

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

+ **Date of Decision: 13.03.2012**

% **W.P.(C) 2503/2010**

MERCK KGAA

..... Petitioner

Through: Mr. Arvind Nayar, Mr. Sushant
Kumar, Mr. Abhinav Lohia &
Mr. Surjeet Singh, Advocates.

versus

GALAXY HOMPRO AND ANR

..... Respondents

Through: Mr. Rajesh Chadha, Advocate.

**CORAM:
HON'BLE MR. JUSTICE VIPIN SANGHI**

VIPIN SANGHI, J. (Oral)

C.M. No. 4285/2011

By this application, the petitioner seeks correction of the word 'RECEBION', typed in this petition, instead of the word 'RECIBION'. Learned counsel for the respondents does not oppose the application. Accordingly, the same is allowed. The expression 'RECEBION' used in this writ petition shall be read as 'RECIBION'.

The application stands disposed of.

W.P.(C) 2503/2010

1. In this writ petition under Article 226 of the Constitution of India, the petitioner assails the order dated 12.06.2009 passed by the Intellectual Property Appellate Board (IPAB) bearing order No. 94/2009 whereby the petitioner's appeal against the order dated 28.06.2001 passed by the Assistant Registrar of Trade Marks, disallowing the petitioner's opposition No. DEL-8313, and allowing the respondent's application No. 517814 for registration of Trademark in Class 5 under the provisions of the Trade and Merchandise Marks Act, 1958, has been dismissed.

2. The petitioner claims to be in the business of manufacture and sale of pharmaceutical drugs formulations. The case of the petitioner is that it is producing and marketing various drugs with the suffix 'BION'. The respondent is also in the same trade. The respondent advertised for registration of the mark 'RECIBION' on 03.10.1989. It claims user since 01.04.1987. When the petitioner noticed the said advertisement, the petitioner filed an application to raise objections. The petitioner claims that it had got registered various marks such as BETABION, POLYBION, CEBION etc. with the Registrar of Trade Marks which were pharmaceutical preparations. It is claimed by the petitioner that the trade mark sought to be registered by the respondent i.e., RECIBION in respect of a medicinal and

pharmaceutical preparation is deceptively similar to its mark 'CEBION' which also contains the suffix 'BION', with which the petitioner's products are identified.

3. The objection of the petitioner was rejected by the Assistant Registrar of Trade Marks vide order dated 28.06.2001. The Registrar held that the mark RECIBION cannot be said to be either visually or phonetically similar to the petitioner's marks 'CEBION'.

4. The petitioner's appeal has also been rejected by the IPAB by the impugned order.

5. The submission of learned counsel for the petitioner, firstly, is that the manner in which the IPAB proceeded to deal with the matter is fundamentally wrong. He submits that the IPAB has resorted to dissecting/breaking up of the marks in question. It has been held that the suffix 'BION' has been widely used not only by the petitioner but by various others in respect of the medicinal preparations and formulations and the prefix 'RECI' used by the respondent is different from the prefix 'CE' used by the petitioner. Learned counsel further submits that there is phonetic similarity between 'RECEBION' and 'CEBION' in as much, as, the letter 'R' is often slurred. Learned counsel further submits that in matters of deceptive similarity in relation to drugs, this Court has held that the test of confusion has to

be applied very strictly. Reliance is placed in this regard on the decision in ***Cadila Laboratories vs. Dabur India Limited***: 1997 (17) PTC 417. Learned counsel for the petitioner has also placed reliance on ***Corn Products Refining Co. vs. Shangrila Food Products Ltd.***: AIR 1960 SC 142; ***Wockhardt Towers vs. American Home Products Corporation***: 2009 (41) PTC 724; ***Torrent Pharmaceuticals Ltd. vs. The Wellcome Foundation Ltd.***: 2002 (24) PTC 580 (Guj.).

