



(T)CMA (TM) No. 72 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Judgment reserved on	27.09.2023
Judgment pronounced on	8.12.2023

CORAM

The Hon'ble Mr. Justice **SENTHILKUMAR RAMAMOORTHY**

(T) CMA (TM) No.72 of 2023
(OA/13/2018/TM/CHN)

M/s.Indian Immunologicals Ltd.,
 A company duly organized and
 existing under the laws of India,
 Road No.44, Jubilee Hills,
 Hyderabad – 50033, Telangana.

... Appellant

vs.

1. IPCA Laboratories Pvt. Ltd.
 At 48, Government Industrial Estate,
 Kandivli (West), Bombay – 400067.

2. Deputy Registrar of Trademarks,
 Intellectual Property Building,
 G.S.T. Road, Guindy,
 Chennai – 600032.
 ...Respondents

PRAYER: This Civil Miscellaneous Appeal is filed under Section 91 of the Trademarks Act,1999, praying to set aside the order dated March 10, 2015, passed by the learned Deputy Registrar of Trade Marks which is contrary to the law and facts of the case at hand;



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grant interim stay on the operation of the order dated March 10, 2015, during the pendency of this appeal; and to pass any other order which this Hon'ble Court deems fit.

For Appellant : Ms.Vindhya S.Mani,
Mr.Kiran Manokaran,
Ms.Krithika Jaganathan,
Mr.Vishal Sundar,
for M/s.Lakshmikumaran
and Sridharan

For Respondent No.1 : Mr.Yatin Khochare,
Ms.Preeta Panthaki,
for M/s.Krishna and
Saurastri Associates.

For Respondent No.2 : Mr.Rajesh Vivekananthan,
Deputy Solicitor General.

JUDGMENT

The appellant assails an order dated 10.03.2015 (wrongly written as 10.03.2014 in the impugned order) by which Opposition No.MAS-164458 was allowed and, consequently, Application No.839370 for registration of the trade mark “INIMOX” was rejected.

2. The appellant applied for registration of the word mark “INIMOX” on 02.02.1999 in relation to medicinal and pharmaceutical preparations for veterinary use on a “proposed to be used” basis. The



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application was accepted for advertisement and such advertisement was published in Trade Marks Journal Mega 2 dated 25.09.2003 at page No.256.

3. Upon noticing such advertisement, on 25.02.2004, the first respondent lodged a notice of opposition objecting to the registration of the above-mentioned mark on the ground that it is the prior user and registered proprietor of the trade mark “IMOX” under Trade Mark No.461167B in class 5 in respect of pharmaceutical and medicinal preparations with effect from 06.10.1986, and that the impugned mark “INIMOX” is deceptively similar to its mark. The appellant filed the counter statement dated 28.09.2004 in response to the notice of opposition by contending that the two marks are visually, structurally, and phonetically different. Both parties filed evidence in support of the opposition and application, respectively. Pursuant to the conclusion of the hearing on 10.09.2014, the impugned order was issued allowing the opposition and, consequently, refusing the application for registration of the mark



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“INIMOX”. The present appeal arises in the said facts and circumstances.

Counsel and their contentions

4. Oral submissions on behalf of the appellant were advanced by Ms.Vindhya S.Mani, learned counsel; on behalf of the first respondent by Mr.Yatin Khochari, learned counsel; and Mr.Rajesh Vivekananthan, learned Deputy Solicitor General, represented the second respondent.

5. Ms.Vindhya S.Mani, learned counsel, submitted that the appellant conceived and adopted the mark “INIMOX” in February 1999. The appellant applied for the registration of the said mark on 02.02.1999 under Application No.839370 in class 5 on a “proposed to be used” basis. The appellant started using the said mark shortly after filing the application.

