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(2010) 11 IPAB CK 0007

In the Intellectual Property Appellate Board

Case No : M.P. Nos. 6/2010, 28/2010, 50/2010 In ORA/5/2009/PT/CH, ORA/5/2009/PT/CH

Enercon India Ltd. APPELLANT

Vs

Aloys Wobben RESPONDENT

Date of Decision : 08-11-2010

Acts Referred:

Patents Act 1970 — Section 2(1)(s), 2(1)(j), 2(1)(ja), 2(1)(t), 2(1)(m), 2(1)(j), 2(1)(ja), 2(1)(t), 8, 10(4)(c), 58, 59, 59(1), 64, 64(1), 64(1)(e), 64(1)(f), 64(1)(m), 64(1)(i), 117D
Evidence Act, 1872 — Section 106
Intellectual Property Appellate Board (Procedure) Rules, 2003 — Rule 43, 43(1)(a)

Citation : (2010) 11 IPAB CK 0007

Hon'ble Judges : S. Usha, J;S. Chandrasekaran, Technical Member

Bench : Division Bench

Final Decision : Allowed

Judgement

,,,

S. Chandrasekaran, Technical Member",,,

This is an original application for revocation filed under Section 64 read with Section 117 D of the Patents Act 1970 (herein after referred to as the,,,

Act) for revoking the patent No. 200616 dated 8.7.1998 granted to the Respondent a German citizen.,,,

1. The impugned Patent was filed on 8.7.1998 having the priority date of 8-7-1997 and the Patent was granted on 23.02.2007 by the Patent Office,,,

after due examination of the Patent application having the title ""A SYNCHRONOUS GENERATOR"". The applicant is a Company registered under",,,

the Companies Act 1956, a subsidiary of ENERCON GmbH. Germany applied for the revocation of the Patent on the following grounds.",,,

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a. The subject matter of the Patent is not new (Section 64 (1) e); and,,,

b. The subject matter of the Patent is obvious and does not involve any inventive step (Section 64 (1)(f)); and,,,

c. The claims do not clearly define the scope of the invention. (Section 64 (1) (i)).,,,

2. The applicant stated that they are the one of the foremost leaders in the wind energy sectors in India and they manufacture and install wind turbines,,,

all over India and thus they are the interested person within the meaning of the Section 64 of the Act.,,,

3. The Respondent challenged the competency of the signatory to the application for revocation and the same was heard by this Appellate Board and,,,

passed an order disposing the matter to be decided along with the main matter. Aggrieved by this order, the Respondent appealed in the High Court,",,,

which was heard and disposed off by the Hon'ble High Court directing this Appellate Board to consider and dispose of this preliminary issue along,,,

with the main matter. The Miscellaneous petition was again heard as per the directions of the High Court.,,,

4. On completion of the pleadings, the matter was listed for final hearing on 7.10.2010 before this Bench. Shri R. Parthasarathy advocate appeared for",,,

the Applicant and the Respondent was represented by the advocate Shri Varun Sharma.,,,

5. On 6.10.2010, Respondent submitted M.P proposing amendments to the claims in the granted patent. As the M.P was filed only on the day prior to",,,

the date of hearing the Registry could not scrutinize the application and number the same and therefore was not listed before us. Consequently the,,,

same was not entertained.,,,

6. The Respondent filed a M.P. No. 50/2010 on 2-3-2010 questioning the locus standi of the applicant to maintain the present revocation application.,,,

Therefore this has to be considered first and disposed of. Before considering this question of locus of the signatory, let us look into the facts and",,,

background of the case as to its origin briefly.,,,

a. The applicant is a joint venture company. The applicant is involved in the manufacturing of wind turbine generators and setting up of wind farms on,,,

a turnkey basis. There are two shareholder groups of the applicant company, viz., Enercon GmbH, a company incorporated under German law owns",,,

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56% of the shareholding of the applicant company as a first shareholder. The members of the Mehra family own the remaining 44% of the,,,

shareholding of the applicant company as a remaining shareholder.,,,

b. There are 4 members on the board of the Applicant,",,,

2 representatives of Enercon GmbH,,,

2 representatives of the Mehra family,,,

The Chairman of the board is Dr. Aloys Wobben and the Managing Director of the applicant company is Mr. Yogesh Mehra.,,,

The actual day to day management of the affairs of the applicant company is to be carried out by the Managing Director of the company in India.,,,

c. In 2007, Enercon GmbH filed a petition under the Companies Act, 1956 in the Company Law Board, Principal Bench, New Delhi alleging",,,

oppression and mismanagement of the affairs of the applicant company by the Mehra group members. On 29.10.2007 the Company Law Board,,,

passed an interim order which directed ...."Status quo with regard to all the issues pending in the proceeding should be maintained and no action in",,,

relation to the same shall be taken"" (emphasis supplied). CLB further directed that ....."No changes shall be brought about in the managerial set up",,,

and their responsibilities."" On 19.5.2008 the CLB passed a further order stating that no further board meetings of the applicant company should be",,,

convened without the leave of the Company Law Board thus freezing all the meetings except the day to day activities of the applicant company.,,,

d. The said revocation applications have been filed in January 2009. They were filed in the name of the applicant company and were signed by Mr.,,,

Yogesh Mehra, the Managing Director of the applicant company. The counter statements were filed nearly after a year later by the Respondent.",,,

Along with the counter statement, miscellaneous applications were also filed questioning the locus standi of Mr. Yogesh Mehra to sign the said",,,

revocation applications for and on behalf of the applicant company. Mr. Yogesh Mehra has signed the revocation applications on the strength of a,,,

Board resolution dated 26.4.2007 which is quite evidently prior to the orders passed by the CLB dated 29.10.2007.,,,

e. The main arguments of the Respondent are as follows:,,,

The Board resolution dated 26.4.2007, by which Mr. Yogesh Mehra is authorized to file proceedings on behalf of the applicant company is bad in law",,,

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since it falls foul of the orders dated 29.10.2007 and 19.5.2008 passed by the CLB;,,,

The Board resolution only authorizes Mr. Yogesh Mehra to manage day to day activities of the applicant company and under the general powers, ""to",,,

defend the Company and file suits on behalf of the company on matters that may arise out of contractual laws, corporate laws, taxation laws or any",,,

other statutory acts"" but not to initiate these revocation proceedings;",,,

Mr. Yogesh Mehra having filed a suit in a derivative capacity in the Bombay High Court could not now file this proceeding on behalf of the applicant,,,

company;,,,

That the validity of the Board resolution has been challenged before the Company Law Board.,,,

This Appellate Board having been formed substituting for the High Court as regards finalizing the applications for revocation of patents, this Appellate",,,

Board like the High Court has the full powers to decide on all the matters of law and those connected matters of legal disputes under CPC;,,,

f. The aforesaid contentions have been refuted by the applicant. The applicant's senior counsel referred to the Supreme Court of India case in ""Patel",,,

Roadways Ltd. v. Birla Yamaha Ltd., (2000) 4 SCC 91"" to show how the Hon'ble Supreme Court of India has decided about ""a suit"".",,,

g. On perusing the entire details available in the records, it is seen that Mr. Mehra was authorized by the Board resolution dated 26-4-2007 to sign the",,,

pleadings i.e the revocation applications. The present revocation applications have been signed by Mr. Mehra by virtue of the said Board resolution,,,

dated 26.4.2007 which empowers Mr. Mehra to do so as is clear from the contents of the resolution produced before us. This Appellate Board cannot,,,

decide upon the validity, legality and propriety of this Board resolution dated 26.4.2007 and this Appellate Board, in the absence of any judgment or",,,

order of a competent Court of Law declaring the resolution to be null and void or staying the resolution, has to proceed on the footing and directions",,,

given therein and assume that the said resolution dated 26.4.2007 is perfectly valid and legal. Counsel for the Respondent during the course of,,,

arguments sought to urge grounds in support of the proposition that the resolution dated 26.4.2007 was not proper and legal. However as stated,,,

hereinbefore the legality and/or validity of the Board resolution dated 26.4.2007

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cannot be questioned in the present proceedings which are instituted,,,

under the provisions of Section 64 of the Act. The jurisdiction to test the validity and legality of the Board resolution does not rest with this Appellate,,,

Board. If that be so, then the obvious conclusion is that Mr. Mehra by virtue of the resolution dated 26.4.2007 is fully empowered to sign the suits /",,,

pleadings including all these revocation applications. As such there is no substance in the contention of the Respondent that Mr. Mehra has no,,,

authority to sign the pleadings. Further the contention of the Respondent is wrong that the applicant company cannot maintain the present revocation,,,

applications.,,,

h. It was further contended by the counsel for the Respondent that the present proceeding is not a suit and as such the resolution dated 26.4.2007,,,

cannot be taken to have empowered Mr. Mehra to sign the same. This argument too is without any substance. It cannot be said that the present,,,

proceeding is not a suit especially in the light of the arguments of the counsel of the Respondent made already, that this Appellate Board is a Court for",,,

all practical purposes, having regard to the nature of the powers and jurisdiction vested in it by statute, which appears that the Respondent is",,,

contradicting his own arguments made already before us. Reliance can be placed in this regard on the law laid down by the Supreme Court of India in,,,

Patel Roadways Ltd. v. Birla Yamaha Ltd., (2000) 4 SCC 91. The Hon'ble Supreme Court at paragraph 48 and 49 observed as follows:",,,

i. ""Suit, Action - 'Suit' is a term of wider signification than action; it may include proceedings on a petition.",,,

49. From the above it is clear that the terms ""suit"" is a generic term taking within its sweep all proceedings initiated by a part for realization of a right",,,

vested in him under law. The meaning of the term ""suit"" also depends on the context of its user which in turn, amongst other things, depends on the",,,

Act or the rule in which it is used. No doubt the proceeding before a National Commission is ordinarily a summary proceeding and in an appropriate,,,

case where the Commission feels that the issues raised by the parties are too contentions to be decided in a summary proceeding it may refer the,,,

parties to a civil court... A proceeding before the National Commission, in our considered view, comes within the term ""suit."""",,,

j. Therefore, as can be seen from the Supreme Court ruling, the term ""suit"" is

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not to be strictly construed but construed in the manner in which it is",,,

used. The term ""suit"" has been used in the Board resolution in the context of 'initiation of proceedings' and has to be liberally construed. That apart, the",,,

above mentioned Supreme Court decision, and particularly the admission of the counsel for the Respondent that this Appellate Board is a Court,",,,

clearly establishes that the proceedings before this Appellate Board would also be in the nature of a suit and as such it is clear that Mr. Mehra is,,,

competent to sign the present revocation applications.,,,

k. As regards the derivative action, the circumstances in which the same were filed have no bearing on the present proceedings. The mere filing of a",,,

derivative action cannot and does not act as estoppel of Mr. Yogesh Mehra from filing these revocation applications. The argument of the counsel for,,,

the Respondent in this regard is therefore completely irrelevant and not germane to the issue as to whether Mr. Mehra has the authority to sign the,,,

present proceedings.,,,

l. It was next contended that Enercon GmbH has filed an application before the Company Law Board, New Delhi praying for a stay of the operation",,,

of the Board resolution dated 26.4.2007. The said application was filed on 5.10. 2010. The said application came up for admission on 19.10. 2010,,,

wherein a stay of the operation of the resolution was sought. The Company Law Board has however not granted any interim order. Therefore, as on",,,

date, the Board resolution is valid and subsisting. It has not been set aside or stayed by any court / judicial body. Under these circumstances, it cannot",,,

be said that Mr. Mehra has no locus or authority to sign the revocation applications on the strength of the resolution dated 26.4.2007. As such it cannot,,,

also be held that the applicant company is not a person within the meaning of Sections 2(1)(s) or 64 of the Act.,,,

m. Lastly, reliance by the Respondent on the interim orders passed by the CLB dated 29.10.2007 and 19.5.2008 is completely misconceived and",,,

misconstrued for the sole reason that these orders have been passed after the resolution dated 26.4.2007 and cannot in any manner have any,,,

relevance on the issue as to whether Mr. Mehra has the authority to sign the revocation applications in the present case, particularly when the Board",,,

resolution has not been made null and void.,,,

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7. Basics and objects of the invention to understand the background and nomenclature in respect of ""A SYNCHRONOUS GENERATOR"" are:",,,

Synchronous machine,,,

The rotor of a common synchronous machine comprises a constant magnetic field, which is either provided by constant magnets arranged on the rotor",,,

or by a DC current flowing through windings on the rotor and this way generating the magnetic field. In this latter example, it is common to provide",,,

the DC current by means of a slip ring to the rotating rotor. However, even though slip rings are used, the direction of the DC current In the rotor",,,

windings does not change and thus the direction of the magnetic field of the rotor does also not change. In order to rotate the rotor, a rotating magnetic",,,

field is provided at the stator. This rotating magnetic field moves the rotor. Accordingly, the rotor just rotates synchronously with the rotation of the",,,

magnetic field of the stator. Said rotational movement of the magnetic field of the stator is provided by means of a plurality of poles, each carrying a",,,

winding. Each winding provides an alternating magnetic field at the corresponding stator pole due to an alternating current flowing through the,,,

corresponding winding. /\s the alternating currents provide a phase shift from one pole to the next, the magnetic field, at least its peak, appears at one",,,

stator pole after another, resulting in the magnetic field effectively moving from one pole to another and thus rotating along the stator.",,,

FIG. SM-1,,,

8. The picture FIG. SM-1 shows the construction of a synchronous machine. The rotor-shown in the middle rotates in the direction indicated by two,,,

arrows. ""The rotor is constructed as an armature carrying a rotor winding. A DC current IR flows through the winding resulting in a magnetic field on",,,

the rotor having a north pole N and a south pole S. The rotor is surrounded by the stator. The stator according to the shown example comprises 6,,,

stator poles (1) to (C3). Each stator pole has a winding and into each of these six windings, there is input an individual current, 11 to l6. Each of these",,,

currents 11 to l6 alternates between a maximum and a minimum value (the minimum value is the negative amount of the maximum value) with the,,,

same frequency, but comprising a phase shift. i. e., each of these six currents 11 to l6. reaches its maximum value at a different point of time than the",,,

other currents. This way, a magnetic field is generated in each stator pole being

