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

% *Judgment delivered on: 24.12.2025*

+ **C.A.(COMM.IPD-TM) 51/2024 & I.A. 33412/2024**

**RECKITT AND COLMAN OVERSEAS HEALTH
LIMITED**

.....Appellant

versus

IND SWIFT LIMITED & ANR.

.....Respondents

Advocates who appeared in this case

For the Appellant : Mr. C.M. Lall, Senior Advocate with
Mr. Rahul Chaudhry, Ms. Ekta Sarin,
Mr. Nikhil Sharma, Mr. Hitesh Malik
and Ms. Ananya Mehan, Advocates.

For the Respondents : Mr. Manish Biala and Mr. Arun
Kumar Jha, Advocates for R1.
Ms. Saumya Tandon and Mr.
Shashank Dixit, CGSCs with Mr.
Gaurav Singh Sengar, Mr. Kunal Raj
and Ms. Charu Khandelwal,
Advocates for R2.

**CORAM:
HON'BLE MR. JUSTICE TEJAS KARIA**

JUDGMENT

TEJAS KARIA, J

1. This is an Appeal filed under Section 91 of the Trade Marks Act, 1999
("Act") read with Rule 156 of the Trade Marks Rules, 2017 ("**Rules**"),



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challenging the order dated 09.02.2024 (“**Impugned Order**”) passed by Respondent No. 2 dismissing Opposition No. DEL-125161 (“**Opposition**”) against registration of the Trade Mark, ‘DECA-NEROPHEN’ (“**Impugned Mark**”), in Class 05 under Trade Mark Application No. 843092 and directing that the Impugned Mark shall proceed for registration.

FACTUAL BACKGROUND:

2. The Appellant is a member of the Reckitt Group of Companies, the ultimate parent company of which is Reckitt Benckiser Group Plc. The Appellant is involved in the field of consumer healthcare and fast-moving consumer goods and products related to health, hygiene and nutrition. The Appellant’s range of products include household cleaners, antiseptic liquids, toilet care products, shoe care products, mosquito repellents and personal health care products, etc.

3. The Appellant’s predecessor, coined and adopted the Mark, ‘NUROFEN’ (“**Appellant’s Mark**”) in the year 1981 for use upon and in relation to pharmaceutical preparations containing ‘Ibuprofen’ as active ingredient having analgesic, anti-inflammatory, anti-pyretic and anti-rheumatic properties. The Appellant’s predecessor received registration for the Appellant’s Mark under Trade Mark Registration No. 406022 in Class 05 on 27.05.1983. The registration is presently subsisting on the Register of Trade Marks in the name of the Appellant.

4. Respondent No. 1 applied for the registration of the Impugned Mark on 26.02.1999 in relation to pharmaceutical and medicinal preparations, claiming user since 01.06.1992. The Application for registration of the Impugned Mark was published in the Trade Marks Journal on 29.06.2003. Thereafter, the Appellant filed Opposition against the Impugned Mark on 24.09.2003.



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5. On 09.02.2024, Respondent No. 2 passed the Impugned Order dismissing the Opposition filed by the Appellant and allowed the Impugned Mark to proceed for registration.

SUBMISSIONS ON BEHALF OF THE APPELLANT:

6. The learned Senior Counsel for the Appellant made the following submissions:

- 6.1 The Appellant is the prior registered proprietor of the Appellant's Mark having secured its registration under Trade Mark Registration No. 406022 in Class 05 on 27.05.1983 in relation to pharmaceutical preparations and substances. Respondent No. 1's Application for registration of the Impugned Mark was made nearly two decades after the Appellant's adoption, and registration of the Appellant's Mark, i.e., on 26.02.1999.
- 6.2 The Appellant's Mark and the Impugned Mark are phonetically identical or in any event confusingly and deceptively similar as the Appellant's Mark is subsumed in its entirety in the Impugned Mark. The element 'DECA' in the Impugned Mark is purely descriptive of the Respondent No. 1's drug, as the name of the Respondent No. 1's drug is 'Nandrolone Decanoate'. The addition of a descriptive word 'DECA' does not make the Impugned Mark different from / dissimilar to the Appellant's Mark as has been held by the Supreme Court in *Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories*, (1965) 1 SCR 737 and *Ruston & Hornsby Ltd v. The Zamindara Engineering Co.*, AIR 1970 SC 1649. A bare reading of the pleadings in the Opposition reflect that there is no denial



