

High Court Of Delhi Rules Governing Patent Suits, 2022

DELHI

India

The Delhi High Court Act, 1966

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Act 14-RULES-DHC- of 2022

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Introduction By virtue of powers conferred on the High Court under Section 7 of the Delhi High Court Act, 1966 read with the provisions of the Patents Act, 1970 and the Tribunal Reforms Act, 2021, the following Rules are framed.

Background The substantive provisions governing patent suits are contained in The Patents Act, 1970. Patent suits being civil in nature are also governed by The Code of Civil Procedure, 1908 (CPC) as amended by The Commercial Courts Act, 2015. The Delhi High Court, in the last 10-15 years, has witnessed a high growth in the number of patent related litigations before it relating to various scientific and technological fields. The need for the present Rules has been felt due to the complex issues that arise in such patent suits and actions. There is a need to provide for procedures and mechanisms for simpler, effective and efficient adjudication of such patent litigations before the Delhi High Court. The Delhi High Court, under Section 7 of the Delhi High Court Act, 1966, Section 129 of the CPC as also the provisions of the Patent Act, is empowered to make Rules governing procedures for civil suits and patents suits filed before it. The Delhi High Court has already notified the Delhi High Court (Original Side) Rules, 2018, which apply to all original side suits. In addition, the present Rules shall also govern the procedure for adjudication of patent related actions. These Rules are in addition to, and not in derogation of, the provisions of the CPC as amended by the Commercial Courts Act, 2015, as also the Indian Evidence Act, 1872 as may be applicable to patent suits and actions. All patent suits and actions shall be listed before the Intellectual Property Division of the Delhi High Court except those matters which are to be dealt with by a Division Bench of the Delhi High Court.

1. Short title and commencement

(i) The present Rules shall be called 'The High Court of Delhi Rules Governing Patent Suits, 2022'. (ii) The Rules shall come into force on such date as the Chief Justice of the Delhi High Court may notify in the Official Gazette and shall apply to such Courts as the High Court may notify in this behalf.

2. Definitions

For the purposes of these Rules, unless otherwise specified, references and meanings to the following terms are as follows:

a. 'Act' shall mean The Patents Act, 1970.

b. 'Patent Suit' means all suits which seek reliefs as provided for under Section 48, Section 105, and Section 106 of the Act including counter claims under Section 64, Section 108, Section 109, and Section 114 of the Act and all reliefs claimed thereunder.

c. 'Claim construction brief' means a brief which would enumerate all the claims relied upon, break down the construction of each of the terms contained in the claims, their meaning thereof, as also the overall scope and effect of all the claims relied upon, as per the party filing the brief.

d. 'Invalidity brief'

- (i) Invalidity brief shall contain the prior art references with details such as date of publication, country of origin/publication, reference number and the specific portion of the prior art(s) which allegedly anticipates or renders the claim obvious.
- (ii) If the Defendant relies on prior publication/prior use of the patented product/process, the brief shall be specifically referenced along with the date of publication, title of publication, country of origin, and/or the source of the product/process to show use, including reference to any inspection reports.
- (iii) Invalidity brief shall contain a conclusive analysis on how each of the prior arts and/or combination thereof seeks to render the patent invalid, due to lack of novelty and/or inventive step. If lack of inventive step is pleaded, the brief shall clearly explain how the invention would have been obvious to the person skilled in the art, as of the priority date.
- (iv) If invalidity is pleaded on any of the grounds contained in Section 3 or Section 4 of the Act, as being non-patentable, an explanation for the same along with the reasoning thereof, shall be provided in the brief. The invalidity brief may also mention the case law relied upon.
- (v) If invalidity is pleaded based on grounds contained in Section 64(h) and/or Section 64(i) of the Act, the brief shall clearly point out the claims that have not been sufficiently disclosed in, supported by, or enabled in, the specification with an explanation of the insufficiency for each of the claims.
- (vi) If invalidity is pleaded based on any of the other grounds provided in the Act, the brief shall specify the provision and the grounds for the same in a simple manner.
- (vii) If any of the grounds of invalidity have been dealt with by the Office of Controller General of Patents, Designs and Trade Marks (IPO), the same shall be referenced against the respective ground.

