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

\+ **IA Nos. 19404/2011 (O.XXXIX R.1 & 2 CPC) & 7794/2012 (O.XXXIX R.4 CPC) in CS(OS) 3024/2011**

% Reserved on: 22nd November, 2013
Decided on: 10th January, 2014

SMITHKLINE BEECHAM LTD & ANR ..... Plaintiff
Through Mr. Manav Kumar, Mr. Manoj Kumar Sahu, Advs.

versus

HANISH K AJMERA & ANR ..... Defendant
Through Mr. Gautam Panjwani, Mr. Rahul Malik, Advs.

Coram:
HON'BLE MS. JUSTICE MUKTA GUPTA

1. Both the applications can be decided by a common order as one seeks grant of interim injunction pending the disposal of the suit and the other vacation of the ad interim injunction granted on 12th December, 2011 by this Court in favour of the plaintiff.

2. Learned counsel for the plaintiff contends that the registration of the trademark CROCIN a Paracetamol tablet in favour of the plaintiff relates back to 26th April, 1982. CROCIN is a household name used everywhere. No part of the plaintiff's mark CROCIN is derived from the Paracetamol and is a coined and adopted name. The defendant infringed the trademark of the plaintiff by adopting the trademark PIROCIN for their Paracetamol tablet. The defendant has not been able to show how it adopted the mark PIROCIN as neither the same relates to the salt in the medicine nor the diseases to be cured. Since it is a case of infringement of plaintiff's trademark the plaintiff

is only required to show that the marks are similar and once the same is shown no further evidence is required to be led. The plaintiff's existence in India dates back to 1963 when it was first adopted by Dhapur Interfan Limited. The mark was then acquired by Smithkline Beecham Plc. In 2010 Smithkline Beecham Plc changed its name to Smithkline Beecham Limited and became the proprietor of mark CROCIN in India. Medicinal preparation under the mark CROCIN are extremely popular and widely consumed in India and the plaintiff's have incurred substantial expenditure in establishing their goodwill and reputation. The blister blue strip packaging of CROCIN launched since the year 2002 has acquired great recognition and thus in addition to being licensed user of the registered trademark CROCIN owned by plaintiff No.1, plaintiff No.2 is the owner of the copyright in the artistic work comprising CROCIN blue blister packaging. Not only the defendants have copied the trademark of the plaintiffs, but have also copied the phrase used "the effective relief from pain - gentle on stomach". Thus, the defendants are copying all the essential features of the plaintiff's mark. The defendants are also in the pharmaceutical business. In 2010 the plaintiff's were alerted to the sale of analgesic and anti-pyretic tablets by the defendant. The defendants have adopted the mark PIROCIN virtually identical to the plaintiffs' well-known and registered CROCIN mark and merely replaced the alphabet 'C' with 'PI'. The members of the trade and purchasing public are likely to perceive the defendants' products as originating from the plaintiffs'; which is absolutely false. Further, the two rival marks are virtually identical. The two products with rival marks are used for identical purposes i.e. both provide relief from pain, the class of consumers directly overlap and the channel of trade is also identical. The plaintiffs sent a legal

notice to the defendant. The stand of the defendant in the reply to the legal notice is different than the written statement. Even the name of the product has been mentioned wrongly. The defendant failed to mention, since when they were using the name and how they acquired the same. The defense taken is that the two marks are not similar. Both are honest and concurrent user of the marks. In case of infringement of the trademark, once marks are found to be similar then honest and concurrent use has no relevance. Secondly, the mark has to be compared as a whole and the same cannot be dissected. The principle to be applied is that of an ordinary man with imperfect recollection. The defendant's plea of want of territorial jurisdiction is also not maintainable, as the plaintiff has an office in Delhi as is mentioned in memo of parties. Thus, the plaintiff works for gain in Delhi. Further, the plaintiff's goods are extensively sold in Delhi. The plaintiff has also filed the sale invoices relating to Delhi. The case of the defendant that the registration is bad and is not valid is not relevant for the present suit, as for the same he has to file an application before the Registrar of Trade Marks. The plea of delay and latches is also unfounded. Though the defendant claim to be using PIROCIN since 1998, the plaintiff has come to know about the same now. Thus, the plaintiff immediately sent a notice to the defendant. The protection under Section 34 of the Trademarks, as claimed by the defendant, is not available to the defendant. Merely because the plaintiff has not taken action against other users of the mark 'CIN' in their pharmaceutical preparation would not render any benefit to the defendant. Reliance is placed on *Cadila Health Care Ltd. Vs. Cadila Pharmaceutiacals Ltd. AIR 2001 SC 1952; Kaviraj Pandit Durga Dutt Sharma Vs. Navratna Pharmaceutical Laboratories AIR 1965 SC 980;*

