

Johnson and Johnson Vs. Lupin Limited and Anr

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Court : Delhi

Decided On : Feb-27-2015

Judge : Manmohan Singh

Appellant : Johnson and Johnson

Respondent : Lupin Limited and Anr

Judgement :

.* IN THE HIGH COURT OF DELHI AT NEW DELHI Judgment pronounced on:

27. h February, 2015 % + I.A. No.11918/2012 in CS(OS) 1931/2012 JOHNSON & JOHNSON Through Plaintiff Mr. Sudhir Chandra, Sr. Adv. With Mr. Deepak Gogia & Ms. Priya Rao, Advs. versus LUPIN LIMITED AND ANR Defendants Through Mr. Kirti Uppal, Sr. Adv. With Ms. Alka Parelkar, Mr. Varun Singh, Mr. Anuj Sharma & Mr. Anshumaan Sahni, Advs. for D-1 CORAM: HON'BLE MR.JUSTICE MANMOHAN SINGH MANMOHAN SINGH, J.

1. The plaintiff has filed the present suit for permanent injunction restraining passing off and rendition of accounts and/or damages, against the defendants in respect of the mark LUCYNTA.
2. By this order, I propose to decide the pending application being I.A. No.11918/2012 filed by the plaintiff under Order 39 Rule 1 and 2 CPC read with Section 151 CPC.

3. Brief facts of the case as per plaint are : i) That the plaintiff, a corporation organized and existing under the laws of State of New Jersey, USA, was founded in the year 1886. The plaintiff along with its group companies claims to be the world leaders in pharmaceutical and consumer products. It is stated that plaintiff has a highly diversified business with at least 250 subsidiaries in 57 countries around the world. ii) Plaintiff's subsidiary Johnson & Johnson Limited was incorporated in India in the year 1957. It is averred that the same is today amongst the leading manufacturers, merchants, dealers and distributors of human pharmaceutical preparations in India. With over last more than 50 years presence in India, plaintiff has gained reputation for offering high-quality products at competitive prices. iii) It is averred that the plaintiff in the year 2008, adopted the mark NUCYNTA in relation to its Tapentadol based drug, an opioid pain reliever. Tapentadol, which is in a class of medications called opiate (narcotic) analgesics and is used to treat moderate to severe pain that is expected to last for a short time. iv) Plaintiff through its fully owned subsidiary Ortho-McNeilJanssen Pharmaceuticals, Inc. (now Janssen Pharmaceuticals Inc.) applied for the New Drug Application (NDA) for NUCYNTA before United States Food and Drug Administration (FDA) which was granted on 20th November, 2008. v) NUCYNTA was launched in USA on 22nd June, 2009 where it has been continuously and extensively used since then. Plaintiff also obtained the FDA approval in the August 2011 for NUCYNTA ER, an extended release formulation of Tapentadol indicated for the management of moderate to severe chronic pain in adults when a continuous, around-the-clock opioid analgesic is needed for an extended period of time. vi) Also, plaintiff launched NUCYNTA CR in Canada in the year 2011 for the treatment of moderate to moderately severe pain in adults, which is continuously in use since then. vii) It is averred that plaintiff has applied for and/or obtained registration for the trademark NUCYNTA in several countries as detailed in para 3.7. of the plaint. viii) It is averred that the sales of NUCYNTA in USA accounted for more than \$ 290 million for the period 2009- 2012 while the plaintiff incurred an expenditure of more than US \$ 650 million on promotion of NUCYNTA since its launch. The trademark NUCYNTA and product thereunder has been widely advertised and promoted through various media including electronic and print media over the years. ix) The information pertaining to plaintiff's products under

NUCYNTA is available and displayed on various websites like www.nucynta.com, www.jnj.com, www.drugs.com, www.wikipedia.com etc. The domain name "nucynta.com" was registered on 29th October, 2008. It is averred that easy availability of information regarding NUCYNTA has contributed immensely in enhancing the reputation and awareness of the said trademark worldwide including India.

4. It is averred that the plaintiff is the original, prior and honest adopter and user of the trademark NUCYNTA, which it has been using continuously, extensively and uninterruptedly since the year 2009 in USA. The drug bearing the trademark NUCYNTA is well known and has been discussed in several international conferences and seminars. Medical literature relating to plaintiff's products including NUCYNTA is freely available in India. The plaintiff has acquired worldwide reputation and enjoys trans-border reputation and/or spill over reputation in India. When the suit was filed, the plaintiff had intended to launch its drug bearing NUCYNTA in India and had also filed a trademark application under No.2199474 in class 5 for Human Pharmaceutical Preparations which was pending at the time of filing of the suit.

5. It is the case of the plaintiff that sometime in the month of March 2012, plaintiff's attention was drawn to defendant No.1's drug for the treatment of oncology related ailment containing Tapentadol being sold under the mark LUCYNTA. Defendant No.1 is the manufacturer and supplier of the pharmaceutical product bearing the mark LUCYNTA. Defendant No.2 is the distributor of the defendant No.1's product in Delhi. It was revealed on further enquiry that defendant No.1 had applied for registration of the mark LUCYNTA under No.2011950 dated 20th August, 2010 in class 5 for 'medical and pharmaceutical preparation and substances' on proposed to be used basis. During the course of plaintiff's investigation, defendant No.1's application for the mark LUCYNTA proceeded to registration.

6. It is averred by the plaintiff that by virtue of its long and extensive use, publicity and promotion, the mark NUCYNTA is associated and identified by the members of the trade and public exclusively with the plaintiff and/or its group companies. The adoption and use by defendant No.1 of the mark LUCYNTA which is virtually

identical to and/or deceptively similar to plaintiff's mark NUCYNTA structurally and CS(OS) No.1931/2012 phonetically and that too for an both identical Page 4 of 37 pharmaceutical preparation, is an inherent dishonest adoption and calculated misrepresentation to the consuming public that their business and products under the mark LUCYNTA owe their origin to or are licensed by the plaintiff. This misrepresentation by the defendant is calculated to take an unfair advantage and is causing and/or likely to cause damage to the plaintiff's exclusive propriety rights and goodwill in the mark NUCYNTA. The defendant is trying to usurp the goodwill and reputation attached to the plaintiff. Also, the possibility of confusion of one medical product for another by the consumer is much higher in the pharmaceutical segment. It is averred that unless the defendants are restrained, grave loss and injury will continue to cause not only to the plaintiff's valuable intellectual property rights but also to public at large.

