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

% *Date of Decision: 17th August, 2026*

\+ C.O. (COMM.IPD-TM) 122/2025

DR. REDDY'S LABORATORIES LIMITED .....Petitioner
Through: Mr. Ranjan Narula, Mr. Shakti Priyan Nair and Mr. Parth Bajaj, Advocates.

versus

M/S RAZENTA PHARMACEUTICALS PRIVATE LIMITED AND ANR .....Respondents
Through: Mr. Satish Kumar, Mr. Rakesh Tiwari and Mr. Shiv Kumar Yadav, Advocates for R1.
Ms. Manisha Agrawal Narain, CGSC with Mr. Arnav Mittal, GP and Mr. Nipun Jain, Advocate for R2.

CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH

JUDGEMENT

JYOTI SINGH, J.

1. This petition is filed on behalf of the Petitioner under Section 57 of the Trade Marks Act, 1999 ('1999 Act') seeking cancellation of trademark registration No.5208898 dated 14.11.2021 for the trademark DAPLOGIN registered in Class 05 in the name of Respondent No.1.

2. Factual matrix as brought forth in the petition and to the extent relevant is that Petitioner is one of India's largest pharmaceutical companies engaged in manufacturing, marketing and distribution of pharmaceutical, nutritional and cosmetic products, both globally and in India. Petitioner was established in 1984 and commenced business in Active Pharmaceutical

Ingredients (API) segment by setting up its first 60 tonne API factory in Hyderabad and is currently, amongst top 3 API companies in the world. Petitioner is stated to be the first Indian company to export active ingredients for pharmaceuticals to Europe. In 1986, Petitioner company went public and was listed on Bombay Stock Exchange (BSE). Presently, Petitioner has businesses spanning 76 countries and 53 nationalities with more than 26,000 individuals and 23 manufacturing facilities around the world, which produce over 550 medications and more than 250 APIs for drug manufacture, diagnostic kits, critical care and biotechnology. The immense goodwill and reputation of the Petitioner can be measured from the revenues earned in a short span of time and illustratively, the turnover for financial year 2023-2024 alone was to the tune of USD 3.35 billion.

3. It is stated that the products manufactured and marketed by the Petitioner are sold under well-known and popular trademarks and/or brand names and are known for their superior quality, technical excellence and effectiveness and to name a few, the popular brands of the Petitioner and its affiliates are DAPLO, Molflu, Nise, Omez, Omez-DSR, Practin, Stamlo, Practin, Editux, Fondared, Razo, Razo-D, Atocor, Econorm, etc. Petitioner is the first Indian company to obtain a 180-day marketing exclusivity from USFDA. Petitioner and its affiliates maintain a state-of-the-art research and development facility for developing new products and upgrading the existing ones, where strict safety and efficacy protocols are followed. Petitioner is also a recipient of several prestigious awards as detailed in the petition, including the Golden Peacock Award, 2023.

4. It is stated that Petitioner coined and adopted the trademark DAPLO, which has no dictionary meaning and the mark serves as a source identifier

for the Petitioner and being a coined mark, is entitled to high degree of protection. The drug sold under the said mark is used either alone or in combination with other medicines to treat Type-2 Diabetes Mellitus and helps in controlling high blood pressure levels in diabetic patients as also in reducing chances of serious complications and preventing heart ailments. Petitioner has used the DAPLO mark continuously and extensively since the year 2020 and it is synonymous with its products and associated in the mind of public with the Petitioner alone. To obtain statutory rights, Petitioner has obtained registration for the mark DAPLO in Class 05 in India and details are as follows:-

Trade Mark	App. No.	Reg. Date	Class	Status
DAPLO	4662842	September 18, 2020	5: Pharmaceutical and Medicinal preparations.	Registered & valid until September 18, 2030

5. It is stated that the said registration is valid and subsisting and therefore, by virtue of Section 28 of 1999 Act, Petitioner has the exclusive right to use the mark DAPLO and also restrain third parties from infringing it. Petitioner also holds registrations in the mark DAPLO in various other countries including Singapore, Vietnam, Malaysia and Philippines, as detailed in the petition. Petitioner has invested and continues to invest substantial amount of money and efforts in promoting its products under the mark DAPLO through various media channels including electronic and print. Petitioner has garnered immense goodwill and reputation over the years by sale of its medicinal product under the DAPLO mark and this is

amply demonstrated from the consolidated annual revenues earned from 2020-2021 to 2024-2025, as follows:-

Year	Quantity	Revenue (INR) approx.
2020-21	2,63,627	2,41,27,350
2021-22	10,77,262	10,23,15,704
2022-23	15,59,293	16,17,27,202
2023-24	17,83,746	20,10,70,846
2024-25	18,21,114	21,35,43,770

6. It is stated that owing to the investments made, revenues earned as also the goodwill and popularity of the mark DAPLO, it satisfies all parameters for being declared as a well-known mark as per Section 11(6) and within the meaning of Section2(1)(zg) of 1999 Act. Therefore, any use of this distinctive trademark by any other person or entity without the express permission of the Petitioner, will inevitably lead to confusion in the eyes of consumers, trade members and public at large. Petitioner has statutory and common law rights in the mark DAPLO and use of an identical/deceptively similar mark in any manner in relation to Petitioner's product without leave and license, will amount to infringement of the mark as also passing off and registration of any mark by a third party which is identical or deceptively similar to DAPLO mark, will therefore be invalid and liable to cancellation.

7. It is stated that registration of the mark DAPLOGIN in favour of Respondent No.1 is illegal and contrary to Section 11(1), (3) and (10) as also other provisions of 1999 Act, since the mark is visually and phonetically similar to DAPLO. Respondent No.1 has obtained registration under No.5208898 dated 14.11.2021 for medicinal and pharmaceutical preparations for human purposes included under Class 05 on 'proposed to be

used' basis. The mark was published in Trade Marks Journal No.2161-0 dated 17.06.2024, however, due to an inadvertence/oversight, the publication skipped the attention of the Petitioner and in the absence of any opposition, the mark proceeded to registration and was placed on the Register on 01.11.2024. Petitioner came across the mark DAPLOGIN in the first week of March, 2025, when it was listed on the official website of Tata 1MG Healthcare Solutions Pvt. Ltd. and subsequent search on the website of Trade Marks Registry led to a revelation that DAPLOGIN was registered in favour of Respondent No. 1.

8. Learned counsel for the Petitioner submits that the mark DAPLOGIN is devoid of any distinctive character and is incapable of distinguishing the goods of Respondent No.1 from the goods of the Petitioner and thus its registration is illegal, owing to the proscription in Section 9(1)(a) of 1999 Act. DAPLOGIN is deceptively similar to DAPLO and its use is likely to cause confusion amongst public and thus its registration also falls foul of Section 9(2)(a). In fact, the mark DAPLO is wholly and completely subsumed in the mark DAPLOGIN and since the drugs have the same salt/composition 'Dapagliflozin' and are used for treating Type-2 Diabetes Mellitus, confusion amongst public and potential consumers is not only likely but is inevitable.

9. It was further argued that there is no doubt that the both the medicines are Schedule H drugs and sold on prescription, however, this factor alone is not enough to rule out confusion. In ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73,*** the Supreme Court observed that physicians and pharmacists are not infallible. 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 divides across and with high degree of possibility of accidental negligence, strict measures must be taken to prevent any confusion arising from similarity of trademarks in this field. It was urged that a stricter approach must be adopted in the instant case while applying the test to judge possibility of confusion since the marks in question relate to pharmaceutical products and any confusion, owing to deceptive similarity of marks, can have disastrous consequences in patients. ***[Ref.: Cadila Health (supra) and Mankind Pharma Limited v. Novakind Bio Sciences Private Limited, 2023 SCC OnLine Del 4806].***

10. It was further argued that Petitioner is a prior adopter, user and registered proprietor of the mark DAPLO since 2020 and is thus a senior user with superior rights in law as compared to Respondent No.1, who being a junior user ought not to have come close to the Petitioner while adopting the mark for identical drug. Prior user's superior rights have been judicially recognised and Courts have consistently held that prior use even trumps registration. ***[Ref.: S. Syed Mohideen v. P. Sulochana Bai, (2016) 2 SCC 683; Usha Intercontinental Ltd. and Others v. Usha Television Ltd., 1985 SCC OnLine Del 562; D&H India Ltd. v. Superon Schweisstechnik India Ltd., 2020 SCC OnLine Del 477;*** and ***Consolidated Foods Corporation v. Brandon & Co. Private Limited, 1961 SCC OnLine Bom 55].*** DAPLOGIN is so deceptively similar to DAPLO that any unwary purchaser on first look will get an unmistakable impression that the drug sold by Respondent No.1 emanates from the house of the Petitioner and this is moreso because Petitioner keeps coming up with variants. Respondent No.1 operates in pharmaceutical sector and had complete notice of prior use and goodwill and

reputation of the mark DAPLO and thus the adoption of DAPLOGIN is dishonest, tainted and *mala fide*.

