

IN THE HIGH COURT OF JUDICATURE AT MADRAS

(ORDINARY ORIGINAL CIVIL JURISDICTION)

THURSDAY, THE 23RD DAY OF SEPTEMBER 2021

THE HON'BLE MR. JUSTICE R. SUBRAMANIAN

C.S.No. 704 of 2014

and

O.A.No. 870 of 2014

and

A.No. 5521 of 2019

C.S.No. 704 of 2014 and
O.A.No. 870 of 2014 :-

Sun Pharma Laboratories Limited,
187, St. Mary's Road,
Alwarpet, Chennai – 600 018.
Rep.by its Authorized Sigantory
Ms. Chandra Nahata

... Plaintiff /Applicant
(in C.S.No. 704 of 2014 and
O.A.No. 870 of 2014)

-Vs-

D.D. Pharmaceuticals Private Limited,
G-1/583, Sitapura Industrial Area,
RIICO, Tank Road,
Jaipur – 302022.
Rajasthan.

... Defendant/Respondent
(in C.S.No. 704 of 2014 and
O.A.No. 870 of 2014)

C.S.No. 704 of 2014 :-

Civil suit praying that this Hon'ble Court be pleased to grant a
judgment and decree on the following terms :-

(a) A permanent injunction restraining the defendant, their manufacturers, distributors, stockists, servants, agents, wholesalers, retailers, legal representatives 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 plaintiff's registered trademark QUTIPIN by use of deceptively similar trademark QUPIN or any mark similar to plaintiff's registered trademark QUTIPIN;

(b) A permanent injunction restraining the defendant, their manufacturers, distributors, stockists, servants, agents, wholesalers, retailers, legal representatives 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 QUPIN or any other trademark that is identical and/or deceptively similar as that of the plaintiff's registered trademark QUTIPIN and/or use similar packaging as that of the plaintiff's products under the mark QUTIPIN 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 connected with the plaintiff;

(c) the defendant be ordered to pay to the plaintiff a sum of Rs.1,00,000/- as liquidated damages for committing acts of infringement against plaintiff's registered trademark so as to pass off its products as and for the plaintiff's products;

(d) 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, hand bills, hoardings, wall posters, calendars, carry bags, stationery items and such other sales promotional materials bearing and/or containing the impugned trademark QUPIN;

(e) 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 QUPIN which is identical and/or deceptively similar and a final decree be passed in favour of the plaintiff for the amount of profits found to have been made by the defendant after the latter have rendered accounts;

(f) for costs of the entire proceedings.

O.A.No. 870 of 2014 :-

Original Application praying that this Hon'ble Court be pleased to grant a temporary, interim, ad-interim injunction restraining the Respondent, their manufacturers, distributor, stockists, servants, agents, wholesalers, retailers, legal representatives 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 QUPIN or any other trademark that is identical and/or deceptively similar as that of the Applicant's registered trademark QUTIPIN and/or use similar packaging as that of the applicant's products under the mark QUTIPIN so as to pass off the Respondent's medicinal preparations as and for the medicinal preparations of the Applicant and/or in any other manner whatsoever connected with the Applicant, pending disposal of suit.

A.No. 5521 of 2019 :-

Sun Pharma Laboratories Limited,
187, St. Mary's Road,
Alwarpet, Chennai – 600 018.
Rep.by its Authorized Sigantory
Ms. S. Radhakumar

... Applicant / Applicant / Plaintiff

-Vs-

D.D. Pharmaceuticals Private Limited,
G-1/583, Sitapura Industrial Area,
RIICO Tank Road,
Jaipur – 302022.
Rajasthan.

... Respondent / Respondent / Defendant

This Civil Suit and these applications along with C.S.No.687 of 2014 and C.S.No. 703 of 2014 having been heard on 18.08.2021 in the presence of Mr. Arun C.Mohan, Advocate or the plaintiff in C.S.No. 704 of 2014 and for the applicant in O.A.No. 870 of 2014 and A.No. 5521 of 2019 and Mr. R. Sathish Kumar, Advocate for the defendant in C.S.No. 704 of 2014 and for the respondent in O.A.No. 870 of 2014 and A.No. 5521 of 2019 and upon reading the plaint filed herein in C.S.No. 704 of 2014 and the Judges Summons and affidavit of Ms.Radha Kumar filed in A.No. 5521 of 2019 and the common affidavit of Ms.Chandra Nahata filed in O.A.No. 870 of 2014 and the order dated 20.11.2018 made in O.A.No. 870 of 2014 in C.S.No. 704 of 2014, 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 day before this Court for orders in the presence of the said advocates for the parties hereto, and this Court having observed that there was a reduction in sale of the plaintiff's products during the interregnum because of the confusion caused by the sale of the defendant's products, which would enable the Court to grant

liquidated damages and the claim of the plaintiff that its turn over is suffered because of the introduction of the defendant's products in the market and the plaintiff has not placed any evidence before this Court to show that the turnover of the plaintiff had dwindled because of the introduction of the defendants products and in the absence of such evidence, this Court does not think that the plaintiff would be entitled to the relief of accounting, **it is ordered and decreed as follows:-**

That D.D. Pharmaceuticals Private Limited, the defendant herein in C.S.No. 704 of 2014, their manufacturers, distributors, stockist, servants, agents, wholesalers, retailers, legal representatives or any other person claiming under it be and are hereby restrained by an order of permanent and mandatory injunction from (a) in any manner manufacturing, selling, offering for sale, stocking, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations infringing plaintiff's registered trademark QUTIPIN by use of deceptively similar trademark QUPIN or any mark similar to plaintiff's registered trademark QUTIPIN (b) in any manner manufacturing, selling, offering for sale, stocking, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations under the trademark QUPIN or any other trademark that is identical and/or deceptively similar as that of the plaintiff's registered trademark QUTIPIN and/or use similar packaging as that of the plaintiff's products under the

mark QUTIPIN 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 connected with the plaintiff.

