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**IN THE COURT OF JURISDICTION**

PONY CORPORATION ..... Plaintiff

Through: Mr.Pravin Anand, Advocate

versus

DONKEY CORPORATION .....Defendant

Through: Mr. Hemant Singh and Ms. Saya  
Choudhary, Advocates

**CORAM:**

**JUSTICE PRATHIBA M. SINGH**

**DRAFT JUDGEMENT FOR MOCK TRIAL**

**Prathiba M. Singh, J.**

**Brief Background:**

1. The Plaintiff-Pony Corporation (*hereinafter 'Plaintiff'*) has filed the present suit seeking permanent injunction restraining infringement of patent No. 20190925 granted on 25<sup>th</sup> September, 2008. The patent application was filed on 25<sup>th</sup> September, 2002 and the term of the patent is till 24<sup>th</sup> September, 2022. The Plaintiff has paid all the annuities and the patent is valid.
2. The Patent relates to an invention titled '*Control method for a car navigation system*'. The asserted claims of the patent read as under: -

*“Control method for car navigation system that displays a map on a display screen, the method comprising steps of:*

*reading, from first memory means in which facility data comprising display data indicative of a plurality of service facilities and coordinate data indicative of existing positions of the service facilities have previously been stored, the display data to display the plurality of service facilities on the display screen;*

*designating one of the plurality of service facilities displayed on the display screen in accordance with an operation;*

*reading coordinate data corresponding to the designated one service facility from the first memory means;*

*storing the read coordinate data as user registered data in second memory means; and*

*displaying a position indicated by the coordinate data read from the second memory means by superimposing a predetermined pattern on to the map when the map is displayed on the display screen.”*

3. The Defendant- Donkey Corporation (*hereinafter ‘Defendant’*) began offering a car navigation service called the DK car navigation in India from 25<sup>th</sup> September, 2013. The said service was offered by the Defendant through leasing of a dedicated portable terminal, held by the customer, known as the DK terminal (*hereinafter ‘D terminal’*). The Defendant implements a method to control a car navigation system which comprises of: -

- (a) A server managed and operated by the Defendant
- (b) The D terminal held by the user.

The server program was exclusively customized by the Defendant for the D method, and is known as the D server program. The same is installed in the Defendant's server.

4. In order to avail the D service, a monthly service charge of 300 yen (3USD= 210 Indian Rupees) is required to be paid by a customer. A subscription would entitle the customer to use both the D terminal and the D server.

5. After a span of five years, i.e., in 2018, the Plaintiff filed an infringement suit against the Defendant seeking permanent injunction, delivery-up and damages of 10 million USD (₹70 crores approx.).

6. No interim injunction was sought in the suit. Parties have completed their respective pleadings. The Defendant has not filed any counter-claim for revocation. However, under Section 107 of the Patents Act, 1970 (*hereinafter 'Act'*) all the grounds for revocation would also be grounds to resist infringement of patent. Broadly, the documents are admitted between the parties i.e.,

- (a) the certificate of registration of patent,
- (b) an extract from the patent register showing payment of annuities
- (c) the granted claims and specification accompanied thereto

(d) the patent prosecution documents ('filewrapper')

(e) details of the Defendant's system.

7. After completion of pleadings and admission/denial of documents, the counsels for the parties made their opening statements. On the basis of the pleadings and the opening statements, the following issues were framed for adjudication in the suit:

- 1. *Whether the court has the jurisdiction to decide the issues in the suit? (onus on Plaintiff);***
- 2. *Whether the Plaintiff is the registered owner of the suit patent? (onus on Plaintiff);***
- 3. *Whether the Defendant is infringing the suit patent? (onus on Plaintiff/onus on Defendant where subject matter of the patent is a process);***
- 4. *Whether the suit patent is invalid in nature and liable to be revoked? (onus on Defendant)***
- 5. *Whether the Plaintiff is entitled to seek an injunction restraining the Defendant from infringing the suit patent? (onus on Plaintiff);***
- 6. *Whether the Plaintiff is entitled to damages? (onus on Plaintiff);***

**Brief findings on the Issues:**

8. Based on the documents filed by the Plaintiff which include print-outs of Defendant's website, it is evident that D services are available within the jurisdiction of this Court and thus, issue no.1 is decided in favour of the Plaintiff. Further, the Plaintiff has placed on record, certified copy of e-Register which is not denied by the Defendant, thus issue no.2 is decided in favour of the Plaintiff. The Defendant has not filed any counter-claim, and thus the patent is deemed to be valid. Thus, issue no.4 is decided in favor of the Plaintiff.

