

ANTI-DISSECTION VS AVERAGE INTELLIGENCE OF CONSUMERS: WHICH DOCTRINE PREVAILS IN A PHARMACEUTICAL CASE?

INTRODUCTION

One of the most common arguments by any legal professional in a Reply to the Examination Report or a Hearing in front of the Hon'ble Trade Marks Registry is the "anti-dissection rule" vis-à-vis section 15 and 17 of the Trade Marks act, 1999 (*hereinafter referred to as "the said act"*). This rule makes it clear that the differences or similarities between two trademarks must be analysed as a whole and not dissected into individual parts. However, in a pharmaceutical case, several judicial pronouncements have made it clear that every trademark proprietor has an additional responsibility of ensuring no confusion and deception in the minds of the consumer with average intelligence and imperfect recollection. This implies that the degree of scrutiny in determining the registration of a mark must be higher which subsequently requires a meticulous comparison between both the marks. As both rules seem antithetical to each other, clarity is required about the practical applicability of the same. In a recent case of M/S Abbott GMBH vs Registrar of Trademarks & Anr.¹, the Hon'ble Delhi High Court (*hereinafter referred to as "the court"*) has offered fascinating insights on this matter which deserve a thorough analysis.

BRIEF BACKGROUND OF THE CASE

The Appellant, M/S Abbot GMBH, is a global healthcare company which aims to help people through life-changing scientific and medical devices and technologies. In the purpose of business development, they trademarked the word "BRUFEN" (*hereinafter referred to as "said mark"*) for "*pharmaceutical products including analgesics, anti-inflammatory, anti-arthritic, and cold and flu products*". The Appellant claimed that the said trademark has been

¹ M/S Abbott GMBH vs Registrar of Trademarks & Anr., C.A. (COMM.IPD-TM) 9/2023.

registered in India and has been used continuously and extensively since 1973.

The Respondent, M/s Meridian Medicare Limited, is an Indian pharmaceutical conglomerate which is in the business of manufacturing and quality assurance. They filed for registration of the mark “MEBUFEN” (*hereinafter referred to as “**impugned mark**”*) for “*Medicinal and Pharmaceutical Preparations.*” They claimed use of the impugned mark since 1988.

The conflict arose when the impugned mark was advertised before acceptance by the Registrar of Trademarks under section 20(1) of the said act on July 1, 2006. The Appellant had filed a notice of opposition against the same on December 7, 2006. However, the Registrar refused the opposition and granted registration of the impugned mark. Aggrieved, the Appellant sought justice in the present case.

SUBMISSIONS OF BOTH PARTIES

The Appellant accused the Registrar of misapplying the ratio of Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.² While this case held that competing marks must be considered as a whole, the Registrar had proceeded with a meticulous comparison of the word marks in a 'letter-by-letter and syllable-by-syllable' manner. They argued that just adding the prefix “ME” to the word “BRUFEN” is not enough to prove distinctiveness. Moreover, they placed reliance on the case of Glenmark Pharmaceuticals Ltd. v. Sun Pharma Laboratories Ltd³ which elaborated on the famous doctrine of average intelligence and imperfect recollection.

The Respondent argued that the words "BRUFEN" and "MEBUFEN" are structurally, visually and phonetically different from each other and the suffix “FEN” is found in around 5,101 other trademarks. Furthermore, they argued that as the word “FEN” is derived from the international non-proprietary name

² Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., AIR 2001 SUPREME COURT 1952.

³ Glenmark Pharmaceuticals Ltd. v. Sun Pharma Laboratories Ltd, 2023 SCC OnLine Del 3786.

of “IBUPROFEN”, the Appellant has no authority to restrict the registration of the impugned mark. They also relied on a different packaging and colour scheme of their impugned mark.

THE JUDGEMENT

By referring to the case of F. Hoffmann-LA Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd.⁴, the Court ruled in favour of the Respondent and dismissed the appeal of the Appellant. The court made it evident that the judgements cited by the Appellant are not enough to secure a verdict in their favour since a clear element of structural and phonetic similarity between the competing marks is wanting in the present case. Thus, the court held that the said mark and the impugned mark are distinct and different enough to not cause any confusion and deception in the minds of the consumer with average intelligence and imperfect recollection. The court held that high level of scrutiny needed in medicinal products does not detract from the guidelines of determining deceptive similarity as laid down in the Cadila case. These guidelines are as follows:

“(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 trademarks.

(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.

⁴ F. Hoffmann-LA Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd., 1970 AIR 2062

(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.”

The court ultimately reaffirmed the assertions of the Respondent regarding the commonality of the suffix “FEN” in other trademarks.

PERSONAL OPINIONS: A LEGAL ENIGMA?

Plentiful discourse is made in this case about the supposed mind of the consumer. The court has admitted that he/she will have average intelligence and imperfect recollection when trying to determine the differences between any two trademarks and purchase a product in the market. Consequently, if the common man is actually assumed to be so unwise, then does logic not dictate that he might look at the aurally similar words "BRUFEN" and "MEBUFEN" and assume it to be originated from the same trader at a first glance? Even if the Cadila guidelines are given due consideration, it is understood that both parties have applied for registration of their respective trademarks in the same class, in similar/cognate type of goods, have been derived from the same international non-proprietary name of IBUPROFEN, and are available for sale in the same market, i.e. pharmacies, medical clinics, hospitals, etc. Thus, the order of the court seems to be perplexing in nature.

Moreover, in the recent case of Zydus Healthcare Limited & Ors. vs Alder Biochem Private Limited on 13 November, 2024⁵, the Hon'ble Delhi High Court itself has ruled in favour of the Plaintiff and stated that the Defendant copied the dominant feature of the Plaintiff's mark “BIOCHEM” to create the impugned mark of “ALDER BIOCHEM”. It was held that *“The overall similarity between the two marks in respect of the same description of goods is likely to cause confusion. Adding of a prefix by the defendant is immaterial, and does not deter from the fact that the impugned mark of the defendant is deceptively similar to the mark of the plaintiff.* Moreover, the Hon'ble Court had

⁵ Zydus Healthcare Limited & Ors. vs Alder Biochem Private Limited on 13 November, 2024, CS(COMM) 516/2023, I.A. 14145/2023 & I.A. 3116/2024

emphasised the importance of stringency in the registrations of pharmaceutical trademark by opining that “*Law is settled that confusion between medical products is life threatening, not merely inconvenient.*”

CONCLUSION

Though the court’s judgement leaves some questions unanswered, it nevertheless lays the foundation of a thought-provoking debate between legal contemporaries regarding the responsibilities of a trademark proprietor in a pharmaceutical case. By ruling in favour of the Respondents, the court has made it clear that the anti-dissection rule is not impenetrable in its use. It cannot be blindly utilised by any party in any case without having due consideration to its actual facts and circumstances. However, the verdict of the same Hon’ble court in the latest case of Zydus Healthcare Limited & Ors. vs Alder Biochem Private seems surprisingly inconsistent to the verdict of the present case. Thus, further judgements of the Hon’ble Court which provide ample clarity on this subject matter are the need of the hour. Perhaps, the Hon’ble Supreme Court can swiftly come to the rescue and decipher this conundrum in a conclusive manner.

ABOUT THE AUTHOR



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