

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated:29.10.2018

CORAM

THE HON'BLE MR.JUSTICE M.SUNDAR

C.S.No.576 of 2018

&

O.A.No.769 to 771 of 2018

Indo French Laboratories Ltd,
No.12, 66th Street,
11th Sector, K.K.Nagar,
Chennai - 600 078.
represented by its Director Ms.Ianthy Fernandez .. Plaintiff

Vs.

M/s.Swiss Garnier Biotech,
21, Industrial Area, Mehatpur,
Himachal Pradesh - 174 315. .. Defendant

This Civil Suit is preferred, under Order IV Rule - 1 O.S Rules and Order VII Rule 1 C.P.C Read with Sections 27,28,29, 134 & 135 of the Trade Marks Act, 1999, Sections 51,54, 55 and 62 of the Copyrights Act, 1957 and Section 7 of the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, No. 4 of 2016 - Suit for Permanent injunction for the infringement of Trade Mark and Passing Off; for a permanent injunction restraining the Defendant by itself, its Directors/Partners/Proprietor as the case may be, affiliates, manufacturers, distributors, stockists, marketers, servants, agents, wholesalers, retailers, legal representatives, successor in business or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, trading, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations infringing plaintiff's registered trademark REJUCALCIUM by use of an identical mark REJUCALCIUM or any mark deceptively similar to plaintiff's registered trademark REJUCALCIUM or in any other manner whatsoever; for a permanent injunction restraining the Defendant by itself, its Directors/Partners//Proprietor as the case may be, affiliates, manufacturers, distributors, stockists, marketers, servants, agents, wholesalers, retailers, legal representatives, successor in business or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, trading, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations under the REJUCLACIUM label/packaging that is identical to the label/packaging of the Plaintiff label/packaging thereby infringing the Plaintiff's copyright in their distinctive REJUCALCIUM label/packaging or any other label identical and/or deceptively similar as that of the Plaintiff's mark REJUCALCIUM label/packaging in any other manner whatsoever; for a permanent injunction restraining the Defendant by itself, its Directors/Partners/Proprietor as the case may be affiliates, manufacturers, distributors, stockists, marketers, servants, agents, wholesalers, retailers, legal representatives, successor in business or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, trading, advertising directly or indirectly

dealing in medicinal and pharmaceutical preparations under the trademark REJUCALCIUM and label/packaging that is identical and/or deceptively similar as that of the Plaintiff's mark REJUCALCIUM and label/packaging so as to pass off the Defendant's medicinal preparations as and for the medicinal preparations of the Plaintiff and/or in any other manner whatsoever; the defendant be ordered to pay to the Plaintiff a sum of Rs.10,00,000/- as damages for committing acts of infringement against Plaintiff's registered trademark, infringement of copyright in label/packaging so as to pass off its products as and for the plaintiff's products; the Defendant be ordered and decreed to deliver up for destruction to the Plaintiff all the preparations, dies, blocks, labels, packaging either filled or empty, brochures, leaflets, pamphlets, handbills, hoardings, wall posters, calendars, carry bags, stationery items and such other sales promotional materials bearing and/or containing the impugned trademark REJUCALCIUM and label/packaging; for a preliminary decree be passed in favour of the Plaintiff directing the Defendant to render accounts of profits made by it by use of the trademarks REJUCALCIUM and label/packaging which is identical and/or deceptively similar to the Plaintiff's mark and label/packaging and a final decree be passed in favour of the plaintiff for the amount of profits found to have been made by the defendants after the latter has rendered accounts; and for costs.

For Plaintiff : Ms.S.Suba Shiny

For Defendant : Ms.C.Bhargavi

JUDGMENT

Ms.S.Suba Shiny, learned counsel on record for sole plaintiff and Ms.C.Bhargavi of M/s.A.K.Mylsamy and Associates (Law Firm) on behalf of sole defendant are before this Commercial Division.

2.Before I proceed further with this judgment / proceedings, it is to be recorded that it is brought to my notice by learned counsel for defendant that defendant has been described as 'M/s.Swiss Garnier Biotech', but the sole defendant is a Private Limited Company incorporated under the laws of India and it was incorporated sometime in July 2018. It is submitted that the sole defendant is, therefore, a juristic person and it goes by the name 'Swiss Garnier Biotech Private Limited'. In the light of the aforesaid submission, which is not disputed, this is recorded in this judgment.

