



2025:DHC:8795-DB



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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**  
+ **FAO (COMM) 166/2024, CM APPLs. 48572/2024,**  
**48574/2024, 8400/2025 & 28815/2025**

**MANKIND PHARMA LIMITED** .....Appellant  
Through: Mr. Amit Sibal, Sr. Adv. with  
Mr. Hemant Daswani, Ms. Saumya Bajpai,  
Ms. Pranjal, Mr. Ankit Handa and Ms.  
Suditi Batra, Advs.

versus

**BRINTON PHARMACEUTICALS LIMITED** .....Respondent  
Through: Mr. Rahul Vidhani, Adv.

**CORAM:**  
**HON'BLE MR. JUSTICE C. HARI SHANKAR**  
**HON'BLE MR. JUSTICE OM PRAKASH SHUKLA**

**JUDGMENT (ORAL)**  
**22.09.2025**

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**C. HARI SHANKAR, J.**

**CM APPL. 28815/2025 (for additional documents)**

1. This application seeks to place on record the documents which have come on record of the learned Trial Court after the passing of the impugned order dated 3 May 2024.

2. Mr. Rahul Vidhani, learned Counsel for the respondent, restricts this application to Document 1, filed with the application, which is order dated 19 July 2021 passed by the learned District Judge (Commercial Court) in CS (COMM) 247/2021.



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3. In as much as the said document is only a judicial order, there can be no objection to the said document being relied upon.

4. Accordingly, to this limited extent, the application is allowed.

**CM APPL. 8400/2025 (for additional documents)**

5. Mr. Rahul Vidhani, learned Counsel for the respondent, seeks to withdraw this application.

6. The application is dismissed as withdrawn.

**FAO (COMM) 166/2024, CM APPLs. 48572/2024 & 48574/2024**

**Facts**

7. The appellant Mankind Pharma Ltd claims to be the fifth largest pharmaceutical company of India. The present dispute is concerned with a preparation for application on the skin to treat acne, initially launched by Lifestar Pharma Private Limited<sup>1</sup>, which was later amalgamated with the appellant, manufactured and sold under the registered trade mark ACNESTAR. The appellant claims that the mark ACNESTAR of the respondent infringes the mark ACNESTAR, and results in passing off, by the respondent, of its product as that of the appellant.

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<sup>1</sup> “LPPL”, hereinafter



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8. The word ACNESTAR is stated to have been devised as a portmanteau of the words ACNE and STAR, which was the latter half of “Lifestar”. The word mark ACNESTAR stands registered in favour of LPPL in Class 5 of the Nice classification as applicable to trademark registrations, for “pharmaceutical and medicinal preparations included in Class 5”. Since, the date of its adoption, it is asserted, by the appellant, that the mark ACNESTAR has been in continuous and uninterrupted use, first by LPPL and thereafter by the appellant. For the year 2020-2021 alone, sales of products under the ACNESTAR mark resulted in earnings of ₹ 54.22 Crores. Thus, over the years, it is asserted that the mark ACNESTAR has acquired considerable goodwill and reputation, and has become a source identifier of the appellant.

9. On or around 13 April 2021, it is asserted that the appellant came across a product manufactured by the respondent Brinton Pharmaceuticals Limited, under the name ACNESCAR. The product being manufactured and sold by the respondent under the name ACNESCAR was similar to the ACNESTAR product of the appellant. Both were applications for use on the skin. Mr. Rahul Vidhani, learned Counsel for the respondent acknowledges this fact but seeks to distinguish the two products on the ground that the respondent’s ACNESCAR cream was intended to treat the scars left behind *after* removal of acne. He submits, therefore, that the products ACNESTAR and ACNESCAR, though both for application on the skin, addressed distinct requirements and were used at different stages of the affliction.



**10.** According to the appellant, the respondent had applied, with the Registrar of Trademarks, for registration of the mark ACNESCAR on “proposed to be used basis”. Admittedly, the respondent does not have any registration for the mark “ACNESCAR”.

**11.** Thus, the position that emerges is that, while the appellant is the proprietor of the registered trademark ACNESTAR with effect from 25 April 2005, the respondent has no registration.

**12.** On coming to learn of the use, by the respondent, of the mark ACNESCAR, the appellant addressed a notice to the respondent on 13 April 2021, calling on the respondent to forthwith cease and desist from continuing to use the said mark. The respondent tendered an interim reply to the notice, but did not discontinue use of the mark ACNESCAR.

**13.** The appellant, in these circumstances, instituted CS (COMM) 242/2021 before the learned District Judge (Commercial), South East, Saket<sup>2</sup>, asserting that the use of the mark ACNESCAR, by the respondent, amounted to infringement of the appellant’s registered trademark ACNESTAR and also amounted to an attempt to pass off its products as the products of the appellant. The appellant, therefore, sought a decree of permanent injunction restraining the respondent from using the mark ACNESCAR or any other mark which would be deceptively similar to the appellant’s mark ACNESTAR for any preparation for application to the skin or any allied or cognate product. With the suit, the appellant also filed an application under Order

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<sup>2</sup> “learned Commercial Court”, hereinafter



XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908<sup>3</sup>, praying for an interlocutory injunction, during the pendency of the suit, restraining the respondent from using the mark ACNESCAR.

14. The learned Commercial Court has, by order dated 3 May 2024, dismissed the said application. Aggrieved thereby, the appellant has approached this Court by means of the present appeal under Section 13 of the Commercial Courts Act, 2015.

15. We have heard Mr. Amit Sibal, learned Senior Counsel for the appellant and Mr. Rahul Vidhani, learned Counsel for the respondent, at length.

### **The impugned judgment**

16. The reasoning in the impugned judgment consists only one paragraph, which may be reproduced as under:

“7. The plaintiff’s case is that in somewhere 2005, it independently and coined and adopted one trademark ACNESTAR, however, admitted that he is not insisted on the word ACNE and only with respect to the mark ACNESTAR as a whole and the mark should be compared as a whole. The case of the defendant is that the plaintiff has taken the same plea as taken by the defendant when his product was challenged by ACNESTAR. However, the plaintiff repelled the said plea by stating that in that proceedings the products of the plaintiff and defendant was different but in present case the products are use for pharmaceutical and found in pharmaceutical shop, therefore test is stricter. Though the test is stricter but the plaintiff product and the defendant product are qualitatively different having different functions and also registered in different classes. The plaintiff product is for medicinal class and the defendant product is non-medicinal class. The plaintiff product is 7 to 8 times cheaper than

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<sup>3</sup> “CPC”, hereinafter



that of the defendant product. The defendant is also a well reputed company. Furthermore, it is not disputed by the plaintiff that he is not claiming the right over the mark ACNE, however, over his mark ACNESTAR as a whole. The ACNE is a prime word in both the products and the SCAR used by the defendant is for removing the SCAR which is the purpose of his product. The make and design is also totally different.”

17. Following this, the learned Commercial Court has rejected the appellant’s application under Order XXXIX Rules 1 and 2 of the CPC.

