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

+ CS(COMM) 912/2024 & I.A. Nos. 42665/2024, 42666/2024,
42667/2024, 42668/2024 & 42669/2024

TORRENT PHARMACEUTICALS LTD

.....Plaintiff

Through: Mr. Sachin Gupta with Mr. Rohit
Pradhan, Ms. Prashansa Singh,
Mr. Ajay and Ms. Archana, Advocates.
(M): 9811180270
Email: info@litlegal.in

versus

INDORBIT PHARMACEUTICALS P. LTD. & ANR.....Defendants

Through: None.

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA

ORDER

21.10.2024

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I.A. 42666/2024 (Exemption from filing certified copies of documents)

1. The present is an application under Section 151 of the Code of Civil Procedure, 1908 ("CPC"), on behalf of the plaintiff, seeking exemption from filing certified clearer/typed or translated copies of documents.

2. Exemption is granted, subject to all just exceptions.

3. Plaintiff shall file legible, clear, and translated copies of the documents, on which the plaintiff may seek to place reliance, before the next date of hearing.

4. Accordingly, the present application is disposed of.

I.A. 42665/2024 (Exemption from instituting Pre-Institution Mediation)

5. The present is an application under Section 12A of the Commercial


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Courts Act, 2015, read with Section 151 of CPC, seeking exemption from undergoing Pre-Institution Mediation.

6. Having regard to the facts of the present case and in the light of the judgment of Supreme Court in the case of *Yamini Manohar Versus T.K.D. Keerthi, 2023 SCC OnLine SC 1382*, and Division Bench of this Court in *Chandra Kishore Chaurasia Versus RA Perfumery Works Private Ltd., 2022 SCC OnLine Del 3529*, exemption from attempting Pre-Institution Mediation, is granted.

7. Accordingly, the application stands disposed of.

I.A. 42667/2024 (Exemption from advance service to the defendants)

8. The present is an application under Section 151 CPC, seeking exemption from advance service to the defendants.

9. The plaintiff seeks urgent interim relief, and has also sought appointment of Local Commissioner. Therefore, in the peculiar facts and circumstances of this case, exemption from effecting advance service upon the defendants, is granted.

10. For the reasons stated in the application, the same is allowed and disposed of.

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11. Let the plaint be registered as suit.

12. Upon filing of the process fee, issue summons to the defendants by all permissible modes. Summons shall state that the written statement be filed by the defendants within thirty days from the date of receipt of summons. Along with the written statement, the defendants shall also file affidavit of admission/denial of the plaintiff's documents, without which, the written statement shall not be taken on record.

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13. Liberty is given to the plaintiff to file replication within thirty days from the date of receipt of the written statement. Further, along with the replication, if any, filed by the plaintiff, an affidavit of admission/denial of documents of the defendants, be filed by the plaintiff, without which, the replication shall not be taken on record. If any of the parties wish to seek inspection of the documents, the same shall be sought and given within the timelines.

14. List before the Joint Registrar (Judicial) for marking of exhibits, on 12th December, 2024.

15. List before the Court on 04th March, 2025.

I.A. 42669/2024 (Application under Order XXXIX Rules 1 and 2 CPC)

16. The present suit has been filed for permanent injunction restraining copyright infringement, passing off, unfair competition, delivery up, rendition of accounts of profits/damages etc.

17. Learned counsel appearing for the plaintiff submits that by way of the present suit, the plaintiff complains against the defendants for dealing in calcium tablets under impugned ORBITCAL-500 label/carton and strip packaging/ trade dress, which is identical to the plaintiff's well-known "SHELCAL 500" label/carton and strip packaging/trade dress. It is submitted that the plaintiff has no objection to the defendants' use of the mark ORBITCAL-500, and the plaintiff's grievance is limited to the adoption and use of the impugned label/carton and strip packaging/ trade dress. The competing products as given in the plaint, are reproduced as under:


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Plaintiff's Trade Dress	Defendant's Trade Dress



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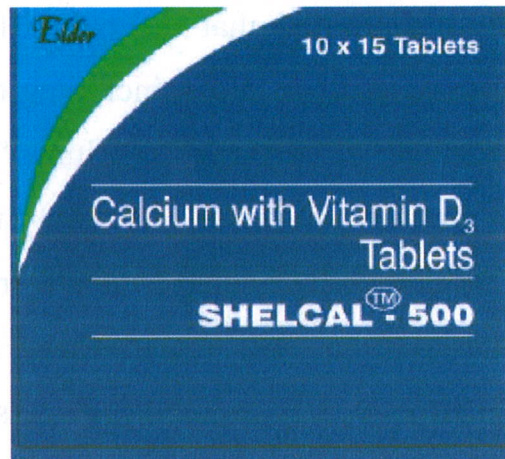
18. It is submitted that the plaintiff's SHELCAL-500 label/carton and strip packaging/ trade dress, including their overall colour combination, get up, placement of features constitute "original artistic work". He further submits that the plaintiff is therefore, the owner of the copyright in the said artistic work thereby having exclusive right to use or reproduce the same in any material form. Any unauthorized reproduction or imitation or use of such imitation by any unauthorized person would constitute infringement of copyright under Section 51 of The Copyright Act, 1957, which is liable to be enjoined under Section 55 of the said Act.

