



IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION (L) NO. 27480 OF 2024
IN
COMMERCIAL IP SUIT NO. 225 OF 2024

Laboratories Griffon Pvt. Ltd. and Another	...Applicants
<u>In the matter between :</u>	
Laboratories Griffon Pvt. Ltd. and Another	...Plaintiffs
<u>Versus</u>	
Adwin Pharma and Another	...Defendants

Mr. Rashmin Khandekar, Ms. Archita Gharat, Mr. Kiran Mehta i/b Mr. Kiran J. Mehta for Plaintiffs.

Ms. Bhavi Gada i/b Ms. Pooja Jain for Defendant Nos. 1, 1A and 1B (through VC).

Mr. Rajiv Gupta i/b Ms. Nisha Kaba, Mr. Abhijit Singh, Ms. Shivani Upadhyay for Defendant No. 2.

Coram : Sharmila U. Deshmukh, J.

Reserved on : 10th November, 2025.

Pronounced on : 18th November, 2025.

ORDER :

FACTUAL MATRIX:

1. This is an action for infringement of trade mark, copyright and passing-off. The Interim Application seeks to restrain the Respondent from using the trade mark "ELGIMET", "ELGIMET-SR 1/500" and "ELGIMET-SR 2/500" or any other identical or deceptively similar mark

as that of the Plaintiff's trade mark "GLIMET" and "GLIMET DS" and from passing off the Defendant's product as that of the Plaintiff. By order of 4th September, 2024, an *ex-parte* ad-interim relief was granted in respect of infringement of trade mark and Court Receiver came to be appointed. Upon service, the Defendants caused appearance. The submission of learned counsel appearing for Defendant No. 1-manufacturer is that Defendant No. 1 intends to settle the dispute amicably with the Plaintiff and hence, no submissions are advanced to oppose the interim relief. Learned counsel appearing for Defendant No. 2 submits that Written Statement has been filed and the same may be treated as Affidavit-in-reply.

2. The Plaintiffs came with the case of the 1st Plaintiff being incorporated in the year 1947 for carrying on business of manufacturing and marketing of medicinal preparation. The 2nd Plaintiff is the licensee of the trade mark of the 1st Plaintiff. The application and registration of the trade mark "GLIMET" was filed in the year 1992 under Part A of the Trade and Merchandise Marks Act, 1958 in respect of its medicinal preparations, which were used for treatment of diabetes. The registration of its variant "GLIMET DS" is of the year 1999. Over the years, the name of the 1st Plaintiff kept changing and presently its name has been brought on record as registered proprietor of the trade marks. In order to demonstrate the

reputation and goodwill, the sales figure is set out which shows that from 1st April, 2017 to 31st March, 2023, the sales turnover in respect of the drugs marketed under “GLIMET” and “GLIMET DS” was Rs. 1,95,73,672/- and of Plaintiff No 2 for the period 2013-2014 is Rs 22,51,59,330/. The Plaint also sets out the invoices showing the sales of the product by the Plaintiffs using the trade marks “GLIMET” and “GLIMET DS”.

3. It is submitted that in the second week of June, 2024, the Plaintiff came across the Defendant’s product bearing the impugned mark ELGIMET-SR 1/500 and ELGIMET-SR 2/500 on e-commerce website. A decoy purchase was made and the impugned products showed the name of 2nd Defendant as marketer of the product bearing the impugned mark. The Plaintiffs conducted a search in the Trade Marks Registry and found that Defendant No. 2 had applied for registration of the impugned mark “ELGIMET” in class 5 on 23rd August, 2023, on proposed to be used basis, which application is stated not to be not yet advertised in the Trade Marks Journal.

4. The defense is that there is no visual or phonetic similarity between the rival marks. There is objection raised to the territorial jurisdiction of this Court. It is contended that the drugs are prescription drugs and are sold by the qualified licensed pharmacists and therefore, there is no question of likelihood of confusion. The Plaintiff’s

registration has been opposed by third-parties and there are other registered identical marks against which no action has been taken by Plaintiffs.