MAIN DEFENCE IN THE WRITTEN STATEMENT

7 On the other hand, defendant No.1 in his written statement has stated that the present suit is not maintainable. On plaintiff's own admission, defendant No.1 is the registered proprietor of the mark LUCYNTA. It is contended that there was no opposition in respect of the said mark which was duly examined by the examiner of trademarks and duly advertised in the Trade Marks Journal. It is contended that defendant No.1 has obtained necessary statutory permissions including permission under Drugs and Cosmetic Act. It is stated that defendant No.1 has been manufacturing and marketing its product under the mark LUCYNTA since September/October, 2011 and launched its product in October, 2011 and the same has acquired enormous reputation and goodwill.

7.1 It is contended that defendant No.1 is a highly reputed and ranks amongst the top five in the Indian Pharmaceutical companies whose products are well accepted by the medical fraternity, members of the public and traders. While on the other hand, plaintiff's product has not been manufactured, sold or marketed under the mark NUCYNTA in India.

7.2 Defendant No.1 is the registered proprietor of the mark LUCYNTA which has been adopted originally, independently, honestly and bonafidely in or around August, 2010. The mark LUCYNTA is solely associated with defendant No.1. In fact now the plaintiff wants to enter the Indian market with the mark NUCYNTA in respect of pharmaceutical goods, which is likely to cause confusion and deception in the market. It is contended that the plaintiff intends to trade on

the goodwill and reputation of defendant No.1 and intends to pass off its goods as that of defendant No.1. Aggrieved of the same the defendant No.1 has filed a suit against the plaintiff on 18th July, 2012 bearing Lodging No.1842/2012 before the Bombay High Court. 7.3 It is contended that defendant No.1 has been using the mark LUCYNTA openly, continuously and extensively since October, 2011. The defendant No.1 has expended a substantial sum of money in its launch in popularizing its products bearing mark LUCYNTA. Defendant No.1 has promoted and advertised its products under the mark LUCYNTA which has resulted into the mark LUCYNTA being popular in the Indian pharmaceutical market and a well known trademark. 7.4 While the defendant No.1 had applied for registration of the mark LUCYNTA on 20th August, 2010 vide application number 2011950 which was advertised in the Trade Marks Journal on 8th August, 2011, the plaintiff had applied for registration of the mark NUCYNTA on 2nd September, 2011 vide application number 2199474. It is contended that plaintiff on the date of making the application for registration apparently had notice and ought to have been aware of defendant No.1's mark LUCYNTA. Despite of such knowledge, plaintiff neither took any action against defendant No.1 nor opposed the registration of the mark LUCYNTA. Therefore, the plaintiff has acquiesced the use of the mark LUCYNTA by defendant No.1, therefore, estopped from challenging the use of the same by defendant No.1.

8. Defendant No.2 has also filed a written statement wherein it is contended that defendant No.2 has unnecessarily been impleaded as a party in the matter. Plaintiff has no right or cause of action against defendant No.2. The suit is bad for misjoinder of parties. Defendant No.2 has also contended that defendant No.1 is the registered proprietor of the mark LUCYNTA and the plaintiff has no right to question defendant No.2's distribution and selling of the product bearing the mark LUCYNTA. Defendant No.2 has denied and disputed the other averments made in the suit. REPLICATION TO THE WRITTEN STATEMENT⁹ In the replication filed by the plaintiff, the plaintiff has averred that defendant No.1 has failed to give any plausible or justifiable reason for adoption of the mark LUCYNTA which is virtually identical to plaintiff's reputed mark NUCYNTA, which is a coined word/mark. It is averred that the written statement filed by defendant No.1 does not disclose as to how defendant No.1 came to adopt the mark LUCYNTA and that too in relation to

identical pharmaceutical preparation. While all the contentions of the defendant No.1 are disputed, it is stated that this suit filed by the plaintiff came up for hearing before the Court on 6 th July, 2012 when the notice was issued to the defendants. On 16th July, 2012, defendant No.1 entered appearance before the Court through counsel and sought time to file reply to plaintiff's interim application. The matter was accordingly adjourned to 12th September, 2012 for hearing arguments on plaintiff's interim application. In the meanwhile on 18th July, 2012, plaintiff received an email from defendant No.1's counsel informing the plaintiff about the factum of the Bombay suit. It is averred by the plaintiff that defendant No.1 took time on 16th July, 2012 in the garb of filing a reply but in fact filed the Bombay suit only as an afterthought merely to harass the plaintiff and to prevent it from using the mark NUCYNTA which is a coined mark and in existence since 2008. However no interim injunction was passed against the plaintiff in the Bombay suit. The plaintiff has also denied that any statement is made by the counsel in the Bombay suit that the plaintiff would not launch its products on commercial scale in India and denied the statement of defendants made in the affidavit. In the replication, plaintiff has denied the contentions raised by defendant No.2 and stated that defendant No.2 is admittedly the distributor of defendant No.1 who is engaged in distribution of the pharmaceutical products of defendant No.1 including the product under the mark LUCYNTA. Defendant No.2 along with defendant No.1 has derived and continuous to derive unjust monetary gains through sale of the product under the mark LUCYNTA. The plaintiff therefore has a valid and subsisting cause of action against defendant No.2.

10. In order to establish prior adoption and user, the plaintiff has filed following document : i) The plaintiff, through its fully owned subsidiary Ortho-McNeilJanssen Pharmaceuticals, CS(OS) No.1931/2012 Inc. (now Janssen Page 8 of 37 Pharmaceuticals Inc), filed an application on 22nd January, 2008 before the United States Food and Drug Administration (FDA) seeking approval for manufacturing NUCYNTA, an opioid pain reliever based on Tapentadol. ii) The plaintiff on 29th October, 2008 registered the domain name . iii) FDA granted approval on 29th October, 2008 for NUCYNTA. iv) The plaintiff filed a trademark application on 28th November, 2008 seeking registration of the mark NUCYNTA in USA. v) The mark NUCYNTA is registered in the name of the plaintiff in around 19 countries across

the world. vi) The plaintiff launched NUCYNTA in USA on 22nd June, 2009 through its subsidiary Janssen Pharmaceuticals Inc.

