

24th August, 2020

To,
Registrar of Trade Marks,
Antop Hill,
Mumbai

RE- Reply to Examination Report

This is in reply to the examination report received in regard of Application No: NTMC2020006 in Class 5 for the word mark '**VIROTIZE**'.

It has been stated that the Trademark application is open to objection on relative grounds of refusal under Section 11 of the Act because the same/similar trademark(s) is/are already on record of the register for the same or similar goods/services.

The objection is raised under S 11 (1) of the Trade Marks Act, 1999, as the mark is identical with or similar to earlier marks in respect of identical or similar description of goods or services and because of such identity or similarity there exists a likelihood of confusion on the part of the public.

The conflicting mark objected by the Registrar is '**VIROTAC**' filed under class 5 for pharmaceutical and medical preparations which is allegedly phonetically similar and used for the same or similar goods or services to the proposed mark '**VIROTIZE**'.

i. Description of goods or services

While considering the similarities in the description of goods or services of two conflicting trademarks, it is essential consider the various aspects of the product for which the trade mark is sought. In the present case, the mark '**VIROTIZE**' is described as a sanitizing wipe used for cleaning, sanitizing and disinfecting surfaces whereas, the alleged conflicting mark is used for pharmaceutical and medical preparations. Keeping this in mind, it can be clearly identified that the two products have different uses and thus, their descriptions do not conflict even though they fall under the same classification of goods.

Moreover, based on this description it can also be observed that two products bearing non-identical descriptions also bring out fact that the two would not be sold in a manner which would cause confusion to the buyers. Since the alleged mark is used for pharmaceutical and medical preparations whereas the proposed mark, 'VIROTIZE' is used for households purposes and would thus, be found in supermarkets and general stores and not medical stores.

In case of *Parle Products v JP & Co., Mysore* [AIR 1972 SC 1359], the court has stated that "In order to come to a conclusion whether one mark is deceptively similar to another, the broad and essential features of the two have to be considered. They should not be laid side by side to the find out the differences." Thus, even in this case, keeping the mind the essential features of the product based on their description, it can be clearly seen that they have different uses and descriptions which establish that they are not similar.

ii. Phonetical similarities

It is common knowledge that in cases of pharmaceutical and medical preparations, the name of the product usually denotes the origin of its use. Similarly, in this case, the prefix 'viro' is used to indicate that the product is used in order to kill viruses and bacteria by sanitizing and disinfecting surfaces.

Many judgements of the Courts have reiterated the point that when a prefix is generic and commonly used in trade, it cannot be restricted in use to only one person. To cite precedent, in the case of *Indo-Pharma Pharmaceutical vs Citadel Fine Pharmaceuticals* [1998 (2) L.W. 646] the findings of the Court was that "the prefix for both the marks are common to the trade and cannot be a proprietary name. Nobody can claim exclusive right to use such an abbreviation." The same was established in the case of *Astrazeneca Uk Ltd. And Anr. vs Orchid Chemicals* [2007 (34) P.T.C. 469 (D.B.)(Del.).

iii. Likelihood of confusion

Keeping in mind the above stated points, it is evident that there is no scope for likelihood of confusion between the two marks by the general public. In the case of *M/s. Nandini Deluxe v. M/s. Karnataka Co-Operative Milk Producers Federation Ltd.* [2018 SCC OnLine SC 741], the Hon'ble Supreme Court has held and observed

that certain goods may fall in the same class; however, they may be quite different in their commercial applications, businesses and markets which would obviate the likelihood of confusion between the rival marks, especially when the marks are commonly used words and not invented. The court based on this, held the marks not to be deceptively similar as seen in light of the difference in the corresponding goods and businesses even though both the marks pertained to the same class.

The fact that both the marks fall under the same class does not intend that they may cause a likelihood of confusion. There are several other factors that that need to be kept in mind such as the use of the marks, its commercial application, its consumer base and its impact on the market. Thus, the mark ‘**VIROTIZE**’ cannot be said to cause any likelihood of confusion in the minds of the public as the mark is used differently from the alleged conflicting mark and the specification of the goods are completely different.

iv. Honest adaptation

The mark ‘**VIROTIZE**’ has been adopted based on its use. The prefix ‘viro’ used to indicate its relating to virus, bacteria and the like and the suffix ‘tize’ used to indicate its sanitizing purpose. Thus, it is to be noted that the mark holds acquired distinctiveness as it is a coined term with no dictionary meaning. There is also a social media advertisement campaign that is to be rolled out soon for the proposed mark. The mark is purposed to be use in an honest and bona-fide concurrent manner with no intention of causing any likelihood of confusion in the minds of the consumers.

Hence, the proposed mark does not fall under any of the objections raised by the Registrar and should be granted Registration. Kindly find attached the documents in support of this reply.

Yours Faithfully,
Advocate Urvi Karolia,
for applicant Xavier D’Souza