



(T)OP(TM)No.173 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

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DATED : 17.06.2025

CORAM:

THE HONOURABLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM)No.173 of 2023
(ORA/139/2015/TM/DEL)

Sun Pharmaceutical Industries Limited
Acme Plaza, Andheri-Kurla Road,
Andheri (E), Mumbai-400 559.

...Appellant

-Vs-

1.K.Venkateshwara Rao
Trading as M/s.NICSON PHARMA
32-29-5/2/2, Coco Cola Street,
Maruthi Nagar, Vijaywada-520 004.

2.The Registrar of Trade Marks
Intellectual Property Office Building,
Plot No.32, Sector 14,
New Delhi – 110 075.

...Respondents

Prayer: This transfer original petition filed under Sections 9, 11, 12, 18, 47 & 57 of the Trade Marks Act, 1999, praying that this Court be pleased to pass the following order/orders:

- a) That the entry relating to Trademark No.2113639 in class 5 be removed from the Register;
- b) Cost of the proceeding be awarded in favour of the Applicant for Rectification
- c) Such other order or orders this Court consider fit and proper.



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For Petitioner : Mr.S. Diwakar for
for Mr. Rajesh Ramanathan

For R1 : Mr.R.Sathish Kumar

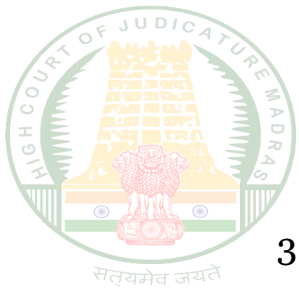
For R2 : Mr. C.Samivel, SPC

ORDER

Background

The first respondent herein applied for the registration of the word mark 'NICSON PHARMA' on 11.03.2011 in class 5 in relation to medicinal and pharmaceutical preparations. The registration certificate was issued in respect thereof on 07.01.2013 under trade mark No.2113639. By this petition, rectification of the entry relating to the above mentioned trade mark by the removal thereof is prayed for by the petitioner.

2. The petitioner is a public limited company incorporated on 01.03.1993 under the corporate name 'SUN PHARMACEUTICAL INDUSTRIES LIMITED'. As the name indicates, the petitioner is engaged in the business of manufacturing and/or marketing medicinal and pharmaceutical products. Upon noticing the trade mark of the first respondent, this petition was lodged before the erstwhile Intellectual Property Appellate Board in November, 2014.



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3. Both the contesting parties opted out of adducing oral evidence and instead proceeded with the matter based on the documents on record.

Counsel and their contentions

4. Oral arguments on behalf of the petitioner were advanced by Mr.S.Diwakar, learned counsel, and on behalf of the contesting respondent by Mr.R.Sathish Kumar, learned counsel.

5. The first contention of Mr.Diwakar is that the petitioner adopted and used the device mark containing a stylized depiction of the word 'SUN' since 01.01.1978. He relied upon the legal use certificate at page 93 of the paper book in this regard. By referring to the legal used certificate in respect of the word mark 'SUN PHARMA', learned counsel submitted that the said mark has been used since 01.01.1993 and that the registration is in class 5. As regards the impugned mark, learned counsel submits that the first respondent has adopted the spelling 'NICSON' instead of 'NIXON' in bad faith inasmuch as 'SUN' has long been associated with the petitioner. He further submits in this connection that the first respondent is using



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the word mark 'NICSON PHARMA' along with a device of the sun.

According to learned counsel, when the mark as used by the first respondent is compared with the petitioner's registered trade mark, it is likely to lead to confusion or deception among the public, including by way of associating the impugned mark with the petitioner's mark. In this connection, learned counsel submits that the likelihood of passing off should also be considered while adjudicating this petition for rectification.

