

Biofarma and anr. Vs. Sanjay Medical Store and ors.

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Court : Delhi

Decided On : Mar-31-1997

Reported in : 1997IVAD(Delhi)451; 1997(1)ARBLR558(Delhi); 66(1997)DLT705

Judge : M.K. Sharma, J.

Acts : [Code of Civil Procedure \(CPC\), 1908](#) - Order 39, Rule 1

Appeal No. : Interim Application No. 11683 of 1995 and Suit No. 2684 of 1995

Appellant : Biofarma and anr.

Respondent : Sanjay Medical Store and ors.

Advocate for Pet/Ap. : Mukul Rohatagi,; M.M. Singh,; Sadhana Sharma,;

Judgement :

M.K. Sharma, J.

(1) In the suit instituted by the plaintiffs praying for a permanent injunction restraining the defendants, their servants, agents, dealers and stockists from using the trade mark 'trivedon' or any other trade mark which is stated to be deceptively similar with the trade mark 'flavedon' of the plaintiffs and for infringement of trade mark and passing off damages. The plaintiffs also filed an application under Order 39 Rules 1 and 2 of the Civil Procedure Code praying for grant of a temporary injunction against the defendants from manufacturing and selling, offering for sale

medicinal preparations and pharmaceuticals under the trade mark 'trivedon' or any other trade mark which is deceptively similar with the trade mark of the plaintiff's 'flavedon'. The aforesaid application was registered as is 11683/ 95. The defendants have filed their written statement as against the suit instituted by the plaintiffs and have also filed reply to the application. The said application was set out for hearing before me on which I have heard the learned Counsel appearing for the parties and accordingly, I propose to dispose of the said application by the present order.

(2) According to the plaintiffs, the trade mark 'flavedon' is a registered trade mark of the plaintiff No. 1 in India having been so registered under No. 337006 dated 30.5.1978 in Class 5 in respect of pharmaceutical preparation and substance. The aforesaid registration of trade mark is stated to be in force and stands renewed from time to time. In view of the aforesaid registration in their favor and by virtue of use, the plaintiff No. 1 is exclusively entitled to use the said trade mark 'flavedon' in relation to the goods for which it is registered. The plaintiff No. 1 has allowed plaintiff No. 2 to use the above said trade mark in respect of the goods under register user agreement in pursuance of which the plaintiff No. 2 has been manufacturing and selling the said product 'flavedon' in respect of the above said goods which are prescribed for heart ailments.

(3) The product under the trade mark 'flavedon' is the largest prescribed drug in the French market and the same was introduced in India for the first time in the year 1987. It is stated that the plaintiff No. 1 has also spent considerable amount by way of promotion expenditure for popularising the said trade mark. As a result of intrinsic good quality of the product marketed, sold and dealt with by the plaintiffs, the product under the said trade mark 'flavedon' have acquired a unique and enviable reputation and exclusive goodwill.

(4) It recently came to the knowledge of the plaintiffs that the defendants are marketing pharmaceutical products and has adopted the trade mark 'trivedon' in respect of drugs prescribed for the treatment of heart ailments, coronary diseases. It is stated that the adoption of the trade mark 'trivedon' by the defendants is visually and phonetically deceptively similar to the registered trade mark 'flavedon'

of the plaintiff in respect of the same or similar drugs and thereby the defendant No. 2 is infringing the trade mark of the plaintiff. Accordingly, the present suit has been instituted by the plaintiffs claiming for the aforesaid reliefs.

(5) The defendant No. 2 contested the suit as also the application under Order 39 Rules 1 and 2 and filed its reply opposing the relief sought for by the plaintiffs for grant of a temporary injunction. In the written statement and reply filed by the defendant No. 2, the following defenses have been raised :

(A) That the two trade marks, namely, 'flavedon' and 'trivedon' are different as the opening syllable are completely different and different and the suffix 'vedon' is commonly used by a number of other pharmaceutical manufacturers.

(B) That the pharmaceutical preparation in question being Trime tazidine being Schedule 'H' drug and more so, being used for the treatment of is chemetic heart diseases. Any invariable purchaser is not likely to walk out to a chemist and ask for the said medicine unless prescribed by a physician/ cardiologist.

(C) The two trade marks, each of the plaintiffs and the defendants, are both visually and phonetically totally dis-similar and different and thereforee there is neither any infringement nor any passing off committed by the defendants.

(D) That there is a marked difference in prices of drugs manufactured and sold by the parties.

(E) That the backing of the two drugs is also different.

