

IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

SUIT NO. 482 OF 2013

Ajanta Pharma Limited,]
a company incorporated under the Companies Act, 1956,]
having its registered Office at]
Ajanta House, Charkop,]
Kandivli (West), Mumbai 400 067] ... Plaintiff

Versus

1. Evans Medical PLC,]
having its office at Plot 6, Abimbola Way, Isolo P.M.B]
1120, Apapa, Lagos, Nigeria and factory at Km 32,]
Lagos-Badagry Expressway, Agbara Industrial Estate,]
Agbara, Ogun State, Nigeria]

2. Cipla Limited,]
a company incorporated under the Companies Act, 1956,]
having its office at 289, Bellasis Road,]
Opp. Sahil Hotel, Next To Citi Center Mall,]
Mumbai Central, Mumbai – 400008]... Defendants

Mr. Hiren Kamod, Advocate a/w Ms. Akshata Kamath, Advocate and Ms. Sakshi Pande i/b W.S. Kane & Co, Advocates for the Plaintiff.

Mr. Asim Hazra, Asst. Manager (Legal) and Authorized Signatory of the Plaintiff abovenamed, present.

None for Defendants.

CORAM : S. J. KATHAWALLA, J.
DATE : JUNE 12, 2015.

JUDGMENT:

1. The Plaintiff is a company incorporated under the Companies Act, 1956, having its registered office at the address mentioned in the cause title and is engaged inter alia in the business of manufacturing and trading pharmaceutical and medicinal preparations.
2. According to the Plaintiff, Defendant No.1 is a company incorporated under the laws of Nigeria, having its office at the address mentioned in the cause title and is the importer of Defendant No. 2's goods. Defendant No. 2 is a company incorporated under the Companies Act, 1956, having its office at the address mentioned in the cause title and is carrying on similar business as manufacturer and/or exporter of and trader in pharmaceutical and medicinal preparations.
3. The Plaintiff has filed the present Suit against the Defendants, inter alia, for an order and perpetual injunction restraining the Defendants from in any manner whatsoever, infringing the Plaintiff's registered trademark TADALIS-SX bearing registration No. 1288845 in Class 05 and also from passing off the Defendants' goods as and for those of the Plaintiff's goods and/or enabling others to do so by using the mark TADALIS with or without the numeral 10/20 or any other mark deceptively similar to the Plaintiff's registered trademark in relation to medicinal and pharmaceutical preparations.
4. The above Suit has already been disposed off as withdrawn against Defendant No. 2 by an order dated 12th July, 2013.
5. Since the Plaintiff has its registered office in Mumbai and carries on its business in Mumbai, this Court has jurisdiction to try and entertain this Suit

with respect to the cause of action for infringement by virtue of Section 134 of The Trade Marks Act, 1999 (hereinafter, “the Act”). The Plaintiff had filed Leave Petition No. 165 of 2013 for obtaining leave under Clause XIV of the Letters Patent to combine the cause of action for passing off with the cause of action for infringement, which leave was granted by this Court by an order dated 12th July, 2013.

6. The Plaintiff had also taken out the above Notice of Motion No. 1040 of 2013 seeking ad-interim and interim reliefs. By an order dated 26th July, 2013, the said Notice of Motion No. 1040 of 2013 was made absolute against the Defendant No.1 in terms of prayer clauses (a) and (b) of the said Notice of Motion.
7. As the Defendant No. 1 has failed to remain present or file its Written Statement despite being served with the Writ of Summons, by an order dated 13th March, 2015, the above Suit was directed to be listed under the caption ‘Ex-parte decree’ against Defendant No. 1.
8. The Plaintiff has filed the Affidavit dated 15th April, 2015 in lieu of Examination-in-Chief of Mr. Asim Hazra who is the Asst. Manager (Legal) and Authorized Signatory of the Plaintiff Company, along with the Compilation of Documents which are taken on record and marked as Exhibits- P1-P8 collectively.
9. The Ld. Advocate for the Plaintiff has submitted that the Plaintiff carries on an old, established and reputed business, inter alia as manufacturer of and trader in pharmaceutical and medicinal preparations and that it is recognized as one of the leading Indian pharmaceutical companies whose products and ethical formulations are developed through advance research and known for their superior quality. The Plaintiff has stated that in or about 2004, the Plaintiff adopted the trade mark TADALIS-SX upon and in relation to pharmaceutical and medicinal preparation containing the drug “tadalafil” in the form of tablet,

