

(2004) 01 IPAB CK 0024

In the Intellectual Property Appellate Board

Case No : TA/4/2003/TM/CH (TMA 1/95)

American Home Products Corporation

APPELLANT

Vs

K.V. Chennamallu

RESPONDENT

Date of Decision : 16-01-2004

Acts Referred:

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

Citation : (2004) 28 PTC 154 (IPAB)

Hon'ble Judges : S. Jagadeesan, J; T.R. Subramanian, Technical Member

Bench : Division Bench

Advocate : T.N. Daruwala, Gladys Daniel

Final Decision : Allowed

Judgement

T.R. Subramanian, Technical Member

1. This is an appeal against the order of the Assistant Registrar of Trade Marks, Chennai dated 3rd January 1995 refusing opposition No. MAS 2028

filed by the appellants opposing the registration of the respondents' application No. 407455. The respondents M/s. K.V. Chennamallu, hereinabove,

had filed trade mark application No. 407465 on 2nd July 1963 at the Trade Marks Registry, Chennai for registering their trade mark 'PREXMIN' in

class 5 in respect of pharmaceutical and medicinal preparations on the basis of proposed to be used. The application was accepted and advertised in

the Trade Marks Journal dated 1st August 1987.

2. On 30th November 1987, the appellants AMERICAN HOME PRODUCTS CORPORATION hereinabove filed a notice of opposition opposing

the registration of the respondents' mark under Sections 11(a), 11(e), 12(1) and 18 of the Trade and Merchandise Marks Act, 1958, mainly claiming

that they are the registered proprietors of the trade mark 'PREMARIN' for the same goods and as the rival mark are deceptively similar, the impugned mark is prohibited from registration.

3. The respondents filed their reply statement denying the allegation. The appellants and respondents filed their evidences. The appellants later filed an Interlocutory Petition on 5.6.1989 for filing further evidence in their support. The respondents filed their reply.

4. The case was heard by the Assistant Registrar of Trade Marks, Chennai on 13th October 1993. The I.P. filed by the appellants was taken on record. By his order dated 3rd January 1995 the Assistant Registrar refused the opposition on the ground that even though the rival goods are same, the rival marks are not deceptively similar. He also refused to take into consideration the opponents' affidavit of Shri Mahesh Haridas Toprani on the ground that the exhibits attached to the affidavit had not been signed by the deponent. As regards the trade affidavits filed by the opponents he had refused them on the ground that they are tutored affidavits. He held that the opponents have not discharged the onus cast on them to prove reputation of their mark.

5. The opponents/appellants filed an appeal (TMA No. 1/95) before the Hon'ble High Court of Chennai, which was transferred to the IPAB, which came into operation on 6.10.2003 under Section 100 of the Trade Marks Act, 1999, which is the present appeal.

6. At the hearing before this Tribunal, Mr. T.N. Daruwalla, Advocate with Ms. Gladys Daniel appeared for the appellants. None appeared for the respondents.

7. The learned counsel for the appellants Mr. T.N. Daruwalla submitted that the Assistant Registrar of Trade Marks has erred by deciding that the rival marks are not deceptively similar and that he had wrongly applied the principle laid down in the Pianotist case referred to by him in his decision. Furthermore, the Assistant Registrar has erred by not taking into consideration the evidence filed by them mainly on the ground that the deponents had not signed the exhibits and had also erred by not taking into consideration the trade affidavits filed by them on the ground that they are tutored affidavits without giving any reason as to how he had arrived at the above conclusion. He submitted that the Assistant Registrar must have decided

that the opponents have proved reputation and use of their trade mark in India, taking into consideration the large volume of invoices filed by them.

Regarding similarity of marks, the counsel for the appellants quoted extensively from the case *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*,

AIR 2001 SC 1952 wherein it was held 'Falcitab' was similar to 'Falcigo', the good being medicines. He forcefully argued that in cases of medicines

and drugs, even a possibility of confusion and not probability of confusion would have disastrous effect and hence the use of confusingly similar marks

should not be allowed.

