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

+ **CS(COMM) 516/2023, I.A. 14145/2023 & I.A. 3116/2024**

ZYDUS HEALTHCARE LIMITED & ORS.Plaintiffs

Through: Mr. Chander M. Lall, Sr. Adv. with
Ms. Aadya Chawla, Ms. Nandini
Choudhary, Mr. Abhinav Bhalla and
Ms. Annanya Mehan, Advs.
M: 9599547073
Email: nandini@singhandsingh.com

versus

ALDER BIOCHEM PRIVATE LIMITEDDefendant

Through: Mr. J. Sai Deepak, Mr. Ankur Sangal,
Ms. Sucheta Roy and Mr. Kiratraj and
Sadana, Advs.

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA

J U D G M E N T

13.11.2024

MINI PUSHKARNA, J:

I.A. 14145/2023 (Application under Order XXXIX Rules 1 & 2 read with Section 151 CPC, 1908)

1. The present application has been filed on behalf of the plaintiffs under Order XXXIX Rules 1 and 2 of Code of Civil Procedure, 1908 ("CPC") seeking interim injunction for restraining the defendant from manufacturing, selling, offering for sale, advertising and/or promoting by using the mark/ trade name 'ALDER BIOCHEM' and any other mark/ trade name/ label/ device that contains the trademark BIOCHEM.

2. The facts as pleaded by the plaintiffs, are as follows:



2.1 The present suit relates to the defendant's adoption of the identical



and deceptively similar mark ‘ALDER BIOCHEM’ and the trade name ‘Alder Biochem Pvt. Ltd.’ in relation to pharmaceutical goods, which amounts to infringement of the plaintiffs’ registered trademark ‘BIOCHEM’ under Section 29 of the Trade Marks Act, 1999 (“Trade Marks Act”), as well as passing off.

2.2 The trademark BIOCHEM (device) is registered in the name of plaintiff no.1 and is being used by the plaintiff nos. 1 and 3 on pharmaceutical products. The trademark BIOCHEM was coined and first adopted by the entity named, Biochem Pharmaceutical Industries, in the year 1959. Thereafter, in the year 2004 Biochem Pharmaceutical Industries converted from a partnership to a company under the name Biochem Pharmaceutical Industries Ltd., which was subsequently amalgamated with Zydus Healthcare Ltd., plaintiff no.1 herein. Consequently, all the intellectual property of Biochem Pharmaceutical Industries, including, the trademark BIOCHEM, were transferred to the plaintiff no.1. Thus, plaintiff no.1 is presently the registered proprietor of the trademark BIOCHEM.

2.3 The details of the trade registrations of BIOCHEM, in the name of plaintiff no.1, are as follows:

Sr. No.	Trade mark	Proprietor	Application date	Application No.	Class & goods	User date
1.		Zydus Healthcare Limited Plaintiff No. 1 herein	March 9, 1961	201091	Class 5 Pharmaceutical Products	January 1, 1959
2.		Zydus Healthcare Limited Plaintiff No. 1 herein	October 22, 1991	560743	Class 5 Pharmaceutical, Medicinal and Veterinary Preparations	Proposed to be used



2.4 The trademarks of the plaintiffs are valid and subsisting as on date.

2.5 In May, 2022, the plaintiff no.1's representatives in Delhi came across an application filed by the defendant for registration of the mark 'ALDER BIOCHEM' under Application No. 4491294 in Class 5, claiming use since 01st January, 2019. Plaintiff no.1 immediately issued a Cease and Desist Legal Notice dated 04th May, 2022 to the defendant. On 01st August, 2022, the defendant issued a reply in response to the plaintiff no.1's legal notice, refuting the plaintiff no.1's averments. The defendant stated that it commenced usage of the trade name Alder Biochem Pvt. Ltd. in the year 2016, though the defendant's trademark application claimed use of the impugned mark since January, 2019.

2.6 Thereafter, in the last week of April, 2023, the plaintiff no.1's representatives came across another application filed by the defendant for registration of the device mark Alder Biochem



AlderBiochem

under application no. 4495449 in Class 5.

The said trademark application claims usage since 01st January, 2019. The plaintiff no.1 immediately filed a notice of opposition dated 28th April, 2023 against the said trademark application, which opposition proceedings, are presently pending before the Trade Marks Registry.

2.7 Plaintiff no.1 and its wholly owned subsidiary-plaintiff no. 3, has been using the trademark BIOCHEM on more than 500 of their pharmaceutical products. The said trademark BIOCHEM has generated huge



reputation and goodwill for the plaintiffs over several years. The defendant had subsequently commenced usage of the mark BIOCHEM as part of its infringing trade name ALDER BIOCHEM Pvt. Ltd.

2.8 The defendant has also applied for registration of the infringing word mark ALDER BIOCHEM under Application No. 4491294 in Class 5 for pharmaceutical products on 24th April, 2020, claiming user date since 01st January, 2019. The defendant has also applied for registration of the infringing device mark ALDER BIOCHEM in Class 5 for pharmaceutical products on 04th May, 2020, claiming user date since 01st January, 2019.

2.9 The impugned mark/name ALDER BIOCHEM of the defendant amounts to a brazen violation of the intellectual property rights of the plaintiff, owing to visual, phonetic and structural identity and deceptive similarity of the impugned mark with the plaintiff no.1's registered trademarks and plaintiff no.2's trade name. Thus, the present application has been filed along with the suit.

