

\$~12

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

Date of Decision: 2nd August, 2023

+

CS(COMM) 1098/2016 & I.A.1395/2023

SUN PARMA LABORATORIES LTD. Plaintiff
Through: Mr. Hemant Singh, Mr. Waseem
Shuaib Ahmed, Mr. Sambhav Jain,
Mr. Anuraj Tirthankar, Advs. (M:
9560190709)

versus

MYLAN LABORATORIES LIMITED & ANR. Defendants
Through: Mr. Prithvi Singh and Ms. P. Lalita
Sowmya Priya, Advocates for the
Defendant No. 1. (M: 8826384092)
Mr. Saurabh Kansal, Ms. Ashu
Chaudhary, Mr. Shaurya Sharma and
Mr. Divyam Aggarwal, Advocates for
D-2.

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.
2. The present suit has been filed by the Plaintiff - Sun Pharma Laboratories Ltd. seeking protection of its trademark 'OXIPLAT', which is used by the Plaintiff for marketing pharmaceutical preparations comprising Oxaliplatin. The case of the Plaintiff is that it is a wholly owned subsidiary of Sun Pharmaceutical Industries Limited, which is one of the top five pharma companies of India and was set up in the year 1983. The Plaintiff is a spin off of the parent company, which is stated to have been set up as a domestic formulation division of the parent company.

3. The mark ‘OXIPLAT’ was coined by the Plaintiff in April, 2001 and has been used for medicinal preparations consisting of Oxaliplatin, which is used in treatment of cancer of colon and rectum. The said drug is said to work by stopping or slowing down the growth of cancer cells. The mark ‘OXIPLAT’ of the Plaintiff is registered and the details of the registration are set out herein below:

TRADE MARK	CLASS	REGISTRATION NO. & DATE	Goods
OXIPLAT	5	1003586 dated 16th April, 2001	Medicinal and Pharmaceutical Preparations and substances included in class 5

4. The sales of the Plaintiff for medicinal formulations using the mark ‘OXIPLAT’ have been substantial and at the time of filing of the suit, the sales turnover was aggregating to approximately Rs. 26.5 crore. Substantive investment has also been made in the form of advertising and promotional expenses for the mark ‘OXIPLAT’, of approximately Rs.20 lakhs for the financial year 2013-14 and aggregating to approximately Rs. 1.3 crore.

5. The Plaintiff acquired knowledge of the Defendants’ mark ‘SOXPLAT’ in the first week of October, 2014, through field force/market analysis, and also found that the trademark of the Defendants for the mark ‘SOXPLAT’ bearing no.1550804 dated 18th April, 2007. The same was filed by the Defendants on a proposed to be used basis and was granted registration. The present suit then came to be filed by the Plaintiff seeking permanent injunction of the mark ‘SOXPLAT’.

6. Vide order dated 7th February, 2017, summons were issued in the suit and thereafter, the interim application was rejected by the Court. The same was also appealed to the Id. Division Bench, which was also rejected. The observations of the Id. Division Bench are set out below:

“9. The drug in question is a anti-cancer drug. It is obviously sold on a prescription of a doctor. We doubt whether a chemist would be confused with reference to the phonetics of 'SOXPLAT' and 'OXIPLAT'. The argument of the appellant that the letter 'I' in the trademark 'OXIPLAT' would be silent and thus a person would pronounce the word more akin to 'OXPLAT'. And so pronounced, there would be phonetic similarity with 'SOXPLAT'.

10. Prima-facie where are of the opinion that a person reading the word 'OXIPLAT' would not pronounce it with the letter 'I' being silent. In any case, it would be a matter of evidence.

11. For three reasons we affirm the impugned order. Firstly, the competing trademarks are registered. Secondly, the respondent is admittedly in the market since the year 2009. The suit was filed in the year 2014. Thirdly, prima-facie we do not find any phonetic similarity and likelihood of confusion keeping in view that the drug is an anti-cancer drug and is sold on the prescription of a doctor.' The chemist who sells the drug is an educated person and would know the phonetic difference between 'SOXPLAT' and 'OXIPLAT'.”

