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IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION (L) NO.30450 OF 2023
IN
COMMERCIAL IP SUIT (L) NO.30149 OF 2023

Glenmark Pharmaceuticals Ltd. ...Applicant /Plaintiff

V/s.

Gleck Pharma (OPC) Pvt Ltd. & Ors. ...Respondents /Defendants

ASHVINI BAPPASAHEB KAKDE
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Mr. Hiren Kamod a/w. Mr. Prem Khullar i/b. Mr. Mahesh Mahadgut for the Applicant/Plaintiff.

Mr. Musharaff Baba a/w. Mr. Sahil Salvi, Mr. Sagar Redkar for Defendant No.1.

CORAM : FIRDOSH P. POONIWALLA, J.

RESERVED ON: 23rd APRIL 2024

PRONOUNCED ON: 13th June, 2024.

JUDGMENT: (PER FIRDOSH P. POONIWALLA, J.)

1. The plaintiff is seeking ad-interim reliefs in terms of Prayer (a) of the Interim Application which reads as under:-

> *"(a) That Pending the hearing and final disposal of the Suit, the Respondents by themselves, their Directors, Partners/Proprietor, employees, servants, agents, associates, distributors, franchisees, sister concerns, subsidiaries, representatives, affiliates and/or assigns and all persons acting for and on their behalf be restrained by a temporary order and injunction of this Hon'ble Court from using in relation to any medicinal and/or pharmaceutical preparations and/or such allied and cogent goods, the impugned trade mark 'XIGAMET" and/or using any other trade mark containing the word 'XIGAMET" or using in combination with*

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> *or without any mark/word/device the word 'XIGAMET" and/or from using any other mark, device, logo, domain name or trade name, word which is identical with and/or deceptively similar to the Applicant's trade mark 'ZITA-MET" and 'ZITA-MET" formative marks so as to infringe the Applicant's trade marks 'ZITA-MET" and formative trade marks containing the word 'ZITA-MET" registered under Nos.2478663, 2985061, 2979092, 3533204, 3533208 and 4862436 all falling in Class-5 by such use and/or in any other manner howsoever;"*

2. The Plaintiff is a Company engaged in the business of *inter alia* manufacturing, marketing and selling pharmaceutical and medicinal preparations. One of the Plaintiff's products is an anti diabetic drug sold under the registered trade mark "ZITA-MET". From April 2013 to January 2014 the chemical composition of the Plaintiff's drug bearing the said trade mark comprised of the molecule SITAGLIPTIN. After 2015 the Plaintiff changed the molecule of "ZITA-MET" from Sitagliptin to Teneligliptin and Metformin. Representations of the Plaintiff's goods bearing the trade mark "ZITA-MET" are annexed at Exhibits D-1 to D-3 of the Plaint.

3. The Plaintiff has applied for and secured trade mark registration for the word mark "ZITA-MET" and ZITA-MET formative trade marks in Class 5. In paragraph 5 of the Plaint, the Plaintiff has produced a table comprising of the particulars of the Plaintiff's trade mark registrations.

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4. It is the case of the Plaintiff that, since the year 2013, the Plaintiff has been openly continuously and extensively using the said trade mark "ZITA-MET" in respect of its goods and has acquired tremendous goodwill and reputation in respect of its goods bearing the trade mark "ZITA-MET". The Plaintiff has produced along with the Plaint Sales Invoices and Chartered Accountant's Certificates.

5. In August 2020, the Plaintiff came across the impugned trade mark application filed by Defendant No.1 before the Trade Marks Registry for the impugned trade mark "XIGAMET" in respect of Class-5. Defendant No.1 had filed the said trade mark application for the trade mark "XIGAMET" on a proposed to be used basis on 26th February 2020. On 17th August 2020, the Plaintiff filed a Notice of Opposition before the Trade Marks Registry opposing the registration for the impugned trade mark application. Defendant No.1 filed its Counter Statement in the said opposition proceedings, however, Defendant No.1 omitted to state/disclose the date from which the Defendant No.1 started use of its impugned trade mark. The Plaintiff also did not come across any actual use of the impugned trade mark in respect of any goods in the market. In view thereof, coupled with the fact that Defendant No.1 had filed the impugned trade mark

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application on proposed to be used basis and that it had not filed any document to show actual use of the impugned trade mark, the Plaintiff did not immediately institute the suit against Defendant No.1. The opposition proceedings before the Trade Mark Registry are pending.

