

rajshree

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
COMMERCIAL APPEAL (L) NO.42382 OF 2025
WITH
INTERIM APPLICATION (L) NO.42454 OF 2025
IN
COMMERCIAL APPEAL (L) NO.42382 OF 2025
WITH
COMMERCIAL APPEAL(L) NO.42382 OF 2025
IN
INTERIM APPLICATION (L) NO.9484 OF 2025
WITH
COURT RECEIVER REPORT NO.220 OF 2025
IN
COMMERCIAL IP SUIT (L) NO.9352 OF 2025

Sun Pharmaceutical Industries Ltd. .. Appellant

vs.

Meghmani Lifesciences Ltd. & Anr. .. Respondents

Mr.Hiren Kamod a/w Mr.Prem Khullar, Mr.Rahul Dhote, Mr.Shwetank Tripathi, Ms.Radhika Mehta and Vidit Desai i/b ANM Global, for the Appellant.

Mr.Rashmin Khandekar a/w Mr.Anand Mohan, Mr. Ashutosh Kane, Ms.Vedangi Soman and Ms.Avani Panchabhai i/b W.S. Kane & Co. for Respondent No.2.

Mr.Nitin Pawar, Court Receiver, present.

**CORAM : BHARATI DANGRE &
MANJUSHA DESHPANDE, JJ**

DATE : 8th APRIL 2026

JUDGMENT (PER BHARATI DANGRE, J) :

1 Sun Pharmaceutical Industries Limited, Appellant/Plaintiff, a Public Limited Company incorporated under the Companies Act, 1956, is engaged in the business of manufacturing, trading, marketing, selling and/or distributing medicinal and pharmaceutical preparations. It claims to be number one pharma company in India with 8.3% market share and ranked no.1 by prescription with 12 different classes of doctors. The Plaintiff's products claim to have the hallmark of technology-based differentiation covering full range of dosage forms including tablets, capsules, injectables, inhalers, ointments, creams and liquids as it offer comprehensive product portfolio across various therapeutic segments.

According to Sun Pharmaceutical Industries Ltd, it owns large Intellectual Property portfolio containing various well-known, distinctive and coined trademarks in relation to its medicinal and pharmaceutical preparations and one such mark which it claim has honestly, independently and bonafidely coined, conceived and adopted is the trademark 'RACIRAFI' in January, 2022. It is the claim of the Appellant that the said trademark was coined by combining the words 'RACI' (misspelling of the word RACY which suggest "full of zest and vigour" and the word 'RAFI' (meaning foam like formation caused by Sodium Alginate).

Claiming that the trademark is a coined word and is inherently distinctive and has been in use since June 2022 in relation to a pharmaceutical product containing the molecules

viz. Sodium Alginate, Sodium Bicarbonate and Calcium Carbonate, and Calcium Carbonate, sold in form of oral suspension/syrup being used in the treatment of heartburn and indigestion, it has the quality of neutralizing the acid present in the stomach and aiding proper digestion. The Appellant sought registration of the said trademark in Class 05 on 'proposed to be used basis'.

The particulars of the registration of the trademark of the Appellant are set out in the proceedings before us as below :-

Sr.No.	Mark	Application Date/User Claim	Class	Status
1.	RACIRRAFT	17 January 2022/Proposed to be used	5	Registered valid and subsisting

2 Claiming that in or about 3rd week of February, 2025, the team of the Appellant came across the Defendant's pharmaceutical product bearing the impugned mark 'ESIRRAFT', and they suspected that the Defendants are using the impugned mark in relation to the identical goods containing identical molecule for identical ailment, as that of the Plaintiff and as the mark as virtually visual, structurally and phonetically has deceptive similarity and substantially similar to the Appellant's prior adopted used and registered trademark. It was therefore constrained to institute a Commercial Suit on the Commercial Division of the High Court, seeking leave under Clause XIV of the letters patent to combine the cause of action of infringement of trademark and passing off and it sought a perpetual order and injunction from infringing its registered trademark 'RACIRRAFT'

in Class 5 by the use of the impugned mark 'ESIRRAFT' and/or any other trademark with the said word and/or any other mark identical with or deceptively similar to the Plaintiffs' trademark, in respect of the goods covered by its registration.

In the Suit, it also sought an injunction restraining the Defendants from dealing with the impugned goods or any other medicinal or pharmaceutical preparations identical with and/or deceptively similar to the Plaintiff's well-known trademark, so as to pass off the Defendants impugned goods as and for the Plaintiffs' well-known goods, or in any other way.

3 In the aforesaid suit filed for infringement of trademark and passing off, on 07/04/2025, ad-interim relief was granted in its favour in terms of prayer clause (a) and (b) with the following primary reasons being assigned while granting such relief.

“15. Having compared the two products and trade marks found on the said products, it is found that a strong prima facie case is made out in favour of the applicant. The defendants have used combination of the expressions 'Esi' and 'Raft' in different colours, similar to the manner in which the registered trade mark 'RACIRRAFT' of the applicant is depicted on its products. The explanation given in the reply to the examination report by defendant No. 1 before the Registrar of Trade Marks, as brought to the notice of this Court, shows that the same can be said to be supporting the contention raised on behalf of the applicant.

16. In any case, the expression 'Raft' prima facie does not appear to be sourced from any molecule or chemical composition, which could have led to a plausible defence on the part of the defendants. There is substance in the contention raised on behalf of the applicant that its registered trade mark "RACIRRAFT" can be said to be a coined mark and in that sense, an arbitrary mark enjoying higher protection in the trade mark law.”

4 On 23/12/2025 Interim Application (L) No.9484/2025 came to be decided by the learned Single Judge, thereby vacating

the ad-interim relief granted on 07/04/2025 and dismissing the Interim Application filed by the Plaintiff by recording that it has failed to make out prima facie case for infringement of trademark and passing off and in absence of any deceptive similarity prima facie being demonstrated, the Defendants cannot be restrained from use of the impugned mark which has been adopted and in use by it since July, 2024.

5 Being aggrieved by the aforesaid order, the Appellant has approached this Court by alleging that the impugned order is ex-facie perverse and contrary to the settled principles of trademark especially in relation to pharmaceutical product. The Single Judge's finding that that Respondent No.1's impugned mark 'ESIRAFIT' and the opponent's trademark 'RACIRAFIT' are dissimilar/not deceptively similar is urged to be contrary to the settled said test of deceptive similarity laid down by the Apex Court in *Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd.*¹ as well as the following decisions which were specifically invoked before the learned Single Judge :-

1. *Medley Laboratories (P) Ltd. vs. Alkem Laboratories Ltd.*²;
- 2 *Macleods Pharmaceuticals Ltd. vs. Union of India*³;
- 3 *Boots Company PLC vs. Registrar of Trade Marks*⁴;
- 4 *Encore Electronics Ltd. vs. Anchor Electronics & Electricals Pvt. Ltd.*⁵;
- 5 *Lupin Ltd. vs. Eris Lifesciences (P) Ltd.*⁶;
- 6 *Wyeth Holdings Corporation vs. Burnet Pharmaceuticals (Pvt. Ltd.)*⁷;
- 7 *Glenmark Pharmaceuticals Ltd. vs. Sun Pharma Laboratories Ltd.*⁸.

