

* IN THE HIGH COURT OF DELHI AT NEW DELHI

Reserved on: 03.02.2023

Date of decision: 23.03.2023

+ **CS(COMM) 353/2018 & CCP(O) 41/2010, IA 1241/2015**

MODI-MUNDIPHARMA PVT. LTD. Plaintiff

Through: Mr.Pravin Anand,
Ms.Prachi Agarwal,
Ms.Mishthi Dubey,
Advs.

versus

PREET INTERNATIONAL PVT. LTD& ANR. Defendants

Through: Mr.Gagan Gupta,
Mr.Deepak Jain,
Mr.Ananta Prasad
Mishra, Advs. for D-2.

CORAM:

HON'BLE MR. JUSTICE NAVIN CHAWLA

1. This suit has been filed by the plaintiff praying for the following reliefs:

“a) An order for permanent injunction restraining the Defendants, its partners or proprietor, as the case may be, its offices, servants, and agents from reproducing on the label or packaging of their product, the trademark FEMICONTIN or any other trademark deceptively similar to the Plaintiffs trademark FECONTIN-F or from using the Plaintiffs registered trademark CONTIN amounting to an infringement of the Plaintiff’s registered trademarks bearing No. 518596 & 518594 respectively in class 5.

b) An order for Permanent Injunction restraining the defendants, its partners or proprietor, as the case may be, its offices, servants, and agents from manufacturing, selling, offering for sale advertising, directly or indirectly dealing in medicinal and pharmaceutical preparation in packaging bearing Trademark FEMICONTIN which is identical or deceptively similar to the Plaintiff’s CONTIN series of marks and the trademark FECONTIN-F or from doing any

other act which would amount to passing off of the Defendant's goods or business as the goods and business of the Plaintiff.

c) An order for delivery up of all the goods bearing the impugned mark, dies, cartons, labels, packaging and any other infringing material to the authorised representative of the Plaintiff for the purposes of destruction /erasure;

d) Direct the Defendants to pay a sum of Rs. 48,00,000/- towards damages which is the estimated loss of sales by the Plaintiff as also the loss of reputation owing to the illegal activities of the Defendants.

e) An order for rendition of accounts of profits of the Defendants on account of sales of the medicines bearing the trademark FEMICONTIN and for any other products bearing the Plaintiff's Trademarks and the sum due paid to Plaintiff.

f) An order directing the Department of Drugs Control Administration, Government of Andhra Pradesh to cancel the Drug manufacturing licence of Defendant No. 1."

PLEADINGS

2. It is the case of the plaintiff that the plaintiff company is the proprietor of a family of trade marks bearing the word **CONTIN** as the common feature in the same. The said trade mark **CONTIN** is also registered under No. 518594 in Class 5 in favour of the plaintiff since 19.10.1989. The subject mark **FECONTIN-F** is also registered in favour of the plaintiff under No.518596 in Class 5. The plaintiff claims that it has been using the said trade mark for its product since March 1993. The plaintiff states the sale figures and the advertisement figures, and claims that by virtue of long, continuous and extensive user of the said trade mark throughout India since the year 1993, the plaintiff has acquired tremendous goodwill and reputation in the said mark.

3. The plaintiff is aggrieved of the adoption of the mark **FEMICONTIN** by the defendant no.2. The plaintiff claims that the said mark is deceptively similar to the plaintiff's **CONTIN** family/series of marks and more particularly the trade mark **FECONTIN-F**.
4. The plaintiff claims that it first acquired the knowledge of the adoption and use of the said mark by the defendant no.2 in July, 1999. It issued a cease-and-desist notice dated 10.07.1999 to the defendant no.2. At that time, the pharmaceutical drug with the impugned name was being manufactured by one 'M/s Eubiotics Pharmaceuticals' at Hyderabad, who by its reply dated 03.08.1999, refused to acknowledge the proprietary rights of the plaintiff in the said marks.
5. The plaintiff claims that its agents thereafter informed the plaintiff that the pharmaceutical product with the trade mark **FEMICONTIN** was not being marketed and, therefore, the plaintiff believed that 'M/s Eubiotics Pharmaceuticals' and the defendant no.2 had stopped manufacturing and marketing the pharmaceutical products under the trade mark **FEMICOTIN**.
6. The plaintiff claims that sometime in March, 2001, the plaintiff came across pharmaceutical products manufactured and marketed under the impugned trade mark **FEMICONTIN**, whereafter, in 2002, the plaintiff instituted a Civil Suit in the learned District Court of Hyderabad, which was last numbered as O.S. No.33/2004, praying for a decree of permanent injunction against the defendant no.2 and 'M/s Eubiotics Pharmaceuticals', apart from other reliefs from using the impugned mark.

7. It is further claimed that the defendant no.2 in its written statement filed before the learned District Court of Hyderabad claimed that it was not selling its pharmaceutical products under trade mark **FEMICONTIN** in Andhra Pradesh, but was selling the same in Rajasthan, New Delhi, Maharashtra, Himachal Pradesh and some parts of Uttar Pradesh. The defendant no.2 therefore, disputed the territorial jurisdiction of the Court at Hyderabad. On such objection, the plaintiff withdrew the said suit on 23.08.2004, with liberty to re-file the same before the Court of appropriate jurisdiction.
8. The plaintiff claims that on withdrawing the said Civil Suit, the plaintiff filed a suit at Delhi, being CS(OS) No.577/2005, wherein an *ex parte ad interim* injunction against the defendants, restraining them from using the trade mark **FEMICONTIN** or any other trade mark deceptively similar to the plaintiff's **CONTIN** series of trade marks was passed on 24.05.2005.
9. On 22.05.2007, the plaint was, however, ordered to be returned on the ground that the plaintiff had arbitrarily valued the suit in order to bring the same within the pecuniary jurisdiction of this Court.
10. An appeal against the said order, being FAO(OS) No.476/2006, was withdrawn on 30.08.2006, reserving liberty to move an appropriate application before the learned Single Judge.
11. The plaintiff thereafter, filed an application under Order VI Rule 17 of the Code of Civil Procedure, 1908 (hereinafter referred to as 'CPC') seeking amendment of its plaint and later also filed a review petition under Order XLVII Rule 1 read with Section 114 and 151 of the CPC, being Review Application No. 07/2007.

