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

% **Date of decision: 22nd November, 2018.**

\+ **CS(COMM) 1668/2016 & IAs No.16066/2016 (u/O XXXIX R-1&2 CPC) & 4813/2018 (of defendant u/O XI R-10 CPC)**

BIOFARMA ..... Plaintiff

Through: Mr. Peeyoosh Kalra, Mr. C.A. Brijesh, Ms. Shreyasi Pal and Ms. Navya Chopra, Advs.

Versus

BAL PHARMA LIMITED ..... Defendant

Through: Ms. Rajeshwari H. and Ms. Swapnil Gaur, Advs.

CORAM:
HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

1. The plaintiff has sued for permanent injunction restraining the defendant from passing off its medicinal preparation as that of the plaintiff by use of the plaintiff's trade mark 'MEX'/trade dress/packaging or any deceptive variations thereof, whether as a trade mark, service mark, trade name, trading style etc. and from infringing the copyright of the plaintiff and for ancillary reliefs.

2. The suit came up first before this Court on 23rd December, 2016 and thereafter on 12th January, 2017. Summons of the suit and notice of the application for interim relief were ordered to be issued to the defendant vide order dated 16th January, 2017. No *ex-parte* relief was granted to the plaintiff. Pleadings have been completed and the suit came up last before this Court on 20th November, 2018 for consideration of the application for interim relief and for framing of issues, if any. The counsels for the parties

were heard on 20th November, 2018 on the application for interim relief and on request of the counsel for the plaintiff in rejoinder to adjourn the hearing to enable him to cite case law, the hearing was adjourned to today. The counsels have been further heard today. At the close of the hearing, considering the extensive hearing held and the nature of the dispute and which qualifies as a commercial dispute, it appeared that no evidence/trial is required and on the basis of the arguments heard, the suit itself, insofar as for the relief of permanent injunction, can be disposed of, with the need to enquire into the relief, if any required to be granted for damages, accounts etc., being considered, after the relief of injunction is adjudicated. It was so indicated to the counsels. Attention of the counsels is drawn to ***Staar Surgical Company Vs. Polymer Technologies International*** 2016 SCC OnLine Del 4813, ***The Financial Times Ltd. Vs. The Times Publishing House Ltd.*** (2016) 234 DLT 305 and ***Jaideep Mohan Vs. Hub International Industries*** (2018) 249 DLT 572 where it has been held that in most of such suits, trial/recording of evidence serves no purpose, with self-serving witnesses being examined by the respective parties and ultimately it falling upon the Court to compare the two marks. The counsels fairly agreed.

3. The undisputed position is:

(i) that the plaintiff is selling Gliclazide and Metformin Hydrochloride Extended Release Tablets under the name and style of 'DIAMICRON XR MEX 500';

(ii) that the defendant is selling Gliclazide Modified Release & Metformin Hydrochloride Extended Release Tablets under the name and style of 'DIABEND-MEX 60';

(iii) that both medicines are for the treatment of diabetes;

(iv) that the plaintiff is the prior adopter of 'MEX', having commenced using the same in April, 2011 with the defendant having commenced using the same in April, 2015;

(v) that in the suit as originally filed, the plaintiff had also sought to restrain the defendant from infringing the copyright of the plaintiff in the trade dress as under:

PLAINTIFF'S PACKAGE

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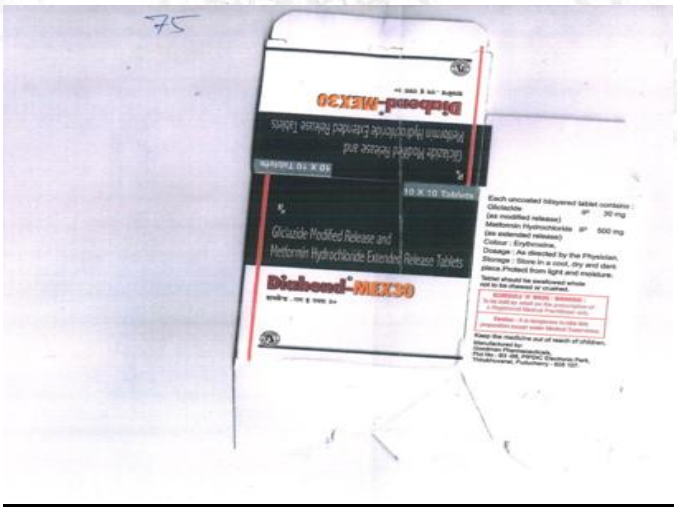
vi) It was the case of the plaintiff that the trade dress as under of the defendant infringed the trade dress of the plaintiff by adopting the red and blue colours:

