



IN THE HIGH COURT OF JUDICATURE AT MADRAS

(ORDINARY ORIGINAL CIVIL JURISDICTION)

WEDNESDAY, THE 06th DAY OF APRIL 2022

THE HON'BLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

O.A.Nos.78 to 82 of 2022  
in  
C.S.(Comm.Div) No.24 of 2022

TIL Healthcare Private Limited,  
Represented by its Authorised Representative  
Mrs.Shabeena Thahseen, AVP Regulatory Affairs,  
Tagros House', 3rd Floor, New No.4 (Old No.10),  
Club House Road, Anna Salai,  
Chennai 600 002.

...Applicants/Plaintiffs  
(in all Original Applications)

-Versus-

1. Bio Conic Remedies,  
Partnership firm, represented by Mr.Shripal Jain  
No.66/67, Gondpur,  
Industrial Estate, HIPSIDC,  
Paonta Sahib District,  
Sirmour 173025  
Himachal Pradesh.

Also at,  
101, A-Wing, Nilkanth Building,  
Opp.Pushp Vinod Building,  
S.V.Road, Borivali (West) Mumbai 400092.

2. Nucrest Pharma Private Limited,  
Represented by its Director, Vikram Ashok Panjwani  
303, 3rd Floor, AHCL Homes,  
Near Shimpoli Telephone Exchange,  
New Link Road Borivali(W)  
Mumbai 400092  
Maharashtra.



3. Channel Pharmaceuticals Limited  
Represented by its Director, Sir Nnamdi Henry Obi  
No.1, Nimo Street, Fegege Onitsha,  
Anambra 434232  
Nigeria.

... Respondents/Defendants  
(in all Original Applications)

**O.A.No.78 of 2022**

Original Application praying that this Hon'ble Court be pleased to grant An ad interim injunction restraining the Respondents, their partners, their employees, officers, servants, agents and all other acting for and on their behalf from manufacturing, selling, distributing, exporting, advertising, offering for sale, and in any other manner, directly or indirectly, dealing with any products under the label mark

amounting to passing off.

**O.A.No.79 of 2022**

Original Application praying that this Hon'ble Court be pleased to grant an ad interim injunction restraining the Respondents, their partners, their employees, officers, servants, agents and all other acting for and on their behalf from using impugned mark and trade dress

in any of the websites, domain names, social media platforms, mobile application and other intermediaries in any language.

**O.A.No.80 of 2022**

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Original Application praying that this Hon'ble Court be pleased to grant an ad interim injunction restraining the Respondents, its partners, directors, proprietors, subsidiaries, affiliates, franchisees, officers, servants, agents, distributors, stockists, representatives, licensees and anyone acting for or on their behalf directly or indirectly as the case may be from performing any actions, especially using artistic works identical to Applicant's original artistic works amounting to infringement of copyright therein.

**O.A.No.81 of 2022**

Original Application praying that this Hon'ble Court be pleased to grant an ad interim injunction restraining the Respondents its partners, directors, proprietors, subsidiaries, affiliates, franchisees, officers, servants, agents, distributors, stockists, representatives, licensees and anyone acting for or on their behalf directly or indirectly, as the case may be from using the

trade dress or in any manner whatsoever, and from selling, offering for sale, advertising, manufacturing, mentioning on their websites, dealing in any manner whatsoever or otherwise using the lay out and/or color combination of the trade dress or get-up almost identical to the

Applicant's trade dress amounting to passing off of its trade dress.



