

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

**Judgment delivered on: May 26, 2020**

+ CS(COMM) 1248/2018 & IAs. 16073/2018, 16074/2018 and  
1997/2019

M/S BHARAT BIOTECH INTERNATIONAL  
LTD.

..... Plaintiff

Through: Mr.Sudhir Chandra, Sr. Adv. with  
Mr.Sughosh S. N., Mr. Vipin Nair,  
Mr.P. B. Suresh and Mr.Karthik  
Jayashankar and Ms.Pracheta Kaur,  
Advs.

versus

OPTIVAL HEALTH SOLUTIONS PVT. LTD.  
& ANR.

..... Defendants

Through: Mr. Yogesh Raavi and Ms. Snigdha  
Singh, Advs. for D-1.  
Mr. Anil Sapra, Sr. Adv. with Ms.  
Anusuya Nigam and Ms.Vrinda  
Pathak, Advs. for D-2

**CORAM:**

**HON'BLE MR. JUSTICE V. KAMESWAR RAO**

**J U D G M E N T**

**V. KAMESWAR RAO, J**

**I.A. 16073/2018**

1. By this order I shall decide this application filed by the plaintiff under Order XXXIX Rule 1 and 2 read with Section 151 of CPC seeking interim injunction against the defendants.

2. The suit has been filed by the plaintiff for permanent injunction against the defendants seeking restraint order from

infringing its trade marks, passing off, rendition of accounts / damages and delivery up etc.

3. It is the case of the plaintiff that it is one of the leading manufacturer of the specialized vaccines and bio-therapeutics in India with significant presence both in India and abroad. It has a history of creating innovative vaccines. The manufacturing facilities of the plaintiff are approved by the regulatory agencies in India and abroad and are also approved by the World Health Organization. The plaintiff has honestly coined the trade mark 'TCV' and 'Typbar-TCV' in the year 2012 in relation to a revolutionary vaccine product for Typhoid treatment, then under development by the plaintiff. Both of the said trade marks are registered in India under Trade Marks Act, 1999 ('Trade Marks Act', in short) and have been in continuous and uninterrupted use since May, 2012. The details of the registration of the trade marks are as under:

a)	Trademark	:	TCV
	Registration No.	:	2291745
	Valid upto	:	28.02.2022
	Class	:	5
	Goods	:	Vaccine formulations, Typhoid conjugated vaccine formulations

b)	Trademark	:	Typbar-TCV
	Registration No.	:	2291743
	Valid upto	:	28.02.2022
	Class	:	5
	Goods	:	Vaccine formulations

It is averred that both the registrations are valid and subsisting.

4. The plaintiff's trade mark 'TCV' is registered in Saudi Arabia and Jordan and is expected for registration in Nigeria. Similarly, the plaintiff's trade mark 'Typbar-TCV' has been registered in Saudi Arabia and Jordan and has been accepted for registration in Vietnam and Nigeria. The vaccine of the plaintiff has been widely sold throughout in India since 2013-2014 and is recognized as a premier product for treatment of Typhoid. As per the plaintiff, the revenue in 2017-2018 alone was INR 108.82 Crores. The plaintiff is actively and diligently monitoring any misuse of its aforesaid trade marks. To quote an example, it is averred that the plaintiff on coming to know of the filing of trade mark application bearing no. 2091888 for 'SCION TCV' by a third party, immediately initiated an opposition proceedings before the Trade Mark Registry on July 20, 2018.

5. It is the case of the plaintiff, based on the information received, the defendant No.1 is a corporate entity with offices pan-

India including Delhi, and appears to be in the business of hosting and operating an interactive website [www.medplusmart.com](http://www.medplusmart.com), where pharmaceutical products are actively offered for sale across India including the products bearing the infringing trade marks. The plaintiff is not aware of the exact composition of the defendant No.1 which will become known only after discovery in the present proceedings.

6. It is averred that in the second week of October, 2018, the plaintiff learnt through market sources including its distributors that defendant No.2 had actively commenced promoting a competing vaccine product for Typhoid infection which was similar if not identical in composition to the plaintiff's conjugated vaccine product. Plaintiff immediately undertook market surveillance and proceeded to cause searches to be made through the internet as well, to determine the authenticity of such information and to determine if any violation of its intellectual property rights was involved. During such enquiry, a website was located which claimed to offer a Typhoid vaccine named 'ZYVAC-TCV' purportedly manufactured by defendant No.2. The product was marked as '**Out of Stock**'. On further enquiry, plaintiff was informed that the product of defendant No.2 was likely to be available within a few weeks all across India

including New Delhi. It also located promotional material distributed by defendant No.2 in India in relation to this vaccine product. Such promotional material used the registered trade mark 'TCV' of the plaintiff in a manner that is bound to cause confusion amongst the target audience, viz., healthcare professional who are accustomed to identifying the vaccine of the plaintiff as 'TCV'. It is stated that the likelihood of defendant No.2's product being passed off as 'TCV' of the plaintiff is very high since the trade mark 'TCV' occupies a prominent location and position in such promotional literature of defendant No.2. In addition, defendant No.2 also uses the same reference 'ZYVAC-TCV' on its website under the page titled 'Products'. It is averred that further searches on the website of the Trade Mark Registry shows that the defendant No.2 has apparently not filed any trade mark application for either 'ZYVAC-TCV' or even for 'ZYVAC' per se. It is stated that defendant No.2 is slavishly copying not only the registered trade mark 'TCV' of the plaintiff, but has also dishonestly adopted the 'ZYVAC' part of its product name from third party trade marks, including of Merck Sharpe & Dohme and Alan Pharmaceuticals. Hence, it is contended that the launch of a Typhoid vaccine by defendant No.2 under the name 'ZYVAC-TCV' is a flagrant

infringement of the plaintiff's registered Trade Mark no. 2291745 for 'TCV' inasmuch as this trade mark forms an inextricable part of the name adopted by defendant No.2. Defendant No.1 is also guilty of infringement of said trade mark 'TCV' inasmuch as it provides a channel for trade in products bearing the infringing the trade mark, and within the jurisdiction of this court.

7. It is the stand of the plaintiff that the use so far in publicizing, and intended launch of a competing product with identical and / or deceptively similar trade mark 'ZYVAC-TCV', is confusing and being in relation to identical product category , it is inherently a misrepresentation to the consuming public that the defendant No.2's product has an association with the plaintiff and / or that such use of a trade mark is authorized by the plaintiff, neither of which are true or correct. It is also stated that the mala fides and dishonesty of defendants are amply clear from the fact that the promotional material for 'ZYVAC-TCV' says *'for children of all ages'*, whereas it is actually the plaintiff's vaccine, which was the first typhoid vaccine in India which was approved for administration to infants and children below two years. According to the plaintiff, given the worldwide reputation, registrations, substantial continuous uninterrupted use, laudatory recognition of the plaintiff, the trade

marks 'TCV' and 'Typbar-TCV' qualifies as well-known trade marks, which are associated with the plaintiff and therefore deserves protection and the use of an identical and deceptively similar mark by the defendants and in respect of identical product category, viz. Typhoid vaccine takes unfair advantage and is detrimental to or likely to dilute the distinctive character and repute of the plaintiff's trade marks. That apart, the presence of the counterfeit products of the defendant No.2 being deceptively similar to the plaintiff's product, is prejudicial to the health of the typhoid patients who are typically from economically disadvantaged sections of the society.

8. Reply to the application has been filed by the defendant No.2 wherein it is stated that defendant No.2 is not infringing the plaintiff's trade mark for the reason that the defendant No.2's mark 'ZYVAC-TCV', when considered as a whole is entirely different from the plaintiff's mark and the essential and prominent feature of the defendant No.2's mark is 'ZYVAC'— which is a combination of the words 'Zydus' and 'Vaccine'. Further, the Trade Mark 'TCV' of the plaintiff is generic and descriptive of a category of vaccine called '*Typhoid Conjugate Vaccine*' and cannot acquire any distinctiveness through use and is therefore not entitled to protection in law. That apart, the plaintiff cannot claim to be the first adopter

of the mark **TCV** and has concealed the fact that prior to the alleged adoption of its mark in the year 2012, another entity had filed an application for the registration of the mark **TCV** on June 24, 2009 claiming use since May 6, 2009. The said application was in fact cited in the examination report of the plaintiff's application for the mark '**TCV**'. Hence, the plaintiff is clearly not the creator nor prior user of the mark as alleged. It is stated that the trade mark '**TCV**' *per se* is not used by the plaintiff and no evidence has been adduced to show use of the said mark. Even the abbreviation '**TCV**' is not being used in a trade mark sense by defendant No.2 in the mark '**ZYVAC-TCV**'. The defendant's mark '**ZYVAC-TCV**' is a coined, original and arbitrary trade mark and third parties are also using the mark '**TCV**' in a descriptive sense as the defendant No.2, and the same is permissible in law. It is stated that the defendant No.2 is not passing off its product as that of the plaintiff and the same is clear as (i) a comparison of the product packaging of the defendant No.2's product with that of the plaintiff shows that there is no similarity between the same; (2) no case of passing off is established by the plaintiff as no evidence is forthcoming to prove the goodwill of the marks of the plaintiff as the plaintiff has not even been using the mark '**TCV**' *per se*. The reply seeks the



dismissal of the application.