19. The plaintiff also has registration for its word mark "SHELCAL" the oldest one dated 07th November, 1991 bearing *no. 561663*. The plaintiff, vide an Assignment Agreement dated 27th June, 2014, was assigned several trademarks, with SHELCAL and SHELCAL formative marks being a part of them.

20. It is further submitted that the defendant has registration for ORBITCAL, bearing *no. 6000626* dated 30th June, 2023, in Class 5, on a '*proposed to be used basis*'. The impugned activities of the defendants are unlawful and amount to copyright infringement, passing off, unfair competition, which is in turn causing confusion and deception amongst the public and loss to the plaintiff. Therefore, the defendants ought to be restrained by way of an *ex-parte ad interim* injunction.

21. It is submitted that the plaintiff has been selling its calcium tablets under the trade mark "SHELCAL" in a distinctive pack with a deep blue, white, and green color packaging since 2014, which is reproduced as under:-

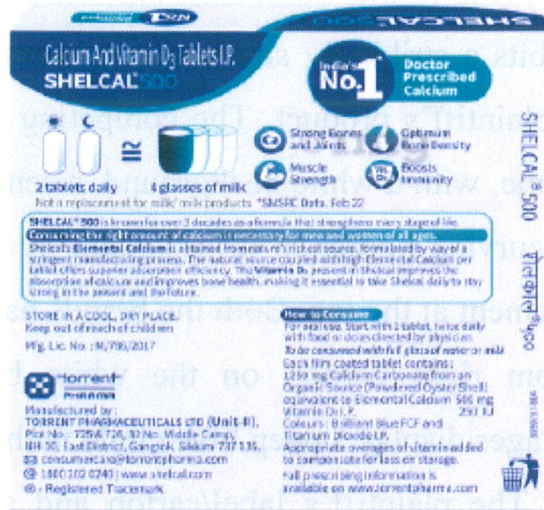
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22. It is further submitted that the above packaging was well recognized in the market. However, with the intention to rebrand the product after the aforementioned trade mark assignment, the plaintiff had engaged an agency to develop the unique trade dress/ label, which was then prepared and came into use, and rights in the same were eventually transferred to the plaintiff through a Copyright Assignment Agreement dated 07th March, 2024. This new design has been in use since September 2022, and is reproduced as under:



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23. It is submitted that the packaging displays plaintiff's trade mark SHELCAL-500 with a distinctive and eye catching combination of colors and design elements that give the product its distinctive dress. The packaging design incorporates a color scheme of blue, white and teal color prominently featuring an illustration of joints. This visual representation effectively communicates the intended use of the tablet to consumers at a glance.

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24. It is further submitted that the impugned ORBITCAL-500 packaging exhibits a strikingly similar label/carton and strip packaging/trade dress to the plaintiff's product. The competing products feature an identical colour scheme, with a white background, a semi-circular patch of deep blue, with a teal curving border to it, separated by a black line, all arranged in similar placement at the top. Both the brands have their brand name displayed in the bottom right corner, on the white background. Additionally, both the packages display a deep blue circle with an adjacent teal box/area with white text. The plaintiff's label/carton and strip packaging/trade dress contains specific claim like "India's No. 1 Doctor Prescribed Calcium" signifying quality and trust. Moreover, the back packaging of both the products, include, a prominent illustration of bones/joints. The competing packaging also have illustrations at the back, of two tablets adorned with sun and moon symbols, an equivalent sign, alongside identical imagery of four glasses. The four descriptive points on the back packaging of both the products namely "strong bones and joints", "optimum bone density", "muscle strength" and "boosts immunity", are verbatim. Furthermore, the circular symbols showcasing "Ca", bone image, muscle symbol, shield shape outline featuring "Vit D3" are identical and a blatant copy of the plaintiff's label /carton and strip packaging/ trade dress. He submits that the defendants have even copied the tablet strip, with 15 tablets present on each strip, presented in a pattern of 5x3 tablets which are almost cylindrical in shape. Additionally, both the products have same drug composition, i.e. Calcium carbonate and Vitamin D3.

