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

Date of Decision: 22nd March, 2024

+ C.O. (COMM.IPD-TM) 154/2021
GSK CONSUMER HEALTHCARE S.A. Petitioner

Through: Mr. Ranjan Narula, Advocate.

versus

CELEBRITY BIOPHARMA LTD. AND ANR. Respondents

Through: Mr. Abhijeet Yadav, Advocate for R-1.

Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. Srish Kumar Mishra,
Mr. Alexander Mathai Paikaday, Mr.
Lakshay Gunawat and Mr. Krishnan
V., Advocates for R-2.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA

JUDGMENT

SANJEEV NARULA, J. (Oral):

1. In the matter before us, the Petitioner - GSK Consumer Healthcare S.A., who holds the registered trademarks “OTRIVIN” and “OTRINOZ” along with their derivative forms in Class 5, has filed a petition under Section 57 of the Trade Marks Act, 1999 [“*Act*”]. The petition seeks the rectification and cancellation of the trademark “OTRINIR”, registered under No. 2892712 in the name of Respondent No. 1 [“*Impugned Mark*”]. Both the Petitioner’s and the said Respondent’s marks are registered in the same class and used for nasal decongestant sprays. Thus, the crucial issue before the Court is whether the Impugned Mark is so similar to the Petitioner’s trademarks as to cause confusion and thereby warrant its removal from the



Register of Trade Marks.

THE FACTUAL BACKDROP:

2. The Petitioner is a member of the GSK group of companies under a joint venture between GlaxoSmithKline (GSK) and Novartis AG [**“GSK Group”**]. As a leading science-driven healthcare entity, GSK Group boasts a significant global footprint, with commercial activities spanning over 150 countries. The group is engaged in the research, development, and production of a broad spectrum of pharmaceuticals, vaccines, and consumer healthcare products. Among its extensive portfolio of over-the-counter medications and self-care products are well-known brands such as OTRIVIN, OTRINOZ, CONTAC, FLONASE, SENSODYNE, AQUAFRESH, PANADOL, and ENO¹.
3. GSK Group has maintained a substantial presence in India for over 90 years, represented through GlaxoSmithKline Consumer Healthcare Limited, established in 1958, and GlaxoSmithKline Pharmaceuticals Limited (GSKPL), founded in 1924. GSKPL, headquartered in Mumbai, oversees seven regional and sales hubs throughout the country. In the Indian market, the GSK Group leads the vaccines self-pay segment and boasts five brands ranked among the top 50 in the pharmaceutical sector.
4. The Petitioner holds the registration for the trademark “OTRIVIN”, a uniquely coined and inherently distinctive mark used for medicinal products designed to treat nasal congestion. Originally, the trademark was filed and registered under the name of Novartis AG. Following a joint venture

¹ To support this submission, the Petitioner has placed on record their annual reports.



between GSK and Novartis AG, the trademark and associated goodwill were transferred to Novartis Consumer Health S.A. Subsequently, Novartis Consumer Health S.A. underwent a name change to GSK Consumer Healthcare S.A., the Petitioner.

5. Petitioner also has another product in the OTRI family of marks, i.e. “OTRINOZ”, which is also used for relieving blocked nose. Both “OTRIVIN” and “OTRINOZ” are nasal decongestants, albeit presented in distinct packaging. Furthermore, the Petitioner, along with its predecessors-in-title, has established *bona fide* ownership over a comprehensive series of related marks. This portfolio includes OTRIVIN-O, OTRIVIN ADULT, OTRIVIN PEDIATRIC, OTRIVIN SALINE, OTRIVIN C, OTRIVIN PLUS, OTRIVIN COLD TAB, and OTRIVIN PERFECT NIGHT, among others.

6. The Petitioner has registrations in over 100 countries in respect of their trademark OTRIVIN in Class 5. The global portfolio originates with its earliest registration dating back to 1939 in Switzerland, while the initial registration in India was secured in 1956². The OTRIVIN-branded products have been available in various markets since 1950, with their introduction to the Indian market occurring in 1979. Given this extensive history of adoption, registration, and consistent use, the Petitioner has established exclusive rights to the trademarks “OTRIVIN” and “OTRINOZ”. These rights extend to prohibiting the use of any identical or deceptively similar marks by unauthorized parties.

