

IN THE HIGH COURT AT CALCUTTA
ORIGINAL SIDE
(Intellectual Property Rights Division)

BEFORE:

The Hon'ble Justice Ravi Krishan Kapur

IPDATM/5/2024

DANONE ASIA PACIFIC HOLDINGS PTE. LTD.
VS
SYED JAWED MOHSIN & ANOTHER

For the petitioner : Mr. Soumya Ray Chowdhury, Adv.
Ms. Susrea Mitra, Adv.
Mr. Riyanshu Agarwal, Adv.
Ms. Bhawna Tekriwal, Adv.

For the respondents : Mr. Shuvasish Sengupta, Adv.
Mr. Balarko Sen, Adv.
Mr. SK. Abumusa, Adv.
Mr. Sariful Haque, Adv.

Hearing on : 24.09.2025

Judgment on : 24.09.2025

Ravi Krishan Kapur, J.:

1. This is an application for rectification and cancellation of the mark "PROTIFIX" bearing trademark no. 3592264 granted in Class 5 and for consequential reliefs.
2. Briefly, the petitioner is part of the Danone Group of Companies which had commenced business operations as far as back as in 1896. The mark PROTINEX has been commercially used in India since 1957 by the petitioner and their predecessor-in-interest. Originally, the trademark was registered by one Dumex Private Limited and later acquired by Pfizer Group in 1972. Thereafter, in or about 2006, the Wockhardt Group of Companies acquired the mark and the same came to be associated with

the Wockhardt EU Operation (Swiss) AG. Subsequently, the Danone Group of Companies acquired the nutrition business and product portfolio from the Wockhardt Group by executing a deed of assignment in favour of the petitioner transferring all its intellectual properties, goodwill and ancillary rights in the various marks including their mark PROTINEX alongwith the related trade dress in favour of the petitioner.

3. In or about the end of September, 2024 the petitioner came across the impugned product PROTIFIX while conducting searches across the website of Alvo Life Science's. On conducting further enquiries, the petitioner came to learn of a deceptively similar product PROTIFIX being listed on different online e-commerce platforms. Further searches were conducted in or about early October, 2024 when the petitioner came to learn of the impugned mark PROTIFIX being manufactured at the premises of M/s. Zyrath Health Care Pvt. Ltd. bearing the impugned mark.
4. In this background, the instant rectification application has been filed on the grounds of non-user and that the leading and essential portions of the impugned mark are deceptively similar to the petitioner's registered trade mark and also bear a deceptively similar trade dress to the petitioner's product. In support of such contentions, the petitioner relies on a number of documents including marketing research reports, invoices, promotional material, online status journals, promotional invoices and registrations granted in favour of the petitioner.
5. On behalf of the respondent it is contended that there is no exclusivity which the petitioner can claim in the word "Proti". In support of such

contention, the respondent relies on a Supplementary Affidavit to suggest that the word “Proti” is being commonly used in the same category of goods by numerous manufactures. In any event, the colour scheme, colour combination, get up and lay out are all different from the product of the petitioner. In such circumstances, the petitioner is not entitled to any reliefs.

6. In or about December, 2024, the petitioner had also filed a suit against the infringing parties including the respondents herein pertaining to the impugned mark before the High Court at Delhi numbered as CS-(COMM)/1197/2024. Upon the filing of the suit, an interim order of restraint had been passed in respect of the impugned mark. In such suit, pleadings have also been filed by the respondent. By an order dated 7th May, 2025, the suit had been amicably resolved between the defendant nos. 1 to 7 and the petitioner. However, insofar as the respondent no. 8 to 10 are concerned (which include the respondent no. 1 herein), the suit is still pending and is being contested.
7. For convenience, the rival marks are set out as follows:

Petitioner’s Marks: PROTINEX



Respondent Marks: Protifix



8. On the basis of the admitted documents, the respondents have been unable to disclose proof of actual use of the impugned mark. Non-use of a mark undermines its purpose as an *indicia* of trade origin. None of the licenses or certification filed by the respondent no. 1 include the impugned mark PROTIFIX. The invoices relied on by the respondent no.1 do not demonstrate use of the impugned mark PROTIFIX by the respondent no.1.
9. The Supplementary Affidavit relied on by the respondents is also inconclusive and does not assist the case of the respondents. The particulars of the invoices relied on by the respondents all go to demonstrate that one Jay Bharat Pharmaceuticals and not the respondents have been purportedly selling the impugned product. Significantly, in the written statement filed by the respondents before the High Court at Delhi, there is an irreconcilable and inconsistent stand *vis-a-vis* Jay Bharat Pharmaceuticals and the respondents. There is no credible evidence of the respondents using the impugned mark. Use of a mark has to be genuine use in the relevant class of goods and services. Unless the non-use is explained by way of special circumstances, the mark is liable to be removed for non-use. This is the clear mandate of section 47 (1) (b) of the Act. [*Hardie Trading Ltd. v. Addisons Paint & Chemicals Ltd.*, (2003) 11 SCC 92].
10. On a comparison of the Affidavit-in-Opposition (affirmed by the respondent no. 1 in the present application) and the Written Statement subsequently filed by the respondent no. 1 before the High Court at Delhi, there are irreconcilable and inconsistent statements by the

respondent no.1 insofar as merits of the case are concerned. In particular, there are contradictions whereby the respondent no.1 alleges to have carried on business under the trade name “*Jai Bharat Pharmaceutical*”. There is also total suppression of the alleged arrangement with M/s. Jairath or any other third party. On the other hand, in the Affidavit-in-Opposition filed in this proceedings user has been claimed by the respondent no.1 through “*Jai Bharat Pharmaceutical*” of which the respondent no.1 is the proprietor whereas in the written statement filed before the High Court at Delhi, it is alleged that the respondent nos. 8 to 10 are lawful and bonafide users of the mark PROTIFIX and the same was independently conceptualized and adopted in good faith. The incorrect and misleading statements made by the respondent no.1 in the two proceedings demonstrate lack of *bonafides* and dishonesty of the respondent no. 1.

11. On a bare perusal of the two products, a consumer who is shown the two products side by side is likely be confused and mistaken by the essential features of the two products. A distinctive portion of the mark of the petitioner which is also its essential portion has been attempted to be deceptively adopted by the respondent. Trade dress must be seen in its entirety and not in isolation. The impugned mark is visually, structurally and phonetically similar to the product of the petitioner. On a comparison of the two products, though the word “Protifix” is prominently displayed on the packaging, the colour combination and the overall impression would tend to confuse and deceive consumers. There is an attempt of the respondents to usurp the reputation of a globally

established mark. The logo, the style and the category of goods, the colour combination of all go to indicate that the relevant section of the public dealing in such category of goods i.e. healthcare products are likely to be confused and deceived. In view of all these facts, the adoption and the use of the impugned mark “Protifix” is violative of the statutory provisions apart from being in bad faith and *malafide*. The continued existence of the impugned mark in the Register is bad in law and it is in public interest that the purity of the Register be maintained. Keeping in view that both the goods are in a similar category of goods i.e., protein supplements, it is also in public interest and to prevent consumer confusion so that market integrity be preserved. In such circumstances, the subsequent registration of the impugned mark is liable to be expunged under section 47(1) read with section 57(2) of the Act.

12. In addition, registration of the impugned mark would also be barred under section 29 (c) of the Trade Marks Act 1999. The impugned mark is phonetically similar and is bound to trigger confusion and deception. The misspelling of the word “PROTI” alongwith the last syllable ‘X’ and a deceptively similar trade dress is what has been slavishly adopted in bad faith by the respondent no.1. This becomes a source for confusion and deception. It is to be remembered that the ordinary purchaser is not gifted with the power and observation of Sherlock Holmes. [*Parle Products (P) Ltd. vs. J. P. and Co., Mysore (1972) 1 SCC 618*].
13. In such circumstances, all the above factors clearly point out that the adoption of the impugned mark is dishonest as is evident from the adoption of strikingly similar mark in a deceptively identical style for the

same category of goods. It is well settled that in considering the possibility of confusion arising between any two marks, the marks in their entirety have to be taken into consideration. [*Fedders Lloyd Corporation Ltd. & Anr. vs. Fedders Corporation & Anr.* ILR (2005) 1 Delhi 478]. To this extent, all the decisions cited on behalf of the respondents are distinguishable and inapposite.

14. In *Corn Products Refining Co. vs. Shangrila Food Products Ltd.* 1959 SCC

Online SC 11 it has been held as follows:

“15. Now it is a well recognised principle, that has to be taken into account in considering the possibility of confusion arising between any two trademarks, that, where those two marks contain a common element which is also contained in a number of other marks in use in the same market such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those features. This principle clearly requires that the marks comprising the common element shall be in fairly extensive use and, as I have mentioned, in use in the market in which the marks under consideration are being or will be used.