1 (2001) 5 SCC 73
 2 2002 SCC OnLine Bom 444 (DB)
 3 2023 SCC OnLine Bom 408 (DB)
 4 2002 SCC OnLine Bom 300
 5 2007 SCC OnLine Bom 147
 6 2015 SCC OnLine Bom 6807
 7 2008 SCC OnLin Bom 76
 8 2024 SCC OnLine Del 2707

6 We have heard the learned counsel Mr.Hiren Kamod for the Appellant, who would place reliance upon the aforesaid decisions and submit that the the approach of the learned Single Judge in comparing the rival trademark is contrary to the well settled principles of comparison laid down and the impugned order has failed to consider the settled principle of deceptive similarity, as the order has failed to appreciate the visual and phonetic structure of the trademark and when the phonetics is to be looked into, the sound which accompanies the pronunciation of the trademark is the sound of the mark when ordinary purchaser, bereft of the niceties of language.

According to Mr.Kamod, the learned Single Judge has failed to appreciate the anti deception rule, which stipulate that marks cannot be deceptive into their constituents parts for the purpose of comparison and has overlooked the applicability test i.e. not to place two marks side by side to identify dissimilarities , but to determine whether the impugned mark, when viewed independently, is likely to create an impression of association of common origin, in the mind of an average consumer. He would submit that the learned Judge has erred in holding that Respondent No.1's trademark 'ESIRAFIT' is not deceptively similar to the Appellant's trademark 'RACIRAFIT' and has disregarded the fact that the Appellant is prior and continuous user of the trademark 'RACIRAFIT'. According to him, the impugned mark is visually and phonetically similar to the mark of the Appellant, and merely because the two letters are written in capital and others are in small letters do not make it visually or structurally dissimilar to the Appellant's mark.

As per Mr.Kamod, the learned Single Judge has failed to apply the decision of this Court in *Lupin Ltd. vs. Eris Lifesciences (P) Ltd* (supra) , where it is held that meticulous comparison of rival trademarks is not permissible and the rival trademarks cannot be compared word by word and syllable by syllable , pronounced with clarity to be expected from a teacher of elocution and the Judge has failed to appreciate the principle in law that phonetic similarity test is crucial and is the principle determinative test.

7 Mr.Kamod by inviting our attention to the pleadings in the Plaint would submit that the Plaintiff has conceived and adopted the trademark 'RACIRAFIT' and it is also registered proprietor of the mark 'RACIPER' and its variants and it is inherently distinctive. He would submit that the rival marks when compared as whole are identical and/or deceptively similar to each other and the Plaintiff sought relief in the Suit on the basis of overall structural, phonetic and visual similarities between the rival marks 'RACIRAFIT' and 'ESIRAFIT'.

According to him, Defendant No.1 who is his own manufacturer , would have very well adopted any other trademark with the use of 'RAFIT' as a part, but it has chose to use 'ESIRAFIT' which is nearly identical with and/or deceptively similar to its mark 'RACIRAFIT' coupled with the fact that it is using 'ESI' in different colour and 'RAFIT' in different colour, using the same style of the Appellant using 'RACI' in different colour and 'RAFIT' in different colour, which according to Mr.Kamod is reflective of its dishonesty.

According to him, Defendant No.1 had dishonestly filed an Application on 21/03/2024 for registration of its mark in relation to impugned goods under Class 5 on 'proposed to be used basis' which is presently pending and is clearly reflective that it is the Appellant who is prior adopter and user of the trademark. When specifically asked whether the Appellant has raised any objection, Mr. Kamod submit that since it is not yet advertised, and hence no objection is raised.

It is also the contention of Mr. Kamod that in the past Defendant No.1 competed with one 'EASYRAFT', but clarified that it is 'ESIRRAFT'.

He has invited our attention to a reply filed to the Examination Report in respect of the Application for trademark 'ESIRRAFT' where it is stated that the trademark 'ESIRRAFT' has a unique structure and pronunciation that set it apart from cited trademark 'ESYRAFT' AND 'EASYRAFT' and that the mark should be viewed as a composite whole and, therefore, it is evident that the trademark possesses its own distinctive character.

8 Mr.Kamod would place reliance upon the following decisions:-

1. *Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd. (supra);*
2. *Medley Laboratories (P) Ltd. vs. Alkem Laboratories Ltd.*⁹;
3. *Macleods Pharmaceuticals Ltd. vs. Union of India*¹⁰;
4. *Boots Company PLC England & Anr. vs. Registrar of Trade Marks, Mumbai*¹¹;

9 2002-3 MHLJ 546

10 2023 SCC OnLine Bom 408

11 2002 SCC OnLine Bom 300

- 5 *Encore Electronics Ltd. vs. Anchor Electronics & Electricals Pvt. Ltd.*¹²;
 6 *Wyeth Holdings Corporation & Anr. vs. Burnet Pharmaceuticals (Pvt.*
*Ltd.)*¹³;
 7 *Glenmark Pharmaceuticals Ltd. vs. Sun Pharma Laboratories Ltd.*¹⁴;
 8 *Schering Corporation & Ors. vs. Kilitch Co. Pharma Pvt. Ltd.*¹⁵;
 9 *Cadila Pharmaceuticals Ltd. vs. Sami Khatib of Mumbai*¹⁶;
 10 *Pidilite Industries Ltd. vs. S.M. Associates & Ors.*¹⁷;
 11 *Dr. Ashok M. Bhat vs. Sandeep Udai Narain Gupta & Anr.*¹⁸;
 12 *Dr. Reddys Laboratories Limited vs. Smart Laboratories Pvt. Ltd.*¹⁹.

9 Bring critical of the impugned order, it is the submission of Mr. Kamod that insofar as pharmaceutical products are concerned, the test to be applied should be more stringent as public interest would support lesser degree of proof showing confusing similarity in the case of trademark in respect of medicinal products as against other non medicinal products, as confusion between medicinal products, may be life threatening and not mere inconvenience. He would submit that for applying visual and phonetic test, if the sound of one word resembles too nearly to the sound of other, the test for likelihood of confusion shall be applied, as it is a person who only knows one word and has perhaps an imperfect collection of it who is likely to be deceived or confused.