7. In April 2020, the Petitioner became aware that the Respondent No. 1

² Registration certificates of the Petitioner’s trademark registrations globally and in India have been filed along with the present petition.



has obtained registration of the Impugned Mark “OTRINIR” under No. 2892712 in Class 5, which encompasses “*Medicinal, pharmaceuticals and ayurvedic preparation and substance, food for babies*”. As per the online record, Respondent No. 1 filed the application for registration of the Impugned Mark on 30th January, 2015, claiming use since 10th April, 2013. Although the Impugned Mark was advertised in the Trade Mark Journal No. 1888 dated 11th February, 2019, the Petitioner did not oppose the application due to inadvertence/ oversight.

8. Upon examining Respondent No. 1’s website, the Petitioner realised that the Impugned Mark was being used specifically for nasal sprays, suggesting that its adoption was intended to create an association with the Petitioner’s products. In an attempt to amicably resolve the issue, the Petitioner issued a legal notice on 1st August, 2020, followed by a reminder letter dated 18th August, 2020. However, Respondent No. 1 declined to settle the matter, as intimated in their reply on 1st September, 2020. In view of the above background, the Petitioner has filed the present petition under Section 57 of the Act seeking cancellation of the Impugned Mark.

PETITIONER’S SUBMISSIONS:

9. In light of the aforementioned factual backdrop, Mr. Ranjan Narula, counsel for the Petitioner, urges the following grounds for the removal of the Impugned Mark from the Register:

9.1. The Impugned Mark “OTRINIR” is phonetically, structurally and visually similar to the Petitioner’s mark “OTRIVIN”, which is likely to cause confusion and deception amongst the general public and trade. Thus, the registration of the Impugned Mark is contrary to Section 9(2)(a) of the



Act.

9.2. The evident similarity between the competing marks “OTRIVIN” and “OTRINIR” would create the impression amongst consumers and traders that Respondent No. 1’s product is associated with Petitioner. Therefore, the registration of the Impugned Mark is liable to be cancelled under Section 11(1) of the Act.

9.3. The Petitioner is the prior adopter of the mark “OTRIVIN”, which has achieved the status of a well-known mark on account of the Petitioner’s extensive and continuous use. Respondent No. 1’s adoption of the Impugned Mark is thus *ex-facie* dishonest, aiming to exploit the goodwill and reputation of the Petitioner’s registered mark, which is borne out by the significant revenue earned by them from the use of the trademark “OTRIVIN”, and also the expenses incurred towards promoting the brand, details whereof are set out as under:

“Year	Worldwide Sales Figures (£ in million)	India Sales Figures (£ in million)	Promotional and marketing Figures (£ in million)
2015	228.2	3.1	48.5
2016	259.7	8.2	58.9
2017	297.0	7.7	60.3
2018	310.4	10.60	65.3
2019	301.5	12.8”	62.5

RESPONDENT NO. 1’S SUBMISSIONS:

10. Mr. Abhijeet Yadav, counsel for Respondent No. 1, contends as follows:

10.1. Respondent No. 1- ‘Celebrity Biopharma Ltd.’ operates as a part of



the “M/S Aishwarya Group”, which has four manufacturing units based on state-of-the-art manufacturing technology approved by WHO-GMP, ISO, CE and various others. Respondent No. 1 and its conglomerate companies have obtained several Approvals & Certifications, details whereof are delineated at Paragraph No. 7 of the reply to the present petition.

10.2. Respondent No. 1 is the *bona fide* user of the Impugned Mark “OTRINIR” since 10th April, 2013, which has been registered *vide* trademark registration No. 2892712. Thus, the mark should be protected under the provisions of the Trade Marks Act and Rules.

10.3. ‘OTRI’ is derived from the term ‘OTORHINOLARYNGOLOGY’, which means the study related to ear, nose and throat. Further, the term ‘OTRI’ is formulated out of two syllables, i.e., ‘OT’ – which stands for ‘over-the-counter medicines’ – and ‘RI’ – which stands for ‘rhinitis’, created by rhinovirus. Thus, Petitioner cannot claim exclusive right over the usage of ‘OTRI’ as it is a generic term or *publici juris* in law, and is employed by several users in the market. Moreover, the suffix ‘NIR’ originates from the name of Respondent No. 1’s founding member/director, Niraj Kumar Nir, and the M/s Aishwarya Group holds several trademark applications incorporating ‘NIR’. This information is further elaborated in Paragraph No. 11 of their reply, supporting the argument that “OTRINIR” is a coined term, combining generic and proprietary elements.

