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

+ CS(COMM) 188/2021, I.A. 5700/2021 & I.A. 3248/2023

MANKIND PHARMA LIMITED ..... Plaintiff

Through: Mr. Amit Sibal, Sr. Adv.  
with Mr. Hemant Daswai, Ms.  
Saumya Bajpai, Mr. Rishabh Sharma  
and Mr. J. Dhingra, Adv.

versus

NOVAKIND BIO SCIENCES PRIVATE LIMITED

..... Defendant

Through: Mr. Sushant Mahapatra,  
Adv.

**CORAM:**

**HON'BLE MR. JUSTICE C.HARI SHANKAR**

**JUDGEMENT (ORAL)**

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**07.08.2023**

**I.A. 5700/2021 (under Order XXXIX Rules 1 and 2 of the CPC) & I.A. 3248/2023 (under Order XXXIX Rule 4 of the CPC)**

1. The plaintiff is the fifth largest pharmaceutical company of India. The chairman and founder the plaintiff, Mr. Ramesh Chand Juneja, adopted the trademark MANKIND as part of the trading style of the plaintiff in 1986. Para 3 of the plaint sets out the encomiums and accolades that the plaintiff has earned over a course of time and, for the purposes of this order, it is not necessary to advert thereto, as they are not in debate. It is further asserted, in the plaint, that 268 brands of the plaintiff are



listed amongst the top five brands, in pharmaceutical products, with 85 brands at the first and 67 brands at the second place. The plaintiff is also the registered owner of the websites: mankindpharma.com, mankindunwanted.com, mankindmanforce.com, mankinddontworry.com, mankindkaloree1.com, futuremankind.com, vetmankind.com, caremankind.com, petmankind.com, mankindpharma.net, magnetmankind.com, specialmankind.com, mankindpharma.asia, mankindpharma.cn, mankindpharma.org, mankindpharma.us and mankindpharma.edu.

2. The plaintiff uses “KIND” as second part of the name of various pharmaceutical preparations which the plaintiff manufactures and sells. The marks of the plaintiff which use “KIND” as the second part thereof have been referred to, in the plaint, as the “KIND family of marks”.

3. The plaintiff is aggrieved by the mark NOVAKIND BIO SCIENCES PRIVATE LIMITED, used by the defendant for various pharmaceutical products manufactured and sold by it. A cease and desist notice was issued by the plaintiff to the defendant on 25 August 2020, calling upon the defendant to desist using the mark “NOVAKIND BIO SCIENCES PRIVATE LIMITED” as in the perception of the plaintiff, the said mark, by including “KIND” as the second part of the word “NOVAKIND” infringed the plaintiff’s registered trademark.



4. It is in these circumstances that the plaintiff has approached this Court by means of the present suit, seeking a permanent injunction restraining the defendant from using “KIND” as a part of the trade name/trademark under which the defendant manufactures and sells any of its medicinal and pharmaceutical preparations.

5. The plaint also seeks an injunction against the use, by the defendant, of the mark “DEFZAKIND”, for Deflazacort tablets, packed and sold by it. The plaint provides a photographic representation of the “DEFZAKIND” strip, which is of some importance and which, therefore, may be reproduced as under:





6. The plaint is accompanied by IA 5700/2021, preferred by the plaintiff under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC).

7. While issuing summons in the present suit, this Court, *vide* order dated 20 April 2021, granted an *ex parte ad interim* injunction restraining the defendant from manufacturing, either on its own behalf or through any job worker, marketing or clearing, for sale in the market, any pharmaceutical product bearing the “KIND” suffix or which may, in any other manner, infringe the registered trademark of the plaintiff.

8. That order continues to remain in force till date. In the interregnum, the defendant has filed IA 3248/2023 under Order XXXIX Rule 4 of the CPC, seeking vacation of the order dated 20 April 2021. Pleadings in both these applications are complete. Both the applications have been heard by me today at some length. Mr. Amit Sibal, learned Senior Counsel appeared for the plaintiff and Mr. Mahapatra, learned Counsel appeared for the defendant. This judgment disposes of both the applications.

