
(2007) 04 DEL CK 0003

In the Delhi High Court

Case No : I.A. No. 9343 of 2005 in CS (OS) No. 441 of 2005

Pfizer Inc.

APPELLANT

Vs

Pifer Pharmaceuticals Pvt. Ltd.

RESPONDENT

Date of Decision : 17-04-2007

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 6 Rule 17, 115, 151

Citation : (2007) 34 PTC 660

Hon'ble Judges : Anil Kumar, J

Bench : Single Bench

Advocate : Saikrishna Rajagopal and Sidharth Chopra, for the Appellant; Sunil Magon, for the Respondent

Final Decision : Dismissed

Judgement

Anil Kumar, J.—This order shall dispose of plaintiff's application under Order 6 Rule 17 read with Section 151 of the CPC seeking amendment to the plaint.

2. The plaintiff has filed this suit for injunction against the defendant seeking a restraint from manufacturing, selling, advertising, marketing or in any other manner whatsoever using PIFER, PIFOL or PIFSER or any other mark or name which is deceptively or confusingly similar to the plaintiff's trade mark and name PFIZER, either as a trademark or as the corporate or trade name or trading style, or part of a trademark, corporate name, trade name or trading style, as the case may be, or in any other manner whatsoever infringing the registered trademark PFIZER of the plaintiff or passing off its goods or business as and for the goods and business of the plaintiff. The plaintiff also sought a decree for mandatory injunction seeking the direction that the defendant should recall all the products and marketing, promotional and advertising material (including the web site at www.piferpharma.com) that bear or incorporate the offending marks/name PIFER, PIFOL or PIFSER and for a rendition of accounts and costs of the suit.

3. In the plaint filed by the plaintiff it was categorically contended that recently it

was brought to the attention of the plaintiff that the defendant is carrying on business under the name and style of Pifer Pharmaceuticals Pvt. Ltd. and selling its products under the trade mark PIFOL and PIFSER. The plaintiff also contended that a search on the Internet disclosed that the defendant has a web site at www.piferpharma.com and the word PIFER has been written in a manner to take an unfair advantage of the goodwill and reputation of the plaintiff. The plaintiff also categorically contended that though the defendant is claiming to be in business since October 1994, the plaintiff believes that this is an exaggerated claim, as otherwise plaintiff would have acquired knowledge of the defendant had he been in business.

4. In paragraph 26 of the plaint the plaintiff categorically contended that it recently came to know of the defendant's activities and filed the plaint on 5th April, 2005. Along with the plaint, the plaintiff also filed an application for an interim injunction and an ex parte injunction order in terms of prayer A and B made in the application which are as under:

A. the Defendant, its directors, principles, proprietor, partners, officers, employees, agents, distributors, franchisees, representatives and assigns be restrained by an ad interim ex-parte temporary injunction from manufacturing, selling, advertising, marketing or in any other manner whatsoever using PIFER, PIFOL or PIFSER or any other mark or name which is deceptively or confusingly similar to the plaintiff's trade mark and name PFIZER, either as a trade mark or as a corporate or trade name or trading style, or part of a trade mark, corporate name, trade name or trading style, as the case may be, or in any other manner whatsoever infringing the registered trade mark PFIZER of the plaintiff or passing off its goods or business as and for the goods and business of the plaintiff;

B. The Defendant including its directors, agents, representatives and assigns be ordered to forthwith, recall all the products and marketing, promotional and advertising materials (including the website at www.piferpharma.com) that bear or incorporate the offending marks/name PIFER, PIFOL or PIFSER which have been manufactured, distributed, sold or shipped by it, as the case may be, and to reimburse all customers from which said materials are recalled and to deliver to the plaintiff's attorneys or representatives for destruction all products, labels, signs, prints, packages, moulds, plates, dies, wrappers, receptacles, and advertisements in its possession or under its control, bearing the PIFER, PIFOL or PIFSER marks or any other trade mark similar to PFIZER.

