IN THE HIGH COURT OF DELHI

DATED: 26.05.1999

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THE HONOURABLE DR. JUSTICE M.K. SHARMA

I.A. 11829/1998, 774/1999 and 775/1999 in Suit No. 2391/1998

(with the applications in Suit Nos. 2428/1996, 289/1997, 1669/1994, 1970/1995, 2427/1996 and C.O. No. 25/1995)

Standipack Private Limited & Another ... Plaintiffs

Vs.

M/s. Oswal Trading Co. Ltd. ... Defendant

ORDER

DR. M.K. Sharma, J.

1. By this common order I propose to dispose of the applications registered as I.A. 11829/1998, 774/1999 and 775/1999 in Suit No. 2391/1998: I.A. 9131/1996 & 1530/1997 in Suit No. 2428/1996; I.A. 1207/1997, 2588/1997 & 3368/1997 in Suit No. 289/1997; I.A. 7489/1995 in Suit No. 1669/1994, I.A. 7749/1996 in Suit No. 1970/1995, I.A. 9132/1996 & 4746/1998 in Suit No. 2427/1996 & I.A. 7374/1995 in C.O. No. 25/1995. For convenience sake, the plaintiff in Suit No. 2391/1998, M/s. Standipack Private Limited is being described as the plaintiff throughout in the present order and the other parties are described as defendants.

Injunction applications have been filed by the plaintiff seeking for a temporary injunction restraining the defendant from manufacturing or using the patented pouch of the plaintiff. The case sought to be made out by the plaintiff in the injunction applications is that the patent in respect of pouch for storage and dispensing of a liquid such as lubricating oil was granted to the plaintiff by the Controller of Patents. Corresponding patents have also been granted to the

plaintiff in various other developed countries including USA, Europe and Australia. It is stated that subsequent thereto it has come to the notice of the plaintiff that the defendants have started selling pouches of the same construction as the patented pouches of the plaintiff and thereby violating the patent in as much as even sale/marketing of the said pouches would constitute violation of the patent. Accordingly, the plaintiff filed the suit for infringement, injunction and rendition of accounts and also for temporary injunction alleging violating of the patent by the defendants and therefore, granting interlocutory injunction in favour of the plaintiff and against the defendants restraining the said defendants from infringing the patent of the plaintiff and restraining them from manufacturing, selling pouches as those patented by the plaintiff.

2. Various defendants appeared in the suits by filing written statement and reply to the injunction application contending inter alia that the patent was granted to the plaintiff illegally and in violation of the provisions of the Patents Act and the Rules framed therein and in few of which applications have been filed by various parties seeking for revocation of the patent granted. It is also stated that the goods in question were pre-published and therefore, the same was not entitled to be granted patent. It is also stated that there was suppression of material facts and variations in the stand of the plaintiff in the plaint and the stand taken at the time of arguments and therefore, the plaintiff is not entitled to any injunction as sought for. It was also stated that post-dating of the application of the plaintiff is also in violation of the provisions of the Act and that there is vital and marked difference in the pouches of the plaintiff and that of the various other parties namely - the defendants and therefore, no injunction should be granted in favour of the plaintiff. Indian Oil Corporation and Castrol India have filed petitions praying for revocation of patent, which are registered as C.O. 25/1995 and C.O. 11/1998 respectively.

3. Mr. Lekhi appearing for the plaintiff in support of the case of the plaintiff placed reliance on the various relevant provisions of the Patents Act particularly the definition of 'invention', 'patented article' and patented process as appearing

in the provisions of sub-section 2(j) & 2 (o) of the Patents Act, 1970 (hereinafter called the Act). Reliance was also sought to be placed on the provisions of Sections 9, 11 and 17 of the Act.

