



2025:DHC:5039-DB



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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

*Reserved on: 21 February 2025*  
*Pronounced on: 1 July 2025*

+ RFA(OS)(COMM) 8/2023, CM APPL. 20433/2023, CM APPL. 34634/2023 &amp; CM APPL. 42133/2023

MODI-MUNDIPHARMA PVT. LIMITED ..Appellant  
Through: Mr. Pravin Anand and Ms.  
Prachi Agarwal, Advs.

versus

SPECIALITY MEDITECH  
PVT. LTD. & ANR. ....Respondents  
Through: Mr. Gagan Gupta, Sr. Adv.  
with Mr. Saurabh Gupta, Adv. for R-1

**CORAM:**  
**HON'BLE MR. JUSTICE C. HARI SHANKAR**  
**HON'BLE MR. JUSTICE AJAY DIGPAUL**

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**JUDGMENT**  
**01.07.2025**

**C. HARI SHANKAR, J.**

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1. This is a regular first appeal filed at the instance of Modi-Mundipharma Pvt. Ltd, the plaintiff in CS (Comm) 353/2018, assailing judgment and decree dated 23 March 2023 passed by a learned Single Judge of this Court, whereby the aforesaid suit has been dismissed.



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2. Respondent 1, who alone ultimately contested the suit, has also filed cross objections, challenging the impugned judgment to the extent it decides Issue 2, as framed in the suit, against Respondent 2 and in favour of the appellant.

3. This judgment disposes of the appeal and the cross-objections.

### ***The lis***

4. By the suit, the appellant-plaintiff alleged that, by use of the trade mark FEMICONTIN, the respondents were infringing the registered trade marks FECONTIN-F and CONTIN, for both of which the appellant possesses registrations under the Trade Marks Act 1999. Respondent-1 Speciality Meditech Pvt Ltd. is admittedly the manufacturer of the allegedly infringing product and Respondent 2 Preet International Pvt Ltd. markets the product. It is alleged that Respondent 2 is the principal infringer who has, from time to time, been contracting with different manufacturers to manufacture the infringing products.

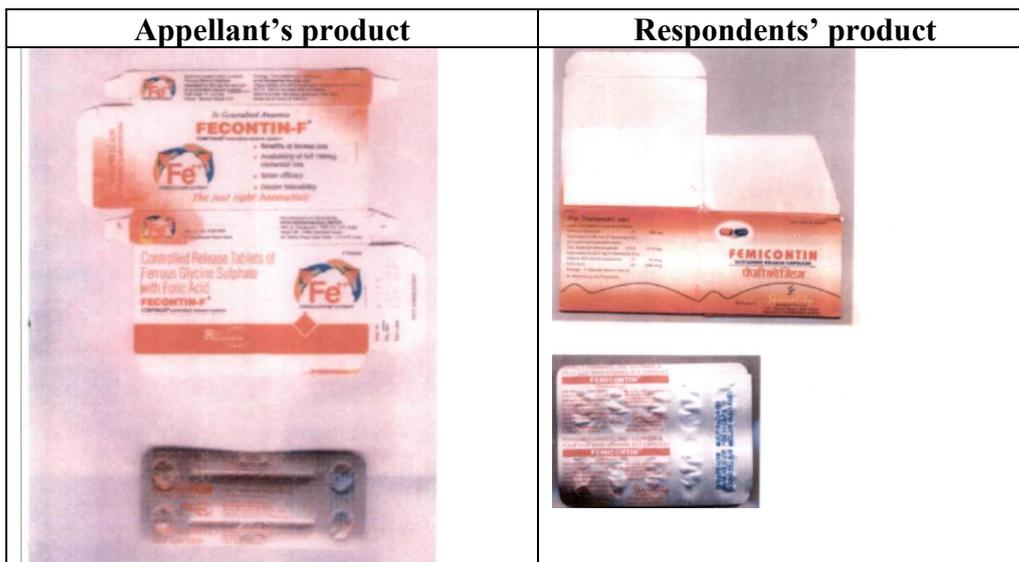
5. The appellant, therefore, sought a decree of permanent injunction, restraining the use, by the respondents, of the mark FEMICONTIN, or any mark which included CONTIN as a part thereof, for pharmaceutical preparations. Additionally, damages, costs etc., were also sought in the suit.

6. The learned Single Judge has, by judgment dated 23 March



2023, dismissed the suit. Aggrieved thereby, the appellant has instituted the present appeal under Section 13 of the Commercial Courts Act 2015. The appellant has, therefore, prayed, in the present appeal, that the impugned judgment and decree dated 23 March 2023, of the learned Single Judge, in CS (Comm) 353/2018 be quashed and set aside and that the respondents and all others acting on their behalf be restrained permanently from using the mark FEMICONTIN or any other mark deceptively similar to FECONTIN-F or the CONTIN “family of marks” of the appellant.

7. Photographs of the appellant and respondents’ products were filed before the learned Single Judge and have also been placed on record with the present appeal. The said photographs may be shown, side by side, thus:



8. Are the products Schedule H drugs?

A somewhat puzzling feature may be noted here. Both sides have



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pleaded, and argued, on the presumption that the products are Schedule 'H' drugs, i.e. drugs which are contained in Schedule H to the Drugs and Cosmetics Rules, 1945 and cannot, therefore, be dispensed without a doctor's prescription. In all such cases, the fact that the formulation is a Schedule 'H' drug, and requires a doctor's prescription for being dispensed, invariably finds place on the package and the strip of the tablets/capsules. We do not find any such mention on the packages or strips either of FECONTIN-F of the appellant, or of FEMICONTIN, of the respondents. We have also scanned the Internet in this regard, and it does not appear that either product is, in fact, a Schedule H drug. Nonetheless, as both sides have argued on this basis, we, in appeal, do not propose to disturb this position. In any event, as the discussion hereinafter would reveal, this fact does not seriously impact the outcome of the present appeal. We merely note it, as it appears strange that, on facts, both sides appear to be proceeding on a wrong premise.

## **Rival pleadings before the learned Single Judge in CS (Comm) 353/2018**

### **9. The plaint**

**9.1** The appellant alleged and asserted, in the plaint before the learned Single Judge, thus:

- (i) The appellant is the proprietor of family of trade marks of which CONTIN is the common feature. CONTIN itself is registered as a trade mark in favour of the appellant in class 5.



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The list of the registered trade marks of the appellant, all of which are in Class 5, have thus been provided in the plaint:

S.No.	Trade Mark
1	ACOCNTIN
2	ALPROCONTIN
3	AMBROCONTIN
4	ANGICONTIN
5	ARCONTIN
6	ASACONTIN
7	ASPICONTIN
8	BUCOCONTIN
9	BUCONTIN
10	CONTIN
11	CONTINUS
12	CORBUCONTIN
13	DILCONTIN
14	DIUCONTIN
15	DIUCONTIN-K
16	FECONTIN
17	FECONTIN-F
18	FECONTIN-Z
19	FENCONTIN
20	GLIPICONTIN
21	INDICONTIN
22	ISOCONTIN
23	METOCONTIN
24	MORCONTIN
25	NAPROCONTIN
26	NITROCONTIN
27	PYRICONTIN
28	SALCONTIN
29	THEOCONTIN
30	TRD-CONTIN
31	UNICONTIN
32	VASCONTIN

(ii) The products of the appellant bearing CONTIN as a part of their names/trademarks have, by dint of extensive and continuous use, amassed considerable reputation in the market. The use of the mark CONTIN as a part of the name of



pharmaceutical product acts as a source identifier for the appellant.

(iii) FECONTIN-F, in respect of which the appellant has a separate trade mark registration, is a combination of Ferrous Glycerine Sulphate, equivalent to 100 mg iron<sup>1</sup>, and folic acid. The mark is in use by the appellant since 1993. The sales turnover and expenses involved in promotion and advertising of the mark were thus provided in the plaint:

S. No.	Period	Total Sales (₹) in lakhs)	Advertisement (₹) (in lakhs)
1	March 93 to Dec 93	16.85	
2	Jan 94 to Dec 94	32.41	0.19
3	Jan 95 to Dec 95	53.07	
4	Jan 96 to Dec 96	73.76	
5	Jan 97 to Dec 97	94.58	
6	Jan 98 to Dec 98	105.60	
7	Jan 99 to Dec 99	112.60	0.02
8	Jan 00 to Dec 00	116.20	
9	Jan 01 to Dec 01	147.13	0.85
10	Jan 02 to Dec 02	143.18	0.75
11	Jan 03 to Dec 03	215.16	21.12
12	Jan 04 to Dec 04	233.89	23.18
<b>Total</b>		<b>1344.43</b>	<b>46.2</b>

(iv) The appellant has, therefore, a right to claim exclusivity over the use of CONTIN as a part of the name of any pharmaceutical product as well as specifically against any trade mark which was deceptively similar to the registered trade mark FECONTIN-F.

(v) In July 1999, the appellant came across the product

<sup>1</sup> "Ferrum" being the chemical name for iron



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FEMICONTIN, being manufactured by M/s Eubiotics Pharmaceuticals<sup>2</sup>, the predecessor-in-interest of Respondent 1.

(vi) FEMICONTIN contains 150 mg Ferrous Sulphate, 61.8 mg Zinc Sulphate Monohydrate, 1.2 mg Cyanocobalamin, 1.2 mg, Folic Acid and Vitamin B12.

(vii) The use of the mark FEMICONTIN by the respondents infringed the registered trade marks FECONTIN-F and CONTIN, of the appellant.

(viii) The appellant, therefore, addressed a cease and desist notice to Eubiotics on 10 July 1999, calling on the respondents to discontinue use of CONTIN as a part of the name of any of their pharmaceutical products as well as specifically to discontinue the use of the mark FEMICONTIN. Eubiotics responded on 3 August 1999, disputing the proprietary rights of the appellant over the trade marks FECONTIN-F and CONTIN.

(ix) As the respondents' product FEMICONTIN was not being sold in the market, the appellant did not institute any suit at that point of time. However, on finding the product FEMICONTIN in the market in March 2001, the appellant instituted OS 33/2004 before the District Court at Ranga Reddy in Hyderabad, alleging that Eubiotics was infringing the appellant's registered trade marks FECONTIN-F and CONTIN and, therefore, seeking an injunction against the respondents in

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<sup>2</sup> "Eubiotics" hereinafter



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that regard, apart from other reliefs.

(x) Though OS 33/2004 was instituted in 2002, Eubiotics changed its name to Stanbiotic Pvt Ltd in 2004, upon which the appellant had to file an amendment application to change the name of the defendant in the array of parties. The suit thus got renumbered as OS 33/2004.

(xi) Respondent 1, as Defendant 2 in OS 33/2004, disputed the territorial jurisdiction of the Ranga Reddy District Court to entertain the suit, as it was submitted that the allegedly infringing products were not being sold in Andhra Pradesh. Among the places where the products were being sold was, however, New Delhi.

(xii) Accordingly, on 23 August 2004, the learned Additional District Judge<sup>3</sup>, Ranga Reddy District Court, allowed OS 33/2004 to be withdrawn with liberty to the appellant to file a fresh suit in the appropriate court.

(xiii) In the meanwhile, the manufacturer of the allegedly infringing FEMICONTIN changed to Mark Drugs Pvt. Ltd<sup>4</sup>, though the marketing company remained Respondent 2.

(xiv) Pursuant to the liberty granted by the Ranga Reddy District Court, *vide* order dated 23 August 2004, the appellant

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<sup>3</sup> “the learned ADJ” hereinafter

<sup>4</sup> “Mark Drugs” hereinafter



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instituted CS (OS) 577/2005 before this Court, seeking the same relief against the respondents as were sought in OS 33/2004 before the Ranga Reddy District Court. Defendant 1, in the suit, was Mark Drugs.

(xv) On 24 May 2005, this Court granted an *ad interim* injunction restraining the respondents from using the mark FEMICONTIN as well as any mark which included CONTIN as a part thereof, as would infringe trade marks 518596 and 518594, under which the trade marks FECONTIN-F and CONTIN respectively were registered in favour of the appellant. Subsequently, however, by order dated 22 May 2006, this Court returned the plaint under Order VII Rule 10 of the CPC, on the ground that the appellant had arbitrarily valued the suit at over ₹ 20 lakhs, with liberty to institute the suit before the court of appropriate jurisdiction.

(xvi) The appellant assailed the said order dated 22 May 2006 before the Division Bench of this Court by way of FAO (OS) 476/2006, which was disposed of by the Division Bench of this Court on 30 August 2006 with liberty to move an application before the learned Single Judge. The appellant, therefore, moved an application under Order VI Rule 17 of the CPC to amend the plaint as well as Review Application 07/2007 under order XLVII Rule 1 of the CPC before the learned Single Judge.

(xvii) At the time of institution of CS (Comm) 353/2018, from which the present appeal emanates, these applications were



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pending before the learned Single Judge, as is reflected in para 23 of the plaint. However, subsequently on 12 November 2007, CS(OS) 577/2005 and Review Petition 07/2007 were withdrawn by the appellant.

(xviii) Thereafter, Respondent 2 Preet International Pvt Ltd succeeded Mark Drugs as the manufacturer of the allegedly infringing products.

(xix) It was in these circumstances that the appellant had instituted the present suit against Respondents 1 and 2. The suit was originally numbered CS (OS) 2176/2007, but, after the coming into force of the Commercial Courts Act in 2015, was renumbered CS (Comm) 353/2018.

(xx) Apart from the fact that the use, by the respondents, of the mark FEMICONTIN infringed the marks CONTIN and FECONTIN-F, registered in favour of the appellant, the use of the mark FEMICONTIN also resulted in brand dilution as well as erosion of the goodwill that had been earned by the appellant's CONTIN series of marks, including FECONTIN-F. The mark FEMICONTIN, therefore, resulted in infringement of the statutory and common law rights of the appellant in the CONTIN family of marks, and specifically in FECONTIN-F.

(xxi) Besides, the mark FEMICONTIN was practically identical to the appellant's registered trademark FECONTIN-F.



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(xxii) The composition of the two products was also identical.

(xxiii) The two products catered to the same class of consumers and were available through the same trade channels.

(xxiv) There was, therefore, every likelihood of a consumer being confused between the appellant's and the respondents' products as a result of use of the mark FEMICONTIN by the respondents.

(xxv) By use of the mark FEMICONTIN, the respondents were also seeking to pass off their product as the product of the appellant.

(xxvi) The case was, therefore, one of rank dishonesty.

(xxvii) As the respondents had themselves acknowledged before the Ranga Reddy District Court that they were selling their products in Delhi, this Court possessed territorial jurisdiction to deal with the matter.

**9.2** Based on the aforesaid assertions and allegations, the appellant prayed, in the suit, thus:

“37. It is therefore prayed that the following reliefs be granted to the Plaintiff:

- a) An order for permanent injunction restraining the Defendants, its partners or proprietor, as the case may be, its offices, servants, and agents from reproducing on the label or packaging of their product,



the trademark FEMICONTIN or any other trademark deceptively similar to the Plaintiffs trademark FECONTIN-F or from using the Plaintiffs registered trademark CONTIN amounting to an infringement of the Plaintiff's registered trademarks bearing No. 518596 & 518594 respectively in class 5.

b) An order for Permanent Injunction restraining the defendants, its partners or proprietor, as the case may be, its offices, servants, and agents from manufacturing, selling, offering for sale advertising, directly or indirectly dealing in medicinal and pharmaceutical preparation in packaging bearing Trademark FEMICONTIN which is identical or deceptively similar to the Plaintiff's CONTIN series of marks and the trademark FECONTIN-F or from doing any other act which would amount to passing off of the Defendant's goods or business as the goods and business of the Plaintiff;

c) An order for delivery up of all the goods bearing the impugned mark, dies, cartons, labels, packaging and any other infringing material to the authorised representative of the Plaintiff for the purposes of destruction/ erasure;

d) Direct the Defendants to pay a sum of Rs. 48,00,000/- towards damages which is the estimated loss of sales by the Plaintiff as also the loss of reputation owing to the illegal activities of the Defendants;

e) An order for rendition of accounts of profits of the Defendants on account of sales of the medicines bearing the trademark FEMICONTIN and for any other products bearing the Plaintiff's Trademarks and the sum due paid to Plaintiff;

f) An order directing the Department of Drugs Control Administration, Government of Andhra Pradesh to cancel the Drug manufacturing license of Defendant No. 1.

And or May Pass any other orders as this Hon'ble Court may deem fit and proper in facts and circumstances of the present case.”



## 10. Written Statement of Respondent 1

Respondent 1, in its written statement, asserted thus:

(i) The word CONTIN was not invented by the appellant, but was merely an abbreviation of the dictionary word “CONTINUE”. It was settled that a person could not be permitted a monopoly over ordinary words which were common to the trade or otherwise descriptive in nature.

(ii) As such, the appellant could not claim any exclusive right over CONTIN either as a prefix or as a suffix in the name of any pharmaceutical product.

(iii) Though the appellant possessed a registration for the trademark CONTIN, it had never used the mark.

(iv) It was denied that the CONTIN, as a prefix or suffix, was the source identifier of the appellant. A tabular representation of three other pharmaceutical products, of which CONTIN formed part of their names, was thus provided:

Marks	Application Nos	Status	Proprietor
CONTINUS	547328	--	Elder Pharmaceuticals Ltd, Delhi
CONTINA	769168	Registered	Schering Aktiengesellschaft, Germany
CONTINUE	1011707	--	Weave Pharmaceuticals



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			Pvt. Ltd, Chennai
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(v) The composition of the appellant and respondents' products were different. FECONTIN-F contained Ferrous Glycine Sulphate equivalent to 100 mg Iron and 0.5 mg Folic Acid whereas FEMICONTIN contained 200 mg Ferrous Fumurate in sustained release form, 61.8 mg Zinc Sulphate Monohydrate, 10 mcg Cynocobalamin and 1.5 mg Folic Acid.

(vi) The appellant had not filed any document to support its user claim of March 1993.

(vii) The appellant had also not filed any document to support the sales turnover and promotional expenses reflected in the plaint. Moreover, these figures were provided only till 2004.

(viii) The appellant and respondent's products were Schedule "H" drugs, which could be sold only on prescription by medical practitioners. Medical practitioners were experienced and were unlikely to be confused between FECONTIN-F and FEMICONTIN.

(ix) There was, therefore, no likelihood of confusion as a result of use, by the respondents, of the mark FEMICONTIN.

(x) Whereas, in OS 33/2004 filed before the Ranga Reddy District Court, the appellant contended that it had come to learn of the use, by the respondent, of FEMICONTIN in January



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2004, in the present suit, the appellant claimed to have learnt of the use of the mark FEMICONTIN by the respondents in July 1999. The averment was, therefore, misleading.

(xi) In fact, Respondent 1 was using the trademark FEMICONTIN since 1999 and had also applied for registration of the mark under the Trade Marks Act, which was pending.

(xii) The marks FECONTIN-F and FEMICONTIN were not similar.

