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

+ CS(COMM) 665/2021 and IA 16858/2021 (Order XXXIX Rules 1 and 2 of the CPC)

USV PRIVATE LIMITED

..... Plaintiff

Through: Mr. Prithvi Singh and Mr. Prithvi Gulati, Advs.

Versus

MASCOT HEALTH SERIES

PVT. LTD. AND ANR.

..... Defendants

Through: None

CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR

JUDGMENT (ORAL)

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01.08.2022

CS(COMM) 665/2021 & IA 6517/2023 (Order XIII-A, Rule 3 & 6(1)(A) read with Section 151 of the CPC)

1. So stark a case of infringement and passing off is the present, that this Court does not find it surprising that the defendants ultimately chose not to continue to prosecute their defence against the suit.

2. The plaintiff manufactures and sells rosuvastatin tablets, for treating of high cholesterol levels, under its registered trademark "ROSEDAY". The defendants also manufacture and sell rosuvastatin tablets under the brand name "ROSUDAY". The plaintiff seeks, therefore, by the present suit, an injunction against the defendants from using the impugned mark "ROSUDAY". The defendant had



applied for registration of its “ROSUDAY” trademark, but it does not appear that it has succeeded in securing registration as the Registry, citing the plaintiff’s ROSEDAY trademark, objected to the defendants’ application under Section 11(1)¹ of the Trademarks Act, 1999.

3. The suit was accompanied by IA 16858/2021, seeking interlocutory injunctive relief under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC).

4. Summons were issued in the suit and an *ex parte ad interim* injunction, restraining the defendants from using the impugned ROSUDAY trademark, was granted by this Court on 16 December 2021. Defendant 1 did not file any written statement in response to the suit, or reply to IA 16858/2021, and its right to file written statement was closed on 5 August 2022. Defendant 2 filed a written statement with an application for condonation of delay. On 8 December 2022, this Court dismissed the application for condonation of delay and struck the written statement off the record. That decision has remained unchallenged. There is, therefore, no written statement on record either by Defendant 1 or by Defendant 2.

5. Defendant 2 did, however, file a reply to IA 16858/2021.

¹ 11. **Relative grounds for refusal of registration.** –

- (1) Save as provided in Section 12, a trade mark shall not be registered if, because of—
 - (a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or
 - (b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,
 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.



6. The defendants have remained absent after 15 December 2022, though the case was listed four times. Notice was issued to learned Counsel for the defendants at their addresses as well as by email and by WhatsApp, there is, however, no appearance on their behalf.

7. In these circumstances, the plaintiff has moved IA 6517/2023 under Order XIII-A Rule 3² & 6(1)(A) read with Section 151 of the CPC, as amended by the Commercial Courts Act 2015, submitting that the defendants have no credible defence to offer and, therefore, seeking summary judgment in the suit. Notice on the present application was issued by this Court on 10 April 2023. Over 30 days since then have passed, as stipulated in Order XIII-A Rule 1(3) of the CPC, no reply is forthcoming.

8. Where the defendant has no real prospect of successfully defending the claim set up by the plaintiff, and there is no other compelling reason why the claim should not be disposed of without recording oral evidence, the Court may, under Order XIII-A Rule 3 of the CPC, give a summary judgment against the defendant. Expeditious disposal of commercial claims is the very *raison d'être* of the Commercial Courts Act and, therefore, where a case for issuing summary judgment is made out on the facts, the Court must not hesitate to do so.

² **3. Grounds for summary judgment.** – The court may give a summary judgment against a plaintiff or defendant on a claim if it considers that –

- (a) the plaintiff has no real prospect of succeeding on the claim or the defendant has no real prospect of successfully defending the claim, as the case may be; and
- (b) there is no other compelling reason why the claim should not be disposed of before recording of oral evidence.



9. What has to be seen, therefore, is whether the defendant has any real prospect of successfully defending the claim set up by the plaintiff.

10. The plaintiff is a reputed pharmaceutical company with an income in the years 2020-2021, for ₹ 3735 crores. It claims to have conceived and adopted the brand ROSEDAY, for its rosuvastatin tablets in April 2009. The mark ROSEDAY was registered in the plaintiff's favour w.e.f. 25 May 1999 in Class 5 in respect of "medicinal, pharmaceutical and veterinary preparations". The plaintiff asserts that the mark "ROSEDAY" is an arbitrary and coined word, unique to the plaintiff's product and having no dictionary or other etymological connotation.