3.Be that as it may, subject matter of this suit is pharmaceutical and medicinal preparations. Plaintiff has a registered Trademark i.e, REJUCALCIUM. This is a word mark. It is registered in Class 5 i.e., Pharmaceutical and Medicinal Preparations. Certificate Number is 217376 dated 31.01.1999 and the registration is valid up to 20.10.2020. This mark shall hereinafter be referred to as 'suit TM' for the sake of convenience and clarity.

4.Plaintiff is manufacturing and marketing pharmaceutical and medicinal preparations and the suit TM is being applied on the plaintiff's products and the depiction of the same, which is placed before this Commercial Division in the suit file are as follows:

5.Plaintiff has laid the suit stating that they have come to know in April 2018 that the defendant is marketing the same product with virtually an identical Trade Mark. It is also the case of the plaintiff that defendant is exporting to Sri Lanka, where the plaintiff has a substantial market.

6.As per the suit file placed before me, the marks that are being used by the sole defendant are as follows:

7. Plaintiff counsel submits that plaintiff has copyright also in the suit TM. Therefore, aforesaid action of defendant is infringement of plaintiff's Copyright also, besides being infringement of suit TM is her say. It is also the further case of the plaintiff that the aforesaid action on the part of the defendant is a clear case of passing off.

8. On coming to know about the aforesaid alleged infringement of suit TM, Copyright and passing off by the sole defendant, plaintiff caused a Cease and Desist notice dated 18.04.2018 to be issued to the sole defendant. From the suit file it is seen that the Cease and Desist notice has been duly received by the sole defendant on 24.04.2018. It is the specific case of the plaintiff that the defendant having received the Cease and Desist notice on 24.04.2018 has not chosen to respond or reply, but sale is continuing unabated. On this basis, instant main suit has been presented in this Commercial Division on 13.08.2018.

9. Three interlocutory applications i.e., O.A.Nos.769 to 771 of 2018 were moved by the plaintiff along with the suit and interim orders were granted by this Court on 20.08.2018. Sole defendant, who has been duly served, has entered appearance and filed a common counter affidavit dated 22.10.2018 in the aforesaid three interlocutory applications.

10. Paragraph 7 of the aforesaid counter affidavit of the sole defendant is vital as it impacts the main suit, is the common say of learned counsel on both sides. Paragraph 7 reads as follows:

'7. It is submitted that the Respondent has infringed on the Intellectual Property Rights of the Applicant to the extent of the manufactured quantity as stated above, however, such infringement is neither willful nor wanton and has arisen from misrepresentations made by M/s. Harcourts (Pvt) Limited. It is submitted that the Cease & Desist Notice dated 24.04.2018 issued by the Applicant was sent to its factory in Himachal Pradesh, while the registered office is in Chennai, due to which the Respondent herein was unable to respond before the institution of the suit. Further, the Respondent hereby undertakes not to infringe or pass off, in any manner, the Intellectual Property Rights of the Applicant. '

(underlining made this Court to supply emphasis and highlight)

11. Referring to the aforesaid Paragraph 7 of the common counter affidavit filed in the three interlocutory applications by the defendant, both learned counsel submit that this is a fit case for summary judgment under Order XIII-A of 'The Code of Civil Procedure, 1908' ('CPC' for brevity) as amended by 'The Commercial Courts Act, 2015' ('said Act' for brevity).

12. In the light of the fair stand taken by the sole defendant, particularly in Paragraph 7 of the common counter affidavit, which has been extracted and reproduced supra, counsel for plaintiff, on instructions from the plaintiff, submits that plaintiff would give up the prayers in the plaint other than the injunctive relief prayers. To be noted, prayer paragraph in the plaint is Paragraph 28 and the same reads as follows:

'28. The Plaintiff therefore prays that this Hon'ble Court may be pleased to grant a Judgment and decree on the following terms:

(a) for a permanent injunction restraining the Defendant by itself, its Directors/Partners/Proprietor as the case may be, affiliates, manufacturers, distributors, stockists, marketers, servants, agents, wholesalers, retailers, legal representatives, successor in business or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, trading, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations infringing plaintiff's registered trademark REJUCALCIUM by use of an identical mark REJUCALCIUM or any mark deceptively similar to plaintiff's registered trademark REJUCALCIUM or in any other manner whatsoever; (b) for a permanent injunction restraining the Defendant by itself, its Directors/Partners/Proprietor as the case may be, affiliates, manufacturers, distributors, stockists, marketers, servants, agents, wholesalers, retailers, legal representatives, successor in business or any other person claiming under it from in any manner manufacturing, selling, offering for sale,

stocking, trading, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations under the REJUCALCIUM label/packaging that is identical to the label/packaging of the Plaintiff label/packaging thereby infringing the Plaintiff's copyright in their distinctive REJUCALCIUM label/packaging or any other label identical and/or deceptively similar as that of the Plaintiff's mark REJUCALCIUM label/packaging in any other manner whatsoever;