Automatic Electricc Ltd. Vs. R.K. Dhawan & Anr. 77 (1999) DLT 292; Corn Products Refining Vs. Shangrila Food Products AIR 1960 SC 142; Himalaya Drug Company Vs. S.B.L. Limited 2030 (53) PTC 1(Del)(DB); United Biotech Vs. Orchid Chemicals and Pharmaceutical Limited 2012 (50) PTC 433 (Del.) (DB): Pankaj Goel Vs. Dabur India Ltd. 2008 (38) PTC 49 (Del) (DB); Novartis AG Vs. Crest Pharma Pvt. Ltd. & Anr. 2009 (41) PTC (57)(Del); Go Delhi Luxury Vs. Go Delhi Tours 2012 (51) PTC 273 (Del); Express Bottlers Service Vs. Pepsi Inc. & Ors. 1989 (14) PTC 14 (Del); Anglo French Drugs & Industries Ltd. Vs. Eisen Pharmaceutical Company Pvt. Ltd. 1998 (1) ARB LR 61; Simatul Chemical Industries Pvt. Ltd. Vs. Citabul Ltd. PTC SUPPL. 1 600 (Guj)(DB); Amritdhara Pharmacy Vs. Satya Deo Gupta AIR 1963 SC 449; M/s. Hindustan Pencils Pvt. Ltd. Vs. M/s. India Stationery Products Co. and Anr. AIR 1990 DELHI 19; Midas Hygiene Industries P. Ltd. & Anr. Vs. Sudhir Bhatia & Ors. 2004 (28) PTC 121 (SC) and Laxmikant V. Patel Vs. Chetanbhat Shah & Anr. 2002 (24) PTC 1 (SC).

3. Learned counsel for the defendant on the other hand contends that the injunction is liable to be vacated because the plaintiff has concealed material facts from this Court. The defendant is preparing ayurvedic medicine which material fact has not been stated in the plaint. Reliance is placed on *S.P. Chengalvaraya Naidu Vs. Jagannath AIR 1994 SC 853; T. Arivandandam Vs. T.V. Satyapal and Anr. AIR 1977 SC 2421 and Satish Khosla Vs. Eli Lilly Ranbaxy Ltd. 71 (1998) DLT 1*. Though the defendant did not state that it was manufacturing and selling ayurvedic medicine in its reply to the legal notice of the plaintiff, however in the second reply the defendant stated that it was manufacturing and selling ayurvedic medicine which reply has not

