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

% *Date of Decision : 1st May, 2023*

+ C.O. (COMM.IPD-TM) 723/2022 & I.A. 12360/2022 (O-XXVI R-9 of CPC)

SUN PHARMA LABORATORIES LTD

..... Petitioner

Through: Mr. Sachin Gupta and Ms. Yashi Agrawal, Advocates.

versus

CIAN HEALTHCARE LTD & ANR.

..... Respondents

Through: None.

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. The present petition has been filed under Section 57 of the Trade Marks Act, 1999 seeking cancellation of the mark "MGalin" bearing Registration No. 3956223 in class 5.

FACTUAL MATRIX

2. The case set up in the petition is as under:

2.1. The petitioner is a wholly owned subsidiary of Sun Pharma Industries Ltd. The petitioner is engaged in the business of marketing drugs and pharmaceutical combinations in over 150 countries with 45 manufacturing sites located in various countries.

2.2. Petitioner is the registered proprietor of the trademark "Maxgalin"

bearing No. 1402291 since 29th November, 2005 and various other marks, details of which are provided in paragraph 12.7 of the petition.

2.3. The “Maxgalin” mark is used by the petitioner for its medicine used to relieve neuropathic pain. The said drug is sold in the form of tablets and is a Schedule H drug.

2.4. The trademark “Maxgalin” has also acquired goodwill and reputation due to its extensive and continuous use since 2005 and has therefore attained the status of a well-known trademark within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999.

2.5. The sales turnover of the petitioner from the year 2012–2013 to the year 2020–2021, for the pharmaceutical preparation sold under the mark “Maxgalin,” is Rs.383,28,66,000/-. In the year 2020–2021 alone, the sales turnover of the petitioner in relation to the aforesaid mark was Rs.52,32,23,000/-.

2.6. The respondent no.1 is a registered company operating out of Pune and engaged in the business of selling medicines.

2.7. The respondent no.1 has gotten registered the impugned mark “MGalin” on the basis of a false user claim.

2.8. Accordingly, the petitioner has filed the present petition.

PROCEEDINGS IN THE CASE

3. Notice in the present petition was issued on 4th August, 2022 and pursuant thereto, respondent no.1 stood served through ordinary mode on 8th November, 2022.

4. On 14th February, 2023, last opportunity of four weeks was afforded to the respondent no.1 to file reply to the cancellation petition. Since the respondent no.1 failed to file any reply to the petition, the right of the respondent no.1 to file reply was closed on 12th April, 2023.

5. Today, none appears on behalf of the respondent no.1 even on the second call.

6. Written submissions have been filed on behalf of the petitioner in the suit.

SUBMISSIONS ON BEHALF OF THE PETITIONER

7. The following submissions have been made on behalf of the petitioner:

7.1. The petitioner has been the registered proprietor and user of the mark “Maxgalin” since 2005.

7.2. The respondent no.1, in order to defeat the effect of registration in favour of the petitioner, applied for registration of the impugned mark “MGalin” in 2018 with a false user date of 7th January, 2003.

7.3. No evidence has been provided by the respondent no.1 as regards use of the impugned mark since 2003.

7.4. The respondent no.1 has failed to rebut the assertion of the petitioner that the respondent no.1 has made a false user claim.

7.5. The registration granted in favour of the respondent no.1 should be cancelled since it has been obtained by making a false statement as to user. Reliance in this regard is placed on the judgment in *Suresh Kumar Jain v. Union of India*, 2012 SCC OnLine Del 12 and *Shri Adepu Surrender v. M/s Adepy Ramaiah Narayana*, 2012 SCC OnLine IPAB 60.

7.6. The impugned mark “MGalin” is deceptively similar to the mark

“Maxgalin”.

7.7. The respondent no.1, by registering and using the impugned mark, is attempting to capitalize on the goodwill and reputation of the petitioner under the “Maxgalin” mark.

7.8. Despite being given a final opportunity to respond to the matter, the respondent has failed to file a reply.

ANALYSIS AND FINDINGS

8. I have heard the counsel for the petitioner and examined the record of the case.

9. In the present case, the respondent no.1 has failed to file reply/counter-statement within the period prescribed by the Court, in terms of Rule 7(ix) of Delhi High Court Intellectual Property Rights Division Rules, 2022. Since the respondent no. 1 has failed to take any requisite steps to contest the present petition, it is evident that the respondent no.1 has no defence to put forth on merits.

10. It is clear from a comparison of the competing marks that the mark “MGalin” is deceptively similar to the mark “Maxgalin,” being visually, phonetically and structurally similar to the latter. The respondent no.1 has merely dropped the letters “AX” from the registered mark of the petitioner. Not only are the marks deceptively similar but their use in class 5 for the drugs being sold under the two marks is also for treating the same type of ailment. Therefore, there is a likelihood of confusion in the market between the drugs under the two trademarks.

11. From a perusal of the material on record, it is clear that the adoption of

the impugned mark by the respondent no. 1 is a dishonest attempt to trade upon the goodwill and reputation of the petitioner. Therefore, the aforesaid registration granted in favour of the respondent no. 1 is liable to be cancelled under Section 57 of the Trade Marks Act, 1999.

12. Further, it is unclear as to why the respondent no.1 filed an application for registration of the impugned mark only in 2018 when it had been using the impugned mark since 7th January, 2003. Since no evidence has been furnished in support of the date of user claimed by the respondent no.1, it appears that the registration application of the respondent no.1 was filed with the claimed date of user as 7th January, 2003 merely to overcome the use and registration of the petitioner. In fact, the date of 7th January, 2003 is actually the date of incorporation of the respondent no.1.

13. The respondent no.1 has failed to rebut the assertion of the petitioner that the registration of the impugned mark “MGalin” was obtained on the basis of a false statement of user since 7th January, 2003. No evidence was filed by the respondent no.1 before the Trade Marks Registry in support of its user of the impugned mark since 2003. Once it is established that the subject registration has been obtained through a false statement as to the date of user, the respondent no.1 cannot claim to be a proprietor of the impugned mark within the meaning of Section 18(1) of the Trade Marks Act, 1999. Reference in this regard may be made to the judgment in *Shri Adepu Surrender* (supra).

14. Accordingly, the respondent no.2, Trade Marks Registry is directed to forthwith remove the impugned mark ‘MGalin’ bearing Registration No.3956223 in class 5 in favour of the respondent no.1 from the Register of Trade Marks.

15. The Registry is directed to supply a copy of the present order to the Trade Marks Registry at the e-mail address llc-ipo@gov.in for compliance.

MAY 1, 2023
at

AMIT BANSAL, J.