(6) According to the defendant No. 2, the defendant honestly conceived and adopted the trade mark 'trivedon' in the month of August, 1994 and on 30.8.1994 applied for the approval of the Fda to manufacture and market the said drug. The defendants further stated that the said trade mark was honestly adopted and coined from telescoping three letters from the active ingredient 'trime tazidine' which is contained as a single ingredient product of the defendants. The Fda in the month of October, 1994 granted approval to the defendant to manufacture the pharmaceutical preparation containing 20 mg of Trime tazidine under the trade mark 'trivedon' and eventually in or around the month of February, 1995, the

defendants commenced manufacture of anti-angina medicinal preparation under their own developed manufacturing process and the same is marketed under the trade mark 'trivedon 20', numeric '20' signifying the 20 mg, that is, the potency of the generated drug.

(7) In the context of the aforesaid pleadings of the parties, the issue that arises for my consideration is whether the plaintiff is entitled to grant of a temporary injunction as prayed for in the application on the alleged ground that there has been infringement and /or passing off of the registered trade mark of the plaintiffs by the defendants. Before embarking upon consideration and appreciation of the aforesaid issue, it is necessary to be acquainted with the concept and principles of infringement and passing off in a trade mark matter.

(8) In *Ruston and Homby Ltd. v. Zamindara Engineering Company* : [1970]2SCR222 , the Supreme Court has laid down the test for passing off and for the infringement and held that the test for passing and for infringement is the same when it observed :

'IN an action for infringement where the defendants trade mark is identical with the plaintiffs mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. But where the alleged infringement consists of using not the exact mark on the registration but something similar to it, the test of infringement is the same in an action for passing off. In other words, the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing offaction.'

(9) Since the two marks involved in the present case are 'flavedon' and 'trivedon', it is not using the exact mark on the registration, but something allegedly similar to it and therefore the test applicable to the present case would be the same as that of passing off. That is to say, whether the said two marks, namely, ' flavedon' and 'trivedon' are deceptively similar and are likely to cause confusion and deception.

(10) Section 2(d) of the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as the 'Act') defines the word 'deceptively similar' as which would be deemed to be deceptively similar to another mark if it so nearly resembles that t

other mark so as to likely to deceive or cause confusion. For deciding the question of deceptive similarity, the Courts have laid down the following factors to be considered: (a) The nature of the marks, i.e., whether the marks are world marks or level marks or composite marks, i.e., both world and level marks. (b) The degree of resemblance between the marks, phonetically similar and hence similar in idea. (c) The nature of the goods in respect of which they are used as trade marks. (d) The similarity in the nature, character and performance of the goods of the rival traders. (e) The class of purchasers who are likely to buy the goods bearing the marks they require on education and intelligence and a degree of care they are likely to exercise in purchasing the goods. (f) The mode of purchasing the goods or placing orders for the goods; and (g) Any other surrounding circumstances. It is also settled that weightage to be given to each of the aforesaid factors depends upon facts of each case and the same weightage cannot be given to each factor in every case.

(11) In *M/s. Hiralal Parbhu das v. Ganesh Trading Company & Others* : AIR1984 Bom218 , it has been held that in deciding the question of similarity of two marks, the following well established principles are to be observed : (a) Marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole. (b) overall similarity is the touchstone. (c) marks must be looked at from the first impression of a person of average intelligence and imperfect recollection. . (d) overall structure, phonetic similarity and similarity of idea are important and both visual and phonetic tests must be applied. (f) marks must be compared as a whole, microscopic examination being impermissible, and (g) the broad and salient features must be considered for which the marks must not be placed side by side to find out difference in design. It was further held that in addition, the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances must also be taken into consideration.

(12) In *Corn Products Refining Co. v. Shangrila Food Products Ltd.* : [1960]1SCR968 , it was held that for deciding the question of similarity between the two marks, the marks have to be considered as a whole. It was further held that in deciding the question of similarity between the two marks, the Court has to

approach it from the point of view of a man of average intelligence and of imperfect recollection.

(13) therefore, in the context of the aforesaid settled decision of law, the issue that arises is whether the two marks 'flavedon' and 'trivedon' are deceptively similar and are likely to cause confusion and deception. According to the plaintiffs, the mark 'flavedon' of the plaintiff is the cellular anti is chemic drug in the treatment of ischemic heart disease. The said mark is the invented word and is exclusively associated with the plaintiffs who have been using the said mark 'flavedon 20' in India through plaintiff No. 2 since the year 1987. According to the plaintiffs, the mark adopted and used by the defendants 'trivedon' is deceptively similar with the mark 'flavedon' registered by the plaintiff. In support of his submissions, the learned Counsel for the plaintiffs relied upon various decisions out of which following are mentioned hereunder :- (a) Amritdhara Pharmacy v. Satya Deo Gupta : [1963]2SCR484 . (b) M/s. Pidilite Industries Pvt. Ltd.v. M/s. Mittees Corporation and another : AIR1989 Delhi157 . (c)M/s. Corn Products Refinding Co. v. Shangrila Food Products Ltd. : [1960]1SCR968 . (d) Astra I DL Limited v. Ttk Pharma Limited : AIR1992 Bom35 . (e)Ciba Geigy Ltd. v. Torrent Lab. Pvt. Ltd. reported in 1992 Iplr Guj 137. (f) Angle French Drug Company v. M/s. Balco Pharma . (g) Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories : [1965]1SCR737 . (h) Ciba Geigy Ltd. v.Cross lands Research Laboratories Ltd. reported in Vol. 16 Ptc 1996 Del 1. (i) Tata Iron b Steel Company v. Mahavir Steels f-f Others reported in Volume : 47(1992)DLT412 . (j) Tata Oil Mills v. Wipro Ltd, b another reported in Air 1986 Del 345. (k) Ranibaxy Laboratories v. Dua Pharmaceuticals : AIR1989 Delhi44 .

