



2024:DHC:7590



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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**% ***Date of decision: 28th August, 2024***+ **C.O. (COMM.IPD-TM) 409/2022****MANKIND PHARMA LTD. 208, OKHLA INDUSTRIAL ESTATE,
PHASE-III, NEW DELHI**PetitionerThrough: **Mr. Hemant Daswani, Ms. Saumya
Bajpai, Ms. Pranjal, Advocates
(M:9810556744)**

versus

**MANOJ KUMAR M/S NOVAKIND BIOSCIENCES, S. 15/10,
16/10, IST FLOOR, T.P. NAGAR, KANPUR ROAD, LUCKNOW,
UP**RespondentThrough: **None.****CORAM:****HON'BLE MS. JUSTICE MINI PUSHKARNA****MINI PUSHKARNA, J (ORAL)**

1. The present petition has been filed seeking cancellation/removal of the impugned trademark 'GYNOKIND', registered under no. 2076029 on 28th December, 2010, under Class 5, in the favour of the respondent no.1, from the Register of Trade Marks.

2. Facts of the case, in brief, are as follows:

2.1 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.

2.2 The petitioner has 45 registrations in their favour for the mark, 'MANKIND' in all the 45 classes. Further, the petitioner has registered for



154 marks in various classes wherein the word ‘KIND’ forms part of their trademarks.

2.3 The petitioner is the owner of various websites and extensively sells more than 100 different products all across the country, wherein, the word ‘KIND’ forms part of the trade mark, with an annual audited turnover of Rs. 3,525.56 Crores in the year 2016-17.

2.4 The petitioner has advertised its products in various newspapers, magazines, billboards, including, advertisements in national television, thereby, investing a substantial sum of money to promote sale of its products, businesses and their various trademarks.

2.5 The petitioner came across the registration of respondent no. 1’s mark, i.e. ‘GYNOKIND’ which is registered under registration no. 2076029 in respect of medical preparation under Class 5 in India. The application for registration of the impugned trademark was filed on 28th December, 2010 on a ‘*Proposed To Be Used Basis*’. The petitioner upon knowledge of the said mark, served upon respondent no. 1, a cease-and-desist notice, which was never replied to.

2.6 The present petition was initially filed before the erstwhile Intellectual Property Appellate Board (“**IPAB**”), and was subsequently transferred to this Court upon abolition of the IPAB. None appeared for the respondent when the matter was taken up for hearing. This Court notes that none has been appearing on behalf of the respondent for the last many dates. In these circumstances, this Court has proceeded to hear the present matter, by taking into account the case as made out by respondent no. 1, in their counter reply dated 03rd April, 2023.

3. The submissions made on behalf of petitioner, are as follows:



3.1 Due to the long and continuous usage of the trademark 'MANKIND' and the family of marks containing the word 'KIND', the petitioner has acquired a goodwill and reputation along with the public exclusively associating the trademark 'MANKIND' and family of marks containing the word 'KIND' with the petitioner.

3.2 The petitioner has several registrations granted in its favour with the word 'KIND' forming part of it, therefore, the petitioner has developed a family of marks with the word 'KIND' as an essential part of the petitioner's trademarks.

3.3 Even if the respondent no. 1's mark cannot be said to be infringing any mark of the petitioner individually, nevertheless, the use of the impugned mark by respondent no. 1 still amounts to infringement of the family of marks under the doctrine of family of marks.

3.4 The petitioner is the prior user of the mark since 1986, with prior use for the words 'MANKIND' and the 'KIND' family of marks, whereas, the respondent no. 1's mark being registered in 2010, that also on a '*proposed to be used basis*' was wrongly registered and therefore, is liable to be cancelled in terms of Section 57 of the Trade Marks Act, 1999.

3.5 The impugned trademark is liable to be removed for 'non-use' in terms of Section 47 (1) (a) and (b) of the Trade Marks Act, 1999, 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 *bona fide* use of the impugned trademark in relation to goods for which the registration was granted.

3.6 The present respondent no. 1 has already been enjoined for the usage of their mark, 'NOVAKIND' vide order dated 22nd September, 2022 in a



trademark infringement suit titled *Mankind Pharma Limited Versus Novakind Biosciences Private Limited*, CS (COMM) 188 of 2021. The appeal filed by the respondent against the aforesaid order dated 22nd September, 2022 was also dismissed by the Division Bench vide order dated 05th October, 2023 in *FAO(OS)(COMM) 212/2023*.

4. The case as put forth on behalf of respondent in its counter reply, is as follows:

4.1 Respondent along with various trademarks, in the year 2010 applied for the mark 'GYNOKIND' after due public search and the mark was adopted after due consideration and in all honesty after due diligence.

4.2 The mark 'GYNOKIND' has been used by the respondent since 2011 continuously and uninterruptedly. Further, the respondent has had an overall turnover of Rs. 1,59,17,711/- since 2011.