2) That the defendant herein, be and is hereby directed to deliver up for destruction to the Plaintiff 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 QUPIN.

3) That the reliefs (c) and (e) prayed in the plaint shall stand dismissed.

4) That the parties hereto be and are hereby directed to bear their own costs.

5) That the O.A.No. 870 of 2014 and A.No. 5521 of 2019 do stand closed.

WITNESS THE HON'BLE MR. JUSTICE SANJIB BANERJEE,
CHIEF JUSTICE, HIGH COURT AT MADRAS AFORESAID, THIS THE
23RD DAY OF SEPTEMBER 2021.

Sd/-

ASSISTANT REGISTRAR (Comm.Cases)

//Certified to be true copy//

Dated at Madras this the day of 2022.

COURT OFFICER(O.S.)

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

ED
07.01.2022

C.S.No. 704 of 2014
and
O.A.No. 870 of 2014
and
A.No. 5521 of 2019

DECREE:

DATED : 23/09/2021

THE HON'BLE MR. JUSTICE
R. SUBRAMANIAN

FOR APPROVAL: 07/01/2022

APPROVED ON : 11/01/2022

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on 18.08.2021	Delivered on 23.09.2021
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CORAM**THE HONOURABLE MR.JUSTICE R.SUBRAMANIAN**

C.S.Nos.687, 703 and 704 of 2014,
OA Nos.868 & 870 of 2014
and A.Nos.5519, 5520 & 5521 of 2019

in CS No.687 of 2014

Sun Pharma Laboratories Limited,
 187, St. Mary's Road,
 Alwarpet, Chennai 600 018
 Rep by its Authorized Signatory
 Ms.Chandra Nahata

... Plaintiff

Vs

1. D.D.Pharmaceuticals Private Limited,
 G-1/583, Sitapura Industrial Area,
 RIICO, Tank Road, Jaipur 302 022,
 Rajasthan.

2, Lifecare Formulations Private Limited,
 Plot No.2 & 3, 91/5, Link Road,
 Sonia Gandhi Nagar Extension,
 Near Mettupalayam Industrial Estate,
 Mettupalayam, Puducherry 605 009.

... Defendants

in CS No.703 and 704 of 2014

Sun Pharma Laboratories Limited,
 187, St. Mary's Road,
 Alwarpet, Chennai 600 018
 Rep by its Authorized Signatory
 Ms.Chandra Nahata

... Plaintiff

Vs

D.D.Pharmaceuticals Private Limited,
G-1/583, Sitapura Industrial Area,
RIICO, Tank Road, Jaipur 302 022,
Rajasthan.

... Defendant

Prayer : Plaints filed under Order IV Rule 1 of the Original Side Rules and Order VII Rule 1 of the Code of Civil Procedure read with Sections 27, 28, 29, 134 and 135 of the Trade Marks Act, 1999, praying for the following judgment and decree:-

in CS 687 of 2014

- (a) A permanent injunction restraining the defendants, their manufacturers, distributors, stockists, servants, agents, wholesalers, retailers, legal representatives 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 plaintiff's registered trademark BUPRON by use of almost identical trademark BUPRO or any mark identical or similar to Plaintiff's registered trademark BUPRON or in any other manner whatsoever;
- (b) A permanent injunction restraining the defendants, their manufacturers, distributors, stockists, servants, agents, wholesalers, retailers, legal representatives 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 BUPRO or any other trademark that is identical and/or deceptively similar as that of

- the plaintiff's registered trademark BUPRON and/or use similar packaging as that of the plaintiff's products under the mark BUPRON so as to pass off the defendants' medicinal preparations as and for the medicinal preparations of the Plaintiff and/or in any other manner whatsoever connected with the plaintiff;
- (c) the defendants be ordered to pay to the Plaintiff a sum of Rs.1,00,000/- as liquidated damages for committing acts as infringement against plaintiff's registered trademark so as to pass off its products as and for the plaintiff's products;
- (d) the defendants 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, hand bills, hoardings, wall posters, calendars, carry bags, stationery items and such other sales promotional materials bearing and/or containing the impugned trademark BUPRO;
- (e) A preliminary decree be passed in favour of the Plaintiff directing the defendants to render accounts of profits made by it by use of the trademarks BUPRO which is identical and/or deceptively similar 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 have rendered accounts;
- (f) for costs of the entire proceedings.

in CS 703 of 2014

- (a) A permanent injunction restraining the defendant, their manufacturers, distributors, stockists, servants, agents, wholesalers, retailers, legal representatives 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 plaintiff's registered trademark LOBAZAM by use of almost identical trademark LOBAZ or any mark identical or similar to Plaintiff's registered trademark LOBAZAM or in any other manner whatsoever;

(b) A permanent injunction restraining the defendant, their manufacturers, distributors, stockists, servants, agents, wholesalers, retailers, legal representatives 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 LOBAZ or any other trademark that is identical and/or deceptively similar as that of the plaintiff's registered trademark LOBAZAM and/or use similar packaging as that of the plaintiff's products under the mark LOBAZAM 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 connected with the plaintiff;

(c) the defendants be ordered to pay to the Plaintiff a sum of Rs.1,00,000/- as liquidated damages for committing acts as infringement against plaintiff's registered trademark so as to pass off its products as and for the plaintiff's products;

(d) the defendants 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, hand bills, hoardings, wall posters, calendars, carry bags, stationery items and such other sales promotional materials bearing and/or containing the impugned trademark LOBAZ;

