
(2012) 01 DEL CK 0166
In the Delhi High Court
Case No : FAO (OS) No. 7 of 2011

Dr. Aloys Wobben

APPELLANT

Vs

Yogesh Mehra and Others

RESPONDENT

Date of Decision : 20-01-2012

Acts Referred:

Citation : (2012) 49 PTC 534

Hon'ble Judges : Sanjay Kishan Kaul, J;Rajiv Shakdher, J

Bench : Division Bench

Advocate : T.R. Andhyarujina and Mr. Sudhir Chandra, with Mr. Pravin Anand, Ms. Binny Kalra, Mr. Shrawan Chopra, Ms. Kruttika Vijay, Ms. Saukshmya T. and Mr. Soumik Ghosal, for the Appellant; Soli Sorabjee with Mr. Nikhil Sakhardande, Amit Singh, Ms. Mehernaz Mehta and Ms. Swagata Naik, Advocates for Respondent Nos. 1 and 2, Mr. Arvind Datar with Mr. R. Parthasarathy, Ayush Sharma and Mr. Sudarshan Singh, Advocates, for the Respondent

Judgement

Rajiv Shakdher, J.—The only issue we are called upon to grapple with is: should the respondents/the original defendants be permitted to continue the prosecution of proceedings for revocation of patents instituted by them, before the Intellectual Property Appellate Board (in short "IPAB") when, purportedly, they have elected to prosecute their counter claims for revocation of the very same patents, in the suits for infringement, filed by the appellant, who is the original plaintiff.

2. Before we proceed further, it may be useful to very briefly sketch out the relevant circumstances which have led to the institution of the captioned appeal. For the sake of convenience we would be referring to the parties before us, by their name with the exception that the respondents collectively would continue to be referred as such.

2.1 Thus, in this appeal the appellant, i.e., Dr. Aloys Wobben has laid a challenge to the judgment and order dated 6.12.2010, passed by the learned Single Judge, in the background of the circumstances set out hereinafter.

2.2 Dr. Wobben is both a scientist and an engineer, who claims to have invented devices, methods and systems in the field of Wind Turbine Generators (in short "WTG") and Wind Energy Convertors (in short "WEC").

2.3 A license appears to have been given by Dr. Wobben to respondent no. 4, i.e., Enercon GmbH, a German company (hereinafter referred to as Enercon). Enercon, is evidently a company, which was founded by Dr. Wobben, in 1984. Respondent no. 3, i.e., Enercon India Ltd. (hereinafter referred to as EIL), it is averred, was formed in 1994. EIL is a fruit of a joint venture, entered into between Enercon, respondent no. 1, i.e., Yogesh Mehra and respondent no. 2, i.e., Ajay Mehra (hereinafter collectively referred to as "Mehra's").

2.4 EIL, appears to have obtained non-exclusive licenses to use technical know-how and, at some stage, the intellectual property contained therein, in respect of defined devices, components and systems through a series of successive license agreements. According to Dr. Wobben, the last of such license in agreements was executed on 29.9.2006. This, according to Dr. Wobben, was an Intellectual Property License Agreement (in short "IPLA") which, superseded all previous agreements, including but not limited to, technical know-how agreement of 1994, and the technical know-how agreement of 2000. It is however claimed by Dr. Wobben that the IPLA dated 29.9.2006, was terminated on, 8.12.2008, by Enercon. The reason for such termination, according to Dr. Wobben, was the failure on the part of EIL to fulfill its obligations under the IPLA dated 29.9.2006 despite, due opportunities.

2.5 Dr. Wobben claims, that despite the said termination the respondents herein/ the original defendants have continued the use of the patents, as well as the intellectual property rights contained therein, without authority, to his extreme detriment.

2.6 The grappling for rights resulted in EIL, instituting proceedings in the IPAB, in January 2009, u/s 64 of the Patents Act, 1970 (hereinafter referred to as the "Patents Act"), to seek revocation of certain patents belonging to Dr. Wobben. Evidently, the applications before the IPAB were filed over a period of time extending till 2011.

2.7 Dr. Wobben, in response, filed a series of suits beginning with suit no. 1349/2009 which was instituted on 27.7.2009, followed by seven (7) other suits. The numbers and dates of institution of the remaining seven (7) suits are set out hereinafter: the other suits being suit no. 1963/2009, suit no. 1967/2009 and suit no. 1968/2009 all instituted on 20.10.2009; suit no. 176/2010 was instituted on 28.1.2010; suit no. 1305/2010 was instituted on 02.07.2010 and lastly, suit no. 1333/2010 was instituted on 5.7.2010.

2.8 The defendants in the suits are not common. We have been able to glean this information, by calling for the suit files. In the aforementioned suits, except suit nos. 1967/2009 and 1968/2009, counter claims have been preferred. The details with respect to the defendant(s) which/who have preferred counter claims in

these suits, and the dates on which the same have been filed, are as follows:

SUIT NO.