7. The suit has thereafter remained pending. In the meantime, the Plaintiff sought cancellation of the Defendants' mark and the Defendants sought cancellation of the Plaintiff's registered trademark. The IPAB vide common order dated 18th June, 2020 in ***Sun Pharma Laboratories Limited and Ors. v. Agila Specialties Private Limited and Ors.***

MANU/IC/0014/2020, cancelled the Defendants' trademark bearing no.1550804 and has dismissed the cancellation petition filed by the Defendants. Thus, as on date, the Defendants are no longer registered for the mark 'SOXPLAT' and the registration in favour of the Plaintiff has been confirmed/upheld by the IPAB. The relevant extracts of the said judgement are extracted as under:

*"36. Two rival marks to be compared as a whole. (See *MANU/SC/0115/1959: AIR 1960 SC 142, MANU/SC/0256/1962: AIR 1963 SC 449 and MANU/SC/0197/1964: AIR 1965 SC 980*) In the case reported in *MANU/SC/0256/1962 : AIR 1963 SC 449 : PTC (Suppl) (2) 1 (SC), Amritdhara Pharmacy v. Satya Deo Gupta* the Apex Court on page 458 and Para 9 has observed as under:*

"We agree that the use of the word "dhara" which literally means 'current or stream' is not by itself decisive of the matter. What we have to consider is the overall similarity of the composite word, having regard to the circumstance that the goods bearing the two names are medicinal preparations of the same description. A critical comparison of the two names may disclose some points of difference but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names" (page 458 Para 9).

37. In the case of MANU/SC/0197/1964 : AIR 1965 SC 980, Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, it is held that in infringing cases only the rival marks are to be compared by the court if the Defendant's mark is closely, visually and phonetically similar then no further evidence is required, even if get up packaging

on the packing of two products in which they are offering their products are different in an action of infringement, the same is immaterial.

XXX

XXX

XXX

41. *McCarthy on Trademarks and Unfair Competition* [J Thomas McCarthy, IV Ed., Clark Boardman Callaghan 2007] under the sub-heading "Comparing Marks: Differences and Similarities". The treatise further states:

"23.15.... The typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall impression created by the mark from the ordinary shopper's cursory observation in the marketplace that will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighed analysis in legal briefs."

"In litigation over the alleged similarity of marks, the owner will emphasize the similarities and the alleged infringer will emphasize the differences. The point is that the two marks should not be examined with a microscope to find the differences, for this is not the way the average purchaser views the marks. To the average buyer, the points of similarity are the more important than minor points of difference. A court should not engage "technical gymnastics" in an attempt to find some minor differences between conflicting marks. However, where there are both similarities and differences in the marks, there must be weighed against one another to see which predominate."



41. As discussed above, and after having gone through the material placed on record and the decisions referred, it is clear that none of decisions relied upon on behalf of Mylan is applicable to the facts and circumstances of the present case. The reasons are given as under:

a). In the cases of Biofarma (supra) Indo Pharma (supra) Apex Laboratory (supra) Panacea Biotec(supra) Schering(supra) and F Heffmann, it is evident that all the above mentioned judgments are delivered prior to the judgment of Cadila case (supra) in the Cadila case all guidelines in pharmaceutical cases, comparisons rules and purchased of drugs through the medical prescription haven changed, After the Cadila case, the trend of pharmaceutical cases is revisited. Two more landmarks decisions were rendered accepting the principles and guidelines of Cadila.

No prominence is given to the concept of doctor prescription in view of grounds situation in the market. Even otherwise the concept of comparison of two rival marks and adoption of the same from name of the salt or from ailments is entirely revisited. The trademark of two parties in similar position ORZID and FORZID are held to be similar in the case of United Biotec(supra) where the salt in question was Ceftazidime was involved couple with the defense of third parties that words ZID was the part of generic name. The said judgment was given by the Division Bench of Hon'ble High Court of Delhi on 18.5.2012, disagreeing with the decision of Astrazeneca (supra) and Indo Pharma (supra)

The facts in the present case are almost identical. The Hon'ble Division Bench has confirmed the orders of IPAB.