6. On the other hand, the submission of learned counsel for the respondent is that the petitioner is not the original user of the mark 'BION'. He submits that Cipla had advertised 'Calcibion' as early as in 1949, and claimed user since 25.08.1942. Reference in this regard has been made to the copy of the advertisement published in 1945. Learned counsel further submits that scores of other drugs are being sold in the market with the suffix 'BION' such as Mecobion, Rumbion, Embion, Pantabion, Lycobion etc. Learned counsel further submits that, in fact, the petitioner has not been using the mark 'CEBION', with which the petitioner claims phonetic similarity vis-à-vis the respondent's trade mark 'RECIBION', for a long period and the petitioner has not produced in the proceedings before the Registrar or even before the IPAB, even a single invoice to show the sale of

'CEBION' in the last 4-5 years. Learned counsel submits that the respondent has already moved an application for rectification of the petitioner's mark CEBION which is also pending. It is also submitted by learned counsel for the respondent that the respondent's drug 'RECIBION' is a schedule C-I drug under the Drugs and Cosmetics Act, 1940, which means that the said drug cannot be sold over the counter except on the prescription of a qualified medical doctor. He further submits that the said drug is a syrup of vitamin B-Complex and other vitamins. Reliance is placed on **Schering Corporation & Ors. vs. Getwell Life Sciences India Pvt. Ltd.**, 2008 (37) PTC 487 (Del), **Kalindi Medicure Pvt. Ltd. vs. Intas pharmaceuticals Ltd. and Anr.**, 2007 (34) PTC 18 (Del.) and **Panacea Biotec Ltd. vs. Recon Ltd.:** 1996 PTC (16) 561.

7. Having heard learned counsel for the parties and considered their respective submissions, in my view there is no error in the impugned order. I find no merit in the present writ petition.

8. The submission of the petitioner, as regards dissecting/breaking-up of the marks in question, seems to be paradoxical. On the one hand, the Petitioner questions the breaking-up of the marks into their respective prefix's and suffix's, as resorted to by the IPAB in the impugned order while deciding the question of

deceptive similarity, and on the other hand, the Petitioner raises the claim of deceptive similarity on account of the latter half (i.e. the suffix) of the marks being similar, i.e., 'BION'. The petitioner's entire case is based on its claim that it has various drugs with registered Trademarks which have 'BION' at the suffix, including 'CEBION'. In my considered opinion the Petitioner cannot be allowed to blow hot and cold at the same time.

9. The reasoning adopted and methodology resorted to by the IPAB, in deciding the question of deceptive similarity of the two marks, namely 'CEBION' (of the Petitioner) and 'RECIBION' (of the Respondent), is in line with the dictum laid down by various Courts.

10. The Supreme Court in **Corn Products** (Supra), while deciding the question of similarity between two marks, took note of a situation where a series of marks, which are in use in the market, contain common element or elements. It made reference to **In re: Harrods' application**, 52 R.P.C. 65, wherein it was observed:

"Now it is a well recognised principle, that has to be taken into account in considering the possibility of confusion arising between any two trademarks, that where those two marks contain a common element which is also contained in a number of other marks in use in the same market such a common occurrence in the market tends to cause

purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those features. This principle clearly requires that the marks comprising the common element shall be in fairly extensive use and, as I have mentioned, in use in the market in which the marks under consideration are being or will be used."

11. In the case before the Supreme Court, the respondent applied for registration of the mark 'Gluvita' used with reference to 'biscuits' manufactured by it. The appellant, who had been using the registered mark 'Glucovita' with reference to glucose with vitamins, opposed the application. In the absence of any evidence being led by the parties as to the use of marks in the market containing the common element, the Supreme Court after considering the structural and phonetic similarity of the two marks, which was likely to cause confusion, allowed the opposition of the Appellant.

