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C.S.No.87 of 2012

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 22.02.2024

Pronounced on : 11.03.2024

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

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Sun Pharmaceutical Industries Limited,
CD Plot No.3, Door No.8,
Old Tower Block Street,
Nandhanam Extension,
Chennai - 600 035.
Rep. by its Power Agent,
K.Murugesan

... Plaintiff

Vs.

Kivi Labs Ltd.,
147 / 148, GIDC,
Por-Ramangamdi,
Dist. Baroda,
Gujarat - 391 243.

... Defendant

Prayer: Plaint filed under Order IV Rule 1 of the Original Side Rules and Order VII Rule 1 of the C.P.C. read with Sections 27, 28, 29, 134 and 135 of the Trademarks Act, 1999 for the following reliefs:

(a) A permanent injunction restraining the Defendant, its distributors, stockists, servants, agents, retailers, legal representatives, job-workers, manufacturers or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking,



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advertising directly or indirectly dealing in medicinal and pharmaceutical preparations infringing Plaintiffs registered trademark AMIXIDE by use of deceptively similar trademark KIMIXIDE or any mark deceptively similar to Plaintiff's registered trademark AMIXIDE or in any other manner whatsoever;

b) A permanent injunction restraining the Defendant, its distributors, stockists, servants, agents, retailers, legal representatives job-workers, manufacturers or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations under the trademark KIMIXIDE or any other trademark that is identical and/or deceptively similar as that of the Plaintiffs registered trademark AMIXIDE and/or use similar packaging as that of the plaintiff's products under the mark AMIXIDE so as to pass off the Defendant's medicinal preparations as and for the medicinal preparations of the Plaintiff and/or in any other manner whatsoever connected with the Plaintiff;

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

(d) The Defendant be ordered and decreed to deliver up for destruction to the Plaintiff all the preparations, dies, blocks, labels, packaging either filled or empty, brochures, leaflets, pamphlets, hand bills, hoardings, wall posters, calendars, carry bags, stationery items and



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such other sales promotional materials bearing and/or containing the impugned trademark KIMIXIDE;

(e) A preliminary decree be passed in favour of the Plaintiff directing the Defendant to render accounts of profits made by it by use of the trademarks KIMIXIDE which is identical and/or deceptively similar and a final decree be passed in favour of the Plaintiff for the amount of profits found to have been made by the Defendant after the latter has rendered accounts;

(f) For costs of the entire proceedings.

For Plaintiff : Mr.P.S.Raman
Senior Counsel
for Mr.S.Diwakar

For Defendant : Mr.Sathishkumar
for Mr.PCN.Raghupathy

JUDGMENT

The suit has been filed for infringement, passing off and for damages. The plaintiff has also sought for destruction of the alleged infringed products and also for preliminary decree to render accounts of the products alleged to have been manufactured by the defendant by using a deceptively similar trademark of the plaintiff.



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2. The plaintiff claims to be a reputed pharmaceutical Company with presence in India and in many parts of the World. They claim that they have registered several trademarks for their pharmaceutical preparations under different brand names and in the course of their regular business, they claim that in or about April, 1984, they adopted the trademark AMIXIDE in respect of pharmaceutical preparations for treatment of depressive disorders and other psychotic disorders.

3. According to the plaintiff, the mark AMIXIDE has been exclusively used by them in medicinal and pharmaceutical products for treatment of depression and other psychotic disorders since 1984.

4. The plaintiff also claims that they have obtained drug license from the Drug Control Administration for manufacture of medicinal and pharmaceutical preparations containing chlordiazepoxide and amitriptyline for treatment of depression and other psychotic disorders under the trademark AMIXIDE in October, 1983. According to the plaintiff, after receiving the drug license, the plaintiff commenced manufacturing of medicinal and pharmaceutical products under the



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trademark AMIXIDE in the year 1984.

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5. The plaintiff also claims that in order to obtain statutory protection for its trademark AMIXIDE, they had obtained trademark registration under No.1748417 in class 5 in respect of medicinal and pharmaceutical preparations and substances included in class 5.

6. According to the plaintiff, they have got exclusive proprietary right over the trademark AMIXIDE. They have also claimed that with the prior and continuous use, the mark AMIXIDE has attained tremendous goodwill and reputation among the trade and public.

7. The plaintiff also claims that the drug sold by them under the trademark AMIXIDE is having huge turnover and the sales has increased ever since the commencement of its usage. The plaintiff has also disclosed the sales turnover for the anti-depression drug by using the trademark AMIXIDE in the plaint. The sales turnover from 2006-07 to April, 2010 - December, 2011 as disclosed in the plaint is re-produced hereunder:



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Year	Amount (in Lakhs of Rs.)
2006 - 07	589.85
2007 - 08	662.86
2008 - 09	722.91
2009 - 10	730.35
2010 - 11	822.72
Apr, 2011 - Dec, 2011	669.19

8. The plaintiff claims that they have incurred huge amount of expenditure towards promoting the drug in the name of the registered trademark AMIXIDE. The details of the expenditure incurred by the plaintiff between 2006 - 07 and April, 2011 - December, 2011 as disclosed in the plaint is reproduced hereunder:

Year	Amount (in Lakhs of Rs.)
2006 - 07	98.53
2007 - 08	109.62
2008 - 09	116.09
2009 - 10	102.19
2010 - 11	117.24
Apr, 2011 - Dec, 2011	91.08

9. According to the plaintiff, by virtue of extensive publicity, long and continuous use of the trademark AMIXIDE in respect of medicinal preparations, the mark has come to be identified only with the plaintiff.



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According to them, the trademark AMIXIDE is an invented word, coined by the plaintiff and therefore, is the exclusive property of the plaintiff.

They have also claimed that in view of the wide use and substantial sales, the trademark AMIXIDE has earned tremendous goodwill and reputation in the market.

10. According to the plaintiff, the defendant has adopted the mark KIMIXIDE, which is deceptively similar to the plaintiff's prior adopted trademark AMIXIDE. According to the plaintiff, the mark AMIXIDE and KIMIXIDE are visually, phonetically and structurally similar, and confusion and deception are bound to arise among the trade and public in view of such similarity. The plaintiff also claims that the defendant's trademark KIMIXIDE is used for treatment of same ailment viz., depression and other psychotic disorders with almost same composition as that of the plaintiff's product AMIXIDE. According to the plaintiff, since the mark KIMIXIDE is almost identical / deceptively similar to that of the plaintiff's trademark AMIXIDE, the defendant has committed an act of infringement and passing off.



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11. According to the plaintiff, they came to know about the defendant's adaptation of the almost identical trademark KIMIXIDE when the application filed by the defendant for registration of the said mark under No.183997 in Class 5 before the Trademark Registry was advertised in the Trademark Journal under No.1444 dated 16.07.2010. According to the plaintiff, immediately after coming to know of the same, they issued a legal notice on 09.10.2010 calling upon the defendant to withdraw their trademark application forthwith in view of close similarity of the two trademarks and also warning them of the legal action in case they continue to use the infringed mark in respect of their medicinal preparations. The defendant, upon receipt of the said notice, had issued a reply vide letter dated 18.10.2010 denying the infringement and passing off. According to the plaintiff, the defendant has falsely taken a plea in the reply that they have legally adopted the mark KIMIXIDE since 2002 without any proof to corroborate the said allegation.