9. The only question that is to be determined is in respect of infringement of patent and whether the Defendants' system/methods violate any of the claims of the suit patent and consequential relief thereof. In relation to issue nos. 3, 5 and 6, the Plaintiff has led the evidence of its expert witness, Mr. Rajiv Bhatnagar. He has also been cross-examined by the Defendant's counsels. The Defendant has not led any oral evidence. Evidence thus stands concluded on behalf of both parties.

**Submissions of the Parties**

10. On behalf of the Plaintiff, Mr. Pravin Anand, Ld. counsel has submitted that since the patent consists of a method claim, in view of Section 104A of the Act, the onus to prove as to what the Defendant's method is upon the Defendant. He submits that since the facts are not disputed by the parties, in respect of the Defendant's method, he wishes to proceed straight for

interpretation of the claims. He submits that the word/expression “means”, used in the claims would have to be interpreted broadly. The said expression is a ‘nonce word’ which could be used in respect of several physical appliances or devices. It, thus, would include any particular device which could act as a storage for being the first memory or the second memory. Thus, according to him, the term is not to be interpreted restrictively but in an expansive manner. He further relies on Section 10(5) of the Act to urge that the “inventive concept” in the patent is a solution to a problem that vehicle owners would not remember historical data of selected spots which they intend to visit. The same has been overcome by the suit patent method, which allows a user to access pre-saved location data (facility data) for multiple spots, select one such facility data, and register the same as coordinate data and separately save it. The coordinate data is then used for the purpose of navigation. This problem which the patent intends to solve could be achieved in several ways. Thus, the inventive concept can have various embodiments and each of the said embodiments ought to be deemed to be covered by the claims. He submits that by the time of the filing of the present patent, use of remote servers and cloud computing was quite prevalent, as the same had gained momentum in the 90’s itself. He cites the example of Amazon web services which used cloud-based infrastructure services. Thus, according to him, the word “memory” for a person skilled in the art, on the priority date, would mean an electronic storage and retention means, from which data could be retrieved upon request.

11. Thus, according to Ld. Counsel, the suit patent does not require a first memory means to be a portable medium like a CD ROM or a Flash drive which can be installed inside the vehicle, it could even be a remote server. He finally submits that the first and second memory means could both be combined to be located in the same server as well.

12. To support the above pleas, Mr. Anand relies upon various rules of claim construction which are well established in Indian law: -

- (a) That if a claim is clear, the scope of the claim is to be determined by a reading of the claim itself, without reference to the content in the specification.
- (b) Only if there is any ambiguity or vagueness in the claims, the patent specification needs to be looked at.
- (c) For interpreting the claims, even the prosecution history is not relevant, if there is no ambiguity in the claims. The terms “first memory means” and “second memory means” are too clear from the claims and no external aids are required to interpret them.
- (d) The word “means” being a word which can denote a wide range of devices, is neutral of any particular structure. (Reliance is placed on judgements passed by the United States Court of Appeals for the Federal Circuit in *Richard A. Williamson v. Citrix Online LLC*, (No. 13-1130 (Fed. Cir. 2014) decision dated June 16, 2015) and *Robert Bosch v. Snap-On Incorporated*, (No. 14-1040 (Fed. Cir. 2014) decision dated October 14, 2014).

13. Further, reliance is also placed on Section 4.4.5 of the CRI Guidelines, 2017 wherein the Patent Office also recognizes that CRI's are often phrased with use of expression "means" to enable conversion of digital signals to analog signals.