9. Mr. Mahapatra, learned Counsel for the defendant raises various defences against the charge of infringement and passing off, levelled by the plaintiff. These may be enumerated thus:

(i) The plaintiff has no registration, in its favour, of



the mark “KIND” it cannot, therefore, claim exclusivity over “KIND” as a suffix in the name of any pharmaceutical product. Moreover, “KIND” is not a registered trademark of the plaintiff.

(ii) The defendant was not using “NOVAKIND” as a trademark, but was only using it as part of its corporate name. In this context, Mr. Mahapatra emphasises the words “in the course of trade”, which figure in Section 2(zb)(ii)<sup>1</sup> of the Trade Marks Act, which defines “trademark”.

(iii) Where the mark is used as part of the corporate name of the defendant, as in the present case, infringement would lie only if the case attracts Section 29(5)<sup>2</sup> of the Trade Marks Act. Apply Section 29(5), as the defendant was not using the plaintiff’s trademark as its company name, no injunction could be granted in favour of the plaintiff.

(iv) Sub-sections (1) to (4) of Section 29 had no place

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<sup>1</sup> (zb) “trade mark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and –

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(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;

<sup>2</sup> (5) A registered trade mark is infringed by a person if he uses such 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 dealing in goods or services in respect of which the trade mark is registered.



to play where the defendant used the impugned mark as part of its corporate name. Such cases had to be tested on the anvil of Section 29(5), and Section 29(5) alone. Section 29(5) applied only where the mark of the plaintiff and the mark of the defendant are identical. As such, in cases in which the impugned mark of the defendant is used as part of its corporate name, if the mark of the plaintiff and the mark of the defendant are not identical, no case of infringement is made out. Mr. Mahapatra relies, in this context, on the judgment of a full Bench of the High Court of Bombay in *Cipla Ltd v. Cipla Industries Pvt Ltd*<sup>3</sup>, the judgment of the High Court of Madras in *Dhiren Krishna Paul v. Health and Glow Retailing Pvt Ltd.*<sup>4</sup> and the judgment of a learned Single Judge of this Court in *Chronicle Publications (P) Ltd. v. Chronicle Academy Pvt. Ltd.*<sup>5</sup>

(v) The requirement of mentioning the name and address of the manufacturer of pharmaceutical preparations was a statutory mandate under the Drugs and Cosmetics Act, 1940. The defendant could not be alleged of infringement merely because it chose to comply with the statutory adduct.

(vi) The rival marks were used for pharmaceutical

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<sup>3</sup> AIR 2017 Bom 75

<sup>4</sup> 2013 (53) PTC 355 (Mad)

<sup>5</sup> 2010 (44) PTC 78



products. Pharmaceutical products are prescribed by doctors, and dispensed by chemists, who know their job. There was, therefore, no chance of confusion in the market.

(vii) Pharmaceutical preparations are not sold by the name of the company manufacturing the preparation, but by their brand names. As such, for example, “DEFZAKIND” would be sold and prescribed under the brand name “DEFZAKIND” and not by the name of the manufacturer of the drug.

**10.** Responding to the submissions of Mr. Mahapatra, Mr. Sibal, learned Senior Counsel for the plaintiff submits that at least two judgments of this Court, namely, *Bloomberg Finance LP v. Prafull Saklecha*<sup>6</sup> and the judgment of this Bench in *Novartis AG v. Novaegis (India) Private Limited*<sup>7</sup> have departed from the view adopted by the Full Bench of the High Court of Bombay in *Cipla*<sup>3</sup>, in fact, he points out that the full Bench in *Cipla*<sup>3</sup> expressed their disagreement with the view expressed by this Court in *Bloomberg*<sup>6</sup>.

**11.** On facts, Mr. Sibal contests Mr. Mahapatra’s submission that the defendant does not use “NOVAKIND” as a trademark. He has drawn my attention to the “DEFZAKIND” strip, a photograph of which is already provided hereinbefore. Mr.

