

ARGUMENTS ADVANCED

1. THAT THE GRANT OF PATENT TO THE DEFENDANT WOULD BE INFRINGE PLAINTIFF'S PATENT RIGHTS.

The plaintiff submits that the claims of the defendant is liable for infringement as its product is a mere colourable variation¹ of the plaintiff's patent. In absence of novelty and non-obviousness, the defendant cannot claim a patent on their product.

1.1 That the claims of the plaintiff have been incorporated, in toto, in the defendant's claims.

1.1.1 It is humbly submitted before this Hon'ble Court that defendant has essentially copied the "Pith and Marrow"² of the plaintiff's patent specification with respect to the dust cleaning capability. The question while considering infringement is whether the essential features of the claim are present or not. This is to be decided on an examination of the claims of the parties.³

Defendant copied "Pith and Marrow" of the plaintiff's product .

1.1.2 It has been averred before the courts that pith and marrow principle can be equated to the doctrine of equivalence⁴, which prevents parties from infringing patents with impunity by making merely trivial changes⁵ in an invention. This proposition was concretized in Marconi's case⁶ where Justice Parker stated that:

" It is a well known rule of patent law that no one who borrows the substance of a patented invention can escape the consequences of infringement by making immaterial variations..."

1.1.3 Hence, in light of the factual matrix, it follows that upon a comparison of the claims of both the parties it is self-evident that the defendant has replicated⁷ individual claims of the plaintiff's specification.

1.2 That the claims of the defendant are in want of novelty.

1.2.1 The defendant claims that it has based its device on a published article of 1974. However, observing the visual timeline of evolution of nanotechnology⁸, there is no prior publication that any inventor let alone the defendant could have relied upon to say that their invention, a dust cleaning system driven by nanorobots, was inspired by the same.

Immaterial changes in a product cannot escape consequences of infringement.

¹ "A mere colourable variation will not confer novelty." *Application of Drisner*; 156 F.2d 164, 3 C.C.P.A., Patents, 991.

² The Pith and Marrow of the invention is the essence of invention which if taken and re-produced in the infringed article even by incorporating a colourable variation of it within the invention, infringement has taken place. B.L. WADEHRA, LAWS RELATING TO PATENT TRADE MARK COPYRIGHT DESIGNS & GEOGRAPHICAL INDICATIONS, (3rd edn., Universal Publishing, New Delhi, 2004).

³ "It is not the province of the Court to guess what is or what is not the essence of the invention; that is a matter to be determined on an examination of the language used by the patentee in formulating his claims." *RCA Photophone v. Gaumont British-Picture Corp.* (1936) 53 RPC 167 at 197.

⁴ *Novartis AG v. Adarsh Pharma*, 2004 (29) PTC 108 (Mad).

⁵ *Marconi v. British Radio Telegraph & Telephone* (1911) 28 RPC 181 at 217- 218, quoted and followed in *Birmingham Sound Reproducers v. Collaro* (1956) RPC 232 at 243 and *RCA Photophone v. Gaumont British-Picture Corp.* (1936) 53 RPC 167.

⁶ *Ibid*

⁷ "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." *Fife Manufacturing Co. v. Stanford Engineering Co.* D.C.III. 193 F. Supp 226, 232. Also see, Equivalents doctrine- Henry C. Black, Black's Law Dictionary 6th edn., 1990, West Publishing Company.

⁸ Delft and Leiden University <http://www.msc-nanoscience.tudelft.nl/nanotimeline.html>.

