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(T) CMA (TM) No.61 of 2



IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 20.06.2024

Pronounced on: 19.07.2024

CORAM:

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

(T) CMA (TM) No.61 of 2023

Sanofi-Aventis Deutschland GmbH,
(earlier known as Aventis Pharma Deutschland GmbH)
50, Bruningstrasse 65926 Frankfurt am Main
Germany
Address for Service n India:
Remfry & Sagar
Remfry House at the Millennium Plaza,
Sector 27, Gurgaon – 122 009.

.. Appellant

..Vs.

1.Jagdale Industries Private Limited,
I No.782, 15th Cross, I Phase,
JP Nagar, Bangalore – 560 078.

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.20/2016/TM/CHN from the file of the Intellectual Property Appellate Board, Chennai praying that the Order dated 19.02.2016 of the second respondent be set aside/quashed; thereby rejecting Application No.948893 of the first respondent and allowing Opposition No.MAS-



717277 of Appellant.

For Appellant : Mr.Vijay Narayan,
Senior Counsel for
Mr.Abishek Jenasenan
For Respondents : Ms.Anchal Nichani for R1
Mr.K.Subbu Ranga Bharathi,
Senior Panel Central Government
Standing Counsel for R2

J U D G M E N T

The present appeal arises against the order of the Assistant Registrar, Trade Marks in Opposition No.MAS-717277 to Trade Mark Application No.948893, dismissing the Opposition application.

2. I have heard Mr.Vijay Narayan, learned Senior Counsel for Mr.Abishek Jenasenan, learned counsel for the Appellant and Ms.Aanchal Nichani for the first respondent and Mr.K.Subbu Ranga Bharathi, Senior Panel Central Government Standing Counsel for the second Respondent.

3. Mr.Vijay Narayan, learned Senior Counsel would contend that the 2nd Respondent has rejected the opposition of the Appellant on three grounds, viz., 1) the Appellant's mark 'CARDACE' is phonetically different from the 1st Respondent's mark, 'CALDALE'; 2) both the products are used for different purposes, i.e. to treat different diseases, and 3) the Appellant's



medicine cannot be obtained without a medical prescription.

4. Mr.Vijay Narayan would submit that the Appellant as well as the 1st Respondent are in the pharmaceutical line and while the Appellant's drug has been registered way back in the year 1988, the 1st Respondent had applied with the tag '*proposed to be used*' only in the year 2000. He would further state that the Appellant's drug seeks to control blood pressure in diabetic patients, the 1st Respondent's drug is a calcium supplement.

5. Mr.Vijay Narayan, learned Senior Counsel would further contend that 'CARDACE' and 'CALDALE' are phonetically very similar and both are Schedule-H drugs as well as sold in tablet form and there is therefore very high chance of confusion arising. He would also submit that the first syllable "CA" is the same and there is high possibility of the second syllable 'DA' being misread or mispronounced, in which case, the consequences would be disastrous. He would also further submit that even while prescribing the medicines, there is a big risk of 'L' and 'C' being misread and being a very big internationally reputed company, the Appellant cannot take the slightest chance of any disrepute being brought upon them as a result of the confusion that is very likely to arise because of the 1st Respondent's drug being very similar, phonetically and also for the other



reasons set out hereinabove.

6. The learned Senior Counsel would further submit that when it comes to medicines, Courts have always been more cautious in permitting names that are deceptively similar because the confusion may even result in life threatening consequences or have serious health impacts. He would therefore submit that even when there is a slightest confusion, the Courts have to step in and he would therefore pray for the appeal being allowed.

7. In support of his contentions, the learned Senior Counsel would also place reliance on the following leading decisions:

7(a). *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*, reported in (2001) 5 SCC 73, where the Apex Court deciding an issue relating to the two marks, “FALCIGO” and “FALCITAB” held that even though both the drugs were sold under prescription would not alone be a ground to prevent confusion and that public interest would support a lesser degree of proof showing confusing similarity in the case of a trade mark in respect of medicinal products as against non-medicinal products.

7(b). *Milmet Oftho Industries and others v. Allergan INC*, reported in (2004) 12 SCC 624, where the Hon’ble Supreme Court was dealing with a case where the trademark, ‘OCUFLOX’ was sought to be passed off, held



that in medicinal products, exacting judicial scrutiny was required if there was a possibility of confusion over the marks as the potential harm may be far more dire than that in confusion over ordinary consumer products.

