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PROTECTION AGAINST INFRINGEMENT OF TRADE MARK-APPEAL BEFORE THE DIVISIONAL BENCH OF THE SINDH HIGH COURT

Appellant: NOVARTIS AG through Authorized Signatory

Respondent: NABIQASIM INDUSTRIES (PRIVATE) LIMITED through Chief Executive/Director/Company Secretary and another

Decision: Appeal Allowed

In this case, the decision of a Single Bench of the Sindh High Court dismissed an application for grant of injunction from **NOVARTIS AG (the Appellant)** against **NABIQASIM INDUSTRIES (PRIVATE) LIMITED through Chief Executive/Director/Company Secretary and others (the Respondents)**. It was held that the trade mark was to be seen with complete getup, colour scheme, design and printing. The Appellant's claims were only related to the phonetic similarity between the two trademarks and not the whole word, design or getup. Deceptive similarity did not exist between the two trademarks when seen as a whole. Pharmaceutical products were not ordinary goods which a person could point out at a shop and buy at his choice. Against the decision of the Single Bench the Appellant preferred an appeal before a Divisional Bench of the Sindh High Court, which allowed the Appeal and set aside the impugned order of the Single Bench.

In the appeal the Appellant argued that it was the global owner and registrant of trade mark "LESCOL" in relation to pharmaceuticals and in Pakistan the said mark was registered in Class 5 w.e.f. 19.02.1991. The Appellant had been using the trade mark in Pakistan since 1995 after having it registered with the Drug authorities in relation to generic compound Fluvastatin, which contained medicaments for the treatment hypercholesterolemia. To the contrary, the Respondents claimed they adopted the trade mark DESCOL independently and had it registered with the Drug authorities in 2007 but did not register it in the Trade Marks Registry as they were in the early stages of developing their brand.

After reviewing the learned Single Judge's impugned order, the Bench observed that the learned Single Judge recognized that both the trade marks were used in relation to pharmaceutical and medicinal products. Furthermore, the learned Single Judge applied the totality of impression test while, physically examining the two packaging, which undoubtedly were distinctive as to their shape, colour and size. The learned Single Judge in fact also took into consideration that since both the products were prescription medicines, where Pharmacists only sell them upon examination of a doctor's prescription there was very little likelihood that people would be deceived, since pharmacists had special knowledge and eye in this regard. In the later part of the impugned order, the learned Single Judge admitted that while both the marks were phonetically similar, however, both had different prefixes. Placing reliance on reported cases, the learned Single Judge reached to the conclusion that there was very little likelihood of the buyer being misguided or confused on account of phonetic similarities between LESCOL and DESCOL.

While distinguishing the cases relied upon by the learned Single Judge, the Bench made reference to a reported case which stated "that in our country since no such precautions are taken and use of wrong drug could be fatal and in



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particular when usually prescriptions are hand written and illegible, therefore, the possibility of mistaking the one (deceptively similar) medicine from another cannot be excluded". The said judgment placed particular emphasis in the case of pharmaceutical products, where public must be protected from the possibility of confusion and tilted the due diligence balance from pharmacists to unwary purchasers and held that those were the ultimate purchasers who had to be taken into consideration and who were likely to be misled by imperfect recollection of the mark, and not to the so called expert chemists.

In its judgment the Bench observed that the two medicines were used for treatment of different ailments and their generic names were also different, therefore a small mistake could be fatal for the user of the medicine(s) and thus no possibility of deception could be allowed. It further observed, that while, public health concerns (drug name mistakes) were not strictly relevant to the issue of trade mark registration, however the same may be seriously considered when assessing the issue of confusion between names of drugs. When a new entrant in the drug market place adopts an already existing distinctive and established trade mark, a query needs to be made as to why the latter entrant had chosen a trade mark deceptively similar with the one that had existed long before. Consequently, the Bench while allowing the Appeal set aside impugned order of Trial Court and restored the grant of interim relief in favour of plaintiff.

