IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 28.10.1976

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THE HONOURABLE MR. P.S. KAILASAM, CHIEF JUSTICE

C. Siddeswaran ... Appellant

Vs.

R. Shanmugham Pillai ... Respondent

JUDGMENT

P.S. Kailasam, C.J.

1. This appeal is preferred by the defendant in the suit against the judgment of Maharajan, J., granting a decree: (a) for injunction restraining the defendant from infringing the plaintiff's patent No. 67546 and patent for addition No. 90265 during the continuance thereof; and (b) directing the defendant to produce into Court the infringing gramfrying machine in his possession for the purpose of destruction of the infringing parts of his machine and the return of the non-infringing parts to the defendant, after the destruction of the infringing parts. The plaintiff is carrying on business in the manufacture and sale of parched Bengal gram and other articles at Dindigul. For the purpose of frying Bengal gram and breaking it into dhalls, the plaintiff invented art automatic machine. The plaintiff registered the patent of the machine as No. 67546 on 8th February, 1961 under the provisions of the Indian Patents and Designs Act, 1911. The plaintiff was using the patented machine for the manufacture of parched Bengal gram. The plaintiff came to know that the defendant, who is carrying on business as grain dealer and fried gram merchant at Madras, was using an automatic machine containing the patented features invented by the plaintiff for roasting Bengal gram. As the plaintiff's notices to the defendant to desist from using the automatic machine failed, he came forward with the suit. The plea of the

defendant was that the machinery was manufactured by him by using his own ingenuity and skill and that he was not aware that the invention of the plaintiff was registered as a patent. He denied that he was using the automatic machine having the patented features invented by the plaintiff.

2. Maharajan, J., who tried the suit, upheld the validity of the plaintiff's patent. He found that the defendant had infringed the patent which the plaintiff is entitled to. The learned Judge fixed the damages payable by the defendant to the plaintiff at Rs. 12,000. He further granted an order of injunction restraining him from infringing the plaintiff's patent No. 67545 and patent for addition No. 90265 during the continuance thereof. He also directed the defendant to produce the infringing machinery for being disposed of.

3. The present appeal is filed by the defendant against the said judgment. In the appeal, Mr. B.T. Seshadri, the learned Counsel for the defendant, did not question the quantum of damages or the fact of infringement of the plaintiff's patent. But he submitted that as the patent, which was registered by the plaintiff on 30th April, 1959 lapsed with effect from 30th April, 1975, i.e., 16 years from 30th April, 1959, the plaintiff is not entitled to the relief of injunction or an order directing the defendant to produce into Court the infringing machinery for the purpose of destruction. The correctness and the form of the decree that was granted by the learned Judge, as the matter stood on the date of the decree, is not challenged. But the learn-ed counsel for the appellant submitted that as the patent had lapsed on 30th April, 1975, the injunction restraining the use of the machinery cannot be continued or the destruction of the machinery carried out. That the order of injunction cannot be continued does not admit of any doubt, for, the plaintiff does not possess any patent right as on date and, therefore, there could be no infringement by the defendant by using his machinery. The only question that arises for consideration is whether the decree of the learned Judge directing the defendant to produce the infringing machinery for destruction should be affirmed. Here again, there can be no doubt that on the date of the decree the said direction was proper. But the question is whether that direction

should be carried out 'because of the lapse of the patent in favour of the plaintiff. Tyrrell on the Law of Patents at para. 965 explains the nature of the order of destruction. A successful plaintiff can obtain an order for the destruction or delivery up of infringing goods in the possession of the defendant, so as to ensure that such goods are not retained in order to be placed upon the market after the expiry of the patent. The form of the order regarding an infringing article which is directed to be delivered for destruction is for the purpose of rendering still more effective the order of injunction, ordinarily granted by the Court prohibiting its use during the term of the patent. The learned author proceeds to state:

> To this end, though the normal form of the order is for actual destruction or delivery up of infringing articles, it is modified in suitable cases, as, for instance, where an infringing article can be rendered non-infringing by some alteration or by the removal of some part.

In Mergenthaler Linotype Co. v. Intertype Ltd. 43 R.P.C. 381, Russell, J., dealing with an order of delivery up for destruction, after referring to the various decisions, observed as follows:

> I think it further follows from that that the Court has a discretion, not only to refuse to make an order for delivery up, but if, in the exercise of its discretion, it makes the order, it has a further discretion limiting the extent to which the order goes. It appears tome that in exercising such a discretion the important thing to bear in mind is this, that such an order is not made and is not intended as a punishment to the infringer. The order is made and the relief given with a view to assisting the plaintiff and ensuring to the plain-tiff the fruits of his success in the action....

The learned Judge proceeded to observe:

> but there, remains this, that, go long as there is still what I might call infringing stock in the possession of the infringer, he may be subjected to too serious and grave a temptation and may there by be tempted to commit a breach of the injunction which he would not otherwise commit.

Thus it is clear that an order of delivery for destruction is not intended as a punishment to the infringer, but is made with a view to assist the plaintiff and to

assure that the order of injunction is made effective, and to prevent the defendant from the temptation of carrying on further breach with the help of the in-fringing machinery. Due, to changed circumstances, namely, the lapse of the patent, an order of injunction cannot be continued and naturally no question of an order being passed for ensuring the observance of the injunction would arise. In the circumstances, it would be futile to sustain the order of injunction. While holding that the judgment and decree of the trial Court was right on the date when they were passed, due to changed circumstances, we set aside the order granting injunction and directing production of the infringing machinery for the purpose of destruction. As we have upheld the validity of the plaintiff's patent, the direction to the defendant to pay the plaintiff a sum of Rs. 12,000 by way of damages for the infringement of the patent is affirmed. The direction to the defendant to produce into Court the infringing machinery for the purpose of destruction is set aside. As the plaintiff has succeeded in the main, he will have his costs in this appeal.