



* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

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Judgment Reserved on: 29.11.2024
Judgment pronounced on: 15.01.2025

I.A. 7635/2024 and I.A. 46685/2024
IN
+ C.O.(COMM.IPD-PAT) 38/2022

MACLEODS PHARMACEUTICALS LTDPetitioner
Through: Mr. G. Nataraj and Mr. Rahul Bhujbal
and Mr. Yash Raj, Advocates

versus

THE CONTROLLER OF PATENTS & ANR.Respondents
Through: Mr. Sandeep Sethi, Sr. Adv. with
Dr. Sanjay Kumar, Ms. Arpita
Sawhney, Ms. Meenal Khurana,
Ms. Pallavi Kiran, Mr. Arun Kumar
Jana, Mr. Priyansh Sharma,
Ms. Pratiksha Varshney, Mr. Sumer
Seth and Ms. Riya Kumar, Advocates
for R-2.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

JUDGMENT

AMIT BANSAL, J.

I.A. 7635/2024 (under Section 151 of CPC)

I.A. 46685/2024 (under Section 151 of CPC)

1. The captioned applications have been filed by the respondent no.2 seeking dismissal of the present petition.



2. The following issues arise for adjudication in the two applications:
- (i) Whether a revocation petition can be held to be not maintainable if the petitioner has filed a written statement, taking a defence of invalidity of the suit patent under Section 107 of the Patents Act, in an infringement suit filed by the patentee.
 - (ii) Whether a revocation petition can be filed or sustained (if already filed) after the expiry of the term of the patent.

PREFATORY FACTS

3. The petitioner, Macleods Pharmaceuticals Ltd., is engaged in manufacturing and marketing of diverse pharmaceutical products including anti-diabetic drugs.
4. The respondent no. 2, Boehringer Ingelheim Pharma GmbH & Co. KG, is a company organized and existing under the laws of Germany. It is engaged in the business of developing, manufacturing and marketing pharmaceuticals worldwide including India.
5. The present revocation petition was filed by the petitioner under Section 64(1) of the Patents Act, 1970 (hereinafter the 'Patents Act') seeking revocation of Indian Patent IN 243301 registered in the name of the respondent no. 2 in respect of a medicinal product called '*LINAGLIPTIN*', an anti-diabetic product (hereinafter 'the subject patent'). The subject patent was granted in favour of the respondent no. 2 on 5th October, 2022 with the priority date of 21st August, 2002.
6. The present petition was filed on 17th February, 2022 just before the intended date for the commercial launch of the petitioner's generic '*LINAGLIPTIN*' product, i.e. 22nd February, 2022.



7. Subsequently, on 19th February, 2022, the respondent no.2 filed an infringement suit against the petitioner herein before the High Court of Himachal Pradesh (COMS 3/2022), alleging infringement of the subject patent (hereinafter the ‘Himachal Suit’).

8. The term of the subject patent expired on 18th August, 2023.

9. On 4th May, 2022, the respondent no. 2 filed an application being I.A. 5611/2022 under Order VII Rule 11 of the Code of Civil Procedure, 1908 (‘CPC’) seeking dismissal of the present revocation petition on the ground that it was filed twelve years after the grant of the subject patent. This Court *vide* oral judgement dated 27th July, 2022 dismissed the said application on the ground that there is no prescribed time limit to file a revocation petition.

10. The respondent no. 2 had also filed an application being I.A. 13077/2023 seeking transfer of the present revocation petition to the High Court of Himachal Pradesh, to be consolidated with the Himachal Suit. However, the said application was also dismissed by the Predecessor Bench *vide* order dated 20th July, 2023.

11. On 2nd April, 2024, I.A. 7635/2024 has been filed on behalf of the respondent no. 2 stating that since the subject patent has expired on 18th August, 2023, nothing survives in the present revocation petition and, therefore, the same should be dismissed.

12. Thereafter, on 8th May, 2024, the petitioner filed a transfer petition bearing no. T.P.(C) 1412/2024 before the Supreme Court seeking transfer of the Himachal Suit to this Court, which is pending before the Supreme Court.

13. Subsequently, on 25th November, 2024, I.A. 46685/2024 has been filed on behalf of the respondent no. 2 seeking dismissal of the present revocation



petition on the ground that the petitioner has filed a written statement seeking invalidity of the subject patent in the Himachal Suit.

SUBMISSIONS ON BEHALF OF THE RESPONDENT NO. 2

14. Mr. Sandeep Sethi, Senior Counsel appearing on behalf of the respondent no.2 has made the following submissions:

14.1. The defence of invalidity under Section 107 of the Patents Act has already been taken by the petitioner in its written statement filed in the Himachal Suit. The prayers sought by the petitioner in the present petition as well as those made in the written statement filed before the High Court of Himachal Pradesh are similar and, therefore, if the petitioner is allowed to proceed with the present petition, it could result in conflicting judgments from two High Courts.

