



## India: Teva Api India Pvt. Ltd. & Anr. Vs. Merck Sharp & Dohme Corp & Anr.

(A SUIT FOR INJUNCTION ON INFRINGEMENT OF PATENT)

In a recent patent infringement case *Teva Api India Pvt. Ltd. & Anr. v. Merck Sharp & Dohme Corp & Anr.* **FAO (OS) (COMM) 34/2016**, the Division Bench of the Delhi High Court vide its order dated May 30, 2016 dealt with the issue of expeditious hearing and disposal of applications seeking vacation of ex-parte ad interim injunctions within 30 days, as stipulated by the Indian Code of Civil Procedure, 1908

### BRIEF FACTS:

- The respondents originally sued the appellants alleging infringement of their rights flowing from Indian Patent No. 209816 concerning a molecule having an International No-proprietary Name, SITAGLIPTIN. It was the case of the respondents that the combination of Sitagliptin and another drug known as Metformin HCL is sold under the trademark JANUMET, while stand-alone Sitagliptin was sold under the trademark JANUVIA. The respondents alleged that the appellants are manufacturing and selling its patented product.
- Along with the suit, the respondents filed IA No.1998/2016 claiming an ex-parte ad-interim injunction in terms of the injunction sought for in the plaint. Issuing summons in the suit and notice in IA No.1998/2016, vide order dated February 10, 2016, the learned Single Judge granted the ad-interim injunction restraining the appellants as prayed for by the respondents. The summons were issued returnable for August 02, 2016.
- Aggrieved by the long date given by the Single Judge, the appellants filed IA No.3675/2016 invoking Order 39 Rule 4 of the Indian Code of Civil Procedure, and thereafter, filed an application seeking review of the order dated February 10, 2016, which was registered as RA No. 201/2016.
- The grievance of the Appellants in the appeal is with regard to the learned Single Judge not hearing the applications filed by the Appellants to vacate the ex-parte ad- interim injunction and mandate of law requiring an endeavor to be made to decide applications seeking injunction and if ex-parte injunction is granted, to decide applications seeking vacation thereof within 30 days as stipulated by



the Code of Civil Procedure.

**CONTENTIONS OF THE APPELLANT (TEVA API INDIA PVT. LTD.)**

- That the appellants were indeed manufacturing the allegedly offending product, but the same was being done purely for the purposes of R&D. The exports were also admitted but it was pleaded that the exports were being made to submit the product and the data to the regulatory authorities around the world, so that when the patent expired, the appellants could market the product. Exemption was thus claimed under S. 107A of the Indian Patents Act, 1970.
- That the law mandates that where an ex parte ad interim injunction is made, the Court must try and decide the application seeking vacation of the same within 30 days, and hence the date of August 2, 2016 given by the Single Judge is arbitrary and unjustified.

**CONTENTIONS OF THE RESPONDENT (MERCK SHARP & DOHME CORP)**

- That the appellants are manufacturing and selling the patented product of the respondents. The injunction prayed for is to restrain the appellants from manufacturing or selling in any manner Sitagliptin or any of its pharmaceutically acceptable salts. Therefore, the grant of ad interim injunction is justified.
- That a Court has the jurisdiction to grant an injunction before a wrong is committed in order to stop it from happening and a quia timet action would lie against the appellants.

**DECISION OF THE DIVISION BENCH OF THE DELHI HIGH COURT**

- That the learned Single Judge ought to have made an attempt to decide the interim applications expeditiously, especially keeping in mind that an ex-parte ad-interim order was issued. The applications filed by the appellants simply stated that the offending goods were exported, not by way of a commercial sale, but to obtain regulatory approval in the countries abroad, and this aspect of the matter only required a short and a crisp hearing not lasting beyond 15-20 minutes. It was held that the learned Single Judge had only to see the documents presented by the two groups.
- That the continuation of the injunction granted is not causing any injuries to the appellants because the marketing authorization which they require would at best take 2-3 years, and the respondents' patent would lapse in the year 2022.



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A D V O C A T E S

- That since the appellants have not even filed their written statement, and adjudication of the injunction application requires a perusal of the documents filed by the parties, within a week the appellants shall file their written submission along with the documents relied upon. Within three weeks thereafter, the respondents shall file the replication along with such further documents which the respondents desire.

The Division of the Delhi High Court, disposed off the appeal as above and remanded the matter back to the Single Judge for adjudication of the interim applications. The next date of hearing fixed before the Single Judge is July 8, 2016.

317, Lawyers' Chambers, High Court Delhi, New Delhi 11000. India  
t: 91-11 - 3056 2000, 2338 4491 f: 91-11 - 3056 2010, 2338 6201 e: ssrana@ssrana.com  
w: www.ssrana.in

NEW DELHI

NOIDA

KOLKATA

MUMBAI

CHENNAI