



March 2026

## **Delhi High Court holds that patent revocation proceedings would continue to survive even after the expiry of the patent sought to be revoked**

A division bench of the Delhi High Court (“**Delhi HC**”) in *Boehringer Ingelheim Pharma Gmbh and Co Kg vs. The Controller of Patents and Anr*<sup>1</sup>, *inter alia* held that (a) a patent Revocation Petition (“**Revocation Petition**”) would be maintainable and would continue to survive, even after the patent sought to be revoked, expires by efflux of time; and (b) a Revocation Petition can be instituted even after an invalidity defence under Section 107<sup>2</sup> of the Patents Act, 1970 (“**Patents Act**”) is taken in a patent infringement suit by a defendant.

### **Brief facts**

On October 5, 2022, Indian Patent (IN) 243301 (“**Patent**”) was granted to Boehringer Ingelheim Pharma Gmbh and Co Kg (“**Boehringer**”) for a pharmaceutical product. On February 17, 2022, Macleods Pharmaceuticals Limited (“**Macleods**”) filed a Revocation Petition before the Delhi HC seeking revocation of the Patent. On February 19, 2022, Boehringer filed a suit before the Himachal Pradesh High Court seeking to restrain Macleods from infringing the Patent (“**Infringement Suit**”). In its written statement, Macleods pleaded invalidity of the Patent under Section 107(1) of the Patents Act. The Patent expired on August 18, 2023 by efflux of time.

Boehringer filed 2 (two) interim applications before the Delhi HC seeking dismissal of the Revocation Petition *inter alia* on the grounds that: (a) no revocation proceedings would lie once the Patent itself had expired; and (b) the Revocation Petition would not lie given Macleods’ defence of invalidity of the Patent in the Infringement Suit. Both these interim applications were dismissed by a Ld. Single Judge of the Delhi HC (“**Impugned Orders**”).

Being aggrieved by the Impugned Orders, Boehringer filed an appeal before a Division Bench of the Delhi HC.

In the Appeal, Boehringer *inter alia* contended that: (a) an expired patent could not be revoked; (b) revocation merely wipes out monopoly with the patent holder and would not date back to its grant; and (c) once an infringement suit is filed, a revocation petition under Section 64<sup>3</sup> of the Patents Act cannot continue, and the only options available with the defendant are to raise an invalidity defence under Section 107 of the Patents Act or prefer a counter claim for seeking revocation of the patent.

<sup>1</sup> LPA 129/2025, CM APPL. 10551/2025 (decided on 24 February 2026)

<sup>2</sup> Section 107 pertains to defences. in suits for infringement. Sub section (1) stipulates that in any suit for infringement of a patent, every ground on which it may be revoked under Section 64 of the Patents Act shall be available as a ground for defence.

<sup>3</sup> Section 64 provides for revocation of patents. Sub section 1 reads as follows: “(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of the Act, may be revoked on a petition of any person interested or of the Central Government or on a counter-claim in a suit for infringement of the patent by the High Court on any of the following grounds, that is to say - ...”

Macleods *inter alia* contended that: (a) expiry of a patent does not efface the right of the patentee to claim damages for infringement which took place during the life of the patent; (b) the effect of revocation is effacement of the patent *ab initio*; (c) an invalidity defence under Section 107 of Patents Act does not, by itself, result in revocation of a patent; and (d) revocation of a patent can only occur if a counter-claim is filed in the infringement suit or if a revocation petition is filed under Section 64 of Patents Act.

## Issue

Whether a revocation petition survives after: (a) the patent has expired; and (b) the defence of invalidity is pleaded under Section 107(1) of the Patents Act in an infringement suit filed by the patentee?

## Findings and analysis

Delhi HC dismissed the appeal and *inter alia* held as follows:

1. Section 64 of the Patents Act envisages revocation of a patent either by a counter claim in an infringement suit or by a revocation petition thereby rendering the same consequences. The counter claim in an infringement suit would invariably seek a declaration of invalidity of the patent *ab initio*. Consequently, revocation of the patent would, in either case, invalidate the grant of the patent from the date of such grant;
2. if the grounds for seeking revocation under Section 64 of the Patents Act are justified, it would indicate that the very grant of the patent was invalid. Therefore, revocation of a granted patent under Section 64 of the Patents Act would relate back to the date when the patent was granted;
3. the retrospective and *in rem* effect of revocation has also been recognised in the judgment of the UK Supreme Court in *Virgin Atlantic Airways Limited vs. Zodiac Seats UK Limited*<sup>4</sup> and the law declared therein is applicable to Indian jurisdiction. The statutory position in the United Kingdom regarding the revocation of patents is akin to that of the Patents Act;
4. the expiry of a patent merely renders it unenforceable and does not deprive the patent of its status as a granted patent under the Patents Act. In an infringement suit, the expiry of a patent merely changes the goal post. The plaintiff still retains the right to claim damages for infringement which took place during the life of the patent, and the defendant, too, therefore has the right to, by way of a counter-claim or revocation petition as he may choose, seek revocation of the patent *ab initio*. Therefore, a revocation petition would be maintainable and would continue to survive even after the patent sought to be revoked expires by efflux of time; and
5. a revocation action under Section 64 of the Patents Act and an invalidity defence under Section 107 of the Patents Act are fundamentally different. The right to file a revocation petition can never be impacted by the right to plead invalidity of the patent under Section 107 of the Patents Act as a defence to the infringement action. Therefore, a revocation petition can be instituted or continue even after an invalidity defence under Section 107 of the Patents Act is taken in the infringement suit.

