

IN THE HIGH COURT OF JUDICATURE AT BOMBAY**ORDINARY ORIGINAL CIVIL JURISDICTION****SUIT NO. 850 OF 2014**

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

Vardhaman Lifecare Private Limited,]
having its office at G/302, Kamala Vihar,]
Mahavir Nagar Area, Kandivali (West),]
Mumbai – 400067 and also at 3rd Floor,]
Prasram & Bros Bung, Building 5, Rupa, Lan,]
Chandanwadi, Mumbai – 400002]...Defendant

Mr. Ashutosh Kane, Advocate 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 : JULY 9TH, 2015.

ORAL JUDGMENT:

1. The Plaintiff is a company incorporated under the Companies Act, 1956.

The Plaintiff carries on an old, established and reputed business, inter-alia as manufacturer of, trader in and exporter of pharmaceutical and medicinal preparations.

2. The Defendant is a company incorporated under the Companies Act, 1956 and has its offices at the addresses mentioned in the cause title.

The Defendant carries on business as manufacturer, supplier and exporter of medicinal and pharmaceutical preparations.

3. The Plaintiff has filed the present Suit against the Defendant, inter alia, for an order and perpetual injunction restraining the Defendant from in any manner whatsoever, infringing the Plaintiff's registered trade mark KAMAGRA bearing registration Nos. 841668, 1499129, 1459619, 1469594, 1475790, 1469596, 1469592, 1475791, 1469597, 1475793, 1469595, 1475792, 1469593, 1474495, 1474496, 1474492 and 1474497 all in class 05 and also from passing off the Defendant's goods

as and for those of the Plaintiff's goods and/or enabling others to do so by using the impugned trade mark "AMAGRA" or any other trade mark deceptively similar to the Plaintiff's registered trade mark KAMAGRA in respect of medicinal and pharmaceutical preparations.

4. Since the Defendant has its registered office in Mumbai from where it is carrying on business of manufacturing and/or selling and/or exporting the impugned goods bearing the impugned trade mark AMAGRA, this Court has jurisdiction to try and entertain the present suit for both the causes of action viz. infringement of trade mark and for passing off.
5. The Plaintiff had also taken out Notice of Motion No.1472 of 2014 seeking ad-interim and interim reliefs against the Defendant. By an order dated 12th June 2015, the said Notice of Motion No. 1472 of 2014 was made absolute against the Defendant in terms of prayer clauses (a) and (b) of the said Notice of Motion.
6. As the Defendant has failed to remain present or file its Written Statement despite being served with the Writ of Summons, by an order dated 16th June, 2015 the above Suit was directed to be placed under the caption "For ex-parte decree" against the Defendant, today.
7. The Plaintiff has filed the Affidavit dated 9th July, 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 P-1 to P-37.

8. Mr. Kane, the Ld. Advocate for the Plaintiff submits 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. He states that for the past several years, the Plaintiff has been using several distinctive trade marks with a view to distinguish its pharmaceutical and medicinal preparations from those of others as well as inter se. He states that one such trade mark used by the Plaintiff is KAMAGRA ("the said trade mark") which the Plaintiff adopted for use upon and in relation to its pharmaceutical and medicinal preparation containing Sildenafil Citrate ("the said goods"). He submits that since about the year 1999, the Plaintiff has been manufacturing and exporting the said goods under the said trade mark. A specimen of the Plaintiff's packaging bearing the said trade mark KAMAGRA is at Exhibit "P-2" to the Compilation of Documents. He submits that the Plaintiff has applied for and secured various registrations in respect of its said trade mark

