



* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% **Reserved on: April 24, 2025**
Pronounced on: May 14, 2025

+ **C.A.(COMM.IPD-TM) 2/2024, I.A. 271/2024-Stay**

MANKIND PHARMA LIMITED

.....Appellant

Through: Mr. Hemant Daswani, Ms. Saumya
Bajpai, Advs.

Versus

**ZHEJIANG YIGE ENTERPRISE MANAGEMENT GROUP CO.
LTD. & ANR.**

.....Respondents

Through: Mr. Amit Tiwari, Advocate with Mr.
Vikram Singh Dalal, Mr. Yashpriya
Sahran and Mr. Pratham Chawla,
Advocates.

CORAM:

HON'BLE MR. JUSTICE SAURABH BANERJEE

J U D G M E N T

PREFACE:

1. The appellant, has preferred the present appeal under Section 91 of the Trade Marks Act, 1999¹ assailing the order dated 29.05.2023², passed by the learned Deputy Registrar of Trade Marks³, whereby its opposition

¹ hereinafter referred to as "*TM Act*"

² hereinafter referred to as "*impugned order*"

³ hereinafter referred to as "*respondent no.2*"



花西子

proceedings against the registration of the impugned mark Florasis⁴ filed under application no.4330041 in *Class 5* has been dismissed.

BRIEF CONSPECTUS:

2. The appellant, Mankind Pharma Limited, a fully integrated pharmaceutical company involved in the business of manufacturing and marketing of a wide range of medicinal, pharmaceutical, veterinary preparations as also therapeutic product ranges under various brand names, including under the trademark ‘FLORA’, coined in the year 1995.

3. For carrying on with its business activities, the appellant has in the year 2007, under application being no.1554350, been granted registration for the trademark ‘FLORA’ in India under *Class 5* with a user claim since 1995 in respect of pharmaceutical preparations for the treatment of ‘diarrhea’ and related health products. In fact, the appellant has been continuously and uninterruptedly using the trademark ‘FLORA’ for medicinal and pharmaceutical preparations since its adoption for the first time in the year 1995.

4. In contrast, the respondent no.1 has on 21.08.2019 under application no.4330041⁵ applied for the mark ‘FLORASIS’ with respect to sanitary towels, anti-overflow, breast pads, baby napkins, sanitary pads, baby’s diapers in *Class 5* on a ‘*proposed to be used*’ basis.

⁴ hereinafter referred to as “**FLORASIS**”

⁵ hereinafter referred to as “**impugned application**”



5. Subsequent thereto, the appellant on 19.03.2020 filed its opposition proceedings being no.2477318 contesting the registration of the respondent no.1's mark on the grounds of deceptive similarity, lack of *bona fide* adoption and likelihood of causing confusion among the public, to which the respondent no.1 filed its counter statement on 08.06.2020. Thereafter, the appellant filed its evidence along with supporting documents under *Rule 45* of the Trade Mark Rules, 2017⁶ on 29.06.2020 and the respondent no.1 filed its evidence under *Rule 46* of the Rules on 07.09.2020.

6. *Vide* the impugned order, the said opposition proceedings was rejected by the respondent no.2 *inter alia* holding that even by stricter measures the registered trademark 'FLORA' of the appellant herein is visually, phonetically or structurally different from the impugned mark 'FLORASIS' of the respondent no.1 and the combination of mandarin characters with a unique device of 'FLORASIS' gives the impugned mark a unique impression, depiction and recollection in the Indian context as also that the application of the respondent no.1 is honest and *bona fide* as the impugned mark is already registered in various countries. As such, the impugned mark 'FLORASIS' was allowed to proceed for registration.

7. Aggrieved thereby, the appellant by way of the present appeal, prayed for setting aside of the impugned order.

8. The respondent no.1, despite service, has never entered appearance in the present proceedings and the respondent no.2, despite entering appearance, has not filed its reply either. As such, *vide* order dated 24.04.2025 passed by

⁶ hereinafter referred to as "*the Rules*"



this Court, the respondent no.1 was proceeded *ex-parte* and its right to file a reply was also closed.

SUBMISSIONS OF THE APPELLANT:

9. Mr. Hemant Daswani, learned counsel for the appellant made the following submissions:-

9.1. The impugned order suffers from manifest legal infirmities, as it overlooks the established principles of law relating to prior statutory right, likelihood of confusion and the need for exercising higher caution in trademarks/ products relating to the pharmaceutical and healthcare industry.

9.2. The appellant's trademark 'FLORA' is a coined and inherently distinctive word with more than two decades of continuous and prior use in the Indian market. Moreover, the respondent no.2 has failed to appreciate that the registration application of the impugned mark 'FLORASIS' was filed on 21.08.2019 on a '*proposed to be used*' basis, when clearly the appellant has been using its trademark 'FLORA' since 1995 and is the prior and registered proprietor since the year 2007.