PARTY/DEFENDANT PREFERRING THE COUNTER CLAIM

DATE OF FILING

1349/2009

Yogesh Mehra (Def No. 1) Ajay Mehra (Def. No. 2) EIL (Def. No. 3)

09.09.2009

1963/2009

Yogesh Mehra (Def No. 1) Ajay Mehra (Def. No. 2) EIL (Def. No. 3)

01.02.2010

176/2010

Amtech Electronics (I) Ltd. (Def. No. 1) EIL (Def. No. 2)

29.04.2010

1305/2010

K.S. Oils Ltd. (Def. No. 1) EIL (Def. No. 2)

24.09.2010 23.09.2010

1333/2010

EIL (Def. No. 2)

22.09.2010

1501/2010

Vaayu (ndia) Power Corporation Pvt. Ltd. (Def. No. 1) EIL (Def. No. 2) Yogesh Mehra (Def. No. 3) Ajay Mehra (Def. No. 4) Enercon Wind Farms (Krishna) Ltd. (Def. No. 5)

24.09.2010

3. It is not in dispute that the revocation petitions preferred with the IPAB, in the year 2009 alone, are nineteen (19) in number. It is also not in dispute that on 02.03.2010, Dr. Wobben raised a preliminary objection with regard to the maintainability of the revocation petition(s) on the ground that Mr Yogesh Mehra, did not have the requisite authority to prefer the said revocation petitions on behalf of EIL. This objection was taken by instituting miscellaneous petitions before IPAB, in which, Dr. Wobben, raised a preliminary objection to the locus standi of Yogesh Mehra to prefer the aforementioned revocation petitions. These miscellaneous petitions were evidently dismissed by the IPAB vide its order dated

22.7.2010; primarily, on the ground that the said objections would be decided and adjudicated upon while, considering the main revocation petitions.

3.1 Evidently, on 10.08.2010, Dr. Wobben filed an interlocutory application (in short "IA") bearing no. 11378/2010 in CS(OS) No. 1963/2009 for stay of proceedings before the IPAB.

3.2 By an order dated 1.9.2010, this court, consolidated the aforementioned eight (8) suits and laid out a schedule for an expedited trial. The arguments on behalf of Dr. Wobben have, largely, rallied around this order. We shall deal with the impact of this order as we go along with the narrative. It is, however, not in dispute that this order was dictated, in court, by the learned Single Judge. Arguments, though, were advanced on behalf of Dr. Wobben, that the order was released only on, 16.9.2010

3.3 It is pertinent to note that just before the aforementioned order was passed by this court, Dr. Wobben had preferred a writ petition against the order of the IPAB dated 22.7.2010 in the Madras High Court. The said writ petition was filed on 26.08.2010. The writ petition was moved, before the Madras High Court, for the first time, on 03.09.2010. This writ petition was disposed of on 8.9.2010. By this order the Madras High Court came to the conclusion, after a detailed discussion, that the original revocation petition and the miscellaneous petitions filed by Dr. Wobben, should be heard and disposed of together, preferably within, a period of three months from the date of receipt of its order.

3.4 It appears that Dr. Wobben being aggrieved by the fact that revocation proceedings before the IPAB were proceeding at a frenetic pace, preferred an application being IA No. 12638/2010 in CS(OS) No. 1963/2009 in this court. The learned Single judge by an order dated 6.12.2010, rejected the prayers made in the said application which read as follows:

a. Defendant nos. 1 and 2 be directed to withdraw the proceedings of revocation filed before the IPAB against suit patents as mentioned in paragraph 2 of the present application; and /or

b. The proceedings for evocation filed by Defendant Nos. 1 and 2 before the IPAB against suit patent nos. 202912 and 202935 be stayed.

Any other orders as this Hon"ble Court may deem fit and proper in the facts and circumstances of the case.

3.5 In so far as the aforementioned application was concerned, i.e., IA No. 12638/2010, a detailed reply was filed by the respondent followed by a rejoinder by Dr. Wobben.

3.6 Since Dr. Wobben was aggrieved by the aforementioned order he preferred the captioned appeal, which was moved before this court on 10.01.2011, when notice was issued in the appeal. The application for interim stay, being CM No. 259/2011, was dismissed as not pressed, at that stage. By an order dated

17.10.2011, the appeal was admitted. Leave was sought by Mehra's and EIL to file an additional affidavit to bring subsequent developments on record. The appeal was posted for hearing on 2.1.2012.

3.7 On the said date, we proceeded to hear appeal. Importantly, the additional affidavit, in respect of which, leave was sought was not filed. The matter was stood over till 3.1.2012 when, arguments in the appeal were heard and the judgment was reserved. Parties were given liberty to file short synopsis, on or before 9.1.2012. While the synopsis on behalf of Dr. Wobben was filed in time, there was a delay of one day on the part of the respondents in filing their synopsis.

SUBMISSIONS OF COUNSELS

5. Mr T.R. Andhyarujina, Sr. Advocate alongwith Mr Sudhir Chandra, Sr. Advocate instructed by Mr Pavin Anand, Advocate advanced submissions on behalf of Dr. Wobben while, the respondents were represented by Mr Soli Sorabjee and Mr Arvind Datar, Sr. Advocates, instructed by Mr Nikhil Sakhardande and Mr R. Parthasarthy respectively.

