

International Update

INDIA

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In a recent decision, GlaxoSmithKline Pharmaceuticals Ltd. v Horizon Bioceuticals Pvt. Ltd. & Anr, the High Court of Delhi had the opportunity to adjudicate upon the interpretation of Section 17(2)(b) of the Indian Trade Marks Act, 1999 (the Act). This section states that: 'any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered'.

The plaintiff (GlaxoSmithKline) is the registered proprietor of the trade mark COBADEX in respect of pharmaceutical goods in Class 5 since 18 July 1958 and alleged that the defendant's (Horizon Bioceuticals) use of the mark COMODEX amounted to trade mark infringement. The defendant argued that the suffix 'DEX' in relation to pharmaceutical products was publici juris and per Section 17(2)(b) of the Act, 'when a trade mark contains any matter which is common to the trade ... the registration shall not confer any exclusive right'. To strengthen this argument, the defendant relied upon several registered trade marks in respect of pharmaceutical preparations that contained the suffix 'DEX' and co-existed on the Trade Marks Register.

Per the court, most brand names/marks in respect of pharmaceutical products are adopted in the following manner:

- use of 'part of the name of the active ingredient' in a pharmaceutical product; or
- use of 'part of the ailment or name of the organ' that the pharmaceutical product intends to cure/heal.

In the extant matter, the suffix DEX was found to be used by several registered

proprietors for products which contained the active ingredient either 'dextromethorphan' or 'dexamethasone'. However, the court observed that there was insufficient evidence to hold that the 'DEX' suffix was 'common to the trade' for drugs that did not contain these active ingredients, (a category into which both the plaintiff's and defendant's products fell).

In interpreting the article 'the' forming part of Section 17(2)(b) of the Act i.e., 'common to the trade', the Court held that there is a significant difference between the said expression and the expression 'common to the register'. Marks that stand registered in the Register of Trade Marks may never see the market, or may, at best, make sporadic appearances. The Court reasoned that 'the trade' refers to actual flow of goods in the market. Thus, it was necessary for the defendant to establish that in 'the market' relating to such pharmaceutical goods, the use of the suffix DEX was common.

Noting that use of DEX by the plaintiff was arbitrary, the Court *vide* order dated 10 April 2023, prima facie held that the defendant's mark COMODEX infringes the plaintiff's registered mark COBADEX as the said marks are structurally and phonetically similar and were being used for essentially the same products – multivitamins. Also, public interest and the possibility of hazardous consequences directed by the fact that one product was a prescription drug (plaintiff's product) and the other an over-the-counter drug (defendant's product), should not be permitted to dilute a finding of likelihood of confusion.

This detailed judgement where the court has carefully examined the nature of pharmaceutical trade mark disputes and the rationale behind adoption of pharma brand names is certain to serve as a valuable reference point for future disputes of similar nature.