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

% **Date of decision: 27th August, 2024**

+ CS(COMM) 606/2024 & I.A. 34122/2024, I.A. 37430/2024

ABBOTT GMBH & ANR.

.....Plaintiffs

Through: Mr. Anirudh Bakhru, Ms. Gunjan Paharia, Mr. Naqeeb Nawab, Ms. Sejal Tayal, Ms. Apurva Bhutani, Mr. Ashutosh Ranga, Ms. Vijay Laxmi Rathi, Advocates (M:9999471233)
Email:info@zeusip.com

versus

MANKIND PHARMA LIMITED & ANR.

.....Defendants

Through: Mr. Rajiv Nayar, Sr. Adv. with Mr. Hemant Daswani, Ms. Saumya Bajpai, Ms. Pranjal, Mr. Kunal Prakash, Advocates (M:9810556744)


CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA


MINI PUSHKARNA, J (ORAL)

1. The present suit has been filed for permanent injunction restraining infringement of trademarks and passing off, dilution, tarnishment, unfair competition, delivery up, damages and rendition of accounts.
2. The present suit essentially relates to defendant no.1's adoption and



offending use of the trade dress “” for its product, being tablets containing the ingredients “thyroxine sodium” under the mark “THYRONEED”, used for the purpose of selling hypothyroidism tablet, which are identical and/or deceptively similar to the plaintiff’s prior THYRONORM products, bearing the distinctive pink and white colour



combination, and pink and white bottle “”. Thus, the present suit has been filed on the ground that the use of the impugned trade dress by the defendant no.1, amounts to infringement and passing off/violation of plaintiff’s statutory and common law rights in their prior, registered and famous pink and white colour combination, and pink and white colour bottle for its THYRONORM products.

3. When the matter was listed for hearing on 24th July, 2024, learned counsel for the defendants, who appeared on advance notice made a categorical statement that defendants have already stopped the use of the impugned trade dress and have adopted a new trade dress, which is totally distinct and different from the trade dress of the plaintiffs, and is blue and white in color. The new trade dress, as adopted by the defendants, is reproduced as under:



4. Subsequently, in terms of the order passed by this Court, two affidavits have been filed on behalf of the defendants, wherein, it is stated that the defendants have existing stock of 24,777 bottles, with pink and white color combination.

5. An affidavit of compliance has been filed on behalf of the defendants, wherein, the defendants have made a categorical statement, which is as follows:

“xxx xxx xxx

2) That pursuant to the directions of this Hon’ble Court, passed in the order dated July 24, 2024, I filed an affidavit dated July 26, 2024, on behalf of the Defendant No. 1, disclosing the statement of existing stock of the bottles of hypothyroidism tablets packaged under the pink and white trade dress (**“Impugned Trade Dress”**) and sold under the mark ‘Thyroneed’. I reproduce below the table (hereinafter referred as **Table A**) that formed a part of the said affidavit:

S.N O.	Material description	PACK	BATCH	MFG DATE	EXP DATE	QUANT ITY	VARIA NT	Quant ity
1	THYRONEED 12.5 TABLETS	120 TABS	W7ALW 001	May-23	Apr-25	5	OLD	9160
2	THYRONEED 25 TABLETS	120 TABS	W8ALW 003	Jul-23	Jun-25	20	OLD	4920
3	THYRONEED 50 TABLETS	120 TABS	W9ALW 002	Jul-23	Jun-25	9	OLD	3849
4	THYRONEED 75 TABLETS	120 TABS	X0ALW 001	Jun-23	May-25	5	OLD	4551
5	THYRONEED 100 TABLETS	120 TABS	X1ALW 002	Jul-23	Jun-25	4	OLD	2297
							TOTAL	24777



3) On noticing that the contents of table required more clarification, therefore, on July 30, 2024, I voluntarily filed a further affidavit dated July 30, 2024 to bring to the notice of the Hon'ble Court, a more detailed statement with respect to the stock of goods under the Impugned Trade Dress. Contents of the table (hereinafter referred as **Table B**) of the said affidavit are repeated herein. It is pertinent to mention, that in the present affidavit while reproducing Table B, I have added a further column which is serial number and corrected certain clerical errors in the expiry month/year. It is pertinent to mention here that the quantity of the old stock remains the same.

