

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

SUIT NO. 1014 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. Haustus Biotech Pvt. Ltd.,)
a Company registered under)
the Companies Act, 1956, having its address)
at 44-45, Industrial Area, Tahliwal Dist.)
UNA – 174 303, Himachal Pradesh.)

2. Energize Pharmaceuticals (P) Ltd.,)
a Company registered under)
the Companies Act, 1956, having its address)
at S. No.70/1/3, Radhika Vihar, Ganesh Nagar,)
New Sangvi FL-6, Pune – 411061.) ...Defendants

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

None for the Defendant No.2

CORAM: S.J. KATHAWALLA, J.

DATE: AUGUST 06th, 2015

ORAL JUDGMENT:

1. This is an action taken by the Plaintiff for infringement of Trade Mark and passing off committed by the Defendants. By an order dated 23rd July, 2015 the suit has been decreed against the Defendant No.1. Despite Defendant No.2 being represented by Advocates, Defendant No. 2 failed to file its Written Statement. In view thereof, pursuant to the order dated 11th June, 2015 the suit is placed for exparte decree. The Advocate for the Defendant is also not present.

2. The Plaintiff has tendered the evidence of Ms. Archana Madhav Bene, Senior Manager –Legal of the Plaintiff company which is taken on record and marked "X-1" for identification. The deponent Ms. Archana Madhav 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 Plaintiff held on 15th February, 2011. The said document is marked as Exh.P-1.

3. The Plaintiff has stated that it is a company registered under the Companies Act, 1956 carrying on business inter-alia, as manufacturers, dealers and exporters of various medicinal and pharmaceutical preparations since last over 3 decades. The Plaintiff are selling their products under various distinctive Trade Marks. According to the Plaintiff, they had adopted the Trade Mark "BON-K2" in early 2010 in respect of a pharmaceutical and medicinal preparation being calcium preparation and that their mark is in use since August, 2010.

4. The Plaintiff has filed the present suit against the Defendants for infringing the Plaintiff's registered Trade Mark "BON-K2" by their use of deceptively similar Trade Mark "BONACTIVE-K2" 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.

5. The Plaintiff has stated that they are the registered proprietors of Trade Mark "BON - K2" as well as label marks containing the word BON - K2 and/or marks containing the word BON - K2 as its prominent part in respect of medicinal and pharmaceutical preparations being goods falling in Class 5 as per details below :

Trade Mark No	Registration Date	Trade Mark
1913228	25/01/2010	BONK2
2005873	09/08/2010	BON-K2
2005874	09/08/2010	BON-K2 (LABEL)
2391089	06/09/2012	BON-K2 STRONG
2391090	06/09/2012	BON-K2 HD

The Legal Proceedings Certificates of above Trade Marks are at Exh.P-2 to P-6 to the affidavit of evidence.

6. The Plaintiff has stated that the Trade Mark "BON-K2" is in use on an extensive scale throughout India since August, 2010. The Plaintiff has further produced certificate of Chartered Accountant certifying the sales figures of the pharmaceutical preparations sold by the Plaintiff under the Trade Mark "BON-K2" since the financial year April 2010 - March 2011 upto April 2014 - 3rd November, 2014. The said documents are at Exh.P-7 to the affidavit of evidence. The Plaintiff has also produced copies of sales invoices of their product BON-K2. The said documents are collectively at Exh.P-8 to the affidavit of evidence. The Plaintiff has also produced a certificate of Chartered Accountant towards promotional expenses incurred by the Plaintiff for the purpose of popularizing and/or promoting its pharmaceutical preparations bearing the said Trade Mark "BON - K2" since financial year April 2010 – March 2011 upto April 2014 - September, 2014. The said document is at Exh.P-9 to the affidavit of evidence. The Plaintiff has further produced copies of the brochure/medical literature in relation to their product BON-K2. The said documents are at Exh.P-10 to the affidavit of evidence. The Plaintiff has also produced product pack of "BON-K2". The same is at Exh.P-11 to the affidavit of evidence.

7. The Plaintiff has stated that in view of the extensive sales, wide publicity and the high quality and efficacy of the Plaintiff's pharmaceutical preparations sold under/bearing the said Trade Mark "BON-K2", the Plaintiff enjoys formidable and invaluable goodwill and reputation in the said Trade Mark "BON-K2" all throughout India. It is stated that members of the pharmaceutical trade, medical profession, doctors, and consumers and the public at large exclusively identify and associate the said Trade Mark "BON-K2" with the Plaintiff alone.

8. The Plaintiff has stated that in September, 2014 it came across the Defendants identical medicinal preparation under the mark 'BONACTIVE-K2'. Plaintiff has produced pack of the Defendants product. The said pack is at Exh.P-12 to the affidavit of evidence. Plaintiff had issued cease and desist notice to the Defendants on 18/09/2014 calling upon the Defendants to stop using the impugned mark. The said document is at Exh.P-13 to the affidavit of evidence. The Defendant No.2 vide their Advocates letter dated 11/11/2014 have replied to the Plaintiffs notice and claimed that they are the owners of Trade Mark "BONACTIVE-K2". The said document is at Exh.P-15 to the affidavit of evidence.

9. The Plaintiff has stated that the impugned mark "BONACTIVE-K2" is phonetically, visually and structurally deceptively similar to the Plaintiff's Trade Mark "BON-K2". The Plaintiff has further stated that the user of the impugned mark constitutes infringement of the Plaintiff's Trade Mark "BON-K2" and leads to passing off.

10. I have gone through the averments made in the Complaint and the documents annexed to the affidavit of evidence of the Plaintiff and also heard the Learned Advocate for the Plaintiff. The documents at Exh.P-2 to P-6 show that the Plaintiff's are the registered owners of the Trade Mark "BON-K2" and that the said registrations are valid and subsisting. The documents at Exh.P-7 to P-11 show the user of the Plaintiff's mark, its annual sales turnover and the annual sales promotional expenses incurred by the Plaintiff.

11. 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 Defendant No.2's impugned mark shows that the Defendants mark "BONACTIVE-K2" is phonetically, visually and structurally deceptively similar to the Plaintiff's registered Trade Mark "BON-K2". Hence, the Defendant No.2's user of the said Trade Mark "BONACTIVE-K2" is illegal and constitutes an infringement of the Plaintiff's rights as the registered proprietor of the Trade Mark "BON-K2". The Plaintiff has also established that it has acquired reputation and goodwill in its mark sufficient to maintain successfully an action for passing off.

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

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

14. The Defendant No.2 has failed to remain present and has also not filed its written statement. The evidence of the witness is uncontroverted.

15. In the circumstances, the suit is decreed against the Defendant No.2 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, 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 BONACTIVE-K2 or using any other mark being deceptively similar in any manner whatsoever to the Plaintiffs mark BON -K2 so as to infringe the Plaintiffs' registered trademark BON - K2 registered under Nos. 1913228, 2005873, 2005874, 2391089 and 2391090 all in class 5 or otherwise howsoever;

(b) That the Defendants by themselves, their servants, Directors, 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 BONACTIVE-K2 or using any other mark being deceptively similar in any manner whatsoever to the Plaintiffs mark BON -K2 so as to pass off the Defendants' goods as and for those of the Plaintiff or otherwise howsoever;

(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;"

16. 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.50,000/- to the Plaintiff and against the Defendant No.2.

17. The Office shall return the original documents to the Advocates 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.)