It is his submission that the court must be careful to make allowance for imperfect recollection as the effect of careless pronunciation in speech on the part not only of the person seeking to buy under trade description, but also of the shop

12 2007 SCC OnLine Bom 147
 13 2008 SCC OnLine Bom 76
 14 Delhi HC CM Appl. 36508/2023
 15 1990 SCC OnLine Bom 425
 16 2011 SCC OnLine Bom 484
 17 2003 SCC OnLine Bom 143
 18 2025 SCC OnLine Bom 2177
 19 2023 SCC OnLine Del. 7276

assistant catering to that person's wants.

According to him, the true test is, whether the totality of proposed trademark is such that it is likely to cause deception or confusion or mistake in the mind of persons accustomed to the existing mark and it is not a matter of microscopic inspection, but it has to be taken from the general and even casual point of view of the customer visiting the shop for purchase of the product.

By relying upon the test of 'possibility' of confusion in medicinal preparation as held by the Apex Court in *Cadila Health Care Ltd.* (supra) and despite the Court declaring to take special care in such cases where the confusion may harm and result in unpleasant consequences if not disastrous results, Mr.Kamod would submit that the learned Single Judge has not applied the said test and, therefore, the impugned order deserve to be set aside.

10 Opposing the Appeal, the learned counsel Mr.Rashmin Khandekar, at the outset has urged before us that the scope of inquiry to entertain an Appeal from a interlocutory order passed in exercise of discretion is extremely limited and circumscribed and well defined and he would place reliance upon the decision of this Court in case of *Wander Ltd. & Anr. vs. Antox India P. Ltd.*²⁰ and submit that an Appeal against exercise of discretion lies, only 'on principle' and the burden on the Appellant is much heavier than that before the Trial Court.

20 1990(Supp)SCC 727

According to him, in an Appeal it is not merely enough to demonstrate that a view and conclusion different from that of the learned Single Judge is possible, as if the Appellant seek interference, he must demonstrate that it is the only possible view and no other view is possible. According to Mr.Khandekar, in an attempt to raise challenge to the impugned order, Mr.Kamod had argued the Appeal as if this Court was the Court of first instance and not an Appellate Court.

Defining the prism through which the Appeal has to be examined, the learned counsel would submit that unless and until it is established that the impugned order is arbitrary, capricious or in the legal understanding of the term 'perverse', then in an Appeal there shall be no interference as the Appellate Court cannot substitute the order impugned.

11 Apart from the aforesaid objection, Mr.Khandekar would submit that a specific concession is given by the Plaintiff in the Plaint itself that it was not claiming any monopoly in protection of the term 'RAFT' *per se* as the term has specific meaning in the context of the specified goods/drugs and in the context of medicinal preparation. 'RAFT' refers to the foam like formation caused by Sodium Alginate and more particularly it refers to a process where a viscous, cohesive gel forms a continuous layer or 'raft', on top of gastric fluids in the stomach primarily used in gastroretentive drug delivery systems and for treating gastroesophageal reflux. From the pleadings of the Plaintiff, it is the contention of Mr.Khandekar that the Plaintiff itself did not claim any monopoly over 'RAFT' and rather has pleaded as

below:-

“The Plaintiff coined the said Trade Mark by arbitrarily combining the words ‘RACI’ (misspelling of the word ‘RACY’ which suggest ‘full of zest and vigour’ and ‘RAFT’ (which means foam like formation caused by Sodium Alginate).”

He would submit that the Plaintiff had clearly admitted in Para 24 of the Plaint that Defendant No.1 would have very well adopted any other trademark even if it wanted to use ‘RAFT’ as part of it and relying upon the aforesaid pleadings of the Plaintiff, it is the case of the Defendant that no monopoly can be claimed or is being claimed over the suffix ‘RAFT’.

12 Inviting our attention to the Reply filed the Defendant, Mr.Khandekar would submit that it has placed on record not less than 32 other brands/marks in the market and more than 100 entries/marks with Registry of Trademarks which has used non distinctive term ‘RAFT’ as a part of the mark and in the Plaintiff’s Affidavit in Rejoinder also according to Mr.Khandekar , the Plaintiff has made it abundantly clear that the Plaintiff has no problem with the usage of the word ‘RAFT’ *per se*.

It is therefore, the submission of Mr.Khandekar that in the backdrop of the admitted position between the parties and the factor that has weighed with the learned Single Judge in assessing the similarity between the rival mark ‘RAFT’, *per se* is an unprotected element being generic and nobody can claim monopoly over ‘RAFT’. The concession granted on behalf of the Plaintiff, according to Mr. Khandekar, lead to a legal consequence as it is settled position that when a mark consist of a word , on which no monopoly is claimed and it is generic and/or non

distinctive, greater regard is to be given to the balance part of the mark in the over all assessment of the rival marks.

He would invoke the principle of law laid down by the Apex Court in **F. Hoffmann- La Roche & Company v. Geoffrey Manners and Company Pvt. Ltd.**²¹, where the rival marks were 'DROPOVIT' and 'PROTOVIT', 'vit' being a non distinctive/generic/common reference to vitamin. He would invoke the following observation from the said decision, as it bear relevance to the issue in the present case and we reproduce the same as below :-

"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 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."

With the aforesaid observation, it is submitted by Mr.Khandekar that having taken into account all circumstances, the Apex Court expressed that the High Court and Joint Registrar of Trademarks were right in holding that there was no

21 1969 (2) SCC 716

real tangible danger of confusion if respondent's trade mark was allowed to continue to remain on the Register and the application for rectification made by the appellant should be dismissed.

According to Mr.Khandekar , the Judgment in ***Cadila Health Care*** (supra) relied upon by Mr.Kamod, specifically notices F. Hoffman La Roche & Company (supra) in Para 16 and has confirmed the same and it is his submission that a series of Division Benches of our Court has followed the dictum consistently and has referred to ***Cadila Health Care*** (supra) and has confirmed that when a trademark contains a part which otherwise cannot be monopolised , this aspect of industry practice needs to be factored while assessing overall similarity and the balance part of the mark is to be given greater weightage in the overall assessment..

Mr.Khandekar would place reliance upon the following following decisions of the Bombay High Court :-

- i) ***Bal Pharma Limited vs. Wockhardt Ltd. & Anr.***²²;
- ii) ***Schering Corporation vs. United Biotech (P) Ltd.***²³;
- iii) ***Macleod Pharmaceuticals Ltd. vs. Swisskem Healthcare***²⁴;
- iv) ***Corona Remedies vs. Franco Indian Pharmaceuticals Pvt. Ltd.***²⁵.

