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PATENTS – SUIT FOR PERPETUAL INJUNCTIVE RELIEF AFTER ACCEPTANCE OF COMPLETE SPECIFICATION

Plaintiff: Pfizer Products Inc., through Authorized Signatory and two others

Defendant: Hilton Pharma (Pvt) Ltd., through Chief Executive / Director / Secretary / Principal Officer

Decision: Suit not Maintainable, Plaintiff Rejected and Suit Dismissed

Plaintiff, after acceptance of its complete specification for patent, sought interim injunctive relief under s.22 of the Patents Ordinance, 2000 (**the Ordinance**) to restrain defendant from acting in any manner that would infringe the patent yet to be granted.

On being granted an ad-interim order on plaintiff's application for interim injunctive relief, defendant filed two applications one under Order VII Rule 11 of the Civil Procedures Code for rejection of plaintiff and the other for recalling the ad-interim order. The learned Judge of the High Court of Sindh after hearing the counsels of the respective parties in respect of Civil Miscellaneous Applications observed that a preliminary question has arisen with regards to the proper interpretation and application of s.22 of the Ordinance since its amendment in 2002 as no prior case law is available on the same. Since, the nature of interpretation of this section in fact is in the nature of a jurisdictional objection, the learned Judge instead of hearing the counsels on the merits of applications only heard them on considering the meaning and proper application of s.22 (reproduced hereunder).

s.22- "Effect of acceptance of complete specification---After the acceptance of an application and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the application:

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been sealed".

Contention of defendant was that proviso to s.22 barred institution of such proceedings. The learned Judge observed that s.22 sought to place the applicant in the same position as a patentee which was clear from the words "like privileges and rights" used in the said section however, an applicant was not the patentee, as application could be defeated and patent, either in part or wholly, could be refused. Therefore s.22 had a proviso, the purpose of which was to highlight that notwithstanding that applicant being granted "like privileges and rights" however, he was yet not the patentee. Right was undoubtedly created by virtue of acceptance of the application under s.21 of the Ordinance but the remedy to which the right holder would be entitled to, was to be regulated and controlled. The proviso to s.22 therefore, carved out an exception from the main provision and nature of such exception was that it affected the remedies but not the rights and a distinction existed between a right and remedy. The proviso does not nullify the main provision but only limited the main provision in the sense that remedies were deferred.

Plaintiff sought reliance on s.67(4) of the Ordinance as well.



s.67(4) "Proceedings for a declaration may be brought by virtue of this section at any time after the date of the publication of the complete specification in pursuance of an application for a patent, and references in this section to the patentee shall be construed accordingly".

Plaintiff pleaded that the proviso cannot take away what has been granted by the main provision itself and the first proviso of original s.22 (prior to its amendment in 2002) balanced with s.67(4) as it puts the person referred to in s.67(4) in the same position as the person dealing with sealed patent. Defendant pleaded that s.22 should be interpreted as it stood. The learned Judge observed that s.67(4) of the Ordinance after insertion of amendment to s.22 of the Ordinance was now an anomaly, was effectively redundant and could not be used to give to the proviso of s.22, a different meaning to what it clearly and naturally had. Plaintiff was therefore not entitled to any interim relief due to the clear bar of proviso s.22 of the Ordinance.

Consequently, application for grant of interim injunction in the circumstances was dismissed and suit being not maintainable, was rejected.

