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(T) CMA (TM) No.32 of 2



IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 05.07.2024

Pronounced on: 26.07.2024

CORAM:

THE HON'BLE MR.JUSTICE P.B.BALAJI

(T) CMA (TM) No.32 of 2023

USV Limited,
B.S.D. Marg,
Govandi,
Mumbai – 400 088.

.. Appellant

..Vs.

1.M/s.Aurobindo Pharma Limited,
248/3RT, I Floor,
Sanjeeva Reddy Nagar,
Hyderabad – 500 038.

2.The Assistant Registrar of Trade Marks,
Intellectual Property Building,
G.S.T.Raod, Guindy,
Chennai – 600 032.

.. Respondents

Prayer: This appeal came to be numbered by transfer of IPAB Case OA.No.59/2013/TM/CHN from the file of the Intellectual Property Appellate Board, Chennai praying that the Order dated 22.05.2013 passed by the 2nd respondent herein rejecting appellant's opposition MAS-197899 to 1st respondent's Application No.636437 in Class 5 for registration of the mark ENRIL and/or to stay the operation and effect of the registration certificate for trademark bearing No.636437 in Class 5 pending final



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disposal of the appeal.

For Appellant : Mr.T.D.Selvan Babu

For Respondents : Mr.P.V.Balasubramaniam,
Senior Counsel for
Mr.Rahul M.Shankar for R1
Mr.M.Karthikeyan,
Senior Panel Counsel for R2

J U D G M E N T

The present appeal arises against the order of the Deputy Registrar, Trade Marks in Opposition No.MAS-197899, dismissing the said Opposition Application.

2. I have heard Mr.T.D.Selvan Babu, learned counsel for the Appellant and Mr.P.V.Balasubramaniam, learned Senior Counsel for Mr.Rahul M. Shankar, learned counsel for 1st respondent and Mr.M.Karthikeyan , learned Senior Panel Counsel for the second Respondent.

3. Mr.T.D.SelvanBabu, learned counsel for the Appellant would attack the order of the 2nd Respondent on the following grounds:



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a) The Appellant is the proprietor of a registered Trademark, **NURIL** in Class 5 and has been enjoying the registration from **1984** onwards.

b) The 1st Respondent without any justification, has proposed to use for the first time the mark **ENRIL**.

c) The names **NURIL** and **ENRIL** are phonetically very similar and there is a high chance of confusion being caused.

d) Both the Appellant's as well as 1st Respondent's medicines are in tablet form and therefore there is a higher risk of confusion.

e) The 1st Respondent has not even able to establish even an honest adoption of the mark, **ENRIL**.

f) The 1st Respondent has not even produced a drug license or even a Chartered Accountant's Certificate to show good presence in the market.

g) Sections 9(1)(a) and 9(2)(a) read with Section 11 (1)(b) of the Trademarks Act, 1999 read together clearly set out that even a likelihood of causing confusion is sufficient and the 2nd Respondent clearly fell in error in dismissing the Opposition Application of the Appellant.

h) Section 13(b) also creates a legal bar for registration of the 1st Respondent's mark.



4. The learned counsel for the Appellant, Mr.Selvan Babu, in support of his contentions, would also place reliance on the following decisions:

4(i). *National Sewing Thread Company Limited v. James Chadwick and Brothers Limited*, reported in (1953) 1 SCC 794, where the Hon'ble Supreme Court held that the real question to decide in such cases is to see 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*.

4 (ii) *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*, reported in (2001) 5 SCC 73, where the Apex Court held that the courts need to be particularly vigilant where the Defendant's drug, of which passing off is alleged, is meant for curing the same ailment as the Plaintiff's medicine, but the compositions are different.

4 (iii). *Eco Learn Research & Development A/S v. Intellectual*



Property Appellate Board and another, reported in 2011 (4) CTC 689, where a Division bench of this Court held that one of the tests to be applied while considering the question of deceptive similarity is to take note of the goods to which they are to be applied and nature and kind of customers, who would likely buy the goods and while examining an application, Sections 9 and 11 of the Act, the Registrar has to keep in mind that the statute enjoins upon him a duty to safeguard the rights created under the Act and to give effect to such rights.

4 (iv). *Rhizome Distilleries Pvt. Ltd. v. Union of India and others,* reported in 2015-5-LW-501, where the Division Bench of this Court held that IMPERIAL GOLD and IMPERIAL BLUE were similar, considering the nature of product and the kind of customer and that the resemblance was likely to deceive a consumer, who is a man of average intelligence and imperfect recollection.

