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C.S.No.55 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 10.11.2023

Pronounced on : 20.11.2023

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

C.S.(Comm.Div.) No.55 of 2023

Apollo Hospitals Enterprises Ltd.,
Having its registered office at
No.19, Bishop Gardens,
Raja Annamalaipuram,
Chennai – 28.

Rep. By its authorized signatory

Mr.S.M.Mohan Kumar – Manager Legal ... Plaintiff

Vs.

Dr.Dheeraj Saurabh
Proprietor of
NEW APOLLO HOSPITAL,
NH-28, Betia Road,
Motihari, Bihar – 845 401.

... Defendant

Prayer: Civil Suit is filed under Order IV Rule 1 of O.S. Rules read with Order VII Rule 1 CPC, Sections 27, 28, 29, 134 & 135 of the Trademarks Act, 1999, and Section 7 of the Commercial Courts Act, praying:-



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(a) to declare the ‘Apollo’ Markas **WELL-KNOWN** Trade Mark under Section 2 (1) (zg) read with Section 11 of the Trade Marks Act, 1999 and issue consequently directions to appropriate authorities;

(b) to grant permanent injunction restraining the Defendant, its proprietor/directors/partners officers, dealers, distributors, successors-in-business, servants, agents, employees, representatives and all other persons claiming through or under them from in any manner from infringing the registered trademarks of the Plaintiff including “Apollo” “Apollo Hospitals” “Apollo Diagnostics” and “Apollo Clinic” and its variants by using the “New Appolo Hospital” and/or any other mark identical and/or deceptively similar mark in any other manner whatsoever;

(c) to grant permanent injunction restraining the Defendant, its proprietor/directors/partners, officers, dealers, distributors, successors-in-business, servants, agents, employees, representatives and all other persons claiming through or under them from in any manner from passing off and/or enabling others to pass off the Plaintiff’s trademarks “Apollo” “Apollo Hospitals” “Apollo Diagnostics” and “Apollo Clinic” and its variants by using the “New Appolo Hospital” and/or any other mark identical and/or deceptively similar mark in any other manner whatsoever;

(d) to grant permanent injunction restraining the Defendants its proprietor/directors/partners and officers, dealers, distributors successors-in-business, servants, agents, employees, representatives and



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all others persons claiming through or under them from in any manner from diluting the distinctive character of Plaintiff's trademarks "Apollo" "Apollo Hospitals" "Apollo Diagnostics" and "Apollo Clinic" and its variants or indulging in any activity which takes unfair advantage of Plaintiff's goodwill and reputation in Plaintiff's registered trademarks or by any activity amounting to unfair trade practice;

(e) the Defendant be ordered to surrender to the Plaintiff for destruction all labels, cartons, containers, packaging materials, blocks, dyes, prints, screen prints, notices, pamphlets, advertisements, hoardings, and other promotional materials bearing the "New Appolo Hospital" mark which is identical to the Plaintiff's registered trademark "Apollo" "Apollo Hospitals" "Apollo Diagnostics" and "Apollo Clinic" and its variants;

(f) Pass a Preliminary decree in favour of the Plaintiff directing the Defendant for rendition of their accounts of sales and profits of the impugned goods sold by the Defendants under the impugned mark "New Appolo Hospital" and a final decree be passed in favour of the Plaintiff for the amount of profit found to have been made by the Defendant after such accounts are rendered;

(h) Defendant be ordered and decreed to pay the Plaintiff a sum of Rs. 10,00,000/- as punitive and compensatory damages for committing acts of infringement of trademark and passing off or such other sum as may be found due and payable by this Hon'ble Court after an account of the profits made by the Defendants is rendered; and

(h) An order as to costs of the proceedings;



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For Plaintiff : Mr.H..Siddarth
for M/s.Cibi vishnu & P.Giridharan

Defendant is set exparte

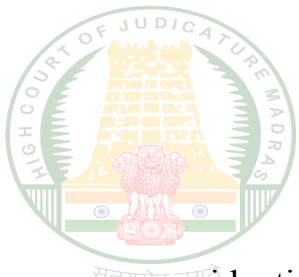
JUDGMENT

This suit has been filed seeking the following reliefs;

(a) to declare the registered mark 'Apollo' as a well-known trademark as per the provisions of Section 2(1)(zg) read with Section 11 of the Trade Marks Act, 1999 (in short “the Act”);

(b) to grant permanent injunction restraining the defendant from infringing the registered trademarks of the plaintiff including 'Apollo', 'Apollo Hospitals', 'Apollo Diagnostics' and 'Apollo Clinic' and its variants by using the 'New Appolo Hospital' and/or any other mark identical and/or deceptively similar mark in any other manner whatsoever;