4.3 The respondent no. 1's mark, 'GYNOKIND' is visually, structurally and aurally distinct from that of the petitioner's mark, 'MANKIND', and therefore, has rightly been accepted and registered by the Registrar of Trade Marks. Furthermore, the word 'KIND' is a generic word which falls under the definition of Section 30 of the Trade Marks Act, 1999, thus, no protection can be sought for the said word.

4.4 When two marks under scrutiny are to be compared and where parts of the marks are similar, the comparison must be made of the prefixes and suffixes. In the present case the word 'KIND' is common for both the parties, therefore, the comparing prefixes 'MAN' and 'GYNO' are to be considered, which are neither similar phonetically, structurally or visually.

5. Having heard learned counsel for the petitioner and having perused the record, at the outset, this Court notes that the petitioner has several



registrations granted in its favour with the prefixes to the word 'KIND'. Thus, the petitioner has developed a large portfolio of more than 300 related marks, with the word 'KIND', as an essential part of the petitioner's trademarks, which are spread over all 45 classes under the Trademarks Act, 1999.

6. It is noted that marks in relation to the pharmaceutical sector, require a higher degree of scrutiny. Comparison of the mark 'MANKIND' of the petitioner and 'GYNOKIND' of the respondent clearly manifests that ordinary consumers and general public are bound to get confused into believing that the drugs manufactured by the respondent, emanate from the petitioner, owing to the common 'KIND' suffix. 'At the end of the day, the guiding principle is that, where medicines are concerned, even the slightest possibility of confusion cannot be permitted, and that, therefore, drugs- especially prescription drugs- have to be clearly distinguishable from one another.' (*See: Mankind Pharma Limited Vs. Novakind Bio Sciences Private Limited, DHC Neutral Citation No.- 2023:DHC:5653*)

7. It is noted that both parties have their marks registered under Class 5 in relation to goods that are pharmaceutical products. Adoption and use of the mark 'GYNOKIND' by the respondent, is likely to cause confusion, as the same is deceptively similar to the petitioner's mark 'MANKIND'. It is clear that the respondent has intentionally and deliberately intended to reap commercial benefit from the goodwill and reputation enjoyed by the mark of the petitioner.

8. A Coordinate Bench of this Court in the case of *C.O. (COMM.IPD-TM) 257/2022* titled as *Mankind Pharma Ltd. Versus Gurinder Singh*, vide



order dated 02nd May, 2024, while discussing the petitioner's rights in the 'KIND' family of marks, held as follows:

“xxx xxx xxx

8. Further, we can also notice that the usage of 'KIND' in both trademarks establishes a conceptual link that could lead consumers to assume a connection between the two brands, particularly due to the established reputation of the Petitioner's 'KIND' family of marks. The addition of the letter 'V' attempts to set the Respondent's mark apart; however, it does not mitigate the phonetic and semantic similarities associated with the use of 'KIND.' These elements, combined with the substantial goodwill associated with the Petitioner's marks, could extend to the 'V-KIND HEALTHCARE' products, particularly if consumers focus more on the shared term than the differing graphical representation. The risk of confusion remains significant due to the prominence of 'KIND' in both marks, especially within the same pharmaceutical industry where specific attributes of products are critically assessed based on textual branding.

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12. It would be relevant to refer to decision of this Court in **Mankind Pharma Ltd. v. Cadila Pharmaceuticals Ltd¹**, which effectively highlights the strong protection awarded to the Petitioner's use of the word "KIND" within its trademarks. The Court recognized that although "KIND" does not inherently relate to pharmaceutical products, the Petitioner has established significant goodwill and market presence since first using "MANKIND" in 1986 and subsequently "METROKIND" in 2003. These actions have developed a distinctive family of marks where "KIND" serves as a central element. This judgment has emphasized that the Petitioner, as the prior user, is entitled to heightened protection against any infringing use that copies the essential or predominant parts of its trademark, affirming the Petitioner's exclusive rights over the "KIND" component within the pharmaceutical industry.

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(Emphasis Supplied)

¹ 2015:DHC:715



9. In light of the above discussion, and considering the fact that the petitioner is the prior user of the mark 'MANKIND', with even an earlier user since 1986 to the family of marks, which include the word 'KIND', it is held that the registration of the impugned trademark 'GYNOKIND' is untenable, and is liable to be cancelled under Section 57 of the Trade Marks Act, 1999.

10. Accordingly, the impugned trademark 'GYNOKIND' registered under no. 2076029, under Class 5 in the favour of the respondent no.1, is hereby cancelled. The Registrar of Trademarks is directed to rectify and remove the aforesaid entry from the Register of Trademarks.

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

12. The present petition is allowed in the aforesaid terms.

MINI PUSHKARNA, J

AUGUST 28, 2024