4 (v). *Sun Pharma Laboratories Ltd. v. Mylan Laboratories and another,* reported in 2023 SCC OnLine Del 4661, the Delhi High Court, extracted *McCarthy on Trademarks and Unfair Competition, IV Edition 2007* and held that a Court should not engage in ‘technical gymnastics’ in



an attempt to find minor differences between conflicting marks but weigh the similarities and differences against one another to see which is predominate.

4 (vi). *Amritdhara Pharmacy v. Satya Deo Gupta*, reported in 1962 *SCC Online SC 13*, where the Hon'ble Supreme Court held that what degree of resemblance is necessary to deceive or cause confusion must in the nature of things be incapable of definition a priori and that the overall similarity between two names in respect of same description of goods was likely to cause deception or confusion within the meaning of the relevant provisions of the Act.

4 (vii). *Corn Products Refining Co. v. Shangrila Food Products Ltd.*, reported in 1959 *SCC OnLine SC 11*, where the Apex Court held that it is well recognised principle, that has to be taken into account in considering the possibility of confusion arising between two trademarks, that, where those marks contain a common element which is also contained in a number of other marks in use in the same market such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those features.



4 (viii). *Express Bottlers Services Private Ltd. v. Pepsico Inc & others*, reported in 1988 SCC Online Cal 62, where the Apex Court held, dealing with public juries, mere neglect by owner of the mark to challenge the infringement or proceed against the infringers does not necessarily constitute abandonment when it is in respect of infringements which are not sufficient to affect the distinctiveness of the mark, even if the proprietor is aware of them.

4 (ix). *Sohan Lal Nem Chand Jain v. Trident Group & others*, reported in 2011 SCC OnLine Del 4272, where the Delhi High Court held that when the defendant himself had applied for registration of the trademark, it does not lie in the mouth of defendant to contend that the mark is generic in nature.

4 (x). *TSI Engineering Industries Private Limited and another v. C.R.I. Amalgamations Private Limited*, reported in 2019 SCC OnLine Mad 28312, this Court held that similarities alone have to be taken into account and not the dissimilarities of the mark in deciding whether there is likelihood of deception or causing confusion.



4 (xi) *Glenmark Pharmaceuticals Ltd. v. Gleck Pharma (OPC) Pvt.*

Ltd. and others, reported in 2024 SCC OnLine Bom 1660, the Bombay High Court held that the Defendant not giving an explanation for adoption of the impugned mark would show that the intention of the Defendant was to adopt a mark deceptively similar to the Plaintiff's mark.

4 (xii). *Neon Laboratories Ltd. v. Themis Medicare Ltd.*, reported in 2014 SCC OnLine Bom 1087, the Bombay High Court held that the issue whether a Defendant can take a plea of a mark or a prominent feature of the mark being common to trade when the Defendant himself applied for registration is no longer *res integra* and that a form of estoppel by conduct applies to such a Defendant, who is not allowed to approbate and reprobate.

4 (xiii). *Boots Company, PLC, England and another v. Registrar of Trade Marks, Mumbai and another*, reported in 2002 (2) Mh.L.J 834, where the Bombay High Court held that CROFEN and BRUFEN were deceptively similar on applying the three tests viz., a) the mark has to be considered as a whole, b) it is a question of first impression and c) the question has to be considered from the view point of a man of average intelligence.



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5. The learned counsel for the Appellant would also place reliance on the list of International Non Proprietary Names (INN) in which ENALAPRIL is included and he would submit that ENRIL is only an abbreviation of ENALAPRIL and hence there is a legal bar for the 1st Respondent to adopt the said trademark. The learned counsel for the Appellant would therefore pray for the appeal being allowed.

6. Per contra, Mr.P.V.Balasubramaniam, learned Senior Counsel appearing for Mr.Rahul M. Shankar, learned counsel for the 1st Respondent would primarily submit,

a) It is not a case of infringement or passing off but only pertaining to the role of the Registrar;

b) The general acceptable practice is to name the product based on the ailment or the organ that it treats;

c) The 1st Respondent is not a fly by night Company, but one of the largest manufacturers in the world;

d) Though the Appellant, in its notice of opposition claimed to be a well known mark, the same has not been declared and hence such a



contention is not available to be canvassed.

e) ENRIL and NURIL are not phonetically similar and the Appellant has not even filed any material to show whether there is visual similarity;

f) There are as many as 19 marks ending with RIL for which additional document was brought on record with the permission of this Court and hence RIL being *publici juris*, the 1st Respondent is entitled to use it;

g) Both the drugs are Schedule and prescription drugs which cannot be sold without a prescription;

h) The INN list was not placed before the 2nd Respondent and being a document of fact, it cannot be relied on at this appellate stage;

i) The Appellant has not made out any case in any of the Section 9, 11 and 13 of the Trademarks Act, 1999; and,

j) The Registrar has followed the law and has not committed any error warranting interference by this Court.

