

* IN THE HIGH COURT OF DELHI AT NEW DELHI

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Judgment Reserved on: 02.05.2025

Judgment pronounced on: 04.07.2025

+ CS(COMM) 361/2023 and CC(COMM) 21/2023, I.A. 10606/2023 & I.A. 14719/2023

CONQUEROR INNOVATIONS

PRIVATE LIMITED & ANR. Plaintiffs

Through: Ms. Swati Sukumar, Senior Advocate
with Mr. Siddharth Sharma, Mr. Nikhil
Sharma, Mr. Daves Vashishtha & Mr.
Rishub Agarwal, Advocates

Versus

XIAOMI TECHNOLOGY

INDIA PRIVATE LIMITED..... Defendant

Through: Mr. L. Badrinarayanan, Mr. Prashant
Phillips, Mr. Ankur Garg, Ms. Vindhya S.
Mani and Mr. Bhuvan Malhotra,
Advocates.

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

JUDGMENT

AMIT BANSAL, J.

I.A. 10606/2024 and I.A.14719/2023 (under Order XXXIX Rule 1 and 2 of the CPC)

1. By way of the present judgment, I shall decide the above-captioned applications filed on behalf of the plaintiffs under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 [hereinafter the 'CPC'].
2. The present suit has been filed seeking relief of permanent injunction restraining the defendant from infringing the plaintiffs' registered patent no. 244963, titled as '*A Communication Device Finder System*' [hereinafter the 'suit patent'] along with other ancillary reliefs.
3. On 29th May 2023, this Court issued summons in the suit and notice in the interim injunction application (I.A. 10606/2024). Further parties were referred for mediation before the Delhi High Court Mediation and Conciliation Centre. However, the mediation proceedings were not successful.
4. On 7th August 2023, the plaintiffs filed I.A. 14719/2023 under Order XXXIX Rules 1 and 2 CPC, seeking relief of interim injunction and a direction for deposit of royalties, in light of proceedings initiated against the defendant by the Enforcement Directorate.
5. Notice in I.A.14719/2023 was issued by the predecessor bench on 8th August 2024.
6. Reply to the interim injunction application (I.A. 10606/2024) and written statement in the suit were filed on behalf of the defendant on 12th August 2023 and 14th August 2023, respectively. A counter-claim was also filed by the defendant seeking revocation of the suit patent on 14th August 2023. A reply to the interim injunction application (I.A.14719/2023) was also filed on 22nd August 2023.

7. Arguments on the interim injunction applications were heard on 13th January 2025, 17th February 2025, 9th April 2025, 2nd May 2025. Subsequently, written submissions have also been filed on behalf of the parties.

CASE SETUP BY THE PLAINTIFFS

8. The case set up by the plaintiffs in the plaint is as follows:

8.1. The plaintiff no.1, a duly recognised ‘start-up’ and a recognised Micro, Small and Medium Enterprises (‘MSME’) company, is the first owner of the suit patent. The plaintiff no.2 is an Indian citizen and inventor of the suit patent. The suit patent was assigned by the plaintiff no.2 in favour of the plaintiff no.1 *vide* assignment deed dated 29th April 2021.

8.2. The plaintiff no.2 started his career in 1995 and while carrying on his business of teaching mobile-related solutions to technicians, the plaintiff no.2 realized the need for developing a technology to help find lost and stolen communication devices without the support of law enforcement agencies. In August 2004, the plaintiff no.2 actively started working towards the invention.

8.3. The plaintiff no.2 analysed available prior arts on the subject and realized that the existing anti-theft technologies were ineffective upon the thief or the unauthorized user performing certain actions with the stolen communication device to prevent it from being monitored, tracked or being retrieved. The plaintiff no.2 identified certain other shortcomings in the existing anti-theft technologies.

8.4. To overcome the shortcomings in the prior art, the plaintiff no.2 developed the invention granted by the suit patent. The invention of the suit patent relates to an embedded security feature and its activation.

8.5. The suit patent was filed on 17th October 2006 and was granted on 28th December 2010. The same is still valid and subsisting. The bibliographic details of the suit patent are given below:

<i>Field</i>	<i>Information</i>
<i>Application No.</i>	2282/DEL/2006
<i>Date of Filing of application in India</i>	17/10/2006
<i>Applicant name</i>	Satyanarayana, Noothigattu Venkata
<i>Title</i>	A Communication Device Finder System
<i>Type of Application</i>	Ordinary Application
<i>Priority Date</i>	17/10/2006
<i>Date of Publication in India (under Section 11 A)</i>	17/11/2006
<i>Date of issue of First Examination Report by Indian Patent Office (IPO)</i>	28/05/2009
<i>Reply to First Examination Report by 2nd Plaintiff/Grantee</i>	26/05/2010
<i>Date of issue of Second Examination report by Indian Patent office (IPO)</i>	12/11/2010
<i>Reply to Second Examination Report by 2nd Plaintiff/ Grantee</i>	15/11/2010

<i>Date of Grant and Date of Recordal of application as patent no. 244963</i>	28/12/2010
<i>Number of granted claims</i>	13
<i>Details of pre-grant opposition, if any</i>	Unopposed
<i>Details of post-grant opposition, if any</i>	Unopposed
<i>Details of expiry of patent</i>	17/10/2026

8.6. The suit patent is listed as a Standard Essential Patent ('SEP') in the International Telecommunication Union's ('ITU') Intellectual Property Rights ('IPR') database, with corresponding licensing and declaration statements available on the official ITU website.