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proportional to the corresponding current and thus also alternating in",,,

the same way as the corresponding current.,,,

9. If for example there is a time shift between each subsequent stator pole of one second, the magnetic field of the second stator pole (2) will reach its",,,

maximum value one second after the magnetic field of the first stator pole (1) had reached its maximum value. Another second later, the magnetic",,,

field of the third rotor pole (3) will reach its maximum value and so on. Accordingly, after 6 seconds, the magnetic field of the first stator pole (2) will",,,

reach again its maximum value. According to this example, the magnetic field rotates around the stator within 6 seconds (which is in fact a fairly slow",,,

rotation).,,,

10. When there is a maximum magnetic field at the first stator pole (1), the fourth stator pole (4) opposing the first stator pole also comprises a",,,

maximum magnetic field, but with opposite direction (with respect to the centre of the machine). In other words, when the magnetic field of the first",,,

stator pole comprises a north pole towards the rotor, the fourth stator pole comprises a magnetic field having a south pole towards the rotor. This",,,

situation is indicated in the above figure FIG. SM-1 by the letters N and S respectively.,,,

11. The resulting movement of the rotor can be explained such that the north pole of the corresponding stator pole pushes the north pole of the rotor,,,

and in the same way. The south pole of the stator pushes the south pole of the rotor resulting in the same rotational direction. While the rotor moves,,,

this way, the magnetic field of the stator also moves and thus keeps the rotor moving.",,,

12. According to this principle, the magnetic field of the stator moves with the same rotational speed as the rotor. This is a fundamental principle of",,,

this machine and also the reason for the name of the machine, i.e. the name ""Synchronous machine"".",,,

13. The following FIG. SM-5 illustrates a time-diagram of each of the currents I1 to l6. All currents have a sinusoidal wave form, wherein the",,,

maximum of each of these six currents appears at a different point in time. In the diagrams, there is one straight vertical dashed line, indicating the",,,

point of time of the illustrated situation according to the shown synchronous machine. As can be seen, the current h has its maximum value and the",,,

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current I1 has its minimum value. Accordingly, the magnetic field at the stator pole 1 is maximum (generating a north pole) and so is the magnetic field",,,

at the stator pole 4, but with opposite direction (generating a south pole). Each of the currents I1 to l6 and thus each of the magnetic fields of the",,,

corresponding stator pole alternate. The diagrams in fact illustrate a common alternating, sinusoidal current, which is generally available in common",,,

public grids. In fact, there are not six, but three different currents, as the currents I4 , l5 and I6 are just the negative currents of l1 , l2 and l3",,,

respectively.,,,

In other words, the shown synchronous machine can simply be run in motor mode by using a common three-phase system, as the general public grid.",,,

14. It is to be noted that as described above, this synchronous machine is completely different to a DC machine (DC-motor) as it uses alternating",,,

(sinusoidal) currents. No commutator or the like is needed. Even though, the magnetic field does not move stepwise but continuously from one stator",,,

pole to another enabling a smooth movement of the rotor.,,,

15. A synchronous machine can often be used as a synchronous motor and a synchronous generator as well. If the synchronous machine is used as a,,,

synchronous generator, the movement of the rotor and thus the movement of the magnetic field of the rotor relatively to the stator poles induces an",,,

electric current in the corresponding windings of the stator poles. The corresponding current rises with the corresponding rotor pole approaching the,,,

corresponding stator pole and falls when the rotor pole moves further to the next stator pole. This way, it is possible, to generate a continuously",,,

alternating current in each stator winding, in particular it is possible, to generate a sinusoidal current in each winding.",,,

16. To summarize a synchronous generator comprises a rotor with a constant magnetic field, which forces the rotor to rotate (motor mode) or which is",,,

generated by the rotating rotor (generating corresponding sinusoidal currents (generator mode).,,,

17. Arguments by the Applicants,,,

The counsel for the Applicant started his argument inviting our attention to the definition of the ""invention"" as under Section 2(1)(j), ""inventive step"" as",,,

under Section 2(1)(ja) respectively of the Act. The counsel submitted that how the applicant is a person interested and what is the definition of ""person",,,

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interested"" as given in Section 2(1)(t) of the Act. Then the counsel submitted his arguments as follows:",,,

1. A Patent is granted for a single invention only. Accordingly the claims and the complete specification shall relate to a single inventive concept.,,,

2. The ORA and M Ps were listed originally for hearing on 09.08.2010, but on the request of the Respondent, time was granted till 06.09.2010 for both",,,

the parties to complete the pleadings i.e. particularly for Respondent to file expert affidavits, if any, in response to the rejoinder and affidavit of the",,,

applicant. The matter was listed for hearing on 13.09.2010 and later adjourned to 14.09.2010. However, on 6th October 2010 the Respondent filed",,,

their expert affidavits and also filed a Miscellaneous Petition for amending the claims one day before the hearing. The Hon'ble Board considered the,,,

Respondent's expert affidavit for arguments, in the interests of justice, despite it being filed in the last minute.",,,

3. The Hon'ble Board did not consider the Respondent's Miscellaneous Petition for amending the claims as the same had not even been numbered by,,,

the Registry and placed in the folders of the Bench on the date of hearing.,,,

4. It was pointed out that the Respondent's Expert Affidavit was signed on 10.09.2010 and notarised on that date itself, but was submitted to the",,,

Registry only on 4.10.2010. This clearly shows the intention of the Respondent to hold back his evidence and see what happens till the last minute and,,,

deny reasonable opportunity to the applicant.,,,

5. The counsel argued inviting our attention to the definition of the ""patent"" as under Section 2(1)(m), ""invention"" as under Section 2(1)(j), ""inventive",,,

step"" as under Section 2(1)(ja), respectively of the Act. The counsel submitted that how the applicant satisfies the condition of ""person interested"" and",,,

what is the definition of ""person interested"" as given in Section 2(1)(t) of the Act.",,,

6. It was submitted that a patent is granted for an invention and invention can be a product or process but that has to be new, and should involve an",,,

inventive step and has to have the industrial application.,,,

7. The inventive step is a two-step analysis. At first, to identify from the claims (since the claims define the invention for which protection is sought as",,,

per Section 10(4)(c)) that particular feature or features which represents the technical advance or economic significance or both.,,,

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8. Only after that feature is identified it is necessary to examine the question whether that feature is obvious or not to the person skilled in the Article,,,

9. If the analysis in the earlier step results in a finding of no such feature then the alleged invention lacks inventive step.,,,

10. It was submitted that a generator is a machine which converts mechanical energy into electrical energy. On the other hand a motor converts,,,

electrical energy into mechanical energy. Further, it was submitted that the principle of working of a motor and a generator are very closely related.",,,

11. It was submitted that every synchronous generator has a stator, inside which an armature moves, the armature is also referred to as the rotor of",,,

the generator, and the rotor is directly coupled with rotor blades of the wind power plant. Further, it was also pointed out that the rotor is designed as a",,,

salient-pole machine i.e., the poles are projecting on the rotor surface and multiple pole shoes are arranged on the rotor. (The above features are",,,

mentioned in the impugned patent as seen at lines 24 to 31 at page 22 of the revocation application).,,,

12. It was submitted that synchronous generators in wind power installations emit a lot of noise. Thus, the construction and design of the generator has",,,

to be such that the emission of noise is as low as possible. (This feature was also shown from the impugned patent at lines 1 to 6 at page 23 of the,,,

revocation application).,,,

13. It was submitted that known generators i.e. generators prior to the priority date of the impugned patent were not always able to achieve low noise.,,,

It was also pointed out that every object vibrates at a natural frequency. Thus, when a stator of the generator vibrates at its fundamental frequency it",,,

gets into resonance, which results in generation of noise. (These submissions were shown from the impugned patent at lines 7 to 17 at page 23 of the",,,

application).,,,

14. It was submitted that torque is a measure of the turning force on an object and whenever there are fluctuations in torque it will result in vibration.,,,

Thus, any torque fluctuation in a generator will result in vibration which in turn will result in generation of noise and the same is well known in the",,,

Article (This has been admitted by the Patentee at page 23 of the application, lines 29 to 33)",,,

15. The object of the impugned patent is to provide a synchronous generator

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which eliminates the noise which is generated due to vibrations.,,,

16. It was submitted that multiple pole shoes distributed with an even spacing or constant spacing between two adjacent poles on the rotor of a,,,

generator is well known in the Article This has also been admitted by the Patentee at page 25 of the application, lines 19 to 21.",,,

17. Thus, it can be ascertained from the specification of the impugned patent that a synchronous generator with a stator and rotor with poles",,,

distributed evenly on the rotor is well known in the Article Further, it was also well known that torque fluctuations in a generator results in vibration,",,,

which in turn results in generation of noise.,,,

18. It is common general knowledge that every object has a natural frequency or a fundamental frequency at which it resonates and results in noise.,,,

Thus, if an object does not reach its natural frequency, there will be reduction in vibration, which in turn will result in reduction in noise.",,,

19. Attention was invited to lines 6 to 13 at page 25 of the revocation application and it was submitted that the Respondent is achieving the noise,,,

reduction in the synchronous generator in two ways. First by distributing individual poles on the circumference of the rotor in an asymmetrical manner,,,

and secondly by asymmetrical pole shoes i.e. by changing the pole shoe geometry. Further, the two measures can be implemented separately or in",,,

combination to achieve the noise reduction.,,,

20. It was submitted that when poles are distributed symmetrically on the rotor the edges of the pole front or rear with respect to the direction of,,,

movement of the rotor move past a groove of the stator (a stator has multiple grooves) synchronously at the same time. This results in mechanical,,,

impulse being produced at each groove of the stator, which excites the stator into vibration. This excitation frequency hits the fundamental frequency",,,

of the stator, which generates high noise levels. This fact is supported in the impugned patent at page 25, lines 21 to 34.",,,

21. It was submitted that according to the impugned patent by arranging the poles in an asymmetrical manner on the rotor, the mechanical impulses,",,,

which induce the vibrations are no longer transmitted simultaneously from the rotor poles to the stator grooves. As the excitation frequency does not,,,

reach the fundamental frequency of the stator, less noise is produced. Thus, asymmetrical distribution of poles on the rotor results in reduction of noise",,,

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emission. This fact is supported in the impugned patent at page 26, lines 6 to 12.",,,

22. Thus, the improvement or the inventive step by the patentee is in the asymmetrical arrangement of the poles in the rotor, in a known synchronous",,,

generator.,,,

18. The applicant's counsel continued his arguments next based on the grounds relied in the revocation application and submitted as follows;,,,

A. Claims of the patent are anticipated:,,,

a. It was submitted that the applicant is not pressing this ground.,,,

B. Claims of the patent are obvious,,,

a. The claim 1 relates to ""A synchronous generator having a generator stator (16) and a generator rotor (12) which can move relative to the stator",,,

(16) and has n poles (14), for producing electrical power, with the waveform of the induced voltage in one stator winding or in a number of stator",,,

windings corresponding the current waveform in one stator winding or the sum of at least m current elements (I1, I2) in m stator windings,",,,

characterized in that poles (14) are disposed asymmetrically on the rotor (12)"".",,,

b. It was submitted that the invention lies in the claim as a whole but the inventive step lies in the post characterization part. At, this juncture,",,,

reference was made to the Affidavit of European expert (Dr. Rudolph Teschemacher) and it was submitted that, the expert at page 10 has made a",,,

submission that though the claim is in two parts, the invention lies in the claim as a whole.",,,

c. Further, the Expert has also stated at paragraph 8 page 10 that where the claim is written in a two part format, the examination division may",,,

assume that what precedes the characterized portion is known. Thus, the expert also states that the claim elements preceding the characterized",,,

portion are known in the Article While it is known that the invention is in the claim as a whole, the inventive step is only in the improvement effected",,,

by the patentee.,,,

d. Further, the expert at Page 10 has also referred to the US practise of writing claims in the Jepson Format which is mandatory. A Jepson claim is a",,,

two part claim which sets out in the preamble what is known in the art and the second part sets out the improvement which is inventive step of the,,,

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invention.,,,

e. Thus the inventive step lies in the present case, only in the disposition of the poles on the rotor in an asymmetrical manner, which results in reduction",,,

of noise, which are found in the post characterization clause of the claim 1 in the impugned patent.",,,

f. Dependent claim 2 at page 44 of the revocation application was referred to and it was submitted that the inventive step of claim 1 and claim 2 are,,,

the same. Thus, the dependent claim 2 does not add any new feature towards the inventive step in the principal claim 1.",,,

g. The dependent claim 3 was referred to and it was submitted that it relates to pitch of the poles being not constant. Further, it was submitted that the",,,

pitch of the poles is the distance between the centre's of the poles. Thus the distance between the centre of the poles is not constant, which is the",,,

same as the feature claimed in claim 1.,,,

h. The dependent claim 4 was referred to and it was submitted that it relates to poles on the rotor being arranged with 3 different pole pitches, which",,,

also indicates asymmetry and hence does not add any new feature to the inventive step claimed in the claim 1.,,,

i. It was submitted that the further dependent claims 5 to 12 relate only to the geometrical configuration of the pole shoe head.,,,

j. Attention was invited to the decision of the Court of Appeal of United Kingdom in 1985 RPC 55 Wind Surfing International Inc., v. Tabur Marine",,,

Great Britain Limited. It was pointed out that the question of obviousness involves analysis of the following four steps, viz.,",,,

(a) Identifying inventive step embodied in the patent.,,,

(b) Imputing to a normal skilled but unimaginative addressee what was common general knowledge in the art at the priority date.,,,

(c) Identifying difference, if any, between the matter cited and the alleged invention and",,,

(d) Decide whether the invention constitutes steps which would have been obvious to a skilled man, without any knowledge of the alleged invention.",,,

k. The above approach to obviousness was also restated by the High Court of Justice, Chancery Division, Patent Courts in 2007 EWHC 2636 (Pat)",,,

between Mr. Aloys Wobben and Vestas Celtic Wind Technology Ltd.,",,,

l. Para 141 of this decision which is relevant is extracted here below.,,,

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m. 141. The correct approach to the issue of obviousness has recently been restated by the Court of Appeal in Pozzoli v. BDMO SA (2007) EWCA,,,

