
(1997) 07 MAD CK 0002
In the Madras High Court
Case No : C.S. No. 42 of 1987

Amrutanjan Limited

APPELLANT

Vs

Mehta Unani Pharmacy and Company

RESPONDENT

Date of Decision : 28-07-1997

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 120, 2(J), 2(V), 33, 34
Trade Marks Act, 1940 — Section 120, 17

Citation : (1997) 07 MAD CK 0002

Hon'ble Judges : K. Govindarajan, J

Bench : Single Bench

Final Decision : Dismissed

Judgement

K. Govindarajan, J.—The Plaintiff has filed the above suit praying for a decree for declaration that the threat issued by the Defendants that

they would be taking action against anybody using the express ion "Cold Rub" on account of their claim that they are the exclusive owners of this

express ion is unjustifiable, for perm anent injunction restraining the Defendants from threatening the Plaintiff by any means circulars, advertisements

or notice directly or indirectly declaring that the expression "Cold Rub" shall not be used by any one and for cost.

2. The Plaintiff is a public limited Company. The Plaintiff and its predecessors -in-interest have been manufacturing pharmaceutical preparations for

coughs, cold and pains. Their most famous preparation is known as Amrutanjan Pain Balm. They product is beings old under the Trade Mark

Nos. 8906 and 8907 etc., registered as early as 1942 under the Trade Marks Act, 1940. The Plaintiff started producing another product in 1962

under the name and style of "Anoleum" for coughs and colds. Such product was

sold in flat circular tins as well as in tubes. The Plaintiff filed Trade Mark Application No. 207076, dated 29.1.1962 for the registration of the name "Anoleum" as a pharmaceutical preparation in Class 5, Schedule IV of the Rules. The same was registered and published in Trade Mark Journal, dated 1.9.1962 in Class 5. Subsequently, on 6.5.1969 another Application in No. 256558 was filed by the Plaintiff before the Registrar and it was published in Trade Mark Journal dated 1.4.1970 for registration of the principal face of the circular tin container with the word "Anoleum" written across the circular tin diametrically. Again Application No. 256676, dated 12.5.1969 was made for registration of the design and get up on the tube capsule in which the product "Anoleum " was sold.

According to the Plaintiff ever since "Anoleum" was released in the market in 1962 the product has been described as "Cold Rub" just as their Amrutanjan product was described as "Plan Balm". According to the Plaintiff, the expression "Cold Rub" consists of two common words in frequent currency in English language. The first Defendant is a manufacturer of pharmaceutical preparations known to the Plaintiff closely as adversaries in Criminal and Civil Proceedings since 1966. In view of the above, according to the Plaintiff, it had seen a publication, styled "caution notice" issued by one Mr. C.H. Bhimani, Advocate, published in Times of India, dated 6.9.1986 stating the word "Cold Rub" is the registered Trade Mark of the second Defendant which owns the first Defendant firm. It is claimed therein that the Trade Mark had been registered in respect of a "vapourising ointment" and the said notice forbids anybody from marketing any ointment with the name "Cold Rub".

2.A. According to the Plaintiff, the first Defendant had obtained an Application No. 329747, dated 13.10.1977 for registering the product as "Athmamanthan Cold Rub" a vapourising ointment. The word "Cold Rub" is inserted in English in small letter and in Hindi in bigger print.

Subsequently, the first Defendant has made two applications before the registrar, Trade Marks in 384462 and 407651 and they are pending for final disposal. According to the Plaintiff, the phrase "Cold Rub" consists of two common words and in this particular case it describes the pharmaceutical product used for coughs and colds. The fact that the Defendants have combined the words will not alter the situation and the

Defendant is disentitled to claim "Cold Rub" for its elf. As such it cannot be registered. The Plaintiff seems to have launched rectification

proceedings to rectify the mistake. The Registration in favour of the first Defendant, namely, 329747, dated 13.10.1977 in Class 5 does not confer

exclusive right to the first Defendant for the use of the word "Cold Rub". On the other hand, the Plaintiff having become owner of the expression

"Cold Rub" by prior use, becomes entitled to claim exclusive right and seeks a permanent injunction against the first Defendant. With the above

pleadings the Plaintiff has filed the above suit.