12. The plaintiff also claims that on receipt of the reply from the



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defendant to the cease and desist notice, the plaintiff filed notice of opposition against the registration of the trademark KIMIXIDE before the trademark registry on 10.11.2010. The notice of opposition was also served on the defendant and the defendant has also filed their counter in Form TM6 on 13.06.2011. According to the plaintiff, the opposition petition filed by the plaintiff before the trademark registry is still pending adjudication.

13. According to the plaintiff, the defendant launched their medicinal preparations bearing the mark KIMIXIDE just prior to the institution of the suit and subsequent to the invention and use of the mark AMIXIDE by the plaintiff since the year 1984. According to the plaintiff, they are the undisputed prior adopter and user of the trademark AMIXIDE. According to them, the defendant has no right to use an almost identical and deceptively similar mark KIMIXIDE as the same amounts to infringement of plaintiff's registered trademark AMIXIDE. According to the plaintiff, being a much later entrant to the market, the defendants are deemed and / or ought to have known the presence of the plaintiff who is a market leader in preparations for treatment of



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depression and other psychotic disorders under the registered trademark sold by the plaintiff under AMIXIDE.

14. According to the plaintiff, with the malafide intention, the defendant is riding on the goodwill and reputation of the plaintiff and diverting the plaintiff's business and sales to their own advantage and has been using a deceptively similar mark KIMIXIDE for the sale and manufacture of a similar drug sold and manufactured by the plaintiff. According to the plaintiff, the defendant has illegally adapted the almost identical / deceptively similar trademark KIMIXIDE as that of the plaintiff. According to them, the defendant has made a slavish imitation of the plaintiffs registered trademark AMIXIDE and has slyly added two alphabets 'K' and 'I' instead of 'A'. According to the plaintiff, the pharmaceutical preparations for which the defendant is using the mark KIMIXIDE are identical to the plaintiff's pharmaceutical preparations sold under the mark AMIXIDE. According to the plaintiff, the marks involved are almost identical / deceptively similar, the goods infringed are almost identical and the medicines are meant for the same ailment / disease / disorder, and further, the class of customers for whom the



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medicines are prepared to be prescribed is also identical. According to the plaintiff, they have satisfied the triple identity test and therefore, they are entitled for the reliefs sought for in the suit.

15. According to the plaintiff, the plaintiff's trademark AMIXIDE and the defendant's mark KIMIXIDE are phonetically and structurally similar. Hence, according to them, there is every possibility and probability that the defendant's mark KIMIXIDE is palmed off as and for the plaintiff's AMIXIDE tablets, which may lead to drastic and dire consequences especially as the plaintiff's and defendant's products vary in dosage and strength.

16. According to the plaintiff, the use of deceptively similar mark KIMIXIDE by the defendant is bound to cause confusion as to the trade origin of the defendant's products. According to the plaintiff, the defendant has deliberately adopted the deceptively similar mark KIMIXIDE with a view to pass off the goods as that of the plaintiff causing heavy loss to the plaintiff.



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17. According to the plaintiff, the trademark AMIXIDE of the plaintiff has been widely publicised and it is well known among the medical practitioners and traders. According to them, an average person with imperfect recollection would not be in a position to differentiate between the two marks and there is every likelihood of the defendant's trademark KIMIXIDE being misspelt or misread as the plaintiff's registered trademark AMIXIDE by the pharmacists and chemists while deciphering the handwriting of the prescription of the doctor because of the high degree of resemblance in both the marks phonetically, visually and structurally.

18. According to the plaintiff, the defendant has knowingly, deliberately and with a malafide intent, adopted the impugned trademark KIMIXIDE. According to the plaintiff, the act of the defendant in adapting the deceptively similar trademark KIMIXIDE with a view to pass off their product as and for the products of the plaintiff is fraught with malice and the defendant ought to be restrained from using the mark in respect of their drugs / medicinal preparations.



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19. According to the plaintiff, they have suffered loss and they continue to suffer loss on account of the infringement and passing off committed by the defendant. According to them, they continue to suffer irreparable monetary loss, loss of reputation and goodwill that cannot be compensated on monetary terms unless the defendant is restrained by this Court from committing the acts of infringement and passing off.

20. The plaintiff has claimed damages from the defendant for a sum of Rs.1,00,000/- for the alleged act of infringement and passing off said to have been committed by the defendant. The plaintiff has also sought for destruction of the products sold by the defendant under the impugned trademark KIMIXIDE and they have also sought for preliminary decree directing the defendant to render the accounts of profits made by using the trademark KIMIXIDE.

21. On the other hand, the defendant claims that they have adopted several brand names for medicinal products. According to them, one of the brand names under which the the defendant is manufacturing and



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marketing is 'KIMIXIDE', which contains two main ingredients, namely, 'Chlordiazepoxide' and 'Amitriptyline'. According to the defendant, they have coined the brand name 'KIMIXIDE' by taking the letters 'KI' from the first two letters of the defendant's company name 'Kivi' and the suffix 'MIXIDE' by telescoping the letters from the names of said two ingredients of the drug i.e. the letters 'MI' from the drug ingredient 'AMITRIPTYLINE' and the letters 'XIDE' from another ingredient 'CHLORDIAZEPOXIDE'.

22. According to the defendant, the adoption of the mark 'KIMIXIDE' is honest and bonafide on the line of trade usage adopted by several pharmaceutical manufacturers. According to the defendant, this kind of 'trade usage' adopted by the defendant for coining the brand name 'KIMIXIDE' is prevalent among pharmaceutical manufacturers and it is admissible as evidenced under Section 146 of the Trademarks Act, 1999 (in short "the Act"). According to the defendant, both the plaintiff's drug and the defendant's drug can be sold only through a medical prescription. Therefore, the possibility of confusion or deception does not arise.



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23. According to the defendant, though the plaintiff has obtained drug licence in the year 1983, they have not filed documents to prove that they have been manufacturing by using the brand name 'AMIXIDE' from 1983 onwards. The defendant also states that they have also applied for trademark registration in Class 5 for the mark 'KIMIXIDE', which has been opposed by the plaintiff, and the said applications are pending before the Trademarks Registry, Ahmedabad. According to the defendant, they are entitled for trademark registration for their brand name 'KIMIXIDE' under Section 12 of the Trademarks Act, 1999 on the basis of honest and concurrent user. The defendant claims that they have been using the brand name 'KIMIXIDE' from 24.10.2002 onwards and they have filed the trademark application seeking for registration of their mark 'KIMIXIDE' on 14.07.2009.

24. According to the defendant, due to their long and continuous usage of the mark 'KIMIXIDE', the question of confusion or deception does not arise. The defendant also claims that as that of the plaintiff, they are also having their place of business at Baroda and therefore, the



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plaintiff cannot plead ignorance that they came to know only just before the filing of the suit in the year 2012 that the defendant is using the brand name 'KIMIXIDE'. According to the defendant, the plaintiff is aware that the defendant has been using the trademark 'KIMIXIDE' from the year 2002 onwards.

