

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

% *Judgment Reserved on: October 11, 2012*
Judgment Pronounced on: November 9, 2012

+ **RFA (OS) No.90/2010**

THE HIMALAYA DRUG COMPANY Appellant
Represented by: Mr.Hemant Singh, Advocate with
Ms.Mamta Jha, Mr.Sachin Gupta and
Ms.Shashi P.Ojha and Mr.Siddhant
Asthana, Advocates

versus

M/S. S.B.L. LIMITED Respondent
Represented by: Mr.V.P.Singh, Sr.Advocate instructed
by Mr.Atish Dipankar, Advocate

CORAM:
HON'BLE MR. JUSTICE PRADEEP NANDRAJOG
HON'BLE MR. JUSTICE MANMOHAN SINGH

MANMOHAN SINGH, J.

1. The above mentioned appeal has been filed by the appellant (hereinafter referred to as plaintiff) against the judgment and decree dated 3rd June, 2010 passed by the learned Single Judge in CS(OS) No. 111/2006 (old Suit No.1305/1996) whereby the suit against the respondent (hereinafter referred to as defendant) for infringement of trade mark Liv.52 by use of trade mark LIV-T by the defendant was dismissed and it was held that there is no case made out of infringement of registered trade mark.

2. The facts leading to filing of abovementioned appeal are that the

plaintiff is the owner of the trademark 'Liv.52' registered under registration No.180564 in class 5 as of 10th July, 1957 in respect of medicinal preparation for treatment of disorder of liver. The said trade mark has been used since the year 1955. The case of the plaintiff is that the use of the trade mark LIV-T by the defendant in relation to medicinal preparation for curing liver disorder amounting to infringement of plaintiff's trade mark Liv.52 as the essential and distinguishable feature LIV which is distinctive and is used by the defendant. The trade mark LIV-T used by the defendant is phonetically and structurally identical with or deceptively similar to Liv.52 thus the same is in violation of statutory and exclusive rights granted in favour of the appellant under Section 29(1) of the Trade and Merchandise Marks Act, 1958.

3. The case set up by the defendant is that the word 'LIV' is generic and common to the trade as the medicines in question manufactured and marketed by both the parties are meant for treatment of liver. Two products of parties are different products; one is an ayurvedic medicine and the other homeopathic preparation. The ayurvedic proprietary medicine is not sold through homeopathic outlets. Packaging and colour combination of two labels are different so as all other features. The composition of two products is also different. It is submitted that the organ liver in the pharmaceutical trade is often abbreviated as LIV and is used as a first syllable of over 50 pharmaceutical companies, include trademarks such as LIV CARD, LIV-UP, LIV-RIL-z, LIVO, LIVO-10, al, LIVAPLEX, LIVOFIT, LIVA, LIVOL, LIVDRO, LIVAZOL, LIVERITE, LIVERJET, LIVERNUT, LIVERPOL, LIVUP, LIVEX, LIVIVRON, LIVIBEE, LIVINA, LIVINOL, LIVINOL, LIVIPREP, LIVIRILE, LIVIRONVITA, LIVIRUBRA and LIVITA. Furthermore, LIV has been adopted as a first syllabus by various

companies from a period prior to the claimed adoption of Liv.52 by the plaintiff itself which they claim since 1955. There are over 100 registrations in the record of the trademark registry as per the search reports obtained which show that many traders have applied for registration or obtained the registration containing the word LIV. Therefore, there can be no monopoly of the word LIV.

4. From the pleadings of the parties, the following issues were framed by way order dated 30th November, 1998:

“1. Whether the plaint is signed, verified and the suit is instituted by a duly competent and authorized person?

2. Whether this Court has no territorial jurisdiction to entertain the present suit? OPD

3. Whether the suit is maintainable in its present form?

4. Whether there is no cause of action for institution of the present suit? OPD

5. Whether the suit is barred by limitation? OPD

6. Whether the suit is bad for non-joinder of necessary

parties? OPD

7. Whether the suit is barred by principles of estoppel and waiver? OPD

8. Whether the products of the defendant company can be sold only through homeopathic outlets? OPD

9. Whether the Plaintiff is the proprietor of the trade mark “Liv.52” in respect of drugs and Pharmaceuticals? OPP

10. Whether the use of trade mark “LIV-T” by the defendant amounts to infringement of trade mark registration numbers 180564, 290061 and 401959 in class 5? OPP

11. Whether the use of trade mark “LIV-T” by the defendant amounts to passing off the goods of the defendant as that of the plaintiff? OPP

12. Whether the word mark “LIV” is *Publici juris* and if so, to what effect? OPD

13. Whether the suit suffers from delay, laches and acquiescence and if so, to what effect? OPD

14. Whether the plaintiff is entitled to relief for rendition of accounts and if so, its nature of relief? OPP

15. Relief.”

5. The plaintiff examined six witnesses namely PW-1 Mr.K.N. Jairaman, PW-2 Mr.Satish Doval, PW-3 Mr.V.Vashisht, PW-4 Mr.Deepak Ohri, PW-5 Mr.Atul Sarin and PW-6 Mr.Navin Dutt. The defendant produced three witnesses, namely, DW-1 Mr.Sangeet Aggarwal, Manager-Finance & Accounts, DW-2 Mr.Rakesh Saxena, Search Assistant of Indmark, and DW-3 Mr.Amarnath Saini, an employee of the defendant.

6. After recording the evidence of the parties, the learned Single Judge dismissed the suit of the plaintiff by the impugned judgment. The issue-wise findings are given by the learned Single Judge. There was no contest on issues No.1 to 7 and 13. Therefore, the said issues are decided in favour of the plaintiff. Issue No.11 claiming relief of passing off was not pressed by the plaintiff. Since the suit was dismissed, issue No.14 relating to relief of rendition of accounts and issue No.15 with regard to cost were also not pressed by the plaintiff as recorded in para 2 of the judgment. With regard

to issue No.9, the plaintiff proved the registration certificate of trade mark 180564 dated 10 of July, 1957 for the trade mark Liv.52 as Ex.PW-1/B. The said issue was decided in favour of the plaintiff. Issue No.8 was answered by the learned Single Judge holding that the defendant's drugs need not be sold only through homeopathic outlets but also through chemist shops which sell all forms of medicines as long as they conform to the requirements of the DCA and are duly licenced for that purpose.

Remaining two issues i.e. issue No.10 of infringement of trade mark and issue No.12 whether the word mark 'LIV' is *publici juris* were decided against the plaintiff and on the basis of findings arrived in these issues, the suit of the plaintiff was dismissed. It was held by the learned Single Judge in his judgment that there is no visual, phonetic or structural similarity in the two trademarks which is likely to cause confusion and deception and use of the trade mark LIV-T by the defendant does not amount to infringement of registered trade mark of the plaintiff bearing Nos.180564, 290061 and 401959 in class 5. On issue No.12, the finding of the learned Single Judge was that the defendant has been able to show that the mark 'LIV' is *publici juris* and therefore, when two trademarks Liv.52 and LIV-T are compared, 'LIV' will be considered as the generic and non-distinctive part of the mark and it is to be ignored even if the two rival marks as a whole.

7. Aggrieved by the impugned judgment, the plaintiff filed an appeal under Section 96 of the Code of Civil Procedure, 1908. The findings arrived at by the learned Single Judge on issue Nos.10 and 12 have been challenged in the appeal by the plaintiff. Both parties have made their respective submissions.

8. Mr.Hemant Singh, learned counsel appearing on behalf of the

appellant admits that in case after considering the evidence produced by the plaintiff, if this Court finds that there is no visual, phonetic and structural similarity of two rival marks Liv.52 and LIV-T and at the strength of the evidence produced by the defendant, the mark 'LIV' is a generic word and it has become *publici juris*, then the appeal must fail.

According to him, mark LIV was taken from the name of human organ LIVER but the same was coined by the plaintiff in the year 1955. It was registered in the year 1957. It is the essential feature of the registered trademark 'Liv.52'. Its validity has not been challenged by the defendant, rather it was protected by the Courts and from time to time by the Tribunals. The LIV is not a medically used term and the products of the parties are available in the chemist shops without any doctor's prescription. None of the document has been proved by the defendant.

Mr.Hemant Singh, learned counsel assailed the findings arrived by the learned Single Judge by stating that they are not correct as the plaintiff pressed its relief only for infringement of trade mark but the test of passing off was applied while deciding the case as if in the case of infringement even, the court can easily assume that there exists a non distinctive portion in the mark. He submits that trade mark Liv.52 is exclusively associated with the goods of the plaintiff for the last 57 years, the word LIV is not a generic word or becomes common to the trade. He states that plaintiff is still stand by the statement made by PW-1, Sh.K.N.Jairaman. There are marks containing the lengthy suffixes after the word LIV which has been used by many traders for which the plaintiff also seriously does not stress upon, however in those cases, the existence of three to four letter suffixes or words by themselves would make the mark sufficiently distinguishable from that of

the plaintiff mark. Therefore, in those cases, if the test of comparing the residual portion of the mark may be applied, there is no difficulty to arrive at the finding that the marks are sufficiently distinguishable from each other or different from each other. But it would be futile to apply the same test of the seeing the residual portion between the mark Liv.52 and LIV T in the instant case so as to say as if the plaintiff's mark is identified by the numeral 52 and the defendant's mark would be identified by the alphabet T. It is inconceivable that such is the case as neither the plaintiff nor defendant has said so or shown on evidence like the same nor the same is the case of the parties. Therefore, the said test which may hold good in some cases containing the residual non distinctive portion may not be applicable in the peculiar case like this.

