

THE PATENTS ACT. 1970
(39 of 1970)
as amended by
THE PATENTS (AMENDMENT) ACT, 2005
(15 of 2005)
(with effect from 1-1-2005)
&
THE PATENTS RULES, 2003
as amended by
THE PATENTS (AMENDMENT) RULES, 2016 .
(with effect from 16-5-2016)
And in the matter of the Patent Application Number 2018/DELNP/2005
Dated 11/05/2005

In the matter of **Patent Number 251037**

Applicant :

M/s J.C.Bamford Excavators Ltd.
(Lakshmi Kumaran & Sridharan
B6/10, Safdarjung Enclave
New Delhi)

&

Opponent :

M/s GuanXI LIUGONG MACHINERY CO. LTD. CHINA
(Renfry & Sagar
Sec.27, Gurgaon)

Present Prashant Philips
Absent opponent's agent

Applicant's Agent

DECISION

Hearing under section 25(2) of the Patents Act 1970 as amended

A post Grant Opposition in the matter of the Patent Number 251037 for the Patent Application Number 2018/DELNP/2005 dated 11/05/2005 has been filed on 22/2/2013 After compliance with the section and the rules a hearing was fixed on 23/08/2016 which was refixed on 16/09/2016 and the opponent and the Patentee attended and placed their arguments for the applicant has filed further documents under rule 60. The question of taking the same on record was examined with the written submissions of both the parties vide their letters number VRH/NSH/Krj/IP:opposition to Patent No. 251037 dated 30/09/2016 And letter number NIL dated 30/09/2016 . an interim notice was conveyed by this office vide office letter number 2018/DELNP/2005/Mech/Gr.-4/1724,1725 dated 07/07/2017 regarding the same and the hearing was again fixed on 21/07/2017 .Which both the parties sought adjournment vide their letters number VRH/hrn/IP:2018/DELNP/2005 Dated 18/07/2017 and letter number NIL Dated 17/07/2017 respectively. The adjourned hearing was again refixed on 07/11/2017 Vide this office letter number 2018/DELNP/2005/Mech/Gr.-4/1724,1725 Dated 12/10/2017 In response to this the opponent has sent their letter number VRH/hrn/IP:2018/DELNP/2005 dated 17/08/2017 apprising first time that there is a decision by the Honorable Delhi High Court regarding the infringement suit filed by the Patentee In the High court of Delhi. The Patentee attended the hearing given on 07th November 2017 and submitted his written submission on 16/11/2017 vide his letter number NIL Dated 16/11/2017 The opponent has not attended the Hearing given on 07/11/2017 .While the hearing Notice was issued on 12/10/2017 fixing the hearing on 07/11/2017. And before that on 07/07/2017 fixing the hearing on 21/07/2017. The Patentee has attended the hearing and only submitted the Delhi High Court Order and has not argued on any matter related to the Ground of opposition for the opposition under section 25(2) of the Patents Act 1970 as amended thereof filed by the Opponent. the Neither the opponent nor the Patentee has apprised the controller during the hearings taken on about the suit pending at the Delhi High court regarding the infringement and then incidence of the same on the opposition field under section 25(2) at the Patent Office under the patent Act 1970 as amended thereof. No document has been filed regarding the same . The same was also not included in the list of the documents given by both the parties to the Patent Office in their filing the documents under Rule 57 ,rule 58,59,60, of the Patents Act 1970 as amended thereof. The controller was therefore not apprised of the suit pending in the Delhi High court and the decision thereof of the Hon'ble High Court of Delhi. and it was only after the final hearing date 07/11/2017 given that both the parties suddenly came up with the decision of the Delhi high court. But as the parties have not apprised the controller of the document of the suit filed in the Delhi High court , both the parties have attended the post grant hearing under section 25(2) which was held on 16/09/2016 and raised the issues regarding further evidence filed by the opponent while the decision of the honorable Delhi High court was pending regarding infringement suit filed by the applicant. The controller was materially kept in dark and material facts were kept in hiding by both the applicant and the opponent, The delhi High court order only take cognizance of the settlement terms agreed upon by both the parties, and in the patent Act there is no provision to withdraw the opposition filed under section 25(2),. The circumstances and the proceedings of the Act warrants that a decision under section 25(2) should be given taking into consideration of the order of the Delhi High court dated 03/08/2017 as presented by the opponent and

the applicant now . The decision is in line with the proceedings of the patent Act and the substance of the Decision of the Delhi High Court .

On going through the opposition filed by the opponent under section 25(2)

The opponent has made Ground of opposition on

(A)Lack of Novelty under section 25(2)(b)

(B) Lack of inventive step under section 25(2)(e)

(C)The patentee has failed to disclose to the controller the information required by section 8 under section 25 (2) (h).

