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IN THE HIGH COURT OF JUDICATURE AT MADRAS

(ORDINARY ORIGINAL CIVIL JURISDICTION)

TUESDAY, THE 03RD DAY OF AUGUST 2021

THE HON'BLE MR. JUSTICE R. SUBRAMANIAN

C.S. No.735 of 2011

1. Sun Pharmaceutical Industries Limited
CD Plot No, 3, Door No. 8,
Old Tower Block Street, Nandhanam Extension,
Chennai – 600 035.
Rep. by its Constituted Attorney
Mr.K. Murugesan

2. M/s. Sun pharma Laboratories Limited,*
187, Third Floor,
St. Mary's Road, Wing B,
Alwarpet, Chennai-600018
Rep by its Authorised Signatory
Mr. Dinesh Dhayalkar

*(Amended as per order dated 10.06.2014 in A.No. 3213 of 2014)

... Plaintiffs

-Versus-

1. Nirma Limited
Nirma House, Ashram Road,
Ahmedabad – 380 009,
Gujarat.

2. Health Biotech Limited
Nalagarh Road,
Baddi – 173205,
Dist.-Solan (HP)

... Defendants



C.S.No. 855 of 2015

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Civil Suit praying that this Hon'ble Court be pleased to pass a Judgement and Decree against the Defendants:

- a) A permanent injunction restraining the Defendants, their distributors, stockists, servants, agents, retailers, legal representatives, job-workers, manufacturers or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations infringing 2nd Plaintiff's registered trademark VECURON by use of deceptively similar trademark VECUNIR or any mark deceptively similar to 2nd Plaintiff's registered trademark VECURON or in any other manner whatsoever;
- b) A permanent injunction restraining the Defendants, their distributors, stockists, servants, agents, retailers, legal representatives, job-workers, manufacturers or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations under the trademark VECUNIR or any other trademark that is identical and/or deceptively similar as that of the Plaintiff's registered trademark VECURON and/or use similar



packaging as that of the plaintiff's products under the mark VECURON so as to pass off the Defendants' medicinal preparations as and for the medicinal preparations of the Plaintiffs and/or in any other manner whatsoever connected with the Plaintiffs;

- c) The Defendants be ordered to pay to the Plaintiffs a sum of Rs. 1,00,000/- as liquidated damages for committing acts of infringement against 2nd Plaintiffs' registered trademark so as to pass off its products as and for the Plaintiffs' products;
- d) The Defendants be ordered and decreed to deliver up for destruction to the Plaintiffs all the preparations, dies, blocks, labels, packaging either filled or empty, brochures, leaflets, pamphlets, hand bills, hoardings, wall posters, calenders, carry, bags, stationery items and such other sales promotional materials bearing and/or containing the impugned trademark VECUNIR;
- e) A preliminary decree be passed in favour of the Plaintiffs directing the Defendants to render accounts of profits made by it by use of the trademarks VECUNIR which is identical and/or deceptively similar and a final decree be passed in favour of the Plaintiffs for the amount of profits found to have been made by the defendants after the latter has rendered accounts, and;
- f) For costs of the entire proceedings.



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This suit having been heard on 22.07.2021 in the presence of Mr. Satish Parasaran, Senior Counsel for M/s. Brinda Mohan and Arun C. Mohan, Advocates for the plaintiffs herein and Mr.T.K. Bhaskar Advocate for the defendants herein and upon reading the plaint filed herein and the other exhibits therein referred to and upon perusing the evidence adduced therein and having stood over for consideration till this date and coming on this date before this court for orders in the presence of said advocates for the parties hereto and this court having observed that this court has got jurisdiction to entertain the suit and there is no similarity between the two and the cartons are essentially distinct and there has been no infringement, the plaintiffs are not entitled to claim any damages and the plaintiffs are not entitled to the relief of mandatory injunction or destructions of the cartons and other promotional materials and the reliefs of accounting would also fail and pw1 has not signed the pleadings as an authorized agent of the plaintiffs, he has only disposed as pw1, as a person.

conversant with the facts of the case, a duly executed power of attorney document has been produced authorizing him to tender evidence in legal proceedings, this court therefore does not think that the objection of the learned counsel regarding competence of the pw1 could be sustained,



That the suit in C.S.No. 735 of 2011, be and is hereby dismissed.

2) That there shall be no order as to costs of this suit.

WITNESS, THE HON'BLE MR.JUSTICE SANJIB BANERJEE,
CHIEF JUSTICE, HIGH COURT OF MADRAS AFORESAID, THIS THE
03RD DAY OF AUGUST 2021.

Sd/-
ASSISTANT REGISTRAR (Comm. Cases.)

//Certified to be true copy//
Dated at Madras this the day of 2021.