**O.A.No.82 of 2022**

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Original Application praying that this Hon'ble Court be pleased to grant an ad interim injunction restraining the Respondents, their partners, their employees, officers, servants, agents and all others acting for and on their behalf from manufacturing, selling, distributing, exporting, advertising, offering for sale, any products and in any other manner directly or indirectly dealing with any products under label mark

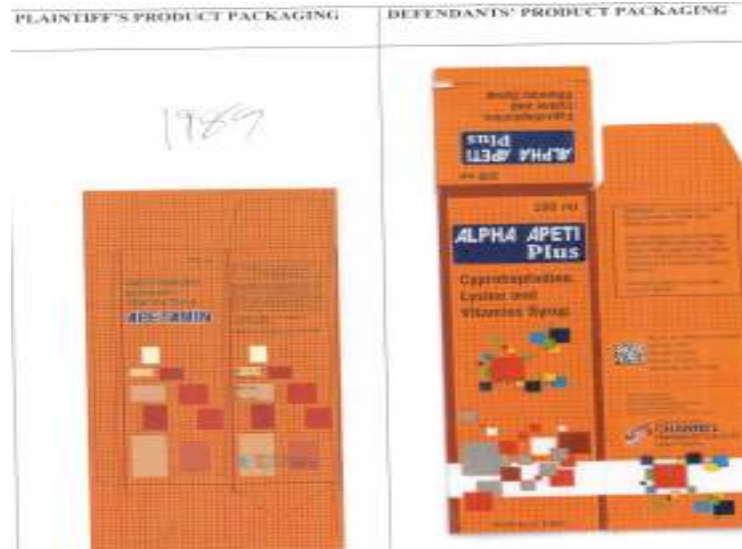
or any other similar/identical mark to the Applicant's registered trademark APETAMIN label" amountng to an infringement of the Applicant's registered trademark No.4145473 in Class 5.

These Original Applications coming on this day before this court for hearing in the presence of Mr.M.S.Bharath, for M/s.KRIA Law Advocates for the Applicant in all Original Applications and Mr.P.V.Balasubramaniam for M/s.BFS Legal, Advocates for the 2nd respondent herein and upon reading the Judges Summons and the Common Affidavit of Shabeena Thahseen and the Counter Affidavit of Ashok Panjwani filed in all Original Applications and the plaint filed herein and the Court is required to postulate a person of average intelligence and imperfect recollection and examine the registered mark and the impugned



person. The marks in question are set out below:

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If the marks in question are compared from the above perspective, it is noticeable that the registered label mark of the applicant consists of three elements which should be looked at collectively or in combination, these three elements are: the orange colour, the checks and the square or rectangular blocks in different colours, which are distinctive when seen in combination, the first and second respondents have adopted a label which also uses these three elements, and this label was adopted subsequently, when viewed as a whole, the two marks appear to be deceptively similar. Therefore, the impugned label *prima facie* infringes the proprietary interest of the applicant, section 27 (2) of the Trademarks Act recognises the common law remedy of passing off as an exception to the rule that statutory rights under the Trademarks Act are not available in respect of unregistered



trademarks, in this case, the second respondent states that the products in question are exclusively intended for export to a particular customer, namely, the third respondent in Nigeria, the applicant has not pointed out any instance of sale in India, in those circumstances, the applicant has not *prima facie* satisfied the more stringent requirements for grant of interim relief in respect of passing off, although the applicant relied on at least two judgments to contend that the legal fiction under Section 56 of the Trade Marks Act extends to the common law remedy of passing off in view of the use of the expression “or any other law” at the tail of sub-section (1) thereof, the question whether the common law remedy extends by legal fiction to sale in Nigeria by virtue of Section 56 of the Trademarks Act is left open for adjudication in course of final disposal,

**it is ordered as follows:-**

That 1. Bio Conic Remedies, Partnership firm, represented by Mr. Shripal Jain 2. Nucrest Pharma Private Limited, Represented by its Director, Vikram Ashok Panjwani and 3. Channel Pharmaceuticals Limited Represented by its Director, Sir Nnamdi Henry Obi the Respondents in O.A.No.82 of 2022 their partners, their employees, officers, servants, agents

and all other acting for and on their behalf be and are hereby restrained by



an order of interim injunction from manufacturing, selling, distributing, exporting, advertising, offering for sale, any products and in any other manner directly or indirectly dealing with any products under label mark .

or any other similar/identical work to the Applicant's registered trademark APETAMIN label" amountng to an infringement of the Applicant's registered trademark No.4145473 in Class 5.

