



IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION
INTERIM APPLICATION NO. 4006 OF 2022
IN
COMMERCIAL IP SUIT NO. 256 OF 2022

Laboratoires Griffon Private Limited And Anr. ...Applicants/Plaintiffs

Versus

Psychotropics India Limited ...Respondent/Defendant

Dr. Veerendra Tulzapurkar, Senior Counsel, a/w. Mr. Rashmin Khandekar, Ms. Archita Gharat and Mr. Kiran Mehta i/b. Kiran Mehta, for the Applicants/Plaintiffs.

Mr. Alankar Kirpekar a/w. Mr. Jash J. Dalia, Mr. Ayush Tiwari, Ms. Yasheswini Sharma and Mr. Anantkumar Nikam, for the Defendant.

CORAM : ARIF S. DOCTOR, J

RESERVED ON : 21st APRIL 2026

PRONOUNCED ON : 15th JUNE 2026

P.C.

1. The present Interim Application seeks to restrain the Defendant from infringing the Plaintiffs' registered trade mark i.e., 'GRILINCTUS' ("the Plaintiffs' mark"), and from passing off the Defendant's products as those of the Plaintiffs. For convenience, reference to the parties in this Order shall be as they are arrayed in the captioned Commercial IP Suit.

The Facts in Brief:

2. Plaintiff No. 1, on 31st August 1972, obtained registration of the Plaintiff's mark i.e., 'GRILINCTUS'. Additionally, Plaintiff No. 1 is the registered proprietor of several other allied marks, of which 'GRILINCTUS' is an essential part ("**the allied marks**"). Plaintiff No. 1 then assigned the allied marks to Plaintiff No. 2 vide a Deed of Assignment dated 25th January 1988. Thereafter, on 8th March 2012, Plaintiff No. 2 reassigned all the rights and goodwill in the allied marks consisting of the word 'GRILINCTUS' back to Plaintiff No. 1 by a Deed of Assignment, which is appended as Exhibit 'C' to the Plaint.
3. It is the Defendant's case that in the year 2008, the Defendant adopted the mark 'PIL-LINCTUS' ("**the impugned mark**") and also commenced use thereof in the same year.
4. On 17th January 2018, the Defendant applied for registration of the impugned mark in Class 5 vide Application No. 3729972. The Plaintiffs filed a notice of opposition dated 20th June 2021 to oppose the said

application. The said application, thereafter, appears to have been abandoned by the Defendant.

5. It is the Plaintiffs' case that it was only in the year 2021 that the Plaintiffs became aware of the impugned mark and thus filed the present Suit on 20th August 2021.
6. Subsequent to the filing of the present Suit, the Defendant, on 8th October 2021, filed a fresh application for registration of the impugned mark, being Application No. 5166666. The Plaintiffs have opposed this Application by filing a notice of opposition dated 5th June 2022, which is presently pending adjudication.

Submissions on behalf of the Plaintiffs:

7. Dr. Tulzapurkar, Learned Senior Counsel appearing on behalf of the Plaintiffs, at the outset submitted that the Defendant, by adopting the impugned mark 'PIL-LINCTUS', had plainly infringed the Plaintiffs' registered trade mark 'GRILINCTUS', more so since the Defendant was using the impugned mark in relation to a cough syrup, being the very same

product in respect of which the Plaintiffs are using the mark ‘GRILINCTUS’.

8. Dr. Tulzapurkar then submitted that it was well settled that rival marks must be compared as a whole and, in support of this contention, placed reliance upon the decision of the Hon’ble Supreme Court in *Amritdhara Pharmacy v. Satya Deo Gupta*¹ He also relied upon the decision of this Court in *Hiralal Parbhudas v. Ganesh Trading Company and Ors.*², which he submitted had laid down the following principles governing the comparison of rival trade marks viz.

“5. What emerges from these authorities is (a) what is the main idea or salient features, (b) marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole, (c) overall similarity is the touchstone, (d) marks must be looked at from the view and first impression of a person of average intelligence and imperfect recollection, (e) overall structure, phonetic similarity and similarity of idea are important and both visual and phonetic tests must be applied, (f) the purchaser must not be put in a state of wonderment, (g) marks must be compared as a whole, microscopic examination being impermissible, (h) the broad and salient features must be considered for which the marks must not be placed side by side to find out differences in design and (i) overall similarity is sufficient. In addition, indisputably must also be taken into

¹ (1962) SCC OnLine SC 13.

