

* IN THE HIGH COURT OF DELHI AT NEW DELHI

% Date of decision: 18th April, 2023

+ C.O. (COMM.IPD-TM) 146/2022

MANKIND PHARMA LIMITED Petitioner
Through: Mr.Hemant Daswani and Ms.Saumya
Bajpai, Advocates.

versus

ARVIND KUMAR TRADING AND ANR. Respondents
Through: None

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. The present petition has been filed seeking cancellation/removal of the impugned trademark 'NIKIND' (word *per se*), registered under no.2290683 in Class 5 in the name of the respondent no.1, from the Register of Trade Marks.
2. Briefly, the case set up in the petition is that the petitioner company is engaged in the business of manufacturing and marketing medicinal, pharmaceutical and veterinary preparations. The mark "MANKIND" was adopted in the year 1986 by the predecessors of the petitioner.
3. The petitioner has more than 150 trademarks registered wherein the word "MANKIND" and/or "KIND" forms a part of its trademarks (hereinafter referred to as 'family of marks'). The petitioner is also the proprietor of the mark 'MANKIND' in all 45 Classes. A list of 133 marks belonging to the "KIND" family of marks registered in favour of the

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petitioner has been given at page 239 of the petition. The petitioner is also the owner of the various websites which include the word “MANKIND”.

4. The petitioner has also filed CA Certificate showing a turnover of the petitioner company in the year 2016-2017 of about Rs.3525.91 crores. The turnover of the petitioner company in respect of products sold under its “KIND” family of marks for the period April, 2017 to October, 2017 was approximately Rs.843 crores. The petitioner’s family of marks have been advertised in various newspapers, magazines and news channels across India.

5. On account of long usage of the mark “MANKIND” and/or “KIND” family of marks, the said marks have acquired the status of ‘well-known trademark’ in terms of Section 2(1)(zg) of the Trademarks Act, 1999 (hereinafter referred to as ‘the Act’).

6. The petitioner came across the registration of the mark “NIKIND” (hereinafter referred to as ‘impugned trademark’) vide registration no. 2290683 in respect of medicines for human purpose in class 5 in India. The application for registration of the impugned trademark was filed on 28th February, 2012 claiming user from 25th November, 2011. A cease and desist notice was issued upon the registered proprietor of the said mark, which was not replied to.

7. It has been averred that due to long and continuous usage of the trademark “MANKIND” and family of marks containing the word “KIND”, the petitioner has acquired goodwill and reputation along with the public exclusively associating the trademark “MANKIND” and family of marks containing the word “KIND” with the petitioner.

8. The petitioner has registration of the mark “NIMEKIND” in Class 5 in its favour vide certificate of registration dated 28th September, 2005. The impugned trademark is similar to the petitioner’s similar registered mark “NIMEKIND” and family of marks containing the word “KIND” and therefore, the mark is liable to be removed in terms of Section 11 (1) and (2) of the Act.

9. The impugned trademark is liable to be removed for ‘non-use’ in terms of Section 47 (1) (a) and (b) of the Act, as upto three months before the date of application, a continuous period of five years from the date of registration has elapsed, during which period there has been no *bonafide* use of the impugned trademark in relation to goods for which the registration was granted.

10. The petitioner is also prior user and owner of the mark “MANKIND” and family of marks containing the word “KIND” and the impugned trademark has been wrongly entered in the Register and therefore, is liable to be cancelled in terms of Section 57 of the Act.

11. Accordingly, the petitioner has filed the present petition.

PROCEEDINGS IN THE CASE

12. Notice in the present petition was issued by the Intellectual Property Appellate Board (IPAB) on 1st November, 2018. However, the respondent no.1 failed to appear before IPAB despite service. Thereafter, due to the enactment of the Tribunals Reforms Act, 2021, the matter has been placed before this Court and notice was issued to the respondent no.1 by this Court on 1st November, 2022. None has appeared on behalf of the respondent no.1 despite service, nor any reply/counter-statement has been filed on behalf of the respondent no.1. It is indicative of the fact that the respondent no.1 has

nothing substantial to put forth on merits, by way of a response to the averments made in the petition.

