

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Judgment reserved on: 25.09.2009
+ **Judgment delivered on: 01.12.2009**

% **1. FAO(OS) 313 OF 2008**

SCHERING CORPORATION & ORS.Appellants
Through: Mr. Sachin Datta, Ms.
Lakshmi Ramamurthy Ms.
Shaila Arora, and Mr. Amit
Mehta, Advocates

VERSUS

ALKEM LABORATORIES LTD.Respondent
Through: Mr. Praveen Anand, Ms.
Ishani Chandra and Ms.
Vaishali Kakra, Advocates

AND

2. FAO(OS) 314 OF 2008

SCHERING CORPORATION & ORS.Appellants
Through: Mr. Sachin Datta, Ms.
Lakshmi Ramamurthy, Ms.
Shaila Arora and Mr. Amit
Mehta, Advocates

VERSUS

GETWELL LIFE SCIENCES INDIA PRIVATE LIMITEDRespondent
Through: Mr. Praveen Anand, Ms.
Ishani Chandra and Ms.
Vaishali Kakra, Advocates

CORAM:
HON'BLE MR. JUSTICE MUKUL MUDGAL
HON'BLE MR. JUSTICE VIPIN SANGHI

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| 1. Whether the Reporters of local papers may be allowed to see the judgment? | No |
| 2. To be referred to Reporter or not? | Yes |
| 3. Whether the judgment should be reported in the Digest? | Yes |

VIPIN SANGHI, J.

1. The present appeals have been filed by the appellants Schering Corporation, Schering-Plough Ltd. and Fulford (India) Ltd. under Order 43 Rule 1(r) CPC. They are directed against the identical orders dated 04th July, 2008 passed by the Learned Single Judge dismissing the appellants'/plaintiffs' applications under Order 39 Rules 1 & 2 in the two suits CS (OS) No.730/2007 (out of which FAO(OS) No. 313/2008 arises) and CS(OS) No.361/2007 (out of which FAO(OS) 314/2008 arises) and vacating the *ex parte ad interim* orders of injunction passed in the said suits.

2. These interim applications had been filed to seek grant of an interim injunction to restrain the Respondent Alkem Laboratories Ltd. (Defendant in CS(OS) NO. 730/2007) (hereinafter referred to as ALKEM) and Getwell Sciences India Pvt. Ltd (Defendant in Suit No. 361/2007) (hereinafter referred to as GETWELL) from using the marks TEMOKEM and TEMOGET respectively in relation to their pharmaceutical products — the active ingredient whereof is TEMOZOLOMIDE, a drug administered for the treatment of brain cancer.

3. The appellants filed the aforesaid two suits to, inter alia, seek permanent injunction to restrain infringement of registered trademarks, copyright, passing off, dilution, unfair competition,

rendition of accounts of profits, deliver-up etc. against the aforesaid respondents ALKEM & GETWELL respectively.

4. The appellants have disclosed the genesis of the TEMOZOLOMIDE molecule and its marks TEMODAL and TEMODAR used by the appellants. In 1984 one Professor Steven synthesized a molecule and named it TEMOZOLOMIDE. In 1991 the Cancer Research Campaign Technology Ltd., UK acquired rights to the TEMOZOLOMIDE technology from its maker, Prof. Stevens. In 1992 the appellants obtained worldwide license for TEMOZOLOMIDE technology from the aforesaid Cancer Technology Ltd. and initiated their research and development of a brain cancer drug. The drug was approved as a medical drug for cancer treatment in 1999. The appellants then filed for TEMODAL as their Trademark for their TEMOZOLOMIDE-based drug. According to the appellants the drug is being sold in India ever since 17.01.2000. Even the mark TEMODAL was registered in India in favor of the appellant *vide* registration no.687936 w.e.f. 23.11.1995 in class 5, which, *inter alia*, relates to pharmaceuticals including alkylating cytotoxic agents for the treatment of various types of cancer. Similarly, TEMODAR is registered in name of appellant no. 3 *vide* registration no. 888816 w.e.f 29.11.1999.

5. The appellants claim that they are global science-based health care business entities with leading prescription, consumer and animal health products. The mark TEMODAL existed in the appellants' portfolio since 1978 and was first applied by them for

“Psychopharmaceutical Preparations” in Class 5 in Norway, Denmark and Sweden. The appellants commenced sales in Europe and thereafter in other parts of the world along with filing for registration of the mark TEMODAL in those respective countries, which they successfully acquired too.

6. The appellants claim to have come to know that the respondent ALKEM was marketing and selling an almost identically positioned drug (for treatment of brain cancer or glioblastoma multiforme) under the mark TEMOKEM which, according to the appellants, was phonetically, linguistically, textually, visibly, manifestly, confusingly and deceptively similar to their marks TEMODAL/TEMODAR. They also came to know that the respondent ALKEM had submitted a “Proposed to be used” application bearing number 1348168 in class 5 for registration of the mark TEMOKEM and the same was advertised in Trademark Journal no. 1335-0 dated 01.11.2006 made available to the public on 03.03.2007. In answer to this, the appellants have filed a notice of opposition dated 23.03.2007 to the above application and the same is still pending.

7. The appellants alleged infringement of trademarks under section 29 of the Trademarks Act, 1999 (hereinafter referred to as ‘The Act’) and also passing off against the respondent ALKEM, in their civil suit, being CS(OS) No.730 of 2007 filed on the original side of this Court.

8. It appears that the learned Single Judge passed an *ex parte ad interim* order of injunction in favour of the appellants, and against the respondent ALKEM on 23.04.2007 thereby restraining the respondent ALKEM from launching/using, advertising, promoting, stocking, offering for sale or distributing or otherwise using trademark "TEMOKEM" or any other mark deceptively or confusingly similar to that of the plaintiff's registered trademark "TEMODAL/TEMODAR" as a drug used especially for treatment of brain cancer. However, after notice to the respondent ALKEM, and after hearing the parties the learned Single Judge by the impugned order has vacated the aforesaid order dated 23.04.2007 and dismissed the appellants' application under Order 39 Rules 1 & 2 CPC being I.A. No.4555/2007 while allowing respondent's application being I.A. No.6041/2007 filed under Order 39 Rule 4 CPC.

9. Similarly, in CS (OS) No.361/2007 wherein GETWELL is the defendant, the appellants claimed that they came to know in December, 2006 of the defendant/respondent marketing and selling an identically positioned drug by GETWELL under the brand name 'TEMOGET' in Delhi and also in other towns of India. The appellants also stated that they had made enquiries with regard to the making of an application for registration of the trademark 'TEMOGET' by the respondent GETWELL, but the search had produced no results.

10. The learned Single Judge initially passed an *ex parte ad interim injunction* order on 27.02.2007 thereby restraining GETWELL

from advertising, promoting, stocking, offering for sale or distributing or otherwise using trademark "TEMOGET" or any other mark deceptively or confusingly similar to that of the plaintiff's registered trademark "TEMODAL/TEMODAR" as a drug used especially for treatment of brain cancer. After notice to and hearing the respondent GETWELL the *ex parte ad interim* order of injunction was vacated by the impugned order dated 04.07.2008 and the appellants application under Order 39 Rule 1 & 2 CPC being I.A. No.2226/2007 was dismissed.

11. The learned Single Judge in his impugned orders observed that the term 'TEMO' used in the appellant's registered trademarks as well as in the respondent's trademarks are derived from the name of the chemical compound TEMOZOLOMIDE. To the said term 'TEMO' the appellants had added the suffix 'DAL' and 'DAR' to arrive at the trademarks 'TEMODAL' and 'TEMODAR' respectively. On the other hand, respondents had added the suffix 'KEM' and 'GET' which are the parts of the respondent's company names, to arrive at the trademark 'TEMOKEM' and 'TEMOGET' respectively. The learned Single Judge held that all the trademarks, as aforesaid, are portmanteau words. He further held as follows:

"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."

12. He held that the respondents were able to show the derivation of the trademarks 'TEMOKEM' and 'TEMOGET' by employing 'TEMO' from TEMOZOLOMIDE and 'KEM' from the name of the respondent ALKEM and, similarly, 'GET' from the name of the respondent GETWELL, respectively. The combined effect of 'TEMO' and 'KEM' would be TEMOZOLOMIDE manufactured by Alkem Laboratories. Similarly, the combined effect of 'TEMO' and 'GET' is TEMOZOLOMIDE manufactured by Getwell.

13. The learned Single Judge relied on the decision of this court in ***Kalindi Medicure Pvt. Ltd. Vs. Intas Pharmaceuticals Limited and Anr.*** 2007 (34) PTC 18 (Del) wherein this Court had taken note of the established practice that in pharmaceutical trade names of various drugs are often 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. In that case, while one of

the products was sold in the form of pills in aluminum foils, the other competing product was sold in pre filled syringes. The price difference in the competing products was also taken into account for vacating the *ex parte* injunction granted in favour of the plaintiff in that case.

14. The learned Single Judge heavily relied on the Division Bench Judgment of this Court in ***Astrazeneca UK Ltd. & Anr. Vs. Orchid Chemicals & Pharmaceuticals Ltd.*** 2007 (34) PTC 469 (DB) (Delhi) which concerned the claim for infringement of the plaintiffs/appellants registered trademark 'MERONEM' by the defendants/respondents use of the trademark 'MEROMER'. Both the products were derived from the active ingredient 'MEROPENEM'. The Division Bench of this Court came to the conclusion that 'MEROPENEM' is a molecule which is used for treatment of bacterial infection and the term 'MERO' being an abbreviation of the generic term 'MEROPENEM' was *publici juris*. Consequently, the appellants/plaintiffs in that case were held not entitled to claim exclusive rights to the use of the term 'MERO' as a constituent of the trademark in question as it was descriptive of the appellants'/plaintiffs' drug. The Division Bench further held that the common feature in both the competing marks 'MERO' being descriptive and *publici juris*, 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 following paragraph from the said decision of the Division Bench was particularly referred by the learned Single Judge :

“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.”