(14) The defendant No. 2 on the other hand denied that there is any similarity between the two words 'trivedon' and 'flavedon' and the said marks are neither visually nor phonetically deceptively similar. It is stated that suffix 'vedon' and/ or 'don' is being used by a number of different manufacturers in respect of their pharmaceutical products. The prefix 'fla' and 'tri' are admittedly different and distinct and accordingly the two marks, one each of the plaintiffs and the defendant No. 2, are totally different and distinct, both visually and phonetically.

(15) Keeping in mind the various principles and factors to be taken in-to consideration for deciding the question of similarity between the two trade marks or the likelihood of deception and confusion arising there from, let me examine the two trade marks in the light of the submissions of the Counsel appearing for the parties.

(16) Admittedly, the product of the plaintiffs and of the defendant No. 2 is used for similar type of diseases, namely, treatment of heart, i.e., ischemic heart disease. The base of the said product is trime tazidine from which the defendant No. 2 is stated to have taken the first syllable 'tri'. According to the defendant 'tri' is a coined word, the first three letters having been taken from the active ingredient trime tazidine and the suffix 'don' connotes as the don of a new era in medicine and the same is only used in the pharmaceutical trades as part of the brand name and the letters 've' have been taken to combine letters 'tri' with the suffix 'don'. According to the plaintiffs, the word 'flavedon' is a coined word of the plaintiffs and there is no pharmaceutical product with the suffix 'vedon' which is registered prior to the plaintiffs. Accordingly, the words 'flavedon' and/or 'vedon' have come to be associated with the plaintiff.

(17) In *Mis. Johan A. Wolfing v. Chemical Industrial & Pharmaceutical Laboratories Ltd. and Another* : AIR1984 Bom281 , it was held that it is now well settled that while ascertaining whether the two rival marks are deceptively similar, it is not permissible to divide and split up the words of the two marks and reliance can be usually made, in this connection, to the decision of the Supreme Court reported in *Corn Products Refining Co. v. Shangrila Food Products Ltd. Supra* and : [1970]1SCR290 ; *K. R. Chinna Krishna Chettiar v. Sri Ambal & Company and Another*. It was held in the said decision that terminal 'bolin' in the two marks 'flabolin' and 'bionabolin' cannot be an exclusive monopoly of the respondents and the conclusion recorded by the Deputy Registrar cannot be sustained and that examining the two rival marks, it is clear that the cumulative effect do not produce the same upward and maintained and impression and even phonetically the two marks are not closely similar.

(18) Admittedly, the opening syllable of the two competing trade marks in the present case are completely different and distinct. thereforee, the principles laid down in the case of Ciba Geigy Limited v. Sun Pharmaceutical Industries reported in 1994 19 Iplr 43 appear to be applicable. In the said decision, the Gujarat High Court, after referring to number of cases, came to the conclusion that as the opening syllable of the two competing trade marks are entirely different and further held that the said drugs were Schedule 'H' drugs, which were available on prescription of a registered medical practitioner, no deception or confusion was likely to occur. It has been brought to my notice that the aforesaid case went up to the Supreme Court by way of a Special Leave Petition and the Supreme Court by its order dated 15.5.1992 dismissed the appeal. While dismissing the Special Leave Petition, the Supreme Court cited with approval the words of Lord Diplock in American Cynamid v. Ethicon Ltd. : 'It is no part of the Court's function at this stage of the litigation to try to resolve conflicts of evidence on affidavit as to facts of which the claims of either party may ultimately depend nor to decide difficult questions of law which call for detailed arguments and mature considerations. These are matters to be dealt with at the trial. One of the reasons for the introduction of the practice of requiring an undertaking as to damages on the grant of an interlocutor injunction was that 'it aided the Court in doing that which was its great object, namely, abstaining from expressing any opinion upon the merits of the case until the hearing'.'

