



2024 : DHC : 2394



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

% Reserved on: 22nd February, 2024

Pronounced on: 21st March, 2024

+ **CS(COMM) 424/2021, I.A. 11524/2021 & I.A. 16787/2021**

SUN PHARMA LABORATORIES LIMITED Plaintiff

Through: Mr. Sachin Gupta, Mr. Ajay Kumar, Mr.
Mana Mondal, Mr. Rohit Pradhan and
Ms. Prashansa Singh, Advocates.

versus

NARENDER KUMAR & ORS. Defendants

Through: Mr. Abhiraj Jayant, Mr. Advait Ghosh
and Mr. Mrinal Chaudhry, Advocates.

CORAM:
HON'BLE MR. JUSTICE ANISH DAYAL

JUDGMENT

ANISH DAYAL, J.

I.A. 11524/2021 (application under Order XXXIX Rules 1 & 2 of the CPC) and
I.A. 16787/2021 (application under Order XXXIX Rule 4 of the CPC)

1. This judgment disposes of I.A. 11524/2021 under Order XXXIX Rule 1 and 2 of the Code of Civil Procedure, 1908 ('CPC') filed by plaintiff seeking injunction against defendants and I.A. 16787/2021 under Order XXXIX Rule



4 of CPC filed by defendants seeking vacation of order dated 09th September, 2021 injuncting defendants.

Brief Facts

2. The suit had been filed by plaintiff seeking a decree of permanent injunction restraining defendants, and all those acting under them, from directly or indirectly, manufacturing, selling, advertising, and dealing in pharmaceutical preparations under defendants' mark "CAFTADAY" (**'impugned mark'**) or any other trademark deceptively similar to plaintiff's trademark "CAFTA" (**'plaintiff's mark'**), which would amount to passing off of defendants' goods as those of the plaintiff, and other attendant reliefs.

3. On 09th September, 2021, this Court issued summons in the suit and notice in the applications, and an *ex-parte ad interim* injunction was passed in favour of plaintiff and against defendants in the following terms:

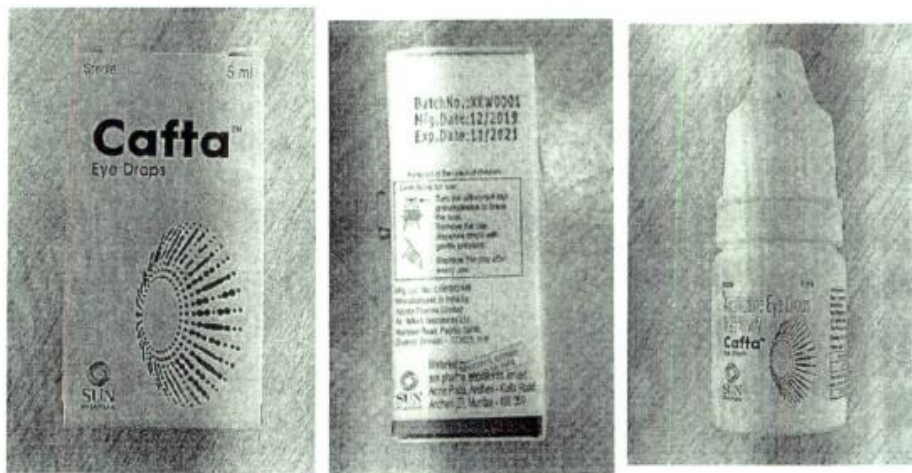
"15. Accordingly, till further orders, the defendants, their partners or proprietors, as the case may be, their assigns in business, licensees, franchisee, distributors, dealers, stockists, retailers/chemists are restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in medicinal & pharmaceutical preparations under the impugned mark CAFTADAY or any other trade mark as may be deceptively similar to the plaintiff's trade mark CAFTA."