² 1983 SSC Online Bom 284.

consideration the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances.” (emphasis supplied)

9. Applying the aforesaid principles to the facts of the present case, Dr. Tulzapurkar submitted that there could be no manner of doubt that the rival marks, viz., ‘PIL-LINCTUS’ and ‘GRILINCTUS’, were phonetically, visually, and structurally similar. He submitted that the concurrent use of the rival marks was therefore likely to cause deception and confusion amongst consumers and members of the trade alike.
10. He submitted that another important factor which required consideration was that the rival products sold under the competing marks were both cough syrups, having different compositions. He pointed out that this fact was not disputed by the Defendant. He submitted that, since the products were medicinal and pharmaceutical preparations with different compositions, any confusion between them could potentially have disastrous consequences. On this ground alone, he submitted, the Defendant ought to be restrained from using the impugned mark.

11. In support of this contention, Dr. Tulzapurkar placed reliance upon the decision of the Hon'ble Supreme Court in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*³, which held that a stricter standard must be applied in cases involving medicinal products since confusion regarding their identity could have disastrous consequences. He also relied upon the decision of this Court in *Wyeth Holdings Corporation & Anr. v. Burnet Pharmaceuticals Pvt. Ltd.*⁴, to point out that where rival products were medicinal preparations intended for the same ailment, greater care was required since even the possibility of confusion may have serious consequences for public health, and deceptive similarity in medicinal marks must therefore be viewed strictly.

12. Dr. Tulzapurkar then submitted that the adoption of the impugned mark by the Defendant was plainly dishonest. According to him, such dishonesty was evident from the fact that the Plaintiffs' marks were already registered at the time when the Defendant claimed to have adopted the impugned mark, whether in the year 2006 or 2017, and thus the Defendant had or then

³ (2001) 5 SCC 73.

⁴ 2008 SCC Online Bom 76.

deemed to have had knowledge of the Plaintiffs' mark. In support of his contention, he placed reliance upon the decision of the Division Bench of this Court in *Bal Pharma Ltd. v. Centaur Laboratories Pvt. Ltd. & Anr.*⁵ and submitted that it was incumbent upon the Defendant, prior to adopting the impugned mark, to undertake a search of the Trade Marks Registry. He submitted that the Defendant having failed to do so, could not claim bona fide adoption and must bear the consequences of such failure by being restrained from using the impugned mark, which was deceptively similar to the Plaintiffs' mark.

13. Conversely, he submitted that if the Defendant had adopted the impugned mark with actual or deemed knowledge of the Plaintiffs' registered mark, it necessarily followed that the Defendant ought to be enjoined from using the same. He submitted that in such circumstances the Plaintiffs were entitled not only to the statutory protection conferred by Sections 28 and 29 of the Trade Marks Act, 1999 but also to protection in the larger public

⁵ 2001 SCC OnLine Bom 1176.

interest so as to avoid confusion and deception amongst members of the public and trade alike.

14. Dr. Tulzapurkar further submitted that the Plaintiffs had adopted and used a series of marks containing the word 'GRILINCTUS'. Consequently, he submitted that the goods sold under the impugned mark were likely to be perceived as emanating from the Plaintiffs or as being associated with the Plaintiffs. In support of this contention, he placed reliance upon the decision of this Court in *Neon Laboratories Ltd. v. Themis Medicare Ltd. & Anr.*⁶, which he pointed out held that where a proprietor has adopted and used a series of marks sharing a common and distinctive element, adoption by a rival of a mark containing that essential feature was likely to lead consumers to assume that the impugned product forms part of the proprietor's established range or is otherwise commercially associated with such proprietor and/or prior adopter.

15. Dr. Tulzapurkar then submitted that the Defendant's contention of alleged use of the impugned mark was plainly false and was also replete with

⁶ 2014 SCC Online Bom 1087.

inconsistencies and contradictions. In support of this contention, he pointed out that the Defendant had (i) in an affidavit filed before the Trade Marks Registry, stated that the Defendant had not commenced use of the impugned mark and was merely taking steps to promote the products proposed to be sold thereunder; (ii) thereafter stated that the stand taken in the affidavit filed before the Trade Mark Registry was an error; (iii) in reply to the examination report, did not claim use of the impugned mark since 2008 but merely asserted that the impugned mark had acquired goodwill within a short span of time; (iv) before the Registrar of Trade Marks, relied only upon invoices from 2018 onwards; and (v) in the Counter Statement filed in the opposition proceedings, claimed use of the impugned mark since December 2017. He then took pains to point out that the Defendant had, in paragraph 14 of the Counter Statement, specifically admitted that there existed a very high degree of phonetic, structural, and visual similarity between the rival marks. This concession by the Defendant he submitted was fatal and one which the Defendant could not resile from.

