
(2004) 07 IPAB CK 0001

In the Intellectual Property Appellate Board

Case No : TA No. 3/2003/TM/CH (TMA No. 9/1993)

Apple Laboratories Limited

APPELLANT

Vs

Boots Company Plc And Anr.

RESPONDENT

Date of Decision : 09-07-2004

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 11(a), 11(e), 12(1), 12(3), 12(e), 18(1)

Trade Marks Act, 1999 — Section 100

Citation : (2004) 29 PTC 265 (IPAB)

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

Bench : Division Bench

Advocate : M.K. Rao, A.A. Mohan

Final Decision : Dismissed

Judgement

S. Jagadeesan, J

1. The appeal is arising out of the order of the second respondent dated 30.4.1993, allowing the notice of opposition filed by the first respondent and

consequently rejecting the registration of the appellant's application in respect of their trade mark ""BRUFORTE"" in respect of Pharmaceutical and

Medicinal preparations in class 5.

2. The appellant herein filed an application bearing No. 458933 on 22.8.1986 for registration of a trade mark ""BRUFORTE"" in respect of

Pharmaceutical and Medicinal preparations in class 5. The said application was accepted by the second respondent herein and advertised in the Trade

Mark Journal No. 953, dated 16.2.1989. The first respondent herein filed their notice of opposition on 7.6.1989, objecting to the registration of the

appellant's trade mark on the ground that the first respondent is carrying on an

established business as manufacturers and merchants of Medicinal and Pharmaceutical products and that they have registered their mark ""BRUFEN"" under No. 250671 in respect of Pharmaceutical preparations for the treatment of Rheumatoid, Arthritis, etc. and that the said mark was extensively used in India and thereby valuable reputation and goodwill have accrued to the said trade mark. The further objection of the first respondent is that the appellant's mark is deceptively similar to that of the first respondent's mark and the use of the mark by the appellant would cause confusion and deception in the minds of the medical practitioners, Chemists and public. Yet another objection taken by the first respondent is that the appellant has claimed the use of the said trade mark for a period of three months only and as such, the refusal of the registration will not prejudice the appellant in any manner. In all, the opposition of the first respondent is that the registration of the appellant's trade mark would be contrary to the provisions of Sections 11(a), 11(e), 12(e) and 18(1) of the Trade and Merchandise Marks Act, 1958, (hereinafter referred to as the Act).

3. The appellant filed the counter statement denying all the material averments made in the notice of opposition and they further contended that their trade mark is distinct and distinguishable from the first respondent's mark BRUFEN. It is further stated that several manufacturers are marketing similar preparations bearing the marks having the prefix ""BRU"" viz., Brufamol, Brupal and Brustan, etc. In such circumstances, the first respondent cannot claim monopoly in respect of the prefix ""BRU"" per-se. The trade mark ""BRUFORTE"" is totally distinct and different from ""BRUFEN"". Since the appellant is the proprietor of the trade mark ""BRUFORTE"", none of the provisions of the said Act prohibited the registration of their trade mark.

4. The Registrar of Trade Marks, after considering the stand taken by both the parties as well as the arguments advanced by their respective counsel, under the impugned order came to the conclusion that the objection raised by the first respondent under Sections 11(a) as well as 11(e) of the said Act cannot be sustained. However, the Registrar of Trade Marks upheld the objection of the first respondent under Section 12(1) of the said Act and found that both the trade marks are identical and as such, allowing the use of the trade mark of the appellant would definitely cause confusion and deception among the Doctors as well as the public. The Registrar of Trade Marks

further held that the appellants are not entitled for protection under Section 12(3) of the said Act since the Appellant's trade mark was in use only 2-3 months prior to the date of application. The Registrar further upheld the objection of the first respondent under Section 18(1) of the said Act and consequently, refused registration of the appellant's Trade Mark "BRUFORTE" and rejected their application No. 458933 in class 5.

5. Aggrieved by the same, the appellant preferred an appeal in TMA 9/1993 on the file of the High Court of judicature at Madras. The same was transferred to this Appellate Board pursuant to Section 100 of the Trade Marks Act, 1999.

