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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% **Date of decision: 09 August 2024**

\+ FAO(OS) (COMM) 191/2018, CM APPL. 34275/2018 &
CM APPL. 53909/2023

MANKIND PHARMA LTD .....Appellant

Through: Mr. Rajiv Nayar, Sr. Adv. and Mr. Akhil Sibal, Sr.Adv. with Mr. Ankur Sangal, Mr. Ankit Arvind, Mr. Kiratraj Sadana, Ms. Nidhi Pathak, Advs.

versus

CHANDRA MANI TIWARI & ANR .....Respondent

Through: Mr. Sanyat Lodha, Ms. Sanjana Saddy, Advs.

CORAM:
HON'BLE MR. JUSTICE YASHWANT VARMA
HON'BLE MR. JUSTICE RAVINDER DUDEJA

O R D E R

% 09.08.2024

1. The plaintiff/appellant impugns the order dated 06 July 2018 passed by the learned Single judge in terms of which its prayer for grant of temporary injunction has come to be refused. The suit itself had been instituted for the defendant/respondent being restrained from adopting and using the trade name "MERCYKIND PHARMACEUTICAL PRIVATE LIMITED".

2. Shorn of unnecessary details, it appears to have been the case of the plaintiff/appellant that it had adopted "MANKIND" as a trademark in 1986. It is also stated to have applied for registration of that name in Class 05 in 1995 claiming its use since 1986. It further asserts that the plaintiff/appellant is a leading manufacturer in the pharmaceutical business and holds as many as 157 trademarks with the suffix "KIND". It is stated to have revenues for more than INR 4000 crores

and a turnover of INR 7000 crores.

3. It is further averred in the plaint that "MANKIND" was also accorded the status of a well-known trademark. However, the defendant/respondent assert that the Trade Mark Registry declared the same as a well-known trademark vide order dated 14 December 2020 and hence post the institution of the suit.

4. It was alleged that the defendant was initially working with the appellant as a Marketing Manager till he left their employment on 17 January 2015. According to them, the defendant initiated the process for incorporation of a company under the corporate name "MERCYKIND PHARMACEUTICALS PRIVATE LIMITED" on 14 January 2015 and which company came to be incorporated on 17 January 2015. The respondent is stated to have applied for registration of the trademark "MERCYKIND PHARMACEUTICAL" on 20 January 2017. It is only thereafter and once it started using the trade name "MERCYKIND" on its packaging that led to the institution of the suit before this Court.

5. While refusing injunction, the learned Single Judge has firstly taken into consideration the responses which were submitted by the plaintiff/appellant itself before the Trademark Registry and where it was faced with proposed registrations of drugs such as "ATROVAKIND" and "STARKIND". The learned Judge has observed that it was incumbent upon the plaintiff to have made appropriate disclosures in respect of the aforesaid prosecution history while seeking injunction.

6. It then proceeds to note that the defendants are not using the word "MERCYKIND" as a trademark. This observation flowed from

the learned Judge taking into consideration that the goods of the defendants were called "MERCYMOX", "MERCYCOUGH" and "MERCYCOPE". It is in the aforesaid context that it has rendered certain observations with respect to the scope and ambit of Section 29(6) of the **Trade Marks Act, 1999**[1] and the same in one sense being unhinged from the requirements of sub-sections (1) and (4) thereof. The principal grievance was noted by the learned Single Judge as being of the plaintiff questioning the use of the suffix "KIND" by the defendant.

7. As we go through the ultimate findings that have come to be rendered by the learned Single Judge, we note that it has clearly taken notice of the fact that the defendant had applied and filed for registration of "MERCYKIND PHARMACEUTICAL" along with a logo as a trademark. However, it has chosen to desist from rendering any substantive findings since, and as is so recorded in the order, no arguments in that respect appear to have been addressed on behalf of the plaintiff/appellant.

