



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

**Reserved on: 09<sup>th</sup> February, 2023**

**Pronounced on: 03<sup>rd</sup> July, 2023**

+ **CS(COMM) 711/2022 & I.As. 20492-20493/2022, 1306/2023**

SUN PHARMA LABORATORIES LIMITED ..... Plaintiff

Through: Mr. Sachin Gupta, Ms. Swati Meena,  
Mr. Yashi Agarwal, Mr. Rohit  
Pradhan, Advocates.

versus

GLENMARK PHARMACEUTICALS LIMITED ..... Defendant

Through: Mr. CM Lall, Sr. Advocate, Mr. Nitin  
Sharma, Mr. Kanishk Kumar, Mr.  
Deepika Pokharia, Mr. Naman  
Tandon, Mr. Ananya Chugh,  
Advocates.

**CORAM:  
HON'BLE MR. JUSTICE SANJEEV NARULA**

**JUDGMENT**

**SANJEEV NARULA, J.**

**I.A. 16736/2022 (under Order XXXIX Rules 1 and 2 r/w Section 151 of CPC, 1908)**

**Prescribing clarity in a trademark tussle between two pharmaceutical giants vis-à-vis the marks - Istamet and Indamet**

1. Sun Pharma Laboratories Ltd. [hereinafter “Sun Pharma”] and Glenmark Pharmaceuticals Ltd. [hereinafter “Glenmark”], the two giants of the pharmaceutical industry in India are contesting their right to use drug



names “ISTAMET” and “INDAMET”, respectively, which Sun Pharma finds to be deceptively similar and confusing.

#### PLAINTIFF’S SUBMISSIONS

2. Mr. Sachin Gupta, counsel for Sun Pharma, has presented following facts and submissions:

2.1. Sun Pharma, one of the top pharmaceutical companies in the world, is a wholly-owned subsidiary of Sun Pharmaceutical Industries Ltd. [*hereinafter* “**SPIL**”] (formerly a partnership firm, M/s Sun Pharmaceutical Industries), which has been engaged in the pharmaceutical sector since 1978. Sun Pharma markets drugs and formulations in over 150 countries under various brand and trade names, and has 45 manufacturing sites in 6 continents and 10 world class research centers with over 37,000 staff of 50 different nationalities.

2.2. Sun Pharma’s manufacturing operations are focused on producing generics, branded generics, specialty, Over-the-Counter [*hereinafter* “**OTC**”] products, Anti-Retrovirals (ARVs), Active Pharmaceutical Ingredients [*hereinafter* “**APIs**”] and intermediates in the full range of dosage forms, including tablets, capsules, injectables, ointments, creams and liquids.

2.3. In 2010, Sun Pharma’s predecessor, Merck Sharp & Dohme Corp. [*hereinafter* “**Merck**”],<sup>1</sup> coined and adopted the trademark (word) “ISTAMET” and applied for registration of the said mark as well as formative marks thereof,<sup>2</sup> over a period of time. The mark “ISTAMET” and said formative marks were assigned from Merck to MSD International GmbH

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<sup>1</sup> It is a global healthcare company based in the United States of America. The name of Merck Sharp & Dohme Corp. was changed to Merck Sharp & Dohme LLC on 12<sup>th</sup> April, 2022.

<sup>2</sup> Trademarks contained at Table-A in this judgment, among other marks.

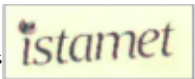


[hereinafter “MSD”] on 01<sup>st</sup> July, 2022 and further assigned to Sun Pharma with respect to India, by MSD, *vide* assignment deed dated 06<sup>th</sup> July, 2022. Sun Pharma has filed an appropriate application to have its name recorded as the subsequent proprietor in the records of the Trade Marks Register for the trademark “ISTAMET XR CP”, which is currently pending.

2.4. Merck started using the trademark “ISTAMET” in India, in 2011, through Sun Pharma and SPIL, as its exclusive licensee under the Co-License Agreement dated 01<sup>st</sup> March, 2011. The medicine sold under the name “ISTAMET” contains the salts, ‘Metformin Hydrochloride’ and ‘Sitagliptin Phosphate Monohydrate’, which is used to treat diabetes. The said medicine is sold in the form of tablets, under the extensions ISTAMET, ISTAMET XR, and ISTAMET XR CP, and is a Schedule ‘G’ drug.<sup>3</sup>

2.5. Merck’s first application for registration of trademark (word) “ISTAMET” bearing no. 2062554 dated 02<sup>nd</sup> December, 2010, in Class 5, was opposed by third-party, Grefith Life Sciences P. Ltd on the ground that the said mark is deceptively similar to their registered mark “ESTIMET” under application no. 1894414 dated 10<sup>th</sup> December, 2009, in Class 5, with user claim of 26<sup>th</sup> November, 2006. Said opposition proceedings are pending. However, Sun Pharma has not come across any medicine being sold under the mark “ESTIMET” till date and therefore, no action has been taken against the same.

