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

+ CS(COMM) 846/2022 & CAV 433/2022, I.A. 20572/2022,
I.A. 20573/2022, I.A. 20574/2022, I.A. 20575/2022

AKUMS DRUGS PHARMACEUTICALS LIMITED

..... Plaintiff

Through: Mr.J. Sai Deepak, Mr.Avinash
Sharma and Mr.R.Abhishek, Advs

versus

FERRING B.V.

..... Defendant

Through: Mr.Amit Sibal, Sr. Adv. with
Ms.Archana Sahadeva, Ms.Sutapa Jana and
Mr.Saksham Dhingra, Advs.

CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR

ORDER

% **06.12.2022**

CAV 433/2022

1. Since learned Counsel for the caveator has appeared, the caveat stands discharged.

I.A. 20575/2022

2. For the reasons stated in this application, the requirement of pre-institution mediation is exemption.

3. The application is allowed accordingly.

I.A. 20574/2022

4. This application seeks permission to place additional documents on record.



5. The plaintiff is permitted to place the additional documents on record within 30 days from today in accordance with the protocol envisaged by Order 11 Rule 1(4) of the CPC as amended by the Commercial Court Act.

6. The application is allowed accordingly.

I.A. 20573/2022

7. Subject to the plaintiff filing legible copies of any dim or illegible documents on which it may seek to place reliance within four weeks from today, exemption is granted for the present.

8. The application is disposed of.

I.A. 20572/2022 (under Order XXXIX Rules 1 and 2 CPC)

9. Issue notice, returnable on 10th February 2023 before the Joint Registrar (Judicial).

10. Reply, if any, be filed within one week from today, with advance copy to learned Counsel for the plaintiff who may file rejoinder thereto, if any, before the next date of hearing.

CS(COMM) 846/2022

11. This is a suit under Section 105 of the Patents Act 1970, whereby the plaintiff seeks a declaration, by the court, that the pharmaceutical composition manufactured by the plaintiff and as described in paragraph 19 of the plaint, does not infringe IN 387567, which is the patent held by the defendant.

12. Mr. Amit Sibal, learned Senior Counsel appearing for the CS(COMM) 846/2022



defendant, advances, as a preliminary objection to issuance of summons in the suit, a contention that the plaint does not satisfy the pre-institution requirement envisaged by Section 105 of the Patents Act, which reads as under:

“105. Power of court to make declaration as to non-infringement.— (1) Notwithstanding anything contained in section 34 of the Specific Relief Act, 1963 (47 of 1963), any person may institute a suit for a declaration that the use by him of any process, or the making, use or sale of any article by him does not, or would not, constitute an infringement of a claim of a patent against the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or the licensee, if it is shown—

(4) that the plaintiff has applied in writing to the patentee or exclusive licensee for a written acknowledgements to the effect of the declaration claimed and has furnished him with full particulars in writing of the process or article in question;

and

(b) that the patentee or licensee has refused or neglected to give such an acknowledgement.

(2) The costs of all parties in a suit for a declaration brought by virtue of this section shall, unless for special reasons the court thinks fit to order otherwise, be paid by the plaintiff.

(3) The validity of a claim of the specification of a patent shall not be called in question in a suit for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid or invalid.

(4) A suit for a declaration may be brought by virtue of this section at any time after the publication of grant of a patent, and references in this section to the patentee shall be construed accordingly.”

13. Mr. Sibal’s contention is that the notice dated 6th October 2022, purported to have been served on the defendant by the plaintiff under Section 105 prior to institution of the present plaint does not satisfy the ingredients of the said provision, for two reasons.



14. He submits, firstly, that the product in respect of which the notice has been issued is not the same as a product which forms subject matter of the plaint, especially with respect to the stability of the compound at room temperature. His second contention is that full particulars with respect to the product have not been provided with the notice under Section 105 as required by the said provision.

15. Mr. J. Sai Deepak, learned Counsel for the plaintiff, needless to say, refutes both the contentions.

16. That matter would be examined when the court takes up the case.

17. As such, let the plaint be registered as a suit.

18. Issue summons in the suit.

19. Summons are accepted, on behalf of the defendant, by Ms. Archana Sahadev.

20. Written statement, accompanied by affidavit of admission and denial of the documents filed by the plaintiff be filed within four weeks with advance copy to learned Counsel for the plaintiff who may file replication thereto, accompanied by affidavit of admission and denial of documents filed by the defendants within four weeks thereof, in terms of the protocol envisaged by CPC as amended by the Commercial Courts Act, 2015.

21. List before the learned Joint Registrar (Judicial) for completion



of pleadings admission and denial of documents and marking of exhibits on 10th February 2023, whereafter the matter would be placed before the court for case management hearing.

C. HARI SHANKAR, J

DECEMBER 6, 2022

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