

IN THE HIGH COURT OF SINDH, KARACHI

Misc. Appeal No.10 of 2013

[*Muhammad Abdullah vs. Sanofi Aventis and another*]

Appellant : Through Mr. Salman Ahmed Shaikh, Advocate
Respondent No.1 : Through Mr. Shanur Rehman, Advocate.
Date of Hearing : 26.01.2026
Date of Order : 05.03.2026

JUDGMENT

ARSHAD HUSSAIN KHAN, J. Through this Misc. Appeal filed under Section 114 of the Trade Marks Ordinance, 2001, the appellant has called in question the decision dated 07.12.2012, passed by the Registrar of Trade Marks, Karachi, whereby Opposition No.1147 of 2007, filed by respondent No.1, namely; Sanofi Aventis, was allowed and the registration of the appellant's trade mark "PROGREL" under Application No.204712 in Class-5, dated 10.01.2005 in respect of pharmaceutical medicines was refused.

2. Briefly stated, the appellant claims to be engaged in the manufacture and sale of pharmaceutical and medicinal preparations and asserts that he has been marketing his products under various trade marks including the mark "PROGREL." In order to secure statutory protection, the appellant applied for registration of the said mark before the Registrar of Trade Marks under Application No.204712 in Class-5 on 10.01.2005. The application was examined in the ordinary course, accepted, and subsequently advertised in Trade Marks Journal No.679 dated 01.08.2007.

Upon such publication, respondent No.1 filed a notice of opposition to which the appellant submitted a counter-statement. Both parties thereafter led evidence in support of their respective claims. After hearing the parties, the Registrar of Trade Marks, vide impugned decision dated 07.12.2012, allowed the opposition and refused registration of the appellant's trade mark. Being aggrieved by such refusal, the appellant has preferred the instant appeal.

3. Learned counsel for the appellant has contended that the impugned decision dated 07.12.2012, passed by the Registrar of Trade Marks, is illegal and unsustainable having been rendered without proper appreciation of the facts, evidence and settled principles of trade mark law. It was argued that the appellant has been extensively using the trade mark “PROGREL” in respect of pharmaceutical preparations, which has acquired distinctiveness through continuous use. It was further submitted that the mark “PROGREL” does not fall within the bar of Section 16 of the Trade Marks Ordinance, 2001, as it is neither the name of any single chemical element or compound nor an International Non-Proprietary (INN) Name. Likewise, the Registrar wrongly applied Section 14, as the impugned mark is an invented and inherently distinctive word, not descriptive of the goods.

Learned counsel has also argued that the mark “PROGREL” is not deceptively similar to the alleged INN “CLOPIDOGREL,” as in trade mark comparison greater importance is attached to the dominant and distinctive features, particularly the prefix, and similarity based merely on a common suffix cannot constitute confusion, especially where such suffix is common in the pharmaceutical trade. In this regard, it was pointed out that several marks containing the suffix “GREL” are already in use in the market, rendering the said portion *publici juris* and incapable of exclusive claim by respondent No.1, namely Sanofi Aventis. It was lastly contended that the impugned order is non-speaking, suffers from misreading and non-reading of evidence, and was passed without properly considering the appellant’s submissions; hence, it is liable to be set aside. Learned counsel has relied upon the case of *Abdul Wahid v. Haji Abdur Rahim and another* [PLD 1973 SC 104], *Byer A.G and another v. Macter International (Pvt.) Ltd.* [2003 CLD 794], *Lipha Lyonnaise Industrielle Pharmaceutique v. Registrar Trade Marks and another* [2009 CLD 1289], *Jamia Industries Ltd. v. Caltex Oil (Pak) Ltd. and another* [PLD 1984 SC 8] and *Messrs Farooq Ghee and oils Mills (Pvt.) v. Registrar of Trade Marks and others* [2015 CLD 1245].