COURT OFFICER(O.S.)
From 25th Day of September 2008 the Registry is issuing certified copies
of the Orders/Judgments/Decrees in this format.



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19.08.2021

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C.S.No. 735 of 2011

DECREE
DATED 03/08/2021

THE HON'BLE MR.JUSTICE
R.SUBRAMANIAN

FOR APPROVAL: 28/09/2021

APPROVED ON: 28/09/2021



IN THE HIGH COURT OF JUDICATURE AT MADRAS

Judgment Reserved on 22.07.2021	Judgment Delivered on 03.08.2021
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THE HONOURABLE MR.JUSTICE R.SUBRAMANIAN

C.S.No.735 of 2011

1.Sun Pharmaceutical Industries Limited
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... Plaintiffs

Vs.

1.Nirma Limited
Nirma House, Ashram Road,
Ahmedabad – 380 009,
Gujarat.

2.Health Biotech Limited
Nalagarh Road,
Baddi – 173205,
Dist.-Solan (HP)

... Defendants



PRAYER : Plaintiff filed under Order IV Rule 1 of Original Side Rules, read with Order VII, Rule 1 of Code of Civil Procedure read with Sections 27, 28, 29, 134 and 135 of the trade Marks Act, 1999 praying to grant a judgment and decree on the following terms:-

(a) A permanent injunction restraining the defendants, their distributors, stockists, servants, agents, retailers, legal representatives, job-workers, manufacturers or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations infringing 2nd plaintiff's registered trademark VECURON by use of deceptively similar trademark VECUNIR or any mark deceptively similar to 2nd plaintiff's registered trademark VECURON or in any other manner whatsoever;

(b) A permanent injunction restraining the defendants, their distributors, stockists, servants, agents, retailers, legal representatives, job-workers, manufacturers or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations under the trademark VECUNIR or any other trademark that is identical and/or deceptively similar as that of the plaintiffs' registered trademark VECURON and/ or use similar packaging as that of the plaintiffs' products under the mark VECURON so as to pass off the defendants' medicinal preparations as and for the medicinal preparations of the plaintiffs and/ or in any other manner



whatsoever connected with the plaintiffs;

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- (c) The defendants be ordered to pay to the plaintiffs a sum of Rs.1,00,000/- as liquidated damages for committing acts of infringement against 2nd plaintiffs' registered trademark so as to pass off its products as and for the plaintiffs' products;
- (d) The defendants be ordered and decreed to deliver up for destruction to the plaintiffs all the preparations, dies, blocks, labels, packaging either filled or empty, brochures, leaflets, pamphlets, hand bills, hoardings, wall posters, calendars, carry bags, stationery items and such other sales promotional materials bearing and / or containing the impugned trademark VECUNIR;
- (e) A preliminary decree be passed in favour of the plaintiffs directing the defendants to render accounts of profits made by it by use of the trademarks VECUNIR which is identical and/ or deceptively similar and a final decree be passed in favour of the plaintiffs for the amount of profits found to have been made by the defendants after the latter has rendered accounts and
- (f) For costs of the entire proceedings.

For Plaintiffs : Mr.Satish Parasarn, Senior Counsel
M/s.Brinda Mohan and Arun C.Mohan

For Defendants : Mr.T.K.Bhaskar

**J U D G M E N T**

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The plaintiffs who are the registered Proprietors of the Trademark 'VECURON' have come up with this suit to restrain the 1st defendant from manufacturing, selling, offering for sale, stocking, advertising and using the deceptively similar trademark 'VECUNIR' in respect of a chemical compound which is used in treatment of muscle spasm, pain and hyper-reflexia on the ground that it is deceptively similar to the plaintiffs' registered trademark 'VECURON'. Permanent injunction restraining the defendants their distributors, stockists from selling or offering for sale the pharmaceutical preparation with the trademark 'VECUNIR' or any other trademark which is identical and/ or deceptively similar to the product of the plaintiffs viz., 'VECURON' and liquidated damages of Rs.1,00,000/- are also sought for. A preliminary decree for accounting and a decree for mandatory injunction to deliver up for destruction the preparations, dies, blocks, labels etc., have also been sought for.

2. The plaintiff would claim that it is a Pharmaceutical Company engaged in production of various pharmaceutical preparations having its Corporate Office at Andheri, Mumbai. It is also claimed that the plaintiff is an international pharma company with presence in over 30 markets. The plaintiff is an established and well known pharmaceutical company in India



since the year 1983 and the equity market of the plaintiff is worth more than 550 Crores. It is also claimed that the plaintiff enjoys a very high reputation in the field of pharmacy and it is one of the leading manufacturers of pharmaceutical preparations. The products of the plaintiff are most sought after by medical practitioners and the consuming public alike. The plaintiff company specialized in therapy areas like psychiatry, neurology and cardiology and it is among the top 3 Companies in a total of 7 therapy areas.