15. The learned Single Judge noted the view of the Division Bench in **Astrazeneca** (supra) that in the trade of drugs it was a common practice to name the drug by the name of the organ or ailment which it treated or the main ingredient of the drug. The name of such an organ, ailment or ingredient being *publici juris* or generic, could not be claimed by anyone exclusively for use as a trademark. The argument of the appellant that it was the first to have adopted and use the name ‘TEMO’, and that the appellants had trans-border reputation [which were claimed to be the distinguishing feature from the **Astrazeneca** (supra) case] was rejected by the learned Single Judge as the claim of the appellants was founded upon an alleged

infringement of registered trademark. It was also not a case where the respondents had raised a defence of prior use under Section 34 of the Act, where again, the question of “who used the mark first” would be relevant. The case of the appellants was one of infringement under Section 29 of the Act and the only question which required consideration was whether the respondent’s trademarks were deceptively similar to the appellants registered trademarks, which could lead to confusion in the mind of the purchaser to purchase the drugs of the respondents, while intending to purchase the appellants drugs.

16. The learned Single Judge held that the present cases are squarely covered by the decision of the Division Bench in **Astrazeneca** (supra).

17. The learned Single Judge also took note of the decision in **Bhagwan Dass Gupta Vs. Shri Shiv Shankar Tirath Yatra Company Pvt. Ltd.** 93 (2001) DLT 406 wherein a learned Single Judge of this court noted that the basic test to find out whether a trademark is *publici juris* is whether 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 learned Single Judge held that as TEMOZOLOMIDE is a generic word and is *publici juris* and nobody can claim exclusivity in respect of the same. Consequently, the clipped expression ‘TEMO’ derived from clipping

word TEMOZOLOMIDE would also be *publici juris* over which no person could claim exclusive proprietorship.

18. The learned Single Judge also placed reliance on another decision of this Court in ***Cadila Laboratories Ltd. V. Dabur India Ltd.***, 1997 PTC (17) 417. The competing marks considered in the said case were `MEXATE' AND `ZEXATE'. The suffix `EXATE' was common to both the marks, the only difference being in the prefix `M' & `Z'. It was held in that case that where the suffix is common, prefix would have to be compared to see whether the marks are deceptively similar. The following extract from ***Cadila*** (supra) was quoted by the learned single Judge in the impugned order:

“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.”

19. The learned single Judge rejected the appellants reliance on the decision of the Supreme Court in ***Milment Oftho Industries & Ors V. Allergan Inc.***, 2004 (28) PTC 585 (SC) on the ground that the said decision was rendered in a case of passing of and not in an action for infringement of trade mark. The competing marks in the case of ***Milment*** (supra) were identical. Both the plaintiff and the defendant had adopted `OCUFLOX' as their trade mark. However, in the present cases the marks of the appellants and the respondents are not

identical. For the same reason, the decision in ***Pfizer Ireland Pharmaceuticals V. Intas Pharmaceuticals & Anr.***, (2004) 28 PTC 456 (Del) (The Lipitor v. Lipicor case) was distinguished.

20. Reliance placed by the appellants on the decision in ***Hoechst Pharmaceuticals Ltd & Ors V. Government of India & Ors***, 1983 PTC 265 (Del) (DB) was also rejected as it proceeded on the assumption that the appellants products are superior to that of the respondent. The said basis could not be accepted at the *prima facie* stage, particularly, when the respondent had obtained drug licence under the Drug and Cosmetics Act, 1940. For the same reason, the learned Single Judge rejected the appellants reliance on the decision in ***Ramdev Food Products (P) Ltd. V. Arvindbhai Rambhai Patel & Ors.***, (2006) 8 SCC 726.

21. The learned single Judge also held that the trade marks 'TEMODAL' & 'TEMODAR' of the appellants were not identical with the trademarks TEMOKEM and TEMOGET. He held that there was no phonetic or visual similarity between the marks. The Court *prima facie* came to the conclusion that the suffix 'KEM' and 'GET' are entirely different and distinct from the suffix 'DAL' and 'DAR' used in the appellants trademarks. *Prima facie* the comparison of the competing marks did not show phonetic or visual similarity between the respondent's marks with the trademarks of the appellants and the respondents' marks were not prone to deceive the consumers. He also took into account the fact that TEMOZOLOMIDE is a schedule 'H' drug

which could be sold in retail only on the prescription of a registered medical practitioner. The same, though not sufficient to answer a case of “no deception”, was an important factor considering the fact that the product in question is a highly specialized drug and used for specific treatment of a type of brain cancer. The Court also took notice of the fact that in the case of both the respondents, their packaging of the drugs contained the warning “*to be supplied against demand from cancer hospitals, institutions and against the prescription of a cancer specialist only.*”

22. The immense price difference between the products of the appellants on the one hand and those of the respondents was also taken note of by the learned single Judge. Whereas a set of 5 capsules of 100 mg of TEMODAL/TEMODAR are sold for Rs.33,602/-, 5 capsules of 100 mg each of TEMOKAM are sold for Rs.6,300/- and a set of 5 capsules of 250 mg each of TEMOGET sell for Rs.12,000/-.

23. For the aforesaid reasons, the learned single Judge dismissed the interim injunction applications filed by the appellants in the two suits.

24. Learned counsel for the parties have made elaborate submissions in support of their cases.

25. As noted above, the learned Single Judge has held that the present cases are covered by the Division Bench decision in **Astrazeneca** (supra). We have, therefore, gone through the said

judgment. Before we proceed further, in our view it is essential for us to deal with the appellants' submissions vis-à-vis **Astrazeneca** (supra), as the scope of the parties' submissions which we need to consider in this appeal would depend upon our understanding of the said judgment.

26. In **Astrazeneca** (supra) both the appellant/plaintiff and the respondent/defendant had got their marks registered, though the appellant/plaintiff had moved an application for rectification in respect of the respondents/defendants trade mark 'MEROMER'. The appellant had contended that since 1995-96, the drug under the brand name 'MERONEM' was being marketed by it in over 89 countries. On the other hand, the respondent/defendant had launched their drug 'MEROMER' in India sometime in November, 2004 and they were granted registration of the trade name 'MEROMER' on the basis of their application for registration filed on 2.8.2004 in Class 5. The appellant/plaintiff had contended that the trade name 'MEROMER' of the respondent as a whole be compared with the trade mark of the appellant/plaintiffs i.e. 'MERONEM' and on such comparison it would be clear that both are deceptively similar. On the other hand, the respondent/defendant had contended that an action for infringement was not maintainable in view of the provisions contained in Section 29 & 32(e) of the Act which provide, inter alia, that use of a mark by its registered proprietor shall not constitute infringement.

27. The learned single Judge held that the two trademarks are phonetically not similar and that the two marks are distinct. He also held that if an injunction as sought for is granted by restraining the respondents/defendants from selling, marketing or in any manner dealing with the drug `MEROPENEM' under the trade name `MEROMER' there would be irreparable inconvenience caused to the respondents/defendants, whereas the loss of the appellants/plaintiffs if any, which is more financial in nature could be safeguarded by directing the respondent/defendants to maintain accounts of sale under the trade name `MEROMER'. The appellant/plaintiff in **Astrazeneca** (supra) placed reliance on the decision of the Supreme Court in **Cadila Health Care Ltd. V. Cadila Pharmaceuticals Ltd.**, 2001 PTC 541 (SC). The Division Bench in **Astrazeneca** culled out the principles laid down by the Supreme Court which would be applicable to a passing off action involving medicinal products. The Supreme Court held that the test to be applied to adjudge the violation of trade mark may not be at par with the case involving non- medicinal products. The Division Bench then proceeded to take notice of an earlier Division Bench judgment of this Court in **SBL Limited. V. Himalaya Drug company**, 1997 PTC (17) 540 and quoted the following observation of the Court:

“25.(3) 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.”

28. The Division Bench in **Astrazeneca** (supra) also referred to two other decisions in **M/s Biofarma V, Sanjay Medical Stores**, 1997 PTC (17) 355 and **Cadila Laboratories V. Dabur India Limited**, 1997 PTC (17) 417 wherein Dr. Mukundakam Sharma, J, as his Lordship then was, had occasion to deal with the trade names `TRIVEDON' and `FLAREDON' in the first case and `MEXATE' and `ZEXATE' in the second case. The Division Bench culled out the following extract from the decision in **M/s Biofarma** (supra):

“Section 2(d) of the Trade and Merchandise Marks Act 1958, (hereinafter referred to as the Act) defines the word ‘deceptively similar’ as which would be deemed to be deceptively similar to another mark if it so nearly resembles that other mark so as likely to deceive or cause confusion. For deciding the question of deceptive similarity the Courts have laid down the following factors to be considered:

(a) The nature of the marks, i.e. whether the marks are world marks or level marks or composite marks, i.e. both world and level marks.

(b) the degree of resemblance between the marks, phonetically similar and hence similar in idea

(c) the nature of the goods in respect of which they are used to trade marks

(d) the similarity in the nature, character and performance of the goods of the rival traders.

(e) The class of purchasers who are likely to buy the goods bearing the marks they require on education and intelligence and a degree of care they are likely to exercise in purchasing the goods.

(f) the mode of purchasing the goods or placing orders for the goods; and

(g) Any other surrounding circumstances.”

29. In **M/s Biofarma** (supra) it was held that since the opening syllable of the two competing trade marks in the said case are completely different and distinct, and in pharmaceutical trade it is natural to find names of various drugs almost similar to each other or having the same prefix or suffix, the competing marks viz. ‘FLAREDON’ and ‘TRIVEDON’ are dissimilar as the two marks start with distinct dissimilarities so far as the first syllable is concerned. Similarly, in the other decision namely, **Cadila Laboratories v. Dabur India Limited** (supra) it was held that there is no possibility of ‘Mexate’ being pronounced and read as ‘Zexate’. It was also laid down that 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.

30. The observation of the Division Bench in **Astrazeneca** (supra) in paragraph 19 has been taken note of by the learned single Judge and has been extracted by us above. The Division Bench also took note of the fact that there are other similar names with the prefix ‘MERO’. The Division Bench further observed: -

“20. In the decisions of the Supreme Court and this Court also, it has been clearly held 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 exclusively for use as a trade mark. In the Division Bench decision of this Court in SBL Limited (supra) it was also held that possibility of deception or confusion is reduced practically to nil in view of the fact that the medicine will be sold on medical prescription and by licensed dealers well versed in the field and having knowledge of medicines. It was further 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* and that a customer will tend to ignore the common feature and will pay more attention to uncommon features i.e. ‘52’ and ‘T’ and that the two do not have such phonetic similarity so as to make it objectionable.