2.6. Merck filed another application for registration of a trademark (device)

“” bearing no. 2722660 dated 22<sup>nd</sup> April, 2014, in Class 5. In the

<sup>3</sup> Schedule ‘G’ to the Drugs and Cosmetics Act, 1940.



Examination Report dated 30<sup>th</sup> September, 2014,<sup>4</sup> issued by Registrar of Trade Marks, conflicting marks being “ASTAMET”, “INSTAMET”, and “ESTIMET” were cited. The said application was refused *vide* order dated 28<sup>th</sup> September, 2018 on the ground that similar marks are already on record. Said order was assailed and is presently pending before this Court.<sup>5</sup> Concededly, the reply to the said Examination Report mistakenly stated that the said trademark is different from the cited marks. However, in terms of the decision of this Court in *Telecare Network India Pvt. Ltd. v. Asus Technology Pvt. Ltd. and Ors.*,<sup>6</sup> there cannot be any estoppel against law and whether a trademark is deceptively similar or not, is a question of law. Once a trademark is registered, replies to the Examination Report become irrelevant. Thus, Sun Pharma is not estopped from proceeding against the said cited marks as also Glenmark’s mark, “INDAMET”.

2.7. In the above background, Merck obtained registration of trademark (word) “ISTAMET XR CP” under application no. 2753891 dated 11<sup>th</sup> June, 2014, in Class 5, on a “proposed to be used basis”. Said mark contains the phrase “XR” for ‘extended release’ and “CP” for ‘combipack’, and was intended to be an extension of ISTAMET. Although the said registration has a condition that “the mark is to be read as a whole”, however, this condition does not travel to the market and retailer does not retain all of the individual details of a composite mark in their mind but only the overall, general impression created by composite as a whole. The said registration was also associated to applications under no. 2062554 and 2722660. Merck also

<sup>4</sup> Dispatch date 05<sup>th</sup> January, 2016.

<sup>5</sup> C.A.(COMM.IPD-TM) 22/2022.

<sup>6</sup> Neutral Citation No. 2019:DHC:2889.



applied for registration of trademark (device) “**Istamet XR**” in Class 5 under application no. 5511525 dated 30<sup>th</sup> June, 2022 with user claim of 07<sup>th</sup> November, 2014, which is presently pending registration.

2.8. The Defendant, Glenmark is engaged in marketing and manufacturing of medicine under mark “INDAMET” which contains ‘Indacaterol’ and ‘Mometasone’. Said medicine, a Schedule ‘H’ drug, is used for treatment of asthma.

2.9. In May 2022, Sun Pharma came across Glenmark’s application for “INDAMET” [*hereinafter “Impugned Mark”*] under no. 4777138 dated 11<sup>th</sup> December, 2020, for goods in Class 5 on a “proposed to be used” basis. The mark was granted registration on 26<sup>th</sup> May, 2021. Thereafter, this Court extended the limitation to file oppositions till 30<sup>th</sup> May, 2022.<sup>7</sup> SPIL and Merck filed oppositions against the said application on 27<sup>th</sup> May, 2022 and 30<sup>th</sup> May, 2022, respectively. Pursuant thereto, Glenmark filed its counter statement contending that there is no ground for confusion, and the said proceedings are presently pending. Glenmark has also filed an application for registration of mark “INDA-MET” under no. 5158364 dated 02<sup>nd</sup> October, 2021 for goods in Class 5 on a “proposed to be used” basis and the same is currently under objection by the Trade Marks Registry and pending registration.

2.10. Although both applications, for the marks “INDAMET” and “INDA-MET” have been filed on a “proposed to be used basis”, however, in its aforementioned counter statement, Glenmark claimed extensive use of the mark

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<sup>7</sup> *Dr. Reddys laboratories Ltd. v. Controller General of Patents Designs and Trade Marks*, W.P.(C)-IPD 4/2022 and connected matters, judgment dated 21<sup>st</sup> March, 2022.



“INDAMET”. It was in the first week of September, 2022, Sun Pharma came across Glenmark’s listings of the medicine under the Impugned Mark being sold on various e-commerce websites/ e-pharmacies, namely, TATA 1MG, Pharmeasy, Netmeds. Details of the websites and URLs have been provided at page 29 of the plaint.

2.11. Sun Pharma’s mark “ISTAMET” being a coined mark is inherently distinctive and indicates the origin of the goods bearing the said mark. On account of superior quality and high efficacy, the medicine sold under the said mark have acquired significant reputation and goodwill. The sales turnover of under the mark “ISTAMET”, “ISTAMET XR” and “ISTAMET XR CP” for 2021-22 was approx. INR 252 crores. Details of the statement of sales from 2011-2012 to 2021-2022, are provided at pages 25 and 26 of the plaint.