3. On behalf of the plaintiffs, the following submissions have been raised:

3.1 Defendant has not provided any reasonable explanation as to why it has adopted the mark BIOCHEM. In its reply to the plaintiffs' legal notice, the defendant has claimed that BIOCHEM is a common word in public domain, over which no one can have exclusivity. However, in its reply to examination report dated 30th September, 2020, the defendant has categorically stated that the word is unique and forms the part of its trademark.

3.2 Defendant has sought to contend that BIOCHEM being an abbreviation of the words Biochemical or Biochemistry, is a generic/



descriptive word. However, the dictionary words and abbreviation meanings of Biochemistry and Biochemical make it clear that the abbreviation BIOCHEM does not by itself mean pharmaceutical products.

3.3 Even if it were to be accepted that BIOCHEM is a dictionary word, it is well settled that dictionary words and abbreviation can also be protected as a trademark.

3.4 Plaintiffs' trademark BIOCHEM has acquired secondary meaning through continuous use since 1959.

3.5 Adoption and usage of the mark BIOCHEM by the defendant is completely dishonest, illegal and *mala fide* with a view to make monetary gain out of plaintiffs' brand. The brand BIOCHEM is one of the most well known and recognized pharmaceutical names in India, which fact is well within the knowledge of the defendant. The defendant has copied the said registered trademarks of the plaintiffs in order to unlawfully exploit the enormous goodwill and reputation in the said brand of the plaintiffs.

3.6 The prominent and essential part of the plaintiffs' registered trademark is the word BIOCHEM. Therefore, adoption of the word BIOCHEM by the defendant amounts to infringement of the plaintiffs' trademark.

3.7 The defendant has falsely claimed that its trademark is only ALDER and not BIOCHEM. This is blatantly false since the manner of use of the impugned mark by the defendant on its products, its website and Facebook page, shows that ALDER and BIOCHEM are always written together and in the same font size. Thus, both ALDER and BIOCHEM are prominent and essential parts of the defendant's mark.

3.8 The defendant's contention that there are several companies on the



Register of Companies having the mark BIOCHEM as part of their corporate name, is of no relevance. At least thirty companies in the list given by the defendants are not active, and have been struck off. The defendant has failed to put on record a single instance of usage of the mark BIOCHEM by the third parties for pharmaceutical products.

3.9 Defendant is estopped from claiming that the mark is generic, after having itself applied for registration of the trademark ALDER BIOCHEM.

3.10 Balance of convenience lies in favour of the plaintiff, as no sales under the infringing mark ALDER BIOCHEM have been made by the defendant.

4. On the other hand, following submissions have been made on behalf of the defendant:

4.1 The defendant company was incorporated under the name Alder Biochem Pvt. Ltd. in and around 2016. The trademark/trade name adopted and being used by the defendant is ALDER BIOCHEM/ device



AlderBiochem .

4.2 The defendant has adopted sub-brands under the prefix ALDER such as ALDER Vit-e-400, ALDERKUFF, ALDER NERVIVE, ALDER GEM, ALDER D3, etc., which show that the primary trademark of the defendant is the mark ALDER. The word BIOCHEM has been added to denote that the defendant deals with pharmaceuticals, i.e., chemical products to treat biological ailments.

4.3 Plaintiffs do not have an exclusive right on the word BIOCHEM.



Admittedly, the plaintiffs do not have a registration for the word mark BIOCHEM, *per se*.

4.4 As per Section 17(2)(a) of the Trade Marks Act, the plaintiffs cannot claim any exclusive right over the word BIOCHEM by virtue of their trademark registrations for the device marks of BIOCHEM, as admittedly, the word BIOCHEM is not the subject of a separate application and is not separately registered by the proprietor.

4.5 The plaintiffs cannot claim any exclusive right over the word BIOCHEM by virtue of their device mark registrations, as under Section 17(2)(b) of Trade Marks Act, the word BIOCHEM is common to the trade, having non-distinctive character.

4.6 The word BIOCHEM is non-distinctive, as it is a commonly used abbreviation of the words biology and chemistry, which are common words in the pharmaceutical industry. The use of the word BIOCHEM by the defendant is as per the honest practice of trade.

4.7 More than 100 companies are using the mark BIOCHEM as part of their corporate name. There are various third parties registered trademarks with the word BIOCHEM.

4.8 Establishing that a generic/ non-distinctive word has acquired secondary meaning, is a matter of evidence.

4.9 The defendant has not applied for registration of the word BIOCHEM. It has applied for registration of the trademark 'ALDER BIOCHEM' as a whole. Hence, it is not estopped from claiming that the mark BIOCHEM is generic.

4.10 On a bare comparison of the rival marks as whole, it is evident that there is no similarity between the plaintiffs' and the defendant's marks. The



only common element of the marks, in comparison, is the word BIOCHEM, which is generic and descriptive to the pharmaceutical industry.

4.11 As the two marks are not identical, the likelihood of confusion is not presumed. On comparing the marks as a whole, it is evident that there is no similarity between the plaintiffs' and defendant's mark and there is no likelihood of confusion.

