

ORDER SHEET

IN THE HIGH COURT OF SINDH, KARACHI

Misc. Appeal No.35 of 2004

Date	Order with signature of Judge
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Appellant Lipha Lyonnaise Industrielle Pharmaceutique through Ms. Amna Salman, advocate.

Respondent No.1. The Registrar of Trade Marks.

Respondent No.2 Ali Gohar Pharmaceutical (Private) Limited through Ms. Saira Shaikh, advocate.

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MUHAMMED KARIM KHAN AGHA, J., This appeal has been filed by the appellant against the order dated 19.8.2003, passed by the respondent No.1-The Registrar, Trade Marks (hereinafter referred to as the "**Impugned Order**"), whereby the Opposition No.20/1998 filed by the appellant against the registration of trademark "GLUCONORM", applied for by respondent No.2, was dismissed and the registration application bearing No.121827 in Class 5 of the respondent No.2 was allowed to proceed for registration.

2. The appellant is an international pharmaceutical company and has obtained registration for the trademark of "GLUCOPHAGE" in at least 48 different countries.

3. The appellant also has a registered trademark in Pakistan known as "GLUCOPHAGE", which is a pharmaceutical product used in connection with the treatment of diabetes. This trademark was registered in Pakistan on 29.12.1975 under Trade Mark No.62385 in Class 5.

4. The respondent No.2 is a Pakistani based company, which had filed an application for registration of the trademark to be known as "GLUCONORM", which was advertised under No.121827 in Class 5 in Trade Marks Journal No.557 of 01.6.1997. GLUCONORM is a pharmaceutical product, which is also used for the treatment of diabetes.



5. The appellant filed an opposition before the respondent No.1 against the registration of respondent No.2's trade mark "GLUCONORM", on the basis of, amongst others, the following grounds:-

- (i) That it was in respect of the same goods or goods of similar description in respect of which the appellant is using and is the registered proprietor of the trademark "GLUCOPHAGE"; that the trademark "GLUCONORM" was nearly identical both visually and phonetically to the registered trademark of the appellant "GLUCOPHAGE" and as such the goods of the respondent No.2 are of the same description as the goods of the appellant.
- (ii) That the respondent No.2's trademark application was objectionable under Section 10(1) of the Trade Marks Act, 1940 (hereinafter called as "Act, 1940") and as such ought to be declined.
- (iii) Furthermore, that the trademark "GLUCONORM" was also objectionable under Sections 6, 8(a), 10(2) and 14(1) of Act, 1940.

6. On the other hand, the respondent No.2 contended before respondent No.1 that when taken as a whole the two marks were completely different from each other and that there were other trademarks, which had been registered with the prefix "GLUCO" and in particular referred to the trademark "GLUCONIL", which had been registered despite also being used for the treatment of diabetes.

7. The respondent No.2 also contended that the suffixes after the prefix "GLUCO" namely "PHAGE" and "NORM" have no similarity and there was no chance of the public being confused by the two trademarks. The fact that other trademarks have also been registered with the prefix "GLUCO" also indicated that there was no deception on the part of the respondent No.2.

8. After hearing the arguments of both the parties, in detail, the respondent No.1 passed the Impugned Order.



9. The learned counsel for the appellant has contended that the respondent No.1 erred in passing the Impugned Order, on amongst other, the following grounds:-

- (i) that the respondent No.1 did not pass a fully speaking order since it is only 25 lines long;
- (ii) that the respondent No.1 misinterpreted the fundamental question, which was, whether in terms of Section 10(1) of Act, 1940 the mark of respondent No.1 could be registered when mark of the appellant namely "GLUCOPHAGE" was already registered with respondent No.1 for the same class of goods and that the appellant's trade mark "GLUCOPHAGE" had been registered without any disclaimer;
- (iii) that the respondent No.1 failed to appreciate the established principle of law that marks have to be compared as a whole, which, had he considered, would have lead him to the conclusion that the mark of "GLUCONORM" was confusingly similar and/or closely resembled the appellant's registered trademark "GLUCOPHAGE" and as such should not be registered;
- (iv) that "GLUCONORM" is phonetically, visually and structurally similar to the appellant's registered trademark "GLUCOPHAGE" and that the adoption of the trademark "GLUCONORM" by respondent No.2 was dishonest.