(xiii) Besides, the products, in appearance, packing, price and composition, were distinct and different, resulting in there being no likelihood of any confusion between them.

(xiv) The suit was bad for want of territorial jurisdiction. The statement made by Respondent 1 before the District Court at Ranga Reddy, on which the appellant placed reliance, was that Respondent 1 did not have any sales of its products in the State of Andhra Pradesh, but was selling its products in Delhi, UP and Rajasthan. This was with reference to the overall sales of the products of Respondent 1 and not specifically with respect to FEMICONTIN. In fact, the product FEMICONTIN was not sold in Delhi.

(xv) The allegation of passing off was denied. Respondent 1 had no intent to pass off its products FEMICONTIN as the product of the appellant.



(xvi) In this context, the origin of the mark FEMICONTIN was thus sought to be explained. “FE” in FEMICONTIN referred to Ferrous Fumarate, “FEMI” was an abbreviation for “Female” as the product was of use to pregnant women and the suffix “CONTIN” was an abbreviation for “CONTINUES”. By using the mark FEMICONTIN, therefore, it was sought to be conveyed that the drug, when administered, continuously released iron into the body of pregnant women, resulting in increase in Red Blood Corpuscles<sup>5</sup> and overall well-being of the patient.

(xvii) The prefix “FE” was generic, and was the origin of both the rival marks FECONTIN-F and FEMICONTIN. The appellant could not, therefore, be permitted a monopoly over the use of the generic “FE” prefix.

(xviii) Besides, the use of the “FE” prefix as an abbreviation for Ferrous (Iron) was also suggestive of the ailment which the product was intended to cure, which was Anaemia.

(xix) The “FE” prefix was common to the trade. A list of several pharmaceutical products, in the names of which “FE” figured as a prefix was thus provided:

Marks	Application No's	Status	Proprietor
FEMICARE	728337	--	Rahul Laboratories Pvt

<sup>5</sup> “RBC” hereinafter



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			Ltd, Hyderabad
<b>FEMICHROME</b>	1026073	Registered	Needs pharma Pvt Ltd, Muzaffar Nagar
<b>FEMICOT</b>	1092685	Opposed	Guapha Remedies Pvt Ltd, NOIDA
<b>FEMICORD</b>	1142048	Registered	Focus health care Pvt Ltd, Punjab
<b>FEMICON</b>	1194028	Opposed	Consis pharma, Kolkata
<b>FEMIRON</b>	--	--	Swarde Pharmaceuticals, Mumbai
<b>FEMICLO-V</b>	1332941	opposed	Foregen Healthcare Ltd, Delhi
<b>FEFODAN</b>	--	--	Danapharma
<b>FEFODAN-Z</b>	--	--	Danapharma
<b>FEFOL</b>	--	--	S B
<b>FEFOL-Z</b>	--	--	S B
<b>FEM</b>	--	--	N A C International
<b>FERGLOW</b>	--	--	Biochem
<b>FERINOVA</b>	--	--	Lupin Laboratories
<b>FERITAS</b>	--	--	Intas Laboratories
<b>FERIZEST</b>	--	--	D W D
<b>FEROSE</b>	--	--	C F L Pharma
<b>FEROLUV</b>	--	--	N E U foreva
<b>FERRO</b>	--	--	Intra Lab
<b>FERRODAN</b>	--	--	Dhana Pharma
<b>FERRUM-FOL</b>	--	--	Khandelwal

(xx) The distinguishing features between the appellant's and the respondents' product was thus tabulated:

<b>Subject</b>	<b>Femicontin</b>	<b>Fecontin-F</b>	<b>Remarks</b>
Application No	837309	518596	
Date of Application	18.01.1999	March 1993	
Class	05	05	
Organisation	Speciality	Modi Mundi	



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	Meditech Private Limited.	Pharmaceuticals Limited.	
Registered office	Situated at Jaipur	Situated at New Delhi	
Is it Schedule H drug	Yes	Yes	Both should be sold only on doctors Prescription.
Cures which disease	Haemitonic <sup>6</sup>	Haemitonic	
Is it a tablet or capsule	Capsules	Tablets	
Areas of operation	Rajasthan, Maharashtra, Himachal Pradesh, Haryana, Assam, Manipur, Madya Pradesh, Some Places of Uttar Pradesh	All over India	There is no sales in Andhra Pradesh and New Delhi
Rate of Tablets /Capsules for Strip	Cost of 10 Capsules is ₹ 24-00 only. (Variable)	Cost of 10 tablets is ₹ 51-05 only. (Variable)	The price of the Plaintiff Product is approximately doubles to the price of Defendant.
Colour of the Tablets	Ponceau 4R (Capsules)	Sun set yellow (Tablets)	Totally Different
Colour of Packing Box	Lite Saffron Colour	Ash Colour	Both are different
Similarities	Word Marks	Word Marks	Visually, Phonetically or Structurally Different.
Contents of Tablets	Dried Ferrous Sulphate I.P. - 200mg Zinc Sulphate	Ferrous Glycine Fumurate equivalent to 100mg Ferrous Iron and Folic Acid I.P - 0.5mg	Contents are different.

<sup>6</sup> Which increases haemoglobin and thereby treats anaemia



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	Monohydrate - 61.8mg., Cynocobalamin I.P 10mcg, Folic Acid - 1.5mg,		
Quotation mentioned on strip	Sustained Release System	Controlled Release System	There are no chances of getting confused.

(xxi) The appellant was also disentitled from seeking the reliefs that it had sought in the suit on the ground of acquiescence. It was well-settled that a person could not sit back and allow the use of a trademark by another over a period of time and belatedly seek an injunction against such use from the Court. CS (OS) 2176/2007, from which the present appeal emanates, was filed by the appellant nine months after CS (OS) 577/2005 was withdrawn. This amounted to acquiescence, by the appellant, to the use of the mark FEMICONTIN by the respondents, thereby disentitling it to any injunctive relief.

(xxii) The appellant's assertions, CS (OS) 2176/2007, that it had come to learn of the use, by the respondents, of the mark FEMICONTIN only in 2004, could not be believed, as the respondent's mark FEMICONTIN was appearing alongside the appellant's product FECONTIN-F in the Indian Drug Review journal since May 2002.

On the basis of the aforesaid assertions, Respondent 1 prayed that the suit be dismissed.



## 11. Written Statement of Respondent 2

Respondent 2, in its written statement, merely stated that it was only manufacturing the product FEMICONTIN for Respondent 1 and that such manufacture did not constitute “use” of the trademark FEMICONTIN for the purposes of the Trade Marks Act. Besides, the manufacture was only for a period November/December 2005 to September/October 2007, and was discontinued thereafter. Respondent 1, therefore, disclaimed all liability towards any infringement or passing off, as alleged by the appellant.

## 12. Replication by the appellant to Written Statement of Respondent 2

As the written statement of Respondent 2 was brief, the appellant, in its replication before the learned Single Judge, merely contended that Section 30<sup>7</sup> of the Trade Marks Act, which was impliedly invoked by

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<sup>7</sup> 30. **Limits on effect of registered trade mark. –**

- (1) Nothing in Section 29 shall be construed as preventing the use of a registered trade mark by any person for the purposes of identifying goods or services as those of the proprietor provided the use—
- (a) is in accordance with honest practices in industrial or commercial matters, and
  - (b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark.
- (2) A registered trade mark is not infringed where—
- (a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;
  - (b) a trade mark is registered subject to any conditions or limitations, the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market or in relation to services for use or available or acceptance in any place or country outside India or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend;
  - (c) the use by a person of a trade mark—
    - (i) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk or which they form part, the registered proprietor or the registered user



Respondent 2, was not applicable, as the case did not fall within any of the circumstances envisaged in the said Section. As such, the appellant submitted that the attempt of Respondent 2 to distance itself from the infringement and passing off which had taken place could not succeed.

### 13. Replication to Written Statement of Respondent 1

13.1 In response to the written statement of Respondent 1, the appellant submitted that, as the appellant possessed a registration for the mark CONTIN *per se*, the respondent was not permitted, in law, to use the mark CONTIN, either by itself or as part of any other mark, especially for pharmaceutical products. It was denied that the appellant could not claim exclusivity over the mark CONTIN.

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conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or

(ii) in relation to services to which the proprietor of such mark or of a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark;

(d) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services, as the case may be;

(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.

(3) Where the goods bearing a registered trade mark are lawfully acquired by a person, the sale of the goods in the market or otherwise dealing in those goods by that person or by a person claiming under or through him is not infringement of a trade by reason only of—

(a) the registered trade mark having been assigned by the registered proprietor to some other person, after the acquisition of those goods; or

(b) the goods having been put on the market under the registered trade mark by the proprietor or with his consent.

(4) Sub-section (3) shall not apply where there exists legitimate reasons for the proprietor to oppose further dealings in the goods in particular, where the condition of the goods, has been changed or impaired after they have been put on the market.



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CONTIN, it was submitted, was not a dictionary word but was coined and inventive in nature and was, therefore, entitled to the highest degree of trademark protection. In any event, as the mark CONTIN was registered in the appellant's favour, the appellant was entitled to claim exclusivity over use of the mark. While it was true that the appellant did not manufacture or sell any product under the mark CONTIN *per se*, CONTIN formed a common part of all the marks under which the appellant sold its products.

**13.2** The appellant denied the respondent's assertions that the ingredients of the appellant and respondent's products were different. It was further submitted that both products were aimed at treating the same ailments and, therefore, catered to the same consumer segment. The appellant submitted that, as the rival marks were used for pharmaceutical products, the Court was required to adopt a stricter approach, as an inalienable element of public interest was involved in ensuring that one drug was not mistaken for another.

**13.3** In this context, the appellant submitted that, even if the products were Schedule "H" Drugs and dispensable only against a medical practitioner's prescription, that was no guarantee against confusion. Inasmuch as CONTIN formed an essential part of the names of all the aforesaid products manufactured and sold by the appellant, the use of CONTIN as a part of the name of the respondents' product was obviously with an intent to create confusion in the market. As such, a clear case of passing off was made out.

**13.4** The appellant, therefore, reiterated the prayers in the plaint.



## Proceedings before the learned Single Judge

14. Respondent 2 stopped appearing in the proceedings before the learned Single Judge after 26 March 2010. After that date, Respondent 1 alone contested the suit.

### 15. Issues framed in the suit

The following issues were framed by the Court, for consideration:

- “1. Whether this court has no jurisdiction to try and entertain the present suit? OPD
2. Whether the present suit is liable to be dismissed on account of delay, laches and/or acquiescence? OPD
3. Whether the present suit is barred by virtue of Section 11 of the Code of Civil Procedure, 1908? OPD
4. Whether the plaintiff is the registered proprietor of the trade mark FECONTIN-F and the trade mark CONTIN/CONTIN family of trademarks in relation to its goods/services? OPP
5. Whether the defendants have infringed the registered trademarks FECONTIN-F and CONTIN of the plaintiff? OPP
6. Whether the use of the deceptively similar mark FEMICONTIN by the defendants amounts to passing off? OPP
7. Whether the plaintiff is entitled to permanent injunction as prayed for? OPP
8. Whether the plaintiff is entitled to damages as prayed for? OPP
9. Whether the plaintiff is entitled to delivery up of materials and rendition of accounts? OPP
10. Relief.”



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16. The appellant led the evidence only of Mr. Rajiv Behl in CS (Comm) 353/2018 as PW-1 and Respondent 1 led the evidence of its Director Prem Prakash Bhardwaj as DW-1.

### 17. The impugned judgment

17.1 As it transpires from a reading of the impugned judgment, the appellant and Respondent 1 reiterated, before the learned Single Judge, the contentions contained in their respective pleadings which have already been noted earlier in this judgment.

17.2 Dealing with the issues which arose before him, the learned Single Judge noted that Issues 1 and 3 were not pressed by Respondent 1 and were accordingly disposed of. Apropos the remaining issues, the learned Single Judge held as under:

### 17.3 Re. Issue 2

17.3.1 Issue 2 dealt with the objections of delay, laches and acquiescence, as raised by Respondent 1.

17.3.2 The learned Single Judge noted that there was a dispute regarding the year in which OS 33/2004 was filed by the appellant before the Hyderabad District Court. The appellant contended that OS 33/2004 had originally been filed in 2002 but was renumbered OS 33/2004 only because there was a change of the manufacturer who was manufacturing the infringing product, which necessitated an



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amendment. As against this, Respondent 1 contended that OS 33/2004 was filed only in 2004, as it referred to certain events on 2004 in paras 7 and 10, which read thus:

“7. In the month of January 2004, representative of the Plaintiff came across the defendant’s pharmaceutical product bearing the trademark FEMICONTIN relating to the same class of goods as that of the Plaintiff containing Dried Ferrous Sulphate I.P. 150 mg, Zinc Sulphate Monohydrate U.S.P. 61.8 mg, Cyanocobalamin I.P. 1.2 mcg, Folic Acid 1.2 mg with Vitamin B12 capsules. The said product is stated to be a sustained release capsules. Using the mark FEMICONTIN, amounts to infringement of the statutory trademark rights of the plaintiff and is likely to confuse the prospective buyers, who will associate the same as the product of the Plaintiff thereby passing off their product as those of the Plaintiff. The continued business of the defendants is pure infringement and is involving in the manufacture and marketing of the drug FEMICONTIN, which is causing untold loss of reputation to the plaintiff. Thus the plaintiff is compelled to institute the present proceedings.

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10. The cause of action in the present suit first arose in the month of January 2004 when it came to the attention of the Plaintiff that the defendants are manufacturing and marketing a sustained release capsules under the trademark FEMICONTIN. The defendants are continuing to infringe the trademark of the plaintiff. The cause of action is a continuous one and continues until such time as the Defendant is restrained by an order of injunction passed by this Hon’ble Court. (Emphasis Supplied)”

**17.3.3** As against this, the appellant sought to rely on certain documents appearing in the Evidence Folder in OS 33/2004 which bore a stamp of acknowledgement from the Ranga Reddy District and Sessions Court dated 30 October 2002.

**17.3.4** The learned Single Judge ruled that the documents in Evidence Folder IV B of OS 33/2004, on which the appellant sought to rely,



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could not be read as evidence, as the appellant had not produced any certified copy of OS 33/2004 as purportedly filed in 2002 or any other evidence of such filing, despite a specific issue to that effect having been framed in the present proceedings. The documents to which the appellant drew attention were registration certificates for its trade marks, and, according to the impugned judgment, they did not show with certainty that they were filed in OS 33/2004. The learned Single Judge, therefore, held that no cogent evidence of OS 33/2004 having been filed by the appellant before the Hyderabad District Court in 2002 had been produced by the appellant.

**17.3.5** In that view of the matter, the impugned judgment holds that, though the appellant had become aware of the use, by the respondents, of the allegedly infringing FEMICONTIN mark in 1999, a suit seeking an injunction thereagainst was first filed before the Hyderabad District Court only in 2004, after a delay of five years.

**17.3.6** The learned Single Judge, thereafter, proceeds to decide Issue 2, thus:

“53. In *Midas Hygiene P. Ltd.*<sup>8</sup>, the Supreme Court has held that mere delay in bringing action is not sufficient to defeat grant of an injunction. In *M/s Power Control Appliances & Ors*<sup>9</sup>, the Supreme Court has held that acquiescence is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with the claim for exclusive rights in a trade mark and it implies positive acts and not mere silence or inaction such as is involved in laches. Therefore, for delay and acquiescence, there has to be something more than a mere delay on part of the plaintiff. In order to support the plea of acquiescence, it must be demonstrated through the conduct of the plaintiff that the plaintiff stood by for a considerable period while the defendant

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<sup>8</sup> *Midas Hygiene Industries (P) Ltd v Sudhir Bhatia*, (2004) 3 SCC 90

<sup>9</sup> *Power Control Appliances v. Sumeet Machines (P) Ltd.*, (1994) 2 SCC 448



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expended money in building up its own business with the aid of a similar mark.

54. In the present case, the plaintiff has asserted that after discovery of the use of the impugned mark by the defendant in the year 1999, and the issuance of a legal notice, it was informed that the products with the impugned mark are not available in the market. It was only in 2001, that it again came to the knowledge of the plaintiff that the products with the impugned mark are available in the market. As noted hereinabove, there is a controversy whether the suit was thereafter filed in the year 2002 or 2004. However, be that as it may, even assuming that the suit was filed in the year 2004, it cannot be said that by its conduct, the plaintiff acquiesced to the use of the impugned mark by the defendant. In this regard, I must also note that apart from stating its sales and advertising figures in the affidavit of evidence of DW-1, the defendant no.2 has not placed any other document on record to show the user of the impugned mark between 1999 to 2005.

55. In view of the above, issue no.2 is decided in favour of the plaintiff and against the defendant no.2, holding that though there is a delay in filing of the suit, the suit is not liable to be dismissed on this account.”

**17.3.7** Thus, despite holding that OS 33/2004 was instituted before the Hyderabad District Court only in 2004, the learned Single Judge has held that the suit could not be dismissed solely on the ground of delay and has, therefore, decided Issue 2 in favour of the appellant.

#### **17.4** Re. Issues 4 to 7

**17.4.1** While dealing with Issues 4 to 7, the learned Single Judge, in para 58, commences the discussion thus:

“58. The plaintiff has been able to establish that it is the registered proprietor of the trade marks FECONTIN-F and CONTIN. It has also been able to establish its reputation in the mark FECONTIN-F, in fact, the same has not been denied by the defendant no.2.”



Thus, at the very commencement of the discussion on Issues 4 to 7, the learned Single Judge holds, in favour of the appellant, that it had succeeded in establishing its reputation in the mark FECONTIN-F, and that it was the registered proprietor of the trademarks FECONTIN-F and CONTIN.

#### 17.4.2 Re. claim of exclusivity over CONTIN as a suffix/prefix

**17.4.2.1** The learned Single Judge, thereafter, proceeds to deal with the claim of the appellant for exclusivity with respect to the mark CONTIN, thus:

“59. At the same time, though the plaintiff is the registered proprietor of the mark CONTIN, in spite of the specific assertion of the defendant no.2 that the said mark is not in use as no product with the said mark alone is available in the market, the plaintiff has led no evidence to the contrary. The only claim of the plaintiff is that it has a family of marks of which CONTIN is the dominant part. For CONTIN, the answer to Question No.11 given by Mr. Rajiv Behl is relevant. The same is reproduced as under:

“Q.11 Does the Plaintiff company manufacture or market any product named only as CONTIN?”

Ans. We do not manufacture any product under the brand name CONTIN however most of our products bear the CONTIN as a suffix in all trademarks.

I am not aware as to how and on what basis Mundipharma AG of Switzerland had adopted the trademark CONTIN. We are using CONTIN as suffix in relation to products with drug delivery system continus.”

60. The above is an admission of the fact that the registered trade mark CONTIN is not used by the plaintiff for its pharmaceutical products for which it is registered. In my opinion, even though CONTIN may be used as a prefix or suffix in a family of marks by the plaintiff, the same would not amount to use of the registered mark.



