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IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
SUIT (L) NO. 900 OF 2016
WITH
NOTICE OF MOTION (L) NO. 2665 OF 2016

Novartis AG & Another ...Plaintiffs
Versus
Hetero Drugs Limited ...Defendants

Mr. Hemant Singh, *with Ms. Mamta Jha, i/b Mr. Rishi Mody, for the Plaintiffs.*

Mr. Abhay Jadeja, *with Mr. Pradeep Mane & Mr. Jay Zaveri, i/b Crawford Bayley & Co., for the Defendants.*

CORAM: G.S. PATEL, J
DATED: 19th October 2016

PC:-

1. Both Defendants have filed Affidavits in Reply to the Notice of Motion. There are also two Affidavits in Rejoinder. These are taken on record.

2. The 2nd Defendant says in paragraphs 2 and 3 of its Affidavit in Reply:¹

“2. At the outset Defendant No. 2 states that it is not commercially undertaking manufacture, sale and/or

¹Notice of Motion Paper book, p. 25.

supply of 'Vidagliptin' API and/or any different form of 'Vidagliptin' and/or of any formulation or pharmaceutical preparation containing 'Vidagliptin'. The Defendant No. 2 was only manufacturing 'Vidagliptin', for the purpose of conducting development, clinical trials, submissions of information required by regulatory authorities; and R&D purpose. The batches as prepared by Defendant No. 2 were in small quantities and not intended to be for commercial purposes. The batches as manufactured by the Defendant No. 2 were permissible under the present regime of the Patents Act, 1970 and thus cannot be amount to infringement.

3. I say that the Defendant No. 2 have during the term of the Plaintiffs patent, no intention to commercialize the same and/or manufacture any further quantities of 'Vidagliptin' for R&D; if they do so decide, the same will be only with the written consent of the Plaintiff and as permissible under law. The Defendant No. 2 shall commercialize 'Vidagliptin' only on expiry of the patent, if commercially viable."

3. For his part, the 1st Defendant says in paragraph 4 of its Affidavit in Reply:²

"4. Defendant No. 1 and other entities of the Hetero Group of Companies, are fully compliant with the patent regime and comply with all applicable laws. 'Vidagliptin', cannot be commercialized during the tenure of the patent. The same can be only used post expiry of the Plaintiffs patent. Defendant No. 1 have during the term of

²Notice of Motion Paper book, *pp.* 22-23.

the Plaintiffs patent, no intention to commercialize the same; if they do so decide, the same will be only with the written consent of the Plaintiff and as permissible under law.”

4. These statements from both Defendants are accepted as undertakings to the Court. It is stated that the Attorneys & Counsel for the Defendants have sufficient authority to give these undertakings.

5. These undertakings having been accepted, the Plaintiffs do not press their prayer for damages.

6. The Suit is decreed in these terms. Drawn up decree dispensed with. Refund of court fee in accordance with the Rules.

7. In view of this, the Notice of Motion is disposed of as infructuous with no order as to costs.

8. All concerned to act on an authenticated copy of this order.

(G. S. PATEL, J.)