narasiah*, it is insufficient for the first respondent to merely deny knowledge of the petitioner's business and put the petitioner to strict proof thereof.

38. The key policy objective underlying the enabling of both pre-grant and post-grant challenges under the Patents Act is that an unjust monopoly should not be permitted to be created and, if allegedly erroneously created, any person interested should have the opportunity to establish the charge that an invalid monopoly was created. The entry barrier for such purpose should be set at an



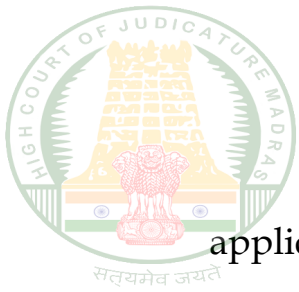
appropriate level. Neither so low as to encourage busybodies with no tangible interest nor so high as to deter and impede those with reasonable interest in the matter. Hence, the formulation of the reasonable and tangible interest standard. Upon applying such standard, I conclude that the petitioner fulfils the requirements of a 'person interested'.

Issue (v):

39. Issue (v) pertains to the alleged lack of clear and definitive scope of the claims and the alleged lack of fair basing thereof on the disclosures in the complete specification. This ground of challenge to the Patent is founded on Section 10(5) of the Patents Act, which reads as under:

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

The text in bold font above prescribes and imposes on a patent



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applicant the obligation to ensure that the claim or claims of a complete specification are clear and succinct and fairly based on matters disclosed in the specification. If this stipulation is not complied with, a revocation petition may be filed under Section 64(1)(i) of the Patents Act, which the petitioner has invoked and reads as under:

“(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may be revoked on a petition of any person interested or of the Central Government or on a counter-claim in a suit for infringement of the patent by the High Court on any of the following grounds, that is to say -

(i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;”

40. Mr.Adarsh Ramanujan relied on *Kirin-Amgen* to submit that if there is lack of clarity on a central/essential feature, the claims would *ipso facto* suffer both from lack of clarity and sufficiency. On the contrary, Mr.Bhaskar relied on *Anan Kasei* and contended that if



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there is uncertainty at the edges or boundaries, such fuzziness does not automatically invalidate the claim for lack of clarity or sufficiency.

41. Before proceeding to examine the specific objections and relevant claims, by way of preamble, it is pertinent to point out that, as in the case of all texts with legal implications, claim construction should be undertaken on the basis of text read in context. A distinction between claim construction and the construction of most other legal texts is that claims are typically replete with terms of art drawn from the field of invention. Therefore, while construing these terms of art, the meaning that the skilled addressee would place on these terms should be borne in mind. In claim construction, the text is the language of the claims and the context is the complete specification, including the drawings therein. Extrinsic evidence is resorted to, if required, to aid in understanding the technical issues and terminology while recognising that the claims and complete



specification are the primary sources for claim construction.

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42. Since the claims define the scope of monopoly, claim construction, in a nutshell, is gleaning the scope of each claim from text and context. The reference to and reliance on contextual material is for purposes of understanding the meaning of the text of the claim concerned, and not for expanding or whittling down the scope thereof. Hence, in my view, use of terminology such as purposive construction compounds confusion and is best avoided. Reference may be made profitably to principles laid down in *Biswanath Prasad and Jasper Motors Pvt. Ltd. and another v. The Proprietor, Basantree Batter Operated Rickshaw and others*, 2018 SCC Online Cal 4785, both of which were cited at the bar. While the principles governing claim construction have evolved over time, I concur substantially with the principles formulated by the UK Supreme Court in *Actavis v. Eli Lilly*, 2017 UKSC 48, in this regard, and proceed with analysis on such basis.



43. The petitioner's objections that the scope of the claims of the complete specification are not sufficiently and clearly defined and that the claims of the complete specification are not based on matters fairly disclosed in the specification are based on the alleged lack of clarity in respect of the following: location of the centre well section in claims 1, 8, 9 and 11; location at which the centre disc joins the rim in claims 1 and 9; location of the cylindrical section in claims 1 and 9; location of the cylindrical section in claims 8 and 11; and location at which the centre disc joins the rim in claims 8 and 11.

44. Given that claim 9 is the method claim corresponding to product claim 1 and, likewise, claim 11 is the method claim corresponding to product claim 8, it becomes necessary to test these objections against each set (i.e. claims 1 and 9; and 8 and 11) of the independent claims of the impugned Patent.



WEB COPY 45. Independent claims 1 and 9 are set out below:

“1. A wheel for a motor vehicle, said wheel being adapted to receive a pneumatic tire, said wheel comprising a rim (300) having a non-constant thickness and a center disc (240), wherein said rim (300) comprises:

A center well section (330), said center well section (330) having a base and two sidewalls, said center well section (330) further having a center well section thickness; an inner bead seat (310) for receiving a bead on a side wall of a tire; an outer bead seat (320) for receiving a bead on an another side wall of a tire; an inner transition section (340) joining said center well section (330) and said inner bead seat (310); an outer transition section (350) joining said center well section (330) and said outer bead seat (320); a cylindrical section (520) between said an inner transition section (340) and said inner bead seat (310), said cylindrical section (520) further having a cylindrical section thickness; a center disc (240) is joined to said rim (300) adjacent said center well section (330); characterized in that said inner transition section (340) has a thickness less than said cylindrical section thickness; said outer transition section (350) has a thickness less than said cylindrical section thickness; and said center well section (330) has a thickness less than said cylindrical section thickness.