4.12 The plaintiffs cannot claim exclusivity on the word mark BIOCHEM in the pharmaceutical industry. In the examination reports issued by the Trade Marks Registry with respect to the defendant's Trademark Application nos. 4491294 and 4495449, respectively, neither the plaintiffs mark nor any other BIOCHEM formative marks were cited. Hence, even as per the Trade Marks Registry there is no exclusive protection granted to the word BIOCHEM.

4.13 The plaintiff has failed to establish the reputation and goodwill in their trademark. The use of the trademark BIOCHEM by the plaintiffs is not standalone, as the said mark is always used by the plaintiffs in form of a device mark.

4.14 There is no misrepresentation by the defendant which could deceive the customers.

4.15 There is no likelihood of confusion, as the products of the plaintiffs and the defendant, are sold under their respective trademarks, and the house



, and ALDER



AlderBiochem, respectively.

5. I have heard learned counsel for the parties and have perused the record.

6. Perusal of the documents and pleadings on record manifest that the trademark 'BIOCHEM' was coined and first adopted by the predecessor-in-interest of the plaintiff no. 1 in the year 1961. The trademark 'BIOCHEM' is being used by plaintiff nos. 1 and 3, on more than 500 of their pharmaceutical products. Further, the trademark 'BIOCHEM' forms an inseparable and essential part of the plaintiff no. 2 company's name.

7. The plaintiff no. 1 is the registered proprietor of the device marks




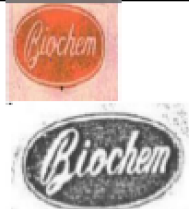
and under registration nos. 201091 and 560743 in

Class 5 since 9th March, 1961 and 22nd October, 1991, respectively. It is to be noted that the sales figures of the plaintiff nos. 1 and 3 for their products, primarily including products bearing the trademark 'BIOCHEM', crossed Rs. 160 crores in 2016 and was approximately Rs. 240 crores in 2022.

8. The defendant has subsequently adopted the mark 'ALDER BIOCHEM' by adding the prefix ALDER to the registered mark of the plaintiffs' 'BIOCHEM'. The defendant has placed on record the invoices to show the sale of its products under the impugned name. It is to be noted that the earliest invoice filed by the defendant is dated 16th May, 2022. Evidently, the plaintiff has established its prior user of the mark 'BIOCHEM'.



9. A comparison of the rival marks is reproduced hereunder, for reference:

DEFENDANT'S TRADEMARK	PLAINTIFFS' TRADEMARK
	

10. A side by side comparison of the defendants' mark with that of the plaintiffs' mark, makes it evident that the defendant has slavishly imitated the mark of the plaintiff by adding a prefix ALDER. The prominent and essential part of the plaintiffs' registered device marks 'BIOCHEM', is the word 'BIOCHEM'. Thus, it is apparent that the essential features of the trademark of the plaintiff have been adopted by the defendant, and the mark adopted by the defendant resembles the plaintiffs' mark in a substantial degree. The plaintiffs having established their first user of the mark 'BIOCHEM', the defendant cannot copy the essential/predominant part of the plaintiffs' marks. The overall similarity between the two marks in respect of the same description of goods is likely to cause confusion. Adding of a prefix by the defendant is immaterial, and does not deter from the fact that the impugned mark of the defendant is deceptively similar to the mark of the plaintiff.

11. Thus, relying upon the judgments of Supreme Court to hold that the question whether two competing marks are so similar as to likely to deceive or cause confusion, is one of first impression and has to be approached from



the point view of a man of an average intelligence and imperfect recollection, this Court in the case of *Subhash Chand Bansal Versus Khadim's and Another*, 2012 SCC OnLine Del 4326, has held as follows:

“xxx xxx xxx

19. I had the occasion to consider somewhat similar issue in Greaves Cotton Ltd. v. Mohamamd Rafi [2011 (46) PTC 468 (Del.)]. In that case, the plaintiff was the registered proprietor of the trademark ‘GREAVES’ which was also being used by it as a part of its corporate name. Defendant no. 1 before this Court had applied for registration of the trademark “GREAVES INDIA”. Holding that the plaintiff was entitled to permanent injunction against use of the impugned mark, this Court, inter alia, held as under:

“12. It is not necessary that in order to constitute infringement, the impugned trademark should be an absolute replica of the registered trademark of the plaintiff. When the mark of the defendant is not identical to the mark of the plaintiff, it would be necessary for the plaintiff to establish that the mark being used by the defendant resembles his mark to such an extent that it is likely to deceive or cause confusion and that the user of the impugned trademark is in relation to the goods in respect of which the plaintiff has obtained registration in his favour. It will be sufficient if the plaintiff is able to show that the trademark adopted by the defendant resembles its trademark in a substantial degree, on account of extensive use of the main features found in his trademark. In fact, any intelligent person, seeking to encash upon the goodwill and reputation of a well-established trademark, would make some minor changes here and there so as to claim in the event of a suit or other proceeding, being initiated against him that the trademark being used by him, does not constitute infringement of the trademark, ownership of which vests in some other person. But, such rather minor variations or distinguishing features would not deprive the plaintiff of injunction in case resemblance in the two trademarks is found to be substantial, to the extent that the impugned trademark is found to be similar to the registered trademark of the plaintiff. But, such malpractices are not acceptable and such a use cannot be permitted since this is actuated by a dishonest intention to take pecuniary advantage of the goodwill and brand image which the registered mark enjoys, it is also likely to create at least initial confusion in the mind of a consumer with average



intelligence and imperfect recollection. It may also result in giving an unfair advantage to the infringer by creating an initial interest in the customer, who on account of such deceptive use of the registered trademark may end up buying the product of the infringer, though after knowing, either on account of difference in packaging etc. or on account of use of prefixes or suffixes that the product which he is buying is not the product of the plaintiff, but is the product of the defendant.