7. The learned Senior Counsel for the 1st respondent would also place reliance on:

7(i) *Ariane Orgachem Private Limited v. Wyeth Employees Union and*



others, reported in (2015) 7 SCC 561, where the Apex Court held that a pure question of law can be raised at any stage.

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7(ii). *Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd.*, reported in (1997) 4 SCC 201, where the Apex Court held that the object of the Trademarks Act, as indicated in the Statement of Objects and Reasons is to 'enlarge the field of registrability' and in deciding an Opposition Application, the questions of infringement or passing off or even defensive registration do not arise.

7 (iii). *F.Hoffmann-LA Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd.*, reported in (1969) 2 SCC 716, where the Apex Court held that it is not necessary that it should be intended to deceive or intended to cause confusion but it is its probable effect on ordinary kind of customers that one has to consider. The Court further held that in both *Dropovit* and *Protovit*, the common suffix VIT indicates that they are vitamin preparations and are both descriptive and common to trade and the marks when compared as a whole, only show that the words are so dissimilar and there is no reasonable probability of confusion between the two marks.



7 (iv). *Cadila Laboratories Ltd. and another v. Dabur India Limited*, reported in 1997 SCC OnLine Del 360, where the Delhi High Court held that the importance of the prefix of the word should be given due weightage where the suffix is common.

7 (v). *Astrazeneca UK Ltd. and another v. Orchid Chemicals & Pharmaceuticals Ltd.*, reported in 2006 SCC Online Del 1668, the Delhi High Court held that when the non-descriptive words in two trademarks cannot be slurred over in pronunciation, there is no reasonable possibility of confusion.

7 (vi). *Schering Corporation & others v. Alkem Laboratories Ltd.*, reported in 2009 SCC OnLine Del 3886, the Delhi High Court held that in the trade of drugs, it is a common practice to name a drug on the basis of the name of the active chemical compound or salt, or the disease it seeks to remedy, or the particular organ it is intended to treat.

7 (vii). *Sun Pharma Laboratories Ltd. v. Intas Pharmaceuticals Ltd.*, reported in 2020 SCC OnLine Del 59, the Delhi High Court held that when the Respondent's trademark has been derived by combining *publici-juris*



and added a suffix, there was no prima facie case made out for grant of an interim injunction restraining the Respondent from using its trademark.

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7(viii). *Apex Laboratories Ltd. v. Zuventus Health Care Ltd.*, reported in 2006 SCC OnLine Mad 1238, a Division Bench of our Court held that when both the medicines are preparations from Zinc and Zinc being common to trade, it falls within the domain of *publici juris* and the Appellant could not claim ownership over the word and that it would be dangerous to split the word into two and grant an injunction merely because both the trade names contain the word 'zinc'.

7 (ix). *Sun Pharmaceuticals Industries Ltd. and another v. Nirma Limited and another*, this Court, in C.S.No.735 of 2011, judgment dated 03.08.2021, held that where a part of the mark is either descriptive or common to trade, greater regard has to be had to the un-common element in the two marks and in view of the recognised practice of the pharma industry, a part of the name of a generic drug could be used by a manufacturer in his product, without being guilty of infringement.

8. The learned Senior Counsel would therefore seek for dismissal of



the appeal.

9. I have carefully considered the rival submissions made on either side. I have also gone through the relevant documents placed before me, by way of a typed set and also the impugned order of the 2nd Respondent, besides the catena of judgments relied on, by the learned counsel on either side.

10. Admittedly, both the Appellant's drug, NURIL as well as the 1st Respondent's drug, ENRIL are schedule drugs which cannot be purchased across the counter in a pharmacy, except by production of a Doctor's prescription. The Appellant's drug intends to treat diabetic patients, whereas the 1st Respondent's drug is for intended use in blood pressure and other related conditions.

11. It is also not in dispute that the Appellant is a prior user in point of time, the trademark NURIL and the 1st respondent, proposed to use ENRIL much later and was also granted registration in Application No.636437 for ENRIL.



12. It is seen that both the Appellant's drug as well as the 1st Respondent's drug, though treating different diseases, contain *Enalapril Maleate*, which justifies the coining of both NURIL as well as ENRIL with a common suffix, RIL.

13. The 2nd Respondent has held that though the rival goods are of same description, they were not similar and hence proceeded to reject the Opposition Application of the Appellant.

