IN THE HIGH COURT OF JUDICATURE AT ALLAHABAD

DATED: 17.02.1986

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THE HONOURABLE MR. JUSTICE B.D. AGARWAL

Fabcon, Corporation Incorporated ... Plaintiff-Revisionist

Vs.

Industrial Engineering Corporation ... Defendant

ORDER

B.D. Agarwal, J.

1. This revision is directed against an order of the Additional District Judge, Ghaziabad, dated 23rd Sept., 1982.

2. The plaintiff brought a suit giving rise to this revision in the Court of the District Judge, Ghaziabad, contending that, the plaintiff holds patent No. 140164, dated Jan. 31, 1974, and that the plaintiff is recorded in the Register of Patents on Nov. 21 1980, as such. There is allegedly infringement of the patent from the side of the defence and hence the relief sought in the suit is permanent injunction besides requiring the defendant to render account to the plaintiff of profits made by the defendant by using a machine containing the plaintiffs invention. The amount thus found due is also sought to be recovered. In defence it is asserted that there is no valid patent held as such by the plaintiff and no relief can be had on the basis of the averments contained in the plaint Subsequent to the defence being put in, there was an application filed by the plaintiff wherein the plaintiff asserted that the defendant be taken to have raised a counter-claim and hence the suit be transferred to this Court for decision as contemplated under the proviso to Section 104 of the Patents Act, 1970. This

was opposed by the defendant. The application filed by the plaintiff was rejected by the trial Court against which this revision is preferred by the plaintiff.

3. Having heard learned counsel for the parties I do not find merit in the revision. Section 104 of the Patents Act provides that a suit for any relief under Section 106 for infringement of a patent shall be instituted in the District Court and not in any Court inferior thereto. The proviso lays down that where a counterclaim for revocation of the patent is made by the defendant, the suit, along with the counterclaim shall be transferred to the High Court for decision. The question is whether there is in this case a counter-claim set up by the defendant. Learned counsel for the revisionist argues that in the written statement filed for the defendant it is prayed at the end that the trial Court be pleased to dismiss the suit of the plaintiff in favour of the defendant and the patent No. 140164 be held as invalid on the basis of the submission contained in the written statement. It is urged that since the defendant has asserted that the patent in question be held invalid, this be taken to be a counter-claim for revocation within the meaning of the aforesaid proviso. This is not acceptable. According to Section 107(1) in any suit for infringement of a patent, every ground on which it may be revoked under Section 64 shall be available as a ground defence. Section 64 enumerates the grounds for revocation of patent Under the scheme of the Act itself, therefore, there is a distinction maintained as between the defence raised to a suit for infringement of a patent (vide Section 107) on the one hand and the revocation sought of a patent on the other (vide Section 64). The grounds may be the same, but still there is no inconsistency on account of the suit being defended as liable to dismissal in a particular case and a case where the defendant seeks also that the patent asserted by the plaintiff be revoked. It is only when there is a counterclaim seeking revocation of the patent that the jurisdiction of the District Court is ousted. The proviso to Section 104 being in the nature of an exception to the general rule, it has to be strictly construed. There is no express claim on the part of the defendant for revocation of the where of infringement is alleged by the plaintiff. That the defendant

pleads that the patent set up by the plaintiff is invalid amounts only to the defendant raising a ground for the relief sought by the plaintiff being declined; it does not follow necessarily that the defendant also seeks by way of a counterclaim that the patent be revoked. The defendant has not asserted in the pleadings anywhere that they are the patentee or that they are entitled to be registered as such, The grounds raised are cumulatively and also individually by way of defence to the plaintiffs action.

4. For these reasons the revision fails and is hereby dismissed. Costs on parties.