21. In our considered opinion the facts of the said case are almost similar and squarely applicable to the facts of the present case. ‘Meropenem’ is the molecule which is used for treatment of bacterial infections. In that view of the matter, the abbreviation ‘Mero’ became a generic term, is *publici juris* and it is distinctive in nature. Consequently, the appellants/plaintiffs cannot claim exclusive right to the use of ‘Mero’ as constituent of any trademark. The possibility of deception or confusion is also reduced practically to nil in view of the fact that the medicine is sold only on prescription by dealers. The common feature in both the competing marks i.e. ‘Mero’ is only descriptive and *publici juris* and, therefore, the customers would tend to ignore the common feature and would pay more attention to the uncommon feature. Even if they are expressed as a whole, the two did not have any phonetic similarity to make it objectionable. There are at least four other

registered users of the prefix 'Mero' in India whereas the names of 35 companies using 'Mero' trademarks, which have been registered or applied for registration, have been furnished in the pleadings."

31. The Division Bench held that the two names, namely, 'MERONEM' and 'MEROMER' were *prima facie* dissimilar to each other. They were Schedule-H drugs available only on doctor's prescription. The factum that the same were available only on doctor's prescription and not as an *over the counter* medicine was also considered relevant and it was held to have been rightly taken note of by the learned Single Judge. The Division Bench also opined that in its opinion, where the marks are distinct and the features are found to be dis-similar, they are not likely to create any confusion. It was also admitted by the parties that there was a difference in the price of the two products. This fact was also considered relevant by the Division Bench. It was held that the very fact that the two pharmaceutical products, one of the appellants/plaintiffs and the other of the respondent/ defendant, were being sold at different prices itself would ensure that there was no possibility of any deception/confusion, particularly in view of the fact that customer who came with the intention of purchasing the product of the appellants/plaintiffs would never settle for the product of the respondent/defendant which was priced much lower. The Bench held that it was apparent that the trademarks of the two products in question were totally dissimilar and different.

32. No doubt, in **Astrazeneca** (supra) the additional factor in favour of the respondent/defendants that weighed in the mind of the Court was that the mark of the respondent/defendant had also been registered, in respect whereof the appellant/plaintiff had applied for rectification. However, to us it is clear that the salient features which led the Court to deny the grant of interim injunction to the appellant/plaintiff were:-

- a) The admission that 'MEROPENEM' was the active salt/drug in the medicines manufactured by both the parties which was *publici juris*;
- b) That nobody could claim exclusive right to use any word, abbreviation, or acronym which has become *publici juris* and which is used descriptively;
- c) 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. The name of an organ, ailment or ingredient being *publici juris* or generic if the use of the name is descriptive, the generic name cannot be claimed by anyone for exclusive use as a trade mark;
- d) 'MERO' which was common to both the competing marks was taken from 'MEROPENEM' in respect whereof neither party could claim exclusive user for 'MEROPENEM' based drug. Both the parties had used

three letter suffixes i.e. `NEM' had been used by the appellant/plaintiff and `MER' had been used by the respondent/defendant, which were distinct and not deceptive;

- e) Even if the competing marks were to be taken as a whole, the suffixes 'NEM' and 'MER' distinguish and differentiate the two products. When they are taken as a whole, the aforesaid two trademarks could not be said to be either phonetically or visually, or in any manner deceptively similar to each other;
- f) The possibility of deception or confusion is reduced to practically `Nil' in view of the fact that the medicine would be sold by medical prescription and by licenced dealers well versed in the field and having knowledge of medicines. When two rival marks contain a common feature, which is not only descriptive but also publici juris, the consumer will tend to ignore the common feature and will pay more attention to the uncommon feature (for example in the case of Liv-52 V. Liv-T). If the uncommon features do not have phonetic similarity, the offending mark cannot be objected to. The drugs in question are Schedule H drugs available only on Doctor's prescription and are not *over the counter* medicines;

- g) There was a vast difference in the prices of the two products. This fact by itself would ensure that there is no possibility of any deception/confusion, particularly, in view of the fact that the customer who comes with the intention of purchasing the product of the appellant/plaintiff would never settle for the product of the respondent/defendant which is priced much lower.

33. The fact situation in the two cases in hand are starkly similar to the fact situation in **Astrazeneca** (supra). If one were to replace 'MEROPENEM' with 'TEMOZOLOMIDE', 'MERO' with 'TEMO', 'MERONEM' with 'TEMODAL'/'TEMODAR', 'MEROMER' with 'TEMOKEM'/'TEMOGET', 'NEM' with 'DAL'/'DAR' and 'MER' with 'KEM'/'GET', and proceed on the basis that 'TEMO' is *publici juris* for TEMOZOLOMIDE, each of the aforesaid factors (a) to (g) would hold true, in principle, in the present cases as well.

34. Mr. Datta submits that the following are the distinguishing features of the present appeals from the decision in **Astrazeneca** (supra):

- i. Plaintiff conceded in **Astrazeneca** (Supra) that they were not claiming monopoly over just "mero". But the appellants herein are asserting their exclusive right to use "TEM"/"TEMO".
- ii. Plaintiff did not specifically dispute that Mero was generic for Moroprenem-based drugs but

argued that even if so, Meronem be compared to Meromer, both as a whole. However, the appellants dispute that TEM/TEMO is *publici juris* for TEMOZOLOMIDE.

- iii. Internationally a third party (other than plaintiff) had first adopted `Mero`. But in the present cases, it is the appellants alone who have adopted TEM/TEMO for their TEMOZOLOMIDE based drugs.
- iv. No pleading of transborder reputation was made in **Astrazeneca** (supra). Not a single piece of evidence filed in this regard. But the appellants have not only pleaded, but also demonstrated their transborder reputation.
- v. In **Astrazeneca**(supra), plaintiffs admitted that there were many other Meroprenem-based drugs incorporating `Mero` as part of the mark but no action was taken against them. However, the appellants do not admit the use of TEM/TEMO for TEMOZOLOMIDE based drugs and have zealously protected their trademarks.
- vi. Plaintiffs disentitled themselves from discretionary relief by filing rectification after filing suit without taking statutory S. 124 permission. However, that is not the case in hand.
- vii. Court found that `Mero` was commonly used; that `Mero` became *publici juris* for Meroprenem-based drugs. No such conclusion can be drawn in respect of TEM/TEMO for TEMOZOLOMIDE.
- viii. Plaintiffs did not dispute that drugs are the same except only for shelf life owing to different buffering agent. No plea of superior formulation and better therapeutic effect was made in **Astrazeneca** (supra). However, the appellants' case is that their drug has a narrow therapeutic index and works differently than the products of the respondents.
- ix. In **Astrazeneca** (supra), there was no recordal of assignment in favour of the appellants/plaintiffs. So none of the Plaintiffs were the recorded proprietors of the registration of `Meronem`. There is no dispute

in the present cases with regard to the rights of the appellants to their trademarks.

- x. In **Astrazeneca** (supra), plaintiffs disentitled themselves from discretionary relief by concealing facts/details of assignment of registration. There is no such allegation against the appellants.
- xi. In **Astrazeneca** (supra), plaintiffs did not dispute that different formulations of the same molecule can be different in therapeutic value and thus legitimately different in price. Thus **Cadila** judgment was applicable. That is not the position in the present cases.

35. The differences enumerated at sl. Nos.(i), (ii) and (vii) pertain to the appellants' submission that 'TEM'/'TEMO' are not *publici juris*. We will deal with this submission of the appellants. However, the so called differences at sl. Nos.(iii), (iv), (v), (vi), (viii), (ix), (x) and (xi) above, in our view, are not material for the present purpose. These so called differences, in fact, had no bearing on the decision in **Astrazeneca** (supra), even if it is assumed that they existed, as they did not form the basis of the decision in **Astrazeneca** (supra). Since in **Astrazeneca** (supra) it was not asserted by the appellants/plaintiffs that 'MERO' is not *publici juris*, whereas in the present cases it is asserted by the appellants that TEM/TEMO is not *publici juris*, and the decision in **Astrazeneca** was primarily founded upon the premise that 'MERO' is *publici juris* being an abbreviation of 'MEROPENEM' (which admittedly was generic), in our view that would be the only aspect which would require our consideration to conclude whether or not the decision in **Astrazeneca** (supra) would apply to the present case. If we

conclude that 'TEM'/'TEMO' is *publici juris* for TEMOZOLOMIDE, even the so called differences at sl. Nos.(i), (ii) and (vii) above would not survive and the decision in **Astrazeneca** (supra) would become applicable squarely to the present cases.

36. We may note that the Division Bench decision in **Astrazeneca** (supra) has also been followed in a recent decision of this Court in the case of **Rhizome Distilleries P. Ltd. and Ors. V. Pernod Ricard S.A. France and Ors**, MANU/DE/2742/2009 in FAO(OS) 484/2008 decided on 23.10.2008 by the Division Bench comprising of Vikramajit Sen and V.K.Jain, JJ. In this decision, the Division Bench observed as follows:-

"23.In **Astrazeneca UK Limited v. Orchid Chemicals and Pharmaceuticals Ltd.** 2007(34) PTC 469 another Division Bench was called upon to decide the dispute in the use of the trademarks MEROMER and MERONEM, in respect of which the learned Single Judge had vacated the ad interim injunction granted earlier. The Division Bench observed that MERO was generic in character and concluded that the suffix in both the rival trademarks were sufficient to draw a distinction between the two. The Bench drew support from the LIV-52 and LIV-T litigation to uphold the refusal of an interim injunction. We can do no better than reproduce a passage from **SBL Limited v. Himalaya Drug Company** 1997 (17) PTC 540 in which Justice R.C. Lahoti, as his Lordship Chief Justice of India then was, spoke for the Bench in these words - "Nobody can claim exclusive right to use any generic word, abbreviation, or acronym which has become *publici jurisdiction*. 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 public jurisdiction or generic cannot be owned by anyone for use as a trademark". The jural message, therefore, is clear and unequivocal. If a party chooses to use a generic, descriptive, laudatory or common word, it must realize that it will not be accorded exclusivity in the use of such words. At the most, it may bring a challenge in the nature of passing off and in such an event the Court would look at the rival labels/packagings/trade dresses in order to determine whether a customer possessing a modicum memory and ordinary intelligence may be so confused as to purchase one product believing it to be the other."

37. We are, therefore, of the view that to get out of the said decision in **Astrazeneca** (supra), it is essential for the appellant to establish that TEM/TEMO is not *publici juris* for TEMOZOLOMIDE.

