

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

+ **Ex.P. No. 81/2005**
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11th August, 2015

LILLY ICOS LLC.

..... Decree Holder

Through: Mr. Chander M. Lall, Ms. Nancy Ray
and Mr. Anuj Nain, Advs.

versus

AJANTA PHARMA LIMITED
Debtor

..... Judgment

Through: Mr. Rajiv Nayar, Sr. Adv. with Mr.
Yogender Nath Bhardwaj, Adv.

CORAM:
HON'BLE MR. JUSTICE VALMIKI J.MEHTA

To be referred to the Reporter or not?

VALMIKI J. MEHTA, J (ORAL)

1. This execution petition has been filed by the decree holder alleging violation by the judgment debtor of the Order and decree of this Court dated 22.5.2004. The decree is a consent decree. The suit being CS(OS) No. 159/2004 which was decreed pertained to disputes between the parties on account of the cause of action pleaded by the decree holder/plaintiff of the judgment debtor/defendant using the trade mark

“CIALIS” or any other mark deceptively similar to “CIALIS” such as “INDIAN CIALIS”, “GENERIC CIALIS” or “APCALIS”. Decree holder/plaintiff *inter alia* had sought restraint against the use or depiction on the packages of the defendant/judgment debtor, a “SWIRL” of the decree holder/plaintiff which is referred to as a “CIALIS SWIRL”. There was also the cause of action and relief as claimed by the decree holder/plaintiff with respect to an almond shaped light yellow colour tablet sold by the decree holder/plaintiff under the trade mark “CIALIS” and same type of the tablet being used by the judgment debtor/defendant.

2. With respect to the disputes by the consent Order and decree dated 22.5.2004, basically the following three agreements/directions were agreed/enforced:-

(i) The judgment debtor/defendant if it uses the trade mark “APCALIS”, the same will be used along with the suffix SX i.e any of the product which is to be sold by the judgment debtor/defendant will be sold as “APCALIS-SX” and not without the suffix SX.

(ii) The judgment debtor/defendant will not use the almond shaped light yellow colour tablet which the decree holder/plaintiff was using for sale of its tablets under the trade mark “CIALIS”, and that the judgment

debtor/defendant will change its tablets from almond shape of light yellow colour to oval shape of cream colour.

(iii) The judgment debtor/defendant will not use the depiction “CIALIS SWIRL” of the decree holder/plaintiff.

3. In addition to the aforesaid three consent terms, there are observations which are recorded in the consent Order dated 22.5.2004 that the judgment debtor/defendant will not permit anyone else to use “CIALIS”, “INDIAN CIALIS” and/or “GENERIC CIALIS”.

4. Taking the last aspect first of the judgment debtor/defendant not permitting anyone else to use CIALIS, INDIAN CIALIS and/or GENERIC CIALIS whether in advertisement or publicity materials etc, the statement of the judgment debtor/defendant as recorded in the Order dated 22.5.2004 would and can only be with respect to persons who are under the control of the judgment debtor/defendant. Such persons under the control of the judgment debtor/defendant would include agents or servants of the judgment debtor/defendant. The effective direction would therefore in terms of the Order dated 22.5.2004 would be that the judgment debtor/defendant must at least write to its agents or servants that they shall not correlate products of the judgment debtor/defendant with “CIALIS, INDIAN CIALIS and/or

GENERIC CIALIS”, that the mark APCALIS will be used with the suffix ‘SX’, and, that the judgment debtor/defendant cannot use CIALIS SWIRL of the decree holder/plaintiff.

5. The valid grievance of the decree holder/plaintiff is that there are various websites which may not be owned or controlled by the judgment debtor/defendant if the case of the judgment debtor/defendant is accepted, these websites, some of which have been referred to in the execution petition and the subsequent affidavits and documents filed, are not only using the “CIALIS SWIRL” with respect to product “APCALIS” that too without the suffix ‘SX’, but also that the product of the judgment debtor/defendant is being called as similar to CIALIS, INDIAN CIALIS and/or GENERIC CIALIS.

