

Mankind Pharma Limited vs Preet Kamal Grewal And Anr on 2 April, 2025

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C.O. (COMM.IPD-TM) 279/2022
MANKIND PHARMA LIMITEDP
Through: Mr. Hemant Daswani, Ms. Saumya
Bajpai and Ms. Pranjal, Advocat
versus
PREET KAMAL GREWAL AND ANR.Respondents
Through: Mr. Shashank Dixit and Mr. Rohit
Gupta, Advocates
CORAM:
HON'BLE MR. JUSTICE SAURABH BANERJEE
JUDGMENT

PREFACE:

1. The petitioner, by this petition under Section 57 of the Trade Marks Act of 1999 1, seeks removal of the impugned trademark 'KINDPAN'² registered vide trademark application no. 2795896, in Class 5 of the Act, in the name of respondent no.1.

BRIEF CONSPECTUS:

2. Though the petitioner, a leading pharmaceutical company involved in the manufacturing and marketing of medicinal, pharmaceutical and veterinary preparations under various brand names, including the trademark hereinafter referred to as the "Act"

hereinafter referred to as the "impugned mark"

'MANKIND,' was incorporated in the year 1991, it was its predecessors-in- interest, through its Chairman and Founder, trading under the name 'MANKIND PHARMA,' who adopted the trademark 'MANKIND' in the year 1986.

3. The petitioner is recognised as a substantial player in the pharmaceutical industry, having generated the highest number of 'Prescriptions per Month per Doctor'³ in the year 2011, as per the PMD Audit for that year. The 24 top 'KIND' brands of the petitioner, for the year 2018, have reportedly generated an audited annual turnover of over Rs. 1,300/- Crores. As per the Chartered Accountant Certificate filed by the petitioner, it had achieved an annual turnover of Rs.3923 Crores for the financial year 2017-2018, Rs. 3877 Crores for the financial year 2018-2019 and Rs. 4794

Crores for the financial year 2019-2020. The said CA Certificate has been filed herewith as Exhibit-H.

4. The petitioner is the registered proprietor of the trademark 'MANKIND' in Class(s) 1 to 45 of the Act and, furthermore, has more than 300 trademarks incorporating the element 'MANKIND' or 'KIND' as part of their trademarks across various classes in its name. A composite list of registration certificates issued by the Trademark Registry 4 has been collectively filed herewith as Exhibit-E in the list of documents. The petitioner has various websites and is into extensive promotional activities hereinafter referred to as the "PDM"

hereinafter referred to as the "respondent no. 2."

through various media channels. A compilation of various news clippings pertaining to the business activities has been filed herewith as Exhibit-K (Colly.).

5. The petitioner has been continuously and uninterruptedly using the trademark 'MANKIND' since its adoption for the first time in the year 1986. In fact, the said trademark 'MANKIND' of the petitioner has also been declared a "well-known trademark" in terms of Section 2(1)(zg) of the Act in Journal No.1978 dated 14.12.2020, which has been filed herewith as Exhibit- N.

6. In the meanwhile, the respondent no.1, a proprietorship firm based out of Ludhiana, Punjab, of one Mr. Preet Kamal Singh, trading as M/s Sanavita Medicare, has been granted registration for the trademark 'KIND' vide registration no. 2795896 dated 22.08.2014, in Class 5 of the Act, for medicinal and pharmaceutical preparations. Interestingly, the respondent no.1 applied for the registration on a "proposed to be used" basis. It is noteworthy that during that period, the petitioner herein, was already a subsisting registrant/ owner of the very same trademark 'KIND' vide registration no. 2457970 dated 10.01.2013 in Class 5 of the Act for medicinal, pharmaceutical and veterinary preparations.

7. Thus, the present petition, initially filed before the Intellectual Property Appellate Board, New Delhi 5, was received on transfer to this Court after its dissolution. The respondent no.1, despite due service, has never entered hereinafter referred to as the "IPAB"

appearance in the present proceedings and the respondent no.2, despite entering appearance, has not filed its reply either. Therefore, vide order dated 11.12.2023 passed by this Court, the respondent no.1 was proceeded ex- parte, as the latter had failed to enter its appearance throughout the course of the present proceedings.

SUBMISSIONS OF THE PETITIONER:

8. Learned counsel for petitioner reiterated the aforesaid and also took this Court through the various documents in support thereof. In short, he submitted that the petitioner has been using the 'MANKIND' mark since the year 1986 through its

predecessor, and that it is the registered proprietor of the said mark across all 45 classes of trademarks. Not only that, the petitioner is also the subsisting registrant/owner of the very same trademark 'KIND' vide registration no. 2457970 dated 10.01.2013 in Class 5 of the Act for medicinal, pharmaceutical and veterinary preparations. As per learned counsel the petitioner, over a span of several years, the petitioner has come to acquire substantial reputation and goodwill in the pharmaceutical industry, both in India and abroad. Primarily, he contended that the element 'KIND' is the signature mark of the petitioner, which functions as a source identifier of the myriad of products marketed and sold by it.