11. Since it launched in 2009, sales of ROSEDAY have garnered returns of over ₹ 950 crores and, in 2020-2021 alone, the plaintiff had earned over ₹ 160 crores through sale of ROSEDAY. The plaintiff, therefore, submits that ROSEDAY is a mark, which is indelibly associated, in the psyche of the consumer, with the plaintiff and with no one else.

12. The defendant also makes and sells rosuvastatin tablets under the mark ROSUDAY. Packages of the tables sold by the defendants reveal that Defendant 1 manufactures the product and Defendant 2 markets it. Defendant 2 is stated to have also applied for registration of ROSUDAY as a trademark on 12 November 2020 on "proposed to be used" basis. As such, the plaintiff asserts that, in fact, ROSUDAY



was not launched in the market by the defendants at any time much prior to April 2021.

13. On the ground that the marks ROSEDAY and ROSUDAY are phonetically, visually and structurally similar to each other, the plaintiff alleges infringement, by the defendants, of the plaintiff's trademark as well as an attempt of the defendants to pass off its products as those of the plaintiff.

14. The plaintiff has, therefore, in these circumstances, instituted the present suit before this Court, seeking a decree of permanent injunction, restraining the defendants as well as all others acting on their behalf from manufacturing or selling any product using the mark ROSUDAY or any other mark which is deceptively similar to the plaintiff's registered ROSEDAY trademark.

15. As already noted, the only defence available on record is in the form of reply filed by Defendant 2 to IA 16858/2021. Defendant 2 has, in the said reply, advanced only three contentions. The first is that there is no similarity between the plaintiff's and defendants' packs. The second is that ROSEDAY and ROSUDAY are not phonetically similar. The third is that the plaintiff cannot claim a monopoly over the trademark ROSEDAY as it is derived from the name of the compound constituting its Active Pharmaceutical Ingredient (API), namely, rosuvastatin.



16. None of these submissions can sustain either on facts or in law. Insofar as the phonetic similarity is concerned, it is quite obvious that ROSEDAY and ROSUDAY are phonetically similar. The only difference between the two is that central letter in one is “E” and the second is “U”. That distinction makes no perceptible difference to the manner in which the two words are pronounced. Indeed, unless they were intoned extremely slowly, it would be extremely difficult to distinguish between the two names. On the aspect of photonic similarity, therefore, the defence put up by Defendant 2 in its reply to IA 16858/2021 is completely bereft of substance.

17. Where the two marks are so phonetically similar, the mere fact that the packs in which the goods are sold may be different in appearance, would not affect the aspect of infringement. This position stands crystallized by the decisions of the Supreme Court in *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*³ and *K.R. Chinna Krishna Chettiar v. Sri Ambal & Co.*⁴

18. *Kaviraj*³ – as the decision is often fondly referred to – lucidly expounded the applicable principles thus:

“28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a

³ AIR 1965 SC 980

⁴ AIR 1970 SC 146



passing off by the use of the same mark. The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods" (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, *if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.*



29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's, mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. *When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered* (Vide Section 21). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. *This has necessarily to be ascertained by a comparison of the two marks - the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff.*"

(Emphasis supplied)

19. **K.R. Krishna Chettiar**⁴ involved two device marks, which were, as is categorically observed in the decision, visually totally dissimilar. Both were used for snuff. The textual matter in one was "Shri Andal"; in the other, "Shri Ambal". So phonetically similar was the textual



matter in the rival marks – which constituted their essential feature – that the Supreme Court held the visual dissimilarity between them to be of no consequence. Thus ruled the Supreme Court:

“5. Now the words “Sri Ambal” form part of trade mark no. 126808 and are the whole of trade mark no. 146291. There can be no doubt that the word “Ambal” is an essential feature of the trade marks. The common “Sri” is the subsidiary part, of the two words “Ambal” is the more distinctive and fixes itself in the recollection of an average buyer with imperfect recollection.

6. The vital question in issue is whether, if the appellant's mark is used in a normal and fair manner in connection with the snuff and if similarly fair and normal user is assumed of the existing registered marks, will there be such a likelihood of deception that the mark ought not to be allowed to be registered (see *In the matter of Broadhead's Application for registration of a trade mark*⁵). It is for the court to decide the question on a comparison of the competing marks as a whole and their distinctive and essential features. We have no doubt in our mind that if the proposed mark is used in a normal and fair manner the mark would come to be known by its distinguishing feature “Andal”. There is a striking similarity and affinity of sound between the words “Andal” and “Ambal”. Giving due weight to the judgment of the Registrar and bearing in mind the conclusions of the learned Single Judge and the Divisional Bench, we are satisfied that there is a real danger of confusion between the two marks.