9. A method for forming a motor vehicle wheel having a non-constant rim thickness, said wheel comprising a rim (300) includes an outer rim (210) and a center disc (240), the method comprising the steps of: forming an outer rim (210) blank by rolling a flat piece into a tubular shape; forming a center well section (330) in said blank, said center well section (330) having a base and two sidewalls, said center well section (330) further having a well section thickness; forming an inner bead seat (310) for receiving a bead on a side wall of a tire; forming an outer bead seat (320) for receiving a bead on an another side wall of a tire; forming an inner transition section (340) joining said center well section (330) and said first inner bead seat (310); forming an outer transition section (350) joining said center well section (330) and said outer bead seat (320); forming a cylindrical section (520) between said inner transition section (340) and said inner bead seat (310), wherein said cylindrical section (520) further having a cylindrical section thickness; and joining a center disc (240) is joined to said outer rim (210) adjacent said center well section (330); characterized in that said inner transition section (340) has a thickness less than the thickness of cylindrical section thickness; said outer transition section (350) has a thickness less than the thickness of said cylindrical section thickness; and said center well (330) has a thickness less than said cylindrical section thickness.



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**Location of centre well section and joining of centre disc with rim
in claims 1 and 9**

46. Each section or part of the wheel in both claims 1 and 9 has been ascribed a reference numeral. The largest components, the rim and centre disc, are assigned reference numerals 300 and 240, respectively. The reference numeral ascribed to the centre well section is 330. The said section is described as having a base and two side walls and as having thickness. After ascribing the reference numerals 340 and 310 to the inner transition section and inner bead seat, respectively, these claims provide that the inner transition section joins the centre well section and the inner bead seat. Similarly, after ascribing the reference numerals 350 and 320 to the outer transition section and outer bead seat, these claims recite that the outer transition section joins the centre well section and the outer bead seat. With regard to the centre disc (240), it is recited that it joins the rim (300) adjacent to the centre well section (330).



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47. In order to further test if the description in the claims is fairly based on and supported by the specification, I turn to the complete specification. The detailed description of the invention therein contains a reference to the drawings, i.e. Figures 1, 2a , 2b, 3, 4 and 5. Figure 3 of the drawings is referred to by specifically using the reference numerals therein. As regards the centre well section, it is stated as under:

"The center well section 330 may be a u-shaped section, having a diameter at the base of the well that is less than the outer diameter of the legs which form the sides of the well section...."

With regard to the point at which the centre disc is joined to the rim, it is stated as under:

"A center disc may be joined to the rim adjacent the well...."

48. While Figure 3 does not indicate the location at which the centre disc joins the rim, Figure 4 does. Hence, these descriptions



should be read with Figures 3 and 4, which are as under:

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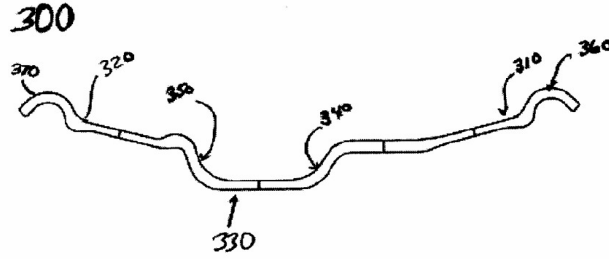


FIG. 3

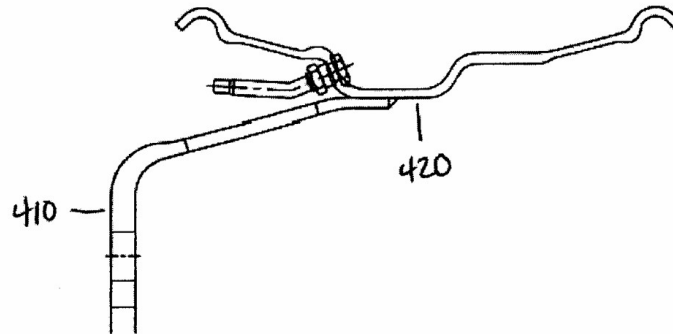


FIG. 4

Upon examining claims 1 and 9 with the complete specification and Figures 3 and 4, both the location of the centre well section and the



location at which the centre disc is joined to the rim are clear. As is noticeable from the above, they are also fairly based on the specification.

Location of cylindrical section in claims 1 and 9

49. It is apparent from claims 1 and 9 that the reference numeral assigned to the cylindrical section is 520. Claims 1 and 9 specify the location of the cylindrical section as under:

"a cylindrical section (520) between said inner transition section (340) and said inner bead seat (310), said cylindrical section (520) further having a cylindrical section thickness;"

Figure 3 corresponds to claim 1. It is noticeable that Figure 3 does not bear the reference numeral 520. The reference numeral for the other sections and parts, such as inner transition section (340) and inner bead seat (310), are, however, specified in Figure 3. Since these claims recite that the cylindrical section (520) is between the inner transition section (340) and inner bead seat (310), if the description of the



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location of the cylindrical section in claims 1 and 9 is read with Figure 3, the location of each section, including the cylindrical section, is clear.