(c) to grant permanent injunction restraining the defendant from passing off and/or enabling others to pass off the plaintiff's trademarks 'Apollo', 'Apollo Hospitals', 'Apollo Diagnostics' and 'Apollo Clinic' and its variants by using the 'New Appolo Hospital' and/or any other mark



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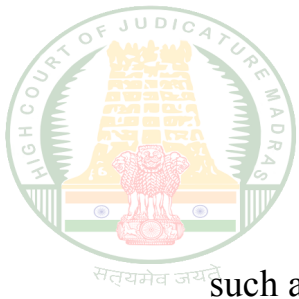
identical and/or deceptively similar mark in any other manner
whatsoever;

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(d) to grant permanent injunction restraining the defendant from diluting the distinctive character of the plaintiff's trademarks 'Apollo', 'Apollo Hospitals', 'Apollo Diagnostics' and 'Apollo Clinic' and its variants or indulging in any activity which takes unfair advantage of plaintiff's goodwill and reputation in plaintiff's registered trademarks or by any activity amounting to unfair trade practice;

(e) the defendant be ordered to surrender to the plaintiff for destruction of all labels, cartons, containers, packaging materials, blocks, dyes, prints, screen prints, notices, pamphlets, advertisements, hoardings, and other promotional materials bearing the 'New Appolo Hospital' mark which is identical to the plaintiff's registered trademarks 'Apollo', 'Apollo Hospitals', 'Apollo Diagnostics' and 'Apollo Clinic' and its variants;

(f) to pass a preliminary decree in favour of the plaintiff directing the defendant for rendition of their accounts of sales and profits of the impugned goods sold by the defendant under the impugned mark 'New Appolo Hospital' and a final decree be passed in favour of the plaintiff for the amount of profit found to have been made by the defendant after



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such accounts are rendered;

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(g) the defendant be ordered and decreed to pay the plaintiff a sum of Rs.10,00,000/- as punitive and compensatory damages for committing acts of infringement of trademark and passing off or such other sum as may be found due and payable after an account of the profits made by the defendant is rendered; and

(h) to direct the defendant to pay the costs of this suit.

2. Despite service of suit summons on the defendant, they have chosen not to defend the suit. Earlier, the defendant had entered appearance through a counsel and had given an undertaking through their counsel that they had stopped using the trademark “New Appolo Hospital”, subsequent to the grant of interim injunction by this Court through its order dated 13.03.2023. Thereafter, the learned counsel for the defendant reported “no instructions” on 11.08.2023 and a memo to that effect was also filed by the said learned counsel. Since none appeared on behalf of the defendant thereafter, the defendant was set *exparte* by this Court on 11.08.2023.



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3. The plaintiff, with regard to their reputation as a leading hospital, has made the following averments in the plaint:-

(i) The Plaintiff owns and operates the world-famous Apollo Hospitals Group of Medical Establishments ranging from hospitals, clinics, diagnostic centers, telemedicine facilities, pharmacies, etc with various specialty facilities such as for cancer treatment, dentistry, child and pediatrics, cardiovascular, transplants, etc. The Plaintiff is a pioneer in the field of treatment of various ailments.

(ii) It is submitted that the Plaintiff company was established by Dr. Prathap C. Reddy, Padma Vibhushan (2010) on 05.12.1979. Dr. Reddy was an established doctor with a flourishing practice in Boston, USA, but left all that behind and returned to India in 1971 to establish a socially motivated medical practice. On his return he found the medical landscape in the country plagued by gaps in infrastructure, delivery and affordability. Dr. Reddy was motivated to establish a hospital by the loss of a young patient who could not afford to go abroad for treatment. This set the blueprint to build India's first multi-specialty private sector hospital to provide quality healthcare to Indians in India.

(iii) The Plaintiff's vision is to "bring healthcare of international standards within the reach of every



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individual", and the Plaintiff is further "committed to the achievement, and maintenance of excellence in education, research and healthcare for the benefit of humanity".

(iv) It is submitted that the Plaintiff adopted the unique trademark "Apollo, "Apollo Hospital', "Apollo Diagnostic' and 'Apollo Clinic' to be used as is trademarks with respect to all its hospitals and other medical undertakings. Prior to the Plaintiff no other person had adopted the said "Apollo', "Apollo Hospital', 'Apollo Clinic" or "Apollo Diagnostic' trademarks in the field of pharma, healthcare and medical services and products. The Plaintiff also has other registered marks associated with the aforesaid trademarks incorporating "Apollo' / "Apollo Hospitals and its brands and logos. Till date there has been no objection nor any limitation placed on the Plaintiff's registered trademarks. The trademarks are valid and subsisting in favour of the Plaintiff as on date.