2. That 1. Bio Conic Remedies, Partnership firm, represented by Mr.Shripal Jain 2. Nucrest Pharma Private Limited, Represented by its Director, Vikram Ashok Panjwani and 3. Channel Pharmaceuticals Limited Represented by its Director, Sir Nnamdi Henry Obi the Respondents herein be and are hereby restrained by an order of interim injunction from using the impugned mark in India on the products ALPHA APETI PLUS in course of export to Nigeria or otherwise.

3. That these O.A.Nos.78 to 81 of 2022 be and are hereby dismissed.



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4. That the A.No.585 of 2022 in C.S(Comm.Div) No.24 of 2022 be posted on 25.04.2022.

WITNESS THE HON'BLE MR.JUSTICE MUNISHWAR NATH BHANDARI CHIEF JUSTICE, HIGH COURT AT MADRAS AFORESAID, THIS THE 06<sup>th</sup> DAY OF APRIL 2022.

Sd./-

ASSISTANT REGISTRAR (Comm.Cases)

I//Certified to be true copy//

Dated at Madras this the       day of       2022.

COURT OFFICER(O.S.)

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20.04.2022

O.A.Nos. 78 to 82 of 2022  
in  
C.S.(Comm.Div)No.24 of 2022

ORDER

DATED :06.04.2022

THE HON'BLE MR. JUSTICE  
SENTHILKUMAR RAMAMOORTHY

FOR APPROVAL: 20.04.2022

APPROVED ON: 22.04.2022



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IN THE HIGH COURT OF JUDICATURE AT MADRAS

D A T E D : 06.04.2022

CORAM

The Hon'ble Mr. Justice **SENTHILKUMAR RAMAMOORTHY**

**Original Application Nos.78 to 82 of 2022**

**and**

**C.S.(Comm.Div.)No.24 of 2022**

TIL Healthcare Private Limited  
Rep. By its Authorised Representative  
Mrs.Shabeena Thahseen, AVP Regulatory Affairs  
Tagros House, 3<sup>rd</sup> Floor, New No.4(Old No.10),  
Club House Road, Anna Road,  
Chennai – 600 002.

... Applicant/Plaintiff  
(in all Original Applications)

vs.

1.Bio Conic Remedies  
Partnership firm,  
Rep. By Mr.Shripal Jain  
No.66/67, Gondpur,  
Industrial Estate, HIPSIDC,  
Paonta Sahib District,  
Sirmour – 173 025  
Himachal Pradesh.  
Also at  
101, A – Wing, Nilkanth Building,  
Opp. Pushp Vinod Building,  
S.V.Road, Borivali(West) Mumbai – 400 092.

2.Nucrest Pharma Private LIMITED,  
Rep. By its Director, Vikram Ashok Panjwani  
303, 3<sup>rd</sup> Floor, AHCL Homes,



Near Shimpoli Telephone Exchange,  
New Link Road Borivali(W),  
Mumbai – 400 09, Maharashtra.

3.Channel Pharmaceuticals Limited,  
Rep. By its Director,  
Sir Nnamdi Henry Obi,  
No.1, Nimo Street, Fegge Onitsha,  
Anambra – 434232. Nigeria.

... Respondents/Defendants  
(in All Original Applications)

**PRAYER IN O.A.NOs.78 to 82 OF 2022:** These Original Applications are filed under Order XIV Rule – 8 of O.S. Rule and Order 39 Rule 1 & 2 of the Code of Civil Procedure, 1908, praying to an ad interim injunction restraining the Respondents, their partners, their employees, officers, servants, agents, and all others acting for and on their behalf from manufacturing, selling, distributing, exporting, advertising, offering for sale, any products and in any other manner, directly or indirectly, dealing with any products under label mark or any other similar/identical mark to the Applicant's registered trademark "APETAMIN label" amounting to an infringement of the applicant registered trademark No.4145473 in Class 5; (b) an ad interim injunction restraining the Respondents, their partners, their employees, officers, servants, agents, and all others acting for and on their behalf from manufacturing, selling, distributing, exporting, advertising, offering for sale, any products and in any other manner, directly or indirectly, dealing with any products under label mark amounting to passing off; (c) an ad interim injunction restraining each of the Respondents, its partners, directors, proprietors, subsidiaries, affiliates, franchisees, officers, servants, agents, distributors, stockists, representatives, licensees and any one acting for or on their behalf directly or indirectly, as the case may be, from using the trade dress or in any



