

MANU/DE/4893/2013

Equivalent Citation: 2014ivAD(Delhi)412, 205(2013)DLT680, 2013(56)PTC570(Del)

**IN THE HIGH COURT OF DELHI**

CS (OS) No. 2206 of 2012

Decided On: 06.11.2013

Appellants: **Koninklijke Philips Electronics N.V.**  
**Vs.**

Respondent: **Sukesh Behl and Ors.**

**Hon'ble Judges/Coram:**

*Dr. S. Muralidhar, J.*

**Counsel:**

*For Appellant/Petitioner/Plaintiff: Mr. Sudhir Chandra, Senior Advocate with Mr. Pravin Anand, Ms. Vaishali Mittal, Mr. Gupreet Singh Kahlon and Ms. D. Neha Reddy, Advocates*

*For Respondents/Defendant: Mr. Ajay Sahni, Mr. N.K. Bhardwaj, Mr. Bikash Ghorai and Ms. Kanika Bajaj, Advocates*

**Case Note:**

**Intellectual Property Rights - Revocation of patent - Section 8 of Patents Act, 1970 and Rule 12 of Patent Rules, 2003 - Present application filed seeking revocation of patent granted to Plaintiff as it failed to disclose mandatorily required information to Controller of Patent (COP) under Section 8 of Act and Rule 12 - Whether application for revocation was maintainable - Held, there was no deliberate or wilful suppression of information - Further, it could not be said that if such information was disclosed to COP, patent may not have been granted at all - Application dismissed.**

**ORDER**

**Dr. S. Muralidhar, J.**

IA No. 14921 of 2013 (Order XII Rule 6, CPC)

**1.** Mr. Sudhir Chandra, learned Senior Counsel for the Plaintiff, states that the Plaintiff does not press this application at this point, i.e., IA No. 14921 of 2013. The application is dismissed as not pressed.

IA No. 21411 of 2012 (Order XII Rule 6, CPC by Defendant)

**2.** The background to the present application filed by the Defendant under Order XII Rule 6, CPC is that the above suit has been filed by Plaintiff Koninklijke Philips Electronics N.V. against Maj. (Retd.) Sukesh Behl, proprietor M/s. Pearl Engineering Company (Defendant No. 1) and M/s. Pearl Engineering Company (Defendant No. 2) for permanent injunction to restrain the Defendants from infringing the Plaintiff's Essential DVD Video/DVD ROM Disc Patents, in particular Indian Patent registered under No. 218255 and for other incidental reliefs.

**3.** Summons in the suit was issued on 25th July 2012 and the suit was itself fast tracked. On service of summons, the Defendants filed Counter Claim No. 97 of 2012

along with the written statement. In the counter claim, the prayer was that Patent No. 218255 should be revoked and declared invalid. The Plaintiff filed its written statement to the counter claim to which replication was also filed.

**4.** In the present application under Order XII Rule 6, CPC, it is pointed out by the Defendants that one of the grounds for seeking revocation was the failure by the Plaintiff to disclose the information to the Controller of Patent ('COP'), as mandatorily required by Section 8 of the Patents Act, 1970 ('Act') and Rule 12 of the Patent Rules thereby attracting revocation under Section 64(1)(m) of the Act. According to the Defendants, the Plaintiff did not submit the details of corresponding foreign applications within the prescribed three months' period. It is pointed out that the Plaintiff filed a letter dated 14th September 2012 before the COP admitting that During the prosecution of granted patent, certain details regarding the corresponding foreign filings were not submitted to the Indian Patent Office". Along with the letter, the Plaintiff had filed an affidavit of the patent agent D.J. Solomon of De Penning & De Penning enclosing Annexures A, B and C with a request to the COP that the said documents which had not been filed earlier under Section 8 of the Act may now be taken on record. It is contended in the present application that the above submission of the Plaintiff constitutes "a clear and unequivocal admission" and that since there was an obvious suppression of vital information, "the ground for vacation of patent" under Section 64(1)(m) is prima facie attracted. It is submitted therefore that this Court should straightaway proceed to revoke Indian Patent No. 218255 on the basis of the above admission.

