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IN THE HIGH COURT OF DELHI AT NEW DELHI*Reserved on: 17th August, 2022**Date of decision: 10th November, 2022*

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C.O.(COMM.IPD-PAT) 3/2021 & I.As. 13644/2021, 3420/2022**DR. REDDYS LABORATORIES LIMITED & ANR ...Petitioners**

Through: Mr. J. Sai Deepak, Mr. Avinash Kr. Sharma, Advocates.(M:7289036972)

versus

THE CONTROLLER OF PATENTS & ORS.,Respondents

Through: Mr. Harish Vaidyanathan Shankar,CGSC, Mr. Srish Kumar Mishra, Mr.Alexander Mathai Paikaday and Mr.Sagar Mehlawat, Advocates for UOI.

Mr. Sandeep Sethi, Sr. Advocate with Mr. Sanjay Kumar, Ms. ArpitaSawhney, Mr. Priyansh Sharma, Ms.Meenal Khurana, Mr. Tabhay Tandonand Mr. Arun Kumar, Advocates forR-2. (M:9810404749)

WITH

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C.O. (COMM.IPD-PAT) 1/2022 & I.A.3570/2022**THYSSENKRUPP ROTHE ERDE GERMANY GMBH .. Petitioner**

Through: Mr. Pranaynath Jha, Mr. MaheshKumar, Ms. Simran Soni & Mr.Anubha Pandey, Advocate. (M:9958944848)

versus

THE CONTROLLER OF PATENTS & ANR.Respondents

Through: Mr. Harish Vaidyanathan Shankar,CGSC, Mr. Srish Kumar Mishra, Mr.Alexander Mathai Paikaday and Mr.Sagar Mehlawat, Advocates for UOI.(M:9810758606) Mr. Bharath M.S., Mr. AyushSharma,

Advocates for R-2.(M:9899096069)

AND

+ **C.A.(COMM.IPD-PAT) 169/2022& I.As. 8920/2022, 8921/2022**
ELTA SYSTEMS LTD.Appellant

Through: Ms. Rajeshwari H. and Mr.Deepanshu
 Nagar, Advocate.(M:8826968200)

versus

THE CONTROLLER OF PATENTSRespondent

Through: Mr. Harish Vaidyanathan
 Shankar,CGSC, Mr. Srish Kumar
 Mishra, Mr.Alexander Mathai
 Paikaday and Mr.Sagar Mehlawat,
 Advocates for UOI.

Mr. Adarsh Ramanujan& Mr. Aditya
 Gupta, Advocates assisting the Court.

CORAM:

JUSTICE PRATHIBA M. SINGH

JUDGMENT

1. This hearing has been done through hybrid mode.
2. Issues of maintainability have been raised in these three proceedings under the Patents Act, 1970(*hereinafter* '1970 Act'). There are two categories of cases:
 - i. **C.O.(COMM.IPD-PAT) No.3/2021** and **C.O.(COMM.IPD-PAT) No.1/2022** are revocation petitions seeking revocation of granted patents under Section 64 of the 1970 Act;
 - ii. **C.A.(COMM.IPD-PAT) 169/2022** is an appeal under Section 117A of the 1970 Act.
3. The enactment of the Tribunal Reforms Act 2021 (*hereinafter* 'TRA')resulted in the abolishing of the Intellectual Property Appellate Board (*hereinafter* 'IPAB'). All matters which were pending before the IPAB stood

transferred to the High Courts. Post the TRA, jurisdiction in respect of appeals and revocation petitions under the 1970 Act has now been transferred back to High Courts. However, the question has arisen as to whether all High Courts can entertain revocation petitions and appeals. How is jurisdiction in respect of such matters to be determined?

4. Owing to the importance and the impact of the issues raised, apart from Id. Counsel for the parties, various other counsels practising in the field of Intellectual Property law have also made submissions for the assistance of the Court.

Facts in brief in C.O.(COMM.IPD-PAT) 3/2021 titled Dr. Reddy's Laboratories Limited & Anr. v. The Controller of Patents & Anr.

5. The present revocation petition under section 64 of the 1970 Act has been filed by Petitioner No.1- Dr. Reddy's Laboratories Limited, and Petitioner No.2- MSN Laboratories Pvt. Ltd. seeking revocation of patent no. IN 268846 granted in favour of Respondent No.2- Boehringer Ingelheim International GmbH (*hereinafter 'Boehringer'*).

6. Boehringer applied for a patent for certain Benzenol derivatives and medicinal preparations containing the said derivatives. The patent application bearing no. 4844/DELNP/2006 was filed through the PCT route on 23rd August, 2006 in the Patent Office, Delhi. The said patent application was granted registration as IN 268846 on 18th September, 2015 by the Patent Office, Delhi. The present revocation petition was filed by the Petitioners on 16th October, 2021. The prayers in the revocation petition read as under:

“122. In view of the facts and circumstances narrated herein above, it is, most respectfully prayed that this Hon'ble Court may be pleased to:
a) *Revoke Indian Patent No. 268846 and direct*

Respondent No.1 to remove IN 268846 from the Register of Patents;

b) Issue a decree of Permanent Injunction restraining the Respondent No.2, its employees, Directors, agents, and any all persons acting or claiming to act on the behalf of Respondent No.2 from issuing any threatening communications, whether oral or written or through public notices or otherwise based on IN 268846 and alleging infringement thereof in order to hamper the legitimate business activity of Petitioners or their agents, distributors, retailers, employees, directors, and any persons acting on their behalf;

7. Three days after the filing of the present revocation petition, a suit for infringement was filed by Boehringer in the High Court of Himachal Pradesh against Petitioner No.1 on 19th October, 2021. The said High Court granted an interim injunction against the present Petitioner No.1. Another suit for infringement was filed by Boehringer against Petitioner No.2 and an interim injunction was passed against the present Petitioner No.2 in the said suit on 25th October, 2021.

8. In the meantime, notice was issued in the present petition on 22nd October, 2021. **I.A.3420/2022** under Section 10 CPC has been filed by Boehringer seeking stay of the present revocation proceeding till the suits for infringement pending adjudication before High Court of Himachal Pradesh reach conclusion. In addition, a preliminary objection as to the maintainability of the present petition before this Court has also been raised.

FactsinbriefinC.O.(COMM.IPD-PAT) 1/2022 titled Thyssenkrupp Rothe Erde Germany GmbH v. The Controller of Patents& Anr.

9. The Petitioner – Thyssenkrupp Rothe Erde Germany GmbH (*hereinafter ‘Thyssenkrupp’*) has filed the present revocation petition under Section 64 of the 1970 Act seeking revocation of patent no. IN 254458 granted in favour of Respondent No.2, IMO Holding GmbH (*hereinafter ‘IMO’*). The Petitioner is a company based in Germany whose Power of Attorney holder resides in Delhi. IMO is also a German company.

10. The patent application was filed in Chennai and the address for service is also of Chennai. The ‘*appropriate office*’*qua* the said application is also at Chennai. The Petitioner had originally filed a revocation petition before the IPAB, Chennai bearing *No.22/2021/PT/CHN* in *ORA/742* in March, 2021.

11. The present revocation petition under section 64 of the 1970 Act has primarily been filed by the Petitioner in January, 2022 upon the enactment of the TRA as it was unsure of the fate of its revocation petition which was originally filed before the IPAB. IMO has filed *I.A. 3570/2022* under Order 7 Rule 11 CPC seeking rejection of the revocation petition filed by Thyssenkrupp on the ground of lack of jurisdiction and concealment of revocation filed before the IPAB. The question in the case before the Court is as to whether the present revocation petition under Section 64 is maintainable before this Court.

Facts in brief in C.A. (COMM.IPD-PAT) 169/2022 titled Elta Systems Ltd. v. The Controller of Patents

12. The present appeal has been filed by the Appellant- Elta Systems Ltd. (*hereinafter 'Elta'*) under section 117A of the 1970 Act against the order of the Id. Asst. Controller of Patents dated 30th July, 2021 by which Elta's application number 2286/MUMNP/2014 for grant of patent was refused. The Appellant, Elta filed a PCT application bearing no. PCT/IL2013/050360 titled '*Estimating a Source Location of a Projectile*' on 25th April, 2013. Application bearing no. 2286/MUMNP/2014 was filed as the Indian national phase application on 12th November, 2014 at the Patent Office, Mumbai.

13. Due to the internal allocation mechanism adopted by the office of the CGPDTM, the application appears to have been marked for examination to the Controller of Patents at Delhi. The First Examination Report (*hereinafter 'FER'*) was issued by the Id. Asst. Controller of Patents at the Delhi Patent Office on 25th February, 2019. The Appellant filed reply dated 23rd August, 2019 to the FER which was addressed to the Patent Office, Mumbai.

14. Hearing was held through Video Conferencing by the Id. Assistant Controller whose seat was at Delhi and finally, after the hearing, the application was rejected vide the impugned order dated 30th July, 2021 passed by the Patent Office, Delhi.

15. The present appeal has been filed before this Court, challenging the said order passed by the Delhi Patent Office. The issue to be decided by this Court is whether the appeal would be maintainable before the Delhi High Court or at the High Court of Bombay.

Submissions:

16. In view of the importance of the issue that arises in these matters, this Court had on 4th March, 2022 permitted counsels to make submissions and assist the Court. Ld. counsels for the parties, as also various other ld. counsels, have made submissions and filed written notes of arguments.

I. Submissions of Ms. Rajeshwari, ld. Counsel

17. Ms. Rajeshwari, ld. counsel, has relied upon Section 2(1)(i) of the 1970 Act defining 'High Court' and Section 2(1)(t) of the Act defining 'person interested'. Her submission is that the High Court which can entertain a Section 64 petition would be a Court which has territorial jurisdiction and can be any High Court. The definition of 'person interested' is inclusive and open ended. Such person may have a current interest or a future interest in the patent. As per *Aloys Wobben v. Yogesh Mehra* (2014) 15 SCC 360 it has to be a person who has a direct, present and tangible interest in the patent.

18. The ld. Counsel further relies upon the judgment of the Full Bench in *Girdhari Lal Gupta v. M/s K. Gian Chand Jain & Co.* 1977 SCC OnLine Del 146 which dealt with Section 51A of the Designs Act, 1911 to argue that the similar situation has arisen under Section 64 of the 1970 Act. The said judgment distinguished between the static effect and dynamic effect of registration. She also relies upon *Jayswal Neco Ltd. v. Union of India* [WP(C) 2103/2007, judgment dated 2nd July, 2007] to argue that in the context of a seat of the Government and cause of action, the Court has set out various permutations and combinations as per which High Courts will have jurisdiction considering the law settled by the Supreme Court right from *Kusum Ingots & Alloys Ltd. v. Union of India* 2004 (6) SCC 254 and

the judgments following the same.

19. Insofar as the question as to which High Court an appeal would lie from the order of the Patent Office, Ms. Rajeshwari, Id. Counsel, has made twofold submissions. First, since the Indian Patent Office has adopted the practice of random allocation of patent applications for examination, the High Court exercising jurisdiction over the Patent Office where the examination of the patent application has taken place would have jurisdiction to entertain an appeal against the said order, as a part of cause of action has arisen within the territorial jurisdiction of that High Court. Id. Counsel places reliance upon the judgment of the Supreme Court in *Nasiruddin and Ors. v. State Transport Appellate Tribunal and Ors.* AIR 1976 SC 331 wherein it was held that if the cause of action arises, wholly or in part, within the territorial jurisdiction of a Court, it would be open to the litigant who is *dominus litis* to have his *forum conveniens*. She further relies upon the judgment of Supreme Court in *Kusum Ingots (supra)* and *Canon Steels (P) Ltd. v. Commissioner of Customs (2007) 14 SCC 464* wherein it was observed that when an order is passed by an authority in a particular jurisdiction, a part of cause of action arises at that place.

20. Second, it is the submission of the Id. Counsel that Rule 4 of the Patent Rules, 2003 (*hereinafter 'Rules'*) has no application or bearing in determining the High Court having territorial jurisdiction to hear appeal against the orders of the Patent Office. The Court's attention is drawn to the wording of Rule 4 which defines '*appropriate office*' for "*all proceedings under the Act*". As per the Id. Counsel the said phrase denotes proceedings commencing from the filing of the patent application till the grant or rejection by the Patent Office. It is her argument that after the grant

or rejection order is passed, the Appropriate Office becomes *functus officio*. Thus, the appropriate office in respect of the Patent Application cannot determine the High Court to which an appeal against the order of the Controller would lie.

II. Submissions of Mr. Bharath, Id. Counsel

21. In *I.A. 3570/2022* seeking rejection of revocation petition being *C.O.(COMM.IPD-PAT) 1/2022*, Mr. Bharath, Id. Counsel submits that the Petitioner is guilty of concealment of material facts. The patent in the present case was filed originally in the Chennai Patent office and was granted there. The Petitioner first approached the IPAB, Chennai by way of a revocation petition. However, thereafter it chose to file the present petition before this Court. Thus, the Petitioner was well aware that the correct forum in the present case is the Madras High Court as the petition which was pending before the IPAB, Chennai has now been transferred to the Madras High Court and is yet to be numbered. He submits that the Petitioner has not disclosed these facts. The patent having been granted by the Chennai Patent Office, this Court would not have jurisdiction to entertain the present revocation petition.