14. The inventors being conscious of the global trends of digital technologies, limiting of the word "means" to any particular kind of storage device would not be a correct approach.

15. The Defendant has copied the main inventive concept i.e. giving assistance to users in vehicles with information as to their spots of interest and their locational information on a map.

16. The system offered by the Defendant is clearly infringing as all the main features of the patented system are contained in the Defendant's invention, namely:

- a terminal within a vehicle with a screen;
- stored information of various spots on a map to be recalled on the screen;
- storage of information related to a specific spot and registering the same in the computer's memory for being displayed on the map.

All these steps of the patented method are contained in the Defendant's system, hence there is infringement.



17. On behalf of the Defendant, Mr. Hemant Singh and Ms. Saya Chaudhary, Ld. counsels have made their submissions before the Court. The first submission of the Defendant is that the specification needs to be read in order to understand the claims as there is no clarity as to the location of the primary and the secondary means in the claims. Since the patent is for a method and not a product, the proper way of understanding the method would be with reference to the specification and the detailed description given in the specification.

18. It is further submitted that since the method relates to a particular system and there is no claim for the system itself, the manner in which the claimed method is to be implemented in the system can only be understood from the specification. The claimed method is to provide a convenient and cost-effective car navigation system. The only manner in which the purpose of the patented method can be understood is by understanding the system where the method is implemented. The method is not in abstract and goes hand in hand with the system. Considering that the installation and maintenance of a remote server requires enormous investment, the same cannot be considered as cost-effective. Thus, the patented method is implemented in an integrated system which is a composite unit within the vehicle itself and neither of the memory means is located outside the vehicle. The method requires application of various steps sequentially as is clear from the diagram supplied. The fact that there is a clear bus line connecting the system itself shows that it is an integrated system located in one place. It is submitted by Ld. counsel that it is evident from the

reading of the specification that the purpose of the patented method is to store facility data in a CD ROM and secondary memory means stored in rewritable RAM, both fulfilling the objective of improving convenience and providing cost effective navigation system. Such cost efficiency cannot be achieved by operating a remote server with constant power backup.

19. One of the main planks of the Defendant's case is the prosecution history of this patent wherein a pedestrian navigation system was cited as a relevant prior art. When the said prior art was cited by the Patent Office, the Patentee/Plaintiff made an assertion that the patented method is different from the prior art, because the system according to the invention is installed "in the vehicle" and there is constant power supply from the battery of the vehicle. Since, the Plaintiff itself distinguished its method/system from the prior art by clearly stating that the system is located in the vehicle, the said statement should be held to be binding on the Plaintiff. It is, thus, submitted that the claim must be read in a restricted manner or alternatively, the Court ought to rectify the claims in order to read them in terms of the prosecution history.

20. The following legal propositions are urged before the Court by the Id. counsel for the Defendant:

- a. The claim has to be read with the specification and not in isolation, as held in ***Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, (1979) 2 SCC 511.***

- b. Since the term “means” is broad and the patent is a method patent, the rules of purposive construction and not literal construction should be adopted for interpreting the claims. (*F. Hoffman-La Roche Ltd. v. Cipla Ltd.*, [(2015) 225 DLT 391 (DB)] and *Merck Sharp and Dohme Corporation v. Glenmark Pharmaceuticals* [FAO (OS) 190/2013 Decided on 20<sup>th</sup> March, 2015].
- c. Once a Patentee obtains a patent on a narrow reading of the claim, it is not unfair to bind the Patentee to a narrow construction of the claim. *Furr v. C.D. Truline* [[1985] FSR 553] and *Merck & Co. Inc. v. Generics UK Ltd.* [[2004] R.P.C. 31].

