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REGISTRATION OF SIMILAR TRADEMARKS

The Delhi High Court (HC) observed in the *Mankind Pharma*¹ case that simpliciter registration of a mark in another jurisdiction does not entitle a person or an entity for registration of the same in India.

Brief Facts.

- Mankind Pharma Limited (MPL) in Delhi was engaged manufacture and marketing of medicinal and pharmaceutical products using the trademark FLORA since 1995.²
- MPL has held the trademark FLORA since its registration in 2007³ under the trademark Class 5.⁴
- Zhejiang Yige Enterprise Management Group Co. Ltd. (ZYEM) is a Chinese Pharmaceutical company with a product line in India, applied for the mark 'FLORASIS' for products such as sanitary towels, breast pads, baby napkins, under Class 5, on 'proposed to be used' basis.⁵
- Before the Deputy Registrar of Trademarks, MPL filed opposition stating that ZYEM's mark was deceptively similar and there was an inherent likelihood of causing confusion among the public.
- ZYEM on contended that the mark 'FLORASIS' is unique to the Indian context, particularly in reference to the combination of Mandarin characters that gave it the name. 'FLORASIS' was allowed to proceed for registration, on the observation that 'FLORA' and 'FLORASIS' were visually, phonetically, and structurally different.
- Aggrieved by the decision of the Deputy Registrar, MPL appealed before the Delhi High Court (HC).
- The matter proceeded *ex-parte* on the ZYEM's end.
- A visual comparison of the trademarks are as below:



花西子
Florasis

¹ *Mankind Pharma Limited vs Zhejiang Yige Enterprise Management Group co. Ltd. & Anr*, 2025 LiveLaw (Del) 557.

² Paragraph 2 of the judgement.

³ Paragraph 3 of the judgement.

⁴ Pharmaceuticals

⁵ Paragraph 4 of the judgement.

Questions of Law.

Whether there existed a deceptive similarity between MPL's registered trademark 'FLORA' and ZYEM's 'FLORASIS'?
Whether such similarity was likely to cause confusion among the public?

MPL's Contentions.

- Contended that the Deputy Registrar's order overlooked the established principles of law relating to prior statutory right, the need for exercising higher caution in the pharmaceutical and healthcare industry as well as the likelihood of confusion.
- Argued that there must be a stricter comparison for pharmaceutical preparations.
- Relied on the judgment of *Cadila Health Care*,⁶ a landmark judgement on this principle.
- Contended that ZYEM cannot claim entitlement to a registration based on the international adoption of the word since 2017, as it is not a well-known trademark within the meaning of the Trademark Act 1999 (**TM Act**), and having international registration or usage outside of India does not confer superior rights over a prior registered proprietor in India.⁷
- Concluded that the mark 'FLORASIS' is liable to be refused under Section 11(1)(a) and 11(1)(b) of the TM Act⁸, due to its identity/deceptive similarity to the earlier registered trademark 'FLORA'. *Novartis AG vs. Crest Pharma Pvt. Ltd.*⁹ & *Milmet Ofibo Industries & Ors. vs. Allegran Inc.*¹⁰ cases were also relied upon.

HC's Decision & Reasoning

The HC Observed that:

- The impugned mark 'FLORASIS' was deceptively similar to the registered trademark 'FLORA'.
- Adding a Mandarin character does not create any distinctiveness for allowing registration.¹¹
- MPL is the prior and continuous user of the trademark, as well as the registered proprietor.
- Observed that any form of confusion, doubt, or deception in the minds of the general public must be strictly avoided with the highest degree of care and caution, as it could pose a serious risk to public health and well-being.¹²
- A simpliciter registration of a mark in another jurisdiction, does not entitle a person or an entity for registration in India.¹³
- MPL, being a registered proprietor of the trademark 'FLORA' is entitled to invoke the appellate jurisdiction of the court under Section 91¹⁴ of the TM Act.

The appeal was allowed¹⁵ and the Deputy Registrar's order was set aside.

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⁶ *Cadila Health Care Limited Vs Cadila Pharmaceuticals* (2001) 5 SCC 73.

⁷ Paragraph 9.7 of the judgement.

⁸ Section 11 of the Trademarks Act – (1) A trademark is not to be registered because of (a) its identity with an earlier trademark and similarity of goods and services covered by the trademark (b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, if there may be a likelihood of confusion on the part of the public, even if it may be an association with the earlier trademark.

⁹ *Novartis AG vs. Crest Pharma Pvt. Ltd* (2009) SCC OnLine Del 4390.

¹⁰ *Milmet Ofibo Industries & Ors. vs. Allegran Inc* (2004) 12 SCC 624.

¹¹ Paragraph 18 of the judgement.

¹² Paragraph 16 of the judgement.

¹³ Paragraph 17 of the judgement.

¹⁴ Paragraph 21 of the judgement.

¹⁵ Paragraph 22 of the judgement.