4. The dispute pertains to alleged passing off by defendants of plaintiff's product "CAFTA", which is a medicinal eye drop containing the compound



“ALCAFTADINE”. Defendants are using the impugned mark “CAFTADAY” for their eye drops containing the same compound. For reference, the pictorial representation of plaintiff’s and defendants’ products is as under:

Plaintiffs Product “CAFTA”:



Defendants’ product “CAFTADAY”:





5. The application under Order XXXIX Rule 4 of CPC was listed before the Court on 13th January, 2022, when defendants sought time to file further documents in support. Subsequently, an affidavit in compliance was filed on 25th January, 2022. Written statement and replication has also been filed by the respective parties, and proceedings are underway in the suit.

Submissions on behalf of defendants

6. In support of their application under Order XXXIX Rule 4 of CPC, counsel for defendants, *inter alia*, submitted as under:

6.1 The generic compound which forms the basis of both plaintiff's and defendants' products is "ALCAFTADINE", where 'AL-' and '-INE' are prefixes and suffixes which are generic and accepted in the trade. Reliance was placed on a document of World Health Organization ('WHO') – Guidance on the Use of International Nonproprietary Names ('INNs') for Pharmaceutical Substances. It was contended that it is an admitted position that "ALCAFTADINE", an ophthalmic preparation, was an INN listed by WHO (*counsel for plaintiff agreed to this*) and that the prefixes 'AL-' and suffix '-INE' were part of "common stems" used in the selection of INNs. These common stems were listed in Annexure-3 of the WHO document. It was submitted that the prefix 'AL-' meant aldehydes, while the suffix '-INE' denotes an alkaloid or organic bases.

6.2 It was, therefore, claimed that plaintiff had not coined the word "CAFTA" but had essentially taken it from the INN "ALCAFTADINE" and



used it as their trademark. They could not, therefore, claim distinctiveness in the same.

6.3 Reliance was placed on Section 13 of the Trade Marks Act, 1999 ('**Trade Marks Act**') which prohibits registration of names of chemical elements or INNs. According to the said provision, INNs declared by WHO and notified in the prescribed manner by the Registrar, or any word which was deceptively similar to such INN, could not be used for registration of a trademark. Plaintiff's mark was not registered and their trademark application for "CAFTA" was still under objections. Plaintiff's case, at best, was of passing off and not infringement. Defendants' mark was also not registered and their trademark application has been opposed by plaintiff.

6.4 "CAFTA" was a significant and dominant part of "ALCAFTADINE" and had become *publici juris* and, therefore, being deceptively similar to the INN, ran the risk of not being registered.

6.5 Presence of the word "CAFTA" as a mark for a product containing "ALCAFTADINE" conveys, to the doctor and the chemist, that the particular medicinal formulation contains the specific salt. Restraining defendants or others from using the word "CAFTA" would lead to a monopoly over the salt "ALCAFTADINE" and would also lead to unfair competition in the market.

6.6 Since the products are medicinal in nature and are used for eyes, which are a sensitive part of the body, it is unlikely that a consumer would self-medicate or buy the product on the mere suggestion of a chemist. The said



product would be available on prescription by a doctor, who is unlikely to get confused between the brands “CAFTA” and “CAFTADAY”.

6.7 Reliance was placed on the decision in *Schering Corporation & Ors. v. Alkem Laboratories Ltd.*, 2009 SCC OnLine Del 3886, where a Division Bench of this Court reiterated, in para 62, that in the trade of drugs, it is a common practice to name a drug on the basis of the name of the active chemical compound or salt, or the disease it seeks to remedy, or the organ it intends to treat. The name of such ingredient or compound, being in the public domain and of a generic nature, cannot be claimed by anyone for exclusive use as their trademark.

6.8 Reliance was also placed on *Orchid Chemicals and Pharmaceuticals Ltd. v. Wockhardt*, 2013 SCC OnLine Mad 1324, where the Madras High Court reiterated that use of generic terms is common and unavoidable and such names have come to be identified with a class or category of goods and service by the public at large and can, therefore, be called generic.

6.9 Pharmaceutical customers tend to ignore common features of products since use of parts of a salt name is unavoidable and there are several medicines of different brands being sold in the market. Reliance was placed on various other trademarks which were using similar generic names such as CAFTADINE, OCUCAFT, CAFTROCARE T, ALCAFT, CAFTYCA, LASTACAFT, etc. A number of these formative marks have been registered in Class 5 domestically and internationally, and have been extracted from online search reports by defendants.



