



2026:DHC:3574



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

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Judgment Reserved on: 19th March, 2026
Judgment pronounced on: 28th April, 2026

+ **CS(COMM) 120/2016**

SANOFI

.....Plaintiff

Through: Mr. Pravin Anand, Ms. Vaishali Mittal
and Mr. Siddhant Chamola, Advocates

versus

INTAS PHARMACEUTICALS LTD. & ANR.Defendants

Through: Mr. Rajiv Nayar and Mr. C.M. Lall,
Senior Advocates with Ms. Vrinda
Pathak, Mr. P.S. Manjunathan,
Ms. Rinkoo Kakkar, Ms. Annanya,
Mr. Rajnish Kumar and Ms. Sandhya
Kukreti, Advocates

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

JUDGMENT

AMIT BANSAL, J.

1. The present suit has been filed seeking relief of permanent injunction restraining the defendants from infringing the trade marks of the plaintiff and from passing off of their goods as those of the plaintiff along with other ancillary reliefs.

CASE SETUP BY THE PLAINTIFF

2. Brief facts relevant for adjudicating the present suit are as follows:

2.1. The plaintiff, a company registered under the laws of France, is engaged in research, development, manufacturing and marketing of *inter alia* medicinal and pharmaceutical preparations.



2.2. The plaintiff is one of the world's leading pharmaceutical companies and has over the years manufactured and sold a number of pharmaceutical products under several trade marks across the world including India.

2.3. One of the most renowned drugs of the plaintiff is its anti-thrombosis drug, namely PLAVIX which helps prevent heart attacks and strokes.

2.4. The trade mark PLAVIX was coined in the year 1995.

2.5. The plaintiff filed an application bearing no.806651 for registration of the device mark **Plavix** in class 5 on 17th June 1998, which was granted on 25th August 2005. The plaintiff also filed an application bearing no.652794 for registration of the word mark PLAVIX in class 5 on 20th January 1995, which was pending at the time of filing of the present suit. However, subsequently, the word mark PLAVIX got registered on 13th August 2013.

2.6. The plaintiff's drug under the mark PLAVIX was launched globally in the year 1998 and in the Indian market in January 2003.

2.7. The plaintiff's goodwill and reputation under the mark PLAVIX is evident from its net global sales. The plaintiff's global sales figures (in million Euros) under the mark PLAVIX since the year 2003 are set out below:

Year	Global Sales Figures
2003	12 688
2004	24 931
2005	59 048
2006	91 582
2007	113 878
YTD May 2008	53 686

2.8. The plaintiff has also extensively advertised and promoted its drug under the mark PLAVIX through internet articles, medical journals and other



literature across the world including India. The plaintiff's drug under the mark PLAVIX is also recognized by medical practitioners as synonymous with heart-care treatment. The aforesaid has resulted into greater recognition of the mark PLAVIX and its association with the plaintiff. The plaintiff's advertisement expenses since the year 2004 are set out below:

Year	Advertisement Expenses
2003	-
2004	139
2005	2 948
2006	4 547
2007	6 290
YTD May 2008	4 313

2.9. A search for the term 'PLAVIX' on Google search engine results in links pertaining to the plaintiff's drug. Further, Wikipedia page for *Clopidogrel* also associates it with the plaintiff's drug PLAVIX. The plaintiff has therefore acquired immense and valuable common law rights over the mark PLAVIX.

2.10. The defendant no.1, a company based in Ahmedabad, is engaged in the business of manufacturing and selling pharmaceutical products. The defendant no.2 is engaged in the marketing of products of the defendant no.1 including those under the mark CLAVIX (hereinafter 'impugned mark'/'CLAVIX'). Both the defendants shall hereinafter be collectively referred to as the 'defendant', unless otherwise provided.

2.11. The plaintiff first became aware of the defendant's use of the impugned mark in relation to identical medicinal preparations in or around mid-2005 through its marketing representative.



2.12. In 2008, the plaintiff learnt that the defendant no.1 had filed an application bearing no.1634650 for registration of the impugned mark in class 5 on 26th December 2007. The said application was opposed by the plaintiff on 10th July 2009.

3. Accordingly, the present suit was filed seeking the following reliefs:

aa) An order for permanent injunction restraining the defendants, their proprietor or partners as the case may be, their principal officers, servants and agents, dealers, distributors and all other representatives, from manufacturing, selling, offering for sale medicinal preparations and other allied or cognate goods under the mark CLAVIX or any other mark that is identical with or deceptively similar to the plaintiff's label/ trade mark registered under no. 806651 in class 5 amounting to infringement thereof.

a) An order for permanent injunction restraining the defendants, their proprietor or partners as the case may be, their principal officers, servants and agents, dealers, distributors and all other representatives, from passing off their medicinal preparations as those of the plaintiff by the use of the trade mark CLAVIX or any other that is identical or deceptively similar to the plaintiff's trade mark PLAVIX or doing any other thing amounting to a misrepresentation of the defendants' goods as those of the plaintiff;

b) An order for delivery up by the defendants of all the goods, labels, dies, blocks, negatives, packaging material, cartons, printed matter, unfinished products and any other material bearing the impugned mark CLAVIX to the authorized representative of the plaintiff for the purpose of destruction/ erasure;

c) An order for damages of INR 1,00,00,000 to be paid by the defendants on account of use of the impugned trade mark and name CLAVIX and also for loss of reputation;

d) An order of rendition of account of profit illegally earned by the defendants on account of use of the impugned trade mark and grant of a decree in favour of the plaintiff for an amount so ascertained;

e) An order for costs of the proceedings

CASE SETUP IN THE WRITTEN STATEMENT

4. The defendants filed a written statement raising preliminary issues as well as defences on merits, which are as follows:



4.1. The defendant derived the impugned mark CLAVIX from Clopidogrel, being the active ingredient, and its therapeutic indication viz Atherosclerotic Vascular Incidences. The last letter X in the impugned mark indicates reduction in the reoccurrence of acute events.

4.2. The defendant coined and adopted the impugned mark in the year 2001 and has been using the same since then.

4.3. The defendant obtained necessary approvals from the relevant authorities for manufacturing of CLAVIX tablets on 27th June 2001 and 12th July 2001.

4.4. The defendant no.1 applied for registration of the impugned mark in class 5 *vide* application no.1634650 dated 26th December 2007 and the same is pending.

4.5. Since the adoption and first use of the impugned mark in 2001, the defendant has built up an enviable reputation thereunder. The defendant's sales figures under the impugned mark since the financial year 2001-02 are set out below:

<u>Year</u>	<u>Sales (Rs. In crores)</u>
2001-02	2.14
2002-03	5.84
2003-04	11.71
2004-05	15.37
2005-06	12.03
2006-07	16.04
2007-08	16.69
2008 till Jan'09	17.89

4.6. The defendant has spent a huge amount of money for promoting the sale of its drug under the impugned mark such as through publicity media



covering specialty doctors, hospitals, chemists, symposiums, CME programs, medical journals, etc. The defendant's marketing expenditure figures towards the impugned drug since the financial year 2001-02 are set out below:

<u>Year</u>	<u>Expenses (Rs. In crores)</u>
2001-02	0.33
2002-03	0.72
2003-04	0.77
2004-05	0.79
2005-06	0.66
2006-07	1.00
2007-08	0.98
1.4.2008 to 31.1.2009	0.85

4.7. The defendant's drug under the impugned mark has acquired distinctiveness and enjoys great reputation and goodwill among the medical professionals and other members of trade and public across India.

5. In its replication, the plaintiff has reaffirmed its assertions made in the plaint. Additionally, the plaintiff has provided its global sales figures (in million Euros) since the year 1998, which are reproduced below:

YEAR	GLOBAL SALES FIGURES
1998	136
1999	635
2000	1279
2001	2033
2002	2587



PROCEEDINGS IN THE SUIT

6. Summons in the suit were issued on 12th December 2008.
7. The defendants entered appearance on 11th February 2009.
8. The suit was initially filed only as an action for passing off. The plaintiff filed an application, being I.A. 8876/2009, seeking amendment of plaint in order to make averments in relation to infringement of its registered trade mark and seek a decree of permanent injunction on the basis of infringement. The said application was allowed on 4th September 2009 and the plaint was amended *qua* inclusion of averments in relation to infringement of the mark **Plavix**.
9. On 17th March 2010, the following issues were framed in the present suit:

1. *Whether the plaintiff is the registered proprietor/ owner of the mark PLAVIX, as claimed? **OPP***
2. *Whether the defendant's use of the mark CLAVIX constitutes infringement and/ or passing off of the plaintiff's mark/ label PLAVIX? **OPP***
3. *Whether the defendant's mark CLAVIX is deceptively similar to the plaintiff's mark PLAVIX? **OPP***
4. *Whether the defendant's trade mark CLAVIX does not infringe the plaintiff's registered mark PLAVIX, as a result of Section 17 of the Trade Marks Act, 1999? **OPD***
5. *Whether the defendant is the prior and/ or bona fide user of the mark CLAVIX for medicinal products in India? **OPD***
6. *Whether there is any delay in filing the present suit?*
7. *Relief.*

10. The plaintiff filed an application, being I.A. 12027/2011, seeking to place additional documents on record. On 1st August 2011, the Court allowed the said application and permitted the additional documents filed on behalf of



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the plaintiff along with the affidavits of its witnesses to be taken on record, reserving the right of the defendant to object to the said additional documents.

11. The plaintiff changed its name from Sanofi Aventis to Sanofi and filed an application, being I.A. 184/2012, to bring the aforesaid change of name on record. The Court allowed the aforesaid application *vide* order dated 6th January 2012.

12. The plaintiff filed an application, being I.A. 185/2012, for appointment of a local commissioner to record evidence in the suit. The said application was allowed on 28th March 2012 and the Court appointed Mr. Raman Kapur, senior advocate as the local commissioner for recording of evidence of the parties.

13. The plaintiff filed I.A. 6930/2013 for amending the list of witnesses and I.A. 6931/2013 seeking leave to place additional documents on record. On 4th January 2014, the Joint Registrar dismissed I.A. 6931/2013. *Vide* the same order, the plaintiff was permitted to lead evidence of its additional witness Mr. Subarto Panda.

14. The plaintiff filed a chamber appeal against the aforesaid order passed by the Joint Registrar. *Vide* order dated 19th March 2014, the chamber appeal was allowed subject to costs. Accordingly, the documents mentioned at serial numbers 1 to 7, 10 and 11 of Annexure A to I.A. 6931/2013 were permitted to be taken on record and the plaintiff was also permitted to examine its additional witness Ms. Kalpana Jaswal. However, the documents mentioned at serial numbers 8 and 9 of Annexure A to I.A. 6931/2013 were not pressed by the plaintiff in the chamber appeal.



15. On 14th July 2015, the Court allowed the defendant's application, being I.A. 11737/2015, seeking leave to place additional documents on record subject to costs.

16. The plaintiff filed an application, being I.A. 25880/2015, seeking amendment of plaint, *i.e.*, paragraph 18 (regarding alleged loss suffered by the plaintiff from several lakhs to crores), paragraph 21 (valuation clause from Rs. 20,01,800/- to Rs. 2,00,01,300/-) and paragraph 22 (prayer clause claiming damages of Rs. 1 crore). On 5th January 2016, the said application was allowed. On the same date, the Registry was directed to re-register the suit and assign it a fresh number as the present suit involves a commercial dispute.

17. The following witnesses appeared on behalf of the plaintiff:

- (i) Mr. Tarun Bhatnagar (PW-1)
- (ii) Ms. Kalpana Jaswal (PW-2)
- (iii) Mr. Subroto Panda (PW-3)
- (iv) Mr. Rajesh Oberoi (PW-4)

18. On behalf of the defendant, Mr. Chandrashekhar Yagnik appeared as the sole witness.

19. As per the report of the local commissioner, the recording of evidence of the parties was closed on 23rd April 2018.

20. I have heard submissions on behalf of the parties on 10th January 2025, 15th January 2025, 18th February 2025, 20th March 2025, 15th May 2025, 18th July 2025, 1st August 2025, 31st October 2025, 5th December 2025, 16th February 2026 and 19th March 2026, when the judgment was reserved.