5. The defendant contested the suit and filed a written statement dated 26th April, 2005 contending inter alia that the plaintiff has suppressed the material facts in order to secure an ex-parte order. It was stated that defendant was incorporated on 18th April, 1994. On 26th November, 1996 a legal notice was received on behalf of plaintiff regarding the trademark of a pharmaceutical product "PLAGYL-FL" under the mark "PIFER". A reply to the said notice was given on 25th December, 1996 and on 23rd April, 1997 an undertaking was given on behalf of defendant. The terms and conditions of the aforesaid undertaking

are extracted as under:

a. We admit that the trademark "PIFER" (word per se and logo) used by us was identical with and/or deceptively similar to the registered trademark "PFIZER" of Pfizer inc.USA. We hereby tender our apology for having used the trademark "PIFER" upon or in relation to their pharmaceutical products.

b. We hereby inform you that we have discontinued the use of the impugned trademark "PIFER" forthwith upon or in relation to any pharmaceutical product or any other goods and agree and undertake that we will not hereafter either by ourselves or through our servants, agents, distributors, licensees or any other person, manufacture, market, distribute, sell, offer for sale, advertise or otherwise use upon or in relation to pharmaceutical products the impugned trade mark "PIFER" (word per se and/or logo).

c. We hereby undertake and agree that we will not hereinafter by ourselves, or through our servants, agents, distributors, licensees or any other persons, manufacture, market, distribute, sell, offer for sale, advertise, export or otherwise howsoever deal in pharmaceutical products bearing the impugned trade mark or use and/or issue any letters, circulars, price-lists, advertisement, literature, or any other material bearing the impugned trade mark or any other trade mark, deceptively similar to your registered trade mark "PFIZER".

d. We further agree and undertake that we shall not at any time hereinafter adopt and/or use or cause to be adopted and/or used any trade mark which is identical with and/or deceptively similar to your trade mark "PFIZER" or any colourable imitation thereof so as to infringe your trade mark "PFIZER" registered in class 5 of the Fourth Schedule of the Trade and Merchandise Marks Rules, 1959 of the Trade and Merchandise Marks Act, 1958 bearing the registration No. 168312.

e. It is understood that in consideration of our fulfilling the foregoing obligations, you will not take any legal proceedings against us, but that the concession shall cease immediately on the failure on our part to perform any of the obligations or any of the terms of this Undertaking.

f. We further agree that this undertaking is binding upon ourselves and our servants, agents, successors and assigns and on all other corporate and/or firms with which we are connected and/or associated with directly or indirectly through ownerships, control, management, partnership or otherwise.

In the circumstances it was pleaded on behalf of defendant that the plaintiff did not have any objection to the name of the defendant company and Therefore did not take any action for the next eight years. The defendant stated that he is obliged under law under Drugs and Cosmetic Rules, 1945 to write the name of the drug, the net contents, active ingredients and the name and address of the defendant on the label of packing. The defendant also categorically pleaded that before filing the suit no legal notice was sent to the defendant. It was also

pleaded that Indian Drug Review (IDR) is a necessary party and the Hon'ble Court has been deprived of the correct version.

6. Despite these categorical pleas raised by the defendant, no replication was filed by the plaintiff taking the plea about not having the knowledge of the earlier notice given to the defendant and the undertaking given by the defendant at the time of filing the present suit.

7. By order dated 13th May, 2005 the ex-parte interim order was modified on the assurance of the defendant that the corporate name of the defendant shall not be written in the manner as set out in paragraph 14 and 15 of the plaint and consequently the defendant was allowed to use corporate name "PIFER PHARMACEUTICALS PVT. LTD." subject to writing the same on all products in a straight line and in the same font and not in the manner as it is being written as set out in Para 14 and 15 of the plaint.

8. Thereafter a number of dates were taken for filing the documents and for admission and denial of these documents. After admission and denial of these documents, before the framing of issues, the present application for amendment of the plaint has been filed. By amendment to the plaint the plaintiff seeks to substitute Para 14, 15 and 26 of the plaint.

9. The application for amendment is contested by the defendant on the ground that the information now sought to be given by the plaintiff was suppressed intentionally in order to get an ex-parte interim order. It was contended that the entire controversy has emanated from the web site of Indian drug review. In the book printed by them the name of the defendant has been correctly mentioned however, mischief has been done in the compact disc. It has been further contended that plaintiff was fully satisfied with the reply given to the plaintiff's notice dated 26th November, 1996 and the undertaking given by the defendant. The defendant objected to the amendment on the ground that the same are neither consequential nor imperative but tend to prejudice the case of the defendant and change the complexion of the suit to the detriment of the defendant and the proposed amendment would enlarge the scope of the suit and raise additional controversies and issues not pleaded earlier by the plaintiff. The defendant contended that the plaintiff has contended that it recently came to know about the offending activities of the defendant and by the proposed amendment, the plaintiff wants to put the clock back to the year 1996. The objection of the defendant is also that by amendment the plaintiff is setting up an altogether new suit and wants to deprive the defendant a valuable right which has accrued to the defendant.