61. Section 47 (1) (b) of the Act states that a registered trade mark may be taken off the Register where it is shown inter alia that up to a date three months before the date of the application filed seeking its removal from the Register of trade marks, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark though registered was not bona fide used in relation to the goods and services for which it had been registered. Sub section (1) of Section 47 of the Act is reproduced herein below:-

**“47. Removal from register and imposition of limitations on ground of non-use. –**

(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the High Court by any person aggrieved on the ground either—

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application; or

(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

Provided that except where the applicant has been permitted under section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the Registrar of the High Court, as the case may be, is



of opinion that he might properly be permitted so to register such a trade mark, the Registrar of the High Court, as the case may be, may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to—

- (i) goods or services of the same description; or
- (ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered.”

62. Sub-Section (2)(c) of Section 2 of the Act states that the “use of a mark” in relation to goods shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods.

63. Therefore, use of the registered trade mark itself by the proprietor is essential. Use of a similar mark or a mark of which the registered mark is a part, cannot be the use of the registered mark itself.

64. Section 28 of the Act gives the exclusive right to the use of the trade mark in relation to the goods and services in respect of which it is registered to the proprietor, if such registration is valid.

65. In the present case, challenge to the mark CONTIN has been filed by the defendant no.2 and is pending adjudication. Notwithstanding the pendency of the same, in my opinion, the non-use of the mark would be of relevant consideration for determining the relief to be granted to the plaintiff on account of registration of the mark CONTIN in its favour.”

Thus, apropos the appellant’s claim to exclusivity for the mark CONTIN, the learned Single Judge has proceeded on the aspect of use of the mark CONTIN, by itself, by the appellant. The learned Single Judge notes that, though the appellant was the registered proprietor of



the mark CONTIN, it had never used CONTIN as a standalone mark for any product. This fact, it was noted, was also acknowledged by PW-1 in his response to Question 11 during cross examination.

**17.4.2.2** We may note that, even before us, the appellant does not seek to contend that it ever used CONTIN as a standalone mark for any of its products.

**17.4.2.3** The learned Single Judge holds that the use of CONTIN as a prefix or a suffix in the various trade marks employed by the appellant would not amount to use, by the appellant, of the registered trade mark CONTIN. It is thus that the learned Single Judge proceeds to examine the entitlement of the appellant to injunction against the use of CONTIN as a part of the respondents' trade mark, even though there was no standalone use of the mark CONTIN by the appellant.

**17.4.2.4** In this context, the learned Single Judge has referred to Section 47(1)(b)<sup>10</sup> in conjunction with Section 2(2)(c)<sup>11</sup> of the Trade

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<sup>10</sup> 47. **Removal from register and imposition of limitations on ground of non-use. –**

(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the High Court by any person aggrieved on the ground either—

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(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

Provided that except where the applicant has been permitted under Section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the Registrar or the High Court, as the case may be, is of opinion that he might properly be permitted so to register such a trade mark, the Registrar or the High Court, as the case may be, may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to—

(i) goods or services of the same description; or  
(ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered.

<sup>11</sup> (2) In this Act, unless the context otherwise requires, any reference—



Marks Act. These provisions, according to the learned Single Judge, render use of a registered trade mark by the proprietor essential for maintaining a claim of infringement. Use of a mark, of which the registered trade mark is a part, does not constitute use of the registered trade mark. In view of the right conferred by Section 28(1)<sup>12</sup> of the Trade Marks Act, for exclusive right to use a registered trade mark, the learned Single Judge holds that the fact that the registered trade mark is not used is a relevant consideration while examining the appellant's plea for injunction.

**17.4.2.5** Having so observed, the learned Single Judge, in para 66 of the judgment, proceeds to observe thus:

“66. I may herein clarify that the above observations are not to be considered relevant for the purposes of determining the claim of passing off that the plaintiff may have due to its family of marks wherein CONTIN forms a predominant part as a suffix or prefix. While the concept of family of marks may be relevant for purposes of determining a claim of passing off, it may not be of much assistance to the plaintiff for considering the claim of infringement of the registered trade mark. It is also not relevant for determining the claim of infringement or passing off due to registration of the mark FECONTIN-F in favour of the plaintiff. Claim of infringement would have to be separately considered for the two marks, that is, CONTIN and FECONTIN-F.”

Thus, in para 66, the learned Single Judge notes the fact of non-use by

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- (c) to the use of a mark,—
- (i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;
  - (ii) in relation to services, shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services;

<sup>12</sup> **28. Rights conferred by registration. —**

- (1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.



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the appellant, of CONTIN as a standalone mark, despite its registration in the appellant's favour, is not a relevant consideration while examining the appellant's plea for injunction on ground of passing off, predicated on the fact that it has a family of marks in all of which CONTIN is a predominant part either as a prefix or a suffix. Equally, the non-use, by the appellant, of CONTIN as a standalone mark has been acknowledged by the learned Single Judge as not being relevant while examining the appellant's claim for infringement predicted on the registration held by it of the mark FECONTIN-F.

**17.4.2.6** Resultantly, the learned Single Judge has, in the impugned judgment, opined that, whereas the appellant did not have a case of infringement, against the respondents, by virtue of the registration held by it in the mark CONTIN, the issues of whether a claim for infringement against the respondents would lie on the basis of the registration held by the appellant in the mark FECONTIN-F or whether a claim of passing off would lie against the respondents by virtue of the fact that CONTIN forms a pre-dominant part of the names of all the marks used by the appellant, still remained open for consideration.

**17.4.3** Re. claim of infringement *vis-à-vis* the FECONTIN-F trade mark of the appellant

**17.4.3.1** The learned Single Judge thereafter addresses the issue of whether the claim for infringement, against the respondents, would lie on the basis of the registration of the mark FECONTIN-F in favour of the appellant. This issue is covered by paras 67 to 88 of the impugned



judgment.

**17.4.3.2** Dealing with the plea of the appellant, against the respondents, of infringement, based on the registration of the trade mark FECONTIN-F in the appellant's favour, the learned Single Judge notes that the prefix "FE" and the suffix "CONTIN" in FECONTIN-F were both used in a descriptive sense.

**17.4.3.3** The prefix "FE", holds the learned Single Judge, indicated the presence of iron in the product. For this purpose, the learned Single Judge relies on the answer of PW-1 to Question 13 posed to him during cross examination. The question, and the response of PW-1 thereto, read thus:

"68. The witness of the plaintiff, that is, Mr.Rajiv Behl, PW-1, in answer to question No.13 has stated as under:

"Q.13 Are you aware as to what is the basis of naming the product in question as FECONTIN-F?"

Ans. FE relates to iron and CONTIN is our registered trademark and F is related to ferrous and ingredients of the product."

**17.4.3.4** Apropos the suffix "CONTIN", the learned Single Judge similarly relies on the response of PW-1 to Questions 11 and 12 put to him during cross-examination thus:

"69. For CONTIN, answers to Question No.11 as also Question No.12 given by Mr.Rajiv Behl are relevant. The same reproduced as under:

"Q.11 Does the Plaintiff company manufacture or market any product named only as CONTIN?"



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Ans. We do not manufacture any product under the brand name CONTIN however most of our products bear the CONTIN as a suffix in all trademarks.

I am not aware as to how and on what basis Mundipharma AG of Switzerland had adopted the trademark CONTIN. We are using CONTIN as suffix in relation to products with drug delivery system continus.”

“Q.12 What is the meaning of the expression “drug delivery system continus”?”

Ans. Continus Drug Delivery means the drug will have continuous effect in the body for a longer duration”  
(Emphasis supplied)

**17.4.3.5** The learned Single Judge therefore holds that “FE” in FECONTIN-F relates to iron, which is an ingredient of the product and “CONTIN” indicates that the product has a Continuous Drug Delivery system. *Even while recognising that a mark is not to be bifurcated into parts to examine whether it is descriptive*, the learned Single Judge holds that if a part of the mark is descriptive, the proprietor cannot be permitted a monopoly over that part. Equally, while examining the aspect of deceptive similarity *vis-a-vis* the rival marks, the descriptive part of plaintiff’s mark is liable to be accorded less weightage. Para 71 of the impugned judgment, which records these findings, reads as under:

“71. Therefore, “FE” relates to iron, which is an ingredient of the plaintiff’s product, while CONTIN is being used in relation to the products with Continuous Drug Delivery system, that is where the drug will have a continuous effect in the body for a longer duration. Though, it is correct that for determining whether a mark is descriptive or suggestive in nature, the mark is not to be bifurcated into parts, at the same time, it is also to be seen that the part which is descriptive is not allowed to be monopolised by any person. For determining whether the complained mark is deceptively similar to the other mark, the descriptive parts of such



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mark may have to be given less weightage.

**17.4.3.6** The learned Single Judge thereafter proceeds to refer to the decisions of Division Benches of this Court in *Marico Ltd v Agro Tech Foods Ltd*<sup>13</sup>, *Schering Corporation v Alkem Laboratories Ltd*<sup>14</sup> and *Sun Pharmaceutical Laboratories Ltd v Hetero Healthcare Ltd*<sup>15</sup>. Based on these decisions, the learned Single Judge proceeds to hold, on the aspect of whether the appellant could claim exclusivity over the mark FECONTIN, and its individual parts thus, in paras 75 to 77 of the impugned order:

“75. Applying the above ratios, in the present case, the word FECONTIN-F is clearly descriptive of the pharmaceutical product itself. It is suggestive of iron released for a continuous period in the body. The plaintiff’s product is Ferrous Glycine Sulphate equivalent to 100mg Ferrous Iron and Folic Acid I.P. 0.5mg tablets. PW1- Shri Rajiv Behl, in his cross examination states as under:-

“The medicine FECONTIN-F is an iron supplement and is used by female patients normally during pregnancy.”

76. The mark is therefore, descriptive of the product. The plaintiff cannot claim any exclusive right over the same.

77. Though a combination of two descriptive words may still be entitled to protection, the plaintiff cannot deny the use of such descriptive parts by a third party or claim exclusive right to use the same. The defendant no. 2 has explained the reason for adoption of its mark in the following words:-

“The Defendant No.2 submits that both the rivals marks in the suit are not similar at all. It is pertinent to mention that it is a very common phenomenon in the Pharmaceutical Industry to club the nature of disease and medicinal compound to coin a Trademark which will enable the medical practitioners and doctors to remember the particular names of the medicine very easily. The

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<sup>13</sup> (2010) 169 DLT 325

<sup>14</sup> (2009) 165 DLT 474

<sup>15</sup> 2022 SCC OnLine Del 2580



Defendant No.2 humbly submits before this Hon'ble Court as to how the Trademark "FEMICONTIN" has been coined by them. The letters „FE' are derived from Ferrous Fumarate, which is an ingredient of the drug. The medicine contained in the Trademark is useful for the pregnant women and hence the word "FEMI" is derived by adding letters "MI" to "FE", which indicates "Female". The word "CONTIN" is derived from the dictionary word "CONTINUES" which means to go on happening or moving. Here, in total, the Trademark "FEMICONTIN" means and indicates a drug which releases iron continuously in a sustained release manner into the body of a pregnant woman to avoid normal side effects and it improves the quality of blood by increasing RBC. That is why the Defendant No.2 has adopted "FEMICONTIN" as their Trademark. It is further submitted that the Defendant No.2 does not have any ill intention or any other reason to adopt the Trademark "FEMICONTIN". It is coined with honest and bonafide intention.”

Interestingly, in the opening sentence of para 75 reproduced *supra*, the learned Single Judge holds, apropos the mark FECONTIN-F, first that it is descriptive and, later, that it is suggestive. We may note, even at this juncture, that while descriptive marks cannot be registered, suggestive marks can<sup>16</sup>; an aspect with which we would deal in greater detail hereinafter.

**17.4.3.7** The learned Single Judge relies on the evidence of PW-1, in cross examination, to the effect that FECONTIN-F is an iron supplement, normally used during pregnancy, as a ground to hold that the mark FECONTIN-F was descriptive of the product and that, therefore, the appellant could not claim any exclusivity over the mark.

**17.4.3.8** Thereafter, in para 77, the learned Single Judge correctly

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<sup>16</sup> Refer T.V. Venugopal v Ushodaya Enterprises Ltd, (2011) 4 SCC 85



observes, at the outset, that a combination of two descriptive words may still be entitled to protection, but immediate follows this observation by a finding that a plaintiff cannot deny the use of such descriptive part by a third party or claim any exclusivity in respect thereof. Thereafter, the learned Single Judge has accepted the explanation adduced by the respondents for using the mark FEMICONTIN, to which reference is already contained in para 17.4.3.5 *supra*. Accepting the said explanation, the learned Single Judge holds that the adoption of the mark FEMICONTIN by Respondent 2 was bonafide.

**17.4.3.9** Following this, in para 79, the learned Single Judge merely returns the following finding, with respect to visual and phonetic similarity of the rival marks:

“79. In the present case, the two marks, in my view, are also not deceptively similar, either visually or phonetically.”

**17.4.3.10** Re. plea of estoppel based on Notice of Opposition filed by Respondent 2 before the Registrar of Trade Marks<sup>17</sup>, opposing appellant’s application for registration of the mark FECONTIN

The learned Single Judge, thereafter, addresses in paras 80 to 85, a contention, advanced by the appellant, to the effect that Respondent 1 having, while opposing the application of the appellant for registration of the mark FECONTIN, contended that the mark FECONTIN was not entitled to registration as it was deceptively similar to the mark FEMICONTIN, was estopped from contending otherwise in the present proceedings. Apropos this submission of the appellant, the



learned Single Judge holds that the Notice of Opposition filed by Respondent 1 before the Registrar of Trade Marks, opposing the appellant's application for registration of the mark FECONTIN, could not be taken into consideration, as it had not been brought on record after obtaining permission of the court and could not, therefore, be confronted to the respondents' witness. The plea of estoppel, raised by the appellant, against Respondent 1, has, therefore, been rejected on this ground.

#### 17.4.4 Requirement of actual confusion

Thereafter, in paras 86 to 89, the learned Single Judge holds thus:

“86. Returning back to the discussion on whether the two marks are deceptively similar to each other, I must also herein note that the plaintiff has also not led any evidence on any confusion being caused by the simultaneous use of the marks of the plaintiff and the defendant no.2, though the suit itself has been pending for more than 15 years.

87. In answer to Question no.25, Mr.Rajiv Behl, PW-1 stated as under:

“Q.25 Have you received any complaint or can you quote a specific instance where a doctor may have misspelt the brand and a chemist had sold the drug in question without prescription?

Ans. No. However field staff has informed about the confusion because of the presence of the product under the trademark.”

88. The plaintiff produced no other witness. Even the alleged information received by it from “field staff” has neither been filed nor proved.

89. For purposes of passing off, it is to be seen whether there is

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<sup>17</sup> “ROTM” hereinafter



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any likelihood of confusion in the mind of an unwary consumer with imperfect recollection due to the use of the two marks. In the present case, the plaintiff has failed to prove any confusion being caused by the use of the mark of the defendant no. 2.”

The learned Single Judge, therefore, has also taken adverse notice of the fact that no evidence of actual confusion, by the use of the mark FEMICONTIN by the respondents, has been produced by the appellant. The plea of infringement, as advanced by the appellant, has, therefore, been rejected.

#### **17.4.5** Re. passing off

On the aspect of passing off, the learned Single Judge has restricted his finding to para 89, which reads thus:

“89. For purposes of passing off, it is to be seen whether there is any likelihood of confusion in the mind of an unwary consumer with imperfect recollection due to the use of the two marks. In the present case, the plaintiff has failed to prove any confusion being caused by the use of the mark of the defendant no. 2.”

**17.4.6** Following the aforesaid, the learned Single Judge has decided Issues 4 to 7 against the appellant and in favour of Respondent 1.

#### **17.5** Re: Issues 8 to 10

In view of the findings returned by him, with respect to Issues 4 to 7, the learned Single Judge has decided Issues 8 to 10 in favour of Respondent 1 and against the appellant.

**17.6** Accordingly, the learned Single Judge has dismissed the



appellant's suit.

18. Aggrieved thereby, the appellant has approached this Court by means of the present appeal.

### **Rival stands of learned Counsel before this Court**

#### **19. Submissions of Mr. Pravin Anand**

19.1 Mr. Pravin Anand, learned Counsel appearing for the appellant, submitted that, as the proprietor of the CONTIN family of marks, the appellant was entitled to an injunction against all other persons using CONTIN as a prefix or a suffix or as any other part of their mark, in respect of pharmaceutical products. He disputes the finding of the learned Single Judge that the adoption of the mark FEMICONTIN, by the respondents, was *bona fide*. He submits that the commonality of the FE prefix and CONTIN suffix between the appellant's and the respondents' marks cannot be mere coincidence and are indicative of a dishonest attempt, on the respondents' part, to mislead consumers into mistaking the respondents' product for the appellants.

19.2 Mr. Pravin Anand submits that the classical triple identity test is satisfied in the present case, as the appellant and respondent's marks are practically identical, the product serve the same purpose and treat the same ailments and, therefore, cater to the same consumer segments and are available through the same trade channels. Besides, he submits that even the composition of the appellant's and respondent's products are the same. In such circumstances, Mr. Anand submits that the fact



that the appellant's and respondents' product may be Schedule H drugs, or that there may be a difference in their prices, cannot mitigate the likelihood of confusion. He relies, for this purpose, on paras 22 and 26 to 33 of the Judgment of the Supreme Court in *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd*<sup>18</sup>, which read thus:

“22. It may here be noticed that Schedule ‘H’ drugs are those which can be sold by the chemist only on the prescription of the doctor but Schedule ‘L’ drugs are not sold across the counter but are sold only to the hospitals and clinics. Nevertheless, it is not uncommon that because of lack of competence or otherwise, mistakes can arise specially where the trade marks are deceptively similar. In *Blansett Pharmaceuticals Co. v Carmick Laboratories Inc.*<sup>19</sup> it was held as under:

“Confusion and mistake is likely, even for prescription drugs prescribed by doctors and dispensed by pharmacists, where these similar goods are marketed under marks which look alike and sound alike.”

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26. It was further submitted on behalf of the appellant that although the possibility of confusion in a drug being sold across the counter may be higher, the fact that a drug is sold under prescription or only to physicians cannot by itself be considered a sufficient protection against confusion. The physicians and pharmacists are trained people yet they are not infallible and in medicines, there can be no provisions for mistake since even a possibility of mistake may prove to be fatal.

27. As far as the present case is concerned, although both the drugs are sold under prescription but this fact alone is not sufficient to prevent confusion which is otherwise likely to occur. In view of the varying infrastructure for supervision of physicians and pharmacists of medical profession in our country due to linguistic, urban, semi-urban and rural divide across the country and with high degree of possibility of even accidental negligence, strict measures to prevent any confusion arising from similarity of marks among medicines are required to be taken.

