

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 24.07.2018

Coram

The Hon'ble Mr. Justice M.M.SUNDRESH
and
The Hon'ble Mr. Justice N.ANAND VENKATESH

O.S.A.Nos.167 to 169 of 2018

M/s.Micro Labs Limited rep. by its
Company Secretary Yogesh K.Shenoy .. Appellant/Plaintiff in
all the appeals

Vs

M/s.Eris Lifesciences Limited,
8th Floor, Commerce House IV,
Prahaladnagar, 100 Feet Road,
Ahmedabad - 380 015. ..Respondent /Defendant in
all the appeals

(cause title amended vide order
dated 10.07.2018 made in C.M.P.
Nos.11812 to 11814 of 2018 in
O.S.A. Nos.167 to 169 of 2018)

Appeals preferred under Order XXXVI Rule 9 of O.S. Rules
r/w Clause 15 of Letters Patent against the order dated
11.01.2017 made in A.No.3571 of 2016, O.A.Nos.472 and 473 of
2013 in C.S.No.426 of 2013.

Prayer in Application 3571 of 2016: Application filed under
section 124 of Trade mark Act 1999 and section 151 of Civil
Procedure code to stay the suit proceedings in view of the
rectification application filed by the Applicant/defendant
before IPAB for removal Trademark "OLAMIN" vide Application No.
451348 in Clause 5 registered in the name of the
respondent/Plaintiff until the Final disposal at rectification
proceedings.

O.A.No. 472 of 2013: Original Application praying that this
Honourable Court pleased to pass on order of Interim Injunction
restraining the respondent/defendant their men agents or any
person claiming through them from in any manner infringing the
applicant/plaintiffs Trade Mark "OLAMIN" by manufacturing
marketing distributing offering or advertising for sale the

respondent/defendants product in the name and style of "OLMIN" or any other deceptively similar name.

O.A.No. 473 of 2013: - Original Application praying that this Court be pleased to pass on order of Interim Injunction restraining the respondent/defendant their men agents or any person claiming through them from in any manner manufacturing marketing distributing offering or advertising for sale their product "OLMIN" or similar sounding names in the course of their business and pass off their products using the Trademark "OLAMIN" or with additions as and for the goods of the applicant/Plaintiff or enable others.

C.S.No.426 of 2013:

The Plaintiff therefore prays for a Judgment and Decree against the defendant:

a) For a permanent injunction restraining the defendant, their men, agents or any person claiming through them from in any manner infringing the plaintiffs trade mark "OLAMIN" by manufacturing, marketing, distributing, offering or advertising for sale the defendants product in the name and style "OLMIN" or any other deceptively similar name.

b) For a permanent injunction restraining the defendant, their men, agents or any person claiming through them, from in any manner, manufacturing, marketing, distributing, offering or advertising for sale their product "OLAMIN" or similar sounding names in the course of their business and pass off their products using the trademark "OLAMIN" or with additions as and for the goods of the plaintiff or enable others to pass off.

c) For a mandatory injunction directing the defendant to surrender all the infringing products, packing, materials, labels etc. in the market to the plaintiff for destroying and

d) award costs.

For Appellant .. Mr.Sai Krishnan
for M/s.Sai Bharath and Ilan
in all the appeals
For Respondent .. Dr.Venkat Reddy
for Mr.S.Vijayabharathi
in all the appeals

COMMON JUDGMENT

(Judgment of the Court was delivered by M.M.SUNDRESH, J.)

The plaintiff is the appellant before us. The suit is filed for infringement of trade mark and passing off. The plaintiff is

having the trade mark "Olamine" as against the defendant who is having the trade mark "Olmin". The plaintiff's trade mark is a registered one. The suit has been laid for passing off also on the ground of prior user and deceptive similarity. Pending the suit, the appellant sought for injunction.

2. Alleging that there is an element of invalidation involved as the trade mark registered by the plaintiff is a drug content itself - Ciclopirox Olamine USP, the respondent invoked Section 124 of the Trade Marks Act. Accordingly, an application was filed seeking stay of the proceedings of the suit till the rectification proceedings are over. The learned single Judge dismissed the injunction applications filed by the appellant while granting stay of the proceedings of the suit as prayed for. Challenging the same, the present appeals are filed.

3. Heard the learned counsel appearing for the parties.

4. Learned counsel appearing for the appellant would submit that it is a suit not only for infringement of trade mark but also for passing off. The respondent is a prior user. It is only during the proceedings before the Court, an application for rectification was filed. Thus the orders passed by the learned single Judge would require interference.

5. Learned counsel appearing for the respondent would submit that the trade mark is international non-proprietary name. Thus it is in the public domain. Therefore, the rigor of Section 13 of the Trade Marks Act would apply. Already, the proceedings have been initiated and in progress before the Intellectual Property Appellate Board. The appellant is yet to file the counter affidavit. There is no material to hold that the appellant was actually using the mark. The ingredients are different. The appellant is using it for dermatological purpose whereas the respondent is using the product for anti hypertension. While the appellant's product is an ointment, the respondent's is one of tablet form. Both are coming under Schedule 4 and therefore they can only be used on prescription by the medical practitioner. One has to see the object behind Section 124 of the Trade Marks Act. Therefore, no interference is required.

6. On a prima facie consideration, we are of the view that the purpose of usage of the product of the appellant and the respondent is different. It is also to be seen that the appellant was actually using the name "Olamine" and thereafter changed it to "Olamine" in the year 2011. This was done only after the objection raised by the respondent. The suit was filed only in the year 2013. Though the delay per se cannot be a ground, it is a factor to be seen at this stage.

7. Admittedly, the proceedings are pending before the Intellectual Property Appellate Board for rectification. Therefore, it is nothing but appropriate to award the compensation. In such view of the matter, we do not find any merit in these appeals. Accordingly, these original side appeals stand dismissed. No costs.

8. However, we are inclined to grant stay of the proceedings of the suit till 31.03.2019 in view of the submission made that the hearing is in progress and it is likely to be completed before the end of February, 2019. Therefore, we restrict the stay of the further proceedings of the suit till the end of March 2019. If the proceedings before the Intellectual Property Appellate Board is not completed by that time, it is well open to the parties to approach this Court to seek for modification of the order. Inasmuch as we are dismissing the appeals against rejection of injunction applications sought for both on the ground of infringement of trade mark and passing off, the respondent is directed to maintain the account and file the same on or before 7th of every month before this Court. The compliance will have to be made from the month of August, 2018.

Sd/-
Assistant Registrar (CS VI)

//True copy//

Sub Assistant Registrar

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To

The Sub Assistant Registrar,
Original Side, High Court, Madras.

+1cc to Mr.RVR Associates, Advocate SR.No.49719

+2cc to Mr.T.Sasikrishnan, Advocate SR.No.49629

O.S.A.Nos.167 to 169
of 2018

NMI (CO)
GN(27/08/2018)