22. In addition, he submits on the legal issue that there could be three scenarios which may exist when revocation or cancellation of an Intellectual Property Right is sought. In the first scenario, if a suit for infringement in respect of the said very Intellectual Property is pending, then the High Court where the said suit is pending would be the appropriate Court where the jurisdiction ought to exist. In the second scenario, where an interested party is to seek revocation, rectification or cancellation, and there is no suit for infringement of the said Intellectual Property which is pending

before any Court. In such a case, it should approach the court within whose jurisdiction the commercial interest of the party is affected, i.e., there is a cause of action which arises in the said jurisdiction. Thus, it need not only be the place where the registration has been granted for the said Intellectual Property. In the third scenario, where there is no cause of action and also no suit of infringement is pending, in such a case cancellation, revocation, rectification may be filed before the High Court in whose jurisdiction the concerned IP Office has granted registration.

23. It is further submitted by Mr. Bharath, Id. Counsel, that the Full Bench decision in *Girdhari Lal Gupta (supra)* clearly records that the static effect and the dynamic effect ought to be considered while deciding the question of jurisdiction. He further submits that Section 33(3) of the TRA has made it clear that the pending matters are to be sent to the concerned High Court which has jurisdiction. In *C.O.(COMM.IPD-PAT) 1/2022*, the same would be the Madras High Court as the revocation petition has already been filed by the Petitioner before the IPAB Chennai and the records have now been transferred to the Madras High Court and thus, the present revocation petition before this Court ought not to be entertained.

24. On the aspect of appeals to the High Court against the decision of Patent Office, Mr. Bharath, Id. Counsel submits that an appeal is a continuation of the original proceeding. Thus, appeals from the order of the Patent Office ought to lie only before the High Court which exercises jurisdiction over the concerned Patent Office.

III. Submissions of Mr. Pranay Nath Jha, Id. Counsel

25. Mr. Pranay Nath Jha, Id. Counsel submits that in the urgent application filed for listing of *C.O.(COMM.IPD-PAT) 1/2022*, it has been

clearly disclosed that revocation petitions were earlier filed before the erstwhile IPAB. However, after the enactment of the Tribunal Reforms Ordinance, 2021 the Petitioner is entitled to invoke the jurisdiction of Delhi High Court by the virtue of Rule 4 of Rules. Specific reference is made to Rule 4 where “for all proceedings under the Act” is referred to and Rule 4(1)(i)(b) where a “party in a proceeding” is referred to. He submits that the Petitioner in this case is a foreign company which has given an address for service in Delhi through its counsels. Accordingly, in view of operation of Rule 4(1)(i)(b) of the Rules, the Delhi High Court would have jurisdiction to entertain the revocation petitions in question. Mr. Jha, Id. Counsel, further submits that the commercial interest aspect would not have any relevance in revocation petition which may otherwise have a relevance in a case of infringement.

26. On the specific facts of the case, he further submits insofar as the filing before the IPAB is concerned, the petition was merely ‘presented’ before the IPAB and the matter is yet to be registered. His petition before the IPAB, Chennai was not even listed. Merely, assigning of diary number is not institution and his case was not pending before the IPAB, Chennai. Thus, there was no ‘institution’ in the strict sense as set out in the judgment of *Selvaraj v. Koodankulam Nuclear Power Plant 2021 (4) CTC 539*. On the other hand, Mr. Bharat points out that the IPAB had numbered the petition **22/2021/PT/CHNinORA/742** as is evident from ‘page – 111 of Respondent’s document’. Thus, the matter was numbered before the IPAB and was duly registered.

IV. Submissions of Mr. J. Sai Deepak, Id. Counsel

27. Mr. J. Sai Deepak, Id. counsel, categorically asserts that Rule 4 of the Rules has no application in the context of revocation petitions filed under Section 64. Rule 4 relates to appropriate office of the “Patent Office”. Thus, it relates only to proceedings related to Patent Office. Once the Head Office or the Branch Office of the Patent Office is *in seisin* of the proceedings, the same cannot be changed in view of Rule 4(2) of the Rules. But this provision would not have any applicability in respect of Section 64 of the 1970 Act. It may have applicability in the context of Section 117A of the 1970 Act for entertaining appeals against the orders passed by the Patent Office. Under the said provision only the High Court in whose jurisdiction the Patent Office which has passed the order is located would have territorial jurisdiction to entertain the appeal.

28. A patent right granted is one *in rem* and has a countrywide application. The choice of filing the petition is purely vested in the Revocation Applicant who files the revocation petition under section 64. So long as the Applicant can justify the reason for filing a petition in a particular High Court, the freedom of the Applicant cannot be curtailed in any manner. Reliance is placed upon the judgment of the Division Bench of this Court in *Ajay Industrial Corporation v. Shiro Kanao of Ibaraki City AIR 1983 DEL 496* which dealt with Section 64 of the 1970 Act, as it then stood, prior to the IPAB coming into existence. The submission of Mr. Deepak, Id. counsel, is that the remedy under Section 64 is independent of a suit or any other remedy under the 1970 Act. The same is not connected to the jurisdiction of a Court where the suit is filed. The right to seek revocation cannot be curtailed by linking the same with the filing of a suit

for infringement. In conclusion, he submits that since there is no limitation on the exercise of jurisdiction by the High Court either in Section 2(1)(i) or in Section 64 of the 1970 Act, the freedom to file the revocation ought to be given in all places where the cause of action has arisen or the patent is registered or the commercial interest is affected so long as the nexus is shown.

29. As far as facts in *C.O.(COMM.IPD-PAT) 3/2021* are concerned, the revocation petition was filed on 16th October, 2021 and was listed on 21st October, 2021 without any objection being raised. However, between these two dates, patent infringement suits were filed by Respondent No.2 in Shimla in Himachal Pradesh. In such a situation, it cannot be held that invoking of the jurisdiction of this Court is in any manner abusive and following the Division Bench judgment in *Ajay Industrial Corporation (supra)*. The application under section 10 CPC is, thus, liable to be dismissed.

V. Submissions of Mr. Sandeep Sethi, ld. Sr. Counsel

30. Mr. Sandeep Sethi, ld. Senior Counsel has, at the outset, submitted that the issue of jurisdiction is a vexed issue only when the revocation petition is independently filed before any High Court. He submits that if the revocation of a patent is sought in a suit of infringement, the same would be filed either as counter claim or as a separate revocation petition to be tried and adjudicated along with the suit. In such a situation, no difficulty as to jurisdiction would arise. However, if the revocation petition is being independently filed, then the issue of jurisdiction would have to be decided.

31. Ld. Sr. Counsel refers to various provisions of the 1970 Act to argue that the High Court has been given jurisdiction under various provisions to deal with different kinds of disputes that may be filed. Reference is made to

Sections 2(1)(i), 64, 71, 100, 103, 113, and 117A of the 1970 Act. He submits that there can be two scenarios when the revocation petition is independently filed. First, when suit for infringement is pending, and second when no suit for infringement is pending. When a suit for infringement is filed, it is his submission that the Plaintiff in a suit for infringement can invoke the jurisdiction of any High Court or District Court having jurisdiction. The principles that would be applicable in those suits are settled in law and once the suit for infringement is filed, the person interested ought to challenge the patent only by way of a counter-claim.

32. On the other hand, if no suit for infringement is pending, revocation petition can be filed wherever the 'cause of action' arises. The provisions of the 1970 Act do not stipulate the *situs* for filing of revocation petitions. He, further, submits that the cause of action for a person interested seeking revocation is the grant of patent. The term 'cause of action' would have to be interpreted as contained in Section 20 CPC. The Court adjudicating the revocation petition has to be a 'competent Court' and any High Court cannot be allowed to entertain revocation petitions. Accordingly, if the patent is to be challenged, applying the principles of Section 20 CPC, the revocation ought to be filed in the High Court which exercises jurisdiction over the Patent Office which granted the patent or the location of the patentee i.e., where the patentee resides or carries on business.

33. The Id. Sr. Counsel submits that the place of residence or place of carrying on business of the Applicant seeking revocation would not by itself constitute 'cause of action', inasmuch as none of the grounds of revocation mentioned in Section 64 of the Act have any relationship to the business or the residence of the revocation Applicant. The acts complained of in a

revocation would be the acts of the patentee or the defaults of the patentee and, thus, they would be governed by the *situs* where the patent was filed or where the patentee is residing or carrying on his business. He seeks to emphasize this submission by arguing that the patentees could even be individuals, small organizations and such patentees ought not to be harassed by filing revocation petitions in far off locations. If the cause of action is deemed to include the place where the revocation Applicant / Petitioner is located or is carrying on business, there is a serious chance of abuse of the same *qua* the patentee.

34. It is his submission that the issue of territorial jurisdiction cannot become an instrument of harassment in the hands of the Revocation Petitioner and a holistic view would have to be taken. Ld. Sr. Counsel submits that though judgments in *Girdhari Lal Gupta (supra)* and *Ajay Industrial Corporation (supra)* hold that wherever the impact of the registration of the design/ patent is felt, such High Court would have jurisdiction. However, he submits that same is now contrary to subsequent judgments. This Court ought to go by the definition of ‘cause of action’ as recently held by the Supreme Court in various decisions. The Supreme Court’s decisions, relied upon by Mr. Sethi, Ld. Counsel, on the question of ‘cause of action’, are as under:

(1) Rajasthan High Court Advocates’ Association v. Union of India and Ors., (2001) 2 SCC 294

(2) Union of India and Ors. V. Adani Exports Ltd. and Anr., (2002) 1 SCC 567

35. Mr. Sethi, Ld. Sr. Counsel, submits that in these judgments the

Supreme Court has held that cause of action would arise at the place which has nexus with the *lis* involved. The *lis* in the revocation petition is the incorrect grant of the patent and thus, this should be governed by the patentee's residence, place of business or the Patent Office where the patent itself was filed. Ld. Senior Counsel further relies upon the judgment of the Supreme Court in *Indian Performing Rights Society Limited v. Sanjay Dalia and Anr., (2015) 10 SCC 161* wherein it has been held that the convenience of the parties should not be stretched to such an extent that the issue of jurisdiction becomes vexatious.

VI. Rejoinder Submission of Mr. J. Sai Deepak, Id. Counsel

36. Mr. Sai Deepak, Id. Counsel in his rejoinder submissions submits that the judgments in *Ajay Industrial (supra)* and *Girdhari Lal Gupta (supra)* would continue to be applicable as they were rendered at a time when the jurisdiction for revocation of patents was vested in High Courts prior to 2003. The 1970 Act itself does not give any guidance as to the High Court which would have territorial jurisdiction to entertain revocation petitions. Thus, recourse would have to be taken to the provisions of the CPC i.e., Section 20. It is his submission that both these decisions were rendered at a time when High Courts had jurisdiction and thus, the interpretation of Section 20 in the manner in which it would apply to revocation petitions would continue to be good law.

37. He submits that the judgment in *IPRS (supra)* would have no applicability as the same dealt with special jurisdiction clause under Section 62 of the Copyright Act, 1957 and Section 134 of the Trade Marks Act, 1999. These two provisions are in addition to Section 20 CPC and the

interpretation which may have been given in *IPRS (supra)* would not be applicable when the Court is considering the width of Section 20 CPC. Mr. Sai Deepak, Id. Counsel, reiterates that in a revocation petition, it is not the order of grant which is under challenge. What is under challenge is, in fact, the effect of the grant which is felt by the person seeking revocation of the patent. Since the effect of the grant can be felt at every place, including where the applicant seeking revocation resides or carries on business, such High Courts would have jurisdiction to entertain the revocation petition.

38. The Id. Counsel submits that the same principle that applies in case of an infringement action being filed by the patentee would also apply, in reverse, for filing of revocation petition. If a patentee can sue a party on *quia timet* basis or actual infringement basis where the said party is either residing, carrying on business or is likely to launch product in question, by the same standard, the revocation could also lie to the same very Court where an infringement action would be maintainable. He submits on the basis of Section 48 of the 1970 Act that since the said provision vests with the patentee, the right to exclude third parties not authorized by it, from manufacturing, selling or offering for sale any product covered by the patented invention, every place where this right can be exercised by the patentee would be a place where revocation petition can also be filed. Reliance is placed on a judgment of the Id. Single Judge of the Himachal High Court in *MSN Laboratories Private Limited v. The Controller of Patents [OMPs No.162 & 230 of 2022, decided on 2nd June, 2022]*.

39. He finally concludes by submitting that in *Rajasthan Advocate Association (supra)* the Supreme Court has clearly held, in paragraph 17 of the said judgment, that the question as to whether any Court has territorial

jurisdiction would be an issue to be decided in every individual case and there cannot be a broad rule. Insofar as the case of *Adani Exports(supra)* is concerned, he distinguishes the same on facts by submitting that in the facts of the said case, the passbook which was under challenge was issued in Madras. Thus, the Supreme Court held that the Gujarat High Court did not have territorial jurisdiction.