6. Learned counsel submitted that the appellant applied for registration of the trade mark “INIMOX” in relation to medicinal/



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pharmaceutical products for veterinary use, specifically for the treatment of respiratory infections in cows and buffaloes. In view of the fact that both the appellant's and first respondent's marks are derived from the name of the active pharmaceutical ingredient (API), amoxycillin, learned counsel contended that any registered trade mark derived in this manner is weak. Consequently, no protection is extended unless the marks are nearly identical. As long as the later mark may be differentiated from the earlier mark, as is the case when "IMOX" is compared with "INIMOX", she contended that the proprietor of the earlier mark cannot object to and prevent the registration of the later mark. Learned counsel pointed out that the pharmaceutical product sold under the mark "INIMOX" is meant for administration to animals by way of injection, whereas the product sold under the first respondent's mark "IMOX" is a capsule meant for human consumption. Therefore, she contended that the trade channels and consumer base of the respective goods are different. By referring to Rule 97 of the Drugs and Cosmetics Rules, 1945, which stipulates that important particulars of the drug have to be conspicuously written on the packaging or container, which is also



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required to contain a pictorial depiction of an animal, she contended that such statutory mandate eliminates any likelihood of confusion among the public.

7. By relying on the annual reports of the appellant for the financial years 2003-2004 and 2012-2013 and copies of invoices bearing the mark “INIMOX”, she contended that there is evidence of use from the year 2000. She also relied on search reports from the Trade Marks registry and the packaging of medicines with the suffix “MOX” to contend that the word “MOX” is common to trade.

8. By inviting my attention to the impugned order, Ms.Vindhya S.Mani, learned counsel, contended that the order is perverse because of the following reasons: first, the finding that both products are a combination of *amoxycillin* and *cloxacillin* is factually incorrect; secondly, the finding that “INIMOX” is used for human consumption is contrary to the evidence on record; and thirdly, in the examination report, the Registrar did not cite the first respondent's mark as being deceptively similar to the impugned mark.



9. In support of the above contentions, learned counsel for

the appellants referred to and relied upon the following judgments:

(i) *Syngenta Limited v. Hyderabad Chemical Supplies Limited & Deputy Registrar of Trade Marks (Syngenta)*, OA/33/2008/TM/CH, Order dated 13.06.2011, Intellectual Property Appellate Board (the IPAB), where, at the interlocutory stage, in the context of two marks used for pesticides/insecticides, the proprietor of the trade mark Icon was held to be not entitled to relief in respect of the trade mark Imicon.

(ii) *Corona Remedies Private Limited v. Franco-Indian Pharmaceuticals Private Limited (Corona Remedies)*, Commercial Appeal No.46 of 2021, Judgment dated 20.01.2023, Bombay High Court (DB), where the proprietor of the trade mark Stimuliv was held to be not entitled to relief in respect of the trade mark Stimu-let.

(iii) *Orchid Chemicals & Pharmaceuticals Ltd. v. Wockhardt Limited (Orchid Chemicals)*, 2013 (3) CTC 841, where, at the interlocutory stage, the proprietor of the trade mark Meto was held to be not entitled to relief in respect of the trade mark Metox.

(iv) *Apex Laboratories Ltd. v. Zuventus Health Care Ltd. (Apex Laboratories)*, 2006 SCC OnLine Mad 1238,



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where, at the interlocutory stage, the proprietor of the trade mark Zincovit was held to be not entitled to relief in respect of the trade mark Zinconia.

(v) *Sanjay Kumar Singh v. The State of Jharkhand*, MANU/SC/0305/2022, where the scope of Order XLI, Rule 27 CPC was discussed.

(vi) *Astrazeneca UK Ltd & Anr v. Orchid Chemicals & Pharmaceuticals Ltd (Astrazeneca)*, ILR (2007) I DELHI 874, where, at the interlocutory stage, the proprietor of the trade mark Meronem was held to be not entitled to relief in respect of the trade mark Meromer.

(vii) *Elyon Pharmaceuticals Pvt Ltd v. The Registrar of Trade Marks*, 2023: DHC: 6074, where the Delhi High Court held that the refusal to register the trade mark Elmentin on the basis of the cited trade mark Elemental warranted interference.

(viii) *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd*, (2018) 2 SCC 1, where the territoriality principle was applied and Toyota was held to be not entitled to prevent the use of the trade mark Prius by the respondent in India.

(ix) *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683, where the centrality of use in trade mark law was underscored.

(x) *Macleods Pharmaceuticals Ltd v. Swisskern Healthcare*



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and another (*Swisskem*), 2019 SCC OnLine Bom 1186, where the proprietor of the trade mark Panderm was held to be not entitled to relief in respect of the trade mark Polyderm.