(vii) that the defendant has since changed its trade dress to as under:



and the plaintiff is satisfied therewith and the counsel for the defendant states that the defendant will not revert to the trade dress as shown above and to which objection was taken by the plaintiff and the counsel for the defendant has stated that the defendant be bound by the said statement;

(viii) that thus the relief claimed qua trade dress is not to be adjudicated and has not been argued and the counsel for the plaintiff has only objected to the defendant adopting pink and white colours as on the tablets of the plaintiff;

(ix) that the defendant was earlier selling the same formulation under the name 'SECREMET' and thereafter under the name 'DIABEND' and 'DIABEND-MR'; and,

(x) that the registered trade mark of the plaintiff is ''DIAMICRON' and the registered trade mark of the defendant is 'DIABEND'.

4. The contention of the counsel for the plaintiff is, that the defendant has changed the name of its subject medicinal preparation, from 'SECREMET' and/or 'DIABEND' and 'DIABEND-MR' to 'DIABEND-MEX 60' ('DIABEND-MEX 30' variant is also available) only to ride on the very popular and high-selling medicinal preparation 'DIAMICRON XR MEX 500' of the plaintiff. However, the counsel for the plaintiff, on enquiry, whether the sales of the plaintiff of its drug 'DIAMICRON XR MEX 500' have dipped and/or fallen ever since the defendant has adopted the name 'DIABEND-MEX 60' for its medicine, has fairly stated that it is not so.

5. The sole issue on which the counsels have addressed is (I) the entitlement of the defendant to use 'MEX', after the same was adopted/used by the plaintiff for its medicine; and, (II) whether by such use, the defendant passes of its medicines as that of the plaintiff.

6. The counsel for the plaintiff has argued, (a) that the word 'MEX' used by the defendant is identical to the plaintiff's identical mark 'MEX' in

relation to identical product and tantamounts to passing off; (b) that the plaintiff has a portfolio of pharmaceutical and medicinal products under the trade mark 'DIAMICRON'; the range of drugs sold under the mark 'DIAMICRON' includes 'DIAMICRON', 'DIAMICRON MR', 'DIAMICRON XR' and 'DIAMICRON XR MEX'; (c) that 'DIAMICRON XR' and 'DIAMICRON MR' are associated with Gliclazide and Metformin Hydrochloride; (d) that the mark 'MEX' has been coined by the plaintiff and is an acronym for 'Metformin Extended Release' and has acquired distinctiveness and secondary significance on account of continuous and extensive use by the plaintiff; and, (e) that the plaintiff has also filed Trade Mark Application seeking registration of the mark 'MEX' in Class 5 and which is pending before the Trademark Registry; only the defendant has filed opposition thereto on the ground of the use by the defendant of 'MEX' and the resultant confusion.

7. I may notice that the plea of the plaintiff in the plaint is that adoption by the defendant of the same mark 'MEX' clubbed with adoption by the defendant of the same colour scheme and trade dress as on the product of the plaintiff, results in passing off. Now, though with the change of trade dress, the 'clubbing effect' no longer exists but the plaintiff still wants to restrain the defendant from using 'MEX'.

8. Finding use by the plaintiff of 'MEX' as part of 'DIAMICRON XR MEX 500' and not stand alone and also not finding the plaintiff to have in the plaint pleaded that its subject drug is marketed or prescribed as 'MEX', it has specifically been enquired from the counsel for the plaintiff, whether the plaintiff raises invoices and/or makes the Medical Practitioners aware of the subject drug as 'MEX' and not as 'DIAMICRON XR MEX 500'.

9. The counsel for the plaintiff fairly states that it is not so the case of the plaintiff.

10. Attention of the counsel for the plaintiff is drawn to the presence in the market of several medicines/drugs with the suffix 'SR', being the acronym for "Sustained Release" and it was enquired, whether not the suffix 'MR' and 'XR' to the medicines under the mark 'DIAMICRON' of the plaintiff also have a similar connotation.

11. While the counsel for the plaintiff states that he has no instructions, the counsel for the defendant states that 'MR' indicates "Modified Release" and 'XR' indicates "Extended Release".