8.7. The suit patent was invented for commercial use, and substantial resources have been utilised in developing the same. The system was initially developed in the 'Symbian OS', now obsolete and discontinued. However, it was later developed for the Android operating system ('Android OS').

8.8. The suit patent sold approximately 15,000 one-year subscriptions through online sales between April 2015 and March 2019, primarily via the Google Play Store in collaboration with Megasoft Ltd, Kochartech, and Zealeers Technologies Pvt. Ltd., and over 3,000 subscriptions were sold through offline/direct sales between April 2017 and February 2020 in partnership with Virtumobile Technologies Pvt. Ltd.

8.9. In January 2023, the plaintiffs got to know that the defendant is manufacturing, offering for sale, importing and selling online and offline mobile devices, tablets, etc., operating on Android OS. The said devices had the ‘*anti-theft kill switch tool*’ embedded in them, which allowed a user to download and install the anti-theft application/ software modules. The details of the said devices are given in paragraph 29 of the plaint.

8.10. Aggrieved by the unauthorized use of its patented technology, the plaintiff no.1, issued a legal notice dated 17th January, 2023 and informed the defendant about its statutory rights in the subject patent, its SEP status, and the infringement resulting from the defendant’s manufacture, sale, and import of listed products without consent. The plaintiff no.1 also offered to grant a non-exclusive license on FRAND terms. Upon receiving no response, a follow-up notice was sent on 14th February 2023. Despite due delivery, the defendant failed to reply to the said notices.

8.11. Being aggrieved by the same, the plaintiffs filed the present suit.

CASE SETUP BY THE DEFENDANT

9. The case set up by the defendant in the written statement and the counter claim is as follows:

9.1. The defendant, Indian subsidiary of a Chinese company Xiaomi Inc., is a leading smart manufacturing company engaged in the business of consumer electronics. It manufactures smartphones and smart hardware connected through Internet of Things (‘IoT’) platforms. In 2022, Xiaomi ranked third globally in smartphone shipments, with its products available in over 100 countries. It also holds a dominant position in the Indian smartphone and tablet market.

9.2. Xiaomi markets its products under brand names such as 'Mi,' 'Xiaomi,' 'Redmi,' and 'POCO.' The defendant has established significant goodwill and a strong presence in the Indian market and has over 662 products in its portfolio. The defendant has also built an extensive distribution network comprising 667 regional partners and 16,184 retailers, including both exclusive and non-exclusive outlets, across India.

9.3. Since entering the Indian market in 2014, the defendant has launched multiple products and built a reputation for offering technologically advanced products at competitive prices, supported by reliable after-sales service. The defendant's brands have gained wide customer acceptance and serve millions of households across categories. The defendant's annual turnover and product sales for the past five years are detailed in paragraphs 12 and 13 of its written statement.

9.4. The plaintiffs have not placed on record any document whatsoever to show that the suit patent is a Standard Essential Patent and declared mandatory in India.

9.5. The plaintiffs are non-practicing entities, and the suit patent is not worked in India. The same is reflected in the declaration made by the plaintiffs in the Forms 27 filed before the Patents Office. The details of the same are given in paragraph 25 of the written statement.

9.6. The present suit has been filed after an inordinate delay of eight years, as the defendant's products have been in the market since 2014.

9.7. The suit patent is invalid and liable to be revoked as the subject matter of the suit patent is not novel, lacks inventive step and is obvious to a person skilled in art.

SUBMISSIONS ON BEHALF OF THE PARTIES

10. At the outset, it may be noted that even though in the applications for interim injunction, the plaintiffs have claimed the suit patent to be a Standard Essential Patent and the defendant has filed a counter claim seeking revocation of suit patent in its reply, however, in their oral submissions, the parties have limited their submissions to infringement of the suit patent.

SUBMISSIONS ON BEHALF OF THE PLAINTIFFS

11. Mr. Swathi Sukumar, Senior Counsel appearing on behalf of plaintiffs has made the following submissions:

11.1. A comparison of the objectives of the suit patent and the defendant's 'Find Device' technology shows that both aim to provide a non-erasable security tool in the mobile device, accessible remotely through a website.

