

(2019) 07 BOM CK 0020**Bombay High Court****Case No:** Commercial IP Suit No. 32 Of 2011

Macleods Pharmaceuticals Ltd

APPELLANT

Vs

Swisskem Healthcare And Ors

RESPONDENT

Date of Decision: July 2, 2019**Acts Referred:**

- Trade Marks Act, 1938 - Section 12
- Trade Marks Act, 1999 - Section 2(1)(h)

Hon'ble Judges: S.J. Kathawalla, J**Bench:** Single Bench**Advocate:** Mikhail Behl, Sonal Doshi, Hiren Kamod**Final Decision:** Dismissed

Judgement

1. The present Suit is filed by the Plaintiff against the Defendants for infringement of the Plaintiff's registered trade marks "PANDERM"

and "PANDERM +" bearing registration Nos.1309828 and 1849407 respectively both in Class 5 and passing off. The Plaintiff has inter alia

sought a permanent order and injunction against the Defendant from using the trade mark POLYDERM +, which according to the Plaintiff is

deceptively similar to the Plaintiff's registered trade marks. Prayer clause (a) of the Plaint is reproduced hereunder:

"(a) That the Defendants by itself, its servants and agents be restrained by a perpetual order and injunction of this Hon'ble Court from in any

manner using in relation to medicinal preparations or any products of the Defendant under the impugned trade mark "POLYDERM+" (Exhibit

"F" hereto) or any other deceptively similar trade mark similar to the Plaintiff's trade mark so as to infringe the Plaintiff's trademarks,

“PANDERM” and “PANDERM +” and to pass off or enable others to pass off the Defendants’™ product as and for the products of the Plaintiff’s™

2. Since the beginning of this Suit, the Defendants have neither entered their appearance, nor contested the Suit, nor the Notice of Motion, despite the service of papers and proceedings and Writ of Summons upon them. The Defendants have not filed any Written Statement. In view thereof, the Suit has proceeded ex-parte. There is no ad-interim or interim injunction order operating against the Defendants till date. Though, the Plaintiff had moved an application seeking ad-interim injunction against the Defendants, this Court (S.J. Vazifdar, J. as he then was), vide its Order dated 14th June 2011, refused to grant ad-interim injunction in favour of the Plaintiff solely on the ground that the two rival marks PANDERM and POLYDERM are not deceptively similar. When this Suit came up before me for hearing for the first time, I had expressed my first impression that - there is no similarity between the rival trade marks PANDERM and POLYDERM. Mr. Behl, Ld. Advocate for the Plaintiff, however, insisted that I should reconsider the aspect of similarity between the rival trade marks particularly in view of the fact that the Defendant has not contested the Suit at all, to which I agreed.

3. The heart and soul of any trade mark dispute, such as the present one, is mostly dependent upon one and only one aspect i.e. whether the trade mark used by the Defendant is identical with and / or closely and / or deceptively similar to the Plaintiff’s™ trade mark and consequently whether there is a possibility of confusion or deception . If ultimately, it is held that there is no deceptive similarity between the rival trade marks, then the matter really ends there and the question of confusion or deception does not arise. No amount of evidence adduced to show prior user or reputation of the Plaintiff’s™ mark can be of assistance to the Plaintiff in such a situation since the whole basis of an infringement and / or passing off action, such as the present one, is dependent on the Court coming to a conclusion that there is deceptive similarity between the rival trade marks. If the rival trade marks are held not to be identical or deceptively similar, there cannot be any cause of action for either infringement or passing off.

4. Considering the fact that the Defendants have not been represented in this matter and in order to ensure that all the principles of trade mark law are put before the Court from the perspective of both the sides, this Court, on 22nd January 2019 appointed Mr. Hiren Kamod, Counsel to assist the Court as Amicus Curiae in the present matter.

5. On 5th March 2019, I heard Mr. Behl, Ld. Advocate for the Plaintiff and Mr. Kamod, Ld. Amicus Curiae in detail, and the matter was reserved for orders.

PLAINTIFF'S SUBMISSIONS :

6. The Plaintiff is engaged in the business of manufacturing and sale of pharmaceutical and medicinal preparations. The present proceedings pertain to dermatological ointments manufactured and sold by the Plaintiff and the Defendants under the trade marks PANDERM / PANDERM + and POLYDERM +, respectively. The rival products seem to have similar molecular compositions and are used in the treatment of infections caused by anaerobic bacteria.

7. As per the Plaintiff, in or about the year 2004-05, the Plaintiff honestly conceived and adopted the trade mark "PANDERM" for its

dermatological preparations. In or about the year 2009-10, the Plaintiff conceived and adopted the trademark "PANDERM" wherein the symbol

"+" signifies the positive results from application of the Plaintiff's product. According to the Plaintiff, PANDERM / PANDERM + is an

original word that has been coined by the Plaintiff. The Plaintiff derived the trade mark PANDERM by combining the Latin word

"PANDEMUS" which means "of all people" and the word "DERMATOLOGY" i.e. the branch of medicine concerned with the

physiology and pathology of the skin and treatment of skin diseases. The trademark "PANDERM" suggests "a treatment for the skin diseases

/ ailments of all the people". It is stated that on or about 20th September 2004 the Plaintiff applied for and secured registration of its trade mark

PANDERM bearing Registration No.1309828 in Class 5. On 11th August 2009, the Plaintiff applied for and secured registration of the trade mark

PANDERM + bearing Registration No.1849407 in Class 5.

