

Privy Council Appeals Nos. 37 and 40 of 1921.

Allahabad Appeals Nos. 16 and 17 of 1918.

Gopi Lal - - - - - *Appellant*

v.

Lakhpat Rai and others - - - - - *Respondents.*

Srikishen Das and others - - - - - *Appellants*

v.

Lakhpat Rai and others - - - - - *Respondents.*

(Consolidated Appeals.)

FROM

THE HIGH COURT OF JUDICATURE AT ALLAHABAD.

JUDGMENT OF THE LORDS OF THE JUDICIAL COMMITTEE OF THE
PRIVY COUNCIL, DELIVERED THE 1ST MARCH, 1923.

Present at the Hearing :

VISCOUNT HALDANE.

LORD SHAW.

LORD PARMOOR.

LORD CARSON.

[*Delivered by* LORD CARSON.]

The material question to be determined in these consolidated appeals is : Whether the respondents' Indian patent No. 2191, and dated the 23rd June, 1915, is a valid patent ?

The appellants resided and carried on business as merchants at Muhalla Sadhwara Farrukhabad, and the respondents, who are the registered owners of the patent in question, resided and carried on business as merchants at Calcutta under the name and style of Lakhpat Rai Sampat Rai.

In the second appeal the respondents, on the 1st March, 1916, sued the appellants for infringement of the said letters patent, and in the first appeal the appellants, on the 16th January, 1917, presented a petition for the revocation of the said letters patent.

The said letters patent were granted to the respondents in respect of "improvements in the manufacture of a medicinal preparation," and as stated in the specification, "the present invention relates to improvements in the treatment of a substance found in the interior of some bamboos and known as 'tabakshir' or 'bamboo manna,' for the purpose of refining the same when in the raw state to convert it into a nutritious and saleable article."

This medicinal preparation was commonly known and marketed as "banslochan," and admittedly had for many years prior to the date of the said patent been refined and sold throughout India.

It was not disputed, that prior to the date of the said patent "banslochan" had been prepared for the market by a process which included (a) washing the crude material in water; (b) treating it at some period of the process with sulphuric acid; and (c) calcining the mass which had been so treated in an iron stove or pan at a high temperature.

The improvements alleged to have been discovered by the respondents, and in respect of which the said letters patent were granted, consist broadly (1) in the addition of sulphuric acid to the substance at a defined stage of the process, viz., when red hot, and (2) in the use of the process of heating of a stove constructed as described and illustrated in the said letters patent.

These improvements were the subject of distinct and separate claims in the said letters patent, and it was not disputed in the argument before this Board that under the law applicable in India, if either of the said claims was bad in law the letters patent would be invalid.

The action for infringement came to trial before the Additional District Judge of Farrukhabad, who, on the 14th February, 1917, gave judgment in favour of the defendants (the present appellants), deciding as matters of fact "that long before the plaintiffs' (respondents') application for the patent, the stove with earthen vessels and of the same construction as the patent stove, was commonly used by other manufacturers at Calcutta, and that sulphuric acid was also applied to the material while it was red hot, and not while it was still cold."

From this judgment the respondents appealed to the High Court of Judicature for the North West Provinces, and on the 22nd May, 1918, the judgment of the Court was delivered reversing the judgment of the Court below and holding that the respondents' patent was valid. As their Lordships have come to the conclusion that the first claim in the specification, viz., "In the preparation of the said substance the treatment of the same when red hot with an acid" is invalid on the grounds of want of novelty

and prior user, it is necessary to examine the judgment of the Appellate Court to see how that question was dealt with, having regard to the definite finding of fact by the Additional District Judge before whom the matter first came. In the first place, it is to be noted that the order of the Appellate Court of the 22nd May, 1918, leaves entirely untouched the question of the appellants' right to apply sulphuric or other acid in the treatment of the substance when red hot and only grants an injunction restraining the defendants (respondents) from constructing or using the special kind of stove which forms the subject matter of the second claim in the respondents' application for a patent. Upon turning to the judgment of the learned Judges, the matter is dealt with in the following passage :—

“ A difficulty has been raised with regard to the first part of the claim where the patentees state that they claim in the preparation of the said substance the treatment of the same when red hot with an acid. We have purposely refrained from referring in detail to the evidence with regard to the use of acid. We think it clearly establishes what the plaintiffs (respondents) have not seriously denied, that in some form or another, and at some stage or another in the process of manufacture, acid has always been used for purifying the material, and there seemed at one time a difficulty with regard to this claim, namely, as to whether it was not either too wide or too vague, or, in itself, old.”

