



* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

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Judgment Reserved on: 04.10.2024
Judgment pronounced on: 22.10.2024

+ **C.A.(COMM.IPD-TM) 9/2023**

M/S ABBOTT GMBH

.....Appellant

Through: Ms Tusha Malhotra and Ms Sugandha
Yadav, Advocates.

versus

REGISTRAR OF TRADEMARKS & ANR.Respondents

Through: Mr Amit Singha, Advocate for
Respondent No.2.

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J.

1. The present appeal under Section 91 of the Trade Marks Act, 1999 [hereinafter 'the Act'] impugns the order dated 20th June, 2022, passed by the Registrar of Trademarks in Trade Mark Application No.1383109 under Class-5, whereby the Appellant's opposition to registration of the mark "MEBUFEN" was refused.

BRIEF FACTS

2. Brief facts giving rise to the present appeal are set out hereinafter:

2.1 The Appellant/ "M/s Abbott GmbH" is the proprietor of the mark "BRUFEN" for pharmaceutical products including analgesics, anti-inflammatory, anti-arthritic, and cold and flu products. The trademark



“BRUFEN”, among other marks, was acquired by the Appellant by virtue of a Deed of Assignment dated 9th August, 1995 from ‘The Boots Company PLC, UK’, and the said trademark has been used continuously and extensively by the Appellant.

2.2 The Appellant's statutory rights in the mark “BRUFEN” also encompass India where the Appellant has a trademark registration for the mark “BRUFEN” under Registration No.250671 in Class-5. The Appellant has extensively and continuously used the mark since the year 1973, in relation to pharmaceutical products. The Appellant has statutory rights over the mark “BRUFEN” in several countries and is also the proprietor of various “BRUFEN” formative marks.

2.3 The Respondent No.2/ “M/s Meridian Medicare Limited”, through its director, Mr Vinod Gupta had filed an application bearing Application No.1383109 dated 7th September, 2005 for registration of the Trade Mark “MEBUFEN” (*hereinafter ‘impugned mark’*) in Class-5 as a word mark for Medicinal and Pharmaceutical Preparations. The Respondent No.2 has claimed user of the impugned mark since 1st April, 1988.

2.4 The said Application No.1383109 was advertised before acceptance by the Respondent No.1/Registrar of Trademarks under Section 20(1) of the Act, in the Trade Marks Journal on 1st July, 2006.

2.5 The Appellant filed a Notice of Opposition by way of TM-5, *vide* Opposition No.248459 dated 7th December, 2006 and opposed the Respondent's impugned mark “MEBUFEN” which was advertised by the Registrar of Trademarks.



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3. By way of the impugned order, the Registrar of Trademarks refused the Appellant's opposition to registration of the mark "MEBUFEN" and consequently, the aforesaid mark was granted registration in Class-5.

4. Aggrieved by the aforesaid order, the Appellant/ Opponent has filed the present appeal.

5. Notice in the present appeal was issued *vide* order dated 13th March 2023. Reply has been filed on behalf of Respondent No.2. Parties have also filed written notes of arguments.

SUBMISSIONS ON BEHALF OF THE APPELLANT

6. Ms Tusha Malhotra, learned counsel appearing on behalf of the Appellant, has made the following submissions:

6.1 The Registrar of Trademarks as a whole has misapplied the ratio of ***Cadila Health Care Ltd.v.Cadila Pharmaceuticals Ltd.***¹ for deciding the question of deceptive similarity. The Supreme Court in ***Cadila Health Care***(supra) has held that the competing marks have to be considered as a whole. However, the impugned order proceeds with a meticulous comparison of the wordmarks, in a 'letter-by-letter and syllable-by-syllable' manner. It is the settled position of law that such dissection of marks is not permissible.

6.2 The mere addition of the letters "ME" to BRUFEN would not ascribe distinctiveness to the impugned mark as the same is cosmetic in nature and would cause confusion in the market. Both the product of the Appellant as well as Respondent No.2 contain the same ingredient "IBUPROFEN"*i.e.*,

¹ (2001) 5 SCC 73.



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used for pain relief. Hence, the similarity between the marks is likely to cause confusion among the public.

6.3 The rival marks are phonetically similar. In this regard, reliance is placed on the judgment in *Glenmark Pharmaceuticals Ltd. v. Sun Pharma Laboratories Ltd.*², wherein a Division Bench of this Court has held that similarity must be seen keeping in mind a person of ‘average intelligence and imperfect recollection’.

SUBMISSIONS ON BEHALF OF THE RESPONDENT NO.2

7. Mr Amit Singha, learned counsel appearing on behalf of the Respondent No.2, has made the following submissions:

7.1 Both the marks, “BRUFEN” and “MEBUFEN” are structurally, visually and phonetically different. The only commonality between the marks “MEBUFEN” and “BRUFEN” is the suffix/word “FEN”. The term ‘FEN’ is found in around 5,101 trademarks which contain the same as a prefix/ middle term or a suffix.