Before deciding the opposition filed under section 25(2) I have before me

The followings

1. The opposition material filed in Form 7 by the opponent
2. The reply evidence filed by the applicant
- 3.The evidence raised by the opponent invoking rule 62 (4)of the Patents Act as amended there of.
- 4.The report of the opposition board
5. The Notice issued by me regarding Post Grant opposition hearing in interim stage regarding further evidence filed by the opponent invoking rule 62(4).
6. The Delhi High Court Judgment dated 03/08/2017 .

After going through the specifications and the drawings and the claims granted to this application under Patent No. 251037 , and the report of the opposition board , The opposition Board has finally recommended that

(I)that the invention as claimed in the present patent is obvious and lack inventive step

(II) that the invention as claimed in the present patent is not patentable u/s 2(1)(ja) of the Patent At

(III) that the patentee failed in its duty to furnish information as mandated under section 8 of the Patents Act

Regarding the novelty and the obviousness I have the report of the opposition board

Both the grounds of the opponent under (A) and (B) can be discussed together and can be decided.

The opponent relied on the following documents

D1: US5265995

D2: EP 1061187

D3: US3893728

D4: US 3612310

D5 :US4372341

D6: US 3896681

D7: US 5193658

For the ground of opposition that the invention is not novel in view of the document US 5265995 .The opponent argues to list all the features of the machine and compares each feature of US 5265995 (D1) with the features of the machine under consideration in the granted patent application. The granted patent application has already agreed to these features to be part of his machine also but there are arrangements for stopping the rotation of the superstructure with B- axis.The provisions of Axis D and Axis C to move the excavator arm independently apart from the rotation of the superstructure (After fixing with less than 360 degree rotation)and the Load 11, is not present in D1.

Ground (B) of the opponent for the opposition can be understood in that the instant application is regarding an invention titled “ Excavating and loading machine” made by the applicant J.C.Bamford Excavators limited assigned with the application number 2018/DELNP/2005 entered in national phase on 11/05/2005 with the priority date 14/11/2002 The instant application has its invention related to an excavating and loading machine describing its prior arts that the excavating and loading machines are known which have a body with a loading arm at front end of the body and an excavating arm at the rear of the body and a wheeled ground engaging structure , such as pair of axles carrying ground engaging wheels. Such machines have two options for steerability, first is either one or both the axles steerable or secondly by the body being articulated. Both the options provide a machine which is capable of performing both excavating and loading operations. But with these options both the machines have constraints of not as capable of as dedicated excavating machine,

Going by page2,3,4 of the specification filed with the instant application it can be understood that the combined loading and excavating machine of the prior arts can prevent a trench being excavated closely adjacent an obstacle such as wall, some machines have the option of moving the arm sideways on a carriage but moving the arm in such a way can present visibility difficulties for an operator

The present invention extends the capabilities of known excavating and loading machine in that the excavating arm is movable together with the cab to enable excavating operations to be carried out in a wide variety of positions, without having to move the excavating arm along a carriage to a position where operator may be unsighted. The rotatable superstructure will be incapable of a full 360 degree

rotation without the excavating arm fouling the body and/or the loading arm assembly. The stops are provided mechanically to limit the rotation of the superstructure although the superstructure may rotate through up to 360 degree. This is possible by mechanical stops, hydraulic brakes may be provided for a hydraulic motor used to slew the superstructure. To dig a trench alongside an excavating an obstacle , may be carried out by combining the rotating the superstructure and slewing the excavating arm 30 about the upright slewing axis C. Mounted on the body 11 at a mounting 18 is a loading arm assembly 20 which includes a single arm which extends forwardly of the mounting 18 beyond a front end of the machine 10 . The mounting 18 permits the loading arm assembly 20 to be raised and lowered about a generally horizontal axis A, by Hydraulic or other actuators 21.

The excavating arm 30 is mounted by a mounting 32 generally centrally of the sides of the cab 26, for movement about further generally upright axis C, like king post , and for the movement about a generally horizontal axis D, such movements being affected by respective hydraulic actuators or the like controlled by the second controls within the cab 26. A king post type of mounting typically would permit the excavating arm 30 to slew through up to 180 degree.

The superstructure 25 is rotated to a desired rotational position relative to the body 11 and is then set , by mechanical/hydraulic locking device relative to the body 1 and thus during excavating operations , the excavating arm 30 is movable relative to the superstructure 25 about the axis C and D, but with the superstructure locked in a **preferential position**. Also the clarification given by the expert David Jhon Brown from the applicant's side throws light on the same lines. The cited documents D1, D2, D3, D4, D5, D6, D7 and even if the document filed by the opponent under rule 62(4) as evidence DE3932555 is taken into consideration , it does not teach that the independent movement of the excavator arm can be obtained with the help of movements about axis C and Axis D as depicted in the instant application for the excavation of trench near an obstacle such as wall. The Patent is therefore considered novel and is inventive over the cited prior arts and the report of the examination board is not considered correct on these two aspects. The Ground of opposition listed in (C) as above is agreed to, as the Patentee has failed to file at the time of application or subsequently within the prescribed period a statement setting out detailed particulars of such application under section 8(1)(a) and under 8(1)(b) to keep the controller informed in writing, from time to time, of the detailed particulars as required under section 8(1)(a), in respect of the same other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequent to the filing of the statement referred to in the aforesaid clause , within the prescribed time.