6. On 18th April 2023, Defendant No.1 filed its evidence in support of the impugned trademark Application in the said opposition proceedings. Upon perusal of the documents filed by Defendant No.1, the Plaintiff came across purchase bills and invoices which indicated that Defendant No.1 was selling medicinal preparations bearing the impugned trademark "XIGAMET". The Plaintiff also learnt that Defendant Nos.2, 3 and 4 were also selling the goods bearing the impugned mark along with Defendant No.1 who claims to be a proprietor of the impugned mark.

7. On 30th May 2023, the Plaintiff's Advocate issued a Cease and Desist notice upon the Defendants. Defendant No.1 replied to the said Notice vide its Advocate's letter dated 7th June 2023 raising various defenses.

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8. In and around the first week of September 2023, the Plaintiff received a summons from the Court of the Third Additional Munsif, Srinagar ("Srinagar Court"), whereby the Plaintiff came to know that Defendant No.1 had filed a Suit against the Plaintiff for groundless threat action under Section 142 of the Trade Marks Act, 1999 ("the Trade Marks Act").

9. By an ex-parte Order dated 13th June 2023, the Srinagar Court passed a temporary injunction against the Plaintiff restraining the Plaintiff from interfering with the manufacturing, distribution and sale of the Defendant's product "XIGAMET". The Plaintiff is contesting Defendant No.1's said Suit. Further by an Order dated 21st October 2023, the Srinagar Court did not continue the injunction granted by its ex-parte Order dated 13th June 2023.

10. On 26th October 2023, the Plaintiff filed the present Suit in this Court.

11. On 19th February 2024, the Srinagar Court passed an Order disposing of Defendant No.1's Interim Application and passed a temporary injunction against the Plaintiff restraining it from in any manner interfering with the manufacturing, distribution and sale of "XIGAMET" until the final disposal of Suit before the Srinagar Court.

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However, the said Order dated 19th February 2024 passed by the Srinagar Court observed that it would be subject to any order that may be passed by this Court.

12. Mr. Kamod, the learned Counsel appearing on behalf of the Plaintiff, submitted that the Plaintiff is the registered proprietor of the trade mark "ZITA-MET" and the present case pertains to the infringement of the said work mark by the Defendant's use of the impugned Trade Mark "XIGA-MET". Mr. Kamod submitted that bare perusal of the Plaintiff's Trademark "ZITA-MET" and Defendant's mark "XIGAMET" leave no manner of doubt that the rival trade marks are phonetically, aurally and visually similar. The structure similar between the trade marks is evident from the fact that both contained the same number of letters and syllables. In support of his submission, Mr. Kamod relied upon a judgment of the Supreme Court in **Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.**[1] and of the Delhi High Court in Glenmark Pharmaceuticals Ltd. Vs. Sun Pharma Laboratories in FAO (OS) (Comm) No. 146 of 2023, wherein the principles/ tests for assessing the said similarity have been laid down.

1 (2001) 5 SCC 73

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13. Further, Mr. Kamod submitted that a pertinent factor in the present case is that the goods involved in the present Suit are medicinal and pharmaceutical preparations and that the Supreme Court in **Cadila Health Care Ltd.** (supra) has observed that where medicinal products are involved, the test to be applied for assessing the violation of trade mark law is not the same as in cases involving non-medicinal products. Mr. Kamod submitted that the Supreme Court has held that a stricter approach should be adopted in such cases to judge the possibility of confusion of one medical product for another by the consumer and that public interest would support less degree of proof in showing confusing similarity between the trade marks in respect of medicinal products as against non-medicinal products.

14. Mr. Kamod submitted that applying the test and principles of deceptive similarity laid down by the Courts in the aforesaid cases would lead to the unmistakable conclusion that the Plaintiff's trade mark "ZITA-MET" and the Defendant's trade mark "XIGAMET" are deceptively similar.

15. Mr. Kamod further submitted that Defendant No.1 was deliberately dissecting the two trade marks to suit its own

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convenience. He submitted that Defendant No.1's attempt to dissect the Plaintiff's trade mark "ZITA-MET" into "ZITA" and "MET" and the Defendants' trade mark "XIGAMET" into "XIGA" and "MET" is violative of the anti-dissection rule and is impermissible in view of the settled principles of law. Mr. Kamod submitted that the Plaintiff is not claiming a monopoly on the word "META". On the contrary, it is the case of the Plaintiff that the Defendants' impugned trade mark "XIGAMET" as a whole is deceptively similar to the Plaintiff's registered trade mark "ZITA-MET".