12. In **Cadila Laboratories Ltd.** (Supra), this Court, while considering the case of infringement of the plaintiff's registered trademark 'MEXATE' by the defendant's trademark 'ZEXATE' in respect of the same type of cancer medicine, observed as under:

"According to the decisions laid down by the various Courts, the importance of the prefix of the word

should be taken due weightage and importance in case where the suffix is common. Where the suffix of the word is common, regard must be had to the earlier portion of the word which distinguishes the one from the other. Where the suffix is common, the earlier portion of the word is the natural, necessary and, in fact, the actual mark of distinction. It is also held in *Miss. Johan A. Wolfing v. Chemical Industrial & pharmaceutical Laboratories Ltd. & Anr.*, AIR 1984 Bom281 and *American Home Products Corporation v. Mac Laboratories Pvt. Ltd. & Anr.*, AIR 1986 SC 137, that the marks are different and not similar medicines considering the prefix. In the present case, competing trade marks 'Mexate' and 'zexate' have different and distinguished prefix, one having syllable 'M' and the other having 'Z'. There is no possibility of 'Mexate' being pronounced and/or read as 'Zexate' under any circumstances. **As has been settled, while ascertaining two rival marks, as to whether they are deceptively similar or not, it is not permissible to dissect the words of the two marks. It is also held that the meticulous comparison of words, letter by letter and syllable by syllable, is not necessary and phonetic or visual similarity of the marks must be considered. The two marks 'Fleboline' and 'Bionoboline' was held to be not similar by the Bombay High Court in *Johan A. Wolfing. v. Chemical Industrial & Pharmaceutical Laboratories Ltd. & Another (Supra)* as the terminology 'boline' cannot be an exclusive monopoly of the respondents and**

that the cumulative effect of the two words did not produce the same impression. Even phonetically the two marks were held to be not closely similar. In the present case, since the two marks are different as the opening syllables of both the rival marks are completely different and distinct and the two drugs are Schedule 'H' drugs of a specialised nature which could only be purchased on showing a prescription from a cancer specialist, the two competing trade marks appear to be prima facie entirely different and dissimilar.” (Emphasis supplied).

13. In ***Astrazeneca UK Limited and Anr. Vs. Orchid Chemicals and Pharmaceuticals Ltd.***, 2007 (34) PTC 469 (Del), this Court was considering the question of infringement of the registered trademark 'MEROMER' by the impugned trademark 'MERONEM'. Both the products referred to 'Meropenem', a molecule used in the treatment of bacterial infections. It was observed that the common feature in both the competing marks, i.e., 'MERO' was only descriptive and publici juris and, therefore, the customers would tend to ignore the common feature and would pay more attention to the uncommon features, namely, 'MER' and 'NEM', which were clearly dissimilar. The relevant observations made, are as under:

“Admittedly, 'Mero', which is common to both the competing marks, is taken by both the

appellants/plaintiffs and the respondent/ defendant from the drug 'Meropenem', taking the prefix 'Mero' which is used as a prefix in both the competing marks. Both the appellants/plaintiffs and the respondent/defendant are marketing the same molecule 'Meropenem'. Neither the appellants/plaintiffs nor the respondent/defendant can raise any claim for exclusive user of the aforesaid word 'Meropenem'. Along with the aforesaid generic/common prefix, 'Mero', the appellants/plaintiffs have used the syllables 'nem', whereas, the respondent/defendant has used the syllable 'mer'. It is true that the aforesaid words/trade names cannot be deciphered or considered separately, but must be taken as a whole. **But even if they are taken as a whole, the prefix 'Mero' used with suffix in the two competing names, distinguishes and differentiates the two products.** When they are taken as a whole, the aforesaid two trademarks cannot be said to be either phonetically or visually or in any manner deceptively similar to each other.” (Emphasis supplied).