10.4. The claimed similarity between the Impugned Mark and the Petitioner’s mark is superficial. Relying on the Supreme Court judgment in ‘*Cadila Health Care Ltd. v. Cadila Pharmaceutical Ltd.*’³, it is argued that the Court must apply the “anti-dissection rule”, which requires marks to be



compared in their entirety rather than segmented into parts. It would be thus be contrary to the doctrine of anti-dissection to assess similarity of the two marks by only comparing the opening string of letters ‘OTRI’ in the two marks.

ANALYSIS AND FINDINGS:

Whether the competing marks are deceptively similar?

11. In considering the grounds for rectification, the primary task is to ascertain whether the trademarks “OTRIVIN” and “OTRINIR” are deceptively similar. Here, as urged by Mr. Yadav, we must apply the anti-dissection rule, which mandates evaluating the marks in their entirety to capture the overall impression they convey to the average consumer, rather than dissecting marks into their individual components. This holistic view is essential to ensure that the analysis does not improperly isolate elements of the marks, which could skew the perception of their similarity.

12. In the present case, both marks comprise seven letters and share the prefix ‘OTRI’, while utilising distinct suffixes, i.e., ‘-VIN’ for “OTRIVIN” and ‘-NIR’ for “OTRINIR”. Visually, the dominant presence of the common prefix is likely to anchor consumers’ first impressions, thus possibly diminishing and overshadowing the distinctiveness of the two suffixes, particularly during quick observations or when recalled imperfectly. Phonetically, ‘OTRI’ in both marks is expected to be pronounced similarly, enhancing the auditory likeness between the two. While the suffixes ‘-VIN’ and ‘-NIR’ sound quite different, this variance may not be enough to prevent

³ (2001) 5 SCC 73



phonetic confusion given the strong similarity of the prefixes. Conceptually, since neither trademark has an inherent meaning in English, their use in the context of nasal decongestant sprays further compounds the likelihood of confusion, suggesting a potential connection or relationship between the products that does not actually exist.

13. In sum, a holistic comparison of “OTRIVIN” and “OTRINIR” reveals significant phonetic, structural, and visual similarities that are likely to cause confusion among consumers, who may mistakenly believe the products are associated or originating from the same source. Furthermore, the fact that the Impugned Mark has been registered under the same class and is used for identical goods—nasal decongestant sprays—reinforces the potential for consumer confusion. While Respondent No. 1’s registration does encompass a broader range of goods, it remains uncontested that the Impugned Mark “OTRINIR” is currently marketed specifically for nasal sprays, which directly competes with the Petitioner’s product. This overlap in product type and target market underlines the necessity of addressing the deceptive similarity to prevent misleading the public and protect the integrity of established trademarks.

Whether Respondent No. 1’s adoption of the Impugned Mark is bona fide?

14. In view of the stark similarities between the two marks, the next pertinent question that arises for consideration relates to the adoption of the Impugned Mark by Respondent No. 1.

15. At the outset, it is pertinent to note that while the Petitioner has been using their mark “OTRIVIN” since the year 1950, Respondent No. 1’s user



claim is only from the year 2013. Therefore, the Petitioner is unequivocally the prior user — a significant factor in trademark jurisprudence, as prior use can establish precedence in rights over a mark.

16. Respondent No. 1 seeks to justify their use of the Impugned Mark by claiming that the prefix ‘OTRI,’ derived from ‘OTORHINOLARYNGOLOGY’—the medical study of ear, nose, and throat—is generic and extensively used by other market players. They argue that due to its widespread use, ‘OTRI’ has become common to the trade. Therefore, they contend, any overlap in its use should not serve as grounds for the cancellation of the Impugned Mark’s registration. To substantiate that ‘OTRI’ is generic to trade, and precludes exclusivity, Respondent No. 1 has placed on record a computer-generated trademark search report in Class 5 with the search strain ‘OTRI’, listing 69 trademarks bearing the prefix ‘OTRI’.