7. There is no evidence of actual confusion, but that might be due to the fact that the appellant's trade is not of long standing. There is no visual resemblance between the two marks, but ocular comparison is not always the decisive test. The resemblance between the two marks must be considered with reference to the ear as well as the eye. There is a close affinity of sound between Ambal and Andal.

8. In the case of *Coca-Cola Co. of Canada v. Pepsi Cola Co. of Canada Ltd.*⁶, it was found that cola was in common use in Canada for naming the beverages. The distinguishing feature of the mark Coca Cola was coca and not cola. For the same reason the distinguishing feature of the mark Pepsi Cola was Pepsi and not cola. It was not likely that anyone would confuse the word Pepsi with coca. In the present case the word “Sri” may be regarded as in

⁵ (1950) 57 RPC 209, 214

⁶ 1942 59 RPC 127



common use. The distinguishing feature of the respondent's mark is Ambal while that of the appellant's mark is Andal. The two words are deceptively similar in sound.

9. *The name Andal does not cease to be deceptively similar because it is used in conjunction with a pictorial device.* The case of *De Cordova & Ors. v. Vick Chemical Co.*⁷ is instructive. From the appendix printed at page 270 of the same volume it appears that Vick Chemical Company were the proprietors of the registered trade mark consisting of the word "Vaporub" and another registered trade mark consisting of a design of which the words "Vicks Vaporub Salve" formed a part. The appendix at p. 226 - shows that the defendants advertised their ointment as 'Karsote vapour Rub'. It was held that the defendants had infringed the registered marks. Lord Radcliffe said: ". . . a mark is infringed by another trader if, even without using the whole of it upon or in connection with his goods, he uses one or more of its essential features."

(Emphasis supplied)

20. Thus, once the rival marks ROSEDAY and ROSUDAY are found to be phonetically deceptively similar, other ancillary features regarding the manner in which the marks are depicted on the respective packs/strips, and the like, recede into insignificance.

21. The sole surviving contention of Defendant 2 is that, as name of the plaintiff's product has been derived from rosuvastatin, i.e. API, the plaintiff cannot claim exclusivity. This submission, too, cannot sustain for the simple reason that the claim of the plaintiff's product is not entirely based on the API, but also contains a distinctive suffix "DAY". It is not the defendants' contention that the "DAY" suffix is *publici juris*. The submission of the defendant that "DAY" refers to the manner in which the drug is to be administered, is not supported by any cogent material. Even if, *arguendo*, the suffix "DAY" were to

⁷ 1951 68 RPC 103



be treated as representing the manner in which the drug is to be administered, the combination of “ROSE” and “DAY” is, nonetheless, inventive and unique, and the plaintiff has every right to claim exclusivity in that regard.

22. In any case, in the considered opinion of this Court, the defendants have, in adopting the mark ROSUDAY, sought to capitalize on the plaintiff’s goodwill and reputation. It is difficult to believe that the mark ROSUDAY could have been conceived by the defendants unaware of the existence of the prior mark ROSEDAY.

23. As such, I am of the opinion that the defendants are required to pay punitive damages to the plaintiff, as their attempt to copy the plaintiff’s trademark is clearly unwholesome and the defendants have not chosen to prosecute the present suit either.

24. For the aforesaid reasons, the plaintiff is entitled to succeed. The suit is decreed in the following terms:

(i) There shall, therefore, be a decree of permanent injunction, restraining the defendants as well as all others acting on their behalf from manufacturing, selling, advertising or in any other manner using the mark ROSUDAY or any other mark, which is deceptively similar to the plaintiff’s registered mark ROSEDAY, either by rosuvastatin tablets or for any other pharmaceutical preparation(s).

(ii) Each of the defendants shall be liable to pay, to the plaintiff, damages of ₹ 2 lakhs, to be paid by way of crossed



cheques within a period of four weeks from the date of uploading of this judgment on the website of this Court.

(iii) The plaintiff shall also be entitled to actual costs of this suit, for which purpose, the plaintiff may present a bill of costs setting out the costs incurred by it before the concerned Taxation Officer appointed by this Court. For the said purpose, let the matter be placed before the concerned Taxation Officer on 15 September 2023.

25. The suit stands decreed in the aforesaid terms.
26. Let the decree-sheet be drawn up accordingly.
27. Miscellaneous applications also stand disposed of.

C.HARI SHANKAR, J

AUGUST 1, 2023

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