



2025:DHC:5549-DB



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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ **FAO (COMM) 114/2024, CM APPL. 34224/2024 & CM APPL. 34226/2024**

MOLD TEK PACKAGING LIMITEDAppellant
Through: Mr. Jayant Mehta, Sr. Adv.
with Mr. Ashutosh Kumar, Mr. Vinod Chauhan, Ms. Radhika Pareva, Ms. Yagya Passi and Mr. Rajat Sinha, Advs.

versus

PRONTON PLAST PACK PVT. LTD.Respondent
Through: Mr. J. Sai Deepak, Sr. Adv.
with Mr. Vikas Khera, Mr. Lalit Ambastha, Ms. Sneha Sethia, Mr. Yash Sharma and Mr. Subham Rathore, Advs.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR
HON'BLE MR. JUSTICE AJAY DIGPAUL

JUDGMENT (ORAL)

% **11.07.2025**

C. HARI SHANKAR, J.

Facts, and the *lis*

1. The appellant before us was the plaintiff in CS (Comm) 668/2023, in which the impugned order dated 2 May 2024 has been passed by the learned District Judge (Commercial), Patiala House Courts¹, under Order XXXIX Rule 4 of the Code of Civil Procedure,

¹ "the learned Commercial Court", hereinafter



1908².

2. Inasmuch as we are inclined to set aside the impugned order and remand the Order XXXIX Rule 4 application of the respondent/defendant for *de novo* consideration, we would be restricting our discussion to the extent necessary for the said purpose.

3. The appellant was granted patents IN 401417³ and IN 298724⁴⁵. For the sake of convenience, both the patents together would be referred to hereinafter as “suit patents”.

4. IN’417 was in respect of an invention titled “TAMPER-EVIDENT LEAK PROOF PAIL CLOSURE SYSTEMS”, whereas IN’724 was in respect of an invention titled “A TAMPER PROOF LID HAVING SPOUT FOR CONTAINERS AND PROCESS FOR ITS MANUFACTURE”.

5. Broadly speaking, we may note that the suit patents were both pertaining to a lid which covers a container. The containers, which are covered by the lid in question, are, we are told, used for storage and transport of food items.

6. Photographs of the lid, forming subject matter of suit patent IN’417, as such, and after it is fixed on the container, may be provided thus:

² “CPC” hereinafter

³ “IN’417”, hereinafter

⁴ “IN’724” hereinafter

⁵ “the suit patents”



7. Mr. Jayant Mehta, learned Senior Counsel for the appellant, has shown us a physical sample of the lid forming subject matter of the suit patents and has also explained, to us what, according to him, are its inventive features.

8. Apropos the suit patent IN'417, Mr. Mehta submits that the lid had small projections all across its edge, called lugs, which enable the lid to be affixed and locked to the container. Once the lid is affixed and so locked, it cannot be removed. The part of the lid which is affixed to the container using the lugs becomes an integral part of the container and cannot be physically detached from it. The upper part of the lid is integrated with the lower part containing the lugs using what is called a tear band. This tear band has to be torn off, in order to detach the upper part of the lid. Mr. Mehta points out, if the tear band is detached and the upper part of the lid is thereafter replaced on to the lower part containing the lugs, the absence of the tear band would make it apparent to anyone who sees the lid that it has been tampered with. The tear band, thus, renders the lid “tamper proof” as well as



“tamper evident”.

9. IN’724, submits Mr. Mehta, essentially relates to the spout which is on the upper part of the lid. The spout can be opened, in case one needs to discharge the contents of the container only in part without opening the lid, that can be done through the spout. Mr. Mehta submits that the spout was also inventive, *vis-a-vis* spouts in earlier such lids, inasmuch as the spout cannot be removed and is integrated into the lid. Thus, the spout is also “tamper proof” and “tamper evident”. There are other features of the spout, to which Mr. Mehta has drawn our attention by showing us a physical sample thereof. However, for the purposes of this order, we do not deem it necessary to enter into those aspects.

10. This, in essence, forms the basis of the suit patents.

11. CS (Comm) 668/2023 was instituted by the appellant, alleging that the respondent/defendant was manufacturing and selling the following lid with a spout attachment, which infringed the lid and spout forming subject matter of the suit patents:

Before fixing on container	Fixed on container
	



12. The suit was accompanied by an application under Order XXXIX Rules 1 and 2 of the CPC, seeking an injunction, against the respondent, from infringing the suit patents by manufacturing and selling the allegedly offending lid.

13. By order dated 20 December 2023, the learned Commercial Court granted an injunction as sought by the appellant, and restrained the respondent in the following terms:

“15. I have considered the arguments advanced by Id. Counsel for plaintiff and gone through the record as well as the photographs/comparative analysis of the plaintiff's and defendant's products which are annexed with the plaint as well as detailed comparison of the products as mentioned in para 60 and para 65 of the plaint. Prima facie, it is evident that defendant's products had constructional and functional features similar to that of plaintiff's patented products. Further, it seems that both these products in comparison had the same purpose. The essence of doctrine of equivalence is to preserve and protect the patented product. Hence, upon the facts and the circumstances of the case, a prima facie case has been made out in favour of the plaintiff and balance of convenience also lies in their favour and in the event, if defendant will not be restrained, it may cause injury to the business and goodwill of the plaintiff, hence, till the next date of hearing, the defendant or any person acting on their behalf is restrained from manufacturing, marketing, using or selling or offering for sale, importing in India, distributing, advertising, exporting and any other manner directly or indirectly dealing in any product namely plastic containers that infringes the plaintiff's Indian Patent No. IN401417 and IN 298724 of any of the claims thereof.”

14. The respondent, as the defendant in the suit, moved an application under Order XXXIX Rule 4 of the CPC, for vacating the afore-noted *ad interim* injunction granted by the learned Commercial Court on 20 December 2023.



The impugned Order

15. By the impugned order dated 2 May 2024, the learned Commercial Court has vacated the *ad interim* order.

16. The reasoning of the learned Commercial Court, which commences from para 8 of the impugned order, reads thus:

“8. I have considered submissions made by Id. Counsels for the parties and gone through the record.

8.1. The Patent Act, 1970 does not define infringement. Where the subject matter is a process, Section 48 (b) of the Act, 1970 confers, on the patentee “the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India”.

8.2. Section 107(1) of the Act “(1) In any suit for infringement of a patent every ground on which it may be revoked under section 64 shall be available as a ground for defence.”