manner whatsoever, and from selling, offering for sale, advertising, manufacturing, mentioning on their websites dealing in any manner whatsoever or otherwise using the lay-out and/ or color combination of the trade dress or get-up almost identical to the Applicant's trade dress amounting to passing off its trade dress; (d) an ad interim injunction restraining each of the Respondents, its partners, directors, proprietors, subsidiaries, affiliates, franchisees, officers, servants, agents, distributors, stockists, representatives, licensees and any one acting for or on their behalf directly or indirectly, as the case may be from performing any actions, especially using artistic works identical to Applicant's original artistic work amounting to infringement of copyright therein; and (e) an ad interim injunction restraining the Respondents, their partners, their employees, officers, servants, agents and all other acting for and on their behalf from using impugned mark and trade dress in any of the websites, domain names, social media platforms, mobile application and other intermediaries in any language.

For Applicants : Mr.M.S.Bharath  
(for all Applications)

For Respondents : Mr.P.V.Balasubramaniam  
for M/s.BFS Legal for R-2.  
(for all Applications)

**COMMON ORDER**

These applications are filed to restrain alleged infringement of the applicant's registered trademark and copyright and to prevent alleged passing off. The applicant asserts that it manufactures and markets an

appetite stimulant with multi-vitamins under the name APETAMIN, and



that it is the registered proprietor of the APETAMIN label mark comprising the said words on an orange background with checks and square or rectangle shaped blocks in different colours, which is used thereon and in relation thereto. It is stated that this label mark is in use from the year 2002. It is also stated that the application for registration was filed on 12.04.2019, and that the registration is valid up to 12.04.2029.

2. The applicant states that the first respondent/defendant also manufactures appetite stimulants with multivitamins. The second respondent/defendant is an exporter of such products to the third respondent/defendant, which is an importer based in Nigeria. By drawing reference to the labels of the applicant *vis-a-vis* that of the respondents/defendants, it is contended that the use of the label mark with the words ALPHA APETI PLUS against an orange background, with checks and square or rectangle shaped blocks in different colours by the respondents/defendants constitutes both infringement and passing off. In particular, the applicant asserts that its label mark comprises 3 features, namely, the use of the orange background, checked pattern and square and rectangle shaped blocks in different colours. When seen in combination, it is asserted that these features are distinctive and that the subsequent adoption of the same features, especially in combination, by the



respondents/defendants is dishonest, deceptively similar and infringing.

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3. In this regard, the applicant relies upon Section 56 of the Trademarks Act 1999 (the Trademarks Act) which incorporates a legal fiction by which the application in India of a mark to goods exported from India would constitute use of the trademark in India in relation to the relevant goods for any purpose for which such use is material under the Trademarks Act. With reference to the facts of the case, the applicant asserts that the undisputed position is that the first and second respondents/defendants applied the impugned mark - i.e. a label consisting of the words, ALPHA APETI PLUS, on an orange background with checks and square or rectangle shaped blocks in different colours - to an appetite stimulant within India. Therefore, the legal fiction is triggered and it is tantamount to the use of an infringing mark within India. As a corollary, the applicant is entitled to remedies under Section 29 of the Trademarks Act. In support of these contentions, the applicant relies upon the following judgments:

*(i) UFO Contemporary, Inc v. Creative*

*Kids Wear (India) Pvt. Ltd and Others, 2020 (84)*

*PTC 461(Delhi).*

*(ii) Wockhardt Limited v. Eden*



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*Healthcare Pvt. Ltd, 2014(58) PTC 14 (Bombay)*

*(iii) Cadila Pharmaceuticals Limited v.*

*Sami Khatib, 2011(47) PTC 69 (Bombay)*

*(iv) Kirorimal Kashiram Marketing and*

*Agencies Private Limited v. Sachdeva and Sons*

*Industries Pvt. Ltd. 2009 (39) PTC 142 (Delhi).*

4. Although notices were served on all the respondents, only the second respondent entered appearance. The second respondent refutes the contentions of the applicant on multiple grounds. By way of preamble, the second respondent submits that appetite stimulants are banned in India amongst several other countries. Therefore, the products in question are not sold in India either by the applicant / plaintiff or by the respondents / defendants. The next contention is that the second respondent exports the goods exclusively to the third respondent/ defendant in Nigeria, and the third respondent/defendant has a registered copyright in respect of the design, i.e. in respect of the packaging depicted at page 2 of the second respondent's typed set, in Nigeria. Consequently, it is contended that the export of the product by using a label, which has IPR protection in Nigeria cannot be construed as infringing the applicant's trademark. The next contention of the third respondent is that the suit is improperly instituted in



submit documents on behalf of the company before the Registrar of Trademarks in India. To put it differently, the second respondent asserts that the institution of the suit before this Court by Mrs. Shabeena Thahseen, AVP Regulatory Affairs, of the applicant is not duly authorized by the applicant.

5. In support of the contention that the applicant is not entitled to interim relief, the second respondent relies heavily on the judgment of this Court in *Crompton Greaves Limited v. Salzer Electronics (2011)3 CTC 453 (SJ) (Crompton Greaves)*. In particular, the second respondent relies upon paragraphs 26 to 29, 31, 34, 35, 36 and 38 of the said judgment to contend that the application of a mark in India to goods meant for export is protected from the charge of infringement provided the importer has IPR protection in respect thereof in the relevant jurisdiction. The second respondent pointed out that the judgment of the learned Single Judge was affirmed in appeal in *Crompton Greaves Limited v. Salzer Electronics, 2011(48) PTC 27 (Madras) (DB)*. The second respondent also pointed out that these judgments were placed before the learned Single Judge of this Court in *M/s. Meenakshi Overseas LLC v. M/s. V.V.V. & Sons Edible Oils Limited, order dated 01.02.2019 in A.No.1948 of 2018 in C.S.No.726 of 2017*, and that the learned Single Judge refused to countenance submissions seeking to distinguish *Crompton Greaves* on facts on the ground that the said judgment



had interpreted Section 56 of the Trademarks Act. The second respondent also relied upon the judgment in *Britannia Industries v. ITC Limited* 2017(70) PTC 66 and, in particular, paragraphs 23 to 25 of the judgment wherein the Court concluded that colour combinations stand on a different footing from a trademark or trade name because colours and combinations thereof are not inherently distinctive. By analogy, the second respondent asserted that the colour “orange” is not distinctive and was deployed because the base colour of the product in question is orange.

6. The second respondent also asserted that the cease and desist notice was issued to the predecessor-in-interest of the second respondent, a proprietary concern, on 16.11.2020, and that the present suit and these interim applications were filed after considerable delay. Consequently, it was contended that the applicant is not entitled to interim relief. In conclusion, it was pointed out that the second respondent is an exporter, which has not exported products bearing the impugned label for about 3 years.