17. However, these attempts by Respondent No. 1 to portray ‘OTRI’ as a generic term commonly used within the industry are not supported by the evidence they have provided. Mr. Narula aptly points out that the status of the trademarks listed—15 owned by the Petitioner, 17 refused, abandoned, or withdrawn, 11 pending, and 5 opposed (including 2 by the Petitioner)—demonstrates a significant proprietary interest in the term in favour of the Petitioner. The list of marks owned by the Petitioner and its related companies under the ‘OTRI’ family of marks is set out as follows:



S.NO	MARK	COMPANY NAME	STATUS
1.	OTRIVIN	GSK CONSUMER HEALTHCARE SARL	Registered
2.	OTRICORTEN	NOVARTIS AG	Removed
3.	OTRI-ALLERGY-	NOVARTIS AG	Removed
4.	OTRISAL	GSK CONSUMER HEALTHCARE S.A	Registered
5.	OTRIVIN ALERT-	NOVARTIS AG	Registered
6.	OTRINOZ-	GSK CONSUMER HEALTHCARE SARL	Registered
7.	OTRIBRINE	NOVARTIS CONSUMER	Registered
8.	OTRITOD-	NOVARTIS CONSUMER	Registered
9.	OTRICORT	NOVARTIS AG	Registered
10.	OTRIWET-	NOVARTIS CONSUMER	Registered
11.	OTRIKID-	NOVARTIS CONSUMER	Registered
12.	OTRIBALM-	GSK CONSUMER	Registered
13.	Otrivin	GSK CONSUMER	Registered
14.	OTRIVIN COLD TAB-	NOVARTIS CONSUMER	Registered
15.	OTRIVIN PERFECTNIGHT-	GSK CONSUMER	Registered

18. This aforementioned analysis contradicts the claim that ‘OTRI’ is generic or devoid of distinctive character. On the contrary, it reveals the Petitioner’s extensive use and registration of the ‘OTRI’-related marks, which contributes to the association of the term ‘OTRI’ with their products specifically, rather than the category of nasal decongestants as a whole. Furthermore, through the material placed on record, the Petitioner has sufficiently demonstrated that they have substantial goodwill and reputation in their marks, on account of long and continuous use. Specifically, as emphasised by Mr. Narula, the data supplied by IMS⁴ underscores the formidable reputation and market-share enjoyed by the Petitioner in respect of nasal decongestants in Class 5. The information to this effect is extracted as follows:

⁴ By way of letter dated 13th September, 2011, IMS Health Information & Consulting Services India Pvt. Ltd. supplied data regarding the value of the Nasal Decongestant Market and the top 10 brands SKU wise, copy whereof has been placed on record by the Petitioner.



