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The conundrum of pharmaceutical trademarks: SOXPLAT held similar to OXIPLAT

Manisha Singh, Partner, and Smrita Sinha, Associate, of LexOrbis examine the deceptive similarities between two pharmaceutical trademarks in a recent case.

Two pharmaceutical companies, Sun Pharma Laboratories Limited ("Sun Pharma"), proprietor of the trademark "OXIPLAT" and Mylan Laboratories Ltd. ("Mylan"), proprietor of the trademark "SOXPLAT" had filed rectification petitions against each other's marks before the Intellectual Appellate Property Board ("IPAB"). These companies were at loggerheads before the Delhi High Court too where Sun Pharma had filed a suit against Mylan's mark SOXPLAT. In 2017, Sun Pharma had lost its interim injunction application against Mylan, when the Delhi High Court had *prima facie* declared that there was no similarity between the two marks. The year 2020, however, has turned out to be favorable for Sun Pharma, as in a recent decision the IPAB has turned the tables in its favour by passing an order to cancel Mylan's trademark, SOXPLAT. The conflicting marks OXIPLAT and SOXPLAT are related to the same active salt – OXALIPLATIN.

Background of proceedings before IPAB

Sun Pharma has claimed rights in OXIPLAT since 2001 and asserted that its mark has been extensively and continuously used in relation to its drug for colon/rectal cancer comprising the salt "OXALIPLATIN". These claims were supported by numbers and figures to showcase that it has acquired formidable goodwill and reputation in favour of this mark. In fact, it claimed to have made sales in excess of USD 2,250,000 million (approx.) in 2007; the same year Mylan's mark SOXPLAT was adopted.

Sun Pharma argued that Mylan's SOXPLAT was deceptively similar to its prior used and registered trademark and had been filed in respect of identical goods, which was contrary to the provisions of the Trade Marks Act. Therefore, use of such mark was likely to cause confusion and deception on account of imperfect recollection. It also asserted that, due to its prior registration, it had the exclusive rights



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to use the mark and that the use of any other deceptively similar mark by any unauthorized party would amount to infringement of the Act.

In contrast to this, Mylan's first strike was the expected reference to the civil suit where it had been the recipient of the favorable interim orders. It further justified the honest adoption of its mark **SOXPLAT** and claimed that it was derived from the first letter of its predecessor's name i.e. M/s **Strides** Arcolab Ltd. with an abbreviated version of the drug **OXALIPLATIN**.

Proceeding further, it challenged the distinctiveness of Sun Pharma's mark by arguing that no monopoly or exclusive rights could be granted to Sun Pharma's mark as it was a mere abbreviation of the salt – OXALIPLATIN. It contended that Sun Pharma's mark OXIPLAT was entirely derived from the active salt and as such, Sun Pharma had no right to exclusively use the same. It was Mylan's contention that adoption of a name of a generic drug/salt and invention of a trademark based on the name of a generic drug/salt were two different things and in the instant case, Sun Pharma had adopted the generic salt name as a trademark, which they cannot be allowed to do. This argument stems from the principle that one party cannot claim exclusive rights over the generic drug's name.

The second facet of Mylan's side revolved around the usage of abbreviation of the salt as part of a trademark by third parties. It argued that such usage of prefix OXI and suffix PLAT by third parties made the mark generic and *publici juris*.

The last leg of Mylan's arguments was based on the sale of these drugs and their administration. It argued that the products sold under the rival marks were sold only against doctor's prescription (Schedule H drug) and not as an over the counter medicine. Further, it stated that both the products were administered by highly skilled cancer therapists and refuted the applicability of likelihood of confusion or deception and the test of imperfect recollection of ordinary

consumers. It also stressed that customers would pay more attention to the uncommon feature of the mark if the common feature is descriptive and *publici juris*.

Observations

- Similarities between the marks

The IPAB had referred to the landmark case laws, *Cadila Health Care Limited Vs. Cadila Pharmaceuticals Ltd.* and *Corn Product Refining Company Vs. Shangrila Food Products Limited* for the assessment of similarity of marks.

As far as similarity of the two marks is concerned, the IPAB was of the view that there was a chance that vowel "I" in Sun Pharma's trademark may be slurred over and not have a prominent and distinguishing pronunciation. It also noted that it was evident that Mylan's mark had the whole of Sun Pharma's mark except the letter 'S'. The IPAB evaluated the effect of the consonant 'S' in Mylan's mark. The single letter 'S' was regarded as a "soft consonant" which was not sufficient to avert the likelihood of confusion on account of phonetic similarity as well as the considerable margin for imperfect pronunciation and recollection in a multilingual society like India. This was in contrast to the Delhi High Court's Single Judge's opinion who had cited the presence of 'I' and 'S' in the concerned marks as the distinctive factors which made the rival marks dissimilar. It is noteworthy that the IPAB did not consider the previous orders passed by Delhi High court as they were *prima facie* views.

