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

+ FAO(OS) (COMM) 159/2023 & CM APPL. 39175/2023 (Interim Stay), CM APPL. 39176/2023(Ex. Filing Suit Record & Summoning of Suit Record), CM APPL. 39177/2023(Addl. Document)

VIFOR (INTERNATIONAL) LIMITED & ANR.

..... Appellants

Through: Mr. Kapil Sibal, Sr. Adv., Mr. Rajiv Nayar, Sr. Adv. and Mr. Sandeep Sethi, Sr. Adv. along with Mr. Pravin Anand, Ms. Vaishali Mittal, Mr. Rohin Koolwal, Ms. Manisha Singh and Mr. Hersh, Advs.

versus

MSN LABORATORIES PVT LTD & ANR. .... Respondents

Through: Mr. Chander M. Lall, Sr. Adv along with Mr. J Sai Deepak, Mr. G. Nataraj, Mr. Shashikant Yadav, Mr. Rahul Bhujbal and Ms. Ananya Chugh, Advs.

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+ FAO(OS) (COMM) 160/2023 & CM APPL. 39195/2023 (Interim Stay), CM APPL. 39196/2023(Ex. Filing Suit Record & Summoning of Suit Record), CM APPL. 39197/2023(Addl. Document)

VIFOR INTERNATIONAL LTD & ANR. .... Appellants

Through: Mr. Kapil Sibal, Sr. Adv., Mr. Rajiv Nayar, Sr. Adv. and Mr. Sandeep Sethi, Sr. Adv. along with Mr. Pravin Anand, Ms. Vaishali Mittal, Mr. Rohin Koolwal, Ms. Manisha Singh and Mr. Hersh, Advs.

versus

CORONA REMEDIES PVT LTD & ANR. .... Respondents

Through: Ms. Rajeshwari H. along with Mr. Tahir AJ and Ms. Garima Joshi, Advs.

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+ FAO(OS) (COMM) 161/2023 & CM APPL. 39199/2023

(Interim Stay), CM APPL. 39200/2023(Ex. Filing Suit Record & Summoning of Suit Record), CM APPL. 39201/2023(Addl. Document)

VIFOR INTERNATIONAL LTD & ANR. .... Appellants

Through: Mr. Kapil Sibal, Sr. Adv., Mr. Rajiv Nayar, Sr. Adv. and Mr. Sandeep Sethi, Sr. Adv. along with Mr. Pravin Anand, Ms. Vaishali Mittal, Mr. Rohin Koolwal, Ms. Manisha Singh and Mr. Hersh, Adv.

versus

DR REDDYS LABORATORIES LTD ..... Respondent

Through: Mr. Chander M. Lall, Sr. Adv along with Mr. J Sai Deepak, Mr. G. Nataraj, Mr. Shashikant Yadav, Mr. Rahul Bhujbal and Ms. Ananya Chugh, Adv.

**CORAM:**

**HON'BLE MR. JUSTICE YASHWANT VARMA**

**HON'BLE MR. JUSTICE DHARMESH SHARMA**

**ORDER**

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**10.08.2023**

**FAO(OS) (COMM) 159/2023 & CM APPL. 39176/2023(Ex. Filing Suit Record & Summoning of Suit Record), CM APPL.**

**39177/2023(Addl. Document);**

**FAO(OS) (COMM) 160/2023 & CM APPL. 39196/2023(Ex. Filing Suit Record & Summoning of Suit Record), CM APPL.**

**39197/2023(Addl. Document);**

**FAO(OS) (COMM) 161/2023 & CM APPL. 39200/2023(Ex. Filing Suit Record & Summoning of Suit Record), CM APPL.**

**39201/2023(Addl. Document)**

1. Notice. Let the noticed respondents file their replies, if so chosen and advised, within a period of two weeks,. The appellants shall have a week thereafter to file their rejoinder affidavits.

