

IN THE HIGH COURT OF DELHI AT NEW DELHI

CS (OS) No. 111 of 2006

Reserved on: 22nd January 2010
Decision on: 3rd June 2010

HIMALAYA DRUG CO. Plaintiff

Through Mr. Hemant Singh with
Ms. Mamta Rani Jha, Mr Sachin Gupta,
Mr. Shashi Jha, Mr. Manish K. Mishra,
Mr. Animesh Rastogi and
Mr. Sumit Rajput, Advocates

versus

SBL LIMITED Defendant

Through Mr. Atishi Dipankar with
Mr. S.P. Jha and Mr.B.K. Jha, Advocates

CORAM: JUSTICE S. MURALIDHAR

1. Whether reporters of local paper may be allowed to see the judgment? No
2. To be referred to the reporter or not? Yes
3. Whether the judgment should be referred in the digest? Yes

JUDGMENT
03.06.2010

Introduction

1. The Plaintiff, which is the manufacturer of an Ayurvedic medicine “**Liv.52**”, seeks a permanent injunction restraining infringement of its said trademark by the Defendant which is manufacturing a Homeopathic drug “**LIV-T**”.

2. The case has been entirely presented and argued as a suit for infringement. The incidental reliefs are for delivery up of all the infringing goods and rendition of accounts by the Plaintiff.

Pleadings

3. The Plaintiff is a registered partnership firm engaged in the business of manufacturing and marketing Ayurvedic medicinal preparations and formulations since 1930. It claims to have gained tremendous reputation in the field of medicine and amongst consumers through large-scale advertising, extensive sales and innovative promotional schemes. **Liv.52** is stated to be among several well-known ayurvedic medicines manufactured and marketed by the Plaintiff.

4. **Liv.52** is a liver tonic prescribed for liver disorders. It is further advised for promoting appetite and growth, the two biological phenomenon directly related to liver. It is stated that the trademark “**Liv.52**” is a coined mark. According to the Plaintiff, the prefix “Liv” has no dictionary meaning or any meaning in common parlance. The said trademark is stated to have been coined and adopted by the Plaintiff in 1955 and has been used by it continuously and exclusively all over India since then.

5. It is claimed that at or around the time of the filing of the present suit in 1996, the approximate turnover for sales of ‘**Liv.52**’ for the year 1995-96 was over Rs. 30 crores and the promotional expenditure during the same period was Rs. 3 crores. This, according to the Plaintiff, was reflective of the goodwill that the trademark **Liv.52** commands in medical circles and in the public. It is stated that the trademark **Liv.52**, apart from having inherent distinctiveness on account of its being a coined mark, has also become distinctive on account of its extensive use by the Plaintiff in relation to liver related preparations and medicines since 1955. The

Plaintiff states that it is the proprietor of the trademark **Liv.52** under the common law having exclusive right to the use thereof in relation to the pharmaceutical and medicinal preparations.

6. The Plaintiff states that it holds the following trademark registrations in Class 5:

Trade Mark	Regn. No.	Class	Date	Goods
LIV.52	180564	5	10.7.57	Medicinal Preparations for the treatment of Disorders of liver
LIV.52	290061	5	10.8.73	-do-
LIV.52 (Label)	401959	5	25.2.87	Medicinal, pharmaceutical and ayurvedic preparations and substances”

It is stated that all the above registrations have been kept renewed till date.

7. The Defendant, M/s. SBL Limited, having its headquarters at Sahibabad, District Ghaziabad, U.P., is engaged in the business of manufacturing and marketing homoeopathic preparations. The Plaintiff alleges that the Defendant has dishonestly and malafide adopted the trademark “**LIV-T**” in relation to homeopathic preparations meant to cure liver disorders. The Plaintiff states that **Liv.52** and **LIV-T** are deceptively similar. In the plaint, it is stated that “the essential and distinguishable feature of both the trademarks being identical, i.e., “**LIV**”. The Defendant’s medicinal preparation is bound to be presumed to be another liver related medicinal preparation originating from the Plaintiff or having an association or nexus with the Plaintiff, which being false is a misrepresentation leading to

passing off of the Defendant's goods/business as those of the plaintiff. It is stated that "the suffix "52" in the Plaintiff's trademark or "T" in the Defendant's trademark are incapable of distinguishing any medicinal preparations of either of the parties or sufficient to prevent the likelihood of confusion or deception that is bound to occur on account of the essential feature "LIV" being identical."

8. It is submitted that the use of the trademark **LIV-T** by the Defendant in relation to liver related preparations which is phonetically and structurally identical to the trademark **Liv.52** of the Plaintiff further amounts to the violation of the Plaintiff's statutory right of exclusive use of the mark **Liv.52** and infringement of its trademark registrations under Section 29 (1) of the Trade & Merchandise Marks Act, 1958 ('TM Act 1958'). It is submitted that the adoption and use of the trademark **LIV-T** by the Defendant in relation to the identical trade and goods "is fraudulent, dishonest and totally illegal." It is alleged that the use of the said mark **LIV-T** by the Defendant in relation to identical trade and goods amounts to counterfeiting an offence under Sections 78 and 79 of the TM Act 1958.

9. The Plaintiff sent a legal notice on 14th March 1996 calling upon the Defendant to desist using the trademark **LIV-T**. However, the Defendant has continued using the said trademark. Accordingly, the present suit was filed seeking the relief of permanent injunction against the infringement and damages.

10. In the written statement filed by the Defendant, apart from raising a

preliminary objection as to the territorial jurisdiction of this Court to entertain the suit and the authorization under which the plaint has been filed, it is contended that the word "LIV" is generic and common to trade as describing the medicines associated with the treatment of liver. It is stated that "Liv" has become "*publici juris*" in the field of medicines and pharmaceuticals where it is common practice that the drugs are named either by the name of organ and or by the principle ingredients or the name of the ailment, thereby reducing the chances of error. It is submitted that a word or its abbreviation, having become *publici juris*, ceases to be the subject matter of proprietorship, and also ceases to be a source of deception or confusion for the persons likely to deal with such goods, who in any event would ignore the *publici juris* and distinguish the goods by either the prefixes or the suffixes.

11. It is then submitted that the conflict alleged by the Plaintiff is between two different products - one which is an ayurvedic medicine and the other a homeopathic preparation. It is submitted that a homeopathic preparation can be sold only through authorised homeopathic outlets having homeopathic drugs licence. The Plaintiff's product, which is an "ayurvedic proprietary medicine", is not sold through homeopathic outlets. However, the packaging, cartons, labels including the distinguishing features are different as are the colour schemes, placement of letters, and all other features. The composition of the two products are entirely different. The packaging carton of the Defendant's product prominently contains the name "SBL" which is written in capital letters, in a bold and prominent fashion and in a very large and prominent size along with the description

“Collaboration Boiron France” written in a smaller font size.