16. Dr. Tulzapurkar then submitted that even assuming the Defendant had established user of the impugned mark, such user would not assist the Defendant since it was subsequent to the Plaintiffs' registration and use. He submitted that the concept of concurrent use as a defence to an action for infringement and passing off was alien to trade mark law.
17. In addition to infringement, Dr. Tulzapurkar submitted that the Defendant's use of the impugned mark also amounted to passing off. He submitted that the Plaintiffs had acquired substantial reputation and goodwill in the mark 'GRILINCTUS' and had also carried out extensive sales by using the said trade mark. In support of his contention, he placed reliance upon Exhibits 'F' and 'G' to the Plaintiffs, i.e., the sales figures; Exhibits 'H-1' to 'H-19', i.e., the sample invoices; and Exhibits 'I-1' to 'I-7', i.e., the promotional material.
18. In addition to the above, Learned Senior Counsel also pointed out that the Plaintiffs had annexed to the Affidavit in Sur-Sur-Rejoinder invoices from the years 1975, 1976, 1987, 1989, 1998, 1999, 2000 and 2003–2007, all of which established that the Plaintiffs' marks had acquired distinctiveness

and had become exclusively associated in the minds of traders and consumers with the Plaintiffs. Given this, and the deceptive similarity between the rival marks he submitted, deception, confusion and association were bound to ensue. He therefore submitted that the Plaintiffs had made out a case not only for infringement but also for passing off.

19. Learned Senior Counsel further submitted that the Defendant's conduct was manifestly dishonest. He submitted that this was evident from the fact that Defendant had, in the year 2009, applied for registration of the mark 'BRILINCTUS', which was opposed by the Plaintiffs on the ground that it was deceptively similar to the Plaintiffs' mark, following which the Defendant abandoned the application. He submitted that this clearly demonstrated the Defendant's knowledge that the Plaintiffs consistently protected their registered trade marks. He also pointed out that in proceedings concerning the mark 'PIL-REST', the Registrar had rejected the Defendant's contention that 'PIL' constituted its house mark. Accordingly, he submitted that the Defendant's present attempt to justify use of 'PIL' as a house mark was demonstrably false to its own knowledge.

20. According to Dr. Tulzapurkar, the Defendant's dishonesty was further evidenced by the fact that, during the pendency of the present Suit, it had filed yet another application seeking registration of the impugned mark 'PIL-LINCTUS' while claiming use since 2008. He pointed out that this application had also been opposed by the Plaintiffs, since it had been filed without disclosure of the pendency of the present Suit concerning the very same mark.

21. Dr. Tulzapurkar submitted that the Plaintiffs had at all times acted diligently in protecting their rights in the mark 'GRILINCTUS'. In this regard, he invited my attention to various Orders obtained by the Plaintiffs restraining third parties from using the marks 'TORILINCTUS', 'ALLINTUS BM' and 'TINILINCTUS'.

22. Dr. Tulzapurkar concluded by reiterating that it was an admitted position that the rival marks were used in relation to cough syrups and that the goods, trade channels and class of consumers were all essentially the same. He therefore submitted that, given the deceptive similarity between the rival marks and the goodwill, reputation and large volume of sales

demonstrated by the Plaintiffs, a strong case of passing off, in addition to infringement, had also been made out. He thus submitted that the Interim Application deserved to be allowed and that the Defendant ought to be restrained from using the impugned mark 'PIL-LINCTUS' in respect of its products falling in Class 5 and from infringing the Plaintiffs' registered trade mark 'GRILINCTUS'.

Submissions on the behalf of the Defendant:

23. Mr. Kirpekar, Learned Counsel appearing on behalf of the Defendant, submitted that the Defendant is a private limited company engaged in the manufacture and marketing of medicinal products and has been in existence since the 1980s. He pointed out that 'PIL' is an acronym derived from the Defendant's corporate name, namely Psychotropics India Limited, and nothing more.

24. He submitted that the Defendant had successfully obtained several trade mark registrations incorporating either the prefix or suffix 'PIL' in Classes 3 and 5, as evidenced by the registration certificates annexed as Exhibits 'E-1' to 'E-26' to the Reply. He submitted that the Defendant had, over

several decades, cultivated a business identity centred on the trade name 'PIL'. He further submitted that the Defendant had consistently adopted the use of a hyphen as part of its trade mark architecture across various products such as 'PIL-SB', 'PILTEN-M' and 'PIL GPM-SR'. He therefore submitted that 'PIL', when used with a hyphen, functions as the Defendant's house mark and that the hyphen is a common feature employed by the Defendant to distinguish different products within the Defendant's range of products.