21. My issue-wise findings are as under:



Issue no.1 – Whether the plaintiff is the registered proprietor/ owner of the mark PLAVIX, as claimed? OPP

22. At the outset, the defendant has raised an objection that the plaintiff is not the registered proprietor/ owner of the mark PLAVIX as the plaintiff in the present suit is Sanofi Aventis whereas the application for registration of the mark PLAVIX has been filed in the name of Sanofi. It is thus submitted that the plaintiff has failed to show the flow/ transfer of rights over the mark PLAVIX in its favour.

23. It is submitted on behalf of the plaintiff that an entity Sanofi Synthelabo had acquired the pharmaceutical and lab testing company Aventis and changed its name to Sanofi Aventis in August 2004. Later on, in May 2011, the plaintiff's name was changed to Sanofi.

Analysis

24. It is an undisputed position that the word mark PLAVIX is registered in the name of Sanofi and the device mark **Plavix** is registered in the name of Sanofi Synthelabo. The plaintiff has placed on record the legal proceeding certificates in respect of the registrations obtained for the aforesaid trade marks. The details of the aforesaid legal proceeding certificates are as follows:

- a. Trade mark application for the word mark PLAVIX bearing no.652794 filed on 20th January 1995 in class 5, registered in the name of Sanofi on 13th August 2013 [**Exhibit PW-4/3** and **Exhibit PW-4/4**].
- b. Trade mark application for the device mark **Plavix** bearing no.806651 filed on 17th June 1998 in class 5, registered in the name of



Sanofi Synthelabo on 25th August 2005 [**Exhibit PW-1/9, Exhibit PW-4/1 and Exhibit PW-4/2**].

25. Mr. Tarun Bhatnagar, PW-1 has deposed in his evidence that the application for the device mark **Plavix** was initially filed in the name of Sanofi Synthelabo, the plaintiff's predecessor. Subsequent to change of name of the plaintiff from Sanofi Aventis to Sanofi, it has taken necessary steps to record the change of name before the Registrar of Trade Marks by filing the form TM-33, which has been marked as **Mark K**.

26. As noted above, issues were framed in the present suit on 17th March 2010. The objection taken on behalf of the defendant that the plaintiff in the present case is Sanofi Aventis whereas the mark PLAVIX has been applied for registration by Sanofi, no longer survives in view of the amendment of plaint carried out in terms of the order dated 6th January 2012 wherein it was noted that the name of the original plaintiff Sanofi Aventis has been changed to Sanofi. A copy of the commercial register evidencing the change of name of the plaintiff on 6th May 2011 has also been filed [**Exhibit PW-1/23**].

27. In view of the above, the issue no.1 is decided in favour of the plaintiff.

Issue no.2 – Whether the defendant's use of the mark CLAVIX constitutes infringement and/ or passing off of the plaintiff's mark/ label PLAVIX? OPP

Issue no.3 – Whether the defendant's mark CLAVIX is deceptively similar to the plaintiff's mark PLAVIX? OPP

Issue no.4 – Whether the defendant's trade mark CLAVIX does not infringe the plaintiff's registered mark PLAVIX, as a result of Section 17 of the Trade Marks Act, 1999? OPD



Issue no.5 – Whether the defendant is the prior and/ or bona fide user of the mark CLAVIX for medicinal products in India? OPD

28. Since all the aforesaid issues are connected, I shall take them up for adjudication together.

29. Issue no.2 is premised on infringement as well as passing off. First, I shall take up the aspect of infringement.

Submissions of the plaintiff – Infringement

30. Insofar as infringement is concerned, the plaintiff has made the following submissions:

30.1. The plaintiff is the registered proprietor of the word mark PLAVIX with effect from 20th January 1995 and the device mark **Plavix** with effect from 17th June 1998 in class 5. On the other hand, the defendant's impugned mark CLAVIX has not been registered till date.

30.2. The defendant's alleged use of the impugned mark since 2001 is subsequent to the date of registration of the plaintiff's marks PLAVIX and **Plavix**. Thus, the defendant is not entitled to a defence under Section 34 of the Trade Marks Act, 1999 (hereinafter 'Act').

30.3. The impugned mark is visually, structurally and phonetically similar to the plaintiff's marks. The defendant has merely substituted the letter 'P' in the plaintiff's mark with the letter 'C' to form the impugned mark.

30.4. The word PLAVIX is the essential element of the mark **Plavix**. Therefore, Section 17 of the Act is not attracted in the present case.



30.5. The competing marks are used for identical pharmaceutical preparation with the active ingredient *Clopidogrel bisulphate* and are used in relation to an anti-thrombosis drug.

30.6. As the competing marks are deceptively similar, and the competing products are identical and are sold side-by-side in pharmacies, likelihood of confusion is inevitable and a case for infringement is made out under Section 29 of the Act.

30.7. Even if the competing products are categorized under Schedule H of the Drugs and Cosmetics Rules, 1945, the plaintiff's claim for infringement is not diluted as likelihood of confusion still subsists on account of factors such as negligence or mistake in reading the prescription, etc.

30.8. It is well settled that courts must be stricter in assessing likelihood of confusion in infringement/ passing off disputes involving medicinal products especially in a country like India where the ordinary consumer may be illiterate or semi-literate and the potential for harm is much higher. Further, the competing products are of an emergency/ life-saving nature and thus extra caution ought to be exercised. Reliance is placed on *Cadila Health Care v. Cadila Pharmaceuticals*¹.

Submissions of the plaintiff – Dishonest Adoption

30.9. The reasoning given by the defendant to adopt the impugned mark is dishonest and merely an afterthought. The term *Atherosclerotic Vascular Incidences* does not exist in medical literature. The correct term for the disease is *Atherosclerotic Cardiovascular Disease* (ASCVD). Further, the letter X

¹ 2001 SCC OnLine SC 578



denotes an increase/ multiplication of activities, and not a reduction as asserted by the defendant.

30.10. The defendant was already using the marks PREVA and PRASUGEL for the impugned drug and had no *bona fide* reason to adopt a deceptively similar impugned mark. The reason for adoption of the impugned mark is only to boost sales by causing confusion in the market and association with the plaintiff's drug.

30.11. The defendant failed to show proof of having carried out any market survey or search on the database of the Trade Marks Registry before adopting the impugned mark. Reliance in this regard is placed on the judgments in *FMI v. Midas Touch Metalloys*², *Adidas AG v. Keshav H. Tulsiani*³ and *Himalaya Wellness Company v. Wipro Enterprises*⁴.

Submissions of the defendant – Infringement

31. With respect to the issue of infringement, the defendant has made the following submissions:

31.1. The defendant's use of the impugned mark since 2001 is not disputed by the plaintiff. Being the user of the impugned mark since 2001 as opposed to the plaintiff's alleged use of the mark PLAVIX in India since 2003, the defendant is the prior user of the impugned mark.

31.2. The plaintiff has failed to place any documentary evidence on record to show use of the mark PLAVIX in India until the year 2006. Since the plaintiff has failed to use the mark PLAVIX in India till 2006, the defendant is entitled to the defence under Section 34 of the Act. Reliance is placed on the

² 2025 SCC OnLine Del 4

³ 2024 SCC OnLine Del 4940

⁴ 2023 SCC OnLine Del 4035



judgement of the Supreme Court in *Neon Laboratories v. Medical Technologies*⁵.

31.3. First letter of any mark is the most significant, which, in the present case, is phonetically and visually different in both the competing marks. Thus, the competing marks are significantly dissimilar.

31.4. The plaintiff obtained registration for the mark PLAVIX despite opposition by a third-party which owned the mark FLAVIX. Thus, the competing marks in the present case, having different first letters, cannot be contended to be similar.

31.5. A single bench of the High Court of Punjab and Haryana has also held that the marks FLAVIX and CLAVIX are phonetically, structurally and visually different. Thus, the competing marks in the present suit ought to be held different in order to maintain judicial consistency.

31.6. In any event, the amended plaint filed by the plaintiff asserts infringement of the mark **Plavix**. Thus, the plaintiff cannot assert any right over the word mark PLAVIX in terms of Section 17 of the Act.

31.7. The competing products are completely distinct in their overall getup, look and appearance. The packaging, colour scheme, price, etc. of the competing products are different in the present case, which factors are sufficient to rule out any likelihood of confusion between the competing marks.

31.8. The plaintiff has failed to provide any proof of likelihood of confusion or actual confusion also on account of the fact that both the competing products are Schedule H medicines, which requires a medical prescription for

⁵ 2015 SCC OnLine SC 905



its dispensation. This precludes any likelihood of confusion or deception in the minds of the purchasing public or members of the trade.

Submissions of the defendant – Dishonest Adoption

31.9. The defendant *bona fide* adopted the impugned mark CLAVIX, *i.e.*, the letters *Cl* from *Clopidogrel* being the active ingredient and the letters *AVI* from its therapeutic indication *viz Atherosclerotic Vascular Incidences*. The letter *X* indicates variables and such use of the letter *X* is common in medicinal and non-medicinal products.

Analysis – Infringement

32. The plaintiff is the registered proprietor of the word mark PLAVIX and the device mark **Plavix** in class 5. The registration of the device mark **Plavix** was granted in favour of the plaintiff on 25th August 2005 with effect from 17th June 1998 [**Exhibit PW-1/9**, **Exhibit PW-4/1** and **Exhibit PW-4/2**] and of the word mark PLAVIX was granted in favour of the plaintiff on 13th August 2013 with effect from 20th January 1995 [**Exhibit PW-4/3** and **Exhibit PW-4/4**].

33. The defendant applied for registration of the impugned mark CLAVIX in class 5 on 26th December 2007 with the user claim since 12th July 2001 [**Exhibit DW-1/4**]. However, it is an admitted position that the registration is yet to be granted in favour of the defendant on account of opposition filed by the plaintiff.

34. As per Section 29(1) of the Act, a registered trade mark is infringed by a person who, not being a registered proprietor, uses, in the course of trade, a mark identical with or deceptively similar to the mark in relation to goods or



services in respect of which it is registered. In terms of Section 29(2)(b) of the Act, infringement would occur when a person, who is not a registered proprietor, uses, during the course of trade, a similar mark in relation to similar or identical goods in respect of which the trade mark is registered and such use is likely to cause confusion.

35. The Supreme Court, in *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*⁶, highlighted the distinction between the ingredients for an action for passing off and an action for infringement of trade marks in light of Section 21 of the Trade Marks Act, 1940, which is *pari materia* with Section 29 of the Trade Marks Act, 1999. The relevant observations of the Supreme Court in *Kaviraj Pandit* (supra) are set out below:

“28. ...While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered, trade mark for the vindication of "the exclusive right to the use of the trade mark in relation to those goods" (Vide S. 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up,

⁶ 1964 SCC OnLine SC 14



packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

29. *When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide S. 21). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". **But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark.***

The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff."

[emphasis supplied]


36. The legal position that emerges from the aforesaid judgement can be summarized as under:



- (a) Infringement is a statutory remedy available to a registered proprietor of a trade mark whereas passing off is a common law remedy.
- (b) In an action for infringement, where the similarity between the competing marks is evident and the Court reaches the conclusion that there is imitation, no further evidence is required to establish that the plaintiff's rights are violated.
- (c) When the competing marks are not identical, the plaintiff is required to establish that the impugned mark is deceptively similar to the plaintiff's registered trade mark and the same is likely to deceive or cause confusion.

37. The aforesaid judgment has been consistently followed by courts across India including the Supreme Court and this Court [*please see Ramdev Food Products v. Arvindbhai Rambhai Patel*⁷, *Renaissance Hotel Holdings v. B. Vijaya Sai*⁸ and *Zydus Wellness Products v. Cipla Health*⁹].