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<sup>18</sup> (2001) 5 SCC 73

<sup>19</sup> 25 USPQ 2nd, 1473 (TTAB 1993)



28. Here it will be useful to refer to the decision of *Morgenstern Chemical Co. case* where it has been held as under:

“(5) In the field of medical products, it is particularly important that great care be taken to prevent any possibility of confusion in the use of trade marks. The test as to whether or not there is confusing similarity in these products even if prescribed and dispensed only by professionally trained individuals does not hinge on whether or not the medicines are designed for similar ailments. The rule enunciated by Judge Helen in *Cole Chemical Co. v Cole Laboratories*<sup>20</sup> is applicable here:

‘The plaintiff and the defendant are engaged in the sale of medical preparations. They are for ultimate human consumption or use. ... They are particularly all for ailments of the human body. Confusion in such products can have serious consequences for the patient. Confusion in medicines must be avoided.

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Prevention of confusion and mistakes in medicines is too vital to be trifled with.’

The observations made by Assistant Commissioner Leeds of the Patent Office in *R.J. Strassenburgh Co. v Kenwood Laboratories, Inc.*<sup>21</sup> are particularly apt, that:

‘Physicians are not immune from confusion or mistake. Furthermore it is common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently handwriting is not unmistakably legible. These facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced.’

The defendant concedes that physicians and pharmacists are not infallible but urges that the members of these professions are carefully trained to detect difference in the characteristics of pharmaceutical products. While this is

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<sup>20</sup> DC Mo 1954, 118 F Supp 612, 616, 617, 101, USPQ 44, 47, 48

<sup>21</sup> 106 USPQ 379 (1955)



doubtless true to dos (*sic*) not open the door to the adoption by manufacturers of medicines of trade marks or names which would be confusingly similar to anyone not exercising such great care. For physicians and pharmacists are human and in common with the rest of mankind are subject to human frailties. In the field of medicinal remedies the courts may not speculate as to whether there is a probability of confusion between similar names. If there is any possibility of such confusion in the case of medicines public policy requires that the use of the confusingly similar name be enjoined (see *Lambert Pharmacol Ltd. v Bolton Chemical Corpn.*<sup>22</sup> ).”

29. In the book titled as McCarthy on Trade Marks, it is observed in the footnote at pp. 23-70 as under:

“Physicians and pharmacists are knowledgeable in their fields does not mean they are equally knowledgeable as to marks and immune from mistaking one mark from another.” (*Schering Corpn. v Alza Corpn.*<sup>23</sup>)

30. In the case of *Syntex Laboratories Inc. v Norwich Pharmacal Co.*<sup>24</sup> it is observed as under:

“Stricter standard in order to prevent likelihood of confusion is desirable where involved trade marks are applied to different prescribed pharmaceutical products and where confusion could result in physical harm to the consuming public.”

31. Trade mark is essentially adopted to advertise one's product and to make it known to the purchaser. It attempts to portray the nature and, if possible, the quality of the product and over a period of time the mark may become popular. It is usually at that stage that other people are tempted to pass off their products as that of the original owner of the mark. That is why it is said that in a passing-off action, the plaintiff's right is

“against the conduct of the defendant which leads to or is intended or calculated to lead to deception. Passing-off is said to be a species of unfair trade competition or of actionable unfair trading by which one person, through deception, attempts to obtain an economic benefit of the reputation which another has established for himself in a particular trade or

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<sup>22</sup> DCNY 1915, 219 F 325.326

<sup>23</sup> 207 USPQ 504 (TTAB 1980)

<sup>24</sup> 169 USPQ 1 (2nd Cir 1971)



business. The action is regarded as an action for deceit”.  
[See *Wander Ltd. v Antox India (P) Ltd.*<sup>25</sup>]

32. Public interest would support lesser degree of proof showing confusing similarity in the case of trade mark 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 support from McCarthy on Trade Marks, 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 medical products such as surgical sutures and clavicle splints.”

33. The decisions of English courts would be relevant in a country where literacy is high and the marks used are in the language which the purchaser can understand. While English cases may be relevant in understanding the essential features of trade mark law but when we are dealing with the sale of consumer items in India, you have to see and bear in mind the difference in situation between England and India. Can English principles apply in their entirety in India with no regard to Indian conditions? We think not. In a country like India where there is no single common language, a large percentage of population is illiterate and a small fraction of people know English, then to apply the principles of English law regarding dissimilarity of the marks or the customer knowing about the distinguishing characteristics of the plaintiff's goods seems to overlook the ground realities in India. While

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<sup>25</sup> 1990 Supp SCC 727



examining such cases in India, what has to be kept in mind is the purchaser of such goods in India who may have absolutely no knowledge of English language or of the language in which the trade mark is written and to whom different words with slight difference in spellings may sound phonetically the same. While dealing with cases relating to passing off, one of the important tests which has to be applied in each case is whether the misrepresentation made by the defendant is of such a nature as is likely to cause an ordinary consumer to confuse one product for another due to similarity of marks and other surrounding factors. What is likely to cause confusion would vary from case to case. However, the appellants are right in contending that where medicinal products are involved, the test to be applied for adjudging the violation of trade mark law may not be on a par with cases involving non-medicinal products. A stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by the consumer. While confusion in the case of non-medicinal products may only cause economic loss to the plaintiff, confusion between the two medicinal products may have disastrous effects on health and in some cases life itself. Stringent measures should be adopted specially where medicines are the medicines of last resort as any confusion in such medicines may be fatal or could have disastrous effects. The confusion as to the identity of the product itself could have dire effects on the public health.””

**19.3** Inasmuch as the marks of the appellant and the rival marks are practically identical, Mr. Anand submits that the present case attracts Section 29(2)(c)<sup>26</sup> read with Section 29(3)<sup>27</sup> of the Trade Marks Act, and there would be a presumption of likelihood of confusion.

**19.4** Mr. Anand further submits that the learned Single Judge is at error in holding that the mark CONTIN, or even FEMICONTIN, is

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<sup>26</sup> (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.

<sup>27</sup> (3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to



descriptive or *publici juris*. He submits that CONTIN is a coined word, which is not to be found in any dictionary and has no etymological meaning. He further submits that there is no evidence, either led by the respondents or relied upon by the learned Single Judge, on the basis of which it could be said that CONTIN or FECONTIN are common to the trade. He relies, for this purpose, on para 88 of the Judgment of the Division Bench of this Court in *Shree Nath Heritage Liquor Pvt Ltd v Allied Blender & Distillers Pvt Ltd*<sup>28</sup>, thus:

“88. The fact that a mark is common to the trademarks register may not mean that it is common to the trade. Furthermore, for an argument common to the trade to succeed, evidence of extensive use of the mark in question needs to be shown. The appellant has relied on copies of a few third party labels, none of which uses the mark ‘Officer’. In the present case, the word ‘Officer’ is not common to the register and there is no evidence to show that it is common to the trade. For the above stated reasons, the decision reported as *Schering Corporation v. Alkem Laboratories Ltd.*<sup>29</sup>, cited by learned senior counsel for the appellant is inapplicable to the present case.”

**19.5** In the same context, Mr. Anand further submits that, having itself applied for registration of the mark FEMICONTIN, Respondent 1 was estopped from contending that the mark FECONTIN was ineligible for registration as it comprised of parts which were common to the trade or descriptive. Apropos the submission that CONTIN was a descriptive suffix, Mr. Anand further points out that CONTIN was not an abbreviation either of any of the constituents of the appellant’s product or of the ailment that the product sought to treat.

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cause confusion on the part of the public.

<sup>28</sup> 2015 SCC OnLine Del 10164

<sup>29</sup> 2010 (42) PTC 772 (Del)



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**19.6** With respect to the appellant's claim to exclusivity over CONTIN, as any part of the mark of pharmaceutical products manufactured by any other person, Mr. Anand submits that the learned Single Judge has materially erred in failing to appreciate the concept of a family of marks, which stands settled, *inter alia*, by the judgment of this Court in *Amar Singh Chawalwala v Shree Vardhaman Rice & General Mills*<sup>30</sup>. As the registered proprietor of the CONTIN family of marks, Mr. Anand submits that the appellant is entitled to maintain an action for infringement against every person who uses CONTIN as part of the name of his pharmaceutical preparation and is entitled to an injunction against such use. He submits that the learned Single Judge has, in order to sustain his finding that the CONTIN was common to the trade, relied only on three marks, none of which would justify such a finding. Mr. Anand submits, therefore, that the learned Single Judge was in error in refusing to grant an injunction, to the appellant, against the use, by any other person, of CONTIN as a part of its trademark, given the fact that the appellant was the registered proprietor of the CONTIN family of marks.

**19.7** Mr. Anand further points out that, while the marks CONTIN and FECONTIN-F were both registered in Class 5, in favour of the appellant, on 19 October 1989, the respondents have no registration of any mark in their favour.

**19.8** Adverting, next, to the appellant's claim for injunction based on its registered FECONTIN-F trademark, Mr. Anand submits that the learned Single Judge was in error in bifurcating the mark into "FE"

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<sup>30</sup> 160 (2009) DLT 267 (DB)



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and “CONTIN” and, by holding that “FE” was an abbreviation for Iron and “CONTIN” was descriptive of the product, proceeding to reject the appellant’s claim by treating the entire mark as descriptive in nature. The learned Single Judge, he submits, was also in error in holding that a combination of a generic and a descriptive mark was not entitled to monopoly, even though he submits that neither could the “FE” prefix be treated as generic nor could the “CONTIN” suffix be treated as descriptive. He points out that the learned Single Judge himself has noticed that a combination of two dictionary words is also entitled to protection. As such, Mr. Anand submits that the learned Single Judge is in manifest error in holding that the mark FECONTIN was either descriptive, or generic, or a combination of a generic and descriptive marks and, therefore, not entitled to protection against infringement.

**19.9** Apropos the aspect of infringement itself, Mr. Anand submits that the marks FEMICONTIN and FECONTIN-F are practically identical, the only difference between the two being the intermediate “MI” syllable between “FE” and “CONTIN”. The marks are, therefore, nearly identical, used for products which cater to the same consumer segment and are available through the same trade channels, thereby satisfying the triple identity test of infringement. Mr. Anand points out that, as the marks are used for pharmaceutical products, a lower threshold is required to be satisfied for a case of infringement to be made out and cites, in this context, the judgment of the Supreme Court in *Cadila Pharmaceuticals*.

**19.10** Mr. Anand further submits that the learned Single Judge was in



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error in relying on the fact that no proof of actual confusion had been led by the appellant. He submits that actual confusion is not required to be shown for a case of infringement or passing off to be made out and that all is required to be seen is whether there is a likelihood of confusion. A comparison of the two marks and of the packages on which the marks are used, he submits, clearly indicates that there is manifest likelihood of confusion between them.

**19.11** Mr. Anand finally submits that the learned Single Judge is also in error in holding that the appellant has acquiesced to the use of the FEMICONTIN mark by the respondents. He submits that the appellant had come to know of the use of the mark by the respondents in 1999 and immediately issued a cease and desist notice to the respondents. From 1999 to 2001, there was no market usage of the mark FEMICONTIN by the respondents. On coming to learn, in 2001, that the mark was being used in the market, the appellant immediately approached the District Court in Hyderabad by way of OS 33/2004. Consequent on the District Court at Ranga Reddy permitting the appellant to withdraw the said suit, the appellant immediately approached this Court by means of CS (OS) 577/2005 and, after withdrawing the said suit, filed the present suit in 2007. It was, therefore, submitted that there were no delay or laches on the part of the appellant, nor could it be said that the appellant had acquiesced to the use of the impugned FEMICONTIN mark by the respondents. In any event, relying on the judgment of the Supreme Court in *Midas Hygiene Industries*, Mr. Anand submits that delay and laches are no impediment to grant of injunction, where infringement is found to exist.



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## **20. Submissions of Mr Gagan Gupta**

**20.1** Responding to the submissions of Mr. Anand, Mr. Gagan Gupta, learned Senior Counsel for Respondent 1, first submits that the appellant's suit was barred by both delay and laches as well as acquiescence. He submits that, having found that the appellant was guilty of delay and laches in initially approaching the District Court at Hyderabad and, thereafter, filing the present suit before this Court in 2007, the learned Single Judge was in error in rejecting the respondent's objection of delay and laches and in deciding Issue 2 in favour of the appellant and against the respondents. He presses, in this context, the cross-objections filed by the respondents in the present appeal, whereby the respondents have challenged the impugned judgment to the extent it has decided Issue 2 in favour of the appellant. He submits that OS 33/2004, initially instituted by the appellant before the Hyderabad District Court, as well as the present suit which was instituted as CS(OS) 2176/2007 before this Court, are both hit by delay and laches and ought to have been dismissed even on that sole ground.

**20.2** For the same reason, Mr. Gupta submits that the appellant is guilty of acquiescence, as it has allowed the respondent to continue to use the impugned FEMICONTIN mark and acquired a reputation by such usage over a period of time. In such circumstances, he submits that no injunction can be granted in favour of the appellant or against the respondents.



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**20.3** Mr. Gupta submits that the marks CONTIN and FECONTIN are neither inventive nor innovative in nature. CONTIN, he submits, is a mere abbreviation of “CONTINUOUS”, which depicts the mode and manner of action in the human body. The prefix “FE” is purely generic, and is an abbreviation for Iron, the chemical name of which is “Ferrum”. He submits that the learned Single Judge is correct in his finding that the Court cannot grant a monopoly, to the appellant, over a mark which is merely a combination of a generic prefix and a descriptive suffix. He relies, in this context, on Section 17 of the Trade Marks Act.

**20.4** Besides, submits Mr. Gupta, the mark FEMICONTIN is descriptive of the product manufactured by the respondents. There can be no injunction against the use of a descriptive mark, in view of Section 35 of the Trade Marks Act.

**20.5** Having obtained a trademark registration for the mark CONTIN, Mr. Gupta points out that the appellant has, in fact, never used CONTIN as its registered trademark for any product. As such, the appellant cannot maintain an action, before the Court, with a prayer that no one should be allowed to use CONTIN as a part of its trademark in respect of any products. Equally, the appellant cannot seek a monopoly over the use of CONTIN, either as a prefix or as a suffix. The case of infringement and passing off, that the appellant had sought to make out had, therefore, to be tested only *vis-a-vis* the registered FECONTIN-F mark of the appellant, and not *vis-a-vis* its CONTIN registered trademark.



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**20.6** The rival marks, according to Mr. Gupta, are not deceptively similar either visually, structurally or phonetically. Besides, the products are Schedule H drugs, which could be sold only on the prescription of a registered medical practitioner. Registered medical practitioners are classically supposed to know their job and, therefore, there was no likelihood of confusion. He points out that, in fact, no evidence was led by the appellant to indicate that the use of the mark FEMICONTIN by the respondents had ever resulted in confusion in the market.

**20.7** In conclusion, Mr. Gupta submits that it is common practice, in the pharmaceutical trade, for manufacturers to name their products on the basis of the constituents or ingredients of the products or the ailments that they seek to treat. Equally, manufacturers routinely combined these elements while naming the products, for ease of dispensation to the ailing public. The marks FECONTIN-F and FEMICOTNIN are both marks which are combinations of the ingredients of the product, the patients for whom they are intended, and the mode and mechanism of their action. There cannot, therefore, be a claim of exclusivity with respect to such marks.

**20.8** Mr. Gupta, therefore, submits that the appeal is without bereft of merit and that the impugned judgment of the learned Single Judge, being unexceptionable on facts and in law, deserves to be upheld in its entirety.

## **Analysis**



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21. This is a Regular First Appeal. Order XLI Rule 31<sup>31</sup> of the Code of Civil Procedure, 1908<sup>32</sup> requires the Court to state (a) the points for determination, (b) the decision thereon, (c) the reasons for the decision and (d) in the event that the impugned judgment and decree is appealed or varied, the relief to which the appellant would be entitled. The Supreme Court has held, in *Malluru Mallappa v Kuruvathappa*<sup>33</sup>, that appellate orders are required to conform to Order XLI Rule 31 of the CPC and one of us (C. Hari Shankar, J.), sitting singly, has reiterated this proposition in *Kailash Devi v Tej Pal*<sup>34</sup>, relying on the aforesaid judgment of the Supreme Court.

22. Accordingly, following the discipline of Order XLI Rule 31 of the CPC, this Court identifies the points that arise for determination in the present case, as

- (i) whether the appellant is disentitled to relief on the ground of delay and laches,
- (ii) whether the appellant has succeeded in making out a case of infringement, against the respondents, on the ground that it is the registered proprietor of the CONTIN family of marks,
- (iii) whether the appellant has succeeded in making out a case of infringement, by the respondents, of the registered FECONTIN-F trademark of the appellant,

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<sup>31</sup> 31. **Contents, date and signature of judgment.** – The judgment of the Appellate Court shall be in writing and shall state—

- (a) the points for determination;
- (b) the decision thereon;
- (c) the reasons for the decision; and
- (d) where the decree appealed from is reversed or varied, the relief to which the appellant is entitled;

and shall at the time that it is pronounced be signed and dated by the Judge or by the Judges concurring therein.

<sup>32</sup> “CPC” hereinafter

<sup>33</sup> (2020) 4 SCC 313

<sup>34</sup> 2022 SCC OnLine Del 3756



- (iv) whether the appellant has succeeded in making out a case of passing off, by the respondents, of their products as the product of the appellant,
- (v) the relief to which the appellant would be entitled, if any, and
- (vi) the extent to which each of the respondents would be liable in that regard, if at all.

23. We proceed, therefore, to address each of these issues *seriatim*.

24. Re. Issue (i) – delay and laches

24.1 This aspect is relevant only insofar as the cross objections, preferred by Respondent 1 in the present appeal, are concerned. The learned Single Judge has decided Issue 2, which dealt with the respondents' objection of delay and laches, in favour of the appellant. Even while holding that the appellant was guilty of delay and laches, the learned Single Judge has held that the suit cannot be dismissed on that ground and has relied, for that purpose, on the judgment of the Supreme Court in *Midas Hygiene Industries*. While the appellant has traversed the finding of the learned Single Judge that it was guilty of delay and laches, Respondent 1 has preferred cross-objections, challenging the decision of the learned Single Judge on Issue 2, inasmuch as it has decided the said issue in favour of the appellant. In its cross-objections, Respondent 1 contends that, as the suit instituted by the appellant was barred by delay and laches, the appellant was not entitled to the prayers contained in the said suit. The suit, therefore, ought to have been dismissed even on the ground of delay and laches.



**24.2** It is obvious that the cross-objections are misconceived. The learned Single Judge is correct in his view that, even if the aspect of delay and laches were to be held on facts against the appellant, the suit could, nonetheless, not be dismissed, in view of the judgment of the Supreme Court in *Midas Hygiene*, from which the following paragraph is relevant:

“5. The law on the subject is well settled. In cases of infringement either of trade mark or of copyright, normally an injunction must follow. *Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases.* The grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was itself dishonest.”