11.2. After accessing the defendant's website i.e., Mi Cloud, a user can locate and play sound for tracking the lost, misplaced or stolen mobile phone or erase data stored on the mobile phone, which are covered by the suit patent.

11.3. Element E-2 and Element E-3 of independent Claim 1 are accessible through the defendant's website. Element E-2 outlines two alternative methods for implementing a non-erasable security tool either by storing the security tool's data in flash memory with an auto-reinstall feature that reinstalls when an unauthorised user attempts to delete it, or by embedding the data in the device's

ROM. The defendant provides the 'Find Device' in the ROM of their devices, which is equivalent to Element 2.

11.4. The defendant misrepresents Element E3 of Claim 1 by equating it to a snooping function, relying on one paragraph of the specification referring to 'auto-answer mode' with 'silent mode' for covert call monitoring. Element E3 only refers to 'auto-answer mode', other terms cited by the defendant, such as silent mode, incoming calls, or conversations, do not appear in Claim 1. E3 pertains to remote activation *via* a website for autonomous operations. None of the Claims 1 to 13 refers to any silent mode for any call being placed to the mobile device.

11.5. The defendant's 'Find Device' technology infringes the dependent Claims of the suit patent. Claims 2 and 9 relate to location tracking, Claim 4 to playing sound, and Claim 5 to deleting phonebook data, all of which are present in the defendant's devices.

11.6. The defendant has admitted that the 'Find Device' feature in their phones is provided in a pre-installed manner in the ROM of their devices.

11.7. The defendant's claim that the plaintiffs admit that third-party apps are needed to implement the features of suit patent is incorrect. The Claim mapping illustrates direct infringement of granted claims by the defendant's devices.

11.8. The pith and marrow of the invention should be assessed, rather than a detailed, literal claim-by-claim analysis. Reliance in this regard is placed on ***Sotefin SA v. Indraprastha Cancer Society & Research Center***¹.

¹ 2022 SCC OnLine Del 516

11.9. It is a settled law that statutory rights cannot be lost by mere delay. The plaintiffs filed the present suit in May 2023 after discovering that the defendant's devices were infringing the suit patent in January 2023.

11.10. The defendant's condition is perilous as the proceedings by the Enforcement Directorate (ED) are pending against them, and there is no surety that the defendant will be able to pay the damages that may be awarded by the Court at the time of final adjudication of the suit.

SUBMISSIONS ON BEHALF OF THE DEFENDANT

12. Mr. L. Badrinarayanan, counsel appearing on behalf of the defendant has made the following submissions:

12.1. The plaintiffs' characterization of the essential elements of the suit patent is incorrect, as it overlooks the language of the Claims. Further, the essential elements as identified by the plaintiffs are not based on the detailed description of the Complete Specification of the suit patent.

12.2. Element 2 of the independent Claim 1 is directed towards restoring deleted data within the mobile device. It does not merely concern storing data in ROM but involves active reinstalling of critical security functions in case of deletion. In no manner does Element 2 relate to only providing a non-erasable security tool in the memory of a mobile device. The plaintiffs' construction of the Claims is incomplete and inaccurate, as it fails to consider the function of the security activation element.

12.3. Element 3 involves activation of an 'auto-answer mode' without visual or audible cues. The activation of the same can be done by multiple means, including *via* a website, enabling the mobile device to automatically receive

calls. This allows communication with the stolen device without alerting the thief or the unauthorised user. The construction of Element 3 as enabling silent call connection is supported by the detailed description. The purpose is to facilitate secret monitoring. Accordingly, the plaintiffs' interpretation of both Elements 2 and 3 is flawed and inconsistent with the Claim language and Complete Specification.

12.4. Neither Element 2 nor Element 3 maps to any aspect of the defendant's 'Find Device' feature. The plaintiffs have failed to provide cogent reasoning or evidence in their claim charts to establish that these elements are mapped onto the defendant's 'Find Device' feature. The plaintiffs, without providing any evidence, rely on unrelated aspects of mobile devices and summarily conclude an infringement by the defendant.

12.5. The plaintiffs have failed to show how the essential elements of suit patent are present in the defendant's device. For purposes of infringement, all essential elements of the claimed invention are to be considered. Reliance in this regard is placed on *Sotefin SA v. Indraprastha Cancer Society Center and Research and Ors*².

12.6. The intent behind defendant's 'Find Device' feature is to safeguard user data by remotely activating a lost policy setting on the device, followed by complete data erasure. The objective of the feature is to locate the device for data protection, not for continuous tracking or snooping.

² *id.*

12.7. The defendant's 'Find Device' feature does not infringe the dependent Claims of the suit patent. It is settled law that dependent Claims incorporate all limitations of the independent Claim. Since the defendant's devices do not infringe the independent Claim, reliance on the dependent Claims alone cannot establish infringement.

