



2024:DHC:9102



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

% **Date of Decision: 12th November, 2024**

+ C.O.(COMM.IPD-CR) 9/2024

OPELLA HEALTHCARE GROUP

.....Petitioner

Through: Mr. C.A. Brijesh and Ms. Pragati
Agrawal, Advs.
M: 9599041991
Email: pragati.agrawal@remfry.com
Mr. Peeyoosh Kalra, Ms. V. Mohini
and Mr. Udayvir Rana, Advs.
M: 9910657461
Email: udayvir.rana@remfry.com

versus

VAIBHAV VOHRA & ANR.

.....Respondents

Through: Mr. Mohit and Mr. Jai Prakash, Advs.

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+ C.O. (COMM.IPD-TM) 92/2024

OPELLA HEALTHCARE GROUP

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Through: Mr. Peeyoosh Kalra, Ms. V. Mohini
and Mr. Udayvir Rana, Advs.
M: 9910657461
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versus

VAIBHAV VOHRA & ANR.

.....Respondents

Through: Mr. Mohit and Mr. Jai Prakash, Advs.

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA

MINI PUSHKARNA, J (ORAL)

1. The present petitions are filed seeking the following:

1.1 C.O. (COMM.IPD-TM) 92/2024 is filed under Sections 47 (1)(A) and



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57 of the Trade Marks Act, 1999 (“**Trade Marks Act**”) for rectification of the Trade Marks Register by removal of the impugned mark, i.e.



PHENSERYL/ registered in favour of respondent no. 1, bearing registration no. 3791026 in Class 5, on account of being phonetically, visually and deceptively similar to the petitioner’s mark.

1.2 C.O.(COMM.IPD-CR) 9/2024 is filed under Section 50 of the Copyrights Act, 1957 (“**Copyrights Act**”) read with Rule 71 (1) of the Copyright Rules, 2013 (“**Copyright Rules**”) for rectification of the Register of Copyright by removal of the impugned copyright, i.e.



with respect to the alleged artistic work, registered in favour of respondent no. 1, bearing Copyright registration no. A-130319/2019.

2. It is to be noted that the petitioner herein is also contesting a suit, i.e. CS (COMM) 552/2024, against respondent no. 1 herein. In the said suit, vide order dated 09th July, 2024, this Court has passed an order of interim injunction in favour of the petitioner/plaintiff, restraining the respondent no. 1/defendant from using the impugned mark, either as a trade name/corporate name/domain name, or in any manner, whatsoever.

3. Respondent no. 2 in both petitions, are a formal party, i.e. Registrar of Trade Marks and Registrar of Copyrights.

4. Facts, as canvassed in the petitions, are as, follows:

4.1. The petitioner is engaged in the business of development and



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distribution of therapeutic solutions, in this case, under the mark 'PHENSEDYL' which was adopted in the year 1954 for their pharmaceutical product created for treating allergic symptoms, like runny nose, watery eyes, sneezing and throat irritation.

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4.5 Thus, the present petitions came to be filed seeking rectification of the impugned trade mark bearing registration no. 3791026 and copyright bearing registration no. A-130319/2019, registered in favour of respondent no. 1, from the Register of Trade Marks and Register of Copyrights.

5. On behalf of the petitioner, the following submissions have been made:

5.1 The impugned mark is liable to be expunged from the Register as no *bona fide* use has been made by respondent no. 1, and any manner of usage is with a *mala fide* intention of associating its products with the petitioner.

5.2 The impugned mark registration is deceptively similar to the petitioner's much prior and well known trade marks PHENSEDYL/

PHENSEDYL, फेन्सिडिल and  and for similar goods. Therefore, the impugned mark would cause confusion and/or deception in the course of trade and will be mistaken for the petitioner's marks.

5.3 The petitioner's mark is a well known mark within the provisions of Article 6 *bis* of the Paris Convention and therefore, by virtue of long and extensive use along with publicity over the world, the petitioner's marks have carved a niche for itself. Therefore, the registration of the impugned mark is taking an unfair advantage and is detrimental to the distinctive character and repute of the petitioner's marks.

5.4 The petitioner's registered mark, 'PHENSEDYL' has a prior use since 1954, i.e. 70 years, and has used the mark for its products in India since 1995. Further, the mark is used on an international level across various countries for the products of the petitioner. Whereas, the impugned mark,



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i.e. 'PHENSERYL' has claimed user only since 01st December, 2016.

