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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
 + C.A.(COMM.IPD-TM) 153/2021
 ELYON PHARMACEUTICALS PVT. LTD. Appellant
 Through: Ms. Niranjana Kaur, Adv.

versus

THE REGISTRAR OF TRADEMARKS Respondent
 Through: Mr. Harish Vaidyanathan
 Shankar, CGSC with Mr. Srish Kumar
 Mishra, Mr. Sagar Mehlawat and Mr.
 Alexander Mathai Paikaday, Advs.

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR

J U D G M E N T (O R A L)

% **23.08.2023**

1. This is an appeal against an order dated 27 August 2018 passed by the Examiner of Trade Marks in the office of the Registrar of Trade Marks, whereby Application No. 2668081, filed by the appellant, seeking registration of the word mark “ELMENTIN” for a pharmaceutical composition of Amoxycillin and Clavulanic Acid, stands rejected by the Examiner under Section 11(1)(b)¹ of the Trade Marks Act 1999. The ground of rejection is that the mark is deceptively similar to an existing earlier trade mark “ELEMENTAL”, also registered in respect of medicinal and pharmaceutical

¹ 11. **Relative grounds for refusal of registration. –**

(1) Save as provided in Section 12, a trade mark shall not be registered if, because of –

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,
 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.



preparations in Class 5, in favour of one Juggat Pharma Pvt. Ltd.

2. I have heard Ms. Niranjana Kaur, learned Counsel for the appellant and Mr. Harish Vaidyanathan Shankar, learned CGSC for the respondent.

3. Ms. Kaur submits that the marks “ELMENTIN” and “ELEMENTAL” cannot be treated as phonetically similar and that, therefore, the ground of rejection of the appellant’s application is without basis.

4. Mr. Harish Vaidyanathan Shankar reiterates the grounds contained in the impugned order and submits that the phonetic difference between “ELEMENTIN” and “ELEMENTAL”, if anything, is miniscule and that, as “ELEMENTAL” already stood registered under the same class for medicinal and pharmaceutical preparations, there is no cause for this Court to interfere with the impugned order dated 27 August 2018 passed by the learned Examiner of Trade Marks.

5. Having examined the matter and considered the rival submissions, I am of the opinion that it may not be correct to hold that the word “ELEMENTIN” is phonetically similar to “ELEMENTAL”.

6. The two words, properly articulated, have distinctly different sounds. Even the concluding syllable of the two words is different. Phonetic similarity for the purposes of likelihood of confusion



between words in trade mark jurisprudence, it is settled, has to be assessed on the basis of the following test enunciated in *In re. Pianotist Co.'s Application*², accorded approval by the Supreme Court in, *inter alia*, *Amritdhara Pharmacy v. Satya Deo Gupta*³ and *Khoday Distilleries v. Scotch Whisky Association*⁴:

“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks are used in a normal way as a trade mark for the goods of the respective owners of the marks.”

Applying the *Pianotist*² standard, it is difficult to accept the finding, of the learned Examiner, that ELEMENTIN and ELEMENTAL, when used for pharmaceutical preparations, are so similar to each other as to confuse the public. They look different. “ELEMENTAL”, as an adjective of “element”, is a word of common English usage, synonymous with “fundamental”, whereas “ELEMENTIN” is clearly a coined word, which has no etymological meaning. They sound different. ELEMENTIN has three syllables, ELEMENTAL has four. The concluding syllables – which are known to convey a distinct ocular impression when pronounced – are also different. ELEMENTIN is a meaningless and, therefore, arbitrary and coined word and is, therefore, entitled to additional trade mark protection, as held in *Kirorimal Kashiram Marketing & Agencies Ltd v. Shree Sita*

² [1906] 23 RPC 774

³ AIR 1963 SC 449

⁴ (2008) 10 SCC 723



Chawal Udyog Mill⁵ and South India Beverages Pvt Ltd v. General Mills Marketing Inc.⁶

7. Further, it is not known as to whether the pharmaceutical composition of the product which stands registered under the name ELEMENTAL is the same as that for which the plaintiff is seeking registration for the mark ELEMENTIN. If the two compositions are different, that would constitute an additional mitigating factor to disabuse the possibility of any likelihood of confusion amongst the public.

8. In any event, in view of the above discussion, the decision of the learned Examiner that the mark ELEMENTIN was disentitled to registration under Section 11(1)(b) of the Trade Marks Act in view of the pre-existing mark ELEMENTAL, cannot, in my view, sustain. It is accordingly set aside.

9. Application No. 2668081, filed by the appellant, for registration of the word mark “ELEMENTIN” is remitted for *de novo* consideration to the concerned officer in the Registry of Trade Marks.

10. The officer would consider the application on its own merits but would not reject the application on the ground of Section 11(1)(a) or Section 11(1)(b) of the Trade Marks Act.

⁵ (2010) 44 PTC 293 (DB)

⁶ (2015) 61 PTC 231 (DB)



11. The appeal stands allowed to the aforesaid extent, with no orders as to costs.

C. HARI SHANKAR, J.

AUGUST 23, 2023

dsn