50. Mr. Adarsh Ramanujan contended, in this regard, that a claim cannot be construed on the basis of the reference numeral by relying on *Lufthansa Technik*. Undoubtedly, a reference numeral cannot be relied on to expand or curtail the scope of a claim. To that extent, he is correct. But, as is evident from the following extract of *Telsonic AG's Patent [2004] R.P.C. 38* from *Lufthansa Technik*, reference numerals can certainly be used to identify the location of a claim element:

"17.That is not to say that numbers are pointless. They help a real reader orient himself at the stage when he is trying to get the general notion of what the patent is about. He can see where in the specific embodiment a particular claim element is, but no more...." (emphasis added)

Thus, in specific, the reference numerals in claims 1 and 9, including



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the reference numeral 520, can certainly be read with Figure 3 and the reference numerals therein for purposes of identifying the cylindrical section in claims 1 and 9.

51. Learned counsel also contended that the location of the cylindrical section is not fairly based on disclosures in the complete specification. Figure 3 is referred to in at least three paragraphs of the complete specification. At page 14 of the complete specification, it is stated, in relevant part, as under:

"....As shown in Figure 3, the rim profile is made with varying thickness to reduce the weight at the farther region to reduce the mass moment of inertia for the rim...."

Likewise, at page 15 thereof, Figure 3 is again referred to and the thickness of various sections, including the cylindrical section, is set out in Table 1 *infra*. Therefore, it cannot be said that the claim is not fairly based on disclosures in the complete specification.



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Location of centre well section and joining of centre disc with rim in claims 8 and 11

52. For purposes of examining the captioned aspect, it is necessary to reproduce claims 8 and 11:

“8. A wheel for a motor vehicle, said wheel being adapted to receive a pneumatic tire, said wheel comprising a rim (300) having a non-constant thickness and a center disc (240), wherein said rim (300) comprises:

a center well section (330), said center well section (330) having a base and two sidewalls, said center well section (330) further having a center well section thickness; an inner bead seat (310) for receiving a bead on a side wall of a tire; an outer bead seat (320) for receiving a bead on an another side wall of a tire; an inner transition section (340) joining said center well section (330) and said inner bead seat (310); an outer transition section (350) joining said center well section (330) and said outer bead seat (320); and a cylindrical section (520), said cylindrical section (520) having a cylindrical section thickness; and a center disc (240) is joined to said rim (300) adjacent said cylindrical section (520); characterized in that said inner transition section (340) has a thickness less than said cylindrical section thickness; said outer transition section (350) has a thickness less than said cylindrical section thickness; and said center



well (330) has a thickness less than said cylindrical section thickness.

11.A method for forming a motor vehicle wheel having a non-constant rim thickness, said wheel comprising a rim (300) includes an outer rim (210) and a center disc (240), the method comprising the steps of: forming an outer rim (210) blank by rolling a flat piece into a tubular shape; forming a center well section (330) in said blank, said center well section (330) having a base and two sidewalls, said center well section (330) further having a center well section thickness; forming an inner bead seat (310) for receiving a bead on a side wall of a tire; forming an outer bead seat (320) for receiving a bead on an another side wall of a tire; forming an inner transition section (340) joining said center well section (330) and said inner bead seat (310); forming an outer transition section (350) joining said center well section (330) and said outer bead seat (320); forming a cylindrical section (520), said cylindrical section (520) joining said center well section (330) and said inner transition section (340), wherein said cylindrical section (520) having a cylindrical section thickness; and joining a center disc (240) to said outer rim (210) adjacent said cylindrical section (520); characterized in that said inner transition section (340) has a thickness less than the thickness of said cylindrical section thickness; and said outer transition section (350) has a thickness less than said cylindrical section thickness; and said center well section (330) has a thickness less than said cylindrical section thickness."



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53. The reference numerals used across claims is common. As in the case of claims 1 and 9, the reference numeral 330 is ascribed to the centre well section, and the description of the centre well section as “having a base and two side walls ... having a center well thickness” also tallies with the description in claims 1 and 9. Likewise, in these claims also, the reference numeral 240 is ascribed to the centre disc. When these claims are examined in the context of the complete specification, for reasons set out while discussing claims 1 and 9, the location of the centre well section is clear.

54. The location at which the centre disc joins the rim is, however, different from claims 1 and 9. These claims recite, in this regard, as under:

“and a center disc (240) is joined to said rim (300) adjacent said cylindrical section (520)”

The complete specification contains the following disclosure in this regard:



“Although Figure 4 illustrates the center disc 410 being joined to the rim at the center well section 420, the present invention is not limited to such a configuration. In particular, the center disc 510 may be joined to the rim with the cylindrical section 520, such as is shown in Figure 5....”