3. In the course of its business, during the year 1997, the plaintiff adopted and started using the trademark 'VECURON' in respect of a muscle relaxant injection to alleviate symptoms such as muscle spasms, pain and hyper-reflexia.

4. According to the plaintiff, the said mark 'VECURON' is unique, inventive and distinctive of pharmaceutical preparations manufactured and marketed by the plaintiff. It is the further claim of the plaintiff that the mark 'VECURON', has been openly, extensively and continuously used in medical and pharmaceutical products for injections, by the plaintiff, since the year 1997. The plaintiff has also obtained a registration of the said mark on 16.02.2009. The registration is in respect of medical and pharmaceutical preparations and substances included in Class 5.



5. Contending that the defendant had applied for registration of the trademark 'VECUNIR' in respect of the same chemical composition under A.No.1975932, dated 07.06.2010, the plaintiff would seek the injunctive reliefs on the ground that the adaptation of the mark 'VECUNIR' by the defendant who is a second comer is with a dishonest intention of passing off its product as if it is that of the plaintiff.

6. It is the further claim of the plaintiff that the defendant being a second comer manufacturing pharmaceutical products with the same medical composition should have refrained from naming its product with a close resemblance to that of the plaintiff, thereby, attempting to practice deception and create confusion among the consumers. It is also claimed that the defendant's application for registration was opposed by the plaintiff upon its publication in the trademark journal on 06.06.2011. The opposition is said to be still pending.

7. It is alleged that the general trade practice of the pharmaceutical industry to name the medicine on the basis of the chemical compound, ailments or the organ has been misused by the defendant to choose a name which is identical and phonetically similar to that of the plaintiffs' mark. The user of the said trademark 'VECUNIR' by the



defendant, according to the plaintiff, amounts to infringement of the plaintiff's trademark 'VECURON'

8. The suit was originally instituted by the first plaintiff alone. Subsequently, in the year 2013, the 1st plaintiff had entered into a Scheme of Arrangement in the nature of spin off and transferred all domestic formulation undertaking along with intellectual properties thereof with the 2nd plaintiff and the same was duly approved and sanctioned by the Hon'ble High Court of Gujarat and the Hon'ble High Court of Judicature at Bombay. Under Clause 11 of the said Scheme of Arrangement, the 2nd plaintiff has become the owner of the rights, title and interest of the 1st plaintiff in various trademarks including the mark 'VECURON'. Therefore, the 2nd plaintiff was impleaded in the suit.

9. The plaintiffs would also justify the filing of the suit before this Court on the ground that the products of the defendant are marketed within the jurisdiction of this Court and therefore, this Court will have jurisdiction to entertain the suit.

10. The suit is resisted by the 1st defendant contending that this

Court has no jurisdiction to entertain the suit as neither the plaintiffs nor the



defendant have any branch office or a working unit within the jurisdiction of this Court. It is the further claim of the 1st defendant that the mark 'VECUNIR' is no way similar to the mark 'VECURON' of the plaintiffs. The defendant would also justify the adaptation of the mark 'VECUNIR' on the ground that the first portion of the mark 'VECU' is derived from the name of the ingredient viz., Vecuronium Bromide. The 1st defendant would also plead that 'NIR' which figure as later part of the name is a part of the name of the daughter of the founder of the defendant's Company viz., Nirupama.

11. It is the further contention of the 1st defendant that the 1st defendant Company had adopted the trademark 'NIRMA' and several variants of the same, for its various products. It is also claimed that the defendant has been using the name 'NIRMA' continuously since the year 1969. The defendant would further plead that the plaintiffs who have adopted the name which is part of the ingredient viz., Vecuronium Bromide cannot claim exclusivity over the said name.

12. It is the further contention of the 1st defendant that the product as such viz., injection is a schedule 'L' drug which is sold only to hospitals that too under prescription of the registered medical practitioners. The same



is used by Anesthetists at the time of surgery. Therefore, according to the 1st defendant, the user being a Elite class, the chances of confusion is almost nil. It is also the contention of the defendant that there is neither visual similarity nor phonetical similarity between the two marks 'VECURON' and 'VECUNIR'. On the above contentions the 1st defendant sought for dismissal of the suit.

13. Upon amendment of the plaint an additional written statement was also filed by the defendant. In the additional written statement, the defendant claims that the plaintiffs have no place of business within the jurisdiction of this court and therefore this court has no jurisdiction to entertain the suit. It was also contended that the plaintiffs who have adopted a portion of the name of the basic drug viz., Vecuronium Bromine cannot seek an injunction against the defendant.