14. The learned Counsel for the Appellant would also contend that the 2nd Respondent has not discussed anything in the impugned order in order to arrive at the decision that the 1st Respondent's claim has to be upheld even under Section 9 of the Act.

15. As held in the various decisions listed and discussed hereinabove, when there is a common suffix or prefix, the focus has to necessarily be on the un-common part of the word and of course, the trademark has to be compared as a whole and cannot be dissected to see similarities or dissimilarities.



16. Admittedly, RIL is a common and identical suffix in both the trade names. The 1st Respondent, by way of production of additional document, has brought on record to show that there are more than one and a half dozen medicines ending with RIL. The ratio laid down in the above cases clearly bar the Appellant from claiming any monopoly over RIL which certainly has become *publici-juris*. The learned counsel for the Appellant has seriously objected to this argument even being put forth in the absence of being pleaded in the opposition proceedings by way of reply.

17. In this regard, I have seen the claims made by the Appellant in the opposition petition as well as the reply of the 1st Respondent to the same.

18. Testing the two words, ENRIL and NURIL, as already discussed, RIL is common to both marks and neither the Appellant nor the 1st Respondent can claim any monopoly over the same, when it is descriptive of the drug, Enalapril used in both the drugs. The notice of opposition has been issued in 2005 and the Appellant claimed that they have been in the market right from 1990 onwards, the trademark NURIL having been



registered even in 1984 and that the 1st Respondent's mark is visually, phonetically and structurally similar and therefore there is undoubtedly cause for deception and confusion; adoption of the mark NURIL by the 1st respondent is not honest and only to trade upon the goodwill and reputation acquired by the Appellant; confusion would lead to disastrous consequences being goods sold as medicines; the Appellant's trademark is a well known trade mark; registration of the 1st Respondent's mark is contrary to Sections 9, 11, 12, 18, 21(5) and 33 of the Act.

19. In response to the above referred notice, the 1st Respondent has replied stating that their adoption of the mark ENRIL is lawful; the marks are different both visually as well as phonetically; the claims made by the Appellant were all false, misleading and stoutly denied.

20. Though there is no specific plea regarding RIL having become *publici juris* in the reply to the notice of opposition, the fact remains that RIL is common to the trade, viz., medicinal field, the Appellant cannot claim any statutory protection over it. The law is well settled that the trademark is as to the mark as a whole and splitting or dissecting the word is



not permissible. EN and NU being the distinguishing portions, are phonetically different and there is no possibility of even a slur leading to any confusion or deception. No doubt, the Hon'ble Supreme Court has time and again cautioned that when it comes to a dispute in trademarks relating to medicines, Courts have to be extra cautious as any slightest chance of confusion might have serious, irreversible health hazards, even leading to loss of lives. But at the same time, the test to be applied is whether there is any similarity either visually or phonetically which is likely to cause even the slightest confusion amongst users. The fact that both the medicines are Schedule drugs which can be purchased by a patient/user only on production of a medical prescription also cannot be ignored. Though the law is equally settled that this alone cannot be a ground to decide, this factor also has its own significance and has to be kept in mind while deciding the issue, alongside other material tests. In an application of this nature, the burden is only on the Appellant who intended to oppose the registration of the 1st Respondent's trademark, to prove that the impugned mark is similar and is likely to cause deception and confusion.

21. In this regard, the claim of the Appellant regarding its growth is



also one factor that cannot be brushed aside. The 1st Respondent's mark has been granted registration in 2005 itself. The opposition petition filed in July, 2005 was also dismissed in 2013, as against which the present appeal has been preferred. There is no order of any interim stay granted in favour of the Appellant. Thus, it is evident that the 1st Respondent's ENRIL has been in the market for close to 2 decades. Firstly, the Appellant who claims that there is every likelihood of confusion and deception, has not been able to even demonstrate a single instance where the 1st respondent's ENRIL has been sold instead of the Appellant's NURIL, especially in the last close to 20 years. Secondly, the claim of the 1st Respondent attempting to sail under the Appellant's trademark is also not established and even by the Appellant's own showing their business has grown leaps and bounds over the years, beginning 1st March 1990 to 2004 at least, just prior to the opposition petition being filed. If really, by riding on the goodwill of the Appellant, the 1st Respondent has passed off its trademark as that of the Appellant, there is bound to be an adverse effect on the sales of the Appellant, which is admittedly not the case of the appellant themselves. When the 1st respondent has been using the mark ENRIL at least from 2002 onwards, the Appellant ought to have discharged the burden of proof on it,



by establishing its claims of opposition by producing sufficient as well as satisfactory evidence on record.