(v) It is submitted that Apollo Hospitals is the forerunner of integrated healthcare in Asia, and has also become a name to reckon with globally as well. The Plaintiff's flagship Apollo Hospital at Chennai was started with just 150 beds and was inaugurated by the then President of India, his Excellency, Shri Giani Zail Singh. Today, the Plaintiff group's futuristic vision and



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decades of established quality of services has ensured that it is in the highest position at every touch point of the healthcare delivery chain. Apollo has over 10,000 beds across 71 hospitals, more than 5,000 pharmacies, over 2,257 primary care & diagnostic clinics including sugar and dental clinics, birthing, day care and dialysis centre, more than 800 Tele-medicine, Tele-Radiology, Tele-Cardiology, units across various countries, health insurance services, global projects consultancy, 5 academic institutions and a Medical Research Foundation with a focus on global clinical trials, epidemiological studies, stem-cell and genetic research.

(vi) It is submitted that the Plaintiff has several Apollo Hospitals across India including Tamil Nadu, Andhra Pradesh, Karnataka, Chhattisgarh, Odisha, Gujarat, West Bengal, Delhi to name a few. It is further submitted that the Plaintiff also has several hospitals abroad in SriLanka, Bangladesh, Ghana, Nigeria, Mauritius, Qatar, Kuwait and Oman among others and employs more than 70,000 persons including over 11,000 doctors, 10,000 nurses and 5000 paramedics. The Apollo group has made quality healthcare accessible to the people of India, and even overseas. It has become an institution of trust, and a beacon of hope to so many searching for a cure for their ailments.



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(vii) *It is submitted that the Plaintiff is an integrated healthcare organization with owned and managed hospitals, diagnostic clinics, dispensing pharmacies and consultancy services, through its Apollo Hospitals, Apollo Clinics, Apollo Pharmacy, etc. In addition, the Plaintiff's service offerings include healthcare at the patient's doorstep clinical & diagnostic services, medical business process outsourcing, third party administration services and health insurance. To enhance performance and service to customers, the Plaintiff also makes available the services to support telemedicine services, education, training programs & research services and a host of other non-profit projects. In the three decades of service, the Apollo Group through its Hospitals, Clinics, Primary Care & Diagnostic Centres, Pharmacies, and medical out - reach programmes, has scripted one of the most magnificent stories of success that India has seen. Not only is the Apollo Group one of the largest integrated healthcare groups in the region, it has also successfully catalysed the private healthcare revolution in the country and the world. Plaintiff has provided medical care to approximately 120 million lives from over 120 countries.*

(viii) *It is submitted that the Plaintiff's service offerings include healthcare at the patient's doorstep,*



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clinical & diagnostic services, medical business process outsourcing, third party administration services and health insurance. To enhance performance and service to customers, the Plaintiff also makes available the services to support business, telemedicine services, education, training programs & research services and a host of other non-profit projects.

(ix) It is submitted that the hospitals in the Plaintiff's Group have performed over 7,600 cardiac surgeries (the highest in a year) with 99.2% success rate. Apollo Hospitals, Chennai, completed 25,000 coronary bypass surgeries. Plaintiff's Group performed over 450 liver transplants including on both children and adults. There are over 35,000 beneficiaries in the various medical camps and outreach programs organised by the hospitals in the group.

(x) In furtherance of the Plaintiff's commitment to increase availability of healthcare to all sections of society led to the birth of Apollo Reach Hospitals an initiative of the Plaintiff to reach tertiary healthcare to rural areas. This is the first major initiative by the private sector to provide high quality medical facilities to the rural population. The first such hospital in the country – Apollo Reach Hospitals, Karimnagar, has 150 beds and successfully performed the following procedures within



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three months of its inauguration

(a) Open Heart Surgery with Cardiopulmonary Bypass on a 14 year old girl with congenital heart defect (Ventricular Septal Defect with pulmonary Stenosis). The patient was discharged 6 days after the surgery.

(b) Placement of a Permanent Pace Maker on a 70 year old man with Complete Heart Block. This patient was admitted in emergency with complaints of recurrent episodes of blackouts and was found to have complete heart block.

(c) Mitral Valve Replacement on a 55 year old female patient suffering from severe Mitral Stenosis with LA clot. The patient was discharged on the sixth day of the surgery.

(d) Angioplasty through Radial Artery - a highly skilled procedure performed at very few centers.

(e) Angioplasty with Stent placement on a 38 year old patient.

(f) Separation of conjoined twins. The twins, who were joined at the posterior, shared an anus, urinary passage and a penis -- a rare condition called as pygopagus twins.

(xi) It is submitted that the Plaintiff has also successfully ventured into the pharmaceutical market.



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Plaintiff's Apollo Pharmacy chain is India's first and largest branded network with more than 5000 operational outlets across various states in India. The Plaintiff also runs an e-commerce platform by name Apollo 24x7 offering medicines online.