38. There is one other submission urged by Mr. Datta, which we would need to address even if we hold against the appellants that, prima facie, 'TEM'/'TEMO' are *publici juris*, and the decision in **Astrazeneca** (supra) applies to and binds the appellants' cases. He has submitted that even if 'TEM'/'TEMO' are considered *publici juris* for TEMOZOLOMIDE, 'TEM'/'TEMO' have acquired a secondary meaning for 'TEMODAL'/'TEMODAR' on account of the registration and use of the said marks in over 100 countries, and on account of the uninterrupted, longstanding use by the appellants.

39. Mr. Datta submits that a word fragment of the word which denotes the ingredient/pharmaceutical substance, may or may not be generic or *publici juris* for that pharmaceutical substance. He submits

that even if the word fragment is *publici juris*, such word fragment may acquire distinctiveness for that pharmaceutical substance in the context of certain formulations containing that pharmaceutical substance for certain indications i.e. for the particular goods, by acquiring a secondary meaning from registrations and use, ceasing thereby to be generic/*publici juris* for that pharmaceutical substance in that limited context. He , therefore, argues that even if it is assumed for the sake of argument that ‘TEMODAL’ and ‘TEMODAR’ were originally generic/*publici juris* for TEMOZOLOMIDE, TEM/TEMO as incorporated in ‘TEMODAL’ and ‘TEMODAR’ have since acquired distinctiveness by acquiring secondary meaning through, registrations and use of ‘TEMODAL’ and ‘TEMODAR’ in over 100 countries, and thereby TEM/TEMO have ceased to be generic/ *publici juris* for TEMOZOLOMIDE in the limited context of TEMOZOLOMIDE based brain cancer drugs, and ‘TEM/‘TEMO’ have acquired secondary meaning i.e. as abbreviations for ‘TEMODAL’ and ‘TEMODAR’. In support of this submission, Mr. Datta cites example of “Naukri.com”, ‘Superflame’ and ‘Ayur’ and placed reliance on **Glaxo Group Ltd. & Ors. v. Vipin Gupta & Ors.** 2006 (33) PTC 145 (Del). He also places reliance upon **Win-medicare Limited Vs. Somacare Laboratories** 1997 (17) PTC 34 (Del), **Orchid Chemicals and Pharmaceuticals Ltd. v. United Bio-tech P. Ltd.** 2008 (38) PTC 691 (IPAB), **Wyeth Holdings Corporation v. Burnet Pharmaceuticals P. Ltd.** 2008 (36) PTC 478 (Bom), **USV Ltd. v. Cadila Pharmaceuticals Ltd.** 2008 (37) PTC 637 (IPAB), **USV Ltd. v. IPCA Lab. Ltd.** 2003 (26) PTC 21 (Mad), **Corn**

Products Refining Co. v. Shangrila Food Products Ltd. AIR 1960 SC 142, **Anglo French Drug Co. (Eastern) Ltd. (Bombay) v. Belco Pharmaceuticals (Haryana)** Sup. (2) PTC 452 (P&H) (DB), **Water Bush Well Ltd. v. Anil Arora & Others** PTC Supp. (1) 849 (Del), **Beechem Group PLC v. SRK Pharmaceuticals** 2004 (28) PTC 391 (IPAB), **State of Maharashtra v. Jethmal Himatmal Jain & Another** 1993 (13) PTC 304 (Bom), **Biochem Pharmaceutical Industries v Astron Pharmaceuticals & Assistant Registrar Of Trade Marks, Trade Marks Registry** 2003 (26) PTC 200 (DEL), **Obsurg Biotech Ltd. v. East West Pharma** 2008 (36) PTC 542 (IPAB), **Lyka Labs Ltd. v. Tamilnadu Dadha Pharmaceuticals Ltd. & Anr.** 2006 (33) PTC 512 (IPAB), **Baroda Pharma Pvt. Ltd. v. Zeneca Limited UK** 2007 (34) PTC 151 (IPAB), **Torrent Pharmaceuticals Limited v. The Wellcome Foundation Limited** 2002 (24) PTC 580 (GUJ), **Ranbaxy Laboratories Limited v. Vets Pharma (P) Limited & Ors.** 2005 (31) PTC 116 (IPAB), **Orchid Chemicals and Pharmaceuticals Ltd. Vs. United Biotech Pvt. Ltd. and The Registrar of Trade Marks** 2008 (38) PTC 691, **Wyeth Holdings Corporation and Anr. Vs. Burnet Pharmaceuticals (Pvt.) Ltd.** 2008 (36) PTC 478 (Bom), **USV Limited Vs. Cadila Pharmaceuticals Limited** 2008 (37) PTC 637, **Allergen Inc. vs. Sun Pharmaceuticals Industries Ltd.** 2006 (32) PTC 495 (CAL), **Lyka Labs Ltd. vs. Tamilnadu Dadha Pharmaceuticals Ltd. & Anr.,** 2006 (33) PTC 512 (IPAB). **Remidex Pharma Private Ltd. v. Savita Pharmaceuticals P. Ltd. & Anr.** 2006 (33) PTC 157, **Pfizer Ireland**

Pharmaceuticals v. Intas Pharmaceuticals & Anr. 2004 (28) PTC 456, **Allergen Inc. v. Chetana Pharmaceuticals** 2007 (34) PTC 267 (CAL), **Corn Products Refining Co. v. Shangrila Food Products Ltd.** AIR 1960 SC 142, **Ciba Geigy Limited & Hindustan Ciba – Geigy Ltd. v. Croslands Research Laboratories Ltd.** 1995 IPLR 375, **Heinz Italia & Anr. v. Dabur India Ltd.** 2007 VI A.D. (S.C.) 677, **Balsara Hygiene Products Ltd. v. Arm Chaudhury & Anr.** 2005 (30) PTC 272 (CAL), **Syncom Formulations (India) Ltd. v. SAS Pharmaceuticals** 2004 (28) PTC 632 (DEL).

40. Mr. Datta submits that even if the adoption of the respondents marks is assumed to be honest, it can be injuncted if the marks the appellants have acquired distinctiveness. He cites the example of “Dr. Reddy”, which was protected in **Dr. Reddy’s Lab. Ltd. v. Reddy Pharmaceuticals Ltd.** 2004 (29) PTC 435. He submits that a word-fragment that is generic/ *publici juris* for a word which is descriptive for certain goods can and does sometimes acquire distinctiveness as a source-cue for those goods. He refers to **Plastindia foundation v. Ajeet Singh** 2002 (25) 71 (Del).

41. The appellants have also contended that TEMODAL and TEMODAR are valid trademarks and their registrations do not in any way, contravene Section 9 of the Act. It is contended that these registrations are in accordance with the WHO recommendation that the pharmaceutical trademarks “should not be derived from” the INN stems of the constituting chemical salts. It is argued that the marks in

question, TEMODAL and TEMODAR cannot be said to be derived from the chemical TEMOZOLOMIDE because: -

- a. They are not trivial modification of the word TEMOZOLOMIDE;
- b. They are not obtained by the elision of a single syllable from the word TEMOZOLOMIDE;
- c. They are not substantially identical to the word TEMOZOLOMIDE;
- d. They are not actually descriptive and not merely suggestive of the word TEMOZOLOMIDE;
- e. They are not the legal equivalent of the word TEMOZOLOMIDE;
- f. They are not so utterly descriptive so as to be disqualified.

42. It is further submitted that the respondents have never filed any rectification or opposition before the Registrar of Trademarks questioning the registration of the appellants on the ground of they being “derived from” TEMOZOLOMIDE.

43. On the other hand, the respondents submit that they have adopted the trademark TEMOKEM/TEMOGET bonafide and have merely followed the practice of the pharmaceutical industry of deriving the name of the medicine from its chemical molecule viz. TEMOZOLOMIDE, which is obviously generic. It is, therefore, contended that the abbreviation or word-fragment, that is, TEM/TEMO of that generic term would also be generic.

44. The next line of argument of the respondent is that, as provided for under Section 17 of the Act, registration of a trademark

confers on the proprietor an exclusive right **to the use of the trademark taken as a whole** and not for parts or fragments of the mark. So the appellants cannot claim exclusivity in respect of word-fragments which are *publici juris* and descriptive of the generic substance.

45. The respondents also contend that there is no likelihood of confusion between the drugs in question because of the vast price difference in the drugs of the appellants on the one hand, and of the two respondents on the other hand. They also contend that the drugs in question are Schedule-`H' drugs and that the drugs of the respondents come with a medical warning that they are to be sold only against demand from cancer hospitals, institutions and against the prescription of a Cancer Specialist.

46. The respondents have sought to place reliance on various decisions and upon various published articles and text books on the relevant subject, which shall be referred to a little later.

47. We first proceed to deal with the submissions of Mr. Datta, which relate to his argument that TEM/TEMO is not *publici juris* for TEMOZOLOMIDE.

48. The crux of the appellants contention is that the word-fragment TEM/TEMO of the word-name TEMOZOLOMIDE is not generic/*publici juris*, as it is not so recognized either by:

- i) The WHO (in its notified list of INN-Stems or in its List of Radicals-Groups);
- ii) A standard dictionary or medical dictionary;
- iii) The market proliferation of brands of formulations of the pharmaceutical substance incorporating the word-fragment TEM/TEMO, which market proliferation is a) uncontested; b) longstanding (c) extensive and (d) significant.

49. The expression "*publici juris*" is defined in **Black's Law Dictionary** (Eighth Edition) as-

"of public right; of importance to or available to the public <a city holds title to its streets as property *publici juris*> <words that are in general or common use and that are merely descriptive and *publici juris* and cannot be appropriated as a trademark>."

50. The concept of 'public', for the purpose of determining whether a word is *publici juris* for an article or thing would depend on what that article or thing is. For example, if the article or thing is one typically belonging to the field of aeronautics, the knowledge of the general public i.e. the common man on the street, of the meaning of the word would not be relevant. The meaning of the word would have to be gathered from the knowledge of the 'public' knowledgeable in the field of aeronautics, to determine whether the word is *publici juris* for the article or thing for which it is claimed to be *publici juris*. Similarly, to determine whether 'TEM'/'TEMO' is *publici juris* for TEMOZOLOMIDE, the query would have to be directed to those who would normally be expected to have knowledge of what

TEMOZOLOMIDE and 'TEM'/'TEMO' mean. If people engaged in the treatment of, and research in the field of brain cancer use the word 'TEM'/'TEMO' for TEMOZOLOMIDE, in our view, it would be fair to conclude that 'TEM'/'TEMO' are *publici juris* for TEMOZOLOMIDE.

