IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION (L) NO. 4610 OF 2023
IN
COMMERCIAL IP SUIT NO. 183 OF 2025

Sun Pharma Laboratories Limited ...Applicant/Plaintiff

Versus

Zawadi Healthcare Limited ...Respondent/Defendant

Mr. Anees Patel, Mr. Vaibhav Keni, Ms. Neha Iyer, Mr. Vishwajeet Jadhav, Mr. Mohd. Affan i/b Legasis Partners for Plaintiff.

Mr. Atmaram Patade, Mr. Pranav Manjrekar, Ms. Shraddha H. Patil, Mr. Atharva Kudtarkar and Mr. Rahul Dubey i/b Mr. Atmaram Patade for Defendants.

Coram : Sharmila U. Deshmukh, J.

Reserved on : 12th March, 2026.

Pronounced on : 1st April, 2026.

ORDER :

1. The present suit has been filed seeking relief against infringement of the Plaintiff's registered trade mark "PANTOCID" and passing-off by Defendant by adoption of the trade mark "PANTOZED-40" by the Defendant.

2. The Plaintiff claims proprietory right in the registered trade mark "PANTOCID", which was adopted in the year 1998 by the Plaintiff's predecessor. The Plaintiff is the subsequent proprietor of the trade mark vide application dated 19th August, 2013, apart from the independent registrations secured by the Plaintiff in India and in

various other countries including Kenya. The Plaintiff's medicinal preparation marketed under the trade mark "PANTOCID" and its variants such as "PANTOCID DSR", "PANTOCID-D", "PANTOCID-IV", "PANTOCID-HP" and "PANTOCID-IP" are Schedule-H drugs consisting of the molecule PANTOPRAZOLE, manufactured and sold in the form of injection, capsules, tablets and used for treating acid-related diseases of stomach and intestine. The goodwill and reputation is demonstrated from the chartered accountant certified sales turnover for the period from 1.8.1999 till the year 2022 and the promotional expenses for the peroid from 1st April, 2002 to 30th September, 2012.

3. It is submitted that in January, 2023, the Plaintiff became aware of the impugned mark "PANTOZED-40" used for marketing the Defendant's drug for treating the same ailment, being marketed in Kenya and manufactured by Defendant No. 2 in Mumbai. The internet search revealed availability of the impugned product on third-party websites and there is no application filed for registration of the impugned trade mark "PANTOZED-40" by Defendants.

4. The affidavit in reply is filed by Defendant No. 2 contends that the Plaintiff has not tendered any explanation for adoption of the mark. It is stated that the Plaintiff has suppressed the fact of opposition to the subsequent application by the Plaintiff on 14th December, 2007 for registration of the identical mark "PANTOCID". It is

stated that the drug "PANTOPRAZOLE" is included in the list of International Non-Proprietary Names (INN) issued by the trade marks registry and adopting the suffix "PANTO" from the active drug molecule "PANTOPRAZOLE" cannot permit the Plaintiff monopoly over the prefix derived from the drug. It is contended that simple search of the Trade Marks Registry revealed about 1,300 trademarks available with prefix "PANTO" out of which more than 500 brands are registered with the trade marks registry. There are various pharmaceutical companies dealing in medicines having the word "PANTO" as part of their mark.

5. The reply Affidavit of Defendant No. 1 dated 28th March, 2023 substantially reiterates the stand of Defendant No 2. It further contends that Defendant No. 1-company is registered owner of the trade mark "PANTOZED" under the Trade Marks Act (CAP 506) in Republic of Kenya. The prefix of Plaintiff's trade mark is derived from the active drug PANTOPRAZOLE and the Plaintiff cannot claim absolute monopoly in such trademark. Paragraph No. 7 of the Affidavit-in-reply sets out various other marks using the word "PANTO" as part of their mark prior to the year 1998 and one of the mark "PANTOCAIN" is stated to have been applied for registration in 1952 with the user detail of 1927. In Paragraph No. 8, the Defendant No 1 has set out the table containing six trade marks containing the prefix

"PANTO". It is contended that the Plaintiff has suppressed the fact of opposition to registration of similar mark. It is further contended that no cause of action has arisen in Mumbai and this Court does not have jurisdiction to entertain the present proceedings. The Defendant No. 1 has its trade mark "PANTOZED-40" registered in Kenya, which is dissimilar to the registered trade mark.

