



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

Reserved on: 16th February, 2024

Pronounced on: 01st May, 2024

+ **CS(COMM) 378/2018**

PFIZER PRODUCTS INC. Plaintiff

Through: Mr. Bharat S. Kumar and Mr.
Sanidleya Meheshwari, Advocates.

versus

RENOVISION EXPORTS PVT. LTD. AND ANR. Defendants

Through: *Ex-parte.*

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA

JUDGMENT

SANJEEV NARULA, J.

1. Pfizer Products Inc,¹ the Plaintiff, through this lawsuit seeks to protect their trademark rights in “VIAGRA,” a well-recognized erectile dysfunction allopathic drug, by seeking permanent injunction and other ancillary reliefs to prevent the Defendants from marketing their homeopathic medicine under a confusingly similar trademark “VIGOURA,” used allegedly for curing sexual disorders. When the suit was initially filed, Pfizer focused on solely protecting their common law rights in the said mark. However, subsequently, with Pfizer securing statutory rights through trademark registration of “VIAGRA,” the scope of reliefs was broadened, and Pfizer

¹ Interchangeably, “Pfizer” or “Plaintiff”.



also alleged trademark infringement, in addition to passing off. The lawsuit thus, raises critical questions concerning cross-border reputation and trademark protection for pharmaceuticals with similar-sounding names, but used for different mechanisms: one is a traditional homoeopathic medicine, while the other is a conventional allopathic drug. By addressing these questions, the Court will determine whether the Defendants’ use of “VIGOURA” infringes upon Pfizer’s “VIAGRA” trademark and/ or constitutes passing off.

THE CASE SET UP BY PFIZER

2. Counsel for Plaintiff presented the following facts and contentions:

2.1. Pfizer is a leading global pharmaceutical company, primarily engaged in research, manufacture and sale of drugs for animal and consumer healthcare and pharmaceutical use. Pfizer’s products have a strong international presence in over 150 countries and they were acknowledged as “No.1 Company” by the Fortune Magazine in 1998.

2.2. *Adoption of “VIAGRA”*: In 1995, Pfizer adopted the trademark “VIAGRA” for its revolutionary drug Sildenafil Citrate, developed to treat erectile dysfunction. Following the approval by the Food and Drug Administration, Department of Health and Human Services of the United States declaring “VIAGRA” to be a significant improvement in treatment of erectile dysfunction on 27th March, 1998,² the drug was introduced in the US market in 1998.

2.3. *VIAGRA’s Rapid Rise to Prominence*: Even prior to its introduction in

² “FDA approval”.



the USA, the “VIAGRA” drug attained widespread media attention in prominent publications like Newsweek Magazine, USA Today, and the New York Times. The proposed launch of “VIAGRA” also became a topic of discussion on popular television programs such as 20/20 and Today. Soon after its launch, “VIAGRA” gained immediate commercial success owing to extensive publicity, media attention and Pfizer’s initiatives to educate the public and medical professionals about its benefits and uses.

2.4. *Registration of the trademark “VIAGRA”*: Pfizer’s efforts resulted in successful registration of the “VIAGRA” trademark in over 147 countries, establishing it as a globally recognized brand. In India, the mark “VIAGRA” has been registered *w.e.f.* 1996 under No. 710135 in class 05 for “*Pharmaceutical compound for treating Erectile Dysfunction*”, which was later renewed in 2006 and continues to be in force.

2.5. In a short span of seven years from the date of its launch, Pfizer accumulated worldwide revenue amounting to a total of USD 9,957 million, as has been delineated in paragraph No. 9 of the plaint. Due to such widespread recognition, the term “VIAGRA” has been included in the Oxford English Dictionary.

2.6. *Prevalence in India*: Extensive publicity through television coverage, press reports, international magazine features, medical books and journals circulated in India, has propelled the trademark “VIAGRA” to a household name status both globally, and within India. The online version of the Indian newspaper, Times of India, also published an article on 28th May, 2001, highlighting “VIAGRA” and its additional benefits for women. Pfizer’s online website “www.viagra.com” is accessible to international customers, including Indian citizens for gaining information about oral therapy for male



erectile dysfunction. The widespread global use of the trademark “VIAGRA” extended the mark’s reputation to India, even prior to its official launch within the country. This argument is supported by the precedent set in *Pfizer Inc. v. B.L. Company and Ors.*³ wherein this Court acknowledged “VIAGRA” as a world-renowned mark despite the absence of direct sales within India. Moreover, “VIAGRA” has been declared a ‘famous mark’ by the courts in Monaco under Article 6 *bis* of the Paris Convention for the Protection of Industrial Property, 1883. These precedents strengthen Pfizer’s claim that the “VIAGRA” mark qualifies as a well-known trademark under the Indian Trademarks Act, 1999.

2.7. *Impugned activities:* In February 2005, Pfizer discovered that Defendant No. 1, trading as Renovision Exports Pvt. Ltd., was selling products described as “Nervine Tonic for Men” and “Homeopathic Medicine Invented in Germany” under the infringing mark “VIGOURA”. Subsequent investigations revealed variants of “VIGOURA” products, such as “VIGOURA 2000”, “VIGOURA 5000”, and “VIGOURA 1000”. These goods are purportedly manufactured by Defendant No. 2. Pfizer’s attorneys immediately addressed the issue by sending a cease-and-desist letter to the Defendants on 03rd February, 2005. A reminder letter was sent on 01st March, 2005.

2.8. A response to the above-noted letters was received on 11th March, 2005, wherein Defendants disputed Pfizer’s claims and asserted their rights in their “VIGOURA” trademark. Defendant No. 1 filed applications for registration of their marks “VIGOURA 2000” under No. 1168129 and

³ 2002 SCC OnLine Del 396.