### **Rival Contentions**

18. At the very outset, it is relevant to note that the learned Commercial Court has, in the afore-extracted para 7 from the impugned judgment, observed, erroneously, that the plaintiff’s and defendant’s products are registered in different classes. The respondent does not have any subsisting registration for any of its products. The ACNESTAR GEL device mark had been registered in favour of the respondent by the Trademark Registry *vide* Registration No. 5369451 dated 14 March 2022, but the said registration stands cancelled by the High Court of Bombay by order dated 6 May 2025 in Comm. Miscellaneous Petition 117/2025<sup>4</sup>.

19. Mr. Vidhani acknowledges this position but submits that, even if the respondent did not have any registration, no case of infringement or passing off could be said to have been made out.

### **Submissions of Mr. Sibal**

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<sup>4</sup> Mankind Pharma Limited v The Registrar of Trade Marks & Anr



20. Mr. Sibal submits that, in an infringement action, comparison has to be mark to mark. He submits that the learned Commercial Court has, in para 7 of the impugned judgment, fundamentally erred in observing that the “prime word” – meaning, one presumes, the dominant feature – of the rival marks ACNESTAR and ACNESCAR was the word “ACNE”. He submits that the prefix ACNE represents the ailment which the rival products intend to treat and cannot, therefore, constitute the dominant feature of the rival marks. He relies, for this purpose, on the judgement of a Division Bench of this Court in *Schering Corporation v Alkem Laboratories*<sup>5</sup> as well as the judgment of the Supreme Court in *J.R. Kapoor v Micronix India*<sup>6</sup> and of another Division Bench of this Court in *South India Beverages Pvt. Ltd. v General Mills Marketing Inc.*<sup>7</sup>.

21. Mr. Sibal submits that the products of the appellant and the respondent are sold through the same trade channels and that, therefore, there is clear likelihood of confusion as a result of the near phonetic identity of the marks ACNESCAR and ACNESTAR. Both the products belong to the same class. He submits that, in near identical circumstances, a Division Bench of this Court has, in *Wipro Enterprises Pvt Ltd v Himalaya Wellness Company*<sup>8</sup>, held that a case of infringement was made out. In that case, too, the products were skincare preparations with the product of the appellant being a cosmetic product and that of the respondent being an Ayurvedic medicine. He places particular reliance on paras 4.2 and 15 of the said

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<sup>5</sup> 2010 (42) PTC 772 (Del)

<sup>6</sup> 1994 Supp (3) SCC 215

<sup>7</sup> (2015) 61 PTC 231

<sup>8</sup> (2024) 100 PTC 284



decision.

22. Mr. Sibal further submits, with respect to the respondent's reliance on the fact that the appellant had, in earlier proceedings in which the Trademark Registry had set up the mark ACNESTAL against the appellant's proposed ACNESTAR mark, contended that the two marks were dissimilar, that this argument was not available to the respondent in view of the declaration of the law in para 43 of the judgment of the Division Bench of this Court in ***Raman Kwatra v KEI Industries Limited***<sup>9</sup>, which reads thus:

“43. We also find merit in the appellant's contention that a party, that has obtained the registration of a trademark on the basis of certain representation and assertions made before the Trade Marks Registry, would be disentitled for any equitable relief by pleading to the contrary. The learned Single Judge had referred to the decision in the case of ***Telecare Networks India Pvt. Ltd. v Asus Technology Pvt. Ltd***<sup>10</sup>, holding that after grant of registration neither the Examination Report nor the plaintiff's reply would be relevant. We are unable to agree with the said view. In that case, the Court had also reasoned that that there is no estoppel against statute. Clearly, there is no cavil with the said proposition; however, the said principle has no application in the facts of the present case. A party that has made an assertion that its mark is dissimilar to a cited mark and obtains a registration on the basis of that assertion, is not to be entitled to obtain an interim injunction against the proprietor of the cited mark, on the ground that the mark is deceptively similar. It is settled law that a person is not permitted to approbate and reprobate. A party making contrary assertions is not entitled to any equitable relief.”

Applying the law laid down in ***Raman Kwatra***, Mr. Sibal submits that, as the prosecution history on which the respondent relies is not in proceedings between the rival marks in the present case, it is of no relevance. Even otherwise, Mr. Sibal submits that the mark

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<sup>9</sup> 2023 SCC OnLine Del 38

<sup>10</sup> 262 (2019) DLT 101





ACNESTAL, which was set up against the ACNESTAR mark of the appellant, was for toilet soap. There could, therefore, be no comparison between that case and this.

23. Mr. Sibal further submits that the learned Commercial Court has erroneously relied on the difference in prices between the appellant and the respondent products. He submits that difference in prices has been held, in several decisions, not to be a consideration which mitigates the effect of trademark infringement, such as the judgement of the Supreme Court in *Renaissance Hotel Holdings Inc. v B. Vijaya Sai*<sup>11</sup>, and of the Division Bench of this Court in *South India Beverages*. He further relies on paras 50 to 59 of the judgment of the Division Bench of this Court in *Glenmark Pharmaceuticals Ltd. v Sun Pharma Laboratories Ltd.*<sup>12</sup>.

24. Mr. Sibal submits that the learned Commercial Court has further erred, in para 7 of the impugned order, in relying on the fact that the mark and design of the rival marks are different. He submits that in an infringement action, added matter is irrelevant and the comparison has to be mark to mark. Seen on a mark to mark basis, he submits that the mark ACNESTAR is obviously deceptively similar to the mark ACNESTAR specially when they are used for similar products and cater to a common consumer segment.

25. Mr. Sibal concludes his submissions by pointing out that the mark ACNESTAR is a portmanteau of ACNE and the suffix of the

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<sup>11</sup> (2022) 5 SCC 1

<sup>12</sup> 2024 SCC OnLine Del 2707



name of the predecessor-in-interest of the appellant, LPPL. Thus, it is an arbitrary and fancifully coined word and is entitled to protection even on that ground.

**26.** Resultantly, Mr. Sibal submits that the impugned order deserves to be set aside and the respondent restrained from using the mark ACNESCAR for skin cream or other products in respect of which the appellant is using the mark ACNESTAR.

#### Submissions of Mr. Rahul Vidhani

**27.** Mr. Vidhani, responding to Mr. Sibal, submits at the outset that the appellant had, before the learned Commercial Court, given up the plea of passing off, as is specifically noted in an order passed by the learned Commercial Court. The only case, therefore, that remains is one of infringement. The appellant was required, therefore, to make out a case of infringement by the use of the mark ACNESCAR by the respondent of the mark ACNESTAR which was registered in appellant's favour in Class 5.

**28.** Mr. Vidhani submits that though the appellant had obtained a registration of the mark ACNESTAR in Class 5, it has never used the said mark for any pharmaceutical products, which were the products in respect of which registration had been granted. Mr. Vidhani submits that the appellant is using the mark ACNESTAR for skin cream but not for pharmaceutical preparations, which were the items covered by the registration held by the appellant. A trade mark registrant who does not use the registered trade mark, he submits is not entitled to



claim exclusivity over the mark or seek injunction against others using that mark or other marks which may be similar thereto.

