



IPAB Intellectual Property Appellate Board
balancing ipprotection

Delhi Registry –Cum-Bench

G-62 to 67 & 196 to 204, August KrantiBhawan, Bhikaji Cama Place,
New Delhi – 110 066

Tele No: 011-26180613/14

Website: <http://www.ipab.gov.in>

ORA/55/2015/TM/MUM

THURSDAY, THIS THE 18th DAY OF JUNE, 2020

HON'BLE SHRI JUSTICE MANMOHAN SINGH
HON'BLE DR. ONKAR NATH SINGH

CHAIRMAN
TECHNICAL MEMBER (PVPAT)

- 1. SUN PHARMA LABORATORIES LIMITED**
SUN ACME PLAZA, ANDHERI-KURLA ROAD,
ANDHERI (E), MUMBAI - 400 059.

...APPLICANT/APPELLANT

(Represented by: Mr. Hemant Singh and Mamta Jha)

Versus

- 1. AGILA SPECIALTIES PRIVATE LIMITED**
STRIDES HOUSE, OPP. IIM BILEKAHALLI,
BANNERGHATTA ROAD, BANGALORE, 560 076
- 2. THE REGISTRAR OF TRADE MARKS**
TRADE MARKS REGISTRY, INTELLECTUAL
PROPERTY BHAVAN, NEAR ANTOP HILL HEAD
POST OFFICE, S.M. ROAD, ANTOP HILL. MUMBAI -
400 037

...RESPONDENTS

(Represented by – Mr. Aditya Verma)

ORA/1/2016/TM/MUM

- 1 MYLAN LABORATORIES LTD**
PLOT NO. 34-A, ANRICH INDUSTRIAL ESTATE,
BOLLARUM, JINNARAM (MANDAL),
MEDAK DISTRICT 502325
ANDHRA PRADESH INDIA

...APPLICANT/APPELLANT

(Represented by: Mr. Aditya Verma)

Versus

- 1 SUN PHARMA LABORATORIES LIMITED**
SUN ACME PLAZA, ANDHERI-KURLA ROAD,
ANDHERI (E), MUMBAI - 400 059.
- 2 THE REGISTRAR OF TRADE MARKS**
TRADE MARKS REGISTRY, INTELLECTUAL
PROPERTY BHAVAN, NEAR ANTOP HILL
HEAD POST OFFICE, S.M. ROAD,
ANTOP HILL. MUMBAI - 400 037

...RESPONDENTS

(Represented by: Mr. Hemant Singh and Mamta Jha)

ORDER

HON'BLE SHRI JUSTICE MANMOHAN SINGH, CHAIRMAN

By this common order, I propose to decide the following two petitions:

1. The rectification petition being ORA No.55/2015/TM/MUM has been filed by Sun Pharma Laboratories Ltd.(For short Sun Pharma) for removal of the trade mark SOXPLAT registered under trade mark registration no. 1550804 dated 18/4/2007 in class 05 from the Register of Trade Marks. The petition was filed on 28/10/2014 on the basis of Sun Pharma's prior registration and use of the distinctive trade mark OXIPLAT bearing trade mark registration no. 1003586 dated 16/4/2001 in class 05.
2. The second rectification petition being ORA No. 1/2016/TN/Mum has been filed by Mylan Pharma Lab. Ltd.(hereinafter referred to as Mylan) on 2/9/2015 as counterblast to the rectification petition filed by Sun Pharma, alleging that Sun Pharma's trade mark OXIPLAT lacks distinctiveness as it is taken from the salt for the drug namely "Oxaliplatin".
3. Both parties have argued the petitions and have also filed the written submissions
4. Case of Sun Pharma about the use of trade mark OXIPLAT.
 - (i) The trade mark OXIPLAT of Sun Pharma is a coined and inherently distinctive trade mark adopted in the year 2001 and has been used on an extensive and continuous commercial scale in relation to Sun Pharma's drug for colon/rectal

cancer comprising the salt "Oxaliplatin". Reliance is placed on the following documents:

➤ Exhibit AW-1/4 in ORA 55/2015 : Copies of sales invoices showing sale of OXIPLAT by Sun Pharma for the period 2001 to 2014 (page 42-90 of ORA 55/2015)

(ii) On account of extensive commercial use of the trade mark OXIPLAT by Sun Pharma, the same has acquired formidable goodwill and reputation as a badge of quality for cancer drug originating from Sun Pharma. The goodwill and reputation that the trade mark OXIPLAT has come about to acquire is evident from the fact that from the period 2001 to 2014, the total sales of OXIPLAT cancer drug have been in excess of INR 26.56 Crores. During the same period, Sun Pharma has spent more than INR 1.32 crores on promotion of the same. Pertinently, Sun Pharma had made sales of OXIPLAT drug in excess of INR 8.81 Crores by 2007 i.e. year of adoption and applying for registration of the impugned and deceptively similar mark SOXPLAT. Reliance is placed on the following documents:

➤ Exhibit AW 1/6 in ORA 1/2016: Copy of Chartered Accountant Certificate dated 3/11/2014 certifying sales of Sun Pharma's OXIPLAT drug for the period August 2001 to March 2014 (Page 52-56 of Counter Statement in ORA No.1/2016)

(iii) The trade mark OXIPLAT of Sun Pharma is a registered trade mark under trade mark registration No. 1003586 dated 16/4/2001 in class 05 in respect of

"medicine and pharmaceutical preparations". The same is valid and subsisting as on date. The registration certificate is placed on record at page nos. 91-92 of ORA No.55/2015.