Civ 588:,,,

i. (a) Identify the notional ""person skilled in the art""",,,

(b) Identify the relevant common general knowledge of that person;,,,

ii. Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;",,,

iii. Identify what, if any, differences exist between the matter cited as forming part of the ""state of the art"" and the inventive concept of the claim or",,,

claim as construed;,,,

iv. Ask whether, viewed without any knowledge of the alleged invention as claimed, those differences constitute steps which would have been obvious",,,

to the person skilled in the art or do they require any degree of invention.,,,

n. Attention was invited to the affidavit of expert Dr. Rudolf Teschemacher, which was filed in the present application.",,,

o. In particular it was pointed out with reference to page 28 attachment 3 of the said affidavit and pages 27 to 29 that the obviousness analysis,,,

according to the expert is conducted in the EU per the following 3 steps.,,,

i. Determination of closest prior Article,,,

ii. Establishing the objective technical problem to be solved,,,

and,,,

iii. Considering whether or not the claimed invention, starting from closest prior art and the objective technical problem, would have been obvious to",,,

the skilled person.,,,

p. Closest prior art is that which in one single reference discloses the combination of features which constitutes the most promising starting point for,,,

an obvious development leading to the invention.,,,

q. In identifying closest prior art account may be taken from the patent specification of what is acknowledged as known.,,,

r. The objective technical problem is the difference between the claim and the closest prior art in terms of the feature that produces the technical,,,

effect.,,,

s. The last question to be answered is whether there is any teaching in the prior

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art as a whole that would have prompted the skilled person faced with,,,

objective technical problem to adopt the closest prior art to arrive at the invention claimed.,,,

t. In the present case, applying the principles enunciated above, the following facts are noticed:",,,

i. A synchronous generator with a stator and a rotor, with the rotor having poles distributed evenly or symmetrically i.e. the space between any two",,,

adjacent poles is the same, is well known;",,,

ii. The said known synchronous generator does not always minimize noise;,,,

iii. Torque fluctuation results in noise;,,,

iv. Reduction of noise, starting from the known synchronous generator, by effecting improvement is the objective technical problem to be solved;",,,

v. Any prior art in the field of electrical generator or the related field of electrical motors which teaches reduction of noise will be a relevant prior,,,

Article,,,

u. Keeping the above background to obviousness analysis, submissions were made on the second ground that claims do not involve any inventive steps",,,

and the steps would have been obvious to a person skilled in the Article,,,

19. Reference to US 5,111,095 patent (herein after referred to US '095 patent -- Annexed at page 54 of the revocation application)",,,

a. The US '095 patent relates to switch reluctance motor. It was submitted that switch reluctance motor works on the principle of magnetic resistance,,,

i.e. like poles of a magnet repeal each other. In a switch reluctance motor magnetic poles are disposed on the rotor and the stator. The poles on the,,,

rotor are permanent magnets with fixed polarity, while the poles on the stator are electromagnets where polarity can be switched / changed.",,,

b. Further, it was reiterated that the principle of operation of a generator and a motor are inter-related. Thus, a person skilled in the art facing the",,,

technical problem outlined above would consider the teachings of prior art related to motors to be relevant.,,,

c. Attention was invited to page 64 of the revocation application, column 3, lines 47 to 50 of US '095 patent and it was submitted that one of the",,,

objects of US '095 patent was to reduce torque ripple characteristics. Further, it was submitted that it was common general knowledge to the person",,,

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skilled in the art that reduction in torque will result in reduction of vibration which in turn will result in reduction of noise. Hence, the teaching of",,,

US'095 Patent would be relevant to a person skilled in the Article,,,

d. Attention was invited to column 4, lines 22 to 24 at page 64 of the revocation application and it was submitted that the US '095 patent discloses that",,,

salient poles on the stator are evenly spaced and salient poles on the rotor are unevenly spaced i.e. Asymmetrical disposition.,,,

e. Attention was invited to column 11, lines 19 to 25 at page 68 of the revocation application which discloses the angle a 1 between pairs of adjacent",,,

rotor poles forming non-overlapping magnetic circuits (i.e, inter-pair angle) and the angle a2 between adjacent rotor poles of different pairs (i.e., intra-",,,

pair angle) are different. Thus, the poles on the rotor are disposed asymmetrically and the same is also evident from fig. 4A at page 57 of the",,,

application.,,,

f. Thus, US '095 patent discloses the inventive step of claim 1 of the impugned patent.",,,

20. Reference to US 4,883,999 patent (herein after referred to US '999 patent -- Annexed at page 71 of the revocation application)",,,

a. Attention was invited to the abstract of the US '999 patent and it was submitted that it relates to switch reluctance motor. Further, it was reiterated",,,

that the principle of operation of a generator and a motor are inter-related. Thus, when a person skilled in the art addresses the problem of the",,,

impugned patent would consider the teachings of prior art related to motors which are found to be relevant.,,,

b. Attention was invited to the abstract of US '999 patent, lines 14 to 16 at page 71 of the revocation application. It was submitted that the first",,,

member has unevenly spaced poles. i.e Asymmetrical distribution.,,,

c. Attention was invited to column 3, lines 11 to 27 of the US '999 patent and it was submitted that discloses uneven spacing of poles on either the",,,

rotor or stator. Thus, US'999 patent discloses the inventive step of claim 1 of the impugned patent.",,,

d. Further, it was pointed out that the US '999 patent states that uneven spacing provides torque to the rotor. Thus, it is a common general knowledge",,,

that torque fluctuation result in vibrations, which in turn results in generation of noise. Hence, a person skilled in the art, when faced with the problem",,,

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addressed by the impugned patent would consider the teachings of US'999 patent which has been found to be relevant.,,,

e. Further, It was submitted that a person skilled in the art when faced with the problem addressed by the impugned patent would borrow the concept",,,

that asymmetrical distribution of poles on a rotor in a switch reluctance motor results in reduction of noise from the teachings of US '095 patent and,,,

US '999 patent and adopt the same concept in a synchronous generator.,,,

21. Reference to US 3,032,670 patent (herein after referred to US '670 patent -- Annexed at page 120 of the revocation application)",,,

a. It was submitted that US '670 patent has been cited in the revocation application as a prior art disclosing the features of dependent claim 10 of the,,,

impugned patent.,,,

b. US '670 patent discloses the use of trapezoidal poles on the rotor. The relevant portion is extracted below:,,,

In the present invention, as shown in the disclosed embodiment, the rotor poles are of trapezoidal configuration that is one edge of each rotor pole",,,

slopes so that the pole root have a greater width then the pole tips. (Column 1, line 72 to Column 2 line 3)",,,

c. Thus, US '670 patent discloses the content of Claim 10 of the impugned patent.",,,

d. Attention was invited to column 3, lines 43 to 47 of the US '670 patent and it was submitted that US '670 patent discloses that the trapezoidal shape",,,

of the pole is resulting in reduction of torque fluctuations. Thus, a person skilled in the art, when faced with the problem addressed by the impugned",,,

patent would consider the teachings of US '670 patent to be relevant. As abrupt changes in torque i.e. torque fluctuations result in vibrations and the,,,

trapezoidal rotor poles by their slope prevent such abrupt changes it will result in noise reduction. The trapezoidal poles are the second way -,,,

asymmetrical pole shoes - disclosed by the Respondent.,,,

22. Submissions on counter statement of the Respondent,,,

1. It was argued that the Respondent has submitted that at para 17-19 and 22-26 of the counter statement, the US '999 patent and US '095 patent",,,

relate to a switch reluctance motor, which is different from a synchronous generator and thus these citations would not stand as a relevant prior arts",,,

and hence it cannot be considered.,,,

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2. In response to this it was submitted that a person skilled in the art in the context of the impugned patent is an electrical engineer having the,,,

complete knowledge of synchronous generator. Further, this person skilled in the art also has full knowledge of analogues fields. This person skilled in",,,

the art would be thorough with the principle of operation of an electrical motor, which also normally includes a switch reluctance motor, as it is only an",,,

analogues field for this person skilled in the Article Thus this person skilled in the art when faced with the problem of the impugned patent would,,,

borrow the concept that asymmetrical distribution of poles on a rotor in a switch reluctance motor results in reduction of noise from the teachings of,,,

US '095 patent and US '999 patent and adopt the same concept in a synchronous generator to achieve the object of this invention.,,,

Reply to the counter statement.,,,

23. It was submitted that the Respondent has stated that before the priority date of the impugned patent it was not known that asymmetrical,,,

distribution of the poles on the rotor will result in reduction of noise in a synchronous generator.,,,

24. Attention was invited to paragraph 8, page 4 of the Reply and it was submitted that US equivalent of the IN'616 Patent was granted after",,,

substantial amendments, which information was not provided to the Indian Patent Office, as required under Section 8. The, application of the",,,

Respondent to amend the claims in US during prosecution was referred to (annexed at page 19 of the reply) and it was submitted that the Respondent,,,

had amended the claims in US on May 3, 2004, while the date of publication of grant of Indian Patent 200616 was 23.2.2007. This fact was not",,,

brought to the notice of the Indian Patent office. Further, it was submitted in light of the deliberate suppression of information required to be provided",,,

by the Respondent under Section 8, the IN '616 Patent is liable to be revoked under Section 64(1) (m). In this context the judgment of the Delhi High",,,

Court in Chemtura Corporation v. Union of India 2009 (41) PTC 260 (Del.) was relied on.,,,

Citation of Non-patent literature,,,

25. Attention was invited to page 83, para 4 of the Reply and it was submitted that the NPL discloses arrangement of rotor slot at irregular interval i.e",,,

asymmetrical distribution in order to reduce magnetic noise. The reference was

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made to page 84, para 5 of the reply to the counter statement, wherein",,,

it has been referred to this report publication titled, ""Magnetic Noise Reduction Method of Inverted Driven Induction Motor Using Non-uniform Slots",,,

Pitched Core"" and written by Yuji Akiyama and Takayuki Sakamoto and published on 25-9-1995.",,,

26. Thus, it was submitted that a person skilled in the art when faced with the problem addressed by the impugned patent would easily apply the",,,

concept that asymmetrical distribution of poles on a rotor in a motor results in reduction of noise from the teachings of the NPL and adopt the same,,,

concept in a synchronous generator.,,,

Reference to 4,263,526 patent (Annexed at page 72 of the Reply)",,,

27. Reference was made to the above US 4,263,526 patent (herein after referred to as US '526 patent) and the comment of the Respondent was this",,,

US '526 patent discloses only about ""AC generator"".",,,

28. Attention was invited to column 1, lines 29 to 30 and then column 2, lines 43 to 55 at page 76 of the Reply, and it was submitted that US'526 patent",,,

discloses that magnetic sound i.e. noise which is generated due to torque variation i.e. torque fluctuation can be reduced by deviating the rotor poles,,,

relative to the tooth portions of the armature iron core i.e., the stator. Further, it also discloses that due to the deviation of the poles on the rotor it",,,

sharply reduces the magnetic sound generated due to the torque variation.,,,

29. Attention was invited to fig. 3 at page 74 and description of fig.3. at column 3, lines 14 to 36 at page 77 of the Reply and it was submitted that the",,,

broken lines in fig. 3 represents the arrangement of the poles on a rotor in a conventional generator at an equal pitch i.e. in symmetrical manner.,,,

Further, the unbroken line represents the arrangements of the poles on a rotor in an unequal pitch i.e. asymmetrical manner as claimed by the US'526",,,

patent. Further, it was pointed out that it is evident from fig.3 that the poles on the rotor are deviated by an angle from the conventional arrangement,",,,

which has resulted in asymmetrical arrangement of poles on the rotor.,,,

Submissions on expert affidavits submitted by the applicant,,,

30. The expert affidavit of Mr. Devendra Kumar Bhatnagar at page 26 of the reply was referred and it was submitted that the expert concurs with,,,

the submissions in the revocation application that the inventive step of claim 1 is

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obvious to him in the light of the teachings of US '095 Patent and US,,,

'999 Patent. Further, at paragraph 26 of the affidavit, the expert has also relied on US '526 Patent and also NPL to support his opinion that",,,

asymmetrical distribution of poles on a rotor will result in noise reduction was well known in the art before the priority date of the impugned Patent.,,,

31. The expert affidavits of Mr. Dilip Trasi at page 47 of the reply and Mr. R.S Barve at page 88 of the reply were also referred to and it was,,,

submitted that the experts have in their opinion found that the inventive step of claim 1 is obvious in the light of the teachings of US 5,315,198 patent",,,

(herein after referred to as US '198 patent).,,,

US 5,315,198 patent (Annexed at page 104 of the Reply)",,,

32. Attention was invited to column 1, lines 5-6; and column 1 lines 29-34 at page 112 and claim 7 at page 116 and it was submitted that the invention",,,

relates to a synchronous machine, which consists of electromagnetic poles on the rotor and the gap between these poles have alternately different",,,

sizes. Thus, it discloses that the distance between the poles on the rotor are not constant i.e. poles are disposed asymmetrically on the rotor.",,,

Submissions on expert affidavit Dr. Rudolf Teschemacher submitted by the Respondent (annexed at page 9 of unnumbered M.P filed by the,,,

Respondent for taking independent technical expert affidavits on record),,,

33. In particular it was pointed out with reference to page 28 attachment 3 of the said affidavit and pages 27 to 29 that the obviousness analysis,,,

according to the expert is conducted in the following 3 steps.,,,

(a) Determination of closest prior Article,,,

(b) Establishing objective technical problem to be solved and,,,

(c) Considering whether or not claimed invention, starting from closest prior art and the objective technical problem, would have been obvious to the",,,

skilled person.,,,

34. Closest prior art is that which in one single reference discloses the combination of features, which constitutes the most promising starting point for",,,

an obvious development leading to the invention. In identifying closest prior art account should be taken of the disclosure of the patentee himself as to,,,

what he acknowledges in his description of the claims to be known.,,,

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35. Thus, in the context of the impugned patent, the closet prior art has been disclosed in the specification itself as a synchronous generator having a",,,

symmetrical distribution of poles on the rotor. Thus, for a person skilled in the art this will be the starting point and not a switch reluctance motor.",,,

