



IN THE HIGH COURT OF HIMACHAL PRADESH AT SHIMLA

ON THE 21st DAY OF APRIL, 2022

BEFORE

HON'BLE MR. JUSTICE AJAY MOHAN GOEL

OMPS NO. 53 AND 79 OF 2022 IN COMS No. 03 of 2022

Between:-

1) BOEHRINGER INGELHEIM
INTERNATIONAL GMBH & CO. KG, D-
55216, INGELHEIM AM RHEIN
GERMANY THROUGH ITS POWER OF
ATTORNEY HOLDER

2. BOEHRINDER INGELHEIM
(INDIA) PVT. LTD. UNIT NO. 202 AND
PART OF UNIT NO. 201, SECOND
FLOOR, GODREJ 2, PIROJSHA
NAGAR, EASTERN EXPRESS
HIGHWAY, VIKHROLI (E), MUMBAI-
400079, THROUGH ITS POWER OF
ATTORNEY HOLDER

..PLAINTIFFS/APPLICANTS

(BY M/S ASHOK AGGARWAL AND VINAY
KUTHIALA, SENIOR ADVOCATES WITH M/S
ATUL JHINGAN, SHILPA SOOD, SANJAY
KUMAR, ARPITA SAWHNEY AND PRIYANKA
SHARMA, ADVOCATES)

AND

MACLEODS PHARMACEUTICALS
LIMITED KHARUNI LODHIMAJRA
ROAD, PO LODHIMAJRA, BADDI,
TEHDA SOLAN, HIMACHAL PRADESH
174101 THROUGH ITS MANAGING
DIRECTOR.

ALSO AT

304, ATLANTA ARCADE, MAROL
CHURCH ROAD, ANDHERI (EAST)
MUMBAI 400059

THROUGH ITS MANAGING DIRECTOR.

.....DEFENDANT/RESPONDENT

(BY MR. BIPIN CHANDER NEGI, SENIOR
ADVOCATE WITH M/S JAI SAI DEEPAK,
GURUSWAMY NATRAJAN, SHRADHA KAROL,
& ANKUR VYAS, ADVOCATES FOR THE
DEFENDANT)

Reserved on : 17.03.2022/29.03.2022

Whether approved for reporting: Yes

These applications coming on for pronouncement of order this day, Hon'ble Mr. Ajay Mohan Goel, passed the following:-

O R D E R

This order shall dispose of OMP No. 53 of 2022, preferred under Order XXXIX, Rules 1 and 2 of the Code of Civil Procedure by the applicants/plaintiffs, praying for interim directions during the pendency of the suit as also OMP No. 79 of 2022, which has been filed under Order VII, Rule XI of the Code of Civil Procedure, on behalf of the applicant/defendant, praying for rejection of the plaint.

OMP No. 53 OF 2022

2. The suit of the plaintiff is for passing of a decree of restraint and permanent injunction against the defendant by its or through its directors, partners licenses, stockiest and distributors, agents etc. from infringing the patent rights of plaintiff No.1 under

Indian Patent No. 243301 by advertising, launching, making, using, offering for sale, selling, importing and/or exporting the medicinal product Linagliptin in any form whatsoever including Linagliptin API, Linagliptin formulation, “Linagliptin Tablet” and/or “Linagliptin + Metformin Hydrochloride Tablets”, or any “generic version” thereof or any product sold under the trade marks/brand names “LINAMAC” and “LINAONE”, or any other trade mark(s)/name(s), whatsoever, or any other product covered by the subject patent granted by the Controller of Patents on October 05, 2010, in favour of plaintiff No 1. In addition, the plaintiffs are also praying for a decree of damages to the tune of Rs. One Crore. According to the plaintiffs, plaintiff No. 1 is a company incorporated under the laws of Germany and plaintiff No. 2 is a company registered under the Companies Act. Plaintiff No. 1 is the owner of plethora of patents worldwide, including Indian Patent No. 243301 (hereinafter to be referred as ‘subject patent or IN 301’ for short). The subject patent was granted in favour of plaintiff No. 1 on 05.10.2010 as per Section 43 of the Indian Patents Act 1970, under ‘IN 301’ for pharmaceuticals product titled “8 (3-AMINOPIPERIDIN-1YL)-XANTHINE COMPOUNDS”, for a term of 20 years from the date of filing.