## Conclusion

By this decision, the Delhi HC has clarified that a revocation petition under Section 64 of the Patents Act and the defence of invalidity of a patent under Section 107 of the Patents Act operate in different spheres. The Delhi HC further clarified that an action for revocation of a patent can be sought by way of a counterclaim or by filing a revocation petition. The right to file a revocation petition under Section 64 of the Patents Act can never be impacted by the right to plead invalidity of a patent under Section 107 of the Patents Act as a defence in an infringement suit.

---

<sup>4</sup> [2009] EWCA Civ 1062

The Delhi HC emphasised that revocation operates retrospectively and renders the patent invalid from the date of grant. Consequently, the expiry of a patent does not render revocation proceedings infructuous, especially when claims of damages survive. This decision sheds light on the fact that the expiry of a patent does not foreclose the right of an interested party from seeking revocation of the patent through revocation proceedings, particularly where claims relating to past infringement and damages remain in issue.

## Disputes Practice

With domain experts and strong team of dedicated litigators across the country, JSA has perhaps the widest and deepest commercial and regulatory disputes capacity in the field of complex multi-jurisdictional, multi-disciplinary dispute resolution. Availing of the wide network of JSA offices, affiliates and associates in major cities across the country and abroad, the team is uniquely placed to handle work seamlessly both nationally and worldwide.

The Firm has a wide domestic and international client base with a mix of companies, international and national development agencies, governments and individuals, and acts and appears in diverse forums including regulatory authorities, tribunals, the High Courts, and the Supreme Court of India. The Firm has immense experience in international as well as domestic arbitration. The Firm acts in numerous arbitration proceedings in diverse areas of infrastructure development, corporate disputes, and contracts in the area of construction and engineering, information technology, and domestic and cross-border investments.

The Firm has significant experience in national and international institutional arbitrations under numerous rules such as UNCITRAL, ICC, LCIA, SIAC and other specialist institutions. The Firm regularly advises and acts in international law disputes concerning, amongst others, Bilateral Investor Treaty (BIT) issues and proceedings.

The other areas and categories of dispute resolution expertise includes; banking litigation, white collar criminal investigations, constitutional and administrative, construction and engineering, corporate commercial, healthcare, international trade defense, etc.

### This Prism is prepared by:



**Farhad Sorabjee**  
Partner



**Pratik Pawar**  
Partner



**Shanaya Cyrus Irani**  
Partner



**Sanjana Pandey**  
Associate



19 Practices and  
40 Ranked Lawyers



8 Ranked Practices,  
22 Ranked Lawyers



15 Practices and  
20 Ranked Lawyers



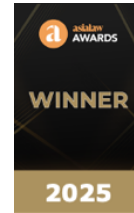
13 Practices and  
49 Ranked Lawyers



20 Practices and  
24 Ranked Lawyers



8 Practices and  
10 Ranked Lawyers  
Highly Recommended in 5 Cities



**Regional Legal Expertise Awards  
(APAC) of the Year**  
Energy Firm Competition/  
Antitrust Firm



Among Best Overall  
Law Firms in India and  
14 Ranked Practices

9 winning Deals in  
IBLJ Deals of the Year

15 A List Lawyers in  
IBLJ A-List – 2026



Recognised in World's 100 best  
competition practices of 2026



Ranked Among Top 5 Law Firms in  
India for ESG Practice



Asia M&A Ranking  
2025 – Tier 1

For more details, please contact [km@jsalaw.com](mailto:km@jsalaw.com)

[www.jsalaw.com](http://www.jsalaw.com)



Ahmedabad | Bengaluru | Chennai | Gurugram | Hyderabad | Mumbai | New Delhi



This Prism is not an advertisement or any form of solicitation and should not be construed as such. This Prism has been prepared for general information purposes only. Nothing in this Prism constitutes professional advice or a legal opinion. You should obtain appropriate professional advice before making any business, legal or other decisions. JSA and the authors of this Prism disclaim all and any liability to any person who takes any decision based on this publication.

Copyright © 2026 JSA | all rights reserved