

2022 LiveLaw (Del) 258

IN THE HIGH COURT OF DELHI AT NEW DELHI

Prathiba M. Singh, J.

CS(COMM) 192/2022 & I.As. 4838-40/2022; 30th March, 2022

MANKIND PHARMA LIMITED *versus* TATA MEDICAL AND DIAGNOSTICS LIMITED

Trade Marks Act, 1999; Section 29(2) and 29(3) - The High Court has refused to pass an ad interim injunction against Tata Medical and Diagnostics Limited, manufacturer of 'OMISURE', an RTPCR kit used for detecting COVID-19 Omicron variant. The medicinal preparations sold by the Plaintiff Mankind Pharma under the mark 'OMIPURE' formulations containing the chemical compound "Omeprazole" which are used as antacids, anti-reflux agents, and anti-ulcerants. The Defendant's product being a RT-PCR test kit to test Omicron variant of the Covid-19 is claimed to be a breakthrough innovation which has been developed in India. The sale of the test kit would be required to test samples for omicron variant of Covid-19 on a day-to-day basis. Any interdicting by the Court, at this stage, would be contrary to the interest of the patients and the public who are suffering from Covid-19. While the phonetic similarities between these two marks is clearly perceptible, the present case would not be one for an ad-interim injunction. This is due to the fact that the RT-PCR test kits 'TATA MD CHECK RT-PCR OMISURE' would not be confused in any manner with the 'Omeprazole' tablets or capsules of the Plaintiff sold under the mark 'OMIPURE'.

Plaintiff through: Mr. Amit Sibal, Sr. Advocate with Mr. Hemand Daswant, Mr. Aviral Shukla, Mr. Piyush Arora, Mr. Aishvarg Vikram & Mr. Saksham Dhingra, Advocates. Defendant through: Mr. Rajiv Nayar, Sr. Advocate with Mr. Saikrishna Rajagopal, Mr. Sidharth Chopra, Ms. Aakanksha Munjhal, Ms. Anjali Agrawal & Ms. Manjira Dasgupta, Advocates.

1. This hearing has been done through hybrid mode.

I.A. 4839/2022(for exemption)

2. Allowed, subject to all just exceptions. *I.A. 4839/2022* is disposed of.

I.A. 4840/2022 (u/S 12A)

3. This is an application seeking exemption from instituting pre-litigation mediation. In view of the orders passed in **CS (COMM) 132/2022 titled ***Upgrad Education v. Intellipaat Software***, exemption is allowed.**

4. *I.A. 4840/2022* is allowed and disposed of.

CS (COMM) 192/2022

5. Let the plaint be registered as a suit.

6. Issue summons in the suit and notice in the application to the Defendant through all modes upon filing of Process Fee. Mr. Siddharth Chopra, Id. counsel accepts summons for the Defendant.

7. The summons to the Defendant shall indicate that a written statement to the plaint shall be positively filed within 30 days from date of receipt of summons. Along with the written statement, the Defendants shall also file an affidavit of admission/denial of the documents of the Plaintiff, without which the written statement shall not be taken on

record.

8. Liberty is given to the Plaintiff to file a replication within 15 days of the receipt of the written statement(s). 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 any documents, the same shall be sought and given within the timelines.

9. List before the Joint Registrar for marking of exhibits on 24th May, 2022. It is made clear that any party unjustifiably denying documents would be liable to be burdened with costs.

10. List before Court on 29th July, 2022.

I.A. 4838/2022(u/O XXXIX R 1 & 2CPC)

11. The Plaintiff- Mankind Pharma Limited has filed the present suit seeking permanent injunction for infringement of trademark, rendition of accounts, delivery up, damages, etc. The Plaintiff claims to be the 5th largest pharmaceutical company in India with a large range of medicinal and pharmaceutical preparations. In the present suit, the Plaintiff seeks to protect its registered trademark 'OMIPURE' bearing registration no. 1588335 dated 8th August, 2007 which was adopted by the Plaintiff in the year 2007. The said registration is under class 5 in respect of pharmaceutical and medicinal preparations. The registration is valid and subsisting in the name of the Plaintiff. It is not in dispute that the Plaintiff sold products under the trademark 'OMIPURE' from 2007 till 2012. However, it is also admitted by the Plaintiff that there is a gap of 9 years between 2012 to 2021 when there was no sale under the mark 'OMIPURE'. Post 2012, sales under the mark 'OMIPURE' have been resumed by the Plaintiff only in 2021-2022. The medicinal preparations sold by the Plaintiff under the mark 'OMIPURE' formulations containing the chemical compound "Omeprazole" which are used as antacids, anti-reflux agents, and anti-ulcerants.