SUBMISSIONS:

5. Learned counsel appearing for Plaintiffs submits that there is visual and phonetic similarity between the rival marks “GLIMET” and “ELGIMET” and being medicinal preparation, greater care is required. He would further submit that the Defendant’s mark is unregistered mark and application has been moved in the year 2023 on proposed to be used basis which shows subsequent adoption of the mark. He would further submit that the Plaintiffs had obtained registration under Part-A of the Trade and Merchandise Marks Act, 1958 which demonstrate distinctiveness. He submits that the rectification has been filed by third-party and not by the Defendant and the same is immaterial. He would submit that the Defendant makes a reference to certain other proprietors of identical registered trade marks without substantiating the same by producing necessary documents. He submits that in any event, the provisions of Trade Marks Act, 1999 admits of more than one registered proprietor. He would further submit that as the registered office of the Plaintiff is within the jurisdiction of this Court, under Section 134 of the Trade Marks Act, 1999, this Court would have jurisdiction. He submits that leave under Clause XIV of Letters Patent

(Bombay) is granted and therefore, the relief of passing-off can be considered. In support, he relies upon the order of this Court passed in ***Laboratories Griffon Private Limited and Anr. vs. Medieos Lifesciences LLP¹***.

6. Learned counsel appearing for Defendant No 2 submits that there is no phonetic or visual deceptive similarity between the two marks. He submits that the Plaintiff's product is sold at price of Rs. 7/- for 10 tablets whereas the Defendant No. 2's medicine is priced at Rs. 70/- for 10 tablets. He submits that the drugs are Schedule H drugs and there is no likelihood of confusion being caused. He submits that Defendant No. 2 had applied for registration of its trade mark "ELGIMET" in Class 5, which application was examined, accepted and has proceeded for registration and therefore, the adoption is an honest adoption. He would further submit that no exclusive right can be claimed over the descriptive or combination of the components of the drug as the Plaintiff's mark "GLIMET" is derived from the pharmaceutical components i.e. "Glibenclamide/Glimepiride" and "Metformin". He submits that the active ingredient or therapeutic use cannot be monopolized. He submits that packaging and get-up are entirely different of the rival products. He submits that as Defendant No. 2 had made a substantial investment in the marketing of its

1 IA(L) No. 25004 of 2024, decided on 16th July, 2025.

product, the balance of convenience tilts in favor of Defendant.

REASONS & ANALYSIS :

7. The rival products marketed under the rival marks, i.e "GLIMET"/"GLIMET DS" and "ELGIMET/ ELGIMET-SR", are medicinal preparations used in treatment of diabetes. The Defendant No 2 has not disputed the prior user and registration of the Plaintiff's trade marks and the primary objection is that there is no distinctiveness as the Plaintiff's trade marks are derived from combination of active pharmaceutical ingredients of the drug. Dealing with the aspect of distinctiveness, the registration of the Plaintiff's trade mark is under Part A of the Trade and Merchandise Marks Act, 1958 (Act of 1958) and the essential particulars required for the mark to be registered in Part A is found in Section 9 of the Act of 1958 which reads as under:

"9. Requisites for registration in Parts A and B of the register.

(1) A trade mark shall not be registered in Part A of the register unless it contains or consists of at least one of the following essential particulars, namely:-

- (a) the name of a company, individual or firm represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) one or more invented words;
- (d) one or more words having no direct reference to the character or quality of the goods and not being, according to its ordinary signification, a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect,

caste or tribe in India;
(e) any other distinctive mark.

(2) A name, signature or word, other than such as fall within the descriptions in clauses (a), (b), (c) and (d) of sub-section (1) shall not be registerable in Part A of the register except upon evidence of its distinctiveness.

(3) For the purposes of this Act, the expression "distinctive" in relation to the goods in respect of which a trade mark is proposed to be registered, means adapted to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to sue within the extent of the registration.

(4).....

(5).....

(6).....

