
(2002) 03 BOM CK 0061

In the Bombay High Court

Case No : Petn. Miscellaneous No. 42 of 1996

BDH Industries Ltd.

APPELLANT

Vs

Croydon Chemical Works Pvt. Ltd., Bombay and Another

RESPONDENT

Date of Decision : 22-03-2002

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 11, 12

Citation : AIR 2002 Bom 361 : (2002) 3 ALLMR 61 : (2002) 4 BomCR 5

Hon'ble Judges : J.A. Patil, J

Bench : Single Bench

Advocate : Rajesh Patil, instructed by M.M. Kadam, for the Appellant; Ravi Kadam and Manish Saurashtri, instructed by Shantilal and Co., for the Respondent

Final Decision : Dismissed

Judgement

J.A. Patil, J.—This is a petition u/s 109 of the Trade and Merchandise Marks Act, 1958 (for short the Act 1958), challenging the order dated 29-12-1995 passed by the Assistant Registrar of Trade Mark in the matter of application No. 408108 in Clause 5, rejecting the petitioners application for registration of trade mark "PV-DINE" and allowing the opposition of respondent No. 1, who has the registration of the trade mark "PIODIN".

2. The petitioner is a company registered under the Companies Act, 1956 carrying on the business of the manufacturing and selling drug and pharmaceuticals falling in Class 5. Respondent No. 1 is also a company similarly registered and carrying the business of selling pharmaceuticals. On 18th July, 1983 the petitioner applied to the Registrar of Trade Marks at Mumbai for registration of the trade mark "P.V. DINE" in class 5 in respect of "Medicinal and Pharmaceutical preparations for human use," it appears that the Trade Mark Registrar raised certain preliminary objection and in compliance there of the petitioners agreed to amend the said trade mark "P.V. DINE" by changing it to PV-DINE. Thereafter the petitioner's application for registration of the said mark was advertised by the Trade Mark Registrar in Trade Marks Journal No. 969,

dated 18th October, 1989. Respondent No. 1 filed its opposition dated 15-2-1990, pointing out that it is the proprietor of the trade mark "PIODIN", which is registered under the Act, 1958 under No. 315231 on 22-8-1980 in class 5 for medicinal and pharmaceutical preparations. Respondent No. 1 further pointed out that its goods and those of the present petitioners are of the same description and that the petitioners mark "PV DINE" is deceptively and confusingly similar to the registered trade mark "PIODIN" of respondent No. 1. Respondent No. 1 further contended that the adoption by the petitioner of the mark "PV-DINE" was not honest and was adopted with the knowledge of the first respondents registered trade mark with a view to get advantage of the same. It was also contended that the petitioners mark "PV-DINE" is neither adopted to distinguish nor it is capable of distinguishing the goods of the petitioner, the Assistant Registrar allowed both the parties to lead the evidence and after giving hearing to both of them passed the impugned order.

3. The Assistant Registrar pointed out that the application of the petitioner was accepted for registration at the pre-advertisement stage subject to disclaimer of letters "PV". He further observed that "DINE" is a common suffix. The Assistant Registrar therefore held that Section 9 operates as a bar to the registration of the trade mark "PV-DINE". The Assist. Registrar upheld the objection of respondent No. 1 u/s 11(a) on the ground that the use of the same goods of same description is contrary to the provisions of Section 12(1). She further held that the petitioner's mark "PV-DINE" and respondent's mark "PIODINE" are quite similar except the additional letters of "IO" to the respondent's mark. She therefore, sustained the objection of respondent No. 1 u/s 12(1). The Asstt. Registrar further held that the petitioner failed to furnish any tangible evidence to substantiate its bona fide adoption of the mark and that it cannot claim absolute proprietor right in respect of the common suffix. She therefore, upheld the objection of respondent No. 1 U/S. 18(1) of the Act.