**5.** In its reply to the above application, the Plaintiff pointed out that it had in fact filed details of corresponding foreign applications on 17th March 1999, 13th March 2002 and 31st August 2004 and, therefore, the requirement of Section 8 of the Act had been met. Further reliance is placed on the decision of this Court in F. Hoffmann-La Roche Ltd. v. Cipla Ltd., MANU/DE/4182/2012 : 195 (2012) DLT 641 : 2012 (52) 1 PTC (Del), where it was held that solely on the ground of non-compliance with Section 8 of the Act a patent cannot be revoked. It is submitted that the letter dated 14th September 2012 and the annexures thereto do not constitute an admission for the purposes of counter claim. It is pointed out that the full information concerning the pending foreign applications was submitted by a letter dated 16th March 2004 but inadvertently one of the pages containing additional information was missed out by the Attorney's office while submitting the application. This was clarified in the affidavit of Mr. D.J. Solomon. It is submitted that the inadvertently omitted details do not prejudice, and are not material to, the grant of the suit patent.

**6.** Mr. Ajay Sahni, learned Counsel for the Defendants/Applicants relied on the decision of this Court in Chemtura Corporation v. Union of India, MANU/DE/1880/2009 : 2009 (41) PTC 260 (Del.), to contend that the requirement of mentioning the pending foreign applications under Section 8 of the Act was mandatory and that the admission made by the Plaintiff in its letter to the COP dated 14th September 2012 constitute a clear admission of failure by the Plaintiff to comply with the mandatory requirement of law. Mr. Sahni urged that Section 64(1)(m) of the Act was straightaway attracted. He relied on the decision in Raghunath Rai Bareja v. Punjab National Bank, MANU/SC/5456/2006 : (2007) 2 SCC 230 to contend that in cases where the statutory provision is plain and unambiguous the Court "shall not interpret the same in a different manner only because of harsh consequences arising therefrom". He pointed out that equitable considerations have no place where the provisions of the statutes are unambiguous. He also placed reliance on the decision in May George v. Special Tahsildar, MANU/SC/0402/2010 : (2010) 13 SCC 98 which held that "the provision is mandatory if it is passed for the purpose of enabling to do something and prescribed the formalities for doing certain things".

**7.** Mr. Sudhir Chandra, learned Senior Counsel appearing for the Plaintiff on the other hand submitted that in the first place under Order XII Rule 6, CPC a judgment on admissions is a matter for the discretion of the Court. Relying on the decision in *Raj Kumar Chawla v. Lucas Indian Services*, MANU/DE/8564/2006 : AIR 2006 Delhi 266 : 129 (2006) DLT 755 (DB), he submitted that where the Defendant raises an objection which goes to the root of the case, it would not be appropriate to exercise that discretion. Consequently, in spite of the admission of a fact having been made "the Court may still require the Plaintiff to prove the fact which has been admitted by the Defendant". He drew attention to the observations of the Court in *F. Hoffmann-La Roche Ltd.* which interpreted the word 'may' in Section 64 of the Act as granting discretion to the Court in the matter of revocation. He submitted that the pleas raised by the Defendant would at best raise a triable issue. He pointed out that in any event an issue on the basis of the counter claim has been framed and trial is in progress. Therefore, the present application was premature.

**8.** Sections 8 and 64(1)(m) of the Act, which are relevant for the present application, read as under:

**8. Information and undertaking regarding foreign applications.--**

(1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application or subsequently within the prescribed period as the Controller may allow

(a) a statement setting out detailed particulars of such application; and;

(b) an undertaking that, up to the date of grant of patent in India, he would keep the Controller informed in writing, from time-to-time, of detailed particulars as required under Clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.

(2) At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of patent made thereon, the Controller may also require the applicant to furnish details, as may be prescribed, relating to the processing of the application in a country outside India, and in that event the applicant shall furnish to the Controller information available to him within such period as may be prescribed.