e. 'Infringement brief' Brief to be filed by the Plaintiff, along with the claim construction brief, that compares the elements of each of the claims, and the manner in which the Defendant's product/process infringes the claims relied upon. In the case of Standard Essential Patents (SEPs), the infringement brief shall contain claim charts, mapping the patent claims to the standards, and the manner in which the Defendant infringes the same.

f. 'Non-infringement brief' Brief to be filed by the party claiming non-infringement comparing the suit patent claims with its product/process to show non-infringement. In cases where the Defendant raises the Gillette defence,¹³ as also in the case of SEPs, the Defendant shall disclose whether its products comply with the standard or the alternate technology/patent being implemented by it. The said party is also free to furnish its own Claim construction brief or claim mapping, if it so chooses, to support the plea of non-infringement.

g. 'Damages brief/Accounts of profits brief' A brief to be filed by a party seeking damages/account of profits giving reasonable estimate of the extent of damages or account of profits claimed and the foundational facts/account statements in respect thereof along with any evidence, documentary and/or oral led by the party to support such a claim. Provided that, such a brief may be amended upon disclosure of further facts by a Defendant.

h. 'Advisors' shall mean the panel of advisors maintained by the Court under Rule 13 of these Rules and as notified on the Delhi High

Court website from time to time.i. ‘Technical primer’ shall mean a document either in text form or electronic form (including PowerPoint presentation(s)/audio/video files) which gives an introduction to the basic science and/or technology covering the patent(s), preferably in simplified language.j. ‘Priority patent application’ shall mean a parent application, a Convention²⁴ application or a Patent Cooperation Treaty application from which the suit patent claims priority.

3. Content of Pleadings

A. **Plaint**The Plaint in an infringement action shall, to the extent possible, include the following aspects:(i)Brief background of the technology, technical details, description of the suit patent(s) and the invention covered by the suit patent, description of the Plaintiff’s product or process, if any;(ii)Ownership details of the patent(s), the details of the patent(s) granted in India including the date of the application;(iii)Any other patent applications filed, withdrawn or pending including divisional applications related to, or emanating from, the suit patent or the priority patent application in India;(iv)Brief summary of international corresponding applications/patent(s) and grant thereof including details of worldwide protection for the invention;(v)Brief prosecution history of the suit patent(s)(vi)Details of any challenge to the suit patent(s) and outcome thereof;(vii)Details of orders, if any, passed by any Indian or international court or tribunal, upholding or rejecting the validity of the suit patent or a patent which is for the same or substantially the same invention;(viii)Information as to whether the patent(s) is being enforced for the first time in India;(ix)Precise claims versus product (or process) chart mapping or in the case of SEPs, claim chart mapping through standards;(x)Infringement analysis explained with reference to the granted claims in the specification. Details of the allegedly infringing product or process, the manner in which infringement is being alleged including, if available, a description of the defendant’s process;(xi)Details of licenses granted qua the suit patent or the Plaintiffs relevant portfolio, to the extent feasible;(xii)Summary of the relevant correspondence entered into between the parties relating to the suit patent(s) or relevant portfolio;(xiii)Preliminary list of experts, if any;(xiv)Details of sales by Patentee and/or statement of royalties received qua the suit patent(s) or the portfolio, wherever feasible and if relied upon by Plaintiff;(xv)The remedy/relief which the Plaintiff seeks and quantification of damages (could be based on estimated loss whether due to lost profits and/or royalties incurred by the Plaintiff), interest and costs.B. **Written Statement**The Written Statement in an infringement action shall, to the extent possible, include the following aspects:(i)Defences of non-infringement and/or grounds for invalidity of the suit patent, if any, shall be pleaded. In addition, if revocation of the suit patent is being sought, a separate counter-claim shall be filed;(ii)To support non-infringement, the written statement shall contain a response to the Plaintiff’s claim chart as also a technical analysis. It may be accompanied by a technical report;(iii)Other defences for non-grant of injunction and damages shall be raised in the written statement;(iv)Details of any challenge to the suit patent either at the stage of pre-grant opposition/post-grant opposition or by way of revocation;(v)If the Defendant is willing to take a license, the quantum of royalty shall also be specified. This shall be without prejudice to the Defendant’s stand on issues of non-infringement and invalidity;(vi)If the Defendant raises a case of non-infringement, the products/process/technology being used by the Defendant would also be specified. Onus of proving infringement would, however, be in terms of Section 104A of the Act;(vii)The written statement may also contain details and the exact description of the allegedly

