



2025:DHC:1980



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

% *Date of decision: 20th March, 2025*

I.A. 7198/2025 and REVIEW PET. 151/2025

In

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

MACLEODS PHARMACEUTICALS LTDPetitioner

Through: Mr. G. Nataraj, Mr. Rahul Bhujbal,
Mr. Yash Raj & Mr. Jegadheesh R.,
Advocates.

versus

THE CONTROLLER OF PATENTS & ANR.Respondents

Through: Mr. Gaurav Barathi, SPC for R-1.
Mr. Sandeep Sethi, Senior Advocate
with Dr. Sanjay Kumar, Ms. Arpita
Sawhney, Ms. Meenal Khurana, Ms.
Pallavi Kiran, Mr. Arun Kumar Jana,
Mr. Priyansh Sharma, Ms. Pratiksha
Varshney, Advocates for R-2.

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

REVIEW PET. 151/2025

1. This review petition has been filed on behalf of the respondent no. 2/ review petitioner, seeking review of the judgment dated 15th January, 2025 passed by this Court.
2. The first ground for seeking review is that the arguments were addressed by the respondent no. 2 only in respect of I.A. No. 7635/2024 and not I.A. No. 46685/2024.



3. The aforesaid contention is disputed by Mr. Nataraj, counsel appearing on behalf of the petitioner.

4. For the reasons set out hereinafter, I am not in agreement with the submissions made on behalf of the review petitioner/ respondent no. 2.

5. The main contention of the review petitioner in I.A. No. 46685/2024 was that since the petitioner has raised a ground of invalidity in the Himachal suit, the same will be adjudicated in the said suit and hence, the petitioner cannot file a revocation petition on the same grounds. This has been captured in the paragraph 13 of the judgment-under-review, which has been set out below:

“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.”

6. A perusal of the written submissions filed on behalf of the respondent no. 2, which were filed after the judgment was reserved in the matter, would show that submissions made on behalf of the respondent no. 2 dealt with the subject matter of I.A. No. 46685/2024. In this regard, reference may be made to paragraphs 10 and 11 of the written submissions of the respondent no. 2, which are set out below:

“B. THE PETITIONER HAS ALREADY AVAILED OF EQUALLY EFFICACIOUS ALTERNATE REMEDIES

10. It is submitted that it is the understanding and considered stand of the Petitioner that the defence of invalidity under section 64 raised by it in its Written Statement in COMS 3 of 2022 [which prayers have been set out at Page 13 in Paragraph No.23 of the Rejoinder filed by Respondent No.2 in IA No.7635/2024] are available as grounds of defence under Section 107 of the Patents Act. Therefore, even with



respect to the prayers sought by the Petitioner, there is no palpable difference in the defence raised in its Written Statement in the infringement suit and the averments made in the present Revocation Petition.

*11. It is therefore submitted that the said stand of the Petitioner constitutes an unqualified admission that the Hon'ble High Court of Himachal Pradesh is fully and equally equipped to render an appropriate finding on merits with regards to the validity of the suit patent, and the Petitioner has not urged any reason whatsoever as to why findings on the question of validity are required from both Courts, especially when the same may result in conflicting decisions. Details of similar applications filed in respective Revocation Petitions are annexed herewith as **Annexure B.**"*

7. The aforesaid submission of the respondent no. 2 was rebutted by the petitioner in its note of arguments. The petitioner's note of arguments which was filed post the judgment being reserved, clearly stated that they were in respect of both the applications, I.A. No. 7635/2024 and I.A. No. 46685/2024. A perusal of the petitioner's note of arguments would show that arguments made on behalf of the petitioner also dealt with the issues that were subject matter of I.A. No. 46685/2024. In this regard, paragraphs 11, 12, 13, 14 and 15 of the written submissions filed on behalf of the petitioner, which deal with the subject matter of I.A. No. 46685/2024 are set out below:

“III. Revocation u/Sec. 64 vis a vis Defense of Invalidity u/Section 107

11. A Revocation Petition is qua the entire patent and acts ab initio, i.e., as if the Patent never ought to have existed. It is effaced by the Register of Patents and the right to sue for infringement u/Sec. 48 [independent of patent expiry] is effaced/removed/obliterated. This is the position under Indian law as well and under practically all jurisdictions.

12. A defense of invalidity u/Sec. 107 is only qua a claim/s asserted in



the Suit.