been filed along with the documents by the plaintiffs. The mark CROCIN is not an invented word and is a word in the dictionary which means saffron. The plaintiffs are neither honest adopter nor the registered owner of the trademark. There are number of medicines ending with the alphabet 'CIN' who are prior adopters than the plaintiff. There are number of distinctions between the two marks i.e. CROCIN and PIROCIN. CROCIN is allopathic medicine used for cold and fever only, the price of 15 tablets is Rs. 20.35/-, Overdose can potentially damage the liver, it is packed in a blue packaging, cannot be taken without the Doctor's prescription and its composition is Paracetamol 500 mg, caffeine 25 mg and Phenylephrine 5 mg, no particular course of medicine is required and is available in almost every general store and medical shops, shape and colour of the tablet is round and white, is a Schedule 'H' drug, whereas PIROCIN is used in cold, fever, headache and bad throat etc., is a ayurvedic medicine, the price of 10 tablets is Rs. 125/-, there are no side effects, is packed in silver transparent packaging, is sold solely on medical prescription, the composition of drug is herbal and ayurvedic, it has a minimum course of five days, is available only in particular ayurvedic medicine shops, the tablet is not round in shape, the colour of the tablet is light brown, there is nothing written on the tablet and below PIROCIN it is written analgesic and anti-pyretic along with being an ayurvedic medicine and is sold in Madhya Pradesh and Southern Parts of India only. This Court has no territorial jurisdiction to entertain the suit as the defendant has no existence in Delhi. As per the documents filed the plaintiff's registered office is in Gurgaon. The sale invoices filed relate to the period of 2005-2006 whereas the suit has been filed in 2011. The plaintiffs have failed to show that at the time of institution of suit, the

plaintiffs are carrying on business in Delhi, as is the requirement under Section 34 of the Trade Marks Act. The availability of plaintiff's goods in Delhi will not confer territorial jurisdiction on this Court as held in *Archie Comic Publications Inc Vs. Purple Creations Pvt. Ltd. & Ors. 2010 (44) PTC 520 (Del) (DB*). Reliance is placed on *M/s. Dhodha House Vs. S.K. Maingi AIR 2006 SC 730; Alberto Co. Vs. R.K. Vijay & Ors. 2010 (42) PTC 300 (Del) and Sholay Media Entertainment and Anr. Vs. Yogesh Patel and Ors. MIPR 2010 (1) 268 (Del).* Since the defendant has no existence in Delhi and the products of the defendant are not sold in Delhi, Section 20 CPC also is not attracted. Relying upon *F. Hoffmann- La Roche and Co. Ltd. Vs. Geoffrey Manners and Co. Private Ltd. AIR 1970 SC 2062* it is contended that the Supreme Court dismissed the appeal against the order of the High Court where injunction was asked in two similar trademarks i.e. DROPOVIT and PROTOVIT. Relying upon *M/S Gufic Ltd. & Anr. Vs. Clinique Laboratories, Llc & Anr., FAO (OS) No. 222/2009* decided by this Court on 29th May, 2009 it is contended that in view of the marked difference in the two medicines, the customers, price, one being ayurvedic and other allopathic and on a comparison as a whole, there is no deception and no similarity. Reliance is also placed on *Apex Laboratories Ltd. Vs. Zuventus Health Care Ltd. 2006 (33) PTC 492 (Mad)(DB); Aviat Chemicals Pvt. Ltd. and Anr. Vs. Intas Pharmaceuticals Ltd. 93 (2001) DLT 247; Astrazeneca Uk Limited and Anr. Vs. Orchid Chemicals 2007 (34) PTC 469 (Del)(DB); Shri Atul Rawal Vs. M/S S.B. Equipments 2010 (43) PTC 521 (Del); ACME Pharmaceutical Vs. Torrent Pharmaceuticals Ltd. MIPR 2010 (1) 0217; B.L. & Co. Vs. Pfizer products Inc. 2001 (93) DLT 346 (DB); Schering Corporation & Ors. Vs. Getwell Life Sciences India 2008 (37) PTC*

487 (Del); Korpan Chemical Co. Ltd. Vs. Sigma Laboratores 1993 (13) PTC 245 (Bom); East African (1) Remedies Pvt. Ltd. Vs. Wallace Pharmaceuticals Ltd. & Anr. 2003 (27) PTC 18 (Del); Schering Corporation & Ors. Vs. Alkem Laboratories Ltd. 2010 (42) PTC 772 (Del)(DB); Cipla Limited Vs. M.K. Pharmaceuticals 2008 (36) PTC 166 (Del); Inco-Pharma Pharmaceuticals Vs. Citadel Fine Pharmaceuticals AIR 1998 Madras 347 Division Bench and Rich Products Corporation & Anr. Vs. Indo Nippon Food Limited 2010 (42) PTC 660 (Del).

