



2026:DHC:1609-DB



2026:DHC:1609-DB

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

*Reserved on: 26.11.2025*

*Pronounced on: 24.02.2026*

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LPA 129/2025, CM APPL. 10551/2025

BOEHRINGER INGELHEIM PHARMA  
GMBH AND CO KG

.....Appellant

Through: Dr. Abhishek Manu Singhvi  
and Mr. Prashanto Chandra Sen, Sr. Advs.  
with Dr Sanjay Kumar, Ms. Arpita  
Sawhney, Ms. Pallavi Kiran, Mr. Arun  
Kumar Jana, Ms. Pratiksha Varshney, Ms.  
Shivangi Mayaramka, Ms. Atiksha Girdhar,  
Mr. Siddhart Seem and Ms. Rashmi  
Goswami, Advs.

versus

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

Through: Ms. Nidhi Raman, CGSC with  
Mr. Arnav Mittal, GP with Mr. Mayank  
Sansanwal, Adv. for R-1  
Mr. G. Nataraj, Mr. Rahul Bhujbal, Mr.  
Yash Raj and Mr. Jegadheesh R., Advs. for  
R-2  
Ms. Swathi Sukumar, Sr. Adv. (*Amicus  
Curiae*)

**CORAM:**

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

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

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**JUDGMENT**

**24.02.2026**

**C. HARI SHANKAR, J.**



2026:DHC:1609-DB



2026:DHC:1609-DB

[Statutory provisions have been reproduced to the extent relevant.]

## A. The *lis*

1. This appeal raises the following two pure questions of law:

(i) Whether a revocation petition, under Section 64<sup>1</sup> of the Patents Act 1970, can be instituted or can survive after the petitioner has pleaded invalidity of the patent, of which revocation is being sought, as a defence under Section 107(1)<sup>2</sup> of the Patents Act, in a suit instituted by the patentee against it?

(ii) Whether a revocation petition can be instituted or can continue after the patent, of which revocation is being sought, has expired?

2. These questions were raised by Boehringer Ingelheim Pharma GMBH<sup>3</sup>, as Respondent 2 in CO (COMM IPD-PAT) 38/2022, instituted by Macleods Pharmaceuticals Limited<sup>4</sup> under Section 64 of the Patents Act.

3. Both questions have been answered in the negative by a learned

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<sup>1</sup> 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,—

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<sup>2</sup> 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.

<sup>3</sup> “Boehringer” hereinafter

<sup>4</sup> “Macleods” hereinafter



2026:DHC:1609-DB



2026:DHC:1609-DB

Single Judge of this Court *vide* judgment dated 15 January 2025.

4. Aggrieved thereby, Boehringer is in appeal.

5. We have heard Dr. Abhishek Manu Singhvi and Mr Prashanto Chandra Sen, learned Senior Counsel for the appellant and Mr. Guruswamy Nataraj, learned Counsel for Macleods, at length. Written submissions have also been filed.

## **B. Facts**

6. Though the dispute is largely fact agnostic, we may briefly advert to the factual backdrop in which the above issues arose.

7. Indian Patent (IN) 243301<sup>5</sup> was granted to Boehringer on 5 October 2022, with a priority date of 21 August 2002, for the pharmaceutical product Linagliptin. On 17 February 2022, CO (COMM. IPD-PAT) 38/2022<sup>6</sup> was filed by Macleods under Section 64(1) of the Patents Act, seeking revocation of IN'301. Two days thereafter, Boehringer filed COMS 3/2022 in the High Court of Himachal Pradesh<sup>7</sup> alleging that Macleods had infringed IN'301 and, therefore, seeking injunctive and other reliefs against Macleods. Macleods, in its written statement in the said suit, pleaded invalidity of IN'301, thereby invoking Section 107(1) of the Patents Act.

8. Boehringer, in these circumstances, filed IA 7635/2024 and

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<sup>5</sup> "IN'301" hereinafter

<sup>6</sup> "the revocation petition" hereinafter

<sup>7</sup> "the Himachal suit" hereinafter



2026:DHC:1609-DB



2026:DHC:1609-DB

46685/2024, seeking dismissal of the revocation petition on different grounds. Both these applications stand dismissed by the impugned judgment.

9. IA 7635/2024 pleaded that, as IN'301 had expired on 18 August 2023 by efflux of time, the revocation petition did not survive for further consideration, as no revocation proceedings could either be instituted or could continue once the patent of which revocation was sought had expired.

10. IA 46685/2024 alleged that, having taken a Section 107 defence in the Himachal suit, Macleods could not continue to maintain a revocation petition.

### **C. Rival stands before the learned Single Judge**

#### **I. Boehringer's stand**

11. With respect to Issue (i), i.e., the maintainability of the revocation proceedings once a Section 107 defence had been taken by Macleods in the Himachal suit, Boehringer submitted that, if the revocation petitions were allowed to be proceeded with, it could result in conflicting judgments in the suit and in the revocation petition which were before two different High Courts, with the suit continuing before the Himachal High Court and the revocation petition being before this Court.

12. Boehringer further submitted that a finding of invalidity of



2026:DHC:1609-DB



2026:DHC:1609-DB

IN'301, whether returned in the Himachal suit or in the revocation petition, would be of equal effect, inasmuch as, in either case, Boehringer would not be able to assert IN'301 thereafter. The finding of invalidity, whether returned in the Himachal suit or in the revocation petition, would operate *in rem*.

13. Keeping this position in mind, Boehringer contended that as the suit proceedings were more comprehensive, where evidence would be led and taken into consideration, and that, therefore, the aspect of invalidity of IN'301 ought to be determined in the suit, rather than in the revocation petition.

14. Apropos Issue (ii), Boehringer contended that a revocation petition was maintainable only at the instance of a “person interested”. Macleods could no longer be regarded as a “person interested” within the meaning of Section 2(1)(t)<sup>8</sup> of the Patents Act once IN'301 had expired by efflux of time. For this proposition, Boehringer relied on the judgment of a learned Single Judge of this Court in *Dr. Reddys Laboratories Ltd v. Controller of Patents*<sup>9</sup>.

## II. Macleod's stand

15. Responding to Boehringer's submissions, Macleods asserted, before the learned Single Judge, that revocation proceedings and proceedings relating to a Section 107 defence raised in a suit, were qualitatively different, with different consequences. A decision on a

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<sup>8</sup> (t) “person interested” includes a person engaged in, or in promoting, research in the same field as that to which the invention relates;

<sup>9</sup> 2022 SCC OnLine Del 1040



2026:DHC:1609-DB



2026:DHC:1609-DB

revocation petition could only be taken by a High Court, whereas a Section 107 defence in a suit could be adjudicated by a District Court. Further, a defendant was not entitled while pleading a Section 107 defence, to seek revocation of the suit patent and could, at best, obtain a declaration of invalidity and that the suit patent was liable to be revoked. In this context, Macleods relied on Section 151<sup>10</sup> of the Patents Act.