ANALYSIS

13. Counsel for the petitioner has placed reliance on the judgments of a Co-ordinate Bench of this Court in its own case, ***Mankind Pharma Ltd. v. Cadila Pharmaceuticals Ltd.***, 2015 SCC OnLine Del 6914. Paragraph 19 of the aforesaid judgment is set out below:

“19. In this context, the submission of the learned counsel for the plaintiff that registration of his trade mark ‘MANKIND’ for the sale of pharmaceutical products and the plaintiff admittedly having several other registrations either with the prefix or suffix to the word ‘KIND’ and although the ‘KIND’ admittedly has no co-relation with the sale of the pharmaceutical products, the plaintiff having established his first user of the word ‘KIND’ in the pharmaceutical market, the ratio of this judgment entitles him to a higher protection for the word ‘KIND’ is an argument which has force. In the instant case the plaintiff is using the word ‘KIND’ with the prefix ‘MAN’ since the year 1986; his registration for the mark ‘METROKIND’ is of the year 2003. The defendant cannot copy the essential/predominant part of the trade mark of the plaintiff which in this case is ‘KIND’ as admittedly the plaintiff has a registration for the trade mark ‘MANKIND’ from the year 1986 and for ‘METROKIND’ since the year 2003 and at the cost of repetition the plaintiff being the prior user in the market of the word ‘KIND’ for sale of pharmaceutical products stands established by him.”

14. The petitioner has several registrations granted in its favour with the prefixes to the word “KIND” and hence, has developed a family of marks with the word “KIND” as an essential part of the petitioner’s trademarks. Although, the word “KIND” is not related to the products being sold by the petitioner, but due to its long and extensive usage it has come to be

exclusively associated with the petitioner and this would entitle the petitioner to a higher protection for the “KIND” family of marks. Merely changing the first part of the mark by use of the distinguishing family ‘name’ (i.e., “KIND” in the present case) or characteristic is likely to cause confusion both in trade and in the mind of public.

15. The adoption and the use of the impugned trademark ‘NIKIND’ by the respondent no.1, which is very similar to the trademark ‘NIMEKIND’ of the petitioner, is likely to create confusion in the market. Not only is the trademark of the respondent no.1 confusingly/deceptively similar to the petitioner’s prior adopted, registered, trademark ‘NIMEKIND’ or family of marks of the petitioner but the nature of the goods of the petitioner and the respondent no.1 are identical i.e., medicines for human purpose falling in Class 5. It is clear that the adoption of the said mark by the respondent no.1 is with the sole purpose of trading upon the goodwill and reputation of the petitioner. The mark of the respondent no.1 is also likely to deceive unwary consumers of its association with the petitioner. Therefore, the aforesaid registration in favour of the respondent no.1 could not have been granted in terms of Section 11(1) and 11(2) of the Act and is liable to be cancelled under Section 57 of the Act.

16. Respondent has failed to rebut the contention of the petitioner that the impugned trademark was registered without any *bonafide* intention on the part of the registered proprietor to use the same in relation to the products covered by the registration and there has been no use of the impugned trademark in relation to the products upto a date of three months before the date of the rectification application. Hence, the mark is liable to be removed in terms of Section 47(1)(a) of the Act.

17. Respondent has failed to rebut the contention of the petitioner that upto a date of three months before the date of the rectification application, a continuous period of five years and longer has expired from the date on which the impugned trademark was registered, during which there was no use of the impugned trademark in relation to the goods covered by registration and therefore, the mark is liable to be removed from the Register under Section 47(1)(b) of the Act.

18. Accordingly, the present petition is allowed and the impugned trademark registered under trademark application no.2290683 in the name of the respondent no.1 in Class 5 is removed from the Register of Trade Marks.

19. The Registry is directed to supply a copy of the present order to the Trademark Registry, at e-mail - llc-ipo@gov.in for compliance.

APRIL 18, 2023

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AMIT BANSAL, J.