xxx xxx xxx

4) The existing stock of goods is available under 5 batch series namely W7 AL, W8AL, W9AL, X0AL and X1AL. Table A provided a summary report of the existing stock. Whereas Table B is more detailed and provided further information regarding manufacturing and expiry dates, along with the quantity of the bottles available of individual batches in the series.

xxx xxx xxx

7) The total quantities of the existing stock under the Impugned Trade Dress have been correctly stated in both the affidavits as 24,777 bottles.

8) I further state that the last batch of goods under the Impugned Trade Dress was manufactured by the Defendant No. 1 in May 2024, which was well before the present suit was filed by the Plaintiff. I state that the blue and white getup (new getup) was adopted by the Defendant No. 1 in June 2024. Copies of sample invoices evidencing transfer/ sale of goods under the new getup are collectively filed as **Document A**.

9) Lastly, I state that the Defendant No. 1 has already stopped manufacturing goods under the Impugned Trade Dress and it shall not manufacture any new goods under the impugned trade dress in future. I therefore pray before this Hon'ble Court to grant 6 months' time to my company to dispose of the goods under the impugned trade dress.

xxx xxx xxx”

6. Perusal of the aforesaid affidavit, categorically shows that the defendants have made an unequivocal statement that last batch of goods under the impugned trade dress were manufactured by defendant no.1 in May, 2024, before the present suit was filed by the plaintiffs. The aforesaid



affidavit also brings to the fore that blue and white getup has been adopted by defendant no.1 in June 2024. It is also categorically stated in the affidavit that defendant no.1 has already stopped manufacturing goods under the impugned trade dress, and it shall not manufacture any new goods under the impugned trade dress in future.

7. Considering the aforesaid affidavit on behalf of the defendants, this Court is of the view that the present suit can be decreed in favour of the plaintiffs, and against the defendants.

8. During the course of hearing, this Court had specifically put to the learned Senior Counsel for the defendants that the existing stock of 24,777 bottles, which has been mentioned in the affidavit of the defendants, shall be exhausted within a period of three months. Further, in case any further stock is left after three months, the same shall be withdrawn from the market.

9. However, learned Senior Counsel for the defendants, submits that once a stock is sold to the stockist, it further goes on to retailers from the stockist, and therefore, things are beyond the control of defendants. Therefore, it would be practically impossible for the defendants to withdraw the bottle of impugned trade dress, after they have already been released in the market.

10. Considering the submissions made by learned counsel for the defendants and also considering the concerns raised by learned counsel for the plaintiffs, this Court directs that defendants shall not release any further new stock of its product under the impugned trade dress of pink and white cap from today, i.e., 27th August, 2024, onwards.

11. The stock which has already been released by the defendants with the impugned trade dress till today, i.e., 27th August, 2024, shall be allowed to be exhausted.



12. All the existing stock of the bottles in the impugned trade dress of pink and white cap, which is lying with the defendants, shall be changed to the new trade dress of blue cap by the defendants. After changing the cap to blue color, as noted above, the defendants shall sell it in the market.

13. Learned counsel for the plaintiffs submits that in view of the undertaking given by the defendants of adopting a new trade dress with cap of the bottle being blue in color, and decree being passed, the plaintiffs are not pressing the prayer for rendition of accounts and also giving up other prayers, except prayer 'a' and 'b' of the prayer clause, in the plaint.

14. Accordingly, the present suit is decreed in favour of the plaintiffs and against the defendants in terms of prayer 'a' and 'b' of the prayer clause in the plaint.

15. Let decree sheet be drawn up.

16. In view of the fact that the present matter is being disposed of upon the undertaking of the defendants, and suit is at a nascent stage, it is directed that Registry shall issue a certificate for refund of full court fees to the plaintiffs.

17. The suit, along with pending applications, stands disposed of.

MINI PUSHKARNA, J

AUGUST 27, 2024

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