Reliance was also placed on the provisions of Section 25 and Section 48 of the Act. It was submitted by him that the patent which was granted in favour of the plaintiff and sealed is in fact in respect of the construction of co-extruded layers of the pouch and not in respect of a stand-up or pillow or any other kind of pouch. In support of his contention, Mr. Lekhi relied upon the report of the committee constituted by the Ministry of Petroleum, a copy of which is placed on record. He submitted that the plaintiff being a patentee has the exclusive right to manufacture and market the said pouch under the provisions of the Act and therefore, the plaintiff is entitled to injunction following the ratio of the decision in American Cynamid Company Vs. Ethicon Ltd.; reported in 1975 RPC 513. He further submitted that although revocation application has been submitted by some of the parties as against grant of the aforesaid patent, the same could be considered only at an appropriate subsequent stage and after evidence is led. He urged that validity or otherwise of the patent cannot be examined at this stage inasmuch as the same rests on matters of evidence to be led by the parties at the time of trial.

4. Counsel appearing for the defendants however, submitted that the case of the plaintiff in the plaint is in respect of an invention of a pouch for storage and dispensing of a liquid such as lubricating oil, but in the replication and during the course of arguments on the injunction application a new case is sought to be made out by the plaintiff that the patent is only in respect of the thickness and construction of the layers of the pouch. It was further submitted that revocation of the patent granted in favour of the plaintiff is pending and when such a revocation application is pending no injunction can be granted by the court. In support of such a submission reliance was placed on various decisions of the Supreme Court and of this court to which reference shall be made at the subsequent stage while dealing with the said issues.

5. It was also submitted that the patent granted in favour of the plaintiff was prior published and in this connection reference was made to the Committee Report, contents of which, it was submitted, prove and establish prior publication of the patent. It was also submitted by the counsel appearing for the defendants/parties that the post-dating of the application for grant of patent was in violation of the provisions of the Patents Act and in support of the contention reliance was sought to be placed on the original records of the Registrar of the Patents. An application was also made by some of the defendants that there has been suppression of material facts by the plaintiff which disentitles the plaintiff from getting an injunction from this court. In the light of the aforesaid rival submissions of the counsel appearing for the parties several issues arise for my consideration at this stage for deciding as to whether the plaintiff has been able to make out a prima facie case for grant of an ad interim injunction or not.

6. In order to come to an appropriate conclusion relating to the main issue as to whether an injunction as sought for should be granted or not the following points/issues are to be considered and taken note of:-

(1) Whether the Patent was granted to the plaintiff after following the requirements and procedure as laid down under the Patents Act and as to whether post-dating of the application is in violation and/or against the law?

(2) Whether patent in question was prior published and if so whether the plaintiff is disentitled from seeking any injunc tion?

(3) Whether the pouch as against which patent is claimed is eally an invention within the meaning of the definition clause of the Patents Act?

(4) Whether there is any difference in the construction of the two pouches and if so whether the plaintiff is entitled to grant of injunction?

(5) Since an application for revocation of the patent is filed hat is the effect of such an application being pending and whether under such circumstances plaintiff could be granted a temporary injunction?

(6) What is the effect, if there be a conflicting stand of the plaintiff in respect of the pouch and layers in the plaint vis-a-vis the replication?

(7) Whether there was any suppression of facts by the plaintiff and if so its effect on the issue of grant of temporary injunction?

I now proceed to decide the main issue regarding grant of injunction as sought for taking note of the aforesaid points urged before me.

WHETHER POST-DATING OF THE PATENT BY THE CONTROLLER IS IN VIOLATION OF SECTION 9 OF THE ACT:

7. Section 9 of the Patents Act, 1970 provides for furnishing provisional nd complete specifications alongwith the application filed for grant of a patent. The relevant provisions of said section 9, having a bearing on the present case are extracted below:-

> 9. Provisional & complete specifications. - (1) Where an application for a patent (not being a convention application) is accompanied by a provisional specification, a complete specification hall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed the application shall be deemed to the abandoned:
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> Provided that the complete specification may be filed at any time after twelve months but within fifteen months from the date aforesaid, if a request to that effect is made to the Controller and the prescribed fee is paid on or before the date on which the complete specification is filed.
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> (4) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (3) as a provisional specification, the Controller may, if the applicant so requests at any time before the acceptance of the complete specification, cancel the provisional specification and post-date the application to the date of filing of the complete specification.

