

Mankind Pharma Limited vs Novakind Bio Sciences Private Limited on 20 April, 2021

Author: C.Hari Shankar

Bench: C.Hari Shankar

\$~10(Original Side)

* IN THE HIGH COURT OF DELHI AT NEW DELHI
+ CS(COMM) 188/2021, I.A. 5700/2021, I.A. 5701/2021 &
I.A. 5702/2021

MANKIND PHARMA LIMITED

Through:

..... Plain
Mr. Amit Sibal, Sr. Ad
Mr. Anmol Saxena,
Dwaipayan Banerje
Hemant Daswani &
Sarabpreet Singh, Adv

versus

NOVAKIND BIO SCIENCES PRIVATE LIMITED

..... Defendant

Through: None

CORAM:

HON'BLE MR. JUSTICE C.HARI SHANKAR

ORDER

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20.04.2021

(Video-Conferencing)

I.A. 5702/2021 (under Section 151 of CPC, 1908- for exemption)

1. Subject to the plaintiff filing legible copies of any dim documents, on which he may seek to place reliance, within four weeks from today, exemption is granted for the present.

2. The application is disposed of.

CS(COMM) 188/2021

1. Issue summons, to be served by all modes.

2. Written statement, accompanied by affidavit of admission and denial of the documents, filed by the plaintiff, be filed within four weeks, with advance copy to learned counsel for the plaintiff, who may file replication thereto, accompanied by affidavit of admission and denial of the documents filed by the defendant, within two weeks thereof.

3. List before the Joint Registrar, for completion of pleadings, admission and denial of documents

and marking of exhibits, on 12th July, 2021.

I.A. 5700/2021(under Order XXXIX, Rules 1 & 2 of the CPC, 1908)

1. By this application, the plaintiff seeks interim injunction.

2. The prayer clause in this application, reads as under:

"37. It is therefore, most respectfully prayed that this Hon'ble Court may be pleased to pass the following orders:

a. Temporary injunction restraining the Defendant/Respondent, either by themselves or through their dealers, distributors, stockiest, agents, associates, employees, servants, and/or assigns from infringing the Plaintiff/Applicant's family of marks with word KIND as a part of their trade name/trade mark in any manner whatsoever in relation to medicinal and pharmaceutical preparations;

b. Temporary injunction restraining the Defendant/Respondent, either by themselves or through their dealers, distributors, stockiest, agents, associates, employees, servants, and/or assigns from passing off the Plaintiff/Applicant's family of marks with word KIND as a part of their trade name/trade mark in any manner whatsoever in relation to medicinal and pharmaceutical preparations;

c. Temporary injunction restraining the Defendant/Respondent, either by themselves or through their dealers, distributors, stockiest, agents, associates, employees, servants, and/or assigns from trading and/or selling and/or marketing and/or dealing and/or advertising including advertising and selling on internet and/or rendering services under the trade name and/or trade mark NOVAKIND BIO SCIENCES PRIVATE LIMITED and/or any other trade name/trade mark with the word element KIND in relation to medicinal and pharmaceutical preparations;

d. Temporary injunction restraining the Defendant/Respondent, either by themselves or through their dealers, distributors, stockiest, agents, associates, employees, servants, and/or assigns from trading and/or selling and/or marketing and/or dealing and/or advertising including advertising and selling on internet under the trade mark DEFZAKIND and/or any other trade mark with the word element KIND in relation to medicinal and pharmaceutical preparations;

e. Ex-Parte ad-interim orders in terms of prayers

(a) to (d) above; and f. Any other or further orders as to this Hon'ble Court may deem fit and proper in the facts and circumstances of the present case be also passed in favour of the Plaintiff/ Applicant against the Defendant/Respondent."

3. Mr. Amit Sibal, learned senior counsel, appearing for the plaintiff, prays for ex parte ad interim injunction.

4. As per the averments in the plaint, the plaintiff is the fifth largest pharmaceutical company in India, and claims to be the registered proprietor of the mark, "MANKIND", in all 45 classes, with 78 registrations "MANKIND" in various classes. It is further averred that the mark "MANKIND", has been certified as a well-

known trademark by the Registrar of Trademarks and is published in the list of well-known trademarks maintained by the Registrar. The plaintiff claims to hold 120 registrations in Class 5 alone, wherein the suffix "KIND", is the essential feature of all marks, such as "DEXAKIND", "DENTAKIND", "METROKIND" and "MOXIKIND". The suffix "KIND" is, therefore, according to the plaintiff, the essential or dominant feature of its family of marks and the plaintiff, is, therefore, entitled to seek remedy against infringement and passing off thereof.

