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

+ **CS(COMM) 270/2021 & I.A. 7219/2021**

**MERCK SHARP AND DOHME CORP & ANR. .... Plaintiffs**

**Through: Ms. Tusha Malhotra and Ms.  
Yamini Jaswal, Advs.**

**versus**

**SOLITAIRE PHARMACIA PRIVATE LIMITED & ANR.**

**..... Defendants**

**Through:**

**CORAM:**

**HON'BLE MR. JUSTICE C.HARI SHANKAR**

**ORDER (O R A L)**

**28.04.2023**

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1. The dispute between the parties stand settled with the intervention of the Delhi High Court Mediation and Conciliation Centre. The settlement agreement dated 4<sup>th</sup> March 2023 has been placed on record.

2. The terms of settlement read thus:

(a) The Parties have agreed that the Commercial Suit for Patent Infringement, being C.S.(Comm) No. 270 of 2021, shall be decreed by the Hon'ble High Court of Delhi, in favour of the Plaintiffs therein and against the Defendant therein, in terms of the present settlement agreement.

(b) The Plaintiff No. 1 i.e. Merck Sharp & Dohme Corporation has recently undergone a corporate restructuring wherein it has merged with another Merck subsidiary, Merck Sharp & Dohme LLC, and the surviving corporation is Merck Sharp & Dohme LLC. The certificate of merger dated April 07, 2022 along with the application for change of title dated June 29, 2022 before the Patent Office has been filed along with the Patent application.

(c) The Second Party acknowledges the right of the First Party to use the Suit Patent IN" 816 as per law in dealing in products containing Sitagliptin or any of its pharmaceutically acceptable salts, including as Sitagliptin Phosphate, which is the subject matter protected by the said suit patent. The Suit patent IN816 tenure has expired as on 05.07.2022.

(d) The Second Party states that it has not commercially manufactured, used, offered for sale, sold, imported or exported Sitagliptin, either as an API, intermediate or a finished product including Sitaglix, Sitaglix-Plus and Sitaglix-Forte, or indulged or participated in any other activity that constitutes infringement of IN816 during the validity of IN816.

(e) The Second Party further declares that:

i. The Second Party has never engaged in manufacturing of Sitagliptin for the domestic market.

ii. The Second Party has not sold any sitagliptin products in the domestic market and have not generated any revenue from it.

iii. The Second Party has not engaged in advertisements or promotional activities for the Sitagliptin product and the publication of the product was undertaken by them inadvertently. The Second Party, undertakes to remove all advertisements pertaining to Sitagliptin from their own website and any third-party websites, if not already removed by them.

(f) The Second Party tenders an unconditional apology to the First Party for its acts, as detailed in the lawsuit, with respect to Sitagliptin.

(g) Subject to the undertakings given by the Second Party herein, the First Party foregoes their claim for damages, rendition of accounts and costs of the proceedings as regards the Second Party, as prayed for in paragraph 61 clauses (iii) to (v) of the Plaint. However, in the event of discovering in the future, a breach of these undertakings by Second Party, the First Party reserves their right to seek any remedies available to them in law and equity including the Plaintiffs' rights to claim damages.

(h) The Parties agree that they have arrived at the present Settlement Agreement with their own free will and desire and without any pressure, fraud, force, coercion or undue influence by either of the parties and they undertake to be bound by the terms thereof. The parties agree that the statements/commitments made by them in the present Settlement Agreement shall be treated as their undertakings to the Hon'ble Court and in case of any violation

of the terms of the present agreement they shall be held liable for contempt of Court under the Contempt of Courts Act.

(i) The parties agree that they shall appear before the Hon'ble Court during the hearing to make their statements in terms of the present settlement agreement.

(j) That the Parties undertake that they are bound by this Settlement Agreement and further undertake to abide by the terms and conditions set out in the agreement and not to dispute the same hereinafter in future.”

3. Learned Counsel for the parties are present and they undertake on behalf of their respective clients to abide by the terms of settlement.

4. The Court has perused the terms of settlement and finds them to be lawful.

5. As such, nothing survives for adjudication in the suit.

6. The suit stands decreed in terms of the aforesaid settlement agreement dated 4<sup>th</sup> March 2023.

7. Let a decree sheet be drawn up accordingly.

8. The plaintiff would be entitled to refund of Court fess, if any, deposited by it.

**C.HARI SHANKAR, J**

**APRIL 28, 2023**

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