9.3. The respondent no.2 has erroneously held the impugned mark 'FLORASIS' to be unique, distinctive and not likely to cause confusion merely because the said mark is accompanied with a mandarin character and fails to appreciate that the entire trademark 'FLORA' of the appellant has been incorporated in and is the dominant and distinctive component of the respondent no.1's mark and merely addition of a suffix 'SIS' and a mandarin character does not materially distinguish the said impugned mark from that of the appellant.



9.4. The respondent no.2 failed to consider that the impugned mark 'FLORASIS' by virtue of being visually, phonetically and structurally similar to the appellant's registered trademark 'FLORA' is liable to be refused/rejected since it is likely to hint to the average consumer with imperfect recollection that the impugned mark is nothing but an extension of the appellant's brand especially when the registration of the impugned mark has also been applied for under Class 5, the same Class under which the appellant holds registration thus, increasing the risk of confusion.

9.5. Although the goods of the parties are not identical, however, the products of the respondent no.1 are sold across the same counters and through the same channels of trade as that of the appellant, grant of registration by the respondent no.2 creates a likelihood of confusion between the registered trademark 'FLORA' and the impugned mark 'FLORASIS'.

9.6. The respondent no.2 has failed to appreciate the established principles of law relating to medical jurisprudence wherein, the Courts have repeatedly held that a comparison of trademarks/ products involving pharmaceutical preparations needs to be stricter. To substantiate his argument, he relied upon the judgement passed in *Cadila Health Care Limited Vs Cadila Pharmaceuticals*⁷.

9.7. The respondent no.2 has failed to appreciate the fact that since the impugned mark 'FLORASIS' is not a well-known trademark within the meaning of the Act, the respondent no.1 cannot be entitled to seek benefit of usage of the same, prior to the date of application. The respondent no.1

⁷ (2001) 5 SCC 73



claims entitlement to a registration based on international adoption of the said word since 2017, however, merely having an international registration or usage outside India, does not confer superior rights over a party who is not only the prior adopter and a prior user but also a registered proprietor in India.

9.8. It is a settled position of law that where the ‘word’ has an independent element and distinctive role, the dominant feature of a composite mark is to be considered, especially since the customers in India relating to pharmaceutical and health-related sectors, rely on the word component of the mark for identification of a particular product and often ignore stylization or foreign scripts, which they cannot read or interpret.

9.9. Foreign script, the mandarin character in the present matter, has no phonetic or visual relevance and does not create a distinguishing factor in the minds of the Indian customers, as the Indian customers are not literate in the said script. The Courts have, time and again, held that device elements or foreign character do not absolve the similarity of the ‘word’, especially, where the phonetic, visual and structural similarity thereof is high.

9.10. The mark of the respondent no.1 is liable to be refused under *Section 11(1)(a) and 11(1)(b)* of the TM Act as the impugned mark ‘FLORASIS’ is identical to/ deceptively similarity to an earlier registered trademark ‘FLORA’ of the appellant.



9.11. In support of the aforesaid contentions, reliance upon *Mankind Pharma Limited vs. Pharmaxia Health Care*⁸; *Subhash Chand Bansal vs. Khadim's & Anr.*⁹; *Indchemie Health Specialities Pvt. Ltd., Mumbai vs. Naxpar Labs Pvt. Ltd. & Ors.*¹⁰; *Bata India Limited vs. Chawla Boot House & Anr.*¹¹; *Toyota Jidosha Kabushiki Kaisha vs. M/s. Prius Auto Industries Limited*¹²; *Cadila Healthcare Limited vs. Cadila Pharmaceuticals Ltd.*¹³; *Milmet Oftho Industries & Ors. vs. Allegran Inc.*¹⁴ and *Novartis AG vs. Crest Pharma Pvt. Ltd.*¹⁵ was placed.

ANALYSIS & FINDINGS:

10. This Court has heard the learned counsel for the appellant and has also gone through the documents on record, along with the relevant judgments on the issues cited therewith.

11. As is borne out from the records, none of the respondents, particularly the respondent no.1, despite being duly served, have filed any response to the contentions raised by the appellant in the present appeal, as such, there being no specific or even general denial of any of the pleadings made by the appellant, therefore, under such circumstances, all the aforesaid averments made therein, without any response/ denials thereto, are deemed to be admitted and true.

⁸ CS(COMM) 713 /2023

⁹ CS(OS) 2392/2006

¹⁰ MANU/MH/0164/2002

¹¹ 2019 SCC OnLine Del 8147

¹² (2018) 2 SCC 1

¹³ (2001) 5 SCC 73

¹⁴ (2004) 12 SCC 624

¹⁵ (2009) SCC OnLine Del 4390



12. Considering the rival marks on hand, there can hardly be any doubt in the minds of the general public as also the customer base, that the impugned mark 'FLORASIS' is not identically and deceptively similar to that of the registered trademark 'FLORA' of the appellant herein. Since there is a high degree of resemblance between them, it is likely that the common people start believing that there exists some semblance of a relation/ connection *inter se* both the impugned mark 'FLORASIS' of the respondent no.1 and the registered trademark 'FLORA' of the appellant, when actually there is none.