“VIGOURA 5000” under application No. 1258414, both in class 05. Pfizer, in turn, filed notices of opposition to the said applications. While the suit was pending adjudication, Plaintiff’s opposition to “VIGOURA 2000” was allowed by the Registrar of Trademarks, Kolkata on 29th April, 2009, resulting in rejection of Defendant No.1’s application. As regards the trademark application for the mark “VIGOURA 5000”, since Defendant No. 1 did not file a counter-statement to the opposition, the application was deemed to be abandoned by the Registrar of Trademarks.

2.9. Defendants’ “VIGOURA” mark is deceptively similar to Pfizer’s well-established “VIAGRA” trademark. This similarity is an intentional attempt by the Defendants to capitalize on the goodwill and reputation associated with “VIAGRA”. Both marks share similar elements: they begin with ‘Vi’, end with ‘Ra’, and have three syllables, making them phonetically comparable. Additionally, both products target the same consumer segment (those seeking remedies for medical conditions), thereby increasing the likelihood of confusion regarding the source and affiliation of the products.

THE DEFENDANTS’ POSITION

3. In the written statement filed, the Defendants have put forth the following defence to the suit:

3.1 Defendants are established specialists in the homeopathic domain. Defendant No. 1 is a registered oil company with a strong reputation for manufacturing homeopathic medicines, which includes the drugs “VIGOURA 1000”, “VIGOURA 2000”, and “VIGOURA 5000”.

3.2. The impugned products are distinct medicines, intended to address varied ailments. “VIGOURA 1000” focuses on vitality and regulating



menstruation in women and is therefore, distinct from the Plaintiff's product, which addresses male erectile dysfunction. This distinction renders the product "VIGOURA 1000" irrelevant to the present dispute. "VIGOURA 2000" and "VIGOURA 5000" are homeopathic medicines formulated as non-steroid aphrodisiacs designed to stimulate metabolic processes. Homeopathic medicines operate on different principles than conventional allopathic pharmaceuticals like Pfizer's "VIAGRA". While "VIAGRA" is utilized for instant relief, Defendants' "VIGOURA" demonstrates gradual effects after consumption for two to three months. The difference in the composition and nature of the two medicines coupled with the fact that both are prescription drugs, reduces the likelihood of confusion for consumers.

3.3. The adoption of the impugned mark "VIGOURA" by Defendants is honest, genuine, and *bona fide*. It is a fanciful mark derived from the English term 'Vigour'. Besides, the impugned products have a significant market history, with "VIGOURA 2000" being first manufactured and marketed by the Defendants in 1999. Defendant No. 1 also sought trademark registration for "VIGOURA 2000" on 21st January, 2003, and for "VIGOURA 5000" on 30th December, 2003 in class 05. In addition, Defendant No. 1 secured a copyright registration for the artistic work vested in the packaging of "VIGOURA 2000" on 27th April, 2005. Thus, the Defendants' products have been in the market for a significant time before Pfizer's trademark registration.

3.4. Various other entities have secured registration rights in trademarks that resemble the word "VIAGRA" for Ayurvedic medicinal or pharmaceutical drugs falling under class 05, much prior to Pfizer. In



support, the written statement enlists registrations held by third parties for the marks “VIGORA”, “VIGOR PLUS”, and “VIGOUR MALT”.⁴

3.5. The mark “VIAGRA” has not been assigned in favour of the Plaintiff by its owner Pfizer Inc. Therefore, the Plaintiff cannot claim proprietorship over the said mark.

RELEVANT PROCEDURAL HISTORY OF THE LAWSUIT

4. On 08th March, 2006, the following issues were framed:

- “1. Whether the plaintiff is the proprietor of the trademark VIAGRA? OPP*
- 2. Whether the use of the mark VIGOURA by the defendant amounts to passing off the goods as that of the plaintiff? OPP*
- 3. Whether the plaintiff is entitled to any damages? If so, the extent thereof. OPP*
- 4. Relief.”*

5. Subsequently, the Plaintiff filed an application [I.A. 2190/2008] under Order VI Rule 17 of the Code of Civil Procedure, 1908,⁵ seeking amendment of the plaint for incorporating the factum of registration of the trademark “VIAGRA” in favour of Pfizer. The application was allowed by this Court on 25th July, 2008, finding the proposed amendments necessary for effective adjudication of the matter and in the interest of justice.

6. On the basis of the amended pleadings and documents of the parties, the following additional issues were framed on 28th April, 2009:

- “1. Whether the defendant is infringing the registered trade mark of the plaintiff ‘Viagra’? OPP*
- 2. Whether other trade marks resembling and similar to the trade mark of the plaintiff have been registered, as alleged by the defendants? If so, to what effect? OPD”*

⁴ In paragraph No. 18 of the amended written statement.

⁵ “CPC”.



For ease of reference, the two additional issues noted above shall be described as issues No. 5 and 6, respectively.

7. The parties were thereafter relegated to trial, where the Plaintiff examined Ms. Anamika Gupta, their Constituted Attorney, as PW-1, while Defendants examined two witnesses: Mr. Firoze Akhtar, Director of Defendant No. 1 [DW-1] and Mr. Ashfaque Rehman, Managing Director of Defendant No. 1 [DW-2].

8. Recording of evidence was concluded on 12th October, 2015, and the matter progressed to the stage of final hearing. However, it is notable that subsequent to the conclusion of the trial, the Defendants ceased to appear. Despite attempts to contact Defendants' counsel, as noted in the order dated 20th January, 2023, none appeared on their behalf. Notwithstanding the continued non-appearance of the Defendants, since the trial has culminated, the Court is to finally adjudicate the lawsuit.

ISSUES WISE ANALYSIS

Issue No. 1 - Whether the Plaintiff is the proprietor of the trademark "VIAGRA"? OPP

9. This issue hinges on the definition and concept of a 'proprietor' of trademark. Under the Trademarks Act, a 'registered proprietor' is defined as the person recorded in the trademarks Register as the proprietor of the trademark.⁶ Thus, the registered proprietor is recognised as the lawful owner of the trademark, vested with exclusive rights to employ the trademark in association with specific goods or services. However, a 'proprietor' is not

⁶ Section 2(1)(v) of the Trademarks Act, 1999.



just the registered owner; the term encompasses anyone who has exclusive rights to use the trademark for specific goods or services. This ownership can be established through utilization of the trademark in commercial activities within the marketplace, thereby engendering common law rights. Additionally, such rights may be secured through formal registration with the Trademarks Registry. Thus, proprietorship can be viewed as a spectrum – ranging from initial use in the marketplace to formal recognition by registration.