(xi) *Schering Corporation & Anr v. United Biotech (P) Ltd (Schering Corporation)*, (2010) (7) Mh.L.J.611, where, at the interlocutory stage, the proprietor of the trade mark Netromycin was held to be not entitled to relief in respect of the trade mark Netmicin.

10. In response to these contentions, Mr.Yatin Khochari, learned counsel, opened his submissions by pointing out that additional documents were submitted to the Court at the appellate stage without leave of the Court and, therefore, he submitted that such additional documents should not taken into consideration by the Court.

11. On merits, learned counsel submitted that the first respondent's mark "IMOX" was adopted in the year 1982 and was registered under Trade Mark No.461167B in class 5 in respect of pharmaceutical and medicinal preparations with effect from



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06.10.1986. He also relied on the findings of the Registrar to that effect and contended that the first respondent is the prior user of the mark. He further submitted that the appellant manufactures a vaccine for human consumption and that the contention that the appellant does not manufacture drugs for human consumption is contrary to fact. Regarding the plea that the element "MOX" is *publici juris* in the pharmaceutical industry, he submitted that such a plea was not taken earlier, and that the appellant has not discharged the burden of establishing *publici juris*. On the contention that the right to exclusive use of a mark originating from a common generic name is limited, learned counsel submitted that the only difference between the appellant's mark and that of the first respondent is the addition of the letters 'NI' after the initial letter 'I' and that the impugned mark infringes even if allowance is made for the common generic source. More importantly, he submitted that allowing such a mark to be entered on the register would cause confusion and deception among the public.



12. In support of these contentions, learned counsel relied

upon the following judgments:

(i) *Associate Builders v. Delhi Development Authority*, (2015) 3 SCC 49, particularly paragraphs 31 and 32, as to what constitutes perversity.

(ii) *Macleods Pharmaceuticals Ltd v. Union of India and Others (Macleods Pharmaceutical)*, 2023 SCC Online Bom 408(DB), particularly paragraph 25, on the criticality of ensuring that the slightest risk of confusion should be prevented as regards pharmaceutical products.

(iii) *E. Griffiths Hughes v. Vick Chemical Co.*, MANU/WB/0180/1959, with regard to the determination of the rights of parties as on the date of application.

(iv) *A. Andisamy Chettiar v. Subburaj Chettiar*, (2015) 17 SCC 713.

(v) *K.R Mohan Reddy v. Network Inc.*, (2007) 14 SCC 257.

(vi) *Sanjay Kumar Singh v The State of Jharkhand*, Civil Appeal No. 1760 of 2022.

(vii) *Bal Pharma v Centaur Laboratories*, 2001 SCC Online Bom 1176, regarding the importance of conducting a search of the register of trade marks



before adoption of a mark.

(viii) *Cadila Health Care Ltd. v Cadila Pharmaceuticals Ltd, (Cadila), (2001) 5 SCC 73*, particularly paragraphs 22, 25, 27 and 32 thereof, regarding the greater need to be strict about the likelihood of confusion in the context of pharmaceutical products.

(ix) *Milmet Oftho Industries and Ors v Allergan Inc, (2004) 12 SCC 624*.

(x) *Cadila Pharmaceuticals Ltd v Sami Khatib (Sami Khatib), 2011 SCC Online Bom 484*, where it was held that the proprietor of a trade mark applied in India for export is entitled to protect such mark.

(xi) *Kirorimal Kashiram Marketing & Agencies Private Limited v Sachdeva & Sons Industries Pvt. Ltd, 2008 SCC Online Del 1328*.

(xii) *UFO Contemporary, INC v Creative Kids Wear (India) Pvt Ltd and Ors, MANU/DE/2108/2020*.

(xiii) *Charak Pharma Pvt Ltd v Glenmark Pharmaceuticals Ltd, 2014 SCC Online Bom 98*.

(xiv) *Corn Products Refining Company v Shangrila Food Products Ltd, AIR 1960 SC 142*, for the proposition that the onus is on the person alleging extensive use of the common element in the relevant marks to establish the same.

(xv) *Sun Pharmaceuticals Industries Ltd and Ors. v*



Kinetic Lifescience (OPC) P. Ltd and Ors – 2022 SCC Online Del 4793.

(xvi) Charak Pharmaceuticals v M.J Exports Pvt Ltd, 1992 SCC Online Bom 534 : (1993) 13 PTC 309.

