

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

+ **CS(OS) No. 336/2005**

**Date of Decision: 14.03.2013**

**GLAXOSMITHKLINE PHARMA LTD. ....Plaintiff**  
Through: Mr. Sushant Singh, Mr. P.C.  
Arya, Mr. V.K. Shukla & Ms.  
Geetika Kapoor, Advs.

Versus

**HIDUSTAN MEDIBIOTIC .....Defendant**  
Through: Nemo.

**CORAM:  
HON'BLE MR. JUSTICE M.L. MEHTA**

**M.L. MEHTA, J. (Oral)**

1. The plaintiff is engaged inter-alia in the manufacture, marketing and world-wide distribution of a wide-range of pharmaceutical, medicinal and veterinary preparations under various trademarks and copyrights. The present suit is with respect to the trademark **HITEK** and the copyright of the artistic work of the packing material/carton of the product. The plaintiff has contended that it is the proprietor of the said trademark and that the registration of the trademark is pending in the trademark registry vide application No. 1176779 in Class-5. The plaintiff has claimed to be the user of the said trademark since January 2003.

2. The plaintiff seeks permanent injunction against the infringement of copyright and passing off with respect to the plaintiff's packaging under the trademark **HITEK** in respect of pharmaceutical, veterinary and sanitary substances. The plaintiff has contended that the defendant is marketing its product **ITEK**, which is deceptively similar to the trade mark, packing carton, get-up, and colour scheme of the plaintiff's product.

3. The plaintiff has contended that it is using the said trademark **HITEK** in respect of Ivermectin Injection which is used for the treatment and control of internal and external parasites of cattle, sheep and camel. The HITEK injection is said to contain a combination of Ivermectin B.P. 10mg and Benzyl Alcohol I.P.85 15mg for each ml. The packing of the material/carton is contended to be the original artistic work of the plaintiff within the meaning of Sec. 29(c) of the Copyright Act, 1957. It is also contended that the plaintiff is the first person in India to have designed the said carton with the distinctive colour scheme, getup, layout and unique features. The description of the plaintiff's carton is as follows.

4. The carton has a white background with the upper portion of the carton containing the trademark **HITEK** in red colour enclosed inside a red rectangle. Above this, the words IVERMECTIN INJECTION are present in black colour. The middle portion of the carton has a white strip showing cattle, camel, cow and sheep. At the bottom portion, there is a line above which the descriptive matters and the name of the

manufacturing and marketing company are enclosed. The plaintiff claims to be the user of the said packing/carton since January 2003 and has annexed the carton as **Exhibit PW1/4**.

5. The plaintiff has contended that by virtue of extensive advertisement on a large scale, it has earned substantial reputation and good will in connection with the above trademark as well as carton. And that the purchasing public not only identifies the product of the plaintiff with the trademark **HITEK**, but also with the distinctive colour scheme, getup and layout of the carton. And that as a result, the plaintiff's product has earned an enviable goodwill and reputation due to its intrinsic and good quality.

6. The plaintiff has contended that in the last week of December 2004, it became aware through its representatives that the defendant has very recently started marketing and selling its Ivermectin Injection under the trademark **ITEK**. The plaintiff also became aware that the defendant's products were not only marketed with a deceptively similar trade mark, but also packaged in a carton having similar getup, colour scheme and layout with that of the plaintiff's packing carton. The plaintiff also contends that the defendant has consciously made a few minor changes in the packaging of its product, without changing the overall impact created in the minds of the purchasing public who recognize the pattern of the carton as being distinctive representation of the plaintiff's product.

7. The plaintiff has contended that the defendant has copied the trademark of the Plaintiff by simply removing the letter H from **HITEK** and adopting **ITEK** as their trademark, which is deceptively similar to the trade mark of the plaintiff. Further, the plaintiff has also contended that by using a deceptively similar packing/carton, the defendant has infringed the copyright of the plaintiff's packing/carton. It is also contended that the defendant is not disclosing where the product has been manufactured because the packing/carton only discloses the name of the firm. The plaintiff has also contended that the illegal and unauthorised imitation of the plaintiff's trademark as well as packing/carton is calculated to deceive the purchasing public into believing that the defendant's goods are those of the plaintiff or in some way connected with the plaintiff.

8. In this regard, the plaintiff has submitted that the cause of action arose during the last week of December, 2004 when the defendant's products were noticed for the first time in the market by the plaintiff's representative. It also submitted that the cause of action continues to subsist till such time the defendant is restrained by an order of injunction is passed by this Court. And the plaintiff has also submitted that this Court has the jurisdiction to entertain and try the present suit as the defendant is marketing its product in Delhi and is working for gain within the jurisdiction of this Court.