5. It is argued by Mr. Hemant Singh, Counsel for Sun Pharma that the Mylan's trade mark SOXPLAT is structurally, visually and phonetically deceptive similar to Sun Pharma's prior used and prior registered trade mark OXIPLAT. The only difference is addition of letter 'S' to the prior registered trade mark OXIPLAT which does not change the phonetic sound of 'OXIPLAT' where the marks are compared as a whole. Further, the impugned mark has been registered in respect of the same goods being *"medicinal and pharmaceutical preparations"*. Hence, it is a case of similarity of trade marks and identity of goods where the Mylan has appropriated the entire trademark of the Sun Pharma. Therefore, use of the impugned mark is likely to cause confusion and deception in the minds of consumers at large and the members of the trade on account of imperfect recollection. The copy of online status and publication in Trade Marks Journal of the impugned registration of SOXPLAT are at page nos. 93-94 of ORA No. 55/2015 is placed on record..

6. It is also submitted on behalf of Sun Pharma that Sun Pharma is the prior registered proprietor of the trade mark OXIPLAT and has the exclusive right to use thereof in respect of medicinal and pharmaceutical preparations under section 28 of the Act. That being so, the use of the mark OXIPLAT or any other deceptively similar mark such as SOXPLAT by any unauthorized party would amount to infringement of trade mark under Section 29(1) of the Act and also is in breach of Section 11(1) which prohibits grant of registration of a mark similar to earlier mark for same or similar goods.

7. It is alleged that the registration of the impugned mark SOXAPLAT by Mylan is contrary to Section 11(1) of the Act, being a deceptively similar mark in respect of identical goods.
8. Brief facts by Mylan and its Trade mark SOXAPLAT On the basis of said facts and pleadings, the counsel for Mylan has addressed the arguments. Counsel has alleged that Sun Pharma has no case. Even the interim orders were refused in a suit filed by Sun Pharma. It is stated that Mylan acquired Agila Specialities Ltd. in 2013 and vide an order of the Hon'ble High Court, Hyderabad, Agila was dissolved. Copy of order dated 24th August, 2014 at pages 63-83 (Annexure A of the counter statement).
9. It is admitted position that the originally M/s Strides Arcolab Ltd. filed an application for the registration of the wordmark SOXPLAT on 18th April, 2007 bearing application no. 1550804 (Annexure 1 at page 125 (TM-1 of the counter statement)). Post the registration of the said trademark, the same was assigned to Agila Specialities Ltd. pursuant to an appropriate request before the trademark registry on 4th May, 2011. The same was allowed vide order dated 19th February, 2014 (Annexure 1 at page 124 of the counterstatement. Statis extract evidencing the aforesaid). Thereafter, Mylan filed a TM 33 to change the name of the registered proprietor of the trademark SOXPLAT to Mylan. (Annexure B at page 51 of the counterstatement).
10. It is submitted on behalf of Mylan that the mark SOXPLAT was coined in April 2007 by Strides which is inherently distinctive as it has no dictionary meaning and was created by Strides by juxtaposing the first letter of its name

i.e. "S" from Strides with an abbreviated version of the name of the active ingredient/salt **OXALIPLATIN**. The said drug is used to treat colon or rectal cancer that has spread(metastasized). It is administered intravenously and there is no pill or oral injectible version of the drug. **Commercial use began since 2009** and total sales of products under the trade mark SOXPLAT is Rs. 2.94 crores. (**Annexure H and J at page 118-123, 130-131 of the counterstatement**).

11.It is alleged that the mark of Sun Pharma, OXIPLAT, is devoid of any distinctive character as per Section 9(1) of the Trade Marks Act, 1999. **No monopoly or exclusive right can be granted to Sun Pharma for the mark OXIPLAT as the same is a mere abbreviation of the active salt which is OXALIPLATIN.** An abbreviation of this nature i.e. based on the generic name of the salt certainly can not be allowed to be misused by a party and hence Sun Pharma cannot seek any exclusive rights over the same. The following decisions were cited in support of here submissions.

a) *M/s Bioforma Vs. Sanjay Medical Stores, 1997 PTC(17)*

(Delhi High Court)para 19

b) *Schering Corporation Vs. Alkem Laboratories, 2010(42) PTC 772(Del),*

(DB); Para 36

12.It is also submitted that it is a common practice in pharmaceuticals, to name a drug on the basis of the name of its active chemical compound or salt, or the disease it seeks to remedy, or the particular organ it is intended to treat and the name of such an ingredient/salt or compound, ailment or organ is in public

domain and of generic nature and no one party can claim an exclusive right over the said name. The following judgments are referred in support of case.