11. The plaintiff has also filed certain documents about the awareness of the mark NUCYNTA in India by way medical practitioners, research scholars etc. and the drug sold under the said mark in other countries at the world. The details of the said documents are given as under: i) Article titled Recent Advances in Postoperative Pain Management published in Yale Journal of Biology and Medicine. ii) Article titled Tapentadol - A Novel Analgesic published in Journal of Anaesthesiology Clinical Pharmacology. iii) Article titled Simple, rapid and cost effective method for routine analysis of Tapentadol Hydrochloride: A novel analgesic drug in bulk and pharmaceutical dosage form by RP-HPLC published in Pharma Science Monitor. iv) Article titled Pharmacological aspects of Tapentadol published in International Journal of Pharma & Bio Sciences. v) Article titled Emerging concepts in post-operative pain management published in Indian Journal of Anaesthesia.

12. The pharmaceutical industry in India is also aware of the plaintiffs mark NUCYNTA as per the case of the plaintiff and documents produced i.e. a) Print out taken from the website www.cadilapharma.com. b) Print out of an article dated 17th May, 2011 taken from the website www.thehindubusinessline.com.

13. The print & electronic media in India have written about the products sold under the plaintiffs mark and/or product which is evident from the following documents filed by the plaintiff : i) Print out of an article dated 4th October, 2010 taken from the website www.zeenews.com. ii) Print out of an article dated 17th May, 2011 taken from the website www.thehindubusinessline.com. iii) Print out of an article dated 30th August, 2011 taken from the website www.pharmabiz.com. iv) Print out of an article dated 26th August, 2011 taken from the website www.in.news.yahoo.com. v) Print outs taken from the website www.medindia.net.

14. The defendant in its written statement has admitted that the mark in question is used since September/October, 2011. Earlier to this date, the defendants filed its application for Registration on 20th August, 2010 as proposed to be used vide application No.2011950. On the other hand, the plaintiffs case is that the mark

NUCYNTA was adopted in overseas countries in January, 2008 and was first time used in U.S.A in June 2009. Thus, it cannot be denied by the defendants that the plaintiff is prior adopter and user of the mark in overseas countries definitely prior to the defendant.

15. The defendant No.1 has not denied the fact that it has claimed and made the declaration in public that defendant No.1 is selling its pharmaceutical preparation under the mark LUCYNTA and the said drug has been approved by US FDA which in fact is untrue as no such approval was granted to the said defendant. The defendant No.1, who is in the same line of business who claims to be amongst top five pharmaceutical companies in India having a global presence including in USA, where the plaintiffs mark was already established by the plaintiffs trademark NUCYNTA. On the date of adoption and user of the defendants mark, the defendants themselves have filed the following documents which would show the presence of defendant No.1 in U.S.A. a) Print out from the website of US based subsidiary (Lupin Pharmaceuticals Inc.) of defendant No.1, www.lupinpharmaceuticals.com. b) Print outs from the official website of U.S Food and Drug Administration evidencing the drug approvals obtained by defendant No.1 in USA. c) Print outs from the official website of U.S Food and Drug Administration evidencing the drug approvals obtained by defendant No.1s US based subsidiary Lupin Pharmaceuticals Inc. d) Relevant extracts from the publication Approved drug products with therapeutic equivalence evaluations 32nd Edition, published by US Department of Health and Human Services evidencing active presence of defendant No.1 in USA. e) Print outs taken from the official website of defendant No.1 www.lupinworld.com and that of its US based subsidiary www.lupinpharmaceuticals.com.

16. Both the parties have made their respective submissions in the pending application being I.A. No.11918/2012 under Order 39 Rule 1 and 2 CPC. This matter is at the stage of evidence.

17. Before dealing with the rival submissions of both the parties, it is necessary to mention here few admitted positions in the matter, in view of pleadings of the parties. The details of the same are given as under: i) The defendant has admitted

in its suit that both rival matters NUCYNTA and LUCYNTA are similar. ii) Both parties are using their trademark in relation to identical goods i.e. the drug in question for identical preparation. iii) In case both trademarks are used in India, it would create confusion and deception in the market as per admitted case of the defendants. iv) That the plaintiff is the prior adopter and user of the trademark NUCYNTA in overseas countries. v) The plaintiff is the first party who has obtained the drug licenses in overseas countries prior to the defendant. vi) The defendant has another trademark TRANSDOL and which is being used in relation to the same drug, for the identical product. vii) In an action of passing off, the interim order can be passed against the registered proprietor. viii) The validity of the registered trademark can be challenged in the civil suit as held by the Full Bench of Mumbai High Court in the suit filed by the defendant against the plaintiff herein. ix) The defendant did not get the interim order against the plaintiff on the basis of registered trademark obtained by the defendant. x) Patients and customers of both rival drug are same as it is meant for same salt and treatment. xi) That both parties have filed their suit against each other in order to assert independent rights claiming ownership of the trademarks on the basis of prior user.

18. In the suit for infringement of its trademark LUCYNTA was filed by the defendant No.1 on 26th July, 2012 in the Bombay High Court bearing Suit (L.D.G.) No.1842/2012 against the plaintiff herein in which it was contended that the plaintiff would be committing an act of infringement by using the mark NUCYNTA. Defendant therein (the plaintiff herein) raised a plea of invalidity of plaintiffs registration to resist the interlocutory reliefs pressed by plaintiff therein. In the said suit before High Court of Bombay, the Full Bench on 23rd December, 2014 gave detailed judgment, inter alia, by coming to the conclusion that a challenge to the validity of the registration of the trademark can finally succeed only in rectification proceedings before the Intellectual Property Appellate Board. However, there is no express or implied bar taking away the jurisdiction and power of the Civil Court to consider the challenge to the validity of the trademark at the interlocutory stage by way of prima facie finding, though a heavy burden lies on the party to challenge the validity of the trademark in order to rebut the strong presumption in favour of the plaintiff on the basis of registration at the interlocutory stage and in case the Court finds that registration is ex-facie illegal and fraudulent the Court may decline

to grant relief in favour of the party who is having the registered trademark.

19. It appears from the pleading of the defendants that their main case is that the plaintiff is not using mark NUCYNTA in India no reputation and/or goodwill is associated with plaintiff herein in respect of the mark NUCYNTA in India. Secondly, defendant No.1 is selling the products under the trademark LUCYNTA in India under its name since October, 2011. Further Goodwill is territorial in nature. Mere knowledge of mark cannot be equated with goodwill. There is something more that is required to culminate the knowledge of the mark into reputation, goodwill within the territory, efforts taken by the owner of the mark to popularize, market the products in the territory so as to create association in the minds of members of trade and public and thereby acquire reputation and goodwill. It is an admitted position that plaintiffs are not using the trademark NUCYNTA in India. Large number of decisions are referred by Mr. Kirti Uppal, learned Senior counsel appearing on behalf of the defendants.