16. It was further submitted that a revocation petition, if it succeeded, would result in revocation of the patent in its entirety, as though the patent had never existed on the register of patents. The entire patent would stand removed from the register. As against this, an invalidity defence under Section 107 could be raised qua individual claims asserted in the suit and was not required to embrace the entire suit patent.

17. With respect to Issue (ii), Macleods submitted that Section 64 was a standalone right, which could be asserted with or without the suit and could therefore be raised even after the patent expired. Similarly, expiry of a patent asserted in a suit did not bring the suit to an end, as the cause of action, qua the claim for damages, survived. Thus, the cause of action for filing a revocation petition would also

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<sup>10</sup> 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.

(3) The provisions of sub-sections (1) and (2) shall also apply to the court to which appeals are preferred against decisions of the courts referred to in these sub-sections.



2026:DHC:1609-DB



2026:DHC:1609-DB

survive even after the suit patent had expired.

#### **D. Findings of the learned Single Judge**

**18.** As we have noted earlier, the learned Single Judge has, in the impugned judgment, decided both the issues arising for consideration in the negative.

#### **19. Re: Issue (i)**

**19.1** With respect to Issue (i), the learned Single Judge has proceeded on the following reasoning:

(i) The scope of a revocation petition under Section 64 and of an invalidity defence under Section 107 of the Patents Act, was different.

(ii) Section 64 of the Patents Act permitted a claim for revocation to be raised either as a standalone petition under the said provision or by way of a counter-claim in an infringement suit. A High Court alone could adjudicate on such a claim. On the other hand, Section 104 of the Patents Act also empowered a district court to adjudicate on a Section 107 defence raised in a patent infringement suit. However, if a counter-claim was filed in a patent infringement suit, seeking revocation of the patent, the suit, along with the counter-claim, was required to be transferred to the High Court under Section 104 of the Patents Act.



2026:DHC:1609-DB



2026:DHC:1609-DB

(iii) Section 151 of the Patents Act was clearly illustrative of the difference between a revocation petition under Section 64 and an invalidity defence under Section 107. A revocation petition, if it succeeded, would, by operation of Section 151(1), require the order to be transmitted to the Controller, who would make a suitable entry in the Register of Patents, effacing, from the Register, the patent, as if it had never existed. On the other hand, an invalidity plea raised under Section 107, if it succeeded, would be required to be transmitted to the Controller of Patents under Section 151(2), who would make a suitable entry in the supplemental record, on the basis of which the defendant in the suit could take separate steps under Section 71(1)<sup>11</sup> of the Patents Act for rectification of the Register. A finding of invalidity, which would follow from a successful Section 107 challenge would not, therefore, result in effacing of the suit patent from the Register of Patents.

(iv) This was also clear from the prayers made by Macleods in the Himachal Suit and in the revocation petition. In the Himachal Suit, Macleods prayed for a declaration of invalidity of IN'301, which would render the suit patent liable to be revoked and removed from the Register of Patents. As against this, in the revocation petition, Macleods sought removal of

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<sup>11</sup> 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.



2026:DHC:1609-DB



2026:DHC:1609-DB

IN'301 from the Register of Patents.

(v) Section 58(1)<sup>12</sup> of the Patents Act empowered the High Court, even if it felt that the patent of which revocation was being sought, was invalid, to allow the patentee to amend the complete specifications of the patent to save it from annihilation, instead of revoking the patent. As against this, while dealing with an invalidity defence under Section 107, the Court seized of the suit could not direct amendment of the suit patent or of the claims therein. This, too, served as a point of distinction between a revocation petition and an invalidity defence in a suit.

(vi) A finding in a suit, including a finding on an invalidity plea raised under Section 107, operated *inter partes* and *in personam*. Section 114<sup>13</sup> of the Patents Act empowered the court, even if some of the claims in the suit patent were declared invalid, to grant reliefs on the other claims. On the other hand, if a patent was revoked under Section 64, the decision would

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<sup>12</sup> 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 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.

<sup>13</sup> 114. **Relief for infringement of partially valid specification. –**

(1) If in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the court may grant relief in respect of any valid claim which is infringed:

Provided that the court shall not grant relief except by way of injunction save in the circumstances mentioned in sub-section (2).

(2) Where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the court as to costs and as to the date from which damages or an account of profits should be reckoned, and in exercising such discretion the court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.



2026:DHC:1609-DB



2026:DHC:1609-DB

operate *in rem*, and the patentee would not, thereafter, be able to assert any of the claims in the patent against any party.

**19.2** Predicated on the above reasoning, the learned Single Judge found that taking of a Section 107 invalidity defence would not inhibit the defendant in a suit from pursuing revocation proceedings under Section 64 of the Patents Act.

**19.3** The learned Single Judge did not adjudicate on the plea of possibility of contrasting decisions in the Himachal Suit and in the revocation petition, on the ground that the Supreme Court was seized of this aspect in transfer proceedings pending before it, whereby it had been prayed that the Himachal Suit be transferred to this Court.

**20.** Re: Issue (ii)

**20.1** With respect to Issue (ii), the learned Single Judge reasoned as under:

(i) A revocation petition was maintainable at the instance of a “person interested”. The expression “person interested” was defined in Section 2(1)(t) of the Patents Act. Inasmuch as Macleods was interested in the manufacture and sale of the products patented under IN’301, and was also a defendant in the Himachal Suit instituted by Boehringer against it, Macleods was “a person interested” within the meaning of Section 2(1)(t), and, therefore, also Section 64 of the Patents Act.



2026:DHC:1609-DB



2026:DHC:1609-DB

(ii) The expiry of a suit patent did not bring a suit to an end, as the cause of action in the suit continue to survive qua the claim for damages. Damages had specifically been claimed by Boehringer in the Himachal Suit against Macleods. This claim would survive even after the expiry of IN'301. *Mutatis mutandis*, the revocation petition would also survive.

(iii) If Macleods were to succeed in the revocation proceedings and IN'301 were to be revoked, Boehringer's Himachal Suit would be liable to be dismissed. This also indicated that a valid cause of action survived in favour of Macleods, which it could continue to contest even after IN'301 had expired by efflux of time.

**20.2** The expiry of the suit patent, therefore, it was held, would not have any effect on the revocation proceedings.

**21.** Aggrieved by the aforesaid order, Boehringer is, as we have already noted, in appeal before us.

## **E. Rival contentions of learned Counsel before this Court**

### **I. Submissions of Dr. Abhishek Singhvi**

**22.** Appearing for Boehringer, Dr. Singhvi submits that the very concept of revocation of a patent *ipso facto* presumed that the patent was alive. There could be no question of revoking a patent which had already expired.



2026:DHC:1609-DB



2026:DHC:1609-DB

23. Dr. Singhvi further submits that the maintainability of a revocation petition, after the patent sought to be revoked had expired, could not be gauged on the basis of the consequence which would follow if the petition were allowed, or otherwise. That apart, he submits that a patent merely created a monopoly in the rights which it conferred. While it was alive, the monopoly was with the patent holder and, after it expired, the patented invention was available to the whole world to exploit. The only consequence of a revocation petition being allowed was, therefore, wiping out of this monopoly. Dr. Singhvi submits that there is no decision, or authority, to the effect that the revocation of a patent would date back to its grant.