6. Mr. Patel, learned counsel appearing for Plaintiff would submit that the Plaintiff's trademark is derived from the molecule "PANTOPARAZOLE" and is sold in the form of injection, capsule, tablets, etc in India and abroad including Kenya. He would further point out the registration obtained by the Plaintiff's predecessor in February, 1998, the sales turnover, promotional expenses and invoices annexed to the plaint to show prior user of the mark since the year 1999 and reputation and goodwill. He would submit that Defendant No. 2 manufactures the impugned product bearing the impugned mark in India and exports the impugned product to Kenya which constitutes infringement under Section 29(6) of Trade Marks Act, 1999. He submits that the Trade Marks Act, 1999 is a territorial law and under Section 56 of the Trade Marks Act, 1999, the use of the trade mark for export trade is deemed to constitute use of a trade mark.

7. Dealing with the defences, he submits that the defense that the mark is common to the trade is based on the registrations existing on

the register and extensive usage is not shown. He submits that proudction of photographs without any other material is insufficient to arrive at a *prima facie* finding that the mark is common to the trade. He submits that the Plaintiff being a registered proprietor of the trademark is not required to show that the adoption is *bona fide*. He submits that the present suit is based on the subsisting registration of PANTOCID and not on the subsequent registration which is opposed.

8. He submits that the defense of the molecule "PANTOPRAZOLE" being part of list of INN is unacceptable as by addition of the words "CID", the mark is conceived. He submits that in any event, the Plaintiff's registration of the Plaintiff's trade mark is of the year 1998 under the Trade and Merchandise Marks Act, 1958 and under the Act of 1999, the prohibition of registration of international non-proprietary names was introduced for the first time. He submits that the list of INN which has been published by the Registrar is of the year 2012. In support he relies upon the following decisions:

K.L.F. Nirmal Industries Pvt. Ltd. vs. Marico Ltd.[1]

Bal Pharma Ltd. vs. Centaur Laboratories Pvt. Ltd.[2]

Cadila Pharmaceuticals Ltd. vs. Sami Khatib[3]

New Bharat Overseas vs. Kisan Agro Processing

1 2023 SCC OnLine Bom 2734.

2 Appeal No. 778 of 2001 in Notice of Motion No. 1645 of 2001 in Suit No. 2349 of 2001, decided on 28th August, 2001.

3 Appeal No. 1158 of 2010 in Notice of Motion No. 599 of 2006 in Suit No. 568 of 2006, decided on 8th April, 2011.

Pvt. Ltd.[4]

Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd.[5]

Wyeth Holdings Corporation vs. Burnet Pharmaceuticals (Pvt.) Ltd.[6]

Glenmark Pharmaceuticals Ltd. vs. Alteus Biogenics Pvt. Ltd.[7]

Macleods Pharmaceuticals Ltd. vs. Union of India and Others[8]

Encore Electronic Ltd. vs. Anchor Electronic and Electricals Pvt. Ltd.[9]

Pidilite Industries Ltd. vs. Riya Chemy[10]

Century Traders vs. Roshan Lal Duggar Co.[11]

Shree Nath Heritage Liquor Pvt. Ltd. vs. Allied Blender and Distillers Pvt. Ltd.[12]

Jagdish Gopal Kamath vs. Lime and Chilli Hospitality Services[13]

Lupin Ltd. vs. Eris Lifesciences Pvt. Ltd.[14]

Regain Laboratories vs. HAB Pharmaceuticals and Research Ltd.[15]

RPG Enterprises Limited vs. Riju Ghoshal[16]