12. It is stated that the carton of the Defendant which features an artistic impression of the organ liver along with the letters in the word **LIV-T** written in close conjunction with each other constitutes an original artistic work under the Copyright Act, 1957 of which the answering Defendant is the proprietor. It is further pointed out that the word “LIV” is used as a prefix for the names of drugs for treatment of liver related problems by over fifty pharmaceutical companies. It is pointed out that it is used in several trademarks such as LIV CARD, LIV-UP, LIV-RIL-z, LIVCO, LIVO-10, LIVO-10 al, LIVAPLEX, LIVOFIT, LIVA, LIVOL, LIVDRO, LIVAZOL, LIVERITE, LIVERJET, LIVERNUT, LIVERPOL, LIVUP, LIVEX, LIVIVRON, LIVIBEE, LIVINA, LIVINOL, LIVIPREP, LIVIRILE, LIVIRONVITA, LIVIRUBRA and LIVITA. It is stated that there are at least eight ayurvedic and homeopathic preparations of eight different manufacturers having names beginning with ‘LIV’. These include LIVOMAP, LIVION, LIVANO, LIVOTRIT, LIVOSIN, LIVOGUARD, LIVOMYN and LIVOTONE. The Defendant, therefore, denies that they have dishonestly and malafide adopted the mark **LIV-T** in relation to its medicinal preparation and that the marks **LIV.52** and **LIV-T** are deceptively similar. Since **LIV** is an abbreviation of liver, and has been used in over 100 registrations as a constituent of the name under which the products relating to treatment associated with liver are being marketed, it is generic and common to trade as describing the medicines associated with the treatment of liver. The Defendant states that upon independent searches conducted by two trademark search agencies, it transpired that there are

several companies that have sought registration of trademarks such as LIVADDEX, LIVOGEN, LIVOTONE, LIVOVIBIN and LIVERON.

13. It is submitted that the Plaintiff's legal notice dated 14th March 1986 was replied on 7th May 1986 denying the allegations.

Proceedings in the case

14. By an order dated 23rd May 1996, a learned Single Judge of this Court issued an ex parte interim injunction, which was subsequently confirmed by the order dated 12th July 1996 in favour of the Plaintiff. Aggrieved by the said order, the Defendant filed FAO (OS) No. 301 of 1996 which was allowed by the judgment dated 15th July 1997 of the Division Bench of this Court reported as *S.B.L. Ltd. v. Himalayan Drugs Co. AIR 1998 Del 126*. It was held that "the two rival marks Liv.52 and LIV-T contain a common feature Liv which is not only descriptive but also *publici juris*; a customer will tend to ignore the common feature and will pay more attention to uncommon features i.e., 52 and T. The two do not have such phonetic similarity as to make it objectionable." It was held that nobody can claim exclusive right to the use of 'Liv' as a constituent of any trademark. It was further held that the two cartons were such that there was "no possibility of one being accused of deceptively similar with the other and the likely customer mistaking one with the other, even by recollecting faint impressions." The interim injunction was accordingly vacated.

15. The matter was then carried to the Supreme Court in SLP (Civil) No. 21173 of 1997 which was dismissed by the Supreme Court on 27th

February 1998 stating that the above judgment of the High Court was "in *CS (OS) No. 111/2006*

the nature of an interim order passed in a pending matter.” The High Court was requested to take up the main case and decide the same expeditiously. It was further observed: “It is needless to say that the learned trial judge will dispose of the matter without being influenced by the observations made in the impugned judgment.”

16. Issues were framed by an order dated 30th November 1998.

17. There was another development which requires to be mentioned. The suit was initially valued for the purpose of court fee jurisdiction at Rs. 5 lakh and was filed in this Court. But with the increase in pecuniary jurisdiction, the case was transferred to the Court of the learned Additional District Judge. Thereafter the Plaintiff filed an application under Order VI Rule 17 CPC to amend the plaint and value the suit at Rs. 20 lakhs. The said amendment was allowed by the order dated 29th March 2005. Thereafter the suit was again transferred to this Court.

Evidence

18. The Plaintiff examined six 6 witnesses. PW 1 was Mr. K.N. Jairaman, the Commercial Manager of the Plaintiff. Mr. Jairaman stated in his evidence that he has been in the employment of the Plaintiff since 1973. He has stated that ‘Liv.52’ is a coined trademark of the Plaintiff and the word ‘Liv’ is not a medically used term. He has also stated that the medicine ‘Liv.52’ is sold without medical prescription, as it is an Ayurvedic medicine. Mr. Jairaman has also informed that this product is sold through the Plaintiff’s 500 stockists throughout the country who in

turn sell the products to the retailers. The Plaintiff also has 500 field representatives promoting this product throughout the country. Mr. Jairaman states that in March 1996, they came to know about the use of the mark 'LIV-T' by the Defendant. Mr. Jairaman has stated that the grievance against the Defendant is that in the Defendant's trademark 'LIV-T', they have adopted the Plaintiff's essential word 'Liv', due to which a consumer is likely to identify the product of the Defendant as a product manufactured by the manufacturers of 'Liv.52', which amounts to a misrepresentation by the Defendant. He has also stated that on account of imperfect recollection on the part of the customer who bought 'Liv.52' before he bought 'LIV-T', the customer may presume that it is the same product which he purchased last. According to Mr. Jairaman, this amounts to misappropriation of the goodwill of the Plaintiff by the Defendant. He also said that the entire profits earned by the Defendant on sale of 'LIV-T' are the loss of the Plaintiff firm for which the Defendant must render accounts to show the profit earned by them on the sale of LIV-T.

19. Mr. Jairaman admitted that the Plaintiff is not selling Homeopathic preparations. However, he has stated that if they want they can sell even Homoeopathy and Allopathy medicines. Mr. Jairaman also stated that he has found the medicine 'LIV-T' being sold in shops other than Homeo shops. He has also mentioned that in the past also the Plaintiff has taken action against other persons using the word 'Liv'. He has provided the instances where the Plaintiff has opposed against the use of the marks 'Liv.up', 'Liv-Ril' and 'Liv-Card'.

20. However, during his further examination on 6th April 1999, Mr. Jairaman stated that he was not aware of the names being used by other companies for selling their preparations/medicines for liver disorder and he could not admit or deny the suggestion that other companies/firms are using the prefix 'Liv' in the names adopted by them for selling the medicines in respect of liver disorders. Mr. Jairaman has also admitted that there is no similarity between the cartons, label and bottle being used by the Plaintiff for 'Liv.52' and the label, carton and bottle being used by the Defendant for 'LIV-T'.

21. The next witness was Mr. Satish Doval, the retail pharmacist of Guardian Pharmacy. He has stated himself to be in business of selling medicines, allopathic, ayurvedic and homoeopathic for five years. He has mentioned 'Liv.52' as the drug sold maximum by him for liver disorders. He further deposed that if he comes across any promotion or literature of 'LIV-T', he will assume that it is another product from the manufacturer of Liv.52.

