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

Pronounced on: 10th April, 2023

+ CS(COMM) 8/2023

GLAXOSMITHKLINE PHARMACEUTICALS LTD.

..... Plaintiff

Through: Mr. Dushyant Mahant,
Mr.Urfee Roomi, Ms. Janaki Arun,
Mr.Alvin Antony and Mr.ritesh Kumar,
Advs.

versus

HORIZON BIOCEUTICALS PVT. LTD & ANR.

..... Defendants

Through: Mr. Vikas Khera, Mr. Vishal K.
Sharan, Mr. Ved Prakash and Mr. Niladri
Bagchi, Advs. for R-1

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

J U D G M E N T

10.04.2023

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I.A.351/2023 (under Order XXXIX Rules 1 and 2 of the CPC)

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1. COBADEX is registered, under the Trade Marks Act, 1999, as a word mark in favour of the plaintiff in Class 5, for pharmaceutical goods, with effect from 18th July 1958. The plaintiff alleges that the defendant is using the mark COMODEX which infringes the plaintiff's registered COBADEX mark. The fact that the defendant

uses the tag-on 'PLUS', with COMODEX, according to the plaintiff, makes no difference. The infringement remains.

2. The plaintiff alleges that the infringement is compounded by the use, by the defendant, of a trade dress which is identical to the trade dress of the plaintiff. These are the rival trade dresses, as provided with the plaint:

Plaintiff's Pack	Defendant's Pack
	

I will be referring, in this order, to these packs as “Pack 1” of the plaintiff and the defendant respectively.

Rival Submissions

3. Submissions of Mr. Dushyant Mahant:

3.1 Mr. Dushyant Mahant, learned Counsel for the plaintiff submits that the trade dress, as well as the brand name, of the defendants' product are so deceptively similar to those of the plaintiff that they disclose a clear case of bad faith adoption, both structural as well as phonetic.

3.2 The plaintiff is, therefore, according to Mr. Mahant, entitled to an injunction against the defendant using the impugned COMODEX mark or the afore-represented Pack 1 trade dress. *Res*, as Mr. Mahant would submit, *ipsa loquitur*.

4. Submissions of Mr. Vikas Khera, by way of reply

4.1 Appearing for the defendants, Mr. Vikas Khera, learned Counsel, submits that the COMODEX PLUS Pack 1, which, according to the plaintiff, adopts a trade dress which is deceptively similar to that of the plaintiff, has been discontinued and is no longer been used by his client. Nor, he submits, would his client use the said packaging during the course of the present proceedings. As such, Mr. Khera submits that the grievance of the plaintiff with respect to Pack 1 does not survive for consideration, at least at the Order XXXIX stage.

4.2 Mr. Khera has also advanced certain further submissions with respect to the manner in which Pack 1 came to be adopted and used by the defendant. He also submits, among other things, that the plaintiff has not placed, on record, any credible material to indicate that, in 2018, when the defendant did start using Pack 1, the plaintiff's product was being sold in the market in the plaintiff's Pack 1. Though Mr. Mahant seeks to contend that, in fact, even in proceedings initiated by the defendant, against the plaintiff under Section 57 of the Trade Marks Act before the Registrar of Trade Marks, the defendant has relied on Pack 1, nonetheless, as Mr. Khera has submitted that the defendants are neither packaging their product in Pack 1 at present nor

intend to do so in future, I do not deem it necessary to examine the plaintiff's contention that Pack 1 adopts a trade dress which was deceptively similar to that of the plaintiff. Order XXXIX of the CPC concerns itself with the future, not the past.

4.3 The plea of trade dress similarity, as urged by Mr Mahant, therefore, stands disposed of accordingly.

4.4 The only issue that survives for consideration is, therefore, whether the plaintiff is entitled to an injunction against the use, by the defendants, of the COMODEX mark, with or without the suffix PLUS.

4.5 Mr. Khera submits that, in pharmaceutical preparations, "DEX", as a suffix, is *publici juris*. He has invited my attention to advertisements and other material which indicate the use of the marks Convidex Forte, Cozodex, Cooldex, Kofadex, Kofradex, Cefodex, Celodex, Curadex, Chloridex, Caredex, Cresadex, Casodex, Cyclodex, Cuf Dex and Clobidex, among others, to indicate that "DEX" is a common suffix figuring in the name of several pharmaceutical preparations. He has also referred to trademarks registered in respect of pharmaceutical preparations which contain "DEX" as a suffix, though he acknowledges the fact that none of these trademarks predate the registration held by the plaintiff in respect of the COBADEX mark.

4.6 To emphasise that, in such circumstances, where part of the asserted mark is common to the goods of several persons in the trade, and the rest of the mark is different, no case of infringement can be

said to be made out, Mr. Khera relies on *F. Hoffmann-la Roche & Co. Ltd v. Geoffrey Manner and Co. Pvt Ltd*.¹, *J R Kapoor v. Micronix India*², *AstraZeneca UK Ltd v. Orchid Chemicals & Pharmaceuticals Ltd*³, *Schering Corporation v. Alkem Laboratories Ltd*⁴, *Sun Pharmaceutical Industries Ltd v. Anglo French Drugs & Industries Ltd*⁵ and *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*⁶.