6.10 Refuting plaintiff's case for passing off, it was contended that plaintiff started selling its formulation in 2019 as per plaintiff, and had not generated enough goodwill in the market for "CAFTA" to have acquired secondary meaning and be associated exclusively with the plaintiff. This was further underscored since the name had been picked from a generic compound and there were several other "CAFTA" formative marks.

Submissions on behalf of plaintiff

7. Counsel for plaintiff placed the following submissions in their response:

7.1 Defendants did not raise an objection under Section 13 of the Trade Marks Act in their written statement and, in any event, plaintiff's mark was not registered, and therefore, Section 13 of the Trade Marks Act had no application in the present case.

7.2 Reliance was placed on the decision of the Bombay High Court dated 18th June, 2015 in Suit No. 235 of 2015 titled '*Ajanta Pharma Ltd. v. Sunways (India Pvt. Ltd.)*', where, in para 13, it was held that the registered trademark "GATE" and other variations were not deceptively similar to INN "GATIFLOXACIN" and that the suffix "-FLOXACIN" was prominent and emphatic and made the INN dissimilar.

7.3 Reliance was placed on the supplementary affidavit filed by defendants in compliance of this Court's order dated 13th January, 2022 stating that they had been able to locate only two eye drops containing the salt "ALCAFTADINE" viz. "ALCAFT" and "ALCAREX" manufactured by third



parties. Plaintiff's counsel contended that they were not using a substantial part of the name of the salt "ALCAFTADINE" and that "CAFTA" was not an abbreviation of the generic name.

7.4 Reliance was placed on the decision of the Hon'ble Supreme Court in *Cadila Healthcare v. Cadila Pharmaceuticals*, 2001 SCC OnLine SC 578, where it was held that the threshold of deceptive similarity is lower in cases involving pharmaceutical drugs. Confusion between two products could be severely harmful and fatal, particularly considering that the doctor's handwriting can be illegible and will cause confusion.

7.5 Reliance was placed on *Corn Products Refining v. Shangrila Food Products Ltd.*, AIR 1960 SC 142, where it was held that the question of similarity had to be approached from the point of view of a man of average intelligence and imperfect recollection.

7.6 Plaintiff was the prior user of the trademark "CAFTA" since 2019, while defendants' earliest trademark application is on 2021 on a '*proposed to be used*' basis. Reliance was placed on the decision in *Radico Khaitan Ltd. v. m/S Devons Modern Breweries Ltd.*, 2019 SCC OnLine Del 7483, where the Court held that defendants had failed to discharge its duty of due diligence and had not conducted a search in the Trade Marks Registry.

7.7 Defendants are estopped from claiming lack of distinctiveness in the word "CAFTA" considering that defendants had themselves applied for registration of the mark "CAFTADAY".



7.8 Plaintiff has garnered immense goodwill in the said product and has annual sales of over Rs.97.67 lakhs in 2019-2020 and Rs.176.33 lakhs in 2020-21 and, therefore, had made a strong case for passing off.

7.9 Reliance was placed on the decision in *Mankind Pharma v. Nova Kind Biosciences Private Limited*, 2023 SCC OnLine Del 4806 (a decision by a Coordinate Bench of this Court) where it was observed in para 32 that in the peculiar circumstances of India, where the poor are unable to afford services of a physician, they are provided drugs by the dispensing chemist and are likely to get confused into believing that drugs manufactured by the defendants are those of the plaintiff owing to a common suffix.

7.10 Reliance was placed on the decision in *Nutrica Pusti Healthcare Pvt. Ltd. and Ors. v. Morepen Laboratories*, 2021 SCC OnLine Del 2631, stating that the differences in packaging etc. between two compared products would be useful for general goods like soaps and detergents but not for medicines. Plaintiff's mark 'CAFTA' had been completely subsumed by defendants in the impugned mark and was being used as a prefix.

7.11 The three tests of passing off i.e. prior and continuous user, goodwill and reputation and deceptively confusing trademark are satisfied in the case and the defendants have been unable to make a case for vacation of injunction, which is subsisting since 2021.

