



\$~43

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

+ **CS(COMM) 263/2024 & I.As. 7076-7079/2024**

F. HOFFMANN-LA ROCHE AG & ANR. Plaintiffs

Through: Mr. Pravin Anand, Mr. Shrawan Chopra, Ms. Prachi Agarwal, Ms. Ridhie Bajaj and Ms. Saumya Singh, Advocates.

versus

BIOPHORE INDIA PHARMACEUTICALS PRIVATE LIMITED

..... Defendant

Through: Mr. Sushant Singh, Mr. Sourav Pattanaik and Mr. Piyush Kumar, Advocates.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA

ORDER

28.03.2024

%

1. Let the plaint be registered as a suit.
2. Issue summons. Mr. Sushant Singh, counsel for the Defendant appearing on advance notice, accepts summons. He confirms receipt of the suit paper-book and waives the requirement for Registry to issue formal summons.
3. Plaintiff No. 1- F. Hoffmann-La Roche AG and Plaintiff No. 2- PTC Therapeutics Inc. have filed the instant suit for restraining infringement of Indian Patent No. IN 334397 [*“Suit Patent”*] titled *“COMPOUNDS FOR TREATING SPINAL MUSCULAR ATROPHY”*. The bibliographic details of the Suit Patent are set out as under:



Indian Patent Number	334397
Patent Application Number	201647038542
Applicant/Patentee	Plaintiff No.1 Plaintiff No.2
Title	COMPOUNDS FOR TREATING SPINAL MUSCULAR ATROPHY
National Phase entry-filing date of Indian Application	November 11, 2016
International Application No.	PCT/EP2015/060343
International Filing Date (Date of Patent)	May 11, 2015
Date of Priority	May 15, 2014
WO Publication No.	WO2015/173181 A1
International Publication date	November 19, 2015
Publication Date (u/S 11A)	February 03, 2017
First Examination Report (FER) Issue Date	September 10, 2019
FER Response Date	January 27, 2020
Date of Grant	March 11, 2020
Publication Date (u/S 43(2))	March 13, 2020
Date of Expiry	May 11, 2035
Pre-Grant Opposition	None
Post-Grant Opposition	None
Revocation	None

4. According to the Plaintiffs, the Suit Patent covers and claims, *inter alia*, a novel pharmaceutical compound which has been assigned the International Non-Proprietary Name (INN) 'Risdiplam'. Risdiplam is the active pharmaceutical ingredient (API) in the Plaintiffs' commercial product which is marketed and sold under the brand name 'Evrysdi®' in various countries, including India. In respect of this brand, Plaintiff No. 1 is the registered proprietor of the trademarks: 'EVRYSDI' under No.



एवरीसडी



4241860; ‘ ’ under No. 4239878; and ‘ ’ under No. 4497791.

5. Plaintiffs have approached this Court apprehending that the Defendant, Biophore India Pharmaceuticals Private Limited, is on the verge of commercially launching a pharmaceutical preparation which infringes the Plaintiffs’ Suit Patent. Plaintiffs’ apprehension arose when they came across the information available on the Defendant’s website www.biophore.com wherein Risdiplam is listed as one of the products under the ‘Orphan Drugs’ category. Further, Plaintiffs contend that pursuant to engaging an independent investigator, they have received information that the Defendant is dealing in Risdiplam API, and intends to begin commercial production in India. In such circumstances, since the Defendant claims to be involved in the manufacture of niche pharmaceutical products for global markets, Plaintiffs have filed the instant suit to restrain the Defendant from commercially launching any product in the Indian market which would directly infringe the Suit Patent.

6. Mr. Singh, representing the Defendant, before commencement of the hearing, on instructions states that the Defendant has neither manufactured nor sold any commercial/ non-commercial quantity of Risdiplam in India or anywhere else. He states that presently, the Defendant is using Risdiplam only for the purposes of research, as permissible under Section 107A of the Patents Act, 1970 [“Act”], in terms of the guidelines laid down in ***Bayer Corporation & Anr. v. Union of India & Ors.***¹. Mr. Singh further places

¹ 2019 SCC OnLine Del 8209



reliance on Section 48 of the Act to submit that the law does not prohibit conducting further research on a patented technology for further development and improvement. Nonetheless, Mr. Singh confirms and undertakes on behalf of his client that the Defendant shall not manufacture or sell any pharmaceutical product which infringes the Suit Patent till its expiry on 11th May, 2035. Furthermore, Mr. Singh states that the Defendant does not challenge the validity of the Suit Patent, and therefore, the instant suit can be disposed of on the basis of the aforementioned statement.

7. Mr. Pravin Anand, counsel for the Plaintiffs, having heard the undertaking given by Mr. Singh, states that the Plaintiffs are agreeable to the suit being disposed of by binding the Defendant to the aforementioned statement of Mr. Singh.

8. In light of the above, the suit is decreed in terms of the statement made by Mr. Singh, which shall bind the Defendant. The Defendant must also file an affidavit confirming the statement made by Mr. Singh, as recorded above. It is clarified that the Defendant shall be free to carry out research on the pharmaceutical preparation in question, as permissible under law.

9. Decree sheet be drawn up.

10. The suit, along with pending applications, is disposed of in the above terms.

SANJEEV NARULA, J

MARCH 28, 2024/as