infringing products and details of manufacture, sale, import, export, in terms of quantity as well as revenue of the allegedly infringing products or products made from the allegedly infringing process;(viii)Details of any relevant correspondence relating to the suit patent or relevant portfolio;(ix)Details of any steps taken for seeking regulatory approval and the status thereof, in respect of the product qua which infringement is alleged;(x)Details of any patent applications filed in India or internationally, by the Defendant, its group companies, affiliates, relating to the allegedly infringing product/process;(xi)Details of any licenses and cross licenses entered into by the Defendant, its group companies, affiliates etc. relevant to the allegedly infringing product including royalties paid or received.C. Counter ClaimThe Counter-claim shall be precise as to the grounds that are raised under Section 64 of the Act. The grounds as to lack of novelty or inventive step shall be supported by relevant prior art documents. The said documents would be listed in the counter-claim and the specific extracts relied upon shall be referenced. All the prior arts and literature shall be attached to the counter- claim. The prior art documents have to be precise and the counter-claim shall contain a chart as to which specific claims are hit by which prior art or combinations thereof. If a counter-claim is filed seeking reliefs on the ground of non-infringement, then the requirements for a Suit under Section 105 of the Act shall be followed.D. ReplicationThe Replication to be filed shall briefly summarise the Plaintiff's case and the Defendant's case. Thereafter, it shall give a para-wise reply to the written statement. If any of the prior arts cited by the Defendant to allege invalidity of the suit patent have been considered during the prosecution of the patent, or during opposition proceedings, details thereof shall be provided in the Replication.E. Written statement to the Counter-claim and Replication in the Counter-claim shall follow a similar pattern as per Clause B or Clause C above, as may be applicable.F. In a suit under Section 105 of the Act seeking declaration of non-infringement, the Plaintiff shall specify the scope of the claims, the product/process being implemented by the Defendant claimed to be non-infringing and the technical/legal basis on which declaration is being sought.In such a case, a claim construction brief and a non-infringement brief shall accompany the suit along with a technical report. The Plaintiff shall also provide details of any proceeding(s) filed by the patentee against the Plaintiff in respect of the same, or substantially the same, invention.G. In a suit under Section 106 of the Act for injunction against groundless threats, the Plaint shall contain the following:(i)Nature of the threat, whether oral or documentary;(ii)If the threat concerns a patent which has been granted and if its validity is being challenged, an invalidity brief to accompany the Plaint;(iii)Any correspondence exchanged between the parties.H. Original petitions under Section 64 of the Act seeking revocation of patents shall follow a similar pattern as a counter-claim seeking revocation with modifications mutatis mutandis.

4. Documents to be filed

A. Documents to be filed along with the PlaintThe documents to be filed with the plaint shall, to the extent possible, include, inter alia:(i)certified copies of the certificate of grant of patent along with payment of annuities thereof. If certified copies are not readily available, an undertaking to furnish the same prior to the First Case Management hearing shall be filed with the Plaint(ii)Complete patent specification including title and description of invention, claims, the abstract and drawings as granted;(iii)a list of all corresponding patent applications/patents in major jurisdictions such as the EU, US, UK, Japan, Canada, if any, along with their current status in a tabulated form.A standard template for the said table is given below. If a decision has been given by any patent authority/court