(e) A preliminary decree be passed in favour of the Plaintiff directing

the defendants to render accounts of profits made by it by use of the trademarks LOBAZ which is identical and/or deceptively similar 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 have rendered accounts;

(f) for costs of the entire proceedings.

in CS 704 of 2014

(a) A permanent injunction restraining the defendant, their manufacturers, distributors, stockists, servants, agents, wholesalers, retailers, legal representatives 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 plaintiff's registered trademark QUTIPIN by use of deceptively similar trademark QUPIN or any mark similar to plaintiff's registered trademark QUTIPIN;

(b) A permanent injunction restraining the defendant, their manufacturers, distributors, stockists, servants, agents, wholesalers, retailers, legal representatives 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 QUPIN or any other trademark that is identical and/or deceptively similar as that of the plaintiff's registered trademark QUTIPIN and/or use similar packaging as that of the plaintiff's products under the mark QUTIPIN 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 connected with the plaintiff;

- (c) the Defendant be ordered to pay to the Plaintiff a sum of Rs.1,00,000/- as liquidated damages for committing acts of infringement against plaintiff's registered trademark so as to pass off its products as and for the plaintiff's products;
- (d) 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, hand bills, hoardings, wall posters, calendars, carry bags, stationery items and such other sales promotional materials bearing and/or containing the impugned trademark QUPIN;
- (e) 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 QUPIN which is identical and/or deceptively similar and a final decree be passed in favour of the Plaintiff for the amount of profits found to have been made by the Defendant after the latter has rendered accounts;
- (f) for costs of the entire proceedings.

For Plaintiff : Mr. Arun C. Mohan
(in all the Suits)

For Defendants : Mr.R.Sathish Kumar
(in all the petitions)

COMMON JUDGMENT

1. The parties to the above three suits are the same. They are producers of pharmaceutical products. The Plaintiff namely Sun Pharma

Laboratories Limited, has come up with these suits on the ground that the Defendant which is a subsequent user is infringing the registered marks of the Plaintiff in respect of three different products which are medicines to treat depression, seizure, bipolar disorders and schizophrenia.

1.1. The claim of the Plaintiff in CS No.687 of 2014 is that the first Defendant has named its medicinal preparation to treat depression as 'BUPRO' which is phonetically and visually similar to its product 'BUPRON' which is also used in treatment of the same disease namely depression had infringed the registered trademark of the plaintiff. The Plaintiff would claim that its predecessor started using the name 'BUPRON' for its pharmaceutical preparation from 12.07.2001 and it had obtained a valid registration on 12.07.2001. The Plaintiff would also claim that the user of the name 'BUPRO' by the Defendant would amount to passing off its products as that of the plaintiff's.

1.2. It is the further contention of the Plaintiff that the drug 'BUPRON' manufactured by the Plaintiff has acquired a significant market share and the turnover which was about 67.05 lakhs in the year 2001 to 2002 had significantly increased to 476.05 lakhs during the year 2011 to 2012. It is also claimed by the Plaintiff that its predecessor which started

using the name 'BUPRON' in the year 2001 had spent huge amounts for advertising and for circulation of the trade literature, pamphlets, product manual, etc. It had also popularised the drug among the medical practitioners as well as the general public at a huge cost. The Defendant by naming its product as 'BUPRO' which is deceptively similar both visually and phonetically to the registered trademark of the Plaintiff is attempting to encash upon the popularity of the plaintiff's product.

1.3. On the above contentions, the Plaintiff would seek a permanent injunction restraining the Defendant from infringing the trademark of the Plaintiff by using the identical trademark 'BUPRO' or any other mark which is identical or similar to the plaintiff's trademark 'BUPRON'. A permanent injunction restraining the Defendant from passing off its medicinal preparation as that of the Plaintiff has also been sought for. A prayer for a direction to deliver up the preparations, dies, blocks, labels, packaging materials, brochures, leaflets etc., for destruction has been sought for and a decree for accounting apart from liquidated damages has been claimed by the plaintiff.

2. This claim is resisted by the Defendant contending that it is also manufacturing tablets for treatment of depression and the products of

the Plaintiff as well as the Defendant being applied in treatment of the same disease and being manufactured from the same active pharmaceutical ingredient viz., Bupropion Hydrochloride, the action of the Defendant in adopting a part of the name of the active pharmaceutical ingredient for its end product is in consonance with the common trade practice in the pharmaceutical industry.

2.1. It is also claimed that the user or adoption of the mark 'BUPRO' by the Defendant is *bona fide* and is in line with the trade usage. The Defendant would further add that major pharmaceutical manufacturers have named their product after the active pharmaceutical ingredient and therefore, such naming would not amount to infringement of the trademark of the plaintiff. It is also pointed out that the fact that the drug is a 'Schedule H Drug' which is sold only on the prescription of a registered medical practitioner, the claim of deceptive similarity cannot be countenanced. It is the further claim of the Defendant that the protection afforded to a manufacturer who uses a part of the name of the active pharmaceutical ingredient is much less than an invented word or a coined name. The fact that the drug in question is a schedule-H drug which could be sold only on a prescription is projected as a factor that would negate the element of confusion.

2.2. The Defendant would also contend that this Court has no jurisdiction, inasmuch as the registered office of the Plaintiff is situate in Bombay and the Defendant is operating from Jaipur. The Defendant would further plead that mere existence of an office of the Plaintiff in Chennai would not enable the Plaintiff to institute the suit at Chennai, where there is no other part of the cause of action. On the above contentions the Defendant sought for dismissal of the suit.