(xvii) Ranbaxy Laboratories v Vets Farma Pvt Ltd and Ors., 2004 SCC Online IPAB 86, where the IPAB concluded that refusal to register the trade mark Levasol was justified although the mark was used for veterinary products whereas the opponent's mark Lemasol was intended for human consumption.

(xviii) Solvay and Cie v Mexin Medicaments Pvt Ltd and Ors. (Solvay and Cie), 2004 SCC Online IPAB 34, where the IPAB concluded that refusal to register the trade mark Solvay was justified although the mark was used for veterinary products whereas the opponent's mark Solvin was intended for human consumption.

(xix) Glaxo Group Limited v Neon Laboratories, 2003 SCC Online Bom 1126.

(xx) Glaxo Smith Kline Pharmaceuticals Ltd v Biovet Formulations, 2004 SCC OnLine Del 139.

*(xxi) Himalaya Drug Co. v S.B.L Limited, 2012 SCC Online Del 5701, where it was held that the person raising the defence of *publici juris* should prove the same.*

(xxii) National Sewing Threading Company Limited v



James Chadwick & Brothers Ltd., (1953) 1 SCC 794, particularly paragraph 28 thereof, where it was held that the likelihood of deception and confusion should be looked at from the perspective of the public and not only the opponent.

(xxiii) *Ciba Ltd., Basle, Switzerland v. M. Ramalingam & S.Subramaniam trading in the name of South Indian Manufacturing Co., Madura and another, 1957 SCC OnLine Bom 45(DB)*, particularly paragraph 5 thereof, where the Court held that the duty to protect the public should outweigh any inconvenience to a particular party.

Discussion, analysis and conclusions

13. In light of the rival contentions, the first question that falls for consideration is whether the additional documents sought to be relied on by the appellant can be admitted at the appellate stage and I deal with the said issue first.

14. In view of sub-rule 7 of Rule 7 of the Intellectual Property Rights Division Rules, 2022 (the 2022 Rules), this Court has the power to grant leave to produce additional documents in an



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appeal. Sub-rule 9 of Rule 7 of the 2022 Rules makes it clear that Order XLI, Rule 27 of the Code of Civil Procedure, 1908 (the CPC), shall apply to the extent that it is not inconsistent with the 2022 Rules. According to Order XLI, Rule 27 of the CPC, parties to an appeal are not entitled to produce additional evidence, oral or documentary, except upon obtaining leave of the Court. Such leave may be obtained if the party applying for leave establishes that the additional evidence could not be produced in spite of the exercise of due diligence when the matter was conducted before the court of first instance or if the court is of the view that such additional evidence is necessary for the adjudication of the appeal.

15. In the case at hand, apart from the application, counter statement and requisite forms, the appellant filed the affidavit of Mr.K.Suryanarayana, its then Company Secretary & Legal Manager, by way of evidence in support of its application before the Registrar of Trade Marks. The appellant annexed two exhibits to the said affidavit: Exhibit A being an abstract indicating the turnover from the sale of products bearing the trade mark "INIMOX" from the year



2002-2005; and Exhibit B being a series of advertisements bearing the trade mark "INIMOX". In the appeal filed before the Intellectual Property Appellate Board (the IPAB), the appellant filed about 14 exhibits along with a miscellaneous application for leave to rely on additional documents.

16. The documents in the appeal paperbook include documents forming part of the prosecution history, such as the certified copy of the impugned order (Exhibit-1); true copy of Form TM-70 filed before the second respondent(Exhibit-4); true copy of Form TM-1 pertaining to the impugned mark "INIMOX" (Exhibit-5); journal advertisement of the impugned mark "INIMOX"(Exhibit-6); notice of opposition(Exhibit-7); counter statement filed in response to the notice of opposition(Exhibit-8); the evidence in support of the opposition(Exhibit-9); evidence in support of the application(Exhibit-12); and evidence in reply filed by the first respondent (Exhibit-13). Since all the above documents clearly formed part of the record before the Registrar of Trade Marks, they are not additional documents within the meaning of Order XLI, Rule 27 of the CPC.



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17. The appeal paper book also includes the annual reports of the appellant(Exhibit-2); copies of invoices showing use of the trade mark "INIMOX"(Exhibit-3); a search report from the trade mark registry's website (Exhibit-10); the original packaging of products containing the suffix "MOX" along with invoices(Exhibit-11); and records pertaining to Trade Mark No.461167 for the mark "IMOX"(Exhibit-14). These documents were not part of the evidence adduced by the contesting parties before the Registrar of Trade Marks.