VII. Submission of Mr. Harish V. Shankar, Id. CGSC

40. Mr. Shankar, Id. CGSC, relies upon Rule 4 Rules to argue that the conditions prescribed in Rule 4(1)(i)(a) and (b) of the Rules would show that the appropriate office would be the Patent Office where any of the following permutations may arise:

- i) Normal residence of an Applicant;
- ii) Domicile of the Applicant;
- iii) Place of business of the Applicant;
- iv) Place where the invention originated from;
- v) The location of the address for service given by a foreign Applicant.

41. He submits that in view of Rule 4(2) of the Rules, the Appropriate Office by itself cannot be changed ordinarily. It is his submission that Rule 4 prescribes appropriate office for '*all the proceedings under the Act*'. An appeal under the Section 117A is a proceeding envisaged under the Act. Moreover, it is the accepted legal position that appeals are continuation of the original proceeding. Therefore, appeals arising out of the orders passed by the Patent Office ought to be restricted to the High Court having territorial jurisdiction over the appropriate office.

VIII. Submissions of Mr. Adarsh Ramanujan, Id. Counsel assisting the

Court

42. Mr. Adarsh Ramanujan, Id. Counsel, has appeared to assist the Court. His first submission is that the issue of jurisdiction would have to be dealt with separately in respect of trademarks and patents. He refers to the following provisions:

- i) Section 2(7) of the Indian Patent and Designs Act, 1911 defined the term 'High Court' which enumerated the various High Courts having jurisdiction over various territories;
- ii) Section 2(h) of the Trade and Merchandise Marks Act, 1958 defined 'High Court' for the purpose of the said Act. When the said section is read along with Section 3 of the said Act, it is clear that insofar as trademarks are concerned, the jurisdiction of the High Court would be determined on the basis of the location of the office of the Registrar of trademarks within whose territorial limit the principal place of business of the proprietor is situated. This provision, according to Mr. Ramanujan, Id. counsel, was based upon the Report of Justice Ayyangar on Trademark Law Revision of 1955 which recommended that the jurisdiction of the High Court should be governed on the basis of the location of the Trade Mark Office where the application for the registration of the Trade Mark is filed.

43. Emphasis is laid on the fact that similar recommendations were made by the Justice Ayyangar Committee on the Revision of the Patents Law in respect of patents. However, the final statute of 1970 did not accept the recommendation of Justice Ayyangar and defined 'High Court' in a manner

similar to what was defined under Section 2(7) of the Indian Patent and Designs Act, 1911 (*hereinafter 'P&DA 1911'*).

44. It is on the basis of this legislative history, it is submitted by Mr. Ramanujan, ld. counsel, that the definition of 'High Court' under the 1970 Act cannot, therefore, be restricted to the High Court which exercises jurisdiction over the four patent offices. Reliance is also placed on *Neiveli Ceramics v. Hindustan Sanitaryware, ILR (1973) II Delhi, Girdhari Lal Gupta (supra)* and *Ajay Industrial Corporation (supra)*. In *Neiveli (supra)*, the Division Bench while considering section 26 of P&DA 1911 has clearly held that in the context of the said Act, that there is no reason to confine the jurisdiction by applying the tests of Section 20 CPC. It is pointed out that under Section 34 of the P&DA 1911, a reference could be made by one High Court to another. However, the said provision does not exist on the present statute.

45. Mr. Ramanujan, ld. counsel concludes that there are various permutations and combinations that could arise in the case of infringement suits and revocations. The crux of his submission is that all High Courts would have jurisdiction in terms of the definition of 'High Court' under the 1970 Act. However, it is his submission that by sheer deference, one High Court or District Court could stay its own proceedings awaiting the judgment of the other High Court. If, finally, when matters are pending before the two different High Courts, the only recourse would be to invoke Section 25 CPC for seeking transfer of the case from one High Court to another so that the matters can be heard together.

IX. Written Synopsis filed by Mr. Aditya Gupta, ld. Counsel assisting the Court

46. Mr. Aditya Gupta, Id. Counsel, in his written synopsis dated 14th March, 2022 relies upon *Girdhari Lal (supra)* to suggest a framework to determine jurisdiction. Mr. Gupta, Id. Counsel has pointed out that Section 33(3) of the TRA does not cater to a situation where proceedings could have been potentially filed before multiple courts and thus does not give any clarity on the issue. The Id. Counsel highlights the test of ‘*real nexus between the subject matter and the Court*’ as also the test of ‘*dynamic effect*’ evolved in the said case by the Full Bench in the context of design registrations. He argues that applying the tests in *Girdhari Lal Gupta (supra)*, a revocation petition under section 64 of the Patent Act, 1970, or a petition for rectification of a trade mark under Section 47 or 57 of the Trade Marks Act, 1999 can be filed before ‘any High Court’ provided that the applicant is able to show that it has suffered legal injury from the registration within the territorial jurisdiction of the High Court.

47. The Id. Counsel also argues that the dictum of *Girdhari Lal (supra)* cannot be applied to appeal proceedings. To support his submission, he places reliance upon the judgment of Supreme Court in *Godrej Sara Lee Limited v. Reckitt Benckiser Australia Pty. (2010) 2 SCC 535* and the judgment of the Delhi High Court in *M/s Scooters India Ltd. v. M/s Jaya Hind Industries AIR 1988 Delhi 82*. Thus, it is the submission of the Id. Counsel that in appellate proceedings the cause of action arises at the place where the office of the original authority is located. The High Court within whose territorial jurisdiction the cause of action arises will have territorial jurisdiction.

Discussion:

48. Heard. In the case of patents, revocation petitions are original proceedings and Appeals arise from orders passed by the Patent Office. Issues of maintainability of these cases have been raised before this Court. In order to decide issues of maintainability, it would be necessary to trace the historical position under the various patent statutes in India.

Historical Position

1. The Indian Patents and Designs Act, 1911

49. Under the Indian Patents and Designs Act, 1911, (*P&DA 1911*) Section 23F dealt with appeals from any order of the Controller and Section 26 dealt with petitions for revocation of patents. Under Section 23F of the P&DA 1911, all appeals would lie to the High Court of Calcutta from any order of the Controller. Here, it is pertinent to mention that at that time, the head office of Controller of Patents was located in Calcutta. Section 23G of the said Act laid down the procedure for hearing of appeals. Appeals were heard by a Bench of not less than two judges as per Section 23G(1). Sections 23F and 23G are set out herein below:

“Section 23F. Appeals. (1) An appeal shall lie to the High Court at Calcutta from any order of the Controller made under section 23 or section 23A or under clause (a) or clause (b) of sub-section (1) of section 23B or under section 23CC.

(2) Every such appeal shall be made within three months of the date of the order passed by the Controller and shall be in writing.

(3) In calculating the said period of three months, the time, if any, occupied in granting a copy of the order appealed against shall be excluded.

Section 23G. Procedure for hearing of appeals.

(1) When an appeal has been preferred to the High Court at Calcutta under section 23F, it shall be heard by a Bench of not less than two Judges.

(2) The Bench hearing the appeal may, if it thinks fit, and shall on the request of the parties to the appeal, call in the aid of an assessor specially qualified for the purpose, and hear the appeal wholly or partially with his assistance.

(3) The remuneration, if any, to be paid to an assessor under this section shall in every case be determined by the High Court and be paid by it as part of the expenses of the execution of this Act.”

50. Under Section 26 of the P&DA 1911, revocation of a patent, in whole or in part, could be obtained from a High Court by way of a petition or by way of counter claim in a suit for infringement. In addition, under Section 28 of the P&DA, 1911, a High Court could direct the trial of any issue, arising in a petition before it under section 26, either before itself or before another High Court or before a District Court. If the trial of an issue was directed to be before a District Court, the evidence recorded would then be placed before the High Court for disposal. The said provisions – Sections 26 and 28 are set out below:

“Section 26. Petition for revocation of patent.(1)
Revocation of a patent in whole or in part may be obtained on petition to or on a counter-claim in a suit for infringement before a High Court on all or any of the following grounds, namely:”

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“28. Framing issue for trial before other courts.

(1) A High Court may, if it thinks fit, direct an issue for the trial, before itself or any other High Court, or any District Court, of any question arising upon a petition to itself under section 26, and the issue shall be tried accordingly.

(2) *If the issue is directed to another High Court, the finding shall be certified by that Court to the High Court directing the issue.*

(3) *If the issue is directed to a District Court, the finding of that Court shall not be subject to appeal, but the evidence taken upon the trial shall be recorded and a copy thereof, certified by the Judge of the Court, shall be transmitted, together with any remarks which he may think fit to make thereon, to the High Court directing the issue, and the High Court may thereupon act upon the finding of the District Court, or dispose of the petition upon the evidence recorded, or direct a new trial, as the justice of the case may require.”*

51. The term ‘High Court’ was defined originally under Section 2(7) of the Patents and Designs Act, 1911 in the following manner:

“High Court” has the meaning assigned to that expression by the Code of Criminal Procedure, 1898. in reference to proceedings against European British subjects:

52. Later the said definition was substituted with the following definition:

“(7) “High Court” means-

(a) in relation to a State, the High Court for that State;

(b) in relation to the Union territory of Delhi or Himachal Pradesh, the High Court of Punjab;

(c) in relation to the Union territory of Manipur or Tripura, the High Court of Assam;

(d) in relation to the Union territory of Andaman and Nicobar Islands, the High Court at Calcutta; and

(e) in relation to the Union territory of the Laccadive, Minicoy and Amindivi Islands, the High Court of Kerala”

II. Unamended Patent Act, 1970

53. The Patents Act, 1970 repealed the P&DA 1911, insofar as it related to patents. Provisions relating to designs remained unaffected. Under the unamended 1970 Act, petitions for revocation of granted patents could be filed by any ‘person interested’ or the Central Government before the High Court as per Section 64. A petition for rectification of register could also be filed under Section 71 of the said Act before the High Court. Appeals under Section 116(2) would lie to the High Court from a decision, order or direction of the Controller. The definition of ‘High Court’ under Section 2(1)(i) was similar to what was prevalent in P&DA 1911. The said section reads as under:

- (i) “High Court” means, -
- (i) in relation to the Union territory of Delhi and the Union territory of Himachal Pradesh, the High Court of Delhi;
 - (ii) in relation to the Union territory of Manipur and the Union territory of Tripura, the High Court of Assam;
 - (iii) in relation to the Union territory of the Andaman and Nicobar Islands, the High Court at Calcutta;
 - (iv) in relation to the Union territory of the Laccadive, Minicoy and Amindivi Islands, the High Court of Kerala;

MODIFICATION

In its application to the U.T. of Lakshadweep, in S. 2(i)(iv) for the words “Laccadive, Minicoy and Amindivi Islands” substitute the word “Lakshadweep”. – Sec S.O. 432(E) of 1974 – Gaz. of Ind., 21-10-1974, Pt. II, S. 3(i), Ext. p. 1989.

- (v) in relation to the Union territory of Goa, Daman and Diu and the Union territory of Dadra and Nagar Haveli, the High Court at Bombay;

- (vi) *in relation to the Union territory of Pondicherry, the High Court at Madras;*
- (vii) *in relation to the Union territory of Chandigarh, the High Court of Punjab and Haryana; and*
- (viii) *in relation to any other State, the High Court for that State;*

III. Amendments in the Patents Act, 1970 post TRIPS Agreement

54. The enactment of the Trade Marks Act, 1999 and the amendments brought in the Patents Act, 1970 - post the TRIPS Agreement resulted in the creation of the Intellectual Property Appellate Board ('IPAB'). The IPAB was established with effect from 15th September, 2003 under the Trade Marks Act, 1999. A series of amendments made to the 1970 Act gave jurisdiction to the IPAB to deal with patent matters. In brief, the IPAB was to deal with original petitions and appeals under the 1970 Act. The IPAB was headquartered at Chennai, however, hearings were conducted in three other cities also i.e., Delhi, Mumbai, Calcutta in respect of patent matters depending upon the appropriate office of the patent application as originally filed.

55. However, since the IPAB was one single body, issues of jurisdiction i.e., as to in which location the hearings were to be conducted by the Benches of the IPAB, were treated in a much more flexible manner. On most occasions, parties or counsel would give consent for hearing wherever the Bench was available. Thus, the strict issue of jurisdiction usually never arose before the IPAB.

