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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ C.O.(COMM.IPD-PAT) 4/2023, I.A. 6721/2023, I.A. 22950/2023
& I.A. 23727/2023

BLICK SYSTEM INDIA PRIVATE LIMITED Petitioner

Through: Mr. J. Sai Deepak, Mr. Utkarsh
Joshi, Ms. Srishti Singhanian,
Ms.Vasundhara Gupta, Mr.Avinesh
Sharma, Mr. Krishan Singhanian, Ms.
Srishti Singhanian, Ms.Vasundhara
Gupta, Ms.Radhika Bansal and Mr.
Pranab Krishna, Advs.

versus

FRANZ SAFFORD AND OTHERS Respondents

Through: Ms. Diya Kapur, Mr. Sangram Singh R.
Bhonsle, Mr. Anand Mahurkar, Mr.
Selwyn D'costa, Mr. Naman Sherstra,
Mr. Pushkara A. Bhonsle, Mr. Nrupal
A. Dingankar, Mr. Raghav Kumar and
Mr. Aditya Ladha, Advs. for R-I & 2

CORAM:
HON'BLE MR. JUSTICE ANISH DAYAL

ORDER
23.02.2024

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1. C.O.(COMM.IPD-PAT) 4/2023 has been filed by petitioner seeking revocation of the suit patent which was granted in favour of respondents.
2. Pursuant to the revocation petition, being CS(COMM) 456/2023, was filed by respondents/plaintiffs seeking a decree against petitioner/defendant for infringement of the suit patent.
3. An application I.A. 6721/2023 under Order XXXIX Rules 1 & 2 of Code



of Civil Procedure, 1908 (“CPC”) was taken up and an undertaking of the counsel on behalf of respondent nos. 1 & 2 was recorded on 20th April, 2023 by this Court, in the said terms:

“8. Ms. Diya Kapur, arguing for Respondents 1 and 2 undertakes, on instructions, that her clients would not contact any distributor/stockists/retailers in order to create any hindrance in the business of the petitioner in relation to the product claimed in the said patent. The undertaking is taken on record and the Respondents shall remain bound thereby.

9. It is clarified that the restraint is only against contacting distributors/stockists/retailers in such a way as would create hindrance in the business of the petitioner. There is no absolute embargo on the respondents contacting anyone for any other purpose or in the ordinary course of business, as, quite obviously, there cannot be.”

4. Ms. Diya Kapur, counsel for respondent nos. 1 & 2 states that she would not like to continue with the said undertaking any further, on the basis that suit patent is in their favour and granted in 2017 and further, petitioner/defendant had neither filed pre-grant nor post-grant opposition to the patent. Therefore, it does not lie in the mouth of petitioner/defendant to seek any restraint on the part of plaintiffs/respondents.

5. On the issue of withdrawing of undertaking by counsel for respondent nos. 1 & 2, Mr. J Sai Deepak, counsel for petitioner has pointed out that the said undertaking was given in the context of their application under Order XXXIX Rules 1 & 2 of CPC and that it was taken on record and respondent was directed to be bound by the same. Therefore, he states that it is in the species of *pro tem* measure pending the adjudication of Order XXXIX Rules 1 & 2 CPC.



6. He has pointed out previous orders of a coordinate Bench dated 20th February, 2023 in CS(COMM) 93/2023 titled as ***Adama India Private Limited v FMC Corporation & Anr***, where in a suit under Section 105 of the Patents Act, 1970, a direction was passed for defendants to be restrained from contacting the distributors/stockists/retailers or regulatory authorities in order to create any hindrance in the business of petitioner in relation to the suit patent. A similar order was passed in C.O.(COMM. IPD-PAT) 68/2022 titled as ***GSP Crop Science Private Limited v FMC Agro Singapore PTE Ltd. & Ors***, dated 23rd September, 2022, in a matter for revocation of patent where pending consideration of invalidity of the patent, respondents were restrained from contacting the distributors/stockists/retailers or regulatory authorities in order to create any hindrance in the business of petitioner in relation to the suit patent. On this basis, he submits that the undertaking was given and recorded by Court, in this matter.