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<sup>6</sup> (2014) 207 DLT 35

<sup>7</sup> MANU/DE/1012/2023



Sibal points out that, in the said strip, “NOVAKIND” is not shown merely as a distributor of “DEFZAKIND”, but, rather, the mark “Novakind Biosciences Private Limited”, along with its address, figure prominently on the strip in white letters on a bold red background which are, in a manner of speaking, even larger than the name of the drug “DEFZAKIND”. He also points out that the defendant has used ® with the aforesaid mark, thereby, proclaiming that it is the registered trademark of the defendant. Clearly, therefore, by its own showing, the defendant is highlighting “Novakind Biosciences Private Limited” as its source identifier and, therefore, as a trademark within the meaning of Section 2(zb) of the Trade Marks Act.

**12.** Mr. Sibal further submits that, even in IA 3248/2023, the defendant has, in paras 22 and 24, impliedly acknowledged that it was using the mark “Novakind Biosciences Private Limited” as its trademark. In para 22, the defendant has averred that, “even today doctors recognised the medicine representation as “NOVAKIND””. In para 24, the defendant has proclaimed that it “has all intent to use the trade name “NOVAKIND” as it has built its trade reputation and good will”. Both these assertions, submits Mr. Sibal, are militating against Mahapatra’s contention that the defendant does not use “NOVAKIND” as its trademark.

**13.** This fact, submits Mr. Sibal, clearly distinguishes the present case from the situation which obtained before the High





Court of Bombay in *Cipla*<sup>3</sup>, as the defendant is using the impugned “Novakind Biosciences Private Limited” mark as its registered trademark, proclaiming it to be so and declaring it to be a source identifier through which it is recognised by doctors and it has earned its reputation and good will.

### **Analysis**

**14.** I have heard learned Counsel for both sides and applied myself to the facts on record as well as the decisions cited at the Bar.

**15.** When used for medicinal preparations, the Supreme Court, in *Amritdhara Pharmacy v. Satya Deo Gupta*<sup>8</sup>, 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. Recognizing this fact, a coordinate bench of this Court has, in fact, in *Mankind Pharma Ltd v. Cadila Pharmaceuticals Ltd*<sup>9</sup>, enjoined the defendant, in that case, from using the mark METROKIND, holding the suffix “KIND” to be a dominant

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<sup>8</sup> AIR 1963 SC 449

<sup>9</sup> (2015) 61 PTC 465



feature of the plaintiff's trademarks.

**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)<sup>10</sup> of the Trade Marks Act,

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<sup>10</sup> **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 –



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 29(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*<sup>3</sup>.

**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*<sup>3</sup> supports the contention that Mr. Mahapatra advances. The Full Bench of the High Court of Bombay in *Cipla*<sup>3</sup> 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)

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(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.



would have no applicability in such a case.

20. Apart from my own judgment in *Novartis*<sup>7</sup>, this Court, speaking much earlier through Hon'ble Justice Dr. S. Muralidhar (as he then was) has, in *Bloomberg*<sup>6</sup>, specifically held that, while Section 29(5) applies in a case where a registered trademark 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*<sup>6</sup> and paras 40 and 41 of *Novartis*<sup>7</sup>, which speak for themselves, thus:

From *Bloomberg*<sup>6</sup>

“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.

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 trademark "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 TM Act 1999 if the conditions attached to Section 29(4) are fulfilled.*

(d) *Given the object and purpose of Section 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*<sup>7</sup>

“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.

**22.** The submission of Mr. Mahapatra that the defendant does not use “Novakind Biosciences Pvt Ltd” as a trade mark is only to be stated to be rejected. The ingredients of a “trade mark”, as envisaged in Section 2 (zb) of the Trade Marks Act, are the following:

- (i) It must be a “mark” as defined in Section 2(m)<sup>11</sup>.
- (ii) It must be capable of being represented graphically.
- (iii) It must be capable of distinguishing goods or services of one person from those of others.
- (iv) In relation to provisions other than those contained in Chapter XII, the mark must indicate a connection in the course of trade between the goods in respect of which it is used and some person having the right to use the mark, with or without any indication of the identity of that person.

**23.** “Mark”, in turn, includes, per definition, a name, signature, word, letter or any combination thereof.

**24.** All the indicia of these definitions stand fulfilled by the mark “Novakind Biosciences Pvt Ltd”. Inasmuch as the mark is

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<sup>11</sup> (m) “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;



used prominently on the strip of the pharmaceutical preparation, Mr. Mahapatra's contention that it is not used in the course of trade can hardly be accepted.