In view of his submission, Mr.Hemant Singh reiterated his submission canvassed before the learned single judge that the plaintiff has no objection if the defendant may change the mark by adding any vowel in between 'LIV' and 'T' within reasonable time in order to resolve the dispute. As per him, the defendant should follow the practice of the trade as per the details provided by the defendant itself. He submits that the mark 'LIV' as a standalone mark coupled with alphabet or numeral is similar to the plaintiff's mark thus cannot be allowed to continue to remain in the market. For example, the defendant is free to use the mark LIVT (together), Livet, LIVISE, LIVO-T, LIVA-T, LIVUP-T LIVORINA, LIVAT, LIVOT, LIVER-T, LIVUT or any other combination as per trade trend to the trade marks who are using the mark LIV as prefix component by adding the suffix in such a manner which is not visually and phonetically similar.

9. Let us now consider the rival contentions of the parties in the light of

facts and evidence adduced by the parties before the learned trial court and see as to whether the findings arrived by the trial court in the issue no. 10 and issue no 12 are correct.

10. As suit was filed in the year 1996, being Suit No.1305/1996; it was valued for the purposes of court fee and jurisdiction at ₹5,05,000/-. With the increase of pecuniary jurisdiction of the District Court, the matter was transferred to the District Court. Thereafter, the plaintiff moved an application under Order VI, Rule 17 CPC for amendment of plaint on the ground that the plaintiff believed that the profits made by the defendant must be in excess of Rs.20 lacs and accordingly the plaintiff sought to amend the plaint by incorporating para 16(d) of the plaint and the application was duly allowed by the order dated 29th March, 2005 passed by the Additional District Judge, Delhi. The matter was re-transferred to this Court and the suit was re-numbered as CS(OS) No. 111/2006. In between, Trade and Merchandise Marks Act, 1958 was amended to new legislation Trade Marks Act, 1999 applicable with effect from 15th September, 2003. Under the saving clause of Section 159(4) of the new Act, the suit proceeding which was initiated prior to amendment is to continue under the old Act i.e. the Trade and Merchandise Marks Act, 1958.

11. We are proposing to answer the issue no. 10 and issue 12 together as the one issue relates to infringement of the trade mark and another issue is based on the defence set up by the defendant which is that the word LIV is *publici juris* and both are inter linked to each other.

12. Before any proceeding further in the matter, it is noteworthy to mention that the present proceedings are governed by the provisions of the Trade and Merchandise Marks Act 1958, therefore it is necessary to refer to

few provisions of the Trade and Merchandise Marks Act, 1958 which are unlike Trade Marks Act 1999. The same are:-

“2. Definitions and interpretation:

(d) “deceptively similar”: A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion;

(j) “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof;

(v) “trade mark” means –

(i) In relation to Chapter X (other than section 81), a registered trade mark or a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark; and

(ii) In relation to the other provisions of this Act, a mark used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right, either as proprietor or as registered user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark registered as such under the provisions of Chapter VIII;.....

28. Rights conferred by registration.—(1) Subject to the other provisions of this Act, the registration of a trade mark in Part A or Part B of the register shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods in respect of which

the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.....

29. **Infringement of trademarks.**—(1) A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or a registered user thereof using by way of permitted use, uses in the course of a trade mark which is identical with, or deceptively similar to, the trade mark, in relation to any goods in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.....

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31. **Registration to be prima facie evidence of validity.**

1. In all legal proceedings relating to a trade mark registered under this Act (including applications under section 56), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the validity thereof.
2. In all legal proceedings as aforesaid a trade mark registered in Part A of the register shall not be held to be invalid on the ground that it was not registrable trade mark under section 9 except upon evidence of distinctiveness and that such evidence was not submitted to the Registrar before registration, if it is proved that the trade mark had been so used by the registered proprietor or his predecessor-in-title as to have become distinctive at the date of registration.

32. **Registration to be conclusive as to validity after seven years** - Subject to the provisions of

section 35 and section 46, in all legal proceedings relating to a trade mark registered in Part A of the register including applications under section (56), the original registration of the trade mark shall, after the expiration of seven years from the date of such registration, be taken to be valid in all respects unless it is proved-

(a) that the original registration was obtained by fraud; or

(b) that the trade mark was registered in contravention of the provisions of section 11 or offends against the provisions of that section on the date of commencement of the proceedings; or

(c) that the trade mark was not, at the commencement of the proceedings, distinctive of the goods of registered proprietor.

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56. Power to cancel or vary registration and to rectify the register. (1) On application made in the prescribed manner to a High Court or to the Registrar by any person aggrieved, the tribunal may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register may apply in the prescribed manner to a High Court or to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as it may think fit.

(3) The tribunal may in any proceeding under

this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(4) The tribunal, of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2).

(5) Any order of the High Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

(6) The power to rectify the register conferred by this section shall include the power to remove a trade mark registered in Part A of the register to Part B of the register.

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111. Stay of proceedings where the validity of registration of the trade mark is questioned etc.

(1) Where in any suit for the infringement of a trade mark-

(a) the defendant pleads that the registration of the plaintiff's trade mark is invalid; or

(b) the defendant raises a defence under clause (d) of sub- section (1) of section 30 and the plaintiff pleads the invalidity of the registration of the defendant's trade mark;

the court trying the suit (hereinafter referred to as the court), shall,-

(i) if any proceedings for rectification of the register in relation to the plaintiff's or defendant's trade mark are pending before the Registrar or the High Court,

stay the suit pending the final disposal of such proceedings;

- (ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is prima facie tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the High Court for rectification of the register.

(2) If the party concerned proves to the court that he has made any such application as is referred to in clause (b)(ii) of sub-section (1) Within the time specified therein or within such extended time as the court may for sufficient cause allow, the trial of the suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court making any interlocutory order (including any order granting an injunction, directing, accounts to be kept,

appointing a receiver or attaching any property), during the period of the stay of the suit.”

13. Upon collective reading of the aforementioned provisions, it can be deduced that the entire scheme of the Act is that a mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion. By virtue of registration under Section 28 of the Trade and Merchandise Marks Act, 1958, if valid, the registered proprietor of the trade mark gets the exclusive right to use the trade mark in relation to the goods in which the said trade mark is registered and to obtain relief in respect of infringements of the trade mark in the manner provided.

Section 29 i.e. infringement of trademarks, mandates that a registered trade mark is infringed by a person who not being the registered proprietor uses in the course of a trade mark which is identical with, or deceptively similar to, the trade mark, in relation to any goods in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark. Under section 31 the registration is prima facie evidence and in all legal proceedings, a registered trade mark in Part A of the register shall not be held to be invalid on the ground that it was not a registerable trade mark under section 9.

Section 32 provides that subject to the provisions of section 35 and 46, in all legal proceedings relating to a trade mark registered in Part A of the register the original registration of the trade mark shall, after the expiry of seven years from the date of such registration, be taken as valid in all respects unless it is proved that the original registration was obtained by fraud and it was contrary to Section 11 and on the date of commencement of the proceedings, the mark was not distinctive of the goods.

The said provisions of the registration of the trade mark and conclusiveness of the registration unless based on some specific grounds is mandate of the statute and ought to be respected. The said provision of conclusiveness of the registration of the trade mark after seven years under section 32 of the Act was present under the old Act and the same very provision is not couched in same form under the New Trade Marks Act 1999. The resultant effect of the same would be that the registrations done under the old Act are conclusive in all legal proceedings after seven years and the same cannot be lightly questioned on the basis of the ground of lack of distinctive character.

Given the aforesaid backdrop of the conclusiveness of the registration envisaged under the Old Act of 1958, let us analyze on facts whether the said provisions of the Act gets attracted or not and the resultant effect of the same on the present proceedings.

14. From the records, it is clear that the application for registration of Liv.52 was filed on July 10, 1957 and is a presumption of examining the application at that stage. The registration of the Liv.52 was granted in Part-A. All this would mean that the registrar ought to have been satisfied while according the registration of the mark Liv.52 as to the factum of the distinctiveness. Naturally, the said trade mark is seven years old, the registration under the provision of Section 32 of the Act to be conclusive as to validity. Section 2(j) read with Section 2(v) provides inter alia that any word or name, letter or numeral or any combination thereof can become a trade mark if a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark. No

challenge to the registration was made by filing of rectification proceedings by the defendant. No grounds of the challenge as per section 32 of the Act have been raised by the defendants to counter the validity of the registration. Consequently, the registrations of mark Liv.52 granted under the Part A of the Old Act shall be conclusive as to validity.