4.7 Mr. Khera further submits that the plaintiff has not placed, on record, documents substantiating its claim to user of the COBADEX mark. The invoices that the plaintiff has placed on record, he submits, have all essential details redacted, and it is impossible to make out anything from the said documents. He also points out, in this context, that the defendants have filed rectification proceedings against the plaintiff's COBADEX mark before the Registrar under Section 57 of the Trade Marks Act, seeking removal of the mark from the register on the ground of non-use. Grant of injunction to the plaintiff, he submits, would defeat the said rectification proceedings, even while they are pending.

4.8 Mr. Khera also pleads delay on the part of the plaintiff, in approaching this Court in the present matter. Having issued a legal notice to the defendant on 23rd November 2021, he points out that the present suit was filed only on 6th January 2023. Such delay, he submits, disentitles the plaintiff to interlocutory injunctive relief, and

¹ (1969) 2 SCC 716

² (1994) Supp (3) SCC 215

³ (2007) 34 PTC 469

⁴ (2010) 42 PTC 772

⁵ (2015) 63 PTC 580

⁶ AIR 1965 SC 980

relies, for the purpose, on para 9 of *Wander Ltd v. Antox India (P) Ltd*⁷.

4.9 Mr. Khera disputes Mr. Mahant's assertion that COMODEX infringes COBADEX within the meaning of Section 29⁸ of the Trade Marks Act. The product of the plaintiff, in which it uses its COBADEX mark is, according to the plaint, COBADEX-Z. Mr. Khera draws attention to the fact that the COBADEX-Z pack contains a prominent warning that the product is to be sold in retail only on the prescription of a registered medical practitioner. Thus, submits Mr. Khera, COBADEX-Z is a prescription drug, whereas the defendant's COMODEX PLUS is an over the counter (OTC) preparation, which can be dispensed, and purchased, without prescription. The products are, therefore, distinct and different, and, inasmuch as the plaintiff's

⁷(1990) Supp SCC 727

⁸ 29. **Infringement of registered trade marks.—**

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

product has to be prescribed by a registered medical practitioner, there is no possibility of confusion. Mr. Khera has relied, in this context, on the following passage from the plaint which, according to him, contains admissions of facts which are seriously prejudicial to the case that the plaintiff seeks to set up:

“46. The investigation, which was completed at the end of April 2022, revealed that the Defendants use the Defendants' COMODEX Marks on/in relation to capsules (whose active ingredient is "B Complex") to treat vitamin deficiencies. An affidavit provided by the investigator attesting to these facts is annexed hereto and marked as DOCUMENT -31. The findings of the investigation clearly shows that the Defendants appear to be trying to ride upon the goodwill and reputation of the Plaintiff in the Plaintiff's COBADEX Mark with mala fide intent. *Given the difference in the active ingredients and the target ailment, it is plausible that owing to common mistakes at the end of the chemists, a patient will end up purchasing and consuming wrong medicines which will cause immense injury to the patient. As has been widely experienced during the pandemic, medicines are mostly prescribed over electronic means like WhatsApp when the patient is not mobile. Additionally, patients send prescriptions to local chemists who in turn deliver the medicines available. In such a scenario, a patient who is bed-ridden shall have no means to countercheck one of the dozens of tablets he/she would be consuming on a daily basis. It is this very grave injury which this Hon'ble Court is prayed to grant relief for.*”

(Emphasis supplied)

4.10 For these reasons, submits Mr. Khera, the plaintiff cannot be held to be entitled to any injunctive relief.

5. Mr. Mahant's submissions in rejoinder

5.1 I queried, of Mr. Mahant, as to the specific provision of Section 29 of the Trade Marks Act that he was seeking to invoke, to allege infringement in the present case. Mr. Mahant cites Section 29(2)(b). I further queried of Mr. Mahant as to how the said provision could

apply, as the plaintiff's product can be sold only on the prescription of a registered medical practitioner whereas the defendants' product is an OTC preparation. Mr. Mahant's response is that, even if it were to be presumed that the prescribing physician would not confuse COBADEX with COMODEX, the possibility of such confusion, at the end of the chemist, could not be gainsaid. Even if there was any likelihood of the chemist, perhaps in a moment of carelessness, dispensing the defendants' product in place of the plaintiff's product, owing to the similarity in the names of the two, that, in his submission, would suffice to constitute likelihood of confusion or deception for the purpose of Section 29(2)(b) of the Trade Marks Act.

5.2 In support of the case that he seeks to set up, Mr Mahant cites

- (i) paras 4 and 7 of *Midas Hygiene Industries (P) Ltd v. Sudhir Bhatia*⁹,
- (ii) paras 8 and 10 of *Laxmikant V. Patel v. Chetanbhai Shah*¹⁰,
- (iii) paras 14, 21, 22, 23, 27 and 32 of *Cadila Healthcare Ltd. v. Cadila Pharmaceuticals*¹¹,
- (iv) paras 46, 74 and 75 of the decision of this Bench in *FDC Ltd v. Faraway Foods*¹²,
- (v) para 25 of *Hindustan Pencils Pvt. Ltd. v. India Stationary Products Co.*¹³,

⁹ (2004) 3 SCC 90

¹⁰ (2002) 3 SCC 65

¹¹ (2001) 5 SCC 73

¹² 2021 SCC OnLine Del 1539

¹³ (1989) 38 DLT 54

- (vi) paras 58, 60, 61, 62, 64 and 67 of the decision of this Bench in *Intercontinental Great Brands v. Parle Product Pvt. Ltd.*¹⁴,
- (vii) paras 4, 5, 7, 9, 10, 14, 15, 19, 25, 26, 31, 34 to 37 and 41 of *FDC Ltd v. Nilrise Pharmaceuticals*¹⁵,
- (viii) paras 8 and 9 of *Pankaj Goel v. Dabur India*¹⁶,
- (ix) paras 5 to 7, 9, 10, 14, 22 and 25 of *Saga Life Sciences v. Aristo Pharmaceutical Pvt. Ltd.*¹⁷,
- (x) paras 7 and 9 of *Remidex Pharma v. Savita Pharmaceuticals*¹⁸ and
- (xi) paras 4, 6 to 8, 11 and 14 to 16 of *FDC v. Tas Med (India)*¹⁹.