38. At this stage, it may be apposite to compare the registered trade marks of the plaintiff with the impugned mark of the defendant.

Plaintiff's Marks	Defendant's Impugned Mark
PLAVIX 	CLAVIX

39. The plaintiff's mark PLAVIX is a coined term and thus inherently distinctive. It does not bear any reference to the active ingredient the drug is derived from or the ailment it is prescribed for. Hence, the plaintiff's mark qualifies for the highest level of protection.

⁷ (2006) 8 SCC 726

⁸ (2022) 5 SCC 1

⁹ 2023 SCC OnLine Del 3785



40. From the aforesaid comparison, it is apparent that the impugned mark used by the defendant is phonetically and structurally similar to that of the plaintiff. The only difference is that the defendant has replaced the letter ‘P’ with the letter ‘C’ in the impugned mark.

41. It is a settled position of law that similarity between the competing marks is to be ascertained by comparing the marks as a whole and similarity is to be approached from the point of view of a man of average intelligence and imperfect recollection. A reference in this regard may be made to *Corn Products Refining v. Shangrila Food Products*¹⁰, wherein the competing marks were GLUCOVITA and GLUVITA. The Supreme Court found the competing marks to be similar. The relevant extracts from *Corn Products* (supra) are set out below:

“18. ...It is well recognized that in deciding a question of similarity between two marks, the marks have to be considered as a whole. So considered, we are inclined to agree with Desai, J., that the marks with which this case is concerned are similar. Apart from the syllable ‘co’ in the appellant’s mark, the two marks are identical. That syllable is not in our opinion such as would enable the buyers in our country to distinguish the one mark from the other.

19. We also agree with Desai, J., that the idea of the two marks is the same. The marks convey the ideas of glucose and life giving properties of vitamins. The Aquamatic Case (Harry Reynolds v. Laffeaty’s Ld.) [1958 RPC 387] is a recent case where the test of the commonness of the idea between two marks was applied in deciding the question of similarity between the two marks we have to approach it from the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonably likely to cause a confusion between them.”

[emphasis supplied]

42. In *Cadila* (supra), it has been held that in respect of pharmaceutical

¹⁰ 1959 SCC OnLine SC 11



products, the Court should adopt a strict approach while determining possibility of confusion as any confusion could result in detrimental effect on the health of members of the public. It was also held that merely the fact that a drug is prescription based does not rule out likelihood of confusion. The relevant extracts from *Cadila* (supra) are set out below:

“27. As far as the present case is concerned, although both the drugs are sold under prescription but this fact alone is not sufficient to prevent confusion which is otherwise likely to occur. In view of the varying infrastructure for supervision of physicians and pharmacists of medical profession in our country due to linguistic, urban, semi-urban and rural divide across the country and with high degree of possibility of even accidental negligence, strict measures to prevent any confusion arising from similarity of marks among medicines are required to be taken.

32. Public interest would support lesser degree of proof showing confusing similarity in the case of trade mark in respect of medicinal products as against other non-medicinal products. Drugs are poisons, not sweets. Confusion between medicinal products may, therefore, be life threatening, not merely inconvenient. Noting the frailty of human nature and the pressures placed by society on doctors, there should be as many clear indicators as possible to distinguish two medicinal products from each other. It is not uncommon that in hospitals, drugs can be requested verbally and/or under critical/pressure situations. Many patients may be elderly, infirm or illiterate. They may not be in a position to differentiate between the medicine prescribed and bought which is ultimately handed over to them...

33. The decisions of English courts would be relevant in a country where literacy is high and the marks used are in the language which the purchaser can understand. While English cases may be relevant in understanding the essential features of trade mark law but when we are dealing with the sale of consumer items in India, you have to see and bear in mind the difference in situation between England and India. Can English principles apply in their entirety in India with no regard to Indian conditions? We think not. In a country like India where there is no single common language, a large percentage of population is illiterate and a small fraction of people know English, then to apply the principles of English law regarding dissimilarity of the marks or the customer knowing about the distinguishing characteristics of the plaintiff's goods seems to overlook the ground realities in India. While examining such cases in India, what has to be kept in mind is the purchaser of such goods in India who may have absolutely no knowledge of English language or of the



*language in which the trade mark is written and to whom different words with slight difference in spellings may sound phonetically the same. While dealing with cases relating to passing off, one of the important tests which has to be applied in each case is whether the misrepresentation made by the defendant is of such a nature as is likely to cause an ordinary consumer to confuse one product for another due to similarity of marks and other surrounding factors. What is likely to cause confusion would vary from case to case. **However, the appellants are right in contending that where medicinal products are involved, the test to be applied for adjudging the violation of trade mark law may not be on a par with cases involving non-medicinal products. A stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by the consumer. While confusion in the case of non-medicinal products may only cause economic loss to the plaintiff, confusion between the two medicinal products may have disastrous effects on health and in some cases life itself. Stringent measures should be adopted specially where medicines are the medicines of last resort as any confusion in such medicines may be fatal or could have disastrous effects. The confusion as to the identity of the product itself could have dire effects on the public health.***

[emphasis supplied]

43. In the present case, the products of the plaintiff and the defendant are medicinal products having an identical active ingredient and are used for treatment of the same disease. Viewed in this light, the likelihood of confusion on the part of the public, who could be patients, would be very high as the only difference between the competing marks is of a single letter.

44. Senior counsel appearing on behalf of the defendant seeks to distinguish *Cadila* (supra) on the ground that in the said judgment, the competing drugs had different uses.

45. Undoubtedly, *Cadila* (supra) was in the context of two medicinal products having different uses, however, the observations in *Cadila* (supra) would be equally applicable if the two competing medicinal products have the same salt and are used for treatment of the same disease. In fact, the likelihood of confusion with respect to source and origin of the impugned product would



be higher when the two competing drugs have the same salt and are used for treatment of the same disease.

46. On behalf of the defendant, it is submitted that as the first letter of the competing marks are different, there exists significant dissimilarity between the competing marks. Reliance in this regard is placed on the following judgments:

- (i) ***F. Hoffman-La Roche v. Geoffrey Mannors***¹¹
- (ii) ***Abbott GmbH v. Registrar of Trade Marks***¹²
- (iii) ***Cadila Laboratories v. Dabur***¹³
- (iv) ***Glaxo India Ltd. v. Eudora Laboratories Pvt. Ltd.***¹⁴
- (v) ***Johann A. Wulfing v. Chemical Industrial & Pharmaceutical Laboratories Ltd.***¹⁵
- (vi) ***Mount Mettur Pharmaceuticals Ltd. v. Ortha Pharmaceuticals Corporation***¹⁶

47. I have given my thoughtful attention to the aforesaid judgments relied upon on behalf of the defendant. In my view, all the aforesaid judgments are distinguishable as explained below:

- (i) ***F. Hoffman*** (supra) – The competing marks were PROTOVIT and DROPOVIT. The common element ‘VIT’ between the competing marks was derived from the word ‘vitamin’ and was common to trade.
- (ii) ***Abbott*** (supra) – The competing marks were BRUFEN and

¹¹ (1969) 2 SCC 716

¹² 2024 SCC OnLine Del 7306

¹³ (1997) SCC Online Del 360

¹⁴ 1997 SCC OnLine Del 804

¹⁵ 1983 SCC OnLine Bom 285

¹⁶ 1974 SCC OnLine Mad 64



MEBUFEN. The common element 'FEN' between the competing marks was taken from the INN name 'ibuprofen' and there was sufficient difference between 'BRU' and 'MEBU' to distinguish the competing marks as a whole.

- (iii) **Dabur** (supra) – The competing marks were MEXATE and ZEXATE. The common suffix 'exate' was derived from the common active pharmaceutical ingredient, namely, *methotrexate sodium*.
- (iv) **Glaxo India** (supra) – The competing marks were ZUPAR and BUPAR. The Court only took a *prima facie* view to arrive at its conclusion and final determination with respect to similarity could only be done after trial.
- (v) **Johann A. Wulfing** (supra) – The competing marks were COMPLAMINA and CIPLAMINA. The initial syllables of the competing marks, being 'COM' and 'CIP', were held to be phonetically different.
- (vi) **Mount Mettur** (supra) – The competing marks were ORTHOGYNOL and UTOGYNOL. The common term 'GYNO' was derived from '*gynaeco*', which term was suggestive of the use of the product. Further, it was held that the suffix 'OL' was common to trade.

48. The defendant has placed reliance on the judgment of the High Court of Punjab and Haryana in *M/s. Wockhardt Ltd. v. M/s. Intas Pharmaceuticals Ltd. and others*¹⁷ in support of its contention that the marks PLAVIX and

¹⁷ Judgment dated 4th December 2002 in Civil Revision No. 2773/2002



CLAVIX are phonetically, structurally and visually different.

49. In the aforesaid case, Wockhardt, which was the registered proprietor of the trade mark FLAVIX, had filed a suit for infringement and passing off against Intas Pharmaceuticals, the defendant herein, for using the mark CLAVIX. The District Judge, Ambala did not grant an *ad-interim* injunction in favour of the plaintiff. Accordingly, the plaintiff filed a revision petition before the High Court of Punjab and Haryana.

50. The High Court of Punjab and Haryana upheld the order of the District Judge not granting an *ad-interim* injunction in favour of the plaintiff. Taking into account that both the products were meant for different purposes as also the difference in colour scheme and packaging, it was held that there is no visual, structural or phonetic similarity between the marks FLAVIX and CLAVIX.

51. The aforesaid judgment does not advance the case of the defendant herein, as the aforesaid judgment was at the stage of an *ad-interim* injunction and it was clearly noted that the two products FLAVIX and CLAVIX were meant for different purposes, *i.e.*, FLAVIX was an anti-depressant drug and CLAVIX an anti-thrombosis drug. Hence, it was held that there is no likelihood of deception or confusion. Pertinently, the aforesaid observations were made in the context of passing off alone.

52. On behalf of the defendant, it is submitted that the competing marks in the present case are not identical. Therefore, the test for passing off has to be applied to determine similarity between the marks. As per the aforesaid test, the added materials in the impugned mark with respect to overall getup, look and appearance would eliminate the possibility of any confusion among the members of trade and public. In this regard, reliance is placed on the judgment



of the Supreme Court in *Kaviraj Pandit* (supra).

53. In my considered view, the defendant's reliance on *Kaviraj Pandit* (supra) is misplaced. *Kaviraj Pandit* (supra) clearly states that the test would be the same in actions for passing off and infringement only for determining what would amount to a colourable imitation of the plaintiff's trade mark. The judgment itself states that in an action for infringement, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark, would be immaterial. In a recent judgment in *Wow Momo Foods v. Wow Burger*¹⁸, a division bench of this Court made the following observations:

“25. Thus, infringement, or its absence, has to be tested by comparing mark to mark [Also refer Rajastham Aushdhalaya Pvt. Ltd. v. Himalaya Global Holdings Ltd., 2025 SCC OnLine Del 4721]. Added features, such as difference in getup, colour, appearance, and the like, would not be of significance where the marks, compared to each other, are deceptively similar. For a case of passing off to be made out, however, added features, which may distinguish the two marks from each other, would be of significance.”

[emphasis supplied]

54. Pertinently, the defendant itself had applied for registration of the word mark CLAVIX in class 5 [Exhibit DW-1/4]. Therefore, at this stage, the defendant cannot take the defence of added material in the impugned mark to overcome the claim for infringement.

55. The defendant has placed reliance on the judgment of this Court in

¹⁸ 2025 SCC OnLine Del 6545



Gensol v. Mahindra¹⁹ to submit that the use of the company name as a prefix to the impugned mark would be sufficient to dispel confusion among the members of trade and public.

56. The judgment in ***Gensol*** (supra), which was delivered by this bench, was in an entirely different context. In that case, the plaintiff was yet to launch its product whereas the plaintiff in the present case had launched its drug. Further, in ***Gensol*** (supra), the vehicles of the parties belonged to different categories targeting different segments of the public – the plaintiff was going to launch a vehicle in the passenger category whereas the defendant’s vehicle was aimed in the commercial space.

