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IN THE HIGH COURT OF DELHI AT NEW DELHI

+ CS(OS) 1236/2013 & I.As. 16133/2013, 280/2014 AND
9968/2013

MERCK SHARP & DOHME
CORPORATION & ANR.

..... Plaintiffs

Through: Mr. Pravin Anand, Advocate with
Ms. Udit Patro and Mr. Shamim
Nooreydzan, Advocates.

versus

APRICA PHARMACEUTICALS
PRIVATE LIMITED

..... Defendant

Through: None.

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Date of Decision: 14th November, 2017

CORAM:

HON'BLE MR. JUSTICE MANMOHAN

J U D G M E N T

MANMOHAN, J: (Oral)

1. Though the defendant initially entered appearance, yet after 13th July, 2017, it stopped appearing and did not file any written statement. Accordingly, the defendant was proceeded ex parte vide order dated 3rd November, 2017.

2. At this stage, learned counsel for the plaintiffs states that in view of the judgment of this Court in *Satya Infrastructure Ltd. & Ors. Vs. Satya Infra & Estates Pvt. Ltd.*, 2013 SCC OnLine Del 508, the present suit should be decreed qua the relief of injunction. The relevant portion

of the said judgment relied upon by learned counsel for the plaintiffs is reproduced hereinbelow:-

“I am of the opinion that no purpose will be served in such cases by directing the plaintiffs to lead ex parte evidence in the form of affidavit by way of examination-in-chief and which invariably is a repetition of the contents of the plaint. The plaint otherwise, as per the amended CPC, besides being verified, is also supported by affidavits of the plaintiffs. I fail to fathom any reason for according any additional sanctity to the affidavit by way of examination-in-chief than to the affidavit in support of the plaint or to any exhibit marks being put on the documents which have been filed by the plaintiffs and are already on record. I have therefore heard the counsel for the plaintiffs on merits qua the relief of injunction.”

3. Learned counsel for the plaintiffs further states that he has instructions not to press for any relief other than the relief of permanent injunction and costs, as prayed for in prayer clause (a) and (d) of the plaint.

4. The relevant facts of the present case as pointed out by learned counsel for the plaintiffs are as under:-

A. The plaintiff No.1 along with its various subsidiaries is amongst the world's leading Pharmaceutical companies and is dedicated to discovering, developing and providing innovative pharmaceutical products that prevent and cure diseases and address evolving medical needs of patients and society worldwide. Plaintiff No.2 is the licensee of plaintiff No.1.

- B. The plaintiff No.1 is the registered proprietor of Indian Patent No.209816 that covers a product which has been given the International Non-Proprietary name SITAGLIPTIN. The said molecule is commercially sold by the plaintiffs in India extensively under the brand/commercial name JANUVIA.
- C. The plaintiff No.1 manufactures another product which is a combination of SITAGLIPTIN and another drug known as METFORMIN HCl which falls under the protection afforded to Indian Patent No.209816 and the said combination is sold by plaintiff No.1 under the brand/commercial name JANUMET.
- D. The defendant is engaged in the business of marketing, selling and/or offering for sale various pharmaceutical products. The plaintiffs have reasonable apprehension that the defendant is going to launch a generic version of SITAGLIPTIN under the brand name ECOGLIPT in the Indian market.
- E. The source of plaintiffs' apprehension is based on two SMSes dated 17th May, 2013 and 30th May, 2013 sent by the defendant to its field force. The said SMSes are reproduced hereinbelow:

SMS dated 17th May, 2013

“ Seeds of the future r planted in the present. Another step from APRICA on the path of dynamic growth. NEW LAUNCH! ECOGLIPT, sitagliptin from APRICA. BE PREPRD”.

SMS dated 30th May, 2013

“Economical gliptin” Ecoglipt MOA-It works to competitively inhibit the enzyme dipeptidyl peptidase 4 (DPP-4). This enzyme breaks down the incretins GLP-1 and GIP (GI hormone)” .

- F. The perusal of aforesaid SMSes makes it clear that the defendant at the time of filing the lawsuit was soon going to launch a generic version of the patented product SITAGLIPTIN across the country under the brand ECOGLIPT. However, to the best of the plaintiffs' knowledge, the defendant had not launched the infringing product at the time of filing of the lawsuit.
- G. The defendant's product is a generic version of SITAGLIPTIN which blatantly infringes the plaintiff No.1's Indian Patent No.209816 wherein SITAGLIPTIN and its pharmaceutically acceptable salts, including Phosphate are specifically claimed in Claim 19.
- H. The acts of the defendant are prohibited under Section 48 of the Patents Act, 1970 and are in complete contravention and disregard of the plaintiff No.1's existing and valid Indian Patent No.209816.
- I. Since a Coordinate Bench of this Court has already issued a certificate of validity to the suit patent through its order dated 07th September, 2016 passed in CS(OS) 586/2013, there is no plausible explanation for the defendant in using

SITAGLIPTIN and its pharmaceutically acceptable salts for its impugned product ECOGLIPT.

- J. Though the infringing product ECOGLIPT had at the time of filing of the lawsuit not yet been commercially sold by the defendant, there existed a reasonable apprehension that the defendant may launch their infringing product at a commercial scale in the future and flood the markets which would cause irreparable harm to the plaintiffs.

5. In view of the averments made in the plaint, which remain uncontroverted, this Court is of the view that the plaintiffs are entitled to the judgment in terms of the relief claimed for in prayer clause (a) and (d) of the plaint as it is a *quia timet* action. A Coordinate Bench of this Court in ***Mars Incorporated Vs. Kumar Krishna Mukerjee and Ors., 2003 (26) PTC 60 (Del)*** has held as under:-

“16. Quia Timet is actually a Latin word which means "because he fears or apprehends". In legal terminology it has been defined in Osborne's Concise Law Dictionary (London: Sweet and Maxwell, 8th edn. 1993, Bone and Rutherford) as an action by which a person may obtain an injunction to prevent or restrain some threatened act being done which, if done, would cause him substantial damage, and for which money would be no adequate or sufficient remedy...

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21. To expect the aggrieved party to wait and watch for the opening of business or manufacturing or sale or goods under the apprehended infringement of trade mark is too much. A stitch in time always saves nine and that is what is the essence of Quia Timet Action...”

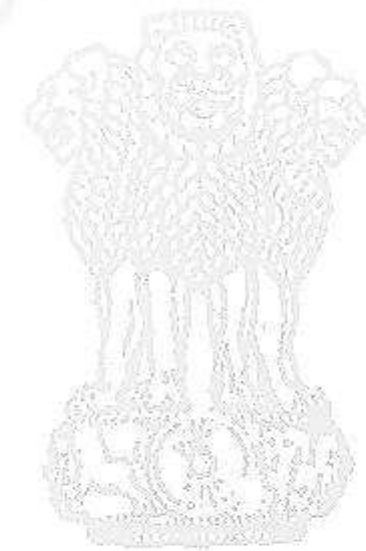
6. In view of the above, the suit is decreed in favour of the plaintiffs and against defendant in terms of prayer clause (a) and (d) of the plaint along with the actual costs. The costs shall amongst others include the lawyers' fees as well as the amounts spent on purchasing the court fees. The plaintiff is given liberty to file on record the exact cost incurred by it in adjudication of the present suit, if not already filed. Registry is directed to prepare a decree sheet accordingly.

7. Consequently, the present suit and applications stand disposed of.

MANMOHAN, J

NOVEMBER 14, 2017

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