20. It is alleged by Mr. Uppal, learned Senior counsel that the defendant No.1, in compliance of order dated 26th July, 2013, has filed an affidavit on 7th August, 2013 stating that the plaintiff herein and defendants in the suit (Lodging) No.1842/2012 on 26th July, 2012 made a statement that they would not launch its product in India during the pendency of the proceedings. The said fact has been denied by the plaintiff, counsel says that no such statement was made. Mr. Uppal argues that even otherwise, the plaintiff in its arguments on 10th October, 2013 before this Court had submitted that they were yet to launch its product in India. The suit was filed on 4th July, 2012 and plaintiff till date has failed to show that it has initiated any steps to launch its product in India. There is no change in circumstances since the filing of the present suit. In the affidavit filed on 28th January, 2013, in compliance of order dated 8th January, 2013, defendant No.1 further affirmed the sales and promotional figures of its trademark. It was stated therein that mark TRANSDOL was adopted subsequent to the adoption of mark LUCYNTA and it is common business practise to use two or more marks for the same molecule as marks are coined as per the departmental requirements of defendant No.1.

21. Learned Senior counsel has referred number of decisions in support of his submission that unless the mark is used in India, no injunction order can be passed against the defendants. As regard the documents filed by the plaintiff, it is argued that the publications, websites it is not established whether substantial segments of members of trade and public associate the product bearing the mark NUCYNTA with plaintiff in India.

22. It is argued by Mr. Uppal, learned Senior counsel that plaintiff is neither the earlier registered proprietor nor the earlier user of the mark NUCYNTA in India. Plaintiff has not undertaken any promotional activity whatsoever to launch its product under the mark NUCYNTA in India whereas defendant No.1 is the registered proprietor and is earlier user of the mark LUCYNTA in India. CS(OS) No.1931/2012 convenience lies in favour of the defendant No.1 and against the plaintiff.

23. Let me now discuss the rival arguments of both the parties issuewise. Similarity of two trademarks, NUCYNTA and LUCYNTA²⁴ The defendant No.1 in its suit filed in Bombay High Court in para 29 has admitted that two marks are similar. Relevant extracts are reproduced as under :

29. The Defendant is also set to infringe the Plaintiffs said registered trade mark. The Plaintiff states that the mark NUCYNTA of the Defendant is almost identical to the registered mark LUCYNTA and NUCYNTA.

Identical Goods 25. In para 22 and 29 of the suit filed before Bombay High Court, the defendant has admitted that the mark NUCYNTA of the plaintiff is almost identical to the registered mark LUCYNTA and NUCYNTA is being used by the plaintiff in respect of identical goods. Confusion and Deception 26. In para 29 of the suit filed before Bombay High Court, the defendant stated that LUCYNTA is deceptively similar to NUCYNTA and the plaintiff is proposing to use the same in respect of identical goods and therefore there exists likelihood of confusion and/or likelihood of association with that of the plaintiff.

27. In view of admissions made by the defendants in their pleading, no further discussions are necessary with regard to similarity of marks, identical medicines,

confusion and deception. Prior user 28. It is settled law that any action for passing off in order to succeed in getting an interim injunction, the plaintiff has to establish user of the mark prior in point of time than the user of the defendant. Reliance is placed on *Century Traders vs Roshan Lal Duggar Co.*, AIR1978 Delhi 250 (DB) (para 14). Goodwill and Trans-Border Reputation 29. One of the essential ingredients is goodwill. The classic case of passing off as it existed since its genesis always insist the existence of goodwill of a merchant in order to give him a locally enforceable right to sue for passing off.

30. This has been explained by Kerlys in his book called *Law of Trade Marks and Trade Names* (Fourteenth Edition) (South Asian Edition 2007), wherein the concept of goodwill has always been categorized as local in character and the learned author observed thus:

Since an essential ingredient of passing off is damage (or prospective damage) to goodwill, he (the Plaintiff) must show that he had, at the date when the Defendants started up, in this country not merely a reputation but a goodwill capable of being damaged. Goodwill, however, is local; it is situated where the business is. Thus a foreign claimant may have a reputation in this country-from travellers or periodicals of international circulation or, increasingly, from exposure on the Internet-yet still fail in an action for passing off because he has here no business and so no goodwill. Such cases have been not uncommon in recent years, and have caused considerable difficulty. Where there is a substantial reputation here, our courts will often accept minimal evidence that a business exists here, but there has to be some.

31. This concept of goodwill and the insistence of localized business has been traditional concept of passing off which sometimes is called as classic case of passing off. The concept of passing off has undergone changes due to advent of technology and modernization. The courts entertaining the case of passing off can discount the localized existence of goodwill and the business in the territory specific if the substantial nature of reputation has been proved which has some kind of nexus in the territory where the protection is sought and the said concept in the modern language is called trans-border reputation whereas the goodwill is

always local in character, the concept of reputation is dynamic and is all encompassing.

32. The reputation of a person can transcend boundaries by virtue of its advertisement in the newspapers, media circulation, expatriate reputation due to cultural akinness and all other relevant factors which connect one countrys business with that of another. This has been aptly explained by the Division Bench of this Court in the case of N.R.Dongre v. Whirlpool Corporation, AIR1995 Delhi 300 wherein the concept of trans-border reputation was approved in the following words:

(25) Thus a product and its trade name transcend the physical boundaries of a geographical region and acquire a trans border or overseas or extraterritorial reputation not only through import of goods but also by its advertisement. The knowledge and the awareness of the goods of a foreign trade and its trade mark can be available at a place where goods are not being marketed and consequently not being used. The manner in which or the source from which the knowledge has been acquired is immaterial.