10. The Plaintiff derives their rights in the mark “VIAGRA” from Pfizer Inc., USA. PW-1 has testified that Pfizer Inc., USA assigned the trademark with the associated goodwill to the Plaintiff, under a Deed of Assignment dated 03rd June, 1999 as per Section 38 of the Trademarks Act. This document, marked as Document B, remains unchallenged by the Defendants, and establishes the Plaintiff’s legal claim as the proprietor under Section 18(1) of the Trademarks Act, and their consequent competence to initiate this lawsuit.

11. The Plaintiff has established through evidence, which has been uncontroverted, that “VIAGRA” is a uniquely coined term with no pre-defined meaning in the English language or its standard dictionaries before its association with the medication, making it inherently distinctive and devoid of descriptiveness under Section 9 of the Trademarks Act. Its subsequent inclusion in the English dictionary as a proper noun reflects its widespread recognition and popularity,⁷ yet without implying any pre-existing connotation related to its effects or purpose. Pfizer’s claim of

⁷ Ex. P-2.



distinctiveness is further substantiated by registrations in over 147 countries demonstrated through several international registration certificates issued by the Trademark Offices of New York, United Kingdom, Hong Kong, Japan etc.⁸ Additionally, the FDA approval letter for the drug,⁹ marketing material and advertisements,¹⁰ and printouts of the Plaintiff's website proving their online presence,¹¹ supplement their claims of first use in the world market. The Defendants have not substantively contested the originality or distinctiveness of the "VIAGRA" trademark. Their arguments primarily aimed at distinguishing their mark "VIGOURA" and the respective products to which the competing trademarks are applied. Thus, Pfizer's documentary evidence unequivocally demonstrates that "VIAGRA" was originally created by them and maintains distinctiveness in the context of the goods or services it denotes, making it a strong candidate for trademark protection.

12. While the demonstration of originality establishes the initial claim to a trademark, that criterion alone is not sufficient to prove legal ownership over it. The Plaintiff must go beyond merely proving conception and adoption of "VIAGRA" trademark and provide either comprehensive evidence of use and market recognition, or registration within India, as trademark rights are inherently territorial. On this aspect, the Plaintiff's application for registration of the trademark "VIAGRA", filed on 18th July, 1996 on a proposed-to-be-used basis, exhibits their intent to utilize the mark in India. This application strengthened their entitlement over the trademark and served as a public declaration of their intention to use "VIAGRA" in

⁸ Plaintiff's Document Mark C.

⁹ Plaintiff's Document Mark D.

¹⁰ Plaintiff's Document Mark E.



association with the listed goods and services.¹² While filing of the trademark application establishes a legally recognized ownership claim to the “VIAGRA” mark, it is not a direct proof of commercial use. The use is proved through subsequent launch of the product in India, cementing their claim of originality, ownership, and use of the trademark.

13. Moreover, the Plaintiff has now secured statutory rights over the trademark “VIAGRA” in India as they have been accorded registration of the aforesaid trademark on 26th June, 2006. This has been proved through the Legal Proceedings Certificate bearing No. 536527.¹³ This significant development was preceded by the advertisement/ publication in the Trademarks Journal on 28th October 2003, notifying the general public of Pfizer’s claim over the trademark and offering a window for opposition. The registration of “VIAGRA” not only reaffirms their ownership, but also ensures exclusive rights to the trademark for the associated goods and services, effective from the application date, 18th July, 1996. This unchallenged fact of registration, rather acknowledged by the Defendants, confirms Plaintiff’s ownership over “VIAGRA” in India.

14. To conclude, the trademark’s journey that commenced from a coined word and its continuous and *bona fide* usage and online presence, corroborated by comprehensive oral and documentary evidence of international registrations, regulatory approvals (e.g., FDA) and inclusion of “VIAGRA” in the Oxford dictionary, successfully proves Pfizer’s status of proprietor of the “VIAGRA” trademark. The culmination of these efforts in

¹¹ Ex. P-3.

¹² *Pfizer Products Inc. v. Rajesh Chopra*, DHC Neutral Citation: 2007:DHC: 649.

¹³ Ex. P-4.



successful registration in India conclusively proves their exclusive ownership as the registered proprietor of the trademark within Indian territory from the application date, establishing a legal presumption of validity and ownership that remains uncontested by the Defendants. Consequently, this issue is decided in favour of the Plaintiff, and against the Defendants.

Issue No. 5 (renumbered) - Whether the Defendants are infringing the registered trade mark of the Plaintiff “Viagra”? OPP

15. The assessment of trademark infringement and passing off involves an interplay of factual analysis and legal principles. Although each claim requires distinct legal considerations, their evaluation often intersects on common elements – primarily, the degree of similarity between the contested trademarks and the circumstances surrounding the adoption of the impugned mark. Given this overlap, it is appropriate for the Court to first address the infringement claim, despite it arising after the initial filing of the lawsuit.

Defendants’ assertion of prior use and adoption of the mark “VIGOURA”

16. The Plaintiff’s basis for pursuing trademark infringement for “VIAGRA” became effective upon its registration relating back to 18th July, 1996. Consequently, the Court’s analysis of the infringement claim must consider the Defendants’ activities from the date of registration. In order to overcome the rights of a registered proprietor, the Defendants must demonstrate under Section 34 of the Trademarks Act, that their use was prior to the date of use or registration of the Plaintiff’s mark, whichever is earlier.