12. The grievance of the Plaintiff in the present case is that in January, 2022, it came across certain material on the internet, including advertisements and newspaper articles, that the Defendant- Tata Medical and Diagnostics Ltd. intends to launch RT-PCR test kits under the trademark 'OMISURE' for detection of the Omicron variant of Covid-19. The Plaintiff then addressed a cease-and-desist notice to the Defendant on 11th January, 2021 which is stated to have been delivered on 13th January, 2021 asking the Defendant to desist from using the mark 'OMISURE' and any other trade mark which are similar to the Plaintiff's mark 'OMIPURE' in relation to any medical testing kits, and medicinal and pharmaceutical perpetrations. However, no reply was received. Thereafter, the Defendant launched the RT-PCR testing kit under the trademark 'OMISURE'.

13. Mr. Sibal, Id. Sr. counsel appearing for the Plaintiff submits that 'OMIPURE' being a registered trademark under Class 5, the use of the mark 'OMISURE' for a diagnostic kit would be infringement of the Plaintiff's registered trademark under Section 29(2) of the Act as also under Section 29(3) of the Trade Marks Act, 1999. He further submits that apart from mere confusion on the part of the public, there is also a likelihood of 'Blurring' by association between the two products, inasmuch as the consuming public could get

an impression that the product under the mark 'OMISURE' is associated or related to the Plaintiff. It is submitted by the Id. Sr. counsel that the fact that cease-and-desist notice was not replied to by the Defendant and the product bearing the mark 'OMISURE' was launched shows that the Defendant had no respect for the registered proprietor's right in the mark 'OMIPURE'. It is submitted by Mr. Sibal, that the application of the test laid down in judgment of the Supreme Court in ***Cadila Healthcare Ltd. v. Cadila Pharmaceutical Ltd. 2001 (5) SCC 73*** would clearly lead to a conclusion that the Defendant's product/mark 'OMISURE' is likely to be confused with the mark 'OMIPURE' of the Plaintiff. Reliance is also placed upon ***Caterpillar Inc. vs Mehtab Ahmed and Ors. 99 (2002) DLT 678*** to argue the point of likelihood of blurring by association.

14. On the other hand, Mr. Rajiv Nayar, Id. Sr. counsel appearing for the Defendant submits that the trademark of the Defendant 'OMISURE' is derived from the Omicron variant of Covid-19 that the diagnostic kit detects. Diagnostic kits generally use the word 'SURE' as a suffix. The RT-PCR test kit has been launched by the Defendant which is a well known company- Tata Medical and Diagnostics Ltd., The product was approved by the ICMR on 28th December, 2021 with the name 'TATA MD CHECK RT-PCR OMISURE'. He submits that the product packaging has also been approved. He seeks to refute the issue of confusion raised by the Plaintiff by arguing that the said test kit is being used only at the point of first line testing i.e., laboratories and is not sold over the counter openly to customers. Mr. Nayar, Id. Sr. counsel, also seeks to emphasise that the sale figures of 'OMISURE' is Rs.21.38 crores in the last two months itself, since its launch. On the other hand, the Plaintiff's sales figure for the product under the mark 'OMIPURE' is only Rs.1.8 crores for the year 2021-2022. It is his submission that the mark of the Plaintiff does not enjoy any goodwill as there was a 9 year gap between 2012 to 2021 during which period no product of the Plaintiff was sold under the mark 'OMIPURE'.

15. Mr. Nayar submits that the mark 'TATA MD CHECK RT-PCR OMISURE' has to be read together and the word 'OMISURE' cannot be read in isolation. Further, there cannot be any monopoly over the word 'OMI', as the term 'OMI' has been derived from Omicron in the present case. He finally submits that Defendant has been supplying large volume of test kits across the country as also to the WHO. Thus, in public interest the sale of Defendant's product under the mark 'OMISURE' ought not to be restrained. Finally, the test laid down in ***Cadila v. Cadila (supra)*** is placed before the Court to argue that the present case would not be a fit case for grant of interim injunction.

16. Heard Id. Sr. counsels for both the parties. The undisputed fact in this case is that the Plaintiff is the registered proprietor of the mark 'OMIPURE'. However, a perusal of the registration of the Plaintiff makes it clear that the registration of the mark 'OMIPURE' is in respect of 'pharmaceutical and medicinal preparations' under class 5. Diagnostic kits/testing kits are not specifically included in the said registration and there is some doubt as to whether diagnostic kits would fall in the same class, i.e., class 5. As per the NICE classification, such kits would be covered in Class 10 which is a different Class altogether. In any event, the fact that diagnostic kits are associated with the field of medicine cannot be disputed. The Defendant's mark 'OMISURE' is for a RT-PCR kit which is used in laboratories for the purpose of detecting whether the omicron variant is

present in the swab sample or not. The test kit of the Defendant sold under the mark 'OMISURE' is of a specialised nature used in laboratories for diagnosing the Omnicron variant of Covid-19 and is not sold openly by chemists to the consuming public. On the other hand, the Plaintiff's product 'OMISURE' is used for the purpose of gastro-intestinal ailments.

