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**CASE COMMENT ON GLENMARK
PHARMACEUTICALS LTD. V. GLECK PHARMA
(OPC) PVT. LTD. & ORS. [2023]¹**

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Background of the Case

In 2013, the Plaintiff, a manufacturer of the anti-diabetic drug ‘ZITA-MET,’ secured trademark registration for ‘ZITA-MET’ and related formative trademarks in Class 5. In August 2020, the Plaintiff discovered that the Defendant had applied to register the trademark ‘XIGAMET’ in Class 5, prompting the Plaintiff to file an opposition notice. By May 2023, the Plaintiff obtained evidence from the Defendant's purchase bills and invoices indicating that the Defendant was selling medicinal products under the trademark ‘XIGAMET,’ which led to a cease-and-desist notice. In response, the Defendant initiated legal action against the Plaintiff for groundless threats under Section 142 of the Trade Marks Act, 1999, resulting in a temporary injunction from the Srinagar Court in June 2023, effectively preventing the Plaintiff from interfering with the Defendant’s manufacturing, distribution, and sales activities. Subsequently, the Plaintiff filed an interim application in a Commercial IP Suit before the Bombay High Court, seeking to restrain the Defendant from using the trademark ‘XIGAMET’ or any mark that is deceptively similar to ‘ZITA-MET’ for medicinal products.

Legal Issues

1. Whether the Defendants’ use of the mark ‘XIGAMET’ infringed upon the Plaintiff’s registered trademark ‘ZITA-MET’.
2. Whether the impugned mark ‘XIGAMET’ is deceptively similar to ‘ZITA-MET’ and may cause confusion among consumers, particularly in the context of medicinal products.

¹ *Glenmark Pharmaceuticals Ltd. v. Gleck Pharma (OPC) Pvt. Ltd. & Ors. [2023]* <https://www.livelaw.in/pdf_upload/glenmark-pharmaceuticals-ltd-vs-gleck-pharma-opc-pvt-ltd-ors-544938.pdf> accessed 14 July 2024

Contentions of Both Parties

The Plaintiff argued:

- That the trademarks ‘ZITA-MET’ and ‘XIGAMET’ exhibit phonetic, auditory, visual, and deceptive similarities, leading to a significant likelihood of consumer confusion.
- That the Defendant’s attempt to dissect ‘ZITA-MET’ into ‘ZITA’ and ‘MET’, and ‘XIGAMET’ into ‘XIGA’ and ‘MET’ to suit their own convenience violated the anti-dissection rule, which mandates that trademarks be considered in their entirety rather than as separate components, therefore said violation is impermissible in view of the settled principles of law.
- That both trademarks are used for anti-diabetic medications targeting consumers suffering from diabetes, therefore, a common target consumer base, and as a result heightening the risk of confusion which is a very precarious situation considering that ZITA-MET and XIGAMET contain different molecules – sitagliptin and teneligliptin respectively – and mixing up the same may potentially cause serious harmful side effects on the consumer.

The Defendant argued:

- That in the present circumstances, it is necessary that the present application for ad-interim relief should not be under consideration at this stage and that the application as well as the suit should be dismissed on the ground of multiplicity of proceedings and misuse of the legal process.
- That ‘XIGAMET’ differed visually, particularly in appearance, initial letters, and the presence of a hyphen, compared to the Plaintiff’s trademark.
- That the pronunciation of “IG” in ‘XIGAMET’ was distinct from the pronunciation of “IT” in ‘ZITA-MET’.
- That the common usage of suffix “met” is used industry-wide across the globe for medicines containing the ingredient metformin. He further argued that there are several medicines being sold in the market with the suffix “met”.
- That the Plaintiff’s product contains sitagliptin, while the Defendant’s product contains teneligliptin, indicating both different classes as well as molecular structures.