14.2. In effect, there is no difference between a finding of invalidity returned in an infringement suit/ counter-claim or in a revocation petition. A finding of invalidity of the subject patent shall be binding on the patentee and the subject patent can no longer be enforced by the patentee irrespective of the fact whether the revocation petition has been filed or not. Further, a finding of validity/ invalidity of a suit patent, whether in a revocation petition or counter-claim or an infringement suit is a finding *in rem* that applies universally to all persons and has the effect of conclusively deciding the rights and obligations related to particular subject matter.

14.3. The infringement suit would constitute a more comprehensive proceeding with respect to the existing disputes between the parties as evidence would be led on behalf of the parties. Therefore, the adjudication of the present petition would be an exercise in futility.



14.4. As on date there is no live patent subsisting in the Register of Patents and therefore, the petitioner no longer qualifies as '*person interested*' in terms of Section 2(1)(t) of the Patents Act. In this regard, the counsel for the respondent no.2 has placed reliance on *Dr. Reddys Laboratories Limited and Anr. v. Controller of Patents and Ors.*, 2022 SCC OnLine Del 1040.

SUBMISSIONS ON BEHALF OF PETITIONER

15. Mr. G. Natraj, Counsel appearing on behalf of the petitioner has made the following submissions:

15.1. A decision of revocation, whether in a petition under Section 64 or in a counter-claim can only be made by a High Court, whereas a decision on invalidity based on a defence under Section 107 of the Patents Act can be taken by a District Court.

15.2. The defence under Section 107 of the Patents Act in an infringement suit has a different legal and practical consequence from a revocation petition/ counter-claim under Section 64 of the Patents Act. Section 107 of the Patents Act does not entitle a defendant to seek revocation. At best, it only enables the defendant to seek a declaration that one or more claims are invalid and the patent is liable to be revoked. The reliefs sought in the present petition are substantially different from the reliefs sought in the written statement filed in the Himachal Suit. In this regard, reliance is placed on Section 151 of the Patents Act.

15.3. In a patent infringement suit where certain claims have been held invalid, the valid claims can still be asserted against third parties under Section 114 of the Patents Act.



15.4. A revocation petition is *qua* the entire patent and if the same is allowed, the patent is removed from the Register of Patents as if it never existed. On the other hand, the defence of invalidity under Section 107 of the Patents Act can be raised *qua* individual claims asserted in the suit.

15.5. Under the scheme of the Patents Act, Section 64 provides a stand-alone right which can be exercised whether a suit has been filed or not. There is no time limit prescribed for availing rights under Section 64 of the Patents Act. Therefore, the same can be exercised at any point of time independent of whether the patent subsists or has expired.

15.6. A patentee can file a suit for infringement claiming damages even after the expiry of the suit patent. If the claim of the patentee for damages survives even after the expiry of the patent, the cause of action to file revocation petition after the expiry of the patent shall also survive.

ANALYSIS

16. I have heard the counsel for the parties and given my careful consideration to the matter. My issue wise findings are as under:

I. Whether a revocation petition can be held to be not maintainable if the petitioner has filed a written statement, taking a defence of invalidity of the suit patent under Section 107 of the Patents Act, in an infringement suit filed by the patentee.

17. After a detailed analysis of the provision of the Patents Act, I am of the considered view that the scope of a petition under Section 64 of the Patents Act is entirely different from the defence of invalidity under Section 107 of the Patents Act for the reasons set out hereinafter.



18. Under Section 64 of the Patents Act, a petition for revocation of the patent can be filed on a stand-alone basis or by way of a counter-claim in an infringement suit. The power to entertain such a revocation petition has been given only to a High Court. On the other hand, in terms of Section 104¹ of the Patents Act, a patent infringement suit can be adjudicated by a District Court as well. Consequently, defence under Section 107 of the Patents Act can also be adjudicated by the District Court. However, where a counter-claim has been filed in a patent infringement suit seeking revocation of the patent by the defendant, in terms of proviso to Section 104 of the Patents Act, the suit along with the counter-claim has to be transferred to the High Court.

19. Section 151 of the Patents Act is illustrative of the difference of the effect between the proceedings under Section 64 of the Patents Act and defence under Section 107 of the Patents Act. For ease of convenience, Section 151 of the Patents Act is set out below:

*“Section 151. Transmission of orders of courts to Controller. -
(1) Every order of the High Court on a petition for revocation, including orders granting certificates of validity of any claim, shall be transmitted by the High Court to the Controller who shall cause an entry thereof and reference thereto to be made in the register.*

(2) Where in any suit for infringement of a patent or in any suit under section 106 the validity of any claim or a specification is contested and that claim is found by the court to be valid or not valid, as the case may be, the court shall transmit a copy of its judgment and decree to the Controller who shall on receipt thereof cause an entry in relation to such proceeding to be made in the prescribed manner in a supplemental record.”