8. Insofar as the question of similarity and likelihood of deception or confusion is concerned, the learned Judge has observed as follows:-

> "O. However, notice can be taken of the fact that pharmaceutical products generally fall in two categories i.e. Over The Counter drugs or prescribed or schedule drugs. Prescribed or schedule drugs cannot be sold except on a prescription of, a qualified medical practitioner. Neither Over The Counter drugs/medicines are known to be asked for by the name of the manufacturer / marketeer thereof nor are the qualified medical practitioners known to prescribe drugs / medicines by the name of their manufacturer / marketeer and are known to prescribe by the name/mark under which the said drugs are sold and which in the case of drugs/medicines of the defendants is not 'MERCYKIND'. In fact, of late, the qualified

[1] Act

> medical practitioners are being instructed to prescribe the schedule / prescribed drugs by their pharmaceutical/generic names and not even by their trade names.
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> P. Thus, mere affixation of the name of the defendant No.2 Company as manufacturer or marketeer of the drugs/medicines sold by the defendants, would in my opinion, not qualify as a use thereof as a trade mark, even under Section 29(6) of the Act."

9. It has ultimately proceeded to observe that once it is found that "MERCYKIND" is not a trademark, the question of Section 29(5) of the Act being violated would not arise.

10. In our considered opinion and in light of the undisputed fact that the plaintiff/appellant had adopted the trademark "MANKIND" way back in 1986, the first issue which clearly merited consideration was that of dishonest adoption. This we observe uninfluenced by the fact that the defendant was an erstwhile employee of the plaintiff appellant company.

11. In our considered opinion, the principles which must govern infringement action in the case of pharmaceutical products are far more stringent than those which may ordinarily be applicable. This aspect was duly highlighted by us in **Glenmark Pharmaceuticals Ltd. vs. Sun Pharma Laboratories Ltd.**[2] where we had observed as follows: -

> "**51.** We at the outset note that the issue which stands raised would have to be examined bearing in mind and at the forefront the stringent, exacting and uncompromising standards which are liable to be adopted when we test an action for infringement or passing off pertaining to competing marks in the pharmaceutical sector as opposed to any other genre of products. It would be pertinent to recollect that in *Cadila Healthcare* the Supreme Court was concerned with the asserted similarity between the brand names "FALCITAB" and "FALCIGO". The Trial Judge had refused interim injunction on the basis that they differed in appearance,

[2] 2024 SCC OnLine Del 2707

formulation and price. The aforesaid order of the Trial Judge was affirmed by the High Court. Although the Supreme Court in *Cadila Healthcare* refused to interfere with the judgment impugned and had disposed of the Special Leave Petition with directions for expeditious conclusion of the trial itself, there were notable observations which came to be rendered and which are of significant import.

52. Indisputably, our courts have consistently held that the question of confusion is essentially one of first impression. It is in the aforesaid backdrop that courts have held that the issue of deceptive similarity has to be answered from the point of view of a man of average intelligence with imperfect recollection. The tests which were propounded in *Re Pianotist Co application*[28] as far back as in 1906 have consistently guided courts in answering issues of deceptive similarity. In *Pianotist* those principles were explained in the following words:

> "You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion—that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods—then you may refuse the registration, or rather you must refuse the registration in that case."

53. It has also been recognized by courts that while a close scrutiny or comparison of the two competing marks may disclose some points of distinction, the question itself is liable to be answered from the point of view of the unwary purchaser and who is unlikely to expend sufficient amount of time examining the marks scrupulously or with a degree of exactness. Yet another precept which precedents require us to bear in consideration is the essential features of a trademark and in such situations marked or slight differences in get-up, packaging or the manner in which the marks are written fading into insignificance. Ultimately a challenge of infringement or passing-off would have to be answered on the anvil of a resemblance so near and unerring that it is likely to deceive or cause confusion.

54. We note that *F. Hoffmann-La Roche* was dealing with the issue of deceptive similarity in the context of usage of the words "DROPOVIT" and "PROTOVIT". While examining the challenge which stood raised, the Court pertinently observed that the question of likelihood of confusion is neither liable to be considered nor answered on a meticulous comparison of two words nor our courts liable to undertake a "*letter by letter and syllable by syllable*" comparison. All of the aforesaid principles, so enunciated, are a reiteration of the underlying precept being of the marks being examined from the gaze of a man of average intelligence and imperfect recollection. In *F. Hoffmann-La Roche* the Supreme Court ultimately came to conclude that the two words were so dissimilar that there existed no reasonable probability of confusion either from a visual or phonetic point of view.