BRANDS	PACKS	COMPANY	MAT Val in crs				
			Dec-06	Dec-07	Dec-08	Dec-09	Dec-10
NASAL DECONGESTANTS MARKET			79.5	89.0	98.7	126.1	156.5
OTRIVIN			21.2	24.5	25.4	31.4	41.0
	OTRIVIN NOSE DROPS 0.10 % 10 ML x 1 (ADLT)	NOVARTIS	14.8	17.1	17.7	22.9	31.1
	OTRIVIN NOSE DROPS 0.05 % 10 ML x 1 (PAED)	NOVARTIS	5.7	6.4	6.6	7.2	8.9
	OTRIVIN NOSE DROPS 0.025 % 10 ML x 1	NOVARTIS	0.7	1.0	1.1	1.2	1.0
NASIVION			11.2	11.8	12.7	15.7	23.2
	NASIVION NOSE DROPS 0.05 % 10 ML x 1 (ADLT)	MERCK	5.1	5.2	5.3	7.2	9.6
	NASIVION NOSE DROPS 0.025 % 10 ML x 1 (PAED)	MERCK	2.8	3.1	3.4	3.8	6.1
	NASIVION NOSE DROPS 0.01 % 10 ML x 1 (MINI)	MERCK	2.0	2.1	2.2	2.5	4.3
	NASIVION NOSE DROPS 0.65 % 10 ML x 1	MERCK	1.2	1.3	1.7	2.2	2.8
	NASIVION NASAL SPRAY 0.05 % 10 ML x 1 (ADLT)	MERCK	0.0	0.0	0.0	0.0	0.4
	NASIVION NAS.SPY.GEL 0.05 % 10 ML x 1	MERCK	0.0	0.0	0.0	0.0	0.0
NASOCLEAR			5.0	4.7	6.9	11.0	14.9
	NASOCLEAR NOSE DROPS 0.65 % 20 ML x 1	ZYDUS	3.0	4.0	6.3	10.1	13.6
	NASOCLEAR NOSE DROPS 0.65 % 15 ML x 1	ZYDUS	1.6	0.5	0.5	0.7	1.0
	NASOCLEAR NOSE DROPS 0.65 % 10 ML x 1	ZYDUS	0.5	0.2	0.1	0.1	0.2
	NASOCLEAR GEL 0.65 % 15 G x 1	ZYDUS	0.0	0.0	0.0	0.1	0.1
KARVOL PLUS			5.0	5.3	7.2	9.3	10.7
	KARVOL PLUS CAPS INHAL x 10	INDOCO	4.0	4.3	5.6	8.5	10.7
	KARVOL PLUS TABS x 10	INDOCO	0.9	1.0	1.7	0.8	0.0
FLOMIST			4.6	5.3	5.5	5.9	6.4
	FLOMIST NASAL SPRAY 50 Y x 100 (/DOS)	CIPLA	4.6	5.3	5.5	5.9	6.4
OTRINOZ-OLD			0.0	0.0	2.1	4.5	6.3
	OTRINOZ-OLD NOSE DROPS 0.10 % 10 ML x 1 (ADLT)	NOVARTIS	0.0	0.0	1.1	2.1	2.8
	OTRINOZ-OLD NOSE DROPS 0.05 % 10 ML x 1 (PAED)	NOVARTIS	0.0	0.0	0.7	1.6	2.2
	OTRINOZ-OLD NOSE DROPS 0.025 % 10 ML x 1 (BAB)	NOVARTIS	0.0	0.0	0.4	0.8	1.3
FLIXONASE			4.4	5.3	4.8	6.8	5.4
	FLIXONASE NASAL SPRAY 50 Y 120 ML x 120 (/DOS)	GSK	4.4	5.3	4.8	6.8	5.4
EFCORLIN			3.7	3.8	4.2	3.9	4.2
	EFCORLIN NOSE DROPS 0.025 % 10 ML x 1 (/02)	GSK	3.4	3.5	3.8	3.6	3.9
	EFCORLIN NOSE DROPS 15 ML x 1	GSK	0.2	0.3	0.4	0.3	0.4
	EFCORLIN NOSE DROPS 10 ML x 20	GSK	0.0	0.0	0.0	0.0	0.0
RHINOCORT			4.2	4.7	4.2	4.6	3.9
	RHINOCORT NAS AERO.DOS 64 Y x 200 (/DOS)	ASTRAZENECA	2.0	2.1	2.0	2.2	2.6
	RHINOCORT NAS AERO.DOS 50 Y x 200 (/DOS)	ASTRAZENECA	2.2	2.6	2.2	2.4	1.3
SINAREST			1.8	2.0	2.3	2.9	3.4
	SINAREST NOSE DROPS 0.50 MG 10 ML x 1 (/1ML)	CENTAUR	1.3	1.4	1.5	1.6	1.7
	SINAREST NOSE DROPS 0.025 MG 15 ML x 1 (/1ML)	CENTAUR	0.3	0.4	0.4	0.6	0.9
	SINAREST NOSE DROPS 0.025 MG 10 ML x 1 (/1ML)	CENTAUR	0	0	0	1	1

19. Furthermore, the manner in which Respondent No. 1 adopted the mark—claiming ‘OTRI’ to be generic, yet using it competitively—casts doubt on the *bona fides* of their usage. Given that the Petitioner’s use of similar marks significantly predates other market entries, Respondent No.1’s subsequent choice of “OTRINIR”, closely mirroring “OTRIVIN” and targeting the same product category, seems more opportunistic than coincidental. This approach indicates a strategic attempt by Respondent No.1 to leverage the strong brand identity and established consumer recognition associated with the Petitioner’s mark.