25. Mr. Kirpekar then submitted that the word 'LINCTUS' is a recognised term in the pharmaceutical and medical trade describing a syrupy medicinal preparation used in the treatment of cough and throat ailments. In support of his contention, he relied on extracts from websites, Codex research papers, and dictionary definitions, which are more particularly set out in Exhibit 'A' to the Sur-Rejoinder. He therefore submitted that 'LINCTUS' was descriptive in character, common to the trade and *publici juris*, and was incapable of being monopolised by the Plaintiffs.

26. Mr. Kirpekar then also placed reliance upon a search report annexed as Exhibit 'I' to the Defendant's Affidavit in Reply and Exhibit 'C' to the Affidavit in Sur-Rejoinder, from which he pointed out that there were presently more than thirty valid trade mark registrations containing the word 'LINCTUS'. He further submitted that several reputed pharmaceutical companies were using 'LINCTUS' as either a prefix or a suffix in their respective trade marks. He also submitted that even at the time when the Plaintiffs acquired their mark in 1971 on a proposed-to-be-used basis, there existed several pre-existing and contemporaneous marks containing the suffix 'LINCTUS', including 'CODIN LINCTUS', 'ACTILINCTUS' and 'MITS LINCTUS-D'. He therefore submitted that it was not open to the Plaintiffs to contend that 'LINCTUS' was exclusively associated with them or that they possessed any monopoly over that expression.

27. Mr. Kirpekar then invited my attention to Section 17(2)(b) of the Trade Marks Act, 1999 to point out that the same clearly provided that registration of a composite mark does not confer exclusive rights in respect

of any element thereof which was common to the trade or otherwise non-distinctive. He pointed out that the Plaintiffs had never obtained an independent registration for the word 'LINCTUS' and, therefore, could not assert exclusive rights over that word in isolation. He also submitted that the Plaintiffs could not dissect their registered mark and claim protection in respect of a single component thereof, since it was well settled that rival marks must be considered as a whole.

28. Mr. Kirpekar then also placed reliance upon the proviso to Section 36 of the Trade Marks Act, 1999 and submitted that where a word has become established in the trade as the name or description of an article or substance, no person could claim exclusivity in respect of such. He submitted that the present case was a classic illustration of such a situation, since 'LINCTUS' was widely recognised in the pharmaceutical industry as a term for cough syrup formulations.

29. Mr. Kirperkar then placed reliance upon the decisions in the case of *Franco Indian Pharmaceuticals Pvt. Ltd. v. Lupin Ltd. & Anr.*⁷, *J.R. Kapoor v. Micronix India*⁸ and *Bal Pharma Limited v. Wockhardt Limited*, to point out that where a mark contains a common, descriptive, or generic element or is found to be *publici juris*, no proprietor can claim exclusivity or monopoly over the common element and that the rival marks must therefore be considered as a whole in order to determine whether or not they are deceptively similar.

30. Mr. Kirperkar then also placed reliance upon the decision of the Hon'ble Supreme Court in *F. Hoffmann-La Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd.*⁹, from which he pointed out that the marks in question in that case, i.e., 'DROPOVIT' and 'PROTOVIT', were held to be dissimilar because the common suffix 'VIT' was descriptive of vitamins and the distinctive portions of the rival marks in that case, i.e., 'DROPO' and 'PROTO', were sufficiently different to avoid confusion.

⁷ 2017 SCC OnLine Bom 143.

⁸ 1994 Supp (3) SCC 215.

⁹ 2001 SCC OnLine Bom 1176.

31. Drawing a parallel to the facts of the present case, Mr. Kirpekar submitted that once 'LINCTUS' is recognised as a descriptive and common-to-trade element, the distinguishing portions of the rival marks are their respective prefixes, namely 'GRI' and 'PIL'. He submitted that these prefixes were entirely different visually, phonetically and conceptually and constituted the dominant source-identifying features of the respective marks.

32. Mr. Kirpekar further submitted that the Defendant's mark 'PIL-LINCTUS' is structurally, visually and conceptually distinct from the Plaintiffs' mark 'GRILINCTUS'. He pointed out that the Defendant's mark comprises of two separate elements, i.e., 'PIL' and 'LINCTUS', which were separated by a hyphen. He submitted that the use of a hyphen created both a visual break and a phonetic pause, and therefore the impugned mark was perceived and pronounced as two separate and distinct components. Conversely, he submitted that the Plaintiffs' mark was a single word and pronounced as such. Mr. Kirperkar then submitted that what the Plaintiffs were effectively seeking to do was to isolate the common element 'LINCTUS' and thereby claim a monopoly over a

descriptive expression, which was impermissible in law. In support of his contention, he placed reliance upon the decision of the Hon'ble Supreme Court in the case of *Pernod Ricard India (P) Ltd. v. Karanveer Singh Chhabra*¹⁰ from which he pointed out that generic elements cannot form the basis for establishing deceptive similarity and that competing marks must be considered in their entirety.

