

IN THE COURT OF SH. VIDYA PRAKASH
DISTRICT JUDGE (COMMERCIAL COURT)-02
NEW DELHI DISTRICT, PATIALA HOUSE COURTS
NEW DELHI

CNR NO.: DLND01-009170-2024

CS (COMM.)/914/2024

IN THE MATTER OF:

RSPL HEALTH PRIVATE LIMITED
119-121 (PART) BLOACK P & T
FAZALGANJ, KALPI ROAD
KANPUR -208012
UTTAR PRADESH

CORPORATE OFFICE AT :
C-1, 2 & 3, PP TOWERS-A
3RD FLOOR, NETAJI SUBHASH PLACE
PITAMPURA, NEW DELHI – 110034

... PLAINTIFF

VERSUS

1. SUN PHARMA LABORATORIES LIMITED
SUN HOUSE, PLOT NUMBER 201 B/1
WESTERN EXPRESS HIGHWAY
GOREGAON (EAST)
MUMBAI- 400063

REGD. ADDRESS AT:
SUN PHARMA ADVANCED RESEARCH CENTRE
(SPARC)
TANDALJA, VADODARA-390012


2. HETERO LABS LIMITED (UNIT II)
KALYANPUR (VILLAGE), CHAKKAN ROAD
BADDI (TEHSIL), SOLAN (DISTT.)
HIMACHAL PRADESH, 173205

REGD. ADDRESS AT:
HETERO LABS LIMITED,
7-2-A2, HETERO CORPORATE INDUSTRIAL
ESTATE, SANATHNAGAR, HYDERABAD
TELANGANA, INDIA - 500018

... DEFENDANTS

ORDER

1. Vide this order, I shall decide the application under Order XXXIX Rules 1 and 2 read with S. 151 CPC seeking *ad interim injunction* against the defendants, filed on behalf of the plaintiff.
2. The facts relevant for the disposal of aforesaid application are that the plaintiff got instituted the present suit under S. 134, 135, 29 & 27 of the Trade Marks Act, 1999 for permanent injunction restraining infringement of trademarks, passing off, delivery up; damages; rendition of accounts etc. against the defendants, through its Authorized Representative namely Mr. Manoj Singh, DGM-Legal, who has been duly authorized by virtue of Board of Resolution passed in his favour by the plaintiff. The case of the plaintiff, as set out in the plaint, in nutshell is as under:-
 - 2.1 The plaintiff, which is stated to be part of the RSPL Group of Companies, is proprietor of various well-known trademarks such as GHARI/ GHADI LABEL, XPERT, VENUS, PRO-EASE, RED CHIEF, NAMASTE INDIA etc. in the field of cosmetics, FMGC, footwear, wind energy, real estate, diary products etc.
 - 2.2 It is stated that the plaintiff originally conceived, coined and adopted the trade mark/label PRO-EASE [*hereinafter referred to as the 'said trade mark'*] in the year 2012 in relation to sanitary napkins,

sanitary towels, sanitary pads, menstruation pads, menstruation briefs, sanitary panties, panty liners for hygienic or menstrual purposes, deodorizing agent and refreshener, other than for personal use; panty shields for hygienic or menstrual purposes, menstruation tampons, sanitary wipes, paper wipes impregnated with sanitizers and paper wipes impregnated with disinfectants etc. and allied and cognate goods [*hereinafter referred to as the 'said goods'*]. Further, it is stated that the said trade mark **PRO-EASE** and/or **PRO-EASE LABEL** are being used word *per se*, and in formative variations with different prefixes and/or suffixes as well as in artistic label form in composite label/ trade dress formats either individually or in combination with each other. These trade dress formats serve trademark functions for the plaintiff and are trademarks of the plaintiff. The trademark / label PRO-EASE/  [*hereinafter referred to as the 'said trade mark / label'*]. It is claimed that the plaintiff has been continuously, commercially, openly and to the exclusion of others, uninterruptedly and in the course of trade and as proprietors thereof, has been using said trademark/label in relation to its said goods and business and has built up a valuable trade, goodwill and reputation thereunder and acquired proprietary rights therein.

- 2.3 Thus, the plaintiff has claimed itself to be owner and proprietor of trademark/ label and stated that said trade marks/ label and formative trademarks have been registered under various classes under the provisions of Trade Mark Act, 1999, which are stated to valid and subsisting as on date in favour of the plaintiff and details thereof have been provided in Para no.6 of the plaint. It is also stated that plaintiff has also trade mark registration and pending applications for the trade mark PRO-EASE under the Trade Marks Act and details thereof have been given in Para no. 7 of the plaint.
- 2.4 It is also claimed that art work involved in the plaintiff's said trade mark / label are original artistic work within the meaning of the Copyright Act, 1957 and the plaintiff is the owner and proprietor thereof.
- 2.5 It is further averred that the plaintiff maintains the highest standards of manufacture and trade and invests enormous amount of money and efforts on Research & Development activities. The plaintiff's said goods are manufactured and traded under strict quality specifications of a very high order, which are scrupulously maintained. The plaintiff has also been constantly upgrading its facilities in the light of technological advancements.
- 2.6 It is further the case of the plaintiff that the plaintiff has been continuously advertising and promoting its said trade mark/label through different means and

modes including through print and electronic media *i.e.*, by way of extensive advertisements in newspapers, magazines and various prominent TV Channels, etc. The plaintiff has also entered into agreements with famous and eminent stars/ actresses such as Kriti Sanon for promotion and advertisement of the plaintiff's said well-known trade mark/label and for brand promotion. Hence, it is claimed that the plaintiff spent huge amount in advertisement and publicity of the said goods and business under the said trade mark/ label and details of the advertisement expenditure incurred by the plaintiff have been given in Para no. 14 of the plaint. As per same, it is shown that the plaintiff has incurred expenditure amounting to ₹1,124 Lacs during the financial year 2021-22.

- 2.7 It is further the case of the plaintiff that on account of goods quality of the goods under the said trade mark/ label, continuous publicity, promotion and advertisements, the plaintiff has built up a valuable trade, goodwill and reputation thereunder. Thus, the plaintiff has huge turnover against the sale of its goods under the said trade mark/ label and details of year-wise sale for period *w.e.f* 2014-15 to 2021-22 have been given in Para no.12 of the plaint, wherein it is shown that the plaintiff has sales worth ₹112.01 Lacs for the year 2014-15, which has

gradually increased to ₹32,202 Lacs in the financial year 2021-22.

2.8 It is further claimed that with the advent of internet and e-commerce, the plaintiff has been displaying its said goods under the said trademark/label on the internet through its web site namely www.myproease.com which contains extensive information about the business & goods provided by the plaintiff under its said trademark/label. It is claimed that the plaintiff is using the said domain names not only to display its said products under the said trademark/label, but is also using them as a tool to carry out its business thereunder. Thus, said domain names of the plaintiff are stated to be interactive in nature. Besides, the plaintiff also deals in its said goods and business in India through several other e-commerce websites such as Amazon, IndiaMart, Flipkart and Big Basket, etc.


2.9 Thus, it is claimed that in consequence of the above-mentioned publicity, advertisements and also having regard to the excellent quality and high standards of the plaintiff's manufacture and extensive sale, plaintiff's goods bearing the said trademark/label enjoy solid, enduring and first class reputation in the markets. Plaintiff's said trademark/label has already become distinctive indicium of the plaintiff and plaintiff's goods and business. The said trademark/label has acquired secondary significance

denoting the goods and business of the plaintiff. The public and trade associate, identify and distinguish the said trademark/label with the plaintiff and plaintiff's goods and business alone. The said trademark/label has become 'well known' within the meaning of provisions of Section 2 (1) (zg) and Section 11 of the Trade Marks Act, 1999.

2.10 Hence, it is stated that on account of its good quality and standards of manufacturing and untiring efforts in advertising and marketing, the goods of the plaintiff under the said trademark /label, have acquired enviable reputation and goodwill in business community and public in general and in view of the plaintiff's proprietary rights both under statutory and common law in its said trademark /label, and its goodwill & reputation, the plaintiff has the exclusive right to the use thereof and nobody can be permitted to use the same or any other deceptively similar trade mark/ label/ trade name/ trade dress in any manner whatsoever in relation to any specification of goods without the leave and license of the plaintiff.

2.11 It is alleged that the defendant no.1 namely M/s Sun Pharma Laboratories Limited is an incorporated company and is engaged in the business of manufacturing and marketing of medicinal and pharmaceutical preparations, including Hygienic and sanitary preparations for

medical purposes, and allied and cognate products [*hereinafter referred to as the “said impugned goods and business”*]. Further, the defendant no.2 namely M/s Hetero Labs Limited, is also an incorporated company and is the manufacturer of the said impugned goods on behalf of defendant no.1 as per the disclosure on the impugned products and thus, it is alleged that both the defendants are acting in connivance and in unison with each other.

2.12 It is further alleged that the defendants recently adopted and started using the word / mark PRUEASE and label/logo  as their trademark [*hereinafter referred to as the “impugned trademark/ label”*] for the impugned goods and business.

2.13 It is stated that the plaintiff first learnt about the adoption of the impugned mark in December 2020, when the plaintiff received notice of opposition No.1070676 dated 05/11/2020 against plaintiff's trademark application no.4491568 in class 5 for registration of the said trademark. Plaintiff filed counter statement thereto, however, the defendant has not filed Evidence under Rule 45 till date. It is stated that the plaintiff made an enquiry in the markets, but no impugned goods were found in the markets, which indicated that the defendants had not

commenced the use of the impugned goods at that time.