36. The technical problem addressed by the impugned patent is generation of noise in a synchronous generator. The generation of noise is reduced by,,,

asymmetrical distribution of poles on the rotor.,,,

37. The last question to be answered is whether there is any teaching in the prior art as a whole that would prompt a skilled person faced with,,,

objective technical problem to arrive at the invention claimed.,,,

38. The teaching of US '095 patent discloses asymmetrical distribution of poles on a rotor and it also discloses that one of the object of the patent is to,,,

reduce torque ripple characteristics i.e. reduction in torque fluctuations. Thus, a person skilled in the art would be prompted to look into the teachings",,,

of US '095 patent when faced with the problem addressed by the impugned patent.,,,

39. The teachings of US '526 patent and NPL disclose asymmetrical distribution of poles on the rotor and it also discloses that asymmetrical,,,

distribution of poles on the rotor results in reduction of noise. Thus, a person skilled in the art would be prompted to look into the teachings of US'526",,,

patent and NPL when faced with the problem addressed by the impugned patent.,,,

Submissions on expert affidavit Dr. Ulf Schuemann submitted by the Respondent (annexed at page 77 of unnumbered M. P filed by the Respondent,,,

for taking independent technical expert affidavits on record),,,

40. The contents of paragraph 6 of the present affidavit were referred to and it was submitted that the Respondent's expert has stated that a high,,,

noise emitting synchronous generator is well known in the Article Further, the Respondent's expert also states that the asymmetrical distribution of",,,

poles on a rotor results in reduction of noise in the synchronous generator. The inventive step is thus very clear i.e. asymmetrical distribution of poles.,,,

41. The content of unnumbered paragraph 3 of paragraph 7.2 of the present expert affidavit was referred to and it was submitted that the,,,

Respondent's expert states that a switch reluctance motor can be operated as a generator. Thus, the Respondent's expert acknowledges that the",,,

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principle of working of a motor and generator are interrelated.,,,

Arguments by Respondent,,,

42. The counsel for the Respondent started his arguments first referring to the M.P No. 50 of 2010, where the Respondent had challenged Mr.",,,

Yogesh Mehra's competency to depose an affidavit and has no locus standi to initiate revocation application on behalf of Enercon (India) Limited. The,,,

counsel said that the matter was heard and decided that this matter would be disposed of. When they appealed against this order, the Hon'ble Madras",,,

High Court, had directed the Appellate Board to consider this issues in the miscellaneous petition along with the main application. Hence the request",,,

was made to decide the locus standi issue along with other grounds of the revocation application.,,,

43. Then Respondent's counsel continued to explain briefly the different types of electrical machines and submitted such electrical machines can be,,,

divided as the following types:,,,

Generators,,,

1 Synchronous Generators,,,

2 Asynchronous Generators,,,

3 Switched Reluctance Generators,,,

Motors,,,

1 Synchronous Motors,,,

2 Asynchronous Motors,,,

3 Switched Reluctance,,,

Motors,,,

Then he explained the meaning of the generator and a motor.,,,

Generator: It converts mechanical energy into electrical energy.,,,

Motor: It converts electrical energy into mechanical energy.,,,

44. Synchronous Generator: Fundamentally, a conductor moving in a magnetic field can produce electricity. However, this fundamental principle has",,,

given rise to different types of generators as mentioned herein above that are different from each other as a tiger from a lion.,,,

45. In synchronous generators, the rotor is magnetic and above all this magnet has fixed poles. This fixed pole configuration of a rotor pole is achieved",,,

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either by using permanent magnets or de electromagnets so that North and South poles of this magnet do not change.,,,

46. The stator poles have coil windings on it and as the magnetic rotor passes each stator pole, due to the magnetic field, voltage is induced on that",,,

stator pole and consequently current flows in its coil windings. The synchronous generator is more explicitly explained and illustrated in Annexure 'A',,,

(Section: Synchronous Generator). Fig. SM-5 of Annexure A, illustrates how alternating current is generated through each stator pole. From said",,,

illustration, it can be observed that after a rotor passes through two poles of the stator, one complete cycle of a sine wave of electric current is",,,

generated. Therefore, to obtain more number of complete cycles of ac current, number of poles of the stator and rotor are increased and these play a",,,

significant role in designing a generator. (Annexure A was also handed over to this Appellate Board for assistance.) The present invention relates to,,,

this type of generator i.e. synchronous generator.,,,

47. Asynchronous Machine: In asynchronous machine, the rotor is not magnetic and does not provide any magnetic field. The rotor is designed such",,,

that the alternating and moving magnetic field of the stator can induce an electric current in that rotor. One design of a rotor of an asynchronous,,,

machine is the so called squirrel cage. A detailed explanation, which is incorporated herein for the sake of reference and distinction of our invention, is",,,

annexed as Annexure A (Section: Asynchronous Machine).,,,

48. As a further result, the rotor is-except for idle mode-rotating with different speed than the magnetic field of the stator is rotating. Accordingly, the",,,

rotor moves asynchronously with respect to the magnetic field of the stator. As the electric current is induced in the rotor, this machine type is also",,,

called as ""induction machine"".",,,

49. Switched Reluctance Motor: A switched reluctance motor is based on a fundamentally different principle. A rotor of a switched reluctance motor,,,

does not provide a magnetic field and is in fact in this respect inactive. The rotor of a switched reluctance motor is only adapted to conduct a magnetic,,,

field generated by one of the pairs of windings of the stator. The principle and working as distinguished from the AC synchronous generators of the,,,

Indian patent No. 200616 (hereinafter called as 'the subject patent') will be

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explained with reference to the prior arts. Nevertheless, a brief explanation",,,

is annexed herein as Annexure A (Section: Switched Reluctance Motor).,,,

50. A major difference in switched reluctance machine from a synchronous generator is that the rotor is non magnetic and apart from that it has to be,,,

a conductor of magnetic field to pass the magnetic field through itself as shown in Fig. SR-l. In said figure the magnetic field is shown in grey lines,,,

from stator A to A and it travels through the rotor from 1 to 1.,,,

51. The applicant tried to explain the subject patent from the summary of the invention. Though summary summarizes the invention alongside,,,

explanation by way of preferred embodiments, the claims limited by reference numerals have to be construed by way of the detailed description.",,,

Moreover, it is a settled law that the specification must be read as a whole.",,,

ENVISAGED PROBLEM:,,,

52. The counsel explained the technical problem: Every torque fluctuation of the generator may cause the generator or another part of the wind driven,,,

power converter to vibrate. (Page 23 (subject patent), lines 29-30). Further, said torque of the generator is proportional to the direct current through",,,

stator winding after coupling downstream of the rectifier diodes i.e. to the time dependent sum of all the partial currents (page 24 lines 1 to 15).,,,

Inevitably, vibrations comprise different frequencies resulting in harmonics. The noise emission is particularly high if the components of generator are",,,

excited into vibrations at what is called their natural frequency (Page 23, lines 14 to 17). Thus,",,,

Current in stator-Torque fluctuations-Vibrations (harmonics) -Natural frequency Noise,,,

53. As is clear from above, the genesis of problem dealt in the present invention relates to induction in the stator winding and resultant current which is",,,

possible only in synchronous machines. This is distinct from other electric machines in which the rotor is non magnetic and induction occurs on the,,,

rotor. Therefore, any machine in which induction of voltage does not occur on the stator i.e. any machine which is not synchronous, will not",,,

necessarily face same problem or will not have similar genesis/origin of this problem. Accordingly, solution for synchronous machine cannot be applied",,,

in other machines.,,,

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ENVISAGED SOLUTION:,,,

54. It has been found by the inventor that by making the profile (shape and characteristic) of partial currents that start flowing in stator due to,,,

induction from rotor, resemble the profile (shape and characteristic) of the induced voltage in stator, torque vibrations explained above can be",,,

minimized (page 24 lines 17 to 21). This is achieved by asymmetric disposition of poles on a rotor resulting in a trapezoidal shaped current profile,,,

similar to the induced voltage (page 25 of revocation application).,,,

55. Asymmetric pole disposition on a rotor means that the disposition is not symmetrical. The distances between the poles are firstly unequal and,,,

secondly not constant (Page 26). By making a non-constant pole distance, randomness is introduced in the pattern of pole disposition with 3 varying",,,

distances.,,,

56. That is to say, firstly the adjacent poles can only have three different distances namely a, b or c explained in page 35 second paragraph of",,,

revocation application. Moreover, lines 12 to 15 on page 35 say that the three types of distances are not repeated in a pattern, they are not constant",,,

and can be placed differently over the rotor. Thus, there are two aspects:",,,

1. Different distances: the subject patent discloses that the distances between poles can have three different distances;,,,

2. Not Constant: the way the distances a, band c are disposed on the poles is not constant but random. That is to say, the different distances can occur",,,

anywhere randomly on the rotor such as ab, ba, ca followed by bb, cc, ac so on and so forth.",,,

This randomness imparts asymmetry to the whole disposition of poles on the rotors.,,,

57. For the meaning of 'symmetry' definition of Wikipedia was referred as follows:,,,

Symmetry generally conveys two primary meanings. The first is an imprecise sense of harmonious or aesthetically pleasing proportionality and,,,

balance; such that it reflects beauty or perfection. The second meaning; is a precise and well-defined concept of balance or ""patterned self-similarity""",,,

that can be demonstrated or proved according to the rules of a formal system: by geometry, through physics or otherwise. A copy is annexed herewith",,,

as Annexure 'B'.,,,

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58. Thus there has to be a set pattern and that pattern must be defined by a formal system. Further, it says that opposite of symmetry is asymmetry",,,

i.e. asymmetry has neither a set pattern nor any formal system to define it as in the present invention. Though there is a system to define the three,,,

different distances a, b and c, how they are arranged all along the rotor is not defined in a set pattern.",,,

59. Reference was made to Claim 1:,,,

The subject-matter of claim 1 is directed to a synchronous generator with the following features:,,,

F1: A synchronous generator having,,,

F2: a generator stator and,,,

F3: a generator rotor, which can move relatively to the stator,",,,

F4: the rotor has n poles for producing electrical power with the wave form of the induced voltage in one stator winding or in a number of stator,,,

windings corresponding the current wave form in one stator winding or the sum of at least n current elements in n stator windings,",,,

F5: the poles are disposed asymmetrically on the rotor.,,,

60. According to feature Fl, a synchronous generator is claimed, which produces an alternating current in the stator by means of a rotating rotor,",,,

wherein the rotating rotor comprises a constant magnetic field, inducing voltage in one or a number of stator windings.",,,

61. As mentioned hereinbefore, the cause for high noise, which is to be reduced, is explained on internal page 3, second paragraph of the specification",,,

(the paragraph before the object of the invention). Generators in operation are excited strongly into mechanical vibration, which may be transmitted to",,,

other components of the wind power plant, such as the rotor blades, the mechanism housing or the tower, leading to undesired noise emission. The",,,

noise emission is particularly high of the stator of the generator or other components are excited into vibration at what is called their natural frequency.,,,

Accordingly, the noise produced is not dependent on the generator and its operation only, but on the attached mechanical parts, into which the",,,

vibrations are transmitted. The noise also depends on the frequency of the vibrations in correspondence to the characteristics of the attached,,,

mechanical parts, in particular on their natural frequency.",,,

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62. According to feature F4, the rotor has n poles for producing electrical power with the wave form of the induced voltage corresponding to the",,,

current wave form in at least one stator winding. This is also explained in the patent on page 4, last paragraph. According to which the time-dependent",,,

profile of the induced voltage is essentially trapezium-shaped with rounded sections at the leading and trailing edges and the trapezium upper edges.,,,

This way, torque vibrations can be minimized. The desired signal shapes of the current and the voltage may be obtained by taking admeasures",,,

explained on page 5, second and third paragraph.",,,

63. The claimed solution is based on the recognition that every torque fluctuation of the generator may cause the generator or another part of the wind,,,

driven power converter to vibrate. This is in particular critical for the case of an angular generator, when very high torque is applied (cf. page 3, last",,,

paragraph of the present patent).,,,

64. According to feature F5, the poles of the rotor are disposed symmetrically.",,,

Grounds taken by applicant in the revocation application:,,,

1. The subject matter of the patent is not new (Section 64(l)(e));,,,

2. The subject matter of the application is obvious and does not involve any inventive step (Section 64(1)(f));,,,

3. The scope of any claim of the complete specification is not sufficiently and clearly defined (Section 64(1)(i)).,,,

65. However, in reply to counter statement, the applicant has raised a new ground under Section 64(1)(m) which is illegal and an abuse of process of",,,

law. It is humbly submitted that the same is liable to be rejected. It may be appreciated that as per the Indian Patents Act, 1970 (hereinafter 'the Act')",,,

and IPAB (Procedure) Rules 2003, pleadings are completed at rejoinder and it is a settled law that no new ground can be raised in a rejoinder since",,,

there is no further opportunity to reply a rejoinder. An uncalled for new ground raised in a rejoinder is liable to be rejected and the same cannot be,,,

considered to have been waived even if there had been an alleged delayed objection by the Respondents. It follows the principle that an illegal,,,

procedure of law cannot be followed even if both the parties waive such illegality. An illegal procedure taken by a applicant remains illegal irrespective,,,

of the fact whether Respondents have or have not raised any objection.,,,

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COUNTER ARGUMENTS TO THE GROUNDS FOR REVOCATION APPLICATION:,,,

66. Under Section 64(1)(i) of the Act,,,

The Respondent humbly submits that detailed analysis of the claims on record has already been done herein above which clearly shows that scope of,,,

the claim is sufficiently and clearly defined. In view of the above, it is submitted that the applicant's reliance on this ground for revocation Under",,,

Section 64(1) (i) of the Act is not maintainable and ought to be rejected.,,,

67. Under Section 64(1)(e) of the Act (LACK OF NOVELTY),,,

It is humbly submitted that the applicant has withdrawn the ground under Section 64(1) (e) of the Act, at the time of arguments, which is on record.",,,

