

(2008) 07 DEL CK 0021

In the Delhi High Court

Case No : IA No. 2226 of 2007 in CS (OS) 361 of 2007

Schering Corporation and Others

APPELLANT

Vs

Getwell Life Sciences India Pvt. Ltd.

RESPONDENT

Date of Decision : 04-07-2008

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2
Drugs and Cosmetics Act, 1940 — Section 28(1), 29, 34

Citation : (2008) 37 PTC 487

Hon'ble Judges : Badar Durrez Ahmed, J

Bench : Single Bench

**Advocate : Sachin Datta, Amit Mehta and Ritesh Singh, for the Appellant;
Valmiki Mehta, Sr Advocate, Ishani Sahiwal, Mahesh and Akanksha, for the
Respondent**

Judgement

Badar Durrez Ahmed, J.—is 2226/2007 has been filed under Order 39 Rules 1 and 2 of the Code of Civil Procedure, 1908 (hereinafter referred to as the "CPC") by the plaintiffs seeking an ad-interim injunction restraining the defendant from using the mark "TEMOGET" in respect of the pharmaceutical product - Temozolomide on the ground that the mark "TEMOGET" is deceptively similar to the plaintiffs' registered trademarks "TEMODAL" and "TEMODAR" in relation to the very same pharmaceutical product - Temozolomide. The plaintiffs seek the confirmation of the ex parte order dated 27.02.2007 whereby the defendant was restrained from using the mark "TEMOGET". The defendant seeks the vacation of that ex parte order.

2. The case of the plaintiffs is that their predecessor synthesized the compound Temozolomide in 1984. Through 15 years of research and development by the plaintiffs, the said compound was found to be useful as a drug for treatment of brain cancer. Temozolomide, according to Wikipedia - an Encyclopedia on the internet, is an oral alkylating agent used for the treatment of refractory anaplastic astrocytoma- a type of cancerous brain tumor. Temozolomide is a derivative of imidazotetrazine. According to the plaintiffs, in 1999 they applied

the pre-existing mark "TEMODAL" in respect of the drug (Temozolomide) and that from 1999 to 2004 the plaintiffs were the sole users of the mark "TEMODAL". In 2004 some Indian manufacturers used similar names.

3. The mark "TEMODAL" was registered in favor of the plaintiff No. 3 in India vide registration No. 687936 with effect from 23.11.1995 in Class 5 which, inter alia, related to pharmaceuticals including alkylating cytotoxic agents for the treatment of various types of cancer. Similarly, the mark "TEMODAR" was also registered in favor of the plaintiff No. 3 in India vide registration No. 888816 with effect from 29.11.1999 under the said Class 5.

4. It was contended on behalf of the plaintiffs that the plaintiffs had exclusive rights in respect of the registered trademarks "TEMODAL" and "TEMODAR" and that the defendant's mark "TEMOGET" used for the very same drug - Temozolomide- constituted an infringement of the plaintiffs' registered trademarks and, Therefore, the plaintiffs were entitled, straightaway, to an interim injunction restraining the defendant from using the mark "TEMOGET". It was also contended on behalf of the plaintiffs that while the plaintiffs' trademarks were registered, the defendant's trademark was not registered. It was also contended that "TEMODAL" and "TEMODAR" have acquired distinctiveness and are well-known and the said marks were used by the plaintiffs worldwide. It was also contended that the prefix "TEMO" constituted an essential feature of the plaintiffs' said registered trademarks and the same could not be appropriated by the defendant. It was contended that the prefix "TEMO" could only be used exclusively by the plaintiffs and by no other person. It was also contended that while there have been infringements in India inasmuch as since 2004 some persons have used the prefix "TEMO" in respect of their products involving Temozolomide, such infringements have not been rampant and that the plaintiffs have taken recourse to law in respect of all such alleged infringers which have come to the notice of the plaintiffs. On behalf of the plaintiffs reliance was placed on:-