14. On the above pleadings, the following issues were framed for trial:

- 1. Whether the defendants are liable for acts of infringement of plaintiff's registered trademark VECURON by use of deceptively similar trademark VECUNIR?*



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2. *Whether the defendants are liable for passing off medicinal preparations as and for the plaintiffs medicinal preparations under the trademark VECURON by use of deceptively similar trademark VECUNIR?*
3. *Whether this Court has territorial jurisdiction to entertain the present suit?*
4. *Whether the plaintiffs Trademark VECURON is a mere adaption of the name of the basic drug 'Vecuronium'?*
5. *Whether the plaintiffs trademark is unique, inventive and distinctive?*
6. *Whether the prefix 'VECU' forming part of the plaintiffs trademark is common to trade generic word?*
7. *Whether the plaintiff is entitled to the sum of Rs.1,00,000/- as liquidated damages for acts of infringement and passing off committed by the defendants?*
8. *Whether the plaintiff is entitled to an order of delivery up of all the preparations, dies, blocks,*

labels, packaging either filled or empty, brochures, leaflets, pamphlets, hand bills, hoardings, wall posters, calendars, carry bags, stationery items and such other sales promotional materials bearing and/ or containing the impugned trademark VECUNIR for destruction?

9. Whether the plaintiff is entitled for a preliminary decree for rendition of accounts of profits made by defendants use of the deceptively similar trademark VECUNIR?

10. To what other relief the plaintiff is entitled to?

15. At trial, one Mr.Rajamallaiah Cirumallah was examined as PW1. He has also produced the powers of attorney executed by the plaintiffs 1 and 2 authorizing him to depose in the suit as Ex.P1 and Ex.P2. On the side of the defendant one Miss.Shital K.Sheth was examined as DW1. Exs.P1 to P13 were marked on the side of the plaintiffs and Exs.D1 to D34 were marked on the side of the 1st defendant.

16. I have heard Mr.Satish Parasaran, learned Senior Counsel appearing for the plaintiffs and Mr.T.K.Bhaskar, learned counsel appearing for the 1st defendant. The 2nd defendant who is added as a distributor has



remained exparte. It should also be pointed out that there is no specific prayer against the 2nd defendant in the suit.

Issue No.3 :-

17. This issue is taken up first since it involves the territorial jurisdiction of this court.

18. Mr.T.K.Baskaran, learned counsel appearing for the 1st defendant would very seriously dispute the claim of the plaintiffs that this Court has got jurisdiction to entertain the suit. According to the learned counsel, the jurisdiction is sought to be invested in this Court by the plaintiffs on the basis of certain invoices which show that the product of the defendant is marketed within the jurisdiction of this Court. Drawing my attention to the invoice that was marked as Ex.P11, the learned counsel would contend that such a sporadic sale, cannot confer jurisdiction on this Court.

19. Contending contra Mr.Satish Parasarn, learned Senior counsel appearing for the plaintiffs would submit that the jurisdiction of the Court to decide an infringement action does not only depend on the sale of the products with the deceptively similar trademark within the jurisdiction of



the Court. He would further submit that the sale of the products coupled with the dominant position of the defendant in the market would confer jurisdiction on the Court to entertain and decide an infringement action.

20. The learned Senior Counsel would contend that the plaintiffs being registered proprietors having a place of business within the jurisdiction of this Court are entitled to file the suit in this Court. He would also draw my attention to the various invoices produced by the plaintiffs as Ex.P5 (series), wherein it is shown that the plaintiffs have got branch offices all over India and the product 'VECURON' is being sold all over India. Therefore, according to the learned Senior Counsel, this Court will have jurisdiction to try the suit.

21. A perusal of the documents filed in the suit would show that atleast two ingredients to vest the jurisdiction with this Court has been satisfied. One is the sale of the product of the defendant which is claimed to be a product of deception practiced by the defendant within the jurisdiction of this Court and two, the plaintiffs which are registered proprietors having an office within the jurisdiction of this Court. I therefore find that this Court has got jurisdiction to entertain the suit. Issue No.3 is answered accordingly in favour of the plaintiffs.

**Issues Nos.1, 2, 4, 5 and 6 :-**

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22. All these issues are taken up together as they involve determination of common questions.

23. It is the case of the plaintiffs that they have adopted the trademark 'VECURON' based on the ingredient of the chemical compound. The learned counsel for the plaintiffs would submit that it is common practice of the pharma industries to adopt the name of the ingredient/chemical compound as the name of its product. Therefore, according to the learned Senior Counsel, the adaptation of the mark 'VECURON' by the plaintiffs is unique and distinctive.