3. When this application was listed before this Court on 25.02.2022, ad-interim protection was granted by the Court to the

applicants/plaintiffs and relevant portion of the said order is being quoted herein below:-

“Till the next date of hearing, respondent/defendant is restrained from manufacturing and selling medicinal product ‘Linagliptin’ in any form, as for the grant of ad-interim injunction, this Court is satisfied that the applicants have a prima-facie case. This order is being passed taking into consideration the un-rebutted facts, at least till this stage, that there exists an Indian Patent 243301 in favour of the applicants, which is to expire on 18th August, 2023 and the respondent, without any valid patent or authorization/licence from the applicant, has started manufacturing and selling the infringing product under the brand name of LINAMAC and LINAONE.

It is clarified that this order shall remain in force till next date of hearing only, subject to any further order that may be passed by the Court in this regard.”

4. The arguments on behalf of the plaintiffs were advanced by Mr. Ashok Aggarwal, learned Senior Counsel and Mr. Vinay Kuthiala, learned Senior Counsel. Arguments on behalf of the defendants were advanced by Mr. Bipin Chander Negi, learned Senior Counsel and M/s Jai Sai Deepak and Guru Natarajan, learned Counsel.

5. Learned Senior Counsel appearing for the plaintiffs argued that for the purpose of grant of interim relief, three primary ingredients, i.e. *prima facie* case, balance of convenience and irreparable loss are all in favour of the plaintiffs. In addition, they argued that as the defendant has not been able to lay any credible challenge to the 'subject patent', therefore, this application be disposed of by confirming ad-interim order dated 25.02.2022.

6. On the other hand, learned Counsel for the defendant have submitted that as the defendant has laid a credible challenge to the 'subject patent' therefore, ad-interim injunction granted on 25.02.2022 be vacated and the application filed under Order XXXIX, Rules 1 and 2 of the Code of Civil Procedure be dismissed.

7. To substantiate their contention that all ingredients exist in favour of the plaintiffs for the continuation of interim order, learned Senior Counsel argued that in the present case, the patent in issue, i.e. Indian Patent No. 243301 (hereinafter to be referred as 'IN 301') was granted to the applicants on 5th October, 2010, and as its international date of filing was 18th August, 2003, the term of the patent being 20 years, the patent is still alive and is to expire on 18th October, 2023. As per learned Counsel, the patent was granted to the applicants after following the procedure prescribed in the Patents Act, 1970, as amended from time to time and the Rules framed there under. There was no opposition to the

grant of patent at any stage after the application was filed for the grant of the patent and after the patent was granted on 5th October, 2010, by anyone, including the respondents in terms of statutory provisions of the Patent Act, 1970. The patent in issue is a commercially successful patent. The medicinal product “Linagliptin Tablet and Lenagliptin + Metformin Hydrochloride Tablets” covered by the said patent were introduced and launched in the Indian market under the brand name “Trajenta/Trajenta Duo” on 27.05.2012 and 21.06.2014, respectively. Learned Senior Counsel stressed that no party, including the respondent has filed any pre-grant opposition, post-grant opposition or a revocation petition against the subject patent especially against the quality and strength of the subject patent. They have further submitted that the respondent-Company is an Indian Pharmaceutical Company and it had recently come within the knowledge of the applicants that the respondent-Company had made preparation to launch and thereafter had launched infringing product Linagliptin 5 mg tablets under the brand names “LINAMAC” and “LINAONE”. As per learned Senior Counsel, the product Linagliptin 5 mg tablets now being offered for sale and being sold under the brand names “LINAMAC” and “LINAONE” by the respondent-Company, are covered by the subject patent and manufacturing of the said product by the respondent-Company is an act of infringement of

the exclusive rights of the subject patent of applicant No. 1. They further argued that as admittedly the respondent-Company neither has any patent nor it has got a licence to manufacture and sell the products covered by the subject patent from the applicant nor the respondents have applied for or have been granted compulsory licence to manufacture and sell the product, therefore, during the pendency of the suit, the respondent be restrained from manufacturing and selling the product in issue which are covered by the subject patent. According to the plaintiffs, the following points demonstrate that there exists a good case in their favour for confirmation of the interim order:

- (a) 'subject patent' is old and well established;*
- (b) 'subject patent' is commercially highly successful and extensively useful;*
- (c) admittedly, no party, including the defendant, raised any pre-grant opposition, post-grant opposition, including against the quality and strength of the 'subject patent';*
- (d) the patent was granted in favour of the plaintiffs after following the substantive provisions of the The Patents Act, 1970;*