11. It was next argued that registration of DAPLOGIN also violates provisions of Section 11(1)(a) of 1999 Act, which proscribes registration of a mark which is similar to an earlier mark registered for identical/similar goods and is likely to cause confusion on the part of public or association with the earlier mark. It is trite that in deciding the question of similarity between two marks, the rival marks have to be compared as a whole applying the anti-dissection test and the standard is of a man with average intelligence and imperfect recollection and when compared as a whole, DAPLO and DAPLOGIN are deceptively similar. Having seen DAPLO at some point, an unwary purchaser will be in a state of wonderment on seeing DAPLOGIN at a later point of time for the same drug, whether he had seen the mark earlier and there will arise an initial interest confusion. Reliance was placed on the judgements in ***Corn Products Refining Co. v. Shangrila Food Products Ltd., 1959 SCC OnLine SC 11.; Zydus Wellness Products Limited v. Cipla Health Ltd. and Another, 2023 SCC OnLine Del 3785;*** and ***FDC Limited v. Docsuggest Healthcare Services Pvt. Ltd. & Anr., 2017 SCC OnLine Del 6381].***

12. It was also argued that Petitioner's mark DAPLO has garnered significant and enviable reputation and goodwill in the market as evidenced by the sales figures duly supported by a CA certificate; expenses incurred on promotion of the mark; extensive, open and continuous use of the mark since 2020; screenshots of Petitioner's website showing DAPLO with its range of products as also screenshots of third-party listings; and Petitioner's laboratories' fact sheets, annual reports, awards etc. Respondent No.1 has

adopted a deceptively similar mark DAPLOGIN for identical goods with the intent of misrepresenting to the members of public and members of trade that its product emanates from the Petitioner or has some association with it. The justification given by Respondent No.1 in the reply is that Petitioner has taken the mark DAPLO from the API 'Dapagliflozin' and 'DAP' being *publici juris*, no exclusivity can be claimed by the Petitioner on the mark DAPLO so as to question the registration of DAPLOGIN, which is taken from the same API. This argument is only to cover up the dishonesty and must be rejected at the outset. DAPLO is a coined word with no dictionary meaning *albeit* it does include 'DAP' and if Respondent No.1 wanted to use the letters and syllables from Dapagliflozin, it could have used DAP with some other letters and combination. There can be no justification for adopting a mark, which subsumes the distinctive and coined word DAPLO in entirety and the adoption of DAPLOGIN constitutes bad faith and the registration deserves to be cancelled under Section 11(10) of 1999 Act read with Section 18(1).

13. Defending the registration of the impugned mark DAPLOGIN, learned counsel for Respondent No.1 contended that DAPLOGIN is not deceptively similar to DAPLO and as a matter of fact, both marks have been co-existing in the market without causing any confusion. Adoption of the mark DAPLOGIN by Respondent No.1 is honest and *bona fide* and is not in bad faith, as alleged by the Petitioner. The mark was adopted on 14.11.2021 in consonance with the normal practices in pharmaceutical industries, where ordinarily, pharma companies derive and coin their marks/brand names from the molecules/salts/APIs of the concerned compositions, as this makes it easier for medical practitioners and pharmacists to recall. Adoption of

DAPLOGIN is a result of *bona fide* business decision and is in consonance with the established pharmaceutical industry practice, inasmuch as the mark is derived from API/molecule ‘Dapagliflozin’, which finds mention in the India list of INN Volume 22 in the Trade Marks Registry. DAPLOGIN was coined by taking the first three letters ‘DAP’ and last five letters ‘LOZIN’ with slight modification by replacing the letter ‘Z’ with ‘G’ to create a distinctive mark. Addition of suffix ‘GIN’ makes the mark even more unique and distinguishable and there is absolutely no deceptive similarity with DAPLO.

14. It was further argued that Respondent No.1 has followed the due procedure for registration of DAPLOGIN in Class 05. Application for registration was filed on 14.11.2021 in the Office of Trade Marks Registry at Mumbai and was accepted and published in Trade Marks Journal No.2161-0 dated 17.06.2024. No opposition was filed either by the Petitioner or any third-party within four months from the date of publication and the trademark proceeded to registration and hence, the registration is valid and warrants no cancellation. In fact, the record shows that there are several medicinal products in the market, which are sold under marks/brand names derived from the salt/molecule ‘Dapagliflozin’, which include registered marks with suffixes added to DAPLO and are being used to treat Type 2 Diabetes Mellitus such as DAPLOCAR-L, DAPLOYD, DAPLOSKY M, DAPLOSE etc. In this context, reliance was placed by learned counsel on the judgment of the Division Bench of this Court in ***Sun Pharmaceutical Laboratories Ltd. v. Hetero Healthcare Ltd. and Another, 2022 SCC OnLine Del 2580,*** where the rival marks were LETROZ and LETERO and Court upheld the order of the Trial Court declining injunction

inter alia on the ground that the mark LETROZ was nothing but a short name of active ingredient LETROZOLE and many third parties were selling the same drug containing the first three letters 'LET'. The Division Bench referred to and relied on an earlier judgement of this Court in ***M/s. Panacea Biotec Ltd. v. M/s. Recon Ltd., 1996 SCC OnLine Del 508,*** where the Plaintiff was using the trademark NIMULID and had filed a suit for injunction against the Defendant for using the mark REMULIDE in relation to the same medicine with API being Nimesulide and Court declined relief holding that when the trademark is derived from the name of the principal ingredient used in the manufacture of the drug, no distinctiveness or exclusiveness can be claimed by the manufacturer. In light of these submissions, it was urged that the cancellation petition be dismissed.

15. Heard learned counsels for the parties and examined their submissions.

16. The rival marks involved in the present petition are DAPLO and DAPLOGIN. Indisputably, Petitioner is the prior adopter, user and registered proprietor of the trademark DAPLO from 2020 and the mark is registered in Class 05. It is claimed that the mark is a coined word with no dictionary meaning and does not identify the salt or composition for which it is used i.e., Dapagliflozin. Petitioner also asserts that it has registrations in DAPLO in various other jurisdictions such as Philippines, Singapore, Vietnam and Malaysia and in this regard, has placed on record the registration documents. Petitioner pleads that it has acquired immense goodwill and reputation in the DAPLO mark, which is evident from the consolidated annual revenues, longstanding use and presence in the market since 2020 and the general public and members of the trade

spontaneously and exclusively associate the mark DAPLO only with the Petitioner.

17. Cancellation of registration of the mark DAPLOGIN is sought by the Petitioner on the ground that the mark is nearly identical/deceptively similar to DAPLO and addition of suffix 'GIN' is insufficient to distinguish the two marks. It is asserted that the dishonest intention in adopting DAPLOGIN is demonstrated from the fact that DAPLO is wholly subsumed in the mark DAPLOGIN and considering the deceptive similarity in the rival marks and identity of products and active ingredient Dapagliflozin as also the fact that both drugs are used for treating Type-2 Diabetes Mellitus, confusion in the market is inevitable. Petitioner strenuously denies that DAPLO is derived wholly from Dapagliflozin and asserts that it is coined by combining 'DAP' and 'LO'. It was also contended that since Petitioner has and keeps coming up with variants in the market under the mark DAPLO, use of deceptively similar mark for identical product used for same disease, will give an unmistakable impression in the minds of consumers that the medicinal product under Respondent No.1's mark belongs to and is yet another variant from the house of the Petitioner.

18. *Per contra,* Respondent No.1 asserts that it has honestly and *bona fidely* adopted the trademark DAPLOGIN on 14.11.2021 as per normal practice in pharmaceutical industries, where companies often derive brand names/trademarks from molecule or salt names to make it easier for medical practitioners to recall. In the instant case, the API or molecule is Dapagliflozin, which is mentioned as an INN in the Indian list and Respondent No.1 has coined the term DAPLOGIN by taking first three letters 'DAP' and last five letters 'LOZIN' from Dapagliflozin, with slight

modification by substituting the letter 'Z' with 'G' and moreover, addition of the suffix 'GIN' makes the mark DAPLOGIN unique and distinguishable and there is no similarity with DAPLO, either visual or phonetic. It was also urged that the rival marks being dissimilar can easily co-exist in the market without any confusion and hence, the ***Cadila Health (supra)*** principle will not apply in the instant case.