4. Learned counsel for respondent No.1, namely Sanofi Aventis, opposed the appeal and supported the impugned decision, contending that the same is lawful and in consonance with the provisions of the Trade Marks Ordinance, 2001. It was argued that respondent No.1 is a globally renowned pharmaceutical group engaged in extensive research, development and marketing of medicinal products, including the discovery of the substance “CLOPIDOGREL,” which has been adopted as an International Non-Proprietary Name (INN). Learned counsel has further submitted that INNs are unique generic names assigned under the system of the World Health Organization to identify pharmaceutical substances and such names, including their common stems, are public property and cannot be monopolized through trade mark registration. It was contended that the stem “GREL” forms part of the INN CLOPIDOGREL and denotes a class of pharmacologically related substances; therefore, no trader can claim exclusive rights over such stem or any mark derived therefrom.

It was further argued that the appellant’s applied mark “PROGREL” is clearly derived from and contains the identical INN stem “GREL,” and its registration would be contrary to Sections 14 and 16 of the Ordinance, which prohibit registration of marks that are generic, descriptive, devoid of distinctiveness, or based on chemical names or INNs. According to learned counsel, permitting such registration would create a likelihood of deception and confusion among medical practitioners, pharmacists and patients, particularly because the public may associate the mark with the generic drug CLOPIDOGREL irrespective of its actual composition, thereby posing serious risks to patient safety.

Learned counsel has also contended that the suffix “GREL” is technical and publici juris, and the appellant, being fully aware of its generic character and prior use in the pharmaceutical trade, cannot claim proprietorship or exclusive rights therein. It was further argued that allowing the mark would unfairly confer monopoly over a generic pharmaceutical term and would enable the appellant to gain undue commercial advantage in prescriptions and dispensing. Lastly, it was submitted that the impugned mark is likely to mislead

consumers into believing that the appellant's product originates from or is associated with respondent No.1, being the inventor of CLOPIDOGREL. On these grounds, learned counsel prayed that the appeal be dismissed with costs. He has relied upon *the Guidance on the Use of International Nonproprietary Names [INNs] for Pharmaceutical Substances and an Indian Case law reported as Pharma Research and Analytical Lab. Vs. Jal Private Limited, another case of Federal Supreme Court Germany reported as Godecke A.G.'s Application to register a trade mark.*

5. Heard learned counsel for the parties, perused the record as well as the relevant laws.

The record reflects that Opposition No. 1147/2007 was filed against Application No. 204712 in Class-5, and the Registrar of Trade Marks, vide order dated 07-12-2012, allowed the opposition and refused registration of the applicant's mark, which has given rise to the present Miscellaneous Appeal.

6. The primary reason cited by the respondents for opposing the registration was that the applicant's proposed mark was allegedly identical or deceptively similar to an earlier mark, and its registration would result in confusion among consumers, particularly in the pharmaceutical and medicinal market. Learned counsel for the respondents placed significant reliance on the INNs (International Nonproprietary Names) guidelines, contending that the applicant's mark, in its phonetic, visual, and structural composition, could potentially mislead consumers or create confusion with established marks in the same class. He has argued that, as per the INNs guidelines, the statutory objective of maintaining clarity and avoiding deceptive similarity in pharmaceutical marks should prevail over the applicant's interest in registration.

7. Upon careful examination of the record, including the Registrar's order, the material submitted by the applicant, and the arguments advanced by both parties, it appears that the Registrar's order was predominantly based on a theoretical assessment of similarity rather than an evidence-based analysis of the actual likelihood of confusion among the relevant class of consumers.

While the INNs guidelines are an important consideration, they are not absolute prohibitions against registration. The guidelines themselves recognize that marks, which are distinctive, clearly differentiated, and unlikely to mislead consumers can be registered even if there is some similarity in nomenclature.

8. As far as Sections 14 and 16 of the Trade Marks Ordinance, 2001 are concerned, it is noted that the Registrar invoked these provisions on the premise that the applied mark allegedly incorporates a stem derived from an International Non-Proprietary Name and, therefore, lacks distinctiveness or falls within the statutory prohibition.