6. We must record, that after preliminary submissions in the matter were heard, counsels for both sides agreed that for the purposes of disposal of the present appeal the court could proceed on the basis that parallel proceedings in two separate forums for revocation of the very same patents could not proceed if, they were found to be inconsistent with each other. The learned senior counsel for the respondent, therefore, entered a caveat, which was that, in a given set of circumstances where the nature of the challenge in the two forums was materially different, it was quite possible to contend that proceedings could continue concurrently both before the IPAB and the High Court. To our minds this is the correct position in law. The mere fact that proceedings which are concurrent in nature are instituted before two separate and distinct forums would not trigger in, the doctrine of election unless, they are also inconsistent with each other. Concurrent or even cumulative proceeding can continue till satisfaction is obtained qua either proceedings. Satisfaction sets up a bar as, it results in an advantage to one party and disadvantage to another. The principle is clearly elucidated in the judgment of the Supreme Court in Transcore Vs. Union of India (UOI) and Another, . The observations being relevant are culled out hereinafter:-

64. In the light of the above discussion, we now examine the doctrine of election. There are three elements of election, namely, existence of two or more remedies; inconsistencies between such remedies and a choice of one of them. If any one of the three elements is not there, the doctrine will not apply. According to American Jurisprudence, 2d, Vol. 25, p. 652, if in truth there is only one remedy, then the doctrine of election does not apply. In the present case, as stated above, the NPA Act is an additional remedy to the DRT Act. Together they constitute one remedy and, therefore, the doctrine of election does not apply.

Even according to Snell's Principles of Equity (31st Edn., p. 119), the doctrine of election of remedies is applicable only when there are two or more co-existent remedies available to the litigants at the time of election which are repugnant and inconsistent. In any event, there is no repugnancy nor inconsistency between the two remedies, therefore, the doctrine of election has no application.

6.1 A similar view is taken by a Division Bench of this court in Ankur Exports Pvt. Ltd. Vs. Monopolies and Restrictive Trade Practices Commission & Ors. (2010) 100 SCL 1 (Del) in which one of us (Sanjay Kishan Kaul, J) spoke for the court. The Division Bench cited with approval the following extract from the American jurisprudence (2nd Edition) Vol.25 Pages 652- 656:-

12. Concurrent or cumulative and consistent remedies

The doctrine of election of remedies does not apply where the available remedies are concurrent or cumulative and consistent. Where the remedies are not inconsistent, but are alternative and concurrent there is no bar until satisfaction has been obtained, unless the plaintiff has gained an advantage or the defendant has suffered a disadvantage. Because satisfaction is the bar, in some cases, parties have been allowed to take judgment independently on more than one remedy on the same set of facts.

6.2 With this backdrop, the learned senior counsel appearing for Dr. Wobben confined his submissions to only one aspect of the matter, which was, that the respondents by their conduct had elected the proceedings pending in this court as their preferred cause as well as forum, to contest the validity of the patents in issue.

6.3 Towards this end, Mr Andhyarujina contended as follows:

(i). It was submitted that EIL, which is a joint venture of Enercon and the Mehra's, was controlled by Enercon, in as much as, it held 56% shares in EIL. Dr. Wobben, who had assigned his rights in the patents in issue, in favour of Enercon had, in turn, licensed the right of use, in respect of, the patent in issue, in favour of EIL. The fact that Dr. Wobben, was the Chairman of EIL, was not in dispute, and that, his grievance emanated from the fact that despite termination of licence in 2008, EIL continued to use the inventions protected by the patents in issue.

(ii). It was Mr Andhyarujina's submission that, looked at in this background, Mr Yogesh Mehra had no authority and/or locus standi to institute revocation petitions before the IPAB. The first set of revocation petitions numbering nineteen (19), were filed in the beginning of 2009, which was, followed by another set of four (4) petitions which were evidently instituted in 2010 and 2011. It was submitted that, in the first instance, six (6) suits were filed by the appellant in this court, from amongst which, the first suit for infringement was filed in June, 2009. In each of these suits the respondents had preferred counter claims even though in respect of at least nine (9) patents which were subject

matters of the suits, revocation proceedings have been preferred before the IPAB.

(iii). Mr Andhyarujina, submitted that after the amendment of Section 64 of the Patents Act, by virtue of the Patents (Amendment) Act, 2005 "a person interested" may approach one of the two forums for revocation of a patent, i.e., the High Court or the IPAB. In aid of this submission stress was laid on the fact that the word "or" present in the Section ordinarily connotes the intent of the legislature, which is that, the person interested cannot concurrently pursue proceedings before both forums, i.e., the High Court as well as the IPAB. An interpretation contrary to this, would lead to, not only, a multiplicity of proceedings, but also, cause inconsistency and conflict, with each other. In this regard, reliance was placed on the judgment of the Supreme Court in Andhra Pradesh State Financial Corporation Vs. M/s. GAR Re-Rolling Mills and another, and National Insurance Co. Ltd. Vs. Mastan and Another, . In addition reliance was also placed on two orders of even dated 14.07.2010 passed by one of us (Rajiv Shakhder, J) in IA No. 8987/2010 in CS(OS) 81/2010 titled F. Hoffmann-La Roche & Anr. vs Dr. Reddy's Laboratories Ltd. & Anr. and IA No. 2869/2010 in CS(OS) 402/2010 titled F. Hoffman-La Roche Ltd. & Anr. vs Glenmark Pharmaceuticals Ltd.

