

\$~102 (Original)

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ CS(COMM) 75/2023

GLAXO GROUP LIMITED Plaintiff
Through: Mr. Urfee Roomi, Ms. Janaki
Arun, Mr. Alvin Antony and Mr. Anubhav
Chhabra, Advs.

Versus

MAIDEN PHARMACEUTICALS LIMITED Defendant
Through: Mr. Inderdeep Singh and Mr.
Chander Shekhar Patney, Advs.

CORAM:
HON'BLE MR. JUSTICE C.HARI SHANKAR

JUDGMENT(ORAL)

% **06.04.2023**

I.A. 2642/2023 (Order XXXIX Rules 1 and 2 of the CPC)

1. The plaintiff asserts the marks BETNESOL and BETNOVATE, which stand registered under the Trade Marks Act, 1999 in its favour with effect from 21st February 1961 and 5th December 1963 respectively.

2. The plaintiff alleges that the defendant, by using the marks BETASON, BETNOMAID and MEDNOVATE, is infringing the aforesaid registered trademarks of the plaintiff, within the meaning of Section 29(2)(b)¹ of the Trade Marks Act.

¹ 29. **Infringement of registered trade marks. –**

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark;

is likely to cause confusion on the part of the public, or which is likely to have an association with

3. The active pharmaceutical ingredient (API) in all these five products, it may be noted is betamethasone. BETNESOL contains betamethasone alone, whereas BETASON, BETNOVATE, BETNOMAID and MEDNOVATE contain betamethasone with neomycin. Betamethasone is a corticosteroid.

4. BETNOVATE, BETNOMAID and MEDNOVATE are skin creams, though BETNOMAID is also available in the form of eye/ear drops. BETNESOL and BETASON are dispensed as tablets and as eye and ear drops.

Rival Contentions

5. Petitioner's submissions

5.1 Mr. Urfee Roomi, learned Counsel for the plaintiff, submitted that the defendant's marks BETASON, BETNOMAID and MEDNOVATE are phonetically similar to the plaintiff's corresponding marks BETNESOL and BETNOVATE. He submits that, owing to the common letters "BET" and "SO", the names BETASON and BETNESOL are phonetically similar. He also relies, in this context, that on the fact that each of these words comprises three syllables and that the first syllable is the same, i.e. "BET" and the third syllable in each of the words "SON" and "SOL" are phonetically similar.

5.2 Apropos the defendant's marks BETNOMAID and MEDNOVATE, Mr. Roomi submits that the defendant has, craftily,

as he would put it, dissected the plaintiff's BETNOVATE mark and used the first five letters of the mark i.e. "BETNO", as the first five letters of the mark BETNOMAID and the last six letters of the mark "NOVATE" as the last six letters of the mark MEDNOVATE. BETNOMAID and MEDNOVATE contain the same chemical constituents as BETNOVATE, i.e. betamethasone and neomycin and, in thus partly copying the plaintiff's BETNOVATE mark in one and partly in another, Mr. Roomi submits that bad faith on the part of the defendant is transparently apparent.

5.3 As the products in question are pharmaceutical preparations, Mr. Roomi submits that his client is entitled to an interlocutory injunction against the use, by the defendant, of the impugned BETASON, BETNOMAID and MEDNOVATE marks, pending disposal of the suit.

6. Defendant's submissions in reply and findings thereon

6.1 Preliminary objections:

6.1.1 Responding to the submissions of Mr. Roomi, Mr. Inderdeep Singh on behalf of the defendant raised a preliminary objection based on the Power of Attorney that the plaintiff has placed on record, which authorises the plaintiff to institute the plaint. He submits that the authorization granted to the plaintiff to sue the defendant Maiden Pharmaceuticals Limited refers only to the plaintiff's marks BETNESOL and BETNOVATE and makes no reference to the defendant's marks. The relevant paras 1 and 2 of the said authorisation may be reproduced thus.

“1. To represent the Company in civil proceedings, including appeals, instituted by the Company against Maiden Pharmaceuticals Limited (hereinafter "MPL"), a company incorporated under the provisions of the Companies Act, 1956 and any other individuals, companies or entities that are related or affiliated to the abovenoted individuals, companies or entities that are related or affiliated to MPL in an action against the adoption and use of a mark identical/ similar to the Company's BETNESOL and BETNOVATE marks and/or packaging before any courts/tribunals in India.