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4 2022 SCC OnLine Del 4575
5 (2001) 5 SCC 73.
6 Notice of Motion No. 4183 of 2007 in Suit No. 3054 of 2007 decided on 25th January, 2008.
7 2024 SCC Online Bom 3141.
8 WP No. 1517 of 2022, decided on 15.02.2023.
9 2007 SCC OnLine Bom 147.
10 2022 SCC OnLine Bom 5077.
11 First Appeal No. 46 of 1976, decided by Delhi High Court on 27.04.1977.
12 FAO (OS) 368 and 493/2014, decided by Delhi High Court on 6th July, 2015.
13 Notice of Motion No. 2586 of 2012 in Suit No. 2549 of 2012, decided on 11th March, 2015.
14 Notice of Motion No. 873 of 2014 in Suit No. 509 of 2014.
15 IA(L)No. 2307 of 2023 in COMIP No. 489 of 2022, decided on 18th July, 2023.
16 Notice of Motion No. 1306 of 2019 in COMIP Suit No. 769 of 2019, decided on 21st March, 2022.

Sun Pharma Laboratories Limited vs. The Madras Pharmaceutical and Others[17]

Laboratories Griffon Pvt. Ltd. vs. Medieos Lifesciences LLP and Others[18]

Stiefel Laboratories INC vs. Ajanta Pharma Ltd.[19]

9. *Per contra*, Mr. Patade, learned counsel appearing for Respondent would submit that there is deliberate suppression of the fact of opposition of the Plaintiff's registration of an identical mark "PANTOCID". He would further submit that the Plaintiff's application filed on 14th December, 2007 for the registration of the wordmark "PANTOCID" has been opposed and in response to the opposition, the Plaintiff has stated that the Plaintiff's mark "PANTOCID" is coined invented mark by taking "PANTO" from the bulk drug "PANTOPARAZOLE" hydrochloride and "CID" from ACID. He would further point out that the mark which was cited was "PANTOCID" and Plaintiff has pleaded that the mark "PANTOCID" is not at all similar to the Plaintiff's registered mark which was in fact an identical mark "PANTOCID". He submits that the Plaintiff is therefore, now estopped from taking the stand that the Defendant's marks "PANTOZED", "PANTOZED-40" are deceptively similar to the Plaintiff's mark "PANTOCID".

17 Notice of Motion (L) No. 2154 of 2016 in Suit (L) No. 755 of 2016.
18 IA(L) No. 25004 of 2024 passed on 16th July, 2025.
19 2014 SCC OnLine Del 3405.

10. He would further point out that the search of Trade Marks Registry reveals almost 5037 marks containing the suffix ”CID”. He would further submit that a simple search in the Trade Marks Registry shows several marks using the prefix “PANTO”. He would further point out that the search result has shown the registration of the mark “PANTOCID” in favor of third-party in the year 1997. He would point out the pleading in paragraph no 8 of reply to contend that on the date of adoption of the Plaintiff’s mark, there was already an application filed for identical mark “PANTOCID” on 7th July, 1997 and therefore, the mark was existing on register. He further submits that the search of the trade mark registry shows almost 1,227 deceptively similar trade marks.

11. He would further point out that in the list published by the Trade Marks Registry of INN, the molecule “PANTOPRAZOLE” finds place. He would further point out the photographs annexed at Exhibit F-1 to Exhibit F-5 to contend that the prefix “PANTO” is used for treatment of the same ailment of acidity. He submits that the Plaintiff and the Defendant’s product have common drug and that the Plaintiff has suppressed that he has derived the mark by appropriating “PANTO” from “PANTOPRAZOLE” and “CID” from “ACID”. He submits that the Defendant No. 1 has registration of the trademark in Kenya. He would further submit that no monopoly could be claimed over the molecule

or active ingredients. In support, he relies upon the following decisions :

Prestige Lights Ltd. vs. State Bank of India[20]

S. K. Sachdeva vs. Shri. Educare Limited and Another[21]

F. Hoffmann-la Roche and Co. Ltd. vs. Geoffrey Manner and Co. Pvt. Ltd.[22]

Schering Corporation and Others vs. Alkem Laboratories Ltd.[23]

Schering Corporation vs. United Biotech (P) Ltd.[24]

Sun Pharma Laboratories Ltd. vs. Finecure Pharmaceuticals Ltd.[25]

