



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

INTERIM APPLICATION (L) NO. 26226 OF 2025
IN
COMMERCIAL IP SUIT (L) NO. 25932 OF 2025

Aristo Pharmaceutical Private Limited	...Applicant
<u>In the matter between :</u>	
Aristo Pharmaceutical Private Limited	...Plaintiff
<u>Versus</u>	
Healing Pharma India Private Limited & Others	...Respondents

Mr. Hiren Kamod, Mr. B. N. Poojari, Mr. Prem Khullar, Ms. Nidhi Bangera i/by Asian Patent Law for the Applicant/Plaintiff.
Mr. Atul Singh, Arzoo Gupta and Ms. Nikita Agrawal i/b AVS Legal for Defendant No. 1.

Coram : Sharmila U. Deshmukh, J.

Reserved on : 14th November, 2025.

Pronounced on : 25th November, 2025.

Uploaded on : 25th November, 2025.

ORDER :

1. This is an action for infringement of trade mark and passing-off. The Plaintiff and the Defendants are pharmaceutical companies engaged in the business of manufacturing and marketing medicinal and pharmaceutical preparations.
2. The Plaintiff's case is that in or about October, 2003, they originally conceived the trade mark "ACECLO" for use and registration in respect of medicinal and pharmaceutical preparations and similar

goods. The mark "ACECLO" is derived from the name Accclofenac. Initially, the Plaintiff had prefixed the trade mark "ACECLO" with "ARISTO" and applied for trade mark registration on 8th October, 2003 in Class 5 on proposed to be used basis, which came to be registered on 3rd September, 2005. It is stated that registered trade mark was used in such a manner that the word "Aristo" was depicted insignificantly and the word "Aceclo" was displayed prominently. In or around December 2003, the Plaintiff commenced use of the mark "Aceclo" in respect of the said goods and obtained registration of its variant "Aceclo Sera". In or about June 2004, the Plaintiff commenced the manufacturing and marketing of tables being aceclofenac sustained release tablets under the mark "ACECLO SR" and in or about July, 2005, combination of Aceclofenac, Paracetamol and Chlorzoxazone under trade mark "ACECLO MR".

3. The trade mark "ACECLO" was registered with effect from 7th February, 2011 claiming user since 31st December, 2003. To demonstrate the reputation and goodwill, the global sales figures and copies of invoices are annexed to the Plaint.

4. It is stated that in or about October, 2024, the Plaintiff became aware of the Defendants having commenced manufacturing and/or marketing of medicinal and pharmaceutical preparations or similar goods of the composition Aceclofenac, Paracetamol and Chlorzoxazone in the form of tablets bearing the trade mark

“ACECLOHEAL-MR” and subsequent adoption of “ACECLOHEAL SP” and “ACECLOHEAL PLUS”. A Cease-and-Desist Notice was issued on 30th October, 2024 and in response, there was denial by Defendant No. 1. Hence, the present suit came to be filed.

5. The defense as set out in Affidavit-in-Reply of Defendant No. 1 is that in the field of medicinal and pharmaceutical preparations, the names derived from main pharmaceutical ingredient of the drug or from the name of organ/ailment which the drug seeks to treat, are *publici juris*. It is further stated that the name of the generic non-steroidal anti-inflammatory drug viz. “Aceclofenac” is accepted as an International Non-Proprietary Name [for short, “**INN**”] and accordingly, published by Registry of Trade Marks in India. It is contended that nomenclature for the drug “Aceclofenac” is descriptive of characteristic of such chemical composition/ingredient. The Defendant No. 1 has coined the word “Acecloheal” being a combination of first six characters of INN, i.e. “Aceclofenac” indicating its acetyl nature along with its NSAID purpose, i.e. Nonsteroidal Anti-Inflammatory Drug and suffixed by first four characters of its name and therefore, there is honest and *bona fide* adoption. It is stated that in view of Section 13 of Trade Marks Act, 1999, the Plaintiff cannot claim any proprietary right in respect of INNs or any part thereof irrespective of its registration. It is stated that use of suffix “Heal” lends distinctiveness to the overall mark “Acecloheal”. It is further stated that

the marks are phonetically, visually and conceptually different from the Plaintiff's mark "ACECLO" and is Schedule-H drug sold on the prescription of medical practitioner only. It is submitted that the pricing of rival drugs is vastly different and there is no likelihood of confusion or deception. It is further stated that the formulations alleged to be coined by the Plaintiff in respect of its product are non-patented non-proprietary generic formulation sold by many manufacturer and marketeers in India and elsewhere in world.