24. The reliance, by the learned Single Judge, on Section 151 of the Patents Act, submits Dr. Singhvi, is misconceived. Transmission of the order of revocation to the Controller of Patents, after the patent has expired by efflux of time, is akin to flogging a dead horse. He relies on the judgment of the Division Bench of this Court in *Ajay Industrial Corporation v. Shiro Kanao of Ibaraki City*<sup>14</sup> and on the decision of the High Court of Calcutta in *Star Textile Engineering Works Ltd v. James Mackie Holding Ltd*<sup>15</sup>.

25. On the maintainability of the revocation petition after Macleods had pleaded invalidity of IN'301 in the Himachal Suit, Dr. Singhvi relies on the following passage from the decision in *Aloys Wobben v.*

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<sup>14</sup> AIR 1983 Del 496

<sup>15</sup> 1977 SCC OnLine Cal 280



2026:DHC:1609-DB



2026:DHC:1609-DB

***Yogesh Mehra***<sup>16</sup>:

“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.”

In view of the law declared in the above passage, Dr. Singhvi submits that, once a plaintiff files a patent infringement suit, the only options with the defendant is to raise an invalidity defence under Section 107 of the Act or prefer a counter-claim if the defendant seeks revocation of the patent. He cannot continue to maintain a revocation petition under Section 64.

**26.** Adverting to the proceedings in the Himachal suit, Dr. Singhvi submits that the suit was filed on 19 February 2022; the revocation petition was filed by Macleods on the very next day, i.e. 20 February 2022; *ad interim* injunction in favour of Boehringer was granted in the suit on 25 February 2022, which was made absolute on 21 April 2022, and the appeal thereagainst, preferred by Macleods, was dismissed by the High Court on 12 March 2024. In these circumstances, Dr. Singhvi

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<sup>16</sup> (2014) 15 SCC 360



2026:DHC:1609-DB



2026:DHC:1609-DB

submits that Macleods would, if it so chooses, have to prefer a counter-claim in the Himachal suit, and allowing it to pursue the revocation petition would merely result in multiplicity of litigation.

27. Both issues, therefore, submits Dr. Singhvi, have been wrongly decided by the learned Single Judge.

## II. Submissions of Mr. Prashanto Chandra Sen

28. Supplementing the submissions of Dr. Singhvi, Mr. Prashanto Chandra Sen submits that a Section 107 defence is essentially in the nature of a counter-claim. He relies, for the purpose, on the judgment of a learned Single Judge of this Court in *Unilin Beheer B.V. v. Balaji Action Buildwell*<sup>17</sup>. He further cites para 19 of *Aloys Wobben* and paras 26 and 28 of *Ramesh Chand Ardawatiya v. Anil Panjwani*<sup>18</sup>.

29. Mr. Sen further placed reliance on Section 2(o)<sup>19</sup>, read with Section 53(4)<sup>20</sup>, of the Patents Act.

## III. Submissions of Mr. Guruswamy Nataraj

30. Mr. Guruswamy Nataraj commences his submissions by pointing out that Section 64 uses the expression “a patent”, and not a “patent in force”. Had the legislature desired to use the latter

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<sup>17</sup> (2018) 76 PTC 194

<sup>18</sup> (2003) 7 SCC 350

<sup>19</sup> (o) “patented article” and “patented process” mean respectively an article or process in respect of which a patent is in force;

<sup>20</sup> (4) Notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on expiry of the term of patent, the subject-matter covered by the said patent shall not be entitled to any protection.



2026:DHC:1609-DB



2026:DHC:1609-DB

expression, submits Mr. Nataraj, it would have done so. Court, he submits, cannot supply *casus omissus*.

**31.** Mr. Nataraj further submits that the conflation between a Section 107 defence, a counter-claim, and a revocation proceeding, which learned Senior Counsel for the appellant attempts, is completely unsustainable in law. He submits that a revocation proceeding under Section 64, and a counter-claim, are paths to revocation. A Section 107 defence, on the other hand, even if it succeeds, does not result in revocation of the patent. The effect of revocation, he submits, is effacement of the patent *ab initio*, as if it were never granted. The legal effect, however, would persist, and a plaintiff may still be entitled to damages.

**32.** In the present case, submits Mr. Nataraj, as Boehringer is, in its Himachal suit against Macleods, also pressing for account of profits, Macleods cannot be disentitled from prosecuting its revocation petition.

**33.** The right to seek revocation of a patent under Section 64, submits Mr Nataraj, is a standalone remedy, which can be exercised at any time. The Patents Act does not engraft any restriction in this regard. A prayer seeking revocation of a patent can, therefore, be preferred either as a counter-claim or as a standalone revocation petition, whether before or after the expiry of the patent.

**34.** Mr. Nataraj seeks to point out that sub-sections (1) and (2) of Section 151 also emphasize the distinction between revocation and a



2026:DHC:1609-DB



2026:DHC:1609-DB

Section 107 defence. Success in a revocation proceeding would require the decision to be transmitted to the Controller of Patents, who would make an entry thereof in the Register of Patents. On the other hand, success in a Section 107 invalidity defence would only obligate the Court to transmit a copy of its decision to the Controller who would make an entry in that regard *in a supplemental record*. The result of success in a Section 107 invalidity defence would, therefore, at best be declaratory, and would not revoke the patent itself. The entry of the patent in the Register of Patents would, therefore, continue to remain, inviolate. Mr. Nataraj has also relied, in this context, on paras 284 to 291 of the Ayyangar Committee Report which preceded the amendment of the Patents Act, which read thus:

“284. The proceedings in relation to patents yet to be considered are: (1) Suits for infringement (clause 58 of the Bill). (2) Suits for a declaration as to non-infringement (clause 57). (3) Suits complaining of groundless threats of infringement proceedings (clause 66).

285. Section 29 of the Indian Patents & Designs Act, 1911, enables a patentee to institute a suit in a District Court having jurisdiction to try the suit against any person who has infringed his right with a proviso that where the defendant counter-claims for revocation the suit along with the counter-claim should stand transferred to the High Court for decision. Clause 58 of the Bill reproduces in substance the above provisions in section 29 of the Act.

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287. The existence of this defence raises questions as to the manner in which possible differences between different Courts as to the validity or invalidity of the claims of a patent should be resolved. To make my meaning clear I would add this. A patent might be infringed by more persons than one and if these infringers reside in or carry on business or commit the act of infringement in different areas of the country, the several suits for infringement would have to be filed in District Courts in different States. The defence regarding the invalidity of the patent might be raised in



2026:DHC:1609-DB



2026:DHC:1609-DB

more than one Court and these Courts might decide differently the point about the validity of the patent. In the United Kingdom this problem of conflicting decisions does not arise because all suits for infringement have to be filed in the High Court.

