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

Date of decision: 17th September, 2018.

+ **CS(COMM) 375/2018 & I .A. 5861/2015**

LIFESTAR PHARMA PVT. LTD. Plaintiff

Through: Mr. Hemant Daswani & Ms. Ishanki
Gupta, Advocates (M-9810556744).

versus

GO-ISH REMEDIES LTD. OF BADDI Defendant

Through: Mr. Amit Jain, Mr. Govind K.
Chaturvedi, Mr. Vardan Anand & Ms.
Vidushi, Advocates (M-9582622350).
Mr. Govind K. Chaturvedi-
Defendant in person (M-
9582622350).

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. The present suit for permanent injunction, restraining passing off, infringement of trademark, delivery up, rendition of accounts and damages has been filed by the Plaintiff in respect of its mark 'SCABELICE'. According to the Plaintiff, the mark was coined in 2006 in respect of pharmaceutical preparations for treatment of skin infections. Paragraph 3 of the plaint avers that the trademark of the Plaintiff was coined by telescoping the words SCABIES and LICE.

2. The Plaintiff claims to be using the mark since January, 2008 and has a substantial turnover of Rs.4.50 crores in 2012-13. The Plaintiff also claims to be advertising the mark extensively. The Plaintiff's mark is a registered

trademark under the registration no. 1514549. The trademark registration certificate for the mark 'SCABELICE' has been placed on record. A perusal of the certificate also shows that the same is registered as of 18th December, 2006. The sales figures of the Plaintiff have also been placed on record along with the copies of invoices.

3. The Plaintiff claims to have come to know of the Defendant's use of the mark 'SCABILICE' in August, 2013. The only difference between the Plaintiff's and Defendant's marks is the substitution of the letter 'E' with 'I'. A cease and desist notice was issued by the Plaintiff, which was replied to by the Defendant. However, since the dispute was not resolved, the present suit was filed by the Plaintiff.

4. Vide order dated 21st January, 2014, this Court passed an ex-parte ad interim injunction order restraining the Defendant in the following terms:

"The plaintiff has filed the present suit for permanent injunction for restraining the defendants from infringing the registered trademark of the plaintiff. The case of the plaintiff is that the plaintiff coined and adopted the mark "SCABELICE" in respect of medicinal and pharmaceutical preparation in the year 2006. The mark was got registered with the Registrar of Trademarks under Registration No.1514549. As per the plaintiff, the annual sale of the plaintiff in respect of the said mark is over Rs.4.5 crores.

The plaintiff claims to have sold medicinal and pharmaceutical preparation under the trademark "SCABELICE" across the length and breadth of the country. In support of the said claim, the plaintiff has placed on record the Registration Certificate and selective invoices for the sale of the product ranging from the period 2008 till date. The plaintiff has also placed on record various advertisements and materials prima facie evidencing the continuous use of the mark

.SCABELICE".

The plaintiff contends that the defendant has recently adopted a deceptively similar trade mark "SCABILICE". Learned counsel for the plaintiff submits that the said adoption is mala fide and with the intention of encroaching upon the goodwill of the plaintiff. He further submits that the plaintiff even issued a cease and desist notice dated 05.08.2013 setting up their claim and also stating that the product was launched by them in the year 2006. In response to the cease and desist notice, the attorneys of the defendant, in the first instance, asked for certain details and documents from the plaintiff vide their email dated 22.08.2013. The plaintiff duly supplied all the materials to the attorneys vide their letter dated 05.08.2013 and reiterated their stand that they had adopted the mark in the year 2006 much prior to the adoption by the defendants. In response to the cease and desist notice and the material supplied, the defendants vide letter dated 29.10.2013 disputed the claim of the plaintiff only on the merits of the matter but did not refute that the adoption of the mark by the plaintiff was in the year 2006, much prior to the adoption by the defendants. In my view, the marks, prima facie, are similar inasmuch as there is a phonetic similarity and even visual similarity in respect of the marks as the only distinction is that of "e" and "i", which when pronounced would sound similar. The defendant has not denied the factum that the plaintiff has adopted the mark prior to the adoption by the defendant. I am further of the prima facie view that if products, more so, medicinal products with deceptively similar marks are permitted to remain in the market, the consequences can be disastrous.

I am of the view that the plaintiff has been able to show a strong prima facie case for grant of an ex-parte ad interim injunction. The balance of convenience is in favour of the plaintiff and, in case, an ex parte ad

interim injunction is not granted, the plaintiff shall suffer an irreparable loss and injury.