19. The other argument seriously pressed on behalf of Respondent No.1 was that the Division Bench of this Court in ***Sun Pharmaceutical v. Hetero (supra)*** has, placing reliance on the judgment in ***Panacea Biotec (supra),*** observed that when the name is derived or coined from the principal ingredient used in the manufacture of the drug, no distinctiveness or exclusiveness can be claimed by the manufacturer and in this backdrop, unequivocally held that the mark LETROZ was nothing but a short name of the active ingredient Letrozole and therefore, Trial Court rightly declined grant of interim injunction holding that the rival marks LETROZ and LETERO were not deceptively similar, either visually or phonetically and Plaintiff having used all six alphabets from the generic name Leterozole, could not stop the Defendant from using the first two alphabets.

20. Petitioner seeks cancellation of registration of DAPLOGIN and therefore, it will be relevant to examine the applicable provisions. Section 9 of 1999 Act provides absolute grounds for refusal of registration and specifically, sub-Section (2)(a) stipulates that the mark shall not be registered as a trademark if it is of such nature as to deceive the public or cause confusion. Section 11(1)(b) proscribes registration of a mark, which is similar to an earlier mark and there is identity/similarity of goods or services covered by the said trademarks. Coming back to the marks DAPLO and

DAPLOGIN, the first question that needs examination is whether the marks are deceptively similar, since identity of rival goods in not in dispute. The classic test to apply while examining the existence of similarity between the rival marks was enunciated by Parker, J. in ***Re Pianotist Co's Application, (1906) 23 RPC 774***, which is the *locus classicus* and the relevant observations are as follows:-

> *"You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks."*

21. In ***Amritdhara Pharmacy v. Satya Deo Gupta, 1962 SCC OnLine SC 13,*** a decision under the Trade Marks Act, 1940, the competing marks were AMRITDHARA and LAKSHMANDHARA and were used for similar ayurvedic preparations. The Supreme Court held that to a man with average intelligence and imperfect recollection, the overall structural and phonetic similarity in the rival marks is likely to deceive and cause confusion and unwary purchaser would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider the meaning of the composite words as 'current of nectar' or 'current of Lakshman'. He would go more by the overall structural and phonetic similarity and nature of the medicine he had previously purchased or had been told about or about what he had otherwise learnt. Relevant paragraphs are as follows:-

> *"7. Let us apply these tests to the facts of the case under our consideration. It is not disputed before us that the two names "Amritdhara" and "Lakshman-dhara" are in use in respect of the same*

description of goods, namely a medicinal preparation for the alleviation of various ailments. Such medicinal preparation will be purchased mostly by people who instead of going to a doctor wish to purchase a medicine for the quick alleviation of their suffering, both villagers and townsfolk, literate as well as illiterate. As we said in Corn Products Refining Co. v. Skangrila Food Products Ltd. the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. To such a man the overall structural and phonetic similarity-of the two names "Amritdhara" and "Lakshmandhara" is, in our opinion, likely to deceive or cause confusion. We must consider the overall similarity of the two composite words "Amritdhara" and "Lakshmandhara". We do not think that the learned Judges of the High Court were right in saying that no Indian would mistake one for the other. An unwary purchaser of average intelligence and imperfect recollection would not, as the High Court supposed, split the name into its component parts and consider the etymological meaning thereof or even consider the meaning of the composite words as "current of nectar" or "current of Lakshman". He would go more by the overall structural and phonetic similarity and the nature of the medicine he has previously purchased, or has been told about, or about which has otherwise learnt and which he wants to purchase. Where the trade relates to goods largely sold to illiterate or badly educated persons, it is no answer to say that a person educated in the Hindi language would go by the etymological or ideological meaning and see the difference between "current of nectar" and "current of Lakshman". "Current of Lakshman" in a literal sense has no meaning; to give it meaning one must further make the inference that the "current or stream" is as pure and strong as Lakshman of the Ramayana. An ordinary Indian villager or townsman will perhaps know Lakshman, the story of the Ramayana being familiar to him; but we doubt if he would etymologise to the extent of seeing the so-called ideological difference between "Amritdhara" and "Lakshmandhara". He would go more by the similarity of the two names in the context of the widely known medicinal preparation which he wants for his ailments.

8. We agree that the use of the word "dhara" which literally means "current or stream" is not by itself decisive of the matter. What we have to consider here is the overall similarity of the composite words, having regard to the circumstance that the goods bearing the two names are medicinal preparations of the same description. We are aware that the admission of a mark is not to be refused, because unusually stupid people, "fools or idiots", may be deceived. A critical comparison of the two names may disclose some points of difference, but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had *purchased a similar medicine on a previous occasion with a similar name. The trade mark is the whole thing-the whole word has to be considered. In the case of the application to register "Erectiks" (opposed by the proprietors of the trade mark "Erector") Farwell, J., said in William Bailey (Birmingham) Ltd. Application:*

> *"I do not think it is right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole…. I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word."*

9. Nor do we think that the High Court was right in thinking that the appellant was claiming a monopoly in the common Hindi word "dhara". We do not think that that is quite the position here. What the appellant is claiming is its right under Section 21 of the Act, the exclusive right to the use of its trade mark, and to oppose the registration of a trade mark which so nearly resembles its trade mark that it is likely to deceive or cause confusion.

xxx xxx xxx

12. On a consideration of all the circumstances, we have come to the conclusion that the overall similarity between the two names in respect of the same description of goods was likely to cause deception or confusion within the meaning of Section 10(I) of the Act and the Registrar was right in the view he expressed. The High Court was in error in taking a contrary view."

22. In the aforesaid judgment, the Supreme Court also held that the two marks must be compared as a whole and it is dangerous to divide the word up and seek to distinguish a portion of it from a portion of the other word. While comparison is generally done by the look and the sound of the competing marks, it is settled that both tests are disjunctive. In ***Encore Electronics Ltd. v. Anchor Electronics & Electricals Pvt. Ltd., 2007 SCC OnLine Bom 147,*** it was held that phonetic similarity constitutes an important index of deceptive similarity of rival marks. It is equally settled that while a mark is to be considered in entirety, it is permissible to accord more or less importance or dominance to a particular portion or element of a

mark in case of composite marks and in ***M/s. South India Beverages Pvt. Ltd. v. General Mills Marketing Inc. & Anr., 2014 SCC OnLine Del 1953,*** the Division Bench held that the dominant mark test is not antithetical to the anti-dissection test. The anti-dissection rule is based on customer's perspective and essentially means that the two competing marks should not be examined with a microscope to find the differences, for this is not the way an average purchaser will view the marks and to an average buyer, the points of similarity will be more important than minor points of differences. In this context, it will be apposite to refer to the decision of this Court in ***Stiefel Laboratories, INC & Anr. v. Ajanta Pharma Ltd., 2014 SCC OnLine Del 3405,*** wherein reference was made to an earlier judgment of this Court in ***Cadila Healthcare Ltd. v. Aureate Healthcare Pvt. Ltd. & Anr., 2012 SCC OnLine Del 3940*** and dealing with the anti-dissection rule, Court cited with approval paragraph 23.15 of McCarthy on Trade Marks and Unfair Competition as follows:-

> *"…..*
>
> *41. The anti-dissection rule which is under these circumstances required to be applied in India is really based upon nature of customer. It has been rightly set out in McCarthy on Trade Marks and Unfair Competition about the said rule particularly in para 23.15 which is reproduced hereunder:*
>
> > *"23.15 Comparing Marks : Differences v. Similarities*
> >
> > *[1] The Anti-Dissection Rule*
> >
> > *[a] Compare composites as a Whole Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison. This is the "anti-dissection" rule. The rationale for the rule is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. However, it is not a violation of the anti-dissection rule to view the component parts of conflicting composite marks as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole. Thus,*

conflicting marks must be compared in their entireties. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. As the Supreme Court observed:"The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." The anti-dissection rule is based upon a common sense observation of customer behavior : the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall impression created by the mark from the ordinary shopper's cursory observation in the marketplace that will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighed analysis in legal briefs. In litigation over the alleged similarity of marks, the owner will emphasize the similarities and the alleged infringer will emphasize the differences. The point is that the two marks should not be examined with a microscope to find the differences, for this is not the way the average purchaser views the marks. To the average buyer, the points of similarity are more important that minor points of difference. A court should not engage in "technical gymnastics" in an attempt to find some minor differences between conflicting marks. However, where there are both similarities and differences in the marks, there must be weighed against one another to see which predominate.

The rationale of the anti-dissection rule is based upon this assumption:"An average purchaser does not retain all the details of a mark, but rather the mental impression of the mark creates in its totality. It has been held to be a violation of the anti-dissection rule to focus upon the "prominent" feature of a mark and decide likely confusion solely upon that feature, ignoring all other elements of the mark. Similarly, it is improper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains."

