

# Sotefin Sa vs Indraprastha Cancer Society And ... on 15 September, 2021

**Author: Sanjeev Narula**

**Bench: Sanjeev Narula**

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\* IN THE HIGH COURT OF DELHI AT NEW DELHI  
+ CS(COMM) 327/2021 & I.As. 8544/2021 and 11697/2021.  
SOTEFIN SA ..... Plaintiff

Through: Mr. Chander M. Lall, Senior  
Advocate with Mr. Monish Panda,  
Mr. Bhavin Gada, Ms. Ayush  
Sharma, Ms. Mehak Gupta, Mr.  
Prabjot Hora and Ms. Priyamwada  
Sinha, Advocates.

versus

INDRAPRASTHA CANCER SOCIETY  
AND RESEARCH CENTER & ORS. .... Defendants

Through: Mr. Neeraj Malhotra, Senior  
Advocate with Ms. Mansi Bajaj, Mr.  
Nitin Prakash, Mr. Saksham Mishra,  
Mr. Nimish Kumar and Mr. Ujjaval  
Kumar, Advocates for D-1 and D-2.  
Mr. S.D. Singh, Advocate for D-3.  
Mr. Saikrishna Rajagopal, Advocate  
with Ms. Deepshikha Malhotra, Mr.  
Dhavish Chitkara, Ms. Julien George  
and Mr. Skanda Shekhar, Advocates  
for D-4 alongwith Mr. Raghav  
Mundhra (Director & AR of D-4).

CORAM:  
HON'BLE MR. JUSTICE SANJEEV NARULA  
ORDER

% 15.09.2021  
[VIA VIDEO CONFERENCING]

I.A. 11759/2021 (u/O 1 Rule 10 r/w 151 CPC seeking deletion/striking of the Defendant No. 3 from the array of parties)

1. Issue notice. Mr. Monish Panda, Ms. Mansi Bajaj and Ms. Deepshikha Malhotra, Advocates, accept notice on behalf of the Plaintiff, Defendants No. 1-2, and Defendant No. 4, respectively. Reply by the non-applicants, if required, be filed before the next date of hearing I.A. 8543/2021 (u/O. 39 Rules 1 and 2 r/w Section 151 CPC 1908 seeking grant of ex-parte ad-interim injunction)

2. The Plaintiff has filed the present suit for infringement of Indian Patent No. 4214088, titled "carriage for the horizontal transfer of Motor Vehicles in automatic machinal car parks" [hereinafter, 'suit patent'] asserting exclusive rights of use under an exclusive license. The grievance of the Plaintiff, inter alia, is that Defendant No. 4 is operating/installing an automatic car parking machine - referred to as "smart dollies" at the premises of Defendant Nos. 1 and 2, which is infringing the Plaintiff's suit patent [hereinafter, 'Defendants' product'].

3. During the course of arguments, Mr. Saikrishna Rajagopal, counsel for Defendant No. 4, on instructions, states that the Defendant's product(s), which is lying/ installed at the premises of Defendant Nos. 1 and 2, does not infringe Plaintiff's suit patent. He further states that the Court may appoint a Local Commissioner/ Technical Expert/ independent Scientific Adviser [hereinafter, 'scientific expert'], to inspect the Defendants' product; compare the same with the claims made by the Plaintiff in respect of the suit patent and submit a report to this Court.

4. Mr. Neeraj Malhotra, Senior Counsel for Defendant Nos. 1 and 2 also confirms that Defendants' product lying/ installed at their premises does not infringe Plaintiff's suit patent. He further supports Mr. Saikrishna's request for appointment of a scientific expert.

5. Mr. Chander M. Lall, Senior Counsel for the Plaintiff, controverts the assertions made by the Defendants, but at the same time, states on instructions, that Plaintiff is also agreeable to the appointment of a scientific expert, since the stand of the Defendants qua denial of infringement is not clearly evident from the pleadings on record, it is directed that Defendant Nos. 1, 2 and 4 shall file an affidavit confirming the statement made by their counsel to the effect that the Defendants' product does not infringe the Plaintiff's suit patent.

6. Further, taking note of technical intricacies involved in the adjudication of the present application, the Court deems it fit to get the opinion of a Scientific Advisor. Accordingly, the Director, Indian Institute of Technology, Delhi is directed to appoint an appropriate expert from the relevant field of technology i.e., with respect to the patent in question, to act as the Scientific Advisor and assist the Court in determining certain questions of fact, as detailed hereinafter.