- 1.2.2 It was difficult to envisage such technological advancement in the field of nanotechnology at such a nascent stage⁹ (in 1974). By no stretch of imagination, could the same have been perceived for cleaning dust in homes. Any prior publication on nanotechnology would have reflected a merely rudimentary picture of the state of art.¹⁰
- 1.2.3 While examining ‘anticipation’ from a prior art, it is essential that the description of the invention in question must be adequate to a person with ordinary skill in the art to which the invention pertains¹¹. The information must sufficiently enable the instructed reader to perceive at once, understand and to practically apply the discovery without the necessity of further experimentation.¹² As stressed by Learned Hand¹³ J. that a publication can not be treated as ‘anticipated’ if it fails to direct as to how the invention is to be practised.¹⁴
- 1.2.4 In the light of above submission, the publication of 1974 claimed by the defendant cannot be treated as prior art. In absence of any prior art reference, the plaintiff’s claims satisfy the test of novelty required for a patent as it involves the presence of some element different from anything found in any prior structure.¹⁵ The defendant has merely based its product on DUSTNIBBLER, thus, lacking novelty¹⁶.

No conclusive proof of existence of prior art in 1974 publication.

1.3 That the claims of the defendant as to dust mite detection and destruction capability lack inventive step.

- 1.3.1 It is humbly submitted that the Section 2(1)(ja)¹⁷ read with Section 25(2)(e)¹⁸ requires that patent specification should not be obvious and should be characterized by an inventive step. Lack of inventive step is known as obviousness¹⁹ which can be determined by the High Court by use of their knowledge of the relevant scientific and technical background to the subject matter of the alleged invention.²⁰ Hence, upon a step by step perusal of the process algorithm underlying the dust mite detection and destruction process, it becomes

⁹ **Key Events in the History of Nanotechnology:** Nanotechnology was first anticipated in 1959 after the talk by Richard Feynman named “There’s Plenty of Room at the Bottom”. In 1986, K. Eric Drexler presented the idea of nanotechnology and outlined its awesome potentials. In 1993, the first nanotechnology lab was established in the U.S.A. In 2001, the first transistors, and then logic gates were made entirely from carbon nanotubes.

¹⁰ “For a document to anticipate a claim must contain clear and unmistakable directions to the claimed invention or there must be evidence that carrying out what was suggested in the document inevitably resulted in the claimed invention.” *Quantel v. Spacward* (1990) RPC 83.

¹¹ CHISUM DONALD, CHISUM ON PATENTS, Lexis Publishing, Vol 1, §3.04, p. 3-44.

¹² *Van Der Lely N.V. v. Bamfords* (1963) RPC 61 at 71. “Experiment” in this context means experiments with a view to discovering something not disclosed and does not mean ordinary methods of trial and error.” *Also see Bugges Insecticide v. Herbon* (1972) RPC 197 at 209, 210.

¹³ *Dewey & Almy Chem. Co. v. Mimex Co.* 124 F. 2d 986, 990, 52 U.S.P.Q. 138 (2d Cir. 1942).

¹⁴ *Ibid.* If the earlier disclosure offers no more than a starting point for further experiments, and its teachings will sometimes succeed and sometimes fail if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge and it is not an anticipation.

¹⁵ *King-Seely Thermo Co. v. Refrigerated Dispensers, Inc.* C.A. Okl 354 F.2d. 533, 537.

¹⁶ In order that there may be novelty, so as to sustain a patent, the thing must not have been known to anyone before. *Seaver v. Wm Filene’s Sons Co.* DC Mass., 37 F. Supp. 762, 765.

¹⁷ Section 2(1)(ja) THE PATENTS ACT, 1970 states *inter alia*: “inventive step” means a feature that makes the invention not obvious to a person skilled in the art;

¹⁸ Section 25(2)(e), *inter alia* states; Opposition of Patents - that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the claim.

¹⁹ CATHERINE COLSTON, PRINCIPLES OF INTELLECTUAL PROPERTY LAW, 99, (Cavendish Pub Ltd, Sydney, 1999).