7(c). *Novartis AG v. Crest Pharma Pvt. Ltd. and another*, reported in 2009 SCC OnLine Del 4390, where the Delhi High Court held that even if products of the Plaintiff are available in tablet and oral suspension form and defendant's product is available only in injection form, it would not matter when it came to confusion and deception arising out of deceptively similar mark.

7(d). *Charak Pharma Pvt. Ltd. v. Glenmark Pharmaceuticals Ltd.*, reported in 2014 SCC OnLine Bom 98, where the Bombay High Court, in a clash between trademarks, "ECONOVA" and "EVANOVA", held that the marks were deceptively similar and wrong administration of drug would lead to disastrous consequences.

7(e). *Sun Pharma Laboratories Limited v. BDR Pharmaceuticals International Pvt. Ltd. and another*, reported in 2020 SCC OnLine Del 623, where the Delhi High Court held that for deceptive resemblance, two important questions would arise and that they are i) who are the persons whom the resemblance must be likely to deceive or confuse and ii) what rules of comparison are to be adopted in judging whether such resemblance



exists. The Court held that “*LABEBET*” and “*LULIBET*” where phonetically, structurally or visually similar.

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7(f). *Unimed Technologies Limited v. Cadila Healthcare Limited and another*, reported in 2022 SCC OnLine Mad 2956, this Court held that the marks “ZYVISC” and “HYVISC” are phonetically similar and even if there was a plea of ‘not mala fide’ use, it would not be a valid defence to the charge of infringement and passing off.

7(g). *Sun Pharmaceuticals Industries Ltd. v. DWD Pharmaceuticals Ltd.*, reported in 2022 SCC OnLine Del 4015, dealing with the marks, “FOLZEST” and “FORZEST”, the Court held the said marks to be deceptively similar with the only difference being in the alphabet “R” being replaced by ‘L’ and further held that in a medicinal good, the right of not only the private litigants but also public interest has to be kept in mind.

7(h). *Glenmark Pharmaceuticals Ltd. v. Sun Pharma Laboratories Ltd*, reported in 2024 SCC OnLine Del 2707, the Delhi Court held that the marks “ISTAMET” and “INDAMET” meet the test of structural and phonetic similarity and mere existence of slightest possibility of confusion in respect of drugs would be sufficient for judicial intervention in order to completely obviate the possibility of an error or mistake.

7(i) *Pfizer Products Inc. v. Renovision Exports Pvt. Ltd. and another*,



reported in 2024 SCC OnLine Del 3140, where the High Court, while holding that the marks, “VIAGRA” and “VIGOURA” are deceptively similar, further held that when goods are being sold to the same segment of consumer, the confusion between the two marks is most probable.

8. Per contra, Ms.Aanchal Nichani, learned counsel for the 1st Respondent, rebutting the submissions of the learned Senior Counsel, Mr.Vijay Narayan, would state that the 1st Respondent’s promoter is Jagdale and has been in the business right from 1994 onwards. She would further submit that there is no similarity between the two trade marks and there is no likelihood of any confusion arising. She would further contend that a microscopic comparison or dissection of the marks cannot be made especially when both the Appellant’s as well as the First Respondent’s drugs are Schedule-H drugs which cannot be sold without a prescription. She would further contend that the ‘L’ is very prominent in ‘CALDALE’ and there is no possibility of overlap at all when both the alphabets ‘R’ and ‘L’ are very dissimilar not confusing. This apart, she would also state that there is a duty cast on the consumer also and even mere remote similarity can never be a decisive factor when even the target audience was totally different, with the Appellant catering to blood pressure in diabetic patients



while the 1st Respondent's drug is basically a calcium supplement. She would further state that the 1st Respondent has been using the drug right from 2007 onwards and there has been no confusion at all. Finally, she would submit that the order of the 2nd Respondent is a speaking order and all the contentions advanced by the learned Senior Counsel, Mr.Vijay Narayan have been appropriately dealt with and hence there is no necessity to interfere with the well considered order of the 2nd Respondent.

9. In support of her contentions, Ms.Aanchal Nichani would also place reliance on the following decisions:-

9(a) *Schering Corporation and others v. Getwell Life Sciences India Pvt. Ltd.*, reported in *MANU/DE/0921/2008* where the Delhi High Court, referring to a judgment of the Division Bench of the Delhi High Court, in *Astrazeneca UK Ltd. and another v. Orchid Chemicals & Pharmaceuticals Ltd.*, reported in *2007 III AD(Delhi) 430* observed that in the trade of drugs, it is common practice to name a drug by the name of the organ or ailment which it treats or the main ingredient of the drug and held that "TEMODAL" and "TEMODAR" were not identical or phonetically or visually similar with "TEMOGET".