5.3 Apropos the redacted invoices, Mr. Mahant submits that the fact that COBADEX was sold under the said invoices is reflected even from the un-redacted portion of the invoices which is, therefore, sufficient to make out a case of user by the plaintiff as claimed in the plaint. Besides, he submits, marketing material evidencing such user has also been filed by the plaintiff.

6. Mr. Khera in surrejoinder:

6.1 In surrejoinder, Mr. Khera seeks to distinguish the decisions on which Mr. Mahant placed reliance, on facts, by referring to alternate paras of the said decisions. He, therefore, cites

¹⁴ 2023 SCC OnLine Del 728

¹⁵ (2022) 295 DLT 437

¹⁶ (2008) 38 PTC 49 (DB)

¹⁷ (2022) 290 DLT 689

¹⁸ (2006) 33 PTC 157

¹⁹ (2006) 33 PTC 157

- (i) para 6 of *Midas Hygiene*⁹,
- (ii) para 14 of *Laxmikant V. Patel*¹⁰,
- (iii) para 35 of *Cadila Healthcare*¹¹,
- (iv) para 35 of *Hindustan Pencil*¹³,
- (v) paras 38, 39 and 43 of *FDC v. Nilrise Pharmaceutical*¹⁵,
- (vi) para 19 of *Pankaj Goel*¹⁶,
- (vii) para 23 of *Sega Life Sciences*¹⁷,
- (viii) para 9 of *Remidex Pharma*¹⁸,
- (ix) paras 87, 88 and 91 of *Intercontinental Great Brands*¹⁴,
- and
- (x) paras 76, 79, 80 and 81 of *FDC v. Faraway Foods*¹².

Mr. Khera also relies on para 14 of the judgment of the Division Bench of the High Court of Bombay in *Corona Remedies v. Franco-Indian Pharmaceuticals*²⁰, the SLP preferred against which was dismissed by the Supreme Court.

Analysis

7. Having heard learned Counsel and perused the record, I proceed to address the individual issues that arise for consideration, thus.

7.1 Re: Trade dress similarity

On the aspect of trade dress similarity, the defendants shall remain bound by Mr. Khera's statement that they would not use Pack 1 to pack or sell their product pending disposal of the present suit. No further directions, in this regard, are necessary at the interlocutory stage.

²⁰ MANU/MH/0410/2023

7.2 Re. Trade mark infringement:

7.2.1 Mr. Mahant submits that the mark COMODEX, with or without PLUS, infringes the plaintiff's registered mark COBADEX.

7.2.2 The first submission of Mr. Khera, by way of response thereto, is predicated on Section 17(2)(b)²¹ of the Trade Marks Act. He submits that the suffix "DEX" is common to the trade, as there are several pharmaceutical preparations, the names of which end with "DEX". The preparations to which he has drawn my attention already stand noted in para 4.4 (*supra*).

7.2.3 The manner in which Mr. Khera seeks to canvass his submission is contrary to paras 21 and 22 of *Pankaj Goel*¹⁶, rendered by a Division Bench of this Court. The facts of that case mirror those of the present, as the competing marks were SATMOLA and RASMOLA, used for Ayurvedic digestive tablets. The suffix MOLA, it was sought to be contended, was common to the trade, just as is, in the present case, the suffix DEX, according to Mr. Khera. Dealing with this submission, *Pankaj Goel*¹⁶ held thus:

"21. As far as the Appellant's argument that the word MOLA is common to the trade and that variants of MOLA are available in the market, *we find that the Appellant has not been able to prima facie prove that the said 'infringers' had significant business turnover or they posed a threat to Plaintiff's distinctiveness. In fact, we are of the view that the Respondent/Plaintiff is not*

²¹ 17. **Effect of registration of parts of a mark.** –

(2) Notwithstanding anything contained in sub-section (1), when a trade mark –

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,

the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

*expected to sue all small type infringers who may not be affecting Respondent/Plaintiff business. The Supreme Court in **National Bell v. Metal Goods**²², has held that a proprietor of a trademark need not take action against infringement which do not cause prejudice to its distinctiveness. In **Express Bottlers Services Pvt. Ltd. v. Pepsi Inc.**²³, it has been held as under:-*

“...To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the malicious persons, just to harass the proprietor may use his mark by way of pinpricks.... The mere use of the name is irrelevant because a registered proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence... Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark. This Court is inclined to accept the submissions of the respondent No. 1 on this point... The respondent No. 1 did not lose its mark by not proceeding against insignificant infringers...”

22. In fact, in **Dr. Reddy Laboratories v. Reddy Paharmaceuticals**²⁴, a Single Judge of this Court has held as under:—

“...the owners of trade marks or copy rights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. If the impugned infringement is too trivial or insignificant and is not capable of harming their business interests, they may overlook and ignore petty violations till they assume alarming proportions. If a road side Dhaba puts up a board of “Taj Hotel”, the owners of Taj Group are not expected to swing into action and raise objections forthwith. They can wait till the time the user of their name starts harming their business interest and starts misleading and confusing their customers.”

