

IN THE HIGH COURT OF DELHI AT NEW DELHI

FAO NO. 123 OF 2004

Date of Decision : December 16, 2008

Ranbaxy Laboratories Limited Appellant
Through Mr. Rajiv Nayyar, Sr. Advocate with
Mr. H.P.Singh, Advocate

Versus

M/s Cipla Limited Respondent
Through None.

CORAM :

HON'BLE MR. JUSTICE SUDERSHAN KUMAR MISRA

1. Whether Reporters of local papers may be allowed to see the judgment? No
2. To be referred to the Reporter or not? No
3. Whether the judgment should be reported in the Digest? No

SUDERSHAN KUMAR MISRA, J.

1. This is an appeal against an interim order passed by the learned Additional District Judge on 23rd March, 2004. By that order, an application under Section 135(2) of the Trade Marks Act, 1999 read with Order 39 Rules 1 and 2 and Section 151 of the Code of Civil Procedure, 1908 filed by the respondent-M/s Cipla Limited, has been allowed and the defendant, who is the appellant before this Court, has been restrained from manufacturing, selling, offering for sale, advertising or directly or indirectly dealing in 'Enflox 400' manufactured in Orange coloured, oval

shaped tablets that are packed in blister packs, till the disposal of the respondent's suit by that court.

2. The case of the respondent/plaintiff before the learned Additional District Judge was that for over 16 years, it has been using the trade mark "Norflox" continuously and exclusively throughout the country on a very large scale and that it had started manufacturing and marketing "Norflox 400" in distinctive, orange coloured, oval shaped tablets since the year 1987. It was claimed that this blister packaging of the plaintiff/respondent containing the distinctive orange coloured, oval shaped tablet constitutes a trade mark, the exclusive right of use of which is reserved to the plaintiff/respondent alone. The plaintiff claimed sales worth hundreds of crores and also claimed to have spent many crores in advertising and promoting this product. The plaintiff contended that on 12th February, 2004, it discovered that the defendant/appellant has launched a similar product with identical oval, orange coloured tablets in blister packs, and that this constitutes passing off. The plaintiff contended that the shape and colour of the tablets produced by the defendant are deceptively similar to its own product and is likely to lead to confusion amongst the purchasing public and the trade, and that it constitutes an unfair attempt on the part of the defendant/appellant to take advantage of the business and goodwill generated by the plaintiff/respondent with regard to sale of this product. On these grounds, the plaintiff had prayed that the defendant be restrained from manufacturing, offering for sale or advertising or directly or indirectly dealing in pharmaceutical preparations

with orange coloured oval shaped tablets of 'Enflox' packed in blister packs till the disposal of the suit by the trial court. Before that court, it was admitted that the drug in question is a schedule 'H' drug, meaning thereby, that the preparation cannot be sold except on prescription of Registered Medical Practitioner. The plaintiff however contended that despite this, such drugs are commonly sold without any doctor's prescription and, therefore, in view of the likelihood of deception due to similar colour, shape and packaging of the tablets, the plaintiff is entitled to interim relief. Before the trial court, it was conceded that there is no challenge to the name adopted by the defendant/appellant and that the same is visually and phonetically different from the name adopted by the plaintiff/respondent. Plaintiff's case was confined to the fact that the defendant/appellant was selling the drug in a colour, shape and packaging similar to that adopted earlier by the plaintiff/respondent. The plaintiff claimed that since the matter involves a medicinal preparation, therefore, similarity and likelihood of the one being mistaken for the other must be more readily inferred in the interest of the consuming public. Agreeing with the plaintiff, the learned Additional District Judge has taken the view that even though the law requires that this product can only be sold under the prescription of a Registered Medical Practitioner, however, ".... this fact alone is not sufficient to prevent confusion which is otherwise likely to occur". According to learned Additional District Judge, since a large percentage of the population is illiterate, confusion between the two products is possible, and keeping in mind that medicinal products are

involved, even a lesser possibility of confusion is enough to grant an injunction. The learned trial court has concluded that this is a case of passing off and even if no confusion or deception may be caused to the dealer or the stockists, unwary purchasers might still be deceived. The contention of the defendant/appellant that various other manufacturers are also using similar orange coloured oval shaped tablets in blister packs for their drugs was not considered worthy of any merit by the learned ADJ in deciding the issue.