8. In or about February 2011, the Plaintiff learnt that the Defendants are manufacturing and marketing the impugned product bearing the impugned trade mark "POLYDERM +". Hence, the Plaintiff filed the present Suit.

9. The Plaintiff has led its evidence by filing Affidavit in lieu of Examination-in-Chief dated 10th August 2013 of Mr. Vivekanand Mukherjee,

Marketing Manager of the Plaintiff; Affidavit in lieu of Examination in Chief dated 30th March 2013 of Mr. Nitesh Srivastava, Senior General

Manager of the Plaintiff; Affidavit in lieu of Examination in Chief dated 30th March 2013 of Mr. Vinayak Shirodkar, Vice President, Accounts and

Finance of the Plaintiff. Through the said evidence, various documents were tendered in Court which are taken on record and marked Exhibit-X

collectively.

10. Mr. Behl, Ld. Advocate for the Plaintiff submitted that the impugned trade mark "POLYDERM+" is identical with and / or deceptively

similar to the Plaintiff's trade marks PANDERM / PANDERM+. He submitted that the rival marks are phonetically, visually and structurally

identical and / or deceptively similar. He submitted that the packaging / trade dress of the Defendant's impugned product is also same as that of

the Plaintiff's product. He pointed out the similarities between the rival packaging / trade dress, details of which are more particularly provided in

paragraph 14 of the Plaint. He submitted that both, the Plaintiff and the Defendant's products are Schedule H drugs. He submitted that this is a

cause for concern, as vulnerable patients would be facing the risk of using the Defendant's product believing the same to be of the same quality

and efficacy as that of the Plaintiff.

11. Mr. Behl submitted that since the Defendants are in the same business as that of the Plaintiff, they ought to have been aware of the Plaintiff's

goods bearing the trade marks PANDERM / PANDERM+ when the Defendants adopted the said trade mark. He submitted that a man of ordinary

intelligence and imperfect recollection is likely to be confused between the Plaintiff's trade mark PANDERM / PANDERM + and the

Defendants' trade mark POLYDERM +. He submitted that the Defendants have made a deliberate attempt to infringe upon the Plaintiff's

trade mark by placing its logo, name and address in the same position and style as that of the Plaintiff. He submitted that despite having a chemical composition identical to that of the Plaintiff, the Defendants'™ product is not stated to be a Schedule H drug on its packaging. He submitted that the unsuspecting consumers who purchase the Defendants'™ products, risk suffering side effects and health complications.

12. Mr. Behl highlighted the following features of the rival cartons, which according to the Plaintiff are deceptively similar and / or identical to its carton :

a. The placement of the mark PANDERM / PANDERM+ viz.a.viz. POLYDERM+, on the top left of the carton / tube.

b. The font of the rival marks as written, both in the English language and in the Devnagiri script.

c. The manner and style in which the trading names of the Plaintiff i.e. (MACLEOD with barcode design below) and the Defendant (PIECIES with barcode design below) are both written on the top right of their respective cartons / tubes.

d. The manner in which the trade marks and trading names of the Plaintiff and the Defendant appear on the flap of their respective cartons.

e. The 'œswoosh line' below the trade mark PANDERM / PANDERM+ and an almost identical wavy line embellishment below the trade mark of the Defendants'™ POLYDERM+.

f. The 'œ+â€ sign following the trade mark POLYDERM is placed in a manner which is identical to the manner in which it is placed on the Plaintiff's™ carton / tube. This can be noted not only for the English word 'œPANDERM+â€ , but equally for the Devnagiri translation thereof.

g. An identity in the manner in which information about the product is presented i.e. the manner in which the composition is shown, as well as the manner in which the addresses are mentioned, as well as the location of this information on the cartons in juxtaposition to one another.

13. Mr. Behl relied upon the Supreme Court's™ decision in the case of Corn Products Refining Co. v. Shangrila Food Product Ltd. AIR 1960 SC

142 He submitted that in this case it was held that in an infringement action the test was of first impression, rather than of skilled / experienced judge

or lawyer; that the view of an "ordinary man of average intelligence and imperfect recollection" must be applied. He submitted that applying the same test, an ordinary man of average intelligence and imperfect recollection is unlikely to recall any difference between the rival marks especially due to the similarity between the cartons / labels and the composition of the products.

14. Mr. Behl also relied upon the Supreme Court's decision in the case of *Amritdhara Pharmacy v. Satya Deo Gupta* AIR 1963 SC 44.9 He

submitted that in this case the Supreme Court held that Courts must consider "the idea behind the mark", its etymology and the manner in which

this idea behind the mark is likely to be assessed by an ordinary man of average intelligence and imperfect recollection in the Indian scenario. The

relevant excerpts relied upon by the Ld. Advocate for the Plaintiff are reproduced below:

"8. It is not disputed before us that the two names 'Amritdhara' and 'Lakshmandhara' 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 v. Shangrila Food Products Ltd.* [1960] 1 SCR 96 8, 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 meanings 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

townsmen will perhaps know Lakshman, the story of the Ramayana being familiar to him, but we doubt if he would etymologine 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.

9. 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.â€|â€

15. Mr. Behl relied upon a Judgment of the High Court of Madras in the case of Wockhardt Limited v. Aristo Pharmaceuticals Limited 1999 PTC

(19) 540. He submitted that in this case the Madras High Court has appreciated the likelihood of the mispronunciation of the letters â€œPâ€ and

â€œFâ€. He submitted that an ordinary man of average intelligence and imperfect recollection is not going to pause and attempt to assess whether

there is any phonetic similarity / dissimilarity between the rival trade marks or that the Defendantsâ€™ product is the same as the Plaintiffâ€™s

product.

