



(T)CMA(TM) No.44 of 2023
(OA/37/2014/TM/CH)

WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 20.02.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(TM) No.44 of 2023
(OA/37/2014/TM/CH)

Alkem Laboratories Limited
having its address at
"Alkem House", Devashish
Adj. to Matulya Centre
Senapati Bapat Marg
Lower Parel, Mumbai - 400 013

... Appellant

Vs.

1.Orchid Healthcare (A Division of
Orchid Chemicals and Pharmaceuticals
Limited)
having its office at
Orchid Towers
No.313, Valluvar Kottam High Road
Nungambakkam, Chennai - 600 034

2.The Assistant Registrar of
Trade Marks, office of the Trade Mark Registry
Branch at Chennai
IPR Building, G.S.T. Road, Guindy
Chennai - 600 032

... Respondents



(T)CMA(TM) No.44 of 2023
(OA/37/2014/TM/CH)

Prayer : Civil Miscellaneous Appeal filed under Section 91 of the Trademarks Act, 1999 (a) to set aside the order of the Assistant Registrar of Trade Marks, passed in Opposition No.MAS-255468 and communicated vide Letter Serial No.TOP/1484 dated 21/09/2012 and allow the opposition filed by the appellant against the respondent No.1; the respondent No.1 be asked to bear the cost of this proceeding under the provisions of Rule 19 of Intellectual Property Appellate Board (Procedure) Rules, 2003 read with paragraph (d) of Sub Section (2) of Section 92 of the Trade Marks Act, 1999 on the ground that (i) the Respondent No.1 has knowingly and deliberately with dishonest intention in bad faith adopted the impugned mark which is closely, confusingly and deceptively similar to the prior adopted and used trade mark of the appellant in relation to medicinal and/or pharmaceutical preparations and, (ii) the respondent No.1 filed the impugned application in total disregard to the guidelines laid down by the Hon'ble Supreme Court with regard to registration of trade marks in relation to pharmaceutical preparations in Class 05 with a view to avoid causing any confusion/deception among consumers; and (c) pending the hearing the final disposal of this appeal, direct the Trade Mark Registry not to use the registration certificate.

For Appellant : Mr.R.Sathish Kumar
for M/s.Vishesh Associates

For Respondent : Mr.C.Kulanthaivel,
Central Govt. Standing Counsel for R2
No Appearance for R1



WEB COPY



(T)CMA(TM) No.44 of 2023
(OA/37/2014/TM/CH)

JUDGMENT

The appellant herein challenges the order of the second respondent dated 31.08.2012 rejecting its opposition to the registration of the word mark 'TAXTAM' for which the first respondent had sought registration under Class 5, for pharmaceutical products. The appellant has its registered word mark, which reads 'TAXIM' in the same class. This was registered in the year 1988 by the appellant.

2. When the first respondent's mark came to be published in the Trademark journal, the appellant herein entered its opposition. The second respondent, then proceeded to comply with the other procedural requirements and passed the impugned order, wherein she listed at least six grounds for rejecting the opposition of the appellant and they read as below:

- 1. Both the packing of the marks are different in their own way and not similar to each other;*
- 2. Usage of both the medicines are different from each other; one is for general use and the other one is*



(T)CMA(TM) No.44 of 2023
(OA/37/2014/TM/CH)

specifically for pediatric use which is used for children below the age of 5 years;

- 3. Difference in price of both the medicines are very vast;*
- 4. One is injectable and the other one is dry syrup;*
- 5. One is Cefotaxime and Sulbactam for injection and the other one is Cefxime Oral Suspension IP; and*
- 6. Further, regarding the similarities of TAXTAM and TAXIM-O, I do not agree with the arguments of opponent's counsel that both the marks are phonetically as well as visually similar. Both are entirely different from each other.*

This is now under challenge.

3. The first respondent's name is printed in the cause list. This court is also informed that the first respondent is facing certain proceedings under the Insolvency and Bankruptcy Code and notice had been taken to the Interim Resolution Professional.

4. The learned counsel for the appellant submitted that when the appellant opposed the registration of first respondent's word mark 'TAXTAM', the basis



(T)CMA(TM) No.44 of 2023
(OA/37/2014/TM/CH)

for the objection was that it was visually and phonetically deceptively similar to the mark of the appellant. However, the second respondent had spent her time listing out six grounds, not one of which is focused on making a visual or a phonetical comparison between both the marks.

5. Relying on the authority in ***Cadila Healthcare Ltd Vs Cadila Pharmaceuticals Ltd*** [(2001) 5 SCC 73], the learned counsel for the appellant submitted that the grounds, on which the second respondent had rejected the appellant's opposition runs contrary to the ratio in the aforesaid authority of the Hon'ble Supreme Court.

6. Heard the learned counsel for the appellant and the standing counsel for the respondent.

7. This court perused the papers and also the authority reported, which the learned counsel for the appellant has relied on. Since both the marks are word marks, and since the first respondent's mark do not display any features to distinguish it otherwise, this court took upon itself to compare both the marks



(T)CMA(TM) No.44 of 2023
(OA/37/2014/TM/CH)

for their phonetical and visual similarity. Except one vowel i.e. 'i' being replaced with the consonants 'ta', the mark of the appellant is similar to the mark of the first respondent. Indeed, it may have to be stated that even in its application, the first respondent has disclosed that it only proposes to use the said mark for its pharmaceutical products. In these circumstances, this court has no hesitation to set aside the the order of the second respondent and directs the second respondent to rectify the Trademark Register accordingly.

8. In fine, this appeal is allowed and the order of the second respondent dated 21/09/2012 made in Opposition No.MAS-255468 and communicated vide Letter Serial No.TOP/1484, is set aside. The second respondent/Assistant Registrar of Trademarks, is now required to rectify the Trademark Register accordingly. However, there is no order as to costs.

20.02.2024

Asr

Index: Yes/No

Speaking Order / Non-Speaking Order

Neutral Citation: Yes / No



WEB COPY



(T)CMA(TM) No.44 of 2023
(OA/37/2014/TM/CH)

To
The Assistant Registrar of
Trade Marks, office of the Trade Mark Registry
Branch at Chennai
IPR Building, G.S.T. Road, Guindy
Chennai - 600 032



WEB COPY



(T)CMA(TM) No.44 of 2023
(OA/37/2014/TM/CH)

N. SESHASAYEE, J.

Asr

(T)CMA(TM) No.44 of 2023
(OA/37/2014/TM/CH)



WEB COPY



(T)CMA(TM) No.44 of 2023
(OA/37/2014/TM/CH)

Dated : 20.02.2024