b). As regards the other decision referred by the counsel for Mylan in the case of Schering (*supra*) apart of giving the distinguishing the features in earlier para a) it is matter of fact *SMDyechem Limited vs Cadbury India Ltd.* reported in *MANU/SC/0407/2000 : 2000 PTC (20) (SC) 297*, the said decision of the Supreme Court was already overruled by the Supreme Court in *Cadila* matter on the reason that law already settled for the last 50 years was overlooked. However it is surprise to note the overruled judgment was referred and the decision was rendered. Further the case referred in the said decision of *SBL vs Himalaya Drug Company* reported in *MANU/DE/0311/1997 : 1997(17) PTC 540 (DB)* it is matter of fact that the SBL appeal was filed against the order of interim injunction granted against the SBL and the appeal was allowed mainly on the reasons that the product *LIVE 52* was general words. Even after trial the suit was dismissed assigning the same reasons. However in appeal before the Division Bench in *RFA(OS)* the appeal filed by Himalaya (*supra*) was allowed. The judgment passed by the single bench dismissing the suit was set aside. The Suit filed by Himalaya was decree and permanent injunction was passed against SBL.

The rest of many judgments referred by counsel for the Mylan mentioned in this judgment of Schering were not accepted by the recent judgment of the Division Bench of Delhi High Court in the case of *United Biotech (supra)*

Therefore all the decisions referred on behalf of Mylan are distinguishable as per its on facts and the valent decisions rendered by the Supreme Court and High Court post *Cadila* case.

According none of the decisions will help the case of Mylan. Apart from above Mylan has miserably failed to make out any case on merit in its favour.

42. As regards ORA 1 of 2016 are concerned, it is false and frivolous petition. It appears that it is filled as counter blast to the suit and rectification filed by Sun Pharma. There is no merit at all in view of reasons mentioned above. The same is dismissed

43. With regards to ORA 55 of 2015, **Sun Pharma has been able to make a strong case in its favour. IPAB holds that the mark OXPLAT is coin word and was registrable. The trade mark of the Mylan SOXCLAT is deceptively similar.**

If rival trademark of both parties are compared as a whole, it is similar. Sun Pharma is the prior in adoption and user of the Trademark than Mylan and other third parties registration referred by Mylan.

Trademark no. 1550804 in class 5 was wrongly registered and wrongly remaining on the Register. The entry of the said trademark offends under Section 11, 18, 32 and 57 of the Act.

44. In order to maintain purity of the register, it is removed from the Register forthwith. The respondent no 2 shall remove the entry immediately. From the record”

8. It is in this context that the Plaintiff has filed an application seeking summary judgement, under Order XIII-A Rule 3 CPC. The contention of Mr. Hemant Singh, Id. Counsel for the Plaintiff is that the findings of the IPAB would operate as *res-judicata* between the same parties. Since the said judgment of the IPAB has not been challenged by the Defendants, the Defendants can no longer use the mark ‘SOXPLAT’.

9. On behalf of the Defendants, Mr. Prithvi Singh, Id. Counsel submits

that his client has already given up use of the mark ‘SOXPLAT’. In addition, the Defendants are willing to pay a sum of Rs. 3 lakhs as costs to the Plaintiff. Insofar as the costs are concerned, Mr. Hemant Singh, Id. Counsel submits that the actual costs incurred are to the tune of Rs.11 lakhs and following the recent decision of the Supreme Court, the decree deserves to be passed and complete costs ought to be awarded to the Plaintiff.

10. The Court has considered the matter. The present application under Order XIII-A Rule 3 CPC is one seeking summary judgment. This Court has in *Rockwool International A/S & Anr. v. Thermocare Rockwool (India) Pvt. Ltd., 2018:DHC:6774*, considered the necessary conditions for passing summary judgement. The kind of cases that can be decided in a summary manner have to be those cases where a party has no real prospect of succeeding in the claim. A perusal of Order XIII A Rule 3 as amended by the Commercial Courts Act, 2005 reads as under:

*“Order XIII-A Summary Judgment 1.....2.....
3. Grounds for summary judgment. – The Court may give a summary judgment against a plaintiff or defendant on a claim if it considers that –
(a) the plaintiff has not real prospect of succeeding on the claim or the defendant has no real prospect of successfully defending the claim, as the case may be;
and
(b) there is no other compelling reason why the claim should not be disposed of before recording of oral evidence.”*

11. The pre-conditions for passing of a summary judgment under Order XIII A Rule 3 CPC, as elucidated in *Rockwool International (supra)* are:

- i) that there is no real prospect of a party succeeding in a claim;
- ii) that no oral evidence would be required to adjudicate the matter;

iii) there is a compelling reason for allowing or disallowing the claim without oral evidence.