²⁰ *John- Melville Corporation’s Patent* (1967) RPC 479 at 491.

evident that defendant's specification lacks inventive step. The nanorobots of the two companies use certain common elements, namely rotary tentacles and suction nozzles.²¹ The manner in which these elements work are comparable to the manner in which plaintiff's device works. As regards the use of biosensors to detect dust and breaking up of dust mites by release of enzymes, this too lacks inventiveness because biosensors²² and the use of enzymes in destruction of bacteria have been successfully reduced to practice²³.

Courts need to have a stepwise perusal to identify involvement of inventiveness in the claims of both the parties.

2. THAT THE ONLINE GAME OF THE PLAINTIFF AMOUNTS TO A LIBELOUS UNILATERAL ANIMATED REPRESENTATION DESIGNED TO DEFAME THE PLAINTIFF'S PRODUCT.

It is humbly submitted that the online game of the defendant, which is not a game in spirit, was designed in a way so as to lower the goodwill²⁴ of the plaintiff in eyes of its customers.

2.1 That the online game of the defendant is a mere unilateral animated representation.

2.1.1 It is humbly asseverated that a computer game involves active participation by the player²⁵ where the output is determined by the user's inputs. In the given facts, the defendant's game falls short of being a game in spirit as the user has no control over it. Hence, it is evident that the so called game ends up being no more than an animated representation.

In case of absence of control over online game, it remains no more manual but merely becomes an animated presentation.

2.2 That the use of the deceptively similar name NIBLERR upon the icon is misleading.

2.2.1 The plaintiff implores the Hon'ble Court to take into consideration the promotion of defendant's product through their so called game. The defendant had advertised that the player of the game is required to accumulate points by destroying biological organisms using the icon NIBLERR. However, at this point it is pertinent to note that it is impractical for any player to attain the target to avail discount (100,000 points) as the game runs beyond their control and terminates at 1500 points.

2.2.2 The word NIBBLER is an integral part of the plaintiff's word mark 'DUSTNIBBLER'. The phonetic similarity in the names of the icon NIBLERR and plaintiff's product NIBBLER causes confusion of source of origin²⁶ among the target customers. Hence, by this act the defendant intends to defame²⁷ the plaintiff by attaching lack of competitiveness to its product. The manner in which a registered trademark is used can affect the esteem in which the mark is held and this in turn could damage the mark as a whole.²⁸

²¹ See Nanotechnology- Background Note annexed with the Fact Sheet.

²² www.ornl.gov/info/ornlreview/rev29_3/text/biosens.htm, www.lsbu.ac.uk/biology/enztech/biosensors.html.

²³ <http://www.rockefeller.edu/graduate/faculty/research/abstract.php>.

²⁴ "the attractive force which brings in customers" *IRC v. Muller's Margarine* [1901] A.C. 217 at 223, "it has been stated to represent, in connection with any business or business product, the value of the attraction to the customers which the name and the reputation possesses." *Renter v. Muhlens* (1953) 70 R.P.C. 235 at 254.

²⁵ <http://encyclopedia.laborlawtalk.com/Game>, http://encyclopedia.laborlawtalk.com/Computer_game.

²⁶ Distinctiveness serves two purposes. Firstly, it acts as means of identifying the **source of the product** (an indication of origin function) and secondly, it acts as means of differentiating the goods of one provider from those of a competitor (a differentiation function). DAVID AAKER, *MANAGING BRAND EQUITY*, (7th edn., Macmillan, N. York, 1991).

²⁷ "...statement or words which are published and calculated to expose any person to ridicule, contempt or hatred or which aim to **injure the said person in his** vocation, **business**, trade, profession or office." ANUBHA CHARAN, *PRICE OF DEFAME*, (<http://www.rediff.com/netguide/2001/nov/01fame.htm>). The essentials of defamation (i) the material complained is defamatory; the test is whether it lowers the person in the estimation of right-thinking members of society; (ii) it refers to the claimant (iii) it has been published to another person. RODNEY D RYDER, *BRANDS, TRADEMARKS AND ADVERTISING*, 318, LexisNexis, Butterworths, New Delhi, 2003).