3. A replication was filed by the Plaintiff disputing the claims in the written statement and contending that this Court has got jurisdiction, inasmuch as, the Plaintiff has an office within the jurisdiction of this Court and that the products of the Defendant are being sold in various pharmacies within the jurisdiction of this Court. On the above pleadings, the following issues were framed by this Court:

1. Whether the Defendant is infringing the plaintiff's registered trademark 'Bupron' by using a deceptively similar trademark 'Bupro'?

2. Whether the defendant's adoption of an identical mark amounts to passing off of the plaintiff's trademark 'Bupron'?

3. Whether the plaintiff's trademark 'Bupron' and the defendant's 'Bupro' are manufactured from the same basic ingredient, 'Bupropion Hydrochloride'?

4. Whether the defendant's adoption of the trademark 'Bupro' is based on the honest trade practices in the pharmaceutical industry?

5. Whether there are others using the trademarks identical or similar to that of the plaintiff's 'Bupron' and whether the trademark is common to trade?

6. To what other relief the Plaintiff is entitled?

4. The case of the Plaintiff in the other two suits as well as the defence is the same as in CS No.687 of 2014. CS No.703 of 2014 relates to the mark 'LOBAZAM' which is a registered mark of the plaintiff, the mark used by the Defendant is 'LOBAZ'. The active pharmaceutical ingredient in respect of the said medicinal preparation is 'CLOBAZAM'. There is no dispute between the parties that the said medicine is used in treatment of 'seizure' and the same is also a Schedule H Drug, which could be sold only on prescription of the registered medical practitioner. The Plaintiff has a valid registration of trademark for the said product and the same is

registered on 03.04.2007 and the user claimed is from 22.12.1998. This trademark registration was also obtained by the predecessor of the Plaintiff namely M/s. Sun Pharmaceutical Industries.

4.1. The Plaintiff has also obtained a license from the Commissioner of Drug Control Administration for production of the tablets 'LOBAZAM'. The Defendant which is admittedly a subsequent entrant had made an application for registration of the trademark 'LOBAZ' on 23.08.2010. The Plaintiff has claimed similar reliefs relating to infringement, passing off, accounting and destruction of materials in CS No.703 of 2014 also.

5. The third suit in CS No.704 of 2014 relates to another medicinal preparation namely 'QUTIPIN' for which the plaintiff's predecessor had obtained a registration on 02.05.2002. It is claimed that the said drug has been manufactured by the predecessor of the Plaintiff from the said date namely 02.05.2002. The defendant's drug subject matter of CS No.704 of 2014 is named as 'QUPIN' both the drugs are used in treatment of bipolar disorders and the active pharmaceutical ingredient is Quetiapine Fumerate.

6. The pleadings in the said suit are also akin to the pleadings in CS No.687 of 2014. Upon the consideration of the rival pleadings, this Court had framed the following issues in both the suits in CS Nos.703 and 704 of 2014:

(i) Whether this Hon'ble Court has jurisdiction to try these suits?

(ii) Whether the name CLOBAZAL is an international Non-proprietary name under the Drug Classification and if so, whether the Defendant has coined their trademark LOBAZ bonafide?

(iii) Whether the Plaintiff is guilty of delay and laches and acquiescence?

(iv) Whether the use of the deceptively similar trademark QUPIN by the defendants for identical class of goods amounts to violation of the proprietary and statutory rights vested with the plaintiff?

(v) Whether the Plaintiff is entitled to an order of permanent injunction against the defendant's use of the trade mark QUPIN?

(vi) To what other reliefs, the parties are entitled to?

7. Since the issue relating to jurisdiction was not framed when issues were framed on 04.10.2019 by this Court in CS No.687 of 2014, the following additional issue was framed on 02.08.2021 in th said suit:

‘Whether this Court lacks jurisdiction to try the suit’

8. At trial, one Mr.Rajamallaiah Gangaram Cirumalla, was examined as P.W.1 in all the three suits and one Mr.Dheeraj Mohandas, was examined as D.W.1 in all the three suits. Exhibits P1 to P12 were marked on the side of the Plaintiff and Exhibit D1 was marked on the side of the defendants in CS No.687 of 2014, Exhibits P1 to P10 were marked on the side of the Plaintiff and Exhibits D1 and D2 were marked on the side of the Defendant in CS No.703 of 2014. Exhibits P1 to P7 were marked on the side of the Plaintiff and Exhibit D1 was marked on the side of the Defendant in CS No.704 of 2014.

9. I have heard Mr.Arun C. Mohan, learned counsel appearing for the Plaintiff in all the cases and Mr.R.Sathish Kumar, learned counsel appearing for the Defendant in all the cases.

Issue No.1 in CS No.703 and 704
and the Additional Issue in CS No.687 of 2014:

10. This issue relates to the jurisdiction of the Court. The Plaintiff seeks to invest the jurisdiction in this Court by contending that it has got an office within the jurisdiction of this Court and claiming that the products of the Defendant in all the three suits are sold within the jurisdiction of this Court and therefore, this Court would have jurisdiction to try the suit.

10.1 Contending contra Mr.R.Sathish Kumar, learned counsel appearing for the Defendant would point out that the registered office of the Plaintiff is situate at Bombay and the registered office of the Defendant is situate at Jaipur. Therefore, applying the principle of forum conveniens this Court should refuse to exercise jurisdiction and direct the parties go either to Bombay or Jaipur, which would be a more appropriate jurisdiction.