13. A decision of revocation [in a stand-alone petition or in a counter claim] can only be by a High Court [Sec. 64, Sec. 104 proviso]. A decision of invalidity based on a defense of Sec. 107 can be taken even by a District Court [Sec. 104 r/w Sec. 107].

14. A finding of invalidity is always qua claim/s of a patent. It does not mean removal of the patent from the Register, and does not have an ab initio effect or an in rem effect. The Patentee can remedy the situation through several means:

- Through amendment as provided for in Section 58-59 of TPA; and/or

- Seeking a certificate of validity as provided in Section 113 TPA.

15. A patent where claim/s has/have been held invalid can still be asserted against third parties [Sec. 114 of TPA, including as appropriate an injunction - proviso to Sec. 114(1).”

8. Mr. Sandeep Sethi, Senior Counsel appearing on behalf of the review petitioner/ respondent no.2, submits that in I.A. No. 46685/2024, reliance has been placed on the judgment of the Supreme Court in ***Aloys Wobben and Anr. Vs. Yogesh Mehra & Ors.***, (2014) 15 SCC 360. It is stated that the said judgment is squarely applicable in the facts and circumstances of the case and was not considered by the Court.

9. Even though, no submissions with regard to the aforesaid judgment were made at the time of hearing, in the interest of justice, I have heard submissions of the counsel in respect of the aforesaid judgment.

10. Mr. Sethi relies upon paragraphs 26 and 27 of the said judgment (which have also been set out in I.A. No. 46685/2024). The same are set out below:

“26. In cases where the “infringement suit(s)” was/were filed by the appellant herein (as plaintiff in the “infringement suit”), before the “revocation petition(s)” was/were filed by the respondents (as defendants in the “infringement suit”), the respondents had the right to file “counterclaim(s)” to seek revocation of the patent under the



strength and authority emerging from Section 64(1) of the Patents Act. Having once filed a “counterclaim” in response to the “infringement suit(s)” on the same analogy as has been recorded above, it would not be open to the respondents herein (the defendants in the “infringement suits”) to file “revocation petition(s)”, as they would likewise be barred by the rule of res judicata. As such, “revocation petitions” filed later in point of time than the institution of the “infringement suit”, would be unsustainable in law. In such cases, the prayer for revocation of the patent shall be adjudicated while disposing of the “counterclaim” filed by the respondents. Therefore, in the above situation, while the “counterclaim” will have to be permitted to be pursued, the “revocation petition” cannot be permitted to be continued.

27. Having examined the four contentions advanced at the hands of the learned counsel for the appellants (delineated in para 10 of the instant judgment) and the fifth contention (noticed in para 22 of our instant determination), we are of the view that the following conclusions emerge therefrom:

27.1. Firstly, if “any person interested” has filed proceedings under Section 25(2) of the Patents Act, the same would eclipse all similar rights available to the very same person under Section 64(1) of the Patents Act. This would include the right to file a “revocation petition” in the capacity of “any person interested” [under Section 64(1) of the Patents Act], as also, the right to seek the revocation of a patent in the capacity of a defendant through a “counterclaim” [also under Section 64(1) of the Patents Act].

27.2. Secondly, if a “revocation petition” is filed by “any person interested” in exercise of the liberty vested in him under Section 64(1) of the Patents Act, prior to the institution of an “infringement suit” against him, he would be disentitled in law from seeking the revocation of the patent (on the basis whereof an “infringement suit” has been filed against him) through a “counterclaim”. This denial of the remedy granted to him by way of a “counterclaim” under Section 64(1) of the Patents Act, is based on the principle of law narrated in para 25 above.

27.3. **Thirdly, where in response to an “infringement suit”, the defendant has already sought the revocation of a patent (on the basis**



whereof the “infringement suit” has been filed) through a “counterclaim”, the defendant cannot thereafter, in his capacity as “any person interested” assail the patent concerned, by way of a “revocation petition”. This denial of remedy granted to him by way of a “revocation petition” under Section 64(1) of the Patents Act is also based on the same principle of law expressed in para 25 above.”