**25.** Resultantly, it is clear that the defendant uses "Novakind Biosciences Pvt Ltd" as a "trade mark" within the meaning of Section 2(zb) of the Trade Marks Act.

**26.** One may also refer, in this context, to Section 2(2)(b) and (c)<sup>12</sup> of the Trade Marks Act, which refer to the circumstances in which a mark can be said to be used within the meaning of said Act. As per the said provisions, the use of a mark shall be construed as a reference to the use of printed or visual representation of the mark, and any reference to the use of a mark shall be construed as a reference to the use of the mark upon or in any relation whatsoever to the goods in respect of which the mark is used. A conjoint appreciation of clause (m) and (z) of Section 2(1) and Section 2(2)(b) and (c) clearly indicate that the defendant uses the mark "NOVAKIND BIO SCIENCES PVT. LTD." as a trade mark in the course of trade in relation to its pharmaceutical products.

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<sup>12</sup> (2) In this Act, unless the context otherwise requires, any reference –

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- (b) to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark;
- (c) to the use of a mark, -
  - (i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;
  - (ii) in relation to services, shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services;





27. In this context, there is also substance in Mr. Sibal's contention that, on facts, the defendant may not be entitled to the benefit of Full Bench of High Court of Bombay in *Cipla*<sup>3</sup>. The representation of the strip of Defzakind, as reproduced in para 5 *supra*, clearly indicate that "Novakind Biosciences Pvt Ltd" is not merely used as on the strip as representing name of the manufacturer of the drug, but is shown as a trade mark as is made quite clear by the use of the ® symbol. Moreover, as Mr. Sibal correctly points out, "Novakind Biosciences Pvt Ltd" is represented in large and prominent white letters on a bold red background and, to an extent, is even more prominent than the brand name of the drug DEFZAKIND itself. It cannot, therefore, be said that "Novakind Biosciences Pvt Ltd" is merely being used by the defendant as part of its corporate name and is not being used a trade mark.

28. This fact clearly distinguishes the present case from the situation which obtained before the Full Bench of the High Court of Bombay in *Cipla*<sup>3</sup>. In the present case, the defendant is using "Novakind Biosciences Pvt Ltd" as a source identifier (as per its own stand in is written statement) and as a trade mark, showing it to be registered by use of the ® symbol and placing the mark boldly and prominently on its strip. The defendant cannot, therefore, escape the clutches of Section 29(2)(b) of the Trade Marks Act by merely pigeonholing its case within Section 29(5).



**29.** The remaining submissions of Mr. Mahapatra are really arguments *in terrorem*.

**30.** The fact that the defendant may, under the Drugs and Cosmetics Act, be statutorily required to affix, on its pharmaceutical products, its company name, is totally irrelevant. The mere fact that the company name has to be affixed on the pharmaceutical product does not justify the defendant using a company name which infringes the registered trade mark of the plaintiff. All that the defendant has to do is to adopt a company name which is non-infringing in nature, and it would be in compliance not only with the Drugs and Cosmetics Act but also with the Trade Marks Act.

**31.** Equally, the submission of Mr. Mahapatra that the pharmaceutical preparations are sold by brand names and not by the name of the company and that they are prescribed and disposed by persons who know their job can also take the defendant's case thus far and no further. The test of deceptive similarity has to be viewed from the point of view of a customer of average intelligence and imperfect recollection. The drug which is dispensed is not merely prescribed by the doctor and dispensed by the chemist; the first person who comes up and asks for the drug is the person who has to consume the drug for being cured of the malady from which she, or he, suffers. The moment, there is possibility of confusion in the mind of such a consumer, the test of deceptive



similarity stands satisfied. Besides, the argument that there was no likelihood of confusion in the case of drugs which were prescribed by doctors and dispensed by chemists stands negated by the Supreme Court in the following passage from ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd***<sup>13</sup>, which also advocates a higher standard of care to be exercised by the Court where confusingly similar marks are used for medicinal products:

“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.***<sup>14</sup> 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.”*

23. In the case of ***Glenwood Laboratories, Inc. v. American Home Products Corpn.***<sup>15</sup> 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*