(xii) The Plaintiff has launched Telemedicine Solutions which includes Teleradiology, Teleconsulting, Telemonitoring, and Telesurgery. The Plaintiff's Apollo Tele-Health Services has been granted an ISO 13131:2021 certificate by the British Standards Institution (BSI) becoming the 1st ever organization globally to attain the standard of ISO 13131:2021.

(xiii) It is submitted that the Plaintiff has also forayed into stem cell research on a non-profit basis through its Molecular Biology Research Centre at Hyderabad. The Plaintiff has also established a Apollo Spine Clinic and Apollo Liver Clinic abroad in Oman.

(xiv) It is submitted that the Plaintiff has also set up 25 wellness centres at the premises of various top Indian companies in Bangalore with vision to spread such centres across India. The Plaintiff, through its group hospitals, clinics and diagnostic centres participated in disaster management activities and provided medications, food, doctors, nurses, ambulances for flood relief in Andhra Pradesh.



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(xv) *It is submitted that the Plaintiff had started Apollo Diagnostics in 2012 and its network today includes more than 523 centres across India, with more than 1,000 employees such as Phicbotomists, Lab Technicians, Pathologists, Marketing & Sales professionals. Apollo Diagnostics is a one stop solution for about 3500 pathology tests from the routine to the complex. It is a business unit of the Plaintiff's subsidiary, Apollo Health and Lifestyle Limited.*

(xvi) *It is submitted that Apollo Diagnostics focuses on quality diagnostic services within the reach of health seeker. Services are offered in the areas of Biochemistry, Clinical Pathology, Cytopathology, Hematology, Histopathology, Immunology, Microbiology, Molecular Genetics, Molecular Diagnostics and Serology. The clinical laboratory testing services at Apollo Diagnostics include: Blood Tests, Body Fluid Testing, Tissue Pathology & Cytology, General Health Screening & Monitoring Tests, Drug Screening & Testing as well as Gene - based Testing (Genetic Testing). Apollo Diagnostics offers free Home Sample Collection services.*

(xvii) *It is pertinent to state that over the years the Plaintiff has brought into the country the best that the world has to offer in terms of technology. India's first 64 slice PET-CT system installed at Apollo Speciality Cancer*



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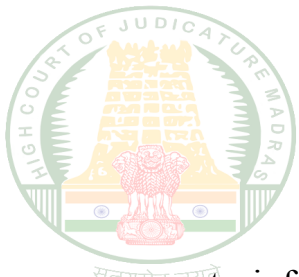


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Hospital, Chennai. State-of-the-art radio surgery equipment, Novalis Tx was commissioned at Apollo Hospitals Hyderabad.

(xviii) It is submitted that the Plaintiff today is also regularly contacted for the management and operations of other hospitals in India and abroad. The Apollo Global Project is amongst the largest hospital consultants in the world. As part of its services the Plaintiff also contracts with its business Partners to lend its name and all other marks, logos and Intellectual property associated with the Plaintiff. The success of the hospitals consultancy limb of the Plaintiff's operations is that immense value is attached to its intellectual property. The unique name "Apollo" used by the Plaintiff is recognised and associated with the Plaintiff, worldwide. As on date hospitals in various countries across the world use the Plaintiff's Trademark.

4. The plaintiff came to know in the month of July, 2022, that the defendant has blatantly adopted a deceptively similar mark by name 'New Appolo Hospital' for its hospital business. The plaintiff has therefore sent a cease and desist notice dated 21.07.2022 calling upon the defendant not to use the mark 'New Appolo Hospital' as it would amount



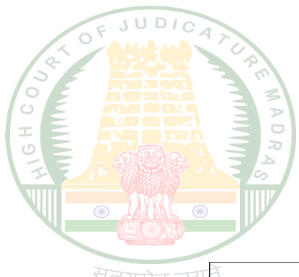
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to infringement and passing off. Since the defendant in its reply dated 13.09.2022 to the cease and desist notice dated 21.07.2022 refused to accept their guilty and stop using the offending trademark, the plaintiff was constrained to file this suit seeking for the reliefs as prayed for in the plaint.