- (e) *the patent has had a successful commercial run in India for more than eleven years, without any challenge, including that from the defendant;*
- (f) *the Central Government has not filed any revocation for the 'subject patent' in terms of Section 64 of the Patents Act, 1970;*
- (g) *the Central Government has not made any declaration for revocation of the 'subject patent' in public interest in terms of Section 67 of the Patents Act;*
- (h) *none, including the defendant, applied under Section 84 of the Patents Act for grant of compulsory licence of the 'subject patent' on the grounds as mentioned therein;*
- (i) *no challenge was ever put forth by the defendants to the 'subject patent' except immediately before the commercial launch of its infringing product in the month of February 2022, when a revocation petition was filed by the defendants under Section 64 of the Patents Act.*

8. It was argued that above facts clearly and categorically demonstrate that there exists a *prima facie* case in favour of the plaintiffs and balance of convenience is also in their favour and in this backdrop, in case, ad-interim order is not confirmed and the

defendant is permitted to infringe the 'subject patent' of the plaintiffs, then, the plaintiffs shall suffer irreparable loss, which cannot be compensated monetarily as all the hard work that has gone into the invention of the product in issue and getting it patented would be washed away. Learned Senior Counsel further stressed that admittedly the defendant neither has any patent in its name nor did it lay any challenge at the time when the plaintiffs had applied for the 'subject patent' or even after the patent was granted in favour of the plaintiffs. They also submitted that the filing of revocation petition by the defendant, in close proximity with the launch of the infringing product was nothing but an afterthought to hold out that in lieu of its having filed a revocation petition, it has laid a credible challenge to the 'subject patent'.

9. Opposing the application, learned Counsel for the respondent Sh. Bipin Chander Negi, Senior Advocate and M/s Sai Deepak and Guru Natrajan, Advocates, argued that the applicants, in fact, have not approached the Court with clean hands as fact of the matter is that the applicants had obtained two patents, i.e. Patent No. 227719 (hereinafter to be referred as 'IN 719') for the "Markush" formula being the 'genus' patent, which expired on 21st February, 2022 and subject patent IN 301, which is a 'species' patent and both patents were granted for the same invention as it is nowhere disclosed either in the plaint or in the application as to

what was the inventive step capable of industrial application, which distinguished patent IN301 from IN719. The Court was apprised by them that the respondent had filed a revocation petition against the patent in issue under Section 64 of the Patents Act, 1970 in the High Court of Delhi, in which, notices to the present applicants have been issued. It was argued that respondent has rightly challenged the 'species' after the 'genius' has expired and as the plaint is conspicuously silent with regard to the difference between the 'genius' patent and the 'species' patent, therefore, the applicants are not entitled for any relief. It was argued that as a credible challenge stood made to the patent in issue by the respondent, therefore, no interim relief be granted. As per them, it is settled law that mere grant of patent does not lend a presumption of validity to the patent. The scheme of the Patents Act is to provide multi-layer challenges, which are available to a non-patentee to challenge and question the validity of a patent at any time and such validity has to be tested on the anvil of the provisions of the The Patents Act, 1970. It was argued that the provisions of Section 13(4) of the The Patents Act expressly set out the absence of any presumption of validity due to mere grant. It was also argued that in the case of pharmaceutical patents, which have been recognized as a specific species of patent infringement litigation, the overwhelming factor is that of public

interest-namely the need to provide for affordable and accessible healthcare products. It was argued that in addition to the settled principles of *prima facie* case, balance of convenience and irreparable loss, the plaintiffs also have to satisfy that there is no **credible challenge** to the 'subject patent' which in the present case, the plaintiffs have not been able to demonstrate and in this view of the matter, the ad-interim injunction granted in favour of the plaintiffs was liable to be vacated and the prayer of the plaintiffs for interim injunction is liable to be dismissed. Learned Counsel have submitted that the genus patent 'IN719' has expired on 21st February, 2022 whereas the specie patent 'IN301' is to expire on 18th August, 2023. According to them, it is apparent and evident from the record that the plaintiffs themselves have held out on more than one occasion that the genus patent and specie patent are the same. Learned Counsel drew the attention of the Court to the order passed by Hon'ble High Court of Delhi in Civil Suit (Comm.) No. 239 of 2019 with I.A. No. 6797 and I.A. No. 6798/2019, titled as Boehringer Ingelheim Phara GMBH & Co. KG vs. Vee Excel Drugs and Pharmaceuticals Private Ltd. & Ors., dated 10.05.2019 and by referring to para 10 thereof, they have argued that the plaintiffs cannot wriggle out from the admissions which have been made by them, as are borne out from the said order that the plaintiffs themselves have claimed to be owners of