13 Relying upon the propositions flowing from the aforesaid pronouncements of this Court, Mr.Khandekar would submit that when a trademark is formed out of the common generic name, no single proprietor can claim absolute monopoly in such name or trademark, as when a Proprietor adopts a trademark on the basis of name of the generic drug or ingredient or molecule, it will be safe to assume that he is aware that the other proprietors are also

22 Appeal No.498.2002

23 2011(1)BomCR 89

24 2019 SCC OnLine Bom 1186

25 MANU/MH/0410/2023

likely to adopt and use similar marks in their products based on the same generic drug or ingredient. In such a case, the first user cannot claim exclusivity in its trademark or the name which is derived from a generic drug and at the most a proprietor can claim exclusivity in those added features, which differentiates his trademark from the name of a generic drug or ingredient.

According to Mr.Khandekar when two trademarks are coined from the same generic drug or ingredient, there is bound to be closeness between the two and in such case even if difference between the two trademarks is minor or small, then even in that case at prima facie stage no injunction can be granted. It is his contention that a part of a mark which is generic/ non distinctive must be discounted in over all assessment with the focus being on the distinctive/non generic part and this proposition is in tune with the fundamental principle that trademark law protect 'source' indicators and are not intended to create any overboard or absolute monopoly over common matters.

14 Taking us through the impugned order passed by the learned Single Judge it is the submission of Mr.Khandekar that the learned Judge has referred to the relevant test which ought to have been applied based on the well settled legal principles evolved from the authoritative pronouncements and he has drawn an inference that the mark is not similar.

Mr. Khandekar also submit that applying the well settled principles which govern the field while assessing the rival marks as regards the anti deception rule, view point of an average

consumer with imperfect recollection, holistic comparison and the likelihood of confusion of the competing marks, prima facie viewed the marks visually and phonetically were found to be dissimilar and no capable of creating any confusion in the minds of customers.

He do not dispute the proposition that even the slightest possibility of confusion must lead to restrain on use of impugned mark, but according to him only upon holistic comparison of rival marks, if there is any possibility of confusion, then a restraint order can be passed. It it, therefore, contended by Mr.Khandekar that the learned Single Judge has rightly applied and took into consideration the anti-deception rule as well as the relevant test namely overall comparison from the view point of an average consumer with imperfect collection, taking into account visual, structural and phonetic similarity and has rendered a finding that, 'RAFT' was admittedly not the subject of monopoly / proprietorship of the Plaintiff and, therefore, mere presence of such shared / generic word cannot justify a finding of deceptive similarity.

Apart from this, he would submit that both the marks which contain the word 'RAFT' which has an indicator of the products molecule properties, combined by the Plaintiff in its distinctive prefix 'RACI' and by the Defendant with its distinctive prefix 'ESI' is honest and bonafide and established in conformity with industry practice in pharmaceutical trade. The finding that the prefixes 'RACI' and 'ESI' being completely different in the manner of their pronunciation and even making an allowance of mis-pronunciation, according to the learned Judge has made it

difficult to hold that the marks are deceptively similar. It is submitted that the learned Judge has taken into consideration the diphthong and has arrived at the conclusion that there is no possibility of confusion, in E versus R and the use of two colour combination or packing which was sought to be invoked to establish similarity was of no consequence.

Relying upon the principle in *Cadilla Health Care* (supra) to the effect that weightage must be given to different factors depending upon the facts of each case and the same weightage cannot be given to each factor in every case, he would submit that the exercise of discretion based upon the weightage to each of the factors noted by the learned Judge is unimpeachable and the injunction has been rightly refused by the learned Single Judge on the conclusion of no similarity.

Apart from this, according to Mr.Khandekar the added matter is only relevant for an action of passing off and the comparison required is only qua the words other than the generic word and since in both the molecule 'RAFT' was identical, the Judge has arrived at a conclusion that there is no visual and phonetic similarity and no likelihood of confusion based on the guiding judicial pronouncements and therefore, according to him, the order passed by the learned Single Judge must be upheld.

He would also distinguish the Judgment relied upon by Mr.Kamod in case of *Macleods Pharmaceuticals Ltd.* (supra) in respect of trademark 'OFRAMAX' and the mark 'OFLOMAC' as it is his submission that in the said case, it was specifically held that the main ingredient of the product of Respondent No.4 is 'CEFTRIAXONE', whereas the main ingredient of the product of

the Petitioner was 'OFLOXACIN' and the two products differ in its method of use, dosage form and indications. With the formulation of both the products being distinct, it was specifically noted that in a medicinal or pharmaceutical product it is the duty of the Court to take utmost care to prevent any possibility of confusion in the use of trademarks as in case of non-pharmaceutical product the result may be every economic loss to the person, but on the other hand, a confusion in terms of medicinal product or pharmaceutical product may have disastrous effect on the health.

Holding that it is proper to require a lesser quantum of proof of confusing similarity for such products, the decision relied upon wherein there was presence of a common molecule in the two products, were held not to be relevant and in comparing the two marks based on the phonetic similarity it was held that the impugned trademark of the Petitioner was of such a nature so as to deceive the public or cause confusion with respect to the trademark of Respondent No.4 as envisaged under Section 9(2) (a) and Section 11(1)(b) of the Act of 1999.

15 The test of determining the deceptive similarity and the factors relevant for its determination was and is the subject matter of various authoritative pronouncements, as this issue has come up for consideration time and again, while deciding the cases for infringement of the registered trademark as well as in an action of passing off, both under the Trade and Merchandise Marks Act, 1958 as well as the Trade Marks Act, 1999.

Trademark is essentially adopted to advertise one's product and to make it known to the purchaser and 'mark' includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof., as per Section 2(m) of the Act of 1999.

A mark attempt to portray the nature and at times the quality of the product and on passage of time and its continuous usage the mark becomes synonymous with the product and a registered trademark deserve protection as the registered proprietor of the trademark has the exclusive right to use the mark in relations to the goods or services in respect of which it is registered and is entitled to obtain relief in respect of infringement of the trademark as provided under Section 29 of the Act of 1999.

A registered trademark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses the same in course of trade, a mark which a) is identical with or similar to the registered trademark, b) is used in relation to the goods or services which are not similar to those for which the trademark is registered and C) the registered trademark has a reputation in India and, the use of the mark without due permission taking unfair advantage of or is detrimental to the distinctive character or repute of the registered trademark.

The protection, however, is not available to a unregistered trademark, but in the wake of Sub Section (2) of Section 27, it will not affect the right of action against any person for passing off

goods or services as the goods of another person or as services provided by that person or the remedies in respect thereof. The said provision, thus, recognises the common law rights of the trademark owner to take action against any person for passing off the goods as the goods of another person. The passing off action has its source in the principle that nobody has a right to represent his goods as the goods of somebody.