12. During the pendency of the above application/petition, the plaintiff filed the present suit.
13. The earlier suit, being CS(OS) No. 577/2005, and the review petition therein were withdrawn on 12.11.2007.
14. The plaintiff claims that the adoption of a deceptively similar mark by the defendants not only amounts to infringement and passing off, but also dilution of the reputation of the family /series of trade marks belonging to the plaintiff.
15. In the written statement filed by the defendant no.1, it was claimed that it manufactured the pharmaceutical products under the impugned trade mark **FEMICONTIN** only from November/December, 2005 till September/October, 2007.
16. The defendant no.1 stopped appearing in the present suit and it is only the defendant no.2 which has contested the present suit.
17. As far as the defendant no.2 is concerned, in its written statement, it claimed that the word **CONTIN** is not invented by the plaintiff and is derived from the dictionary word 'CONTINUE', which means "to go on happening or moving". The defendant no.2 claims that the trade mark **CONTIN** is, therefore, descriptive in nature and no exclusive right therein can be claimed as a prefix or a suffix.
18. The defendant no.2 further claimed that though the trade mark **CONTIN** has been registered, there is no user of the same and no product with the said trade mark is available in the market.
19. The defendant no.2 further stated that the products of the plaintiff and the defendant no.2 are distinct; while the plaintiff's products contains Ferrous Glycine Sulphate equivalent to 100 mg Ferrous Iron and Folic Acid I.P.0.5 mg., the defendant no.2's product

FEMICONTIN contains Ferrous Fumarate IP-200 mg. (in sustained release form), Zinc Sulphate Monohydrate-61.8 mg (in sustained release form), Cyanocobalamin I.P. -10 mcg. and Folic Acid-1.5 mg.

20. The defendant no.2 further claims that the pharmaceutical products are Schedule 'H' drugs under the Drug and Cosmetic Rules, 1945 and as per the Rules cannot be sold without a prescription. Therefore, there is no likelihood of confusion being caused.
21. Most importantly, the defendant no.2 denied that the suit before the learned District Court of Hyderabad was filed in 2002. Placing reliance on the contents of the certified copy of the plaint filed in the said suit and the affidavit filed in the said suit, the defendant no.2 claimed that the said suit was filed only in the year 2004 as it makes reference to events of 2004. It is claimed by the defendant no.2 that as the plaintiff itself has stated that it gained knowledge of the use of the impugned trade mark **FEMICONTIN** in 1999, there was considerable delay in filing of the suit before the learned District Court at Hyderabad, and on this ground alone, the plaintiff is not entitled to any relief.
22. As far as the claim of passing off is concerned, the defendant no.2 stated that the marks are not similar. The letters 'FE' are derived from Ferrous Fumarate, which is an ingredient of the drug and is useful for pregnant women. The word 'FEMI', which indicates 'Female', is derived by adding letters 'MI' to 'FE'. The word **CONTIN** is derived from the dictionary word 'CONTINUES', and, therefore, the trade mark **FEMICONTIN** means and indicates a drug which releases iron continuously in a

sustained release manner into the body of pregnant women to avoid normal side effects and improves the quality of blood by increasing Red Blood Cells (in short, 'RBCs'). The defendant no.2 claims that, therefore, the trade mark of the defendant no.2 is based on generic words and the trade mark of the plaintiff and the defendant no.2 are neither structurally, visually or phonetically similar to each other.

23. The defendant no.2 also highlighted the difference in the packaging of the two marks.
24. The defendant no.2 further claimed that there are various other marks with the prefix 'FE', a list whereof has been provided by the defendant no.2 in its written statement.

ISSUES

25. Based on the pleadings of the parties, this Court by its order dated 21.11.2011, framed the following issues:

- “1. Whether this court has no jurisdiction to try and entertain the present suit? *OPD*
2. Whether the present suit is liable to be dismissed on account of delay, laches and/or acquiescence? *OPD*
3. Whether the present suit is barred by virtue of Section 11 of the Code of Civil Procedure, 1908? *OPD*
4. Whether the plaintiff is the registered proprietor of the trade mark FECONTIN-F and the trade mark CONTIN/CONTIN family of trademarks in relation to its goods/services? *OPP*
5. Whether the defendants have infringed the registered trademarks FECONTIN-F and CONTIN of the plaintiff? *OPP*
6. Whether the use of the deceptively similar mark FEMICONTIN by the defendants amounts to passing off? *OPP*
7. Whether the plaintiff is entitled to permanent injunction as prayed for? *OPP*
8. Whether the plaintiff is entitled to damages as prayed for? *OPP*

9. *Whether the plaintiff is entitled to delivery up of materials and rendition of accounts? OPP*
10. *Relief."*

EVIDENCE

26. The plaintiff, in support of its claim examined PW-1- Mr.Rajiv Behl, while the defendant no.2 examined Mr.Prem Prakash Bhardwaj, its Director, as DW-1.

INTERIM ORDER

27. Before recording the submissions of the learned counsels for the parties, it would also be relevant to note herein that by an order dated 03.12.2009, an *interim* order restraining the defendants from using the trade mark **FEMICONTIN** was passed in favour of the plaintiff. However, on an appeal filed by the defendant no.2, being FAO(OS) No.197/2010, the operation of the said order was stayed on 16.04.2010 and, thereafter, by an order dated 10.01.2013, the stay on the order dated 03.12.2009 was directed to continue during the pendency of the present suit.