3. The second Defendant filed a written statement stating that this Court has no jurisdiction to entertain the suit. It is stated that the second

Defendant has been manufacturing Ayurvedic preparations (Pain Balm) and has introduced vapourising ointment under the name "Cold Rub" along

with House Mark "Atmamanthan" as early as 1971 and has been in the market since then. After introducing vapourising ointment, the Defendants

got the Trade Mark label "Atmamanthan" Cold rub" also duly registered. The purpose of second registration is to claim exclusive right on the word

"Cold Rub" specially coined by them. The Trade Mark "Cold Rub" is not a mere dissected word but it is coined out of two words which do not

convey any meaning in its ordinary significance and the resulting combination as an invented word. The Trade Mark "Cold Rub" has now been

duly registered. The second Defendant has statutory right to have a legal protection and his taking steps to defend any action of infringement cannot

be stifled by resorting to the proceedings like the present suit. The Defendant has denied that the Plaintiff has been using the Trade Mark "Cold

Rub" from 1962, with the above pleadings, the second Defendant has prayed for dismissal of the suit.

4. On the basis of the above pleadings, the following issues were framed for trial:

(1) Whether part of the cause of action for filing this suit has arisen within the jurisdiction of this Court or not?

(2) Whether the Defendants have not been using the expression "COLD RUB" since 1970 along with the Trade Mark

ATHMAMANTHAN?

(3) Who has adopted the expression "COLD RUB" earlier, whether the Plaintiff or Defendant, to sell their respective product along with, their

trade names namely "ANOLEUM" and "ATHMAMANTHAN"?

(4) Whether the expression "COLD RUB" found in the label mark registered under No. 329747 dated 13.10.1977 in Class-5 in favour of the

Defendant is a Trade Mark by itself as defined in Section 2(V) or a mere mark as defined in Section 2(J) of the Trade and Merchandise Marks

Act, 1958?

(5) Is it not lawful for the Defendants to claim exclusive right over the expression "COLD RUB".

(6) Is the Plaintiff entitled for declaration and for injunction as prayed for?

(7) Whether the suit is maintainable u/s 120 of the Trade Marks Act as the word "Cold Rub" is an exclusive coined word belonging to the

Defendant?

(8) Whether there is disclaimer of the word "COLD RUB" as contemplated u/s 17 of the Trade Marks Act?

(9) To what other relief?

5. The Plaintiff and Defendants by consent have filed documents and marked the same as Exs. P-1 to P-59 and Exs. D-1 to D- 14 respectively.

No oral evidence was let in.

6. Issue Nos. 2 and 3. The cause of action for filing the suit is Ex.P-22 in which the learned Counsel for the second Defendant has caused a

caution notice in "Times of India" to the effect that the first Defendant owned by the second Defendant are owners of Registered Trade Mark

"COLD RUB" in respect of vapourising ointment and if anybody manufactures or sells or markets the said vapourising ointment under the Trade

Mark "COLD RUB", they shall be liable for breach of injunction obtained in C.S. No. 4 of 1986 from the Court of District Judge, Rajkot District

at Rajkot and/or in contempt of Court. So, the Plaintiff has laid the suit u/s 120 of the Trade and Merchandise Marks Act (hereinafter called the

Act).

7. Section 120 of the Act reads as follows:

Groundless threats of legal proceedings:

(1) Where a person, by means of circulars advertisements or otherwise, threatens a person with an action or proceeding for infringement of a trade

mark which is registered or alleged by the first mentioned person to be

registered or with some other like proceedings a person aggrieved may, whether the person making the threats is or is not the registered proprietor or the registered user of the trade mark, bring a suit against the first-mentioned person and may obtain a declaration to the effect that the threats are unjustifiable and an injunction against the continuance of the threats, and may recover such damages (if any) as he has sustained, unless the first-mentioned person satisfies the Court that the trade mark is registered and that the acts in respect of which the proceedings were threatened constitute, or if done, would constitute, an infringement of the trade mark.

(2) The last preceding Sub-section does not apply if the registered proprietor of the trade mark, or a registered user acting in pursuance of Sub-section (1) of Section 51, with due diligence, commences and prosecutes an action against the person threatened for infringement of the trade mark.