10. In the plaint plaintiff contended that he was shocked when it was recently brought to his attention in 2005 that the defendant is carrying on business under the name and style of PIFER PHARMACEUTICALS LTD and marketing two of its products under the trademark PIFOL and PIFSER. The plaintiff wants to replace this paragraph completely and substitute it with another paragraph contending

that around November 1996 defendant was manufacturing and marketing the product's with the marks PIFER. The plaintiff wants to withdraw his plea `that he was shocked to know recently in 2005 about the plaintiff using deceptively and confusingly similar trademark" on the ground that due to passage of time and intervening mergers and numerous changes in the staff did not at the time of institution of the present proceedings had the record of notice given in 1996 and the undertaking tendered by the defendant in 1997. Withdrawal of the plea is also made on the ground that nondisclosure of the facts is neither deliberate or intentional and because over the years the legal representations of the plaintiff has shifted to different trademark attorneys.

11. The plaintiff in paragraph 15 of the plaint also wants to delete the sentence "additionally, on the web site, though the defendant is claiming to be in business since October 1994, the plaintiff believes that this is an exaggerated claim, as the plaintiff would have acquired knowledge of the defendant had they been in business". The plaintiff by this plea contended that defendant was not in business since 1994 because had he been in business plaintiff would have known about the same.

12. The plaintiff also wants amendment in the clause of cause of action. In the plaint cause of action is based on the activities of the defendant in using deceptively and confusingly similar trademark and name PFIZER of the plaintiff. By amendment the plaintiff wants to change the cause of action and wants to rely on the alleged breach of undertaking given by the defendant in 1997.

13. This cannot be disputed that the law of amendment to the pleadings have become very liberal. The following principles can be culled regarding exercise of the discretion in allowing the amendment. The amendment however, should not work injustice to the other side. If the injury to the other side can be compensated by costs then it is not treated as injustice. The amendment should be allowed to avoid multiplicity of proceedings as far as possible. Amendments should not be allowed which are impliedly or expressly prohibited by law. Amendments which are malafide should not be allowed. The amendments which deprive the other party a valuable right accrued to them should not be allowed.

14. In Modi Spinning and Weaving Mills Co. Ltd. and Another Vs. Ladha Ram and Co., . amendment to the written statement was disallowed as the proposed amendment in that case entailed depriving the plaintiff of a valuable right accrued on account of admission already made by the defendant in the written statement. In the un-amended written statement it was contended that pursuant to agreement with the defendant, plaintiff worked as stockiest cum distributor but the agreement was not applicable to the transactions in which the plaintiff acted as principal. By amendment the defendant wanted to contend that the plaintiff was appointed as mercantile agent and the plaintiff acted in that capacity in placing order on the defendant and wanted to deny that the plaintiff placed order on the defendant in plaintiff's capacity as purchaser. This was held to be completely displacing the plaintiff from the admissions made by the defendant.