23. Relying on the aforesaid judgment and the passage from McCarthy, in ***Stiefel (supra),*** the Court held that Plaintiffs' mark CLINDOXYL on one side and the marks CLINOXID, CLINOXIDE and CLINOXIDE-A of the Defendant on the other side, were deceptively similar and likely to cause

confusion in the minds of an unwary purchaser. Court negated the argument of the Defendant that it had adopted the mark by telescoping the prefix 'CLIN' from the generic drug CLINDAMYCIN and suffix 'OXIDE' from the generic drug BENZOYL PEROXIDE. It was observed that the Defendant had itself applied for and obtained registration of the mark, which it claims to have adopted by telescoping letters from the generic drugs, and could not question Plaintiffs' adoption as also that Courts must be very cautious while dealing with cases of trademark similarities relating to medicinal products. If deceptively similar rival marks are permitted to stay in the market in respect of pharmaceutical products, there is likelihood of grave injury to the public and where greater public interest is involved, the commercial rights of the parties become subservient and therefore, if there is any likelihood of confusion in the two competing marks, the deceptively similar mark that enters the market later in time has to go. Therefore, the takeaway from these judgements is that while examining similarity between rival trademarks where the rival goods are pharmaceutical products, Courts must tread carefully as any confusion will be detrimental to public interest as also that the general test to examine marks is to compare them as a whole with focus on similarities rather than on minor differences.

24. At this stage, it will be apposite to refer to two passages from the judgment of the Supreme Court in ***Parle Products (P) Ltd. v. J.P. And Co., Mysore, (1972) 1 SCC 618,*** one of which contains an extract from Kerly's Law of Trade Marks and Trade Names and the other, which beautifully brings out the overall similarity concept and notes that after all, an ordinary purchaser is not gifted with powers of observation like a Sherlock Holmes. The passages are as follows:-

"8. According to Karly's Law of Trade Marks and Trade Names (9th Edn., para 838):

> *"Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in detail might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own."*

9. It is, therefore, clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. In this case we find that the packets are practically of the same size, the colour scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can essily be mistaken for the other. The essential features of both are that there is a girl with one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word "Gluco Biscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Anyone in our opinion who has a look at one of the packets today may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs' goods, he might easily mistake the defendants' wrapper for the plaintiffs' if shown to him some time after he had seen the plaintiffs'. After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Homes. We have *therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think it necessary to refer to the decisions referred to at the bar as in our view each case will have to be judged on its own features and it would be of no use to note on how many points there was similarity and in how many others there was absence of it."*

25. Since this petition concerns pharmaceutical products, this judgement will be incomplete without referring to the observations of the Supreme Court in the landmark case of ***Cadila Health (supra),*** wherein it was observed that public health would support lesser degree of proof showing confusing similarity in the case of trademarks concerning medicinal products as against non-medicinal products. Relevant passages are as follows:-

*"**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. 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. the Court of the United States had held that:*

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

> *The board's view that a higher standard be applied to medicinal products finds support in previous decisions of this Court, Clifton v. Plough ('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')."*

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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.*

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30. *In the case of Syntex Laboratories Inc. v. Norwich Pharmacal Co. [169 USPQ 1 (2nd Cir 1971)] 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."*

31. *Trade mark is essentially adopted to advertise one's product and to make it known to the purchaser. It attempts to portray the nature and, if possible, the quality of the product and over a period of time the mark may become popular. It is usually at that stage that other people are tempted to pass off their products as that of the original owner of the mark. That is why it is said that in a passing-off action, the plaintiff's right is*

> *"against the conduct of the defendant which leads to or is intended or calculated to lead to deception. Passing-off is said to be a species of unfair trade competition or of actionable unfair trading by which one person, through deception, attempts to obtain an economic benefit of the reputation which another has established for himself in a particular trade or business. The action is regarded as an action for deceit". [See Wander Ltd. v. Antox India (P) Ltd. [1990 Supp SCC 727] , SCC p. 734, para 16.]*

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

> *"The tests of confusing similarity are modified when the goods involved are medicinal products. Confusion of source or product between medicinal products may produce physically harmful results to purchasers and greater protection is required than in the ordinary case. If the goods involved are medicinal products each with different effects and designed for even subtly different uses, confusion among the products caused by similar marks could have disastrous effects. For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations. The same standard has been applied to medical products such as surgical sutures and clavicle splints."*

***33.** The decisions of English courts would be relevant in a country where literacy is high and the marks used are in the language which the purchaser can understand. While English cases may be relevant in understanding the essential features of trade mark law but when we are dealing with the sale of consumer items in India, you have to see and bear in mind the difference in situation between England and India. Can English principles apply in their entirety in India with no regard to Indian conditions? We think not. In a country like India where there is no single common language, a large percentage of population is illiterate and a small fraction of people know English, then to apply the principles of English law regarding dissimilarity of the marks or the customer knowing about the distinguishing characteristics of the plaintiff's goods seems to overlook the ground realities in India. While examining such cases in India, what has to be kept in mind is the purchaser of such goods in India who may have absolutely no knowledge of English language or of the language in which the trade mark is written and to whom different words with slight difference in spellings may sound phonetically the same. While dealing with cases relating to passing off, one of the important tests which has to be applied in each case is whether the misrepresentation made by the defendant is of such a nature as is likely to cause an ordinary consumer to confuse one product for another due to similarity of marks and other surrounding factors. What is likely to cause confusion would vary from case to case. However, the appellants are right in contending* *that where medicinal products are involved, the test to be applied for adjudging the violation of trade mark law may not be on a par with cases involving non-medicinal products. A stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by the consumer. While confusion in the case of non-medicinal products may only cause economic loss to the plaintiff, confusion between the two medicinal products may have disastrous effects on health and in some cases life itself. Stringent measures should be adopted specially where medicines are the medicines of last resort as any confusion in such medicines may be fatal or could have disastrous effects. The confusion as to the identity of the product itself could have dire effects on the public health."*

26. In ***Sun Pharma Laboratories Limited v. Glenmark Pharmaceuticals Limited, 2023 SCC OnLine Del 3786,*** *albeit* in the context of an injunction application in a suit for infringement between two pharmaceutical giants, this Court was examining whether Glenmark's use of the mark INDAMET amounted to infringement of Sun Pharma's registered mark ISTAMET XR CP as also whether a case of passing off was made out. It was held that although Sun Pharma's registration was for composite mark ISTAMET XR CP, the dominant feature indisputably was the word ISTAMET as the terms 'XR' and 'CP' were standard nomenclatures used by pharmaceutical companies to describe products and when ISTAMET is compared to INDAMET, there is striking similarity. On the argument of the Defendant that no monopoly could be claimed on the suffix 'MET', Court held that it was not dissecting the mark for comparing the suffix selectively and when compared as a whole, the two were structurally and phonetically similar, the only difference being in two letters of the prefix 'ST' in 'ISTA' and 'ND' in 'INDA'. Referring to the judgment of the Supreme Court in ***Cadila Health (supra)*** and observing that there were high chances of confusion and deception owing to the deceptive similarity in the two marks, Court granted

injunction. This case is particularly relevant to the instant case inasmuch as one of the defences raised by the Defendant was that the suffix 'MET' in Sun Pharma's product ISTAMET was an abbreviation derived from the first three letters of 'Metformin Hydrochloride', the active ingredient in the drug and likewise, the 'MET' in Glenmark's INDAMET was from 'Mometasone Furoate', a different active compound. On this argument, the Court held that the marked similarity between the two rival marks could cause substantial confusion amongst customers suffering from the ailments which the drugs treated and lead to serious consequences and this fact overshadows the differences in compositions and the shared suffix 'MET'. It was also observed that in pharmaceutical products, minor differences in compositions or formulations can yield significantly varied effects on the body, including potential side effects and therefore, it is critical that public is not misled and thus a more stringent test needs to be applied.