A careful reading of Section 14 shows that the bar operates only where a mark is devoid of any distinctive character, or consists exclusively of indications that may serve in trade to designate the kind, quality, intended purpose, or other characteristics of the goods. In the present case, the applied mark, taken as a whole, is an invented and inherently distinctive word, and does not directly describe the composition, nature, or characteristics of the pharmaceutical product. Mere presence of a common suffix, without evidence that the mark as a whole is descriptive or non-distinctive in trade, does not attract the mischief contemplated under Section 14.

Similarly, Section 16 prohibits registration of words, which are the commonly used and accepted names of single chemical elements or compounds, or International Non-Proprietary Names in their generic sense. The prohibition is directed against appropriation of the exact chemical or generic name itself, and not against marks that may incidentally contain a syllable or stem resembling part of such a name. In the absence of evidence that the applied mark is itself an INN, or is used in trade as the recognized chemical name of a substance, the statutory bar under Section 16 cannot be invoked merely on theoretical or remote similarity.

Thus, the reliance placed by the Registrar on Sections 14 and 16, without a clear finding that the applied mark squarely falls within the precise scope of these prohibitions is unsustainable and cannot operate as a ground for refusal of registration.

9. As far as the definition of a trade mark is concerned, Section 2(xlvii) of the Trade Marks Ordinance, 2001, provides that a trade mark must be capable of being represented graphically and must be able to distinguish the goods or services of one undertaking from those of others. This provision forms the foundation of the Ordinance and guides the examination of any mark for registration. The reference to Section 2(xlvii) in the Registrar's order appears to have been misapplied, as a mark cannot be refused registration merely on the basis of theoretical similarity to an INN or its components. In the present case, it is evident from the material on record that the mark "PROGREL", as a whole, is capable of distinguishing the applicant's goods in the marketplace and does not merely replicate the INN "CLOPIDOGREL" or its stem. Therefore, the correct test is satisfied, and there is no justification for denying registration on the ground of Section 2(xlvii). Accordingly, the mark "PROGREL" must be recognized as meeting the statutory requirements for registration, notwithstanding any common suffix or stem with existing INNs.

10. The applicant has submitted comprehensive evidence demonstrating that the proposed mark is distinctive in appearance, pronunciation, and overall presentation. The evidence includes trade practice details, packaging, and market placement, showing that the marks function in different market contexts, thus eliminating the possibility of consumer confusion.

11. Furthermore, the principles of trade mark law are that a mark may only be refused registration if it is identical or so nearly resembling a prior mark that it is likely to deceive or cause confusion. The respondents have not produced concrete evidence demonstrating actual deception, confusion, or likelihood thereof. Their reliance on INNs guidelines does not, by itself, satisfy the statutory requirement of proving a substantive likelihood of consumer deception. The contentions of the respondents regarding similarity and potential confusion are therefore unsubstantiated and theoretical. The applicant has successfully shown that the proposed mark is legally and commercially distinguishable from any earlier marks relied upon by the respondents and that registration will not

contravene public interest, mislead consumers, or violate INN standards.

12. The record reflects that the Government of Pakistan, Ministry of Health, granted registration to the appellant's mark under Section 7 of the Drugs Act, 1976, read with Rules 28, 29, and 30 of the Drugs (Licensing, Registration and Advertising) Rules, 1976, vide order dated 22.04.2004. There is nothing on the record to indicate that the respondent either raised any objection at the time of registration or, thereafter, initiated any proceedings for cancellation of the said registration. Though registration under the Drugs Act, 1976 does not automatically mean that a mark must be registered as a trade mark, the fact that the authorities allowed the product to be sold under this mark, and no objection was raised at that time, is a relevant circumstance showing that the mark was in regulated use.