33. Mr. Kirpekar then submitted that the Plaintiffs had failed to establish a case for passing off. He submitted that in order to succeed in such an action the Plaintiffs were required to *inter alia* establish (i) goodwill and reputation in the mark; (ii) misrepresentation by the Defendant leading the public to believe that the Defendant's goods originated from or were associated with the Plaintiffs; and (iii) consequent damage or likelihood of damage. He submitted that in the facts of the present case, the Plaintiffs had not established any of these elements.

¹⁰ (1969) 2 SCC 716.

34. Mr. Kirperkar then also submitted that the Plaintiffs had failed to demonstrate continuous use of the mark since 1971 and that many of the invoices relied upon by the Plaintiff, in fact, emanated from a third party, i.e., Franco-Indian Pharma Pvt. Ltd. He also pointed out that the invoices annexed to the Plaint were largely from the year 2018 onwards, whereas the Defendant had been using the impugned mark since 2008. He therefore submitted that the Plaintiffs were unable to demonstrate continuous commercial use corresponding to their claim of use dating back to 1971. He thus submitted that the present Suit was founded primarily upon a registration obtained on a proposed-to-be-used basis and unsupported by sufficient evidence of continuous use or assignment.

35. Mr. Kirpekar then also submitted that there was no likelihood of confusion amongst consumers or members of the trade since, firstly, the rival products were sold under entirely different trade dress, packaging and get-up and, secondly, the products were prescription medicines and were not sold as over-the-counter products. He then, from the decision of the Hon'ble Supreme Court in *Cadila Laboratories Ltd. & Anr. v. Dabur*

*India Limited*¹¹ pointed out that when the rival products differ in appearance and the same are not available for individual sale, a case for infringement cannot be said to have been made out.

36. Mr. Kirpekar then submitted that the Plaintiffs' assertion that the Plaintiffs had become aware of the impugned mark only in the year 2021 was wholly untenable. He then submitted that the Defendant had openly and continuously used the impugned mark since 2008 and had obtained a drug licence on 3rd June 2006 in respect of 'PIL-LINCTUS SYRUP', as was evident from Exhibit 'D' to the Reply. He submitted that this demonstrated the Defendant's bona fide intention to market the product under the impugned mark and negated any allegation of dishonest adoption.

37. He then submitted that the Plaintiffs' reliance upon the decisions in the case of *Amritdhara Pharmacy* and *Hiralal Parbhudas* was misplaced. He submitted that the factual matrix in those cases was materially different, as

¹¹ 1997 SCC OnLine Del 360.

the common elements in the rival marks were not shown to be descriptive or generic in the same manner as 'LINCTUS' is in the present case.

38. Mr. Kirpekar further submitted that the Plaintiffs' reliance upon the decisions in *Cadila Healthcare*, *Sytex Labs* and *Wyeth Holdings Corporation* were also equally misconceived since the rival marks in the present case were not phonetically or visually similar but were, on the contrary, clearly distinguishable. He also submitted that the decision in *Bal Pharma Ltd.* did not assist the Plaintiffs since a search of the Trade Marks Registry would itself have revealed numerous registrations incorporating the word 'LINCTUS', thereby demonstrating that the expression was open to trade and not exclusively associated with the Plaintiffs.

39. Lastly, Mr. Kirpekar submitted that the Defendant had openly and continuously used the mark 'PIL-LINCTUS' since 2008 and had, over the course of more than fifteen years, built substantial goodwill and recognition in the market. He submitted that the parties were independent competitors operating in a market where the word 'LINCTUS' was a recognised descriptive term. He thus submitted that the Plaintiffs had stood

by for years while the Defendant had developed a distinct market identity centred around the house mark 'PIL'. He therefore submitted that the Plaintiffs' inaction amounted to acquiescence and that the balance of convenience was overwhelmingly in favour of the Defendant. He submitted that granting an injunction at this stage would cause grave prejudice to the Defendant and would effectively permit the Plaintiffs to monopolise a descriptive expression that had long remained available to the trade.

40. Mr. Kirpekar, therefore, submitted that the Interim Application was devoid of merit and deserved to be dismissed with costs.

