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A.No.5555 of 2024
in C.S.No.282 of 2018

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 05.02.2025

CORAM:

THE HONOURABLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

A.No.5555 of 2024
in C.S.No.282 of 2018

Novartis AG
Lichtstrasse 35, 4056, Basel, Switzerland,
Rep.by its Power of Attorney holder,
Mr.Atul Bade and another .. Applicants

Vs.

Venkata Narayana Active Ingredients Pvt Ltd
Venkata Narayana Towers, III Floor, New No.60, Old No.35, Venkata
Narayana Road, T. Nagar, Chennai 17

(Amended as per order dated 23.11.2018 in Appln. No.8946/2018 and
time Extended as per order dated 22/04/2019) .. Respondent

For Applicants:

Mr.Hemanth Singh
Ms.Mamta Jha
for Mr.Arun C.Mohan

For Respondent:

Mr.T.K.Ramkumar
Ms.Sumitha Vibhu



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ORDER

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The suit was filed seeking remedies in respect of alleged infringement of suit patent No.212815 by the defendant. Issues were framed on 19.01.2024. By this application, the plaintiffs seek amendment or recasting of issues.

2.Learned counsel for the plaintiffs seeks such recasting on three grounds. The first ground is on the basis of typographical errors in the issues, as originally framed. The second ground is that the onus has been placed on the plaintiffs even with regard to issues wherein the onus should lie on the defendant. The last ground is that issue (c) is repetitive and may be deleted.

3.By referring to the affidavit in support of the application, learned counsel submits that the proposed amendments have been set out in paragraph 6 thereof.

4.In response, learned counsel for the defendant submits that the issues may be amended with regard to the correction of typographical errors, such as the use of the erroneous abbreviation “APA” in issues (b)



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and (c) instead of API and the use of the erroneous expression “metabolize” in issue (j) instead of “metabolite”. As regards the date “09.12.2018” in issue (b), learned counsel submits that the defendant has taken the express stand in the written statement that the date of expiry of the suit patent is 09.12.2018. With regard to the onus, learned counsel submits that it is for the Court to decide on whom onus lies.

5. Since parties agreed that there are typographical errors in certain issues, without doubt, those typographical errors are liable to be corrected. As regards the date of expiry of the suit patent, in view of the express assertion by the defendant that the suit patent expired on 09.12.2018 and the denial thereof by the plaintiffs, it is appropriate that an issue be framed separately with regard to expiry of the suit patent. As regards issues relating to the validity of the suit patent or the defence raised by relying on Section 107 of the Patents Act, 1970, as contended by learned counsel for the plaintiffs, the onus is on the defendant. Therefore, the issues are required to be recast to reflect the same. Original issue (c) requires modification by changing APA to API and by deleting the words “for scientific, research and development” therefrom.



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6.It is also appropriate to indicate the party on whom the *onus probandi* falls by specifying OPP or OPD, as the case may be.

7.Accordingly, in substitution of issues framed on 19.01.2024, the issues are recast as under:

“(a) Is the suit infructuous consequent to expiry of the plaintiffs Patent No.212815? (OPD)

(b) Whether the suit patent expired on 09.12.2018, as contended by the defendant, or on 09.12.2019, as contended by the plaintiffs. (OPD & OPP)

(c) Whether the supply of Vildagliptin in API form by the defendant to Egyptian importers was only for scientific research and development purposes as declared by the importers, anticipating the expiry of plaintiffs patent No.212815, as per Section 107-A of the Patents Act or was it for commercial purposes? (OPD)

(d) Whether the supplying of Vildagliptin in API form by the defendant violates the undertaking given by the defendant in earlier proceedings? (OPP)

(e) Whether the defendant is in violation of the judgment and



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decree dated 31.07.2015 passed by this Court in the suit C.S.No.329 of 2015? (OPP)

(f) Whether the defendant is estopped from raising the plea of invalidity of the suit patent IN 212815 by way of defence under Section 107 of the Patents Act, 1970 in view of the decree dated 31.07.2015 passed on the basis of admission in undertaking dated 28.07.2015 furnished before this Court in the suit C.S.No.329 of 2015? (OPP)

(g) Whether the manufacture, stockpiling and export of Vildagliptin by the defendant amounts to infringement of the suit patent IN 212815? (OPP)

(h) Whether the manufacture and export of Vildagliptin by the defendant falls within the exceptions under Section 107-A of the Patents Act, 1970? (OPD)

(i) Was the quantity of Vildagliptin in API form supplied to the Egyptian Importers essential for normal clinical trials for each variation of Vildagliptin or was it excessive? (OPD)

(j) Was the plaintiffs' patent No.212815 invalid on account of misrepresentation and lack of disclosure to the patent office under Section 8 of the Patents Act? (OPD)



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(k) Is Vildagliptin a metabolite and therefore not patentable under Section 3(d) of the Patents Act 1970? (OPD)

(l) Whether the plaintiffs are entitled to damages and in the alternative, rendition of account, as prayed for? (OPP)

(m) To what other reliefs?”

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SENTHILKUMAR RAMAMOORTHY,J.

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