12.8. Non-use or non-working of the patent is a ground for refusing injunction. Since the suit patent is not worked or used, the plaintiffs are not entitled to any interim relief. Reliance in this regard is placed on *Franz Xaver Huemer v. New Yash Engineers*³.

12.9. The plaintiffs have provided no plausible explanation for the delay of more than 9 years in filing the present suit.

12.10. The balance sheets of the defendant company indicate that the defendant is a profitable company and have sufficient assets in India. The defendant has neither any intention nor any necessity to wind up its business operations in India.

ANALYSIS AND FINDINGS

13. Based on the analysis of the record and the submissions advanced on behalf of the counsel, the key question that arises for consideration in the present case is whether the defendant's 'Find Device' feature infringes upon the 'communication device finder system' covered in the suit patent.

³ 1996 SCC OnLine Del 243

14. In *Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries*⁴, the Supreme Court has observed that in infringement proceedings, the Complete Specification of the suit patent is sacrosanct and plays an important role in construing Claims of a patent. For construing the claims of the suit patent and to determine the manner in which the underlying problem that existed in the prior art is sought to be solved by the ‘inventive concept’ of the suit patent, the Court shall be required to examine the Complete Specification and Claims of the suit patent. Therefore, I begin by looking at the Complete Specification of the suit patent.

COMPLETE SPECIFICATION ALONG WITH CLAIMS

15. Firstly, a reference may be made to the section titled ‘*Prior Art*’ in the Complete Specification of the suit patent, where the patentee/plaintiff no.2 has acknowledged the existence of multiple prior arts that disclose different aspects of tracking and locating a lost/misplaced cellular mobile phone. The suit patent addresses the problem identified in the prior arts in the following manner:-

“However, *the above citations are not teaching how to locate a mobile phone which has been stolen because the thief may change SIM to that of different mobile network service provider. A clever thief may try to disable the security activation element by deleting its software or deleting or changing message center number. The present invention over comes any steps a smart thief may take to escape detection and enable location of device in all circumstances.*”

[Emphasis supplied]

16. From the extract above, it is clear that the invention claimed in the suit patent is addressing the problem in the prior art of locating and recovering a

⁴ (1979) 2 SCC 511

stolen device from a thief who might remove the SIM card or attempt to disable the security feature by deleting its software or altering the ‘message center number’.

17. In the section of the Complete Specification titled ‘**Object of the Invention**’, the objectives of the suit patent have been listed out. The same is reproduced below:

“Primary object of the present invention is to propose a communication device finder system having a non erasable security features installed in the device, which enables location of lost communication device independent of a specific mobile network service provider.

Another object of the present invention is to allow these security features to be disabled / activated only by the original owner of the device or by an authorized service center, remotely, by means of sending an SMS to the lost/stolen device. Another object of the present invention is to use one or more methods of communicating to a central server/ another device i.e. either by messaging or generating voice.

Further object of the present invention is to provide the device with a security activation element for activating and bringing into auto answer mode said communication device finder through a tele communication service provider network on being triggered by any other designated communication device or through internet from a predetermined and designated internet protocol (IP) address or on entering incorrect personal identification number (PIN) or pass word with or without changing said sim.

Further object of the present invention is to provide the device with a security activation element is designed for enabling the device to send prerecorded short messaging service (SMS) and /or multimedia messaging service (MMS) or e-mails etc. after said activation.

Further object of the present invention is to provide the device with a security activation element which is programmed for generating and playing voice messages and visual messages in the device.

*Further object of the present invention is to provide the device with **a security activation element for auto re installing the data when attempt is made to delete it or a non erasable read only memory (ROM).***

*Further object of the present invention is to provide the device with **a security activation element to find out the present location of the device.***

[Emphasis supplied]

18. From a reading of the aforesaid, the main objects of the invention can be summarized below:

- (i) To provide a communication device finder system with non-erasable security features to locate a lost device, independent of the mobile network service provider.
- (ii) To ensure that activation or disabling of security features can only be done remotely by the original owner or an authorized service center through an SMS.
- (iii) To enable communication with a central server or another device using messaging or voice generation methods.
- (iv) **To provide a security activation element capable of triggering ‘auto-answer mode’, initiated remotely via the telecom network, a designated IP address, or by entering an incorrect PIN/password, with or without a SIM change.**
- (v) To allow the device, upon activation, to send pre-recorded SMS, MMS, or emails.
- (vi) To enable the device to generate and play voice and visual messages after activation.

- (vii) **To incorporate an auto-reinstallation feature of the security activation element that restores deleted data and stores it in a non-erasable ROM.**
- (viii) To provide a feature for tracking and locating the current position of the lost or stolen device.