Submissions in Rejoinder:

41. Dr. Tulzapurkar submitted that it was not open to the Defendant to contend that 'LINCTUS' was generic since the Defendant had applied for registration of the impugned mark of which the word 'LINCTUS' formed an essential part. In support of his contention, he placed reliance upon the decision of this Court in the case of *UltraTech Cement Limited v.*

*Alkandanda Cement Pvt. Ltd.*¹² where the marks involved were ULTRATECH and ULTRATUFF, and pointed out that this Court had observed that since the Defendant therein had applied for registration of the impugned word ULTRATUFF, the Defendant was estopped from contending that the word 'ULTRA' was descriptive or common to the trade.

42. He also submitted that the fact that both products were available by prescription was also irrelevant in view of the decision of the Hon'ble Supreme Court in *Cadila Healthcare Ltd.* which had specifically taken note of the fact that in India even prescription medicines were sold over the telephone and had observed that "*Drugs are poisons, not sweets. Confusion between medicinal products, may, therefore be life threatening, not merely inconvenient*".

43. Dr. Tulzapurkar then also submitted that the Defendant's contention that there was delay, laches, and acquiescence was also wholly unsustainable. He submitted that, in any event, delay and laches were not, by themselves,

¹² 2011 SCC Online Bom 783.

defences to oppose interim relief if a case for the grant of such relief was otherwise made out. He submitted that the principle of acquiescence was based on equity, and to establish acquiescence, the Defendant was, *inter alia*, required to plead and prove that the Plaintiff had knowingly stood by and encouraged or assented to the Defendant's use of the impugned mark, thereby inducing the Defendant to alter its position to its detriment. He submitted that mere delay or inaction was not sufficient to constitute acquiescence. In support of his contention, he placed reliance upon the decisions in the case of *Willmott v. Barber*¹³ and also *M/s. Power Control Appliances and Ors. v. Sumeet Machines Pvt. Ltd.*¹⁴ .

44. Dr. Tulzapurkar submitted that in the instant case there was no question of the Defendant having made any mistake in adopting the impugned mark, as the Defendant was aware of the Plaintiffs' registered trade marks and, therefore, the essential requirement to prove acquiescence was not established. Secondly, he pointed out that the Plaintiffs had opposed the Defendant's application for registration, and thus the question of the

¹³ [L.R.] 15 Chancery Division 96.

¹⁴ 1994 2 SCC 448.

Plaintiffs encouraging the Defendant's use of the impugned mark did not arise. In support of his contention, he placed reliance upon the decision in the case of *Kamath Hotels (India) Ltd. v. Royal Orchid Hotels Ltd and Ors.*¹⁵ and *Schering Corporation v. Kiltch Co Pharma Pvt. Ltd.*¹⁶.

45. Dr. Tulzapurkar submitted that the Defendant's contention that there were several other marks in the market of which the word 'LINCTUS' formed part was wholly irrelevant to the facts of the present case, as the *lis* before this Court was confined only to the competing marks, i.e., 'GRILINCTUS' and 'PIL-LINCTUS'. He submitted that mere production of entries from the register or references to other marks was of no evidentiary value unless the Defendant pleaded and established by cogent material that such marks were in substantial, extensive, and actual use in the market. Absent proof of such use, no inference could be drawn that the common element had become *publici juris* or had lost its distinctiveness. In support of his contention, he placed reliance upon the decisions in the case of *Corn*

¹⁵ 2011 (4) M.h.L.J.

¹⁶ 1990 SCC Online Bom 425.

Products Refining Co. v. Shangrila Food Products Ltd. and National Bell Co. v. Metal Goods Mfg. Co. Pvt. Ltd.

46. Dr. Tulzapurkar submitted that the Defendant's contention that the Plaintiffs had failed to establish continuous use since 1971 was misconceived. He pointed out that Franco-Indian Pharmaceutical Pvt. Ltd. was not an independent third party but the Plaintiff's sister concern and authorised marketing and distribution entity, through whom goods bearing the 'GRILINCTUS' marks were sold, marketed, and distributed, and therefore invoices issued by such entity enured to the benefit of Plaintiff No. 1 as registered proprietor. He further submitted that the Plaintiffs had placed on record, including in the Affidavit in Sur-Sur Rejoinder, invoices from 1975 onwards, together with sales figures, promotional material and other documents evidencing continuous and uninterrupted use of the marks since 1973. Thus, the Defendant's reliance on a single invoice from 2018, while not considering earlier invoices from 1975 onwards, was, according to the Plaintiffs, wholly selective and misleading. He further submitted that the Defendant's alleged use was in any event subsequent to the Plaintiffs'

registration and prior use and that concurrent user was no defence to an action for infringement and passing off.

Reasons and Conclusions:

47. Having heard the learned counsel for the parties and having considered the rival contentions and the case law upon which reliance has been placed, I have no hesitation in holding that the Application deserves to be allowed.