16. Further, Mr. Kamod submitted that it is a matter of record that both the Plaintiff's goods bearing the trade mark" ZITA-MET" and the Defendant's goods bearing "XIGAMET" are anti-diabetic preparations that are used for treating the same ailment. The Plaintiff's goods bearing the trade mark "ZITA-MET" contain the molecule sitagliptin and the Defendants' goods bearing the trade mark "XIGAMET" contain the molecule teneligliptin. Hence, both the drugs are different classes of drugs and at the molecular level these medicines are very different from each other. Mr. Kamod submitted that any confusion or deception between the drugs sold by the Plaintiff under the trade mark "ZITA-MET" containing the molecule

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sitagliptin and the Defendants' goods bearing the trade mark "XIGAMET" containing the molecule teneligliptin could potentially cause harmful side effects on the consumers.

17. Mr. Kamod submitted that, hence, the facts and circumstances of the present case call for this Court to apply the test strictly as laid down by the Supreme Court in **Cadila Health Care Ltd.** (supra).

18. Mr. Musharaff Baba, the learned Counsel for the Defendants, oppose the granting of any ad-interim reliefs.

19. Mr. Baba submitted that, in the Suit filed by Defendant No.1 in the Srinagar Court, an Order dated 19th February 2024 has been passed whereby the Plaintiff has been directed not to cause any interference with the sale, distribution and stocking of the product "XIGAMET". He submitted that without any legal reason the said order has been made subject to orders passed by this Court. Mr. Baba submitted that, being aggrieved by the said Order, the Plaintiff had preferred an Appeal which is pending for disposal before the 2nd Additional District Judge, Srinagar, and Defendant No.1 has filed its cross objections seeking expungement of the observation that the Order passed would be subject to the Order passed by this Court.

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20. Mr. Baba submitted that, since, the said Appeal is pending for adjudication, the present suit filed by the Plaintiff and its ad-interim application is a gross abuse of the process of law. He submitted that in case the second Additional District Judge, Srinagar, allowed the cross objections filed by Defendant No.1, the same would give validity to the order whereby the Plaintiff has been restrained from interfering with the sale, distribution and stocking of the product "XIGAMET". Consequently, if, ad-interim reliefs are granted by this Court, the same would render the Orders conflicting and diverging, resultantly impracticable and unreasonable to be executed. Mr. Baba submitted that this Court is not sitting as an Appellate Court in the matter. He submitted that, in these circumstances, it is imperative that the present Application for ad-interim relief should not be considered at this stage and the Application as well as suit should be dismissed on the ground of multiplicity of proceedings and abuse of law.

21. Next, Mr. Baba submitted that this Court lacks jurisdiction to try this matter as the Defendants are not manufacturing or selling or stocking their products within the territorial jurisdiction of this Court. Although Defendant No.1 has its office in Mumbai but no actual business is being undertaken within the territorial jurisdiction of this

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Court. Mr. Baba submitted that this Court would have jurisdiction in the matter only if the actual business is being undertaken within its jurisdiction.

22. Next, Mr. Baba submitted that the product of the Plaintiff is completely distinct from the product of the Defendants. Mr. Baba submitted that the two marks are distinctive in character as the two words are visually, phonetically and aurally distinct from each other. He submitted that the Defendant's mark as a whole is distinct because of the appearance, the starting letters and the hyphen in between the Plaintiff's mark. He further submitted that the "IG" in the Defendants' mark is aurally completely different from the Plaintiff's mark which uses "IT". Mr. Baba further submitted that the common usage of suffix "met" is used industry-wide across the globe in medicines having the ingredient metformin. He further submitted that there are several medicines being sold in the market with the suffix "met".

23. Mr. Baba further submitted that there is a registered trade mark by the name Sitamet being sold in the Indian market having exactly the same composition as the Plaintiffs product and having registration and use much prior to that of the Plaintiff's mark.

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24. Mr. Baba submitted that if Sitamet and Zitamet can operate in the same market without causing any confusion amongst the consumers, then the objections raised by the Plaintiff about the Defendant's mark and product do not hold any water.