- a) *Astrazeneca UK Ltd & Anr Vs. Orchid Chemicals & Pharmaceuticals Ltd.,*
2007(34)PTC 469(DB), (Del), para 20 and 21
- b) *Schering Corporation Vs Alkem Laboratories, 2010 (42)PTC (Del),*
(DB); para 36
- c) First Syllable different - marks dissimilar

13. It is argued that the Sun Pharma's trademark OXIPLAT **entirely derived from the active sale OXALIPLATIN** merely deleting the **3rd and the 4th letter (AL)** and **the last two letters (IN)**. It is well settled that when a mark is derived from the common generic salt (OXALIPLATIN in the present case), no single proprietor can claim exclusive right over the said mark. (Section 17(2) of the Trademarks Act, 1999) Abbreviation of a generic word/salt will also be generic. In support of her submissions the following judgments were relied upon.

- a) *Indo-Pharma Pharmaceuticals Works Ltd. Mumbai Vs. Citadel Fine Pharmaceuticals Ltd. Madras, 1998 (18)PTC (DB)(Mad) at paras 42, 42,55 and 56*

McCarthy in Trademarks and Unfair Competition (Third Ed n. Vol.2)

The name of the product and service itself - what it is - is the very antithesis of a mark. In short, a generic name of a product can never function as a trademark to indicate origin. The terms "generic" and "trademark" are mutually exclusive.....The

concept of "generic", it can never function as a mark to identify and distinguish the products of only one seller (para 12.01)

- b) Adopting the name of a generic drug/salt for a trademark is one thing and 'inventing' the trademark based on the name of a generic drug is another thing entirely. In the present case, Sun Pharma has evidently adopted the generic salt name as a trademark, which they cannot be allowed to do.

Case laws referred

- *Apex Laboratories Limited v Zuventus Health Care Limited (2006(33)PTC 492(MAD) at para 5*

- c) It is submitted that no exclusive right can be granted to a mark which is based on the generic name of drug/salt. At best, right can be to the added features which differentiate the trademark from the name of the generic drug. The following decisions were cited.

- i) *Panacea Biotec Ltd. v.Recon Ltd. 1996(16)PTC 561(Del) Para 10*
- ii) *Schering Corporation Vs. United Biotech (P) Ltd 2011(1) Bom CR 89, para 12*

14.It is alleged that it is well settled law that if a party chooses to use a generic, descriptive, laudatory or common word as a trademark, the said trademark will not be accorded with any protection or exclusively in the use of such words. Thus under those circumstances, either the trademark is enforceable in infringement suit nor prayer for rectification can be granted rather, the parties claiming rights, their trademarks should be removed from the register.

➤ *The reliance is placed in the matter of Schering Corporation vs. Alkem Laboratories Ltd.;2010(42) PTC 772(Del.)(DB) at para 35*

15.The next argument addressed on behalf of Mylan is that there are many third parties which are using the abbreviation of salt OXALIPLATIN as a part of the trademark and hence it is common to trade. Several third parties are using the prefix OXI and suffix PLAT as part of their trademark therefore the is generic and publicijuris. A table with the list of over 17 third parties who are using the prefix OXI and suffix PLAT as part of their trademark has been provided in para N of the counterstatement and at pages 132-140 of documents. Section 17(2)(b) of the trademarks Act.

The details of a few of the companies who are using the aforesaid prefix and suffix alongwith the registration details are provided herein below:-

S.No	Trade Mark	Registration No.	Date of Registration
1	FEXOPLAT	1425965	28.02.2006
2	X-PLATIN	1231145	03.09.2003
3	OXOPLAN	1700505	08.06.2008
4	OXAMIL	1345689	18.03.2005
5	OXALTOR(DEVICE)	2136773	28.04.2011
6	BOXALIPLATIN(DEVICE)	1602668	17.09.2007
7	XALIPLAT	1458343	09.06.2006

The following decision is relied upon on this aspect:

Hardie Trading Ltd. and Ors. Vs. Addisons Paint and Chemicals Ltd.(12.09.2003-SC) :MANU/SC/0705/2003

" A trade mark is a commercial asset intended to be used commercially by business men, and it seems to me that "special circumstances" have to be understood and applied in a business sense"

16. It is also stated that Sun Pharma's and Mylan's product are sold only against doctor's prescription (Schedule H drug) not as an over the counter medicine. Further the products are administered also by highly skilled cancer therapist. Therefore, there is no likely hood of confusion or deception and the test of imperfect recollection of ordinary consumers is inapplicable. The following decisions are referred in support of her arguments:

- a) *M/s Biofarma Vs. Sanjay Medical Stores, 1997 PTC (17) (Delhi High Court) para 21*
- b) *Schering Corporation Vs. Alkem Laboratories Ltd.; 2010 (42)PTC 772 (Del)(DB) at para 42 & 45*
- c) *Astrazeneca UK Ltd &Anr. Vs. Orchid Chemicals & Pharmaceuticals Ltd. 2007 (34)PTC 469 (DB), (Del), para 22.*

It is also alleged that customers would pay more attention to the uncommon feature of the mark if the common feature is descriptive and publicijuris.