2.12. The Impugned Mark is confusingly similar to Sun Pharma’s mark “ISTAMET” in terms of visual, structural and phonetic similarity. The adoption of the Impugned Mark by Glenmark amounts to infringement of Sun Pharma’s mark “ISTAMET XR CP” under Section 29 (1) and (2) of the Trade Marks Act, 1999 [*hereinafter “the Act”*] and erosion of distinctiveness of Sun Pharma’s mark. Further, given the deceptive similarity and likelihood of confusion between the marks, the use of the Impugned Mark constitutes misrepresentation, misappropriation as also passing off of Sun Pharma’s mark.

2.13. A human error in reading/ writing Sun Pharma’s mark as the Impugned Mark, which is likely, could mislead a user into purchasing the incorrect medicine leading to adverse impact on their health. Considering the likelihood of confusion on account of similarity between the two marks, the public interest should also be considered. The Supreme Court in *Cadilla Healthcare*



*v. Cadila Pharmaceuticals*,<sup>8</sup> has held that test of deceptive similarity in relation to pharmaceutical products must be applied to, stringently, keeping public interest paramount. Accordingly, an interim injunction must be granted.

#### DEFENDANT'S SUBMISSIONS

3. Mr. Chander M. Lall, Senior Counsel representing Glenmark, contests the above submissions and avers that no interlocutory order of injunction is necessary for the following reasons:

3.1. At the very outset, Sun Pharma has failed to disclose correspondences and actions taken prior to the institution of the present suit, rendering the suit liable to be dismissed on grounds of non-disclosure. First, Glenmark had, without prejudice, offered in its settlement proposal dated 11<sup>th</sup> July, 2022 to limit its specification of goods to “*Pharmaceutical preparations for inhalers for treatments of Asthma and Chronic Obstructive Pulmonary Disease, Pharmaceutical preparations being powder for inhalation*” as opposed to Sun Pharma’s registration for “*Pharmaceutical preparations for the treatments and prevention of diabetes*”, in response to a cease-and-desist notice dated 24<sup>th</sup> June, 2022 issued by Merck. There was no response to this settlement proposal and neither has the same been disclosed in Sun Pharma’s submissions. Second, Glenmark filed 12 caveats across all Commercial Courts in Delhi as well as this Court, against Merck, SPIL and Sun Pharma, details whereof are provided at page 9 of the written statement, which have not been disclosed by Sun Pharma, as well.

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<sup>8</sup> (2001) 5 SCC 73.



3.2. Glenmark, incorporated in 1977, is an Indian multinational pharmaceutical company with a footprint in over 80 countries, with 10 manufacturing facilities and workforce of 14,000 employees. Glenmark is engaged in manufacturing and marketing of a variety of pharmaceutical formulations, APIs, and medicinal preparations. In the last four decades, Glenmark has introduced several brands of products which have acquired tremendous goodwill and reputation amongst the public and members of the trade. Details of Glenmark's annual sales turnover, awards and accreditations are provided at pages 5 and 6 of the written statement.

3.3. On 16<sup>th</sup> June, 2022, Glenmark launched a novel fixed dose combination drug for uncontrolled asthma under the mark "INDAMET". The drug sold under the mark "INDAMET" is distinguishable from the one sold under the mark "ISTAMET"/ "ISTAMET XR CP", since both are for different ailments, have different packaging and the former is sold as a capsule to be inhaled with a dry-powder inhaler [*hereinafter* "**DPI**"] whereas the latter is sold as a tablet. Thus, no likelihood of confusion arises.

3.4. The mark "ISTAMET" is yet to be registered and registration for the mark "ISTAMET XR CP" under no. 2753891 must be read as a whole, inclusive of the terms "XR" and "CP", in terms of the specific restriction imposed by the Registrar of Trade Marks. Accordingly, no monopoly can be claimed over the mark "ISTAMET" more so *qua* all goods under Class 5 given the registration for "ISTAMET XR CP" is limited to preparations for diabetes. There is no visual, phonetic or structural similarity between "INDAMET" and "ISTAMET XR CP".

3.5. Glenmark independently coined the term "INDAMET", which is derived from the constituent chemical compounds, i.e., "INDA" from





“Indacaterol acetate” and “MET” from “Mometasone furorate”. Sun Pharma’s “ISTAMET” also borrows “MET” from the constituent compound “Metformin”. Sun Pharma cannot claim any monopoly over the term ‘MET’ given it is common to trade. Several third-party manufactures have obtained registrations and are using the suffix “MET” for drugs, which includes the drugs sold under the marks “ZITAMET”, “JANUMET”, “SEPAMET”, “SANTIA MET”, all of which are substitutes to the drug sold under the mark “ISTAMET”.

3.6. Both the drugs can be sold only through prescription since Sun Pharma’s drug and Glenmark’s drug fall under Schedule ‘G’ and Schedule ‘H’, respectively. Said prescription would necessarily prescribe a DPI like Rotahaler as the method of intake for the “INDAMET” drug, as opposed to the oral dosage of ISTAMET which is to be swallowed. In this regard, reliance is placed on prescriptions, which have been filed.

