



2023:DHC:8618



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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ CS(COMM) 383/2023, I.A. 10923/2023, I.A. 19841/2023 &
I.A. 20256/2023

BHARGAVA PHYTOLAB PRIVATE LIMITED Plaintiff
Through: Mr. Varun Singh and Mr.
Tanvir Nayar, Advs.

versus

LDD BIOSCIENCE PRIVATE LIMITED Defendant
Through: Mr. Purvesh Buttan, Mr.
Prateek Narwar and Ms. Jaspreet Kaur,
Advs.

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

J U D G M E N T (O R A L)

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30.11.2023

I.A. 10923/2023 [under Order XXXIX Rules 1 and 2 of the CPC]

1. The plaintiff asserts its registered trademark TUMORIN. The mark stands registered in the plaintiff's favour with effect from 18 February 2011 in Class 5. Under the said mark, the plaintiff manufactures and sells homeopathic preparations intended to cure benign growths. Mr. Varun Singh, learned Counsel for the plaintiff candidly acknowledges that, though, while applying for registration of the mark TUMORIN, the plaintiff had claimed that the mark was in use by his predecessor in interest since 1 March 2010, there is, in fact, no actual evidence of such use forthcoming on record. The plaint,



however, does annex invoices evidencing use of TUMORIN by the plaintiff at least with effect from 4 April 2018. Mr. Varun Singh has also drawn my attention to a certificate dated 22 May 2023, issued by the plaintiff's Chartered Accountant, certifying that even in the financial year 2019-20, the returns from sales of TUMORIN exceeded ₹ 2 crores.

2. Mr. Varun Singh submits that the defendant is using a deceptively similar mark TUMOTIN for homeopathic preparations which are aimed at curing similar ailments. He also points out that the composition of TUMORIN and TUMOTIN is largely the same. The only difference between the two preparations, he submits, is that the plaintiff also claims that TUMORIN is safe for lactating mothers, whereas the defendant does not hold out any such claim. TUMOTIN, therefore, infringes TUMORIN. Inasmuch as the defendant was incorporated only on 31 October 2019, and is claiming user of the TUMOTIN mark only with effect from 10 June 2020, Mr. Varun Singh submits that the plaintiff, being a registrant of the TUMORIN mark with priority of user *vis-à-vis* the defendant, is entitled to an interlocutory injunction, restraining the defendant from continuing to use the TUMOTIN mark.

3. Mr. Bhuttan, learned counsel for the defendant submits, *per contra*, that his client is a pioneer in the field of homeopathic preparations and has been in the market for over 40 years. The TUMOTIN mark itself, he points out, has been in use since 2020. The plaintiff, having acquiesced to such use for over three years before



moving the Court, Mr. Bhuttan submits that the interests of justice would not warrant any interlocutory injunction against the use, by his client, of the TUMOTIN mark, being granted at this point of time.

4. Mr. Bhuttan has also questioned the entitlement of the plaintiff's asserted TUMORIN mark to registration. He points out that, on the date when the plaintiff applied for registration of the mark TUMORIN, there was already in existence the mark TUMOCIN, registered in favour of Neon Laboratories Ltd. As such, he submits that TUMORIN ought not to have been registered at all in view of Section 11(1)(b)¹ of the Trade Marks Act.

5. Mr. Bhuttan also invokes Section 9(1)(b)² of the Trade Marks Act to contend that the plaintiff's mark TUMORIN is descriptive of the ailment which it seeks to cure and that, therefore, even on this ground, the mark TUMORIN was not entitled to registration. He points out that TUMORIN is a portmanteau of two ordinary English

¹ 11. **Relative grounds for refusal of registration.** –

(1) Save as provided in Section 12, a trade mark shall not be registered if, because of –

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

² 9. **Absolute grounds for refusal of registration.** –

(1) The trade marks –

(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;

shall not be registered:

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.



words “tumor” and “in” is also, therefore, lacking in distinctiveness.