Case Laws are referred as under:

- i) *M/s Bioforma Vs. Sanjay Medical Stores, 1997 PTC(17) (Delhi High Court) para 19*
- ii) *Astrazeneca UK Ltd &AnrVs. Orchid Chemicals and Pharmaceuticals Ltd., 2007(34) PTC 469(DB), (Del), para 21.*

17. Lastly, it is submitted that since Sun Pharma's mark OXIPLAT is an abbreviation of the generic salt and there is no new or invented or distinctive part in the said mark, the said mark should be rectified and removed from the Register of Trade Marks. Any Mylan's mark SOXPLAT is a coined mark (derived from the generic salt and by adding S i.e. first letter of the company name, Strides) and in thus invested mark. Mylan's said mark is inherently distinctive as it has no dictionary meaning, hence the same is entitled to protection.

18. From the pleadings of both parties, documents placed and addresses of arguments, there are admission positions in the matters which are outlined as under:

- a. The Sun Pharma is the earlier user of the trademark OXPLAT which is being used since 2001 even as per evidence available on record.
- b. The drug used by both parties is being used for treatment of cancer.
- c. The generic name is OXALPLATIN.
- d. The area of use of both products of the parties is the same.
- e. The drug of both parties are being under doctor's prescription.
- f. That Mylan is the subsequent user of product for the same purposes.
- g. Third parties user are all subsequent user. Nothing has been proved by the Mylan. No documentary evidence or affidavit of any third party has been produced/filed in order to show that third party is the prior adopter or used. Most of the third parties details would show that the trademark applied as proposed to be used and where the user is claimed, the same is 2006 which subsequent to the use of Sun Pharma.

- h. Mylan started using the trademark SOXPLAT since 2009 as per statement but there is no cogent evidence has been produced.
- i. The date of application and user of Sun Pharma trademark OXPLAT is much prior to the application of the Mylan or third parties.

19. It is submitted on behalf of Sun Pharma that the impugned mark SOXAPLAT is deceptively similar to Sun Pharma's trade mark OXIPLAT on account of overall structural and phonetic similarity when "compared as a whole" and when examined from the point of view of a man with "average intelligence" and "imperfect recollection" and not having the drugs together for side-by-side comparison. The competing marks are:

SUN PHARMA

MYLAN

OXIPLAT

SOXPLAT

Let me discuss the matter on this aspect as well as the other issue raised on behalf of Mylan

20. In Cadila Health Care Limited Vs. Cadila Pharmaceuticals Ltd. reported in 2001 AIR Supreme Court page Nos. 1952, it is rightly observed that the Drugs are poisons and not sweet and confusion between medicinal products may, therefore, be life threatening, not merely inconvenient.

It is also correctly laid down that where medicinal products are involved, the test to be applied for adjudging the violation of Trade mark law may not be at par with the cases involving non-medical products and a stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by the consumer.

The fact that a drug is sold under prescription or only to physicians can not itself be considered a sufficient protection against confusion.

The physicians and pharmacists are trained people yet they are not infallible and in medicines, there can be no provisions for mistake since even a possibility of mistake may prove to be fatal.

20.1. Actually when the Cadila judgment was rendered in 2001, forty one years earlier, also in the case of Corn Product Refining Company Vs. Shangrila Food Products Limited reported in AIR 1960 Supreme Court 142 wherein it was held that in deciding the question of similarities between the two marks, the right approach is to form the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonably likely to cause a confusion between them. It was also held that it is well recognised that in deciding a question of similarity between two marks, the marks are to be compared as whole. The similar view was taken in AIR 1963 S.C. 449 where two marks Amritdhara and Laxmandhara held to be closely similar.

20.2. The onus to prove similar marks are already in the market by third parties and common to trade, the burden of proof heavily lies on the party who has taken such defense. Merely presence of such marks on the Register of Trade Marks is no proof of its user. Party raising such defense has to prove third parties user prior in the time and to prove that the third party has acquired a reputation by user in the market. It is not permissible to draw any inference as to their user merely from the presence of the marks on the Register. The same is rightly laid down the law by the Hon'ble Supreme Court in the case of Corn Product(Supra).

20.3 Both judgments rendered by the Supreme Court are considered to be landmark judgments as the principles laid down are followed upto dates in all pharmaceutical cases. Many judgments referred on behalf of Mylan are

rendered prior to the judgment of Cadila(Supra) in which the law of pharmaceutical cases was re-visited and guidelines are issued at the prevailing ground situation in the market.

21.4 On 30th October 2014 Sun Pharma Laboratories Limited filed a suit for infringement, passing off being CS(OS)1098 of 2014 was filed before Delhi High Court restraining Mylan from using the registered trademark SOXPLAT. After hearing the interim application was dismissed on 07.02.2017 by the single judge in favour of Mylan. The said order was challenged by Sun Pharma before the Division Bench who dismissed the appeal being number FAO(OS)71 of 2017.

21.5. In the present litigation between two private pharmaceutical companies, IPAB is to decide as whether two rival marks of parties OXIPLAT and SOXPLAT are deceptively similar or not. No doubt when the civil suit was filed by the petitioner against the respondent for infringement of rights, no interim was granted in favour of the petitioner, inter alia, on the grounds that two marks are not similar and chances of confusion will not arise. The Division Bench of the Hon'ble Delhi High Court while dismissing the appeal of Sun Pharma has held that it was the prima facie view, competing marks of both parties are registered, the user of Mylan since 2009 and Prima facie no similarities.