8.3. It is relevant to mention here that unlike the Trade Marks Act, 1999, where grant of a trademark leads to a presumption of its validity; grant of patent does not lead to any statutory presumption as to its validity. Thus, if a defendant raises a credible challenge to the validity of the patent, the same is relevant for deciding whether any interim orders restraining the defendant from using the patent in question, is warranted.

8.4. In case of *F. Hoffmann La-Roche Limite v Cipla Limited*⁶, the Hon'ble Court observed that the court has to see the tenability and the credible nature of defence while deciding the grant or non-grant of injunction. If the defendant's case is found to be tenable and there are serious questions as to validity to be tried in the suit, then the interim injunction in this case may not be granted. This practice is prevalent in the patent infringement cases where patentee always presses for injunction either interim or permanent and the defendant always attempts at the interim stage to raise a

⁶ ILR 2009 Supp (2) Del 551



question on the validity so as to cast doubt in the mind of the court on the validity aspect and seeks refusal of interim injunction. The court faces a bigger challenge in deciding as to which case warrants injunction and which case does not.

8.5. It is equally well settled principles of grant of injunction in the cases relating to patent infringement are no different from that of ordinary civil cases which are normally prima facie case, balance of convenience and irreparable loss. Lord Denning M.R. in his famous speech in the case of *Hubbard and Another v Vosper and Another*⁷, had observed in considering whether to grant an interlocutory injunction, the right course for a Judge is to look at the whole case and form a holistic view of the matter. In the words of Lord Denning, it was observed "In considering whether to grant an interlocutory injunction, the right course for a judge is to look at the whole case. He must have regard not only to the strength of the claim but also to the strength of the defence, and then decide what is best to be done. Sometimes it is best to grant an injunction so as to maintain the status quo until the trial."

8.6. Again in a celebrated case of *American Cyanamid Co. v Ethicon Ltd.*⁸ Lord Diplock speaking for House of Lords in England observed about the object of grant of interlocutory injunction in the following words: "The object of the interlocutory injunction is to protect the plaintiff against injury by violation of his right for which he could not be adequately compensated in damages recoverable in an action if the uncertainty were resolved in his favour at the trial.

8.7. In case of *Glaverbel S.A v Dave Rose & Ors*⁹, it is held that:

"85. The said fact again raises a disputed question of fact which requires evidence and raises a prima facie doubt on the fact as to whether the defendants are using the same process which corresponds to that of the plaintiff patent. At the interlocutory stage, this court has to form a just and a prima facie opinion and the disputed questions which have been asserted by the plaintiff and denied by the defendants and the veracity of which is in question requires a trial. Thus, the same is another reason for the non grant of interim injunction as question of infringement or no infringement in the present is disputed question of the fact."

8.8. It is no more *res integra* that the court in such cases has to

⁷ (1972)1 All ER 1023 at 1029

⁸ [1975] RPC 513

⁹ 2010 SCC Online Del 308



weigh the case of plaintiff *vis-à-vis* the case of defendant if the plaintiff is able to satisfy that there is a serious question to be tried and the defence of invalidity of patent raised by the defendant is not credible or weak, then the court can conveniently grant interim injunction in favor of the plaintiff till the pendency of the proceedings. On the other hand, the defendant's defence as to invalidity of patent is found to be credible one and defendant is able to satisfy that the said defence if proved and thrashed out in trial would lead to defendant being successful in the proceedings, then the interim injunction may be refused on the ground of credible and tenable defence. It is, however, a question of fact as to in which case the former proposition will hold good or the latter.

8.9. It is well settled law that it is incumbent upon the plaintiff to approach with clean hands, a principle that mandates the full disclosure of relevant and material facts. In case of **S.P. Chengalvaraya Naidu v Jagannath and Others**¹⁰, it was held that the Courts of Law are meant for imparting justice between the parties. One who comes to the Court, must come with clean hands. "It can be said without hesitation that a person whose case is based on false-hood has no right to approach the Court. He can be summarily thrown out at any stage of the litigation. A litigant, who approaches the Court, is bound to produce all the documents executed by him which are relevant to the litigation. If he withholds a vital document in order to gain advantage on the other side then he would be guilty of playing fraud on the Court as well as on the opposite party. Further, in **Aura Synergy India Ltd. v New Age False Ceiling Co. Pvt. Ltd.**¹¹, the specific view that suppression and misrepresentation can have a bearing on interim injunction application, especially in the context of IP disputes, was upheld. The said decision has also been approved by the Id. Division Bench vide judgment dated 18th November, 2016 in **Aura Synergy India Ltd. v New Age False Ceiling Co. Pvt. Ltd.**¹². Further, in **FMC Corporation v GSP Crop Science Private Limited**¹³, Hon'ble High Court held that 'suppression and misrepresentation' is one of the grounds available to a Defendant to challenge the grant of an interim injunction. In **Gujarat Bottling Co. Ltd. v Coca Cola Co.**¹⁴, the Supreme Court categorically held that since the grant of an injunction is wholly equitable in nature, the conduct of parties have a significant bearing on the grant or non-grant of an interim injunction. The relevant extract of decision is as follows:

“In this context, it would be relevant to mention that in the

¹⁰ AIR 1994 SC 853

¹¹ (2016) 65 PTC 483

¹² (2017) 72 PTC 95 (DB)

¹³ 2022 SC OnLine Del 3784

¹⁴ (1995) 5 SCC 545



instant case GBC had approached the High Court for the injunction order, granted earlier, to be vacated. Under Order 39 of the Code of Civil procedure, jurisdiction of the Court to interfere with an order of interlocutory or temporary injunction is purely equitable and, therefore, the Court, on being approached, will, apart from other considerations, also look to the conduct of the party invoking the jurisdiction of the court, and may refuse to interfere unless his conduct was free from blame. Since the relief is wholly equitable in nature, the party invoking the jurisdiction of the Court has to show that he himself was not at fault and that he himself was not responsible for bringing about the state of things complained of and that he was not unfair or inequitable in his dealings with the party against whom he was seeking relief. His conduct should be fair and honest. These considerations will arise not only in respect of the person who seeks an order of injunction under Order 39 Rule 1 or Rule 2 of the Code of Civil Procedure, but also in respect of the party approaching the Court for vacating the ad-interim or temporary injunction order already granted in the pending suit or proceedings.”

8.10. Furthermore, the Hon’ble High Court of Delhi in the matter of *Columbia Sportswear Company v Harish Footwear & Anr*¹⁵, observed that “The Courts have time and again noted that the conduct of a party who is seeking a discretionary relief from the Court weighs largely in the mind of the Court while dealing with such a prayer. Where a party is guilty of suppression of a material fact, he may not be entitled to such a relief.”