### **SUBMISSIONS**

9. Mr. Sudhir Chandra, learned Sr. Counsel appearing for the plaintiff apart from reiterating the stand taken in the application submitted that Typhoid, caused by *Salmonella Typhi (bacterium)*, is a major endemic disease in Asia, Africa and Middle East, resulting in 1,28,000 – 1,61,000 deaths annually. The disease burden is probably the highest in India, with 494 deaths for every one lakh persons per year. The earlier types of vaccines available were (1) Parenteral Killed Whole Cell Vaccine (2). Oral-live attenuated Vaccine; and (3) Typhoid-Vi Capsular Polysaccharide Vaccine. According to him, due to the fact that earlier generation vaccines were not producing immunization in children, a need was felt for a new vaccine which can be given to young children as well. In the year 2008, the plaintiff invented a bacterial vaccine and methods to manufacture thereof the new generation of Typhoid Vaccine, being '*Typhoid Vi Capsular Polysaccharide Tetanus Toxoid Conjugate Vaccine*', for which the plaintiff acquired following patents:

Patent Title	Country	Application Number	Date of Filing	Granted Number	Date of Grant	Status
	PCT	PCT/IN2014/000530	19.08.2014	National phases entered in following countries:		
	USA	14/913816	23.02.2016	10046039	14.08.2018	Grant
	Mexico	mx/a/2016/002386	24.02.2016	365726	11.06.2019	Grant
	South Africa	2016-01123	18.02.2016	2016-01123	18.02.2017	Grant
	Russia	2016110576	23.03.2016	2684615	10.04.2019	Grant

	EPO	2014841291	02.03.2016	14841291.9 notice of grant dated 13.08.2019		Notice of Grant
	Ukraine	2016 02951	23.03.2016	Decision of grant issued on 24.04.2019		Decision of Grant

10. It was his submission that the vaccine developed by the plaintiff has been referred to in the industry as *Typhoid Vi Capsular Polysaccharide Tetanus Toxoid Conjugate Vaccine* / *Typhoid Vi Conjugate Vaccine I.P. / ViP's – TT'etc.*, therefore proving that the term 'TCV' was a creation of the plaintiff. The aforesaid fact is clearly reflected from defendant No.2's packaging which prescribes the vaccine differently as '*Typhoid Vi conjugate Vaccine I.P.*' on top of their mark whereas the plaintiff's brochure refers the vaccine as '*Typhoid – Tetanus Toxoid Conjugated Vaccine*'. Ever since May 17, 2013, plaintiff has been granted license for commercial manufacture of '*Typhoid Vi Capsular Polysaccharide Tetanus Toxoid Conjugate Vaccine*' in India. The defendant No.2 was nowhere in the picture until April, 2018 by which time the public had associated the vaccine as belonging and owned by the plaintiff.

11. It was further submitted that on February 29, 2012, the plaintiff had applied for the registration of the two trade marks '**TYPBAR-TCV**' (TM Application No. 2291743) and '**TCV**' (TM Application No. 2291745), separately, both in Class-5, covering

vaccine formulations. The said applications were accepted after following the due procedure contemplated under Sections 20, 72, 73 of the Trade Marks Act, which envisages inviting opposition for registration through public advertisement. No opposition was filed under Section 23 of the Trade Marks Act. Thereafter, trade marks were granted to the plaintiff on September 15, 2016 and March 20, 2018 respectively and the same are valid and subsisting. Both trade marks ‘TCV’ and ‘TYPBAR-TCV’ are unique and distinct. The plaintiff has coined the term ‘TCV’. Plaintiff is the first and prior user of the mark ‘TCV’ since 2013 when it started its commercial run for the said vaccine. The term ‘TCV’ has acquired distinctiveness as a result of continuous use made by it and is now solely and exclusively associated with the plaintiff. In order to prove distinctiveness, he has relied on the two parameters laid down by the Supreme Court in *Satyam Infoway Ltd. v. SIFFYNET Solutions Pvt. Ltd., (2004) 6 SCC 145*, which are the volume of sales and extent of advertisement. In this context, he had drawn the attention of the Court to the sale figures of the plaintiff, as compared to that of defendant No.2, in the following manner: -

YEAR	SALES OF PLAINTIFF VOL. III, PG. 16 (IN CRORES)	SALES OF DEFENDANT NO.2 Vol. IV. PG. 6 (IN CRORES)
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2013-2014	10.62	
2014-2015	37.15	
2015-2016	71.70	
2016-2017	85.90	
2017-2018	108.82	
April, 2018 – Dec. 2018	For the year 2018-2019, the sales stand at Rs.120.57	0.09

The commercial sales of the vaccine clearly imply the way the product has been associated in the perception of the public.

12. It was his submission that the plaintiff is also exporting aforesaid vaccine (*Purified Vi Capsular Polysaccharide of S. Typi Ty. 2 Conjugated to Tetanus Toxoid*) to various countries including Nigeria, Nepal, Cambodia and Laos etc. He submitted that huge amount of money is invested in Research and Development, and advertisement, tabulated as under:

FINANCIAL YEAR	RESEARCH AND DEVELOPMENT EXPENDITURE (IN CRORES)
2005-2006	18.08
2006-2007	10.63
2007-2008	17.11
2008-2009	15.86
2009-2010	31.93
2011-2012	16.49
2012-2013	11.16
2013-2014	11.35
2014-2015	20.95
2015-2016	35.91
2016-2017	45.08
2017-2018	25.25

13. This investment will be lost and irreversible damage will be caused, if injunction is not granted. Therefore, in view of the sales, expenditure on R&D, advertisement and the fact that WHO, a

premier body on the health matters, has pre-qualified the plaintiff's vaccine as the only vaccine for typhoid to be utilized for the UN program, convincingly establishes that the plaintiff's trade mark has achieved distinctiveness. He stated the defendants have relied on the cases of *Cluett Peabody & Co. Inc. v. Arrow Apparals, 1998 (18) PTC 156 (Bom)* and *Veerumal Praveen Kumar v. Needle Industries (India) Ltd. and Ors., 2001 (21) PTC 889 (Del.)* to submit that the distinctiveness will be lost by non-user. According to Mr. Chandra, such an argument cannot be sustained in the eye of law, for the simple reason that 'TCV' has been continuously used by the plaintiff and also as 'TYPBAR-TCV' which itself is a registered trade mark. The registration of the trade marks is a prima facie evidence of their validity under Section 31 of the Trade Marks Act, and any infringement thereof is actionable. In this regard, he has relied on the judgment of the full Bench of the Bombay High Court in *Lupin v. Johnson and Johnson, 2014 SCC Online Bom. 4596*. He argued, even if it is assumed that the aforesaid trade mark is registered in breach of Section 9(1) of the Trade Marks Act, still the trade mark cannot be declared as invalid, as the plaintiff's trade mark has attained distinctiveness as mandated under Section 32 of the Trade Marks Act. He submitted that the

product packaging of the parties herein are as under:



**DEFENDANT PACKAGING (IMAGE NO.1)**



**PLAINTIFF'S PACKAGING (IMAGE NO.2)**

14. He stated that the plaintiff's packaging has 'TCV' surrounded by a protective semi-circular shield. Similarly, defendant no.2 has deceptively copied the shield around the term 'TCV' in their packaging. Therefore, he submitted that the aforesaid attempt of the defendant No.2, is to deceive and confuse the consumers and thereby cause loss to the plaintiff herein by riding upon the goodwill and reputation of the plaintiff. A similar type of vaccine developed by Bio-Med is being sold in India under the name 'PEDA Typh'. The defendant No.2 has made a reference

to the aforesaid typhoid vaccine 'PEDA Typh', to show that same is a type of 'TCV' available in the market and therefore the 'TCV' is not exclusive to the plaintiff. However, on a reference to, Vol. IV. Pg. 12 of the defendant No.2's documents, it is evident that the same is in fact a *'Typhoid Vi Conjugate Vaccine'* and not 'TCV' *per se*. He further submitted defendant No.2 has not produced any evidence to prove that 'TCV' was a generic term. The articles and material supplied by the defendant No.2 are all relatively recent, post 2015, whereas plaintiff's product was already in the market since 2013. There is not a single article / document / material, as submitted by the defendant No.2, to point that 'TCV' was utilized in a generic sense before 2013.