6. Learned counsel for the judgment debtor/defendant however contends that the judgment debtor/defendant has never at any point of time asked the owners of these websites or any other persons to sell the products of the judgment debtor/defendant by depicting the products as “APCALIS” without the suffix SX or containing the “CIALIS SWIRL” or making comparison of the product of the judgment debtor/defendant with the marks CIALIS, INDIAN CIALIS and/or GENERIC CIALIS.

7. In order to resolve the disputes, so far as this issue of violation of the consent Order and decree dated 22.5.2004 is concerned, it will suffice if the judgment debtor/defendant will write to its agents or any person to whom the judgment debtor/defendant is selling its products i.e such agents or persons who are under the direct control of the judgment debtor/defendant, that the products which are being sold by the judgment debtor/defendant should not be depicted as would cause the products to be shown only as “APCALIS” without the suffix SX or having a “CIALIS SWIRL” or are equated to CIALIS, INDIAN CIALIS and/or GENERIC CIALIS. I may note that it is the contention of the judgment debtor/defendant that it has no control over any of the websites on which its products are sold and the products which are sold by the judgment debtor do contain the suffix SX after the mark “APCALIS”. Counsel for the judgment debtor/defendant also states that in no products which are manufactured and supplied by the judgment debtor/defendant the “CIALIS SWIRL” is being used and if the “CIALIS SWIRL” or the trade mark “APCALIS” without the suffix SX or calling the product of the judgment debtor/defendant as CIALIS etc is being used by certain websites, the judgment debtor/defendant would have no objection if the decree holder/plaintiff sues such persons to ensure true and complete compliance of the consent Order and decree dated

22.5.2004. Accordingly, this issue is disposed of with the direction that in case the decree holder/plaintiff brings to the notice of the judgment debtor/defendant that if certain websites are selling the products of the judgment debtor/defendant in violation of the consent decree dated 22.5.2004, and if such websites have direct nexus/link with the judgment debtor/defendant whereby the judgment debtor/defendant is directly supplying its products to the customers of these websites, then the judgment debtor/defendant will give the addresses of the person/or persons who are running such websites so that the decree holder/plaintiff can cause compliance of the consent decree dated 22.5.2004.

8. In case, the decree holder/plaintiff feels that consent decree dated 22.5.2004 is violated by persons who are not under the direct control of the judgment debtor/defendant, the decree holder/plaintiff can always file appropriate independent execution proceedings alleging violation with respect to the consent decree dated 22.5.2004 by such persons.

9. So far as the aspect of the judgment debtor/defendant not being entitled to sell its products with almond shape with light yellow colour is concerned, though there are disputes which are raised in view of the affidavit dated 24.3.2009 filed on behalf of the decree holder/plaintiff (and assuming

that the subsequent violation of 2009 can be taken as a basis for execution of a petition filed in 2005) because the judgment debtor/defendant has denied the claim made in the affidavit dated 24.3.2009 of Mr. Douglas K. Norman, by its reply affidavit dated 3.2.2010 of Sh. Nikhil Bhatt, this issue is agreed to be disposed of with the consent order that the judgment debtor/defendant will in no case or circumstance will ever in future use the almond shaped tablet with light yellow colour and will use an oval shaped tablet with cream colour as per the defendant's/judgment debtor's consent recorded in the Order dated 22.5.2004.

10. That takes us to the final aspect as to the use of “CIALIS SWIRL” which is prohibited in terms of the consent Order and decree dated 22.5.2004. This aspect also will stand disposed of by giving directions which have already been given above with respect to the agents and servants who are under the direct control of the judgment debtor/defendant. The directions therefore issued on the first aspect discussed above, will *mutatis mutandis* apply with respect to “CIALIS SWIRL” of the decree holder/plaintiff.

11. No other issue is pressed or arises before this Court.

12. The execution petition is accordingly disposed of in terms of the observations and directions contained hereinabove.

AUGUST 11, 2015
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VALMIKI J. MEHTA, J.