57. There is a stark difference in the facts and circumstances of the present case. It is an undisputed position that both the plaintiff and the defendant are using their respective marks in respect of pharmaceutical products having the same salt/ active ingredient and the competing products are used for treatment of the same disease. Hence, the judgment in ***Gensol*** (supra) is not applicable in the facts of the present suit.

58. The bench in ***Gensol*** (supra) had also taken note of the fact that the manufacturers in the automobile industry significantly affect the purchase decision, which is not the case in the present suit. The relevant extracts from ***Gensol*** (supra) are set out below:

“33. While purchasing a motor vehicle, the name of the manufacturer becomes very important and an average consumer while deciding to purchase a motor vehicle would not only consider the model of the motor vehicle but also its manufacturer. There is an amount of brand equity, goodwill and reputation attached to the name of the manufacturer. It is a known position in the automobile industry that a model of a car is identified and recognized not only by the name of the model but also by the name of the manufacturer. It is common in the automobile trade that

¹⁹ 2025 SCC OnLine Del 68



the cars are identified by the manufacturer's name along with the model of the car. For instance, car models such as Mercedes E220, Toyota Camry, Honda Accord, Maruti SX4 would not be readily recognizable without the name of the manufacturing company i.e., Mercedes, Toyota, Honda, or Maruti respectively. Thus, the name of the manufacturer is of utmost importance for a consumer and becomes a distinguishing factor as the consumer would consider the manufacturer's name and not just the car model."

59. It is also the case of the defendant that the plaintiff, even in its amended
plaint, has asserted infringement of the device mark **Plavix**.
Thus, in terms of Section 17 of the Act, the plaintiff cannot assert any right
over the word mark PLAVIX.

60. To appreciate the legal position with respect to Section 17 of the Act, a
reference may be made to the decision of a division bench of this Court in
United Biotech Private Limited v. Orchid Chemicals & Pharmaceuticals²⁰,
where the Court made the following observations:

*"25. The entire arguments are on the wrong premise and it proceeds on the basis of common feature of the two marks suffix "ZID" and since the respondent has registration and trade mark "ORZID", it cannot bare a part of it, i.e., "ZID". What has been seen in a case like this is as to whether the mark "FORZID" is deceptively similar to "ORZID". That is the test which is to be applied and in a process, it is to be seen as to whether the two marks are structurally and phonetically similar and would cause deception in the minds of consumers. When we judge the matter from this angle, we find ourselves in agreement with the view taken by IPAB as well as the learned Single Judge. **Although the mark "ORZID" is a label mark, the word mark "ORZID" is an essential feature that has been covered by the registration. Therefore, the learned counsel for the respondent appears to be right in his submission on this aspect, which is predicated on the Supreme Court decision in Ramdev Food Products Ltd. (supra). Following dicta on the decision is pertinent:***

84. Mr. Nariman is also not correct in contending that only a label has been registered and not the name 'Ramdev'. Definition of 'mark' as contained in Section 2(j) of the 1958 Act also includes names, signature, etc."

²⁰ 2012 SCC OnLine Del 2942



26. We find that the learned Single Judge rightly held that when a label mark is registered, it cannot be said that the word mark contained therein is not registered. We, thus, are of the opinion that although the word “ORZID” is a label mark, the word “ORZID” contained therein is also worthy of protection...”

[emphasis supplied]

61. In the present case, the registered device mark **Plavix** is only a stylized representation of the word PLAVIX. No other word or logo, except PLAVIX, forms a part of the said device mark. Therefore, in light of the aforesaid findings in *United Biotech* (supra), it becomes clear that when taken as a whole, the word PLAVIX is the essential part of the registered device mark **Plavix** in terms of Section 17 of the Act.

62. In any event, the plaintiff in the present case has obtained registration for the word mark PLAVIX during the pendency of the present suit with effect from 20th January 1995. [Exhibit PW-4/3 and Exhibit PW-4/4].

Analysis – Dishonest Adoption

63. At this stage, it would be relevant to refer to the justification given by the defendant for adopting the impugned mark CLAVIX. In paragraph 7 of the evidence affidavit of DW-1, it has been explained that the impugned mark CLAVIX is an amalgamation of the letters ‘CL’ taken from the active ingredient *Clopidogrel*, the letters ‘AVI’ taken from its therapeutic indication viz *Atherosclerotic Vascular Incidences* and the letter ‘X’ indicating reduction in recurrence of acute events. Relevant extracts of paragraph 7 of the evidence affidavit of DW-1 are reproduced below:

“7. I state that the Defendants had launched its medical product CLAVIX in the market, in the year 2001. I state that the Defendant No.1 has adopted and coined the mark CLAVIX. I further state that the mark CLAVIX is an amalgamation of the drug “CLOPIDROGEL” (‘CL’ taken from this drug)



being the basic drug and its therapeutic indication viz. Atherosclerotic Vascular Incidences ('AVI') and the last letter 'X' is referable and indicates reduction in recurrence of acute events..."

64. DW-1 was cross-examined by counsel for the plaintiff on this aspect.

The relevant extracts from the cross-examination are set out below:

Q.101 You have mentioned in para 7 that the syllable AVI is taken from atherosclerotic vascular incidences (AVI). I put it to you that the recognized terms are either atherosclerotic vascular disease or atherosclerotic vascular calcification or atherosclerotic events. There is no such term as atherosclerotic vascular incidences and the syllable AVI is therefore clearly an afterthought. What do you have to say?

Ans. I maintain what I have stated in para 7 of my affidavit.

Q.102 I put it to you that the correct nomenclature in the acronym form of this disease is ASCVD and not AVI.

Ans. It is incorrect.

Q.104 Please refer to para 7 of your affidavit again. The letter X signifies in ordinary parlance as a sign for multiplication and hence signifies "increase" and not reduction. Hence your explanation is faulty, flawed and an afterthought.

Ans. It is incorrect.

65. It is clear from the aforesaid evidence of DW-1 that the explanation for adopting the impugned mark CLAVIX as given by the defendant is dishonest and far-fetched. Clearly, it is in the nature of an afterthought.

66. To highlight the dishonest adoption of the impugned mark CLAVIX by the defendant, it has also been contended on behalf of the plaintiff that the defendant has been using two marks other than CLAVIX, namely PREVA and PRASUGEL, for the very same drug.



67. Once again, DW-1 was cross-examined by counsel for the plaintiff in this regard. The relevant extracts from the cross-examination are set out below:

Q.30. Does your company make any drug that has the same functionality as clopidogrel (other than clopidogrel)?

A. I need to check and revert.

Q32. Can you answer Question No. 30 now?

Ans. Our company was making similar product functionally called Prasugel. We are not manufacturing the same anymore.

Q33. What do you mean by "similar product functionally"?

Ans. This product was functionally similar to Clavix.

Q.105 Is it correct that your company marketed clopidogrel under the trademark PREVA in the year 2001?

Ans. Clopidogrel is promoted and marketed amongst neurologists under the brand PREVA, while it is promoted and marketed amongst cardiologists under the brand CLAVIX. Both were promoted in around the year 2001.

Q.106 I put it to you that PREVA is very much a drug promoted and commercialized by the Defendants and many others as an anti-platelet drug as it prevents the clotting of blood in the blood vessels and people with heart problems or blood vessel disorders are advised to reduce chances of suffering from heart attacks / strokes by taking this medicine daily. Is it correct?

Ans. We are promoting and marketing clopidogrel product for neurological disorders amongst neurologists under the trademark PREVA and not for heart disease for which we are promoting under trademark CLAVIX amongst cardiologists.



Q.107 Is there any difference between the active ingredients (API) of PREVA and CLAVIX?

Ans. The active ingredients are the same. Vol. however, neurologists for brain related ailment while cardiologists for heart related ailments are recommending/ advising / prescribing these medicines containing clopidogrel.

Q.108. I put it to you that cardiologists regularly prescribe, even today, clopidogrel under the brand PREVA.

Ans. It is incorrect.

Q.109. I put it to you that there is no difference between the two drugs PREVA and CLAVIX other than the marketing reasons given by you above.

Ans. Both products are differently marketed, promoted, positioned amongst different therapeutic segments of cardiology and neurology.

Q.110. I put it to you that your only objective of using two brands for the same drug clopidogrel was to gain a strategic advantage of goodwill and renown of the Plaintiff's product PLAVIX.

Ans. It is incorrect.

68. The aforesaid cross-examination establishes that the defendant was indeed selling formulations of *Clopidogrel* under the marks PREVA and PRASUGEL. No satisfactory explanation has been given by the defendant as to why it adopted the impugned mark when it had already been using other marks for the same drug.

69. Yet another aspect which has emerged from the evidence of the defendant is that the defendant launched CLAVIX in 2001 without conducting



any due diligence including trade mark search in the database of the Trade Marks Registry as well as any market research. This is evident from the cross-examination of DW-1 conducted on behalf of the plaintiff on 21st December 2017 and 6th January 2018. The relevant extracts from the cross-examination are set out below:

Q48. Was any Trade Mark search done by Defendant Company before the Trade Mark Registry before application for CLAVIX was filed in the year 2007?

Ans. Yes, it was done.

Q49. Can you produce the said search report?

Ans. I will check and revert.

Q.52. Can you answer Q.49 now?

A. We have adopted the mark 'CLAVIX' in 2001. We must have done a search at that point of time. I could not find the search report referable to that point of time.

Q.53. Could you find the letter of instructions requesting your trademark agent at that point of time to conduct a search for the trade mark 'Clavix' for pharmaceutical goods falling in Class 5?

A. No I could not.

Q.54. Did you check up from the trademark agent who you earlier identified whether any such search was conducted and if so, whether he had retained a copy of the search results?

A. No, I did not.

Q.55. Since you had joined your company in 2004 which is 3 years after the alleged launch of Clavix in market, did you check up from your predecessor about the same?



A. I verified the record that is available with the company. I was the first person as far as formal legal department is concerned. Prior to me some other persons were looking after trademark related matters. I checked with my colleague who was working prior to me and we could not find search report.

Q.56. Did you conclude at the end of your discussion with your predecessor that no search was taken in the year 2001 or that the search was conducted but the report had been misplaced?

A. Our discussion could not conclude whether search was done or search was done and report is not available.

Q.57. Do you not have access to your trademark agent by a simple telephone call?

A. I joined in 2004 and therefore, matter concerning 2001 in my view the agent could not have been in position to explain whether any search report was obtained. I did not call the trademark agent to ascertain whether the search report was available with him. Though I verified the record and I could not find any search report of 2001.

70. From the aforesaid cross-examination of DW-1, it becomes evident that the defendant did not conduct any search on the Register of Trade Marks before adopting the impugned mark CLAVIX.

71. In fact, DW-1, during his cross-examination, has admitted that if a search on the database of the Trade Marks Registry would have been conducted by the defendant in 2001 before launching CLAVIX, it would have shown the trade mark applications filed on behalf of the plaintiff for the marks PLAVIX and **Plavix**. The relevant extracts from the cross-examination of DW-1 are set out below:



Q.63. I put it to you that the trademark search report filed on the court record and marked as Exhibit DW-1/8 clearly shows the two registrations for the Plaintiff's trademark 'Plavix' under numbers 652794 and 806651 filed on 20.01.1995 and 17.06.1998 respectively. Correct?

A. This search report contains positions with regard to trademark applications status filed by various applicants including above mentioned numbers.

Q.64. I put it to you that even in the year 2001 the search report issued by the Trademarks Office would have contained the registrations mentioned in Q.63?

A. Yes the same would have contained the registration numbers.

72. It was also put to DW-1 whether any market research was conducted by the defendant in the year 2001 with regard to the brands that existed in India for the drug *Clopidogrel*. From the responses of DW-1, it is apparent that no market research was done by the defendant in the year 2001 to determine the existence of other brands in relation to the drug *Clopidogrel*. The relevant extracts from the cross-examination are set out below:

Q.61. Did your company in the year 2001 conduct a market search either through your own in-house marketing department or through professional external market research organizations regarding which brands exist in relation to the drug 'Clopidogrel'?