15. He submitted that a probable reason why the plaintiff's mark 'TCV' is being contended as a 'generic term' by the defendant No.2 is because of the lack of a convenient substitute to the term of *'Typhoid Vi Capsular Polysaccharide Tetanus Toxoid Conjugate Vaccine'*. The plaintiff's product, being the first of its kind in the market, has acquired distinctiveness with respect to the aforesaid trade mark 'TCV'. In support of his contention, he relied on *Sunil Mittal v. Darzi on Call, (2017) 242 DLT 62*, Para 15 thereof.

16. He argued that the defendant No.2 has not applied for the registration of its mark 'ZYVAC TCV'. This shows the malafide intent of defendant No.2 in copying the 'TCV', without having a registration on the same. Added to the above in an utter disrespect to plaintiff's trade mark, the defendant No.2's brochure utilized the symbol 'TM' after 'ZYVC-TCV'. This clearly portrays the malafide intention of the defendant No.2 to ride on the goodwill of the plaintiff herein.

17. It was his submission that the defendant No.2, while relying on the case of *Nestle India Ltd. v. Mood Hospitality Private Limited, 2010 (42) PTC 514 (Del.)* has contended that 'TCV' is only used as a suffix to 'ZYVAC', therefore, there is no similarity, between the plaintiff's trade mark and the defendant's. However, the facts of that case are easily distinguishable, having regard to the fact that usage of the term 'YO!' therein was not as a trade mark, rather was just used to 'call the attention'. In this case, the unique and distinctive word coined by the Plaintiff i.e., 'TCV' is utilized by the defendant No.2 to only cause confusion in the minds of the buyers, accordingly, the presumption under Section 29 (3) of the Trade Marks Act shall operate in favour of the plaintiff. Moreover, there are umpteen examples wherein by merely adding prefix to a



distinctive mark, the infringer i.e the defendant No.2 in this case, cannot defeat the legitimate rights of the other party. He has relied on the judgment in *Kamani Oil Industries Pvt. Ltd. v. Bhuwaneshwar Refineries Pvt. Ltd., 2014 (4) ABR 103*. The use of 'TCV' in the impugned mark of the defendant No.2 i.e., 'ZYVAC-TCV' is an infringement of the registered trade mark of the plaintiff and is already causing confusion in the minds of the public. He further stated that in any case Section 29 (3) of the Trade Marks Act, contemplates that the Court shall presume the confusion on the part of the public with regard to the identity of the goods and services, if a registered trade mark is copied so as to be identical or similar to the goods of the registered trade mark user. In the instant case, 'TCV' is a registered trade mark of the plaintiff. The use of 'TCV' by the defendant No.2 does violence to Section 29 (3) of the Trade Marks Act and therefore the Court ought to grant the injunction, in view of the mandate of Section 29 (3) of the Act.

18. He submitted that defendant No.2 has contended that the term 'TCV' is a generic term and using it along with 'ZYVAC' as a prefix, makes it distinct from that of the plaintiff's trade marks. The aforesaid contention cannot be sustained in the eye of law as 'TCV' itself is registered trade mark of the plaintiff and has been associated

with the plaintiff's product. The very use of the 'TCV' by the defendant No.2 is done to cash on the goodwill and reputation of the plaintiff's product. The sweat and labor of the plaintiff in developing a product and creating the scheme of the product in the mind of the public, is sought to be exploited by the defendant No.2. Further the objections, raised, at the time of grant of the trade marks, have been considered by the Registry before the grant to the plaintiff and therefore, cannot be looked into at this stage of the proceedings wherein the plaintiff has established a *prima-facie* case in its favour. Further, it is well established principle that the plaintiff is not expected to sue all small-time infringers who may not be affecting plaintiff's business. He relied on the judgment of the Division Bench of this Court in the case of ***Pankaj Goel v. Dabur India Ltd., 2008 (38) PTC 49 (Del).***

19. He argued that defendant No.2 has failed to satisfy that the registration of the plaintiff's trade mark is *ex-facie* illegal, fraudulent or shocks the conscience of the Court. Defendant No.2 has failed to discharge the very high threshold placed on it. He placed reliance on the case of ***Lupin (Supra)***. He submitted that the case of the ***Marico Ltd. v. Agro Tech Foods Ltd., 2010 (44) PTC 736 (Del.)*** was one wherein the usage of the term 'LOW ABSORB'

being a common descriptive word indicating the nature of edible oil could not be upheld by the Court as it was *ex facie* illegal and shocked the conscious of the Court. However, in this case at hand, the very high threshold set by the case of *Lupin (Supra)* for the defendant No.2 is not discharged.

20. According to Mr. Chandra, the defendant No.2 has raised a contention in the present suit challenging the validity of the plaintiff's trade mark, without first approaching the appropriate authority i.e., Registrar or IPAB as the case may be, for setting aside the same, as envisaged under various provisions of the Trade Marks Act (Section 57 and 124). In this regard, he has placed reliance on para 41 of *Patel Field Marshal Agencies v. P.M. Diesels Limited and Others, (2018) 2 SCC 112*.

21. It is also contended that, the defendant No.2, in breach of the ratio laid down by the Supreme Court in the *Patel Field Marshal Agencies (Supra)* inasmuch as, it has neither sought the permission of this Court nor has this Court given a *prima facie* finding on the invalidity, for it to approach the concerned Registrar or the IPAB as the case may be, during pendency of the Suit.

22. Finally, Mr. Chandra submitted that the plaintiff is a Company which believes in innovation and is not merely producing

generic drugs in India. If the injunction in this matter is not granted, then the investment made by plaintiff in Research and Development would be in jeopardy. Every day of delay is causing irreparable loss / harm to the plaintiff herein. According to him, the plaintiff satisfies the required ingredients, of a *prima facie* case, balance of convenience and has a good case on merits, for seeking an interim injunction against the defendants herein. Matters pertaining to infringement of Intellectual Property Rights (IPRs) are special cases. Mere compensation can never be treated as an efficacious remedy in IPR infringement matters and an injunction is therefore necessary to prevent the defendants from invading or threatening to invade the plaintiff's right to, or enjoyment of the property.

23. On the other hand, it was the submission of Mr. Anil Sapra, learned Sr. Counsel appearing for the defendant No.2 that the product in question in the present suit is a type of vaccine for Typhoid, being one of the three vaccines available for the disease, viz. *Typhoid Conjugate Vaccine (TCV)*, *Unconjugated Vi Polysaccharide (ViPS)* and *Live attenuated Ty21a Vaccine*. The marks in question in the present matter are 'TYPBAR-TCV' and 'TCV' of the plaintiff and the mark 'ZYVAC-TCV' of the defendant No.2. The vaccine '*Typhoid Conjugate Vaccine*', is

commonly known world over, especially as part of medical journals and in the medical community as 'TCV'. Therefore, as per the '*Spectrum of Distinctiveness of Marks*' propounded by McCarthy, the mark 'TCV' being a generic abbreviation of the product, as also being descriptive of the goods it relates to, is incapable of trade mark protection. So it, follows that generic marks i.e. marks that indicate a type / kind / variety of the goods being sold thereunder are incapable of acquiring distinctiveness even through years of use and have no trade mark significance.