Thus, the complete specification leads to Figure 5 for purposes of identifying the location at which the centre disc is attached to the rim in claims 8 and 11. Figure 5 is as under:

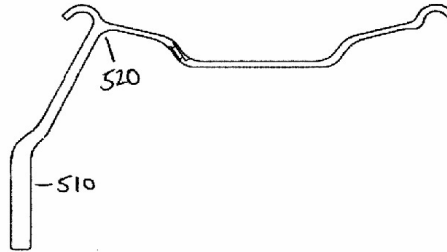


FIG. 5

If claims 8 and 11 are read along with the complete specification, including Figure 5, there is clarity on the location at which the centre disc is attached to the rim.

Location of cylindrical section in claims 8 and 11

55. The petitioner alleged lack of clarity in the location of the cylindrical section especially by comparing claims 1 and 8. On



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examining claims 8 and 11, as in the case of claims 1 and 9, it is noticeable that the reference numeral 520 continues to be used to refer to the cylindrical section. Unlike claims 1 and 9, which identify the location of the cylindrical section as *"a cylindrical section (520) between said inner transition section (340) and said inner bead seat (310)"*, claim 8 merely recites *"a cylindrical section (520), said cylindrical section (520) having a cylindrical section thickness"*. Claim 11, which is the method claim corresponding to claim 8, purports to identify the location of the cylindrical section as under:

"forming an inner transition section (340) joining said center well section (330) and said inner bead seat (310);

...

forming a cylindrical section (520), said cylindrical section (520) joining center well section (330) and said inner transition section (340), wherein said cylindrical section (520) having a cylindrical section thickness;"

56. The text of Claim 11 clearly provides that the inner transition section joins the inner bead seat and the centre well section,



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thereby indicating that the inner transition section lies between the inner bead seat and the centre well section. With regard to the cylindrical section, claim 11 recites that it joins the inner transition section and the centre well section without providing any indication as to the location of the cylindrical section in relation to the inner bead seat. Nonetheless, at a minimum, these descriptions indicate that the cylindrical section is located on the same side as the inner transition section and the inner bead seat. In fact, the absence of any reference to inner bead seat while describing the cylindrical section as joining the inner transition section and the centre well section could lead to the surmise, if not clear inference, that the cylindrical section lies between the inner transition section and the centre well section. The explanation of the 1st respondent on this issue, therefore, assumes importance.

57. In the counter statement, at paragraph 33 thereof, it is stated, in relevant part, as under with regard to the location of the



cylindrical section in claims 8 and 11:

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“....It is submitted that the “cylindrical section” in claims 8 and 11 is provided between the outer flange and the outer bead seat of the wheel rim based on Fig. 5 of the drawings and Page 11 of the specification. It is reiterated that the claims have to be considered and read wholly in order to ascertain the working of the invention. Claim 11 clearly shows the position of the cylindrical section by stating that, “the cylindrical section (520) having a cylindrical thickness; and joining a centre disc (240) to said outer rim (210) adjacent said cylindrical section”. It is further stated: “In particular, the center disc may be joined to the rim with the cylindrical section 520, such as is shown in Figure 5.” (emphasis added)

As noticed in the preceding paragraph, the above explanation is untenable as regards claim 11 because the text thereof, even if read with the complete specification, is not compatible with the position of the cylindrical section being between the outer flange and the outer bead seat.

58. As regards claim 8, it bears repetition that the claim contains no indication about the location of the cylindrical section. If claim 8 is



read with Figure 5 for purposes of identifying the location of the cylindrical section, there is clear indication that the centre disc joins the rim at or adjacent to the cylindrical section (520). There is also indication that the cylindrical section is close to the outer flange, but not that it is between the outer flange and the outer bead seat. If construed in this manner, however, the cylindrical section in claim 8 would be on the outer flange side, whereas the cylindrical section in claim 11, which is the method claim corresponding to claim 8, would be on the inner flange side. The 'without prejudice' explanation of the 1st respondent that the cylindrical section in claim 11 is also at the place where the centre disc joins the outer rim is not corroborated by the record and is, in fact, contradicted by the text of claim 11.

59. Both in oral and written submissions, learned counsel for the 1st respondent contended that the contention of learned counsel for the petitioner regarding the difference in the position of the cylindrical section, as between claims 8 and 11, was not supported by



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pleading. While this assertion is correct, the petitioner did plead that the position of the cylindrical section in claims 8 and 11 is unclear.

Obviously, both claims 8 and 11 are on record as are the descriptions of the cylindrical section therein. Therefore, notwithstanding the objection, this aspect calls for adjudication. Before doing so, it is instructive to examine precedents cited at the bar.

60. In the factual context of a patent in relation to a heart rate monitor comprising a live electrode and a common electrode as elements mounted in spaced relationship with each other but without any parameters to determine appropriate spacing, in *Nautilus*, the Supreme Court of the United States, after recognising the inherent limitations of language, held, in relevant part, as under at page 12 of the Lexis Nexis Report:

"At the same time, a patent must be precise enough to afford clear notice of what is claimed, "thereby appris[ing] the public of what is still open to them"...."