12. There is no reason to doubt the same. I may also state that not only is the medicine of the plaintiff under the mark 'DIAMICRON XR MEX 500' is described 'gliclazide and metformin hydrochloride extended release tablets' and the medicine of the defendant under the mark 'DIABEND-MEX 60' is described as 'Gliclazide Modified Release & Metformin Hydrochloride Extended Release Tablets' but the ingredients of the medicine of the plaintiff are also described on the packaging itself as:

"gliclazide I.P. (as extended release)……60 mg
metformin hydrochloride I.P. (as extended release)….500 mg"

and the ingredients of the medicine 'DIABEND-MEX 60' of the defendant on the packaging are described as:

"Gliclazide IP…….60 mg
(as modified release)
Metformin Hydrochloride IP……..500 mg
(as extended release)"

and confirms what the counsel for the defendant has stated.

13. The plaintiff, in the plaint has not alleged that the registered trade mark 'DIABEND' of the defendant infringes the registered trade mark 'DIAMICRON' of the plaintiff or the two are similar. The only objection, as aforesaid, is to 'MEX'. However, the plaintiff in the plaint itself has admitted 'MEX' to be an acronym for 'Metformin Extended Release' and which is the common medicinal preparation of both and to which neither any exclusive right can be claimed nor has been claimed.

14. The counsel for the plaintiff has argued that 'DIAMICRON' and 'MEX' are two separate and distinct marks and it is permissible to have two marks on the product and both the marks are entitled to protection, even if the other mark is dissimilar. Reliance in this regard is placed on the dicta of this Court in ***Procter & Gamble Manufacturing (Tianjin) Co. Ltd. Vs. Anchor Health & Beauty Care Pvt. Ltd.*** 211 (2014) DLT 466.

15. The counsel for the plaintiff, in response to the plea in the written statement of the defendant to the effect that 'MEX' is common to the trade, has also drawn attention to page 71 of Part III file to contend that a Google search of the word 'MEX-500' shows results of the plaintiff and the defendant only and no none else is using 'MEX'.

16. The counsel for the plaintiff has today also contended that while the defendant, in opposition to the application for registration of the mark has claimed using 'MEX' as a mark but in the written statement to the present suit has claimed use thereof as a feature. However, on enquiry as to the effect of the said inconsistency even if any in the stand of the defendant, no definite answer is given. The fact remains that neither the subject medicine

of the plaintiff nor of the defendant is pleaded to be known by 'MEX' alone and 'MEX' is only a part of the name of the medicine of both.

17. The counsel for the plaintiff has today also relied on ***Ashland Licensing And Intellectual Property LLC Vs. Savita Chemicals Limited*** 2010 (44) PTC 220 (Del) injuncting the defendant therein from using the words "ALL FLEET" to market its automobile lubricant, even though 'ALL FLEET' was only a description of one of the automobile lubricant of the plaintiff 'VALVOLINE COMMINS LTD.' whose registered trademark was 'VALVOLINE'. The counsel for the plaintiff has contended, that similarly 'MEX 500' is one of the variants of the portfolio of medicines under the trade mark 'DIAMICRON' and just like 'VALVOLINE'. 'ALL FLEET' was held entitled to injunction against use of 'ALL FLEET' even without the word 'VALVOLINE', so is the plaintiff entitled to protection of 'MEX' variant of 'DIAMICRON'.

18. I am afraid the said judgment does not come to the rescue of the plaintiff. 'ALL FLEET' was a registered trade mark; 'MEX' is not. Use of 'ALL FLEET' was not as part of a mark as of 'MEX' in 'DIAMICRON XR MEX 500'. Valvoline Cummins Ltd. was one of the joint venture partners and the proprietor of the registered mark and 'ALL FLEET' was the other joint venture partner. The product, besides showing the name of Valvoline Cummins Ltd. did not use 'VALVOLINE' in conjunction with 'ALL FLEET' and besides the name Valvoline Cummins Ltd., only 'V' was shown on the product. On the contrary here, it is not as if 'DIAMICRON' is a part of a name of the plaintiff. 'DIAMICRON' is a part of the mark, with 'MEX' being another part of the same mark. ***Ashland Licensing And Intellectual Property LLC*** supra specifically records that it was not even

argued by the defendants therein that the marks were dissimilar. The finding returned was of the trade mark 'VALVOLINE' being used as the label under the plaintiff's product were sold and the defendants therein were using the same mark as part of its mark 'SAVSOL ALL FLEET'.

