

IN THE HIGH COURT OF SINDH, KARACHI

HCA No. 134 of 2015

Novartis AG
vs.
Nabiqasim Industries (Private) Limited & another

Before: Mr. Justice Sajjad Ali Shah, Chief Justice

Mr. Justice Zulfiqar Ahmad Khan

Date of Hearing : 09.02.2017
Appellant : Novartis AG through Amna Salman, Advocate
Respondents : Nabiqasim Industries (Private) Limited through
Mirza Mehmood Baig, Advocate

JUDGMENT

Zulfiqar Ahmad Khan, J. :- Appellant claim to be global owner and registrant of trade mark LESCOL in relation to pharmaceuticals and have secured registration of the said mark in Class 5 with the Pakistan Trade Marks Registry w.e.f. 19.02.1991 under Registration No.109707 and calmly have been effectively using the same trade mark in Pakistan since 1995 after the same having been registered with the Drug authorities in relation to generic compound *Fluvastatin* containing medicaments for the treatment hypercholesterolemia. To the contrary, the respondents claim to have adopted trade mark DESCOL independently and had it registered with Drug authorities in 2007, however admit that the said trade mark is not registered with the Trade Marks Registry as yet, and submits that while the respondents were in the earlier stages of developing their brand, Suit No. 1203 of 2007 was filed by the current appellant restraining the respondents from using their trade mark, which injunction continued till it was vacated by the impugned order dated 03.02.2015, against which the instant appeal was

filed on 23.04.2015, in which interim stay was granted in favour of the appellant restricting the respondents from using the trade mark DESCOL.

A review of the learned Single Judge's impugned order passed in CMA No.8055/2007 shows that the learned Single Judge while admittedly having recognized that both the trade marks are used in relation to pharmaceutical and medicinal products, however, applied the totality of impression test while physically examining the two packagings, which undoubtedly are distinctive as to their shape, colour and size. The learned Single Judge in fact also took into consideration that since both the products are prescription medicines, where pharmacists only sell them upon examination of a doctor's prescription, therefore, there is very little likelihood that people will be deceived, since per learned Single Judge, the pharmacists have the special knowledge and special eye in this regard. In the later part of the impugned order, the learned Single Judge admits that while both the marks are phonetically similar, however, observing that both have different prefix, and placing reliance on GLUCOPHAGE vs. GLUCONORM (which was also medicines) reached to the conclusion that there is very little likelihood of buyer being misguided or confused on account of phonetically similarities between LESCOLO and DESCOL. Reliance has also been placed on a case where question arose between the deceptive similarities of CIPROXIN, CIPROQUINE and CIPROCIDE trade marks (2003 CLD 794).

As mentioned earlier, the learned counsel for respondents while admitted that the trade mark DESCOL is not registered, however, placed reliance on the registration of the said medicine with the Drug Authorities, which claim was rightly refuted by the counsel for the appellants contending that mere registration of a drug name under Drug law does not give right to the registrant to sell the said drug in the market, as with regards to products being sold in the market place under a particular mark, the Trade Mark laws govern such use of the drug's name.

Heard the counsel and reviewed the record.

With regard to the contention of the prescription drugs only being sold by pharmacists upon a doctor's advice thereby reducing the chances of deception and confusion, guidance could be sought from *Glaxo Laboratories Limited vs. Assistant Registrar Trade Marks Karachi (PLD 1977 Karachi 858)*, where the Court while looking into peculiar circumstances of Pakistan, where drugs are usually sold without prescriptions and most of the times no specialist pharmacist is available at the drug store, the Court came to the conclusion that in our country since no such precautions are taken and use of wrong drug could be fatal and in particular when usually prescriptions are hand written and illegible, therefore, the possibility of mistaking the one (deceptively similar) medicine from another cannot be excluded. The said judgment placed particular emphasis that in the case of pharmaceutical products, public must be protected from the possibility of confusion and tilted the due diligence balance from pharmacists to the unwary purchasers and held that these are the ultimate purchasers who have to be taken into consideration and who are likely to be misled by imperfect recollection of the mark, and not to the so called expert chemists.

With regards learned Single Judge's consideration of the case of *Glucophage vs. Gluconorm*, the said could be distinguished since therein the prefix "Gluc" was a short form of publically available word "Glucose". These were both antibiotics and could be used as substituted products (one for the other), which share similar generic name as Ciprofloxacin and were taken for the treatment of diabetes.

The case at hand is of two medicines used for the treatment of different ailments as mentioned earlier, and whose generic names are also different. For LESCOL it is *Fluvastatin* and for DESCOL it is *Atorvastin*.. While the first one is used for the treatment of diabetes, the second is used as lipid-

lowering agent for the prevention of cardio vascular diseases, meaning thereby used in cases of heart attack, therefore, a small mistake could be fatal for the user and no possibility of deception could be allowed.

While public health concerns (eg, drug name mistakes) are not strictly relevant to the issue of trade mark registration, however courts and drug authorities around the globe agree that they may be seriously considered when assessing the issue of confusion between drug names. In *Sanofi-Aventis v GlaxoSmithKline Biologicals SA* ((2010) 89 CPR (4th) 378 (TMOB)) the Canadian Trade Marks Opposition Board considered the issue of medication errors as a surrounding circumstance contributing to the likelihood of confusion between the trademarks PACIRIX and PLAVIX. The Board found both the marks to be confusing even though they were associated with different pharmaceutical preparations and end-uses.

One other aspect that we need to consider in case where a new entrant in the market-place adopts an already existed distinctive and established trade mark is to make a query as to why the latter entrant had chosen a trade mark deceptively similar with one that had existed long before. When we posed this question to the learned counsel for the respondents as to why his client chosen to use a similar six letter word for which only the first letter "L" was replaced with the letter "D" (LESCOL vs. DESCOL), the learned counsel had no satisfactory answer.

It is for the aforesaid reasons that we set aside the impugned order and allow the instant appeal by allowing CMA No. 8055/2007 and expect that the main suit is decided within six months.

Judge

Chief Justice