5. The plaint also avers that the plaintiff has a turnover of 4,794 crores in 2019-2020.

6. Mr. Sibal has invited my attention to at least two orders, passed by coordinate Single Benches of this Court, in Mankind Pharma Ltd. v. Cadila Pharmaceuticals Ltd. 1 and in Mankind Pharma Ltd. v. Sebakind Pvt. Ltd. 2, in which, in circumstances similar to those obtaining in the present case, interim injunction has been granted.

7. One may refer, in this regard, to Paras 7 to 10 of the order dated 10th December, 2020, in Mankind Pharma Ltd. v. Sebakind Pvt. Ltd.², being the most recent order involving the plaintiff and involving cognate issues, thus:

"7. It is thus evident that the plaintiff is the registered owner of the family of 'MANKIND' marks. The plaintiff in the suit has also given its sales figures which were around 3,877 crores in the year 2018-19 and for its leading 24 MANU/DE/0200/2015 Order dated 10th December, 2020, in CS(COMM) 484/2020 products itself the sales turnover in the year 2018-19 was 1,950 crores. Therefore, the plaintiff has established a goodwill and reputation in the family of marks with suffix/prefix 'MANKIND' and 'KIND'.

8. Grievance of the plaintiff in the present suit is to the adoption of the mark 'SEBAKIND' by the defendants which came to the notice of the plaintiff in the month of September, 2020. On further inquiry the plaintiff found that the defendant had applied for registration of the mark 'SEBAKIND' and in its application the date of user has been given as 14th March, 2019 and the application in this regard was filed on 15th April, 2019. In the column relating to 'any other important information or statement' the reason for adoption of the mark by the defendant given is as under:

"SEBA - Seba stands for sebaceous gland in the epidermis keeps skin healthy. (Sebaceous gland produces a kind of fluid which keep skin healthy and hence the

prefix name KIND - For Mankind SEBAKIND - A Pharmaceutical Company focus on Dermatological Segment (Skin Care Products)"

9. From this statement as given by the defendants in application it is evident that one of the words influencing the decision of the defendants to use the mark with the prefix 'KIND' has been 'MANKIND' and at the stage when the plaintiff has established a goodwill and reputation in its family of marks with suffix/prefix 'MANKIND' and 'KIND'. The plaintiff has been granted various injunction orders in its favour both at the ad-interim stage as also finally in the suit wherein the mark of the plaintiff with the suffix/prefix 'KIND' or 'MANKIND' has been treated as a well established family of marks.

10. Considering the averments in the plaint as also the documents filed therewith, this Court finds that the plaintiff has made out a prima facie case in its favour and in case no ex-parte ad-interim injunction is granted the plaintiff would suffer an irreparable loss. Balance of convenience also lies in favour of the plaintiff and against the defendants. Consequently, till the next date of hearing before the Court, the defendants are restrained in terms of prayer (a) and (b) in para-36 of I.A. 10004/2020 (under XXXIX Rule 1 and 2 CPC)."

8. In the present case, moreover, submits Mr. Sibal, there is also a supervening element of fraud on the public. Mr. Sibal has invited my attention in this context, to the representations contained on the strip of DEFZAKIND, one of the products manufactured by the defendant, a photograph of which is as under:

9. A glance at the aforesaid strip reveals that it depicts "NOVAKIND BIOSCIENCES" as a registered trademark, and DEFZAKIND, to be a trademark for which the application is in process as is manifested by the TM superscript in "DefzakindTM". Mr. Sibal points out, by referring to Pages 1359 and 1360 of the documents annexed to the plaint, that the trademark, "NOVAKIND BIOSCIENCES" was still at the "proposed to be used" stage and is not registered till date. Insofar as the trademark "DEFZAKIND", is concerned, Mr. Sibal has drawn my attention to an order dated 23rd March, 2017, passed by the Registrar of trademarks, which read thus:

"Trademark Application No. 1834114 in Class 5 was advertised in journal no: 1669 dated 1/12/2014. Subsequently an opposition was filed under section 21(1) of the Trade Mark Act, 1999 by the above named opponent On 31/03/2015 to oppose the registration of Trade Mark DEFZAKIND applied for the Notice of Opposition was served to the applicant on 05/10/2016 and till date no counter statement filed by the applicant.