²² (1970) 3 SCC 665

²³ (1989) 7 PTC 14

²⁴ (2004) 29 PTC 435

7.2.4 The onus to establish the existence of the ingredients to substantiate a plea that a mark, or a part thereof, is common to the trade, is unquestionably on him who so asserts. It is for Mr. Khera, therefore, to positively establish, at least *prima facie*, that the suffix DEX is common to the trade in pharmaceutical preparations. I do not think that he has succeeded in doing so.

7.2.5 How has Mr. Khera attempted to discharge this burden? He has cited a number of pharmaceutical products, the names of which end in DEX. The question is – does the burden on him thus stand discharged?

7.2.6 *Pankaj Goel*⁶ would indicate otherwise, but, before adverting to that decision, another facet of this issue merits mention.

7.2.7 Several of the pharmaceutical preparations, cited by Mr. Khera in this context, contain either Dextromethorphan or Dexamethasone. The use of part of the name of the active ingredient in a pharmaceutical product, as part of the brand name of the product itself, is a matter of common trade practice, as is recognized, *inter alia*, in *F. Hoffmann*¹, *J R Kapoor*² and, *AstraZeneca*³ on which Mr. Khera himself relies. Equally, manufacturers of pharmaceutical preparations tend, on occasion, to use part of the name of the ailment that the preparation intends to target, or part of the name of the organ that it intends to cure, as part of its brand name. Thus do there exist brand names such as PRESOLAR, which claims to reduce blood pressure, CARDACE, intended at dealing with cardiac ailments and

STIMULIV, which is a liver tonic. Part of the name of the API is also commonly used as part of the brand name of the therapeutic preparation, of which one of the most commonly encountered examples is FLOX, which figures in OFLOX, LEVOFLOX and CIPROFLOX, which contain Ofloxacin, Levofloxacin and Ciprofloxacin respectively. The use of DEX as a suffix in COZODEX, COSMODEX C, COOLDEX DS, CELODEX which contain either Dextromethorphan or Dexamethasone fall into this category. These products cannot, therefore, legitimately be cited in support of the proposition that DEX, as a suffix in pharmaceutical preparations, is *publici juris*.

7.2.8 For the rest, the issue stands covered by the passages from *Pankaj Goel*¹⁶ reproduced *supra*. Merely citing marks of products containing DEX as a suffix is insufficient to substantiate a contention that DEX, as a suffix, is common to the trade in pharmaceutical preparations. On the defendant, pleading that the part of the brand name, common to the product of the plaintiff and the defendant, is *publici juris*, is cast the onus to establish the assertion. This, according to *Express Bottlers Services*²³ and *Pankaj Goel*¹⁶, requires the defendant to show (i) substantial use, by the proprietors of the marks cited by it, (ii) the extent of trade in products bearing the said marks and (iii) that the said marks pose a threat to the distinctiveness of the mark asserted by the plaintiff. Else, would not be possible for this Court to return a finding that the mark of the plaintiff, or the part thereof which, according to the defendant, is common to the trade, is indeed so.

7.2.9 By corollary, it would be even more impermissible for the defendant to plead that the plaintiff's mark, or a part thereof, has become common to the trade, thereby invoking Section 17(2)(b) of the Trade Marks Act, by merely citing registrations, existing on the Register of Trade Marks, of names containing the asserted mark, or a part thereof. As is often correctly pleaded in these cases, "common to register" is qualitatively different from "common to the trade". One may register a mark and leave it unused. Products bearing marks which stand registered in the Register of Trade Marks may never see the market, or may, at best, make sporadic appearances. Such registrations cannot divest the plaintiff's mark of distinctiveness, or disentitle the plaintiff to injunction.

7.2.10 Plainly put, a mark, though registered, may not make it "to the trade". Section 17(2)(b) applies only where the asserted mark, or a part thereof, is common "to the trade". The use of the article "the", in Section 17(2)(b) is, in my considered opinion, significant. There is a clear difference between the expressions "common to trade" and "common to *the* trade".

7.2.11 It is an elementary principle of legislative interpretation that the legislature is presumed not to indulge either in superfluity or tautology. Every word used in parliamentary legislation is intended, axiomatically, to have been deliberately used²⁵. This principle applies with greater force where the use of the concerned word or phrase is not necessary to make the provision, in which it is used, syntactically complete. If, therefore, the legislature has, in the phrase "common to

²⁵ Refer *Umed v. Raj Singh*, (1975) 1 SCC 76; *Dilbagh Rai Jerry v. UOI* AIR 1974 SC 130

trade”, inserted the definitive article “the”, that insertion has to be treated as deliberate and intended to serve a particular purpose. Etymologically, the insertion of the definitive article “the” is obviously intended to make the provision applicable to “the trade” which could, in a manner of speaking, be analogised to “the market”. The use of the definitive article “the” indicates that the accompanying word “trade” is to be understood, in the provision, as a noun, and not a verb. As a noun, “trade” has been defined in several judgements of the Supreme Court. Perhaps the most comprehensive definition is to be found in *Fatechand Himmatlal v. State of Maharashtra*²⁶, which defines “trade”, used as a noun, as meaning “lending, movements of goods, transactions linked with merchandise order, flow of goods, the promotion of buying and selling advance, borrowings, discounting bills and mercantile documents, banking and other forms of supply of funds”. What, therefore, section 17(2)(b) requires is commonness, of the asserted mark or part thereof, to “the trade”; in other words, *in the trade relating to the goods to which the mark pertains*, the use of part of the mark must be found to be “common”. “The trade” referring to actual flow of goods in the market, it is necessary for the defendant who invokes Section 17(2)(b) to establish that, in the market relating to such goods, the use of the asserted mark, or part thereof, is common.