13. As held by the Supreme Court in Amritdhara Pharmacy v. Satyadeo Gupta, AIR 1963 SC 449, whether a trade name is likely to deceive or cause confusion by its resemblance to another mark already registered is a matter of first impression and the standard of comparison to be adopted in judging the resemblance is from the point of view of a man of average intelligence and imperfect recollection. What is important to keep in mind that the purchaser does not have both the marks lying side by side for comparison and, therefore, chances of deception are rather strong.

14. In a case based on infringement of a registered trademark, the plaintiff need not prove anything more than the use of its registered trademark by the defendant. In such a case, even if the defendant is able to show that on account of use of other words by him in conjunction with the registered word/mark of the plaintiff, there would be no confusion in the mind of the customer when he come across the product of the defendant and/or that on account of the packaging, get up and the manner of writing trademark on the packaging, it is possible for the consumer to distinguish his product from that of the plaintiff, he would still be liable for infringement of the registered trademark.”

xxx xxx xxx”

(Emphasis Supplied)

12. There is no doubt that the rival marks are structurally, phonetically and visually, deceptively and/or confusingly similar to each other. Confusion is bound to take place as the rival marks are used in respect of similar goods, i.e., Pharmaceuticals, and the trade channels as well as the purchasing public/target consumer are likely to overlap. Mere adding of a prefix by the defendant is inconsequential and will make no difference, as



the two marks are substantially and deceptively similar to each other. In fact, the defendant's mark wholly subsumes the mark of the plaintiffs. Thus, in the case of *Living Media India Limited and Another Versus Aabtak Channel. Com (John Does) and Others*, 2023 SCC Online Del 5680, it was held as follows:

“xxx xxx xxx

18. Defendants 15 to 19, in their written statement, do not urge any ground which would entitle them to be treated differently from Defendants 1 to 14 and 20 to 30. The only ground taken by Defendants 15 to 19 in their written statement is that the plaintiffs



could not dissect the registered 'आ तक' mark and claim exclusivity over the “TAK” suffix inasmuch as the “TAK” suffix has not been separately registered as a mark. The judgment of a Division Bench of this Court in South India Beverages¹ is a complete answer to the said contention. In South India Beverages, the Division Bench of this Court has engrafted an exception to the anti-dissection rule contained in Section 17(2) of the Trade Marks Act, where the common part of the rival marks can be treated as a dominant part. In that event, the Division Bench has held that, on the basis of commonality of the dominant part of the marks, the Court can arrive at a finding that the marks are deceptively similar to each other. The Court has also observed that, by so holding, the Court is not transgressing the mandate of Section 17 of the Trade Marks Act, as the dominant part of the rival marks is being used as representative of the marks as a whole.

xxx xxx xxx”

(Emphasis Supplied)

13. Clearly, the adoption of the prominent and essential part of the plaintiffs' mark by the defendant, amounts to infringement. Thus, holding that dominant features are significant because they attract attention and consumers are more likely to remember and rely on them for purposes of

¹ 2014 SCC OnLine Del 1953



identification of the product, this Court in the case of *Blue Heaven Cosmetics Private Limited Versus Deepak Arora and Another*, 2022 SCC Online Del 1001, has held as follows:

“xxx xxx xxx

25. Respondent No. 1 in the present case has appropriated the word ‘Heaven’ and the blue logo colour from the mark of the Petitioner. The test of confusion in case of composite marks is well settled in the case of *South India Beverages Pvt. Ltd. v. General Mills Marketing Inc.*, (2015) 61 PTC 231 where, while holding that ‘DAZS’ is an essential and dominant feature of the Plaintiff’s mark, the Court was of the opinion that the mark ‘D’DAAZS’ was deceptively similar to Plaintiff’s mark ‘HAAGEN-DAZS’. The relevant observation of the Court is as under:

“23. It is also settled that while a trademark is supposed to be looked at in entirety, yet the consideration of a trademark as a whole does not condone infringement where less than the entire trademark is appropriated. It is therefore not improper to identify elements or features of the marks that are more or less important for purpose of analysis in cases of composite marks.”

24. In this regard we may fortify our conclusion by take note of the decision reported as 405 F. Supp. 530 (1975) *Eaton Allen Corp. v. Paco Impressions Corp.* The facts of the said case reveal that the plaintiff manufactured coated paper under the registered trademark ‘Super-Ko-Rec-Type’. The defendant manufactured and advertised a similar product under the mark ‘Super Type’ and ‘Super Type-7’. The defendant contended that the only similarity between the said marks was use of the words ‘Super’ and ‘Type’, terms which were neither significant parts of the plaintiff’s registered trademark nor protectable as a matter of law. **The court held that the consideration of a trademark as a whole does not preclude infringement where less than the entire trademark is appropriated.**

25. Therefore, the submission of the appellant-defendant predicated upon the principle of ‘anti-dissection’ that action for infringement would not lie since use of the word ‘D’DAAZS’ does not result in complete appropriation of the respondent-plaintiff’s mark ‘HAAGEN DAZS’, which is to be viewed as an indivisible whole, is liable to be rejected.