7. By way of a brief rejoinder, the applicant asserted that the judgment in *Crompton Greaves* is distinguishable on facts in as much as there was privity of contract between the plaintiff and the first defendant in that case. It was also pointed out that the impugned mark therein was not visible unless the external cover was removed and that those facts had a



material bearing on the outcome. With regard to the board resolution, the applicant pointed out that it is a curable error and should not come in the way of the grant of interim relief. As regards the contention on delay and laches, the applicant relied upon *Midas Hygiene Industries P. Ltd and others v. Sudhir Bhatia and Others* (2004)3 SCC 90 and, in particular, paragraph 5 thereof, and *Hindustan Pencils Pvt. Ltd. v. India Stationery Products Co. and Others* 1989(9) PTC 61 (Delhi) and, in particular, paragraph 40 thereof to contend that interim injunctions should not be declined merely on the ground of delay in instituting actions for infringements.

8. The limited question that arises for consideration is whether the applicant is entitled to interim injunctions either in respect of infringement or passing off. Before delving into the other contentions, the objection on the ground of lack of authorisation is dealt with. The lack of specific approval in favour of the authorised signatory is a defect, which is capable of ratification because it is within the power of the board of directors of the applicant to ratify the same, including with retrospective effect. In my view, any technical defect, which is capable of ratification, does not preclude the consideration of applications for interlocutory relief.



Act, the said provision is extracted below:

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***"56. Use of trade mark for export trade and use when form of trade connection changes.***

*(1) The application in India of trade mark to goods to be exported from India or in relation to services for use outside India and any other act done in India in relation to goods to be so exported or services so rendered outside India which, if done in relation to goods to be sold or services provided or otherwise traded in within India would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods or services for any purpose for which such use is material under this Act or any other law.*

*(2) The use of a registered trade mark in relation to goods or services between which and the person using the mark any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the mark has been or is used in relation to goods or services between which and the said person or a predecessor in title of that person a different form of connection in the course of trade subsisted or subsists."*

10. By relying on this provision, the applicant contended that the application of the mark to the product in India by the first and second

<https://hcservices.ecourts.gov.in/hcservices/> respondents/ defendants constitutes use of the mark in relation to the



relevant goods for all material purposes under the enactment. Before proceeding further, it is relevant to record that the applicant does not allege infringement as regards the word mark and that the grievance is focused on the label mark. The second respondent does not dispute that the mark was applied to the relevant goods in India. Therefore, on a textual reading of Section 56(1), it appears that the legal fiction incorporated therein applies to the facts of this case. The consequences thereof would be that there is deemed use of the mark as per Section 2(2)(c) of the Trade Marks Act. Since such use is admittedly in course of trade, if there is infringement by the application of the mark, the applicant would be entitled to the same remedies as are available to products sold in India. Both Section 29(6)(c) and the judgments cited by the applicant point in the same direction. The second respondent relied on *Crompton Greaves* to contend that it is not liable for infringement or passing off because the product in question is intended exclusively for export to the third respondent in Nigeria, and the third respondent has a registered design copyright in respect of the label in question. In *Crompton Greaves*, this Court dealt with a case wherein the plaintiff had engaged the services of the first defendant therein to manufacture goods for export purposes and in connection therewith to apply the plaintiff's logo, CG, on such goods. Subsequently, it appears that the second defendant therein engaged the services of the first defendant therein