22. As the rectification of respondent registered trademark was filed before IPAB, the suit filed by the petitioner who is seeking cancellation of trademark of respondent, the said some proceedings initiated by Sun Pharma were stayed till the present two petitions are decided. IPAB is to decide the issues after evidence adduced produced by the parties. On most without any influence of the orders passed by the Hon'ble High Court which are even otherwise prima facie views.

23. Counsel for the parties admitted during the course of hearings of appeals that the findings arrived by the single bench in Division Bench were tentatives and merely prima facie view. It is also a matter of fact that respondent has also filed rectification of the petitioner registered trademark after the suit filed by Sun Pharma. Counsel for both parties have given their oral consent to argue both matters before Chairman.
24. Mylan has not denied the fact that it's predecessor had applied for a mark SOXPLAT on the basis of distinctive mark as claimed. The proprietyship is claimed before respondent No.2. It is stated that it was coined from the name of the salt and is a distinctive mark but Mylan in it's rectification challenged the trademark of the Sun Pharma alleging, in the petition that OXIPLAT used by Sun Pharma is contrary to Section 9 and 11 and it is not distinctive mark, it would cause confusion and deception, though it as admitted that both trademark of the parties were also coined from the name of the salt.
25. However, when the application of registration was filed, it was claimed as distinctive and it can acquire rights of ownership but the trademark of the Sun Pharma is not distinctive and no right of ownership can be claimed. If the Mylan and Sun Pharma respective trademarks derived from the name of said self then now Mylan is claiming the ownership right of the mark. It cannot be allowed not to argue just opposite that its trade mark is distinctive whereas the earlier trade mark OXIPLAT is descriptive and none distinctive. This aspect is dealt with in the judgment of Hon'ble High Court in
- (a) Automatic Electric Ltd. Vs RK Dhawan (1999 PTC(19)81) para-16 of the judgment is reproduced below:*

“16. The defendants got their trade mark “DIMMER DOT” registered in Australia. The fact that the defendant itself has sought to claim trade proprietary right and monopoly in “DIMMER DOT”, it does not lie in their mouth to say that the word “DIMMER” is a generic expression. User of the word “DIMMER” by others cannot be a defence available to the defendants, if it could be shown that the same is being used in violation of the statutory right of the plaintiff.”

(b) IshiKhosla V. anilAggarwal 2007 (34) PTC 370 (Del) (WHOLE FOODS) – para 22 where the defendant has also applied for registration of the words whole and Food who attempted to claim the trade mark and then challenged the trade mark of the plaintiff. The said arguments were rejected by the Hon'ble High Court.

(c) Procter & Gamble v. Anchor Health 2014 (59) PTC 421 (Del) (DB) – [(pg.435 – para (xviii)] similar the position where the defendant in U.S. obtained the registration All-Around Protection and now claiming the user right of the mark Protection.

(d) Neon Laboratories Ltd. v. Themis Medicate Ltd. & Anr. Suit (L) No.336 of 2014 – para 17,21,22. In this case, the argument in this aspect were rejected.

26. Now, it is to be considered about the similarity of the two rival marks and to be decided about the phonetically deceptively similar. It is the admitted position that the letter “I” being a vowel, in Sun Pharma’s trade mark OXIPLAT would be slurred over and does not have a prominent and distinguishing sound in pronunciation. It is evident that Mylan’s mark SOXPLAT has the whole of the applicant’s registered trade mark OXIPLAT except the letter S was added to the mark OXPLAT.

27. It is to be examined as to whether a mere addition of letter “S” in SOXPLAT neither changes the sound of the prefix “OX” nor the sound of the mark as a whole. This is because “S” is a singular letter and a soft consonant which does not significantly alter the sound of the trade mark OXIPLAT and will therefore not be sufficient to avert likelihood of confusion on account of phonetic similarity along with margin to be kept for imperfect pronunciation and imperfect recollection in multilingual society of India.

On doubt Mylan has argued that Sun Pharma’s trade mark OXIPLAT is taken from the salt “OXALIPLATIN” and hence, the same cannot be protected. Such argument is entirely misconceived as **OXIPLAT** is different to “Oxaliplatin”. The prefix of the trade mark being **OXI** is different to the prefix of the salt being “Oxali”, and the suffix of the trade mark **PLAT** is different from the suffix of the salt namely “Platin”.

28. The real test for determining whether a pharmaceutical trade mark is descriptive to ask whether an ordinary man or even a medical man will be in a position to say that the mark is so composed unless he is so told. Reliance is placed on the judgment of Hon’ble Delhi High Court in *Win-Medicate v. Somacare Laboratories (1997 PTC (17) 34)*. The relevant portion of the judgment is reproduced hereinbelow for ready reference of this Tribunal:

“18. Learned counsel for the defendant has contended that in the mark DICLOMOL prefix DICLO has been taken from DICLOFENAC SODIUM and suffix MOL has been taken from Paracetamol which are basic drugs and as such the mark is a descriptive mark and the plaintiff has no exclusive right for its use.