10.2. Mr.Arun C. Mohan, learned counsel appearing for the Plaintiff would draw my attention to Section 134 (2) of the Trademarks Act, and contend that the Trademarks Act, which is a special legislation gives an additional option to the Plaintiff to sue from a place where it carries on business and therefore, once the Plaintiff is found to be carrying on business from within the jurisdiction of this Court, this Court would be perfectly justified in entertaining the suit. Adverting to the argument based on the

principle of forum conveniens advanced by Mr.R.Sathish Kumar, Mr.Arun C.Mohan would contend that once the entire evidence has been taken and the trial itself has been completed, the principle of forum conveniens cannot be invoked to deny the jurisdiction to this Court and to shunt to the parties to another jurisdiction where proceedings will have to be commenced *de novo*.

10.3. Placing particular reliance on Sub Section 2 of Section 134 of the Trademarks Act, which contains a non-obstante clause, Mr.Arun C. Mohan, would contend that where the Plaintiff carries on business in more than one jurisdiction an option is available to the Plaintiff to institute the suit in any one of such jurisdictions, de hors the fact that the Defendant may not be physically present within the said jurisdiction.

10.4. Mr.Arun C. Mohan, learned counsel appearing for the Plaintiff would invite my attention to the judgment of a Division Bench of this Court in ***Surplur Mills Limited v. Dayal Fertilizers Pvt. Limited and Ors.***, reported in ***2021 (3) CTC 178***, in support of his contention that a suit shall not be short circuited, if the plaint otherwise discloses a cause of action within the jurisdiction of this Court. While distinguishing the jurisdiction under the enactments dealing with Intellectual Property Rights

from the jurisdiction that is dealt with under Section 20 of the Code of Civil Procedure, the Division Bench has pointed out that it is always open to the Plaintiff to choose a Court where the jurisdiction had either arisen in full or a part of the cause of action has arisen. In doing so, the Division Bench had concluded that in suits which pertain to the alleged infringement of Intellectual Property Rights, the jurisdiction will have to be decided in conjunction with the relevant provisions of the Trade Marks Act, which deal with the said rights.

10.5. Mr. Arun C. Mohan, would also draw my attention to the judgment of a Division Bench of this Court in ***Mankind Pharma Limited v. Sun Pharma Laboratories Limited***, reported in ***2016 (4) LW 760***, wherein the Hon'ble Division Bench had held that this Court would have jurisdiction, inasmuch as the Plaintiff in the said suit which is also the Plaintiff herein, has an office within the jurisdiction of this Court. After making a specific reference to Section 134 (2), the Division Bench, concluded that this Court would have jurisdiction to entertain the suit.

10.6. Relying upon the above two pronouncements and a judgment of mine in ***Sun Pharmaceuticals Industries Limited and another v. Nirma Limited and another, in CS No.735 of 2011***, wherein I had

upheld the claim of the Plaintiff that this Court would have jurisdiction to entertain a suit regarding infringement of the trademark of the Plaintiff on the basis of the location of the office of the Plaintiff and sales of the products of the Defendant within the jurisdiction of this Court, Mr.Arun C. Mohan, would submit that this Court has got jurisdiction to entertain the suits.

10.7. Contending contra, Mr.R.Sathish Kumar, learned counsel appearing for the Defendant would submit that the Hon'ble Supreme Court had held that the principles of forum conveniens would apply to Civil suits also and mere existence of the office of the Plaintiff within the jurisdiction of this Court would not enable the Plaintiff to file a suit here and drag the Defendant which is actually carrying on business in Jaipur, Rajasthan. Mr.R.Sathish Kumar, learned counsel would also rely upon the judgment of the Full Bench of this Court in ***Duro Flex Pvt. Limited v. Duroflex Seatings System***, reported in ***2014 (6) CTC 577***, in support of his contention that principles akin to that of forum conveniens would also apply to Civil Suits.

10.8. Mr.R.Sathish Kumar, learned counsel would also rely upon the judgment of the Single Judge of the Punjab & Haryana High Court in ***Himachal Pradesh Horticulture Produce Marketing and Processing***

Corporation Ltd., Simla v. Mohan Meakin Breweries Limited, Solan, reported in ***AIR 1981 P & H 117***, to contend that sporadic sales of the products of the Defendant within the jurisdiction of this Court would not confer jurisdiction on this Court.

10.9. I have considered the rival submissions.

10.10. The fact that the Plaintiff has an office within the jurisdiction of this Court is not in dispute. The fact that the products of the Defendant have been sold within the jurisdiction of this Court has been established by production of invoices which have been marked as Ex.P10 in CS No.687 of 2014, Ex.P8 in CS No.703 of 2014 and Ex.P3 in CS No.704 of 2014. It is therefore clear that two of the pre-requisites for this Court exercising jurisdiction are present in the case on hand, if I am to deny the jurisdiction, it could only be on the basis of the principle of forum conveniens as projected by the Hon'ble Supreme Court in ***Indian Performing Rights Society Ltd v. Sanjay Dalia and Another***, reported in ***AIR 2015 SC 3479***. The Hon'ble Supreme Court while considering the question of jurisdiction in a suit for infringement on a reading of Section 134 of the Trademarks Act and Section 62 of the Copy Right Act had held that while the Trademark Act does not create a jurisdiction it only prescribes

an additional jurisdiction apart from what is prescribed under Section 20 of the Code of Civil Procedure, in cases relating to infringement.

10.11. The Hon'ble Supreme Court also held that the intendment of the provisions inserted in the Trademark Act, is to provide an additional forum to the Plaintiff where he is resides, carries on business or personally works for gain. The Hon'ble Supreme Court had also pointed out that the object is to ensure that the Plaintiff is not deterred from instituting an infringement proceeding because the Court in which such infringement proceedings ought to be instituted is at a considerable distance from the place of the plaintiff's ordinary residence. While rejecting the claim of the Plaintiff before it on the basis that bulk of litigation relating to Intellectual Property Rights is instituted in Delhi and the counsel there, have expertise as an irrelevant factor to determine jurisdiction, the Hon'ble Supreme Court pointed out that the doctrine of forum conveniens must also be taken into account and not every place where the Plaintiff has insignificant presence could afford a jurisdiction to the Plaintiff to institute a suit.