51. The submission of the appellants that 'TEM'/'TEMO' is not generic/ *publici juris* for TEMOZOLOMIDE because it is not notified as a INN STEM or is not listed as one of the radical groups by the WHO; that it is not so mentioned in a standard dictionary or medical dictionary is fallacious, as it proceeds on the assumption that for a medicine related word/term to become *publici juris*, it must either to listed as an INN Stem or a radical group by the WHO or by a standard dictionary or medical dictionary. There is nothing to suggest that these sources are exhaustive of medical terms which are *publici juris*. Whether or not a medical term is *publici juris* is an issue of fact, which would have to be established at the trial of the suits. At this stage only a *prima facie* view has to be formed, which is not the final view. Therefore, if there is some material available to show that TEM/TEMO has been used to describe TEMOZOLOMIDE or any other chemical compound, TEM/TEMO would, *prima facie*, be *publici juris*.

52. The respondents have placed on record a medical study published in the journal of nuero-oncology by the Duke University, wherein TEMO has been used for TEMOZOLOMIDE. There is another article on the subject of "Synthesis and antibacterial activity of dual-action agents of a β -lactam antibiotic with cytotoxic agent

mitozolomide or TEMOZOLOMIDE, wherein TEMOZOLOMIDE has been denoted by TEMO.

53. It is also interesting to note from the above mentioned latter article that there is another chemical compound by the name of MITOZOLOMIDE. The extension 'ZOLOMIDE' itself appears to be *publici juris* for a group of chemical compounds having some common features/properties. Therefore, it appears to be quite natural to refer to TEMOZOLOMIDE as 'TEMO' just as MITOZOLOMIDE is described as 'MITO'.

54. We may also take note of the fact that on the website www.allacronyms.com on keying the abbreviation 'TEM', the same leads to, inter alia, TEMOZOLOMIDE. On the website www.medilexicon.com a search for medical abbreviation 'TEM', inter alia, results in 'TEMOZEPAM' and TEMOZOLOMIDE. We are not suggesting that these instances establish that 'TEM'/'TEMO' are *publici juris* for TEMOZOLOMIDE. But these are instances, which establish that the materials and documents produced by the appellants, to show that 'TEM'/'TEMO' refer to TEMODAL and/or TEMODAR are not exhaustive to conclude, at this interlocutory stage, that 'TEM'/'TEMO' is not *publici juris* for TEMOZOLOMIDE, and that they necessarily refer exclusively to TEMODAL and TEMODAR.

55. **McCarthy in Trademarks and Unfair Competition**, inter alia, states:

“Clearly, one seller cannot appropriate a previously used generic name of a thing and claim exclusive rights in it as a “trademark” for that thing. Similarly, if one seller develops trademark rights in a term which a majority of the relevant public then appropriates as the name of a product, the mark is a victim of “genericide” and trademark rights may cease.”

“An abbreviation of a generic name which still conveys to the buyer the original generic connotation of the abbreviated name is still generic.”

56. The Madras High Court in ***Indo-Pharma Pharmaceuticals Works Ltd., Mumbai v. Citadel Fine Pharmaceuticals Ltd., Madras*** 1998 (18) PTC (DB) (Mad) while dealing with two marks ‘Enerjex’ and ‘Enerjase’ held that the abbreviation of a generic word will also be generic. Reliance was placed on the aforesaid extract from **McCarthy in Trademarks and Unfair Competition**. Since the components ‘Jase’ and ‘Jex’ were completely dissimilar, injunction was refused by the Court to the plaintiff. The Madras High Court held as follows:

“The two rival marks ‘ENERJEX’ and ‘ENERJASE’ contain the common feature ‘ENERJ’ which is not only descriptive but also publici juris. Therefore a customer will tend to ignore the common feature and will pay more attention to uncommon features i.e ‘JEX’ and ‘JASE’. These two cannot be said to have such phonetic similarity so as to make it objectionable.”

“So the word ‘ENERG/J’ used as a prefix in both the trade names is the abbreviation of the generic term of the English word ‘energy’. As such, it is descriptive in nature and common in usage. Nobody can claim an exclusive right to

the use of the word `ENERG/J' as the constituent of any trademark.”

57. In ***The Cellular Clothing Company*** (supra), the Court held the following:-

“If a man invents a new article and protects it by a patent then during the term of the patent, he has of course a legal monopoly, but when the Patent expires all the world may make the article, and for that purpose use the name which the Patentee has attached to it during the time when he had the legal monopoly of the manufacture. **But my Lords, the same thing in principle must apply where a man has not taken out a Patent, as in the present case, but has a virtual monopoly because other manufacturers, although they are entitled to do so, have not in fact commenced to make the article.**”(emphasis supplied).

58. The argument of the appellants that to establish that the term TEM/TEMO is *publici juris*, there should be market proliferation of various brands of ‘TEMOZOLOMIDE’ incorporating the word fragment TEM/TEMO, which market proliferation is un-contested, longstanding, extensive and significant, cannot be accepted in our view, particularly in the light of the fact that the products of the appellants’ enjoyed a patent and, consequently, the appellants enjoyed a statutory monopoly. It is only on account of the fact that the product patent in this country was not protected till the amendment in the law in 2005, that the respondents’ have been able to manufacture the said drug.

Obviously, during the tenure of the said statutory monopoly, none could validly manufacture and sell the said drug by whatever name.

59. Therefore, merely because the molecule TEMOZOLOMIDE may have been patented and commercially pioneered by the appellants, they do not become entitled, on the statutorily protected monopoly disappearing, to prevent others from calling, what the molecule is, by its generic name, and such other names which are “publicly” known to describe and denote it.

60. In ***McCain International Limited*** (supra), the Court held:

“Here the plaintiffs have brought the article oven chips before the world, they have given it a name descriptive of that article, they have had a monopoly in it before other persons have entered into competition with them and they cannot now claim a monopoly of that name. All they can claim is that other person who make the same article shall distinguish their products by the appropriate means, which the defendants have adopted in this case, of making it quite clear that the products they produce come from County Fair and Birds Eye respectively.”

61. TEMO has been used for TEMOZOLOMIDE by several parties apart from the respondents, namely, Cipla Limited, who use the brand name ‘TEMOSIDE’, Netco Pharma Limited, who use the brand name ‘TEMONET’ and Dabur Pharma Limited, who use the brand name ‘TEMOZEM’. There are a number of other similar marks with the prefix TEM/TEMO for drugs, which are present in the market. The appellants

have themselves pointed out that TEM/TEMO is contained as a part of the trade mark of a variety of different pharmacological groups, such as (i) TEMSIROLIMUS (an anti kidney-cancer agent); (ii) TEMOPORFIN (a photosensitizing anti cancer agent like TEMOZOLOMIDE); (iii) TEMOCILLIN (antibiotic); (iv) TEMOCAPRIL (anti hypertensive). We may also notice that from the documents filed by the appellants it appears that there are various other drugs having the prefix TEM/TEMO such as TEMARIL- trademark for preparations of trimeprazine tartrate; TEMAZEPAM- a benzodiazepine used as a sedative and hypnotic in the treatment of insomnia, administered orally; TEMEFOS- USAN for temephos; TEMEPHOS- an organophosphorous insecticide used as a larvicide for control of mosquitoes and blackflies and as a veterinary ectoparasiticide; TEMODOX- a veterinary growth stimulant; TEMOVATE- trademark for preparations of clobetasol propionate.

62. It has been repeatedly recognized that in the trade of drugs it is a common practice to name a drug on the basis of the name of its active chemical compound or salt, or the disease it seeks to remedy, or the particular organ it is intended to treat. The name of such an ingredient or compound, ailment or organ being in the public domain and of generic nature, which has been used descriptively, cannot be claimed by anyone for use exclusively as only his/her trademark.

63. From the materials produced by the respondent, it is evident that TEM/TEMO have been employed in place of TEMOZOLOMIDE or as abbreviations for certain other medicines. No doubt TEM/TEMO have

also been used in place of 'TEMODAL' and 'TEMODAR'. However, there is nothing to suggest that TEM/TEMO mean, and only mean, TEMODAL/TEMODAR and nothing else. Even when TEM/TEMO is used in relation to 'TEMODAL' and 'TEMODAR', the reference is actually to the chemical compound TEMOZOLOMIDE, which is the active ingredient in 'TEMODAL' and 'TEMODAR'.

64. Consequently, in our view, *prima facie* the word fragment TEM/TEMO is *publici juris* and also generic for and descriptive of the chemical compound, TEMOZOLOMIDE, and, therefore, the appellants cannot claim the exclusive right to use thereof. The decision in **Astrazeneca** (*supra*) has rightly been held to apply on all fours to the cases in hand.

65. As the appellants have chosen to brand their product with a generic and descriptive prefix 'TEMO', any other person entering the market would be entitled to use the said term to identify the product in question. If the appellants were desirous of avoiding such a situation they should have branded their drug with a unique name instead of a descriptive name. [see **Rhizome Distilleries P. Ltd.** (*supra*)]

66. We now proceed to consider the second plea of Mr. Datta, that assuming that 'TEM'/'TEMO' are *publici juris* for TEMOZOLOMIDE, 'TEM'/'TEMO' have acquired a secondary meaning for TEMODAL and TEMODAR for the reasons stated by him and that, therefore, the appellants alone are entitled to the exclusive use of the same. Since

various cases have been cited in this regard, we proceed to deal with each one of them.

67. In **Glaxo Group** (supra), the court was dealing with the plaintiff's marks 'BETNOVATE' and 'CROCIN' on the one hand and 'BETAVAT' and 'CORINAL' on the other hand. The court held on a comparison of the various features in the get up of the competing products, that the products of the defendants could be passed off as that of the plaintiff. The court held that the mark 'CORINAL' does not appear to be deceptively or confusingly similar to the trademark 'CROCIN', but confusion is sought to be created by adopting similar strip/packaging as that of the plaintiff. The defendant was found to be using the logo 'SGS' in the same manner as the plaintiff's logo 'GSK' within a heart shaped device. The court found that even though the competing marks were not identical, the marks used by the defendants so nearly resembled the plaintiff's trademarks as was likely to deceive or cause confusion in relation to the similar goods, on account of the adoption of the similar getup by the defendant in respect of its products. The above was the basis for the grant of injunction by the Court in favour of the plaintiff.

