

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
APPEAL NO. 448 OF 2015
IN
NOTICE OF MOTION (L) NO. 2540 OF 2014
IN
SUIT NO. 175 OF 2015

Indchemie Health Specialities Pvt. Ltd.	..Appellant
versus	
Intas Pharmaceuticals Ltd. & Ors.	..Respondents

Mr. Virag Tulzapurkar – Senior Advocate with Mr. Hiren Kamod and Mr. Mahesh Mahadgut i/b. Mahesh Mhadagut for Appellant.
Mr. V. R. Dhond – Senior Advocate with Rashmin Khandekar, Adheesh Nargolkar, Mr. S. Bhandare and Mr. Vaibhav Keni i/b. Khaitan & Company for Respondents Nos. 1 to 3.

**CORAM: DR. MANJULA CHELLUR, CJ. &
M.S. SONAK, J.**

Date of Reserving the Order	: 17 November 2017
Date of Pronouncing the Order	: 28 November 2017

ORDER :

1] This Appeal is directed against the order dated 24th June 2015 in Notice of Motion (L) No. 2540 of 2014 in Suit No. 175 of 2015 denying the Appellant / Plaintiff ad interim relief to restrain the Respondents / Defendant from infringing Appellant's registered trade mark CHERI bearing registration no. 472197 in class 5 in respect of pharmaceutical preparations by use of the trade mark MULTI CHERRY in respect of the dietary health supplement.

2] The main ground on which the learned Single Judge has declined ad interim relief to the Appellant was that the Appellant's registration was restricted to a narrow class i.e. pharmaceutical preparations and therefore, the same did not cover the Respondent's medicinal or dietetic product. This is evident from the discussion at paragraphs 11 to 13 of the impugned order.

3] The Appellant has instituted Suit No. 175 of 2015 alleging both, infringement of the registered trade mark as well as passing off. Since, the two causes of action were sought to be combined in the same suit, the Appellant applied and obtained leave under Clause XIV of the Letters Patent by order dated 14th January 2015. The Respondents appealed against the order dated 14th January 2015 (Appeal No. 95 of 2015) before the Division Bench. By order dated 5th February 2015, the appeal was posted for final disposal on 19th March 2015. In the meantime, the Appellant / Plaintiff was granted liberty to take out their motion seeking ad interim / interim relief on the ground of infringement of their trade mark. The objection as regards jurisdiction and other contentions raised by the Respondents herein, were however kept open. It is in these circumstances that the learned Single Judge took up motion for ad-interim relief restricting examination to the ground of infringement of trade mark and not passing off.

4] We are now informed that Appeal No. 95 of 2015 instituted by the Respondents has since been dismissed. The notice of motion, in which, ad-interim relief came to be denied by the impugned order is also due for hearing. The Respondents herein, in their written submissions, have stated that the notice of motion is itself due for hearing and the issue of jurisdiction raised by the Respondents is an issue of law which will not detain the hearing of the notice of motion. In such circumstances,

ordinarily, this appeal could have been disposed of by merely requesting the learned Single Judge to take up and dispose of the notice of motion itself, as expeditiously as possible.

5] However, Mr. Tulzapurkar, learned Senior Counsel for the Appellant, submits that the reasoning in paragraphs 11 to 13 of the impugned order will completely foreclose the Appellant's case of infringement and perhaps even passing off at the stage of consideration of Notice of Motion. He therefore, submits that this Appeal be decided on merits so that the observations in the impugned order or its reasoning does not in any manner influence the disposal of the Notice of Motion. At that stage, as noticed earlier, Appeal No. 95 of 2015 was pending before the Division Bench.

6] The matter was argued by Mr. Tulzapurkar for the Appellant and Mr. Dhond for the Respondents on some dates. On account of reorganization of the Benches, the hearing was interrupted for some time. Ultimately, both the learned counsel, filed written submissions in support of their respective positions.

