

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED:31.07.2015

CORAM:

THE HONOURABLE MR. JUSTICE K. RAVICHANDRABAABU

C.S.No.329 of 2015
& O.A.No.435 of 2015

1. Novartis AG
Lichtstrasse 35, 4056
Basel
Switzerland
Rep. by its Power of Attorney
Mr.Durganand Singh
Sandoz House, Dr. Annie Besant Road
Worli, Mumbai-400 018.
2. Novartis Healthcare Pvt. Limited
Sandoz House, Shiv Sagar Estate
Dr. Annie Besant Road
Worli, Mumbai-400 018
Rep. by its Power of Attorney
Mr.Durganand Singh

..Plaintiffs

-Vs.-

Nutra Specialities Pvt. Limited
No.4, First Floor
Bharathi Nagar 4th Street
T. Nagar
Chennai-600 017.

..Defendant

Prayer:- Suit filed under Order IV Rule 1 of Original Side Rules read with Order VII Rule 1 of Civil Procedure Code praying for the following reliefs:

(i) a decree for permanent injunction restraining the defendant, by itself or through its directors, group company, associates, divisions, assigns in business, licensees, franchisees, agents, distributors and dealers from using, manufacturing, importing, selling, offering for sale either through website <http://www.nutraforlife.com> or by any other means, exporting, directly or indirectly dealing in Active Pharmaceutical Ingredient (API), Pharmaceutical products, or formulation containing Vildagliptin alone or Vildagliptin in combination with any other compound or API or in any other form as may amount to infringement of Indian Patent No.212815 of the plaintiff No.1;

(ii) a decree for delivery up of all the stock of infringing pharmaceutical formulations, compound of combinations comprising Vildagliptin alone and/or Vildagliptin in combination with any other compound or formulation available with the defendant to an authorized representative of the plaintiffs;

(iii) an order for rendition of accounts of profits earned by the defendant for manufacture and sale of infringing pharmaceutical products or formulation or combination containing Vildagliptin alone or Vildagliptin in combination in any form and a decree for the amount so found due may be passed or in the alternative damages may be ascertained by the Hon'ble Court and a decree for damages as ascertained may be passed in favour of the plaintiffs and against the defendant;

(iv) Cost of the proceedings.

For Plaintiff : Mr.Sathish Parasaran

For Defendant : Mr.K. Harishankar

J U D G M E N T

The plaintiffs filed the above suit seeking for the following reliefs

"(i) a decree for permanent injunction restraining the defendant, by itself or through its directors, group company, associates, divisions, assigns in business, licensees, franchisees, agents, distributors and dealers from using, manufacturing, importing, selling, offering for sale either through website <http://www.nutraforlife.com> or by any other means, exporting, directly or indirectly dealing in Active Pharmaceutical Ingredient (API), Pharmaceutical products, or formulation containing Vildagliptin alone or Vildagliptin in combination with any other compound or API or in any other form as may amount to infringement of Indian Patent No.212815 of the plaintiff No.1;

(ii) a decree for delivery up of all the stock of infringing pharmaceutical formulations, compound of combinations comprising Vildagliptin alone and/or Vildagliptin in combination with any other compound or formulation available with the defendant to an authorized representative of the plaintiffs;

(iii) an order for rendition of accounts of profits earned by the defendant for manufacture and sale of

infringing pharmaceutical products or formulation or combination containing Vildagliptin alone or Vildagliptin in combination in any form and a decree for the amount so found due may be passed or in the alternative damages may be ascertained by the Hon'ble Court and a decree for damages as ascertained may be passed in favour of the plaintiffs and against the defendant;

(iv) Cost of the proceedings.

2. Pending suit, the plaintiff filed O.A.No.435 of 2015 seeking for an ad-interim injunction restraining the respondent, by itself or through its directors, group company, associates, divisions, assigns in business, licensees, franchisees, agents, distributors and dealers from using, manufacturing, importing, selling, offering for sale either through website <http://www.nutraforlife.com> or by any other means, exporting, directly or indirectly dealing in Active Pharmaceutical Ingredient (API), Pharmaceutical products, or formulation containing Vildagliptin alone or Vildagliptin in combination with any other compound or API or in any other form as may amount to infringement of Indian Patent No.212815 of the plaintiff No.1/Applicant No.1.

3. This Court by an order dated 21.04.2015 granted interim injunction for a period of six weeks, which is being extended periodically and the same is still in force.

4. Today the defendant has filed an affidavit of undertaking dated 28.7.2015 which reads as follows:

"1.The defendant unconditionally agrees and acknowledges the plaintiff No.1 is the registered patentee of Indian Patent No.212815.

2. The defendant hereby undertakes to this Hon'ble Court and to the plaintiffs that it will not either by itself or through its directors, group company, associates, divisions, assigns in business, licensees, franchisees, agents, distributors and dealers use, manufacture, import, sell, offer for sale either through website <http://www.nutraforlife.com> or by any other means, exporting, directly or indirectly deal in Active Pharmaceutical Ingredient (API), Pharmaceutical products, or formulation containing Vildagliptin alone or Vildagliptin in combination with any other compound or API or in any other form as may amount to infringement of Indian Patent No.212815 of the plaintiff No.1.

3. The defendant admits and accepts the rights of the plaintiff No.1 in patent being IN 212815 and acknowledges the validity thereof.

4. The defendant further submits that the present dispute may be resolved in view of the undertaking given hereinabove and the suit may be decreed in terms of para 41 of the plaint.

5. The defendant consents that a decree may be passed between the parties in favour of the plaintiffs and against the defendant.

6. The above undertaking has been read over and explained to the defendant and defendant has agreed to this undertaking after reading and understanding all the clauses and facts and thus this undertaking is binding on the defendant."

5. The learned counsel appearing for the defendant submitted that the suit may be decreed in favour of the plaintiffs and against the defendant in view of the undertaking given by the defendant and also in terms of paragraph 41 of the plaint. Paragraph 41 of the plaint reads as follows:

The use, manufacture, import, export, offer for sale and sale of Vildagliptin API and/or pharmaceutical products containing Vildagliptin alone or in combination with any other compound, excipients or salts or substance, without prior permission and license/authorization from plaintiff No.1 would constitute infringement of Indian Patent No.212815 under Section 48 of The Patents Act, 1970. Additionally, the use, manufacture, import, export, offer for sale and sale of Vildagliptin in a pharmaceutical composition together with at least one pharmaceutically acceptable carrier or diluents would constitute use of the patented compound which is covered by claims 1,3,4 and 5 of the suit patent and infringement of Indian Patent No.212815 under Section 48 of the Patents Act, 1970 and is liable to be enjoined being illegitimate and unlawful under the provisions of Section 108 of the said Act. Vildagliptin therefore cannot be manufactured, used, offered to be sold or sold either alone or in combination with other pharmaceutically acceptable salts as a formulation without prior permission, consent or license from plaintiff No.1."

6. Considering the above stated facts and circumstances and considering the fact that the defendant has submitted to the decree as stated supra by filing an affidavit of undertaking dated 28.07.2015, the suit is decreed as prayed for. However, considering the above stated facts and circumstances, there will be no order as to costs. Consequently, the connected application is closed.

Index:Yes/No
Internet: Yes/No

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Tr/

K. RAVICHANDRABAABU, J

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