

(2001) 06 CAL CK 0013
In the Calcutta High Court

Case No : G.A. No's. 862 and 985 of 2001 and C.S. No. 109 of 2001

Strassenburg Pharmaceuticals Limited	APPELLANT
Vs	
Himalaya Drug Company and Another	RESPONDENT

Date of Decision : 27-06-2001

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 1, Order 39 Rule 2, Order 39 Rule 4
Trade and Merchandise Marks Act, 1958 — Section 28, 29

Citation : (2002) 24 PTC 441

Hon'ble Judges : Bhaskar Bhattacharya, J

Bench : Single Bench

Advocate : Protap Chatterjee, for the Appellant; Goutam Chakraborty, for Defendant No. 1 and Supriyo Bose, for Defendant No. 2, for the Respondent

Judgement

Bhaskar Bhattacharya, J.—The question that arises for determination in these applications is whether the plaintiff, a manufacturer of anti reflux antacid, under the registered trade mark "EFACID", in an action for infringement of trade mark as well as of passing off is entitled to get an order of temporary injunction restraining the respondents their servants, agents and assigns from in any manner infringing the plaintiffs trade mark "EFACID" by selling antacid under the names "EFCID" or "EFCID-CA", or any other name deceptively similar there to.

2._There is no dispute that the trade mark "EFACID" has been duly registered by the Registrar of Trade Marks on June 2, 1986. By reason of the aforesaid fact, the petitioner has the sole and exclusive right to use the said trade marks to the exclusion of others.

3. The case made out by the petitioner in this application is that in or around October 2000 the petitioner came to learn that the respondent No. 1 had introduced an antacid formulation in tablet and in suspension form and was selling the same under the name "EFCID". The said name "EFCID" used by the respondent No. 1 was identical and/or deceptively similar to that of the petitioner's said product. By a letter dated October 25, 2000 the petitioner asked

the respondent No. 1 not to infringe the said trade mark "EFACID". By a letter dated November 2, 2000 the respondent No. 1 informed the petitioner that they had already change the name of their product from "EFCID" to "EFCID-CA" and claimed that addition of the word "CA" as suffix would distinguish the same from the petitioner said trade mark.

4. According to the petitioner, the addition of the said suffix by the respondent No. 1 was not sufficient to distinguish the respondent's product and was not in compliance with the notice dated October 25, 2000 and accordingly by a further notice dated November 16, 2000 the petitioner asked the respondent No. 1 to forthwith cease and desist from the use of the said trade mark. Inspite of service of such notice, the respondent No. 1 having failed to comply with the demand the petitioner instituted the present action.

5. Initially, a learned Single Judge of this Court granted an ad-interim order of injunction on the application filed by the present petitioner. Subsequently, the respondent having come up with an application for vacating the said interim injunction, another learned Single Judge of this- Court varied the said interim order and passed a direction to expedite the hearing of the main injunction application by treating the application for variation of interim order as affidavit-in-opposition to the main application and asking the petitioner to file affidavit-in-opposition to the application for variation within a specified period by treating the same as affidavit-in-reply. Thus, the instant matter has come up for hearing.

6. The defence of the respondent is that the words "EFCID-CA", colour scheme, the get up, the layout and the allied features form a composite and compact set of features which is distinctive trade dress of the respondent's product. According to the respondent, the trade dress of plaintiffs product consists of a green plastic bottle bearing the label which is in a colour scheme of white, black and two shades of green and the label of the plaintiffs product bearing the name of the product "EFACID" in a dark block letters in black colour with the composition of the product being Sodium Aliginate, Magnesium Carbonate Suspension and Magaldrate written on the top of it in thinner version of capital letter again in black colour. The other features of the label includes the term "suspension 11, the aspect of flavour "Mint Flavoured", Anti Reflux Antacid ; the name of the plaintiff along with The address of its place of business ; composition in miligrammes being "Sodium Aliginate U.S.N.F.-100 mg., Light Magnesium Carbonate I.P.-40 mg., Magaldrate LP.-500 gm., dosage" as directed by physician" and other mandatory features as date of manufacturing, expiry etc. all printed in black colour. The mark "EFCID-CA" according to the respondent is in no way similar to that of the plaintiffs product "EFACID", The term "CID" in the respondent's product is a generic term in respect of antacid medicines. Furthermore, the initial terms "EF1 of the respondent's product "EFCID", according to the respondents, could not be said to be in any way similar to that of initial "EFA" of the plaintiffs product "EFACID". According to the respondents, the terms "EF" of respondent's "EFCID" and "EFA" of plaintiffs "EFACID" are in no