6. The Affidavit-in-rejoinder reiterates the stand of the Plaintiff and states that the prohibition under Section 13 of Trade Marks Act, 1999 is for registration of Aceclofenac and not to the word Aceclo *per se*.

SUBMISSIONS :

7. Mr. Kamod, learned counsel appearing for Plaintiff submits that the rival drugs are used for obviating pain and inflammation. Pointing out to the registration certificates, he submits that the first registration was obtained of the word mark "ARISTO ACECLO" in 2005 and thereafter, "ACECLO" word mark was registered since the year 2011. He submits that the Plaintiff's registered trade mark "ACECLO" is derived from Aceclofenac. He submits that reputation and goodwill is demonstrated from the sales figure for the relevant period, i.e. 2020-2021 when Defendants commenced the use of the mark which was approximately Rs. 42 crores. He submits that the principal defense raised is non exclusivity in "ACECLO" without raising a challenge to the

validity of registration. He submits that the list of INNs includes Acecelofenac and not Aceclo. He submits that Plaintiff's mark being registered trade mark, Section 28 of Trade Marks Act, 1999 grants an exclusive right to Plaintiff to use the trade mark. He submits that defense of Section 13 of Trade Marks Act, 1999 is unsustainable inasmuch as the Plaintiff's mark is not "Aceclofenac" and is neither similar sounding to the INN. He would further submit that the defense of the mark being common to trade requires *prima facie* evidence of long-standing extensive use. He submits that the only material produced on record are photographs of the product which may possibly show the use of the mark, but not extensive use. He would further submit that Defendants use the mark "ACECLOHEAL" as trade mark and not in descriptive sense. He submits that the third-party products, which are produced at Page No. 142 of the Reply Affidavit uses the mark in descriptive sense and not part of their mark. He submits that mere entry in the Register of trade marks is not sufficient to show use.

8. He submits that the defense of the rival products being Schedule-H drugs has lost its significance in view of decision of Hon'ble Apex Court in the case of ***Cadila Health Care Limited vs. Cadila Pharmaceuticals Ltd.***¹. In support, he relies upon the following decisions:

Wyeth Holdings Corporation and Anr vs.

1 (2001) 5 SCC 73.

Burnet Pharmaceuticals (Pvt.) Ltd.²

Aventisub LLC vs. Healing Pharma India Pvt. Ltd.³

Lupin Limited vs. Eris Lifesciences Pvt. Ltd.⁴

Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd. (supra)

Schering Corporation vs. Kilitch Co. (Pharma) Pvt. Ltd.⁵

9. *Per contra*, Mr. Singh learned counsel appearing for Defendant No 1 submits that it is undisputed that Plaintiff's registered mark is derived from the international non-proprietary name "Aceclofenac" and in view of Section 13 of Trade Marks Act, 1999, no proprietary right can be claimed in respect of INNs or any part thereof. He submits that in Paragraph No. 15 of Affidavit-in-rejoinder, the Plaintiff had admitted the abbreviations MR/SR/SPAS are common to pharmaceutical preparation and therefore, only "ACECLO" is registered. He submits that in identical facts in the case of ***Sun Pharmaceutical Laboratories Limited vs. Hetero Healthcare Limited and Another⁶***, the Delhi High Court refused to grant injunction where the mark was an international non-proprietary name and could not be registered. He submits that it is an admitted position that Plaintiff had earlier prefixed the trade mark "ACECLO" with "ARISTO" as they were aware that no exclusivity

2 2008 SCC OnLine Bom 76.

3 Contempt Petition (L) No. 21571 of 2022 in Commercial IP Suit No. 139 of 2021, decided on 3rd February, 2025.

4 2015 SCC OnLine Bom 6807.

5 1990 SCC OnLine Bom 425.

6 2022 SCC OnLine Del 2580.

could be claimed in "ACECLO". He would further submit that it is a Plaintiff's own case that initially the product packaging displayed the word "ACECLO" prominently and not "ARISTO." He submits that it is only in 2011 when the Plaintiff did not face any objections that ACECLO came to be registered.