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regarding deceptive similarity of the rival Marks. On the contrary, by placing reliance on Section 12 of the Act, as also by opposing third party's application for registration of the Mark 'NUROFEN' the Respondent No. 1 has admitted not only to the deceptive similarity between the rival marks, but also that the existence of these marks would hamper the purity of the Register. Hence, Respondent No. 2's finding that the rival Marks are different, is entirely against the pleadings and the stance taken by Respondent No. 1.

- 6.3 Once Respondent No. 2 held that the rival Marks are different / dissimilar, it could not have granted Respondent No. 1 benefit under Section 12 of the Act, since Section 12 of the Act presupposes that the rival Marks are identical / deceptively similar. Respondent No. 2's findings are thus self-contradictory and ought to be set aside.
- 6.4 Respondent No. 1 was not entitled to seek benefit under Section 12 of the Act. Honesty of adoption and concurrency of use are *sine qua non* for applicability of Section 12 of the Act. There was no honesty on Respondent No. 1's part in adopting the Impugned Mark. The Appellant's Mark is a coined and invented word having no dictionary meaning. No cogent reason has been furnished by Respondent No. 1 behind adopting the Impugned Mark. Respondent No. 1 had a duty to conduct a search of the Register of Trade Marks before adopting the Impugned Mark as has been held in ***Bal Pharma Ltd. v. Centaur Laboratories Pvt. Ltd.***, 2002 (24) PTC 226 (BOM) and ***Devans Modern Breweries***



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Ltd. v. Radico Khaitan Ltd. FAO(OS)(COMM) 74/2019. The duty is even stringent in the cases involving pharmaceutical Marks as has been held by the Supreme Court in *Cadila Healthcare Limited v. Cadila Pharmaceuticals Limited*, (2001) 5 SCC 73. Since the Appellant's Mark was validly subsisting as on the date of Application for registration of the Impugned Mark, Respondent No. 1 had notice of Appellant's Mark. The adoption of the Impugned Mark was with knowledge of Appellant's statutory rights in the Appellant's Mark and was thus dishonest.

6.5 Respondent No.1 has even failed to prove any concurrent use of the Impugned Mark. The Application for registration of the Impugned Mark was made on 26.02.1999 with a user claim of 1992. Not a single document has been filed to support this user claim. Even if the user claim is considered as correct, the adoption and use of the Impugned Mark is nearly a decade after the registration of the Appellant's Mark and hence, Respondent No. 1 cannot be concurrent user. The earliest documentary evidence submitted by the Respondent No. 1 is allegedly a copy of a sale invoice dated 12.06.1999, which is illegible.

6.6 Since the invoices submitted by Respondent No. 1 are subsequent to the date of application for registration of the Impugned Mark i.e., 26.02.1999, the same are liable to be ignored for the present proceedings. Thus, Respondent No. 1 has failed to establish concurrent use of the Impugned Mark. Further, Respondent No. 2's reliance on the alleged 25 years of use of the Impugned Mark is entirely misplaced and contrary to law. Any use made of the



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Impugned Mark after the date of Application for registration of the Impugned Mark is completely irrelevant, immaterial and should be ignored as has been held in ***Mohan Goldwater Breweries (Private) Ltd. v Khoday Distillerie Pvt. Ltd.***, 1977 IPLR Page 83; ***Charak Pharmaceuticals v M.J. Exports Pvt. Ltd.*** 1993 IPLR 39 (Bom DB). The Appellant had opposed the Application for registration of the Impugned Mark in 2003, when the same was advertised in the Trade Marks Journal. The fact that Respondent No. 2 has taken 20 years to decide the Opposition proceedings cannot be a ground for prejudicing the Appellant and conferring long use to the benefit of the Respondent.