25. It is further submitted that this distinct combination of the colour scheme, patterns, joint illustrations, and product claims has remained

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consistent over the years; establishing a strong market presence and building significant goodwill for the plaintiff.

26. It is further submitted that the plaintiff has been manufacturing and marketing its SHELCAL calcium tablets as an "Over the Counter" ("OTC") product. Once a product is marketed as OTC product, it is promoted extensively in a manner to gain consumer awareness. He submits that the OTC products can be purchased over the counter without prescription of medical practitioners, hence are primarily purchased by consumers who make informed decisions of their own. In such a case, the burden falls upon the brand owner to reach out to the consumers on its own by way of marketing, promotion, quality consistency and control, goodwill and distinctiveness of the brand for identification of source and origin of the product, like any other consumer non-durable product. Based upon the market reach, brand recollection and quality maintained by the product, the consumer makes a choice amongst several other similar products available in the market. In such cases, the distinctiveness of their packaging acquires great significance as a source identifier of such goods and constitutes valuable trade mark rights for the proprietor. Hence, he submits that the OTC products and preparations are altogether a different and distinct segment category, as compared to prescription drugs or scheduled drugs, and hence, ought to be treated differently for purposes of likelihood of consumer confusion.

27. It is submitted that the present label /carton and strip packaging/ trade dress of plaintiff's SHELCAL-500 has acquired distinctiveness and enviable goodwill and reputation due to its extensive, long and continuous use since September 2022. These OTC products bearing the said label /carton and

strip packaging/ trade dress, identify plaintiff as the source or origin and none else. The plaintiff has the common law right to the exclusive use of the label /carton and strip packaging/ trade dress of plaintiff's SHELCAL-500. The use of the same or a deceptively similar trade dress by an unauthorised person or trader in relation to the similar kind of goods will constitute passing off of the plaintiff's right of the exclusive use under the provisions of the Trade Marks Act, 1999.

28. It is further submitted that the plaintiff is the proprietor of the label/carton and strip packaging/trade dress of plaintiff's SHELCAL-500 thereof, which has acquired formidable goodwill, reputation and distinctiveness *vis-a-vis* such goods. The plaintiff, therefore, has the exclusive right to use the said label/carton and strip packaging/trade dress and ought to be protected by this Court against imitation, confusion, deception, dilution and unfair competition by competitors in trade.

29. It is submitted that in the last week of September 2024, the plaintiff came across the defendant's product having the impugned ORBITCAL-500 label /carton and strip packaging/ trade dress being sold in the markets of Delhi. The impugned goods are used for the same purposes, i.e. as a calcium supplement, and is being sold in the same form i.e. tablets.

30. It is further submitted that the defendant has registration for the word ORBITCAL bearing registration no. 6000626 dated 30th June, 2023, in class 5, on a '*proposed to be used basis*', but to the best knowledge of the plaintiff, the defendant have no registration for the trade dress *per se*.

31. It is submitted that the defendants have unethically and unlawfully adopted the impugned trade dress ORBITCAL-500. He submits that being in pharmaceutical business, the defendants are well aware of the plaintiff's

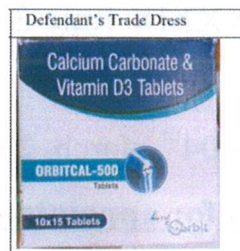
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adoption and use of its trade dress SHELCAL 500 and having seen the success of the plaintiff's product, thus, the defendants adopted the impugned label/carton and strip packaging/ trade dress. Such dishonest adoption amounts to copyright infringement, passing off, unfair trade practice, unfair competition and dilution. Such act also amounts to misrepresentation and misappropriation of plaintiff's goodwill in its trade dress.

32. It is submitted that the use of the impugned ORBITCAL-500 Label/ Carton Packaging/Trade Dress by the defendants is mala fide, constitutes acts of misrepresentation as well as misappropriation of goodwill and reputation built-up by the plaintiff by their own effort and investment amounting to passing off of the defendant's goods for those of the plaintiff as well as unfair competition.

33. In the above circumstances, the plaintiff has demonstrated a *prima facie* case for grant injunction and, in case, no *ex parte ad interim* injunction is granted, the plaintiff will suffer an irreparable loss. Further, balance of convenience also lies in favour of the plaintiff, and against the defendants.

34. Accordingly, till the next date of hearing, the defendants, their directors, partners or proprietors (as the case may be), their assignees in business, distributors, dealers, stockists, retailers / chemists, servants and agents, are restrained from selling their product in the impugned carton and



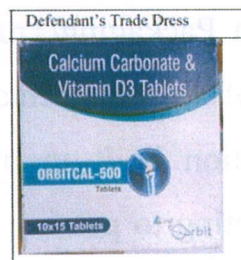
the trade dress, amounting to infringement of the copyright

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of the plaintiff as well as passing off of the defendants goods, as those of the plaintiff's goods and businesses.

