IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORIGINAL CIVIL JURISDICTION

INTERIM APPLICATION (L) NO. 14697 OF 2025

IN

COMMERCIAL MISCELLANEOUS PETITION (L) NO. 12147 OF 2025

Abbott Product Operations AG ... Petitioner

Versus

Menschlich Healthcare (OPC) Private Limited & Anr. … Respondents

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Mr. Hiren Kamod a/w Ms. Rupa Shaw i/b. Mr. Atishay Jain for the Petitioner.

Mr. Chander M. Negi - in Person for the Respondent.

CORAM : ARIF S. DOCTOR, J.

RESERVED ON : 27th MARCH 2026

PRONOUNCED ON : 15th JUNE 2026

JUDGMENT:

1. The Captioned Miscellaneous Petition has been filed under the provisions of Sections 47 and 57 of the Trade Marks Act, 1999, ("**the Act**") and seeks rectification/cancellation/removal of the trade mark DUPHACHRIT ("**the impugned mark**") from the Register of Trade Marks. Registration of the

impugned mark was obtained by Respondent No. 1 in Class 5 on 1st July 2021 ("**the impugned registration**").

A Brief Background:

2. It is the Petitioner's case that in the year 1949, the Petitioner's predecessors-in-title, i.e., Dutch Pharmaceuticals, coined and adopted the word 'DUPHAR', which was an acronym for DUTCH Pharmaceuticals, i.e., 'DU' from 'Dutch' and 'PHAR' from 'Pharmaceuticals'. The Petition also sets out that Dutch Pharmaceuticals and the DUPHA marks were successively adopted and owned by various entities and were finally acquired by the Petitioner from Solvay Pharmaceuticals in 2010.

3. During the course of its business, the Petitioner has adopted various trade marks containing 'DUPHA' as an integral part thereof, including but not limited to DUPHASTON, DUPHALAC, DUPHABEARS, DUPHALAC FIBER, DUPHAPRO, DUPHACHEWS, DUPHAACTIVE, DUPHAPLUS, DUPHAR as well as the device marks ' 

', ' 

’(hereinafter referred to as ‘**DUPHA Marks**’). It is the Petitioner’s case that these marks have become well-known among the members of the trade and the public at large and thus constitute the ‘**DUPHA family of marks**’.

4. In order to secure statutory rights in the ‘DUPHA family of marks’, the Petitioner and the Petitioner’s predecessors-in-title have, over the years, applied for and secured registrations of the DUPHA Marks in India. Details of the Petitioner’s various registrations in India have been set out in paragraph 26 of the Petition and copies of the relevant documents pertaining to these registrations, such as the online status pages, registration certificates, and journal copies, as available on the website of the Trade Marks Registry, are annexed as Exhibit “O” to the Petition. Additionally, the Petition also sets out that the Petitioner holds international registrations for the DUPHA Marks, a list whereof is filed with the Petition annexed as Exhibit “M”.

5. A table of the Petitioner’s trade mark registrations in respect of the ‘DUPHA family of marks’ in India is reproduced below:

Trade Mark	Date of Registration	Registration No.	Class
DUPHAR	22.03.1951	148107	05 (Pg. 823)
DUPHASTON	05.10.1960	198281	05 (Pg. 769)
DUPHALAC	24.08.1989	515614	05 (Pg. 775)
DUPHALAC FIBER	26.02.2014	2687844	05 (Pg. 798)
DUPHAPRO	28.11.2017	3689204	05 (Pg. 803)
DUPHABEARS	20.02.2018	IRDI – 3777878	05 (Pg. 809)
	15.11.2019	4348989	05 (Pg. 812)
	15.11.2019	4348988	05 (Pg. 818)

As is evident from the above, the Petitioner's earliest trade mark registration in India in respect of DUPHAR in class 5 is dated 22nd March 1951.

6. The Petition also sets out that the Petitioner markets and sells under the registered trade mark DUPHASTON, a dydrogesterone preparation (an oral form of progesterone) which is one of the Petitioner's well-known and widely sold products. The Petitioner has, in support, set out the Petitioner's

worldwide and Indian annual sales figures in respect of DUPHASTON, which for the year 2023 alone, were more than $487 million and Rs 324 crore, respectively.

7. Additionally, the Petition also sets out that the Petitioner has managed to garner substantial sales with respect to its products sold under the trade mark DUPHALAC. The sales figures with respect to the DUPHASTON and DUPHALAC marks in India and overseas for the period 2013 until 2023 have been set out in paragraphs 34 and 40 of the Petition, respectively, and are duly supported by an Affidavit of the Petitioner's representative deposing to the correctness of the global sales figures and the Petitioner's Chartered Accountant certifying the correctness of the Indian sales figures. The Petitioner has also placed reliance upon material to demonstrate that the Petitioner's products under the DUPHA Marks are extensively promoted throughout the world and in India and has in paragraphs 46 and 47 of the Petition set out the promotional expenditure incurred by the Petitioner in respect of the trade marks DUPHASTON and DUPHALAC in India for the

period 2013 till 2023, which is also duly certified by a chartered accountant.

8. The Petitioner has also set out the steps taken to protect its intellectual property rights in the 'DUPHA family of marks' to demonstrate that it has been extremely vigilant and zealous in protecting those rights. Details of some of the actions initiated in India with respect to the DUPHA Marks before the Courts and Trade Marks Registry are set out in paragraph 59 of the Petition.

Facts Leading to the Present Petition:

9. It is the Petitioner's case that in August 2024, the Petitioner became aware of the impugned mark and, therefore, issued a cease-and-desist notice dated 12th August 2024, calling upon Respondent No. 1 to, *inter alia,* voluntarily cancel the impugned registration by filing an appropriate request/application before Respondent No. 2. Respondent No. 1, however, in emails dated 29th August 2024 and 2nd September 2024, without providing any explanation to support the bona fide adoption of the impugned mark, stated that the rival marks were phonetically dissimilar and therefore refused to comply with the

cease-and-desist notice.

10. It is, in the backdrop of the above facts, that the present Petition came to be filed under the provisions of both Sections 47 and 57 of the Act. However, Mr Kamod, learned counsel appearing on behalf of the Petitioner, has advanced submissions only under Section 57 and has not advanced any submissions under Section 47 of the Act.