2.14 It is also stated that the plaintiff again received notices of opposition Nos.1191872 and 1191873 dated 18-10-2022 against plaintiff's trademark applications no. 5426855 in class 5 and 5426854 in class 3, for registration of the said trademark. Plaintiff filed counter statements thereto, however, again the defendant has not filed Affidavits of Evidence under Rule 45 till date. The said trademark application no. 5426855 in class 5 has been erroneously abandoned and the plaintiff has filed a TM-M for review there-against. It is averred that in the notices of opposition, the defendant has claimed that the marks PRO-EASE and PRUEASE are deceptively similar. It is also stated that again, the plaintiff made an enquiry in the markets, but no impugned goods were found in the markets, which indicated that the defendants had not commenced the use of the impugned goods.

2.15 It is averred that around January, 2024, the plaintiff came across the publication, in the Trade Marks Journal, of an application filed by the defendant for registration of impugned trademark PRUEASE bearing no. 5353750 in class 05 dated 03-03-2022, but falsely claiming user since 2017 for wide range of medicinal and pharmaceutical preparations, including Hygienic and sanitary preparations for



medical purposes. The plaintiff immediately filed an opposition No.1267957, dated 03-01-2024 there-against. The plaintiff conducted an online search of the website of the Trade Marks Registry and learnt that the defendant had previously also filed an application under no. 3562708 in class 5 in the year 2017 on a proposed user basis but the same was not prosecuted by the defendant and the same was deemed as abandoned by the Trade Marks Registry. Again, the plaintiff made an enquiry in the markets, but no impugned goods were found in the markets, which indicated that the defendant had not commenced the use of the impugned goods.

- 2.16 It is stated that however, recently in the 1st week of November, 2024, the plaintiff came across display/solicitation/sale of impugned goods under the impugned trademark on the interactive online markets and trade channels like www.lmg.com and www.indiamart.com, through which online sales of the impugned goods bearing impugned trademark are being carried out. Being aggrieved from above, the plaintiff launched an enquiry and learnt from its marketing personnel, dealers and distributors in the 1st week of November, 2024 itself, that the defendants have recently started using, selling, soliciting and networking for the impugned goods under the impugned trade mark in the markets of New Delhi viz. Connaught Place, Sarojini Nagar,

Naraina, South Extension, Khan Market etc. *i.e* within the jurisdiction of this Court. Screen-shots of the impugned online activities of the defendants under the impugned trademark have been depicted in the plaint.

- 2.17 Thus, it is alleged that the defendants have dishonestly and malafidely adopted impugned trade mark/ label **PRUEASE/** , which is identical and /or deceptively and confusingly similar to plaintiff's registered trade mark/ label **PRO-EASE /**  in relation to similar goods, thereby causing confusion and deception amongst the unwary purchasing public and traders by making them believe that the origin of those goods is that of the plaintiff. It has been averred that by doing so, the defendants are not only damaging the reputation and goodwill of the plaintiff by passing off their substandard products as that of the plaintiff but are also causing financial loss to the plaintiff by reaping unfair advantage of the repute and distinctive character of the said trademark / label/ trade dress of the plaintiff.

3. On these grounds, by way of application under Order XXXIX Rules 1 & 2 CPC, the plaintiff has, thus, sought an *ad interim injunction* thereby restraining the defendants and all others acting on their behalf from using impugned

trade mark/ label **PRUEASE**/  which is identical and/or deceptively and confusingly similar to plaintiff's trade mark / label **PRO-EASE** /  in relation to similar goods.

4. At this juncture, it may be noted that both the applications *i.e.* application under Order XXXIX Rules 1 & 2 CPC read with S. 151 CPC for grant of an *ex- parte ad interim* injunction and another application under Order XXVI Rule 9 CPC seeking an *ex-parte* order for appointment of Local Commissioner, moved by the plaintiff, were allowed vide common order dated 03-12-2024 passed by this Court, whereby the defendants were restrained from using the impugned trade mark/ label PRUEASE in any form and manner which is identical and/or deceptively and confusingly similar to plaintiff's registered trade mark/ label PRO-Ease on any goods, thereby infringing plaintiff's registered trade mark and passing off their goods and business as that of the goods and business of the plaintiff. Besides, Ld. Local Commissioner was also appointed to visit and search the premises of defendant no.2, as prayed for, with certain directions mentioned therein. The summons of the suit and notice of accompanying applications including injunction application, were also directed to be issued to both the defendants for next date of hearing *i.e.* 06-02-2025.
5. In pursuant thereto, Ld. Local Commissioner has executed the Commission and filed her detailed report on record.

6. It may be noted here that the matter was taken up by the Court on 16-01-2025 on receipt of order dated 18.12.2024 in case titled as '*Sun Pharmaceutical Laboratories Ltd. v. RSPL Health Care Pvt. Ltd. & Anr.*' in FAO (COMM)/241/2024, passed by Division Bench of Hon'ble Delhi High Court, whereby the order dated 03-12-2024 (*supra*), passed by this Court, had been set aside with the consent of the plaintiff herein, with direction to this Court to expedite the hearing of the instant application of plaintiff and to make an *endeavour* to dispose off this application within a month from 16.01.2025.
7. On the said date of 16.1.2025, both the defendants put their appearance through Sh. Sachin Gupta and Sh. Rohit Pradhan, Advocates. Written statement as per provision of Commercial Courts Act, 2015 was filed on record on behalf of defendant no.1. Subsequent thereto, the defendant no.2 has also filed its separate written statement on 27-01-2025.
8. Both the defendants have also filed separate replies to the application under consideration, thereby contesting the same.
9. The plaintiff has preferred to file rejoinder to the reply of defendant to the instant application. However, Ld. Counsel of plaintiff sought and was granted 4 weeks' time to file replication to the written statement, which has not been filed till date.

10. In their separate but almost identical written statements, by way of Preliminary Submissions, the defendants have taken various preliminary objections, *inter alia*, that:-

10.1 The plaintiff obtained an *ex parte ad interim* injunction on the basis of concealment and false statement, which was informed by the defendants to Hon'ble Delhi High Court in appeal bearing FAO (COMM)/241/2025 and accordingly, vide order dated 18.12.2024, the *ex parte* order was set aside by consent of both the sides;

10.2 It is stated that there is concealment qua defendants' use since 2017. In this regard, it is claimed that the plaintiff has filed Document No.15 (Page nos. 251 to 255) being the File Wrapper of defendant's Application for registration of the trade mark PRUEASE under No.5353750 dated 03.03.2022 in class 5 for the goods namely *Pharmaceutical, Phytopharmaceutical, Medical Preparations, herbal medicines, etc.*, and the Notice of Opposition filed by plaintiff dated 3.1.2024. It is stated that just below the File Wrapper, there is an option to download the "*uploaded document*" and merely by clicking the said option of '*upload document*', a list appears, which clearly shows that both Trade Mark Application (TM-A) and Notice of Opposition (TM-O) are available on the official website of the Trade Marks Registry *i.e.*, <https://tmrsearch.ipindia.gov.in/eregister/>. However,

the plaintiff cleverly downloaded only the file wrapper and the TM-O from the official website of the Trade Marks Registry and placed the same on record at Page nos. 241 and 243. The fact of having downloaded such documents from the website of the Trade Marks Registry, is confirmed in their Affidavit under Order XI Rule 6(3) of the Commercial Courts Act, 2015 (Sr. No. 9);

10.3 The plaintiff cleverly did not file the affidavit of use filed along with its Trade Mark Application (TM-A) and with Reply to Exam Report (MIS-R). It is stated that the very first document attached to the affidavit of use is the DRUG TODAY Medical Journal dated 2017, which clearly shows that '*Pruease*' was soon going to be launched. It is further stated that the defendant no.1 had also placed therewith 5 sample invoices of sale of PRUEASE, earliest being of the year 2017;

10.4 It is further stated that had the plaintiff disclosed the complete set of documents of use, filed along with the Trade Mark Application or the Reply to Examination Report demonstrating defendant's use of the mark 'PRUEASE' since 2017, this Court would have been in a better position to appreciate the lack of *prima facie* case in favour of the plaintiff. It is stated that seeking an injunction is an equitable relief, which mandates that the party approaching the Court must do so with clean hands. However,

the plaintiff, through its calculated and malafide suppression of material facts, has abused the judicial process;

10.5 It is further stated that apart from deliberately withholding the Trade Mark Application, which clearly included documents showcasing defendant no.1's use of the trade mark 'PRUEASE' since 2017, the plaintiff also made a positive assertion in the plaint, claiming therein that it was only after due diligence that the plaintiff discovered that the defendants had "*recently started*" its goods in the market *i.e.*, in the 1st Week of November 2024 and has referred to Para no.30 of the plaint in this regard. It is stated that such statement is admittedly false considering that the plaintiff was well aware of defendant no.1's affidavit of use and the accompanying sales invoices and advertisement of the year 2017, but still chose not only to conceal the same but also making positive assertion just in order to mislead this Court and wrongly obtained an *ex-parte* injunction, which the Hon'ble Division Bench of Delhi High Court set aside on consent;

10.6 It is stated that the plaintiff has taken self contradictory stands in previous proceedings before Trade Mark Registry, *vis-a-vis* the stand taken in the present suit;

10.7 It is claimed that the defendants' mark is a coined and inherently distinct word. It is stated that for

infringement to arise, confusion among the public must be probable or inevitable, however, in the present case, no reasonable consumer is likely to confuse a sanitary pad with a medicine designed for constipation relief; and

10.8 It is stated that sanitary napkins are entirely distinct from pharmaceutical goods due to the following reasons:-

10.8.1 *Nature of Goods:* Sanitary pads are consumer hygiene products intended for personal comfort and cleanliness during menstruation. They are soft, absorbent, and designed for single-use purposes. Pharmaceutical goods are medicinal in nature, consisting of chemical or biological compositions formulated to diagnose, treat, or prevent medical conditions.

10.8.2 *Composition:* The composition and usage of the products under the marks PROEASE and PRUEASE are entirely distinct, reinforcing their dissimilarity. As regards *PROEASE*, it is designed and composed as a hygiene product to be worn for menstrual comfort and absorption. It is made of soft, absorbent materials intended for external use only, catering specifically to women's hygiene needs. Whereas, as

far as PRUEASE is concerned, it is composed as a pharmaceutical preparation intended for ingestion to relieve constipation. It contains active medicinal ingredients like Prucalopride and is formulated for internal therapeutic use, typically prescribed by a medical practitioner.

