

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
SUIT NO. 748 OF 2014

Glenmark Pharmaceuticals Ltd.,	)	
a Company registered under	)	
the Companies Act, 1956, having	)	
its registered office at B-2,	)	
Mahalaxmi Chambers, 22, Bhulabhai	)	
Desai Road, Mumbai – 400 026.	)	...Plaintiff

V/s.

1. G.R.A.F. Laboratories Pvt. Ltd.,	)	
a company incorporated under the	)	
Companies Act, 1956 and having its address	)	
at 8 th Floor, Sarovar Complex, Near Jain	)	
Temple, B/h. Samudra Annexure,	)	
Area : Navrangpura, C. G. Road,	)	
Ahmedabad – 380 009.	)	
2. Valence Health Care,	)	
a concern having its address at	)	
Plot No. 8 & 9, New Industrial Area,	)	
Village : Bain Attarian, P.O. Kandari,	)	
(Near Pathankot), Tehsil : Indrora,	)	
Dist : Kangra H P 176401	)	
Himachal Pradesh, India.	)	.. Defendants

Mr. Mahesh Mahadgut along with Ms. Miloni Gala for the Plaintiff.

None for the Defendants.

CORAM: S.J. KATHAWALLA, J.

DATE: 30th June, 2015

ORAL JUDGMENT:

1. The plaintiff has filed the present suit against the defendants for infringing the plaintiff's registered Trade Mark "ZITA" by their use of similar trade mark "ZITA" and also for passing off committed by the Defendants by using the impugned mark and for damages caused to the Plaintiff by the Defendants unlawful conduct.
2. The suit has appeared under the caption for "ex parte decree". Since the Plaintiff failed to appear and defend the suit despite service of the writ of summons, the suit is placed for ex parte decree.
3. The plaintiff has tendered the evidence of Ms. Archana Bene, Senior Manager –Legal of the plaintiff company which is taken on record and marked "X-1" for identification. The deponent Ms. Archana Bene has produced the authorisation by way of true copy of Resolution dated 22nd August, 2013 passed by the plaintiff in the meeting of the Board of Directors of the company held on 15th February, 2011. The said document is marked as Exh.P-1.
4. The plaintiff has stated that the plaintiff is a company dealing in pharmaceutical and medicinal preparations since over three decades. It is listed on the stock Exchange in India. The plaintiff company is selling its products under various distinctive Trade Marks. Plaintiffs products are sold throughout India and in around 91 countries abroad.

5. The plaintiff has stated that one Hardeep Singh Bhatia, Proprietor M/s. Genesis Biotech Inc., was the the original proprietor of Trade Mark ZITA registered under No. 1124111 dated 05/08/2002 in Class 5 in respect of the goods "Pharmaceuticals, Medicines for Dental Purpose, Medicines for Human Purpose". By Deed of Assignment dated 28/01/2013 he had assigned his Trade Mark ZITA in favour of one Sahil Juneja alongwith goodwill. The Deed of Assignment dated 28/01/2013 is at Exh.P-2 to the affidavit of evidence. According to Plaintiff, document at Exh. P-2 is already registered with Trade Marks authority and the name of Sahil Juneja was entered on the Register of Trade Marks on 17/04/2014.

6. The Plaintiff has further stated that by Deed of Assignment dated 31/01/2013 Sahil Juneja has assigned his Trade Mark ZITA in favour of Plaintiff alongwith goodwill. The Deed of Assignment dated 31/01/2013 is at Exh.P-3 to the affidavit of evidence. It is the case of Plaintiff that the Deed of Assignment dated 31/01/2013 has been taken on record by the Registrar of Trade Marks on 17/04/2014 and the name of Plaintiff is entered as proprietor of Trade Mark ZITA bearing No. 1124111 dated 05/08/2002 in class 5. In support of its case that Plaintiff is now the registered Proprietor of assigned Trade Mark ZITA, Plaintiff has filed Legal Proceeding Certificate of registration of the trademark "ZITA" issued in favour of the Plaintiff Company dated 08/07/2014. This certificate shows that the name of the Plaintiff is taken on record as subsequent proprietor of Trade Mark ZITA on 17/04/2014. The Legal proceeding certificate dated 08/07/2014 is at Exh.P-4 to the affidavit of evidence.

7. The plaintiff has stated that the plaintiff's and/or its predecessor-in-title have been using the mark ZITA since July, 2002. The Plaintiff has further

stated that after having acquired the mark, Plaintiff has been selling its product “ZITA” since April 2013 in India in relation to its anti-diabetes product. The said product is also sold as ZITA MET. Plaintiff has produced invoices / stock transfer notes belonging to Genesis Biotec Inc. The same are collectively at Exh P-5 to the affidavit of evidence. Plaintiff has further produced carton of the Plaintiff’s pharmaceutical preparation bearing the trademark ‘ZITA’ and “ZITA MET”. The same are at Exh P-6 and Exh.P-7 to the affidavit of evidence.