15. In *Heeralal Vs. Kalyan Mal and Others*, The appellant-plaintiff had filed a civil suit for partition of 10 items of immovable properties mentioned in Schedule A of the plaint and also for partition of other properties listed in Schedule B of the plaint. The contesting Respondents 1 and 2, who are Defendants 1 and 2 in the suit, being real brothers of the plaintiff filed a joint written statement and a definite stand was taken by the contesting defendants that out of the listed properties in Schedule A only three properties at Items 4, 9 and 10 were exclusively belonging to the contesting defendants and were not joint family properties of the plaintiff and Defendants 1 and 2 and impliedly other seven properties listed in Schedule A were admitted to be joint family properties. It was also contended that the plaintiff is only entitled for partition regarding the properties of Schedule A except Items 4, 9 and 10 and all the properties mentioned in Schedule B". In these properties 1/3rd share of the plaintiff was admitted. After a number of hearing, the plaintiff filed an application for appointment of receiver and at that stage Defendant 1 came forward with an amendment application to amend his written statement. In the amendment application it was submitted that because of incomplete information supplied by him to his counsel the written statement came to contain the so-called admissions regarding 5 out of 7 items of the properties in Schedule A and that he had suffered a heart attack in 1989 and Therefore when the written statement was moved in 1993 this error crept in. He also wanted to insert a further averment in the written statement regarding Schedule B properties that they had ceased to remain in possession of Defendant 1 and were in possession of trespassers. The trial judge dismissed the application on the ground that the defendant No. 1 was trying to get out of the admissions made by Defendants 1 and 2 in connection with the relevant suit properties. In revision High Court allowed the application for amendment. The Supreme Court set aside the order of the High Court holding that order passed by the High Court u/s 115 CPC, allowing withdrawal of earlier admissions of Defendants 1 and 2 in their original written statement about 5 out of 7 items of Schedule A properties could not be sustained. It was stated that the reason is obvious because as far as Schedule A properties were concerned, a clear admission was made by Defendants 1 and 2 in their joint written statement in 1993 that 7 properties out of 10 were joint family properties wherein the plaintiff had 1/3rd share and they had 2/3rd undivided share. Once such a stand was taken, naturally it must be held that there was no contest between the parties regarding 7 items of suit properties in Schedule A. It was held by the Apex Court that right which had accrued to the plaintiff, as noted earlier, would be irretrievably lost if such amendment is allowed qua five of these seven items in Schedule A of the plaint for which by the impugned amendment the earlier admissions were sought to be recalled. Consequently it was held that when the amendment sought in the written statement was of such a nature as to displace the plaintiff's case it could not be allowed.

16. The Apex Court has again relied on *Modis Spinning and Weaving Mills Co.*

Ltd. (supra) and Heeralal (supra) regarding amendment to the pleadings and had held in Sangramsinh P. Gaekwad and Others Vs. Shantadevi P. Gaekwad (Dead) thr. Lrs. and Others, that Order 6 Rule 17 of the CPC postulates amendment of pleadings at any stage of the proceedings but before an amendment can be carried out in terms of Order 6 Rule 17 of the CPC the court is required to apply its mind on several factors including viz. whether by reason of such amendment the claimant intends to resile from an express admission made by him. In such an event the application for amendment may not be allowed.

17. Thus one has to see and keep in mind that the amendment sought does not purport to set up a new case or substitute one cause of action or the nature of claim for another in the original plaint. Similarly introduction by amendment of inconsistent or contradictory allegation in negation on the admitted petition of facts, or mutual destructive allegations of facts are not permissible.

18. By proposed amendment the plaintiff wants to completely withdraw his plea that in 2005 it was brought to his attention that the defendant is using deceptively and confusingly similar trademark and the name of the plaintiff. The plaintiff could have retained this plea and could file replication detailing therein the circumstances in which at the time of filing the plaint, the facts pertaining to 1996 and 1997 about the notice given to the defendant and the undertaking executed by the defendant could be explained. The plaintiff could seek amendment which could be clarificatory and explanatory by retaining original plea. The plaintiff, however, wants to completely withdraw his plea that it was brought to his attention in 2005 that the defendant is using deceptively and confusingly similar trademark and the name of the plaintiff. After defendant filed the written statement categorically denying that the defendant has come to know in 2005, a right has accrued to the defendant, which the plaintiff wants to take away by completely withdrawing the said plea. Similarly in Para 15 the plaintiff wants to completely withdraw the plea that had the defendant been in business since October, 1994 the plaintiff would have acquired the knowledge of the same. In the clause of cause of action also the plaintiff wants to rely on the undertaking executed by the defendant in 1997. Applying the principles enunciated in the precedents it is apparent that the amendments as has been sought by the plaintiff should not be permitted in the facts and circumstances of the case because the injury which will be caused to the defendant will not be capable of being compensated by way of cost.

19. In these facts and in totality of circumstances it will not be appropriate to allow the plaintiff to amend the plaintiff in a manner as proposed by him leading to withdrawal of admissions made by him which have given some rights to the defendant. Consequently the application must fail and the amendment sought by the plaintiff should not be permitted.

20. Therefore, the application of the plaintiff for the amendment of the plaint is dismissed. However, considering the facts and circumstances of the case the parties are left to bear their own costs.