KAMAGRA in respect of its goods in Class 05 bearing registration nos. 841668, 1499129, 1459619, 1469594, 1475790, 1469596, 1469592, 1475791, 1469597, 1475793, 1469595, 1475792, 1469593, 1474495, 1474496, 1474492, 1474497. He submits that each of the said registrations is valid and subsisting. Original certified copies of the entries in the Register of Trade Marks in respect of registered trade marks bearing nos. 1459619, 1474495, 1474492, 147449 and 1474497 all in class 5 for use in legal proceedings recording the Plaintiff as the proprietor of the said trade mark are at Exhibits “P-19” to “P-23” of the Compilation of Documents. Copies of certified copies of entries made in the Register of Trade Marks in respect of the registered trade marks bearing nos. 841668, 1499129, 1469594, 1475790, 1469596, 1469592, 1475791, 1469597, 1475793, 1469595, 1475792 and 1469593 all in class 5 for use in legal proceedings are at Exhibits “P-24” to “P-35” of the Compilation of Documents. Mr. Kane submits that the Plaintiff has made attempts to trace the certified copies in respect of the registered trade marks bearing nos. 841668, 1499129, 1469594, 1475790, 1469596, 1469592, 1475791, 1469597, 1475793, 1469595, 1475792 and 1469593 all in class 5 for use in legal proceedings before making this affidavit, however the same are not traceable. He submits that in view

thereof, the Plaintiff has submitted copies of the certified copies in respect of the aforesaid trade marks.

9. Mr. Kane submits that the Plaintiff is the registered proprietor of the said trade mark "KAMAGRA" in respect of medicinal and pharmaceutical preparations in Class 05. He submits that since the past many years, the Plaintiff has been regularly, openly and extensively using the said trade mark "KAMAGRA" in relation to the said goods. He submits that during all these years, the Plaintiff has effected large sales of its said goods bearing the said trade mark. He submits that the Plaintiff has also been exporting its said goods under the said trade mark to several other countries world over. He submits that the Plaintiff has taken efforts to popularize its said medicine bearing the said trade mark KAMAGRA and has expended substantial sums of money and efforts on promoting sales of its said medicine bearing the said trade mark. Original certificates, both dated 9th October, 2014 issued by the Plaintiff's Chartered Accountant viz. Kaushik Shahukar & Co., Chartered Accountants, certifying the correctness of the Plaintiff's Statement of Annual Sales and Annual Expenses in respect of its goods bearing the trade mark KAMAGRA are at Exhibit "P-3" and "P-4" respectively of the Compilation of Documents. Plaintiff's original commercial invoices proving sale of the Plaintiff's goods bearing the said trade mark are at Exhibits "P-5" to "P-

18” of the Compilation of Documents. 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 goods and the efforts taken by it in popularizing the said goods sold under the said trade mark, as also by reason of high efficacy and superior quality of the said goods sold under the said trade mark, the Plaintiff's said goods 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 “KAMAGRA” has become distinctive of the Plaintiff's said goods and connotes and denotes to the members of the medical profession, trade and general public, the said goods of the Plaintiff and of none else. He submits that in view of the above, valuable statutory and common law rights have come to be vested in the Plaintiff.

10. Mr. Kane submits that on or about 7th October, 2014 the Plaintiff came to know from the website of the Defendant having its address “www.vardhamanlifecare.com” that the Defendant is manufacturing, selling and exporting an identical pharmaceutical and medicinal preparation namely, one containing ‘Sildenafil Citrate’, under the trade mark AMAGRA. A printout of the relevant page of the Defendant's

website offering the impugned goods under the impugned trade mark is at Exhibit “P-36” of the Compilation of Documents.

11. Mr. Kane submits that the Defendant’s impugned trade mark AMAGRA is deceptively similar to the Plaintiff’s registered and well-known trade mark KAMAGRA. He submits that the Defendant has merely deleted the first letter “K” from the Plaintiff’s trade mark KAMAGRA. He submits that despite the said deletion of the first letter of the Plaintiff’s trade mark, the Defendant’s impugned trade mark AMAGRA as a whole is visually and phonetically similar to the Plaintiff’s trade mark KAMAGRA. He submits that by the use of the impugned trade mark AMAGRA in respect of its medicinal and pharmaceutical preparation, the Defendant has infringed and is continuing to infringe the Plaintiff’s registered trade mark KAMAGRA.

