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

+ **CS(COMM) 269/2020**

I.A. 5952/2020 (under Order XXXIX Rule 1 and 2 CPC)

I.A. 5953/2020 (under Order XI Rule 1(4) Commercial Courts Act)

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..... Plaintiff

Represented by: Mr. Pravin Anand, Advocate with
Ms. Archana Shanker, Mr. Shrawan
Chopra, Mr. Vaibhav Mithal and
Mr. Bobby Jain, Advocates.

versus

UPL LIMITED

..... Defendant

Represented by: Ms. Rajeshwari H., Advocate with
Mr. J. Sai Deepak and Mr. Tahir A.J.,
Advocates.

CORAM:

HON'BLE MS. JUSTICE MUKTA GUPTA

ORDER

11.09.2020

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The hearing has been conducted through Video Conferencing.

1. The present suit has been filed by the plaintiff against the defendant UPL Limited inter alia seeking a decree of permanent injunction restraining the defendant from infringing its India Patent No. 262428 (in short 'IN 428') which is titled as "MONOCLINIC 2-CHLORO-N-(4'-CHLOROBIPHENYL-2-YL) NICOTINAMIDE AND A PROCESS FOR PREPARING THE SAME" besides rendition of accounts/ damages, delivery up etc.

2. In the plaint, besides describing its achievements and the patent granted to the plaintiff and that the same was valid till 28th January, 2024, the plaintiff expressed its apprehension of the defendant violating and

infringing the suit patent on the ground that the defendant has been granted Export Registration for 'Boscalid' and defendant has also filed three revocation petitions against plaintiff's three patents being IN 262428, IN 230247 and IN 207019 before the Intellectual Property Appellate Court.

3. Summons in the present suit was issued. Learned counsel for the defendant entered appearance on the first day itself and stated that the defendant had applied for licence of BOSCALID Technical for which there is no valid patent existing as on date and the defendant has not applied for the anhydrous form-II of BOSCALID i.e. the suit patent. It was also stated on behalf of the defendant that it has also not filed any further application seeking license for supply of BOSCALID anhydrous form-II and that the defendant is using the said product only for the purposes of research and development.

4. Thus, this Court required the defendant to file an affidavit in this regard so that the suit could be decreed.

5. An affidavit of Mr. Ravindranath Hegde dated 25th July, 2020 was filed in response to the order of this Court dated 23rd July, 2020. In the said affidavit Mr. Ravindranath Hegde, the Authorised Signatory of defendant stated in Para 3, 4 and 5 as under:

"3. I state that UPL Ltd. was granted a certificate of registration of Insecticides under Section 9(3) of the Insecticides Act, 1968, bearing registration No. CIR-(SE)-9142/2017(374)-Boscalid (Technical)-3. The said registration certificate is annexed as Annexure-1. I state that the said registration is for 'Boscalid-Technical' i.e. the active ingredient. This is stated in the registration certificate.

4. I state that UPL Ltd. has not filed any application for registration, in respect of Boscalid anhydrous Form-II, before

the Central Insecticides Board and Registration Committee (CIB&RC).

5. I state that UPL Ltd. is conducting Research & Development studies, in respect of polymorphic forms of Boscalid, as of date.”

6. Since the affidavit on behalf of the defendant did not clarify its exact position and particulars in respect of the suit patent, learned counsel for the defendant sought time to file detailed affidavit alongwith the authorisation of the defendant in favour of the deponent. Consequently, an affidavit of Mr. Ravindranath Hegde has been filed on 17th August, 2020, wherein in Para 3, 4, 5, 6, it is stated as under:-

“3. I state that No patent was applied for in India for the molecule Boscalid and thus the said molecule is not or was not ever protected by any valid patent in India. The Suit patent itself states that Boscalid is disclosed in expired patent EP0545099. There is no corresponding valid & subsisting patent equivalent to EP0545099 in India & the public at large including UPL is free to use, make, sell and offer for sale, the molecule Boscalid disclosed in the patent EP0545099.

4. I say that UPL Ltd. does not and shall not carry out any commercial activity as to Anhydrate Polymorphic Form II of Boscalid claimed by Indian Patent No.262428 till such time the said Patent ceases or is revoked or is surrendered by the Patentee, which is earlier. The suit can be decreed.

5. I say that UPL is conducting research on polymorphic forms of Boscalid including Anhydrate form II. UPL Ltd. has not applied for registration of Anhydrate Polymorphic Form II of Boscalid before CIB&RC. Also the recommendations of the Central Insecticides Board and Registration Committee (CIB&RC) on applications for registrations approving or rejecting an application, are uploaded on the website of

CIB&RC i.e. <https://ppqs.gov.in> and is publicly available and accessible.

6. The present affidavit is without prejudice to the rights and contentions of UPL Ltd. in its challenge to the validity of the patent made in the application for revocation of Patent No. 262428 filed by UPL Ltd. made on or about January 21, 2019 and is pending before the Intellectual Property Appellate Board.”

7. The General Power of Attorney on behalf of the defendant in favour of Mr. Ravindranath Hegde is on record. Considering that in Para 4 of the affidavit dated 17th August, 2020 filed on behalf of the defendant, it is clearly stated that the defendant does not and shall not carry out any commercial activity as to Anhydrate Polymorphic Form II of Boscalid claimed by Indian Patent No.262428 till such time the said Patent ceases or is revoked or is surrendered by the Patentee, whichever is earlier, the suit can be decreed.

8. Consequently, the suit is decreed in favour of the plaintiff and against the defendant granting a decree of permanent injunction, restraining the defendant, its directors, employees, officers, servants, agents and all others acting for and on its behalf from using, making, selling, distributing, advertising, exporting, offering for sale, importing or in any other manner, directly or indirectly, dealing in any product that infringes the suit patent i.e. Indian Patent No. IN 262428 till its expiry or revocation, whichever is earlier.

9. The decree is further passed in favour of the plaintiff and against the defendant directing that in case the defendant seeks to utilise/ use or distribute Anhydrous Form – II of Boscalid covered by the suit Patent i.e.

IN 262428 for the purposes of exporting, they shall comply with the directions issued by the Division Bench of this Court in '*Bayer Corporation versus. Union of India and Ors.*' in LPA No. 359/2017 and '*Bayer Intellectual Property GMBH & Another versus Alembic Pharmaceuticals Ltd.*' in RFA (OS)(COMM) 6/2017 decided on 24th April, 2019 and Section 107A of Indian Patents Act, 1970.

10. In view of the decree having been passed in favour of the plaintiff and against the defendant, learned counsel for the plaintiff states that he has instructions to give up the prayers (b),(c),(d) and (e) in the suit.

11. The suit is accordingly disposed of. Pending applications also stand disposed of.

12. Decree sheet be drawn accordingly.

13. Order be uploaded on the website of this Court.

MUKTA GUPTA, J.

SEPTEMBER 11, 2020

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