Moreover, there was an explicit admission by the applicant that none of the prior art documents anticipate the present invention. Therefore, the",,,

Respondent is not advancing any arguments to establish novelty of the invention, as the same is not disputed rather has been acknowledged by the",,,

applicant. Without prejudice however, the assertions in our Counter Statement are reiterated which have not been repeated herein only for the sake of",,,

brevity.,,,

68. Under Section 64(1)(f) of the Act (LACK OF INVENTIVE STEP),,,

Primarily, the applicant has not been able to establish obviousness by any evidence since till the conclusion of the final arguments; the original",,,

affidavits of the alleged experts were not on record. Therefore, the assertions in the revocation petition and the rejoinder are whimsical, unfounded",,,

and have failed because of lack of evidence in support thereof. It is a settled law that burden of proof in a revocation petition lies on the applicant. It,,,

has been also held in VISX Inc. v. Nidex Co. Ltd. (1999) FSR 405 at 454 which has been given in the extracts/excerpts annexed as Annexure 'B',,,

(page 402 of the book Patent Law by P. Narayanan).,,,

i. In Molnlycke A.B. v. Proctor and Gamble (No. 5) (1994) RPC 49 at 113 (CA) it was followed that the court has to make two findings of fact; what,,,

had been included in the state of the art and whether the claimed inventive step would have been obvious to a person skilled in the Article In applying,,,

this criterion and making the findings, the court would almost invariably require the assistance of expert evidence. Therefore, the question of",,,

obviousness has to be factually established by way of proper evidence on record

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which in this case is not on record.,,,

ii. However, in the present matter, the applicants have miserably failed to provide even an iota of evidence in support of their pleadings. Till the day of",,,

hearing, applicants had only filed their revocation petition and reply to the Respondent's counter statement. Attached to Respondent's counter",,,

statement were Annexures where were copies of alleged affidavits of one Mr. Devendra Kumar, Mr. Dilip Trasi and Mr. R.S. Barve. However, no",,,

evidence in the form of original affidavits of said experts had been filed till the conclusion of the final hearing in the matter.,,,

iii. Being judicial proceedings under the Patents Act, 1970, this Hon'ble Board is inevitably bound by Indian Evidence Act which says in Section 1 that",,,

it applies to all judicial proceedings. Accordingly, an affidavit submitted as a photocopy and that too as an annexure is inadmissible as evidence and",,,

thus, since till the final hearing of the matter no evidence in the form of original affidavits has been filed, the applicants have miserably failed to prove",,,

their case. However, technical expert evidence of the Respondent in original and notarized is on record.",,,

iv. Strangely, none of the prior art documents relate to synchronous generators but all other types of machines. Further, these prior arts relate to",,,

motors except one prior art and the principles, problem and limitations attributed to motors are significantly different from those of generators",,,

particularly, synchronous generator.",,,

v. The Respondent's expert affidavit is of Dr. Rudolf Teschemacher, former legal member of the highest Board of the European Patent Office. He",,,

brought forth his evidence as a problem and solution approach, according to which: for obviousness the closest prior art must be identified. Based on",,,

this, the effect of ""missing features"" were identified between the subject patent and the closest prior Article This effect which basically forms the",,,

object of the invention will not necessarily be the same object as mentioned in the patent. Finally, in evidence it is stated that none of the prior art",,,

documents cited would lead the skilled person to the claimed invention when trying to solve the objective problem.,,,

vi. However, this problem and solution approach was admitted at the end of the hearing by the applicant as the applicant's counsel read it during the",,,

final argument, but no explanation was provided, whether the claimed invention

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is obvious or not. In particular, it is not clear what exactly shall form",,,

the closest prior Article The applicant at the end alleged that e. g. a synchronous generator of an Enercon E-66 would form the closest prior Article,,,

The applicant's counsel also alleged that the prior arts mentioned in the specification of the subject patent are closest prior Article However, there is",,,

no document provided by the applicant relating to wind power installation or its generator as in the subject patent. Therefore, it is not clear, what shall",,,

form the closest prior art and thus, it is not clear, which actually were the known features.",,,

vii. The applicant also tried to explain the well-established ""could-would-approach"" according to which a claimed invention is not obvious, just because",,,

a skilled person could combine a document in order to get to the claimed invention, is not necessarily obvious if the skilled person indeed would have",,,

combined said documents in order to find a solution to the objective problem. Thus, applicant admitted the points of the Respondent.",,,

69. US 5111095 Patent,,,

i. US'095, which is directed to a polyphase switched reluctance motor, does at least not disclose a synchronous generator according to feature Fl. It",,,

also does not disclose that the rotor has n poles for producing electrical power with the wave form of the induced voltage in one stator winding or in a,,,

number of stator windings corresponding to the current wave form in one stator winding or the sum of at least n current elements in n stator windings,,,

according to feature F4, as the principle of such switched reluctance motor is to selectively provide currents at some stator poles in order to pull rotor",,,

poles towards these stator poles.,,,

ii. In other words, the noise is due to the profile of the partial currents in 'n' stator windings and to minimize noise, induced voltage in these 'n' stator",,,

winding are corresponded to the partial currents in these stator winding. Said feature or suggestion to this is not at all present in US '095 patent.,,,

iii. Therefore, the US '095 patent is at least directed to a different kind of machine and this different kind of machine is also providing different kinds of",,,

currents and Voltages.,,,

iv. It was pointed to column 3, lines 47 to 50 of US'905:",,,

It is another specific object of the invention to provide a high speed, high torque SR motor having very small torque ripple characteristics and no dead",,,

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torque positions for the rotor.,,,

v. This basically explains the design concept underlying the US'095 patent and also addressed the above-mentioned differences, i. e. the different",,,

machine type and the different situation of voltage and current.,,,

vi. In detail, very small torque ripple characteristics are disclosed. The applicant alleged that this would be a disclosure for reduced noise. In this",,,

respect, the applicant also pointed to a wikipedia-page. As far as this page could have been analysed by the patentee, it was clearly mentioned therein",,,

that such problems are typically associated with the Switched Reluctance Motors and thus, the same cannot be equated with a synchronous machine",,,

of the subject patent. It may be appreciated that if the small torque ripples would correspond to a natural frequency of the correspondingly attached,,,

mechanical parts, even an increase of noise can be expected and thus, it infact teaches away from the subject patent.",,,

vii. However, these are pure speculations and at least the US'095 patent does not disclose any relation of the rotor design and noise emission. Alleging",,,

that the ""very small torque ripple characteristics"" would point the skilled person directly and unambitiously to noise reduction is simply not supported",,,

and not within the law towards establishment of obviousness.,,,

viii. Regarding the avoiding of dead torque positions for the rotor, this is a very specific task for designing a switched reluctance motor, as is explained",,,

in figure 4A to the situation according to figure 4B of Annexure A. In an SR motor the rotor moves with some rotor poles towards the stator poles,,,

being magnetized. If the rotor would not be moving and if a newly magnetised pair of stator poles would attract two pairs of rotor poles in the same,,,

manner (with the same strength), it would not be clear, which pair of rotor poles would actually be attracted by the magnetic field and thus, it is not",,,

clear, which direction the rotor will move then. Such dead torque position for the rotor is to be avoided. An asymmetric arrangement of the rotor poles",,,

can solve this problem.,,,

ix. Now coming back to the question, whether a skilled person in order to improve a synchronous generator having symmetrically arranged rotor poles",,,

in order to reduce noise would consider the US'095 patent, which solution would the skilled person find in this US'095.",,,

x. He would find a specific design for a switched reluctance rotor, which might

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lead to having very small torque ripple and to avoid dead torque",,,

portions for the rotor. There is no teaching that the design of the US'095 would improve the noise emission situation particularly, since in US'095 the",,,

stator is producing a magnetic field contrary to the subject patent. Since genesis of noise in the subject patent is the current produced and voltage,,,

induced in non magnetic stator, a magnetic stator of US '095 will solve the same purpose is not what a skilled person in art would expect.",,,

xi. Even further, regarding the US'095 patent, it would not even be clear, whether it is possible and suitable to rearrange the rotor poles of a",,,

synchronous generator in an asymmetrical way. Figure SM-5 of Annexure A makes it clear that dependent on the geometric design of the,,,

synchronous generator, a sinusoidal current occurs in each stator windings. What would happen, if the rotor would be designed in an asymmetrical",,,

way? Wouldn't a significant change in the generated currents occur? The disclosed switched reluctance motor according to US'095 patent provides a,,,

rotor design perfectly adapted to the principle of the switched reluctance motor but not synchronous generator.,,,

xii. Returning to the ""could-would-approach"", the patentee even doubts that the known principle of the US'095 patent could be adapted to a",,,

synchronous generator. But at least, a skilled person trying to improve a synchronous generator would at least not consider adapting the principle",,,

design of the arrangement of the rotor poles according to the US'095 patent to a synchronous generator.,,,

70. US 4,883,999 patent",,,

i. US '999 patent also relates to Switched Reluctance (SR) Motors and its object is to provide a SR motor that has greater efficiency than SR motors,,,

of conventional construction, particularly at higher RP Ms. Primarily, the Synchronous generator of the present invention is for a wind power",,,

installation and rotates at low RP Ms.,,,

ii. Secondly, as explained above, principle, limitations and problems of SR motors cannot be applied or solutions thereof be suggested for a",,,

synchronous generator of the subject patent. Moreover, on page 91 column 3 lines 12 to 25 clearly show that said document provides low reluctance",,,

path in a rotor which is only possible in non magnetic rotor and solution of the same cannot be applied to a magnetic rotor of synchronous generator.,,,

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71. US 8,032,670 Patent",,,

Said prior art was mentioned only to show that trapezoidal rotor poles were known before. In this regard it is submitted that Figure 4 (which was,,,

referred to by the applicant) does not show a trapezoidal figure. Moreover, the subject patent is about asymmetric disposition of poles on rotor and not",,,

particular shape of the rotor poles.,,,

72. Non Patent Literature -Sakamoto (Page 133 of the reply to counter statement),,,

a. Firstly, this prior art document relates to induction motors having squirrel cage (page 134 line second last line). As is known in the state of art,",,,

squirrel cage can only be used in induction motors. Moreover, induction motors have non magnetic rotor. Apart from that the applicant has failed to",,,

prove how this art is applicable to synchronous generators when on page 134 lines 1 -2 fourth paragraph, it clearly states that the problem it deals with",,,

cannot be attributed to synchronous machines. Accordingly, it teaches away from the subject patent.",,,

b. Moreover, Figures 7 A on page 139 and its explanation relates to machines in high frequency zone i.e. 500 Hz which is not the case of the present",,,

invention that correspond to low frequencies-50 Hz or lower. This figure clearly distinguishes that noise is totally different in low frequency zones,,,

(magnetic) than in high frequency zones. Thus it teaches away from the subject patent.,,,

c. Figure 7 C discloses equidistant slots and is said to be better than irregular slots of Figure 7 B. Thus, this document discloses away from the",,,

teaching of the subject patent. Moreover, on page 139 second paragraph, it IS clearly shown that the method of designing the irregular slots will be",,,

reported in another paper. Thus, designing of irregular slots i.e. distances a, band c of the present invention as well as asymmetry is not taught in this",,,

document.,,,

d. Therefore, any person skilled in the art cannot utilize this document to devise an asymmetrical disposition of poles such as explained in the subject",,,

patent from this document.,,,

73. US 4,263,526 patent",,,

i. This document relates to AC generators for vehicles and not synchronous generators of wind power installation as that of the subject patent. Apart,,,

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from that, the applicant has failed to prove as to how a skilled person in the art would apply the principles of a generator of a vehicle to that of a wind",,,

power installation.,,,

ii. The differences between the subject patent is clear in Figure 5 wherein the shifted poles though having unequal distances between them are,,,

symmetrical as the pattern of poles on one half corresponds to the pattern on the other half. Thus, unequal distances do not necessarily mean that",,,

there is asymmetry. While in the subject patent, the unequal distances i.e. three different distances, does not impart symmetry as suggested by Fig. 5",,,

(and its explanation) of this document, but imparts asymmetry. Thus, this prior art teaches away from the subject patent.",,,

iii. The common meaning of symmetry means that it has a pattern and that pattern is defined by a formal system. This formal system of pattern for,,,

disposing poles on rotor is explained on page 131 column 3 line 25 of US '526 patent. While in the subject patent there is no fixed pattern and it cannot,,,

be defined by a formal system. The three different types of distances a, band c are not disposed on the rotor in a pattern but randomly without any",,,

pattern thus, imparting asymmetry.",,,

iv. Accordingly, a person skilled in the art would not be suggested, taught or motivated by the symmetrical arrangement of poles on the rotor of a",,,

vehicle generator of US '526 patent to have an asymmetrical arrangement of poles on the rotor as in the subject patent.,,,

v. It may be appreciated that it is not sufficient to prove common general knowledge that a particular disclosure is made in an article, or series of",,,

articles etc. It becomes a general knowledge when it is generally known and accepted without question by the bulk of those who are engaged in the,,,

particular Article This was also held in British Acoustic Films Ltd. v. Nettlefold Productions (1936) 53 RPC 221 at 250 and approved in General Tire,,,

& Rubber Co. v. Firestone Tyre and Rubber Co. Ltd. (1972) RPC 457 at 481-484 (C.A.).,,,

vi. Common general knowledge has also been elaborated in the case of Dyson Appliances J 2-Ltd. v. Hoover Ltd. (2002) RPC 22. An excerpt/extract,,,

of page 247 from the book Terrell on Patents is referred to in this regard.,,,

vii. All what we learned from the patented invention is the teaching of the patent, whereas all this teaching was presented by the Applicant as being",,,