- 6.7 The goods under the Appellant's Mark and the Impugned Mark are medicines meant for ailment of two completely different diseases, with completely different side effects, consumption of one in place of the other may result in disastrous consequences ***Cadila Healthcare Limited*** (supra). In public interest, there cannot be two medicinal preparations bearing the same name from different sources and with different compositions as has been held in ***Milmet Oftho Industries & Ors. Vs Allergan Inc*** (2004) 12 SCC 624. On this ground also Respondent No. 1 was not entitled to benefit under Section 12 of the Act.
- 6.8 The Appellant's products are available in the form of capsules, tablets, gels used for treating migraine while Respondent No. 1's goods are available in the injection form, which keeps bones strong and reduces the risk of osteoporosis, is completely irrelevant. The Appellant's statutory exclusivity over the



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Appellant's Mark is not restricted to a particular type of or form of medicine. The description of goods mentioned in the Application for registration of the Impugned Mark is also not restricted to a particular type of medicine being made available in a particular form. The rival goods are, thus, evidently identical. The alleged non-use of the Appellant's Mark in India is not a defence available to Respondent No. 1. Neither Section 11 of the Act nor any other provision requires use of a registered Trade Mark as a prerequisite to enforce the same against other traders. In any event, the Appellant's products are available in India. Further, the documents showing international goodwill and reputation of the Appellant's Mark was duly filed before Respondent No. 2. Respondent No. 1 has also not denied the international use and goodwill and reputation associated with the Appellant's Mark.

- 6.9 The use of the Appellant's Mark outside India since 1983 ought to be considered as use in India. The law with respect to medicinal products, i.e., 'who is first in the world market' has been clearly laid down by the Supreme Court in *Milmet Oftho Industries* (supra). Medicines have an inherent international character and the principle of territoriality does not apply vis-à-vis medicines. Further, the Supreme Court in *Meghraj Biscuits Industries Ltd. v. Commissioner of Central Excise*, (2001) 3 SCC 780 and *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683 has held that registration of a Trade Mark in India is equivalent to its deemed public use in India. In rectification proceedings, the rights



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of prior registrant are superior to rights of prior user of the Mark as has been held in *Medical Technologies Limited v. Neon Laboratories Limited & Ors.* 2012 (51) PTC 173 (Bom).

6.10 Further, Section 11 of the Act clearly lays down that the Registrar ought to protect a Mark by not allowing identical or similar marks from subsisting on the Register. Further, the use of the Mark in India is not the *sine qua non* for a Mark to have acquired goodwill and reputation as also a well-known character in India or that the Mark need not be well-known through the entire populace of India. Respondent No. 2 applied an incorrect principle for determining trans-border reputation and noting that entire Indian population is more than 130 crores and entire population is not moving from India to UK and vice versa. It is not necessary that the entire Indian population to travel abroad to become aware of the Appellant's Mark.

6.11 In view of the above, the Impugned Order deserves to be set aside and the Impugned Mark deserves to be deleted from the Register of Trade Marks.

SUBMISSIONS ON BEHALF OF RESPONDENT NO. 1:

7. The learned Senior Counsel for Respondent No. 1 made the following submissions:

7.1. Respondent No. 1, a company originally incorporated under the Companies Act, 1956, is the original adopter and exclusive proprietor of NEUROPHEN series of Marks, the details of registrations of which are as follows:



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S. No.	Trade Mark	Application No.	Class	User Detail	Date of Application	Date of Registration & Status
1.	NEUROPHEN FORTE	601475	5	10.04.1984	12.07.1993	Registration granted on 19.07.2022 & valid upto 12.07.2033
2.	DECA-NEUROPHEN	843092	5	01.06.1992	26.02.1999	Registration granted on 15.02.2024 & valid upto 26.02.2029