way phonetically similar. Over and above, according to the respondents, the product and packaging of its "EFCID-CA" are visually unique and so bound to be distinct from not only the plaintiffs product but also any other products and packaging in the market. It is the further contention of the respondent that the plaintiffs product is an allopathy medicine while the nature product of respondent is ayurvedic.

7. Mr. Chatterjee, the learned counsel appearing on behalf of the plaintiff has contended that the action having the brought not only for passing off but also for infringement of trade marks, merely because the respondents have used additional Suffix "CA" after the word "EFCID" which is deceptively similar to "EFACID" cannot evade the rigour of law on this subject. Mr. Chatterjee strenuously submits that phonetically there is practically no difference between "EFCID" and "EFACID" and as such by merely adding additional suffix "CA" the respondent tried to deceive the customer of the petitioner. According to Mr. Chatterjee in case of infringement of trade marks the get up at the packet or the colour of the medicine are immaterial. Mr. Chatterjee further contents that both the medicines being of the same nature Le. an acid and being available without any prescription of medical practitioner, the fact that the respondent's drug is of the nature of Ayurvedic will not alter the position. Mr. Chatterjee thus contends that his client has made out a strong prima facie case and is thus entitled to get an order of injunction till the disposal of the suit. Mr. Chatterjee submits that in case of violation of trade mark mere delay of two months inconsequential and the balance of convenience and inconvenience is always in favour of granting such injunction.

8. Mr. Chakraborty, the learned counsel appearing on behalf of the respondent has however opposed the aforesaid contentions of Mr. Chatterjee and by drawing attention of this Court to the get up and other special features of the bottle containing his client's drug submitted that merely because there is some phonetical approximation that fact alone will not enable the plaintiff to get an order of temporary injunction unless" it can further show that there is visual semblance of the two products. In support of such contention Mr. Chakraborty has relied upon the following decisions :

(a) Indo-Pharma Pharmaceutical Works Ltd. Vs. Citadel Fine Pharmaceuticals Ltd., ;

(b) Johann A. Wulfinf Vs. Chemical Industrial and Pharmaceutical Laboratories Limited and Another, ;

(c) Anjendra Kumar Aggarwal v. Kmzer Herbals, 1996PTC (16) 501 ;

(d) J.R. Kapoor v. Micronix India 1994 PIC 260 ;

(e) F. Hoffmann-la Roche and Co. Ltd. Vs. Geoffrey Manner and Co. Pvt. Ltd., - and

(f) S.M. Deychem Ltd. v. Cadbury (India) Ltd., AIR 2000 SC 2114

9. After hearing the learned counsel for the parties and after going through the decisions relied upon I find that the scope of investigation in an action for infringement of registered trade mark varies a lot from that in one for passing off. As pointed out by a bench consisting of three Judges of the Apex Court in the case of Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, in the former type of cases, once it is established that the essential features of the trade mark of the plaintiff has been adopted by the defendant, the fact that the get up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the "added matter" is sufficient to distinguish his goods from those of the plaintiffs.

10. There is no dispute that the present action is one both for infringement of registered trade mark and passing off.

11. Keeping in view the aforesaid principles laid down in the case of Durga Dutt Shanna (supra), I now propose to consider the present case.

12. "EFACJD" is the registered trade mark of the plaintiff. The defendant was initially selling its goods in the trade name "EFCID" by dropping the forth letter *A" from the plaintiffs mark "EFACID". Subsequently, however, the defendant changed the said mark and started selling its goods in the new trade name "EFCID-CA" by adding a (-) and suffix CA to the former trade name "EFCID".

13. Therefore, the question that falls for determination is whether the essential features of the plaintiffs trade mark "EFACID" have been adopted by the defendant.