25. Mr. Baba further submitted that the Defendants' product "XIGAMET" uses a combination of Glimpredite and Metformin and hence the name "XIGAMET". He submitted that the said product is a hight quality trusted medicine being regularly used by patients for a really long period of time and is not a spurious medicine as is usual in the case of infringing goods. Therefore, the question of public interest is secured by virtue of this fact.

26. In support of his submission, Mr. Baba relied upon the following judgments:-

(i) Johann A. Wulfing V/s. Chemical Industrial and Pharmaceutical Laboratories Ltd & Ors[2].

(ii) Pidilite Industries Limited and Ors. v/s. Vilas Nemichand Jain & Ors[3].

2 (1984) AIR (Bombay) 281

3 2018 (6) AIR BomR 389

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(iii) Pernod Ricad India Private Limted & Ors. v/s. Karanveer Singh Chaabra trading in Misc. Appeal No.232 of 2021 (Madhya Pradesh High Court).

(iv) Dura Roof Pvt. Ltd. v/s. Dyna Roof Pvt. Ltd[4].

(v) Indo Pharma Pharmaceutical Works Ltd. v/s. Citadel Fine Pharmaceuticals[5].

(vi) F. Hoffmann La Roche & Co. Ltd v/s. Citadel Fine Pharmaceuticals[6]

(vi) International Association of Lions Club Vs. the Association of Lions India (2008) AI HC 1997)

27. Further, Mr. Baba submitted that the Plaintiff has not established any *prima facie* case. He submitted that on a bare perusal of the two products, that is "XIGAMET" and "ZITA-MET", the two are exceptionally dissimilar, phonetically, visually metamorphically and considering the price of the products. He submitted that as such, the claim raised by the Plaintiff that the Defendant's product could be passed of as the Plaintiff's product is only a figment and imagination of the Plaintiff. Mr. Baba further submitted that balance of

4 (2017) 6 Gaul J.18
5 (1998) AIR Madras 347
6 (1970 AIR (SC) 2062

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convenience also lies in favour of the Defendants as the product of the Defendant is a high quality product having less price and has been dominating the market in Kashmir Valley as compared to the product of the Plaintiff. In this regard he submitted that the sales of the Defendant run into crores of rupees as the said product is recommended by all doctors for the treatment of diabetes. Being a life saving drug, the said product is not available over the counter and is only sold on prescription. Finally, Mr. Baba submitted that the Plaintiff will not suffer any irreparable loss in the matter as all the reliefs claimed can be quantified in terms of money, and in case the Defendants fail to prove their case during trial, the Plaintiff could be compensated in monetary terms and damages could be granted.

28. Mr. Baba concluded that, for the aforesaid reasons, the Plaintiff is not entitled to any ad-interim relief. He further submitted that this Suit may not be proceeded with till the litigations pending before the Courts in Srinagar concerning the same subject matter are decided on way or the other.

29. Heard learned Counsel for the parties and perused the documents on record. The main issue for my consideration is whether the impugned mark of the Defendant is deceptively similar to the

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trade mark of the Plaintiff. In this context, it would be useful to refer to paragraph 35 of the judgement of the Supreme Court in **Cadila Health Care Ltd.** (supra) which has listed the factors for deciding the question of deceptive similarity, which reads as under:-

> *"35. Broadly stated, in an action for passing-off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered:*
>
> *a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.*
>
> *b) The degree of resembleness between the marks, phonetically similar and hence similar in idea.*
>
> *c) The nature of the goods in respect of which they are used as trade marks.*
>
> *d) The similarity in the nature, character and performance of the goods of the rival traders.*
>
> *e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.*
>
> *f) The mode of purchasing the goods or placing orders for the goods and*
>
> *g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks."*

30. Further what is the approach to be adopted whilst considering deceptively similarity in respect of marks used on medicinal products has been laid down by the Supreme Court in paragraph 33 of the Judgement in **Cadila Health Care Ltd.** (supra), which reads as under:-

> *"33. The decisions of English Courts would be relevant in a country where literacy is high and the marks used are in the language which the purchaser can understand. While English cases may be relevant in understanding the essential features of trade mark law but*