7.2. The Mark 'NEUROPHEN FORTE' was coined and adopted by the Respondent's predecessor in the business M/s Mukur Pharmaceutical Co. Pvt. Ltd. on 10.04.1984 for medicinal and pharmaceutical preparations. The said Mark has been in continuous and uninterrupted use in the open market all over India since its adoption in 1984, and it is widely used in India. Owing to the popularity of the Mark 'NEUROPHEN', which is the dominant part of the Respondent No. 1's registered Mark 'NEUROPHEN FORTE', Respondent No. 1 coined and adopted the Impugned Mark on 01.06.1992 for pharmaceutical and medicinal preparations. The Impugned Mark has also been in continuous and uninterrupted use in the open market all over India since its adoption, and it is widely used for treatment of osteoporosis in women. The sales turnover of the products under the Impugned Mark is evidence of its popularity, reputation and



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goodwill, which has grown from ₹32,22,032 in the year 1993-94 to ₹81,88,891 in the year 2023-24.

7.3. The Appellant, a company incorporated and existing in the United Kingdom (“UK”), has claimed to be the proprietor and user of the Appellant’s Mark in UK and some other countries. However, the Appellant’s Mark is not used in India and the products thereunder are not sold in India. The Appellant has claimed that it has been using the Appellant’s Mark since 1983 in UK, and it applied for the Appellant’s Mark in India on 27.05.1983 under Class 5 on proposed to be used basis. Thereafter, the Appellant applied for 5 more variants of the Appellant’s Mark in India in 2007, 2009, 2013, 2018 and 2019, all under class 5 and all of them on proposed to be used basis. The details of all the Trade Mark Applications filed by the Appellant are as follows:

S. No.	Trade Mark	Application No.	Class	User Detail	Date of Application	Status
1.	NUROFEN	406022	5	Proposed to be used	27.05.1983	Registered Rectification filed by Respondent No. 1 is pending.
2.	NUROFEN (device)	1589182	5	Proposed to be used	10.08.2007	Registered Rectification filed by Respondent No. 1.



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3.	NUROFEN (device)	1856958	5	Proposed to be used	31.08.2009	Opposed by a third party.
4.	NUROFEN LYSI-PRO	2580982	5	Proposed to be used	16.08.2013	Registered Rectification filed by Respondent No. 1.
5.	NUROFEN Stylised (device)	3730883	5	Proposed to be used	18.01.2018	Registered Rectification filed by Respondent No. 1.
6.	NUROFEN	4131662	5	Proposed to be used	29.03.2019	Opposed by Respondent No. 1.

7.4. Since the Appellant has never used the Appellant's Mark in India, the Appellant has filed all its Trade Mark Applications from 1983 to 2019 on proposed to be used basis. Despite the same, the Appellant had filed Opposition to the Application for the registration of the Impugned Mark, which was dismissed by Respondent No. 2 in the Impugned Order and the Impugned Mark was granted registration, on the ground that the rival Marks and products are different, given that the products of the Respondent No. 1 under the Impugned Mark are used as Nandrolone Decanoate Injection whereas, the Appellant's product is used as Ibuprofen Capsule and, therefore, there cannot be any confusion or deception at all.



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- 7.5. Further, it was held that the Appellant has not been able to prove any trans-border reputation of the Appellant's Mark in India, as the said claim was not supported by any documents and the Appellant made only vague claims about Indians having knowledge about the Appellant's products. Further, even if the rival Marks are similar to each other, Respondent No. 1 is an honest concurrent user and protected under Section 12 of the Act since the Impugned Mark and the Appellant's Mark were adopted around the same time and the Impugned Mark has been in use in India for more than four decades.
- 7.6. Respondent No. 1's use of the Impugned Mark is in continuation of its use of the Mark, 'NEUROPHEN FORTE', adopted in 1984, and the same is also protected by Section 55 of the Act. The use of the earlier Mark by the Respondent No. 1 is relevant for considering any use of the later Mark as they are substantially the same and do not affect each other's identity. Thus, there arises no question of any challenge to the Respondent No. 1's rights in the Impugned Mark. Respondent No. 1's products are in the form of injection and the Appellant's products are in form of capsules or tablets. Thus, the rival marks are used for completely different products and there is no similarity in goods.
- 7.7. From 1983 till date, the Appellant's Mark has not been used in India and, thus, the Appellant has been filing Trade Mark Applications on proposed to be used basis. The Appellant has failed to file a single document on record to show actual use of the Appellant's Mark in India. Thus, it is clear that the Appellant's



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Mark is not in use, and the Appellant is a mere squatter. In view of non-use, the Appellant's Mark is liable to be cancelled.