Here, the application number 1834114 in class 5 is deemed as ABANDONED by operation of section 21(2) of the trade mark Act, 1999 and consequently opposition no/s. 830488 abates.

There shall be no order as to costs and respect of the above proceedings."

Thus, submits Mr Sibal, the defendant is misrepresenting an abandoned trademark as valid.

10. Mr. Sibal, points out that, therefore, apart from the aspect of infringement and passing off, the defendants are also defrauding the public by representing their trademarks as registered, whereas they are either abandoned or registration is still in process.

11. Mr Sibal, has, additionally, submitted that in the strip of "DEFZAKIND", the defendants have shown their registered office to be D-251/B, Madhu Vihar, New Delhi-110059, whereas the master data of the defendant, on the record of the Registrar of Companies shows the registered address to be F-343, Phase-II, Transport Nagar, Lucknow, UP 226012. As such, Mr Sibal, submits that the defendant has resorted to misrepresentation even regarding its registered office, probably so to avoid or to evade any coercive action.

12. In para 32 of the report in Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd. 3, the Supreme Court has cautioned thus, in the matter of infringement and passing off in respect of pharmaceutical products:

"32. Public interest would support lesser degree of proof showing confusing similarity in the case of trademark in respect of medicinal products as against other non-medicinal products. Drugs are poisons, not sweets. Confusion between medicinal products may, therefore, be life threatening, not merely inconvenient. Noting the frailty of human nature and the pressures placed by society on doctors, there should be as many clear indicators as possible to distinguish two medicinal products from each other. It is not uncommon that in hospitals, drugs can be requested verbally and/or under critical/pressure situations. Many patients may be elderly, infirm or illiterate. They may not be in a position to differentiate between the medicine prescribed and bought which is ultimately handed over to them. This view finds the support from McCarthy on Trademarks, 3rd Edn., para 23.12 of which reads as under:

"The tests of confusing similarity are modified when the goods involved are medicinal products. Confusion of source or product between medicinal products may produce physically harmful results to purchasers and greater protection is required than in the ordinary case. If the goods involved are medicinal products each with different effects and designed for even subtly different uses, confusion among the products caused by similar marks could have disastrous effects. For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations. The same standard has been applied to (2001) 5 SCC 73 medicinal products such as surgical sutures and clavicle splints".

13. Prima facie, the suffix "KIND", being common to all the products of the plaintiff, has attained distinctiveness within the meaning of Section 17(2) (b) and Section 32 of the Trademarks Act, 1999. The orders passed by this court in cases involving similar challenges by the plaintiff also underscore this position.

14. The use, by the defendant, of "KIND", as the suffix for its pharmaceutical product, therefore, prima facie, infringes the plaintiffs' registered trademark and has the pernicious possibility of confusing or deceiving the public into believing the products of the defendants to be those of the plaintiff.

15. In similar circumstances, this court has, in Mankind Pharma Ltd. v. Cadila Pharmaceuticals Ltd.¹ and in Mankind Pharma Ltd. v. Sebakind Pvt. Ltd. ², granted interim injunction in favour of the plaintiff, of which the latter was granted at an ex-parte ad interim stage.

16. Additional seriousness is imbued, to the challenge of the plaintiff, by the fact that the defendant is probably resorting to misrepresentation regarding the registration of its trademarks as well as the location of its registered office, on the body of its products. Given the fact that the products of the defendants are pharmaceutical products, this is a serious matter, and entirely justifies the prayer of the plaintiff for ad interim injunction.

17. In view thereof, issue notice returnable on 17th May, 2021, before Court. Notice be served on the defendants by all modes possible as per the dispensation in force at present. Let a response to this application, if any, be filed within two weeks from today, with advance copy to learned counsel for the plaintiff/applicant, who may file joinder thereto, if any, before the next date of hearing.

18. Till the next date of hearing, the defendant is restrained from further manufacturing, either on its own behalf or through any job worker, marketing or clearing, for sale in the market, any pharmaceutical product, bearing the "KIND" suffix or which may in any other manner infringe the registered trademarks of the plaintiff.

19. Accordingly, re-notify before Court on 17th May, 2021.

I.A. 5701/2021 (under Order XXVI, Rule 9 of the CPC, 1908- for appointment of LC)

1. Given the presently existing lock down, it is not possible to accede, at this stage to the request for appointment of a local commissioner.

2. The liberty is granted, however, to the plaintiff, to move the court for taking up this application at an appropriate stage, whereupon the prayer would be considered on its merits.

C.HARI SHANKAR, J APRIL 20, 2021/ss