SUBMISSION ON BEHALF OF THE PLAINTIFF.

28. The learned counsel for the plaintiff has submitted that in view of the prior use of the mark **FECONTIN-F** and its registration, along with the registration of the trade mark **CONTIN**, which is a family mark of the plaintiff, the plaintiff has been able to establish that it is a proprietor of the mark **CONTIN** and **FECONTIN-F**.
29. He submits that the mark of the defendant no.2, that is, **FEMICONTIN**, is deceptively similar to the marks of the plaintiff, thereby making the defendant no.2 guilty of infringement, passing off and dilution of the mark of the plaintiff.

He submits that the fact that the price of the medicine of the

defendant is much lower than that of the plaintiff would not be material to or offer any defence to the defendants. Similarly, the contention that the products being Schedule 'H' drugs, also does not reduce the chances of confusion and deception.

30. He submits that the plea of the defendant that the word **CONTIN** has been derived from the dictionary word 'CONTINUES' and 'FE' represents 'Ferrous', thereby the mark of the plaintiff being descriptive in nature, is also incorrect. He submits that for judging whether the mark of the plaintiff is descriptive, the Court cannot bifurcate the mark into various parts, but is to consider the mark as a whole.
31. He submits that even otherwise, the defendant having applied for registration of the mark **FEMICONTIN**, is estopped from contending that the word **CONTIN** is a generic expression.
32. He submits that merely by contending that there are other companies marketing their products with the suffix 'FE', the subject mark would not become *publici juris*.
33. On the question of delay and laches, the learned counsel for the plaintiff submits that in the year 1999, the plaintiff was informed that the defendants' products are not available in the market. It was only in 2001 that the plaintiff became aware of the presence of the product of the defendant in the market, and the plaintiff immediately thereafter, in 2002, filed a Civil Suit in the District Court at Hyderabad. Merely because the suit was re-numbered as OS 33/2004, due to change of the name of the manufacturer manufacturing the products for the defendant no.2, it cannot be said that the suit was filed only in 2004. He submits that the fact that the suit has been filed in 2002 is also evident from the stamp

on the documents relating to the said suit filed on record of the present suit.

34. He submits that even otherwise, mere delay is not a ground for refusal of injunction. For acquiescence, it has to be shown that the plaintiff allowed the defendants to believe that it has no objection to the use of the impugned mark by the defendant. He submits that no such case has been made out by the defendant. Placing reliance on the judgment of the Supreme Court in *Midas Hygiene P. Ltd. & Anr. v. Sudhir Bhatia & Ors.*, 2004 (28) PTC 121 (SC), and of this Court in *Colgate Palmolive Company & Anr. v. Anchor Health and Beauty Care Pvt. Ltd.*, 2003 (27) PTC 478 (Del), he submits that where the adoption of the mark by the defendant is not *bona fide*, delay itself cannot act as a defence. He submits that even otherwise, for claiming acquiescence, it has to be shown that the plaintiff allowed the defendants to believe that it has no objection to the use of the mark by the defendant. He submits that no such case can be alleged against the plaintiff in the present suit.

SUBMISSION ON BEHALF OF THE DEFENDANT NO.2

35. On the other hand, the learned counsel for the defendant no.2 submits that the defendant no.2 does not press Issue No.1.
36. As far as Issue no.2, is concerned, he submits that the suit filed before the learned District Court at Hyderabad refers to events of the year 2004, clearly revealing that the same could have been filed only thereafter and not in 2002 as claimed by the plaintiff.
37. He submits that in reply to the notice dated 10.07.1999, the defendant had refused the claim of the plaintiff of being the proprietor of the mark or being entitled to an injunction against

the defendant. The cause of action, therefore, arose in 1999 and the suit filed in 2004 itself was belated.

38. The claim of the plaintiff that the defendant no.2 was not selling its product in the market is also incorrect as the DW-1 has stated the sale figures for the period 1999 to 2013 in his affidavit of evidence. He submits that, therefore, on account of delay, acquiescence, laches and suppression of material facts itself, the plaintiff is not entitled to any relief.
39. Taking the year of filing of the suit as 2004, the learned counsel for the defendant no.2 has contended that the plaintiff is not entitled to any relief, having acquiesced for a continuous period of five years in the use of the mark by the defendant no.2. He places reliance on Section 33 of the Trade Marks Act, 1999 (hereinafter referred to as 'the Act') and on the judgments of the Supreme Court in *M/s Power Control Appliances & Ors. v. Sumeet Machines Pvt. Ltd.* (1994) 2 SCC 448 and *Khoday Distilleries Ltd. (now known as Khoday India Ltd.) v. Scotch Whisky Association & Ors.*, (2008) 10 SCC 723.
40. On merits, he submits that the mark of the plaintiff **FECONTIN-F** is a combination of the letters 'FE', which is a generic word for 'Ferrous', that is, iron, and **CONTIN**, derived from the words 'CONTINUE' or 'CONTINUOUS', which is a common dictionary word and descriptive in character. It has a direct link with the disease for which the medicine is used, that is, deficiency of iron. The use of the word **CONTIN** describes that the drug has a continuous release in the body. He submits that such a combination of generic and descriptive words cannot be monopolized and this is a general practice in the trade of

medicine. He submits that even if such a mark is registered, it will amount to an invalid registration. He submits that the defendant no.2 has, in fact, filed applications seeking cancellation of such registrations, which are pending adjudication.