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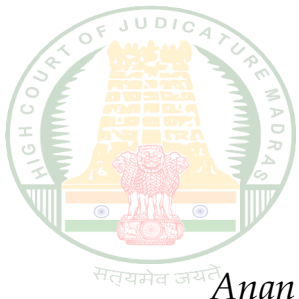
Claim 19 of the patent was challenged in *Kirin-Amgen* on the ground that the claim and specification did not specify the urinary erythropoietin (uEPO), and the House of Lords held as under, in relevant part, at paragraph 126 of the report:

“The lack of clarity does not merely create a fuzzy boundary between that which will work and that which will not. It makes it impossible to work the invention at all until one has found out what ingredient is needed.”

61. In *No-Fume*, in the factual context of a claim for an ash receptacle which, without the use of movable parts, retains the smoke rising from objects thrown into it, the failure to provide the dimensions of the elements of the receptacle were held to be insufficient to hold the patent invalid for insufficiency or ambiguity.

In relevant part, it was held as under at page 238 of the report:

“.... It seems to me that the proportions can be ascertained without the exercise of any new inventive faculty, if the directions laid down are followed; because the purpose of the invention is to construct a space for cooling smoke, and yet that is to be done within the limits of what might be called the conventional ash receptacle....”



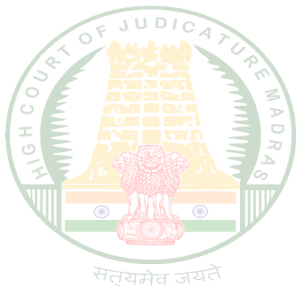
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Anan Kasei concerned a patent for ceric oxide used as a catalyst for purifying vehicle exhaust gases. The claim used the expression “consisting essentially of ceric acid” and an insufficiency attack was mounted on the ground that the other ingredients were not disclosed. In that context, after noticing that the above expression would be understood by the skilled addressee as excluding any other material ingredient, the Court of Appeals distinguished *Kirin-Amgen* as dealing with conceptual uncertainty and rejected the insufficiency challenge. While other precedents were cited on this issue, it is unnecessary to deal with them. The common thread running through these precedents is that the nature of alleged insufficiency or ambiguity should be assessed to determine whether it impacts determination of the scope of the monopoly, and whether it impacts working of the invention by a person skilled in the art. I turn to the facts so as to apply and test these principles.



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62. The core of the invention is the formation of a wheel with uneven thickness of different sections of the rim as a solution to the problem of dealing with fatigue failure without increasing wheel weight. The object of the exercise is to avoid unduly increasing the mass moment of inertia. In each independent claim, including claims 8 and 11, the thickness of the cylindrical section of the rim is higher than the other sections. Without identifying the location of the cylindrical section with a reasonable degree of clarity, it would not be possible to either determine the scope of monopoly or work the invention. Hence, the location of the cylindrical section is central to the invention and qualifies as an essential feature. Even the relative thicknesses in Table 1 of the complete specification are for the embodiment shown in Figure 3, which corresponds to claims 1 and 9 but not to claims 8 and 11. On account of the lack of clarity on the location of an essential feature of the invention in claims 8 and 11, the grant in respect of these claims is liable to be revoked.

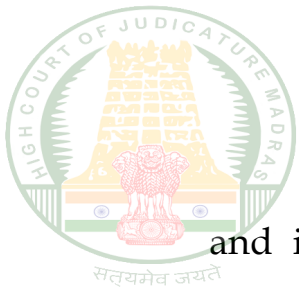


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63. Claim 13 is an independent method claim relating to the method of forming a motor vehicle wheel with a rim of uneven thickness, and warrants independent examination to decide on the lack of clarity objection. Claim 13 is as under:

13. A method for forming a motor vehicle wheel having a non-constant rim thickness, the method comprising the steps of: spin forming an outer rim (210) for said wheel, wherein said outer rim (210) having a non-constant rim thickness; and joining a center disc (240) to said outer rim (210) to form said motor vehicle wheel"

As regards claim 13, the petitioner contended that the claim is not restricted to or dependent on claims 1, 8, 9 or 11. On closely examining the language of claim 13, as contended, it does not contain any restriction by making the claim dependent on claims 1, 8, 9 or 11. In other words, claim 13 would extend monopoly even to a rim with non-constant thickness in areas different from those mentioned in independent claims 1 and 8. To that extent, the petitioner is justified in contending that claim 13 unfairly expands the scope of monopoly



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and is not fairly based on the specification. Whether this entails revocation or amendment is considered next.

64. Section 58 of the Patents Act is as under:

“58. Amendment of specification before High Court. – (1) In any proceeding before the High Court for the revocation of a patent, the High Court, may, subject to the provisions contained in section 59, allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the High Court may think fit, and if in any proceedings for revocation the High Court decides that the patent is invalid, it may allow the specification to be amended under this section instead of revoking the patent.

(2) Where an application for an order under this section is made to the High Court, the applicant shall give notice of the application to the Controller, and the Controller shall be entitled to appear and be heard, and shall appear if so directed



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by the High Court.

(3) Copies of all orders of the High Court allowing the patentee to amend the specification shall be transmitted by the High Court to the Controller who shall, on receipt thereof, cause an entry thereof and reference thereto to be made in the register."

The above provision clearly enables the Court to direct an amendment of the specification instead of revoking the patent provided it is within the scope of Section 59. The Controller of Patents, who is required to be put on notice for such purpose, is a party to this proceeding and is represented through counsel.