7.12 The decision in *Schering Corporation (supra)* was distinguished. While there was evidence in Schering that "TEMO" was an abbreviation for



“TAMOZOLOMIDE”, there was no evidence that “CAFTA” was an abbreviation of “ALCAFTADINE”. Moreover, injunction was refused in *Schering Corporation (supra)* because of the price difference of about 600%, between the competing products; while in this case, plaintiff’s and defendants’ products are priced similarly.

7.13 The reliance on *Orchid Chemicals (supra)* was distinguished on the ground that it was a case where injunction was refused since appellant was claiming a right in the prefix, was not able to show that it was the subsequent proprietor of the mark and was also not able to justify the delay of two years in approaching the Court. In this case, plaintiff was not claiming any right in the prefix of “ALCAFTADINE” and no other medicines have been brought to the attention of the Court which starts with the prefix “CAFTA”.

Analysis

8. Heard counsel for parties and perused the material on record.

9. Admittedly, plaintiff’s case is one of passing off and not of infringement of a registered mark. Plaintiff’s mark is unregistered, and the application for registration has been objected by the Trade Marks Registry on the ground that it is similar to a prior registered mark “CEFTA”. Defendants’ mark is also unregistered, and is currently opposed by plaintiff before the Trade Marks Registry.



10. The common law tort of passing off has been succinctly explained by the Hon'ble Supreme Court in *Laxmikant V. Patel v. Chetanbhai Shah and Another*, (2002) 3 SCC 65, in the following terms:

“10. A person may sell his goods or deliver his services such as in case of a profession under a trading name or style. With the lapse of time such business or services associated with a person acquire a reputation or goodwill which becomes a property which is protected by courts. A competitor initiating sale of goods or services in the same name or by imitating that name results in injury to the business of one who has the property in that name. The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury.

11. Salmond & Heuston in Law of Torts (20th Edn., at p. 395) call this form of injury as “injurious falsehood” and observe the same having been “awkwardly termed” as “passing-off” and state:

“The legal and economic basis of this tort is to provide protection for the right of property which exists not in a particular name, mark or style but in an established business, commercial or professional reputation or goodwill. So to sell merchandise or carry on business under such a name, mark,



description, or otherwise in such a manner as to mislead the public into believing that the merchandise or business is that of another person is a wrong actionable at the suit of that other person. This form of injury is commonly, though awkwardly, termed that of passing-off one's goods or business as the goods or business of another and is the most important example of the wrong of injurious falsehood. The gist of the conception of passing-off is that the goods are in effect telling a falsehood about themselves, are saying something about themselves which is calculated to mislead. The law on this matter is designed to protect traders against that form of unfair competition which consists in acquiring for oneself, by means of false or misleading devices, the benefit of the reputation already achieved by rival traders.”

(emphasis added)

11. In a case of passing off, plaintiff is essentially required to establish three things, i.e., volume of sales and extent of advertisement, misrepresentation by the defendant to the public, and finally, loss or the likelihood of it. This triple test has been summarized by the Hon’ble Supreme Court in *Satyam Infoway Ltd. vs. Sifynet Solutions (P) Ltd.*, (2004) 6 SCC 145. Relevant paragraphs from the same are extracted below:

“13. The next question is, would the principles of trade mark law and in particular those relating to passing off apply? An action for passing off, as the phrase “passing off” itself suggests, is to restrain the defendant from passing off its goods or services to the public as that of the plaintiff’s. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. The defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive the public into thinking that the defendant’s goods or services are the plaintiff’s. The



action is normally available to the owner of a distinctive trade mark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first? It is not essential for the plaintiff to prove long user to establish reputation in a passing-off action. It would depend upon the volume of sales and extent of advertisement.

14. The second element that must be established by a plaintiff in a passing-off action is misrepresentation by the defendant to the public. The word misrepresentation does not mean that the plaintiff has to prove any mala fide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to the plaintiff [Cadbury Schweppes v. Pub Squash, 1981 RPC 429 : (1981) 1 All ER 213 : (1981) 1 WLR 193 (PC); Erven Warnink v. Townend, 1980 RPC 31 : (1979) 2 All ER 927 : 1979 AC 731 (HL)] . What has to be established is the likelihood of confusion in the minds of the public (the word “public” being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the “imperfect recollection of a person of ordinary memory” [Aristoc v. Rysta, 1945 AC 68 : (1945) 1 All ER 34 (HL)] .