22. PW 3 was Mr. V. Vashisht, a consumer of 'Liv.52', who was running a garment fabrication unit in Noida. He stated that he was consuming 'Liv.52' for last six years for liver related ailments. He further states that he has not heard of any medicine other than 'Liv.52' for treatment of liver related ailments. After seeing the label 'LIV-T', he stated that he felt it should be by the manufacturers of 'Liv.52' as 'Liv' has been written on it.

23. PWs 4, 5 and 6 were Mr. Deepak Ohri, Mr. Atul Sarin and Mr. Navin Dutt respectively. They are the medical representatives of the Plaintiff who conducted survey on the significance of the distinctiveness of "Liv". They produced reports exhibited as Ex. PW 4/1 to PW 4/4, PW 5/1 to PW 5/4 and PW 6/1 to PW 6/2. PW 4 stated that he did not try to find out from doctors, chemists or from journals whether there were other drugs in the market for treatment of liver disorders.

24. The Defendant tendered three witnesses. DW 1 Mr. Sangeet Aggarwal, Manager-Finance & Accounts of SBL Ltd, DW 2 Mr. Rakesh Saxena, the Search Assistant of Indmark and DW 3 Mr. Amarnath Saini, an employee of the Defendant

25. DW 1 stated that the formulation of the Plaintiff's product and the Defendant's product were entirely different. He pointed out that 'Liv.52' is sold by the chemist and even by the general merchant and no prescription from a registered medical practitioner was required for purchasing it. 'LIV-T' is sold through licensed Homoeopathic drug retailer. He further stated that homoeopathic drugs are generally sold on the prescription of the person practising Homoeopathy. He stated that although 'LIV-T' is not a scheduled drug, it is sold only on prescription. He further deposed that for selling allopathic drugs, a licence is required under Form 20A and 20B of the Schedule to the DCA no licence is required for selling Ayurvedic drugs. He further stated that to his knowledge there were about 100 drugs

in the market with prefix word 'LIV'. It was not the invented word of the Plaintiff but a prefix traceable to the organ 'Liver'. He denied the statement that the chemists who are selling ayurvedic and allopathic drugs are also selling homoeopathic drugs.

26. DW 2 was the Search Assistant of Indmark, the company that issued search report Ex. DW 2/1 to DW 2/4. DW 3 Mr. Amarnath Saini, an employee of the Defendant since 1988, deposed that in ayurvedic, homoeopathic and allopathic medicines there may be more than one hundred medicines which starts with the name 'LIV' for liver related diseases. He also stated that homoeopathic medicines are sold exclusively from homoeopathic shops and only a qualified person can dispense homoeopathic medicines. He further stated that both medicines i.e. 'Liv.52' and 'LIV-T' cannot be sold to a person from the same counter.

Issue wise findings

27. Issue No.1: *Whether the plaint is signed, verified and the suit is instituted by a duly competent and authorised person?*

The onus to prove this issue is on the Plaintiff. The power of attorney ('PoA') in favour of Mr. B.L. Kakroo to institute the suit is Ex. PW 1/F and PW1 has also spoken about it. There is no cross-examination on this aspect. This issue is decided in favour of the Plaintiff and against the Defendant.

28. Issue No.2: *Whether this Court has no territorial jurisdiction to*
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entertain the present suit? (OPD).

The onus to prove this issue was on the Defendant. The Plaintiff has proved by production of an invoice Ex.P-2 that the product LIV-T of the Defendant is being sold at Delhi. In fact, there is no contest on this issue at all. This issue is decided against the Defendant and in favour of the Plaintiff.

29. Issue No.3: *Whether the suit is maintainable in its present form?*

Under Order XXX Rule 1, the partnership firm can sue or be sued in the name of the firm. The record of change of the constitution of the Petitioner firm is Ex. PW1/I. There was no cross-examination of PW-1 on this aspect. Ex.PW1/J is the application filed before the Trade Marks Registry in Form TM-24 for recording the additional partners as subsequent proprietors of the registered trade mark **Liv.52**. The order passed by the Registrar on 29th August 1996 is Ex. PW 1/K. It has been established that the Plaintiff has been able to discharge the onus of showing that the suit is maintainable in its present form. The issue is decided in favour of the Plaintiff and against the Defendant.

30. Issue No.4: *Whether there is no cause of action for institution of the present suit? (OPD)*

There is a specific averment in para 14 of the plaint that the use of the trademark **LIV-T** by the Defendant constitutes infringement and gives rise to the cause of action for the suit. The defendant has not been able to show that there is no cause of action for instituting the suit. This issue is decided

against the Defendant and in favour of the Plaintiff.

31. Issue No.5: *Whether the suit is barred by limitation? (OPD)*

It is averred in para 14 of the plaint that the Plaintiff came to know of the adoption by the Defendant of **LIV-T** in March 1996 and a legal notice was issued by the Plaintiff to the Defendant on 14th March 1996. The suit was filed on 16th May 1996. The Defendant has not been able to prove that the suit is barred by limitation. The issue is decided in favour of the Plaintiff and against the Defendant.

32. Issue No.6: *Whether the suit is bad for non-joinder of necessary parties? (OPD)*

The Defendant has failed to discharge the onus of showing that the suit is bad for non-joinder of necessary parties. This issue is decided in favour of the Plaintiff and against the Defendant.

33. Issue No.7: *Whether the suit is barred by principles of estoppel and waiver? (OPD)*

The Defendant has not led any evidence to show that the suit is barred by the principle of estoppel and waiver. This issue is decided in favour of the Plaintiff and against the Defendant.

34. Issue No.8: *Whether the products of the defendant company can be sold only through homeopathic outlets? (OPD)*

Elaborate arguments were advanced by the learned counsel for the

Defendant with reference to the Drugs and Cosmetics Act, 1940 ('DCA')

to demonstrate that there was a statutory requirement that homeopathic drugs should be sold only through authorised homeopathic outlets. While this may be correct, it is also true that a chemist shop can be authorised to sell both allopathic and homeopathic medicines and sometimes even the ayurvedic medicines. PW-2 has produced invoices of such sales which have been exhibited as PW 2/1 and PW 2/2. Consequently, it is seen that ayurvedic and homeopathic drugs can indeed be sold in the same shop side-by-side as long as the pharmacy holds licence for both. Therefore, this issue is answered by holding that the Defendant's drugs need not be sold only through homeopathic outlets but also through chemist shops which sell all forms of medicines as long as they conform to the requirements of the DCA and are duly licenced for that purpose.