17. The Plaintiff's claim over the "VIAGRA" trademark originates from its global introduction in 1995, followed by filing of an application for registration in India on 18th July, 1996, and its first commercial use in 2005. In contrast, the earliest evidence of Defendant No. 1's engagement with the impugned products under the trademark "VIGOURA" dates 15th May, 1999, when they were granted a license by the Chief Licensing Authority, State Drugs Controller, Patna.¹⁴ Notably, this use began nearly three years after Plaintiff's application to secure exclusive statutory rights over the "VIAGRA" mark in India. Thus, by the time Defendant No. 1 entered the market, Plaintiff had already applied for registration for "VIAGRA" in India, establishing their priority.

18. It is essential for any entity seeking to introduce a new trademark into the market to conduct thorough due diligence, which includes searching the national trademark database for any pending applications or registrations that could conflict with the proposed mark. The responsibility to avoid infringement includes the duty to be aware of existing trademarks and pending applications, particularly for marks that are phonetically, visually, or conceptually similar. Had Defendant No. 1 undertaken such a search prior to the adoption of the "VIGOURA" trademark in 1999, they would have discovered Pfizer's pending application for "VIAGRA", filed in 1996. This discovery would have alerted the Defendants to the potential for conflict and the likelihood of infringing on Pfizer's prior rights to the "VIAGRA" trademark. Significantly, in his cross-examination, DW-1 – Mr. Firoz Akhtar (Director of Defendant No. 1) has acknowledged his awareness of

¹⁴ Ex. DW 1/4.



Plaintiff's mark "VIAGRA". This admission and failure to conduct the basic trademark screening undermines the Defendants' claim of honest concurrent use.

Pfizer's plea of infringement

19. The Plaintiff, having established priority in the use of the trademark "VIAGRA" and asserting their exclusive statutory rights under the Trademarks Act, requires this Court to consider whether the Defendants' "VIGOURA" trademark constitutes infringement. The Plaintiff argues that the Defendants' employment of a deceptively similar trademark "VIGOURA" constitutes a direct infringement of their "VIAGRA" mark as delineated in Section 29 of the said Act. According to the Plaintiff, the impugned actions not only infringe upon their trademark rights, but also undermine the trust and recognition built around the "VIAGRA" brand, jeopardizing its established market position and consumer perception as the "VIGOURA" mark: (a) capitalizes, and poses a risk of further capitalizing on the substantial and valuable goodwill associated with the "VIAGRA" trademark that has the potential to further cause public confusion regarding the origin, sponsorship, and affiliation with the Defendants' products, (b) inflicts damage upon, and is a potential threat of further damaging the goodwill attached to Pfizer's "VIAGRA" mark, (c) compromises and threatens to further compromise Pfizer's exclusive right to utilize the "VIAGRA" mark as a distinct indicator of the origin of their erectile dysfunction product, and (d) dilutes and threatens to further erode the distinctive character of the globally recognized "VIAGRA" trademark.

20. Defendants dispute Pfizer's contentions, basing their stand on the



distinctions in the therapeutic effect of the products/ marks “VIAGRA” and “VIGOURA.” They highlight that “VIAGRA” is an allopathic medicine, and whereas “VIGOURA” is homeopathic medicine; “VIAGRA” is sold in a tablet form while “VIGOURA” in a liquid form. As per them, Pfizer’s “VIAGRA” provides instant relief intended only for male erectile dysfunction, but Defendants’ “VIGOURA” is a complete therapy originating from 100-year-old proven homeopathic practices for curing several other sexual problems. Therefore, two are distinct medicines as is also evident from the difference in their composition. Since the rival products are to be prescribed by knowledgeable persons and are dispensed by skilled persons, some degree of similarity is permissible as the factors detailed above sufficiently reduce the chances of confusion. Besides the above differences, Defendants asseverated that “VIAGRA” and “VIGOURA” are phonetically and structurally distinct and mere identity of the syllables ‘Vi’ and ‘Ra’ does not make the two phonetically similar. “VIAGRA” has a denotative meaning, but “VIGOURA” is a coined word, derived from the English word ‘vigour’.

21. The Court now turns to the issue of discerning similarity between Pfizer’s “VIAGRA” and Defendants’ “VIGOURA” trademarks. To determine their visual, phonetic, and conceptual similarity, let us first consider the following comparative chart:

<u><i>Plaintiff’s mark</i></u>	<u><i>Defendants’ mark</i></u>
VIAGRA	VIGOURA VIGOURA 1000 VIGOURA 2000



	VIGOURA 5000
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22. The trademarks “VIGOURA” and “VIAGRA” exhibit a high degree of phonetic similarity. Both marks are comprised of three syllables, with ‘Vi’ as a common prefix and ‘Ra’ as a similar suffix, producing a strikingly similar auditory impression. This phonetic resemblance is particularly concerning in the pharmaceutical industry, where the precise identification of products is crucial for consumer safety and confidence. The similarity in sound could mislead consumers into believing that “VIGOURA” is either a variant of, associated with, or endorsed by the makers of “VIAGRA,” potentially resulting in mistaken purchases or the belief in equivalent efficacy. Visually, the trademarks “VIAGRA” and “VIGOURA” share notable similarities in the letter structure and length, contributing to strong visual resemblances. The initial alphabets ‘Vi’ in both marks are likely to capture consumer attention due to their prominent placement and the shared context of pharmaceutical products. Furthermore, the overall length of the words and their similar letter arrangements can cause confusion at a glance, especially in environments where consumers make quick decisions, such as online searches or pharmacy purchases. The mere addition of numerals “1000”, “2000” and “5000” after embodying almost whole of Plaintiff’s mark, does not render Defendants’ mark distinguishable from Plaintiff’s mark. This visual resemblance is compounded by the conceptual link consumers might draw between the two, associating them with similar health benefits or outcomes. Additionally, the goods are being sold to the same segment of consumers making the confusion between the two marks



most probable. The combination of these factors could confound the consumers or lead them erroneously to associate “VIGOURA” with “VIAGRA”, thereby blurring the distinctiveness of the latter’s brand identity and infringing upon its established market presence.