(Emphasis supplied)

The Supreme Court has, therefore, clarified that, in the case of infringement of the trademark, an injunction must follow, even if there is delay on the part of the plaintiff in bringing the action. The Supreme Court has further observed the fact that the defendant has acted dishonestly provides an additional reason for grant of an injunction in such cases. However, even if no dishonesty could be imputed to the defendant, and the infringement of the appellant’s trademark may be wholly innocent, para 5 of *Midas Hygiene* is clear in its mandate that an injunction has to be granted. Delay on the plaintiff’s part is irrelevant in such cases.

**24.3** That said, as the discussion hereinafter would reveal, in the present case, the respondents have acted dishonestly, so that the requirement of grant of injunction stands accentuated.



24.4 The decision in *Midas Hygiene* has been followed by a Division Bench of this Court of which one of us (C. Hari Shankar, J.) was a member, in *Mex Switch Gears Pvt Ltd v Omex Cables Industries*<sup>35</sup>, para 44 of which read thus:

44. In any case, delay if any, is not fatal in a case of infringement inasmuch as in every infringement of the registered trademark is a recurring cause of action. We may extract the extensive enunciation of law on the subject which was discussed in para 24 of *Max Switchgears Pvt Ltd v Max Switchgears Pvt. Ltd.*, which reads as follows:

“e) In the case of *Midas Hygiene Industries Pvt. Ltd. v Sudhir Bhatia*, relevant para-5 of the said judgment is as under:

“5. The law on the subject is well settled. In cases of infringement either of Trade Mark or of Copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the Mark was itself dishonest.”

f) In the case of *Swarn Singh v Usha Industries (India)*<sup>36</sup>, it was held as under:

“There is then the question of delay. Learned counsel for the respondents had urged that the delay is fatal to the grant of an injunction. We are not so satisfied. A delay in the matter of seeking an injunction may be a ground for refusing an injunction in certain circumstances. In the present case, we are dealing with a statutory right based on the provisions of the trade and Merchandise Marks Act, 1958. An exclusive right is granted by the registration to the holder of a registered trade mark. We do not think statutory rights can be lost by delay. The effect of a registered mark is so clearly defined in the statute as to be not capable of being misunderstood. Even if there is some delay, the

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<sup>35</sup> 2018 SCC OnLine Del 10412

<sup>36</sup> AIR 1986 Del 343 (DB)



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exclusive right cannot be lost. The registered mark cannot be reduced to a nullity”

g) In the case of *Hindustan Pencils Pvt. Ltd. v India Stationery Products Co.*<sup>37</sup>, it was held as under:

“..... It was observed by Romer, J. in the matter of an application brought by *J.R. Parkinson and Co. Ltd.*<sup>38</sup>, at page 181 that “in my judgment, the circumstances which attend the adoption of a trade mark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user. If the user in its inception was tainted it would be difficult in most cases to purify it subsequently”. It was further noted by the learned Judge in that case that he could not regard the discreditable origin of the user as cleansed by the subsequent history.”

h) In the case of *Bengal Waterproof Lim. v Bombay Waterproof Manufacturing Co.*<sup>39</sup>, it was held as under:

“20. It is now well settled that an action for passing off is a common law remedy being an action in substance of deceit under the Law of Torts. Wherever and whenever fresh deceitful act is committed the person deceived would naturally have afresh cause of action in his favour. Thus every time when a person passes off his goods as those of another he commits the act of such deceit. Similarly whenever and wherever a person commits breach of a registered trade mark of another he commits a recurring act of breach or infringement of such trade mark giving a recurring and fresh cause of action at each time of such infringement to the party aggrieved. It is difficult to agree how in such a case when in historical past earlier suit was disposed of as technically not maintainable in absence of proper relief, for all times to come in future defendant of such a suit should be armed with a license to go on committing fresh acts of infringement and passing off with impunity without being subjected to any legal action against such future acts.”

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<sup>37</sup> AIR 1990 Del 19

<sup>38</sup> (1946) 63 RPC 171

<sup>39</sup> (1997) 1 SCC 99



**24.5** We may also refer, in this context, to a decision of a Division Bench of the High Court of Calcutta in *Amar Nath Chakroborty v Dutta Bucket Industries*<sup>40</sup>, specifically to the following passages from the said decision:

21. Although, Mr. Banerjee appearing on behalf of the respondent assiduously tried to convince us that suit having been filed after a long time there should not be any injunction, we are not at all impressed by such submission. In this connection reference may be made to the decision of the Supreme Court in the case of *Midas Hygiene Industries (Pvt.) Ltd. v Sudhir Bhatia*, reported in where the Apex Court has held that once allegation of passing off is established, delay is immaterial for considering the case of injunction. In the case of *Power Control Appliances v Sumeet Machines Pvt. Ltd.*<sup>41</sup>, relied upon by Mr. Banerjee, it was held that acquiescence is one of the defences available under section 30(1)(b) of the 1958 Act. According to the Apex Court, acquiescence is sitting by, when another is invading right and spending money on it. It implies positive act; not merely silence or inaction as is involved in laches. According to the Supreme Court, the acquiescence must be such as to lead to the inference of a licence sufficient to create a new right in favour of a defendant. In this case, the defendant has not produced any material showing positive act on the part of the plaintiff consenting to grant of licence in favour of the defendant.

22. As indicated above, once the charge of passing off has been prima facie proved, in our view, the delay is immaterial unless it is shown that there is definite proof of acquiescence of the plaintiff. Such material has not been placed before the learned Trial Judge by the defendant. We, thus, find that this is a fit case where the plaintiff is entitled to get an order of temporary injunction restraining the defendant from using trade mark “MAJ” till the disposal of the suit.

**24.6** Para 21 of *Amar Nath Chakroborty* also, incidentally, answers the plea of acquiescence, raised by Mr. Gupta, as we would have occasion to observe presently.

**24.7** Thus, in view of the law enunciated in *Midas Hygiene*, and

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<sup>40</sup> 2005 SCC OnLine Cal 156

<sup>41</sup> 1994 (2) SCC 448



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followed in *Mex Switchgears* and *Amar Nath Chakroborty* among others, the aspect of delay and laches, on the part of the appellant, in bringing the action before the Court, loses much of its steam. Even if the Court were to hold that the appellant was guilty of delay and laches to the some extent, that would nonetheless not inhibit, in any manner, the appellant's right to injunction, where infringement was found to have taken place.

**24.8** That said, even on facts, we are of the opinion that the appellant cannot be said to be guilty of delay or laches. The learned Single Judge has noted, in para 49 of the impugned judgment, that there were certain documents, on the record of OS 33/2004, as originally filed in the Hyderabad District Court, bearing the stamp of acknowledgement from the Office of the District and Sessions Judge, Ranga Reddy District, dated 30 October 2002. The learned Single Judge observes that the documents in question were the registration certificates of the trademarks and that there was no certain indication that they had been filed in OS 33/2004. We are unable to subscribe to this finding. If the documents bore the stamp of acknowledgement, from the Office of the District and Sessions Judge, Ranga Reddy, dated 30 October 2002, it stands to reason that OS 33/2004, had, in fact, been originally filed before the Hyderabad District Court in 2002. These documents, it must be noted, were not being produced for the first time before the learned Single Judge in the present suit, but constituted part of the original OS 33/2004, as instituted before the Hyderabad District Court. The impugned judgment does not record any contention, raised by the respondents, questioning the veracity of the stamp of acknowledgement dated 30 October 2002, from the Office of the



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Ranga Reddy District and Sessions Judge as it figured on some of the documents. In that view of the matter, we are of the opinion that the learned Single Judge was not factually correct in his finding that there was no indication that OS 33/2004 had originally been filed in the Ranga Reddy District Court in 2002.

**24.9** Besides, the learned Single Judge has also erred in failing to note the communications exchanged between the appellant and its Counsel between 2002 and 2004, which were also part of the record before the learned Single Judge. We may reproduce the said communications, chronologically, thus:

Email dated 16 November 2002

Dear Hari,

Could you confirm the status of this. Thanks,

Neel

Email dated 18 November 2002

From: nunepally harinath reddy  
(nharinathreddy@rediffmail.com)  
Sent: Monday, November 18, 2002 4:41 PM  
To: Neel Mason  
Subject: Re: FW: Eubiotics

Dear Neel,

The matter has come up today, the court has asked us to produce the sample of the defendants drug. I shall procure it and produce it in the court the matter shall again come up on Friday.

regards,

Hari

Email dated 18 November 2002



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From: Neel Mason (Neel@AnandAndAnand.com)  
To: anuragseth@winmedicare.com  
Sent: Monday, November 18, 2002 4:44 PM  
Subject: FW: FW: Eubiotics

Dear Mr. Seth,

I am enclosing the report in the Hyderabad matter.

Warm regards,

Neel Mason

Email dated 29 December 2002

From: nunepally harinath reddy  
(nharinathreddy@rediffmail.com)  
Sent: Sunday, December 29, 2002 2:27 PM  
To: Neel Mason  
Subject: Re: FW: Eubiotics

Dear Neel,

sorry Neel, could not respond on 24th Dec, I was travelling. well, the hearing could not take place, as the summons were returned with an endorsement ADDRESSEE NOT TRACABLE.

I feel the defendant has shifted the operations, I am trying to ascertain the address from the Registrar of Companies and then shall file fresh summons on the new address.

regards,  
Hari

Email dated 30 December 2002

From: Neel Mason (Neel@AnandAndAnand.com)  
To: anuragseth@winmedicare.com  
Co: secretarial@winmedicare.com  
Sent: Monday, December 30, 2002 12:14 PM  
Subject: Eubiotics Hyderabad

Dear Mr. Seth,

I am enclosing the email of Harinath Reddy, the counsel representing you in Hyderabad.

Would you be in a position to help him with a fresh address.

Warm regards,



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Neel Mason  
Anand And Anand Advocates  
B-41, Nizamuddin East  
New Delhi-110013  
India

Tel Nos. # 91 11 24350360, 24355076, 24358078,  
Fax Nos. #91 11 24354243, 24353060, 24352090  
Email : [neel@anandandanand.com](mailto:neel@anandandanand.com)

Email dated 30 January 2003

Dear Hari,

Have you had any luck on following up with the new address of the Defendant.

If not could you advise whether we can move an application for substituted service in this matter under Order 5 Rule 20.

Thank you,

Warm regards,

Neel Mason  
Anand And Anand Advocates  
B-41, Nizamuddin East  
New Delhi-110013  
India

Tel Nos. # 91 11 24350360, 24355076, 24358078,  
Fax Nos. #91 11 24354243, 24353060, 24352090  
Email : [neel@anandandanand.com](mailto:neel@anandandanand.com)”

Email dated 30 January 2003

From: Neel Mason ([Neel@AnandAndAnand.com](mailto:Neel@AnandAndAnand.com))  
To: ([anuragseth@winmedicare.com](mailto:anuragseth@winmedicare.com))  
Cc: ([secretarial@winmedicare.com](mailto:secretarial@winmedicare.com))  
Sent: Thursday, January 30, 2003 3:00 PM  
Subject: FW: Eubiotics matter

Dear Mr. Seth,

I am enclosing the response of the counsel representing you in Hyderabad.



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The only way now to serve is by publication and he is taking steps accordingly.

Warm regards,  
Neel Mason  
Anand And Anand Advocates  
B-41, Nizamuddin East  
New Delhi-110013  
India

Tel Nos. # 91 11 24350360, 24355076, 24358078,  
Fax Nos. #91 11 24354243, 24353060,24352090  
Email neel@anandandanand.com

Email dated 30 January 2003

From: nunepally harinath reddy  
(nharinathreddy@rediffmail.com)  
Sent: Thursday, January 30, 2003 3:06 PM  
To: Neel Mason  
Subject: Re: Eubiotics matter

Dear Neel,

No luck so far, the address available in the Registrar is also the same one and the records are not updated. I shall request the court to permit us to carry out paper publication. I shall revert back with the latest.

regards,  
Hari

Email dated 30 January 2003

From: Anurag Seth (anungseth@winmedicare.com)  
Sent: Thursday, January 30, 2003 3:33 PM  
To: Neel Mason  
Subject: Re: Eubiotics matter

Dear Neel,

Please wait for the publication as our field force is taking steps to find out the correct address and locate the people. In case they fail then we may move further to publish



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Regards

Anurag Seth

Email dated 30 January 2003

From: Neel Mason (Neel@AnandAndAnand.com)  
To: Anurag Seth (anuragseth@winmedicare.com)  
Sent: Thursday, January 30, 2003 4:09 PM  
Subject: RE: Eubiotics matter

I spoke to Hari who stated that he will await instructions before taking any steps. He also stated that usually in the District court they await a couple times for summons to be returned unserved before permitting publication and hence it is unlikely that we can take steps for publication before another month or so.

Warm regards,

Neel Mason  
Anand And Anand Advocates  
B-41, Nizamuddin East  
New Delhi-110013  
India

Tel Nos. # 91 11 24350360, 24355076, 24358078,  
Fax Nos. #91 11 24354243, 24353060, 24352090  
Email : neel@anandandanand.com

Email dated 23 July 2003

From: Anurag Seth (anuragseth@winmedicare.com)  
Sent: Wednesday, July 23, 2003 2:04 PM  
To: Neel Mason  
Subject: RE: Amendment in Proceedings: Eubiotics: Hyderabad

Dear Neel,

What happened in the below mentioned matter. this was to come on 16.06.2003.

Anurag Seth  
Modi-Mundipharma Pvt. Ltd.

Email dated 23 July 2003

From: Neel Mason (Neel@AnandAndAnand.com)



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Sent: Wednesday, July 23, 2003 2:23 PM  
To: 'anuragseth@winmedicare.com'  
Subject: RE: Amendment in Proceedings : Eubiotics : Hyderabad

Dear Mr. Seth,

I just spoke to Harinath Reddy in Hyderabad who informs me that fresh summons has been issue for the 4th of August 2003 as the Defendants remain unserved.

Warm regards,

Neel Mason  
Anand and Anand  
D-41, Nizamuddin East  
New Delhi-110013  
India

Tel Nos. # 91 11 24350360, 24355076, 24358078,  
Fax Nos. # 91 11 24354243, 24353060,24352090  
Email :Neel@AnandAndAnand.com

Email dated 18 August 2003

From: Anurag Seth (anuragseth@winmedicare.com)  
Sent: Monday, August 18, 2003 9:58 AM  
To: Neel Mason  
Subject: RE: Amendment in Proceedings: Eubiotics:  
Hyderabad

Dear Neel,

Any news from Harinath Reddy. The matter was listed for 4th August?

Regards

Anurag Seth  
Modi-Mundipharma Pvt. Ltd.  
Company Secretary & D.G.M. (Legal)  
Ph: (M) 9810294516  
(0) 011-26421384 (Direct)  
(0) 011-26286581 to 5 (Indirect)

Email dated 20 August 2003

Dear Hari,



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Could you give me an update on what happened on the 4th of August.

Thanks,  
Neel Mason  
Anand and Anand  
B-41, Nizamuddin East  
New Delhi-110013  
India

Tel Nos. 91 11 24350360, 24355076, 24358078,  
Fax Nos. 91 11 24354243, 24353060, 24352090  
Email :Neel@AnandAndAnand.com”

Email dated 20 August 2003

From: nunepally harinath reddy (nharinathreddy@rediffmail.com)  
Sent: Wednesday, August 20, 2003 6:07 PM  
To: Neel Mason  
Subject: Re: Eubiotics matter

HI Neel,

Extremely sorry for the delay, in reporting. The matter has not shown any development, the summons have again returned unserved. Fresh summons have been filed into the court. The matter has been adjourned to 22.11.2003.

I shall report back with some development by then.

rgds,  
Hari

Email dated 20 August 2003

From: Neel Mason [Neel@AnandAndAnand.com]  
Sent: Wednesday, August 20, 2003 6:57 PM  
To: anuragseth@winmedicare.com  
Subject: Eubiotics matter

Dear Mr. Seth,

I am enclosing the letter of Harinath Reddy, the counsel representing Win Medicare against Eubiotics.

Warm regards,

Neel Mason  
Anand and Anand  
B-41, Nizamuddin East



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New Delhi-110013  
India

Tel Nos. 91 11 24350360, 24355076, 24358078,  
Fax Nos. 91 11 24354243, 24353060, 24352090  
Email :Neel@AnandAndAnand.com

Email dated 18 November 2003

From: Hari Advocate (nharinathreddy@rediffmail.com)  
Sent: Tuesday, November 18, 2003 4:30 PM  
To: Neel Mason  
Cc: 'secretarial@winmedicare.com';  
'anuragseth@winmedicare.com'  
Subject: Re: Modi Mundipharma vs. Eubiotics Pharma & Anr.

Dear Neel,

Point taken I shall do the needful.

Rgds,

Email dated 19 November 2003

From: Anurag Seth (anuragseth @winmedicare.com)  
Sent: Wednesday, November 19, 2003 10:50 AM  
To: Hari Advocate  
Cc: Neel Mason  
Subject: RE: Modi Mundipharma vs. Eubiotics Pharma & Anr.

Dear Mr. Hari,

Mr. Neel Mason must have provided you the new address of Eubiotics with its changed name immediately after the last hearing when we were informed that summons could not be served as the party no more exists at the given address. We hope the prs summons were served on the party at new address. For your immediate reference we are once again appending here below text of the mall sent to Mr Nee Mason:

As discussed, we are giving below the address of the manufacturer and marketing Company of product FEMICONTIN:

Manufactured by : Stanbiotech Pvt. Ltd.  
Plot No. 6/3, Road No. 11,  
IDA, Nacharam,  
Hyderabad-500 076



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Marketed by :                   Speciality Meditech Pvt. Ltd.  
7-61, Bapuji Nagar, Main Road,  
Nacharam,  
Hyderabad-500 076

Please note that manufacturer's name has changed from Eubiotics Pharmaceuticals, 6-4/1/1, Savarkar Nagar, Nacharam, Hyderabad-600 076-to Stanbiotech Pvt. Ltd. at the address mentioned above. The product sample of FEMICONTIN has been purchased by us from Madhur Medical Agencies, Nangal Road, UNA-174 303 (H.P.) which is being sent to you by hand alongwith original Bill.

We request you that if this time also the summons are not served please try and take an early date with orders for dasti as we need to press this matter and expedite the court proceedings otherwise the whole purpose of filing the cases is going to be forfeited.

Regards

Anurag Seth  
Modi-Mundipharma Pvt. Ltd.  
Company Secretary & D.G.M. (Legal)  
(M) 9810294516  
(O) 011-26421384 (Direct)  
(O) 011-26286581 to 5 (Indirect)

Email dated 15 December 2003

From: Hari Advocate (nharinathreddy@rediffmail.com)  
Sent: Monday, December 15, 2003 11:46 AM  
To: Anurag Seth  
Subject: Re: RE: Modi Mundipharma vs. Eubiotics Pharma & Anr.