(1) Astrazeneca UK Ltd. and Anr. v. Orchid Chemicals & Pharmaceuticals Ltd. 2007 III AD (Delhi) 430;

(2) Heinz Italia and Another Vs. Dabur India Ltd., ;

(3) Bhagwan Dass Gupta v. Shiv Shankar Tirath Yatra Co. Pvt. Ltd. 2001 V AD (Delhi) 663;

(4) Milmet Oftho Industries and Others Vs. Allergan Inc., ;

(5) Pfizer Ireland Pharmaceuticals Vs. Intas pharmaceuticals and Another, ;

(6) Hoechst Pharmaceuticals Ltd. and Ors. v. Government of India and Ors. 1983 PTC 265 (DelHI.);

(7) Ramdev Food Products Pvt. Ltd. Vs. Arvindbhai Rambhai Patel and Others, .

5. On behalf of the defendant it was contended that Temozolomide was a generic

word referring to a particular chemical compound being a derivative of imidazotetrazine. It was submitted that consequently Temozolomide was publici juris. "TEMO" being an abbreviation of Temozolomide would, Therefore, also be publici juris. In this background, it was submitted that the term "TEMO" being publici Jurisdiction could be adopted by anyone as a part of his trademark in respect of the chemical compound Temozolomide. It was contended that the defendant has taken a part of the word Temozolomide and combined it with a part of its company name: "TEMO" from Temozolomide and "GET" from Getwell Life Sciences India Private Limited (i.e, the defendant's name).

6. It was also contended that there is no deceptive similarity between the plaintiffs' registered marks "TEMODAL" and "TEMODAR" and the defendant's mark "TEMOGET". It was further submitted that if the prefix is derived from a salt/ compound, as in the present case the term "TEMO" is derived from Temozolomide, then the emphasis should be on comparing the suffixes by ignoring the common prefix. Employing this test, it is apparent, according to the learned Counsel for the defendant, that "DAL" and "DAR" are entirely dissimilar from "GET". Consequently, it was submitted that the basic ingredient for an infringement action, of deceptive similarity, is not satisfied and, Therefore, the plaintiffs would not be entitled to any injunction.

7. It was also contended that apart from the visual and phonetic dissimilarity between the plaintiffs' registered trademarks and the trademark of the defendant, the price ranges of the products are so distinct that no reasonable person would confuse the product of the defendant as that of the plaintiffs and, Therefore, there is no question of there being any possibility of deception. It was submitted that 5 capsules of 250 mg each of TEMODAL cost approximately Rs 72,000/- whereas similar 5 capsules of 250 mg each of "TEMOGET" sell for only Rs 12,000/-. It is apparent that the price of the plaintiffs' product is six times the price of the defendant's product. It was contended on behalf of the defendant that this stark difference in price is an important factor to be kept in mind while taking a decision on the question of deceptive similarity.

8. It was also contended on behalf of the defendant that the defendant has honestly adopted its trademark and that it is the usual practice of the defendant in adopting a trademark in respect of its pharmaceutical products by taking the prefix from the name of the salt/ chemical compound and attaching the suffix "GET" which forms part of the defendant's name. It was also contended that the defendant is not a fly-by-night operator and is an established concern.

9. Another factor which was highlighted is that Temozolomide is a Schedule "H" drug under the Drugs and Cosmetics Act, 1940 and the Drugs and Cosmetics Rules 1945, which implies that it can only be sold in retail on the prescription of a registered medical practitioner. In other words, Temozolomide whether it is sold under the plaintiffs' mark "TEMODAL/ TEMODAR" or under the defendant's mark "TEMOGET", can only be sold upon prescription of a registered medical practitioner. It was contended on behalf of the defendant that this is also an

important aspect which has to be kept in mind when the question of deception is being considered.

