

(2004) 09 IPAB CK 0008

In the Intellectual Property Appellate Board

Case No : Transferred Appeal No. 266/2004/TM/AMD (A.No. 1111996)

Aesculapius Remedies (P) Ltd.

APPELLANT

Vs

Aesculapwerke Aktiengesellschaft And Ors.

RESPONDENT

Date of Decision : 08-09-2004

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11(a), 11(e), 12(1), 18(1), 18(4)
Trade Marks Act, 1999 — Section 100

Citation : (2005) 31 PTC 722 (IPAB)

Hon'ble Judges : S. Jagadeesan, J;Raghubir Singh, J

Bench : Division Bench

Advocate : R.R. Shah, Girish N. Shah

Final Decision : Dismissed

Judgement

Raghubir Singh, J

1. An Appeal No. 11/1996 was filed in the High Court of Gujarat at Ahmedabad. The same has been transferred to this Board in terms of Section 100

of the Trade Marks Act, 1999 and has been numbered as TA/266/2004.

2. An application bearing No. 436533 for registration of word mark 'AESCULAPIUS' for the goods 'Medicinal and Pharmaceutical preparations' in

Class 5 was filed by the appellant on 16.4.1985. The mark was proposed to be used on the date of application. The application, after having been

accepted, was advertised in Trade Marks Journal No. 933, dated 16.4.1988 at page 80. The respondent filed his notice of opposition in Form TM 5

stating that it is the registered proprietor of trade mark 'AESCULAP' under No. 285347 dated 12.1.1973 in class 30 in respect of 'Instruments,

apparatus and appliances included in class 10 for neuro-surgical, surgical, medical, hygienical and veterinary purposes as well as for the dentistry and

for animal husbandry and treatment'. The said mark is being used and advertised throughout the world including in India and thus has acquired much reputation and goodwill throughout the world and the adoption of the impugned mark by the appellants is with a view to cash in on the reputation and goodwill enjoyed by the opponent in its mark. The respondent took objection under Sections 9, 11(a), 11(e), 12(1) and 18(1) of the Act and also prayed for the exercise of the discretion vested in the Tribunal under Section 18(4) of the Act.

3. In the counter statement filed on 27.12.1988, the appellant denied the various averments of the respondent. The Assistant Registrar of Trade Marks heard the matter and held that the impugned mark is having a dictionary meaning being the name of 'God of healing' in Roman mythology. Further, the mark is proposed to be used on the date of application. Thus, he reached the conclusion that the mark being directly descriptive and laudatory of the goods is not registerable within the meaning of Section 9 of the Act. In relation to his examination under Section 11(a) also, the Assistant Registrar held against the appellant and found that though the rival goods fall under different classes, but, still have got a definite interconnection. Thus, the adoption of the impugned mark by the appellant is dishonest. He did not examine the matter under Section 12(1) of the Act. He decided in relation of Section 18(1) and Section 18(4) of the Act as against the appellant.

4. The appeal was taken up for consideration and heard arguments on 28th July, 2004, at Ahmedabad. Shri R.R. Shah, the learned Counsel appeared for the appellant and Shri G.N. Shah, appeared for the respondent.

5. The learned Counsel for the appellant expressed that the case pertains to different classifications under the Act. Hence, there is no scope for any confusion. He pleaded that the respondents have no sale or reputation of their goods in India. He put reliance upon the judgment of the Bombay High Court in Consolidated Food Corporation v. Brandon & Co. AIR 1965 Bom 3,5 He also cited the decision of the I.P.A.B. in E.I. Du Pont De Nemours & Co. of USA v. Gemini Distilleries Ltd., 2004 PTC 663/IPAB. In relation to the findings of the Assistant Registrar that the impugned mark is having a dictionary meaning and as such, it is directly descriptive and laudatory of the goods in question, the learned Counsel argued that the word as such is not known in India and the word 'AESCULAPIUS, as such, does not mean

medicines. He pleaded that the Assistant Registrar has wrongly decided the matter under Section 18(1) of the Act. In any case, he should have exercised his discretion under Section 18(4) and decided the matter in favour of the appellant. The learned Counsel pleaded that the trade channels for both the marks are different and the goods are different.

6. The learned Counsel for Respondents took us through various bills for sales of the respondent in India and argued that in view of this volume of sale in India, the proposed mark shall trade upon their reputation and thus it is having deceptive similarity to the mark of the respondent. It is true from those bills that respondent No. 1, though dealing in surgical goods, has his trade channels common with the proprietors dealing in medicines.

7. In successive judgments of the Supreme Court and various High Courts culminating in the judgment of the Supreme Court in *Cadila Health Care*

Ltd. v. Cadila Pharmaceuticals, a sufficient warning has been given that a stricter view in matter of interpretation of the relevant provisions of the Act

is to be taken in matter of registration of trade marks relating to medicines. The impugned mark is proposed to be used. Thus, there is no case for

acquired distinctiveness. It is not a coined word and it has a dictionary meaning. 'Aesculap' or 'Aesculapes' means to do with or relating to the art of

healing, See the Chambers Dictionary, 2002 published by Allied Chambers (India) Ltd., New Delhi, page 24. Now let us have a comparison of the

impugned word with the word already on the register. 'Aesculapius' gives a look and sound of an adjectival derivative of noun 'Aesculap'.

Grammatical derivatives of the words not permissible are also not permissible. It may be argued that it is not a grammatical derivative of the word

'Aesculap'. Even if it be so, it suffers from the vice of deception and confusion as to mislead someone to be having associated with the word already

in the register. Hence, we fear that the judgment of the Mumbai High Court in the case of *Consolidated Food* does not help the appellant. It provides

that for the purposes of Section 11(a), it is necessary that the mark should have attained much reputation among the members of the public as would

lead them to associate the mark only with the products of the petitioner and of no one else. To the contrary, Respondent No. 1 has adduced sufficient

evidence that its trade mark has attained much reputation since its products bearing that trade mark are sold throughout India in sufficient quantity.

Similarly, the order of IPAB in E.I. Du Pont De Nemours is of no help to appellant since in that case the appellant failed to adduce any evidence of its

sales in India to claim reputation. Accordingly, we conclude:

(a) that the impugned mark is neither distinct nor has acquired distinctiveness to qualify under Section 9 as it is proposed to be used and is having a

dictionary meaning;

(b) that the word having a look and sound of a grammatical variation of a word already on the register is deceptive and confusing in terms of Section

11(a);

(c) In view of the above position relating to Section 9 and Section 11(a), the benefit of Section 18(1) and 18(4) cannot accrue to the appellant.

We, accordingly dismiss the appeal with no order as to the cost.