68. This decision does not advance the proposition canvassed by the appellants that even if TEM/TEMO were originally generic/*publici juris* for TEMOZOLOMIDE, TEM/TEMO as incorporated in 'TEMODAL' and 'TEMODAR' have since acquired distinctiveness and that TEM/TEMO have acquired a secondary meaning through registration and use of

'TEMODAL' and 'TEOMDAR' in over hundred countries and thereby ceased to be generic/*publici juris* for TEMOZOLOMIDE in the context of TEMOZOLOMIDE based brain cancer drugs. The position in the following cases cited by the appellants is the same, which are discussed below in paragraphs 69 to 88. The grant of injunction in all these cases, it would be seen, was, inter alia, either on account of similar get up or on account of minimal difference in the trade name leading to structural and/or phonetic and/or visual similarity in the competing marks, and not on account of the Court allowing appropriation of a term which is *publici juris* by the plaintiff on the ground that the *publici juris* term has acquired a secondary meaning to denote the product of the plaintiff alone.

69. In **Win-medicare Limited** (supra) the plaintiff had brought the action for passing off. The competing trademarks were 'DICLOMOL' of the plaintiff and 'DICMOL' of the defendant. It was not an action founded upon Section 29 of the Act for infringement of registered trademark. Neither of the two trademarks in question in that case were registered. The court concluded that the two marks were structurally and phonetically similar which gave the impression that the defendant had copied the mark of the plaintiff. It was on this basis that the court had granted the injunction. The difference in 'DICLOMOL' and 'DICMOL' was only that the two letters 'LO' had been removed from the plaintiff's mark by the defendant while coining its

own mark 'DICMOL'. On account of the structural and phonetic similarity the court had granted the injunction.

70. Similarly, in **Wyeth Holdings** (supra) while considering whether the mark "FOLV" of the defendant was deceptively similar to the mark 'FOLVITE' of the plaintiff, the court held that the two competing marks have to be considered as a whole. The structure of the mark visually and phonetically must be borne in mind. The image that the court must have is that of the quintessential common man. It was held: *"when the Judge looks at phonetics, the sound which accompanies the pronunciation of the mark is the sound of the mark to an ordinary purchaser bereft of the niceties of language."* Neither the term 'FOL' derived from 'FOLIC ACID'; nor the term 'VITE' derived from 'VITAMIN' were treated as being the proprietary of the plaintiff and that was not the basis of the said decision.

71. In **USV Ltd. v. Cadila Pharmaceuticals Ltd** (supra) the Intellectual Property Board was considering the two competing marks 'PIOZULIN' and 'PIOZ'. Both were held to be structurally one and the same and they even looked alike. It was for this reason that the Appellate Board declared the registration obtained by the respondent to be invalid.

72. In **USV Ltd. v. IPCA Lab. Ltd.** (supra) the Madras High Court was considering the two competing marks namely, 'PIOZ' of the plaintiff and 'PIOZED' of the defendant. Since they were found to be

phonetically similar and were drugs intended to be used for the same disease, the court enjoined the defendant from adopting the mark 'PIOZED'. The active ingredient in the two drugs in question was 'PIOGLITAZONE HYDROCHLORIDE'. It was held that the prescription given by the doctors for purchase of medicines 'PIOZ' or 'PIOZED' will be in scribbling and the spelling normally written by doctors may not be read by common man and even by the English knowing literates. Even the chemists in the drug stores may not be able to make out a distinction between the 'PIOZ' and 'PIOZED' scribbled by the doctors. It was on this account that the court granted injunction in favour of the plaintiff. The court even in this case did not hold that the plaintiff was entitled to the exclusive use of the abbreviated version of the generic active compound in the medicine namely "PIOGLITAZONE HYDROCHLORIDE".

73. In **Anglo French Co.** (supra) the Punjab and Haryana High Court was concerned with the plaintiffs registered mark 'BEPLEX' and the defendant's mark 'BELPLEX' being used for vitamin 'B COMPLEX' tablets. Even in this case the court concluded that there was deceptive similarity both phonetic and visual in the goods manufactured by the parties which is likely to cause confusion and deception in the minds of the purchasers. On this account the court granted injunction in favour of the appellant/plaintiff. This decision also, therefore, is of no avail to the appellants.

74. In **Water Bush Well** (supra) a learned Single Judge of this court was dealing with a claim for infringement of trademark 'AMCLOX' of the plaintiff, by the defendant who had adopted 'AMPCLOX'. The court granted injunction on the ground that 'AMCLOX' and 'AMPCLOX-500' were both visually and phonetically similar to deceive and to cause confusion amongst the buyers of the products. The court also took into account that the mere insertion of the letter 'P' in the defendant's mark would not make a difference while hearing the name of the mark. The court also compared the colour combination of the capsules. No doubt, the argument that the drug was a Schedule-H drug was advanced by the defendant, and the same was rejected by the court on the ground that for a minor complaint or indisposition one does not always go to the medical practitioner and the same medical preparation (even though they are Schedule H drugs) would be administered by a patient/person by directly approaching the chemist, in our view the said distinction cannot be held good in the present case as we are dealing with a drug meant for treating brain cancer which, by no means, can be described as a minor complaint or indisposition. As noticed by the learned Single Judge the medicines/drugs in question contain a warning that the same can be sold only on the prescription of not just any ordinary medical practitioner, but on the prescription of only a Cancer Hospital or Cancer Specialist. We may hasten to add that we are not commenting on the view of the learned Single Judge, as aforesaid, one way or another, as it is not necessary for us to do so

in view of the materially different factual context. This decision also, therefore does not support the appellants cases.

75. In **Biochem Pharmaceuticals Limited** (supra) the learned Single Judge of this Court was concerned with the trademarks 'BIOCILIN' and 'BICILLIN' in respect of the same drug. Once again the court concluded that there was phonetic deceptive similarity in the two marks which is likely to lead to confusion and deception. Though the relief of injunction was granted, it was not on the basis that the appellant was entitled to appropriate the generic name of the two drugs in question namely 'AMPICILLIN' and 'CLOXACILLIN'. In this case both the parties were manufacturing the drug by combining 'AMPICILLIN' and 'CLOXACILLIN'. The appellant had used the mark 'BIOCILLIN' as it was a combination of two drugs. Consequently, 'Bio', of which 'Bi' means two, was used as a prefix to coin the word 'BIOCILLIN'. The respondent had done the same and had merely dropped the letter 'O' and introduced an extra 'L' in the trademark adopted by it. This case, therefore, has no relevance.

76. **Beecham Group PLC** (supra) is a decision of Intellectual Property Board, Chennai in respect of the application made by the applicant for registration of the mark 'LYMOXYL'. The trademark 'AMOXIL' belonged to the objector. Once again the court held that the mark adopted by the applicant was phonetically, structurally and deceptively similar to that of the objector. The only difference in the applicants trade name was the employment of the letters 'LY' and 'M'.

Like the earlier decisions this decision does not advance the proposition propounded by the appellants, and is, therefore, of no relevance.

77. In **Obsurge Biotech Limited** (supra) the common trademark was 'SERADIC'. Since the two marks were identical in respect of medicinal preparations, the rectification application was allowed. This case has absolutely no relevance for our purpose.

78. **Lyka Labs** (supra) also is a decision of IPAB, Chennai dealing with the marks 'TAMIACIN' and 'TAMNIFO' on the one hand and the mark 'TAMIN' on the other hand. The Appellate Board was examining whether 'TAMIN' is deceptively similar to the registered marks 'TAMIACIN' and 'TAMNIFO'. The Board held that the mark 'TAMIN' was phonetically, visually or structurally similar to the respondents mark 'TAMIACIN'. Once again this decision did not proceed on the basis that a party could appropriate to itself the generic name or the abbreviation of the chemical active compound in a drug.

79. **Baroda Pharma Private Limited** (supra) is also a decision of the IPAB, Chennai dealing with the mark 'TENOREX' and 'TENORMIN'. 'TENOREX' was not permitted to be registered on the opposition of the proprietor of the mark 'TENORMIN' on the ground of deceptive and phonetic similarity which was likely to cause confusion. We find that though the argument of *publici juris* in respect of the

prefix 'TENOR' did arise, the same was not gone into by the Appellate Board. Consequently, this decision does not help the appellants.

80. ***Torrent Pharmaceuticals Limited*** (supra) is a decision of the Gujarat High Court dealing with the mark 'TROVIREX', which was objected to by the proprietor of the mark 'ZOVIREX'. The registration of 'TROVIREX' was denied on the ground that 'TROVIREX' had the highest degree of resemblance, visually and phonetically and the same was likely to deceive or cause confusion in the minds of the purchasers of the drug. The Gujarat High Court does not appear to have gone into the issue of *publici juris* in respect of the concerned active chemical compound, disease, organ on the basis of which the drug 'ZOVIREX' might have been named. This judgment is, therefore, of no assistance to the appellants.

81. ***Ranbaxy Laboratories*** (supra) is also a case decided by the IPAB, Chennai. The trademark under examination was 'LEVASOL', in respect whereof opposition was filed by the proprietor of the trademark 'LEMASOL'. 'LEVASOL' was a veterinary medicine, whereas 'LEMASOL' was a pharmaceutical preparation for human use. The IPAB held that there was phonetic and visual identity, inasmuch as, for the letter 'M' in the objector's drug, the letter 'V' had been substituted by the applicant. The drug of both the parties fell within the same class 5 and the distribution channel of the goods being the same, there was likelihood of confusion. This case also does not throw any light on the

generic chemically active compound on which either of the two drugs were based. It has absolutely no relevance to the cases in hand.

82. ***Allergen Inc. v. Sun Pharmaceuticals Industries Ltd.*** (supra) is the decision of the Calcutta High Court. The suit had been filed alleging passing off of the ophthalmic solution under the trademark name 'OCUFLOX'. The defendant was also marketing its product, which could be used both for treatment of eyes as well as ears with the same tradename 'OCUFLOX'. It was for this reason, the Court had granted the injunction. This case, therefore, has absolutely no bearing on the present appeals.