The Controller has been vested with the power to post-date the patent under the provisions of Section 17 of the Act which reads as under:-

> 17. Power of Controller to make orders respecting dating of application. - (1) Subject to the provisions of Section 9, at any time after the filing of an application and before acceptance of the complete specification under this Act, the Controller may, at the request of the applicant made in the prescribed manner, direct that the application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly:
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> Provided that no application shall be post-dated under this subsection to a date than six months from the date on which it was actually made or would, but for the provisions of this sub-seccion be deemed to have been made.
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> (2) Where an application or specification (including drawings) is required to be amended under clause (b) of sub-section (1) of Section 15, the application or specification shall, if the Con troller so directs, be deemed to have been made on the date on which the requirement is complied with or where the application or specification is returned to the applicant on the date on which it is refiled after complying with the requirements.

8. The aforesaid provisions make it crystal clear that post-dating of the patent can be done only to the date of filing of the complete specifications. In the present case the Controller of Patents had filed the original records relating to the grant of patent in favour of the plaintiff. The said records reveal that the application for the grant of patent was originally filed by plaintiff on 11.4.1989 and the complete specification was filed on 11.10.1990. The Controller of Patents however, post-dated the patent to 11.7.1989 although complete specifications followed by the provisional specification was filed on 11.10.1990. Thus the post-dating of the patent by the Controller to 11.7.1989 prima facie appears to be in violation of the provisions of Section 9 of the Act. The date of the patent, therefore, should have been 11.10.1990. The patent documents referred the validity of the patent for 14 years from 11.7.1990. Thus the validity of the patent has also been ignored by the Controller of Patents. The plaintiff also during the course of arguments admitted that complete specifications were submitted on 11.10.1990, which is the date from which the Patent granted would be effective. Thus post-dating the Patent to 11.7.1989 appears to be illegal in view of the provisions of Section 9(4) of the Patent Act and the provisions of Section 17 are subject to Section 9.

WHETHER THE POUCHES WERE PRE-PUBLISHED:

9. It is the specific case of the defendants that there exists documentary evidence in the nature of the Report of the Committee appointed by the Ministry of Petroleum and Natural Gas to advise in suitable specifications and orders placed by Indian Oil Corporation on other manufacturers for lubricating oil pouches which indicates and establishes that pouches for storing and dispensing of lubricating oil were being used and were being purchased by the Indian Oil Corporation from diverse sources much prior in advance to the patent of the plaintiff. The aforesaid allegation however, is denied by the plaintiff contending inter alia that there was no prepublication of the aforesaid goods prior to the grant of the patent in favour of the plaintiff. The patent was granted in favour of the plaintiff by the Controller on 11.10.1990. The Committee was appointed in the month of May, 1989 and the report was submitted in September, 1989. The said report discloses reference to the sales of pouches in millions by various companies including the plaintiff and the defendant six years prior to the date of the report. There are several other documents on record filed on behalf of the Castrol India Limited indicating that the patent claimed by the plaintiff was already known much prior to the date of patent i.e. 11.10.1990. The defendants also produced on record a pouch relevant to the period December, 1986 in order to show that the pouch of Castrol Super TT oil was available in the market during the aforesaid period. The defendant No. 2 has also produced photostat copies of the magazine 'Maya' alongwith the documents dated 14.10.1987 pertaining to advertisement of Castrol Super TT in pouches. The documentary evidence on record proves and establishes that construction of the said pouch was publicly known and used in India before the date when the patent was granted in favour of the plaintiff on 11.10.1990 and even before the application filed by the plaintiff on 11.4.1989 alongwith provisional specifications. The documents placed on record indicate that similar pouches for which the plaintiff was granted a patent were being manufactured, marketed and used by various parties including the plaintiff in India. Although in the plaint the plaintiff