29. In this context, Mr. Vidhani also places reliance on the prayer clause in the plaint filed by the appellant, which reads thus:

“26. In the circumstances, the Plaintiff pray for the following reliefs:

a A Decree for perpetual injunction restraining the Defendant, either by themselves or through their dealers, distributors, stockiest, agents, associates, employees, servants, and/or assigns from infringing the Plaintiffs trade mark ACNESTAR with respect to medicinal and pharmaceutical preparations in any manner whatsoever.

b A Decree for perpetual injunction restraining the Defendant, either by themselves or through their dealers, distributors, stockiest, agents, associates, employees, servants, and/or assigns from passing off the Plaintiffs trade mark ACNESTAR with respect to medicinal and pharmaceutical preparations in any manner whatsoever;

c A Decree for perpetual injunction restraining the Defendant, either by themselves or through their dealers, distributors, stockiest, agents, associates, employees, servants, and/or assigns from trading and/or selling and/or dealing and/or advertising including advertising and selling on internet under the impugned trade mark ACNESTAR.

d Orders directing rendition of accounts of profit illegally earned by the Defendant by selling the goods under the impugned trade mark ACNESTAR and a decree may be passed in favour of the Plaintiff for an amount so found due against the Defendant.

e A decree for an enquiry to ascertain into the damages suffered by the Plaintiff by reason of such wrongful acts of the Defendant and a decree for payment of such amount be passed as may be found due and payable by the Defendant to the Plaintiff upon such enquiry.

f Pass a decree for damages in tune of Rs. Five Lakh only (Rs 5,00,000/-) against the Defendant and in favour of the Plaintiff on account of use of the impugned trade mark



ACNESCAR.

g Allow costs in the proceedings in favour of Plaintiff; and

h Any other or further orders as to this Hon'ble Court may deem fit and proper in the facts and circumstances of the present case be also passed in favour of the Plaintiff against the Defendant.”

**30.** Adverting to the prayer in para 26(a), Mr. Vidhani submits that the injunction that was sought by the appellant was with respect to use of the mark ACNESCAR by the respondent for medicinal and pharmaceutical products. The respondent is not using the mark ACNESCAR for medicinal or pharmaceutical products and therefore, the very prayer for injunction in the plaint was meaningless.

**31.** Mr. Vidhani further submits that the appellant's and respondent's products are not used for the same purpose. The appellant's product treats acne whereas the respondent's product is meant to heal the scar that remains after acne is treated. It is for this reason, he submits, that the respondent has named the product ACNESCAR. The adoption of the mark ACNESCAR is, therefore, honest and is entitled to protection even on that ground.

**32.** Apropos his reliance on the prosecution history of the application filed by the appellant for registering the mark ACNESTAR vis-a-vis the rival mark ACNESTAL, which had been set up by the Trade Mark Registry, Mr. Vidhani submits that the prosecution history continues to be relevant, even if the rival mark set up against the mark of the appellant was not that of the respondent.



For this purpose, he relies on para 5 of the judgment of the Division Bench of this Court in *S.K. Sachdeva v Shri Educare Limited*<sup>13</sup>.

33. In this context, he has specifically drawn our attention to para 4(a) of the ground taken by Biomedica Life Science<sup>14</sup> which had opposed Application 2520524 filed by the appellant for registering the mark ACNESTAR, which read thus:

“4(a) That the Applicant's mark "ACNESTAR" for which registration is sought is deceptively similar to the Opponents Trade Mark "ACNESTAL". The Applicants have copied the Opponents' mark "ACNESTAL" and dishonestly adopted the similar impugned mark "ACNESTAR". The applicant has reproduced the opponent's reputed Trademark "ACNESTAR". There is no difference between the two marks. Thus, the impugned mark "ACNESTAR" is similar to the opponents' trademark "ACNESTAL", in as much as both the marks are orally, visually, structurally and conceptually similar to each other and one cannot be distinguished from the other. The goods for which the Applicants' are seeking registration are of the same description for which the Opponents' Trade Mark is registered and confusion and deception is likely to arise in the course of trade in view of close and deceptive similarity between the rival marks and in view of the fact that both the goods are prescribed by doctors and sold in the same counter i.e. general pharmacies.”

Mr. Vidhani juxtaposes the aforesaid ground with the response in the counter statement filed in para 6(b) of the counter statement filed by the respondent, to the aforesaid assertion:

“6(b) In reply to paragraph 4 (a) of Notice of Opposition, it is submitted that applicant trade mark ACNESTAR is neither identical with nor deceptively similar to the opponent trade mark ACNESTAL. Applicants have adopted a distinct trade mark which is capable of distinguishing its good for those of others. Opponent's allegations are highly untenable. Opponents have meticulously scrutinized applicant's trade mark and put strenuous

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<sup>13</sup> 2016 (65) PTC 614 (Del)

<sup>14</sup> 'Biomedica', hereinafter



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efforts to find out similarities with their trade marks. It is submitted that Applicant is using the mark ACNESTAR at-least 8 years prior to the date of application and have also adopted the mark in a bonafide manner keeping the practices of the pharmaceutical industry in mind. It is submitted that applicants were not aware of opponents trade mark when they adopted the trade mark ACNESTAR. Applicants have honestly adopted the trade mark ACNESTAR with bonafide intention.”

Mr. Vidhani further submits that the application filed by the appellant for the registration of the mark ACNESTAR, which was opposed by Biomedica, was in Class 3 for “Bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, deodorants, essential oils, cosmetics, hair lotions and dentifrices”. The mark ACNESTAR of Biomedica was also used for soaps. As such, Mr. Vidhani submits that the rival marks following Application No. 2520524 filed by the appellant for registering the mark ACNESTAR in Class 3, were both for goods which included soaps.

**34.** Apropos his plea of honest adoption, Mr. Vidhani places reliance on the decision in *Schering Corporation* as well as paras 3, 39, 42 to 45 and 48 of *RSPL Healthcare Pvt. Ltd v Sun Pharma Laboratories Ltd.*<sup>15</sup> :

“3. The above suit has been filed by the appellant praying for *inter alia* a decree of permanent injunction restraining the respondents from dealing in or using the trademark/label

‘PRUEASE’



(hereinafter referred to as the ‘Impugned Mark’) on the ground that it is deceptively similar to appellant's trademark/label ‘PRO-

EASE’



(hereinafter referred to as the ‘Subject

<sup>15</sup> 2025 SCC OnLine Del 4461 (DB)



Mark’).

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39. Applying the above principles to the facts of the present case, there is no dispute that the appellant is using its Subject Mark for goods like sanitary napkins, sanitary towels, pads etc., while the respondents are using their Impugned Mark for medicine claimed to be giving relief against constipation. The two goods are neither allied nor cognate. The learned District Judge, in our opinion, has rightly held that the nature of goods, their trade channel, their purpose, and the intended consumers are distinct, and there is no likelihood of confusion being caused by the use of the marks for such goods.

