

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

Date of decision: 19th July, 2016

+ **CS(COMM) No.855/2016, IA No.8365/2016 (u/O 39 R-1&2 CPC) & IA No.8366/2016 (u/O 26 R-9 CPC).**

STAAR SURGICAL COMPANY **Plaintiff**

Through: Mr. Sanjeev K. Singh, Adv.

versus

**POLYMER TECHNOLOGIES INTERNATIONAL
& ORS**

..... **Defendants**

Through: None.

CORAM:

HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

IA No.8367/2016 & IA No.8368/2016 (both or exemption).

1. Allowed, subject to just exceptions.
2. The applications stand disposed of.

CS(COMM) No.855/2016, IA No.8365/2016 (u/O 39 R-1&2 CPC) & IA No.8366/2016 (u/O 26 R-9 CPC).

3. The plaintiff, marketing foldable intraocular lenses under the brand name 'VISIAN ICL'/'ICL', has instituted this suit to restrain the defendants from passing off the intraocular lenses being manufactured by the defendants under the trademark 'EYEPCL' as those of the plaintiff.
4. The plaintiff, prior to the institution of this suit, instituted CS(OS) No.3164/2015 to restrain the defendants from marketing their lenses under the brand name



and *prima facie* finding which to be similar/ deceptively similar to the brand name



of the plaintiff, vide *ex parte* order dated 20th October, 2015 in the said suit the defendants were restrained from using the aforesaid trademark. The said suit is said to be still pending.

5. The defendants, during the pendency of that suit have now changed their trademark to 'EYEPCL' and to restrain the defendants from use whereof this suit has been filed.

6. The label now being used by the defendants is as under:-



and the screen shot from the defendants' website is as under:-



7. I do not find the same to be similar or deceptively similar to the label/trademark of the plaintiff, for the suit to be entertained. The two are entirely distinct.

8. The counsel for the plaintiff has generally argued that the Court has in *Amritdhara Pharmacy Vs. Satyadeo Gupta* AIR 1963 SC 449 enjoined *Laxamdharma* because of *Amritdhara*.

9. The question of similar/deceptively similar is to be seen in the context of the goods and the customers to which the said goods are targeted. The subject goods are for use by ophthalmology surgeon to treat cataract or myopia and the principles which may have been laid down with respect to over the counter drug or with respect to liquor or with respect to shampoo would not be applicable to such goods.

10. Though the counsel for the plaintiff has also argued that the chemists or other persons dispensing the said goods may pass off the goods of the defendants even though the surgeon has prescribed the goods of the plaintiff but it cannot be lost sight of that ultimate user of the said goods is the surgeon who would clearly be able to distinguish between the two goods.

Moreover, the packaging of the goods of the defendants is also shown to be entirely different from that of the plaintiff.

11. Merely because on an earlier occasion the suit of the plaintiff was entertained and interim injunction granted, does not vest any right in favour of the plaintiff as is argued.

12. The plaintiff has not even bothered to, along with the plaint, file any pictorial depiction of its own packaging from which it could be seen whether there is any possibility of the goods of the defendant being confused with the goods of the plaintiff.

13. In the trademark earlier adopted by the defendants and with respect to which the first suit was filed, though the defendants were using the trademark 'IPCL' but by embossing the alphabet 'P' within the alphabet 'C', making the alphabet 'P' inconspicuous and leading to the trademark of the defendants appearing as 'ICL' only i.e. similar to the trademark of the plaintiff. However now it is not so in 'EYEPCL'.

14. The counsel for the plaintiff has sought passover to bring judgments.

15. Passedover.

16. The counsel for the plaintiff has handed over copies of the judgments in (i) ***American Home Products Corpn. Wyeth Lab. Ltd. Vs. Lupin Lab. Ltd.*** 1996 (16) PTC 44 (Bom); (ii) ***Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.*** (2001) 5 SCC 73; (iii) ***Medley Pharmaceuticals Ltd. Vs. Twilight Mercantiles Ltd.*** 2014 (60) PTC 85 (Bom); and, (iv) ***Lupin Limited Vs. Eris Lifesciences Pvt. Ltd.*** 2016 (67) PTC 144 (Bom).

17. In ***American Home Products Corpn. Wyeth Lab. Ltd.*** supra a Single Judge of the High Court of Bombay, by an interim injunction, restrained the defendants from using the trademark “TOROLAC” in relation to proprietary medicines *prima facie* finding the same to have structural as well as visual and phonetic resemblance with the registered trademark “ROLAC” of the plaintiff also used to sell proprietary medicine. It was held that a person who only knows “ROLAC” and who has an imperfect recollection will be deceived and confused if the chemist gives him “TOROLAC” and *vice-versa*. While doing so it was also held that the legibility of the handwriting of the doctors writing the prescription gives rise to the possibility of wrong reading of the said prescription by a chemist.

18. In ***Cadila Health Care Ltd.*** supra Supreme Court though dismissed the Special Leave Petition (SLP) against the order of refusal of interim injunction restraining use of brand name “FALCIGO” on the ground of the same amounting to passing off the goods of the defendant as goods of the plaintiff under the brand name “FALCITAB” but laid down the general principles to be followed for deciding the question of deceptive similarity. While doing so it was also held that though schedule H drugs can be sold only on the prescription of the doctor and schedule L drugs are to be sold only to the hospitals and clinics but it is not un-common that because of lack of competence or otherwise mistakes can arise where the trademarks are deceptively similar. It was also held that confusion of source or product between medicinal products may produce physically harmful results to purchasers and greater protection is thus required than in the ordinary case and that if the goods involved are medicinal products, each with different

effects and designed for different uses, confusion amongst the products caused by similar marks could have disastrous effects and for this reason, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations. Else, the factors to be considered were laid down as (a) the nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works; (b) the degree of resemblance between the marks, phonetically similar and hence similar in idea; (c) the nature of the goods in respect of which they are used as trade marks; (d) the similarity in the nature, character and performance of the goods of the rival traders; (e) the class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods; (f) the mode of purchasing the goods or placing orders for the goods; and, (g) any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks. It was also held that weightage to be given to each of the said factors depends upon facts of each case and the same weightage cannot be given to each factor in each case.