65. The overarching condition in Section 59 is that the amendment should be by way of disclaimer, correction or explanation. If claim 13 were to be amended by linking and restricting the scope to that of claims 1 and 9, the consequence would be to whittle down the width of claim 13 by confining it to the production of a wheel with a



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rim of non-constant thickness, as per claim 1, and to which the centre disc is joined either at the position specified in claim 1 or that specified in claim 9. Consequently, such amendment would fall squarely within the scope of Section 59.

66. Given that it was previously held that claims 8 and 11 fail for lack of clarity, it is necessary to confine claim 13 to the characterization specified in respect of the areas of non-constant thickness in claims 1 and 9. This can be accomplished by amending claim 13 as under:

*“Claim 13: A method for forming a motor vehicle wheel having a non-constant rim thickness, the method comprising the steps of:
spin forming an outer rim (210) for said wheel, wherein said outer rim (210) having a non constant rim thickness **according to claims 1 or 9;**
joining a center disc (240) to said outer rim (210) **according to claims 1 or 9** to form said motor*



vehicle wheel."(emphasis added)

This will impact all claims dependent on claim 13, namely, claims 14-17 by importing the same limitation therein. The Controller shall comply with the requirements of sub-section (3) of Section 59 and any other requirements in this regard shall be complied with both by the Controller and the 1st respondent.

Issue (iv)

67. Issue No.4 pertains to whether the complete specification of the impugned Patent sufficiently and fairly describes the invention, and the best method of working the same. The obligation to fully and particularly describe the claimed invention, its operation and use and the method by which it is to be performed is imposed on a patent applicant under Section 10(4)(a) of the Patents Act. Section 10(4)(b) thereof imposes the additional obligation of disclosing the best method known to the patent applicant of performing the invention in respect whereof such applicant is entitled to claim protection.



Section 10(4(a) and (b) are as under:

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“(4) Every complete specification shall -

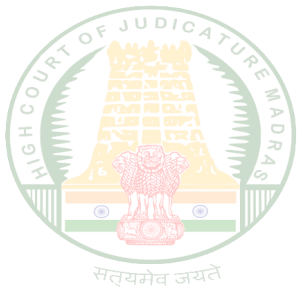
(a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;

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

68. The petitioner alleges non-compliance with this obligation by invoking, as a ground for revocation, Section 64(1)(h), which is as under:

“(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may be revoked on a petition of any person interested or of the Central Government or on a counter-claim in a suit for infringement of the patent by the High Court on any of the following grounds, that is to say -

(h) that the complete specification does not sufficiently and fairly describe the invention and



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the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection."

69. In the complete specification, after describing the problem to be solved as dealing with fatigue failure and other stress factors, such as rotational speed of the wheel and vehicle cornering, it is stated as under at page 14 :

"As shown in Figure 3, the rim profile is made with varying thickness to reduce the weight at the farther region to reduce the mass moment of inertia for the rim. Appropriate thicknesses are determined through analysis of the loads to be



applied to the wheels, such as through finite element analysis, and consideration of the required fatigue life of the rim section. The fabrication process for forming the profile may be selected such that work hardening of the rim material improves the strength of the material, particularly in areas of reduced thickness, to provide improved material characteristics to allow strength and fatigue resistance criteria to be met in spite of reduction in the thickness of the rim"

The relative thicknesses of different sections of the wheel rim for the embodiment in Figure 3 with specific bead seat parameters were thereafter set out in Table 1 *infra*. As regards the spin forming process, the patentee/1st respondent set out comparative data in Table 3, which is as under:



Table 3: Comparative Physical Properties

Physical Property	ETRTO Rim	Improved Rim	ETRTO Rim	Improved Rim
	Matl. Hardness (BHN)		Matl. Strength (UTS)	
Inner Bead Seat	H1	1.77 H1	S1	1.67 S1
Well Section	H1	1.80 H1	S1	1.52 S1
Cylindrical Sect.	H1	1.74 H1	S1	1.43 S1
Outer Bead Seat	H1	1.78 H1	S1	1.66 S1

70. On examining the complete specification at pages 95 to 101 of the typed set of the petitioner along with independent claims 1 and 9, including claims dependent thereon, and claim 13, as amended above, including claims dependent thereon, and the drawings relating thereto, I see no reason to conclude that the disclosures are insufficient to enable a person of average skill and knowledge in the art in India to work the invention as regards independent claims 1 and 9 and claims dependent thereon. By contrast, as regards independent claims 8 and 11 and claims dependent thereon, for reasons set out while considering revocation under Section 64(1)(i), I conclude that the disclosure is insufficient to enable a person of



average skill and knowledge in India to work the invention.

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Therefore, Issue 4 is disposed of on the above terms.

Issue (ii)

71. This issue pertains to the alleged lack of novelty in the invention. This contention was raised by contending that claim 8 lacks novelty in view of prior art D1. According to the petitioner, prior art D1 provides for a rim for large and medium size tubeless wheels, wherein the patent addresses the problem of optimizing weight by maintaining strength. The petitioner contends that D1 also teaches the feature of producing a rim of non-constant thickness as the means to achieve the objective of optimizing weight while maintaining strength.