5. Before the Additional Master-II, the authorised signatory of the plaintiff by name S.M.Mohan Kumar, Manager (Legal), was examined as a witness-PW1 on the side of the plaintiff. Through PW1, the following documents were marked as exhibits on the side of the plaintiff:-

Date	Nature of documents	Exhibits
05.12.1979	Incorporation certificate of the plaintiff	Ex.P1
27.12.1979	Commencement of business of plaintiff	Ex.P2
2021-2022	Extract of plaintiff's annual report	Ex.P3
08.10.2001 to 18.03.2020	Legal use certificate/registration certificates for marks Apollo	Ex.P4
26.08.2008	Copy of registration certificate for the artistic work	Ex.P5
16.03.2022	Trademark assignment agreement between the plaintiff and its subsidiary Apollo Healthco Ltd.	Ex.P6
02.11.2009	First commemorative stamp	Ex.P7
04.11.2014	Second commemorative stamp	Ex.P8
19.02.2019	Third commemorative stamp	Ex.P9
	List of awards, honors of doctors of plaintiff's company and manage	Ex.P10



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Date	Nature of documents	Exhibits
21.07.2022	Cease and desist notice sent by the plaintiff to the defendant	Ex.P11
30.09.2022	Reply issued by the counsel for the defendant	Ex.P12
22.12.2022	Original certificate of chartered Accountant	Ex.P13
	List of plaintiff's active mark download copy with 65B	Ex.P14
	Downloaded copy of the domain name owned by the plaintiff	Ex.P15
	Downloaded copy of the list of plaintiff branches in India	Ex.P16
	Downloaded copy of photo of defendant's signboard	Ex.P17
15.10.2020	Board resolution	Ex.P18
	Original 65B certificate, affidavit under Section 65B Evidence Act	Ex.P19

PW1 has also reiterated the contents of the plaint in his proof affidavit.

6. The learned counsel for the plaintiff has relied upon the following authorities in support of his contentions:-

(i) Godfrey Philips India Ltd. Vs. Girnar Foods & Beverages (P) Ltd [2004 (5) SCC 257];

(ii) Bennet, Coleman and Company Ltd. Vs. Vnow Technologies Private Limited and another [2023 SCC Online Del 864];

(iii) PEPS Industries Private Limited Vs. Kurlon Limited [2022 SCC Online Del 3275];

(iv) Apollo Hospitals Enterprises Ltd. Vs. Sri Sai Apollo Pharmacy [2018 (74) PTC 199 (Mad)];



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(v) Apollo Hospitals Enterprises Ltd. Vs. Naseer Apollo Pharmacy [2019 (77) PTC 344 (Mad)];

(vi) Apollo Hospitals Enterprises Ltd. Vs. Sai Apollo Medicals [MANU/TN/3010/2018]; and

(vii) Apollo Hospitals Enterprises Ltd. Vs. Mahesh Apollo Pharmacy [2016 (67) PTC 167 (Mad)].

7. The issues that arise for consideration in this suit are as follows:-

(a) Whether the plaintiff has proprietary right to the trademarks 'Apollo', 'Apollo Hospital', 'Apollo Diagnostic' and 'Apollo Clinic' and its variants?

(b) Whether the plaintiff's trademark falls within the definition of Well-Known mark within the meaning of Section 2(1)(zg) of the Trade Marks Act?

(c) Whether the plaintiff is entitled for damages and surrender of infringed materials by the defendant and rendition of accounts by the defendant as sought for in prayer (e), (f) and (g) of the plaint?

(d) Whether the use of the word "New Appolo Hospitals" by the defendant would



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amount to infringing the trademark of the plaintiff? and

(e) To what other reliefs the plaintiff is entitled to?

Issue (a):-

Whether the plaintiff has proprietary right over the trademarks 'Apollo', 'Apollo Hospital', 'Apollo Diagnostic' and 'Apollo Clinic' and its variants?

8. The plaintiff has *inter alia* registered the trademark 'Apollo' in Class 42 with respect to all medical services, which includes dispensing of pharmaceutical products and services. The plaintiff has registered the trademark “Apollo Hospitals” under Classes 5, 35 and 42. The plaintiff has registered the trademark “Apollo Clinic” under Classes 5, 10, 16, 35, 42 and 44. The plaintiff has registered the trademark “Apollo Diagnostic” under Classes 5, 10, 16, 35 & 44. The legal usage certificate of the aforesaid marks of the plaintiff have been marked as Ex.P4. The Assignment Agreement between the plaintiff and its subsidiary Apollo Health Co. Ltd. is marked as Ex.P6.



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9. In addition to the trademark 'Apollo', 'Apollo Hospitals', 'Apollo Pharmacy' and other related brands and logos, the plaintiff is also the owner of the copyright of the labels consisting of 'Apollo', 'Apollo Hospitals', 'Apollo Pharmacy' and other variants thereto presented using a distinct font and colored background, a stylized device and other distinctive elements. The domain name owned by the plaintiff has been marked as Ex.P15.

10. The plaintiff has obtained registration under the Copyright Act for 'Apollo', 'Apollo Hospitals' and 'Apollo Pharmacy' under the registration dated 26.08.2008. By virtue of the registration, the plaintiff has got right over the artistic work in the label. All rights, title and interest in the artistic work for 'Apollo', 'Apollo Hospitals' and 'Apollo Pharmacy' labels vests with the plaintiff and the use of any identical label or deceptively similar label by anyone amounts to passing off and infringement of copyright. The Copyright Registration Certificates for 'Apollo', 'Apollo Hospital', 'Apollo Pharmaceutical' have been marked as Ex.P5.