24. He also stated that the mark 'TCV' is descriptive of the product in question, and therefore, cannot be granted exclusive protection under the law in the absence of acquired distinctiveness. He further submitted, '*Typhoid Conjugate Vaccine*' is the name of the vaccine, which is commonly abbreviated as 'TCV' for ease of reference, such that all 'TCV' vaccines are generically and colloquially referred to as 'TCV'. He also stated that published scientific articles clearly refer to '*Typhoid Conjugate Vaccines*' as 'TCV'. In this regard, he has relied on page 86 and Page 91@92, Volume III, plaintiff's documents; Pages 48@49, 64-66, 69@74,75,78,81, Volume IV Defendant no.2's Documents. Therefore, as per the '*Spectrum of Distinctiveness*', the mark

‘TCV’ is generic, and incapable of being distinctive – as such, no party can claim exclusivity over the same. Further, a highly generic mark is incapable of trade mark protection (Ref:- *Cadila Healthcare Limited v Gujarat Cooperative Milk Marketing Federation Limited & Ors*, 2009 (41) PTC 336 (Del)) and any registration granted in respect of a generic mark will also not grant sanctity to the mark. The grant of a trade mark registration is only *prima facie* evidence of its validity and the presumption of *prima facie* validity of registration is a rebuttable presumption. In such cases, the Court has the power to go behind the registration, specially at the interim stage. Thus, an abbreviation cannot be used as a trade mark if it is a generic term and has clear generic connotations. In such cases, the defendant No.2 would have, as good a right to a descriptive title as the plaintiff. Further, the mark TCV is descriptive of the product in question, as it merely describes one of the three types of typhoid vaccines available. A descriptive mark can only be afforded protection in case it has acquired distinctiveness on facts.

25. It was his submission, the following details of the plaintiff’s marks and its user are relevant to show that the plaintiff’s

marks 'TCV' and 'TYPBAR-TCV' have not acquired distinctiveness as:

a. The Plaintiff is not the first one to coin and adopt the mark 'TCV'. In this regard, he relied on page 14, Volume IV of defendant's Documents. The trademark application for the mark 'TCV' was first filed by one Sanjeev Thakkar, in relation to medicinal preparations in the year 2009 claiming user since May 2009 i.e. well before the plaintiff sought to claim rights in the same. Additionally, the said fact was concealed by the Plaintiff when it approached the Court seeking equitable relief;

b. No evidence has been adduced by the plaintiff that the mark 'TCV' has been used by it in any manner whatsoever. The plaintiff's documents, including invoices, clearly show that the mark used by them is in fact 'TYPBAR-TCV'. Even on its own website, the plaintiff has used the marks 'TYPBAR' and 'TYPBAR-TCV'. Non-use of the mark 'TCV' has been cleverly concealed in order to mislead the Court. It is settled law that a mark that is not used in commerce affords no rights. Marks do not exist in a vacuum. (Ref:-*Cluett Peabody (supra)*, *Veerumal Praveen Kumar (supra)*);

c. The Plaintiff's reliance, on the WHO pre-qualification in a trade mark infringement and passing off suit is misconceived and misplaced. The said pre-qualification does not have any bearing on the trade mark used in respect of the product;

d. Assuming for the sake of argument that the mark 'TCV' is descriptive, it has not acquired distinctiveness inasmuch as the user of the plaintiff is only of six years since 2012 onwards as mentioned in para 3 of the plaint, that too of the mark '**TYPBAR - TCV**', and not 'TCV' itself. Further, the plaintiff has made no claim of acquired distinctiveness in its pleadings, even though the same was sought to be addressed during the course of arguments before this Court;

e. Such being the case, third parties including defendant No.2 cannot be barred from using a descriptive and generic mark;

f. In fact, allowing the Plaintiff to enjoy exclusivity over a highly descriptive and generic mark such as 'TCV' would be contrary to public policy, as the natural effect thereof would be that honest traders such as defendant no.2 would not be able to inform the public at large that it is manufacturing a vaccine for the treatment of Typhoid. Such a chilling effect is highly undesirable *Marico (supra)*;



26. Mr. Sapra submitted that defendant no.2's mark 'ZYVAC-TCV' when considered as a whole, is entirely different from the plaintiff's mark 'TYPBAR-TCV' and the essential and prominent feature of the defendant No.2's mark is 'ZYVAC'. It is settled law that while comparing trade marks, the competing marks should be considered as a whole (Ref:- *Kaviraj Pandit Durga Dutt Sharma v Navaratna Pharmaceutical Labs, AIR 1965 SC 980*) and not broken into fragments and parts; competing marks should not be placed side by side to find out if there are any differences in them, since the whole of a mark is greater than the sum of its parts (Ref:- *Marico (supra)*). The test, therefore, is if one mark bears such an overall similarity to the registered mark as would likely to mislead a person usually dealing with one to mistake it for the other. (Ref:- *Parle Products Ltd. v. J.P and Co., 1972 (3) SCR 289; Para 9*).

27. It was submitted by Mr. Sapra that by applying the abovementioned test, the marks 'ZYVAC-TCV' and 'TYPBAR-TCV' bear no resemblance or similarity and therefore eliminate any likelihood of confusion or deception. The essential feature of the defendant No.2's mark is 'ZYVAC' and not 'TCV', as it is evident from a mere glance at defendant No.2's product packaging. The

mark 'ZYVAC' is a coined mark and is a unique combination of the words ZYDUS and VACCINE, and as such, has no meaning, thus qualifying as an arbitrary and fanciful mark. Without prejudice, while a mark is to be considered in its entirety, yet, it is permissible to accord more importance to a dominant element in composite marks. It is not a violation of the anti-dissection rule to view the dominant component parts in order to decipher the probable consumer reaction. (Ref:- *South India Beverages Pvt. Ltd. v. General Mills Marketing Inc.*, (2015 (61) PTC231 (Del)). Any reference to the mark 'ZYVAC' relates solely to defendant No. 2, owing to the enormous reputation and goodwill associated with the mark 'ZYDUS'. Members of the trade and consumers at large associate the mark 'ZYVAC' exclusively with 'ZYDUS' and the Zydus Group in view of the reputation of the defendant No.2's group companies and the various medicines provided under marks containing 'ZY'. The very adoption of the arbitrary mark 'ZYVAC' shows the defendant No.2's *bona fide* intention, and clarifies that it only seeks to convey to consumers that the product in question is a 'TCV' vaccine manufactured by the Zydus Group.

28. He further submitted, in pharmaceutical products, trade marks are usually adopted using one of the following three features

of the product, or their combination: (i) A part of the name of the drug or the INN name (eg: NAXDOM for Domperidone and Naproxen Tablets, CETRIZINE for levocetizine tablets), (ii) a part of the name of the manufacturer of the drug and/or (eg: LEVOCIP for Levocetizine sold by Cipla Limited) (iii) a completely fanciful name that had no relation to the above (eg: COMBIFLAM for Ibuprofen and paracetamol tablets) (Ref:- *Cadila Healthcare Limited v Aureate Healthcare Pvt Ltd., 2012 (51) PTC 585(Del)*, Para 27). In such cases, the importance of the prefix of the word should be given due weightage and important, in case where the suffix is common. Where the suffix is common, regard must be had to the earlier portion of the word which distinguishes one from the other. Where the suffix is common, the earlier portion of the word is the natural, necessary and in fact, the actual mark of distinction (Ref: *Cadila Healthcare Limited v Dabur India Limited, (1997) 17 PTC 417*). Such being the settled position of law, it is clear that there can be no confusion whatsoever when the marks ‘**TYPBAR-TCV**’ is compared to the mark ‘**ZYVAC-TCV**’.

29. Mr. Sapra submitted that the defendant No.2’s use of the mark ‘**TCV**’ is not in the trade mark sense as envisaged in Section 29 of the Trade Marks Act, and is thus within the ambit of the law

under Sections 35 and 30(2) of the Trade Marks Act. An action for infringement under Section 29(1) of the Trade Marks Act, could only be brought where the defendant uses a mark 'as a trade mark' i.e. in a manner '*indicative of trade origin*' (Ref:- ***Nestle v Mood Hospitality***, (2010 (42) PTC 14(Del), para 12). If a mark is not being used in a '*trade mark sense*' but merely in a descriptive sense, it is covered in the exceptions under Section 30(2) and Section 35 of the Trade Marks Act. If a defence of use of a descriptive mark as an indication of kind, quality or characteristic of goods (under Section 35) is to succeed, the term used is required to be generic and that the use of the term be *bona fide*. It has been held that if a sufficiently distinctive term is used along with the descriptive term, the same would qualify as *bona fide* use. Thus, the presence of the word '**ZYVAC**' along with the descriptive abbreviation '**TCV**' in defendant No. 2's, makes the mark '**ZYVAC-TCV**' sufficiently distinctive and clearly indicates the *bona fide* intention of the defendant No. 2.