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> *when we are dealing with the sale of consumer items in India, you have to see and bear in mind the difference in situation between England and India. Can English principles apply in their entirety in India with no regard to Indian conditions? We think not. In a country like India where there is no single common language, a large percentage of population is illiterate and a small fraction of people know English, then to apply the principles of English law regarding dissimilarity of the marks or the customer knowing about the distinguishing characteristics of the plaintiffs goods seems to over look the ground realities in India. While examining such cases in India, what has to be kept in mind is the purchaser of such goods in India who may have absolutely no knowledge of English language or of the language in which the trade mark is written and to whom different words with slight difference in spellings may sound phonetically the same. While dealing with cases relating to passing off, one of the important tests which has to be applied in each case is whether the misrepresentation made by the defendant is of such a nature as is likely to cause an ordinary consumer to confuse one product for another due to similarity of marks and other surrounding factors. What is likely to cause confusion would vary from case to case. However, the appellants are right in contending that where medicinal products are involved, the test to be applied for adjudging the violation of trade mark law may not be at par with cases involving non-medicinal products. A stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by the consumer. While confusion in the case of non-medicinal products may only cause economic loss to the plaintiff, confusion between the two medicinal products may have disastrous effects on health and in some cases life itself. Stringent measures should be adopted specially where medicines are the medicines of last resort as any confusion in such medicines may be fatal or could have disastrous effects. The confusion as to the identity of the product itself could have dire effects on the public health."*

31. Further, the test in respect of medicinal products has been considered by the Delhi High Court in the case of **Glenmark Pharmaceuticals Ltd.** (Supra), wherein the Delhi High court has taken note of the principles laid down in this regard by a Division Bench of this Court in **Macleods Pharmaceuticals Ltd. vs. Union of India**.[7] Paragraph Nos.60 to 62 of the judgment of the Delhi High Court in

7 2016 SCC Online Bom 4295

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Glenmark Pharmaceuticals Ltd. (supra) are relevant and read as under:-

> *60. We find that the aspect of heightened scrutiny was also emphasized by a Division Bench of the Bombay High Court in Macleods Pharmaceuticals. While enunciating the first principles which must be borne in mind, the Bombay High Court in paras 21 and 22 held as follows:*
>
> > *"21. This Court in the decision of Boots Company Plc. England (supra) after considering various judgments held that there are three tests which have to be considered for deciding the question whether the trade mark is deceptively similar to the other mark or not and they are:-*
> >
> > *(1) The mark has to be considered as a whole,*
> > *(2) It is a question of first impression and*
> > *(3) The question has to be considered from the view point of a man of average intelligence.*
> >
> > *22. The Delhi High Court in Win-Medicare Pvt. Ltd(supra) after considering the relevant decisions on the question of misrepresentation or deception between two trade marks held that following Rules of Comparison can be culled out from various pronouncements of the Courts from time to time:*
> >
> > *I. Meticulous Comparison not the correct way.*
> > *II.Mark must be compared as a whole*
> > *III. First Impression.*
> > *IV. Prima Facie view not conclusive.*
> > *V. Structural Resemblance.*
> > *VI. Similarity in Idea to be considered."*
>
> *61. The test of "exacting judicial scrutiny", when we are called upon to deal with medicinal products was reiterated and re-affirmed as would be evident from para 23:*
>
> > *23. The Supreme Court in the decision between Milment Oftho Industries (supra) after reviewing the law on the subject held as follows:*
> >
> > *"8. In respect of medicinal products it was held that exacting judicial scrutiny is required if there was a possibility of confusion over marks on medicinal products because the potential harm may be far more dire than that in confusion over ordinary consumer products. It was held that even though certain products may not be sold across the counter,*

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> *nevertheless it was not uncommon that because of lack of competence or otherwise that mistakes arise specially where the trade marks are deceptively similar. It was held that confusion and mistakes could arise even for prescription drugs where the similar goods are marketed under marks which looked alike and sound alike. It was held that physicians are not immune from confusion or mistake. It was held that it was common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently the handwriting is not legible. It was held that these facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike.*
>
> *(Emphasis added)*