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11. Therefore, it is clear from the documentary evidence placed on record before this Court that the plaintiff has proprietary right over the trademark 'Apollo' and its variants. Infact, the registration under various classes shows that the plaintiff has got various proprietary rights and rights as conferred for registration as applicable for a registered proprietor. Therefore, issue (a) is decided in favour of the plaintiff by declaring that the plaintiff has proprietary right to the trademarks 'Apollo', 'Apollo Hospitals', 'Apollo Clinic' and 'Apollo Diagnostic' and its variants.

Issue (b):-

(b) Whether the plaintiff's trademark falls within the definition of Well-Known mark within the meaning of Section 2(1)(zg) of the Trade Marks Act?

12. This Court earlier had a doubt as to whether concurrent powers are vested with both the trademark registry as well as this Court for granting recognition for a particular trademark as a well-known mark. In the year 2017, the Trade Marks Rules were amended empowering the



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trademark registry to grant recognition of a trademark as a well-known mark within the meaning of Section 2(1)(zg) of the Act, but, did not exclude the power of the Court also to grant such a recognition. Prior to the amendment of the Trade Marks Rules in the year 2017, the power to grant recognition of a trademark as a well-known mark was vested only with the Court. Only due to the said reason, a doubt had arisen in the mind of this Court as to whether, with the amendment of the Trade Marks Rules, 2017, the power of this Court to grant recognition of a trademark as a well-known mark has been ousted. To get over the doubt, this Court had to analyze the provisions of Sections 11(6) and 2(1)(zg) of the Act and the amended Trade Marks Rules, 2017, pertaining to grant of recognition by the trademark registry for a trademark to be recognized as a well-known mark.

13. After analyzing the said provisions and the authorities pertaining to grant of recognition of a trademark as a well-known mark, this Court is now convinced that concurrent powers are vested with both this Court as well as the Trade Marks Registry for granting recognition to a trademark as a well-known mark.



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14. Section 2(1)(zg) of the Act defines a 'well – known trademark' in relation to any goods or services, as "a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services." The above definition clearly demonstrates the extraordinary protection provided to a well-known mark.

15. The relevant provisions under the Trade Marks Act, 1999, with regard to “well-known” marks, are as follows:-

(a) Section 11(2) recognizes one of the relative grounds of refusal of a trade mark stating that a trade mark shall not be registered if or to the extent the earlier trade mark being a well-known trademark in India.

(b) Section 11(6) lays down the criteria for determination of a well-known mark, which is as follows:-

(i) The knowledge or recognition of that trademark in the relevant



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section of the public including knowledge in India obtained as a result of promotion of the trademark;

(ii) the duration, extent and geographical area of any use of that trademark;

(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent that they reflect the use or recognition of the trade mark;

(v) the record of successful enforcement of the rights in that trade mark, in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

(c) Section 11(9) lays down the conditions/factors which are taken into consideration for grant of a well-known trademark. They are as follows:-

(i) That the Trademark is registered in India.



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(ii) That public at large has knowledge of the trademark .

(iii) That the Trademark has been used in India.

(iv) Application for registration of trademark is underway in India

(v) That the trademark is registered in any other jurisdiction

(d) Section 11(10) sets out an obligation on the Registrar of Trade Marks to protect a well-known trademark against marks which are identical and/or similar.

16. As seen from the aforesaid sections and in particular, Section 11(6) of the Trademarks Act, 1999, it is clear that both the Registrar of Trademarks as well as the Court having competent jurisdiction can recognize a trademark as a well-known mark. The Trademarks Act does not prohibit this Court, which is a competent Court, from recognizing the plaintiff's trademark as well-known marks.

17. Rule 124 of the Trade Marks Rules of 2017, which empowers the trademark registry to grant recognition of a trademark as a well-known mark, also makes it clear that once the Court passes an order recognizing a trademark as a well-known mark, trademark registry will



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have to give due consideration to the said recognition, while adjudicating as to whether the applicant is entitled to be granted the recognition of its trademark as a well-known mark. As seen from Section 11(6) of the Act, for adjudicating whether a trademark is a well-known mark or not, the following 10 factors will have to be considered:-

- (i) The extent of knowledge of the mark vis-à-vis the relevant public segment;
- (ii) Duration of use;
- (iii) Extent of product and services to which the mark is being used;
- (iv) Method, frequency and duration of advertising and promotion of the mark;
- (v) Geographical extent of trading area where the mark is being used
- (vi) Registration of the mark;
- (vii) Volume of goods and services being sold under the mark;
- (viii) Nature and extent of use of same or similar marks by other parties;
- (ix) Extent to which rights claimed in the mark have been



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successfully enforced; and

(x) Actual number of consumers consuming goods or availing services under the brand.