9(b). *F.Hoffman-la Roche & Co. Ltd. v. Geoffrey Manner & Co. Pvt.*

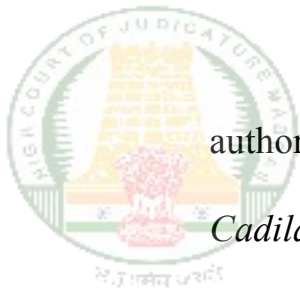


Ltd., reported in *MANU/SC/0302/1969* where the Hon'ble Supreme Court held that the marks have to be compared as a whole and it is not right to take a portion of the word and the true test is to see whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade. The Apex Court affirmed the decision of the High Court holding that “DROPOVIT” and “PROTOVIT” are not deceptively similar in nature.

10. Ms.Aanchal Nichani, learned counsel for the Respondent, for all the above reasons, would therefore, pray for dismissal of the appeal.

11. I have considered the submissions advanced on either side. I have also gone through the impugned order of the 2nd Respondent as well as the documents that have been filed by way of a typed set. I have also kept the settled legal principles enunciated in the various decisions set out hereinabove, in mind while proceeding to discuss the merits and demerits of the appeal.

12. In fact on going through the various authorities on which reliance is placed on by the learned Senior Counsel, what emerges is that the leading



authority on the issue of trade mark registration and opposition is that of the *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*, reported in (2001) 5 SCC 73. Several subsequent judgments look up to *Cadila* in deciding cases relating to medicinal drugs or products.

13. The Hon'ble Supreme Court in *Cadila's* case, at paragraph 35, laid down various factors to be considered for deciding the question of deceptive similarity, in an action for passing off, on the basis of an unregistered trade mark. I deem it fit to extract the same, for easy reference:

“(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.

(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect of which they are used as trademarks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods.

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.”

14. At paragraph 36, the Apex Court further held that weightage is to



be given to each of the aforesaid factors depending on facts of each case and the same weightage cannot be given to each factor in every case.

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15. At the outset, I am conscious of the fact that the above factors were set out in a passing off action and not in trade mark opposition application before the Registrar. At the same time, the above factors are certainly available for consideration in a case of an opposition of a trade mark on the ground that the mark is similar or deceptively similar.

16. The competing marks in the present case are 'CARDACE' of the Appellant and 'CALDALE' of the 1st Respondent. There is no quarrel between the parties that both the trademarks are medicinal drugs and that they are also both Schedule-H drugs which cannot be sold without a doctor's prescription.

17. The learned Counsel for the 1st Respondent would submit that the founder of the 1st Respondent is Jagdale and it is pronounced as 'Jagdaley' and the 'dale' has been added to 'Cal' being a part of calcium and the new word Cardale (pronounced Cardaley) has been coined by the 1st Respondent and therefore no similarity whatsoever. To this argument, Mr.Vijay



Narayan, learned Senior counsel would rightly respond stating that this argument was never put forth before the 2nd Respondent and even otherwise, the rejection of the opposition application of the Appellant was also not on this ground. I am, therefore, unable to countenance the said argument of the learned counsel for the 1st Respondent that the pronunciation of the 1st Respondent's trademark is totally dissimilar, being pronounced 'Cardaley', even though the said argument appears to be attractive and also possible, at first blush.

18. I now proceed to discuss the other submissions advanced before me.

19. It is not disputed that the Appellant's drug is dealing with the heart (blood pressure control in diabetic patients) and hence they have adopted "CAR" and added 'DACE' to it and registered their trademark, 'CARDACE'. The 1st Respondent, on the other hand, deals with calcium supplements, and therefore they have adopted 'CAL' and added it to 'DALE' to coin "CALDALE".

20. The parties have got their respective trademarks duly registered

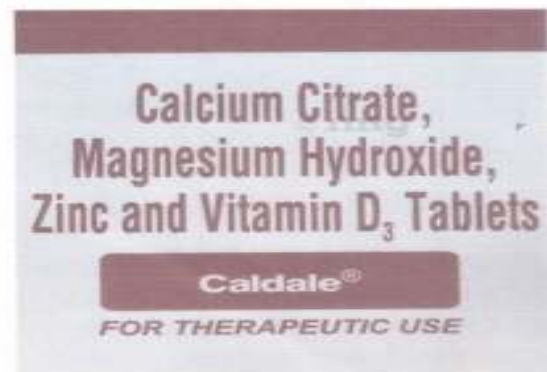


under the same Class 5 as well.