8.11. In the case of *Bishwanath Prasad v Hindustan Metal Industries*¹⁶, the Hon’ble Supreme Court held that in order to be patentable an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or 'inventive step'. It was further held that mere collection of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify, for the grant of a patent. The Supreme Court has categorically held that in order to be patentable, the new subject matter must involve invention producing new result or a new article or better or cheaper article. In my considered opinion the nature and manner of construction of layers, was publicly known, used and practised in India, prior to the date of patent and thus there is novelty attached to it. The invention as claimed by the plaintiff does not satisfy the test laid down in the aforesaid decision

¹⁵ (2017) 70 PTC 489

¹⁶ (1979) 2 SCC 511



for an invention.

9. Reverting back to the facts of the case in hand, the factual matrix of this case shows that while seeking the ex-parte injunction, *the plaintiff averred* that the defendant's product bore striking similarities in terms of product features and manufacturing processes to those covered by the plaintiff's patents IN'417 and IN'274. It was emphasize that the technology and processes utilized in the defendant's product were evidently reminiscent of those of the plaintiff which are protected by patents. Consequently, this court, recognizing the potential infringement and the need to preserve the plaintiff's rights, granted the relief in the form of an ex-parte injunction.

10. However, *the defendant while contesting the plaintiff's assertions, raised a substantial objection, contending that* defendant's products significantly differed from those of the plaintiff's by exhibiting them in a comparison chart as discussed in preceding paragraph 6.1. *It is claimed by the defendant that the defendant's product has Closure of the container which has ridges, Total of 24 (twenty four) lock teeth on the periphery, single wall on the periphery, Tear band which is a three-piece strip etc. Based on these facts, the defendant avers that the plaintiff in the plaint have alleged false and misleading statements regarding the defendant's product to which the defendant submits that that the defendant product has only 3 side tear band and on 4th side, there is no path of tear band, the defendant's product does not have the tear path on all four sides of the lid. Hence, the tear band does not fall off independently upon opening of the lid from the container. The tear band opens only on three sides of the container, the lid doesn't detach from the container or the lower secondary portion of the locking section, lid cannot be completely lifted from the container hence, it acts like the bin mechanism. The tear band on defendant's product is not continuous. The defendant's product has no spring back hinges, however has two 'wedge- shaped' lock teeth. Furthermore, the ld. Counsel for the defendant argued that the plaintiff's expert, tasked with comparing the products, had been presented with the wrong product—one not covered by the relevant patents. Allegedly, the comparison was made against a product of the plaintiff that fell outside the scope of protection afforded by patents IN'417 and IN'724. The defendant has strongly contested the grant of ex-parte stay on the basis that the comparison submitted by the plaintiff was based on wrong products which do not pertain to the plaintiff. The defendant claims it to be misrepresentation of facts.*

11. *In rebuttal, the plaintiff urged* by emphasizing that the comparison should be done based on the granted claims of the patents, rather than focusing solely on the specific products by



relying on the judgment *Sotefin Sa supra* wherein it was held that “For patent infringement analysis, comparison of elements of the suit patent's claims is to be done with the elements/ claims of the infringing product.”

12. The divergent arguments of the parties on products or the granted claims of their patents is also examined. The argument of the defendant that its products are dissimilar to the plaintiff is a valid credible defence available to the defendant. It is settled law in the domain of Patents that when the defendant raised a credible challenge to the validity and serious substantial question and triable issue, then, interim protection cannot be granted.

13. Now coming to the contention of the plaintiff that court should examine the granted claims of their patents then in the present case there are few facts which are of prime importance such as while granting the patent there is always a paramount consideration of ‘prior arts’ which practically determines the novelty of any patent and thus its infringements. It is matter of record that *in Patent No. IN'417 there were other prior arts besides eight prior arts as mentioned by the plaintiff and with regard to Patent IN'724, there are other prior arts.* The defendant has substantiated and provided prima facie evidence indicating that *properties outlined in the claims of the suit patents are well-known to the industry and are part of prior arts, consequently, the plaintiff shall not claim monopoly or exclusivity over these features.* While the defendant referred to other prior arts and claimed that there are 18 prior arts for the patent IN'417. *Both the parties have given the details of these prior arts which is not disputed.* The plaintiff claims that the extra ten prior arts quoted by the defendant are not relevant for the present case and *also disputed that none of the 18 prior arts are similar to the granted claim of the plaintiff's registered patent IN'417.* It is noteworthy that *the Controller of Patent had no occasion to consider whether the improvement made in the claimed patent over the prior art is to the extent that such a technological advance which would merit grant of patent and secondly whether to limit the grant of patent only to such improvements or grant patent as an invention of a new product. Obviously, Controller had no occasion to examine the claim made by the plaintiff as an improvement over the existing art and uphold the claim for patent made by the plaintiff. There is, therefore, a serious triable issue on decision of which validity of the patent depends namely whether the features claimed to be a novelty or a technical advance as compared to the known prior art, not obvious to the persons skilled in the art. Even if a combination of features, independently found to exist can be claimed to be novelty as contended by the plaintiff, such a claim should have been made by the plaintiff after discovering the existing prior art. The issue needs consideration, which prior art contained which features and*



whether plaintiff's product contains features which involve technological advance over prior art which is non-obvious to the person in the same field of art. This is a question of fact to be decided at the trial.

14. Another noticeable feature with regard to Patent IN'417 is that the plaintiff in its plaint admits it to be improved version thus it would again raise questions about novelty when the infringement is in question because the plaintiff is burdened to show the novelty and its adoption by the defendant before even a case is made out.