in another jurisdiction, a link to the same can be provided in the same table: Indian Patent Application No. Corresponding PCT application Priority date Date of filing of provisional specification Date of filing of final specification in major jurisdictions S.No. Country Patent Application/Grant No. Status (Pending/Opposed/granted/rejected (if opposed, name of opponent)) (iv) Details of related patent applications/patents to the suit patent, including divisional applications, patents of addition, if any, in India shall be furnished in a tabulated form along with their current status; (v) A summary of the patented invention and infringement alleged shall be annexed either as a note or as a PowerPoint presentation printed with two slides per page; (vi) Expert report, if any, relied upon by the Plaintiff for infringement analysis; (vii) Copies of all relevant correspondence; (viii) In case of license agreements being relied upon, copies of the license agreements redacted or otherwise; (ix) Note on justification for license fee, if claimed; (x) Laboratory analysis reports, if any.

B. Documents to be filed along with the Written Statement/Counter-Claim The documents filed with the Written Statement/Counter-Claim shall, to the extent possible, include, inter alia: (i) Copies of any decisions of a Court or any patent authority relating to the suit patent or a corresponding patent application in any jurisdiction; (ii) Expert report/technical report relied upon; (iii) Analysis for non-infringement or invalidity; (iv) In case of a process patent, the analysis relating to invalidity shall include the prior art references that are relied upon for lack of novelty or inventive step; (v) Any licenses obtained and copies thereof redacted or otherwise; (vi) Clear copies of the prior art documents relied upon. If the same are commentaries or technical journal or books, the cover page showing the author, title, year of publication and the relevant extract be filed. In case of internet print-outs of prior art documents, the specific link from where the document is downloaded be mentioned on the cover page, if the same is not appearing in the footer of the document along with the date of printout; (vii) In case of pharmaceutical patents, the specific formula/molecule/composition in the prior art documents which seeks to defeat the novelty or inventive step of the suit patent be highlighted; (viii) Laboratory analysis reports, if any; (ix) Statement of accounts of quantum and sales of allegedly infringing product(s) or the product(s) obtained from the allegedly infringing process; (x) Documents relied upon for each of the grounds under Section 64 of the Act, as required.

C. Any other documents to be filed by either party (i) Any other Documents in the possession of the parties and material to the issue of infringement shall be filed; (ii) Details of licensees, royalty, FRAND pricing (under sealed cover) may be filed.

5. First hearing of the suit

(i) At the first hearing, the patentee may seek an interim injunction as also appointment of a Local Commissioner for inspection, etc.. If appointment of a Local Commissioner is being prayed for, the specific premises where the product is being manufactured or the process is being implemented, be ascertained and mentioned in the application. (ii) In addition to any interim orders that the Court may pass at the first hearing, inspection of the manufacturing facilities may also be directed. (iii) In order to assist the Local Commissioner, technical experts from both sides may be permitted to be present at the time of execution of the commission. The Local Commissioner shall address any issues of confidentiality, if raised by either party, at the time of execution of the commission by filing the said confidential information before the Court in a sealed cover for further orders. (iv) If the Defendant is on caveat, upon receiving notice of two working days, the Defendant shall be ready

with any documents it wishes to rely upon to oppose the grant of any interim relief, on the first hearing.(v)Upon infringement being prima facie established, the court may pass directions for monetary payments instead of an injunction, in exceptional situations, and on such terms and conditions as the Court may deem fit.(vi)In case of grant of an interim injunction, the Court may direct the Plaintiff to give a cross undertaking of costs or security, in case it loses at trial or if the patent is held to be invalid, on such terms as it deems fit.

6. Memo of Parties/Service of Defendant

The name of the main Defendant against whom relief is sought shall be impleaded as Defendant No. 1 in the Memo of Parties. Where ex-parte relief is sought, service to the Defendants is not mandatory. However, if the Plaintiff chooses so, advance service of two working days, by email, would be considered as adequate service for the first hearing, especially for Defendants located in India. If the Defendant has filed a caveat, service by email should be made at least two working days, at the address available on the caveat, before the first listing of the case.