15. The said discussion relating to conclusiveness of the registration under the old Act is missing in the impugned judgment, though the learned single judge arrived at the finding in answer to issue no. 9 that the plaintiff is the proprietor of the mark Liv.52 and decided the issue in favour of the plaintiff. We think that the said finding as to conclusiveness of the validity of the registration is essential to be decided in the instant case which is to be decided under the Old Act. The said finding as to the validity of the registration has a direct bearing in answering issue no. 10 relating to the word LIV being *publici juris* and consequently warrants discussion vis-a-vis the arguments of the defendant. We believe that if the learned single judge while deciding the question of the LIV being *publici juris* or generic component should have taken into account the conclusiveness of the registration in instant case, it would not have persuaded learned single judge to proceed on a priori basis that the LIV is a generic component and thus ought to be excluded for the purposes of measuring deceptive resemblance.

16. The rival marks and packaging on the date of filing of the suit are scanned as under:



Test of Infringement

17. In order to establish infringement, the main ingredients of Section 29 are that the plaintiff's mark must be registered under the Trade and Merchandise Marks Act, 1958, the defendant's mark is identical with or deceptively similar to the registered trade, the defendant's use of the mark is in the course of trade in respect of the goods covered by the registered trade mark. The rival marks are to be compared as a whole. Where two rival marks are identical, it is not necessary for the plaintiff to prove further that the use of defendant's trade mark is likely to deceive and cause confusion as the registration shows the title of the registered proprietor and the things speak for themselves. In an infringement action, once a mark is used as indicating commercial origin by the defendant, no amount of added matter intended to show the true origin of the goods can effect the question. If court finds that the defendant's mark is closely, visually and phonetically

similar, even then no further proof is necessary. It is not necessary for the plaintiff to adduce evidence of actual deception in order to prove the case of infringement. If packing of two products is different in an action of infringement, the same is immaterial. Its validity cannot be challenged in the infringement proceedings under the Trade and Merchandise Marks Act, 1958. (See Corn Products Refining Co. v. Shangrila Food Products Ltd. (supra), AIR 1963 SC 449 (V 50 C 63), Amritdhara Pharmacy Vs. Satya Deo Gupta and AIR 1965 SC 980, Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, 1999 PTC (19) 81 (Del) (para 15), Automatic Electric Limited v. R.K. Dhawan and Anr. and 1963 Madras page 12 S.A.P. Balraj and Ors. Vs. S.P.V. Nadar and Sons and Another)

Legal Effect of Registration

18. On registration of a trade mark the registered proprietor gets under Section 28 the exclusive right to the use of such trade marks in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of any infringement of such trade mark. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods. (See Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories (supra) and AIR 1971 SC 898, National Bell Co. v. Metal Goods Mfg. Co.)

Essential Features

19. The courts have propounded the doctrine of prominent and essential feature of the trade mark for the purposes of adjudication of the disputes relating to infringement of trade mark. While deciding the question of

infringement, the court has to see the prominent or the dominant feature of the trade mark. Even the learned single judge agrees to this proposition when the learned judge quotes McCarthy on Trade Marks that all composite marks are to be compared as whole. However, it is dependent on case to case to basis as a matter of jury question as to what can be the possible broad and essential feature of the trade mark in question.

20. It is settled law that where the defendant's mark contains the essential feature of the plaintiff's mark combined with other matter, the correct approach for the court is to identify an essential feature depending particularly "on the court's own judgment and burden of the evidence that is placed before the Court". In order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are differences, rather overall similarity has to be judged. While judging the question as to whether the defendant has infringed the trade mark or not, the court has to consider the overall impression of the mark in the minds of general public and not by merely comparing the dissimilarities in the two marks.

21. The ascertainment of an essential feature is not to be by ocular test alone but if a word forming part of the mark has come in trade to be used to identify the goods of the owner of the trade mark, it is an infringement of the mark itself to use that word as the mark or part of the mark of another trader for which confusion is likely to result. The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for

orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole”. In the decision reported as (1951) 68 RPC 103 at page 105, De Cordova v. Vick Chemical Co., the plaintiffs were the proprietors of a label containing the words “Vick’s VapoRub” as the essential feature, registered in Jamaica, and the defendants used a similar label with the words “Karsote Vapour Rub” as the essential feature, and it was shown that the expression “VapoRub” had become distinctive of the plaintiff’s goods in Jamaica, an action for infringement was successful. (See De Cordova v. Vick Chemical Co. (supra), (1941) 58 RPC 147, Saville Perfumery Ltd. v. June Perfect Ltd., AIR 1972 SC 1359 at 1362, M/s. National Chemicals and Colour Co. and Others v. Reckitt and Colman of India Limited and AIR 1991 Bombay 76, M/s National Chemicals and Colour Co. and others vs. Reckitt and Colman of India Limited and another)

22. Identification of essential features of the trade marks has been discussed in details in the case of Kaviraj Pandit Durga Dutt Sharma vs. Navaratna Pharmaceutical Laboratories (supra):-

“In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant’s mark is likely to deceive, but where the similarity between the plaintiff’s and the defendant’s mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff’s rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on

the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial;.....

“When once the use by the defendant of the mark which is claimed to infringe the plaintiff’s mark is shown to be “in the course of trade”, the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out....”

23. The Court in determining whether the Defendant's mark is deceptively similar to the mark of the Plaintiffs were enunciated in the judgment of Mr.Justice Parker in the decision reported as 1906(23) RPC 774, Pionotist Case:

“You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion – that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.

Likelihood of Confusion and Deception

24. In the decision reported as AIR 1951 Bombay 147, James Chadwick & Bros. Ltd. v. The National Sewing Thread Co. Ltd, Chagla C.J. and Bhagwati, J.; referring to the words “likely to deceive or cause confusion” in

section 10 of the Trade Marks Act, 1940, observed at page 152 as follows:-

“Now in deciding whether a particular trade mark is likely to deceive or cause confusion, it is not sufficient merely to compare it with the trade mark which is already registered and whose proprietor is offering opposition to the registration of the former trade mark. What is important is to find out what is the distinguishing or essential feature of the trade mark already registered and what is the main feature or the main idea underlying that trade mark, and if it is found that the trade mark whose registration is sought contains the same distinguishing or essential feature or conveys the same idea, then ordinarily the Registrar would be right if he came to the conclusion that the trade mark should not be registered. The real question is as to how a purchaser, who must be looked upon as an average man of ordinary intelligence, would react to a particular trade mark, what association he would form by looking at the trade mark, and in what respect he would connect the trade mark with the goods which he would be purchasing. It is impossible to accept that a man looking at a trade mark would take in every single feature of the trade mark. The question would be, what would he normally retain in his mind after looking at the trade mark? What would be the salient feature of the trade mark which in future would lead him to associate the particular goods with that trade mark?”

The decisions referred with regard to essential features were followed by the Division Bench in the decision reported as ILR 1973 Delhi 393, M/s. Atlas Cycle Industries Ltd. Vs. Hind Cycles Limited. The Division Bench has examined the similar question very thoroughly while dealing with the two rival trademarks *Royal Star* and *Eastern Star* of the parties and has come to the conclusion that the trade mark adopted and used by the defendant Royal Star is similar to plaintiff's trade mark Eastern Star.

In the decision reported as (1945) 65 RPC 62, Aristoc v. Rysta decided

by the House of Lords, it was held that the comparison of trademarks was a matter of first impression, but the mark “Rysta” too closely resembled mark “Aristoc” phonetically and it would be liable to lead to deception and confusion.

25. After having considered the above mentioned decisions, it is clear to us that it is not the right test of a meticulous comparison of two marks, letter by letter and syllable by syllable. It is the person who only knows the one mark and has perhaps an impression, or imperfect recollection of it, who is likely to be deceived or confused. In fact it depends on first impression of a person. In case he is aware or familiar with both rival marks of the parties he will neither be deceived or confused. The degree of similarity between the two rival marks and which depends upon the first impression whether visual or phonetic and in case court finds that there is a risk of confusion which is the public interest should not be authorised. The question is merely the dispute of inter se between the parties but it is matter of right by the registered proprietor who got the exclusive rights to protect the same, otherwise, many competing marks would be available in the market in due course and uncertainty might happen in case the infringer is allowed to use similar mark.

26. In the present case, it was not disputed by the defendant that the plaintiff is registered proprietor of the trade mark Liv.52 which is registered as of 10th July, 1957 and the same is being used since 1955. There was no disclaimer or any condition put by the Registrar of Trade Marks to the mark LIV at the time of granting registration. Validity of the registration was not challenged by filing of rectification proceedings. It is recorded by the learned Single Judge in his impugned judgment that the defendant had

proceeded his case on the footing that the plaintiff has a valid registration for Liv.52 and while deciding issue No.8, it has been held that the defendant's drugs need not be sold only through homeopathic outlets but also through chemist shops which sell all forms of medicines.