15. *In respect of Patent IN'724 besides the aforesaid issues there is another additional fact that it is an admitted position that there is one patent no. IN'276 regarding similar product which admittedly cease to exist. Subsequently, another patent is born which is no. IN'724. Now this raises a fundamental question of extent of novelty between patent no. IN'276 and patent no. IN'724. The issue gets compounded in when the question is posed that the products of the defendant are in infringements. In case, the products of the defendant are congruent to any ceased Patent then there is no case as it occupies the same space. The plaintiff would be burdened to show the novelty of its patent over '276. Moreover, it is material to note that defendant has not disclosed about status of its patent '276. Undeniable, non disclosure or suppression of this fact is significant and adverse to the case of plaintiff. In case of **Satish Khosla v M/s Eli Lilly Ranbaxy**¹⁷, the Hon'ble High Court rejected the suit on account of the failure to disclose earlier proceedings. There is no cavil that in cases where a party seeking interim relief has withheld necessary information and misrepresented material facts, it would be disentitled for equitable relief.*

16. In considered opinion of this court, *prima facie, defendant has succeeded in raising disputed question of facts and credible challenge to the suit patents on the ground of novelty and viz.a.viz, prior arts and further, suppression of material facts by the plaintiff, thus, for non grant of temporary injunction. At this stage, this court has to form a just and prima facie opinion and veracity on disputed facts and credible challenges requires a trial.*

17. In view of above discussion, the plaintiff's prayer for interlocutory injunction is rejected. Accordingly, the *ad interim* interlocutory injunction granted vide 20.12.2023 stands accordingly vacated. Accordingly, the application of the defendant under Order XXXIX Rules 4 CPC is allowed.

18. Nothing mentioned here in above shall tantamount to be an

¹⁷ 1997 SCC OnLine Del 935



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expression of opinion on the merits of the case.”

17. Aggrieved by the aforesaid order, the plaintiff in the suit has filed the present appeal under Section 13A of the Commercial Courts Act read with Order XLIII of the CPC.

Rival Contentions

Submissions of Mr. Mehta

18. We have heard Mr. Jayant Mehta, learned Senior Counsel for the petitioner and Mr. J. Sai Deepak, learned Senior Counsel assisted by Mr. Vikas Khara, learned Counsel for the respondent at length.

19. Among the submissions advanced by Mr. Mehta, to question the correctness of the impugned order, is the submission that the order is completely unreasoned.

20. He submits that, after dealing with the rival contentions of the parties on the aspect of infringement, the learned Commercial Court has not examined the said aspect at all, by comparing the respondent's product to the complete specifications in the suit patents. In fact, he submits that the learned Commercial Court has proceeded on a premise that infringement is to be decided on a product-to-product comparison, which itself is infirm, as the comparison has to be between the product of the defendant and the complete specifications in the suit patent of the plaintiff.



21. Even that analysis, he submits, has not been done.
22. He points out that, till para 11 of the impugned order, the learned Commercial Court has noted the contentions of the parties and has, thereafter, proceeded, in para 12, to first observe that “the argument of the defendant that its products are dissimilar to the plaintiff (was) a valid credible defence available to the defendant” and, thereafter, that “when the defendant raised a credible challenge to the validity and serious substantial question and trivial issue, then, interim protection cannot be granted”.
23. Thus, he submits that there is no discussion regarding the issue of whether the respondent’s product in fact mapped on to the suit patents of the appellant.
24. Even on the aspect of whether the respondent had raised a credible challenge to the validity of the suit patent as envisaged by Section 107(1)¹⁸ of the Patents Act, read with Section 64(1)¹⁹ thereof,

¹⁸ 107. **Defences, etc. in suits for infringement.** –

(1) In any suit for infringement of a patent, every ground on which it may be revoked under Section 64 shall be available as a ground for defence.

¹⁹ 64. **Revocation of patents.** –

(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may, be revoked on a petition of any person interested or of the Central Government or on a counter-claim in a suit for infringement of the patent by the High Court on any of the following grounds, that is to say,—

- (a) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;
- (b) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;
- (c) that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;
- (d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;
- (e) that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in Section 13;
- (f) that the invention so far as claimed in any claim of the complete specification is



Mr. Mehta submits that there is no discussion in the impugned order.

25. After observing that a credible challenge was required to be raised by the defendant, the learned Commercial Court has, in para 13 only noted the existence of certain prior arts, and has questioned the issue of whether the Controller of Patents had all the material available before him while granting the suit patent.

26. Thereafter, in para 14 of the impugned order, the learned Commercial Court has, according to Mr. Mehta, completely shifted the statutory onus which otherwise lies on the defendant under Section 107 of the Patents Act, to the plaintiff, by observing that “the plaintiff

obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim;

(g) that the invention, so far as claimed in any claim of the complete specification, is not useful;

(h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;

(i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;

(j) that the patent was obtained on a false suggestion or representation;

(k) that the subject of any claim of the complete specification is not patentable under this Act;

(l) that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in sub-section (3), before the priority date of the claim;

(m) that the applicant for the patent has failed to disclose to the Controller the information required by Section 8 or has furnished information which in any material particular was false to his knowledge;

(n) that the applicant contravened any direction for secrecy passed under Section 35 or made or caused to be made an application for the grant of a patent outside India in contravention of Section 39;

(o) that leave to amend the complete specification under Section 57 or Section 58 was obtained by fraud;

(p) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(q) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.



is burdened to show the novelty and its adoption by the defendant before even a case is made out”. Mr. Mehta submits that this is a fundamentally erroneous understanding of the statutory and legal position, which clearly places the onus of the defendant, who seeks to raise Section 107 defence, to substantiate the defence. The onus, he submits, cannot be initially placed on the plaintiff.

27. Mr. Mehta further submits that even with respect to the patent IN’724, except for observing that there were an earlier patent IN’276 of the appellant “regarding a similar product”, there is no attempt by the learned Commercial Court to establish that the two products are similar or that the suit patent IN’724 was either obvious or anticipated from the prior art IN’276. Mr. Mehta has placed on record a tabular statement which, according to him, would clearly establish that IN’724 is neither obvious nor anticipated from IN’276. However, we do not propose to examine that aspect as, in our view, the learned Commercial Court has also not done so.

Submissions of Mr. J. Sai Deepak and Mr. Vikas Khara

28. Mr. J. Sai Deepak, learned Senior Counsel for the respondent, on the other hand, even while accepting that the impugned order may not be as reasoned as such orders ordinarily ought to be, submits that the learned Commercial Court could not be said to have been in error in holding that the initial onus to establish that the suit patent IN’417 was an improvement over the earlier patent held by the appellant was on the appellant. He submits that, once the appellant had, in its plaint and in the complete specifications of the suit patents IN’417,



specifically pleaded that it was an improvement over earlier prior arts, the onus to prove that it was an improvement was on the appellant. He relies, in this context, on the following passage from the judgment of the Supreme Court in *Bishwanath Prasad Radhey Shyam v Hindustan Metal Industries*²⁰:

“21 It is important to bear in mind that in order to be patentable an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an “inventive step”. To be patentable the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. The combination of old, known integers may be so combined that by their working inter-relation they produce a new process or improved result. Mere collection of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent. “It is not enough”, said *Lord Davey in Rickmann v Thierry*²¹ “that the purpose is new or that there is novelty in the application, so that the article produced is in that sense new, but there must be novelty in the *mode* of application. By that, I understand that in adopting the old contrivance to the new purpose, there must be difficulties to be overcome, requiring what is called invention, or there must be some *ingenuity* in the mode of making the adoption”. As Cotton, L.J. put it in *Blackey v Lathem*²² “to be new in the patent sense, the novelty must show invention”. In other words, in order to be patentable, the new subject-matter must involve “invention” over what is old. Determination of this question, which in reality is a crucial test, has been one of the most difficult aspects of Patent Law, and has led to considerable conflict of judicial opinion.”