(c) for a permanent injunction restraining the Defendant by itself, its Directors/Partners/Proprietor as the case may be affiliates, manufacturers, distributors, stockists, marketers, servants, agents, wholesalers, retailers, legal representatives, successor in business or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, trading, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations under the trademark REJUCALCIUM and label/packaging that is identical and/or deceptively similar as that of the Plaintiff's mark REJUCALCIUM and label/packaging so as to pass off the Defendant's medicinal preparations as and for the medicinal preparations of the Plaintiff and/or in any other manner whatsoever;

(d) the defendant be ordered to pay to the Plaintiff a sum of Rs.10,00,000/- as damages for committing acts of infringement against Plaintiff's registered trademark, infringement of copyright in label/packaging so as to pass off its products as and for the plaintiff's products;

(e) the Defendant be ordered and decreed to deliver up for destruction to the Plaintiff all the preparations, dies, blocks, labels, packaging either filled or empty, brochures, leaflets, pamphlets, handbills, hoardings, wall posters, calendars, carry bags, stationery items and such other sales promotional materials bearing and/or containing the impugned trademark REJUCALCIUM and label/packaging;

(f) for a preliminary decree be passed in favour of the Plaintiff directing the Defendant to render accounts of profits made by it by use of the trademarks REJUCALCIUM and label/packaging which is identical and/or deceptively similar to the Plaintiff's mark and label/packaging and a final decree be passed in favour of the plaintiff for the amount of profits found to have been made by the defendants after the latter has rendered accounts;

(g) For costs of the entire proceedings, and;

(h) pass such further or other orders as this Hon'ble Court may deem fit and proper in the circumstances of the case and thereby render justice.'

13. In other words, it is the specific submission of learned counsel for plaintiff, on instructions, that in the light of the fair stand taken by the sole defendant, plaintiff is giving up prayers contained in sub-paragraphs (d), (e), (f), (g) and (h) of the prayer paragraph extracted and reproduced supra. Axiomatically it is submitted that the plaintiff will be entitled to a decree in terms of sub-paragraphs (a), (b) and (c) of the prayer paragraph extracted supra.

14. To be noted, this is a common submission made by both learned counsel and learned counsel for defendant also submits on instructions that a decree in the aforesaid manner will give a quietus to the entire lis.

15. Adverting to Rule 3 of Order XIII-A of CPC as amended by said Act, both learned counsel submitted that defendant has no real prospect of successfully defending the claim qua sub-paragraphs (a), (b) and (c) of prayer paragraph extracted supra and there is no other compelling reason as to why the claim of the plaintiff with regard to those three limbs should not be disposed without recording oral evidence. It is also pointed out that in the light of plaintiff, on instructions, giving up other limbs of the prayer sub-paragraphs, namely (d) to (h), the main suit itself can be disposed of by this summary judgment without resorting to oral evidence.

16. One aspect of relevance is, besides aforesaid Paragraph 7 in the counter affidavit, there are certain other averments inter alia touching upon some proceedings between the plaintiff and its

demerged entity. It is made clear that this Court does not express any opinion whatsoever on the aforesaid aspects of the matter and all those aspects are left open to be carried to their logical end in the appropriate fora. In other words, this summary judgment will not be an impediment for those proceedings and this summary judgment does not express any opinion on those proceedings.

17. In the light of the narrative supra, there shall be a decree in the main suit in terms of sub-paragraphs (a) to (c) of the prayer paragraph. Sub-paragraphs (d) to (h) are given up. As the given up sub-paragraphs includes prayer paragraph (g), there shall be no order as to costs. Consequently, the connected interlocutory applications are closed.

There shall be a compromise decree on aforementioned terms and the aforesaid counter affidavit dated 22.10.2018 shall form part of the compromise summary judgment.

29.10.2018

Index : Yes/No

gpa/mp

M.SUNDAR, J.

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