(iv). Mr Andhyarujina, thus, in fact contended that the counter claims in the infringement suit were preferred by the respondents after they had filed revocation petitions before the IPAB. Being conscious of this position, the respondents, had given their consent to the order dated 01.09.2010 passed by this court. The purpose behind the consent accorded by the respondents, was that, the infringement suits alongwith the respective counter claims would proceed at an expedited pace. The respondents having elected to pursue their counter claims, cannot be allowed to pursue concurrently their revocation petitions before the IPAB.

(v). Lastly, Mr. Andhyarujina also relied upon the extract from AIR Commentaries, The Code of Civil Procedure, 9th (1977) Edition, to buttress his submission that two parallel proceedings which have the potentiality of conflict cannot be allowed to proceed.

7. As against this, Mr Sorabjee, learned senior counsel submitted that the prayers sought for by Dr. Wobben in his interlocutory application (being IA No. 12638/2010) from which the present appeal emanates, if granted, would result in a direct conflict with the directions issued by the Madras High Court, whereby the IPAB has been asked to dispose of the revocation petitions pending before it, alongwith the miscellaneous applications filed by Dr. Wobben.

7.1 To support this submission, Mr Sorabjee, attempted to demonstrate the diffidence displayed by Dr. Wobben in not bringing this very aspect, by which he claims he is aggrieved, to the notice of the Madras High Court and thereafter to the notice of the Supreme Court, at the point in time when, the order of the Madras High Court dated 8.9.2010 was carried in appeal.

7.2 In this context it was pointed out to us, that the writ petition in the Madras High Court was first heard by the court on 3.9.2010; a date decidedly after the order dated 1.9.2010 was passed by the Delhi High Court. At this stage, it was submitted, no attempt was made to bring to the notice of the Madras High Court that an order dated 1.9.2010, had been passed by this court. It was contended that the position was no different even after the Madras High Court passed the order dated 8.9.2010, which was assailed, by way of a special leave petition. It was submitted that the SLP also did not make, any reference whatsoever, to the order of this court dated 1.9.2010. There was in fact no averment to the effect that the respondents had filed counter claims in the infringement suit filed by Dr. Wobben, and therefore, elected to prosecute the proceedings in this court as against those pending before the IPAB. Since, the SLP was withdrawn, the order of the Madras High Court dated 8.9.2010, had attained finality and, was thus, binding on Dr. Wobben, EIL as also the IPAB, which was, arrayed as respondent no. 2, in the writ petition filed in the Madras High Court.

7.3 This apart, Mr Sorabjee stressed that the appellant had participated in no less than 40 hearings/proceedings before the IPAB. The IPAB, as a result of the hearings held by it, has adjudicated upon twelve (12) out of the first nineteen (19) revocation petitions filed before it. The said twelve (12) revocation petitions, have been allowed. Writ petitions assailing the said twelve (12) orders, have been instituted in the Madras High Court and are posted for hearing before the first bench of Madras High Court, on 23.1.2012. Similarly, the IPAB has posted the remaining seven (7) petitions, from amongst nineteen (19) revocation petitions filed, in the first instance, for hearing on 20.02.2012. It was thus contended on behalf of the respondents that as a matter of fact by its conduct, Dr. Wobben had categorically elected to pursue proceedings before the IPAB.

7.4 Apart from the above, Mr Sorabjee sought to bring to our notice the provisions of Section 124 of the Trade Marks Act, 1999 (in short the "TM Act") to demonstrate, by contradistinction, that where the legislature wishes to confer a power of stay, to avoid a potential conflict between two parallel proceedings, it does so, expressly, by conferring such a power in the court. Therefore, while u/s 124 of the TM Act, the court can stay, a suit pending before it (in the eventuality of an application for revocation of the trade mark being adjudicated, either before the Registrar or, before the IPAB); to ascertain their outcome, no such provision is present in the Patent Act. It was submitted that prior to the passing of the Amendment Act of 2005, a person could file both, a revocation petition as well as a counter claim by way of a defence in the High Court. However, despite the constitution of IPAB, no amendment in Section 64(1) of the Patent Act has been brought about conferring a power in the court, similar to that, obtaining in Section 124 of the TM Act.

7.5 Mr Sorabjee, further submitted that, it is not always that the nature of the proceedings before the IPAB and that which is pending before the High Court is similar. To demonstrate this point, it was contended that, to maintain a

revocation petition before the IPAB, the locus of the person would depend on whether he is a "person interested" as defined in Section 2(t) of the Patent Act; however, a defendant who prefers a counter claim in an infringement suit may or, may not, be a "person interested" though he would have the right to challenge the grant of patent. The sum and substance of this argument was that, the legislature has consciously provided for concurrent remedies, and therefore, acceptance of Dr. Wobben's plea will result in a re-writing of the provision. It was submitted that, the doctrine of election would have no application in the present case. In order to invoke the said doctrine, it should satisfy three pre-requisites:

- (i). the existence of two or more remedies;
- (ii). inconsistencies between the two remedies and
- (iii). a choice between two of them.