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42. In *Nandhini Deluxe v Karnataka Coop. Milk Producers Federation Ltd.*<sup>16</sup>, the Supreme Court held that if a trader or manufacturer actually trades in or manufactures only one or some of the articles coming under a broad classification and such trader or manufacturer has no *bona fide* intention to trade in or manufacture other goods or articles which also fall under the said broad classification, such trader or manufacturer should not be permitted to enjoy monopoly in respect of all the articles which may come under such broad classification and by that process preclude the other traders or manufacturers from getting registration of separate and distinct goods which may also be grouped under the broad classification. We quote from the judgment, as under:—

“32. Having arrived at the aforesaid conclusion, the reasoning of the High Court that the goods belonging to the appellant and the respondent (though the nature of goods is different) belong to the same class and, therefore, it would be impermissible for the appellant to have the registration of the trade mark concerned in its favour, would be meaningless. That apart, there is no such principle of law. On the contrary, this Court in *Vishnudas Trading v Vazir Sultan Tobacco Co. Ltd*<sup>17</sup> has decided otherwise as can be seen from the reading of paras 47 and 48 of the said judgment :

“47. The respondent Company got registration of its brand name “Charminar” under the broad classification “manufactured tobacco”. So long such registration remains operative, the respondent Company is entitled to claim exclusive use of the said

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<sup>16</sup> (2018) 9 SCC 183

<sup>17</sup> (1997) 4 SCC 201





*brand name in respect of articles made of tobacco coming under the said broad classification “manufactured tobacco”. Precisely for the said reason, when the appellant made application for registration of quiwam and zarda under the same brand name “Charminar”, such prayer for registration was not allowed. The appellant, therefore, made application for rectification of the registration made in favour of the respondent Company so that the said registration is limited only in respect of the articles being manufactured and marketed by the respondent Company, namely, cigarettes. In our view, if a trader or manufacturer actually trades in or manufactures only one or some of the articles coming under a broad classification and such trader or manufacturer has no bona fide intention to trade in or manufacture other goods or articles which also fall under the said broad classification, such trader or manufacturer should not be permitted to enjoy monopoly in respect of all the articles which may come under such broad classification and by that process preclude the other traders or manufacturers from getting registration of separate and distinct goods which may also be grouped under the broad classification. If registration has been given generally in respect of all the articles coming under the broad classification and if it is established that the trader or manufacturer who got such registration had not intended to use any other article except the articles being used by such trader or manufacturer, the registration of such trader is liable to be rectified by limiting the ambit of registration and confining such registration to the specific article or articles which really concern the trader or manufacturer enjoying the registration made in his favour. In our view, if rectification in such circumstances is not allowed, the trader or manufacturer by virtue of earlier registration will be permitted to enjoy the mischief of trafficking in trade mark. Looking to the scheme of the registration of trade mark as envisaged in the Trade Marks Act and the Rules framed thereunder, it appears to us that registration of a trade mark cannot be held to be absolute, perpetual and invariable under all circumstances. Section 12 of the Trade Marks Act prohibits registration of identical or deceptively similar trade marks in respect of goods and description of goods which is identical or deceptively*





*similar to the trade mark already registered. For prohibiting registration under Section 12(1), goods in respect of which subsequent registration is sought for, must be (i) in respect of goods or description of goods being same or similar and covered by earlier registration, and (ii) trade mark claimed for such goods must be same or deceptively similar to the trade mark already registered. It may be noted here that under sub-section (3) of Section 12 of the Trade Marks Act, in an appropriate case of honest concurrent use and/or of other special circumstances, same and deceptively similar trade marks may be permitted to another by the Registrar, subject to such conditions as may deem just and proper to the Registrar. It is also to be noted that the expressions “goods” and “description of goods” appearing in Section 12(1) of the Trade Marks Act indicate that registration may be made in respect of one or more goods or of all goods conforming a general description. The Trade Marks Act has noted distinction between description of goods forming a genus and separate and distinctly identifiable goods under the genus in various other sections e.g. goods of same description in Section 46, Sections 12 and 34 and class of goods in Section 18, Rules 12 and 26 read with Fourth Schedule to the Rules framed under the Act.*

48. *The “class” mentioned in the Fourth Schedule may subsume or comprise a number of goods or articles which are separately identifiable and vendible and which are not goods of the same description as commonly understood in trade or in common parlance. Manufactured tobacco is a class mentioned in Class 34 of Fourth Schedule of the Rules but within the said class, there are a number of distinctly identifiable goods which are marketed separately and also used differently. In our view, it is not only permissible but it will be only just and proper to register one or more articles under a class or genus if in reality registration only in respect of such articles is intended, by specifically mentioning the names of such articles and by indicating the class under which such article or articles are to be comprised. It is, therefore, permissible to register only cigarette or some other specific products made of “manufactured tobacco” as mentioned in Class 34 of Fourth Schedule of the Rules. In our view, the*



*contention of Mr. Vaidyanathan that in view of change in the language of Section 8 of the Trade Marks Act as compared to Section 5 of the Trade Marks Act, 1940, registration of trade mark is to be made only in respect of class or genus and not in respect of articles of different species under the genus is based on incorrect appreciation of Section 8 of the Trade Marks Act and Fourth Schedule of the Rules.”*

*(emphasis supplied)*

33. *We may mention that the aforesaid principle of law while interpreting the provisions of the Trade and Merchandise Marks Act, 1958 is equally applicable as it is unaffected by the Trade Marks Act, 1999 inasmuch as the main object underlying the said principle is that the proprietor of a trade mark cannot enjoy monopoly over the entire class of goods and, particularly, when he is not using the said trade mark in respect of certain goods falling under the same class.* In this behalf, we may usefully refer to Section 11 of the Act which prohibits the registration of the mark in respect of the similar goods or different goods but the provisions of this section do not cover the same class of goods.

*(Emphasis Supplied)*

43. In the present case as well, the goods are distinct, having distinct and separate trade channels, and there is no likelihood of confusion being caused to the public by the use of the marks. There is also no case of passing off made out by the appellant as the packaging of the products and the manner of the depiction of the mark along with other additional ingredients of the label do not indicate any likelihood of confusion resulting in the use of the same.

44. As far as the plea of the appellant that non-grant of injunction may prevent the appellant from expanding its business to pharmaceuticals, apart from being based on mere conjectures, even otherwise, cannot be accepted. It is common practice that for distinct goods the manufacturers use distinct trademarks. In fact, it is own case of the appellant that it has other trademarks like GHARI/GHADI Label, VENUS, REDCHIEF, NAMASTE INDIA etc.. The above plea, therefore, appears to be a red herring, rather than any genuine concern.

45. Equally, the plea of the appellant that the respondents may venture out to the products like sanitary napkins, etc., has been answered by the respondents by stating that they do not intend to use their marks for these goods. This intent has also been evidenced by the respondents withdrawing their oppositions to the



applications of the appellant seeking registration of its mark.

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48. For grant of an *interim* injunction, the appellant has to meet the trinity test that is, of showing a good *prima facie* case, balance of convenience in its favour, and that irreparable harm shall be caused to it in case such *interim* order is not granted. The appellant has failed to make a *prima facie* case in its favour. The balance of convenience is also in favour of the respondents and against the appellant inasmuch as the respondents have, at least *prima facie*, been able to show the user of their mark since 2017, that is, for a period of almost seven years prior to the filing of the suit. The adoption of the Impugned Mark by the respondents has also been explained by it, and the same appears to be *bona fide* and in accordance with industry practice, wherein alphabets are taken from the chemical compound the product is made of, and additions are made to it to make it a coined mark. In the present case, as noted hereinabove, the respondents have taken the first three alphabets from the chemical compound prucalopride, and have added the word 'Ease' to the same, for reflecting the ultimate use of the medicine, that is, giving relief to constipation. As far as irreparable harm and injury is concerned, the appellant can always be compensated in terms of the damages, in case, it is later found to have made out a case for the same."