17. A perusal of Section 29(2) of the Act shows that Section 29(2)(a),(b),(c) of the Act stipulates different varieties of confusion which can take place under Section 29(2) of the Act. If the trademarks are identical and the goods/services covered by the registered trademarks are also identical, then there is deemed confusion as per section 29(3) of the Act. However, in the present case, perusal of the two marks in question, i.e., 'OMIPURE' and 'OMISURE' shows that the marks are not identical. Moreover, pharmaceutical and medical preparations for which the Plaintiff's mark is registered is not the product for which the Defendant is using the mark i.e., diagnostic kits. Thus, this would not be a case of identical mark or identical goods.

18. The guidelines for establishing confusion and deception in medicines is laid down in **Cadila(supra)** which reads as under:

"42. 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 resemblance 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."*

19. The Court would have to test the present case, therefore, on the standard of degree of confusion and the likelihood of the same by comparing the factors set out above. In the opinion of this Court, the following are the broad differences between the two products and the marks:

- a) The Plaintiff's product is a capsule/tablet for gastro-resistant intestinal ailments which is sold across the counter and consumed directly by patients. But the Defendant's product is a RT-PCR test kit used for the detection of omicron variant of the Covid-19 in human swab samples, only by laboratories.
- b) The Plaintiff's product is sold across the counter to the customers whereas the Defendant's product is of a specialised nature used only in laboratories and is not sold over the counter to general public.
- c) Insofar as the good will and association argument raised by the Plaintiff is concerned, the fact that there have been no sales for a period of 9 years is quite telling inasmuch as dilution can only

be of a mark which is in extensive use and can be protected for dissimilar goods. However, that is not the case with 'OMIPURE'. The sale figures of the Defendant in the last two months or so show considerable volumes of high monetary value. The chances of blurring are thus negligible.

20. The Defendant's product being a RT-PCR test kit to test Omicron variant of the Covid-19 is claimed to be a breakthrough innovation which has been developed in India. The sale of the test kit would be required to test samples for omicron variant of Covid-19 on a day-to-day basis. Any interdicting by the Court, at this stage, would be contrary to the interest of the patients and the public who are suffering from Covid-19.

21. This is, however, not to say that the Defendant ought not to have conducted a search of the Trademark Register prior to adopting the mark 'OMISURE'. Such a search ideally ought to have been undertaken. But the factum of the search having not been conducted cannot automatically result in an injunction. Since, the trademark 'OMISURE' is now in use in full form as 'TATA MD CHECK RT-PCR OMISURE', and due to the factors set out above, this Court is of the opinion that the sale of the test kit for the purpose of diagnosis of the omicron variant of Covid-19 would not cause any confusion in the market or even association between the Defendant's product and the Plaintiff's mark.

22. This Court cannot stop but opine that Covid-19 is omnipresent and Courts are no exception. Disputes relating to trade marks and patents in respect of Covid-19 products have reached the doors of courts. In such cases, the Court has to strike a balance between the rights of the individual and the public interest and apply the law to the facts and circumstances of each case. While the phonetic similarities between these two marks is clearly perceptible, the present case would not be one for an ad-interim injunction. This is due to the fact that the RT-PCR test kits 'TATA MD CHECK RT-PCR OMISURE' would not be confused in any manner with the 'Omeprazole' tablets or capsules of the Plaintiff sold under the mark 'OMIPURE'.

23. In the overall facts and circumstances of the case, the following directions are issued:

i. Proper accounts shall be maintained by the Defendant of the sale of 'TATA MD CHECK RT-PCR OMISURE' test kits and the same shall be filed bi-annually by the Defendant in the form of an affidavit of a senior official duly authorised by a Board Resolution.

ii. If the Defendant intends to launch any RTPCR test kits or any other diagnostic kits for use in households and for sale across the counter in future, the Defendant would ensure that no mark which is identical similar/deceptively similar to 'OMIPURE' is used by it.

iii. The test kits under the name 'TATA MD CHECK RT-PCR OMISURE' may continue to be manufactured and sold subject to the above conditions.

24. These are only *prima facie* observations and shall not have any bearing on the final adjudication of the interim injunction application or the suit.

25. Reply to the application be filed within four weeks from the service of the present order along with the paper book. Rejoinder 4 week thereafter.

26. List the application before the Court on 29th July, 2022.