7. Refuting the same, Ms. Diya Kapur, counsel for respondent nos. 1 & 2 has pointed out to a subsequent order by the same Bench in C.O.(COMM.IPD-PAT) 06/2023 titled as ***Worldfa Exports Pvt Ltd v Ashish Padia & Anr.*** dated 29th August, 2023, where the Bench, adverting to the previous orders passed directing not to communicate with the opposing side clients, expressed reservations on the permissibility and appropriateness of such directions. For a full understanding of the context, relevant paragraphs are extracted as under:

“3. Learned Counsel for the petitioner seeks a direction to the respondents not to communicate with the petitioner’s clients, regarding the present case, during the pendency of these proceedings.

4. It is a fact that this Court has been passing some such



orders in the past. Following orders passed by other Benches, I have also passed some orders to the said effect.

5. However, it seems to me that, in passing these orders, the Court may be transgressing the legitimate boundaries of its jurisdiction. It is not permissible in my view for a Court to pass a direction restraining a party from contacting his client. Learned Counsel for the petitioner acknowledges that some of the clients of the petitioner are also clients of the respondents. If that is so, I see no basis on which the Court can restrain the respondent from contacting its clients.

6. A further question which would arise would be whether the Court can monitor the content of such communications. That, too, in my view, would be an extremely perilous exercise. To what extent can the Court direct the respondent not to communicate with its clients? At what point would such communication be regarded as permissible or impermissible? Learned Counsel for the petitioner submits that the respondents may be permitted to write to its clients regarding the fact of pendency of the present matter, but nothing more. That again becomes an extremely debatable issue. What if the respondents were to write to its client communicating the fact of the pendency of the present matter, as well as the orders passed by this Court? Beyond that, is it permissible for the respondent to communicate what, in its opinion, is the import of the orders passed by this Court? Can the Court monitor such communications or pass an advance order either restraining such communications or setting out the terms and conditions thereof?

7. Repeated applications are coming up before this Court for passing similar orders. In my view, the matter requires a debate as to the nature of orders which can be passed in such cases, if at all.

8. List this matter for hearing on this aspect, so that the Court can take a view on the scope of such prayers, as the issue is coming up in case after case.”

(emphasis added)



8. While the coordinate Bench did not express a final view on the concerns expressed in para 5-6 above, it is instructive and persuasive to the extent that directions to the opposing side of restraint from communicating with business agencies in relation to a patent they hold ought not to be granted.

9. In view of this Court, this issue can be a subject matter of final adjudication of an application filed under Order XXXIX Rules 1 & 2 of CPC, which is yet to take place in this matter.

10. Parties are at issue on the maintainability of an application under Order XXXIX Rules 1&2 of CPC in proceedings for revocation for patent. Those issues will be considered on the next date of hearing.

11. However, considering what has been noted above, reliance by the petitioner's counsel on **Adama** (supra) and **GSP Crop** (supra) may not be useful considering the subsequent observations made by the same Bench in **Worldfa Exports** (supra). Independently, this Court is of the opinion that there may be no necessity binding down respondents to the statement, which was given by their counsel, who is entitled to withdraw the said undertaking. Also since restraint on a patent holder to communicate with parties in respect of their patent and make statements in furtherance of protection of their patent may be a "*extremely perilous exercise*" (as observed by the coordinate Bench). However, it is expected that parties while dealing with business agencies and partners shall give accurate information regarding the contest as regards the suit patent before this Court and its current status, and not indulge in falsehoods.

12. In this view of the matter, statement of Ms. Diya Kapur is taken on record and the undertaking in para 8 & 9 of the order dated 20th April, 2023 is therefore, no longer sustained.



13. List on 17th May, 2024.
14. Order be uploaded on the website of this Court.

ANISH DAYAL, J

FEBRUARY 23, 2024/RK/na