

**2015 C L D 1162**

**[Sindh]**

**Before Muhammad Shafi Siddiqui, J**

**NOVARTIS AG through Authorized Signatory and another---Plaintiffs**

**Versus**

**NABI QASIM INDUSTRIES (PRIVATE) LIMITED through Chief  
Executive/Director/Company Secretary---Defendant**

Suit No. 1203 of 2007, decided on 3rd April, 2015.

**Trade Marks Ordinance (XIX of 2001)---**

---Ss. 8(1) & 40---Civil Procedure Code (V of 1908), O. XXXIX, Rr.1 & 2---Specific Relief Act (I of 1877), S. 54---Infringement of trade mark---Permanent Injunction--- Application for grant of interim injunction under O. XXXIX, Rr. 1 & 2, C.P.C.--- Similarity and deceptivity in trademarks, determination as to--- Plaintiffs, pharmaceutical company owned trade mark "LESCOL" and got the same registered in year 1991---Trade mark "DESCOL" belonged to defendant, also a pharmaceutical company, which was registered in 2003---Plaintiff sought permanent injunction against use of defendant's trade mark and running of business thereunder contending that defendant's trade mark was phonetically, visually and structurally deceptive and confusingly similar and/or resembled plaintiff's trade mark and defendant's product was likely to pass off as that of plaintiff's product---Both trade marks involved sale of almost same medicinal product--- Validity---Prescription of doctor and his expert opinion would be important factor in recommending medicine---Persons prescribing, dealing and offering medicines were specialist meant to protect passing of such medicine available at shop and sale of such medicine were carried out by authorized or licensed persons---Partially phonetically both trade marks were similar, but, for pharmaceutical products, the assigned names were given on basis of generics---No one could claim any proprietary right regarding such generic words as to its exclusive use---Trade mark was to be seen with complete getup, colour scheme, design and printing---Plaintiff's claim related to phonetic similarity between the two trade marks and not to the whole word or design or getup---No deceptive similarity existed between the two trade marks when seen as a whole--- Pharmaceutical products were not ordinary goods which a person could point out at shop and buy at his choice---No case was made out for injunction---Application was dismissed, in circumstances.

Jamia Industries Ltd. v. Caltex Oil (Pak.) Ltd. PLD 1984 SC 8; Societe Des Products Nestle S.A. v. Food International (Pvt.) Ltd. 2004 CLD 1383; Platinum Pharmaceuticals Company (Private) Limited v. Stand Pharm Pakistan (Private) Limited 2006 CLD 1109; National Detergents Ltd. v. Mod International (Pvt.) Ltd. 1993 MLD 590; Lipha Lyonnaise Industrielle Pharmaceutique v. Registrar of Trademarks 2009 CLD 1289; Bayer A.G. v. Macter International (Pvt.) Ltd. 2003 CLD 794; English Laboratories (Pvt.) Ltd. v. Chas Mendoza Pharmaceutical Laboratories 1998 MLD 1234 and Johann A. Wulfing v. Chemical Industrial and Pharmaceutical Laboratories AIR 1984 Bombay 281 rel.

Ms. Amna Salman for Plaintiffs.

Muhammad Akram Swaleh for Defendants.

Date of hearing: 12th March, 2015.

**ORDER**

**MUHAMMAD SHAFI SIDDIQUI, J.**---This suit is filed by the plaintiffs against the defendant for permanent injunction claiming therein that the defendant by marketing their product has in fact infringed the trade mark rights of the plaintiff and the listed application is filed under Order XXXIX, Rules 1 and 2, C.P.C. seeking interim restraining order.

Learned counsel for the plaintiffs in support of the application submitted that plaintiff No.1 is engaged in research, manufacture and sale of pharmaceutical products

throughout the world and plaintiff No.2 is part of plaintiff No.1 which is also engaged in business of manufacturing and/or formulating and selling of various pharmaceutical products in Pakistan for and on behalf of first plaintiff. In pursuit of the business plaintiff No.1 has appointed plaintiff No.2 as authorized user of various trademarks including "Lescol" belonging to the first plaintiff. In order to protect the interest the plaintiff No.1 registered his trademark "Lescol" in several territories of the world and accordingly in Pakistan under Trade Marks Act, 1940 (now replaced by Trade Marks Ordinance, 2001) and Government of Pakistan Trade Mark Registry Karachi was pleased to register the trademark of the plaintiffs as "Lescol" on 19-2-1991.

It is contended by the learned counsel for the plaintiff that the medicine of the plaintiffs containing treatment of hypercholesterolemia and carrying trademark "Lescol" was first launched in the year 1995 and since then they are in uninterrupted use of such trademark and the products are continuously sold in Pakistan under such, trademark. Thus, the product of the plaintiff during this period acquired high reputation and goodwill in Pakistan and the use of similar or deceptive trademark by another manufacturer or trader would result in misrepresentation in the course of trade to potential customers, which amounts to infringement of the rights of the plaintiffs.

It is contended by the learned counsel that in the year 2007 the plaintiffs came to know that the defendant had started manufacturing, packing and selling pharmaceutical product for the treatment of cholesterol levels using the trademark "Descol". It is contended that the defendant's trademark "Descol" is phonetically, visually and structurally deceptive and confusingly similar and/or resembles plaintiffs trademark "Lescol". Learned counsel added that since the product has been launched by the defendant after some time when the product of the plaintiffs has gained popularity therefore there is no other reason for giving this deceptive name than the mala fide and dishonesty.

It is contended that the product containing atorvastatin has similar use and sales outlets as of plaintiffs' product and hence the plaintiff apprehends that the defendant may pass on their product through this imitative trademark. Hence, submitted that the defendants be restrained from selling, marketing their products which are deceptively similar as contended above.