16 In an action for the infringement it is imperative to make out that the use of the Plaintiff's mark by the Defendant is likely to deceive, but where the similarity between the Plaintiff and Defendant's mark is so close either visually, phonetically or otherwise, the relief sought alleging infringement and passing off shall be granted.

In an action for passing off the similarity between the competent marks is crucial and the Court should determine whether there is likelihood of deception or cause of any confusion. As far as drugs and pharma products are concerned, the Courts have treated them on a different pedestal and have directed application of the test of 'possibility' of harm strictly resulting from any kind of confusion by the consumer since it would give rise to disastrous results.

In *Cadila Health Care* (supra), the Court applied the test for similarity/dissimilarity by applying distinct parameters as it was conscious of the fact the drugs are meant for curing some ailment and the cure lies in its composition, coupled with the side effects and it is possible that the drugs are sold not only under prescription, but over the counter and the similarity or deceptive

similarity in the products would cause confusion, which would result in health hazardous.

Focusing on this aspect, the Apex Court observed thus :

“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')."

17 The Apex Court also did not rule out the possibility when the physicians themselves would be subjected to confusion or mistake as many a time the prescriptions are telephoned to the pharmacists and others are hand-written and frequently handwriting is not unmistakably legible and it was observed thus :-

“These facts enhance the chances of confusion or mistake by the pharmacists in filing the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced.”

It is also noted that although the drugs are sold under prescription this fact alone is not sufficient to prevent confusion which is otherwise likely to occur.

The peculiarity of this country was specifically focused upon when their Lordships observed thus:-

“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.”

18 Confusion between medicinal products, therefore is considered to be life threatening and not merely resulting into inconvenience and in the wake of a phenomenon that is common in hospital, drugs can be requested verbally and /or under critical or pressure situations with participation of many patients who are elderly, infirm or illiterate, when they may not be in a position to differentiate between medicines prescribed and brought, which is ultimately handed over to them , the Apex Court applied the test from *McCarthy on Trade Marks, 3rd Edition Para 23.12* as below :

"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."

19 In an action for passing off on the basis of unregistered trademark, for deciding the question of deceptive similarity the following factors are directed to be considered :

"35. Broadly stated, in an action for passing-off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors are to be considered:

(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.

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks."

It is further clarified that weightage shall be given to each of the aforesaid factors depending upon facts of each case and the same weightage cannot be given to each factor in every case.

20 In *F.Hoffmann-La Roche & Co. Ltd. vs. Geoferey Manner & Co. Pvt. Ltd.* (supra) , when the contest was between the Appellant's mark 'Protovit ' registered under Class V in respect of 'pharmaceutical preparations for human use and for veterinary use, infants' and invalids' foods' and the mark was used on multi-vitamin preparations in liquid form and tablet, the goods being sold since the year 1951, the Respondent applied for registration

of its mark 'Dropovit' in respect of 'medicinal and pharmaceutical preparations and substances'. The Application was registered which escaped the notice of the Appellant who filed an application for rectification before the Register on the ground that the mark of the Respondent nearly resemble its mark, as to be likely to deceive or cause confusion.

21 The question that felt for consideration was whether the word 'Dropovit' is deceptively similar to word 'Protovit' and offends the provision of Section 12(1) of the Act and the precise question formulated was, whether the Respondent's mark so nearly resemble the registered mark, as to 'likely to deceive or cause confusion'.

The test for comparison of the two words mark formulated by Lord Parker in *Pianotist Co. Ltd.*²⁶ was gainfully reproduced to resolve the issue before the Court:-

"You must take the two words. You must judge of 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. If, considering all those circumstances, you come to the conclusion that there will be a confusion, that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods-then you may refuse the registration, or rather you must refuse the registration in that case."

It is categorically held that the marks must be compared as a whole and it is not right to take a portion of the word and say that because that portion of the word differs from the

2623 RPC 774 at 777

corresponding portion of the word in other case there is no similarity sufficient enough to cause confusion.

The true test evolved is, whether the totality of the proposed trademark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trademark.

In the facts of the case, it was held thus :-

“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 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.”

22 In *Encore Electronics Ltd. vs. Anchor Electronics & Electricals Pvt. Ltd.* (supra), the Division Bench of Bombay High Court was dealing with an Appeal against interlocutory order of injunction granted by the Single Judge as the Suit sought injunction restraining use of the mark 'Encore' or any other deceptively similar mark in relation to electrical or electronic goods including dish antennae. The action was based on the case of infringement and passing off.

The Plaintiff, Proprietor of various trademarks sought registration of the trade mark 'Anchor' in Class 9 and 11 of IVth Schedule in relation to large number of electrical appliances and electronic goods, the mark being adopted for the first time in the year 1963 by the predecessor of the Plaintiff. Setting out the details about the volume of sales in respect of electrical and electronic goods on which the mark was advertised, it was urged that the trade mark of the Plaintiff had become 'a household word' and the products of the Plaintiff together with the associated mark are utilised in various locations.

The Plaintiff pleaded that the use of the mark 'Encore' by the Defendant is deceptively similar to its registered mark, being used in respect of the same goods. It was also pleaded that when the mark 'Anchor' is pronounced or written in Gujarati or Devnagari script, it appears 'very close' to the registered trade mark of the Plaintiff and the use of the corporate name 'Encore Electronics Ltd.' by the Defendant is misleading, being deceptively similar and is liable to cause confusion.

The learned Single Judge on appreciation of the prima facie case granted interlocutory injunction by expressing that both the words were phonetically as well as visually similar to the mark of the Plaintiff and both in Gujarati and Devnagari scripts the word 'Encore' is written in the manner similar to the word "Anchor".

The Division Bench compared the two marks and noted phonetic similarity between the two. Recording that the two marks are phonetically, visually and structurally similar, it was found that the overall impression conveyed by a mark as a whole,

has to be assisted in evaluating the deceptive similarity. The Division Bench observed thus :--

“8. The phonetic structure indicates how the rival marks ring in the ears. Courts in a country such as ours whose culture is enriched by a diversity of languages and scripts have to consider how the rival marks are spelt that pronounced in languages in which they are commonly used. Counsel for the defendant submits before the Court that while ‘Encore’ is a word of French origin, ‘Anchor’ is a word of English usage and the pronunciation of the two words must differ. The submission misses the point. The case before the Court is not about how an Englishman would pronounce ‘Anchor’ or a Frenchman would pronounce ‘Encore’. The Court must consider the usage of words in India, the manner in which a word would be written in Indian languages and last but not least, the similarity of pronunciation if the rival marks were to be pronounced in languages prevalent in the country where the marks are used. The manner in which ‘a’ as in ‘anchor’ is pronounced by an Englishman on Notting Hill may well appear to a discerning traveller to be distinct from a Frenchman’s pronunciation of the ‘e’ in ‘encore’ on a fashionable by lane near Champs Elysees. That is no defence to an action in our courts for passing off: For the ordinary consumer in Ahmedabad and her counterpart in Mumbai’s shopping streets, the ‘a’ in ‘anchor’ and the ‘e’ in ‘encore’ are perilously and deceptively similar. The Court must ass the make up of an Indian consumer and, associated with that, the cultural traits that underlie the spelling and pronunciation of words. The case of the plaintiff is that in Gujarati as well as in Hindi, there is not even a subtle distinction between the manner in which ‘Anchor’ and ‘Encore’ would be pronounced and we find merit in the submission.”.