24. Countering the said submission of the learned Senior Counsel for the plaintiffs, Mr.T.K.Bhaskar, learned counsel appearing for the 1st defendant would vehemently contend that the plaintiffs cannot claim that the mark 'VECURON' adopted by them is unique or inventive or distinctive, on the admitted position that the basic chemical compound used in preparation of the formulation both by the plaintiffs and the defendant is 'Vecuronium Bromide'. Pointing out the fact that the plaintiffs have chosen to adopt the first seven letters of the word Vecuronium and arrived at the trade name 'VECURON', Mr.T.K.Bhaskar, learned counsel would contend



that the name adopted by the plaintiffs is neither inventive nor unique.

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25. He would also invite my attention to the judgment of the Bombay High Court in *Macleods Pharmaceuticals Limited Vs. Intas Pharmaceuticals Ltd* reported in **2013 (55) PTC 380 (Bom)**, wherein, it was held that a person who adopts a part of the name of the compound or the ingredient without any other distinguishing factor cannot claim exclusivity or distinctiveness in order to prevent others from using some part of the same name. It is also the contention of the counsel that the plaintiffs having adopted a portion of the name of the ingredient in full cannot seek an injunctive relief, even though it is a registered proprietor.

26. He would also draw my attention to the judgment of the Delhi High Court in *M/s. Penacea Biotec Ltd. Vs. Recon Ltd.* reported in **1996 (16) PTC 561 (Del)**, wherein, it was held that a trademark of a medicinal preparation which is wholly derived from the name of the principle drug used in its manufacture does not enjoy the same protection that is available to an invented word.

27. If the claim of the plaintiffs is tested in the back drop of the

above position of law, which takes into account the essential practice in the



industry, it is clear that the plaintiffs which had adopted a part of the name of the principle drug used in the manufacture of the plaintiffs' product cannot claim that it is an invention or that it is unique and distinctive. Therefore, Issue No.5 is answered against the plaintiffs.

28. The claim of the plaintiffs is that the defendant by adopting a deceptively similar mark for the same product is guilty of infringement of its registered trademark. The right of a person or Company to make or sell the same product is well recognized. All that the Law of Trademarks offers is a protection to the first comer or the first manufacturer by imposing an obligation on the second comer to name and dress its product in such a manner to avoid likely confusion. This principle of law has been recognized by the Delhi High Court in **N.Ranga Rao and sons Vs. Anil Garg and others** reported in **2006 (32) PTC 15**. The Hon'ble Mr. Justice Sanjay Kishan Kaul, as he then was, had referred to the judgment of the Court of Appeals, Second Circuit in **Harold F. Ritchie, Inc. Vs. Chesebrough – Pond's, Inc.**, reported in **126 USPQ 310** which observed as under:-

“Second comer has duty to so name and dress his product as to avoid all likelihood of consumers confusing it with product of first comer; although second comer may endeavour to capture



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first comer's market, he must do this by giving his product a name and dress descriptive and fanciful in its own right and selling it on its own merit, not by confusing public into mistakenly purchasing his product for competitor's; second comer must create reputation of his own and not trade on goodwill of another product already established at considerable cost and risk; important in determining whether second comer's entrance into market creates possible confusion is any evidence of conscious imitation of first comer's product."

29. No doubt the law imposes an obligation on the subsequent entrant to the market to avoid a possible confusion to the extent possible. Mr.Satish Parasaran, learned Senior Counsel appearing for the plaintiffs would attempt to project an imposed similarity between the two marks in question viz., 'VECURON' and 'VECUNIR'. He would submit that while the first four letters 'VECU' are identical. Out of the following three letters two letters have been used by jumbling up them and this would definitely create a confusion in the minds of the customers.

30. It is a well settled position of Intellectual Property Law that a mark should be considered as a whole and any attempt to dissect it and



conclude that the mark of the defendant is deceptively similar to that of the plaintiffs should be avoided.

31. Even in *N.Ranga Rao and sons Vs. Anil Garg and others* case, referred to *supra*, the Delhi High Court had pointed out that for establishing confusion and deception, overall impact has to be seen in entirety and not parts have to be picked up in isolation. The attempt of the learned Senior Counsel for the plaintiffs in breaking up the mark and imposing a deceptive similarity into them is just the breaking up which is prohibited in Trademarks Law. Reference can be made to several judgments including the judgment of the Delhi High Court in *Kellogg Company Vs. Pravin Kumar Bhadabhai* reported in *1996 PTC (16) 187*.