19. The counsel for the plaintiff has also relied on ***Filex Systems Pvt. Ltd. Vs. Rotomac Pens (Guj.) Pvt. Ltd.*** 2004 (28) PTC 300 (Del) granting interim injunction against the use of the trade mark 'SOLO' even though it was used with the prefix 'ROTOMAC', holding that the use was likely to cause confusion and deception. However, a reading of the judgment shows that the finding in favour of the plaintiff was returned for the reasons of the word 'SOLO' being associated with the plaintiff who was marketing its same class of goods under the said trade mark alone and on the finding that 'SOLO' formed an important feature of the mark adopted by the defendant as well. Here, the plaintiff is not using 'MEX' alone but 'MEX' as a part of the medicinal name 'DIAMICRON XR MEX 500' and thus is not entitled to the benefit of the said judgment also.

20. On it being enquired from the counsel for the plaintiff that how could the defendant's medicine 'DIABEND-MEX 60' or 'DIABEND-MEX 30' be passed off as medicine 'DIAMICRON XR MEX 500' of the plaintiff, when both are prescription medicines and are not claimed to be known or marketed as 'MEX' alone, the counsel for the plaintiff also drew attention to ***Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.*** (2001) 5 SCC 73 requiring the Courts to be particularly vigilant in the claims of infringement and passing off of drugs and the fact that a drug is sold under prescription or only to physicians being by itself to be considered a sufficient protection against confusion. However, the said findings came to

be recorded, reasoning that the drugs have a marked difference in their composition, with completely different side effects and consequence of taking one instead of another being fatal. Here, both drugs have identical formulation and are for treatment of the same ailment. Be that as it may, I am unable to find any possibility of passing off, considering a) the names in totality of the two medicines, with neither being prescribed or sold or marketed by one part only i.e. 'MEX' and qua which the suit has been filed; and, b) that 'MEX', to which objection is taken, is admittedly an acronym for 'Metformin Extended Release' which is common to both medicines. The defendant cannot be restrained from using the acronym, particularly when it relates to the active ingredient of the medicine.

21. The counsel for the plaintiff has again emphasized that the action of the defendant of changing the name of its medicine with the same formulation from 'SECREMET' and 'DIABEND MR' to 'DIABEND-MEX 60' shows an intent to pass off the same as that of the plaintiff.

22. There is however nothing before this Court to show that the formulations are the same or whether the defendant is continuing to market 'SECREMET', 'DIABEND', 'DIABEND MR' along with 'DIABEND-MEX 60'.

23. Not only does 'DIABEND' distinguish the medicine of the defendant from that of the plaintiff under the mark 'DIAMICRON', but in my opinion '30' and '60' in the name of the medicine of the defendant also distinguish the medicine of the defendant from that of the plaintiff with '500'. Even if it were to be believed that, if not Medical Practitioners and Chemists, at least the patients can remember the drug of the plaintiff instead of its full name 'DIAMICRON XR MEX 500' merely as 'MEX', even then they are

unlikely to forget '500' used in conjunction with 'MEX' and are bound to immediately distinguish between the two, finding '30' or '60' in conjunction with 'MEX' in the medicine of the defendant.

24. The counsel for the defendant has argued, that the whole mark is to be seen and so seen, the two are different. Reference is made to Section 17(2)(b) of the Trade Marks Act, 1999, though the claim in the present suit is not for infringement but of passing off.

25. The counsel for the defendant has also relied on:

(A) ***Schering Corporation Vs. Alkem Laboratories Ltd.*** 2010 (42) PTC 772 (Del) denying injunction restraining use of the marks 'TEMOKEM' and 'TEMOGET' on the ground of the same infringing the medicines 'TEMODAL' and 'TEMODAR' of the plaintiffs therein, holding that 'TEMO' was used for 'TEMOZOLOMIDE' which was the active ingredient of the medicines of the plaintiffs as well as the defendant and further holding the word fragment 'TEM/TEMO' to be *publici juris* and also generic for and descriptive of the chemical compound and it being not possible for the plaintiffs to claim exclusive rights thereto. It is emphasised that the said judgment is subsequent to the dicta of the Supreme Court in ***Cadila Health Care Ltd.*** supra.

(B) ***S.B.L. Limited Vs. The Himalaya Drug Co.*** ILR (1997) II Delhi 168 holding 'LIV-T' to be not amounting to passing off of 'LIV. 52', for the reason that 'LIV' was an abbreviation for 'Liver', relating to treatment whereof both the medicines were directed.