12. Mr. Kane submits that the Plaintiff has acquired wide and enviable reputation and goodwill in its trade mark KAMAGRA and the medicinal and pharmaceutical preparation sold under the said trade mark and the aforesaid trade mark is exclusively associated with the Plaintiff’s said medicinal and pharmaceutical preparation. He submits that as the Defendant’s impugned trade mark AMAGRA is phonetically, visually and structurally closely and deceptively similar to the Plaintiff’s well-known trade mark KAMAGRA confusion and deception in the minds of traders

and consumers between the rival medicinal preparations is inevitable. He submits that members of the medical profession, trade and public who are acquainted with the Plaintiff's medicinal preparation bearing the trade mark KAMAGRA since past many years, upon coming across the Defendant's medicinal preparation bearing the impugned trade mark AMAGRA are likely to be confused and / or deceived into believing that the Defendant's impugned goods are those of the Plaintiff and /or are originating from the Plaintiff and/ or are connected in the course of the trade with the Plaintiff. He submits that alternatively, they might be put in a state of wonderment as to origin of the said goods. He submits that by the aforesaid acts of manufacturing and selling medicinal and pharmaceutical preparation bearing the impugned trade mark AMAGRA, the Defendant is passing off its goods as and for the Plaintiff's well-known goods. He submits that the Defendant has adopted the impugned trade mark AMAGRA knowing fully well that due to its close and deceptive similarity to the Plaintiff's well-known trade mark KAMAGRA, the Defendant will be able to trade upon the immense reputation and goodwill of the Plaintiff in the said trade mark and thereby make unlawful gains.

13. Mr. Kane submits that the Defendant has adopted the impugned trade mark AMAGRA in bad faith. He submits that the Plaintiff and Defendant

both carry on business in Mumbai. He submits that the Defendant has been aware of the Plaintiff's medicinal and pharmaceutical preparation containing the generic drug Sildenafil Citrate sold under the trade mark KAMAGRA and its popularity. He submits that the same is evident from the fact that the Defendant, on its aforesaid website, has claimed that its organization is offering a wide range of KAMAGRA products and that the Plaintiff is the manufacturer of the said KAMAGRA products. A printout of the relevant page of the Defendant's website offering the Plaintiff's said goods bearing the said trade mark is at Exhibit "P-37" of the Compilation of Documents.

14. Mr. Kane submits that the Plaintiff has suffered and is likely to suffer irreparable loss to its trade and reputation on account of the aforesaid acts of infringement and passing off committed by the Defendant. He submits that by the use of the impugned trade mark AMAGRA the Defendant is diluting the distinctive character of the Plaintiff's well-known trade mark KAMAGRA. He submits that unless the Defendant is restrained by a permanent order and injunction of this Hon'ble Court from committing the aforesaid acts of infringement and passing off, the Plaintiff will suffer irreparable loss and injury and pecuniary compensation will not be an adequate relief.

15. Mr. Kane submits that continued use of the impugned trade mark AMAGRA by the Defendant in relation to the impugned goods may lead to unpleasant consequences. He submits that significantly, the medicinal and pharmaceutical preparations sold under the rival trade marks contain the drug Sildenafil Citrate which can have strong side effects. He submits that therefore, more care is required to be taken whilst selling or administering the said medicinal preparation. He submits that judicial notice has been taken of the fact that medicines are often ordered over the telephone and it is possible that chemists/pharmacists may confuse one product for another if the trade marks used in respect of the said products are closely and/or deceptively similar to one another. In this regard, Mr. Kane relies on the judgment of the Hon'ble Supreme Court in the case of *Cadila Healthcare Ltd.v. Cadila Pharmaceuticals Ltd.* in **paragraphs 28 and 32**, wherein the Hon'ble Supreme Court has held as follows:

28. Here, it will be useful to refer to the decision of Morgenstern Chemical Company's case (supra) where it has been held as under:

[5] In the field of medical products, it is particularly important that great care be taken to prevent any possibility of confusion in the use of trade marks. The test as to whether or not there is confusing similarity in these products even if prescribed and dispensed only by.

professionally trained individuals does not hinge on whether or not the medicines are designed for similar ailments. The rule enunciated by Judge Helen in Cole Chemical Co. Vs. Cole Laboratories D.C. Mo. 1954, 118F. Supp. 612, 616, 617, 101, USPQ 44,47,48, is applicable here:

Plaintiff and defendant are engaged in the sale of medical preparations. They are for ultimate human consumption or use.* **They are particularly all for ailments of the human body. Confusion in such products can have serious consequences for the patient. Confusion in medicines must be avoided.