9. Learned counsel submitted that the use of the 'KIND' family of marks in connection to pharmaceutical preparations, is neither generic nor descriptive nor laudatory and, thus, the petitioner is vested with the exclusive right of usage of the said family of marks. For this, he relied upon *Mankind Pharma Limited v. Cadila Pharmaceuticals Limited* 6, wherein it has been held that the petitioner's long-standing use of the 'KIND' family of marks provided sufficient ground to it for heightened protection of its marks. The learned counsel has also placed reliance on the decisions of this Court, as rendered in the cases of *Caterpillar Inc. v. Mehtab Ahmed & Ors.*⁷ and *Bata India Ltd. v. Chawla Boot House*⁸. In both cases, this Court has held that despite any generic or descriptive connotations, the long-standing, extensive use of the marks had endowed the plaintiffs in the said matters with inherent distinctiveness and secondary meaning, thereby vesting the petitioners with exclusive rights over their respective families of marks.

10. Learned counsel further submitted that the mark with the element 'KIND' is being used by the petitioner in a fanciful and arbitrary manner within the pharmaceutical industry and has no direct or even remote reference to any characteristic or description of the goods that it markets and sells. Consequently, it is contended, that the exclusive right to use the mark is vested solely in the petitioner. For this, he relied upon *Kirorimal Kashiram Marketing and Agencies Pvt. Ltd. v. Shree Sita Chawal Udyog* 9 wherein, it has been held that it is impermissible to replicate a substantial element of another party's registered trademark, particularly, when such a word mark is arbitrarily adopted in relation to the products in question.

2015 SCC OnLine Del 6914 2002 SCC OnLine Del 865 2019 SCC OnLine Del 8147 2010 SCC OnLine Del 2933

11. Relying upon 'McCarthy on Trademarks and Unfair Competition' (Thomson West, 2006), Volume IV, 4th edition, learned counsel then submitted that even where the impugned mark does not directly infringe any individual mark of the petitioner, its use may, nevertheless, constitute an infringement upon the petitioner's entire family of trademarks. For this, he relied upon *Mankind Pharma Ltd. v. Arvind Kumar Trading*¹⁰, which involved the same petitioner herein, as also its registered trademark 'MANKIND', wherein, after observing that even minor variation to a mark that retains the discerning element 'KIND' are likely to cause confusion in both trade and public

perception, held that the petitioners' multitudinous registrations, bearing the prefix 'KIND' have served to establish, in favour of the latter, a 'KIND' family of marks. As per learned counsel, the aforesaid also stands affirmed by the Hon'ble Supreme Court in *Shree Vardhman Rice and General Mills v. Amar Singh Chawalwala* 11, and that the said position can also be inferred from what has been held in *Amar Singh Chawal Wala v. Shree Vardhman Rice and Genl. Mills*.¹²

12. Learned counsel then asserted that as the first user of the word 'KIND' in the pharmaceutical market, it is entitled to higher protection, and no third party should be permitted to appropriate the essential and predominant part of its marks. In any manner, the petitioner has been vigilant in protecting its intellectual property rights, particularly with respect to preserving the 2023 SCC OnLine Del 2265 (2009) 10 SCC 257 2009 SCC OnLine Del 1690 exclusivity of its 'MANKIND' and 'KIND' family of marks at all times. In an effort to police the market against infringers, the petitioner has filed various oppositions, served notices, and instituted suits to prevent any dilution or unauthorized use of its marks. For this contention learned counsel took this Court through Exhibit-M (Colly.) of the present petition, which entails the details of the various proceedings initiated by the petitioner from time to time before various forum(s) of Law to protect its mark 'KIND'.

13. Thence, relying upon *Mankind Pharma Limited v. Novakind Bio Sciences Private Limited* 13, wherein a co-ordinate bench of this Court held, *mutatis mutandis*, that the mark 'NOVAKIND' used for pharmaceutical preparations, was confusingly similar to the trademark 'MANKIND' of the petitioner. As per learned counsel, the same reaffirmed that the suffix 'KIND' has, through extensive use, become a dominant source identifier for the petitioner's products.

14. Lastly, as per the learned counsel, adoption of the element 'KIND' by the respondent no.1 confers an undue advantage on it, thereby enabling it to springboard its activities in the pharmaceutical field, which is an opportunity it would otherwise not be able to exploit. The said adoption by the respondent no.1 is nothing but an attempt at unduly encash upon the goodwill and reputation of the petitioner, knowing fully well that it is the leading marketer and manufacturer of pharmaceutical products using the mark 'KIND'. The latter fact being rather evident from the slew of marketing 2023 SCC OnLine Del 4806 materials, advertisements, several invoices evincing the spread of its business domestically as well as internationally. In fact, a Coordinate Bench of the Bombay High Court has in *Neon Laboratories Ltd. v. Themis Medicare Ltd.*¹⁴ held as under:-

"11. [...] If there be a series of marks registered to a single proprietor, a new mark with a feature prominent in that series leads to a perfectly natural assumption by a consumer that the new mark, too, emanates from the same proprietor."