16. Relying upon the Supreme Court's decision in Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd. 2001 PTC 300 (SC), Mr. Behl submitted

that the slight difference in spelling between the rival marks may not be noticed by customers who come to purchase the Plaintiff's medicine. He

submitted that there is every likelihood of confusion and a customer is very likely to purchase the Defendant's products believing it to be that of

the Plaintiff's.

17. Relying upon the Delhi High Court's decision in Glaxo Group Ltd. & Anr. v. Paun & Paum Chemicals 2003 (27) PTC 234 (Del), Mr. Behl

submitted that to a person of average intelligence and imperfect recollection, the overall structural similarity between the rival marks is likely to cause

confusion, especially when the cartons are similar in all respects.

18. Mr. Behl relied upon another decision of the Delhi High Court in Pfizer Ireland Pharmaceuticals v. Intas Pharmaceuticals and Anr. 2004 (28) PTC

456 (Del) He submitted that in this case it was held that to consider visual or phonetical similarity, the entire word as a whole must be considered. He

submitted that the Defendant by changing a few letters in its trade mark is trying to cash upon the reputation which has been built by the Plaintiff over

the years.

19. Mr. Behl further submitted that a Division Bench of this Court in the case of Sun Pharmaceutical Industries Limited v. Wyeth Holdings

Corporation and Ors. 2005 (30) PTC 14 (BOM) (DB) had held that the trade mark PACITANE of the respondent therein was deceptively similar to

the trade mark of the appellant PARKITANE even after holding that the prefixes ""Pace"", ""Par"" and ""Paki"" and suffixes ""Tan"", ""Thane"", ""Ten"" and

Teen"" are common to the trade.

20. He also relied upon this Court's decision in Encore Electronics Ltd. v. Anchor Electronics & Electricals Pvt. Ltd. 2007 (5) Bom.C.R. 262 He

submitted that in this case it was held that phonetic and visual similarities constitute an important index as to whether a mark is deceptive and

misleading.

SUBMISSIONS OF AMICUS CURIAE :

21. Mr. Kamod the Learned Amicus Curiae, at the outset made submissions on the general principles in relation to the law of "deceptive similarity" of trade marks. He submitted that both at the stage of interim and final relief, the matter rests on first impression itself. He submitted that trade marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. He submitted that it is important to find out what is the distinguishing or essential feature of the Plaintiff's trade mark and what is the main feature or the main idea underlying that trade mark, and ascertain if the Defendant's trade mark contains the same distinctive or essential feature, or conveys the same idea. He submitted that in deciding the question of similarity between the two marks, the approach must be from the point of view of a man of average intelligence and imperfect recollection. He submitted that marks must be compared as a whole. He submitted that the true test is whether the totality of the Defendant's trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark. He submitted that while ascertaining the question of deceptive similarity, the Courts must not conduct a microscopic examination and both the visual and the phonetic tests must be applied. He submitted that the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances must also be considered. He submitted that the prefix in a mark is important and the first syllable is considered to be an important factor in deciding the phonetic similarity between the two trade marks.

22. Mr. Kamod submitted that if the settled principles of trade mark law are applied to the present case, the rival marks PANDERM and POLYDERM cannot be said to be deceptively similar. He submitted that the Plaintiff's mark consists of 2 syllables i.e. PAN + DERM, whereas, the Defendant's trade mark consists of 3 syllables i.e. PO + LY + DERM. He submitted that though the marks are always to be compared as whole, the first syllable of a word mark is generally the most important one as there is a tendency of person using the English language to slur the termination of words. He relied upon the decision of a Division Bench of this Court in the case of Johann A. Wulfig v. Chemical Industrial and

Pharmaceutical Laboratories Limited and Ors. 1984 (4) PTC 81 (Bom). The relevant excerpts relied upon by him are reproduced below:

10. This method of approach is to start with the microscopic method of comparison with the marks placed side by side. Such approach has

repeatedly been condemned in various decisions, *F. Hoffmann v. Geoffrey Manners*, [1970] 2 SCR 213, being one, where the Supreme Court rejected

the contention that "Dropovit" and "Protovit" were likely to deceive or cause confusion. In the present matter, the Joint Registrar's emphasis on the

starting letter "C" in both the words, does not take into account the total phonetic dissimilarity between the 2 words, namely that the very same "C" is

pronounced entirely differently in both the words, it is not the suffix that is the controlling sound. It is the disparate "COM" and the other as written)

that is the controlling sound and it is that which makes all the difference. "The first syllable of a word mark is generally the most important". As there

is a "tendency of person using the English language to slur the termination of words". (Kerly's Law of Trade Marks, 11th ED. Page 416). In *Re;*

Bayer Products, (1947) 64 RPC 125, it was held that "Diasil" and "Alasil" were not deceptively similar or likely to cause confusion.

Where the first two syllables are different, there is little likelihood of confusion. So was it observed by the Division Bench of the Madras High Court in

Mount Mettur v. Ortha Corporation, AIR1975Mad74, while holding that UTOGYNOL and ORTHOGYNOL were not deceptively similar.

11. The Court is not concerned with hypothetical possibilities but with the ordinary practical business probabilities having regard to the circumstances

of the case. *F. Hoffmann Roche v. Sanitex Chemical Industries* (1965) 67 BOMLR 729 .