I. Deceptive Similarity of the Rival Marks -

11. Mr Kamod, at the outset, submitted that the Petitioner is the registered proprietor of as many as eight (8) word marks, all in Class 5 and all of which have 'DUPHA' as a prefix. He submitted that in light of the aforesaid word mark registrations and on account of the Petitioner's open, continuous, and extensive use of the said marks, the Petitioner had developed a family of marks with the word 'DUPHA' being an essential part thereof.

12. He then submitted that the word 'DUPHA' was neither generic nor descriptive and had no relation whatsoever to any pharmaceutical or medicinal products. He also submitted that due to the Petitioner's open,

continuous and extensive usage, the DUPHA Marks have come to be exclusively associated with the Petitioner and that the Petitioner has acquired immense goodwill and reputation in the pharmaceutical industry in respect of the 'DUPHA family of marks'.

13. Mr. Kamod submitted that the Petitioner has been constrained to file the present Petition since the impugned mark, i.e., DUPHACHRIT, was phonetically, aurally, structurally and visually deceptively similar to several of the word mark registrations obtained by the Petitioner such as DUPHASTON, DUPHALAC, DUPHALAC FIBER, DUPHAPRO, DUPHAACTIVE, DUPHAPLUS, and DUPHAR, as well as the device marks, i.e.,  and  . He submitted that all that Respondent No. 1 had done was to merely substitute the suffix used in the Petitioner's DUPHA Marks with the word/letters 'CHRIT' to form the impugned trade mark 'DUPHACHRIT'. He submitted that such a minuscule change did not, in any manner, make the impugned trade mark distinctive and/or dissimilar to the Petitioner's DUPHA family of trade marks and,

therefore, submitted that there existed a high likelihood that a customer of average intelligence and imperfect recollection would believe that DUPHACHRIT was a part of the Petitioner's 'DUPHA family of marks'. Alternatively, he submitted that a consumer of average intelligence and imperfect recollection would likely carry the impression of there being an association between the impugned mark and the Petitioner's 'DUPHA family of marks'.

14. Mr. Kamod then placed reliance upon the decision of the Hon'ble Supreme Court in ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.,***[1] to point out that the relevant factors to be taken into consideration when assessing deceptive similarity were (**i**) the nature of the marks; (**ii**) the degree of resemblance, phonetically and in idea; (**iii**) the nature and similarity of the goods; and (**iv**) the class of purchasers, their education, intelligence, and the degree of care they are likely to exercise when purchasing the products in question. He submitted that when all these factors were taken into account and applied to the facts of the

[1] 2001 (5) SCC 73.

present case, the same could only lead to the inevitable conclusion that the impugned mark, i.e., DUPHACHRIT, was deceptively similar to the Petitioner's 'DUPHA family of marks' and that their concurrent use would lead to deception and confusion amongst the members of the public and trade alike.

II. Stricter Standard Applicable to Pharmaceutical Trade Marks -

15. Mr. Kamod then also placed reliance on the decision of the Division Bench of this Court in ***Macleods Pharmaceuticals Ltd. v. Union of India,***[2] to point out that this Court had, following the decision of the Hon'ble Supreme Court in ***Cadila*** on the aspect of deceptive similarity of medicinal/pharmaceutical products inter alia held as follows, viz.

> *"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***.

[2] 2023 SCC OnLine Bom 408.

(b) ***Confusion in case of a non-medicinal or a non-pharmaceutical 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 pronouncements of Court from time to time.*

Meticulous comparison is not the correct way.

Mark must be compared as whole.

First impression.

Prima facie view is not conclusive.

Structural resemblance.

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***." (Emphasis Added)

Basis the above and given the deceptive similarity between the rival marks, he submitted that there could be no manner of doubt that there would be both confusion amongst customers and also the likelihood of association of the Respondent's product with that of the Petitioner's and therefore the requirements of Sections 11(1), 11(2), 11(3), and 11(10)(ii) of the Act were adequately satisfied. He thus submitted that the impugned mark was liable to be treated as an entry wrongly made and wrongly remaining on the Register of Trade Marks.

III. Dishonest Adoption of the Impugned Mark by Respondent No. 1 -

16. Mr. Kamod submitted that it was a matter of record that the Petitioner is the prior registered proprietor of the DUPHA Marks and reiterated that the Petitioner's earliest trade mark registration in class 5 dates back to 22nd

March 1951. He submitted that since the 1960s the Petitioner has been openly, continuously, and extensively using the DUPHA Marks in respect of medicinal and pharmaceutical preparations and has achieved sales of hundreds of crores of rupees.

17. Mr. Kamod also submitted that the Courts in India had taken judicial notice of the fact that prior to adopting a trade mark it is incumbent upon the party/person who is adopting a mark to undertake a search in the records of the Trade Marks Registry and that a party who does not do so cannot claim that the adoption of a mark was bonafide. He, therefore, submitted that it was not open for Respondent No. 1 to feign ignorance of the Petitioner's prior statutory rights in the registered DUPHA Marks and/or the existence of the Petitioner's products available in the market bearing the DUPHA Marks. He also submitted that it cannot be a matter of coincidence that Respondent No. 1 had adopted an identical and/or deceptively similar trade mark to the Petitioner's 'DUPHA' family of marks, and that too, in respect of a medicinal and/or pharmaceutical preparation, which was identical to the

Petitioner's popular and widely selling product 'DUPHASTON'. He thus submitted that it was clear that the adoption of 'DUPHACHRIT' by Respondent No. 1 was ex-facie dishonest and only to ride upon the Petitioner's immense goodwill and reputation so that Respondent No. 1 could profit from the same.

18. Mr. Kamod then submitted that the dishonesty of Respondent No. 1 was also manifest from the fact that Respondent No. 1 had not given any cogent explanation for adopting the impugned mark. He pointed out that Respondent No. 1 had only made a flippant attempt to justify such adoption by stating that Respondent No. 1 has eighteen (18) registered trade marks all of which contain the suffix 'CHRIT'. He, however, pointed out that Respondent No. 1 had not offered any cogent explanation for adopting 'DUPHA'. He therefore reiterated that Respondent No. 1 had merely affixed 'DUPHA' before 'CHRIT' to create the impugned mark, solely to bring it as close as possible to the Petitioner's 'DUPHA family of marks'. He submitted that such conduct was patently dishonest and had been expressly frowned

upon by the Delhi High Court in the case of ***Suzuki Motor v. Suzuki (India) Ltd***.[3] which, he pointed out, had taken judicial notice of the tendency of parties to somehow explain a dishonest adoption and held that even if such an explanation were found to be tenable, the same would not come in the way of the Court stopping the use of such a copied trade mark.