IV. Tribunal Reforms Act, 2021 ('TRA')

56. The enactment of the TRA which came into effect from 4th April, 2021, resulted in the abolition of various tribunals under different statutes. One such tribunal which was abolished by the TRA was the IPAB which was dealing with disputes under the Trade Marks Act, 1999, Copyright Act, 1957 and Patents Act, 1970 and other Intellectual Property statutes. Under Section 33(3) of the TRA, the abolition of the IPAB was immediate and all pending cases before the IPAB were transferred to the High Courts before which they would have been filed had the TRA been in force on the date of filing of such appeal or application or initiation of the proceeding. The High Court to which transfer of cases were affected, has been broadly based on the category of the patent application i.e., MUM/CHN/DEL/KOL– Mumbai, Chennai, Delhi or Kolkata. The manner in which the various States in India have been delineated between the four Patent Offices is as under:

<i>Patent Office</i>	<i>Territorial Jurisdiction</i>
<i>Mumbai</i>	<i>The States of Gujarat, Maharashtra, Madhya Pradesh, Goa, Chhattisgarh, the Union Territories of Daman & Diu and Dadra & Nagar Haveli</i>
<i>Delhi</i>	<i>The States of Haryana, Himachal Pradesh, Punjab, Rajasthan, Uttar Pradesh, Uttarakhand, National Capital Territory of Delhi and the Union Territories of Chandigarh, Jammu and Kashmir, and Ladakh.</i>
<i>Chennai</i>	<i>The States of Andhra Pradesh, Karnataka, Kerala, Tamil Nadu, Telangana and the Union Territories of Pondicherry and Lakshadweep.</i>
<i>Kolkata</i>	<i>Rest of India (States of Bihar, Jharkhand, Orissa, West Bengal, Sikkim, Assam, Meghalaya, Manipur, Tripura, Nagaland, Arunachal</i>

	<i>Pradesh and Union Territory of Andaman and Nicobar Islands)</i>
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57. Before the IPAB, parties mentioned 'JURISDICTION' on the basis of the Patent Office where the patent application was originally filed. Thus, the transfer of pending IPAB matters has been broadly governed by the 'appropriate office' of the patent application/patent concerned. Thus, if the appropriate office of a particular patent application was Mumbai, the jurisdiction in Form 1 was mentioned as Mumbai. Before the IPAB, the hearings in such matters would usually be held in Mumbai and all such cases stood transferred, after the enactment of TRA, to the High Court of Bombay. Similar is the ensuing position in Calcutta/Kolkata, Delhi and Madras/Chennai.

58. The three cases presently under consideration are freshly instituted cases before the Delhi High Court after the enactment of the TRA and they are not cases transferred from the IPAB. In all the three cases, the Respondents have raised issues of maintainability and jurisdiction. It is in the context of the various provisions of the 1970 Act and the changes brought about therein owing to enactment of the TRA that the said issues have to be determined.

ANALYSIS:

59. Under the 1970 Act, High Courts are conferred with various powers, *inter alia*, under the following provisions:

- i. Amendment of patent specifications under Section 58, in any proceeding seeking revocation of a patent;
- ii. Adjudication of revocation of patents under Section 64;

- iii. Rectification of register on the application of any person aggrieved under Section 71;
- iv. Fixation of terms for Central Government use of the patent under Section 100(3);
- v. Fixation of terms under Section 101 for Government use where third party rights are involved;
- vi. Fixation of compensation and terms for acquisition of invention and patent by the Central Government under Section 102(3);
- vii. Adjudication of disputes and fixation of terms for use, or the amount of compensation for the acquisition of patent on reference under Section 103(1);
- viii. Reference to an official referee, commissioner or an arbitrator of any dispute between the patentee and the government under Section 103 of the whole proceedings or any question or issue of fact arising therein under Section 103(5);
- ix. Adjudication of suits for infringement under Section 104;
- x. Adjudication of counter claims for revocation in suits for infringement under Section 104;
- xi. Issuing of certificate of validity of a patent under Section 113(1);
- xii. Adjudication of appeals from a decision, order or direction of the Controller or the Central Government under Section 117A(2).

60. A perusal of the above provisions shows that High Courts exercise both- original and appellate jurisdiction under the 1970 Act. The definition of 'High Court' as originally contained in the unamended Patent Act, 1970 was substituted vide the Patent (Amendment) Act, 2005 and a new

definition was put in place. Section 2(1)(i) of the 1970 Act, which now defines the term ‘*High Court*’ in relation to a State or Union territory, reads as under:

“High Court”, in relation to a State or Union territory, means the High Court having territorial jurisdiction in that State or Union territory, as the case may be”.

61. The question that arises is as to what constitutes ‘territorial jurisdiction’ for the purposes of the provisions of the 1970 Act in respect of powers exercised by the High Court. Would the territorial jurisdiction of a High Court for the purpose of ‘appeals’ and ‘other proceedings’ be differently construed?

62. Insofar as suits for infringement of patents are concerned, the issue of jurisdiction is clearly governed by Section 104 read with the provisions of the Code of Civil Procedure. For the present purposes, this Court is not dealing with suits for infringement of patents. The two types proceedings in respect of which contours of territorial jurisdiction of High Court is presently being considered are –

- i. Revocation petitions under Section 64 of the 1970 Act filed as original proceedings before the High Court;
- ii. Appeals under section 117A of the 1970 Act against orders passed by the Patent Office.

Revocation Petitions Under Section 64 of the Patents Act, 1970 Post the Enactment of the Tribunal Reforms Act, 2021

63. As already noted above, revocation petitions under Section 64 of the 1970 Act can be filed as original proceedings by any ‘person interested’ or by the Central Government or as counter claims in a suit for infringement of

a patent. In the present judgment, the Court is only concerned with the former and not with the latter, as in the case of a counter claim it would obviously be filed before the Court where the suit for infringement is already pending.

64. Prior to the enactment of the TRA, revocation petitions were maintainable both before the IPAB, as original proceedings, as also before the High Court in a counter claim in a suit for infringement of a patent. Various decisions have been rendered by High Courts and by the Supreme Court dealing with the scheme of revocation of patents under the Act when the IPAB was functioning. In *Aloys Wobben v. Yogesh Mehra (2014) 15 SCC 360* the Supreme Court held that a person seeking revocation has to choose the forum and maintain the revocation before one forum and not before multiple forums.

65. However, with the enactment of the TRA, revocation petitions would only be maintainable before the High Court. Even if a suit for infringement is filed before the District Court, in view of the proviso to Section 104 of the 1970 Act, upon filing of the counter claim, the entire matter is to be mandatorily transferred to the concerned High Court. Thus, High Courts can deal with suits for infringement coupled with counter claims for revocation of patent.

66. The question before this Court is as to in which High Court would revocations petitions, which are filed purely as original proceedings, be maintainable. Under Section 64, revocation petitions are filed by persons interested. Section 2(1)(t) of the Act defines 'person interested' as under:

“(t) “person interested” includes a person engaged in, or in promoting, research in the same

field as that to which the invention relates”

67. The said terminology has been held by Courts to mean any person who is affected by the grant or continuation of a patent on the Register of patents. Such person is usually a person who is aggrieved by the grant or who has opposed the grant, or who seeks revocation of the patent even in public interest. Thus, persons interested would, *inter alia*, include:

- manufacturers, sellers, exporters, importers of a product related to the patented invention;
- persons engaged in research in the field of the invention;
- persons who may be funding such research, *etc.*

68. The definition of ‘person interested’ is an inclusive one and has been broadly interpreted by Courts. The Supreme Court in *Aloys Wobben (supra)* interpreted ‘person interested’ in the following manner:

*“20. A corrective mechanism is also available to "any person interested", to assail the grant of a patent Under Section 64(1) of the Patents Act. This is in addition, to a similar remedy provided to "any person interested", Under Section 25(2) of the Patents Act. In the above scenario, it is necessary to first appreciate the true purport of the words "any person interested". The term "person interested" has been defined in Section 2(1)(t) of the Patents Act. Unless the context otherwise requires, in terms of Section 2(1)(t) aforementioned, a "person interested" would be one who is..."engaged in, or in promoting, research in the same field as that to which the invention relates". **Simply stated, a "person interested" would include a person who has a direct, present and tangible interest with a patent, and the grant of the patent, adversely affects his***

above rights. A "person interested" would include any individual who desires to make independent use of either the invention itself (which has been patented), or desires to exploit the process (which has been patented) in his individual production activity. Therefore, the term "any person interested" is not static. The same person, may not be a "person interested" when the grant of the concerned patent was published, and yet on account of his activities at a later point in time, he may assume such a character or disposition. It is, therefore, that Section 64 of the Patents Act additionally vests in "any person interested", the liberty to assail the grant of a patent, by seeking its revocation. The grounds of such challenge, have already been enumerated above."

69. It is, therefore, clear that a large number of persons could be 'persons interested' in respect of a patented invention. The grant of a patent has an all-India effect. Once granted, the exclusive rights of the patentee spelt out in section 48 of the 1970 Act extend to the entire length and breadth of the country. Persons who are interested in seeking the revocation of the patent could, therefore, be located in any part of the country where the factum of grant and its effect would determine their conduct. For example, a person may be prevented from continuation of a particular research for commercial purpose, a person may be prevented from manufacturing or selling a particular product or an entity may be prevented from expanding its manufacturing activities due to grant of a patent. Thus, the effect of the patent could be felt wherever the conduct of the person interested is likely to be affected.

70. The patent applicant may have filed the patent application in the

Patent Office of a particular jurisdiction and the prosecution thereof may be at the ‘appropriate office’ as per Rule 4 of the Rules. However, the effect of the grant is not restricted to that jurisdiction. In recent times, it is also possible that patent applications are marked for examination to an official in a different Patent Office than the appropriate office. In either situation, the grant is not confined to the appropriate office or the examining office, as the effect is nationwide.

71. When viewed in this backdrop, the High Court having territorial jurisdiction in respect of revocation petitions under section 64 of the Act has to be construed not merely on the basis of appropriate office or the examining office, but on the basis of where the cause of action for filing a revocation petition arises. Cause of action, as per settled law, is a bundle of facts, which gives rise to a particular proceeding. The Supreme Court in ***Kusum Ingots (supra)*** has defined the term ‘cause of action’ as under:

“6. Cause of action implies a right to sue. The material facts which are imperative for the suitor to allege and prove constitutes the cause of action. Cause of action is not defined in any statute. It has, however, been judicially interpreted inter alia to mean that every fact which would be necessary for the plaintiff to prove, if traversed, in order to support his right to the judgment of the Court. Negatively put, it would mean that everything which, if not proved, gives the defendant an immediate right to judgment, would be part of cause of action. Its importance is beyond any doubt. For every action, there has to be a cause of action, if not, the plaint or the writ petition, as the case may be, shall be rejected summarily.”

72. In ***Nawal Kishor Sharma v. Union of India AIR 2014 SC 3607***, the

Supreme Court relied upon the dictum of *Kusum Ingots (supra)* and held as under:

*“11. On a plain reading of the amended provisions in Clause (2), it is clear that now High Court can issue a writ when the person or the authority against whom the writ is issued is located outside its territorial jurisdiction, if the cause of action wholly or partially arises within the court's territorial jurisdiction. Cause of action for the purpose of Article 226(2) of the Constitution, for all intent and purpose must be assigned the same meaning as envisaged Under Section 20(c) of the Code of Civil Procedure. The expression cause of action has not been defined either in the Code of Civil Procedure or the Constitution. **Cause of action is bundle of facts which is necessary for the Plaintiff to prove in the suit before he can succeed.**”*

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19. Regard being had to the discussion made hereinabove, there cannot be any doubt that the question whether or not cause of action wholly or in part for filing a writ petition has arisen within the territorial limit of any High Court has to be decided in the light of the nature and character of the proceedings under Article 226 of the Constitution. In order to maintain a writ petition, the Petitioner has to establish that a legal right claimed by him has been infringed by the Respondents within the territorial limit of the Court's jurisdiction.”

73. In the context of a petition filed for revocation of patent, the cause of action could, *inter alia*, arise at any of the following places:

- (i) Place where the patent application is filed;
- (ii) Place where the patent is granted;

- (iii) Place where the manufacturing facility of a person interested is located;
- (iv) Place where cease and desist notice may be served or replied from;
- (v) Place where patentee resides or carries on business i.e., manufactures or sells the patented invention;
- (vi) Place where the approval for manufacture or sale of product has been granted, but the same is prevented due to the existence of the patent;
- (vii) Place where the import of the product may be interdicted due to the existence of the patent;
- (viii) Place from where the export of product is being stopped due to existence of the patent;
- (ix) Place where research on a commercial scale in respect of the patented subject matter is curtailed;
- (x) Place where the suit for infringement has been filed;

74. Though the above list is merely illustrative and non-exhaustive, on the basis of the above situations, it can be clearly gleaned that the High Court having territorial jurisdiction, in the context of an original revocation petition, would include a High Court in the jurisdiction of which any of the above causes of action could arise. In sum and substance, wherever the effect of the patent is felt would be the place which has nexus with the *lis* and, there are revocation petition under Section 64 could be maintainable. This is also clear from a reading of the decision of the Full Bench of this Court in ***Girdhari Lal Gupta v. K. Gian Chand Jain & Co. AIR 1978 Delhi 146,***

where the Court was dealing with Section 51A of the now repealed Designs Act, 1911(*hereinafter 'DA 1911'*). Section 51A of the said Act reads as under:

“51A. Cancellation of registration- (1) *Any person interested may present a petition for the cancellation of the registration of a design-*

(a) *at any time after the registration of the design, to the High Court on any of the following grounds, namely:-*

(i) that the design has been previously registered in India; or

(ii) that it has been published in India prior to the date of registration; or

(iii) that the design is not a new or original design;or

(b) within one year from the date of the registration, to the Controller on either of the grounds specified in sub-clauses (i) and (ii) of clause (a).