26. Dominant features are significant because they attract attention and consumers are more likely to remember and rely on them for purposes of identification of the product. Usually, the dominant portion of a mark is that which has the greater strength or carries more weight. Descriptive or generic components, having little or no source identifying significance, are generally less significant in the analysis. However, words that are arbitrary and distinct possess greater strength and are thus accorded greater protection.[174 F. Supp. 2d 718, 725 (M.D. Tenn. 2001) Autozone, Inc. v. Tandy Corporation]

26. On the issue of likelihood of confusion, J. Thomas McCarthy in McCarthy on Trademarks and Unfair Competition [4th edition, Vol. 3, page 23-128] opines that the ordinary rule is that marks must be compared in their entirety, however, more weightage can be given to the dominant feature of the mark in reaching a conclusion on the issue of confusion. The relevant observation is as follows-

“While the basic rule is that marks must be compared in their entireties and not dissected, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Although it is not proper to dissect a ‘mark,’ one feature of a mark may be more significant and it is proper to give greater force and effect to that dominant feature. Thus, as a preliminary to comparing marks in their entireties, it is not improper to downplay the similarity of very descriptive parts of conflicting marks.”

xxx xxx xxx”


(Emphasis Supplied)

14. Similarly, dealing with a case where the plaintiff was the registered proprietor of the trademark JAVA and the defendants adopted the mark/logo JAVA T POINT, by addition of the word T POINT as a suffix, it was held that the same constituted as infringement. Thus, in the case of ***Oracle America Inc. Versus Sonoo Jaiswal and Others, 2024 SCC Online Del 1386***, it was held as follows:

“xxx xxx xxx



19. The Court has considered the aforementioned submissions. The Plaintiff is the registered proprietor of the trademark 'JAVA'. The Defendants' Impugned Mark/Logo 'JAVA T POINT'

 utilizes the Plaintiffs trademark entirely, and the same is also part of their domain name and tradename. Further, they have also incorporated two companies which utilise 'JAVA' in their corporate names, i.e. Defendant No. 2/Javatpoint Limited and Defendant No. 3/Javatpoint Tech Private Limited. **In the opinion of the Court, the mere addition of the word 'TPOINT' as a suffix to the Plaintiffs trademark 'JAVA' does not take away from the fact that 'JAVA' is the prominent part of the Defendant's Impugned Mark, which is evidently being used purely in a trademark sense. Therefore, such use amounts to prima facie infringement under Section 29(5) of the Act. Moreover, the Plaintiff Group also has a registration of the trademark 'JAVA' in, inter alia, Class 41, and are offering the same services as those offered by the Defendants. Thus, the Defendants' use is also prima facie infringing under Section 29(1) of the Act.**

20. The Court finds the Defendants' argument, positing that 'JAVA', being the name of a programming language, is ineligible for trademark protection, to be without merit. The Defendants' argument in this regard stems from an article which serves as a piece of opinionated discourse rather than a definitive scholarly work with conclusive insights on the matter. The article primarily raises concerns about the potential for trademark holders to overly police the use of a language name, thereby impacting free speech and limiting the language's usage. However, this scenario does not apply to the current dispute as the Plaintiff has expressly stated its intention not to enforce the 'JAVA' trademark in a manner that would unduly restrict third-party use of the term in its descriptive sense related to programming. The crux of the Plaintiffs complaint lies not in the generic use of 'JAVA' but in its specific application as a trademark by the Defendants, which is precisely the case here. **The law of trademark protects against the use of a mark in a way that could cause confusion among consumers regarding the source of goods or services. Therefore, if 'JAVA' is being used by the Defendants in a way that capitalizes on its trademark value established by the Plaintiff Group, and not merely in reference to the programming language, then it constitutes infringement.** In the present case, the Court finds that the Defendants' utilization of the Impugned

Mark , as a logo goes beyond



generically referencing the programming language in a descriptive or educational context. Instead, it adopts 'JAVA' in a trademark capacity, thereby directly infringing upon the Plaintiffs rights over their registered trademark.

xxx xxx xxx”

(Emphasis Supplied)

15. Clearly, adoption of a prominent part of the registered mark, forming part of a label mark of another party, is not permissible. Thus, holding that when a label mark is registered, it cannot be said that the word mark contained therein is not registered, and emphasizing that the word contained in the label mark, is also worthy of protection, a Division Bench of this Court in the case of *United Biotech Pvt. Ltd. Versus Orchid Chemicals & Pharmaceuticals Ltd. & Ors.*, 2012 SCC OnLine Del 2942, has held as follows:

“xxx xxx xxx

26. We find that the learned Single Judge rightly held that when a label mark is registered, it cannot be said that the word mark contained therein is not registered. We, thus, are of the opinion that although the word “ORZID” is a label mark, the word “ORZID” contained therein is also worthy of protection. The learned Single Judge has rightly observed that the judgment of the Supreme Court in *Ramdev Food Products Ltd. (supra)* is the complete answer. This aspect is considered and the argument of the appellant is rejected in the following words:

“27. On whether the OCPL could successfully ask for rectification for UBPL's word mark FORZID notwithstanding that OCPL held registration only for a label mark, the judgment of the Supreme Court in *Ramdev Food Products Ltd. v. Arvindbhai Rambhai Patel*, (2006) 8 SCC 726 : AIR 2006 SC 3304 is a complete answer. The Court there referred to an earlier decision in *Registrar of Trade Marks v. Ashok Chandra Rakhit*, AIR 1955 SC 558, which concerned the proprietary mark 'Shree' which formed part of the device as a whole and was an important feature of the device. The Supreme Court observed that registration of a trade mark as a whole would give the proprietor “a right to the exclusive use of word 'Shree' as if separately and by itself.” Therefore it would not be



correct for UBPL to contend that the registration held by OCPL does not cover the word mark ORZID.”

xxx xxx xxx”

(Emphasis Supplied)

16. Similarly, delving on the aspect of deceptive similarity between two marks, the Division Bench in the case of ***United Biotech Pvt. Ltd. (Supra)***, has held as follows:

“xxx xxx xxx

30. The law on this aspect, where the Courts are called upon to consider the deceptive similarity between the two marks is firmly engraved in a series of judgments pronounced by the Courts in the last half century or more. Many are cited by the learned counsel for the appellant, note whereof is taken above. Judgment of Supreme Court in the case of Cadila Health Care Limited (supra), which deals with pharmaceutical preparations, is a milestone on law relating to drugs. Application of the principles laid down in this judgment can be found in scores of subsequent judgments of this Court and other High Courts. The position which emerges from the reading of all these judgments can be summarized in the following manner:

In such case, the central issue is as to whether the defendant's activities or proposed activities amount to a misrepresentation which is likely to injure the business or goodwill of the plaintiff and cause damage to his business or goodwill. To extend this use to answer this, focus has to be on the aspect as to whether the defendant is making some representation in course of trade to prospective customers which is calculated to injure the business or goodwill of the plaintiff thereby causing damage to him. In the process, difference between the confusion and deception is to be understood. This difference was explained by Lord Denning in “Difference: Confusion & Deception” in the following words:

“Looking to the natural meaning of the words, I would make two observations: first, the offending mark must ‘so nearly resemble’ the registered mark as to be ‘likely’ to deceive or cause confusion. It is not necessary that it should be intended to deceive or intended to cause confusion. You do not have to look into the mind of the user to see what he intended. It is its probable effect on ordinary people which you have to



consider. No doubt if you find that he did intend to deceive or cause confusion, you will give him credit for success in his intentions. You will not hesitate to hold that his use of it is likely to deceive or cause confusion. But if he had no such intention, and Was completely honest, then you will look carefully to see whether it is likely to deceive or cause confusion before you find him guilty of infringement.

Secondly, 'to deceive' is one thing. To 'cause confusion' is another. The difference is this: when you deceive a man, you tell him a lie. You make a false representation to him & thereby cause him to believe a thing to be true which is false. You may not do it knowingly, or intentionally, but you still do it, & so you deceive him. But you may cause confusion without telling him a lie at all, & without making any false representation to him. You may indeed tell him the truth, the whole truth & nothing but the truth, but still you may cause confusion in his mind, not by any fault of yours, but because he has not the knowledge or ability to distinguish it from the other pieces of truth known to him or because he may not even take the trouble to do so."

31. While examining the question of misrepresentation or deception, comparison has to be made between the two trademarks as a whole. Rules of Comparison was explained by Justice Parker in the following words:

"You must take the two words. You must judge of them, both by their look & by their sound. You must consider the goods to which they are to be applied. You must consider the nature & 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 trademarks is used in a normal way as a trademark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be confusion - that is to say, not necessarily that one man will be injured & the other will gain illicit benefit, but that there will be 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."

xxx xxx xxx"

(Emphasis Supplied)

17. It is settled law that the rule of dominant feature of a trademark is not



antithetical to the principle of anti-dissection, as contained in Section 17 of the Trade Marks Act, and the two Rules work in tandem with each other. In the present case, upon a comparison of the competing marks as a whole, the impugned mark is clearly infringing, since it prominently uses the dominant and essential part of the registered mark of the plaintiffs.

18. In the frequently quoted case of *Kaviraj Pandit Durga Dutt Sharma Versus Navaratna Pharmaceuticals Laboratories, 1964 SCC Online SC 14*, Supreme Court has held in categorical terms that where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise, no further evidence is required to establish that the plaintiff's rights are violated. If the essential features of the trademark of the plaintiff have been adopted by the defendant, the fact that the getup, packing and other writing or marks on the goods or on the packets in which he offers his good for sale, show mark differences, would be immaterial. When two marks are identical, no further questions arise, for then, the infringement is made out. Thus, Supreme Court has held as follows:

“xxx xxx xxx

28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the



manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. **While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods**” (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. **In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial;** whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be “in the course of trade”, the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would



have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide Section 21). A point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". 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.

xxx xxx xxx"

(Emphasis Supplied)

19. This Court also notes the submission of the plaintiffs that the plaintiffs' mark 'BIOCHEM' has been protected by the Bombay High Court in proceedings instituted previously by their predecessors-in-interest, as also by the Trade Marks Registry in a number of opposition proceedings instituted by the plaintiffs' predecessors-in-interest. The submissions made in this regard, as given in the plaint, read as under:

"xxx xxx xxx

29. It is stated that the Plaintiffs and their predecessors-in-interest



have been highly vigilant in protecting their statutory and common law rights over the trade mark **BIOCHEM** and its labels, and have initiated actions against third parties for violation of their rights in the trade mark **BIOCHEM**. The Plaintiffs' trade mark **BIOCHEM** has been protected by the Hon'ble Bombay High Court in proceedings instituted previously by their predecessors-in-interest. The predecessors-in-interest of the Plaintiffs had filed a suit seeking permanent injunction before the Hon'ble Bombay Court, restraining the use of trade mark **BIOCHEM** by an infringer. The suit along with its current status has been listed hereunder:

S. No.	Case No.	Case Title	Status
1.	Suit No. 1962 of 2008	Biochem Pharmaceutical Industries Limited vs.	The Hon'ble Bombay High Court, vide order dated July 16, 2008, decreed the suit in terms of the consent terms agreed between the parties, wherein the
	before Hon'ble Bombay High Court	Biochem Laboratories Private Limited	Defendant therein had agreed to suffer permanent injunction from manufacturing, packing, marketing, selling or using in relation to pharmaceutical and medicinal preparations or any other goods falling in class 5, or in any manner using as or as part of their corporate name, the mark 'Biochem'.

The aforesaid order passed by the Hon'ble Court protecting the registered trade marks of the Plaintiffs is being filed along with the present proceedings.

30. It is stated that the Plaintiffs' trade mark **BIOCHEM** has been protected by the Trade Marks Registry in a number of opposition proceedings instituted previously by their predecessors-in-interest, the details of which have been listed hereunder:



Sr. No.	Applicant	Trade Mark	Application No.	Class	Opposition date	Result/ Status
1.	Aasha Biochem	AASHA BIOCHEM	844176	5	May 30, 2008	Application abandoned vide Order dated October 17, 2007 for non-filing of Counter Statement
2.	Biovet Private Limited	BIOCAM	1487062	5	May 24, 2008	Application abandoned vide Order dated April 29, 2009 for non-filing of Counter Statement

xxx xxx xxx”

20. This court also notes the submissions made by the plaintiffs that the defendant’s trademark application no. 4491294 for the word mark ‘ALDER BIOCHEM’ has been objected by the Trade Mark Registry. Further, *qua* the defendant’s trademark application no. 4495449 for the device mark,



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, the plaintiff has already filed a notice of opposition against it.

21. The defendant has contended that the word BIOCHEM is generic and non-distinctive, as it is commonly used abbreviation of the word biology and chemistry, which are common words in the pharmaceutical industry. It is further the case of the defendant that the word BIOCHEM is common to the



trade. All these issues, as raised by the defendant, cannot be adjudicated at this stage, as the same are a matter of evidence, which shall be decided upon trial. It is settled law that the onus to establish the existence of the ingredients to substantiate a plea that a mark has become common to trade, has to be established by a party who raises such a plea. This Court is in agreement with the submissions of the plaintiffs that the defendant has failed to put on record a single instance of usage of the mark BIOCHEM by the third parties on pharmaceutical products.

22. Holding that there is distinction between a mark being ‘common on the register’ and ‘common to the trade’ and trademark being property right, an invasion of it should be protected, and balance of convenience would obviously be in favour of a party who was the first user of the mark, this Court in the case of *Century Traders Versus Roshan Lal Duggar & Co., 1977 SCC OnLine Del 50*, has held as follows:

“xxx xxx xxx

11. In Consolidated Foods Corporation v. Brandon and Co., Private Ltd., A.I.R. 1965 Bombay 35 (2), it was observed that “A trader acquires a right of property, in a distinctive mark merely by using it upon or in connection with his goods irrespective of the length of such user and the extent of his trade. The trader who adopts such a mark is entitled to protection directly the article having assumed a vendible character is launched upon the market. Registration under the statute does not confer any new right to the mark claimed or any greater rights than what already existed at common law and at equity without registration. It does, however, facilitate a remedy which may be enforced and obtained throughout the State and it established the record of facts affecting the right to the mark. Registration itself does not create a trade mark. The trade mark exists independently of the registration which merely affords further protection under the Statute. Common law rights are left wholly unaffected. Priority in adoption and use of a trade mark is superior to priority in registration.



xxx xxx xxx

14. Thus, the law is pretty well-settled that in order to succeed at this stage the appellant had to establish user of the aforesaid mark prior in point of time than the impugned user by the respondents. The registration of the said mark or similar mark prior in point of time to user by the appellant is irrelevant in an action passing off and the mere presence of the mark in the register maintained by the trade mark registry did not prove its user by the persons in whose names the mark was registered and was irrelevant for the purposes of deciding the application for interim injunction unless evidence had been led or was available of user of the registered trademarks. In our opinion, these clear rules of law were not kept in view by the learned Single Judge and led him to commit an error.

xxx xxx xxx

21. We now come to the question of balance of convenience. It has been urged on behalf of the respondents that the mark “RAJARANI” is common to the trade and for this purpose reliance has been placed on the registration in Andhra Pradesh and Amritsar. There is a distinction between a mark being “common on the register” and “common to the trade”. There is no evidence on record to show that there is actual user of this mark by any party other than the parties before us. Inasmuch as trade mark is property right, an invasion of it should be protected and the balance of convenience would obviously be in favour of the appellant who was admittedly the first user of this mark. We cannot accept that there is any prima facie evidence of respondent No. 3 being the owner of the mark. Indeed, this is belied by the registration applications filed by respondent No. 2. As was observed by Goddard, L.J. in *Draper v. Trist*, 1939 (3) A.E.R. 513 (8):—

“In passing off cases, however, the true basis of the action is that the passing off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business.....”