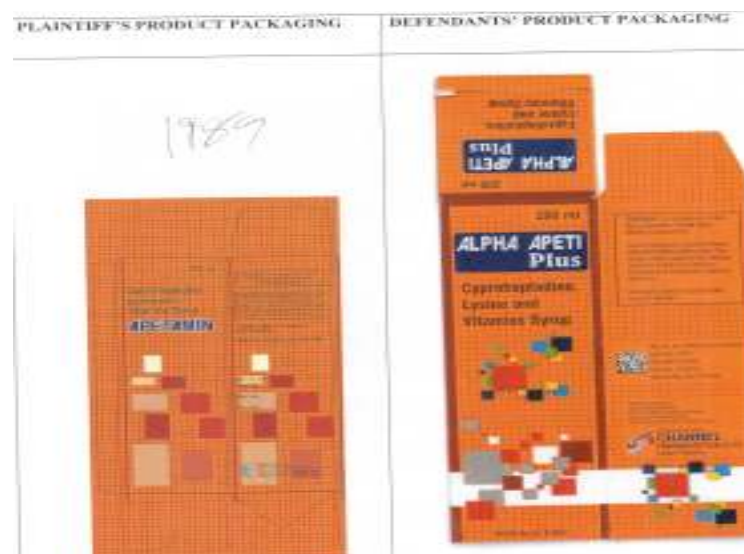
to manufacture products for export to the second defendant by applying the second defendant's registered trademark MCG thereto, which such second defendant had registered in the UK under the applicable trademark legislation. In that factual context, by an interim order, this Court refused to grant interim relief to the plaintiff therein. In course of deciding the application, the Court examined both Section 56 and Section 30(2)(e). It should be noticed that Section 30(2)(e) prescribes that a registered trademark is not infringed by its use by a registered proprietor of a mark in a situation where two or more trademarks, which are identical or which nearly resemble each other, have been registered. On the facts of this case, the admitted position is that the respondents/defendants do not have a registered trademark in India or elsewhere. As such, whether directly or by analogy, the respondents/defendants are not entitled to protection under Section 30(2)(e) of the Trademarks Act.

11. While on this issue, it should be borne in mind that these are proceedings instituted in India by the registered proprietor of a trademark in India, *inter alia*, alleging infringement of such trademark in India. As stated earlier, the applicant is entitled to invoke Section 56(1) because the impugned mark was admittedly applied to products within India. By contrast, in case the first or second respondents/defendants had exported the goods to Nigeria and applied the mark there, Section 56 would not be of any



assistance to the applicant. In my view, once it is concluded that Section 56 applies, the critical aspect to be considered is whether the respondents infringed the applicant's registered trademark or whether the sale of the products in question constitute passing off. This question is considered next.

12. For such purpose, the marks in question should be compared. In matters of this nature, the Court is required to postulate a person of average intelligence and imperfect recollection and examine the registered mark and the impugned mark from the perspective of such person. The marks in question are set out below:



If the marks in question are compared from the above perspective, it is noticeable that the registered label mark of the applicant consists of three elements which should be looked at collectively or in combination. These



three elements are: the orange colour, the checks and the square or rectangular blocks in different colours, which are distinctive when seen in combination. The first and second respondents have adopted a label which also uses these three elements, and this label was adopted subsequently. When viewed as a whole, the two marks appear to be deceptively similar. Therefore, the impugned label *prima facie* infringes the proprietary interest of the applicant.

13. With regard to the relief of passing off, such relief is distinct from the relief of infringement in as much as it is founded on the tort of deceit. Thus, the likelihood of deception is central thereto. Section 27 (2) of the Trademarks Act recognises the common law remedy of passing off as an exception to the rule that statutory rights under the Trademarks Act are not available in respect of unregistered trademarks. In this case, the second respondent states that the products in question are exclusively intended for export to a particular customer, namely, the third respondent in Nigeria. The applicant has not pointed out any instance of sale in India. In those circumstances, the applicant has not *prima facie* satisfied the more stringent requirements for grant of interim relief in respect of passing off. Although the applicant relied on at least two judgments to contend that the legal fiction under Section 56 of the Trade Marks Act extends to the common law



remedy of passing off in view of the use of the expression “or any other law” at the tail of sub-section (1) thereof, the question whether the common law remedy extends by legal fiction to sale in Nigeria by virtue of Section 56 of the Trademarks Act is left open for adjudication in course of final disposal.

14. Accordingly, there shall be an order of interim injunction restraining the respondents from using the impugned mark in India on the products ALPHA APETI PLUS in course of export to Nigeria or otherwise. The applications for passing off and copyright infringement are dismissed.

15. In fine, O.A.No.82 of 2022 is allowed as prayed for. O.A.Nos.78 to 81 are dismissed.

16. List A.No.585 of 2022 and the suit on 25.04.2022.

Sd./- S.K.R.J  
06.04.2022

//Certified to be true copy//

Dated at Madras this the      day of      2022.

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