25. Therefore, according to the defendant, the plaintiff is guilty of delay, laches and acquiescence. It is also contended by the defendant that the plaintiff's mark 'AMIXIDE' is not a distinctive trademark and is liable to be rectified from the trademark registry on the ground that a false claim has been made by the plaintiff that they have been using the mark 'AMIXIDE' from the year 1984. The defendant categorically contends that they have not committed an act of infringement as claimed by the plaintiff in the plaint. They also contend that they have not misrepresented to the consuming public that the product sold by them under the brand name 'KIMIXIDE' is that of the plaintiff. Therefore, they claim that the defendant has not committed an act of passing off. The defendant also claims that their packing material used for their brand name 'KIMIXIDE' are different from the packing material of the plaintiff



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used for the plaintiff's trademark 'AMIXIDE'. According to the defendant, there will be no possibility of confusion or deception in the market. The defendant has also categorically contended that the plaintiff has not suffered any loss on account of the defendant's usage of the brand name 'KIMIXIDE'. Therefore, the question of payment of damages by the defendant to the plaintiff does not arise.

26. Based on the pleadings of the respective parties to the suit, this Court framed the following issues on 09.11.2021:

- '1. Whether the use of mark by the defendant KIMIXIDE amounts to infringement of the plaintiff's registered trademark AMIXIDE?
2. Whether the mark KIMIXIDE used by the defendant is deceptively similar to the plaintiff's trademark AMIXIDE and by using the said trademark whether the defendant is trying to misuse the goodwill/reputation of the plaintiff and is deceitfully getting an economic advantage by passing off the plaintiff's trademark?
3. Whether the defendant is bonafide adopting a mark KIMIXIDE by adding their company name and the name of the ingredient of the product?
4. Whether the plaintiff is entitled for a decree for permanent injunction on the ground of infringement of the plaintiff's



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trademark AMIXIDE?'

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27. No oral evidence was let-in on behalf of both the parties and this was also recorded by this Court vide its order dated 24.11.2021. The following documents were marked as exhibits on the side of the plaintiff:-

Exhibit	Description
P1	Registration certificate for trademark AMIXIDE under No.1748417 in class 5 dated 27/10/2008
P2	Product permission granted by Food and Drug Control Administration in respect of medicinal product under the mark AMIXIDE dated 29/10/2008
P3	Product brochure of plaintiffs AMIXIDE drug
P4	Extract from medical journals in relation to plaintiffs product under the mark AMIXIDE
P5	Invoice raised for the sale of products under mark AMIXIDE
P6	Chartered Accountant certified statement of sales of products under the mark AMIXID dated 06/02/2012
P7	Chartered Accountant certified statement of sales promotion expenses with respect to products under the mark AMIXIDE dated 06/02/2012
P8	Legal notice issued by the plaintiff dated 09/10/2010
P9	Reply sent by the defendant along with postal cover dated 18/10/2010
P10	Notice of opposition filed by the plaintiff against defendants application for registration of the mark KIMIXIDE dated 10/11/2010
P11	Counter filed by the defendant in Form TM 6 dated 13/06/2011
P12	Plaintiffs AMIXIDE cartons
P13	Defendants KIMIXIDE carton

28. On behalf of the defendant, the following documents were



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marked as exhibits:-

Exhibit No.	Description
D1	Certificate of incorporation
D2	KIMIXIDE Drug Controller approval for year 2002 to 2007
D3	KIMIXIDE Drug Controller approval for year 2006 to 2011
D4	KIMIXIDE Drug Controller approval for year 2011 to 2016
D5	KIMIXIDE Drug Controller approval for year 2016 to 2021
D6	Certificate of turnover of KIMIXIDE
D7	Invoice copy for year 2002
D8	Invoice copy for year 2003(12 invoices)
D9	Invoice copy for year 2004 (12 invoice)
D10	Invoice copy for year 2005 (11 invoice)
D11	Invoice copy for year 2006 (10 invoices)
D12	Invoice copy for year 2007 (9 invoices)
D13	Invoice copy for year 2008 (12 invoices)
D14	Invoice copy for year 2009 (10 Invoices)
D15	Invoice copy for year 2010 (13 invoices)
D16	Invoice copy for year 2011 (14 invoices)
D17	Invoice copy for year 2012 (2 invoices)
D18	Invoice copy for year 2013 (2 invoices)
D19	Invoice copy for year 2014 (3 invoices)
D20	Invoice copy for year 2015 (3 invoices)
D21	Invoice copy for year 2016 (3 invoices)
D22	Invoice copy for year 2017 (2 invoices)
D23	Invoice copy for year 2018 (3 invoices)
D24	Invoice copy for year 2019 (3 invoices)
D25	Invoice copy for year 2020 (3 invoices)
D26	Invoice copy for year 2021 (6 invoices)
D27	Renewal of license for year 2016 to 2021
D28	KIMIXIDE label
D29	KIMIXIDE label



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Exhibit No.	Description
D30	KIMIXIDE label
D31	KIVI LABS label
D32	KIVI LABS label
D33	KIMIXIDE label
D34	KIMIXIDE label

29. Heard Mr.P.S.Raman, learned Senior counsel, for Mr.S.Diwakar, learned counsel for the plaintiff; and Mr.P.C.N.Raghupathy, learned counsel, for Mr.Sathishkumar, learned counsel for the defendant.

30. The learned Senior counsel for the plaintiff drew the attention of this Court to the documents marked as exhibits on the side of the plaintiff and would submit that as seen from the trademark registration certificate for the plaintiff's trademark “AMIXIDE”, it is clear that the plaintiff has been using the word mark “AMIXIDE” since 1984. The learned Senior counsel for the plaintiff also drew the attention of this Court to the 'drug license' obtained by the plaintiff in respect of the drug sold under the trademark “AMIXIDE” and would submit that the drug license was also obtained in the year 1983 itself. He would also submit



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that the word mark “AMIXIDE” was coined from two ingredients of the drug, namely, Amitriptyline and Chlordiazepoxide.

31. The learned Senior counsel for the plaintiff would submit that the plea taken by the defendant that the defendant is an honest and concurrent user of the trademark “KIMIXIDE” is false and the same has to be rejected for the following reasons:-

(a) The drug sold by the plaintiff under the registered trademark “AMIXIDE” and the drug sold by the defendant under the mark “KIMIXIDE” are both anti depression drugs.

(b) Both the drugs cater to the very same patients, who are suffering from depression.

(c) The defendant had used only the prefix “KIVI”, its trade name for most of the pharmaceutical products manufactured and sold by it. The sale of the anti depression drug by the defendant under the mark “KIMIXIDE” is only to ride over the reputation/goodwill of the plaintiff's trademark “AMIXIDE” and thereby make unlawful and illegal gains.

(d) The plaintiff has been using the trademark “AMIXIDE” as seen from the trademark registration certificate since 1984. Invoices



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have also been filed, which have been marked as exhibits on the side of the plaintiff to establish that the plaintiff has been using the trademark “AMIXIDE” since 1984, when admittedly, the defendant has been using the mark “KIMIXIDE” only from 2002 onwards.

(e) As seen from the pleadings in the plaint as well as through the exhibits marked on the side of the plaintiff, the sales turnover of the plaintiff is huge and if compared with the defendant's turnover, it will be matchless.

(f) The sales turnover of the plaintiff establishes that the plaintiff has build-up the reputation on its own for its trademark “AMIXIDE” in respect of anti depression drug by its long and continuous usage and its distinct identity.

(g) The defendant's mark “KIMIXIDE” is deceptively similar to that of the plaintiff's trademark “AMIXIDE”, since it is phonetically and structurally similar.

