

MANU/DE/5834/2017

IN THE HIGH COURT OF DELHI

CS(OS) 3132/2014, CC 71/2015, I.A. 20105/2014 and 14072/2015

Decided On: 15.12.2017

Appellants: **Merck Sharp and Dohme Corp. and Ors.**

Vs.

Respondent: **Vinod Jadhav and Ors.**

Hon'ble Judges/Coram:

Jayant Nath, J.

Counsels:

For Appellant/Petitioner/Plaintiff: Pravin Anand, Tusha Malhotra and Udit M. Patro, Advs.

For Respondents/Defendant: Aditya Kumar, Proxy Counsel for Vinod Jadhav, Adv.

JUDGMENT

Jayant Nath, J.

I.A. 20105/2014

1. This application is filed by the plaintiffs under Order 39 Rule 1 and 2 CPC seeking an ex parte ad interim injunction against the defendants so as to restrain the defendants from infringing the registered patent in respect to SITAGLIPTIN.

2. Brief facts of this application are that the plaintiffs are the registered patentee for drug SITAGLIPTIN having an Indian Patent No. 209816. The said drug was approved for sale in the Indian Market on 28.03.2008. Thereafter Plaintiff No. 1 is selling the said drug in India under the trademark JANUVIA and JANUMET. The said drug is also being sold under the brand name of ISTAVEL and ISTAMET which are through its Licensee i.e. Plaintiff No. 2. The said drug was also launched in more than 107 countries. The dispute arose in March, 2014 when the plaintiffs came to know that the defendants are using the said patent drug under the brand name of SIFORES and are exporting it to Mauritius and Singapore. Hence, this application was filed by the plaintiffs to pass an ex parte ad interim injunction as the plaintiffs are having an apprehension that the said product may be launched by the defendants any time in the Indian Market in the near future.

3. This application was heard at length by this court on 14.10.2014, where it relied on the submission of the learned counsel of plaintiffs regarding the registered patent of the plaintiffs and was pleased to pass an ex parte interim injunction. It had also further noted that the defendants intend to launch medicines/drugs with identical salt by the name of SIFORES in India which would be an infringement of the patent rights of the plaintiffs as per the details of the patent as described in the plaint.

4. Learned counsel for the plaintiffs points out that in CS(OS) 586/2013 titled as Merck Sharp & Dohme & Anr. V Glenmark Pharmaceuticals Ltd., this court passed a decree dated 07.10.2015 in favour of the plaintiffs and against the defendants for permanent injunction for using, selling, distributing etc. or dealing in "Sitagliptin Phosphate Monohydrate Tablets" or any other salt of "Sitagliptin" in any form alone or in combination with one or more other drugs thereby infringing the suit patent No.

209816 of the plaintiffs. There was no challenge to the said decree. Thereafter, a certificate of validity was granted by this court pursuant to the said decree under Section 113 of the Patent Act.

5. Section 113 of the Patent Act reads as follows:-

"113 Certificate of validity of specification and costs of subsequent suits for infringement thereof: -

(1) If in any proceedings before the Appellate Board or a High Court for the revocation of a patent under section 64 and section 104, as the case may be, the validity of any claim of a specification is contested and that claim is found by the Appellate Board or the High Court to be valid, the Appellate Board or the High Court may certify that the validity of that claim was contested in those proceedings and was upheld.

(2) Where any such certificate has been granted, then, if in any subsequent suit before a court for infringement of that claim of the patent or in any subsequent proceeding for revocation of the patent in so far as it relates to that claim, the patentee or other person relying on the validity of the claim obtains a final order or judgment in his favour, he shall be entitled to an order for the payment of his full costs, charges and expenses of and incidental to any such suit or proceeding properly incurred so far as they concern the claim in respect of which the certificate was granted, unless the court trying the suit or proceeding otherwise directs: Provided that the costs as specified in this sub-section shall not be ordered when the party disputing the validity of the claim satisfies the court that he was not aware of the grant of the certificate when he raised the dispute and withdrew forthwith such defence when he became aware of such a certificate.

[(3) Nothing contained in this section shall be construed as authorising the courts or the Appellate Board hearing appeals from decrees or orders in suits for infringement or petitions for revocation, as the case may be, to pass orders for costs on the scale referred to therein.]"

6. The Certification of Validity issued by this court reads as follows:-

"CERTIFICATION OF VALIDITY UNDER SECTION 113, PATENTS ACT, 1970:

It is certified that in Civil Suit being CS(OS) 586 of 2013, the validity of Claims 1-20 of Indian Patent No. 209816 (the suit patent) had been contested by the Defendant, on the grounds inter alia, lack of inventive step, lack of industrial applicability, insufficient disclosure, claims not being fairly based, patent having been obtained on false suggestion, violation of Section 8, etc., in CC No. 46 of 2013, and that the claims of the patent have been found to be valid through judgment and Order dated October 7, 2015."

7. Keeping in view the above certificate, in my opinion, the plaintiffs have clearly made out a prima facie case in its favour. Balance of convenience is also in favour of the plaintiffs.

8. Learned counsel for the defendants seeks an adjournment stating that the main counsel is held up in the District Courts. On 04.05.2017, the learned counsel for the defendants had sought an adjournment stating that the learned counsel for the defendants was not available. On 13.09.2017, the learned counsel for the defendants stated that they have filed an application under Order 7 Rule 10 of CPC but the same

is lying under objections. The said application has still not been listed.

9. In these circumstances, it is clear that the defendants are needlessly delaying the matter. The request for adjournment is declined.

10. The interim order dated 14.10.2014 is confirmed. This application stands disposed of.

I.A. 14072/2015

11. In view of the above orders, the present application stands disposed of.

CS(OS) 3132/2014

12. List on 13.02.2018.

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