288. In the case of Trade Marks where conflicts of decisions of this type also arise, I recommended the procedure of having the suits for infringement in which the validity of the registration of the mark was raised, stayed and requiring the person raising the point of invalidity of the registration to move the competent High Court for the rectification of the Register. I do not think it is necessary to adopt such a procedure in the case of suits for infringement of patents. The number of such suits would be so few that such a complicated procedure is not called for.

289. In its place I would recommend the following. A suit for infringement may be filed in any court not inferior to a District Court which has territorial jurisdiction under the Civil Procedure Code to entertain it. All defences including those based on the invalidity of the patent would be gone into by that Court and by the appellate Courts if appeals were filed. But any finding by the Court that the patent or any claim therein was invalid would not have any effect on the patent as such and would not lead to the revocation of the patent. In other words, the decision in the suit would be merely one inter-partes operating between them by way of *res judicata* and not one in technical phraseology “in rem” affecting the patent itself.

### **Revocation proceedings only before High Court having jurisdiction**

290. If any person interested were desirous of obtaining an adjudication which would, if successful, have an effect on the patent itself and beyond the immediate parties to that proceeding, he should file a petition for revocation of the patent, and the forum for this proceeding would be exclusively the High Court having territorial jurisdiction over the office where the patent is registered. If the petition succeeds, and the patent is held invalid, then subject to the result of any appeal preferred against such a decision, the patent would be revoked and an entry to that effect would be made in the Register of Patents. It is needless to add that where the Court dismisses the petition for revocation, there would be no legal bar against other persons interested in initiating fresh proceedings for revocation, though, save in exceptional circumstances, the chances of such a petition succeeding, particularly since the later proceeding also would be in the same High Court, would be very remote.



2026:DHC:1609-DB



2026:DHC:1609-DB

### **“Supplemental Record” for entries of decisions as to validity in infringement**

291. I have referred to the fact that when a petition for revocation succeeds, appropriate entries would be made in the Register of Patents. It is now necessary to mention what should happen in cases where a Court pronounces against the validity of a patent in a suit for Infringement. The decision of the trial court might be taken up in appeal to a High Court, or the suit itself might be tried in a High Court, and it is therefore proper that some record should be made of this finding for the information of other persons interested in the patented invention. I would recommend the opening of a “supplemental record” and entries being made in such record of the result of proceedings, which, though of importance in relation to the validity of a patent grant, do not legally affect the patent itself. The patent may be the subject of sale, or of licensing and it would be of the utmost importance to the prospective purchase or licensee to be informed of what any court has pronounced regarding the validity or invalidity of the claims in a patent.”

**35.** Mr. Nataraj submits that the expiry of a patent does not efface the right of the patentee to claim damages, under Section 108<sup>21</sup> of the Patents Act, for infringement which took place during the life of the patent. This right also stands recognized by Section 48<sup>22</sup> of the Patents Act.

**36.** Mr. Nataraj has also placed reliance on paras 25 to 27 of the judgment of the Supreme Court in *Aloys Wobben* and the decision of

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<sup>21</sup> 108. **Reliefs in suits for infringement.** –

(1) The reliefs which a court may grant in any suit for infringement include an injunction (subject to such terms, if any, as the court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.

(2) The court may also order that the goods which are found to be infringing and materials and implements, the predominant use of which is in the creation of infringing goods shall be seized, forfeited or destroyed, as the court deems fit under the circumstances of the case without payment of any compensation.

<sup>22</sup> 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:



2026:DHC:1609-DB



2026:DHC:1609-DB

a Division Bench of this Court in *Ajay Industrial Corporation*.

37. Mr. Nataraj points out that removal of a patent from the Register of Patents is governed by a separate provision, viz., Section 71<sup>23</sup>.

38. Mr. Nataraj further relies on the definition of “patent” in the Patents Act, which means “a patent for any invention granted under this Act”. Mr. Nataraj emphasizes the word “granted”. He submits that, once granted, a patent remains a patent till it is revoked. The word “patent” in Section 64, he submits, has to be understood in the light of the definition of “patent” in the Patents Act. It cannot be read as a patent *in force*. He also relies, in this context, on the definition of “revoke” in Black’s Law Dictionary Revised Fourth Edition, which reads “to annul or make void by recalling or taking back, cancel, rescind, repeal, reverse” and in P. Ramanatha Aiyar’s Advanced Law Lexicon 7<sup>th</sup> Edn, which reads “an act of recalling or calling back, the act by which one having the right annuls something previously done”.

39. The reliance, by Mr. Sen, on Section 53(4) of the Patents Act is, according to Mr. Nataraj, misplaced. Section 53(4) only impacts the *patentee’s right to sue*, and has no effect on Macleod’s right to maintain the revocation petition.

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<sup>23</sup> 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.



2026:DHC:1609-DB



2026:DHC:1609-DB

40. Mr. Nataraj submits that, before any infringement suit is filed, a revocation petition under Section 64 would in any case be maintainable. After an infringement suit has been filed, the defendant can raise a Section 107 invalidity defence *and* seek revocation of the patent *either* via a revocation petition under Section 64 *or* by way of a counter-claim, though a revocation petition and a counter-claim *cannot simultaneously* be maintained, as held in *Aloys Wobben*.

41. Adverting to *Aloys Wobben*, Mr. Nataraj submits that the decision is being cited entirely out of context, and that para 26 thereof, which Dr. Singhvi and Mr. Sen rely on, is not even its *ratio decidendi*. He submits that *Aloys Wobben* involved an instance of a revocation petition and counter-claim having been filed before two different fora; the former before the IPAB and the latter before the High Court. Even after the IPAB had invalidated certain patents, the revocation petitioner continued to file counter-claims, seeking revocation of the same patents, in infringement suit. It was in these circumstances that the Supreme Court held that the counter-claim could not be pursued. Macleods, on the other hand, had only raised a Section 107 invalidity defence and had not preferred any counter-claim.

42. Mr. Nataraj submits, if the arguments of the appellant were to be accepted, a counter-claim would also perish with the expiry of the patent. He seeks to distinguish *Ramesh Chand Ardawatiya* on the ground that the issue in controversy in the present case is governed by Section 64 and its interpretation. In *Unilin*, he points out that this Court granted liberty to file a revocation petition, which means that the patent remains on the register even after its expiry.



2026:DHC:1609-DB



2026:DHC:1609-DB

43. Finally, Mr. Nataraj submits that, even after an invalidity defence succeeds, the patentee-plaintiff can seek to amend the invalid claims under Section 58 or 59 of the Patents Act, or seek a validity certificate under Section 113. Thereafter, the claim would again be open to assertion. As against this, a revocation action, if it succeeds, eviscerates the patent entirely, and it cannot be revived in any manner and to any extent.