Apart from the aforesaid finding it is also held that the overall impact in terms of phonetical usage is one of striking similarity and the most relevant observation in the decision reads thus :-

“The test is not whether a customer who wishes to buy the product of the plaintiff is likely to end up buying the product of the defendant. The test is whether the ordinary customer is likely to be led to believe that ‘Encore’ is associated with the mark and the trading style of the plaintiff. The phonetical, visual and structural get up of the two words is so strikingly similar as to lead to a likelihood of deception. The question of deception is a matter for the Court to determine, particularly, at the interlocutory stage. The judgment of the learned Single Judge has been criticized on the ground that the Court attempted to break up the words contained in the rival marks. We do

not share that perception. What the learned Single Judge has done in the present case is to compare the two rival marks and to emphasize a striking similarity between the marks with reference to the common features of the rival words.”

Reliance was placed upon the decision in *Cadila Health Care* (supra), which had disapproved the view in *S.M. Dyechem Ltd. vs. Cadbury (India) Ltd.*²⁷ holding that the principle of phonetic similarity has to be jettisoned when the manner in which the competing words are written is different.

Concluding that the Plaintiff had established prima facie case as the essential requirement in action for passing off have been duly established, the balance of convenience was held to be in favour of the Plaintiff and the Appeal came to be dismissed.

23 In yet another decision on which Mr. Kamod has placed reliance in case of *Boots Company PLC vs. Registrar of Trade Marks* (supra), the two marks involved a pharmaceutical product being ‘CROFEN’ and ‘BRUFEN’ a registered trade mark expensively sold in market and having acquired a valuable reputation and goodwill.

In an Appeal under Section 119 of the Trade and Merchandise Act, 1958, the order passed by the Assistant Registrar of Trade Marks allowing the application for registration of trade mark ‘CROFEN’ and detecting the opposition, the Appeal was filed.

Referring to the authoritative pronouncements, the learned Single Judge of this Court held thus :

“ It is thus clear that there are three tests which have to be considered

27 (2000) 5 SCC 573

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. Applying these 3 tests, I am of the opinion that the mark applied for i.e. "CROFEN" is deceptively similar to the registered trade mark of the petitioner i.e. "BRUFEN". The words 'BRUFEN' and "CROFEN" both are six lettered words having common suffix 'FEN'. The prefixes of both these words consist of 3 letters one of which i.e. 'R' is common. The same is preceded by different syllable and followed by different vowels. Visually there is some dissimilarity in both the prefixes and phonetically also there is dissimilarity, since the first letters of both these words are different but the vowels 'u' and 'o' which follow the letter 'R' are apt to be slurred over. The hurried and fast utterance of the word 'CROFEN' may sound as 'BRUFEN', while that of 'CROFEN' as 'BRUFEN'. It is common knowledge that in this country pronouncement defers from person to person. For instance, some people pronounce 'school' as 'school', 'para' as 'pera', 'bank' as 'baink', report as 'report' and so on. English not being the mother-tongue of the people in this country, English words are pronounced in different manners and with a distortion. Therefore, it is not unlikely that the word 'CROFEN' when pronounced hurriedly or fastly may slur over and pass as 'BRUFEN' and vice versa. I cannot say whether this is a possibility or probability, but it cannot be ignored that it is a fact which is likely to occur. The question which therefore, arises is as to what is the test for assessing whether there is deceptive similarity or not in the two words or mark."

In light of the aforesaid observations, holding that it would not be proper to allow any scope for the possibility or probability of any confusion being caused between the two marks 'BRUFEN' and 'CROFEN' it was held that the Assistant Registrar was not right in allowing the Application for registration of trade mark 'CROFEN'.

24 The test to be applied while comparing the similarity in pharmaceutical/medicinal products, has received a different consideration as the possibility of confusion over marks on medicinal products may not only result in some financial loss or gain, but it has the potential to cause more harm than in case of

any ordinary customer product. Confusion and mistake is not unlikely while prescribing the drugs by doctors and its dispensation by Pharmacists being similar goods are marketed under marks which look alike or sound alike.

In given situation, it is possible that the confusion or mistake in prescribing the actual drug may have disastrous consequences and it is, therefore, necessary to avoid any confusion or mistake in pharmaceutical products. Even the doctors prescribing the drugs can also commit mistake and specifically when the prescriptions are telephoned to the pharmacists or hand written and if the same is not legible, there is scope of confusion and possibility of intake of incorrect medicine which may result in loss of life or cause serious health hazardous.

25 In this background, in *Cadila Health Care* (supra), the Apex Court relying upon the rule enunciated by Judge Helen in *Cole Chemical Co. v. Cole Laboratories*, DC Mo 1954, 118 F Supp 612, took note of specific observation to the following effect :-

“Confusion in medicinal preparations can have serious consequences for the patient. Prevention of confusion and mistakes in medicine is too vital to be trifled with.”

Taking into consideration the ground realities in a country like India with multiple languages, different dialects being invoked and this being juxtaposed with a large chunk of population being illiterate, non conversant with English terminology and again with varied pronunciation of an English name, the test laid down for adjudging the violation of Trade

Mark law in medicinal products is different than applicable in non medicinal products. The Apex Court, therefore, cautioned that a strict approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by the consumer, as the confusion as to the identity of the product itself could result in direct effect on public health.

This test received application from time to time in respect of medicinal products and though it is held that as regards the base drug being used in the product the Plaintiff cannot claim any monopoly over a word, which may be indicative of the active ingredient used in the product or in cases where there is presence of a component which is generic, but in cases where there is phonetic similarity, there is more chance of confusion as one product may be taken as a prescribed medicine, but it may not give the desired result.