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general knowledge. Adapting all the teachings derived from the invention in order to find the invention is using hindsight.,,,

viii. It may be appreciated that the case laws mentioned herein refer to the settled law on patents that have withstood the tests of time and have,,,

become independent of facts. Only after such test, the same have been incorporated in reference books on law adopted and followed by the patent",,,

fraternity in India including Indian courts.,,,

ix. It has been admitted by the applicant on page 30B that considerations are in place to minimize harmonics i.e. higher frequency vibrations that if,,,

matched with natural frequency of components would cause noise. Accordingly, if still the problem of noise in generators, broadly speaking all types of",,,

generators, is not yet solved despite the plethora of prior arts cited by the applicant, how can it be obvious to use asymmetric disposition of poles and",,,

above all why still considerations are going on and this asymmetric disposition has not been used. It may be added that the positive effect of,,,

asymmetric disposition has been elaborated by results using graphs in the specification itself. Accordingly, it is an admitted position of the applicant",,,

that the cited documents do not obviously solve the problem envisaged by the Respondents and more research is pending to minimize noise.,,,

x. The Respondent has also submitted evidence by way of a technical affidavit of Dr. Ulf Scheumann which affirms the novelty and inventive step of,,,

the invention claimed in the subject patent.,,,

74. NEW GROUND TAKEN UNDER SECTION 64(1)(m),,,

Without prejudice,,,

i. Primarily, as mentioned herein above, the burden of proving and establishing a ground for revocation rests on the applicant, a fact which the",,,

applicant also agreed to. The applicant has whimsically and conjecturally alleged that requirements of Section 8 of the Act were not met by the,,,

Respondents. However, the applicant has failed to bring a single document on record to prove such allegations, which are in fact without any",,,

substance.,,,

ii. The applicant quoted Section 106 of the Indian Evidence Act in his support. As per said section, when any fact is especially within the knowledge of",,,

any person, the burden of proving that fact is upon him. In Shambhu Nath v. State of Ajmer AIR 1956 SC 404), the Hon'ble Supreme Court held that",,,

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the relevant and material information was as much within the especial knowledge of the prosecution as in that of the accused and the prosecution,,,

could not rely upon illustration (b) to S. 106.,,,

iii. The details filed under Section 8 of the Act are record of the Indian Patent Office and certified copies thereof can be obtained from the Indian,,,

Patent Office by any person. Therefore, the details provided under Section 8 by the patentee were within the knowledge and accessible to any person",,,

of the public including the applicant and if he has not relied upon it, the same has to be taken against the applicant. Therefore, it is wrong to suggest",,,

that such information was especially within the knowledge of the Respondent. Thus, this allegation has no force and the same is unfounded.",,,

iv. The case law: Chemtura Corporation v. Union of India and Ors. (2009(41) PTC 260 (Del) cited by the applicant does not give any finding as it,,,

relates to prima facie view of the Hon'ble Court and the matter has not been finally adjudicated. Moreover, in paragraph 57 it has been clearly cited",,,

that it is only a prima facie opinion and not intended to influence either the final outcome of the suit or any other proceedings. Thus, a decision which is",,,

not applicable to its own case cannot be applied to any other matter.,,,

v. It is submitted that the decision on the subject revocation petition cannot be guided by prima facie opinions.,,,

75. The Respondent finally ended his arguments by making the following submissions:,,,

a. In view of the submissions made in the counter statement, expert opinion of Dr. Rudolf Teschemacher, expert opinion of Dr. Ulf Scheumann and",,,

submissions made' during hearing before the Hon'ble Board and the present submissions, it is prayed that the revocation petition be dismissed and the",,,

subject patent be retained in the Register of Patents.,,,

b. Without prejudice, in the event this Hon'ble Board decides that the patent is invalid, the Respondent humbly prays that the Hon'ble Board may",,,

consider and allow the amended claims as annexed with application for amendments filed under Section 58 read with Section 59 of the Act on,,,

October 06, 2010 and allow the subject patent to be retained in the Register of Patents.",,,

76. Rejoinder to the Respondent's arguments,,,

1. The counsel for the Respondent submitted that the asymmetrical distribution

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means distribution in a particular pattern. In response to this, it was",,,

submitted that the meaning for asymmetrical distribution imparted by counsel for the Respondent was nowhere to be found in the specification.,,,

Further, it was also submitted that the counsel was imparting a meaning, which even the patentee did not intend to. In this context lines 18-22 of the",,,

specification at page 25 of the application was referred to and it was submitted that impugned patent states that the rotors with even spaced poles i.e.,,,

poles with constant spacing with one another is well known in the Article Further, in this context lines 1-7 of the specification at page 26 of the reply",,,

was referred to and it was submitted that distance between the pole centers on the rotor is not constant. Thus, the meaning that can be attributed from",,,

the specification to asymmetrical distribution of poles on the rotor as claimed in claim 1 is that the distance between the poles is not constant. Hence,",,,

the submission made by the counsel for the Respondent is incorrect.,,,

2. The counsel for the Respondent had made a submission with reference to US '095 patent that torque ripple is not related to noise, thus a person",,,

skilled in the art will not consider the teachings of US '095 patent relevant. In response to this the article on reluctance motor in wikipedia (Annexure,,,

1) which was made available by the Respondent at the hearing, was relied upon wherein it has been stated that in reluctance motor noise is caused by",,,

torque ripple.,,,

3. The counsel for the Respondent had submitted with regard to disclosure of amended claims in US to the Indian patent office that the burden of,,,

proof was on the Petitioner to prove. In response, attention was invited to Section 106 of the Indian Evidence Act to show that when any fact is",,,

specially within the knowledge of any person then the burden of proving that fact is upon him. In the present case the knowledge that whether, the",,,

information regarding amendment of claims in US was submitted to the Indian Patent Office before the publication of grant of the Indian Patent is,,,

within the exclusive domain of the Respondent and hence the argument of the Respondent fails.,,,

On proposed claim amendment,,,

4. The Respondent had served on the Petitioner on 6.10.2010 at 6.15 p.m. a Miscellaneous Petition for amending the granted claim of the impugned,,,

patent.,,,

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5. The amended claims are at page 7 and 8 of the Miscellaneous Petition.,,,

6. At the outset it was submitted that the amendment application has been served at the last minute and the Petitioner is denied the opportunity of,,,

introducing further evidence in order to object to the claims as sought to be amended.,,,

7. In view of the fact that the amendment application has been moved at the last moment, the Respondent does not deserve exercise of the discretion",,,

of the Hon'ble Board to consider the amendment.,,,

77. The applicant's counsel submitted that the Respondent has not produced any expert affidavit till the date of hearing, the Respondent should not be",,,

allowed to produce any affidavit later, as the arguments have been concluded. Finally the counsel made the prayer that the impugned patent 201910 be",,,

revoked in its entirety.,,,

78. We have heard the arguments of both the counsel and have gone through the pleadings and the documents filed in support thereof.,,,

79. Person interested,,,

In this case, the Respondent has first raised a question of locus standi for the person who has filed the application for revocation for and on behalf of",,,

the applicants that he is not authorized and is not ""the person interested"" to file a revocation petition. The Respondent has taken the ground that in",,,

terms of the articles of association of the company, Mr. Yogesh Mehra, the Managing Director lacks the competence to file a revocation application",,,

for and on behalf of the applicants for revoking the patent granted to the Respondent, as the reliance placed on the articles of association is wrong and",,,

the power is not conferred on him to execute any such legal action, and more so when the matter is still pending before the company law board. The",,,

applicant had stated that Mr. Yogesh Mehra, being the Managing Director has been authorized by the Board resolution dated 26th April 2007 to",,,

defend and initiate suits and proceedings on behalf the applicant and that in terms of the articles of association of the company, Mr. Yogesh Mehra,",,,

being the Managing Director has the requisite locus standi to file and institute the revocation proceedings. Appellate Board has the power only to,,,

check as to whether the applicant filing the revocation, namely the applicant company, herein M/s. Enercon (India) limited is a ""person interested"" or",,,

not according to the Act under which this proceeding has been initiated.,,,

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80. Now we wish to point out that this issue of locus standi of Mr. Mehra has already been discussed and decided earlier in Para 6(g) ante. The,,,

Company Law Board having not granted any interim order after 29.10.2007 and 19.5.2008, as on date, the Board resolution is valid and subsisting. It",,,

has not been set aside or stayed by any court / judicial body. Under these circumstances, it cannot be said that Mr. Mehra has no locus or authority to",,,

sign the revocation applications on the strength of the resolution dated 26.4.2007. Miscellaneous Petition No. 50/2010 is therefore dismissed. As such,,,

it cannot also be held that the applicant company is not a person within the meaning of Sections 2(1)(s) or 64 of the Act.,,,

81. Now we have to see whether the applicant is a person interested or not to file a revocation application. According to Section 2(1)(t) of the Act,",,,

person interested"" is defined as below:",,,

Person interested"" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates;",,,

The word or expression ""person interested"" appears under Sections 25 as well as 64 of the Act, dealing with opposition proceedings to the grant of",,,

patent and revocation proceedings before this Appellate Board. In fact the actions taking place in opposition proceeding is almost analogous and,,,

similar to the revocation proceedings before this Appellate Board, excepting for the creation or constitution of an opposition Board under Section 25(3)",,,

(b) of the Act, to examine and submit the recommendation to the Controller who is to hear the opposition parties. As per Patent Law by P.",,,

Narayanan, it could be clearly seen or stated that there are three grounds upon which the opponent can establish his locus Standi to oppose the grant",,,

of patent or to seek the revocation of the patent, which are mainly,",,,

1) possession of patents in the same field as the invention relates;,,,

2) manufacturing interest relating to a similar product being manufactured by the patentee; and,,,

3) trading interest..,,,

82. In AIR 1983 DELHI 496 Ajay Industrial Corporation v. Shiro Kanao of Ibaraki city, para B in page 496, it was held that, ""person interested"" must",,,

be a person who has a direct, present and tangible commercial interest which was injured or affected by the continuance of the patent on the register.",,,

The applicant's counsel stated at the very beginning, that they are the one of the

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foremost leaders in the wind energy sectors in India and they",,,

manufacture and install wind turbines all over India and thus they are an interested person within the meaning of the Section 2(1)(t) as well as the,,,

Section 64 of the Act. In view of this judgment, we have to check and find out whether this applicant is a person interested as per the requirement of",,,

the Act under which these proceedings are taking place.,,,

83. In Ajay Industrial Corporation vase (supra), it was held that ""the person interested within the meaning of Section 64 must be a person who has a",,,

direct, present and tangible commercial interest or public interest which is injured or affected by the continuance of the patent on the register."""",,,

84. In Globe Industries Corporation's Patent (1977) R.P.C 563 in the Supreme Court of Judicature - Court of Appeal, Lord Justice Scarman observed",,,

that, ""where the statute uses the words 'any person interested', the interest has to be genuine; the possibility of prejudice has to be genuine and in",,,

addition, and quite independently, the Court must be satisfied that the opposition or the application for revocation, as the case may be, is not a frivolous,",,,

vexatious or blackmailing operation."""",,,

85. And in the same case law, Lord Justice Goff observed that, ""what an opponent on an application for revocation has got to establish is that there is",,,

genuine interest which may be prejudiced; Of course, the prospect of prejudice must be real, not speculative or fanciful and it must be a prejudice to",,,

present a commercial interest."""",,,

86. In Mediline A.G's Patent (1973) R.P.C 91 before the patents Appeal Tribunal, Mr. Justice Graham has held that, ""there must be a real, definite",,,

and substantial interest to prove the commercial interest and that it must be a genuine interest. There must be the existence, or the likelihood of real",,,

prejudice."""",,,

87. Therefore applying the same analogy here, we find that, as regards the first ground, there is no evidence before us to show that the applicants are",,,

in possession of any patents in the same field. As regards the second ground i.e., the manufacturing interest, the applicants are one of the foremost",,,

leaders in the wind energy sectors in India and they manufacture and install wind turbines all over India and this establishes the manufacturing interest.,,,

As regards the trading interest, looking at the ruling of the Solicitor General, Sir Thomas Inskip in Clavel's application 45 R.P.C 222 and a previous",,,

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ruling by Sir Stanley Buckmaster in New Thing's application, 31 R.P.C 40 that ""a trading interest to be effective, must be a real, definite and",,,

substantial interest and must not arise from something that the opponent proposes to do"".",,,

88. It is very clear that the applicants have been manufacturing and installing the wind turbines shows the trading interest of the product, too, as ""a",,,

person interested"" in opposing the grant or revocation of the patent. Therefore what an applicant for revocation of patent, has to establish is that there",,,

is a real and genuine interest together with a commercial interest, which may be prejudiced when such a patent is granted. The applicants have shown",,,

that they have been manufacturing and installing wind turbines all over India and this shows that they have a real and genuine interest together with a,,,

commercial interest in the product. In view of the above said findings, we feel and think that undoubtedly locus Standi is established by the applicants",,,

and they are ""the person interested"" in this case sufficiently meeting the requirement of the Section 2(1)(t) of the Act.",,,

89. Common general knowledge,,,

Now we shall see as to whether a common knowledge on the date of the patentee's claim would amount to anticipation by way of public knowledge,,,

destroying the novelty or affecting the inventive step. First we should see what is a common general knowledge?,,,

90. ""Criteria for ""Common General Knowledge""",,,

It is important to have a clear understanding of the meaning of the common general knowledge. It is the background technical knowledge available to,,,

all in a particular trade while doing or carrying out a product development activity.,,,

91. The common general knowledge as described by Laddie J in Raychem Corp's Patents (1998) RPC 31 at 40, ""The common general knowledge is",,,

the technical background of the notional man in the art against which the prior art must be considered ... It includes all that material in the field he is,,,

working in which he knows exists, which he would refer to as a matter of course if he cannot remember it and which he understands is generally",,,

regarded as sufficiently reliable to use as a foundation for further work or to help understand the pleaded prior Article This does not mean that,,,

everything on the shelf which is capable of being referred to without difficulty is

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common general knowledge nor does it mean that every word in a,,,

common text book is either. In the case of standard textbooks, it is likely that all or most of the main text will be common general knowledge.""",,,

92. The law as to what constitutes common general knowledge is also set out in the decisions of the Court of Appeal in General Tire & Rubber Co v.,,,

Firestone Tyre & Rubber Co Ltd (1972) RPC 457 at 482-483 and Beloit Technologies Inc v. Valmet Paper Machinery Inc (1997) RPC 489 at 494-,,,