8. He also referred to the following cases in support of his contentions that the rival marks are deceptively similar:-

1. AIR 1956 BOM 56 (CIBA mark)
2. AIR 1960 SC 142 (GLUCOVITA mark)
3. 2002 (25) PTC (BOM) DB (SPOXIN mark)
4. 2002 (24) PTC (GUJ) (ZOVIREX mark)
5. 1995 (20) IPLR 378 (EMULGEL mark)
6. 1996 (21) IPLR 61 (ROLAC mark)

9. He drew our attention to pages 70, 71 and 72 of the book *Trade & Merchandise Marks Act, 1958 Third Edition* by Shri K.S. Shavaksha and

submitted that the scope of enquiries under Sections 11 and 12(1) have been clearly brought out by the author.

The extract from the above book on Section 11 and Section 12(1) is as follows:-

Section 11 and Section 12(1) :- Where the question is whether the applicant's mark is likely to cause confusion having regard to the opponent's mark,

the scope of the enquiries under Section 11 and Section 12(1) may be stated as follows:

(a) Under Section 11 - Having regard to the reputation acquired by the opponents' mark, is the Tribunal satisfied that the mark applied for, its use in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion among a substantial number of persons?

(b) Under Section 12(1) - Assuming use, by the opponent, of his mark in a normal and fair manner on any of the goods covered by the registration of

the mark, is the Tribunal satisfied that there will be a no reasonable likelihood of

deception or confusion among a substantial number of persons, if the applicant also uses his mark normally and fairly in respect of any goods covered by the proposed registration.

10. We will consider the question whether the appellants' mark 'Premarin' is deceptively similar to respondents 'Prexmin' both being used for medicines and drugs. The counsel for the appellants had relied upon various cases in support of his contention. The cited cases lay down some principles for comparison. However, each trade mark case is unique by itself and the matter has to be decided on the basis of facts and evidences filed by the parties in each case.

11. In the decision of the Hon'ble Supreme Court relied upon by the learned counsel for the appellants in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals*, AIR 2001 SC 1952 the Supreme Court has considered the various earlier decisions on the question of deceptive similarity and on para 35, held as under:

35. Broadly stated in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered:

- a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.
- b) The degree of resemblances between the marks, phonetically similar and hence similar in idea.
- c) The nature of the goods in respect of which they are used as trade marks.
- d) The Similarity in the nature, character and performance of the goods of the rival traders.
- e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.
- f) The mode of purchasing the goods or placing orders for the goods, and
- g) Any other surrounding circumstances when may be relevant in the extent of dissimilarity between the competing marks.

12. Also while dealing with deceptive similarity with respect to pharmaceuticals and medicines with respect to the earlier decisions of the Supreme Court the learned Judges, in the *Cadila Healthcare* case had made some

observations. From this, it can be concluded that among other things, the following factors have to be considered in deciding similarity between the marks:-

1) The class of purchasers and in case of medicines, it is purchased by both literate and illiterate residing in villages and towns and also by a man of average intelligence and imperfect recollection.

2) Potential harm may be far more serious in case of medicines than in the case of other consumable products.

3) Even in case of prescription drugs prescribed by doctors and dispensed by chemists, confusion and mistakes are likely when marks which look like and sound like are marketed.

4) Medicines are sometimes ordered over telephone. Hence, if there is phonetic similarity, it enhances the chances of confusion or mistake by the pharmacists. Sometimes, in hospitals, drugs may be requested verbally under critical conditions to treat patients.

5) Prescriptions are handwritten and many times it is not unmistakably legible if the rival marks appear too much alike then there are chances of confusion or mistake by the pharmacists while dispensing the medicine.

6) The drugs have a marked difference in the composition with completely different side effects. Even if the rival drugs are for curing the same ailment, there is possibility of harm resulting from any kind of confusion and the consumer can have unpleasant if not disastrous results.

7) Even though the physicians and pharmacists and trained people yet they are not infallible and in medicines, there can be no provision for mistake since even a possibility of mistake may prove to be fatal.

8) In case of medicines, whether there is any probability of confusion should not be speculated, but that if there is any possibility of confusion the use of confusingly similar marks should be enjoined.

9) Confusion by the use of similar marks which are used for different diseases for medicinal products could have disastrous effect on health and in some cases life itself.

10) In a country like India, where a small fraction know English and for whom different words with slight difference in spelling may sound phonetically same and who cannot pronounce the marks correctly, the use of deceptively similar marks could cause confusion.