41. He submits that the plaintiff has admitted that it is not using the mark **CONTIN** *per se* for any of its products. He submits that for this reason alone, the said mark is liable to be removed from the Register of Trade Marks.
42. He submits that the marks of the plaintiff and the defendants are, in any case, different; there is also a difference in the packaging of the products, therefore, there is no likelihood of any confusion being caused.
43. The learned counsel for the defendant no.2 further submits that barring a short period, there has been no injunction against the defendant no.2 from using the impugned mark **FEMICONTIN**. He submits that there is no evidence of any confusion or deception being caused by the user of the mark by the defendant no.2 during all this period.

ANALYSIS AND FINDINGS

44. I have considered the submissions made by the learned counsels for the parties.

ISSUE NO.1

45. As noted hereinabove, the learned counsel for the defendant no. 2 has not pressed the said issue. It is, therefore, answered as not pressed.

ISSUE NO.2

46. On the question of delay and laches and/or acquiescence, the plaintiff in its plaint admits that it gained knowledge of the use of the impugned mark **FEMICONTIN** by the defendant no.2 in the year 1999. It also issued a cease-and-desist notice dated 10.07.1999. In the reply dated 03.08.1999, 'M/s Eubiotics Pharmaceuticals' expressed its unwillingness to acknowledge proprietary rights of the plaintiff.
47. The plaintiff claims that thereafter it was informed that the pharmaceutical products with the impugned mark of the defendant no.2 were not available in the market. This is strongly refuted by the defendant no.2, and DW-1 in his affidavit, has stated that defendant no.2 has been continuously using the impugned trade mark since the year 1999. DW1, in his affidavit, has also given the sale figures and the advertising expenses for the said mark from 1999-2000 till 2012-13.
48. The plaintiff claims that it gained knowledge of the use of the impugned trade mark by the defendant no.2 again in March, 2001, whereafter, it instituted a Civil Suit in the learned District Court of Hyderabad in 2002. While the plaintiff claims that the suit was renumbered as OS No.33/2004 due to change of the manufacturer manufacturing the product with the impugned mark, the defendant no.2 claims that the suit was filed only in 2004 as it refers to the events of 2004 in the body of the plaint. In this regard, reliance is placed on paragraphs 7 and 10 of the plaint before the learned District Court of Hyderabad, a certified copy of which has been placed on record by the defendant no.2 as Ex.PW-1/D1, reproduced hereinbelow:

*"7. In the month of January 2004,
representative of the Plaintiff came across the*

defendant's pharmaceutical product bearing the trademark FEMICONTIN relating to the same class of goods as that of the Plaintiff containing Dried Ferrous Sulphate I.P. 150 mg, Zinc Sulphate Monohydrate U.S.P. 61.8 mg, Cyanocobalamin I.P. 1.2 mcg, Folic Acid 1.2 mg with Vitamin B12 capsules. The said product is stated to be a sustained release capsules. Using the mark FEMICONTIN, amounts to infringement of the statutory trademark rights of the plaintiff and is likely to confuse the prospective buyers, who will associate the same as the product of the Plaintiff thereby passing off their product as those of the Plaintiff. The continued business of the defendants is pure infringement and is involving in the manufacture and marketing of the drug FEMICONTIN, which is causing untold loss of reputation to the plaintiff. Thus the plaintiff is compelled to institute the present proceedings.

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10. The cause of action in the present suit first arose in the month of January 2004 when it came to the attention of the Plaintiff that the defendants are manufacturing and marketing a sustained release capsules under the trademark FEMICONTIN. The defendants are continuing to infringe the trademark of the plaintiff. The cause of action is a continuous one and continues until such time as the Defendant is restrained by an order of injunction passed by this Hon'ble Court." (Emphasis Supplied)

49. On the other hand, the learned counsel for the plaintiff has drawn my attention to various documents appearing in the Evidence Folder IVB to show that the documents bear a stamp of acknowledgment from the District and Sessions Court, Ranga Reddy District, dated 30.10.2002.
50. I am afraid that the same cannot be read as evidence of the fact that the suit was filed in 2002. The plaintiff has not produced a certified copy of the plaint which was purportedly filed in the

filing of the Suit in the year 2002, in spite of a specific issue being raised in the present Suit. The documents referred to are the registration certificates for its trade marks and do not show with any certainty that the same were filed in the suit as claimed by the plaintiff. This objection was also taken by the defendant on 28.02.2013 before the learned Local Commissioner, recorded as under:

“(xvii) Copies of documents numbering seven filed alongwith the plaint in suit in District Court of Hyderabad in 2002 (The documents are being marked for the purpose of identification only - Learned counsel for the Defendant No.2 submitted that the copies do not relate to the suit allegedly filed in 2002 being O.S. No.33 of 2004. Commissioner's observation - Objection kept open to be decided at the final stage). The copies of the documents are marked as Mark F1 to F7. (In the affidavit they are referred to as Exhibit PW-1/12 (Colly)).”

51. It is important to note here that it is the consistent case of the defendant no.2 that the said suit was filed only in 2004; this was stated even in the written statement. In spite of the same, the plaintiff has chosen not to produce any cogent evidence of the suit having been filed in 2002.
52. In view of the above, it has to be held that though the plaintiff became aware of the adoption of the impugned mark **FEMICONTIN** by the defendant no.2 in the year 1999, it filed the suit against the defendant no.2 only in the year 2004, that is with a delay of almost 5 years. What is to be seen now is the effect of such delay.
53. In *Midas Hygiene P. Ltd. (supra)*, the Supreme Court has held that mere delay in bringing action is not sufficient to defeat grant

of an injunction. In *M/s Power Control Appliances & Ors.* (*supra*), the Supreme Court has held that acquiescence is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with the claim for exclusive rights in a trade mark and it implies positive acts and not mere silence or inaction such as is involved in laches. Therefore, for delay and acquiescence, there has to be something more than a mere delay on part of the plaintiff. In order to support the plea of acquiescence, it must be demonstrated through the conduct of the plaintiff that the plaintiff stood by for a considerable period while the defendant expended money in building up its own business with the aid of a similar mark.