495;,,,

In General Tire v. Firestone (1972) RPC 457 at 482: it is held, 'on the other hand, common general knowledge is a different concept (sc. from public",,,

knowledge) derived from a commonsense approach to the practical question of what would in fact be known to an appropriately skilled addressee -the,,,

sort of man, good at his job, that could be found in real life.'",,,

93. In Beloit v. Valmet (1997) RPC 489 (CA)). Aldous J held; ""At the same time, the skilled man should not be taken to represent some sort of lowest",,,

common denominator of persons actually engaged in the field, possessed only of the knowledge and prejudices that all of them can be said to possess.",,,

The common knowledge of different groups employed on the same tasks in different organizations is likely to be different, and It is unlikely that the",,,

expert witnesses will be truly representative of the skilled person, as not only may they be too well qualified but they will come to the case with",,,

personal prejudices or preferences that must be discounted:""",,,

94. Luxmoore J. in British Acoustic Films (53 R.P.C.221) stated: ""It is not sufficient to prove common general knowledge that a particular disclosure",,,

is made in an article, or series of articles, in a scientific journal, no matter how wide the circulation of that journal may be, in the absence of any",,,

evidence that the disclosure relates. A piece of particular knowledge as disclosed in a scientific paper does not become common general knowledge,,,

merely because it is widely read, and still less because it is widely circulated. Such a piece of knowledge only becomes general knowledge when it is",,,

generally known and accepted without question by the bulk of those who are engaged in the particular art; in other words, when it becomes part of",,,

their common stock of knowledge relating to the Article""",,,

95. The correct explanation was given by the Court of Appeal in Beloit Technologies Inc v. Valmet Paper Machinery Inc (1997) RPC 489 at pages,,,

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494-495:,,,

The information in a patent specification is addressed to such a man and must contain sufficient details for him to understand and apply the invention.,,,

It only lacks an inventive step if it is obvious to such a man. It follows that evidence that a fact is known or even well-known to a witness does not,,,

establish that fact forms part of the common general knowledge. Neither does it follow that it will form part of the common general knowledge if it is,,,

recorded in a document.,,,

96. In ICI Chemicals & Polymers Ltd., v. Lubrizol Corps 45 IPR 577 Emmett J stated, ""the common general knowledge is the technical background to",,,

the hypothetical skilled worker in the relevant art....but also includes the material in the field in which he is working which he knows exists and to,,,

which he would refer as a matter of course.""",,,

97. Thus from the above cases, common general knowledge is the common knowledge in the field to which the invention relates. It is generally known",,,

as common knowledge and regarded as a good basis for further research activity by those engaged in that art before it becomes part of their common,,,

stock of knowledge relating to the art, and then becoming part of the common general knowledge. Therefore it means the information which at the",,,

date of the patent in question is known and accepted without question by those who are engaged in the art or science to which the alleged invention,,,

relates. It would also appear therefore that when it is a question of common general knowledge i.e, knowledge available in a country for a long time,",,,

which every skilled worker in that field is, expected to know. Then such knowledge would be sufficient to invalidate a patent. Again such knowledge",,,

need not even be found in a particular document. In other words a patent application has to be accessed on the basis of not only what will be available,,,

from prior documents but also from the common general knowledge on the subject, which may or may not be available in any such document. It can",,,

be taken as a well settled principle, that the common general knowledge is a knowledge that must be attributed to a skilled person, without which he",,,

may not be taken to be a skilled person in the Article Therefore it is a knowledge that every skilled person should acquire before he embarks on the,,,

problem for which the patent provides the solution. A patent can therefore be taken to be addressed to the skilled addressee, someone skilled in the",,,

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subject matter of the invention. It is also important to differentiate between matter which was in the public domain at the priority date of the patent and,,,

matter which can properly be regarded as common general knowledge. Evidence that a particular fact is known or even well-known to a witness does,,,

not mean that it is common general knowledge. Likewise, a piece of information disclosed in a scientific paper does not become common general",,,

knowledge merely because it is widely read. On the other hand, it is not necessary to show that the information is known in the sense that the skilled",,,

person has memorized it. Material which is known to exist and to which the skilled person would refer as a matter of course if he cannot remember it,,,

is clearly part of the common general knowledge.,,,

98. Skilled person in the art,,,

A patent specification is addressed to those likely to have a practical interest in the subject matter of the invention, and such persons are those with",,,

practical knowledge and experience of the kind of work in which the invention is intended to be used. The addressee reads the specification with the,,,

1.,What is the requirement?,Low noise emission,

,Problem seen and faced:-,"Synchronous generators in wind

power installations emit a lot of

noise.

(lines 7 to 17 at page 23 of the

revocation application)",

,How the problems occur?,"1) Any torque fluctuation in a

generator will result in vibration.

(lines 29 to 33 at page 23 of the

revocation application)

2) Stator of the generator vibrates

at its fundamental frequency; it gets

into resonance, which results in

generation of noise. (lines 26 to 33

at page 25 of the revocation

application)",

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,Solution to the problem faced,"By taking the following measures on the armature
a) asymmetric distribution of the individual poles over the circumference of the disk formed by the poles;
b) changing the pole shoe geometry to the effect that the pole' head is essentially in the shape of an arrow when viewed from above and is in the shape of a trapezium in cross-section.
the two measures can be implemented separately or in combination with further measures on the generator, so as to achieve the desired aim of low noise. (lines 4 to 17 at page 23 of the revocation application)",
,,,
2.,Object of the invention,"It is same as the solution to the problem as given in Sl.1 above",
3.,What is the inventive step?,"Asymmetric distribution of individual poles over the circumference of rotor and changing pole shoe geometry to that of a trapezium shape cross-section. (lines 6 to 15 at page 26 of the revocation application)",
concept in the synchronous generator to solve the problem of noise reduction

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due to torque fluctuation.,,,

114. The learned Counsel referred to U.S. '670 patent column 3 lines 36 to 47 which disclose the use of trapezoidal poles on the rotor. In fact the,,,

claim 10 in the impugned patent claims the feature that the pole head of a pole has an approximately trapezoidal cross section. Here there is clear,,,

admission by the Respondent during his argument and in his written submissions about the trapezoidal rotor poles shown in fig. 4 of this US '670,,,

patent. The next comment by the Respondent, which the subject patent is about asymmetric disposition of poles on rotor and not particular shape of",,,

the rotor poles is not correct, in view of specific admission by himself about the trapezoidal cross section for the pole shoe geometry in lines 10 to 13 in",,,

the original page 5 of the specification. This U.S. '670 patent discloses the same features claimed in claim 10 of the impugned patent showing that the,,,

features claimed wherein do not have any inventive step and therefore the invention is obvious.,,,

115. Further column 3, lines 43 to 47 of the US '670 patent discloses that the trapezoidal shape of the pole is resulting in reduction of torque",,,

fluctuations. Thus, a person skilled in the art, when faced with the problem addressed by the impugned patent would consider the teachings of US '670",,,

patent to be relevant. As abrupt changes in torque i.e. torque fluctuations result in vibrations and the trapezoidal rotor poles by their slope prevent such,,,

abrupt changes it will result in noise reduction. The trapezoidal poles are the second way - asymmetrical pole shoes - disclosed by the Respondent.,,,

Therefore the U.S. '670 patent discloses the same features claimed in the impugned patent showing that the features claimed do not have any,,,

inventive step and therefore the invention is obvious.,,,

116. Thus it is very clear that the person skilled in the art being thorough with the principle of operation of an electrical motor, which would normally",,,

include a switch reluctance motor, as it is only an analogues field for this person skilled in the Article Thus this person skilled in the art when faced",,,

with the problem of the impugned patent would borrow the particular concept of asymmetrical distribution of poles on a rotor in a switch reluctance,,,

motor to result in reduction of noise from the teachings of US '095 patent and US '999 patent and adopt the same concept in a synchronous generator,,,

to achieve the object of this invention.,,,

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117. There was a reference to page 83, para 4 of the Reply which discusses about the Non Patent Literature disclosing the arrangement of rotor slot",,,

at irregular interval i.e asymmetrical distribution in order to reduce magnetic noise. Further reference was made to page 84, para 5 of the reply to the",,,

counter statement, wherein it has been referred to this report publication titled, ""Magnetic Noise Reduction Method of Inverted Driven Induction",,,

Motor Using Non-uniform Slots Pitched Core"" and written by Yuji Akiyama and Takayuki Sakamoto and published on 25-9-1995. But it is very",,,

unfortunate that the Respondent has not noticed the starting line in the third paragraph in the same page 134 of the Reply to the counter statement,,,

before making any comment on this non patent literature. This third paragraph discusses at length about the magnetic noise related problems for all the,,,

rotating machines, which are said to include induction machines and synchronous machines.",,,

118. Thus, it is very clear that a person skilled in the art when faced with the problem addressed by the impugned patent would easily apply the",,,

concept that asymmetrical distribution of poles on a rotor in a motor results in reduction of noise from the teachings of the above Non Patent,,,

Literature and adopt the same concept in a synchronous generator.,,,

119. Referring to the citation of US '526 patent in column 1, lines 29 to 30 and then column 2, lines 43 to 55 at page 76 of the Reply, and it is seen that",,,

US'526 patent discloses that magnetic sound i.e. noise which is generated due to torque variation i.e. torque fluctuation can be reduced by deviating,,,

the rotor poles relative to the tooth portions of the armature iron core i.e., the stator. Further, it also discloses that due to the deviation of the poles on",,,

the rotor it sharply reduces the magnetic sound generated due to the torque variation.,,,

120. Considering the citation of US '526 patent in fig. 3 at page 74 and description of fig.3. at column 3, lines 14 to 36 at page 77 of the Reply and it is",,,

clear that the broken lines in fig. 3 represents the arrangement of the poles on a rotor in a conventional generator at an equal pitch i.e. in symmetrical,,,

manner. Further, the unbroken line represents the arrangements of the poles on a rotor in an unequal pitch i.e. asymmetrical manner as claimed by the",,,

US'526 patent. Further, it is noticed here that it is evident beyond doubt from fig.3 (reproduced below for clear understanding) that the poles on the",,,

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rotor are deviated by an angle from the conventional arrangement, which has resulted in asymmetrical arrangement of poles on the rotor. Moreover as",,,

per the Indian patent law the invention claimed in any invention should meet the requirement of the Section 2(1) (j a) of the Act, which specifies very",,,

clearly that, ""inventive step"" means a feature of an invention that involves technical advance as compared to the existing knowledge or having",,,

economic significance or both and that makes the invention not obvious to a person skilled in the art"". Further this US '526 patent being already nearly",,,

20 years old would make these features form part of the common general knowledge and the person skilled in the art would certainly be aware of,,,

these special features to solve such problem of the noise emission from any rotating machine. Further the basic idea is how to reduce the noise,,,

emission in a rotating machine and it is immaterial whether it is a AC generator or any synchronous generator or induction motors. Likewise the,,,

argument by the Respondent that this machine is for a vehicle and not for a wind power installation is also not correct and will not stand as a right,,,

argument as it is only a mere application of the invention.,,,

121. The test to ascertain whether an invention involves an inventive step is expressed in Halsbury Laws of England as: 'was it for practical purposes,,,

obvious to the skilled worker, in the field concerned, in the state of knowledge existing at the date of the patent to be found in the literature then",,,

available to him, that he should or would make the invention the subject of the claim concerned.' In other words, the question to be answered in",,,

determining inventive step is 'Would a non-inventive mind have thought of the alleged invention?' If the answer is 'no', then the invention is non-",,,

obvious. If the patent claimed merely includes the development of some existing trade, in the sense that it is a development as would suggest itself to",,,

an ordinary person skilled in the art, it would fail the test of non-obviousness.",,,

122. We shall consider a few case laws as regards obviousness or inventive step and particular reference is made to M/s. Bishwanath Prasad Radhey,,,

Shyam v. Hindustan Metal Industries, (1979) 2 SCC 511, where it was held that, ""was it for practical purposes obvious to a skilled worker, in the field",,,

concerned, in the state of the knowledge existing at the date of the patent to be found in the literature then available to him, that he would or should",,,

make the invention the subject of the claim concerned?""",,,

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123. Buckley LJ in Valensi v. British Radio Corporation (1973) RPC 337, held that, "" The hypothetical addressee is not a person of exceptional skill",,,

and knowledge, and he is not to be expected to exercise any invention nor any prolonged research, enquiry or experiment. He must, however, be",,,

prepared to display a reasonable degree of skill and common knowledge of the art in making trials and to correct obvious errors in the specification if a,,,

means of correcting them can readily be found and arrive at the result..."""",,,

124. A patent will be invalid for lack of inventive step if the invention claimed in it was obvious to a person skilled in the art having regard to the state,,,

of the art at the priority date. The familiar structured approach to the assessment of allegations of obviousness first articulated by the Court of Appeal,,,

in Windsurfing International Inc v. Tabur Marine (Great Britain) Ltd (1985) RPC 59; It is convenient to address the question of obviousness by using,,,

the structured approach as explained by the Court of Appeal in Pozzoli v. BDMO (2007) EWCA 588 : (2007) FSR 37. This involves the following,,,

steps:,,,

Sl. No.,"Prior art shown in the

citation","Invention claimed

in the impugned

patent","Remarks about the

differences if any

1.,"US '095 patent in col.4

lines 22 to 24discloses that

rotor has plurality of

unevenly distributed poles

i.e. poles are distributed

asymmetrically on the rotor","Impugned

patent(IN '616

patent) claims a

synchronous

generator having

poles which have

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been
asymmetrically
distributed on the
rotor","It is a known fact
of knowledge to
the person skilled
in the art, that
asymmetrical
distribution of poles
over the rotor will
result in noise
reduction
2.,"US '999 patent in the
abstract lines 14 to 16 and
also in col.3 lines 11 to
27discloses about unevenly
spaced poles i.e. poles are
distributed asymmetrically
on the rotor","Impugned
patent(IN '616
patent) claims a
synchronous
generator having
poles which have
been
asymmetrically
distributed on the
rotor","There is no change
in the subject
matter regarding

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inventive step i. e
poles being
asymmetrically
distributed over the
rotor, which will
result in noise
reduction.
3.,"US '526 patent in the col. 1
lines 41 to 60 and also in
col.2 lines 7 to 27discloses
about unevenly spaced
poles i.e. poles are
distributed asymmetrically
on the rotor","Impugned
patent(IN '616
patent) claims a
synchronous
generator having
poles which have
been
asymmetrically
distributed on the
rotor","No change in the
subject matter
regarding inventive
step; i. e poles are
have been
asymmetrically
distributed over the
rotor, which will

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result in noise

reduction.