6. Mr. Bhuttan places reliance, in this context, on the judgment of this Bench in *Sun Pharma Laboratories Ltd. v. Finecure Pharmaceuticals Ltd.*³ in which, he submits, this Court specifically observed that the grant of registration to the mark PANTOCID of the plaintiff, Sun Pharma Laboratories Ltd., was open to challenge, in view of a pre-existing application for registration of an identical mark PANTOCID, filed by Takeda GMBH (hereinafter “Takeda”).

7. Mr. Bhuttan also submits that he has placed on record documents to indicate that vendors in the market are having no difficulty in distinguishing between TUMORIN and TUMOTIN. He also seeks to point out, in this regard, that both the medicines often figured alongside each other on the shelves of stores selling homeopathic remedies.

8. For all these reasons, Mr. Bhuttan submits that there is no justification for granting an injunction as sought by Mr. Varun Singh.

9. I have heard learned counsel for both sides and have applied myself to the rival submissions.

Analysis

Deceptive similarity and infringement

³ 2023 SCC OnLine Del 4932



10. Infringement of trade marks is entirely covered by Section 29 of the Trade Marks Act. A trade mark, in order for it to be infringed, has to be registered. The plaintiff's TUMORIN mark is undoubtedly a registered mark. Section 29 also makes it clear that the infringement must be by a person who is not a registered proprietor of the infringing mark. This is also apparent from Section 30(2)(e)⁴ which clarifies that the use of a mark, by virtue of the right to use conferred on the mark on account of its registration, cannot be infringing in nature.

11. The defendant has no registration for the mark TUMOTIN. As such, the requirement of the defendant's allegedly infringing mark being unregistered also stands satisfied in the present case.

12. Various circumstances, in which a registered trade mark would be infringed, are to be found in sub sections (1) to (5) of Section 29. Section 29(1) applies where the defendant's mark is identical or deceptively similar to the plaintiff's mark and is used in the course of trade in relation to the goods or services in respect of which the plaintiff's mark is registered, in such a manner as would render the use of the mark by the defendant likely to be taken as being used as a trade mark. The expression "use as a trade mark" is not defined in the

⁴ **30. Limits on effect of registered trade mark –**

(2) A registered trade mark is not infringed where –

(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.



Trade Marks Act. Its connotation and contours have to be divined from the definition of a “trade mark” as contained in Section 2(zb)(ii)⁵. Section 2(zb)(ii) defines “trade mark” as the meaning of a mark capable of being represented graphically and capable of defining the goods or services of one person from those of others and use for the purpose of indicating a connection in the course of trade between the goods or services and the proprietor of the mark. Inasmuch as the mark TUMOTIN is used by the defendant to indicate the connection in the course of trade between the mark and the defendant, the mark is, *prima facie*, being used by the defendant as a trade mark.

13. Section 29(2)⁶ envisages use of the defendant’s mark as being infringing if the defendant’s mark is identical or similar to the plaintiff’s mark and is used in relation to goods or services which are identical or similar to the goods or services in respect of which the plaintiff’s mark is registered and if, owing to a combination of these factors, there is likelihood of confusion on the part of the public or of

⁵ (zb) “trade mark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and –

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;

⁶ (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 –

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

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

(c) its identity with the registered trade mark and the identity 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 the registered trade mark.



the public believing an association between the two marks. Deceptive similarity between the mark can be of various types. In the case of word marks, the court is normally concerned with the aspect of phonetic similarity. Phonetic similarity between marks is classically to be decided on the basis of the test postulated by Parker, J. in *In re. Pianotist Co Application*⁷, which has been followed by the Supreme Court and various High Courts times without number. The test reads thus:

“You must take the two words. You must judge them, both by their look and by their sound. You consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trade mark for the goods of the respective owners of the marks.”