55. However, *Cadila Healthcare* assumes significance insofar as medicines and drugs are concerned in light of the following observations which were rendered:

> **"**21. It will be useful to refer to some decisions of American courts relating to medicinal products. In the case of *American Cynamid Corpn.* v. *Connaught Laboratories Inc*. [231 USPQ 128 (2nd Cir 1986)] it was held as under:
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> > "Exacting judicial scrutiny is required if there is a possibility of confusion over marks on medicinal products because the potential harm may be far more dire than that in confusion over ordinary consumer products."
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> 22. It may here be noticed that Schedule 'H' drugs are those which can be sold by the chemist only on the prescription of the doctor but Schedule 'L' drugs are not sold across the counter but are sold only to the hospitals and clinics. Nevertheless, it is not uncommon that because of lack of competence or otherwise, mistakes can arise specially where the trade marks are deceptively similar. In *Blansett Pharmaceuticals Co.* v. *Carmick Laboratories Inc*. [25 USPQ 2, 1473 (TTAB 1993)] it was held as under:"Confusion and mistake is likely, even for prescription drugs prescribed by doctors and dispensed by pharmacists, where these similar goods are marketed under marks which look alike and sound alike."
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> 23. In the case of *Glenwood Laboratories, Inc.* v. *American Home Products* Corpn. [173 USPQ 19 (1972) 455 F Reports 2d, 1384 (1972)] the Court of the United States had held that:

> "The fact that confusion as to prescription drugs could produce harm in contrast to confusion with respect to non-medicinal products is an additional consideration for the Board as is evident from that portion of the opinion in which the Board stated:'The products of the parties are medicinal and the applicant's product is contraindicated for the disease for which the opposer's product is indicated. It is apparent that confusion or mistake in filling a prescription for either product could produce harmful effects. Under such circumstances, it is necessary for obvious reasons, to avoid confusion or mistake in the dispensing of the pharmaceuticals.'

The board's view that a higher standard be applied to medicinal products finds support in previous decisions of this Court, *Clifton* v. *Plough* [341, F 2d 934, 936, 52, CCPA 1045, 1047 (1965)] ('it is necessary for obvious reasons, to avoid confusion in the dispensing of pharmaceuticals'), *Campbell Products, Inc.* v. *John Wyeth & Bro. Inc*. [143, F 2d 977, 979, 31 CCPA 1217 (1944)] ('it seems to us that where ethical goods are sold and careless use is dangerous, greater care should be taken in the use of registration of trade marks to assure that no harmful *confusion* results')."

24. In the case of *R.J. Strasenburgh Co.* v. *Kenwood Laboratories, Inc*. [106 USPQ 379 (1955)] as noted in the decision of *Morgenstern Chemical Co. case*, it had been held that:"*Physicians* are not immune from confusion or mistake. Furthermore it is common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently handwriting is not unmistakably legible. These facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced."

25. The drugs have a marked difference in the compositions with completely different side effects, the test should be applied strictly as the possibility of harm resulting from any kind of confusion by the consumer can have unpleasant if not disastrous results. 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. The confusion is more likely in such cases and the incorrect intake of medicine may even result in loss of life or other serious health problems. In

this regard, reference may usefully be made to the case of *Glenwood Laboratories, Inc.* v. *American Home Products Corpn.* [173 USPQ 19 (1972) 455 F Reports 2d, 1384 (1972)] where it was held as under:

> "The products of the parties are medicinal and the applicant's product is contraindicated for the disease for which opposer's product is indicated. It is apparent that confusion or mistake in filling a prescription for either product could produce harmful effects. Under such circumstances it is necessary for obvious reasons, to avoid confusion or mistake in the dispensing of the pharmaceuticals."

56. The aforesaid principles as propounded clearly point towards a more exacting and stringent test being adopted when an action of infringement or passing-off comes to be laid in respect of drugs. As was pertinently observed by the Supreme Court in *Cadila Healthcare*, in the case of drugs, the tests to be adopted is that of "*exacting judicial scrutiny*". It was further held that the mere fact that the drug was being sold on the basis of a prescription or dispensed by pharmacists would also not constitute a reliable determinant which would dilute the strict view test as articulated by it while attempting to answer the question of possibility of confusion. This the Supreme Court so held bearing in mind the injurious or detrimental possibilities attendant to an inadvertent purchase, sale and consequential consumption of a drug. It also took into consideration the harmful effect that a usage of a drug may have even though the competing products may be meant for curing an identical ailment. Not stopping at this, the Court also found that notwithstanding the pharmaceutical market being regulated by prescriptions and the dispensation of products being overseen and supervised by trained physicians, those factors would not allay the fears and apprehensions attendant to an incorrect or inappropriate drug being accidentally dispensed. This is evident from the following observations appearing in Paras 27 and 28 of the report:

> "27. As far as the present case is concerned, although both the drugs are sold under prescription but this fact alone is not sufficient to prevent confusion which is otherwise likely to occur. In view of the varying infrastructure for supervision of physicians and pharmacists of medical profession in our country due to linguistic, urban, semi-urban and rural divide across the country and with high degree of possibility of even accidental negligence, strict measures to prevent any confusion arising from similarity of marks among medicines

are required to be taken.

28. Here it will be useful to refer to the decision of *Morgenstern* Chemical *Co. case* where it has been held as under:

> "(5) In the field of medical products, it is particularly important that great care be taken to prevent any possibility of confusion in the use of trade marks. The test as to whether or not there is confusing similarity in these products even if prescribed and dispensed only by professionally trained individuals does not hinge on whether or not the medicines are designed for similar ailments. The rule enunciated by Judge Helen in *Cole Chemical Co.* v. *Cole Laboratories* [DC Mo 1954, 118 F Supp 612, 616, 617, 101, USPQ 44, 47, 48] is applicable here:
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> > 'The plaintiff and the defendant are engaged in the sale of medical preparations. They are for ultimate human consumption or use. … They are particularly all for ailments of the human body. Confusion in such products can have serious consequences for the patient. Confusion in medicines must be avoided.
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> > ***
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> > Prevention of confusion and mistakes in medicines is too vital to be trifled with.'
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> The observations made by Assistant Commissioner Leeds of the Patent Office in *R.J. Strasenburgh Co.* v. *Kenwood Laboratories, Inc*. [106 USPQ 379 (1955)] USPQ 380 are particularly apt, that:'Physicians are not immune from confusion or mistake. Furthermore it is common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently handwriting is not unmistakably legible. These facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced.'
>
> The defendant concedes that physicians and pharmacists are not infallible but urges that the members of these professions are carefully trained to

detect difference in the characteristics of pharmaceutical products. While this is doubtless true to dos (*sic*) not open the door to the adoption by manufacturers of medicines of trade marks or names which would be confusingly similar to anyone not exercising such great care. For physicians and pharmacists are human and in common with the rest of mankind are subject to human frailties. In the field of medicinal remedies the courts may not speculate as to whether there is a probability of confusion between similar names. If there is any possibility of such confusion in the case of medicines public policy requires that the use of the confusingly similar name be enjoined (see *Lambert Pharmacol Ltd.* v. *Bolton Chemical Corpn.* [DCNY 1915, 219 F 325, 326])."

57. More significantly, the Supreme Court proceeded to hold and spoke of a lesser degree of proof being applicable in the case of medicinal products while answering the question of confusing similarity and the same being warranted in order to subserve large public interest. These observations are found in para 32 of the report, which is extracted hereinbelow:

"32. Public interest would support lesser degree of proof showing confusing similarity in the case of trade mark in respect of medicinal products as against other non-medicinal products. Drugs are poisons, not sweets. Confusion between medicinal products may, therefore, be life threatening, not merely inconvenient. Noting the frailty of human nature and the pressures placed by society on doctors, there should be as many clear indicators as possible to distinguish two medicinal products from each other. It is not uncommon that in hospitals, drugs can be requested verbally and/or under critical/pressure situations. Many patients may be elderly, infirm or illiterate. They may not be in a position to differentiate between the medicine prescribed and bought which is ultimately handed over to them. This view finds support from *McCarthy on Trade Marks*, 3rd Edn., para 23.12 of which reads as under:

"The tests of confusing similarity are modified when the goods involved are medicinal products. Confusion of source or product between medicinal products may produce physically harmful results to purchasers and greater protection is required than in the ordinary case. If the goods involved are medicinal products each with different effects and designed for even subtly different uses, confusion among the products caused by similar

marks could have disastrous effects. For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations. The same standard has been applied to medical products such as surgical sutures and clavicle splints.""