19. The section titled '**Description of Invention**' in the Complete Specification of the suit patent has also summarized the features of the invention. The relevant extract from the said section is given below:

“According to one of the embodiments of the invention a communication device finder system comprises;

- a transmitter-receiver for transmitting and receiving data in electronic connection with a microprocessor to process the data received or to be transmitted, and to a memory element to store the data;*
- a keyboard or touch screen and optionally a mouse, connected to a dialer element, for entering the number to be dialed or an alphanumeric short message (SMS) or a multimedia message (MMS);*
- a display panel connected to the microprocessor for displaying alphanumeric characters, graphics and optionally video and/or streaming video; a read-write element for reading and writing data from/to said memory element;*
- an embedded or discrete subscriber identity module (SIM) for enabling wireless connection with a predetermined telecommunication service provider network;*
- optionally, elements for providing visual cues on said display panel and/or generating voice cues when said devices are activated; wherein*
- said device is provided with a security activation element for activating and bringing into auto-answer mode said communication device finder through a telecommunication service provider network on being triggered by any other designated communication device or through internet from a predetermined*

and designated internet protocol (IP) address or on entering incorrect personal identification number (PIN) or password with or without changing said SIM, such that no visual or voice cues accompany such activation, said security activation element comprising flash memory with auto reinstall option set for auto reinstalling the data including the message center number when attempt is made to delete it and/or a non erasable read only memory (ROM) containing said data.”

[Emphasis supplied]

20. At this juncture, it may be useful to refer to the independent Claim 1 of the suit patent. The plaintiffs have provided a table of the break-up of the Elements (E1-3) of the independent Claim 1 (C1) of the suit patent in paragraph 17 of the plaint. For the sake of convenience, the same is set out below:

Claim Reference	Relevant Claim
C1- Preamble	<i>A communication device finder system comprising</i>
C1- Element 1 (C1- E1)	<i>a transmitter-receiver (1) for transmitting and receiving data in electronic connection with a microprocessor (2) to process the data received or to be transmitted and to a memory element to store the data; a keyboard or touch screen (3) and optionally a mouse, connected to a dialer element, for entering the number to be dialed or an alphanumeric short message (SMS) or a multimedia message (MMS); a display panel (4) connected to the microprocessor (2) for displaying alphanumeric characters, graphics and optionally video and/or streaming video; a read write element for reading and writing data from/to said memory element; an embedded or discrete subscriber identity module (SIM) for enabling wireless connection with a predetermined telecommunication service provider network; optionally, elements for providing visual</i>

	<i>cues on said display panel and/or generating voice cues when said devices is activated;</i>
C1- Element 2 (C1- E2)	<i><u>characterized in that, said device is provided with a security activation element (7) comprising a flash memory with auto re-install option set for auto re-installing data including message center number when attempt is made to delete it and/or a non-erasable read only memory (ROM) containing said data,</u></i>
C1- Element 3 (C1- E3)	<i><u>wherein the said security activation element (7) is adapted for activating and bringing the said communication device finder into auto-answer mode through a telecommunication service provider network on being triggered by any other designated communication device or through internet from a predetermined and designated internet protocol (IP) address or on entering incorrect personal identification number (PIN) or password with or without changing said SIM, such that no visual or voice cues accompany such activation.</u></i>

21. In *Guala Closures v. AGI Greenpac Ltd.*⁵, it was held that the crux of the invention is described where the expression ‘characterized’ is used in the Claim. A perusal of the aforesaid independent Claim 1 of the suit patent highlights that Elements 2 and 3, following the term ‘characterized in that’, are the novel features of the ‘communication device finder system’ claimed in the suit patent. The characteristic features of the suit patent can be described below:

- (i) A flash memory that can auto-reinstall the relevant data associated with the security activation element against an attempt to delete the

⁵ 2024 SCC OnLine Del 3510

same and/or a non-erasable read-only memory (ROM) containing such data.

- (ii) A trigger mechanism for activating the security activation element, including entering an incorrect PIN/password with or without SIM change, or triggering a signal from another phone or through a predetermined Internet Protocol (IP) address.
- (iii) A security activation element that activates and brings the phone into 'auto-answer mode' silently without visual cues and voice cues through a telecommunication service provider network.

22. As highlighted above, the above-mentioned features have also been addressed in the sections titled '*Objects of the Invention*' and '*Description of the Invention*' of the Complete Specification of the suit patent.

DEFENDANT'S DEVICES

23. Now, a reference may be made to the 'Find Device' features of the defendant's device. The defendant has filed documents evidencing the working of its 'Find Device' feature. As per the same, a user can trigger the 'Find Device' feature in the defendant's device by signing into their Xiaomi account through a web browser using another device. Thereafter, the following options are provided to the user:

- (i) play sound on the device (hereinafter the 'sound mode')
- (ii) initiate 'lost mode' (hereinafter the 'lost mode')
- (iii) erase data from the device (hereinafter the 'erase mode');

23.1. When the sound mode is activated, a user can play sound on the device at maximum volume, which cannot be controlled by an unauthorised user/ thief.