29. As a fall back argument and without prejudice, Mr. Sai Deepak submits that, if the Court were ultimately to feel that the matter required *de novo* consideration by the learned Commercial Court, the case should be sent back to the Order XXXIX stage. In other words, he exhorts the Court to set aside that it should not only restrict itself

²⁰ (1979) 2 SCC 511

²¹ (1896) 14 Pat Ca 105

²² (1888) 6 Pat Ca 184



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setting aside the impugned order but should also set aside the initial *ad interim* order passed under Order XXXIX Rules 1 and 2 of the CPC. He also took us through certain passages of the initial *ad interim* order dated 20 December 2023, in order to seek to convince us that it was unsustainable in law.

Analysis

Re. without prejudice prayer to set aside the *ad interim* order dated 20 December 2023

30. We may straightaway observe, apropos the last submission of Mr. Sai Deepak, that we cannot tinker, in this appeal, with the *ex parte ad interim* order dated 20 December 2023. That order is not under challenge before us.

31. The respondent took a conscious decision to move an application under Order XXXIX Rule 4 of the CPC, seeking vacation of the order, instead of filing an appeal against the order dated 20 December 2023. Both courses of action were open before it. Having chosen to pursue one, the respondent cannot, now, in appeal at the instance of the appellant, seek the other.

32. The order which is under challenge before us is the order passed on the said application filed under Order XXXIX Rule 4 of the CPC. We, therefore, cannot only examine the correctness of the order dated 2 May 2024 passed under Order XXXIX Rule 4 of the CPC.

33. We, therefore, are constrained to reject Mr. Sai Deepak's plea



that we must set the clock back to the stage when the Order XXXIX Rules 1 and 2 application was considered by the learned Commercial Court.

Re. Impugned Order dated 2 May 2024

34. Adverting, now, to the impugned order dated 2 May 2024, we find ourselves in agreement with Mr. Mehta that the order, as passed, cannot sustain the scrutiny of law. It does not examine, to any satisfactory extent, any of the important aspects which are involved which were in consideration before the learned Commercial Court.

Features of patent infringement litigation, and the task of the Court – Aspect of “infringement” – Right of defendant to raise credible challenge to vulnerability of suit patent – Onus of proof

35. Every patent infringement litigation essentially involves, depending on the nature of the defence raised by the defendant, only two aspects and does not ordinarily involve any other.

36. The first is whether the product of the defendant infringes the suit patent. The Patents Act is, in the intellectual property firmament, a peculiar statute, in that it does not define “infringement”, or delineate what constitutes infringement of a patent. There is no provision, in the Patents Act, akin to Section 29 of the Trade Marks Act, 1999, which defines infringement of a trade mark, Section 51 of the Copyright Act, 1957, which defines infringement of copyright, or Section 22 of the Designs Act, 2000, which defines design piracy. This appears, frankly, to be a legislative lacuna, and it may be



advisable for the legislature, at some appropriate stage, to correct it. Though it is not difficult to glean, from the provisions of the Patents Act, what constitutes “infringement”, certainty and precision are always desirable virtues in any legislative instrument.

37. That said, the Patents Act refers, at various points, to patent infringement. Without defining patent infringement, it refers, in Section 49(1)²³, to circumstances in which patent rights are *not* infringed, and dedicates an entire Chapter XVIII to “Suits concerning Infringement of Patents”. Which makes it all the more necessary to know what constitutes infringement of a patent.

38. The answer is apparently contained in Section 48²⁴, which sets out the rights of patentees. Insofar as product patents are concerned, grant of the confers on the patentee the exclusive right to prevent third parties from making, using, offering for sale, selling or importing, into India, the product covered by the patent. The fact that Section 48 is immediately followed by Section 49, which sets out circumstances in

²³ 49. **Patent rights not infringed when used on foreign vessels, etc., temporarily or accidentally in India.** –

(1) Where a vessel or aircraft registered in a foreign country or a land vehicle owned by a person ordinarily resident in such country comes into India (including the territorial waters thereof) temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention—

(a) in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or

(b) in the construction or working of the aircraft or land vehicle or of the accessories thereof, as the case may be.

²⁴ 48. **Rights of patentees.** – Subject to the other provisions contained in this Act and the conditions specified in Section 47, a patent granted under this Act shall confer upon the patentee—

(a) where the subject-matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;

(b) where the subject-matter of the patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India:



which patent rights are *not* infringed, indicates that the making, using, offering for sale, selling or importing of a product covered by a product patent, without the consent of the patentee, constitutes “infringement”.

39. Whether infringement has, or has not, taken place in a particular instance, has to be decided on the basis of a mapping between the product of the defendant and the complete specifications of the suit patent. Mr. Mehta is correct in his submission that the comparison has to be product to patent and not product to product. What is prohibited, by Section 48, is the making, using, offering for sale, selling or importing of the product which forms “subject matter of” the patents held by another. In order to ascertain whether this right has been breached, therefore, the Court has to first ascertain the subject matter of the suit patent. This subject matter is to be found in the complete specifications of the suit patent. In other words, the Court as to compare the goods of the defendant with the subject matter of the suit patent, as is contained in the complete specifications of the suit patent, in order to ascertain whether infringement has taken place. The comparison has, therefore, to be product-to-patent, and not product-to-product.

40. If the Court finds that there is no infringement, the matter rests there.

41. If, however, the Court finds that infringement has taken place, the Court has to examine whether the defendant has raised a defence under Section 107 of the Patents Act. If it has, the second aspect arises



for consideration. We may note that, in almost every matter, such a defence is raised and, in many cases (especially in the area of pharmaceutical patents), that is the sole defence that is raised by the defendant. In the present case, of course, the respondent-defendant has also pleaded non-infringement.