13. It is further noted that the appellant has filed a statement dated 26th January, 2026, placing on record eight extracts from the Official Register of Trade Marks, namely ZYGREL, LODIGREL, ABAGREL, ACTOGREL, GRELIXAN, FORGRELIS and OGREL, together with their respective registration numbers and dates of registration. These marks, all registered in Class-05, pertain to pharmaceutical and medicinal products, including antiplatelet and related therapeutic drugs. The appellant contends, and this Court agrees, that the mere presence of the suffix "GREL" cannot render the impugned mark deceptively similar to any other mark, as the overall impression, dominant features, and prefix of the mark are determinative. This Court observes that the registration of multiple marks containing the same suffix demonstrates that such endings are descriptive of the therapeutic class rather than indicative of a single source. In view of this, the impugned mark possesses sufficient distinctiveness in its dominant features and is not likely to cause confusion among the relevant public. Therefore, reliance solely on the common suffix, particularly in the context of Class-05 pharmaceutical products, cannot operate as a ground to refuse registration.

14. The Supreme Court of Pakistan, in *Abdul Wahid (supra)*, held that where two marks share a common suffix, the distinguishing

value ordinarily lies in the earlier and dominant portion of the word. In that case, the Court observed that the marks “Daigon” and “Dragon” were neither deceptive nor likely to cause confusion despite having a common ending, as their distinctive initial portions were materially different. The principle thus established is that a shared suffix, by itself, is insufficient to create confusion in trade. Applying this reasoning to the present case, the suffix “GREL” in the mark “PROGREL” cannot, on its own, render the mark confusingly similar to the INN “CLOPIDOGREL,” as the dominant and distinctive portions of the two expressions are clearly different.

15. It is also observed that the Registrar, in arriving at the refusal, did not provide a detailed evaluation of the applicant’s submissions regarding market practices, channels of distribution, and the distinct identity of the mark in trade. A plain reference to potential confusion, without weighing the distinguishing factors and actual evidence, does not meet the threshold required under the Trade Marks Ordinance for refusal of registration.

16. Moreover, it would be useful to briefly notice the foreign authorities relied upon by the learned Registrar, namely (1986) ILPR 16, (1980) IPLR 64 and (1981) FSR 354. These decisions underscore that pharmaceutical trademarks require stricter scrutiny in view of public health considerations. They emphasize that International Non-Proprietary Names (INNs), including their recognized stems, are intended to remain available to the trade, and that a mark which substantially appropriates or closely imitates an INN may give rise to confusion and should not be permitted to monopolize generic nomenclature. However, these authorities do not lay down an absolute rule that every mark containing a syllable resembling part of an INN must automatically be refused. The caution expressed therein is directed against adoption of the INN itself, or a mark so closely modeled upon it as to create a real likelihood of deception. The main point is to see whether the marks are actually similar and likely to confuse the public, not just superficially or slightly alike.

In the present case, the learned Registrar appears to have treated the suffix “GREL” alone as sufficient to attract statutory

prohibition, without examining the mark as a whole or recording any finding of actual or probable confusion. Such mechanical reliance upon the cited precedents, without applying the settled test of overall impression and likelihood of deception, amounts to misapplication of those principles. The refusal of registration on that basis, therefore, cannot be sustained.

17. In light of the above discussion, it is evident that the refusal of registration by the Registrar of Trade Marks was overly cautious and not fully in accordance with the statutory principles and that the applicant is entitled to registration of the mark. The applicant has fulfilled all statutory requirements, including distinctiveness, non-deceptiveness, and compliance with the relevant class specifications.

18. In view of the analysis of the material on record, the arguments advanced by the parties, and the principles governing trade mark registration under the Trade Marks Ordinance, 2001, the Miscellaneous Appeal is hereby allowed. Opposition No.1147/2007 is overruled, and Application No.204712 in Class-5 is directed to be registered. The Registrar of Trade Marks is directed to update the register and complete all formalities accordingly.

JUDGE