18. The appellant had two prior opportunities to place on record all relevant evidence, i.e. either along with the application, or in response to the notice of opposition. Besides, since the trade mark application was made on a "proposed to be used" basis, evidence of use does not advance the case for registration with effect from 02.02.1999. Therefore, I am unwilling to permit reliance on Exhibits-2, 3 and 11. I would, however, permit reliance on Exhibits-10 & 14 because they are documents in the public domain and would be of value in the adjudication of this appeal.



Whether the rejection of registration was justified?

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19. On the merits of the dispute, the first question that arises is whether the decision of the Registrar is liable to be interfered with. The impugned order of the Registrar, in relevant parts, is extracted below:

"I have heard the arguments of both the counsels and gone through the evidences filed in the instant proceedings. It is found that the opponent's mark is in use since 1982 and it is being used for the purpose of curing lower respiratory tract infections, ENT infections, Skin & soft tissue infections and Dental infections in human beings. The opponent's herein mark IMOX was registered under No.461167 and it is valid upto 6/10/2017. The said registered mark was applied on 6/10/1986 with a proposed to be used mark. The IMOX is a combination of Amoxycillin + Cloxacillin. On the other hand, it is found that the applicant's mark 'Inimox' is also a combination of Amoxycillin + Cloxacillin Injection....The applicant has not filed invoices in support of use of the mark. The opponent has filed invoices from 1982 in support of use of the mark. But, the applicants have applied their mark 'INMOX' with a proposed to be used mark. Therefore, it is clear from the evidences that both the mark is used for the same purposes and the opponent is the prior user of the



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mark. The applicant is the subsequent user of the mark applied for. The intention of the applicant, it appears that the applicant is wanted to ride upon the opponent's reputation in absence of establishing honest adoption and as rightly pointed out by the opponent's counsel that the prefix 'IN' has been added to make it 'INIMOX'. It is also clear that the mark of applicant is used both for the human and animal purposes to treat the respiratory tract infections. Definitely, it will cause confusion and/or deception amongst the consumers by virtue of likelihood of slurring of prefix 'in' at the time of purchase."

As correctly pointed out by learned counsel for the appellant, some conclusions in the impugned order are clearly untenable. For instance, the conclusion that both products contain 'amoxycillin' and 'cloxacillin' is contrary to the factual position that the first respondent's product bearing the trade mark "IMOX" contains only 'amoxycillin', whereas the appellant's product bearing the trade mark "INIMOX" contains both 'amoxycillin' and 'cloxacillin'. Although the first respondent manufactures and markets a product bearing the trade mark, IMOX-CLO, which contains both amoxycillin and cloxacillin, the opposition was filed on the strength of the mark



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"IMOX" and not "IMOX-CLO". The conclusion that both products are used for humans and animals is completely untenable in view of the admitted position that the first respondent's product is intended for human consumption, whereas the appellant's product is intended to be administered only to animals. Even so, the fundamental basis of the impugned order is that there is likelihood of confusion among the public if the appellant's mark is entered on the register. In order to examine whether this conclusion calls for interference, I turn first to the relative grounds for refusal of registration.

20. The relative grounds for refusal of registration of a trade mark, other than a well-known trade mark, are contained in Section 11(1) of the Trade Marks Act, which is set out below:

"11. Relative grounds for refusal of registration.

(1) Save as provided in section 12, a trade mark shall not be registered if, because of--

(a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or



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(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

Section 11 indicates that the first question to be examined is: who is the prior user of the mark? The first respondent has placed on record invoices evidencing use of its mark from 1982 and provided evidence of incurring promotional expenditure from the financial year 1982-83. This was, however, countered by learned counsel for the appellant on the ground that such use was outside India. The evidence on record indicates that the first respondent's mark was applied to goods in India since 1982, albeit the said goods were exported from India in the early years. Under Section 56 of the Trade Marks Act, such use is tantamount to use in India. The judgment of the Bombay High Court in *Sami Khatib*, which was cited by the first respondent, also supports this position. Thus, the position that emerges is that the first respondent's use pre-dated use by the appellant by several years. The



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next question to be examined is whether the goods of the first respondent and appellant are similar.