42. Under Section 107 of the Patents Act, a defendant is entitled to raise every ground on which a patent is vulnerable to revocation under Section 64 of the Patents Act as a ground of defence. In other words, if the defendant is able to show that the suit patent is vulnerable to revocation for one or more of the grounds envisaged by Section 64 of the Patents Act, that would constitute a valid defence even if, otherwise, the defendant's product does infringe the suit patent, and the defendant would escape an injunction.

43. The nature of the challenge that the defendant raises under Section 107 is also important. The defendant is not required to make out a cast iron case of vulnerability of the suit patent to revocation under Section 64. All that the defendant has to raise is a credible challenge to the suit patent as being vulnerable to revocation under Section 64. The scope and extent of the "credible challenge" that the alleged infringer-defendant has to raise, to the validity of the suit patent and its vulnerability to revocation have been thus delineated by Muralidhar J. (as he then was), sitting singly as a learned Judge of this Court, in *Strix Ltd v Maharaja Appliances Ltd*²⁵:

"22. It was contended by learned counsel for the Defendant that at an interlocutory stage, the Defendant should be held to have

²⁵ 2009 SCC OnLine Del 2825



discharged its burden of raising a ‘credible challenge’ to the validity of the Plaintiff’s patent by merely pointing out the existence of the European Patent. This court is unable to agree. In order to raise a credible challenge to the validity of a patent, even at an interlocutory stage, the Defendant will have to place on record some acceptable scientific material, supported or explained by the evidence of an expert, that the Plaintiff’s patent is prima facie vulnerable to revocation. The burden on the Defendant here is greater on account of the fact that there was no opposition, pre-grant or post-grant, to the Plaintiff’s patent. In *Beecham Group Ltd. v Bristol Laboratories Pty Ltd.*²⁶, and *Australian Broadcasting Corporation v O’Neill*²⁷, it was held that the defendant alleging invalidity bears the onus of establishing that there is “a serious question” to be tried. In *Hexal Australia Pty Ltd. v Roche Therapeutics Inc.*²⁸, it was held that where the validity of a patent is raised in interlocutory proceedings, “the onus lies on the party asserting invalidity to show that want of validity is a triable question.” ”

One of us (C. Hari Shankar J.) has, also sitting singly, examined the scope and ambit of a “credible challenge” thus, in *Kudos Pharmaceuticals Ltd v Natco Pharma Ltd*²⁹:

“The consideration of credible challenge

24. Mr. Sai Deepak seeks to contend that the defendant is only required to raise a credible challenge to the vulnerability of the suit patent in order to succeed in its defence against infringement.

25. There is no dispute about this legal position.

26. However, it is necessary to understand what “credible challenge” means. In this context, this court has held, in para 19 of *FMC-II*³⁰, paras 178 and 231 to 233 of *Novartis I*³¹ and para 129 of *Novartis II*³² thus:

FMC-II

“19. Thus, the challenge, posed by the defendant to the

²⁶ (1967-68) 118 CLR 618

²⁷ (2006) 229 ALR 457

²⁸ 66 IPR 325

²⁹ 2024 SCC OnLine Del 1439

³⁰ *FMC Corporation v Best Crop Science LLP*, (2021) 87 PTC 217

³¹ *Novartis AG v Natco Pharma Ltd*, 2023 SCC OnLine Del 106

³² *Novartis AG v Natco Pharma Ltd*, 2021 SCC OnLine Del 5340



validity of the plaintiffs patent need not be such as to demonstrate, conclusively, the invalidity thereof. It is sufficient if the defendant is able to make out a case of the suit patent being vulnerable to revocation under the Patents Act. This vulnerability has, however, to be demonstrated by way of a credible challenge. The onus would be on the defendant, therefore, to establish the credibility of the challenge raised by it. The challenge cannot be incredible, fanciful, or moonshine. It must not strain the sinews of acceptability. There can, however, needless to say, be no fixed standard on the basis of which the credibility of the challenge can be assessed. It would be for the Court, in each case, therefore, to ascertain, for itself, whether the challenge raised by the defendant, to the validity of the suit patent, is, or is not, credible.”

Novartis I

“178. The challenge in this regard must be credible. Credibility indicates that, on the face of the challenge, it must merit favourable consideration. A credible challenge occupies a higher pedestal than a challenge, which is merely worthy of consideration.

231. Before closing the discussion, I wish to enter a final observation. There appears, *prima facie*, to me, to be a fundamental misconception relating the concepts of a “credible challenge” and of “vulnerability”. The submissions advanced by the defendant seem to have been predicated on the premise that the slightest shadow of doubt, which could be cast on the suit patent, was sufficient to constitute a credible challenge, exposing its vulnerability to revocation. This proposition, according to me, is completely misconceived. Para 28 of the report in ***Bishwanath Prasad Radhey Shyam*** recognises the fact that, prior to grant of a patent, especially for a pharmaceutical product, a thorough study is normally undertaken by the Patent Office, regarding the validity of the patent as sought. When an infringer seeks to defend infringement on the ground that the patent that he infringes is invalid, the onus, to prove such invalidity heavily lies on him. This standard has to be met, when applying the principle of “credibility”. Repeated attempts were made to convince me that any and every ground that the defendant sought to raise, and for which a cast iron response from the plaintiff was not immediately forthcoming, was sufficient to establish vulnerability of the suit patent to revocation.



Revocation is a drastic act, and a patent, once granted, cannot be treated as easily vulnerable to revocation. Even if, *prima facie*, a ground for revocation is made out, as is noted in *Merck v Glenmark*³³, revocation is not automatic, but remains a matter of discretion, for the patent authority. The grant of such discretion is itself a pointer to the legislative intent that, before revoking a patent, the authority is required to satisfy itself, that, all considerations having been mould in mind, revocation is absolutely necessary. Vulnerability to revocation has also to be judged on the same standard. It is only when, judged on that standard, a credible challenge to the validity of the patent as vulnerable to revocation is made out, that an infringer can escape the consequences of infringement. The standard is, therefore, high, rather than low.