²⁸ *Ibid* at 108.

2.3 That the shape of the icon employed in the game resembles with plaintiff's product.

2.3.1 Additionally, the online game uses a disc shape icon which closely resembles the shape of the Plaintiff's product. There is a high likelihood of confusion amongst the customers due to the deceptively similar²⁹ shapes of the icons. The plaintiff must be compensated³⁰ as such defamation³¹ can result in loss of sales as confirmed by the studies of the Iowa School of Business with regards influence of non-credible information on investing public.³²

The online game can cause confusion in the minds of customers results in damage to reputation.

3. THAT THE DEFENDANT HAS INFRINGED THE LAWS RELATED TO TRADE SECRET.

The defendant had gained technical know-how of product during his tenure at the plaintiff's office and has reproduced the same, making him liable for misappropriation of trade secret.

3.1 That the TRIPS provisions mandate protection of "Undisclosed Information".

3.1.1 It is humbly submitted that the defendant being an ex-employee of the same concern has every reasonable possibility to possess and use trade secret in their own concern. In India trade secrets are protected by common law principles of equity, laid down by the Courts of law³³. In addition, Article 39(2)³⁴ of TRIPs³⁵ mandates the protection of undisclosed information³⁶, which is similar to the Uniform Trade Secrets Act, applies in the United States and other countries.³⁷

TRIPs provisions can be incorporated by virtue of common law and Court's intervention.

3.2 That the technical know-how underlying the product is a trade secret.

3.2.1 The kind and variety of information that may fall within the ambit of Trade Secret is varied. Furthermore, data retains usefulness for the Plaintiff even after it is disclosed as basis for developing new products or refining old products, as marketing and advertising tools, or as information necessary to obtain registration in foreign countries.³⁸

²⁹ A phonetic or visual or otherwise false representation that is likely to deceive or cause confusion. *Bhim Sain v. Janta Naswar Factory* 1997 PTC (17) 423.

³⁰ "Exemplary damages" need to be awarded by different courts for online defamation to deter people from indulging in the said illegal activities. PAVAN DUGAAL., Cyberlaw Consultant and President, Cyberlaws.Net. <http://www.indiaonline.com/cyva/colu/cybe/padu4.html>

³¹ Defamation is an intentional false communication, either published or publicly spoken, that injures another's reputation or good name." Henry C. Black, *Black's Law Dictionary* - 6th edition, 1990, West Publishing Company.

³² "People are greatly influenced by what should be non-credible communications. It affects what people are willing to pay, and there can be unbelievable movement of stock on the vaguest information." www.fndlaw.com/html/bruce_article.htm

³³ See for the Commonwealth countries. A.E. TURNER, *THE LAW OF TRADE SECRETS*, (London 1962); for US position, R. MILGRIM, *TRADE SECRETS*, (New York, 1967).

³⁴ Article 39 (2) provides that natural and legal persons shall protect information in honest commercial practice provided the information should be secret, non accessible, possess commercial value & protected by reasonable steps.

³⁵ JUSTICE (DR.) A. S. ANAND, *Intellectual Property - Indian Experience*, (1997) 6 SCC J.1; the object of the TRIPs agreement is to reduce distortions and impediments to the international trade. It provides adequate protection of Intellectual Property Rights. It ensures that the measures and procedures to enforce IPRs do not become barriers to legitimate interest. The GATT/TRIPs Agreements binds the member countries to bring their domestic laws in consonance with the provisions of these Agreements.

³⁶ TRIPs Agreement is the first inter international convention that expressly requires member countries to protect undisclosed information. See TRIPs agreement, Part I, Section 7 ('Protection of Undisclosed Information').

³⁷ On Comparison of TRIPs Agreement with Uniform Trade Secret Act, one can deduce that pro. RODNEY D RYDER, *BRANDS, TRADEMARKS AND ADVERTISING*, 318 (LexisNexis, Butterworths, New Delhi, 2003).