8. The registration of the Plaintiff's trade mark in Part A of the Register *prima facie* indicates satisfaction of the requisite particular of the mark being distinctive. The defense that the Plaintiff's trade mark is descriptive and cannot be monopolised is fallacious as it overlooks the fact that exclusivity is claimed in the unique and distinct combination of the active pharmaceutical ingredients i.e. Glipizide and Metformin. The Plaintiff's mark is portmanteau of combination of names of two generic drugs in a distinct and unique manner. There can be no exclusivity claimed in Glipizide and Metformin Hydrochloride taken separately, however, exclusivity can be claimed in the unique combination of these two components. There are infinite permutations and combinations probable of these two components and it is the adoption of a

combination which is deceptively similar to the Plaintiff's combination which can constitute infringement of the registered trade mark.

9. The issue therefore to be decided is whether there is deceptive similarity between the two marks. The marks are GLIMET and ELGIMET. The Defendant No. 2 has interchanged the first two alphabets of the registered trade mark GLIMET and prefixed the vowel "E". The test of deceptive similarity has to be applied from the aspect of an average consumer with imperfect recollection. There is likelihood of the impugned mark being pronounced as "gi-met" which is phonetically similar to the mark "gli-met". There would be a tendency amongst the less informed to mispronounce the drug particularly when the mark is derived from active pharmaceutical ingredients. It would be crediting the average consumer with much capability by expecting that the impugned mark would be pronounced correctly as "el-gi-met" in contradistinction to "gli-met". It cannot be said that an average man with imperfect recollection would be able to distinguish between the rival marks and would be able to recollect precisely the mark of the drug which he intends to purchase. *Prima facie* there is structural and phonetic similarity between the rival marks.

10. In the case of **Laboratories Griffon Pvt. Ltd. vs. Medieos Lifesciences LLP** (supra), this Court had summarized the test which was laid down by the Hon'ble Apex Court in **Cadila Health Care Ltd and**

Cadila Pharmaceuticals Ltd² in paragraph 20 as under:

"20. The tests laid down by the Hon'ble Apex Court can be broadly summarised as under:

- (a) Where the drugs have marked differences in composition with completely different side effects, the test should be stricter.
- (b) The Courts are required to be vigilant where the Defendant's drug, of which passing off, is alleged is meant for curing the same ailment.
- (c) Public interest would support lesser degree of proof showing confusing similarity in case of the infringement of trademark of medicinal product as compared to nonmedicinal products.
- (d) Many patients may be elderly, infirm or illiterate and may not be in a position to differentiate between the medicine prescribed and bought which is ultimately handed over to them.
- (e) The fact that the drugs are sold under prescription is not sufficient to prevent confusion in view of the varying infrastructure for supervisions of physicians and pharmacists of medical profession in India due to linguistic, urban, semi-urban and rural divide across the country and with high degree of possibility of even accidental negligence required strict measures.
- (f) In case of passing off, one of the test is whether there is likelihood of causing an ordinary consumer being confused between one product and another due to similarity of marks and other surrounding circumstances.
- (g) It is also important that the marks must be compared as wholes. It is to right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in other case there is no sufficient similarity to cause confusion. The true test is whether the totality of the proposed trade mark is such that it is

2 (2001) 5 SCC 73.

likely to cause deception or confusion or mistake in mind of persons accustomed to the existing mark.”

11. The Hon’ble Apex Court has held that the drugs being sold under prescription is not sufficient to prevent confusion and the true test is whether the totality of the proposed trade mark is such as is likely to cause deception and confusion. The rival drugs having different compositions are used for treatment of diabetes which is a common ailment transcending all strata of society and an exacting judicial scrutiny is required in case of medicinal preparations. The explanation given for adoption of the impugned mark is that the Defendant No 2 has given its own company’s name Elcliff to the impugned mark. Even accepting the same, there is no justifiable reason as to why the first two letters of the Defendant No 2’s company’s name was suffixed with the word gimet by removing the alphabet “l”. The Plaintiffs being in the pharmaceutical industry since the year 1992, the Defendant No 2 ought to have been aware of the Plaintiff’s registered trade mark being in existence and avoided adoption of deceptively similar trade mark. The mere existence of slightest probability of confusion in the case of medicinal products require that the use of the product be restrained. In my view, upon comparison of the rival marks, there is deceptive phonetic and structural similarity between the two

marks and therefore, *prima facie* case for infringement of trade mark is made out.