14. This Court, again, in **Schering Corporation** (Supra), was posed with a question of infringement on account of deceptive similarity. The Plaintiff claimed infringement of its registered mark 'TEMODAL' and 'TEMODAR' by the Defendant's mark 'TEMOGET'. This Court placing reliance on its decision in **Astrazeneca** (Supra), amongst various others, held as under:

“Comparing the plaintiffs' trademark 'TEMODAL' and 'TEMODAR' with the defendant's trademark 'TEMOGET', it is apparent that the marks are not identical. There is also no phonetic or visual similarity between the marks. I have already noted above that the term 'TEMO' cannot be exclusively used by the plaintiffs in view of the fact that it is publici Jurisdiction being a clipped abbreviation of the generic word Temozolomide. There is no doubt in my mind, at this prima facie stage, that the suffix 'GET' is entirely different and distinct from the suffixes 'DAL' and 'DAR' of the plaintiffs' trademarks. There is also no doubt that there is no phonetic or visual similarity between the defendant's mark and the plaintiffs' marks taken as a whole as would be prone to deceive consumers. It is also relevant to point out that Temozolomide is a Schedule 'H' drug which can only be sold in retail on the prescription of a registered medical practitioner. While this condition is not by itself sufficient to establish a case of no deception, it is an important factor particularly when the pharmaceutical product is a highly specialized drug and is used for the specific treatment of a type of brain cancer.” (Emphasis supplied).

This decision has been upheld by the Division Bench of this Court in ***Schering Corporation & Ors vs. Getwell Life Sciences India Private Limited*** in FAO (OS) 314/2008.

15. In ***Wockhardt Towers*** (Supra), registration of the mark 'AZICIN'

was opposed on account of infringement of the registered trademark 'ANACIN' on the ground of deceptive similarity. The Registrar of Trade Marks while dealing with the said opposition, referred to the decision of the Supreme Court in ***Corn Products*** (Supra), and held as under:

“As the applicants have not filed any evidence so as to prove that the so-called marks in the series, alleged to have common suffix ‘CIN’ have been used in the market, they are not allowed to seek any relief from the presence of such marks in the series, if on record and/or to challenge the existence of the opponents’ registration and as such, the arguments addressed by the applicants to this have no bearing. Thus, considering the question of deceptive similarity having in view the settled principles that the two marks are to be compared as a whole and bearing in the mind, the structure of the marks visually and phonetically and the idea conveyed as well as an average intelligence and imperfect recollection of an unwary customer, the trademark ‘AZICIN’ is considered deceptively similar to the opponents trademark ‘ANACIN’. However, it is needless to state that the opponents mark consisted of an invented word and it would not be open to the applicants to break the marks in parts and compare a part of one mark with other of another trade mark against the settled principles of law and thus, the objection raised on under Section 11 (1) of the Act is

sustained.” (Emphasis supplied).

16. In the present case, the suffix ‘BION’ is common to both the marks in question. It is in use in various other marks of not only the Petitioner, but also other traders in the market. In view of such common occurrence of the suffix ‘BION’ in the market, the IPAB proceeded to hold that the purchasers would pay more attention to the other features of the respective marks, namely, the Prefix’s ‘CE’ and ‘RECI’.

17. The petitioner cannot claim to enjoy protection of a part (namely ‘BION’) of his registered mark. Merely because a part of the mark, the prefix or suffix, may be common, because it is common to the trade or it is public juris, is no ground to claim that the two marks are deceptively similar. In that situation, the other parts of the marks have to be compared so as to see whether the marks in question as a whole can be held to be deceptively similar. The law confers on the proprietor the exclusive right to the use of the trademark as a whole, and not a part of it. The whole marks have to be compared to decide whether there is deceptive similarity between them.

18. Considering the marks as a whole, there is no phonetic or visual similarity between them, so as to cause confusion. In **Corn products** (Supra), the Supreme Court while considering the aspect of visual and

phonetic similarity observed as under:

“We think that the view taken by Desai, J., is right. It is well known that the question whether the two marks are likely to give rise to confusion or not is a question of first impression. It is for the court to decide that question. English cases proceeding on the English way of pronouncing an English word by Englishmen, which it may be stated is not always the same, may not be of much assistance in our country in deciding questions of phonetic similarity. It cannot be overlooked that the word is an English word which to the mass of the Indian people is a foreign word. It is well recognised that in deciding a question of similarity between two marks, the marks have to be considered as a whole... Again, in deciding the question of similarity between the two marks we have to approach it from the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonable likely to cause a confusion between them.”