(2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.”

75. The designs in *Girdhari Lal Gupta (Supra)* were granted registration by the Patent Office located at Calcutta. However, petitions for cancellation of designs were filed in the Delhi High Court. The Id. Single Judge held that the petitions for cancellations of designs could be filed in any High Court in India as the Act had not vested exclusive jurisdiction in the High Court of Calcutta. Appeals were preferred against the order of the Id. Single Judge which were heard by the Id. Full Bench.

76. The Full Bench went on to consider the differences between the two elements i.e., the registration of the design and the effects of the registration of the design. It brought out the distinction between the static effect and the

dynamic effect of the registration of a design. The static effect would be the grant of the design registration and its continuation. However, the dynamic effect would be wherever the exclusionary effect of the registration are felt leading to monopolist situation and the injury caused to others due to the same. Relevant paragraphs of the said judgment are set out below:

“10. What is jurisdiction? It is the power of a court over a territory and a subject-matter. Power over a territory in itself is not sufficient. The territory is significant only as being the place at which the subject matter is situated. If the subject-matter is outside the territory, the court would not have jurisdiction over it for the simple reason that the subject matter would fall within the territorial jurisdiction of some other court.

The test of the territorial jurisdiction of a court is, therefore, “whether the case relates to the general category of subject matter assigned by law to the Tribunal (or the court)” (Rubinstein- Jurisdiction and illegality page 218). Dr. Rubinstein supports his proposition by referring to the observation of Dixon J. in R. v. Hickman Exp. Fox & Clinton (1946) 70 C.L.R. 598 at 615(4), holding that a privative clause will not be excluded provided the tribunal's decision is a bona fide attempt to exercise its power, that it relates to the subject matter of the legislator and that it is reasonably capable of reference to the power given to that body'. Thus, the prima facie relationship between the case and the subject-matter prescribed by law is relevant criterion for jurisdiction (ibid 218-219).

Nexus between subject matter & jurisdiction

11. Where more than one authorities or courts are invited to exercise jurisdiction, it is relevant to inquire as to which of them has the real connection with subject-matter over which the jurisdiction is to be exercised. This inquiry will result in giving

jurisdiction to the court having the nexus with the subject matter and correspondingly in showing that the other courts which do not have a similar connection with the subject matter would not have jurisdiction over it. For instance, section 2(a)(i) of the Industrial Disputes Act defines “appropriate Government” to mean the Central Government in relation to industrial disputes concerning certain specified industries. Section 2(a)(ii) of the said Act enacts the residuary definition as follows: “In relation to any other industrial dispute, the State Government” Just as the definition of a “High Court” in S. 2 (7) gives the list of all the High Courts in India, similarly the expression “State Government” would bring in each and every State Government in India. Just as the question before us is which of the High Courts has the jurisdiction to entertain an application under Section 51-A, the question arose before the Supreme Court in the case referred to below as to which the State Governments had the jurisdiction to make a reference of an industrial dispute under section 10(1)(d) of the industrial Disputes Act. The line of reasoning followed by the court in Workmen of Shri Rangavilas Motors (P.) Ltd. v. Shri Rangavilas Motors (P.) Ltd. & others. (1967) 2 S.C.R. 528 at 534 (5), is instructive for us. Their Lordships observed as follows:

“The order of transfer, it is true, was made in krishnagiri at the head office, but the order was to operate on a workman working in Bangalore. In our view the High Court was right in holding that the proper question to raise is: where did the dispute arise? Ordinarily, if there is a separate establishment and the workman is working in that establishment, the dispute would arise at that place. As the High Court observed,

there should clearly be some nexus between dispute and the territory of the State and not necessarily between the territory of the State and the industry concerning which the dispute arose."

What is the subject-matter of an application under section 51-A? It was argued at length by Mrs. Shyamla Pappu that the subject-matter of such an application was the registration of a design by an entry made in the Register of Designs which is maintained in the Patent Office under section 46 of the Act. She argued that the subject-matter consisted, Therefore, only of the act of registration and continuance of registration both of which were situated at the place at which the Register of Designs happens to be kept. According to the learned counsel, the definition in section 2 (7) of the Act of "High Court" can also be explained on the same theory of subject matter. The legislature did not mention in the Act the place at which the Patent (Designs) Office and the Register of Designs would be maintained. The legislature, therefore, had to provide a list of the High Courts in India in defining a "High Court", so that the territorial jurisdiction would accrue to that High Court in the local limits of which the registration would happen to be made and would happen to be continued. Her argument, therefore, was that it is a mere accident that the office of the Register of Designs happens to be at Calcutta and, therefore, the High Court at Calcutta would have the jurisdiction over the subject matter of these applications made under section 51-A. It was open, however, for the Government to shift the Designs Office to any other place in India with the result that the subject matter of an application under section 51-A would then arise at the place where the Designs Office is shifted and such a

place may be within the local limits of a High Court other than Calcutta High Court.

12. The strength of this argument depends on the correctness of its assumption that the subject-matter consists only of the registration and the continuance of the registration of a design. This takes into account only the static effect of the registration. But the registration gives the registered proprietor of the design a monopoly of the copyright in the design and this extends to all the territories of India to which the Act applies. The impact of the registration, Therefore, travels beyond the place of registration. This is the dynamic aspect of the effect of registration.

13. An analysis of section 51-A yields two distinct elements. The first element is the registration of the design and the effects of the registration - static and dynamic. The second is the capacity to make the application being vested only in a person interested. It is only when both these elements co-exist that an application under section 51-A can be made for the cancellation of the registration on all or any of the grounds specified therein. Let us now further consider each of these two elements of section 51-A.

EFFECTS OF REGISTRATION.

14. If the cause of action for an application for cancellation is only the static effect of the registration then it is confined to the place where the registration is made and is continued. Since the Register is kept presently at Calcutta, the High Court of Calcutta would have jurisdiction over the place at which the cause of action arises due to the static effect of the registration. What about the dynamic effects of the registration which prevents any person other than the registered proprietor of the design from using the said design in any of the territories to which the Act applies? This

prevention may be of two kinds. Firstly, a person may intend to use the registered design but is prevented from carrying out his intention into practice because he would be thereby infringing the copyright created by the registered design and would, therefore, be contravening the law. The cause of action in favor of such a person consists only of the existence of the registration. Since such a cause of action arises only at the place of the registration, it is only that High Court which has jurisdiction over the place of registration which can entertain an application under Section 51-A for the cancellation of the design from such a person.

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22. For the above reasons, we find that the petition for cancellation of the design under section 51-A would lie to that High Court within the territory of which subject matter has the necessary nexus. The subject matter consists of a series of connected events beginning with the registration of the design in the register of designs by the order of the Controller and ending with the impact of the said design on the rights of the competitors at such places at which the trading of the competitors is injured or affected by the enjoyment of the copyright by the registered proprietor of the design basing his right on the registration of the design. An application may, therefore, be filed either in the High Court having jurisdiction over the place at which the design is registered or in the High Court having jurisdiction over the place at which enjoyment of the copyright by the registered proprietor causes injury to the commercial interests of the applicant. Briefly, the application would be made in the High Court, the local jurisdiction of which has a nexus with the subject

matter or the cause of action of the application. It follows, therefore, that the application cannot be made in any other High Court merely because the applicant chooses to do so. **The applicant would have to show jurisdiction in the High Court to which the application is made and such jurisdiction can be shown only by establishing connection between the cause of action and/or subject matter of the application and the territory within the local jurisdiction of the High Court.** While such an application can always be made to the High Court within the local limits of which the registration of the design is made, the jurisdiction is not confined to that High Court, but would extend to any other High Court within the local limits of which a part of the cause of action and/or subject matter of the application may arise. This view differs from the view of the learned single Judge and the other decisions of this court relied in the order under appeal. We also differ from the view expressed by K. T. Desai J. of the High Court of Bombay in the Kohinoor Mills Co.'s Case

23. We have not considered the question whether the High Court acting under section 51-A being a court of civil jurisdiction, the procedure laid down in the code of Civil Procedure would be applicable to the proceedings before it. For, we do not consider it necessary to express any view in this particular case as to whether the determination of jurisdictional facts which have to exist before the High Court can take up jurisdiction would be an enquiry into what procedure would be applicable to an application under section 51-A after the High Court entertains it. The jurisdictional conditions have to be satisfied before the High Court can entertain such an application. Consequently, we have not considered whether the jurisdiction of the

High Court would depend on the presence of the defendant or non-applicant within the local jurisdiction, that is to say, the residence of or carrying on of business by the defendant within the local jurisdiction of the High Court on the analogy of section 20 of the Code of Civil Procedure. We have therefore, attempted to determine the question of jurisdiction of the High Court independently of the applicability of the provisions of the Code of Civil Procedure.”

77. The ratio of *Girdhari Lal Gupta (supra)* can, therefore, to be summarized as under:

- i. The static effect of the designregistration has to be considered i.e., the High Court under whose territorial jurisdiction the Patent Office granting the registration is located would have jurisdiction to entertainthe cancellation petition;
- ii. Dynamic effect of the designregistrationalso has to be considered i.e., in the case of cancellation, wherever the commercial interest of the person interested is affected, such a High Court would have necessary nexus with the subject matter and thus jurisdiction to entertain the cancellation petition;
- iii. The jurisdictional facts would have to exist for a High Court to exercise jurisdiction.

78. As already pointed out, the judgment in *Girdhari Lal Gupta (supra)* was rendered in the context of the DA 1911. The same has also been followed by the Id. Division Bench of this Court in *Ajay Industrial Corporation v. Shiro Kanao of Ibaraki City AIR 1983 Delhi 496* where the Court was dealing with two petitions filed under section 64 of the Act seeking revocation of patents. The background facts are that a suit for

infringement was filed before the District Court in Ahmedabad prior to the filing of the applications for revocation before the Delhi High Court. An objection as to territorial jurisdiction was raised by the patentee which was rejected by the High Court after analysing the judgment of the Full Bench in *Girdhari Lal Gupta (supra)*. The Division Bench held that a revocation petition could be filed where the registration is granted, where the suit for infringement has been filed, and where a part of cause of action arises i.e., where there is an injury to the commercial interest of the person interested. The relevant observations of the Court are as under:

“4. ...Turning to (i), the only guidance that the statute provides regarding the High Court in which the application should be moved is contained in the definition in Section 2(i) which reads:

"High Court" means-

(i) in relation to the Union Territory of Delhi the High Court of Delhi;

(viii) in relation to any other State, the High Court for that State.

This definition is not helpful for it says nothing more than that the suit should be instituted in the High Court of the State in relation to which the matter arises; it does not define the nature, or method for determination, of the relationship between a State and the matter in question. What, then, can be the basis on which one can decide which High Court should be approached in a particular matter? What is to be the basis of the correlation? Sri Anoop Singh suggests it can only be either the place of registration of the patent or the place in which a suit for infringement has been filed, if any, and none else. This does not appear to be correct. It will not be possible to correlate the jurisdiction with the State in which the place of

registration of the patent is situate for all registration of patents in India is done only at Calcutta and three or four other cities in India and the elaborate provision in Section 2(i) will be totally superfluous if the intention was to confine jurisdiction to the four or five High Courts having jurisdiction over these cities. The statute would then have easily defined the High Court as the one having jurisdiction over the place of registration of the patent sought to be revoked. It is also obviously not possible to restrict jurisdiction to the High Court within the territorial jurisdiction of which a suit for infringement is filed. For, while no doubt such a High Court will be the forum for deciding the issue when the revocation of a patent is sought by way of a counter-claim (vide Section 104, Proviso), that provision is not exhaustive. **The revocation of a patent need not be sought only by way of a counterclaim. Section 64 confers an independent right on any person interested in a patent or the Central Government to seek such revocation. Such an application can be made even when no suit for infringement is pending against the applicant. It can also be made where such a suit is pending. There is no statutory requirement that in a case where a suit for infringement is pending, revocation of the patent can be sought for only by way of a counter-claim and not by way of a separate and independent application. Thus, the statutory provisions show that the remedy of seeking the revocation of a patent from a High Court is not correlated to the pendency of an action for infringement but is made available to any person who finds that his commercial interests are likely to be jeopardised or injured by the claims of the owner of a patent.** If this apprehension has already become a reality by reason of a suit for infringement filed

against him he is given a right to seek revocation by way of counterclaim in that suit. But it is also open to him to seek the remedy by an independent application, whether or not a suit against him has already been instituted. It would not, therefore, be correct, in principle, to confine jurisdiction to the High Court having ordinary original or appellate jurisdiction over a place where a suit for infringement may have been filed. It does not solve the problem in a case where no suit for infringement has been filed. The plea of Sri Anoop Singh that an application under Section 64 should be filed only in the High Court at the place of registration with the exception that, in case there is a pending suit for infringement, the application may be filed also in the High Court having jurisdiction over the place where the suit is filed cannot, therefore be accepted. The statute would have more clearly spelt out the position if such were its intendment.”