A. The company must have done the market research. I am not aware.

Q.62. Did you contact the marketing people to try and obtain a copy of the aforesaid market research or any other associated data

which they may have collected at that time in 2001 or earlier to the launch of the drug 'Clavix'?

A. I did not contact the marketing people for any search details.



73. This Court finds it hard to believe that the defendant, which is a significant player in the pharmaceutical industry, would not be aware of the launch of the plaintiff's drug PLAVIX in the world market. A reputed pharmaceutical company cannot be expected to launch a new drug in the market under a mark without conducting even a basic search about competing drugs with identical or similar trade marks that are already available in the market. In this regard, reference may be made to the judgment in *Himalaya Wellness* (supra), wherein this bench was faced with the aspect of due diligence required to be carried out on behalf of the defendant prior to adoption of the impugned mark. The relevant extracts from *Himalaya Wellness* (supra) in this regard are set out below:

“66. It is intriguing for me as to why a reputed company such as the defendant company would launch its product, also pertaining to female reproductive hygiene, almost 22 years later, using the identical trade mark as that of the plaintiffs. A simple due diligence exercise conducted on behalf of the defendant would have informed the defendant about the existence of the product of the plaintiffs with an identical trade mark. A google search or a Trade Marks Registry search across various classes would have brought to light the registered mark of the plaintiffs.

67. The reply of the defendant only indicates that the defendant conducted a search only in Class 3 and found that there was no other registered mark or pending application in respect of the mark “EVECARE”. It is not the case of the defendant that they conducted a trade mark search and came across the registration of the plaintiffs under Class 5 and yet decided to adopt the identical trade mark in respect of their product, which was under Class 3. Nor is it the case that the defendant took a legal opinion before adopting an identical trade mark. The defendant company is not a small time operator. It is a company with ample resources and surely, with access to legal resources.

68. The reply of the defendant is conspicuously silent with regard to its knowledge of the products of the plaintiffs selling under the identical mark. It is difficult to fathom that the defendant was not aware of the use of the trade mark “EVECARE” by the plaintiffs when it decided to launch its product under the same trade mark in 2020. While countering the contention of the plaintiffs that the plaintiffs became aware of the defendant's “EVECARE” product in November 2022, the defendant has



argued that the plaintiffs ought to have been aware of the defendant's "EVECARE" product, which has only been launched 1.5 years back. Applying the same argument, the defendant ought to have been aware of the plaintiffs' "EVECARE" product that has been in the market for a period of 24 years.

69. As noted in the judgments above, misrepresentation can even be made out in the absence of any mala fide intention on the part of the defendant. Further, there is no need to establish fraud or actual deception or actual damage to the business or goodwill of the plaintiff, and a mere likelihood is sufficient. In my considered view, the defendant has failed to provide a plausible explanation for adopting the identical trade mark. Accordingly, this Court is of the prima facie view that the adoption of the registered trade mark of the plaintiffs by the defendant was not bona fide and amounts to misrepresentation.”

[emphasis supplied]

74. The judgment in ***Himalaya Wellness*** (supra) has been upheld by the division bench²¹.

75. In view of the discussion above, I am of the opinion that the adoption of the impugned mark CLAVIX by the defendant was dishonest.

Whether the defendant is entitled to the defence under Section 34 of the Act

76. The defendant seeks to invoke the defence under Section 34 of the Act. Section 34 operates as a complete defence available to a prior user of a trade mark against a claim for infringement by a registered proprietor. It provides that the proprietor of a registered trade mark cannot interfere with or restrain a prior user from using an identical or deceptively similar mark. For the purpose of this provision, a person can be said to be the prior user of a trade mark only if he has continuously used the said mark prior to:

- (a) the use of the first-mentioned trade mark by its proprietor, or
- (b) the date of registration of the first-mentioned trade mark, whichever is

²¹ Wipro Enterprises v. Himalaya Wellness, 2024 SCC OnLine Del 6859



earlier.

77. The legal position with regard to Section 34 is clear from the recent judgment of the division bench in *Bodhisattva Charitable Trust v. Mayo Foundation for Medical Education and Research*²².

78. In *Mayo* (supra), a division bench of this Court made the following observations:

“30.1 ... The use of the words “whichever is earlier” in Section 34 results in the Section being applicable only where the defendant has been using the infringing mark from a point of time prior to the date of registration as well as user of the plaintiff’s mark. The user, by the defendant, of the infringing mark has, therefore, to pre-date both the registration and user of the asserted mark of the plaintiff. In the present case, the registration of the mark MAYO and MAYO CLINIC in favour of the respondent in Class 16 is of 1992 whereas, admittedly, the user of the MAYO mark by the appellants is only of 1995.

31. Mere priority of user no defence to infringement

Priority of user is not a defence to an action for infringement. It becomes a defence only if it falls within the parameters of Section 34 of the Trade Marks Act. That, in its turn, requires user, by the defendant or the infringing mark, predating both the user as well as the registration of the asserted mark of the plaintiff. In other words, it is only if the defendant has been using the allegedly infringing mark, from a point of time prior to the registration as well as the user of the asserted mark of the plaintiff, that the defendant, despite being an infringer can escape an injunction by seeking recourse to Section 34. Else, mere priority of user by the defendant is no defence to infringement, or the injunction which must inexorably follow a finding of infringement.”

[emphasis supplied]

79. In *Adidas AG* (supra), the defendant contended that he is the prior user of the mark ADIDAS and when he adopted the said mark, the plaintiff’s goods under the mark ADIDAS were not available in India. A coordinate bench of this Court held that a registered proprietor can initiate legal proceedings

²² Judgment dated 28th July 2025 in FAO(OS) (COMM) 73/2024



against infringement even without actual use of the registered mark. The relevant date for purposes of establishing prior use would be the date of registration of the mark and not when the plaintiff actually started using it.

80. It is the case of the defendant that since the defendant adopted and commenced using the impugned mark CLAVIX in 2001, *i.e.* although after the filing of the plaintiff's trade mark applications in the years 1995 and 1998 but before the plaintiff's alleged use in 2003 and grant of first registration in 2005 in India, it would be entitled to benefit under Section 34 of the Act. Reliance in this regard is placed on *Neon Laboratories* (supra).

81. In *Neon Laboratories* (supra), the plaintiff, an unregistered proprietor using its mark since 1998, instituted a suit for passing off against the defendant, which had commenced use of the impugned mark only from 16th October 2004. The defence of the defendant was that it had received registration for its trade mark in 2001, which would date back to its date of application filed in 1992.

82. In this background, the Supreme Court gave its *prima facie* view that Section 34 of the Act would come to the aid of the plaintiff against the defendant, who did not use the impugned mark for twelve years from the date of filing of its trade mark application.

83. The aforesaid observations were made by the Supreme Court in the facts and circumstances of the case where the defendant, despite applying for registration in 1992 and obtaining registration in the year 2001, had not launched its product in the market till 2004. In the meanwhile, the plaintiff commenced use of its mark back in the year 1998 and had acquired substantial goodwill in the market for the said trade mark. The defendant also did not ever take any action against the plaintiff from using its trade mark.



84. In *Neon Laboratories* (supra), a suit for passing off had been instituted against a prior registrant of a trade mark whereas in the present case, the plaintiff, who is the prior registered proprietor, has instituted a suit for infringement and passing off against the defendant for using the impugned mark. The defendant in the present case has not filed a suit for passing off against the plaintiff, nor is it the case of the defendant that it had acquired goodwill and reputation in the impugned mark CLAVIX before the plaintiff launched PLAVIX in India. Therefore, the judgment in *Neon Laboratories* (supra) does not advance the case of the defendant.

85. In the present case, the defendant's drug under the mark CLAVIX was admittedly launched in the year 2001. On the other hand, the registration of the plaintiff's marks PLAVIX and **Plavix** would date back to 20th January 1995 and 17th June 1998, respectively.

86. Therefore, in the facts of the present case, the defendant has failed to establish prior use of the impugned mark CLAVIX in terms of Section 34 of the Act.

87. In any event, the defendant cannot assert the benefit of prior user in terms of Section 34 of the Act in view of my conclusion that the defendant's adoption of the impugned mark is dishonest. A reference in this regard may be made to the judgment of this bench in *Mayo Foundation for Medical Education and Research v. Bodhisattva Charitable Trust*²³, the relevant extracts of which are set out below:

“20. In FDC (supra) it has been clearly held where the defendants dishonestly adopt a mark that is identical to a prior registered trademark, whether a well-known or not, the benefit of prior user in terms of Section 34 of the Trade Marks Act, 1999 would not be available to the defendants

²³ 2023 SCC OnLine Del 3241



even if such user by the defendants was in respect of different goods and services.”

88. In view of the discussion above, a clear case of infringement under Section 29 of the Act is made out by the plaintiff against the defendant.

Submissions of the plaintiff – Passing off

89. The plaintiff has made the following submissions:

89.1. The plaintiff was first to launch the drug *Clopidogrel* worldwide in the year 1998. In disputes involving medicinal products, prior use is determined on the basis of first use in the world market and not just first use in India. In this regard, reliance is placed on the judgment of the Supreme Court in ***Milmet Oftho v. Allergen***²⁴.

89.2. The plaintiff has placed sufficient evidence on record to show worldwide reputation of the mark PLAVIX.

89.3. Further, the global reputation and goodwill of the mark PLAVIX since 1998 has spilled over in India and made it well-known in the Indian medical fraternity far before the defendant’s alleged adoption of the impugned mark in 2001.

89.4. Notwithstanding the plaintiff’s commercial launch of PLAVIX in India in 2003, the same was being prescribed by doctors and imported by hospitals/pharmacists in India at least since the year 2000. Sufficient evidence in this regard has been placed on record.

Submissions of the defendant – Passing off

90. The defendant has made the following submissions:

²⁴ (2004) 12 SCC 624



90.1. The plaintiff's product PLAVIX had no presence in India when the defendant's product under the impugned mark was launched in 2001. Thus, the plaintiff did not have any goodwill or reputation for the mark PLAVIX in 2001 in India, which is *sine qua non* in an action for passing off.

90.2. Since trade mark rights are territorial in nature, use of the plaintiff's mark outside India cannot be considered without proof of a trans-border reputation.

90.3. The alleged trans-border reputation of the plaintiff's mark PLAVIX since 2000 is unsubstantiated and merely an afterthought. The plaintiff has failed to show any sale, customer base, marketing expenditure or potential growth for its product under the mark PLAVIX in India to establish trans-border reputation. No sales or advertisement figures have been given prior to the years 2003 and 2004, respectively.

90.4. The medical journals filed by the plaintiff do not target Indian customers in particular and are inconsequential and sporadic.

Analysis – Passing off

91. Passing off is an action founded in common law, which is based on the principle that no person has the right to represent his/ her goods or services as those of someone else. Section 27(2) of the Act recognizes the right of action against any person for passing off his/ her goods or services as the goods or services of another person. In *S. Syed Mohideen v. P Sulochana Bai*²⁵, the essential elements for constituting an action for passing off have been elucidated by the Supreme Court in the following terms:

“31.1. Traditionally, passing off in common law is considered to be a right for protection of goodwill in the business against misrepresentation

²⁵ (2016) 2 SCC 683



caused in the course of trade and for prevention of resultant damage on account of the said misrepresentation. The three ingredients of passing off are goodwill, misrepresentation and damage. These ingredients are considered to be classical trinity under the law of passing off as per the speech of Lord Oliver laid down in Reckitt & Colman Products Ltd. v. Borden Inc. [Reckitt & Colman Products Ltd. v. Borden Inc., (1990) 1 WLR 491 : (1990) 1 All ER 873 (HL)] which is more popularly known as “Jif Lemon” case wherein Lord Oliver reduced the five guidelines laid out by Lord Diplock in Erven Warnink Besloten Vennootschap v. J. Townend & Sons (Hull) Ltd. [Erven Warnink Besloten Vennootschap v. J. Townend & Sons (Hull) Ltd., 1979 AC 731 at p. 742 : (1979) 3 WLR 68 : (1979) 2 All ER 927 (HL)] (“the Advocaat case”) to three elements: (1) goodwill owned by a trader, (2) misrepresentation, and (3) damage to goodwill. Thus, the passing off action is essentially an action in deceit where the common law rule is that no person is entitled to carry on his or her business on pretext that the said business is of that of another. This Court has given its imprimatur to the above principle in Laxmikant V. Patel v. Chetanbhai Shah [Laxmikant V. Patel v. Chetanbhai Shah, (2002) 3 SCC 65].”