14. As such, when examining the aspect of phonetic similarity between two marks, the Court is required to see the two word marks as whole marks, and not in part, and also to keep in mind the nature of the consumers who would be dealing with the marks and the circumstances and manner in which the marks would be used in the market. It is also necessary to bear in mind, in this context, Section 17 of the Trade Marks Act. Sub section (2)⁸ of Section 17 grants

⁷ (1906) 23 RPC 774

⁸ (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,



exclusivity to a proprietor of a registered trade mark only to use of the mark as a whole. The proprietor is not entitled to exclusivity in respect of any *part* of the registered trade mark, unless such part is separately registered as a trade mark.

15. From these provisions, it is clear that the plaintiff cannot claim exclusivity over any part of the registered trade mark TUMORIN and can claim exclusivity in respect of the TUMORIN mark as a whole. The aspect of similarity and likelihood of confusion has, therefore, to be assessed by comparing TUMORIN and TUMOTIN as whole marks.

16. Reverting to the *Pianotist* test, who are the consumers, and how are the rival marks used in the trade? Admittedly, both marks are used for homeopathic preparations. Mr. Buttan has himself candidly stated that the preparations of the plaintiff and the defendant are often displayed together in stores or other outlets which dispense homeopathic remedies. TUMORIN and TUMOTIN are both prescribed by homeopaths and used by patients who believe in homoeopathy.

17. Somewhat in tune with the prevailing consideration that informs Section 29(2)(b), courts have evolved the “triple identity test” as being a useful guiding factor in determining whether a likelihood of confusion does, or does not, exist. Where the rival marks are similar

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.



or identical, they cater to the same consumer base, and are available at or through the same outlets, likelihood of confusion is presumed.

18. Phonetically, there can be, in my opinion, little doubt that the words TUMORIN and TUMOTIN are closely similar. The only difference between the two is the ‘R’ in one and the ‘T’ in the other. The words rhyme. They share the common TUMO prefix. RIN and TIN are obviously phonetically similar. Both are homeopathic preparations, and as already noted, are sold through common outlets, targeting the same consumer segment.

19. The Supreme Court has, in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*⁹, noted the overarching consideration of public interest which has to guide the approach of Courts while dealing with claims of deceptive similarity or infringement between rival pharmaceutical preparations. It has been observed that courts have to adopt a more relaxed standard while examining the aspect of deceptive similarity and be more liberal while granting injunction in such cases, so as to ensure that, owing to deceptive similarity, patients do not end up being administered, or end up consuming one preparation instead of another. This Court has, in its recent decision in *Dr. Reddy’s Laboratories Ltd. v. Smart Laboratories Pvt. Ltd.*¹⁰ applied the *Cadila* test even in cases where both pharmaceutical preparations contained identical compositions.

⁹ (2001) 5 SCC 73

¹⁰ 2023: DHC:8214



20. Applying the said principles here, given the confusing phonetic similarity between TUMORIN and TUMOTIN, the fact that the preparations would be prescribed by homeopaths who are aware of which preparation to prescribe, and that dispensing pharmacists may also not be readily confused between the marks, cannot mitigate the aspect of infringement, as the Court cannot act as a predictor of the possibility or otherwise of confusion, whether in the mind of prescribing homoeopath or the dispensing chemist. Besides, homeopathic preparations are not “Schedule H” drugs, which can only be dispensed on the advice of a registered practitioner. They are available across the counter. Confusion, even in the minds of the patient who visits the homoeopathic pharmacy, wanting to buy TUMORIN, and who may end up buying TUMOTIN instead, cannot, therefore, be overlooked. There is every likelihood of the unschooled consumer confusing one for the other.

21. The considerations of similarity of marks, identity of the goods covered by the marks and the likelihood of confusion in the public as a combined effect of these factors, as envisaged by Section 29(2)(b) of the Trade Marks Act, therefore, are clearly satisfied in the present case. Additionally, as the marks are deceptively similar, and the defendant is using the mark TUMOTIN as a trade mark, infringement even within the meaning of Section 29(1) of the Trade Marks Act also *prima facie* exists.

The plea of invalidity



22. Mr. Buttan sought to contend that the plaintiff is not entitled to any injunctive relief, as the mark TUMORIN ought not to have been registered in the first place. He, therefore, seeks to plead invalidity of the registration of the mark TUMORIN as a ground to defend the case of infringement that the plaintiff seeks to set up.