7.6 According to the respondents, the necessary pre-requisites were not present, in order to, trigger the doctrine of election. This was sought to be demonstrated by contending that the remedies before the two forums are different. As indicated hereinabove, to maintain a revocation petition it necessarily has to be filed by a person interested, which may not be so, vis-?-vis a defendant in the suit, who, by virtue of his being arrayed as a party is entitled by right to prefer a counter claim. Therefore, the revocation which is maintained in the High Court is contingent upon institution of a suit for infringement and, is thus, not an independent remedy available to a litigant. Furthermore, in the counter claim, revocation may be sought with respect to a particular claim alleged to be infringed, whereas in a revocation action before the IPAB, the challenge may relate to each and every claim made in the patent. The remedies, therefore, are not inconsistent, and thus, would not require a litigant to elect, as was sought to be contended on behalf of Dr. Wobben. It was also submitted that the order of the Delhi High Court dated 1.9.2010, on which, reliance is placed by Dr. Wobben, is a procedural order, fixing a schedule for prosecution of the suits with the consent of the parties. It was not as if, the respondents had unequivocally, displayed their intention to discontinue the proceedings instituted with the IPAB and elect those, which were pending before the Delhi High Court. The respondents' conduct is compatible with a stand that the Patent Act prescribed for concurrent remedies. It was submitted that, Dr. Wobben at his own peril chose to move the Madras High Court by way of a petition under Article 226 of the Constitution of India instead of moving the Delhi High Court u/s 41(1) of the Specific Relief Act, 1963. For all these reasons, Mr Sorabjee submitted that any order passed by this court would be directly in conflict with the order of the Madras High Court.

8. In rejoinder Mr Andhyarujina submitted that there was no occasion to amend the writ petition filed in the Madras High Court and bring the factum of the order passed by the Delhi High Court dated 1.9.2010 to the notice of that court, as the order passed by the Delhi High Court, was released to the parties only on

16.9.2010. For this purpose reference was not only made to the reply filed by the respondents to IA No. 12638/2010, but also, the emails exchanged between the parties on 13.9.2010 and 15.9.2010. This apart, Mr Andhyarujina submitted that the issue in the writ petition was as to whether Mr Yogesh Mehra had the requisite authority and therefore, the locus standi, to maintain revocation petitions before the IPAB, and thus, the contention that the aspect pertaining to parallel proceedings could have been incorporated in the writ petition, was a submission that this court should disregard as, it is completely untenable and, therefore, the fact that this aspect was not referred to in the SLP would also have no relevance. Reliance was also placed on the provisions of section 104 and section 117 G of the Patent Act to show that where a counter claim is filed in the suit, it is the High Court alone, which can decide the issue of validity of patent. It was submitted that, in contradiction, the provisions of Section 124 of the TM Act confer this jurisdiction on the IPAB alone, when it comes to determination of the validity of a registered trade mark. Therefore, the parallel sought to be drawn with Section 64 of the Patent Act was misconceived. The fact that some of the grounds raised in the counter claims, as against those in the revocation petitions filed before the IPAB were different, had no substance as a person interested could not "split" the grounds based on which revocation of a patent is sought. It was submitted that in these circumstances, the revocation proceedings pending before the IPAB which relate to patents, which are subject matter of the counter claims, in this court, ought to be stayed.

REASONS:

9. After hearing learned senior counsel for both parties and on perusal of record by us what emerges is as follows:

9.1 The respondents, in January, 2009 had filed the first batch of nineteen (19) revocation petitions before the IPAB. This was followed even according to Dr. Wobben, by four (4) more revocation petitions. These, evidently were, filed in 2010 and 2011. As against this, the record shows that the first suit bearing no. 1349/2009, was instituted by Dr. Wobben, on 27.07.2009. This was followed by three (3) more suits, which were instituted in 2009 itself, as noted above by us. Out of the four (4) suits filed in 2009, two (2) suits do not contain a counter claim. The remaining four (4) suits were filed in 2010 between January, 2010 and July, 2010. Each of these suits contained counter claims. Therefore, what emerges is: (i) that a substantial number of revocation petitions were preferred prior to the institution of even the first suit; (ii) and that out of the eight (8) suits filed, in two suits, i.e., in suit nos. 1967/2009 and 1968/2009 there are no counter claims preferred.

9.2 The order of this court dated 1.9.2010, on which great stress has been laid by Mr Andhyarujina, is an order which was passed admittedly by the learned Single Judge in court. This order was, as it appears, from the record, released to the parties only on 16.9.2010. As to what were the broad contours of the order were definitely known to the parties.

9.3 The miscellaneous petitions impugning the authority and / or the locus standi of Mr. Yogesh Mehra were filed on 02.03.2010.

9.4 The writ petition, in the Madras High Court, bearing no. 20165/2010 was filed on, 26.8.2010 to assail the order of the IPAB dated 27.7.2010 whereby, the IPAB had observed that it would deal with the preliminary objections raised by Dr. Wobben to the authority of Mr Yogesh Mehra along with the revocation petitions. The writ petition, bearing no. 20165/2010, evidently came to be heard for the first time before the Madras High Court on 3.9.2010 and, was finally, disposed of by an order dated 8.9.2010. A SLP was preferred by Dr. Wobben, against the said order of the Madras High Court, which was withdrawn on 26.11.2010. Therefore, the writ petition filed before the Madras High Court could not possibly refer to the events which transpired in the Delhi High Court on 1.9.2010. Since the order of 1.9.2010 was dictated by the learned Single Judge in court, perhaps a corrective action, by way of an abundant caution, could have been taken by at least bringing the said aspect to the notice of the Madras High Court.