12. It is the totality of the impugned trade mark which has to be examined by taking into consideration the nature of goods, class of purchasers, mode of purchase. I am not inclined to accept the submission that the difference in pricing negates the deception or confusion or that the same will be sold through different channels as admittedly being medicinal preparation, both products would be sold by pharmacists. The class of the consumers cannot be said to be divided by reason of pricing.

13. In so far as balance of convenience is concerned, the Plaintiff's trade mark has been registered in the year 1992. The sales figure on record demonstrates the combined sales of the 1st and 2nd Plaintiff of about Rs 25 Crores. There is no document produced on record by Defendant No 2 to demonstrate the so-called substantial investment, or the sale achieved and not even an invoice to demonstrate the use of impugned mark. The Written Statement has been filed without any supporting documents and mere pleadings are not sufficient to accept the case of balance of convenience being in favor of the Defendants. The written statement does not set out any details of incorporation of the Defendant No 2 nor any document is produced to *prima facie* demonstrate the sales under the impugned mark. The plaint pleads

that in June, 2024 the Plaintiffs came across the Defendant No 2's product in the market. *Prima facie* it appears that the Defendant No 2 is a late entrant in the market. The infringement of the Plaintiff's registered trade mark is likely to cause damage to the Plaintiffs. Considering the facts and circumstances, the balance of convenience is in favour of the Plaintiffs.

14. Though the learned counsel for Defendant No. 2, in the Written Submissions, has referred to the number of decisions, none of these citations were submitted or referred during the hearing and therefore, this Court has not considered the same.

15. In so far as the aspect of passing-off is concerned, the same is an tortious action in deceit. The classic trinity test i.e. reputation and goodwill, misrepresentation and likelihood of damage is to be applied while considering an action for passing off. No submissions were canvassed to *prima facie* demonstrate any attempt at misrepresentation and the defence raised as regards the difference in the pricing assumes significance. It is not *prima facie* demonstrated that the Defendant No 2 has designed its product in a manner so as to pass off its product as that of the Plaintiff. Even if *prima facie* the requirement of goodwill and reputation stands established, I do not find any *prima facie* case of misrepresentation made out. At this stage, I am not inclined to grant interim relief against passing off.

16. As far as the other defences are concerned, though the submission of learned counsel for Defendant No. 2 is that its application for registration of the impugned mark has proceeded for advertisement, perusal of Annexure-A of the Written Statement would show that the mark has been objected. There is no document produced to show the registration of deceptively similar third party trade marks as set out in Paragraph No. 9 of the Written Statement and in any event, the existence of third party infringers does not entitle the Defendant No 2 to adopt deceptively similar trade mark. There is no obligation upon the Plaintiffs to proceed against each and every infringer and particularly in the absence of any use of deceptive similar trade mark being demonstrated by Defendant No. 2. Similarly, the filing of rectification application by the third-party is of no consequence.

17. In light of above discussion, *prima facie* case is made out for infringement of trade mark. The ad-interim relief granted by order dated 4th September, 2024 is confirmed as interim relief in terms of prayer clause (a) which reads as under:

“a) that pending the hearing and final disposal of the suit, the Respondents by themselves, their partners, directors, associate/s, sister/group companies, employees, servants, agents, dealers, stockist, distributors, assignees, licensees and all those connected with them in their business be restrained by a temporary order and injunction of this Hon'ble Court from using,

manufacturing, marketing, distributing, stocking, selling, importing, exporting, promoting, publishing, advertising, exhibiting, displaying or offering for sale in shops or on their websites or on third party website or on social media or on e-commerce sites and/or using in any manner in relation to their medicinal and pharmaceutical preparations the trademarks ELGIMET, ELGIMET-SR 1/500 and ELGIMET-SR 2/500 or any mark identical and/or deceptively similar thereto and any mark identical and/or deceptively similar to the Applicant No.1's trademarks GLIMET registered under No.579544 and GLIMET DS registered under No.2676118 both in class 05, so as to infringe the 1st Applicant's registered trademarks;

[Sharmila U. Deshmukh, J.]