14. Since the two marks are not identical, the onus is upon the plaintiff to establish that the mark used by the defendant so nearly resembles the plaintiffs registered mark as is likely to deceive or cause confusion in relation to the goods in respect of which his mark has been registered. This has necessarily to be ascertained by comparison of the two marks bearing in mind that the person who would be deceived are the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration.

15. At this stage it will not be out of place to mention the observation of the Supreme Court in the case of Cadila Healthcare Ltd. v. Cadila Pharmaceutical[^] Ltd. 2001 PTC 300 (SC), that in a country like India where there is no single common language, a large percentage of population are illiterate and a small fraction know English, in dealing with a case of this nature the Court should not lose sight of the fact that the purchasers may Kwe absolutely no knowledge of English language or of the language in which the trade mark is written and to whom different words with slight difference in spelling may sound phonetically the same.

16. By applying the aforesaid principles to the case in hand, I am of the view that the defendant by dropping a vowel "a" from "EFACID" and adding the suffix "CA" thereafter, has adopted the essential features of the plaintiffs registered trade mark thereby making its trade mark deceptively similar to that of the registered mark of the plaintiff which is likely to deceive or cause confusion in relation to the goods in respect of which it is registered. The resemblance is not only phonetic but also in the basic ideal represented by the plaintiffs mark. Moreover, both the drugs are antacid in nature and can be availed of even without the prescription of a registered medical practitioner in any shop dealing in medicine. Thus, the fact that "EFACID" is an allopathy medicine while "EFCID-CA" is in the nature of ayurvedic is inconsequential. The plaintiff's action being based also on infringement of registered trade mark, the dissemblance of get up or the colours of the products are also immaterial.

17. The plaintiff has therefore made out a very strong prima facie case to go to the trial.

18. Once a very strong prima facie case has been made out, the balance of convenience and inconvenience is in this type of a case in favour of granting the prayer of temporary injunction otherwise the plaintiff shall suffer irreparable loss and injury.

19. Although Mr. Chakraborty strenuously tried to convince this Court that this application should fail for delay of two months in moving this application, I am not at all impressed by such submission. Inaction of the plaintiff after receiving the letter of the defendant No. 1 dated December 22, 2000 till February 26, 2001 cannot stand in the way of getting an order of injunction. In this type of a case where the interest of the general public is also affected by the act of the defendant, delay is inconsequential. (See Allergan Inc Vs. Milment Oftho Industries and Others,).

20. As regards the various decisions cited by Mr. Chakraborty, at the very outset I should point out that the principles laid down in the case of MA. S.M. Deychem Ltd. v. Cadbury (India) Ltd. (supra), have been disapproved by a subsequent decision of a larger bench of the Apex Court in the case of Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd. (supra).

21. The case of F. Hoffmann-La Roche & Co. Ltd. v. Geoffrey Manners and Co. Ltd. (supra), arose out of proceedings for rectification of a registered trade mark "DROPOVIT" by the holder of registered trade mark TROTOVIT and it was held that those were not deceptively similar. The said decision of the Apex Court is in no way conflict with the decision given in the case of Durga Dutta Sharma (supra), upon which I have placed reliance. In my view, if "Navaratna Kalpa" is held to be deceptively similar to registered trade mark "Navaratna" as pronounced in the case of Durga Dutt Shanna (supra) or if "Lakshmandhara" is held to be deceptively similar to "Am-ritdhara" (Amritdhara Pharmacy Vs. Satyadeo Gupta, } or "Gluvida" is found to be similar to "Glucovita" (Corn

Products Refining Co. Vs. Shangrila Food Products Ltd.,), "EFCID-CA" should also be construed as deceptively similar to "EFACID".