27. This judgment was taken up in appeal before the Division Bench in ***Glenmark Pharmaceuticals Ltd. v. Sun Pharma Laboratories Ltd., 2024 SCC OnLine Del 2707*** and by a detailed judgment, injunction granted by the learned Single Judge was upheld. Division Bench found that the two marks were structurally and phonetically similar. In the context of the argument of the Appellant that if 'XR CP' was liable to be excluded, the suffix 'MET' must also be accorded similar treatment as it was *publici juris,* the Division Bench held that the argument cannot be countenanced since that would amount to undertaking a wholesale reconstruction of the two competing marks and will not constitute a safe basis for purpose of answering the question of likelihood of confusion. While anti-dissection is the primary rule, Courts can acknowledge and identify dominant elements of

a mark and undoubtedly, the word 'MET' was an integral part of both the competing marks, intended to convey existence of an essential ingredient or salt of the two products. More importantly, a purchaser of average intelligence would not break down the trade names at the time of transaction and will view the marks as INDAMET and ISTAMET while ignoring 'XR' and 'CP' since these abbreviations are well known as additional attributes of a formulation. The Court emphasized on the more exacting and stringent standards required to be adopted, when dealing with trademarks in respect of drugs. Relevant paragraphs are as follows:-

> *"**50.** Having noticed the rival submissions which were addressed, the first question which arises for consideration is the correctness of the conclusions rendered by the learned Single Judge with respect to deceptive similarity. As was noticed by us hereinbefore, the learned Judge had found that the competing marks "ISTAMET" and "INDAMET" were structurally and phonetically similar. The learned Judge had also found that although the registration in favour of Sun Pharma bids one to view the composite mark "ISTAMET XR CP", the dominant feature of that mark is liable to be recognized as being "ISTAMET". It was in challenge to the aforesaid conclusions that both Dr. Singhvi and Mr. Sibal had argued that if "XR CP" was liable to be excluded, the suffix "MET" which was publici juris must also be accorded similar treatment. According to learned senior counsels if the aforesaid process of reasoning were adopted for the purposes of answering the question of deceptive similarity, it would be apparent that there is a marked difference between the two competing marks, namely, "ISTA" and "INDA" and the grant of injunction thus being clearly unjustified. It was in the aforesaid context that learned senior counsels had referred to the decisions rendered in Schering and Astrazeneca.*
>
> ***51.** We at the outset note that the issue which stands raised would have to be examined bearing in mind and at the forefront the stringent, exacting and uncompromising standards which are liable to be adopted when we test an action for infringement or passing off pertaining to competing marks in the pharmaceutical sector as opposed to any other genre of products. It would be pertinent to recollect that in Cadila Healthcare the Supreme Court was concerned with the asserted similarity between the brand names "FALCITAB" and "FALCIGO". The Trial Judge had refused interim injunction on the basis that they differed in appearance,*

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

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

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

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***56.** The aforesaid principles as propounded clearly point towards a more exacting and stringent test being adopted when an action of infringement or passing-off comes to be laid in respect of drugs. As was pertinently observed by the Supreme Court in Cadila Healthcare, in the case of drugs, the tests to be adopted is that of "exacting judicial scrutiny". It was further held that the mere fact that the drug was being sold on the basis of a prescription or dispensed by pharmacists would also not constitute a reliable determinant which would dilute the strict view test as articulated by it while attempting to answer the question of possibility of confusion.*

This the Supreme Court so held bearing in mind the injurious or detrimental possibilities attendant to an inadvertent purchase, sale and consequential consumption of a drug. It also took into consideration the harmful effect that a usage of a drug may have even though the competing products may be meant for curing an identical ailment. Not stopping at this, the Court also found that notwithstanding the pharmaceutical market being regulated by prescriptions and the dispensation of products being overseen and supervised by trained physicians, those factors would not allay the fears and apprehensions attendant to an incorrect or inappropriate drug being accidentally dispensed. This is evident from the following observations appearing in Paras 27 and 28 of the report:

> *"**27.** As far as the present case is concerned, although both the drugs are sold under prescription but this fact alone is not sufficient to prevent confusion which is otherwise likely to occur. In view of the varying infrastructure for supervision of physicians and pharmacists of medical profession in our country due to linguistic, urban, semi-urban and rural divide across the country and with high degree of possibility of even accidental negligence, strict measures to prevent any confusion arising from similarity of marks among medicines are required to be taken.*
>
> *28. Here it will be useful to refer to the decision of Morgenstern Chemical Co. case where it has been held as under:*
>
>> *"(5) In the field of medical products, it is particularly important that great care be taken to prevent any possibility of confusion in the use of trade marks. The test as to whether or not there is confusing similarity in these products even if prescribed and dispensed only by professionally trained individuals does not hinge on whether or not the medicines are designed for similar ailments. The rule enunciated by Judge Helen in Cole Chemical Co. v. Cole Laboratories [DC Mo 1954, 118 F Supp 612, 616, 617, 101, USPQ 44, 47, 48] is applicable here:*
>>
>> *'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.'*
>>
>> *The observations made by Assistant Commissioner Leeds of the Patent Office in R.J. Strasenburgh Co. v. Kenwood Laboratories, Inc. [106 USPQ 379 (1955)] USPQ 380 are particularly apt,*

that:'Physicians are not immune from confusion or mistake. Furthermore it is common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently handwriting is not unmistakably legible. These facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced.'

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

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

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

"25. The drugs have a marked difference in the compositions with completely different side effects, the test should be applied strictly as the possibility of harm resulting from any kind of confusion by the consumer can have unpleasant if not disastrous results. The courts need to be particularly vigilant where the defendant's drug, of which passing off is alleged, is meant for curing the same

ailment as the plaintiffs medicine but the compositions are different. The confusion is more likely in such cases and the incorrect intake of medicine may even result in loss of life or other serious health problems. In this regard, reference may usefully be made to the case of Glenwood Laboratories, Inc. v. American Home Products Corp, 173 USPQ 19 (1972) 455 F. Reports 2d, 1384 (1972), where it was held as under:

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

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

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

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

*(1) **The mark has to be considered as a whole**,*

*(2) **It is a question of first impression and***

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

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

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

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

*III. **First Impression**.*

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

*V. **Structural Resemblance**.*

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

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

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

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

***(Emphasis added)**"*

***62.** After noticing the decision in Cadila Healthcare, the Bombay High*

Court culled out the following principles:

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

(v) Structural resemblance.

(vi) Similarity in idea to be considered.

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

***63.** On an overall consideration of the aforesaid, we are of the considered opinion that the finding of deceptive similarity and likelihood of confusion as ultimately rendered by the learned Judge clearly merits no interference. The learned Judge has on a prima facie evaluation come to conclude that a comparison of the marks "ISTAMET" and "INDAMET" meets the test of structural and phonetic similarity. That conclusion cannot, by any stretch of imagination, be said to be either manifestly erroneous or perverse. We are inclined to accept the principles as lucidly culled out in Macleods Pharmaceuticals and where their Lordships propounded the test in respect of drugs to be the "mere existence of the slightest possibility" of confusion. The aforesaid enunciation of the legal position is clearly in accord with the tests laid down by the Supreme Court in Cadilla Healthcare. In our considered opinion, the question of likelihood of confusion in case of competing drugs would have to be answered on a basis distinct from those that we may employ for ordinary consumer products. We would be erring if we were to fail to adopt strict principles of proof when it comes to drugs bearing in mind the need to completely obviate the possibility of an error or mistake. The test of confusing similarity, as McCarthy in his seminal work explains, stands "modified" and spoke of a "lesser quantum of proof" being required when the subject be drugs and medicinal preparations.*

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***72.** We ultimately bear in mind the indubitable fact that ISTAMET and INDAMET are meant to attend to chronic ailments. It would therefore be perilous to ignore the test of heightened scrutiny as propounded in Cadilla Healthcare while considering the issue of deceptive similarity. We also bear in mind the undisputed fact that "ISTAMET" had been available in the market right from 2011 whereas the appellant chose to launch its product only on 16 June 2022 and that too after an opposition to its mark had come to be filed by the respondent on 27 May 2022. The question of balance of convenience was thus rightly answered by the learned Single Judge while passing the impugned order."*

28. In ***Sun Pharma Laboratories Ltd. v. Lupin Ltd. & Anr., 2018 SCC OnLine Del 7310,*** one of the questions that fell for consideration before the Coordinate Bench of this Court was whether the trademark of the Plaintiff TRI VOLIB was deceptively similar to Defendants' trademark TRI-VOBIT and both parties relied on the judgment of the Supreme Court in ***Cadila Health (supra).*** Following the said judgment as also the judgment of this Court in ***Stiefel (supra),*** the Court observed that the test is to see whether the essential features of Plaintiff's trademarks have been adopted by the Defendants and phonetic similarity would constitute an important index and in this backdrop, held that TRI-VOBIT was *prima facie* phonetically and structurally similar to TRI VOLIB and further, since the two drugs were for the same disease, the likelihood of confusion cannot be ruled out. Significantly, the Court negated the contention of the Defendants that it was the prior user of the mark VOBIT and had only added a prefix 'TRI' and held that the full words have to be compared and not a part of the word, which means TRI-VOBIT has to be compared with TRI VOLIB and when so compared, there is deceptive similarity and the mere fact that the mark VOBIT was used by the Defendants prior to the Plaintiff's use of TRI VOLIB, cannot be a defence.