32. It is in evidence that the 1st defendant has been using the coinage 'NIR' for several of its products. While Exs.D8 to D12 relate to the trademark 'NIRMA' and the trademark 'NIRLIFE', Ex.D18 is a bunch of registration certificates of the products of the defendant using the suffix 'NIR'. Ex.D19 is another series of trademark registration certificates of the products of the defendant using the prefix 'NIR'. No doubt, an objection is taken that the defendant has not produced the legal user certificates for all the products registered in the series of Ex.D18 and Ex.D19. I do not think



that objection could be sustained in view of the fact that the production of those certificates is not for establishing a right over that trademark, but, it is only to establish the usage of the defendant. Even otherwise the defendant has produced the legal user certificates in respect of the trademark 'NIR 10D' as Ex.D29. The legal user certificate for the trademarks 'NIRMA' and 'NIRLIFE' have been produced as Exs.D30 and D31. The legal user certificate for the trademark 'VECUNIR' has been produced as Ex.D33. Yet another aspect which would arise in the case on hand is the nature of the product. It is the admitted case of the parties that the product viz., the injection vials are schedule 'L' drugs which are sold only to hospitals based on the prescription of the registered medical practitioners. Therefore, the consumers of this particular product belong to the Elite category who have discerning capabilities.

33. The learned Senior Counsel for the plaintiffs Mr.Satish Parasarn would rely upon the judgment of the Hon'ble Supreme Court in ***Cadila Health Care Ltd. Vs. Cadila Pharmaceutical Ltd.***, reported in ***AIR 2001 SC 1952*** to contend that even infringement action for pharmaceutical products will have to be decided on the basis of the fundamental principles of Trademark Law that the consumer is presumed to be a man of average intelligence with imperfect recollection.



34. The learned Senior Counsel would draw my attention to the observations of the Hon'ble Supreme Court that Physicians are also not immune from confusion or mistake, though they may be knowledgeable in their field, the same amount of knowledge cannot be imputed to them in respect of the mark and they cannot be assumed to be immune from mistaking from one mark for the other. After saying so, the Hon'ble Supreme Court in paragraph 42 of the judgment had broadly stated the basis of the passing off action and the factors to be considered in deciding the question of deceptive similarity, they are as follows:-

a) The nature of the marks i.e., whether the marks are word marks or label marks or composite marks, i.e., both words and label works.

b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

c) The nature of the goods in respect of which they are used as trademarks.

d) The similarity in the nature, character and performance of the goods of the rival traders.

e) The class of purchasers who are likely to but the goods bearing the marks they require, on



their education and intelligence and a degree of care they are likely to exercise in purchasing and/ or using the goods. (emphasis supplied)

f) The mode of purchasing the goods or placing orders for the goods and (emphasis supplied)

g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

35. It should be pointed out that even while laying down the broad parameters, the Hon'ble Supreme Court has pointed out that the class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/ or using the goods as well as the mode of purchasing the goods or placing orders for the goods are relevant factors to be borne in mind while deciding on the question of deceptive similarity. In ***Khoday Distilleries Limited Vs. Scotch Whisky Association and others*** reported in **2008 (10) SCC 723**, the Hon'ble Supreme Court after referring to the parameters laid down in ***Cadila Health Care Ltd. Vs. Cadila Pharmaceutical Ltd.***, referred to *supra* had held that



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Where the class of buyers, as noticed hereinbefore, is quite educated and rich, the test to be applied is different from the one where the product would be purchased by the villagers, illiterate and poor.

36. The Hon'ble Supreme Court had also considered the judgment of the Bombay High Court in **Carew Phipson Ltd. Vs. Deejay Distilleries (P) Ltd.**, reported in **AIR 1994 Bom 231** and had in fact approved the following observations of the Hon'ble Mr. Justice A.P. Shah, as he then was:

On comparison of the two marks bearing the aforesaid principles in mind, it is difficult to appreciate as to how there is even a remote possibility of any customer being misled. In my opinion, when a customer goes to a shop to buy the plaintiffs' product, he will not ask for 'Duet' or 'Gin Nlime' or 'Gin N Orange' but he will ask for a 'Blue Riband Gin N Lime' or 'Blue Riband Tango Gin N Orange'. Further having regard to the fact that the customer who is likely to buy the products of the plaintiffs and the defendants will be normally educated and discerning type, it is impossible to hold that there is any likelihood of confusion. It is pertinent to note that the plaintiffs have failed to cite even a single instance showing that there was confusion in the minds of the customers.



37. The position of law that emerges is that while deciding an infringement action, the courts should not be oblivious to the nature of the product and the status of the consumers. A feeble attempt has been made by PW1 to contend that even though the product is a schedule 'L' drug to be sold to hospitals, only on prescription of the registered medical practitioner, it is being sold across the counters in pharmacies. That statement is not supported by any other material evidence. Such a sale is a illegal sale and the same cannot be taken note of by this Court.

38. Adverting to the fundamental question as to whether the two marks are similar, I find that there is no deceptive similarity between the two marks. More over, as pointed out by the Bombay High Court in *Macleods Pharmaceuticals Limited Vs. Intas Pharmaceuticals Ltd*, referred to *supra*, in cases where marks are evolved from generic drugs and/or parts of body organs, the emphasis is always on the other parts/ feature of the marks.