claimed right of patent in respect of the pouches, however, there is a change in the stand taken by the plaintiff in the replication and reply filed wherein the plaintiff admitted that invention of the stand-up or pillow pouch is not within the scope of the patent of the plaintiff but it is the nature of construction of the layers of the pouch that have been patented. It is stated that it is only the plaintiff's pouch with specific thickness and construction of the layers that can successfully hold such a liquid. There appears to be a change in the stand of the plaintiff now than what was pleaded in the plaint. In view of the present aforesaid stand the plaintiff itself has changed the entire case as made out in paragraph 3, 4 and 9 of the plaint. The plaintiff also relies upon the report of the committee appointed by the Ministry of Petroleum and Natural Gas dated May, 1989. As stated above the said report indicates that Hindustan Petroleum and Bharat Petroleum Corporation Limited has been manufacturing and selling pouches with the same number of microns as claimed by the plaintiff prior to the date of patent of the plaintiff i.e. 11.10.1990. Such nufacture and sale thus was definitely a number of years ahead of the date of the patent i.e. 11.10.1990. The said report further indicates that the sale of the pouches was not in small quantity but pouches with similar construction and layers were available and sold in the market in lakhs prior to the date of patent. Thus it is crystal clear that the patent was pre-published, publicly known and used in India before the priority date of claim. Documentary evidence in the nature of invoices and advertisement in magazines referred to above, placed on record also corroborates the aforesaid position. Thus the claim made by the plaintiff was already known in the trade and the patent was pre-published.

WHETHER THE PATENT IS REALLY AN INVENTION WITHIN THE MEANING OF THE DEFINITION CLAUSE OF THE PATENTS ACT, 1970:

10. Section 3(d) of the Patents Act provides that ere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs atleast one new reactant, could not fall within the category of

an invention. Section 3(f) of the Act provides that mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way, would not constitute an invention for the purposes of the Patents Act.

11. Although the plaintiff in the plaint claimed exclusive right of patent in respect of the invention of the stand-up or pillow pouch, subsequently in the replication and reply filed, the plaintiff has admitted that invention of the stand-up or pillow pouch is not within the scope of the patent of the plaintiff. The plaintiff changed its earlier position and in the replication and reply claimed the right of exclusiveness and claimed exclusive right of patent in respect of nature of construction of the layers of the pouch which according to them is patented. Thus the plaintiff relies upon and claims the right of patent in respect of the thickness of the films that have been used in the manufacture of the pouches. It may however, be noted that thickness of the plastic film/layer depends upon the tolerance of the contents in the pouch. Thus the same is merely an arrangement and re-arrangement of the mixture of the material and cannot be termed as a novel concept and does not have any novelty. Such arrangement and rearrangement of mixture of the material cannot become an invention, for it is only an improvement by adding microns as per the strength of the layers. Thus prima facie the invention claimed by the plaintiff in respect of the thickness of the layers of the aforesaid pouch cannot be called an invention as envisaged within the definition clause of the Patents Act. Besides the documentary evidence placed on record prima facie indicates that the claim made by the plaintiff is already known in the trade and the patent was pre-published.

12. Learned counsel for the plaintiff sought to submit that the patent was granted to the plaintiff after the examiner had examined the patent in terms of the provisions of the Patents Act and having found novelty in respect of the said pouch has granted the patent in favour of the plaintiff. The said submission cannot be accepted in view of the fact that the examiner who examined the patent accepted the patent on the basis of the declaration made by the plaintiff

and the examiner had no knowledge at that point of time that the pouches were already available in the market. The application of the plaintiff was examined on the basis of the declaration made by the plaintiff and as per the record available. On consideration of the documentary evidence read with the aforesaid statutory provisions it is prima facie held that the said contention of the plaintiff is not tenable. In this connection reference may be made to the case of Bishwanath Prasad Vs. Hindustan Metal Industris; . In the said decision the Supreme Court held that in order to be patentable an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or 'inventive step'. It was further held that mere collection of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify, for the grant of a patent. The Supreme Court has categorically held that in order to be patentable, the new subject matter must involve invention producing new result or a new article or better or cheaper article. In my considered opinion the nature and manner of construction of layers, was publicly known, used and practised in India, prior to the date of patent and thus there is novelty attached to it. The invention as claimed by the plaintiff does not satisfy the test laid down in the aforesaid decision for an invention.