29. Lastly, I may allude to a judgment of this Court in ***Glaxosmithkline Pharmaceuticals Ltd. v. Horizon Bioceuticals Pvt. Ltd. and Another, 2023 SCC OnLine Del 2065,*** where the Court applied the initial confusion test while deciding an injunction application in respect of Plaintiff's registered trademark COBADEX, stated to be infringed by Defendant's mark COMODEX used with the tag-on 'PLUS'. Court referred to the judgement of the Division Bench in ***Shree Nath Heritage Liquor Pvt. Ltd. v. M/s.***

Allied Blender & Distillers Pvt. Ltd., 2015 SCC OnLine Del 10164 elucidating the stages at which confusion may occur: (a) point of sale confusion; (b) post-sale confusion; (c) initial interest confusion; and (d) reverse confusion and observing that the test is one of 'initial interest wonderment' if one was to combine the tests suggested by the Division Bench, held that *prima facie* the two marks were deceptively similar and COMODEX infringed COBADEX and addition of words 'PLUS' or 'FORTE' or any other such addition will not alter this position, applying the strict standards in pharmaceutical products, where confusion has no place. The judgment has been upheld by the Division Bench in FAO(OS) (COMM) 116/2023 in ***Horizon Bioceuticals Pvt. Ltd. & Anr. v. Glaxosmithkline Pharmaceuticals Ltd.,*** decided on 01.06.2023.

30. Coming to the marks in the instant case and comparing them as a whole on the touchstone of the aforesaid judgments, I am of the view that the marks DAPLO and DAPLOGIN are deceptively similar. In fact, as rightly flagged by counsel for the Petitioner, the mark DAPLOGIN subsumes all the five letters of the mark DAPLO and the suffix 'GIN' is not sufficient to diminish the similarity. If the two marks are compared as a whole, there is a phonetic similarity since the word DAPLO with two syllables will be pronounced as 'DAP-LO' and the word DAPLOGIN will be pronounced as a three syllable word i.e., 'DAP-LO-GIN', which means that while pronouncing DAPLOGIN, the word DAPLO will be prominently pronounced. Even if the dominant mark test is applied, which Courts have consistently held is not antithetical to anti-dissection test, the dominant part of the mark DAPLOGIN is 'DAPLO', which is identical to Petitioner's mark DAPLO. In pharmaceutical industries, the first syllables of marks or

prefixes have a great identifying force since the recall value is mostly phonetic i.e. what rings in the ears. In the instant case, there is both visual and phonetic similarity and addition of 'GIN' as a suffix does not dispel confusion. In ***Intel Corporation v. Dinakaran Nair & Ors., 2006 SCC OnLine Del 459,*** Court held that there was force in the grievance of the Plaintiff that the impugned mark ARTINTEL subsumed Plaintiff's INTEL mark in entirety and though it was one word, however, while pronouncing the same it gets broken into 'ART' and 'INTEL' and would show a connection with Plaintiff's mark, leading to chances of deception which gets enhanced since the product range was same or similar.

31. Tested from the angle of initial interest confusion doctrine and applying the ***Parle Products (supra)*** test, one can safely say that that any person with average intelligence and imperfect recollection who has encountered the mark DAPLO, upon seeing the mark DAPLOGIN, will mistakenly perceive that it belongs to or is associated with the Petitioner and this will result in confusion, which will be heightened, owing to the fact that both drugs are used for treatment of the same disease and share the same API Dapagliflozin. Petitioner is also right in contending that as a huge pharmaceutical giant, it produces extensions and variants of DAPLO and hence, DAPLOGIN could be perceived by an unwary purchaser as just another variant from the house of the Petitioner, leading to both deception and confusion, which will be enhanced owing to the fact that both drugs are used for treatment of Type-2 Diabetes Mellitus and trade channels and consumer base will invariably be common.

32. The main plank of the defence of Respondent No.1 is that the mark DAPLO is not a coined word and is derived from the name of the active

ingredient Dapagliflozin and is thus *publici juris* and/or generic and Petitioner cannot exercise exclusive right over the mark and to show that DAPLO is common to trade and common to register, six marks were cited with prefixes 'DAP' and/or 'DAPLO'. To buttress the proposition that Petitioner cannot assert a right on a mark which is *publici juris,* reliance was placed on the judgment of the Division Bench in ***Sun Pharmaceutical v. Hetero (supra),*** where relying on earlier judgments in ***Schering Corporation & Ors. v. Alkem Laboratories Ltd., 2009 SCC OnLine Del 3886*** and ***Panacea Biotec (supra),*** Court held that LETROZ was nothing but a short name of active ingredient LETROZOLE and many companies were selling drugs using marks with three letters 'LET' and thus Appellant could not claim exclusivity to restrain the use of impugned mark 'LETERO'.

33. To put this point in correct perspective and for sake of completeness, it is important to see the factual narrative in these decisions. In ***Schering Corporation (supra),*** the Division Bench upheld the order of the learned Single Judge of this Court declining to grant injunction to the Plaintiff, who had filed a suit alleging infringement of marks TEMODAL and TEMODAR in relation to pharmaceutical products containing Temozolomide as the API, used for treatment of brain cancer. Defendant's marks were TEMOKEM and TEMOGET. Court held that the word TEMO was taken from the API and was *publici juris* as also generic for and descriptive of the chemical component Temozolomide and no exclusive right could be claimed by the Appellant. The suffixes 'KEM' and 'GET' were entirely different and distinct from the suffixes 'DAL' and 'DAR' and since the drugs were Schedule H drugs, sold only prescription of a registered medical

practitioner, there was no scope of confusion. In ***Panacea Biotec (supra),*** Plaintiff was using the trademark NIMULID and was denied injunction against the use of the mark REMULIDE, with the API being Nimesulide. It was held that when the name is derived or coined from the name of the principal ingredient used in manufacture of the drug, no distinctiveness or exclusiveness can be claimed. Applying these two judgments, the Division Bench in ***Sun Pharmaceutical v. Hetero (supra),*** upheld the order of trial court declining injunction against use of mark LETERO.

34. In my considered opinion, these judgments do not come to the aid of Respondent No.1. In trademark law, *publici juris* refers to words or parts of words that are common to trade or derived from the generic name or the product, such that no single trader can claim exclusivity over them. The mark DAPLO is neither *publici juris* nor common or generic. It is a coined and distinctive mark, conceived by the Petitioner by combining 'DAP' and 'LO' and thus it is not open to Respondent No.1 to contend that Petitioner cannot assert exclusive right on the said mark. DAPLO as a whole is neither the prefix nor suffix nor an abbreviation or short name of the API Dapagliflozin. In similar circumstances, this Court in ***FDC Limited v. Tas Med (India) Private Limited and Another, 2021 SCC OnLine Del 5289,*** granted injunction against the Defendants using the mark CINZITAS for pharmaceutical and medicinal preparations at the instance of the Plaintiff, who was selling its pharmaceutical products under the mark CINZAN, observing that the argument of the Defendants that the prefix 'CINZ' was taken from the salt Cinnarizine and was *publici juris* was *prima facie* not made out.

35. In my considered view, it is Respondent No.1 who has dishonestly

adopted the impugned mark DAPLOGIN which subsumes the mark DAPLO in entirety and the explanation given for adoption that following normal practices in pharmaceutical industries, where companies often derive brand names from molecules and salt for medical practitioners to recall easily, Respondent No.1 adopted first three letters 'DAP' and last five letters 'LOZIN' from the molecule Dapagliflozin and substituted 'Z' with 'G' and also added the suffix 'GIN' to make the mark unique and distinguishable, is completely fallacious. One wonders why Respondent No.1 adopted DAPLOGIN with DAPLO as a prefix and a dominant part of its mark, knowing that DAPLO was Petitioner's mark and that too for a drug used for treatment of Diabetes and the only answer that comes to mind is that this was with an intent to sail as close as possible to the Petitioner and take unfair advantage of Petitioner's immense goodwill demonstrated by the revenues earned.