which is prescribed for treatment for men with erectile dysfunction. It is stated that on or around 8th June 2004, the Plaintiff applied for and obtained registration of the trade mark TADALIS-SX under registration No. 1288845 in class 05, which registration is valid upto 8th June, 2024. The original certified copy of the entry in the Register of Trade Marks relating to the said trade mark for use in legal proceedings is at Exhibit P-2 to the Compilation of Documents. It is further submitted that for the past many years, the Plaintiff has been manufacturing and selling/exporting the said medicine under the said trade mark with the addition of the numerals 10 and 20 as TADALIS-SX 10 and TADALIS-SX 20 to denote the strength of the drug “tadalafil”. Specimen of the Plaintiff’s packaging containing the Plaintiff’s said trade mark is at Exhibit “P-3” to the Compilation of Documents.

10. The Plaintiff has submitted that in or about June, 2013, the Plaintiff came to learn that the Defendant No.2 is manufacturing and exporting and the Defendant No.1 is importing from the Defendant No. 2, a medicinal and pharmaceutical preparation containing the generic drug ‘tadalafil’, in the form of tablets under trade mark TADALIS-10 and/or TADALIS-20 wherein the numerals 10 and 20 denote the strength of the drug “tadalafil”. It is submitted that the impugned goods are also prescribed for treatment of men with erectile dysfunction. A specimen of the Defendants’ packaging bearing the impugned trademark TADALIS-10 and/or TADALIS-20 is at Exhibit P-8 to the Compilation of Documents.
11. The Ld. Advocate for the Plaintiff has submitted that the Defendants’ impugned trade mark TADALIS with the numeral 10/20 is identical with and deceptively similar to the Plaintiff’s registered trade mark TADALIS-SX. He further submits that the goods in respect of which the impugned trade mark is being used by the Defendants are same as the goods in respect of which the Plaintiff has been using the trade mark “TADALIS-SX” and/ or in respect of

which the Plaintiff has secured registration of its said trade mark under registration No. 1288845 in class 05.

12. The Ld. Advocate for the Plaintiff has submitted that the Plaintiff is the registered proprietor of the said trade mark TADALIS-SX bearing registration No. 1288845 in Class 05. He submits that since about 2004, the Plaintiff has been regularly, openly and extensively using the said trade mark TADALIS-SX in relation to the said medicine. He submits that the Plaintiff has been continuously and on large scale selling in India and exporting the said medicines to various countries including Guyana, Hong Kong, U.A.E. He submits that the Plaintiff's said trade mark is inherently distinctive. He further submits that even otherwise, by reason of continuous and extensive user of the said trade mark by the Plaintiff in relation to the said medicine and the efforts taken by it in popularizing the said medicine sold under the said trade mark, as also by reason of high efficacy and superior quality of the said medicine sold under the said trade mark, the Plaintiff's said medicine and the said trade mark enjoy wide and enviable reputation and goodwill amongst the doctors, chemists and the general public. He submits that consequently, the said trade mark TADALIS-SX has become distinctive of the Plaintiff's said goods and connotes and denotes to the members of the medical profession, trade and general public, as medicine of the Plaintiff and of none else. The Plaintiff has also submitted that it has incurred substantial amount of expenses and efforts in promoting and popularizing its goods bearing its registered trademark and thus the mark TADALIS-SX is well known and is solely and exclusively associated by the members of the trade and public with the Plaintiff alone and none else. The Plaintiff has also produced a list of its Annual Sales in India and Annual Export Sales and Promotional Expenses in respect of the goods sold under the trade mark TADALIS-SX from the year 2008-2009 to 2012-2013 and 2004-2005 to 2011-2012 respectively. The Certificates issued by the Plaintiff's Chartered Accountant evidencing the same are at Exhibits P-4 and P-5

respectively to the Compilation of Documents. The Plaintiff has also produced original invoices including export invoices in respect of sale of the said goods bearing the trade mark TADALIS-SX. The said invoices are at Exhibit P-6A to P-7f to the Compilation of Documents.