- 7.8. The Appellant has failed to show any trans-border reputation in India. The Appellant has claimed to use the Appellant's Mark in 53 countries of the world, yet it has failed to file any documents in support thereof, and the invoices filed by the Appellant show alleged use in 6 countries only i.e. Singapore, Hong Kong, France, Australia, Malaysia and UK. Before Respondent no. 2, it was submitted on behalf of the Appellant that the Appellant's products are sold *via* 3rd party website in India. However, the Appellant has miserably failed to file any documents in support of the said claim. The Appellant has made very vague and frivolous claims regarding the trans-border reputation of the Appellant's Mark in India, claiming that a number of Indians in the UK are aware of the Appellant's products, and since Indians keep travelling between UK and India, the Appellant's purported popularity has travelled to India. The said frivolous claims of the Appellant have been rejected by Respondent No. 2.
- 7.9. The concept of first use, similarity of marks and passing off are of no relevance as the Respondent No. 1 is protected by Section 12 of the Act. The Appellant has relied on the judgments in ***Cadila Healthcare Ltd.*** (supra) and ***Milmet Oftho Industries*** (supra), which are concerned primarily with passing off, where the concept of first use is an important factor. Even the other judgments relied upon by the Appellant deal with the issue of passing off, which is not the case in the present matter. However,



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under honest concurrent use, any prior use or similarity of Trade Marks or confusion are not to be considered while granting registration under Section 12 of the Act. In the present case, the Appellant has miserably failed to show that.

7.10. The Appellant's Mark has not acquired any trans-border reputation in India and that the Appellant has not shown that their alleged reputation outside India, has travelled to India and, therefore, the Appellant cannot claim goodwill in India as has been held in *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd.*, (2018) 2 SCC 1. Further reliance is placed on *London Rubber Co. Ltd. v. Durex Products Incorporated*, 1963 SCC Online SC 223 to support the case of Respondent No. 1 for obtaining the registration of the Impugned Mark on the ground that Respondent No. 1 is a honest concurrent user of the Impugned Mark.

7.11. Accordingly, Respondent No. 2 has passed the Impugned Order after duly understanding the facts and circumstances of the present dispute has rightly dismissed the Opposition and allowed the Impugned Mark to be registered.

SUBMISSIONS ON BEHALF OF RESPONDENT NO. 2

8. Respondent No. 2 is a proforma party and will abide by any judgment passed by this Court.

ANALYSIS AND FINDINGS:

9. The Appellant has challenged the Impugned Order passed by Respondent No. 2 rejecting the Opposition filed by the Appellant for registration of the Impugned Mark, 'DECA-NEUROPHEN' in Class 05 under



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Trade Mark Application No. 843092 filed by Respondent No. 1 on the ground of being deceptively similar to the Appellant's Mark, 'NUROFEN' and allowed the Impugned Mark to proceed for registration.

Deceptive Similarity and Likelihood of Confusion between the Impugned Mark and the Appellant's Mark

10. A comparison of the Appellant's Mark 'NUROFEN' and the Impugned Mark 'DECA-NEUROPHEN' appears to be similar visually and phonetically. As regards the likelihood of confusion, it is contended on behalf of Respondent No. 1 that the Appellant primarily deals with forms of capsules, tablets, gels used for treating migraine, whereas Respondent No. 1 deals with products in the injection form, which keeps bones strong and reduces the risk of osteoporosis.