two patents, the first patent being IN719 and the second patent being IN301 and it stood submitted on behalf of the plaintiffs before the said Court that these two patents both cover Linagliptin and all its forms. It was argued that in the entire plaint, the plaintiffs have very conveniently concealed this fact that except a vague and short reference somewhere in between has been made that the plaintiffs were also holding patent 'IN719', which as per defendants in fact was for the same product for which subsequently the plaintiffs obtained patent 'IN301'. The difference between has not at all been explained by the plaintiffs in the plaint. Learned Counsel for the defendant also submitted that the defendant is not infringing the suit patent as the product of the defendant is based on the teaching of 'IN719' after the expiry of the term of said patent and therefore, its act does not amount to an act of infringement. They have also argued that the contents of the cease and desist notice which was issued by the plaintiffs to the defendant, which stand placed on record as Annexure-G in the list of documents filed by the defendant dated 01.11.2021 and another communication in continuation thereof dated 16th December, 2021, demonstrate that the plaintiffs had referred the patents IN719 and Patent IN301 in the same breath and in the same context while calling upon the defendant to cease and desist from launching their product on the ground that the same

amounted to infringement of intellectual property rights of the plaintiffs which stood conferred upon them under IN719 and IN301. This according to the defendant, was a clear cut admission on the behalf of the plaintiffs that IN719 was the genus and IN301 was specie as term of genus had expired, the plaintiffs in fact were not having any case at all for grant of interim prayer being sought by them. Further as per them, in terms of the provisions of Section 146(2) of the Patents Act, 1970, read with Rule 131 of the Patents Rules 2003, the plaintiffs have filled in Form 27, perusal whereof would demonstrate that the same product was being reflected in the said statutory form under both genus patent and specie patent. Thus, they prayed that the ad-interim order be not confirmed and same be vacated in the larger public interest.

10. In rejoinder to the arguments so advanced by learned Counsel for the respondent, learned Senior Counsel appearing for the applicants have submitted that the presumption of validity, though rebuttable, which is attached to a patent, which has been running successfully commercially without any challenge, cannot be belittled down by a company like the respondent who blatantly infringe the patent of the applicants on the strength of the respondents simply having filed a revocation petition, that too, in close proximity to the launching of the infringed product. It was further argued that the contents of cease and desist notice as also

the order passed by the Hon'ble High Court of Delhi were being misconstrued and misread by the defendant and further the contents of Form 27 at this particular stage cannot be made a ground to non-suit the plaintiffs from the grant of interim relief for the reason that what is contained in the said Form is explainable and shall be explained in due course of the trial. Therefore, they prayed that ad-interim order be confirmed in favour of the applicants/plaintiffs.

11. I have heard learned Counsel for the parties and have also gone through the relevant pleadings and documents appended therewith.

12. In **M/s Bishwanath Prasad Radhey Shyam** vs. **Hindustan Metal Industries**, (1979) 2 Supreme Court Cases 511, Hon'ble Supreme Court has been pleased to hold that grant and sealing of the patent, or the decision rendered by the Controller in the case of opposition, does not guarantee the validity of the patent, which can be challenged before the High Court on various grounds in revocation or infringement proceedings. Hon'ble Supreme Court further held that the 'validity of a patent is not guaranteed by the grant', was also expressly provided in Section 13(4) of the Patents Act, 1970.

13. Hon'ble Supreme Court of India in **Dalpat Kumar and Another** vs. **Prahlad Singh and Others**, (1992) 1 Supreme Court

Cases 719 has held that it is settled law that the grant of injunction is a discretionary relief and exercise thereof is subject to the Court satisfying that (1) there is a serious disputed questions to be tried in the suit and that an act, on the facts before the Court, there is probability of his being entitled to the relief asked for by the plaintiff/defendant; (2) the Court's interference is necessary to protect the party from the species of injury. In other words, irreparable injury or damage would ensue before the legal right would be established at trial' and (3) that the comparative hardship or mischief or inconvenience which is likely to occur from withholding the injunction will be greater than that would be likely to arise from granting it. In para-5 of the judgment, Hon'ble Apex Court has been further pleased to hold as under:-