10. The learned Counsel for the defendant placed reliance on:

(1) Astrazeneca (supra);

(2) Kalindi Medicure Pvt. Ltd. Vs. Intas Pharmaceuticals Ltd. and Another, ;

(3) Cadila Laboratories Ltd. v. Dabur India Ltd. 1997(17) PTC (Del.)

11. In rejoinder, the learned Counsel for the plaintiffs contended that as the plaintiffs' marks were well-known, the argument of publici Jurisdiction was not available to the defendant. He submitted that the term "TEMO" is only suggestive of Temozolomide and cannot be regarded as a substitute or an abbreviation of Temozolomide. Consequently, although Temozolomide is publici juris, the term "TEMO" cannot be regarded as publici juris.

12. The entire controversy in the present case is whether the defendant's mark "TEMOGET" is deceptively similar to the plaintiffs' registered trademarks "TEMODAL" and "TEMODAR". There is no doubt that registration of a trademark gives the registered proprietor thereof the exclusive right to the use of the trademark in relation to the goods or services in respect of which the trademark is registered and to obtain relief in respect of infringement of the trademark in the manner provided under the Trademarks Act, 1999 (hereinafter referred to as the "said Act"). This is stipulated in Section 28(1) of the said Act. There is no doubt that the plaintiffs' trademarks "TEMODAL" and "TEMODAR" are registered in their favor in relation to, inter alia, pharmaceuticals (including alkylating cytotoxic agents for the treatment of various types of cancer) which include the chemical compound Temozolomide. Clearly, the plaintiffs have the exclusive right to use the marks "TEMODAL" and "TEMODAR" in respect of Temozolomide.

13. However, in order to establish infringement of the said registered marks, the plaintiffs would have to bring the case within the ambit of Section 29 of the said Act. Sub-section (1) of Section 29 specifically stipulates that a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark. In the context of the facts of the present case, it is apparent that the mark "TEMOGET" is not a registered trademark. It is also apparent that the defendant's mark is not identical with the plaintiffs' registered trademarks. It is also clear that the defendant's trademark and the plaintiffs' trademarks are in relation to the very same goods, i.e, Temozolomide. Therefore, the only question that has to be examined is whether the defendant's mark is deceptively similar to the plaintiffs' registered trademarks.

14. It is obvious that the term "TEMO" used in the plaintiffs' registered

trademarks as well as in the defendant's mark is derived from the name of the chemical compound Temozolomide. To the said term "TEMO", the plaintiffs have added the suffixes "DAL" and "DAR" to arrive at the trademarks "TEMODAL" and "TEMODAR" respectively. On the other hand, the defendant has added the suffix "GET", which is part of its company name, to arrive at the trademark "TEMOGET". All the trademarks in this case, be they the plaintiffs' registered trademarks or the defendant's trademark are what are described as portmanteau words. A portmanteau word is used to describe a linguistic blend, namely, a word formed by blending sounds from two or more distinct words and combining their meanings. Examples of portmanteau words are - brunch (breakfast + lunch); Tanzania (Tanganyika + Zanzibar). As per the Wikipedia, portmanteaus can also be created by attaching a prefix or suffix from one word to give that association to other words. For example, the suffix "holism" or "holic" taken from the word "alcoholism" or "alcoholic" can be added to a noun, creating a word that describes an addiction to that noun. For example, chocoholic means a person who is addicted to chocolate and workaholic means a person who is addicted to work and so on. Portmanteau words can also be used to describe bilingual speakers who use words from both languages while speaking. For instance, a person would be considered speaking "spanglish" if he is using both spanish and english words at the same time. Similarly, the portmanteau word "hinglish" would refer to the usage of hindi and english words at the same time.

15. This discussion makes it clear that parts of words can be combined to pack the meanings of both the words in the new word so formed. The defendant has been able to show the derivation of the trademark "TEMOGET": "TEMO" from Temozolomide and "GET" from Getwell Life Sciences India Private Limited. The combined effect of "TEMO" and "GET" would be Temozolomide manufactured by Getwell Life Sciences India Private Limited.