58. Equally instructive are the following principles which came to be identified by our Court in *Novartis AG:*

21. I do not accept the submission of the learned counsel for the defendant as I feel that it is more dangerous if the pharmaceuticals products bearing the same mark is used for different purposes for the same ailment or even otherwise. I also do not accept the contention of the defendant's counsel that there would be no confusion if the product contain different ingredients/different salt. In my opinion, it is more dangerous and harmful in the trade if the same trade mark is used for different ailments. The Apex court has already dealt with this proposition of law in the case of *Cadila Healthcare Ltd.* v. *Cadila Pharmaceuticals*, (2001) 5 SCC 73 : (2001) 21 PTC 300 (SC) and held as under:

"25. The drugs have a marked difference in the compositions with completely different side effects, the test should be applied strictly as the possibility of harm resulting from any kind of confusion by the consumer can have unpleasant if not disastrous results. 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 plaintiffs medicine but the compositions are different. The confusion is more likely in such cases and the incorrect intake of medicine may even result in loss of life or other serious health problems. In this regard, reference may usefully be made to the case of *Glenwood Laboratories, Inc.* v. *American Home Products Corp*, 173 USPQ 19 (1972) 455 F. Reports 2d, 1384 (1972), where it was held as under:

"The products of the parties are medicinal and applicant's product is contraindicated for the disease for which opposer's product is indicated. It is apparent that confusion or mistake in filling a prescription for either product could produce harmful effects. Under such circumstances, it is necessary for obvious reasons, to avoid confusion or

mistake in the dispensing of the pharmaceuticals."

> 22. The other argument of the counsel for the defendant that the plaintiffs product is available in tablets and oral suspension form and the defendant's product is available in injection form has also no force as it has been seen from experience of the pharmaceuticals products available in all over the world that most of the companies are making pharmaceuticals products in both the forms i.e. tablets as well as in injection form under the same trade mark. As per well settled law, the actual confusion and deception is not required in order to prove the case of passing, off even if the defendant has adopted the mark innocently and the court comes to the conclusion that the two trade marks are deceptively similar, injunction under the said circumstances has to be granted. Actual deception is not required in an action of passing off. *Century Traders* v. *Roshan Lal Duggar & Co.*, AIR 1978 Del 250 : 1 Supp PTC 720 (Del) (DB). Therefore there is no chance of confusion and deception.

59. As is evident from the aforesaid extracts, our Court found that a difference in ingredients or salts which make up competing pharmaceutical products, would not be aspects which could be said to be germane when it come to the question of likelihood of confusion. It also negated the mode and method of ingestion as well as the form of the competing products. This is evident from para 22 of the report and where the Court held that the fact that the competing products were dispensed either in the form of a tablet or an oral suspension would be wholly irrelevant.

60. We find that the aspect of heightened scrutiny was also emphasized by a Division Bench of the Bombay High Court in *Macleods Pharmaceuticals.*While enunciating the first principles which must be borne in mind, the Bombay High Court in paras 21 and 22 held as follows:

> **"**21. This Court in the decision of *Boots Company Plc, England* (supra) after considering various judgments held that there are three **tests**which have to be considered for deciding the question whether the trade mark is deceptively similar to the other mark or not and they are:—
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> (1) **The mark has to be considered as a whole**,
>
> (2) **It is a question of first impression and**

(3) **The question has to be considered from the view point of a man of average intelligence**.

22. The Delhi High Court in *Win-Medicare Pvt. Ltd.* (supra) after considering the relevant decisions on the question of misrepresentation or deception between two trade marks held that following **Rules of Comparison can be culled out from various pronouncements of the Courts from time to time**:

I. **Meticulous Comparison not the correct way**.

II. **Mark must be compared as a whole**

III. **First Impression**.

IV. **Prima Facie view not conclusive**.

V. **Structural Resemblance**.

VI. **Similarity in Idea to be considered."**

61. The test of "exacting judicial scrutiny", when we are called upon to deal with medicinal products was reiterated and re-affirmed as would be evident from para 23:

23. The Supreme Court in the decision between *Milment Oftho Industries* (supra) after reviewing the law on the subject held as follows:

"8. In respect of medicinal products it was held that exacting judicial scrutiny is required if there was a possibility of confusion over marks on medicinal products because the potential harm may be far more dire than that in confusion over ordinary consumer products. It was held that even though certain products may not be sold across the counter, nevertheless it was not uncommon that because of lack of competence or otherwise that mistakes arise specially where the trade marks are deceptively similar. It was held that confusion and mistakes could arise even for prescription drugs where the similar goods are marketed under marks which looked alike and sound alike. It was held that physicians are not immune from confusion or mistake. It was held that it was common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently the handwriting is not

legible. It was held that these facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike.