³⁸ For similar discussion refer, *Ruckelshaus v. Monsanto Co.* 467 U.S. 986; Also see, *Elanco Products Limited v. Mandops Limited* [1979] F.S.R. 46.

3.3 That mere publication does not amount to disclosure of confidential information.

3.3.1. The plaintiff submits that confidentiality is taken in account with respect to its availability in the public domain.³⁹ However, information may be confidential even if it comprises several elements that may be individually publicly known.⁴⁰ Regardless of the fact that patenting of an invention amounts to revelation of information underlying the invention, the confidentiality does not necessarily get destroyed with publication.

Mere publication does not amount to disclosure.

3.3.2. It is humbly submitted that, in the present factual matrix the defendant has failed to place on any reliance on the published article of 1974. The only other source is the insider's knowledge, which the defendant possesses by virtue of being an ex-employee of the plaintiff. The implied contractual jurisdiction applies in circumstances where the parties have not entered into any express term at all. Hence, in an absence of consent, express or implied of the plaintiff, to use the classified information, the defendant is liable for infringement of the plaintiff's rights.⁴¹

In case of absence of express covenant, implied covenant comes into existence.

4. THAT THE DEFENDANT IS LIABLE FOR TRADEMARK INFRINGEMENT.

It is humbly submitted that components of PSL's registered trademark 'DUSTNIBBLER' have been copied and placed at strategic places by the defendant in its flyer, thereby constituting trademark infringement⁴². When a defendant does business under a name which is sufficiently close to the name under which the plaintiff is trading and that name has acquired reputation, the public at large is likely to be misled⁴³ that the defendant's business is the business of the plaintiff or is a branch or department of the plaintiff, the defendant is liable.⁴⁴

4.1 That the use of trademark in advertising amounts to direct infringement.

4.1.1 The plaintiff is the registered user of the trademark 'DUSTNIBBLER' and is thus entitled to protection in case of infringement⁴⁵. The plaintiff's product, falling in a completely distinct class, is state of the art, introduced in the market with a distinctive trademark 'DUSTNIBBLER'. The product was an instant hit since its market launch shortly after plaintiff obtained patent in India and later gained a trans-border reputation. The defendant is engaged in exactly the same business as the plaintiff, and uses essential components⁴⁶ of the latter's word mark and trade dress in its flyers. Such piecemeal usage of essential features of trade dress and trademark of the plaintiff amounts to infringement.⁴⁷

³⁹ *Ackroyds (London) Ltd v. Islington Ltd* [11962] RPC 97 at 104 as per Havers J.

⁴⁰ *Weir Pumps Ltd & Others v. CML Pumps Ltd* [1984] PSR 33

⁴¹ *Saltman Engg. Co. v. Campbell Engg. Co. Ltd* [1978] 3 All E.R. 193.

⁴² Section 29 of the Trademarks Act provides: (1) A registered trademark is infringed by a person who, not being a registered proprietor...uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

⁴³ V. VASHISHTH, LAW & PRACTICE OF INTELLECTUAL PROPERTY IN INDIA, (Bharat Law House, New Delhi, 2002).

⁴⁴ *Montari Overseas Ltd. v. Montari Industries Ltd.*, 1996 PTC (16) 142.

⁴⁵ *Sri Swarn Singh Trading Appliances Emporium v. Usha Industries (India) New Delhi*, AIR 1986 Del 343.

⁴⁶ P. NARAYANAN., INTELLECTUAL PROPERTY LAW, 149 (2nd edn., Eastern Law House, Calcutta, 2000).

⁴⁷ "A mark is said to be infringed by another trader if, even without using the whole of it, but if uses its "essential features"...Ascertainment of an essential feature is not to be by ocular test alone; it is impossible to exclude consideration of the sound of words forming part or the whole of the mark." *S.M. Dyechem Ltd. v. Cadbury (India) Ltd.*, AIR 2000 SC 2115. Also see, KERLY, LAW OF TRADE MARKS AND TRADE NAMES, 14.21 (11th edn. London, Sweet & Maxwell, 1983).