32. In support of his submissions, the learned Senior counsel for the plaintiff relies upon the following authorities:-

(i) Midas Hygiene Industries Pvt. Ltd. And others Vs.



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Sudhir Bhatia and others [2004 (3) SCC 90];

(ii) The Himalaya Drug Company Vs. S.B.L. Limited
[2013 (53) PTC 1 (Del)];

(iii) Sun Pharmaceuticals Industries Limited Vs.
Cadila Healthcare Ltd and Ors [2010 (43) PTC 483 (Mad)];

(iv) Sun Pharmaceuticals Industries Limited Vs.
Cadila Healthcare Ltd and Ors [(2016) MLJ 147];

(v) Hindustan Pencils (P) Ltd. Vs. India Stationery
Products Co. and others [AIR 1990 Del 19];

(vi) Ciba Geigy Vs. Crosslands Research
Laboratories Ltd. [1995(15)PTC 251 (Mad)];

(vii) Corn Products Refining Co. Vs. Shangrila Food
Products Ltd. [AIR 1960 SC 142]; and

(viii) Cadila Healthcare Care Ltd. Vs. Cadila
Pharmaceuticals Ltd [2001 (5) SCC 73].

33. On the other hand, the learned counsel for the defendant, after drawing the attention of this Court to the documents, which have been marked as exhibits on the side of the plaintiff as well as on the side of



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the defendant, would submit as follows:-

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(a) The plaintiff has tacitly admitted that their use of the trademark “AMIXIDE” is only from 1999 and no proof has been filed by the plaintiff for using the trademark “AMIXIDE” since 1984.

(b) It can be inferred from the Indian Drug Review issue dated July-August, 1999, that the plaintiff has been using the trademark “AMIXIDE” for anti depression drug manufactured and sold by it, only from July-August, 1999.

(c) The invoices filed by the plaintiff for the sales made by them under the trademark “AMIXIDE” are only from the year 1999 and therefore, since the defendant has been using the word mark “KIMIXIDE” from 2002 onwards, the defendant is an honest and concurrent user entitled to get protection under Section 12 of the Trademarks Act.

(d) There is no deceptive similarity between the plaintiff's trademark “AMIXIDE” and the defendant's mark “KIMIXIDE”. The letters 'KI' found in the mark “KIMIXIDE” was taken from the first two letters of the defendant's company name 'KIVI LABS LTD.'. The



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remaining letters in “KIMIXIDE” were also taken from the two ingredients of the drug “Amitriptyline” and “Chlordiazepoxide”, which was also done by the plaintiff, and therefore, the question of deceptive similarity does not arise.

(e) The trade dress of both the plaintiff and the defendant are totally different.

(f) The drug license for the drug manufactured and sold by the defendant under the mark “KIMIXIDE” was also obtained by the defendant as early as in the year 2002 and therefore, being an honest and concurrent user, the plaintiff cannot sue the defendant for infringement and passing off. Since both the plaintiff's trademark “AMIXIDE” and the defendant's mark “KIMIXIDE” were coined only from the ingredients of the drug, namely, “Amitriptyline” and “Chlordiazepoxide”, the plaintiff cannot sue the defendant for infringement and passing off, as both the marks cannot be termed to be phonetically and structurally similar.

34. The learned counsel for the defendant would further submit that the judgments relied upon by the learned Senior counsel for the



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plaintiff has no bearing to the facts of the instant case. According to him, the decision of the Hon'ble Supreme Court in ***Power Control Appliances and Others Vs. Sumeet Machines Pvt. Ltd and others [1994 (2) SCC 448]*** is not applicable to the facts of the instant case, as the Hon'ble Supreme Court held that while deciding copyright case, Section 12 of the Trademarks Act is not applicable. He would submit that as corollary, the Delhi High Court case relying on *Sumeet's case (cited supra)* is also not applicable to the facts of the present case as the Delhi High Court, while dealing with an interim application, was only dealing with the prima facie case. On the other hand, the present case is a final hearing one and therefore, the said decision cannot be applied to the present case.

35. The learned counsel for the defendant would further submit that both the plaintiff's office and the defendant's office are only at Gujarat and the plaintiff is aware of the same. Therefore, the plaintiff is aware of the using the word mark "KIMIXIDE" by the defendant since 2002 and deliberately, the plaintiff has suppressed the said fact in the plaint. In *Sumeet's case (cited supra)*, the Hon'ble Supreme Court held



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that if the plaintiff stood by knowingly and let the defendant build up an important trade until it had become necessary to crush it, then the plaintiff should be stopped by their acquiescence. According to him, the plaintiff is not entitled to the reliefs as claimed in the suit on the ground of laches and delay as well. According to him, the suit was filed in the year 2012, after a delay of 10 years with a false plea that the plaintiff came to know about the defendant only at the time of advertisement in the trademark journal. The use of the mark “KIMIXIDE” by the defendant and its trade dress are distinctive and hence, all these years, the presence of both the marks in the market has not created any confusion in the minds of the general public. He would submit that any confusion will not arise, since the product is a Schedule-H drug and hence, average consumer cannot purchase the plaintiff's or the defendant's product across the counter. According to him, unless there is a medical prescription by a medical practitioner, the anti depression drug cannot be purchased.

36. He would further submit that the question of passing off will not arise, since the packaging of all manufacturers of Schedule – H drug



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will be same across different manufacturers and marketers in the pharmaceutical industry. The defendant has also filed originals of Drug Controller Approvals for the years 2002-2021, which have been marked as exhibits. The plaintiff has not produced any proof to show that the defendant has misrepresented the reputation/goodwill of the plaintiff's trademark "AMIXIDE".

DISCUSSION

37. The trademark dispute involved in this matter is pertaining to a medicinal Schedule-H drug. The plaintiff's registered trademark is "AMIXIDE", an anti-depression drug and the defendant's mark is "KIMIXIDE", which is also an anti-depression drug. Before deciding as to whether the mark "KIMIXIDE" used by the defendant is deceptively similar to that of the plaintiff's trademark "AMIXIDE", this Court will have to take into consideration the well settled principles laid down by the Hon'ble Supreme Court in *Cadila Healthcare Limited Vs. Cadila Pharmaceutical Limited reported in 2001 (5) SCC 73*, while dealing with the issue of confusion and deception in Schedule-H and Schedule-L drugs. Schedule-H drugs are those which can be sold by the Chemist



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only on the prescription of the doctors, but, Schedule-L drugs are not sold across the counter, but, are sold only to the Hospitals and Clinics.

38. In the case of *Cadila (supra)*, the Hon'ble Supreme Court considered large number of judgments of Foreign Courts as well as Indian Courts and laid down the following principles:-

(a) Though drugs are sold under prescription, the actual conditions of the society have to be kept in mind.

(b) Dispensing of drugs by the Chemists in urban and rural areas as also the linguistic difference, lead to higher level of confusion.

(c) Strict measures to prevent confusion especially in medicinal cases should be taken.

(d) Public interest supports that a lesser degree of proof is required for a plaintiff to prove infringement in a pharmaceutical case if the marks are similar especially in medicinal cases.

(e) Since confusion in drugs and medicines could be life threatening, drugs should be treated as poisons and not sweets.

(f) In a society like India, doctors are under tremendous pressure and therefore, any confusion at their level should also be avoided.

(g) Drugs are available on verbal requests even on telephone and



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therefore, there are higher chances of confusion.