(Emphasis added)"

62. After noticing the decision in *Cadila Healthcare*, the Bombay High Court culled out the following principles:

> **"25.** The principles which are emerging from the decisions set out hereinabove are summarised in the following manner:
>
> (a) When a particular medicinal or a pharmaceutical product is involved as the impugned trade mark which may deceive the public or cause a confusion with respect to another trademark, it is the Court's primary duty to take utmost care to prevent any such possibility of confusion in the use of trademarks.
>
> (b) Confusion in case of a non-medicinal or a nonpharmaceutical product may only cause economic loss to the person, but on the other hand, a confusion in terms of medicinal or a pharmaceutical product may have disastrous effect on the health. Hence, it is proper to require a lesser quantum of proof of confusing similarity for such products.
>
> (c) The Court may not speculate as to whether there is a probability of confusion between the marks. Mere existence of the slightest probability of confusion in case of medicinal product marks, requires that the use of such mark be restrained.
>
> (d) While arriving at a conclusion with respect to the similarity and confusion between medicinal products, the same should be examined from the point of view of an ordinary common man of average intelligence instead of that of a specialised medicinal practitioner. Courts must decide the same from the view point of man with average intelligence considering multiple factors such as the first impression of the mark, salient features of both the products, nature of the commodity, overall similarity and the possibility of the same creating a confusion amongst the public at large.
>
> (e) The primary duty of the Court is towards the public and the purity of the register. Duty of the Court must always be

to protect the public irrespective of what hardship or inconvenience it may cause to a particular party whose trade mark is likely to deceive or cause confusion.

(f) The following rules of comparison can be culled out from various pronouncement of Court from time to time.

(i) Meticulous comparison is not the correct way.

(ii) Mark must be compared as whole.

(iii) First impression.

(iv) Prima facie view is not conclusive.

(v) Structural resemblance.

(vi) Similarity in idea to be considered.

(g) The main object of maintaining trade mark register is that the public should know whose goods they are buying. It is therefore essential that the register should not contain the trade mark which is identical by which purchaser may likely to be deceived by thinking that they are buying the goods of a particular company/industry whereas he is buying the goods of another company/industry.""

12. Additionally, we also bear in consideration the judgment rendered by a learned Single Judge in **Mankind Pharma Ltd. v. Novakind Bio Sciences (P) Ltd**[3], and who had explained the scope of Section 29 of the Act in the following terms: -

"**15.** When used for medicinal preparations, the Supreme Court in Amritdhara Pharmacy v. Satya Deo Gupta [Amritdhara Pharmacy v. Satya Deo Gupta, 1962 SCC OnLine SC 13 : AIR 1963 SC 449] , held the marks "AMRITDHARA" and "LAKSHMANDHARA" to be so structurally and phonetically similar as to confuse a customer of average intelligence and imperfect recollection. Mutatis mutandis, it has to be held that the marks "NOVAKIND" and "MANKIND", when used for pharmaceutical preparations, are also confusing, especially as it is not in dispute that the plaintiff uses, for all its products, the suffix "KIND" which has, therefore, become a source identifier of sorts for the plaintiff. Recognising this fact, a Coordinate Bench of this Court has, in fact, in Mankind

[3] 2023 SCC OnLine Del 4806

Pharma Ltd. v. Cadila Pharmaceuticals Ltd. [Mankind Pharma Ltd. v. Cadila Pharmaceuticals Ltd., 2015 SCC OnLine Del 6914 : (2015) 61 PTC 465] , injuncted the defendant, in that case, from using the mark METROKIND, holding the suffix "KIND" to be a dominant feature of the plaintiff's trade marks.

16. The plaintiff has, in its favour, registration of the mark "MANKIND" in every class. Inasmuch as the marks "MANKIND" and "NOVAKIND", even when compared as sole marks, are phonetically deceptively similar, their concluding "KIND" suffix/syllable being the same, the submission of Mr Mahapatra that the plaintiff does not have any registration for the mark "KIND", fails to impress.