16. The series of marks containing the common element or elements therefore only assist the applicant when those marks are in extensive use in the market. The onus of proving such user is of course on the applicant, who wants to rely on those marks. Now in the present case the applicant, the respondent before us, led no evidence as to the user of marks with the common element. What had happened was that Deputy Registrar looked into his register and found there a large number of marks which had either 'Gluco' or 'Vita' as prefix or suffix in it. Now of course the presence of a mark in the register does not prove its user all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register. If any authority on this question is considered necessary, reference may be made to *Kerly* p. 507 and *Willesden Varnish Co. Ltd. v. Young & Marten Ltd.* [39 R.P.C. 285 p. 289]. It also appears that the appellant itself stated in one of the affidavits used on its behalf that there were biscuits in the market bearing the marks 'Glucose Biscuits', 'Gluco biscuits' and 'Glucoa Lactine biscuits'. But these marks do not help the respondent in the present case. They are ordinary dictionary words in which no one has any right. They are really not marks with a common element or elements. We, therefore, think that the learned appellate Judges were in error in deciding in favour of the respondent basing themselves on the series marks, having 'Gluco' or 'Vita' as a prefix or a suffix.

17. We have already said that in our view the mark 'Glucovita' has acquired a reputation among the general buying public. The first question that then arises is whether the marks 'Glucovita' and 'Gluvita' are so similar as to be likely to cause confusion to the buying public or deceive them. On this matter, we have not the advantage of the view of the learned appellate Judges of the High Court. They did not express any view on this aspect of the question at all. We are however

inclined to think that their answer to the question would have been in the affirmative. However that may be, the Deputy Registrar felt that the words were not so similar as to be likely to give rise to confusion or to cause deception. He felt that the syllable 'co' in the appellant's mark was an emphatic characteristic and was not likely to be slurred over. He apparently felt that this syllable would prevent any confusion arising between the two marks or any person being deceived by the use of them both. He thought that the test down in what is called the "Ovax" case (In re : an application by Smith Hayden and Co. Ltd. [63 R.P.C. 97], should be applied and that the emphatic characteristic of the second syllable in the mark 'Glucovita' should decide that there was no likelihood of confusion arising. Desai, J., thought that the Deputy Registrar was wrong."

15. In *Amritdhara Pharmacy v. Satya Deo Gupta* AIR 1963 SC 449, it has been held as follows:

*6. It will be noticed that the words used in the sections and relevant for our purpose are "likely to deceive or cause confusion". The Act does not lay down any criteria for determining what is likely to deceive or cause confusion. Therefore, every case must depend on its own particular facts, and the value of authorities lies not so much in the actual decision as in the tests applied for determining what is likely to deceive or cause confusion. On an application to register, the Registrar or an opponent may object that the trade mark is not registrable by reason of clause (a) of Section 8, or sub-section (I) of Section 10, as in this case. In such a case the onus is on the applicant to satisfy the Registrar that the trade mark applied for is not likely to deceive or cause confusion. In cases in which the tribunal considers that there is doubt as to whether deception is likely, the application should be refused. A trade mark is likely to deceive or cause confusion by its resemblance to another already on the Register if it is likely to do so in the course of its legitimate use in a market where the two marks are assumed to be in use by traders in that market. In considering the matter, all the circumstances of the case must be considered. As was observed by Parker, J., in *Pianotist Co Application* [(1906) 23 RPC 774] which was also a case of the comparison of two words.*

"You must take the two words. You must judge them, both by their look and by their sound. You consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks." (p. 777)

For deceptive resemblance two important questions are : (1) who are the persons whom the resemblance must be likely to deceive or confuse, and (2) what rules of comparison are to be adopted in judging whether such resemblance exists. As to confusion, it is perhaps an appropriate description of the state of mind of a customer who, on seeing a mark thinks that it differs from the mark on goods which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection. (See Kerly on Trade Marks, 8th Edition, p. 400.)

16. In view of the above and the documentary evidence relied on by the petitioner, the petitioner has been able to disclose sufficient grounds *inter alia* under section 47 and section 57 of the Act justifying cancellation of the impugned mark.

17. In such circumstances, the petitioner is entitled to following directions:

- a. The registration granted in favour of the respondent no. 1 in respect of the impugned mark bearing application no. 3592264 be cancelled and set aside.
- b. The entry made in relation to the mark PROTIFIX being Trade Mark No. 3592264 in Class 5 be rectified/cancelled/removed/expunged from the Register of Trade Marks.

18. With the above directions, IPDATM 5 of 2024 stands allowed.

(RAVI KRISHAN KAPUR, J.)

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