10. Learned counsel for the appellant, in support of her contentions, has placed reliance on the following case law:-

- (i) REXONA PROPRIETARY LTD. v. MAJID SOAP WORKS ((PLD 1956 Sindh 1);
- (ii) ZENITH LABORATORY (PAK.) LTD. v. BRITISH DRUG HOUSES LTD. (PLD 1970 Dacca 772);
- (iii) RAM KUMAR JALAN v. R. J. WOOD & CO. (AIR 1941 Lahore 262);



- (iv) BURNEY'S INDUSTRIAL AND COMMERCIAL CO. LTD. v. REHMAN MATCH WORKS (PLD 1983 Karachi 357);
- (v) KABUSHIKI KAISHA TOSHIBA v. MUHAMMAD ALTAH (PLD 1991 SC 27);
- (vi) SEVEN-UP COMPANY v. KOHINOOR THREAD BALL FACTORY (PLD 1990 SC 313);
- (vii) AL-ANIS LABORATORIES v. AL-CHEMIST (1987 MLD 2823);
- (viii) PLATINUM PHARMACEUTICALS CO. (PVT) LTD. v. STAND PHARM PAKISTAN (PVT.) LTD (2006 CLD 1109);
- (ix) GLAXO LABORATORIES LTD. v. ASSTT. REGISTRAR, TRADE MARKS (PLD 1977 Karachi 858).

11. On the other hand, learned counsel for the respondent No.2, refuted all the above contentions of the appellant's counsel and submitted that the Impugned Order was correctly passed by the respondent No.2. In support of her submissions, she has relied on the following authorities:-

- (i) BAYER A.G. v. MACTER INTERNATIONAL (PVT) LTD., (2003 CLD 794);
- (ii) ENGLISH LABORATORIES PRIVATE LTD. v. CHAS A MENDOZA (1998 MLD 1234);
- (iii) INDO-PHARMA PHARMACEUTICAL WORKS LTD. v. CITADEL FINE PHARMACEUTICALS LTD. (AIR 1998 Madras 347);
- (iv) J.R. KAPOOR v. MICRONIX INDIA (1994 (3) SCC 215);
- (v) S.B.L. LTD. v. HIMALAYA DRUG CO. (AIR 1998 Delhi 126);
- (vi) E.Q. SQUIBB & SONS INC. v. CUREWEL INDIA LTD. (AIR 1987 Delhi 197);
- (vii) HAMDARD N.F. (PAK.) v. E.I.DU PONT DE NEMOURS & CO. (1987 CLC 1937);
- (viii) WELCOME FOUNDATION LTD. v. KHAWAR (1989 MLD 2516);
- (ix) MUHAMMAD YAQOOB LASANI ENGINEERING COMPANY v. PUNJAB ENGINEERING COMPANY (1992 CLC 2036);
- (x) CORN. PRODUCTS v. SHANGRILA FOOD PRODUCTS (AIR 1960 SC 142);
- (xi) In the matter of an application by Beck, Koller & Company (England) Limited for the Registration of a Trade Mark, before the Assistant-Comptroller (1947 RPC 76);

12. I have reviewed the documents on file, in detail, and carefully considered the arguments advanced by the learned counsel for the respective parties.

13. With regard to the ground of appeal, which, in essence, contends that the Impugned Order was a non-speaking order and was, therefore, liable to be set aside, I find no merit in this contention. This is because it is not the length of the order but the quality of the order, which is important. In my view the Impugned

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Order provided sufficient reasons to justify its findings. In this regard reliance is placed on the case of MUHAMMAD YAQOOB LASANI ENGINEERING COMPANY (supra), where it was held as follows:-

“I have examined the order. Major part of the order contains the statement of facts, contentions of the parties and it is only in the last paragraph that observations have been made. It is correct that the order is not an elaborate one but it will not be correct to say that it is not a speaking order. It has precisely given the reasons for rejecting the application mainly on the ground that in view of identical nature of the marks in respect of the same goods, public is bound to be deceived and confusion is likely to be created in their mind. Speaking order does not mean that it should be long and elaborate containing all minor details. It should give reasons for the decision in a clear manner which may be precise and should be intelligible. From a reading of the order one should feel that the issues have been dealt with in an analytical manner, mind has been applied and due consideration has been given to the facts, law and contentions of the parties.”

14. With regard to the other grounds of appeal, these would seem to revolve around the interpretation/application of Sections 8(a) and 10(1) of Act, 1940 by respondent No.1 to the registration of the proposed trademark of “GLUCONORM” by respondent No.2. For ease of reference, both these sections are set out below:-

Section 8(a)

“8. *Prohibition of registration of certain matter.* No trade mark nor part of a trade mark shall be registered which consists of, or contains, any scandalous design, or any matter the use or which would:-

(a) by reason of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a Court of justice; or

Section 10(1)

“10. *Prohibition of registration of identical or similar trade mark.* (1) Save as provided in sub-section (2), no trade mark shall be registered in respect of any goods or description of goods which is identical with a trade mark belonging to a different proprietors and either already on the register in respect of the same goods or description of goods or which so nearly resembles such trade mark as to be likely to deceive or cause confusion”.