7] Taking into consideration the fact that much time has elapsed since the institution of this Appeal and the circumstance that Appeal No. 95 of 2015 now stands disposed of, we propose to remand the matter for consideration of the Notice of Motion to the learned Single Judge. The Notice of Motion will now be required to be considered not only on the issue of infringement of trade mark but also passing off. In the written submissions filed on behalf of the Respondents, it is made clear that the issue of jurisdiction raised by the Respondents is only an issue of law and therefore, the same, will not detain the hearing of the Notice of Motion. This is noted and accepted.

8] Since, remand is proposed, we do not think that it will be appropriate to deal with the issues raised in the Appeal in some detail. However, we have some difficulty in accepting the reasoning in paragraphs 11 to 13 of the impugned order. In these paragraphs, it is basically held that the Appellant's trade mark relates to pharmaceutical preparations and the Respondents products are dietary health supplements. Therefore, considering the narrow class of products for which the Appellant holds registration, there is no case of infringement of the trade mark made out.

9] According to us, the proposition that a plaintiff is entitled to protection of its registered trade mark only in respect of the narrow class of products to which the registration relates, is a rather broad proposition. This will unduly narrow the scope and ambit of the provisions in sections 28 and 29 of the Trade Marks Act, 1999. On basis of such construction, the learned Single Judge in the present case, has really not gone into the issue of whether the rival products were of similar description or not. In any case, the learned Single Judge has held that even the aspect of similarity of products has to be examined only with reference to the narrow and sharply defined class of products in respect of which the registration has been obtained. The impugned order holds that since the Appellant's registration pertains to pharmaceutical preparations, infringement can arise only where the rival products are pharmaceutical preparations. In our opinion, at least, *prima facie*, such a construction may not be consistent with the statutory scheme of sections 28 and 29 of the Trade Marks Act, 1999.

10] In terms of section 29 of the Trade Marks Act, 1999, a registered trade mark is infringed by a person, who uses in the course of trade, a

mark which is deceptively similar to the registered trade mark and user of such mark in a manner as to render the use of the mark '*likely to be taken as being used as a trade mark*'. Section 29(2) after setting out the manner in which or the circumstances in which infringement can take place makes specific reference to the situation where the use '*is likely to cause confusion on the part of the public*'. Infringement can occur where the rival mark is identical with or similar to the registered trade mark and is used in relation to goods or services which are similar to those for which the trade mark is registered.

11] At least *prima facie*, therefore, in a matter of this nature, it is not sufficient to go merely by the classification against which registration may have been obtained. The classification may be one of the considerations, but it cannot be the sole consideration. The weight to be attached to this consideration will depend upon the fact situation in a particular case. The usual criteria for determining whether the rival products are of similar description cannot be ignored or made subservient to the sole criteria of classification against which registration may have been obtained.

12] The usual criteria for determining whether rival products are of similar description include the nature and composition of the product; their respective uses and functions; and the trade channels through which they are generally traded. The three need not even concurrently co-exist. The relative weight to be attached to each of such considerations again depends upon the fact situation of a particular case. But generally, the expression '*goods of same description*' is not to be construed so narrowly as to limit it only to goods which may be substantially analogous to or mere substitutes or alternatives to one another. Such matters must be construed from the point of view of the

public or the consumers. Such matters must not ordinarily, be construed from the perspective of chemists or pharmacists. Even in case of prescription drugs, confusion and mistakes in relation to similar goods is not ruled out. Therefore, such matters have to be necessarily viewed from the business point of view.

13] In the present case, the rival products are concerned with iron and vitamin deficiencies. In a sense therefore, both are health supplements. At least *prima facie*, the rival products are traded on the same or similar trade channels. The public or the consumers, normally, are unaware and in any case, do not go by the classification against which registration may have been obtained. They go by the normal business point of view. It is therefore from this point of view with which the matter should normally be examined. It is therefore this perspective which must receive due weight and consideration in determining whether the rival products are similar, deceptively similar or likely to cause confusion on the part of the public. All such considerations do not fade away only because the registration relates to a particular classification and the rival products to another. At least *prima facie*, such a construction may unduly restrict scope and ambit of sections 28 and 29 of the Trade Marks Act, 1999.