10.8.3 *Use and Function of Goods:* It is stated that hygiene products aim to provide cleanliness, comfort, and convenience, specifically catering to menstrual hygiene, whereas, medicinal goods are for curing illnesses, alleviating symptoms, or aiding recovery from medical conditions.

10.8.4 *Trade Channels are not identical:* It is stated that hygiene products like sanitary napkins are also sold in shopping malls, grocery stores, kirana shops, supermarkets, cosmetic and beauty stores, convenience stores, and e-commerce platforms, whereas, medicinal and pharmaceutical goods are only available through pharmacies, drugstores, hospitals, and clinics, often requiring a prescription for sale.

10.8.5 *No Stretch of Imagination Allows Confusion:* It is inconceivable that any

reasonable consumer, under any stretch of imagination, would confuse a sanitary napkin with a pharmaceutical product like a medicine or drug. The two categories of goods cater to entirely different consumer needs, are marketed differently, and are perceived distinctly by the public.

11. On the basis of aforesaid differences, it is stated that sanitary napkins bear no similarity to medicinal or pharmaceutical goods, ruling out any likelihood of confusion between the two. Therefore, in light of the absence of any confusion, the plaintiff's claim of infringement is entirely unsustainable and ought to be dismissed.
12. As regards passing off, it is stated that there is no passing off. It is stated that it is a settled principle of law that "*added matter*" is a defence in cases of passing off. In the present case, the plaintiff's and the defendants' products bear starkly different packaging and design elements, making it impossible for an ordinary consumer to confuse between the two.
13. It is stated that the defendant no.1's claim of rights is strictly confined to pharmaceutical goods and does not extend to any other category of goods. Consequently, the defendant no. 1's opposition to the plaintiff's application being 5700638, and 5426855 is solely in respect of pharmaceutical goods, and no objections have been raised concerning the plaintiff's application for sanitary pads or

other women-oriented hygienic products. The defendant no. 1 has demonstrated this intent through its conduct by not filing opposition against the plaintiff's applications for non-pharmaceutical categories and for the one where opposition was wrongly filed, has been allowed to be abandoned /withdrawn.

14. It is stated that defendant no.1 is a wholly owned subsidiary of Sun Pharmaceutical Industries Limited [SPIL]. SPIL started business of marketing *pharma* products as a proprietary firm in the year 1978. In the year 1982, a partnership firm under the name and style of M/s Sun Pharmaceutical Industries was formed to manufacture, deal in and trade into pharmaceutical goods, preparation and allied goods and services. On 01.3.1993, M/s Sun Pharmaceutical Industries, the partnership firm, was converted into a Joint Stock Company and was incorporated under the Companies Act, 1956 under the name and style of Sun Pharmaceutical Industries Limited (SPIL). It is further averred that the defendant no.1 markets drugs and formulations in more than 150 countries of the world under its extensive range of well-known and distinctive trade marks/ brand name and has been referred in that trade circles as SUN / SUN PHARMA. It has a consolidated annual turnover of over ₹33,139 Crores globally. It is now ranged as No.1 *Pharma* Company in India in a total of 11 specialties and is the world's 4th largest Generic Pharmaceutical Company. It has multiple factory sites, which have been granted US Food and Drug

Administration (USFDA) approval and it has been ranked as the top Pharma Company of India (AIOCD-AWACS December 2014) and is ranked as one of the top three pharma companies in branded dermatology in US while the company is ranked as one of the top five specialty Generic Pharma Companies globally.

15. It is stated that on or about the year 2017, the defendant no.1 independently coined and adopted the trademark PRUEASE in relation to medicinal and pharmaceutical preparations and has been continuously using the same since then without any interruptions. The defendant no.1 applied for the registration of the same, vide application no. 3562708 dated 02/06/2017 in Class 5. The said application has been abandoned for lack of prosecution under Section 132 of the Trade Marks Act 1999. Subsequently, in order to protect the statutory rights apart from what defendant no.1 enjoyed under common law, the defendant no.1 has filed another application for the said trademark, vide application no. 5353750 dated 03/03/2022 with a prior user claim from 2017 in Class 5. The registration of the said trademark is pending.
16. Defendant No.1 has invested considerable efforts and resources to promote and popularize its goods under the adopted trademark, including significant expenditures on sales and promotional activities. Consequently, the said trademark has become exclusively associated in the course of trade with defendant no.1, which has garnered immense goodwill and an enviable reputation in connection with the

mark. Defendant no.1 has, therefore, acquired an exclusive proprietary rights in the said trademark under common law. The trademark PRUEASE has acquired distinctiveness and enviable goodwill and reputation due to its extensive, long and continuous use since the year 2017. The medicines bearing the trademark PRUEASE identify defendant no. 1 as the source or origin and none else. The defendant no. 1 has the common law right to the exclusive use of the trademark PRUEASE.

17. Due to superior quality and high efficacy of the medicine bearing the trademark PRUEASE, continuous and extensive use of the said trademark, and large sales, the defendant no. 1 has acquired immense reputation and goodwill in the said trademark and the medicine sold thereunder.
18. It is also stated that the defendant no.1 has been taking action against various parties in order to protect its trademark PRUEASE. The details of cases, where the defendant no.1 has been granted favourable orders against third parties are stated to be as under:-

S. No.	Impugned marks	Order dated	Case details
1	PURGEASE	01.03.2024	Abandonment order passed against Application No. 5736436 by the Trade Mark Registry.
2	PREASE-NM	17.02.2023	Application under no.4312828 was withdrawn subsequent to a letter of

			withdrawal filed by the Applicant.
3.	PRUSS	25.05.2023	Abandonment order passed against application no.4949367 by the Trade Mark Registry.
4.	PURGEASE	01.03.2024	Abandonment order passed against Application no. 5736436 by the Trade Mark Registry.

19. Likewise, in “*Para-Wise Reply*”, the defendants have denied and controverted the averments made in the corresponding paras of the plaint.

20. The defendants have also strongly contested the instant application and filed replies thereto stating *inter alia* therein more or less same grounds of challenge as raised in their written statements.

21. In rejoinder, the plaintiff has stated as under:-

21.1 There has been no willful concealment or suppression of facts on the part of the plaintiff. The plaintiff had explicitly mentioned in the plaint regarding the claims of defendant no.1 since 2017 and has also referred to relevant Para of the plaint. Thus, it is stated that the plaintiff did not conceal or suppress the fact that the defendant no.1 falsely claims to be user and adopter of the mark “PRUEASE” since the year 2017 and the ‘user affidavit’ is now being placed on record by the defendant no.1 only with the sole intention to claim

their use and adoption since 2017. It is further stated that the cause of action and case of the plaintiff remains unchanged and unaffected irrespective of the '*user affidavit*' now being placed on record by the defendant no.1, which does not affect the claims and the case of the plaintiff in any manner whatsoever. The '*user affidavit*' does not alter the fact that the plaintiff has been the prior user of the mark 'PRO EASE' since the year 2012 and the defendant only started using the mark 'PRUEASE' much after the plaintiff. Further, the case of the plaintiff remains unchanged that the use of the said mark by the defendant no.1 is likely to cause confusion and deception in the market during the course of trade and amongst the consumers and the '*user affidavit*' also does not alter the fact that the plaintiff's goods and impugned goods are sold over the counter at same trade channels *i.e.* pharmaceuticals shops, which is likely to cause confusion and deception during the course of trade and amongst consumers;

- 21.2 It is stated that the plaintiff has approached this Court with bonafide intentions and never had any intention to conceal any material fact relevant to the present suit. It is also stated that the plaintiff and the defendant no.1 have filed various oppositions against numerous trademark applications, however, the said '*user affidavit*' was never relied upon by the

defendant no.1 in any prosecution proceedings *inter se* the parties. Consequently, the Affidavit was not in the active knowledge, power, or possession of the plaintiff. It is stated that the plaintiff has neither concealed, nor suppressed the fact that the defendant no.1 is claiming false user since 2017, this aspect was explicitly acknowledged and observed by this Court in its *ex parte* order dated 03.12.2024. Hence, the plaintiff's intention was not to obtain an *ex parte* order through *mala fide* action or concealment, which is further evident from the fact that the plaintiff had also filed the status page of defendant no.1's mark, clearly demonstrating that the defendant's user claim since 2017. Therefore, there was no intentional or willful concealment or suppression on plaintiff's part;

- 21.3 Further, it is stated that without prejudice to the merits of the case and assuming solely for the sake of arguments that the affidavit submitted by the defendant no.1 is relied upon, it is stated that despite defendant no.1's purported claims of global business operations and reputation, they have only produced a single 'sample' invoice for each year from 2017 to 2021, along with an excerpts from the DRUG TODAY Medical Journal dated 2017, to support their alleged prior adoption and usage of mark since 2017. It is inconceivable that a business of such purported global stature could fail to provide

even a single sales figure or substantive evidence to corroborate its claims of prior usage and longstanding reputation in the market before the Trademark Registry. Furthermore, the assertions made in defendants' reply appear to be a deliberate attempt to divert the attention of this Court from their infringing activities;

21.4 It is stated that the defendant no. 1's contentions are based on selective and out-of-context interpretations of the plaintiff's submissions. The plaintiff's statements were specific to the goods cited in each instance and did not pertain to the entirety of pharmaceutical or medicinal products. Therefore, the documents referenced by the defendant no. 1 are neither relevant to the present case, nor indicative of any inconsistency in the plaintiff's position. The defendant no. 1's attempt to generalize these specific submissions to mislead the Court should be dismissed as unfounded;