23.2. If the lost mode is activated, the phone gets locked, and a message to that effect is displayed on the defendant's device. Notably, when the defendant's device is in lost mode, the person in possession of the phone is able to receive calls, however, the defendant's device has no option of auto-answering an incoming call. These aspects are, in fact, contrary to the claimed feature of the suit patent, which requires that upon activation of 'auto-answer mode', the incoming calls on the device get auto answered without any visual or voice cues to the person in unauthorised possession.

23.3. If the erase mode is activated, a user can wipe out all personal data from the device to prevent it from being misused. The 'erase data' option in the defendant's 'Find Device' feature performs data deletion which is not present in the suit patent.

24. In the written statement filed by the defendant, it has been averred that the 'Find Device' feature in the defendant's devices becomes inoperable if an unauthorised person, which may include a thief, resets the device to its factory settings (*See: Page 356 PDF in Volume 1 of Pleadings*). Such factory resetting results in the loss of access to the defendant's device. In contrast, the 'security activation element' in the suit patent cannot be deleted or deactivated and communication with the plaintiffs' communication device cannot be lost, as the 'message center number' is either backed up using 'flash memory' capable of reinstalling the same or is stored in ROM, from where the data is non-erasable.

25. The plaintiffs have contended in their replication that a 'factory reset' can only be undertaken by an authorised person possessing the PIN/Password of the device (*See: Page 578 PDF in Volume 1 of Pleadings*). However, the aforesaid

contention overlooks the fact that once a password of the defendant's device is compromised, any unauthorised person can perform the factory reset, disabling the 'Find Device' feature entirely. This is not possible with the invention claimed in the suit patent as the reinstallation feature will come into play if any unauthorised user tries to delete the 'security activation element'.

CLAIM MAPPING

26. With the aforesaid backdrop, a reference may be made to the Claim mapping filed by the plaintiffs along with the plaint (*page 60 of Volume 3 of the documents filed by the plaintiffs*)

27. From the claim mapping filed on behalf of the plaintiffs, the plaintiffs have alleged that the essential elements of the suit patent are present in the 'Find Device' feature in the defendant's devices.

28. However, a perusal of the Claim mapping of the suit patent and the defendant's devices filed by the plaintiffs would show that, in respect of the independent Claim 1, the Claim mapping refers only to 'non-erasable anti-theft tool'. It does not make any reference whatsoever to other elements covered in independent Claim 1, i.e., putting the device in 'auto-answer mode' silently and the flash memory with the data reinstallation feature and/or ROM with non-erasable 'message center number'.

29. The term 'auto answer mode' has been defined in the description of the Complete Specification of the suit patent in the following terms:

"The "auto answer mode" is set ON along with the "silent mode" so that all incoming calls to the device are answered at the first ring without the user's knowledge. This would allow the caller (investigator or owner) to hear the conversation (with outsiders) of the person having the stolen device."

[Emphasis supplied]

30. Therefore, when a phone is put into ‘auto answer mode’, it enables an incoming call to be answered automatically in a silent manner without the unauthorised user/thief getting to know about the call. This allows the caller to listen to the conversations occurring around the stolen device without the unauthorised user’s knowledge. Notably, this feature is absent in the defendant’s devices.

31. Yet another feature absent in the defendant’s devices is the flash memory for reinstalling the data related to the ‘security activation element’ when an attempt is made to delete it or a ROM with non-erasable ‘message center number’. This feature has also been defined in the description of the Complete Specification of the suit patent. The same is set out below:

“The security activation device comprises software modules installed on the flash memory in the device by the authorized owner. The security element is made non erasable by installing the auto-re-install feature set. Yet another way to achieve this is to provide the security activation element comprising a ROM by the manufacturer at the time of manufacturing the device. This element is dormant during the normal working of the device, but will get activated once a codified SMS message is received by the communicating device. This codified SMS will be sent by the authorized owner of the communicating device from any other device or server to the device in question, once he/she realizes that his/her device has been lost/misplaced/stolen.”

[Emphasis supplied]

WHETHER ESSENTIAL FEATURES OF THE SUIT PATENT ARE COVERED IN THE DEFENDANT’S DEVICES?

32. Relying upon the ‘*Manual of Patent Office Practice and Procedure*’, (version 3.0) dated 26th November, 2019 and the ‘*Case Law of the Boards of*

Appeal of the European Patent Office' (10th Edition, 2022), in *Crystal Crop Protection Ltd. v. Safex Chemicals India Ltd.*⁶, I have held that the features covered in the independent Claim that solve the problem of the prior art are considered to be the essential features of a patent. The relevant paragraph from *Crystal Crop* (supra) is set out below:

“31. The position that emerges from a reading of the above extracted paragraphs is that the independent or principal claim of a patent must include all features essential to define the invention. The essentiality of a particular feature in the patent is also confirmed if it solves a particular problem identified in the prior art.”