The applicant has filed before grant of the Patent following Form 3 under their letter under reference

1. Form 3 filed on 11 May 2005 vide letter no. FSG:RMG:New Patent Appln dated 11, May 2005-
-Filed details of united Kingdom, International PCT application
2. Form 3 filed on 01 February , 2007, vide letter No FSG:PMP:IP No. 2018/DELNP/2005 dated
01/02/2007 .--- information for Grant of Patent in United Kingdom

3. Form 3 filed on 27 March 2006 vide letter Number FSG:TRK:IPAppln No. 2018/DELNP/2005 dated 27 March 2006,--- information on filing the Patent Applications in US,Brazil,China , Europe ,Japan
4. Form 3 filed on 29 December 2011vide letter no FSG:SS:2018/DELNP/2005 dated 29/12/2011 filed on 30/12/2011 .---- information on Granting of Patents in CHINA and Japan.

A petition under rule dated 16/04/2007 filed on 16 April 2007 for condoning the irregularity in filing the Form 3 beyond the prescribed time,
In the above mentioned Forms and the opponents grounds of opposition and the applicant' s Written reply statement filed, the arguments put forth by the opponent that the details of corresponding US,BR,AU application were never filed on Form 3 by the Patentee
And also that the details of the corresponding CN and JP applications were conveyed on Form 3 with the delay of more than 06 years and no justification given by the Patentee for such delay

And the arguments by the Patentee that

The intended Australian application never entered the national phase in Australia as proved by the attached Inpadoc status printout marked Exhibit E,The Australian Patent Office provides a publication number with the PCT is in the International phase but no actual processing by the Australian Patent Office took place , there was, therefore nothing to convey the controller in respect of the Australian application.

The recommendation of the Examination Board regarding the opposition Ground at (C) that is the patentee has failed in its duty to furnish information as mandated under section 8 of the Patent Act 1970 is also considered. Also the report of the Examination Board is also seen. The arguments of the applicant regarding Australian Patent office is not agreed to as the applicant should have informed to the Indian Patent Office that it has applied in the Australian Patent office and the fate of the application there, e.g. not published, abandoned etc. The applicant has also not filed any petition under rule 137 or 138 for condoning the irregularity in filing the Form 3 beyond the prescribed time. The Australian application number AU2003301995(A1) –2004-06-03 is accessible in esp@cenet database of the EPO.The applicant has not filed any petition under Patent rules and the Patents act 1970 as amended thereof for condonation of irregularity. The Applicant has entered in the national phase of the Australian Patent office and should have informed the Patent Office by filing Form 3 and has failed to keep the controller informed , the Form 3 filed on 30/11/2011.

The applicant's agent and the opponent filed the Decision of the High Court regarding infringement suit after the attending then hearing on 07/11/2017 In the hearing he has not argued for any of the opponent point but submitted the decision of the Delhi high court. The High court has acknowledged their settlement to withdraw the post grant opposition filed, but there is no provision in the Patents Act to withdraw the post grant opposition filed under section 25(2), the court order is regarding their settlement towards infringement suit but not towards the post Grant opposition per se filed under section 25(2) of the Patents act 1970 as amended thereof except the settlement of the parties regarding withdrawal of opposition under section 25(2) , for the withdrawal of opposition under section 25(2) there is no provision in the Patents act 1970 as amended thereof.

Therefore after considering all the facts and the records available in this matter and proceedings under the Patent Act 1970 as amended thereof, for deciding the post Grant opposition under section 25(2) it is concluded that

1. The alleged invention is novel and involves inventive step under section 2(1)(j) and 2(1)(j)(a)
 2. The applicant has failed to inform the controller about the Australian application, has not informed at all on Form 3, the Form 3 filed on 30/12/2011 has been filed beyond the prescribed period regarding the information given therein and thus section 8(1) of the Patents Act and the rules made therein and has not been complied with.
 3. The order of the Delhi High court is regarding settlement between the parties regarding the infringement of the patent right, the controller was kept in dark regarding this suit filed in the high court of Delhi during the processing of the opposition and the hearing given thereof.
 4. In view of above, the Patent number 251037 so granted is therefore revoked.
 5. Cost under section 77 of the Patents Act 1970 is imposed on both the parties for not keeping the controller informed regarding the suit filed for the infringement, by the applicant against the opponent in the Delhi High Court though both the parties were well aware of the same during the proceedings of the Post Grant Hearing under section 25(2) and kept the Controller in the dark. A cost of Rupees Ten Thousands (R10000) to the Patentee and cost of Rupees Ten Thousands (R10000) to the opponent of this granted Patent number 251037 is imposed, which should be deposited at the Patent Office Delhi within ten days of the issue of this order.

Dated :9th April 2018 .
Patent office ,Delhi

(NAVEEN MATHUR)
Deputy Controller of Patents and Designs