(19) In pharmaceutical trade, we find names of various drugs almost similar to each other or having the same prefix or suffix. Different Courts have taken different views while deciding the similarity or otherwise in the names of such drugs. But when judged the said view with the factors and principles laid down by the Supreme Court for deciding the same in the present case, it is found that in the two competing words, namely, 'flavedon' and 'trivedon', the degree of resemble between the two marks, deceptively, phonetically and visually, appear to be dissimilar as the mark of the defendants starts with distinct dis-similarity, so far the first syllable is concerned. The defendant No. 2 have given a list of several drugs which apparently end with the suffix 'vedon'/'vidon'. 'Tie said two trade name relates to drugs which are schedule drugs of a specialised nature, namely, for heart disease and, thereforee, the same could be purchased by a customer only

on showing a prescription from a heart specialist.

(20) In respect of the same, the Counsel appearing for the plaintiff relied upon a decision of Bombay High Court in *Astra IDL Limited v. Ttk Phartila Limited* Supra and a decision of this Court in *Ciba Geigy Ltd. v. Cross lands Research Laboratories Ltd.* reported in 1996 Ptc (16) Del 1, wherein it was held that in the present circumstances and particularly in Indian context, the doctor's prescription factor, as last it is important since the reality of the situation could not be ignored and that in India schedule drugs which are to be sold under doctor's prescription are even sold without production of doctor's prescription and reduces the weightage that could be given to this aspect of the matter while considering the -- question of deceptive similarity. However in *Reckitt & Coleman of India Ltd. v. Medicross Pharmaceuticals Pvt. Ltd.* reported in 1994 19 Iplr 31, Bombay High Court held that the preparation bearing plaintiff's mark was an analgesic medicine useful for relief from common ailments like toothache, headache etc. and hence was available without a doctor's prescription even in pan-beedi shops, whereas on the contrary, the defendants' medisprin, although it contained the an algestic aspirin like the plaintiff's disprin, yet it also included other ingredients and made it a special drug for heart patients and thereforee was a Schedule H drug available only on doctor's prescription and not otherwise. It was further held that where marks are different and other factors like nature of product, design and get- up of packing and prices are dissimilar, weightage has necessarily to be given to availability of impugned product on doctor's prescription as has been done in decided cases.

(21) The two marks, namely, 'trivedon' and 'flavedon' are found to be prima fade dissimilar to each other. They are Schedule 'H' drugs available only on doctor's prescription being prescribed for heart diseases, which is a serious disease in the medical world. The factor that the same is available on doctor's prescription only and not across the counter is also a relevant factor to be taken not of while deciding whether the two words are deceptively similar to each other or not. In my considered opinion, where the marks and also other factors like the product and packing have been found not to be similar and not likely to create confusion and where the impugned mark related to Schedule 'H' drug, the factor of the product

being sold only by a licenced chemist and that too against a doctor's prescription is to be given due weightage.

(22) It is also admitted by the parties that there is a difference in prices of the two products. According to the Counsel for the plaintiff price difference is a cause of deception in view of the fact that the price of the drug of the defendant No. 2 is fixed lower than that of the plaintiffs and accordingly there is a fair chance of the customers being deceived by the manufacturers/retailers and the chemists by giving the customers a drug which is priced lower than that of the plaintiffs. In my considered opinion, however, the fact that the two pharmaceutical products, one each of the plaintiff and the defendant, are to be sold at different prices itself ensures that there is no probability of any deception/confusion being caused, particularly in view of the fact that a customer, who approaches a chemist with the intention of purchasing the product of the plaintiff, will never settle down for a drug of the defendant which is priced lower and the difference is visible at that stage itself.

(23) On an overall consideration of each of the factors as mentioned above, it is apparent that the two trade names of the product, one each of the plaintiff and the defendant, are totally dissimilar and different. This Court, at the time of entertaining the suit, issued notice on the application under Order 39 Rules 1 and 2 filed by the plaintiff and directed that the defendants would maintain accounts of the sale and submit the same every quarterly. Since at the present stage, the issue regarding the similarity of the two trade names are being approached only on the basis of affidavits filed by the parties and a decision being arrived at only for the purpose of arriving at a prima facie opinion, it would be in the interest of justice requiring the defendant No. 2 to give an undertaking to pay the damages, if at the final stage and after detailed evidence laid and arguments and mature considerations of the facts, this Court comes to the opinion upon the merits of the case to decide the issue against the defendant No. 2.

(24) Under the circumstances, I do not think it appropriate to grant a temporary injunction in favor of the plaintiff and as sought for in the present application and the said application accordingly stands rejected, subject to the condition that the

defendant No. 2 shall furnish an undertaking to pay damages to the plaintiff within three weeks, if in case, finally on merits it is decided in favor of the plaintiff and against the defendant No. 2. The defendant shall also continue to main account of the sale and submit the same every quarterly to this Court till the disposal of the suit.

(25) With the aforesaid direction and observation, this application stands dismissed.

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