35. Issue No.9: *Whether the Plaintiff is the proprietor of the trade mark "Liv.52" in respect of drugs and Pharmaceuticals? (OPP)*

The registration certificate Registration No. 180564 dated 10th July 1957 for the trade mark Liv.52 has been produced by the Plaintiff and marked as PW 1/B. The registration is valid and in terms of Section 28 of the TM Act 1958 it makes the Plaintiff the registered proprietor of the said registered trademark. Although the Defendant has averred in the written statement that the grant of such registration is not valid since the mark lacks distinctiveness, the fact remains that till date the Defendant has not raised any challenge to the validity of the grant of registration of the trademark Liv.52 in favour of the Plaintiff. Apart from the above, the Plaintiff has also sought to establish its proprietary right over the trade mark Liv.52 on account of long usage. Invoices of sales since 1972 have

been exhibited as Ex. PW 1/1 to PW 1/38. Ex. PW X-1 to X-14 is the literature pertaining to Liv.52. The evidence of PW-1 shows that Liv.52 is sold through 500 stockists throughout the country. Ex. PW 4/1 to PW 4/4, PW 5/1 to PW 5/4 and PW 6/1, PW 6/2 are the questionnaires filled by doctors from various parts of India subscribing to the popularity, goodwill and reputation of Liv.52.

36. The Plaintiff has also produced sales figures and promotional expenses figures of Liv.52 as Ex. PW 1/A. In 1987, the sale of Liv.52 was Rs. 9.36 crores, the year in which the Defendant claims it began using LIV-T for its products. In 1987-88, the promotional expenses were Rs.93 lakhs for Liv.52. The year in which the suit was filed i.e. 1996-97 the turnover for Liv.52 was over Rs. 35 crores and promotional expenses Rs. 3.5 crores. According to the Plaintiff, the current annual sale for Liv.52 for 2008-09 is over 91 crores with annual promotional expenses of Rs. 9 crores.

37. This Court is persuaded to hold that the Plaintiff is indeed the proprietor of the trademark Liv.52 in respect of drugs and pharmaceuticals. The issue is answered in favour of the Plaintiff and against the Defendant.

38. Issue No.10: *Whether the use of trade mark "LIV-T" by the defendant amounts to infringement of trade mark registration numbers 180564, 290061 and 401959 in class 5? (OPP)*

This is the key issue in the present suit. The question in short is whether by using the mark **LIV-T** for its product which is a homeopathic drug meant to treat liver ailments the Defendant has infringed the registered

trade mark of the Plaintiff i.e. **Liv.52** which is used for the Plaintiff's ayurvedic drug, also used for treating liver ailments.

Plaintiff's arguments

39. The principal submission by Mr. Hemant Singh, learned counsel for the Plaintiff is that it is the registered proprietor of the trade mark **Liv.52**. The Defendant over these years has not made any attempt at seeking rectification of the said registration. The suit, therefore, continues to remain one for infringement. Relying on the judgment in ***Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceuticals Laboratories AIR 1965 SC 980*** it is emphasised that there is a distinction between an 'infringement action' and a 'passing off action'. It is submitted that in an infringement action, it is only the similarity of "essential features" of the registered trade mark that need to be examined whereas in a passing off action notwithstanding said similarity, the Defendant can escape liability by showing that "added matters" to the features of similarity are sufficient to distinguish its goods.

40. Mr. Hemant Singh submits that keeping in view the above test as laid down in para 28 of ***Durga Dutt***, the present case requires comparison of the two marks **Liv.52** and **LIV-T** for the purposes of determining "deceptive similarity".

41. The case of the Plaintiff is that **LIV-T** is deceptively similar to **Liv.52** on account of its "overall structural and phonetic similarity" when compared as a whole, and when examined from the point of view of a man

of “average intelligence” and “imperfect recollection”, not having both drugs together for side by side comparison. Basing the argument on Section 29 of the TM Act 1958, reliance is placed on the judgment in *Amritdhara Pharmacy v. Satyadeo Gupta AIR 1963 SC 449*, *Corn Products Refining Co. v. Shangrila Food Products Ltd. AIR 1960 SC 142* and *Cadila Health Care Ltd. v. Cadila Pharma Ltd. AIR 2001 SC 1952*.

42. It is further submitted that while undertaking such comparison as a whole, no ‘disclaimer’ can be read in the prefix ‘LIV’ since no disclaimer exists on the Trade Mark Register. It is emphasized that the difference between ayurvedic and homeopathic medicinal preparations are irrelevant for the purposes of an infringement action since the registration of **Liv.52** includes homeopathic preparations. According to the Plaintiff, allopathic, ayurvedic and homeopathic preparations are “goods of same description” and hence are likely to be considered as “variants of each other.” Reliance is placed on the judgment in *Charak Pharmaceuticals v. Deepharma Ltd. AIR 1999 Delhi 15*. It is submitted that an unwary customer could easily mistake **LIV-T** to emanate from the same source as a homeopathic variant of **Liv.52**. Reliance is placed on *Sony Kabushiki Kaisha v. Mahaluxmi Textile Mills 2009 (41) PTC 184 (Cal.)* and *Lilly ICOS LLC v. Maiden Pharmaceuticals Ltd. 2009 (39) PTC 666 (Del)*.

43. Mr.Hemant Singh placed extensive reliance on *Cadila Health Care Ltd.* to urge that the fact that a drug is sold under prescription or only to physicians cannot by itself be considered as sufficient protection against confusion. According to the Plaintiff, in view of the varying infrastructure

for supervision of physicians and pharmacists and due to linguistic, urban, semi-urban and rural divide across the country, there is a high degree of possibility of accidental negligence in administering the wrong drug. Therefore, strict measures are required to be put in place for preventing confusion arising from similarity of marks among medicines. The Plaintiff urges that public interest supports a lesser degree of proof showing confusing similarity in case of a trademark in respect of medicinal products against non-medicinal products. According to the Plaintiff, the question that has to be answered is “what will be the effect of use of Liv.52 and LIV-T together in a homeopathic medicinal field.” The manner in which the business may be conducted in future is a relevant consideration. Reliance is placed on the judgment in *Laxmi Kant Patel v. Chetanbhai Shah AIR 2002 SC 275*.

Defendant's Arguments

44. Mr. Atishi Dipankar, learned counsel for the Defendant, first urges that marks are to be categorized on a sliding scale of distinctiveness from fanciful and arbitrary marks which enjoy a higher degree of protection to marks that are suggestive, descriptive or comprising generic terms. The latter, according to the Defendant, do not enjoy protection. On this scale, ‘Kodak’ will be a fanciful mark, ‘Apple’ for computers will be an arbitrary mark, ‘Coppertone and Whirlpool’ for washing machines would be suggestive marks, ‘Roller Blade and Weight Watchers’ can be descriptive marks and ‘Aspirin’ would be a generic mark. It is emphasised that the prefix “LIV” is essentially an abbreviated form of Liver which is the name of the organ the ailments of which are sought to be treated both by the

Plaintiff's drug as well as by the Defendant's drug. It is a known method of naming medicinal products. This is because both doctors and consumers can easily relate to the drug and recognise it as treating the organ whose name is incorporated in the name of the medicine. It is claimed that manufacturers consistently adopt this trade practice to popularize the medicines and to get their medicines easily identifiable by doctors and consumers.

