

(2023) 05 DEL CK 0002

In the Delhi High Court

Case No : Civil Suit (COMM) No. 241, 242 Of 2023, I.A. No. 7809, 7817 Of 2023

Vifor (International) Ltd & Anr

APPELLANT

Vs

J.B. Chemicals And Pharmaceuticals Limited

RESPONDENT

Date of Decision : 01-05-2023

Acts Referred:

Patents Act, 1970 — Section 48

Citation : (2023) 05 DEL CK 0002

Hon'ble Judges : Amit Bansal, J

Bench : Single Bench

Advocate : Rajiv Nayyar, Vaishali Mittal, Rohin Koolwal, Siddhant Chamola, Shivang Sharma, G.Nataraj, Shashikant Yadav, Rahul Bhujbal, Harshita Agarwal, Varsha Jhavar, Surbhi Nautiyal, Yojana Sonkusare

Judgement

Amit Bansal, J

I.A. 7808/2023 (O-XXXIX R-1 & 2 of CPC) in CS(COMM) 241/2023 and I.A. 7816/2023 (O-XXXIX R-1 & 2 of CPC) in CS(COMM) 242/2023

1. The present suits have been filed seeking relief of permanent injunction restraining the defendants from infringement of the Indian Patent No. 221536 for manufacturing of water-soluble iron carbohydrate complex. The water-soluble iron carbohydrate complex is also designated as "FERRIC CARBOXYMALTOSE" or "IRON CARBOXYMALTOSE" and it is used for the intravenous treatment of iron deficiency and iron deficiency anaemia when oral iron preparations are ineffective or cannot be used.

2. The suit patent was granted on 25th June, 2008 with a priority date of 23rd October, 2002. The PCT International filing date for the suit patent is 20th October, 2003. The term of the patent expires on 20th October, 2023.

3. The drug "FERRIC CARBOXYMALTOSE" was launched in India in March, 2011 by the plaintiff no.2 pursuant to entering into a non-exclusive license agreement dated 25th January, 2012 with the plaintiff no.1.

4. Plaintiffs have given details of over 20 lawsuits filed by them against third parties, where orders protecting the plaintiffs' rights have been passed.

5. In the third week of April, 2023, the plaintiffs discovered marketing/promotional material in respect of an intended launch of a generic version of the plaintiffs' drug comprising "FERRIC CARBOXYMALTOSE". The drug is being launched by the defendant in CS(COMM) 241/2023 under the name "JBCARB" and by the defendant in CS(COMM) 242/2023 under the name "CipFCM".

6. It is the case of the plaintiffs that the launch of the aforesaid products would result in infringement of the suit patent. Apprehending the commercial launch of the infringing products of the defendants, the present suits were filed on 24th April, 2023.

7. The suits along with the applications for grant of interim injunction were initially listed before the Co-ordinate Bench of C. Hari Shankar, J. on 25th April, 2023. Since an earlier suit, being CS(COMM) 505/2022, involving the same patent is before this Court, the present suit was also transferred to this Court. Earlier, CS(COMM) 198/2023 was also transferred by the Bench of C. Hari Shankar, J. to this Court vide order dated 10th April, 2023 and CS(COMM) 194/2023 was transferred to this Court by the Bench of Sanjeev Narula, J. vide order dated 6th April, 2023. It is to be noted that the aforesaid suits and CS(COMM) 505/2022 are listed for hearing before this Court on 2nd May, 2023, along with the applications seeking an interim injunction.

8. While transferring the suits, the Bench of C. Hari Shankar J. directed that the status quo as it existed on 25th April, 2023 would continue till 26th April, 2023. The relevant observations from the order dated 25th April, 2023 are set out below:

"8. The status quo, regarding the launching of the product bearing the impugned patent, as it exists today, shall continue only till tomorrow i.e. 26th April 2023, when the matter is listed before the Bench of Hon'ble Mr. Justice Amit Bansal.

9. This order of status quo shall come to an end tomorrow. It would not automatically stand continued unless the Bench to which this matter is being transferred deems it appropriate to continue it.