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“6. It is, therefore, seen that the earlier view of this Court was that an application of this type could be filed in any High Court in India. The decision of the Full Bench, by a majority, took a restricted view but even the Full Bench does not restrict jurisdiction in the manner contended for by Sri Anoop Singh. On the ratio of the Full Bench, the application could be filed in the Calcutta High Court or any other High Court within whose jurisdiction the commercial interests of the applicant are affected by the enjoyment of the copyright by the registered proprietor. This would include not only the High Court having jurisdiction over a place in which a suit for infringement is filed but also that having jurisdiction over a place where the Assessee carries on business and finds that his rights to

carry on the business freely is sought to be restricted on account of the claim of someone else to a patent or design in respect of the goods dealt in by him. It is true that this interpretation may expose the registered proprietor of a patent to applications filed in different High Courts by persons carrying on business within their respective jurisdiction. But, (a) that was also the position under the earlier decisions; (b) that is because the registration of the patent though done in one place affects persons carrying on business in different jurisdictions; and (c) the only solution that can avoid such multiple action against the proprietor of the patent (viz. to restrict jurisdiction only to the High Court with jurisdiction over the place of registration of the patent) is clearly not countenanced by the statute.

7. *It is perhaps possible to advocate an intermediate view, narrower than the one enunciated by the Full Bench and slightly broader than the one suggested by Sri Anoop Singh. **This would be on the basis of the provisions of the Code of Civil Procedure. The suggestion can be that such applications can be filed either at a place where the patent-holder resides or carries on business or a place where the cause of action (in a more restricted sense) arises viz., the place where the patent is registered or the place or places where the applicant has been sought to be made liable for infringement of patent.** It can perhaps be said that where no such action against the applicant is pending, it would not be correct to say that he has a cause of action against the registered proprietor other than the one arising as a result of the registration of the patent. However, this may also be not quite a correct approach. For instance, to take the instant case itself, the applicant is facing an action for infringement only*

in Ahmedabad. But it is selling the same goods in Delhi as well and may face a similar action in respect thereof at any moment either in the form of a separate suit or even by way of an amendment to the existing suit. It may, therefore, be unrealistic to say that he has no cause of action arising in Delhi but has one only at Ahmedabad. Thus, the suggestion of such a modified interpretation is also not free from difficulties. Whether we go by the Full Bench (as we do and should) or by the earlier decisions of this Court, the Delhi High Court has jurisdiction to entertain the Appellant's applications. The objections of Sri Anoop Singh as to lack of jurisdiction are, therefore, overruled.”

79. In *Ajay Industrial (supra)* the Court explicitly rejected the argument that once a suit for infringement of patent is filed, the person interested can challenge the patent only by way of counter-claim and not by way of a separate and independent application. The Court was of the view that Section 64 confers an independent right to any person interested in a patent or the Central Government to seek such revocation. As per *Ajay Industrial (supra)* wherever the ‘commercial interest’ of the applicant is affected, a revocation could be filed in the concerned High Court.

80. The High Court of Himachal Pradesh in *MSN Laboratories Pvt. Ltd. v. The Controller of Patents [OMPs No.162 & 230 of 2022, decided on 2nd June, 2022]* has also taken a similar view. In the said case the patent was granted by the Patent Office, Delhi. However, the Defendant, who was carrying on business in the territory of the Himachal Pradesh, filed a revocation petition in the High Court of Himachal Pradesh. While holding that the Court had territorial jurisdiction to entertain the revocation petition, the Court observed as under:

“21. Now, this Court will address the issue of return of the revocation petition in terms of the provisions of Order VII, Rule 10 of the Code of Civil Procedure. It is not much in dispute that on the strength of the patent, revocation of which has been sought by the plaintiff, business is being carried out by the defendant in the territorial jurisdiction of the State of Himachal Pradesh. The Court is not oblivious to the fact that the patent in issue has been granted by the Controller of Patents at New Delhi, but then there is no bar that a petition for revocation of patent cannot be filed in any other Court except the Court having territorial jurisdiction over the Controller of Patents. **The patent so granted by the Controller of Patents is used by the patent holder throughout the territory of India and in this view of the matter, holding that such a patent can be challenged only before the Courts within the jurisdiction of which the Controller of Patents is situated, will on the one hand burden the said Courts with the revocation petition which may be filed by parties assailing the patent and on the other hand shall exclude other Courts from exercising their jurisdiction of going into the validity of patents, on the strength of which business is being carried out within their territorial jurisdiction.**

22. Therefore, this Court holds that the plaintiff has the right to invoke the territorial jurisdiction of this Court and the plaint is not liable to be returned under the provisions of Order VII, Rule 10 of the Code of Civil Procedure.”

81. Section 48 of the 1970 Act vests exclusive rights in the patentee for making, using, offering for sale, selling or importing the patented product or any product made using the patented process. The impact of such a patent can be felt wherever a person interested carries on its business, including for

manufacturing or selling or even packing or distributing the product in respect of which patent has been granted. Thus, the commercial interest of the person interested could be affected in various other jurisdictions apart from the jurisdiction where the patent was granted. Such a person may be aggrieved by the incorrect grant of the patent and may even challenge the validity of the patent.

82. Undoubtedly, the High Court in whose jurisdiction the patent was granted would be one of the fora which would have jurisdiction as the cause of action consists of a series of events beginning with the grant of the patent. In the opinion of this Court, since the dynamic effect of the patent, as contemplated in *Girdhari Lal Gupta (supra)*, would also extend to other places where the commercial interest of the person interested may be affected, such other High Courts would also have jurisdiction to entertain revocation petitions, under section 64 of the Act. Thus, the expression ‘High Court having territorial jurisdiction in that State or Union Territory’ in case of revocation petitions would have to be decided on the basis of both the static effect and the dynamic effect of the grant of the patent. The place where the commercial interest of the applicant is affected would also be a relevant consideration to determine jurisdiction.

Appeals Under Section 117A of the Patents Act, 1970

83. Under the 1970 Act, appeals are filed and maintained under Section 117A. The said provision reads as under:

“117A. Appeals to High Court. (1) Save as otherwise expressly provided in sub-section (2), no appeal shall lie from any decision, order or direction made or issued under this Act by the Central Government, or from any act or order of

the Controller for the purpose of giving effect to any such decision, order or direction.

(2) An appeal shall lie to the High Court from any decision, order or direction of the Controller or Central Government under section 15, section 16, section 17, section 18, section 19, section 20, sub-section (4) of section 25, section 28, section 51, section 54, section 57, section 60, section 61, section 63, section 66, sub-section (3) of section 69, section 78, sub-sections (1) to (5) of section 84, section 85, section 88, section 91, section 92 and section 94.

(3) Every appeal under this section shall be in the prescribed form and shall be verified in such manner as may be prescribed and shall be accompanied by a copy of the decision, order or direction appealed against and by such fees as may be prescribed.

(4) Every appeal shall be made within three months from the date of the decision, order or direction, as the case may be, of the Controller or the Central Government or within such further time as the [High Court] may, in accordance with the rules made by it allow. ”

84. It is the settled position in law that an appeal is a continuation of the original proceedings.¹ Under Section 117A of the Act, appeals are maintainable from any decision, order or direction made or issued under the Act either by the Central Government or from the orders of the Controller. If the appeal is against any decision, order or direction of the Central Government, the same would then be governed by the general principles of

¹M/S Ramnath Exports Pvt. Ltd. v. Vinita Mehta & Anr., (2022) 7 SCC 678; Malluru Mallappa v. Kuruvathappa and Others, (2020) 4 SCC 313; Hindustan Petroleum Corp. v. Dilbahar Singh (2014) 9 SCC 78; M/s Diamcad NV v. Assistant Controller of Patents and Designs OA/4/2009/PT/CH

law as laid down in the decision rendered by the Supreme Court in *Kusum Ingots and Alloys Ltd. v Union of India (supra)* and subsequent decisions in *Mosaraf Hossain Khan v. Bhageeratha Engg. Ltd. (2006) 3 SCC 658* and *Nawal Kishore Sharma v. Union of India AIR 2014 SC 3607*.

85. In the present case, however, the appeal being dealt with is not in respect of an order or direction by the Central Government but from a decision of the Patent Office rejecting the patent application of the Appellant. Where would such an appeal lie? The question is further complicated by the recently adopted practice by the CGPDTM where a patent application filed in one Patent Office can be randomly allocated for examination to a different Patent Office. Would such a practice entitle the Patent Applicant to invoke the jurisdiction of a High Court where the said randomly allotted Patent Office is located?

86. A patent application under Section 7 of the Act is filed in the Patent Office as defined under Section 2(1)(r) read with Section 74 which read as under:

“2. Definitions and interpretation-(1) In this Act, unless the context otherwise requires,-

(r) “patent office” means the patent office referred to in section 74;

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74. Patent office and its branches - (1) For the purposes of this Act, there shall be an office which shall be known as the patent office.

(2) The Central Government may, by notification in the Official Gazette, specify the name of the Patent Office.

(3) The head office of the patent office shall be at such place as the Central Government may specify, and for the purpose of facilitating the registration of patents there may be established, at such other places as the Central Government may think fit, branch offices of the patent office.

(4) There shall be a seal of the patent office.”

87. The Indian Patent Office functions from four locations i.e., Kolkata, Delhi, Chennai, Mumbai. Section 7 provides that a patent is to be filed in the 'Patent Office'. The term 'Patent office' is defined in Section 2(1)(r) with reference to Section 74 as per which the Central Government is to notify the Patent offices including the Head Office and branch offices. As per clause 03.02 of the Manual of Patent Office Practice and Procedure [version 3.0, published on 26th November, 2019] (hereinafter 'Manual'), which codifies the practice and procedures being followed by the Indian Patent Office, the territorial jurisdiction of each of the Patent Offices and the office where the patent applications are to be filed is elaborated as under:

“Jurisdiction

Unlike many other Countries, Indian Patent Office functions from four locations viz. Kolkata, Delhi, Chennai and Mumbai for carrying out all procedures relating to patents.

An application for patent shall be filed with the Patent Office having appropriate jurisdiction. A territorial jurisdiction of patent office in respect of a patent application is decided based on any of the following:

- i. Place of residence, domicile or business of the applicant (first mentioned applicant in case of joint applicants) or,*
- ii. Place from where an invention actually originated or,*

- iii. *Address for service in India given by the applicant, when the Applicant has no place of business or domicile in India (Foreign applicants).*
- iv. *Also, the further application referred to in section 16 of the Act shall be filed at the appropriate office of the first mentioned application only.*

Territorial jurisdictions are as under:

<i>Patent Office</i>	<i>Territorial Jurisdiction</i>
<i>Mumbai</i>	<i>The States of Gujarat, Maharashtra, Madhya Pradesh, Goa, Chhattisgarh, the Union Territories of Daman & Diu and Dadra & Nagar Haveli</i>
<i>Delhi</i>	<i>The States of Haryana, Himachal Pradesh, Punjab, Rajasthan, Uttar Pradesh, Uttarakhand, National Capital Territory of Delhi and the Union Territories of Chandigarh, Jammu and Kashmir, and Ladakh.</i>
<i>Chennai</i>	<i>The States of Andhra Pradesh, Karnataka, Kerala, Tamil Nadu, Telangana and the Union Territories of Pondicherry and Lakshadweep.</i>
<i>Kolkata</i>	<i>Rest of India (States of Bihar, Jharkhand, Orissa, West Bengal, Sikkim, Assam, Meghalaya, Manipur, Tripura, Nagaland, Arunachal Pradesh and Union Territory of Andaman and Nicobar Islands)</i>

An appropriate office where a patent application is filed shall not be ordinarily changed.

However, the Controller may allocate an application for patent to any of the four Patent Offices, if required.

All applicants and patent agents are required to give an address for service including postal address in India, an email address and a mobile number registered in India.

Such address for service shall be considered for all proceedings under the Patents Act and Rules.”

88. Rule 4(1) of the Patent Rules, 2003 defines ‘appropriate office’ as under:

“4. Appropriate office.— (1) *The appropriate office of the patent office shall—*

(i) *for all the proceedings under the Act, be the head office of the patent office or the branch office, as the case may be, within whose territorial limits—*

(a) *the applicant or first mentioned applicant in case of joint applicants for a patent, normally resides or has his domicile or has a place of business or the place from where the invention actually originated; or*

(b) *the applicant for a patent or party in a proceeding if he has no place of business or domicile in India, the address for service in India given by such applicant or party is situated; and*

(ii) *[Omitted by Patents (Amendment) Rules, 2006]*

(3) *The appropriate office once decided in respect of any proceedings under the Act shall not ordinarily be changed.*”

89. Thus, at the time of filing of a patent application, the appropriate office in respect of the said patent application, ordinarily, is frozen i.e.,

- it is decided on the basis of either the place where the applicant or one of the applicants normally resides or has domicile or has a place of business or the place where the invention originated or;

- it is decided on the basis of the address for service of the applicant in India in case of a foreign applicant.
90. The term ‘appropriate office’ as defined in Rule 4 is used on several occasions in the Rules. Some of such Rules are extracted below:

“Rule 28

Procedure in case of anticipation by prior publication

*(6) The hearing may also be held through video-conferencing or audio-visual communication devices: **Provided that such hearing shall be deemed to have taken place at the appropriate office.***

Rule 55

Opposition to the patent

(1) Representation for opposition under sub-section (1) of section 25 shall be filed in Form 7(A) at the appropriate office with a copy to the applicant, and shall include a statement and evidence, if any, in support of the representation and a request for hearing, if so desired.