"5. Therefore, the burden is on the plaintiff by evidence aliunde by affidavit or otherwise that there is "a prima facie case" in his favour which needs adjudication at the trial. The existence of the prima facie right and infraction of the enjoyment of his property or the right is a condition for the grant of temporary injunction. Prima facie case is not to be confused with prima facie title which has to be established, on evidence at the trial. Only prima facie case is a substantial question raised, bona

fide, which needs investigation and a decision on merits. Satisfaction that there is a prima facie case by itself is not sufficient to grant injunction. The Court further has to satisfy that non-interference by the Court would result in "irreparable injury" to the party seeking relief and that there is no other remedy available to the party except one to grant injunction and he needs protection from the consequences of apprehended injury or dispossession. Irreparable injury, however, does not mean that there must be no physical possibility of repairing the injury, but means only that the injury must be a material one, namely one that cannot be adequately compensated by way of damages. The third condition also is that "the balance of convenience" must be in favour of granting injunction. The Court while granting or refusing to grant injunction should exercise sound judicial discretion to find the amount of substantial mischief or injury which is likely to be caused to the parties, if the injunction is refused and compare it with that it is likely to be caused to the other side if the injunction is granted. If on weighing competing

possibilities or probabilities of likelihood of injury and if the Court considers that pending the suit, the subject-matter should be maintained in status quo, an injunction would be issued. Thus the Court has to exercise its sound judicial discretion in granting or refusing the relief of ad interim injunction pending the suit.”

14. In **Ten XC Wireless Inc and Others vs. Mobi Antenna Technologies (Shenzhen) Co. Ltd.**, 2011 SCC Online Delhi 4648, Hon’ble Delhi High Court has summarized the principles in general being followed for the grant of interim injunction in patent matters and the same are as under:-

- (i) *The registration of a patent per se does not entitle the plaintiffs to an injunction. The certificate does not establish a conclusive right.*
- (ii) *There is no presumption of validity of a patent, which is evident from the reading of Section 13(4) as well as Sections 64 and 107 of the Patents Act.*
- (iii) *The claimed invention has to be tested and tried in the laboratory of Courts.*
- (iv) *The Courts lean against monopolies. The purpose of the legal regime in the area is to ensure that the inventions should benefit the public at large.*
- (v) *The plaintiff is not entitled to an injunction if the defendant raises a credible challenge to the patent. Credible challenge means a serious question to be tried. The defendant need not make out a case of actual invalidity. Vulnerability is the issue at the preliminary injunction stage whereas the validity is*

the issue at trial. The showing of a substantial question as to invalidity thus requires less proof than the clear and convincing showing necessary to establish invalidity itself. ◇

(vi) At this stage, the Court is not expected to examine the challenge in detail and arrive at a definite finding on the question of validity of the patent. That will have to await at the time of trial. However, the Court has to be satisfied that a substantial, tenable and credible challenge has been made.

(vii) The plaintiff is not entitled to an injunction, if the patent is recent, its validity has not been established and there is a serious controversy about the validity of the patent.

15. In the case in hand, the patent in issue, i.e. 'IN301' was granted in favour of the plaintiffs in India on 5th October, 2010 and the terms of the patent is 20 years, which is to expire on 5th October, 2023 as the international filing date of the patent application in the present case is August 18, 2003.

16. On the other hand, admittedly, the defendant does not has any patent qua the infringing product and no challenge, either to the application filed by the plaintiffs for grant of patent was laid by the defendant nor any post patent challenge was laid by it. Of course, in light of law laid down by Hon'ble Supreme Court in M/s Bishwanath Prasad Radhey Shyam (supra), grant of patent does not guarantee the validity of a patent, which can be challenged before the High Court on various grounds in revocation or infringement proceedings, but the factum of a patent being there

in favour of the plaintiffs and the factum of no pre or post grant challenge to the same by anyone, including the defendant, except recently by way of a revocation petition which was filed in close proximity to the launch of the infringing product, does create a *prima facie* case and balance of convenience in favour of the plaintiffs. The Court is observing so for the reason that as per the plaintiffs, since the patent was granted on 5th October, 2010, the same has had a successful commercial run till date which continues and there is no serious dispute qua the same. The patent is an old patent and it has not been granted recently to the plaintiffs. Therefore, these facts do create *prima facie* case and balance of convenience in favour of the plaintiffs vis-a-vis the defendant, who admittedly does not have any patent qua the infringing product.