10. It is made clear that the status quo is being granted for one day only because this Court has deemed it appropriate, to maintain uniformity, that similar matters are heard by the same Bench, and is not being passed even on a tentative appreciation of the merits of the matter.

11. It is clarified, once again, that unless the status quo is continued by the Bench to which the matter is being transferred, it shall come to an end tomorrow."

9. Accordingly, the matter was listed before this Bench on 26th April, 2023 and submissions on behalf of the counsels in respect of the continuation of the status

quo orders were heard.

10. It has been submitted on behalf of the plaintiffs that the suit patent is an old patent and in over twenty suits filed before this Court, various orders protecting the rights of the plaintiffs have been passed. Copies of the said orders have been filed along with the suit. It is further submitted that the suit patent is a 'product by process patent', which covers both the product and the process.

11. Per contra, counsels appearing on behalf of the defendants in the present suits submit that the suit patent is only a 'process patent' and therefore, the plaintiffs cannot be granted an ad interim injunction if the products are manufactured by the defendants by using a different process. It is further submitted by the counsels for the defendants that they do not manufacture the products themselves. The products are being manufactured by BDR Pharmaceuticals and the defendants only market the aforesaid products. In CS(COMM) 505/2022 filed by the plaintiffs, BDR Pharmaceuticals is one of the defendants and no injunction has been passed against BDR Pharmaceuticals as well as the other defendants. No ad interim injunction has been passed against the defendants in CS(COMM) 198/2023 and CS(COMM) 194/2023 as well. Therefore, no injunction order may be passed against the defendants in the present suits.

12. On behalf of the defendant in CS(COMM) 241/2022, Mr. Natarajan submits that the defendant has already launched its product in India, which has been vehemently disputed on behalf of the plaintiffs.

13. Counsel for the plaintiffs submits that, unlike the defendants in the present suits, the defendants in CS(COMM) 505/2022, CS(COMM) 198/2023 and CS(COMM) 194/2023 had already launched the product on the date of the filing of the suit. Therefore, the plaintiffs had not pressed for an ad interim injunction and the defendants in those suits were directed to maintain accounts in respect of sales of the impugned products.

14. I have heard the counsels for the parties.

15. It cannot be denied that the plaintiffs' patent is an old patent in the final year of its twenty-year term, which expires on 20th October, 2023. It is also a matter of record that in around twenty suits against infringing parties, various positive orders have been passed protecting the rights of the plaintiffs by different Benches of this Court. The defendant in CS(COMM) 242/2023 is yet to launch its products and though a statement has been made by the counsel for the defendant in CS(COMM) 241/2023 that it has already launched the impugned products, no proof has been filed evidencing that the products have been commercially launched.

16. I do not find merit in the submission of the defendants that since there is no interim injunction against the manufacturer, BDR Pharmaceuticals/the defendant no.3 in CS(COMM) 505/2022, no ad interim injunction should be passed against

the defendants in the present suits. Under Section 48 of the Patents Act, 1970, a right has been conferred upon the patentee to prevent third parties from 'offering for sale' or 'selling' the infringing products without the consent of the patentee. Therefore, the plaintiffs have a separate cause of action against the defendants in the present suits. Similarly, I do not find merit in the submission of the defendants that since no ad interim injunction has been passed against the defendants in CS(COMM) 198/2023 and CS(COMM) 194/2023, no status quo orders should be passed in the present matters. The plaint in CS(COMM) 198/2023 and CS(COMM) 194/2023 states that the defendants therein had already launched their products at the time of filing the suits.

17. Therefore, taking into account the principles of balance of convenience and the fact that CS(COMM) 505/2022 along with CS(COMM) 198/2023 and CS(COMM) 194/2022 are listed for hearing on the interim application on 2nd May, 2023, I am of the considered view that at this interlocutory stage, status quo as it existed on 25th April, 2023 should continue till further orders. It is ordered accordingly.

18. List on 2nd May, 2023.

19. Needless to state, the observations made hereinabove are only limited for the purposes of arriving at an ad interim arrangement.