54. In the present case, the plaintiff has asserted that after discovery of the use of the impugned mark by the defendant in the year 1999, and the issuance of a legal notice, it was informed that the products with the impugned mark are not available in the market. It was only in 2001, that it again came to the knowledge of the plaintiff that the products with the impugned mark are available in the market. As noted hereinabove, there is a controversy whether the suit was thereafter filed in the year 2002 or 2004. However, be that as it may, even assuming that the suit was filed in the year 2004, it cannot be said that by its conduct, the plaintiff acquiesced to the use of the impugned mark by the defendant. In this regard, I must also note that apart from stating its sales and advertising figures in the affidavit of evidence of DW-1, the defendant no.2 has not placed any other document on record to show the user of the impugned mark between 1999 to 2005.

55. In view of the above, issue no.2 is decided in favour of the plaintiff and against the defendant no.2, holding that though there is a delay in filing of the suit, the suit is not liable to be dismissed on this account.

ISSUE NO.3

56. The learned counsel for the defendant no.2 has not pressed the said issue.

57. The issue is therefore, decided as not pressed.

ISSUE NOS.4 TO 7

58. The plaintiff has been able to establish that it is the registered proprietor of the trade marks **FECONTIN-F** and **CONTIN**. It has also been able to establish its reputation in the mark **FECONTIN-F**, in fact, the same has not been denied by the defendant no.2.

59. At the same time, though the plaintiff is the registered proprietor of the mark **CONTIN**, in spite of the specific assertion of the defendant no.2 that the said mark is not in use as no product with the said mark alone is available in the market, the plaintiff has led no evidence to the contrary. The only claim of the plaintiff is that it has a family of marks of which **CONTIN** is the dominant part. For **CONTIN**, the answer to Question No.11 given by Mr.Rajiv Behl is relevant. The same is reproduced as under:

“Q.11 Does the Plaintiff company manufacture or market any product named only as CONTIN?”

Ans. We do not manufacture any product under the brand name CONTIN however most of our products bear the CONTIN as a suffix in all trademarks.

I am not aware as to how and on what basis Mundipharma AG of Switzerland had adopted the trademark CONTIN. We are using

CONTIN as suffix in relation to products with drug delivery system continus.”

60. The above is an admission of the fact that the registered trade mark **CONTIN** is not used by the plaintiff for its pharmaceutical products for which it is registered. In my opinion, even though **CONTIN** may be used as a prefix or suffix in a family of marks by the plaintiff, the same would not amount to use of the registered mark.
61. Section 47 (1) (b) of the Act states that a registered trade mark may be taken off the Register where it is shown *inter alia* that up to a date three months before the date of the application filed seeking its removal from the Register of trade marks, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark though registered was not *bona fide* used in relation to the goods and services for which it had been registered. Sub section (1) of Section 47 of the Act is reproduced herein below:-

“47. Removal from register and imposition of limitations on ground of non-use.—(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the High Court by any person aggrieved on the ground either—

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or

services by any proprietor thereof for the time being up to a date three months before the date of the application; or

(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

Provided that except where the applicant has been permitted under section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the Registrar of the High Court, as the case may be, is of opinion that he might properly be permitted so to register such a trade mark, the Registrar of the High Court, as the case may be, may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to—

(i) goods or services of the same description; or

(ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered.”

62. Sub-Section (2)(c) of Section 2 of the Act states that the ‘use of a mark’ in relation to goods shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods.

63. Therefore, use of the registered trade mark itself by the proprietor is essential. Use of a similar mark or a mark of which the

registered mark is a part, cannot be the use of the registered mark itself.

64. Section 28 of the Act gives the exclusive right to the use of the trade mark in relation to the goods and services in respect of which it is registered to the proprietor, if such registration is valid.
65. In the present case, challenge to the mark **CONTIN** has been filed by the defendant no.2 and is pending adjudication. Notwithstanding the pendency of the same, in my opinion, the non-use of the mark would be of relevant consideration for determining the relief to be granted to the plaintiff on account of registration of the mark **CONTIN** in its favour.
66. I may herein clarify that the above observations are not to be considered relevant for the purposes of determining the claim of passing off that the plaintiff may have due to its family of marks wherein **CONTIN** forms a predominant part as a suffix or prefix. While the concept of family of marks may be relevant for purposes of determining a claim of passing off, it may not be of much assistance to the plaintiff for considering the claim of infringement of the registered trade mark. It is also not relevant for determining the claim of infringement or passing off due to registration of the mark **FECONTIN-F** in favour of the plaintiff. Claim of infringement would have to be separately considered for the two marks, that is, **CONTIN** and **FECONTIN-F**.

67. On the question of comparison of two marks that is, **FECONTIN-F** of the plaintiff and **FEMICONTIN** of the

pharmaceutical product of the plaintiff as also of the defendant contains Ferrous, that is iron. The same is described by letters 'FE'.

68. The witness of the plaintiff, that is, Mr.Rajiv Behl, PW-1, in answer to question No.13 has stated as under:

"Q.13 Are you aware as to what is the basis of naming the product in question as FECONTIN-F?"

Ans. FE relates to iron and CONTIN is our registered trademark and F is related to ferrous and ingredients of the product."

69. For **CONTIN**, answers to Question No.11 as also Question No.12 given by Mr.Rajiv Behl are relevant. The same reproduced as under:

"Q.11 Does the Plaintiff company manufacture or market any product named only as CONTIN?"

Ans. We do not manufacture any product under the brand name CONTIN however most of our products bear the CONTIN as a suffix in all trademarks.

I am not aware as to how and on what basis Mundipharma AG of Switzerland had adopted the trademark CONTIN. We are using CONTIN as suffix in relation to products with drug delivery system continus."

"Q.12 What is the meaning of the expression "drug delivery system continus"?"