232. This would especially be so in a situation, as in the present case, the infringer never chose to challenge the suit patent either at pre-grant or at post-grant stage, by filing oppositions. The defendants have not, therefore, “cleared the way”, before exploiting the suit patent. Mr. Sai Deepak sought to contend that, by deferring the release of their Eltrombopag Olamine, till the expiry of the term of IN 176, the defendants had sufficiently cleared the way. Mr. Hemant Singh has disputed this contention, and I confess that I agree with him. IN 161 was granted as far back as on 27th March, 2009. It has remained in force for 12 years. The defendants have neither chosen to launch any pre-grant or post-grant, opposition to IN 161. Nor have they filed any proceedings before the patent office or the IPAB, to cancel or suspend the registration granted to IN 161. Rather, even while IN 161 continues to remain valid, the defendants have, without blinking an eyelid, sought to exploit the subject matter of the said patent, i.e. EO. That they have done so with the full awareness that EO is specifically claimed in IN 161, is not disputed. Clearly, therefore, the defendants have, by their attitude, as well as by failing to clear the way before exploiting the suit patent, IN 161, exposed themselves to an interlocutory injunction.

233. It is only when they have been “caught in the act”, as it were, that the infringer defendants, unable to dispute the charge of infringement on facts, seek to question the validity of the suit patent. While Section 64, undoubtedly, allow them to do so, the challenge has to be credible, not incredible. The defendants, in the present case, neither launched any pre-grant nor any post-grant, opposition to IN

³³ *Merck Sharp & Dohme Corporation v Glenmark Pharmaceuticals*, (2015) 63 PTC 257 (Del-DB)



161. They have not initiated any proceeding before IPAB or any other authority, for revocation, cancellation or removal of the suit patent from the register of patents. In such circumstances, the holder of the suit patent would ordinarily be entitled to an injunction against continued infringement. Absent *any prima facie* case of vulnerability of the suit patent to revocation on the ground of invalidity, therefore, injunction cannot be refused, once infringement is established.”

Novartis II

“129. *In fact, Natco has, in its submissions, completely glossed over the most important query which it would have to answer, in order to set up even a credible challenge to the validity of the suit patent, vis-à-vis a Markush prior art. The suit patent could be said to be vulnerable to invalidity, vis-à-vis known Markush prior art, only if it is established, cumulatively that*

- (i) *from the known prior art, it is possible to arrive at the suit patent, by effecting suggested substitutions in the Markush formula claimed in the prior art, from the substitutions suggested therein, and*
- (ii) *the Markush prior art contains the requisite teaching, as would suggest the substitutions which are to be so made in order to arrive at the suit patent.*”

27. Thus, the onus to establish that the challenge raised by it is credible, is on the respondent. A credible challenge, as Mr. Pravin Anand has correctly submitted, is a challenge which is not incredible, fanciful, or moonshine, and must *prima facie* be acceptable. On its face, the challenge must merit favorable consideration. It is not enough for the defendant to raise a challenge which is worthy of consideration. The challenge must be more than that; it must partake of the character of *prima facie* acceptability “credibility”, even by itself, connotes a fairly high standard. In examining whether the challenge raised is credible, a relevant consideration is the fact that the Patent Office has, after a thorough study, found the patent to be valid and capable of being granted. In *Merck*, the Division Bench of this Court held that, even if a ground for revocation of a granted patent was made out, revocation was not an inevitable sequitur, but that the patent authority retained discretion in that regard. The same standard has to be adopted while examining vulnerability to revocation. The standard of credibility is, therefore, a high standard, not a low standard, as is commonly understood..”



44. Thus, every court which is seized with a patent infringement action has ordinarily two aspects to consider. The first aspect is whether the defendant’s product does, or does not, infringe the suit patent. In case the defendant raises a Section 107 defence, the second aspect that the Court has to consider is whether the defendant has raised a credible challenge of vulnerability of the suit patent to revocation on one or more of the grounds envisaged in Section 64 of the Patents Act. The “credibility” of the challenge has to be tested on the anvil of the decisions cited *supra*.

Infirmities in the impugned judgment

No discussion or finding on infringement

45. We have reproduced the relevant paragraphs from the impugned order. There is no discussion, by the learned Commercial Court, regarding the aspect of infringement, which is the first aspect that the Court is required to consider. In fact, the learned Commercial Court has, in para 12 of the impugned order, observed that “the argument of the defendant that its products are dissimilar to the plaintiff” was by itself “a valid credible defence available to the defendant”. The learned Commercial Court has contented itself with this observation, without examining, for itself, whether in fact the respondent’s products were, or were not, infringing the suit patents IN’417 and IN’724. There is no exercise of mapping of the respondent’s products to the appellant’s suit patents in order to examine whether the case was in fact one of infringement.



46. The observation of the learned Commercial Court, in fact, suffers, *ex facie*, from perversity in law. An “argument” that the products of the respondent were dissimilar *to the plaintiff* can never, *by itself*, constitute “a valid credible defence”. Without examining the merits of the argument, we are unable to fathom how the learned Commercial Court found the argument to constitute a defence which was both “valid” and “credible”.

47. Moreover, we are unable to understand the finding that the products of the defendant were “dissimilar to the plaintiff”. The product of the defendant could not be compared with the plaintiff. It had either to be compared with the product of the plaintiff, or the complete specifications of the suit patents. If the learned Commercial Court was comparing the product of the defendant with the product of the plaintiff – as appears to be the case – it was seriously in error in law. The comparison has to be product-to-patent, not product-to-product.

48. Let us partly vivisect the impugned order.

49. Paras 8.1 to 8.11 merely set out general principles, unconnected with the specific facts of the present case. Para 9 sets out the contention of the appellant-plaintiff. Para 10 sets out contentions of the respondent-defendant. Para 11 sets out the submission of the appellant-plaintiff in rebuttal.

50. Thereafter, in para 12, the learned Commercial Court first observes that the divergent arguments of the parties had been



examined and proceeds to hold that the very argument of the respondent-defendant that its products were “dissimilar to the plaintiff” constituted a valid credible defence. We have already pointed out that this finding is unsustainable in law.

51. The second sentence in para 12 notes that it was settled law that, if a defendant raised a credible challenge to the validity of the suit patent, interim protection could not be granted. There can be no cavil with the proposition. However, having so said, there is no attempt, by the learned Commercial Court, to examine whether the respondent had, in fact, raised a credible challenge to the validity of the suit patents. A reading of para 12 seems, in fact, to indicate that the learned Commercial Court has erroneously conflated the aspects of infringement by the defendant’s product, of the suit patent and validity of the suit patent.

52. Para 13 of the impugned order goes on, first, to note that, while granting a patent, the Controller of Patents is required to examine prior arts. It thereafter holds thus:

“... It is noteworthy that the Controller of Patent had no occasion to consider whether the improvement made in the claimed patent over the prior art is to the extent that such a technological advance which would merit grant of patent and secondly whether to limit the grant of patent only to such improvements or grant patent as an invention of a new product. Obviously, Controller had no occasion to examine the claim made by the plaintiff as an improvement over the existing art and uphold the claim for patent made by the plaintiff.”