72. On comparing prior art D1 with the claimed invention, it is noticeable that the complete specification of the claimed invention identifies the problem to be resolved as reducing fatigue failure on



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account of cyclical loading. Any reference to fatigue failure, whether on account of cyclical loading or otherwise, is absent in D1. Thus, the problem addressed by the Patent and D1 are not the same. Moreover, D1 does not provide for a cylindrical section with highest thickness relative to other sections. The settled legal position while testing novelty, as can be seen in *Farbwerke*, is that a patent cannot be rejected on this ground unless all the features of the claimed invention or of the patent, as the case may be, are contained in a single prior art. Since such is not the case when the impugned Patent is compared with prior art D1, the challenge on the basis of alleged lack of novelty fails.

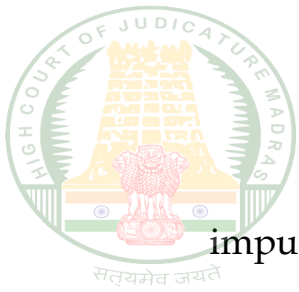
73. The same contention was also raised with regard to claim 13. By comparing claim 13 with prior art D3, the petitioner contended that the only difference between claim 13 and prior art D3 is that prior art D3 teaches formation of a rim with non-uniform thickness after the disc is attached to the rim by a spinning process, whereas



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the impugned Patent provides for the attachment of the disc after formation of the rim with non-uniform thickness. According to Adarsh Ramanujan, this is purely a case of change in sequence of steps involved in the method claim. By relying upon the judgment in *Interactive Gift Express*, he contended that such change of sequence is by itself not consequential while deciding whether the method claim comprising a series of steps is novel.

74. On closely examining prior art D3, it is evident that it provides for mounting an intermediate unit comprising a rim pre-form and an attached centre portion (disc) within the forming apparatus so as to form the rim of non-uniform thickness. Thus, the monopoly claim in D3 involves the mounting of the rim pre-form and disc on a forming apparatus so as to undertake spinning. This is a particular method of forming a vehicle wheel with non-uniform thickness of the rim while the vehicle rim is attached to the centre wheel. It certainly cannot be said that all the features of the impugned Patent are contained in D3 or *vice versa*. Therefore, the



impugned patent cannot be revoked on account of lack of novelty.

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Issue (iii):

75. The next issue that falls for consideration is whether the impugned Patent lacks an inventive step. Learned counsel for the first respondent argued that the petitioner failed to lead expert evidence and, therefore, did not discharge the burden of proving that the impugned Patent lacks an inventive step. He relied on *Molnlycke* for support. The petitioner relied on the decision of the Court of Appeals in *Rockwater*, wherein it was observed that the primary function of the expert is that of a teacher, i.e. to assist the court in understanding the scientific terminology and technology. The Court further held that the expert plays a facilitatory role as the maker of the mantle; and that it is for the court to don the mantle of the notional PSITA for the purpose of inventive step analysis. Expert evidence would probably have aided obviousness analysis in this case, particularly in understanding terminology and relevant



concepts. The eventual adjudication of inventive step is, however, a core judicial function to be performed in course of adjudicating such matters with or without the aid of expert evidence. Hence, the absence of expert evidence does not *per se* lead to a rejection of the obviousness challenge.

76. Learned counsel for the petitioner relies on prior arts D1 to D3 to contend that the impugned Patent lacks an inventive step. He also contended that there is no technical advance over cited prior art. After providing data in the form of Table 3, which is reproduced *supra*, the complete specification provides as under:

As can be seen, the spin forming process imparted significant work hardening of the material, which resulted in significant increases to the ultimate tensile strength at the spin formed region. Furthermore, the weight of the rim section using the non-constant thickness is only approximately 78% of the ETRTO Standard rim, which greatly decreases the mass moment of inertia of the rim.



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Finally, the fatigue life to failure of the compared rims has been determined to be increased between 17 and 20% by using the spin formed non-constant thickness rim section when cornering force fatigue life and radial fatigue life are compared.

In the absence of evidence from the petitioner that this does not represent a technical advance over cited prior arts, the impugned Patent cannot be revoked on this ground.

77. The 1st respondent relied on the decision dated 18.09.1990 of the Boards of Appeal of the European Patent Office in *Detergent Composition / UNILEVER, T 606/89(1990)* to contend that if the technical problem addressed by the closest prior art is different, then the inventive step requirement is satisfied. In my view, a comparison of the problem addressed by prior arts and that addressed by the invention is material but is not the sole factor in obviousness analysis.



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78. As discussed earlier, D1 identifies the problem as weight optimization while maintaining wheel strength. This problem is resolved by producing a rim of non-constant thickness wherein the thickness of the flange part is highest relative to the thickness of other parts. On examining independent claim 1 of the Patent, it is noticeable that it is a two-part claim consisting of the part known in prior art and the part in respect of which the monopoly is claimed. The part in respect of which monopoly is claimed follows the words “characterized in that”. In effect, the monopoly claimed in claim 1 is in respect of a wheel for a motor vehicle, which is adapted to receive a pneumatic tyre, wherein the wheel comprises a rim with non-constant thickness characterized by the thickness of the inner transition section being less than the thickness of the cylindrical section; the thickness of the outer transition section also being less than the cylindrical section thickness; and the centre well section's thickness also being less than that of the cylindrical section.