15. The distinction between Section 8(a) and Section 10(1) of Act, 1940 was

set out in the case of GLAXO LABORATORIES LTD. v. ASSTT.



REGISTRAR, TRADE MARKS (PLD 1977 Karachi 858), relevant portion of which is reproduced as below:-

“.....The distinction between the two subsections, however, is that under section 10(1), the opponent may rely purely on his statutory right obtained by him. Under this section, the question of likelihood of deception or confusion becomes purely a question of comparison of the marks themselves for similarity; whereas, under section 8(a), the opponent, who alleges similarity of the marks, must further show that having regard to his user, the use of the mark by the applicant for registration for the same goods would be likely to deceive or to cause confusion.....”

16. In my view the crux of the matter in this appeal is whether the respondent No.1 in the Impugned Order has correctly come to the conclusion that the two trademarks, based on their alleged similarities, are unlikely to cause confusion in the mind of the general public.

17. A test for how confusion was to be judged was laid down in the case of ZENITH LABORATORY (PAK.) LTD. v. BRITISH DRUG HOUSES LTD. (PLD 1970 Dacca 772), as under:-

“The prohibition of the registration is applied to a trademark which is ‘likely to deceive or to cause confusion’. It is not necessary that there must be evidence of actual deception or confusion. It is true if such evidence is forthcoming that would support the refusal of registration on the ground of likelihood of future deception or confusion. But even in the absence of such evidence, if it appears to the registering authority that a trade mark sought to be registered is likely to deceive or cause confusion it would plainly be the duty of the Registrar to refuse registration in such a case. It is, therefore, to be considered if there is a likelihood of the public being deceived or confused in case of registration of the trade mark.

In considering as to whether a confusion is likely to occur it has to be borne in mind as to whether such a confusion would occur in the mind of a man of ordinary prudence.”

18. In the case of BAYER A.G. (supra) it was held in paragraphs 14 to 16 at pages 806 and 807 as follows:-

“14. The ultimate test is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff. The Court has to compare the two marks with the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down

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objective standard. The persons who would be deceived are of course the purchasers of the goods and it is the likelihood of their being deceived that is the subject for consideration. The purpose of comparison is for determining whether the essential features of the plaintiffs trade mark are to be found used by the defendant. When two marks are not identical the plaintiff would have to establish that the marks used by the defendant so nearly resembles with the plaintiff is registered trade mark is likely to deceive or cause confusion in relation to the goods in respect of which it is registered.

15. The test for judging the case of infringement and/or passing off remains the same when applied to medicines and pharmaceuticals. However, a few additional considerations arise when dealing with cases of such drugs which cannot be sold except on prescription of a doctor and which are sold only by such persons who have special knowledge or expertise in the field. The manner in which trade in such medicines is carried on that is, the patients advised by doctors, chemists and druggists, these two facts assume significance and shall have to be kept in view by the Courts.

16. To sum up correctly test to be applied for judging an infringement action or action in the field of medicinally and pharmaceutical preparations remains the same as are applicable to other goods. However, in case of preparation trading whereof is governed by the statutory rules or regulations, additional consideration becomes relevant they are (i) manner in which trade is carried on, such as sales should have been made only by authorized or licensed vendor, who will be also having supplied all medicine, (ii) class of person, who would be purchaser whether they would be accompanied by doctors prescription and would in all probability attaches with the doctor....."

19. In essence, it would seem that whether a proposed trademark with a similar name to that of an already registered trademark can also be registered, or be regarded as infringement or passing off in respect of the earlier trademark the test is whether through a similarity in name and pronunciation the two trademarks are likely to cause confusion in the mind of the public.

20. In the case of ENGLISH LABORATORIES (PRIVATE) LIMITED, it was held that two expressions and trade names used by parties viz. "Medicam" and "Medipac" were neither similar in get up nor in colour scheme nor in shape of label so as to deceive innocent buyer to buy one or the other. Even phonetically both trade names were enormously distinctive.

21. However, in the earlier mentioned case of ZENITH LABORATORY it was held that the words "livatogen" and "livegen" resembled visually and



phonetically and were likely to cause confusion. In the case of PLATINUM PHARMACEUTICALS CO. (PVT) LTD. v. STAND PHARM PAKISTAN (PVT.) LTD (2006 CLD 1109), it was held that the use of the name "ZANAFLEX" was so similar to "ZANIFLEX" that it would have caused confusion. Likewise, in the case of AL-ANIS LABORATORIES, referred above, the Court found the two proposed trademarks of "WHOBUCIDE" and "WHOMOCIDE", without doubt appearing both visually and phonetically similar and both marks consisting of a similar device of ribs and lungs. In the case of GLAXO LABORATORIES LTD. (supra) it was held at placitam (d) as follows:-

"Opposition to registration of Trade Mark "Vistamycin" filed by holder of Trade Mark "Crystamycin" on ground that proposed mark "Vistamycin" so nearly resembled its registered Trade Mark "Crystamycin" both visually and phonetically that its registration and use in respect of same products likely to deceive and cause confusion in course of trade and among purchasing public—Held" Structure of two words almost same—Each word having four syllables major portion whereof identical in sound and appearance, 'V' and 'C' being soft consonants prefix syllables 'vis' and 'crys' sounding similar, prefix syllables likely to be missed when words imperfectly heard, especially on telephone or when carelessly pronounced, words when pronounced bear close resemblance."