21. The admitted position is that the rival marks are used in relation to pharmaceutical products. In order to decide whether goods are similar, the primary considerations are: the nature of goods; the origin; whether the goods may be used as substitutes; whether the goods are complementary; and whether the trade channels are common. Being pharmaceutical products, notwithstanding the fact that the goods of the appellant are intended for veterinary use whereas the goods of the first respondent are intended for human use, the goods are similar in nature and origin. Therefore, I conclude that they are similar. This leads to the question whether refusal under Section 11(1) of the Trade Marks Act was justified.

22. On this issue, learned counsel for the appellant contended that both the trade marks are derived from the generic name 'amoxycillin'; that a mark derived from a generic name is weak;



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and that the claim to exclusive use may be defeated by pointing to even minor differences between the marks. The judgments in *Astrazeneca*, *Swisskem*, *Schering Corporation*, *Orchid Chemicals*, *Syngenta* and *Apex Laboratories* were relied on in support of this proposition. Learned counsel for the first respondent did not disagree with the principle that a claim to exclusive use may be relatively easier to defeat when the relevant marks trace their origin to a generic name, but contended that the degree of similarity is so striking, in this case, that the appellant cannot be permitted to register the later mark. By relying on the Supreme Court's judgment in *Cadila* and the judgment of the Division Bench of the Bombay High Court in *Macleods Pharmaceuticals*, learned counsel for the first respondent contended that, as regards marks relating to pharmaceutical products, the necessity to avoid the slightest risk of deception or confusion on the part of the public should be accorded the highest importance because the consequences of confusion may be dire.



23. Many related questions arise from the discussion in the preceding paragraph. To what extent does the origin of a mark from a generic name impact its strength? Does the extent of impact depend on how much of the mark is appropriated from the generic name? Does the extent of impact depend on how much is added to the mark by the proprietor to the material appropriated from the generic name? To what extent does it depend on how much of the later mark is appropriated from the generic name? How do you reconcile the weakness of marks derived from a generic name or source with the vital need to protect the public from the likelihood of confusion, including by association, especially in the context of pharmaceutical products? In order to answer these questions, it is instructive to look closely at cases cited at the bar. I focus on those cases next.

24. By way of caveat, it should be noticed that most of the judgments were in interlocutory proceedings. In *Astrazeneca*, in the context of both the earlier and later mark being derived from the generic name Meropenem, the Division Bench of the Delhi High Court refused to interfere with an order dismissing the application



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for interim injunction filed by the proprietor of the trade mark

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Meropenem against use of the trade mark Meromer. It is noticeable

that the proprietor of the earlier mark merely omitted the letters 'pe'

from the generic name Meropenem while coining its mark. In *Orchid*

Chemicals, in the context of both the earlier and later mark being

derived from the generic name Metoprolol, the Division Bench of this

Court refused to interfere with an order dismissing the application

for interim injunction filed by the proprietor of the trade mark Meto

against use of the trade mark Metox. In this case, the earlier mark,

Meto, was formed merely by appropriating the first four letters from

the generic name.

25. In *Schering Corporation*, in the context of both the earlier

and later mark being derived from the generic name Netilmicin, the

Division Bench of the Bombay High Court refused to interfere with

an order dismissing the application for interim injunction filed by the

proprietor of the trade mark Netromycin against use of the trade

mark Netmicin. It is noticeable that the proprietor of the earlier mark

appropriated both the prefix 'Net' and the suffix 'micin', albeit by



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replacing the 'i' in 'micin' with 'y' to form 'mycin'. Besides, the letters 'il' in the middle of the generic name were replaced by the letters 'ro'.

In *Corona Remedies*, in the context of both the earlier and later mark being derived from the English word 'stimulate', the Division Bench of the Bombay High Court interfered with an order of interim injunction granted against use of the mark 'Stimu-let' at the instance of the proprietor of the trade mark 'Stimuliv'. Here, the earlier mark combined an abbreviation of stimulate and liver and the later mark combined an abbreviation of stimulate and the generic 'letrozol'.