13. The Hon'ble Supreme Court in the CADILA Healthcare case has referred to various decisions of the Indian, US and UK Courts where it has

been held that serious consequences may result in cases of pharmaceuticals or medicines where the rival marks are similar or deceptively similar and

therefore a higher and strict standard should be applied in deciding cases to prevent possibility of confusion in the minds of the public. There should be

clear indicators as possible to distinguish the two medicinal products from each other and that drugs are poisons and not sweets. It was also held that

exacting judicial scrutiny is required if there is possibility of confusion over marks, which are applied to medicinal products because of potential harm.

The rules for comparison of words has been laid down by Lord Parker in Pianotist Company Limited's application, (1906) 23 RPC 774 at p. 777,

which is as follows:-

-- 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 to be

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 is used in a normal way as a trade mark for the

goods of the respective owners of the mark. If considering all those circumstances, you come to the conclusion that there will be a confusion - that is

to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public

which will lead to confusion in the goods then you may refuse the registration, or rather you must refuse the registration in that case. --

14. It has been stressed that the question whether the two marks are likely to give rise to confusion or not is a question of first impression (Corn

Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142).

It is also a well settled proposition that the marks have to be compared as a whole. Also to determine whether the two marks are deceptively similar

the test of an average person with imperfect recollection has to be applied. The authority has to visualize, if a customer who may be an ordinary

citizen and who may want to purchase a medicine would get confused.

15. The appellants' mark is 'PREMARIN' and the respondents' mark is 'PREXMIN'. Both the marks relate to pharmaceuticals and medicines.

Hon'ble Supreme Court in Cadila Healthcare case AIR 2001 SC 1952)has observed that the courts have to apply a higher and stricter standard in

deciding the question of deceptive similarity between rival marks in case of medicines. Even if there is possibility of confusion it may result in

disastrous consequences. It has also held that 'FALCITAB' was similar to 'FALCIGO'.

16. The prefix 'PRE' is common to both the marks. Both the marks end with the letter 'IN'. Usually the prefixes are pronounced distinctly and are also

remembered. The doctors usually while prescribing, write the prefix clearly and thereafter the prescription becomes illegible. While ordering the

medicines over phone also there is possibility of confusion as there is some phonetic similarity.

17. As pointed out in Simatul Chemical Industries (P) Ltd. v. Cibatul Ltd., 19 GLR 315, deception between two trade marks is not only concerned with

the concerned two parties but is concerned with the consumers and the interest of the general public will also have to be seen. When the rival marks

are compared as a whole, we are of the opinion that the rival marks are phonetically and structurally deceptively similar. Keeping in view the above,

we are of the opinion that 'PREXMIN' is deceptively similar to 'PREMARIN' more so as the goods are pharmaceutical goods.

18. As regards Section 11(a), the arguments put forward by the learned counsel for the appellants is that the deponent Mr. Mahesh Haider Topran,

Vice President/Secretary of Geoffrey Manners & Company, Mumbai, who are the registered users of the appellants' trade mark, has initialed in the

exhibit which has been countersigned by the notary and that the mere absence of full signature of the deponent in the exhibits should not be a bar for

taking into record the evidence of the appellants. He submitted that this is a mere technical error and that procedural laws or practice are meant to act

as a handmaid in the administration of justice and not to subvert it. He had also submitted that the two trade affidavits filed by them were rejected by

the Assistant Registrar as they were considered to be tutored without giving any reason for coming to that conclusion.

19. We agree with the contention of the counsel for the appellants. The procedure law is meant to help in the administration of justice and that the

evidence filed in support of reputation and use of the mark by the appellants in the form of exhibits containing invoices cannot be rejected merely on

minor irregularity. We are also of the opinion that the Assistant Registrar should not also have refused the two trade affidavits of Mr. S. Vidyasagar

and Mr. N. Subramanyan on the ground that they are tutored affidavits, without giving any reason.

20. The evidences filed by the appellants have been considered by us for arriving at a decision as to whether the appellants have established the use

and reputation of their mark in India. The appellants have adduced sufficient evidence in the form of invoices etc., that they have been using the mark

in India from 1980, that is, much before the date 2nd July 1983 when the respondents filed their trade mark application in the Trade Mark Registry for

registering the trade mark 'PREXMIN' on the basis of proposed to be used. Hence we have no hesitation in deciding that the appellants have

established the use and reputation of their mark in India. For the foregoing reason, in our opinion, the appeal deserves to be allowed and is accordingly

allowed. There is no order for costs.