3. There is no appearance on behalf of the respondent despite service. In this matter, notice was accepted by counsel for the respondent on 21st April, 2004 in Court and both counsel had consented that the matter be listed for final disposal on 22nd May, 2004. Respondent did not wish to file any reply. On that date, the impugned order was also stayed. Thereafter, the matter was repeatedly adjourned, either on joint request or on request of counsel for one of the parties. Some adjournments were also sought to enable parties to explore the possibility of a settlement. Ultimately, on 8th July, 2008, since there was no appearance on behalf of the respondent, this court adjourned the matter to 26th September, 2008 and learned counsel for the appellant undertook to inform counsel for the respondent that the matter is posted for that date. On 26th September, 2008, learned counsel for the appellant stated that he had informed counsel for the respondent in writing that the matter was posted for that date. There was, however, no appearance on behalf of the respondent. Counsel for the appellant also informed the court that the same issue involved has

also been decided by an order of this Court passed in Cipla Limited vs. M.K.Pharmaceuticals 2008(36) PTC 166 (Del.) decided on 23rd July, 2007. Ultimately, this Court adjourned the matter for final disposal to 10th November, 2008. On 10th November, 2008 also, since there was no appearance on behalf of the respondent, the matter was finally heard in its absence.

4. The aforesaid case of CIPLA Ltd. (supra) is directly on the point and squarely covers the issue that has arisen for decision in this appeal. The said suit was instituted by M/s Cipla Ltd. who happens to be the respondent in this appeal. There, M/s Cipla Ltd. had moved an application under Order 39 Rules 1 and 2 CPC seeking an interim injunction to restrain one M/s M.K.Pharmaceuticals from marketing and selling “Norfloxacin” under its generic name because the tablets offered for sale by M/s M.K. Pharmaceuticals happened to have the same colour, shape and packaging as that of ‘Norflox’ sold by M/s Cipla. In the instant case also, M/s Cipla have mounted the same challenge on the same grounds against M/s Ranbaxy Laboratories Ltd. i.e. the appellant before this Court. In the case brought by M/s Cipla against M/s M. K. Pharmaceuticals, this Court concluded that although undisputedly the packaging, shape and colour of the tablets of the plaintiff as well as the defendant is similar, however, in view of the fact that blister form of packaging of tablets is a common and prevalent type of packaging used for 50% of the tablets in the market, the plaintiffs can have no monopoly over a particular form of packaging and cannot pray that no one else should

offer its medicine in that fashion. With regard to the colour and shape of the tablets, this Court had stated as follows:-

“5. The next issue arises whether defendant can copy the colour of the plaintiff’s tablets and shape of the plaintiff’s tablets. It is settled law that there can be no monopoly over colours. The plaintiff is in the field of manufacturing a wide range of medicines. Plaintiff may colour its tablets in any colour starting from violet to red. Merely because plaintiff has started using a particular colour for its tablets plaintiff does not get monopoly over colour so that no one else can use that colour.

The medicines are not bought by colours by the customers. There are thousand types of tablets available with Chemist for different ailments. No one goes to a chemist and asks for red, blue, orange, peach or white colour of tablets. All medicines are purchased at the advise of Doctors and they are sold on prescription. Even those tablets readily available without prescription, are known by their names. You will not find any manufacturer advertising his tablets by colour or shape. Even the common brands Crocin, Anacin, Disprin, Coldarin etc. are sold by name and not by shape or colour of the tablets. It is preposterous to believe that a person would go to the Chemist and ask the Chemist to give him tablets of such and such colour for such and such ailments. Neither colour of the tablet can be associated with any brand. Similar is the case of the shape. Shape of the tablets is not associated either with the quality of the tablets or with the nature of medicine. Most of the tablets are made round, oval or cylindrical shape so that they are easy to swallow. It would be very hard to get tablets in the rectangular or square shape in the market unless they are chewing tablets or sucking tablets. It cannot be said that because the shape of the plaintiff tablets and defendant’s tablets being oval, it was going to create confusion in the minds of the customers.

The distinctiveness of the medicines is in the name and not in the colour and shape. Even if there has been deliberate copying of similar colour and shape of the plaintiff’s tablets that would not amount to passing off, since colour and shape are not indicative of the drugs neither they are associated with the trade mark. There may be several other tablets of

the similar shape and colour available in the market. I am supported in my above view by **Rizla Limited v. Bryant and May Limited 1986 RPC 389; Smith, Kline and French Laboratories Ltd's Cinetidine Trade Mark (1991) RPC 17 Ch.D.Surya Roshni Limited v. Metalman Industries Limited 2001 PTC 777 (Del.); Colgate Palmolive Com. Limited and Anr. V. Patel and Anr. 2005(31) PTC 583 (Del.)."**

5. The above decision deals with the same product of the plaintiff/respondent. It also deals with an identical grievance, albeit regarding another manufacturer. There, the manufacturer was M/s M.K. Pharmaceuticals. Here, the manufacturer is the appellant - M/s Ranbaxy Laboratories Ltd. There is no other difference. The issue in this appeal is thus squarely covered by the ratio of the decision in the aforesaid judgment of **M/s Cipla Limited (supra)**. Consequently, the interim order passed by this Court on 21st April, 2004 is made absolute and the impugned order dated 23rd March, 2004 passed by the learned Additional District Judge is set aside. The appeal is accordingly allowed.

Sudershan Kumar Misra, J.

December 16, 2008
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