17. Moreover, the plaintiff is not pitching its case on infringement merely on the suffix "KIND". The mark "NOVAKIND", even seen as a whole, is phonetically deceptively similar to the mark "MANKIND". The "KIND" suffix not being endemic to pharmaceutical preparations, there is every likelihood of a customer of average intelligence and imperfect recollection, who chances across the defendant's "NOVAKIND" product, to believe it to be one of the KIND family of the marks belonging to the plaintiff. At the very least, therefore, the possibility of an impression of association between the defendant's mark and the plaintiff's mark, in the mind of the customer of average intelligence and imperfect recollection would exist. Such likelihood of association is statutorily sufficient to constitute the infringement within the meaning of Section 29(2)(b) [29. Infringement of registered trade marks.—(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—***(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark;is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.] of the Trade Marks Act, inasmuch as the two marks are deceptively similar and they are used for identical goods. Where similar marks are used for identical goods, and, owing to similarity of the marks and identity of the goods in respect of which they are used, there is likelihood of association of the defendant's mark with the plaintiff's, Section 29(2)(b) categorically holds that a case of infringement is made out.

18. But, submits Mr Mahapatra, Section 29(2)(b) has no application in the present case, as cases where the defendant's mark is used as part of its corporate name have to be examined solely within the peripheries of Section 29(5), and the applicability of

Sections 29(2) to (4) of the Trade Marks Act stand ruled out. He has relied for this purpose, on the judgment of the Full Bench of the High Court of Bombay in Cipla Ltd. case [Cipla Ltd. v. Cipla Industries (P) Ltd., 2017 SCC OnLine Bom 6791 : AIR 2017 Bom 75] .

19. As a legal proposition, and without examining its applicability to the facts of the present case, there can be little doubt that the judgment of the Full Bench of this High Court of Bombay in Cipla Ltd. case [Cipla Ltd. v. Cipla Industries (P) Ltd., 2017 SCC OnLine Bom 6791 : AIR 2017 Bom 75] supports the contention that Mr Mahapatra advances. The Full Bench of the High Court of Bombay in Cipla Ltd. case [Cipla Ltd. v. Cipla Industries (P) Ltd., 2017 SCC OnLine Bom 6791 : AIR 2017 Bom 75] has, indeed, expressed the view that, in the case of marks which are used as part of the corporate name of the defendant, the case would have to be tested on the anvil of Section 29(5) of the Trade Marks Act alone and that Sections 29(2) to 29(4) would have no applicability in such a case.

20. Apart from my own judgment in Novartis AG case [Novartis AG v. Novaegis (India) (P) Ltd., 2023 SCC OnLine Del 1124] , this Court, speaking much earlier through Justice Dr S. Muralidhar (as he then was) has, in Bloomberg Finance LP case [Bloomberg Finance LP v. Prafull Saklecha, 2013 SCC OnLine Del 4159 : (2014) 207 DLT 35] , specifically held that, while Section 29(5) applies in a case where a registered trade mark is used by another person as part of its corporate name, nonetheless, even if it is found on facts that Section 29(5) does not apply, the applicability of the preceding sub-sections (1) to (4) of Section 29 is not ruled out. I may reproduce, for this purpose, Paras 36 and 51 of Bloomberg Finance LP case [Bloomberg Finance LP v. Prafull Saklecha, 2013 SCC OnLine Del 4159 : (2014) 207 DLT 35] and Paras 40 and 41 of Novartis AG case [Novartis AG v. Novaegis (India) (P) Ltd., 2023 SCC OnLine Del 1124] , which speak for themselves, thus:

From Bloomberg case [Bloomberg Finance LP v. Prafull Saklecha, 2013 SCC OnLine Del 4159 : (2014) 207 DLT 35]

> "36. The expression 'mark' has been defined in Section 2(m) of the TM Act to include 'a device brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof'. (emphasis supplied) Therefore, for the purpose of Section 29(4), the use of a mark as part of a corporate name would also attract infringement. In other words, if the registered mark is used by a person, who is not the registered

proprietor of such mark or a permitted user, as part of the corporate name under which he trades then also infringement would also result. What is however important is that the registered trade mark must be shown to have a reputation in India and should be shown to have been used by the infringer 'without due cause'. Further, it should be shown that such adoption or use has resulted in the infringer taking unfair advantage of the registered mark or is detrimental to the distinctive character or repute of the registered trade mark.