4. Heard learned counsel for the parties. The facts relevant to the applications are borne out from the contentions of the learned counsel for the parties and thus this Court proceeds to deal with the contentions raised.

5. Learned counsel for the defendant has strenuously contended that the factum of the defendant's product being an ayurvedic medicine has been concealed from this Court and thus the plaintiff is not entitled to an injunction from this Court. The case of the defendant is that the second reply given by the defendant has not been filed on record. The plaintiff had issued a legal notice to the defendants on 17th March, 2010. The defendant replied to the said notice vide its letter dated 24th March, 2010 wherein there is no reference to the fact that the drug of the defendant is an ayurvedic drug and further even the name of the medicine has been wrongly spelt as PYROCIN. The plaintiff again replied back vide its letter dated 18th May, 2010. It is the case of the defendant that he had sent a reply to the letter of the plaintiff dated 18th May, 2010 which has not been filed. Learned counsel for the plaintiff has contended that the defendant has not filed any document to show that the said reply to the letter of the plaintiff dated 18th May, 2010

was received by the plaintiff. The plaintiff in fact never received any such reply and thus could not have filed it. Without going into the controversy whether the reply by the defendant to the letter of the plaintiff dated 18th May, 2010 had been sent by the defendant or not, or received by the plaintiff or not, suffice it is to note that the plaintiff has placed on record the packaging of the strip of tablet of the defendant at page 4 of its document, which itself notes that PIROCIN is an ayurvedic medicine, and thus, it cannot be held that the plaintiff concealed material facts before this Court and thus the injunction is liable to be vacated in view of the law laid down in *S.P. Chengalvaraya Naidu Vs. Jagannath AIR 1994 SC 853; T. Arivandandam Vs. T.V. Satyapal and Anr. AIR 1977 SC 2421 and Satish Khosla Vs. Eli Lilly Ranbaxy Ltd. 71 (1998) DLT 1*.

6. The second contention of the defendant is that this Court has no territorial jurisdiction to entertain the present suit. In fact, this was framed as issue No.5 and was directed to be treated as a preliminary issue. After hearing the parties this Court has already held that since the issue involves mixed question of fact and law, the same cannot be treated as a preliminary issue in view of the law laid down in *Ramesh B. Desai & Ors. Bipin Vadilal Mehta & Ors. AIR 2006 SC 3672*. However, this Court is dealing with this issue only to form a prima facie opinion on the issue of interim injunction. Section 134 of the Trade Marks Act provides that a suit for the infringement of a registered trademark or any right relating thereto can be filed in a Court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceedings, the person instituting the suit or proceedings, actually or voluntarily resides or carries on business or personally works for

gain, notwithstanding the provisions contained in the Code of Civil Procedure, 1908. As per the memo of parties, the plaintiff has a sales depot in the name of Glaxosmithkline Consumer Healthcare Limited at 619/1, Chattarpur, New Delhi 110030. The plaintiff in Para 30 of the plaint has stated that the plaintiffs have their office and carries on business in Delhi and are thus voluntarily working within the jurisdiction of this Court. The plaintiff has placed on record sale invoices pertaining to the medicine CROCIN from its Smithkline Beecham Consumer Healthcare Limited office. The case of the defendant is that the said invoices relate to the period 1996, 2004, 2005 and 2006. Thus, at the moment the plaintiff is not working for gain in Delhi as it has closed down its office. Merely on an oral averment by the learned counsel for the defendant that the plaintiff has closed down its office at Chattarpur, it cannot be said that the plaintiff is not working for gain in Delhi. There is a specific averment in Para 30 with regard to carrying on business at Delhi. The address of the Delhi office i.e. Sales Depot at 619/1 Chattarpur, New Delhi has been mentioned. Sale invoices till the period 2006 have been filed. Thus, at this stage prima facie on the basis of averments in the plaint, it cannot be said that the plaintiff is not carrying on business at Delhi and thus no interim injunction be granted because this Court has no territorial jurisdiction to try the suit. Reliance on the decision in *Archie Comic Publications Inc Vs. Purple Creations Pvt. Ltd. & Ors. 2010 (44) PTC 520 (Del) (DB*) is misconceived as in the said case this Court came to the conclusion that when there is a total inherent lack of jurisdiction on the basis of averments in the plaint itself, then the Court has no power to even permit amendment of the plaint. In the present case as per the facts pleaded in the plaint territorial jurisdiction of this Court is made