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(h) Under Section 17-B of the Drugs and Cosmetics Act, 1940, any drug, which is an imitation or resemblance of another drug, is in fact a spurious drug which even has penal consequences.

39. As seen from the above summarised principles, it is clear that the burden to prove infringement by a registered proprietor of a trademark is relatively lighter in case of medicinal drugs, more particularly, Schedule-H drugs, which can be sold only through a medical prescription issued by a doctor.

40. The likelihood of confusion or deception amongst the consuming public is a sine qua non element in an action for infringement or passing off. There are various parameters that are taken into consideration while assessing the degree of likelihood of confusion between two trademarks, such as, the goods and services under the disputing marks, the class of consumer, the trade channels involved, inter alia. The Triple Identity Test, which is an amalgamation of the aforementioned three parameters is often relied upon by the Courts to



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assess the similarity between two marks and/or likelihood of confusion amongst the public.

41. It is settled principle of law that deceptive similarity is adjudged based on the visual, phonetic and structural similarity between the marks in question. The process of assessing similarity between two composite marks births direct conflict between the rule of "anti-dissection" and "the rule of dominant feature". While the spirit of the former rule has been captured by Sections 15 and 17 of the Act, the latter is a product of judicial pronouncements.

42. A plain reading of Sections 15 and 17 of the Act evidences the fact that a legislative intent behind these provisions is that where a trademark consists of several elements, it should be viewed as a whole, i.e., as an indivisible unit and unless a part of such a composite trademark is separately subject of trademark protection, the proprietor has no exclusive right over the part of the composite mark. The rule of anti-dissection is based on the basic assumption, that an ordinary prospective buyer would be impressed by the composite mark as a whole



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and not by its component parts. Therefore, the rule of anti-dissection promotes the idea that technical gymnastics should not be done in an attempt to find some minor differences between conflicting marks. On the other hand, over the years the Courts have propounded the rule of dominant feature, which means that a mark is said to be infringed by another trader, if, even without using a whole of it, latter uses one or more of its essential features. This rule is based on the understanding that a consumer of average intelligence having an imperfect recollection might only retain the prominent part of a composite mark. The reflection of rule of dominant feature could be seen in Section 11(b) of the Trademarks Act, which states that a mark ought not to be registered if the said mark is similar to an earlier mark and is being used with respect to similar or identical services and capable of causing confusion and deception amongst the public. Here a deceptively similar mark could also mean a mark wherein the dominant feature of another mark is being used.

43. The Courts in India appear to be in conflict on the applicability of rule of dominant feature and the rule of anti-dissection. In certain



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cases, the rule of anti-dissection has been preferred over the rule of dominant feature, whereas, in certain other cases, it has been the other way round. India being a common law country, the law of precedents, i.e., stare-decises is also an eminent source of law, where there are more similarities and differences in the mark, there must be weighed against one another to see which predominates. Hence, whether the rule of anti-dissection or the rule of dominant feature applies depends upon the facts and circumstances of each case. Therefore, the fundamental criteria for assessing similarity between two trademarks is the likelihood of confusion and there is no one straight jacket rule, that can be relied on to assess the confusion amongst the consumers.

44. Section 2(zb) of the Act defines the term trademark as a mark that is capable of distinguishing the goods and services provided by one person from those of another. In other words, a trademark as an identifier, which means, for example, that when you look at the product, you will be able to trace its origin or the person/company who manufactures such products, so, one is able to identify the person responsible for such a product or service. In general, the purpose of



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having a trademark is to easily recognize the product or service or to stand out from the groups of other manufactures or service providers.

45. Section 2(h) of the Act defines deceptively similar trademark. In simple terms, it means that a mark need not be identical to be called deceptively similar to that of another, but, if it so nearly resembles the other mark, there is a high chance that it will deceive the general public or cause confusion in their minds.

46. The following are the three kinds of deception in trademarks:

(a) Deception concerning the goods:-

When a deceptively similar mark is applied to the goods, which do not belong to the registered trademark owner, a person may purchase such goods thinking that it belongs to a brand which he had in mind while purchasing the goods.

(b) Deception about the trade origin:-

Under this, a person may purchase the goods after recognizing the mark, thinking that they have the same source as that of the other goods bearing a similar mark, with which he is familiar.

(c) Deception concerning the trade connections:-



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Under this, the goods bearing the marks may not be identical, but, they share the same similarity with the mark bearing different goods.

Here, a person purchasing the goods may not think that the goods belong to the same brand that he had in mind, but, due to the similarity between the marks, he may believe that both marks are connected in some way or that they have some kind of association with each other.

47. The three different types of similarity found in the marks are as follows:-

(a) Visual similarity:

The first similarity which is considered for comparison between the marks is the visual similarity and under this, all usual aspects like any common syllables, suffixes, prefixes, shapes, length, etc. of the mark are compared with the other mark.

(b) Phonetic similarity:

To determine whether there is any kind of similarity between the two trademarks, the phonetic similarity in sound is one of the relevant factors to consider, as phonetic similar trademarks can create confusion in the minds of the public.



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(c) Conceptual similarity:

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In this, the similarity is judged based on the message a mark is trying to convey and this type of similarity comes under both phonetic and visual similarity, as it refers to the eyes as well as the top of the ears.

48. We shall now examine the relevant provisions under the Trademarks Act, 1999, which protects the registered proprietor of a trademark.

(a) As per Section 29(2), a registered mark shall be deemed to be infringed if any person/entity without the consent of the registered trademark owner, uses, in the course of trade, a mark identical or similar to or goods and service and under such mark that are identical or similar to those covered by the registered trademark and the result is that it is likely to confuse the minds of the public or people who wrongly associate such mark or goods or services with the owner of the registered trademark .

(b) Section 28(1) of the Act gives the registered owner of the trademark an exclusive right to use the trademark concerning goods and services and he can obtain remedy in respect of an infringement of such



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exclusive right.

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(c) As per Section 102(1)(a)&(b), a person shall be deemed to falsify a trademark, if he makes any addition, alteration or otherwise to any genuine trademark or if he makes the trademark, i.e., identical or deceptively similar without the consent of the trademark owner, and if such person applies such a trademark (identical or deceptively similar) to goods or services or any package containing goods, he shall be deemed to be liable for falsely applying any trademark to goods or services.

(d) As per Section 103 of the Act, any person who falsifies any trademark or falsely applies to a goods or services any trademark or any other act, that confuses the eyes of the public, shall be punished with the imprisonment for a term not less than six months, but, which may extend to three years with fine not less than fifty thousand, but, which may extend to rupees two lakhs.

49. Having analysed the fundamental concepts and principles of trademarks law with particular reference to the principles involving Schedule-H drugs as in the instant case, this Court shall now analyse the case on hand by applying the principles and decide as to whether the



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defendant has committed an act of infringement and passing off.

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50. The following facts as seen from the exhibits marked on the side of the plaintiff and the defendant are undisputed:-

(a) The usage of the plaintiff's trademark “AMIXIDE” is prior in point of time, when compared to the defendant's drug under the mark “KIMIXIDE”, which admittedly was used only from 2002 onwards.

(b) Both the drugs sold under the marks “AMIXIDE” and “KIMIXIDE” are anti depression drugs and they are Schedule-H drugs.

(c) The sales turnover of the plaintiff when compared with that of the defendant is far too higher and is matchless beyond comparison.