3.7. Sun Pharma is taking an inconsistent and contradictory stand *qua* “INDAMET” as opposed to the cited marks in its own registrations. For the mark “ISTAMET XR CP” bearing no. 2753891, Sun Pharma, itself, distinguished its mark from one of the cited conflicting mark “INTAMET”, as dissimilar. Notably, Sun Pharma’s device mark bearing no. 2722660 also stands refused by Registrar of Trade Marks on account of prior registered marks in Class 5 including “ASTAMET”, “INSTAMET” and “ESTIMET”. Sun Pharma distinguished its device mark *vis-à-vis* the cited marks in its response to the Examination Report, as dissimilar. Such admission in the plaint of an incorrect response to the cited conflicting mark renders the device mark non-registrable, on account of failure to clear the hurdle under Section



11 of the Act. Thus, in light of its earlier stand, Sun Pharma, in the present suit, cannot be permitted to approbate and reprobate per its convenience.

3.8. In the market, “ISTAMET XR CP” co-exists peacefully with other anti-diabetic drugs without any confusion, i.e., “ZITAMET”, which is Glenmark’s own offering, “JANUMET” and “SEPAMET”. Sun Pharma’s “ISTAMET XR CP” is also co-existing peacefully with “INSTAMET” and “ESTIMET”, without any confusion for the same ailment and with “VISTAMET” for a different ailment.

3.9. In respect to the concerns relating to public health, it is averred that if a person suffering from diabetes takes “INDAMET”, which is used for treatment of asthma, instead of “ISTAMET”, there will be no negative impact and the drug would just pass through the system of the user.

### ANALYSIS

4. This Court has considered the aforementioned contentions.

5. Sun Pharma contends that Glenmark’s use of the mark “INDAMET” amounts to infringement of Sun Pharma’s registered mark “ISTAMET XR CP”, as also, passing off of Sun Pharma’s “ISTAMET” marks [hereinafter “*ISTAMET Marks*”], detailed as under: -

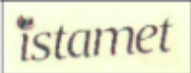
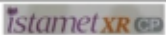
**TABLE-A**

SN	APPLN No.	DESCRIPTION	CLASS [GOODS]	DATE OF APPLN.	USER	STATUS
1.	2062554	ISTAMET (word)	5 <sup>9</sup>	02 <sup>nd</sup> December, 2010	Proposed to be used	Under opposition by third-party <sup>10</sup>

<sup>9</sup> For goods, “pharmaceutical preparations for the treatment and prevention of diabetes.”

<sup>10</sup> Under opposition by third-party, Grefith Life Sciences P. Ltd.



2.	2722660	 (device)	5 <sup>11</sup>	22 <sup>nd</sup> April, 2014	24 <sup>th</sup> August, 2011	Appeal against refusal allowed by this Court, mark allowed to proceed for advertis ement prior to accepta nce <sup>12</sup>
3.	2753891	ISTAMET XR CP (word)	5 <sup>13</sup>	11 <sup>th</sup> June, 2014	Proposed to be used	Register ed
4.	5511525	 (device)	5 <sup>14</sup>	30 <sup>th</sup> June, 2022	07 <sup>th</sup> November 2014	Examin ation Report yet to be issued

6. Details of Glenmark's marks/ Impugned Mark are as under: -

**TABLE -B**

SN	APPLN No.	DESCRIPTION	CLASS	DATE OF APPLN.	USER	STATUS
1.	4777138	INDAMET (word)	5 <sup>15</sup>	11 <sup>th</sup> December, 2020	Proposed to be used	Opposed

<sup>11</sup> For goods, "Pharmaceutical preparations for the treatment and prevention of diabetes."

<sup>12</sup> C.A.(COMM.IPD-TM) 22/2022. Subsequent to this matter being reserved for judgment, the said mark was allowed to proceed for advertisement prior to acceptance, *vide* order dated 20<sup>th</sup> April, 2023.

<sup>13</sup> For goods, "Pharmaceutical preparations for the treatment and prevention of diabetes."

<sup>14</sup> For goods, "Pharmaceutical preparations for the treatment and prevention of diabetes."

<sup>15</sup> For goods, "Pharmaceutical, Medicinal and Ayurvedic Preparations and Substances, Dietetic Food and Substances adapted for Medical Use, Dietary Supplements for Humans, Nutritional Supplements, Nutraceutical Preparations for Therapeutic or Medical Purposes, Nutraceuticals for use as Dietary Supplements, Pharmaceutical Preparations for Inhalers, Nicotine Inhalers for Medical Purposes, Pharmaceutical Preparations for filling in Inhalers."