17. In the light of what has been discussed hereinabove, if an infringer is not restrained from infringing the patent of patent holder, then, but of course, the patent holder will suffer from irreparable loss and it cannot be said that the infringer stands on the same pedestal on which the patent holder is. Of course, the patent of the plaintiffs is vulnerable. It is open to challenge and now it has also been challenged by the defendant by way of a revocation petition. But mere filing of revocation proceedings cannot be treated to be a “credible challenge” to the old and

successful patent of the plaintiffs. As far as the element of public interest is concerned, it may be observed that in the present case, the Central Government has not invoked the provisions of Section 66 of the Patents Act and after following the procedure referred to therein, made a declaration in the Official Gazette to the effect that the patent of the plaintiffs stand revoked in public interest. Not only this, the defendant has not approached the competent authority under Section 84 of the Patents Act after the expiry of three years from the grant of the patent for grant of compulsory licence of patent on the conditions enumerated therein.

18. At this stage, it is relevant to refer to Section 48 of the Patents Act as it stood prior to the amendment and also post amendment, which amendment was carried out in the said section w.e.f. 20.05.2003.

19. Section 48 of the Patents Act, which deals with rights of the patentees, before amendment provided as under:

Section 48. Rights of patentees

- (1) Subject to the other provisions contained in this Act, a patent granted before the commencement of this Act, shall confer on the patentee the exclusive right by himself, his agents or licensees to make, use, exercise, sell or distribute the invention in India.
- 2) Subject to the other provisions contained in this Act and the conditions specified in Section 47, a patent granted after the commencement this Act shall confer upon the patentee---

- (a) where the patent is for an article or substance, the exclusive right by himself, his agents or licensees to make, use, exercise, sell or distribute such article or substance in India;
- (b) where a patent is for a method or process of manufacturing an article or substance, the exclusive right by himself, his agents or licensees to use or exercise the method or process in India."

20. After amendment, said Section now reads as under:-

Section 48: Rights of patentees.

Subject to the other provisions contained in this Act and the conditions specified in Section 47, a patent granted under this Act shall confer upon the patentee--

- (a) where the subject-matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;
- (b) where the subject-matter of the patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India:

21. It is evident that though subject to other provisions contained in the Patents Act, including Section 47 thereof, a patent granted under the Patents Act does confers upon the patentee, where the subject matter of the patent is a product, the exclusive right to prevent a third party, who do not have his

consent, from the act of making, using, offering for sale etc. of that product in India. Thus, a statutory right, which has been conferred upon the patentee, clothes the patentee with an umbrella of safety[>] qua the infringement of its patent by a third party.

22. Further, it may be observed that the premise of the defendant that there is “credible challenge” to the subject patent of the plaintiffs is that the subject matter of the subject patent ‘IN 301’ granted to the plaintiffs was covered by subject matter of another Indian Patent, i.e. Patent Number ‘IN 719’ against granted to the plaintiffs which had expired in February, 2022. According to the defendant, IN301 is nothing but Evergreening of IN719. This Court is of the considered view that at this stage when the Court has to primarily see as to whether the plaintiffs have made out a case for the grant of interim relief as prayed for, this Court cannot make any observation as to whether IN301 is Evergreening of IN719 because this is an issue which shall be decided by the Court in the light of the defence that may be taken by the defendant coupled with the evidence which may be led by the parties in support of their respective contentions. The effect of holding out of the plaintiffs as referred to by the defendants before various Courts or in the cease and desist notice etc. as well as in Form 27 can also be gone into at that stage only. Therefore, on this count, it cannot be said that at this stage, the



defendant has rendered the patent of the plaintiffs to be vulnerable so as to lay a credible challenge to it for the purpose of declining interim protection. These observations have been made by this Court only to demonstrate its *prima facie* satisfaction on the point urged and this Court is refraining from making any further observation on merit in view of observations made by Hon'ble Supreme Court of India in Special Leave to Appeal C No. 18892/2017, titled as **Az Tech (India) & Anr. Vs. Intex Technologies (India) Ltd. & Anr.**, on 16.08.2017, in which Hon'ble Apex Court has been pleased to observe as under:-

“3. In the present Special Leave Petition (No.18892 of 2017) on 31st July, 2017, this Court passed the following order: Having read the order of the High Court of Delhi dated 10th March, 2017 passed in FAO(OS) No.1/2017 we find that it is virtually a decision on merits of the suit. We wonder if the High Court has thought it proper to write such an exhaustive judgment only because of acceptance of the fact that the interim orders in Intellectual Property Rights (IPR) matters in the Delhi High Court would govern the parties for a long duration of time and disposal of the main suit is a far cry.

This is a disturbing trend which we need to address in the first instance before delving into the respective rights of the parties raised in the present case. We, therefore, direct the

Registrar General of the Delhi High Court to report to the Court about the total number of pending IPR suits, divided into different categories, in the Delhi High Court; stage of each suit; and also the period for which injunction/interim orders held/holding the field in each of the such suits.