ANALYSIS & FINDINGS:

15. This Court has heard the learned counsel for the petitioner and has also gone through the documents on record, along with the relevant judgments on the issue cited at the Bar.

16. Before delving into the facts of the present case, as noted in paragraph 7 hereinabove, considering the factual matrix involved and the conduct of the respondent nos. 1 and 2, the right to file their respective replies is closed.

17. As is borne out from the records before this Court, none of the respondents, particularly the respondent no.1, despite being duly served, have filed any response to the averments raised by the petitioner in the present petition, as such there being no specific or even general denial of any of the pleadings made by the petitioner, therefore, under such circumstances all the said averments made therein, without any response/ denials thereto, are deemed admitted as true.

2014 SCC OnLine Bom 1087

18. In view thereof, the undeniable/ admitted facts are that the trademark 'MANKIND' and 'KIND' family of marks belonging to the petitioner are unique and fanciful, neither generic nor laudatory and have no direct connection with the petitioner nor with the goods falling in Class 5 of the Act for which they are being used; and that the petitioner is the prior adopter thereof; and that the petitioner has been using them from the time of its first inception way back in the year 1986; and the petitioner is the owner and registered proprietor of the said 'MANKIND' and 'KIND' family of marks; and today the petitioner has gained such reputation and developed a goodwill in the said 'MANKIND' and 'KIND' family of marks that they are identified/ connected with the petitioner, and it only, and especially when they are qua medicinal, pharmaceutical and veterinary preparations in Class 5 of the Act; and the petitioner has all throughout, from time to time, ever-zealously protected the said 'MANKIND' and 'KIND' family of marks; and when the respondent no.1 applied for the registration of the impugned mark in the same Class 5 of the Act, the petitioner had already been granted registration for the very same trademark 'KIND' vide registration no. 2457970 dated 10.01.2013 in Class 5 of the Act for medicinal, pharmaceutical and veterinary preparations by the very same respondent no.2; and that the respondent no.1, in any ways, applied for registration of the impugned mark on a "proposed to be used" basis.

19. The aforesaid and the conduct(s) of the respondent no.1 establishes that there was no plausible occasion and/ or reason for it to first adopt and then apply for the very impugned mark 'KIND' as that of the petitioner and which is similar in more than one way to the trademark 'MANKIND' and 'KIND' family of marks belonging to the petitioner. The same casts a shadow of doubt since the respondent no.1 was in the same field of offering the very same medicinal and pharmaceutical preparations as the petitioner. The only plausible occasion and/ or reason for doing that is seemingly that the respondent no.1 wanted to encroach upon the established goodwill and built-up reputation of the petitioner in and to the trademark 'MANKIND' and 'KIND' family of marks to establish a possible connection with the petitioner as also to potentially causing confusion amongst the members of the trade, the general public and all. All these amount to diluting the distinctiveness of the trademark 'MANKIND' and 'KIND' family of marks belonging to the petitioner.

20. Thus, in view of the aforesaid submissions made by the learned counsel for the petitioner as also considering the aforesaid factual matrix involved, the registration of the impugned mark in the name of respondent no.1 is not sustainable and is liable to be taken off.

21. Since, the position of law qua the aforesaid aspects in Caterpillar Inc. (supra), Bata India Ltd. (supra), Kirorimal Kashiram M&APL (supra), Shree Vardhan R&GM (supra), Amar Singh Chawal Wala (supra) and Neon Laboratories Ltd. (supra), as detailed hereinabove, is well-settled, there is no reason for keeping the impugned mark alive. Moreover, the various pronouncements qua recognition of the trademark 'MANKIND' and 'KIND' family of marks belonging to the petitioner in its favour, in Mankind PL v. Cadila Pharmaceuticals Limited (supra), Mankind Pharma Ltd. v. Arvind Kumar Trading (supra) and Mankind Pharma Limited v. Novakind Bio Sciences Private Limited (supra), as detailed hereinabove, also reinforce the case of the petitioner herein.

22. Resultantly, this Court has no hesitation in holding that the registration of the trademark 'KIND' granted to the respondent no.1 is contrary to the provisions of Section(s) 11(1) and 11(2) of the Act and thus liable to removal/ cancellation/ strike off from the Register of the Trade Marks Registry and that the petitioner, as the prior adopter, user, and registered proprietor of its well-known 'KIND' family of marks, is a person aggrieved within the meaning of Section 57(2) of the Act.

23. Accordingly, the present petition is allowed and the Trade Marks Registry is directed to remove the impugned trademark 'KINDPAN' registered vide trademark no. 2795896 in Class 5 of the Act, issued in the name of respondent no. 1.

24. The Registry is directed to send a copy of the present order to the Trade Marks Registry for compliance.

25. The present petition is disposed of.

SAURABH BANERJEE, J April 02, 2025/So