7. Filing of affidavits of admission/denial and other briefs

(i)In patent infringement suits, certified copies of extracts from the patent register, grant certificates, granted patent specification along with abstracts and drawings, and publicly available cited prior art documents, shall not be usually denied.(ii)Affidavits of admission/denial shall accompany the respective pleadings of the parties as provided for in the Commercial Courts Act, 2015.(iii)Affidavits of admission/denial shall be filed in respect of correspondence exchanged between the parties and other documents.(iv)Any person who unjustifiably denies any documents, shall be liable to be burdened with costs.(v)Upon admission/denial being completed, prior to the First Case Management Hearing, both parties shall file their respective claim construction briefs, invalidity briefs and infringement briefs. The said briefs shall usually not exceed 10 pages each and would contain a brief description of the construction of claims, the case on invalidity and infringement of the patent. If there are multiple patents involved in a suit, or for other justifiable reasons, then leave of Court shall be sought for filing longer briefs. Leave to amend the said construction, invalidity and infringement briefs may be sought for substantial cause prior to commencement of evidence.(vi)Upon completion of pleadings, prior to the First Case Management Hearing, the Plaintiff may also file the Damages/Accounts of Profit brief.(vii)The claim construction brief, invalidity brief, infringement brief, non-infringement brief, etc. filed by parties shall not be construed as pleadings. The contents of these briefs shall also not be beyond the pleadings. Filing of non-infringement brief shall not shift the onus as prescribed in the Act.(viii)Technical Primer: Prior to the First Case Management Hearing, the court may direct filing of a technical primer jointly by the parties to understand the basic science/technology covering the patent(s).

8. First Case Management Hearing

(i)The Court would peruse the pleadings, the claim construction briefs, invalidity, infringement, and damages/accounts of profit briefs, and strike the actual issues where there exists a dispute between the parties. For the purposes of settlement of issues, the Court may also seek the assistance of an

independent technical expert from amongst the panel of Advisors maintained by the Court or call experts of the parties to assist the court. Hot-tubbing may be resorted to by the Court even before striking of issues. Provided that the Court may decide any issue, which does not require evidence, at any stage. (ii) The Court shall then direct parties to file their list of witnesses including the names of the expert witnesses whose evidence is to be adduced. (iii) The Court shall also direct the filing of affidavits in evidence by the parties, and in which order. The Court may, depending on the facts, direct the order in which the trial is to be conducted i.e. trial of infringement or invalidity of the patent first, as it deems fit. (iv) The Court may direct leading of evidence on any one or more of the issues, as a preliminary issue to expedite the decision in the suit.

9. Second Case Management Hearing

(i) The Court shall peruse the affidavits in evidence filed by the parties and shall fix the time, venue and duration for the cross-examination of the witnesses. On the Court's own motion or on application of a party or a witness, evidence may be directed to be recorded through video conferencing, as per the applicable Rules. (ii) If parties are willing to engage agencies for transcription of evidence, appropriate directions qua the same may also be passed. Video recording of evidence may also be directed. The timelines for recording of evidence may be monitored by the Court. In case of outstation witnesses, the Court shall endeavour to fix specific time limits for cross examination. (iii) Hot-tubbing: Expert testimony may be directed by the Court on its own motion or on the application by a party, to be recorded by Hot Tubbing technique guided by Rule 6, Chapter XI, Delhi High Court (Original Side) Rules, 2018. (iv) Recording of evidence may be directed in outstation venues with the consent of parties or if the Court deems fit. For such recording of evidence, electronic records of the suit may be made available to the parties. (v) Recording of evidence by a Local Commissioner may be directed to expedite the trial.

10. Third Case Management Hearing

In this hearing, the Court shall review the evidence recorded so far and may proceed to decide any preliminary issues, or alternatively direct the parties to proceed to trial on the remaining issues. All directions, as can be passed in the Second Case Management Hearing, may also be passed by the Court.