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<sup>13</sup> (2001) 5 SCC 73

<sup>14</sup> 25 USPQ 2nd, 1473 (TTAB 1993)

<sup>15</sup> 173 USPQ 19 (1972)455 F Reports 2d, 1384 (1972)



*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*<sup>16</sup> (‘it is necessary for obvious reasons, to avoid confusion in the dispensing of pharmaceuticals’), *Campbell Products, Inc. v. John Wyeth & Bro. Inc.* (‘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. Strassenburgh Co. v. Kenwood Laboratories, Inc.*<sup>17</sup> as noted in the decision of *Morgenstern Chemical Co*<sup>18</sup>. 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.”*

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26. *It was further submitted on behalf of the appellant that although the possibility of confusion in a drug being sold across the counter may be higher, the fact that a drug is sold under prescription or only to physicians cannot by itself be considered a sufficient protection against confusion. The physicians and pharmacists are trained people yet they are not infallible and in medicines, there*

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<sup>16</sup> 341, F 2d 934, 936, 52, CCPA 1045, 1047 (1965)

<sup>17</sup> 106 USPQ 379 (1955)

<sup>18</sup> 253 F.2d 390



*can be no provisions for mistake since even a possibility of mistake may prove to be fatal.*

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.*<sup>18</sup> 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*<sup>19</sup> is applicable here:

‘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.

Prevention of confusion and mistakes in medicines is too vital to be trifled with.’

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<sup>19</sup> DC Mo 1954, 118 F Supp 612, 616, 617, 101, USPQ 44, 47, 48



The observations made by Assistant Commissioner Leeds of the Patent Office in *R.J. Strassenburgh Co. v. Kenwood Laboratories, Inc.*<sup>20</sup> 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.*<sup>21</sup>).*"

29. In the book titled as McCarthy on Trade Marks, it is observed in the footnote at pp. 23-70 as under:

*"Physicians and pharmacists are knowledgeable in their fields does not mean they are equally knowledgeable as to marks and immune from*

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<sup>20</sup> [106 USPQ 379 (1955)] USPQ 380

<sup>21</sup> [DCNY 1915, 219 F 325.326]



*mistaking one mark from another.” (Schering Corpn. v. Alza Corpn.<sup>22</sup>)*

30. In the case of *Syntex Laboratories Inc. v. Norwich Pharmacal Co.*<sup>23</sup> it is observed as under:

“Stricter standard in order to prevent likelihood of confusion is desirable where involved trade marks are applied to different prescribed pharmaceutical products and where confusion could result in physical harm to the consuming public.”

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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

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<sup>22</sup> 207 USPQ 504 (TTAB 1980)

<sup>23</sup> 169 USPQ 1 (2nd Cir 1971)



preparations. The same standard has been applied to medical products such as surgical sutures and clavicle splints.”

**32.** The little apothecary, oftentimes not even able to flaunt a medical degree, occupying the little cubbyhole at the street corner, dispensing medicines, is an unfortunate reality in this country. The poor, and those who are unable to afford the services of the more upmarket physician, often people these “clinics”. Many of these “doctors” prescribe medicines based on their manufacturer. Again, it is a well known fact that the same drug, when manufactured by different companies, may work differently, and that, at the very least, with different degrees of efficacy. Thus, without meaning either to extol the plaintiff or denigrate the defendant, a physician, or dispensing chemist, who finds drugs manufactured by the plaintiff especially effective, may prefer them, but may get confused into believing the drugs manufactured by the defendant to be those of the plaintiff, 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.

### **Conclusion**

**33.** In view of the aforesaid, the marks of the plaintiff and the defendant being deceptively similar, and the arguments of Mr.





Mahapatra, to avoid an injunction, having failed to find favour with this Court, the *ad interim* injunction granted by this Court on 20 April 2021 is made absolute pending disposal of the present suit.

**34.** IA 5700/2021 is accordingly allowed and IA 3248/2023 is dismissed.

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**35.** List before the learned Joint Registrar (Judicial) on 8 September 2023, whereafter the matter would be placed before the Court for case management hearing and further proceedings.

**C.HARI SHANKAR, J**

**AUGUST 7, 2023**

*ar/dsn*