Ans. Continus Drug Delivery means the drug will have continuous effect in the body for a longer duration"

(Emphasis supplied)

70. From the evidence of the plaintiff itself, it is evident that even the word **CONTIN** is used by the plaintiff itself in a descriptive manner.
71. Therefore, 'FE' relates to iron, which is an ingredient of the plaintiff's product, while **CONTIN** is being used in relation to the products with Continuous Drug Delivery system, that is where the drug will have a continuous effect in the body for a longer duration. Though, it is correct that for determining whether a mark is descriptive or suggestive in nature, the mark is not to be bifurcated into parts, at the same time, it is also to be seen that the part which is descriptive is not allowed to be monopolised by any person. For determining whether the complained mark is deceptively similar to the other mark, the descriptive parts of such mark may have to be given less weightage.
72. In *Marico Limited v. Agro Tech Foods Ltd.*, 2010 SCC OnLine Del 3806, the Division Bench of this Court has observed as under:

"10. In view of the judgment of the Division Bench in the Cadila Healthcare Ltd. (supra), and with which we respectfully agree, the appellant in the facts of the present case can have no exclusive ownership rights on the trade mark "LOW ABSORB". The expression "LOW ABSORB" is quite clearly a common descriptive expression/adjective. The expression "LOW ABSORB" is not a coined word and at best it is a combination of two popular English words which are descriptive of the nature of the product as held by the Division Bench in Cadila Healthcare Ltd. (supra) case that such adoption naturally entails the risk that others in the field would also be entitled to use such phrases. Low

Absorb is not an unusual syntax and the same can almost be said to be a meaningful part sentence or phrase in itself. The expression "LOW ABSORB" surely and immediately conveys the meaning of the expression that something which absorbs less, and when used with respect to edible oil, it is descriptive in that it refers to less oil being absorbed or low oil being absorbed. Similar to the expression "Sugar Free" being not an unusual juxtaposition of two English words the expression "LOW ABSORB" equally is not an unusual juxtaposition of words in that the same can take away the descriptive nature of the expression. The expression "LOW ABSORB" is used in the functional sense for the character of the product viz. edible oil. With respect to the unregistered trade mark "LOW ABSORB" we are of the firm opinion that in essence the expression "LOW ABSORB" only describes the characteristic of the product edible oil and ordinarily/normally incapable of being distinctive. We are also of the view that it is high time that those persons who are first of the blocks in using a trade mark which is a purely descriptive expression pertaining to the subject product ought to be discouraged from appropriating a descriptive expression or an expression which is more or less a descriptive expression as found in the English language for claiming the same to be an exclusive trade mark and which descriptive word mark bears an indication to the product's kind, quality, use or characteristic, etc. This in our view is in accordance with the spirit of various subsections of Section 9 and Section 30 besides also Section 35 of the Act. The very fact that in terms of Section 9 of the Act, in cases falling therein, there is an absolute ground for refusal of registration of the trade mark, the same clearly is an indication of ordinarily a disentitlement from claiming exclusive ownership of a descriptive expression as a trade mark. We are in this entire judgment for the sake of convenience only using the expression 'descriptive expression' or 'descriptive word' or 'descriptive trade mark' 'descriptive', etc. but these expressions are intended to cover cases

with respect not only to a descriptive word mark used as a trade mark but to all word marks used as trade marks which refer to kind, quality, intended use or other characteristics, etc. of the goods, and also other ingredients of Sections 9(1)(b) and Section 30(2)(a)."

(Emphasis supplied)

73. In *Schering Corporation & Ors. v. Alkem Laboratories Ltd.*, 2009 SCC OnLine Del 3886, another Division Bench of this Court observed as under:

"32. No doubt, in Astrazeneca (supra) the additional factor in favour of the respondent/defendants that weighed in the mind of the Court was that the mark of the respondent/defendant had also been registered, in respect whereof the appellant/plaintiff had applied for rectification. However, to us it is clear that the salient features which led the Court to deny the grant of interim injunction to the appellant/plaintiff were:

- (a) The admission that 'MEROPENEM' was the active salt/drug in the medicines manufactured by both the parties which was publici juris;*
- (b) That nobody could claim exclusive right to use any word, abbreviation, or acronym which has become publici juris and which is used descriptively;*
- (c) In the trade of drugs it is common practice to name a drug by the name of the organ or ailment which it treats or the main ingredient of the drug. The name of an organ, ailment or ingredient being publici juris or generic if the use of the name is descriptive, the generic name cannot be claimed by anyone for exclusive use as a trademark;*
- (d) 'MERO' which was common to both the competing marks was taken from 'MEROPENEM' in respect whereof neither party could claim exclusive user for 'MEROPENEM' based drug. Both the parties had used three letter suffixes i.e. 'NEM' had been used by the appellant/plaintiff and 'MER' had been used by the respondent/defendant, which were distinct and not deceptive;*

- (e) *Even if the competing marks were to be taken as a whole, the suffixes 'NEM' and 'MER' distinguish and differentiate the two products. When they are taken as a whole, the aforesaid two trademarks could not be said to be either phonetically or visually, or in any manner deceptively similar to each other;*
- (f) *The possibility of deception or confusion is reduced to practically 'Nil' in view of the fact that the medicine would be sold by medical prescription and by licensed dealers well versed in the field and having knowledge of medicines. When two rival marks contain a common feature, which is not only descriptive but also publici juris, the consumer will tend to ignore the common feature and will pay more attention to the uncommon feature (for example in the case of Liv-52 v. Liv-T). If the uncommon features do not have phonetic similarity, the offending mark cannot be objected to. The drugs in question are Schedule H drugs available only on Doctor's prescription and are not over the counter medicines;*
- (g) *There was a vast difference in the prices of the two products. This fact by itself would ensure that there is no possibility of any deception/confusion, particularly, in view of the fact that the customer who comes with the intention of purchasing the product of the appellant/plaintiff would never settle for the product of the respondent/defendant which is priced much lower.*

