

(2011) 02 CAL CK 0055

In the Calcutta High Court

Case No : GA No. 2302 of 2006 CS No. 183 of 2006

Aurio Pharma Laboratories Pvt. Ltd. and Others

APPELLANT

Vs

Prem Pathak and Others

RESPONDENT

Date of Decision : 25-02-2011

Acts Referred:

Citation : (2011) 02 CAL CK 0055

Hon'ble Judges : Sanjib Banerjee, J

Bench : Single Bench

Advocate : Ranjan Bachawat, Prithviraj Sinha, Arindam Chandra and Atish Ghosh, for the Appellant; Debnath Ghosh and Bimalendu Das, for the Respondent

Judgement

Sanjib Banerjee, J.—The Plaintiffs claim to be entitled to an order of injunction not only in respect of the infringement of their registered label by the Defendants, but also in the Defendants passing off their product as that of the Plaintiffs.

2. The Plaintiffs are the manufacturers of a medicinal compound marketed under the name "Gassanol" meant for the treatment of duodenal and gastric ulcers and relieving gastric pain. The Plaintiffs maintain that their product under such name has been in the market from 1972 and have relied on documents dating back to 1997 and 1983 in support of their contention that the product has been sold for a considerable period. The Plaintiffs have relied on their publicity and sales figures relating to the product from or about the year 2000.

3. The Plaintiffs' label is registered in class 5 and the certificate is dated December 1, 1982 in respect of an application made on September 20, 1978. There is no dispute that the Plaintiff company is at present the owner of the registered label. The label has a horizontal band on top where the name of the product is indicated. The rest of the label declares the composition of the product and at its foot it names the manufacturer. The Plaintiffs have enjoyed an ad-interim order from the year 2006 and submit that the order should be continued

till the disposal of the suit.

4. The Plaintiffs say they have made out a twin case of infringement in respect of the label and passing-off in respect of the name of the product used by the Defendants. According to the Plaintiffs, the Defendants' mark "Gasanal" is phonetically similar, if not identical, to the Plaintiffs' "Gassanol." The Plaintiffs suggest that the adoption of both the name and the label by the Defendants was dishonest and an attempt to ride piggy-back on the reputation and goodwill of the Plaintiffs' established product.

5. The Plaintiffs have referred to a judgment reported at N.R. Dongre and Others Vs. Whirlpool Corporation and Another, , which was affirmed by the Supreme Court in the judgment reported at N.R. Dongre and Others Vs. Whirlpool Corpn. and Another, . The Plaintiffs say that in view of the judgment in Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd reported at Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd., , a stricter approach is now in vogue while assessing the possibility of confusion in rival medicinal products.

6. The Defendants do not contest the Plaintiffs' claim of exclusivity based on the Plaintiff company's registration of the label. The Defendants seek a modification of the subsisting order such that the Defendants are left free to use "Gasanal" as the name of their product by using an altogether different label and get-up.

7. The Defendants have relied on the judgments reported at East African (I) Remedies Pvt. Ltd. Vs. Wallace Pharmaceuticals Ltd. and Another, and S.B.L. Ltd. Vs. Himalaya Drug Co., suggest that notwithstanding the Cadila judgment (where the rival brands were "Falcigo" of the successful Appellant and "Falcitib" of the Respondent), if there is a discernable element of dissimilarity in the names of the two rival medicinal products an interlocutory injunction would be refused. In East African the Plaintiff failed to obtain an interlocutory injunction against the Defendant's "Revox" product despite the Plaintiff's use of "Rivox" for at least a decade before the Defendant's product. In SBL Ltd the Defendant's mark, "Liv-T," was found to be not confusingly similar to the Plaintiff's mark, "Liv-52." The judgment in East African considered the Supreme Court dictum in Cadila.

8. The other aspect of the defence is the Defendants' contention that the Plaintiffs have not established continuous use of their product since the Plaintiffs have only relied on the sales figures of their product in the years 1977 and 1983 and referred to the subsequent sales and publicity figures from the year 2000 till the time of the institution of the suit. The Defendants also assert that their "Gasanal" mark is registered and the Plaintiffs came to court by suppressing such fact. The Defendants say that there can be no infringement by the Defendants in using their registered mark; since a claim of infringement may not be maintained against a registered trade mark. The Defendants contend that no case in support of the apparent claim in passing-off relating to the name of the Defendants' product has been made out by the Plaintiffs.

9. The Plaintiffs do not assert their right to exclusivity in respect of "Gassanol" by

virtue of such name figuring prominently in the registered label. The Plaintiffs insist that notwithstanding the rights conferred by statute on the registered owner of a mark, the common law cause of action of passing-off is still maintainable against a registered mark. Such proposition is beyond dispute. Though the reliefs claimed in the suit and the immediate prayers in the application do not spell out the cause of action of passing-off, the manner in which the reliefs and prayers have been couched do not preclude the Plaintiffs from urging such cause of action.

10. In the absence of registration of the name of their product in their favour, the Plaintiffs cannot claim the exclusivity recognised by statute in such name. Again, in the Defendants having obtained registration of their mark, they are entitled to the exclusive use thereof; subject, however, to the common law rights of a previous user of the same or similar name. Notwithstanding the apparent dissimilarity in the last syllables of the two names, ordinary seekers of a medicinal compound for a common Indian ailment cannot be credited with the ability to make the fine distinction. Both compounds are for oral use, albeit the revolting suggestion in the second syllable of the name of the Defendants' product. It is not the Defendants' case that their product is a restricted compound available only by prescription. The proximity of the proclaimed nature of efficacy of the two products is also a factor that has to be weighed in.

11. The Defendants have not pressed for the use of the label that, in addition to being otherwise similar to the Plaintiffs', also bears the same orange colour. There is an element of dishonesty in the Defendants' adoption of the form of marketing of their product and, for interlocutory purposes, that would count in the exercise of discretion.

12. It is evident that the Plaintiffs' product was in the market at least in the late 1970s and the early 1980s and, in any event, it has been continuously sold from a time preceding the Defendants' launch of their product. The impressive sales figures of the Plaintiffs' product would entitle the Plaintiffs to enjoy the injunction that has continued for nearly five years. Nothing in this order should, however, have any impact on proceedings, if any, brought by the Plaintiffs for rectification of the register by deleting the Defendants' mark therefrom.

13. GA No. 2302 of 2006 is disposed of by confirming the subsisting interim order in the Plaintiffs' favour. Since the written statement has been filed, documents should be discovered within eight weeks from date and inspection taken forthwith thereupon. The parties will have liberty to seek an early listing of the suit after the summer vacation. There will be no order as to costs.

14. Urgent certified photocopies of this judgment, if applied for, be supplied to the parties subject to compliance with all requisite formalities.