13. Moreover, a close comparison of the two marks leads to the conclusion that there are hardly any visible differences and/ or change noticeable to the naked eye of any average person with imperfect recollection belonging to the trade and/ or to the general public. In fact, the impugned mark 'FLORASIS' of the respondent no.1 is visually, structurally and phonetically similar to the appellant's registered trademark 'FLORA' and is likely to be perceived as yet another variant emanating from the appellant and to be falsely associated with the mark(s) of the appellant.

14. Thus, allowing the said impugned mark 'FLORASIS' of the respondent no.1 to subsist under those circumstances, in all likelihood will amount to creating confusion, suspicion and deception in the minds of one and all as they will, thereafter, be available in the Indian market. More so, since the registered trademark 'FLORA' of the appellant is already very much in existence in the Indian market since long whereas the impugned mark 'FLORASIS' of the respondent no.1 is yet to be launched and has not seen the light of the day.



15. The fact that the respondent no.1 has only applied for registration under application no.4330041 in *Class 5* in India only on 21.08.2019, i.e. much later than the appellant herein, and that too on a '*proposed to be used*' basis, admittedly establishes, without doubt, that the appellant herein is not only the prior adopter, prior and continuous user of the registered trademark 'FLORA' but also the registered proprietor thereof. In view thereof, the appellant has already acquired substantial goodwill and reputation in the registered trademark 'FLORA' in India. Further, since the appellant herein is the registered proprietor of the trademark 'FLORA', it has a better right to seek protection in and to the same against third parties like the respondent no.1 as it is entitled for statutory protection and exclusivity in terms of *Section 28* of the TM Act.

16. Thus, this Court has to carefully take note of the parameters under which the impugned mark is being adopted/ chosen by the respondent no.1, which, under the given scenario as above, weighs in favour of the appellant herein and against the respondent no.1 as it is very closely similar to that of the registered trademark 'FLORA' of the appellant herein, and also since the impugned mark 'FLORASIS' of the respondent no.1 has been applied on a '*proposed to be used*' basis for a pharmaceutical product and the registered trademark 'FLORA' of the appellant is also being already used for a pharmaceutical product. Therefore, all/ any kind of creating confusion, suspicion and deception in the minds of the common people has to be avoided with utmost care and caution as the same could be severely detrimental to the public health and welfare.



17. Though the respondent no.2 has recorded that the intentions of the respondent no.1 are *bona fide* as the said mark 'FLORASIS' is registered in various countries, however, in the considerable opinion of this Court under the peculiar facts and circumstances involved herein, simpliciter registration of a mark in another jurisdiction does not entitle a person/ entity for registration of the same in India. Hence, the respondent no.2 has wrongly given the benefit of registration in other countries to the respondent no.1.

18. Furthermore, in India merely adding a mandarin character cannot add any distinctiveness thereto for being granted registration, and that too qua a pharmaceutical product, especially, when the said character cannot be deciphered by the general public and/ or the members of trade.

19. The adoption of the impugned mark 'FLORASIS' by the respondent no.1 by merely adding the suffix 'SIS' to the already registered trademark 'FLORA', which is the dominant/ distinguishing feature thereof is itself, under the existing circumstances, not sufficient.

20. Further, the registered trademark 'FLORA' of the appellant is unique and fanciful with respect to *Class 5* for pharmaceutical product as it has no connection with the product it is being used for. The respondent no.1 has also sought registration under the same *Class 5* and is operating in the same line of business and is also dealing in the same trade channels, with an identical customer base, was sufficient reason for the respondent no.2 to allow the opposition proceedings initiated by the appellant herein.



CONCLUSION

21. Therefore, in view of the aforesaid, the appellant herein being a prior user as also a registered proprietor of the trademark 'FLORA' in India and also a '*person aggrieved*', is entitled to invoke the appellate jurisdiction of this Court under *Section 91* of the TM Act.

22. Accordingly, the present appeal is allowed and the impugned order dated 29.05.2023 passed by the respondent no.2 is set aside. The Registrar of Trade Marks is directed to remove the entry pertaining to application bearing

花西子

no.4330041 of the respondent no.1 for the mark Florasis / 'FLORASIS' in *Class 5* from the Register of Trade Marks forthwith.

23. In thereof, the present appeal alongwith the pending application stands disposed of.

24. A copy of this judgment be forwarded to the Registrar of Trade Marks for compliance.

SAURABH BANERJEE, J

MAY, 14, 2025/bh