

Legal Issues in ‘Pharmaceutical-Trademarks’

Topic: ‘Whether Pharmaceutical Trademarks derived from Generic Names can be Exclusive to a Proprietor?’

Relevant Legal Provisions

❖ Section 13, Trade Marks Act, 1999

“13. Prohibition of registration of names of chemical elements or international non-proprietary names.—No word—

*(a) which is the **commonly used and accepted name** of any single chemical element or any single chemical compound (as distinguished from a mixture) in respect of a chemical substance or preparation, or*

*(b) which is declared by the World Health Organisation and notified in the prescribed manner by the Registrar from time to time, as **an international non-proprietary name or which is deceptively similar to such name,***

shall be registered as a trade mark and any such registration shall be deemed for the purpose of section 57 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register, as the circumstances may require.” (emphasis supplied)

Relevant Legal Provisions (Contd.)

❖ Section 28, Trade Marks Act, 1999

- “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.***
- (2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject... ” (emphasis supplied)*

Relevant Judicial Decisions

❖ **Panacea Biotec Ltd. v. Recon Ltd., AIR 1997 Delhi 244**

“5... it would be convenient to juxtapose the trade mark of the plaintiff with the name of the drug of which it is composed: 'NIMULID' -- 'NIMESULIDE’”

*“6. From a comparison of the two it is clear that the first three letters of the trade mark of the plaintiff have been taken from the name of the drug four letters which are 'ULID' and the same have also been taken from the last but four letters of the name of the same drug 'Nimesulide'.... It appears that the plaintiff has adopted trade mark 'NIMULID' in view of its near similarity or resemblance with the name of the basic drug 'Nimesulide'. **In fact 'NIMULID' can be taken as short form for the generic name of the drug 'Nimesulide'.** The trade mark of the plaintiff is descriptive in nature indicative of the composition of the medicine. It is well settled that no person can claim exclusive use of the descriptive and generic terms. **It would be highly undesirable to confer on one trader proprietary right over the use of an ordinary, descriptive or a generic word indicative of the nature, composition and quality of the goods as that would give him complete monopoly to exploit the word to the exclusion of others.** A word which can qualify as an exclusive mark of a trader must be distinctive so as to distinguish his goods from those of the other persons.*

Relevant Judicial Decisions (Contd.)

❖ **Schering Corporation & Ors. v. Alkem Laboratories Ltd. [2010 (42) PTC 772 (Del) (DB)]**

“2. These interim applications had been filed to seek grant of an interim injunction to restrain the Respondent from using the marks TEMOKEM and TEMOGET respectively in relation to their pharmaceutical products - the active ingredient whereof is TEMOZOLOMIDE, a drug administered for the treatment of brain cancer.”

“5. The mark TEMODAL existed in the appellants' portfolio...”

The Court noted that the word "TEMO" was used for an active ingredient 'TEMOZOLOMIDE' by several parties apart from the respondents. The Coordinate Bench held that, prima facie, the word "TEM/TEMO" is publici juris and also generic for and descriptive of the chemical component 'TEMOZOLOMIDE' and, therefore, the appellant cannot claim an exclusive right to use thereof

Relevant Judicial Decisions (Contd.)

- ❖ **Sun Pharma Laboratories Ltd v. Ajanta Pharma Ltd. [CS (COMM) 622/2018 & I.A. 12663/2014, Judgement dated May 10, 2019, Delhi High Court]**

“2....The dispute between the Plaintiff and the Defendant in the present case is in respect of two products used by patients of age related dimness of vision and diabetic retinopathy. They are sold under the trademarks 'GLOEYE' and 'GLOTAB' Both are ocular medicines.”

“5. ...It is submitted that the prefix 'GLO' is derived from 'hemoglobin”

“21. ... In the category of anti-oxidant ophthalmic drugs, there are only two products with prefix 'GLO' i.e. 'GLOEYE' and 'GLOTAB'. The Defendant has not brought on record any other product with the prefix 'GLO' in this category of products. The physical products that have been placed on record by the Defendant using the prefix 'GLO' are in respect of toothpaste (Glodent), a facewash (Glogeous), a gel (Glocin) and two products by the name Globac-Z and Globac-XT which are multi-vitamin products. None of this constitutes relevant third party use, which would justify the use of the word prefix 'GLO' in respect of anti-oxidant ophthalmic products.

Relevant Judicial Decisions (Contd.)

❖ **Ranbaxy Laboratories Ltd. v. Indochemie Health Specialities Pvt. Ltd. [11 2013 (55) PTC 380 (Bom)]**

11. ... , is to be considered is that the basic drug used by the Plaintiff is "Ofloxacin". Their mark is "Zanocin". It is clear that the mark of the Plaintiff is substantially derived from name of the basic drug used by them. Similarly, the basic drug used by the Defendant is "Cefuroxime". Their mark is "Zenoxirn". It is the case of the Defendant that its mark is substantially derived from the name of the basic drug used by it. Thus, the marks adopted by both the parties are derived from the name of the basic drug that is sued by them. The marks are thus, descriptive in nature being indicative of the composition of the medicine. The Delhi High Court has considered this aspect in its judgment in the case of M/s. Panacea Biotec Ltd, K Mis. Recon Ltd. 1996 PTC 16 ... I find myself in respectful agreement with the above view."

Relevant Judicial Decisions (Contd.)

❖ **Sun Pharmaceutical Laboratories v. Hetero Healthcare Ltd. & Anr. [FAO (COMM) 96/2022, Judgement dated August 26, 2022, Delhi High Court]**

“4. SUN (Plaintiff) ... manufactures a generic drug for second line treatment of advanced breast cancer containing an active ingredient 'LETROZOLE' under the trademark 'LETROZ’.”

“13. HETERO contends that it is common practice in the pharmaceutical industry to use trademarks derived from the active pharmaceutical ingredient (API). It further argued that the mark 'LETRO' is a registered trademark of HETERO and is coined by combining the first two letters of the salt 'LETROZOLE' with the last four letters of HETERO, that is, 'TERO’.”

19. ⁸...the list of international non-proprietary names (INN) ...clearly shows that the word 'LETROZOLE' is an international non-proprietary name and cannot be registered.

Relevant Judicial Decisions (Contd.)

“20. Section 13 of the Trade Marks Act, 1999, specifically provides that no word or a word deceptively similar to such name which is declared by the World Health Organization and notified in the prescribed manner by the Registrar from time to time, as an international non-proprietary name, shall be registered as a trademark.”

“28. In the present case, it is apparent that the mark adopted by SUN is nothing but the first six letters of the INN. The question whether the trademarks are similar has to be considered bearing the aforesaid in mind.”

Conclusion

- ❖ Pharmaceutical Trademarks are largely named after the active pharmaceutical ingredient (API) that is incorporated in the pharmaceutical preparation. As such chemical ingredients/compounds are common to trade, such marks are usually protected only upon determination of either the distinctive character/ repute gained through continuous use or when such common names are combined with uncommon features to create an invented mark.
- ❖ It is an established principle of law that members of the trade and/or public will give more regard to the uncommon elements or new features in the mark, thereby, a trademark derived from a generic drug names are considered distinctive as a *whole*.
- ❖ Therefore, when a trademark has been derived from the name of its generic ingredient, having no inventive or uncommon elements constituting a composite mark, there exists no exclusive right over the generic component of the mark.

Thank you!
Questions?

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