14] In ***Gutta Precha and Rubber Manufacturing Company of Toronto*** reported in **(1909) 26 RPC 428**, the Court has held that the description of the goods is not to be read solely with the class in which registration is effected. The description of the goods may be narrower or wider than the whole class. The matter should be looked at from the business and commercial point of view and if the Court is satisfied that the goods, although in different classes, are really the same description of the goods, relief cannot be denied.

15] In ***The Australian Wine Importers, Limited*** reported in (1889) 6 RPC 311, the Court has held that wine and spirits are, no doubt, different goods. However, in matters of infringement and in determining the expression “*the same description of the goods*”, the Court does not consider how Chemists would describe them but would consider how manufacturers and merchants would look upon them as goods of the same description. Thus, the question has to be addressed from the business point of view.

16] For the aforesaid brief reasons, we set aside the impugned order. However, from this, it does not follow that we grant the Appellant ad interim relief in this Appeal itself. The reasons for this are briefly discussed hereafter.

17] Almost three years have elapsed since the institution of this Appeal and there is no ad interim relief in operation. The Notice of Motion is now due for hearing. At the stage of making the impugned order, the learned Single Judge had only adverted to the issue of infringement and not the issue of passing off. The impugned order had denied ad interim relief to the Appellant focusing almost entirely on the issue of classification. Just as other contentions urged by the Appellant were not considered, so also, various other defences urged by the respondents were also not considered.

18] If we have to consider the motion for ad-interim relief ourselves in this Appeal, then, we will also have to consider the several grounds raised by Mr. Dhond as to why no ad-interim relief is due to the Appellant. Several of these grounds were never considered by the learned Single Judge and therefore, it will be for the first time that we will have to

consider the same. Mr. Dhond relies on ***Indian Cable Co. Vs. Their Workmen 1974 (3) SCC 11***, to submit that the Respondents in the Appeal are entitled to defend the impugned order not only on the grounds and reasoning stated in the impugned order but on other grounds and reasons as well.

19] Mr. Dhond, whilst defending the reasoning in the impugned order on demurer urged several grounds for denial of any ad interim relief to the Appellant. He urged the issue of suppression, scope of pharmaceuticals, medicinal and dietary preparations, tendency to operate trade marks beyond their legitimate bounds, the significance of conditions and limitations at the stage of registration of a trade mark and their impact in interpreting sections 28 and 29 of the Trade Marks Act, 1999, the impact of other provisions of the Trade Marks Act on the interpretation of the provisions in sections 28 and 29 thereof, the protection in misspelling cases, the significance of a descriptive trade mark, the policy of monopolizing common words and so on. If we are to consider all such aspects at the ad interim stage, then, this might deprive the parties of the right of an appeal. In this matter, we do not have the benefit of the examination of all these aspects by the learned Single Judge. For all these reasons, we feel that interests of justice will be better served if the matter is remanded for disposal of the Notice of Motion itself, on its merits and in accordance with law.

20] As submitted by Mr. Dhond, the preliminary objection raised by the respondents is only a question of law and will not involve leading of any evidence. This is already noted. The respondents may raise the preliminary objection but not unduly detain the hearing of the Motion.

21] Accordingly, we dispose of this Appeal by the following order :

- (A) The impugned order dated 24th June 2015 is set aside;
- (B) The learned Single Judge is requested to dispose of the Notice of Motion (L) No. 2540 of 2014 in accordance with law and on its own merits as expeditiously as possible and preferably, within a period of two months from today;
- (C) There shall be no order for costs.

(M. S. SONAK, J.)

(CHIEF JUSTICE)