16. In *Kalindi Medicure Pvt. Ltd. (supra)*, a learned Single Judge of this Court considered the question as to whether the defendants' trademark "LOPARIN" was deceptively similar to the plaintiff's registered trademark "LOPRIN" in respect of pharmaceutical products. In that decision the learned judge took the view that in the pharmaceutical trade, one finds names of various drugs almost similar to each other, having common prefixes or suffixes, for the reason that the name of the drug conveys as to which salt/ compound it is a derivative of. The learned judge also indicated that the method of intake of a drug by a person is also an important factor. Taking this into consideration, the learned judge decided to vacate the ex parte injunction which had been earlier granted because "LOPRIN" was sold in the form of pills in aluminum foils whereas "LOPARIN" was sold in prefilled syringes. It was also held that the price difference between the two products was huge. Consequently, the ex parte injunction was vacated. From this decision three things become clear. First of all, in the pharmaceutical trade it is common to have prefixes or suffixes linked to the chemical compound / salt across various similar products manufactured by different persons. What it

means in the context of the present case is that in the pharmaceutical trade it would not be unusual to find drugs including the term "TEMO" as a prefix or a suffix as a part of the name of the drug when it relates to the chemical compound Temozolomide. Secondly, the form in which the drug is sold is also material. If it is different, such that one drug is sold in the form of pills or capsules and the other is sold in the form of prefilled syringes, the likelihood of deception is minimized. Thirdly, when the price difference of the products is of a high magnitude, the likelihood of deception would also be greatly reduced.

17. In *Astrazeneca (supra)*, a Division Bench of this Court was considering the question of infringement of the registered trademark "MEROMER" by the impugned trademark "MERONEM". Both the products referred to Meropenem. The Division Bench after considering several decisions including *Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.*, and *SBL Limited v. Himalaya Drug Company 1997 PTC (17) 540 (Del.)* came to the conclusion that "Meropenem" is the molecule which is used for treatment of bacterial infections and the term "MERO", being an abbreviation of a generic term (Meropenem), was publici juris. It was held that the plaintiffs in that case could not claim exclusive right to the use of "MERO" as a constituent of any trademark. It was observed that the common feature in both the competing marks, i.e., "MERO" was only descriptive and publici Jurisdiction and, Therefore, the customers would tend to ignore the common feature and would pay more attention to the uncommon features, namely, "MER" and "NEM" which were clearly dissimilar. The Division Bench observed as under:

19. Admittedly, "Mero", which is common to both the competing marks, is taken by both the appellants/plaintiffs and the respondent/ defendant from the drug "Meropenem", taking the prefix "Mero" which is used as a prefix in both the competing marks. Both the appellants/plaintiffs and the respondent/defendant are marketing the same molecule "Meropenem". Neither the appellants/plaintiffs nor the respondent/defendant can raise any claim for exclusive user of the aforesaid word "Meropenem". Along with the aforesaid generic/common prefix, "Mero", the appellants/plaintiffs have used the syllables "nem", whereas, the respondent/defendant has used the syllable "mer". It is true that the aforesaid words/trade names cannot be deciphered or considered separately, but must be taken as a whole. But even if they are taken as a whole, the prefix "Mero" used with suffix in the two competing names, distinguishes and differentiates the two products. When they are taken as a whole, the aforesaid two trademarks cannot be said to be either phonetically or visually or in any manner deceptively similar to each other.

The Division Bench also noted that in the trade of drugs, it is a common practice to name a drug by the name of the organ or ailment which it treats or the main ingredient of the drug. The name of such an organ, ailment or ingredient being publici Jurisdiction or generic cannot be owned by anyone exclusively for use as a trademark.