23. Trademark law primarily seeks to prevent consumer confusion regarding the source or sponsorship of goods and services. In assessing likelihood of confusion between trademarks, it is important to recognize that consumers generally rely on the overall impressions or prominent details of a mark, rather than retaining a photographic memory of the entire trademark. Thus, similarity between two trademarks is not assessed in isolation, but in the context of their market use. It is also essential to consider whether the goods or services offered under both marks are identical or similar. The rationale is that the closer the goods or services are in terms of nature, purpose, use, or consumer base, the higher the likelihood of confusion. That said, the classification of goods or services alone does not determine similarity; the overall impression on the target market is also crucial. The manner in which the goods or services are marketed, sold, and consumed, along with the characteristics of the target consumer base, are also significant factors. Products that are sold in the same or overlapping channels of trade, or that target the same segment of consumers, are more likely to cause confusion.

24. The distinction sought to be made by the Defendants between the intended use of “VIGOURA” products and “VIAGRA” does not fully mitigate the risk of consumer confusion. As “VIGOURA” is phonetically, visually, and conceptually similar to “VIAGRA”, there exists a substantial potential for consumers to associate the two products. This initial confusion



can occur regardless of the consumer's overall awareness or knowledge of the differences between allopathic and homeopathic remedies. In such scenarios, while the consumer might understand the distinctions between the kinds of treatments (allopathic v. homeopathic), the resemblance in the ailment intended to be cured and the names/ trademarks, can induce an association between the two products, based on perceived endorsements or verbal accounts/ recommendations. Both types of products are frequently sold in similar retail environments such as pharmacies, health stores, or online platforms. When consumers encounter different products with similar branding in the same retail context, the risk of assuming a common source or affiliation increases. Moreover, the concern in the present dispute is not solely the possibility of consumers confusing the products themselves *i.e.*, thinking an allopathic drug is homeopathic or vice versa, but more about them confusing their commercial source or assuming that they originate from the same entity or have the same level of efficacy due to similar branding. This is why even in different but related fields, maintaining distinct trademarks is crucial for clear communication to consumers and maintaining the integrity of brands in the marketplace. This risk is underscored by the congruence in the intended use of the Defendants' products with the Plaintiff's, a fact acknowledged by DW-2, Mr. Ashfaque Rahman, during his testimony in the following terms:

*“Q. Is it correct that ‘Vigoura’ is a medicinal series relating to sexual problems, manufactured and marketed by your company?
Ans. It is correct.”*

25. Mr. Rahman further admitted as follows:

“...As per Ex.P-1, the product can be used for sexual power booster. Vol. on prescription by homeopathic doctor. There is no other nervine tonics



manufactured and marketed by our company except VIGOURA series products”

26. The Ex. P-1 referred above is as follows:



27. While the Defendants point to the significant market history of “VIGOURA 2000”, subsequent introduction of “VIGOURA 5000”, and their efforts to register these trademarks, as indicators of their commercial intentions, these factors do not negate the infringement of the trademark. Their long-standing presence in the market does not confer immunity against infringement actions. The Plaintiff successfully opposed the trademark registrations of “VIGOURA 2000” and “VIGOURA 5000” and the Defendants have not taken any further actions to challenge the order of rejection of their trademark application.

28. The Supreme Court has, in *Cadila Healthcare Limited v. Cadila*



Pharmaceuticals Limited,¹⁵ articulated that a more stringent approach is warranted when assessing the potential for confusion between medicinal products. Unlike non-medicinal products, where confusion might only result in economic harm to the Plaintiff, confusion between medicinal products can pose serious risks to public health. Therefore, the Court must apply rigorous standards to prevent such outcomes. In the given scenario, the differences between homeopathic and allopathic treatments becomes less relevant than the overarching need to prevent misleading impressions about the product's origin or affiliation. Given the critical nature of the medicines involved, which are designed to address sensitive health issues, the potential for deception is not only high, but also fraught with serious implications for consumer health and safety.

29. To conclude, the Defendants' trademark "VIGOURA" is held to be deceptively similar to the Plaintiff's trademark "VIAGRA". In view of the resemblances between the two trademarks and the overlap in field of use and commercial operations, as elucidated above, there is a strong potential of confusion amongst the general public. Thus, the Court answers this issue in favour of the Plaintiff and against the Defendants, holding that Defendants' "VIGOURA" mark infringes the Plaintiff's registered "VIAGRA" mark under Sections 29(1) and 29(2)(b) of the Act.

Issue No. 2 - Whether the use of the mark "VIGOURA" by the Defendants amounts to passing off the goods as that of the Plaintiff? OPP

30. The act of passing off is a common law tort that serves to protect the goodwill and reputation attached to trademarks. The fundamental essence of

¹⁵ 2001 SCC OnLine SC 578.



a passing off claim is to prevent one party from misrepresenting their goods or services as those of another, thereby causing damage to the latter's goodwill. For a successful claim of passing off, three key elements, often referred to as the "classic trinity test", need to be established.¹⁶ Firstly, the Plaintiff must demonstrate the existence of goodwill or reputation attached to their goods or services in the mind of the purchasing public. Goodwill is understood as the positive recognition that a business earns through the distinctive quality, performance, or presentation of its products or services, which distinguishes it from its competitors. The concept goes beyond the mere presence of a trademark and delves into the customer's association of the mark with a particular source or quality. Secondly, there must be evidence of misrepresentation by the Defendants, whether intentional or not, leading the public to believe that the goods or services offered by the Defendants are the goods or services of the Plaintiff. Misrepresentation can occur in various forms, including the use of similar trademarks, packaging, or marketing strategies, which could confuse the public about the origin of the goods or services. Lastly, the Plaintiff must prove that they have suffered, or are likely to suffer, damage due to the Defendants' misrepresentation. This damage could manifest as a diversion of sales, dilution of goodwill, or tarnishing of reputation of Plaintiff's trademark.