21. Thus, it is submitted that the Defendant’s car navigation system consisting of a remote server does not infringe the suit patent. There are fundamental differences between the Plaintiff’s and the Defendant’s method. The Plaintiff’s method involves use of secondary memory means located in the vehicle. The Plaintiff’s secondary memory receives its power backup from the car battery which enables it to register the user data even when the car is not running and this enables the user to retrieve the data. However, in the Defendant’s system, there is only a display terminal in the car with a remote server being used by various users who are connected to it through their terminals. The manner of operation, the efficiency and the costs involved in the two systems are not comparable. The Defendant’s system is different because both its primary and secondary means are one and the same i.e. a server unlike the Plaintiff’s patented system which has ROM and RAM memory, which

serve as the first and the second memory means respectively. The ROM memory further ought to be read as a CD ROM as disclosed in the specification, in order to achieve cost efficiency.

22. Thus, by reading the claims narrowly, as per the specification, it is clear that the Defendant does not infringe the suit patent.

**Summary of evidence of Mr. Rajiv Bhatnagar**

23. The Plaintiff, during the course of trial by way of examination-in-chief of its Expert Witness Mr. Rajeev Bhatnagar, was able to establish a person with qualifications in Electronics and Telecommunication such as an Engineer would be regarded as a person skilled in the art in the field of Car Navigation System. Such a person, on the date of filing of the patent, had knowledge relating to cloud computing, and different forms of memories, including external memory which could include cloud-based memory. Further, such a person would know that the cost of memory is substantially lesser when put on a server or on cloud as compared to when it is individually pre-fixed inside a vehicle or localized. In view of the same, it was argued by the Plaintiff that based on the prosecution history, it cannot be argued that the inventor intended to claim a very limited localized memory as opposed to decentralized memory, which is also evident from the manner in which the finally granted claims are worded.

24. The Defendant in cross-examination sought to establish that, the second memory means which is a RAM was localized within the vehicle, as that was

the only manner in which the secondary power source from the battery of the vehicle could be drawn by such memory. The Defendant also sought to establish that one of the key objectives of the suit patent was to provide a convenient and cost effective Car Navigation System, which could be achieved only when both the first and the second memory means were located inside the vehicle. However, the Expert Witness disagreed with the counsel for the Defendant, and during the course of his cross-examination clarified that a server is much more cost effective, and convenient as compared to CD ROM and RAM separately installed inside a vehicle. He further clarified that even a server can be configured to have a secondary source of power, which was claimed by the Plaintiff to be the inventive feature during the course of prosecution. Further, even though the Expert Witness admitted that the only embodiment detailed in the complete specification depicts a composite Car Navigation System, wherein the display terminal and both memory means are located in the same place, and are connected by bus lines which were different from wireless network system as used in D's method. However, the Expert Witness clarified that based on the knowledge prevalent in the art at the time of filing of the suit patent, it would be known to a person skilled in the art that bus line connections can be replaced with wireless network connections, and both these would be regarded as being equivalent to each other.

### **Analysis and Findings**

25. The points that have arisen for determination are as under:

- i. *Whether all the features of the car navigation system as per the suit patent are installed in the vehicle?*
- ii. *Even if all the features of the car navigation system are not installed in the vehicle, does D's method satisfies the "first memory means", and "second memory means" of the suit patent?*
- iii. *Whether P Corporation would be bound by the statements made related to the suit patent during prosecution?*
- iv. *If yes, what would be the effect of the same on infringement analysis by the Court?*

26. The manner of interpretation of a Specification and its claims is well settled. Section 10 of the Act requires a Patentee to give a description of the invention and thereafter set out the claims which would define the monopoly. The claims have to be interpreted in the context of the invention and are not alien to the specification. The specification and the claims have to be read as a whole in order to understand the purpose and object of the invention, the existing prior art, the inventive concept in the invention as also the actual monopoly claimed. In ***Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, (1979) 2 SCC 511***, the Supreme Court had held as under:

*"As pointed out in Arnold v. Bradbury (1871) 6 Ch. A. 706 the proper way to construe a specification is not to read the claims first and then see what the full description of the invention is, but first to read the description of the invention, in order that the mind may be prepared for what it is, that the invention is to be claimed, for the patentee cannot claim more than he*