15. The third element of a passing-off action is loss or the likelihood of it.

(emphasis added)



12. In order to establish the first element of passing off, plaintiff has drawn this Court's attention to the CA Certificate appended with the plaint which reflects that it has made sales of Rs. 97.67 lakhs between January 2020 and March 2020, and sales of Rs. 176.33 lakhs in the Financial Year 2020-2021 for goods bearing the mark "CAFTA". Sale invoices from September, 2020 to August, 2021 have also been appended.

13. Insofar as the question of misrepresentation is concerned, plaintiff's mark "CAFTA" has been completely subsumed by the impugned mark "CAFTADAY". In this regard, counsel for plaintiff, in the written submissions, draws attention to the decision of a Coordinate Bench of this Court in *Intel Corporation vs. Dinakaran & Ors.*, 2006 SCC Online Del 459, which also finds favor with this Court. Plaintiff's grievance in the said decision was that defendant's mark "ARTINTEL" subsumed plaintiff's mark "INTEL". Therefore, it was argued, that the prefix in the form of "ART" was affixed to the word "INTEL" to take advantage of plaintiff's goodwill and reputation. Although the defendants were proceeded against *ex-parte* and the plaintiff's mark was registered, the observations made by this Court in Para 12 of the said decision are instructive:

"12. The defendants have failed to appear and to point out any significance why word ARTINTEL was used for the business of the defendants. There is force in the contention of the learned Counsel for the plaintiff that though word ARTINTEL is one word while pronouncing the same it gets broken up into two parts ART and INTEL. The mark INTEL of the plaintiff is well known and obviously the use of the word INTEL is with the object of showing some connection



with the mark of the plaintiff INTEL and to take advantage of the goodwill and reputation of the plaintiff. Needless to say that the chances of such deception increase when the product range is same or similar. In view thereof, I am of the considered view that the plaintiff is entitled to a decree of permanent injunction and delivery up as prayed for in paras 48(i) to (iii) of the plaint.”

(emphasis added)

14. Attention was also drawn to the decision of the Division Bench of the Bombay High Court in **Indchemie Health Specialities Pvt. Ltd., Mumbai vs. Naxpar Labs Pt. Ltd.**, 2001 SCC OnLine Bom 868. In this case, the two marks under consideration were the registered mark “Cheri” and defendant’s (respondent therein) mark “Cherish” for pharmaceutical products. The Court observed that the phonetic similarity between the two competing marks was all the more manifest because appellant’s entire mark is incorporated in the mark of the respondents. The relevant paragraph from the said decision is extracted below:

“8. In the light of the aforesaid observations of the Supreme Court the question we must ask to ourselves is: what would be the effect on the mind of the person of average intelligence and imperfect recollection. Applying this test which is established principle quoted above, there can be no manner of doubt that the respondents' mark “Cherish” is deceptively similar to the appellants' mark “Cheri”. If we compare the words cheri and cherish they are structurally and visually similar as well as aurally similar and easily give rise to deception and confusion. It would be highly improbable to expect on ordinary person of average intelligence and imperfect recollection to notice the difference in the meaning



of two words cheri and cherish. As there is great deal of similarity in the phonetics of these two words. This phonetic similarity taken in conjunction with the fact that there is also a similarity in the products, to our minds, undoubtedly confuse an ordinary purchaser of average intelligence an imperfect recollection and who may even be an illiterate. This is all the more manifest because entire mark of the appellants is incorporated in the mark of the respondents. We have therefore no hesitation in coming to the conclusion that the respondents' mark Cherish is deceptively similar to the appellants' mark "Cheri" and is likely to deceive or cause confusion. Merely because the words are different it makes no difference since possibility of confusion remains.

(emphasis added)

15. This Court finds merit in plaintiff's submissions. The deceptive similarity between "CAFTA" and "CAFTADAY" is writ large as the former has been entirely subsumed by the latter. "CAFTADAY" will, necessarily, be pronounced as two words "CAFTA" and "DAY". Therefore, an average consumer of imperfect recollection is likely to be confused between the two marks.