45. Mr. Dipankar submits that the Plaintiff cannot claim monopoly over an organ name i.e. Liver or its abbreviation. Although at the stage of the interim injunction this was the stand of the Plaintiff, it has given up that case during the final hearing and is now asserting that the marks are to be compared as a whole and that the Plaintiff is not insisting on separating out the prefix 'LIV' and then asking for comparison of the marks after removing that prefix. It is submitted that this, in any event, does not make a difference to the case of the Defendant since even when comparing the marks as a whole, there is no deceptive similarity.

46. It is submitted that although according to the order of the Supreme Court, this Court has to decide the issue independent of the judgment of the Division Bench at the interlocutory stage in *SBL v. Himalaya Drug Co.* that judgment has been followed consistently in many other judgments of this Court. In particular, reference is made to *Khandelwal Laboratories Ltd. v. FDC Ltd. 2001 PTC 864 (Delhi)* where it was held that the marks 'CEFI' and 'ZIFI' are not deceptively similar since they are pronounced differently and visually appear quite different particularly when

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pronounced in the Devanagari script and being Scheduled drugs can only be purchased through a written prescription of a doctor or a registered medical practitioner and dispensed by a chemist or a registered pharmacist. In ***Pfizer Products Inc. v. B.L. & Co. 2002 (25) PTC 262 (Delhi)***, it was held that Sildenafil Citrate is a single active ingredient chemical compound consisting of certain elements and the drug was well known throughout the world for treatment of angina. There was nothing new or novel about the drug. It was held that just like in ***F. Hoffman v. Geoffrey Manners AIR 1970 SC 2062*** the Supreme Court had held that Dropovit and Protovit were not deceptively similar likewise Viagra and Penegra “when taken as a whole are completely dissimilar and cannot be slurred over in pronunciation”. In ***Astrazeneca U.K. Ltd. v. Orchid Chemicals & Pharmaceuticals Ltd. 2006 (32) PTC 733 (Delhi)*** which was later affirmed by the Division Bench in ***141 (2007) DLT 565***, it was emphasised that “nobody can claim exclusive right to use any word, abbreviation, or acronym which has become *publici juris*. In the trade of drugs, it is common practice to name a drug by the name of the organ or ailment which it treats or the main ingredient of the drug. Such an organ ailment or ingredient being *publici juris* or generic cannot be owned by anyone for use as trade mark.” In that case it was held that the two marks derived prefix ‘Mero’ from the drug ‘Meropenem’ and there was no similarity between ‘Meromer’ and ‘Meronem’. In ***Schering Corporation v. Getwell Life Sciences Pvt. Ltd. 2008 (37) PTC 487 (Delhi)*** which was affirmed by the Division Bench of this Court in ***Schering Corporation v. Alkem Laboratories Ltd FAO (OS) 313 of 2008***, again it was held that there was no similarity between ‘Temodal and ‘Temodar’ since the prefix derived

from the name of the chemical compound Temozolomide to arrive 'Temodal' and 'Temodar' on the one hand and 'Temoget' and 'Temokem' on the other. Reliance is also placed on *FDC Ltd. v. Ajay G. Piramal 2008 (38) PTC 97 (Delhi)* and *Lowenbrau AG v. Jagpin Breweries Ltd. 157 (2009) DLT 791*.

47. Mr. Dipankar, learned Counsel for the Defendant submitted that even prior to the judgment of the Division Bench in *SBL v. Himalaya Drug Co.* the Supreme Court and in *Panacea Biotec v. Recon 1996 PTC (16) 561* this Court had emphasized that if a manufacturer uses the name of a basic drug of which the medicine is constituted, no monopoly can be claimed in regard to the use of the same as a trade mark. In *Biofarma v. Sanjay Medical Store 66 (1997) DLT 705* again 'trivedon' and 'flavedon' were said to be dissimilar. 'Mexate' and 'Zexate' were found dissimilar in *Cadila Laboratories Ltd. v. Dabur India Limited 1997 PTC (17) 417*.

48. It is next submitted that as far as test of infringement is concerned, the essential requirement is of deceptive similarity. Reliance is placed on the observation of the Supreme Court in *Ramdev Food Products Pvt. Ltd. v. Arvind Bhai Ram Bhai Patel (2006) 8 SCC 726*.

49. It is submitted that there is no structural, phonetic and visual similarity between the two marks. It is submitted that in the Plaintiff's mark, "L" is written in capital and 'iv' are written in small letters and after "Liv" there

is a **dot** and after that there is numeral '52'. In Defendant's mark, "LIV" is written in Capital letters and after "LIV" there is a **hyphen** and after that there is alphabet 'T' and it is clear from the above that structurally both the marks are written in a totally different manner. It is emphasised that a numeral is meaningless whereas an alphabet may have a meaning and phonetically the two marks are totally different.

Anti-dissection rule

50. This Court proceeds to discuss the points urged. In the first place, there can be no dispute on the test of deceptive similarity which is now well-settled in *Durga Dutt, Amritdhara and Glucovita* cases. The marks indeed must be compared as a whole for determining if there is infringement without reading any disclaimer in any part thereof even if the similarity is in respect of descriptive marks.

51. The *anti-dissection rule* which is prevalent both in US as well as in India is really based upon customer behaviour. It has been succinctly set out in *McCarthy on Trade Marks and Unfair Competition* as under:

“23.15 Comparing Marks: Differences Versus Similarities

[1] The Anti-Dissection Rule

[a] Compare composites as a Whole

Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison. This is the “anti-dissection” rule. The rationale for the rule is that the commercial impression of a composite

trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. However, it is not a violation of the anti-dissection rule to view the component parts of conflicting composite marks as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole.

Thus, conflicting marks must be compared in their entireties. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. As the Supreme Court observed: “The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.”

The anti-dissection rule is based upon a common sense observation of customer behavior: the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall impression created by the mark from the ordinary shopper’s cursory observation in the marketplace that will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighed analysis in legal briefs.

In litigation over the alleged similarity of marks, the

owner will emphasize the similarities and the alleged infringer will emphasize the differences. The point is that the two marks should not be examined with a microscope to find the differences, for this is not the way the average purchaser views the marks. To the average buyer, the points of similarity are more important than minor points of difference. A court should not engage in “technical gymnastics” in an attempt to find some minor differences between conflicting marks. However, where there are both similarities and differences in the marks, there must be weighed against one another to see which predominate.

The rationale of the anti-dissection rule is based upon this assumption: “An average purchaser does not retain all the details of a mark, but rather the mental impression of the mark creates in its totality. It has been held to be a violation of the anti-dissection rule to focus upon the “prominent” feature of a mark and decide likely confusion solely upon that feature, ignoring all other elements of the mark. Similarly, it is improper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains.”