In the present case, all things considered, (visually and

phonetically). We do not see any real tangible danger of "confusion in the mind of the public which will lead to confusion in the goods". (*Pianotist case*

(1906) 23 RPC 774.

(Emphasis Added)

23. Mr. Kamod submitted that admittedly the rival products are dermatological products and the suffix of the Plaintiff's mark is derived from

"DERMATOLOGY". He submitted that DERM is a common suffix in the pharmaceutical industry with respect to dermatological products and it

is very likely that the Defendants have adopted their suffix DERM from the same word. Relying upon the Supreme Court's decision in F.

Hoffmann-la Roche & Co. Ltd. v. Geoffrey Manner & Co. Pvt. Ltd. 1982 (2) PTC 335 (SC), he submitted that in such circumstances the first

syllable is of greater importance. The relevant excerpt from the said judgment is reproduced below:

¶ It is necessary to apply both the visual and phonetic tests. In *Aristoc Ltd. v. Rysta Ltd.* 62 R.P.C. 65 the House of Lords was considering

the resemblance between the two words "Aristoc" and "Rysta". The view taken was that considering the way the words were pronounced in English,

the one was likely to be mistaken for the other. Viscount Maugham cited the following passage of Lord Justice Luxmoore in the Court of Appeal,

which passage, he said, he completely accepted as the correct exposition of the law :

The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of

Section 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, It is also important that the marks must be compared as

wholes. It is not right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in

the other case there is no sufficient similarity to cause confusion. The true test is whether the totality of the proposed trade mark is such that it is likely

to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark. Thus in *Layroma case, Tokalon Ltd. v.*

Davidson & Co. 32 R.P.C.133 Lord Johnston said :

...we are not bound to scan the words as we would in a question of comparatio literarum. It is not a matter for microscopic inspection, but to be taken

from the general and even casual point of view of a customer walking into a shop.

8. In order to decide whether the word "DROPOVIT" is deceptively similar to the word "PROTOVIT" each of the two words must, therefore, be

taken as a whole word. Each of the two words consists of eight letters, the last three letters are common, and in the uncommon part the first two are

consonants, the next is the same vowel 'o', the next is a consonant and the fifth is again a common vowel 'o'. The combined effect is to produce an

alliteration. The affidavits of the appellant indicate that the last three letters ""VIT"" is a well known common abbreviation used in the pharmaceutical

trade to denote Vitamin preparations. In his affidavit dated January 11, 1961 Frank Murdoch, has referred to the existence on the Register of about 57

trade marks which have the common suffix ""VIT"" indicating that the goods are vitamin preparations. It is apparent that the terminal syllable ""VIT"" in

the two marks is both descriptive and common to the trade. If greater regard is paid to the uncommon element in these two words, it is difficult to hold

that one will be mistaken for or confused with the other. The letters 'D' and 'P' in ""DROPOVIT"" and the corresponding letters 'P' and 'T' in

PROTOVIT"" cannot possibly be slurred over in pronunciation and the words are so dissimilar that there is no reasonable probability of confusion

between the words either from the visual or phonetic point of view.â€

24. Mr. Kamod submitted that in cases when the marks are evolved from generic drugs, or parts of body organs, or the branch of science to which

they belong, the emphasis is always on the other parts / features of the marks. While he submitted that there can be no quarrel with the principle that

the marks are always to be compared as a whole, he submitted that where a part of a mark is descriptive, as it is in the present case (DERM which

describes DERMATOLOGY), greater regard is to be paid to the uncommon element in the two marks i.e. PAN and POLY, in this case. He relied

upon this Courtâ€™s decision in Macleods Pharmaceuticals Limited v. Intas Pharmaceuticals Ltd. and Ors. 2013 (55) PTC 380 (Bom) The relevant

excerpt from the said Judgment is reproduced below:

â€œ27. The Plaintiff has contended that the mark LETHYROX used by the Defendant No. 1 is deceptively similar to their marks THYROX and

ANTI THYROX which they have been using since 1996, whereas the Defendant No. 1 has stoutly denied the said allegation and has submitted that

the test for determination of deceptive similarity is that the marks must be compared as a whole. It is also submitted that the mark THYRO is publici

juris and there cannot be any monopoly on the use of the mark THYROX. In cases when the marks are evolved from generic drugs and/or parts of

body organs, the emphasis is always on the other parts/features of the marks. In various judgments, the Supreme Court and also this Court has held

that where a part of a mark is either descriptive or common to trade, greater regard is to be paid to the uncommon element in the two marks. â€

(Emphasis Added)

25. Mr. Kamod submitted that this Court in the case of Ranbaxy Laboratories Ltd. v. Indohemie Health Specialities Pvt. Ltd. 2002 (24) PTC 510

(Bom) observed that an ordinary Indian consumer may have absolutely no knowledge of the English language and therefore, the visual similarity in the

rival marks which are both written in English would be of little consequence. He submitted that in such circumstances this Court tested the phonetic

and aural similarity between the rival marks to ascertain the probability of confusion. He submitted that the Court further observed that a party who

uses a descriptive or generic term for its trade mark cannot be permitted to monopolize the same. The relevant excerpts relied upon by him are

reproduced below:

â€œ9.â€! It is, therefore, obvious that as both the marks are written in English language and Roman script, visual similarity or absence of visual

similarity of the two marks is not of much consequence. So far as the aspect of phonetic similarity is concerned, the mark of the Plaintiff is Zanocin

and the mark of the Defendant is Zenoxim. Now comparing these two marks phonetically, so far as the prefix ""Zan"" and ""Zen"" are concerned, they

appear to be phonetically similar, however suffix ""Ocin"" and ""Oxim"" can not be said to be so. â€!

