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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

\+ CS(COMM) 211/2022 & I.A. 5212/2022, 5213/2022, 5214/2022, 5215/2022

FERRING B.V. & ORS. ..... Plaintiffs

Through: Mr. P.S. Raman, Senior Advocate with Mr. Pravin Anand, Ms. Archana Shanker, Ms.Prachi Agarwal, Ms. Ridhie Bajaj, Ms. Misthi Dubey, Ms. Lakshana and Ms. Maithreui, Advocates.

versus

PRECISE BIO PHARMA PVT. LTD. & ORS. ..... Defendants

Through: Ms. Rajeshwari H. and Ms. Sugandh Shahi, Advocates for D-1.
Mr. Chander M. Lall, Senior Advocate with Ms.Swapnil Gaur, Advocate for D-2.

CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH

O R D E R

% 07.04.2022

1. Present suit has been filed by the Plaintiffs under Section 48 read with Sections 108 and 11A(7) of the Patents Act, 1970(hereinafter referred to as Act) seeking *inter alia* permanent injunction against the Defendants as well as damages, delivery, disclosure, recall of the infringing products and deposit of sale proceeds alleging infringement of the patent IN 387567 for the period 31.10.2014 to 03.03.2022.

2. It is the case of the Plaintiffs that the subject invention relates to pharmaceutical compositions for prevention of post-partum haemorrhage due to uterine atony and the composition comprises of

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carbetocin which is stable on storage at upto 30°C (hereinafter referred to as RTS Carbetocin). The importance of the invention as explained in the plaint is that the RTS Carbetocin, when administered prevents excessive bleeding after child birth.

3. The suit patent was filed as a Patent Cooperation Treaty application on 20.03.2013 claiming priority from 30.09.2010. The patent was granted vide order dated 27.01.2022 by the Assistant Controller of Patents, dismissing the pre-grant opposition, filed by Defendant No.1 herein. Certificate regarding grant of patent was issued on 27.01.2022 and the grant of patent was published on 04.02.2022.

4. It is undisputed between the parties that the order dated 27.01.2022 granting patent in favour of the Plaintiffs was challenged by Defendant No.1 in a writ petition being W.P.(C) IPD 3/2022 on a limited ground that the order was a non-speaking order. On 22.02.2022, the Court stayed the operation of the order dated 27.01.2022 granting opportunity to the Respondents therein to take instructions in the matter and the writ petition was re-notified for 03.03.2022.

5. Vide order dated 03.03.2022, the Court set aside the order dated 27.01.2022 on the ground that it was bereft of any reason and was a non-speaking order. The matter was remanded to the Assistant Controller of Patents and Designs to pass a reasoned order within four weeks, after hearing the parties, justifying rejection of the pre-grant opposition filed against the suit patent. Liberty was granted to the Petitioner therein to impugn any further order passed by the Assistant

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Controller.

6. Subsequent thereto, a Review Petition 69/2022, was filed by Petitioner therein and vide order dated 22.03.2022, Court clarified that the direction issued to the Assistant Controller did not necessarily have to result in a rejection of the pre-grant opposition and that the Assistant Controller was free to adjudicate the opposition in any manner he deemed appropriate in the facts and circumstances of the case, in accordance with law. A further period of four weeks was given to comply with the directions commencing from 22.03.2022 which is admittedly expiring on 19.04.2022.

7. It is the contention of learned Senior Counsel for the Plaintiffs that Defendant No.1 has started manufacturing the generic RTS Carbetocin 100 mcg/ml which is the subject matter of the suit patent for Defendants No.2 and 3, who are likely to sell and market the infringing goods in the near future. Since the patent granted in favour of the Plaintiffs was valid and subsisting on the Register in February, 2022, pursuant to the grant on 27.01.2022 and the order of grant was set aside later on 03.03.2022, any act of manufacturing, using, selling or offering for sale etc. of the infringing product, while the patent was in force clearly amounts to infringement of the patent under Section 48 of the Act.

8. Learned Senior Counsel relies on a judgment of the Co-ordinate Bench in ***Astra Zeneca AB and Anr. vs. Natco Pharma Ltd.*** in CS(COMM) 117/2020, decided on 02.02.2022 as well as another judgment of another Co-ordinate Bench in ***Sotefin SA vs. Indraprastha Cancer Society and Research Center and Ors.*** in

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CS(COMM) 327/2021, decided on 22.02.2022, to contend that if infringement has occurred during the lifetime of the patent, the infringing good would not be kosher on expiry of the patent and the Plaintiff would be entitled to seek restraint with respect to the infringing products, which were made or imported at the time when the suit patent was valid and subsisting. Court further held that irrespective of the fact that the patent is to expire in the near future, Plaintiff can insist on protection under Section 48 of the Act.

9. *Per contra*, learned Senior Counsel appearing on behalf of the Defendants draws the attention of the Court to Section 48 of the Act and contends that the exclusive right of a patentee to prevent third parties from the act of making, using, offering for sale or importing a product or a process as the case may be, arises only from the grant of the patent. It is further contended that under Section 11A (7) of the Act on and from the date of publication of the application for the patent and until the date of grant of a patent, the applicant has the like privileges and rights as if the patent for the invention had been granted on the date of application, however, Proviso to Section 11A(7) clearly provides that the applicant shall not be entitled to institute proceedings for infringement until the patent is granted. It is, therefore, contended that no doubt the patent was granted in favour of the Plaintiffs by the Assistant Controller vide order dated 27.01.2022 but the order has been set aside by this Court in a writ petition and therefore, there is no valid patent entitling the Plaintiffs to file the present suit.

10. Responding to the argument of the learned Senior Counsel for

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the Plaintiffs that the patent was valid from the date of its grant i.e. 27.01.2022 till 03.03.2022, on which date it was set aside, Mr. Lall, submits that once the order granting the patent has been set aside, the order will relate back to the date of grant and it cannot be argued by the Plaintiffs that the patent was valid for a limited period entitling them to sue for infringement on that basis.

11. This Court finds merit in the contentions raised on behalf of the Defendants. Plain reading of Section 48 of the Act leaves no doubt that the exclusive right of a patentee to prevent third parties from manufacturing, selling etc. the products or using the process, as the case may be, being the subject matter of the patent, only arises once the patent is granted. It is also explicitly clear from a reading of the first Proviso to Section 11A(7) that an infringement action cannot lie until the grant of the patent.

12. In the present case, the order granting the patent in favour of the Plaintiffs, admittedly stands set aside in a writ petition and as rightly contended by the Defendants, the order of the Court would relate back to the date of grant of the patent. The inevitable consequence of setting aside of the order granting the patent is that there is no valid patent in favour of the Plaintiffs and thus the Plaintiffs are not entitled to file the present suit for infringement. The judgments relied upon by the learned Senior Counsel for the Plaintiffs are distinguishable on facts inasmuch as in the said cases the patents had expired or lapsed and the issue was regarding the rights of a patentee during the period of validity of the patents.

13. At this stage, learned Senior Counsel appearing on behalf of the

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Plaintiffs, on instructions, seeks to withdraw the present suit with liberty to take recourse to legal remedies after the decision is rendered by the Assistant Controller of Patents and Designs.

14. The suit is accordingly disposed of as withdrawn granting liberty to the Plaintiffs to take recourse to remedies available, in accordance with law.

15. It is made clear that this Court has not expressed any opinion on the merits of the case.

JYOTI SINGH, J

APRIL 07, 2022
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