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

\+ C.A.(COMM.IPD-TM) 22/2022

SUN PHARMA LABORATORIES LTD. ..... Appellant

Through: Mr. Sachin Gupta and Ms. Yashi Agrawal, Advocates.

versus

REGISTRAR OF TRADE MARKS ..... Respondent

Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advocates.

CORAM:
HON'BLE MR. JUSTICE SANJEEV NARULA

O R D E R

% 20.04.2023

1. Appellant – 'Sun Pharma Laboratories Ltd.', has filed an appeal under Section 91 of the Trade Marks Act, 1999 [hereinafter "*the Act*"] impugning order dated 28th September, 2018 read along with Statement of Grounds of decision dated 30th October, 2018 [hereinafter separately "*Refusal Order*" and "*Statement of Grounds*" and collectively "*Impugned Orders*"] whereby Appellant's (*erstwhile proprietor* 'M/s. Merck Sharp and Dohme Corp.') Trade Mark Application No. 2722660 for the device mark – ' istamet ', under Class-05 in respect of "*PHARMACEUTICAL PREPARATIONS FOR THE TREATMENT AND PREVENTION OF DIABETES*" claiming prior use since 24th August, 2011 [hereinafter "*subject mark*"], has been refused. Reasons disclosed in Statement of Grounds of decision are as follows:

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"With reference to the above and request on Form TM-M dated 27/10/2018. It has been decided by the Registrar of Trade Marks to inform you that hearing in respect of above application was held on 24/09/2018 and the said application is refused on the following Grounds;
* Advocate Sonal appeared. Matter argued, Identical/Similar, valid mark with same classification of goods/services is already on record. Likelihood of confusion. There is no supporting documents is on record claiming the use and distinctiveness of the mark. Perused. Objection under Section (11) sustained. Trademark refused on merit.
*11(1)(a) – Relative grounds for refusal of registration- The said trade Mark is refused for registration because of its identify with an earlier trade mark and similarity of goods or services covered by the trade mark; or
*11(1)(b)- Relative grounds for refusal of registration. The said trade Mark is refused for registration because of its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trademark there exists a likelihood of confusion on the part of the public,which includes the likelihood of association with the earlier trademark." [sic.]

[Emphasis supplied]

2. Subject mark is found objectionable under Section 11 (1)(*a*) and (*b*) of the Act, in view of the cited marks in the 'WORD MARK SEARCH REPORT' annexed to the Examination Report, which is culled out below:

GOVERNMENT OF INDIA
TRADE MARKS REGISTRY

INTELLECTUAL PROPERTY INDIA

LOCATION:
SECTION: EXM
REPORT: EXM007

WORD MARK SEARCH REPORT
APPLICATION NUMBER: 2722660
Class : —
TRADEMARK: 'istamet'