11. â€! Thus, the marks adopted by both the parties are derived from the name of the basic drug that is used by them. The marks are thus, descriptive

in nature being indicative of the composition of the medicine. The Delhi High Court has considered this aspect in its judgment in the case of M/s.

Panacea Biotec Ltd, K Mis. Recon Ltd. 1996 PTC 16 and has observed thus:-

6. From a comparison of the two it is clear that the first three letters of the trade mark of the plaintiff have been taken from the name of the drug

Nimesulide"". Suffix of the trade mark of the plaintiff consists of four letters which are 'ULID' and the same have also been taken from the last but

four letters of the name of the same drug. It appears that the Plaintiff has adopted trade mark 'NIMULID' in view of its near similarity or

resemblance with the name of the basic drug 'Nimesulide'. In fact NIMULID can be taken as short form for the generic name of the drug

'Nimesulide'. The trade mark of the plaintiff is descriptive in nature indicate of the composition of the medicine. It is well settled that no person can

claim exclusive use of the descriptive and generic terms. It would be highly undesirable to confer on one trader proprietary right over the use of an

ordinary, descriptive or a generic word indicative of the nature, composition and quality of the goods as that would give him complete monopoly to

exploit the word to the exclusion of others. A word which can qualify as an exclusive mark of a trader must be distinctive so as to distinguish his

goods from those of the other persons.

10. Having regard to the aforesaid decisions, I am of the opinion that where a party uses a descriptive and generic term for its trade mark it cannot be

given sole right to use the same to the exclusion of other traders. Commonly used words in trade and descriptive of the nature or colour or laudatory

of the quality of the goods cannot be permitted to be monopolised. Similarly, in the case of a medicine, if a manufacturer uses the name of the basic

drug of which it is constituted, no monopoly can be claimed by him in regard to the use of the same as his trade mark.

I find myself in respectful agreement with the above view.â€

26. Mr. Kamod submitted that when a trade mark is formed from the common generic name or the branch of science to which they belong, no single

proprietor can claim absolute monopoly in such name or trade mark. He submitted that when the Plaintiff adopted the trade mark PANDERM on the

basis of the branch of science to which its products belong viz. DERMATOLOGY, the Plaintiff ought to have been aware that the other proprietors

are also likely to adopt and use similar marks in case their product is also based on DERMATOLOGY. He submitted that when two trade marks are

coined on the basis of the branch of science to which they belong, there are bound to be similarities between the two, and in such a case even if the

differences between the two trade marks are minor or small, then also no injunction ought to be granted. He relied upon the case of Schering

Corporation v. United Biotech (P) Ltd. 2011 (1) BomCR 89 Mr. Kamod submitted that though this Judgment was passed in the context of a passing

off action, the principle would apply even to an infringement action. The relevant excerpt of the said Judgment is reproduced below:

¶11. ¶ The Appellants have adopted their trade mark NETROMYCIN from the generic drug name Netilmicin. When a trade mark is found from the common generic name, no single proprietor can claim absolute monopoly in such name or trade mark. When a proprietor adopts a trade mark on the basis of name of generic drug or ingredient, it will be safe to assume that he is aware that the other proprietors are also likely to adopt and use similar marks in case their product is based on the same generic drug or ingredient. In such a case, the first user cannot claim exclusivity in his trade mark or in the name which is derived from the generic drug. At the most such proprietor can claim exclusivity in those added features which differentiates his trade mark from the name of the generic drug or ingredient. When two trade marks are coined from the same generic drug or ingredient, there are bound to be similarities between the two and in such a case, even if the differences between the two trade marks are minor or small, then also at least at the prima facie stage no injunction can be granted.

12. It has come on record that the other manufacturers and traders of medicinal goods have also adopted trade marks with prefix NET to indicate the drug name Netilmicin Sulfate and the suffix MICIN/MYCIN is common to pharmaceutical trade. Both the trade marks are used in respect of Netilmicin Sulfate and both the trade marks owe their origin to the said medicine name.

Since there is commonality in origin, ingredient, composition and purpose, even if one drug is consumed for the other, there cannot be disastrous consequences. ¶

(Emphasis Added)

27. Mr. Kamod further submitted that where the compositions of the rival products are the same, the question of causing health problems really does not arise. He submitted that this principle was recognized by a Division Bench of this Court in Bal Pharma Limited v. Wockhardt Limited & Anr.

Unreported Judgment ¶ DB ¶ Bombay High Court dated 12th June 2002 in Appeal No.490 of 2002 The relevant excerpt of the Judgment is reproduced below:

“In the present case apart from the fact that there is no likelihood of confusion in the two marks there is no difference in the composition of the two drugs and both products are made of a single ingredient viz Azithromycin and, therefore, the question of causing any health problem or side effects really does not arise.”

28. Mr. Kamod submitted that there cannot be any quarrel with the principles laid down by the Judgments cited by the Ld. Advocate for the Plaintiff.

He however submitted that each case must be judged on its own features and it would serve no useful purpose to note on how many points there were similarities and in how many others there was absence of it.