27. The learned Single Judge by referring passages from Mc-Carthy on Trade Marks and Unfair Competition and Gilson on Trade Mark (2008 Edn, Lexis Nexis) has come to the conclusion that the evidence produced by the plaintiff does not satisfy the requirement of showing either likelihood of confusion or the actual deception. The reasons given in the judgment are that during the long pendency of the case if there were any likelihood of confusion, it should have been reflected in a drop of sales of the plaintiff's drugs. As the sales turnover in Liv.52 has been progressing from year to year, it does not appear that LIV-T has made any dent whatsoever in the market for Liv.52.

The learned Single Judge after applying the anti-dissection rule, came to the conclusion that where the trademark includes a generic component, the manufacturers are not precluded from using as part of their marks the said generic component as the same are not the distinctive portion and the dominant portion would be dissimilar or non generic portion and when the comparison of the marks are taken up as a whole, the distinctive portion of the trademark i.e. non-generic component would have to be compared and not the generic component which is considered to be non-distinctive and weak component cannot form the basis for comparison.

The visual impact of the two marks Liv.52 and LIV-T are different as there is essentially no difference between an alphabet and a numeral. They also do not sound phonetically similar. Nature of the products which are

being sold are not similar. There is unlikely to be any mistake in administering LIV-T instead of Liv.52. It is unlikely then unwary customer entering into a chemist shop asking for Liv.52 and he would get LIV-T. An user of Ayurvedic medicine or of homeopathic medicine understands the distinction between the two. Even if the registration is validly granted and not challenged by the defendant by filing of cancellation proceedings, the question that still remains is whether the use of LIV-T amounts to infringement of plaintiff's trade mark Liv.52.

28. We find that the finding of the learned single judge laying down rules of comparison on the basis of the applicability of anti dissection rule quoted from McCarthy on Trade Marks is not the correct approach to be applied in the instant case. We agree with the said proposition that there may arises cases where the trade marks comprises of the portions which have some nexus with the name of the ailment or organ or salt and the same portion may be termed as generic component. Actually, whether a particular mark is a generic mark or portion of the mark is generic component is essentially a question of fact. Further, what level of distinctiveness, it has attained in market by its long standing user in the market, whether the said descriptiveness is withered away by way of acquired distinctiveness is another question to be answered by way of seeing the facts and circumstances of the case and the evidence of the parties. Let us see whether on facts and evidence, such burden of the defendant to show the generic nature of the word "LIV" is discharged.

Evidence of Plaintiff

29. PW-1 Mr.K.N.Jairaman, the Commercial Manager of the plaintiff stated that Liv.52 is a coined trade mark of the plaintiff and the word 'LIV'

is not a medically used term and it is sold without medical prescription. The product is sold through the plaintiff's 500 stockists throughout the country. The plaintiff has also produced the sales figures and promotional expenses figures of Liv.52 as Ex.PW-1/A. The registration is proved as Ex.PW-1/B. Invoices of sales have been exhibited as Ex.PW-1/1 to PW-1/38. Ex.PW-1 to PW-1/14 are the literature materials pertaining to the trade mark 'Liv.52'. In 1987, the sale of Liv.52 was Rs.9.36 crores. In 1987-88, the promotional expenses were Rs.93 lacs for the product. In the year 1996-97, the turnover for Liv.52 was over Rs.35 crores and promotional expenses Rs.3.5 crores, and in the year 2008-09 the annual sale was over 91 crores and annual promotional expenses Rs.9 crores. PW-4, 5 & 6, the Medical Representatives of the plaintiff, conducted survey on the significance of the distinctiveness of 'LIV'. They have produced several reports, some of which were exhibited as Ex.PW-4/1 to PW-4/4, PW-5/1 to PW-5/4, PW-6/1 and PW-6/2.

PW-1 in his statement has also stated that in the past also the plaintiff has taken action against other persons using word 'LIV'. He has provided the instances where the plaintiff has opposed against the use of the marks 'Liv.up', 'Liv-Ril' and 'Liv-Card'. PW-2 in his statement has clearly stated that if he comes across any promotion or literature of 'LIV-T', he will assume that it is another product from the manufacturer of Liv.52. The plaintiff has exhibited the copies of the orders, undertaking given by the parties who tried to copy the mark LIV who were using the deceptively similar trade mark, in order to prove that the mark LIV was protected from time to time, details of the same are given as under:-

Sr.No.	Impugned Trade Mark	Order/Undertaking	Exhibit No./Mark
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i)	LIVOLIV	Certified copy of decree of District Court of Saharanpur in OS No.5/1974 dated 22.5.1974	Ex.PW1/C1
ii)	LIVOLIV	Certified copy of judgment of OS No.5/1974	Ex.PW1/C3
iii)	LIV ER 80	Certified copy of the order dated 20.07.1985, Case No.220/S/1982, Bombay	Ex.PW1/C6
iv)	LIV A	Original order of Joint Registrar of Trade Mark, Calcutta dated 17.01.1978	Ex.PW1/C4
v)	LIV-O	Order of Dy. Registrar of Trade Mark, Delhi dated 05.08.1992	Ex.PW1/C5
vi)	LIV ER-82	Certified copy of order dated 20.07.1985, Case No.220/S/1982, Bombay	Ex.PW1/C6
vii)	LIVSEV	Copy of order dated 10.07.1989 of Trade Mark Registry, Bombay of M/s Dupor Industries Limited	Ex.PW1/C7
viii)	LIVSEV	Copy of order dated 10.07.1989 of Trade Mark Registry, Bombay of M/s Dupor Industries Limited	Ex.PW1/C8
ix)	HAMOLIV	Order of Asstt. Registrar of Trade Mark, Bombay dated 18.01.1991	Ex.PW1/C9
x)	LIV-100	Certified copy of the order of Addl. Chief Metropolitan Magistrate dated 08.12.1982	Ex.PW1/C10 & C11
xi)	Liv 62	Letter of Undertaking	Mark-A
xii)	Liv 60	Letter of Undertaking	Mark-B
xiii)	LIV 60	Letter of Undertaking	Mark-C
xiv)	LIV 100	Letter of Undertaking	Mark-D
xv)	EMELIV	Letter of Undertaking	Mark-E
xvi)	LIVOREX	Letter of Undertaking	Mark-F
xvii)	LIV 80	Letter of Undertaking	Mark-G
xviii)	LIV 80	Letter of Undertaking	Mark-H

xix)	LIV ER-52	Letter of Undertaking	Mark-I
xx)	LIV ER-82	Letter of Undertaking	Mark-J
xxi)	LIV-H	Letter of Undertaking	Mark-K
xxii)	LIV 100	Letter of Undertaking	Mark-M
xxiii)	LIV-100	Letter of Undertaking	Mark-N
xxiv)	Liveron	Letter of Undertaking	Mark-O
xxv)	LIV 62	Letter of Undertaking	Mark-P
xxvi)	LIV.50	Letter of Undertaking	Mark-Q
xxvii)	LIVER.82	Letter of Undertaking	Mark-Q

PW 4, PW 5 and PW6 medical representatives who conducted survey on significance of distinctiveness of 'LIV' and they have produced several reports some of which were marked as Ex.PW4/1 to PW4/4, PW5/1 to PW5/4 and PW6/1 to PW6/2 which clearly indicates the distinctiveness of the mark LIV. The defendant in the cross examination of these witnesses was not able to demolish these testimonies not produced any witness or report contrary to the statement made by them.

30. In the decision reported as (2001) 5 SCC 73, Cadila Healthcare ltd. v. Cadila pharmaceuticals Ltd., the Apex Court after considering a large number of judgments of foreign courts as also the Indian courts laid down the following principles:

- (a) Though drugs are sold under prescription, the actual conditions of the society have to be kept in mind.
- (b) Dispensing of drugs by chemists in urban and rural areas as also the linguistic difference, lead to higher level of confusion.
- (c) Strict measures to prevent confusion especially in medicinal cases should be taken.
- (d) Public interest supports that a lesser degree of proof is required for a plaintiff to prove infringement in a pharmaceutical case if

the marks are similar especially in medicinal cases.

- (e) Since confusion in drugs and medicines could be life threatening, drugs should be treated as poisons and not sweets.
- (f) In a society like India, doctors are under tremendous pressure and therefore, any confusion at their level should also be avoided.
- (g) Drugs are available on verbal requests even on telephone and therefore, there are higher chances of confusion.