2. To institute, initiate, file, defend or pursue any civil proceeding, including appeals, on behalf of the Company, against Maiden and any other individuals, companies or entities that are related or affiliated to Maiden in an action against the adoption and use of a mark identical/ similar to the Company's BETNESOL and BETNOVATE marks and/or packaging before any legal forum in the territory of India, including District Courts, High Courts and the Supreme Court of India.”

6.1.2 There is obviously no substance in this contention. A plain reading of paras 1 and 2 of the authorisation, authorising the plaintiff to institute the present suit, clearly states that the suit could be instituted against the defendant in respect of marks which are identical/similar to the plaintiff's BETNESOL and BETNOVATE marks. The present suit alleges, precisely, that the defendant's marks BETASON, BETNOMOID and MEDNOVATE infringe the plaintiff's BETNESOL and BETNOVATE marks, being deceptively similar thereto. The cause of action in the suit is, therefore, clearly covered by the authorization contained in the Power of Attorney. This preliminary objection of Mr. Inderdeep Singh is, therefore, rejected.

6.1.3 Mr. Singh further submits that though it is alleged, in para 24 of the plaint, that the plaintiff had coined the term BETNOVATE several decades earlier, the identity of the person who coined the mark is not disclosed. The identity of the person who coined the mark asserted by the plaintiff is irrelevant to the issues of infringement and passing off. As such, the said submission, as a defence to the case set up by the

plaintiff, is also without substance.

6.2 Apropos the actual aspect of infringement, Mr. Inderdeep Singh has drawn my attention to paras, 21, 22 and 24 of the Preliminary Objections, and para 6 of the ‘Reply On Merits’ contained in the written statement filed by the defendant by way of response to the plaint. Para 6 sets out a number of registered marks of pharmaceutical preparations starting with “BETA”, para 22 sets out a list of twenty-one registered marks which use “NOVATE” either as the former or the later part of the mark and para 24 gives a list of three registered marks which commence with MEDNOV, i.e. MEDNOVIT, MEDNOVIT CD3 and MEDNOVIS. Predicated thereon, Mr Singh would contend that the prefixes BETA and MEDNOV, as also the suffix NOVATE, are common to the pharmaceutical trade within the meaning of Section 17(2)(b)² of the Trade Marks Act and that, therefore, the plaintiff can claim no exclusivity therein.

6.3 Mr Singh’s submission is, *prima facie*, without substance. Paras 6, 21, 22 and 24 merely set out the details of marks which are stated to be figuring in the register of trademarks. No details, regarding the actual use of the said marks, the extent to which they are used or the market that they command, are forthcoming. It is often seen that the defendant, in trademark infringement suits, provides lists of marks available in the register of trademarks to make out a case of

² 17. **Effect of registration of parts of a mark.**—(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.
(2) Notwithstanding anything contained in sub-section (1), when a trade mark—
(a) contains any part—
(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or
(ii) which is not separately registered by the proprietor as a trade mark; or
(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,
the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

commonality of use of the marks. No such principle is known to trademark law. Section 17 of the Trade Marks Act proscribes claims of exclusivity if a mark or a part of the mark is *common to the trade*. The mere presence of the marks in the register of the trademarks does not make out a case of the marks being common to the trade. The nature of “the trade”, if any, in the marks that stand registered, and cited by Mr Singh, is not forthcoming. The following passages from a judgment of the Division Bench of this Court in ***Pankaj Goel v. Dabur India Ltd.***³ neatly encapsulate the legal position in this regard:

“21. As far as the Appellant's argument that the word MOLA is common to the trade and that variants of MOLA are available in the market, we find that the Appellant has not been able to prima facie prove that the said ‘infringers’ had significant business turnover or they posed a threat to Plaintiff's distinctiveness. In fact, we are of the view that the Respondent/Plaintiff is not expected to sue all small type infringers who may not be affecting Respondent/Plaintiff business. The Supreme Court in ***National Bell v. Metal Goods***⁴, has held that a proprietor of a trademark need not take action against infringement which do not cause prejudice to its distinctiveness. In ***Express Bottlers Services Pvt. Ltd. v. Pepsi Inc.***⁵, it has been held as under:—

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

³ 2008 (38) PTC 49 (DB)

⁴ (1970) 3 SCC 665: AIR 1971 SC 898

⁵ (1989) 7 PTC 14

infringers...”

22. In fact, in *Dr. Reddy Laboratories v. Reddy Paharmaceuticals*,⁶ a Single Judge of this Court has held as under:—

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

(Emphasis supplied)

6.4 In the absence of any material regarding the actual use, in the mark, of the marks enlisted in paras 6, 12, 22 and 24 of the written statement, the averments contained in the said paragraphs cannot make out that even a *prima facie* case that any part of the plaintiff’s marks, that it asserts in the suit, are common to the trade.