21.5 It is stated that withdrawal of opposition by defendant no.1 filed in application no.4491568, is clearly an afterthought and depicts the *mala fide* intentions of defendant no.1. It is stated that the defendant no. 1 in their opposition filed against the plaintiff's Trademark Application. No. 4491568, has explicitly asserted the similarities between the marks 'PROEASE' and 'PRUEASE'. The defendant no.1 qua the said opposition categorically admitted that

the plaintiff's mark and the defendant no. 1's mark are "deceptively, confusingly similar visually, structurally, and phonetically". In this regard, the plaintiff has relied upon and referred to certain extracts of opposition as mentioned in Para no. 16 of the rejoinder. Thus, it is stated that the defendant no. 1, after explicitly admitting to the similarity between the marks, cannot now contradict their own averments and claim the dissimilarity of the goods. The defendant no. 1 qua the averments made in the Opposition, explicitly admitted that there is bound to be confusion and deception when the chemists and patients and hospitals place the orders on phone or over the counters without prescription which is the normal practice even for the scheduled or prescription drugs as taken note of by various Hon'ble Courts. Hence, the defendant no.1 cannot hide behind the defence of dissimilarity in the "nature", "composition", "use and function", "different trade channel" and "no stretch of imagination allows confusion" and now contradict themselves before this Court. Furthermore, it is submitted that the defendant no. 1 vide their statements explicitly admit to the likelihood of confusion between the marks "PROEASE" and "PRUEASE" due to a mere change in the alphabet "O" and "U". The defendant no.1 themselves consider the marks to be similar and bound to cause a likelihood of confusion, hence, the defendant no. 1

cannot now contradict on their averments and claim honest adoption;

21.6 Defendant no. 1 claims to have “erroneously” filed opposition to the plaintiff’s application No. 4491568 under the impression that the said application was sought for other pharmaceutical goods. It is unfathomable that the defendant no.1 is claiming the filing of the said opposition as an “error”. On the contrary, the defendant no.1 was in fact aware of the said application filed exclusively for sanitary pads and other sanitary products and had proceeded therein to file an opposition against the said application being fully aware of the contents of the application. It is stated that the defendant no.1 through these false and misleading averments, is merely trying to evade its own admissions and accountability of its own admissions by claiming the same to be an error.

22. I have already heard Sh. Rishi Bansal, counsel for the plaintiff and Sh. Sachin Gupta, counsel for the defendants. I have duly considered the submissions made by them. I have also gone through the written submissions along with relied upon judicial precedents/ judgments cited at Bar on behalf of the respective parties.

ARGUMENTS OF PLAINTIFF

23. Ld. counsel for the plaintiff made the following submissions:-

23.1 The plaintiff is honest, *bona fide* and prior adopter and user of the said trade mark / label PRO-EASE/



23.2 The said trade mark/ label is registered under various classes with the Trade Mark Registry under the provisions of the Trade Mark Act, which are valid and subsisting as on date in favour of the plaintiff;

23.3 The plaintiff spend huge amount of money in advertising and promotion of its products under the said trade mark/label, due to which the products of the plaintiff under the said trade marks/labels enjoy huge goodwill and reputation in business community and amongst public in general in India. The plaintiff has huge turnover against the sale of its goods under the said trade mark/ label;

23.4 The defendants have malafidely and dishonestly adopted and are using the impugned trade mark/

label PRUEASE / , which is

identical and /or deceptively similar to trade mark/

label PRO-EASE /  in all material particulars;

23.5 The impugned trade mark/ label PRUEASE is still not registered under the provisions of Trade Marks Act in favour of the defendants and thus, use of phonetically and visually similar mark PRUEASE

by the defendants amounts to infringement of plaintiff's registered trademark PROEASE;

23.6 Further, it is own case of the defendants, as per their trademark application, they have claimed user of their mark 'PRUEASE' since the year 2017, whereas, the plaintiff has been using the trade mark/label 'PROEASE' much prior to that. Thus, by virtue of prior adoption, prior use and registrations, the plaintiff has got exclusive rights in the mark and to restrain others from using the identical or similar mark;

23.7 While rebutting the stand raised by the defendants in their written statements, Ld. Counsel of plaintiff vehemently argued that class of consumers for the products belonging to both the sides, happen to be same, inasmuch as they would go and purchase the sanitary napkins/pads bearing trade mark of the plaintiff, as also the pharmaceutical / medicinal goods bearing impugned trade mark of the defendants over the same counters from the Chemist Shops, Pharmacist Stores etc. and thus, there is every possibility of confusion arising in the minds of unwary purchasers / consumers, thereby making out a *prima facie* case in favour of the plaintiff for grant of temporary injunction against the defendants;

23.8 The goods bearing impugned trade mark of the defendants fall in the category of allied and cognate goods within the meaning of S.29(2)(b) of the Trade

Marks Act, 1999 and for this reason also, the plaintiff is entitled to *ad interim injunction* against the defendants;

23.9 In its response to the Examination Report dated February 25, 2014, in plaintiff's trade mark Application No. 2450092 for the mark PROEASE, the plaintiff had asserted that sanitary pads and medicinal goods are distinct, thereby obtaining registration for the mark "PROEASE" on the said basis and the interpretation put by the defendants is nothing but a selective reading of the plaintiff's comprehensive response. Reference has been made to paragraph 5 of the said reply, wherein the plaintiff is claimed to have explicitly stated that, to its knowledge, the marks cited in the report (Nos.1729998 and 2038104) were not in active use in trade or business, as the plaintiff had not encountered any goods bearing these marks;

23.10 Ld. Counsel clarified that the aforesaid observation was pertinent to the specific marks cited and formed the basis for subsequent submissions regarding distribution channels and thus, the defendant no.1's extraction of isolated statements from the plaintiff's response is devoid of their full context and constitutes a deliberate attempt to mislead this Court. He further submitted that the plaintiff's submissions were confined to the specific goods associated with the cited marks and did not

encompass the entirety of pharmaceutical products. He further contended that the defendant no.1's assertion that the plaintiff had made broad claims about all pharmaceutical goods is totally unfounded and completely misleading;

23.11 As regards Application No. 2662319 – PROEASE, Ld. Counsel of plaintiff submitted that the plaintiff's response to the Examination Report dated February 20, 2014, pertained specifically to the goods associated with the cited mark and did not extend to all the pharmaceutical products. He claimed that the plaintiff did not make any general statement regarding the entirety of pharmaceutical goods and also that defendant no.1's broad interpretation of the plaintiff's specific submissions is an attempt to mislead the Court by generalizing the statement that were context-specific;

23.12 Similarly, with respect to Counter-Statement for Application No. 2662319 - PROEASE (Opposed by Charak Pharma Pvt. Ltd.), Ld. Counsel of plaintiff submitted that the defendant no.1 has misinterpreted the assertion made by plaintiff in its counter-statement, that sanitary napkins and ayurvedic medicinal preparations are distinct, thereby implying a general distinction between sanitary napkins and all medicinal goods. He contended that the plaintiff's statements in the counter-statement were specifically directed towards

the ayurvedic preparations cited in the opposition by Charak Pharma Pvt. Ltd. and the plaintiff did not make any general assertions regarding all pharmaceutical or medicinal goods. He claimed that each submission was tailored to address the specific goods in question and should not be extrapolated to represent a general stance on all medicinal products;

23.13 As regards the suppression and concealment of facts, Ld. Counsel of plaintiff drew attention of this Court to the relevant portion of the averments made in Para no.28 of the plaint, wherein, it is stated that the plaintiff came to know that the defendants had previously filed an application under No.3562708 in Class 5 in the year 2017 on a proposed user basis but, no impugned goods were found in the market, which indicated that the defendants had not commenced the use of impugned goods. He further submitted that the relevant documents in the form of user affidavit and sample invoices submitted by defendant no.1 along with said TM A, could not be filed by plaintiff along with plaint under *bona fide* mistake, since the said defendants did not file their *inter se* affidavit in evidence in terms of Rule 45 of the Trade Mark Rules before the Trade Mark Registry. He further submitted that such *bona fide* mistake on the part of the plaintiff needs to be tested by this Court on the touch stone of preponderance of probability, for which he made three folds

submissions: (i) there was no active knowledge on the part of the plaintiff regarding submission of said documents along with TM-A; (ii) there were series of litigation already pending between the parties; and (iii) user affidavit and supporting documents like invoices were supposed to be filed by defendant no.1 separately and the plaintiff in any case did not intend to be benefited by concealing those documents in view of the fact that the mark of the plaintiff was already registered since much prior to the year 2017;

23.14 Alternatively, Ld. Counsel of plaintiff submitted that even if this Court finds that there has been some suppression/ concealment of material facts on the part of the plaintiff, still, the plaintiff deserves an *ad interim* injunction against the defendants and this Court can always impose appropriate terms including imposition of costs for such negligent conduct if any on the part of the plaintiff;

23.15 Ld. Counsel further contended that the principles of '*Initial Interest Confusion*', '*Hush Hush Products*', and '*Reverse Confusion*' would be attracted to the facts and circumstances of the present case. He submitted that as and when the unwary consumer would go and demand products of the plaintiff by its name as 'PROEASE', there is every likelihood of the shopkeeper supplying him the products bearing impugned trade mark 'PRUEASE' to him/her. He

further submitted that as and when such unwary purchasers would ask for the products bearing trade mark of the plaintiff, he/she may end up in getting the products bearing impugned trade mark of the defendant no.1 and thus, there is every likelihood of such consumers getting deceived in the said process.

24. Hence, it is prayed that an *ad interim injunction* may be granted in favour of the plaintiff and against the defendants, by restraining them to use the said impugned trademark/label PRUEASE.