31. The Defendants adopted the trademark "VIGOURA" for their products in India in 1999. By this time, the Plaintiff had already launched its product "VIAGRA" in the USA in 1998 for the treatment of male erectile dysfunction. Nonetheless, the Plaintiff did not have trademark registration in

¹⁶ *Laxmikant V. Patel v. Chetanbhat Shah and Anr.*, (2002) 3 SCC 65.



“VIAGRA”, nor had they launched their product in India at the time the lawsuit was filed. However, their intent to enter the Indian market had been clearly expressed through the filing of a trademark application. Consequently, the assessment of the claim of passing off necessitates an evaluation of the Plaintiff’s reputation on a global scale and whether this reputation had extended into India by 1999, the year when the Defendants adopted the impugned mark “VIGOURA”. On this issue, the Court refers to the concept of trans-border reputation of a trademark, articulated in the celebrated cases of *N.R. Dongre and Ors. v. Whirlpool Corporation and Anr.*,¹⁷ *Milmet Optho Industries v. Allergan Inc.*,¹⁸ *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd.*¹⁹

32. Regarding the factual determination of similarity between the Defendants’ and the Plaintiff’s marks and the consequent probability of consumer confusion, the Court has already addressed these concerns in issue No. 5 relating to trademark infringement. Therefore, further deliberation on these points is considered unnecessary for evaluating the claim of passing off.

Transborder reputation of Pfizer in the “VIAGRA” mark

33. The Plaintiff has put forth following evidences to prove passing off on the basis of transborder reputation: (a) trademark registration certificates evincing the adoption of trademark “VIAGRA” by Pfizer for its Sildenafil Citrate product in the year 1995 and recognition of their rights world over,²⁰

¹⁷ (1996) 5 SCC 714.

¹⁸ (2004) 12 SCC 624.

¹⁹ (2018) 2 SCC 1.

²⁰ Plaintiff’s Document Mark C.



(b) legal proceedings certificate for the trademark application dated 18th July, 1996 filed in India on a proposed-to-be-used basis,²¹ (c) FDA approval dated 27th March, 1998,²² and (d) extensive advertisement and promotional material of “VIAGRA” in numerous publications, medical books, journals, magazines, including Newsweek, Fortune, Money, Business Week, Forbes, the Associated Press, Dow Jones News Service, the Times of London, Financial World, New York Times, and USA Today.²³

34. The principles of cross-border reputation recognise that even if the product is not sold directly in India, but information about it is accessible through print media, particularly through magazines targeting consumers interested in that category of goods, this constitutes strong evidence of the product’s reputation permeating the municipal jurisdiction of India. Such exposure indicates that the product’s reputation and recognition extend beyond its physical market presence, impacting consumer perception within India. On this issue, Plaintiff has provided ample evidence. They have proved the publicity of the ground-breaking drug “VIAGRA” through newspaper reports and promotional materials. The text of these articles clearly demonstrate that “VIAGRA” was a revolutionary product that earned significant reputation since its market debut. The product/ mark captured significant media attention, public and trade interest globally that underscores its significance in the pharmaceutical industry. It was extensively discussed in major international journals and magazines, which also had a substantial circulation in India, thereby indirectly establishing its

²¹ Ex. P-4.

²² Plaintiff’s Document Mark D.

²³ Plaintiff’s Document Mark E.



presence in the Indian market. Although internet penetration was relatively low in 1999 when the Defendants adopted the impugned mark, the Plaintiff had already established an active online presence with “www.viagra.com”. This website was accessible from India, thus enhancing the global visibility of the trademark. The widespread commercial recognition of the mark “VIAGRA”, along with its registration in numerous countries and its acknowledgment as a ‘famous mark’ by courts in various jurisdictions, collectively highlight its rapid ascent to international fame. Such recognition inures to Pfizer, establishing a substantial reputation that arguably extended into the Indian market even before the Defendants’ adoption of the similar mark “VIGOURA”.

35. To further establish the reputation and recognition of the “VIAGRA” mark amongst the Indian public, Plaintiff’s witness, Ms. Anamika Gupta [PW-1], provided crucial testimony. She outlined the extensive dissemination of information about “VIAGRA” through various media channels, particularly those targeting the profession, which also reached India, including the medical professionals. Her deposition reads as under:

*“4. I affirm that after extensive research and clinical trials, the Plaintiff in early 1998, introduced in the US, a revolutionary product - sildenafil citrate, for the treatment of male erectile dysfunction (hereinafter referred to as ED), which the Plaintiff markets and sells under its aforementioned trade mark VIAGRA. I say and depose that on March 27, 1998 the Department of Health & Human Services of the US Government approved the drug VIAGRA. I further state that VIAGRA also finds a mention in the list of drugs approved in March 1998 made available to the public by the U.S. Food and Drug Administration Department. I say that the said copy of Letter of Approval has been filed along with the present suit and may be marked and exhibited as **Mark D**.*

5. I affirm that Plaintiff’s drug marketed under the brand name VIAGRA received enormous media attention, which included cover stories in publications such as 'Newsweek Magazine' and 'New York Times', discussions on several popular television programs including “20/20” and



*“Today” and feature articles in major publications such as ‘USA Today’. I say that the VIAGRA brand sildenafil citrate has been the subject of intense media attention, public scrutiny and commentary. I affirm that the plaintiff has expended millions of dollars to promote and educate patients and medical professionals about the product sold under the trademark ‘VIAGRA’. I say that the copies of articles, pertaining to VIAGRA published in various reputed journals have been filed along with the present suit and may be marked and exhibited as **Mark E**. By virtue of this extensive publicity, unsolicited press reports, articles and features, the Plaintiff’s trademark VIAGRA has become famous throughout the world as designating the Plaintiff’s brand of oral therapy for male erectile dysfunction. I say that the brand name VIAGRA has thus, become a household name around the world, including India, where the product was launched in December 2005.*

xx ... xx ... xx

8. *I say that for promoting, advertising and popularizing various brands of the Plaintiff including the trademark VIAGRA, the Plaintiff maintains a formidable presence upon the internet. I say that the trademark features prominently upon the Plaintiffs website <www.viagra.com>, which can be accessed from India. In addition by a judgement dated 29th August, 2007 in Pfizer Products, Inc. v Mr. Altamash Khan & Another. CS (OS) No. 1192/2005, the Plaintiff was held to be entitled to the domain name ‘viagra.in’ and the same was transferred to the Plaintiff by the .IN Registry. The domain name <Viagra.in> is being used by the Plaintiff on its website <www.viagra.in.>. I say that the printouts of the said website are filed along with the present affidavit and may be marked and exhibited as **Exhibit P3.**”*