16. Defendants' counsel, *per contra*, contends that the mark "CAFTA" is derived from the salt "ALCAFTADINE", which is an INN listed by WHO, and therefore, incapable even of registration. Reliance in this regard was placed on Section 13 of the Trade Marks Act. Defendants' counsel submits that "CAFTA", being a significant and dominant part of "ALCAFTADINE", had become *publici juris*. Attention was also drawn to other trademarks containing



the mark “CAFTA”, such as CAFTADINE, OCUCAFT, CAFTROCARE T, ALCAFT, CAFTYCA, LASTACAFT.

17. The expression “*publici juris*” was explained by the Division Bench of this Court in *Schering Corporation* (*supra*), where the competing marks “TEMODAL/TEMODAR” and “TEMOGET/TEMOKEM” for the drug “TEMOZOLOMIDE” were under consideration, in the following relevant paragraphs:

“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.”

(emphasis added)

18. It is settled law that nobody can claim an exclusive right to use any word, abbreviation, or acronym, which has become *publici juris*, and that, 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. However, whether or not a medical term is *publici juris* is an issue of fact, to be decided at the stage of trial. Even so, at the interim stage, defendant ought to produce some material to suggest that the term “CAFTA” has become *publici juris*. At this juncture, it would be instructive to take note of the overwhelming evidence that influenced the Court to observe that “TEMO” for “TEMOZOLOMIDE” was *publici juris* in *Schering Corporation* (*supra*). The relevant paragraphs are produced below:

“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.

....

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 trademark 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.”

(emphasis added)

19. In the present case, while it is an admitted position that the salt “ALCAFTADINE” is an INN listed by WHO, defendant has failed to provide any evidence suggesting that “CAFTA” is an abbreviation or a term that had become *publici juris* in the trade of pharmaceutical drugs, especially ophthalmic solutions containing the salt “ALCAFTADINE”. In compliance of this Court’s order dated 13th January, 2022, defendants were able to locate and purchase only two eye drops in the market containing the salt “ALCAFTADINE” in their ophthalmic solutions: “ALCAFT” and “ALCAREX”. While “CAFTA” does not feature in “ALCAREX” at all, “ALCAFT” contains the prefix “AL”. Plaintiff, as per its written submissions, has no qualms with defendants’ use of the mark “ALCAFTADAY”. However, as recorded in this Court’s order dated 11th October, 2022, counsel for defendants was not agreeable to adopting the same in light of the registered mark “ALCAFT”.

20. In contrast to *Schering Corporation* (*supra*), in the present case, it is neither the suffix nor the prefix of the salt “ALCAFTADINE” that has been used by defendants as their mark. Rather, defendants have chosen to extract



“CAFTA” alone, in a manner identical to plaintiff, and have proceeded to add the suffix “-DAY” to it. The contention that the prefix “AL-” in “ALCAFTADINE” denotes the presence of an aldehyde formulation, and that the suffix “-INE” denotes the presence of alkaloids or organic bases, and that, therefore, it is only the term “CAFTA” that truly reflects the presence of “ALCAFTADINE”, is a hyper technical and overstretched argument, and does not establish that “CAFTA” is *publici juris*.

21. Insofar as defendants rely on other marks in the Trade Marks Registry which contain the mark “CAFTA/CAFT” to substantiate their plea of *publici juris*, this Court does not find any merit in the same. Defendants have not been able to prove that any third-party infringer has a significant business turnover. In any case, plaintiff is not expected to sue every insignificant infringer. In this regard, following observations of the Division Bench of this Court in ***Pankaj Goel v. Dabur India Ltd.***, 2008 SCC OnLine Del 1744, are instructive:

“21. As far as the Appellant's argument that the word MOLA is common to the trade and that variants of MOLA are available in the market, we find that the Appellant has not been able to prima facie prove that the said ‘infringers’ had significant business turnover or they posed a threat to Plaintiff's distinctiveness. In fact, we are of the view that the Respondent/Plaintiff is not expected to sue all small type infringers who may not be affecting Respondent/Plaintiff business. The Supreme Court in National Bell v. Metal Goods, (1970) 3 SCC 665 : AIR 1971 SC 898 has held that a proprietor of a trademark need not take action against infringement which do not cause prejudice to its distinctiveness. In Express Bottlers Services Pvt. Ltd. v. Pepsi Inc., (1989) 7 PTC 14 it has been held as under:—



“...To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the malicious persons, just to harass the proprietor may use his mark by way of pinpricks.... The mere use of the name is irrelevant because a registered proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence... Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark. This Court is inclined to accept the submissions of the respondent No. 1 on this point... The respondent No. 1 did not lose its mark by not proceeding against insignificant infringers...”

22. In fact, in *Dr. Reddy Laboratories v. Reddy Paharmaceuticals*, (2004) 29 PTC 435 a Single Judge of this Court has held as under:—

“...the owners of trade marks or copy rights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. If the impugned infringement is too trivial or insignificant and is not capable of harming their business interests, they may overlook and ignore petty violations till they assume alarming proportions. If a road side Dhaba puts up a board of “Taj Hotel”, the owners of Taj Group are not expected to swing into action and raise objections forthwith. They can wait till the time the user of their



name starts harming their business interest and starts misleading and confusing their customers.””

(emphasis added)

22. It is clear that plaintiff has made out a *prima facie* case of misrepresentation of its mark “CAFTA” by defendants. However, this Court has not expressed any views on whether such misrepresentation was *mala fide*. In any case, in proving misrepresentation, plaintiff need not prove any *mala fide* intention, and the question of innocent misrepresentation would only be relevant at the stage of final relief per the decision in *Satyam Infoway (supra)*.

23. This Court also finds no merit in defendants’ submission that restraining defendants or others from using the word “CAFTA” would lead to a monopoly over the salt “ALCAFTADINE” and unfair competition in the market.

24. Moreover, defendants sell their product at Rs. 220/-, while the plaintiff had priced its product at Rs. 255/-. Clearly, not only does defendants’ product ride on the goodwill generated by plaintiff, it also has a slightly cheaper product that might lure an unsuspecting consumer. Therefore, there exists a likelihood of loss and damage in case the defendants are permitted to sell products under the impugned mark “CAFTADAY”. Furthermore, should there be any difference in the quality of the two competing drugs, such misrepresentation may have an adverse effect on the health of consumers.

25. Therefore, in light of the analysis above, and keeping in view the decision of the Hon’ble Supreme Court in *Cadila Healthcare (supra)*, this Court does not find any merit in the defendants’ contentions. Plaintiff, at the



interim stage, has satisfied the triple test for passing off and has made out a *prima facie* case in its favor by establishing sales, misrepresentation, and likelihood of damage. Balance of convenience lies in its favor, and irreparable prejudice would be caused if the interim injunction granted on 9th September, 2021 is not made absolute. This Court does not find any reason to vacate the said order in pursuance of defendants' application under Order XXXIX Rule 4 of CPC.

26. It is made clear that this Court has made no observations on the registrability of plaintiff's mark "CAFTA" insofar as Section 13 of the Trade Marks Act is concerned. Plaintiff's application for registration of "CAFTA" is currently lying under objections before the Trade Marks Registry, who shall take a decision as per the applicable law.

27. Accordingly, during the pendency of the present suit, defendants, their partners or proprietors, as the case may be, their assignees in business, licensees, franchisee, distributors, dealers, or any person acting for or on their behalf, are restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly, dealing in medicinal and pharmaceutical preparations under the impugned mark "CAFTADAY" or any other mark which may be deceptively similar to plaintiff's mark "CAFTA".

28. I.A. 11524/2021 under Order XXXIX Rule 1 and 2 of CPC is allowed, while I.A 16787/2021 under Order XXXIX Rule 4 of CPC is dismissed.

29. Both applications are disposed of in the above terms.



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30. List on 16th May, 2024 before the Joint Registrar for further proceedings.
31. Judgment be uploaded on the website of this Court.

(ANISH DAYAL)
JUDGE

MARCH 21, 2024/MK/rj