22. The above cited cases illustrate the words' distinction in terms of similarity in name and pronunciation. However, in cases where only the prefix of the trademark (which is generic in nature) is similar and the suffixes are largely different then generally the authorities show that there is lesser chance of confusion.

23. This is relevant to this case where both marks contain the prefix "GLUCO".

24. In the above case of BAYER A.G. it was further held at page 810 as under:-

"The word "CIP/CIPRO" has been used in the field of medicinal preparation, which has the prefix of generic name of antibacterial medicine "CIPROFLAXIN" common to the trade describing the medicine preparation for antibiotic product. The

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generic name of a product can never function as trade name to indicate the origin. It has become public juris on which anyone cannot claim proprietary right to exclusively use. In this context, it may be relevant to refer the sentence contained in *mc Cathy on Trade Marks and Unfair Competition*:

"An abbreviation of generic name which still conveys to the buyer the original generic connotation of the abbreviated name is still generic.

Phonetically the words "XIN","QUINE" and "CIDE" being totally dissimilar are not going to create any confusion in the minds of user, specially in this case when the visual impression of the above trade marks is completely different with different label, design, getup and colour scheme."

Therefore, the submission made by the learned counsel for the defendant that there cannot be chance of buyer and user being misguided or confused by the above trade name cannot be brushed aside. Therefore there is no difficulty in coming to the conclusion that there is no phonetic or visual resemblance. *Moreover, nobody can claim exclusive right to use any abbreviation, which has become public juris. The rival marks "CIPROXIN", "CIPROQUINE" and "CIPROCIDE" contain the common feature "CIPRO", which is not only descriptive but also public juris. Therefore, a customer will bend to ignore the common feature and will pay more to uncommon features i.e. "XIN", "QUINE", "CIDE" which cannot be said to have such phonetic similarity so as to make it objectionable.*" (italics added)

25. This being the position, it is clear that because both products have the prefix of "GLUCO", this will not alone exclude respondent No.2's product from being registered.

26. The argument will turn on the similarity of the words coming after the prefix and whether such similarity would be likely to cause confusion in the mind of the public. In this case the suffixes of the marks are "PHAGE" and "NORM" respectively. Both these suffixes are entirely different, in spelling and pronunciation and are distinguishable from the earlier cited cases where the spelling or pronunciation of the name was found to be too similar.

27. The boxes in which the products are sold not only show a dissimilarity in spelling of the suffixes but also each have different chemical names underneath. The colouring used on the respective boxes is also different (one green and the other red and blue). Furthermore, there is already a registered



product in the market known as "GLUCONIL" which is also for the treatment of diabetes. Since these are pharmaceutical products, the public, who purchases the product, may also have the benefit of the pharmacist's advice or even have been prescribed the respective product in writing by a doctor. This is especially relevant in this particular case, as both the products on their respective boxes state that the dosage is to be as prescribed by the Physician and that they are to be sold on the prescription of a registered Medical Practitioner.

28. In the case of NEW LIGHT CHEMICAL INDUSTRIES, referred above, it was observed at placitum (c) as follows:-

"In consideration an application under Section 10 of the Trade Marks Act, the main duty of the Court is towards the public and maintenance of purity of the register. When a case is sought to be made out that a particular Trade Mark is likely to deceive and create confusion, the contest is not so much between the parties to the litigation as it is a contest between a party defending his right to a particular Trade Mark and the public, and the decision of the Registrar in such a case must carry considerable weight with any Court or Tribunal which is to review its decision. *If the Registrar has exercised his discretion properly, High Court would be loath to interfere with his order.*" (italics added)

29. Bearing in mind the above considerations, in my view, there is very little chance of the public, even a semi literate one as in Pakistan, being confused by the marks "GLUCOPHAGE" and "GLUCONORM".

30. This being the case, I am of the view that the respondent No.1 correctly disallowed the opposition of the appellant for the findings disclosed in the Impugned Order and as such I do not find any reason to interfere with the same.

Accordingly, Misc. Appeal No.35 of 2004 is dismissed in limine.

Karachi,
Dated: 25.5.2009.