52. There is merit in the contention that where the trademark includes a generic component, the manufacturers are not precluded from using as part of their marks the said generic component. This is because the generic component will obviously not be the distinctive portion and the dominant portion would be dissimilar or non-generic portion. When the comparison of the marks are taken up as a whole, the distinctive portion of the trade

marks i.e. non-generic component would have to be compared and not the generic component.

53. The following passage in **McCarthy on Trademarks, IVth Edition, 2009** at page 23-203 is significant in this respect:

“23:49 Common “generic” element of marks

If a common portion of the two conflicting marks is a public domain generic name, the emphasis of enquiry should be upon the confusing similarity of the non-generic portion, with the ultimate issue determined by the confusing similarity of the total impression of both marks. For example, the Second Circuit found that the trademark HIBVAX does not infringe the mark HIB-IMMUNE, both for influenza vaccine against a type of influenza disease named by the generic term “HIB”. “[A] trademark infringement finding...cannot be based on the use of a generic or descriptive term such as ‘Hib.’

The presence of a generic term can make little difference in comparing otherwise similar marks. For example, the Federal Circuit found a likelihood of confusion between applicant’s JOSE GASPAR GOLD for tequila and the cited registration of GASPAR’S ALE for beer and ale. The presence of the generic word “ale” in the cited mark did not prevent likely confusion because it was proper to accord such a generic term less weight in judging the similarity of the marks.”

54. Likewise, in **Gilson on Trademarks** the following passage is relevant particularly with regard to pharmaceuticals products:

[iii] **Likelihood of Confusion.** Two issues set pharmaceutical cases apart when arguing likelihood of confusion. First, is the standard for showing confusion easier to meet in such cases? And second, who are the relevant purchasers for a showing of confusion?

[A] **Standard for Confusion with Pharmaceutical Products.** Some courts have held that, when pharmaceutical products are at issue, “any possibility” of confusion should be sufficient to find infringement, reasoning that public safety is at risk. However, this is not the standard set out in the Lanham Act, as more recent authority notes, and courts should not follow it.

55. It was repeatedly urged by learned counsel for the Plaintiff that the Plaintiff is not claiming any monopoly over the word ‘LIV’ and has no objection to its use so long as the use is not deceptively similar. However, the insistence was on the Defendant’s not adopting the same **structure** “for its mark”, i.e. a component of ‘LIV’ with a hyphen and an alphabet which according to the Plaintiff is structurally similar to the component of ‘Liv’ followed by a dot and the numeral 52. The case of the Plaintiff is that there is structural similarity in the two competing marks is on account of the following features:

- “i. both trademarks have LIV as a stand-alone first component;
- ii. LIV is followed by a hyphen/dot;
- iii. hyphen/dot is followed by alphabet/numeral.”

Comparison of marks

56. For a better appreciation of the above submission, the Plaintiff’s and

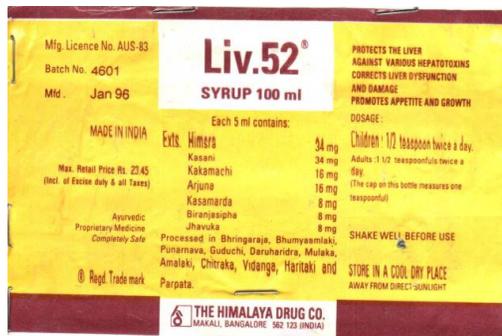
the Defendant's trademarks, as depicted on their respective bottles and cartons, are set out below:

Liv.52[®]

Plaintiff's mark

LIV-T

Defendant's mark



Plaintiff's packaging



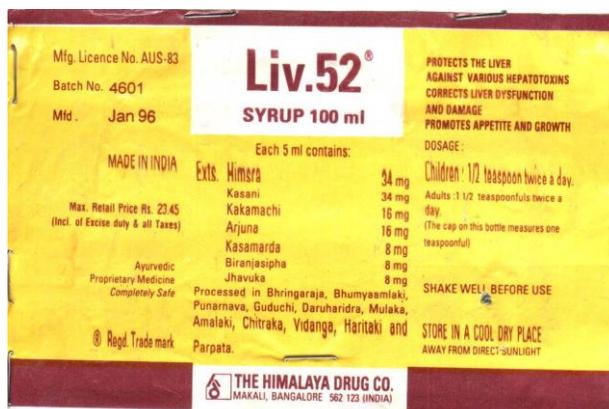
Defendant's packaging

Liv.52[®]

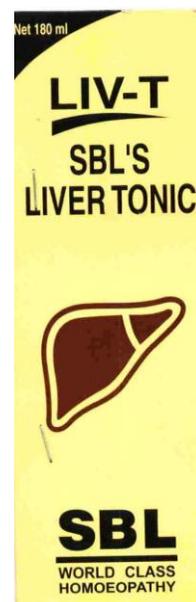
Plaintiff's mark

LIV-T

Defendant's present mark



Plaintiff's packaging



Defendant's present packaging

57. The emphasis by the Plaintiff on “LIV” as a standalone first component militates against its principal submission that the marks are to be compared as a whole. If “LIV” is non-distinctive, then it cannot form the basis for comparison. If one went by the rule of ‘dominant/weak component’, even then “LIV” alone cannot be compared. The marks ‘Liv.52’ and ‘LIV-T’ have to be compared as a whole. This Court is not persuaded to hold that a **dot** following **Liv** is similar to the **hyphen** following **LIV** and the alphabet “L” followed by “iv” in the small letters and a **dot** is the same as a **hyphen** following **LIV** written in the capital letters. It must be at once observed that these marks prominently figure on labels and cartons and, therefore, the visual impact that these marks leave on the human eye are distinctively different. **Liv** followed by a **dot** does not make the same impact as capital **LIV** followed by a **hyphen**. Further, the element of similarity which is urged by the Plaintiff is that the hyphen/dot is followed by an alphabet/numeral. This submission is premised on an understanding that there is essentially no difference between an alphabet and a numeral. This submission cannot be accepted when the name of a medicinal drug is figured prominently and one has it as an essential component of its mark and it brings out a degree of distinction. It cannot be said that there is similarity between the use of the alphabet and the use of the numeral.

No phonetic similarity

58. Next is the aspect of phonetic similarity. If one were to simply speak out the two marks **Liv.52** and **LIV-T** clearly they do not sound phonetically similar. Given the nature of the trade and the drugs which are

being sold under a mark what is likely to happen is one of the two things. Either the name of the drug is written in a prescription which is then read by the Pharmacist before dispensing the medicine. As already noticed, when he reads the name of the medicine as written it is unlikely that such pharmacist will make a mistake. What is more likely to happen, given the popularity enjoyed by both these medicines in their respective fields, a customer may indeed ask for either **Liv.52** or **LIV-T**. Phonetically, they do not sound same. There is unlikely to be any mistake in administering Liv-T instead of Liv.52 or vice-versa. Even otherwise, given the respective claims of the Plaintiff and the Defendant here, the two medicines are not likely to have side effects if consumed by a person needing treatment for a problem concerning the liver. In other words, the apprehension expressed in *Cadilla Healthcare* may factually not be justified in the present case.