13. The Ld. Advocate for the Plaintiff has submitted that in view of the above, valuable statutory and common law rights have come to be vested in the Plaintiff. The Plaintiff has submitted that Defendants are using the impugned trademark TADALIS-10 and/or TADALIS-20 in respect of identical goods (i.e. pharmaceutical preparation containing the generic drug “tadalafil” in tablet form for the treatment of men with erectile dysfunction) covered by the registration of the Plaintiff. The Plaintiff has further contended that there is bound to be confusion and deception when chemists, patients or hospitals place orders for the Plaintiff's medicinal preparation via telephone.
14. The learned Advocate for the Plaintiff has submitted that the Plaintiff's medicinal and pharmaceutical preparations bearing the mark TADALIS-SX are being sold throughout India and thus the Defendants were aware and/or ought to have been aware of the existence of the Plaintiff's mark TADALIS-SX. The Plaintiff has therefore contended that the adoption by the Defendants of the impugned mark TADALIS with or without the numeral 10/20 is dishonest and a deliberate attempt to encash and trade upon the goodwill and reputation of the Plaintiff. The Plaintiff has stated that if Defendant No.1 is not restrained from continuing the acts of infringement and passing off by use of the impugned mark TADALIS with or without the numeral 10/20, the Plaintiff will suffer irreparable loss and injury.
15. I have considered the submissions made on behalf of the Plaintiff and have also perused the pleadings and the evidence led by the Plaintiff. After consideration of the same, I find merit in the submissions made on behalf of

the Plaintiff. The Plaintiff has proved all its contentions satisfactorily by providing substantial material in support of the same. It is clear that the impugned mark TADALIS with or without the numeral 10/20 being used by Defendant No.1 is identical with and/or deceptively similar to the Plaintiff's registered trademark TADALIS-SX. The said rival marks are also being used in respect of pharmaceutical products which are meant for the treatment of the same ailment i.e. erectile dysfunction in men. Hence, the continued use of the impugned trademark by Defendant No. 1 is bound to create confusion and deception in the minds of the public.

16. Defendant No.1 has remained absent despite the service of Writ of Summons by the Plaintiff. There is no written statement on record. Thus, there is no explanation provided or defence raised by the Defendant in respect of the use of the impugned mark TADALIS with or without the numeral 10/20 which is identical with and/or deceptively similar to the Plaintiff's registered trademark TADALIS-SX. The evidence of the Plaintiff is therefore uncontroverted. It is quite clear that Defendant No.1 by use of the impugned mark is dishonestly attempting to trade on the goodwill and reputation of the Plaintiff thereby causing irreparable loss and damage to the Plaintiff. In view thereof, it is established that the Defendant No.1 is infringing the trademark of the Plaintiff and is passing off its medicinal and pharmaceutical preparation as that of the Plaintiff's products.

17. The Plaintiff is not pressing for damages other than punitive damages. In assessing the similarity of the two trade marks in the present case, no oral evidence is necessary. In the circumstances, suit is decreed against the Defendant No.1 in terms of Prayer Clauses (a), (b) and (d) of the Plaint. Costs to be quantified as per rules.

18. Considering the nature of infringement and with a view to dissuade others from indulging into such activities it is imperative that some punitive damages

be awarded to the Plaintiff. I, therefore award punitive damages amounting to Rs.1,00,000/- to the Plaintiff and against Defendant No.1.

19. The office shall return the original documents to the Advocates for the Plaintiff upon the Advocates for the Plaintiff handing over photostat copies of the said documents duly certified by them as true copies. Refund of court fee, if any, as per rules.

(S. J. KATHAWALLA, J.)