9. It is pertinent to note at this stage that vide IA 12540/2006 filed under Order XXII Rule 10 of CPC, the plaintiff has submitted that

during the pendency of this suit, the plaintiff has assigned the trade mark **HITEK** in favour of M/s. Virbac Animal Health India Pvt. Ltd.. Vide Order dated 21.02.2007, the substitution of the plaintiff as M/s. Virbac Animal Health Pvt. Ltd. has been allowed. Vide Order dated 20.05.2010, the opportunity to file Written Statement was closed and the matter was listed for ex-parte evidence.

10. Counsel for the Plaintiff has identified Ex. PW1/1 as the photocopy of the power of attorney dated 21.07.2003 in favour of Sh. K. Patel. He has also identified Ex. PW1/3 to be the copy of the acknowledgment against application for registration of trademark. And he has also identified Ex. PW1/4 to be the original carton of the plaintiff's product and Ex. PW1/5 to be the original carton of the infringing copy belonging to the defendant. He has also tendered that Ex. PW2/1 is the photocopy of the deed of assignment dated 31.07.2006. Ex PW1/2 is not placed on record.

11. In support of its contentions, the plaintiff has sought to rely on the decision of the Apex Court in the landmark case of ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.***, AIR 2001 SC 1952 (*Cadila Case*) and the decision of this court in the case of ***Remidex Pharma Pvt. Ltd. v. Savita Pharmaceuticals Pvt. Ltd. & Anr.***, 2006 (33) PTC 157 (Del.) (*Remidex Case*).

12. I have heard the submissions of the counsel for plaintiff and also compared the two cartons placed on record. I am of the view that that

the two cartons are substantially similar. The defendant's carton as placed on record as Ex. PW1/5 is nearly identical to that of the plaintiff's. The carton has a white background with the upper portion of the carton containing the trademark **ITEK** in red colour enclosed in a red rectangle. Above this are the words IVERMECTIN INJECTION in black colour. The middle portion of the carton has a white strip showing the outline of a cow, sheep and a camel. At the bottom portion, there is a line above which the descriptive matters and the name of the manufacturing and marketing company are mentioned as Hindustan Medibiotic. The composition of the injection is also the same as that of the plaintiff, containing a combination of Ivermectin B.P. 10mg and Benzyl Alcohol I.P.85 15mg for each ml.

13. With respect to the injunction which is sought for by the plaintiff, it is pertinent to take note of the observations of the Apex Court in the *Cadila Case*. The Apex Court, observing that confusion of source of product between medicinal products may produce physically harmful results to purchasers and greater protection is required than in the ordinary case, formulated the following test:

*“Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered:*

*a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.*

*b) The degree of resemblances between the marks, phonetically similar and hence similar in idea.*

*c) The nature of the goods in respect of which they are used as trade marks.*

*d) The similarity in the nature, character and performance of the goods of the rival traders.*

*e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.*

*f) The mode of purchasing the goods or placing orders for the goods and*

*g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks”*

14. Further, in the *Remidex Case*, this Court had examined a similar case with phonetically similar trademarks regarding medicinal drugs ‘ZEVIT’ and ‘EVIT’. The Court held:

*“Comparing the marks 'ZEVIT' and 'EVIT', I find that the prefixes 'ZE' and 'E' are phonetically quite similar. The suffix 'VIT' is common to both the marks and is, indeed, identical. The marks taken as a whole, therefore, include identical suffixes and quite similar prefixes, therefore, in my view, the inescapable conclusion is that the mark 'EVIT' is deceptively similar to the registered trademark 'ZEVIT' of which the plaintiff is the proprietor.”*

15. I have no doubt in my mind that defendants, by using such colour scheme and other features, have dishonestly adopted the artistic work of the plaintiff. I am further satisfied that the plaintiff is the prior user not only of the trademark **HITEK** and that the defendant's trade mark **ITEK** is intended to deceive the purchasing public. Since the Counsel for the plaintiff has stated that he is not willing to pursue the prayers regarding delivery-up of infringing goods and accounts therefore, I dispose of the suit by passing a decree of permanent injunction in favour of the plaintiff restraining defendant from passing off by manufacturing, selling, distributing Ivermectin Injections or other pharmaceutical, veterinary or sanitary substances under the trade mark **ITEK** using the colour scheme and getup of the packing/carton similar to that of the plaintiff.

**M.L. MEHTA, J.**

**MARCH 14, 2013**

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