WAS THERE ANY DIFFERENCE IN THE CONSTRUCTION OF THE POUCHES OF THE PLAINTIFF AND OF THE DEFENDANTS:

13. It is stated on behalf of the defendants that the pouch being marketed by the defendant is different from the specification claimed by the plaintiff. It is also stated that the defendant started using the pouch much before 11.10.1990 which is the date of grant of the patent to the plaintiff. Learned counsel appearing for M/s. Rollatainers Limited, at the time of arguments drew my attention to the difference between the plaintiff's pouch and the pouch of M/s. Rollatainers Limited. It was pointed out that the Standipack pouch comprised of three independent sheets i.e. front, back and bottom which are joined together, whereas the Rollatainers pouch comprises of one single layer of sheet which is

folded and joined together from bottom and the side and is sealed after the oil is filled in it from the top. The other difference that is pointed out is that the Standipack pouch has a construction of polyester layer adhered to two co-extruded films of LDPE, LLDPE OR HDPE whereas the Rollatainers pack has a construction wherein polyester layer is adhered to three co-extruded layers of LLDPE, HDPE and LDPE. One more difference that is pointed out is that the standipack pouch has polyester layer having a minimum thickness of 12 microns whereas the Rollatainers pack has polyester layer of minimum thickness of 10 microns. Several other differences have also been pointed out. This however, is a matter which is required to be gone into at the time of trial of the final suit and no opinion, even prima facie is expressed at this stage.

REVOCATION OF THE PATENT:

14. Section 13(4) of the Patents Act provides that the examination and investigations required under sections 12 & 13 shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon. Thus, grant of patent in any manner does not guarantee the validity of the patent. Reference may also be made to the provisions of Section 64 of the Patents At which deals with revocation of patents. It provides that a patent whether granted before or after the commencement of the Act, may, on the petition of any person interested or of the Central Government or on a counter-claim in a suit for infringement of the patent, be revoked by the High Court on the ground that the subject of any claim of the complete specification is not an invention within the meaning of this Act or that the invention so far as claimed in any claim of the complete specification is not new having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in Section 13 or that the invention so far as claimed in any claim of the complete specification is obvious or does not involveany inventive step,

having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim.

15. It has been held in a series of judgments that no presumption of validity attaches to a patent granted by the Controller under the Act notwithstanding examination and investigation made under Sections 12 and 13. In this connection reference may be made to a decision in Bishwanath Prasad Vs. Hindustan Metal Industries; , Hindustan Lever Ltd. Vs. Godrej Soaps Ltd. and M/s. Niky Tasha India Pvt. Ltd. Vs. M/s. Faridabad Gas Gadgets Pvt. Ltd. reported in AIR 1985 Delhi 136 at 138. In Surendra Lal Mahendra Vs. M/s. Jain Glazers & Others, reported in ILR 1981(1) Delhi 257, the Delhi High Court relying upon the judgment in Smith Vs. Grigg Ld., 41 RPC 149(1) held that despite all the safeguards and circumspection contemplated in various provisions of the Act against grant of patent in respect of a spurious, purloined or fake invention, the Legislature minced no words in clarifying its intendment that no presumption of validity would attach to a patent granted by the Controller under the Act, notwithstanding examination and investigation made under Sections 12 & 13 thereof.

16. When the conditions referred to in Section 64 are examined and applied to the facts and circumstances of the present case in the light of the observations made herein before, it is clear that the use of the pouches for packaging purposes of the nature of the one used by the plaintiff and in respect of which patent has been granted was widely prevalent. The same is also an admitted position when the plaintiff has stated that the storage of liquid products other than liquid in a pouch does not constitute a novel idea. Some of the defendants have filed applications for revocation of the patent granted in favour of the plaintiff under section 64 of the Patents Act.

There are cases where it is held that when an application is filed seeking for revocation of the patent and questioning the validity of the patent the court should not grant an injunction. It is settled law that in an action for infringement

of a patent an injunction would not be granted where the validity of the patent itself has been questioned and a revocation petition has been filed. In this connection reference may be made to a decision of the Madras High Court in V. Manicka Thevar Vs. M/s. Star Plough Works, , wherein it was held that if from the objections raised by the defendant it is clear that a serious controversy exists as to whether or not the invention involves any new inventive skill having regard to what was known or used prior to the date of the patent; courts would not grant an injunction restraining the defendant from pursuing his normal business activity. It was also held that an interim injunction would not be granted if the defendant disputes the validity of the grant. In M/s. Niky Tasha India Pvt. Ltd. Vs. M/s. Faridabad Gas Gadgets Pvt. Ltd., AIR 1985 Delhi 136 at 140 (supra) it was observed by this court that no injunction should be granted when there is a serious question of the validity of the design to be tried in the suit and an application for cancellation has been made.