(emphasis supplied)

¹ Section 104. **Jurisdiction.** – No suit for a declaration under Section 105 or for any relief under Section 106 or for infringement of a patent shall be instituted in any court inferior to a district court having jurisdiction to try the suit:

Provided that where a counter-claim for revocation of the patent is made by the defendant, the suit along with the counter-claim, shall be transferred to the High Court for decision.



A reading of Sub-section (1) of Section 151 of the Patents Act would show that all orders of the High Court on a petition for revocation shall be transmitted to the Controller who shall make suitable entry in the register on the basis of the said order. Once a revocation petition under Section 64 of the Patents Act is allowed, the patent is effaced from the Register of Patents as if it never existed.

20. Under Sub-section (2) of Section 151 of the Patents Act, in a suit for infringement of a patent or under Section 106 of the Act, the judgment/decree of the court regarding validity/invalidity of the claims of a patent shall be transmitted to the Controller who shall make a suitable entry in the prescribed manner in the supplemental records. Based on a finding of invalidity of claims by a competent court on the basis of a defence under Section 107 of the Patents Act, the defendant has a right to take additional steps under Section 71(1)² of the Patents Act for rectification of the register. Hence, a finding of invalidity by itself would not result in removal of the patent from the register.

21. Therefore, the effect of the two proceedings is completely different.

22. This distinction is highlighted by the prayers made by the petitioner in the present petition and in the written statement filed before the High Court of Himachal Pradesh. The relevant prayer in revocation petition before this Court is set out below:

² Section 71. **Rectification of register by High Court.** – (1) The High Court may, on the application of any person aggrieved—

- (a) by the absence or omission from the register of any entry; or
- (b) by any entry made in the register without sufficient cause; or
- (c) by any entry wrongly remaining on the register; or
- (d) by any error or defect in any entry in the register,

make such order for the making of variation or deletion, of any entry therein, as it may think fit.



“144. In view of the facts and circumstances narrated herein above, it is, respectfully prayed that this Hon'ble Court may be pleased to:

a. Revoke Indian Patent No. 243301 and direct Defendant No. 1 **to remove IN 243301 from the Register of Patents;**”

(emphasis supplied)

The relevant prayer in written statement before the High Court of Himachal Pradesh is set out below:

“214. In view of the facts and circumstances narrated herein above, it is, most respectfully prayed that this Hon'ble Court may be pleased to:

....

....

....

b) Hold that Indian Patent 243301 **is invalid and is liable to be revoked and removed from the Register of Patents** under the grounds of Section 64(1) relied on in the present Written Statement;”

(emphasis supplied)

23. In the present revocation petition, the petitioner is seeking revocation/removal of the subject patent from the Register of Patents. However, in the Himachal Suit, the petitioner is praying for declaration of invalidity which would render the subject patent **“liable to be revoked and removed from Register of Patents”** which implies that the defendant/ petitioner herein would need to take additional steps for getting the patent revoked/removed from the Register of Patents.



24. Yet another distinction is evident from a reading of the Sections 58 and 59 of the Patents Act. Under Section 58(1)³ of the Patents Act, in revocation proceedings before the High Court, if the High Court is of the view that the patent is invalid, it can allow the patentee to amend the complete specification instead of revoking the patent. In contrast, based on a defence taken under Section 107 of the Patents Act, the court cannot direct the patentee to amend the claims in a patent.

25. It is a settled position of law that findings in an *inter se* suit between the contesting parties operates as a finding *in persona* and will only bind the contesting parties. This rationale would also apply in the context of a patent infringement suit where a finding of invalidity has been given on the basis of a defence taken under Section 107 of the Patents Act. Under Section 114 of the Patents Act, even when certain claims have been held to be invalid in a patent infringement suit, the Court may grant relief in respect of any valid claims which are infringed. The finding of invalidity given by the Court would not have a direct bearing in a suit filed by the patentee against third parties. On the other hand, once the High Court revokes a patent under Section 64 of the Act, the same would operate *in rem* and the patentee would not be able to assert the said patent or claims against any third party.

26. It has been vehemently contended on behalf of the respondent no. 2 that once an infringement suit has been filed by the respondent no. 2 before High

³ Section 58. **Amendment of specification before High Court.** –

(1) In any proceeding before the High Court for the revocation of a patent, the High Court, may, subject to the provisions contained in Section 59, allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the High Court may think fit, and if, in any proceedings for revocation, the High Court decides that the patent is invalid, it may allow the specification to be amended under this section instead of revoking the patent.