2.	5158364	INDA-MET (word)	5 <sup>16</sup>	02 <sup>nd</sup> October, 2021	Proposed to be used	Objected
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**(I) Whether the two competing marks are deceptively similar?**

7. The restriction that Sun Pharma's mark has to be read as a whole, is a reiteration of Section 17 of the Act, which provides that when a trademark consists of several matters, its registration shall confer exclusive right to use of the trademark taken as a whole. It must be noted that protection afforded to a trademark is based on mark's overall impression on the consumers and not just one particular feature. The distinctive element or combination of elements is typically the most essential feature of the mark and the same is entitled to protection,<sup>17</sup> as it sets the mark apart from others in the market and makes it identifiable to consumers. Although Sun Pharma's registration is for the composite mark "ISTAMET XR CP", the dominant feature indisputably remains the word "ISTAMET". Furthermore, the terms "XR" (denoting 'extended release') and "CP" (indicating 'combipack'), the added matter is standard nomenclature used by pharmaceutical companies to describe products. Therefore, the distinguishing feature of Sun Pharma's mark is the term "ISTAMET", which, when compared to Glenmark's "INDAMET", exhibits striking similarity. As for Mr. Lall's argument that no monopoly can be claimed on the suffix "MET", the Court is not dissecting the mark for

<sup>16</sup> For goods, "Pharmaceutical, Medicinal and Ayurvedic Preparations and Substances, Dietetic Food and Substances Adapted for Medical Use, Dietary Supplements for Humans, Nutritional Supplements, Nutraceutical Preparations for Therapeutic or Medical Purposes, Nutraceuticals for use as Dietary Supplements, Pharmaceutical Preparations for Inhalers, Nicotine Inhalers for Medical Purposes, Pharmaceutical Preparations for filling in Inhalers."

<sup>17</sup> *United Biotech Pvt. Ltd. v. Orchid Chemicals & Pharmaceuticals Ltd. & Ors.*, 2012 SCC OnLine Del 2942.



comparing the suffix selectively. The competing marks “ISTAMET” and “INDAMET” are evidently structurally and phonetically similar, when compared as a whole with different prefix. The only difference lies in two letters of the prefix, with Sun Pharma employing ‘ST’ in ‘ISTA’ and Glenmark using ‘ND’ in ‘INDA’. Therefore, “INDAMET” is deceptively similar to “ISTAMET” both structurally and phonetically. The next question to be addressed is whether such similarity between the two marks is substantial enough to warrant an injunction, given Glenmark's various defenses concerning the description of goods under Sun Pharma's registration and the perceived differences between the products associated with the competing marks.

8. In *Cadilla Healthcare (supra)*, the Court has held that trademarks in relation to pharmaceuticals must be assessed with utmost care and attention, keeping in the mind the potential risk to public health. Thus, scrutiny of deceptive similarity between trademarks for pharmaceutical products is higher as compared to other goods. The Court should not engage in technical gymnastics in an attempt to find some minor differences between conflicting marks.<sup>18</sup> Such matters must be constructed from the point of view of public or consumers and must not ordinarily be construed from the perspective of chemists and pharmacists. Even so, chemists and pharmacists cannot be said to be infallible even though they are trained/ qualified, and thus, confusion and mistakes as to similar marks may arise.<sup>19</sup> Thus, Glenmark’s contention that both drugs are provided to users only on producing appropriate

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<sup>18</sup> *Stiefel Laboratories v. Ajanta Pharma Ltd.*, 2014 SCC OnLine Del 3405; *M/s South India Beverages v. General Mills Marketing Inc.*, 2014 SCC OnLine Del 1953.

<sup>19</sup> See *Cadilla Healthcare (supra)*; *Novartis AG v. Crest Pharma*, 2009 SCC OnLine DEL 4390.



prescriptions of different kinds as opposed to an over-the-counter drug, does not hold weight. The Court is unimpressed with the argument that no confusion is possible as the source is mentioned on packaging. In the opinion of the Court, considering the overall similarity between the two marks, the likelihood of confusion for a buyer cannot be ruled out solely because the packaging is different. The Court is also unimpressed with Mr. Lall's submission that added matter is sufficient to distinguish the two products. Such a proposition firstly, should not be applied to pharmaceutical products where the Courts apply a stricter approach to gauge the possibility of confusion and do not engage in speculation as to minor differences since 'drugs are poisons not sweets'<sup>20</sup>. Further, considering the potentially dangerous consequences,<sup>21</sup> such a proposition cannot be accepted.

9. The two competing marks "ISTAMET" and "INDAMET" are clearly structurally and phonetically similar, and when seen from the eyes of consumer of average intelligence having imperfect recollection, there are high chances of confusion and deception. Confusion surrounding the mode of administration of a drug can lead to misuse and potential health risks. Such risks are particularly heightened in scenarios where patients are self-administering medications at home, without direct supervision from healthcare professionals. Furthermore, while the DPI device may provide some differentiation, it is not an intrinsic part of the drug but an accessory, the purchase of which is discretionary. The deceptive similarity between the trademarks could lead to confusion at the point of purchase, irrespective of the mode of administration. Hence, this Court must prioritize the primary

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<sup>20</sup> See *Cadilla Healthcare* (supra).