26. By drawing on the above cases but without intending to be exhaustive of relevant considerations, I reach the following conclusions. Undoubtedly, the strength of a trade mark that is coined by appropriating from a generic name or API is weaker than an arbitrary or invented mark. In my view, the extent of appropriation from such generic name matters and, other things being equal, the greater the appropriation, the weaker the mark. Apart from the extent of appropriation, the extent of addition by the proprietor of the mark matters. Other things being equal, the greater the addition to



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the generic name by the proprietor, the stronger the mark. Needless to say - be it in infringement or passing off actions, or in the context of an application for registration and objections being raised on relative grounds - the visual, phonetic and structural similarity between the later and earlier marks will, as in all cases, play a significant role. The likelihood of deception and confusion on the part of the public also cannot be underestimated and this assumes relatively greater significance when an application to enter a mark on the register is under consideration because no infringement action would lie against a proprietor upon registration of the relevant mark.

27. I apply the above principles to this case. The first respondent admits that it coined the trade mark "IMOX" by appropriating the letters 'mox' from amoxycillin. In view of such admission, the contention that *publici juris* was not proved becomes immaterial. The first respondent has thus appropriated three letters from the generic name. The addition thereto is, however, limited to the alphabet 'I' at the beginning. The appellant also appropriated the letters 'mox' from amoxycillin and added the letters "Ini" at the



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beginning. In my view, the appropriation from a generic name and the limited addition thereto render the first respondent's mark weak.

While it may still be sufficient if the later mark turns out to be identical or if the later mark did not trace its origin to a common generic name, which is the active pharmaceutical ingredient in the relevant products, in the facts and circumstances, the first respondent is not entitled to prevent registration of the later mark. Whether the registration of the later mark was, nonetheless, liable to be refused in public interest by the Registrar because of the likelihood of deception and confusion, especially in the context of a pharmaceutical product in light of principles laid down in *Cadila* and *Macleods Pharmaceuticals*, falls for consideration next.

28. The factual position is that the appellant's product is an injection administered to animals whereas the first respondent's product is a capsule for human consumption. Rule 97(3) of the Drugs and Cosmetics Rules, 1945, which was relied on by learned counsel for the appellant, provides as under:



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"97(3) *The container of a medicine made up ready only for treatment of an animal shall be labelled conspicuously with the words 'Not for human use; for animal treatment only' and shall bear a symbol depicting the head of a domestic animal.*"

While learned counsel for the first respondent placed reliance on documents indicating that the appellant is also engaged in the production of human vaccines, there is clearly no evidence of the use of the trade mark "INIMOX" in relation thereto. More importantly, learned counsel for the appellant submitted, on instructions, that the appellant agrees to restrict use of the trade mark "INIMOX" to drugs intended for veterinary use. The fact that the first respondent has admittedly not initiated any action for infringement or passing off against the appellant although the appellant asserts use since 1999 does not operate as an estoppel against an opposition by the first respondent, but it is indicative *prima facie* of the absence of actual deception or confusion. The absence of evidence of actual confusion or deception, in these type of cases, is not a condition precedent for a



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successful opposition, but cannot be construed as irrelevant. The search report from the Trade Marks Registry's website also discloses that several marks with the element 'MOX' were registered, including 'MOX', 'UMOX', and 'IDIMOX'.

29. By taking into account the following: the administration of the drug only in the injection form and, therefore, only by doctors or nurses trained in veterinary medicine; the use of the impugned mark only in relation to veterinary drugs at present; the statutory prescription regarding packaging; the existence of many registered marks with the element 'MOX'; and the fact that most pharmacies in India do not combine human and animal drugs, I conclude that there is no likelihood of deception or confusion provided a condition is imposed that the mark should not be applied to products for human consumption. I am not inclined to endorse the conclusion of the IPAB, in this regard, in *Ranbaxy Laboratories and Solvay and Cie*.

30. For reasons discussed above, the conclusion of the Registrar on the fundamental issue of likelihood of confusion among



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the public also calls for interference. Consequently, the impugned order is set aside and it is directed that the appellant's mark "INIMOX" shall be registered subject to the condition that the mark shall be used only in respect of products intended for veterinary use and shall not be used in relation to pharmaceutical products intended for human use.

31. (T) CMA(TM) 72 of 2023 is allowed on the above terms without any order as to costs.

08.12.2023

Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No

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SENTHILKUMAR RAMAMOORTHY J.

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Pre-Delivery Judgment made in

(T) CMA (TM) No.72 of 2023

08.12.2023