9.5 Though, nothing much may turn, on this aspect, as Dr. Wobben seems to have taken a conscious decision not to enlarge the scope of the proceedings either before the Madras High Court or thereafter, in the SLP filed, to assail the order of the Madras High Court dated 8.9.2010. In this regard, we agree with Mr Andhyarujina that since the scope of the writ petition was really to assail the order of the IPAB and, in substance the authority of Yogesh Mehra, to institute the revocation petitions on behalf of Enercon, the instant issue which aggrieves Dr Wobben could not have been made subject matter either of the writ petition or that of the special leave petition. It was not incumbent on Dr. Wobben to mention this fact in the writ.

9.6 However, what concerns us is the ultimate direction issued by the Madras High Court. It is not for us to hazard a guess whether the direction issued by Madras High Court would have been maintained or not, had the order of this court dated 01.09.2010 been brought to its notice. It is therefore, relevant at this juncture to extract the operative part of the Madras High Court's order :-

11. Therefore, in such circumstances, the Hon''ble Supreme Court while laying down the practice and procedure to be adopted where several issues are raised before court and there is possibility of appeal, the court must deal with all issues instead of disposing of the case on only one issue. In fact the decision by the Hon''ble Supreme Court in the case of M/s Fomento Resorts and Hotels Ltd., referred supra, specifically took note of the fact that when, there is a possibility of appeal all issues have to be taken up and decided. The facts of the case clearly indicates that there is a definite possibility of appeal against the decision of the Tribunal and the present writ petition itself is one such illustration. Therefore, in our view, the Tribunal rightly directed the miscellaneous petitions to be considered along with the respective original Revocation Applications and also directed the case to be posted on a specific date and the hearing to be

continuous on day to day basis.

12. Hence, we find no good grounds to interfere with the order passed by the Tribunal. Accordingly, the writ petition stands dismissed. The Tribunal is requested to take up the original Revocation Application along with the miscellaneous petition and her and dispose of the same preferably within a period of three months from the date of receipt of a copy of this order. No costs. Consequently, connected miscellaneous petitions are closed.

(Emphasis is ours)

9.7 A reading of the order would show, while the issue before the Madras High Court concerned the locus standi of Mr Yogesh Mehra to maintain the revocation petition, its direction to the IPAB was to take up the revocation petitions alongwith miscellaneous petitions filed by Dr Wobben raising the said preliminary issue. Therefore, any direction that we pass in the present appeal would have to take into account this direction of the Madras High Court which, is a court of co-equal jurisdiction.

9.8 The contention of Mr Andhyarujina that the respondents have, by consenting to this Court's order dated 1.9.2010, demonstrated their disposition to elect one of the two forums is, in our view, untenable and misconceived. In order to appreciate this submission, we had, in these proceedings, indicated at the very outset that we would presume that the nature of challenge before the two forums was substantially similar, if not completely identical, though we have our reservations on this score as well. The issue of election of one remedy as against the other would arise only if it could be said that respondents are prosecuting two concurrent remedies which are in conflict with each other. The aspect of election would arise only in such a situation, However, to pin, a litigant to his choice, in our view, would require demonstration of the following ingredients: (i) knowledge of the nature of the two actions; (ii) knowledge of the consequences of his choice; and (iii) a conduct which is consistent with the litigant choosing one remedy over the other. Though the conduct could be either explicit or implied; it should be certainly one which demonstrates a conscious application of mind towards the said requisites. If, the choice is conveyed overtly there is no difficulty. The difficulty arises when the choice is implied and hence is required to be construed from attendant circumstances. In either situation there should be a clear demonstration of a choice between two alternatives which are mutually exclusive. The first ingredient would present no difficulty as the person instituting the revocation petitions and the counter claims would ordinarily know the nature of the two actions; it is the latter two which are required to be ascertained. This principle is well articulated by Spencer Bower and Turner's *The Law relating to Estoppel by Representation*, 3rd Edition at paras 324 and 325 at page 341-342. The relevant extracts reads as follows:

324 An election cannot rest upon equivocal words or conduct; it must amount to a clear demonstration of a choice between two alternatives, one being chosen to

the necessary exclusion of the other. There are many decisions in which a submission of election has failed, simply on the ground that the words or conduct proved did not amount to a sufficiently clear and unequivocal intimation of a choice finally made.....

325 In all cases to which the doctrine of election applies the elector has the choice of two rights, either of which he is at liberty to exercise, but not both. The rights between which he has a choice must be mutually exclusive. Obviously there can be no election, choosing one course to the exclusion of another, when in fact there is only one course to take or where the two courses are such that the adoption of one of them does not necessarily indicate a final intention to abandon the other.

(Emphasis is ours)

9.9 In the instant case, having regard to the fact that nineteen (19) out of the twenty three (23) actions for revocation of the patents in issue, had been filed in the IPAB prior to even the institution of the first suit by Dr. Wobben, it would require something more tangible than, just the order of this court dated 1.9.2010, to establish that the respondents had given up their remedy of pursuing their revocation petitions before the IPAB. On a bare reading of the order dated 01.09.2010, we find no conscious exercise of choice by the respondents which would convey election of one remedy over another. Therefore, the other two ingredients according to us, are not present, to hold respondents to its purported election as contended by Dr. Wobben.