Ayurvedic v. Homeopathic medicine

59. There is yet another aspect of the matter. A user of ayurvedic medicine or of homeopathic medicine usually understands the distinction between the two. Neither are they consumed simultaneously nor can they, given the different kinds of regimen that is usually asked to be followed by the practitioners of these two branches of medicine.

60. The evidence of the parties is not unequivocal as regards the availability of homeopathic medicines like LIV-T in a chemist's shop that deals essentially with ayurvedic medicines. PW-3, in his examination-in-chief admitted that he purchased homeopathic medicines from a shop other than the shop from which he used to purchase **Liv.52**. PW-4 admitted that

allopathic and homeopathic medicines can be stored only under licence. PW-2 also pleaded ignorance of any specific requirement for keeping allopathic, homeopathic and ayurvedic medicines separately but admitted that he was keeping them separately. He stated that he was not selling homeopathic medicines. In fact, he did not know if there was any medicine in homeopathy for liver diseases. He had heard of **Liv.52**, of LivFit manufactured by Dabur and Livogen by Glaxo. DW-1 stated that **LIV-T** was sold only on prescription and that only a person competent to deal in homeopathic drugs can sell them. To his knowledge, there were about 100 drugs in the market with the prefix word "LIV". He produced several cartons of such products as well as photographs. He asserted that both **Liv.52** and **LIV-T** could not be sold to a person through the same counter.

61. It is very difficult to come to the conclusion that an unwary customer entering into a chemist shop asking for **Liv.52** is likely to be deceived when she is given **LIV-T** instead. When she reads "SBL's LIV-T" she is further unlikely to mistake the origin of the product as that of the Plaintiff. The evidence produced by the Plaintiff does not prove its case of either likelihood of or actual deception or deceptive similarity. The submission that a customer with imperfect recollection who might see both **Liv.52** and **LIV-T** side-by-side lying on a shelf, will mistake one for the other, or they are produced by the same manufacturer is not backed by the evidence on record. What is significant to note is that it is not as if as in a department store, the customer walks around picking drugs off the shelf. There is a

person dispensing medicines. As pointed out by Gujarat High Court in *Cadila Healthcare Ltd. v. Swiss Pharma Pvt. Ltd. 2002 (24) PTC 708 (Guj)* “chemist shops are required to have a permanent skilled and qualified person to attend the shop, under whose supervision, all the activities or supply of drugs would go on. This further reduces chances of any mistake.” To this, it may be added that persons dispensing medicines in a chemist shop are usually aware of the different medicines produced by the different pharmaceutical companies. In fact, medicines are usually stacked on that basis. Certainly those behind the counter would make the distinction between ayurvedic and homeopathic medicines. There being at least 100 medicines prefixed with the word ‘LIV’ and used for treating liver diseases, it cannot be accepted that the person dispensing the medicines in the chemist’s shop will make a mistake by supplying to the customer who asks for an ayurvedic medicine, a homeopathic medicine and vice versa. Even assuming that there is no written prescription and the customer orally asks for **Liv.52**, the pharmacist is unlikely to hear it as **LIV-T**. A regular user of ayurvedic medicines is unlikely to accept **LIV-T** when what he was asking for was **Liv.52**. Even assuming that she is a first-time user, a cursory look at the carton or the label on the bottle will tell her whether it is the drug she asked.

No challenge to Plaintiff’s registered trademark

62. Mr.Hemant Singh learned counsel for the Plaintiff sought to distinguish the American cases by pointing out the differences between the Federal Trademark Act 1946 (The Lanham Act) in the USA, the TM Act
CS (OS) No. 111/2006

1958 and the Trade Marks Act, 1954 in UK. It is submitted that the issue of validity can be challenged by a Defendant at the final stage of infringement proceedings in the US courts and there is no statutory waiver against a Defendant who has not applied for cancellation. However in India, if no cancellation proceedings are filed by a Defendant who has taken the plea of invalidity, it leads to a waiver of such plea under Section 111(3) of the TM Act, 1958. It is contended, therefore, that under the Lanham Act while it will be open to the Defendant that 'LIV' being a weak component should be ignored, it is not open for the Defendant to raise such a plea before the Indian Courts at the final stage of a suit, in view of the specific bar and statutory waiver vide Section 111(3) of 1958 Act. Further it is pointed out that under Section 37 of the Lanham Act, the Court before which an infringement action is brought is empowered to examine the validity of a registered trademark even at the final stage of infringement proceedings whereas a Court in India is specifically barred by virtue of Section 125 of the TM Act, 1999. Here it is the Intellectual Properties Appellate Board ('IPAB') which will have to examine if the mark was validly registered. In the absence of any challenge to validity, it is submitted that the trade mark **Liv.52** must be considered entitled to protection as a whole and as granting the statutory right of "exclusive use" conferred by Section 28 "in respect of whole of trade mark and not any part thereof."

63. The above submission essentially concerns the question of validity of the Plaintiff's mark. Even if the Court proceeds on the footing that the

registration of the Plaintiff's mark has been validly granted and the Plaintiff is entitled to enforce its right to use '**Liv.52**' as a whole in terms of Section 28 of the TM Act 1958, the question that still remains is whether the use of '**LIV-T**' by the Defendant amounts to infringement of the Plaintiff's trademark '**Liv.52**'. The question, therefore, in the present case is not so much as whether on account of its trademark containing a generic component 'LIV', the Plaintiff's mark lacks distinctiveness and, therefore, is not a valid mark. That is also not the question raised by the Defendant at the stage of final argument. The Defendant proceeds on the footing that the Plaintiff has a valid registration for '**Liv.52**'.

Requirement of proof of "actual confusion" and not mere "likelihood of confusion"

64. The passages from **McCarthy** and **Gilson** as extracted hereinbefore are relevant for the purposes of the confusion that is likely to result in the mind of an unwary customer who goes to purchase a pharmaceutical product. Those passages reiterate the common law principles which are generally applicable irrespective of whether the suit in question permits or does not permit a challenge to the validity of a mark at the final stage of an infringement suit. At this stage, this Court would like to delve on the question of the Plaintiff in infringement action having to prove actual confusion and not merely a likelihood of confusion.