6. After submitting that a trade name qualifies as a trade mark and that the test for deceptive similarity applies equally to trade names, learned counsel submitted a compilation consisting of the following judgments of the Delhi High Court: (i) *Intel Corporation v. Dinakaran Nair & Others*, 2006 SCC OnLine Del 459, (ii) *Infosys Technologies Ltd. v. Park Infosys & others*, 2007 SCC OnLine Del 27, (iii) *Cadila Healthcare Ltd. v. Aureate Healthcare Pvt. Ltd.*, 2012 SCC OnLine Del 3940, (iv) *Satya Infrastructure Ltd. and others v. Satya Infra & Estates Pvt. Ltd.* MANU/DE/0511/2013, (v) *South India Beverages Pvt. Ltd. v. General Mills Marketing Inc.* MANU/DE/2574/2014, (vi) *Stiefel Laboratories, Inc & Anr. v. Ajanta*



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Pharma Ltd. 2014 SCC OnLine Del 3405, (vii) Sun Pharmaceutical Industries Limited v. Brexsun Pharma Private Limited, LQ/DelHC/2018/3230 and (viii) Sun Pharmaceutical Industries Ltd. v. Infocom Network Limited & Ors in C.S.(Comm) No.922 of 2018 and the judgment of the Supreme Court in Renaissance Hotel Holdings Inc. v. B.Vijaya Sai and Ors. MANU/SC/0066/2022. He also placed reliance on the judgment of the Hon'ble Supreme Court in Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., (Cadila), (2001) 5 SCC 73 to contend that circumspection should be shown while dealing with trade marks relating to pharmaceutical products because there is likelihood of grave injury to public interest.

7. In response to these contentions, Mr.Sathish Kumar submitted that the first respondent uses 'NICSON PHARMA' only as a trade name and that no drugs are manufactured or marketed under the said name. After pointing out that both the petitioner and the first respondent use the trade marks 'SUN PHARMA' and 'NICSON PHARMA', respectively, as trade names, learned counsel submits that if the two trade marks are compared, there is no likelihood of confusion or deception among the public.



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WEB COPY8. Learned counsel next submitted that the first respondent had applied for registration of a device mark containing the words 'NICSON PHARMA' under trade mark application No.2113640, which was opposed by the petitioner. He submits that such opposition and proceedings are pending. On this basis, learned counsel submits that it is probable that the petitioner would have been aware of the filing of trade mark application No.2113639 but opted not to oppose the same earlier.

9. After pointing out that the first respondent commenced business in 2011 and also applied for registration of the trade mark in the same year, learned counsel submits that the petitioner did not file an action for passing off during the period of about 10 years that have elapsed since the date of filing of the rectification petition. According to learned counsel, this clearly indicates that the petitioner has not been adversely impacted by the first respondent operating its business under the trade name 'NICSON PHARMA'. After admitting that trade names qualify as trade marks under the Trade Marks Act, 1999 (the TM Act), learned counsel submits that the fact that the rival marks are



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being used only as trade names is nonetheless a relevant consideration while assessing whether there would be likelihood of confusion or deception. As regards the use of the device of the sun by the first respondent, learned counsel submits that the petitioner is not using the device of the sun as part of its trade marks.

10. Learned counsel referred to the registration certificate of the partnership firm 'NICSON PHARMA' to establish that the said partnership firm was registered on 26.02.2011. He also relied on the certificate dated 23.11.2015 issued by Gaddam Satyanarayana & Co., Chartered Accountants, and pointed out that the document reveals that the first respondent's turnover was substantial during the relevant period, even if not comparable with the turnover of the petitioner. He also relied upon the invoices which were issued between 2011 and 2015 to establish the continuous use of the impugned mark by the first respondent.