26 In *Maclods Pharmaceuticals Limited* (supra), while accepting the principle that nobody can claim exclusive right to use any generic word, abbreviation or acronym which has become *publici juris* it is noted that in trade of drugs it is common practice to name a drug by the name of the organ or ailment which it treats or the main composition of the drug. The Court was dealing with 'CEFTRIAXONE', as the main ingredient of the product being 'OFLOXACIN'. The drug being prescribed for hospitalized patients and for treating respiratory tract infections, meningitis, pediatric infections etc. In contrast to this, the product of the Petitioner was prescribed for enteric respiratory tract infections, gram-negative bacterial infections,

infection of tissue in skins, infection of bones and joints, pelvic inflammation, infection of kidney, genital organs and gonorrhoea.

In such a scenario, it is the Court's primary duty to take care to prevent any such possibility of confusion in the use of trade marks and a medicinal product would require lesser quantum of proof of confusing similarity.

27 When the Court dealing with medicinal products fail to apply the test of 'possibility of confusion' as laid down in *Cadila Health Care* (supra) to determine whether there was likelihood or in any case, possibility of consumer being confused so as to make the Plaintiff entitled for interim injunction, in *Medley Laboratories (P) Ltd.* (supra) it was held that, 'SPOXIN' and 'SUPAXIN' are visually, phonetically and structurally similar and though the drugs were sold under prescription that itself was held to be not sufficient to prevent confusion, likely to arise. Reiterating that the test of possibility of confusion in relation to medicinal preparations, as declared by the Apex Court in *Cadila Health Care* (supra) ought to have been strictly applied and injunction ought to have been granted, the Division Bench, intervened when the Single Judge did not apply the correct test of possibility of confusion, rather than requiring proof of actual confusion to be brought on record by placing necessary material.

28 The decision in case of *Wyeth Holdings Corporation* (supra) is also placed before us where the Plaintiff's Motion for interlocutory relief in an action of passing off or infringement was revolved around registration of trade mark 'FOLVITE' in

Class V in respect of a nutritional factor of Vitamin B complex in treatment and prevention of Vitamin deficiency and anemia and while the registration mark subsisted, the Defendant adopted mark 'FOLCACID' for its product which was then changed to 'FOL-V'. The Plaintiff filed an Application opposing the registration and the registration was refused for trademark 'FOL-V' on the basis that it bears similarity to the earlier trade mark 'FOLVITE' of the Plaintiff and having regard to the similarity of the goods involved, there is a likelihood of confusion on part of the public and there was an apparent danger of public being confused and the use of mark 'FOL-V' would be detrimental to the distinctive character and reputation of the marks of the Plaintiff.

With reference to the decision in *Cadila Health Care* (supra), when the Supreme Court had revisited the issue of deceptive similarity in the context of pharmaceutical preparations, the learned Single Judge, observed thus :-

“14A. As a matter of principle, it would be inappropriate for the Court to apply a stricter standard only to a particular class of medicinal preparations. If the Court were to do this, it would have to make artificial distinctions from case to case based on whether or not the Court considers that a confusion arising out of the medicinal product in issue may or may not have disastrous effects on health and life. Such an approach is impermissible. An ostensibly innocuous medicinal preparation taken for an affliction which is not life threatening may yet result in a serious danger to life and health, where the drug is not manufactured under correct conditions. A consumer who desires to obtain a medicine even for an ordinary ailment is entitled to be sure that the drug that he purchases is of an assured character and quality. A manufacturer builds up a reputation for quality and standards assiduously over a length of time and an established mark assures to the consumer that the medicine which he has purchased is of a requisite quality that is associated with the mark. A less than strict standard cannot be applied on the hypothesis that the ailment which the drug is intended to treat is not life threatening, nor for that matter can the application of a lower standard be justified

merely on the ground that the composition of the Plaintiffs product is the same as that of the Defendant and the confusion caused by mistaking one for the other would not result in a danger to health. Undoubtedly, where the competing drugs are meant to cure the same ailment but the compositions are different, mistaking one for the other may result in deleterious consequences. But, merely because the two competing marks are used for drugs with the same composition that would not justify applying a lower standard of scrutiny. For, even in such a case, the public interest lies in protecting the consumer against an unwary purchase of deceptively similar product. The consumer must be protected against a reasonable possibility of confusion arising out of a deceptively similar mark. The attempt, therefore, to read down Cadila is impermissible.”

29 In considering the the question of deceptive similarity, it is held that the two marks shall be considered as a whole and the structure of the mark visually and phonetically must be borne in mind and the image of the Court should have in mind of a quick essential common man.

In specific words the Court applied the following test, “ the ordinary man goes to a small shop of a chemist and to him the distinction between ‘FOLVITE’ on one hand and ‘FOL-V’ on other is so thin as to almost be lacking any significance. It may well be that the manner in which the mark of the Plaintiff is written in Devnagari, may make the ‘VITE’ in the mark resembling ‘VIT’. But every customer in multilingual country, such as India, is not conversant with that nuance. An average consumer who ask for ‘FOLVITE’ would fail to capture the distinction, when he is given a strip of tablets of ‘FOL-V’ and that is what matters on the question of deceptive similarity”.

30 The ultimate test to be applied being, it is not right to take

part of a word and compare it with part of another or as Mr.Kamod has argued 'syllable by syllable'. Each word must be taken as a whole and compared as a whole and it is not appropriate to take a portion of a word, dissect it and then compare the balance with the another word and then conclude that there is no cause for confusion.

In *Schering Corporation vs. United Biotech (P) Ltd.*²⁸ (*supra*), the Defendant's mark 'NETMICIN' was compared with the Plaintiff's mark 'NETROMICIN', and it was noted that there was no possibility of confusion, because Defendant's product was purchased in bulk by hospitals and Plaintiff's product was sold over the counter. Since the area of the usage of the product and the manner of its sale was different, the test of similarity was not applied.

31 Recently, the Delhi High Court in *Dr.Reddys Laboratories Limited* (*supra*) was dealing with trade mark 'AZIWOK' registered under Section 23 of the Trade Marks Act, 1999 covering medicinal, pharmaceutical and veterinary preparations and sanitary substances.

'AZIWOK' being a portmanteau of 'AZI' and 'WOK' ; 'AZI' being abbreviation of azithromycin, the active pharmaceutical ingredient in the product, whereas, 'WOK' is an abbreviation for 'WOCKHARDT', which was assigned the registration of mark 'AZIWOK' in the past.

The Defendant, had applied for registration of the mark 'AZIWAKE' on the proposed to be used basis in the year 2022 and

28 2011(1) BomCR 89

therefore, the Plaintiff instituted a Suit alleging that the brand name 'AZIWAKE' is deceptively similar to the Plaintiff's registered trade mark 'AZIWOK' as both marks are used for azithromycin and there is every chance or likelihood of confusion as well as likelihood of association between the two marks in the mind of the consumer of average intelligence and imperfect recollection.