31. Both parties have given the list of the cases which are decided by various High Courts including this High Court. The details of few relevant cases are given as under:-

Sr. No.	Case Name	Citation	Name of Drug by the parties	Compound of Origin	Allowed/ Restrained
i)	Anglo-French Drug Co. (Eastern) Ltd. Vs. Belco Pharma	AIR 1984 P&H 430 (DB)	Beplex(P) Belplex(D)	Vitamin-B Complex	Injunction granted
ii)	Allegran Inc., Vs. Milment Oftho Inds.	1999(19) PTC 160 (Cal) (DB)	Ocuflox Ocuflox	Ocu-ocular Flox- Ciprofloxacin	Injunction granted
iii)	Astra-Idl Limited Vs. Ttk Pharma Limited	AIR 1992 Bom 35	Betaloc(P) Betalong(D)	Beta receptors – arteries – drug was to work on this part of body	Injunction granted
iv)	Medley Laboratories (P) Ltd. & Anr. Vs. Alkem Laboratories Limited	2002(25) PTC 593 (Bom.) (DB)	Spoxin(P) Supaxin(D)	Sparfloxacin	Injunction granted
v)	Sun Pharmaceutical Industries Vs. Cadila Healthcare Ltd.	2010 (43) PTC 483 (Mad) DB	VENIZ (P) VENZ (D)	Venlajaxine	Injunction granted
vi)	Apex Laboratories Ltd. Vs. Zuventus Health Care Ltd.	2006 (33) PTC 492 (Mad)	ZINCOVIT (P)	Zinc	Injunction granted

		DB	ZINCONIA (D)		
vii)	Torrent Laboratories Ltd. Vs. Ciba-Geigy Ltd.	MANU /GJ/ 0344/ 1998 (DB)	CIBA (P) ULCIBAN (D)	CLIMETIDINE	Appeal allowed Trademark granted
viii)	United Biotech Vs. Orchid Chemicals & Pharmaceuticals Ltd.	2012 (5) PTC 433 (Del.) (DB)	ORZID (P) FORZID (D)	CEFTAZIDINE used to treat many kinds of bacterial infections	Division Bench held marks are similar
ix)	Pankaj Goel Vs. Dabur India Ltd.	2008 (38) PTC 49 (Del.) (DB)	RASMOLA (A) HAJMOLA (R)	Digestive tables	Appeal dismissed Injunction granted
x)	Arvind Laboratories vs. Hahnemann Laboratory Pvt. Ltd.	2007(35) PTC 244 (SJ)	EYETEX (P) EYELEX (D)	Eye Lotion	Injunction granted
xi)	USV Limited vs. IPCA Laboratories Limited	2003(26) PTC 21 (SJ)	PIOZ (P) PIOZED (D)	Pioglitazone Hydrochloride	Injunction granted
xii)	Aravind Laboratories vs. V.Annamalai Chettiar	1981(1) MLJ 75 (SJ)	EYETEX (P) EYESOL (D)	Eye Tonic	Injunction granted
xiii)	Schering Corporation vs. Alkem Laboratories Ltd.	2010(42) PTC 772 (Del) DB	TEMOKEM (P) TEMOGET (D)	Temozolomide	Injunction refused
xiv)	Astrazeneca UK Ltd. vs. Orchid Chemicals	2007(34) PTC 469 (DB) (Del.)	MERONEM (P) MEROMER (D)	Meropenem	-do-
xv)	Novartis vs. Wanbury Ltd.	2005 (31) PTC 75 (Del.)	TRIAMINIC (P) CORIMINIC (D)	SYMPATHO-MIMETIC DRUGS	Injunction refused
xvi)	Aviat Chemicals Pvt. Ltd. vs. Intas	2001 PTC 601 (Del.)	LIPICARD (P)	Lipid Corrective Medicines	Injunction refused

	Pharmaceuticals		LIPICOR (D)		
xvii	Serum Institute of India Limited vs. Green Signal Bio Pharma Pvt. Ltd. and Anr.	2011(47) PTC 452 (Bom) (SJ)	ONCO BCG(P) BCG ONCO BP (D)	Bacillus Calmette Guenn	Injunction granted
xviii	Wyeth Holdings Corporation and Anr. vs. Burnet Pharmaceuticals (Pvt.) Ltd.	2008(36) PTC 478 (Bom) (SJ)	FOLVITE (P) FOLV (D)	Folic Acid Vitamin	Injunction granted
xix	Wyeth Holdings Corp. and Anr. vs. Sun Pharmaceuticals Industries Ltd.	2004(28) PTC 423 (Bom) (SJ)	PACITANE(P) PARIKTANE (D)	Trihexylphenidyl, Anti Spasmodic Preparations	Injunction granted
xx	Boots Company Plc vs. Registrar of Trade Marks	2002(4) BomCR 36 (SJ)	BRUFEN (P) CROFEN (D)	Ibuprofen	Registration rejected
xxi	Medley Laboratories (P) Ltd., Mumbai and Anr. vs. Alkem Laboratories Limited	2002(4) BomCR 70 (DB)	SPOXIN (P) SUPAXIN (D)	Sparfloxacin Ofloxacin	Injunction granted
xxii	Glaxo Group Limited vs. Vipin Gupta	2006(33) PTC 145 Del (SJ)	BETNOVAT E (P) BETAVAT (D)	BETA from Betamethasone and VAT from Valerate IP	Injunction granted
xxiii	Remidex Pharma Private Limited vs. Savita Pharmaceuticals	2006(33) PTC 157 (Del) (SJ)	ZEVIT (P) EVIT (D)	Vitamins	Injunction granted
xxiv	Cadila Laboratories Ltd. vs. Dabur India Limited	66(1997) DLT 741 (SJ)	MEXATE (P) ZEXATE (D)	Methotrexate Sodium	Injunction not granted
xxv	Win-medicare Limited vs. Somacare Laboratories	65(1997) DLT 369 (SJ)	DICLOMOL(P) DICMOL (D)	Diclofenac Sodium	Injunction granted

32. The suit was filed in May 1996 and it was listed first time before court

on 23rd May, 1996 when the summons were issued and interim order was passed restraining the defendant from using the mark 'LIV' or any other deceptively similar mark. The said order was confirmed after hearing on 12th July, 1996. An appeal was preferred by the defendant before the Division Bench who allowed the same and interim order was vacated, inter-alia, on many grounds included of non-compliance of the provisions of Order XXXIX, Rule 3 of the Code of Civil Procedure, 1908.

In the decision reported as 2008 (37) PTC 487 (Delhi), Schering Corporation v. Getwell Life Sciences Pvt. Ltd. which was affirmed by the Division Bench of this Court in Schering Corporation v. Alkem Laboratories Ltd., *FAO (OS) 313 of 2008*, it was held that there was no similarity between 'Temodal' and 'Temodar' since the prefix derived from the name of the chemical compound Temozolomide to arrive 'Temodal' and 'Temodar' on the one hand and 'Temoget' and 'Temokem' on the other. Injunction applications in both the matters were dismissed.

All the cases, laws which are cited are interim order wherein after considering the prima facie strength of the case of the either sides, prima facie views are formed. What follows from the same is that, once the court while deciding the interim applications excludes the generic components for the purposes of comparison, then the court prima facie believes that there exists a triable case. However, the party who had taken the plea had to prove strictly by producing cogent and clear evidence in law.

33. Let us now discuss the evidence produced by the defendant. The burden to prove issue No.12 was upon the defendant. The pleadings of the defendant on this issue were that word 'LIV' is generic and common to the trade as describing the medicines associated with the treatment of liver. It

has become *publici juris* in the field of medicine and it ceases to be subject matter of proprietorship. Once the issues are settled on the basis of pleading and onus is cast, the burden is upon to lead evidence and the matter is to be decided on the basis of evidence led. In case, there is no evidence led by a party on the plea raised by it and not proved by it, the said plea by itself means nothing.

34. In examination-in-chief DW1 Mr.Sangeet Aggarwal deposed that the few cartons filed by the defendant are available in the market. In cross-examination he did not produce the invoices in respect of Mark B to Mark F as well as did not remember the other medicines. The defendant did not produce any witness from traders who could depose before Court that he or any third party is using the mark LIV as prefix portion of the entire mark and the actual product of carton marked as Mark A to Mark H is available in the market. The defendant has also not produced any witness in order to prove that the word 'LIV' is generic word and common to the trade and here is the cogent of a party who got registration and used the 'LIV' prior to the plaintiff, even certified copies of pending applications and registrations were not filed and proved under the law as only certified copies are admissible in evidence in legal proceedings under Section 115 of the Trade and Merchandise Marks Act, 1958.

35. Only the search reports of 'LIV' issued by the private party i.e. M/s Indmark were exhibited as Ex.DW2/1, Ex.DW2/2 and Ex.DW2/4 and photocopies of relevant page of Trade Marks Journal were exhibited as DW2/5 in the testimony of DW-2 Mr.Rakesh Saxena who is the Search Assistant of M/s. Indmark Company at Green Park Extension, New Delhi. Packaging/cartons were of third party which have not been provide in

evidence by producing witnesses of the respective traders of mark using said cartons filed by the defendant. The similar is the position of photographs filed. Ex.DW2/1 to Ex.DW2/5 and Mark B to F do not prove that the trade mark mentioned in the search reports and cartons are used in the mark LIV alone as used by the plaintiff. In totality, we can easily mention here that not a single witness was produced by the defendant who had made the statement that mark LIV was used as alone by any trader in India.