[emphasis supplied]

92. A reading of the aforesaid extracts makes it evident that the first and foremost element in the test for an action for passing off is establishing goodwill and reputation of the plaintiff’s mark among the members of trade and public.

93. It is the case of the plaintiff that the mark PLAVIX was coined by the plaintiff in the year 1995 and a drug under the said mark was launched globally in the year 1998. PLAVIX was a blockbuster drug and soon after its launch in 1998, it became popular worldwide.

94. From the evidence led on behalf of the defendant, it has come out that the defendant had launched its product CLAVIX in India in the year 2001 after obtaining permission from the Drugs Controller General (India) for manufacturing *Clopidogrel* on 27th June 2001 [Exhibit DW-1/2]. On the basis of the said permission, the defendant was granted permissions from



Food and Drugs Control Administration (Gujarat) to manufacture the drug *Clopidogrel* under the name CLAVIX on 12th July 2001 [Exhibit DW-1/3].

95. It is vehemently submitted on behalf of the defendant that the plaintiff did not have any goodwill and reputation in the mark PLAVIX when the defendant launched CLAVIX in India in 2001. In this regard, defendant places reliance on the judgment of the Supreme Court in *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd. & Ors*²⁶.

96. In *Toyota v. Prius* (supra), the plaintiff had instituted a suit for infringement as well as passing off. The plaintiff in the said case had claimed that international reputation and goodwill in respect of its car model PRIUS had spilled over into India even though the said model had not been launched in India. The Supreme Court held that in order to succeed in an action for passing off, the Court has to determine if there has been a spillover of reputation and goodwill of the mark used by the plaintiff in India. In this context, the relevant observations of the Supreme Court are set out below:

“38. The next exercise would now be the application of the above principles to the facts of the present case for determination of the correctness of either of the views arrived at in the two-tier adjudication performed by the High Court of Delhi. Indeed, the trade mark “Prius” had undoubtedly acquired a great deal of goodwill in several other jurisdictions in the world and that too much earlier to the use and registration of the same by the defendants in India. But if the territoriality principle is to govern the matter, and we have already held it should, there must be adequate evidence to show that the plaintiff had acquired a substantial goodwill for its car under the brand name “Prius” in the Indian market also. The car itself was introduced in the Indian market in the year 2009-2010. The advertisements in automobile magazines, international business magazines; availability of data in information-disseminating portals like Wikipedia and online Britannica dictionary and the information on the internet, even if accepted, will not be a safe basis to hold the existence of the necessary goodwill and reputation of the product in the Indian market at the relevant point of

²⁶ 2017 SCC OnLine SC 1500



time, particularly having regard to the limited online exposure at that point of time i.e. in the year 2001. The news items relating to the launching of the product in Japan isolatedly and singularly in *The Economic Times* (Issues dated 27-03-1997 and 15-12-1997) also do not firmly establish the acquisition and existence of goodwill and reputation of the brand name in the Indian market. Coupled with the above, ***the evidence of the plaintiff's witnesses themselves would be suggestive of a very limited sale of the product in the Indian market and virtually the absence of any advertisement of the product in India prior to April 2001. This, in turn, would show either lack of goodwill in the domestic market or lack of knowledge and information of the product amongst a significant section of the Indian population.*** While it may be correct that the population to whom such knowledge or information of the product should be available would be the section of the public dealing with the product as distinguished from the general population, even proof of such knowledge and information within the limited segment of the population is not prominent.

39. All these should lead to us to eventually agree with the conclusion of the Division Bench of the High Court that the brand name of the car Prius had not acquired the degree of goodwill, reputation and the market or popularity in the Indian market so as to vest in the plaintiff the necessary attributes of the right of a prior user so as to successfully maintain an action of passing-off even against the registered owner. ***In any event the core of the controversy between the parties is really one of appreciation of the evidence of the parties; an exercise that this Court would not undoubtedly repeat unless the view taken by the previous forum is wholly and palpably unacceptable which does not appear to be so in the present premises.***

40. ***If goodwill or reputation in the particular jurisdiction (in India) is not established by the plaintiff, no other issue really would need any further examination to determine the extent of the plaintiff's right in the action of passing-off that it had brought against the defendants in the Delhi High Court. Consequently, even if we are to disagree with the view of the Division Bench of the High Court in accepting the defendant's version of the origin of the mark "Prius", the eventual conclusion of the Division Bench will, nonetheless, have to be sustained..."***

[emphasis supplied]

97. From a reading of the above, it emerges that merely because a trade mark has acquired goodwill and reputation overseas, the same cannot be the basis to say that the said mark has also acquired goodwill and reputation in India. There has to be adequate evidence to show that the plaintiff has



acquired substantial goodwill for its trade mark in Indian market. In the facts of the case, the Supreme Court held that a singular news item relating to the launch of the product in India would not establish goodwill and reputation in view of the limited sale of the plaintiff's car and absence of advertisements in India at the relevant time. It was also held that information on the internet cannot be the sole basis to acquire goodwill or reputation, particularly having regard to the limited exposure to content available on the internet in the year 2001.

98. *Per contra*, the plaintiff submits that in cases of medicinal products, the position of law has been laid down in *Milmet* (supra).

99. In *Milmet* (supra), the plaintiff, which was a foreign company, had instituted a suit for passing off against the defendant, an Indian entity, for restraining the defendant from using an identical mark in respect of a medicinal product. The claim of the plaintiff was based on prior use of the mark by the plaintiff outside India.

100. A single bench of the High Court of Calcutta did not grant an interim injunction in favour of the plaintiff. The aforesaid order was set aside by a division bench of the High Court of Calcutta holding that the plaintiff had been able to establish spillover of worldwide reputation in respect of its trade mark in India. Accordingly, the judgment of the single bench was set aside and an interim injunction was passed in favour of the plaintiff.

101. The defendant took the matter to the Supreme Court. The Supreme Court did not interfere with the judgment of the division bench. The relevant extracts from *Milmet* (supra) are set out below:

“8. We are in full agreement with what has been laid down by this Court. Whilst considering the possibility of likelihood of deception or confusion, in present times and particularly in the field of medicines, the Courts must



also keep in mind the fact that nowadays the field of medicine is of an international character. The Court has to keep in mind the possibility that with the passage of time, some conflict may occur between the use of the mark by the Applicant in India and the user by the overseas company. The Court must ensure that public interest is in no way imperilled. Doctors particularly eminent doctors, medical practitioners and persons or Companies connected with medical field keep abreast of latest developments in medicine and preparations worldwide. **Medical literature is freely available in this country. Doctors, medical practitioners and persons connected with the medical field regularly attend medical conferences, symposiums, lectures etc. It must also be remembered that nowadays goods are widely advertised in newspapers, periodicals, magazines and other media which is available in the country. This results in a product acquiring a worldwide reputation.** Thus, if a mark in respect of a drug is associated with the Respondents worldwide it would lead to an anomalous situation if an identical mark in respect of a similar drug is allowed to be sold in India. However one note of caution must be expressed. Multinational corporations, who have no intention of coming to India or introducing their product in India should not be allowed to throttle an Indian Company by not permitting it to sell a product in India, if the Indian Company has genuinely adopted the mark and developed the product and is first in the market. Thus the ultimate test should be who is first in the market.

9. **In the present case, the marks are the same. They are in respect of pharmaceutical products. The mere fact that the Respondents have not been using the mark in India would be irrelevant if they were first in the world market. The Division Bench had relied upon material which prima-facie shows that the respondents' product was advertised before the Appellants entered the field. On the basis of that material the Division Bench has concluded that the Respondents were first to adopt the mark. If that be so then no fault can be found with the conclusion drawn by the Division Bench.**

10. However, it was submitted on behalf of the Appellants that the Respondents were not the first to use the mark. it was submitted that there was no proof that the Respondents had adopted the mark and used the mark before the Appellants started using the mark in India. **In our view, these are matters which would require examination on evidence. Considering the fact that for all these years, because of the injunction Order, the Appellants have sold their product under some other name, the balance of convenience is that the injunction order be continued and the hearing of the Suit be expedited. If on evidence it is proved that the Respondents had adopted the mark prior to the Appellants doing so, on the settled law, then the Respondents would become entitled to an injunction. However, if on evidence it is shown that the Respondents had**



not adopted the mark prior to its use in India by the Appellants then, undoubtedly, the trial Court would vacate the injunction. The trial Court would undoubtedly then assess the damage which Appellants have suffered for having wrongly not been allowed to use the mark for all these years.”

[emphasis supplied]

102. The suit in *Milmet* (supra) was at the stage of interim injunction and the Supreme Court rejected the appellant’s contention of prior use of the mark in India on the ground that the same would require examination on evidence. One of the factors for the Supreme Court’s non-interference with the decision of the division bench was that the defendant started selling its product under some other mark after suffering injunction during the pendency of the suit.

103. Another important factor in *Milmet* (supra) was that the plaintiff’s product was widely advertised in newspapers, periodicals, magazines and other media having circulation in India before the defendant entered the market, which was specifically noted by the division bench.

104. In my considered view, *Milmet* (supra) does not hold that spillage of trans-border reputation is automatic in all cases of pharmaceutical products. The division bench, whose judgment was affirmed in *Milmet* (supra), clearly noted that the plaintiff had advertised its medicine extensively in India before the defendant entered the market. Therefore, the judgment in *Milmet* (supra) cannot be read in a manner to suggest that in cases of pharmaceutical products, there is no requirement for the plaintiff to establish goodwill and reputation in India so as to maintain an action for passing off.

105. Merely because the plaintiff was the first to launch its product in the world market cannot be the basis to assume that the plaintiff has established goodwill and reputation in India. The judgment in *Toyota v. Prius* (supra) would continue to hold the field and in order to succeed in an action for



passing off, the plaintiff would have to establish spillover of its goodwill and reputation in India.

106. To be noted, the judgment in *Toyota v. Prius* (supra) was a final judgment based on trial in the suit, whereas the judgment in *Milmet* (supra) was only at the stage of interim injunction.

107. At this stage, it may be apposite to examine the evidence produced by the plaintiff to show goodwill and reputation of PLAVIX, including spillover of its trans-border reputation, in India at the time when CLAVIX was launched by the defendant, *i.e.*, July 2001. The said evidence is detailed below:

- (i) Literature, brochure and leaflets for PLAVIX [**Mark A**]
- (ii) Extracts from the plaintiff's website [**Exhibit PW-1/7** also exhibited as **Exhibit PW-3/2** and **Exhibit PW-3/3**]
- (iii) Promotional materials circulated in other countries [**Mark G**]
- (iv) European Public Assessment Report for PLAVIX [**Exhibit PW-2/3**]
- (v) Financial report for the year 2001 [**Exhibit PW-1/22**] and annual reports [**Exhibit PW-3/6**]
- (vi) Documents available on the internet [**Exhibit PW-2/4**]

108. The literature, brochure and leaflets for PLAVIX produced by the plaintiff [**Mark A**] do not bear any date of publication. Hence, they do not show reputation of PLAVIX in India at the relevant point of time. Insofar as the extracts from the plaintiff's website [**Exhibit PW-1/7** also exhibited as **Exhibit PW-3/2** and **Exhibit PW-3/3**] are concerned, the plaintiff has failed to show that its website was being accessed by the members of trade and public in India prior to 2001. The promotional materials circulated in other countries [**Mark G**] do not show that these materials were accessed by the members of trade and public in India. The European Public Assessment



Report [Exhibit PW-2/3] does not advertise the plaintiff's drug PLAVIX in any manner. This report, at best, only shows that PLAVIX has been authorized by the European Commission. Insofar as the plaintiff's financial report for the year 2001 [Exhibit PW-1/22] and annual reports for the year 2000 [Exhibit PW-3/6] are concerned, they only show consolidated sales of the plaintiff for PLAVIX across the globe. They do not, in any manner, establish goodwill and reputation of PLAVIX in India. The article from Neurology India Publication of 2001 [Exhibit PW-2/4] does not talk about sale of PLAVIX in India. The article also cannot be construed to be an advertisement.