- Distinctiveness of Sun Pharma's mark and non-exclusivity over generic drug

The IPAB observed that it was an admitted position that both the marks have been derived from the same salt, therefore, Mylan could not be allowed to claim that its mark is distinctive whereas that of Sun Pharma is non-distinctive. It further stated that the argument pertaining to the adoption of OXIPLAT from the drug OXALIPLATIN was misconceived and relied on the different prefixes "OXI" and "OXALI" as well as the suffixes "PLAT" and "PLATIN".

In IPAB's view, the real test to determine the descriptive nature of a pharmaceutical trade mark was to ask whether an ordinary man, or even a person dealing in the medical field, will be in a position to say that the mark is so composed unless he is so told. This reasoning was substantiated by the judgment of the Delhi High Court in *Win-Medicare v. Somacare Laboratories* (1997 PTC (17) 34).

The IPAB further emphasized that mere plea that a mark is common to trade, without any iota of supportive evidence was not sufficient to establish that the mark is common to trade.

- Evidence of usage of the marks

The IPAB pressed on the admitted position of subsequent adoption and use by Mylan. It also noted that while Sun Pharma's evidence was available on record from 2001, there was no cogent and clear evidence on record to corroborate Mylan's user claim of 2009, barring the pleadings.

- Similar marks used by third parties

IPAB opined that it was common practice in pharmaceutical cases to raise the defense of the existence of similar marks of third parties and common to the trade. It further commented

Résumés

Manisha Singh, Managing Partner

Manisha Singh is a founder and Managing Partner of LexOrbis. She overviews and supervises all practice groups at the firm. Starting her career at the time when Indian IP laws and practices were undergoing substantial changes pursuant to India's obligations to comply with the TRIPS agreement, Manisha played an important and crucial role in advising and apprising Indian policy and law makers on global standards associated with IP administrative and enforcement systems. Manisha is known and respected for her deep expertise on prosecution and enforcement of all forms of IP rights and for strategizing and managing global patents, trademarks, and designs portfolios of large global and domestic companies. Her keen interest in using and deploying latest technology tools and processes has immensely helped the firm to develop efficient IP service delivery models and to provide best-in-the-class services. She is also known for her sharp litigation and negotiation skills for both IP and non-IP litigations and dispute resolution. She represents the Reserve Bank of India, India's central banking institution before the High Court of Delhi and the Supreme Court of India in cases related to banking and non-banking financial companies in addition to a large number of intellectual property litigations with a focus on patent litigations covering all technical fields – particularly pharmaceuticals, telecommunications and mechanics. She has been involved and successfully resolved various trademarks, copyright and design infringement and passing off cases in shortest possible time and in the most cost-efficient manner applying out-of-box strategies and thinking.

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Smrita is an advocate, enrolled with the Bar Council of Delhi since 2019 and has graduated from Amity Law School Delhi, GGSIPU. She has also completed online courses pertaining to Intellectual Property Rights from the Indian Law Institute and World Intellectual Property Office. As part of her course curriculum in law school, she has interned with law firms, companies as well as the Information Commissioner, Central Information Commission and has worked on diverse areas of law including arbitration, competition law, consumer affairs, contract law, intellectual property laws, and right to information. She has participated in various co-curricular activities such as moot court competitions, paper presentations, ADR competitions. At LexOrbis, she has been involved in various matters related to copyright, trademark, and design laws and hopes to create an identity for herself in the media and entertainment sector.

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“The single letter ‘S’ was regarded as a “soft consonant” which was not sufficient to avert the likelihood of confusion.”

on the practice of modifying letters here or there from the name of the salt or ailments. It also noted that Mylan had failed to establish user of any of the third parties. The IPAB observed that the issues arising from such practices have been considered time and again by various courts and in most cases the courts had held that the rival marks should be compared as a whole.

Ruling

The IPAB extensively referred to various judgments and principles surrounding the determination of similarity between marks. It opined that all the decisions referred on behalf of Mylan were distinguishable as per their facts and the valent decisions rendered by the Supreme Court and High Court post *Cadila* case. It also stated that Mylan had failed to make out any case on merit in its favour.

The IPAB held that Sun Pharma's mark OXIPLAT was a coined word, which is registrable, thereby dismissing Mylan's arguments of non-distinctiveness. Considering the myriad of observations and principles, IPAB pronounced the order in Sun Pharma's favour, stating that the rival marks, when compared as a whole, were similar. The IPAB also considered prior adoption and use of Sun Pharma's marks.

Accordingly, it directed removal of Mylan's mark stating that its entry offends the provisions of Sections 11, 18, 32, and 57 of the Act. Therefore, it found that Mylan's mark was deceptively similar and also dismissed its rectification petition. Per the IPAB, Mylan's petition was false and frivolous and merely a counter blast.

The catch here is that two adjudicatory authorities have passed conflicting orders on the same set of marks, where the presence of two letters has been one of the determining factors in both cases. While the Delhi High court's *prima facie* view on dissimilarity favored Mylan, the IPAB compared the marks as a whole and held them to be similar and rolled the ball in Sun Pharma's court. Two pharmaceutical giants and their fight over a drug's name is a familiar dispute in the trademark arena. At this juncture, time will tell which mark has won the battle.

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