25. In support of his aforesaid submissions, Ld. Counsel of plaintiff has relied upon the following judgments:-

25.1 “*FDC Limited vs. Docsuggest Healthcare Services Pvt. Ltd. & Anr.*” reported as (2017) 237 DLT 23;

25.2 “*Borosil Glass Works Ltd. vs O.P. Batra and Ors.*” reported as 1996 (16) PTC;

25.3 “*Raman Kwatra and Another vs. KEI Industries Limited*” reported as 2023 SCC Online Del 38 (Para 43);

25.4 “*S.K. Sachdeva and Another vs. Shri Educare Limited and Anr.*” reported as (2016) 65 PTC 614;

25.5 “*Wipro Enterprises Private Limited vs. Himalaya Wellness Company and Ors.*” reported as (2024) 100 PTC 284;

25.6 “*Preetendra Singh Aulakh vs. Green Light Foods*

Pvt. Ltd.” reported as (2023) 304 DLT 684;

25.7 “*Sona BLW Precision Forgings Ltd v. Sonae EV Private Limited*”, reported as (2023) 95 PTC 170;

25.8 “NEON Laboratories Limited vs. Medical Technology Limited & Ors” reported as (2016) 2 SCC 672;

25.9 “*Sun Pharmaceuticals Industries Ltd. vs. DWD Pharmaceuticals Ltd.*” reported as (2023)296 DLT 1(decided on 22.11.2022);

25.10 “*Sun Pharmaceuticals Industries Ltd. Vs. DWD Pharmaceuticals Ltd.*” bearing FAO(OS) (COMM) 310/2022 (decided on 30.11.2022)

25.11 “*Cadila Health Care Ltd. vs. Cedilla Pharmaceuticals Ltd.*” reported as (2001) 5 SCC 73;

25.12 “*Kaviraj Pandit Durga Dutt Sharma vs. Navaratna Pharmaceutical Laboratories*”, reported as MANU/SC/0197/1964;

25.13 “Mehr Distilleries Private Limited vs. SG Worldwide” reported as MANU/MH/22592021;

25.14 “*Sona Mandhira Pvt. Ltd. and Anr. Vs. Sona BLW Precision Forgings Ltd. and Ors.*” reported as 2023 SCC Online Del 2184;

25.15 “*Swiss Bike Vertriebs GMBH Subsidiary of ACCELL Group V Reliance Brands Limited (RBL)*’ bearing CS(COMM) 25/2023, decided on

04-3-2024; and

25.16 “*Under Armour, INC vs. Aditya Birla Fashion & Retail Ltd.*” reported as 2023 SCC Online Del 2269.

ARGUMENTS OF DEFENDANTS

26. Ld. Counsel of the defendants made the following submissions:-

26.1 The plaintiff has deliberately and intentionally concealed/ suppressed material facts from this Court and wrongly obtained an *ex parte ad interim injunction*, on the basis of concealment and false statement, which was informed by defendants to Hon’ble Delhi High Court in appeal bearing FAO (COMM)/241/2025 and accordingly, vide order dated 18.12.2024, the *ex parte* order was set aside by consent of both the sides;

26.2 There is concealment qua defendants’ use since 2017, as the plaintiff has filed File Wrapper of defendants’ Application for registration of the trade mark PRUEASE under No.5353750 dated 03.03.2022 in class 5 for the goods namely *Pharmaceutical, Phytopharmaceutical, Medical Preparations, herbal medicines, etc.*, and the Notice of Opposition filed by plaintiff dated 3.1.2024, however, it deliberately and intentionally, did not file the ‘affidavit of use’ filed along with its Trade Mark Application (TM-A) and Reply to Examination Report (MIS-R), which contained an

affidavit of use with advertisement and sample invoices of sale of PRUEASE, earliest being of the year 2017;

- 26.3 The plaintiff has also concealed from this Court its replies to Examination Reports. With respect to its application no.2450092 dated 27.12.2012 for registration of the mark PROEASE for Sanitary Napkins in class 5, the Registry in the examination report cited the conflict marks PROAGE and PROACE. The plaintiff in its reply to said Examination report dated 25.2.2014 categorically stated that *‘the goods/services and distribution channels as well as the trade channels of the applicant's goods/services/products in respect of which the applicant's mark PROEASE has been filed are altogether different from the others as mentioned in the search report’*. Similarly, the plaintiff had taken same stand in respect of application no.2662319 dated 20.01.2014 for registration of trade mark PROEASE in class 5. The said application was also opposed by one Charak Pharma P. Ltd. on the ground that the plaintiff's mark is deceptively similar to its registered trade mark PROSTEEZ in class 5 for goods *i.e.* Ayurvedic Medicinal Preparation. Again, the plaintiff in its Counter Statement had taken same stand while stating that *‘it is surprising how the opponents claim the similarity of the goods when*

clearly there is no similarity whatsoever. It is submitted that the opponent is dealing with Ayurvedic medicinal preparation/s, which are very specific and distinguishable from the sanitary napkins being dealt with by the applicant. It is further submitted that the marks in relation to the respective goods/business shall not cause any confusion or deception in the market."

26.4 Therefore, according to the submissions made on behalf of defendants, it was the stand of the plaintiff in overall spectrum of medicinal/ pharmaceutical goods, that the Sanitary Napkins are different and on the basis of such claims, the plaintiff had obtained registration for the mark PROEASE;

26.5 After taking such a stand, the plaintiff is now claiming that consumer will get confused between Sanitary Pads and Pharmaceutical medicines and thus, it is submitted that the plaintiff cannot be allowed to approbate and reprobate at the same time, when the plaintiff itself has obtained registration after claiming that sanitary pads and medicinal goods are different entity;

26.6 It has been further argued that the plaintiff also made a positive assertion in the plaint, claiming therein that it was only after due diligence that the plaintiff discovered that the defendants had "*recently started*" its goods in the market *i.e.*, in the 1st week of November 2024, which is absolutely false

statement, in view of the fact that the plaintiff was well aware of defendant no.1's affidavit of use and the accompanying sales invoices and advertisement of the year 2017, but still chose not only to conceal the same, but also making positive assertion just in order to mislead this Court and had wrongly obtained an *ex-parte* injunction;

26.7 There is no similarity between the goods of the plaintiff and that of the defendants. The defendants' mark PRUEASE is coined mark, 'PRU' is derived from the salt '*PRUCALOPRIDE*' and 'EASE' connoting 'eases constipation' In the trade of drugs, it is common practice to name a drug, by the name of the organ or ailment which it treats or the main ingredient of the drug. Such organ, ailment or ingredient being *public juris* or generic cannot be owned by anyone for use as trademark; and

26.8 The plaintiff is only seeking relief against infringement under S. 29(2) of TM Act, which is not maintainable as the marks cannot be said to be deceptively similar under S. 2(h) *i.e.* as there is no likelihood of any confusion or deception, as also that the goods of the plaintiff *i.e.* sanitary napkins/pads and the goods of the defendants *i.e.* medicinal drugs are not related / allied or cognate goods.

27. In support of his aforesaid submissions, Ld. Counsel of the defendants has relied upon the following judgments:-

- 27.1 *“S.B.L. Ltd. vs Himalaya Drug Co.” reported as, 67 (1997) DLT 803;*
- 27.2 *“Oswal Fats & Oils Ltd. v. Commr. (Admn.)” reported as (2010) 4 SCC 728;*
- 27.3 *“Amar Singh v. Union of India Ors” reported as 2011 SCC Online SC 772;*
- 27.4 *“Natco Pharma Ltd. v. Bristol Myers Squibb Holdings” reported as, 2019 SCC OnLine Del 9164 (DB);*
- 27.5 *“Infosys Ltd. v. Southern Infosys Ltd.”, reported as 2024 SCC OnLine Del 4345*
- 27.6 *“S.K.Sachdeva and anr. v. Shri Educare”, reported as 2016 SCC OnLine Del 473*
- 27.7 *“PhonePe P. Ltd. v. DigiPe Fintech P. Ltd.”, reported as 2023 SCC OnLine Mad 5626*
- 27.8 *“FDC Ltd. v. Docsuggest Healthcare.”, reported as 2017 SCC OnLine Del 6381 (Para 54)*
- 27.9 *“Sun Pharmaceutical Industries Ltd. V. Vensat Bio & Ors.” reported as CS(COMM) 459/2022 along with TM Well-known list*
- 27.10 *“Sona Blw Precision Forgings Ltd. v. Sonae EV (P) Ltd.”, reported as 2022 SCC OnLine Del 2321 (Para 32)*
- 27.11 *“Frankfinn Aviation Services (P) Ltd. v. Tata Sia*

Airlines Ltd.” reported as, 2022 SCC OnLine Del 3550 (SJ)

27.12 *“United Brothers v. United Traders”, 1982 SCC OnLine Del 20*

27.13 *“N. Ranga Rao & Sons (P) Ltd. v. Sree Annapoorna Agro Foods”, reported as 2021 SCC OnLine Mad 2916 (SJ)*

27.14 *“Intel Corporation v. Anil Hada & Ors.”, reported as 2006 SCC OnLine Del 1677 (SJ)*

27.15 *“Dharampal Satyapal Ltd. v. Youssef Anis Mehio” reported as 2022 SCC OnLine Del 3307*

27.16 *“Aegon Life Insurance Co. Ltd. v. Aviva Life Insurance Co. India Ltd.”, 2019 SCC OnLine Bom 1612*

27.17 *“Inter Ikea Systems BV v. Annanya Gautam,” 2018 SCC OnLine Del 11665*

27.18 *“Intercontinental Great Brands v. Parle Product (P) Ltd.,” 2023 SCC OnLine Del 728*

27.19 *“Wipro Enterprises P. Ltd. v. Himalaya Wellness Company and Ors.”, reported as 2024 SCC OnLine Del 6859 (DB)*

27.20 *“Charak Pharrna (P) Ltd. v. Glenmark Pharmaceuticals Ltd.”, reported as 2014 SCC OnLine Bom 98*

- 27.21 *“Modern Snacks P. Ltd. v. Modern Foods Enterprises P. Ltd.,” reported as 2023 SCC OnLine Del 3872*
- 27.22 *“ICOMM Tele Ltd. V Bharat Sanchar Nigam Ltd. And Another” reported as 2019 SCC OnLine Del 8667; and*
- 27.23 *“Shri K. Jayaram and others v Bangalore Development Authority and Ors.” reported as (2022) 12 SCC 815.*

ANALYSIS & CONCLUSION

28. Before discussing further, it would be apposite to note down the relevant provisions of Trade Marks Act, 1999, which read as under:-

2. Definition and interpretation. – (1) In this Act, unless the context otherwise requires, -

(a) xxxx

(h) “deceptively similar”. – A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion.