35. It is clarified that the defendants can continue to manufacture and sell their products in the strips, without the carton having the impugned trade dress, which is deceptively similar to the trade dress of the carton of the plaintiff.

36. It is further clarified that the present injunction order is only with



respect to the carton of the defendants, with the deceptively



similar trade dress, as that of the plaintiff on its carton, i.e.,

37. Issue notice to the defendants by all permissible modes upon filing of the Process Fee, returnable on the next date of hearing.

38. Let reply be filed within a period of four weeks.

39. Rejoinder thereto, if any, be filed within two weeks, thereafter.

40. Compliance of Order XXXIX Rule 3 CPC, be done, within a period of two weeks.

41. List before the Court on 04th March, 2025.

I.A. 42668/2024 (Application for appointment of Local Commissioner)

42. The present application has been filed on behalf of the plaintiff under Order XXVI Rule 9 read with Order XXXIX Rule 7 read with Section 135

of the Trade Marks Act, 1999, seeking appointment of Local Commissioner.

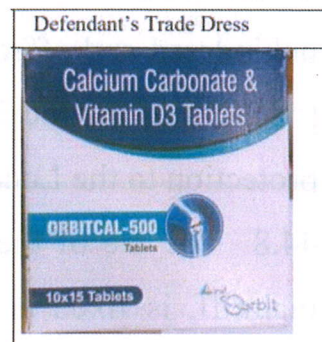
43. It is submitted that in order to preserve evidence of infringement, it is necessary that Local Commissioner be appointed to visit the premises of the defendants.

44. Accordingly, the following directions are issued:

44.1 Mr. Chirantan Krishna, Advocate, (Mob. No. 9315779319), is appointed as Local Commissioner, with a direction to visit the following premises of the defendant no. 2:

***Mauza Rampur Jattan, Nahar Road Kala Amb,
Dist. Sirmour,
Himachal Pradesh – 173030***

44.2 The learned Local Commissioner, along with a representative of the plaintiffs and their counsel, shall be permitted to enter upon the premises of the defendants mentioned hereinabove, or any other location/premises, that may be identified, during the course of commission, in order to conduct the search, and seize products which are being marketed by the defendants, i.e.



the carton with the similar trade dress, . It is clarified that the products of the defendants inside the carton, are not subject matter of this order, and the mandate of the learned Local Commissioner is confined to seizing only the carton of the defendants' products, as depicted hereinabove.

44.3 After seizing the infringing material, the same shall be inventoried, sealed, and signed by the learned Local Commissioner, in the presence of the parties, and released on *superdari* to the defendants, on their undertaking to produce the same, as and when further directions are issued, in this regard.

44.4 The learned Local Commissioner shall also be permitted to make copies of the books of accounts, including ledgers, cash books, stock registers, invoices, books, etc., in so far as they pertain to the infringing products.

44.5 Further, the learned Local Commissioner shall be permitted to undertake/arrange for photography/videography of the execution of the commission.

44.6 Both the parties shall provide assistance to the learned Local Commissioner, for carrying out the aforesaid directions.

44.7 In case, any of the premises are found locked, the learned Local Commissioner shall be permitted to break open the lock(s). To ensure an unhindered and effective execution of this order, the Station House Officer (“SHO”) of the local Police Station, is directed to render all assistance and protection to the Local Commissioner, as and when, sought.

44.8 The fee of the learned Local Commissioner, to be borne out by the plaintiff, is fixed at ₹ 1,50,000/- (Rupees One Lac Fifty Thousand). The plaintiff shall also bear all the expenses for travel/lodging of the Local Commissioner and other miscellaneous out-of-pocket expenses, for the execution of the commission. The fee of the Local Commissioner shall be paid in advance by the plaintiff.

44.9 The Local Commission shall be executed within a period of two

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weeks from today. The Local Commissioner shall file the report within a period of two weeks from the date, on which the commission is executed.

45. The order passed today, shall not be uploaded for a period of two weeks.

46. In terms of the foregoing, the present application stands disposed of.

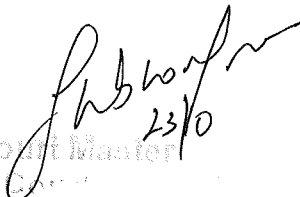
47. *Dasti* under signatures of the Court Master.



MINI PUSHKARNA, J

OCTOBER 21, 2024

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