CONFLICTING STAND OF THE PLAINTIFF IN RESPECT OF THE POUCH AND LAYERS IN THE PLAINT VIS-A-VIS REPLICATION:

17. Foregoing discussions have clearly revealed that the plaintiff has taken a stand in the plaint that novelty in the exclusive right of a patent rests in respect of the pouch whereas in the reply and the replication filed the stand is that the novelty is in respect of the specific thickness and construction of the layers that can successfully hold the liquid in the pouch. The pleadings, therefore, are self-contradictory and conflicting.

SUPPRESSION OF MATERIAL FACTS:

18. The defendants have alleged fraudulent and mala fide conduct of the plaintiff in conducting the proceedings and have submitted that in the light thereof the plaintiff is not entitled to any interim injunction. It is an admitted position that the plaintiff although filed suits in this court, including against Rollatainer Ltd., which is the main upplier of the pouches to Castrol India Ltd., could not obtain any interim ex parte injunction against the defendant. The plaintiff however,

filed a suit before Ambala District Courts against Castrol India Limited, which is the main buyer of one of the defendants, Rollatainers Ltd. and obtained an ad interim injunction order restraining Castrol, from using the pouch in question. In the said suit filed in the Ambala Court, the plaintiff did not mention/aver that the plaintiff filed a suit as against M/s. Rollatainers Limited, who has been supplying pouches to Castrol India Limited, in Delhi High Court, which was registered as Suit No. 2427/1996 in which ad interim injunction was refused in favour of the plaintiff. The plaintiff in the said suit filed before the Ambala Court also concealed the letter dated 20.2.1998 written by the plaintiff to defendant No. 2 in order to show that the plaintiff was fully aware that the defendant No. 2 has been purchasing pillow pouches from M/s. Rollatainers Limited against whom the suit is pending in this court. The Ambala Court granted an ex parte ad interim injunction in favour of the plaintiff and against the defendant and immediately after obtaining the said ex parte ad interim injunction the said news was published in all the leading newspapers about the alleged infringement of patent. The defendant however, moved the Hon'ble Supreme Court and the Supreme Court passed an order directing for transfer of the said suit to be tried by this court. The aforesaid position makes it crystal clear that the plaintiff suppressed material facts in the suit filed in the Ambala Courts and did not approach the court with clean hands and therefore, the said order of injunction is liable to be vacated on that count alone which the Supreme Court rightly stayed. In this connection reference may be made to the decision of the Supreme court in S. P. Chengalvaraya Naidu Vs. Jagannath; (1994) 1 SCC 1. It was held in the said case by the Supreme Court that the non-production and even non-mentioning of the release deed at the trial amounted to playing fraud on the court and that a litigant who approaches the court is bound to produce all the documents executed by him which are relevant to the litigation and if he withholds a vital document in order to gain advantage on the other side then he would be guilty of playing fraud on the court as well as on the opposite party. The Supreme Court further held that in case there is suppression of material facts

and concealment of facts the High court would be justified in vacating the injunction order as the plaintiff has failed to come before the court with clean hands. The Supreme Court went to the extent of holding that even the suit could be dismissed, in view of such concealment of material facts. The Division Bench of this court is Satish Khosla Vs. M/s. Eli Lilly Ranbaxy Ltd., reported in 71 (1998) Delhi Law Times 1 (DB) dismissed the suit itself on the ground of non-disclosure and suppression of material facts by the plaintiff by observing as under:

> "In our view, by withholding the plaint of the earlier suit from the Court and by not disclosing that in the earlier suit the respondent has not been able to get the injunction, the respondent is guilty of playing fraud on the court as well as on the opposite party and such acts had been done only in order to gain advantage on the other side and to get a stay in the second suit."