10. Apart from the above, there is another dimension to the matter to which we will shortly advert to and, for this purpose, we would assume that the respondents had elected to pursue, though implicitly, their remedy by way of a counter claim before this court. In this context, it would be important to note that in the Code of Civil Procedure, 1908 (in short the "Code") there are several powers conferred upon the court, which allow the court to administer the proceedings in the action filed before it, in a manner that : the convenience of parties, hierarchy of courts, and avoidance of conflicts between courts of co-equal jurisdiction or between a superior and subordinate courts, are borne in mind, so as to secure for the litigant an orderly, timely and just disposal of the cause. To cite some examples: power to consolidate suits (See Section 151); order separate trials (Order 2 Rule 6); to stay parallel proceedings, (Section 10 and Section 151); transfer of proceedings from one subordinate court to another or to itself (Section 24); striking out defence (Section 151), etc.

11. Having regard to the aforesaid, notwithstanding the purported election by the respondents, we are of the view that it is ultimately for the court to decide as to whether or not to restrain a litigant to pursue what is contented to be a concurrent remedy. In this case, it is the respondents action before the IPAB which is sought to be stayed. As a matter of fact, the prayer in the application filed before the Single Judge, in our view, is not quite appropriately paraphrased;

in as much as, it seeks withdrawal of the IPAB proceedings and/or its stay. If we were to agree with Mr Andhyarujina, we would have appropriately restrained the respondents to pursue their action before IPAB. Thus, when a court takes upon itself the task of deciding whether or not, it should allow a party to pursue a proceeding, it would have to examine the surrounding circumstances, in order to avoid a conflict with proceedings in another forum, as also, as in this case, a conflict with the order of a court of co-equal jurisdiction. The circumstances, which persuade us not to restrain the respondents from pursuing their action before the IPAB are as follows:

(i) twelve (12) out of the nineteen (19) revocation petitions initially filed before the IPAB have been disposed of;

(ii) the respondents did not move any court prior to institution of IA No. 12638/2010, for stay of the proceedings before the IPAB. An application bearing no. 11378/2010 in CS(OS) 1963/2009, was filed, as late as on, 10.8.2010 which, to date has not been pressed;

(iii) the Madras High Court, by an order dated 8.9.2010 has, in no uncertain terms directed the IPAB to dispose of the revocation petitions;

(iv) the orders passed in the twelve (12) revocation petitions filed by the respondents, whereby they stand allowed, have been assailed by way of fresh writ petitions, in the Madras High Court. The said writ petitions are posted for hearing before the first bench of the Madras High Court on 23.1.2012.

(v) IPAB has listed the remaining (7) petitions out of the batch of nineteen (19) revocations petitions filed in the first instance before it, for hearing on 20.2.2012;

(vi) the suits pending before this court have yet not reached the stage of final arguments. The issues in the suit were framed on 20.09.2011.

(vii) the proceedings of the court dated 16.11.2011 in CS(OS) 1963/2009, show that the time was sought to file an evidence by way of an affidavit and for exhibiting documents. For the said purpose the suits were listed before the local commissioner on 21.12.2011; then renotified on 22.12.2011, on which date further time was granted to Dr. Wobben for the aforesaid purpose.

12. The aforesaid circumstances would show that the continuation of the proceedings before the two forums has not yet reached a stage of collision, as apprehended by Dr. Wobben. This court is well within its power at the appropriate stage, to pass an order, (after reviewing the circumstances then obtaining) on this very aspect, that is, whether, proceedings before this court ought to continue any further or, should it appropriately await the decision before the IPAB. We take it, ultimately, the purpose of this entire exercise from the point of view of the court would be to avoid conflict, if any.

13. At this juncture, we may also deal with argument advanced by Mr. Andhyarujina based on the principles analogous to section 10 of the Code. It

would be trite to say that principles analogous to section 10 of the Code empower a court to stay a suit pending before it if, the cause and parties before it are substantially the same and, the court dealing with the earlier action would have the jurisdiction to deal with the latter action as well. Where Section 10 of the Code does not apply *sensu stricto*, power is exercised by a court, often u/s 151 of the Code. The supervening object being, to avoid conflict of judgments and decrees. There is no difficulty with the principle, it is its application which at time causes problems. If we were to apply this principle, then we should ordinarily be staying the latter proceedings, that is, the suits pending in this court to await the result of the IPAB action.

13.1 It is perhaps to meet this difficulty, qua his earlier submission, that Mr. Andhyarujina took recourse to the provisions of section 104 and section 117 G of the Patents Act. A careful reading of section 104 would show it provides that no suit instituted whether for declaration u/s 105 or for a relief u/s 106 or for infringement of a patent can be filed in a court which is inferior to a District court and, where the defendant(s) have preferred a counter claim, it will have to be transferred to the High Court. Similarly, in tandem with this provision, section 117 G transfers all appeals against order or decision of the Controller and all cases pertaining to revocation of Patents to the IPAB, save and except that which pertains to counter claims in infringement suits and rectification of registers, which are pending before a High Court.

13.2 None of these provisions to our minds exemplify an intention of the legislature, contrary to what we have observed, that proceedings can continue only in the High Court. All that section 104 provides is that, where in a suit for infringement, a counter claim is preferred, it would stand transferred to the High Court. Section 117 G only emphasises this scheme and the intent behind section 104.

14. Mr. Andhyarujina's reliance on the judgments of the Supreme Court in the case Andhra Pradesh Financial Corporation (*supra*) and National Insurance Co. (*supra*) will not further Dr. Wobben's cause.