11. Confidentiality clubs and redaction of confidential information

(i) At any stage in a proceeding, the Court may constitute a confidentiality club or adopt such measures as appropriate, consisting of lawyers (external & in-house), experts as also nominated representatives of the parties, for the preservation and exchange of confidential information filed before the Court including documents, as per the Delhi High Court (Original Side) Rules, 2018. Such nominated representatives of the parties, appointed to the Club, may inter alia, be persons who are not in charge of, or active in, the day-to-day business operations and management of the respective parties so as to maintain the integrity of the information so disclosed. The members so constituting the Club shall be bound to desist from disclosing, sharing or utilizing, including to third parties, the confidential or sensitive information that they may access, or become privy to, in the course of

proceedings;(ii)The Court may, upon a request made by way of an application, direct the redaction of such information (including documents) it deems to be confidential;(iii)If any redacted pleading/document is sought to be filed as being confidential, a non-redacted version of the same may be filed in a sealed cover along with an application supporting such claim for redaction.

12. Mediation/Early Neutral Evaluation (ENE)

At any stage in the suit, if the Court is of the opinion that the parties ought to explore mediation, the Court may appoint a qualified mediator or panel of mediators including, technical experts to explore amicable resolution of the dispute. Consent of the parties is not required, once the court is of the opinion that an amicable resolution needs to be explored. Further the mediator appointed by the court could be a scientific expert, economic expert or a legal expert, assisted by technical experts. At any stage the court may also direct ENE by appointing a qualified and independent evaluator, if it is of the opinion that such ENE would assist in early resolution. Mediation/ENE proceedings may proceed concurrently with the legal proceedings before the Court, so as not to delay adjudication.

13. Panel of Advisors

The Delhi High Court shall draw up a panel of Advisors, for assisting Judges in deciding patent suits. Such advisors may include experts in the sciences, economists, academicians, accountancy experts, legal experts, qualified patent agents with subject expertise, officers of the IPOs, etc. The list shall be reviewed periodically. Prior to their appointment, a declaration shall be signed by the advisor that he/she has no conflict of interest with the suit/proceedings, and would assist the Court fairly and impartially. While appointing advisors to assist the Court, the Court may take suggestions from the parties. The compensation to be paid to the experts shall be commensurate to the experts' qualification, experience, standing and expertise on the subject. It is clarified that such Panel shall be distinct from the panel of experts constituted under the Delhi High Court Intellectual Property Rights Division Rules, 2022.

14. Preservation of evidence

Any audio or video recordings of the evidence recorded shall be preserved in the electronic record of the case, in a manner so as to ensure that the same is not editable or cannot be tampered with in any manner.

15. Final hearing

Prior to the final hearing, the court shall direct parties to present a summary of pleadings and evidence along with the specific page numbers of the files. The Court can direct the presence of at least one technical person from among the witnesses from each side, to assist the Court during the final hearing. The Court may fix time limits for oral submissions to be made.

16. Summary Adjudication in Patent cases

In addition to the provisions contained in the Commercial Courts Act, 2015 for Summary judgment, summary adjudication may be considered by the Court in cases falling in any of the following categories: (i) Where the remaining term of the patent is 5 years or less; (ii) A certificate of validity of the said patent has already been issued or upheld by the erstwhile Intellectual Property Appellate Board, any High Court or the Supreme Court; (iii) If the Defendant is a repeated infringer of the same or related Patent; (iv) If the validity of the Patent is admitted and only infringement is denied.

17. General Clause

Procedures and definitions not specifically provided for in these Rules shall, in general, be governed by The Civil Procedure Code, 1908 as amended by The Commercial Courts Act, 2015 and the Delhi High Court (Original Side) Rules, 2018, as also the Delhi High Court Intellectual Property Rights Division Rules, 2022, to the extent they are not inconsistent with the present Rules. By Order of the Court, MANOJ JAIN, Registrar General