10. He would further submit that for the purpose of passing-off, the case set out in rejoinder affidavit imputes possibility of fraud by the chemist and not that by itself, there is misrepresentation by the Defendants. He would further submit that it is not necessary for Defendants to show the sales figure or reputation and goodwill at the interim stage and it is the Plaintiff's own case that Defendants are manufacturing and selling the product atleast from 2024. He submits that balance of convenience therefore, tilts in favor of Defendants. He would distinguish the decisions cited by the Plaintiff as the marks therein were not international non-proprietary names.

11. In rejoinder, Mr. Kamod would distinguish the decision in the case of ***Sun Pharmaceutical Laboratories Limited vs. Hetero Healthcare Ltd.*** (supra) to contend that the said decision does not lay down an absolute proposition of law that there cannot be infringement of INN mark. He submits that in the facts of that case, the Court held that the marks were not similar and in present case, the Plaintiff's entire mark has been subsumed. Mr. Kamod would further submit that provisions of Section 13 of Trade Marks Act, 1999 creates a deeming fiction for

the purpose of Section 57 of the Trade Marks Act, 1999. He would further submit that balance of convenience is demonstrated as Plaintiff had been using the mark since the year 2003.

REASONS AND ANALYSIS :

12. The prayer clause seeks relief of restraining the Defendants from infringing the Plaintiff's registered trade mark ACECLO and ACECLO-MR and from adopting or using the mark "ACECLO HEAL"/"ACECLOHEAL-MR" or "ACECLO" per se or in combination with other words as trademark. Perusal of the registration certificates appended to the Plaint demonstrates that what was registered by the Plaintiff in the year 2003 was the mark "ARISTO ACECLO". Despite obtaining registration of the trade mark "ARISTO ACECLO", it is the Plaintiff's own case that it used the trademark in the manner which was at variance with the registered trade mark by depicting the word "ARISTO" insignificantly and prominently displaying the word "ACECLO". It is only in the year 2011 that the Plaintiffs obtained registration of the mark "ACECLO" and its variants subsequently. The Plaintiff's conduct of using the mark at variance from the registered trade mark disentitles the Plaintiff to seek any support from the user since the year 2003 to claim distinctiveness.

13. It is the admitted position that the Plaintiff's trade mark is derived from the word "Acceclofenac", which is the drug's active pharmaceutical ingredient. The Defendant No 1 has placed on record

the list of INN's, which includes the word "Aceclofenac" as an INN. The primary defense is that the Plaintiff's trade mark ACECLO being derived from the generic drug Aceclofenac which is an INN, no exclusivity can be claimed. In this context, it would be apposite to refer to Section 13 of the Trade Marks Act, 1999 which reads as under:

"13. Prohibition of registration of names of chemical elements or international non-proprietary names.—No word—

(a) which is the commonly used and accepted name of any single chemical element or any single chemical compound (as distinguished from a mixture) in respect of a chemical substance or preparation, or

(b) which is declared by the World Health Organisation and notified in the prescribed manner by the Registrar from time to time, as an international non-proprietary name or which is deceptively similar to such name,

shall be registered as a trade mark and any such registration shall be deemed for the purpose of section 57 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register, as the circumstances may require."

14. Section 13 of the Trade Marks Act, 1999 prohibits the registration of an INN or a name which is deceptively similar to such a name. It further provides that any such registration shall be deemed for purpose of Section 57 to be any entry made without sufficient cause or an entry wrongly remaining on the register. The source of the Plaintiff's mark is to be found in the list of INN's. The INN's are inherently non registrable being *publici juris*. INN's are unique, globally recognized generic names for a pharmaceutical substance or active ingredient, which facilitate the identification of active pharmaceutical ingredient and are in public domain. The names included in list of INNs cannot be monopolized by any entity and Section 13 operates to

render the generic name incapable of registration.

15. To counter this objection, Mr. Kamod would seek to take support of Section 28 of the Trade Marks Act, 1999 and submit that in absence of any challenge to validity of the registered trade mark, which if challenged, will have to fit in the Lupin principles, the Plaintiffs are entitled to exclusive right. According to him the use of the words “deceptively similar name” in Section 13 of Trade Marks Act, 1999 would mean a similar sounding name such as Aceclodenac or so and that Aceclo is not the same as Aceclofenac. I am unable to accept the said contentions. The Plaintiff’s trade mark is “Aceclo” and is derived from Aceclofenac by deleting the last five alphabets from the INN, whereas, the Defendants trade mark is derived from Aceclofenac by deleting last five alphabets and suffixing it with the name of the Defendant No 1 Company i.e. “Heal”. The Plaintiff’s trade mark is a clipped version of the INN and is largely derived from the generic source and hence can only be termed as descriptive. It is no answer to say that the Plaintiff’s mark is Aceclo whereas the INN is Acecelofenac. The use of the words “deceptively similar to such name” takes within its fold even the clipped version.