62. After noticing the decision in Cadila Healthcare, the Bombay High Court culled out the following principles:

> *"25. The principles which are emerging from the decisions set out hereinabove are summarised in the following manner:*
>
> > *(a) When a particular medicinal or a pharmaceutical product is involved as the impugned trade mark which may deceive the public or cause a confusion with respect to another trademark, it is the Court's primary duty to take utmost care to prevent any such possibility of confusion in the use of trademarks.*
> >
> > *(b) Confusion in case of a non-medicinal or a nonpharmaceutical product may only cause economic loss to the person, but on the other hand, a confusion in terms of medicinal or a pharmaceutical product may have disastrous effect on the health. Hence, it is proper to require a lesser quantum of proof of confusing similarity for such products.*
> >
> > *(c) The Court may not speculate as to whether there is a probability of confusion between the marks. Mere existence of the slightest probability of confusion in case of medicinal product marks, requires that the use of such mark be restrained.*
> >
> > *(d) While arriving at a conclusion with respect to the similarity and confusion between medicinal products, the same should be examined from the point of view of an ordinary common man of average intelligence instead of that of a specialised medicinal practitioner. Courts must decide the same from the view point of*

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man with average intelligence considering multiple factors such as the first impression of the mark, salient features of both the products, nature of the commodity, overall similarity and the possibility of the same creating a confusion amongst the public at large.

(e) The primary duty of the Court is towards the public and the purity of the register. Duty of the Court must always be to protect the public irrespective of what hardship or inconvenience it may cause to a particular party whose trade mark is likely to deceive or cause confusion.

(f) The following rules of comparison can be culled out from various pronouncement of Court from time to time.

(i) Meticulous comparison is not the correct way.
(ii) Mark must be compared as whole.
(iii) First impression.
(iv) Prima facie view is not conclusive.
(v) Structural resemblance.
(vi) Similarity in idea to be considered.

(g) The main object of maintaining trade mark register is that the public should know whose goods they are buying. It is therefore essential that the register should not contain the trade mark which is identical by which purchaser may likely to be deceived by thinking that they are buying the goods of a particular company/industry whereas he is buying the goods of another company/industry."

32. On applying the aforesaid tests to the marks in question before me, I am of the view that the Defendant's impugned mark "XIGAMET" is deceptively similar to the Plaintiff's registered trademark "ZITA-MET". Firstly, both the marks are word marks. The two work marks are phonetically similar. They are structurally similar as they contain the same number of letter and syllables. Both the

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marks are used in respect of the same kind of products. This, by itself, makes the Defendants' impugned mark deceptively similar to the Plaintiff's trade mark.

33. Further, as held by the Supreme Court in **Cadila Health Care Ltd.** (supra), a stricter approach has to be adopted while applying the test of deceptive similarity to judge the possibility of confusion of one medicinal product from another by the consumer as, while the confusion in the case of non medicinal products may only cause economical loss to the Plaintiff, confusion between two medicinal products may have disastrous effects on health, and, in some cases, on life itself. Further, as held by this Court in the case of **Macleods Pharmaceuticals Ltd.** (supra) and as referred to by the Delhi High Court in **Glenmark Pharmaceuticals Ltd.** (supra), when a particular medicinal or a pharmaceutical product is involved as the impugned trade mark which may deceive the public or cause a confusion with respect to another trade mark, it is the Court's primary duty to take utmost care to prevent any such possibility of confusion in the use of trademarks, as a confusion in terms of medicinal or pharmaceutical products may have disastrous effects on the health of the consumer. Hence, it is proper to require a lesser quantum of proof of confusing

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similarity for such products. The Court is not to speculate as to whether there is a probability of confusion between the marks. Mere existence of the slightest probability of confusion in case of medicinal product marks requires that the use of such mark be restrained. Keeping these tests in mind, by virtue of the fact that the word mark "XIGAMET" of the Defendant is phonetically and structurally similar to the word mark "ZITA-MET" of the Plaintiff and the two marks are used on medicinal products, in my view the injunction sought by the Plaintiff in respect of Defendant's mark is required to be granted. There can be no doubt that there is a probability of confusion in respect of both these marks.

34. Further, as held by this Court and the Delhi High Court, while arriving at a conclusion with respect to the similarity and confusion between medicinal products, the same should be examined from the point of view of an ordinary man of average intelligence instead of that of a specialized medicinal practitioner.

35. In my view, viewed from this angle, the mark "XIGAMET" of the Defendant is deceptively similar to the trademark "ZITA-MET" of the Plaintiff. The ordinary common man of average intelligence who would go to buy medicines is definitely going to be confused between

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the two marks and this is one more reason as to why the ad-interim injunction sought by the Plaintiff ought to be granted.

36. For the aforesaid reasons, I am of the view that the Defendants' mark "XIGAMET" is deceptively similar to the Plaintiff's trade mark "ZITA-MET" and the Plaintiff is entitled to the ad-interim injunction sought by it.