30. He submitted that the packaging and overall getup of the competing marks is different and thus no action of infringement or passing off lies against the defendants. A bare perusal of the packaging of the products, reveal the pronounced differences in the

packaging of the products. The differences combined with the fact that the prefix in both the marks are entirely different, he submitted that no action of infringement or passing off lies against defendant No 2.

31. It was the submission of Mr. Sapra that the plaintiff's contention that it is the first manufacturer of the '*Typhoid Conjugate Vaccine*' and is entitled to the exclusive use of the mark '**TCV**', is highly misconceived. The plaintiff has claimed in the pleadings that it is the first entity to sell a '**TCV**' vaccine. In this regard, even if the same is assumed to be true, it does not entitle the plaintiff to debar future manufacturers by adapting a generic/descriptive term as a mark. Such a situation would impinge on the legitimate use of the mark in future by any other manufacturer.

32. Mr. Sapra submitted that the arguments advanced on behalf of the plaintiff are devoid of merit and the plaintiff has sought to argue beyond its pleadings. It is a well settled position of law that the parties cannot argue beyond their pleadings. He stated that during the course of arguments, it was contended on behalf of the plaintiff that the only players in the market using the term '**TCV**' are the plaintiff and the defendant No.2. However, it is

relevant to note that there are two other players in the market that manufacture the said vaccine, apart from the parties in the present suit. In view of the same, it cannot be contended that the defendant No. 2 is the only party that chose to use the mark 'TCV' in order to ride on the alleged goodwill of the plaintiff's product. He submitted that for such an argument to sustain, there should be considerable number of parties in the same trade, and only defendant No.2 choosing the same mark as that of the plaintiff. However, as the facts of the present case show, 'TCV' is presently at a nascent stage of development for commercial sale, and thus there are very few players in the market, rendering the argument of the plaintiff baseless.

33. It was the submission of Mr. Sapra, that it was contended on behalf of the plaintiff that the mark 'TCV' has acquired distinctiveness through years of use, however, no such pleading has been made in the plaint, thus, the argument should be rejected outrightly. Without prejudice to the aforesaid, he highlighted that a generic mark can never acquire distinctiveness, as has been propounded by *McCarthy* and reiterated in the *Cadila Healthcare Limited v Gujarat Cooperative Milk Marketing Federation Limited & Ors, 2009 (41) PTC 336 (Del)*. Further, it has been

stated by the plaintiff during the course of hearing that the plaintiff has registered patents for the vaccine in various jurisdictions and has also applied for a patent in India. He submitted that the aforesaid argument should be rejected as (a) patent registration/pending application for patent registration is entirely irrelevant for the present trade mark infringement dispute and (b) the aforesaid argument was not averred by the plaintiff in the pleadings. He reiterated that a party cannot go beyond its pleadings. He submitted that the plaintiff has, during the course of the hearing, taken the argument that alleged 'protective semi-circular shield' over the mark of the plaintiff has been copied by the defendant No. 2. In this regard, he stated the symbol present in the mark of the plaintiff, can by no stretch of imagination, be called a 'shield'. In any event, the symbol is entirely different from the defendant No.2's mark. Further, as is the case in most of the arguments taken by the plaintiff at the stage of hearing, the aforesaid, has not been pleaded in the plaint. According to him such submissions point towards the desperate attempts of improving the case, which evidently is devoid of merit.

34. It was his submission that the plaintiff has sought to distinguish the case of *Marico (supra)* by saying that the marks

therein (LOW ABSORB and LOSORB) were evidently generic and thus would not apply to the facts of the present case. However, the reliance was placed on the said judgment to substantiate the following propositions of law:

a. That companies/persons who are first of the block in the market to use a said mark which is descriptive in nature should be discouraged from claiming exclusivity on the same;

b. Further, it was categorically held in the judgment that if a defendant uses his own word mark as a trade mark prominently in addition to the descriptive word mark which the plaintiff claims to be his trade mark, nothing further is required to show the bona fides of the defendant against whom infringement of a registered trade mark is alleged.

According to Mr. Sapra, both the aforesaid principles remain un rebutted by the Plaintiff.

35. According to Mr. Sapra, Mr. Chandra during the course of arguments stated that the cases of *Cluett Peabody (supra)*, *Veerumal (supra)* have no application in the present case since the mark 'TCV' is being used as part of 'TYPBAR-TCV'. According to him, the aforesaid contention of the plaintiff points directly towards the *mala fide* of the plaintiff, since it fails to answer the



pertinent question which is: why has the plaintiff registered both the marks '**TYPBAR TCV**' and '**TCV**' when in fact it had no intention of using the mark '**TCV**' *per se*. He stated that the plaintiff has failed to justify or answer the aforesaid question all throughout the pleadings and oral arguments, clearly evidencing that the registration over the mark '**TCV**' is devoid of merit. According to him, it was contended on behalf of the plaintiff during the course of the hearing that the fact that the defendant No.2's mark is '**ZYVAC-TCV**' is immaterial since the whole mark cannot be copied with the addition of another word with it. Taking the example of the mark '**TATA**', it was stated that "xyz TATA" would still be an infringement. According to Mr. Sapra, the aforesaid argument is entirely misplaced, while comparing two competing marks, the 'essential features' of the marks are to be seen. Reliance is placed on the Supreme Court judgment in *Ramdev Food products v. Arvindbhai Ramabhai Patel*, (2006) 8 SCC 726. Owing to the generic nature of the mark '**TCV**', it is an inescapable conclusion that the essential and dominant feature of the Plaintiffs mark is '**TYPBAR**' and not '**TCV**'. Furthermore, the essential feature of the mark of the defendant No 2 is '**ZYVAC**', since the defendant No. 2 manufactures and sells numerous medicines under

the 'ZY' prefix, indicating its origin from defendant No. 2 and none else. Thus, the analogy drawn with TATA trade mark is erroneous, since TATA is the essential and dominant feature in the mark of the proprietor, which, if used by any other party along with other words would indeed constitute infringement, whereas 'TCV' standalone is a generic mark and is standalone not being used by the plaintiff, disentitling it from being the essential feature of the plaintiffs mark.

36. He submitted the reliance placed by Mr. Chandra on the judgment of *Lupin (supra)* is misplaced since though a high burden of proof lies on the defendant to prove a *prima facie* case that a registration is invalid, such burden has been discharged by defendant No. 2 in the present case since the mark 'TCV' has not been used at all. Thus, the registration is patently illegal, obtained even when the plaintiff had no intention to ever using the mark standalone. Further, the plaintiff's argument regarding seeking permission of the Court before filing a rectification is also misplaced since the judgement of the Supreme Court in *Patel Field Marshal (supra)*, clarifies the position by categorically holding that no permission of the court is required before initiating a rectification proceeding.

37. It was submitted on behalf of defendant No.2, that in the note of arguments filed by the plaintiff that they have also sought to place reliance on arguments that were taken neither in the plaint/application or during arguments. It is settled law that arguments that traverse beyond pleadings ought not to be considered.

No case for grant of interim injunction is established by the plaintiff since:

a. **No prima facie case is established**

- i. There is no similarity whatsoever between the marks 'TYPBAR-TCV' and 'ZYVAC-TCV', therefore, there is no infringement of the said mark as claimed or otherwise;
- ii. There is no similarity between the packaging of the plaintiff and that of the defendant No.2, therefore, likelihood of confusion, as alleged or otherwise.
- iii. The mark 'TCV' is highly generic and incapable of affording exclusive protection.
- iv. Assuming for the sake of argument, that the mark 'TCV' is descriptive, it has not acquired distinctiveness, as established by the Plaintiff's documents.

v. The mark 'TCV' *per se* is not being used by the plaintiff itself – therefore, equities have to be balanced in favour of the defendant no.2.

**b. Balance of convenience is in favour of the Defendant No 2**

i. The mark 'TCV' *per se* is not being used by the plaintiff itself.

ii. The plaintiff would not be put to any inconvenience if the mark 'ZYVAC-TCV' which is entirely different from 'TYPBAR-TCV' is used in the course of trade.

iii. Being a vaccine for a tropical disease such as Typhoid, all parties manufacturing the said vaccine ought to be permitted to describe the product as such, so that the same is made available, without any confusion or deception, to the largest possible patient base.

iv. Since 'TCV' is completely descriptive of the type of vaccine, not allowing the defendant No.2 and others from using the name 'TCV' would be against public policy.

v. The fact that the defendant No.2 has used the coined mark 'ZYVAC' (ZYDUS + VACCINE) along with the descriptive term 'TCV' clarifies beyond

doubt, the Defendant no.2's *bona fide* adoption of the mark.