11. The Appellant submitted that both the Appellant and Respondent No. 1 are dealing in similar products and the trade channels of the products of the Appellant and Respondent No. 1 are the same. Both the products of the Appellant and the Respondent No. 1 are sold through chemists and e-pharmacies. Both the Appellant and Respondent No. 1 are selling medicines and pharmaceutical products. Therefore, the defence that the Appellant and Respondent No. 1 are manufacturing and selling different products is untenable. On account of similarity of products sold by the Parties, there is likelihood of confusion in the market especially among the medical practitioners, pharmacists etc. as well as the general public at large.

12. If the Impugned Mark is allowed to subsist on the Register of Trade Marks, irreparable harm and injury would be caused not only to the Appellant, but also to the public at large. Any use the Impugned Mark by Respondent No. 1, in respect of similar goods, which are in the nature of medicines, having



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identical and overlapping trade channels, it is likely to cause confusion and deception among the consumers, who are ordinary persons of average intelligence and imperfect recollection. Consuming the wrong medicine could have disastrous side effects which will cause harm to the consumers.

13. Respondent No. 1 had a responsibility to carry out due diligence before adoption of the Impugned Mark. A mere search on the Register of Trade Marks would have revealed the existence of the Appellant's Mark on the Register of Trade Marks. Before adoption of a Mark it is the duty of the proprietor of the Mark to carry out a search of the Register of Trade Marks as has been held in *Bal Pharma* (supra) and *Devans Modern Breweries* (supra). It is a settled position of law that a stricter approach has to be adopted by courts while judging the likelihood of confusion between the two competing Marks in respect of pharmaceutical products as has been held in *Cadila Healthcare Limited* (supra). In public interest, there cannot be two medicinal preparations bearing the same name from different sources and with different compositions as has been held in *Milmet Oftho Industries* (supra). The addition of a descriptive word 'DECA' does not make the Impugned Mark dissimilar to the Appellant's Mark as has held been by the Supreme Court in *Kaviraj Pandit* (supra) and *Ruston & Hornsby Ltd* (supra).

14. In view of the above, it has been established that the Appellant's Mark and the Impugned Mark are deceptively similar and there exists a likelihood of confusion between the Appellant's Mark and the Impugned Mark.

Prior Adoption and Use by the Appellant:

15. The Appellant is the prior user and registrant of the Appellant's Mark as the Appellant coined the Appellant's Mark in 1981 and the Appellant's Mark is validly subsisting on the Register of Trade Marks with effect from



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27.05.1983. Respondent No. 1 filed the Application for registration of the Impugned Mark on 26.02.1999 claiming user detail of 01.06.1992, which is subsequent to the adoption of the Appellant's Mark.

16. In the present case, there is no cavil that the date of filing the Application for the registration of the Appellant's Mark is prior in time to the date of filing of the application for the registration of the Impugned Mark. Therefore, the Appellant's Mark is clearly the earlier Trade Mark in accordance with the provisions of Section 11 of the Act.

17. Further, Section 11(1) of the Act provides that a Trade Mark will not be registered, if there exists a likelihood of confusion on the part of the public because of its identity or similarity to an earlier Trade Mark. Therefore, for the purpose of deciding whether the Impugned Mark is identical or deceptively similar to the prior registered Appellant's Mark, Respondent No. 2 ought to have considered whether the Appellant's Mark constitutes an earlier Trade Mark in accordance with the provisions of Section 11 of the Act.

18. Therefore, Respondent No. 2 has erred in dismissing the Appellant's Opposition on the ground that the Appellant's claim of prior use has not been established.

Whether Respondent No. 1 is the Honest and Concurrent User of the Impugned Mark.