out, further subject to the parties leading evidence in this regard, and thus the interim injunction cannot be refused to the plaintiff on this ground.

7. In Gufic the word VIT was derived from the word Vitamin and both PROTOVIT and DROPOVIT were held to be distinct as the word VIT was essential to the trade both drugs being vitamins and the words 'PROTO' and 'DROPO' were distinct words. In the present case word 'CIN' neither relates to the salt in the drug nor the ailment it cures.

8. The present is a suit for infringement of the trademark of the plaintiff as the plaintiff has placed on record documents to show that plaintiff No.1 is the registered owner of the trademark CROCIN. In *Ruston & Hornsby Limited Vs. The Zamindara Engineering Co. 1969 (2) SCC 727* the Supreme Court in Para 7 held:

> "7. In an action for infringement where the defendant's trade mark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. But where the alleged infringement consists of using not the exact mark on the register, but something similar to it, the test of infringement is the same as in an action for passing-off. In other words, the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing-off actions."

9. In *Ramdev Food Products (P) Ltd. Vs. Arvindbhai Rambhai (2006) 8 SCC 726*, at page 765 in Para 91 the Supreme Court held:

> "Although the defendant may not be using the actual trade mark of the plaintiff, the get-up of the defendant's goods may be so much like the plaintiff's that a clear case of passing-off could be proved. It is also possible that the defendant may be using the plaintiff's mark, the get-up of the defendant's goods may be so different from the get-up of the

plaintiff's goods and the prices also may be so different that there would be no probability of deception to the public. However, in an infringement action, an injunction would be issued if it is proved that the defendant is improperly using the plaintiff's mark. In an action for infringement where the defendant's trademark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. The test, therefore, is as to likelihood of confusion or deception arising from similarity of marks, and is the same both in infringement and passing-off actions"

10. In *Kaviraj Pandit Durga Dutt Sharma Vs. Navratna Pharmaceutical Laboratories AIR 1965 SC 980* it was held:

"28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negativing the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as

those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods" (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."

11. Thus, in view of the legal position as laid down in *Kaviraj Pandit Durga Dutt Sharma (supra*) in an action for infringement where the plaintiff is able to show that the defendant's mark is likely to deceive either due to visual, phonetic or otherwise similarity, and the Court reaches a conclusion that there is an imitation, no further evidence is required to be established that the plaintiff's rights are violated. In the present case, learned counsel for the defendant has strenuously sought to support that there are numerous

differences between the two marks, as the packaging's are different, the price is different, one is allopathic medicine and the other is an ayurvedic medicine. However, the fact remains that there is a very close phonetic similarity between the two trademarks PIROCIN and CROCIN. Both the medicines are used for the same ailment i.e. relieving the pain, both are analgesics and soft on stomach, and there is not much variation in the prices of the two strips. Thus, the ex-parte ad interim injunction in favour of the plaintiff is required to be made absolute till the disposal of the suit.

12. Consequently IA 19404/2011 filed by the plaintiff under Order XXXIX Rule 1&2 is allowed and the order dated 12th December, 2011 is made absolute till the disposal of the suit and I.A No. 7794/2012 filed by the defendant for vacation of interim injunction under Order XXXIX Rule 4 CPC is dismissed.

(MUKTA GUPTA)
JUDGE

JANUARY 10, 2014
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