(d) The plaintiff has also obtained drug license for the anti-depression drug under the trademark “AMIXIDE” in the year 1984 itself, whereas the defendant has obtained the drug license for its mark “KIMIXIDE” only in the year 2002.

(e) As seen from the exhibits marked on the side of the defendant, the defendant is using the mark “KIMIXIDE” only for the anti depression drug manufactured and sold by it. There are other drugs manufactured by the defendant for other ailments, but, none of those



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drugs are sold by the defendant by using the prefix “KIMI”. The only drug sold by the defendant under the prefix “KIMI” is the anti depression drug, which, the plaintiff claims, is deceptively similar to that of the plaintiff's trademark “AMIXIDE”.

51. The plaintiff has coined the trademark from the ingredients of drug, namely, Amitriptyline and Chlordiazepoxide. The have taken the first three letters in Amitriptyline and the last four letters in Chlordiazepoxide. Admittedly, the plaintiff has been using the trademark “AMIXIDE” for a very long time and even according to the defendant from the year 1999 onwards. Even according to the defendant, they have been using the mark “KIMIXIDE” for their anti depression drug manufactured by them only from the year 2002. They have also filed invoices only from the year 2002, which have been marked as exhibits. Therefore, it is clear that the plaintiff is the prior user of the trademark “AMIXIDE” as the defendant admittedly has been using the mark “KIMIXIDE” only from the year 2002 onwards.

52. The defendant has been using the mark “KIMIXIDE” only for



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anti-depression drug and the ingredients of both the drugs manufactured and sold by both the parties are one and the same and they are Amitriptyline and Chlordiazepoxide. The plaintiff has coined its trademark “AMIXIDE” by taking three letters from 'Amitriptyline' and the last four letters from 'Chlordiazepoxide'. Though the defendant contends that the first two letters of their mark “KI” were taken from their trade name “KIVI LABS LTD.”, it is noticed from various marks used by the defendant that, except for the anti depression drug having the very same ingredients to that of the plaintiff's anti depression drug, the defendant has used only the first four letters of their trade name, namely, 'KIVI', which goes to prove that only to ride over the plaintiff's reputation/goodwill and make unlawful gains, the defendant has used the letters 'KI' and has also taken the last six letters 'MIXIDE' from the plaintiff's registered trademark “AMIXIDE”, which would amount to slavish imitation of the plaintiff's registered trademark “AMIXIDE”. The plaintiff's trademark “AMIXIDE” and the defendant's mark “KIMIXIDE” are also phonetically similar as they sound similar and can create confusion in the minds of the public. Being a medicinal drug, that too, a Schedule-H drug treating depression patients, the burden of proof



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to prove that the defendant is an honest and concurrent user is on the defendant. On the face of it, it is clear that the defendant's mark "KIMIXIDE" is deceptively similar to that of the plaintiff's registered trademark "AMIXIDE". The prior user of the trademark "AMIXIDE" by the plaintiff also proves that the defendant has committed an act of infringement and passing off. The defendant cannot be allowed to pick and choose letters from the plaintiff's trademark "AMIXIDE" in order to illegally attempt to find some minor differences between the conflicting marks. When it is clear from the plaintiff's reputation in the pharmaceutical segment that their trademark "AMIXIDE" has earned a distinct identity and goodwill of its own, it cannot be copied by any other party by using a deceptively similar word mark.

53. The test for proving the passing off is confusion in the minds of the general public having average intelligence and imperfect recollection. Though the anti depression drug manufactured and sold by the plaintiff and the defendant is a Schedule-H drug, which can be sold only through a medical prescription, the plea that on account of the same, there cannot be any confusion in the minds of the general public is



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incorrect, as the Hon'ble Supreme Court in the case of ***Cadila Health***

Care Ltd. Vs. Cadila Pharmaceuticals Ltd. [(2001) 5 SCC 73] has held

that physicians are not immune from confusion or mistake and it is common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently, handwriting is not unmistakably legible. The facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced.

54. In the instant case, the registered trademark “AMIXIDE” of the plaintiff and the defendant's mark “KIMIXIDE” appear too much alike when pronounced, and there is a chance of public confusion, even though the said drugs are sold only through a medical prescription, either due to handwriting of physician or the customers/patients may have an opinion that both the drugs sold by the plaintiff and the defendant are one and the same, on account of they being phonetically and structurally similar. The public should not have any confusion while purchasing a drug, more particularly, Schedule-H drugs, as allowing



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such confusion will have disastrous results causing much harm to the patients, who seek cure for their ailment. The confusion would more likely occur in the case on hand by the incorrect intake of medicine by the patients and may result in loss of life or other serious health problems.

55. The plaintiff's drug under the registered trademark "AMIXIDE" is having a huge turnover, which has been proved by the plaintiff through its documentary evidence. The plaintiff has acquired a reputation of its own for the trademark "AMIXIDE" and by its long and continuous usage, they have also acquired a distinctive identity. On the other hand, the defendant mark "KIMIXIDE", when compared to the plaintiff's registered trademark "AMIXIDE", is of comparatively recent origin. The defendant has also not obtained trademark registration for its mark "KIMIXIDE". Under Section 29 of the Act, the registered proprietor of a trademark must be protected from infringement by any third party. Section 12 of the Act gives protection for an honest and concurrent user. Section 12 of the Act, on the face of it, is applicable only to the trademark registry, when it adjudicates whether a trademark



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can be registered or not. Section 12 is essentially a provision which enables the Registrar to permit registration of a mark which is identical or similar to an existing mark in respect of same or similar goods, but, it does not envisage an honest and concurrent user as a defence to an allegation of infringement of the registered trademark. The Trademarks Act too envisages an honest and concurrent user only as a ground on which concurrent registration of similar and identical marks would be granted by the registry of trademark. There is no provision in the Trademarks Act, which contemplates honest and concurrent user as a defence to a charge of infringement of trademark. Where a case of infringement is made out, necessarily injunction has to follow and it is no defence to the defendant to urge that the usage by the defendant of the alleged infringing mark was honest and concurrent.

56. As regards the argument by the defendant regarding availability of defences under Sections 30, 34 and 35 of the Act as laid down in *Lowenbrau AG and another reported in 2009 SCC Online 45*, the said judgment has no applicability to the facts of the instant case. First of all, the Delhi High Court in that decision was deciding an



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interlocutory application, whereas, in the instant case, this Court is deciding a suit. Section 30 of the Act speaks about honest business practices and use of marks that indicate the kind, quality or intended purpose of the goods/services. Section 34 of the Act saves the right of the prior user of the mark from a registered proprietor and Section 35 saves the right of the person to use ones own name or address or description as a trademark. None of these provisions are applicable to the case on hand, as it is not the case by the defendant that its adoption of the mark "KIMIXIDE" is based on kind, quality or intended purpose of the goods, nor is the defendant claiming to be a prior adopter than that of the plaintiff.

57. The defendant has also not let-in any oral evidence to prove its honesty in adoption. The defendant, who pleads honest and concurrent user, ought to have let-in oral and documentary evidence, as the burden to prove the same vests solely with the defendant. Being a medicinal Schedule-H drug, the burden to prove honest and concurrent user is also heavier. The defendant has miserably failed to prove through oral and documentary evidence that they are an honest and concurrent user. It is



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also clear from the evidence available on record that adoption of the mark “KIMIXIDE” by the defendant for the anti-depression drug is itself dishonest and is likelihood to deceive and cause confusion in the minds of the general public, who will think that the mark “KIMIXIDE” is also associated with the plaintiff.