33. The said judgment of Whirlpool [supra]. has been approved by the Supreme Court in the case of N.R. Dongre and Ors. vs Whirlpool Corpn. and Anr., 1996 (2) Arb.LR488(SC) wherein the law laid down by the Division Bench of this Court was again reiterated. This exposition of 1996 in the case of Whirlpool [supra]. has been further revisited by the Courts in India more importantly in the case of Allergan Inc. v. Milment Oftho Industries, 1999 PTC (19) (DB) 160 wherein it has carefully analyzed the interplay between the goodwill and reputation in a case of passing off action and has laid down that the Courts in India have followed the third approach which is a middle path wherein strict insistence of localized business is not necessary. However, reputation which is sought to be protected has to be substantial one having global character. The observation made by Honble Judge is as under:

13. Reputation is the connection that the public makes between a particular product or service and a particular source which may or may not be known. Some Courts have held that reputation which is built up on the basis of trade within the

country is entitled to protection from passing off. Other Courts have made some concession to the communication explosion and held that if the plaintiff has a reputation in another country, his right to the mark will be protected if it is coupled with some actual or proposed business activity within the country (See *Alain Beniardin et Cie v. Pavilion Properties*, (1967) RFC581 *Amway Corporation. v. Eurway Int. Ltd.* (1974) RFC82) Still other Courts have held that with the increase in international commerce, mass media communications and the frequency of the foreign travel, political and geographic boundaries do not stem the exchange of ideas and instant information. Local business is not an essential ingredient of a passing off action. However, the reputation must be well established or a known one See : *Panhard et Levassor v. Panhard Motor Co. Ltd.*, (1901) 18 RPC405 *Sheraton Corpn. v. Sheraton Motels*, (1964) RPC202 *Orkin Exterminating Co. Tnd. v. Pest Co. of Canada* (1985) 5 Canadian Patent Reporter 433; *Vitamins L. D.'s Application for Trademark*, 1956 (1) RPC1 The decisions which reflect the first and second view have so held for reasons which are partly historic, partly geographic and partly because reputation was equated with goodwill. Goodwill has been defined as the benefit derived from reputation. It is not the reputation required to found a passing off action. The law of passing off is not trammelled by definitions of goodwill developed in the field of revenue law [per Hockhart J., *Conagra Inc. v. McCain Foods (Aust) P. Ltd.*, 1993 (23) IPR193231].. It is an asset of a business assessable in terms of money and transferable (See *IRC v. Muller*, (1901) AC217 *Trego v. Hunt* (1896) AC7 *ITC v. B.C. Srinivas Shetty*. In my opinion reputation forming the basis of a passing off action need not be so localised. Whatever the compulsion for the Courts taking the first or second view in other countries, as far as this country is concerned, Courts in India prescribe to the third view and have held that a plaintiff with a reputation which is established internationally can sue to protect it in this country even if it does not have any business activity here. In other words reputation of a product may precede its introduction and may exist without trade in such product in the country. See *N.R. Dongre v. Whirlpool Corporation*, (DB); J.

N. Nichols (Vimto) Ltd. v. Rose & Thistle, 1994 PTC83(DB); *Calvin Klein Inc. v. International Apparels*, (1995) FSR515:

1995. IPLR83 Conagra Inc. v. McCain Foods (Supra) at p. 133.

34. The said judgment passed in the case of Milment (supra) passed by Division Bench of Kolkata High Court has been further approved by Supreme Court of India in the case of Milment Oftho Industries v. Allergan Inc., (2004) 12 SCC624 wherein the Supreme Court has laid down that :

It must also be remembered that nowadays goods are widely advertised in newspapers, periodicals, magazines and other media which is available in the country. This results in a product acquiring a worldwide reputation. Thus, if a mark in respect of a drug is associated with the Respondents worldwide it would lead to an anomalous situation if an identical mark in respect of a similar drug is allowed to be sold in India. However one note of caution must be expressed. Multinational corporations, who have no intention of coming to India or introducing their product in India should not be allowed to throttle an Indian Company by not permitting it to sell a product in India, if the Indian Company has genuinely adopted the mark and developed the product and is first in the market. Thus the ultimate test should be who is first in the market. It was further observed on the facts of the case as under:

(9) In the present case, the marks are the same. They are in respect of pharmaceutical products. The mere fact that the Respondents have not been using the mark in India would be irrelevant if they were first in the world market. The Division bench had relied upon material which prima facie shows that the Respondents product was advertised before the Appellants entered the field. On the basis of that material the Division Bench has concluded that the Respondents were first to adopt the mark. If that be so then no fault can be found with the conclusion drawn by the Division Bench.

35. The position of law uptill Milment (supra) has been followed that the Courts in India by placing reliance on the said decision have proceeded to grant interim orders to the multi-nationals having their brands which are of global character and prevented the misuse of the said brands by protecting trans-border reputation subject to fulfilling of essential characteristics necessary to prove trans-border reputation. The decision in the case of Milment (supra) was also rendered in the year 2004 when the impact of internet, e-commerce, social media was yet to be

seen and realized.

36. In the case of Cadbury U.K. Limited & Anr vs. Lotte India Corporation Ltd., reported in 2014 (57) PTC422(Delhi) wherein the decision of law relating to trans-border reputation has been further strengthened and has been taken to another level wherein the court has not merely relied upon the decision of Milment (supra) and Whirlpool (supra) but has also extended the principle of trans-border reputation by observing that the existence of a merchant on web pages which are of foreign origin and social media are sufficient to show the trans-border nature of reputation without having any activity in India at the relevant time. Though it is very broad extension of the concept of trans-border reputation, but it is a question of fact in each case as to how the internet documents are sufficient to show the global character of the trademark and the reputation attached to the same. The impact of the said decision which has been given very recently is yet to be seen and analyzed by the other Courts in India in the upcoming times. Effectively, the concept of trans-border reputation and goodwill is interesting in academic sense. However, due to advent of internet media, international travel, the insistence on the localized business as well as trans-border reputation is nowadays more or less dealt with in a kind of presumptive approach rather than by actual establishment of the same. As the international businesses grow and proximity between the markets would increase, over the time this concept will become weaker and on one good day world will be treated as one market and injunction order can be passed against the registered proprietor on the basis of unregistered trademark in an action of passing off as held in the case of Whirlpool (supra). In Cadbury UK Limited (supra) in para 33 of the said decision, the following principles have been summarized:

Legal principles summarized 33. The position, therefore, that emerges from the above case law is : (a) The concept of goodwill is derived from reputation but the reputation need not be necessarily a local reputation. It can even be a spill over in India of the international reputation enjoyed by the Plaintiffs mark. (b) It is not necessary for the Plaintiff to actually show the presence of or sale of its products in India as long as it is able to establish that it enjoys a spill over reputation in India. In other words, the reputation of a product may precede its introduction and

may exist without trade of the product in the country. (c) The proof of reputation can be in the form of advertisements in the media and general awareness which in the modern day context would include advertisements or display on the internet and social media. The reputation must be shown to exist at the time the Defendant enters the market. (d) A mechanical incantation of reputation is not sufficient. There must be some material that the product is known to the Indian consumer. The material will be scrutinised by the Court from many relevant perspectives including the class of consumers likely to buy the product (See the decision dated 15th March 2010 of this Court in CS (OS) 626 of 2006 Roca Sanitario S.A. v. Naresh Kumar Gupta). (e) Although in the internationalisation of trade there could be a possible confusion with the domestic trader bona fide adopting business names similar to names legitimately used elsewhere, a dishonest adoption or use of a mark similar to one having a reputation in the market, with a view to causing deception or confusion in the mind of the average consumer, may invite an injunction. including the class of consumers likely to buy the product (See the decision dated 15th March 2010 of this Court in CS (OS) 626 of 2006 Roca Sanitario S.A. v. Naresh Kumar Gupta). (f) Although in the internationalisation of trade there could be a possible confusion with the domestic trader bona fide adopting business names similar to names legitimately used elsewhere, a dishonest adoption or use of a mark similar to one having a reputation in the market, with a view to causing deception or confusion in the mind of the average consumer, may invite an injunction.

37. Even the test of confusion and deception in order to prove the case of passing off has been very well discussed in the case of Laxmikant V. Patel vs. Chetanbhat Shah and Another, reported in (2002) 3 SCC65 wherein the Supreme Court while considering a plea of passing off and grant of ad interim injunction held in no uncertain terms that a person may sell his goods or deliver his services under a trading name or style which, with the passage of time, may acquire a reputation or goodwill and may become a property to be protected by the Courts. It was held that a competitor initiating sale of goods or services in the same name or by imitating that name causes injury to the business of one who has the property in that name. It was held that honesty and fair play are and ought to be the basic policy in the world of business and when a person adopts or intends to adopt a

name which already belongs to someone else, it results in confusion, has the propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury. It was also held in *Laxmikant V. Patel* (supra) that the principles which apply to trademark are applicable to trade name also. Para 10 of the aforesaid judgment reads as under:

The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that his goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury.

In this case, the Supreme Court further observed that:

Where there is probability of confusion in business, an injunction will be granted even though the defendants adopted the name innocently.

38. There is no valid argument raised by defendant No.1 that the plaintiffs mark NUCYNTA does not enjoy any trans-border reputation in India. The same has no substance in view of documentary evidence placed by the plaintiff as in the present case, the plaintiff has filed cogent documentary evidence establishing that medical practitioners, research scholars and those related to the field of medicine in general in India and also the Indian media (both print/electronic) were well aware of the plaintiffs mark NUCYNTA at the time when defendant No.1 allegedly launched its pharmaceutical preparation bearing the mark LUCYNTA in India in October, 2011.

39. That apart, the plaintiff has a dedicated website www.nucynta.com that contains information pertaining to the pharmaceutical preparation sold under the plaintiffs mark NUCYNTA. The plaintiff registered the domain name on 29th October, 2008. In addition to the above, the information pertaining to plaintiffs

mark NUCYNTA and/or the pharmaceutical preparation sold thereunder is also freely available on several other websites on the Internet such as www.wikipedia.com.

40. The defendant No.1 in the present case has not assigned any reason or jurisdiction in reply and/or written statement as to how the said defendant hit upon the mark LUCYNTA in relation to an identical pharmaceutical preparation, which has no connection either from the basic molecule named Tapentadol or formed part at the name of disease. In the present case, admittedly the plaintiffs application for rectification of the defendants registered trademark is pending. It is settled law that if a party at the time of making the application for registration of the trademark had knowledge that the mark applied for had already been used by another trader in relation to the said goods then the claim of the proprietorship made by him is false and frivolous. The heavy burden lies on the said party who had applied for registration of the same trademark. Indian trader has to justify before the Court in order to claim the proprietorship of the mark if the mark is a foreign mark. It is also settled law that under those circumstances if the foreign proprietors have an intention to use the mark in India then the conduct of the party, who has applied for registration of the same foreign mark in his name, is questionable. Under Section 11 of the Trade Marks Act, 1999 there is prohibition of registration of the similar trademark which is already well-known and if the later mark would cause unfair advantage or be detrimental to the distinctive character or repute of the earlier trademark. In view of above said reasons, it appears to the Court that the plaintiff in the matter has been able to make a prima facie good and strong case of invalidity of defendant No.1s trademark. Even otherwise, if a defendant in a suit of infringement of rights fails to give valid reason for adopting the similar mark, the presumption would have to be drawn in favour of the party whose trademark has been appreciated by another party. The entire scheme of the Act is that only rightful and honest party is entitled to get the relief from the Court.

41. The plaintiff has already filed a rectification petition before the Registrar of Trademarks seeking cancellation of the registration of the defendant No.1s mark LUCYNTA in India. It is anyways well settled that registration of a mark is only a

prima facie evidence of its validity and the presumption of prima facie validity of registration is a rebuttable. Reliance is placed on Whirlpool (supra) (para 31). Furthermore, it is open for this Court to look in to the validity of the defendant No.1s registration for the purposes of deciding the plaintiffs interlocutory application as held by the Full Bench of Bombay High Court in the present case between the parties. Be that as it may, it is a settled law in India that an injunction can be issued even against a registered proprietor of a trademark.

42. In the case of Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd., (2001) 5 SCC73 in para 28, 30 and 32, Supreme Court has referred few judgments while issuing the guidelines in order to consider the case of passing off on the basis of unregistered trademark :

28. Here, it will be useful to refer to the decision of Morgenstern Chemical Company's case (supra) where it has been held as under: "[5]. In the field of medical products, it is particularly important that great care be taken to prevent any possibility of confusion in the use of trade marks. The test as to whether or not there is confusing similarity in these products even if prescribed and dispensed only by professionally trained individuals does not hinge on whether or not the medicines are designed for similar ailments. The rule enunciated by Judge Helen in Cole Chemical Co. Vs. Cole Laboratories D.C. Mo. 1954, 118F. Supp. 612, 616, 617, 101, USPQ44 47, 48, is applicable here: "Plaintiff and defendant are engaged in the sale of medical preparations. They are for ultimate human consumption or use.***They are particularly all for ailments of the human body. Confusion in such products can have serious consequences for the patient. Confusion in medicines must be avoided. ***** "Prevention of confusion and mistakes in medicines is too vital to be trifled with" The observations made by Assistant Commissioner Leeds of the Patent Office in R.J.