**c. No loss will be suffered by the Plaintiff if the interim injunction is granted/irreparable harm will be caused to Defendant no.2 in case an order of interim injunction is passed**

i. There is no similarity between the marks 'TYPBAR-TCV' and 'ZYVAC-TCV', therefore, there is no infringement of the said mark as claimed or otherwise.

ii. There is no similarity between the packaging of the plaintiff and that of the defendant No.2, therefore, no likelihood of confusion, as alleged or otherwise.

iii. The mark 'TCV' is highly generic and incapable of affording exclusive protection. Assuming for the sake of argument, that the mark 'TCV' is descriptive, it has not acquired distinctiveness, as established by the Plaintiff's documents.

iv. The mark 'TCV' per se is not being used by the Plaintiff itself.

He seeks, the dismissal of the application.

**CONCLUSION:**

38. Having heard the learned counsel for the parties, the issue which needs to be adjudicated in this application is whether the plaintiff is entitled to an interim order seeking a

restraint against the defendants from using the mark 'ZYVAC-TCV'. It was contended by Mr. Chandra that earlier three types of vaccines were available; for treating typhoid (i) Parenteral Killed Whole Cell Vaccine; (ii) Oral-live attenuated Vaccine; and (iii) Typhoid-Vi Capsular Polysaccharide Vaccine. As these vaccines were not producing immunization in children, a need was felt for a new vaccine, which can be given to young children. It is the case of the plaintiff that in the year 2008, it had invented a new generation of Typhoid vaccine, being *'Typhoid Vi Capsular Polysaccharide Tetanus Toxoid Conjugate Vaccine'* which is also referred in the industry as *'Typhoid Vi Conjugate Vaccine IP / ViP's-TT'*, and accordingly coined the abbreviation / acronym of the said vaccine as 'TCV' by applying for the registration of two marks 'TYPBAR-TCV / TCV' in the year 2012, which were granted in the year 2016 and 2018 respectively. It started manufacturing in May 2013 and is a prior user.

39. Mr. Chandra had stated that the revenue of the plaintiff from the selling of the vaccine alone was INR 108.82 Crores in the year 2017-18. His case is that the

launch of '*Typhoid Conjugate Vaccine*' by defendant No.2 in the year 2018 under the name of '**ZYVAC-TCV**' is apparent violation of the plaintiff's trade mark '**TCV**' / '**TYPBAR-TCV**', inasmuch as '**TCV**' forms part of the mark '**ZYVAC-TCV**'.

40. The case as argued by Mr. Sapra is that, the mark '**TCV**' of the plaintiff is generic abbreviation of the product as also being descriptive of the goods it relates to, that is '*Typhoid Conjugate Vaccine*' and cannot acquire any distinctiveness through use and is therefore not entitled to protection of law. It was also contended that the mark '**ZYVAC**' is a composite mark in which '**ZY**' are the first two alphabets of '*ZYDUS*' and '**VAC**' are the three alphabets of the word vaccine.

41. So, from the above, it is noted that the plaintiff has registered marks '**TCV**' and '**TYPBAR-TCV**', whereas the mark of the defendant No.2 is '**ZYVAC-TCV**' for the same vaccine.

42. So, first of all, it is necessary to look into the plea of Mr. Sapra, that the mark '**TCV**' being a generic abbreviation / acronym of '*Typhoid Conjugate Vaccine*' and

being descriptive of the goods i.e. vaccine, the marks are incapable of trade mark protection.

43. The defendant No.2 has placed on record literature of WHO, wherein the descriptive word, '*Typhoid Conjugate Vaccine*' has been described as one of the three types of vaccines, other two being unconjugated '*Vi Polysaccharide (ViPS)*' and '*Live attenuated Ty21a*' available for treating Typhoid. The Division Bench of this Court in *Marico Limited (supra)* has held that the abbreviation of descriptive words cannot and should not be given protection as a trade mark. The Division Bench also in para 6 of the said judgment has referred to the fact that if a person is first of the blocks in using descriptive words as a trade mark or its abbreviation that will not entitle such person to exclusively use the descriptive word mark or its abbreviation as a trade mark, and for this purpose reference has been made to the provisions of Section 9, 30 and 35 of the Trade Marks Act. In fact, it was further held that even if the descriptive word mark or its abbreviation is registered even then such registration can be got cancelled. The relevant paragraph 6 of the judgment is reproduced as



under:

“6.....it is high time that those persons who are first of the blocks in using a trade mark which is a purely descriptive expression pertaining to the subject product out to be discouraged from appropriating a descriptive expression or an expression which is more or less a descriptive expression as found in the English language for claiming the same to be an exclusive trademark and which descriptive word mark bears an indication to the product's kind, quality, use or characteristic etc. This is our view is in accordance with the spirit of various sub sections of Section 9 and Section 30 besides also Section 35 of the Act.....”

44. Similarly, in ***Cadila Healthcare Limited v Gujarat Cooperative Milk Marketing Federation Limited & Ors***, 2009 (41) PTC 336 (Del), wherein this Court while considering the mark “Sugar Free” in an appeal filed against the order of the Single Bench declining the injunction, held that the use of the term ‘*Sugar Free*’ by the respondent (in that case) was not in the trade mark sense but in common descriptive adjective.

45. A Division Bench of this court, in ***SBL Ltd. v.***

*Himalaya Drug Co., 67 (1997) DLT 803*, after observing that descriptive marks are inherently incapable of being appropriated and protected, until they assume a secondary meaning, held as follows:

*"(3) Nobody can claim exclusive right to use any word, abbreviation, or acronym, which has become public juris. In the trade of drugs it is common practice to name a drug, by the name of the organ or ailment which it treats or the main ingredient of the drug. Such organ, ailment or ingredient being public juris or generic cannot be owned by anyone for use as trade mark. (emphasis supplied)*

*(4) Whether such feature is public juris or geris is a question of fact. (5) If the two trade marks by two competing traders use a generic word or an expression public juris common to both the trademarks it has to be seen if the customers who purchase the goods would be guided by the use of such word expression or would ignore it and give emphasis to prefixes or suffixes or words used in association therewith. The primary question to be asked is what would remain in the memory of customer? The surrounding circumstances such as the presentation of goods, colour scheme and lettering style etc., used on the packing also assume significance."*

46. In the case in hand, the mark 'TCV' as conceded

by Mr. Chandra is an abbreviation / acronym of ‘Typhoid Vi Capsular Polysaccharide Tetanus Toxoid Conjugate Vaccine’ / Typhoid Vi Conjugate Vaccine I.P. / ViP’s – TT’ (see Para 10 above), which being a descriptive word / generic term with regard to one vaccine for treating Typhoid, *prima facie* the mark ‘TCV’ could not have been registered and the registration to that extent is illegal.

47. Having said that, it is also a settled position of law that a generic / descriptive term / words can be registered provided they have acquired secondary meaning / distinctiveness.

48. Insofar as the submission of Mr. Chandra that the mark ‘TYPBAR-TCV/TCV’ has attained distinctiveness is concerned, this Court in *FDC Limited (supra)*, in paras 19 and 20 held as under:

*“19. In Godfrey Philips India v. Girnar Food and Beverages, 2005 (30) PTC 1 (SC) and Indian Shaving Products . Gift Pack, 1998 (18) PTC 698, it was held that even descriptive marks are capable of registration as trademarks, and their unauthorized use can amount to infringement, provided they attain that level distinctiveness,*

through sustained use and reputation, that a mere use of such generic term would immediately signify the plaintiff as its manufacturer. Therefore, in order to so find, that use of a descriptive term or a term that is publici juris, amounts to infringement, the plaintiff must establish that use of the term has become synonymous with its mark, or that the reputation of the mark is of such nature that the public is likely to get confused and would attribute the defendants' goods to the plaintiff's. The more descriptive the term employed or alleged to be infringing, higher the standard of evidence required to establish that term has in fact acquired secondary meaning and thereby, attained distinctiveness. (Emphasis supplied)

20. As to the standard of evidence required to demonstrate distinctiveness, it was held, in British Sugar [1996] RPC 281, that:

"There is an unspoken and illogical assumption that use equals distinctiveness. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word "Soap" as a purported trade mark for soap the word would not be distinctive of his goods."  
(internal quotes omitted)

In Bach Flower Remedies, [2000] RPC 513, the

*Court observed that:*

*"First, use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not so either. The use and increased use must be in a distinctive sense to have any materiality."*

*(Emphasis supplied)*

*In Broadhead (1950) 67 RPC 209, the Court, following the observation of Lord Russell in the much celebrated Coca Cola of Canada v. Pepsi Cola of Canada (1942) IA 2265/2007 in CS(OS) 334/2008 page No. 14 of 20 59 RPC 127, stated:*

*"Where you get a common denominator, you must in looking at the competing formulae pay much more regard to the parts of the formulae which are not common-although it does not flow from that that you must treat words as though the common part was not there at all."*

From the above, it is clear to establish that a generic / descriptive term / word has attained distinctiveness / secondary meaning, the plaintiff has to establish:

- (1) That the use of the term has become synonymous with its mark.
- (2) The quality or characteristic would be a material factor determining the purchasing

decision of significant portion of consumers.