14.1 Briefly, the issue which arose for consideration in A.P. State Financial Corporation (*supra*) was whether a Financial Corporation, which is set up u/s 3 of the State Financial Corporation Act, 1951 (in short "SFC Act") was entitled to take recourse to a remedy u/s 29 of the SFC Act even after obtaining an order under the provisions of Section 31 of the SFC Act without executing the said order. The Supreme Court came to the conclusion: firstly, that an order u/s 31 of the SFC Act was not a money decree. Secondly, it held that since Section 31 of the SFC Act provided that an action under the said provision could be taken "...without prejudice to the provisions of Section 29 of the SFC Act...", there was no impediment in a Financial Corporation taking recourse to provisions of section 29 of the SFC Act to recover its outstanding dues by abandoning the proceedings u/s 31 of the SFC Act as the final order u/s 31 of the SFC Act had remained unsatisfied.

14.2 Mr Andhyarujina has attempted to lay stress on those observations made in paragraph 13 at page 659 of the said judgment of the Supreme court wherein, it is stated that the State Financial Corporation: "...cannot simultaneously initiate and take recourse to the remedy available to it u/s 29 of the Act unless it gives up, abandons or withdraws the proceedings u/s 31 of the Act, at whatever stage those proceedings may be. The Corporation cannot simultaneously pursue two remedies at the same time. The reach and scope of the two remedies is essentially different even if somewhat similar result flows by taking recourse to either of the two provisions in certain respects....."

14.3 The conclusion that we have arrived at is somewhat similar, in as much as, till the stage of satisfaction is reached two concurrent proceedings can proceed unimpeded. The facts in the instant case would show that substantially, the proceedings before the IPAB, were initiated prior to those which were instituted in this court. The respondents did not, nor could it, under the provisions of the Patents Act suo motu initiate proceedings in this court. It is by virtue of a suit for infringement being filed by Dr. Wobben wherein, the respondents are impleaded as defendants that a statutory right arose in their favour giving them right to challenge the validity of patents in issue in the suits, by filing counter claims. Therefore, neither were the actions taken by the respondents simultaneous in point of time nor, was the action in this court, in a sense, voluntary. As we construe it, the counter claims filed by respondents only establish the consistency of the stand taken by them before the IPAB, that the patents in issue, according to them, are not valid. Therefore, as observed by us hereinabove, it would be in the fitness of things that the respondents continue with their proceedings before the IPAB and, it is only when they reach a stage of complete satisfaction that it could be stated that the proceedings, in this court, perhaps could not continue further. That stage, in our view, has not been reached as yet.

14.4 As regards the judgment in the case of National Insurance Co. Ltd. (supra) is concerned, the facts which briefly, obtained in the said case, were as follows: The appellant in that case was an insurance company, which was aggrieved by the order of the High Court. The first respondent before the Supreme Court was a cleaner of the offending lorry while, the second respondent was its owner. It was the first respondent's accident with the offending lorry which resulted in his suffering injuries. The first respondent initiated action under the Workman's Compensation Act, 1923 (in short the "1923 Act"). The Commissioner for Workman's Compensation awarded compensation and interest to the first respondent to be paid by the appellant- insurance company. It is against this order that an appeal was preferred by the insurance company to the High Court u/s 30(1) of the 1923 Act, which was dismissed by the High Court. On an appeal being filed, the Supreme Court reversed the view taken by the High Court. The Supreme Court held that by virtue of the provisions of Section 167 of the Motor Vehicle Act, 1988 (in short the "1988 Act"), the first respondent was required to choose one of the two remedies available to him. In other words, he would be

required to elect as to whether a claim for compensation ought to be made under the 1923 Act or under the 1988 Act. In the facts of that case the first respondent continued to pursue his claim under the 1923 Act till an award was passed, and simultaneously, invoked the provisions of the 1988 Act. The Supreme Court held that the first respondent, i.e., the claimant was not entitled to do so, and thus, reversed the view taken by the High court in that regard.

14.5 As is evident the facts obtaining in the instant case are quite different. It is not as if, the respondents have instituted the suit proceedings. The respondents are defendants in the suits, and it is only, in the course of advancing their defence that they have challenged the patents in issue, in accordance with, the right conferred on them, u/s 64 of the Patents Act. The other distinguishing factor is that, there is no provision under the Patents Act similar to Section 167 of the 1988 Act.

14.6 Interestingly, both judgments, that is, A.P. State Financial Corporation (Supra) and National Insurance (supra) have been noticed in Transcore (supra) in paragraphs 84 and 85 at pages 171-172 and thereafter, distinguished.

14.7 As regards the F. Hoffmann-La Roche vs Dr. Reddy's (supra) order one need only say that a bare perusal would show that it was an order ad-invitem.

15. Therefore, for the reasons articulated by us above, we are of the definitive view that the relief sought for in the appeal ought not to be granted. Accordingly, the appeal is dismissed. We had asked the parties to file their actual bill of cost in the matter. Total costs incurred by the respondent nos.1 to 3 on fee of Solicitors and senior counsels is Rs.48,37,000/-. In the given facts and circumstances, we award to respondent no.3, a cost of Rs.5 Lacs to be shared equally with respondent nos.1 and 2 in the event costs are incurred from their personal account.