XXXX

11. Relative grounds for refusal of registration. - (1) Save as provided in section 12, a trade mark shall not be registered if, because of-

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

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

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

(2) A trade mark which-

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor,

shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.

XXX

29. Infringement of registered trade marks. - (1) *A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.*

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of

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

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

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

XXXX”

29. Before dealing with the rivals submissions made on behalf of both the sides, it would also be worthwhile to quote the extracts of the judgment of Hon’ble Supreme Court in the case of *Renaissance Hotel Holdings Inc. v. B. Vijaya Sai*

& Ors, MANU/SC/0066/2022, which has laid down law with respect to infringement of trade mark, to quote:-

43. The legislative scheme is clear that when the mark of the Defendant is identical with the registered trade mark of the plaintiff and the goods or services covered are similar to the ones covered by such registered trade mark, it may be necessary to prove that it is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark. Similarly, when the trade mark of the plaintiff is similar to the registered trade mark of the Defendant and the goods or services covered by such registered trade mark are identical or similar to the goods or services covered by such registered trade mark, it may again be necessary to establish that it is likely to cause confusion on the part of the public. However, when the trade mark of the Defendant is identical with the registered trade mark of the plaintiff and that the goods or services of the Defendant are identical with the goods or services covered by registered trade mark, the Court shall presume that it is likely to cause confusion on the part of the public.

45. It could thus be seen that this Court has pointed out the distinction between the causes of action and right to relief in suits for passing off and for infringement of registered trade mark. It has been held that the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark, cannot be equated. It has been held that though an action for passing off is a Common Law remedy being an action for deceit, that is, a passing off by a person of his own goods as those of another; the action for infringement is a statutory right conferred on the registered proprietor of registered trade mark for the vindication of the exclusive rights to the use of the trade mark in relation to those goods. The use by the Defendant of the trade mark of the plaintiff is a sine qua non in the case of an action for infringement. It has further been held that 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 case of infringement of the trade mark, whereas in the case of a 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.

47. It could thus been seen that this Court again reiterated that the question to be asked in an infringement action is as to whether the Defendant is using a mark which is same as, or which, is a colourable imitation of the plaintiff's registered trade mark. It has further been held that though the get up of the Defendant's goods may be so different from the plaintiff's goods and the prices may also be so different that there would be no probability of deception of the public, nevertheless even in such cases, i.e. in an infringement action, an injunction would be issued as soon as it is proved that Defendant is improperly using the Plaintiff's mark. It has been reiterated that no case of actual deception nor any actual damage needs to be proved in such cases This Court has further held that though two actions are closely similar in some respects, in an action for infringement, where the Defendant's trade mark is identical with the Plaintiff's trade mark, the Court will not enquire whether the infringement in such as is likely to deceive or cause confusion.

30. In the case of '*Durga Dutt v. Navaratna Laboratories*', reported as AIR 1965 SC 980, Hon'ble Apex Court has held that 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 similarities between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the Court reaches to the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. It further held that if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get up, packaging and other writings or marks on the goods or the packets in which he offers his goods for sale show marked differences, or indicates 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 liabilities if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

31. Further, in the case of ‘*Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*’, reported as (2001) 5 SCC 73, Hon’ble Apex Court has laid down the following tests for deciding the question of marks being ‘*deceptively similar*’ as under:-

“35. Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following facts are to be considered:-

a) the nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label marks.

b) the degree of resemblance between the marks, phonetically similar and hence, similar in idea.

c) the nature of the goods in respect of which, they are used as trade marks.

d) the similarity in the nature, connector and performance of the goods of the rival traders.

e) the class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

f) the mode of purchasing the goods or placing orders for the goods.

g) any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

36. Weightage to be given to each of the aforesaid factors depends upon facts of each case and same weightage cannot be given to each factor in every case.

xxx”

32. As regards the point as to whether there is similarity between the two products, now, it is no more *res integra* that test of deceptively similarity is that of a perspective from common man with average intelligence and imperfect recollection, as laid down by Hon’ble High Court of Delhi in the case titled as “*Himalaya Drug Company v. M/s S.B.L. Limited*”, 2012 (194) DLT 536.
33. In the light of above legal position, let’s examine the case in hand.
34. No doubt, the marks of both the sides fall under Class 5. It is a well-settled principle of trademark law that goods within the same class can differ significantly and the stark distinction between the nature, purpose, and consumer base of the two products eliminates any likelihood of confusion. It is *trite law* that in order to constitute a case of infringement, the plaintiff is required to show that use of impugned trademark by the opponent creates or is likely to create confusion amongst the public at large. However, such confusion must be shown to be probable or inevitable.
35. In the case in hand, the plaintiff’s mark PRO EASE pertains to sanitary napkins, whereas, the defendants’ mark PRUEASE is associated with a pharmaceutical product used for relief from constipation. As pointed out on behalf of the defendants, the term PRU appearing in defendants’ mark is derived from the active pharmaceutical ingredient **Prucalopride**, while “**Ease**” is a term indicating easy relief

from constipation. For the said purpose, the defendants have also referred to and relied upon Drug Today's post on Pruease of the year 2017, which also had the tagline '*eases constipation... provides satisfaction*'.

36. The nature of plaintiff's goods, as already noted above, are sanitary pads which are primarily consumer hygiene products mainly used by females during menstruation, whereas, the defendants' products bearing alleged impugned trade mark are pharmaceutical goods, which are medicinal in nature and their composition consists of chemical or bio-logical composition meant for medical treatment of the patients, who may be either male or female and there is no distinction as such either in terms of gender or age of the person who may be using such goods/ drugs. Thus, the plaintiff, in the opinion of this Court, has even *prima facie* failed to show that any reasonable consumer or unwary purchaser is likely to get confused between a sanitary pad, and a medicine designed for constipation relief.
37. In the cited judgment of *S.B.L. Ltd. (supra)*, Hon'ble Division Bench of Delhi High Court found merit in the contention of the appellant and observed as under, *to quote:-*

"25(3) ... In the trade of drugs it is common practice to name a drug, by the name of the organ or ailment which it treats or the main ingredient of the drug. Such organ, ailment or ingredient being public juris or generic cannot be owned by anyone for use as trade mark".

38. Moreover, the trade channels and routes in respect of hygiene products like sanitary pads and napkins are quite different from that of the medicinal and pharmaceutical goods, inasmuch as these hygiene products are being openly sold in shopping malls, grocery stores, departmental stores, super markets, cosmetic and beauty stores, e-commerce platforms etc., whereas the medicinal and pharmaceutical goods are only available at pharmacists, drugs stores, hospitals, nursing homes, clinics, etc. and that too on production of medical prescriptions of qualified medical practitioners. Thus, it is difficult to anticipate or perceive any situation where any reasonable consumer would get confused or deceived between the sanitary pad/ napkin and the pharmaceutical products like a medicine or drugs. Thus, the plaintiff has failed to show that there is any likelihood of any confusion and/or deception within the meaning of S. 2(h) read with S. 29(2) of the Trade Marks Act, 1999.
39. In so far as the case set up by plaintiff regarding passing off by the defendants of their products bearing impugned trade mark is concerned, it may be noted that the products of the defendants are *prima facie* shown to be having starkly different packaging and design elements, which would clearly distinguish their goods from the goods of the plaintiff. The distinguishing features in terms of packaging and design elements in the products of the plaintiff and that of the defendants may be summarized here as under:-

- 39.1 In plaintiff's mark, 'PRO-EASE' is prominently written in shades of purple and blue font with "*Go ULTRA XL+*" highlighted underneath in white and mustard yellow, whereas, it is apparent from perusal of defendants' mark, that the word mark 'PRUEASE' is written in a clean, minimal green and grey font;
- 39.2 The plaintiff's products are Sanitary pads/ napkins, which are basically feminine hygiene products, whereas, the defendants' products are Prucalopride tablets, which are basically medicinal products and are meant to be used for 'ease' in constipation;
- 39.3 The packaging of the products of the plaintiff depicts the colour scheme of bright and vibrant purple and mustard yellow with floral and abstract graphics, whereas, the packaging of the products of the defendants are shown to be in sub-dued green and white packaging with pharmaceutical aesthetics;
- 39.4 The packaging of the goods of the plaintiff features an image of a sanitary pad alongside the tagline "*Longest & Driest Ultra*", with a focus on absorption and comfort, whereas, in case of packaging containing goods of the defendants, it is shown to be simple and clear box featuring text-only information about dosage, composition, and manufacturing details, consistent with pharmaceutical norms; and

- 39.5 In the case of plaintiff, the form of the product and its size is like soft, rectangular sanitary pads enclosed in plastic pouches, whereas, in the case of defendants, the form of the products and its size is like tablets in blister packs enclosed in rectangular cardboard boxes. Not only this, the plaintiff uses flexible and lightweight plastic packaging in respect of its goods, whereas, the defendants use cardboard box with blister packs for tablet protection.
40. In view of above, this Court is of the view that there is least possibility of creating any confusion for any ordinary consumers while purchasing the products of the plaintiff *vis-a-vis* that of the defendants and thus, no case of the passing off is made out in the facts and circumstances of the present case..
41. There is another aspect involved in this case. The defendant no.1 is claimed to be prior user in pharmaceutical goods with earliest user from 2017, whereas, the plaintiff has never been involved into Pharmaceuticals, and has only dealt in Sanitary Napkins qua the plaintiff's mark. This fact has also been fairly conceded to on behalf of plaintiff during the course of arguments. However, Ld. Counsel of plaintiff submitted before this Court that the plaintiff has every intention to expand its business by entering into the field of manufacturing pharmaceutical drugs. As of now, the defendants are not in the business of manufacturing or selling Sanitary Napkins. In fact, it has been the specific

stand taken by the defendants that they do not intend to enter into the field of manufacturing or selling sanitary napkins/pads. That being so, this Court does not find any substance in the argument advanced on behalf of the plaintiff that there would be any confusion amongst the unwary consumers while purchasing the products of the parties, which are otherwise shown to be entirely different from each other, in all material particulars.