18. In the case of the plaintiff, the trademark 'Apollo' has satisfied all the tests required for granting recognition as a well-known mark. The exhibits marked on the side of the plaintiff make it clear that in respect of the healthcare industry, their trademark 'Apollo' and its variants is well-known, not only in India, but also in abroad. They have commenced their business in the year 1979 and over a period, they have established various hospitals, clinics, Daycare centres, pharmacies and other allied business, not only in India, but also in abroad. Their annual reports also prove that their turnover runs into several hundreds of crores of rupees and they have carved a niche for themselves in the health and pharmaceutical segments. Judicial notice can also be taken with regard to the said fact. Ten-factors tests highlighted supra are also satisfied by the plaintiff for recognizing their trademark as a well-known mark as per the provisions of Section 11(6) of the Act.

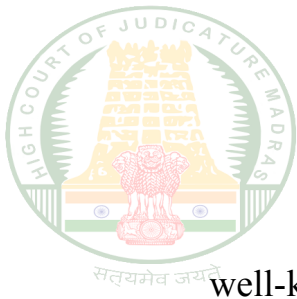


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19. The name 'Appolo' is perceived to be synonymous to the plaintiff and the plaintiff is therefore entitled to the highest level of protection as the public at large associate the name 'Apollo' only with the plaintiff insofar as health and pharmaceutical segments are concerned. Therefore, the plaintiff's trademark falls within the definition of well-known mark within the meaning of Section 2(1)(zg) of the Act and deserves protection, that is conferred to well-known marks under the Trade Marks Act.

20. The judgments relied upon by the learned counsel for the plaintiff during the course of his submissions also throw light on the circumstances when a trademark can be recognized as a well-known mark under Section 11(6) of the Act. In all those judgments, the respective High Courts have recognized the trademark involved in those cases as a well-known mark under Section 11(6) of the Act. The plaintiff's averments, oral and documentary evidence placed on record make it clear that the plaintiff's trademark 'Apollo' and its variants are well-known marks in the health and pharmaceutical industry. Hence, the plaintiff is entitled to get recognition by this Court for its trademark 'Apollo' as a



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well-known mark in respect of the healthcare and pharmaceutical segments. Accordingly, issue (b) is answered in favour of the plaintiff by declaring that the trademark 'Apollo' is a well-known mark as per the provisions of Section 11(6) read with Section 2(1)(zg) of the Act, insofar as health and pharmaceutical segments are concerned.

Issue (c):-

(c) Whether the plaintiff is entitled for damages, surrender of infringed materials and rendition of accounts by the defendant as sought for in prayer (e), (f) and (g) of the plaint?

21. The learned counsel for the plaintiff has made an endorsement in the plaint on instructions that the plaintiff is not pressing the relief as sought for in the prayer (e), (f) and (g) of the plaint. Hence, there is no necessity for this Court to adjudicate with regard to prayer (e), (f) and (g) of the plaint. Hence, the suit claim insofar as prayer (e), (f) and (g) of the plaint has to be dismissed as not pressed.

Issue (d):-

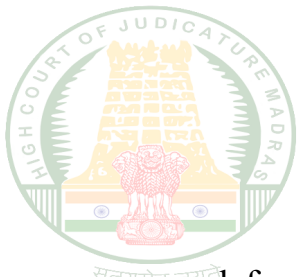


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Whether the use of the word “New Appollo Hospitals” by the defendant would amount to infringing the trademark of the plaintiff?

22. A cease and desist notice was sent by the plaintiff to the defendant on 21.07.2022, which has been marked as Ex.P11, calling upon the defendant not to use the same trade name 'Apollo'. However, despite the cease and desist notice, the defendant has been using the same trade name 'Apollo' for its hospital by naming it 'New Appollo Hospital'. As observed earlier, the plaintiff is having registration for its trademark 'Apollo' and its variants in different Classes under the Trade Marks Act. They have been using their trademark 'Apollo' and its variants ever since 1979. From the oral and documentary evidence available on record as well as from the plaint averments, it is clear that the defendant has been unauthorizedly using the mark 'New Appollo Hospital' despite having knowledge that the plaintiff being an established player in the healthcare and pharmaceutical sector is having trademarks registration for 'Apollo' and its variants and has attained secondary meaning on account of its long usage in the healthcare and pharmaceutical industry. The name 'New Appollo Hospital' used by the

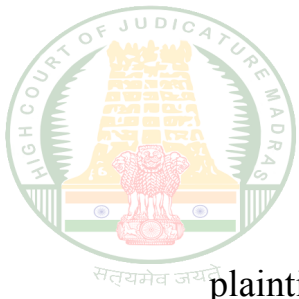


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defendant is deceptively similar to the plaintiff's trademark 'Apollo' and its variants.