I say so for the following reasons:

A. As held in the case of *Amritdhara Pharmacy* and *Hiralal Parbhudas*, deceptive similarity must be assessed by comparing the rival marks as a whole and not by dissecting them into their individual components. The enquiry must proceed on the basis of the overall impression created by the marks in the mind of a person of average intelligence and imperfect recollection. What is required to be considered is the overall structural, phonetic and visual impression created by the rival marks and the likelihood of confusion and/or association arising from their use. It is through this lens that the rival marks, namely ‘GRILINCTUS’ and ‘PIL-LINCTUS’, must be examined and compared.

- B. It is equally important to note that the Hon'ble Supreme Court in *Cadila Health Care Ltd.* has held that, particularly in cases involving medicinal and pharmaceutical products, a stricter approach must be adopted while assessing deceptive similarity, since confusion between medicinal products may have serious and, in some cases, disastrous consequences. The Hon'ble Supreme Court specifically observed that, in relation to medicinal products, even the possibility of confusion must be avoided since “*drugs are poisons, not sweets*”, and confusion between medicinal products may therefore be life-threatening rather than merely inconvenient.
- C. Applying the principles laid down in the aforesaid decisions, I am of the *prima facie* view that there can be little doubt that the rival marks ‘GRILINCTUS’ and ‘PIL-LINCTUS’ are aurally, phonetically and structurally similar. I say so because both marks are three-syllable words and, when pronounced, it is the suffix ‘LINCTUS’ that dominates and virtually eclipses the respective prefixes, namely ‘GRI’ and ‘PIL’. Although the impugned mark contains a hyphen, in my view, the use of a hyphen by itself is insufficient to obviate confusion. This is particularly so

because, as noted by the Hon'ble Supreme Court in ***Cadila Health Care Ltd.***, even prescription drugs in India are often ordered over the telephone and sold without prescriptions. In such circumstances, the hyphen pales into insignificance, and there exists a real and substantial possibility of confusion between the rival products, which, as held in ***Cadila Health Care Ltd.***, must be avoided. Thus, the law laid down in the case of ***Pernod Ricard India (P) Ltd.***, in my view, will not apply to the facts of the present case.

D. Hence, for the reasons stated in (C) above, I am of the *prima facie* view that the decision in ***F. Hoffmann-La Roche & Co. Ltd.***, would not apply. In that case, the rival marks, namely 'DROPVIT' and 'PROTOVIT', were distinguishable by their respective prefixes, which created distinct overall impressions. The present case stands on a different footing, as the common suffix 'LINCTUS' overwhelmingly dominates the pronunciation and overall impression of both marks. Further, and significantly, the Defendant has itself admitted in its Counter Statement filed before the Registrar of Trade Marks that there exists a "*very high degree of phonetic, structural*

and visual similarity” between the rival marks. Thus, the Plaintiffs’ reliance upon the decision in the case of *Neon Laboratories Ltd.* is apposite in the facts of the present case.

E. Even assuming that the word ‘LINCTUS’ is descriptive, for the reasons already recorded in (C) and (D) above, deception and confusion are nevertheless likely to arise. Another factor which merits consideration is that the Defendant, having itself sought registration of the mark ‘PIL-LINCTUS’, cannot now be permitted to contend that the essential feature of its mark, namely ‘LINCTUS’, is merely descriptive or common to the trade. In this regard, the Plaintiffs’ reliance on *UltraTech Cement Limited* is apposite. Consequently, in the facts of the present case, I find that the decisions in *Franco Indian Pharmaceuticals, J.R. Kapoor, F. Hoffmann-La Roche & Co. Ltd., Kamath Hotels (India) Ltd.,* and *Schering Corporation*, relied upon by the Defendant, would not apply.

F. I am also, at this *prima facie* stage, unable to accept the Defendant’s contention that the Plaintiffs are effectively seeking to monopolise ‘LINCTUS’. The Plaintiffs, as the registered proprietor of the composite

mark 'GRILINCTUS', are merely seeking to protect their registered mark as a whole from the deceptively similar mark, i.e., PIL-LINCTUS. Section 17(2)(b) of the Trade Marks Act, 1999 does not in any manner denude the proprietor of a registered composite mark of the right to protect the mark in its entirety, which is exactly what the Plaintiffs are seeking to do. The Plaintiffs are not seeking any exclusivity in 'LINCTUS' or in its use by the Defendant. It is possible that, had the Defendant adopted 'LINCTUS-PIL' as its mark, the Plaintiffs may have had no legitimate grievance, since such a mark would not create the same phonetic, visual or structural impression as 'GRILINCTUS'. Significantly, the Defendant's own registrations demonstrate that it has, in several instances, adopted 'PIL' as a suffix rather than a prefix, such as 'K-PIL' and 'NATURAL PIL'S SMART PET'.