58. The following factors also will undoubtedly establish that the defendant has failed to prove that they are an honest and concurrent user:-

(a) Admittedly, the plaintiff is the prior user of the registered trademark “AMIXIDE”. Even according to the defendant, the plaintiff has been using the trademark “AMIXIDE” from 1999 onwards. The defendant also admits that the defendant has been using the mark “KIMIXIDE” from 2002 onwards.

(b) Both the plaintiff and the defendant are having a place of their business in Gujarat and they are manufacturing and selling anti depression drugs.

(c) The plaintiff has proved through documentary evidence that they are the prior user of the trademark “AMIXIDE” and their turnover



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and advertisement costs are huge when compared to the defendant's drug manufactured and sold under the mark “KIMIXIDE”

(d) Both “AMIXIDE” and “KIMIXIDE” are deceptively similar marks. The plaintiff has given proper explanation for the method adopted by them for coining the trademark “AMIXIDE”, whereas the defendant's explanation is illogical, as, excepting for the usage of the prefix 'KIMI' in respect of the anti depression drug, they have never used the prefix 'KIMI' for other drugs, sold and manufactured by them, and this would prove that the defendant has copied the plaintiff's trademark “AMIXIDE” to cause confusion in the minds of the general public and to make unlawful gains by riding over the reputation/goodwill of the plaintiff's trademark “AMIXIDE”.

59. It is well settled that in order to decide whether there is trademark infringement, the Triple Identity Test has to be considered. The Triple Identity Test to prove the infringement of the Trademark are (a) use of identical or deceptively similar trademark; (b) use of trademark in relation to identical goods; and (c) use of trademark in relation to identical goods having identical trade channels. The trade channel is the



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way adopted by the companies to sell their products to customers. It is like a path that the product takes from the manufacturer or distributor to the person who buys it. If two companies use the same channel of trade and have similar names, it can be confusing for the customers.

60. The provision dealing with infringement of a registered trademark as a result of phonetic similarity is incorporated under Section 29(9) of the Act, 1999, which states that a mark may be infringed by the spoken use as well as visual representation of words. The Hon'ble Supreme Court has on several occasions affirmed that comparison of trademarks must be done with reference to both ear as well as eye. Phonetic similarity as one of the fundamental tests of comparison is dealt with in *Cadila Healthcare Ltd. (cited supra)*, where the Hon'ble Supreme Court observed that it is not correct in law to hold that the principle of phonetic similarity cannot be used when the manner in which the conflicting words are written is different. The application of this principle can be seen in the decision of the Delhi High Court in the case of *Consitex SA vs. Kamini Jain and others [2011 (47) PTC 337]*, where the Delhi High Court was tasked with the decision on two similar



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sounding marks 'Zenga', an Italian luxury fashion brand (pronounced Zen-Yah) and 'Jenya'. The Delhi High Court held that 'Jenya' was a deceptively similar trademark and if 'Zegna' has not adduced documents in support of the pronunciation of 'Zegna' as 'Zen-Yah', the Court may not have decided in their favour as the two marks otherwise differ significantly. The decision in *Consitex SA(cited supra)* was then referred to in the case of *Imaging Marketing Private Limited Vs. Exotica Mile[AIR Online 2020 DEL 90]*, where the Court, inter alia, held the mark Bout to be phonetically similar to Boat due to similar opening and closing syllables of the words.

61. Telescoping of two parts of words to constitute a mark is a well known practice in business. A distinctive contraction or variation of two common words resulting in a new word conveying no meaning may be registered as an invented word. In the instant case, the plaintiff's trademark "AMIXIDE" has been invented by telescoping of letters from the two ingredients of the anti depression drug, namely, Amitriptyline and Chlordiazepoxide. The plaintiff has coined the trademark "AMIXIDE" by taking first three letters from 'Amitriptyline' and the last



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four letters from 'Chlordiazepoxide'. The word “AMIXIDE” also does not convey any meaning and a valid trademark registration has also been obtained by the plaintiff.

62. The distinctiveness of the mark has to be seen as a whole. It is trite law that a mark in the ordinary circumstances should not be split into two to find out that what meaning the mark conveys. To find out whether a mark is descriptive or not, the mark in entirety has to be considered. The mark being coined one and redundant of any meaning is eligible for registration.

63. It is seen from the above discussion that the plaintiff has satisfied the Triple Identity Test to prove that the defendant has infringed the plaintiff's trademark “AMIXIDE”, on account of (a) use of deceptively similar trademark “KIMIXIDE”; (b) use of trademark in relation to identical goods, namely, anti depression drug, which is a Schedule-H drug; (c) use of trademark “KIMIXIDE” in relation to identical goods having identical trade channels.



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64. As observed earlier, being an anti depression drug, the plaintiff and the defendant will be selling their products to the very same customers using the very same trade channels. Therefore, having deceptively similar marks, namely, “AMIXIDE” and “KIMIXIDE”, there is every possibility that the customers will get confused. Admittedly, the plaintiff is having a huge turnover and they have obtained the drug license in the year 1983 itself and they have also filed documents which have been marked as exhibits to prove that they are in continuous usage of the registered trademark “AMIXIDE” even prior to the defendant's usage of the deceptively similar mark "KIMIXIDE". Even according to the defendant, the defendant is selling their anti depression drug under the mark “KIMIXIDE” only from 2002 onwards.

65. At the risk of repetition, it is to be noted again that physicians are not immune from confusion or mistake and it is common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently, handwriting is not unmistakably legible. The Hon'ble Supreme Court in Cadilla's case (cited supra) further held that the aforementioned facts enhance the chances of confusion or



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mistake by the pharmacists in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced. In the instant case, the anti depression drug sold by the plaintiff and the defendant are Schedule-H drug and therefore, if any iota of confusion is allowed, it will cause serious harm to the patients.

66. As observed earlier, the plaintiff's sales turnover when compared to the defendant's turnover as seen from Ex.P6 (statement of sale of products under the trademark "AMIXIDE"); and Ex.D6 (certificate of turnover of "KIMIXIDE"), will prove that the defendant's turnover is too low and it is matchless beyond comparison. As seen from Ex.P7 (statement of sales promotion expenses), the plaintiff has also incurred huge amount towards advertisement for promoting their anti depression drug sold under the registered trademark "AMIXIDE".

67. The plaintiff's anti depression drug under the trademark "AMIXIDE" has acquired a distinct identity and goodwill of its own by its long and continuous usage atleast from 1999 onwards, though the plaintiff has claimed that they have been using the trademark



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“AMIXIDE” ever since they obtained the license in the year 1984. The plaintiff is obviously the prior user. Excepting for replacing 'A' in “AMIXIDE” with 'KI', the other letters of the defendant mark “KIMIXIDE” are one and the same to that of the plaintiff. The defendant cannot plead that they are an honest and concurrent user of the mark “KIMIXIDE”. Excepting for the anti depression drug, the defendant has not used the letters 'KI' and they have used 'KIVI', its trade name, for other drugs manufactured and sold by them. Admittedly, the plaintiff has been using the trademark “AMIXIDE” from 1999 onwards even according to the defendant, and therefore, the defendant cannot claim that they are an honest and concurrent user, as, even according to them, they have been using the mark “KIMIXIDE” only from 2002 onwards. The surrounding facts and circumstances through the documents marked on the side of the plaintiff will disprove the contention of the defendant that they are an honest and concurrent user of the trademark “KIMIXIDE”.