*desires to patent. In Parkinson v. Simon (1894) 11 R.P.C. 483 Lord Esher M.R. enunciated that as far as possible the claims must be so construed as to give an effective meaning to each of them, but the specification and the claims must be looked at and construed together.*

*The learned trial Judge precisely followed this method of construction. He first construed and considered the description of the invention in the provisional and complete specification, and then dealt with each of the claims, individually. Thereafter, he considered the claims and specification as a whole, in the light of the evidence on record.”*

27. In ***Lallubhai Chakubhai v. Chimanlal & Chunilal & Co., AIR 1936 Bom 99.***, the Court held as under:

*“Patentee must particularly describe and ascertain the nature of his invention in the specification, as the ambit of his invention is circumscribed by the claims. The construction of a specification is a matter of law and is for the Court. It must be construed as a whole. A specification must be construed impartially, and the Court is generally slow to construe it against the patentee. But the construction must be reasonable one.”*

28. The claims in the present case clearly use broad terminology. The term “means” cannot be read in a restricted manner and has to be interpreted in the context of the invention itself. It is a fact of which judicial notice can be taken, as confirmed by the expert witness, that there has been a drastic change in the

manner in which memory is stored and the devices used therefor. The devices have undergone constant progression over the years and the physical nature of the device cannot restrict the word expression “memory means”. The term of a patent being twenty years, if the specification contains an example of a CD ROM, to restrict the term “memory means” to a CD ROM would be doing injustice to the invention as the devices that can be used to store memory are extremely fluid in nature. The said means could include a large server to the smallest USB/flash drive. In 2002, the inventors could not have restricted the claims of the suit patent to a first memory and a second memory means which were both localized since non-localization of such data was quite prevalent at that time.

29. The context of the invention is to provide for a constant dialogue between the primary and the secondary means, for ensuring that the user does not need to perform complicated operations to find a location. The intention is not to just make it just cost-effective but primarily to make the same user-friendly, by allowing the primary and the secondary means to seamlessly communicate with each other constantly and provide the results on a display terminal.

30. The specification clearly captures the objective/purpose of the invention as user-friendly - “*without performing complicated operations for displaying service facilities on the map*”. Viewed from this perspective, the inventive concept of the invention resides in the method by which the primary and the secondary means communicate constantly with each other rather than the



location or the nature of the said memory means. What is important is how the required data by the user is thrown up on the terminal by an inter-link established between the primary and the secondary means wherein the stored data is used for the purposes of displaying the requested data on the basis of the input received from the user, communicated by the primary means to the secondary means. The integrated data so acquired, is then displayed on the display terminal. This obviates the requirement for the user to choose, for example - latitude/longitude coordinates or to know by the user's memory, the name of the facility etc., The user is able to arrive at his destination on the basis of generic knowledge rather than specific technical detailed knowledge. If the purpose of the invention is to create such a system and a method to operate the said system, any other system which uses an identical or an equivalent method to produce the same result would be infringing in nature.

31. The primary and the secondary means are thus not required to be interpreted in a narrow manner but have to be interpreted purposively in the context of the invention and the objective sought to be achieved by the said invention. As per Section 10(4)(c) of the Act, the claims define the "*scope of the invention*". Section 10(4)(b) makes it clear that the Patentee has to disclose in the specification, "*the best method of performing the invention which is known to the applicant*". This clearly shows that the Patentee at the relevant point, may have thought that the best method practically feasible and cost-effective, would be to use a CD ROM for the primary memory means. However, the "best method" cannot be construed as "the only method". The

scope of the claims is beyond the best method disclosed. The claims have to be thus, interpreted broadly, and the Court would have to take into consideration the technological development in the relevant art at the time of filing of the patent in order to determine its scope.

32. D terminal has a primary and a secondary memory means - both may be remotely located and even located in the same server. The physical location does not take away the fact that the server performs the function of two memory means. The physical location of the system except the terminal being outside the vehicle does not take the D terminal outside the claims so long as the D terminal has the primary means, the secondary means and the terminal. The navigation system of the Defendant achieves the same purpose using the same method. The present patent is a method patent and not a patent for a system. If the patent was for a system wherein each of the components was defined and restricted, say for example as a CD ROM, the components of such a system would have been identified and even restricted, to what was disclosed in the specification. However, since, the patent is for a method, any system which uses the same method but contain different components, would infringe the patent, if broadly, the same method is followed without taking into consideration the location of the components.