36. In ***Laxmikant V. Patel v. Chetanbhai Shah and Another, (2002) 3 SCC 65,*** the Supreme Court held that the law does not permit anyone to carry on his business in such a way as would persuade the customers in believing that the goods belong to someone else or are associated therewith and it does not matter whether the latter does so fraudulently or otherwise and the reasons are two-fold. Firstly, honesty and fair play are and ought to be the basic policies in the business world and secondly, when a person adopts or intents to adopt a name in connection with his business which already belongs to someone else, it results in confusion and has propensity of diverting the customers, resulting in injury. There is another facet to this case. Respondent No.1 repeatedly asserts that the mark DAPLO is generic since 'DAP' is taken from Dapagliflozin. In my view, once Respondent

No.1 has itself used 'DAP' or 'DAPLO' as part of DAPLOGIN, it is not open to Respondent No.1 to claim that either of the two are generic and in this context, I may refer to the judgment of the Division Bench of this Court in ***Procter & Gamble Manufacturing (Tianjin) Co. Ltd. & Ors. v. Anchor Health & Beauty Care Pvt. Ltd., 2014 SCC OnLine Del 3374.***

37. As for the argument that the prefix 'DAP/DAPLO' is generic or common to trade and common to register, firstly it be noted that Respondent No.1 has cited six trademarks to show third party user. Out of the six marks, the mark DAPLO M is Petitioner's mark and DAPLOGIN is Respondent No.1's mark, both of which are subject matter of this petition. The other four marks are DAPLOCAR-L, DAPLOYD, DAPLOSKY M and DAPLOSE and the TM search report filed by Respondent No.1, these four marks are registered but there is not an iota of evidence to show their use. In ***Under Armour, INC v. Aditya Birla Fashion & Retail Ltd., 2023 SCC OnLine Del 2269,*** the Court dealt with the 'common to trade' defence and held as follows:-

> *"**The 'common to trade' defence***
>
> ***31.** Mr. Lall also advanced the contention that the mark "ARMOUR" was common to trade and that the plaintiff was, therefore, operating in what he, interestingly, called a "crowded market place". He relied, for this purpose, on a tabular statement, filed with the reply to the present application, in which there is a reference to a large number of marks which include the word "ARMOUR". Thus, submits Mr. Lall, even the register of trade marks, insofar as the word "ARMOUR" is concerned, was crowded.*
>
> ***32.** With all due respect to the felicity of Mr. Lall in presenting, for judicial consideration, the somewhat innovative concept of a crowded market place, the Trade Marks Act does not recognise any such concept. The proscription against claiming of exclusivity in respect of part of a mark is to be found in Section 17(2). That provision proscribes claiming of exclusivity in respect of part of a registered trademark, where the said part is "common to the trade". A Division Bench of this Court has already*

examined the ingredients which are required to be satisfied before Section 17(2) can be invoked against the plaintiff, to dispute the entitlement of the plaintiff to seek claim exclusivity in respect of the whole or part of the mark which is asserted in the plaint. In Pankaj Goel v. Dabur India, this Court has spoken thus:

> *"21. As far as the Appellant's argument that the word MOLA is common to the trade and that variants of MOLA are available in the market, we find that the Appellant has not been able to prima facie prove that the said 'infringers' had significant business turnover or they posed a threat to Plaintiff's distinctiveness. In fact, we are of the view that the Respondent/Plaintiff is not expected to sue all small type infringers who may not be affecting Respondent/Plaintiff business. The Supreme Court in National Bell v. Metal Goods, has held that a proprietor of a trademark need not take action against infringement which do not cause prejudice to its distinctiveness. In Express Bottlers Services Pvt. Ltd. v. Pepsi Inc, it has been held as under:—*
>
> > *"….To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the malicious persons, just to harass the proprietor may use his mark by way of pinpricks…. The mere use of the name is irrelevant because a registered proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence… Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark. This Court is inclined to accept the submissions of the respondent No. 1 on this point… The respondent No. 1 did not lose its mark by not proceeding against insignificant infringers…"*
>
> *22. In fact, in Dr. Reddy Laboratories v. Reddy Pharmaceuticals, a Single Judge of this Court has held as under:—*
>
> > *"…the owners of trade marks or copy rights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. If the impugned infringement is too trivial or insignificant and is not capable of harming their business interests, they may overlook and ignore petty violations till they assume alarming proportions. If a road side Dhaba puts up a board of "Taj Hotel", the owners of Taj Group are not expected*

to swing into action and raise objections forthwith. They can wait till the time the user of their name starts harming their business interest and starts misleading and confusing their customers.""

(Emphasis supplied)

xxx xxx xxx

33. *Relying on Pankaj Goel, this Bench has, in a recent decision in Glaxosmithkline Pharmaceuticals Ltd. v. Horizon Bioceuticals Pvt. Ltd., observed as under:*

"7.2.4 The onus to establish the existence of the ingredients to substantiate a plea that a mark, or a part thereof, is common to the trade, is unquestionably on him who so asserts. It is for Mr. Khera, therefore, to positively establish, at least prima facie, that the suffix DEX is common to the trade in pharmaceutical preparations. I do not think that he has succeeded in doing so.

7.2.5 How has Mr. Khera attempted to discharge this burden? He has cited a number of pharmaceutical products, the names of which end in DEX. The question is - does the burden on him thus stand discharged?

7.2.6 Pankaj Goel would indicate otherwise, but, before adverting to that decision, another facet of this issue merits mention.

****

7.2.8 For the rest, the issue stands covered by the passages from Pankaj Goel reproduced supra. Merely citing marks of products containing DEX as a suffix is insufficient to substantiate a contention that DEX, as a suffix, is common to the trade in pharmaceutical preparations. On the defendant, pleading that the part of the brand name, common to the product of the plaintiff and the defendant, is publici juris, is cast the onus to establish the assertion. This, according to Express Bottlers Services and Pankaj Goel, requires the defendant to show (i) substantial use, by the proprietors of the marks cited by it, (ii) the extent of trade in products bearing the said marks and (iii) that the said marks pose a threat to the distinctiveness of the mark asserted by the plaintiff. Else, would not be possible for this Court to return a finding that the mark of the plaintiff, or the part thereof which, according to the defendant, is common to the trade, is indeed so.

7.2.9 By corollary, it would be even more impermissible for the defendant to plead that the plaintiff's mark, or a part thereof, has become common to the trade, thereby invoking Section 17(2)(b) of the Trade Marks Act, by merely citing registrations, existing on the Register of Trade Marks, of names containing the asserted mark, or a part thereof. As is often correctly pleaded in these cases, "common to *register" is qualitatively different from "common to the trade". One may register a mark and leave it unused. Products bearing marks which stand registered in the Register of Trade Marks may never see the market, or may, at best, make sporadic appearances. Such registrations cannot divest the plaintiff's mark of distinctiveness, or disentitle the plaintiff to injunction.*

7.2.10 Plainly put, a mark, though registered, may not make it "to the trade". Section 17(2)(b) applies only where the asserted mark, or a part thereof, is common "to the trade". The use of the article "the", in Section 17(2)(b) is, in my considered opinion, significant. There is a clear difference between the expressions "common to trade" and "common to the trade".

7.2.11 It is an elementary principle of legislative interpretation that the legislature is presumed not to indulge either in superfluity or tautology. Every word used in parliamentary legislation is intended, axiomatically, to have been deliberately used. This principle applies with greater force where the use of the concerned word or phrase is not necessary to make the provision, in which it is used, syntactically complete. If, therefore, the legislature has, in the phrase "common to trade", inserted the definitive article "the", that insertion has to be treated as deliberate and intended to serve a particular purpose. Etymologically, the insertion of the definitive article "the" is obviously intended to make the provision applicable to "the trade" which could, in a manner of speaking, be analogised to "the market". The use of the definitive article "the" indicates that the accompanying word "trade" is to be understood, in the provision, as a noun, and not a verb. As a noun, "trade" has been defined in several judgments of the Supreme Court. Perhaps the most comprehensive definition is to be found in Fatechand Himmatlal v. State of Maharashtra, which defines "trade", used as a noun, as meaning "lending, movements of goods, transactions linked with merchandise order, flow of goods, the promotion of buying and selling advance, borrowings, discounting bills and mercantile documents, banking and other forms of supply of funds". What, therefore, section 17(2)(b) requires is commonness, of the asserted mark or part thereof, to "the trade"; in other words, in the trade relating to the goods to which the mark pertains, the use of part of the mark must be found to be "common". "The trade" referring to actual flow of goods in the market, it is necessary for the defendant who invokes Section 17(2)(b) to establish that, in the market relating to such goods, the use of the asserted mark, or part thereof, is common.