37. As far as the defence of the Defendants is concerned, the Defendants have raised a defence that the present Suit filed by the Plaintiff is an abuse of the process. I am unable to accept the said submission of the Defendants. The present Suit has been filed by the Plaintiff for infringement of its trademark in the exercise of its statutory right as a proprietor of a registered trademark under the TradeMarks Act. As far as the proceedings before the Srinagar Court are concerned, the Srinagar Court has passed an Order dated 19th February 2024 wherein it has observed that its Order shall be subject to any Order as may be passed by this Court. Therefore, the proceedings in the Srinagar Court do not come in the way of the Plaintiff filing this Suit and seeking ad-interim and interim reliefs therein. Even otherwise, there is no restriction on the Plaintiff which prevents it from filing the present Suit and seek an injunction against

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the Defendants in the present Suit and Interim Application. Therefore, there is no question of any abuse of the process of this Court. Further, the Defendants' submission that it is not carrying on business in Mumbai, i.e. within the territorial jurisdiction of this Court, is incorrect, is borne out by the Defendants' own admission in paragraph 8 of their Affidavit in Reply that Defendant No.1 has its registered office at Goregaon, Mumbai. In my view, therefore, the Defendants' contentions in this regard have no merit.

38. It was also the contention of Defendant No.1 that it would not have filed a trademark application if it intended to dishonestly adopt the impugned trademark. This contention was raised for the first time in the oral submissions and has not been raised in the Defendant's Affidavit in Reply. Further, Defendant No.1 has failed to show as to how the act of merely filing the impugned trademark application displays any honesty in the adoption of the impugned trademark. In my view, the said contention of the Defendants has no merits.

39. In this context, it should be noted that the Defendants' have not given any explanation for adoption of the impugned mark XIGAMET. There is no whisper in the Affidavit in Reply as to why the Defendant decided to use the term XIGA. In fact, in the counter statement filed by the Defendant before the TradeMarks Registry, the

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Defendant has given a frivolous explanation for adopting the term XIGA by stating that it had been adopted from a philosophical background in which XIGA meant compassionate. In my view, the fact that the Defendants have failed to give any proper explanation for adopting the mark XIGAMET clearly shows that it was the intention of the Defendants to adopt a mark deceptively similar to ZITA-MET of the Plaintiff.

40. It was submitted by the Defendants that it had come to the knowledge of Defendant No.1 that there is a third party product in the mark under the name SITAMET which contains sitagliptin. Defendant No.1 also tendered a print out of the alleged listing of SITAMET. Again, it can be seen that the Defendants have not raised this contention in their Affidavit in Reply. Even otherwise, the mere presence / availability of this one product in the market is not sufficient. It is a settled principle of law that to show a mark is common to the trade, a party must produce substantial evidence to show actual extensive use of the mark by third parties even at the interlocutory stage. A mere presence of a testing on the internet, as is shown by the Defendants, is insufficient to suffice the test laid down by the Courts. For this reason, I am unable to accept the said defence raised by the Defendants.

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41. The next contention of the Defendants is that the strip / packaging of the Plaintiff's goods and the Defendants' goods is very dissimilar and, therefore, the Defendants' mark is not deceptively similar to the Plaintiff's mark.

42. A Division bench of this Court in ***Medley Laboratories (P) Ltd., Mumbai and Ors. vs. Alkem Laboratories Limited***[8] has observed that once the Court concludes that the rival trademarks are deceptively similar, the other factors, viz., the packing being different, number of tablets contained in the competing packaging is not the same, prices are not identical and/or the goods being sold on doctor's prescription are altogether irrelevant and immaterial. Further, the Supreme Court in **Cadila Health Care Ltd. vs. Cadila Phamaceuticals Ltd.** (Supra) has observed that, if the essential features of the trademark of the Plaintiff have been adopted by the Defendant, the fact that the get-up or packaging or writing on the goods or packets in which the Defendant offers its goods for sale shows marked difference or indicates a clearly different trade origin, different from that of the registered proprietor of the mark , would be immaterial. In my view, in the light of the said law laid down by this Court and the Supreme Court, the said

8 (2002) SCC OnLine Bom 425

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submission of the Defendant regarding the strip / packaging of the goods being dissimilar cannot be accepted.