36. As indicated above, the onus to show that the “LIV” is a generic component of the mark was essentially on the defendant. The said onus was heavy and independent in view of the conclusiveness of the registration of the mark Liv.52 where the word LIV is written in isolation, is represented in a particular manner and is an essential feature of the mark. From the evidence, we find that the defendant was not able to prove by producing even single witness that any trader as per the details mentioned in Ex.DW2/1 to DW2/5 and labels Mark B to Mark F who could make the testimony in Court that he is using the mark LIV in isolation or even otherwise. It is not proved from the documents file that the said word “LIV” is a generic word. There are some products and labels available on record like the mark LIVOGEN and some other products wherein there is a use of the word LIV is coupled by the lengthy suffixes, however the same by itself are few users of the marks which as per the plaintiff are not objectionable as the depiction of the word LIV is not in the same manner as that with the defendant. There are no labels or products on record wherein the word “LIV” is written in the capital words in isolation or coupled by alphabets or numerals.

37. There is no finding of court shown besides the orders passed in the instant case that the LIV is a generic component of the mark. On the other

hand, there are orders passed by the tribunals and lower courts wherein the Liv.52 mark has been protected against the manner of the representation of LIV along side numerals and alphabets. Consequently, from the evidence of DW1, it is not emanating that under no circumstances, the manner of use of the expression LIV is not objectionable or it has become so public in trade that the plaintiff is estopped from objecting the same. Even for the pending application and details of registered trade marks mentioned in the search reports and photocopies of the relevant pages of Trade Marks Journal, no certified copies, which are admissible in evidence under Section 115 of the Trade and Merchandise Act, 1958 for use in legal proceedings, are produced and proved in order to establish that the mark LIV is common to the trade.

38. Likewise, DW2 has shown the search report which is quite extensive showing entries on the register wherein LIV prefixed trade marks are cited. The said witness again does not depose that LIV is generic under all circumstances and also does support the case with the actual furnishing of the products. The evidence of DW2 states he did not know how those datas are collected and datas which were in Ex.DW2/1 to DW2/4 but which were not in Ex.2/5 were not collected by him. He did not if the trade mark LIV-RIL-Z has been withdrawn in opposition proceedings BOM-8771. He had no information that which of the application had been withdrawn, dismissed or rejected from the one shown in Ex.DW2/1 to DW2/4. He did not know which of the trade marks were in operation/use from the one which were shown in Ex.DW2/1 to Ex.DW2/4. Therefore, the defendant was not able to discharge the onus in support of issue No.12.

39. It is well settled law that the mere entries on the register of the mark do not testify the user of the mark. (Corn Products (Supra)). Therefore, even

if the defendant's case is to be believed, mere showing of the search reports do not persuade this court to believe that the word "LIV" is a generic component in the mark "Liv.52", this is due to the reason that the plaintiff's bone of contention is that the similarity has to be seen in the context of the instant case and the manner of the usage of the mark rather than comparing the same with the other marks where the word LIV is used along with other words or suffixes.

40. After considering the evidence led by the defendant to support the case that the LIV is generic component in the Liv.52 trade mark, we do not find that on facts and evidence, such weighty evidence exists on record to show that under no circumstances the manner of the use of the mark "LIV" can be objected to. Rather, there is a positive evidence on record of Doctors and others in the form of survey reports which state that the mark Liv.52 is identified by the customer with the prominent features which is LIV.

41. The learned Single Judge in the impugned judgment held that the generic component to be considered as non-distinctive and being a weak component and cannot form the basis of comparison. The Supreme Court in this context in the case reported as 2004 (28) PTC 585 (SC), Milment Oftho Vs. Allergan Inc., has taken the opposite view. The facts of the said case are that the plaintiff filed the suit for infringement on the basis of the trade mark Ocuflux. The word Ocu was derived from Ocular and Flux from Ciprofloxacin. The Calcutta High Court Division Bench (comprising Justice Ruma Pal and Justice Devinder Kumar Jain) passed the interim orders restraining the defendant from using the trade mark Ocuflux and also came to the conclusion that there cannot be two medicinal preparations bearing the same name from different sources. One must go. The judgment of the

Division Bench was challenged by the defendant in the Supreme Court, who after hearing both the parties dismissed the appeal by following the principles of Cadila's case. It was observed that Cadila case holds that exacting judicial scrutiny is required when a court is dealing with medicinal products.

Subsequently, to Milment Oftho (supra) case, the Supreme Court in the decision reported as 2007 (35) PTC 1 (SC), Dabur Vs. Heinz Italia, held that two trademarks Glucose-D and Glucon-D containing Glucose power are phonetically similar. The learned Single Judge of the Punjab and Haryana High Court had held that word Glucose being generic of the contents, no monopoly can be granted. The learned Single Judge of the High Court had refused to grant the injunction in this case. When this case came to the Supreme Court, the Court in fact reversed it and granted the injunction. The ratio of the Supreme Court contained in para 11 reiterates Cadila Healthcare while granting the injunction and it was held that both Glucon D and Glucose D are items containing glucose which are phonetically so similar that it can easily confuse a purchaser and small changes in the packaging is merely an attempt to continue to mislead the purchasers and to make it more difficult for the owner to protect their mark.

In the decision reported as 1960 SC 142, Corn Products Refining Co. v. Shangrila Food Products Ltd., where two rival marks were Gluvita and Glucovita, the Supreme Court discussed the issue of likelihood of confusion and deception as well as similarity of the marks and trade connection between the two different goods. The trade mark Glucovita was with reference to Glucose was registered in favour of the owner of the trade mark. The other side applied for registration of the trade mark Gluvita in respect of

the biscuits manufactured by them. The argument of the other side was that the mark was coined as biscuit contains glucose mixed with vitamins. In para 17, the Apex Court held as under:

“17. 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 recognized that in deciding a question of similarity between two marks, the marks have to be considered as a whole. So considered, we are inclined to agree with Desai J. that the marks with which this case is concerned are similar. Apart from the syllable ‘co’ in the appellant’s mark, the two marks are identical. That syllable is not in our opinion such as would enable the buyers in our country to distinguish the one mark from the other.”

In the recent decision of United Biotech (P) Ltd. vs. Orchid Chemical and Pharmaceuticals Ltd. (supra), decided by the Division Bench of this Court, who noticed various earlier cases including SBL, Astrozenca and Schering Corporation (Supra), where two rival trade marks were ORZID and FORZID and in both the marks part of the active ingredient CEFTAZIDINE was taken by both the parties, still the Division has held that two marks are deceptively similar.

42. In the abovementioned cases, the Courts have not ignored the word which was part of active ingredient. But in his judgment, learned Single Judge made side by side comparison, i.e., letters for letters and numbers for

numbers, the test of deceptive similarity laid down by the Supreme Court was not correctly followed by not considering the essential feature of the mark LIV part of registered trade mark Liv.52. In the decision reported as AIR 1963 SC 449, Amritdhara Pharmacy vs. Satyadeo Gupta, has laid down principles of comparison of marks. The relevant paras are as under:

“7. As we said in *Corn Products Refining v. Shangrila Food Products Ltd.*, (1960) 1 SCR 968: (AIR 1960) SC 142) the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man the overall structural and phonetic similarity of the two names ‘Amritdhara’ and ‘Lakshmandhara’ is, in our opinion, likely to deceive or cause confusion. We must consider the overall similarity of the two composite words ‘Amritdhara’ and ‘Lakshmandhara’. We do not think that the learned Judges of the High Court were right in saying that no Indian would mistake one for the other. An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider meanings of the composite words as ‘current of nectar’ or ‘current of Lakshman’. He would go more by the overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which has otherwise learnt and which he wants to purchase.

8. What we have to consider here is the overall similarity of the composite words, having regard to the circumstance that the goods bearing the two names are medicinal preparations of the same description. We are aware that the admission of a mark is not to be refused, because unusually stupid people, “fools or idiots”, may be deceived. A critical comparison of the two names may disclose some points of difference, but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of

the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name. The trade mark is the whole thing - the whole word has to be considered. In the case of the application to register 'Erectiks' (opposed by the proprietors of the trade mark 'Erector') Farwell, J. said in *William Bailey (Birmingham) Ltd.'s Application* (1935) 52 R.P.C. 137 :

"I do not think it is right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole. I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other work".