36. Ms. Gupta’s testimony indicates that although “VIAGRA” was officially launched in the US in 1998 and in India only in 2005, its ground-breaking nature as a treatment for erectile dysfunction garnered extensive international media coverage from the outset. The drug “VIAGRA” was introduced in the US in early 1998, following extensive research and clinical trials, and received approval from the US FDA on 27th March, 1998, which was publicly listed. PW-1 detailed the significant media attention “VIAGRA” received worldwide, including major features in top-tier publications like Newsweek Magazine and The New York Times, and



discussions on popular television programs such as 20/20 and Today, which had wide international circulation, including viewership/ readership in India. This publicity significantly contributed to the brand's global recognition. PW-1 also highlighted the Plaintiff's robust online presence, notably through the website "www.viagra.com," accessible globally, including in India.

37. This media coverage, alongside the Plaintiff's strategic promotional activities at international medical and pharmaceutical conferences attended by professionals from around the world, including India, facilitated the permeation of "VIAGRA" reputation across national borders. Furthermore, it is crucial to note that Ms. Gupta's testimony regarding the extensive international recognition and its indirect presence in India through these channels, remains unchallenged. Her statements were not countered in cross-examination, as the Defendants focused only on aspects such as the side effects of the medicine, dissimilarities in packaging, pricing, and the basis for computing damages. Therefore, her testimony regarding reputation of trademark "VIAGRA" in India being contemporaneous with its launch in the US remains uncontroverted and strengthens Plaintiff's claim that "VIAGRA" had established a substantial reputation in India based on its global recognition and media presence.

38. In *Milmet Oftho* (*Supra*), the Supreme Court has recognized the 'international character' of the realm of medicine, where medical professionals constantly endeavour to remain abreast of the latest global advancements by referring to various sources such as medical journals, magazines, newspapers, and online publications. This holding further bolsters the Plaintiff's assertion of knowledge of their mark among the



relevant segment of the public in India. Moreover, Pfizer also maintained a website displaying the “VIAGRA” products and related information to users across the world, including those present in India. These factors signal towards familiarity of the Indian public, especially those travelling abroad, with the Plaintiff’s mark “VIAGRA”, thereby reinforcing the mark’s reputation traversing the Indian borders.²⁴

39. Furthermore, in *B.L. Company (Supra)*, this Court has rendered a finding of fact that Pfizer’s reputation in the trademark “VIAGRA” has spilled over in India.

40. To conclude, in 1999, the landscape of information dissemination, though not as digitally pervasive as today, still significantly influenced public perception and brand reputation through targeted media outlets. For trademarks such as “VIAGRA”, which may not have been physically available in the Indian market, substantial recognition could still be achieved instantly through strategic exposure in print media. Publications dedicated to health and pharmaceuticals, accessible to Indian consumers, played a crucial role. These magazines and articles, by focusing on a niche audience with a specific interest in healthcare, and also to general public, effectively introduced and built a transborder reputation for “VIAGRA”. Thus, this Court would be justified in taking judicial notice of such events to attribute knowledge to the public, acknowledging the widespread recognition that “VIAGRA” attained through these publications. Therefore, the Plaintiff having established reputation in India at the time of Defendants’ adoption of the trademark “VIGOURA”, renders the Defendants’ adoption tainted. Such

²⁴ See: *Cadbury UK Ltd. v. Lotte India Corporation Ltd.*, 2014 SCC OnLine Del.



an adoption was clearly intended to ride upon the goodwill and reputation of Plaintiff's mark. The Court has, in the preceding paragraphs, already ruled that Defendants' trademark "VIGOURA" and its formative marks have a high likelihood of causing confusion, particularly in view of the fact that the impugned mark is being issued for similar pharmaceutical products. There is thus apparent danger of the public getting confused, or at least wondering, whether the products marketed under the impugned "VIGOURA" mark are associated with the products of Plaintiff.

41. These factors lead the Court to conclude that the Defendants' use of the "VIGOURA" mark constitutes a clear case of passing off, undermining the distinctive character and reputation of the Plaintiff's "VIAGRA" trademark. Therefore, keeping the afore-noted legal principles in mind and considering the compelling evidence on record, notable degree of resemblance between the two competing marks, the nature of goods for which these trademarks are applied, and the critical fact that the medicines/pharmaceutical products in question address comparable medical conditions, the Court is persuaded to hold that the Plaintiff has satisfactorily discharged the burden of proof required to establish a case of passing off.