29. On the aspect of similarity in the packaging of the rival products, Mr. Kamod submitted that the Plaintiff in this Suit is praying for relief against

infringement and passing off on the basis of its word mark PANDERM / PANDERM + bearing Registration Nos. 1309828 and 1849407 both in Class

5. The Plaintiff has pleaded about its proprietary and statutory right in the word mark PANDERM / PANDERM+. He submitted that the Plaintiff has

neither pleaded nor claimed, let alone proved any proprietary rights, in its packaging or trade dress. He submitted that the Plaintiff’s Plaintiff and

evidence is devoid of any pleadings / statements wherein it pleads or claims a proprietary right in its packaging / trade dress/carton. He submitted that

there may be several others before the Plaintiff using the same or similar carton or packaging, and that in order to claim any kind of proprietary right

over the packaging, carton or trade dress, the least the Plaintiff could have done was to plead that its carton or packaging or trade dress is unique, or

that the Plaintiff has acquired common law right/proprietary right in respect of the same. To substantiate the submissions, he drew my attention to the

Plaint alongwith the prayers therein and the Evidence Affidavits filed by the Plaintiff.

30. He further submitted that considering the nature of the products involved i.e. medicinal and pharmaceutical preparations “ Scheduled H Drug,

coupled with the case of the Plaintiff in the Plaintiff and Evidence Affidavits, the similarity if any, between the packaging / trade dress of rival products,

is of no consequence to the reliefs prayed for in the present Suit. He submitted that the issue that requires adjudication is whether the Defendants’s

by using the wordmark POLYDERM + are infringing the Plaintiff's registered trade marks PANDERM / PANDERM+, and passing off their goods as and for those of the Plaintiff.

31. My first impression before the hearing commenced in the present matter was that the rival trade marks are completely dissimilar, both visually and

phonetically and even at the conclusion of the hearing, I am of the opinion that there is no similarity in the Plaintiff's trade marks

PANDERM/PANDERM+ and Defendant's trade mark POLYDERM. Though the Plaintiff has led evidence to establish its statutory right in its

trade mark PANDERM / PANDERM+ and the goodwill and reputation acquired therein, which I must state is uncontroverted in view of the fact that

the Defendants have chosen not to contest the Suit, I am of the opinion that the Plaintiff is not entitled to the reliefs as prayed for, in view of my

reasoning given hereunder.

32. The question of deceptive similarity between the two trade marks arises in the following proceedings:

- a. Application for registration of a trade mark;
- b. Notice of Opposition to application for registration of a trade mark;
- c. Application for rectification of a registered trade mark;
- d. Infringement of trade mark;
- e. Passing Off.

The expression "deceptive similarity" is defined in Section 2(1)(h) of the Trade Marks Act, 1999 as follows:

"deceptively similar" A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to

be likely to deceive or cause confusion

33. The principles for deciding the question of deceptive similarity between the rival trade marks, albeit in the case of passing off, are laid down by the

Supreme Court in the case of Cadila (supra) as follows:

- a. The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.

- b. The degree of resemblance between the marks, phonetically similar and hence similar in idea.
- c. The nature of the goods in respect of which they are used as trade marks.
- d. The similarity in the nature, character and performance of the goods of the rival traders.
- e. The class of purchasers who are likely to buy the goods bearing the marks, they require, on their education and intelligence, and a degree of care they are likely to exercise in purchasing and / or using the goods.
- f. The mode of purchasing the goods or placing orders for the goods, and g. Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

The Apex Court has also observed that "Weightage is to be given to each of the aforesaid factors depending upon the facts of each case and the same weightage cannot be given to each factor in every case.

34. The weightage that is required to be given to the factors enumerated by the Supreme Court in Cadila case (supra) differs from case to case. In

case of pharmaceutical preparations, the nature of the goods is a factor which is required to be given greater importance. In the case of

pharmaceutical preparations, three important aspects that are required to be taken into consideration are as follows:

- a. For deciding the question of deceptive similarity, the test is one of possibility and not probability of confusion;
- b. Stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by a consumer;
- c. Public interest would support lesser degree of proof in establishing confusing similarity in the case of a trade mark in respect of medicinal products as against other non-medicinal products.

35. The Pianotist's case 1906 (23) RPC 774 which involved comparison of two word marks and quoted by the Supreme Court in Amritdhara

(supra) has laid down the test of deceptive similarity generally applicable to all the cases. The relevant quotation is reproduced hereunder:

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.

36. Now, it is a well settled principle that while comparing the deceptive similarity between the rival trade marks, the Court should consider their overall similarity, including the similarity of the main idea and the similarity of their broad and salient features, rather than doing a microscopic examination and close scrutiny by placing the rival marks side by side and extracting their dissimilarities. The Division Bench of this Court in the case of M/s. Hiralal Prabhudas v. Ganesh Trading Company & Ors. AIR 1984 BOM 218 has summarized the law relating to deceptive similarity as under:

“5. What emerges from these authorities is (a) what is the main idea or salient features, (b) marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole, (c) overall similarity is the touchstone, (d) marks must be looked at from the view and first impression of a person of average intelligence and imperfect recollection, (e) overall structure, phonetic similarity of idea are important and both visual and phonetic tests must be applied, (f) the purchaser must not be put in a state of wonderment, (g) marks must be compared as a whole, microscopic examination being impermissible, (h) the broad and salient features must be considered for which the marks must not be placed side by side to find out differences in design and (i) overall similarity is sufficient. In addition indisputably must also be taken in-to consideration the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances.”