In the above facts and circumstances, the defendant, their distributors, agents, employees are restrained from manufacturing, selling, offering for sale, advertising or in any manner dealing in the goods under the trademark "SCABILICE" or any other trademark which is identical or deceptively similar with the trademark "SCABELICE" of the plaintiff till the next date of hearing.

Compliance of order XXXIX Rule 3 be made within two weeks.

Issue notice to the defendant by ordinary process and speed post, returnable on 12th February, 2014."

5. Local Commissioner was appointed in the matter. Thereafter, pleadings were filed by the Defendant and mediation was also explored, which unfortunately failed.

6. The matter was heard on 17th and 30th August, 2018. On the last date it was submitted that the Defendant has agreed to change its trademark to 'SCABIES-LICE'. The Defendant is also willing to undertake not to use the trademark 'SCABILICE' in future. The Defendant was then directed to file an affidavit to the said effect, which has been filed. The affidavit of Sh. Nanank G. Mohan who is the Director and authorized signatory of Defendant is taken on record. The said affidavit reads as under:

"1. I state that I am the Director and Authorised Signatory of GO ISH REMEDIES LTD., the Defendant above named, having its office at the abovementioned address. I state that I am conversant with the facts and circumstances of the case and I am competent to depose this affidavit on behalf of the Defendant.

2. I state that pursuant to the ad-interim order dated 21.01.2014 passed by this Hon'ble Court, a

commission was conducted at the Defendant's premises by the Ld. Commissioner appointed by this Hon'ble Court for custody and/or seizure of the goods bearing the objectionable mark SCABILICE. I state that the Defendant company had ceased to use the mark SCABILICE immediately after execution of the said commission and upon becoming aware of the said ad-interim order.

3. I state that following are the details of the stock/ packaging material lying with the Defendant which was seized by the Ld. Commissioner under the objectionable mark 'SCABILICE'

<i>S. No.</i>	<i>Particulars</i>	<i>Expiry</i>	<i>Quantity</i>
<i>1.</i>	<i>SCABILICE empty tubes</i>	<i>N.A.</i>	<i>4500</i>
<i>2.</i>	<i>SCABILICE soap empty cartons</i>	<i>N.A.</i>	<i>2500</i>
<i>3.</i>	<i>SCABILICE ointment</i>	<i>Expired in 2015</i>	<i>1800</i>
<i>4.</i>	<i>SCABILICE soap</i>	<i>Expired in 2015</i>	<i>1811</i>

4. I state that the Defendant shall not use the objectionable mark 'SCABILICE' in future. I state that the Defendant will be using the trade mark 'SCABIES-LICE' instead of the objectionable mark 'SCABILICE' to market its pharmaceutical preparations or products."

7. Counsel for the Plaintiff has also sought instructions in the matter and has no objection with the new mark, which is now sought to be adopted by the Defendant. In this view of the matter, the dispute between the parties no longer survives.

8. In view of the affidavit filed and the Plaintiff having no objection to the proposed trademark of the Defendant, it is directed that Defendant shall

remain enjoined from using the mark '*SCABILICE*'. The Defendant shall however be permitted to use the mark '*SCABIES-LICE*'. The Plaintiff has no objection to the cartons which were impugned and being used by the Defendant. However, the Defendant undertakes that it would not in future adopt any get-up or colour scheme which is a colourable imitation of the Plaintiff's SCABELICE.

9. The Defendant has also filed a cancellation petition before the IPAB against the Plaintiff's registered trademark, which is listed on 15th October, 2018. The Defendant is willing to withdraw the same. If the Defendant does not withdraw the Cancellation petition, the Plaintiff is permitted to place on record the order and seek dismissal of the same.

10. In view of the above, the suit is decreed in terms of para (a) and (b) of the plaint. Defendant is however permitted to use the mark '*SCABIES-LICE*'.

11. Defendant has some stock of the products and the Plaintiff has no objection if the Plaintiff destroys the same under confirmation to the Plaintiff. Since the products are pharmaceutical preparations and the same may be past the date of expiry, the Defendant shall destroy the same and confirm the same to the plaintiff in writing within a period of four weeks. The remaining reliefs are not pressed by the Plaintiff.

11. The suit is decreed in the above terms.

12. Suit is disposed of. All pending applications are also disposed of.

PRATHIBA M. SINGH
JUDGE

SEPTEMBER 17, 2018

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