7.2.12 The word “common”, too, has its own significant etymological connotation. Commonality cannot be easily presumed. It has to be established as a statistical reality. “Common” is defined in P. Ramanatha Aiyar’s authoritative Advanced Law Lexicon, as

²⁶ AIR 1977 SCC 1825

“describing something that happens very frequently, or that applies equally to a number of people, without exclusion or differentiation”. The Worcester Dictionary, also quoted in Ramanatha Aiyar, defines “common”, as an adjective, as meaning “usual, accustomed, shared among several; owned by several jointly; belonging to the public; general; universal; frequent, customary, habitual”. Plainly stated, therefore, for the use of an expression to be regarded as “common to the trade”, the persons who are asserting as to establish, positively, that the use of the expression *in the trade* is frequent, customary or habitual. Registering of a multiplicity of marks containing the expression can go no way, whatsoever, towards that end.

7.2.13 In other words, what Section 17(2)(b) envisages is, firstly, the existence of a trade in the articles, or class of articles, in respect of which the asserted mark is used by the plaintiff and, secondly, frequent, customary or habitual use, in that trade, of the mark, or part of the mark, asserted by the plaintiff which the defendant claims to have become “common to the trade”. By its very nature, satisfaction of this test would require appreciation of evidence. It would require the Court to be satisfied of (i) the existence of a trade in the article, or class of articles, in respect of which the plaintiff uses the asserted mark and (ii) common, i.e. frequent, customary or habitual use, in that way, of the mark or part thereof. It is only, therefore, where there is sufficiently overwhelming evidence, of the satisfaction of these two ingredients, placed on record by the defendant, that the Court may, at a *prima facie* stage, justify the invocation of Section 17(2)(b), by holding that the mark asserted by the plaintiff, or a part thereof, has become “common to the trade”, thereby disentitling the plaintiff from claiming exclusivity in respect thereof.

7.2.14 Tested on this touchstone, it cannot be said that Mr. Khera has made out a case for holding the plaintiff disentitled from claiming exclusivity on the ground that the suffix DEX is common to the trade. The Court does not have, with it, statistical data regarding the market presence of other pharmaceutical compounds, the brand names of which end with DEX. When one excludes, from the examples cited by Mr. Khera, those products which contain dexamethasone or dextromethorphan, the remaining examples cannot, at the *prima facie* stage, make out a case under Section 17(2)(b) of the Trade Marks Act. The principle that the mere failure, on the part of the plaintiff, to sue every infringer, cannot disentitle it from claiming exclusivity *vis-à-vis* the infringer whom it chooses to sue, would also apply in such circumstances.

7.2.15 The judgements cited by Mr. Khera do not help him; some, in fact, militate against the submissions that he advances.

7.2.16 In *F. Hoffmann-la Roche*¹, the Supreme Court, observing that the suffix VIT was commonly used by manufacturers of pharmaceutical multivitamin preparations, rejected the plea of infringement between the rival marks PROTOVIT and DROPOVIT on the ground that, if one were to exclude the common suffix VIT, the remainder of the two marks, i.e. PROTO and DROPO, were dissimilar.

7.2.17 Similarly, the rival marks in *J.R. Kapoor*² were MICRONIX and MICROTEL, used in respect of items involving microchip technology. The Supreme Court held that the common prefix MICRO

was descriptive of the nature of technology used in the products. Again, as the suffixes of the rival marks NIX and TEL were dissimilar, the Supreme Court held that no infringement could be said to have taken place.

7.2.18 *AstraZeneca*³ was a decision of a Division Bench of this Court. The plaintiff AstraZeneca sought an injunction against the defendant Orchid Chemicals and Pharmaceuticals Ltd (“Orchid”, hereinafter) against using the mark MEROMER, claiming that it was deceptively similar to the plaintiffs registered mark MERONEM. Both marks were used for pharmaceutical preparations containing the API Meropenem. The Division Bench of this Court noted that, “in the trade of drugs, it is common practice to name drugs by the name of the organ or ailment which treats of the main ingredient of the drug”. Meropenem being the main ingredient of the drugs sold under the rival marks, the Division Bench held that no exclusivity could be claimed over the prefix MERO. NEM and MER being dissimilar, the Division Bench refused to hold that a prima facie case of infringement existed.

7.2.19 The tendency of pharmaceutical manufacturers to use abbreviations of the organ or ailment that the preparation intended to treat, or of the API in the product, was also noticed in ***Schering Corporation***⁴, also rendered by a Division Bench of this Court. Noticing the said fact, the Division Bench rejected the plea of the appellant-plaintiff Schering Corporation (“Schering”, hereinafter) for an injunction against the respondent-defendant Alkem Laboratories from using the brand name TEMOKEM and TEMOGET which, according to Schering, were deceptively similar to its registered

trademarks TEMODAL and TEMODAR. In this case, too, the Division Bench held that the prefix TEMO was commonly used in the pharmaceutical trade while naming products containing Temozolamide as the API. As in the case of *AstraZeneca*³, this finding of the Division Bench in *Schering Corporation*⁴ directly attracted Section 17(2)(b) of the Trade Marks Act, as it amounted to recognition of the fact that the common part of the rival marks – MERO in *AstraZeneca*³ and TEMO in *Schering Corporation*⁴ – were common to the pharmaceutical trade. The statutory sequitur, flowing from Section 17(2)(b) was, therefore, that no exclusivity could be claimed in respect of the said prefixes. The rest of the marks being dissimilar, therefore, the plea of infringement was negated by this Court.