109. There is no evidence in the present suit that the plaintiff's mark PLAVIX was widely advertised in newspapers, periodicals, magazines and other media having circulation in India.

110. The documents placed on record by the plaintiff showing use of the mark PLAVIX post 2001 are not relevant to establish its goodwill and reputation in India in 2001.

111. Counsel for the plaintiff further submits that the doctors in India have been prescribing PLAVIX at least since 2001, *i.e.*, before its official launch in India in January 2003. Reliance in this regard has been placed on the following documents:

- (i) Four certificates issued by doctors practicing in India stating that they have been using/ prescribing PLAVIX to their customers/ patients in India since 2001.
- (ii) Three prescriptions of Apollo Hospital to show that the said hospital has been prescribing PLAVIX to treat its patients since September 2001.
- (iii) A statement from a pharmacy dated 31st August 2001 showing that



it had stocks of PLAVIX.

112. The defendant has objected to the aforesaid documents being admitted in evidence, as the same had been specifically refused to be taken on record by the Joint Registrar *vide* order dated 4th January 2014 and the same was not pressed for by the plaintiff in the chamber appeal against the said order.

113. Without going into this controversy, even if the documents mentioned above are to be considered, at best, they establish that few doctors and hospitals in India were aware of PLAVIX in 2001 and had been prescribing it to their patients. However, these documents only establish sporadic use of PLAVIX in India till 2001. Mere fact that some of the doctors and hospitals were aware of the launch of the plaintiff's product globally and/ or have prescribed the same to their patients would not be sufficient to establish goodwill and reputation of PLAVIX in India.

114. After carefully analyzing the evidence led on behalf of the parties, this Court is of the opinion that the plaintiff has been unable to establish goodwill and reputation in respect of PLAVIX in India at the time of launch of CLAVIX by the defendant in 2001.

115. In view of the aforesaid conclusion, this Court does not need to examine the remaining aspects of passing off, *i.e.*, misrepresentation on the part of the defendant and injury to the plaintiff on account of such misrepresentation. Accordingly, the plaintiff has failed to establish a case for passing off.

116. Therefore, Issue no.2 so far as infringement is concerned is decided in favour of the plaintiff. Remaining issues, *i.e.*, Issues no.3, 4 and 5 are also decided in favour of the plaintiff and against the defendant.



Issue no.6 – Whether there is any delay in filing the present suit?

Submissions of the plaintiff

117. In respect of Issue no.6, the plaintiff has made the following submissions:

117.1. The plaintiff learnt of the defendant in mid-2005 and the defendant's business started to cause market damage to the plaintiff only in 2006-07. Thus, there is no delay in instituting the present suit.

117.2. Notwithstanding the aforesaid, delay is not a relevant factor for consideration when the defendant's adoption of the impugned mark is dishonest.

Submissions of the defendant

118. The defendant has rebutted the aforesaid submissions of the plaintiff in the following manner:

118.1. Admittedly, the plaintiff was aware of the defendant's drug CLAVIX since mid-2005, however, the suit came to be instituted only in 2008. The suit is therefore barred on account of inordinate delay.

118.2. The delay on behalf of the plaintiff is intentional which resulted in the defendant's product CLAVIX becoming popular in the market. Thus, the plaintiff is disentitled to any injunctive relief from this Court.

Analysis

119. At the outset, it may be relevant to highlight the settled position of law with respect to the question of delay in instituting the suit and its consequences in granting relief to the parties.



120. In *Midas Hygiene Industries v. Sudhir Bhatia*²⁷, the Supreme Court, taking note of dishonest adoption of the impugned mark by the respondents, gave the following findings with respect to the issue of delay:

“5. The law on the subject is well settled. In cases of infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was itself dishonest.”

121. In *Hindustan Pencils v. India Stationary Products*²⁸, the Court made the following observations on the aspect of delay:

“30. Even though there may be some doubt as to whether laches or acquiescence can deny the relief of a permanent injunction, judicial opinion has been consistent in holding that if the defendant acts fraudulently with the knowledge that he is violating the plaintiff’s rights then in that case, even if there is an inordinate delay on the part of plaintiff in taking action against the defendant, the relief of injunction is not denied. The defence of laches or inordinate delay is a defence in equity. In equity both the parties must come to the Court with clear hands. An equitable defence can be put up by a party who has acted fairly and honestly. A person who is guilty of violating the law or infringing or usurping somebody else’s right can’t claim the continued misuse of the usurped right. It was observed by Romer, J. in the matter of an application brought by J.R. Parkington and Coy. Ltd., 63 R.P.C. 171 at page 181 that “in my judgment, the circumstances which attend the adoption of a trade mark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user. If the user in its inception was tainted it would be difficult in most cases to purify it subsequently”. It was further noted by the learned Judge in that case that he could not regard the discreditable origin of the user as cleansed by the subsequent history. In other words, the equitable relief will be afforded only to that party who is not guilty of a fraud and whose conduct shows that there had been, on his part, and honest concurrent user of the mark in question. If a party for no apparent or a valid reason, adopts, with or without modifications, a mark belonging to another, whether registered or not, it will be difficult for that party to avoid an order of injunction because the Court may rightly assume that such adoption of the mark by the party was not an honest one. The Court would be justified in concluding that the defendant, in such an action,

²⁷ 2004 SCC OnLine SC 106

²⁸ 1989 SCC OnLine Del 34



wanted to cash in on the plaintiff's name and reputation and that was the sole, primary or the real motive of the defendant adopting such a mark. **Even if, in such a case there may be an inordinate delay on the part of the plaintiff in bringing a suit for injunction, the application of the plaintiff for an interim injunction cannot be dismissed on the ground that the defendant has been using the mark for a number of years.** Dealing with this aspect Harry D. Nims in his "The Law of Unfair Competition and Trade-Mark", Fourth Edition, Volume Two at page 1282 noted as follows:

"Whether infringement is deliberate and wilful and the defendant acts fraudulently with knowledge that he is violating plaintiff's rights, essential elements of estoppel are lacking and in such a case the protection of plaintiff's rights by injunctive relief never is properly denied. "The doctrine of estoppel can only be invoked to promote fair dealings.""

[emphasis supplied]

122. The aforesaid observations are fully applicable in the facts of the present case. I have already concluded above that the defendant has adopted the mark CLAVIX in a dishonest manner. Therefore, the plaintiff cannot be denied the relief of permanent injunction even if there is any delay on the part of the plaintiff in instituting the present suit.

123. In the present case, the plaintiff has pleaded in the plaint that it came to know about the defendant's use of the impugned mark CLAVIX in mid-2005. In its evidence, PW-1 has deposed that the business of the defendant under the impugned mark started to affect the business of the plaintiff only in the year 2006-07. Accordingly, the present suit was filed in the year 2008.

124. In the case of **Dr. Reddy's Laboratories v. Reddy Pharmaceuticals**²⁹ before a coordinate bench of this Court, the defendant was using the trade name 'Reddy Pharmaceutical Limited' for a long time in relation to bulk drugs, *i.e.*, goods not similar to that of the plaintiff. It was only in 2003 that

²⁹ 2004 SCC OnLine Del 668



the defendant launched various pharmaceutical preparations under the mark REDDY, which resulted in the plaintiff instituting a suit for infringement against the defendant.

125. This Court, in ***Dr. Reddy's*** (supra), reiterated the settled principle of law that trade mark/ copyright owners cannot be expected to initiate legal proceedings against every infringer and incur litigation cost, especially those proceedings which are too trivial or insignificant in terms of causing loss to the plaintiff's business. Accordingly, it was held that the plaintiff is entitled to wait till the time the user of its name starts harming its business interests and starts misleading and confusing its customers. The relevant observations of the Court in ***Dr. Reddy's*** (supra) are reproduced below:

*“16. ...till August, 2003 there was no clash of interests between the plaintiff and the defendant-company and in fact the defendant was engaged in advancing and promoting the business of the plaintiff-company by acting as its agent for the sale of bulk drugs. The threat came in August, 2003 when the defendant introduced in the market its pharmaceutical preparations and thereby threatened the business interests of the plaintiff company. This move of the defendant was mala fide on the face of it as it was not manufacturing pharmaceutical preparations earlier but now it was trying to market the pharmaceutical preparations manufactured by others under the trade mark “Reddy”...It cannot be said that the plaintiff has allowed the defendant to build a reputation or goodwill in trade name “Reddy” for use on pharmaceutical preparations. **Moreover, the owners of trade marks or copy rights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. If the impugned infringement is too trivial or insignificant and is not capable of harming their business interests, they may overlook and ignore petty violations till they assume alarming proportions. If a road side Dhaba puts up a board of “Taj Hotel”, the owners of Taj group are not expected to swing into action and raise objections forthwith. They can wait till the time the user of their name starts harming their business interests and starts misleading and confusing their customers.**”*

[emphasis supplied]

126. ***Dr. Reddy's*** (supra) was followed by this bench in ***Alkem Laboratories***



v. *Alchem International*³⁰, wherein it was observed that the plaintiff is entitled to sue when the defendant's business starts to pose a threat to the business interest of the plaintiff and not before. The relevant extracts of *Alkem* (supra) are set out below:

“46. This is illustrative of the fact that when the defendant started expanding its business and launching new products in 2017 and 2018, the plaintiff was compelled to file the present suit. The present suit was filed in the year 2018, when the plaintiff was of the view that the business activities of the defendant have expanded in a manner that it threatens the business interests of the plaintiff and would likely to mislead the consumers. Earlier, even though the plaintiff may be aware of the defendant, the business of the defendant was of a scale that it did not pose a threat to the business interest of the plaintiff.”

[emphasis supplied]

127. Therefore, in my considered view, it cannot be said that there was a delay in instituting the present suit. Accordingly, Issue no.6 is decided in favour of the plaintiff and against the defendant.

Damages

128. Counsel for the plaintiff submits that the reliefs *qua* damages and rendition of accounts have been sought in the plaint. Hence, the plaintiff would be entitled to damages/ rendition of accounts.

129. *Vide* order dated 5th January 2016, the plaintiff's claim for damages was amended from Rs. 20,00,000/- to Rs. 1 crore. However, no issue with regard to the damages and/ or rendition of accounts has been framed in the suit.

130. It is submitted on behalf of the plaintiff that damages/ rendition of accounts can be granted under Issue no.7, *i.e.*, Relief.

131. The plaintiff relies upon the evidence of the defendant, wherein the

³⁰ 2025 SCC OnLine Del 6412



defendant has provided its sales figures under the impugned mark CLAVIX from 2001 to 2014. The aforesaid sales figures are supported by a CA Certificate, which has been exhibited as **Exhibit DW-1/5**. The plaintiff also relies upon the cross-examination of DW-1 conducted by the plaintiff to contend that the profit margin of the defendant was 25%, which would translate into profits of approximately Rs. 75 crores. The cross-examination on which the plaintiff places reliance is set out below:

Q.144. In paragraph 8 of your affidavit you have mentioned sales turnover of Defendant of "CLAVIX" as Rs.199.76 Crores for the period 2001 to 2014. What has been the turnover for "CLAVIX" from 2014 to 31.03.2018 i.e. last four years?