19. He submitted that the Petitioner had been using its prior, registered trade mark 'DUPHASTON' in respect of dydrogesterone preparations since at least 1980, thereby establishing long-standing use, goodwill, and reputation in relation to the said pharmaceutical compound dydrogesterone. In contrast, he submitted that Respondent No. 1 had applied for registration of the impugned mark 'DUPHACHRIT' on a "proposed to be used" basis and had only recently, if at all, commenced use thereof. He submitted that the adoption of the impugned mark, incorporating the distinctive prefix 'DUPHA', in respect of identical goods, namely, dydrogesterone preparations, could not be a matter of coincidence since Respondent No. 1

[3] 2019 SCC OnLine Del 9241.

was operating in the same field as the Petitioner and would therefore necessarily have been aware of the Petitioner's prior and extensive use of the trade mark 'DUPHASTON'. In these circumstances, he submitted that the adoption of the impugned mark by Respondent No. 1 was clearly dishonest and with the sole intention of riding upon the goodwill and reputation of the Petitioner.

IV. Public Interest and Purity of the Register -

20. Mr. Kamod, then on the aspect of public interest and purity of the register, submitted that when a trade mark is likely to deceive or cause confusion, the proceedings cease to be a private dispute between rival traders and becomes a matter of public interest. In such circumstances, he submitted that it is the Court's primary duty to ensure that public interest is best subserved and that the purity of the Register is maintained. In support of his contention, he placed reliance upon the decision of the Division Bench of this Court in ***Ciba Ltd. Basle Switzerland v. M. Ramalingam and S. Subramaniam,***[4] from which he

[4] 1957 SCC OnLine Bom 45.

pointed out that the Court must protect the public irrespective of any hardship it may cause to the party whose mark is likely to deceive or cause confusion since the object of the Register is to ensure that the public is aware of the source of the goods in question. He submitted that, given the deceptive similarity between the impugned mark and the Petitioner's 'DUPHA family of marks', the continued presence of the impugned mark on the Register in respect of identical pharmaceutical goods posed a tangible risk to public health and undermined the sanctity of the Register. He thus submitted that the impugned mark should be removed from the Register of Trade Marks in the public interest.

Submissions on behalf of Respondent No. 1:

21. Mr. Negi, a Director of Respondent No. 1, appearing in person after obtaining the requisite permission at the outset, pointed out that the Petitioner does not have registration of the standalone mark 'DUPHA', nor has the same ever been assigned and/or transferred to the Petitioner. He submitted that the Petitioner had in fact applied for the registration of the standalone DUPHA mark, which was still pending, and therefore it was not open to the Petitioner to claim any

exclusivity over the word ‘DUPHA’. He therefore submitted that the present petition was nothing but an attempt on the part of the Petitioner to secure a monopoly over ‘DUPHA’ irrespective of the well-settled principles governing trade mark law.

22. Mr. Negi submitted that the real question which falls for determination in these proceedings was whether the impugned mark had wrongly been entered on the Register as on the date of the grant of its registration and not whether the mark was objectionable today. He then pointed out that the impugned mark had been duly examined by the Trade Marks Registry by following the prescribed procedure, after which registration thereof was granted. He therefore submitted that it could not be suggested that the registration of the impugned mark was an entry that was wrongfully made on the Register. He submitted that a subsequent grievance the Petitioner might now have cannot be retrospectively applied to invalidate a lawful registration. Mr. Negi then laid great emphasis on the fact that the Petitioner had failed to oppose the registration of the impugned mark, despite the fact that it was advertised in the Trade Marks Journal. He therefore

submitted that the Petitioner could not take advantage of its own inaction and now seek cancellation of the impugned mark or rectification of the Register when the Petitioner had not opposed the registration of the impugned mark.

No Exclusive Rights in DUPHA – Section 17 and Anti-Dissection -

23. Mr. Negi then submitted that the Petitioner's entire case rested upon an exercise which was impermissible in law, i.e., dissection of the Petitioner's registered marks by isolating the prefix 'DUPHA' from the composite marks of which registration had been granted to the Petitioner. He invited my attention to Section 17 of the Act, to point out that the effect of registration confers upon a proprietor exclusive rights in the mark as a whole and not in any of its components or elements. He therefore submitted that the Petitioner having obtained several word mark registrations which had 'DUPHA' as a part thereof, would not, by itself, confer upon the Petitioner any enforceable monopoly over 'DUPHA', unless the Petitioner could establish that 'DUPHA' was separately registered and independently recognised by the public as a source identifier. In

the facts of the present case, he submitted that neither of these conditions was satisfied.

24. Mr. Negi then also submitted that there had been no express assignment or transmission to the Petitioner of the prefix 'DUPHA' as an independent trade mark. He submitted that it was only the composite marks, such as DUPHALAC and DUPHASTON, which were transferred to the Petitioner on acquisition of Solvay's pharmaceutical operations in 2010. He submitted that, in the absence of any independent registration or an express assignment of the prefix 'DUPHA', the Petitioner cannot claim any enforceable right in it. He also submitted that since the Petitioner had applied for standalone registration of 'DUPHA' in the year 2020, which application was still pending, the Petitioner could not assert any exclusive right or claim a monopoly over 'DUPHA'.

Fragmentation of the Alleged 'DUPHA Family' in 1996 and 2010 -

25. Mr. Negi submitted that even if the Petitioner's predecessor-in-title, i.e., Solvay Pharmaceuticals, was accepted as having built a family of DUPHA formative marks, that family was irreversibly destroyed by the deliberate and voluntary

fragmentation of ownership of the said marks, first in 1996 and again in 2010. He pointed out that in 1996, Solvay's animal health division was sold, and several DUPHA-formative marks, including DUPHASPASMIN, DUPHAMOX, DUPHATRIM, and DUPHACYCLINE, were assigned to entities entirely independent from the Petitioner. He also pointed out that in the year 2010, when the Petitioner acquired Solvay's pharmaceuticals operations, the Petitioner only received the specific marks forming part of the business division of Solvay's human health (pharmaceutical) operations, namely DUPHALAC and DUPHASTON, and not the DUPHA-formative marks that had already been assigned to third parties.