Dear Mr Seth,

The matter had come up on 12.12.2003. the court ordered personal summons on the defendant to be carried by special messenger of court and posted the matter to 29.12.2003. I have entrusted the job of ensuring the service of

Email dated 30 December 2003

From: Hari Advocate (nharinathreddy@rediffmail.com)  
Sent: Tuesday, December 30, 2003 2:50 PM  
To: Anirag Seth  
Cc: Neel Mason  
Subject: Re: RE: RE: Modi Mundipharma vs. Eubiotics Pharma & Anr.



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Dear Mr. Seth,

some of the Trade Marks matters have been transferred to the fast track court of Ranga Reddy District Court, the matters shall be renumbered after they are allotted to the fast track court. I shall get the number next week latest by 5th or 6th and I shall move an urgent application before the Fast Track Court.

Regards,

Hari

Email dated 30 December 2004

Dear Mr. Hari.

Please advise what happened in the matter yesterday, any success??

Regards

Anurag Seth.  
Modi-Mundipharma Pvt. Ltd.  
Company Secretary & D.G.M. (Legal)  
Ph: (M) 9810294516  
(O) 011-26421384,55504536 (Direct)  
(O) 011-55504555 Ext. 4536 (Indirect)

**24.10** The afore-extracted communications also indicate that OS 33/2004 had initially been filed before the Ranga Reddy District Court in 2002. This sequence of communications had been brought on record by PW-1 and were part of the record before the learned Single Judge.

**24.11** No question was put to PW-1, in his cross-examination, with respect to the aforesaid documents.

**24.12** We may note, in this context, that the aforesaid communications between the appellant and its Counsel were only marked by the



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learned District Court, and not exhibited, for the sole reason that Mr. Anurag Seth, who was the author of the emails, had not been produced. They were, nonetheless, tendered in evidence by PW-1, and it remains a matter of record that, in his cross-examination, no questions were put to him with respect to said communications.

**24.13** In view of the aforesaid evidence, we are of the opinion that the conclusion of the learned Single Judge, in para 52 of the impugned judgment, that there was delay of almost five years in the appellant moving the Ranga Reddy District Court, cannot sustain.

**24.14** Even otherwise, as we have already held, delay and laches on a plaintiff's part cannot disentitle a plaintiff to injunction, where infringement is found to have taken place.

**24.15** Resultantly, the cross-objections of Respondent 1, which are limited to the findings of the learned Single Judge on Issue 2 as framed in the suit, have necessarily to be rejected.

**24.16** The ultimate finding of learned Single Judge on Issue 2, which is to the effect that CS (OS) 2176/2007, later re-numbered CS (Comm) 353/2018, could not have been dismissed on the ground of delay and laches, deserves to be affirmed. At the same time, the observations of the learned Single Judge that the appellant was in fact guilty of delay and laches in approaching the Court is also, to our view, unsustainable.

**25.** Re: Issue (ii) – Infringement vis-à-vis the “CONTIN family of



marks” of the plaintiff

## **25.1 Relevant statutory provisions**

**25.1.1** Before dealing with the aspect of infringement, it would be worthwhile to advert to certain provisions of the Trade Marks Act, which deal with infringement, the right to relief against infringement, and the exceptions to each.

**25.1.2** Infringement is defined in Section 29 of the Trade Marks Act, specifically in sub-sections (1) to (5), (7) and (8)<sup>42</sup> thereof. In each case, infringement can only be of a registered trade mark. Registration of the plaintiff’s trade mark is, therefore, mandatory for the plaintiff to be entitled to institute an action for infringement.

**25.1.3** Section 29(1) generally treats, as infringement, use, in the course of trade, by the defendant, of a mark which is identical with, or deceptively similar to, the plaintiff’s registered trade mark, in relation to the goods or services in respect of which the trademark is registered in the plaintiff’s favour, in such a manner as to render the use likely to be taken as a trademark. Section 29(1) would apply, therefore, only where the use of the infringing trademark by the defendant is in relation to the goods or services in respect of which the trademark is registered in favour of the plaintiff.

**25.1.4** Section 29(2) which is the provision which most commonly applies, envisages three situations in which infringement can be said

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to have taken place.

**25.1.5** Section 29(2)(a) applies where the rival marks are identical, but the goods or services in respect of which they are used are not identical, but similar. Section 29(2)(b) applies where the rival marks are not identical, but only similar, and the goods or services in respect of which they are used are either identical or similar. Section 29(2)(c) applies where the rival marks are identical, and are used in relation to identical goods or services. In each of these situations, where the nature of the rival marks, and the nature of the goods or services, in respect of which they are used, is likely to cause confusion on the part of the public or a presumption of an association between the plaintiff and the defendant, infringement is said to have taken place.

**25.1.6** Thus, for infringement to have taken place within the meaning of Section 29(2), three factors must be found to co-exist. There must be (i) identity or similarity of the rival marks, (ii) identity or similarity of the goods or services in respect of which the rival marks are used, and (iii) *resultant* likelihood of confusion or of association between the two marks in the minds of the public.

**25.1.7** Section 29(3) caters to a situation in which Section 29(2)(c) applies, i.e., where the rival marks, as well as the goods or services in respect of which the rival marks are used, are identical. In such a circumstance, Section 29(3) ordains that likelihood of confusion in the minds of the public would be presumed.

**25.1.8** Section 29(4) applies in a situation where three circumstances,



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envisaged in clauses (a) to (c) of the sub-section, are simultaneously present. Clause (a) requires the rival marks to be identical or similar, clause (b) requires that the goods or services in respect of which the rival marks are used are not similar and clause (c) requires the plaintiff's marks to have a reputation in India and the use, by the defendant, of the impugned mark to be without due cause and to result in unfair advantage of, or be detrimental to, the distinctive character and repute of the plaintiff's registered trademark. Thus, Section 29(4) would apply where there is no similarity or identity between the goods and services in respect of which the rival marks are used; in other words, it would cater to a situation which does not fall within any of the three clauses (a) to (c) of Section 29(2). Even in such a case, if the plaintiff's mark is reputed, and the use of the defendant's mark without due cause results in unfair advantage or detriment to the plaintiff's mark, a case of infringement would be made out.

**25.1.9** Section 29(5) applies where the rival marks are identical. For the provision to apply, the defendant must use the plaintiff's registered trademark as the defendant's trade name, part of the defendant's trade name or business concerned or part thereof, in relation to the goods or services in respect of which the trademark is registered in favour of the plaintiff. This, therefore, is a simple case of poaching of a registered trademark, where one person misuses the registered trademark of another, in respect of the goods or services for which the mark is registered, as part of his own trade name or business concern.

**25.1.10** Section 29(7) deals with use of a registered trademark, labelling or packaging material, as a business paper or for advertising



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goods or services, by a defendant who was aware of the fact that such use was not permissible.

**25.1.11** Section 29(8) explains the circumstances in which infringement by advertising of a registered trademark can be said to have taken place.

**25.1.12** Section 29(9) clarifies that infringement need not always be in writing or by visual representation, but could also be by spoken use of the words which constitute part of the infringed trademark.

**25.1.13** We may straight away note, here, that the only subsection of Section 29, which applies in the present case, is Section 29(2). Even in Section 29(2), though Mr. Anand has sought to contend that clause (c) would apply, the contention cannot be accepted, as clause (c) applies only where the rival marks are identical. Any difference between the rival marks, howsoever infinitesimal, would exclude the applicability of Section 29(2)(c). In the present case, the appellant's mark is FECONTIN-F and the respondent's mark is FEMICONTIN. They are not identical. Section 29(2)(c), therefore, does not apply and Mr. Anand's contention that it does, has necessarily to be rejected.

**25.1.14** Equally, as Section 29(2)(c) does not apply, Section 29(3) is also inapplicable.

**25.1.15** The definition of infringement in Section 29 of the Trade Marks Act is not absolute. The Trade Marks Act itself provides for



exceptions to the definition. Where the exceptions apply, no infringement can be said to have taken place, even if all the ingredients of one or more of the various sub-sections of Section 29 are found to exist in a given case.

**25.1.16** Section 30(1) and (2)<sup>43</sup> set out, expressly, circumstances in which infringement cannot be said to take place even if the ingredients of one or more of the sub-sections of Section 29 are found to exist.

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<sup>43</sup> **30. Limits on effect of registered trade mark. –**

(1) Nothing in Section 29 shall be construed as preventing the use of a registered trade mark by any person for the purposes of identifying goods or services as those of the proprietor provided the use—

- (a) is in accordance with honest practices in industrial or commercial matters, and
- (b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark.

(2) A registered trade mark is not infringed where—

(a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;

(b) a trade mark is registered subject to any conditions or limitations, the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market or in relation to services for use or available or acceptance in any place or country outside India or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend;

(c) the use by a person of a trade mark—

(i) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk or which they form part, the registered proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or

(ii) in relation to services to which the proprietor of such mark or of a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark;

(d) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services, as the case may be;

(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.



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**25.1.17** Though Section 30(2) is expressly stated as enumerating circumstances in which a registered trademark is not infringed, Section 30(1) also sets out, in its clauses, additional circumstance in which infringement cannot be said to have taken place. The provisions of Section 30 stand reproduced in the footnote to this judgment, and, for our purposes, it is only necessary to refer to Section 30(1) and Section 30(2)(a).

**25.1.18** Section 30(1) excludes the applicability of Section 29 where the defendant uses the allegedly infringing trademark for identifying the goods or services as those of the proprietor of the trademark, provided the use by the defendant is in accordance with honest industrial and commercial practice and does not take unfair advantage of, and is not detrimental to, the character and repute of the plaintiff's trademark.

**25.1.19** Section 30(2)(a) excludes, from the ambit of infringement, use, by a defendant, of the registered trademark of the plaintiff, where such use indicates the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services or other characteristics of the goods or services. It is this group of circumstances, envisaged in Section 30(2)(a) which are popularly characterised as “descriptive” use of the impugned mark. Where, therefore, the impugned mark of the defendant describes the characteristics of the goods or services of the defendant, it cannot be said to be infringing, even if the ingredients of one or more of the sub-sections of Section 29, *vis-a-vis* the plaintiff's



registered trademark, are satisfied.

**25.1.20** Section 28(1)<sup>44</sup> of the Trade Marks Act entitles the registered proprietor of a trademark not only to the right to exclusive use of the registered trademark, but also to relief in respect of infringement of the trademark. If, therefore, a registered trademark is infringed, within the meaning of Section 29, and none of the exceptions contained in Section 30 apply, the proprietor of the registered trademark is entitled, in the event that the registered trademark is infringed, to relief against infringement.

**25.1.21** Section 135(1)<sup>45</sup> of the Trade Marks Act deals with the reliefs available in the case of infringement. Among these include injunction, damages, rendition of accounts and delivery up of the infringing labels and marks. As in the case of infringement, there are also exceptions, in the Trade Marks Act, to the right of the proprietor of a registered trademark to obtain relief against infringement. In other words, the proprietor of a registered trademark would, in a case in which one or more of the exceptions in the Trade Marks Act is found to apply, not be entitled to relief against infringement, even where infringement is found to have taken place.

**25.1.22** These exceptions are to be found in Section 30(1),

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<sup>44</sup> 28. **Rights conferred by registration.** –

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

<sup>45</sup> 135. **Relief in suits for infringement or for passing off.** –

(1) The relief which a court may grant in any suit for infringement or for passing off referred to in Section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order



33(1)<sup>46</sup>, 34 and 35<sup>47</sup>. Of these, the only provisions with which we need be concerned are Section 30(1)(a), 33(1) and 35.

**25.1.23** We have already dealt with Section 30(1)(a). Section 33 applies where the plaintiff, as the proprietor of the allegedly infringed earlier trademark, acquiesces to the use of *the registered trademark of the defendant*, for a period of five years. In such a situation, the plaintiff cannot seek an injunction against the use, by the defendant, of its registered trademark in relation to the goods or services in respect of which it shall be used, unless the registration was not applied for in good faith. Thus, *the principle of acquiescence statutorily applies only where the defendant's trademark is registered, and not where the impugned trademark of the defendant is unregistered.*

**25.1.24** Section 35 prohibits grant of an injunction against *bona fide* use, by a defendant, of his own name, his place of business, the name or place of business of his predecessors or of any *bona fide* description of the character or quality of the respondent of his goods or services. This, again, is one of the grounds on which a defence of “descriptive use” is at times raised, as a bulwark against an injunction, even where infringement may otherwise be found to exist.

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for the delivery-up of the infringing labels and marks for destruction or erasure.

<sup>46</sup> 33. **Effect of acquiescence.** –

(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark—

(a) to apply for a declaration that the registration of the later trade mark is invalid,  
or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was not applied in good faith.

<sup>47</sup> 35. **Saving for use of name, address or description of goods or services.** – Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any *bona fide* use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any *bona fide* description of the



**25.2** Having thus adverted to the various provisions in the Trade Marks Act which deal with infringement, the right to injunction, and the statutory exceptions in that regard, we may now proceed to examine the appellant's claim of infringement, as well as his consequent prayer for injunction, *vis-a-vis* the registration held by the appellant of the marks CONTIN and FECONTIN-F, *seriatim*.

**25.3** Issue (ii), as framed by us in para 22, *supra* as arising for consideration, deals with the appellant's claim of infringement, by the impugned FEMICONTIN mark of the respondents, of the CONTIN family of marks of the appellant.

**25.4** The appellant is the registered proprietor of the mark CONTIN, in respect of which it holds a registration dating back to 19 October 1989 in Class 5. Section 28(1) of the Trade Marks Act, therefore, entitles the appellant, as of right, to relief against infringement, by way of injunction, against the use of the mark CONTIN by any third party, in respect of pharmaceutical products or any allied or cognate goods or services.

**25.5** The appellant does not, however, seek an injunction against the use of the mark CONTIN *per se* by any other person. Nor has the appellant claimed to ever have used the mark CONTIN *per se* in respect of any goods or services, though it holds a registration for the mark CONTIN under the Trade Marks Act.



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**25.6** What the appellant seeks is an injunction against any third party using CONTIN *as a part of any trademark, whether as a prefix or a suffix*, in respect of goods falling in Class 5 or which may be allied or cognate thereto.

**25.7** For this purpose, the appellant invokes the concept of a “family of marks”. The appellant claims to be the registered proprietor of the CONTIN family of marks and, by virtue thereof, to be entitled to exclusivity over the use of CONTIN as a prefix or a suffix in any trademark by any third party for goods covered by Class 5 or which are allied or cognate thereto.

**25.8** The learned Single Judge has rejected this plea on two grounds.

**25.9** Aspect of non-use of CONTIN as a standalone mark by the appellant

**25.9.1** The first ground on which the learned Single Judge has rejected the appellant’s prayer for an injunction against any third party using CONTIN as a part of any trade mark for pharmaceutical products, is that there has been no use, by the appellant, of the mark CONTIN *per se*, despite the appellant being the registered proprietor of the said mark, at any point of time. Use of the registered trademark, according to the learned Single Judge, is necessary for an action against infringement of the said mark to be sustainable in law. For this purpose, the learned Single Judge relies on Section 47(1)(b)<sup>48</sup> read

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<sup>48</sup> 47. **Removal from register and imposition of limitations on ground of non-use.** –

(1) A registered trade mark may be taken off the register in respect of the goods or services in



with Section 2(2)(c)<sup>49</sup> of the Trade Marks Act. The learned Single Judge also adverts to Section 28(1) of the Trade Marks Act, in this context.

**25.9.2** To our mind, the reliance, by the learned Single Judge, on Section 47(1)(b) of the Trade Marks Act is misguided.

**25.9.3** Section 47 deals with the right of one person to apply to the Registrar of Trade Marks to have the trade mark of another person taken off the register. Continuous non-use of a registered mark, upto a period of three months prior to the application, is the ground on which Section 47 (1)(b) permits the removal of the registered trade mark, from the Trade Marks register, to be sought by the applicant.

**25.9.4** Section 47 is not an exception either to Section 29 of the Trade Marks Act, which defines infringement, or to Section 28(1) read with Section 135 which entitles the proprietor of a registered trade mark to an injunction against an infringer of such a registered trade mark. It is, no doubt, open to the infringer, as it is to everyone else, to apply to the Registrar of Trade Marks for taking off the registered trade mark from

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respect of which it is registered on application made in the prescribed manner to the Registrar or the High Court by any person aggrieved on the ground either—

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(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

<sup>49</sup> (2) In this Act, unless the context otherwise requires, any reference—

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(c) to the use of a mark,—

(i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;

(ii) in relation to services, shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services;



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the Trade Mark register and, for that reason, to cite five years' non-use of the registered trade mark as a ground for seeking cancellation. *So long as this is not done, and the registered trade mark remains on the register, however, infringement of the registered trade mark is impermissible and, if infringement takes place, the right of the proprietor of the registered trade mark to relief against infringement is statutorily guaranteed.*

**25.9.5** The Court cannot refuse to grant relief where it finds infringement on the ground that the defendant could possibly, if it so chose, institute proceedings for cancellation of the asserted mark of the plaintiff under Section 47(1). Nor can the Court presume the outcome of such proceedings, even if they were instituted. So long as they are not instituted, the registration of the asserted mark of the plaintiff has to be accorded due respect.

**25.9.6** The Trade Marks Act, we may note, significantly differs from the Designs Act, 2000 and the Patents Act, 1970, in this respect. Section 22(3)<sup>50</sup> of the Designs Act, and Section 107(1)<sup>51</sup> of the Patents Act, envisage any ground on which the asserted design, or patent, of the plaintiff, is vulnerable to invalidation, or revocation, as being available as a defence against a claim of infringement. There is no such provision in the Trade Marks Act.

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<sup>50</sup> (3) In any suit or any other proceeding for relief under sub-section (2), every ground on which the registration of a design may be cancelled under Section 19 shall be available as a ground of defence.

<sup>51</sup> **107. Defences, etc. in suits for infringement.** –

(1) In any suit for infringement of a patent, every ground on which it may be revoked under Section 64 shall be available as a ground for defence.



**25.9.7** Inasmuch as these are cognate statutes protecting infringement of intellectual property, it must be presumed that the legislature, in not providing, in the Trade Marks Act, any provision analogous to Section 22(3) of the Trade Marks Act or Section 107(1) of the Patents Act, did so consciously. The legislative mandate has to be respected.

**25.9.8** Ergo, howsoever fragile the validity of a registered trade mark may seem, so long as it remains on the register, the right against infringement, available under Section 28(1), stands protected.

**25.9.9** It is true that Section 28(1) uses the expression “if valid”. However, that does not empower a Court, seized with an infringement action based on a registered trade mark, to pronounce on the validity of the trade mark as a ground to deny injunction, even where the defendant has infringed the mark. It merits mention, in this regard, that Section 31(1)<sup>52</sup> of the Trade Marks Act provides that the registration of a trade mark would by itself be *prima facie* evidence of its validity. This *prima facie* presumption of validity can be unseated only if the defendant succeeds in having the trade mark invalidated under Section 57(1) or (2)<sup>53</sup>, or Section 47, of the Trade Marks Act. So long as this is not done, the right to relief against infringement,

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<sup>52</sup> 31. **Registration to be prima facie evidence of validity.** –

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the validity thereof.