<sup>21</sup> See *Cadilla Healthcare* (supra); *Novartis AG* (supra).



factor - the striking resemblance between the product names - in its assessment of potential consumer confusion and associated risks with public interest to be paramount and be conscious of the dangerous consequences that can follow on account of any confusion. Thus, the contentions of differentiation urged by Mr. Lall to differentiate the products is of no consequence in the present assessment.

**(II) Whether the description of goods mentioned under Sun Pharma's registration and packaging of products under the competing marks, is sufficient to distinguish the parties' marks?**

10. Mr. Lall has strongly relied upon the limitation on the specification of the goods relating to Sun Pharma's registration of "ISTAMET XR CP" bearing no. 2753891 by emphasizing that it can only be applied for "pharmaceutical preparations for the treatment and prevention of diabetes" falling in Class 5. This limitation of goods combined with the fact that registration is further subject to the restriction that the 'mark has to be read as a whole' demonstrates that no monopoly can be claimed on the term "ISTAMET", particularly in respect of all goods falling under Class 5.

11. Mr. Lall has also laid stress that the distinct packaging of two products removes any source of confusion, which are compared as under: -

SUN PHARMA'S PRODUCT	GLENMARK'S PRODUCT
<i>Outer Box Packaging - white base background with black font</i>	<i>Outer Box Packaging - colour combination of white, red and blue</i>
<i>Inner Packaging- Blister packaging- silver colour</i>	<i>Inner Packaging- white bottle with sealed cap</i>



12. Beyond the variations already noted, Mr. Lall has also drawn attention to the dissimilarities in the Maximum Retail Price (MRP) of the two products. Furthermore, he emphasizes that the therapeutic applications of the products differ significantly. Sun Pharma's product is designed for diabetes management, while Glenmark's is formulated for asthma treatment. He also distinguishes the mode of administration for each product and points out that Sun Pharma's medication is taken orally, whereas Glenmark's product is inhaled using a device akin to a DPI, like Rotahaler.

13. In evaluating this case, the Court holds that the specificity outlined in Sun Pharma's registration, which confines their pharmaceutical product to be utilized for diabetes, should not be interpreted narrowly, as Mr. Lall proposes. When it comes to pharmaceutical products, it is crucial to consider the perspective of the end consumer. This viewpoint, often of a person with average intelligence, has consistently been deemed to be the guiding factor by





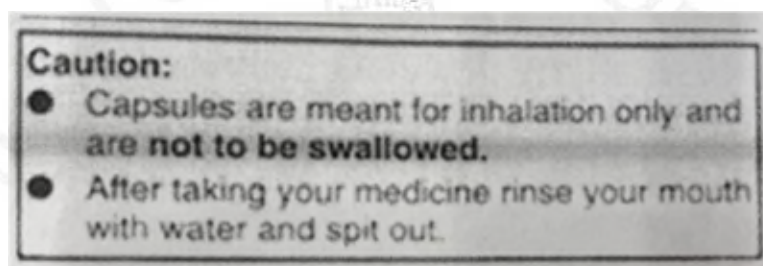
this Court. Therefore, given the similarities between the products, we cannot discount the potential for confusion or misunderstanding when ordinary consumers are faced with similar-looking prescription drugs, even if their therapeutic applications differ significantly. This is particularly relevant in the context of public health, where any ambiguity could potentially lead to harmful consequences.

14. Bearing in mind the established legal principles mentioned earlier, we will now address the various points of differentiation emphasized by Mr. Lall. The suffix “MET” in Sun Pharma's product “ISTAMET” is an abbreviation derived from the first three letters of “Metformin Hydrochloride”, the active ingredient in the drug. Likewise, the “MET” in Glenmark's “INDAMET” is based on a different active compound, “Mometasone Furoate”. Although Glenmark has emphasized that the difference in these compounds as a significant point of distinction, however, in the Court's view, the marked similarity between Glenmark's and Sun Pharma's brand names overshadow these differences in composition, due to the shared suffix “MET.” This could cause substantial confusion among consumers suffering from either asthma or diabetes, potentially leading to serious consequences. It is important to note that, in pharmaceuticals, minor differences in composition or formulation can yield significantly varied effects on the body, including potential side effects. It is thus critical that the public is not misled into purchasing a product under the belief that it has a specific composition or formulation, only to discover it contains different active ingredients. A more stringent test must be applied to pharmaceutical products, given their significant impact on public health and safety. Consumers trust these brand names for their respective health



conditions and consequently, any ambiguity concerning a drug's composition or formulation could result in grave health repercussions.