This right is to be protected and the balance of convenience is in favour of the person who has established a prime facie right to property.

xxx xxx xxx”

(Emphasis Supplied)



23. On the aspect whether a word mark is common to the trade, it has been held that to establish a plea of common use, the use by other persons should be shown to be substantial and a party is not expected to sue all small type infringers, who may not be affecting such party's business. Thus, a Division Bench of this Court in the case of *Pankaj Goel Versus Dabur India Ltd. , 2008 SCC OnLine Del 1744*, has held as follows:

“xxx xxx xxx

21. As far as the Appellant's argument that the word MOLA is common to the trade and that variants of MOLA are available in the market, we find that the Appellant has not been able to prima facie prove that the said 'infringers' had significant business turnover or they posed a threat to Plaintiff's distinctiveness. In fact, we are of the view that the Respondent/Plaintiff is not expected to sue all small type infringers who may not be affecting Respondent/Plaintiff business. The Supreme Court in *National Bell v. Metal Goods, (1970) 3 SCC 665 : AIR 1971 SC 898* has held that a proprietor of a trademark need not take action against infringement which do not cause prejudice to its distinctiveness. In *Express Bottlers Services Pvt. Ltd. v. Pepsi Inc., (1989) 7 PTC 14* it has been held as under:—

“....To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the malicious persons, just to harass the proprietor may use his mark by way of pinpricks.... The mere use of the name is irrelevant because a registered proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence... Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark. This Court is inclined to accept the submissions of the respondent No. 1 on this point... The respondent No. 1 did not lose its mark by not proceeding against insignificant infringers...”



22. In fact, in Dr. Reddy Laboratories v. Reddy Paharmaceuticals, (2004) 29 PTC 435 a Single Judge of this Court has held as under:—

“...the owners of trade marks or copy rights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. If the impugned infringement is too trivial or insignificant and is not capable of harming their business interests, they may overlook and ignore petty violations till they assume alarming proportions. If a road side Dhaba puts up a board of “Taj Hotel”, the owners of Taj Group are not expected to swing into action and raise objections forthwith. They can wait till the time the user of their name starts harming their business interest and starts misleading and confusing their customers.”

23.....

24. In fact, in Castrol Limited v. A.K. Mehta, (1997) 17 PTC 408 (DB) it has been held that a concession given in one case does not mean that other parties are entitled to use the same. Also in Prakash Roadline v. Prakash Parcel Service, (1992) 2 Arb LR 174 it has been held that use of a similar mark by a third party in violation of Plaintiff's right is no defence.

xxx xxx xxx”

(Emphasis Supplied)

24. Having regard to the aforesaid discussion, the case laws cited by the defendant, have no applicability to the facts of the present case.

25. In view of the aforesaid, the plaintiffs have established a *prima facie* case in their favour. There is presumption of validity of the plaintiffs’ registered trademark. The prominent, essential and dominant feature of the plaintiffs’ mark is the word BIOCHEM, which is being used by the defendant for identical goods, i.e., Pharmaceuticals products. Further, the balance of convenience also lies in favour of the plaintiffs. The plaintiffs have filed on record documents pertaining to their sales figures of their products under the mark BIOCHEM, which is more than two hundred crores in the year 2022. In contrast, the defendant’s sale of products under the



impugned mark ‘ALDER BIOCHEM’, were to the tune of Rs. 21 lacs, in 2022-2023 and Rs. 38 lacs, in 2023-2024. Further, irreparable injury and loss will be caused to the plaintiffs if the defendant is not injuncted. Law is settled that confusion between medical products is life threatening, not merely inconvenient. Further, the damage to a parties’ reputation and goodwill as a result of acts of infringement and passing off, cannot be compensated in cases relating to pharmaceutical, by damages alone.

26. Accordingly, the defendant, its principal officers, assignees, family members, servants and agents, and all other persons claiming under the defendant, are restrained from selling, offering for sale, advertising and/or



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promoting and/or using the mark/trade name, ‘ALDER BIOCHEM’ and any other mark/trade name/label/device that contains the mark ‘BIOCHEM’ and any other mark/name/label/device that is deceptively



similar to the plaintiffs’ mark/trade name ‘BIOCHEM’.

and

27. Further, the defendant and all other persons claiming under the defendant, are also restrained from using the domain name www.alderbiochem.com or any other domain name that contains any mark



identical or deceptively similar to the plaintiffs’ mark/label

and



‘BIOCHEM’.



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28. It is clarified that any observations contained herein are only for the purpose of disposing of the present application seeking interim directions, and would have no bearing on the merits of the case, at the time of final hearing of the case. Nothing contained herein shall be construed as an expression on the merits of the case.

29. The present application is accordingly disposed of, in terms of the aforesaid directions.

**(MINI PUSHKARNA)
JUDGE**

NOVEMBER 13, 2024

c/ak