26. He also submitted that a family of trade marks, as a legal concept, necessarily presupposes single ownership and unified control over all marks constituting such a family. He submitted that where the original proprietor had fragmented and dispersed the constituted marks across different independent entities, the legal consequence was that no single successor could thereafter claim to be the proprietor of such a family of trade marks as a whole since the family as a legal

unit had ceased to exist. He submitted that the Petitioner, having succeeded only to a portion of the fragmented rights, could not seek to revive any claim of exclusivity over a prefix that had long been common to multiple independent owners.

27. In the aforesaid context, he submitted that this fragmentation was not a matter of inference but was demonstrated by the Register itself, which, at page 1615 of the Counter Affidavit, showed the DUPHA-formative marks registered in the names of different companies, including DUPHASOL, which was registered in favour of an entity other than the Petitioner or any predecessor as early as 1954. He thus submitted that the Petitioner cannot claim to be the first user of the prefix 'DUPHA' when marks with that prefix were on the Register years before several of the Petitioner's own DUPHA-formative registrations.

DUPHA is a *Publici Juris* -

28. Mr. Negi then submitted that the prefix 'DUPHA' was common to the pharmaceutical trade, having been used by multiple independent entities for decades, and was therefore incapable of any exclusive appropriation. He

pointed out that the Trade Marks Register disclosed more than 90 marks with the ‘DUPHA’ prefix standing in the names of multiple companies. He also pointed out that a prominent international pharmaceutical trade exhibition has been conducted for several years under the name 'DUPHAT', with participation from over 100 countries, at which the Petitioner itself was a regular exhibitor. He submitted that this made evident the Petitioner's awareness and tacit acceptance of the widespread use of the ‘DUPHA’. He then placed reliance upon the decision in the case of ***F. Hoffmann-La Roche & Co. Ltd. v. Geoffrey Manners & Co. (P) Ltd.***[5], to submit that similarity of a common prefix alone cannot establish infringement and that marks must be evaluated in their entirety and in their commercial context. He pointed out that in the said case, the rival marks were ‘DROPOVIT’ and ‘PROTOVIT’, which were held to be dissimilar since “VIT” was held to be common to the trade in the pharmaceutical industry to denote vitamins, and the prefixes, i.e., ‘DROPO’ and ‘PROTO’, were held to be sufficiently dissimilar. He submitted that this decision would squarely apply,

[5] (1969) 2 SCC 716.

since the suffix 'CHRIT' was entirely dissimilar from any of the Petitioner's 'DUPHA family of marks'

Marks must be compared as a whole -

29. Mr. Negi then pointed out from the decision in the case of ***Cadila,*** upon which the Petitioner had placed reliance, that it was well settled that marks must be compared as a whole and not by dissecting their individual components. He submitted that any common prefix shared between pharmaceutical marks does not automatically give rise to confusion and pointed out that when the impugned mark DUPHACHRIT is considered in its entirety, as it must be, it is visually, phonetically, and structurally distinct from each of the Petitioner's DUPHA Marks. He reiterated that the suffix 'CHRIT' creates a wholly different aural and visual identity, dominating consumer perception and serving to identify the product in question.

30. He submitted that the Petitioner's own admissions supported the abovementioned contention and pointed out that the Petitioner simultaneously markets multiple products, including DUPHASTON, DUPHALAC,

DUPHAPRO, DUPHABEARS, and others, all bearing the same prefix 'DUPHA'. He also pointed out that these products co-exist in the market under the Petitioner's ownership without any confusion between them *inter se*. He then pointed out that the Petitioner had, at paragraph 23 of the Petition, stated that 'DUPHA' is "*suffixed with additional elements mostly to distinguish the medication for treatment of various ailments*", which, according to him, was a clear admission of the fact that it is the suffix that conveys product identity and distinguishes one DUPHA-formative mark from another.

31. He therefore submitted that a Petitioner who accepts that its own products sharing the same prefix co-exist in the market without confusion cannot simultaneously contend that the use of that very prefix by a third party gives rise to a likelihood of confusion. Mr. Negi then submitted that Respondent No. 1 had independently built a distinct commercial identity in the market through its family of more than twenty-five (25) products with the suffix 'CHRIT/CRIT'. He submitted that all the twenty-five products of the Respondent bearing the suffix 'CHRIT/CRIT' were registered as trade marks

and that a physician familiar with the products of Respondent No. 1 would immediately associate the suffix 'CHRIT' with Respondent No. 1.

32. Mr. Negi did not deny that the Court's primary duty is to the public. He, however, submitted that the Petitioner's reliance upon the decision in ***Ciba Ltd. Basle Switzerland,*** in the facts of the present case, was entirely misplaced since protection of public interest required the Court to assess the marks holistically and in their commercial setting. He submitted that any such inquiry did not, however, extend to permitting a party to claim a monopoly over a prefix that is demonstrably common to the trade. He submitted that applying the principle of public interest would result in granting the Petitioner a monopoly over 'DUPHA' would in fact harm the public by stifling legitimate competition, as it is based on a prefix that has never been under the exclusive control of any single entity.

33. He placed reliance upon the decision of this Court in ***Century 21 Real Estates LLC v. Century 21 Town Planners Pvt. Ltd.***[6] to point out that even where the

[6] Order dated 6th March 2026 in COMMP No. 857 OF 2022 passed by Bombay High Court.

dominant part of two marks is identical, the overall commercial impression remains the decisive factor, and confusion is not to be assumed automatically. He submitted that this principle, which is directly applicable to rectification proceedings, militates strongly against the Petitioner's case, which seeks to achieve exactly such an automatic inference of confusion based solely on a shared prefix. He then also pointed out that even in the case of ***Macleods Pharmaceuticals Ltd., v. Union of India***[7]**,** wherein it was held that the overall commercial impression remains the decisive factor and that this was consistent with the primary contention that 'DUPHACHRIT', when assessed as a whole, was clearly distinct from the Petitioner's marks.

Honest and Bona Fide Adoption -

34. Mr. Negi submitted that the adoption of the mark 'DUPHACHRIT' by Respondent No. 1 was honest, bona fide, and consistent with the trade practice prevailing in the pharmaceutical industry. He submitted that Respondent No. 1 entered the dydrogesterone market when the active pharmaceutical ingredient

[7] 2023 SCC OnLine Bom 408.

became commercially available around 2019-2020, having previously been available only through the Petitioner's proprietary manufacturing processes. He submitted that in researching this market, Respondent No. 1 found that the prefix ‘DUPHA’ was common to multiple pharmaceutical entities and was not associated exclusively with any single company. It was thus submitted that Respondent No. 1 adopted 'DUPHACHRIT' as a composite mark, combining a common prefix with its own established and distinctive suffix 'CHRIT', and thereafter obtained statutory registration in 2021 following examination by the Trade Marks Registry.