7.2 The word “FEN” is derived from “IBUPROFEN” i.e., an international non-proprietary name and hence, cannot be registered. The mark of the Appellant closely resembles the aforesaid non-proprietary name. Hence, the Appellant cannot restrain the use of other marks on the basis of similarity with a few letters of its trademark.

² 2024 SCC OnLine Del 2707.



7.3 The packaging and the manner in which the marks “BRUFEN” and “MEBUFEN” are depicted, are distinctly different. It is apparent from the packaging and colour scheme that the said marks are not similar.

ANALYSIS

8. I have heard counsel for the parties and examined the material on record.

9. To appreciate rival submissions, it may be relevant to refer to some of the judgements of the Apex Court dealing with the issue of deceptive similarity between marks, in relation to medicinal products.

10. In *F. Hoffmann-LA Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd.*³, the Supreme Court was dealing with competing marks “DROPOVIT” and “PROTOVIT” in respect of medicinal products. While concluding that the aforesaid two marks are dissimilar and there was no reasonable possibility of confusion in the market, it was observed that there cannot be any meticulous comparison of the two words, nor can there be any ‘letter-by-letter and syllable-by-syllable’ comparison. It was held that there was no visual or phonetic similarity between the aforesaid marks, “DROPOVIT” and “PROTOVIT”.

11. The judgement in *F. Hoffmann-LA Roche* (supra), was discussed in *Cadila Health Care* (supra) where a three-judge Bench of the Supreme Court laid down guidelines for determining the question of deceptive similarity between competing marks. The relevant extracts from *Cadila Health Care* (supra) are set out below:

³ (1969) 2 SCC 716.



“35. Broadly stated, in an action for passing off on the basis of unregistered trademark general for deciding the question of deceptive similarity the following factors are to be considered:

- (a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.*
- (b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.*
- (c) The nature of the goods in respect of which they are used as trade marks.*
- (d) The similarity in the nature, character and performance of the goods of the rival traders.*
- (e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.*
- (f) The mode of purchasing the goods or placing orders for the goods.*
- (g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.”*

12. The legal position that emerges from areading of the aforesaid judgments, broadly, is that while determining the issue of competing marks, the marks are to be seen as a whole and not individual components/letters thereof. Further, the question of confusion has to be approached from the point of view of a man of *‘average intelligence and imperfect recollection’*. It is true that in cases where the competing marks concern medicinal products, the degree of scrutiny should be of a higher level considering the public interest involved. But, this cannot detract from the basic principles for determining deceptive similarity.

13. Applying the aforesaid principles to the facts of the present case, in my considered view, there is no structural or phonetical similarity between the rival marks “BRUFEN” and “MEBUFEN”. The dicta of **Hoffmann-LA Roche** (supra) is fully applicable in the present case. The marks “BRUFEN”



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and “MEBUFEN” are quite dissimilar and I cannot foresee any confusion being caused while pronouncing the said marks by a person of average intelligence or any possibility of confusion being caused in the market.

14. The rival marks have different prefixes *i.e.*, “BRU” and “MEBU”, which are strikingly dissimilar. The common suffix “FEN” used in both marks, is derived from the chemical element “IBUPROFEN” which is used in both medicines. Therefore, the petitioner cannot claim exclusivity over “FEN”. The Respondent No.2 has placed on record details of various medicinal products using “FEN” as a part of their name.

15. On behalf of the Appellant, reliance has been placed in the judgment of the Bombay High Court in its own case titled, ***Boots Company PLC, England and Anr. v. Registrar of Trade Marks, Mumbai and Anr.***⁴, where the two competing marks were “BRUFEN” and “CROFEN”. Holding that the aforesaid two marks are structurally and phonetically similar, the Bombay High Court quashed the registration of the mark “CROFEN”.

16. The Appellant has also placed reliance on the judgment of a Division Bench of this Court in ***Glenmark Pharmaceuticals*** (supra), wherein the Division Bench was dealing with the marks “INDAMET” and “ISTAMET”, in respect of medicinal products. The Division Bench held that the two marks have structural as well as phonetic similarity and therefore upheld the injunction order.

17. In my considered view, both the aforesaid judgments would not come to the aid of the Appellant since there is a clear element of structural and phonetic similarity between the competing marks that were the subject matter

⁴2002 SCC OnLine Bom 300.



of the aforesaid judgments, which is not discernible in the marks “BRUFEN” and “MEBUFEN” that are the subject matter of the present appeal.

18. In view of the discussion above, no grounds are made out for interference with the impugned order passed by the Registrar of Trademarks.

19. Consequently, the appeal is dismissed.

**AMIT BANSAL
(JUDGE)**

OCTOBER 22, 2024
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