6.5 Apropos the marks themselves, Mr. Inderdeep Singh seeks to justify their use by stating that (i) the mark BETNOMAID is a portmanteau of “BETNO” and “MAID”, of which the first part, i.e. “BETNO” is taken from the API betamethasone and “MAID” is an abbreviation of the defendant’s company name Maiden Pharmaceuticals Limited, (ii) the mark MEDNOVATE is a portmanteau of “MED” and “NOVATE” of which “MED” is an abbreviation for “medicine” and “NOVATE” is an abbreviation for “innovate” and (iii) the name BETASON is a portmanteau of the first and last parts of “betamethasone”, merely omitting the central “METH” part of the name.

⁶ (2004) 29 PTC 435

6.6 Mr. Inderdeep Singh has also placed reliance on para 38 of the recent judgment of Division Bench of this Court in *Sun Pharmaceutical Laboratories Ltd. v. Hetero Healthcare Ltd.*⁷, which reads thus:

“38. In the case of *Panacea Biotec Ltd. v. Recon Ltd.*⁸, the plaintiff was using the trademark ‘NIMULID’ and had filed a suit for injunction against the defendant for using the mark ‘REMULIDE’ in relation to the same medicine with the API being ‘NIMESULIDE. This Court held that when the name is derived or coined from the name of the principal ingredient being used in the manufacture of the drug, no distinctiveness or exclusiveness can be claimed by the manufacturer. The said decision is applicable to the facts of this case as well; the mark ‘LETROZ’ is nothing but a short name of the active ingredient ‘LETROZOLE’.”

6.7 Mr. Roomi in rejoinder reiterates the submissions advanced by him in his initial address and also placed reliance on para 26 of *Sun Pharmaceuticals*⁷. He submits that the manner in which the defendant has coined the words MEDNOVATE and BETNOMOID clearly discloses bad faith and attempt to copy the plaintiff and ride upon its goodwill. As such, he submits that a clear case for grant of injunction is made out.

6.8 Having heard learned Counsel and applied myself to the material on record in the light of the extant law, I am not convinced, *prima facie*, that the mark BETASON infringes the mark BETNESOL. To my mind, it would be stretching phonetics a trifle too far to treat the said marks as phonetically similar. While dealing with the marks EXITOL and OXETOL, a Division Bench of this Court, in *Sun Pharmaceutical Industries Ltd. v. Anglo French Drugs and Industries Ltd.*⁹, cautioned against stretching the principle of phonetic similarity too far. Excluding the common TOL suffix, the

⁷ 2022 SCC OnLine Del 2580

⁸ 1996 SCC OnLine Del 508

⁹ (2014) 215 DLT 493 (DB)

Division Bench was of the view that the first parts of the mark, EXI and OXE, could not be regarded as phonetically similar. To my mind, it would only be by a strained and unnatural effort that one would pronounce BETASON similarly to BETNESOL. Neither is the opening BET, nor is the concluding SON/SOL, in the two names, pronounced similarly. There is a clear difference in the way in which BETA and BETNE are intoned. What is required, for phonetic similarity to constitute a basis to return a finding of infringement, is *proximate*, not *remote* phonetic similarity. There are ways and ways of pronouncing words, especially proper nouns. What the Court has to assess is whether, as *ordinarily pronounced*, the rival marks are, phonetically, confusingly or deceptively similar. Thus tested, I find it difficult to accept that BETASON is phonetically similar to BETNESOL.

6.9 That apart, there is, *prima facie*, merit in Mr. Inderdeep Singh's contention that BETASON is a mere abbreviation of the API betamethasone. While the entitlement of an abbreviation to registration may be questionable, there is no legal embargo on a manufacturer using an abbreviation of the API in a pharmaceutical preparation as the name of the preparation. Indeed, Courts have, in several decisions, noted the practice of pharmaceutical companies to use, as parts of the marks of pharmaceutical products, the names of the constituents of the preparation, the organ which it intends to treat as well as the ailment that it intends to address¹⁰.