12. A Division Bench of this Court in ***Bright Enterprises Private Ltd. and Ors. v. MJ Bizcraft and Ors. 2017 (69) PTC 596 (Del)*** has held that the procedure under Order XIII A has to be scrupulously followed. Relevant portion of the judgment reads as under:

“ ...

20.....*It is true that Rule 3 of Order XIII A CPC empowers the Court to give a summary judgment against a plaintiff or defendant on a claim if it considers that – (a) the plaintiff has no real prospect of succeeding on the claim or the defendant has no real prospect of successfully defending the claim, as the case may be; and (b) there is no other compelling reason why the claim should not be disposed of before recording of oral evidence. But, in our view, this power can only be exercised upon an application at any date only after summons have been served on the defendant and not after the Court has framed issues in the suit. In other words, Order XIII A Rule 2 makes a clear stipulation with regard to the stage for application for summary judgment. The window for summary judgment is after the service of summons on the defendant and prior to the Court framing issues in the suit.*

21. **The provisions relating to summary judgment which enables courts to decide claims pertaining to commercial disputes without recording oral evidence are exceptional in nature and out of the ordinary course which a normal suit has to follow. In such an eventuality, it is essential that the stipulations are followed scrupulously otherwise it may result in gross injustice.** As pointed out above, a specific period of time has been provided during which an application for summary judgment can be made. That period



begins upon the service of summons on the defendant and ends upon the court framing issues in the suit. Even if we were to accept, which we do not, the argument of the respondents that the Court had suo moto powers to deliver summary judgment without there being any application, those powers also would have to be exercised during this window, that is, after service of summons on the defendant and prior to framing of issues. In addition to this, we also reiterate that, in our view, a summary judgment under Order XIII A CPC is not permissible without there being an appropriate application for summary judgment. The contents of an application for summary judgment are also stipulated in Rule 4 of Order XIII A. The application is required to precisely disclose all material facts and identify the point of law, if any. In the event, the applicant seeks to rely on any documentary evidence, the applicant must include such documentary evidence in its application and identify the relevant content of such documentary evidence on which the applicant relies. The application must also state the reason why there are no real prospects of succeeding or defending the claim, as the case may be.

13. Insofar as the procedural requirements for Order XIII A CPC are concerned, as laid down by a Division Bench of this Court in ***Bright Enterprises Private Ltd. (supra)***, the same have been complied with. The requisite application seeking summary judgment has been filed by the Plaintiff. Grounds have been succinctly set out therein and the Defendant has also replied to the said application for summary judgement.

14. The circumstances and facts of the case as recorded above would show that insofar as the mark ‘SOXPLAT’ is concerned, there is no longer any dispute that exists between the parties as the Defendants have already given up the mark ‘SOXPLAT’, for whatever reasons. Thus, without

rendering any opinion on the similarity or otherwise of the two marks 'OXIPLAT' and 'SOXPLAT', the Defendants' submission is recorded and the Defendants shall be bound by the said statement that they do not wish to use the mark 'SOXPLAT' or any other mark, which is identical and similar to the mark 'OXIPLAT'. The suit is, thus, decreed in terms of paragraph 26(a) & (b) of the prayer clause in the plaint.

15. The Defendants have made a statement today that they do not have any stock of the goods of medicines bearing the mark 'SOXPLAT', which they have discontinued since November, 2022. Thus, prayer 26(c) has become infructuous.

16. Insofar as the damages and costs are concerned, in the opinion of this Court, the following factors are borne in mind.

- (i) The suit has remained pending and there was no interim injunction during this entire period against the Defendants. In fact, the Id. Single Judge and the Id. Division Bench have held against the Plaintiff and not granted an interim injunction.
- (ii) The IPAB has rendered its decision only as in 2020. Immediately thereafter, the Defendants have given up the mark 'SOXPLAT'.
- (iii) The mark of the Defendants also stands removed from the Register.

17. Accordingly, in these facts and circumstances, this Court is of the opinion that the interest of the Plaintiff would be suitably served by awarding costs of Rs.5 lakhs. The costs shall be paid within eight weeks from today.

18. Decree sheet be drawn accordingly.

19. The suit is, thus, decreed and disposed of. All pending applications

are also disposed of.

**PRAITHIBA M. SINGH
JUDGE**

AUGUST 2, 2023/dk/am