42. Moreover, it is *prima facie* evident from the material available on record that the defendant no.1 is one of the reputed manufacturers of pharmaceutical goods. The averments made in the written statement, which are *prima facie*, supported by the documents filed therewith, it is evident that the defendant no.1 already had widespread sales of its goods bearing the impugned trademark across the entire country. The defendant no.1 has also provided details of their year wise sales turnover from the financial year 2017-18 till 2023-24, under the heading 'D' of their written statement, as per which, it is duly shown that the said defendant had turn over of ₹204.36lacs during the financial year 2017-18, which was increased to ₹1867.05lacs during the financial year 2023-24. Thus, it cannot be said that the said defendants would require any piggy bag in the form of trademark of the plaintiff to sell their pharmaceutical goods. In the cited judgment of *Sun Pharmaceutical Industries Ltd. (supra)*, Hon'ble High Court of Delhi has declared '*Sun Pharma*' to be a well-known trademark. For this purpose, it would be

apposite to reproduce the relevant portion of the observations made in the said judgment, which reads as under:-

“11. From the averments made in the plaint and the documents filed along with the plaint, it is clear that the plaintiff is a leading pharmaceutical company in the world. For more than three decades, the plaintiff is the leader in the marketing of pharmaceutical products. The plaintiff has acquired tremendous good will and reputation over the years in the pharmaceutical market.”

43. It is also pointed out from record that the plaintiff's application for the mark PRO-EASE LOVINGLY in Class 5 under no.5426855 dated 28.4.2022, covering pharmaceutical, veterinary, and sanitary preparations; dietetic substances adapted for medical use, among other goods was filed on proposed to be used basis and the same currently stands abandoned. Although, it is the case of the plaintiff that its Review Petition dated 13.2.2024 is currently pending, however, the fact remains that until 28.04.2022, the plaintiff was not using the mark in question for pharmaceuticals.
44. Regarding withdrawal of opposition filed by defendant no.1 against plaintiff's application under No.4491568, it is explained on behalf of said defendant that the said defendant had erroneously filed an opposition to plaintiff's application under No.4491568 which was solely filed for sanitary pads and other women-oriented hygienic products. The opposition was initiated under the wrong impression that the application also sought registration for pharmaceutical goods. With this belief, the opposition proceedings continued. This submission made on behalf of

defendants stands fortified from the language of the Notice of Opposition filed by defendant no.1, wherein the said defendant has stated that *‘The Opponents say & submit that there is bound to be confusion and deception when the chemist and patients and hospitals place the orders on phone or over the counter without prescription which is the normal practice even for the scheduled or prescription drugs as taken note by various Hon’ble Courts.* Thus, it is *prima facie* evident from the above-quoted averments that these submissions were specifically made with respect to pharmaceutical goods, as the mention of prescriptions pertains exclusively to pharmaceutical goods. It is also relevant to note that the defendant no.1 has been able to show from the documents placed on record that it had allowed its opposition to get abandoned by not attending the hearing fixed on 23.11.2023 and also by not filing its evidence in support of its evidence, required to be filed on or before 22.2.2024. Not only this, the said defendant has also filed a letter dated 18.12.2024 to the Trade Mark Registry thereby seeking withdrawal of its opposition and withdrawal of its statements to the effect that the competing goods are of same description. The act of defendant no.1 in getting its opposition abandoned, was undisputedly much prior to the institution of the present suit. That being so, this Court is not inclined to infer any *mala fide* intention on the part of defendant no.1 in submitting the letter dated 18-12-2024 regarding withdrawal of its opposition to the application for registration of its trade mark filed by the plaintiff.

45. This Court also does not find any force in the contention raised on behalf of the plaintiff that the medicinal goods bearing impugned trade mark of the defendants, would fall in the category of allied and cognate goods insofar as the consumer hygiene products in the form of sanitary napkins/ pads bearing trade mark of the plaintiff is concerned. In the cited judgment of *United Brothers (supra)*, Hon`ble Single Bench of High Court of Delhi has observed, *to quote:-*

“8...forks, knives and spoons cannot be said to be goods allied or cognate to the goods of the plaintiffs; in any case, the sale of the said goods by the defendants can in no case, be considered by the buyer as the goods of the plaintiffs, for, the plaintiffs have never manufactured and sold spoons, forks and knives. The goods manufactured by the plaintiffs and the defendants may well be sold in the same shop or the counter but the said goods are so different in shape and use that there cannot be any confusion in the mind of purchaser that the goods manufactured by the defendants are of the plaintiffs.”

46. This Court also does not agree with the other contention raised on behalf of plaintiff that facts of the present case would attract ‘*Initial Interest Confusion*’ test. In the cited case of *Dharampal Satyapal (supra)*, Hon`ble Single Bench of Delhi High Court has observed, in reference to the ‘*initial interest confusion*’ test that, *to quote:-*

84. There is substance in this contention. What counts is the immediate effect that the impugned packing would have on the unwary customer of average intelligence and imperfect recollection. If, at first glance, a consumer is likely to be confused, and evinces interest in the product, the test of initial interest confusion stands satisfied, and the mark loses distinctiveness....”

47. Further, in another cited case of *Aegon Life Insurance Co. Ltd. (supra)*, Hon`ble Single Bench of Bombay High Court

had occasion to deal with the contention regarding initial interest confusion test and has observed that, *to quote:-*

“97. ...After hearing the submissions on the law apropos the principle of initial interest confusion, I am inclined to disagree with the applicability of the said principle to the facts of the present case.... the principle of initial interest confusion applies in a situation where a customer who is looking for the plaintiffs’ product develops an “initial interest” in the defendant's product believing the same to be emanating from the plaintiff or having some nexus with the plaintiff. Even though no purchase is made or the customer realises before purchasing from the defendant, the mere deception/confusion with respect to the origin of the defendant's goods or services shall invoke the principle of initial interest confusion. However, the Plaintiff's contention that customers search for the Plaintiff's policies online by using the keyword “iTerm”, or that the “interest” of the prospective customer of the Plaintiff will be invoked upon finding an ‘i-Term’ product on the Defendant's portfolio, is based on an assumption that the Plaintiff has acquired substantial goodwill and reputation in the expression “iTerm” and that the said expression is distinctive of the Plaintiff's goods and services. As observed hereinbefore, this is not a case where the Plaintiff has been able to show that it has acquired the requisite goodwill and reputation in the expression ‘iTerm’ per se. In the absence of such goodwill and reputation it would be incorrect to infer that a prospective customer of the Plaintiff associates the expression ‘iTerm’ exclusively with the goods and services of the Plaintiff and that such customer's interest will be piqued upon coming across the Defendant's ‘i-Term’ product....”.

48. No doubt, the sanitary napkins/pads are considered ‘hush products’. Still, the ‘*Hush Products*’ principle does not get attracted to the facts of the present case, for the reason that the defendants’ *pharma* tablet is not a ‘*hush product*’, it being a pharmaceutical medicine used for constipation treatment, and is openly discussed and often dispensed with medical advice, lacking the discretion typically associated with hush product. ‘*Hush Hush Test*’ will only

be applicable if competing products are identical and competing with each other.

49. Apart from above reasons, there is yet another reason, which disentitles the plaintiff from seeking the discretionary and equitable relief of injunction. For the said purpose, it would be apposite to refer to the provisions contained in Order XI Rule 1(3) of the CPC, 1908 [as applicable to the Commercial Courts Act, 2015], which makes it obligatory for a party to file a Statement of Truth affirming that all documents in its power, possession, or control have been disclosed and placed on record. It is relevant to note that in its Statement of Truth filed along with plaint, the plaintiff is *prima facie* shown to have made false statement that it had already filed all the documents as were in its power, control and possession at the time of institution of the suit. *Pertinently*, the plaintiff also did not place reliance upon any other document in the List of Documents filed along with the plaint. However, it is only when the defendants filed their written statements, it has come to the *fore* that it had made false averments in the plaint duly supported by Statement of Truth that in the first week of November, 2024 itself, the plaintiff launched an enquiry and learnt from it dealers and distributors that the defendants had recently (*emphasis laid*) started using, selling, soliciting and networking for the impugned goods under the impugned trade mark in the markets of New Delhi.

50. Further, the plaintiff is also shown to have withheld user affidavit along with documents *i.e.* sample invoices showing use of goods bearing impugned trade mark by defendant no.1 since the year 2017, as also reply to examination report *w.r.t.* it's application under no. 2450092 / 2662319 and counter statement *w.r.t.* it's application no. 2662319. Although, all the said documents were well within the power, control and possession of the plaintiff, but still, the plaintiff did not place them on record. It is needless to mention that Statement of Truth is filed on oath, and thus, filing of such false affidavit by the plaintiff, *prima facie* amounts to grave misuse of judicial process. Such conduct on the part of the plaintiff, in the opinion of this Court, disentitles it from seeking the equitable and discretionary relief of injunction.
51. It is settled law that if a party is guilty of concealment of material facts, the Court not only has the right but a duty to deny an equitable relief to such person. Further, it is *trite law* that the relief of an injunction is an equitable relief, which mandates that the party approaching the Court must do so with clean hands.
52. In the cited case of ICOMM Tele Ltd. (*supra*), Hon'ble Delhi High Court has observed that, to quote:-

"13...the entire purpose of "Statement of Truth" is defeated if a party elects to keep a document away from judicial scrutiny, claiming that it is inconsequential. If a document is indeed irrelevant, it would be for the Court to decide and not for the parties. The approach adopted by the Petitioner is strongly deprecated...."