42. Accordingly, the issue is also decided in favour of Plaintiff and against Defendants.

Issue No. 6 (renumbered) - Whether other trademarks resembling and similar to the trademark of the Plaintiff have been registered, as alleged by the Defendants? If so, to what effect? OPD

43. It was one of the primary contentions of the Defendants that there exist multiple entities other than the Plaintiff, who are the registered holders of trademarks concerning pharmaceutical drugs falling under class 05, that



are similar to the mark “VIAGRA”. These products have allegedly been marketed in India much prior to the Plaintiff, with the only difference being that the said marks have been registered in ayurvedic system of medicine or for a different pharmaceutical preparation, whereas the Plaintiff’s mark is under the allopathic system of medicine. Details of such products were provided by the Defendants in their written statement as follows:

<i>Application No.</i>	<i>Class</i>	<i>Trade Marks</i>	<i>Journal No.</i>	<i>Proprietor</i>	<i>Status</i>
1097428	5 (Ayurvedic Medicinal Preparations)	VIGORA	1328/2	Sahil Limited Mangalam Building, 2 nd Floor, 26 Hemanta Basu Sarani, Kolkata-700001	Registered User date 01.01.1998
1150713	5 (Medicine for human consumption, Ayurvedic medicine)	VIGOR PLUS	1328/5	Vipin Oberoi, 1 st Floor, Opp. Octroi post near ESI hospital, Raghunathpuri, Yamuna Nagar	Registered User date 22.10.2002
1208725	5 (Ayurvedic Medicine)	VIGOURMALT (Device)	1328/5	Ajit Ranka, 265-A, Sector E, Sanwer Road, Indore MP	Registered User date 31.10.2002
1253568	5 (Medicinal & Pharmaceutical)	VIGORA	1324/1	Hab Pharmaceutical & Research Ltd. Dewan & Shah Industrial Complex No. 1, Unit No. 18. Sativali Road, Waliv Phata,	Registered User date 14.08.2003



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44. In light of these registrations by third parties, the Defendants contend that their use of the mark “VIGOURA” under the homeopathic system of medicine cannot be presumed to be in violation of the law.

45. The Court remains unconvinced with the Defendants’ argument. It is a well-established principle in trademark law that a Plaintiff’s decision not to pursue legal action against third parties who may possess marks similar to that of the Plaintiff does not preclude them from obtaining an injunctive relief against a specific Defendant in a case of trademark infringement. This legal stance is reinforced by the precedent set by this Court in the case of *Essel Packaging Ltd. v. Sridhar Narra and Anr.*,²⁵ where the Defendants contended that the existence of third parties using a name akin to the Plaintiff’s should mitigate their liability. The Court decisively refuted this argument, emphasizing that the unauthorized use of a trademark by others does not grant a *carte blanche* to the Defendant to infringe upon the trademark in question. The Court noted that such third-party use is irrelevant to the legal analysis of whether the Defendant has violated the Plaintiff’s trademark rights. The primary concern remains the protection of the trademark’s distinctiveness and the prevention of consumer confusion, regardless of actions or inactions taken against other parties. Thus, the infringement and the need for injunctive relief are to be determined by the Defendants’ actions alone, without consideration of third-party use that have

²⁵ 2002 SCC OnLine Del 631.



not been contested by the Plaintiff.

46. Therefore, in absence of any cogent evidence to demonstrate that “VIAGRA” is generic, the Court does not find merit in the averments made by Defendants and this issue is decided against the Defendants and in favour of the Plaintiff.

Issue No. 3 - Whether the Plaintiff is entitled to any damages? If so, the extent thereof? OPP

47. It must, at the first instance, be noted that Pfizer, in the amended plaint, has elected to seek rendition of accounts of the profits earned by the Defendants through the impugned activities. However, in the written submissions filed before the Court on 28th April, 2023, the Plaintiff has requested for a decree of damages against the Defendants. Considering the Plaintiff’s stance, the Court has proceeded to evaluate Pfizer’s claim for damages.

48. Plaintiff’s trademark “VIAGRA” is highly recognized by its name in the sphere of erectile dysfunction drugs, as demonstrated by documentary and oral evidence placed on record. They have invested heavily in building a brand and owing to its success, “VIAGRA” has acquired national and global repute. Consequently, the Defendants’ subsequent adoption of the impugned mark with the knowledge of the Plaintiff’s existence, as attested by DW-1 in his deposition, warrants an award of damages in the Plaintiff’s favour.

49. The Plaintiff has valued their damages’ claim at Rs. 20 lakhs, however, no evidence has been led to prove the damages. PW-1, in her affidavit by way of evidence or cross-examination, has not deposed anything on damages except for stating that Defendants’ adoption was in bad faith



with an effort to take unfair advantage of the Plaintiff's goodwill and reputation. According to her, Rs. 20 lakhs/- is a reasonable assessment of injury caused to the Plaintiff, without an elucidation of how the figure has been determined. The Plaintiff has also not raised any questions in the cross-examination of Defendants' witness which could assist the Court in computing damages, apart from giving a suggestion to DW-1, Mr. Firoz Akhtar, that he is liable to pay damages to Plaintiff. Moreover, there has been no attempt for any discovery by the Plaintiff during the trial to ascertain the loss caused to them. Thus, in absence of any evidence, on the question of computation to damages, the Court is unable to concur with the quantum of damages prayed for. However, since the Defendants have been held to be guilty of infringement and passing off, the Court considers it appropriate to award nominal damages of Rs. 3,00,000/-. Additionally, the Plaintiff is also held entitled to actual litigation cost in terms of the Commercial Courts Act, 2015 and Delhi High Court (Original Side) Rules, 2018 read with Delhi High Court Intellectual Property Division Rules, 2022.

Issue No. 4 - Relief

50. In light of the foregoing discussion, the suit is decreed in favour of the Plaintiff, and against the Defendants as follows:

50.1. The Defendants or anyone acting on their behalf are permanently restrained from manufacturing, selling, or offering for sale, marketing, advertising, or in any other manner using the mark "VIGOURA" or any mark deceptively similar to the Plaintiff's trademark "VIAGRA" in relation to any of their goods as would amount to infringement or passing off of the



Plaintiff's registered mark "VIAGRA".

50.2. The Plaintiff shall be entitled to nominal damages to the tune of Rs. 3,00,000/-, recoverable jointly and severally from the Defendants.

50.3. The Plaintiff shall file their bill of costs in terms of Rule 5 of Chapter XXIII of the Delhi High Court (Original Side) Rules, 2018 on or before 30th May, 2024. As and when the same is filed, the matter be listed before the Taxing Officer for computation of costs.

51. With the above directions, the suit is disposed of.

52. Decree sheet be drawn up.

SANJEEV NARULA, J

MAY, 01 2024

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