

Infringement of a product patent must be established through product-to-claim mapping. In an SEP matter, even the indirect method requires proof that the patent maps onto the standard and that the implementer's product maps onto the same standard

The **Delhi High Court** in the case of **KK Bansal vs Koninklijke Philips Electronics NV [RFA(OS)(COMM) 17/2018] dated May 18, 2026**, has held that to establish that a patent is a Standard Essential Patent (SEP), the plaintiff must prove the existence of a standard set by an SSO and also prove, by credible evidence such as proper claim mapping, that the claims of the suit patent map onto the technical features of that standard. Essentiality certificates or reports by private evaluators, being expert evidence, do not prove essentiality unless proved in accordance with Section 45 of the Evidence Act, including disclosure of the basis of the opinion and availability of the expert for cross-examination. In the absence of such proof and in the absence of claim charts, the suit patent cannot be treated as an SEP.

The Court further held that infringement of a product patent must be established through product-to-claim mapping. In an SEP matter, even the indirect method requires proof that the patent maps onto the standard and that the implementer's product maps onto the same standard. Where no such mapping is undertaken, where the primary technical deponent does not enter the witness box, and where the alleged independent expert withholds logs and technical analysis, infringement is not proved either directly or indirectly.

Under Section 107A(b) of the Patents Act, the Court clarified that after the 2003 amendment, importation of patented products from a person duly authorised under law to produce and sell or distribute them does not amount to infringement, and it is not necessary that such person be authorised by the patentee. Therefore, once the patented chip/PCB embodying the invention had been lawfully placed in the market and purchased by the defendants from lawful sources, Philips' patent rights stood exhausted and could not be enforced against the defendants.

Thus, the High Court asserted that a plaintiff claiming relief as an SEP holder must prove that the licence terms offered were FRAND. In the absence of disclosure of comparable third-party licence agreements or other objective material, a court cannot determine that the offered royalty is FRAND. Further, where the patent claim is only to a device embodied in a chip/PCB, royalty or damages cannot be assessed on the basis of the entire end product, i.e., per DVD player. Resultantly, the Division Bench quashed and set aside the judgment dated July 12, 2018 and allowed the appeals, holding that Philips failed to prove SEP status, infringement, enforceability in light of exhaustion, or FRAND royalty and damages.

The Court first examined the nature of the suit patent and held that the claims in the suit patent were only for a "decoding device" and not for any decoding technology or method. The Bench noted that although the complete specification used broader language referring to methods, coding device, recording device, reading device, signal and record carrier, protection under Section 10(4)(c) of the Patents Act could extend only to what was claimed. On the evidence of Philips' own witness PW-2, the Court found that the invention forming

the subject matter of the suit patent resided in the chip or PCB contained in the DVD player, and not in the entire DVD player or in any general technology.

On the issue whether the suit patent was an SEP, the Court accepted that the DVD Forum was the relevant SSO and also held that the Bansals could not deny this, having acknowledged the same in their written statement. The Bench also accepted that equivalence of the Indian suit patent with US'505 and EP'254 stood admitted by the Bansals. However, it found that Philips had failed to prove essentiality because the essentiality certificates issued by Proskauer Rose LLP and Cohausz & Florack were in the nature of expert evidence, but no person from those firms entered the witness box, no affidavit from them was filed, and the certificates did not disclose the manner in which the patents were mapped to the DVD standard. The Court also emphasized that no claim charts mapping the claims of the suit patent, or even US'505/EP'254, to the technical features of the standard were produced, as required by para 95 of Intex.

On infringement, the Court held that the indirect test necessarily required mapping of the patent to the standard and of the defendant's product to the standard, and that such mapping had not been undertaken. As regards direct infringement, the Court reiterated that the classical test was product-to-claim mapping, which had not been done.

On FRAND and damages, the Court held that an SEP holder could claim injunction, royalty or damages only after establishing that it was a willing licensor offering FRAND terms and that the defendant was an unwilling licensee. It found that Philips had not produced even a single third-party licence agreement, though PW-2 admitted being in possession of such agreements. In the absence of such material, the Bench held there was no evidentiary basis to conclude that the rates offered by Philips were FRAND.

The Court also held that interim negotiations or without-prejudice offers could not form the basis of final adjudication of FRAND royalty. Further, since the suit patent was only for a device residing in a chip/PCB, royalty could not lawfully be computed on a per DVD player basis. The award of punitive damages merely because Rajesh Bansal had been an employee of Philips was also held to be unsustainable.