19. The mark may have been so formed but it cannot be said that an ordinary person or even a medical man will be in a position to say that this mark is so composed unless he is so told. The mark in itself does not convey the idea that it is descriptive of the said basic drugs not has any dictionary meaning. Moreover, the mark has to be considered as a whole. Applying the test laid down in Dropovit’s case (supra) as noticed above, in my view the mark DICLOMOT is not a descriptive word not a generic word but an invented word.”

29. The reliance is placed on following judgments on behalf of Sun Pharma where competing trade marks have been held to be deceptively similar, notwithstanding Defendant’s argument that the earlier trade mark for pharmaceutical/medical product was derived from the salt or ailment or organ:

Case Title, Citation & date of order	Forum	Plaintiff’s Trade Mark	Salt	Defendant’s/ Respondent’s Injected/Cancelled Trade Mark	Relevant Paragraph
Sun Pharmaceutical Industries Ltd. V. Salud Care(I) Pvt. Ltd. MABY/TN/19 36/2012 17/7/2012	Madras High Court	CABGOLIN	Cabergoline	Golin	5,15,20

Stiefel Laboratories &Anr. V. Ajanta Pharma 2014(59) PTC 24(Del) 1/7/2014	Delhi High Court	CLINDO XYL	Clindamycin & Benzoyl Peroxide	CLINOXID	8,12,35
United Biotech pvt. Ltd. V. Orchid Chemicals and Pharmaceutica ls 2012(50) PTC 433 (Del) (DB) 18/5/2012	Delhi High Court	ORZID	Ceftazidine	FORZID	29,36&38
RemidexPhar maPvt. Ltd. v.Savita Pharmaceutica ls 2006(33) PTC157 3/7/2006	Delhi High Court	ZEVIT	Zinc Sulphate Manohydrate, Vitamines B1,B2,B6,B1 2 Calcium Pantothenate and Vitamin C	EVIT	2,5,6,9

30. As mentioned above, it is admitted position that Mylan is the subsequent in adoption and user. It is also admitted position that not a single third party is the earlier user than Sun Pharma. All the subsequent adopt or user of their respective marks.

Admittedly nothing has been proven to the contrary. Mylan in their pleadings has admitted that the mark coined by it distinctive and ownership rights within the meaning of Section 18 of the Act can be claimed. There is no cogent and clear evidence of 2009 on record except pleadings. Evidence on behalf of Sun Pharma since the year 2001 is available on record.

31. It is the practice in the pharmaceutical cases to raise the defence of existence of similar marks of third parties and common to the trade. It is also the practice of pharmaceutical companies to file applications in routine course as a proposed to be used by adding or deleting or deleting of letter here or there either from the name of salt or from the name of ailments. The said issues have been discussed or decided by the Supreme Court and various High Courts time and again but most of the time, it was held that the two rival marks of the parties are to be compared as a whole.

It is not the good practice to spilt the marks of the parties for the purposes of comparison. No doubt there are conflicting decisions in the pharmaceutical cases. However after Cadila case (supra) all the issues are settled. Still few orders are passed in the interim application by splitting the rival marks by taking different views were taken.

If all the decisions are read in meaningful manner, it is evident that each case has to be decided as per its own merit.

32. Mylan has not proved the cogent and clear evident of use of the impugned mark SOXPLAT the year 2009, as claimed. Whereas Sun Pharma has established continuous and extensive commercial use of the trade mark OXIPLAT since 2001 on the record.
33. Mylan has incorrectly in the proceedings that “OX” and “PLAT” are common to trade as since Sun Pharma is not claiming any exclusive rights over the abbreviations ‘OX’ and ‘PLAT’. There is no pleading that Sun Pharma’s trade mark OXIPLAT is common to trade. The mere plea that a mark is common on trade without adducing any supporting evidence is not sufficient to establish that the mark is indeed common to the trade. Apart from the judgment already referred in the case of Corn Products (supra) AIR 1960 SC 142 wherein the specific law laid down on this issue. Mylan has failed to establish any user of third parties. The reliance is also placed on behalf of Sun Pharma of judgment Delhi High Court in Century Traders v. RoshanLalDuggar AIR 1978 Del 250. The relevant extract of the same is reproduced hereinunder for ready reference:

“21...It has been urged on behalf of the respondents that the mark “RAJARANI” is common to the trade and for this purpose reliance has been placed on the registration in Andhra Pradesh and Amritsar. There is a distinction between a mark being “common on the register” and “common on the trade”. There is no evidence on record to show that there is actual user of this mark by any party other than the parties before us.”

34. Reliance is also placed on the following judgments:

a) Stiefel Laboratories &Anr.. v. Ajanta Pharma Ltd. – 2014 (59) PTC 24 (Del) – para 37. No material was produced, thus third party defence was not accepted.

b) PankajGoel v. Dabur India Ltd. 2008 (38) PTC 49 (Del)(DB) – paras 22 and 23. The defence of third party rejected in the absence of establishment of user prior in point of time than the main party.