G. *Also*, in my view, the conduct of the Defendant is another factor which, at this interlocutory stage, would go against Defendant. The Defendant has adopted the impugned mark despite being aware or then deemed to have been aware of the Plaintiffs' registered mark. Also, the Defendant had, in the year 2018, applied for registration of the impugned mark 'PIL-

LINCTUS', which was abandoned after it was opposed by the Plaintiff. The Defendant had, thereafter, in 2009, applied for registration of the mark 'BRILINCTUS', which the Plaintiffs also opposed and which was also subsequently abandoned. *Crucially*, the Defendant has taken inconsistent pleas regarding its claim of user of the impugned mark and has also failed to produce any material evidencing any substantial use of the impugned mark.

H. *Conversely*, there is no dispute that the Plaintiffs are and have been the registered proprietor of the mark 'GRILINCTUS' since the year 1973. The Plaintiffs have also, *prima facie*, established extensive and continuous use of the mark 'GRILINCTUS' and the fact that the Plaintiffs have substantial goodwill and reputation associated with the said mark and has also produced material which supports the fact that the Plaintiffs have acted diligently in protecting its statutory rights in respect of the said mark and has obtained injunctions against the use of TORILINCTUS, ALLINTUS BM and TINILINCTUS. In my *prima facie* view, therefore, the balance of convenience lies clearly in favour of the Plaintiffs.

- I. Though the Defendant has sought to contend that the Plaintiffs have relied upon third-party invoices to establish continuous use of the mark, given that the invoices relied upon are of Franco Indian Pharmaceuticals, which is a sister concern of the Plaintiffs, who was using the mark under licence from the Plaintiffs, such use would necessarily inure to the benefit of the Plaintiffs. I am, therefore, not inclined, at this *prima facie* stage, to accept the contention that the Plaintiffs have failed to establish continuous use of the Plaintiffs' mark.
- J. I also find no merit in the contention that the Plaintiffs are disentitled to relief on the grounds of delay and acquiescence. It is well settled that delay would not by itself be sufficient to disentitle the Plaintiffs to relief if a case is otherwise so made out. Equally, acquiescence requires proof of active encouragement or assent on the part of the Plaintiff to the Defendant's use of the impugned mark. In the present case, the Defendant has not produced any material to support the contention that the Plaintiff acquiesced in the Defendant's use of the impugned mark. On the contrary, the material upon which the Plaintiff placed reliance indicates that the Plaintiff has, in fact,

opposed the Defendant's trade mark applications. Hence, the Plaintiff's reliance upon the decisions in *Willmott, M/s. Power Control Appliances and Ors.*, and *Kamath Hotels (India) Ltd.* is entirely apposite.

K. Also, the Defendants' reliance on third-party registrations containing the word 'LINCTUS' is, in my view, insufficient at this stage to deny relief to the Plaintiff. It is well settled, as held in *Corn Products Refining Co.*, and *National Bell Co.*, that the burden of establishing actual third-party use lies upon the party asserting it. In my prima facie view, the Defendant has failed to place any substantial material on record demonstrating such use. That issue would, in any event, be more appropriately determined at trial.

L. As already noted in (B) and (C) above, the impugned mark is used in relation to a pharmaceutical product, in respect of which a stricter standard is required to be applied while assessing deceptive similarity, as held in *Cadila Health Care Ltd.* and *Wyeth Holdings Corporation & Anr.*. The Defendant's conduct, as noted in (G) above, also does not inspire confidence and, at this stage, appears to reflect a deliberate attempt to come as close as possible to the Plaintiff's registered trade mark

‘GRILINCTUS’. I am therefore *prima facie* satisfied that the Plaintiffs have established both prior registration and long-standing use of the trade mark ‘GRILINCTUS’. The rival marks are deceptively similar and are used in relation to substantially identical pharmaceutical products, albeit with different compositions. The Plaintiffs have therefore made out a strong *prima facie* case for the grant of interim relief.

41. Hence for the reasons set out in (A) to (L) above, I pass the following order:

ORDER

- i. The captioned Interim Application is allowed in terms of prayer clause ‘(a)’.
- ii. There shall be no orders as to costs.

[ARIF S. DOCTOR, J.]

42. After the pronouncement, Mr. Kirpekar sought a stay of Order. To this, Mr. Khandekar submitted that this Order will not be acted upon for a period of 4 weeks from today. His statement is accepted.

[ARIF S. DOCTOR, J.]