(3) Nothing in this Section shall render a legal practitioner or a registered trade mark agent liable to an action under this Section in respect of an act done by him in his professional capacity on behalf of a client.

(4) A suit under Sub-section(1) shall not be instituted in any Court inferior to a District Court

8. The Plaintiff claims that since 1893 the Plaintiff and their predecessors-in title have been manufacturing pharmaceutical preparations for cough, cold and pain. Their famous preparation is Amirtanjan Pain Balm. In 1962 the Plaintiff started producing another product under the name and style of "ANOLEUM" for cough and cold with the introduction to rub it over chest and cover the chest with warm cloth for relief. They availed the name "ANOLEUM" as pharmaceutical preparation in Class-5 in Schedule 4 of the Rules, which came to be registered with effect from 29.1.1962 and published in the Trade Mark Journal dated 1.1.1962. The Plaintiff marked Ex.P-1 to prove the same. Subsequently, the principal face of circular tin container with the word "ANOLEUM" written across the circular tin diametrically was registered with effect from 6.5.1969. On further application by the Plaintiff, the design and get up of the tube capsules in which the product "ANOLEUM" was sold was registered. To prove the

above registrations the Plaintiff filed Exs.P-2 and P- 3.

The Plaintiff claims that "ANOLEUM" was released in the market in 1962 with the description as "COLD RUB". According to the Plaintiff, the

expression "COLD RUB" consists of two common word in frequent currency in English Language which belongs to the Plaintiff and the same is

not to be appropriated for the private benefit of any particular individual. The Plaintiff has, filed Exs.P-12, P-13, P-16 to P-18 to prove that

"ANOLEUM" was marketed describing in the advertisements as "COLD RUB". The learned Counsel appearing for the Plaintiff on the basis of

the above documents has submitted that the Plaintiff has been using the word "COLD RUB" along with "ANOLEUM" ever since the date of

introduction of "ANOLEUM" namely, 1962.

9. We now proceed to see how the Defendants are claiming right over the word "COLD RUB". The Defendants are the manufacturer of

Ayurvedic medicinal and pharmaceutical ointments with the Trade name "ATMAMANTHAN". It is the admitted case that there were litigations

between the Plaintiff and Defendants regarding the trade mark. Since it is not relevant for this case, I am not discussing about the same in detail.

The first Defendant obtained registration for the product described as vapourising ointment "ATHMAMANTHAN COLD RUB" in Application

No. 329749. The same has been market as Ex.P-19. The word "COLD RUB" is inserted in English in small letters and in Hindi in big print. Under

Ex.P-20, the attorney of the Defendants informed the Registrar of Trade Mark with reference to the above said application that the mark is in use

since 1970 and the applicants agreed to disclaim the word "COLD RUB" appearing in the Trade Mark. In view of the above undertaking, the

registration was made as described in Ex.P.21. Subsequently, the Plaintiff filed an application in No. 407651 to register the word "COLD RUB".

The Registrar in Ex.P-30 informed the Defendants through his attorney that the registration can be given only subject to association with Registered

Trade Mark; Nos. 265260, 285693, 307448 and 329747. Trade Mark No. 329747 was (Ex.P-21) registered after agreeing to disclaim the

word "COLD RUB" appearing in the Trade Mark. In spite of that, the said word "COLD RUB" seems to have been registered subject to

association with Registered Trade Mark No. 329747. On the basis of the same,

the Defendants claim right with respect to the word "COLD RUB".

10. Subsequently, on 13.7.1987 the Plaintiff has lodged notice of opposition in Form TN-5 objecting the registration of the said word "COLD

RUB". The said objection was disallowed by the authorities and accepted the application No. 447643, Class-5. The copy of the said order is

marked as Ex.P-57. The Plaintiff filed a Review Petition and the review Petition also was dismissed by the Assistant Registrar of Trade Mark on

9.3.1994. The copy of the said order is marked as Ex.P-59. It is represented that aggrieved against the said proceedings the Plaintiff has filed an

appeal before the High Court of Gujarat at Ahmedabad in Appeal No. 5/94. According to the Plaintiff in the appeal, they obtained interim stay of

the order passed by the Assistant Registrar. According to the Defendants, no interim stay was granted. But the learned Counsel appearing for the

Plaintiff produced certified copy of the order passed in Civil Application No. 32 of 1994 in Appeal No. 5 of 1994 on the file of the High Court of

Gujarat at Ahmedabad stating that ad-interim relief was granted in terms of para 6(a).