Rule 55A

Filing of notice of opposition

The notice of opposition to be given under sub-section (2) of section 25 shall be made in Form 7 and sent to the Controller in duplicate at the appropriate office.

Rule 58

Filing of reply statement and evidence

(1) If the patentee desires to contest the opposition, he shall leave at the appropriate office a reply statement setting out fully the grounds upon which the opposition is contested and evidence, if any, in

support of his case within a period of two months from the date of receipt of the copy of the written statement and opponent's evidence, if any by him under rule 57 and deliver to the opponent a copy thereof.

Rule 59

Filing of reply evidence by opponent

The opponent may, within one month from the date of delivery to him of a copy or the patentee's reply statement and evidence under rule 58, leave at the appropriate office evidence in reply strictly confined to matters in the patentee's evidence and shall deliver to the patentee a copy of such evidence.

Rule 74A

Inspection of documents related to grant of patent

After the date of publication of a grant of a patent, the application together with the complete specification and provisional specification, if any, the drawing if any, abstract and other documents related thereto may be inspected at the appropriate office by making a written request to the Controller and on payment of fee and may obtain copies on payment of fee specified in the First Schedule.

Rule 82

Preparation of amended specifications, etc.

Where the Controller allows the application for a patent or the complete specification or any other document to be amended, the applicant shall, if the Controller so requires and within the time to be specified by him, leave at the appropriate office an amended application or the specification or the other document, as the case may be, in accordance with the provisions of these rules.

Rule 88**Register of patents under section 67**

(1) Upon the grant of a patent, the Controller shall enter in the register of patents at each appropriate office, the name, address and nationality of the grantee as the patentee thereof, the title of the invention (including the categories to which the invention relates), the date of the patent and the date of grant thereof together with the address for service of the patentee.

Rule 121A**Address of Communications**

All communications in relation to any proceeding under the Act or these rules shall be addressed to the Controller at the appropriate office.

91. A perusal of Sections 2(1)(r) & 74 of the Act, Rule 4, Clause 03.02 of the Manual, and all the above Rules shows that the term ‘appropriate office’ is of immense significance in the process of prosecution and grant of patent application in India. All proceedings related to the patent application are conducted in the appropriate office itself, right from the filing of the patent application, filling of opposition to the patent application, reply statement and evidence, inspection of documents, all take place before the appropriate office. As per Rule 88, the Register of patents specified in Section 67 of the Act is also maintained at each appropriate office. All communications in relation to any proceedings under the Act or the Rules have to be addressed to the appropriate office. Even divisional applications to the first application under Section 16 are to be filed at the appropriate office. Rule 28 makes it clear that even if the hearing is held through video-conferencing or audio-visual communication devices from a different location, the hearing is

'deemed' to have been held at the appropriate office. Rule 4(2) specifically provides that the appropriate office shall not ordinarily be changed once the same is decided or frozen. This obviously means that it is only in exceptional circumstances that change of appropriate office is possible under Rules.

92. In recent times, for administrative exigencies, the office of CGPDTM allocates examination of applications between Patent Offices. Going by the principle enshrined in Rule 28 which is location-neutral, administrative exigencies would not change the appropriate office of the patent application. Even if the hearing is done by a Controller not based at the appropriate office through video conferencing, in view of Rule 28, such a hearing is 'deemed' to have taken place at the appropriate office. Thus, for all purposes, the appropriate office is the Patent Office where all the procedures and proceedings related to the patent application have to take place and are deemed to have taken place. The appropriate office is, thus, the situs of the patent application.

93. Once orders are passed by the Patent Office on an application, any challenge to such order or direction would, therefore, ordinarily lie before the High Court in whose jurisdiction such appropriate office is located. This is because of the following reasons:

- i. The appeal is a continuation of the original proceeding;
- ii. The entire record of the patent application is readily available at the appropriate office;
- iii. As per the scheme of the Rules, the concerned applicant would be domiciled, carrying on business or normally residing within the said territorial jurisdiction;

- iv. The invention may have originally originated from the said territory;
- v. The address of service in India in case of a foreign applicant would be in the territory where the appropriate office is located.

94. Submissions have been made by ld. counsels to the effect that even in the case of appeals, the concept of cause of action ought to be merge into Section 117A in order to determine the High Court before which appeals would be maintainable. However, this Court does not agree with the said submission as the same is not legally tenable.

95. In *Scooters India Ltd. v. Jaya Hind Industries Ltd.* AIR 1988 Delhi 82, a ld. Single Judge of this Court dealt with an appeal under Section 116 of the Act, as it then existed, against an order rejecting opposition to the grant of the patent. The patent application was filed in the Patent Office, Bombay and the order dismissing the opposition was passed by the said Patent Office. Appeal against the said decision was filed before the Delhi High Court. The ld. Single Judge, after considering the provisions of the Patents Act, 1970 as also Section 51A of the DA 1911 distinguished the judgment of Full Bench in *Girdhari Lal Gupta (supra)* and held as under:

“9. In support of his arguments Mr. Bhushan referred to a Full Bench decision of this court in *Girdhari Lal Gupta v. K. Gian Chand Jain and Co.* MANU/DE/0040/1978 : AIR 1978 Delhi 146. This decision was rendered on S. 51A of the Designs Act. Under sub-s. (1) of this section any person interested may present a petition for the cancellation of the registration of a design to the High Court. Under sub-s. (2) of this section appeal lies from any order of the Controller to the High Court, and the Controller under sub-s. (3) of

Section 2 of the Designs Act, 1911 means the Controller General of Patents, Designs and Trade Marks appointed under subsection (1) of Section 4 of the Trade and Merchandise Marks Act, 1958. **The definition of the High Court under the Designs Act, 1911 is the same as that in the Patents Act, 1970.** The Full Bench while interpreting sub-section (1) of Section 51-A of the Designs Act, by a majority of two to one held **that a petition for cancellation of the design under Section 51-A would lie to that High Court within the territory of which subject matter has the necessary nexus. It held that a petition may, therefore, be filed either in the High Court having jurisdiction over the place at which the design is registered or in the High Court having jurisdiction over the place at which the enjoyment of the copyright by the registered proprietor causes injury to the commercial interests of the petitioner. On these reasonings it was submitted that the present appeal in this court against the impugned order was competent as the commercial interest of the appellant was affected in the territory of Delhi where the appellant was also having its offices.** It may be noted that H.L. Anand, J. who has given dissenting judgment was of the opinion that such a petition under S. 51-A could lie in any of the High Courts as we find in Section 2 (7) of the Designs Act. **I do not think this Full Bench decision of this court is of any help to me in deciding the question now posed before me. This judgment dealt with the initial institution of the proceedings. It could have been of help if the court had decided as to which High Court appeal lay against the order of the Controller under sub-s. (2) of Section 51-A.** It was the argument of Mr. Bhushan that on the analogy of this judgment he could file a suit in Delhi for

revocation of the patent granted to the first respondent under Section 64 of the Act and impugned order of the second respondent would be the subject matter of the suit and if the court revokes the patent, that order would have to be set aside. I am afraid this is not the point I am called upon to decide in the present case. Then, Mr. Bhushan submitted that under sub-s. (4) of Section 73 of the Act the Controller is empowered to withdraw any matter pending before an officer appointed under sub-s. (2) of that section and deal with such matter either himself or transfer the same to any other officer appointed under sub-s. (2). **He said that in case the proceedings pending in the Patents Office at Bombay are transferred to Delhi, then could it be said that the Bombay High Court still had the jurisdiction or it was the Delhi High Court which would have the jurisdiction. Again, I am not called upon to decide this point, though it was submitted by Mr. N.K. Anand that the proceedings as such are not transferred but any other officer would continue to hold proceeding at Bombay....**

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12. Under the Act patent offices could be established at various places. An application for a patent is to be made in the form prescribed and filed in the appropriate patent office. **It is not disputed that in the present case the application for the patent was filed in the patent office at Bombay, which was the appropriate office. This application for patent by the first respondent could not have been filed at any other place. It would follow, therefore, that the appeal against the impugned order of the second respondent rejecting opposition of the appellant under Section 25 of the Act would have to be filed in the Bombay High Court. As the word 'appeal' is to be**

construed in its natural and ordinary meaning, the appeal cannot be brought to this court. The argument that though Rule 4 of the Patents Rule, 1972 prescribes a particular patent office to which an application for patent could be filed, but that would not mean that the appeal against the order could be filed only in a particular High Court where the patent office is situate, has to be rejected. If it were to be that appeal could be filed in any High Court, there was no point in defining the High Court under Section 2 (1) (i) of the Act. **Once the application is filed as prescribed under Section 7, the jurisdiction of the High Court to which an appeal would lie is fixed. It would be that High Court of the State or Union Territory where the patent office, where the application is filed, is situate in terms of Section 2 (1)(i) of the Act.** Provision of the Act referred to above clearly show that appeal cannot be filed against an order of the Controller passed under sub-section (2) of Section 116 of the Act to any High Court of the choice of the appellant.”

96. Thus, the view taken by the Id. Single Judge was that the appeal would not be maintainable before the Delhi High Court as, once the patent application is filed under Section 7, the jurisdiction of the High Court to which an appeal would lie is fixed. The Court explicitly rejected the argument that the Rules prescribe a particular Patent Office to which an application for patent could be filed, however the appeal against such order would not be limited to the High Court within the territorial jurisdiction of which the appropriate office is situated. This judgment was approved by the Supreme Court in *Godrej Sara Lee Limited v. Reckitt Benckiser Australia AIR 2010 SC 1331* wherein orders cancelling two registered designs were

passed by the Controller of Designs, Kolkata. Under Section 19(1) of the Designs Act, 2000 the question was whether the appeal was maintainable against the said orders before the Delhi High Court. The Supreme Court considered the decision in *Girdhari Lal Gupta (supra)* as also *Scooters India (supra)* and held that the appeals would not be maintainable before the Delhi High Court. The observations of the Supreme Court are as under:

“21. In contrast to the provisions of Section 51A(1)(a) of the 1911 Act, Section 19(1) of the 2000 Act, which also deals with cancellation of registration, provides for a petition for cancellation of registration of a design to be filed before the Controller and not to the High Court. On a comparison of the two provisions of the two enactments, it will be obvious that under the 2000 Act the intention of the Legislature was that an application for cancellation of a design would lie to the Controller exclusively without the High Court having a parallel jurisdiction to entertain such matters. It is also very clear that all the appeals from any order of the Controller under Section 19 of the 2000 Act shall lie to the High Court. The basic difference, therefore, as was pointed out to the High Court and noticed by it, is that while under Section 19 of the 2000 Act an application for cancellation would have to be made to the Controller of Designs, under Section 51A of the 1911 Act an application could be preferred either to the High Court or within one year from the date of registration to the Controller on the grounds specified under Subclauses (i) and (ii) of Clause (a) of Section 51A(1). Under Section 19 of the 2000 Act the power of cancellation of the registration lies wholly with the Controller. On the other hand, an application for cancellation of a design could be made directly to the High Court

under Section 51A of the 1911 Act. Under the 2000 Act, the High Court would be entitled to assume jurisdiction only at the appellate stage, whereas under Section 51A of the 1911 Act the High Court could itself directly cancel the registration. Whereas in Girdharilal Gupta's case (supra), the question of jurisdiction of the High Court was in relation to an application made to the High Court directly, in the instant case, we are concerned with an order of the Controller against which an appeal is required to be filed before the High Court. While in Girdharilal Gupta's case the Court was considering the expression "High Court" in the context of a fall-out in respect of the ground of registration and the cause of action arising on account of such fall-out, in the present case, there is no question of any consequential impact since the application for cancellation of registration was on the basis of fake documents created in order to perpetrate a fraud.

22. The reliance placed by the High Court on the judgment in Girdharilal Gupta's case (supra) appears to be misplaced, inasmuch as, while under the 1911 Act the High Court acts as an Original forum, under the 2000 Act the High Court acts as an Appellate forum, which are two separate jurisdictions operating in two different fields. In the instant case, the doctrine of cause of action, as understood under Section 20 C.P.C., has been imported on the basis of the provisions of Section 51A of the Designs Act, 1911, whereas the case of the appellant would fall under Section 19 of the Designs Act, 2000, where the High Court functions as the Appellate forum. The cause of action for the instant proceedings is most certainly the cancellation of the registered design of the appellant which happened in the State of West Bengal which gave the Calcutta High Court

the jurisdiction to deal with the matter. The Delhi High Court, in our view, erred in holding that the cause of action had arisen within its local jurisdiction, whereas the jurisdiction of the High Court was on account of the cancellation of registration of the design and not on account of the impact thereof in any particular State. This is what distinguishes the decision in Girdharilal Gupta's case from the facts of this case.