#### Purpose

(i) The Advisor so appointed shall examine the patent claims [including system, methodology, process, apparatus and any other specification that the Advisor deems appropriate] and compare the same with the Defendant's, i.e., the dollies installed/lying at the premises of Defendants No. 1 and 2, which are allegedly infringing the Plaintiff's suit patent. The date of visit to the premises of Defendant Nos. 1 and 2 shall be determined by the Advisor in consultation with the counsel for the parties.

(ii) The Advisor shall compare and map the Defendant's product against the claims of Plaintiff's suit patent, and give their opinion, in the form of a report, on the following aspects:

- a. Whether all the features of the Plaintiff's suit Patent as mentioned in Claim 1 are found in the Defendants' product as installed/lying in the premises of Defendant Nos. 1 and 2?
- b. What are the overlaps, in technology/ mechanism and the apparatus used, between the Defendants' product and the Plaintiff's suit patent?
- c. How is the process, apparatus and system used in the Plaintiff's patent different from the process, apparatus and system of the Defendants' product, i.e., whether the Defendant's products fall within the claims of the Plaintiff's patents. d. Whether the supporting means in Defendants' carriage has elements that are dissimilar to claims in Plaintiff's suit patent in terms of their parts and their method of operation? e. Whether the Defendants' product has the same mechanism of engagement with the motor vehicle as described in Claim No. 2 of the suit patent, if so, what are the elements of engagement? If not, what are the elements of disengagement?
- f. Whether the electronic device/mechanism for detecting the presence of the wheel of the motor vehicle and movement of the carriage are also present in the Defendants' product? g. Are there any differences in the Defendants' carriage and the electronic/mechanical devices as described in the Plaintiff's claims for the suit patent?
- h. Whether the claim comparison given by the Plaintiff in the suit is accurate. i.e., whether any claims set out in the patent are found to be in violation by the Defendants. Each claim has to be analysed separately for infringement.
- i. Any other aspect that the Advisor deems it fit to report upon.

#### Presence of Parties' Experts & Cooperation

(iii) At the time of inspection, experts on behalf of all the parties are permitted to remain present; they shall however not give any instructions to the Advisor or attempt to influence them in any manner. The Advisor shall however be free to seek any clarification, if required for the purpose of carrying out the inspection and forming his opinion. A complete conspectus of the same shall be expressly mentioned in the Advisor's report.

(iv) Prior to the inspection, the Plaintiff shall hand over to the Advisor the complete copy of suit patent along with relevant documents relating thereto, which include its claims, drawings and diagrams, and further furnish such documents, whether prior, during or after the inspection, as may be required by the Advisor for the purpose of making their report.

(v) The Advisor, if required, may give an opportunity to the parties to make a short presentation for the purpose of explaining their products/technologies. The same must however be done on the appointed day at the appointed venue and in the presence of experts/representatives of the opposite parties.

(vi) The Advisor shall be permitted to make drawings, diagrams, take photos, videos, and/or copies of documents of either parties' technologies, as required to ensure that their report is clear and complete. Such diagrams, drawings, photos videos, and/or copies of documents shall be annexed to the report.

(vii) The Defendants shall extend full cooperation and ensure that the Advisor is able to examine the Defendants' product- dolly(ies) without any hindrance. The Advisor shall be permitted to open the dolly(ies) and its components, for making the comparison, if so required.

(viii) For the purpose of giving the opinion, the Advisor will consider the claims, read along with detailed description and also the drawings/diagrams annexed with the patent certificate. Miscellaneous

(ix) The fee of the Advisor is fixed at One Lakh Rupees, which shall be jointly paid by Plaintiff and Defendant Nos. 1, 2 and 4 equally (i.e., except Defendant No. 3).

(x) The Advisor's report shall be furnished to the Court within a period of four weeks from today and copies thereof, shall be circulated amongst all the parties.

7. The statements made by Mr. Saikrishna and Mr. Malhotra, are taken on record and their respective clients shall remain bound by the same. In the event any statement is found to be untrue, the consequence in law shall follow.

8. It has been pointed out by the Defendants that the dollies carry product warranty which becomes void in case the same are opened without permission. It is, therefore, clarified that in the event, the Defendants suffer any loss on account of the machine being opened for the purpose of carrying out the inspection by the Defendants' product and the warranty claim becoming void as a result thereof, the Plaintiff shall compensate the Defendants for any such loss, which shall not be more than the actual cost of the dolly(ies). The cost of the dolly(ies) shall be intimated to the Plaintiff, with requisite proof of purchase/ invoice etc within one week from today. The plaintiff shall, however, not be liable to pay for warranty if infringement is found.

9. Re-notify on 27th October, 2021.

10. The Registry is directed to send a copy of this order to the Director, IIT for compliance.

SANJEEV NARULA, J SEPTEMBER 15, 2021 nd