20. Additionally, there is apparent contradiction in Respondent No. 1’s argument. By using ‘OTRI’ in the Impugned Mark, they inadvertently



affirm its distinctiveness—a direct counter to their defence that it is a generic term widely used in the trade. This paradox not only reinforces the inherent weaknesses in Respondent No. 1's arguments but also exposes the Impugned Mark to potential cancellation for lacking distinctiveness, in addition to the grounds previously discussed.

21. Lastly, the Court agrees with Mr. Narula's contention that the search results provided by Respondent No. 1 do not conclusively prove that 'OTRI' is common to trade. The relevance of such a list is limited, as the mere presence of trademarks in a search report does not verify whether these marks are actively employed by businesses to distinguish their goods or services. This understanding is supported by the decision in *Novartis AG v. Crest Pharma Pvt. Ltd.*⁵, wherein this Court has observed that a party must substantiate their claim that a mark is common to trade with cogent and clear evidence of actual user of such marks. There is no such material placed on record by Respondent No. 1 to indicate that the marks cited in the aforementioned search report are actually in use, and if they are, that such use is in respect of identical goods with which we are concerned, i.e., nasal decongestant sprays. This lack of evidence on the usage of the listed 'OTRI' trademarks weakens the argument that the term 'OTRI' is generic and commonly used within the industry. Furthermore, as noted by the Division Bench in *Pankaj Goel v. Dabur India Ltd.*⁶, there is no onus on a proprietor to sue every small infringer who may not pose any threat to the distinctiveness of a mark⁷. Accordingly, Respondent No. 1 has not discharged their burden of demonstrating actual use of the cited marks, and

⁵ 2009 SCC OnLine Del 4390

⁶ 2008 SCC OnLine Del 1744



therefore, the search results in and of themselves would not render the mark ‘OTRI’ to be common to trade.

CONCLUSIONS AND DIRECTIONS:

22. In view of the above analysis, the Court finds that the registration of the Impugned Mark violates Section 9(2)(a) and Section 11(1), 11(2) read with Section 18 of the Act, and is thus liable to be removed from the Register under Section 57 of the Act.

23. Accordingly, the present petition is allowed with the following directions:

23.1. Registration under Application No. 2892712 for the Impugned Mark “OTRINIR” in Class 5, is cancelled.

23.2. Respondent No. 2 is directed to issue an appropriate notification to this effect.

23.3. Registry is directed to supply a copy of the present order to the Trade Marks Registry at llc-ipo@gov.in for compliance.

24. With the aforesaid, the petition is disposed of.

POSTSCRIPT:

25. In the previous order dated 23rd November, 2023, a significant issue was highlighted concerning the updating of the records by the Controller General of Patents, Designs and Trademarks (CGPDTM), as noted in Paragraph No. 4 to the following effect:

“4. The office of CGPDTM shall take steps to ensure that in future, whenever cancellation petitions are filed and notice is being issued by the High Court, the same is duly reflected in the website of the IPO. Registry is also directed that whenever notices are issued in petitions i.e., C.O., relating to any of the

⁷ Similarly held in (1970) 3 SCC 665; (189) 7 PTC 14; (2004) 29 PTC 435.



IPR property, a copy of the said order, ought to be automatically transmitted to the office of CGPTDM on the e-mail: llcipo@ gov.in & legal-tmrd@gov.in.”

26. Mr. Harish Vaidyanathan Shankar, CGSC, has reported compliance difficulties with the Court’s directions, particularly in updating the status on the IPO website. This complication primarily arises because the Court’s orders often do not include the registration details of the specific Trademarks, Designs, Copyrights, or Patents against which a rectification action has been filed.

27. Accordingly, it is directed that the Registry must ensure that any order pertaining to cancellation/ revocation includes the necessary details that will enable the CGPD TM and/or the Registrar of Copyrights to effectively update their records. Ideally, these details should be explicitly stated within the order itself. However, should there be instances where these details are omitted, the Registry is instructed to provide this essential information to the concerned Office, along with the copy of the order. This measure is intended to facilitate the accurate and timely update of the official records, thereby maintaining the integrity of the registered Trademarks, Designs, Copyrights, or Patents. It would not only enhance administrative efficiency but also ensure transparency and accessibility, enabling the public and interested parties to obtain the most current and accurate information regarding the legal status of intellectual property rights.

SANJEEV NARULA, J

MARCH 22, 2024/as

Corrected and released on 12th April, 2024.