USER : LAH
PAGE:1
DATE: 27/09/2014

APPL NO	CLASS	CONFLICTING MARK	JOURNAL No	PROPRIETOR NAME	PROPRIETOR ADDRESS	STATUS	TM IMAGE
GOODS SERVICES							
1366667	5	ASTAMET	1353	SVEN GENETECH LTD.	D NO 74, SURYA ENCLAVES, TRIMULGHERRY, SECUNDERABAD - 500 015, ANDHRA PRADESH, INDIA.	Registered	
APPLICATION DATE 27/06/2005 10:54:00							
GOODS/SERVICE PHARMACEUTICAL, VETERINARY AND SANITARY PREPARATIONS; DIETETIC SUBSTANCES ADAPTED FOR MEDICAL USE, FOOD FOR BABIES; PLASTERS, MATERIALS FOR DRESSINGS; MATERIAL FOR STOPPING TEETH, DENTAL WAX; DISINFECTANTS; PREPARATIONS FOR DESTROYING VERMIN; FUNGICIDES, HERBICIDES.							
1755265	5	INSTAMET		HEM LATA	SCO 859, FF, N A C MANI MAJRA CHANDIGARH	Exam Report Issued	
APPLICATION DATE 19/11/2008 11:52:08							
GOODS/SERVICE MEDICINES FOR HUMAN PURPOSE.							
1894414	5	ESTIMET	1450	GREFITH LIFE SCIENCES PVT. LTD	PLOT NO77 INDUSTRIAL AREA1 CHANDIGARH	Registered	
APPLICATION DATE 10/12/2009 16:00:17							
GOODS/SERVICE MEDICINES FOR HUMAN PURPOSE.							
2273369	5	ASTAMET		ASTEC CROP CARE PRIVATE LIMITED	274, Elite Square, 7th Floor, Perin Nariman Street, Fort, Mumbai - 400001.	Objected	
APPLICATION DATE 28/01/2012 11:24:44							
GOODS/SERVICE Insecticides, Insect Repellent, Pesticides, Rodenticides, Miticides, Preparations For Destroying Vermin, Anti-Allergy Preparations And Sprays, Disinfectants, Germicides Fungicides, Disinfectants, Germicides, Fungicides, Herbicides, Preparations For Killing Weeds And Vermin.							

LAHANE SANJEEV S.
For REGISTRAR OF TRADE MARKS

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3. The present status of conflicting cited marks, in accordance with the status reflected on the online portal of the Trade Marks Registry, is given in a tabular representation below:

SL. NO.[1]	CITED MARKS	CURRENT STATUS[2]
1. and 2.	Word mark – 'ASTAMET' under Trade Mark Application No. 1366667 (Valid up/ renewed up to 27th June, 2015)	Likely to be removed due to non-filing of renewal request in prescribed timelines.
	Word mark – 'INSTAMET' under Trade Mark Application No. 1755265 (Valid up/ renewed up to 19th November, 2018)	
4.	Word mark – 'ASTAMET' under Trade Mark Application No. 2273369	Refused.

This brings us to conflicting mark at Sl. No. 3 – 'ESTIMET' registered under Trade Mark Application No. 1894414. The said mark has been recently renewed and is valid up to December 2029. However, Mr. Sachin Gupta, counsel for Appellant, has pointed out that, as per his information, the said mark is not in use. To buttress his submissions, he places reliance on the screenshots of e-commerce portals where the products under the name 'ESTIMET' has been advertised/ marketed, but are shown as unavailable. As regards similarity with the conflicting marks, Mr. Gupta argues that resemblance is immaterial as the marks are not in use. He requests that Appellant's application should be allowed to be advertised and objection, if any, can be considered at the stage of opposition.

[1] Corresponding with the 'WORD MARK SEARCH REPORT'.
[2] As per online portal of Trade Marks Registry.

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4. Appellant has a registration of word mark 'ISTAMET XR CP' under Trade Mark Application No. 2753891. This mark, although not identical to subject mark, certainly includes the word 'ISTAMET' and has been in use since the year-2011. Considering the facts noted above, in the opinion of the Court, the mark can be allowed to be advertised before acceptance.

5. In view of the above, the present appeal is allowed with following directions:

(a) Impugned Orders are set-aside.

(b) Trade Marks Registry is directed to process the registration application for the subject mark.

(c) Subject mark be advertised before acceptance as per proviso of Section 20 of the Act, within a period of three months from today. On advertisement in the Trade Marks Journal, an intimation shall also be sent by Trade Marks Registry to the registered proprietors of the cited marks, as per the Examination Report.

(d) If there is any opposition, the same shall be decided on its own merits, uninfluenced by observations made hereinabove.

(e) Appellant shall also send a copy of the order passed today to the proprietors of competing/ cited marks.

6. With the above directions, the appeal is disposed of along with pending application(s), if any.

7. Registry is directed to supply a copy of the present order to the Trade Mark Registry at llc-ipo@gov.in for compliance.

SANJEEV NARULA, J

APRIL 20, 2023/*d.negi*
(Corrected and released on 10th May, 2023)

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