35. To support his proposition that non use of the mark ACNESTAR by the appellant in Class 5, for which it was registered, would result in death of the mark and extinguishing of the right of the appellant to seek exclusivity in respect thereof, Mr. Vidhani places reliance on the judgment of the Division Bench of this Court in *Veerumal Praveen Kumar v Needle Industries (India) Ltd.*<sup>18</sup>.

#### Submissions of Mr. Sibal in rejoinder

36. Mr. Sibal submits that the stand that Mr. Vidhani is seeking to canvass before this Court is directly opposed to the stand that he had adopted before the learned Commercial Court. He draws our attention

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<sup>18</sup> 93 (2001) DLT 600



in this context to para 3 of the impugned order in which the learned Commercial Court has specifically recorded the following contention of the respondent:

“3 ...The Acnescar of the defendant is a cosmetic product whereas the product of the plaintiff is a pharmaceutical product falls in Schedule H.”

**37.** With respect to the prosecution history of Application No. 2520524 submitted by the appellant for registering the mark ACNESTAR in Class 3, he submits that the application was for use of the mark in bleaching products and is of no relevance to the present case.

**38.** Apropos the decision in *S.K. Sachdeva*, Mr. Sibal submits that the Division Bench in that case was persuaded by the fact that there was active concealment in the pleadings of the prosecution history of the rival mark. In the present case, the appellant has itself disclosed Application No. 2520524 filed by it for registering the mark ACNESTAR in class 3 and the opposition put up by Biomedica thereto. There is, therefore, no concealment of fact as was existing in *S.K. Sachdeva*. That decision therefore is of no value.

### **Analysis**

**39.** We have considered the rival submissions and the material on record.

**40.** Action for infringement maintainable



The word mark ACNESTAR stands registered in favour of the appellant in Class 5 for pharmaceutical and medicinal preparations. The respondent has no surviving trademark registration. Registration No. 5369451 which had been issued to the respondent was subsequently cancelled by the High Court of Bombay by order dated 6 May 2025 in Comm Misc. Petition 117/2025. The appellant can, therefore, maintain an action for infringement against the respondent.

**41. Prima facie case of infringement made out**

**41.1** Clearly, the mark ACNESTAR is phonetically nearly identical to ACNESTAR and, unless the two words are pronounced syllable by syllable, they are indistinguishable. A clear case of near phonetic identity, therefore, exists between the marks.

**41.2** Mr. Vidhani sought to contend that the mark ACNESTAR is a coined portmanteau of “ACNE” and “STAR”, as the preparation is intended to treat the scar that is left behind after acne is treated. The submission does not, in any way, mitigate the aspect of infringement. It is certainly open to any manufacturer to coin a mark under which it seeks to manufacture and sell its products. This principle would apply as much to pharmaceutical products or cosmetic products or as to any other product. While doing so, however, the manufacturer has to take care to ensure that the mark is not confusingly or deceptively similar to any registered trademark. If it is, he risks the chance of an injunction. Innocence is no defence. Infringement is not dependent on *mala fides* or *mens rea*.



**41.3** The fact that the mark ACNESCAR may be a coined portmanteau of the words ACNE and SCAR cannot, therefore, save it from injunction on the ground of infringement, as it is clearly phonetically deceptively similar to the mark ACNESTAR of the appellant, for which the appellant has a subsisting trademark registration of 2005 vintage, i.e., of nearly two decades.

**41.4** Besides, the mark ACNESTAR, of the appellant, cannot, in any manner of speaking, be regarded as descriptive of the product for which it is used. ACNESTAR is also a portmanteau of ACNE and STAR which is the second half of “LIFESTAR”, representing Livestar Pharmaceuticals who was the original manufacturer of the product. Being, thus, a combination of the affliction which the preparations intend to treat, i.e., acne, and the second part of the name of the company which manufactures the product, the mark ACNESTAR acquires distinctiveness.

**41.5** Besides, it is settled that, in respect of pharmaceutical products, a greater degree of care is required to be exercised by courts while assessing the aspect of infringement. The principle is authoritatively captured in the following passages from *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd*<sup>19</sup>:

“19. With respect, we are unable to agree that the principle of phonetic similarity has to be jettisoned when the manner in which the competing words are written is different and the conclusion so arrived at is clearly contrary to the binding precedent of this Court

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<sup>19</sup> (2001) 5 SCC 73



in *Amritdhara*<sup>20</sup> where the phonetic similarity was applied by judging the two competing marks. Similarly, in *Durga Dutt Sharma*<sup>21</sup> it was observed that:

“In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiffs and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated.”

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21. It will be useful to refer to some decisions of American courts relating to medicinal products. In the case of *American Cynamid Corp. v Connaught Laboratories Inc.*<sup>22</sup> it was held as under:

“Exacting judicial scrutiny is required if there is a possibility of confusion over marks on medicinal products because the potential harm may be far more dire than that in confusion over ordinary consumer products.”

22. It may here be noticed that Schedule ‘H’ drugs are those which can be sold by the chemist only on the prescription of the doctor but Schedule ‘L’ drugs are not sold across the counter but are sold only to the hospitals and clinics. Nevertheless, it is not uncommon that because of lack of competence or otherwise, mistakes can arise specially where the trade marks are deceptively similar. In *Blansett Pharmaceuticals Co. v Carmick Laboratories Inc.*<sup>23</sup> it was held as under:

“Confusion and mistake is likely, even for prescription drugs prescribed by doctors and dispensed by pharmacists, where these similar goods are marketed under marks which look alike and sound alike.”

23. In the case of *Glenwood Laboratories, Inc. v American Home Products Corp.*<sup>24</sup> the Court of the United States had held that:

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<sup>20</sup> *Amritdhara Pharmaceuticals v Satya Deo Gupta*, AIR 1963 SC 449

<sup>21</sup> *Kaviraj Pt Durga Dutt Sharma v Navratna Pharmaceutical Laboratories*, AIR 1965 SC 980

<sup>22</sup> 231 USPQ 128 (2<sup>nd</sup> Cir 1986)

<sup>23</sup> 25 USPQ 2<sup>nd</sup>, 1473 (TTAB 1993)

<sup>24</sup> 173 USPQ 19 (1972) 455 F Reports 2d, 1384 (1972)





“The fact that confusion as to prescription drugs could produce harm in contrast to confusion with respect to non-medicinal products is an additional consideration for the Board as is evident from that portion of the opinion in which the Board stated: ‘The products of the parties are medicinal and the applicant's product is contraindicated for the disease for which the opposer's product is indicated. It is apparent that confusion or mistake in filling a prescription for either product could produce harmful effects. Under such circumstances, it is necessary for obvious reasons, to avoid confusion or mistake in the dispensing of the pharmaceuticals.’

The board's view that a higher standard be applied to medicinal products finds support in previous decisions of this Court, *Clifton v Plough*<sup>25</sup> (‘it is necessary for obvious reasons, to avoid confusion in the dispensing of pharmaceuticals’), *Campbell Products, Inc. v John Wyeth & Bro. Inc.*<sup>26</sup> (‘it seems to us that where ethical goods are sold and careless use is dangerous, greater care should be taken in the use of registration of trade marks to assure that no harmful confusion results’).”