35. He submitted that the Petitioner’s reliance upon the decision in ***Suzuki Motor v. Suzuki (India) Ltd.*** was not applicable to the facts of the present case because in that case the marks were identical, which was admittedly not so in the present case where the shared element was only the prefix ‘DUPHA’, which was not under the exclusive ownership of the Petitioner. He pointed out that the Delhi High Court, in the said decision, held that the context and overall identity matter and that the enquiry is not confined to a single shared element. He

therefore submitted that the decision, far from assisting the Petitioner, in fact supported the case of Respondent No. 1, i.e., that the marks must be assessed in their entirety.

36. He then also submitted that the impugned mark does not in any manner imitate the Petitioner's trade dress, packaging, or any suffix used by the Petitioner, a fact that the Petitioner had accepted in the Petition itself. He pointed out that bad faith cannot be presumed from (i) the mere adoption of a prefix that is common to the trade, (ii) has been fragmented across multiple entities by the Petitioner's own predecessor, and (iii) in respect of which the Petitioner itself sought independent registration as recently as 2020. He submitted that the Petitioner's goodwill in its composite marks was also not disputed but submitted that the goodwill in a composite mark cannot be converted into a statutory right over a fragment of that mark which was never independently assigned or registered.

Suppression of Material Facts -

37. Mr. Negi then submitted that the Petitioner had not approached this Court with clean hands and had suppressed (i) the fact that several DUPHA-formative marks had been fragmented and assigned by the Petitioner's predecessor to third parties in 1996, including DUPHASPASMIN, DUPHAMOX, DUPHATRIM, and DUPHACYCLINE; (ii) the extensive third-party use of the prefix 'DUPHA' in the pharmaceutical trade over several decades, including the existence of the DUPHASOL registration in favour of a third party since 1954, pre-dating several of the Petitioner's own DUPHA-formative registrations; and (iii) that the Petitioner had also not disclosed the application made in the year 2020 for standalone registration of ‘DUPHA’, which directly contradicts the Petitioner's case that it has always enjoyed exclusive rights to the prefix 'DUPHA'. He submitted that these omissions go to the very root of the Petitioner's claim of exclusivity and disentitle the Petitioner to the equitable relief it seeks. In support of his contention, he placed reliance upon the decision of the Hon'ble

Supreme Court in ***Dalip Singh v. State of Uttar Pradesh***[8], from which he pointed out that a litigant who approaches the Court with unclean hands is not entitled to any discretionary relief.

38. Basis the above Mr. Negi submitted that the Petition ought to be dismissed.

Submissions in Rejoinder:

Prescription/Schedule H Drugs – No Protection against Confusion -

39. Mr. Kamod, in rejoinder, submitted that the contention of Respondent No. 1, that no confusion could arise since the rival goods were sold only under prescription, was entirely untenable in view of the decision of the Hon'ble Supreme Court in ***Cadila.*** He pointed out that in the case of ***Cadila***, the Hon'ble Supreme Court had taken judicial notice of the fact that (i) prescriptions had lost their significance in India and had noted that Schedule H drugs were in fact regularly sold over the counter without prescriptions; (ii) physicians, doctors, and chemists were not immune to confusion or to committing errors; (iii) that consumers in India often place orders for prescription drugs with chemists over

[8] (2010) 2 SCC 114.

the telephone; and (iv) handwritten prescriptions are often difficult to read. He pointed out that these factors only served to enhance, not diminish, the likelihood of confusion and deception, particularly in the facts of the present case where the rival marks are phonetically, aurally, visually, and structurally deceptively similar.

40. Mr. Kamod then submitted that the present proceedings were for rectification and cancellation of a trade mark registration under Section 57 of the Act and were not proceedings for either infringement or passing off. He pointed out that in rectification proceedings, only the impugned mark as registered was to be compared with the Petitioner's registered 'DUPHA family of marks' and nothing else. He submitted that the packaging, get-up, or pricing of the goods bearing the rival marks were all factors that were wholly irrelevant for the purposes of the present proceedings. He reiterated that the impugned mark was plainly deceptively similar to the Petitioner's family of 'DUPHA' marks, and the goods in respect of which the rival marks were used were also identical. He thus submitted that these factors were *ipso facto* sufficient for this Court to arrive at

a finding that the registration of the impugned trade mark would lead to confusion and deception amongst consumers and members of the trade.

Third Party Marks – Estoppel, Burden of Proof, and Absence of Evidence -

41. Mr. Kamod then submitted that the Petitioner's statutory and common law rights in the family of DUPHA marks remained wholly unaffected by the existence of third-party marks on the Trade Marks Register. He further pointed out that several of the marks relied upon by the Respondent had, in fact, been withdrawn, refused, or abandoned. He then also placed reliance upon the decision of this Court in ***Pidilite Industries Ltd. v. Riya Chemy***[9] to point out that a party who applies for or has obtained registration of a mark is estopped from urging that the mark, or its essential and prominent feature, is common to the trade or incapable of registration. He submitted that Respondent No. 1, having secured registration of the impugned mark 'DUPHACHRIT', was therefore estopped from contending that 'DUPHA' was common to the trade.

[9] 2022 SCC OnLine Bom 5077.

42. Mr. Kamod also submitted that it was well settled that the mere presence of a mark in the market or on the Register of Trade Marks is not by itself sufficient to establish that a mark is common to the trade. He submitted that, to successfully raise such a defence, the party alleging that the mark is common to the trade must produce substantial evidence showing the actual and extensive use of that mark by third parties and that merely producing search reports or online case status in respect of certain marks on the register does not constitute evidence that such marks are actually being used or are available in the market. He submitted that the burden of proving such alleged use by third parties lies on the party who asserts and/or relies upon the same. In support of his contention, he placed reliance upon the decision of the Hon'ble Supreme Court in the case of ***Corn Products Refining Co. v. Shangrila Food Products Ltd***.[10]

43. Mr. Kamod pointed out that in the present case Respondent No. 1 had not placed any material on record to demonstrate that any of the cited third-party marks enjoy any commercial use or goodwill. On the contrary, he submitted that

[10] 1959 SCC OnLine SC 11.

the material on record indicated that several of those marks had been withdrawn, refused, abandoned, or opposed. He therefore submitted that Respondent No. 1 cannot seek to justify the adoption of the impugned mark by relying upon stray or unsupported entries appearing in the Register of Trade Marks.

