

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 05.07.2021

CORAM :

THE HON'BLE MR.SANJIB BANERJEE, CHIEF JUSTICE

AND

THE HON'BLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

O.S.A. (CAD) Nos.141 and 142 of 2021

M/s.Apex Laboratories Private Limited,
29, III Floor, SIDCO Garment Complex,
Guindy, Chennai - 600 032
rep. by its Authorised Signatory
D.Jude F.L.S.Durai Pandian ... Appellant
in both appeals

Vs.

Macleods Pharmaceuticals Limited,
304, Atlanta Arcade, Marol Church Road,
Near Leela Hotel, Andheri Kurla Road,
Andheri (East),
Mumbai - 400 059. ... Respondent
in both appeals

PRAYER: Appeals filed under Section 13 of the Commercial Courts Act, 2015 against the order dated 23.02.2021 passed in O.A.Nos.418 and 419 of 2020 in C.S.No.232 of 2020.

Prayer in O.A.No.418 of 2020:

filed under order XXXIX Rules 1 & 2 of the Civil Procedure Code read with order XIV Rule 8 O.S., Rules, praying to grant an ad-interim injunction restraining the respondent, by itself, its partners, men, servants, agents, distributors, stockiest, representatives or any one claiming through or under them from in any manner passing off and /or enabling others to pass off the respondent's products under the trademark BELATIN as and for the applicants' products by manufacturing, selling, or offering to sell, distributing, displaying, printing, stocking, using, advertising their products with a trademark BELATIN which is deceptively similar to the applicant's BILTEN trademark or in any other manner whatsoever.

Prayer in O.A.No.419 of 2020:

This Civil Suit is filed under Order XXXIX Rules 1 & 2 of the Civil Procedure Code read with order XIV Rule 8 O.S., Rules, praying to grant an ad-interim injunction restraining the respondent, by itself, its partners, men, servants, agents, distributors, stockiest, representatives or any one claiming through or under them from in any manner infringing the applicant's registered trademark BILTEN under No.4246358 in Class 5 by using a deceptively similar trademark BELATIN or any other trademark deceptively similar to the applicant's registered trademark or in any other manner whatsoever.

For Appellant : Mr.R.Sathishkumar

For Respondent : Mr.P.S.Raman
Senior Counsel
for M/s.Madhan Babu

COMMON JUDGMENT

(Delivered by the Hon'ble Chief Justice)

These appeals arise out of a common judgment and order dated February 23, 2021 passed at the final stage of an interlocutory application in a suit for infringement and passing off.

2. The plaintiff is the appellant herein. The plaintiff is the registered owner of the word-mark BILTEN used as a medicine with the product Bilastine as its principal component. The product is sold as tablets and comes in strips and is described as "Bilastine Tablets 20 mg". The defendant uses the mark BELATIN. The mark is not registered. The defendant's product also comes as a tablet in strips and is described as "Bilastine Tablets 20 mg". Both products are used as antihistamines.

3. An ex parte injunction was obtained by the plaintiff on September 18, 2020 immediately upon the suit being received. What counted with the Court at such stage was that the plaintiff's mark was registered and the plaintiff may have introduced the product in the market prior to the defendant's launch or commercial sale of the defendant's BELATIN.

4. In the impugned judgment, the trial Court noticed that there was close proximity between the dates of application for registration of the two marks, the launch of the products and the commercial release thereof. Indeed, at paragraph 19 of the impugned judgment, the following dates have been recorded:

"19. ...

The above facts throw up for further discussion the following:

(1) that the defendant had applied for registration on 21.06.2019;

(2) that the plaintiff had applied for registration on 25.07.2019;

(3) that both the plaintiff and the defendant had given in their application forms as propose to use their respective marks;

(4) The defendant launched their product on 31.10.2019;

(5) The plaintiff commenced commercial exploitation in November 2019; and

(6) The defendant commenced commercial exploitation in February 2020."

5. The plaintiff says that the only reason furnished in the impugned judgment for vacating the subsisting injunction is found at paragraph 24 thereof. The plaintiff disagrees with the test formulated in the paragraph and the distinction made between an ordinary person seeking to purchase an article of commerce and a medical practitioner prescribing a particular medicine or drug. In the relevant paragraph, the trial Court has held that a different set of parameters needs to be adopted "by not just comparing the two products as is compared in cases of products sold off a shelf or by comparing the similarities in names but by examining them through the looking glass of a registered medical practitioner." The trial Court has reasoned that the medical practitioner would be aware of the efficacies of several available drugs in the field and would choose an appropriate drug for the patient. What the trial Court seems to suggest is that a medical practitioner would know the difference between BILTEN and BELATIN while prescribing the one or the other for a particular patient. Prima facie, such a test cannot be completely brushed aside. However, it must also be remembered that several similar sounding drugs or medicines may be generic and, to such extent, they may be interchangeable and the medical practitioner may prescribe one or the other without making any distinction or even the pharmacist may provide one or the other depending on the availability. In a sense, the trial Court appears to be justified that when it is the name of a medicine or drug, particularly one which is not available over the counter and without a prescription, the verisimilitude of the names may not create the kind of confusion that may occur if

the product was an ordinary article of commerce where the imperfect recollection theory would operate with greater force.