<sup>53</sup> 57. **Power to cancel or vary registration and to rectify the register.** –

(1) On application made in the prescribed manner to the High Court or to the Registrar by any person aggrieved, the Registrar or the High Court, as the case may be, may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the High Court or to the Registrar, and the Registrar or the High Court, as the case may be, may



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available to every registered trade mark under Section 28(1), stands preserved. The words “if valid” in Section 28(1) have, therefore, in our opinion, to be read in conjunction with Section 31(1), and the statutory presumption of validity engrafted therein.

**25.9.10** Insofar as Section 28(1) is concerned, the provision clearly favours the appellant, rather the respondents. Section 28(1) entitles the appellant, as the proprietor of each of its registered trade marks, to relief against infringement of such registered trade mark by any third party, by way of injunction or by way of any of the other reliefs envisaged in Section 135 of the Trade Marks Act. Mere registration, even by itself, assures the appellant of the right to relief against infringement. Use of the registered trademark is not necessary.

**25.9.11** As such, we are of the opinion that the learned Single Judge is not correct in his view that, owing to the fact that the appellant has not used the trade mark CONTIN per se, despite being its registered proprietor, it cannot maintain an action for infringement or seek relief against infringement of the mark.

**25.9.12** The learned Single Judge could not, therefore, have held that, because the appellant did not use trade mark CONTIN, which was registered in its favour, the appellant was disentitled to injunction against its infringement.

**25.10** The registration of the mark CONTIN, held by the appellant would, however, ordinarily entitle it only to an injunction against use,

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make such order for making, expunging or varying the entry as it may think fit.



by any third party, of the mark CONTIN *per se*. Else, the appellant would have to establish, in the case of a particular impugned mark, that, by use of CONTIN as a part thereof, the registration of CONTIN as a trade mark in the appellant's favour stands infringed. The provisions of the Trade Marks Act do not permit any grant of injunction, merely because the appellant is the registered proprietor of the mark CONTIN or of a series of marks in all of which CONTIN may form a part, absolutely against any third party using CONTIN as any part of its trade mark, whether for pharmaceutical products or otherwise.

### **25.11 Re. the “family of marks” concept**

**25.11.1** The appellant has invoked, for this purpose, “the family of marks concept”. The learned Single Judge has held, in para 66, that the family of marks concept applies only to passing off, and not to infringement.

**25.11.2** The finding of the learned Single Judge that the concept of family of marks is relevant only for passing off, and not for infringement, may not be correct, in view of the judgment of the Division Bench of this Court in *Amar Singh Chawal Wala*.

### **25.11.3 The judgment in *Amar Singh Chawal Wala***

**25.11.3.1** A short digression into the exact dispute before the Division Bench in *Amar Singh Chawal Wala* is necessary at this



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point. Amar Singh Chawal Wala<sup>54</sup> instituted Suit 2247/1989 against Shree Vardhman Rice and General Mills<sup>55</sup>, alleging infringement. Amar Singh was the proprietor of the registered word marks GOLDEN QILLA, LAL QILLA CHAPP and the word and device marks LAL QILLA and NEELA QILLA, in respect of rice. It was also the proprietor of a registered device mark “QILLA” with a fort representing the mark. It sought an injunction against Vardhman using the trade mark HARA QILLA or the QILLA device or any deceptively similar mark. Amar Singh claimed the exclusive right to use the asserted word and device marks QILLA, GOLDEN QILLA, LAL QILLA, LAL QILLA CHAPP and NEELA QILLA, of which it claimed extensive and continuous user. It was asserted that the use, by the Vardhman, of the mark HARA QILLA and the QILLA device, also for rice, infringed the registered trade marks of Amar Singh, and that unwary purchasers were likely to mistake Vardhman’s rice for Amar Singh’s.

**25.11.3.2** Amar Singh filed an application for interim injunction, along with its suit. The application was dismissed by a learned Single Judge of this Court by order dated 1 March 1996. Amar Singh challenged the order before the Division Bench, resulting in the passing of the judgment under discussion.

**25.11.3.3** The Division Bench finally allowed the appeal and reversed the judgment of the learned Single Judge. Vardhman was restrained, during the pendency of the suit, from dealing in any rice or

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<sup>54</sup> “Amar Singh” hereinafter

<sup>55</sup> “Vardhman” hereinafter



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any other allied or cognate goods using the QILLA device or the trade mark HARA QILLA or any mark or device deceptively similar to the registered trademarks or device marks of Amar Singh in respect of rice.

**25.11.3.4** It is not necessary to advert to all the findings of the Division Bench. For the present discussion, which deals with the “family of marks” concept, it is sufficient to note that, in para 18 of the judgment, the Division Bench held as under:

“18. It is not possible to agree with the reasoning of the learned Single Judge that the word QILLA is not associated with rice and therefore no ordinary purchaser of rice would associate the Defendant's mark as that of the Plaintiffs. It is plain from the pleadings that the Plaintiff has been using the words QILLA consistently in connection with the rice being sold by them with only the first word indicating the colour viz., GOLDEN, LAL or NEELA. It must be held that the Plaintiff has been able to prima facie show that it has developed a ‘family of marks’ and that by merely changing the first word from GOLDEN, LAL or NEELA to the word HARA there is every possibility of confusion being caused both in trade and in the mind of any person desiring to purchase rice. Likewise the use of the picture or depiction of a fort in the background on the label/packing of the rice is also likely to cause confusion in the mind of the purchaser and in the trade that the product being sold by the Defendants are in fact those manufactured by the Plaintiff.”

**25.11.4** It is obvious that the above findings would analogously apply to the present case. Just as, in the appeal before the Division Bench in *Amar Singh Chawal Wala*, Amar Singh had used the second word QILLA consistently with different first words such as GOLDEN, LAL and NEELA, merely changing the first word each time, thereby resulting in a QILLA “family of marks”, the appellant has also developed a family of registered marks of which CONTIN is



the common suffix, with different prefixes. Applying the principle enunciated in para 18 of *Amar Singh Chawalwala*, the use, by any other third party, of a mark, for pharmaceutical products, with the CONTIN suffix and another prefix – such as FEMICONTIN in the present case – may be potentially likely to deceive consumers into confusing the mark with the appellant or, at the very least, presuming an association between the mark and the appellant.

**25.11.5** In view of para 18 of *Amar Singh Chawalwala*, to which the attention of the learned Single Judge appears not to have been drawn, the finding of the learned Single Judge that the family of marks concept would apply only to passing off, is not correct. *Amar Singh Chawalwala*, rendered by a Division Bench of this Court and therefore binding on us, clearly holds the family of marks concepts to apply, equally, to infringement.

**25.11.6** The concept of family of marks was also adopted by the High Court of Bombay in *Neon Laboratories v Themis Medicare Ltd*<sup>56</sup>, to hold “the “XYLOX family of marks” comprising XYLOX 2%, XYLOX HEAVY, XYLOX GEL, XYLOX ADRENALINE and XYLOX 2% Jelly to be infringing the "LOX family of marks" comprising LOX 2% ADRENALINE, LOX 4%, LOX 5%, LOX HEAVY 5%, LOX VISCOUS, LOXALPRIN, LOXALPRY, LOXIMLA, PLOX and RILOX.”

**25.11.7** Both these judgments were followed by this Court in

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<sup>56</sup> (2014) 60 PTC 621



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*Bennett Coleman and Co. Ltd v Vnow Technologies Pvt Ltd*<sup>57</sup> and *Bennett Coleman and Co. Ltd v Fashion One Television LLC*<sup>58</sup>, both of which were authored by one of us (C Hari Shankar, J.), sitting singly.

**25.11.8** These two decisions adjudicated on rectification petitions under Section 57 of the Trade Marks Act filed by Bennett Coleman and Co. Ltd seeking rectification of the register of Trade Marks by removal, therefrom, of the mark VNOW (in the case of *Bennett Coleman and Co. Ltd v VNOW Technologies*) and FASHION NOW (in the case of *Bennett Coleman and Co. Ltd v Fashion One Television*). This Court allowed the petitions in both the cases, noting the proprietary rights of Bennett Coleman in the “NOW” family of marks, which included TIMES NOW, ET NOW, MOVIES NOW, ROMEDY NOW and MIRROR NOW. Following the decisions in *Amar Singh Chawalwala* and *Neon Laboratories*, this Court held that, having established a NOW family of marks, in each of which proprietary rights were conferred on Bennett Coleman as the registered proprietor of the marks, the registration of VNOW and FASHION NOW would result in confusion and that, therefore, such registration would violate Section 11 (1) of the Trade Marks Act, rendering the registration liable to cancellation.

**25.11.9** It is a fact that the Trade Marks Act does not expressly recognise the concept of a family of marks. However, the concept, though judicially created and developed, is merely a manifestation of

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<sup>57</sup> 2023 SCC OnLine Del 864

<sup>58</sup> 2023 SCC OnLine Del 8083



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the principles contained in the Trade Marks Act. When an entity is the proprietor of a number of registered trademarks containing a common prefix or suffix, or a common first or second word, any other mark by a third party which would contain the same first or second word, if used for similar goods or service, could result in likelihood of confusion within the meaning of Section 29(2) of the Trade Marks Act. It is this concept which is elliptically described as the “family of marks” concept. Thus, the concept of a family of marks is not alien to the Trade Marks Act, but merely a recognition of the principles that underlie the statute.

**25.11.10** As already noted, the “family of marks” concept when applied to the present case, clearly indicates that the appellant is the registered proprietor of a family of marks of which CONTIN is a common suffix. The use of any other mark by a third party, with the same suffix, for pharmaceutical preparation, could, therefore, lead to confusion or a presumption of association within the meaning of Section 29(2) of the Trade Marks Act. As the registered proprietor of the CONTIN family of marks, the appellant would be entitled to injunct any such mark from being used.

**25.11.11** That said, however, the principle of a “family of marks” cannot extend to grant of an injunction, in favour of the appellant and against all third parties, from using any mark of which CONTIN is a part, for pharmaceutical preparations or otherwise. Though the principle of a family of marks is well recognised, the Court cannot, without actual facts before it, presume that every mark of which CONTIN is a part, and which may deal with pharmaceutical



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preparations, is necessarily infringing in nature. One may, for example, hypothetically, envisage the use of a mark with the word “CONTINUOUS” or “CONTINGENT” which, hypothetically, may not be infringing even if it is used for pharmaceutical preparations, and contains “CONTIN”. Notably, even in the decisions which have upheld the family of marks principle, including *Amar Singh Chawal Wala* and *Neon Laboratories*, and the two *Bennett Coleman* decisions, the Court has not granted an absolute injunction, across the board, in favour of the family of marks holder and against all third parties from using the common feature of the family of marks in any case. The family of marks concept has been applied only to injunct the use of specific marks, which were under consideration in those cases.

**25.11.12** This, in fact, is but logical. Section 135 of the Trade Marks Act also envisages injunction of a particular trade mark or trade marks, and not of hypothetical trade marks which are not before the Court.

**25.11.13** Even if, therefore, the benefit of the family of marks principle is extended to the appellant, the sequitur cannot be that the appellant would be entitled to an injunction against the use, by every third party, of CONTIN as a part of any trade mark, whether for pharmaceutical preparations or otherwise. The Court would have to examine each instance on a case to case basis. While it is possible for the Court to invoke the family of marks principle to grant injunction, that injunction has to be against marks which are specifically under challenge before the court.



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**25.11.14** By way of example, the appellant would be entitled to an injunction, against the respondents, restraining use of the FEMICONTIN mark, as it infringes the CONTIN family of registered trade marks of the appellant.

**25.11.15** While, therefore, we are unable to subscribe to the view of the learned Single Judge that the concept of a family of marks principle is applicable only to passing off, we agree with the learned Single Judge that the appellant cannot be granted an absolute injunction against use of CONTIN as a prefix or suffix or any other part of any mark under which pharmaceutical preparations are manufactured or cleared.

**25.12** We, therefore, uphold the decision of the learned Single Judge insofar as it refuses to grant injunction to the appellant, as sought, against any third party using CONTIN as a prefix or as a suffix of any mark under which pharmaceutical preparations are manufactured or cleared.

**26.** Re. Issue (iii) – Plea of infringement *vis-a-vis* the FECONTIN-F registered trade mark

**26.1** Re. finding of learned Single Judge that FECONTIN is a descriptive mark

**26.1.1** There are three significant findings of the learned Single Judge,



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in the impugned judgment, with respect to the appellant's claim of infringement, by the FEMICONTIN trade mark of the respondents, of the FECONTIN-F registered trade mark of the appellant. All three have a relation with the aspect of whether FECONTIN, or FEMICONTIN, can be treated as descriptive marks.

**26.1.2** The first is in para 71, in which the learned Single Judge observes:

“...it is correct that for determining whether a mark is descriptive or suggestive in nature, the mark is not to be bifurcated into parts...”

**26.1.3** Secondly, in the opening sentence in para 75 of the impugned judgment, the learned Single Judge observes, even while holding the mark FECONTIN-F to be descriptive of the product for which it is used, that “it is *suggestive* of iron released for a continuous period in the body”.

**26.1.4** The third significant observation is in para 77, where the learned Single Judge observes that “...a combination of two descriptive words may still be entitled to protection...”.

**26.1.5** These three observations of the learned Single Judge, when applied to the facts of the present case, clearly indicate that neither FECONTIN nor FEMICONTIN can be treated to be descriptive of the marks for which they are used, so as to disentitle the appellant from injunction against the respondent.

**26.1.6** Once it is correctly acknowledged, by the learned Single Judge,



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in para 71 of the impugned judgment, that a mark is not to be bifurcated into parts in order to decide whether it is descriptive or suggestive or otherwise, the issue of whether the marks FECONTIN or FEMICONTIN, are descriptive, suggestive or otherwise have to be decided on the basis of the marks themselves, and not by dividing the marks into their individual elements such as “FE” and “CONTIN”.

**26.1.7** At this point, it is important to note that the aspect of whether a mark is descriptive or suggestive or otherwise, would actually be relevant only for the respondents’ FEMICONTIN mark, and not for the appellant’s FECONTIN mark. This is because, *if the respondents’ mark is descriptive*, its use would not amount to infringement by virtue of Section 30(2)(a), and it would be saved from any injunctive order by virtue of Section 35 of the Trade Marks Act. The issue of whether the appellant’s FECONTIN-F mark is descriptive, suggestive or otherwise, is actually irrelevant, insofar as the aspect of infringement, and the appellant’s right to injunction against the respondents, is concerned.

**26.1.8** To that extent, in stressing the purported descriptive nature of the mark FECONTIN, the learned Single Judge appears, with respect, to have misdirected himself in law.

**26.1.9** We also find substance in Mr. Pravin Anand’s contention that as Respondent 1 had itself applied for registration of the FEMICONTIN mark, it could not lie in its mouth to contend that either FEMICONTIN or FECONTIN-F was descriptive.



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**26.1.10** That said, the issue of whether the mark is descriptive or suggestive or neither of the two, would bear more or less the same scrutiny, when applied to the mark FEMICONTIN as to the mark FECONTIN. Expressed otherwise, if FECONTIN is descriptive, so would FEMICONTIN be.

**26.1.11** As we have already noted, the learned Single Judge himself acknowledges that the test of whether a mark is descriptive or suggestive or otherwise has to be decided by reference to the entire mark, and not by breaking it up into fragments. The proscription against injunction of a descriptive mark applies, under Section 35, to the entire mark. Equally, the amnesty against the injunction, as contained in Section 30(2)(a) also applies *vis-a-vis* the entire mark of the defendant, and not with respect to part thereof. The learned Single Judge has correctly held, therefore, that this issue has to be decided by examining the entire mark, though he has, somewhat inaccurately, applied the test to the appellant's FECONTIN mark instead of the respondents' FEMICONTIN mark.

**26.1.12** The exception to infringement, and the protection against infringement, are available to marks which are themselves descriptive of the product in respect of which they are used. In our considered opinion, the imagination would have to be stretched to unrealistic limits to hold that FEMICONTIN is a descriptive mark, merely because "FE" happens to be the chemical symbol for iron, "FEMI" is some sort of abbreviation for "female" and "CONTIN" is an abbreviation for "continuous", which is neither indicative of the ailment that the drug intends to treat or to any of the constituents of



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the drug, but is supposed to represent the mechanism in which the drug acts within the body of the patient. Even if, for the sake of argument, it is assumed that, in devising the FEMICONTIN mark, Respondent 1 was intending to achieve some kind of a portmanteau of the chemical symbol for one of the ingredients of the product, the sex of the patient for whom the drug was intended and the mode or mechanism or action of the product within the body of the patient, that can hardly render the name FEMICONTIN, as plainly read, descriptive of the product.

**26.1.13** At the very highest, FEMICONTIN may be regarded, though again by stretching the imagination somewhat, to be *suggestive* of the nature of the product for which the mark is used. This position appears, in fact, to have been acknowledged by the learned Single Judge himself, by his observation in para 75 that the name is “suggestive of iron released for a continuous period in the body”.

**26.1.14** This observation is by itself sufficient to defeat the final conclusion of the learned Single Judge that no injunction can be granted against the mark FEMICONTIN, or even that the mark FECONTIN-F is not entitled to injunction, applying the law laid down by the Supreme Court in *T.V. Venugopal*, which clearly distinguishes between descriptive and suggestive marks. The following passage, from *T.V. Venugopal* may, in this context, be reproduced, to advantage:

“30. The argument of the respondent Company is that “Eenadu” is not a generic or descriptive mark but a suggestive mark. The



difference between categorisation as generic, descriptive or suggestive is as follows:

- A generic mark can never be a trade mark.
- A descriptive mark can become a trade mark if it acquires secondary meaning.
- A suggestive mark is inherently distinctive.”

Thus, while a descriptive mark is not entitled to registration, and cannot be injuncted, a suggestive mark escapes these interdictions. The proscription against injunction, available under Section 35 of the Trade Marks Act, applies only to descriptive marks, and not to merely suggestive marks.

**26.1.15** By no stretch of imagination, in our considered opinion, can the mark FEMICONTIN be regarded as descriptive of the drug in respect of which it is used. The same conclusion would apply to FECONTIN-F as well.

**26.1.16** Interestingly, while acknowledging, in para 77 of the impugned judgment, that a combination of two descriptive words may be entitled to protection, the learned Single Judge proceeds to observe that “the plaintiff cannot deny the use of such descriptive part by a third party or claim exclusive right to use the same”. Thus, what the learned Single Judge appears to be conveying, through these observations in para 77 of the impugned judgment, is that, though a trade mark which is a combination of two descriptive parts, or a generic and a descriptive part, may be entitled to protection, no individual protection for each of the parts can be claimed by the proprietor. In other words, even if FECONTIN is entitled to protection, the appellant would not be to seek protection individually



for “FE” as a prefix or “CONTIN” as a suffix.