16. Section 13 of the Trade Marks Act, 1999 would render the generic name non-registrable and in addition for purpose of Section 57 creates a deeming fiction for treating the entry being without sufficient cause or wrongly remaining in the register. It is not

necessary for the Defendants to challenge the validity of the Plaintiff's registration as the Plaintiff's cannot monopolise an INN. A nuanced approach is required to be applied for co-existence of trade marks derived from the active pharmaceutical ingredient especially in case of an INN. No entity can claim exclusive rights over generic or descriptive words which are *prima facie publici juris*.

17. Mr. Singh has rightly placed reliance on decision of the Delhi High Court in ***Sun Pharmaceutical Laboratories Ltd v. Hetero HealthCare Ltd & Another*** (supra). The the Delhi High Court considered the decision of ***Schering Corporation & Others v. Alkem Laboratories Ltd*** (supra), where the rival marks were TEMODAL/TEMODAR vs TEMOKEM/TEMOGET. The Delhi High Court had held that the word TEMO was used for the active ingredient, which is *publici juris* and descriptive of chemical component Temozolomide and no exclusive right can be claimed by the Plaintiff therein. The Delhi High Court quoted the extract from McCarthy in Trademarks and Unfair Competition in paragraph 55 as under:

"Clearly, one seller cannot appropriate a previously used generic name of a thing and claim exclusive rights in it as a trademark, for that thing. Similarly, if one seller develops trademark rights in a term which a majority of the relevant public then appropriates as the name of a product, the mark is a victim of 'genericide' and trademark rights may cease. An abbreviation of generic name which still conveys to the buyer the original generic connotation of the abbreviated name is still generic."

18. In ***Sun Pharmaceutical Laboratories Ltd v. Hetero HealthCare Ltd & Another*** (supra), the rival marks "Letroze" and "Letero". The Delhi

High Court noted that the marks are derived from the INN "Letrozole" and considered the similarity of the marks in the background of the registered mark being derived from an INN and in the context of Section 13 of Trade Marks Act, 1999. The Court held that the Plaintiff's mark Letroz is not similar to the trade mark Letero merely because both the parties have adopted the initial letters of INN "Letrozole". The Delhi High Court upheld the finding of the Commercial Court that there is difference in the pronunciation of the rival marks therein and that the Plaintiff cannot stop the Defendant from using the alphabets of the generic name when the Plaintiff itself is using the same.

19. It will also be relevant to refer to decision of the Delhi High Court in the case of *M/s. Panacea Biotec Ltd. vs. K M/s. Recon Ltd.*⁷, where it was observed thus:-

"6. From a comparison of the two it is clear that the first three letters of the trade mark of the plaintiff have been taken from the name of the drug "Nimesulide". Suffix of the trade mark of the plaintiff consists of four letters which are 'ULID' and the same have also been taken from the last but four letters of the name of the same drug. It appears that the Plaintiff has adopted trade mark 'NIMULID' in view of its near similarity or resemblance with the name of the basic drug 'Nimesulide'. In fact NIMULID can be taken as short form for the generic name of the drug 'Nimesulide'. The trade mark of the plaintiff is descriptive in nature indicate of the composition of the medicine. It is well settled that no person can claim exclusive use of the descriptive and generic terms. It would be highly undesirable to confer on one trader proprietary right over the use of an ordinary, descriptive or a generic word indicative of the nature, composition and quality of the goods as that would give him complete monopoly to exploit the word to the exclusion of others. A word which can qualify as an exclusive mark of a trader must be distinctive so as to distinguish his goods from those of the other persons.

⁷ 1996 PTC 16.