2. Let the appeals be put down on 04.09.2023 in the category of "End of Board".

**CM APPL. 39175/2023 (Interim Stay) in FAO(OS) (COMM) 159/2023;**

**CM APPL. 39195/2023 (Interim Stay) in FAO(OS) (COMM) 160/2023;**  
**CM APPL. 39199/2023 (Interim Stay) in FAO(OS) (COMM) 161/2023**

1. Having heard Mr. Sibal, learned senior counsel appearing for the appellants, Mr. Lall, learned senior counsel and Mr. Deepak, learned counsel appearing for respondents in FAO(OS) (COMM) 159/2023 and FAO(OS) (COMM) 161/2023, we prima facie find that the following issues arise for our consideration in the present appeals. The product in question has been conferred an **International Non-proprietary Name<sup>1</sup> Ferricum Carboxymaltose<sup>2</sup>**. The said assignment of an INN to the product has also been accepted by the **World Health Organisation<sup>3</sup>**. The plaintiff/appellant has held the patent in various countries since 2007. As would be evident from the applications that were filed before the Patent Office in India, Claim No. 1 was for a product while Claim Nos. 2 to 6 were for a process. The respondents at today's hearing were unable to dislodge the claim of novelty insofar as FCM as a product is concerned. It was also not their case that FCM was known in or discoverable from prior art. We thus, prima facie, find ourselves unable to concur with the learned Single Judge who has understood it to be a product by process patent alone.

2. We also take note of Clause 7.9 of the **“Guidelines for Examination of Patent Applications in the Field of Pharmaceuticals”** framed by the Office of the Comptroller General of Patents, Design and Trademarks, October, 2014 which reads thus: -

**“7.9 Product-by-process claims:**

A claim to a product obtained or produced by a process is anticipated by any prior disclosure of that particular product *per se*, regardless of its method of production. In a product-by-process claim, by using only process terms, the applicant seeks rights to a

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<sup>1</sup> INN

<sup>2</sup> FCM

<sup>3</sup> WHO

product, not a process. The IPAB held in ORDER No. 200/2012 “.....product-by-process claims must also define a novel and unobvious product, and that its patentability cannot depend on the novelty and unobviousness of the process limitations alone. Therefore, the patentability of a product by process claim is based on the product itself if it does not depend on the method of production. In other words, if the product-by-process claim is the same as or obvious from a prior product, the claim is un-patentable even if the prior art product was made by a different process. Accordingly the product by process claim must define a novel and unobvious product and the patentability in such claim cannot depend on the novelty and un-obviousness of the process limitation alone”.

Therefore, in product-by-process claims, the applicant has to show that the product defined in process terms, is not anticipated or rendered obvious by any prior art product. In other words the product must qualify for novelty and inventive step irrespective of the novelty or inventive step of the process.”

3. We, in light of the above, find ourselves at this stage unable to sustain the conclusions that have ultimately come to be recorded by the learned Single Judge in paragraphs 66-67 in terms of which a conclusion has come to be recorded that Indian Patent No. 221536 was a product by process claim alone.

4. The grievance of the appellants further is that the impugned judgment has come to be rendered after more than seven months as a consequence of which various technical documents which had been relied upon have neither been taken into consideration nor noticed. These are detailed in Para-II of the Note which has been placed for our consideration. We are further of the opinion that the conclusions recorded in Para 71 to 73 would also not sustain when one bears in mind the allegations made in the plaint as well as the filings before the Patent Office.

5. We note that during the pendency of the proceedings before the learned Single Judge, a statement was made on behalf of the respondents in FAO (OS) (COMM) 159/2023 and FAO (OS) (COMM) 161/2023 that they would not commence the launch of their competing products till the matter is decided. The patent itself is to

expire on 20 October 2023.

6. We thus take on board the prayer made by learned counsels for respective parties for these appeals being placed for expeditious disposal.

7. Accordingly and for the reasons assigned hereinabove, we stay the operation and effect of the impugned directions contained in paragraph 113 of the impugned order dated 24 July 2023.

8. The applications shall stand disposed of.

**YASHWANT VARMA, J.**

**DHARMESH SHARMA, J.**

**AUGUST 10, 2023**

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