18. In my view, the present case is covered entirely by the Division Bench decision in Astrazeneca (supra). However, it was sought to be contended on behalf of the defendant that the present case is different from the Astrazeneca case. It was contended that in Astrazeneca (supra), the plaintiff therein was not the first to have adopted and used the prefix "MERO" and that there were other companies using "MERO" as a prefix and that there was also no averment in Astrazeneca (supra) with regard to trans-border reputation. Whether the plaintiff was the first to adopt and use the prefix "MERO" in the Astrazeneca's case and "TEMO" in the present case is not of much consequence when infringement of a registered trademark is being considered. The case is not one of passing off where prior user would be a relevant consideration. The case is also not one where the defendant has raised a defense of prior user u/s 34 of the said Act where, again, the question of who used the mark first would be relevant. The present case is one of infringement u/s 29 of the said Act and the only question that requires consideration, as noted above, is whether the defendant's trademark is deceptively similar to the plaintiffs' registered trademarks. The distinction that the defendant seeks to draw between the Astrazeneca case and the present case is a mere illusion. There is no such distinction.

19. The decision in Heinz Italia (supra) is a case which deals with passing off and stands on a different footing. In Bhagwan Dass Gupta (supra), a learned Single Judge of this Court noted that the basic test to find out whether a trademark is a publici Jurisdiction is that if the mark has come to be so public because of its universal use that it does not confuse or deceive by the use of it the purchasers of the goods of the original trader. The object to protect a trademark is merely to prevent the trader from being deceived or confused by the other persons goods as his goods. Although this decision was cited on behalf of the plaintiff, there is nothing in it which enables us to detract from the clear position as indicated in Astrazeneca's case. There is no doubt that Temozolomide is a generic word and is publici Jurisdiction and nobody can claim exclusivity in respect of the same. Consequently, the clipped expression "TEMO" derived from clipping the word "TEMO" would also be publici Jurisdiction over which no person can claim exclusive proprietorship.

20. In Cadila Laboratories Ltd. v. Dabur India Ltd. 1997 PTC (17) 417, a learned Single Judge of this Court considered the case of infringement of the plaintiffs' registered trademark "MEXATE" by the defendant's trademark "ZEXATE" in respect of the same type of cancer medicine. The suffix "EXATE" in both cases was common. The prefixes were only the letter "M" and the letter "Z". The learned judge took the view that:

According to the decisions laid down by the various Courts, the importance of the prefix of the word should be taken due weightage and important (sic) in case where the suffix is common. Where the suffix of the word is common, regard must be had to the earlier portion of the word which distinguishes one from the other. Where the suffix is common, the earlier portion of the word is the natural,

necessary and, in fact, the actual mark of distinction.

Applying this test to the present case, the prefix being common to the plaintiffs' mark and the defendant's mark, it would be the suffixes which would have to be compared to see whether the marks are deceptively similar or not.

21. While holding that the marks "MEXATE" and "ZEXATE" were not deceptively similar, this Court in Cadila Laboratories (supra) observed:

As has been settled, while ascertaining two rival marks, as to whether they are deceptively similar or not, it is not permissible to dissect the words of the two marks. It is also held that the meticulous comparison of words, letter by letter and syllable by syllable, is not necessary and phonetic or visual similarity of the marks must be considered.

22. The learned Counsel for the plaintiffs had placed reliance on Milmet Oftho Industries (supra) with regard to the first adoption of the mark. He placed reliance on the following observation:

8. We are in full agreement with what has been laid down by this Court. Whilst considering the possibility of likelihood of deception or confusion, in present times and particularly in the field of medicines, the Courts must also keep in mind the fact that nowadays the field of medicine is of an international character. The Court has to keep in mind the possibility that with the passage of time, some conflict may occur between the use of the mark by the Applicant in India and the user by the overseas company. The Court must ensure that public interest is in no way imperiled. Doctors particularly eminent doctors, medical practitioners and persons or Companies connected with medical field keep abreast of latest developments in medicine and preparations worldwide. Medical literature is freely available in this country. Doctors, medical practitioners and persons connected with the medical field regularly attend medical conferences, symposiums, lectures etc. 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.