The basis of these observations, submits Mr Mehta, are not to be found anywhere in the impugned order or, for that matter, on the



record.

53. Following this, there is also no examination, by the learned Commercial Court, in the paragraphs that follow, of the plea of the respondents that the appellant's suit patents were vulnerable to revocation under Section 64 of the Patents Act.

54. Apropos the suit patent IN'417, Mr. Khara submits that the respondent's main ground for pleading vulnerability of the suit patent to revocation on the ground of anticipation and obviousness *vis-a-vis* prior art was based on the prior art document IN 288127³⁴, filed by the appellant.

55. There is no reference, anywhere in the impugned order, to IN'127. This submission of the respondent, we find, is noted in para 6.4 of the impugned order, but the learned Commercial Court has not bestowed any consideration to the said argument while dealing with the aspect of vulnerability of the suit patent IN'417 to revocation under Section 64.

56. Insofar as the suit patent IN'724 is concerned, the learned Commercial Court merely observes that "*there is a prior art*" in the form of the IN'276 patent of the appellant, without carrying out any exercise of mapping the features of the respondent's product to the complete specifications of the said prior art IN'276. The learned Commercial Court has regarded the very *existence* of a prior art in the form of IN'276 as sufficient to raise a credible challenge to the

³⁴ 'IN'127' hereinafter



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vulnerability of the suit patent IN'724. The assumption is obviously fallacious in law.

57. As such, the learned Commercial Court has not examined either of the two aspects which were required to be kept in mind while considering the respondent's application under Order XXXIX Rule 4 of the CPC.

58. Mr. Mehta is correct in his contention that, without considering either of these aspects, the learned Commercial Court could not have vacated the existing *ad interim* injunction dated 20 December 2023.

59. We may now advert to the observation of the learned Commercial Court that, as the appellant had, in its complete specifications in IN'417, pleaded that the subject matter of IN'417 was novel over its earlier patent IN'276, the onus was on the appellant to establish that it was novel. The learned Commercial Court, in our view, has seriously erred in this approach. While returning this observation, the learned Commercial Court appears to have lost sight of the fact that it was dealing with an infringement action. In an infringement action, the onus is, at the first stage, on the plaintiff alleging infringement and, at the second stage, on the defendant pleading a Section 107 defence. Once the plaintiff has succeeded in discharging its initial onus to establish that the defendant's product infringed the plaintiff's suit patent, the onus on the plaintiff stands discharged. Thereafter, while examining the defendant's Section 107 defence, the onus to establish that the plaintiffs' suit patent was vulnerable to invalidity for one or more of the grounds envisaged by



Section 64 is *wholly* on the defendant. In an infringement action, *it never shifts*.

60. One of the said grounds is absence of novelty of the suit patent, *vis-a-vis* prior art. The onus was, therefore, on the defendant to establish that the suit patent lacked novelty *vis-a-vis* prior art. Even if, in the complete specifications of the suit patent, it was stated that the suit patent was novel *vis-a-vis* prior art, that does not shift the onus under Section 107 read with Section 64 of the Patents Act, to establish absence of novelty of the suit patent *vis-a-vis* prior art from the defendant to the plaintiff. The onus continues to remain on the defendant.

61. Thus, the learned Commercial Court was fundamentally in error in holding that, as the plaintiff had pleaded that the suit patent IN'417 was novel over the existing prior art, the initial burden to establish novelty was on the plaintiff.

The sequitur

62. In view of the aforesaid observations, we are of the considered opinion that the impugned order of the learned Commercial Court cannot sustain either in law or on facts.

63. We make it absolutely clear that we have not examined any aspect of the case on merits. Specifically, we have not examined the aspect of whether the respondents products actually do, or do not, infringe the appellant's suit patents. Equally, we have also not



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examined whether the respondents have succeeded in raising a credible challenge to the vulnerability of the appellant's suit patents to revocation under section 64 of the Patents Act. All these questions are, therefore, required to be re-examined, *de novo*, by the learned Commercial Court.

64. We are informed that, consequent on a counter-claim having been filed by the respondents, the CS (Comm) 668/2023, in which the impugned order has been passed by the learned Commercial Court has travelled to this Court and is now re-numbered as CS (Comm) 944/2024.

65. Accordingly, in view of the aforesaid discussion, we quash and set aside the impugned order dated 2 May 2024 passed by the learned Commercial Court. The Registry would register the application filed by the appellant under Order XXXIX Rule 1 & 2 of the CPC as well as the application of the respondent under Order XXXIX Rule 4 of the CPC, fresh registration numbers.

66. The application under Order XXXIX Rule 4 of the CPC, which stands disposed of, by the impugned order dated 2 May 2024 is, therefore, restored to the file of the learned Single Judge, for consideration *de novo*.

67. Needless to say, the learned Single Judge would consider the said applications uninfluenced by any observation contained in the impugned order dated 2 May 2024 passed by the learned Commercial Court.



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68. In order to expedite matters, we direct the parties to appear before the learned Single Judge on 25 July 2025.

69. Both sides are directed to place on record short notes not exceeding six pages each, setting out their respective stands, along with duly indexed compilations of any judicial authorities on which they may seek to place reliance, before the learned Single Judge at least 48 hours in advance of the next date of hearing and also to e-mail copies thereof to the Court Master of the learned Single Judge.

70. The learned Counsel for the parties undertake not to take any adjournment on the next date before the learned Single Judge.

71. We request the learned Single Judge to take up the application under Order XXXIX Rule 4 of the CPC on the date fixed and decide the application as expeditiously as possible thereafter.

72. The appeal stands allowed to the aforesaid extent with no orders as to costs.

73. Mr. Khera prays that the learned Single Judge may be requested to decide the matter in a time-bound manner. We reserve liberty with Mr. Khera to make the said request before the learned Single Judge.

74. We again clarify that we have not expressed any opinion on the merits of the application of the appellant under Order XXXIX Rule 4 of the CPC. We have essentially endeavoured to clarify the applicable



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principles, as we feel that the impugned order has erred in understanding and applying them.

75. Pending disposal of the Order XXXIX Rule 4 application of the appellant, the order dated 20 December 2023, whereby *ex parte ad interim* relief was granted by the learned Commercial Court, shall continue to remain in operation.

C. HARI SHANKAR, J.

AJAY DIGPAUL, J.

JULY 11, 2025/AR/an