7.2.20 All these cases related, therefore, to situations in which the common part of the rival marks was found to be common to the trade as it was an abbreviation of the API, and the remaining parts of the marks were dissimilar. DEX, as used either by the plaintiff or the defendant, however, is not intended as an abbreviation of the API, or the organ, or the ailment that the products intend to alleviate. The use, by the plaintiff, of DEX as the suffix in COBADEX is, therefore, arbitrary, and the above decisions, which pertain to cases where the common suffix, or prefix, was an abbreviation of the API in the product concerned, would not apply.

7.2.21 *Sun Pharmaceutical Industries*⁵ was decided on different considerations. The rival marks, before the Division Bench of this Court in the said case, were EXITOL and OXETOL. The considerations which persuades the Division Bench in *Sun*

*Pharmaceutical Industries*⁵ to hold that there was no infringement were that

- (i) the name OXETOL had been derived from oxycarbazapene, being the API of the product,
- (ii) both products were Schedule H drugs, to be sold only on medical prescription,
- (iii) the active ingredients in the two products were different,
- (iv) EXITOL was available only in capsules and tablets, whereas OXETOL was available only in syrup or granule form,
- (v) the packing and visual representation of the products was different,
- (vi) EXITOL was a laxative whereas OXETOL was an anticonvulsant for mood stabilising,
- (vii) EXITOL could only be administered to patients admitted in hospital, by trained nurses, on prescription by a competent doctors and
- (viii) the target customers were also different, as OXETOL could be used by any person suffering from any ailment whereas EXITOL was used only by patients suffering from neurological disorders.

These governing considerations have neither been pleaded, nor do they cumulatively arise in the facts of the present case.

7.2.22 The decisions cited by Mr. Khera do not, therefore, advance his submission that, as the suffix DEX is common to the trade, COBADEX and COMODEX cannot be treated as deceptively similar.

7.2.23 Indeed, in emphasizing his contention that the suffix DEX is common to the trade and that, therefore, the plaintiff cannot claim any exclusivity in respect of the said suffix, in view of Section 17(2)(b), Mr. Khera obfuscates the fact that the words COBADEX and COMODEX are, even otherwise, phonetically similar. The phonetic similarity between the two words does not begin and end with the common suffix DEX. They are both words of three syllables each. The first and third syllables are the same – CO and DEX. The only difference is in the intervening middle syllable which, in COBADEX is BA, and in COMODEX is MO. Confusion or deception, for the purposes of assessing infringement under Section 29 of the Trade Marks Act, has to be from the perception of a person of average intelligence and imperfect recollection, as held in *Amritdhara Pharmacy v. Satyadeo Gupta*²⁷, *Cadila Healthcare*¹¹, *Mahendra & Mahendra Paper Mills Ltd v. Mahindra & Mahindra Ltd*²⁸ and *Satyam Infoway Ltd v. Sifynet Solutions Pvt Ltd*²⁹. Impliedly inbuilt into the requirement of the customer being a person of imperfect recollection is the requirement that he should not be over-familiar with either of the products. The marks are not to be seen side by side and compared, to assess infringement. Rather, the Court is required to assess whether, if a customer of average intelligence and imperfect recollection were to see the plaintiff's mark and, sometime – perhaps a few days later – come across the defendant's mark, she is likely to recollect having seen the mark earlier or to conjecture an association between the marks that she now sees and the marks that she saw earlier. All that is needed is confusion. The concept of “confusion”, in

²⁷ AIR 1963 SC 449

²⁸ (2002) 2 SCC 147

²⁹ (2004) 6 SCC 145

trademark infringement, was thus explained, by a Division Bench of this Court in *Shree Nath Heritage Liquor Pvt Ltd v. Allied Blender & Distillers Pvt Ltd*³⁰:

“5. Confusion can be of the following categories:

- Point of sale confusion-this refers to confusion that takes place at the time of purchase.
- Post sale confusion - this includes confusion of those other than the purchaser.
- Initial interest confusion - this refers to confusion that may be caused initially, i.e. prior to purchase, but at the time of purchase of the alleged infringer/tortfeasor's product or using its service, the consumer is not confused.
- Reverse confusion - this occurs when consumers purchase the goods or use services of the senior user thinking them to originate from the junior user.

6. When a person knows that the mark in question does not originate from the senior user but the senior user is called to mind, then it's a step before confusion. If on the other hand, the consumer is in a state of wonderment if there's a connection, this is confusion. Further, if this consumer then purchases the junior users product, this is then deception.”