[Emphasis supplied]

33. The features covered in the independent Claim 1 of the suit patent that are absent in the defendant's devices are the flash memory with the capability to reinstall relevant data and a ROM with non-erasable 'message center number' and activation of the 'auto answer mode' silently in the communication device. These features are essential for addressing the problems identified in the prior arts, which is to continue the communication with the stolen device even after the thief has changed the SIM or has attempted to disable the security activation element or has attempted to delete or change the 'message center number'. Therefore, these features qualify as essential elements of the suit patent.

34. In the suit patent, the security activation element, along with the relevant data including the 'message center number', is stored in the flash memory or ROM. The same activates 'auto answer mode' silently upon being triggered by

⁶ 2025 SCC OnLine Del 2981

specified mechanism helps the owner of the phone to locate and recover the lost or stolen phone whereas the intent behind the defendant's 'Find Device' feature is to protect the data from being misused by the unauthorised user or thief by remotely locking or erasing the data from the device. The intent of the 'Find Device' feature in the defendant's devices is not to monitor the device, as claimed in the suit patent, but to protect the data from falling in wrong hands.

35. In my *prima facie* view, the plaintiffs' Claim mapping is fundamentally flawed as it fails to identify or demonstrate the presence of all essential features of the suit patent in the defendant's devices. The defendant's devices do not offer an 'auto-answer mode' that enables incoming calls to be silently and automatically answered without the user's knowledge, as required under Element 3. Although the 'Find Device' feature in the defendant's devices is non-erasable and stored in the ROM, the defendant's devices do not contain a flash memory with the critical 'reinstall' feature and ROM with non-erasable 'message center number', which is part of Element 2. Therefore, there is a functional difference between the 'Find Device' feature of the defendant's device and the communication device finder system covered in the suit patent.

36. Both sides have placed reliance on the judgment of a Coordinate Bench of this Court in ***Sotefin SA v. Indraprastha Cancer Society and Research Center & Ors***⁷. The plaintiffs rely on the judgment to argue that the focus should be on the pith and marrow of the invention, rather than conducting a detailed, literal, element-by-element claim analysis. *Per contra*, the defendant relies on ***Sotefin***

⁷ *supra* note 1

(supra) to contend that the plaintiffs were required to demonstrate that all essential elements of the suit patent are present in the defendant's 'Find Device' feature.

37. In *Sotefin* (supra), the Court came to the conclusion that the omitted elements in the defendant's product were not essential for achieving the central purpose of the invention. This was based on the report of the independent scientific advisor appointed by the Court. In the present case, I have already concluded above that the features that are absent in the defendant's devices are essential elements of the suit patent. Therefore, the judgment in *Sotefin* (supra) would not come to the aid of the plaintiffs.

38. In view of the discussion above, the plaintiffs have failed to establish a *prima facie* case of infringement of independent Claim 1 by the defendant's devices.

INFRINGEMENT OF DEPENDENT CLAIMS

39. It is contended on behalf of the plaintiffs that the defendant's devices also infringe the other dependent Claims of the suit patent. It is a settled position of law that the independent Claims are the widest in scope and the dependent Claims limit the scope of the independent Claims. Therefore, if the defendant's devices do not infringe the independent Claim, there cannot be any infringement of the dependent Claims.

40. In this regard, a reference may be made to the judgment of the United States Court of Claims in *Teledyne McCormick Selph v. United States*⁸, wherein the Court has observed as follows:

“[24] The patent in suit issued with 10 claims and plaintiff charges defendant with infringing all 10 claims.[fn1] Moreover, claim 1, which follows, is the only independent claim:

...

...

...

[25] It, of course, has long been established that a dependent claim, such as claims 2-10 of the Allen patent, cannot be infringed unless the accused device is also covered by the independent claim, claim 1. Dresser Industries, Inc. v. United States, MANU/USFD/0283/1970 : 432 F.2d 787, 193 Ct.Cl. 140, 167 USPQ 473 (1970). Since, as will be shown hereinbelow, the evidence of record conclusively establishes that the acts of defendant do not infringe claim 1 of the patent in suit, no purpose is served by considering or reproducing dependent claims 2 through 10.”

[Emphasis supplied]

41. The aforesaid observations in *Teledyne* (supra) have been consistently followed by courts in various jurisdictions (Refer: *Wahpeton Canvas Company Inc., v. Frontier, Inc.*⁹, *Akamai Technologies Inc., v. Limelight Networks Inc.*¹⁰, *Mylan Health Pty Ltd (formerly BGP Products Pty Ltd) v. Mylan Health Pty Ltd (formerly BGP Products Pty Ltd)*¹¹)

42. The rationale of the aforesaid judgments would squarely be applicable to the present case. In the present case, since the defendant's devices do not satisfy

⁸ MANU/USFD/0071/1977

⁹ MANU/USFD/0128/1989

¹⁰ MANU/USFD/0165/2015

¹¹ MANU/AUFC/1165/2019

or infringe the independent Claim 1 of the suit patent, the plaintiffs cannot sustain an infringement claim based on the claims dependent on independent Claim 1 either.