23. Based on the oral and documentary evidence available on record, it is clear that only with a dishonest intention of making undue profits by using the trademark 'Apollo', which belongs exclusively to the plaintiff, the defendant has been using the name 'New Appolo Hospital'. Both the plaintiff and the defendant are in the same area of business. If the defendant is allowed to use the name 'New Appolo Hospital', it will certainly cause confusion in the minds of the public, who are familiar only with the usage of name 'Apollo' for healthcare and pharmaceutical sectors by the plaintiff alone and no one else. Being a deceptively similar mark to that of the plaintiff, the defendant should be permanently enjoined from using the name 'New Appolo Hospital' for its hospital business. The defendant has not only infringed the plaintiff's trademark, but also committed an act of passing off on account of the fact that the public will be deceived as they will be under the impression that 'New Appolo Hospital' is also an hospital run by the plaintiff, which, in reality, is not true. Therefore, permanent injunction reliefs sought for by the



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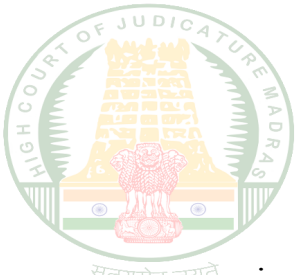
plaintiff in the suit as found in prayer (b) and (c) of the plaint have to be granted by this Court. Accordingly, issue (d) is answered in favour of the plaintiff. It is also to be noted that the defendant has already given an undertaking to this court through its counsel that they have stopped using the name 'Appolo' for their hospital, subsequent to the interim order passed by this Court.

24. In view of infringing and passing off committed by the defendant, the defendant will have to pay the costs of this suit.

25. For the foregoing reasons, this suit is partly decreed by granting the following reliefs:-

(a) It is declared that the mark 'Apollo' is a well-known trademark insofar as healthcare and pharmaceutical sector is concerned as per the provisions of Section 2(1)(zg) read with Section 11 of the Trade Marks Act, 1999.

(b) Permanent injunction is granted restraining the defendant from infringing the registered trademarks of the plaintiff including 'Apollo', 'Apollo Hospitals', 'Apollo Diagnostics' and 'Apollo Clinic' and its



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variants by using the 'New Appolo Hospital' and/or any other mark identical and/or deceptively similar mark in any other manner whatsoever.

(c) Permanent injunction is granted restraining the defendant from passing off and/or enabling others to pass off the plaintiff's trademarks 'Apollo', 'Apollo Hospitals', 'Apollo Diagnostics' and 'Apollo Clinic' and its variants by using the 'New Appolo Hospital' and/or any other mark identical and/or deceptively similar mark in any other manner whatsoever;

(d) Insofar as prayer (d), (e) and (f) sought for in the plaint is concerned, the same is dismissed as not pressed.

(e) The defendant is directed to pay the costs of this suit.

20.11.2023

Index: Yes/no
Speaking order/non-speaking
Neutral citation : Yes/no
rkm

Plaintiff's witness:



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Mr.S.M.Mohan Kumar - PW1

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Documents exhibited by the Plaintiff:

Date	Nature of documents	Exhibits
05.12.1979	Incorporation certificate of the plaintiff	Ex.P1
27.12.1979	Commencement of business of plaintiff	Ex.P2
2021-2022	Extract of plaintiff's annual report	Ex.P3
08.10.2001 to 18.03.2020	Legal use certificate/registration certificates for marks Apollo	Ex.P4
26.08.2008	Copy of registration certificate for the artistic work	Ex.P5
16.03.2022	Trademark assignment agreement between the plaintiff and its subsidiary Apollo Healthco Ltd.	Ex.P6
02.11.2009	First commemorative stamp	Ex.P7
04.11.2014	Second commemorative stamp	Ex.P8
19.02.2019	Third commemorative stamp	Ex.P9
	List of awards, honors of doctors of plaintiff's company and manage	Ex.P10
21.07.2022	Cease and desist notice sent by the plaintiff to the defendant	Ex.P11
30.09.2022	Reply issued by the counsel for the defendant	Ex.P12
22.12.2022	Original certificate of chartered Accountant	Ex.P13
	List of plaintiff's active mark download copy with 65B	Ex.P14
	Downloaded copy of the domain name owned by the plaintiff	Ex.P15
	Downloaded copy of the list of plaintiff branches in India	Ex.P16
	Downloaded copy of photo of defendant's signboard	Ex.P17
15.10.2020	Board resolution	Ex.P18
	Original 65B certificate, affidavit under Section 65B Evidence Act	Ex.P19

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ABDUL QUDDHOSE, J.

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