Thus, the test is one of “initial interest wonderment”, if one may take the liberty of combining the tests suggested by the Division Bench. If the initial glance at the defendant’s mark makes the person of average intelligence and imperfect recollection wonder as to whether she has seen the same mark, or an associated mark, earlier, and that wonderment arises because she has, in fact, seen the plaintiff’s mark at an earlier point of time, then the defendant’s mark infringes that of the plaintiff within the meaning of Section 29 of the Trade Marks Act. The web cast by a registered trademark is, therefore, very wide. What

³⁰ (2015) 221 DLT 359

matters, as in the case of the unwary fly that approaches too close to the spider's web, is the initial effect. Once caught, even by the most distant strand of the web, the hapless fly is drawn inexorably inward, and there is no scope for escape. Similarly, if the defendant's mark approaches so close to the mark of the plaintiff that the customer of average intelligence and imperfect recollection is initially confused, or placed in a state of confusion or wonderment, the tort of infringement, *ipso facto* and *proprio vigore*, stands committed. The defendant's mark has, like the fly, come too close to the plaintiff's. Infringement has taken place, at that very moment. Once done, it cannot be undone. That the confusion thus initially created may be dispelled by information which comes to the customer's knowledge at a later point of time cannot save the defendant from the tort of infringement. The moment initial interest confusion occurs, the tort stands committed, and the consequences of commission of the tort, as envisaged in the Trade Marks Act, must inexorably follow. In *Laxmikant V. Patel*¹⁰ and *Midas Hygiene*⁹, the Supreme Court holds that, once infringement is found to have taken place, immediate injunction must necessarily follow with, if necessary, appointment of a local commissioner to seize the infringing goods.

7.2.24 Even tested on the above principles, it is clear, to me, that there is every likelihood of a person of average intelligence and imperfect recollection who, at one point of time, encounters the plaintiff's COBADEX tablets and, at a later point of time, comes across the defendants' COMODEX tablets, confusing the two, and of wondering whether she had not, earlier, come across the same product. The possibility of such confusion is augmented by the fact that the

composition of the products is the same, except that COBADEX contains, additionally, zinc. In fact, I am somewhat surprised at the fact that the defendant's product is an OTC preparation, whereas the plaintiff's product contains a warning that it should be sold only on the prescription of a registered medical practitioner. *Prima facie*, however, the warning appears more to be aimed at guarding against indiscriminate dissemination of the product, rather than as a cautionary note because of the possible harmful effects of unnecessary ingestion of the product. Both the products are essentially multivitamins, the only difference being that COBADEX contains zinc in addition to the compounds which comprise COMODEX. They are, therefore, targeted at the same customer segment, available from the same outlets and comprise essentially the same constituents.

7.2.25 It is also important to note that, in respect of pharmaceutical preparations, the Supreme Court has advanced additional care and caution while dealing with cases of infringement. The following passages from the decision in *Cadila Healthcare*¹¹ underscore the legal position:

*“22. It may here be noticed that Schedule ‘H’ drugs are those which can be sold by the chemist only on the prescription of the doctor but Schedule ‘L’ drugs are not sold across the counter but are sold only to the hospitals and clinics. Nevertheless, it is not uncommon that because of lack of competence or otherwise, mistakes can arise specially where the trade marks are deceptively similar. In **Blansett Pharmaceuticals Co. v. Carmick Laboratories Inc.**³¹ it was held as under:*

“Confusion and mistake is likely, even for prescription drugs prescribed by doctors and dispensed by pharmacists, where these similar goods are marketed under marks which look alike and sound alike.”

³¹ 25 USPQ 2nd, 1473 (TTAB 1993)

21. It will be useful to refer to some decisions of American courts relating to medicinal products. In the case of *American Cynamid Corpn. v. Connaught Laboratories Inc.*³² it was held as under:

“Exacting judicial scrutiny is required if there is a possibility of confusion over marks on medicinal products because the potential harm may be far more dire than that in confusion over ordinary consumer products.”

23. In the case of *Glenwood Laboratories, Inc. v. American Home Products Corpn.*³³ the Court of the United States had held that:

“The fact that confusion as to prescription drugs could produce harm in contrast to confusion with respect to non-medicinal products is an additional consideration for the Board as is evident from that portion of the opinion in which the Board stated: ‘The products of the parties are medicinal and the applicant's product is contraindicated for the disease for which the opposer's product is indicated. It is apparent that confusion or mistake in filling a prescription for either product could produce harmful effects. Under such circumstances, it is necessary for obvious reasons, to avoid confusion or mistake in the dispensing of the pharmaceuticals.’

The board's view that a higher standard be applied to medicinal products finds support in previous decisions of this Court, *Clifton v. Plough*³⁴ (‘it is necessary for obvious reasons, to avoid confusion in the dispensing of pharmaceuticals’), *Campbell Products, Inc. v. John Wyeth & Bro. Inc.*³⁵ (‘it seems to us that where ethical goods are sold and careless use is dangerous, greater care should be taken in the use of registration of trade marks to assure that no harmful confusion results’).”

27. *As far as the present case is concerned, although both the drugs are sold under prescription but this fact alone is not sufficient to prevent confusion which is otherwise likely to occur. In view of the varying infrastructure for supervision of physicians and pharmacists of medical profession in our country due to*

³² 231 USPQ 128 (2nd Cir 1986)

³³ 173 USPQ 19 (1972) 455; F Reports 2d, 1384 (1972)

³⁴ 341, F 2d 934, 936, 52, CCPA 1045, 1047 (1965)

³⁵ 143, F 2d 977, 979, 31 CCPA 1217 (1944)

linguistic, urban, semi-urban and rural divide across the country and with high degree of possibility of even accidental negligence, strict measures to prevent any confusion arising from similarity of marks among medicines are required to be taken.