15. Mr. Lall fervently posited that, should a consumer mistakenly consume Glenmark's "INDAMET" in place of Sun Pharma's "ISTAMET," intended for the treatment of Type 2 Diabetes, no adverse effects would ensue; the medication would simply be excreted from the body. This assertion does not find favor with the Court, especially considering the explicit warnings provided on the packaging of Glenmark's "INDAMET" drug, which read as follows:



16. Glenmark's product labeling clearly advises users against ingesting the "INDAMET" capsule in the same manner as an oral tablet, presumably due to associated health risks. As such, Mr. Lall's assertion that accidental ingestion would result in no harm seems unfounded, and moreover, this assertion is unsupported by any scientific evidence or research. No authoritative report, study, or peer-reviewed publication has been submitted to indicate the potential repercussions of accidental consumption of either party's medication. In fact, Mr. Lall's assertion is controverted by Mr. Gupta, who states that in a situation where a person suffering from diabetes accidentally consumes Glenmark's "INDAMET" drug meant for asthma, blood sugar levels of the patient will increase on account of the molecules of



“Indameterol” and “Mometason” present in the drug and also on account of the patient missing out on their actual prescribed dosage of “ISTAMET”. If untreated, damage could occur to the blood vessels and could aggravate the potentiality of heart disease, stroke, kidney disease, vision problem and even nerve problems.

17. As illustrated by Mr. Gupta there is also a second scenario where a person suffering from asthma accidentally takes Sun Pharma’s “ISTAMET” drug which is used to treat diabetes. That, as highlighted by him, can lead to Hypoglycaemia and continuing such dosage would lead to dramatic fall in a person’s blood sugar levels leading to Hypoglycaemic coma which can have varied outcomes including death. Further, considering that the person taking “INSTAMET” is suffering from asthma, he would be miss out on his prescribed dosage of “INDAMET” which may worsen his asthma over time.

18. Thus, the clinical consequence of the accidental consumption of an incorrect drug is a ‘grey area’ and cannot be a point of differentiation for this Court to rule out any possibility of confusion between the two drugs. On the contrary, the scenarios illustrated by counsel underscore the need for a rigorous assessment.

19. Mr. Lall has contended that confusion can be averted as the “INDAMET” medication is intended to be used alongside a Dry Powder Inhaler or DPI such as a Rotahaler, which is always prescribed to first-time users. However, this argument doesn't stand as a solid distinguishing factor, given that the Rotahaler is not packaged with the drug but must be purchased separately, and it can indeed be obtained independently. Mr. Gupta has counter-argued, stating that there are asthma treatments available in tablet form. Consequently, an asthma patient could inadvertently consume the



“ISTAMET” tablet, failing to detect any anomaly. Additionally, it's entirely plausible that a user of the “INDAMET” medication, due to the deceptive similarity of the trademarks, could inadvertently obtain the “ISTAMET” drug and then administer it in a powdered form *via* the Rotahaler. Thus, the method of administration cannot serve as the sole differentiator for the products and bears little relevance in this assessment.

**(III) Whether Sun Pharma’s stand in the present suit is hit by the plea of estoppel?**

20. Mr. Lall has fervently contended that since Sun Pharma had previously differentiated its ISTAMET Marks from the similarly structured conflicting trademarks, such as “INTAMET”, “INSTAMET” and “ESTIMET”, during the registration process, they are now estopped from contesting the similarity of their mark with the disputed mark “INDAMET”. However, this argument is not persuasive for several reasons discussed hereinafter.

21. Firstly, the distinction drawn by Sun Pharma during the registration process was specific to those third-party conflicting marks and did not pertain to the disputed mark at hand. Therefore, any statement or stance by Sun Pharma during the trademark registration process or during the opposition to third-party marks cannot logically or legally be applied to the current dispute involving the mark “INDAMET”.

22. Secondly, the principle of estoppel hinges on a sequence of events involving a party making a factual representation, the other party accepting and relying upon this representation, and consequently altering its position.<sup>22</sup>

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<sup>22</sup> *Pratima Chaudhary v. Kalpana Mukhejee*, (2014) 4 SCC 196.



Any alteration of position should be such that it would be unjust to compel the party to revert back to its original state.<sup>23</sup> In the current context, Glenmark has not presented evidence to suggest that these conditions for estoppel have been met. There is no representation by Sun Pharma that Glenmark could have reasonably relied on to alter its position, especially not in a manner that would render a return to its original position unjust.

23. The determination of whether two marks are deceptively similar is essentially a legal question, and it is a well-established principle that there can be no estoppel against the law.<sup>24</sup> Responses to an examination report or cyclostyled oppositions to other trademarks,<sup>25</sup> cannot preclude or dictate the legal evaluation of deceptive similarity in a separate case.

24. Legal rights carry significant weight, and they cannot be decided merely based on routine oppositions and responses to examination reports in unrelated matters. Given the considerations outlined above, the circumstances of the present case do not lend themselves to the application of the doctrine of estoppel.

#### **(IV) Where does the balance of convenience lie?**

25. The balance of convenience unequivocally lies in favour of Sun Pharma in this case. Sun Pharma has been utilizing the mark “ISTAMET” since 2011, establishing a considerable period of usage and market recognition. In contrast, Glenmark launched their product under the “INDAMET” mark quite recently, on 16<sup>th</sup> June, 2022. Significantly, this initiation occurred in the face

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<sup>23</sup> See *Pratima Chaudhary* (supra).

<sup>24</sup> See *Telecare* (supra).