On behalf of the Defendant, a stand was adopted that 'AZIWAKE' cannot be regarded as visually or phonetically similar to 'AZIWOK' and the competing marks where the words are phonetically similar and the test in the Re Pionotist Company's application and adopted by the Court in the country on several occasions was pressed into service.

The test being " You must take the two words. You must judge them, both by their look and 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. You must consider all the surrounding circumstances and consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the respective goods of the respective owners of the marks."

32 On consideration of the counter submissions, the Delhi High Court concluded thus :-

"54 The competing words are, in the present case, "AZIWOK" and "AZIWAKE". There is no real distinction between their "look" and "sound", especially as the plaintiff holds a word mark registration for the word "AZIWOK". Though, to my mind, it is obvious that AZIWAKE is phonetically similar to AZIWOK, as they sound deceptively alike to the ear, one may, if it is necessary to pare the issue to its essentials, explain why the two words are phonetically similar, thus:

- (i) Each word consists of three syllables.
- (ii) Of the three syllables, the first and second syllables in each word are the same; "a" and "zi".
- (iii) The third syllable which, therefore, would be determinative in examining phonetic similarity, is "wok" in one case and "wake" in the other.
- (iv) The third syllable in each case has, therefore, three distinct sounds, with an initial and the terminal consonant sound and an intervening vowel sound.
- (v) The initial and terminal consonant sounds are the same in both the words, namely "w" and "k".
- (vi) The only difference between the two words AZIWOK and AZIWAKE is, therefore, in the intervening vowel sound between the consonants forming part of the third syllable ("wok" and "wake") in each word. In AZIWOK, the intervening sound is "o" and, in AZIWAKE, it is "ay".
- (vii) This minuscule difference between the two words is too slight to detract from the overall phonetic similarity between them.
- (viii) To the ear of the consumer of average intelligence and imperfect recollection, it is, therefore, clear that the words "AZIWOK" and "AZIWAKE" are phonetically deceptively similar.

Noting that the marks are used for the same pharmaceutical preparation and it would be unrealistic to expect that every doctor would be aware of the distinction between 'AZIWOK' and 'AZIWAKE', it was held that the possibility of a customer being dispensed 'AZIWAKE' when he want 'AZIWOK' , cannot be discounted and by applying the the test laid down in *Cadila Health Care* (supra) it was also noted that if a physician desire his patient to be treated with 'AZIWOK' , the patient must not end up taking 'AZIWAKE' because of the confusion caused by similar name/mark.

In light of this, the Defendant as well as others acting on his behalf were restrained from using mark 'AZIWAKE', with or without any prefixes or suffixes in respect of pharmaceutical preparations or for any other allied of cognate goods or services.

33 Being guided by the abovesaid authoritative pronouncements, when we applied the test laid down in *Cadila Health Care* (supra), we find substance in the arguments advanced by Mr.Kamod, about the phonetic similarity in 'RACIRAFIT' AND 'ESIRAFIT'; 'RAFT' being the common word indicative of Sodium Alginate i.e. foam.

When the Defendant competed with 'EASYRAFT' it clarified that its mark is 'ESIRAFIT' and that 'RAFT' is generic and there is no similarity between 'RACIRAFIT' and 'ESIRAFIT'.

A perusal of the impugned Judgment would reveal that the learned Single Judge has considered the marks syllable by syllable; 'ECI-ACI', which in the wake of the settled proposition in law, is not permissible to be compared as the word has to be picked up as a whole and when the comparison is to be made, the apparent phonetic similarity between the two products is striking.

In the wake of the test repeatedly laid down , the mark has to be considered as a whole. The impression that is gathered from reading of the two words must be striking feature for considering the similarity or dis-similarity. The mere existence of the slightest possibility of confusion in case of medicinal product marks would warrant use of such marks to be restrained. The degree of resemblance in the two marks must be

taken into consideration while deciding the similarity and phonetic similarity or similar pronunciation itself can be a cause for confusion amongst the public.

The test laid down being, the confusion from the point of view of an ordinary common man of average intelligence instead of a specialized medicinal practitioner when the two products 'RACIRAFIT' and 'ESIRAFIT' are compared, it definitely resonate similarity and since the words are to be considered as a whole and not by exclusion of 'RAFT' and when a comparison should be drawn between 'RACI' AND 'ESI', in our view the Single Judge has mis-applied the test in *Cadila Health Care* (supra). Whenever while comparing the two marks, there is likelihood of confusion on account of phonetic similarity alongwith margin to be kept for imperfect pronunciation and imperfect recollection in multi-lingual society in India, coupled with illiteracy, difference in the pronunciation, in our view the two marks are capable of creating a confusion, as one product may be taken for other and probably being medicine, if consumed it may not give the desired result and that is what must be avoided.

34 Though an attempt is made by Mr.Khandekar to establish the colour theme and the difference in the manner in which the product is described, we may not go by the packaging of the product, but by the very pronunciation of the marks 'RACIRAFIT' and 'ESIRAFIT', which in our view has the potential of confusion and which is a real test to determine the similarity in the two products.

The learned Single Judge has referred to the decision in

Cadila Health Care (supra), but in Paragraph 18 and 19, returned a finding that the actual distinction would be decided at the time of trial. Whereas, in our view the test is prima-facie appearance/impression created by the two marks to be compared and with the phonetic similarity, amongst two, we are of the clear view that mis-pronunciation or hurried or fast utterance of the word with a silent use of the word 'R' and mis-reading of the word A/E there is every possibility of creation of confusion or deception. The test to determine whether the trade mark is deceptively similar being, consideration of the mark as a whole, by gathering first impression and the likelihood of confusion from the view point of a man of average intelligence, the product of Defendant is likely to cause confusion.

35 By applying the two tests, in our view 'RACIRAFIT' is deceptively similar to 'ESIRAFIT' of the Respondent and though visually there may be dis-similarity in their prefixes, the phonetic similarity and the possibility of confusion on its mis-pronunciation, satisfy the test of deceptive similarity. To allow any such confusion to continue shall be against public interest and in the wake of aforesaid reasoning, we disagree with the findings rendered by the learned Single Judge and deem it appropriate to set aside the impugned order as the learned Single Judge has failed to apply the test for granting injunction by applying the similarity test applicable to pharmaceutical products and since there is a failure to apply the said test at the stage of grant of injunction, according to us, an illegality has occasioned, and in an attempt to set aside the order, we are not adopting a

merely possible view, but our view is based upon the test laid down in *Cadila Health Care* (supra), and, therefore, by setting aside the impugned Judgment/Order dated 23/12/2025, we allow the Appeal filed by the Appellant.

Pending Interim Applications, if any, stand disposed of.

[MANJUSHA DESHPANDE, J.]

[BHARATI DANGRE, J.]