10.12. As already pointed out a Full Bench of this Court in ***Duro Flex Pvt. Limited, v. Duroflex Sitzings System***, had held that principles akin to the principle of forum conveniens would apply to civil proceedings

also. No doubt, the Plaintiff has its principal place of business at Mumbai and the office at Chennai is only a branch office. It is not specifically pleaded by the Defendant that the Plaintiff has no activity or minimal activity at its office at Chennai. In paragraph 19 of the plaint, the Plaintiff has specifically averred that the Plaintiff has an office at Chennai and carries on business at Chennai and therefore, it is statutorily entitled to institute the suit here at Chennai.

10.13. It is also claimed that the products of the Defendant are available in the pharmacies all over the country including the city of Chennai and therefore, substantial part of the cause of action had arisen within the jurisdiction of this Court. The Defendant has not denied that its products are sold within the jurisdiction of this Court. The fact that the Plaintiff has an office within the jurisdiction of this Court has been recognised in at least two judicial proceedings in ***Mankind Pharma Limited v. Sun Pharma Laboratories Limited***, reported in ***2016 (4) LW 760*** and ***Sun Pharmaceuticals Industries Limited and another v. Nirma Limited and another, in CS No.735 of 2011***. The argument of Mr.Sathish Kumar, learned counsel based on the principle of forum conveniens, though attractive, overlooks the statutory provision in the Trademarks Act which enables the Plaintiff to institute the suit in this Court, if the Plaintiff carries

on business within the jurisdiction of this Court.

10.14. Yet another aspect which detains me from invoking the principle of forum conveniens to non-suit the Plaintiff is the present stage of the litigation. Entire evidence has been recorded in all the three suits and the suits have been pending in this Court for atleast 7 years now, to invoke the principle of forum conveniens and to relegate the parties for a *de novo* trial before an another forum would only cause much inconvenience to the parties. I am therefore of the considered opinion that the objection to the jurisdiction of this Court has to necessarily fail and Issue No.1 in CS Nos. 703 and 704 of 2014 and the additional Issue in CS No.687 of 2014 will have to be answered in favour of the plaintiff.

Issue No.3 in CS No.687 of 2014:

11. This issue is, as to whether, the products of the Plaintiff and the Defendant are manufactured from a common pharmaceutical ingredient 'Bupropion Hydrochloride'. This issue in fact does not arise for consideration in this suit particularly because of the claim of the Defendant that its medicinal preparations are made using the active pharmaceutical ingredient Bupropion Hydrochloride, which is also the active pharmaceutical ingredient for the plaintiff's product 'BUPRON'. In fact in

paragraph 4 of the written statement, the Defendant had very clearly conceded that both the products are identical medicines with the same base ingredient namely Bupropion Hydrochloride. Hence Issue No.3 in CS No.687 of 2014, does not really arise for consideration.

Issue Nos.1 and 2 in CS No.687 of 2014
and Issue No.4 in CS Nos.703 and 704 of 2014:

12. This issue relates to the infringement of the trademark of the plaintiff. The Plaintiff is admittedly a registered proprietor of the three marks namely 'BUPRON', 'LOBAZAM' and 'QUTIPIN'. The Plaintiff has valid registrations and the respective Legal User Certificates have been produced as Ex.P2 in all the three suits. The Defendant does not have a registration in fact the defendant's application was opposed by the Plaintiff and the said opposition is stated to be pending. While the Plaintiff would claim that the Defendant which is a later entrant into the market has adopted phonetically and visually similar trade names for its products, thereby it not only infringes the trademark of the plaintiff, but also passes off its products as the products of the plaintiff.

12.1. The claim that the products are Schedule H Drugs and that they being sold only on prescription of a registered medical practitioner

therefore, the possibility of confusion is not there, has been rejected by the Hon'ble Supreme Court in *Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd.*, reported in *AIR 2001 SC 1952*. Therefore, the question of deceptive similarity will have to be considered, taking into account the trade practice of the industry also. It is in evidence and it is conceded by the counsel appearing for the parties that the practice in the pharmaceutical industry is to name a drug, after the name of the active pharmaceutical ingredient.

12.2. In the case on hand, the active pharmaceutical ingredients of the drugs involved in the above three suits are 'BUPROPION HYDROCHLORIDE', 'CLOBAZAM' and 'QUTIPINE FUMERATE'. The above fact is not in dispute. The Plaintiff which is an earlier entrant has named its products after the name of the active pharmaceutical ingredients in all the three cases. The plaintiff's products are named as 'BUPRON', 'LOBAZAM' and 'QUTIPIN'. The Plaintiff has got a valid registration for the above marks and I had already pointed out legal user certificates have been produced to show that the registration of the above marks are valid and subsisting.

12.3. It is the contention of the Defendant that it has a right to

name its products after the active pharmaceutical ingredient, as per the trade practice in the pharmaceutical industry. No doubt such practice in the pharmaceutical industry has been acknowledged by this Court also. However, a right of a subsequent entrant to name its products adopting a deceptively similar name or a mark as that of earlier entrant who has got a registration in its favour is to be considered, while deciding on the issue of infringement.

12.4. I had in fact considered this very question in *Sun Pharmaceuticals Industries Limited and another v. Nirma Limited and another, in CS No.735 of 2011*, and had held that when a manufacturer adopts the name of active pharmaceutical ingredient with a prefix or a suffix for its product then the Court while testing the claim of infringement will have to remove the part of the name of the active pharmaceutical ingredient and see the similarity or dissimilarity or the attempted deception in the remaining part. I had also pointed out that a manufacturer who adopts the name of the pharmaceutical ingredient without any addition thereto is entitled to a lesser protection in claims for infringement.