6.10 That apart, "BETA", or "BET", constitute a part of the name of the API betamethasone. It is common to both names and would,

¹⁰ Refer *AstraZeneca UK Ltd. v. Orchid Chemicals & Pharmaceuticals Ltd.*, (2007) 34 PTC 469 and *Schering Corporation v. Alkem Laboratories Ltd.*, (2010) 42 PTC 772

therefore, ordinarily be required to be excluded from consideration while assessing phonetic similarity, applying the law laid down in *AstraZeneca*¹⁰ and *Schering Corporation*¹⁰. Excluding BETA and BET, SON cannot, in my view, be regarded as phonetically similar to NESOL.

6.11 Phonetic similarity being the only ground canvassed by Mr. Roomi, I am not inclined, *prima facie*, to grant any injunction against use of the mark BETASON.

6.12 Insofar as marks BETNOMAID and MEDNOVATE are concerned, however, I find substance in Mr. Roomi's submission that the defendant appears to have broken up the plaintiff's mark BETNOVATE and use the first five letters "BETNO" as the first half of BETNOVATE and the last six letters "NOVATE" as the second half of the mark MEDNOVATE. Mr. Inderdeep Singh's contention that, in MEDNOVATE, MED is an abbreviation for "MEDICINE" and NOVATE for "INNOVATE" is, in my view, too facile to *prima facie* pass muster.

6.13 Even if it were to be assumed that the second half of the name BETNOMAID i.e. MAID, is an abbreviation of the defendant's company name Maiden Pharmaceutical Ltd, there is no explanation for the use of the first half "BETNO". As Mr. Roomi correctly points out that there is a difference between the use of the mark "BETA" and "BETNO". "BETNO" cannot be treated as an abbreviation of "betamethasone". In using the prefix BETNO in BETNOMAID, therefore, the defendant does appear, *prima facie*, to have drawn inspiration from the use of BETNO by the plaintiff in BETNOVATE. This is, by itself, *prima facie* sufficient to evidence an intent to copy.

6.14 A juxtaposed appreciation of the impugned marks BETNOM AID and MEDNOVATE *vis-à-vis* the plaintiff's mark BETNOVATE, therefore, indicates, *prima facie*, an intent to copy the main features of the mark BETNOVATE. In such circumstances, the following exordiums from the decisions of Kekewich, J. in *Munday v. Carey*¹¹ and of the Lindley, LJ, *Slazenger & Sons v. Feltham & Co*¹² would apply:

*Munday*¹¹:

“Where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity.”

*Slazenger*¹²:

“One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?”

In *Munday*¹¹, Kekewich, J. held that where there was an intent to confuse, and the mark of the defendant was a copy of the mark of the plaintiff, one had to concentrate more on similarities rather than on dissimilarities. *Slazenger*¹² extrapolated the principle by holding that, where the defendant had strained every nerve to make his mark as similar to the plaintiff's mark as would deceive the consumer, the court would presume that the attempt was successful rather than unsuccessful.

¹¹ (1905) 22 R.P.C. 273

¹² (1889) 6 RPC 531

6.15 There is, therefore, *prima facie*, substance in Mr. Roomi's contention that the marks BETNOMAID and MEDNOVATE deserve to be injuncted.

6.16 The contention of Mr. Inderdeep Singh that the marks have been in use for a long time cannot aid the defendant. Delay *per se* cannot defeat a claim for injunction, where infringement is found to exist, as held in *Midas Hygiene Industries P. Ltd. v. Sudhir Bhatia*¹³ and *Laxmikant V. Patel v. Chetanbhai Shah*¹⁴ which also hold that, where a case of infringement is found to exist, an injunction should follow as a matter of course.

Conclusion

7. The defendant as well as all others acting on its behalf shall stand restrained from using, in any manner, the marks BETNOMAID and MEDNOVATE, or any other mark deceptively similar to the plaintiff's marks, in respect of any pharmaceutical preparations, pending disposal of the present suit. However, as the products in question are pharmaceutical preparations, the defendant shall be entitled to clear and sell the products if any lying in their premises as on date within a period of four weeks from today. For this purpose, the defendant shall also file a statement of the stock of BETNOMAID and MEDNOVATE preparations lying in their premises, factories/godowns and other premises, on affidavit, within a period of one week from today.

8. The prayer for injunction in respect of the marks BETNOMAID

¹³ (2004) 3 SCC 90

¹⁴ 2002 3 SCC 65

and MEDNOVATE stands allowed in the aforesaid terms.

9. However, the Court is not inclined to grant any injunction in respect of the mark BETASON. To that extent, the application is rejected.

10. IA 2642/2023 is partly allowed in the aforesaid terms.

C.HARI SHANKAR, J

APRIL 6, 2023

rb