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79. In the complete specification, the relative thicknesses of specific sections are disclosed as under:

“ In the embodiment shown in Figure 3, and using a wheel having a distance between bead seats of approximately 8 ½ inches and a bead seat diameter of approximately 22 ½ inches the relationships between the thicknesses can be shown. For an optimized wheel having a joint formed between the center disc and the rim adjacent to the center of the well section, and utilizing the proportions approximated in the Figure, the ratios between the thicknesses of the various sections can be shown as below:

Table 1: Optimized Wheel Thicknesses

Location Description	Figure Ref.	Proportionate Thickness
Inner Transition Section	A	.61t
Well Region	B	.71t
Cylindrical section	C	.96t
Outer Transition Section	D	.61t

Where "t," a notional base thickness, is dependant on the expected loading for the wheel.

The above Table corroborates and supports independent claim 1, i.e. that the cylindrical section has the highest thickness. Indeed, even



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when the cylindrical section is located in a different position, as in independent claims 8 and 11, the impugned Patent provides that the cylindrical section would have the highest thickness.

80. Given the fact that the impugned Patent endeavours to resolve the problem of fatigue failure, it appears that the solution provided in the impugned Patent is to provide for higher thickness relative to other sections in areas where the cyclical load is greater. Such feature is not present in prior art D1, wherein the non-constant thickness appears to be a measure targeted at weight reduction. D1 also does not contain any cues that would lead PSITA to look at solutions to fatigue failure especially by providing for a rim with the cylindrical section having the greatest relative thickness.

81. As regards prior art D2, it provides for first forming a rim blank of uniform thickness and then forming an area of reduced thickness. Any reference to the specific areas of reduced or increased



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thickness is conspicuous by its absence in the complete specification and claims of prior art D2.

82. Turning to prior art D3, as discussed earlier, the problem to be resolved therein is the avoidance of misalignment and the consequential improper riding and steering. The solution proposed to that problem is to attach the centre portion of the wheel to the rim pre-formed by welding or casting. Once this is done, the rim pre-formed with the attached centre portion is mounted on a machine or apparatus by simulating the manner of attachment to the axle of the vehicle. Thereafter, the desired portion is stretched to reduce the thickness thereof. Thus, prior art D3 teaches a particular method of reducing the thickness, wherein an intermediate unit comprising a rim pre-form and attached centre portion are mounted on a forming apparatus so as to reduce the radial depth of a portion of the rim.

83. If PSITA were to be armed with D3, PSITA would look at

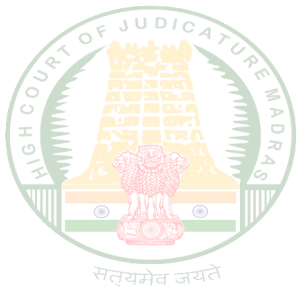


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methods of reducing thickness of a portion of the rim by adopting a process similar to that adopted in D3. Such process would consequently entail mounting an intermediate unit, including the attached centre portion / disc, on the forming apparatus. Hence, there is teaching away in D3 and PSITA would not be led to the claimed invention on the basis of D3, even if D3 were to be looked at in the context of D1. For reasons set out above, I conclude that the impugned Patent would not be obvious from any of the cited prior

arts. This concludes the discussion on all the grounds of challenge and the relief to be granted flows from conclusions recorded while discussing the respective ground.

84. In the result, (T)OP(PT) No.60 of 2023 is disposed of as under:



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(i) The challenge is rejected in respect of independent claims 1 and 9 and corresponding dependent claims 2-7 and 10.

(ii) The grant of patent is partially revoked in respect of independent claims 8 and 11 and corresponding dependent claim 12.

(iii) The grant of patent in respect of Claim 13 is maintained subject to claim 13 being amended as under and, consequently, dependent claims 14-17 also being similarly limited:

*“Claim 13: A method for forming a motor vehicle wheel having a non-constant rim thickness, the method comprising the steps of:
spin forming an outer rim (210) for said wheel, wherein said outer rim (210) having a non constant rim thickness according to claims 1 or 9;
joining a center disc (240) to said outer rim (210) according to claims 1 or 9 to form said motor vehicle wheel.”*

(iv) All procedural requirements in relation to the amendment and the partial revocation shall be complied with by the Controller and, if any action by the 1st respondent is necessary in this regard, the



1st respondent shall comply with directions of the Controller.

WEB COPY (v) There will be no order as to costs.

03.04.2025

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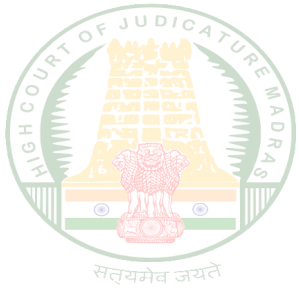
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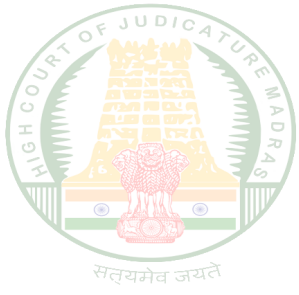
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03.04.2025