(C) ***Biofarma Vs. Sanjay Medical Store*** 66 (1997) DLT 705 holding 'TRIVEDON' to be not deceptively similar to

'FLAVEDON' because the opening syllable of the two were completely different and because both were prescription drugs.

(D) ***Ultratech Cement Limited Grasim Industries Limited Vs. Dalmia Cement Bharat Limited*** 2016 SCC OnLine Bom 3574 holding that when a trade mark contains any matter which is of non-distinctive character, forming only a part of the whole, even registration thereof does not confer any exclusive right in the matter.

(E) ***Cipla Limited Vs. M.K. Pharmaceuticals*** 2008 (36) PTC 166 (Del) holding that there can be no monopoly qua colours.

26. The judgments cited by the counsel for the defendant support what I have already reasoned above, of there being no possibility of the medicine 'DIABEND-MEX 60' or 'DIABEND-MEX 30' of the defendant being passed off as medicine 'DIAMICRON XR MEX 500' of the plaintiff because:

(I) It is not the case of the plaintiff that its medicine is known as 'MEX' only;

(II) The prefix 'DIABEND' and the suffix '30' and '60' in the mark of the defendant being capable of distinguishing the said mark from the prefix 'DIAMICRON XR' and suffix '500' in the mark of the plaintiff;

(III) The plaintiff being not entitled to monopolise 'MEX' which according to the plaintiff also is an acronym for 'Metformin Extended Release' being an active ingredient in the medicine of both.

27. In addition to the aforementioned cases, mention may also be made of:

(a). ***Amritdhara Pharmacy Vs. Satya Deo Gupta*** AIR 1963 SC 449 laying down that it is not right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole; it is dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other.

(b). ***Reckitt & Colman of India Ltd. Vs. Medicross Pharmaceuticals Pvt. Ltd.*** 1992 SCC OnLine 195 holding that comparison has not to be microscopic but general and casual, as that of a customer walking into a shop.

Applying the said test, I am unable to allow the claim of the plaintiff.

(c). ***Panacea Biotec Ltd. Vs. Recon Ltd.*** 1996 (38) DRJ 732 holding that where a trade mark of the medicinal preparation is wholly derived from the name of the principal drug used in its manufacture, the protection which is available in the case of invented word, would not be forthcoming.

Applying the said test, the admission of the plaintiff of "MEX" being an acronym of 'Metformin Extended Release' disentitles the plaintiff to any relief.

(d). ***Astrazeneca UK Ltd. Vs. Orchid Chemical & Pharmaceuticals Ltd.*** ILR (2007) I Delhi 874 where finding "MERO" which was common to both the competing marks to be taken by both the plaintiff as well as the defendant from the drug 'MEROPENEM', it was held that neither could raise any claim to exclusive use thereof. It was also held that the marks 'MERONEM'

and 'MEROMER' taken as a whole could not be said to be either phonetically and visually or in any manner deceptively similar to each other.

The same is the position of 'DIAMICRON XR MEX 500' and 'DIABEND-MEX 60'. "MERO", in that case also was found to be descriptive.

(e). ***Aviat Chemicals Pvt. Ltd. Vs. Intas Pharmaceuticals Ltd.*** (2001) 93 DLT 247 holding that (i) nobody can claim exclusive right to use any word, abbreviation which has become *publici juris*; and, (ii) in the trade of drugs, it is common practice to name a drug by the name of the organ or ailment which it treats or the main ingredient of the drug; such organ, ailment or ingredient become *publici juris* or generic and cannot be owned by anyone for use as a trade mark.

28. I am also of the view that the plaintiff cannot restrain the defendant from using the white and pink colours for its tablets. There are a large number of other medicines with the same colour combination.

29. I am also of the view that the whole case of the plaintiff was premised on passing off being possible owing to the defendant also using the same colour combination and trade dress for its medicine and which has since been given up by the defendant. The plaintiff, on the basis of mark alone, has neither claimed any right nor is found entitled to have any right.

30. Having not found the plaintiff entitled to the relief of injunction, the question of enquiry into the ancillary reliefs claimed does not arise and thus the suit itself has to be disposed of.

31. The suit is thus dismissed, save for binding the defendant to their statement aforesaid of not reverting to the packaging as earlier being used at the time of institution of the suit.

32. However, the counsels having cooperated in expeditious disposal of the suit, no costs.

33. Decree sheet be drawn up.

RAJIV SAHAI ENDLAW, J.

NOVEMBER 22, 2018
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(Corrected & released on 18th January, 2019)