Suffice would it be to state whether the marks 'TCV' / 'TYPBAR-TCV' have attained distinctiveness / secondary meaning can only be established during trial. It is the case of Mr. Sapra that there are no pleading in the plaint with regard to distinctiveness. I say nothing on that. The same shall be seen, at the time of final hearing following the trial.

49. In so far as the submission of Mr. Chandra that the mark 'ZYVAC-TCV' is deceptively similar to mark 'TYPBAR-TCV' is concerned the Supreme Court, in *Kaviraj Pandit Durga Dutt (supra)* has laid down a test in para 29 by stating as under:-

*"29.....But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks-the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of*

*the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff." (emphasis supplied)*

50. The Supreme Court, in ***Hoffman La Roche v. Geoffrey Manner and Co., 1969 (2) SCC 716***, approvingly quoted the following test for the comparison of marks from Pionotist Co., Ltd.'s Application, 23 R.P.C. 774:

*"You must take the two words. You must judge of 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. In fact, 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. If, considering all those circumstances, you come to the conclusion that there will be a confusion- that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods- then you may refuse the registration, or rather you must refuse the registration in that case."

**(emphasis supplied)**

51. The Court then proceeded to apply the test to the case and observed:

"In order to decide whether the word "DROPOVIT" is deceptively similar to the word "PROTOVIT" each of the two words must, therefore, be taken as a whole word. Each of the two words consists of eight letters, the last three letters are common, and in the uncommon part the first two are consonants, the next is the same vowel 'o', the next is a consonant and the fifth is again a common vowel 'o'. The combined effect is to produce an alliteration. The affidavits of the appellant indicate that the last three letters "VIT" is a well known common abbreviation used in the



pharmaceutical trade to denote Vitamin preparations. In his affidavit dated January 11, 1961 Frank Murdoch, has referred to the existence on the Register of about 57 trade marks which have the common suffix "VIT" indicating that the goods are vitamin preparations. It is apparent that the terminal syllable "VIT" in the two marks is both descriptive and common to the trade. If greater regard is paid to the uncommon element in these two words, it is difficult to hold that one will be mistaken for or confused with the other. The letters 'D' and 'P' in "DROPOVIT" and the corresponding letters 'P' and 'T' in "PROTOVIT" cannot possibly be slurred over in pronunciation and the words are so dissimilar that there is no reasonable probability of confusion between the words either from the visual or phonetic point of view."  
(emphasis supplied)

52. The aforesaid view was followed by the Supreme Court in *JR Kapoor v. Micronix India, (1994) Supp 3 SCC 215*, wherein the Court set aside the interim injunction in relation to the marks 'Micronix' and 'Microtel' by holding that the word 'micro' being descriptive of the technology used for producing electronic goods, no one could claim monopoly over the same and also its usage was not likely to be misleading / confusing.

The relevant paragraph reads as under:

*“6. There are two things which impress us. Firstly, the appellant is not manufacturing any one product such as the boosters, which has been mainly taken into consideration by the High Court. He is producing various electrical and electronic apparatus in many of which micro-chip technology is used. Even the boosters which he manufactures and sells are of two types, viz., transistorized boosters and Integrated Circuit boosters whereas the respondent-plaintiff manufacturers aerial boosters only of the first type. Thus micro-chip technology being the base of many of the products, the word 'micro' has much relevance in describing the products. Further, the word 'micro' being descriptive of the micro technology used for production of many electronic goods which daily come to the market, no one can claim monopoly over the use of the said word. Anyone producing any product with the use of micro chip technology would be justified in using the said word as a prefix to his trade name. What is further, those who are familiar with the use of electronic goods know fully well and are not only likely to be misguided or confused merely by, the prefix 'micro' in the trade name. Once, therefore, it is held that the word 'micro' is a common or general name descriptive of the products which are sold or of the technology by which the products are manufactured, and the users of such products are, therefore, not likely to be misguided or confused by the said word, the only question which has to be prima facie decided at this stage is whether the words 'tel' and 'nix' in the trade names of the appellant and the respondent are deceptive for the buyers and users and are likely to misguide or confuse them in purchasing one for the other. According to us, phonetically the words being totally dissimilar are not going to create any such confusion in the mind of the users.....” (Emphasis supplied)*

53. A Division Bench of this Court in *Astrazeneca UK Ltd v.*

*Orchid Chemicals, 2007 (34) PTC 469*, concluded that the prefix 'Mero' had become publici juris, and concluded that the marks 'Meronem' and 'Meromer' are *prima facie* dissimilar to each other. In *Apex Laboratories v. Zuventus Health Care, 2006 (33) PTC 492 (Mad) (DB)*, a similar proposition of law was articulated and a similar conclusion was arrived at in relation the marks 'Zincovit' and 'Zinconia'. The Court specifically reasoned that there was no visual or phonetic similarity and therefore, no deceptive similarity.”

54. Similarly, a Coordinate Bench of this Court in the case of *Superon Schweisstechnik India Limited v. Modi Hitech India Ltd., MANU/DE/1319/2018*, has, in paras 6 and 7 held as under:

“6. The facts of this case show that the plaintiff is selling its goods by using two trademarks SUPERON and VAC-PAC, whereas the defendant is selling its goods by use of its primary trademark GMM/arc with addition of the words VAC-PAC on the packaging. The colour combination of the packaging of the plaintiff is dark yellow with use of two other main colours being blue and black, whereas the main packaging of the defendant is of blue and white colour with use of the red colour for

*the words 'arc' which is part of the trademark GMM/arc, and there is also an expression 'Umesh Modi Group' appearing on the packaging of the defendant which is in red colour. We therefore will look at the issue with respect to entitlement of the reliefs claimed by the plaintiff on the ground that whether in the facts of the present case as hereinabove stated, can the defendant be said to be passing off its goods as that of the plaintiff.*

*7. On the aspect of passing off, in my opinion, the plaintiff has no real prospect to succeed in the suit. This is firstly because the main trademark of the plaintiff is SUPERON along with the added trademark of VAC-PAC whereas the main trademark of the defendant is totally different being GMM/arc with the use of VAC-PAC. There is no identity or deceptive similarity qua the aforesaid two main trademarks of the parties and the different trademarks are such to distinguish the goods of the plaintiff from that of the defendant, and hence no case is made out of passing off."*

*(emphasis supplied)*

55. Having noted the position of law and drawing inference from the above mentioned judgments, in the case in hand the main mark of the plaintiff is **'TYPBAR-TCV'**

with 'TCV' being generic abbreviation / acronym of 'Typhoid Conjugate Vaccine' which is not a coined word and being common to trade as such, needs to be excluded for comparison with 'ZYVAC' of the defendant. On such exclusion what remains is 'TYPBAR' of plaintiff and 'ZYVAC' of defendant No.2. These are the essential features of the marks of the parties and not 'TCV'. From the comparison of these two marks, there is no deceptive similarity between the two and as such there is no reasonable probability for confusion between the words either visually or phonetically. That apart, the reliance placed by Mr. Sapra on *Cadila Healthcare Limited v Dabur India Limited*, (1997) 17 PTC 417, wherein it is held that where suffix is common, the earlier portion of the word is natural, necessary and in fact, the actual mark of distinction is justified.