44. In dealing with the decision in ***F. Hoffmann-La Roche & Co. Ltd.***, he submitted that the said decision was clearly distinguishable, since the defendant in that case had produced substantial and extensive evidence to demonstrate that the word ‘VIT’ was a well-known and commonly used abbreviation for vitamins in the pharmaceutical trade. He submitted that in the present case, Respondent No. 1 had not produced any comparable evidence whatsoever to show that ‘DUPHAR’ or 'DUPHA' were well-recognised abbreviations and/or were either descriptive or generic in any manner in the pharmaceutical trade. He thus submitted that the said decision was of no assistance to Respondent No. 1.

Fragmentation is not established either in law or on facts -

45. Mr. Kamod then submitted that as long as the Petitioner is the registered proprietor of the 'DUPHA' marks and as long as the Petitioner's trade mark registrations are valid and subsisting, any allegation of fragmentation of rights is wholly irrelevant. He submitted that the contention that the alleged sale of Solvay's animal health (veterinary) business to AHP Corp in 1996 fragmented the DUPHA Marks across different entities was misleading, as the transaction pertained only to the sale of a specific business division and did not establish any assignment or transfer of proprietary rights in the DUPHA Marks. He thus submitted that this contention ought to be rejected.

'DUPHAR' is a coined term – not a word of common language -

46. Mr. Kamod reiterated that DUPHAR is a coined term and is not generic or descriptive, having been coined as Dutch Pharmaceuticals, and that Respondent No. 1 had failed to produce an iota of evidence to show that the trade mark DUPHAR was not coined or distinctive. Furthermore, he submitted that the Petitioner was not seeking protection over any word of common language but over the registered trade mark 'DUPHAR' and the 'DUPHA' family of marks,

which are arbitrary and bear no relation to medicinal or pharmaceutical products.

47. He reiterated that the present proceedings were filed under Section 57 of the Act and were not proceedings for infringement and/or passing off and that merely because a word is used in common language does not make it generic or descriptive in relation to all goods or services. To illustrate his point, he gave the example of the trade mark 'APPLE', which, he submitted, was descriptive in relation to fruits and vegetables but was entirely arbitrary and distinctive when used in relation to electronic goods. He thus submitted that the contention of Respondent No. 1 on this ground was entirely without merit.

Delay is not a relevant factor under Section 57 -

48. Mr. Kamod submitted that the ground of alleged delay taken by Respondent No. 1 to oppose the Petition was also wholly misconceived since no time limit was prescribed under Section 57 of the Act. It was thus that he submitted that even assuming there was some delay, such delay would not *ipso facto* be a ground to deny the Petitioner relief if the Petitioner had otherwise made out a case under

Section 57. He pointed out that while Respondent No. 1 had made claims regarding the alleged use of the impugned mark, Respondent No. 1 had failed to produce even a single document demonstrating any actual use of the impugned mark, nor had Respondent No. 1 disclosed any sales figures, annual turnover, or advertisement and promotional expenses. He submitted that the absence of any such documents was telling of the fraudulent nature of the claim made by Respondent No. 1. Mr. Kamod also submitted that in the absence of any evidence of use of the impugned mark by Respondent No. 1, this Court ought to draw an adverse inference against Respondent No. 1, and therefore no equities could be claimed by Respondent No. 1. Conversely, he pointed out that Petitioner's rights in the 'DUPHA family of marks' could be traced back to the year 1949 when its predecessors-in-title first coined and adopted the mark DUPHAR, and that registrations and use of the DUPHA-formative marks in India date back to at least 1951 and 1960, respectively. He submitted that such rights devolved upon the Petitioner through the succession of title from Philips-Duphar B.V. and Solvay Pharmaceuticals. He thus submitted that the

Petitioner had valuable statutory and common law rights in the 'DUPHA family of marks', and therefore the equities and the balance of convenience were entirely in favour of the Petitioner.

49. Mr. Kamod, then, in dealing with the decisions upon which reliance was placed by Respondent No. 1, submitted that they would be of no assistance to Respondent No. 1. As regards the decision of the Hon'ble Supreme Court in ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.,*** Mr. Kamod submitted that the observations made therein would in fact assist the Petitioner's case. He pointed out that ***Cadila Health Care Ltd*** not only enumerates the factors for assessing deceptive similarity but also specifically holds that a stricter standard and a lesser quantum of proof apply in pharmaceutical trade mark disputes, a position that squarely favours the Petitioner.

Reasons and Conclusions:

50. After having heard Mr. Kamod for the Petitioner and Mr Negi on behalf of Respondent No. 1, and having considered the material upon which reliance has

been placed as well as the case law cited, I have no hesitation in holding that the Petition deserves to be allowed. I say so for the following reasons.

A. It is not in dispute that the Petitioner is the prior registered proprietor of as many as eight word mark registrations, all of which are valid and subsisting and each of which has 'DUPHA' as a prefix/part thereof. Also, 'DUPHA' is neither generic nor descriptive of medicinal/pharmaceutical products and is clearly an acronym for 'Dutch Pharmaceuticals'. The impugned mark, i.e., ‘DUPHACHRIT’, and the Petitioner’s ‘DUPHA family of marks' are all in class 5 and are in respect of pharmaceutical products. Crucially, the products sold under the impugned mark and the Petitioner’s mark 'DUPHASTON' contain the identical active pharmaceutical ingredient, i.e., dydrogesterone. Equally crucial is the fact that Respondent No. 1 has admitted to adopting 'DUPHA' on the basis that several companies use 'DUPHA'. Also it is not in dispute that the adoption of the impugned mark by Respondent No. 1 was only in the year 2021, whereas the Petitioner’s earliest registration dates back to the year 1951. The Petitioner’s sales of ‘DUPHALAC’ and ‘DUPHASTON’ run into several

hundreds of crores of rupees, whereas Respondent No. 1 has failed to show any commercial benefit or substantial use of the impugned mark.