IV. Submissions of Ms. Swathi Sukumar, learned *amicus curiae*

44. Ms. Swathi Sumar, learned Senior Counsel, who ably assisted us at our request as *amicus*, submitted that the Patents Act provides for a challenge to be laid to the validity of a patent, and for the patentee to repel the challenge, in a pre-grant opposition, post-grant opposition, revocation, a Section 107 invalidity defence, a declaration of non-infringement as well as compulsory licensing. Each, she submits, is distinct and different. She draws attention to paras 37 and 44 of the Ayyangar Committee Report, which read:

“37. In the present decade under the impact of the national plans that have been formulated for the economic uplift of the country and the raising of the standard of living of its people, the conservation of foreign exchange is a matter of prime importance. In the context of this need, it would be seen that any increase in the price of the patented products imported into the country must to that extent be a disadvantage to the nation's economy. This apart, there is also the factor that by reason of these patents, our country is deprived of the benefits of importing from that country, payment in whose currency would be the least burdensome to India. Due to the existence of the grants, this country has no choice as regards the currency to be paid for the importation because this depends not on our choice but on the location of the patentee's manufactory



2026:DHC:1609-DB



2026:DHC:1609-DB

or the country from which the patentee chooses to import for sale in India.

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### **What changes are necessary in the Indian law**

44. The precise provisions of the Patent law, however, have to be designed, with special reference to the economic conditions of the country, the state of its scientific and technological advance, its future needs and other relevant factors and so as to minimise if not to eliminate the abuses to which a system of patent monopoly is capable of being put.”

45. Ms. Sukumar endorses Mr. Nataraj’s submission that, as an infringement suit, qua the claim for damages therein, would not lapse even after expiry of the patent, the issue of revocation continues to retain significance. In any event, she submits that Section 64 uses the expression “person interested”. It is not, therefore, open ended, and can be maintained only by such a person. So long as the applicant seeking revocation of the patent remains a “person interested”, Ms. Sukumar submits that the revocation action would be maintainable.

46. To support her submissions, Ms. Sukumar places reliance on para 21 of *Aloys Wobben*, para 15 of *Girdhari Lal Gupta v. K. Gian Chand Jain*<sup>24</sup> and various paragraphs from *Ajay Industrial Corporation*. She also relies on Section 108 of the Patents Act, which provides for the reliefs available in a case of infringement.

### **V. Submissions of Mr. Prashanto Chandra Sen in rejoinder**

47. Arguing in rejoinder, Mr. Prashanto Chandra Sen submits that the concept of a “person interested” is dynamic, and that no person

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<sup>24</sup> AIR 1978 Del 146



2026:DHC:1609-DB



2026:DHC:1609-DB

can continue to be interested in a revocation proceeding once the patent of which revocation is sought has itself expired by efflux of time. Once the corpus of the interest does not subsist, he submits, the interest must also perish. He relies on paras 10 to 12 of the decision of a learned Single Judge of this Court in *Dr Reddys Laboratories*.

48. Mr. Sen responds to Mr. Nataraj's emphasis on the word "granted" in the definition of "patent" as contained in Section 2(o) of the Patents Act by submitting that the grant would subsist only so long as the patent is alive. The grant is, therefore, limited; not unlimited. He relies, for this purpose, on para 17 of *Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries*<sup>25</sup>, which specifically says so.

49. Mr. Sen concludes his submissions by referring to para 10 of *Ajay Industrial Corporation* and para 9 of the judgment of the Supreme Court in *Ibrahim Bachu Bafan v. State of Gujarat*<sup>26</sup>.

## F. Analysis

### I. Section 64 - Revocation acts retrospectively - Definition of "patent" – "Person interested"

50. Section 64 states that *a patent* may be *revoked* on a petition of any *person interested* or of the Central Government, *or on a counter-claim* in an infringement suit. The pivotal words are, to our mind, "patent", "revoked", "person interested" and "or on a counter-claim".

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<sup>25</sup> (1979) 2 SCC 511

<sup>26</sup> (1985) 2 SCC 24



2026:DHC:1609-DB



2026:DHC:1609-DB

**51.** We deem it appropriate, first, to address the expression “revoked”. A major point of controversy, among learned Counsel, is whether “revocation” of a patent under Section 64 would invalidate the very grant, i.e., whether it would operate retrospectively from the date of grant, or prospectively from the date of revocation. Mr. Nataraj and Ms. Sukumar assert the former, whereas Dr. Singhvi and Mr. Sen submit that there is no legal basis for the proposition that revocation would date back.

**52.** Unfortunately, the Patents Act does not directly address this issue, or throw any direct light thereon. However, it is not entirely silent on the issue, and an answer to the poser, to our mind, is available even in Section 64 itself.

**53.** Having addressed ourselves to this issue, we are of the view that the submission of Mr. Nataraj and Ms. Sukumar deserves to be accepted. We say so for various reasons.

**54.** Firstly, Section 64 states that a patent may “be revoked on a petition of any person interested or the Central Government or on a counter-claim in a suit for infringement of the patent by the High Court”. A petition for revocation and a counter-claim in an infringement suit which already stands instituted, are therefore, at par, as both are governed by Section 64. Section 64 clearly envisages success in both to result in the same legal consequence, i.e. revocation of the patent. This is expressed from the words of the provision. It clearly states that a granted patent may be revoked either by a revocation petition or by a counter-claim in an instituted suit.



2026:DHC:1609-DB



2026:DHC:1609-DB

**55.** As Section 64 envisages revocation of a granted patent to be permissible as much by a revocation petition as by a counter-claim in an instituted suit, the consequences of either action have to be the same. A counter-claim in an instituted suit would invariably seek a declaration that the grant of the patent is itself invalid as, else, there would be no advantage in filing any such counter-claim at all. The assertion of infringement in an instituted suit, is also the claim for damages on the basis of such infringement, would invariably be prior to the date of institution of the suit, after the patent has been granted. Any counter-claim, filed to question the claim of the plaintiff would, therefore, invariably have to seek a declaration of invalidity of the suit patent *ab initio*.

**56.** Inasmuch as Section 64 envisages the consequence of revocation petition and of a counter-claim in an instituted suit being the same, i.e. revocation of the patent, the revocation would, in either case, invalidate the very grant of the patent and would date back to the date of grant. Hence, it would run counter to the intent of the legislature in envisaging a revocation petition and a counter-claim in an infringement suit as both being avenues for obtaining revocation of the patent under Section 64.

**57.** As a defendant in an infringement suit, therefore, *apart from* raising a Section 107 invalidity defence, the defendant can seek revocation of the patent *either* by a counter-claim seeking a declaration to that effect *or* by way of a revocation petition, *but not both*. Both would lie under Section 64.



2026:DHC:1609-DB



2026:DHC:1609-DB

**58.** Secondly, without proceeding ground-by-ground, a glance at the grounds on which revocation of a patent may be sought under Section 64, with the preceding provisions in the Patents Act governing grant of a patent, reveal that the grounds on which revocation can be sought, if found to be justified, but invariably indicate that the very grant of the patent was invalid. To wit, a patent cannot be granted if the claim in the patent has been claimed in an earlier granted patent of earlier priority date; or if the applicant is not entitled to apply for the patent; or if the claim does not relate to any invention within the meaning of the Patents Act; or if the invention is obvious from prior art; or if the invention lacks novelty and any inventive step; or if the invention is not useful; or if the complete specification in the application does not sufficiently and fairly describe the invention and the method by which it is to be performed; or if the scope of the claim is not clearly and sufficiently defined in the complete specification; or if there is any misrepresentation or falsity in the application; or if the subject of the claim is not patentable under the Patents Act; or if the invention was secretly used in India before the priority date of the claim; or if information as required by Section 8 of the Patents Act is not disclosed; or if any direction for secrecy passed under Section 35 is contravened by the applicant; or if leave to amend the complete specification was obtained by fraud; or if the complete specification does not correctly disclose the source or geographical origin of biological material used in the invention. If a granted patent is found to be invalid on any of these grounds, it would mean that the very grant of the patent was invalid. Even for this reason, therefore, the revocation of a granted patent under Section 64 has to date back to the



2026:DHC:1609-DB



2026:DHC:1609-DB

date when the patent was granted.