8. The plaintiff has stated that it has been selling its pharmaceutical preparation, bearing the trademark ‘ZITA’ openly, uninterruptedly and extensively in the domestic/Indian market, since April, 2013. The Plaintiff has produced certificates of Chartered Accountant certifying the sales figures of the pharmaceutical preparations sold by the plaintiff under the Trademark "ZITA". The said documents are at Exh.P-8 and Exh.P-9 to the affidavit of evidence. The plaintiff has also produced certificates of Chartered Accountant for the promotional expenses incurred by the plaintiff on its ZITA range. The said documents are at Exh.P10 and Exh.P-11 to the affidavit of evidence. The Plaintiff has also produced copies of sales invoices of their product ZITA. The said documents are collectively at Exh.P-12 to the affidavit of evidence. The Plaintiff has further produced copies of the brochure/medical literature in relation to their product ZITA. The said documents are collectively at Exh.P-13 to the affidavit of evidence.

9. The plaintiff has stated that in view of extensive sales, the said mark ZITA has acquired reputation and goodwill in India.

10. The plaintiff has stated that in or about April, 2013 the plaintiffs learnt of the Defendants use of the impugned mark "ZITA" the same being manufactured by Defendant No.1 and marketed by Defendant No.2. Plaintiff has produced pack of the Defendants product. The said pack is at Exh.P-14 to the affidavit of evidence. Plaintiff had issued notice to the Defendants on 29/04/2013 calling upon the Defendants to stop using the impugned mark. The said document is at Exh.P-15 to the affidavit of evidence. The Defendants vide their Advocates letter dated 23/05/2013 have replied to the Plaintiffs notice. The said document is at Exh.P-16 to the affidavit of evidence. To the Defendants reply, Plaintiffs through their Advocates letter dated 29/05/2013, have sent reply. The letter dated 29/05/2013 and its postal acknowledgments are at Exh.P-17 and Exh. P-18 to the affidavit of evidence.

11. The plaintiff has stated that the impugned mark "ZITA" is phonetically visually and structurally identical to the plaintiff's trade mark "ZITA". The Plaintiff has further stated that the user of the impugned mark constitutes infringement of the plaintiff's trade mark "ZITA" and passing off.

12. I have gone through the averments made in the plaint and the documents annexed to the affidavit of evidence of the plaintiff and also heard the Learned Advocate for the Plaintiff. The document at Exh.P-4 shows that the plaintiffs are the registered owners of the trade mark "ZITA" and that the said registration is valid and subsisting. The documents at Exh.P-5 to P-13 shows the user of the Plaintiffs mark and the huge annual sales turnover of ZITA product of the plaintiff and the annual sales promotional expenses

incurred by the plaintiffs on "ZITA" range. The documents at Exh.P-15 and Exh.P.17 show that the Defendants were put to notice.

13. In assessing the similarity of the rival marks in the present case, no oral evidence is necessary. Comparison of the plaintiff's mark with that of the defendants' impugned mark shows that the defendants' mark "ZITA" is phonetically, visually and structurally similar to the plaintiff's registered Trade Mark "ZITA". Hence, the defendants' user of the said trademark "ZITA" is illegal and constitutes an infringement of the plaintiff's rights as the registered proprietor of the trademark "ZITA". The Plaintiff has also established that it has acquired reputation and goodwill in its mark sufficient to maintain successfully an action for passing off.

14. The Plaintiff led the evidence of Ms. Archana Bene by filing her affidavit in lieu of examination-in-chief. The witness confirms the correctness of the contents of the affidavit.

15. There is nothing on record that militates against anything that has been averred in the plaint and deposed to by the witness.

16. The Defendants were served with the writ of summons and an affidavit dated 15/06/2015 proving service of the writ of summons is on record. However, the Defendants are absent. The Defendants have also not filed written statement. The evidence of the witness is uncontroverted.

17. In the circumstances, the suit is decreed in terms of prayer clauses (a), (b) and (d) which are reproduced hereunder. Cost to be quantified as per rules.

“(a) That the Defendants by themselves, their servants, directors, partners, dealers, distributors, stockists, franchisees, agents, sister concerns, subsidiaries, representatives, affiliates and/or assigns and all persons acting for and on their behalf be restrained by a perpetual order and injunction of this Hon'ble Court from in any manner manufacturing, marketing, selling, distributing, exporting and/or using in relation to medicinal and/or pharmaceutical preparations and/or such allied and cognate goods the trade mark ZITA or using any other mark being deceptively similar in any manner whatsoever to the Trade Mark ZITA of Plaintiff so as to infringe the registered trade mark ZITA of Plaintiff registered under No. 1124111 in class 5;

(b) That the Defendants by themselves, their servants, directors, partners, dealers, distributors, stockists, franchisees, agents, sister concerns, subsidiaries, representatives, affiliates and/or assigns and all persons acting for and on their behalf be restrained by a perpetual order and injunction of this Hon'ble Court from in any manner manufacturing, marketing, selling, distributing, exporting and/or using in relation to medicinal and/or pharmaceutical preparations and/or such allied and cognate goods the trade mark ZITA or using any other mark being deceptively similar in any manner

whatsoever to the Trade Mark ZITA of Plaintiff so as to pass off the Defendants goods as and for those of the Plaintiff;
(d) *That the Defendants be ordered and decreed to deliver up for destruction to the Plaintiff or to the authorised representatives of Plaintiff all the products, packs, packaging materials, goods and things bearing the impugned trademark.”*

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 are awarded to the Plaintiff. I, therefore award punitive damages amounting to Rs.1,00,000/- to the Plaintiff and against the Defendants.

19. The suit is accordingly disposed off. The Office shall return the original documents to the Advocate for the Plaintiff upon the Advocate for the Plaintiff handing over Photostat copies of the said documents duly certified as true copies.

(S.J. KATHAWALLA, J.)