**26.1.17** This observation, in fact, is clearly in favour of the appellant, as the appellant is not seeking any injunction against the use, by any third party, of the prefix “FE”, and we have already held, in earlier in this judgment, that no injunction against the use of CONTIN as a suffix can be granted to the appellant. As such, we are not concerned with individual injunctions for the prefix “FE” or the suffix “CONTIN”, and, as the learned Single Judge himself observes that the combined FEMICONTIN mark may be entitled to protection, it has to be held that, in denying injunction to FECONTIN-F mark, against the FEMICONTIN mark of the respondents on the ground that it was descriptive of the nature, the learned Single Judge has apparently erred.

**26.1.18** The appellant’s prayer for injunction against the use, by the respondents, of the impugned FEMICONTIN mark could not, therefore, have been rejected on the ground that FECONTIN-F mark of the appellant was descriptive in nature. This finding of the learned Single Judge is, therefore, *ex facie* erroneous.

## **26.2** On merits

**26.2.1** On merits, there can be hardly any doubt that the respondents’ mark FEMICONTIN is practically identical to the appellant’s mark FECONTIN-F. It cannot be said that the combination of “FE”, being the chemical symbol for iron, and “CONTIN”, as an abbreviation of the mode of action of the product, is one which would ordinarily occur



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to any person manufacturing the drug. We are in entire agreement with Mr. Pravin Anand that the devising of FEMICONTIN as the name for the respondents' product in the face of the existing FECONTIN-F product of the appellant, both of which are intended to treat similar conditions in the human body, cannot be purely coincidental. The only distinction between FECONTIN and FEMICONTIN is the intervening "MI, between "FE" and "CONTIN". That intervening "MI" does not result in any such distinction between the two marks as would mitigate the possibility of confusion, not only in the mind of the consumer of an average intelligence and imperfect recollection, but even in the mind of a doctor. The marks FECONTIN and FEMICONTIN are practically identical.

**26.2.2** They are also phonetically similar, when one applies the test in that regard as laid down in *In Re: Pianotist*<sup>59</sup>

"You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. Infact you must consider all the surrounding circumstances and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."

**26.2.3** We have already reproduced, towards the commencement of this judgment, photographs of the packs of the appellant and the respondents. These photographs also constituted part of the record before the learned Single Judge. The respondents do not deny that the photographs are of the packages of the appellant and the respondents'

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<sup>59</sup> (1906) 23 RPC 774



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products. If one compares the photographs, it is clear that the respondents have not only adopted a name which is deceptively similar to FECONTIN, but have also adopted a trade dress, including colouring on the package, which would augment the possibility of confusion.

**26.2.4** In that view of the matter, we are also not inclined to agree with the learned Single Judge in his observation that the adoption, by the Respondent 1 of the mark FEMICONTIN was *bona fide*. We agree with Mr. Pravin Anand that the adoption of the mark FEMICONTIN was a conscious decision, taken with a view to confuse the product of the respondents, in the mind of the consumer, with the product of the appellant.

**26.2.5** While dealing with the aspect of confusion, we may note the exordium, in the judgment of the Supreme Court in *Cadila Pharmaceuticals*, to which Mr. Pravin Anand has rightly drawn our attention, that, while dealing with alleged trade mark infringement in the case of pharmaceutical products, the court has to adopt a stricter stand. The degree of resemblance which would otherwise be necessary is relaxed when one deals with pharmaceutical products, and the Court has to ensure that there is absolutely no chance of confusion in the minds of the public between one pharmaceutical product and another, by reasons of similarity of the marks under which the two products are dispensed. Inasmuch as it is public health which hangs in the balance, there can be no leniency whatsoever. Even the slightest chance of confusion in the mind of public between, one drug and another, has to be avoided at all costs.



**26.2.6** Thus viewed, the mark FEMICONTIN is phonetically, structurally and visually practically identical to FECONTIN-F, both when viewed as a word mark *per se* as well as the manner in which they are visually depicted on the individual packs of the products of the appellant and the respondents.

**26.2.7** The facts of the present case, in fact, also justify invocation of the principle in *Munday v Carey*<sup>60</sup> and *Slazenger v Feltham*<sup>61</sup>. The relevant extracts from the said decisions may be reproduced thus:

***Munday v Carey***

"...Where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity."

***Slazenger***

"One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?"

In *Munday*, it has been held, in cases of dishonest imitation or copying, that the Court has to concentrate on the points of similarity between the rival marks, rather than points of dissimilarity. Where there is a clear and dishonest intention to adopt a mark which is imitative of an existing mark of another, with intent to deceive, the decision in *Slazenger* holds that the Court must presume that the

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<sup>60</sup> 1905 RPC 273

<sup>61</sup> (1886) 6 RPC 531



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attempt at deception, practiced by the defendant, succeeds.

**26.2.8** Applying these principles, too, there is no escape, in our mind, from the conclusion, that the Respondent 1's mark FEMICONTIN is in fact deceptively similar to the appellant's mark FECONTIN-F and that there is, in fact, every likelihood of confusion between the two.

**26.2.9** The judgment of the Supreme Court in *Cadila Pharmaceuticals* clearly holds that, in such cases, the mere fact that the products may be Schedule H drugs, or may be differently priced, does not mitigate the possibility or likelihood of confusion. We have to bear in mind the fact that it is not a doctor alone who deals with pharmaceutical preparations. Once the doctor prescribes a medicine, the patient approaches the dispensing chemist to purchase the medicine. The dispensing chemist is also required to dispense the correct drug. Equally, the dispensing chemist dispenses the drug which the patient seeks. The patient is also, therefore, required to be aware of the exact drug which he wants. The likelihood of confusion, while dealing with pharmaceutical products, therefore, arises not only at the end of the prescribing doctor, but also at the end of the dispensing chemist and the purchasing consumer. The possibility of such likelihood of confusion at any stage is by itself sufficient, especially while dealing with pharmaceutical preparations, to justify grant of an injunction.

**26.2.10** Viewed from this angle, too, it cannot be said that there is no likelihood of confusion between the marks FECONTIN-F and FEMICONTIN. We are of the clear and considered opinion that the mark FEMICONTIN is so close, phonetically, structurally and



visually, to the mark FECONTIN-F, as to result in every likelihood of one being confused for the other, within the meaning of Section 29(2)(b) of the Trade Marks Act.

### **26.2.11**      No requirement of actual confusion

In this context, the learned Single Judge has also erred in his observation that no proof of actual confusion has been produced by the appellant. Section 29, which defines infringement, uses the expression “likelihood of confusion”. In order to succeed in a claim of infringement, and to be entitled an injunction on that basis, the plaintiff is not required to prove actual confusion. All that has to be proved is likelihood of confusion.

**26.2.12**      The issue of whether there is likelihood of confusion, too, is an issue which has to be decided not on the basis of evidence, but from the perspective of the Judge, as enunciated in *Dr. Reddys Laboratories v Smart Laboratories*<sup>62</sup>, authored by one us (C. Hari Shankar, J.) sitting singly:

“70. ... There can obviously be no absolute guidelines on the basis of which it can qualitatively, or quantitatively, be determined whether two marks are phonetically similar. Ultimately, it is a call which the Court has to take on its own perception of the rival marks, keeping in mind the principle that deceptive similarity has to be examined from the point of view of a consumer of average intelligence and imperfect recollection.”

**26.2.13**      Once the Court finds, by a comparison of the marks that there is likelihood of confusion, the necessity of establishing actual confusion does not survive. We, therefore, are of the opinion that, in



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his observation that no proof of actual confusion had been led by the appellant, the learned Single Judge has, with respect, erred in law.

**26.2.14** At the very commencement of his discussion on issues 4 to 7, which dealt with the aspect of infringement and the appellant's entitlement to injunction, the learned Single Judge has clearly held that the appellant had succeeded in establishing the reputation of the product FECONTIN-F. Once this was found to have successfully established, it is clear that, by adopting a mark FEMICONTIN, for a product which had closely similar constituents, and was intended to treat an identical physical condition, the respondents have sought to capitalise on the reputation of the appellant's FECONTIN-F product. There is no other reason why the respondents adopted a mark which was so starkly similar to the mark adopted by the appellant. As Mr. Pravin Anand correctly submits, it is too much of a coincidence to sustain judicial scrutiny.

**26.3** For all the above reasons, we are of the opinion that the learned Single Judge is not correct in his finding that the mark FEMICONTIN, as used by the respondents, does not infringe the existing FECONTIN-F mark of the appellant. We are of the view that the FEMICONTIN mark of the respondents is clearly infringing of the appellant's FECONTIN mark and, inasmuch as the respondents are not entitled to the benefit of Section 30(2)(a) or Section 35 of the Trade Marks Act, the appellant would, by operation of Section 28(1), read with Section 135 of the Trade Marks Act, be entitled to an injunction against the use, by the respondents, of the mark



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FEMICONTIN, for pharmaceutical products.

## 27. Re.Issue (iv) – Passing Off

27.1 On passing off, the learned Single Judge has merely held that, as there is no “likelihood of confusion in the mind of an unwary consumer with imperfect recollection”, by the respondents’ use of the mark FEMICONTIN, no case of passing off was made out.

27.2 The finding is, with respect, fundamentally erroneous, in law as well as on facts.

27.3 In the first place, if one were to apply the test of an unwary consumer with imperfect recollection, there is *every* chance of confusion between the marks FEMICONTIN and FECONTIN. To expect that an average consumer, whose recollection is imperfect, would recollect, on coming across the respondents’ mark FEMICONTIN, that it is not the mark of the appellant FECONTIN which he had earlier seen, and that there is an extra “MI” in the former, is plainly unrealistic. Even if one were to place the products side by side, there is every likelihood of confusion between FEMICONTIN and FECONTIN.

27.4 Even if one were to apply the stricter test of confusion in the mind of the prescribing doctor, or the dispensing chemist, there is still every likelihood of confusion owing to the similarity of the marks, combined with the fact that they are intended to treat similar physical conditions and are available through the same trade outlets. In passing



off, it has to be remembered that the Court is concerned, not so much with the likelihood of confusion, but whether there is a chance, owing to the similarity of marks, of one product being mistaken for the other. The *Slazenger* principle, which requires the Court to presume that the attempt at deception, or even creation of confusion, succeeds, would equally apply when examining whether a case of passing off is made out. Plainly, the respondents, in adopting the mark FEMICONTIN, when the appellant's FECONTIN-F, intended at treating similar patients suffering from similar ailments, was already in the market, have attempted to create confusion in the minds of the persons who would be prescribing, dispensing, or even purchasing the product. By adopting a practically identical mark, the respondents, in our view, have made every attempt at ensuring that, instead of prescribing, dispensing or purchasing the appellant's FECONTIN-F, the doctor, chemist or consumer may end up prescribing, dispensing or purchasing the respondent's FEMICONTIN. This, therefore, is a textbook case of passing off, in its truest and most classical sense.

**27.5** Though, *stricto sensu*, the triple identity test may not directly apply, as there is a minor difference between the two marks owing to the intervening "MI" in the mark of the respondents, the test, to all intent and purposes, would apply to the present case as well. As such, the finding of the learned Single Judge that there was no likelihood of confusion between the two marks, which is the only basis on which the learned Single Judge has rejected the claim of passing off, cannot sustain.

**27.6** We have already held that the rival marks are nearly identical.



We have also held that the adoption of the FEMICONTIN mark, by Respondent 1, cannot be treated as bona fide and is an apparent attempt, by the respondent, to capitalise on the reputation of the FECONTIN-F mark of the appellant, by creating confusion in the mind of the persons who would be dealing with the product. This is, therefore, a clear case of attempt, by the respondents, to pass off their product as the product of the appellant, by adopting a nearly identical mark. The finding of passing off is underscored by the similarity between the two packs of FEMICONTIN and FECONTIN, which augment the possibility of confusion between the two products.

**27.7** We, therefore, are of the opinion that the appellant would be entitled to relief even on the ground of passing off and cannot sustain the finding to the contrary as returned by the learned Single Judge in the impugned judgment.

**28. Re. Issue (v) – Relief to which the appellant would be entitled**

**28.1** The sequitur to the above discussion is obvious. The appellant would be entitled to injunctive reliefs against the respondents, both on the ground of infringement as well as on the ground of passing off.

**28.2 The finding of acquiescence**

**28.2.1** Mr. Gagan Gupta, however, also sought to plead acquiescence, on which issue the learned Single Judge has held against the appellant and in favour of the respondent. The delay in institution of CS (OS) 2176/2007, after CS (OS) 577/2005 was withdrawn by the appellants,



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has been held, in the impugned judgement, to amount to acquiescence.

**28.2.2** The finding, in our considered opinion, cannot sustain on facts or in law.

**28.2.3** Acquiescence constitutes a statutory interdiction to injunction, even where a case of infringement is made out. It is covered by Section 33 of the Trade Marks Act and has, therefore, to be pleaded, and established, within the four corners of that provision. Where the principle that is sought to be invoked is statutorily defined, the Court has to invoke the principle, if it intends to, within the four corners of the definition.

**28.2.4** Section 33(1)(b) of the Trade Marks Act disentitles the proprietor of a registered trade mark from opposing the use of a later *registered* trade mark by another, if he has acquiesced “*for a continuous period of five years*” to the use of the latter trade mark.

**28.2.5** Plainly, there are two statutory conditions, which are required cumulatively to be satisfied for the principle of acquiescence to apply, and neither is fulfilled here. Firstly, the later trade mark, i.e. the trade mark which the plaintiff desires to see enjoined, must be a *registered* trade mark. FEMICONTIN is not a registered trade mark. Secondly, the plaintiff must have acquiesced to the use, by the defendant, of the later trade mark, *for a period of five years*. No such acquiescence exists in the present case.

**28.2.6** Acquiescence is a positive act. It must involve active



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facilitation, whether by action or omission, of continued infringement by the respondent. Mere inaction, even if it were found to exist, would not amount to acquiescence. In the present case, immediately on coming to know of the use, by the respondents, of the use of the infringing FEMICONTIN mark, the appellant issued a cease and desist notice to the respondents. On the respondents continuing to use the mark, the appellant instituted not one but three suits in succession, first moving the Ranga Reddy District Court, and, thereafter, moving this Court twice. It cannot, therefore, be said that the appellant had set back and acquiesced in the use, by the respondents, of the infringing FEMICONTIN mark. The plea of acquiescence, as advanced by the respondents is, therefore, bereft of merit.

**28.3** While the passage from *Midas Hygiene Industries*, already reproduced *supra* in para 24.2, clearly holds that, where infringement is found to exist, injunction must follow, a similar legal formulation is to be found in para 13 of the judgment of the Supreme Court in *Laxmikant V Patel v Chetanbhai Shah*<sup>63</sup>, where a case of passing off is found to exist. In *Laxmikant Patel*, the Supreme Court has held that where the Court is satisfied that a case of passing off exists, the Court must immediately grant an injunction and appoint a local commissioner to seize the infringing products.

**28.4** We, of course, have crossed that stage, as this is an appeal against the final judgment passed by a learned Single Judge. As such, the appellant would be entitled to relief of injunction both on the ground of infringement as well as on the ground of passing off.



## 29. Re. Issue (vi) – Extent of liability of the defendants

29.1 Section 29 of the Trade Marks Act makes “use” of the deceptively similar trade mark infringing. Though Section 29(6)<sup>64</sup> defines “use”, for the purposes of Section 29, that sub-section may not apply as it defines use “of a registered trade mark”, and not use of a mark which is confusingly or deceptively similar to a registered trade mark. While interpreting the term “use” as employed for the alleged infringer in Section 29(1) to (5), therefore, one has to seek recourse to Section 2(2)(b)<sup>65</sup> and (c) (of which the latter already stands reproduced earlier in this judgement). Section 2(2)(b) clarifies that any reference, in the Trade Marks Act, to the “use” of a mark is to be construed as a reference to the use of the mark in printed or visual form. In the present case, the respondent uses the FEMICONTIN mark both in printed and visual form. Section 2(2)(c)(i) clarifies that the reference to the “use” of a mark, in relation to goods, would be construed as a reference to the use of the mark upon, or in any physical or in any relation whatsoever, to the goods. Clearly, both the respondents are using the FEMICONTIN mark in relation to the pharmaceutical products manufactured and sold thereunder.

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<sup>63</sup> (2002) 3 SCC 65

<sup>64</sup> (6) For the purposes of this section, a person uses a registered mark, if, in particular, he—  
(a) affixes it to goods or the packaging thereof;  
(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;  
(c) imports or exports goods under the mark; or  
(d) uses the registered trade mark on business papers or in advertising.

<sup>65</sup> (2) In this Act, unless the context otherwise requires, any reference—

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(b) to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark;



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**29.2** Respondent 2 is, therefore, as liable, for infringement and its sequelae, as Respondent 1.

## **Conclusion**

**30.** In view of the foregoing discussion, we sustain the finding of the learned Single Judge insofar as it deals with the plea of injunction against the use of CONTIN, as a suffix or a prefix or any other part of a mark by any person for pharmaceutical products, but set aside the finding of the learned Single Judge insofar as it rejects the plea for injunction, predicated on the FECONTIN-F mark of the appellant.

**31.** Resultantly, the present appeal is disposed of in the following terms:

- (i) The FEMICONTIN mark of the respondents is held to infringe the FECONTIN-F mark of the appellant and also amount to passing off, by the respondents, of their product as the product of the appellant. As such, the respondents, as well as all others acting on their behalf would stand permanently enjoined from using the mark FEMICONTIN, or any other mark which is confusingly or deceptively similar to any of the appellant's registered trade marks, in respect of pharmaceutical product in class 5 or for any other similar, allied or cognate products. Though we are not calling upon the respondents to withdraw, from the market, any batches of the products which may have already been cleared by the respondents, the



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respondents are injuncted from clearing into the market any further stock of FEMICONTIN, which may be available with them. Any such stock if available, shall be destroyed by the respondents, and details in that regard shall be furnished on affidavit with the Registrar of this Court.

(ii) The prayer of the appellant for a restraint against the use of CONTIN as a suffix, a prefix or any part of the mark by any third party for pharmaceutical products of any other preparations, is rejected. However, there shall be a restraint against any third party using CONTIN per se as a mark for pharmaceutical product or for any other allied, cognate or similar products.

(iii) This shall not, however, preclude the appellant from instituting infringement, or passing off, proceedings, against any individual mark or marks, alleging infringement on the ground that the mark or marks are deceptively similar to the plaintiff's registered trade mark, *inter alia* because of use of CONTIN as a part thereof.

(iv) No separate submissions were advanced before us on the aspect of damages. As such, we refrain from passing any order in that regard.

(v) The cross-objection filed by Respondent 1, against the decision of the learned Single Judge with respect to Issue 2, is rejected.



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**32.** The impugned judgment of the learned Single Judge stands set aside in part, and the present appeal stands allowed in part to the aforesaid extent, with no order as to costs.

**C. HARI SHANKAR, J.**

**AJAY DIGPAUL, J.**

**JULY 1, 2025**

*dsn/ar*

*Click here to check corrigendum, if any*