Strassenburgh Co. Vs. Kenwood Laboratories INC. 1955, 106 USPQ379 380 are particularly apt, that "Physicians are not immune from confusion or mistake. Further more it is common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently handwriting is not unmistakably legible. These 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."

30. In the case of Syntex Laboratories Inc. Vs. Norwich Pharmacol Co. reported in 169 USPQ12nd Cr. 1971), it is observed as under: "Stricter standard in order to prevent likelihood of confusion is desirable where involved trade marks are applied to different prescription pharmaceutical products and where confusion result in physical harm to consuming public."

32.This view finds support from McCarthy on Trade Marks, 3rd Edition, para 23.12 of which reads as under: "The tests of confusing similarity are modified when the goods involved are medicinal products. Confusion of source or product between medicinal products may produce physically harmful results to purchasers and greater protection is required than in the ordinary case. If the goods involved are medicinal products each with different effects and designed for even subtly different uses, confusion among the products caused by similar marks could have disastrous effects. For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations. The same standard has been applied to medical products such as surgical sutures and clavicle splints."

43. In view of settled law on the aspect of pharmaceutical preparatory drug, none of the decisions cited by the defendants are applicable to the facts and circumstances of the present case. The defendants has admitted in their pleading in the present case and in the suit filed by them that the two marks are deceptively similar and are being used for identical goods. Salt is also same and if both are used in the market, there would be confusion and deception. Thus, all the decisions referred are distinguishable in view of materially different facts and circumstances.

44. Out of compilations containing many decisions, Mr. Uppal has heavily relied upon the following decisions in support of his arguments on the issue of non-user and goodwill and reputation : a) In Roca Sanitario S.A. vs. Naresh Kumar Gupta and Anr., 2010 (7) RAJ634(Del) held that trans-border reputation can be taken into consideration, but not without there being any evidence of use in this very country.

b) In *Chorion Rights Ltd. vs. M/s Ishan Apparel & Ors.*, 2010 (43) PTC616(Del.) in absence of the plaintiff to show any evidence of advertisement, sales in India held that :

18. The plaintiff has not adduced any evidence to show prior user in India, it is even not the prior registered owner of the said trademark in India. A claim of dilution cannot sustain against a registered owner of the trademark, as is clear from Section 29(4). In this case the defendant has not only established prior user, at least from 1995, but also prior registration of the mark. c) In *Cluett Peabody & Co. Inc. vs. Arrow Apparels*, 1998 (18) PTC156(Bom) the principles for consideration in an action for infringement or passing off under the Trade Marks Act was revisited. It was held that Just as the right of customers or the purchasers of the goods are required to be protected so also traders who are in business over a long period of time, cannot be harassed by threat of litigation by registered proprietors, particularly when after registration, they have not used the mark for long period.

d) In *Smithkline Beecham Plc. & Ors. vs. M/s Hindustan Lever Limited & Ors.*, 1999 (19) PTC775 held that in order to prove trans-border goodwill and reputation the plaintiffs have relied upon materials published in the dental journal which admittedly has very restricted circulation. Mere publication of such advertisement and materials in dental journal cannot and would not establish a transborder reputation. Such reputation, if any, was confined to a particular class of people i.e. the persons subscribing to the said specialized journals and cannot be said to be extended to the general consumers.

e) (emphasis supplied) In the matter of R.J.

Reynolds Tobacco Company vs. Indian Tobacco Company Ltd., 32 (1987) DLT177 the plaintiff was the registered proprietor of trademark NOW for tobacco in more than 80 countries including in India. However the mark was never put to use in India. Plaintiff filed a suit against defendant for use of an identical mark for cigarettes in India. Defendant was using the mark extensively. Held that the balance of convenience was in favour of the defendant. Accordingly, it was ruled that injunction would not be granted and therefore, the application was rejected.

45. (i) In Roca (supra) the facts are different, it was a common word. The defendant was using the mark Roca for the last many years. Even in India, there was not sufficient to show the trans-border reputation, therefore the injunction was not granted in the present case. The mark NUCYNTA was common word and goods in which the marks used are pharmaceutical preparation, thus, different test is used when the life saving drug is involved. The similar are the reasons in the case of Chorion Rights Ltd. (supra). ii) Another judgment referred by the defendant was in the case of Cluett Peabody & Co. (supra) which has no application as in the said case the injunction was refused mainly on the reason of long delay for taking the action against the defendants and at the same time there was a non user of the mark in India. In order to strike the balance between the parties such order was passed. It is also a matter of fact that the Courts have delivered judgments by taking the different view by accepting the concept of trans-border goodwill and reputation, even by the Supreme Court in the case of Whirlpool (supra) took the same view. The same is the circumstances in the case of Smithkline Beecham Plc. (supra) where the facts are materially different. iii) With regard to the case of R.J.

Reynolds Tobacco Company (supra), the facts in the said case were totally different. The mark involved in the said case was NOW which was very common word and never used in India or any part of the world. The plaintiff never intended to use the said mark, therefore, the injunction was not granted. However, the facts in the present case are different. In the present case, the plaintiff has not been using the mark in many countries of the world. The same was registered, printed and electronic evidence is available in India. There is valid reason given by the plaintiff not to use the mark in India on commercial scale on the main reason that the similar mark is being used by the defendants. Mr.Sudhir Chandra, learned Senior counsel for the plaintiff says that there would be total confusion and deception in the mark in case for the same drug, two similar marks would be used by two different parties and image and goodwill of the plaintiff would be tarnished.

46. Even prior to the alleged use by the defendant No.1 of the mark LUCYNTA in India since October, 2011, the plaintiff had applied for a trademark application on 2nd September, 2011 (under No.2199474 in class 05) seeking registration of the

said mark in India with an obvious intent of using the said mark in India.

47. The argument raised by defendant No.1 has no relevance that plaintiff has no intention to come to India has no bearing and is anyway immaterial for the purpose of the present dispute. It is most respectfully submitted that in a case like this where the adoption of the impugned mark LUCYNTA by defendant No.1 is ex facie dishonest, the question of whether or not the plaintiff has any intention to use its mark in India is inconsequential. Reliance is placed on the judgement of Supreme Court in Milmet Oftho (supra) (para 8).