21. Now, applying the tests laid down and enunciated by the Courts, starting from Cadila, to the facts of the present case,

21(a). The competing marks are not identical.

21(b). There is also no visual similarity or deception in the trademark adopted by the 1st Respondent when compared with the Appellant's trademark. (Colour photostat copies of both the medicines was also produced before me and they are reproduced hereunder, though in black and white:





21(c). The issue therefore narrows down to whether the drugs are phonetically similar and whether there is any likelihood of confusion being caused or not. Even if there is any remote similarity and slightest of confusion arising, then the Appellant is bound to succeed in the appeal, in view of settled legal position by a catena of decisions holding that in medicinal products, the test to be applied is different from the test applicable to usual or ordinary consumer products. The reason for this is that in the case of any mistake arising out of any confusion, however slightest it may be, the consumer, rather patient might end up not taking the medicine he ought to take or consume a medicine which he ought not to take, in both scenarios, the risks are extremely not only high but also dangerous as it might lead to irreversible health complications and also may be life threatening as well. In such view of the matter, judicial scrutiny that is required is of a much higher degree to ensure that even the remotest possibility of a confusion should be avoided as it might lead to disastrous consequences.

21(d). Though the Appellant's registered mark is CARDACE, as seen from the medicine sold in the pharmacies, the name of the medicine is CARDACE 5.



22. In the above backdrop, let me test whether any degree of phonetic similarity exists and whether the same is likely to cause even the slightest confusion. Even if the drugs are pronounced as CAR DACE and CALDALE, first impression being the best impression, I do not find even the remotest of phonetic similarity between the two. The alphabets 'R' and 'L' are pronounced very differently and therefore there is no possibility of any overlap, even giving concessions to any slur or different pronunciations by different persons/consumers/patients. Moreover, even to a person dispensing the drugs at the store, not only is he trained to give the correct medicines in line with the prescription, he would also be basically aware of the facts that anything to do with the heart is pronounced CAR as in cardiac and there is a sea of difference when CAL from calcium is pronounced. There is also no similarity in ACE and ALE with "C" and "L" being very dissimilar and distinct from each other. Even the words, tested as a whole, CARDACE and CALDALE are not phonetically similar and there is not even a remote possibility of a mistake or confusion arising. Moreover, the addition of 5 (notifying 5mg of Ramipril contained in the drug) besides CARDACE clearly sets it apart from CALDALE. I am therefore unable to countenance the argument of the learned Senior Counsel, Mr. Vijay Narayan that the first part CA being phonetically same and identical, there is a strong



chance of misreading or even mispronouncing. Moreover, both the marks are associated with distinct purposes, viz., controlling blood pressure in diabetic patients and the other being only a calcium supplement. Therefore, I do not find any similarity in order to cause confusion amongst the consumers, especially taking into account that both these drugs address totally different purposes and both being prescriptive drugs.

23. Though Mr.Vijay Narayan, learned Senior Counsel would also contend that there is even a likelihood of a doctor's handwriting being misread and CARDACE being read as CALDALE, I am unable to agree with his contentions in this regard as, the alphabets R and L especially are written very differently (in both upper and lower cases) and they are key distinguishing factors in both the marks. Moreover, the end product of the Appellant, though registered mark is CARDACE, is only CARDACE-5 and therefore there is absolutely no chance of a pharmacist or chemist misreading the doctor's prescription and giving CALDALE in its place.

24. Yet another argument of Mr.Vijay Narayan, learned Senior Counsel is that the 1st Respondent is 'Juggat Pharma' and the 2nd Respondent grossly erred in holding that the name of the 1st Respondent



was Jagdale and hence adoption of the CALDALE was honest and bona fide. I am however not impressed by this argument for the simple reason that the Appellant had taken out CMP (TM) No.5 of 2023 where they themselves have gone on record admitting the fact that the 1st Respondent had filed a Form TM-P for amendment of the name before the Registrar from Juggat Pharma (A pharma division of Jagdale Industries) to Jagdale Industries Private Limited and based on the said application of the Appellant, this Court also ordered amendment of the name of the 1st Respondent. Therefore, having clearly acquiesced itself of the name of the 1st Respondent, before and after amendment, it is not open to the Appellant to subsist with this ground at this stage.