Later on the judgment continues :—

“ Therefore we must hold that it is established that the treatment of sulphuric acid at “ red heat,” which is a defined stage in the process of heating, is well known to the trade and perfectly intelligible, and also new, as nobody in the case suggests that there was any defined or ascertained stage at which it was always done.”

Their Lordships find it very difficult to reconcile this statement with what follows :—

“ . . . and the patent does not confer upon the plaintiff's either the sole right to manufacture and sell the substance itself or even the sole right to apply sulphuric acid at red heat so that nobody may use it. What people cannot do is to manufacture an oven or stove substantially as described and illustrated in the specification for drying, heating, roasting and calcining the said substance, and to use such construction for the purpose of applying sulphuric acid in the process of preparing and heating the substance to a red heat in the stove.”

Their Lordships cannot help thinking that the Appellate Court did not keep sufficiently clearly before their minds the necessity of adjudicating on each claim independently and was construing the specification as if it was one for a combination and not for subject matters which were distinctively claimed. Indeed, in another part of the judgment it is stated :—

“ We find that the essential features of the process patented by the plaintiffs is the treatment of the substance at a red heat with sulphuric acid inside a closed crucible or retort made entirely of earthenware.”

Their Lordships can find no reason for disagreeing with the finding of the Additional District Judge on this point.

It is unnecessary to decide whether, when, as found by the Appellate Court, “ that in some form or another, and at some

stage or another in the process of manufacture, acid has always been used for purifying the material," a valid claim for a patent can be made for the use of such acid for the same purpose at a definite stage, *e.g.* when the material is red hot. The evidence which has been given at the trial, and which has been carefully and ably analysed by the Trial Judge, seems to their Lordships amply to support the finding of the Judge that long prior to the date of the letters patent, "the sulphuric acid was also applied to the material while it was red hot."

This was proved distinctly by Manna Lal, Ramishwar Bajpei, Shrovaj Narain, Maharaj Narain, Gobind Singh and Chhedu. No doubt there is evidence on the other side of the use of the acid at different stages, but as regards its use when the material is "red hot" the evidence is purely negative.

It is also worthy of note that from beginning to end of the plaint filed in the respondents' action there is no mention of the claim in respect of the application of the acid to the material when "red hot," and the same observation applies to the notice served by the attorney of the plaintiffs on the 3rd February, 1916, before the action was commenced, when the complaint was founded on an alleged infringement of the second branch of the plaintiffs' claim, *viz.*, the construction of a special kind of earthenware stove.

Having come to the conclusion that the first claim put forward by the respondents in the application for a patent cannot be sustained, and that therefore the letters patent are invalid, it is unnecessary for their Lordships to examine the second claim. Their Lordships, however, would like to make it clear that they must not be taken as assenting to the proposition that the substitution of well-known earthenware vessels in lieu of iron ones for the purpose of carrying out the process of manufacture would necessarily be a good subject matter for a patent.

Under the circumstances, their Lordships will humbly advise His Majesty that the present appeals should be allowed with costs. This will involve that the decree of the Appellate Court of the 22nd May, 1918, in the second appeal, should be set aside and the decree of the District Court of the 14th February, 1917, should be restored with costs, and, further, that the decree made on the appellants' petition in the first appeal on the 22nd May, 1918, dismissing the claim for revocation of the letters patent should be set aside and an order for such revocation decreed with costs.

In the Privy Council.

GOP! LAL

vs.

LAKHPAT RAI AND OTHERS.

SRIKISHEN DAS AND OTHERS

vs.

LAKHPAT RAI AND OTHERS.

(*Consolidated Appeals.*)

DELIVERED BY LORD CARSON.

Printed by

Harrison & Sons, Ltd., St. Martin's Lane, W.C. 2.

1923.