Analysis and Court's Decision

In this case, the court cited the legal precedent set by the Hon'ble Supreme Court in *Cadila Health Care Ltd vs. Cadila Pharmaceuticals Ltd.*², wherein the court specified the criteria for determining deceptive similarity, particularly with regard to trademarks for medicinal and pharmaceutical products. The Supreme Court emphasized that in trademark cases involving the aforesaid category of products, even the slightest potential for confusion requires limiting or restraining the use of those marks³. As a result, the Court determined that the Defendant's mark would cause confusion among consumers, which would have grave consequences.

Paragraph 13 of the judgment especially underscores the Supreme Court's stringent standards for trademark disputes involving medicinal products, referencing the *Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd.* case. The plaintiff's counsel argued for a stricter test for potential confusion due to the critical nature of these products. This rigorous approach prioritizes public health, recognizing the severe implications of consumers confusing one medicinal product for another. Consequently, the court advocates for a lower threshold of proof for confusing similarity in medicinal trademark cases to protect public interest, ensuring even minor similarities are rigorously scrutinized to prevent harm to consumers.

The Court noted the Defendant lacked a convincing reason for choosing "XIGAMET," suggesting a malicious intent to mimic "ZITA-MET." Further, citing *Medley Laboratories (P) Ltd. vs. Alkem Laboratories Ltd.*⁴, the Court acknowledged that in India, prescriptions have become insignificant, with Schedule-H drugs being sold over the counter without prescriptions. Consequently, the Court rejected the Defendant's claim that prescription-only status would prevent confusion. Both products treat the same medical condition, thereby increasing the risk of confusion between 'ZITA-MET' (with sitagliptin) and 'XIGAMET' (with teneligliptin), potentially leading to harmful side effects.

² *Cadila Health Care Ltd vs. Cadila Pharmaceuticals Ltd.* 2001 (5) SCC 73

< <https://indiankanoon.org/doc/1114158/> > accessed 14 July 2024

³ Aastha Kaushik, 'Slightest Confusion Between Medicinal Products Should Be Examined from Point of View of Ordinary Man of Average Intelligence: Bombay HC' (Verdictum, 17 June 2024)

< <https://www.verdictum.in/court-updates/high-courts/bombay-high-court-2024bhcos8628-glenmark-pharmaceuticals-v-gleck-pharma-confusion-medicinal-products-examined-ordinary-man-practitioner-interim-injunction-1540435> > accessed 14 July 2024

⁴ *Medley Laboratories (P) Ltd. vs. Alkem Laboratories Ltd.* 2002(4) BOMCR70

< <https://indiankanoon.org/doc/545914/> > accessed 14 July 2024

The Court further noted that the Plaintiff's product is a brand of teneligliptin, which belongs to an entirely different class of drugs compared to the product of Defendant No.1, which contains glimepiride, a medicine classified as a sulfonylurea. Therefore, the Court concluded that there is no possibility of confusion between the Plaintiff's and Defendant's products.

The Court emphasized that the potential for confusion in medicinal products requires a stricter standard due to the severe health risks, including life-threatening situations, that such confusion can cause. The Court observed that the Plaintiff had established a prima facie case of trademark infringement due to the deceptive similarity of the marks and their related products. Consequently, the Court ruled in favor of the Plaintiff, granting ad-interim relief against the Defendant.

Conclusion

Upon examining the Bombay High Court's observations and the referenced landmark rulings such as the Cadila Health Care Case, it becomes evident that even professionals like physicians and pharmacists can be confused by phonetically and structurally similar trademarks on medicinal products. This risk is exacerbated by illegible prescriptions and orders made over the phone. Given the potentially grave consequences of administering incorrect medication, particularly when drugs for the same condition differ in composition, a stringent standard for evaluating deceptive similarity is imperative. Therefore, the Court's foremost responsibility is to safeguard the public, and it must do so irrespective of the inconvenience or hardship caused to a party whose trade practices are likely to mislead or confuse consumers.