7.2.12 The word "common, too, has its own significant etymological connotation. Commonality cannot be easily presumed. It has to be *established as a statistical reality. "Common is defined in P. Ramanatha Aiyar's authoritative Advanced Law Lexicon, as "describing something that happens very frequently, or that applies equally to a number of people, without exclusion or differentiation. The Worcester Dictionary, also quoted in Ramanatha Aiyar, defines "common, as an adjective, as meaning "usual, accustomed, shared among several; owned by several jointly; belonging to the public; general; universal; frequent, customary, habitual. Plainly stated, therefore, for the use of an expression to be regarded as "common to the trade", the persons who are asserting as to establish, positively, that the use of the expression in the trade is frequent, customary or habitual. Registering of a multiplicity of marks containing the expression can go no way, whatsoever, towards that end.*

7.2.13 In other words, what Section 17(2)(b) envisages is, firstly, the existence of a trade in the articles, or class of articles, in respect of which the asserted mark is used by the plaintiff and, secondly, frequent, customary or habitual use, in that trade, of the mark, or part of the mark, asserted by the plaintiff which the defendant claims to have become "common to the trade". By its very nature, satisfaction of this test would require appreciation of evidence. It would require the Court to be satisfied of (i) the existence of a trade in the article, or class of articles, in respect of which the plaintiff uses the asserted mark and (ii) common, i.e. frequent, customary or habitual use, in that way, of the mark or part thereof. It is only, therefore, where there is sufficiently overwhelming evidence, of the satisfaction of these two ingredients, placed on record by the defendant, that the Court may, at a prima facie stage, justify the invocation of Section 17(2)(b), by holding that the mark asserted by the plaintiff, or a part thereof, has become "common to the trade", thereby disentitling the plaintiff from claiming exclusivity in respect thereof.

7.2.14 Tested on this touchstone, it cannot be said that Mr. Khera has made out a case for holding the plaintiff disentitled from claiming exclusivity on the ground that the suffix DEX is common to the trade. The Court does not have, with it, statistical data regarding the market presence of other pharmaceutical compounds, the brand names of which end with DEX. When one excludes, from the examples cited by Mr. Khera, those products which contain dexamethasone or dextromethorphan, the remaining examples cannot, at the prima facie stage, make out a case under Section 17(2)(b) of the Trade Marks Act. The principle that the mere failure, on the part of the plaintiff, to sue every infringer, cannot disentitle it from claiming exclusivity vis-à-vis the infringer whom it chooses to sue, would also apply in such circumstances."

> ***34.*** *The aforenoted observations apply mutatis mutandis, to the facts of the present case. Mere citing of a multitude of marks, which are available on the register of trade marks and which include, as a part or as the whole thereof, "ARMOUR", cannot make out a case of the marks asserted in the present case, or even of part thereof, being common to the trade."*

38. From the aforesaid judgments, it is clear that to establish the plea of 'common to trade', one will have to show substantial use of the mark by the third parties through evidence since a proprietor of the trademark is not expected to sue every small infringer. There may be occasions when some party may use a mark only to harass the proprietor. Courts have consistently taken a view that by merely citing registrations, existing on the Register of Trade Marks, of names containing the asserted mark or a part thereof is not enough inasmuch as 'common to register' is qualitatively different from 'common to the trade'. One may register a mark and leave it unused and the products bearing the mark may never see the market or at best may make sporadic appearances and such registrations cannot divest the proprietor's mark of its distinctiveness or disentitle injunction. Therefore, merely citing four marks with prefixes 'DAPLO' without a shred of evidence on their actual use cannot divest Petitioner's mark DAPLO of its distinctiveness and Petitioner's right to use the said mark and/or seek cancellation of registrations of identical or deceptively similar marks, particularly, when the marks are in the field of pharmaceutical products.

39. Counsel for Respondent No.1 also argued that there is no scope of confusion in the market since the drugs in question treat Type-2 Diabetes Mellitus and are prescription drugs. This argument must be rejected at the outset in light of the observations of the Supreme Court in ***Cadila Health (supra)***, as follows:-

*"**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 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. case where it has been held as under:*

> *"(5) In the field of medical products, it is particularly important that great care be taken to prevent any possibility of confusion in the use of trade marks. The test as to whether or not there is confusing similarity in these products even if prescribed and dispensed only by professionally trained individuals does not hinge on whether or not the medicines are designed for similar ailments. The rule enunciated by Judge Helen in Cole Chemical Co. v. Cole Laboratories [DC Mo 1954, 118 F Supp 612, 616, 617, 101, USPQ 44, 47, 48] is applicable here:*
>
> > *'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.'*
>
> *The observations made by Assistant Commissioner Leeds of the Patent Office in R.J. Strasenburgh Co. v. Kenwood Laboratories, Inc. [106 USPQ 379 (1955)] USPQ 380 are particularly apt, that:*
>
> > *'Physicians are not immune from confusion or mistake. Furthermore it is common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently handwriting is not unmistakably legible. These facts*

enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced.'

The defendant concedes that physicians and pharmacists are not infallible but urges that the members of these professions are carefully trained to detect difference in the characteristics of pharmaceutical products. While this is doubtless true to dos (sic) not open the door to the adoption by manufacturers of medicines of trade marks or names which would be confusingly similar to anyone not exercising such great care. For physicians and pharmacists are human and in common with the rest of mankind are subject to human frailties. In the field of medicinal remedies the courts may not speculate as to whether there is a probability of confusion between similar names. If there is any possibility of such confusion in the case of medicines public policy requires that the use of the confusingly similar name be enjoined (see Lambert Pharmacol Ltd. v. Bolton Chemical Corpn. [DCNY 1915, 219 F 325.326])."

***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 mistaking one mark from another." (Schering Corpn. v. Alza Corpn. [207 USPQ 504 (TTAB 1980)]).

40. I may also refer in this context to the judgment of the Division Bench in ***Glenmark v. Sun Pharma (supra),*** where the Court held as follows:-

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

***"21.** It will be useful to refer to some decisions of American courts relating to medicinal products. In the case of American Cynamid Corpn. v. Connaught Laboratories Inc. [231 USPQ 128 (2nd Cir 1986)] it was held as under:*

"Exacting judicial scrutiny is required if there is a possibility of confusion over marks on medicinal products because the potential harm may be far more dire than that in confusion over ordinary consumer products."

22. It may here be noticed that Schedule 'H' drugs are those which can be sold by the chemist only on the prescription of the doctor but Schedule 'L' drugs are not sold across the counter but are sold only to *the hospitals and clinics. Nevertheless, it is not uncommon that because of lack of competence or otherwise, mistakes can arise specially where the trade marks are deceptively similar. In Blansett Pharmaceuticals Co. v. Carmick Laboratories Inc. [25 USPQ 2, 1473 (TTAB 1993)] it was held as under:"Confusion and mistake is likely, even for prescription drugs prescribed by doctors and dispensed by pharmacists, where these similar goods are marketed under marks which look alike and sound alike."*

23. In the case of Glenwood Laboratories, Inc. v. American Home Products Corpn. [173 USPQ 19 (1972) 455 F Reports 2d, 1384 (1972)] the Court of the United States had held that:

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

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

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

25. The drugs have a marked difference in the compositions with completely different side effects, the test should be applied strictly as *the possibility of harm resulting from any kind of confusion by the consumer can have unpleasant if not disastrous results. The courts need to be particularly vigilant where the defendant's drug, of which passing-off is alleged, is meant for curing the same ailment as the plaintiff's medicine but the compositions are different. The confusion is more likely in such cases and the incorrect intake of medicine may even result in loss of life or other serious health problems. In this regard, reference may usefully be made to the case of Glenwood Laboratories, Inc. v. American Home Products Corpn. [173 USPQ 19 (1972) 455 F Reports 2d, 1384 (1972)] where it was held as under:*

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

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

41. This Court is of the opinion that the mark DAPLOGIN is deceptively similar to the mark DAPLO, which is an earlier registered trademark and the rival products under the two marks are identical with same API and are for treating Type-2 Diabetes Mellitus. The fact that both are prescription drug,

as held consistently, is not enough to dispel the likelihood of confusion and therefore, the registration of the mark DAPLOGIN falls foul of Sections 9(1)(a) and (2)(a) and 11(1)(b) of 1999 Act. The Supreme Court has held in ***Cadila Health (supra),*** in trademark disputes relating to pharmaceutical products, it is the primary duty of the Courts to take utmost care to prevent any possibility of confusion inasmuch as confusion in non-medicinal products may at best cause economic loss but confusion in the pharmaceutical industry may have disastrous effects on the health of the patients and therefore, the threshold of the confusion is different. It is also settled that phonetic similarity/pronunciation can cause huge confusion at the time of purchase of the product, which must be avoided at all cost.

42. Accordingly, this petition is allowed and registration of the mark DAPLOGIN under No.5208898 in Class 05 is cancelled. Respondent No.2/Registrar of Trade Marks is directed to rectify the Register of Trade Marks within six weeks from today for the sake of purity of Register.

43. Petition is disposed of in the aforesaid terms.

JYOTI SINGH, J.

AUGUST 17 , 2026/YA