35. The Supreme Court in the case of 2007 (35) PTC 1 (SC), Dabur Vs. Heinz Italia, it was held that two trademarks were Glucose - D and Glucon - D. Both products contained Glucose power. The learned Single Judge of the Punjab and Haryana High Court had held that word Glucose being generic of the contents, no monopoly can be granted. The learned Single Judge of the High Court had refused to grant the injunction in this case. When this case came to the Supreme Court, the Court in fact reversed it and granted the injunction. The ratio of the Supreme Court contained in Para 11 reiterates Cadila Healthcare while granting the injunction and it was held that both Glucon D and Glucose D are items containing glucose which are phonetically so similar that it can easily confuse a purchaser and small changes in the packaging is merely an attempt to continue to mislead the purchasers and to make it more difficult for the owner to protect their mark.

36. Two rival marks to be compared as a whole. (See AIR 1960 SC 142, AIR 1963 SC 449 and AIR 1965 SC 980) In the case reported in AIR 1963 SC 449 : PTC (Suppl) (2) 1 (SC), Amritdhara Pharmacy v. Satya Deo Gupta the Apex Court on page 458 and Para 9 has observed as under :

"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 is the overall similarity of the composite word, having regard to the circumstance that the goods

bearing the two names are medicinal preparations of the same descriptionA 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...."(page 458 Para 9).

37. In the case of AIR 1965 SC 980, Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories, it is held that in infringing cases only the rival marks are to be compared by the court if the Defendant's mark is closely, visually and phonetically similar then no further evidence is required, even if get up packaging on the packing of two products in which they are offering their products are different in an action of infringement, the same is immaterial.

38. In many cases anti-dissection rule has been discussed and decided various cases and same is also to be applied in India is really based upon nature of customer. It has been rightly set out in McCarthy on Trademarks and Unfair Competition about the said rule particularly in Para 23.15 which is reproduced hereunder:

"23.15 Comparing Marks: Differences v. Similarities

[1] The Anti-Dissection Rule

[a] Compare composites as a Whole Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison. This is the "anti-

dissection" rule. The rationale for the rule is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts. However, it is not a violation of the anti-dissection rule to view the component parts of conflicting composite marks as a preliminary step on the way to an ultimate determination of probable customer reaction to the

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

The rationale of the anti-dissection rule is based upon this assumption: "An average purchaser does not retain all the details of a mark, but rather the mental impression of the mark creates in its totality. It has been held to be a violation of the anti-dissection rule to focus upon the "prominent" feature of a mark and decide likely confusion

solely upon that feature, ignoring all other elements of the mark. Similarly, it is improper to find that one portion of a composite mark has no trademark significance, leading to a direct comparison between only that which remains."

39. It is rightly held in the recent judgment given by the Division Bench of this Court comprising A.K. Sikri, Hon'ble Acting Chief Justice and Rajiv Sahai Endlaw, J. in the case of United Biotech (P) Ltd. (supra) in which law pertaining to anti-dissection rule as well as the test of deceptively similarity have been dealt with in great detail. The Division Bench has also laid down the rules of comparison in Para 32 of the judgment. Two rival trademarks in the matter decided by the Division Bench were ORZID and FORZID and it was held that two trademarks are visually and phonetically similar and would cause deception in the minds of the consumer in relation to medicine. The said judgment has also been discussed in Stiefel Laboratories (Supra). The relevant paras of the said judgment read as under:

"30. The law on this aspect, where the Courts are called upon to consider the deceptive similarity between the two marks is firmly engraved in a series of judgments pronounced by the Courts in the last half century or more. Many are cited by the learned counsel for the appellant, note whereof is taken above. Judgment of Supreme Court in the case of Cadila Health Care Limited (supra), which deals with pharmaceutical preparations, is a milestone on law relating to drugs. Application of the principles laid down in this judgment can be found in scores of subsequent judgments of this Court and other High Courts. The position which emerges from the reading of all these judgments can be summarized in the following manner:

In such case, the central issue is as to whether the Defendant's activities or proposed activities amount to a misrepresentation which is likely to injure the business or goodwill of the Plaintiff and cause damage to his business or goodwill. To extend this

use to answer this, focus has to be on the aspect as to whether the Defendant is making some representation in course of trade to prospective customers which is calculated to injure the business or goodwill of the Plaintiff thereby causing damage to him. In the process, difference between the confusion and deception is to be understood. This difference was explained by Lord Denning in "Difference: Confusion & Deception" in the following words:

"Looking to the natural meaning of the words, I would make two observations: first, the offending mark must „so nearly resemble“ the registered mark as to be „likely“ to deceive or cause confusion. It is not necessary that it should be intended to deceive or intended to cause confusion. You do not have to look into the mind of the user to see what he intended. It is its probable effect on ordinary people which you have to consider. No doubt if you find that he did intend to deceive or cause confusion, you will give him credit for success in his intentions. You will not hesitate to hold that his use of it is likely to deceive or cause confusion. But if he had no such intention, and was completely honest, then you will look carefully to see whether it is likely to deceive or cause confusion before you find him guilty of infringement.

40. Hon'ble Division Bench of this Court in the case of United Biotech (P) Ltd. (supra) after referring to various decisions including the decision referred by the Defendant's counsel has followed the anti-dissection rule“ as set out in McCarthy on Trademarks and Unfair Competition which was not applied in the cases referred by the Defendant. In fact the said law had been applied in India for the last five decisions by Hon'ble Supreme Court in three judgments delivered by the Supreme Court in the cases reported in Corn Products Refining (supra), Amritdhara Pharmacy (supra) and Kaviraj Pandit Durga Dutt Sharma (supra).