Learned counsel in support of her contention has relied upon section 40 of Trademark Ordinance, 2001 and the cases of Jamia Industries Ltd. v. Caltex Oil (Pak.) Ltd. (PLD 1984 SC 8), Societe Des Produits Nestle S.A. v. Food International (Pvt.) Ltd. (2004 CLD 1383), Platinum Pharmaceuticals Company (Private) Limited v. Stand Pharm Pakistan (Private) Limited (2006 CLD 1109) and National Detergents Ltd. v. Mod International (Pvt.) Ltd. (1993 MLD 590).

On the other hand learned counsel for the defendant contended that there is nothing deceptively similar in the two products as the generatic ingredients used for cure of the disease, which is common in both the products is "Col". Learned counsel also relied upon the product registration certificate, which is filed along with written statement. He also relied upon the packing material, which has been separately filed during the course of the arguments as the original color wrappers were not available which were then made part of the record.

Learned counsel further submitted that the suit is filed in the year 2007 whereas the DRAP has issued certificate of its registration in the year 2003 and hence they have squeezed their rights, if at all, without prejudice to the above, were available to them. Learned counsel while referring to section 81(1) of Trademark Ordinance, 2001 submitted that although five years are prescribed in the aforesaid section however for the purpose of this application at least four years' time has lapsed and hence the plaintiffs have lost prima facie case insofar as injunction is concerned.

Learned counsel in this regard has also relied upon the case of Lipha Lyonnaise Industrielle Pharmaceutique v. Registrar of Trademarks (2009 CLD 1289), Bayer A.G. v. Macter International (Pvt.) Ltd. (2003 CLD 794), English Laboratories (Pvt.) Ltd. v. Chas Mendoza Pharmaceutical Laboratories (1998 MLD 1234), Johann A. Wulff v. Chemical Industrial and Pharmaceutical Laboratories (AIR 1984 Bombay 281).

Heard the learned counsel and perused the record.

The question that needs to be decided through these proceedings is the similarity and deceptiveness in the words "Lescol" and "Descol". The plaintiffs have brought this

suit for permanent injunction restraining the defendants from using the alleged deceptive trademark which allegedly infringes the rights of the plaintiff. The main grounds of the plaintiff are that the two names "Lescol", and "Descol" are phonetically similar and as such the products of the defendants are likely to pass off as that of plaintiff's product. These are pharmaceutical and medicinal products and the ultimate tests as to whether mark used by the defendant as a whole deceptively similar to that of a registered mark of the plaintiff to me carries an additional step of prescription of doctor and pharmacist and only on this account it distinguishes from other goods for the simple reason that it is not choice of the patient or a consumer who may be deceived of its deceptive name if at all is. It is rather based on prescription of a doctor whose expert opinion would play an important factor in recommending the medicines. No doubt the general test for judging case for infringement and/or passing off remains the same when applied to the medicines and pharmaceutical, the additional features however are that they are sold on a prescription of a doctor by a Pharmacist who has special knowledge and special eye in this regard and chances of deception on such score would be least. As observed above that while dealing the trademark in relation to the medicines this special significance is attached that the person who is prescribing the medicines and person who is dealing and offering the medicines are specialist and are meant to protect passing of such medicines available at the shop. It is also matter of fact that the sate of these medicines are carried out by authorized or licensed persons.

No doubt that partially phonetically the two trademarks that are being used are similar and apart from all such general tests prescribed for judging similarity and deceptiveness it is to be seen on the touchstone of principle as laid down insofar as these pharmaceutical products are concerned that the assigned names are on the basis of generics. In the instant case the claim only relates to phonetic similarity of the word "Col". However prefix to this suffix is different i.e. "Les" and "Des". However exclusiveness is being claimed insofar as the entire word is concerned The word "Col" is in the field and is being a generic word and the prefix apparently is not similar and hence insofar as these generic words are concerned no one can claim any' proprietary right to its exclusive use.

The similar question was raised in the case of Liphā Lyonnaise Industrielle Pharmaceutique v. Registrar of Trade Marks and another reported in 2009 CLD 1289. Dealing with the words "Glucophage" and "Gluconorm", the Court while dealing in the similar circumstances has held that these products are being sold on the prescription of a doctor and hence there could not be a chance of buyer and user being misguided or confused by such similarities. It was observed that the abbreviation such as "Gluc" has now been considered as a public juris hence only for the reason that it has common suffix will not amount to any infringement as claimed by the plaintiff.

Similarly in the case Bayer A.G. v. Macter International (Pvt.) Limited (2003 CLD 794) a similar question arose as to whether rival marks such as "Ciproxin", "Ciproquine" and "Ciprocide" have a deceptive character in terms of pronunciation and visual resemblance. The learned Single Judge held that phonetically word; "Xin", "quine" and "cide" being totally dissimilar are not going to create any confusion in the minds of user specially when it is presented with different label, design, getup and colour scheme and learned Single Judge observed that there is no phonetic or visual resemblance. Moreover, nobody can claim exclusive right to use any abbreviation which has become public juris.

In the instant case claim of the plaintiff is not on the entire word or design or getup but on the phonetic similarity between the two marks of the plaintiff and defendant, which is only partial as apparently a prefix to the suffix is different in spelling. The marks are also to be seen with complete getup, colour scheme, design and printing, which is very different, nor it is claimed to be similar as only phonetic similarity in words are challenged.

On the above factors and tools of test when I compared the mark as a whole including its design, getup, and colour scheme etc. I see no similarity in the two which can deceive the eye. More importantly as I observe that these are not ordinary goods which a person can point out at the shop and buy at his choice. Hence, plaintiff has not made out any case of injunction and as a result of the above discussion, the application in hand is dismissed.