23. Validity of the registration of the plaintiff's mark is not a consideration envisaged by Section 29 for infringement to exist. All that Section 29 requires is that the plaintiff's mark must be registered. However, in order for the plaintiff to be entitled to relief against infringement, Section 28(1) requires that the registration be valid. As such, an invalid registration cannot entitle a person to injunctive relief, in view of Section 28(1).

24. At the same time, the statute engrafts a presumption of validity of a registered trade mark in Section 31(1). The provision presumes every registered trade mark to have been validly registered. A harmonised reading of Sections 28(1) and 31(1) and, therefore, would result in a presumption of validity attaching to every registered trade mark. However, if there are overwhelming circumstances available, as would clearly indicate the registration granted to the plaintiff's mark to be invalid, that can be a legitimate factor which the Court bears in mind while deciding the aspect of relief against infringement, even where infringement is found to exist.

25. The reliance, by Mr. Buttan on the judgment of this Court in *Sun Pharma* is misconceived. That was a case in which the plaintiff



was asserting the mark PANTOCID. It was evident from the documents on record that, on the date when the plaintiff Sun Pharma had applied for registration of the mark PANTOCID, an earlier application by Takeda GMBH, for the very same PANTOCID mark was pending with the Indian Trademarks Registry. An earlier application for an identical mark is to be treated as an earlier trade mark, in view of the Explanation¹¹ following Section 11(4) of the Trade Marks Act. The pre-existing application of Takeda was, therefore, deemed to be an earlier trade mark in view of Explanation (a) following Section 11(4). Inasmuch as an identical earlier trade mark was in existence, when Sun Pharma applied for registration of its PANTOCID mark, *prima facie*, the Court found that the application itself might not have been entitled to proceed to consideration, let alone registered. These were the circumstances in which the validity of Sun Pharma's PANTOCID mark was found to be vulnerable to challenge in that case.

26. TUMORIN is a registered trade mark. It has successfully weathered the challenge set up, to its registration, by Neon Laboratories' TUMOCIN. Having emerged victorious, Section 31(1) entitles it to a presumption of validity, at least at this *prima facie* stage. It cannot be said that there is overwhelming material with the Court to indicate that the obtaining of the said registration was

¹¹ **Explanation—For the purposes of this section, earlier trade mark means—**

¹[(a) a registered trade mark or an application under Section 18 bearing an earlier date of filing or an international registration referred to in Section 36-E or convention application referred to in Section 154 which has a date of application earlier than that of the trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trade marks;]

(b) a trade mark which, on the date of the application for registration of the trade mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection as a well-known trade mark.



violative of the law, unlike the situation in *Sun Pharma*.

27. Similarly, the submission of Mr. Buttan that the mark TUMORIN was not entitled to be registered, as it was descriptive in nature, or lacking in distinctiveness, can also not be accepted, at least *prima facie*. The submission is predicated on the fact that the initial part of the mark is “TUMOR” which is the ailment that the preparation intends to address.

28. The submission cannot be accepted. Seen as a whole, it cannot be said that TUMORIN is descriptive. Indeed, in *Cadila*² as well as in other judgments including the decision of the Division Bench of this Court in *Schering Corporation v. Alkem Laboratories Ltd.*¹², the Court has noted the fact that the names of pharmaceutical preparations are oftentimes based on the ailment that they seek to address, or the compound constituting the active pharmaceutical ingredient of such preparations, or the organ which the preparation intends to heal. There is an element of public interest in this practice, which has also been noted by the Supreme Court in *Cadila*². The coining of marks, for pharmaceutical preparations, based on the ailment or the organ or the composition of the preparation, is intended to facilitate persons, who prescribe such preparations, or who dispense such medicines, to easily recollect the name of the medicines. There can, therefore, be no injunction against use of “TUMOR” as part of the name of a pharmaceutical preparation which is aimed at treating tumours. Similarly, it cannot be said that, seen as a whole, the mark TUMORIN

¹² 2009 SCC OnLine Del 3886



is devoid of any distinctive character, as a result of which its registration would be vulnerable to challenge under Section 9(1)(a) of the Trade Marks Act. At the highest, the only handicap that the registrant of such a mark would suffer is that he would not be able to claim exclusivity over the prefix “TUMOR”, as the prefix, by itself, would be *publici juris*.