41. McCarthy on Trademarks and Unfair Competition [J Thomas McCarthy, IV Ed., Clark Boardman Callaghan 2007] under the sub-heading "Comparing Marks: Differences and Similarities". The treatise further states:

"23.15 ... The typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall impression created by the mark from the ordinary shopper's cursory observation in the marketplace that will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighed analysis in legal briefs."

"In litigation over the alleged similarity of marks, the owner will emphasize the similarities and the alleged infringer will emphasize the differences. The point is that the two marks should not be examined with a microscope to find the differences, for this is not the way the average purchaser views the marks. To the average buyer, the points of similarity are the more important than minor points of difference. A court should not engage "technical gymnastics" in an attempt to find some minor differences between conflicting marks. However, where there are both similarities and differences in the marks, there must be weighed against one another to see which predominate."

41. As discussed above, and after having gone through the material placed on record and the decisions referred, it is clear that none of the decisions relied upon on behalf of Mylan is applicable to the facts and circumstances of the present case. The reasons are given as under:

a). In the cases of Biofarma (supra) Indo Pharma (supra) Apex Laboratory (supra) Panacea Biotec (supra) Schering (supra) and F Heffmann, it is evident that all the above mentioned judgments are delivered prior to the judgment of Cadila

case (supra) in the Cadila case all guidelines in pharmaceutical cases, comparisons rules and purchased of drugs through the medical prescription haven changed, After the Cadila case, the trend of pharmaceutical cases is revisited. Two more landmarks decisions were rendered accepting the principles and guidelines of Cadila.

No prominence is given to the concept of doctor prescription in view of grounds situation in the market. Even otherwise the concept of comparison of two rival marks and adoption of the same from name of the salt or from ailments is entirely revisited .

The trademark of two parties in similar position ORZID and FORZID are held to be similar in the case of United Biotec(supra) where the salt in question was Ceftazidime was involved couple with the defense of third parties that words ZID was the part of generic name. The said judgment was given by the Division Bench of Hon'ble High Court of Delhi on 18.5.2012, disagreeing with the decision of Astrazeneca (supra) and Indo Pharma (supra)

The facts in the present case are almost identical. The Hon'ble Division Bench has confirmed the orders of IPAB.

b). As regards the other decision referred by the counsel for Mylan in the case of Schering (supra) apart of giving the distinguishing the features in earlier para a) it is matter of fact SMDyechem Limited vs Cadbury India Ltd reported in 2000PTC (20) (SC) 297, the said decision of the Supreme Court was already overruled by the Supreme Court in Cadila matter on the reason that law already settled for the last 50 years was overlooked. However it is surprise to note the overruled judgment was referred and the decision was rendered. Further the case referred in the said decision of SBL vs Himalaya Drug Company reported in 1997(17) PTC 540 (DB) it is matter of fact that the SBL appeal was filed against the order of interim injunction granted against the SBL and the appeal was allowed mainly on the reasons that the product LIVE

52 was general words. Even after trial the suit was dismissed assigning the same reasons. However in appeal before the Division Bench in RFA(OS) the appeal filed by Himalaya (supra) was allowed. The judgment passed by the single bench dismissing the suit was set aside. The Suit filed by Himalaya was decree and permanent injunction was passed against SBL.

The rest of many judgments referred by counsel for the Mylan mentioned in this judgment of Schering were not accepted by the recent judgment of the Division Bench of Delhi High Court in the case of United Biotech (supra)

Therefore all the decisions referred on behalf of Mylan are distinguishable as per its on facts and the valent decisions rendered by the Supreme Court and High Court post Cadila case.

According none of the decisions will help the case of Mylan. Apart from above Mylan has miserable failed to make out any case on merit in its favour.

42. As regards ORA 1 of 2016 are concerned, it is false and frivolous petition. It appears that it is filled as counter blast to the suit and rectification filed by Sun Pharma. There is no merit at all in view of reasons mentioned above. The same is dismissed

43. With regards to ORA 55 of 2015, Sun Pharma has been able to make a strong case in its favour. IPAB holds that the mark OXPLAT is coin word and was registrable. The trade mark of the Mylan SOXCLAT is deceptively similar.

If rival trademark of both parties are compared as a whole, it is similar. Sun Pharma is the prior in adoption and user of the Trademark than Mylan and other third parties registration referred by Mylan.

Trademark no. 1550804 in class 5 was wrongly registered and wrongly remaining on the Register. The entry of the said trademark offends under Section 11,18,32 and 57 of the Act.

44. In order to maintain purity of the register, it is removed from the Register forthwith. The respondent no 2 shall remove the entry immediately. From the record

45. Copy of order be served to Respondent no 2 for compliance.

46. Prayer in ORA/55/2015/TM/MUM is allowed and Prayer in ORA/1/2016/TM/MUM is rejected

47. No costs

sd-/

(ONKAR NATH SINGH)
TECHNICAL MEMBER (PVPAT)

sd-/

(JUSTICE MANMOHAN SINGH)
CHAIRMAN

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