19. It is submitted on behalf of Respondent No. 1 that the adoption of the Impugned Mark is *bona fide* and has nexus with the business activity of Respondent No. 1. It is further submitted that Respondent No. 1 has been using the Mark, 'NEUROPHEN FORTE' since 1984 and adoption of the Impugned Mark is an attempt to take advantage of the goodwill that Respondent No. 1 has attained in the Mark 'NEUROPHEN' and over the



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years Respondent No. 1 has built up goodwill and reputation in the market with a turnover of ₹81,88,891 in FY 2023-24. It is contended on behalf of Respondent No. 1 that in the year 1984, when Respondent first adopted the Mark, 'NEUROPHEN FORTE', the prominent feature of which is 'NEUROPHEN' came into being, the Appellant had not acquired any goodwill or reputation in the market. In response, it has been contended on behalf of the Appellant that the adoption of the Impugned Mark by Respondent No. 1 was not bona fide as Respondent No. 1 was always aware of the Appellant and existence of the Appellant's Mark they proceeded to adopt a name nearly identical to the Appellant's Mark.

20. It is an admitted position that the Appellant is the prior user and adopter as well as the registrant of the Appellant's Mark at least since the year 1983. Admittedly, Respondent No. 1 applied for the registration of the Impugned Mark in 1999, claiming use since 1992, which is subsequent to the adoption and registration of the Appellant's Mark. Respondent No. 1 has not pleaded that it was not aware of the Appellant's existence or the Appellant's Mark being used by the Appellant, when it adopted the Impugned Mark. A simple due diligence exercise conducted on behalf of Respondent No. 1 or a Trade Marks Registry search across Class 5 would have revealed that the Appellant was the prior registered proprietor of the Appellant's Mark in Class 5.

21. Accordingly, Respondent No. 1 is not the honest and concurrent user of the Impugned Mark and the decision in **London Rubber Co.** (supra) would not help the case of Respondent No. 1.

22. In view of the above, Respondent No. 1 is not an honest and *bona fide* adopter or concurrent user of the Impugned Mark and, accordingly, the defence under Section 12 of the Act is not available to Respondent No. 1.



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Analysis of the Impugned Order

23. Respondent No. 2 has held that the Appellant has not been able to establish the use of the Appellant's Mark in India and the Appellant cannot rely upon use of the Appellant's Mark in 53 countries of the world to state that the Appellant's Mark is known and has goodwill across the entire world.

24. Neither Section 11 of the Act nor any other provision requires use of a registered Trade Mark as a prerequisite to protect the statutory rights. Accordingly, Respondent No. 2 was required to properly examine the likelihood of confusion under Section 11(1) of the Act as the actual use is not necessary to determine the likelihood of confusion. If for filing opposition, the opponent is required to establish prior use, Section 11(1) of the Act would be rendered otiose. The registration of a Trade Mark is a *prima facie* evidence of its validity and the registered proprietor of the Trade Mark acquires valuable rights on account of the registration. In view thereof the decision of ***Toyota Jidosha Kabushiki*** (supra) does not help the case of Respondent No. 1.

25. Further, it has been held in the Impugned Order that the Impugned Mark is being used in India for more than 25 years, and the Appellant being the registrant of the Appellant's Mark for over 40 years cannot stop Respondent No. 1 from using the Impugned Mark as Respondent No. 1 is an honest and concurrent user of the Impugned Mark. The time spent between filing of the Opposition and the pronouncement of the Impugned Order is around 20 years, whereas, the Appellant filed the Opposition soon after the Impugned Mark was advertised in the Trade Marks Journal. The period spent deciding the Opposition cannot be considered as honest and concurrent use and as a result cannot be considered a ground to allow the registration of the Impugned Mark.



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Any use made of the Impugned Mark after the date of Application for registration of the Impugned Mark is completely irrelevant, immaterial and should be ignored as has been held in *Mohan Goldwater Breweries* (supra), and *Charak Pharmaceuticals* (supra).

CONCLUSION

26. Accordingly, the present Appeal is allowed, and the Impugned Order dated 09.02.2024 passed by Respondent No. 2 is hereby set aside. Respondent No. 2 is directed to remove the entry pertaining to Application No. 843092 for registration of the Impugned Mark, 'DECA-NEUROPHEN', in Class 5 from the Register of Trade Marks.

27. The Appeal and the pending Applications stand disposed of.

28. A copy of the present Order is directed to be sent the Trade Marks Registry through email: at llc-ipo@gov.in for compliance.

TEJAS KARIA, J

DECEMBER 24, 2025

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