33. The achieving of the object of the invention through an equivalent means would also constitute infringement by applying the doctrine of equivalents. This is a well recognized doctrine under Indian Law and has been applied in

several patent cases. In ***Raj Parkash v. Mangat Ram Chowdhry, AIR 1978 Delhi 1***, the Court held as under:

*“...Unessential features in an infringing article or process are of no account. If the infringing goods are made with the same object in view which is attained by the patented article, then a minor variation does not mean that there is no piracy. A person is guilty of infringement if he makes what is in substance the equivalent of the patented article. Some trifling or unessential variation has to be ignored.*

....

*We have seen the viewers marketed by the defendants and the viewers produced by the plaintiff. The viewers marked and kept on the record as (1), (1A) Mecorama and a fourth viewer are definitely objects produced by piracy of the plaintiff's patent. The defendants have made certain variations in its viewers but these are unessential; and what the defendants market is substantially the same thing, as was conceived by the plaintiff. By trifling variations if the effect obtained by the defendants is the same, and we hold that it is the same, then according to the rule enunciated in the Ampicillin case, referred to above, there is a clear piracy. The idea of the plaintiff which is a novelty is clearly infringed.”*

Thus, unessential or trifling variations from the patented methods would not obviate infringement. Location of the primary and secondary means in the car is not the essential feature of the invention but only one of the means to achieve the purpose behind the invention. The same purpose, can be achieved using the same method, by changing the location of the primary and secondary means.

34. In so far as prosecution history and file wrapper estoppel is concerned, the complete details of cited invention 1 and 2 are not available and whether the said cited inventions were ever put into practical application is also not known to the Court. The Defendant has not been able to show as to whether the cited invention during the prosecution history had the features of the claimed invention. Mere reliance on a statement made during the prosecution history in an isolated manner would not suffice to read the invention in a narrow and constricted manner, in the absence of further details of the cited invention. The cited invention ought to have been produced before the Court and expert evidence ought to have been led to show the inventive elements in the cited invention, which the Defendant has failed to do. On the basis of the available data about the cited invention, it appears that it was only a navigation apparatus for pedestrians and the question as to whether the said pedestrian system had any separate memory means at all is not clear. The cited invention 1 could have been a standalone apparatus which had pre-fed information relating to facilities and in that sense, could have just been an electronic version of a map. Recently, in *Shogun Organics Ltd. v. Gaur Hari Guchhait & Ors.* [CS (COMM)201/2017, decided on 14<sup>th</sup> August, 2019] this Court has held as under:

*“This issue is also worded in the negative, and the onus has been placed on the Defendants. The reason for this appears to be the background in which the Defendants failed to disclose the process which was adopted by them. The Court repeatedly directed the Defendants to disclose their process, which they failed*

to do. The affidavits filed were cryptic and did not answer the question posed by the Court.

33. Under Section 104A, whenever the subject matter of a patent is a process, the Court can direct the Defendants to prove that the process used by the Defendants is different from the patented process. Recently in *Communications Component Antenna Inc. v ACE Technologies Corp. and Ors.*, CS (COMM) 1222/2018, Decided on 12th July, 2019 this Court has held that the Defendant cannot withhold its best evidence, especially if the same is within its own knowledge. The extract reads as under:

“64. It was quite convenient and easy for the Defendants to produce the beam patterns of their antenna to argue that they do not infringe the patent of the Plaintiff. The bare denial being given shows that the Defendants have deliberately chosen not to produce the beam patterns. In any event, the claims of the invention, and the beam patterns attached in the patent specification, show that the beam patterns need not be identical to the drawings accompanying the specification. Minor variations would not obviate infringement. Equivalence would also apply. The preferred embodiments of an invention are what they say, i.e., they are only the “preferred” embodiments. They are not the only embodiments. The claims are broader than the preferred embodiments and have to be read as such.