Aristo Pharmaceutical Pvt. Ltd. vs. Healing Pharma India Pvt. Ltd.[26]

Shantapa alias Shantesh S. Kalasgond vs. M/s. Anna[27]

Mangalam Organics Ltd. vs. N. Ranga Rao and Sons Ltd.[28]

Pernod Richard India Pvt. Ltd vs. Karanveer Singh Chhabra[29]

Macleods Pharmaceuticals Ltd. vs. Swisskem Healthcare and Another[30]

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20 (2007) 8 SCC 449.
21 2016 SCC On Line Del 6708.
22 Civil Appeal No. 1330 of 1966, decided by Supreme Court on 8th September, 1969.
23 2009 SCC OnLine Del 3886.
24 2010(7) Mh. L. J. 611.
25 2023 SCC OnLine Del 4932.
26 IA(L) No. 26226 of 2025 in Commercial IP Suit (L) No. 25932 of 2025.
27 Appeal from Order No. 915 of 2023 decided on 30th November, 2023.
28 IA(L) No. 7446 of 2025 in COMIP Suit No. 194 of 2025, decided on 3rd September, 2025.
29 2025 INSC 981.
30 COMIP Suit No. 32 of 2011, decided on 2nd July, 2019.

12. Rival contentions now fall for determination.

13. The rival marks in the present case are PANTOCID vs. PANTOZED/PANTOZED-40 used for marketing of drugs for treatment of identical ailment containing identical molecule PANTOPRAZOLE. It is evident that both marks are derived from the molecule by appropriating the first four letters of the molecule and suffixing it with "CID" and "ZED' respectively. The prior adoption and use of the registered trademark "PANTOCID" since 19th February, 1998 is *prima facie* demonstrated from the material placed on record and is not disputed by the Defendants.

14. The Plaintiff's predecessor secured registration of the mark "PANTOCID" derived from the molecule "PANTOPRAZOLE" under the erstwhile statutory regime of Trade and Merchandise Marks Act, 1958. The statutory provisions of Section 13 as it then stood, prohibited the registration of word which is commonly used and accepted name of any single chemical element or single chemical compound (as distinguished from a mixture). The prohibition against registration of a word which is declared by WHO and notified in the prescribed manner by the Registrar from time to time as an "INN" or which is deceptively similar to such name was introduced in Section 13 of the Trade Marks Act, 1999. Section 159(2) which is the repeal and savings clause of

Trade Marks Act, 1999 saves the registration granted under the Act of 1958 as if the same was granted under the corresponding provision of the Trade Marks Act, 1999. The list of INN including the molecule PANTOPRAZOLE has been published by the Registrar in the year 2012 much subsequent to the registration of the Plaintiff's trade mark. The registration of Plaintiff's trade mark cannot be affected by the subsequent prohibition on use of an "INN".

15. The defence under Section 13 of Trade Marks Act, 1999 must fail also on the ground that the registered mark PANTOCID is not entirely derived from the molecule PANTROPRAZOLE but is a unique combination of portion of the molecule and portion of ailment that it treats i.e. acidic reflux. It is common in medicine industry to name the drug after its molecule, or disease or the concerned organ. The exclusivity is claimed in the combination of the "PANTO" with "CID" and not in the prefix "PANTO". It is the appropriation of the mark substantially from generic word which is descriptive and incapable of registration and not the unique combination derived from portion of generic drug and the ailment that it treats. Even accepting that the trade mark is derived from two generics, it is the combination which deserves statutory protection as the registration grants an exclusive right to the Plaintiff to use the said registered mark.

16. The Defendants have stopped short of assailing the validity of

the registered trade mark and the registration of the trade mark *prima facie* implies the distinctive nature of the mark. Unless the validity is assailed on the principles set out in ***Lupin Limited vs. Eris Lifesciences Pvt. Ltd.***[31], the use of deceptively similar trade mark would constitute infringement. It is not necessary for the registered proprietor to give an explanation for adoption of the mark but for the Defendants to demonstrate *bona fide* adoption of a deceptively similar mark. The Defendant No 1 has set out the history and origin of PANTO/PANTOPRAZOLE without a single averment explaining the adoption of its mark.