A. I cannot give the exact figure without checking but it could be the range of Rs.275 to Rs.300 Crores for the period mentioned above.

Q.145. I put it to you that the margin of profit in the pharmaceutical industry is as high as 25% of the turnover.

A. Margin depends upon product to product. Vol. Most of the products are under Drug Pricing control Order. So it is the Government which fixes the prices.

132. It is submitted on behalf of the plaintiff that at the very least, the Court should award nominal damages in favor of the plaintiff.

133. At this stage, it may be apposite to mark a reference to the decision of this Court in *Kabushiki Kaisha Toshiba v. Tosiba Appliances*³¹, the relevant extracts of which are set out below:

"138. ...The Court's decision on awarding damages must be predicated on a substantive examination of evidence that justifies the quantum of such compensation. The burden of proving damages rests unequivocally with the Plaintiff. To succeed, the Plaintiff must present compelling evidence substantiating the claimed damages resulting from the

³¹ 2024 SCC OnLine Del 5594



Defendant's alleged infringement. They must provide a reasonable estimate of the amount claimed, foundational facts, account statements, and supporting documentary and/or oral evidence. This entails establishing a direct link between the Defendant's actions and the claimed damages and quantifying these damages in a manner acceptable in law. They must demonstrate how the claimed figure was reached and the methodology employed, which must withstand the Court's scrutiny. Speculative or hypothetical assertions cannot form the basis for a substantial damages award.

139. *The Plaintiff's late introduction of a claim for damages totalling Rs. 25,00,000/- along with punitive damages is premised on speculative assumptions rather than tangible evidence. This claim is derived from an extrapolation of the Defendant's sales data, specifically using sales bills, invoices for "TOSIBA" products, and a Chartered Accountant's certification of the Defendant's annual sales. The Plaintiff estimates the Defendant's profits from the sale of allegedly infringing products by assuming a profit margin of 10%. **Such an approach to assessing damages post-trial, without evidence or proof and opportunity to the Defendant to controvert cannot be accepted.** Pertinently, the parties conducted a trial on an entirely different premise and the Defendant was not confronted with this claim any time prior to filing of the written submissions. **In absence of direct, tangible evidence linking the Defendant's actions to quantifiable losses incurred by the Plaintiff, this method of calculation remains conjectural and insufficient to form the basis for a credible claim for damages. Thus, due to lack of evidence put forth by the parties during the trial, the Court is not inclined to award damages as claimed.** In the precedents cited by Plaintiff, persuasive material elaborating the foundation of the claimed amount of damages, such as the product-wise price chart, detailed account of profit earned on each sale and seizures made by a Local Commissioner, was presented to the Court. **Contrastingly, in the case at hand, the Plaintiff's claim is entirely dependent on the evidence of sale of "TOSIBA" products of the Defendant, without any breakdown of amounts purportedly due to the Plaintiff. Plaintiff's claim of intangible losses manifested in the form of loss of consumer confidence and trust also fails to persuade the Court, given the Plaintiff's inability to establish their reputation in India at the relevant juncture.***

140. *Nonetheless, the Court is empowered to award nominal damages to the aggrieved party who is able to establish that they have suffered an injury caused by the wrongful conduct of a wrongdoer but cannot offer proof of a loss that can be compensated. This is particularly necessary when the infringement of rights is clear, as in the present case, where the Defendant has used a deceptively similar mark. The rationale behind this is to affirm the rights of the trademark holder and recognize the wrongdoing, albeit the actual damage might not be quantifiable due to the*



Plaintiff's lack of express evidence. Given the protracted duration of this lawsuit - spanning three decades - and the continuous use of the infringing mark by the Defendant throughout this period, it is both reasonable and just for the Court to award nominal damages. Therefore, in recognition of these factors and in line with judicial precedents that support the award of nominal damages in cases of clear infringement but insufficient proof of actual damage [See : Gujarat Ginning and Manufacturing Co. Ltd. v. Swadeshi Mills Co. Ltd., 1938 SCC OnLine Bom 94], the Court finds it appropriate to award nominal damages of Rs. 15,00,000/-. This amount is intended not as a measure of actual loss suffered, but as a minimal compensatory amount reflecting the infringement's duration and the need to uphold trademark rights."

[emphasis supplied]

134. The aforesaid observations are entirely applicable in the present case.

135. I am in complete agreement with the aforesaid findings of the coordinate bench. The onus to make out a case for damages in a suit is unequivocally on the plaintiff. Material evidence is required to justify the quantum of damages claimed by the plaintiff and the same must be directly linked to the loss suffered on account of the defendant selling the impugned product. However, in the present case, the plaintiff has failed to lead any evidence in respect of the claim of damages. The only basis for the plaintiff to claim damages is the alleged profit margin of 25% over the approximate sale of CLAVIX by the defendant. The onus of proving damages/ rendition of accounts cannot be shifted to the defendant nor can it be awarded on the basis of mere speculative or hypothetical claims. It was for the plaintiff to lead positive evidence to show loss suffered by the plaintiff on account of the defendant selling CLAVIX in India or the profits made by the defendant for the relief of rendition of accounts. Having failed to do so, the plaintiff would not be entitled to damages and/ or rendition of accounts.

136. However, in the facts and circumstances of the present case, the plaintiff has made out a case for infringement in its favour and against the



defendant. This Court has also come to the conclusion that the defendant's adoption of the impugned mark was dishonest. Further, given the fact that there was no interim injunction in favour of the plaintiff restraining the defendant from using the impugned mark CLAVIX, the defendant has continuously been able to sell its drug CLAVIX during the pendency of the suit, *i.e.*, from 2008 to 2026.

137. In light of the aforesaid findings, this Court deems it appropriate to award nominal damages amounting to Rs. 20,00,000/- in favour of the plaintiff for the loss and injury suffered by the plaintiff. The aforesaid amount shall be paid by the defendant within a period of eight (8) weeks.

138. It is clarified that the said amount is not towards actual loss or damage suffered by the plaintiff but as a minimal compensation in light of the conclusion of the Court that the defendant has infringed the plaintiff's mark

Plavix.

Costs

139. Counsel for the plaintiff presses for actual costs of litigation in relation to the present suit.

140. In this regard, a reference may be made to Section 35 of the Code of Civil Procedure, 1908 as applicable to the commercial disputes:

“35. Costs.— (1) In relation to any Commercial dispute, the Court, notwithstanding anything contained in any other law for the time being in force or Rule, has the discretion to determine:

- (a) Whether costs are payable by one party to another;*
- (b) The quantum of those costs; and*
- (c) When they are to be paid*

Explanation.—For the purpose of clause (a), the expression “costs” shall mean reasonable costs relating to—



- (i) *the fees and expenses of the witnesses incurred;*
- (ii) *legal fees and expenses incurred;*
- (iii) *any other expenses incurred in connection with the proceedings.*

(2) If the Court decides to make an order for payment of costs, the general rule is that the unsuccessful party shall be ordered to pay the costs of the successful party:

Provided that the Court may make an order deviating from the general rule for reasons to be recorded in writing.”

[emphasis supplied]

141. A reference may also be made to Rule 2 of Chapter XXIII of the Delhi High Court (Original Side) Rules, 2018, which is set out below:

“2. Imposition of actual costs. – In addition to imposition of costs, as provided in Rule 1 of this Chapter, the Court shall award costs guided by an upto actual costs as borne by the parties, even if the same has not been qualified by parties, at the time of decreeing or dismissing the suit. In this behalf the Court will take into consideration all relevant factors including (but not restricted) the actual fees paid to the Advocates/ Senior Advocates; actual expenses for publication, citation etc.; actual costs incurred in prosecution and conduct of the suit including but not limited to costs and expenses incurred for attending proceedings, procuring attendance of witnesses, experts etc.; execution of commissions; and all other legitimate expenses incurred by the party; which the Court orders to be paid to any party.

In addition to imposition of costs as above, the Court may also pass a decree for costs as provided in Sections 35-A and 35-B of the Code or any applicable law.”

[emphasis supplied]

142. The Supreme Court in *Uflex Limited v. Government of Tamil Nadu*³² has laid down the principles for determining costs in commercial matters. The relevant observations of the Supreme Court are set out below:

“55. We may note that the common thread running through all these three cases is the reiteration of salutary principles: (i) costs should ordinarily follow the event; (ii) realistic costs ought to be awarded keeping in view the ever-increasing litigation expenses; and (iii) the costs should serve the purpose of curbing frivolous and vexatious litigation. [Report No. 240 of the Law Commission of India]

³² 2021 SCC OnLine SC 738



56. *We may note that this endeavour in India is not unique to our country and in a way adopts the principle prevalent in England of costs following the event. The position may be somewhat different in the United States but then there are different principles applicable where champerty is prevalent. No doubt in most of the countries like India the discretion is with the court. There has to be a proportionality to the costs and if they are unreasonable, the doubt would be resolved in favour of the paying party [UK Civil Procedure Rule 44.2]. As per Halsbury's Laws of England, the discretion to award costs must be exercised judicially and in accordance with reason and justice. [Vol. 10, 4th Edn. (Para 15)] The following principles have been set out therein:*

“In deciding what order (if any) to make about costs, the court must have regard to all the circumstances, including:

(i) The conduct of all the parties;

(ii) Whether a party has succeeded on part of his case, even if he has not been wholly successful; and

(iii) Any payment into court or admissible offer to settle made by a party which is drawn to the court's attention.

The conduct of the parties includes:

(a) Conduct before, as well as during, the proceedings and in particular the extent to which the parties followed any relevant pre-action protocol;

(b) Whether it was reasonable for a party to raise, pursue or contest a particular allegation or issue;

(c) The manner in which a party has pursued or defended his case or a particular allegation or issue; and

(d) Whether a claimant who has succeeded in his claim, in whole or in part, exaggerated his claim.” [10th Vol. 4th Edn. (Para 17)]

58. *We have set forth the aforesaid so that there is appreciation of the principles that in carrying on commercial litigation, parties must weigh the commercial interests, which would include the consequences of the matter not receiving favourable consideration by the courts. Mindless appeals should not be the rule. We are conscious that in the given facts of the case the respondents have succeeded before the Division Bench though they failed before the learned Single Judge. Suffice to say that all the parties before us are financially strong and took a commercial decision to carry this legal battle right up to this Court. They must, thus, face the consequences and costs of success or failure in the present proceedings.”*

[emphasis supplied]

143. The present suit was instituted as far back in 2008 and involved multiple hearings. Additionally, Local Commissioner was appointed by this



Court to record evidence.

144. As discussed above, the plaintiff has succeeded in establishing a case for infringement of its mark **Plavix** by the defendant.

145. Taking into account the aforesaid position, I am of the view that in the facts and circumstances of the present suit, the plaintiff is entitled to recover actual costs from the defendant.

146. In view of the above, for the purposes of calculation of actual costs, the plaintiff shall file its bill of costs in terms of Rule 5 of Chapter XXIII of the Delhi High Court (Original Side) Rules, 2018 within four (4) weeks. For this purpose, the representatives of the plaintiff shall appear before the Taxation Officer on 14th July 2026, who shall determine the actual costs incurred by the plaintiff in the present suit.

147. Costs as determined by the Taxation Officer shall be paid by the defendant within a period of eight (8) weeks from the date of determination.

Relief

148. A decree is accordingly passed in favour of the plaintiff and against the defendant in the following terms:

- (i) Permanent injunction restraining the defendants, their proprietor, partners, principal officers, servants, agents, dealers, distributors and/ or other representatives from manufacturing, selling, offering for sale medicinal preparations and other allied or cognate goods under the mark CLAVIX or any other mark identical with or deceptively similar to the plaintiff's mark **Plavix** registered under trade mark no.806651 in class 5 amounting to infringement;



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(ii) Nominal damages to the extent of Rs.20,00,000/-;

(iii) Actual costs.

149. Let decree sheet be drawn up accordingly.

150. All pending applications stand disposed of.

**AMIT BANSAL
(JUDGE)**

APRIL 28, 2026

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