22. In the case of J.R. Kapoor v. Micronix India (supra), a bench consisting of two Hon"ble Judges of the Supreme Court was considering the question whether trade mark "Microtel" was deceptively similar to "Micronix" used by the respondent. It appears from paragraph 3 of the judgment that defendant/appellant and the plaintiff/respondent were at one point of time partners of M/s. Micronix India ; the said firm was selling goods under registered trade mark "Micronix". The said firm was dissolved by way of compromise in a Civil Suit and according to one of such terms of compromise the plaintiff was permitted to carry on with the said registered mark. On the allegation that the defendant after dissolution of the firm was producing goods under the trade name "Micro tek" which is deceptively similar to "Micronix" action was brought. It does not appear from the judgment reported whether the plaintiff after dissolution obtained fresh registration of the trade mark "Micronix" in his own name on the basis of such decree. Thus, it is not clear whether the suit was for preventing passing off or for infringement of registered trade mark. If the suit was against mere passing off, the principles laid down in the fact of such case cannot have any application to the present case where the plaintiff has also alleged infringement of registered trade mark. If it is assumed for the sake of argument that the plaintiff of that case after obtaining proper assignment of registration of the said trade mark in his name brought an action also for infringement of registered trade mark, in that even the Court could not consider whether the get up of the articles of the defendant was different from that of the plaintiff as laid down by the decision of bench consisting of three Judges in the case of Durga Dutt Shanna (supra). In such a situation the said decision cannot be cited as a precedent as the said decision is contrary to earlier decision of a larger bench holding that in such an action dissemblance of the get up of the defendant's product is not material. Thus, at any rate, the decision in the case of J.R. Kapoor (supra) is of no avail to Mr. Chakraborty's client.

23. For the same reason, the decision of a learned Judge of Delhi High Court in the case of Anjendra Kumar Aggarwal v. Kmzer Herbals (supra), cannot be shown as an authority as the learned Judge in refusing injunction solely relied upon the decision of the Apex Court in the case of J.R. Kapoor (supra), but failed to consider the earlier decisions of the Supreme Court taking a contrary view.

24. In the case of Mis. Johann A. Wulfmg v. Chemical Industrial & Phaimaceuti-ail Laboratories Ltd. (supra), a Division Bench of Bombay High Court held that "CIPLAMINA" cannot be held to deceptively similar to "COMPLAMINA". The reason was obvious. If any of the letters e,i,y is placed after the first letter c of a word, in such a case, "c" is pronounced softly, whereas in case of other vowels after such c, the same is pronounced as *k". Thus, "CIPLAMINA" is pronounced as "Siplamina" whereas "COMPLAMINA" is pronounced as "Komplamina". Thus, there is no phonetic similarity between the two words nor was there any visual

similarity of the words. The said decision therefore cannot held the defendant in any way.

25. In the case of Indo-Phanna Phannaceutical Works Ltd. v. Citadel Fine Pharmaceuticals Ltd. (supra), a Division Bench of Madras High Court in an appeal against order refusing to grant injunction in a suit for infringement of registered trade mark affirmed the order of the learned trial Court holding that trade mark "Enerjase" cannot be said to be deceptively similar to "Enerjex". In the said decision, various authorities on the subject have been taken note of and ultimately the Division Bench arrived at the conclusion stated above. With great respect of the learned Judges, I am unable to subscribe to the view taken by their Lordships as in my opinion the said view is not in conformity with the one taken by the Supreme Court in the case of Durga Dull Sharma (&upTa),Amritdhara Pharmacy (supra) and Corn Product Refining Company (supra).

26. Thus, the decisions relied upon by Mr. Chakraborty do not help the defendant in any way.

27. In the application, although the plaintiff prayed for similar relief in respect of another product "EFACINE", but at the time of hearing the learned counsel appearing on behalf of the petitioner did not press such relief.

28. Therefore, on consideration of the entire materials on record I allow this application by restraining the defendant No. 1, their servants, agents and assigns from infringing in any manner the plaintiff's trade mark "EFACID" by selling goods under the name "EFCID" or "EFCID-CA" till the disposal of the suit. They are also restrained from manufacturing, selling or distributing and/or offering for sale or distribution any product bearing the names "EFCID" or "EFCID-CA" till the disposal of, the suit. Earlier order dated March 13, 2001 passed in the suit stands vacated.

29. I make it clear that the observations made herein are all tentative for the purpose of disposal of the instant application. The application for variation of interim order filed by the defendant No. 1 which was treated as affidavit-in-opposition to the plaintiffs application is also disposed of in terms of this order.