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

+ LPA 129/2025 & CM APPL. 10551/2025

**BOEHRINGER INGELHEIM PHARMA  
GMBH AND CO KG**

.....Appellant

Through: Dr. Abhishekh Manu Singhvi,  
Sr. Adv. with Dr. Sanjay Kumar, Ms. Arpita  
Sawhney, Ms. Pallavi Kiran, Mr. Arun  
Kumar Jana, Mr. Priyansh Sharma, Ms.  
Akshita Prasad, Ms. Atiksha Girdhar and  
Mr. Sidharth S, Advs.

versus

**THE CONTROLLER OF PATENTS & ANR.** .....Respondents

Through: Mr. G. Nataraj, Mr. Rahul  
Bhujbal and Mr. Yash Raj, Advs.  
Ms. Nidhi Raman, CGSC with Mr. Arnav  
Mittal, GP and Mr. Akash Mishra, Adv.

**CORAM:**

**HON'BLE MR. JUSTICE C. HARI SHANKAR**

**HON'BLE MR. JUSTICE OM PRAKASH SHUKLA**

**ORDER**

**03.11.2025**

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1. The parties before us have various litigations on-going between them. The respondents filed a revocation petition against the appellant, for revoking its patent. The appellant, on the other hand, filed an infringement suit against the respondents, alleging infringement of the very same patent. In the said infringement proceedings, the respondents raised a defence under Section 107 of the Patents Act, 1970, alleging invalidity of the patent of the appellant.

2. In this chiaroscuro of litigations, the learned Single Judge raised



two preliminary issues for consideration, which have been thus set out in para 2 of the impugned order:

“(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.”

3. The learned Single Judge has answered the first issue in the negative and the second in the affirmative. In other words, the learned Single Judge has held that the mere raising of a Section 107 defence by the respondents does not disentitle the respondents from continuing to maintain a revocation petition seeking revocation of the appellant’s patent. On the second issue, the learned Single Judge has held that such a revocation petition could continue even after the appellant’s patent had expired by efflux of time.

4. We have heard Dr. Singhvi, learned Senior Counsel for the appellant and Mr. Nataraj, learned Counsel for the respondents, at some length.

5. Though we feel that the sustainability of the challenge on the first finding of the learned Single Judge may be arguable, we *prima facie* are unable to agree with the finding of the learned Single Judge that a revocation petition could continue even after the patent of which revocation was sought had expired by efflux of time.

6. Mr. Nataraj, with his experience, is candid in acknowledging



that there is no direct authority on the point except *Star Textile Engineering Works Ltd v James Mackie Holdings Ltd*<sup>1</sup> which is a judgment of a learned Single Judge of the High Court of Calcutta.

7. He has taken us through the said decision. We find that, in the said decision, there is a submission recorded of Counsel to the effect that, even if a patent expires, there is no bar to a Court revoking the patent. This submission, in turn, has been made on the basis of a judgment in *North Eastern Marine Engineering Co. Ltd. v Leeds Forge Company Ltd*<sup>2</sup>, rendered by the Court of Appeal in the UK.

8. We, however, find that there is no clear application of mind by the learned Single Judge of the High Court of Calcutta on this aspect, nor has the learned Single Judge returned a positive finding thereon.

9. To our query as to how a petition for revocation can be maintained even after the patent which is sought to be revoked has expired, Mr. Nataraj submits that there is no specific bar in Section 64 of the Patents Act, barring the maintainability of a revocation petition after the patent has expired.

10. It is true that Section 64 of the Patents Act does not state that a revocation petition cannot continue even after the patent of which revocation is sought is expired. We, however, *prima facie* are of the view that the very concept of revocation would imply the subsistence of the patent of which revocation is sought. We *prima facie* do not feel

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<sup>1</sup> 1977 SCC OnLine Cal 280

<sup>2</sup> 23 RPC 96



that it was necessary for the legislature to incorporate a specific provision to the effect that a revocation petition would not lie against an expired patent, as the very concept of revocation, at the cost of repetition, would imply that the patent was a subsisting patent which was alive.

**11.** We may note, in this context, the distinction between Section 64 of the Patents Act and Section 57 of the Trade Marks Act, 1999. Unlike Section 57 of the Trade Marks Act, which envisages the removal of a trademark from the register of trademarks, Section 64 of the Patents Act talks of revocation of a patent. That apart, as we have already noted, in the absence of anything to the contrary in the Patents Act itself, we find it difficult to understand the concept of revocation of an expired patent. Can one kill a dead body?

**12.** Mr. Nataraj has submitted that, if a revocation action is allowed and a patent is revoked, that order takes effect *ab initio* and it is as though the patent was never granted. That submission, to our mind, begs the actual issue at hand. If a revocation petition is allowed while the patent is alive, no doubt the decision may take effect *ab initio*. That does not answer the issue of whether a revocation petition can be granted after the patent itself has expired by efflux of time.

**13.** As the issue is of considerable importance and would affect various matters, we list this matter on 17 November 2025 at 2.30 pm.

**14.** We have also requested Ms. Swathi Sukumar, learned Senior Counsel to act as *amicus* in this matter and assist us on this aspect.



**15.** In the meanwhile, the operation of the impugned order would stand stayed.

**16.** Learned Counsel for all parties are directed to place on record bulleted short notes of their respective submissions, with cross reference to relevant PDF page numbers, not exceeding four pages each after exchanging copies with each other at least a week in advance of the next date of hearing.

**17.** We clarify, before parting, that observations in this order are merely in the nature of thoughts that have come to mind today, and should not be regarded as even a perfunctory expression of opinion on the issue. We are conscious that it is highly arguable.

**C. HARI SHANKAR, J**

**OM PRAKASH SHUKLA, J**

**NOVEMBER 3, 2025/AR**