17. Having registered its trade mark PANTOZED, which is also derived from the molecule PANTOPRAZOLE, the Defendant No 1 is estopped from claiming that the Plaintiff's mark is incapable of being registered. The defence of being common to trade must fail on the same reasoning, apart from the fact that there is no material produced on record to show extensive usage. The Defendants have themselves pleaded that the existence of several similar marks using the prefix PANTO and the suffix CID are result of public search which at the highest may show existence on register, which does not assist the case of the Defendants in absence of any material to show extensive use. The search results showing registrations prior to the Plaintiff's

31 (2015) SCC OnLine Bom 6807.

registration is unsubstantiated and the registration of the Plaintiff's mark is *prima facie* evidence of its validity. The defence is also flawed as it dissects the mark to claim that the prefix PANTO is common to the trade contrary to the well settled tests that the marks have to be compared as a whole. It is equally well settled that the Plaintiff is not expected to go after every infringer and the existence of other deceptively similar trade marks cannot constitute a defence in an infringement action.

18. The Defendant No. 1 is a Kenyan entity and Defendant No. 2 is exporting the products bearing the trade mark "PANTOZED-40" to Defendant No. 1. Section 56 of Trade Marks Act, 1999 provides that the application in India of trade mark to goods to be exported from India would constitute use of trade mark in relation to those goods for any purpose for which such use is material under the Trade Marks Act, 1999. It would also be apposite to make a reference to Section 29(6) of the Trade Marks Act, 1999 which provides that for the purpose of infringement, a person uses a registered mark if he exports goods under the mark. The statutory provisions would indicate that the activity of Defendant No 2 of manufacturing the impugned product with the impugned mark carried out in India and exporting the impugned products from India is liable for an infringement action as such use constitutes use of the trademark.

19. Mr. Patade would stress on the suppression of the application filed by the Plaintiff on 14th December, 2007 for registration of an identical wordmark PANTOCID claiming user detail of 1st March, 1999, which has been opposed. It is perplexing as to why the subsequent application was filed in the year 2007 for registration of identical mark for identical products despite the earlier registrations. An action for infringement can be founded only on the basis of a registered trade mark and the facts which are necessary to be disclosed are the facts pertaining to the registration of the trade mark. The trade mark which has not been registered and is not the basis for the infringement action is immaterial for adjudication of injunctive reliefs. From the written submissions filed by the Plaintiff to the opposition proceedings against the subsequent application for registration, it appears that the cited marks were "PANTOCID" and "PANTOBID". The stand of the Plaintiff in in paragraph 7 that the Plaintiff's mark "PANTOCID" was not at all similar to the mark cited in the examination report would have to be read with the subsequent paragraphs which state that in respect of the mark "PANTOCID" registered under application no. 756590 the said mark is not in use though registered and in respect of the mark "PANTOCID" under the registration application no. 802552, it is stated that the said trademark is withdrawn and in respect of the cited trademark registered under application no 1213995 i.e. of "PANTOCID"

and application no 1506043 of "PANTOBID", it is stated that the trade marks are opposed by the Plaintiff. From the written submissions placed on record, it is not clear whether the marks cited as conflicting marks were registered prior to registration secured by the Plaintiff in the year 1998 of identical "PANTOCID" mark and in fact, the list which has been produced by the Defendant at page no. 178 shows that the said mark under application no. 756590 has been removed from the trademark as on 15th March, 2022. The opposition came to the application which was filed in the year 2007 whereas the Plaintiff also had a prior trademark which was registered in the year 1998. Even if these facts would have been disclosed, it was not a material fact to be considered for injunctive reliefs when the Plaintiff has secured registration of its PANTOCID mark which is in use since the year 1998. The infringement is complete upon use of identical or deceptively similar trade mark. The doctrine of prosecution history estoppel will not come in the way of the Plaintiff claiming infringement of its registered trade mark.