NON-WORKING OF THE SUIT PATENT

43. Yet another aspect to be considered while adjudicating the present applications is the contention of the defendant that the plaintiffs have not worked the patent in India.

44. Even though the plaintiffs have asserted in the plaint that it has sold various subscriptions *via* the Google Play Store in respect of the suit patent, nothing has been placed on record to substantiate the same. The defendant has placed on record Forms-27 filed by the plaintiffs with the Patent Office from 8th April 2011 till 23rd September 2022, to show that the suit patent has not been worked since the grant of the patent. (*See: Forms-27 pages 234 to 249 of the Volume 1 of the documents filed by the defendant*)

45. A perusal of Forms-27 filed by the plaintiffs before the Patent Office would clearly demonstrate that the invention, which is the subject matter of the suit patent, has been worked in India only to a limited extent during the Financial Year 2019-20.

46. The Division Bench of this Court in ***Franz Xavier Huemer v. New Yash Engineers***¹² has categorically held that a registered patentee who has not used the patent in India cannot seek an interim injunction against a party. Relevant extracts in paragraphs 12 and 29 of the judgment are set out below:

¹² *supra* note 3

*“12. The Indian precedents in this behalf are clear and say that **non-user of the patent by the patentee is a ground for refusing injunction.** A learned single Judge of the Delhi High court in *N.R.D. Corporation of India v. D.C. and G.Mills Co.*, AIR 1980 Delhi 132 refused injunction on the ground of non-user by the plaintiff-patentee. To a like effect is the decision of the Calcutta High Court in *Boots Pure Drug and Co. (India) v. May & Baker Ltd.* (1948) 52 Cal WN 253 which was followed by the Madras High Court in *Manicka Thevar v. Star Plough Works.* **We are in agreement with these decisions for the more elaborate reasons we propose to the give below.***

...

...

...

*29. For the above reasons, the plaintiff who has registered patents in India in 1948 **but has not used them in India cannot, in equity, seek temporary injunction against the respondent. Points 1 and 2 are decided accordingly.**”*

[Emphasis supplied]

47. The fact that the suit patent has hardly been worked in India would also be one of the factors for refusing the grant of an interim injunction in favour of the plaintiffs.

DELAY IN FILING THE SUIT

48. The defendant contends that the present suit is barred by delay as the impugned devices have been sold in India since 2014, and the plaintiffs have approached this Court after an inordinate and unexplained delay of around nine years. It is submitted that such delay disentitles the plaintiffs from seeking interim relief. The plaintiffs, however, contend that the cause of action arose only in January 2023, when they first became aware of the defendant’s devices.

49. Notably, the suit patent was granted in favour of the plaintiffs on 28th December, 2010. It has specifically been averred in the Written statement that the defendant has been selling its devices with the impugned ‘Find Device’ feature in India since the year 2014 (*See: paragraph 11 of the Written Statement*).

There is no explanation provided by the plaintiffs as to the delay of almost nine years in filing the present suit. In Form 27 filed before the Patent Office in April 2015, the plaintiffs have acknowledged their awareness of several global smartphone manufacturers allegedly infringing the suit patent. (*See: Page no.141 of Volume 3 of documents filed plaintiffs*). Therefore, I am unable to accept the submission of the plaintiffs that they became aware of infringing devices only in January 2023. This inordinate delay in filing the present suit is yet another factor that dissuades this Court from granting an interim injunction in favour of the plaintiffs at this stage.

CONCLUSION

50. In view of the aforesaid discussion, the plaintiffs have failed to establish a *prima facie* case of infringement against the defendant. Balance of convenience is also in favour of the defendant as the defendant's products have been sold in India since 2014. Irreparable injury and undue hardship would be caused to the defendant if an interim injunction is granted in favour of the plaintiffs, restraining the defendant from selling their devices in India.

51. On the other hand, in the event the plaintiffs succeed at the time of final adjudication of the suit, the plaintiffs can be suitably compensated by way of damages. There is nothing on record to suggest that the defendant is not in a good financial condition or that the defendant would not be in a position to satisfy a decree for damages that may be passed against the defendant upon final adjudication of the suit.

52. Since the plaintiffs have failed to establish a *prima facie* case, both the applications for the grant of an interim injunction are dismissed. However, it is

directed that the defendant shall maintain complete accounts of the manufacture and sale of the impugned devices and file the statement of accounts on a half-yearly basis.

53. Needless to state that the observations made herein are only for the purpose of deciding the present applications and shall have no bearing on the final outcome of the suit and the counter claim.

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54. List the suit and counterclaim before the Joint Registrar on 12th August 2025.

JULY 4, 2025

Vivek/-

**AMIT BANSAL
(JUDGE)**