83. ***Allergen Inc. v. Chetana Pharmaceuticals*** (supra) is a case decided by the Calcutta High Court in respect of the trademark 'OXYLINE'. The plaintiff was the proprietor of the said mark in relation to a drug for ophthalmic use. The defendant used the identical mark in relation to its drug i.e. nasal drops. Since the marks were identical, injunction followed. This case too has no bearing on the issue in hand.

84. ***Remidex Pharma Private Ltd.*** (supra) is a decision of a learned Single Judge of this Court. The competing marks were 'ZEVIT' and 'EVIT'. The defendant had adopted 'EVIT' in respect of its vitamin tablets. The defence of the defendant was that the clipping 'VIT' had been taken from word vitamin and was, therefore, generic. Since the product of the defendant was vitamin E tablets, the defendant claimed bonafide adoption of the mark 'EVIT'. The learned Single Judge while

confirming the injunction in favour of the plaintiff observed that on comparison of 'ZEVIT' with 'EVIT', the prefixes 'ZE' and 'E' of 'ZEVIT' and 'EVIT', respectively, are phonetically similar. It was, on this account that the Court held that the mark 'EVIT' is deceptively similar to the registered mark 'ZEVIT' of the plaintiff. It is not that the Court proceeded on the basis that the plaintiff had the right to appropriate to itself the generic and phonetic term 'VIT' derived from vitamin. Consequently, this case too does not advance the case of the appellants.

85. In ***Pfizer Ireland Pharmaceuticals*** (supra) the Court was dealing with the passing off action. The court found that there was phonetic and visual similarity between 'LIPITOR' and 'LIPICOR', inasmuch as, only one letter i.e. 'T' had been replaced by 'C'. It was, on this account, that the Court had granted the requisite injunction in favour of the plaintiff.

86. In ***Heinz Italia & Anr.*** (supra) the Supreme Court was dealing with the marks 'GLUCON-D' of the appellant/plaintiff and 'GLUCOSE-D' of the respondent/defendant. The injunction granted in this case was, again, not founded upon the recognition of any exclusive right of the plaintiff to appropriate the word 'GLUCOSE' which is generic. The injunction was granted on the basis that 'GLUCON-D' and 'GLUCOSE-D' appear to have phonetic similarity. The color scheme in the packaging of the two competing products was also found to be more or less identical. The court found that the packaging

and getup of the two competing products was almost identical. It was on this basis that the injunction was granted.

87. The decision in **Balsara Hygiene Products Ltd.** (supra) is also of no use to the appellants. The court while recognizing the legal principle that a party cannot have any monopoly right to use a generic word, concluded in the facts of that case that the plaintiff had not used a generic word and on that basis the defence of the defendant was rejected in respect of the defendant's marks 'ODOJA' in comparison with the plaintiff's registered trademarks 'ODONIL', 'ODOPIC' and 'ODOMOS'. The Court held that 'ODO' was an adoption and/or coinage of the plaintiff and was not a dictionary word. Consequently, the court, in fact, rejected the argument that 'ODO' was *publici juris* for 'ODOUR'. This case too has no application in the facts of the present cases.

88. **Syncom Formulations (India) Ltd.** (supra) was a case of passing off in respect of the plaintiff's trademark 'REGULIN FORTE' by the defendant who adopted the mark 'REGU-30'. This Court dismissed the first appeal preferred by the defendant against the grant of injunction by the Trial Court in favor of the plaintiff. In the facts of that case the Court found that the mark of the defendant was confusing and deceptively similar to that of the plaintiff and the product of the defendant could be passed off as that of the plaintiff. This case also has absolutely no bearing on the present appeals.

89. The decision in **Ciba Geigy Ltd.**(supra), in our view, is also of no assistance to the appellants, as this case proceeded on the foundation that the medicine vendor may not know the difference, and he may unknowingly give the product of the defendant ('VOLTA-K' in this case) in place of the product of the plaintiff i.e. 'VOLTAREN'. In the facts of the present cases, considering the nature of the drug, the warning endorsed on the drugs of the respondents, and the price difference in the drugs of the appellants on the one hand and those of the respondents on the other hand, in our view, there is no scope for any such confusion, and this decision has no bearing on the present appeals.

90. **Corn Products Refining Co.** (supra) was a case where the Supreme Court was concerned with the claim for registration made in respect of the mark 'GLUVITA' in respect of the biscuits made by the respondent. The appellant before the Supreme Court had got the mark 'GLUCOVITA' registered in respect of 'DEXTROSE', a substance used as food or as an ingredient in food; glucose and food. This is not a decision dealing with medicines/drugs. The relief granted to the appellant in the said case was primarily founded upon the similarity in the marks in question namely 'GLUVITA' and 'GLUCOVITA'. The letters 'CO' alone had been dropped by the respondent from the mark of the appellant to coin the mark 'GLUVITA'. It does not advance the submission of the appellants, as the ratio of this decision is not to the effect that the word fragment of a generic/*publici juris* word can be

appropriated by the person who may have used the word fragment as a part of a descriptive trademark.

91. The ***State of Maharashtra v. Jethmal Himatmal Jain*** (supra) is not a case dealing with infringement of trademark or even with passing off. The same is, therefore, of no relevance whatsoever.

92. The appellants have relied upon the decision ***Plastindia Foundation*** (supra) in support of their submission that a word fragment of a word that is generic/*publici juris* which is descriptive of certain goods, can and does sometimes acquire distinctiveness as a source que for those goods. In ***Plastindia Foundation*** (supra) the plaintiff had adopted the name 'Plastindia Foundation' for its trust, which was an apex body of associations of all the leading organizations and institutes concerned, directly or indirectly, with the manufacture, sale or promotion of plastics in India. The defendant adopted the same mark 'PlastIndia' for their magazine. The court granted an injunction in favour of the plaintiff and against the defendant from using the said mark on the basis that the adoption of 'PlastIndia' by the defendant may lead to the confusion that the magazine 'PlastIndia' has its source at, or that it has connection with Plastindia Foundation i.e. the plaintiff.

93. We do not see the relevance of this decision in the present context. Plastindia was a coined word derived from generic words Plastic and India. The Court did not hold that the Plaintiff alone was entitled to appropriate 'Plast' or 'India', which are *publici juris/generic*.

Pertinently, the Court permitted the defendant to use, inter alia, "PLAST WORLD" and "WORLD PLAST". It follows that others too would be entitled to use these generic and descriptive words. However, that does not mean that another person can use the identical or deceptively similar name/mark which is likely to cause confusion and deception. Because the Court found that the defendants mark was more or less identical with that of the plaintiff, and could lead to confusion and deception with regard to the source of the defendants' magazine, the Court granted the injunction in favour of the plaintiff. Pertinently, this is also not a case relating to drugs.

94. TEMOZOLOMIDE is a generic word. TEM/TEMO, as we have already seen, is *publici juris* for TEMOZOLOMIDE. TEM/TEMO is not generic for the trademarks 'TEMODAL' and 'TEMODAR' of the appellant, but for TEMOZOLOMIDE. The use of TEM/TEMO in TEMODAL/TEMODAR is descriptive of 'TEMOZOLOMIDE'. The use of the marks TEMOKEM and TEMOGET by the respondents, therefore, possibly cannot lead to the inference that TEMOKEM and TEMOGET have been sourced from the manufacturers of TEMODAL and TEMODAR i.e. from the appellants. Such a conclusion is also contra-indicated by the vast difference in price of the products of the appellants and the respondents.

95. The SUPERFLAME case (***Globe Super Parts v. Blue Super Flame Industries*** AIR 1986 DELHI 245) was a passing off action by the plaintiff who was the proprietor of the unregistered mark
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“SUPERFLAME”. The defendants were using the mark “SUPERFLAME” for the same articles, namely, gas appliances. The Court held that the mark “SUPERFLAME” was a coined word. It was held that “SUPERFLAME” was not descriptive of gas stoves. For this reason, the Court granted permanent injunction to restrain the defendants from using the word “SUPERFLAME”, as the plaintiff was the prior user of the said coined word. Such is not the claim in the present appeals.

96. ***Dr. Reddy’s Laboratories Ltd. v. Reddy Pharmaceuticals Ltd.*** 2004 (29) PTC 435 (Del) was a case of passing off. The Court came to the conclusion that the adoption of the mark “REDDY” by the defendant was fraudulent to encash upon the trade reputation and goodwill of the plaintiff built over two decades. The Court found that there was phonetic similarity between “DR. REDDY” and “REDDY” capable of creating confusion. The Court also found deceptive similarity in the names and packaging of the drugs of the defendant with those of the plaintiff. It is for this reason that the Court had granted injunction. The Court did not declare that “REDDY” could not be used by another person by that name bonafide, even if such user is not deceptively similar to that of the plaintiffs. This case, therefore, has no relevance in the present context.

97. ***Ayurherbs Pharmaceuticals Private Limited v. Three-N-Products Private Limited*** 2007 (35) PTC 261 (Del) was a case where the plaintiff, the proprietor of the mark “AYUR” initiated an action against the defendant, who had adopted a business/tradename

"Ayurherbs Pharmaceuticals Private Limited". The defendant was also in the same trade, namely, manufacture and sale of ayurvedic products, as the plaintiff, who was selling its ayurvedic products under the trademark "AYUR". The Court dismissed the defendant's first appeal against the grant of injunction by the trial Court, on the premise that the use of the name "AYUR" by the appellant is likely to cause confusion in the mind of the ordinary purchaser and, consequently, it was held that the adoption of the name "AYUR" by the appellant in its trade name amounts to passing off. In this case the Court did not hold that "AYUR" was *publici juris* for ayurveda or that the plaintiff was exclusively entitled to appropriate to itself the use of the generic term ayurveda or its abbreviation "AYUR".

98. The second 'Ayur' case reported as ***Three-N-Products Private Ltd. v. Karnataka Soaps & Detergents Ltd. & Anr.*** 2007 (34) PTC 515 (Cal) was also a passing off action. As the plaintiff was the prior user of "AYUR", the defendant was enjoined from using the said mark for soaps. This case too is of no relevance for our purpose.