33. *The fact situation in the two cases in hand are starkly similar to the fact situation in Astrazeneca (supra). If one were to replace 'MEROPENEM' with 'TEMOZOLOMIDE', 'MERO' with 'TEMO', 'MERONEM' with 'TEMODAL'/'TEMODAR', 'MEROMER' with 'TEMOKEM'/'TEMOGET', 'NEM' with 'DAL'/'DAR' and 'MER' with 'KEM'/'GET', and proceed on the basis that 'TEMO' is publici juris for TEMOZOLOMIDE, each of the aforesaid factors (a) to (g) would hold true, in principle, in the present cases as well.*

37. *We are, therefore, of the view that to get out of the said decision in Astrazeneca (supra), it is essential for the*

appellant to establish that TEM/TEMO is not publici juris for TEMOZOLOMIDE.

62. *It has been repeatedly recognized that in the trade of drugs it is a common practice to name a drug on the basis of the name of its active chemical compound or salt, or the disease it seeks to remedy, or the particular organ it is intended to treat. The name of such an ingredient or compound, ailment or organ being in the public domain and of generic nature, which has been used descriptively, cannot be claimed by anyone for use exclusively as only his/her trademark.*

63. *From the materials produced by the respondent, it is evident that TEM/TEMO have been employed in place of TEMOZOLOMIDE or as abbreviations for certain other medicines. No doubt TEM/TEMO have also been used in place of 'TEMODAL' and TEMODAR'. However, there is nothing to suggest that TEM/TEMO mean, and only mean, TEMODAL/TEMODAR and nothing else. Even when TEM/TEMO is used in relation to 'TEMODAL' and 'TEMODAR', the reference is actually to the chemical compound TEMOZOLOMIDE, which is the active ingredient in 'TEMODAL' and 'TEMODAR'.*

64. *Consequently, in our view, prima facie the word fragment TEM/TEMO is publici juris and also generic for and descriptive of the chemical compound, TEMOZOLOMIDE, and, therefore, the appellants cannot claim the exclusive right to use thereof. The decision in Astrazeneca UK Ltd. v. Orchid Chemicals & Pharmaceuticals Ltd., 2007 (34) PTC 469 has rightly been held to apply on all fours to the cases in hand.*

65. *As the appellants have chosen to brand their product with a generic and descriptive prefix 'TEMO', any other person entering the market would be entitled to use the said term to identify the product in question. If the appellants were desirous of avoiding such a situation they should have branded their drug with a unique name instead of a descriptive name [see Rhizome Distilleries P. Ltd. v. Pernod Ricard S.A. France, MANU/DE/2742/2009]*

74. Recently, a Division Bench of this Court in *Sun Pharmaceutical Laboratories Ltd v. Hetero Healthcare Ltd. and Another*, 2022 SCC OnLine Del 2580, while relying on the ratio of *Schering Corporation & Ors* (*supra*), held as under:

35. In our opinion, the judgment and the ratio laid down in *Schering Corporation v. Alkem Laboratories Ltd.* (*supra*), squarely applies to the facts of the present case. The appellant, in the present case, cannot be allowed to monopolize the INN 'LETROZOLE'. The mark, 'LETROZ', is not similar to the trademark 'LETRO' merely because both the parties have adopted the initial letters (SUN adopted the first six and HETERO adopted the first three) of the INN 'LETROZOLE'. It is apparent that both SUN and HETERO are using their marks, which are derived from the drug, that is, 'LETROZOLE'.

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38. In the case of *Panacea Biotec Ltd. v. Recon Ltd.*, 1996 SCC OnLine Del 508, the plaintiff was using the trademark 'NIMULID' and had filed a suit for injunction against the defendant for using the mark 'REMULIDE' in relation to the same medicine with the API being 'NIMESULIDE'. This Court held that when the name is derived or coined from the name of the principal ingredient being used in the manufacture of the drug, no distinctiveness or exclusiveness can be claimed by the manufacturer. The said decision is applicable to the facts of this case as well; the mark 'LETROZ' is nothing but a short name of the active ingredient 'LETROZOLE'.

(emphasis supplied)

75. Applying the above ratios, in the present case, the word **FECONTIN-F** is clearly descriptive of the pharmaceutical product itself. It is suggestive of iron released for a continuous period in the body. The plaintiff's product is Ferrous Glycine Sulphate equivalent to 100mg Ferrous Iron and Folic Acid I.P.

0.5mg tablets. PW1- Shri Rajiv Behl, in his cross examination states as under:-

“The medicine FECONTIN-F is an iron supplement and is used by female patients normally during pregnancy.”

76. The mark is therefore, descriptive of the product. The plaintiff cannot claim any exclusive right over the same.

77. Though a combination of two descriptive words may still be entitled to protection, the plaintiff cannot deny the use of such descriptive parts by a third party or claim exclusive right to use the same. The defendant no. 2 has explained the reason for adoption of its mark in the following words:-

“The Defendant No.2 submits that both the rivals marks in the suit are not similar at all. It is pertinent to mention that it is a very common phenomenon in the Pharmaceutical Industry to club the nature of disease and medicinal compound to coin a Trademark which will enable the medical practitioners and doctors to remember the particular names of the medicine very easily. The Defendant No.2 humbly submits before this Hon'ble Court as to how the Trademark "FEMICONTIN" has been coined by them. The letters 'FE' are derived from Ferrous Fumarate, which is an ingredient of the drug. The medicine contained in the Trademark is useful for the pregnant women and hence the word "FEMI" is derived by adding letters "MI" to "FE", which indicates "Female". The word "CONTIN" is derived from the dictionary word "CONTINUES" which means to go on happening or moving. Here, in total, the Trademark "FEMICONTIN" means and indicates a drug which releases iron continuously in a sustained release manner into the body of a pregnant woman to avoid normal side effects and it improves the quality of blood by increasing RBC. That is why the Defendant No.2 has adopted "FEMICONTIN" as their Trademark. It is further submitted that the Defendant No.2 does

not have any ill intention or any other reason to adopt the Trademark "FEMICONTIN". It is coined with honest and bonafide intention."