68. In order to make out acquiescence, it is necessary to establish that the plaintiff stood by and knowingly allowed the defendant to use



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the mark “KIMIXIDE” and to expend money for the promotion and sale of the drug under the trademark “KIMIXIDE”. Though acquiescence may be a good defence, it is for the defendant to prove the same. Acquiescence cannot be inferred just because no infringement action was brought by the plaintiff in the year 2002 itself, when, according to the defendant, they had started using the mark “KIMIXIDE” for the anti depression drug. The plaintiff has categorically stated that they came to know about the usage of the mark “KIMIXIDE” by the defendant just prior to the filing of the suit in the year 2012. When such a categorical stand has been taken by the plaintiff, the burden of proof to show that the plaintiff acquiesced to the usage of the mark “KIMIXIDE” by the defendant is vested solely with the defendant. The defendant has also not let in oral evidence and has not filed any documents to prove that the plaintiff acquiesced to the use of the mark “KIMIXIDE” by the defendant. Therefore, the defence of acquiescence raised by the defendant in this suit has to be rejected by this Court.

69. For the foregoing reasons, issues (1) to (4) framed by this Court, which have been extracted supra, are answered in favour of the



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plaintiff and against the defendant by holding as follows:-

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(a) The use of the mark "KIMIXIDE" by the defendant amounts to infringement of the plaintiff's registered trademark "AMIXIDE".

(b) The mark "KIMIXIDE" used by the defendant is deceptively similar to the plaintiff's trademark "AMIXIDE". The defendant has misused the goodwill/reputation of the plaintiff and has committed an act of passing off.

(c) There is no bonafides on the part of the defendant to adopt the mark "KIMIXIDE", which is deceptively similar to the plaintiff's trademark "AMIXIDE".

(d) The plaintiff is entitled to a decree for permanent injunction as prayed for in the suit, as the defendant has committed an act of infringement and passing off.

70. In the result, the suit is partly decreed by passing a judgment and decree in favour of the plaintiff against the defendant by granting the following reliefs:-

(a) Permanent injunction is granted restraining the defendant, its



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distributors, stockists, servants, agents, retailers, legal representatives, job-workers, manufacturers or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations infringing plaintiff's registered trademark AMIXIDE by use of deceptively similar trademark KIMIXIDE or any mark deceptively similar to the plaintiff's registered trademark AMIXIDE or in any other manner whatsoever;

b) Permanent injunction is granted restraining the defendant, its distributors, stockists, servants, agents, retailers, legal representatives job-workers, manufacturers or any other person claiming under it from in any manner manufacturing, selling, offering for sale, stocking, advertising directly or indirectly dealing in medicinal and pharmaceutical preparations under the trademark KIMIXIDE or any other trademark that is identical and/or deceptively similar as that of the Plaintiffs registered trademark AMIXIDE and/or use similar packaging as that of the plaintiff's products under the mark AMIXIDE so as to pass off the defendant's medicinal preparations as and for the medicinal preparations of the plaintiff and/or in any other manner whatsoever connected with



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the Plaintiff;

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(c) The defendant, who may be holding the stocks of anti-depression drugs under the mark “KIMIXIDE” on account of their usage earlier, is directed to destroy the said stocks available within a period of one month from the date of receipt of a copy of this judgment.

(d) Eventhough the plaintiff has claimed other reliefs, namely, reliefs (c), (d) & (e) in the plaint, no issues with regard to the said claims were framed by this Court and the learned Senior counsel for the plaintiff, during the course of his submissions, did not also press for the same. No evidence is also available on record to enable this Court to consider reliefs (c), (d) & (e) sought for in the plaint. The reliefs (c), (d) & (e) sought for in the plaint are therefore dismissed.

(e) The defendant is directed to pay the costs of the suit.

11.03.2024

Index: Yes/ No

Speaking order / Non speaking order

Neutral citation : Yes / No

ab/vga/rkm



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Plaintiff's witness:

NIL

Documents exhibited on the side of the plaintiff:-

Exhibit	Description
P1	Registration certificate for trademark AMIXIDE under No.1748417 in class 5 dated 27/10/2008
P2	Product permission granted by Food and Drug Control Administration in respect of medicinal product under the mark AMIXIDE dated 29/10/2008
P3	Product brochure of plaintiffs AMIXIDE drug
P4	Extract from medical journals in relation to plaintiffs product under the mark AMIXIDE
P5	Invoice raised for the sale of products under mark AMIXIDE
P6	Chartered Accountant certified statement of sales of products under the mark AMIXID dated 06/02/2012
P7	Chartered Accountant certified statement of sales promotion expenses with respect to products under the mark AMIXIDE dated 06/02/2012
P8	Legal notice issued by the plaintiff dated 09/10/2010
P9	Reply sent by the defendant along with postal cover dated 18/10/2010
P10	Notice of opposition filed by the plaintiff against defendants application for registration of the mark KIMIXIDE dated 10/11/2010
P11	Counter filed by the defendant in Form TM 6 dated 13/06/2011
P12	Plaintiffs AMIXIDE cartons
P13	Defendants KIMIXIDE carton

Defendant's witness:-



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NIL

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Documents exhibited on the side of the defendant:-

Exhibit No.	Description
D1	Certificate of incorporation
D2	KIMIXIDE Drug Controller approval for year 2002 to 2007
D3	KIMIXIDE Drug Controller approval for year 2006 to 2011
D4	KIMIXIDE Drug Controller approval for year 2011 to 2016
D5	KIMIXIDE Drug Controller approval for year 2016 to 2021
D6	Certificate of turnover of KIMIXIDE
D7	Invoice copy for year 2002
D8	Invoice copy for year 2003(12 invoices)
D9	Invoice copy for year 2004 (12 invoice)
D10	Invoice copy for year 2005 (11 invoice)
D11	Invoice copy for year 2006 (10 invoices)
D12	Invoice copy for year 2007 (9 invoices)
D13	Invoice copy for year 2008 (12 invoices)
D14	Invoice copy for year 2009 (10 Invoices)
D15	Invoice copy for year 2010 (13 invoices)
D16	Invoice copy for year 2011 (14 invoices)
D17	Invoice copy for year 2012 (2 invoices)
D18	Invoice copy for year 2013 (2 invoices)
D19	Invoice copy for year 2014 (3 invoices)
D20	Invoice copy for year 2015 (3 invoices)
D21	Invoice copy for year 2016 (3 invoices)
D22	Invoice copy for year 2017 (2 invoices)
D23	Invoice copy for year 2018 (3 invoices)
D24	Invoice copy for year 2019 (3 invoices)
D25	Invoice copy for year 2020 (3 invoices)
D26	Invoice copy for year 2021 (6 invoices)



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Exhibit No.	Description
D27	Renewal of license for year 2016 to 2021
D28	KIMIXIDE label
D29	KIMIXIDE label
D30	KIMIXIDE label
D31	KIVI LABS label
D32	KIVI LABS label
D33	KIMIXIDE label
D34	KIMIXIDE label

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