19. In *Medley Pharmaceuticals Ltd.* supra the marks “O₁B”, “O₁B PLUS” and “O₂B” were held at the interim stage to be too proximate in visual, phonetic and structural similarity to the marks “OTWO”, “O₂” and “O₂H” and case of passing off was held to have been made out.

20. In *Lupin Limited* supra a Single Judge of the Bombay High Court, again at the interim stage found the mark “NEBISTOL” of the defendants to be identical and/or deceptively similar to the registered trademark

“NEBISTAR” of the plaintiff.

21. I have considered the case of the plaintiff in the light of the principles of law laid down in the aforesaid judgments also but do not find the same to be affecting the view expressed hereinabove, of there being absolutely no similarity between the marks ‘EYEPCL’ of the defendants to the mark of ‘ICL’ of the plaintiff or of the possibility of the goods of the defendants being passed off as that of the plaintiff. As aforesaid, Supreme Court in ***Cadila Health Care Ltd.*** also held that the weightage to be given to each of the factors spelled out in that judgment depends upon the facts of each case and the same weightage cannot be given to each factor in each case. The nature of the goods in the present case is surgical implantable intraocular lenses. The marks of both the plaintiff and the defendants are composite marks i.e. both words and label marks. There is no resemblance between the marks. The use of the word ‘EYE’ in relation to the said goods is a necessity and merely because the plaintiff in its mark has incorporated the word ‘I’, the plaintiff cannot claim a right to restrain all other manufactures of the goods from using the word ‘I’ whatsoever way it may be written in relation to the goods of others. There is no resemblance or similarity otherwise in the marks of the plaintiff and the defendants. The class of purchaser of such goods is highly skilled i.e. those who are competent to intrude into the human body and perform surgical procedure therein. Certainly there can be no possibility of such purchasers/consumers confusing the goods of the defendants as those of the plaintiff. Ordinarily surgeons and hospitals procure such surgical implants themselves. Even if a case of the surgeon/hospital asking the patients to procure the surgical implants were to

be considered, the surgical implants cannot be used by the patient himself/herself and have to necessarily pass through the hands of the surgeon.

22. Supreme Court, not only in ***Cadila Health Care Ltd.*** supra but earlier also in ***Amritdhara Pharmacy*** supra held that “The Act does not lay down any criteria for determining what is likely to deceive or cause confusion. Therefore, every case must depend on its own particular facts, and the value of authorities lies not so much in the actual decision as in the tests applied for determining what is likely to deceive or cause confusion”.

23. I have also wondered that this being a suit, whether I am bound to issue summons thereof and go through the drill of completion of pleading, framing of issues, recording of evidence, inspite of not finding any possibility of the goods of the defendants being passed off as that of the plaintiff by use by the defendants of the trademark ‘EYEPCL’.

24. Having given a thought I conclude that it is not as if a civil suit has to be necessarily entertained and carried through the process of completion of pleadings, framing of issues and recording of evidence. It has been held in ***Zubair Ul Abidin Vs. Sameena Abidin*** 214 (2014) DLT 340 DB that suits which are doomed to fail and of which there is no chance of any success should be dismissed at whatever stage the Court finds it to be so. In relation to passing off suits also, it has been held by this Court in ***Camlin Private Limited v. National Pencil Industries*** AIR 1986 Del 444 that the suit can be dismissed in *limine*.

25. Not only so, the plaintiff though had an option to institute this suit before the District Judge, has chosen to file it as a commercial suit before the Commercial Division of this Court. Commercial Courts, Commercial Division and Commercial Appellate Division of the High Courts Act, 2015 has amended CPC vis-à-vis Commercial Disputes and Order 13A of the Code of Civil Procedure, 1908 as applicable to commercial disputes allows summary dismissal of suit. The plaintiff having chosen to file the suit as a commercial suit, has taken a chance of the suit being summarily dismissed.

26. I am also of the view that the test ultimately has to be applied by the Courts on formation of a view in accordance with the principles laid down from time to time including in the judgments supra and even if an opportunity is given to the plaintiff to lead evidence, the self serving evidence of the witnesses of the plaintiff of having got confused is rarely of any help. Supreme Court, in ***Mahendra & Mahendra Paper Mills Ltd. Vs. Mahindra & Mahindra Ltd.*** (2002) 2 SCC 147 followed by the Division Bench of this Court in ***Larsen & Toubro Ltd Vs. Lachmi Narain Trades*** (2008) 149 DLT 46 held that, whether there is a likelihood of deception or confusion arising, is a matter for decision by the Court and no witness is entitled to say whether the mark is likely to deceive or to cause confusion. For this reason also I have no hesitation in dismissing the suit in *limine* having not found the plaintiff to have satisfied the test of passing off as also laid down in ***Satyam Infoway Ltd. Vs. Sifynet Solutions Pvt. Ltd.*** (2004) 6 SCC 145.

27. No case of admitting the suit is thus made out.
28. Dismissed. No costs.

Decree sheet be prepared.

RAJIV SAHAI ENDLAW, J

JULY 19, 2016

‘pp’ (*Corrected and released on 24th August, 2016*).