43. Another argument made by the Defendants is that there was no reason for any confusion amongst the consumers because the Plaintiff's and Defendant's goods are prescription medicines (Schedule-H drugs) and not something that can be sold over the counter. This submission of the Defendants also cannot be accepted. In ***Medley Laboratories (P) Ltd.,*** (Supra), the Court has taken judicial notice of the fact that prescriptions have lost their significance in India and Schedule-H drugs, which must be sold only on a prescription, are being sold over the counter, without prescriptions.

44. Further in **Cadila Health Care Ltd.** (Supra), the Supreme Court and this Court have held that it is a settled principle of law that physicians, doctors and chemists are not immune to confusion or mistake. It is also common knowledge that consumers often place order for prescription drugs with chemists over the phone and that often the hand written prescriptions are difficult to read. These factors enhance the likelihood of confusion and deception by the chemists and physicians especially in facts such as the present case where the rival trade marks are phonetically and structurally deceptive similar. As stated hereinabove, stricter standards must be involved in the

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present case. Physicians and pharmacists are generally knowledgeable in their field, however they are not infallible, and in respect of medicinal and pharmaceutical products there cannot be any leeway for mistakes, since even a possibility of a mistake may prove fatal to the consumers. For all these reasons, the Defendants' submission that no confusion would be caused between the Plaintiff's and the Defendant's goods because they are prescription medicines, cannot be accepted.

45. The next submission of the Defendants is that the rival products are meant for the same ailment i.e. for diabetes. However, the product of the Plaintiff is a brand of teneligliptin which is altogether a different class of drug as compared to the product of Defendant No.1, which contains glimperpride which belongs to the class of drugs called sulfonylurea, and hence, there is no question of any confusion between the goods of the Plaintiff and the Defendants.

46. This submission of the Defendants also cannot be accepted. It is a matter of record that both the Plaintiff's goods bearing the trademark ZITA-MET and the Defendants' goods bearing the trade mark XIGAMET are anti-diabetic preparations that are used for treating the same ailment. According to Defendant No.1 itself, the Plaintiff's goods bearing the trademark ZITA-MET containing the

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molecule sitagliptin and the Defendants' goods bearing the trademark XIGAMET containing the molecule teneligliptin are both different class of drugs and that at the molecular level these medicines are very different from each other. In my view, any confusion or deception between the drugs sold by the Plaintiff under the trade mark ZITA-MET containing the molecule sitagliptin and the Defendants' goods bearing the trademark XIGAMET containing the molecule teneligliptin could potentially cause harmful side effects on the consumers and / or lead to other disastrous consequences. For these reasons, the test in respect of deceptively similar is to be most strictly applied in the case of the said goods. In this context, it would be relevant to refer to the relevant extract from the judgement of the Supreme Court in **Cadila Health Care Ltd. vs. Cadila Phamaceuticals Ltd.** (Supra) which reads as under:

> *"25. The drugs have a marked difference in the compositions with completely different side effects, the test should be applied strictly as the possibility of harm resulting from any kind of confusion by the consumer can have unpleasant if not disastrous results. The courts need to be particularly vigilant where the defendants drug, of which passing off is alleged, is meant for curing the same ailment as the plaintiffs medicine but the compositions are different. The confusion is more likely in such cases and the incorrect intake of medicine may even result in loss of life or other serious health problems. In this regard,*

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> *reference may usefully be made to the case of Glenwood Laboratories, Inc. Vs. American Home Products Corp., 173 USPQ 19(1972) 455 F.Reports 2d, 1384(1972), where it was held as under:*
>
> > *"The products of the parties are medicinal and applicants product is contraindicated for the disease for which opposers product is indicated. It is apparent that confusion or mistake in filling a prescription for either product could produce harmful effects. Under such circumstances, it is necessary for obvious reasons, to avoid confusion or mistake in the dispensing of the pharmaceuticals."*

47. As far as various judgements relied upon by the Defendants are concerned, in the light of the law laid down by the Supreme court in **Cadila Health Care Ltd.** (Supra), the same do not take the case of the Defendants any further.

48. In the light of the aforesaid discussion, and for the aforesaid reasons, there will be ad-interim relief in favour of the Plaintiff in terms of prayer (a) of the Interim Application.

49. In the facts and circumstances of the case, there will be no order as to costs.

(FIRDOSH P. POONIWALLA, J.)

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