24. In the case of *R.J. Strassenburgh Co. v Kenwood Laboratories, Inc.*<sup>27</sup> as noted in the decision of *Morgenstern Chemical Co. case*, it had been held that:

“Physicians are not immune from confusion or mistake. Furthermore it is common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently handwriting is not unmistakably legible. These facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced.”

25. The drugs have a marked difference in the compositions with completely different side effects, the test should be applied strictly as the possibility of harm resulting from any kind of confusion by the consumer can have unpleasant if not disastrous results. The courts need to be particularly vigilant where the defendant's drug, of which passing-off is alleged, is meant for curing the same ailment as the plaintiff's medicine but the compositions are different. The confusion is more likely in such cases and the incorrect intake of medicine may even result in loss

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<sup>25</sup> 341, F 2d 934, 936, 52, CCPA 1045, 1047 (1965)

<sup>26</sup> 143, F 2d 977, 979, 31 CCPA 1217 (1944)

<sup>27</sup> 106 USPQ 379 (1955)





of life or other serious health problems. In this regard, reference may usefully be made to the case of ***Glenwood Laboratories, Inc. v American Home Products Corpn.*** where it was held as under:

“The products of the parties are medicinal and the applicant's product is contraindicated for the disease for which opposer's product is indicated. It is apparent that confusion or mistake in filling a prescription for either product could produce harmful effects. Under such circumstances it is necessary for obvious reasons, to avoid confusion or mistake in the dispensing of the pharmaceuticals.”

26. It was further submitted on behalf of the appellant that although the possibility of confusion in a drug being sold across the counter may be higher, the fact that a drug is sold under prescription or only to physicians cannot by itself be considered a sufficient protection against confusion. The physicians and pharmacists are trained people yet they are not infallible and in medicines, there can be no provisions for mistake since even a possibility of mistake may prove to be fatal.

27. As far as the present case is concerned, although both the drugs are sold under prescription but this fact alone is not sufficient to prevent confusion which is otherwise likely to occur. In view of the varying infrastructure for supervision of physicians and pharmacists of medical profession in our country due to linguistic, urban, semi-urban and rural divide across the country and with high degree of possibility of even accidental negligence, strict measures to prevent any confusion arising from similarity of marks among medicines are required to be taken.

28. Here it will be useful to refer to the decision of ***Morgenstern Chemical Co. case*** where it has been held as under:

“(5) In the field of medical products, it is particularly important that great care be taken to prevent any possibility of confusion in the use of trade marks. The test as to whether or not there is confusing similarity in these products even if prescribed and dispensed only by professionally trained individuals does not hinge on whether or not the medicines are designed for similar ailments. The rule enunciated by Judge Helen in ***Cole Chemical Co. v Cole Laboratories***<sup>28</sup> is applicable here:

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<sup>28</sup> DC Mo 1954, 118 F Supp 612, 616, 617, 101, USPQ 44,47,48



‘The plaintiff and the defendant are engaged in the sale of medical preparations. They are for ultimate human consumption or use. ... They are particularly all for ailments of the human body. Confusion in such products can have serious consequences for the patient. Confusion in medicines must be avoided.

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Prevention of confusion and mistakes in medicines is too vital to be trifled with.’

The observations made by Assistant Commissioner Leeds of the Patent Office in ***R.J. Strassenburgh Co. v Kenwood Laboratories, Inc.*** USPQ 380 are particularly apt, that:

‘Physicians are not immune from confusion or mistake. Furthermore it is common knowledge that many prescriptions are telephoned to the pharmacists and others are handwritten, and frequently handwriting is not unmistakably legible. These facts enhance the chances of confusion or mistake by the pharmacists in filling the prescription if the marks appear too much alike when handwritten or sound too much alike when pronounced.’

The defendant concedes that physicians and pharmacists are not infallible but urges that the members of these professions are carefully trained to detect difference in the characteristics of pharmaceutical products. While this is doubtless true to dos (*sic*) not open the door to the adoption by manufacturers of medicines of trade marks or names which would be confusingly similar to anyone not exercising such great care. For physicians and pharmacists are human and in common with the rest of mankind are subject to human frailties. In the field of medicinal remedies the courts may not speculate as to whether there is a probability of confusion between similar names. If there is any possibility of such confusion in the case of medicines public policy requires that the use of the confusingly similar name be enjoined (see ***Lambert Pharmacol Ltd. v Bolton Chemical Corpn.***<sup>29</sup>).”

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<sup>29</sup> DCNY 1915, 219 F 325.326



29. In the book titled as McCarthy on Trade Marks, it is observed in the footnote at pp. 23-70 as under:

“Physicians and pharmacists are knowledgeable in their fields does not mean they are equally knowledgeable as to marks and immune from mistaking one mark from another.” (*Schering Corp. v Alza Corp.*<sup>30</sup>.)

30. In the case of *Syntex Laboratories Inc. v Norwich Pharmacal Co.*<sup>31</sup>, it is observed as under:

“Stricter standard in order to prevent likelihood of confusion is desirable where involved trade marks are applied to different prescribed pharmaceutical products and where confusion could result in physical harm to the consuming public.”

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32. Public interest would support lesser degree of proof showing confusing similarity in the case of trade mark in respect of medicinal products as against other non-medicinal products. Drugs are poisons, not sweets. Confusion between medicinal products may, therefore, be life threatening, not merely inconvenient. Noting the frailty of human nature and the pressures placed by society on doctors, there should be as many clear indicators as possible to distinguish two medicinal products from each other. It is not uncommon that in hospitals, drugs can be requested verbally and/or under critical/pressure situations. Many patients may be elderly, infirm or illiterate. They may not be in a position to differentiate between the medicine prescribed and bought which is ultimately handed over to them. This view finds support from McCarthy on Trade Marks, 3rd Edn., para 23.12 of which reads as under:

“The tests of confusing similarity are modified when the goods involved are medicinal products. Confusion of source or product between medicinal products may produce physically harmful results to purchasers and greater protection is required than in the ordinary case. If the goods involved are medicinal products each with different effects and designed for even subtly different uses, confusion among the products caused by similar marks could have disastrous effects. For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations. The same

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<sup>30</sup> 207 USPQ 504 (TTAB 1980)

<sup>31</sup> 169 USPQ 1 (2<sup>nd</sup> Cir 1971)



standard has been applied to medical products such as surgical sutures and clavicle splints.”

33. The decisions of English courts would be relevant in a country where literacy is high and the marks used are in the language which the purchaser can understand. While English cases may be relevant in understanding the essential features of trade mark law but when we are dealing with the sale of consumer items in India, you have to see and bear in mind the difference in situation between England and India. Can English principles apply in their entirety in India with no regard to Indian conditions? We think not. In a country like India where there is no single common language, a large percentage of population is illiterate and a small fraction of people know English, then to apply the principles of English law regarding dissimilarity of the marks or the customer knowing about the distinguishing characteristics of the plaintiff's goods seems to overlook the ground realities in India. While examining such cases in India, what has to be kept in mind is the purchaser of such goods in India who may have absolutely no knowledge of English language or of the language in which the trade mark is written and to whom different words with slight difference in spellings may sound phonetically the same. While dealing with cases relating to passing off, one of the important tests which has to be applied in each case is whether the misrepresentation made by the defendant is of such a nature as is likely to cause an ordinary consumer to confuse one product for another due to similarity of marks and other surrounding factors. What is likely to cause confusion would vary from case to case. However, the appellants are right in contending that where medicinal products are involved, the test to be applied for adjudging the violation of trade mark law may not be on a par with cases involving non-medicinal products. A stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal product for another by the consumer. While confusion in the case of non-medicinal products may only cause economic loss to the plaintiff, confusion between the two medicinal products may have disastrous effects on health and in some cases life itself. Stringent measures should be adopted specially where medicines are the medicines of last resort as any confusion in such medicines may be fatal or could have disastrous effects. The confusion as to the identity of the product itself could have dire effects on the public health.