32. *Public interest would support lesser degree of proof showing confusing similarity in the case of trade mark in respect of medicinal products as against other non-medicinal products. Drugs are poisons, not sweets. Confusion between medicinal products may, therefore, be life threatening, not merely inconvenient. Noting the frailty of human nature and the pressures placed by society on doctors, there should be as many clear indicators as possible to distinguish two medicinal products from each other. It is not uncommon that in hospitals, drugs can be requested verbally and/or under critical/pressure situations. Many patients may be elderly, infirm or illiterate. They may not be in a position to differentiate between the medicine prescribed and bought which is ultimately handed over to them. This view finds support from McCarthy on Trade Marks, 3rd Edn., para 23.12 of which reads as under:*

“The tests of confusing similarity are modified when the goods involved are medicinal products. Confusion of source or product between medicinal products may produce physically harmful results to purchasers and greater protection is required than in the ordinary case. If the goods involved are medicinal products each with different effects and designed for even subtly different uses, confusion among the products caused by similar marks could have disastrous effects. For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations. The same standard has been applied to medical products such as surgical sutures and clavicle splints.””

(Emphasis supplied)

7.2.26 Where the rival marks are used for pharmaceutical products, therefore, the necessity of avoiding confusion, by using similar marks is underscored. Dispensation of a wrong medicine can have catastrophic results. The argument that the mark is used in respect of a prescription drug and that, as doctors are meant to know their job, there is little likelihood of a wrong medicine being prescribed, has

advisedly been rejected, in the afore extracted passages from *Cadila Healthcare*¹¹. A drug, once it leaves the manufacturer's premises, suffers several tribulations. It is first prescribed by a doctor. The handwriting of the doctor may be legible, or unintelligible. It is left to the chemist to decipher what the doctor has written. Where, as in the present case, the rival marks are as similar as COBADEX and COMODEX, the likelihood of the chemist misreading the prescription of the doctor, or wrongly dispensing one medicine for the other, cannot be ignored. Then again, it is an unfortunate matter of common practice that, at times, prescription drugs are also sold without prescription. Where public interest is involved, the Court cannot shut its eyes to this reality. Especially in a case such as the present, where the marks are used for multivitamin preparations, there is every likelihood of a chemist dispensing the product even without a prescription. In such a situation, the chemist would depend on the request made by the customer. The customer may not have even the training of the chemist, and it is quite possible that the customer may ask for COMODEX instead of COBADEX, or *vice versa*. In that event, he would end up getting the product of the defendant, instead of that of the plaintiff. This may make a significant difference if, for example, the customer suffers from zinc deficiency, as COMODEX has no zinc, whereas COBADEX has. Multivitamin prescriptions are also often given telephonically. Given the phonetic similarity between COBADEX and COMODEX, an error may take place at the time of prescription, at the time of placing the request to the chemist, at also the time of dispensation of the medicine by the chemist. The afore extracted passages from *Cadila Healthcare*¹¹ recognize this factual position and, therefore, hold that, if the rival marks are so

phonetically similar that an error could take place at any of these stages, the defendants' drug cannot be allowed to be marketed under an infringing trade mark. In the case of pharmaceutical products, to reiterate, the degree of care that is required to be maintained in these cases is greater.

7.2.27 Given the above legal position, it is clear to this Court, *prima facie*, that the defendant's mark COMODEX infringes the plaintiff's registered mark COBADEX. The use of "plus" or "forte", and other such additions, whether with COBADEX or COMODEX, cannot alter this position.

7.2.28 Mr. Khera sought to contend that the plaintiff is not using the mark COBADEX, despite its registration for over six decades. He submits that the invoices placed on record by the plaintiff as evidence of such use are largely redacted and cannot, therefore, be relied upon. Mr. Mahant, *per contra*, denies the allegation and asserts that the plaintiff has been using the registered COBADEX mark, and dealing in pharmaceutical preparations bearing the said mark, on a regular basis. He has sought to submit that, in the invoices placed on record by the plaintiff, though much of the text is redacted, the fact that, under the said invoices, COBADEX is sold, is clear.

7.2.29 At a *prima facie* stage, this Court need not concern itself with this controversy, especially in view of the rival stands. Invoices, which reflect the sale of COBADEX, although much of the rest of the invoices are redacted, are on record. *Prima facie*, it is not possible for this Court to agree with Mr. Khera's submission that the plaintiff's

COBADEX mark is bad for disuse. In any event, the fact that the plaintiff holds a subsisting registration of the mark COBADEX under the Trade Marks Act is not in dispute. In view of the *prima facie* opinion of this Court that the defendants' COMODEX mark infringes the plaintiff's COBADEX mark, an injunction has to follow.

8. Conclusion

8.1 In view of the aforesaid discussion, the defendants, as well as all others acting on their behalf, are restrained, during the pendency of the present suit, from using, in any form, the mark COMODEX, or any other similar mark as may be confusingly similar to the COBADEX mark of the plaintiff, by itself or with any additive such as "plus" or "forte", in respect of pharmaceutical preparations or allied goods, or from further manufacturing any such product. They are also directed to remove, from all physical and virtual sites and platforms, the said COMODEX mark forthwith.

8.2 The defendants are also directed to place on affidavit, within a week, the details of the stock of pharmaceutical products bearing the COMODEX mark, lying in stock in their factories, godowns, or other premises of which they have control. As the products are pharmaceutical compounds, the defendants are permitted to dispose of the said stock, by sale or otherwise, within a period of two weeks from today, and to place the details of such disposal by way of affidavit in the present proceedings within four weeks.

8.3 The Court is not passing any injunctive orders with respect to stock which may already have been cleared by the defendants, and circulating in the market.

8.4 I.A. 351/2023 stands allowed to the aforesaid extent.

APRIL 10, 2023

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C.HARI SHANKAR, J