4. I have heard Shri C. R. Patil for the petitioner and Mr. Ravi Kadam for the respondent. Shri Patil contended before me that there is no similarity in both the trade mark "PV-DINE" and "PIODINE" and therefore, according to him the Asstt. Registrar was not justified in rejecting the petitioners application for registration. Shri Ravi Kadam on the other hand submitted that the petitioners trade mark "PV DINE" lacks distinctive feature and it was incapable of registration. He further pointed out the prohibition contained in Sections 11 and 12 and submitted that interest of consumers against any confusion or deception being caused due to the similarity of both the marks, requires to be protected.

5. Before any mark is registered under the Act 1958 and entered into the register of trade marks, it has to cross hurdles contemplated by Sections 9 and 11, 12(i) and 18 of the Act. Section 9 states that a trade mark shall not be registered in Part A of the register unless it contains or consists of at least one of the essential particulars namely Clauses A to E. Section 9 reads as under :

9. Requisites for registration in Parts A and B of the register : (1) A trade mark

shall not be registered in part A of the register unless it contains or consists of at least one of the following essential-particulars, namely :-- (a) the name of a company, individual or firm represented in a special or particular manner;

(b) the signature of the applicant for registration or some predecessor in his business;

(c) One or more invented words;

(d) one or more words having no direct reference to the character or quality of the goods and not being, according to its ordinary signification, a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in India;

(e) any other distinctive mark;

It is the petitioner's case that the mark "PV DINE" was coined by it. In 1983 by taking the letters "P & V" from "POIDINE" and the letters "DINE" from "IODINE". As pointed out above, in view of the preliminary objection raised by the Registrar of trade marks, the petitioner agreed to apply for amended trade mark "PV-DINE". The petitioner has made a disclaimer to the letters "P. V." which is not distinctive. The suffix "DINE" is a common suffix. Therefore, the Asstt. Registrar was right in holding that the mark applied for is not capable of distinguishing the petitioner's goods.

6. Coming to Section 11 it also prohibits registration of certain marks and states - A mark--

(a) the use of which would be likely to deceive or cause confusion ; or

(b) the use of which would be contrary to any law for the time being in force; or

(c) which comprises or contains scandalous or obscene matter; or

(d) which comprises or contains any matter likely to hurt the religious susceptibilities of any class or section of the Citizens of India; or

(e) which would otherwise be disentitled to protection in a court; shall not be registered as a trade mark.

Section 12(1) also contemplates prohibition of registration of identical or deceptively similar trade marks and it reads as under :--

(1) Save as provided in Sub-section (3) no trade mark shall be registered in respect of any goods or description of goods which is identical with or deceptively similar to a trade mark which is already registered in the name of a different proprietor in respect of the same goods or description of goods.

The term "deceptively similar" has been defined by Section 2(d) as follows :--

(d) "deceptively similar" :-- A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive

or cause confusion:"

There are series of decisions which lay down the test for considering the question as to whether a trade mark is deceptively similar to the other trade mark or not. They are National Sewing Thread Co. Ltd. Vs. James Chadwick and Bros. Ltd. (J. and P. Coats Ltd., Assignee), ; Ciba Ltd. Vs. M. Ramalingam and S. Subramaniam trading in the name of South Indian Manufacturing Co. and Another, ; Corn Products Refining Co. Vs. Shangrila Food Products Ltd., , F. Hoffmann-la Roche and Co. Ltd. Vs. Geoffrey Manner and Co. Pvt. Ltd., ; Astra-IDL Limited Vs. TTK Pharma Limited, and Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd., .

7. The perusal of all these decisions makes it clear that apart from the structural, visual and phonetic similarity or dissimilarity, the question has to be considered from the point of view of a man of average intelligence and imperfect recollection. Secondly, it is to be considered as a whole and thirdly it is the question of his impression. It is for these reasons that in the above mentioned decisions, the marks "GLUVITA" and "GLUCOVITA"; "CIBA" and "CIBOL"; BETALOG AND BETLOC; "FALCITAB" and "FALIGO" were held to be deceptively similar.