The decision in Milmet Oftho Industries (supra) is not applicable to the present case. First of all, it is not an action for infringement of a trademark under the said Act but one of passing off. It is obvious that in a passing off case prior use and first adoption would be of vital importance. Secondly, and more importantly, the case before the Supreme Court was one where the competing marks were

identical. Both the plaintiff and the defendant had adopted "OCUFLOX" as their trademark. In the present case the mark adopted by the defendant is not identical to the registered marks of the plaintiffs. Clearly, the decision in Milmet Oftho Industries (supra) would not be of much help to the plaintiffs' case. Similarly, the decision in the case of Pfizer Ireland Pharmaceuticals (supra), the "LIPITOR"- "LIPICOR" case, would also not be relevant for the purposes of the present case inasmuch as that was also a case of passing off. The decision in Hoechst Pharmaceuticals Ltd (supra) has been relied upon by the learned Counsel for the plaintiffs to submit that derivative drugs from the same bulk drug may have different therapeutic values. It was submitted that while both the plaintiffs and the defendant are manufacturing and marketing Temozolomide, their products are not interchangeable and may have different therapeutic values. Consequently, consumers may be deceived into purchasing the defendant's product thinking that it would have the same therapeutic value as that of the plaintiffs' products. This argument cannot be accepted because it proceeds on the basis of an assumption that the plaintiffs' products are superior to the defendant's product. At this prima facie stage such an assumption cannot be made. Moreover, the defendant has a drug license under the Drug and Cosmetics Act, 1940 and no presumption can be drawn that the defendant's product is not a quality product. For the same reasons, the decision in Ramdev Food Products (P) Ltd. (supra) would also not be applicable to the present case.

23. Comparing the plaintiffs' trademark "TEMODAL" and "TEMODAR" with the defendant's trademark "TEMOGET", it is apparent that the marks are not identical. There is also no phonetic or visual similarity between the marks. I have already noted above that the term "TEMO" cannot be exclusively used by the plaintiffs in view of the fact that it is publici Jurisdiction being a clipped abbreviation of the generic word Temozolomide. There is no doubt in my mind, at this prima facie stage, that the suffix "GET" is entirely different and distinct from the suffixes "DAL" and "DAR" of the plaintiffs' trademarks. There is also no doubt that there is no phonetic or visual similarity between the defendant's mark and the plaintiffs' marks taken as a whole as would be prone to deceive consumers. It is also relevant to point out that Temozolomide is a Schedule "H" drug which can only be sold in retail on the prescription of a registered medical practitioner. While this condition is not by itself sufficient to establish a case of no deception, it is an important factor particularly when the pharmaceutical product is a highly specialized drug and is used for the specific treatment of a type of brain cancer. The warning indicated in the packaging of the defendant is also relevant. The warning reads:

To be supplied against demand from cancer hospitals, institutions and against the prescription of a cancer specialist only.

It is obvious that the defendant's product is not an off-the-shelf product which any person can go and purchase. The product is to be supplied only against demand from cancer hospitals / institutions and that too against the prescription

of a cancer specialist only. This warning greatly reduces the possibility of deception. The cancer specialist would be aware of the therapeutic values of the defendant's product as also of the plaintiffs' products. Apart from this, a significant consideration is the vast difference in the prices of the products. It has already been noted above that the plaintiffs' products are six times more expensive than the defendant's product. When the difference in the price structure is so vast, the likelihood of deception is virtually nil.

24. For all these reasons, I am of the view that the plaintiffs are not entitled to the interim injunction that they seek. The order dated 27.02.2007 is hereby vacated. is 2226/2007 under Order 39 Rules 1 and 2 CPC filed by the plaintiffs is dismissed. No order as to costs.