20. Coming to the aspect of deceptive similarity, both the marks use the common prefix PANTO. The Plaintiff uses the suffix CID and Defendants use the suffix ZED. When the marks are pronounced as a whole, it is likely that both the marks would sound similar as ZED is phonetically similar to CID. There is strong likelihood of the

Defendant's drug being handed over when asked for the Plaintiff's product. Being medicinal preparation even the slightest possibility of confusion is liable to be arrested. The principles set out in ***Cadilla Health Care Ltd vs Cadila Pharmaceutcials Ltd*** (supra) are well settled.

21. In so far as the objection to jurisdiction is concerned, there are no submissions canvassed and even otherwise Section 134 of Trade Marks Act, 1999 is sufficient answer to the objection to jurisdiction.

22. The Plaintiff has succeeded in making out a *prima facie* case for infringement of trade mark by use of the deceptively similar mark "PANTOZED". The use by the Plaintiff through its predecessor of the registered trade mark is *prima facie* shown from the year 1998/1999 and there is no reason for the Defendants to adopt deceptively similar trade mark, which is registered under the Kenyan laws on 25th June, 2021. The Defendants cannot claim balance of convenience in their favour as the Plaintiff's adoption through their predecessor is since the year 1998. The Defendants have no registration in India and even its Kenyan registration is of recent origin. The Plaintiffs have thus made out *prima facie* case for grant of injunction against infringement of its registered trade mark.

23. Insofar as the action of passing-off action is concerned, the grant of injunction against infringement does not *ipso facto* lead to injunctive

reliefs against passing off. The considerations may overlap to certain extent, however, the common law remedy is founded on the principle that no man should be allowed to trade its goods as that of others and obtain unjust enrichment at the cost of the goodwill and reputation of other party. The elements of misrepresentation, goodwill and reputation and damage to the Plaintiff are required to be satisfied. There were no submissions canvassed to satisfy this Court that the Defendants intentionally or unintentionally mis-represented their product as that of the Plaintiff. The Plaintiff claim of infringement is premised on Section 29(6) of Trade Marks Act, 1999 as the Defendant No 2 is manufacturing the product in India and exporting the same to Kenya to Defendant No 1. There is no material brought to the notice of the Court that the Defendant's products are available in India so as to damage the Plaintiff's goodwill and reputation which is shown in India. I am thus not inclined to grant interim relief as against passing off.

24. Dealing with the citations which have been relied upon by Defendants on the proposition that no relief can be granted on suppression of material facts, the decision of Hon'ble Apex Court in the case of ***Prestige Lights Limited vs. State Bank of India*** (supra) and decision of Delhi High Court in the case of ***S. K. Sachdeva vs. Shri Educare Limited*** (supra) was cited. As far as the decision of ***Prestige Lights Limited*** (supra) is concerned, there can be no quarrel with the

proposition however, its applicability to the facts of the present case is doubtful as Plaintiff claims infringement of its registered trade mark and the opposition proceedings as well as the stand taken by the Plaintiff was in the context of subsequent application for registration of identical trade mark. As it is already held that it was not material fact to be pleaded in the context of infringement of registered trade mark, the decisions of the Hon'ble Apex Court as well as the Delhi High Court are clearly distinguishable. In the case of ***S. K. Sachdeva vs. Shri Educare Limited*** (supra), the stand taken by Plaintiffs was in respect of same trade mark of which the infringement was alleged which distinguishes the facts from the facts of the present case.

25. The decision of Hon'ble Apex Court in the case of ***F. Hoffmann-La Roche and Co. Ltd. vs. Geoffrey Manner and Co. Pvt. Ltd.*** (supra), the Delhi High Court in the case of ***Schering Corporation vs. Alkem Laboratories Limited*** (supra), ***Sun Pharmaceuticals Limited vs. Finecure Pharmaceuticals Ltd.*** (supra), the Bombay High Court in the case of ***Schering Corporation vs. United Biotech (P.) Ltd.*** (supra) have been cited to support the proposition that where the trade mark is adopted from a common generic drug, no single proprietor can claim absolute monopoly in such a trade mark. In the case of ***F. Hoffmann-la Roche & Co. Ltd. vs. Geoffrey Manner & Co. Pvt. Ltd.*** (supra), the proceedings arose out of rectification application and the marks in