25. That apart, I also find a lot of force in the submission of the learned Counsel for the 1st Respondent, Ms.Aanchal Nichani, that the 1st Respondent has been selling CALDALE right from 2007 onwards, after getting a registration and there has been no confusion whatsoever, for the last close to 2 decades. The very object of the opposition of the Appellant was only that the 1st Respondent's drug was similar, in fact deceptively similar to its drug, CARDACE. Though the Appellant filed its opposition application way back in 2008, by then, in 2007 the 1st Respondent's drug



was in the market already and close to 15 years now, the Appellant has not been able to show even a single instance of a mistake or confusion having arisen anywhere, leading to the 1st Respondent's drug, CALDALE being sold instead of the Appellant's drug, CARDACE. This is, in my, considered opinion, a very relevant factor that requires favourable consideration in favour of the 1st Respondent.

26. Here, the argument of the learned Counsel for the 1st respondent that there is a degree of care to be exercised by the consumer also assumes a good deal of significance. These drugs, both the Appellant's as well as the first Respondent's are not sold over the counter but only on prescription. Therefore, even at the end of the pharmacy or chemist selling the drug to the consumer there is a check and the persons who are issued licences to sell medicines also need to have certain basic qualifications and therefore it is not as if carelessly, CALDALE will be sold for CARDACE. In fact, we also have to bear in mind that post Cadila's verdict in 2001, we have taken giant strides in technology and many of the hospitals and doctors have even started issuing computerised or digital prescriptions and the days of the Doctor writing the prescription by hand are also a fast decline. These also have to be kept in mind while deciding cases of this nature. Law also has to



change in order to keep pace with change and be in tune with times.

Therefore, when the Appellant has not even made an attempt to cite even a solitary instance of confusion or mistake, it only leads to a logical conclusion that both CARDACE and CALDALE have been in the market from 2007 onwards and there has been no occasion of any confusion or mistake all these long years.

27. Let me now deal with the decisions that have been relied on both sides.

28. I have already culled out the ratio and principles laid down in the various cases even while setting them out as part of the submissions made on either side.

29. In *Cadila's* case, (referred herein supra) the Apex Court was dealing with a case where both the parties to lis were selling their respective drugs, which was a treatment for malaria only. Moreover, one of the parties did not even hold a registered trademark and an action of passing off was before the Apex Court. However, in our case, both the parties have a registration of their respective marks under Class 5 and therefore, the facts



of the case before the Supreme Court were on an entirely different footing.

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30. At the same time, I bear it in mind that it is in this verdict that the Apex Court laid down guidelines or determinative factors to be considered in cases of deception and similarity. All these guidelines are applicable even today. However, even the Apex Court clarified in the very next paragraph that the applicability of the various factors would depend on the facts of each case.

31. In *Milmet Oftho's* case, (referred herein supra) the mark was identical and hence the ratio laid down in those facts may not be applicable here.

32. In *Unimed's* case, (referred herein supra) both the parties were using the same suffix and both the medicines were only in connection with ophthalmology.

33. In *Glemnark's* case, (referred herein supra) what weighed with the Court was the identical suffix, like in *Unimed's* case. In *Novartis's* case, (referred herein supra) the Court found the marks to be phonetically similar.



Suffice to state that each case lays down the law for the facts of the case before it. However, if the ratio laid down in any particular set of facts can be applied to the facts of the present case, then there is no difficulty in following the ratio already laid down. In fact, even in *Sun Pharmaceutical's* case, (referred herein supra) the Court ultimately found on facts that the marks were not deceptively similar. Thus, as cautioned by the Apex Court, in *Cadila's* case, weightage to be given to the determinative factors depends on facts of each case. Even in *Amritdhara Pharmacy v. Satya Deo Gupta*, reported in *AIR 1963 SC 449*, the Apex Court observed 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.

34. There can be no second opinion with regard to confusion as to even prescriptive drugs when likely, would cause potential harm and injury to the consumer and therefore it is of paramount importance to ensure that there is not even the slightest of confusion likely to occur or take place. Only keeping this cardinal principle in mind, I have tested the competing marks and for all the foregoing discussions and reasons, I do not see even a remote possibility or the slightest confusion being caused on account of the



1st Respondent's registered mark CALDALE being allowed to remain in the register of trademarks. I am of the considered opinion that the registered mark of the 1st Respondent does not qualify as 'nearly resembling the mark of the Appellant as to be likely to deceive or cause confusion.

35. In fine, I see no justifiable grounds to interfere with the findings and conclusions arrived at by the second Respondent, which I also find to be well founded and reasoned. The Appeal is therefore dismissed. However, there is no order as to costs.

19.07.2024

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.61 of 2



P.B.BALAJI,J.

rkp

**Pre-delivery Judgment in
(T) CMA (TM) No.61 of 2023**

19.07.2024