**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 by the Appellate Board 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--

....

....(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.

**9.** In *F. Hoffmann-La Roche Ltd.*, even while the Court, on the facts of that case, held that the grant of Section 8 read with Section 64(1)(m) was made out, it proceeded to hold in para 156 as under:

156. Consequently, the ground of violation of Section 8 read with Section 64(1)(m) is made out. However, still there lies a discretion to revoke or not to revoke which I have discussed later under the head of relief. Under these circumstances, even in case, the said compliance of Section 64(1)(m) of the Act has not been made by the Plaintiffs, still there lies a discretion in the Court not to revoke the patent on the peculiar facts and circumstances of the present case. The said discretion exists by use of the word "may" under Section 64 of the Act. Thus, solely on one ground of noncompliance of Section 8 of the Act by the Plaintiffs, the suit patent cannot be revoked.

**10.** Thereafter, on the facts of that case/it was held that the Defendant was still not entitled to revocation as it had taken certain inconsistent pleas.

**11.** In *Chemtura Corporation*, the context was vacation of an interim stay granted in favour of the Plaintiff. The plea of the Defendant in that case was that the ground of revocation was prima facie attracted both under Sections 64(1)(j) as well as 64(1)(m) of the Act since the Plaintiff had obtained the patent on a false suggestion and representation and failed to disclose to the COP the information in terms of Section 8 of the Act. The Court discussed the pleadings in great detail and came to the conclusion that on the context of that case, it appeared prima facie, that there had been a failure by the Plaintiff to comply with the mandatory requirement and, therefore, the interim injunction should be vacated. Importantly, the Court in that case was not deciding on whether the patent itself should be revoked. It is clarified that the opinion was prima facie and not intended to influence the final outcome of the suit. Consequently, the entire discussion in *Chemtura Corporation* was in the context of vacation of an interim stay granted in favour of the Plaintiff. In the considered view of the Court, the above decision in *Chemtura Corporation* is not particularly helpful to the Defendant in persuading the Court to grant a decree on admissions under Order XII Rule 6 at this stage.

**12.** As far as the present case is concerned, the letter dated 14th September 2012 sent by Mr. Solomon to the COP encloses certain documents regarding corresponding foreign applications. In the affidavit dated 14th September 2012 filed by Mr. Solomon, he states in para 9 that "inadvertently my paralegal assisting me missed out the information in relation to corresponding foreign applications that was printed in the reverse of the first page as forwarded to us by the Plaintiff". In other words, while the details of the foreign applications provided on two of the pages were disclosed, those contained on the reverse of the first page were not. Mr. Sahni argued that what was deliberately suppressed was crucial information concerning the US Patent where the Plaintiff's claims were narrowed down and this would have shown that the claims made under the patent under challenge was far beyond what was granted by the US Patent Office. It is submitted that if this information had been available to the COP in the first instance, the patent may not have been granted at all.

**13.** It requires to be noted that while the Plaintiff does not deny that a part of the information concerning the pending foreign applications was inadvertently not disclosed, there is no admission as to the withholding of that information being deliberate or that there was wilful suppression of such information. That surely would be a matter for evidence. Further, the question whether the non-disclosure of the above information contained on the reverse of the first page in the first instance before the COP was material to the grant of the patent raises a triable issue. It is not possible at the present stage for the Court to form a definitive opinion on the above aspects. If at the end of the trial the Court, after examining the evidence, agrees with the Defendants that the information that was withheld was material to the grant of the patent itself, it might proceed to revoke the patent- Alternatively, it might disagree with the Defendant and decline to revoke the patent. In other words, that determination would have to await the conclusion of the trial.

**14.** For the aforementioned reasons, the Court is of the view that it is not possible to grant the prayer made in this application by the Defendant under Order XII Rule 6, CPC.

**15.** Leaving open the questions urged to be decided at the conclusion of the trial, this application is dismissed.

**16.** List before the Joint Registrar on 6th February 2014, the date already fixed. List before the Court for the framing of issues on 30th April 2014.

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