12.5. The marks that were in dispute in CS No.735 of 2011 were '**Vecuron**' and '**Vecunir**', the active pharmaceutical ingredient was

Vecuronium Bromide, the Plaintiff in the said suit had adopted the name Vecuron, which is actually a portion of the name of the active pharmaceutical ingredient without any prefix or suffix. Whereas the Defendant had adopted the name 'Vecunir', which can be split into two parts namely 'Vecu' which is the part of the name of the active pharmaceutical ingredient and 'Nir', which is the part of the name of the Defendant Company namely 'Nirma'. Therefore, while considering the protection that is available to the Plaintiff who had just used the portion of the name of the active pharmaceutical ingredient vis-à-vis, the Defendant who had added something to a portion of the name of the active pharmaceutical ingredient, I had held that the Plaintiff in such a case would be entitled to a lesser degree of protection and had rejected the claim of the Plaintiff for infringement.

12.6. The case on hand stands on a different footing. On a comparison of the names adopted by both the parties in the case on hand, I find that both of them have used portions of the name of the active pharmaceutical ingredient without any prefix or suffix, therefore, both of them stand on equal footing in so far as the degree of protection that is available to them under law. In such case what remains to be seen is the right of a registered proprietor and a prior user as against the right of an

infringer. It is fundamental principle of trademark law that a registered proprietor who is also a prior user has got a much superior right than that of a later entrant or an infringer. Admittedly, the Plaintiff in all the three suits is the prior user and it has got a valid subsisting registration of its marks. The defendant's marks are yet to be registered and they are pending in view of the opposition of the plaintiff. On a comparison of these three marks in the manner suggested by the Hon'ble Supreme Court in ***Parley Products (P) Ltd v. J.P. & Co., Mysore***, reported in ***1972 (1) SCC 618***, I am sure that there is a great likelihood of deception in respect of the three marks.

12.7. As I already pointed out the Hon'ble Supreme Court had in ***Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd.***, reported in ***AIR 2001 SC 1952***, held that even when the products are medicinal preparations which are to be sold under prescription, there is a possibility of a mistake. While doing so, in paragraph 27 of the said judgment, the Hon'ble Supreme Court has observed as follows:

“27. As far as present case is concerned, although both the drugs are sold under prescription but this fact alone is not sufficient to prevent confusion which is otherwise likely to occur. In view of the varying infrastructure for supervision of physicians and

pharmacists of medical profession in our country due to linguistic, urban, semi-urban and rural divide across the country and with high degree of possibility of even accidental negligence, strict measures to prevent any confusion arising from similarity of marks among medicines are required to be taken.”

12.8. In fact in paragraph 32 of the very same judgment, the Hon’ble Supreme Court had pointed out that public interest would support a lesser degree of proof showing confusing similarity in case of medicinal preparations. It will be relevant to quote the observations of the Hon’ble Supreme Court, which read as follows:

“32. Public interest would support lesser degree of proof showing confusing similarity in the case of trade mark in respect of medicinal product as against other non-medicinal products. Drugs are poisons, not sweets. Confusion between medicinal products may, therefore, be life threatening, not merely inconvenient. Notwithstanding the frailty of human nature and the pressures placed by society on doctors, there should be as many clear indicators as possible to distinguish two medicinal

products from each other. It is not uncommon that in hospitals, drugs can be requested verbally and/or under critical/pressure situations. Many patients may be elderly, infirm or illiterate. They may not be in a position to differentiate between the medicine prescribed and bought which is ultimately handed over to them. This view finds support from McCarthy on Trade Marks, 3rd Edition, para 23.12 of which reads as under”

“The tests of confusing similarity are modified when the goods involved are medicinal products. Confusion of source or product between medicinal products may produce physically harmful results to purchasers and greater protection is required than in the ordinary case. If the goods involved are medicinal products each with different effects and designed for even subtly different uses, confusion among the products caused by similar marks could have disastrous effects. For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations. The same standard has been applied to medical products such as surgical sutures and clavicle splints.

12.9. Coming to the marks in the present case, I have already indicated that there is a very clear possibility of there being confusion between the marks of the Plaintiff and that of the defendant. It is just one or two letters that go missing in either of the marks. I am therefore of the considered opinion that there is every possibility of deception or confusion between the marks of the Plaintiff and the marks of the defendant, if the test applied suggested by the Hon'ble Supreme Court in ***Parley Products (P) Ltd v. J.P. & Co., Mysore***, 's case are to be followed. I therefore answer the above issues in favour of the Plaintiff and against the defendant.

Issue No.4 in CS No.687 of 2014
and Issue No.2 in CS Nos.703 and 704 of 2014:

13. This issue relates to the *bona fides* of the user. No doubt the trade practice of the Pharma industry to use the part of an active pharmaceutical ingredient in the name of the products is recognized. At the same time, the right of the prior user who has a registration and who has a statutory protection afforded by the Trademarks Act will have to be protected by the Court. I find that the names adopted by the defendant, though based on the names of the active pharmaceutical ingredient, there is a clear lack of *bona fides* on the part of the Defendant in adopting almost a

similar name which would definitely cause confusion among the general public or the consumer. Hence these issues are answered against the Defendant and in favour of the plaintiff.