37. Undisputedly, it is a practice in the field of medicinal and pharmaceutical preparations to derive / coin trade marks from either of the following:

- a. the generic names of the components/molecule (Example “ TELMA from TELMISARTAN);
- b. the disease which the drugs are meant to cure (Example “ PARKITANE from PARKINSONS);
- c. the body organ for which the drug is used (Example “ Thyrox from Thyroid); or

d. the stream of science to which the drug belongs (Example - ONCO-BCG from Oncology - the science of treating cancer).

38. Even in the present case the Plaintiff, and possibly the Defendants have derived their respective mark PANDERM / PANDERM+ and

POLYDERM+ for their dermatological product from the stream of science to which the product belongs viz. DERMATOLOGY. The marks

involved in the present case are word marks. There is no visual or structural similarity in the Plaintiff's registered trade mark PANDERM and the

Defendants' trade mark POLYDERM. Keeping aside the descriptive suffix DERM which is indicative of a dermatological product, the only

similarity between the rival trade marks is the first letter in both marks i.e. 'P'. It is neither the Plaintiff's case, nor would it be fair to allow

the Plaintiff to monopolize the suffix DERM in respect of pharmaceutical preparations. In this respect it would be important to consider the practical

aspects to ascertain the possibility of confusion. As this Court has held before in cases such as the present one where a part of the rival mark is

descriptive, greater regard must be paid to the uncommon element in the two marks, which in this case are PAN and POLY. The Plaintiff's trade

mark consists of two syllables as against the Defendants' trade mark which consists of three syllables. In my view, the first syllables of the rival

wordmarks PANDERM and POLYDERM are sufficiently dissimilar to rule out any chance of confusion. I am of the opinion that an average

consumer is unlikely to be confused between the rival trade marks since the pronunciation of the rival marks are easily distinguishable.

39. To ascertain phonetic similarity between the rival trade marks, the number of syllables in the rival trade marks, alongwith the aural and phonetic

effect from the pronunciation of the same must be considered. Where the rival trade marks have different number of syllables, like in the present

case, their pronunciation is bound to be different. It is important to consider how an average consumer in India would hear or pronounce the said trade

marks. In the present case, the Plaintiff's mark PANDERM has two syllables i.e. PAN + DERM which in the Devangiri script are pronounced

as and respectively. Similarly, the Defendants' marks POLYDERM has three syllables i.e. PO + LY + DERM which are pronounced

as , and respectively. In view thereof, I do not see how a person with average intelligence and imperfect recollection in India would be

confused between the rival marks which have such distinctive prefixes. In the absence of any likelihood of confusion or deception, the Plaintiff's

action for infringement or passing off cannot lie.

40. Whether the sound of one word resembles too nearly the sound of another, must nearly always depends on the first impression, as held in in the

matter of an application by Rysta Ltd. (1943) 60 RPC 87 at 108 As already observed, earlier my first impression was and still remains that there is no

phonetic or visual similarity between the rival trade marks PANDERM and POLYDERM+.

41. It is also a settled principle of law that the prefix in a trade mark is important and the first syllable is considered to be an important factor in

deciding the phonetic similarity between the two trade marks. In the matter of trade mark application Herogen 1913 (Vol. 30) RPC page 73 at 76,

while considering the deceptive similarity between the two trade marks viz. Herogen and Cerogen, it was held that the two trade marks are not similar

because their first syllable were different. The said principle is also reiterated by the Division Bench of this Court in Johann A. Wulfing case (supra),

wherein while comparing the rival trade marks CIPLAMINA and COMPLAMINA in respect of medicinal and pharmaceutical preparations, this

Court came to a conclusion that the two trade marks are not similar. It was held that the first syllable of a word mark is generally the most important

as there is a tendency of person using the English language to slur the termination of words. The first syllable generally plays an important role in

assisting the identification of the mark and creates a lasting impression in the person's mind. Applying the said principle to the present case, there

is no doubt in my mind that the rival marks PANDERM and POLYDERM with completely different prefixes and syllables can ever be termed as

deceptively similar.

42. Further, even in the case of F. Hoffmann-la Roche & Co. Ltd. v. Geoffrey (supra), while deciding a question of deceptive similarity between

marks DROPOVIT and PROTOVIT, the Supreme Court holding that the suffix- 'VIT' was descriptive, gave more emphasis on the uncommon

elements between the rival marks and it arrived at the conclusion that the same are not deceptively similar. The Court held that the 'D' and 'P' in

DROPOVIT"" and the corresponding letters 'P' and 'T' in ""PROTOVIT"" cannot possibly be slurred over in pronunciation and the words are so

dissimilar that there is no reasonable probability of confusion between the words, either from the visual or the phonetic point of view. I believe the

same principle is squarely applicable to the present case.

43. Even applying the principles laid down by M/s. Hiralal Prabhudas (supra) to the present case, I am of the opinion that there is no overall similarity

between the rival marks. The idea conveyed by the rival marks PANDERM and POLYDERM cannot be considered to be the same. The rival marks

are phonetically, structurally and visually dissimilar. I do not think that an ordinary person of average intelligence and imperfect recollection, who has

seen the Plaintiff's products bearing the trade mark PANDERM / PANDERM + on a prior occasion, would be confused or deceived upon

encountering the Defendants' products bearing the mark POLYDERM or that such person would be put into a state of wonderment. Bearing in

mind the principles set out above, while comparing the marks in the present matter i.e. PANDERM / PANDERM + and POLYDERM +, I do not see

a reasonable possibility of confusion between the trade marks whether visually or phonetically. DERM being a descriptive term, the Plaintiff cannot be

permitted to claim monopoly in its use merely because it is a prior user or adopter of the term. The Plaintiff ought to have been cognizant of the fact

while adopting a suffix from a term such as DERMATOLOGY that other proprietors are also likely to adopt and use similar marks in respect of their

dermatological products.