59. Thirdly, this view of ours is also supported by judicial authority, albeit largely from foreign jurisdictions. The only judgment from an Indian court which seems to speak on the issue is by a learned Single Judge of the High Court of Calcutta in *Star Textile Engineering Works* which, in para 12, merely records the submission of learned Counsel before the Court, premised on the decision in *North Eastern Marine Engineering Co. Ltd v. Leeds Forge Co. Ltd*<sup>27</sup>, that “though the patent has expired there is no bar for the Court revoking the same”. It does not appear, however, that the High Court independently addressed itself to the correctness of this proposition.

60. We are, however, supported, in our view, by the judgment of the UK Supreme Court in *Virgin Atlantic Airways Ltd v. Zodiac Seats UK Ltd*<sup>28</sup>. Before advertent to the said decision, however, it is necessary to refer to the provisions of the patent law governing UK at the time when the decision was rendered.

61. *Virgin Atlantic Airways* dealt with “a “European Patent (UK)”<sup>29</sup>, i.e. one which is granted for the United Kingdom or for states including the United Kingdom”.<sup>30</sup> Para 4 of the decision clearly states that, as per Section 77(1) of the UK Patents Act, 1977<sup>31</sup>, a European Patent (UK) “is to be treated as if it were a patent granted under the Act”. European Patents (UK) and UK Patents, thereby, stand equated

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<sup>27</sup> 23 RPC 96

<sup>28</sup> [2009] EWCA Civ 1062

<sup>29</sup> “the UK Patent” hereinafter

<sup>30</sup> Refer para 4 of *Virgin Atlantic*

<sup>31</sup> “the UKPA” hereinafter



2026:DHC:1609-DB



2026:DHC:1609-DB

under the UK Patents Act. In this backdrop, Article 68 of the European Patent Convention<sup>32</sup> is significant. It reads thus:

**“Effect of revocation or limitation of the European patent**

The European patent application and the resulting European patent shall be deemed *not to have had, from the outset*, the effects specified in articles 64 and 67, to the extent that the patent has been revoked or limited in opposition, limitation or revocation proceedings.”

Thus, revocation of a European patent operates, under the EPC, *ab initio*, i.e. the patent stands revoked from the date of grant.

**62.** Section 72 of the UKPA deals with revocation of UK patents. Though Section 72 does not state that revocation would operate retrospectively from the date of grant of the patent, Section 130(7)<sup>33</sup> of the UKPA provides that Section 72(1) and (2) of the UKPA would have, as nearly as practicable, the same effects in the UK as the corresponding provisions of the EPC. This would, therefore, make the stipulation, regarding retrospective revocation of a European patent under the EPC, provided in Article 68 of the EPC, *mutatis mutandis* applicable to revocation of a UK patent under the UKPA.

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<sup>32</sup> “the EPC” hereinafter

<sup>33</sup> **130. Interpretation.**

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(7) Whereas by a resolution made on the signature of the Community Patent Convention the governments of the member states of the European Economic Community resolved to adjust their laws relating to patents so as (among other things) to bring those laws into conformity with the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty, it is hereby declared that the following provisions of this Act, that is to say, sections 1(1) to (4), 2 to 6, 14(3), (5) and (6), 37(5), 54, 60, 69, 72(1) and (2), 74(4), 82, 83, . . . 100 and 125, are so framed as to have, as nearly as practicable, the same effects in the United Kingdom as the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty have in the territories to which those Conventions apply.



2026:DHC:1609-DB



2026:DHC:1609-DB

63. In this backdrop, the following passages from *Virgin Atlantic Airways* makes for instructive reading:

(per Lord Sumption)

“28. How then did the Court of Appeal come to a different conclusion? The answer is that they followed a line of cases culminating in the decision of the Court of Appeal in *Unilin Beheer BV v Berry Floor NV* [2007] FSR 635, which had held that a patentee whose patent has been held to be valid is entitled to claim damages for its infringement without regard to a subsequent revocation of the patent. This has been held to be so, even though it has always been the law in England (as it is under the European Patent Convention) that the revocation of a patent for invalidity relates back to the date of grant: see, currently, section 75(3) of the Patents Act 1977.

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32. ....The revocation of the patent was an act in rem which determined the status of the patent as against the world. It had been revoked by the authority which had granted it and must be treated as never having existed. Although the patent had been revoked on the ground of invalidity, the issue which the defendant wished to raise on the enquiry was not invalidity but revocation. The revocation would be decisive regardless of the ground on which it was ordered.”

(per Lord Neuberger)

“49. The essential point is that, although the decision to revoke the patent was indeed made in proceedings involving different parties, the effect of the Patents Act 1977 (and its statutory predecessors) (“the Patents Act”) and the European Patent Convention (“the EPC”) whose relevant provisions are set out in paras 3-7 of Lord Sumption’s judgment, was that the revocation did not just have effect between those parties. The revocation of the patent deprived the patentee of the rights which the patent had bestowed on him as against the world; furthermore, it did so retrospectively. In other words, the effect of the revocation was that everyone was entitled to conduct their affairs as if the patent had never existed.

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2026:DHC:1609-DB



2026:DHC:1609-DB

51. In *Poulton*<sup>34</sup> and the cases which followed it, the Court of Appeal failed to focus on the point that the effect of the Patents Act was that the revocation meant that, as against the world, the patentee had never had a valid patent.

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58. The policy of the Patents Act is that valid patents are enforceable against the world, even if an infringer is honestly and reasonably unaware of the existence of the patent. Equally, if a patent is revoked (or amended), the policy is that the revocation (or amendment) takes effect retrospectively, and that this can be relied on by the world. I find it hard to see why someone who has failed in an attack on the patent should not be entitled, like anyone else, to rely on the points that the patent has been revoked (or amended), and that the revocation (or amendment) is retrospective in its effect, whether in legal proceedings or in another context.

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61. So far as the interests of patentees are concerned, it is inherent in the grant of a patent under the Patents Act that, however often its validity may be unsuccessfully challenged in earlier litigation, it may none the less be revoked (or amended), and with retrospective effect, at some point by a court or by the EPO.”