Court of Himachal Pradesh, the petitioner ought to have filed a counter-claim in the said suit seeking revocation rather than pursuing the present petition. From a reading of the Patents Act, the position which emerges is that it is the choice of a party whether to file a revocation petition on a stand-alone basis under Section 64 of the Patents Act or file a counter claim in a pending suit. There is no limitation in the Patents Act to curtail the aforesaid choice of the party. There is nothing in the Patents Act to suggest that once a suit for infringement is filed, the defendant can only use the defence under Section 107 of the Patents Act or file a counter-claim in the suit. Hence, the petitioner has an independent stand-alone right under Section 64 of the Patents Act to file a revocation petition and any other interpretation would result in causing violence to the statute.

27. This is not a case where the petitioner deliberately chose to file the revocation petition in Delhi after the Himachal Suit had been instituted. The present revocation petition was filed before the Himachal Suit. Further, it is to be noted that the petitioner, though has taken the defences under Section 107 of the Act in its written statement, it has not filed a counter-claim in the suit seeking revocation of the suit patent.

28. As regards the possibility of conflicting judgments by two competent High Courts, the Supreme Court is already seized of the same in the transfer petition filed by the petitioner seeking transfer of the Himachal Suit to this Court.

29. In light of the discussion above, I am of the view that the scope and effect of a revocation petition filed under Section 64 of the Patents Act and the defence of invalidity taken under Section 107 of the Patents Act in an



infringement suit is entirely different. Hence, the present revocation petition is maintainable.

30. Now, I move to adjudicate the second issue, which is set out below:

II. Whether a revocation petition can be filed or sustained (if already filed) after the expiry of the term of the patent.

31. Section 64 of the Patents Act provides that a patent granted may be revoked on a petition filed by (i) a person interested or (ii) the Central Government.

32. The phrase '*person interested*' has been defined under Section 2(1) (t)⁴ of the Patents Act and the same has been interpreted by a Co-ordinate Bench of this Court in *Dr. Reddys Laboratories Limited* (Supra). The relevant paragraph of the said judgment is reproduced below:

“11. Therefore, the trigger for a person to file a revocation petition could arise in various circumstances including:

a. If the person interested wishes to manufacture or sell the patented product or a product using the patented process.

b. If a suit for infringement is filed against the person interested.

c. If a person is 'interested' in the invention covered by the patent in any other manner whatsoever.”

33. The petitioner in the present case is a person who is interested in manufacture and sale of the patented products and he is also a defendant in the patent infringement suit filed by the respondent no.2. Therefore, the petitioner qualifies as a '*person interested*' in terms of Section 2(1)(t) of the Patents Act and it would be entitled to file and maintain the present revocation petition.

⁴ 2. **Definitions and interpretation.** - (1) In this Act, unless the context otherwise requires, —

(t) “person interested” includes a person engaged in, or in promoting, research in the same field as that to which the invention relates;



34. Respondent no.2 also places reliance on the aforesaid judgment in ***Dr. Reddys Laboratories Limited*** (Supra) to submit that revocation petition can be filed only during the life/term of the patent. The issue before the Court in the said judgment was whether the revocation petition was barred by limitation. It was held that under Section 64 of the Patents Act, there is no limitation which is prescribed and therefore, no limitation can be read into it. The observations with regard to the revocation petition being filed during the term of the patent was in the nature of *obiter* and therefore, no reliance can be placed on the same. Moreover, there is nothing to suggest that in the facts obtaining in the said case, an infringement suit was filed by the patentee against the petitioner therein.

35. The respondent no. 2 has filed a patent infringement suit in which it has claimed damages for the alleged infringement of its patent by the petitioner during the life of the patent. Just because the term of the patent has expired, it would not mean that the suit has become infructuous, as the cause of action, insofar as damages are concerned, still survives. Applying the same rationale, it cannot be argued that a revocation petition cannot be filed or will not survive (if filed earlier) after the term of the patent has expired.

36. The Himachal Suit filed by the respondent no.2 is still continuing despite the term of the patent having expired. If the petitioner succeeds in the present petition and the subject patent is revoked, the suit of the respondent no. 2 would be liable to be dismissed. Therefore, there is a valid cause of action in favour of the petitioner to pursue the present petition and simply because the life of the patent has expired, would not mean that the present petition becomes infructuous.



37. Therefore, I am of the opinion that the present petition can be sustained even after the expiry of the subject patent.

38. In light of the discussion above, I do not find merit in the objections taken by the respondent no. 2 with regard to the maintainability and sustainability of the present rectification petition. Consequently, both I.A. 7635/2024 and I.A. 46685/2024 are dismissed.

C.O.(COMM.IPD-PAT) 38/2022

39. List before the Joint Registrar on 24th February, 2025 for further proceedings.

**AMIT BANSAL
(JUDGE)**

JANUARY 15, 2025

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