

# Novartis Ag & Ors vs Natco Pharma Limited on 21 February, 2019

**Author: Jayant Nath**

**Bench: Jayant Nath**

\$~OS-21

\* IN THE HIGH COURT OF DELHI AT NEW DELHI

+ CS(COMM) 62/2019

NOVARTIS AG & ORS. . . . . Plaintiffs  
Through Mr.Gopal Subramaniam, Sr. Adv.  
with Mr.Hemant Singh, Ms.Mamta Jha, Dr. Shilpa  
Arora, Mr. Pavan Bhushan, Ms.Hima Lawrence  
and Ms.Ujwala Uppaluri, Advs.

versus

NATCO PHARMA LIMITED . . . . . Defendant  
Through Mr.Sanjeev Sindhvani, Sr. Adv. with  
Ms.Rajeshwari H., Mr.Saif Rahman Ansari,  
Mr.Chitranshu Kumar and Ms.Swapnil Gaur,  
Advs.

CORAM:

HON'BLE MR. JUSTICE JAYANT NATH  
ORDER

% 21.02.2019

1. This application is filed by the plaintiffs under Section 151 CPC seeking the following prayers:-

"a. Defer the reference of matter to scientific expert for his opinion till completion of pleadings and hearing of submissions of the parties;

b. If necessary, appoint a scientific expert from the panel of experts submitted by the Plaintiffs and Defendant which will contain full description of their qualifications;

c. frame a question which may be answered by the scientific expert in terms of paragraph 4 stated hereinabove and reproduced herein below:

"Whether or not the Defendant's product VALSAC on the basis of the description in the Defendant's packaging and Patient Information Leaflet comprises the following: (Claim 1 of Suit patent -IN 229051)

1. A pharmaceutical composition comprising

(i) the AT 1-antagonist valsartan or a pharmaceutically acceptable salt thereof and

(ii) N-(3-carboxy-1-oxopropyl)-(4S)-p-phenylphenylmethyl)-

4 - a m i n o - 2 R - m e t h y l b u t a n o i c a c i d e t h y l e s t e r o r N - ( 3 - c a r b o x y - 1 -  
oxopropyl)-(4S)-p-phenylphenylmethyl)-4-amino-2 R- methylbutanoic acid or a pharmaceutically  
acceptable salt thereof and a pharmaceutically acceptable carrier."

2. I have heard learned senior counsel for the plaintiffs and learned senior counsel for the defendant.

3. As far as the issue of Scientific Expert is concerned, learned senior counsel for the plaintiffs had submitted that the appointment may be deferred till the adjudication of the application for injunction which has already been fixed by this court for hearing on 28.02.2019. Alternatively, it was suggested that a scientific expert from the panel of experts submitted by the plaintiffs and defendant should be appointed and the name of the expert earlier appointed be changed.

4. Learned senior counsel for the defendant had opposed this prayer of the plaintiffs. However, after some arguments, he suggested that this court may modify the name of the Expert already appointed by order dated 06.02.2019 and may choose anybody from the Roll of Experts as stipulated under Rule 103 of the Patent Rules.

5. In my opinion, the Expert has already been appointed in exercise of powers under Section 115 of the Patent Act, I see no reason to defer the appointment. As far as the name of the expert is concerned, I accept the contention of the learned senior counsel for the defendant to appoint an expert from the Roll of Experts stated in Rule 103 of the Patent Rules. I accordingly modify the order dated 06.02.2019 and appoint Sh.Rajendra Prasad, C-89, Mansarovar Garden, New Delhi-110015, drrajendra@gmail.com, 011-25446234, 011-45630873, 9810096099 as an Expert Advisor.

6. The next issue is about framing of the question which needs to be answered by the Scientific Expert. I have heard the various suggestions of the learned senior counsel for the parties. In my opinion the following question be framed for the answer by the learned Scientific Expert. The following question is referred for opinion of the learned Scientific Expert:-

"Q. Whether in the opinion of the learned Expert defendant's product described as a complex as given in para 10 of the patient information leaflet is encompassed or subsumed by claim 1 of suit patent:

"1. A pharmaceutical composition comprising

(i) the AT 1-antagonist valsartan or a pharmaceutically acceptable salt thereof and

(ii) N-(3-carboxy-1-oxopropyl)-(4S)-p-phenylphenylmethyl)-

4 - a m i n o - 2 R - , m e t h y l b u t a n o i c a c i d e t h y l e s t e r o r N - ( 3 - c a r b o x y - l - o x o p r o p y l ) - ( 4 S ) - p - p h e n y l p h e n y l m e t h y l - 4 - a m i n o - 2 R - m e t h y l b u t a n o i c a c i d o r a p h a r m a c e u t i c a l l y a c c e p t a b l e s a l t t h e r e o f a n d a p h a r m a c e u t i c a l l y a c c e p t a b l e c a r r i e r . ? " "

7. The fees of the Expert is fixed at Rs.3 lakhs to be shared by the parties.

8. The Expert is requested to expeditiously give his opinion preferably within two weeks from the receipt of the documents.

9. Needless to say, this order is passed without prejudice to the rights and contentions of the parties.

10. In view of the above, the present application stands disposed of.

1. By this application the grievance of the defendant is that the plaintiffs are giving publicity/issuing communications in the public, etc. regarding the pendency of the present suit.

2. Learned senior counsel appearing for the plaintiffs has denied any such act.

3. Learned senior counsel for the plaintiffs also states that in view of the continued undertaking given by the learned counsel for the defendant, the plaintiff shall not in any case give any publicity or issue communication to the public during the pendency of the present suit.

4. The application stands disposed of.

1. By this application, the defendant seeks permission to submit its reply along with the relevant documents to the concerned Expert appointed by this court.

2. Let a copy of the entire documents filed by the plaintiffs be sent to the Expert to enable him to give his opinion on the question that has been framed. The Registry may send a copy of this order to the Expert along with the entire photocopy of the documents only filed by the plaintiffs. (Pleadings are not to be sent). The copies of the said documents be also sent by e-mail, if possible.

3. This application stands disposed of.

CS(COMM) 62/2019 and IA No. 1803/2019 The date of 28.02.2019 is cancelled.

List on 11.03.2019.

A copy of this order be given dasti under the signatures of the Court Master.

JAYANT NATH, J FEBRUARY 21, 2019/rb