53. In another cited case of Shri K. Jayaram (*supra*), the Hon'ble Supreme Court has observed that, to quote:-

“14.... We are of the view that the parties have to disclose the details of all legal proceedings and litigation either past or present concerning any part of the subject-matter of dispute which is within their knowledge. In case, according to the parties to the dispute, no legal proceedings or court litigation was or is pending, they have to mandatorily state so in their pleadings in order to resolve the dispute between the parties in accordance with law.

15. ...they have not come to the court with clean hands and they have also abused the process of law. Therefore, they are not entitled for the extraordinary, equitable and discretionary relief.”

54. In the case of Natco Pharma Ltd. (*supra*), the Hon'ble Division Bench of Delhi High Court set aside the injunction order granted by Hon'ble Single Judge, while relying upon the observations made by Hon'ble Apex Court in the case of '*Seema Arshad Zaheer v. Municipal Corporation of Greater Mumbai*' reported in (2006) 5 SCC 282. The relevant portion of the said judgment is extracted here as under:-

“28 in addition, temporary injunction being an equitable relief, the discretion to grant such relief will be exercised only when the plaintiff's conduct is free from blame and he approaches the court with clean hands.”

55. In the cited case of Oswal Fats (*supra*), the fact that by virtue of the lease deed dated 15-10-1994, the appellant had succeeded in securing temporary legitimacy for its possession over the excess land, was not disclosed and in this backdrop, Hon'ble Supreme Court observed that if it would have been disclosed, then there would have been no occasion for the High Court or the Supreme Court to

entertain the writ petition or the SLP. While dismissing the appeal, it was held by Hon'ble Supreme Court that, to quote:-

“20...It is settled law that a person who approaches the Court for grant of relief, equitable or otherwise, is under a solemn obligation to candidly disclose all the material/important facts which have bearing on the adjudication of the issues raised in the case. In other words, he owes a duty to the court to bring out all the facts and refrain from concealing/suppressing any material fact within his knowledge or which he could have known by exercising diligence expected of a person of ordinary prudence. If he is found guilty of concealment of material facts or making an attempt to pollute the pure stream of justice, the court not only has the right but a duty to deny relief to such person.”

56. In the cited case of *S.K. Sachdeva (supra)*, Hon'ble Division Bench of Delhi High Court has held that the objections raised by the Trade Mark Registry, response by the plaintiff with respect to 3rd party conflicting marks and admissions, were not disclosed in the plaint and thus, the same amounts to concealment and misrepresentation. In this backdrop, the injunction order was vacated citing multiple factors including the fact that the respondents therein were guilty of concealment and misrepresentation. The relevant portion of the said decision reads as under:-

“16. ...The admissions made by letter dated 08.06.2012 have a material bearing on the stand of the appellants in the subject suit. The fact that the respondents did not mention about the letter dated 08.06.2012 in the plaint, in our view, amounts to a clear case of misrepresentation and concealment of material facts that have a bearing on the very case set up by the respondents in the plaint.”

57. In the case in hand, the defendants have pointed out from the record that self contradictory stands have been taken by the plaintiff before Trade Mark Registry *vis-a-vis* the

present suit. It may be noted that with respect to application for registration of the mark PROEASE under no. 2450092 dated 27.12.2012 filed by plaintiff only for Sanitary Napkins in class 5, when the Trade Mark Registry in the examination report had cited the mark PROAGE and PROACE of Sandeep N. Gogawale and Alembic Pharmaceuticals Ltd. as conflicting marks on the ground that PROACE was used by Alembic Pharmaceuticals Ltd. to treat high blood pressure and heart failure, the plaintiff in its response / reply dated 25.2.2014 thereto, categorically stated that '*the goods/ services and distribution channels as well as the trade channels of the applicant's goods/services/products in respect of which the applicant's mark PROEASE has been filed are altogether different from the others as mentioned in the search report*'. Based on said assertions that Sanitary pads and Medicine were different goods, the plaintiff successfully obtained registration for the mark PROEASE in its favour.

58. Likewise, the plaintiff is *prima facie* shown to have taken similar stand in respect of its application no.2662319 dated 20.01.2014 for registration of trademark PROEASE in class 5. The said application was also opposed by one Charak Pharma P. Ltd. on the ground that the plaintiff's mark was deceptively similar to its registered trade mark PROSTEEZ in class 5 for goods *i.e.* Ayurvedic Medicinal Preparation. Again, the plaintiff in its Counter Statement is found to have taken the same stand that '*it is surprising how the opponents claim the similarity of the goods when*

clearly there is no similarity whatsoever. It is submitted that the opponent is dealing with Ayurvedic medicinal preparation/s, which are very specific and distinguishable from the sanitary napkins being dealt with by the applicant. It is further submitted that the marks in relation to the respective goods/business shall not cause any confusion or deception in the market." Therefore, this Court is in agreement with the submission made on behalf of defendants that not only the plaintiff claimed the pharmaceutical medicinal goods to be different from its sanitary napkins, but also claimed ayurvedic medicinal goods to be different from its said goods. It is well settled principle of law that one cannot be allowed to approbate and reprobate at the same time.

59. In view of what has been stated above, the claim of the plaintiff that consumer will get confused between Sanitary Pads and Pharmaceutical medicines, is considered to be wholly devoid of any merit, since it is shown that the plaintiff itself had obtained registration of its trade mark PROEASE as against deceptively similarly registered trade marks of prior users on the ground that sanitary pads and medicinal goods are different entity.
60. In *PhonePe P. Ltd. (supra)*, Hon'ble Division Bench of Delhi High Court did not grant injunction and observed that, to quote:-

"32. On the given facts and circumstances of the case, it is difficult to reconcile the plaintiff's stand taken before different courts. The stand taken before the Registrar of Trademark was absolutely different and not coherent with

the stand taken in the present matter. The stand taken before the Delhi High Court while litigating against "BharatPe" was also completely different. The plaintiff in the said case admitted that "CardPe" was the prior user and adopter of the "Pe" formative mark. The Plaintiff is not the innovator of the "Pe" formative mark...."

61. Now coming to the judgments cited on behalf of plaintiff.

There is no quarrel to the ratio of law and the legal proposition discussed in those cited judgments. However, it is *trite law* that the same cannot be applied like *Euclid's Theorem* to every case without first examining the facts and circumstances involved in each particular case.

61.1 In the case of *Borosil Glass Works Ltd. (supra)*, Hon'ble High Court of Delhi, while rejecting the contention of the defendants that goods and services offered by both the parties were different, had granted the injunction in favour of plaintiff and against the defendants.

61.2 In the cited judgment of *Wipro Enterprises Private Limited (supra)*, it was contended that since the products of both appellant and respondents pertained to female reproductive hygiene and the consumers of both the products are same *i.e.* women, both the products are allied and cognate goods. Hon'ble Single Bench had based its decision on the said factor, amongst other factors, that in case of hush products such as mentioned above, the prospective buyer would be unlikely to ask too many questions about the product and its origin and it would thus

cause confusion in the minds of the purchaser. In appeal preferred against the order passed by Hon'ble Single Bench before Hon'ble Division Bench of Delhi High Court, it was held that on a *prima facie* findings, the goods appeared to be similar/allied/cognate goods and thus, it upheld the injunction granted by Hon'ble Single Bench citing that the same was passed after a detailed analysis. However, the facts of the present case are distinguishable inasmuch as the goods of the plaintiff are primarily sanitary napkins/ pads which basically fall in the category of consumer hygiene products and are mainly used by female folk, whereas, the products of the defendants are medicinal goods in the form of tablets which are used for treatment of constipation and thus, can be purchased by any person irrespective of gender and age.

- 61.3 The cited judgment in case of *Sona Mahindra Pvt. Ltd. (supra)* was in respect of application under Order XLI Rule 27 CPC wherein the appellants wished to bring on record the examination report of the Trade Marks Registry in which the registrants had disclaimed any exclusive right of the impugned Trade Mark. It was claimed that it was incumbent upon the respondents to bring it on the record, but they failed to do so as per the requirement of Order VI Rule 15A of the Code of Civil Procedure, as

amended by the Commercial Courts Act. Thus, the facts of the said case are quite distinguishable from the facts and circumstances of the case in hand. The plaintiff herein not only withheld user affidavit alongwith supporting documents in the form of invoices showing user of medicinal goods bearing impugned trade mark 'PRUEASE' by the defendant no.1 since the year 2017 alongwith its TMA, but, also shown to have made false averments in the plaint that the said defendant had recently started using, selling, soliciting and networking for the impugned goods. Not only this, the plaintiff also intentionally withheld its reply to the examination report with regard to its application under No.2450092/ 2662319, as also its Counter Statement with regard to its application no. 2662319. Indisputably, all the said documents were well within the power, control and possession of the plaintiff at the time of institution of the present suit, yet, the plaintiff deliberately and consciously withheld such documents by neither disclosing the same in the plaint, nor filing them alongwith the plaint.

62. In the light of aforesaid discussions, this Court is of the considered opinion that the plaintiff has failed to satisfy the triple tests for grant of ad interim injunction *i.e. prima facie* case, balance of convenience and causing of irreparable loss and injury to it, which cannot be

compensated in terms of money. Consequently, the injunction application under consideration is hereby dismissed.

63. However, nothing mentioned herein shall tantamount to an expression of any opinion on merits of the case.

Announced in the open court
On 15th day of February, 2025

(VIDYA PRAKASH)
DISTRICT JUDGE (COMMERCIAL COURT)-02
PATIALA HOUSE COURTS, NEW DELHI