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51. The legal position emerging as a result of the above discussion may be summarised as under:

(a) Section 29(5) of the TM Act, 1999 relates to a situation where: (i) the infringer uses the registered trade mark 'as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern'; and (ii) the business concern or trade is in the same goods or services in respect of which the trade mark is registered.

(b) This is in the nature of a per se or a 'no-fault' provision which offers a higher degree of protection where both the above elements are shown to exist. If the owner/proprietor of the registered trade mark is able to show that both the above elements exist then an injunction order restraining order the infringer should straightway follow. For the purpose of Section 29(5) of the TM Act, 1999 there is no requirement to show that the mark has a distinctive character or that any confusion is likely to result from the use by the infringer of the registered mark as part of its trade name or name of the business concern.

(c) However, in a situation where the first element is present and not the second then obviously the requirement of Section 29(5) is not fulfilled. Where the registered trade mark is used as part of the corporate name but the business of the infringer is in goods or services other than those for which the mark is registered, the owner or proprietor of the registered trade mark is not precluded from seeking a remedy under Section 29(4) of the TM Act, 1999 if the conditions attached to Section 29(4) are fulfilled.

(d) Given the object and purpose of Sections 29(1) to (4), Section 29(5) cannot be intended to be exhaustive of all situations of uses of the registered mark as part of the corporate name. Section 29(5) cannot be said to render Section 29(4)

otiose. The purpose of Section 29(5) was to offer a better protection and not to shut the door of Section 29(4) to a registered proprietor who is able to show that the registered mark enjoying a reputation in India has been used by the infringer as part of his corporate name but his business is in goods and services other than that for which the mark has been registered.

(e) A passing-off action is maintainable in the case of a well-known mark even if the goods and services being dealt with by the parties are not similar."

From Novartis AG case [Novartis AG v. Novaegis (India) (P) Ltd., 2023 SCC OnLine Del 1124]

> "40. Adverting, now, to the submissions advanced by Mr Jayant Kumar regarding the various sub-clauses of Section 29 of the Trade Marks Act, I am unable to subscribe with the view that he seeks to espouse. Section 29(5), in my considered opinion, is an additional ground of infringement, apart from the grounds contained in Sections 29(1) to (4). Section 29(5) states that a registered trade mark is infringed by a person who uses such registered trade mark as part of his trade name or part of the name of his business concern, while dealing with goods of service in respect of which the trade mark is registered. Undoubtedly, if a defendant falls within the mischief of Section 29(5), he would be guilty of infringement under that provision. That does not, however, in my mind, dilute, in any fashion, the impact or import of Sections 29(1) to (4). Neither have Sections 29(1) to (4) been made subject to Section 29(5), nor is there any non obstante clause in Section 29(5) which would render the preceding sections subject to it.
>
> 41. Besides, Sections 29(1) to (4) refer to the defendant using a 'mark'. The expression 'mark' is defined in Section 2(1)(m) of the Trade Marks as including 'a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof'. As such, within the broad parentheses of the expression 'mark' are included 'headings', 'names', 'words' and 'letters'. 'NOVAEGIS', even as part of the business name of the defendant is, therefore, a 'mark' as defined in Section 2(1)(m)."
>
> (emphasis supplied)

> **21.** With greatest respect to the Full Bench of the High Court of Bombay, therefore, I would choose to follow the contrary view that this Court has been adopting in such cases."

The aforesaid decision ultimately came to be affirmed by us in **Novakind Bio Sciences Private Limited vs. Mankind Pharma Limited**[4]**.**

13. Although we are informed that during the pendency of the present appeal, the defendant has made significant changes both in its logo and get up of products which are being marketed by it, in our considered opinion, these and other issues which arise would clearly merit consideration afresh by the learned Single Judge.

14. We accordingly allow the instant appeal along with pending applications and set aside the order dated 06 July 2018 passed by the learned Single Judge. The application under Order XXXIX Rule 1 & 2 of the Code of Civil Procedure, 1908 shall consequently stand revived for consideration afresh. All rights and contentions of respective parties are kept open.

15. We request the learned Single Judge to take up application for temporary injunction with due expedition subject to the status of its Roster and the pendency of matters of older vintage.

16. List before the concerned Roster Bench on 27.08.2024.

YASHWANT VARMA, J.

RAVINDER DUDEJA, J.

AUGUST 09, 2024/*neha*

[4] FAO (OS) (COMM) 212/2023