11. By way of a brief rejoinder, learned counsel for the petitioner submitted that the evidence of use should be examined as of the date of filing of the trade mark application by the first respondent or, at the



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latest, as of the date of filing of the rectification petition. Since the petitioner adopted the arbitrary mark 'SUN' in relation to its pharmaceutical business, learned counsel submits that the petitioner is entitled to protect its proprietary interest in the said trade mark against the adoption of deceptively similar marks such as the mark adopted by the first respondent. As regards the distinction between a trade name and a trade mark, learned counsel submits that for the purpose of adjudicating this rectification petition, only Section 11 of the TM Act and not Section 29(5) thereof is relevant. He concluded his submissions by pointing out that trade mark application No.2113639 was not opposed by oversight.

Discussion, analysis and conclusion

12. The rectification petition is founded on alleged deceptive similarity between the petitioner's trade mark and the impugned mark. Therefore, this petition is required to be determined largely with reference to Section 11 of the TM Act. Section 11, in relevant part, reads as under:

“11. Relative grounds for refusal of registration: (1) Save as provided in section 12, a trade mark shall not be registered if,



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because of -

(a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

As is evident from the text of Section 11(1), the question to be considered is whether there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark.

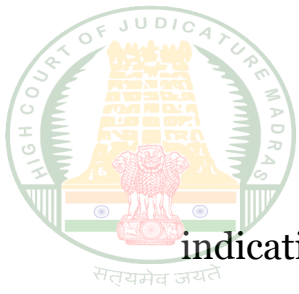
13. In this case, both parties use their respective trade marks as trade names. Although such use of a mark qualifies as the use of a trade mark under the TM Act, this aspect is relevant while assessing whether there exists likelihood of confusion. The first respondent has stated categorically that it does not manufacture or market medicinal or pharmaceutical products under the trade mark 'NICSON PHARMA'



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or even 'NICSON'. Keeping that aspect in mind, the comparison is to be made between the two marks as a whole. Learned counsel for the petitioner contended that the first respondent adopted the spelling NICSON in bad faith instead of the more common spelling NIXON. There is no evidence of bad faith adoption except for the said submission of learned counsel. In fact, if there were bad faith on the part of the first respondent, it is likely that the first respondent would have adopted the spelling 'NICSUN' and not 'NICSON'.

14. The first respondent has placed on record the certificate of registration dated 26.02.2011 of the partnership firm under the name 'NICSON PHARMA'. The petitioner has also submitted the certificate of the chartered accountant. The turnover of the petitioner in 2011-12 was Rs.78,41,369.04. The said turnover increased to Rs.1,26,21,506.50 as on the date of filing of the rectification petition. Multiple invoices issued between 2011-15 have also been placed on record. In spite of the extensive use of the impugned trade mark/trade name, the petitioner has chosen not to sue the first respondent for passing off. While it is not a condition precedent to establish actual confusion or deception, the above fact is at least



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indicative of the fact that the petitioner was not prejudiced by instances of actual confusion or deception.

15. On the strength of registration of the trade mark 'SUN PHARMA', it cannot be said that the proprietary rights of the petitioner extend to restraining any other person from adopting any mark containing the element 'SON'. If such test were to be adopted, the adoption and use of word marks such as 'SAMSON', 'ADDISON' 'JOHNSON' would be construed as infringing although a consumer of average intelligence and imperfect recollection is unlikely to be deceived or confused between the petitioner's mark and any of the above. It should be borne in mind that the test is not whether there is a remote possibility of confusion or deception or even whether a person who is particularly prone or vulnerable to getting confused or deceived is likely to be confused or deceived. The test in all these matters is to compare the marks as a whole and thereafter determine whether the notional consumer of average intelligence and imperfect collection is likely to be confused or deceived. If such test were to be applied to the rival trade names/marks in this case, SUN PHARMA and NICSON PHARMA, the conclusion that follows is that it is not



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likely that the said consumer would be confused or deceived, including
with regard to trade association.

16. For reasons aforesaid, (T)OP(TM) No.173 of 2023 is
dismissed without any order as to costs.

17.06.2025

Index : Yes / No

Internet : Yes / No

Neutral Citation : Yes / No

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The Registrar of Trade Marks
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