6. The plaintiff insists that since it is evident from the documents relied upon by the parties that it was the plaintiff who was the first to hit the market with its BILTEN tablets, the injunction already obtained should not have been vacated. There is substance in the plaintiff's assertion in such regard that in a fifty-fifty situation where no injunction subsists, none may be issued if there is a genuine defence which is made out; but where an injunction subsists, something more must be demonstrated by the defendant to have it vacated than a mere arguable defence.

7. The dates indicated in the relevant order are important in such context. Both products appear to be generic as they indicate the primary composition to be Bilastine. Both products are used as antihistamines.

8. Ordinarily, the prior user of a product has a better right, where user is not necessarily the prior adopter of the mark, but the person who uses the mark with the product in the market. Again, the test is not as high as whoever is the earlier is entitled to protection against the other. The assessment is not made with a stopwatch, whereby an interim order is issued merely because one of the products was launched at 12 noon and the other at 6 pm or one was launched a week before the other was.

9. At the end of the day, the substance of the actionable wrong is the attempt to cash in on the goodwill or the reputation of a mark or the efficacy of the product associated with the original mark. If such is the basis of the law in this branch, the mere fact that a product is launched one day before or the rival product enters the market three or four months down the line, makes little difference.

10. The impugned judgment cannot be faulted since it finds the rights of the parties to be so evenly balanced so as not to be able to choose one ahead of the other for an injunction to continue, which is the veritable knell for the product injuncted. In such context, particularly to balance the equities, the middle path chosen by the impugned judgment and order appears to be justified and unexceptionable. It is generally the practice for a direction for accounts to be maintained so that in the event the plaintiff is successful in establishing exclusivity at the time of the trial, adequate compensation may be ascertained from the quantum of sales of the defendant's product.

11. For the reasons aforesaid, the judgment and order impugned dated February 23, 2021 does not call for any interference. It is hoped that the trial Court will find time to decide the suit as expeditiously as possible and not encourage any delay on the part of the defendant in the trial being conducted expeditiously.

O.S.A.Nos.141 and 142 of 2021 are disposed of without any order as to costs. C.M.P.Nos.6361 ad 6382 of 2021 are closed.

Sd/-
Assistant Registrar(CO)

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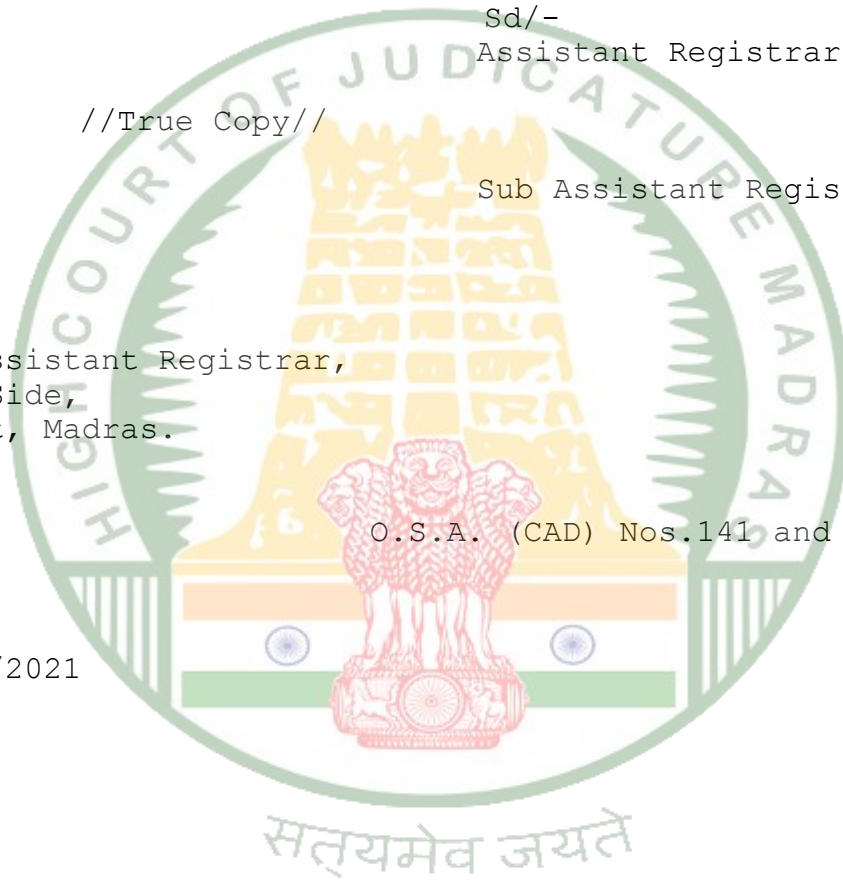
Sub Assistant Registrar

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To:

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

O.S.A. (CAD) Nos.141 and 142 of 2021

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