64. In view of the fact that a conjoint and juxtaposed reading of the provisions of the UKPA, cited *supra*, reveals the statutory position in the UK, with respect to revocation of patents, to be similar to that which exists under the Patents Act, we may usefully rely on the aforesaid decision of the UK Supreme Court in *Virgin Atlantic Airways* to support our conclusion that revocation acts *in rem* and retrospectively from the date of grant.

65. Patent rights are often trans-national in nature. It is rarely that patents are restricted to a country alone, and most patents have their genesis in one location before individual patents are taken in different

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<sup>34</sup> *Poulton v. Adjustable Cover and Boiler Block Co.*, [1908] 2 Ch 430



2026:DHC:1609-DB



2026:DHC:1609-DB

countries. This itself requires the Court, administering justice in patent litigations, to stay abreast of, and if possible remain in sync with, international legal practices. Of course, this would always be subject to the international legal practice not being contrary to municipal law applicable in, in our case, India. So long as applicable of internationally accepted legal principles, practice and procedure, in patent matters, does not conflict with Indian law, Courts should have no hesitation in applying them.

66. We, therefore, feel no hesitation in applying, to our jurisdiction, the law declared in *Virgin Atlantic Airways*.

67. We next turn to the definition of “patent”, as contained in the Patents Act. Section 2(m) defines a “patent” as meaning “a patent for any invention granted under this Act”. A patent, once granted, therefore, remains a “patent” under the Patents Act, and does not cease to remain a patent which was granted, even if it expires by efflux of time. The expiry of the life of the patent merely renders it unenforceable, and does not denude it of its character as a “patent granted under” the Patents Act.

68. Applying, to the word “patent” in Section 64(1), therefore, the definition of “patent” in Section 2(m), a patent remains a patent for the purposes of Section 64(1), even after it expires.

69. In so far as the expression “person interested” in Section 64(1) is concerned, we do not deem it necessary to enter deeply into the etymological niceties of the expression, for the simple reason that



2026:DHC:1609-DB



2026:DHC:1609-DB

Boehringer has itself filed the Himachal suit against Macleods. In view of our finding that Macleods' revocation, if it succeeds, would invalidate Boehringer's patent in the suit from inception, so that Boehringer would not be able to seek either injunction or damages, it is obvious that Macleods has a real and live interest in seeing that its revocation petition succeeds. Macleods is, therefore, *ex facie* a "person interested" within the meaning of Section 64(1).

70. These findings, in fact, should by themselves be dispositive of the issue of whether a revocation proceeding can survive expiry of the patent of which revocation is sought. Section 64 does not state otherwise. Revocation, if granted, takes effect from the grant of the patent being revoked. It is, therefore, rendered ineffective and incapable of assertion *ab initio*. The interest of the revocation petitioner, to ensure that the revocation succeeds, therefore, subsists, and he remains a "person interested".

71. Ergo, and per sequitur, the revocation petition would continue to be maintainable even after the patent, of which revocation is sought, expires.

72. The expiry of a patent, during the pendency of an infringement suit, therefore merely changes the goal post. The remedy of injunction, for the plaintiff, is lost, and the defendant, too, can rest easy on that score. However, the plaintiff still retains the right to claim damages for infringement which took place during the life of the patent, and the defendant, too, therefore, has every right to, by way of a counter-claim or a revocation petition as he may choose, seek



2026:DHC:1609-DB



2026:DHC:1609-DB

revocation of the patent *ab initio*.

## II. The decision in *Aloys Wobben*

73. Both sides have relied on the judgment of the Supreme Court in *Aloys Wobben*. It becomes necessary, therefore, to examine the said decision.

74. Dr. Singhvi and Mr. Sen have sought to contend that a revocation petition could not be preferred after an infringement suit had been filed. From this, it is also sought to be inferred that a revocation petition, preferred prior to the institution of the suit, cannot continue after the suit has been instituted or, at any rate, after the patent of which revocation is sought has expired. This submission, however, to our mind, selectively relies on the following sentence from para 26 of report in *Aloys Wobben*:

“.....As such, “revocation petitions” filed later in point of time than the institution of the “infringement suit”, would be unsustainable in law.....”

75. We feel, with greatest respect to learned Senior Counsel, that the sentence has been read out of context.

76. To the extent relevant, the facts in *Aloys Wobben* may be noted thus. Aloys Wobben was a scientist-engineer and inventor. He filed ten patent infringement suits, alleging that inventions patented in his name had been infringed by, amongst others, Enercon India Ltd<sup>35</sup>,

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<sup>35</sup> “Enercon” hereinafter



2026:DHC:1609-DB



2026:DHC:1609-DB

before this Court. Subsequent thereto, Enercon filed a counter-claim, seeking revocation of the Aloys Wobben's patent. Enercon also filed twenty three revocation petitions before the IPAB, praying for revocation of the patents. The prayers in the revocation petitions and the counter claim were identical, i.e. that the patent be revoked.

77. Despite some of the revocation petitions having been settled by the IPAB, Enercon continued to prosecute its counter-claim in respect of the same patents. This was the position which was before the Supreme Court when it came to render its decision.

78. After extracting the relevant provisions, the Supreme Court referred to Section 64 of the Patents Act and noted that it commences with the words "subject to the provisions contained in this Act". In other words, Section 64 was subservient to all other provisions in the Patents Act. The Supreme Court held, therefore, if there was any provision in the Patents Act *in conflict with the mandate contained in Section 64*, Section 64 would stand eclipsed and the other provisions would govern. Para 18 of the report in *Aloys Wobben*, which sets out this legal position, may be reproduced as under:

"18. Having heard the learned counsel, and having examined the different provisions of the Patents Act relating to revocation of patents, we shall now endeavour to examine the controversy in hand. In our considered view, Section 64 of the Patents Act needs a close examination. Section 64 aforementioned, is prefaced by the words "Subject to the provisions contained in this Act,...". And not by the words, "Without prejudice to the provisions contained in this Act ...", or "Notwithstanding the provisions contained in this Act ...". The words with which the legislature has prefaced Section 64, necessarily lead to the inference, that the provisions contained in Section 64 are subservient to all the other provisions contained in the Patents Act. This exordium to Section 64 of the Patents Act



2026:DHC:1609-DB



2026:DHC:1609-DB

mandates that the directive contained in Section 64 would be subservient and deferential to the other provisions of the Patents Act. *Stated simply, if there is any provision under the Patents Act, which is in conflict with the mandate contained in Section 64, Section 64 of the Patents Act would stand eclipsed*, and the other provision(s) would govern the field under reference. Therefore, no interpretation can be placed on Section 64 of the Patents Act which will be in conflict with any other provision(s) of the Patents Act.”

(Emphasis supplied)

**79.** Section 64, therefore, “stands eclipsed” only if it is *in conflict with* some other provision of the Patents Act.