6. Shri M.K. Rao, the learned counsel for the appellant, mainly contended that the appellant's trade mark "BRUFORTE" is totally different and distinct

from that of the first respondent's trade mark "BRUFEN". Except the three prefixed letters "BRU", the suffix is phonetically different and as such the

Registrar of Trade Marks has committed an error in finding that the trade marks of the appellant as well as the first respondent are similar and

identical. Shri M.K. Rao also drew our attention to the Indian Pharmaceutical Guide, 2000, which contains the Index to Pharmaceutical products,

wherein several marks with prefix "BRU" have been given. On this basis, he also contended that when the trade mark with prefix "BRU" is commonly

used, especially, in the Pharmaceutical field, the deciding factor is only the suffix words. When the suffix word "FORTE" of the appellant is totally

different from the suffix word "FEN" of the first respondent, both the trade marks cannot be said to be identical. There is a total distinctiveness in both

phonetic and visual expressions between the two marks. The learned counsel for the appellant also relied upon the principles laid down by the

Supreme Court in the case of "F. Hoffman - La Roche and Co. Ltd. v. Geoffrey Manners and Co. Private Limited, AIR 1970 SC 2062".

7. On the other hand, Shri A.A. Mohan, the learned counsel for the first respondent contended that the appellants have disclaimed the word "FORTE",

the suffix word. In that event, the prefix word plays a major role. When the medicine of the appellant and the first respondent are identical and to treat

the same ailment, naturally, there will be some confusion in the minds of the Doctors as well as the traders and the public. The Pharmaceutical

Guideline relied upon by the learned counsel for the appellant to establish that

there are other marks with the prefix words ""BRU"" cannot be conclusively taken that those trade marks are in the market and are being used. In the absence of any evidence to establish the use of the trade mark as on the date of the application, the burden of which is on the appellant, the said contention is liable to be rejected. The learned counsel for the first respondent also relied upon the judgments of the Supreme Court in the case of (1) ""Corn Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142; (2) Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., AIR 2001 SC 195 2to support his argument that the trade marks are deceptively similar and the use of the same would cause confusion in the minds of the Medical practitioners and the traders.

8. We have carefully considered the above arguments of both the counsel. The main issue for consideration is to see whether the appellant's trade mark ""BRUFORTE"" is identical and similar to that of the first respondent's trade mark ""BRUFEN"".

9. Before we enter into discussion, we may refer to some of the well laid principles of various Courts including that of this Appellate Board. At the same time, we do not want to multiply the authorities. We will restrict to a few of the cases. In the case of ""Astra-IDL Limited v. TTK Pharma Limited, AIR 1992 Bom 35 ,the learned single Judge of that High Court held that the trade mark ""Betalong"" was deceptively similar to the mark

Betaloc"", The learned Judge has held as follows:

17. In the instant case in deciding whether the word 'Betalong' is deceptively similar to the word 'Betaloc', each of the two words must, therefore, be taken as a whole word. The words are so similar that there is reasonable probability of confusion between the words both from the visual and phonetic point of view. It is not a matter for microscopic inspection, but to be taken from the general and even casual point of view of a customer walking into a shop. As observed above in the instant case, apart from the syllable 'ng' in defendants' mark, the two marks are identical. Even if proper attention is paid to the termination of the marks, the likelihood of confusion being caused cannot be ruled out. The mark 'Betaloc' is too near and so similar to the mark 'Betalong' as to make the confusion likely.

10. In the case of ""Corn Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142, the learned Judges of the Supreme Court held that

the trade marks ""Gluvita"" and the mark ""Glucovita"" were likely to cause deception or confusion. Here again, the learned Judges have held as follows:

17. It is well known that the question whether the two marks are likely to give rise to confusion or not is a question of first impression. It is for the

court to decide that question. English cases proceeding on the English way of pronouncing an English word by Englishmen, which it may be stated is

not always the same, may not be of much assistance in our country in deciding questions of phonetic similarity. It cannot be overlooked that the word

is an English word which to the mass of the Indian people, is a foreign word. It is well recognised that in deciding a question of similarity between two

marks, the marks have to be considered as a whole.