44. The essential and distinguishing features of the Plaintiff's and the Defendants' marks are the prefixes "PAN" and "POLY". Had

the case been that the Defendant was using a similar sounding prefix such as "TAN", "DAN", "BAN" etc. or other similar term, the

case would have been different. However, the structure of the rival marks and the phonetical dissimilarity does not permit any likelihood of confusion

or deception amongst the public. Compared as a whole, the Defendants' trade mark is both visually and phonetically dissimilar with the

Plaintiff's mark.

45. Relying upon the Supreme Court's decision in Cadila (supra) a Division Bench of this Court in Bal Pharma Limited v. Wockhardt Limited &

Anr. (supra) has observed that where the chemical composition of two drugs is the same, the question of causing any health problem or side effects

really does not arise. Admittedly, the compositions of the Plaintiff and the Defendants' products are identical. Thus, there is no cause for concern

with respect to public health.

46. While there is no quarrel with the principles set out in the Judgments cited on behalf of the Plaintiff, which principles I have applied to the present

case, it is a settled position in law that the authorities are binding for the principle laid down and not for the facts viz. whether in one case, the two

marks were considered to be similar or not. Each case is required to be decided on its own facts 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. I, have however observed that one Judgment relied upon by the Plaintiff in the

case of Wockhardt v. Aristo (supra) has been set aside by the Supreme Court vide its Order dated 24th November 1999 in Civil Appeals Nos. 6739-

6740 of 1999.

47. The present case is filed on the basis of infringement and passing off of the Plaintiff's wordmark PANDERM / PANDERM +. A perusal of

the record endorses the submission of Mr. Kamod that the Plaintiff has neither pleaded nor claimed, let alone proved any proprietary rights in its

packaging or carton or trade dress. The relevant excerpts from the Complaint and the said Affidavits in Lieu of Examination-in-Chief relied are

reproduced below:

A. Complaint

16. The Plaintiff states that by using the impugned trade mark "POLYDERM+", the Defendants have been and are infringing the registered

trademarks of the Plaintiff and are also likely to further pass off or enable others to pass off their products as and for those of the Plaintiff or in some

way connected with the Plaintiff.

17. I say that the Defendants by using the impugned, trade mark "POLYDERM" are infringing the Plaintiffs registered trademark "PANDERM"

and "PANDERM" and are passing off their medicinal preparations as that of the Plaintiff. I say

B. Affidavit in Lieu of Examination-in-Chief of Mr. Niteesh Srivastava, Senior General Manager of the Plaintiff, dated 30th March 2013

I say that the packaging and symbols on the packaging of the infringing carton is identical to the packaging of the Plaintiff's cartons. I

say that on account of the similarity of the trademark "POLYDERM" with the registered trademarks of the Plaintiff "PANDERM" &

"PANDERM" there is a likelihood that the public would be confused and associate the infringing trademark "POLYDERM" with the

trademark of the Plaintiff "PANDERM" & "PANDERM". I say

C. Affidavit in Lieu of Examination-in-Chief of Mr. Vivekanand Mukherjee, Marketing Manager of the Plaintiff, dated 10th August 2013

I say that the packaging and symbols on the packaging of the infringing carton is identical to the packaging of the Plaintiff's cartons. I

say that on account of the similarity of the trademark "POLYDERM" with the registered trademarks of the Plaintiff "PANDERM" &

"PANDERM" there is a likelihood that the public would be confused and associate the infringing trademark "POLYDERM" with the

trademark of the Plaintiff "PANDERM" & "PANDERM". I say

It is not the Plaintiff's case that it has a unique and / or artistic packaging / trade dress/ carton to which it has the exclusive proprietary rights. It is

not the Plaintiff's case that the Plaintiff has been using the said packaging / trade dress / carton openly, continuously, exclusively or extensively, or

that by virtue of such open and continuous use, the Plaintiff has acquired goodwill and reputation in the said packaging / trade dress/ carton. Though I

find that the Plaintiff has alleged that the Defendants have a similar packaging and / or trade dress, there is no specific pleading that the Plaintiff has

acquired any proprietary right in its packaging or trade dress or carton in the first place. In short, the Plaintiff has not come to the Court with the case

that it has any proprietary or statutory or common law right in its packaging or trade dress or carton and therefore the question of comparing the

Defendants'™ carton with that of the Plaintiff's™ carton does not arise.

48. In any event, before considering the features of the rival cartons, the Court must satisfy itself that the rival word marks are visually similar, and

only when it is satisfied, the Court may go on to consider whether the added matter upon the Defendant's carton out-weighs the impression created by

the visual similarity of the marks themselves. I have observed hereinbefore that the rival word marks are not similar. There is no visual or phonetic

similarity between the word marks. Hence, the question of considering the similarities between the rival cartons, as suggested by the Plaintiff, does not

arise. In any event, even if I was to consider both the cartons, I do not feel that both are so similar so as to outweigh the impression of dissimilarity

created by the rival word marks and thereby create any confusion or deception.

49. In view of the above, the Plaintiff is not entitled to reliefs as prayed for in the present Suit. The Suit is accordingly dismissed with no order as to

costs.