43. It is also fortified by the view taken by several courts in India including Division Bench of Madras High Court and learned single judge Bombay High Court in the decision reported as 2006 (33) PTC 492 (DB) (Mad), *Apex Laboratories Ltd. Vs. Zuventus Health Care Ltd.*, and 2008 (36) 478 (BOM), *Wyeth Holdings Corp. and Anr. vs. Burnet Pharmaceuticals Pvt Ltd.*, wherein the courts have protected the mark ZINCOVIT against the mark ZINCONIA wherein the word ZINCO is derived from the common denominator ZINC. Likewise, Bombay High Court in the case of *Wyeth* (supra) proceeded to protect FOLVITE P against the FOLV D wherein the word FOL is derived from folic acid. Even we apply the said rule of splitting the mark by excluding ZINCO, then conclusion to be arrived would be the same as arrived at by the Learned Single Judge which is difference between "NIC" and "VIT" but actually that is not the approach for comparison and no a priori assumption can be drawn about the generic component unless material placed on record speaks in the same voice. Both, Bombay High Court and Madras High Courts strictly followed the Supreme Court in the

case of Cadila Healthcare Ltd. v. Cadila pharmaceuticals Ltd. (supra). There exist many other examples of the same which are evocative of the same proposition which is that the mere fact that the word is derived from the name of the salt does not mean that it loose protection for all times to come. This is more so especially in the light of observation of the Supreme Court in Cadila(Supra) that the stringent measures are required to be taken to avoid any likelihood of confusion and deceptive especially in the case of medicines.

44. The findings of the learned Single Judge on this aspect are not correct and those are contrary to the judgments referred to above. As per settled law, it is established principle that both marks are to be compared as a whole. Let us examine the two cases decided by the Division Benches of this Court. In the decision reported 2008 (38) PTC 49 (Del.) (DB), Pankaj Goel v. Dabur India Ltd., two rival marks were HAJMOLA and SATMOLA. The appellant produced clear evidence before Court that MOLA was being used by many manufacturers of digestive product. Prefix portions of two marks were HAJ and SAT which are apparently different. The Division Bench of this Court after following various judgments of Supreme Court, which are referred by us, came to the conclusion that two marks are deceptively similar as the rival marks are to be compared as a whole and an injunction was issued. In case portion MOLA, which was common to the trade, as per the case of the appellant was to be ignored, then the question of similarity of two marks would not have arisen. Special Leave Petition was filed in Supreme Court, the same was also dismissed.

In the decision reported as 2010 (44) PTC 293 (Del.) (DB), Kirorimal Kashram Mktg. & Agencies Pvt. Ltd. vs. Shree Sita Chawal Udyog Mill

Tolly Vill., where two rival trade marks of the parties were “Double Deer” and “Golden Deer”, the Division Bench of this Court (Comprising Sanjay Kishan Kaul, J. and Valkmiki J. Mehta, J.) has passed the interim order holding that copying of a prominent part of a trade mark of a person is prohibited, more so, when the same is a registered trade mark. Various judgments have been referred including 2009 (40) PTC 417 (Del.) (DB), Amar Singh Chawal Wala vs. Shree Vardhan Rice and Genl. Mills, where two rival trade marks were “Lal Qilla” and “Hara Qilla”.

45. The learned Single Judge has not considered the voluminous evidence produced by the plaintiff, several orders obtained, notice issued and undertaking obtained from the various parties using the LIV as prefix to their respective trade marks. The evidence of PW-3 to PW-6 was completely ignored by the learned Single Judge who had approved survey report of the mark LIV. The plaintiff was able to adduce the evidence that it was a fit case of likelihood of confusion and deception and the two marks are deceptively similar.

46. It is well settled law that whether a mark is generic word or is a *publici-juris*, it is a question of fact. If the word has attained distinctiveness as mark of a particular party, the distinctiveness is entitled to recognition unless distinctiveness is lost, it was entitled to recognition. The loss of distinctiveness might also be due to a volume of common user, which destroyed distinctiveness.

47. In the decision reported as 41 L.J. (1872) Ch. 682, Ford vs. Foster, Lord Justice Nullish held that:-

“There is no doubt, I think, that a word which was originally a trade mark to the exclusive use of which a

particular trader of his successors in trade, may have been entitled, may subsequently become *publici juris* I think that the test must be whether the use of it by other persons is still calculated to deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however, hard to some extent it may appear on the trader, yet practically, as the right to the trade mark is simply a right to prevent the trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of his trade mark, the right to the trade mark must be gone.”

48. The plaintiff in the present case was able to prove that the Liv.52 is still distinctive. The customers purchase the product of the plaintiff by asking Liv.52 which is being used for the last more than 57 years. It has also come in evidence that the mark LIV is the essential feature of the registered trade mark Liv.52. On the other hand, the defendant was unable to prove that it is a generic word and becomes common to the trade. It is also pertinent to mention here that on one hand, the defendant's entire case is that mark 'LIV' is a generic word and is unprotectable in law, but on the other hand, the defendant itself applied for registration of 'LIV-T' in the Trademarks Registry for getting the exclusive right before filing of the written statement, however in written statement word LIV is a generic mark and has become *publici juris*.

49. Law of *publici juris* has been discussed in various cases and the Courts have given their respective findings to the effect that a party who has taken the defence of *publici juris* has to prove his case. The same has been dealt with by the Supreme Court and various High Courts in the following

cases:

- a) In *Corn Products Refining Co. v. Shangrila Food Products Ltd.*, **1960 SC 142** it has been held as under:

“15. The series of marks containing the common element or elements therefore only assist the applicant when those marks are in extensive use in the market. The onus of proving such user is of course on the applicant, who wants to rely on those marks. Now in the present case the applicant, the respondent before us, led no evidence as to the user of marks with the common element. What had happened was that Deputy Registrar looked into his register and found there a large number of marks which had either 'Gluko' or 'Vita' as prefix or suffix in it. Now of course the presence of a mark in the register does not prove its user all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register. If any authority on this question is considered necessary, reference may be made of Kerly p. 507 & Willesden Varnish Co. Ltd. v. Young & Marten Ltd., (1922) 39 RPC 285 at p. 389. It also appears that the appellant itself stated in one of the affidavits used on its behalf that there were biscuits in the market bearing the marks 'Glucose Biscuits', 'Gluko biscuits' and 'Glucoa Lactine biscuits'. But these marks do not help the respondent in the present case. They are ordinary dictionary words in which no one has any right. They are really not marks with a common element or elements. We, therefore, think that the learned appellate Judges were in error in deciding in favour of the respondent basing themselves on the series marks, having 'Gluko' or 'Vita' as a prefix or a suffix.

- b) The Supreme Court set aside the judgment of the Division Bench of this Court and restored the order of the Learned Single Judge. The Supreme Court dealt with the finding of the Division Bench that trademarks with the prefix or suffix 'Gluko' and 'Vita' were common features of the trade and could not be associated only with the appellant's product, and observed thus:

“The second point on which the learned appellate Judges based themselves in arriving at the conclusion that there was no reasonable apprehension of confusion or deception was, as we have earlier stated, that there were various trademarks with a prefix or suffix 'Gluco' or 'Vita' and that made it impossible to say that the common features 'Glu' and 'Vita' were only associated with the appellant's products. This view was founded on a passage which the learned appellate Judges quoted from Kerly on Trade Marks, 7th Edn., p.624. That passage may be summarized thus: Where there are a "series of marks, registered or unregistered, having a common feature or a common syllable, if the marks in the series are owned by different persons, this tends to assist the applicant for a mark containing the common feature. This statement of the law in Kerly's book is based on *In re: an Application by Beck, Koller and Co. (England) Ltd. (1947)* 64 R.P. C. 76. It is clear however, from that case, as we shall presently show, that before the applicant can seek to derive assistance for the success of his application from the presence of a number of marks having one or more common features which occur in his mark also, he has to prove that these marks had acquired a reputation by user in the market.” (emphasis supplied)

- c) In *Express Bottlers Services Pvt. Ltd. v. Pepsi Inc. and Ors., 1989 (9) PTC 14* it has been held as under.

“50. To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the malicious persons, just to harass the proprietor may use his mark by way of pinpricks.... The mere use of the name is irrelevant because a registered proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence... Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the

mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark. This court is inclined to accept the submissions of the respondent No.1 on this point...The respondent No.1 did not lose its mark by not proceeding against insignificant infringers...”

d) ***Rolex Sa v. Alex Jewellery Pvt. Ltd. and Ors., 2009 (41) PTC 284 (Del).***

“22. The next aspect to be considered is the effect/impact, if any, of a large number of other persons using the word ROLEX as claimed by the defendant. At this stage, this plea will be examined believing the same to be true. In my view, the same would be immaterial. Firstly, nothing has been shown that any of the said users has any significant presence. Secondly, it is now well settled in *Honda (supra)* in turn relying upon *Indian Shaving Products Ltd Vs Gift Pack* that merely because the plaintiff who is otherwise found entitled to the interim injunction is shown to have not taken any step against other infringers is no ground to deny relief to the plaintiff. It cannot also be said that the plaintiff's trademark has lost its distinctiveness for the said reason. The reply affidavit of the plaintiff lists the orders of the Trade Mark Registry from 1964 to 2000, where plaintiff's mark has been protected inter alia for reason of having great reputation. It also shows that the plaintiff has been enforcing its rights. Though the list filed by defendant No.1 in this regard is long but a perusal thereof shows a number of applicants to have abandoned or withdrawn their applications. This is a vast country. Mere long list of applicants/registrants of mark, without any extensive use of the mark, cannot dent the distinctive character or repute of the mark.”