The Registrar General of the Delhi High Court will also indicate to the Court what, according to the High Court, would be a reasonable way of ensuring the speedy disposal of the suits involving intellectual property rights which are presently pending.

We will expect the Registrar General of the Delhi High Court to report to the Court within two weeks from today, latest by 14th August, 2017.”

23. Accordingly, in light of the observations made hereinabove, the ad-interim protection granted to the plaintiffs, vide order dated 25.02.2022, is made absolute during the pendency of the civil suit, of course, subject to any further order(s) which may be passed by this Court. No order as to costs. The application stands disposed of in above terms.

OMP No. 79 of 2022

24. This is an application filed under Order VII, Rules 11 read with Section 151 of the Code of Civil Procedure, on behalf of applicant/defendant, *inter alia*, on the grounds that the suit is

barred in law in terms of the provisions of Section 53 (4) of the Patents Act, 1970 and the suit is improperly filed in as much as the person signing as 'constituted attorney' of the plaintiffs is barred by law from representing the plaintiffs.

25. Learned counsel for the applicant/ defendant argued that Section 53(4) of the Patents Act, 1970 (hereinafter referred to as the '1970 Act') provides that notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection. They submitted that in the case in hand, the Indian Patent 'IN' 301 is an Evergreening of another Indian Patent 'IN' 719, both of which patents were registered in the name of the non-applicants/plaintiffs. 'IN' 719 being the genus patents, it specifically covered the commercial embodiments being marketed by patent 'IN' 301, which is the subject matter of the suit in hand. As per the applicant, in view of the specific provisions of Section 53 (4) of the 1970 Act and in view of the admissions made on behalf of the plaintiffs, as was evident from the holding out made by them before various Courts as also from the notices of cease and desist which were issued by the plaintiffs to the defendant, the suit in hand is not maintainable, being hit by the

provisions of Section 53 (4) of the 1970 Act, which renders the suit to be rejected in terms of the provisions of Order VII, Rule 11 (d) of the Civil Procedure Code as the plaint is evidently barred by law.

26. With regard to the ground of the suit being improperly filed, learned counsel argued that the present being a commercial suit, the pleadings are signed and verified by a person who is not entitled in law to do so, which also calls for rejection of the plaint at the threshold under Order VII, Rule 11 being barred by law. They argued that the tactic of litigant compelling their counsels to sign and verify the pleadings stands bewailed by the Hon'ble Apex Court as well as other constitutional Courts across the country and the plaint in hand having been verified by one Shri Sujit Kumar, who claims to be the constituted attorney of plaintiff No.2, renders the suit liable to be rejected under Order VII, Rule 11 of the Civil Procedure Code.

27. On the other hand, learned Senior Counsel for the non-applicants/plaintiffs have argued that the application filed under Order VII, Rule 11 of the Civil Procedure Code is without any merit for the reason that by no stretch of imagination it can be said that the plaint in hand is liable to be rejected in terms of the provisions of Order VII, Rule 11 of the Civil Procedure Code. It has been submitted on their behalf that the provisions of Section

53(4) of the 1970 Act are being read totally out of context by the applicant/defendant, as said provision nowhere expressly or impliedly bars the filing of the suit and further the suit has been filed by the authorized signatory who is the constituted attorney of the plaintiffs and the ground as taken by the applicant/defendant of the suit being improperly filed having been signed by the constituted attorney being barred by law is also not sustainable. Learned Senior Counsel have relied upon the judgment of Hon'ble Division Bench of High Court of Delhi in **Columbia Pictures Industries, Inc. and others Versus Siti Cable Network Ltd., 2001 (60) DRJ 11 (DB)**, in which the Hon'ble High Court has held that there is no legal bar to an advocate being appointed as a constituted attorney by a party for the purposes of the case, however, if said constituted attorney was himself/herself to act and plead as an advocate, then his/her conduct could be said to be questionable.

28. I have heard learned counsel for the parties and have gone through the relevant pleadings.

29. The suit filed by the plaintiffs herein is to the effect that plaintiff No.1 is the owner of number of worldwide Patents, including Indian Patent No.243301 (hereinafter referred to as 'the subject patent') and on the strength of the said patent, pharmaceutical products as mentioned in the plaint were being

manufactured by it, which patent was to expire on 18.08.2023. Said patent is being infringed by the defendant by selling the products referred to in the plaint which products stood manufactured by the defendant without any implied or express consent of the plaintiffs.