CONCLUSIONS:

19. Counsel for the plaintiff sought to submit that the suit at Ambala and suit filed in Delhi had separate and different causes of action and therefore, there was no necessity of mentioning about the suit pending at Delhi in the plaint filed at Ambala Court. This contention is without any merit. Suit filed in Delhi was against Rollatainer Ltd., who is the main supplier of the pouches in question to Castrol India Ltd. against whom the suit was filed by the plaintiff at Ambala Court. When an injunction was obtained by the plaintiff against Castrol India Ltd., at Ambala, the effect of the order was that Castrol India Ltd., was restrained from making purchase of the pouch from Rollatainer Ltd. and then the affected party was also Rollatainer Ltd. and against whom the plaintiff could not obtain an ex parte injunction in Delhi, even by filing such a Suit. Thus causes of action in the two suits cannot strictly be called to be distinct and separate and definitely the two suits are inter-connected.

20. Counsel for the plaintiff however, submitted that the patent granted to the plaintiff by the Controller of Patents is in respect of the construction of co-extruded layers of the pouch for storage and dispensing of the liquid such as

lubricating oil. As the defendants started selling pouchs of the same construction as the patented pouch of the plaintiff they have violated the patent in the light of the provisions of Section 48 of the Patents Act, and therefore, in the light of the principles of law laid down in American Cynamid Vs. Ethicon Ltd.; 1975 RPC 513 the plaintiff is entitled to an injunction as it has satisfied all the principles governing the grant of an interlocutory injunction in the patent matter. According to the plaintiff the patent was granted to the plaintiff and no objection was raised by any party before the same was sealed, and therefore, applying the principles as laid down in the American Cynamid case (supra) the plaintiffs are entitled to injunction in their favour. According to the plaintiff various arguments relating to the validity of the patent and aspects such as prior publication etc. would depend on evidence. The aforesaid submission of the learned counsel for the plaintiff, in my considered opinion, is misplaced. Some of the defendants have already challenged the validity of the patent and have filed applications for revocation of the patent granted in favour of the plaintiff. When the validity of a patent is challenged and revocation application is filed, some of the decisions referred to above have held that no injunction should be granted under such circumstances. There is a strong prima facie case in favour of the defendant in the application filed for revocation and the defendants have strong arguable case. Even Delhi High Court has held that in an infringement act relating to a patent the plaintiff has to make out a prima facie case about the existence of a monopoly right and its infringement by the defendant independently of the grant of patent as such in the case of Surendra Lal Mahendra Vs. M/s. Jain Glazers & Others; ILR (1981) 1 Delhi 257. In Franz Xaver Huemer Vs. New Yash Engineers; , a Division Bench of this court after analysing the law on this point have held that it is not sufficient merely to have registration of the patent. It was also held that the court must look at the whole case of the patentee and the strength of the defense such as those falling under section 107 read with Section 64. It was also noticed in that case that the law in India has deviated from the principles laid down in American Cynamid case (supra) and the rule of triable

issue stands mellowed down in favour of prima facie case. The Calcutta High court also in Hindustan Lever Ltd. Vs. Godrej Soaps Ltd. & Others; has held that the American Cynamid principle does not govern the field of law in India and it was observed that the plaintiff in a patent case must show a prima facie case of an infringement and further that the balance of convenience or an inconvenience is in his favour. It was also held that in a patent case the onus of showing a prima facie case justifying the grant of an injunction is a heavy one and it is comparatively easy for the respondent to establish a defense sufficient to prevent the grant of such an injunction.

21. Considering the entire facts and circumstances of the case and the principles discussed above, I am of the considered opinion that the plaintiff has failed to make out any prima facie case for the grant of temporary injunction in its favour. The injunction as sought for is also refused on the ground that the plaintiff did not act with clean hands rather suppressed material fact from the Court at Ambala where a suit was instituted by the plaintiff against one of the defendants. The application seeking for interim injunction stands rejected and the applications filed under Order 39 Rule 4 CPC stand allowed. The injunction order granted by Ambala Court stands vacated.

It is, however, made clear that whatever opinion has been expressed in this order is my tentative opinion and shall have no bearing on the merits of the case.

Let all the suits be listed on 6.10.1999 for further directions.