99. In ***Indo Edge (India) Pvt. Ltd. & Anr. v. Shailesh Gupta & Anr.*** 2002 (24) PTC 355 (Del) the plaintiff had developed the domain name "NAUKRI.COM" used to provide job placement services and employment with the peculiarity that the plaintiff had adopted a Hindi word with English script. It was held on the basis of press reports and write ups that the domain name of the plaintiff is unique and distinct which has a distinctive character and which has assumed a reputation

in the market. The defendant, who had a similar business with the domain name “*jobsourceindia.com*”, had also adopted “*naukari.com*”. The Court held that *“If a product of a particular character or composition is marketed in a particular area or place under a descriptive name and gained a reputation thereunder, that name which distinguished it from competing products of different composition, the goodwill in the name of those entitled to make use of it there was protected against deceptive use there of the name by competitors”*. The Court referred to McCarthy on Trademarks and Unfair Competition Vol.2, 3rd Edition, wherein in para 12.5(2) it was stated that in order to obtain some form of relief on a “passing off” claim, the user of the generic terms must prove some false or confusing usage by the newcomer above and beyond mere use of generic name. The only difference between the plaintiff’s and the defendant’s domain names was the insertion of the letter ‘A’ between the letters ‘K’ and ‘R’ in the word “Naukri”. It was further held that even if “Naukri” is assumed to be a generic word, the adoption of a similar mark by the defendant, when the plaintiff’s mark had attained distinctiveness and was associated with the business of the plaintiff for a considerable time, was dishonest and in bad faith. It is for these reasons that the Court had granted the injunction in favour of the plaintiff. In our view, this decision does not advance the case of the appellants, as, in our opinion, the marks of the appellants on the one hand and those of the respondents on the other hand are not phonetic and visually similar.

100. In ***Cadila Health Care Ltd. V. Cadila Pharmaceuticals Ltd.*** (supra) the two competing trademarks were 'FALCIGO' of the plaintiff and 'FALCITAB' of the defendant. Both the drugs were meant to cure cerebral malaria commonly known as "falcipharum". The drugs were schedule 'L' drugs which means, that the drugs were not at all available for sale in retail and could be supplied only to hospitals and clinics. Consequently, there was even stricter regime for the sale of such drugs when compared to Schedule 'H' drugs. There was also substantial price difference in the two drugs. The Trial Court as well as the High Court (in First Appeal) found that the packaging and getup of the two products was not deceptively similar or confusing. The extra Assistant Judge, Vadodra declined the interim injunction sought by the plaintiff. This order was upheld in First Appeal. The Supreme Court also declined to interfere with the order. The reasons given by the Supreme Court for its decision, and the principles to be kept in mind while dealing with an action for infringement or passing off, specifically in the cases relating to medical products, were subsequently set out by the Supreme Court in the aforesaid judgment. The Court did not grant the interim injunction for the reason that it felt that there was possibility of evidence being required on merits of the case. The Court felt that expression of opinion on merits of the case by the Supreme Court at the interlocutory stage would not be advisable.

101. In the above decision, the action was brought by the plaintiff alleging passing off. It appears that the same was not an action for

infringement of trademark under Section 29 of the Act. The Supreme Court in this decision overruled its earlier decision in **S. M. Dyechem Ltd. v. Cadbury (India) Ltd.** (2000) 5 SCC 573 in so far as it has been held in **S.M. Dyechem** (supra) *“Where common marks are included in the rival trade marks, more regard is to be paid to the parts not common and the proper course is to look at the marks as whole, but at the same time not to disregard the parts which are common.”* The Supreme Court held that *“.....the decisions in the last four decades have clearly laid down that what has to be seen in the case of a passing off action is the similarity between the competing marks and to determine whether there is likelihood of deception or causing confusion.....Having come to the conclusion, in our opinion incorrectly, that the difference in essential features is relevant, this Court in Dyechem case (supra) sought to examine the difference in the two marks “PIKNIK” and “PICNIC”.....”*.

102. The Supreme Court then proceeded to refer to American Court’s decisions relating to medicinal products. In paragraphs 35 and 36 the Supreme Court laid down the factors to be considered by the Court in an action for passing off on the basis of unregistered trademark. The said paragraphs reads as follows:

“35. Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered:

a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.

b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

c) The nature of the goods in respect of which they are used as trade marks.

d) The similarity in the nature, character and performance of the goods of the rival traders.

e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

f) The mode of purchasing the goods or placing orders for the goods and

g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

36. Weightage to be given to each of the aforesaid factors depends upon facts of each case and the same weightage cannot be given to each factor in every case."

103. As we have already noticed, the present is an action for infringement under Section 29 of the Act and not an action for passing off. In any event, on consideration of the various factors set out by the Supreme Court, as aforesaid, to us it is clear that keeping in view the nature of the marks-which are word marks; the lack of resemblance between the marks-phonetic or otherwise; the fact that the word fragment 'TEMO' is *publici juris* for the generic term TEMOZOLOMIDE, which is the active ingredient in the appellants drugs and the use of

'TEMO' is, therefore, descriptive; the fact that the appellants cannot appropriate to themselves the exclusive use of a generic term which is *publici juris* and descriptive; the fact that the drugs in question are Schedule-H drugs and that there are vast price differences, we are of the view that the injunction earlier granted in favour of the appellants in the two cases have rightly been vacated by the learned Single Judge.

104. Learned counsel for the appellants has also sought to urge that the trademarks of the appellants are valid, and the respondents have not challenged the registration of the appellants' marks by seeking rectification.

105. The issue before us is not with regard to the validity of the appellants' trademarks TEMODAL and TEMODAR. Merely because the said trademarks may be valid and legally registered and their registrations may not contravene Section 9 of the Act, it does not necessarily lead to the conclusion that the appellants would be entitled to claim proprietary over a word fragment of their marks, particularly when the said word fragment is *publici juris* for a generic compound TEMOZOLOMIDE, and is used descriptively for the active chemical compound in the appellants products and is descriptive in nature.

106. Mr. Datta submits that the appellants would fail in their action only if the appellants trademarks are a trivial modification of the word TEMOZOLOMIDE; the appellants' trademarks are obtained by

elision of a single syllable from the word TEMOZOLOMIDE; the appellants' trademarks are substantially identical to the word TEMOZOLOMIDE; the appellants' trademarks are legal equivalent of the word TEMOZOLOMIDE.

107. These may be some of the grounds for the appellants to fail in their action against the respondents, but these are not the only grounds why the Court would deny interim relief of injunction in cases like these. For the appellants to succeed, they must also establish that the respondents have no right to use the generic name/abbreviation of the compound 'TEMOZOLOMIDE' in their drugs, and that the appellants have an exclusive right in this regard. This, unfortunately for the appellants, they have failed to show. In our view, for the appellants to fail it is enough that the appellants' trademark have been coined by combining the *publici juris* abbreviation TEM/TEMO for TEMOZOLOMIDE with the suffix 'DAL' in one case and 'DAR' in the other case, the marks of the appellants are descriptive, and the marks of the respondents do not bear phonetic or visual similarity which could be said to be deceptive or confusing for the purchasers of the drugs in question.

108. The registration of the appellants marks is in respect of TEMODAL and TEMODAR. By virtue of Section 17 of the Act, it is the said marks and not parts of the said marks, which stand protected. Consequently, TEM/TEMO cannot be claimed to enjoy protection by virtue of Section 17 of the Act. Section 17 of the Act confers on the proprietor the exclusive right to the use of the trademark as a whole.

It provides: *“Notwithstanding anything contained in sub-section (1) when a trademark contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trademark so registered”* (See Section 17 (2) (b)).

109. The packaging in which the products of the appellants, namely, ‘TEMODAL’ is marketed and the products of the respondents’ ALKEM and GETWELL are marketed, have been placed on record. ‘TEMODAL’ is marketed in 20 mg tablets, each bottle containing 5 tablets. On the other hand ‘TEMOKEM’ is marketed in an aluminum strip of five tablets and the potency of the tablets is 100 mg. There is absolutely no similarity in the getup of the packaging adopted by the appellants and the respondents. Similarly, ‘TEMOGET’ is sold in an aluminum strip of five capsules of either 20 mg or 250 mg. The colour of the capsules of the appellants is green for the 5 mg capsule, brown for the 20 mg capsule, blue for the 100 mg capsule and black for the 250 mg capsule. The product of the respondent GETWELL is sold in capsules of 20 mg of blue colour, 100 mg in white colour and 250 mg in green colour. Therefore, there is no similarity in the getup of either the packaging or the product itself.

110. In our view, the factors that the products of the respondent contain the warning *“To be supplied against demand from cancer hospitals, institutions and against a prescription of a cancer patient only”* and the huge price difference (about 600%) in the product of the

appellants on the one hand, and the respondents on the other hand, are extremely germane considerations to rule out the possibility of any confusion or deception in the minds of the purchasers of the drugs in question.

111. The drugs of the respondents can be bought only against prescriptions from cancer hospitals, institutions and cancer specialists and not otherwise. The appellants have not produced any credible material to show actual confusion or that their product is, in any way, superior to that of the respondents which could be relied upon at this stage of the proceedings.

112. The aforesaid trademarks cannot be deciphered or considered separately i.e. by fragmenting them, but must be taken as a whole. But even if they are taken as a whole, the prefix TEMO used with suffix KEM and GET in the two competing names distinguish and differentiate the products of the appellants from those of the two respondents. When they are taken as a whole, the aforesaid two trademarks of the two respondents cannot be said to be either phonetically or visually or in any manner deceptively similar to the trademarks of the appellants i.e TEMODAL and TEMODAR.

113. The common feature in the competing marks i.e. TEMO is only descriptive and *publici juris* and, therefore, the customers would tend to ignore the common feature and would pay more attention to

the uncommon feature. Even if they are expressed as a whole, the two do not have any phonetic similarity to make them objectionable.

114. Consequently, we find no infirmity with the findings arrived at by the learned Single Judge at this stage. The learned Single Judge was justified in not continuing the temporary injunction in favour of the appellants/plaintiffs. We, therefore, dismiss these appeals but with no orders as to costs. However, we direct the respondents Alkem and Getwell in the two appeals to maintain detailed accounts of the sales of their respective drugs 'TEMOKEM' and 'TEMOGET' and to regularly file half yearly statements in the suit, till the disposal of the suit. It goes without saying that any observation made by us on the merits of the cases of either party is only tentative, and the learned Single Judge shall decide all issues arising in the suit without being influenced one way or another by our said findings.

**(VIPIN SANGHI)
JUDGE**

**(MUKUL MUDGAL)
JUDGE**

DECEMBER 01, 2009
as/rsk/dp