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

+ **FAO(OS) (COMM) 322/2022**

SUN PHARMA LABORATORIES LTD Appellant

Through: Mr.Sachin Gupta with Ms.Jasleen
Kaur and Ms.Yashi Agrawal,
Advocates.

versus

INTAS PHARMACEUTICAL LTD & ANR. Respondents

Through: Ms.Bitika Sharma with Mr.Lakshay
Kaushik and Ms.Vrinda Pathak,
Advocates.

Date of Decision: 12th December, 2022

CORAM:

HON'BLE MR. JUSTICE MANMOHAN

HON'BLE MR. JUSTICE SAURABH BANERJEE

J U D G M E N T

MANMOHAN, J:

Caveat No.441/2022

Since appearance has been entered on behalf of the respondents,
present caveat stands discharged.

C.M.Nos.53627-53628/2022

Exemption allowed, subject to all just exceptions.

Accordingly, the applications stand disposed of.

FAO(OS)(COMM) No.322/2022 & C.M.No.53629/2022

1. Present appeal has been filed challenging the order dated 22nd November, 2022 passed by the learned Single Judge of this court in CS(COMM) 688/2022 whereby Appellant-Plaintiff's application under Order XXXIX Rules 1 & 2, CPC was dismissed on the ground that the two marks in question are not phonetically or visually similar.
2. Learned counsel for the Appellant-Plaintiff states that the Appellant-Plaintiff and the Respondents-Defendants launched their medicines around the same time i.e. June-July, 2022 after expiry of the patent protection granted to the anti-diabetic drug 'Sitagliptin'. He states that the Appellant-Plaintiff's trademark "SITARED" and the Respondents-Defendants' mark "SITARA" are derived from the salt 'Sitagliptin' and the registration applications of the marks of both the parties are currently pending registration. He further states that the Respondents-Defendants are using an additional letter 'D' as a suffix with its primary mark "SITARA" to indicate the presence of an additional secondary salt 'Dapagliflozin' and therefore trading its medicine under the name "SITARA-D".
3. Learned counsel for the Appellant-Plaintiff states that the Respondents-Defendants' mark "SITARA-D" is deceptively similar to two of the Appellant-Plaintiff's trademarks namely "SITARED" (which is not registered) and "SETARET" (which though registered in 1998, yet has not been used by the Appellant-Plaintiff). He states that even though the Respondents-Defendants claim that its mark "SITARA-D" is not deceptively similar to the mark of the Appellant-Plaintiff's by virtue of the hyphen (-) in between its primary mark "SITARA" and the letter 'D', yet in light of human error when the impugned mark is written without the

hyphen (-), “SITARA-D” would become “SITARAD” which is similar to the Appellant-Plaintiff’s marks “SITARED” or “SETARET”. He points out that the Appellant-Plaintiff does not have any objection to the use of the Respondents-Defendants’ mark “SITARA” and is only opposing the use of the letter ‘D’ as a suffix to the primary mark. He suggests that the Respondents-Defendants instead of using the mark “SITARA-D”, should use the mark “SITARA-DAP” and/or “SITARA-DAPA”.

4. Learned counsel for the Appellant-Plaintiff submits that the test of deception in a pharmaceutical product is more stringent and any possibility of confusion is to be avoided as it can lead to disastrous consequences. In support of his submission, he relies on the decision of the Supreme Court in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd, (2001) 5 SCC 73*.

5. Learned counsel for the Appellant-Plaintiff states that the learned Single Judge erred in holding that the Appellant-Plaintiff cannot claim an *ad-interim* order of injunction based on its registered trademark “SETARET” as it had never been used by the Appellant-Plaintiff or its predecessor-in-interest. He states that till date, the Appellant-Plaintiff’s registration in the mark “SETARET” is valid and subsisting and therefore the Appellant-Plaintiff is a deemed user and entitled to statutory protection and is not required to show use. In support of his submission, he relies on the decision of the Supreme Court in *Gujarat Bottling Co. Ltd. V. Coca Cola Co. (1995) 5 SCC 545* and the Bombay High Court in *Wockhardt Ltd. vs Eden Healthcare Pvt. Ltd. 2014 SCC OnLine Bom 163*.

6. Per contra, learned counsel for the Respondents-Defendants, who appears on advance notice, states that the Respondents-Defendants are the

prior adopter of the mark “SITARA”. In support of her contention, she relies upon the letter of Drug Approval dated 04th February, 2022. She states that “SITARA-D” is the natural progression of the mark “SITARA” as and when the additional secondary salt ‘Dapagliflozin’ is used.

7. Having heard learned counsel for the parties, this Court is of the view that though the Appellant-Plaintiff’s mark “SETARET” is registered, yet the same has not been used for more than twenty four years. There is also a dispute as to who is the prior user. This Court is of the prima facie opinion that prior registration of the mark without the use of the mark for over twenty-four years would not entitle the appellant to an interim injunction.

8. This Court is further in agreement with the view of the learned Single Judge that the marks in question cannot be appropriated by any party as they are based on their active ingredients which are generic. In any event there is not much of a time difference in the first usage of the marks between both the parties. In fact, there are no equities in favour of either of the parties as both are generic drug manufacturers who have started manufacturing the drug in question as soon as the patent of the original inventor had lapsed. If the appellant-plaintiff is of the view that the marks in question are causing confusion, it is open to the appellant-plaintiff to change its marks at this prima facie stage!

9. The Supreme Court in ***Wander Ltd and Anr. v. Antox India P. Ltd., 1990 (supp) SCC 727*** has held that in appeals against the exercise of discretion by the learned Single Judge, the Appellate Court will not interfere with the exercise of such discretion of the court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily or capriciously or perversely or

where the court had ignored the settled principle of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle.

10. In view of the aforesaid parameters, this Court finds no ground to interfere with the impugned order at the interim stage. Accordingly, the present appeal along with pending application is dismissed.

MANMOHAN, J

SAURABH BANERJEE, J

DECEMBER 12, 2022
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