14. In the light of the finding that the user by the Defendant of the names which are substantially similar to that of the plaintiffs would amount to infringement of the marks of the Plaintiff and that such user is not *bona fide*, the Plaintiff would be entitled to the reliefs of prohibitory injunction sought for and the relief of mandatory injunction also. Though a claim for liquidated damages has been made, I do not find any evidence in support of the said claim. No material is placed before the Court to show that there was a reduction in sale of the plaintiff's products during the interregnum because of the confusion caused by the sale of the defendant's products, which would enable the Court to grant liquidated damages. Hence the prayer for liquidated damages stands rejected.

15. As regards the relief of accounting also I do not find any substantial evidence to probalise the claim of the Plaintiff that its turnover is suffered because of the introduction of the defendant's products in the market. Though it is claimed that the defendant's products were introduced in the years 2010 and 2011, the Plaintiff has not placed any evidence before

the Court to show that the turnover of the Plaintiff had dwindled because of the introduction of the defendant's products. In the absence of such evidence, I do not think that the Plaintiff would be entitled to the relief of accounting.

16. In fine all the three suits are decreed in part, granting the reliefs of permanent injunctions and mandatory injunction namely reliefs (a), (b) and (d) alone. The suits in respect of reliefs (b) and (e) will stand dismissed. In view of the facts that the suits are partially decreed, I direct the parties to bear their own costs. Consequently, the connected miscellaneous applications are closed.

in CS Nos.687, 703 & 704 of 2014:

List of Witness examined on the side of the plaintiff:

PW1 – Mr.Shri Rajmallaiah Gangaram Cirumalla

List of Witness examined on the side of the Defendants:

DW1 – Mr.Dheeraj Mohandas

in CS No.687 of 2014:

List of Exhibits marked on the side of the Plaintiff:

<i>S. No.</i>	<i>Exhibits</i>	<i>Description of Documents</i>
1	Ex.P1	Power of Attorney
2	Ex.P2	Legal Use Certificate for registration of trademark BUPRON under No.1026230 in class 5
3	Ex.P3	Product Permission granted by Food and Drug Control Administration for manufacture of tablets under mark BUPRON
4	Ex.P4	Order passed by Trademarks Registry allowing change of proprietorship of mark
5	Ex.P5	Invoices for sale of plaintiff's BUPRON tablets along with Section 65B Certificate
6	Ex.P6	Chartered accountant Certificate of sales figures in respect of BUPRON tablets
7	Ex.P7	Extract from medical journals listing Plaintiff's BUPRON tablets
8	Ex.P8	Cases and desist notice issued by plaintiff
9	Ex.P9	Reply issued by 1 st defendant
10	Ex.P10	Original Invoice proving sale of defendants' BUPRO
11	Ex.P11	Scanned images of plaintiff's BUPRON pack along with Section 65B Certificate
12	Ex.P12	Scanned images of defendants' BUPRO pack along with Section 65B Certificate

List of Exhibits marked on the side of the Defendant:

<i>S. No.</i>	<i>Exhibits</i>	<i>Description of Documents</i>
1	Ex.D1	The original Authorization dated 15.07.2020 in my favour

in CS No.703 of 2014:

List of Exhibits marked on the side of the Plaintiff:

<i>S. No.</i>	<i>Exhibits</i>	<i>Description of Documents</i>
1	Ex.P1	Power of Attorney
2	Ex.P2	Legal Use Certificate for registration of trademark LOBAZAM under No.1546006 in class 5
3	Ex.P3	Product Permission granted by Food and Drug Control Administration for manufacture of tablets under mark LOBAZAM
4	Ex.P4	Order passed by Trademarks Registry allowing change of proprietorship of mark
5	Ex.P5	Invoices for sale of plaintiff's LOBAZAM tablets along with Section 65B Certificate
6	Ex.P6	Chartered accountant Certificate of sales figures in respect of LOBAZAM tablets
7	Ex.P7	Extract from medical journals listing Plaintiff's LOBAZAM tablets
8	Ex.P8	Invoices proving sale of defendant's LOBAZ
9	Ex.P9	Scanned images of plaintiff's LOBAZAM pack along with Section 65B Certificate
10	Ex.P10	Scanned images of defendant's LOBAZ pack along with Section 65B Certificate

List of Exhibits marked on the side of the Defendant:

<i>S. No.</i>	<i>Exhibits</i>	<i>Description of Documents</i>
1	Ex.D1 marked through P.W.1 Cross	Q.40: Please check whether this Opposition proceedings initiated against the defendant's trademark LOBAZ by the Plaintiff document (Defendant's Doc. No.3) is the opposition filed by the Plaintiff? A: Yes. The above said document is marked Ex.D1
2	Ex.D2	The original Authorization dated 15.07.2020 in my favour

in CS No.704 of 2014:

List of Exhibits marked on the side of the Plaintiff:

<i>S. No.</i>	<i>Exhibits</i>	<i>Description of Documents</i>
1	Ex.P1	Power of Attorney
2	Ex.P2	Legal Use Certificate for registration of trademark QUTIPIN under No.1101622 in class 5
3	Ex.P3	Invoices for sale of plaintiff's QUTIPIN tablets along with Section 65B affidavit
4	Ex.P4	Chartered accountant Certificate of Sales figures in respect of QUTIPIN tablets
5	Ex.P5	Original Invoice proving sale of defendant's QUPIN
6	Ex.P6	Scanned images of plaintiff's QUTIPIN pack along with Section 65B affidavit
7	Ex.P7	Scanned images of defendant's QUPIN pack along with Section 65B Certificate

List of Exhibits marked on the side of the Defendant:

<i>S. No.</i>	<i>Exhibits</i>	<i>Description of Documents</i>
1	Ex.D1	The original Authorization dated 15.07.2020 in my favour

Sd./- R.S.M.J.
23.09.2021

//Certified to be true copy//

Dated at Madras this the day of 2022.

COURT OFFICER(O.S.)

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