30. Order VII, Rule 11 of the Civil Procedure Code, *inter alia*, envisages that the plaint shall be rejected where it does not discloses a cause of action or where the suit appears from the statement in the plaint to be barred by any law.

31. In the present case, as it is not the case of the applicant that the plaint is liable to be rejected as it does not discloses a cause of action, this Court is not going to dwell on the said aspect of the matter. The contention of the applicant is that the plaint is liable to be rejected as the suit appears from the statement in the plaint to be barred by law. According to the applicant, the suit is barred by law in terms of the provisions of Section 53 (4) of the 1970 Act. Section 53 of the 1970 Act provides as under:-

“53. Term of patent- [(1) Subject to the provisions of this Act, the term of every patent granted, after the commencement of the Patents (Amendment) Act, 2002, and the term of every patent which has not expired and has not ceased to have effect, on the date of such

commencement, under this Act, shall be twenty years from the date of filing of the application for the patent.]

[Explanation- For the purpose of this sub-section, the term of patent in case of International applications filed under the Patent Cooperation Treaty designating India, shall be twenty years from the international filing date accorded under the Patent Cooperation Treaty.]

(2) A patent shall cease to have effect notwithstanding anything therein or in this Act on the expiration of the period prescribed for the payment of any renewal fee, if that fee is not paid within the prescribed period [or within such extended period as may be prescribed].

*3[***]*

(4) Notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection.]

32. Having perused the contents of Section 53 of the 1970 Act in general and sub-Section (4) thereof in particular, this Court has no hesitation in holding that the contention of the applicant that the suit in hand is liable to be rejected being barred by law in terms of Section 53 (4) of the 1970 Act is totally misconceived. Sub-section (4) of Section 53 of the 1970 Act only provides that notwithstanding anything contained in any law for the time being in force, on cessation of the patent right, *inter alia*,

on expiry of the term of the patent, the subject matter covered by the said patent shall not be entitled to any protection. In other words, as per this particular statutory provision, the protection which is available to a patent holder during the term of patent ceases after the expiry of the term.

33. In the present case, it is no one's case that the term of the subject patent has expired. Whether or not, the plaint has to be rejected in terms of the provision of Order VII, Rule 11 (d) of the Civil Procedure Code, this has to be decided by the Court on the basis of the statement in the plaint. However, in terms of the averments contained in the application, the applicant has indirectly introduced its defence and the same, but obvious, cannot be taken into consideration by the Court at the stage of deciding an application filed under Order VII, Rule 11 (d) of the Civil Procedure Code.

34. Whether or not, the plaintiffs are entitled for the relief being prayed for can very well be contested by the defendant on the strength of the provisions of Section 53 (4) of the 1970 Act and the defendant may ultimately succeed on the strength of said statutory provisions. However, by no stretch of imagination, it can be said that in the light of the language of Section 53 (4) of the 1970 Act, the plaint in hand is liable to be rejected being barred by law. Section 53 (4) of the 1970 Act nowhere bars the

plaintiffs or a party similarly situated as the plaintiffs, on the strength of the averments as are contained in the plaint from filing the suit. The words “barred by any law’ have to be construed strictly by the Court and the same cannot be confused by a plaintiff ultimately not being entitled to the relief being prayed for by it on account of certain statutory provisions.

35. In this backdrop, this Court does not concur with the contention of the applicant/ defendant that the plaint is liable to be rejected being barred by law in terms of the provisions of Section 53 (4) of the 1970 Act.

36. Coming to the second objection which has been taken with regard to the suit not having been filed by a duly authorized person, this Court is of the considered view that whether the suit, as it has been filed, is maintainable or not is an issue which cannot be decided by this Court under the provisions of Order VII, Rule 11 (d) of the Civil Procedure Code.

37. Assuming that the suit has not been filed through a duly authorized person, then but of course, this objection has to be taken by the defendant in the written statement and an issue in this regard shall be struck by the Court, which will be subsequently adjudicated upon on merit.

38. Though, it was argued on behalf of the plaintiffs that otherwise also, the defect being pointed out by the defendant was

a curable defect, however, this Court is not making any observation on the said point for the simple reason that this Court is of the considered view that this is not the stage when any observation in this regard can be made by this Court more so in an application filed under Order VII, Rule 11(d) of the Civil Procedure Code.

Accordingly, in view of what has been discussed hereinabove, present application being devoid of any merit is dismissed.

(Ajay Mohan Goel)
Judge

April 21, 2022
(narender/rishi)