5.5 The petitioner has adopted and are using a unique, artistic and distinctive packaging comprising a unique colour combination blue and pink/red colour, comprising unique artwork with respect to the products under the petitioner's trade marks, 'PHENSEDYL' viz.



5.6 The packaging of the petitioner on the their products bearing the mark, 'PHENSEDYL' constitutes original 'artistic work' and has garnered a well known reputation, indicative of which are the sale figures of the petitioner over the years.

5.7 The *mala fide* of respondent no. 1 is evident from the fact that they are aware of the goodwill and reputation vesting in the artwork,



, and therefore, have commenced use of similar packaging/artwork and obtained registration of the same.

5.8 The impugned work of respondent no. 1 is an exact and verbatim copy along with substantial reproduction of the artwork in the petitioner's trademarks, therefore, any viewer would clearly get an unmistakable



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the petitioner's rights in their artwork.

5.10 The Registrar of Copyrights could not have issued the 'Clearance Certificate' on account of the registered trademarks of the petitioner, therefore, the grant of registration and Clearance Certificate is erroneous and liable to be cancelled.

5.11 The respondent no. 1 sought registration of the copyright work only to create *prima facie* evidence in its favour to lend weight to its alleged claim of being vested with the proprietary rights in the petitioner's mark/artwork. Therefore, where the dominant objective for registration of copyright was only to acquire legitimacy and not to copyright artistic work, the registration is liable to be removed.

5.12 The products of the both the parties are essentially a 'cough syrup' and 'cough medicine' which is a product 'sold Over the Counter'. Therefore, the same is likely to cause confusion for the general public. Furthermore, infringement or confusion in relation to pharmaceutical products, have to undergo high scrutiny.

5.13 The respondent no. 1 is a habitual offender and has been restrained from using several marks by this Court. To substantiate the same, the following judgements/orders are relied upon:

i. Dr. Reddy's Laboratories Limited Versus Pureca Laboratories Pvt. Ltd., CS (COMM) 221/2020.

ii. The Himalaya Drug Company & Ors. Versus Pureca Laboratories Pvt. Ltd., CS (COMM) 170/2020.

iii. M/s Antex Pharma Pvt. Ltd. Versus Pureca Laboratories (P) Ltd., CS (COMM) 1315/2016.

6. On behalf of respondent no. 1, the following submissions have been



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made:

6.1 There is no deceptive similarity between the marks of the petitioner and respondent no. 1. Further, the registered trademark of respondent no. 1, i.e. 'PHENSERYL' and colour, combination, character, packaging, logo are completely different from that of the Copyright and Trade Mark of the petitioner. Therefore, there is no likelihood of confusion being caused between the products.

6.2 The respondent no. 1's mark/artistic work are registered by complying all due process and law with a valid, *bona fide* and legal use. Further, when the mark was applied for, there was no objection from the Trade Marks Registry with regard to the plaintiff's product.

6.3 The name and address of respondent no. 1 appears on its packaging which is itself sufficient to distinguish the goods of respondent no. 1 from that of the petitioner's goods.

6.4 The artistic work in respondent no. 1's mark is a registered copyright and is different from that of the artistic work in the petitioner's mark. Further, the products sold by respondent no. 1 is under prescription and recommended by doctors, therefore, public or common man will not be confused by the name.

7. I have heard learned counsels for the parties and have perused the record.

8. At the outset, this Court notes that the petitioner has various trademark registrations under Class 05 in relation to its mark, 'PHENSEDYL', which are valid and subsisting. Further, the usage of the said marks dates back as far as 21st July, 1954. The registrations in favour of the petitioner, are reproduced as under:



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S. No.	Trade Mark	Registration No. / Dated	Class	Goods	Status
1.	PHENSEDYL	165059 July 21, 1954	5	'pharmaceutical preparations and substances for human use and veterinary use'	Registered and valid upto July 21, 2030.
2.	फेन्सिडिल	789677 February 2, 1998	5	'pharmaceutical products'	Registered and valid upto

S. No.	Trade Mark	Registration No. / Dated	Class	Goods	Status
					February 2, 2025
3.		795369 March 17, 1998	5	Pharmaceutical products in Class 05'	Registered and valid upto March 17, 2028

9. The petitioner has also substantially demonstrated their usage of the marks, as can be made out through their sales under the said mark. Table showing the sales figures from the year 2014 to 2023 is reproduced as under:

Year	Net Sales (In Euro Millions)	Net Sales (In INR Crores)
2014	31,380	2,84,00
2015	34,060	3,08,30
2016	33,809	3,06,00
2017	35,072	3,17,40
2018	34,160	3,14,00
2019	36,126	3,27,020
2020	36,041	3,26,751
2021	37,761	3,42,00
2022	42,800	3,91,00
2023	43,070	3,91,00

10. It is to be noted that the petitioner has been operating, marketing and selling its products in India through its sub-licencees, Rhone Poulenc India Ltd., since 1995, and Abbott Healthcare Pvt. Ltd. since 2010, through sub-



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licensor, Piramal Pharma Ltd. Thus, on account of the same, it becomes manifest that in India, the petitioner has been extensively, continuously and regularly using its trademarks, PHENSEDYL/ **PHENSEDYL**, फेन्सिडिल and



11. On the other hand, the respondent no. 1 has claimed user in his impugned mark, i.e. 'PHENSERYL' since 01st December, 2016. Furthermore, there is no supporting evidence brought on record to show any sales or user of the said mark by respondent no. 1. The contention as put forth by the said respondent is solely on the lines of its registrations being granted by the Trade Marks and Copyrights Registry, and a blanket denial of deception or resemblance with the petitioner's marks or artistic work, therein.

12. Hence, it is indisputably established that the marks of the petitioner have a prior user, with the petitioner having its user in India, since 1995. While, the user of the respondent no. 1 is claimed to be only since 01st December, 2016.

13. It would be pertinent to compare the two marks, along with the artistic works therein. A comparative table is reproduced, as under:

DESCRIPTION	PETITIONER	RESPONDENT NO. 1
Trade Mark <i>(Word & Label/Device)</i>	PHENSEDYL 	PHENSERYL 



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Copyright		
Product		

14. Comparisons of the two marks, makes it evident that the respondent no. 1's mark 'PHENSERYL' is visually and phonetically similar to the petitioner's mark, 'PHENSEDYL'. Further, the colour dark blue in the trade dress/packaging and the white font to depict the name, are the prominent and dominant part of both the marks and/or the artistic work, therein.

15. The artistic work in the packaging/label, as shown above, indicates that the respondent no. 1 has attempted to bring his packaging as close as possible, to that of the petitioner's packaging. The usage of the dark blue colour, white font, blue and pink/red combination as is being used by the petitioner in their packaging, is being used by respondent no. 1 in a similar manner.

16. Further, it is to be noted that the products, i.e. cough syrups, are also similar in their manner of design, especially, to the aspect of usage of the dark blue colour, white font and the blue-pink/red combination, which is the theme as followed by the petitioner in their products and in a similar manner by respondent no. 1, in their products.



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17. Therefore, it is manifest that the marks of the respondent no. 1 are likely to cause confusion and give the general impression that the same may be associated with the petitioner. The consumers and members of the trade, are likely to be confused, or deceived into believing, that the respondent no. 1 is associated with the petitioner, or is selling the goods originating from the petitioner.

18. Holding that Courts have to maintain the purity of the Register and the Register should not contain marks, which are likely to confuse or deceive an unwary purchaser, the Division Bench of Bombay High Court in the case of *Ciba Ltd. Basle Switzerland Versus M. Ramalingam and S. Subramaniam trading in the name of South Indian Manufacturing Co., Madura and another*, 1957 SCC OnLine Bom 45, has held as follows:

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5. Now, in considering both S. 46 and S. 10 it has got to be remembered that the primary duty of the Court is towards the public and the maintenance of the purity of the register. When a case is sought to be made out that a particular trade mark is likely to deceive or cause confusion, the contest is not so much between the parties to the litigation as it is a contest between the party defending his right to a particular trade mark and the public, and the duty of the Court must always be to protect the public irrespective of what hardship or inconvenience it may cause to a particular party whose trade mark is likely to deceive or cause confusion. The object of maintaining a trade mark register is that the public should know whose goods they are buying and with whom particular goods are associated. It is therefore essential that the register should not contain trade marks which are identical or which so closely resemble each other that an unwary purchaser may be likely to be deceived by thinking that he is buying the goods of a particular person or a particular firm or a particular industry, whereas he is buying the goods of another person or firm or industry.