19. In **Wyeth Holdings Corporation vs. Burnet Pharmaceuticals P. Ltd**, 2008 (36) PTC 478 (Bom), while considering whether the mark ‘FOLV’ of the defendant was deceptively similar to the mark ‘FOLVITE’ of the plaintiff, the Registrar of Trade Marks held that the two competing marks have to be considered as a whole. The structure of the mark visually and phonetically must be borne in mind.

The image that the court must have is that of the quintessential common man. It was held:

“When the Judge looks at phonetics, the sound which accompanies the pronunciation of the mark is the sound of the mark to an ordinary purchaser bereft of the niceties of language.”

20. Approaching the problem at hand from the point of view of a man of average intelligence and imperfect recollection and keeping in view the pronunciation of an ordinary purchaser bereft of the niceties of the English language, it cannot by any means whatsoever be held that the marks in question are structurally and phonetically similar and would, thereby, cause confusion. There is a marked difference in the prefix of both the marks in question, not only in terms of their appearance but also in terms of their pronunciation, which would differentiate the respective words when taken and spoken as a whole, i.e., one word.

21. It is also relevant to point out that the medicinal product, to which the respondent's mark pertains, is a Schedule C-1 drug which can only be sold on the prescription of a registered medical practitioner. Although this condition by itself is not sufficient to establish a case of no deceptive similarity, but this condition coupled with the aforementioned reasons leads to the conclusion that there is no

deceptive similarity between the two marks, namely, 'CEBION' and 'RECIBION'.

22. It is also pertinent to note that to the respondent's submission, that the petitioner has not shown actual use of its mark CEBION in the past few years by producing even a single invoice, the petitioner has no answer. This is also an important and germane consideration. Therefore, even if the mark of the respondent had been somewhat deceptively similar to that used by the petitioner at some earlier point of time, that would not have sufficed as the petitioner does not appear to be using the mark CEBION for a number of years.

23. The judgment of the Gujarat High Court in ***Torrent Pharmaceuticals Ltd.*** (Supra), relied upon by the petitioner would not render much assistance to its submissions. The said case did not involve the question of use of marks in the market containing the common element of the marks in question. The Court, while dealing with the question of deceptive similarity between two marks 'TROVIREX' and 'ZOVIREX', concurred with the finding of the Registrar of trade marks that there existed the highest degree of resemblance, visually and phonetically, between the two marks. The Court further observed that the probability of confusion and deception was more since the trade marks were used in relation to the pharmaceutical

products i.e. similar goods.

24. Because the competing marks pertain to medicinal products would not, by itself, be sufficient to establish deceptive similarity. There are several factors that have to be kept in mind while deciding deceptive similarity. These factors were laid down by the Supreme Court in ***Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd.***, (2001) 5 SCC 73, as under:

- “a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.
- b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.
- c) The nature of the goods in respect of which they are used as trade marks.
- d) The similarity in the nature, character and performance of the goods of the rival traders.
- e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.
- f) The mode of purchasing the goods or placing orders for

the goods, and

g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.”

25. On consideration of the various factors set out by the Supreme Court, as aforesaid, it is clear that there is no deceptive similarity between the marks in question. For all the above stated reasons, namely, the use of various marks in the market containing the term ‘BION’ common to both the marks in question, the absence of visual and phonetic similarity between the marks, the fact of the respondent’s product with mark in question being a prescribed drug and the undisputed non-use of the mark ‘CEBION’ by the petitioner over the years, I find no infirmity in the impugned order.

26. Accordingly, the present petition is dismissed, and the parties are left to bear their respective costs.

MARCH 13, 2012
mb

VIPIN SANGHI, J