**80.** In para 20 of the report, the Supreme Court noted that the defendant in a patent infringement suit could raise a counter-claim, questioning the validity of the asserted patent under Section 64. Thus, Section 64 provided two remedies, one by way of a revocation petition and the other by way of a counter-claim. In para 23 of the report, the Supreme Court held that the use of the disjunctive “or” in Section 64 disentitled a defendant from filing *both* the proceedings for the same purpose simultaneously. In the case before it, the Supreme Court noted that Enercon had in fact availed both the remedies, and that the issue to be considered was, therefore, the remedy which Enercon should be permitted to pursue. Paras 25, 26 and 27.2 of the report in *Aloys Wobben* set out the legal position, thus:

“25. ....Therefore, where an issue is already pending adjudication between the same parties in a court having jurisdiction to adjudicate upon the same, a subsequently instituted suit on the same issue between the same parties cannot be allowed to proceed. A similar question arises for consideration before this Court in the present controversy. *If the respondents in their capacity as “any person interested”, had filed a “revocation petition” before the institution of an “infringement suit”, they cannot be permitted to file a “counterclaim” on the same cause of action.* The natural conclusion in the above situation would be, the validity of the grant



2026:DHC:1609-DB



2026:DHC:1609-DB

of the patent would have to be determined in the “revocation petition”. Therefore, *in the above situation, while the “revocation petition” will have to be permitted to be pursued, the “counterclaim” cannot be permitted to be continued.* Therefore, in the above eventuality, it is apparent that the situation would be resolved in the same manner as it would have been resolved in cross-suits filed by the rival parties before different jurisdictional courts. In our considered view, the above conclusion is imperative for a harmonious interpretation of the relevant provisions of the Patents Act.

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.*

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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.”

(Emphasis supplied)

**81.** Thus, the Supreme Court has, in para 25 of *Aloys Wobben*, held that, if a defendant, before the institution of the infringement suit, has



2026:DHC:1609-DB



2026:DHC:1609-DB

already preferred a revocation petition seeking revocation of the suit patent, it could not be permitted to file a counter-claim in the infringement suit, as the invalidity of the suit patent would then have to be tested in the revocation proceedings.

**82.** In para 26 of the report, the Supreme Court has addressed a situation in which the defendant in the suit has filed a counter-claim therein. In such a situation, the Supreme Court holds that it would not be open to the defendant thereafter to file a revocation petition, as the remedy sought in the counter-claim in the revocation petition is the same and the revocation petition would be barred by *res judicata*.

**83.** It is in this context that, in para 26, it is held that the revocation petition would not be maintainable. Mr. Nataraj is correct in his emphasis on the words “as such” in para 26, which clearly link the observations which follow to all these which precede the expression. The observation that a revocation petition cannot be filed after an infringement suit has been instituted is, therefore, clearly not stated as an absolute proposition in para 26, but only if the defendant has already filed a counter-claim in the said suit.

**84.** Para 27.2 of the report in *Aloys Wobben* deals with a situation in which the revocation petition is filed prior to the institution of the suit. In such a situation, as the same relief would be claimed in the counter-claim, the Supreme Court has held that the defendant cannot, after institution of the suit, prefer a counter-claim.

**85.** *Aloys Wobben*, therefore, does not address either the issue of



2026:DHC:1609-DB



2026:DHC:1609-DB

whether a revocation petition can survive the expiry of the patent of which it seeks revocation, or whether a revocation petition can be filed after a Section 107 invalidity defence is taken by the defendant in the infringement suit. The decision is, therefore, of no substantial significance, in the facts of the present case.

III. Whether a revocation can be instituted, or can continue, after a Section 107 invalidity defence is taken in an infringement suit

**86.** This issue, though really a no brainer, is partly answered by the observations and findings *supra*, as well as the decision of the Supreme Court in *Aloys Wobben*. *Aloys Wobben*, we may note at the cost of repetition, clearly holds that revocation of the plaintiff's patent can, *prior to the institution of an infringement suit*, be sought by way of a revocation petition, and, *after the institution the infringement suit*, by way *either* of a revocation petition *or* of a counter-claim, *but not both*. *Neither* does *Aloys Wobben* say that a revocation petition *cannot* be filed after the infringement suit is instituted (as we have already held hereinabove), *nor* does it say that a Section 107 invalidity defence cannot simultaneously accompany a revocation petition, or a counter-claim.

**87.** The issue, as raised by the appellant is, in fact, hardly an issue at all. Revocation, and an invalidity defence under Section 107, are fundamentally – and *obviously* – different. Revocation can, per Section 64, be sought by way of a counter-claim. It would be unknown to all principles of civil law and procedure to urge that a defence taken in a written statement can, in any way, restrict the right



2026:DHC:1609-DB



2026:DHC:1609-DB

of the defendant to independently file a counter-claim. And, if the defendant can file a counter-claim, it can, equally, file, *instead*, a revocation petition for the same relief, *but not both simultaneously*. The right to file a revocation petition can, therefore, *never* be impacted by the right to plead invalidity of the suit patent under Section 107, *as a defence* to the infringement action.

**88.** There are any number of differences between a revocation action under Section 64, and an invalidity defence under Section 107, of which the following, correctly noticed by the learned Single Judge, are self-apparent:

(i) A revocation petition, if it succeeds, removes the patent entirely from the register of patents, and invalidates the very grant of the patent. The patentee cannot, therefore, amend or modify the patent, or assert it for any purpose. As against this, a Section 107 plea is merely a *defence* in the infringement suit. The highest that would result, if the defence succeeds, is that the suit would be dismissed. The patent does not stand removed, thereby, from the register of patents, even if the defendant may, in another proceeding in which, hypothetically, the same patent is asserted, rely on the decision in the earlier suit.

(ii) It is for this reason that Section 151 requires the decision on the revocation petition to be transmitted to the Controller of Patents, and requires the Controller to make an entry in that regard in the register of patents, whereas the decision on a



2026:DHC:1609-DB



2026:DHC:1609-DB

Section 107 invalidity defence is, though transmitted to the Controller, only required to be entered in a supplemental record.

(iii) The decision on an invalidity defence under Section 107 operates *in personam*, whereas the decision in a revocation petition under Section 64 operates *in rem*. This position stands recognized even in *Virgin Atlantic Airways*.

**89.** Dr. Singhvi's submission that allowing a revocation petition to continue even after an invalidity defence has been raised under Section 107 would result in multiplicity of litigation, therefore, obviously cannot be accepted. The two operate in different spheres. Till the patent is revoked, it continues to remain valid and enforceable, and the cause of action for raising the Section 107 invalidity defence, too, therefore, subsists. There is, therefore, no question of multiplicity of litigation.

## **G. Conclusion**

**90.** We therefore, agree with the learned Single Judge on both the issues framed by him. More particularly, we hold that

- (i) a revocation petition would be maintainable, and would continue to survive, even after the patent of which revocation is sought expires by efflux of time, and
- (ii) a revocation petition can be instituted even after a Section 107 invalidity defence is taken in the infringement suit.



2026:DHC:1609-DB



2026:DHC:1609-DB

**91.** The appeal, therefore, fails and is dismissed, with no orders as to costs.

**92.** We appreciate the assistance rendered by learned Counsel in resolving an issue for which there was no ready legal precedent.

**C. HARI SHANKAR, J.**

**OM PRAKASH SHUKLA, J.**

**FEBRUARY 24, 2026**

DSN/AR