65. It appears that by and large most cases covered by the Trade Mark Act are contested intensely at the stage of interlocutory proceedings when evidence is not complete and a decision has to be taken only on the basis of

the documents and affidavits placed on record at that stage. Naturally, therefore, the Court is only considering whether by the Defendant using the infringing trademark, there is a likelihood of confusion and not whether there is actual confusion. In *Gilson on Trade Marks (2008 Edn, LexisNexis)*, while acknowledging that the Plaintiff in a trademark infringement need prove only that confusion is likely and that the Plaintiff need not show that actual confusion has occurred, the importance of proving actual confusion is highlighted in the following passage at Page 5-72:

“[3] Relevance of Lack of Evidence of Actual Confusion

Where products or services have co-existed in the marketplace for an extended period of time with no actual confusion and consumers would have reported any actual confusion, the factor weighs against a finding of likelihood of confusion. The Restatement (Third) of Unfair Competition notes that a court may infer that confusion is not likely “from absence of proof of actual confusion if the actor and the other have made significant use of their respective designations in the same geographic market for a substantial period of time, and any resulting confusion would ordinarily be manifested by provable facts. One of the Federal Circuit’s *du Pont* factors and one of the Third Circuit’s Lapp factors explicitly direct those courts to analyze the length of time and conditions under which there has been concurrent use of the marks without evidence of actual confusion. Courts reason that if there were any confusion between the marks at issue, it would

have manifested itself over the time the marks were used simultaneously in the marketplace.”

66. In the present case, the suit itself has been pending nearly for 15 years. The Defendant’s drug is in the market for over 20 years. The Plaintiff’s drugs have been in the market for over 50 years. The sales of neither drugs has diminished. Even on the Plaintiff’s own showing, the sales turnover in ‘**Liv.52**’ has been progressing from year to year as also that of ‘**LIV-T**’. In other words, it does not appear that ‘**LIV-T**’ has made any dent whatsoever in the market for ‘**Liv.52**’. If it did, the Plaintiff’s evidence does not show it.

67. **Gilson on Trademarks** points out at page 5-73 that for proving actual confusion “the Trademark owners alleging infringement may prove actual confusion through direct consumer testimony, consumer surveys and anecdotal evidence of consumer confusion.” Further, it is observed that “in sum, confusion occurs when consumers believe erroneously that the senior mark user manufactures the junior mark user’s product or that the senior mark user sponsored or approved of the junior mark user’s product. A simple mental association with the senior mark is not sufficient to show confusion between the marks. Where consumers contact a company and ask whether it is associated with the alleged infringer, such question may not demonstrate the existence of actual confusion where they indicate that consumers are aware that there is a distinction between the companies. Further, where a consumer is merely reminded of the Plaintiff’s product upon seeing the defendant’s such evidence does not show actual confusion.

Courts do not give much weight to simple inquiries about the parties' relationship.”

68. In the instant case, the customer surveys were sought to be relied upon by the Plaintiff leave a close-ended question which refers to essentially the Plaintiff's product instead of bringing out the aspect of confusion *vis-a-vis* the Defendant's product. The evidence so produced does not satisfy the requirement of showing either likelihood of confusion much less the actual confusion. In the considered view of this Court, during the long pendency of the case and with the trial in progress over several years during which a number of witnesses have been examined, the Plaintiff was in a position to prove actual confusion. This is because during these many years if there was any likelihood of confusion, it should have been reflected in a drop of the sales of the Plaintiff's drug when compared to an increase of sales of the Defendant's drug. The Plaintiff should have been able to show that there is actual confusion in the minds of the customers. As already observed, as far as the present case is concerned, the Plaintiff has not been able to show even a likelihood of confusion.

69. For the aforementioned reasons, it is held that there is no visual, phonetic or structural similarity in the two trademarks which is likely to cause deception or confusion. On comparing the two trademarks taken as a whole, it is not possible to hold that the use of the trademark 'LIV-T' by the Defendant amounts to infringement of trademark Registration Nos.

180564, 290061 and 401959 in Class 5. The aforementioned issue is, therefore, decided against the Plaintiff and in favour of the Defendant.

70. Issue No. 11: *Whether the use of trade mark “LIV-T” by the defendant amounts to passing off the goods of the defendant as that of the plaintiff? (OPP)*

The Plaintiff has not pressed the relief of passing off and, therefore, there is no need to decide this issue.

71. Issue No. 12: *Whether the word mark “LIV” is Publici-Juris and if so, to what effect? (OPD)*

The Defendant has produced the trade mark survey report to support its plea that ‘LIV’ is *publici juris*. The Plaintiff points out that the said survey report does not prove the use of the mark. It relies upon para 15 of the judgment of the Supreme Court in *Shangrila*. Further it has been pleaded that the Plaintiff is not required to sue every infringer and the plea of “common to trade” is not maintainable unless the cited infringement are proven to be substantial. Reliance is placed on the decision in *National Bell Co. v. Metal Goods Manufacturing Company AIR 1971 SC 898 at 908* and *Dabur v. Pankaj Goel 2008 (38) PTC 49*. Reliance is placed on the judgment in *Tarun K. Narayanan v. S. Murali AIR 2008 SC 3261* where it was held that mere filing for trademark registration application by a party does not give rise to any cause of action for passing off. Further, the entries in the register are not relevant for determining if the mark has been used by either party for long.

72. The above submissions ignore the fact that the Plaintiff itself is not claiming monopoly in 'LIV' and has stated that "it has no objection to it so long that its use is not deceptively similar."

73. As pointed out by the Defendant, 'LIV' is really an abbreviation of Liver which is a generic name of an organ. It is, in any event, understood as such. There appear to be a number of drugs in the market using the prefix 'LIV' for their names. Notwithstanding the survey report, the evidence of the witnesses in the present case bear this out. Many of the cartons of such marks including the photographs have been placed on record.

74. In the considered view of this Court, the Defendant has been able to show that 'LIV' is *publici juris* and, therefore, when the two marks **Liv.52** and **LIV-T** are compared, 'LIV' will be considered as the generic and non-distinctive part of the mark which, therefore, will have to be kept out of comparison. The issue is, therefore, answered in favour of the Defendant and against the Plaintiff.

75. Issue No. 13: *Whether the suit suffers from delay, laches and acquiescence and if so, to what effect? (OPD)*

The Defendant has not been able to show that the suit is barred by laches.

The issue is decided against Defendant and in favour of the Plaintiff.

76. Issue No. 14: *Whether the plaintiff is entitled to relief for rendition of accounts and if so, its nature of relief? (OPP)*

In view of the findings of this Court that there is no deceptive similarity in the use by the Defendant of the trade mark 'LIV-T' for its homeopathic medicines for treating liver related ailments *vis-à-vis* the Plaintiff's ayurvedic medicine 'Liv.52' the question of the Plaintiff being entitled for relief for rendition of accounts does not arise. The issue is decided against the Plaintiff.

77. Issue No. 15: *Relief.*

For all of the aforementioned reasons, the suit is dismissed with costs of Rs.50,000/- which will be paid by the Plaintiff to the Defendant within a period of four weeks.

S. MURALIDHAR, J.

JUNE 3, 2010
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