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

Date of decision: 5th July, 2018

+ **CS(COMM) 93/2018 & I.A. 17848/2014 (Stay), I.A. 8333/2015 (u/o XXXIX Rule 4)**

M/S SBS BIOTECH(UNIT II) & ORS

..... Plaintiff

Through: Mr. Sanjeev Singh, Mr. D.K. Yadav
Ms. Kamla, Advocates (M-9650508945).

versus

M/S SAMPHIRE FOOD & PHARMA (P) LTD & ANR

..... Defendant

Through: Mr. Nikhilesh Kumar, Advocates.

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. The Plaintiff has filed the present suit for permanent injunction restraining infringement, passing off, and rendition of accounts. The product in question is oil which is sold under the trademark/labels/packaging- “*DR. ORTHO*”. The Plaintiff claims to have adopted the same on 8th April, 2011 and has been continuously using it since then. The Plaintiff came to know that the Defendant has adopted the trademark “*ORTHO PREMIUM*” in a deceptively similar packaging/label. Accordingly, the Plaintiff has filed the present suit.

2. The competing labels are set out below:

FRONT VIEW:
DR. ORTHO



ORTHO



3. The Plaintiff also claims that the Defendant is copying the bottle design of the Plaintiff's bottle. The competing bottles are also set out herein below:



4. This court on 15th September, 2014 had granted an ex-parte order of injunction in the following terms:

CS(OS) No.2807/2014 & I.A. No.17848/2014 (u/o XXXIX R.1 & 2 CPC)

Let the plaint be registered as a suit.

Issue summons in the suit and notice in the interim application, to the defendants, on filing of process fee and Regd. A.D. Covers within three days, returnable on 29th October, 2014.

The plaintiff has filed the suit for permanent injunction restraining infringement, passing off, rendition of accounts etc.

Learned counsel for the plaintiffs is pressing for ex-parte ad-interim order. I have heard counsel for the plaintiffs who has referred to various paras of the plaint and documents placed on record.

At the outset, the learned Counsel for the plaintiffs states that the plaintiffs are not pressing the interim order with regard to word ORTHO. However, he states that the defendants have copied the packaging/wrapper/trade dress as well as the design of the bottle which is registered in favour of the plaintiffs bearing No.237224. The contention of the learned counsel for the plaintiffs is that the plaintiffs' goods are available throughout the country and sales of the plaintiffs are increasing day by day. The said set up, lay out and packaging was adopted by the plaintiffs in the year 2011 and within a short span of time, the plaintiffs have achieved today an annual sale of more than Rs.300 crores. The plaintiffs have been advertising their products through various media and modes including television and newspaper etc. The plaintiffs' design is new and original and it has acquired tremendous goodwill and reputation in the global market. Even the turnover of the plaintiff firm for the years 2009-2010 to 2013-2014 has been given in para 18 of the plaint. With regard to advertising of

the said brand name ORTHO along with the trade dress, literatures as design in question in newspapers, the advertisement expenses have been given in para 19 of the plaint which contains the expenses for the years 2009-2010 to 2013-2014. Counsel for the plaintiffs states that the defendants could not have designed the packaging material as well as bottle unless they have seen the design and bottle of the plaintiffs.

In para 27 of the plaint, it is mentioned by the plaintiff that the essential features of the outer packaging and side views of the label are deceptively similar. The point of similarity between front, back and side views are mentioned in the said para which also contains the details of the point of similarities between the perspective and back views and inner packaging/label of the products in question.

In view of the material placed on record, it appears that the plaintiffs have made a strong prima facie case for grant of ex-parte ad-interim injunction against the defendants. Hence, the defendants are restrained from selling, marketing, offering for sale, advertising and selling pharmaceutical and preparations including ayurvedic, homeopathic and unani medicines and preparations i.e. pain killer massage oil and capsules and all allied and cognate goods with the similar packaging/wrapper/trade dress of ORTHO label which are available at pages 4, 5 and 6 of the list of documents filed by the plaintiffs.

Compliance of Order XXXIX Rule 3 CPC be made within two weeks."

5. A Local Commissioner was appointed to make an inventory of the infringing products and as per the Local Commissioner's report 2425 bottles of oil were found and were inventorised.
6. The Defendant no.1 is a proprietary concern of Defendant no.2. In the written statement it was claimed that the Defendant started manufacturing

and selling the products under the brand name ORTHO since 3rd April, 2008. Hence, the Defendant claimed to be a prior user of the brand ORTHO. It was also pleaded in the written statement that the word ORTHO is generic.

7. The Defendant has also filed an application under Order XXXIX Rule 4 seeking vacation of the injunction order.

8. A perusal of the documents filed on record by the Defendant shows that the Defendant has not filed any advertisement or any other independent evidence to show adoption and use of the infringing labels/packaging prior to the Plaintiff i.e. since 2008. However, the Defendant has placed on record documents to show the adoption of the trademark ORTHO since 2008. These documents, however, do not depict the packaging and the labels. Further, none of the documents also depict the design of the bottle which was being used by the Defendant. The invoices which have been placed on record by the Defendant also mention the product as 'ORTHO Oil'.

9. The counsel for the Plaintiff submits that he does not claim exclusive right in the word 'ORTHO'. However, his objection is to the packaging/labels and the design of the bottle being used by the Defendant.

10. Since there is no evidence on record to show that the Defendant has in fact been using the infringing labels/packaging/bottles since 2008, or any time prior to the Plaintiff's adoption and use thereof, the defence of prior user qua the labels/packaging/bottles is not made out by the Defendant.

11. The counsel for the Defendant submits that his client is willing to change the labels/packaging and design of the bottles and that the injunction may be confirmed. Under these circumstances, the suit is decreed in terms of para 39 (A) and (B) of the plaint. The Defendant shall ensure that any new

packaging/label are not similar to that of the Plaintiff's. The Defendant shall also ensure that the shape of the bottle is also not a colourable imitation or reproduction of the Plaintiff's bottle shape.

12. Insofar as the products seized by the Local Commissioner are concerned, the Defendants undertake to destroy the same in the presence of the Plaintiff's representative. The parties shall mutually fix a date for the said purpose. The Plaintiff does not press the relief of rendition of accounts/damages.

13. The suit is decreed in terms of Paragraph 39 (A) and (B) of the plaint. Decree sheet be drawn accordingly. All the pending applications are disposed of.

PRATHIBA M. SINGH
JUDGE

JULY 05, 2018
Rahul