34. Keeping in view the provisions of Section 17-B of the Drugs and Cosmetics Act, 1940 which inter alia indicates that an imitation or resemblance of another drug in a manner likely to deceive being regarded as a spurious drug it is but proper that before granting permission to manufacture a drug under a brand



name the authority under that Act is satisfied that there will be no confusion or deception in the market. The authorities should consider requiring such an applicant to submit an official search report from the Trade Mark Office pertaining to the trade mark in question which will enable the Drug Authority to arrive at a correct conclusion.”

## 42. Errors in the reasoning of the learned Commercial Court

**42.1** The learned Commercial Court has also, in para 7 of the impugned order, acknowledged this principle. However, having done so, the learned Commercial Court proceeds to distinguish the case at hand, on manifestly erroneous grounds.

**42.2** The learned Commercial Court first observes that the products of the appellant and the respondent “are qualitatively different having different functions”. This is incorrect. Even though the appellant’s product may fall in the class of pharmaceutical products whereas the respondent’s product may be an ordinary skin cream, both are intended to treat associated skin ailments, the appellants product being intended to treat acne and the respondent’s product to treat the scars left behind after acne has been treated. They, therefore, cater to the same consumer segment. It cannot, therefore, be said that they are either qualitatively different or having different functions. Besides it has to be remembered that Section 29(2)(b) of the Trademarks Act uses the word “similar”. If two marks are similar, and are used for similar goods or services, and such use results in likelihood of confusion in the mind of a consumer of average intelligence and imperfect recollection<sup>32</sup>, the tort of infringement *ipso facto* stands

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<sup>32</sup> Refer *Amritdhara Pharmacy v Satyadeo Gupta; Satyam Infoway Ltd. v Siffynet Solutions (P) Ltd.*, (2004) 6 SCC 145



committed. While applying this principle to the facts of the present case, it is clear that the marks ACNESTAR and ACNESCAR are similar and that they are used for products which are also similar. Likelihood of confusion is, therefore, self-evident.

**42.3** The second ground on which, the learned Commercial Court has sought to distinguish the *Cadila* principle is that the rival marks are registered in different classes. This, as we have already noted, is a factually incorrect finding, as the respondent has no registration for the mark ACNESCAR.

**42.4** The third ground which has weighed with the learned Commercial Court in para 7 of the impugned order is that the price of the two products is different. On this aspect, too, the law is no longer *res integra*. It has been held by the Supreme Court in *Renaissance Hotel Holdings Inc.* as well as by the Division Bench of this Court in *South India Beverages* that difference in prices cannot mitigate the effect of infringement.

**42.5** Besides, a person who seeks treatment for a skin problem is unlikely to concern himself much with the price of the product. In fact, Mr. Vidhani's submission that the products of the appellant and the respondent cater to different skin problems defeats the reliance on the difference in price between the products. If the products cater to different skin problems, the fact that they may be differently priced would not make a difference to the matter of infringement, especially as the marks are nearly phonetically identical and the skin problems which are treated by the two products are associated. A consumer of



average intelligence and imperfect recollection would be bound either to confuse the two marks or, at the very least, to presume an association between them owing to their near phonetic identity and the fact that they treat associated skin issues, one to be applied while the person is suffering from acne and the other after the acne stands treated. In such circumstances, the difference in price between the two marks would hardly matter.

**42.6** The learned Commercial Court has next observed that the make and design of the two products are different. As Mr. Sibal correctly points out, in so holding, the learned Commercial Court has conflated the principles which apply to passing off, with those which apply to infringement. Difference in appearance, or added matter, are of significance only in a case of passing off. Infringement is to be decided on a mark to mark basis. One may refer, in this context, to the following passages from *Kaviraj Pandit Durga Dutt Sharma v Navaratna Pharmaceuticals Laboratories*:

“28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under Section 21 in respect of a registered trade mark and also of a passing off by the use of the same mark. The finding in favour of the appellant to which the learned counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in the colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set





out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy for the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods" (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade





mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide Section 21). A point has sometimes been raised as to whether the words “or cause confusion” introduce any element which is not already covered by the words “likely to deceive” and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words “likely to deceive”. But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks — the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff.”

**42.7** Another decision of significance, in this context, would be *K. R. Chinna Krishna Chettiar v Sri Ambal & Co.*<sup>33</sup>. In that case, the Supreme Court was concerned with snuff. The appellant and respondents were both manufacturers of snuff. The rival marks were “Sri Ambal” and “Sri Andal”. Both were device marks, with “Sri Ambal” and “Sri Andal” constituting the textual component of each. Pictorially and visually, they were completely different, and this fact is noted in para 7 of the judgment. Nonetheless, the Supreme Court held that, in view of the near phonetic identity of the expressions ANDAL and AMBAL, there was a likelihood of confusion and a

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<sup>33</sup> (1969) 2 SCC 131



*prima facie* case of infringement was made out. The decision would, *mutatis mutandis*, apply to the facts at hand. In that view of the matter, the visual difference in the appearance of the marks ACNESTAR and ACNESCAR would not make any difference, given the near phonetic identity between them.

**42.8** The learned Commercial Court has further noted the fact that, while the appellant's mark ACNESTAR was of the "medicinal class", the respondent's product ACNESCAR was of the "non-medicinal class". This, again, makes no difference. They are similar products, meant for treatment of similar ailments. They are available through the same trade channel and cater to the same consumer segment. The mark ACNESCAR, as used by the respondent, would, therefore, *ipso facto* infringe the mark ACNESTAR of the appellant within the meaning of Section 29(2)(b)<sup>34</sup> of the Trade Marks Act.

**42.9** Thus, the grounds on which the learned Commercial Court has sought to wish away the *Cadila* principle that, in the case of pharmaceutical products, a greater degree of circumspection is necessary, and that courts have to be cautious in ensuring that there is not even a slightest chance of confusion, given the primordial element of public interest involved in all such cases, cannot sustain. The principle applies with full force. As the rival marks were both products used for care of skin, and there is no dispute about the fact

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<sup>34</sup> (2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

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(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

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is likely to cause confusion on the part of the public, or which is likely to have an association with the



that the appellant's product is, in any case, a pharmaceutical product, the respondent could not have adopted the name ACNESCAR which was deceptively similar to the appellant's mark ACNESTAR as that was likely to mislead consumers into using the respondent's mark instead of the appellant's or *vice versa*. In either case, the products being products for application on the skin, severe consequences could conceivably ensue as a result of a wrong product being applied.

#### 43. The plea of non-use

43.1 Mr. Vidhani sought to contend that the appellant had not used its mark ACNESTAR in Class 5 in which it was registered.