56. Further, I note in the written statement filed by defendant No.2, it is stated in para 13 of sub-para (iv) that the 'TCV', *per se* is not being used by the plaintiff and no evidence has been adduced to show use of the said words as a trade mark. This stand of the defendant No.2 though

denied, has not been substantiated by any document to show that the plaintiff is actually selling the vaccine under the mark 'TCV'.

57. It is a settled position of law in view of *Cluett Peabody & Co. Inc. (supra)*, which was followed in *Veerumal Praveen Kumar (supra)*, on which the reliance has been placed by Mr. Sapra, that if the mark is not used in commerce, it affords no rights. The relevant para in *Cluett Peabody & Co. Inc. (supra)* reads as under:

“37. XXX XXX XXX

*(g) Registration enables the registered proprietor to sue for infringement of registered trade mark irrespective of the fact whether it is used or not used. Registration confers on the proprietor a monopoly right over the use of the mark. But, proprietary rights in a trade mark acquired by use are superior to rights obtained by registration under the Act. This is the main defence put up on behalf of the defendants in this Notice of Motion. Therefore, prior user of the marks should be protected against monopoly rights conferred by the Act. (Pages 5 & 6 of Narayanan). A trade mark has no meaning even if it is registered unless it is used in relation to goods. Otherwise, its non-use may*

*lead to its death. A trade mark which drops out of the use dies. Where there are no goods offered for sale, there is no use of trade mark.”*

58. Similarly relevant portion in ***Veerumal Praveen Kumar (supra)*** reads as under:

29. *We are in agreement with the view of the learned Single Judge of the Bombay High Court that if there is non user for a long period of time then by mere registration of the mark continuing the respondents would not be entitled to any injunction. This view is further reinforced by the judgment in Imperial Group’s case (supra) wherein it was held that where there is no trading to give rise to a goodwill there is no interest to be protected by a trademark and such a trademark cannot exist in vacuum.”*

59. That apart, it is also noted that the plaintiff’s packaging of the vaccine is dark blue in colour whereas the defendant No.2’s is light blue. The words ‘TCV’ in the plaintiff’s packaging are written in orange whereas in the defendant No.2’s packaging, they are in green colour. Further what is significant is, on the packaging of both the parties the words *‘Typhoid Vi Capsular Polysaccharide*

*Tetanus Toxoid Conjugate Vaccine*’ (in the case of plaintiff) and *‘Typhoid Tetanus Toxoid Conjugated Vaccine*’ (in the case of defendant No.2) are written. The same clearly highlight / signifies the nature of the product, to be vaccine, that too of similar type. So, a consumer can easily make out what **‘TCV’** stands for.

60. Even the plea of Mr. Chandra that the words **‘TCV’** on the defendant’s packaging has a protective semi-circular shield similar to the one on the plaintiff’s packaging is also not appealing. The positioning of the shield on **‘TCV’** in both the cases is different and has no resemblance. The plea of Mr. Chandra that the plaintiff is the first manufacturer of the *‘Typhoid Conjugate Vaccine’* and as such is entitled to exclusive use of the trade mark **‘TCV’** is also not appealing.

61. Mr. Sapra is justified in relying on the conclusion of this Court in *Marico Limited (supra)*, wherein this Court has held as under:

*“6.....it is high time that those persons who are first of the blocks in using a trade mark which is a purely descriptive expression*



*pertaining to the subject product out to be discouraged from appropriating a descriptive expression or an expression which is more or less a descriptive expression as found in the English language for claiming the same to be an exclusive trademark and which descriptive word mark bears an indication to the product's kind, quality, use or characteristic etc. This is our view is in accordance with the spirit of various sub sections of Section 9 and Section 30 besides also Section 35 of the Act.”*

62. That apart, I have already held that ‘TCV’ being an abbreviation, is not capable of being registered as a trade mark and also that the mark ‘ZYVAC-TCV’ is not deceptively similar to the mark ‘TYPBAR-TCV’. So, it is inconsequential if the plaintiff is using ‘TYPBAR-TCV’ earlier to the defendants as one of the plea of Mr. Sapra was that the plaintiff is not the first one to adopt the words, ‘TCV’, inasmuch as the application for mark ‘TCV’ was first filed by one Sanjeev Thakkar, in relation to medicinal preparations in the year 2009. This aspect has not been denied by the plaintiff in its replication. The relevant part of the same reads as under:

***“D. "TCV"® has been continuously used by Plaintiff***

*13. The contents of paragraphs 31 to 34 of the Written Statement are denied in toto as false and incorrect, and reliance is placed on the documents and evidence placed on record with the plaint. It is denied that the TCV per se registration was obtained by Plaintiff without any bona fide intent of use, and on the contrary such trade mark has been extensively used by the Plaintiff and is recognized as belonging to the Plaintiff in the field of typhoid vaccines. It is denied that the registration for TCV is liable to be removed from the Register under Section 9 or any other ground. It is reiterated that the non-raising of Section 9 as an objection is clear proof that as of 2012 when the trade mark application was filed, Plaintiff was the first coiner and adopter of the expression in respect of typhoid vaccines. It is denied that there has been no use of TCV® as a trade mark by the Plaintiff, and on the contrary, the documents filed with plaint show that such mark is inextricably and indelibly associated in the minds of the public with the Plaintiff alone. It is further submitted that the submission regarding distinction between "prescription drugs" and*

*"over the counter' drugs has no merit or basis, in as much as it does not address the inherent confusion in the minds of the weaker sections of the patient population who may be sold the Defendant's product as "TCV" belonging to the Plaintiff."*

63. In the absence of denial, it must be held that Sanjeev Thakkar has coined the mark 'TCV' in 2009. That apart, during his submissions it was stated by Mr. Chandra that the plaintiff is not expected to sue all small time infringers who may not be affecting plaintiff's business by referring to the judgment of this Court in the case of *Pankaj Goel (supra)* is concerned, the same shall not help the case of the plaintiff as it is held by this Court in *FDC Ltd. (supra)* that the existence of third party / parties clearly depicts that medicinal products by different entities, with similar words 'TCV' can co-exist in the market without causing deception or confusion. It follows, there cannot be any claim for infringement or passing off.

64. That apart I also note, that the defendant No.2 has applied for registration of the mark "ZYVAC" only

and not 'TCV', which also demonstrate that the defendant No.2, do not intend to use the words "TCV" in a trade mark sense.

65. In so far as the judgments referred to by Mr. Chandra are concerned, he referred to *Satyam Infoway Ltd. (Supra)*, to contend that it is not necessary to establish long user, to establish reputation, it would depend upon the volume of sales and extent of advertisement. I may state here in view of my conclusion above, this judgment, has no applicability.

66. Further he has relied upon the Judgment of the Full Bench of the Bombay High Court in the case of *Lupin (supra)* to contend that there is a strong presumption in law as to the validity of registration of the mark. There is no dispute on the proposition it lays down. But in the facts of this case, as I have held, the registration of the words 'TCV' is *prima facie* invalid, the judgment has no applicability.

67. In so far as his reliance on the Judgment in the case of *Kumani Oil Industries Pvt. Ltd. (supra)* to contend that mere prefixing to a mark, the infringer

cannot defeat the legitimate rights of the plaintiff is concerned, I have already held, that the words 'TCV' are not capable of being used as a trade mark and the prefix "ZYVAC" is clearly different from the mark 'TYPBAR'. The Judgment is clearly distinguishable.

68. Similarly, *Patel Field Marshal Agencies (Supra)* shall also have no applicability. Rather the word 'TCV' being incapable of registration, this Court has *prima-facie* held the registration is invalid. An issue has to be framed as to the invalidity of the mark 'TCV' to enable defendant No.2 to approach the statutory authority to decide the same.

69. In so far as the Judgment in the case of *Sunil Mittal and Anr. (supra)* is concerned, the said Judgment is clearly distinguishable on facts inasmuch as this Court negated the argument that mark "Darzi" is generic / descriptive and by holding that the mark being used by the plaintiff for the last 20 years, granted injunction in favour of the plaintiff against the defendant.

70. In view of my above discussion, this Court is of the view that the plaintiff has not made out any case

for grant of interim relief, in the manner prayed for, in its favour. The application is accordingly dismissed. It is made clear that the aforesaid is a tentative view.

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71. List the matter before Joint Registrar on 3<sup>rd</sup> July, 2020, for marking exhibits.

**V. KAMESWAR RAO, J**

**MAY 26, 2020/jg/ak**

भारतमेव जयते