39. In various judgments, the Hon'ble Supreme Court as well as this Court have held that where a part of the mark is either descriptive or common to trade greater regard is to be had to the un-common element in the two marks. As already pointed out, the plaintiffs have borrowed a



portion of the name of the generic drug Vecuronium Bromide. Therefore, there is nothing un common in the trademark of the plaintiffs which could be compared with that of the defendant.

40. In *M/s.Penacea Biotec Ltd. Vs. Recon Ltd.* referred to *supra*, considering the question of such derivative names, the Delhi High Court has observed as follows:-

Therefore, it clearly follows that in a case where the trade mark of the medicinal preparation is wholly derived from the name of the principal drug, used in its manufacture, the protection, which is available in the case of the invented word, would not be forthcoming.

41. If the above principles of law are applied to the facts of the case on hand, the irresistible conclusion would be that the so called deception or possibility of confusion does not exist at all. I also conclude that the adaptation of the plaintiffs' trademark 'VECURON' is only a partial adaptation of the name of the basic drug Vecuronium and it lacks exclusivity or distinctiveness.

42. In view of the above conclusion and the recognized practice of



by a manufacturer in his product, I do not think that the 1st defendant is guilty of infringement of the plaintiffs' registered trademark. As already pointed out, considering the nature of the drug and the possible consumers there is no possibility of the defendant passing off its product as that of the plaintiffs. The cartons of the injection vials have also been produced as Exs.P12 and P13. A perusal of the same would also show that there is no similarity between the two and the cartons are essentially distinct. In the light of the above conclusion, issue Nos.1, 2, 4, 5 and 6 are answered against the plaintiffs.

Issue No.7 :-

43. This relates to the claim of liquidated damages of Rs.1,00,000/- for the acts of infringement. In view of the conclusion reached that there has been no infringement, the plaintiffs are not entitled to claim any damages.

Issue No.8 :-

44. As a consequence of the findings on issue Nos.1, 2, 4, 5 and 6, the plaintiffs are not entitled to the relief of mandatory injunction or destructions of the cartons and other promotional materials.

Issue No.9 :-

45. This issue relates to accounting. As a result of the conclusion



reached for issue Nos.1, 2, 4, 5 and 6, the relief of accounting would also fail.

46. Mr.T.K.Baskar, learned counsel appearing for the 1st defendant would, in the course of the arguments, contend that PW1 did not have a valid authorization for deposing before this Court. PW1 has deposed that he is an employee of the plaintiffs and he is also duly authorized by the specific powers of attorney executed by the Director of the plaintiffs 1 and 2. Those powers of attorney have been produced as Exs.P1 and P2. Mr.T.K.Baskar, learned counsel would submit that the Board Resolution authorizing the executant of the powers of attorney has not been produced.

47. PW1 has not signed the pleadings as an authorized agent of the plaintiffs. He has only deposed as PW1, as a person conversant with the facts of the case. A duly executed power of attorney document has been produced authorizing him to tender evidence in legal proceedings. I therefore do not think that the objection of the learned counsel regarding competence of the PW1 could be sustained.

48. In view of the above, the suit fails and it is accordingly **dismissed**. However, in the circumstances there will be no order as to costs.

Sd/- R.S.M.J.
03/08/2020



List of the Witnesses examined on the side of the Plaintiffs:

PW1 – Rajamallaiah Cirumallah

List of Exhibits marked on the side of the Plaintiffs:

<i>Sl.No</i>	<i>Exhibits</i>	<i>Description of documents</i>	<i>Date</i>
1	Ex.P1	Xerox copy of Power of attorney executed by the 1 st plaintiff in favour of PW1	11.11.2014
2	Ex.P2	Xerox copy of Power of attorney executed by the 2 nd plaintiff in favour of PW1	11.11.2014
3	Ex.P3	Registration Certificate for trademark VECURON under No.1785412 in Class 5	16.02.2009
4	Ex.P4	Product permission granted by Food and Drug Control Administration for manufacture of injections under mark VECURON	--
5	Ex.P5 (series)	Invoices proving sale of VECURON injection all over India	--
6	Ex.P6	Chartered accountant Certificate of Sales figures in respect of VECURON injections	10.11.2011
7	Ex.P7	Extracts from medical journals listing VECURON injection	--
8	Ex.P8	Product brochures published by 1 st plaintiff in respect of VECURON medicinal preparations	--
9	Ex.P9	Chartered accountant Certificate of Sales promotion expenditure in respect of VECURON injunction	10.11.2011
10	Ex.P10	Legal notice issued by 1 st plaintiff	18.08.2011
11	Ex.P11	Invoice raised for sale of defendants' products under the mark VECUNIR	08.10.2011
12	Ex.P12	Plaintiffs' VECURON carton	--