65. The technical opinion produced by the Defendants seeks to limit the Plaintiff's

*patent to the beam patterns contained in paragraph 28 of the plaint, which it cannot do. The Defendants have not produced any documents to show that they have followed any other invention or any other prior art document, in the construction of their antenna. The withholding of beam patterns, by the Defendants, leads this Court to draw an adverse inference against the Defendants, as the Defendants have withheld and not disclosed the most crucial aspect of this case i.e., the beam patterns of their antennae.*

*66. In a patent infringement action, once the Plaintiff, prima facie establishes infringement, the onus shifts on the Defendants, to disprove the same. The complete silence by the Defendants shows that there is, in fact, withholding of relevant and crucial information from the court. During the course of arguments, since the beam patterns were not produced on record, it was put to the Defendants if the antenna could be made available for inspection by a scientific expert appointed by the Court, to which no positive response was elucidated by the Defendants. A perusal of the claims, complete specification, and the beam patterns read with the two reports by the experts, placed on record by both parties, clearly establishes infringement. The Defendants' expert has not dealt with the issues raised head on in respect of the beam patterns, but has sought to deflect the issue. Thus, at this stage the Court has no option*

*but to draw an adverse inference against the Defendants.”*

34. *In the present case, the new product sought to be patented was D-trans Allethrin manufactured with a new process. The Defendants did not again, lead any evidence to show why the Defendants’ process is not infringing. In order to establish the same, the Defendants would have had to:*

*a) disclose their process;*

*b) highlight the differences in the process; and*

*c) show that the product obtained from the Defendants’ own process has different properties or reactants or ingredients, though it could still be D-trans Allethrin.*

35. *None of this is done by the Defendants. On the other hand, the Plaintiff’s witness has, in his affidavit shown the manner in which the process used by the Defendants is the same as that of the Plaintiff by conducting a HPLC (High Performance Liquid Chromatography) test.”*

35. On the question of file wrapper estoppel, the settled position is that statements made during prosecution are ‘less useful’ for claim construction. At best, the Court can look at statements made during prosecution if the same were made prior to the grant of the claims and not thereafter. In ***F. Hoffman-La Roche Ltd. v. Cipla Ltd., [(2015) 225 DLT 391 (DB)]***, it was held as under:

*“In the decision reported as 415 F. 3d 1303 Edward H. Phillips v. AWH Corporation it was held that claims have to be given their ordinary and general meaning*

*and it would be unjust to the public, as well as would be an evasion of the law, to construe a claim in a manner different from plain import of the terms and thus ordinary and customary meaning of the claim term is the meaning of the term to a Person Of Ordinary Skill in the Art as of effective date of filing of the patent application. In case of any doubt as to what a claim means, resort can be had to the specification which will aid in solving or ascertaining the true intent and meaning of the language employed in the claims and for which the court can consider patent prosecution history in order to understand as to how the inventor or the patent examiner understood the invention. The Court recognized that since prosecution is an ongoing process, it often lacks clarity of the specification and thus is less useful for claim construction. The Court also recognizes that having regard to extrinsic evidence such as inventor testimony, dictionaries and treaties would be permissible but has to be resorted to with caution because essentially extrinsic evidence is always treated as of lesser significance in comparison with intrinsic evidence. In the decision reported as 457 F.3.1284 (United States) Pfizer v. Ranbaxy the Court held that the statements made during prosecution of foreign applications are irrelevant as they are in response to unique patentability requirements overseas. The Court also held that the statement made in later unrelated applications cannot be used to interpret claims of prior patent. In the decision reported as 1995 RPC 255 (UK) Glaverbel SA v. British Coal Corp the Court held that a patent is construed objectively, through the eyes of a skilled addressee. The Court also held that the whole document must be read together, the body of specification with the claims. But if claim is clear then*



*monopoly sought by patentee cannot be extended or cut down by reference to the rest of the specification and the subsequent conduct is not available to aid the interpretation of a written document.”*

36. The Patent Office, in view of the cited invention, if it deemed appropriate, ought to have restricted the claims of the patent on the basis of the geographical location. The claims themselves having not being challenged in the present case and there being no restriction in the claims, the Court cannot import language into the claims so as to restrict or limit them. To read the claims as the Defendant wants this Court to read, would mean importing of limitations into the claims which do not exist. The claim would have then read as – “Control method for car navigation system **installed in the car**....”

