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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 05.06.2025

CORAM

THE HONOURABLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

C.M.A.(PT).No.42 of 2024

TVS Motor Company Limited,
"Jayalakshmi Estates",
No.29 (Old No.8), Haddows Road,
Chennai – 600 006, India ... Appellant

..Vs..

The Assistant Controller of Patents and Designs
The Patent Office
Intellectual Property Building
G.S.T. Road, Guindy,
Chennai – 600 032. ... Respondent

PRAYER: Civil Miscellaneous Appeal filed under Section 117A of the Patents Act, 1970 read with the Tribunals Reforms and Rationalisation and Conditions of Service Ordinance, 2021, to set aside the order dated 12.04.2021 passed by the respondent in Indian Patent Application No.798/CHE/2011 and further allow Indian Patent Application No.798/CHE/2011.

For Appellant : Mr.S.Harish
For Mr.Thriyambak Kannan

For Respondent : Mr.M.Karthikeyan, CGSC

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JUDGMENT

This appeal is directed against the order dated 12.04.2021 rejecting Patent Application No.798/CHE/2011 for the grant of patent for an invention titled "An Internal Combustion Engine".

2. Upon receipt of such application, at the request of the appellant, the respondent issued First Examination Report dated 29.01.2018 (" The FER"). In the FER, objections were raised *inter alia* on grounds of lack of novelty and inventive step by citing prior art documents D1 and D2. The appellant replied to the FER on 27.07.2018, by *inter alia* distinguishing the claimed invention from prior art documents D1 and D2.

3. Pursuant to hearing notice dated 15.03.2021, the appellant was heard on 19.03.2021. After the hearing, the appellant filed written submissions dated 01.04.2021. The order impugned herein was issued in the above facts and circumstances.

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4. Learned counsel for the appellant invited my attention to the rejected claims of the appellant and pointed out that the claims consisted of one independent claim and two dependant claims. After pointing out that the independent claim was a two-part claim, learned counsel submitted that the monopoly claim pertains to a bearing structure for supporting a crankshaft comprising an engaging groove for receiving a tapered circlip, which presses against a washer deployed between the bearing and the circlip and which exerts continuous pressure on the bearing thereby controlling the bearing float.

5. After pointing out that the claimed invention sets out to resolve the problem in the prior art of a rattling sound caused due to backlash as a result of the play between the bearing race and the crankcase, learned counsel submitted that the claimed invention provides a solution to such problem.

6. According to learned counsel, prior art document D1 is not analogous inasmuch as the said invention is directed at securing the bearing cap relative to the shaft and the bearing body, and is not intended to prevent the rattling sound

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caused by backlash. He also points out that D1 deals with a diesel engine. As regards D2, learned counsel submits that it is directed at reduction of axial movement by using a clamp and not a circlip. By referring to figure 8 at page No.118 of the paper book, learned counsel submits that the clamp is a completely different element from a circlip. Thus, learned counsel contends that neither of the cited prior arts contain teaching, suggestion or motivation that would lead a person skilled in the art to the claimed invention.

7. In response to these contentions, learned counsel for the respondent referred to the impugned order and pointed out that the appellant failed to disclose whether the claimed invention is targeted at reducing axial movement or rotational movement. As regards the cited prior arts, learned counsel submits that prior art document D1 may not use the terminology used in the claimed invention, but resolves the same problem. As regards prior art document D2, learned counsel submits that the said invention resolves the same problem of reducing the backlash and rattling sound during operation of an internal combustion engine.

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8. At the outset, it is relevant to set out the problem sought to be resolved by the claimed invention. In the compete specification, in relevant part, it is recited as under:

> *"However, in this type of conventional structure, some play remains between the left outer bearing race and the left crankcase half after assembly. As a result, during operation of the engine, a little "backlash" is unavoidably generated between the outer race of the left bearing and a bearing surface of the crankcase. Therefore, a rattling sound due to the "backlash" is generated upon the operation of the internal combustion engine, and the desired bearing function cannot be optimised. Hence the main objective of the present invention is provide a stabilized bearing structure for supporting a crankshaft in an internal combustion engine, and a backlash-absorbing mechanism for absorbing a backlash of a bearing race."*

9. The manner in which the problem is attempted to be resolved may be gleaned from independent claim 1, which is as under:

> *"We claim:*
>
> *1.An internal combustion engine (200) comprising a crankcase (208) with right (212) and left side (211) crankcase halves, a crankshaft (206) rotatably supported on the crankcase*

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(208) through a plurality of ball bearings (216,217) wherein said internal combustion engine (200) comprises a bearing structure for supporting said crankshaft (206), said bearing structure being provided on an outer race of one of said ball bearings (217); characterized in that,

said bearing structure comprises an engaging groove (301) for receiving a tapered circlip (302), which presses against a washer (304) disposed between said bearing (217) and said circlip (302), and exerting continuous pressure on said bearing (217) for controlling bearing float."

10. It is noticeable from the second part thereof (after the words "characterized in that") which contains the monopoly claim, that the backlash is sought to be mitigated or eliminated by deploying a tapered circlip, which presses against the washer, which, in turn, is placed between the bearing and the circlip and exerts continuous pressure on the bearing for controlling bearing float. Whether the claimed invention would be evident from the cited prior arts falls for consideration next.

11. The problem sought to be resolved by prior art D1 is evident from the following extract from the complete specification:

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"As a result of the present invention the bearing cap is effectively secured in position relative to the bearing body and simultaneously a securing and pre-stressing pressure is applied to the bearing shells."

As is evident from the above, there is no reference to backlash and the rattling sound caused thereby in prior art D1. Merely because a circlip is used in prior art D1, it cannot be said that the claimed invention would be obvious from D1.

12. Prior art D2 is an invention titled "Stabilised Bearing Structure for supporting a Crankshaft in an Internal Combustion Engine, and Engine including the same". Paragraphs [0009] and [0011] of the complete specification discloses that prior art D2 is also directed at reducing or eliminating the rattling sound due to the backlash generated upon the operation of an internal combustion engine. Independent claim 1 of D2 reveals that it is directed at reducing axial movement by deploying an axial movement restraining structure. This structure involves the use of clamps and not a circlip, unlike the claimed invention.

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13. By adverting to the impugned order, learned counsel for the respondent pointed out that the appellant did not clearly disclose whether the claimed invention is directed at reducing axial or rotational movement and pressure. This contention merits consideration.

14. In the impugned order, the respondent extracted from prior art documents D1 and D2 and concluded that D1 discloses a circlip and that D2 discloses a restraining clamp. On that basis, in the absence of clarity with regard to whether the claimed invention is directed at reducing axial or rotational movement, the patent application was rejected.

15. This approach cannot be countenanced. While undertaking obviousness analysis, it is necessary to examine whether the cited prior arts contain either direct or indirect pointers which would lead a person skilled in the art to the claimed invention. In the absence of such exercise, interference with the impugned order is warranted.

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16. Therefore, the impugned order dated 12.04.2021 is set aside and the matter is remanded for reconsideration on the following terms:

i). In order to preclude the possibility of pre-determination, an officer other than the officer who issued the impugned order shall undertake reconsideration.

ii). After providing a reasonable opportunity to the appellant, a reasoned order shall be issued within four months from the date of receipt of a copy of this order.

iii). It is made clear that no observation has been made on the merits of the patent application.

05.06.2025

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Index : Yes
Internet : Yes
Neutral Citation Case: Yes/No

To:

The Assistant Controller of Patents and Designs
The Patent Office
Intellectual Property Building
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