B. The Hon'ble Supreme Court has in the case of ***Cadila*** held that for determining the aspect deceptive similarity between rival pharmaceutical marks what is to be considered is (i) the degree of visual, phonetic and structural similarity between the rival marks and the overall impression created by such rival marks; (ii) the nature of the goods in respect of which the rival marks are used; (iii) the class of purchasers who are likely to purchase and/or consume the products sold under the rival marks; and (iv) the mode of purchase and the circumstances in which the goods are marketed, sold or dispensed, including whether they are prescription drugs or products available over the counter.

C. <u>*Crucially*</u>, the Hon'ble Supreme Court has, in the case of ***Cadila*** also specifically noted that, particularly in cases involving medicinal and pharmaceutical products, a stricter approach must be adopted while assessing deceptive similarity since any confusion between medicinal products may have

serious and even disastrous consequences. Crucially, it was held that when it comes to medical and pharmaceutical products, even the possibility of confusion must be avoided since "*in cases involving medicinal products, the test to be applied for addressing the question of deceptive similarity is not at par with cases involving other products, and the Courts should be particularly vigilant because confusion between medicinal products may have disastrous consequences for the health and even the life of the patient.*"

D. Also, the Division Bench of this Court in the case of ***Macleods Pharmaceuticals*** laid down that, when ascertaining deceptive similarity in the context of medicinal and pharmaceutical products, the rival marks must be compared as a whole from the standpoint of a person of average intelligence and imperfect recollection since it is the overall commercial impression created by the rival marks, including their prominent and essential features, structural and phonetic similarity, and the first impression conveyed to a consumer that constitutes the determinative factors. It is therefore on this basis that the

impugned mark ‘DUPHACHRIT’ must be compared with the Petitioner’s ‘DUPHA family of marks’.

E. Applying the tests as laid down in ***Cadila*** and ***Macleods,*** to my mind, there can be no manner of doubt that the impugned mark ‘DUPHACHRIT’, when considered as a whole, is phonetically, aurally, structurally, and visually deceptively similar to the Petitioner’s ‘DUPHA family of marks’ especially ‘DUPHASTON’. Importantly, the impugned mark and the Petitioner’s ‘DUPHA family of marks' are all used in respect of pharmaceutical products and are all registered in Class 5. Crucially, the impugned mark ‘DUPHACHRIT’ and the Petitioner’s mark 'DUPHASTON' both contain the identical active ingredient, i.e., dydrogesterone.

F. It is clear that in coining and adopting the impugned mark, Respondent No. 1 has simply taken 'DUPHA' and added the suffix ‘CHRIT’. The contention of Respondent No. 1 that the suffix 'CHRIT' is enough to distinguish the impugned mark from the Petitioner’s ‘DUPHA family of marks’ in my view only needs to be stated to be rejected since the entire identity and association with the

Petitioner's products is based on the prefix 'DUPHA', which forms an integral and is a consistent part of the Petitioner's 'DUPHA family of marks' and the real source identifier of the Petitioner's products.

G. In light of the above, there is no gainsaying that the Petitioner also uses different suffixes to identify different medicinal or pharmaceutical products to justify 'CHRIT' as being a distinguishing factor. Such contention deliberately seeks to overlook the fact that the association of the impugned mark with the 'DUPHA family of marks' is immediately drawn by the use of 'DUPHA', and hence the suffix is entirely immaterial for the purpose of association with the Petitioner. Hence, in my view, therefore, the decision of the Hon'ble Supreme Court in the case of ***Suzuki Motor Corporation*** would squarely apply, since such a minor variation does not render the impugned mark either distinctive or sufficiently dissimilar from the Petitioner's 'DUPHA family of marks'.

H. Also, the contention that the products sold under the rival marks are both prescription drugs and thus the question of confusion does not arise is untenable since, as noted by the Hon'ble Supreme Court in the case of ***Cadila,***

prescriptions have lost their significance in India, and Schedule H drugs are regularly sold over the counter without prescriptions and even over the telephone.

I. Hence, for the reasons set out in (**A**) to (**H**) above, I don't have the slightest hesitation in holding that the rival marks are deceptively similar and that a consumer of average intelligence and imperfect recollection would in all likelihood associate 'DUPHACHRIT' with the Petitioner and perceive it to be a part of the Petitioner's 'DUPHA' family of marks. In my view, such likelihood of confusion and association is sufficient to attract the provisions of Sections 11(1), 11(2), 11(3), and 11(10)(ii) of the Act.

J. I also have no hesitation in holding that the adoption of the impugned mark by Respondent No. 1 is not only dishonest and entirely lacking in bona fides but is clearly calculated to deceive and to encash upon the reputation and goodwill enjoyed by the Petitioner in the 'DUPHA' family of marks. I say so because both 'DUPHASTON' and 'DUPHALAC' have been registered since 1960 and

1989, respectively, and are well-established products, having generated Indian sales in excess of Rupees 324 crore and global sales exceeding USD 487 million. In contrast, the impugned registration was obtained only in the year 2021. Despite this, Respondent No. 1 has failed to provide any meaningful or cogent explanation for its adoption of the mark 'DUPHA', a term which is admittedly neither generic nor descriptive in the pharmaceutical trade. The explanation advanced by Respondent No. 1 is that 'DUPHA' was adopted because it was allegedly common to the Register and was not exclusively associated with any one entity. Far from assisting Respondent No. 1, this explanation only makes plain the absence of any bona fide reason for the adoption of the impugned mark.

K. Also, *and crucially*, Respondent No. 1 has itself stated that dydrogesterone became commercially available as an active pharmaceutical ingredient to entities other than the Petitioner only in the year 2019 and that, prior thereto, it was available exclusively through the Petitioner's proprietary manufacturing

processes. In these circumstances, it is impossible to accept that Respondent No. 1 was unaware of the Petitioner's product and the goodwill associated with the 'DUPHA' marks. Thus in light of these facts, the conduct of Respondent No. 1 is plainly dishonest and mala fide. The adoption of the impugned mark appears to be a deliberate attempt to ride upon the reputation and goodwill built up by the Petitioner over several decades. I am therefore of the prima facie view that confusion is not merely likely to ensue but was, in fact, intended so that Respondent No. 1 could derive a commercial benefit therefrom.

L. For the reasons set out in (**H**) and (**J**) above, I find much merit in the Petitioner's contention that the public interest is paramount and that the purity of the register must be maintained. In this context, I find the Petitioner's reliance upon the decision in ***Ciba Ltd Basle Switzerland*** to be entirely apposite, in particular the following observations, viz. .