23. Apart from the fact that the parties to the suit were in Kolkata, it is clear that the cause of action for the suit arose in Kolkata by virtue of the order passed by the Controller in relation to the appellant's design. As the facts indicate, the cause of action for the suit arose in Kolkata, which, in any event, had jurisdiction to entertain the suit. Having erroneously applied the decision in Girdharilal Gupta's case (supra) to the facts of the case, the High Court was led into error in holding that the consequence of the cancellation gave jurisdiction to the Delhi High Court to entertain the suit, without considering in its proper perspective the provisions of Section 51A of the 1911 Act in contrast to the provisions of Section 19 of the 2000 Act.

24. The various decisions cited by Mr. Dave to support his submissions that the question as to which High Court would have jurisdiction to entertain an appeal under Section 19, had to be determined on the basis of the statutory provisions and not on the basis of dominus litus or the situs of the Appellate Tribunal or the cause of action. We are inclined to accept Mr. Dave's submission that the Delhi High Court had erred in making a comparison between the provisions of Section 51A of the 1911 Act and Section 19(2) of the 2000 Act, which operate on different planes.”

97. The Supreme Court took the view that there is a marked difference

between the nature of original proceedings and appellate proceedings which are two separate jurisdictions operating in two different fields. The doctrine of cause of action cannot be imported by a High Court, while acting as an appellate forum, to assume territorial jurisdiction. Thus, the dictum of *Girdhari Lal Gupta (supra)* cannot be applied to appellate proceedings.

98. This Court is also not convinced that a mere arrangement made for administrative convenience by the CGPTDM would give rise to facts that would vest territorial jurisdiction in this Court. Merely holding of hearing virtually by the Controller, who is in Delhi, and passing of the impugned order by the Delhi Patent Office, while the appropriate office in respect of such an application continues to remain in Mumbai, cannot vest jurisdiction in Delhi High Court to entertain an appeal. The Madras High Court in *Bharat Bhogilal Patel v. Union of India MANU/TN/1915/2014* had an opportunity to deal with a case where the question as to whether practices adopted for administrative convenience would vest jurisdiction in the High Court.

99. In *Bharat Bhogilal (supra)* the Court was dealing with an appeal challenging a revocation order passed by IPAB Chennai. The background facts of the matter are that patent applications were filed in the Mumbai Patent Office and Mumbai was the appropriate office. Revocations petitions were filed, prior to the constitution of the IPAB, in the Gujarat High Court. The said revocations were transferred to the IPAB Circuit Bench at Mumbai upon its constitution. However, in view of the fact that the Circuit Bench at Mumbai was not having adequate time, the hearing took place before the IPAB, Chennai as per consent of the parties where the Bench held regular proceedings. The patents were revoked by the IPAB. Writ Petitions were

filed before the Madras High Court assailing the order passed by the IPAB wherein the Id. Division Bench observed as under:

“8. Conclusion

On an analysis of the aforesaid judgments, the principles which emerge can be summarized as under :-

i) In view of the 42nd Constitutional Amendment and the wordings of Clause (2) of Article 226 of the Constitution of India, even a part of cause of action would confer jurisdiction on the Court.

ii) The choice would be normally of the litigant approaching the Court as to where he would initiate the litigation if there were two High Courts which would have jurisdiction.

iii) Merely because the original order is passed within the jurisdiction of another Court, it would not exclude the jurisdiction of the Court which is the situs of the appellate authority.

iv) The principles of forum conveniens, though applicable to international law as a principle of Comity of Nations, would apply to the discretionary remedy under Article 226 of the Constitution of India.

9. *Now, turning to the facts of the present case, undisputedly, the first respondent's business is located at Mumbai. This gave rise to the first respondent filing applications under the Patents Act in the Office of the Registrar of Patents at Mumbai, and the patents of the first respondent were registered at Mumbai. It is in fact the petitioner which was aggrieved by the registration of the patents in favour of the first respondent and sought revocation of the patents by initiating proceedings before the Gujarat High Court. In those proceedings, the first respondent took an objection about the jurisdiction of that Court. The*

first respondent also initiated criminal proceedings before the X Metropolitan Magistrate's Court at Mumbai. He had also filed a writ petition in the Bombay High Court, which he subsequently withdrew on account of other reasons.

10. In view of the constitution of the IPAB in the year 2007, the Gujarat High Court itself transferred the issue of revocation of patents to the IPAB Circuit Bench at Mumbai, where the proceedings commenced. In these circumstances any further cause would undoubtedly have given rise to proceedings only in the Bombay High Court.

11. Yet another development which needs to be taken note of is that while the Principal Seat of IPAB was at Chennai, it held Circuit Bench sittings at different locations. It appears that the number of cases were too many at Mumbai, whereas the frequency of sittings was comparatively less. The result was that proceedings would take longer time to reach a culmination.

12. The petitioner was desirous of an early adjudication on the issue of the applications filed for revocation of patents. The parties thus joined together to have the matter heard at Chennai, which was the Principal Seat of the IPAB, on account of time being at the disposal of the IPAB. It is in this context that the hearing was held by the IPAB at Chennai and the final order was passed at Chennai and not at Mumbai. In our view, this was an arrangement only for convenience of hearing.

13. We fail to appreciate as to why such an arrangement for convenience of hearing should shift the venue of the litigation itself to Chennai and not at Mumbai, where all proceedings

practically arose. We are unimpressed by the argument of the learned counsel for the first respondent that if at all there was any inconvenience, it was at the stage of hearing of the appeal, since records would have to be called for from the Office of the Patents. We are thus unable to accept the plea of the learned counsel for the first respondent that once the order has been passed at Chennai in the aforesaid circumstances by the IPAB, at best, it was an option for the first respondent to either approach the Madras High Court or the Bombay High Court, and having thus approached the Madras High Court, it is not for the petitioner to object to the same.

14. Merely because both the parties having agreed to get the matter heard early, made arrangements through their counsel to attend the hearings at Chennai being the Principal Seat of the IPAB, would not make a difference and we are of the view that it is a fit case where the principle of forum conveniens should be invoked and the parties be put to adjudication before the High Court of Bombay, rather than this Court.

15. We draw strength from the observations made in Canon Steels case (supra) that if a small part of cause of action arises within the territorial jurisdiction, the same by itself may not be considered to be a determinative factor compelling the High Court to decide the matter on merits, and the High Court may refuse to exercise its discretionary jurisdiction by invoking the doctrine of forum conveniens.

16. The present factual matrix is not even where it is the situs of the appellate authority in question. The Bench of the appellate authority was actually located at Mumbai and thus, only for convenience of hearing for certain days were sittings held at Chennai. This is a distinct factor, even though the

Full Bench of the Delhi High Court in M/s. Sterling Agro's case (supra) had in fact observed that an order of the appellate authority constitutes a part of the cause of action, yet the same may not be a singular factor, and the High Court may refuse to exercise jurisdiction by invoking the doctrine of forum conveniens. The mere fact that hearing was held at Chennai rather than at Mumbai on account of a given inadequacy of sittings at Mumbai by the IPAB Circuit Bench at Mumbai, thus would not imply that this Court should necessarily exercise the jurisdiction.

17. The observations thus made in Dr. Nandu Dwarakasingh's case (supra) become material in the facts of the present case. We are thus inclined to allow the application filed by the petitioner (original fourth respondent in the writ petitions) and non-suit the first respondent (original writ petitioner), applying the principles of forum conveniens, with leave to the first respondent to file the proceedings before the competent court at Mumbai. If one may say, the situation is akin to a scenario where though the seat of arbitration may be in one place, for convenience, some hearings are held at another location.

18. The application, viz. M.P. No. 3 of 2012 is accordingly allowed. In view of the orders passed in the miscellaneous petition, the writ petitions are dismissed, with liberty to the writ petitioner to initiate legal proceedings at Mumbai, if so advised. However, there shall be no order as to costs. Consequently, all the connected miscellaneous petitions stand closed.”

100. The Id. Division Bench, thus, held that the patent applications having originated from Mumbai, the High Court of Bombay had territorial jurisdiction. The Court refused to exercise jurisdiction eventhough the

impugned order was passed by IPAB, Chennai on account of the fact that the hearing before the IPAB Chennai was merely an arrangement made for convenience by the parties.

101. In *Indian Performing Rights Society v. Sanjay Dalia (2015) 10 SCC 161* relied upon by Mr. Sethi, the Supreme Court was dealing with interpretation of section 62 of the Copyright Act, 1957, and Section 134(2) of the Trade Marks Act, 1999 with regard to the place where a suit can be instituted by the Plaintiff. The said decision would not be applicable in the context of the issues being considered by this Court.

102. The judgment of the Supreme Court in *Nasiruddin and Ors. v. State Transport Appellate Tribunal (supra)* sought to be relied upon by Ms. Rajeshwari, Id. counsel is also not applicable to the legal position under consideration. The Supreme Court in *Kusum Ingots & Alloys (supra)* has observed that the said decision is an authority for the proposition that the place from where an appellate order or a revisional order is passed may give rise to a part of cause of action. However, in the case at hand the impugned order is not an order of the appellate court or the revisional court but an order passed under an arrangement made for administrative convenience.

103. In view of the above legal position, an order passed by the Delhi Patent Office as a part of arrangement put in place by the Office of CGPDTM, though within the territorial limits of this Court, would not vest territorial jurisdiction in the High Court under section 117A of the 1970 Act. In this background, it is clear that even after the enactment of the TRA, appeals under Section 117A challenging the order or direction of the Patent Office would lie before the High Court having territorial jurisdiction over the appropriate office from where the patent application originates and

which is the situs of the said application. In the case of appeals where challenges against orders of the Patent Office are raised, the concept of cause of action cannot be pleaded to vest jurisdiction in other High Courts i.e., other than the one in the territorial jurisdiction of which the appropriate office is located.

Conclusion on facts in C.O.(COMM.IPD-PAT) 3/2021 titled Dr. Reddy's Laboratories Limited & Anr. v. The Controller of Patents & Anr.

104. Suits for infringement have been filed by Boehringer against both the Petitioners herein in the High Court of Himachal Pradesh and interim injunctions have been granted. However, revocation petition before this Court was filed prior to the suits for infringement themselves. Ideally, after the filing of infringement proceedings, the Defendant, if it wishes to seek revocation, ought to prefer the counter claim in the said suit so as to avoid multiplicity of proceedings and possibility of contradictory judgments. However, in the present case, since the revocation petition was filed prior to filing of the suits for infringement and the patent was itself granted by the Delhi Patent Office, and the appropriate office is the Delhi Patent Office. Hence, the present petition is maintainable before this Court. **C.O. (COMM.IPD-PAT) 3/2021** is held to be maintainable before this Court. The application under Section 10 CPC would, however, be decided on its own merits.

105. List for further proceedings on 9th January, 2023.

Conclusion on facts in C.O.(COMM.IPD-PAT) 1/2022 titled Tyssenkrupp Rothe Erde Germany GMBH v. The Controller of Patents

106. On the basis of the findings given above, if any of the elements of

cause of action had arisen in Delhi, this Court would have had jurisdiction. However, Thyssenkrupp has already filed a revocation petition seeking revocation of IN 254458 before the IPAB which admittedly now stands transferred to the High Court of Madras. Thyssenkrupp cannot sail in two boats before two different High Courts. In view these facts, this Court holds that the present revocation petition is not maintainable.

107. It is clarified that the matter has not been considered on merits by this Court. Thyssenkrupp is free to raise all the grounds for revocation of the patent before the High Court of Madras where its revocation petition is currently stated to be pending.

108. Accordingly, *I.A. 3570/2022* filed under Order 7 Rule 11CPC is allowed.

109. *C.O. (COMM.IPD-PAT) 1/2022* is dismissed along with all pending applications with liberty to pursue the cancellation petition before the High Court of Madras.

Conclusion on facts in C.A. (COMM.IPD-PAT) 169/2022 titled Elta Systems Ltd. v. The Controller of Patents

110. In view of the findings given above, the appeal having originated from the patent application filed in the Mumbai Patent Office which is also the appropriate office in respect of the patent application in question, it is held that the appeal against the impugned order would lie before the Bombay High Court. Even though due to administrative exigencies, the examination was done by the Asst. Controller at the Delhi Patent Office who has passed the impugned order, the appeal would not be maintainable before this Court.

111. *C.A. (COMM.IPD-PAT) 169/2022* is, accordingly, dismissed along with all pending applications with liberty to Elta Systems Ltd. to approach the High Court of Bombay. In view of the fact that the legal issue was pending adjudication before this Court, the period during which the appeal was pending before this Court, Appellant may seek condonation of delay which may be considered by the Appellate Court, if the need so arises.

112. There shall be no orders as to costs in all these cases.

NOVEMBER 10, 2022

Dk/Sk

**PRATHIBA M. SINGH
JUDGE**

सत्यमेव जयते