questions were PROTOVIT vs. DROPOVIT, the Hon'ble Apex Court accepted that common suffix "VIT" indicates that goods are vitamin preparations and are descriptive. It held that if greater regard is paid to the uncommon element in these two words, it is difficult to hold that one will be mistaken for or confused with the other. In the present case, this Court has held that there is phonetic similarity and even applying the test of Hon'ble Apex Court, the suffix "CID" vs. "ZED" are similarly sounding words and are therefore, deceptively similar.

26. In the case of ***Schering Corporation vs. Alkem Laboratories Ltd.*** (supra), the marks in question were "TEMODAL/TEMODAR" vs. "TEMOGET/TEMOLKEM". The Delhi High Court held that "TEM/TEMO" is *publici juris* for TEMOZOLOMIDE and not for "TEMODAL/TEMODAR". It held that use of the marks "TEMOKEM" and "TEMOGET" by Respondents cannot lead to inference that TEMOKEM and TEMOGET have been sourced from the manufacturer of TEMODAL/TEMODAR and had also taken into consideration the vast difference in the prices of the products. It held that rival marks in view of the suffix distinguishes and differentiates the products and held them not to be phonetically or visually deceptively similar to the trade marks TEMODAL/TEMODAR. In that case, there was a specific finding that the marks are dissimilar and that common features were descriptive and publici juris which is not the finding of this Court.

27. In the case of ***Schering Corporation vs. United Biotech (P.) Ltd.*** (supra), the marks in question were NETROMYCIN vs. NETMICIN. This Court noted that the rival trade marks were coined from the generic drug "Netilmicin". The rival marks in that case were appropriated from the generic drug and there was no combination by using the part of generic drug with suffix which is the case in the present application.

28. In the case of ***Sun Pharma Laboratories Limited vs. Finecure Pharmaceuticals Limited*** (supra), the marks in question were PANTOCID vs. PANTOPACID, the Delhi High Court held that PANTOCID and PANTOPACID were structurally, phonetically and visually similar and PANTOPACID *prima facie* infringes PANTOCID. The application came to be rejected by accepting the contention of suppression, concealment and misstatement. The said decision would in fact assist the case of the Plaintiff as there was a categorical finding by the Delhi High Court that even excluding the consideration of common prefix "PANTO", the remaining parts were deceptively similar.

29. In support of the proposition that use of "INN" in trade mark will not confer exclusivity, reliance is placed on the decision of this Court in the case of ***Aristo Pharmaceutical Limited vs. Healing Pharma India Pvt. Ltd.*** (supra). In that case, the Plaintiff had adopted a clipped version of "INN" and in that context, this Court had held that infringement cannot be claimed. The facts are therefore, clearly

distinguishable.

30. To support the case of prosecution history estoppel, the decision in the case of ***Shantapa alias Shantesh S. Kalasgond vs. M/s. Anna*** (supra) is cited. There is no quarrel with the said proposition however, in the present case, as the infringement is claimed on the basis of the trade mark which is registered without any opposition, the decision does not assist the case of the Defendant.

31. On the aspect of the applicable test for deceptive similarity, the decision in the case of ***Mangalam Organics Limited vs. N. Ranga Rao and Sons*** (supra), ***Macleods Pharmaceuticals Limited vs. Swisskem Healthcare*** (supra) and the decision of the Hon'ble Apex Court in the case of ***Pernod Richard India Pvt. Ltd. vs. Karanveer Singh Chhabra*** (supra) is relied. It is by now well-settled that each case is decided on its own facts by assessing the deceptive similarity of the marks contained therein by applying the well-settled tests. In these decisions, the Courts have considered the rival marks to come to a finding that the marks not being similar. These decisions cannot assist the case of the Plaintiff upon finding being arrived at by this Court that the marks are similar.

32. In view of above, Interim Application is allowed in terms of prayer clause (a).

[Sharmila U. Deshmukh, J.]