<sup>25</sup> See *Telecare* (supra); *Anil Verma v. R. K. Jewellers SK Group & Ors.*, 2019 SCC OnLine Del 8252.



of an opposition already filed against the use of the mark on 27<sup>th</sup> May, 2022. This scenario strongly suggests that Glenmark consciously chose to use the Impugned Mark despite the existing opposition, thus accepting the associated risks. This action can be construed as either negligence or a strategic gamble on Glenmark's part. In either case, it does not situate the balance of convenience in their favour.

26. Additionally, the well-established principle that 'first in the marketplace' holds the right, applies here, favoring Sun Pharma. They have been in the market with their mark for over a decade, building consumer recognition and goodwill that Glenmark surely cannot claim to have achieved in such a short span of time. Glenmark's decision to proceed with the Impugned Mark despite the pending opposition demonstrates their willingness to risk potential legal consequences. Such disregard for established opposition cannot serve as a basis to claim the balance of convenience in their favour.

27. Glenmark also avers that the correspondences in respect of the Merck's cease-and-desist notice prior to the institution of the suit, were concealed. Sun Pharma states that the cause of action pleaded in the present suit arose on 27<sup>th</sup> May, 2022, when the opposition was filed against the Impugned Mark, which is prior to the date of issue of cease and desist notice. In the opinion of the Court, there has been no concealment or non-disclosure of any material and essential facts to deny the discretionary and equitable remedy on injunction. To the extent necessary, Sun Pharma's pleadings make a complete disclosure of the facts relating to the use of the competing marks by the parties, which is the subject matter of the suit.



28. Given these considerations, the balance of convenience distinctly favours the Plaintiff, Sun Pharma, thus warranting the issuance of an injunction. Furthermore, if an injunction is not granted, Sun Pharma may suffer an irreparable loss and damage. The deceptive similarity of the marks, coupled with Glenmark's recent market entry with a strikingly similar mark, could potentially lead to significant loss of business for Sun Pharma. More critically, it may damage Sun Pharma's long-built reputation and goodwill among consumers, who may inadvertently associate the quality and effects of Glenmark's product with Sun Pharma's product, due to the deceptive similarity in their marks. This reputational damage is intangible and often impossible to fully quantify or rectify, thereby characterizing it as irreparable harm. Furthermore, the potential health risks for consumers due to confusion between the two products adds a heightened element of public interest to this case. Therefore, in the interest of protecting Sun Pharma from such irreparable harm, and to safeguard public health, it is crucial that an injunction is granted in this case.

### **CASE LAWS**

29. Finally, the Court addresses the extensive case laws presented by both parties. Glenmark has produced a brief note containing 18 case laws in an attempt to demonstrate that injunctions were not granted even in scenarios involving similar-sounding drug names. Sun Pharma, as a countermeasure, has listed 27 cases to rebut Glenmark's arguments and to assert that injunctions should indeed be granted in the face of deceptively similar drug names. The Court acknowledges these respective legal references. However, upon examination, it is clear that these case laws predominantly reinforce the



fundamental principles and criteria that Courts adhere to while deliberating on whether to grant injunctions concerning deceptively similar trademarks.

30. As such, to delve into an exhaustive analysis of all these cited precedents would prove largely unnecessary and non-productive, given that these cases largely reaffirm the basic tests and principles which are already well-established and accepted. The Court is more concerned with the direct application of these principles to the unique facts and circumstances of the present case, rather than the rote recapitulation of case law. Each case must be judged on its own merits, keeping in mind the particular factual matrix, the nature of the industry involved, the likely degree of public confusion and the potential consequences thereof. This nuanced analysis, rather than a rigid adherence to precedent, is the approach that best serves the objectives of trademark law: the protection of consumer interest and the avoidance of public confusion.

### **DIRECTIONS**

31. In light of the aforementioned reasons, Sun Pharma has successfully met the criteria required for the issuance of an interim injunction against Glenmark. Therefore, it is hereby ordered that, during the pendency of this suit, Glenmark, including any parties acting on their behalf, are restrained from manufacturing, offering for sale, selling, displaying, advertising, marketing, directly or indirectly, any medicinal/pharmaceutical preparations bearing the Impugned Mark, “INDAMET” or any other mark which is identical/ deceptively similar to Sun Pharma’s registered mark “ISTAMET XR CP” (as enumerated in Table-A above).





32. This injunction will not extend to the products bearing the Impugned Mark that have been manufactured prior to the date of this judgment. Glenmark is hereby instructed to compile and submit details pertaining to the existing products that bear the Impugned Mark, "INDAMET", which should include the batch number and manufacturing date. The affidavit be filed within two weeks from today.

33. With the above directions, the present application is allowed.

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34. List before the Joint Registrar on 11<sup>th</sup> August, 2023.

35. List before Roster Bench on 03<sup>rd</sup> October, 2023.

**SANJEEV NARULA, J**

**JULY 03, 2023**  
*d.negi*

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