8. Coming to the marks in question, namely "PV-DINE" and "PIODIN" both consist of six letters and begin with a common syllable "P". The suffixes "DINE" and "DIN" in these two marks are almost similar except the fact that suffix in the mark "PV-DINE" consists of 4 letters whereas the suffix in the mark "PIODIN" consists of three letters. However, so far as the phonetic test is concerned, there is not much difference in the pronunciation of these two suffixes. The prefix in "PV-DINE" consists of two letters "PV" whereas the pre-fix in the mark "PIODIN" consists of three letters "PIO". However, there is not much difference in the pronouncement of the same. Thus a fast or faint utterance of both the marks is very much likely to make a confusion that they are one and the same. It is a common knowledge that in our country English is not a mother tongue and therefore, pronunciations are different from person to persons. For instance some people pronounce "school" as "Eschool". Para as "Pera", Bank as Baint, Report as Repot and so on. Therefore, it is not unlikely that the mark "PV-DINE" is likely to be pronounced as "PIODIN". This is not a hypothetical possibility or probability but a practical reality which cannot be ignored.

9. So far as the medicinal preparations are concerned, the Supreme Court has laid down a stricter test. In the case of Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd., , in para 33 of its judgment the Supreme Court has observed that :--

"In a country like India where there is no single common language, a large percentage of population is illiterate and a small fraction of people know English, then to apply the principles of English law regarding dissimilarity of the marks or the customer knowing about the distinguishing characteristics of the plaintiffs goods seems to overlook the ground realities in India. While examining such

cases in India, what has to be kept in mind is the purchaser of such goods in India who may have absolutely no knowledge of English language or of the language in which the trade mark is written and to whom different words with slight difference in spellings may sound phonetically the same. While dealing with cases relating to passing off, one of the important tests which has to be applied in each case is whether the misrepresentation made by the defendant is of such a nature as is likely to cause an ordinary consumer to confuse one product for another due to similarity of marks and other surrounding factors. What is likely to cause confusion would vary from case to case. However, the appellants are right in contending that where medicinal products are involved, the test to be applied for adjudging the violation of trade mark law may not be on a par with cases involving non-medicinal products. A stricter approach should be adopted while applying the test to judge the possibility of confusion of one medicinal products one another by the consumer. While confusion in the case of non-medicinal product with only cause economic loss to the plaintiff, confusion between the two medicinal products may have disastrous effects on health and in some cases life itself. Stringent measures should be adopted specially where medicines are the medicines of last resort as any confusion in such medicines may be fatal or could have disastrous effects. The confusion as to the identity of the products itself could have dire effects on the public health".

In view of the above position, the Assistant Registrar was right in upholding the objections of respondent No. 1 raised under Sections 11 and 12(1) of the Act, 1958.

10. Mr. Patil relied on the decision in Johann A. Wulfig Vs. Chemical Industrial and Pharmaceutical Laboratories Limited and Another, , where a division bench of this Court considered the question, whether the trade mark "COMPLAMINA" and "CIPLAMINA" were identical and deceptively similar and held that they were not so as there was phonetic dissimilarity between the two. It was pointed out that the first letter "C" in the mark "COMPLAMINA" is pronounced as "K" whereas the first letter "C" in the mark "CIPLAMINA" is pronounced as it is written. It was pointed out that in both the words it is not the suffix that is the controlling sound. It is the disparate "COM" and "CIP" (the one pronounced "KOM" and the other as written) that is the controlling sound and it is that which makes all the difference. The division bench observed that the first syllable of the word mark is generally most important. In the instant case, the first syllables in both the marks "PV DINE" and "PIODIN" are common and they are pronounced as written and therefore, when the two words are pronounced they are very much apt to give an impression that they are one and the same. Thus there is hardly any phonetic dissimilarity between the two like the marks "COMPLAMINA" and "CIPLAMINA" in the above mentioned case. Therefore, in my opinion reliance upon said decision by Shri Patil is of no help to him. The Assistant Registrar after considering the similarities in the two words has rightly refused to use her discretion in favour of the petitioners. I do not think that any interference therein is called for. I thus find that there is no merit in this petition.

11. In the result, the petition is dismissed.