<i>Sl.No</i>	<i>Exhibits</i>	<i>Description of documents</i>	<i>Date</i>
13	Ex.P13	Defendants' VECUNIR carton	--

List of the Witnesses examined on the side of the Defendants:

DW1 - Shital K.Sheth

List of Exhibits marked on the side of the Defendants:

<i>Sl.No</i>	<i>Exhibits</i>	<i>Description of documents</i>	<i>Date</i>
1	Ex.D1	Notice of opposition filed by the 1 st plaintiff with the Trademark authorities	03.10.2011
2	Ex.D2	Counter filed by the 1 st defendant to the notice of opposition filed by the 1 st plaintiff	--
3	Ex.D3	Affidavit filed by the 1 st plaintiff in support of the opposition in the proceedings before the trademark Registry.	--
4	Ex.D4	Affidavit filed by the 1 st defendant in support of the counter statement in the proceedings before the trademark Registry.	--
5	Ex.D5	True copy of Board Resolution	--
6	Ex.D6	True copy of MCA Report	--
7	Ex.D7	Photo copy of order of the Hon'ble High Court, Gujarat, Scheme of Arrangement between NIRMA Industries Ltd. And NIRMA Ltd.	--
8	Ex.D8	Trademark Journal in the year 1984	--



Sl.No	Exhibits	Description of documents	Date
9	Ex.D9	Registration certificate granted in favour of NIRMA Chemical Works Ltd., under No.422863 B and subsequent renewals	--
10	Ex.D10	Registration Certificate for NIRMA and its house mark Better products, better value, better living	--
11	Ex.D11	Registration Certificate of NIRMA in all classes	--
12	Ex.D12	Registration Certificate of trademark NIRLIFE	--
13	Ex.D13	Photo copy of Promotional Material for Pharmaceutical products circulated to Distributors	--
14	Ex.D14	Photo copy of WHO GMP Certificate	--
15	Ex.D15	Photo copy of Best Supplier Award by State Pharmaceuticals Corporation of Srilanka	--
16	Ex.D16 (series)	Registration Certificate of trademark NIRMA obtained in foreign countries	--
17	Ex.D17	Photocopy of NIRMA as superbrand – Booklet for years 2004, 2006 and 2011	--
18	Ex.D18 (series)	List of Trademarks certificates (existing) with prefix NIR	--
19	Ex.D19 (series)	List of Trademarks certificates (existing) with suffix NIR	--
20	Ex.D20 (series)	Registration Certificate of trademark NIRLIFE obtained in foreign countries	--
21	Ex.D21	Foreign Court judgment – Malawi – 2005 (31) PTC 286 (Reg) accompanied with 65B certificate.	--
22	Ex.D22	Foreign Court judgment – Sindh, Pakistan – 1992 (12) PTC 273 (Sindh) accompanied with 65B certificate.	--
23	Ex.D23	Mumbai Trademark Registry Order in	--



Sl.No	Exhibits	Description of documents	Date
		opposition no.BOM-164430 against the application No.1009559B with 65B certificate	
24	Ex.D24	Order of Deputy Registrar of Trademarks Chennai in Application No.781264 along wit 65B certificate	--
25	Ex.D25	Electronic record of the trademark application filed in respect of the mark VECUNIR under No.1975932 along with 65B certificate.	--
26	Ex.D26	Electronic record of Examination Report issued by the Trademark Registry in respect of trademark NIR along with 65B certificate	--
27	Ex.D27	Electronic record of search report downloaded from the Website of the Trademark Registry in respect of the mark VECU along with 65B certificate	--
28	Ex.D28 (series)	Notarised copies of the sales invoices raised by the defendant on its distributors.	--
29	Ex.D29	Certified copy of legal use certificate of existing trademark NIR10D with prefix NIR	07.07.2016
30	Ex.D30	Certified copy of legal use certificate of trademark NIRMAX in Class 19	07.07.2016
31	Ex.D31	Certified copy of legal use certificate of trademark NIRLIFE in Class 5	07.07.2016
32	Ex.D32	Certified copy of legal use certificate of trademark NIRMA in favour of NIRMS Chemical Works Limited under Class 5	08.07.2016
33	Ex.D33	Certified copy of legal use certificate of existing trademark VENCONIR with suffix NIR	08.07.2016



<i>Sl.No</i>	<i>Exhibits</i>	<i>Description of documents</i>	<i>Date</i>
34	Ex.D34	Examination report along with the search report issued by the Registrar of Trademark in respect of the Trademark VECUNIR with 65B certificate.	--

Sd/- R.S.M.J.
03/08/2020

//Certified to be true copy//
Dated at Madras this the day of 2021.

COURT OFFICER(O.S.)

From 25th Day of September 2008 the Registry is issuing certified copies of the Orders/Judgments/Decrees in this format.