#### 43.2 Plea erroneous in law

43.2.1 Though this assertion is incorrect on facts, we may first observe that non-user is not a defense against infringement in view of Section 28(1)<sup>35</sup> of the Trade Marks Act read with Section 29. "Infringement", as defined in the various sub-sections of Section 29, is not dependent on user of the infringed mark. It is dependent only on registration. Each sub-section of Section 29 starts with the word "a registered mark is infringed if..." What matters is, therefore, registration, not user.

43.2.2 This is also apparent from Section 28(1) of the Trade Marks

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registered trade mark.

<sup>35</sup> 28. **Rights conferred by registration.** –

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.



Act. The sub-section confers, on the registrant of a valid registration, two rights. The first is the exclusive right to use the mark in respect of the goods or services for which it is registered. The second is the right to remedy against infringement. Both these rights result as a consequence of registration of the mark. Section 28(1) does not refer to user. The remedy available against infringement are set out in Section 135(1)<sup>36</sup>, and they include, apart from damages, delivery-up, injunction against use of the infringing marks by the defendant.

**43.2.3** Non-user is, in fact, envisaged as a ground on which a mark can be sought to be removed from the register of trade marks. That, however, is an exercise which is subject to the rigours of Section 47<sup>37</sup> of the Trade Marks Act. Section 47 can only be invoked by application, and not *suo motu*. An applicant may apply for removal of a registered mark from the trade mark registry if two conditions, envisaged by Section 47, are simultaneously satisfied. The first is that the mark must not have been used for a continuous period of more than five years. The second is that there must be no user of the mark

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<sup>36</sup> **135. Relief in suits for infringement or for passing off. –**

(1) The relief which a court may grant in any suit for infringement or for passing off referred to in Section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

<sup>37</sup> **47. Removal from register and imposition of limitations on ground of non-use. –**

(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the High Court by any person aggrieved on the ground either—

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of Section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application; or

(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:



within three months prior to the date of application. It is only if an application, which subscribes to these requirements, is preferred in the office of the register of Trade Marks that the registrar can remove a mark from the register for non-user.

### 43.3 Plea erroneous on facts

43.3.1 That apart, even on facts, the submission is incorrect. The registration of the mark ACNESTAR, in favour of the appellant, is for pharmaceutical and medicinal preparation. The preparation that is manufactured, packed and sold by the appellant under the mark ACNESTAR is a combination of clindamycin and nicotinamide. Clindamycin is an antibiotic. By no stretch of imagination can it be said that a combination of clindamycin and nicotinamide is not a pharmaceutical and medicinal preparation.

43.4 Mr. Vidhani is, therefore, factually and legally incorrect in his assertion that the appellant cannot assert its ACNESTAR mark on the ground of non-user.

### 44. Prima facie evidence of validity by registration – Section 31(1)<sup>38</sup>

44.1 A mark which is not removed from the register and which subsists on the register is presumed to be valid.

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<sup>38</sup> 31. **Registration to be prima facie evidence of validity.** –

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity thereof.



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**44.2** Section 31(1) of the Act clearly states that the very fact of registration of a mark is *prima facie* evidence of its validity. At the stage of Order XXXIX Rules 1 and 2, therefore, registration of the plaintiff's mark itself discharges the onus on the plaintiff to prove that the mark is *prima facie* valid.

**45.** Prosecution history of Application 2520524

**45.1** Mr. Vidhani also sought to rely on prosecution history of appellant apropos Application no. 2520524 filed for registration of the mark ACNESTAR in Class 3 for bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, deodorants, essential oils, cosmetics, hair lotions and dentifrices. He has sought to rely on the opposition filed by Biomedica to the said application and the response of the appellant thereto.

**45.2** After the judgment of the Division Bench of this Court in ***Raman Kwatra***, this submission cannot survive. In ***Raman Kwatra***, it has clearly been held, in para 43 of the report, that prosecution history is relevant only where the history pertains to the rival marks. In other words, a stand adopted by the appellant when the respondent's mark is cited against the appellant in opposition may be relevant. However, a stand adopted by the appellant against Biomedica, apropos an opposition by Biomedica, cannot be relevant in a dispute between the appellant and the respondent, applying the law laid down in ***Raman Kwatra***.



**45.3 *S.K. Sachdeva***, on which the respondent seeks to place reliance, is completely distinguishable. As Mr. Sibal correctly points, the dispute in that case was essentially with respect to concealment. The Division Bench of this Court took a seriously adverse view of the fact that the prosecution history had been concealed by the plaintiff while instituting the suit. As against this, in the present case, the appellant has candidly disclosed, in its plaint, the facts relating to Application No. 2520524 as well as the opposition of Biomedica thereto and the counter statement of the appellant to the said opposition. There is, therefore, no suppression or concealment of facts as was present in *S K Sachdeva*.

**46. Re. prayer in the plaint**

**46.1** Mr. Vidhani also sought to contend that the prayer of the appellant in the plaint was only for an injunction against the respondent infringing the appellant's mark ACNESTAR with respect to medicinal and pharmaceutical preparations. We feel that the manner in which Mr. Vidhani reads the prayer is not correct. The very injunction against infringement, as is sought, would encompass use, by the respondent, of any mark which is confusingly or deceptively similar to ACNESTAR. The words "with respect to medicinal and pharmaceutical preparations" follow "ACNESTAR" and, therefore, are apparently intended to refer to the registration held by the appellant in the mark ACNESTAR, and not to the use of which appellant seeks an injunction.





**46.2** We are not in agreement with Mr. Vidhani, therefore, that the plaint instituted by the appellant merely sought an injunction against the use by the respondent, of the mark ACNESCAR with respect to medicinal and pharmaceutical preparations. Indeed, there is nothing of the kind to be found in the prayers in the plaint.

### The Sequitur

**47.** The sequitur of the above discussion is obvious. The case is plainly one of infringement of the appellant's registered trade mark ACNESTAR, by use, by the respondent, of the nearly phonetically identical and, therefore, deceptively similar mark ACNESCAR, for skin preparations.

**48.** We are, therefore, of the opinion that the learned Commercial Court has not proceeded on the correct principles and has erred in refusing to grant interim injunction to the appellant.

**49.** As a result, the impugned order dated 3 May 2024 passed by the learned Commercial Court is quashed and set aside.

**50.** Resultantly, pending disposal of the suit by the learned Commercial Court, the respondent as well as all other acting on its behalf shall stand restrained from using the mark ACNESTAR, or any other mark which is confusing or deceptively similar to the said mark for pharmaceutical or medicinal products or skin cream or any other allied or cognate goods or services. The injunction shall extend not only to manufacture of any infringing products by the respondent but



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also to release into the market of any stock of infringing goods which may be available with them.

**51.** The interim application of the appellant before the learned Commercial Court shall stand allowed to the aforesaid extent.

**52.** The appeal stands allowed in the aforesaid terms with no orders as to costs.

**53.** The observations contained in this judgment are only for disposing of the application filed by the appellant for interim relief and would be treated as binding on the learned Commercial Court when adjudicating on the *lis*.

**C. HARI SHANKAR, J.**

**OM PRAKASH SHUKLA, J.**

**SEPTEMBER 22, 2025**

*dsn/aky/yg/ar*