4.2 That the use of synonymous suffix in word mark does not save the defendant's mark from infringing the plaintiff's trademark.

4.2.1 The plaintiff's word mark 'DUSTNIBBLER' is a coined term, comprising two generic words 'DUST' and 'NIBBLER'. The structure of the defendant's word mark is also same, with a change as the suffix NIBBLER is substituted by a synonymous suffix 'MUNCHER'. There exist certain common law rules, which have been often quoted as the basic rules for comparison of word marks.⁴⁸ The similarity in ideas conveyed by marks should be considered. When any distinctive arrangement or unusual features of the common elements are copied the mark is infringed.⁴⁹ Words conveying the same meaning or same idea are in general likely to cause confusion,⁵⁰ which is against the gist of the Act.⁵¹

Similarity in common elements amounts to infringement-ent..

4.3 That the use of device and common elements amounts to copying of trade dress.

4.3.1 The defendant has deceptively⁵² carried out what is simply a cut and paste job. The White streak device, a unique feature super-imposed on the plaintiff's word mark, has been adapted by the defendant's in their advertisement very prominently, forming an integral part of the background scheme of their advertisement⁵³. Additionally, the defendant's slogan "Another one Bites the Dust"⁵⁴ is a mere derivative of the plaintiff's "Bite the dust".⁵⁵ The cut and paste is not restricted to just discernable features like the device and slogan, but even color scheme bears resemblance. To any average person of imperfect reflection⁵⁶, such resemblances are likely to cause confusion.⁵⁷ By doing so, the defendant has ended up emulating essential features⁵⁸ of the plaintiff's trade dress. The Apex Court recognized that such situations would warrant an injunction⁵⁹.

Variation should be backed by proper reasoning and should not bears resemblance-ence.

4.3.2 The ascertainment of distinctive arrangement of common elements is also relevant to determine infringement. The defendant couldn't take a plea that his mark contains besides the plaintiff's mark other matters also⁶⁰. Relying on the above authority we contend that slight variations in appearance do not exonerate defendant from the liability.

⁴⁸ *In the matter of an Application by the Pianotist Company Ltd. for Registration of Trademark.* (1906) 23 RPC 774.

⁴⁹ *S. M. Dyechem Ltd. v Cadbury (India) Ltd.* (2000) 5 SCC 573

⁵⁰ *Harry Reynolds v. Lafferty's Ltd., Dodwell & Coy Ltd. & S. Gutterman & Co. Ltd.* (1958) RPC 387. In this case the words 'WaterMatic' and 'Aquamatic' were considered similar.

⁵¹ *Supra* note 40.

⁵² *Supra* note 41.

⁵³ Refer Flyers annexed with fact sheet.

⁵⁴ *Ibid*

⁵⁵ *Ibid*

⁵⁶ *Torrent Pharmaceuticals Ltd. v. The Wellcome Foundation Ltd.* (Guj) 2001 (2) CTMR 158. The Court applied the test of "Average person of imperfect re-collection abilities" for checking deceptive similarity.

⁵⁷ Similar representation can cause confusion. *Bhim Sain v. Janta Naswar Factory* 1997 PTC (17) 423.

⁵⁸ "A mark is said to be infringed by another trader if, even without using the whole of it, the latter uses one or more of its 'essential features'." *S.M. Dyechem Ltd. v. Cadbury (India) Ltd.*, AIR 2000 SC 2115

⁵⁹ *Ruston & Hornby Ltd. v. Zamindara Engineering Co. Ltd.* AIR 1970 SC 1649

⁶⁰ *Peshawar Soap & Chemicals Ltd. v Godrej Soap Ltd.* 2001 PTC 1 (Del.)