11. The learned senior counsel appearing for the Plaintiff has submitted that the Plaintiff had been using the word "COLD RUB" along with the

"ANOLEUM" from 1960. According to the Defendant they had been using the said word from 1970. Though in paragraph 6 of the plaint it is

stated that ever since "ANOLEUM" was released in the market in 1962, the product has been described as "COLD RUB" just as their product

"Amirtanjan" was described as "Pain Balm" the Plaintiff has marked the documents Exs.P-12, 13, 16 to 18 and these documents will show that

the word "COLD RUB" has been added with "ANOLEUM" only from 1973. No document is produced to prove that "ANOLEUM" with the

word "COLD RUB" was marketed from 1962. In the order passed by the Assistant Registrar, between the parties. Marked as Ex.P-57, he can

me to the conclusion on merits holding that the Plaintiff has not proved the user of the word "COLD RUB" from 1962. The said finding is binding

on the Plaintiff. In view of the above, the case of the Plaintiff that the Plaintiff has been using the said word from 1962, i.e., earlier than that of the

Defendants cannot be sustained. So the Plaintiff cannot invoke the right u/s 33 of

the Act. So, I find these issues in favour of the Defendants.

12. Issue Nos. 4 and 8. The Defendants are claiming right in the word "COLD RUB" on the basis of Registration under Ex.P-30 and so these

issues are not decided as they are unnecessary.

13. Issue Nos. 5 and 6. The learned Counsel appearing for the Plaintiff took me through some documents, Exs.P-20, P-21, P-24, P-25 and P-31

to show that the Defendants obtained the registration misrepresenting the facts before the authorities as if the word "COLD RUB" forms part

of the Trade Mark already registered. Though, under Ex.P-20, the Defendants have specifically agreed to disclaim the word "COLD RUB"

appearing in the market, regarding this issue, in spite of the fact that the Plaintiff has raised specifically about this, the authorities have decided

against the Plaintiff and against that order, the appeal is pending before the Gujarat High Court at Ahmedabad. Hence at this stage I cannot decide

the said issue whether the Defendants obtained the registration by playing fraud or misrepresentation.

14. I have to decide the right of the Plaintiff only on the basis of the order passed by the statutory authorities relating to the issues in question.

15. The Plaintiff has proved that it has been using the said word along with the trade mark at least from 1973. "COLD RUB" is a descriptive

word. The said words can be used only for describing the article along with the trade mark. It cannot be said that neither the Defendants nor the

Plaintiff had coined the said word. Even the Defendants themselves in Ex.P-25 in paragraph 9 have stated that the word "RUB" is likelihood of

confusion or deception by the use of the similar or similar trade mark by the applicants, totally diminishes. In Vishnudas Trading as Vishnudas

Kishandas Vs. Vazir Sultan Tobacco Co. Ltd., Hyderabad and another, the Hon'ble Supreme Court observed as under:

Therefore surely descriptive and confirm to the pharmaceutical trade and no trader can have exclusive right to use the same as a trade mark or part

of the trade mark. Therefore, the use of the word "COLD RUB" can be said to be bona fide description of the character of the goods.

16. The learned Counsel appearing for the Plaintiff has relied on Section 34 of the Act, which reads as follows:

Saving for use of name, address or description of goods:

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods.

In view of the above provisions and in view of the finding that the use of the word "COLD RUB" is a bona fide description of the character of the goods, the safeguard provided u/s 34 is available to the Plaintiff. So the Plaintiff is entitled to use the word "COLD RUB" as a bona fide description of the product in terms of Section 34 of the Act. So I find issue No. 5 against the Defendants and issue No. 6 in favour of the Plaintiff.

17. Issue No. 1. The learned Counsel for the Defendants has not raised any objections regarding jurisdiction to entertain the suit during the course of his arguments. Hence, I do hold that this Court has jurisdiction to entertain the suit.

18. Issue No. 7. In view of the above discussion, I hold that the suit is maintainable, and this is sue is answered accordingly.

HELD:

Issue No. 9. In the result, the suit is decreed as prayed for no costs.