37. The above limitation which the Defendant wants the Court to read into the claims, being conspicuously absent in the claims, the claims cannot be restricted. The Defendant, however, has the option of approaching the Intellectual Property Appellate Board (IPAB) seeking revocation or restriction in the claims, as has been sought by Ld. counsels for the Defendant. Until then, however, the Court would have to hold that the Defendant’s system infringes the Plaintiff’s patented system.

### **Relief**

38. The Court has considered the submissions of the parties as also the pleadings and the documents on record. The expert has given his evidence which shows that the claims cannot be read in a narrow manner. The patent

dates back to 2002 and only three years of the life of the patent are left. The Court while considering the grant of a permanent injunction, has also to keep in mind apart from the infringement analysis, the balance of convenience and the irreparable loss and injury. In the present case, the Defendant launched its navigation system in 2013, but the suit for infringement has been filed by the Plaintiff only in 2018. Thus, in the 5-year period, the Defendant has sold its car navigation system to millions of users across the country. Considering that these navigation systems are installed in millions of automobiles which are currently running, the Court has to balance the equities. The Plaintiff has not led any evidence as to what is the loss caused to it, however, since the Defendant's system is held to be infringing, the Patentee/Plaintiff is entitled to be reasonably compensated for the said infringement. It is not clear as to whether the Plaintiff also has a successful car navigation system which has been commercialized or not. The user numbers are not available. A permanent injunction can be refused under certain circumstances by the Court and keeping in mind the interest of the consuming public, the Court can mould the relief.

39. As held in *Bard Peripherals Vascular Inc v. WL Gore & Associates*, (No. 10-1510 (Fed. Cir. 2012) decision dated February 10, 2012) the Court can, in place of a permanent injunction direct future royalties to be paid to the Plaintiff for the term of the patent, as deemed appropriate.

40. Keeping in mind the above legal position, it is directed as under:

- (a) The Defendant's navigation system is held to be infringing of the suit patent;
- (b) However, instead of granting a decree of permanent injunction, the Defendant is directed to render accounts of all sales of the infringing navigation system, in the last five years, within a period of 8 weeks from today.
- (c) Since each system of the Defendant approximately costs ₹210 and even if the Defendant is deemed to be earning 20% to 30% as profits, the profits of the Defendant per system would be ranging from ₹42 to ₹63. This Court accordingly deems it appropriate to direct the Defendant to pay to the Plaintiff a sum of ₹5/- per system as compensation/damages to the Plaintiff for all past sales.
- (d) For future sales, the Defendant shall render accounts on a quarterly basis and pay the above amount per system. The said amount shall be deposited with the Registrar General of this Court and the Plaintiff would be permitted to withdraw the same subject to furnishing a guarantee/security that if the IPAB either restricts the claims or revokes the patent prior to its expiry, the amount would be refunded to the Defendant with reasonable interest of 6% per annum.
- (e) If no revocation takes place prior to expiry, the security/guarantee shall stand automatically discharged.

(f) If the deposits directed above are not made, within the time prescribed, there shall be a permanent injunction restraining the Defendant from manufacturing, selling, offering for sale or advertising, any car navigation system including the DK Navigation system, which is infringing of the Plaintiff's Patent no. 20190925 granted on 25<sup>th</sup> September, 2008.

41. The suit is decreed in the above terms. Let decree sheet be drawn. Parties are left to bear their own costs.

**PRATHIBA M. SINGH  
JUDGE**

**AUGUST\_\_\_, 2019**