> *"5. Now, in considering both S. 46 and S. 10 it has got to be remembered that the primary duty of the Court is towards the public and the maintenance of the purity of the register. When a case is sought to be made out that a particular trade mark is likely to deceive or cause confusion, the contest is not so much*

between the parties to the litigation as it is a contest between the party defending his right to a particular trade mark and the public, and the 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. The object of maintaining a trade mark register is that the public should know whose goods they are buying and with whom particular goods are associated. It is therefore essential that the register should not contain trade marks which are identical or which so closely resemble each other that an unwary purchaser may be likely to be deceived by thinking that he is buying the goods of a particular person or a particular firm or a particular industry, whereas he is buying the goods of another person or firm or industry."

The continued presence of the impugned mark on the Register for identical pharmaceutical goods poses a tangible risk of deception and confusion to consumers at large, and hence the said decision would squarely apply.

M. The contention that there are certain third-party marks which have 'DUPHA', even if correct, would not *ipso facto* dilute or defeat the Petitioner's statutory and common law rights in the 'DUPHA'. The mere presence of marks on the Register, without evidence of actual and substantial commercial use, is insufficient to establish that 'DUPHA' is in any manner common to the trade. It is well settled that the burden of proving extensive third-party use is upon the

party who alleges it, i.e., Respondent No. 1. The Petitioner's reliance upon the decisions in the case of ***Corn Products Refining Co.*** and ***Pidilite Industries Ltd.*** is therefore entirely apposite. In the facts of the present case, the material on record shows that several such marks have either been abandoned, opposed, withdrawn, or refused. Also, Respondent No. 1, having applied for and obtained registration of the impugned mark, is estopped from simultaneously contending that the Petitioner's mark is common to the trade or incapable of protection.

N. I also find that the reliance placed by Respondent No. 1 upon the decision in the case of ***F. Hoffmann-La Roche & Co. Ltd.*** is entirely misplaced. In the said case, substantial evidence had been produced by the Defendants therein to establish that the expression "VIT" was a well-known abbreviation commonly used in the pharmaceutical trade for vitamin preparation, respectively. In the present case, not even an attempt has been made by Respondent No. 1 to demonstrate how 'DUPHA' or 'DUPHAR' are descriptive, generic, or common trade expressions in the pharmaceutical industry. Therefore, the said decision does not advance the case of Respondent No. 1 in any manner.

O. The contention regarding alleged fragmentation of rights in the 'DUPHA' marks also does not merit acceptance. So long as the Petitioner continues to be the registered proprietor of the 'DUPHA' marks and the registrations remain valid and subsisting, the Petitioner would be entitled to the statutory protection afforded to a registered proprietor of a trade mark, especially where the adoption is patently dishonest and entirely lacking in bona fides. To deny the Petitioner relief in the present case would, in my view, be akin to putting a premium on calculated and well-thought-out dishonesty. Therefore, upholding any of the contentions raised by Respondent No. 1 would effectively permit Respondent No. 1 to benefit from such dishonesty and would also act as an impetus for others to similarly adopt trade marks or essential features of trade marks only to profit from the same. In my view, such practice must not only be discouraged but also be deprecated.

P. I find no merit in the contention that the Petitioner is not entitled to relief due to delay. Firstly, Section 57 of the Act does not prescribe any period within which rectification proceedings are to be filed. Secondly, and crucially, as held by the

Division Bench of this Court in the case of ***Ciba Ltd. Basle Switzerland***, what is paramount in trade mark rectification proceedings is the purity of the Register. Thus, even assuming there has been some delay on the part of the Petitioner in approaching this Court, for the reasons set out in (**H**) to (**N**) above, in my view any such delay would be wholly irrelevant to the overarching public interest in maintaining the purity of the Register. Also, in the facts of the present case, it is also crucial to note that Respondent No. 1 has, despite asserting use of the impugned mark, failed to produce any cogent evidence of commercial use of the impugned trade mark. In the absence of such material, in my *prima facie* view, an adverse inference must be drawn against Respondent No. 1. Conversely, the Petitioner has established long-standing statutory and common law rights in the 'DUPHA' marks dating back to 1951 and continuous use since the 1960s. Therefore, the balance of convenience and equity is clearly in favour of the Petitioner.

Q. I also find no merit in the contention that the Petitioner is disentitled to relief on the ground of suppression. The Petition is filed on the basis of the Petitioner's

statutory rights in the ‘DUPHA’ family of marks based on the 8 registrations, all of which are valid and subsisting, and all of which have ‘DUPHA’ as a prefix to them. It also cannot be lost sight of that the present Petition has been filed under the provisions of Section 57 of the Act, the remit and scope of which is the rectification of the Register by cancelling and removing entries that are wrongly made or wrongly remaining thereon under Section 57 of the Act and is not a case of either infringement or passing off. Therefore, the fact that the Petitioner has applied for registration of 'DUPHA' in the year 2020, which does not find mention in the Petition, would not have any bearing on the Petitioner's challenge in the present Petition and would, in my view, certainly not amount to suppression of a material fact so as to warrant the dismissal of the Petition. Hence, in my view, the Hon’ble Supreme Court's decision in ***Dalip Singh*** would not apply.

R. Also, in my view, the decisions relied upon by Respondent No. 1 are clearly distinguishable and would have no application in the facts of the present case. In ***Century 21 Real Estate LLC,*** the very test laid down therein, when applied

to the facts of the present case, would, in my view, in fact support the case of the Petitioner, since the overall commercial impression created by the impugned mark ‘DUPHACHRIT’ would, as held in (**H**) above, inevitably lead a consumer of average intelligence and imperfect recollection to associate the impugned mark with the Petitioner’s 'DUPHA' family of marks.

52. Hence, for the reasons mentioned hereinabove, I pass the following Order:

i. The captioned Petition is allowed in terms of prayer clause ‘(a)’ of the Petition which reads as follows:

> “*(a) That the entry relating to the impugned mark “DUPACHRIT” bearing number 5027549 in class 5 made in the name of the Respondent No. 1 be rectified, cancelled and removed from the Register of Trade Marks”*

ii. There shall be no order as to costs.

iii. In view of the above, the captioned Interim Application will not survive and is accordingly disposed of.

[ARIF S. DOCTOR, J.]