78. I find merit in the claim of *bona fide* adoption of the mark by the defendant no. 2.
79. In the present case, the two marks, in my view, are also not deceptively similar, either visually or phonetically.
80. At this stage, I would also deal with another issue that has arisen during the course of submissions. The plaintiff, along with its written submissions, has placed on record an alleged opposition filed by the defendant no.2 before the Trade Marks Registry, opposing the application of the plaintiff for the mark **FECONTIN**, alleging therein that the two marks, that is **FEMICONTIN** of the defendant no. 2 and **FECONTIN** of the plaintiff, are deceptively similar to each other. The learned counsel for the defendant no.2 has submitted that this document has been surreptitiously introduced with the written submissions by the plaintiff and did not form part of the documents filed by the plaintiff in the regular course and on which the parties went to trial. He submits that permission of this Court was not obtained for placing this document on record and, therefore, the same cannot be taken into consideration by this Court.
81. On the other hand, the learned counsel for the plaintiff, placing reliance on the judgment of the Supreme Court in **Madamanchi Ramappa & Anr. v. Muthaluru Bojjappa** (1964) 2 SCR 673; and of this Court in **Burger King Corporation v. Techchand Shewakramani & Ors.**, 2018 SCC OnLine Del 10881, submits that as the said document is a certified copy of the public

document, the same can be taken note of by this Court even at this stage.

82. I am unable to agree with the submission made by the learned counsel for the plaintiff. The parties have undergone the rigors of a trial. This document was not placed on record by the plaintiff during the course of such trial. The witness of the defendant no.2 was also not confronted with this document. In spite of the objection of the learned counsel for the defendant no.2 that the said document cannot be placed reliance on at this stage as it does not form part of the record of the Suit, the plaintiff has not taken any steps by moving an appropriate application for the said document to be taken on record. Written submissions are merely for the benefit of the Court so that the Court can get a summary of the submissions that are proposed to be made or have been made by the learned counsels; the parties cannot introduce new documents along with the written submissions in such a surreptitious manner.

83. In *Madamanchi Ramappa & Anr (supra)*, no objection on the mode of proof of the document either before the learned Trial Court or the learned District Court had been taken. The Court held that being a certified copy of a public document, it need not have been proved by calling of witnesses. The Court was not dealing with the situation where the document itself was not part of the record but was sought to be added later without any formal application.

84. In *Burger King Corporation (supra)*, the Court was considering whether the denial of the documents that are available publicly

and are verifiable, such as trade mark certificates, copyright certificates from India and other countries, is justified. The Court was not confronted with the position where the defendant, due to such belated attempt on part of the plaintiff to introduce a new document, and that too without seeking permission of the Court, would be denied an opportunity to explain the same in his evidence.

85. In the present case, the learned counsel for the defendant no.2 has sought to explain the said document by stating that it cannot act as an estoppel against the defendant. This may or may not be a correct submission, however, the witness of the defendant was not confronted with this document, and, therefore, had no opportunity to explain the said document. The plaintiff has also not filed on record its own reply to the opposition filed by the defendant no. 2 before the Trade Marks Registry nor stated the outcome of the opposition filed. Had this document been filed in regular course or with the leave of the Court, the defendant no. 2 would have had an opportunity to state its case on this document. It cannot be taken by surprise at the stage of the final hearing by introducing this document in such a surreptitious manner. The CPC gives the procedure by which an additional document can be received in the evidence. The plaintiff having not followed the said procedure, cannot be allowed to rely upon the said document. As noted hereinabove, though, this objection was taken at the very inception of the oral submission of the learned counsel for the defendant no.2, the plaintiff did not take any steps to have the said document taken on record by moving an

appropriate application. The said document, therefore, has to be ignored from consideration.

86. Returning back to the discussion on whether the two marks are deceptively similar to each other, I must also herein note that the plaintiff has also not led any evidence on any confusion being caused by the simultaneous use of the marks of the plaintiff and the defendant no.2, though the suit itself has been pending for more than 15 years.

87. In answer to Question no.25, Mr.Rajiv Behl, PW-1 stated as under:

“Q.25 Have you received any complaint or can you quote a specific instance where a doctor may have mis-spelt the brand and a chemist had sold the drug in question without prescription?”

Ans. No. However field staff has informed about the confusion because of the presence of the product under the trademark.”

88. The plaintiff produced no other witness. Even the alleged information received by it from ‘field staff’ has neither been filed nor proved.

89. For purposes of passing off, it is to be seen whether there is any likelihood of confusion in the mind of an unwary consumer with imperfect recollection due to the use of the two marks. In the present case, the plaintiff has failed to prove any confusion being caused by the use of the mark of the defendant no. 2.

90. For the above stated reasons, Issue nos.4 to 7 are decided against the plaintiff and in favour of the defendant no.2.

ISSUES 8 AND 9

91. As these are issues which are consequential to the decision of Issue nos.4 to 7, the same having been decided against the plaintiff, the Issue nos.8 and 9 are also decided against the plaintiff and in favour of the defendant no.2.

ISSUE NO.10

92. In view of the above findings, the plaintiff is not entitled to any relief in the suit. The same is dismissed.

93. The parties shall bear their own costs.

94. Let a Decree Sheet be drawn accordingly.

NAVIN CHAWLA, J.

**MARCH 23, 2023
RN/DJ/KP**