11. The Supreme Court, in the latest case of ""Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., AIR 2001 SC 1952,"" had an occasion to deal

with the brand name ""Falcitab"" used by the respondent and the brand name of the appellant ""Falcico"" and found that both are similar and likely to

cause deception and confusion. While laying down the principle to decide the issue, the learned Judges have held as follows:

32. Public interest would support lesser degree of proof showing confusing similarity in the case of trade mark in respect of medicinal product as

against other non-medicinal products. Drugs are poisons, not sweets. Confusion between medicinal may, therefore, be life threatening, not merely

inconvenient. Nothing is frailty of human nature and the pressures placed by society on doctors, there should be as many clear indicators as possible to

distinguish two medicinal products from each other. It is not uncommon that in hospitals, drugs can be requested verbally and/or under critical/pressure

situations. Many patients may be elderly, infirm or illiterate. They may not be in a position to differentiate between the medicine prescribed and bought

which is ultimately handed over to them. This view finds support from McCarthy on Trade Marks, 3rd Edition para 23.12 of which reads as under:

The tests of confusing similarity are modified when the goods involved are medicinal products. Confusion of source or product between medicinal

products may produce physically harmful results to purchasers and greater protection is required than in the ordinary case. If the goods involved are

medicinal products each with different effects and designed for even subtly different uses, confusion among the products caused by similar marks

could have disastrous effects. For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal

preparations. The same standard has been applied to medical products such as surgical sutures and clavicle splints.

12. A Bench of this Appellate Board had an occasion to consider a trade mark ""Prexmin"" and the trade mark ""Premarin"" and found that both are

identical and the use of the same would cause confusion in the minds of the public and consequently, the Bench set aside the order of Registrar in the

case of American Home Products Corporation, New York, IPLR 2004 (APRIL) 159. The Bench drew support from the principles laid down by the

Supreme Court in Cadila Health Care Ltd. case.

13. In the light of the above laid principles, we have now to take up the two trade marks for consideration. It is unnecessary for us to elaborately

discuss on the similarity or the dis-similarity of both the products minutely. As in the latest case held by the Supreme Court, we have to take the

generic term of the trade mark both phonetically, visually and structurally by taking the whole word of both the Trade Marks. The Trade Mark of the

appellant is ""BRUFORTE"", whereas the first respondent's Trade Mark is ""BRUFEN"". The terminal letters in both the Trade Marks do not make any

distinctiveness either phonetically or visually. When the goods are Pharmaceutical ones and to treat the common ailment as held by the Supreme Court

in the Cadila Health Care case, there cannot be any liberal comparison to find out the distinctiveness on a microscopic comparison. In fact, the

Registrar of Trade Marks had elaborately discussed the same and found that both the trade marks are identical. Even if there is a slight difference, on

the principles laid down by the Supreme Court that so far as the medicinal products are concerned, the harmful result is greater than the harmful

results of other products and as such, some strictness is necessary to find the dis-similarity between the two trade marks. If we apply the principles

laid down by the Apex Court in the Cadila Health Care Ltd. case, we have no other option except to concur with the view taken by the Registrar of

Trade Marks as both the Trade Marks are similar almost in all respect. We accordingly do so.

14. Insofar as the contention of the learned counsel for the appellant that the prefixed word ""BRU"" is in common use in respect of many other

Pharmaceutical products is concerned, the only material placed before us was the Pharmaceutical Guide 2000. Of course, there is a mention to

various medicinal products such as, Bruace, Brucomb, Brucon, Brufamol, Brufen, Bruflam, Brufogesic, Brugesic, Brukid, Brum, Brumed, Brupal,

Brutec-P. As rightly pointed out by the learned counsel for the first respondent that there is absolutely no evidence either before the Registrar of

Trade Marks or before us that those trade marks are in use or at least were in use on the date of the application. In an identical case, the Supreme

Court in the case of *"Corn Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142* has held as follows:

15. The series of marks containing the common element or elements therefore may assist the applicant when these marks are in extensive use in the

market. The onus of proving such user is of course on the applicant, who wants to rely on those marks. Now, in the present case the applicant, the

respondent before us, led no evidence as to the user of marks with the common element. What had happened was that the Deputy Registrar looked

into his register and found there a large number of marks which had either 'Gluko' or 'Vita' as prefix or suffix in it. Now of course the presence of a

mark in the register does not prove its user at all. It is possible that the mark may have been registered but not used. It is not permissible to draw any

inference as to their user from the presence of the marks on the register. If any authority on this question is considered necessary, reference may be

made to *Kerly p. 507 & Willesden Varnish Co. Ltd. v. Young & Marten Ltd., (1922) 39 RPC 285* at p. 289.

15. In view of the above principle laid down by the Supreme Court, the burden of proof lies on the appellant to establish the use of those trade marks

pointed out by them. The appellant had miserably failed to lead any evidence on this aspect. Consequently, the said contention of the learned counsel

for the appellant is liable to be rejected.

16. For all the reasons stated above, the order of Registrar of Trade Marks is confirmed and the appeal is dismissed. However, there will be no order

as to costs.