,,,

,,,

4.,"Pages 83 & 84 of the NPL

article by Akiyama &

Sakamoto on the topic of

irregular spaced rotor slots

for magnetic noise

suppression.","Impugned

patent(IN '616

patent) claims a

synchronous

generator having

poles which have

been

asymmetrically

distributed on the

rotor","NPL clearly points

out the irregular

spaced slots on the

rotor for

suppressing

magnetic noise in

an electrical

machine.

132. Amendment of claims,,,

Respondent in the revocation application came up with a miscellaneous petition 01.10.2010 with a revised set of claims, stating that the amendments",,,

have been carried out in their US equivalent patent and are merely directed to

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have uniformity with the US claims as granted and therefore requested,,,

that the revised claims filed under Section 58 of the Act may be considered rather than revoking the entire patent. The Respondent has filed these,,,

amendments, revising the claims, on 6-10-2010 i.e. one day before the hearing which is also not correct as per law. The Respondent's Miscellaneous",,,

Petition for amending the claims was filed very belatedly in the registry and so the same had not even been numbered by the Registry and placed in,,,

the folders of the Bench on the date of hearing.,,,

133. The amendments which have been proposed must be complying with the requirements of Section 59 of the Act. Section 59 (1) of the Act reads,,,

as follows:,,,

134. Hence from the above Section 59 of the Act, permissible amendments could be as follows:",,,

1 Amendment must be by way disclaimer, correction, clarification or explanation;",,,

2 The amendment must be for incorporation of actual fact; and,,,

3 The effect of amendment should not enable the specification as amended to describe any matter not in substance disclosed or shown in the,,,

specification before amendment; or,,,

4 That any claim of the specification as amended would fall wholly within the scope of the claim of the specification before the amendment.,,,

135. Section 58 of the Act, gives the court the power, in revocation proceedings in which the validity of a patent is put in issue, to allow the proprietor",,,

of the patent to amend the specification of the patent ""in such manner, and subject to such terms .... as the court .... thinks fit"". Plainly seen, this is a",,,

wide statutory discretion. The general principles on which such discretion should be exercised were summarised by Aldous J in Smith, Kline & French",,,

Laboratories Ltd v. Evans Medical Ltd (1989) FSR 561 as follows:,,,

First, the onus to establish that amendment should be allowed is upon the patentee and full disclosure must be made of all relevant matters. If there is",,,

a failure to disclose all the relevant matters, amendment will be refused.",,,

Secondly, amendment will be allowed provided the amendments are permitted under the Act and no circumstances arise which would lead the court to",,,

refuse the amendment.,,,

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Thirdly, it is in the public interest that amendment is sought promptly. Thus, in cases where a patentee delays for an unreasonable period before",,,

seeking amendment, it will not be allowed unless the patentee shows reasonable grounds for his delay. Such includes cases where a patentee believed",,,

that amendment was not necessary and had reasonable grounds for that belief.,,,

Fourthly, a patentee who seeks to obtain an unfair advantage from a patent, which he knows or should have known should be amended, will not be",,,

allowed to amend. Such a case is where a patentee threatens an infringer with his unamended patent after he knows or should have known of the,,,

need to amend.,,,

Fifthly, the court is concerned with the conduct of the patentee and not with the merit of the invention.",,,

136. Accordingly checking the principles before exercising such discretion, we find that the onus has not been established by the Respondent who is",,,

the patentee, making full disclosure of the invention, as to why it is done, thus meeting the requirements of the provisions of law in force. The patent",,,

was filed on 8.7.1998 claiming the priority date of 8.7.1997 and was granted on 23.2.2007. The application for revocation was filed only on 27.1.2009,,,

raising the question of patentability under the law and the patentee who is the Respondent in the revocation application has not sought necessary,,,

amendments immediately within a reasonable period, to avert such patentability issue, but the necessity of which never arose until the same was",,,

challenged now by the applicant herein. In fact during the hearing, the applicant's counsel confirmed that the Respondent has already amended the",,,

claims in the USPTO to meet the requirements of law. The amendments have been filed just one day before the date of hearing. The amendment,,,

sought has not been made in a prescribed manner. The patentee, who is the Respondent herein, has delayed for an unreasonable period before",,,

seeking this amendment of the claims. The Respondent has not shown any reasonable grounds for his delay. This shows the conduct of the party, viz,",,,

the Respondent and when it is causing concern to the Court while considering the matter, the merits of the amendment do not find a place for allowing",,,

the same. Moreover the revised claim 1 of the specification as amended should fall wholly within the scope of the claim of the specification before the,,,

amendment. When these requirements have not been complied with, in a sincere

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and genuine manner by the Respondent, the amendments sought",,,

have not been allowed.,,,

137. Requirement under Section 8 of the Act --During the hearing of this case the applicant's counsel pointed out that the Respondent has submitted,,,

along with their counter statement the details of corresponding applications made outside India in the form of an annexure marked as Annexure-A.,,,

This Annexure-A gives the details about the filing of the application in USA and its grant therein i.e., the US application has been made on 7th July,",,,

1998 and the same was granted on 8th March, 2005. Likewise the Annexure-A also contains details regarding the filing in various other patent offices,",,,

such as EPO, Australia, Canada, New Zealand etc. From the details available in the said Annexure-A it is seen that the patent has been granted in",,,

Australia, EPO, New Zealand and USA on the respective dates, 6-9-2001, 19-6-2002, 9-12 2002 and 8-3-2005 respectively. Whereas the Indian",,,

application has been filed on 8th July, 1998 claiming the priority of 8th July, 1997. The 18th month publication has taken place on 29th July, 2005 and",,,

obviously the examination of this patent application must have taken place after this date of publication and the patent was granted on 23rd February,",,,

2007. Based on the information available in the Annexure-A and on an analysis and scrutiny of the US application the fact that the Respondent has,,,

amended his claims in US based on the office action and restricted his claims. Further in abundant caution while defending the attack of revocation of,,,

the patent, the Respondent has replied that the patent has been granted in almost 11 countries after having followed a strict examination procedure.",,,

Probably with all these information the applicant has found out the amendments have been carried out in the US application before grant, as there is",,,

absolutely transparency in the patent grant procedure in the USPTO. Hence though not having raised this objection regarding furnishing of information,,,

under Section 8 of the Act by the applicant, the counsel after having found out the amendments have been carried out in the US patent and based on",,,

the same line when the Respondent has sought an amendment in the claims of the impugned patent, this fact as to whether the details of amendment",,,

having been carried out in the US application has been informed or not, in writing to the Controller of the patents during the prosecution of the Indian",,,

application came to limelight. Against this objection by the applicant, the

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Respondent argued that the applicant has taken this ground initially and so he",,,

is barred from raising this objection at a later date and in any case the applicant is supposed to have produced the proof as to whether this information,,,

under Section 8 of the Act about the amendment has been communicated or not to the Controller of Patents. Also the Respondent said that the burden,,,

of proof is upon the applicant. In this respect the Respondent drew the attention to the Supreme Court case, Shambhu Nath v. State of Ajmer AIR",,,

1956 SC 404). The applicant's submission is that it is the duty and responsibility of the Respondent to show that he has complied with the requirement,,,

of Section 8 and must have produced the proof for verification if necessary to show the compliance is genuine, whereas the Respondent not having",,,

shown any proof, amounts to a circumstance and the situation that the Respondent has not complied with such a requirement. In this respect the",,,

applicant relied on the judgment of the Delhi High Court in Chemtura Corporation v. Union of India 2009 (41) PTC 260 (Del.). The Respondent,,,

contested saying that ""it is only a prima facie opinion and not intended to influence either the final outcome of the suit or any other proceedings. Thus,",,,

a decision which is not applicable to its own case cannot be applied to any other matter. It is submitted that the decision on the subject revocation,,,

petition cannot be guided by prima facie opinions more so, when the same is the original jurisdiction of this Hon'ble Board"". Now we find that it is not",,,

possible to accept this argument / submission made by the Respondent when he is seeking a request for amendment in the claims in line with the US,,,

patent and when his compliance regarding the submission of amendment as required under Section 8 of the Act has been questioned, the Respondent",,,

is supposed to produce or show that he has complied with the requirement. Not complying with such a requirement is a fit case for revocation as,,,

contained in Section 64(1)(m) of the Act and the provision therein is prima facie attracted. As can be seen from the provisions under Section 43(1)(b),,,

of the Act a patent can be granted only when the application has been found not to be contrary to any provision of the Act. As held in the said case,,,

law, Delhi High Court in Chemtura Corporation v. Union of India 2009 (41) PTC 260 (Del.), the fact of amendment of claims in the US patent, if",,,

provided, would have certainly come to the notice of the Controller of Patents about the office action taken by the USPTO and the extent to which the",,,

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Respondent has restricted the claims, probably avoided this proceeding before the Appellate Board. Hence we are of the opinion that the Respondent",,,

is duty bound under Section 8 of the Act, being a prima facie requirement under the said provision of the Act, that the Respondent shall keep the",,,

Controller of Patents informed up to the date of grant of patent, about the different details relating to the developments in the applications filed for",,,

grant of patents elsewhere outside India. Therefore we notice that it is a serious omission on the part of the Respondent if he had not furnished such,,,

particulars as required under Section 8 of the Act regarding the developments that have taken place like amendments in the US application herein,",,,

then it would be a fit case for revocation of the patent only on this ground as it is a original revocation application for the revocation of patent. It is,,,

found that the Respondent have not kept the Controller of Patents informed about the developments of amendments in the claim in the US patent,,,

during the prosecution of the Indian patent application before its grant. So we find that the Respondent has failed to disclose to the Controller of,,,

Patents about the information required under Section 8 of the Act and has also furnished information which in any material particular was false to his,,,

knowledge.,,,

138. Conclusions,,,

1. Obviousness,,,

a. Comparing the features in the US '095 patent, US '999 patent and US '526 patent, the inventive features as construed from the principal claim 1, no",,,

difference between the inventive features claimed in the impugned patent and features shown in the above US patents could be perceived or noticed.,,,

b. Invention claimed would be obvious to a person skilled in the art having regard to the state of the art, when no technical advance over the prior art,",,,

is established, that patent lack inventive step and will become invalid.",,,

c. In the instant case, on the date of the patent, the US '095 patent, US '999 patent and the US'526 patent are already known to the public knowledge",,,

and the person skilled in the art is aware of the same and has clear access to know and make himself up to date with the development of technology,,,

evolved till then. So any skilled person in the art, though he is unaware of this impugned patent, but with his average knowledge and skill in the field of",,,

relevant technology will certainly be able to visualize the details of the invention

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and will be able to arrive at this invention, as this is a known technical",,,

knowledge, that in the field of wind power machines, when there is a huge noise from the rotating machines causing noise pollution in the nearby",,,

environment, the first step would be is to how to suppress the noise emission or elimination of noise while running the wind power machines, which the",,,

person skilled in the art would also certainly tap every available source to overcome this noise suppression. This person skilled in the art may not have,,,

an access to the latest development which are available in the patent documents like the one under consideration or may not be aware of it even. But,,,

yet the problem being more than a decade old according to the date of this patent, every electrical engineer running any such rotating machines would",,,

have come across such problem earlier and tried to have solved the problem. If the technical solution shown now, does not exhibit any technical",,,

advance over the existing technology as required under the Section 2(1)(j a) of the Act, then absence of any such technical advance in the work done,",,,

compared to the knowledge present and available in the state of art, would not deserve the right of any monopoly.",,,

d. In view of this analysis and the finding herein, it is very clear there is no inventive step in the method claimed in the impugned patent and the",,,

invention claimed is obvious to any skilled person in the Article,,,

2. Therefore combining the teachings of all said cited US patents, a person skilled in the art can arrive at the invention claimed in the claim 1 of the",,,

impugned patent. Hence the invention cannot be said to have any inventive step and the invention is obvious.,,,

3. The Respondent has not established the onus to amend the claims in meeting the requirements of law in force. The application for revocation was,,,

filed only recently raising the question of patentability and the Respondent has not sought the amendments immediately to avert revocation issue.,,,

Amendments have been filed one day prior to the date of hearing and so the amendment has not been made in the prescribed manner. The delay for,,,

an unreasonable period before seeking this amendment of the claims has not been shown which tells about the conduct of the party, causing concern",,,

to the Court while considering the amendments, they do not find to be allowable. Moreover the revised amended claim 1 does not fall wholly within the",,,

scope of the claim of the specification as seen before the amendment. These

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requirements have not been met, in a sincere and genuine manner by",,,

Respondent. So we refuse the amendment sought and accordingly, the amendments sought have not been allowed.",,,

4. It is found that the Respondent have not kept the Controller of Patents informed about the developments of amendments in the claim in the US,,,

patent during the prosecution of the Indian patent application before its grant. So we find that the Respondent has failed to disclose to the Controller of,,,

Patents about the information required under Section 8 of the Act and has also furnished information which in any material particular was false to his,,,

knowledge.,,,

139. Hence after taking into consideration of the above said case laws and findings and analysis made herein above, together with foregoing",,,

statements in the conclusions, we hereby allow the application for the revocation of the patent M.P. No. 6/2010 for stay has been dismissed as nothing",,,

remains in the miscellaneous petition and also that the main application has been disposed of M.P. No. 28/2010 for early hearing is dismissed as,,,

infructuous. As per the directions of the Hon'ble High Court of Madras, all the miscellaneous petitions have been heard and decided along with the",,,

main application. Consequently the patent granted to the Respondent is revoked and we direct the Controller of Patents to remove the patent No.,,,

200616 from the register of patents. The parties shall bear their own costs.,,,

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