9. Having regard to the aforesaid decisions I am of the opinion that where a party uses a descriptive and generic term for its trade mark it cannot be given sole right to use the same to the exclusion of other traders. Commonly used words in trade and descriptive of the nature or colour or laudatory of the quality of the goods cannot be permitted to be monopolised. Similarly, in the case of a medicine, if a manufacturer uses the name of the basic drug of which it is constituted, no monopoly can be claimed by him in regard to the use of the same as his trade mark. (emphasis supplied)

20. In the present case, the rival marks are Aceclo and Acelcoheal. The Plaintiff has adopted a clipped version of the INN Aceclofenac and cannot claim infringement when the Defendants adopts the clipped version and suffixes the same with its name HEAL. The Plaintiff's product prominently bears the mark "Aceclo" and "Aceclo-MR" as well as the Plaintiff's logo, whereas the Defendant No 1's product is marketed under the trade mark "Acecloheal TH" and "Acecloheal-MR" depicted in different font. *Prima facie* the rival marks are depicted in different style and there is no possibility of causing confusion as the marks are dissimilar. In my view, where the rival marks are derived from an INN and incorporates letters of the INN, the usual test of deceptive similarity by reason of the entire mark being subsumed in the impugned mark cannot constitute the sole criteria. It is also stated by Defendant No. 1 that there is vast difference in pricing of the two products, which has not been denied by the Plaintiff in its Rejoinder Affidavit. The possibility of confusion *prima facie* appears to be bleak.

21. In the case of ***F. Hoffman-La Roche & Co. Ltd. vs Goeffrey Manners and Co. Pvt. Ltd.***⁸, the rival marks before the Hon'ble Apex Court were Dropovit and Protovit. Since both the marks used Vit as common suffix, the Hon'ble Apex Court took into account only the first half and compared the marks for similarity. The Hon'ble Apex Court held that it is apparent that the terminal syllable "VIT" in the two marks is both descriptive and common to the trade. If greater regard is paid to the uncommon element in these two words, it is difficult to hold that one will be mistaken for or confused with the other. Since the common portion was descriptive, the Hon'ble Apex Court decided on the basis of uncommon parts and considered the marks to be dissimilar.

22. It is not necessary for the Defendant No 1 to demonstrate extensive use as inclusion in list of INNs *prima facie* establishes the mark to be *publici juris*. Even if the impugned mark is used by the Plaintiff and the Defendant No 1 in the trademark sense and not in the descriptive sense, no statutorily protected monopoly is available to the Plaintiff to prevent the others from using as their trade mark, the generic name of the drug. The registration of the Plaintiff's trade mark will not prevent the use of an INN by the Defendants.

23. Insofar as the other defense of the drugs being Schedule-H drug, the decision of the Hon'ble Apex Court in the case of ***Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd.*** (supra) is sufficient answer to the same. The contention of Mr. Kamod that the Defendant No 1

8 1970 AIR 2062.

has not set out any invoices, sales etc are irrelevant as it is the Plaintiff's own case that the Defendants are using the impugned mark in respect of the impugned product. It is not necessary for the Defendants to set out its sales figure or reputation or goodwill as the Defendants do not seek to assert any right over the generic name.

24. Insofar as the relief of passing off is concerned, the same is a tortious action in deceit. The case put up in the Plaint is that by reason of unauthorised adoption of deceptively similar trade mark, amounts to infringement of the Plaintiff's trade mark resulting in passing off for unlawful gains. The considerations in respect of infringement and passing off may overlap. Alongwith reputation, goodwill and likelihood of damages, *prima facie* it must be demonstrated an attempt to misrepresent the Defendant's goods as that of the Plaintiffs. I do not find any material to *prima facie* hold that the Defendants have designed their goods in a manner as to pass off its goods as that of the Plaintiffs. The packaging and the depiction of the respective trade marks on the products distinguishes the goods of the Plaintiff from that of the Defendants. The difference in pricing is also a significant aspect. More so when the Defendant No 1 has produced photographs to show use of the clipped version of INN i.e. Acecelofenac by many other companies. Mr. Singh is also right in pointing out to the case for passing off as set out in the Rejoinder Affidavit, that the chemist is likely to offer the drug bearing the impugned mark, persuade and

convince the buyer that the Acecloheal is same as Aceclo. There is no *prima facie* case of misrepresentation by the Defendants made out. In none of the decisions cited by Mr. Kamod, the registered trademark was derived from an INN and the decisions dealing with the issue of deceptive similarity was *de-hors* the consideration of Section 13 of Trade Marks Act, 1999. There is no quarrel with the propositions laid down in the said decisions, however the same are inapplicable to the present case.

25. In light of the above discussion, the Plaintiff having failed to make out *prima facie* case for infringement of trade mark and passing off, the Interim Application stands dismissed.

[Sharmila U. Deshmukh, J.]