29. In any event, as already noted, the plaintiff, being the proprietor of the registered trade mark, TUMORIN, is entitled to a presumption of validity under Section 31(1) and, at the *prima facie* stage, is also entitled to relief against injunction by the use of others of marks which are deceptively similar to the plaintiff’s mark under Section 28(1) of the Trade Marks Act.

30. Mr. Buttan’s submission that the plaintiff should be disentitled an injunction as it has belatedly approached the Court despite being aware of the existence of the defendant for three years as on date, has also, even if it is treated as factually correct, to be rejected. In *Midas Hygiene Industries (P) Ltd v. Sudhir Bhatia*¹³, the Supreme Court has clearly held that where infringement is seen to exist, mere delay in approaching the Court is no impediment against grant of an injunction. That apart, Section 33¹⁴ of the Trade Marks Act envisages

¹³ (2004) 3 SCC 90

¹⁴ **Effect of acquiescence.**—(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark—

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was not applied in good faith.

(2) Where sub-section (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the



acquiescence as being a ground to disentitle the plaintiff to injunction only where the plaintiff has acquiesced for a continuous period of five years in the use of the defendant's mark, even where the defendant's mark is registered.

31. As such, the mere fact that, after the plaintiff having come to learn of the use, by the defendant, of the infringing TUMOTIN mark, three years have elapsed before the plaintiff has approached this Court, cannot be a ground to refuse an interim injunction to the plaintiff, where the fact of infringement is otherwise very much apparent.

32. For all the aforesaid reasons, the plaintiff has succeeded in making out a *prima facie* case for the grant of an interlocutory injunction, as sought in the application.

33. The defendant as well as all others acting on its behalf shall, therefore, stand restrained, pending disposal of the suit, from using the mark TUMOTIN or any other mark which is deceptively similar to the plaintiff's registered mark TUMORIN, either for Homeopathic preparations or in any other allied or cognate goods or services. The Court is, however, not passing any injunctive orders in respect of the stocks of the defendant's products which have already entered the market. In case any manufactured stock of TUMOTIN is presently lying with the defendant, the defendant shall stand injuncted from

earlier trade mark, or as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark may no longer be invoked against his later trade mark.



releasing the stock in the market.

34. The application stands allowed to the aforesaid extent.

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35. Both sides submit that if this matter is referred to mediation, the dispute is capable of being amicably resolved. As such, parties are referred to the Delhi High Court Mediation and Conciliation Centre. Let the parties contact the concerned officer in the Delhi High Court Mediation and Conciliation Centre on 4 December 2023 at 3:00 PM in order to fix a schedule for mediation.

36. Renotify before the Court on 28 February 2024 to ascertain the outcome of mediation.

I.A. 20256/2023 (Order VI Rule 17 of the CPC)

37. Issue notice, returnable before the Court on 28 February 2024.

38. Notice is accepted on behalf of the plaintiff by Mr. Varun Singh.

39. Reply, if any, be filed within a period of four weeks with advance copy to learned counsel for the applicant/defendant who may file a rejoinder thereto, if any, within a period of four weeks thereof.



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I.A. 19841/2023 (Order XI read with Section 151 of the CPC)

40. Issue notice, returnable before the Court on 28 February 2024.
41. Notice is accepted on behalf of the plaintiff by Mr. Varun Singh.
42. Reply, if any, be filed within a period of four weeks with advance copy to learned Counsel for the applicant/defendant who may file rejoinder thereto, if any, within a period of four weeks thereof.

C.HARI SHANKAR, J

NOVEMBER 30, 2023

ar/rb

[Click here to check corrigendum, if any](#)