Similar view was taken by this court in various cases reported in 2009 (41) PTC 57, *Novartis AG v. Crest Pharma Pvt. Ltd. and Anr.*, 93 (2001) DLT 406, *Bhagwan Dass Gupta v. Shri Shiv Shankar Tirath Yatra Company Pvt. Ltd.*, 1998 PTC 18, *Indian Shaving Products Ltd. & Anr. v. Gift Pack & Anr.*, and 2008 (38) PTC 49 (Del.) (DB) *Pankaj Goel v. Dabur India Ltd.*

50. It was held by the learned Single Judge while deciding issue No.12 in his judgment that the mark LIV is non-generic component which is to be considered as non-distinctive and weak component and it has to be ignored when the comparison of the marks is to be taken as a whole and the defendant was able to show the mark LIV is *publici juris* in view of many cartons, marks including the photographs placed on record. The learned Single Judge has not considered the fact that in the absence of any cancellation petition filed by the defendant, the plea of generic word or *publici juris* was not available to the defendant as the same was contrary to the statutory provision of exclusive use conferred under Section 28 and right to relief arising for infringement thereof conferred under Section 29 of the Trade and Merchandise Act, 1958.

51. Learned Single Judge did not consider his finding arrived on issue No.8 where it was held that defendant's product Ayurvedic need not be sold only through homeopathic outlets but also through chemist shop. It is a matter of fact that the plaintiff's registration was granted in respect of medicinal preparation which covers the products manufactured and sold by the defendant. So, it is not right test that in case one product is Ayurvedic and another Homeopathic if both are available in the chemist shop, there cannot be any confusion and deception. Each is likely to be considered as variants of other originating from the common source. The Delhi High Court in the decision reported as AIR 1999 DEL 15, Charak Pharmaceuticals vs. Deep Pharma Ltd, held as under :

“9. Submission advanced by Sh. S.K.Bansal appearing for the defendant was mainly two-fold. First, that the medicine manufactured by the defendant under the trade mark ULCEREX is allopathic while the plaintiff's preparation under the trade mark ALSAREX is

ayurvedic. Medicine of the defendant is schedule 'H' drug which can only be sold on Doctor's prescription by chemist(s) which is not the case in respect of the medicine of plaintiff. It is not in dispute that both the said medicines are meant for treatment of ulcer. Further, that the trade marks ALSAREX and ULCEREX are phonetically similar. It is not uncommon that both allopathic and ayurvedic medicines are available across the same counter in various shops of the chemists and even schedule drugs are sold by some chemists without prescription slips of the Physicians. Thus, an unwary customer who goes to purchase medicine can make mistake in purchasing the medicine of the defendant under the aforesaid trade mark as that of the plaintiff because of phonetical similarity between the said two trade marks. Therefore, the distinction pointed out by Sh. Bansal is of little help to the defendant.

10. All medicines whether they may be allopathic, ayurvedic or homeopathic are goods of the same description under the Act.”

52. Though in the judgment a reference was made that no rectification proceedings were initiated by the defendant, but still the validity of the trade mark was considered by the learned Single Judge by following the principles of the American jurisprudence based on Section 37 of The Lanham (Trade Mark) Act of United States, which permits an infringement Court to go into the entire issue of validity or invalidity thereof and even cancel an invalid registration. A US Court, therefore, is entitled to limit the nature, extent and scope of right of exclusive use that registration should confer upon a registered proprietor whereas no such jurisdiction is conferred on Civil Courts in India under the Indian Trade Marks law. On the contrary, according to Section 32 of the Trade Marks Act permits very limited ground of scrutiny of the validity of the trade marks which are beyond seven years old. The said ground clearly limits the testing of validity on the ground of

lack of distinctive character except by showing that on the date of commencement of proceedings, the said mark lacked the distinctive character. It is being used for the last 57 years. In the present case, nothing has been shown on evidence by proving its plea has been raised by the defendant while attempting to show genericness or the word LIV lacked distinctive character. No challenge of such nature has either been made by the defendant by filing of rectification proceedings in the prescribed manner though undisputed fact is that Liver is the generic term and not LIV. We are therefore unsure as to how within the bounds of Trade and Merchandise Marks Act 1958, it is permissible to import the provisions of Lanham Act to test the validity of the registration in generality when Indian Trade Marks Act is a self-contained code and provides for the limited level of scrutiny of validity under section 32. Therefore, the same principles are not applicable to the facts of this case.

53. We also do not agree with the learned Single Judge that the submission of the counsel that the LIV may be allowed to use as a standalone mark would militate against the submission that the mark has to be compared as whole. We think that rather it supports the said submission. This is due to the reason that if the presence of the LIV is considered for the purposes of deceptive resemblance, the mere existence of 52 or T is held to be inconsequential for the purposes of arriving at the finding as to infringement, the marks are compared as whole for the purposes of infringement and the rule laid down by the Apex Court in Corn Products (Supra) is respected.

54. It is totally immaterial if the sales turn over of the plaintiff was progressing almost every year after introduction of the trademark LIV-T by

the defendant, therefore, the defendant has not made any dent whatsoever in the market for Liv.52. There is no prohibition in law if the product is introduced by the defendant in the market and the sale of the plaintiff is increased year by year, the Court should not pass the orders if the case of infringement of trade mark is made out. The statutory provisions cannot become nullity if such test is applied. One prudent person could also give the justification that in case the defendant's mark LIV-T was not available in the market, the sales turn over would have been much more. In commercial market due to increase of prices of the product and because of its promotion, sale has to be increased in every case.

55. The plaintiff in the present case was able to prove that the Liv.52 is still distinctive. The customers purchase the product of the plaintiff by asking Liv.52 which is being used for the last more than 57 years. It has also come in evidence that the mark LIV is the essential feature of the registered trade mark Liv.52. On the other hand, the defendant was unable to prove that it is a generic word and becomes common to the trade. It is also pertinent to mention here that on one hand, the defendant's entire case is that mark 'LIV' is a generic word and is unprotectable in law, but on the other hand, the defendant itself applied for registration of 'LIV-T' in the Trademarks Registry for getting the exclusive right before filing of the written statement, however in written statement word LIV is a generic mark and has become *publici juris*. Therefore, the findings arrived at by the learned single judge in relation to issue no. 12 are not correct and the same are set aside.

56. As we have arrived at the finding that the LIV written in isolation is an essential feature of the trade mark Liv.52 and also noticed the rules of

comparison which is that the marks are to be compared as whole. Therefore, the presence of the mark LIV which is an essential feature of the mark Liv.52 shall be considered for the purposes of comparison with that of LIV-T.

57. Following the dictum of Cadila (supra) and tests laid down by the Supreme Court from time to time and also the material available on record, it can be said that for the purposes of comparison of the mark Liv.52 and LIV-T, the word LIV represented in a particular form cannot be excluded for the purposes of measuring the deceptive resemblance. This is more so when we have arrived at the finding that there is no sufficient material showing the user of the word LIV written in isolation which establishes the generic nature of the component and there is no also non establishment of material facts leading up to generic nature of the word.

58. Once we arrive at the finding that the Liv.52 mark is conclusive in registration without any challenge as per section 32, then the conclusion would be that the use of the expression LIV in isolation is an infringement of the prominent feature of the plaintiff's registered trade mark. As the defendant is using the mark LIV in isolation, therefore, the defendant is not entitled to use the same. However, we permit the defendant, if so advised, that the defendant may use the mark containing the expression LIV not written in isolation and is accompanied by suffixes, examples of which are given in the written statement i.e. LIVOGEN, Livpar, Livosin, LIVAPLEX, LIVOFIT, LIVA, LIVOL, LIVDRO, LIVAZOL, LIVERITE, LIVERJET, LIVERNUT, LIVERPOL, LIVUP. At this stage, we wish to recall the submission of the Mr.Hemant Singh, learned counsel that the plaintiff that the plaintiff has no objection if the defendant may use the word LIV along

with suffixes which may not be visually, phonetically or structurally similar to the trade of the plaintiff.

59. For the aforesaid reasons, we allow the appeal. The judgment and decree dated 3rd June, 2010 is set aside. Suit of the plaintiff with regard to infringement of trade mark is decreed. The defendant is restrained from using the mark LIV as part of its trade mark LIV-T while dealing with the medicinal preparations. Decree be drawn accordingly. Since the present litigation is pending for the last more than 15 years and as of today the infringing mark is being used by the defendant for the last 20 years, the defendant is granted six months time to liquidate its pending stock.

60. No order as to costs.

(MANMOHAN SINGH)
JUDGE

(PRADEEP NANDRAJOG)
JUDGE

NOVEMBER 9, 2012/jk/kk