

Law Lore & Practice



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It is common practice in the pharmaceutical industry to derive names of drugs from their chemical compounds and this often results in co-existence of similarly named medicines. At the same time, it is well-established that trade mark law envisages stricter examination of marks in respect of medicinal and pharmaceutical preparations as infringement/passing off here not only causes economic loss but can also have hazardous health consequences. Extreme caution has to be exercised in such cases, more so, in a polyglot nation like India where diverse scripts are used and a significant segment of consumer base is uneducated. The recent judgment of *Win-Medicare Private Limited (plaintiff) v Galpha Laboratories Limited (defendant)* highlights these issues, amongst others, and emphasizes that public interest is paramount.

The plaintiff, registered proprietor of the trade mark BETADINE in India in relation to pharmaceutical preparations, was manufacturing and selling a Povidone-iodine combination since the year 1990 under a distinctive trade dress comprising of a white background with dark blue lettering prominently featuring a two stripe mark accompanied by the trademark BETADINE appearing on the label. When it learnt that the defendant had filed a deceptively similar mark BECTODINE-M in Class 5, the plaintiff opposed the application in 2013 upon its advertisement. Subsequently, on noticing use of the mark BECTODINE by the defendant with a similar get up as that of the plaintiff's products, the plaintiff instituted a suit for permanent injunction

asserting its prior and well-established rights in the trade mark, trade dress and copyright.

An order of ex-parte ad interim injunction was granted by the Delhi High Court on 14 November 2014. Thereafter, an application was filed by the defendant for vacation of the ex-parte interim injunction and the said application along with the application for interim injunction was argued before the High Court at length.

The defendant submitted that BECTODINE was honestly coined by taking prefix BECT from BACTERIA and suffix ODINE from the generic molecule IODINE. It countered that ODINE was a publici juris word and no one could claim exclusivity thereon, as was also evident from over 700 trade marks with the suffix DINE subsisting on the Trade Marks Register. The defendant also pressed for having acquired rights over their mark by continuous use since 2006 on which basis it sought co-existence with BETADINE.

The court applying the anti-dissection rule held that the marks BETADINE and BECTODINE when compared in entirety are confusingly similar. Further, it held that the defendant adopted the mark BECTODINE being fully aware of Plaintiff's trade mark BETADINE which is evident from the similar packaging and trade dress. Given the malafide adoption, the court was of the view that no amount of subsequent use would protect the defendant's rights in the dishonestly adopted mark. The court also upheld plaintiff's rights in the color scheme and layout not only as a trade dress but also as a novel and unique artistic work and held that the defendant also infringed the plaintiff's copyright.

The order of ex-parte interim injunction was confirmed by the High Court vide order dated 4 January 2016.