* * * * *

“Prevention of confusion and mistakes in medicines is too vital to be trifled with”

The observations made by Assistant Commissioner Leeds of the Patent Office in R.J. Strassenburgh Co. v Kenwood Laboratories, Inc. 1955, 106 USPQ 379, 380 are particularly apt, that Physicians are not immune from confusion or mistake. Further more it is common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently handwriting is not unmistakably legible. These facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced.”

29. ...

30. ...

31. ...

32. Public interest would support lesser degree of proof showing confusing similarity in the case of trade mark in respect of medicinal product as against other non-medicinal products. Drugs are poisons, not sweets. Confusion between medicinal products may, therefore, be life threatening, not merely inconvenient. Noting the frailty of human nature and the pressures placed by society on doctors, there should be as many clear indicators as possible to distinguish two medicinal products from each other. It is not uncommon that in hospitals, drugs can be requested verbally and/or under critical/pressure situations. Many patients may be elderly, infirm or illiterate. They may not be in a position to differentiate between the medicine prescribed and bought which is ultimately handed over to them. This view finds support from McCarthy on Trade Marks, 3rd Edition, para 23.12 of which reads as under:

The tests of confusing similarity are modified when the goods involved are medicinal products. Confusion of source or product between medicinal products may produce physically harmful results to purchasers and greater protection is required than in the ordinary case. If the goods involved are medicinal products each with different effects and designed for even subtly different uses, confusion among the products caused by

similar marks could have disastrous effects. For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations. The same standard has been applied to medical products such as surgical sutures and clavicle splints.

16. Mr. Kane submits that there is strong likelihood that the pronunciation of the letter K in the Plaintiff's trade mark is kept silent or not emphasized upon enough by the customer and/or the chemist and hence it is possible for the chemist to confuse between the Plaintiff's goods bearing the trade mark KAMAGRA and the Defendant's impugned goods bearing the impugned trade mark AMAGRA. Mr. Kane submits that in the circumstances, in the interest of consuming public, the Defendant ought to be restrained from using the impugned trade mark.
17. 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 "AMAGRA" being used by Defendant is identical with and/or deceptively similar to the Plaintiff's registered trademark "KAMAGRA". Hence, the continued use of the impugned trade mark by Defendant is bound to create confusion and deception in the

minds of the public. Further, having regard to the nature of the goods great care must be taken to prevent any possibility of confusion in the use of rival trade marks,

18. The Defendant 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 "AMAGRA" which is identical with and/or deceptively similar to the Plaintiff's registered trade mark "KAMAGRA". The evidence of the Plaintiff is therefore uncontroverted. It is quite clear that Defendant 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 is infringing the trade mark of the Plaintiff and is passing off its medicinal and pharmaceutical preparation as that of the Plaintiff's goods.

19. 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 in terms of Prayer Clauses (a), (b) and (d) of the Plaint which are reproduced hereunder:

“(a) That the Defendant by itself, its directors, servants, stockists, dealers, distributors and agents be restrained by a perpetual order and injunction of this Hon'ble Court from infringing the Plaintiff's registered trade marks bearing registration Nos. 841668, 1499129, 1459619, 1469594, 1475790, 1469596, 1469592, 1475791, 1469597, 1475793, 1469595, 1475792, 1469593, 1474495, 1474496, 1474492 and 1474497 all in class 05 by the use of the impugned trade mark AMAGRA or any other trade mark deceptively similar to the Plaintiff's aforesaid registered trade marks, in respect of medicinal and pharmaceutical preparations and/or like goods or in any other manner whatsoever.

(b) That the Defendant by itself, its directors, servants, stockists, dealers, distributors and agents be restrained by a permanent order and injunction of this Hon'ble Court from manufacturing and/or trading in and/or exporting and/or offering for sale and/or advertising and/or otherwise dealing in medicinal and pharmaceutical preparations bearing the impugned trade mark AMAGRA or any other trade mark deceptively similar to the Plaintiff's trade mark KAMAGRA, so as to pass off or enable others to pass off the Defendant's goods as and for the Plaintiff's well-known goods or in any other manner whatsoever;

(d) that the Defendant be ordered and directed to deliver up to the Plaintiff for destruction all goods and material including packaging bearing the trade mark AMAGRA.”

20. 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.

21. The suit is accordingly disposed off. Costs to be quantified as per rules. Refund of court fee, if any, as per rules.

22. 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.

(S. J. KATHAWALLA, J.)