(Emphasis Supplied)

19. Likewise, holding that deceptive similarity or confusion is the



principle criterion for determining applications both for registration as also for rectification, and that purity of register is to be maintained, Supreme Court in the case of *Khoday Distilleries Limited Versus Scotch Whisky Association and Others*, 2008 SCC OnLine SC 975, has held as follows:-

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29. **Indisputably, the purity of the register is to be maintained. Indisputably again, the public interest has to be kept in view. An application for registration has also to be considered keeping the public interest in view. What is therefore necessary for the Registrar is to arrive at a conclusion as regards registration of mark, is as to whether having regard to the nature of the mark sought to be registered and the use thereof as also the class of buyers (sic they) would be deceived or confused with the mark registered or not.**

30. An application for rectification and correction of the register may be entertained if any of the grounds specified therein exist viz. contravention or failure to observe the condition entered on the register or in relation thereto. An application for rectification and correction of the register would also be maintainable if a person is 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.

31. The power of the Registrar in terms of Section 56 of the Act is wide. Sub-places. It enables a person aggrieved to file an application. It enables the Tribunal to make such order as it may think fit. **It may not, therefore, be correct to contend that the delay or acquiescence or waiver or any other principle analogous thereto would apply under no circumstances. Purity of register as also the public interest would indisputably be relevant considerations.** But, when a discretionary jurisdiction has been conferred on a statutory authority, the same although would be required to be considered on objective criteria but as a legal principle it cannot be said that the delay leading to acquiescence or waiver or abandonment will have no role to play. (See *Ciba Ltd. v. M. Ramalingam* [AIR 1958 Bom 56]). In determining the said question, therefore, conduct of the person aggrieved in filing the application for rectification would be relevant. For the aforementioned purpose, whether it is a class or group action or a private action although would be relevant but may not be decisive. It is one thing to say that class or group action will receive special attention of the statutory authority vis-à-vis a private action. But, in both types of cases, public interest should remain uppermost in the mind of the authority. **The question which is required to be posed therefore would be**



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as to whether the public in general or the class of buyers would be deceived or be confused if the existing mark is allowed to remain on the register. Thus, deceptive similarity or confusion is the principal criterion for determining applications both for registration as also for rectification.

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(Emphasis Supplied)

20. It is also apposite to consider that the products sold by the parties are clearly those which are sold as Over the Counter products. Therefore, the argument by learned counsel for respondent no. 1, that the products are sold through doctor's prescription, is unacceptable. Furthermore, the same being pharmaceutical products, require a higher degree of scrutiny and care. Thus, Supreme Court in the case of ***Milmet Oftho Industries and Another v. Allergan Inc., (2004) 12 SCC 624***, while holding that judicial scrutiny is required in case of medicinal products, even if the same are prescription drugs, but which look alike or sound alike, has held as follows:

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7. In the case of Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd. [(2001) 5 SCC 73: 2001 PTC 300] the question was whether the

court refused interim injunction. The appeal was also dismissed. This Court did not interfere on the ground that the matter required evidence on merits but laid down principles on which such cases were required to be decided. This Court held that in a passing-off action for deciding the question of deceptive similarity the following facts had to be taken into consideration: (SCC p. 95, para 35)

word marks or label marks or composite marks i.e. both words and label works.

(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect of which they are used as trade marks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.



(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods.

(g) Any other surrounding circumstances which may be relevant

In respect of medicinal products it was held that exacting judicial scrutiny is required if there was a possibility of confusion over marks on medicinal products because the potential harm may be far more dire than that in confusion over ordinary consumer products. It was held that even though certain products may not be sold across the counter, nevertheless, it was not uncommon that because of lack of competence or otherwise mistakes arise specially where the trade marks are deceptively similar. It was held that confusion and mistakes could arise even for prescription drugs where similar goods are marketed under marks which looked alike and sound alike. It was held that physicians are not immune from confusion or mistake. It was held that it was common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently the handwriting is not legible. It was held that these facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike.

(Emphasis Supplied)

21. This Court in the case of ***Hugo Boss Trademark Management GmbH and Company Versus Sandeep Arora Trading as Arras the Boss and Others, 2023 SCC OnLine Del 7956***, while dealing with a case, wherein, the copyright registration in favour of the respondent therein, was found to be infringing the trademarks registration of the petitioner therein, held that though trademarks and copyrights operate under different statutes, rights in an artistic work for copyrights, could overlap with label marks registrable under the Trade Marks Act. It was held that an identical mark being used as an artistic work, as copyright, would result in infringement of an existing trademark. Thus, it was held as follows:



15. This Court notes that Section 45 of the Act clearly specifies that when any person is seeking copyright registration for artistic works used or potentially used in connection with goods or services, the application for copyright registration must include a statement acknowledging this use. **Additionally, the said application must include a certificate from the Registrar of Trade Marks that no trade mark identical or deceptively similar to the artistic work has been registered or applied for by anyone other than the applicant. This requirement ensures that the artistic work does not infringe upon existing trade marks.** Section 45 of the Act is set out below:

Entries in register of copyrights. (1) The author or publisher of, or the owner of or other person interested in the copyright in, any work may make an application in the prescribed form accompanied by the prescribed fee to the Registrar of Copyrights for entering particulars of the work in the register of copyrights:

Provided that in respect of an artistic work which is used or is capable of being used in relation to any goods or services, the application shall include a statement to that effect and shall be accompanied by a certificate from the Registrar of Trade Marks referred to in Section 3 of the Trade Marks Act, 1999 (47 of 1999), to the effect that no trade mark identical with or deceptively similar to such artistic work has been registered under that Act in the name of, or that no application has been made under that Act for such registration by, any person other than the applicant.

(2) On receipt of an application in respect of any work under sub-section (1), the Registrar of Copyrights may, after holding such inquiry as he may deem fit, enter the particulars of the work in the register of copyrights.

16. Vide judgment dated 20-4-2018, this Court in *Marico Ltd. v. Jagit Kaur* [Marico Ltd. v. Jagit Kaur, 2018 SCC OnLine Del 8488] had observed **that though trade marks and copyrights operate under different statutes, since rights in an original artistic work could overlap with label marks registrable under the Trade Marks Act, 1999, the legislature in its wisdom added a proviso to Section 45 in the Copyright Act. Clearly, this proviso has been inserted into the Act to prevent unscrupulous persons from copying label marks with the intention of passing off and taking shelter under a false claim of ownership of copyright in an artistic work. Unquestionably, this proviso would be applicable in this case as well.**



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26. In terms of Section 13(1)(a) of the Act, in order to be able to obtain copyright protection, an artistic work would be required to meet the threshold of originality. After perusing the above table, it is evident that the impugned artistic work is definitely not an original

not belong to Respondent 1. **Even the colour scheme of the petitioner has been substantially imitated by Respondent 1, which would also supplement the finding that the impugned registration is not an original work.**

27. Recently, vide judgment dated 6-9-2023, this Court in, Manju Singal v. Deepak Kumar [Manju Singal v. Deepak Kumar, 2023 SCC OnLine Del 5503], **while referring to the commentary, The Modern Law of Copyright and Designs, 4th Edn. by Laddie, Prescott and Vitoria, has emphasised that in discussions of “originality” and “substantial part”, it is crucial to understand that if there is substantial similarity between two works, the later work cannot be considered original.** The relevant extract from the same is set out below: (SCC OnLine Del para 22)

The key question is, therefore: has the second man taken a substantial part of what the first man has created? The

merely the object in which the creation is embodied, as may be seen from the fact that the copyright in the work survives accidental destruction of the artefact. As was well put by Prichard, J. in a New Zealand case:

It is not enough that there is a causal connection with a drawing in which the plaintiff owns copyright. There must also be such similarity between the article made by the defendant and a drawing in which the plaintiff has copyright that it be seen that a substantial amount of the skill and effort which was devoted to can making the drawing was appropriated by the defendant.

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4.37. Whether or not a substantial part has been reproduced must be determined by reference to the copyright work and not the work that is alleged to infringe. The question in any particular case is whether the features found to have been copied from the copyright work formed a substantial part of that work as an artistic work. That is a question of judgment or impression. However, in answering it, it is not generally



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relevant to consider whether the features that are alleged to have been copied also comprise a substantial part of the alleged infringing work. As a result, even though the alleged infringing work may not look particularly similar to the copyright work, it may amount to an infringement. That said,

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23.1 The trademark registration for the mark PHENSERYL/



registered in favour of respondent no. 1, bearing registration no. 3791026 in Class 5, is hereby cancelled.



23.2 The copyright registration with respect to the artistic work, registered in favour of respondent no. 1, bearing Copyright registration no. A-130319/2019, is hereby cancelled.

23.3 The Registrar of Trademarks and the Registrar of Copyrights, are directed to remove and expunge the aforesaid entries from the Register of Trademarks and Copyrights, respectively.

24. The Registry is directed to supply a copy of the present order to the Office of the Controller General of Patents, Designs and Trade Marks of India, on E-mail Id: llc-ipo@gov.in, for compliance.

25. The present petitions are, accordingly, disposed of, with the aforesaid directions.

MINI PUSHKARNA, J

NOVEMBER 12, 2024/kr