

ORIGINAL CIVIL.

Before Lord-Williams J.

In re HEERA LAL BANJARA.

1937

Feb. 8.

Patent—Assignment—Infringement of patent, Suit for—Counter-claim—Revocation of patent—Jurisdiction—Indian Patents and Designs Act (II of 1911), ss. 2(12), 29, 63, 64.

Where a High Court purports to revoke a patent by way of decreeing a counter-claim in a suit for infringement of the patent brought by the assignee from the patentee, the patentee not being a party to the suit and the assignment being unregistered, and in consequence a notification of revocation of the patent is entered in the Register of Patents, another High Court has jurisdiction, on the patentee's application, to order cancellation of the entry.

Indian Patents and Designs Act, 1911, commented upon.

Obiter. A person who becomes entitled to a patent by assignment, but does not cause his title to be registered under s. 63 of the Indian Patents and Designs Act, 1911, cannot bring a suit under s. 29 of the Act for infringement of the patent in question, as he is not the patentee within the meaning of the Act.

Obiter. The defendant in a suit for infringement of patent, cannot obtain revocation of the patent by way of counter-claim in the suit, because no such procedure is recognised in the Code of Civil Procedure.

REFERENCE by the Controller of Patents and Designs under s. 64(3) of the Indian Patents and Designs Act, 1911.

The facts of the case and arguments of counsel appear from the judgment.

P. C. Ghose and *A. C. Mitra* for the patentee Heera Lal Banjara.

S. M. Bose, Standing Counsel, for the Controller of Patents and Designs.

LORT-WILLIAMS J. The petitioner is the original inventor on the record in respect of the Indian Letters Patent No. 14245, dated July 12, 1928.

On May 11, 1936, he attended at the Patent Office in Calcutta for the purpose of depositing the renewal fee in respect of his patent. It was intimated to him that his patent had been revoked by the Patna High Court, and on the next day he received a letter calling

upon him to show cause why, in view of the judgment passed by that Court in suit No. 1 of 1931, his renewal fee should be accepted.

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The petitioner was not a party to that suit. That was a suit by one Ghanashyam Das Jagnani against Ram Narayan Ganesh Narain. The plaintiff apparently alleged that he was the proprietor of the patent in question, which had been originally granted to the petitioner. But the fact was that although the petitioner had assigned his rights to that plaintiff, the latter had not registered the assignment under the provisions of s. 63 of the Indian Patents and Designs Act, 1911. Therefore he was not the patentee within the meaning of s. 2 (12) of the Act, and had no right to bring any suit for infringement of patent rights regarding the patent in question. But the Court, having assumed that the plaintiff had such rights, proceeded to deal with the issues raised and gave judgment against the plaintiff, and purported, in respect of a counter-claim made by the defendant, to revoke the patent. There was an appeal, but the particular question, with which I have to deal now, was not raised or discussed by their lordships of the Privy Council.

With regard to that judgment, it is to be observed that the learned Judge who tried the case (Courtney Terrel C. J.) gave the defendant his remedy by way of counter-claim, but there is no provision in the Code of Civil Procedure for procedure in any suit by way of counter-claim. The learned Judge apparently had in view the provisions of s. 32 of the (English) Patents and Designs Act, 1907, which provides that:—

A defendant in an action for infringement of a patent may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counter-claim in the action for the revocation of the patent.

In view of the fact that the petitioner had no notice of and was not made a party to that suit, there is no way now in which he can get that decision

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reversed, nor do I think it possible now for any Judge of that Court to declare that any part of that decision is a nullity, and no Judge of this Court has power to make such a declaration with regard to the judgment of another Indian High Court of equal jurisdiction.

The position created by the present Act seems to be very inconvenient and likely to raise difficulties such as the one with which I have to deal, because a number of High Courts of equal and separate jurisdiction have jurisdiction to deal with the same patent, that is to say, any patent issued under the provisions of the Indian Patents and Designs Act. The result is that unless some further provision is made by the legislature, it is very likely that there will be conflicting decisions with regard to the same patent by different High Courts.

Some difficulty also is caused by the provisions of s. 64, which refer to *the* High Court, without specifying which High Court is intended. So far as I can understand the meaning of the section, the Controller, whose office happens to be in Calcutta, may refer any application under the section to the Calcutta High Court, which he has done in the present case. But under the definition section, *viz.*, s. 2 (7), "High Court" has the meaning assigned to that expression by the Code of Criminal Procedure, 1898, in reference to proceedings against European British subjects, which meaning includes the High Courts at Fort William, Madras, Bombay, Allahabad, Patna, Lahore and Rangoon, and the Chief Courts of Oudh and Sind, and the Court of the Judicial Commissioner of the Central Provinces.

The difficulty in the present case has really been caused owing to the learned Judge having acceded to the defendant's counter-claim, and granted him revocation of this patent, without reference to the provisions of ss. 26 and 27 of the Act. Section 27 (1) reads as follows:—

Notice of any petition for revocation of a patent under s. 26 shall be served on all persons appearing from the register to be proprietors of

that patent or to have shares or interests therein, and it shall not be necessary to serve the notice on any other person.

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If that procedure had been followed, and the register had been referred to, the only person whose name would have been found appearing in the register would have been that of the present petitioner, and if notice under this section had been given to him, he might have taken the necessary steps to draw the attention of the High Court at Patna to the fact that the assignment to the plaintiff had never been registered, and that he was not the proprietor or patentee within the meaning of the Act.

In view of the judgment of the Patna High Court the Controller has entered in the register of patents a note to the effect that the patent No. 14245, originally granted to the petitioner, was revoked in suit No. 1 of 1931, to which I have already referred. That entry is obviously to the detriment of the petitioner, and his only remedy was to apply to the Controller to expunge that entry. That question has been referred by the Controller, quite properly, to this Court.

The only order, therefore, which it is necessary for this Court to make is that the entry to which I have referred be expunged from the record, and that the register be rectified accordingly, and that the renewal fee already deposited by the petitioner be accepted by the Controller on the basis of the validity of the Letters Patent No. 14245 granted to the petitioner.

Application allowed.

Attorney for patentee: *B. K. Bosu.*

Attorney for Controller of Patents and Designs:
Government Solicitor.

P. K. D.