[Emphasis supplied]

11. The conclusion of *Aloys Wobben* (Supra) is contained in paragraph 33 of the judgment, which is set out below:

“33. It is necessary to keep in mind that the instant submission was advanced at the hands of the learned counsel for the reason that the appellants did not desire two proceedings on the subject of revocation of the same patent to be continued simultaneously before different fora. In our discussion recorded while dealing with the submission advanced by the learned counsel for the appellants, we have accepted the contention advanced at the hands of the learned counsel for the appellants, that only one out of two remedies available under Section 64 of the Patents Act can be availed of, so as to assail the grant of a patent. Accordingly the said remedy may be availed of in the capacity of either “any person interested”, or in the capacity of a defendant in a “counterclaim”. We have already concluded hereinabove, that having availed of any one of the above remedies, it is not open to the same person to assail the grant of a patent by choosing the second alternative available to him. In view of our above conclusion, the instant submission advanced by the learned counsel for the appellants does not survive for consideration.”

[Emphasis supplied]

12. None of the aforesaid extracts relied from *Aloys Wobben* (Supra) support the case of the review petitioner/ respondent no. 2. A reading of the aforesaid extracts from *Aloys Wobben* (Supra) would show that in the said case, the appellant had filed revocation petitions before the *erstwhile* Intellectual Property Appellate Board (‘IPAB’) and counter-claims in the infringement suits, which the court held were impermissible. In the present



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matter, it is not the case of the respondent no. 2 that the petitioner had filed a counter-claim in the suit instituted in Himachal Pradesh. The petitioner had only filed a written statement in which the defence of invalidity was taken under Section 107 of the Patents Act, 1970. Therefore, *Aloys Wobben* (Supra) would have no application to the facts of the present case.

13. In light of the discussion above, I am not in agreement with the contention of the review petitioner/ respondent no. 2 that the arguments were addressed by the respondent no. 2 only in respect of I.A. No. 7635/2024 and not I.A. No. 46685/2024. Even while reserving the judgment, it was noted that the judgment was reserved in both the applications. To be noted, the judgment-under-review was reserved on 29th November, 2024 and was pronounced on 15th January, 2025. If the respondent no. 2 had any concern that arguments were not advanced in I.A. No. 46685/2024, then it should have approached the Court immediately thereafter.

14. Therefore, I do not find any merits in the aforesaid ground for seeking review of the judgement.

15. The second ground for seeking review is that the judgement-under-review erroneously notes that the present revocation petition was filed on 17th February, 2022, and the suit was filed subsequently on 19th February, 2022.

16. Mr. Sandeep Sethi, Senior Counsel appearing on behalf of the review petitioner/ respondent no. 2 submits that in fact, the present rectification petition was filed on 20th February, 2022.

17. In this regard, attention of the Court has been drawn to the case-filing status as reflected on the website of this Court, which shows the date of filing as 20th February, 2022.



18. Mr. Nataraj, counsel appearing on behalf of the petitioner contests the above position, however, he is not in a position to produce any document showing the earlier filing of the suit.

19. For the sake of convenience, the original paragraphs 6, 7 and 27 of the judgment-under-review are set out below:

“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’).

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.”

20. In light of the above, I am in agreement with the review petitioner/respondent no. 2 that there appears to be a factual error, which has crept in paragraphs 6, 7 and 27 of the judgment-under-review that would be required to be corrected.

21. Accordingly, paragraph 6 of the judgment-under-review is corrected to the extent that the date of filing of the present petition is changed from 17th February, 2022 to 20th February, 2022 and in paragraph 7 of the judgment-under-review, the word ‘Subsequently’ is removed.

22. In light of the aforesaid corrections, the observations of the Court in paragraph 27 of the judgment-under-review would also be required to be



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corrected. Accordingly, the first two sentences of paragraph 27 are ordered to be removed. The corrected paragraph 27 of the judgment-under-review is set out below:

“27. 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.”

23. The aforesaid corrections would not have any bearing on the outcome of the judgment-under-review as the judgment-under-review proceeds on the basis that remedies under Section 107 and Section 64 of the Patents Act, 1970 are independent proceedings and merely because defence of invalidity under Section 107 of the Act has been taken in the written statement, would not bar the party from filing independent revocation petition under Section 64 of the Act.

24. The review petition stands disposed of in light of the aforesaid terms.

I.A. 7198/2025 (under Order XI Rule 1(5) of the CPC)

25. Counsel for the petitioner does not press this application.

26. The application is dismissed as not pressed.

AMIT BANSAL, J

MARCH 20, 2025

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