
Delhi High Court reiterates 'first in the world market' is what matters

In a trademark passing off action titled *Boehringer Ingelheim Pharma v. Premchand Godha & Anr.* [CS(OS) No. 1287 of 2013], the High Court of Delhi rejected IPCA Laboratories Ltd. (IPCA) application for setting aside interim injunction restraining them from using the mark MUCOSOLVIN and/or any other mark which is identical or deceptively similar to Boehringer Ingelheim Pharma (Boehringer) mark MUCOSOLVAN. Interestingly, Boehringer was yet to launch products under the mark MUCOSOLVAN and its application is pending registration in India.

Boehringer, in support of its case argued as follows:-

- It adopted the mark MUCOSOLVAN in 1975 and has been using it continuously since 1979 for treatment of productive cough.
- MUCOSOLVAN is not derived from its active pharmaceutical ingredient (API) namely Ambroxol. It is a coined word and inherently distinctive and, therefore, entitles to maximum protection.
- It markets a wide range of products under MUCOSOLVAN which are available in 56 countries. The worldwide sales figure for MUCOSOLVAN products for 2007-2011 is stated to be 6,839 million Euros and the worldwide promotional expenditure is submitted as 1,888 million Euros.
- It owns registration for the mark MUCOSOLVAN in 93 countries worldwide and has applied for registration of the mark in India in October 2011, which is pending registration.
- The mark MUCOSOLVAN enjoys enormous goodwill and reputation around the world, including India. The popularity of MUCOSOLVAN products in India was shown by the number of 'hits' received by the Plaintiff's website www.mucosolvan.com from the Indians.
- It has made significant preparations for the introduction of the product in India.
- It was the first to adopt and use the mark MUCOSOLVAN anywhere in the world and with the pending application in India, has exclusive right to use the mark in India.
- In September 2011, it learnt about the Defendants' use of the mark MUCOSOLVIN for pharmaceutical preparations for treatment of cough.
- The mark MUCOSOLVIN is virtually identical and deceptively similar to the Plaintiff's well-known mark MUCOSOLVAN. The confusion due to mispronunciation or misspelling is very high.
- Both the products contain the same API i.e., Ambroxol which is meant to treat productive cough.
- Although both the products are Schedule-H drugs, they can be sold over the counter. Thus a person of average intelligence and imperfect recollection would not be able to distinguish between the two marks, where the difference is of only one letter.

- The adoption of the mark MUCOSOLVIN by the Defendants is dishonest and subsequent to the Plaintiff's adoption and use of the mark MUCOSOLVAN.
- The Defendants, being in the same area, were aware of the goodwill and reputation of Plaintiff's mark MUCOSOLVAN and its use since 1979.
- The use of the Defendants' mark holds out misrepresentation of the high quality which the Plaintiff's products adhere to. Thus it tarnishes the Plaintiff's goodwill and reputation.

IPCA in their reply contended that:-

- The medicinal preparations bearing their mark SOLVIN have been available for over 30 years in the Indian market. Also, they are the owner of a family of cold range and cough range of products/ brands comprising the word SOLVIN.
- They are the registered proprietor of SOLVIN label mark and a family of SOLVIN suffixed marks.
- The adoption of the mark MUCOSOLVIN is honest and genuine. Since the Defendants' products comprise the mark 'SOLVIN' and a new product with Ambroxol was launched, the appropriate choice of name was MUCOSOLVIN as the same was indicative of the product being meant for action on mucus.
- Apart from the sales figures for SOLVIN and SOLVIN formatted marks since the years 1982-83, they set out the annual sales turnover of MUCOSOLVIN for the years 2011-June 2013.
- The expression 'MUCO' is *publici juris*. There are several manufacturers of medicinal preparations including cough syrups who are using the prefix MUCO as part of their trademark. A list of 67 such products was submitted.
- No exclusive rights can be claimed over the prefix MUCO which is generic and descriptive, and mere addition of the prefix MUCO to the already used and registered mark SOLVIN cannot be said to be a dishonest adoption.
- The Plaintiff cannot claim reputation in the word MUCOSOLVAN in India since it has never used the said mark in India. The principles of transborder reputation would not be applicable in the present case.
- The Plaintiff, on its own showing, was aware of the Defendants' goods being available in the market as far back as in September 2011. There is no explanation why the suit was filed only in July 2013. Thus the suit is barred by delay, acquiescence and laches.

Boehringer in its rebuttal arguments brought out the following:-

- The reputation of the mark MUCOSOLVAN has spilled over into India and the trademark is well-known in India.
- The Plaintiff is seeking to enforce its right in the mark MUCOSOLVAN as a whole and not as individual components.
- The Defendants manufactured cough syrup under the brand 'BronchoSolvin', until they changed the API to Ambroxol and renamed the brand to MUCOSOLVIN in 2011. Thus the adoption of the mark is not bonafide.
- The transborder reputation of the mark MUCOSOLVAN is enhanced by virtue of information available on the internet, exchange between the relevant sections of the public around the world and during international medical conferences and seminars which are attended by thousands of Indian doctors. Also, the Indians travelling abroad would have become aware of the mark through advertisements and retail displays.

- The negligible delay, if any, in filing the suit will not matter since the adoption of the mark MUCOSOLVIN by the Defendants is dishonest and fraudulent.

After considering both the parties' arguments and submissions, the Court ruled that Boehringer has been able to show IPCA's adoption of MUCOSOLVIN mark was not honest and thus confirmed the injunction order based on the following observations:

- Although there may be several 'MUCO' products in market, the peculiar feature of the present case is that the two rival composite marks MUCOSOLVAN and MUCOSOLVIN are confusingly and deceptively similar in terms of the tests spelt out in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd. (AIR 2001 SC 1952)*.
- Whether a mark is generic or *publici juris* is a question of fact. However, it is not permissible to split the marks and thereafter undertake comparison of the different parts. The marks have to be compared as a whole.
- Regarding the question of transborder reputation of the Plaintiff's product in India, the Court regarded the Plaintiff's reliance on the decision in *Milmet Oftho Industries v. Allergan Inc. [(2004) 12 SCC 624]*, wherein it was held that the mere fact that the Plaintiff was not using the mark in India would be irrelevant if they were first in the world market. The Defendants did not dispute that the Plaintiff hold registration for the mark MUCOSOLVAN in as many as 93 countries and that the Plaintiff's MUCOSOLVAN products are available worldwide.
- As regards the delay in filing the suit, it was explained in *Hindustan Pencils Pvt. Ltd. v. India Stationery Products Co. (AIR 1990 Del 19)* that if the Defendant was acting with the knowledge that it is violating the Plaintiffs rights, then injunction cannot be refused, even if there is some delay in filing the suit.

This decision confirms the established principle that a stricter approach should be adopted when judging the possibility of confusion in case of pharmaceutical products. Also, the judgement once again reiterates that medicines are international in character and it is first in the world market that would determine who has the better rights in a mark.

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