

Decoding the Judgment in Vifor v. MSN: Delhi High Court lays down the law on product by process claims

In a significant recent judgment, the Delhi High Court in *Vifor (International) Limited & Anr. v. MSN Laboratories Pvt Ltd & Anr.* has laid down the law on product by process claims. In a judgment delivered on 24th July, 2023, Justice Jyoti Singh had held that the scope of protection for a product by process patent is circumscribed to the process by which the product in question was obtainable, as stated in its claims. Differently stated, it was open to defendants to produce the same product through a different process without being found liable for patent infringement.

In a detailed and carefully reasoned judgment, the Division Bench overturned this opinion. It held that the sole distinguishing feature of a product by process patent, as compared to a simpliciter product patent, is that the product in question is not definable without the given process. The stated process, therefore, is the only pathway through which the given product can be defined. That, however, the Court held, cannot mean that the scope of protection should be confined to that of a process claim. This is because, even for the grant of a product by process claim, the patentee must establish the novelty of the product as compared to the prior art from the standpoint of a person skilled in the art. Absent this showing, the product in question is not patentable. The reference to the process in the patent application is only as an aid to understand the novel attributes of a new product unknown in the prior art. If this be so, pruning down the scope of protection to the product, as obtainable through the given process, for the purpose of evaluating a claim of infringement would be anomalous and unjust.

The Court was also at pains to underscore that a consistent criterion must be deployed at the stage of examination of a patent application and while assessing claims of patent infringement. It held that there cannot be ‘shifting lines’ of protection, one which would ‘imbue the examination process’ and a completely ‘distinct and discordant’ test for infringement. It cited with approval the judgment of the England and Wales High Court in the case of *Hospira UK Limited v. Genentech Inc* which had characterized product by process claims as being founded on the need to strike a balance between ‘clarity and fairness’ on the one hand and according a leeway in the ‘limited class of cases’ in which the patentee is unable to identify a characteristic or parameter other than by way of an “obtainable by” process definition. The UK court had laid down the test, for evaluating such claims, as being whether ‘a characteristic or attribute is discernible from claims

structured in product-by-process terms'. The Division Bench affirmed this test as being a 'reasoned, just and balanced' threshold to examine claims made in such patents.

With a view to balancing the need to incentivize novelty in inventions and the public interest, the Division Bench further held that such product-by-process claims are permissible when the given structures are indefinable at the time of patent filing and an applicant is constrained to resort to process terms in order to render sufficient clarity on the inventive qualities of the claimed product. On the facts, while the Court did not grant an interim injunction to the patentee as the patent term had expired, it left it open for the patentee to press its claim for deposit of percentage of sales made by the defendants and directed the continuation of the lawsuit subject to the legal position outlined by it. Further, the Court also kept all other objections and defences taken by the defendants open which may be pursued in the pending lawsuit.

In conclusion, the Division Bench's judgment provides perhaps the closest test to a bright line for understanding product by process claims and is likely to have profound and far-reaching ramifications in patent law.