48. Mr. Sudhir Chandra, learned Senior counsel has rightly argued that the defendant No.1, admittedly, has an alternative brand TRANSDOL under which it is selling the identical pharmaceutical preparation i.e. Tapentadol Hydrochloride Tablets in India. The said brand is doing fairly well in the market and enjoys higher sales as compared to LUCYNTA. There was no occasion for defendant No.1 to use the mark LUCYNTA.

49. The defendant No.1 has failed to explain as to how the said defendant came to adopt the mark LUCYNTA, which is nothing but a blatant imitation of plaintiffs arbitrary and coined mark NUCYNTA in relation to an identical pharmaceutical preparation, particularly. In the absence of any explanation much less any satisfactory explanation by the defendant, the adoption of the mark LUCYNTA by the said defendant cannot be regarded as honest. Reliance is placed on Whirlpool (supra) (para 44); Alferd Dunhill Limited v. R.P.S. Chawla and Others 2004 (29) PTC39(para 6); Go Delhi Luxury Tours v. Go Delhi Tours 2012 (51) PTC273(para 23).

50. The said defendant cannot claim to be unaware of the reputation and/or extensive use of the mark NUCYNTA by the plaintiff. Defendant No.1, admittedly, has an alternative brand TRANSDOL under which it is selling the identical pharmaceutical preparation i.e. Tapentadol Hydrochloride Tablets in India. Accordingly, no prejudice would be caused to the said defendant if it is restrained from using the impugned mark LUCYNTA. Thus, the plaintiff has been able to make out a prima facie case for grant of injunction.

51. Even internet search by defendant No.1 for its mark LUCYNTA would have revealed to the said defendant, the prior existence of the plaintiffs mark NUCYNTA. In fact, when one searches for the expression lucynta medicine on Google, the search results that are thrown up are for the plaintiffs pharmaceutical preparation sold under the mark NUCYNTA.

52. Thus, in view of above said reasons and material placed on record, it is no doubt apparent that the trademark of the plaintiff has a unique goodwill and reputation in India, also as people in India are aware about the said mark despite of the fact that the trademark NUCYNTA is not being used on commercial scale in India. Delay 53. The issue of delay in passing off matters has been considered by Courts from time to time. Some of them are referred to as under: a) In the case of Midas Hygiene Industries Pvt. Ltd. vs. Sudhir Bhatia and Others, 2004 (28) PTC121 wherein it was held in the judgment that in case, no explanation could be given as to why the identical label is used and there is dishonest intention to pass off his goods as those of plaintiff, then the interim order can be passed. b) In the case of Hindustan Pencils Pvt. Ltd. vs. M/s India Stationery Products Co., AIR1990 Delhi 19 it was held as under :

It was observed by Romer, J.

in the matter of an application brought by J.R. Parkinson and Co. Ltd., (1946) 63 RPC171 at page 181 that in my judgment, the circumstances which attend the adoption of a trade mark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user. If the user in its inception was tainted it would be difficult in most cases to purify it subsequently. It was further noted by the learned Judge in that case that he could not regard the discreditable origin of the user as cleansed by the subsequent history.

c) In the case of M/s. Bengal Waterproof Ltd. vs. M/s. Bombay Waterproof Manufacturing Co., AIR 1997 SC1398 it was held as under :

20...It is now well settled that an action for passing off is a common law remedy being an action in substance of deceit under the Law of Torts. Wherever and

whenever fresh deceitful act is committed the person deceived would naturally have a fresh cause of action in his favour. Thus every time when a person passes off his goods as those of another he commits the act of such deceit. Similarly whenever and wherever a person commits breach of a registered trade mark of another he commits a recurring act of breach or infringement of such trade mark giving a recurring and fresh cause of action at each time of such infringement to the party aggrieved. It is difficult to agree how in such a case when in historical past earlier suit was disposed of as technically not maintainable in absence of proper relief, for all times to come in future defendant of such a suit should be armed with a license to go on committing fresh acts of infringement and passing off with impunity without being subjected to any legal action against such future acts.

The ratio of the aforesaid decisions is squarely applicable to the facts of the present case. Thus, injunction cannot be refused on account of delay as the plaintiff has made a strong prima facie case of passing off. Even otherwise, from the facts in the present case, there is no much delay in bringing the action by the plaintiff against the defendants. The plaintiff has filed the suit against the defendants in the month of May, 2012. The defendant No.1 has admitted that it has launched the product in October, 2011. There is a small delay of about 8 months. Being a foreign company, it always takes some time to bring the suit for the purpose of collecting documents and preparing the papers. The defendants suit is of subsequent date as the same was filed in July, 2012 i.e. after the suit of the plaintiff.

54. Under these circumstances, it is clear that the plaintiff has established a prima facie case in its favour. The balance of convenience is also in favour of the plaintiff and against the defendants. The plaintiff is the prior adopter and user of the mark NUCYNTA internationally. The defendant No.1s adoption of a similar mark LUCYNTA is not coincidental. The defendant No.1 has no plausible justification for the adoption/use of the mark LUCYNTA.

55. In case the defendants are not restrained from using the mark LUCYNTA, irreparable loss and damage would continue to be caused not only to the plaintiffs

proprietary rights in its coveted mark NUCYNTA but also to the public at large. Taking into consideration the fact that the products in questions are pharmaceutical preparations having a bearing on public health and safety, thus interim order is necessary in the present case to be passed against the defendants as the balance of convenience lies in favour of the plaintiff and against the defendants.

56. Thus, the prayer made in the application under Order XXXIX Rule 1 and 2 read with Section 151 CPC is allowed. The defendants are restrained during the pendency of suit from using of trademark LUCYNTA in respect of pharmaceutical and medicinal preparation and/or any mark which is deceptively similar to the plaintiffs trade mark NUCYNTA.

57. As the defendants have been using the trademark since October, 2011, therefore, in the interest of justice, equity and fair play the defendants are granted three months time to dispose off the earlier stock bearing the mark LUCYNTA.

58. It is made clear that the finding arrived while disposing off the present application are tentative and shall have no bearing when the matter is decided at the final stage of suit after trial. CS(OS) 1931/2012 59. List the matter before Roster Bench on 20th April, 2015 for further proceedings. (MANMOHAN SINGH) JUDGE FEBRUARY27 2015

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