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22. The Appellant has also not taken any effort to show any visual similarity between the two competing marks. The Appellant, as discussed hereinabove, has also not proved that there has been deception or confusion caused because of similarity in the names, NURIL and ENRIL or that the 1st Respondent's adoption of the trademark ENRIL was not honest and only to sail on the reputation and goodwill of the trademark of the Appellant, NURIL. In fact, the Appellant, though claimed that its mark is 'well known mark', has not been able to show any declaration to such effect, either by the authority under the Act or any Court of law, which is a mandatory pre-requisite for a claim of a 'well known' mark.

23. The Delhi High Court in *Astrazeneca UK*'s case, (referred herein supra) has held that though the fact that prescription or scheduled drugs cannot be purchased without a medical prescription, is no longer a valid test for affording protection to a trademark, it is still an available ground, though not the sole ground any longer. In fact after the decision of the Hon'ble Supreme Court, in *Cadila*, (referred herein supra), there has been a marked



shift in assessing cases pertaining to pharmaceutical cases.

24. The Apex Court also in *Amritdhara's* case, (referred herein supra) has held that the Act does not lay down any criteria for determining what is likely to deceive or cause confusion and that every case must depend on its own particular facts, and the value of authorities lies not so much in the actual decision as in the tests applied for determining what is likely to deceive or cause confusion.

25. Therefore, having consciously applied the settled principles enunciated by the various Courts, viz., the tests to be applied for finding out whether there is a cause of any likely confusion, the facts of this case, I find that 2nd Respondent has not committed any patent error or mistake in rejecting the Appellant's Opposition Application.

26. With regard to the submission of the learned counsel for the Appellant that the 2nd Respondent has not even discussed Section 9 of the Act, the 2nd Respondent has concluded that in view of findings arrived at in respect of Section 11, the claim of the 1st Respondent was being upheld even in respect of Section 9. Section 11 deals with relative grounds of



refusal of registration and Section 9 deals with absolute grounds for refusal of registration. Section 9(1)(a) deals with trademarks which are devoid of any distinctive character and not capable of distinguishing the goods or services of one person from those of another person. Section 9(2)(a) deals with marks which are of such nature as to deceive the public or cause confusion. Section 11(1)(b) also deals with similarity to an earlier trade mark only. The specific case of the Appellant is that there is deceptive similarity which is likely to cause confusion. In the backdrop of such a specific case put forth by the Appellant, there is certainly an element of overlapping between Sections 9 [Sec.9(1)(a) & 9(1)(b)] and Section 11 (Sec.11(1)(b)]. It is not the case of the Appellant that any other limb of Section 9 is attracted to the facts of the present case. Thus, I do not find any infirmity in the conclusion arrived at by the 2nd Respondent.

27. Section 13 of the Act was also contended and raised by the learned counsel for the Appellant against the 1st Respondent. Section 13 prohibits registration of names of chemical elements or international non-proprietary names. Though this ground was not taken by the Appellant either in the opposition proceedings or in the grounds of appeal, even



assuming that it can be entertained and pressed into service, I see no merit in the said contention that there is a statutory bar for the 1st Respondent in adopting NURIL. The prohibition is only for the word being verbatim sought or requested for registration and not an abbreviation or coined term/word. Even according to the Appellant, as seen from the list of International Non-Proprietary Names (INN) extracted from the Trade Marks Registry, India, the non-proprietary name which is prohibited is the name of the chemical, ENALAPRIL alone and not ENRIL which is only its abbreviation and coined name. There is no prohibition under Section 13 to use an abbreviation of the prohibited International Non-proprietary Names (INN) and therefore I am unable to countenance the argument of the learned counsel for the Appellant in this regard.

28. I also do not find Section 18 coming in the way of the 1st Respondent's registration of its trademark, ENRIL. An application can be made by a person, for registration, even if the person only proposes to use and it is not necessary for such person to show actual use. In any event use of the mark is not a pre-requisite for registration, especially while testing or deciding an opposition petition. The extent of use would have a bearing



only in cases of infringement and passing off and not in an application before the Registrar, in an Opposition Application.

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29. From the foregoing discussions, I see no justifiable grounds to interfere with the findings and conclusions arrived at by the second Respondent, which are also in my considered opinion, reasoned as well as well founded.

30. In fine, the Appeal is dismissed. However, there is no order as to costs.

26.07.2024

Index : Yes/No
Speaking/Non-speaking order
rkp

To
The Assistant Registrar of Trade Marks,
Intellectual Property Building,
G.S.T.Road, Guindy,
Chennai – 600 032.



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(T) CMA (TM) No.32 of 2



P.B.BALAJI,J.

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**Pre-delivery Judgment in
(T) CMA (TM) No.32 of 2023**

26.07.2024